# Silence speaks volumes as IP cert denials pile up at US Supreme Court

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By Melissa Ritti

Following a decade of high-profile, high-impact rulings, the interest in intellectual property at the nation's highest court could be waning. The US Supreme Court has agreed to hear just one IP case so far this term — a precipitous drop over their average of six IP grants, annually, from 2016-2019. The inaction no longer feels like a patient wait for the perfect vehicle, and more like a challenge to Congress.

Eligibility under Section 101 of The Patent Act is a mess.

In so many words, that has been the message to the US Supreme Court, consistently, year after year, for over a decade.

And year after year, the Supreme Court has said no — refusing to revisit its 2014 ruling in Alice Corporation v. CLS Bank International and the 2012 holding in Mayo Collaborative Servs. v. Prometheus Labs, which collectively counsel that abstract ideas and laws of nature are ineligible for patenting.

Twice, the Supreme Court has gone so far as to call for the views of the US Solicitor General, or CVSG, on Section 101. Twice, in American Axle & Manufacturing v. Neapco and Interactive Wearables v. Polar Electric Oy, the government responded by urging a grant of certiorari.

Twice, certiorari was denied.

"I think they've said all they're going to say on patent eligibility," Jamie Simpson, chief policy officer and counsel of the Council for Innovation Promotion, or C4IP, told MLex.

"They've had a number of very good vehicles, and they've declined review."

— Deeply divided —

The latest strikeout goes to Return Mail.

At issue are two claims of a mail sorting patent declared ineligible by the US Court of Federal Claims in a win for the US Postal Service. The Federal Circuit affirmed, pursuant to its own Local Rule 36 — itself the subject of numerous unsuccessful requests for high court review (see here).

In its July 2024 petition for writ of certiorari, Return Mail argued "all key decisionmakers — district courts, the U.S. Patent and Trademark Office, and the Federal Circuit — are deeply divided on how to apply" the two-step eligibility framework set forth in Alice.

The Solicitor General, this time representing the US Patent and Trademark Office, acknowledged "the government previously has urged this Court to clarify the scope of the abstract-idea exception," but said in an October 2024 response brief that Return Mail's case "is an inappropriate vehicle in which to do so because the claims at issue here are patent ineligible under any reasonable view of that exception."

Return Mail's petition was denied November 18.

— Cold shoulder —

Patents aren't the only intellectual property getting the cold shoulder from the justices. From 2016-2019, the US Supreme Court issued an average of six intellectual property-related opinions each term. In the four years since then, from 2020 to 2023, that number dropped to just over two.

In their current term, the justices have agreed to hear only one case — Dewberry v. Dewberry, a trademark row over disgorged profits awarded against legally separate, non-party corporate affiliates of an adjudicated infringer (see here).

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Last month, they issued a CVSG in a copyright dispute between the music industry and Cox Communications.

The reasons for the drop in grants are a matter of debate.

— Sea Changes —

Mark Fleming of WilmerHale credits a course correction by the Federal Circuit after two decades of steady criticism from the High Court, over the rigid application of patent-specific rules of their own creation.

“Our sense is that the Supreme Court believes that the Federal Circuit is generally getting things right, such that the Supreme Court can focus on other things,” Fleming said.

Anne Li, co-chair of Crowell & Moring’s Life Sciences and Patents group, says that in her practice area the justices “pulled a lot of levers over the last 10 years and it caused sea changes each time.”

More recently, however, she pointed out that the few petitions that are being granted are narrower in scope and focused on the more “arcane” elements of patent law, such as Amgen v. Sanofi, a dispute over enablement decided in 2023. “It’s getting pretty clear to me that they’re making really technically specific rulings,” Li added.

The makeup of the court has changed dramatically since the death of Justice Antonin Scalia in 2016, with the addition of four new justices — the number needed to grant certiorari. The court’s docket has also been shrinking as a whole, with 10 fewer decisions on the merits during the 2023 term than in 2020.

A reluctance to revisit precedent is also possible.

Five current members were on the court for Alice, including Clarence Thomas, who authored the unanimous opinion, and Sonia Sotomayor, who authored a concurrence. The same five — Chief Justice John G. Roberts, Thomas, Sotomayor, Justice Samuel Alito and Justice Elena Kagan — were also seated for Mayo, another unanimous decision, authored by former Justice Stephen Breyer.

Thus, to undo those holdings, a majority of the court would need to admit they got it wrong.

— Message received —

Yet another scenario, and the one that resonates most with Simpson and Li, is that the justices believe the ball is no longer in their court. Instead, Simpson said, "I think they’re leaving it in Congress’s hands."

If so, the message appears to have been received.

Three bills pending in Congress would address two of the most common laments by petitioners: The PERA Act would change the governing standard for Section 101 to eliminate all judge-made exceptions to patent eligibility (see here) while the RESTORE Act (see here) would shift the burden to an infringer to show why it should not be enjoined, in a rebuke of the 2006 ruling in eBay v. MercExchange. A third piece of legislation, the PREVAIL Act, pertains to the Patent Trial and Appeal Board.

Simpson sees Supreme Court interest in patents as cyclical, with “periods of intense interest” that generate impactful decisions, followed by a lull as lower courts deal with “the ramifications.” Li agreed that the justices have a tendency to make “big changes, and then see how things shake out” over time.

For the tech and lifescience sectors, in particular, in the decade post-Alice, confusion over Section 101 has lingered.

“Say what you will,” Li added, “but it forced the legislative branch to sit down and look at the law.”

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