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# Where Does Judge Gorsuch Fall on IP?

The SCOTUS nominee's opinions don't appear to favor alleged intellectual property infringers or owners.

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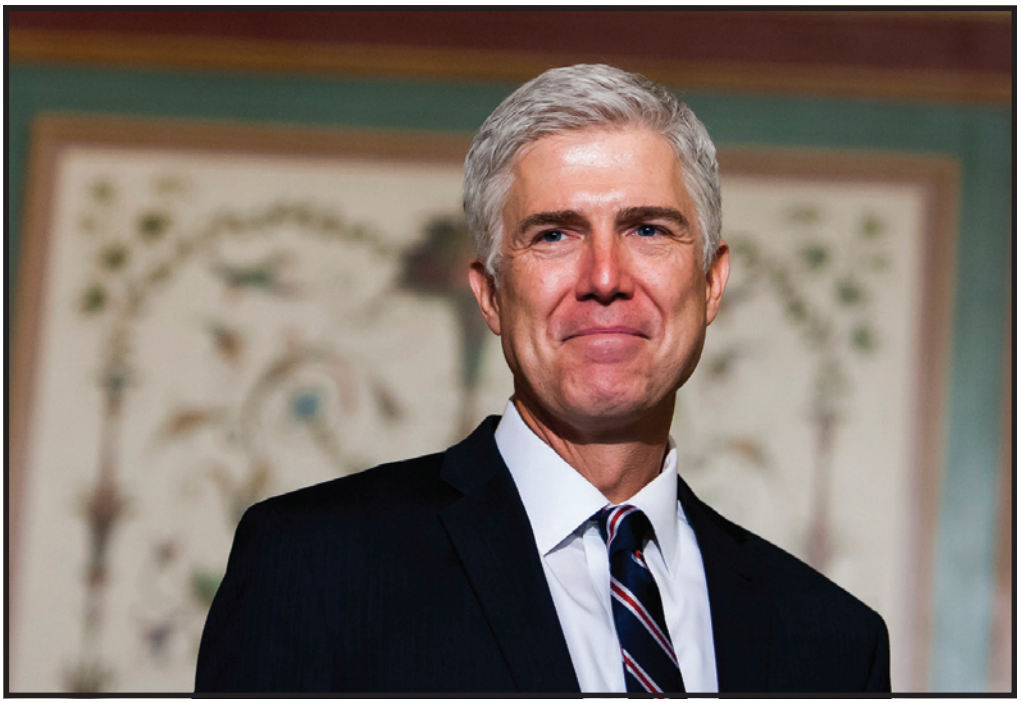

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The U.S. Supreme Court has played a growing role in shaping intellectual property policy, and President Donald Trump's nomination of Judge Neil Gorsuch to the nation's high court promises to continue that trend.

Over the 10 years that he has served on the U.S. Court of Appeals for the Tenth Circuit, Gorsuch's decisions in intellectual property disputes have reflected a close attention to statutory text and a preference for narrow results that hew closely to precedent.

Although Gorsuch's approach to patent disputes remains largely unknown, his general approach to administrative law questions could reflect some skepticism toward deference to the U.S. Patent and Trademark Office.

## NO CLEAR FAVORITE

Overall, Gorsuch's written opinions have not clearly favored intellectual property owners or accused infringers.

In seven trademark cases where there was a clear result, Gorsuch voted for the trademark owner twice and for the party challenging the exercise of a trademark right five times. Similarly, in eight copyright and trade secret cases, Gorsuch voted for the owner four times and for the accused infringer four times.

In a handful of other cases, there was no clear winner or loser, and Gorsuch wrote or joined decisions that gave partial wins to both sides.

One illustration of Gorsuch's approach is his 2008 opinion in *Meshwerks v. Toyota Motor Sales* for the Tenth Circuit.

The case raised the novel question of whether a computer programmer should be given copyright protection for a digital model that accurately depicted an actual, mass-produced automobile.

Gorsuch, in examining whether the digital model displayed the requisite level of originality to merit copyright protection, analyzed both the text of the Copyright Act and the Supreme Court's guidance on the "modicum of creativity" required in the high court's 1991 case, *Feist Publications v. Rural Telephone Service*.

Gorsuch concluded that "as (very good) copies of [the defendant's] vehicles" Meshwerks' digital models were not "independent creations" and thus did not merit copyright protection.

Importantly, Gorsuch refused to establish a categorical rule for digital modeling, stating that the court did "not doubt for an instant that the digital medium before us, like photography before it, c[ould] be employed to create vivid new expressions fully protectable in copyright."

Several other Tenth Circuit decisions follow this same pattern of carefully construing the text of intellectual property statutes and applying that text to the facts.

For example, in *General Steel Domestic Sales v. Chumley* in 2015, Gorsuch parsed the text of the Lanham Act's remedial provision, concluding that it "pretty plainly" contemplated the type of burden-shifting framework that the district court applied to determine how much of the defendant's profits were to be disgorged.

In 2014, in *Storagecraft Technology v. Kirby*, Gorsuch looked to the text of Utah's trade-secret law, which authorizes an award of a "reasonable royalty" "for a misappropriator's unauthorized disclosure or use of a trade secret."

Writing again for a unanimous panel, Gorsuch concluded that the statute did not require the plaintiff to prove that the defendant disclosed the trade-secret information for personal gain, or that the recipient of the trade-secret information made commercial use of the information; the "Utah law doesn't distinguish between a misappropriator's venial motives," he wrote on behalf of the panel.

Rejecting alternative constructions, Gorsuch noted that "arguments like these are more appropriately directed to those charged with writing Utah's trade-secret statute than those charged with applying it."

As these examples illustrate, Gorsuch's approach to statutory construction resembles that of the late Justice Antonin Scalia, who often joined with justices of differing ideological viewpoints in intellectual property cases.

## AGENCY DEFERENCE

Gorsuch may, however, have distinct views on the issue of agency deference, which is arising with increasing frequency in appeals from decisions of the Patent Trial and Appeal Board.

For example, last year in *Cuozzo Speed Technologies v. Lee*, an eight-member Supreme Court issued a decision deferring to the Patent and Trademark Office's construction of its authority to promulgate a rule of construction for patent claims undergoing inter partes review.

Although the opinion was issued after Scalia's death, the late justice had traditionally been perceived as a supporter of certain forms of agency deference.

Gorsuch, in contrast, has criticized the doctrine of agency deference articulated in the high court's 1984 ruling *Chevron, U.S.A. v. Natural Resources Defense Council*, writing in a concurrence last year in Tenth Circuit case *Gutierrez-Brizuela v. Lynch* that "[m]aybe the time has come to face the behemoth" that the *Chevron* doctrine had become.

As PTO decision-making comes under increasing judicial scrutiny, Gorsuch's views on agency deference may take on added significance for intellectual property practitioners.

On balance, Gorsuch's record with respect to intellectual property cases seems to indicate that he may approach such cases on the Supreme Court much like he has on the court of appeals, neither as an ideologue nor a reformist.

But given the Supreme Court's active involvement in intellectual property cases in recent years, it also seems likely that if Gorsuch is confirmed, he will have a significant opportunity to help shape the direction of intellectual property policy for years to come.


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