

Glimmers of Justice Gorsuch's Prospective IP Jurisprudence

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by Ashley Johnson and David G. Barker

Introduction

On April 10, 2017, Neil Gorsuch was sworn in as the 113th justice of the Supreme Court, filling the vacancy left by Justice Antonin Scalia. While on the Tenth Circuit, Justice Gorsuch wrote opinions on complex trade secret, copyright, and trademark issues in a detail-oriented manner that indicates balanced treatment of intellectual property owners and challengers. His intellectual property opinions delve into complicated issues and thoroughly explain his reasoning. But his criticism of *Chevron* deference, exemplified in his concurring opinion in [*Gutierrez-Brizuela v. Lynch* \(2016\)](#), raises questions about how he will approach agency interpretation of intellectual property laws.

Copyright

In [*Meshworks, Inc. v. Toyota Motor Sales* \(2008\)](#), Gorsuch dealt with copyright protection in “unadorned, digital wire-frames of Toyota’s vehicles.” While recognizing the presumption of a valid copyright based on the registration certificate, Gorsuch analogized to photography cases and analyzed the specific requirements for copyright protection in photographs. Historically, photography was viewed simply as copying the natural world as it existed, and thus not subject to copyright. But now photographs may be protected because of artistic qualities, such as lighting and perspective, incorporated by the photographer. Contrasting the wire-frames with the photography cases, Gorsuch reasoned that the wire-frames simply copied the vehicles, but did not add additional protectable elements to render them independent creations deserving of copyright protection.

Trade Secret, Patent, and Preemption

In [*Russo v. Ballard Medical Products* \(2008\)](#), Gorsuch wrote the panel opinion in a case involving the interplay between trade secret law, patent law, and federal pre-emption. The opinion addressed the Supreme Court’s 1974 decision in *Kewanee Oil v. Bicron Corp.*, a case which dealt with trade secret pre-emption, together with *Bonito Boats v. Thunder Craft Boats*, a Supreme Court case regarding the Supremacy Clause and patent law. The court held in part that the trade secret claim was not pre-empted based on the specific facts in the case, including because the trade secret owner “did not seek to be proclaimed the inventor of [the patents] or seek any of the rights associated with inventorship of a patent . . . Instead, like any other plaintiff proceeding under traditional trade secret laws, [the owner] simply sought to establish that he had a valid trade secret” and to obtain redress for its misappropriation.

Trademark

In [*El Encanto, Inc. v. Hatch Chile Company* \(2016\)](#), Gorsuch wrote, “The Hatch Valley [in New Mexico] may be to chiles what the Napa Valley is to grapes. . . . One thing we know about life and the law is that where value lurks litigation will soon follow — and the Hatch Valley chile pepper supplies no exception. . . . As so many do these days, this seemingly mild dispute turned hot during discovery.” This colorful prose addressed an apparently ordinary motion to quash a federal subpoena. The subpoena issued in a trademark opposition at the Trademark Trial and Appeal Board (TTAB), and the district court granted the motion to quash. Gorsuch analyzed the Federal Rules of Civil Procedure, federal statutes authorizing parties in TTAB proceedings to use federal discovery processes, the Trademark Trial and Appeal Board Manual of Procedure (what he called a “sub-regulatory manual”), and case law.

The Tenth Circuit panel reversed the district court, and the opinion displayed Gorsuch's detail-oriented approach in what he recognized was a "seemingly small case about chile pepper sourcing and document discovery [which] has carried a surprisingly large punch, requiring us to try to fit together in a sensible way an aged statute, many and diverse judicial glosses given to that law, various agency rules — and musings — about the statute, and their interaction with amendments to the Federal Rules of Civil Procedure."

***Chevron* Deference**

Gorsuch has criticized *Chevron* deference, the concept that courts should defer to interpretations of statutes made by government agencies unless they are unreasonable.

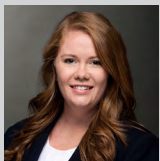
In *Gutierrez-Brizuela*, Gorsuch wrote *both* the majority opinion and a separate concurrence. He explained in the concurrence that *Chevron* deference "permit[s] executive bureaucracies to swallow huge amounts of core judicial *and* legislative power and concentrate federal power in a way that seems more than a little difficult to square with the Constitution of the framer's design." He also noted that this principle gives executive agencies the ability to overrule judicial determinations regarding statutory interpretation, circumventing legislative processes.

It remains to be seen whether Gorsuch's views expressed in his concurring opinion might affect decisions regarding interpretations of statutes by the United States Patent and Trademark Office and the United States Copyright Office. Several cases currently pending at the Federal Circuit, on rules governing the America Invents Act (AIA) for example, may soon come before the Supreme Court and Justice Gorsuch.

Conclusion

These opinions indicate Justice Gorsuch may not favor one side or the other in an intellectual property case, but he is likely to produce detailed opinions that rely on the text of the statutes he considers. In that regard, he is similar to his predecessor, Justice Scalia, who favored a textualist approach (see [here](#), for example). Perhaps Gorsuch may also entertain with his writing, as Scalia did. In any event, it seems likely that Gorsuch's opinions may lead to increased clarity on finer points of intellectual property law.

Ashley is an associate and David is a partner at Snell & Wilmer in Phoenix, Arizona. You can read about Ashley [here](#) and David [here](#).

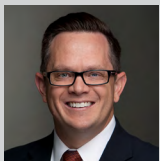


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