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2011

## Naïve Textualism in Patent Law

Jonathan R. Siegel

*George Washington University Law School, jsiegel@law.gwu.edu*

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### Recommended Citation

Siegel, Jonathan R., Naïve Textualism in Patent Law (2011). 76 Brook. L. Rev. 1019 (2011); GWU Law School Public Law Research Paper No. 2017-79; GWU Legal Studies Research Paper No. 2017-79. Available at SSRN: <https://ssrn.com/abstract=3068886>

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# Naïve Textualism in Patent Law\*

Jonathan R. Siegel†

## INTRODUCTION

This symposium asks, “How much work does language do?” The answer these days is “too much.” Courts are letting statutory language do the work that used to be done by judges’ paying sensitive attention to context, history, policy, and background understandings.<sup>1</sup> Or at least, they are apparently doing so—the even less appealing possibility is that courts are using statutory language as a cover for decisions reached on other grounds.<sup>2</sup>

I have long argued that part of the judicial function in statutory interpretation is to apply “background principles” of law, or “field-specific canons of construction.”<sup>3</sup> Courts, in construing statutes, should—and do—discern the background principles of the area of law of which a statute is a part and interpret statutory text in light of them. Background principles of law frequently influence statutory interpretation, and in appropriate cases, the force of field-specific canons of construction may be so great as to cause courts to depart from apparently clear statutory text.<sup>4</sup>

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† Professor of Law, Kahan Research Professor, George Washington University Law School; A.B., Harvard College; J.D., Yale Law School. The author is currently on leave from teaching while serving as the Director of Research and Policy of the Administrative Conference of the United States. This essay is written in the author’s academic capacity and is not endorsed by the United States or any agency thereof. The author wishes to thank the participants in the Brooklyn Law School symposium at which this paper was presented for their helpful comments.

<sup>1</sup> See *infra* Part II.B.

<sup>2</sup> See *infra* Part II.C.

<sup>3</sup> Jonathan R. Siegel, *Guardians of the Background Principles*, 2009 MICH. ST. L. REV. 123, 123-29; Jonathan R. Siegel, *What Statutory Drafting Errors Teach Us About Statutory Interpretation*, 69 GEO. WASH. L. REV. 309, 348 (2001); Jonathan R. Siegel, *Textualism and Contextualism in Administrative Law*, 78 B.U. L. REV. 1023, 1033, 1043-44, 1054 (1998) [hereinafter Siegel, *Textualism and Contextualism*].

<sup>4</sup> See, e.g., Siegel, *Textualism and Contextualism*, *supra* note 3, at 1045-48. Such cases are unusual, but they are sufficiently numerous to demonstrate that reliance on background principles is a part of the judicial process of statutory construction.

Textualist interpreters, however, are pushing more and more in the direction of insistently following statutory text. Textualists are becoming increasingly radical, as they gradually realize that the accommodations they previously allowed in order to reach sensible results are inconsistent with fundamental textualist premises.<sup>5</sup> This trend has resulted in the creation of a “naïve textualism.” This mode of interpretation is not sharply differentiated from textualism *per se*, but is distinguished by its naïve attitude that statutes can be best understood by simply looking up their words in a dictionary, applying a few canons of statutory construction, and eschewing other considerations.

The Supreme Court recently provided an excellent example of its radical shift in the direction of naïve textualism in the field of patent law. For decades—indeed, for centuries—patent law was a paradigm of richly contextualized judicial interpretation. Courts understood the sparse text of patent statutes in light of history, policy, and background understandings of the field of patent law.<sup>6</sup> In the recent case of *Bilski v. Kappos*,<sup>7</sup> however, the Supreme Court looked to little more than the dictionary in deciding fundamentally important questions under the patent statute. *Bilski* shows the dangers of language doing too much work.

This essay first outlines the Court’s shift from a richly contextual approach to a naïvely textualist approach to statutory interpretation in patent law,<sup>8</sup> and then discusses why courts should avoid naïve textualism.<sup>9</sup>

## I. INTERPRETING THE PATENT ACT, THEN AND NOW

### A. *Traditional Methods of Interpreting the Patent Act*

For a statute that governs such an important and tremendously varied array of human behavior, the Patent Act is remarkably compact. Three short sections set out the requirements that a patentable invention be new, useful, and nonobvious, and comprise a patentable subject matter.<sup>10</sup> But life

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<sup>5</sup> Jonathan R. Siegel, *The Inexorable Radicalization of Textualism*, 158 U. PA. L. REV. 117, 120-22 (2009).

<sup>6</sup> See *infra* Part I.A.

<sup>7</sup> 130 S. Ct. 3218 (2010).

<sup>8</sup> See *infra* Part I.

<sup>9</sup> See *infra* Part II.

<sup>10</sup> See 35 U.S.C. §§ 101, 102, 103 (2006).

under the patent statute is not as simple as its brief text might suggest: “the statute cannot be read in isolation from the array of judicial precedent that has interpreted nearly each of its words.”<sup>11</sup> In making the terse language of the patent statute workable in practice, the courts have glossed, strained, and sometimes departed from the statutory text, and they have not been embarrassed to acknowledge their policy reasons for doing so. To fully document the judicial role in drawing patent law principles out of sparse statutory text would require far more space than is available in a symposium contribution, but a few examples will give the flavor of traditional judicial methods of interpreting the Patent Act.

### 1. Novelty

Section 102 of the Patent Act, which embodies the statutory requirement that a patented invention be “new,” has been the subject of much judicial development. For example, the statute provides that an invention cannot be patented if, prior to the applicant’s invention of it, the invention was “known . . . by others in this country.”<sup>12</sup> Notwithstanding the seemingly straightforward text of the statute, however, the courts have held that the word “known” means “publicly known.” A patent, therefore, is not barred by prior knowledge of the invention that was not available to the public.<sup>13</sup> The courts have justified this somewhat strained reading on the policy ground that an inventor should not lose patent rights because of knowledge that a prior inventor kept “in his closet.”<sup>14</sup>

This textual strain becomes more readily apparent when one contrasts this reading of “known” with the reading that courts give to the rule that a patent cannot be granted if the claimed invention was in “public use” more than a year prior to the date of the patent application.<sup>15</sup> The cases that address this issue hold that a use is a “public use,” within the meaning of the statute, even if it is hidden from public view and gives the public no information about the invention—as

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<sup>11</sup> ROGER E. SCHECHTER & JOHN R. THOMAS, *INTELLECTUAL PROPERTY: THE LAW OF COPYRIGHTS, PATENTS, AND TRADEMARKS* 323 (2003).

<sup>12</sup> 35 U.S.C. § 102(a).

<sup>13</sup> *E.g.*, *Carella v. Starlight Archery*, 804 F.2d 135, 139 (Fed. Cir. 1986); *In re Borst*, 345 F.2d 851, 854 (C.C.P.A. 1965) (referring to this rule as a “well-established principle”).

<sup>14</sup> *Heath v. Hildreth*, 11 F. Cas. 1003, 1005 (C.C.D.C. 1841).

<sup>15</sup> 35 U.S.C. § 102(b).

might occur, for example, if the invention were a mechanism hidden in the workings of a watch.<sup>16</sup> Thus, the statutory prohibition that includes the word “public” requires less public knowledge than the statutory text that does not—certainly a surprising result from a textualist perspective.<sup>17</sup>

The surprise is still greater when one learns that even the most open, public use of an invention does *not* count as a “public use” if the purpose of the use is to test the invention, even though the statutory text makes no reference to the purpose of a use.<sup>18</sup> Again, the courts have not hesitated to justify this atextual reading on policy grounds, based on the rationale that “it is the interest of the public, as well as [of the inventor], that the invention should be perfect and properly tested.”<sup>19</sup> Many similar examples of courts adopting atextual interpretations of the Patent Act’s novelty requirement could be cited.<sup>20</sup>

## 2. Nonobviousness

Section 103 of the Patent Act provides that, even if an invention survives the novelty requirement of section 102, a patent cannot be obtained if the invention “would have been obvious at the time the invention was made to a person having

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<sup>16</sup> *Egbert v. Lippmann*, 104 U.S. 333, 336 (1881).

<sup>17</sup> *See id.* at 338-39 (Miller, J., dissenting) (complaining that “the word public is . . . an important member of the sentence” and that the Court’s reading “eliminate[s] from the statute the word public”).

<sup>18</sup> *Elizabeth v. Am. Nicholson Pavement Co.*, 97 U.S. 126, 134 (1877) (holding that installing experimental pavement on a public toll road for six years was not a “public use”).

<sup>19</sup> *Id.* at 137.

<sup>20</sup> Indeed, the first U.S. patent act barred a patent if the invention was “known or used before the application” for a patent. Patent Act, § 1, 1 Stat. 318 (1793). Read naïvely, this language would bar *all* patents, because every inventor necessarily knows his or her claimed invention before applying for a patent for it. The Supreme Court saved the statute by interpreting it as applying only to knowledge or use *by others* besides the inventor, as Section 102(a) now provides. *E.g.*, *Shaw v. Cooper*, 32 U.S. (7 Pet.) 292, 319 (1833).

Another strikingly atextual reading relates to manufacturing process inventions. If a process is secretly used to produce a product that is openly sold, such use is a “public use” of the process only if it is by the patentee himself, and not if it is by others, even though the statutory text makes no reference to *who* is using the invention. *Compare Metallizing Eng’g Co. v. Kenyon Bearing & Auto Parts Co.*, 153 F.2d 516 (2d Cir. 1946) (holding such use to be public if by the patentee himself), *with W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983) (holding such use not to be public if by another). In each case, the court justified its interpretation on policy grounds. *See W.L. Gore*, 721 F.2d at 1550 (holding that the law prefers a later inventor who files a patent application over an earlier one who keeps the process secret); *Metallizing Eng’g*, 153 F.2d at 520 (holding that the patent applicant should not be permitted to “extend . . . his monopoly”).

ordinary skill in the art to which said subject matter pertains.”<sup>21</sup> This requirement was born as an extratextual statutory gloss; the Supreme Court read it into the word “invention” in the Patent Act (if, indeed, the Court was concerning itself with statutory language at all) long before the modern section 103 even existed.<sup>22</sup> Today, the requirement is the subject of a strikingly atextual rule: although the text clearly turns on whether the invention would have been obvious “at the time the invention was made,” the lower courts have held that it bars a patent for an invention that would have been obvious in light of material published more than a year before the filing of the patent application, even if publication took place *after* the invention was made.<sup>23</sup> Again, this interpretation is justified on policy grounds.<sup>24</sup>

### 3. Subject Matter

Perhaps nowhere has the judiciary played a larger role in the development of patent law than with regard to patentable subject matter—the fundamental question of what kinds of things are patentable. Section 101 of the Patent Act provides: “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.”<sup>25</sup> Innumerable cases have attempted to explain this requirement, particularly with regard to “process” inventions.

Although the statutory term “process” seems very broad (especially since it is further statutorily defined to mean “process, art, or method”),<sup>26</sup> the courts have long imposed restrictions based on widely shared understandings of what kinds of things are patentable. Most fundamentally, the Supreme Court has held that “laws of nature, physical phenomena, and abstract ideas” are not patentable.<sup>27</sup> This rule is tied less to statutory text than to the principle that such

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<sup>21</sup> 35 U.S.C. § 103(a) (2006).

<sup>22</sup> *Hotchkiss v. Greenwood*, 52 U.S. (11 How.) 248, 267 (1850). It is unclear from the Court’s opinion whether the Court was interpreting a specific word in the Patent Act or simply relying on general principles.

<sup>23</sup> *In re Foster*, 343 F.2d 980, 987-90 (C.C.P.A. 1965).

<sup>24</sup> *See id.*

<sup>25</sup> 35 U.S.C. § 101 (2006).

<sup>26</sup> *Id.* § 100(b).

<sup>27</sup> *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980).

things cannot be patented because they are “the basic tools of scientific and technological work.”<sup>28</sup> While the boundaries of the category of “abstract idea” are not especially clear, the Supreme Court has held, for example, that algorithmic processes that do no more than manipulate numbers are not patentable, even though they would fall within the dictionary definition of the term “process.”<sup>29</sup>

Particular controversy has surrounded the patentability of processes that may be characterized as “business methods.” Although the dictionary definition of the term “process” (and its statutory predecessor, “art”) would encompass a process for doing business, the patent community long acted on the basis of a widely shared “understanding . . . about what patents were meant to protect” under which an application for a patent on a business method “would have been seen as absurd.”<sup>30</sup> Based on this understanding, courts long denied patents for business methods, and treatise writers agreed that business methods, as generally understood, were outside the patent system.<sup>31</sup>

Thus, for well over a century, the courts, including the Supreme Court, imbued the text of the patent statute with meaning based on widely shared, background understandings of how the patent system is supposed to work.<sup>32</sup> Courts deployed a substantial amount of policy reasoning in arriving at their decisions. They accepted an important role in the development of patent law. Some of the resulting decisions heavily glossed the statutory text, and some can only be described as having departed from the statutory text.

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<sup>28</sup> *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972).

<sup>29</sup> *Id.* at 67-72.

<sup>30</sup> Robert P. Merges, *As Many as Six Impossible Patents Before Breakfast: Property Rights for Business Concepts and Patent System Reform*, 14 BERKELEY TECH. L.J. 577, 585 (1999); see also Peter S. Menell, *Forty Years of Wondering in the Wilderness and No Closer to the Promised Land: Bilski's Superficial Textualism and the Missed Opportunity to Ground Patent Law Interpretation and Return Patent Law to Its Technology Mooring*, STAN. L. REV. (forthcoming 2011) (manuscript at \*5-9) (available on SSRN); John R. Thomas, *The Patenting of the Liberal Professions*, 40 B.C. L. REV. 1139, 1145-47 (1999). (Professor Menell's article, which concerns a topic similar to that of this essay, was posted on SSRN in December 2010, after this essay was presented at the Brooklyn Law School symposium in November 2010.)

<sup>31</sup> *Bilski v. Kappos*, 130 S. Ct. 3218, 3246 (2010) (Stevens, J., dissenting).

<sup>32</sup> Menell, *supra* note 30, at \*20-21.

*B. Business Method Patents and Naïve Textualism*

Notwithstanding the long tradition of rich judicial involvement in patent law, the Supreme Court recently applied quite different interpretive methods with respect to the patent statute, and particularly with regard to the question of whether business methods are patentable subject matter. The issue became prominent after 1998, when the Federal Circuit, departing from tradition, declared that there was no “business method” exception to patentability.<sup>33</sup> The Federal Circuit’s ruling led to a decade of uncertainty, during which inventors claimed, somewhat absurdly, to have invented everything from arbitration<sup>34</sup> to hedging.<sup>35</sup>

*Bilski v. Kappos* arose when an inventor sought a patent on a method of hedging against certain business risks.<sup>36</sup> When the case reached the Supreme Court, the Court, speaking through Justice Kennedy, produced an opinion notably different from those described in the previous section. Gone were the appeals to policy and background understandings of the patent system. In their place was brisk, textualist reasoning.

Patent law, the Court declared, is subject to the usual rule that, “[u]nless otherwise defined, words will be interpreted as taking their ordinary, contemporary, common meaning.”<sup>37</sup> In place of policy analysis, the Court deployed “dictionary definitions” and “common usage.”<sup>38</sup> The Court recognized that the long-standing exception for “laws of nature, physical phenomena, and abstract ideas”<sup>39</sup> deviates from the dictionary definitions of words in the Patent Act. But the Court denied that “the existence of these well-established exceptions gives the Judiciary *carte blanche* to impose other limitations that are inconsistent with the text and the statute’s purpose and design.”<sup>40</sup>

With specific regard to the question of whether the term “process” can encompass business methods, the Court’s

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<sup>33</sup> *State St. Bank & Trust Co. v. Signature Fin. Grp., Inc.*, 149 F.3d 1368, 1375 (Fed. Cir. 1998).

<sup>34</sup> *In re Comiskey*, 554 F.3d 967, 970 (Fed. Cir. 2009).

<sup>35</sup> *Bilski*, 130 S. Ct. at 3223.

<sup>36</sup> *See id.* at 3223-24.

<sup>37</sup> *Id.* at 3226 (alteration in original) (quoting *Diamond v. Diehr*, 450 U.S. 175, 182 (1981) (quoting *Perrin v. United States*, 444 U.S. 37, 42 (1979))) (internal quotation marks omitted).

<sup>38</sup> *Id.*

<sup>39</sup> *Id.*

<sup>40</sup> *Id.*

analysis was starkly textual.<sup>41</sup> Looking to a 1954 dictionary, the Court quoted the definition of “method” (part of the statutory definition of “process”), and observed that this definition—“[a]n orderly procedure or process . . . regular way or manner of doing anything”<sup>42</sup>—encompasses methods of doing business. The Court set aside the tradition of reading the language of the Patent Act in light of history and background understandings; it simply relied on the dictionary.

The Court buttressed its dictionary analysis with just one other observation—an appeal to the canonical “rule against redundancy.” The Court observed that section 273 of the Patent Act provides a special, limited defense to claims based on business method patents.<sup>43</sup> Such a defense, the Court observed, would be superfluous if there were no such thing as business method patents in the first place.<sup>44</sup> Although the Court acknowledged that section 273 was a later addition to the Patent Act (it was enacted only after the Federal Circuit’s 1998 decision approving business method patents),<sup>45</sup> it said that the rule against redundancy “cannot be overcome by judicial speculation as to the subjective intent of various legislators in enacting the subsequent provision.”<sup>46</sup>

And that was that. Justice Kennedy’s opinion went on to invoke some policy reasoning; he explained that tests for patentable subject matter had to respect the needs of the information age.<sup>47</sup> But these policy observations were not part of the opinion of the Court. They were segregated into sections of Justice Kennedy’s opinion that received four votes only; Justice Scalia declined to join them.<sup>48</sup> Thus, the opinion of the Supreme Court was a textualist opinion that relied exclusively on a dictionary definition and a canon of construction to decide an extremely important question of patent law.

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<sup>41</sup> Menell, *supra* note 30, at \*11-12 (noting that the Court “collapsed the rich historical development of patentable subject matter doctrine into three amorphous, static, and ill-defined exceptions”).

<sup>42</sup> *Bilski*, 130 S. Ct. at 3228 (alteration in original) (quoting WEBSTER’S NEW INTERNATIONAL DICTIONARY 1548 (2d ed. 1954)) (internal quotation marks omitted).

<sup>43</sup> *Id.*; see also 35 U.S.C. § 273 (2006).

<sup>44</sup> *Bilski*, 130 S. Ct. at 3228-29.

<sup>45</sup> *Id.*; see also *id.* at 3250 (Stevens, J., concurring in judgment).

<sup>46</sup> *Id.* at 3229 (opinion of the Court).

<sup>47</sup> *Id.* at 3227.

<sup>48</sup> See *id.* at 3223 n.\*.

## II. THE DANGERS OF NAÏVE TEXTUALISM

*Bilski* illustrates the dangers of naïve textualism. To answer the question posed by this symposium, *Bilski* permits statutory language to do too much work. The interpretive regime of *Bilski* can be criticized in at least three ways. First, it seems unfair to apply naïve textualism to a statute passed in a former era, when courts applied quite different interpretive methods. Second, even at its best, naïve textualism will result in too many issues being decided by fortuitous language choices by a legislature that did not foresee the decisions it was making. And finally, at its worst, naïve textualism will serve as a disingenuous cover for judicial choices made on extratextual grounds.

### A. *The Bait and Switch of Bilski's Naïve Textualism*

In *Bilski*, the Supreme Court applied modern-day textualism to a statute from a former era. Congress has not comprehensively revised the Patent Act since 1952.<sup>49</sup> At the time Congress was writing the 1952 revisions, it had every reason to expect that its handiwork would not be interpreted purely textually.<sup>50</sup> The courts had spent more than a century sensitively applying (and interstitially making) patent law and imbuing the statutory text with the spirit of widely shared background understandings of the patent system.

Congress would likely have expected courts to continue these practices. The statute's authors would have expected that they could trust the courts to exercise sound discretion in implementing the patent system. It seems unfair for courts to surprise Congress by changing the interpretive rules after a statute is enacted. If an analysis of *Bilski's* naïve textualism suggests nothing else, it at least suggests that courts should interpret a statute using the interpretive techniques that were prevalent when the statute was adopted, lest Congress be unfairly surprised.

It is, after all, standard dogma that courts should consider a statute's enactment date in determining the meaning of individual words in it: courts look to the words' "ordinary, contemporary, common meaning."<sup>51</sup> That is why the

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<sup>49</sup> Act of July 19, 1952, ch. 950, 66 Stat. 792 (codified as amended at 35 U.S.C. §§ 1-376 (2006)).

<sup>50</sup> See *supra* Part I.A.

<sup>51</sup> *Perrin v. United States*, 444 U.S. 37, 42 (1979) (emphasis added).

Supreme Court consulted a 1954 dictionary to determine the meaning of terms in the 1952 statute. But meaning does not reside solely in the definitions given to individual words. It is also a product of context and interpretive approach. If it is sound practice not to read modern definitions of individual words into a statute passed in a previous era, then it should be sound not to read modern interpretive techniques into the statute either.

Of course, it will not always be easy to say what the interpretive regime was at a given point in history. The courts make many pronouncements on interpretive methodology and are not particularly consistent about it.<sup>52</sup> But it seems clear that interpretive methods prevailing in 1952 were not nearly as textualist as the methods applied by the Supreme Court in *Bilski*. Congress could reasonably claim unfair surprise at the Court's reading modern-day textualism back into history.

#### B. *Language Doing Too Much Work*

Even setting aside the problem of applying a modern interpretive approach to a statute passed in a different era, the difficulty with naïve textualism is that it makes language do too much work. The result is that fortuitous language choices—what Larry Solan calls “linguistic accidents”<sup>53</sup>—made without foreknowledge of issues that would later arise, end up controlling questions of great moment. Extraordinary weight is being placed on Congress's choice of the words “process” and “method.”

The scope of patentable subject matter is vital to the patent system. It is difficult to come up with a precise definition of patentable subject matter, in part because the very purpose of the patent system is to encourage the development of new and unforeseen things.<sup>54</sup> It is almost inevitable, therefore, that the statutory language that defines the scope of patentable subject matter will never perfectly capture the universe of inventions that should be patentable. The patent laws require sensitive construction by judges who are knowledgeable in the full context of the patent system. If,

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<sup>52</sup> See Jonathan R. Siegel, *The Polymorphic Principle and the Judicial Role in Statutory Interpretation*, 84 TEX. L. REV. 339, 385-89 (2005).

<sup>53</sup> Lawrence M. Solan, *Statutory Interpretation, Morality, and the Text*, 76 BROOK. L. REV. 1033 (2011).

<sup>54</sup> *Diamond v. Chakrabarty*, 447 U.S. 303, 315-16 (1980).

instead, the courts “make a fortress out of the dictionary,”<sup>55</sup> they will doom legislatures to producing statutes with unintended consequences that depart from widely shared understandings of how the system is supposed to work.

To give the textualists their due, they are surely aware of this point, and they have an answer to it. A textualist would say that if a statute’s language is not used to answer whatever questions arise under it, even questions that were unanticipated at the time the language was written, the alternative is for judges to answer the questions, and that alternative gives judges too much power. Judges are not supposed to make policy decisions in a democratic society; they are supposed to implement the policy decisions laid down by the legislature. By abandoning efforts to imbue statutes with the spirit of policies and background understandings, courts confine themselves to their proper role. If that means that some questions get unanticipated answers, that is the price we pay for preventing judges from exercising too much power.

The riposte to this argument, however, is that glossing or even departing from statutory text need not mean that the judges are implementing their own policies. In appropriate cases glossing or departing from statutory text is precisely what is needed to implement the legislature’s policies. The trick, of course, is for judges to discern those unusual occasions that warrant something other than straightforward application of statutory text. Background principles play a critical role in this process. When the result of simply running statutory language through the dictionary is a startling departure from widely shared background understandings of how the system is supposed to work, it may be a clue to the court that indicates that something other than a purely textual construction of the statute is appropriate.<sup>56</sup> Judges should certainly not depart from statutory language at will, but neither should they make statutory language do all the work.

### C. *Language as a Cover for Judicial Decision Making*

Moreover, the argument that judges ought to answer questions based solely on statutory language, lest they exercise too much policy-making power, is based on a highly

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<sup>55</sup> See *Cabell v. Markham*, 148 F.2d 737, 739 (2d Cir. 1945) (L. Hand, J.).

<sup>56</sup> Siegel, *supra* note 52, at 373-74.

questionable assumption—namely, that courts really can set aside all other influences and decide questions based solely on the statutory text. In fact, this seems unlikely. There is too much indeterminacy in statutory text. Even courts that purport to be abdicating any policy-making role and following the rule laid down in the text may be making an interpretive choice—as can be seen in *Bilski*.

In *Bilski*, the Court relied on a standard canon of statutory construction, the rule against redundancy.<sup>57</sup> The Court noted (rightly enough) that the recently added section 273 of the Patent Act, which provides a limited defense to suits based on business method patents, would be redundant if business method patents could never exist. From a textualist perspective, this is a strong argument.

The flaw in the argument, however, is that courts must make a choice regarding whether to follow the rule against redundancy. Sometimes courts set aside the rule on the ground that a legislature occasionally writes redundant statutory text as a precaution. Indeed, just two years before *Bilski*, in *Ali v. Federal Bureau of Prisons*,<sup>58</sup> the Supreme Court interpreted the Federal Tort Claims Act in a way that arguably rendered some words in the statutory text superfluous.<sup>59</sup> The Court justified its ruling by asserting that Congress might have inserted the superfluous language “to remove any doubt.”<sup>60</sup> Chief Justice Roberts and Justices Thomas, Scalia, and Alito, all part of the *Bilski* majority, joined this opinion.<sup>61</sup>

Two years later, in *Bilski*, the Court flatly asserted that the rule against redundancy “cannot be overcome by judicial speculation as to the subjective intent of legislators.”<sup>62</sup> Obviously, this assertion is at best overstated and at worst

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<sup>57</sup> See *supra* Part I.B.

<sup>58</sup> 552 U.S. 214 (2008).

<sup>59</sup> See *id.* at 237 (Kennedy, J., dissenting) (complaining that the Court’s reading rendered part of the text “mere surplusage” in violation of the rule against redundancy).

<sup>60</sup> *Id.* at 226 (majority opinion).

<sup>61</sup> The Court similarly rejected application of the rule against redundancy on the ground that the legislature might have inserted apparently superfluous language to avoid risk of doubt in *Landgraf v. USI Film Products*, 511 U.S. 244, 260 (1994), although in that case the more textualist justices joined a separate concurrence. See also *Chickasaw Nation v. United States*, 534 U.S. 84, 94 (2001) (holding that a court may reject words as “surplusage” if they are “inadvertently inserted or . . . repugnant to the rest of the statute”) (quoting KARL LLEWELLYN, *THE COMMON LAW TRADITION* 525 (1980)).

<sup>62</sup> *Bilski v. Kappos*, 130 S. Ct. 3218, 3229 (2010).

disingenuous. The Court *has* overcome the rule against redundancy through judicial speculation about the subjective intent of legislators. Indeed, the speculation in *Ali* was more aggressive than would have been the necessary speculation in *Bilski*. In *Ali* there was no particular evidence to suggest that Congress had acted out of the caution that the Court attributed to it, whereas in *Bilski* there was powerful evidence of the motives behind the potentially redundant provision. Congress inserted the statutory defense to actions based on business method patents only after the Federal Circuit ruled that such patents could be lawful. It seems quite plausible that Congress was not trying to ratify the Federal Circuit's decision, but to limit any fallout that would ensue if that decision were ultimately to stand.<sup>63</sup>

Something other than statutory language, therefore, told the Supreme Court that it could overcome the rule against redundancy in *Ali*, but not in *Bilski*.<sup>64</sup> The judges made a choice. Even within textualism, the rules of statutory interpretation are not perfectly constraining. The canons of construction are only guides.<sup>65</sup> It is wrong to pretend that the courts cannot overcome canons of statutory interpretation when they can and do.

Justice Scalia has accused those who rely on legislative history of using it merely as “an omnipresent makeweight for decisions arrived at on other grounds.”<sup>66</sup> Naïve textualism uses text in the same way. It is bad enough to make language do all the work. It is even worse to pretend that language has done all the work, when other factors must have guided a court's understanding of that language.

## CONCLUSION

The Supreme Court did not reach an inappropriate result in *Bilski*—all nine justices agreed that the claimed

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<sup>63</sup> Of course, rather than insert a limited defense to business method patents, Congress could have clarified that such patents should never be granted. But it might have lacked the votes to settle the ultimate question of the validity of business method patents, while having the votes for the limited defense.

<sup>64</sup> See also Menell, *supra* note 30, at \*14-15 (noting that the Court's choice to apply the canonical rule against redundancy in *Bilski* was in tension with the equally canonical principle that repeals by implication are not favored).

<sup>65</sup> E.g., *Chickasaw Nation*, 534 U.S. at 94.

<sup>66</sup> *Thunder Basin Coal Co. v. Reich*, 510 U.S. 200, 219 (1994) (Scalia, J., concurring in part and concurring in the judgment).

invention was not patentable. But the Court displayed an unfortunately naïve interpretive attitude. Setting aside the centuries-old tradition of imbuing the text of the patent statutes with a rich awareness of the history, policy, and background understandings of the patent system, the Court imagined, or at least pretended to imagine, that it could interpret the Patent Act with no more tools than the dictionary and the canons of construction.

Such naïve textualism, if generally applied, would make the legislature's job, and ultimately the task of governing, even harder than it already is. The legislature cannot foresee everything as it writes statutes. Judges must exercise judgment in the process of statutory interpretation. Language cannot do all the work.