Fall 2006

Rules for Radicals: A Politics of Patent Law

Kali Murray
Marquette University Law School, kali.murray@marquette.edu

Publication Information
Kali N. Murray, Rules for Radicals: A Politics of Patent Law, 14 J. Intell. Prop. L. 63 (2006).

RULES FOR RADICALS: A POLITICS OF PATENT LAW

*Kali N. Murray**

TABLE OF CONTENTS

---

* Assistant Professor of Law, University of Mississippi School of Law. I would like to dedicate this Article to my grandparents, Rosa and Donald Murray and Louise and George Rice, for all that they gave me. I thank the Lamar Order for providing summer research grants to support this project. I thank the 5th Annual Intellectual Property Scholars Conference and the University of Mississippi Faculty Workshop for allowing me to present early drafts of this work. I also thank my colleagues Jack Nowlin, Matthew Hall, Jacqueline Serrao, and Lisa Roy for their helpful comments. Valuable research assistance was provided by Meaghin Burke, Latoya Tate, Clyde McGee, J.D. Johnson, Shalon Love, and Loren Henagan.

Using environmental law as a comparative model, this Article contends that patent law needs to embrace a functional "politics," which would allow diverse constituencies to participate substantively in the process of formulating policies and resolving claims disputes. Three key mechanisms—expanded standing, citizen suits, and transparency—that allow environmental law to maintain a robust participation of diverse constituencies, are absent from patent law. While this can be explained by patent law's over-reliance on a bilateral patent bargain, a reinvigorated patent bargain must see the opportunities for third party participation as integral. Although recent patent reform has embraced moderate changes, which would incorporate these mechanisms, any continuing reform must be cognizant of the predominant models—structural pluralism and deliberative proceduralism—so as to maintain clarity as to the nature of third party participation.

I. INTRODUCTION

Busy with the dishes, a mother glances over her shoulder at a child in a high chair playing with Cheerios®.[1] The child carefully selects each Cheerio and throws it on the floor, thus enacting a rather common scene of early childhood. Experts have theorized that this "play" is a key stage of early childhood development where children use concrete objects, such as food or building blocks, to learn perception behavior reasoning.[2] These concrete objects are generally termed "manipulatives." In the early 1990s, an emerging children's

---

[1] As an associate at a large firm from 1999 to 2004, I worked on matters associated with this subject matter. All information related to this subject matter is derived from generally known information. To ensure compliance with any relevant ethical duties, all initial searches as to this related subject matter were conducted in public databases and undertaken by independent researchers with no prior knowledge of any related subject matter.

[2] Jean Piaget, a Swiss biologist and noted theorist of early childhood development, argued that

> children do not just passively observe and remember the things they see and hear. Instead, they are naturally curious about their world and actively seek out information to help them understand and make sense of it. They continually experiment with the objects they encounter, manipulating things and observing the effects of their actions. For example, we think back (without much nostalgia) to the days when our children were in high chairs, experimenting with picking up, squishing, pushing, rolling, dropping, and throwing their food as readily they might eat it.

TERESA M. MCDEVITT & JEANNE ELLIS ORMROD, CHILD DEVELOPMENT AND EDUCATION 111 (1st ed. 2002); *see also* JEFFREY TRAWICK-SMITH, EARLY CHILDHOOD DEVELOPMENT: A MULTICULTURAL PERSPECTIVE 231 (2d ed. 2000) ("Because pre-schoolers' thinking is still based so much on perception and action, learning at this age requires an environment that is rich in sensory experience and provides much activity with objects. Through active manipulation of play materials, preschoolers gradually construct an understanding of the world.").

literature market employed this theory to create a new product: the interactive children's book.[3] Interactive children's books sought to ensure that children would use manipulatives to comprehend narrative in their early years. The exploding market of interactive books was coupled with another development: the direct marketing of consumer products like candies, cereals, and other food items to young children so as to lock in their consumer preferences at an early age.

Seeking to maximize on both of these trends, in April 1995, an early childhood specialist named Deborah D'Andrea[4] sought to patent a method of preparing a book entitled "Book Including Candy As Part of the Pages."[5] The patent application described an invention that encouraged the reader to secure accompanying candy to the individual pages of the book, thereby completing the depicted picture.[6] Patent number 5,573,438 ('438 Patent) was issued on November 12, 1996.[7] After issuance, Ms. D'Andrea began to pursue a series of license agreements with various companies to sell products such as REESE'S PIECES®, Jelly Belly Beans®, Goelitz® Gummies, and Necco® Candy Buttons.[8] However, by 1998, Ms. D'Andrea faced significant competition. Simon & Schuster, Inc., a major publisher in the children's literature market, introduced a competing series of books known as the Cheerios Play Book Series.[9] Unlike Ms. D'Andrea's patented products, the successful Cheerios Play Book Series used cereal as the primary food object, thus satisfying parental concerns about nutrition. In response, Ms. D'Andrea filed a reissue application in October 1998.[10] Her reissue application claimed that she had not drafted her claims

---

[3] The market for interactive books exploded in the early 1990s. *See, e.g.*, LISA ROJANY BUCCIERI, WRITING CHILDREN'S BOOKS FOR DUMMIES 26–27 (2005) ("A *novelty book* is one that goes beyond just words and pictures on flat pages. It is often three-dimensional and always *interactive* (interactive here meaning that the child must engage more than just his eyes in the experience). From pop-ups to pull-tabs, from juggling balls to paper dolls, innovative novelty books can really engage the imagination.").

[4] A former educational specialist, Ms. D'Andrea owns a small publishing company called Playhouse Publishing Company, located in Akron, Ohio. *Playhouse Publishing Exhibits Creativity and Courage*, INDEPENDENT PUBLISHER, http://www.independentpublisher.com (search "Article Archives" for "playhouse") (last visited Oct. 27, 2006).

[5] U.S. Patent No. 5,573,438 (filed Apr. 25, 1995) (issued Nov. 12, 1996).

[6] *Id.* at col.1, l.50–45.

[7] *Id.* at 1.

[8] *See* Playing By The Book, VA. TECH. MAG. (2004), *available at* http://www.vt.magazine.vt.edu/spring04/shorts.html (scroll down to "Playing By the Book").

[9] The Cheerios Play Book series includes several different books. *See generally* LEE WADE, CHEERIOS EL LIBRO DE JUGAR (2000); LEE WADE, THE CHEERIOS ANIMAL PLAY BOOK (1999); LEE WADE, THE CHEERIOS CHRISTMAS PLAY BOOK (2000); LEE WADE, THE CHEERIOS HALLOWEEN PLAY BOOK (2001); LEE WADE, THE CHEERIOS PLAY BOOK (1998).

[10] U.S. Reissue Patent No. 37,362 (filed Oct. 22, 1998) (issued Sept. 11, 2001).

broadly enough to include those items separately obtained by the reader (as opposed to her initial application, which claimed only those items attached to the book by a separate substrate).[11] Ms. D'Andrea also contacted Simon & Schuster in 1999, claiming that the Cheerios Play Book Series violated the claims of the '438 Patent; she was rebuffed.[12] After a five-year examination period, the PTO reissued a revised patent on September 11, 2001.[13] The same day, Ms. D'Andrea sued a number of companies, including General Mills, Inc., Kellogg, Inc., M&M Mars, Inc., Simon & Schuster, Inc., HarperCollins Publishing, Inc., and Charlesbridge Publishing, Inc., who she claimed violated the newly broadened claims of the reissued patents.[14] Later, in June 2002, the relevant parties settled their claims quietly, and we presume, amicably.[15]

So, why do I tell this story? Ms. D'Andrea's patents are not "important" patents in the larger sense. Her patents are not for pharmaceutical compounds or genes; they are rather minor patents so far as it goes; indeed, the major parties have already moved on to sell other types of products. The Cheerios® food fight is worth examining because it reveals two trends that have driven recent debates over intellectual property, including patent law. First, there has been an increasing "propertization" of subject areas not commonly associated with the core subjects protected by the relevant legal regime.[16] Second, as such propertization occurs, the relevant products have become sensitive to a process that can be described as multiplicity, which refers to the ability of multiple users to put any given intellectual property resource to different uses. The interactive books are a good example of these trends. First, an interactive book is not an engine machine. Ms. D'Andrea and others' patenting of interactive books[17] took a relatively unknown

---

[11] Within two years of the issuing of a patent, a patent applicant may seek what is termed a reissue patent if the patentee claimed either more or less than what was disclosed in the initial patent application. 35 U.S.C. § 251 (2000).

[12] Susan Decker, *General Mills, M&M Mars Sued Over "Nibble Me Books,"* BLOOMBERG NEWS, Sept. 20, 2001.

[13] '362 Patent.

[14] *Akron Publisher Settles Tasty Lawsuit*, PLAIN DEALER, June 14, 2002, at C1.

[15] *Id.*

[16] I am using the term "propertization" to refer to, among other things, the process of an object being claimed as a property. Margaret Jane Radin has contended that the term "propertization" refers to the evolutionary and contested nature by which property rights are acquired and enforced. *See* Margaret Jane Radin, *A Comment on Information Propertization and Its Legal Milieu*, 54 CLEV. ST. L. REV. 23–24 (2006). Within the context of intellectual property, Radin has stressed that within the realm of "information propertization" interested constituencies have seen the benefit of overprotecting informational property at the expense of a robust public domain. *Id.*

[17] From 1995 onwards, at least nine patents or patent applications were sought on interactive books. *See* Educational Systems and Methods Utilizing Edible Body Parts and Associated Information Cards, U.S. Patent App. No. 0,213,877 (filed Mar. 24, 2003) (disclosing a method of informing individuals about the human body through the copious use of edible chocolate parts

academic theory—Piaget's theory of manipulatives—and claimed a property right that could implicate the preexisting rights of many users. These claims contribute to a rapidly diminishing public domain, a subject that has been the subject of an extensive academic debate.[18] Second, the interactive books assumed a different meaning within the political culture as examples of the ongoing commercial effort to market to children.[19] In a sense, these books are like images superimposed on

---

attached to instructional cards); U.S. Patent No. 6,764,372 (filed Jan. 29, 2003) (disclosing a book where the reader could place an attached marionette figure through each page of the book); Talking Phonics Interactive Learning Device, EPO Patent 0,746,832 (filed Mar. 2, 1995) (relating to interactive learning devices that had electronic circuitry triggered by the touch of the reader); Book with Storage for Manipulatives, U.S. Patent No. 6,247,729 (filed Feb. 11, 2000) (disclosing a book with a storage tube for manipulatives for used enjoyment of a book); U.S. Patent No. 6,234,534 B1 (filed Jan. 31, 2000) (disclosing a book with an elongated sliding toy attached to the back of the book); Book-Toy Combination, EPO Patent App. 0,832,673 (filed Sept. 29, 1997) (disclosing a book with a toy character attached to the back of the book that could be manipulated by a child reader); Interactive Book Assembly, U.S. Patent No. 5,951,298 (filed Apr. 10, 1997) (disclosing a coordinated set of instructional materials designed to be used by a parent and child with activities for developing a child's skills involving indicia contained in the text of the book); Interactive Story Book Using Stickers and a Method of Teaching, U.S. Patent No. 5,447,439 (filed on July 9, 1993) (describing a story book assembly and method of teaching where the reader used stickers to complete a picture partially disclosed by a previous image); Personalized Interactive Storybook and Method of Teaching a Reader a Desired Behavioral Pattern, U.S. Patent No. 5,387,107 (filed Aug. 23, 1993) (disclosing a storybook with an illustration that could be personalized by the reader).

[18] The extensive debate over the public domain has traditionally appeared in oppositional terms: the public domain versus the encroaching demands of the property ownership. *See* Yochai Benkler, *Free as the Air to Common Use: First Amendment Constraints on Enclosure of the Public Domain*, 74 N.Y.U. L. REV. 354, 363 (1999) ("The core difference between the public domain and the enclosed domain is that anyone is privileged to use information in ways that are in the public domain, and absent individualized reasons, government will not prevent those uses. The opposite is true of the enclosed domain. There, government will prevent all uses of information unless there is an individualized reason not to prevent a particular use."). Recently, a number of theorists have argued that resolving these disputes solely in favor of the public domain creates distributional issues. Anupam Chander & Madhavi Sunder, *The Romance of the Public Domain*, 92 CAL. L. REV. 1331, 1335 (2004); *see also* PETER DRAHOS WITH JOHN BRAITHWAITE, INFORMATION FEUDALISM: WHO OWNS THE KNOWLEDGE ECONOMY? 98 (2003) ("Our contention . . . is that information feudalism is an evocative way of describing the contemporary institutional push to redistribute property rights unequally.").

[19] *See, e.g.*, Susan E. Linn, *Sellouts*, THE AMERICAN PROSPECT, Oct. 23, 2000, at 17 ("What makes such ubiquity all the more disturbing is that children—especially young children—are even more vulnerable to advertising than adults. Advertisers today know that preschoolers have trouble differentiating between commercials and regular programming (and now that Simon & Schuster and other reputable publishing houses market books to babies like *The Cheerios Play Book* or *Sun Maid Raisins Play Book*, they're going to have even more trouble.)."); British Broadcasting Company, *Concern Over Food Child Marketing*, BBC NEWS UK EDITION, Apr. 26, 2005, http://news.bbc.co.uk/1/hi/health/4486923.shtm (detailing criticisms of the use of *Cheerios Play Book* to advertise Cheerios to small children); Press Release, The Food Commission, Children Encouraged to Advertise Food

each other. One image is of an ordinary book used by a mother to read to her child; the second is of a marketing campaign that seeks to reinforce certain uses of products.

These two trends are not mutually exclusive ones. Intellectual property owners assert a stronger property right to combat the efforts of potential creative competitors or multiple end users to use the disputed intellectual property. Each of these trends has created interested constituencies that have begun to contest the claims of owners who could once have easily relied on quiet acquiescence to their ownership rights. The rise of organized constituencies highlights an essential development that has resulted from these two debates: a politics of intellectual property. James Boyle, analogizing this development to the environmental movement has argued that a "politics," which he roughly defines as "a conceptual map of issues, a rough working model of costs and benefits, and a functioning coalition-politics of groups unified by common interest perceived in apparently diverse situations," is apparent within the context of intellectual property.[20] Such a politics, as defined by Boyle, has been typically associated with the field of copyright.[21] However, two key debates—the furor over the impact of the patent regimes on developing nations combating the widespread outbreak of AIDS[22] and the controversy over the use of indigenous people's products by

---

To Themselves (Apr. 27, 2005), *available at* http://www.foodcomm.org.uk/press_05_advertising._htm; *World view: Marketing News and Other Sick Stuff*, 17 STAY FREE, http://www.stayfreemagazine.org/archives/17/worldview.html ("Baby books are now made to resemble Pepperidge Farm Goldfish, M&Ms, Sun-Maid Raisins, Hershey's Kisses and other snacks. Some of the books—a joint effort between food companies and publishers—suggest kids sort, place, and count using the product.").

[20] James Boyle, *A Politics of Intellectual Property: Environmentalism For The Net?*, 47 DUKE L.J. 87, 89 (1997).

[21] *Id.*

[22] *See generally* James Thuo Gathii, *The Structural Power of Strong Pharmaceutical Patent Protection in U.S. Foreign Policy*, 7 J. GENDER RACE & JUST. 267, 268 (2003) (arguing that extensive humanitarian efforts in U.S. foreign policy results from attempts to legitimize its reliance on strong intellectual property rights that interfere with developing nations' access to medical products); Rishi Gupta, *TRIPS Compliance: Dealing with the Consequences of Drug Patents in India*, 26 HOUS. J. INT'L L. 599, 605 (2004) (analyzing the impact ongoing compliance with TRIPS will have on India's pharmaceutical industries); Ellen 't Hoen, *TRIPS, Pharmaceutical Patents, and Access to Essential Medicines: A Long Way From Seattle to Doha*, 3 CHI. J. INT'L L. 27, 27–28 (2002) (summarizing the history of the debates surrounding barriers to drug access experienced by developing nations under an international intellectual property regime); Bryan C. Mercurio, *TRIPs, Patents, and Access to Life-Saving Drugs in the Developing World*, 8 MARQ. INTELL. PROP. L. REV. 211, 212–14 (2004) (examining the impact of Paragraph 6 of the Doha Declaration on developing nations' access to compulsory licenses); Michael R. Taylor & Jerry Cayford, *American Patent Policy, Biotechnology, and African Agriculture: The Case for Policy Change*, 17 HARV. J.L. & TECH. 321, 323 (2004) (analyzing the impact of the international intellectual property regime on African agriculture); Anthony P. Valach, Jr., *TRIPS: Protecting the Rights of Patent Holders and Addressing Public Health Issues in Developing Countries*, 4 CHI.-KENT J. INTELL. PROP. 156

major corporations[23]—has brought a functioning politics to patent law. Moreover, Congress has repeatedly undertaken efforts to overhaul patent law, partly in response to four major reports on its current state.[24]

Boyle's insight, however, does not fully explore what makes such a politics of patent law possible: namely, an institutional design of the law that accords these constituencies a full voice through key participatory mechanisms such as expanding standing for organizational interests or the availability of citizen suits. The use of these mechanisms reflects a key aspect of environmental law: the relative ease with which it includes different constituencies in its decisionmaking process. Perhaps, due to its initial origins in the political movements of the 1960s and 1970s, environmental law has reflected the shift, more than any other legal field, from what Richard Stewart has termed a bipolar administrative model, where the agency essentially seeks to protect "recognized liberty and property

---

(2005) (analyzing the impact of TRIPS provisions on the efforts of developing nations to access medical products).

[23] *See generally* Erik B. Bluemel, *Substance Without Process: Analyzing TRIPS Participatory Guarantees in Light of Protected Indigenous Rights*, 86 J. PAT. & TRADEMARK OFF. SOC'Y 671 (2004) (analyzing international guarantees of participation within the context of plant genetic resources); Shubha Ghosh, *Traditional Knowledge, Patents, and the New Mercantilism* (Part II), 85 J. PAT. & TRADEMARK OFF. SOC'Y 885 (2003) (analyzing the issue of traditional knowledge within the context of strategic intellectual property rights); Paul Kuruk, *Protecting Folklore Under Modern Intellectual Property Regimes: A Reappraisal of the Tensions Between Individual and Communal Rights in Africa and the United States*, 48 AM. U. L. REV. 769, 775–76 (1999) (analyzing the adequacy of current legal frameworks for protecting African folklore and proposing a *sui generis* system of intellectual property rights to protect indigenous folklore); Symposium, *Traditional Knowledge, Intellectual Property, and Indigenous Culture*, 11 CARDOZO J. INT'L & COMP. L. 239 (2003) (symposium issue on indigenous claims to intellectual property resources); John L. Trotti, *Compensation Versus Colonization: A Common Heritage Approach to the Use of Indigenous Medicine in Developing Western Pharmaceuticals*, 56 FOOD & DRUG L.J. 367 (2001) (advocating that a Common Heritage of Mankind regime could compensate indigenous peoples for use of their medicinal knowledge); Michael Woods, *Food For Thought: The Biopiracy of Jasmine and Basmati Rice*, 13 ALB. L.J. SCI. & TECH. 123 (2002) (analyzing the inadequacies of TRIPS as to indigenous rights utilizing the controversy over the biopiracy of jasmine and basmati rice).

[24] *See* AMERICAN INTELLECTUAL PROPERTY ASSOCIATION, AIPLA RESPONSE TO THE NATIONAL ACADEMIES REPORT ENTITLED "A PATENT SYSTEM FOR THE 21ST CENTURY" (2004), *available at* http://www.aipla.org/Content/ContentGroups/Issues_and_Advocacy/Comments2/Patent_and_Trademark_Office/2004/NAS092304.pdf; AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION, AIPLA RESPONSE TO THE OCTOBER 2003 FEDERAL TRADE COMMISSION REPORT: "TO PROMOTE INNOVATION: THE PROPER BALANCE OF COMPETITION AND PATENT LAW AND POLICY" (2004), *available at* http://www.aipla.org/Content/ContentGroups/Issues_and_Advocacy/Comments2/Patent_and_Trademark_Office/2004/ResponseToFTC.pdf; Committee on Intellectual Prop. Rights in the Knowledge-Based Economy, Nat'l Research Council, A Patent System For the 21st Century (Stephen A. Merrill et al. eds., 2004), *available at* http://stills.nap.edu/catalog/10976.html; FED. TRADE COMM'N, TO PROMOTE INNOVATION: THE PROPER BALANCE OF COMPETITION AND PATENT LAW AND POLICY (2003), *available at* http://www.ftc.gov/os/2003/10/innovationrpt.pdf.

interests" to a multipolar administrative model that serves as a "surrogate political process to ensure the fair representation of a wide range of affected interests in the process of administrative decision."[25] Thus, environmental law offers important lessons for patent law on how to balance the demands of multiple constituencies against the potential property interests of the patent owner. Beyond these administrative concerns, environmental and patent law share some key similarities. Both patent and environmental law are areas where agency decisionmakers have to confront considerable scientific uncertainty in assessing desired outcomes. Moreover, both environmental law and patent law must confront how to balance public demands of access to scarce resources. Environmental law, however, is characterized by substantial contributions by third parties in crafting policy.

I have adopted the title of this Article from Saul Alinsky's famous book, *Rules For Radicals: A Pragmatic Primer for Realistic Radicals*, which has served as one of the preeminent books about organizing disenfranchised communities to assert political power.[26] While our ultimate "rules" may differ, I start in a similar spirit with the premise that "citizen participation is the animating spirit and force in a society predicated on voluntarism."[27] Although other rules are possible here,[28] I argue that any institutional design of patent law must follow one key rule: diverse constituencies must be allowed to participate in the outcomes associated with patent decisionmaking. By allowing a range of third parties—competitors, public interest organizations and even unaffiliated citizens—to participate in assessing patents, these parties may be less likely to initiate later, more expensive challenges to patents. Moreover, the entire patent administrative regime may acquire more

---

[25] Richard B. Stewart, *The Reformation of American Administrative Law*, 88 HARV. L. REV. 1669, 1670 (1975). For a review of recent literature on different type of paradigms associated with environmental law; *see* Eileen Guana, *The Environmental Justice Misfit: Public Participation and the Paradigm Paradox*, 17 STAN. ENVTL. L.J. 3, 17–31 (1998). The bipolar model has been tested in various ways: the challenge to a singular notion of "authorship" within copyright law, the research activities of collaborative governmental and private efforts, and the growing popular recognition of collaborative elements in creative arts such as the hip-hop movement. *See, e.g.*, 35 U.S.C. §§ 200–212 (2000); *see generally* ROSEMARY J. COOMBE, THE CULTURAL LIFE OF INTELLECTUAL PROPERTIES: AUTHORSHIP, APPROPRIATION, AND THE LAW (1998); THE RZA & CHRIS NORRIS, THE WU-TANG MANUAL: ENTER THE 36 CHAMBERS, VOLUME ONE (2004).

[26] Saul D. Alinsky, RULES FOR RADICALS: A PRAGMATIC PRIMER FOR REALISTIC RADICALS xxv (1971).

[27] *Id.*

[28] A second project associated with this topic will examine the second "rule": intellectual property must also embrace substantive norms that allow for internal judicial experimentalism around public participation. This development, obviously, would mean a major shift in patent law. However, judicial experimentation as to substantive internal norms, such as the public notice function, indicates that the Federal Circuit may be becoming more sensitive to rights of multiple constituencies.

legitimacy in the eyes of relevant stakeholders and the larger public if more third parties could participate in resolving disputes over patents.

In Part I of this Article, I briefly analyze the types of mechanisms environmental law has used to structure decisionmaking and compare how patent law has failed to support access to the same types of mechanisms. I continue this inquiry in Part II of this Article, which analyzes two types of models that are available to structure third party decisionmaking: (1) a structural pluralist model, where competition between third parties is encouraged as the best mechanism for resolving policy disputes; and (2) a deliberative democratic model, which borrows theoretical insights initially advanced by Jurgen Habermas, one of the preeminent social theorists in democratic theory, who states that deliberative mechanisms are the best mechanisms for resolving policy disputes.[29] While adopting either one of these potential models will increase third party participation in patent law, I contend that any patent reform must be cognizant of the differing consequences of adopting a particular model and should, therefore, sufficiently distinguish between the two models throughout the process of reform.

II. A PARTICIPATORY TOOLBOX: PARTICIPATORY MECHANISMS IN ENVIRONMENTAL AND PATENT LAW

A politics of patent law has to follow from a design of intellectual property laws and institutions.[30] This Article focuses on those participatory mechanisms

---

[29] Hugh Baxter, *Habermas's Discourse Theory of Law and Democracy*, 50 BUFF. L. REV. 206 (2002).

[30] Erik Luna has defined "institutional design" as "the process of creating or modifying the rules and incentives of an official entity to achieve certain substantive ends, with the design process predicated on an understanding of the normative goals of a particular institution." Erik Luna, *Race, Crime, and Institutional Design*, LAW & CONTEMP. PROBS., Summer 2003 at 183, 190. Institutional design in patent law has typically focused on modifying the rules associated with a centralized judicial decisionmaker in patent law such as the U.S. Court of Appeals for the Federal Circuit, or potentially, a centralized district court decisionmaker. *See, e.g.*, Rochelle Cooper Dreyfuss, *The Federal Circuit: A Case Study in Specialized Courts*, 64 N.Y.U. L. REV. 1 (1989) (analyzing the formation of the Federal Circuit); Rochelle Cooper Dreyfuss, *The Federal Circuit: A Continuing Experiment in Specialization*, 54 CASE W. RES. L. REV. 769 (2004) (analyzing the ongoing impact of the centralized judicial mechanisms on patent law); Arit K. Rai, *Engaging Facts and Policy: A Multi-Institutional Approach to Patent System Reform*, 103 COLUM. L. REV. 1035 (2003) (analyzing the multi-institutional framework associated with the Federal Circuit); R. Polk Wagner & Lee Petherbridge, *Is the Federal Circuit Succeeding? An Empirical Assessment of Judicial Performance*, 152 U. PA. L. REV. 1104 (2004) (analyzing the empirical data on the effectiveness of the Federal Circuit).

Recently, the redesign of administrative procedures during the examination process has received scholarly attention. Such design has focused on implementing mechanisms such as expanding the type of available proceedings in a variety of ways. *See, e.g.*, Jordan K. Paradise, *Lessons From The European Union: The Need for a Post-Grant Mechanism for Third-Party Challenge to U.S. Patents*, 7 MINN. J. L. SCI. & TECH. 315, 326 (2005) (examining the recent legislative reform and its use of

that permit groups to organize and act to impact the relevant agency or judicial policy maker. For lack of a better word, I call these mechanisms "participatory" because they ensure the ability of individuals to participate substantively in the relevant decisionmaking process. This Part will first briefly examine those mechanisms used by environmental law to expand third party constituency participation. This Part will then analyze the absence of such mechanisms in patent law. The absence of such political mechanisms has affected patent law by limiting the ability of potential constituencies to challenge potential patents.

A. PARTICIPATORY MECHANISMS IN ENVIRONMENTAL LAW

Participatory mechanisms are organized around two types of actions: (1) mechanisms that increase citizen enforcement of the relevant laws; and (2) mechanisms that increase transparency so that citizens can acquire a greater range of information on a given topic. These mechanisms serve two complementary functions within the administrative state. First, these mechanisms reflect a normative desire to support and legitimize agency behavior.[31] As Sidney Shapiro states, "[a]gency legitimacy is enhanced when procedures make administrators politically accountable, ensure that agencies stay within their statutory authority, promote the rationality of agency decisions, and are perceived as fair by the public."[32] Second, these mechanisms serve a practical purpose, allowing

---

a post-grant proceeding); Joseph Farrell & Robert P. Merges, *Incentives to Challenge and Defend Patents: Why Litigation Won't Reliably Fix Patent Office Errors and Why Administrative Patent Review Might Help*, 19 BERKELEY TECH. L.J. 943, 948 (2004); Stephen G. Kunin & Anton W. Fetting, *The Metamorphosis of* Inter Partes *Reexamination*, 19 BERKELEY TECH. L.J. 971, 973 (2004) (suggesting a two-tiered post-grant patent review based on the timing of the requested review); Kristen Jakobsen Osenga, *Rethinking Reexamination Reform: Is It Time for Corrective Surgery, or Is It Time to Amputate?*, 14 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 217, 251–52 (2003) (suggesting that a patent invalidation board should be used to reexamine patents); Gerald J. Mossinghoff & Vivian S. Kuo, *Post-Grant Review of Patents: Enhancing the Quality of the Fuel of Interest*, 43 IDEA 83, 110 (2002) (positing that the availability of a post-grant review would allow academic and industrial experts to more fully participate in patent decisionmaking); Allan M. Soobert, *Breaking New Grounds in Administrative Revocation of U.S. Patents: A Proposition for Opposition—and Beyond*, 14 SANTA CLARA COMPUTER & HIGH TECH. L.J. 63, 67 (1998) (proposing an opposition system that is more flexible than current reexamination proceedings); Mark D. Janis, *Rethinking Reexamination: Toward a Viable Administrative Revocation System for U.S. Patent Law*, 11 HARV. J.L. & TECH. 1, 6–7 (1997) (analyzing existing post-examination procedures and suggesting alternatives to those actions).

[31] Jerry L. Mashaw, *Explaining Administrative Process: Normative, Positive, and Critical Stories of Legal Development*, 6 J.L. ECON. & ORG. 267, 267–98 (1990) (stating that positive political theory fails to sufficiently address normative values that legitimize administrative law).

[32] Sidney A. Shapiro, *A Delegation Theory of the APA*, 10 ADMIN. L.J. AM. U. 89, 92 (1996).

legislators to embed "fire-alarms" that serve to warn regulatory actors of potential problems in the regulatory process.[33]

1. Citizen Enforcement Mechanisms. Expanded standing claims and citizen suits are the two primary citizen enforcement mechanisms.[34] To achieve standing to bring a claim, a party must establish three constitutional requirements: (1) that the plaintiff has suffered an injury in fact; (2) that the injury can be traced to the challenged action; and (3) that the injury is redressable.[35] The Supreme Court has further determined that if the injury claimed is the result of a statutory violation, the injury must be within the "zone of interests" sought to be protected by the underlying substantive statute.[36] The zone of interest test is distinguishable from the "injury-in-fact" analysis because the "test focuses on whether Congress intended an already-injured party to be allowed to sue."[37]

Randall S. Abate and Michael J. Myers have identified three types of injury in fact recognized in environmental law.[38] *Substantive injury* includes those types of harm that exist outside any statutory violations.[39] In environmental law, liberal claims of substantive injury have generally been accepted. Beginning with *Sierra Club v. Morton*, the Supreme Court outlined a broad theory of injury in fact, which allowed a plaintiff or organization acting on behalf of its members, to assert that injury in fact existed as to those potential injuries that caused aesthetic and environmental injury to an individual plaintiff or a member of an environmental group.[40] But in 1992, the Supreme Court raised more hurdles to standing in *Lujan*

---

[33] Mathew D. McCubbins & Thomas Schwartz, *Congressional Oversight Overlooked: Police Patrols versus Fire Alarms*, 28 AM. J. POL. SCI. 166 (1984).

[34] *See infra* notes 35–50 and accompanying text.

[35] Lujan v. Defenders of Wildlife, 504 U.S. 555, 560–61 (1992). The Supreme Court has noted that

> [A]lthough standing in its outer dimensions is a prudential concept to be shaped by the decisions of the courts as a matter of sound judicial policy and subject to the control of Congress, at its core it becomes a constitutional question; for standing in its most basic aspect can be one of the controlling elements in the definition of a case or controversy under Article III.

ASARCO Inc. v. Kadish, 490 U.S. 605, 613 (1989) (citing to Valley Forge Christian College v. Americans United for Separation of Church & State, Inc., 454 U.S. 464, 471–76 (1982)).

[36] Ass'n of Data Processing Serv. Orgs., Inc. v. Camp, 397 U.S. 150, 153 (1970) (articulating, for the first time, zone of interests test under the Administrative Procedure Act).

[37] Kurt S. Kusiak, Note, *Standing to Sue: A Brief Review of Current Standing Doctrine*, 71 B.U. L. REV. 667, 680 (1991).

[38] *Id.*

[39] Randall S. Abate & Michael J. Myers, *Broadening the Scope of Environmental Standing: Procedural and Informational Injury-in-Fact after* Lujan v. Defenders of Wildlife, 12 UCLA J. ENVTL. L. & POL'Y 345, 346 (1994).

[40] *See* 405 U.S. 727 (1972) ("Aesthetic and environmental well-being, like economic well-being, are important ingredients of the quality of life in our society, and the fact that particular

v. Defenders of the Wildlife.[41] Authored by Justice Scalia, the majority opinion in *Lujan* attempted to limit the scope of injury in fact to "actual or imminent" environmental injuries.[42] The Supreme Court, however, in *Friends of the Earth, Inc. v. Laidlaw Environmental Services (TOC), Inc.*, appears to have retreated from the stricter *Lujan* requirements to lesser ones involving the use of the affected area and a specified aesthetic injury.[43]

The other two types of injury in fact arise separately from claims of a substantive injury and instead arise from a class of injuries created by Congress. *Procedural injury* "is found when a governmental entity's action or inaction violates a law under a statutory scheme in which Congress has expressly or impliedly created an interest in private individuals to affect such administrative decisions through the law."[44] Parties have been able to claim that an agency has committed a procedural injury in fact under the National Environmental Policy Act, the Federal Insecticide, Fungicide and Rodenticide Act (FIFRA) and the Federal Water Pollution Control Act (Clean Water Act).[45] A lesser type of procedural

---

environmental interests are shared by the many rather than the few does not make them less deserving of legal protection through the judicial process.").

[41] Lujan v. Defenders of Wildlife, 504 U.S. 555 (1992).

[42] *Id.* at 560.

[43] *See* Friends of the Earth, Inc. v. Laidlaw Envtl. Servs., Inc., 528 U.S. 167, 183 (2000) ("We have held that environmental plaintiffs adequately allege injury in fact when they aver that they use the affected area and are persons 'for whom the aesthetic and recreational values of the area will be lessened' by the challenged activity." (quoting Sierra Club v. Morton, 405 U.S. 727, 735 (1972))); Interfaith Cmty. Org. v. Honeywell Int'l, Inc., 399 F.3d 248, 256–58 (3d Cir. 2005) (adopting a *Laidlaw* analysis for environmental plaintiffs); *see also* Am. Canoe Ass'n v. Murphy Farms, Inc., 326 F.3d 505, 520 (4th Cir. 2003); Cantrell v. City of Long Beach, 241 F.3d 674, 681 (9th Cir. 2001); Hill v. Norton, 275 F.3d 98, 103 (D.C. Cir. 2001). For commentary acknowledging this retreat, see William W. Buzbee, *Standing and The Statutory Universe*, 11 DUKE ENVTL. L. & POL'Y F. 247, 263–67 (2001) (analyzing the lessening of the stringent injury in fact requirement in *Laidlaw*); Emily Longfellow, Friends of the Earth v. Laidlaw Environmental Services: *A New Look at Environmental Standing*, 24 ENVIRONS ENVTL. L. & POL'Y J. 3, 5 (2000) ("*Laidlaw* signals a retreat from the Court's recently strict approach to environmental standing law.").

[44] Abate & Myers, *supra* note 39, at 346.

[45] *Id.* at 353–58. Miriam S. Wolok has identified a number of other statutory context in which Congress has recognized a procedural injury including: Staggers Railroad Act of 1980, 49 U.S.C. § 10101 (2000), United Transp. Union v. Interstate Commerce Comm'n, 891 F.2d 908 (D.C. Cir. 1989); Employee Retirement Income Security Act, 29 U.S.C. § 1381 (2000), Fernandez v. Brock, 840 F.2d 622 (9th Cir. 1988); Ethics in Government Act, 2 U.S.C. § 1 (2000), Dellums v. Smith, 797 F.2d 817 (9th Cir. 1986); Farm Labor Contractor Registration Act, 7 U.S.C. § 2041 (2000), Alvarez v. Longboy, 697 F.2d 1333 (9th Cir. 1983); Age Discrimination Act, 42 U.S.C. § 6101 (2000), Action Alliance of Senior Citizens of Greater Phila. v. Heckler, 789 F.2d 931 (D.C. Cir. 1986), *vacated on other grounds*, 494 U.S. 1001 (1990); Education for All Handicapped Children Act, 20 U.S.C. § 821 (2000), Ga. Ass'n of Retarded Citizens v. McDaniel, 716 F.2d 1565 (11th Cir. 1983); Federal Election Campaign Act, 2 U.S.C. § 431 (2000), Nat'l Conservative Political Action Comm. v. Federal Election Comm'n, 626 F.2d 953 (D.C. Cir. 1980). Miriam S. Wolok, *Standing for Environmental Groups:*

injury, *informational injury*, exists where a governmental entity's or private party's failure to provide or collect information required by a statute subverts a group's organizational ability to obtain relevant information.[46] Of the three types of available claims of injury in fact, a claim of informational injury is the narrowest type of claim that can be possibly be made and appears to be the least successful injury in fact claim.[47]

The second type of enforcement mechanism is the use of citizen suits.[48] Such suits give organizations the independent ability to enforce individual or collective statutory responsibilities.[49] At least nine of the major environmental statutes contain citizen suit provisions, which provide individuals and organizations with the broad-based ability to sue any private or public entity violating a relevant environmental statute, as well as the narrower ability to sue the relevant administrators that fail to carry out non-discretionary statutory duties.[50] Citizen suits have proven to be an important element of environmental enforcement

---

Procedural Injury as Injury-in-Fact, 32 NAT. RESOURCES J. 163, 184 n.152 (1992).

[46] Abate & Myers, *supra* note 39, at 349–52.

[47] *Id.*

[48] *See infra* note 50 and accompanying text.

[49] Mark Seidenfeld & Janna Satz Nugent, *"The Friendship of the People": Citizen Participation in Environmental Enforcement*, 73 GEO. WASH. L. REV. 269, 301–02 (2005) ("Indeed, one of the benefits produced by citizen suits, namely, increased competition for enforcement, has far surpassed the effects originally envisioned. At the federal level, 'the growth of private enforcement is acting as a competitive spur to government enforcers, prodding them to improve their management tools for measuring, securing, and overseeing compliance.' Additionally, competition from private enforcers may have been the impetus for the EPA's innovative settlements and its reconciliation of policies and practices.").

[50] JAMES SALZMAN & BARTON H. THOMPSON, JR., ENVIRONMENTAL LAW AND POLICY 70 (2002); *see, e.g.*, Solid Waste Disposal Act, 42 U.S.C. § 6972 (2000) (containing a citizen suit provision); *see also* Safe Drinking Water Act, 42 U.S.C. § 300j-8 (2000); Emergency Planning and Community Right-To-Know Act, 42 U.S.C. § 11046 (2000); Clean Air Act, 42 U.S.C. § 7604 (2000); Clean Water Act, 33 U.S.C. § 1365 (2000); Marine Protection, Research and Sanctuaries Act, 33 U.S.C. § 1415(g) (2000); Solid Waste Disposal Act, 42 U.S.C. § 6972 (2000); Comprehensive Environmental Response, Comprehension and Liability Act, 42 U.S.C § 9659 (2000); Toxic Substances Control Act, 15 U.S.C. § 2619 (2000); Endangered Species Act, 16 U.S.C. § 1540(g) (2000).

The ability of parties to claim a procedural injury in fact based on the availability of citizen suits is not clear. Justice Kennedy in a concurrence in *Lujan* suggested that the existence of a citizen suit would not be sufficient to create a procedural injury in fact. *Lujan*, 504 U.S. 555, 580.

> The citizen-suit provision of the Endangered Species Act does not meet these minimal requirements, because while the statute purports to confer a right on 'any person . . . to enjoin . . . the United States and any other governmental instrumentality or agency . . . who is alleged to be in violation of any provision of this chapter,' it does not of its own force establish that there is an injury in 'any person' by virtue of any 'violation.'

Id.

because such statutes allow interested parties to undertake enforcement roles that may not be possible for underfunded or ideologically hostile environmental agencies. Moreover, such citizen suits may force agencies to undertake politically unpopular initiatives.[51]

2. Transparency Mechanisms. The final participatory mechanisms are those statutory requirements that ensure transparency in the public assessment of environmental risks. Although transparency mechanisms can take many forms, public transparency has been defined as having two key goals.[52] First, public transparency requires that citizens are able to observe, form, and scrutinize policy choices.[53] Second, public transparency requires public declaration of any adopted policy rationales.[54] Environmental statutes use a number of mechanisms to increase public transparency in administrative decisionmaking. For instance, statutory provisions, including § 102(c) of the National Environmental Policy Act (NEPA) and § 7 of the Endangered Species Act (ESA), require that policy makers engage in sustained assessments before undertaking major decisions with substantive environmental impact.[55] Other statutes require policy makers to make available baseline information about environmental risks.[56] For instance, the Emergency Planning and Community Right-to-Know Act requires companies with ten or more employees to complete a form that reports any release of toxic chemicals and submit that information to be included in a national Toxic Release Inventory, which is to be maintained in a publicly accessible form.[57]

---

[51] Susan George et al., *The Public in Action: Using State Citizen Suit Statutes to Protect Biodiversity*, 6 U. BALT. J. ENVTL. L. 1, 7–8 (1997); *see also* Barton H. Thompson, Jr., *The Continuing Innovation of Citizen Enforcement*, 2000 U. ILL. L. REV. 185, 187 (2000).

[52] Erik Luna, *Transparent Policing*, 85 IOWA L. REV. 1107, 1164 (2000).

[53] *Id.*

[54] *Id.*

[55] Endangered Species Act, 16 U.S.C. § 1536(a) (2000) (requiring that all federal agencies must consult with the Secretary of the Interior to ensure that their actions will not jeopardize the continued existence of any endangered or threatened species); National Environmental Policy Act, 42 U.S.C. § 4332(C)(i)–(v) (2000) (requiring an assessment of environmental impacts on any major federal action).

[56] *E.g.*, 42 U.S.C. § 11023 (2000).

[57] *Id. See also* Clean Water Act, 33 U.S.C. § 1318(b) (2000) (requiring any records, reports, or information related to toxic, pretreatment, or new source performance standards be made publicly available); Pollution Prevention Act, 42 U.S.C. § 13106(e) (2000) (requiring source reduction and recycling data be made publicly available).

B. PARTICIPATORY MECHANISMS IN PATENT LAW

As discussed above, three mechanisms—standing, citizen suits, and transparency values—are necessary for a functional politics within a regulatory regime. Patent law, unfortunately, fails to sufficiently utilize these mechanisms.

1. Citizen Enforcement Mechanisms. The ability to pursue a suit under the Patent Act is traditionally understood to be a private right controlled by a limited number of parties (potentially, the patentee and a competitor) who seek to pursue relief from a retrospective injury (an infringed-upon patent).[58] This reliance on a private interest model leads to a reluctance to fully accord standing to parties seeking to protect broader public interests, such as an error by the patent office that implicates an entire class of technologies.[59] A reassessment of standing is necessary if patent law is to be sensitive to these broader concerns of third party constituencies. Currently, the issue of third party standing in patent law is determined by the potential timing of a challenge.[60] Counterintuitively, I start with an analysis of standing after the patent has issued since once a patent has issued, the presumption of ownership in a patent is strong and thus creates limited opportunities for *any* party, besides the patent owner, to claim a substantive injury in fact necessary to maintain an action.[61] Arguably, broader opportunities for an interested third party constituency may be available before a patent has issued.[62] However, the potential for a pre-issuance attack directed towards the agency's actions in examining the patent has been limited by narrow interpretations of standing under Patent Act, or alternatively, the Administrative Procedure Act (APA).[63]

a. Post-Issuance Challenge. Only a patentee has the right to bring a claim of infringement after a patent has issued.[64] Section 281 of the Patent Act states that only "a patentee" may seek civil remedies for infringement;[65] the term "patentee" is limited to the party to whom a patent has been issued or to successors-in-title to that patentee.[66] So, once a patent has issued, the only party potentially capable

---

[58] Steven L. Winter, *The Metaphor of Standing and the Problem of Self-Governance*, 40 STAN. L. REV. 1371, 1410–11 (1988) (distinguishing between private and public models of standing).

[59] Winter criticizes the standing jurisprudence within the context of patent law, contending that the focus on particular, individualized injury prevents parties from raising broader concerns over the state of a field of technology. *Id.* at 1461.

[60] *See infra* notes 62–73 and accompanying text.

[61] *See infra* notes 82–94 and accompanying text.

[62] *See infra* notes 82–94 and accompanying text.

[63] *See infra* notes 96–143 and accompanying text.

[64] Patent Act of 1952, 35 U.S.C. § 281 (2000) ("A patentee shall have remedy by civil action for infringement of his patent.").

[65] *Id.*

[66] 35 U.S.C. § 100(d) (2000) ("The word 'patentee' includes not only the patentee to whom the

of suffering a substantive injury to their interest under the Patent Act is the patentee. The major issue as to standing after post-issuance has been whether a third party licensee has sufficient standing to bring an independent infringement action.[67] The limited standing afforded to third parties reflects the premium placed on establishing ownership under the current patent regime. Once a patent has been examined and issued, the patent owner is granted the right to exclude others from use.[68] But in a sense, the real power lies in the ability to *initiate* an action against other users; this initiative power, for instance, allows a power to control the timing of the challenges.

This initiative power has been limited somewhat by the ability of a potentially infringing party to file a declaratory judgment under the federal Declaratory Judgment Act.[69] Under this Act, a party seeking to file a declaratory judgment must: (1) actually produce or be prepared to produce an allegedly infringing product; and (2) demonstrate that the patentee's conduct creates an objectively reasonable apprehension that the patentee will initiate a suit if the activity in questions continues.[70] Although the ability to raise a preemptive claim under the Declaratory Judgment Act is broad, the Federal Circuit has been criticized for mandating that a potential infringer can only bring a declaratory judgment if "an explicit" threat of litigation exists; a mere accusation of infringement by the patentee will not suffice to support a successful challenge under the Act.[71]

---

patent was issued but also the successors in title to the patentee."); *see also* Fieldturf, Inc. v. Sw. Recreational Indus., Inc., 357 F.3d 1266, 1268 (Fed. Cir. 2004) ("To bring an action for patent infringement, a party must be either the patentee, a successor in title to the patentee, or an exclusive licensee of the patent at issue."); Speedplay, Inc. v. Bebop, Inc., 211 F.3d 1245, 1249–50 (Fed. Cir. 2000) ("A party may bring an action for patent infringement only if it is the 'patentee,' *i.e.*, if it owns the patent, either by issuance or by assignment."). For a review of this standing doctrine, see Roger D. Blair & Thomas F. Cotter, *The Elusive Logic of Standing Doctrine in Intellectual Property Law*, 74 TUL. L. REV. 1323, 1336–65 (2000) (analyzing the development of the limited standing accorded parties after a patent has issued).

[67] *See, e.g.*, Rite-Hite Corp. v. Kelley Co., 56 F.3d 1538, 1552 (Fed. Cir. 1995) (examining the circumstances under which a licensee may have standing to sue as a co-plaintiff in an infringement action).

[68] Schenck v. North Corp., 713 F.2d 782, 786 n.3 (Fed. Cir. 1983).

[69] 28 U.S.C. § 2201 (2000).

[70] Arrowhead Indus. Water, Inc. v. Ecolochem, Inc., 846 F.2d 731, 736 (Fed. Cir. 1988).

[71] Lisa A. Dolak, *Declaratory Judgment Jurisdiction in Patent Cases: Restoring the Balance Between the Patentee and the Accused Infringer*, 38 B.C. L. REV. 903, 935–37 (1997) (citing Phillips Plastics Corp. v. Kato Hatsujou Kabushiki Kaisha, 57 F.3d 1051, 1052 (Fed. Cir. 1995)). Under the current test for a claim under the Declaratory Judgment Act, the party must show: (1) an explicit threat of other action by the patentee which creates a reasonable apprehension on the part of the declaratory judgment plaintiff that it will face an infringement suit; and (2) present activity by the declaratory judgment plaintiff which could constitute infringement, or concrete steps taken by the declaratory judgment plaintiff with the intent to conduct such activity. Teva Pharm. USA, Inc. v. Pfizer, Inc.,

Indeed, the Supreme Court has recently accepted *certiorari* in *MedImmune, Inc. v. Genentech, Inc.*,[72] to determine if the Federal Circuit's requirement that a licensee must refuse to pay royalties and commit material breach of the license agreement to create an actual controversy under the Declaratory Judgment Act is too stringent under existing precedent.[73]

The Patent Act contemplates—post-issuance—the party best able to bring a claim is a competitor to the patent owner. Taken together, the norms for standing and declaratory judgment indicate that the statute contemplates that the onus for determining a patent's validity can be placed on either the patent owner or potential competitors. The Patent Act's grant of special status to competitors can be seen most clearly within the context of a subsidiary inquiry undertaken in *Walker Process Equipment, Inc. v. Food Machinery & Chemical Corp.*, which states that a patent's immunity from suit under antitrust laws is withdrawn if a patentee has fraudulently obtained a patent.[74] Such *Walker Process* claims are brought as counterclaims by a direct competitor in response to a patentee's claim of patent infringement.[75] This is a traditional posture for patent claims, demonstrating the special status accorded to direct competitors.[76] Recently, however, third party consumers have attempted to raise a *Walker Process* claim in order to challenge fraudulently obtained patents.[77] At least one court, in *Molecular Diagnostics Laboratories v. Hoffman-La-Roche, Inc.*, has argued that since a *Walker Process* claim is directed towards antitrust injury (and not patent injury), consumers directly harmed by the antitrust injury have standing to bring a claim.[78] This line of cases

---

395 F.3d 1324, 1330 (Fed. Cir. 2005).

[72] 126 S. Ct. 1329 (2006).

[73] *See* Gen-Probe Inc. v. Vysis, Inc., 359 F.3d 1376 (Fed. Cir. 2004) (holding that to obtain standing under the Declaratory Judgment Act a licensee must commit material breach of the license agreement).

[74] 382 U.S. 172, 177 (1965).

[75] *See* Nobelpharma AB v. Implant Innovations, Inc., 141 F.3d 1059, 1067 (Fed. Cir. 1998) ("[A]n antitrust claim premised on stripping a patentee of its immunity from the antitrust laws is typically raised as a counterclaim by a defendant in a patent infringement suit." (citing Argus Chem. Corp. v. Fibre Glass-Evercoat Co., 812 F.2d 1381, 1383 (Fed. Cir. 1987))).

[76] *See Nobelpharma AB*, 141 F.3d at 1067.

[77] *Id.*

[78] *See* 402 F. Supp. 2d 276, 280 (D.D.C. 2005) ("*Walker Process* claims are intended to address antitrust injury, thus the requirement that a plaintiff be able to allege a violation of Section 2 of the Sherman Act. A *Walker Process* claim is not a fraud claim, as the court intonates, but an antitrust violation. The harm is not the invalid patent, but the use of the invalid patent to establish a monopoly." (citations and footnote omitted)). *Contra In re* Remeron, 335 F. Supp. 2d 522, 529 (D.N.J. 2004) ("Plaintiffs, as direct purchasers, neither produced mirtazapine nor would have done so; moreover, Plaintiffs were not party to the initial patent infringement suits. Plaintiffs may not now claim standing to bring a *Walker Process* claim by donning the cloak of a Clayton Act monopolization claim.").

reveals the strength of the competitive presumption in patent law since not even the court in *Molecular Diagnostics Laboratories* questions the limited standing accorded in patent law to third parties other than competitors.[79]

Reliance on competitors to prove or disprove patent validity can be problematic as competitors may have compelling business reasons for not pursuing a challenge to a particular patent. Indeed, the battle between the makers of interactive books outlined at the beginning of this Article indicates that settlement may often be a strategic business choice.[80] The battle ended quietly with a private settlement.[81] The important public goals associated with the Cheerios battle—namely, the potential invalidity of a patent that impacted substantive uses in the public domain—were secondary to prudently avoiding costly, long-term litigation. Such incentives have proven to be extremely problematic within the pharmaceutical context. For example, increasingly, a generic producer may derive significant benefits by settling with a conventional producer; indeed, the potentially collusive practices between generic and conventional producers of pharmaceuticals have been the subject of increasing judicial and administrative scrutiny.[82]

b. Pre-Issuance Challenge. Even if a claim of substantive injury is not available as a claim, theoretically, a range of administrative actions could be

---

[79] *Molecular Diagnostics*, 402 F. Supp. at 280 ("The inclusion of the fact that the plaintiffs were not parties in the initial patent infringement suits suggests that the court confused the harm addressed through a *Walker Process* claim. The court appears to believe that, standing alone, the enforcement of the fraudulently procured patent is the relevant injury in a *Walker Process* claim, hence the court's assertion that a plaintiff must be an actual or potential competitor. This, however, is not the case.").

[80] *See supra* note 14 and accompanying text.

[81] *See supra* note 14 and accompanying text.

[82] Leila Abboud, *Branded Drugs Settling More Generic Suits*, WALL ST. J., Jan. 17, 2006, at B1 (detailing the increasing reliance of pharmaceutical companies on settlement with generic competitors); *see also* FED. TRADE COMM'N, GENERIC DRUG ENTRY PRIOR TO PATENT EXPIRATION, AN FTC STUDY (2002), *available at* http://purl.access.gpo.gov/GPO/LPS21619 (analyzing collusive methods of preventing full generic competition within the pharmaceutical competition). For cases representative of this trend, see, e.g., *In re* Tamoxifen Citrate Antitrust Litig., 429 F.3d 370, 374 (2d Cir. 2005) (holding that a patent infringement suit entered between a pioneer manufacturer and a generic competitor to settle a pending appeal did not violate relevant antitrust laws); Schering-Plough Corp. v. Fed. Trade Comm'n, 402 F.3d 1056, 1058 (11th Cir. 2005) (questioning whether the contested agreements unreasonably restrained trade in violation of § 1 of the Sherman Antitrust Act and § 5 of the Federal Trade Commission Act); Valley Drug Co. v. Geneva Pharm., 344 F.3d 1294, 1296 (11th Cir. 2003) (examining whether agreements not to enter the market between a pioneer manufacturer and generic competitors were restraints against trade under the relevant antitrust law); *In re* Cardizem Co. Antitrust Litig., 332 F.3d 896, 900 (6th Cir. 2003) (holding that payment of forty million dollars by a pioneer manufacturer to a generic competitor so the competitor would refrain from entering the market was a horizontal market allocation agreement and thus, per se illegal under the relevant antitrust laws).

subject to attack by an interested third party that claims an administrative actor in the PTO or other relevant agency had violated a statutory duty and thus committed a procedural injury in fact under either the Patent Act or the APA. Such a third party standing challenge may be easier to make in a pre-issuance context since the presumption of ownership granted by an issued patent has not attached. However, the Federal Circuit has significantly limited use of these two available statutory avenues.

A third party could claim that the existence of ex parte reexamination and optional inter partes reexamination proceedings creates an implied private interest that would support a claim of procedural injury in fact under the Patent Act. Ex parte reexamination and optional *inter partes* reexamination proceedings can be used to introduce a limited category of prior art citations.[83] A recent amendment to the Patent Act, the optional *inter partes* proceedings, grants broader rights to the third party requester than a reexamination proceeding in one key respect: a third party requester in optional *inter partes* proceeding can appeal to the Board of Patent Appeals and Interferences and, if dissatisfied with the Board's decision, appeal to the Federal Circuit.[84]

While each of these procedures could potentially serve as the basis for third party procedural standing, such claims have been rejected by the Federal Circuit. For instance, in *Syntex (U.S.A.) Inc., v. U.S. Patent & Trademark Office*, the Federal Circuit upheld the district court's decision that standing could not be granted to a third party requester who had sued the PTO to revoke a reexamination certificate and reopen the reexamination proceeding since the Patent Act accorded no rights to a third party requester after the initial request for reexamination.[85] The Federal Circuit concluded that two key reexamination limits indicated that Congress did not accord procedural standing to third parties under the Patent Act.[86] First, once the third party requester initiated a reexamination, the requester could not participate throughout the rest of the proceedings.[87] Second, the third

---

[83] 35 U.S.C. § 301 (2000) ("Any person at any time may cite to the Office in writing prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent."); 35 U.S.C. § 311(a) (2004) ("Any third party requester at any time may file a request for *inter partes* reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.").

[84] 35 U.S.C. § 315(b)(1) (2000) ("[A third party requester] may appeal under the provisions of section 134, and may appeal under the provisions of sections 141 through 144, with respect to any final decision favorable to the patentability of any original or proposed amended or new claim of the patent. . . ."). Third-party requesters cannot initiate a de novo civil action in the district court. *See* 35 U.S.C. § 141 (2005).

[85] 882 F.2d 1570, 1571 (Fed. Cir. 1989).

[86] *Id.* at 1573–74.

[87] *Id.* This argument is supported by two other cases. *See* Boeing Co. v. Comm'r of Patents and Trademarks, 853 F.2d 878, 880 (Fed. Cir. 1988) (holding that a third party has no standing to appeal

party requester could not appeal any reexamination determination.[88] The court in *Syntex* also concluded that even if the injury claimed by a third party was a genuine procedural injury in fact, standing could still be denied because the injury of the requester was potentially not redressable.[89] The court equated Syntex's position as a third party requester to that of a potential infringer seeking to preemptively challenge the issuance of a patent and concluded that in both cases "a remedy must await confrontation with the patent owner."[90] Therefore, a third party could not bring a direct suit against the PTO because their injury in fact was not redressable.[91]

The result in *Syntex* has been interpreted to suggest that a third party cannot claim *any* threatened or alleged procedural injury in fact under the Patent Act since the limited right of protest outlined in reexamination procedures indicates that the rights of third parties are not covered under the Patent Act. Two post *Syntex* scenarios have arisen. The first scenario mirrors *Syntex*: a party claims that the PTO has violated a statutory duty, thus creating a procedural injury in fact.[92] Under this scenario, *Syntex* is used to demonstrate that any standing claim made by a third party that challenges the procedures of the PTO should be denied because the Patent Act (as demonstrated by the limited rights accorded to third party requesters under the reexamination procedures) does not recognize an implied private right to challenge the outcomes of these procedures. The second *Syntex* scenario recognizes that even if procedural injury in fact is available as a claim, such injury is not redressable because once the PTO has issued a patent, a party must directly confront the patent owner.[93] The strength of *Syntex* is questionable. The statutory landscape on which the holding in *Syntex* is based has changed. Optional inter partes proceedings provide patent owners with the ability to participate throughout the entire process and a right of appeal.[94] These new

---

because of limited right to file a protest); Yuasa Battery Co. v. Comm'r of Patents and Trademarks, 3 U.S.P.Q.2d 1143, 1144 (D.D.C. 1987) (holding that a third party reexamination requester does not have standing to appeal reexamination decision).

[88] *Syntex*, 882 F.2d at 1573–74.

[89] *Id.* at 1576.

[90] *Id.*

[91] *Id.*

[92] *See, e.g.*, Hitachi Metals Ltd. v. Quigg, 776 F. Supp. 3, 10 (D.D.C. 1991) (determining that a plaintiff seeking to challenge the issuance of a regulation that retroactively applied to a reissue application could not be granted standing because third party procedural rights were limited to the right to file a protest under the Patent Act) (citing Dellums v. Smith, 797 F.2d 817, 823 (9th Cir. 1986)).

[93] Hallmark Cards, Inc. v. Lehman, 959 F. Supp. 539, 544 (D.D.C. 1997) ("A potential infringer may not sue the PTO seeking retraction of a patent issued to another by reason of its improper allowance by the PTO; a remedy must await confrontation with the patent owner.").

[94] 35 U.S.C. § 314(b)(2) (2000) ("Each time that the patent owner files a response to an action

rights answer both arguments made against finding that no implied right exists under the Patent Act. The amendment of the Patent Act to include optional *inter partes* procedures provides an opportunity to revisit the ability of third parties to claim procedural injury in fact under the Patent Act.

The Federal Circuit has placed similar limits on third party claims under the APA. While the Patent Act subjects agency decisionmaking to a narrow range of reviewable actions, such as reexamination and correction of mistakes or errors, the APA would allow third parties to challenge a potentially broader range of agency behavior.[95] Section 702 of the APA affords any "person suffering legal wrong because of agency action, or adversely affected or aggrieved by agency action within the meaning of a relevant statute"[96] the ability to obtain judicial review of a range of agency actions under § 706.[97] The Federal Circuit, however, has also placed significant limits on third party standing under the APA as is demonstrated by its holding in *Animal Legal Defense Fund v. Quigg* (*ALDF*).[98] *ALDF* involved a challenge by nine plaintiffs[99] to the Commissioner of the PTO's issuance of a controversial notice that stated that non-naturally occurring non-human multicellular organisms were patentable subject matter under § 101 of the Patent Act.[100] The plaintiffs filed a joint complaint, which had two primary

---

on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response."); *see also* 35 U.S.C. § 315(b).

[95] Under the Administrative Procedure Act, a range of administrative actions are subject to review, among them, rule-making procedures, orders, adjudications, sanctions, and other types of relief. *See* Administrative Procedure Act, 5 U.S.C. § 551 (2000).

[96] *Id.* § 702.

[97] *Id.* § 706. Section 706(2) provides for judicial review of agency action that is: (1) arbitrary, capricious, an abuse of discretion, or otherwise not in accordance of the law; (2) contrary to a constitutional right, power, privilege, or immunity; (3) in excess of statutory jurisdiction, authority, or limitations; (4) without observance of procedure required by law; (5) unsupported by substantial evidence in a case subject to administrative hearing; or (6) unwarranted by the facts to the extent that the facts are subject to trial de novo by the reviewing court. *Id.* § 706(2)(A-F) (2005).

[98] Animal Legal Def. Fund v. Quigg, 710 F. Supp. 728 (N.D. Cal. 1989), *aff'd*, 932 F.2d 920 (Fed. Cir. 1991) [hereinafter *ALDF*].

[99] The nine plaintiffs were the Animal Legal Defense Fund (ALDF), the American Society for the Prevention of Cruelty to Animals (ASPCA), the Marin Humane Society (MHS), Wisconsin Family Farm Defense Fund (WFFDF), John Kinsman, Michael Cannell, Humane Farming Association (HFA), Association of Veterinarians for Animal Rights (AVAR), and People for the Ethical Treatment of Animals (PETA). *ALDF*, 932 F.2d at 923, n.3. For further background on the controversy over the patenting of animals, see Elizabeth Joy Hecht, *Beyond* Animal Legal Defense Fund v. Quigg*: The Controversy Over Transgenic Animal Patents Continues*, 41 AM. U. L. REV. 1023, 1043–45 (1992) (reviewing the factual and legal issues that arose in *ALDF*).

[100] *ALDF*, 932 F.2d at 923.

counts.[101] In Count I, the plaintiffs alleged that the Commissioner had violated § 553 of the APA by issuing the notice without sufficient notice and comment rulemaking under the statute.[102] In Count II, the plaintiffs further alleged that the Commissioner acted in excess of his statutory jurisdiction or authority under § 706(2)(C) of the APA by declaring animals as patentable subject matter under § 101 of the Patent Act.[103]

The Federal Circuit affirmed the district court's holding that the plaintiffs had failed to sufficiently prove that they had standing on both claims.[104] On Count I, the organizational plaintiffs claimed that the Commissioner had violated their collective rights to participate under § 553 of the APA since the Commissioner did not allow them to comment on his interpretation of § 101.[105] In essence, the plaintiffs argued that they suffered an informational injury in fact and therefore, had standing to raise a claim. The Federal Circuit rejected this claim, concluding that the notice at issue did not have the full force and effect of the law and therefore, was an interpretative rule that did not fall within the scope of § 553.[106] The notice, the Federal Circuit concluded, was interpretative because the Commissioner did not issue the notice under any relevant statutory authority.[107] The Commissioner was not acting under his statutory authority since the notice relied on a previous interpretation of the same issue undertaken by the Board of Patent Appeals and Interferences (BPAI).[108] In doing so, the Board was acting under its independent statutory authority to interpret the Patent Act, and therefore, the notice was merely a secondary interpretation of the same issue.[109] Moreover, even if the BPAI's intervening interpretation had not occurred, the Federal Circuit concluded that the Commissioner did not interpret the Patent Act under his statutory authority, which only extends to rules and notices directed towards the "conduct of the proceedings" before the PTO.[110]

---

[101] *Id.* at 926, 931.

[102] *Id.* at 926.

[103] *Id.* at 931.

[104] *Id.* at 939.

[105] *Id.* at 926. Under § 553 of the APA, outside parties can participate in certain categories of agency rulemaking, by submitting written data, views, or arguments. General notice of the relevant agency-decisionmaking must be published in the Federal Register. *See* 5 U.S.C. § 553(b)–(c).

[106] Section 553(b) does not apply to "interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice." 5 U.S.C. § 553(b)(A).

[107] *ALDF*, 932 F.2d at 930.

[108] *Id.* at 929.

[109] *Id.* at 928.

[110] *Id.* at 930. At the time of *ALDF*, § 6 of the Patent Act outlined the scope of the Commissioner's authority. This authority is now contained in § 2 of the Patent Act. *See* 35 U.S.C. § 2(b)(2)(a).

The Federal Circuit also rejected the standing claims made by the parties in its analysis of Count II, which claimed that the notice violated § 706(2)(C) of the APA.[111] In this section of *ALDF*, the Federal Circuit is preoccupied with the problem of "indirect" standing, which occurs where the actions of a third party may influence the redressability of a potential plaintiff's injury.[112] The opinion addressed the claims of two different categories of plaintiffs.[113] The first category of plaintiffs, which included two farming associations and farmers, argued that the notice's allowance of transgenic animal patenting would cause an economic injury in fact by forcing them to pay royalty payments for genetically altered animals and increasing the cost of operations associated with employing non-genetically modified animals.[114] The second category of plaintiffs, the animal protection associations, claimed that the rule would increase their enforcement responsibilities under state statutes to prevent inhumane experiments that would arise as a result of increased patent protection.[115]

The Federal Circuit rejected the claims of the first category of claimants.[116] The court asserted that the type of economic injuries alleged were "speculative" because it was unclear whether there would be an actual increase in either royalty payments or cost of operations.[117] Moreover, even if such claims of injury in fact were sufficient, such claims could be not redressed by a favorable court decision since the plaintiffs' claims of injury rested on "the speculative activities of third party competitors."[118] By contrast, the Federal Circuit recognized claims of injury in fact made by the animal protection associations as legitimate under existing precedent because state statutes imposed an obligation upon the associations to fulfill a range of duties to protect animals.[119] However, the Federal Circuit ultimately rejected the animal associations' claims, once again, because of the difficulty of proving a causal link between the PTO's issuance of a notice and the potential injury resulting from the fact that "researchers would likely disregard applicable animal protection laws because of the Notice."[120] The Federal Circuit appears to require that claims of an injury in fact have a very direct harm to the interest of the organization or claimant at issue.

---

[111] *ALDF*, 932 F.2d at 931.
[112] *Id.* at 935.
[113] *Id.* at 932.
[114] *Id.*
[115] *Id.* at 937.
[116] *Id.*
[117] *Id.* at 934.
[118] *Id.*
[119] *Id.* at 936 ("Nevertheless, we recognize that courts have found the type of allegations made by ASPCA and MHS here sufficient for showing personal injury.").
[120] *Id.* at 937.

Finally, the Federal Circuit stated that, even if the third parties' claims were to be accorded standing, none of the claims made by the plaintiffs at issue—the farmers, the farming associations, or the animal protection associations—fell within the zone of interests contemplated by the Patent Act.[121] Preliminarily, the court rejected the plaintiffs' claims that the zone of interest claim could be satisfied by treating § 702 as the relevant statute under which a person aggrieved by agency action could claim standing to challenge that action.[122] Rather, a standing claim brought under the APA had to fall within the zone of interest contemplated by the Patent Act.[123] Here, the plaintiffs argued that their claims fell within the Patent Act because patents were issued for public benefit under the Constitution.[124] The Federal Circuit, contending that acceptance of such claims would "encompass[ ] any member of the public who perceives they will be harmed," rejected the claims on two grounds.[125] First, such a broad claim would subject issued patents to collateral attack by competitors on the validity of patent.[126] Second, the Federal Circuit implied that the statutory scheme of the Patent Act suggests that Congress intended to preclude judicial review for third parties altogether.[127] In coming to this conclusion, the Federal Circuit relied on *Block v. Community Nutrition Institute*.[128] In *Block*, the Supreme Court held that while milk handlers could seek judicial review of pricing orders issued by the Secretary of Agriculture under the Agricultural Marketing Agreement Act of 1937, consumers did not have a corresponding right since the statute entirely precluded third party relief under a complex administrative scheme.[129]

ALDF has had significant consequences for third party standing under the APA. Had the Federal Circuit rejected the Complaint on the grounds outlined in Count I,[130] *ALDF* would have had merely articulated the types of PTO administrative actions subject to the notice and comment procedures outlined in the APA.[131] *ALDF*, however, is representative of three trends within patent law. First, the Federal Circuit's analysis of third party standing in *ALDF* reveals the

---

[121] *Id.*

[122] *Id.* (citing 5 U.S.C. § 702).

[123] *Id.*

[124] *Id.* at 938.

[125] *Id.*

[126] *Id.*

[127] *Id.*

[128] 467 U.S. 340 (1984).

[129] *Id.* at 348; *ALDF*, 932 F.2d at 938.

[130] *See supra* notes 94–100 and accompanying text.

[131] *See, e.g.*, Merck & Co. v. Kessler, 80 F.3d 1543, 1549–50 ("As we have previously held, the broadest of the PTO's rulemaking powers—35 U.S.C. § 6(a)—authorizes the Commissioner to promulgate regulations directed only to 'the conduct of proceedings in the PTO'; it does not grant the Commissioner the authority to issue substantive rules.").

central dilemma of third party standing in administrative patent law. If third parties can only be injured by an issued patent, then third party injury is *always* speculative (in that it depends on the actions of the patentee), and thus can never be potentially redressable. Such a formulation ignores other types of procedural and informational injury that have been recognized in environmental law that could be translated to the arena of patent law. These interests could include the efforts of an organization to prevent a patent from issuing because of the patent's ability to impact an area of technology useful to its members, to assess the efforts of a particular examiner, or to participate in the creation of policies that impact its members.

Second, *ALDF* remains anomalous in that the Federal Circuit ruled that procedural standing under the Patent Act was entirely precluded under § 702 of the APA.[132] *ALDF*, however, arguably fails to scrutinize the statutory scheme of the Patent Act with the same care undertaken by the Supreme Court in *Block*, lumping together post-issuance challenges, such as civil actions related to infringement, interference, and pre-issuance challenges, such as reexamination.[133] Finally, *ALDF* conflates a range of different parties—potential competitors and public interests—into the same category. Therefore, under *ALDF* a competitor is potentially precluded from bringing a procedural standing claim under the APA in the same way as a third party is precluded from bringing a claim. Such a stringent reading of procedural standing would be in direct conflict even with the limited rules of standing outlined within the post-issuance context.

c. Other Methods of Citizen Enforcement. No equivalent to a "citizen suit" exists in patent law that permits third party participation to prevent potential violations of the relevant statute or enforce proper application of the statute. To the extent that reexamination proceedings or optional *inter partes* proceedings seek to correct errors committed by the examiners, neither of these proceedings can be seen as a pure citizen enforcement mechanism. As discussed *supra*, the scope of such examinations is limited since third party requesters can only cite to written prior art consisting of patents and prior publications.[134] Thus, a third party requester cannot submit bases for rejecting the patent application such as a failure to properly disclose under 35 U.S.C. § 112, a failure to properly disclose previous non-written uses under 35 U.S.C. § 102, or a failure to act properly before the examiner.[135] Moreover, no matter how inadequate, these mechanisms have a

---

[132] *ALDF*, 932 F.2d at 938.

[133] *See generally id.* at 938 (citing to Simon v. E. Ky. Welfare Rights Org., 426 U.S. 26 (1976)).

[134] *See* U.S. PATENT & TRADEMARK OFFICE, MANUAL OF PATENT EXAMINING PROCEDURE (MPEP) § 2206 (8th ed. 2001).

[135] *Id.* ("Thus, for example, a prior art citation cannot include a statement as to the claims violating 35 U.S.C. § 112, a statement as to the public use of the claimed invention, or a statement as to the conduct of the patent owner.").

retrospective effect—a third party could not object to potential examiner error during the prosecution of a patent.[136] The limited opportunities to challenge the adequacy of the examination process leave third parties with no option to significantly police the behavior of the examiner.

2. Transparency Mechanisms. Of the three relevant mechanisms, transparency mechanisms have been most successfully incorporated into the structure of patent law. For instance, publicly accessible information about the administrative actions of the PTO is available in various electronic formats.[137] One key exception, however, limits the transparency of the patent regime. An anemic publication requirement allows a patent to remain confidential for the entire scope of the application unless the patent applicant has filed or will file a foreign application, in which case the patent application has to be published within a period of eighteen months.[138] While the publication requirement has been generally criticized for its ability to support submarine patents (broad patents that lie dormant for a number of years and then are used to impact a mature industry), they are also damaging from a political standpoint because limited publication of

---

[136] Indeed, even a patent applicant cannot challenge potential examiner error during the prosecution of a patent. The Federal Circuit has determined that patent applicants cannot preemptively challenge the actions of an examiner under the APA. *See* Star Fruits S.N.C. v. U.S. Dep't of Commerce, 393 F.3d 1277 (Fed. Cir. 2005) (Newman, J., dissenting).

[137] *See* United States Patent and Trademark Office, Patents, http://www.uspto.gov/main/patents.htm (last visited Oct. 27, 2006). The PTO website contains significant information resources that allow users to research existing patents and publications as well as relevant laws, rules, and examining procedures. *Id.* The website further contains information about the primary administrative bodies of the PTO, including the Board of Patent Appeals and Interferences and the Patent and Trademark Office Public Advisory Committees, which are composed of diverse users of the PTO who assess the practices and procedures of the agency. *Id.*; *see* 35 U.S.C. § 5(d)(1) (2000). The public advisory committee publishes an annual report that outlines an effort to make information publicly accessible, including overall information related to the types of examinations conducted throughout the year. PTO PAT. PUB. ADVISORY COMMITTEE ANN. REP. (Nov. 30, 2005), *available at* http://www.uspto.gov/web/offices/com/advisory/acrobat/ppac_annual_rpt_05.pdf (last visited Oct. 27, 2006).

[138] 35 U.S.C. § 122(a) (2000) ("Except as provided in subsection (b), applications for patents shall be kept in confidence by the Patent and Trademark Office . . . ."); *see also* 37 C.F.R. § 1.14(a) (2005). Moreover, four types of patent applications never have to be published: (1) a non-pending patent application; (2) a patent application subject to a secrecy order for national security reasons; (3) a provisional application; and (4) a design patent application. 35 U.S.C. § 122(b)(2)(A)(i)-(iv) (2000). The publication requirement has been subject to a number of suggested reforms. *See, e.g.*, Jay P. Kesan, *Carrots and Sticks to Create a Better Patent System*, 17 BERKELEY TECH. L.J. 763, 780 (2002) ("I suggest that patent applications be published ninety days after the issuance of the first Office Action. This publication date is carefully chosen to address the concerns associated with an inordinately early publication date, such as prompt publication at the time of filing. In addition, this publication date will permit a patentee to assess her chances of getting an issued patent or preserving the option of keeping her invention a trade secret based on the results of the first Office Action.").

patent applications deprives interested constituencies of early information that would allow them to monitor a particular industry and to bring pressure to bear on the relevant decisionmaker.

II. A PARTICIPATORY PATENT BARGAIN?: REDESIGNING PATENT LAW TO SUPPORT PARTICIPATORY MECHANISMS

The absence of participatory mechanisms that support third party constituencies in patent law appears to result from the pervasiveness of one key norm in patent law—the metaphor of the patent bargain. The patent bargain has been a traditional trope of patent law. In *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, the Supreme Court noted that:

> [t]he federal patent system thus embodies a carefully crafted bargain for encouraging the creation and disclosure of new, useful, and non-obvious advances in technology and design in return for the exclusive right to practice the invention for a period of years. "[The inventor] may keep his invention secret and reap its fruits indefinitely. In consideration of its disclosure and the consequent benefit to the community, the patent is granted. An exclusive enjoyment is guaranteed him for seventeen years, but upon expiration of that period, the knowledge of the invention inures to the people, who are thus enabled without restriction to practice it and profit by its use.[139]

---

[139] Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 150–51 (1989) (quoting United States v. Dubilier Condenser Corp., 289 U.S. 178, 186–87 (1933)); *see also* Eldred v. Ashcroft, 537 U.S. 186 (2003) (mentioning the patent bargain theory and distinguishing it from copyright theory). Viva Moffat, identifying the consideration contemplated by the patent law regime, states that "the public . . . gets full disclosure of the invention by the inventor, the right to invent and patent improvements to the invention, and the right to copy the invention at the expiration of the twenty-year term." Viva R. Moffat, *Mutant Copyrights and Backdoor Patents: The Problem of Overlapping Intellectual Property Protection*, 19 BERKELEY TECH. L.J. 1473, 1483 (2004); *see also* Chiron Corp. v. Genentech, Inc., 363 F.3d 1247, 1254 (Fed. Cir. 2004) ("Thus, the public's end of the bargain struck by the patent system is a full enabling disclosure of the claimed technology."); AK Steel Corp. v. Sollac, 344 F.3d 1234, 1244 (Fed. Cir. 2003) ("However, as part of the *quid pro quo* of the patent bargain, the applicant's specification must enable one of ordinary skill in the art to practice the full scope of the claimed invention."). For a more detailed discussion of Supreme Court jurisprudence on this issue, see Shubha Ghosh, *Patents and the Regulatory State: Rethinking the Patent Bargain Metaphor After* Eldred, 19 BERKELEY TECH. L.J. 1315, 1320–21 (2004) (analyzing the development of the patent bargain metaphor within the jurisprudence of the Supreme Court).

The patent bargain presupposes a bilateral relationship between the patent owner and the government that resists third party demands. Patent bargain theory describes two acts: (1) the existence of an original inventive act that results in a potential claim of ownership on the part of the inventor;[140] and (2) the existence of a governing authority with the ability to verify ownership of the property right.[141] If we assume that the government acts for itself in the singular manner, the term "bargain" implies an exchange between two equal actors that excludes all others.

Commentators have objected to the patent bargain on three major grounds. First, commentators have contended that the metaphor of patent bargain fails to acknowledge the origins of patent law in trade policy, and therefore, fails to properly explore the interdependence of trade and patent policy.[142] Such interpretations challenge the metaphor of the patent bargain by shifting the interpretative focus from the natural rights of the inventor to the competitive needs of the governing state. Moving to a trade-based patent regime would

---

[140] John Locke's "fruits of labor" theory provides the basis for the patent bargain theory. Locke posited that property is a natural right, inhering in an inventor, because of the inventor's initial labor investment in the potential invention. *See* JOHN LOCKE, TWO TREATISES OF GOVERNMENT §§ 27–28 (Peter Laslett ed., Cambridge Univ. Press 1967) (1690); *see also* Adam Mossoff, *Locke's Labor Lost*, 9 U. CHI. L. SCH. ROUNDTABLE 155, 156–58 (2002) (analyzing the theoretical foundations of Locke's labor theory of property); Andrew R. Sommer, *Trouble on the Commons: A Lockean Justification for Patent Law Harmonization*, 87 J. PAT. & TRADEMARK OFF. SOC'Y 141, 144 (2005) (proposing that international intellectual property law adopt Locke's political theory to justify harmonization with other national regimes).

[141] American intellectual property theorists have always regarded the Lockean claim of ownership based on natural rights as paramount; however, this theoretical justification may minimize the benefits of the alternative theory offered by Jean-Jacques Rousseau. Most notably, while recognizing the existence of natural law, Rousseau rejected a property right based on a strong natural right to the fruits of labor because such a natural right did not adequately protect the rights of a property owner. An inherent natural property right grounded in an individual's labor fails, according to Rousseau, because it does not oblige others to respect that right. Rather, Rousseau posits two types of potential property rights: (1) a minimal possessory right based on natural right; and (2) public possession, which he posits is the legal title of possession enjoyed by an owner within society. *See* JEAN-JACQUES ROUSSEAU, THE SOCIAL CONTRACT 65–68 (Maurice Cranston trans., Penguin Books 1968) (1762).

[142] *See, e.g.*, DOREN S. BEN-ATAR, TRADE SECRETS: INTELLECTUAL PIRACY AND THE ORIGINS OF AMERICAN INDUSTRIAL POWER (2004); Adam Mossoff, *Rethinking the Development of Patents: An Intellectual History, 1550–1800*, 52 HASTINGS L.J. 1255, 1259–76 (2002); Srividhya Ragavan, *Can't We All Get Along?: The Case for a Workable Patent Model*, 35 ARIZ. ST. L.J. 117, 130–49 (2003) (tracing the development of trade-based policies in developing nations after World War II, using India as a primary example); Shanker A. Singham, *Competition Policy and the Stimulation of Innovation: TRIPS and the Interface Between Competition and Patent Protection in the Pharmaceutical Industry*, 26 BROOK. J. INT'L L. 363, 375–79 (2000) (examining the positive role of patent laws in generating economic markets in developing nations).

highlight the importance of harmonization with Europe and Japan, the major alternative patent systems.[143] Second, critics have argued that the patent bargain fails to adequately explain why patent law serves to protect the creative effort necessary to invent a particular product and have sought to explore the proper way to enshrine incentives for creative effort that does not rely on a natural rights philosophy.[144] Finally, the metaphor of the patent bargain, as Shubha Ghosh and others have acknowledged, fails to precisely account for a multilateral exchange between multiple parties.[145] Unlike others, however, I am not willing to completely abandon the patent bargain. The patent bargain serves a politically persuasive purpose in that it justifies to non-owners why the claims of intellectual property owners are honored.[146] Moreover, the patent bargain serves to legitimize agency behavior to its regulated parties. We can, however, relegitimize the patent bargain by invigorating the abilities of third parties to participate in the process of evaluating patents.

The question, then, is the form such a participatory bargain could take. A revised patent bargain can take two forms. First, we can structure third party participation around a *structural pluralist* model of group interaction, which stresses allowing competition among various groups to resolve conflicts around legal issues.[147] Notably, the suggested reforms contained in multiple bills proposed in

---

[143] Singham, *supra* note 142, at 379–80.

[144] *See, e.g.*, Mark A. Lemley, *Property, Intellectual Property, and Free Riding*, 83 TEX. L. REV. 1031, 1055 (2005) ("Intellectual property, then, is not a response to allocative distortions resulting from scarcity, as real property law is. Rather, it is a conscious decision to create scarcity in a type of good in which it is ordinarily absent in order to artificially boost the economic returns to innovation."); Clarisa Long, *Patent Signals*, 69 U. CHI. L. REV. 625, 636 (2002) ("Rather than conceptualizing patent law as a set of legal rules that allows individuals to privatize what would otherwise be dissipated in the public domain, I will instead consider patents as a means of credibly publicizing information.").

[145] Shubha Ghosh, *Patents and the Regulatory State: Rethinking the Patent Bargain After* Eldred, 19 BERKELEY TECH. L.J. 1315, 1345 (2004) ("Reducing patents to a bilateral exchange, as social contract theory does, fails to incorporate issues like administration and morality into the contract.").

[146] The patent bargain, then, can be seen as a political construct that supports the legitimacy of patent norms. As originally conceived by Max Weber, the concept of legitimacy seeks to answer why individuals consent to political authority. Daniel Bodansky, *The Legitimacy of International Governance: A Coming Challenge for International Environmental Law?*, 93 AM. J. INT'L L. 596, 601–03 (1999). Legitimacy can be analyzed in light of three different behavior models: (1) attitudinal approval of the rules, based upon attachment, loyalty, allegiance, and favorable effective orientation to a political regime, and enforced through normative mechanisms; (2) behavioral consent, signaled by active participation, passive acquiescence, or obedience to the political regime; and (3) cognitive orientation, which presupposes that a collective orientation to the rules will bind individuals to the ultimate outcome. Robin Stryker, *Rules, Resources, and Legitimacy Processes: Some Implications for Social Conflict, Order, and Change*, 99(4) AM. J. SOC. 847, 856–58 (1994).

[147] *See infra* notes 152–57 and accompanying text.

Congress draw on aspects of a pluralist model.[148] Alternatively, we can adopt a *deliberative democratic* model. A deliberative democratic model emphasizes consensual "radically open, potentially transformative dialogues"[149] as a source of legitimacy for an inventor to comfortably assert his rights against other competitive and public interests. I will address each in turn, stressing how each of these models would likely impact the participatory mechanisms discussed *supra*.

A. A PLURALIST PATENT BARGAIN?

1. A Framework of Structural Pluralism. The basic model that describes group participation in legal regimes is known as structural pluralism. While the term "pluralism" has at least four different definitions,[150] I refer to pluralism here as structural pluralism, which holds that access of political constituencies to neutral decisionmaking is key. Donald J. Farole, summarizing a classic structural pluralist perspective, states that:

> According to the pluralist perspective, politics is the resolution of group conflict. Groups form around common interests, and in a complex political system with multiple points of access, groups help to coordinate and provide stability to policy making. As a consequence of competition among various groups, policies emerge that are responsive at least roughly to public needs, and no single interest dominates.[151]

The agency or other decisionmaker serves to arbitrate the competing self-interests of the relevant constituencies.[152] The structural pluralist model posits that the political process benefits by providing adequate access to constituencies so that they can participate in the process; once that access is granted, the goals underlying this model have been satisfied. A classic structural pluralist perspective

---

[148] *See infra* notes 165–71 and accompanying text.

[149] Amy Bartholomew, *Human Rights and Post-Imperialism: Arguing for a Deliberative Legitimation of Human Rights*, 9 BUFF. HUM. RTS. L. REV. 25, 32 (2003).

[150] Paul H. Conn, *Social Pluralism and Democracy*, 17 AM. J. POL. SCI. 237 (May 1973). Conn identifies four types of pluralism: (1) values pluralism, which studies how societies are characterized by competing values; (2) cultural pluralism, in which societies are characterized by competing cultural groups; (3) structural pluralism, which studies how the government structures interest group participation; and (4) social pluralism, which studies how diversity of groups are organized to compete formally and informally for societal rewards. *Id.* at 237–38.

[151] DONALD J. FAROLE, JR., INTEREST GROUPS AND JUDICIAL FEDERALISM: ORGANIZATIONAL LITIGATION IN STATE JUDICIARIES 14 (1998).

[152] Guana, *supra* note 25, at 23.

is illustrated by the Supreme Court's rejection of the potentially substantive impact of § 102(c) of NEPA in *Vermont Yankee Nuclear Power Corp. v. Natural Resources Defense Council, Inc.*[153] In *Vermont Yankee*, the Supreme Court limited the scope of judicial review of agency decisionmaking under § 102(c) to whether the agency had properly followed the required agency procedures.[154]

These three mechanisms discussed above—standing, citizen suits, and transparency—reflect basic norms of structural pluralism. First, such mechanisms reflect *motivational* norms, which provide organizational groups with incentives to sustain actions that either support or contest governmental norms. For example, citizen suits often provide interested environmental groups the ability to organize around a perceived local threat and challenge that threat through a lawsuit.[155] Second, these diverse mechanisms reflect *informational* norms. These informational norms seek to provide interest groups with access to published informational sources so that the groups can assess both the methods and outcomes associated with agency decisionmaking. These norms reinforce each other—increased access to information can support the preexisting motivational aspirations of potentially interested political constituencies.

Legal regimes in the United States reflecting a structural pluralist perspective have traditionally been organized around two models. The first, the New Deal regulatory regime, exemplified three values: (1) the primary administrator was representative of diffuse public interests; (2) the agency was insulated from political and judicial oversight; and (3) there was an implicit sanctioning of informal cooperative relationships between business interests and the relevant agency.[156] The second model is a pluralist regulatory regime, of which the environmental movement (and its resulting body of law) is the predominant example. A pluralist regulatory regime centralizes policy making at the national level in three ways. First, independent agency expertise to determine specific goals is limited by specific legislative directives.[157] Second, judicial enforcement of administrative action becomes more active as review of agency action becomes

---

[153] 435 U.S. 519 (1978).

[154] *Id.* at 548.

[155] For examples of this strengthened standing, see, e.g., ANDREW JAY KOSHNER, SOLVING THE PUZZLE OF INTEREST GROUP LITIGATION 46–49 (1998) (analyzing the impact of broadened standing rules on the types of litigation brought under the Establishment Clause); Kim Lane Scheppele & Jack L. Walker, Jr., *The Litigation Strategies of Interest Groups, in* MOBILIZING INTEREST GROUPS IN AMERICA 157, 164–65 (Jack L. Walker, Jr., ed. 1991) (analyzing the impact of broadened standing claims on environmental groups' organization).

[156] GEORGE HOBERG, PLURALISM BY DESIGN: ENVIRONMENTAL POLICY AND THE AMERICAN REGULATORY STATE 29–31 (1992).

[157] *Id.* at 45–46.

more searching.[158] Third, a pluralist regulatory regime is characterized by a network of actors, such as public policy interest organizations, competing business interests, and academic actors, who are competing at range of policy levels to assert their policy interests.[159] The participatory mechanisms discussed *supra* in many ways result from the emergence of a pluralist regime in environmental law.

While the structural pluralism model is usually seen as the predominant model of group interaction, commentators have raised two criticisms about this model. First, the mechanisms discussed *supra*, may not have any real impact on the actual actions of the decisionmaker.[160] Critics have contended that substantive outcomes cannot not be obtained by simply affording access to particular groups.[161] Second, the structural pluralist model fails to account for the organizational challenges faced by social and political groups, such as low-income or minority communities that do not have access to sufficient political and economic resources to participate in agency or judicial decisionmaking.[162] Recent legal commentaries have devoted significant resources to reevaluating the structural pluralist model in light of these distributional concerns.[163] These commentaries have suggested that environmental law adopt "deliberative" mechanisms, including programs like environmental priorities projects, which seek to engage the relevant actors (government, business, non-governmental organizations, and non-aligned citizens) to assess and compare environmental

---

[158] *Id.* at 46–47.

[159] Claudia Jauβs, *The United States: Rule by Virtue of Competition, in* DEMOCRACY AT WORK: A COMPARATIVE SOCIOLOGY OF ENVIRONMENTAL REGULATION IN THE UNITED KINGDOM, FRANCE, GERMANY, AND THE UNITED STATES 129, 131–36 (Richard Munch et al., eds. 2001). *See, e.g.*, Harvey Bartlett, Comment, *Is NEPA Substantive Review Extinct, or Merely Hibernating? Resurrecting NEPA Section 102(1)*, 13 TUL. ENVTL. L.J. 411, 428–46 (2000) (summarizing jurisprudence of Supreme Court on review of agency decisionmaking under NEPA); *see also* Nicholas C. Yost, *NEPA's Promise—Partially Fulfilled*, 20 ENVTL. L. 539–49 (1990).

[160] For instance, in *Strycker's Bay Neighborhood Council, Inc. v. Karlen*, 444 U.S. 223, 231 (1980) (Marshall, J., dissenting), Justice Marshall argued that judicial review of agency action under NEPA may be necessary if a court could not assess an agency's ultimate conclusion as to the necessity of a given environmental action.

[161] In *Strycker's Bay*, 444 U.S. at 231 (Marshall, J., dissenting), Justice Marshall argued that judicial review of agency action would be "essentially mindless" if a court could not assess an agency's ultimate conclusion as to the necessity of a given environmental action. For more discussion of these issues, see Harvey Bartlett, Comment, *Is NEPA Substantive Review Extinct, or Merely Hibernating? Resurrecting NEPA Section 102(1)*, 13 TUL. ENVTL. L.J. 411, 428–46 (2000); *see also* Nicholas C. Yost, *NEPA's Promise—Partially Fulfilled*, 20 ENVTL. L. 533, 539–49 (1990).

[162] Guana, *supra* note 25, at 28.

[163] *Id.* at 37–47; *see also* Kimberly K. Smith, *Mere Taste: Democracy and the Politics of Beauty*, 7 WIS. ENVTL. L.J. 151, 189–91 (2000).

risks in a given region.[164] These mechanisms may serve to fully increase the participation of potentially disenfranchised populations.

2. Structural Pluralism in Patent Law. The recently proposed Patent Reform Acts reflect elements of a pluralist regime.[165] The Patent Reform Acts outline procedures for post-grant multiparty opposition procedures so that a person could challenge a patent claim on all validity issues, including §§ 101, 102, 103, 112, and 251 of the Patent Act.[166] The suggested opposition proceeding has elements of the structural pluralist model. The procedure at issue presupposes that the agency would serve as an arbitrator between competing parties that seek to invalidate a newly issued patent.[167] In one key respect, however, the opposition proceeding departs from a standard pluralist model since the actions of an opposer have a substantive outcome in that a successful challenge can prevent the issuance of a patent.[168]

An opposition proceeding could expand the use of two types of participatory mechanisms. Initially, the limits placed on third party standing in *Syntex* and *ALDF* may be minimized in light of a newly created opposition proceeding. Including an opposition proceeding eliminates the two primary objections to third party standing under the Patent Act. A third party claim of procedural injury in fact may be available if the right to file an appeal is included in the opposition procedures.[169] Unlike the reexamination proceeding at issue in *Syntex*, a specified

---

[164] John S. Applegate, *Comparative Risk Assessment and Environmental Priorities Projects: A Forum, Not A Formula*, 25 N. KY. L. REV. 71 (1997).

[165] Two major patent reform bills have been proposed. *See* Patent Reform Act of 2005, H.R. 2795, 109th Cong. (2005); Patent Reform Act of 2006, S. 3818, 109th Cong. (2006). The proposed Patent Reform Act is the result of a series of major reports, *supra* note 24, and an extensive series of hearings and town meetings on patent reform. *See* FED. TRADE COMM'N, A SUMMARY REPORT OF DISCUSSIONS AT TOWN MEETINGS ON PATENT REFORM (2005), *available at* http://www.ftc.gov/opp/intellect/050601summarytownmtg.pdf. For instance, the Federal Trade Commission, the National Academies' Board on Science, Technology, and Economics Policy, and AIPLA held a series of meetings in February and March 2005 on a proposed patent reform act. *Id.* at 1. These meetings, however, have been criticized for a lack of interest in the concerns of the public interest patent community. *See, e.g.*, Colette Vogele, *FTC's Patent Reform 'Town Meeting,"* http://cyberlaw.stanford.edu/blogs/vogele/archives/002943.shtml (last visited Oct. 16, 2006). The Patent Reform Act of 2006 is not as far-reaching as the Patent Reform Act of 2005. Notably, the Patent Reform Act of 2006 does not eliminate the best mode requirement. *Compare* H.R. 2795 § 118(d)(1)(b), *with* S. 318 § 118.

[166] Both bills retain significant post grant procedures. *See* H.R. 2795 §§ 321–338; S. 3818 §§ 311–323.

[167] H.R. 2795 § 321; S. 3818 § 315.

[168] H.R. 2795 § 355; S. 3818 § 320.

[169] *Id.* § 334 (outlining the process of appeal under the opposition proceeding). Notably, however, the director still retains discretion to *initiate* an opposition proceeding. *See* H.R. 2795 § 325(a)(1). As a result, the director may be able to argue that the ability to initiate a proceeding may

right of appeal would demonstrate that the statutory scheme of the Patent Act does recognize an implied private right on the part of third parties to bring a claim of procedural injury in fact.[170] Moreover, as the opposition proceeding contemplates a way in which a third party could directly confront a patent owner, the third party could contend the claimed injury would be redressable.

Likewise, adopting such procedures could potentially expand the type of standing afforded to *all* third parties under the APA. First, as under the Patent Act, the existence of an opposition proceeding would alleviate concerns over the redressability of the injury because of the direct remedy against the owner. Second, the existence of opposition proceedings would bring third parties within the zone of interests contemplated by the Patent Act. Therefore, a third party could raise a claim under § 702 of the APA because the existence of an opposition proceeding demonstrates legislative intent to bring third parties within the zone of interest contemplated by the Patent Act.[171] Demonstrating a legislative intent

---

be an agency action that is committed to agency discretion by law. *See* 5 U.S.C. § 701(a)(2) (2000). However, one of the notable differences between H.R. 2795 and S. 3818 is that § 318 of the S. 3818 clearly contemplates a process that is not limited by the Director's initiation. For instance, § 312 states that a petition for a post-grant review proceeding may be instituted if a petitioner files a cancellation petition within twelve months after the patent is issued and establishes a significant reason to believe that the continued existence of the challenged claim causes or is likely to cause the petitioner significant economic harm. S. 3818 § 312. Adopting such a provision, however, may limit claims of other non-economic types of injury.

[170] *See supra* note 87 and accompanying text.

[171] Recognizing a concentrated legislative intent to increase third party participation may allow third parties to utilize the test outlined in *Clarke v. Securities Industries Ass'n*, 479 U.S. 388 (1986). In *Clarke*, the Supreme Court, examining whether a securities trading association could sue the Comptroller for his determination that national banks could offer discount brokerage services, stated that procedural standing is only to be denied where "the plaintiff's interests are so marginally related to or inconsistent with the purposes implicit in the statute that it cannot reasonably be assumed that Congress intended to permit the suit." *Id.* at 399. The Supreme Court further refined the test in *National Credit Union Administration v. First National Bank & Trust Co.*, 522 U.S. 479 (1998), by requiring that in a "zone of interest" inquiry a court must first examine: (1) whether the interests at issue are "arguably . . . to be protected" by the relevant statutory provision; and then (2) whether the interests at issue are affected by the relevant agency action. *Id.* at 492. The scope of the *Clarke* test is in dispute. At least two circuits have argued that *Clarke* and *NCUA* should be read only to lessen the standing requirements for competitors under a relevant statute. *See, e.g.*, Dismas Charities, Inc. v. U.S. Dep't of Justice, 401 F.3d 666, 677 (6th Cir. 2005) (procedural standing under the APA was not granted to a prison services organization, in part because the organization was not a direct competitor under the relevant statute); TAP Pharms. v. U.S. Dep't of Health Serv., 163 F.3d 199, 207 (4th Cir. 1998) ("The Court's discussion of its prior zone of interests cases in *NCUA* thus suggests that a party who is not expressly subject to a statute's provisions can only pass the zone of interests test if it asserts the interests of a competitor of the subject class."). By contrast, the Third Circuit has applied liberal review to claims of procedural standing under the APA. *See* Davis v. Philadelphia Hous. Auth., 121 F.3d 92, 100 (3d Cir. 1997) (procedural standing was granted to successor tenants of formerly federally owned property under the Lead-Based Paint Poisoning

to increase the abilities of third parties may defeat the claim of *ALDF* that the statutory scheme of the Patent Act precludes third parties from seeking review under the APA. The existence of opposition proceedings, then, may have a significant impact on the types of claims that may be made by third parties.

Besides potentially expanding the scope of standing claims that can be made by a third party, amending the Patent Act to include opposition proceedings may create a "citizen suit" type proceeding by permitting potential third parties to significantly challenge aspects of the initial assessment of the patent. The contemplated opposition proceeding, nevertheless, is unlike a citizen suit in two key respects. First, like reexamination proceedings and optional *inter partes* proceedings, an opposition proceeding still only has retrospective effect since third parties cannot challenge examiner error during the prosecution of the patent.[172] Second, the opposition proceeding can only correct examiner error, so third parties cannot challenge other types of agency actions.[173] For example, a third party, seeking to monitor the quality of a relevant patent, may want to correct a typographical error in the patent. The Patent Act, however, only allows the patent owner or the PTO the ability to correct various mistakes.[174] Amending a potential patent allowing third parties to correct these types of errors would be more akin to the citizen enforcement mechanisms used in environmental law. The failure of current patent reform to include these expanded third party mechanisms leaves the project of increasing third party participation an incomplete one.

B. A DELIBERATIVE PATENT BARGAIN?

1. A Framework of Deliberative Proceduralism. A more radical alternative for reinvigorating the patent bargain than the structural pluralist model is the theory of discursive or deliberative democracy. Here, I turn to a framework of deliberative or discursive proceduralism, a theory originated by Jurgen Habermas and refined by other prominent scholars. At its simplest, deliberative

---

Prevention Act, although the successor tenants were not the intended beneficiaries of the Act because their claims for damages were closely related to the purposes of the Act, and granting standing would not interfere with the regulatory scheme under the Act); Schering Corp. v. FDA, 51 F.3d 390, 395–96 (3d Cir. 1995) (procedural standing under the APA was granted to a competing manufacturer who was not the direct subject of regulatory action because the manufacturer's competitive interests were consistent with the relevant statute).

[172] *See supra* note 136 and accompanying text.

[173] *Id.*

[174] *See* 35 U.S.C. § 254 (2000) (allowing the Director to correct mistakes to an issued patent); *id.* § 255 (allowing patent owner to petition to clerical or typographical mistakes); *id.* § 256 (allowing Director or petitioning owner or relevant assignees to correct the named inventor).

proceduralism insists that democratic institutions obtain legitimacy by undertaking deliberative procedures that allow the widest range of arguments to come into play under the fairest bargaining conditions.[175] A deliberative principle may serve to reinvigorate the patent bargain, since deliberative procedures would potentially allow the most participants to negotiate using the most accessible procedures.

Habermas' proceduralism revolves around a number of interlocking premises that build cumulatively to the above conclusion. I will briefly summarize these basic premises. Initially, Habermas relies on a complex theory known as "communicative rationality," which seeks to coordinate communicative interactions in social settings.[176] Communicative rationality is based upon the belief that individuals are working towards a mutual understanding of claims that can be accepted or opposed by the relevant audience.[177] If communicative rationality exists, such claims can be justified and tested within a dialogue on the validity of that claim.[178] This creates what is known as an ideal speech situation.[179] Habermas contrasts communicative rationality to what he terms strategic action. Strategic action exists where an actor pursues his own selfish, egocentric calculations of interests; an individual's participation in economic activities is the archetypical strategic action.[180] For Habermas, communicative rationality can be compromised by the breakdown of a shared "background knowledge" that actors

---

[175] JÜRGEN HABERMAS, BETWEEN FACTS AND NORMS: CONTRIBUTIONS TO A DISCOURSE THEORY OF LAW AND DEMOCRACY 278, 279–79 (William Rehg trans., 1996). For a review of the major articles on deliberative proceduralism, *see* DEMOCRACY (David Estlund ed., 2002). Although these terms—discursive or deliberative—can be used, I will for ease of reference refer to these processes as deliberative.

[176] *Id.* at 17–18. Habermas' theory of communicative rationality identifies three types of rational reasoning: instrumental, communicative, and strategic. Baxter, *supra* note 29, at 209. While instrumental action is merely the "solitary performance of a task according to 'technical rules,' " strategic and communicative reasoning revolve around how individuals reason within social contexts. *Id.* Habermas posits that communicative and strategic action is oppositional. JÜRGEN HABERMAS, MORAL CONSCIOUSNESS AND COMMUNICATIVE ACTION 134 (Christian Lenhardt & Shierry Weber Nicholsen trans., MIT Press 1990). According to Habermas,

> [c]ommunicative action can be understood as a circular process in which the actor is two things in one: an *initiator* who masters situations through actions for which he is accountable and a *product* of the traditions surrounding him, of groups whose cohesion is based on solidarity to which he belongs, and of processes of socialization in which he is reared.

Id. at 135.

[177] HABERMAS, *supra* note 175, at 18.

[178] Baxter, *supra* note 29, at 214.

[179] HABERMAS, *supra* note 176, at 89.

[180] "In strategic action, by contrast, actors are oriented toward 'success,' as measured by their 'egocentric calculations' of interest." Baxter, *supra* note 29, at 210.

in a diverse society bring to bear in determining the outcome of a relevant issue.[181] As societies become characterized by diverse ethical, religious, ethnic, and social experiences, the risk of disagreement becomes stronger, and thus the opportunities for genuine communicative action become rarer.[182] This growing diversity creates incentives for individuals to act strategically in a self-interested way, thus further undermining communicative rationality.[183] This purely strategic action within a pluralist society fails to adequately stabilize a frayed social order, since it is often removed from any particular ethical content.[184]

Habermas argues, however, that legal norms serve a socially integrating function, thus overcoming the fragmentation of society.[185] Law serves, in Habermas' words, as a kind of "transmission belt" that transforms everyday social interaction into an abstracted binding form.[186] The legal order, however, is compromised by a dual nature. It operates coercively to bind the actions of those actors, who do not believe in its normative values and are merely acting strategically, and performatively, because actors comply because they view the law as outlining valid normative principles that should properly regulate their existence.[187] Given these tensions, the legal order faces a crisis of legitimacy.[188] Such a crisis is best resolved by adopting a process that creates opportunity for substantive deliberation.[189]

Deliberative democracy, argues Habermas, reconciles the tensions in the legal order by using elements of the two major political philosophies—liberalism and republicanism.[190] Deliberative democracy reconciles the importance placed on

---

[181] Habermas refers to this basic "background knowledge" as the "lifeworld." *Id.* at 21. According to Habermas, the lifeworld "forms the *context* for the process of reaching understanding but also furnishes *resources* for it." HABERMAS, *supra* note 176, at 135.

[182] HABERMAS, *supra* note 175, at 25.

[183] *Id.*

[184] *Id.*

[185] *Id.* at 39, 83, 448.

[186] *Id.*

[187] *Id.* at 448; *see also* Baxter, *supra* note 29, at 238. Habermas' outline of these structural tensions reveals a larger theoretical aspect of his project—his attempt to undertake a philosophical inquiry that mediates the difference between norms, those regulative principles that bind individuals together, and facts, the empirical accounts of social realities. *See* Abdollah Payrow Shabani, *Habermas' Between Facts and Norms: Legitimizing Power?*, *available at* http://www.bu.edu/wcp/Papers/Poli/PoliShab.htm (last visited Oct. 27, 2006) ("The *internal* aspect of this tension can be seen between law as demarcating the range of one's actions and choices, which are social facts, and law as connected with a universalizable principle of rights, which is the source of law's legitimacy.").

[188] HABERMAS, *supra* note 175, at 488.

[189] *Id.*

[190] HABERMAS, *supra* note 175, at 454. Habermas views his discourse theory as reconstructive since it reconciles two competing political philosophies: the liberal tradition and the civic republican theory. *Id.* Habermas views these systems as addressing three different ways in which an individual

basic liberal rights with a legitimacy derived from the democratic action of active citizens.[191] Habermas' deliberative model is characterized by four elements: (1) citizenship that is defined by a "testing" by which citizens determine the basic rights which they mutually accord each other; (2) a legal order that bases its legitimizing norms on reciprocity, a mutual observance of rights and duties; (3) procedural conditions that ensure a wide array of arguments in deliberation and in secure fair bargaining conditions; and (4) a democratic process that depends upon "the institutionalization of the corresponding procedures and conditions of communications, as well as on the interplay of institutionalized deliberative processes with informally developed public opinions."[192]

Habermas, in *Between Facts and Norms*, does not fully outline what he considers procedures that would constitute a deliberative process. He cites, with reservations, six procedures suggested by Joshua L. Cohen:

- Process of deliberation takes place in argumentative form, through the regulated exchange of information and reasons among parties who introduce and critically test proposals[;]
- Deliberations are inclusive and public so that all of those who are possibly affected by the decisions have equal chances to enter and take part[;]
- Deliberations are free of any external coercion[;]
- Deliberations are free of any internal coercion that could detract from the equality of the participants[;]

---

can achieve optimal political autonomy. Habermas argues the individual autonomy of a citizen is the primary goal within a liberal state. JEAN L. COHEN & ANDREW ARATO, CIVIL SOCIETY AND POLITICAL THEORY 398 n.109 (1992). Therefore, the status of citizen is defined by negative rights (i.e., the classical rights to life, liberty, and property) that the individual is free to exercise without interference from the political sphere. *Id.* at 398. This focus on private autonomy is reinforced by a legal order that seeks to define the rights of each individual in every case; procedural conditions, which envision a contest between competing interests seeking the optimal conditions in a separate political sphere, and a democratic process that is seen as an effective way to manage competing interests administratively through a simple voting process. HABERMAS, *supra* note 175, at 269, 270–74, 296. By contrast, republican theory recognizes that, in a publicly autonomous society, citizens act deliberately to "develop existing relations of reciprocal recognition into an association of free and equal citizens." *Id.* at 269. Republican theory is expansive in the sense that citizen rights guarantee not only freedom from governmental interference but the positive right to participate in the constitutive process. *Id.* at 270. Democratic processes in republican theory are conceived primarily as participatory discourses. *Id.* at 270–71. These participatory discourses are based on ethicopolitical self-understanding wherein citizens share a common background that aids them in their constitutive decisionmaking. *Id.* at 269–70.

[191] *Id.* at 450.

[192] *Id.* at 271, 273–74, 279, 298.

- Deliberations aim in general at rationally motivated agreement and can in principle be indefinitely continued or resumed at any time[;] and
- Political deliberations extend to any matter that can be regulated in the equal interest of all.[193]

These procedures, collectively, fall into two categories: fairness and competence.[194] Fair procedures seek to define "what people are permitted to do in a deliberative policy-making process."[195] Two characteristics of these listed procedures would ensure fairness. First, the procedures are horizontal in that all participants are treated equally within the process, with equal chances to enter, submit information, and criticize the participation of others. Second, the procedures are non-coercive in that deliberations are free of any external or internal coercive behavior. For example, a non-coercive action would be to decide the final procedure for determining outcomes before the beginning of the deliberative process so that individuals do not feel as if they are coerced into an action where the outcome is uncertain.[196] Competence, on the other hand, seeks to ensure that "the best possible understandings and agreements given what is reasonably knowable to the participants at the time the discourse takes place."[197] Those listed procedures are directed towards increasing transparency so as to ensure competent deliberative procedures. For instance, transparency—the ability of individuals to effectively access the relevant information so that the deliberations are inclusive, public, and open-ended—allows all parties to participate equally.

---

[193] Some of these procedures have been restated for clarity. HABERMAS, *supra* note 175, at 305–06. Habermas disputes Cohen's conception of a society as one that is "deliberatively steered" and states that his procedures underestimate an active public sphere. *Id.* at 305, 307. Habermas also cites with approval Robert Dahl's indicators of democratic procedures:

> (a) the inclusion of all affected; (b) equally distributed and effective opportunities to participate in the political process; (c) an equal right to vote on decisions; (d) an equal right to choose topics, and more generally, to control the agenda; and (e) a situation that allows all the participants to develop, in the light of sufficient information and good reasons, an articulate understanding of the contested interests and matter in need of regulation.

Id. at 315 (citing ROBERT A. DAHL, A PREFACE TO ECONOMIC DEMOCRACY 59 (1985)).

[194] Thomas Webler & Seth Tuler, *Fairness and Competence in Civic Participation: Theoretical Reflections From a Case Study*, 32 ADMIN. & SOC'Y 566, 568 (2000).

[195] *Id.* at 569.

[196] *Id.*

[197] *Id.* at 571.

Various procedures have been utilized in different contexts.[198] Given these diverse procedures, I will focus on one category: those involving public scientific decisionmaking. I do so because the patentability decisions made by the PTO are part of a larger project of assessing scientific and technical information for societal use. Scientific decisionmaking processes exist on many different levels, among them: academic peer review, which seeks to link new ideas within an ongoing discourse mediated by journals and peer conferences; international, national and regional policy organizations, which coordinate the interests of

---

[198] Legal scholars have begun to substantively address questions associated with deliberative democracy, although analysis of already existing projects is limited. *See, e.g.*, ETHAN J. LEIB, DELIBERATIVE DEMOCRACY IN AMERICA: A PROPOSAL FOR A POPULAR BRANCH OF GOVERNMENT (2004) (proposing a fourth branch of government to make laws using randomly selected civic juries, wholly displacing the referendum and initiative systems as they exist today); Pablo de Greiff, *Deliberative Democracy and Punishment*, 5 BUFF. CRIM. L. REV 373 (2002) (discussing the relationship between criminal punishment and deliberative democracy procedures). Michael Froomkin's analysis of the Internet Engineering Task Force (IETF), a standard-setting organization that resolves all immediate protocol and architecture issues affecting the functionality of the Internet, is a useful example of a flexible deliberative process. *See* A. Michael Froomkin, *Habermas@Discourse.Net: Toward a Critical Theory of Cyberspace*, 116 HARV. L. REV. 751, 786–87 (2003); *see also* The Internet Engineering Task Force, http://www.ietf.org (last visited Oct. 27, 2006). The Internet Engineering Task Force is organized around working groups, which propose, analyze, and test draft protocol standards. Froomkin, *supra*, at 786–87. Froomkin's analysis of the IETF demonstrates that the IETF working groups enacted several mechanisms that create a deliberative process. First, to ensure fairness the IETF working groups: (1) opened meetings "to anyone with the ability to attend meetings"; (2) allowed individuals to participate in email discussion; (3) disclosed the protocol standards to all interested participants; and (4) allowed more than one group to test the suggested protocols. *Id.* at 799–804. Second, the ITEF process incorporated argumentative elements. *Id.* at 802. Participants have sufficient expertise in their fields and can offer informed arguments on issues related to the proposed protocol. *Id.* Moreover, the argumentative process itself was structured consensually, in that the participants, rather than voting on a given proposal, reached a "rough consensus." *Id.* at 801.

The political science literature has also analyzed deliberative projects undertaken at the municipal and state levels. For example, Archon Fung and Erik Olin Wright have examined a number of projects including: (1) the participatory fiscal management projects in the cities of Porto Alegre, Brazil, and West Bengal, India, which enable residents of the relevant cities and villages to participate in fiscal management; (2) neighborhood governance councils in Chicago that address "policing and public schools"; (3) transition councils, such as the Wisconsin Regional Training Program, which brings together "organized labor, large firm management, and government" to ease employment transition; and (4) environmental planning such as habitat conservation planning under the Endangered Species Act that "convenes stakeholders and empowers them to develop ecosystem governance arrangements." Archon Fung & Erik Olin Wright, *Experiments in Empowered Deliberative Democracy: Introduction*, June 1999, http://www.ssc.wisc.edu/~wright/deliberative.html; *see also* Colleen M. Grogan & Michael K. Gusmano, *Deliberative Democracy in Theory and Practice: Connecticut's Medicaid Managed Care Council*, 5 ST. POL. & POL'Y Q. 126 (2005) (examining Medicaid reform in Connecticut, where the state legislature created an interactive Medicaid Managed Care Council to ensure that reform was effectively implemented).

institutional and corporate interests; and temporary advisory panels, which assess new sciences and technologies.[199] Scientific decisionmaking is often more difficult than other types of deliberative processes because a tension exists between reconciling the need for technical expertise within a given subject area with the need for a broad-based societal use for that information.[200]

Four different types of deliberative processes are common in the scientific context: citizen juries, consensus conferences, participatory design, and citizen science shops.[201] Citizen juries seek to involve the public by allowing a panel of diverse constituencies to consider a number of expert-generated scenarios on a relevant topic.[202] These panels are allowed to question the experts as well as suggest changes to the expert-generated scenarios.[203] In consensus conferences, policy makers and citizens meet over a series of days or weekends on a given topic.[204] The initial meetings are typically devoted to teaching the lay participants key issues related to the topic as well as selecting the relevant experts who will testify at a final series of meetings to determine the recommended citizen outcome.[205] The citizens then prepare a report of the proceedings for the relevant administrative decisionmaker.[206] Participatory design allows citizens to participate in the development of socially relevant design.[207] Citizen science shops are research groups that offer free access to public interest organizations, thus serving as intermediaries between universities and social groups with specific questions

---

[199] *See, e.g.*, T. Dixon Long, *The Government of Science: A Comparative Approach*, 1 SCI. STUD. 263 (1971) (outlining and analyzing the functions of different science policy making bodies).

[200] ALAN IRWIN, CITIZEN SCIENCE: A STUDY OF PEOPLE, EXPERTISE, AND SUSTAINABLE DEVELOPMENT 26–31 (2002).

[201] Patrick N. Hamlett, *Technology Theory and Deliberative Democracy*, 28 SCI., TECH. & HUM. VALUES 112, 118–21 (2003).

[202] *Id.* at 119.

[203] *Id.*

[204] *Id.*; *see generally* David H. Guston, *Evaluating The First U.S. Consensus Conference: The Impact of Citizens on Telecommunications and The Future*, 24 SCI., TECH. & HUM. VALUES 451 (1999) (outlining the procedures related to consensus conferences within the European context); PUBLIC PARTICIPATION IN SCIENCE: THE ROLE OF CONSENSUS CONFERENCES IN EUROPE (Simon Jose & John Durant eds., 1995).

[205] Hamlett, *supra* note 201, at 119.

[206] *Id.*

[207] *Id.*; *see generally* Randall Trigg, Susan Irwin Anderson & Elizabeth Dykstra-Erickson, eds., *PDC 94: Proceedings of the Participatory Design Conference* (1995).

about a relevant topic.[208] Moreover, advisory panels themselves have begun to incorporate deliberative processes.[209]

Commentators have found a number of common elements that reinforce the success of the deliberative scientific decisionmaking process.[210] First, understanding the impact of the timing of the interactive process is key to structuring design of a particular project. Early access for the participants to a chosen interactive process may lead to a more successful outcome.[211] For example, Robert Futrell, examining the disposal of chemical weapons by the United States Army, concluded that the initial difficulties associated with the review process could be traced to the failure to include the affected communities (located in Utah and Kentucky) earlier in the process.[212] The importance of early inclusive procedures, however, may be limited if non-deliberative administrative procedures predominate later in the review process. Jurian Edelenbos, examining a municipal design project in the Netherlands, concluded that even if temporary interactive procedures are adopted at the beginning of the process, the impact of these deliberative processes are lessened by the time the administrative sponsor considers the final product.[213] Edelenbos' work demonstrates the importance of embedding deliberative processes throughout the entire administrative process.

Second, the type of public engagement contemplated has important consequences. Two theorists, Gene Rowe and Lynn Frewer, identify three types of public engagement: (1) communicative engagement, in which information is "conveyed from the sponsors of the initiative" to the public and thus

---

[208] Joseph Wachelder, *Democratizing Science: Various Routes and Visions of Dutch Science Shops*, 28 SCI., TECH. & HUM. VALUES 244, 252–54 (2003) (outlining history of science shops). Examining the history of science shops, Wachelder concludes that while science shops have served a significant role in providing information to Dutch public interest groups, the role of these organizations is currently limited as a result of financial difficulties and withdrawal of support from sponsoring institutions. *Id.* at 255–57.

[209] Gene Rowe et al., *Evaluation of a Deliberative Conference*, 29 SCI., TECH. & HUM. VALUES 88 (2004) (analyzing the efficacy of deliberative procedures undertaken by advisory panels associated with the United Kingdom Food Standards Agency to assess the presence of excessive radiation in food).

[210] A number of case studies have examined how organizations have applied deliberative procedures within the context of scientific discourse. *See, e.g., id.* at 142–43 (analyzing the deliberative procedures used by New Zealand's Royal Commission on Genetic Modification); Robert Futrell, *Technical Adversarialism and Participatory Collaboration in the U.S. Chemical Weapons Disposal Program*, 28 SCI., TECH. & HUM. VALUES 451 (2003) (analyzing the deliberative process undertaken with regard to the U.S. Chemical Weapons Disposal Program); Rowe et al., *supra* note 209.

[211] Futrell, *supra* note 210, at 462; *see also* Rowe et al., *supra* note 209, at 93 ("The participants should be involved as early as possible in the process, as soon as value judgments become salient.").

[212] Futrell, *supra* note 210, at 472–73.

[213] Jurian Edelenbos, *Institutional Implications of Interactive Governance: Insights from Dutch Practice*, 18 GOVERNANCE: AN INT'L J. POL'Y ADMIN. & INSTITUTIONS 111, 123 (2005).

contemplates passive public reception of information; (2) consultative engagement, in which information is "conveyed from members of the public to the sponsors of the initiative following a process *initiated by* the sponsor"; and (3) participatory engagement, where information is "exchanged between the members of the public and the sponsors."[214] Each of these types of engagement contains potentially deliberative elements. For instance, given the pervasiveness of electronic media, transparency of publicly available information can add a deliberative potential to communicative engagement. However, a number of commentators have noted that interactive governance facilitated by electronic medium is limited by preexisting government norms that may limit the impact of transparency initiatives.[215] Consultative engagement has the potential of allowing the governmental sponsor to learn more information about a given option. Neither one of these options, however, has the potential of changing the other parties' initial perspective through argumentative means; such a dialogue is only made possible through participatory engagement.

Linked to the issue of how participation is structured is who should participate in the deliberative process. While fairness may be an important value, mediating the relationships in an efficient manner could result in different levels of standing to participate in certain processes as opposed to others.[216] Formal and informal

---

[214] *See* Gene Rowe & Lynn J. Frewer, *A Typology of Public Engagement Mechanisms*, 30 SCI., TECH. & HUM. VALUES 251, 254–55 (2005). Further, Rowe and Frewer define "sponsor" as "the party commissioning the engagement initiative, which will usually—but not always—be a governmental or regulatory agency, although representatives of the public may sometimes *be* the sponsors." *Id.* at 254.

[215] Wilson Wong and Eric Welch investigated the use of e-government measures by fourteen nations and concluded that "[t]he effect of e-government on accountability of public organization is affected both by the civil service system within which it is embedded and by its agency-specific organizational characteristics." Wilson Wong & Eric Welch, *Does E-Government Promote Accountability? A Comparative Analysis of Website Openness and Government Accountability*, 17 GOVERNANCE 275, 289 (2004). J. Woody Stanley and Christopher Weare, analyzing the interactive process associated with the 2010 Strategy and Planning Process conducted by the Federal Motor Carrier Safety Administration, reached a similar conclusion. J. Woody Stanley & Christopher Weare, *The Effects of Internet Use on Political Participation*, 36(5) ADMIN. & SOC'Y 503, 522 (2004) ("Comments from the written docket and Web-based discussion were considered at the draft stage and the subsequent revision, yet manager comments indicate that neither had a significant impact on the final plan . . . .").

[216] Crafting clear participation guidelines is a difficult aspect of a deliberative design. For an interesting discussion within the context of sustainable development, see Peter Moser, *Glorification, Disillusionment or the Way into the Future? The Significance of Local Agenda 21 Processes for the Needs of Local Sustainability*, 6(4) LOC. ENV'T 453, 464 (2001) ("Participation dilemma (participation overkill): the comprehensive requirement for participation in Agenda 21 ties up powerful resources that are solely dedicated to information and co-operation. This weakens content (consent/comprise is put before sustainability) and becomes tiresome for the working groups (this itself becomes an empty phase). On the other hand, insufficient participation means that inadequate attention is paid to certain

requirements can complicate attempts at deliberative dialogues. For example, during its analysis of the use of genetically modified foods, the Review Committee on Genetic Modification (RCGM), required to follow formalized administrative practices, only recognized individuals designated as "interested parties" to testify at the formal hearings. Interested parties were defined as those persons "with 'an interest in the inquiry apart from an interest in common with the public' "; all of the 117 persons who testified at the formal hearings were organizations or representatives of organizations.[217] The RCGM attempted to alleviate this perceived inequality for other potentially interested parties by holding a number of subsidiary consultative processes, including fifteen meetings in different regions and a number of forums based on the practice of the Maori indigenous populations.[218] Additionally, informal social practices may prevent full participation, such as deliberative procedures that exclude individuals based on social identities that remain unacknowledged in the deliberative process as well as perceived incompetence about the relevant subject matter.[219] Although deliberative procedures would ideally incorporate every interested party equally, it appears that determining the boundaries of who can participate is key to any deliberative process.

2. Deliberative Proceduralism in Patent Law. The current patent regime resists incorporating any of these elements. First, as noted *supra*, third parties are not included during the prosecution of a patent. Moreover, current third party review options—reexamination proceedings and *inter partes* reexamination proceedings—have been subject to withering criticism because of what Robert Merges and Joseph Farrell have termed "agenda control," which is the ability of the inventor to control the outcome of the proceedings after the initial submission of the potential challenger.[220] This control over the proceedings arises from the ability of the patent owner to strategically advance their interests unchallenged from the beginning of the prosecution. Second, the current patent regime is characterized by the most minimal type of engagement, as outlined by Rowe and Frewer: public communication, in which the public, is seen as passive

---

democratic interests.").

[217] Sally Davenport & Shirley Leitch, *Agoras, Ancient and Modern, and a Framework for Science-Society Debate*, 32 SCI. & PUB. POL'Y 137, 147 (2005) (quoting RCGM website, http://www.gmcommission.govt.n2/inquiry/decs_app_interestedperson_1708.html).

[218] *Id.* at 147–48.

[219] Marian Barnes et al., *Constituting 'the Public' in Public Participation*, 81 PUB. ADMIN. 379, 392–93 (2003).

[220] Joseph Farrell & Robert P. Merges, *Incentives to Challenge and Defend Patents: Why Litigation Won't Reliably Fix Patent Office Errors and Why Administrative Patent Review Might Help*, 19 BERKELEY TECH. L.J. 943, 965–66 (2004).

recipients of a bargain that already has been negotiated by the patent owner and the government.

Notably, both versions of the Patent Reform Act contemplate a higher engagement from third parties: consultative engagement. In the House version, H.R. 2795, § 122(e) of the Patent Reform Act would allow any third party to submit evidence of "any patent, published patent application or other publication of potential relevance" for consideration and inclusion in a patent application either six months after the patent is published or rejected, whichever comes first, or before the notice of allowance.[221] This submission could be accompanied by a concise statement of its relevance.[222] The Senate version, S. 3818, adopts similar procedures as those contained in H.R.2795.[223] Additional third party submission of the patent would presumably provide patent examiners with a better ability to identify relevant prior art and other relevant information. Nevertheless, third party review as contemplated by either Patent Reform Act is not fully participatory. Argumentative discourse is significantly constrained. Contemplated submissions can only direct the examiners to the patents, published applications, or other relevant publications. Moreover, third parties are not allowed to respond to any arguments made by either the patent examiner or the claimant or appeal if the examiner fails to adequately address the submitted prior art.[224]

Given these limitations, a number of commentators have suggested that a truly deliberative process would be a community patent or peer review system that uses peer review[225] to fully incorporate an analysis of the person having ordinary skill in the art (PHOSITA) into the prosecution of a patent.[226] A peer review system would have the benefit of grounding a dialogic process in specific time period. Moreover, a peer review system would identify who could participate within the course of a given proceeding if it was undertaken by third parties with

---

[221] H.R. 2795 § 122(e)(1). By contrast, the current Patent Act only offers a limited opportunity to cite relevant prior art to the examiner within the context of a potential reexamination proceeding. *See* 35 U.S.C. § 301 (2005).

[222] H.R. 2795 § 122(e)(2)(A).

[223] S. 3818 § 7(e)(1).

[224] H.R. 2795 § 122(e)(2); S. 3818 § 7(e)(1).

[225] Peer review of submitted articles typically consists of two levels of reviews: (1) a designated number of referees; and (2) an editorial staff that initiates the review process. Chris Harrison, *Peer Review, Politics and Pluralism*, 7 ENVTL. SCI. & POL'Y 357, 360–61 (2004) (analyzing the editorial peer review process).

[226] The most prominent project to date supporting a peer to peer patent review is the Peer to Patent Project, which supports community review of patents. *See* Beth Novocek et al., *"Peer to Patent": A Proposal for Community Peer Review of Patents, available at* http://peertopatent.jot.com/WikiHome (last visited Oct. 27, 2006); *see also* Rebecca S. Eisenberg, *Obvious To Whom? Evaluating Inventions From the Perspectives of PHOSITA*, 19 BERKELEY TECH. L.J. 885, 901 (2004) (analyzing the impact of peer review practice on the PTO).

relevant experience within a given field. Such an undertaking would not be seen as a particularly onerous one. The patent examiner would simply have to publish an outline of the likely PHOSITA. Interested participants could determine whether they fulfill those qualifications and participate by responding to arguments raised by the examiners. A peer review system would formally embed the institutional commitment to a dialogic process in two significant ways. First, a broader range of opinions would be presented to the examiner. Second, unlike the merely consultative engagement contemplated by current patent reform, the argumentative dialogue could actually lead to a more complete universe of relevant information that reflects the expertise associated with a relevant invention.

Despite these potential reforms, adopting deliberative procedures to formalized administrative discourses faces significant barriers. As an initial matter, the adversarial process of the law encourages "strategic interaction, to reach a favourable outcome" so that "truth-finding is not necessarily a cooperative but rather a competitive enterprise."[227] The model of structural pluralism rewards these types of strategic actions, seeing this competitive interaction as central to organizing group behavior. Additionally, administrative discourses are inherently coercive because government agencies can bind unwilling parties to their ultimate decisionmaking.[228] Most importantly, the rules for the argumentative structures in the administrative arena may not be as open-ended as contemplated within a truly deliberative method. Instead, administrative processes are characterized by a closed sequence of procedures that limit potential parties, argumentative methods, and topics for discussions.[229] The Federal Circuit's reluctance to allow an open-ended administrative challenge under the APA to examination procedures points to this preference within administrative regimes. For example, in *Star Fruits*,[230] the Federal Circuit, examining the challenge of a patent applicant to an examiner's request for information, held that a party under the APA cannot preemptively challenge the PTO's patentability determination. In order to undertake a challenge under the APA, a patentee had to await a statutory rejection and then litigate the propriety of the act in the relevant administrative forum, such as the BPAI, before pursuing such an option in district court.[231] In dissent, Judge Newman noted that this requirement was onerous to the extent that such a process "bypasses and forecloses" APA

---

[227] Peter Bal, *Discourse Ethics and Human Rights in Criminal Procedure*, *in* HABERMAS, MODERNITY AND LAW 71, 79 (Mathieu Deflem ed., 1996).

[228] *Id.*

[229] *Id.*

[230] Star Fruits S.N.C. v. U.S. Dep't of Commerce, 313 F.3d 1277 (Fed. Cir. 2005).

[231] *Id.* at 1284.

procedures and would require a relevant party to undertake a costly and overly complicated challenge to major interpretative changes made the patent community.[232] *Star Fruits* creates a closed examination process, wherein potential statutory errors cannot be corrected before grant of the patent, further limiting agency accountability.[233]

If adopted, the model of deliberative proceduralism could potentially impact third party participation in a patent regime by emphasizing transparency as the predominant participatory mechanism. A deliberative perspective is much more interested in establishing the transparency of government action than a structural pluralist model. By allowing more individuals to participate in the examination process, a deliberative exchange may subject a patent to a more rigorous review than from a sole patent examiner and his or her supervisors. Although patent examiners are required to have expertise in a particular area, practitioners, competitors, academics, and other interested parties may be more capable of completing the reconstructive history of the relevant art necessary to determine a patent's actual inventiveness. Indeed, a deliberative exchange would create a more complete administrative record of a patent for a court to exercise review under the APA. Moreover, a more transparent process would potentially strengthen the perceived legitimacy of the PTO.

The benefits of a transparent deliberative regime, however, may negatively affect the strengthened standing claims enjoyed in a structural pluralist regime. While a wider number of interests may participate in a deliberative process, their interests may be more diffuse and less concentrated on obtaining a particular policy outcome. Given the diffuse nature of these interests, the type of standing afforded to third parties is not very clear within the deliberative exchange. Any type of community patent may want (much like the RCGM's efforts) to distinguish between the types of parties within any given deliberative process. A key revision to the third-party review contemplated by § 122 of the Patent Reform Act of 2005, will potentially allow a range of interests to participate as third party submitters, but would also allow designated entities the right to apply for a "full" status that would include a right of appeal to challenge the conclusions reached by a patent examiner.

IV. CONCLUSION

Clarity is not always a premium during the often messy legislative process. Including elements of both models discussed above without thinking through the unique consequences of each model, however, may confuse rather than clarify the

---

[232] *Id.* at 1286.
[233] *Id.*

nature of third party participation in patent law. For example, if third party review of § 122 includes a peer review patent proceeding, then a significant question exists over whether an expanded opposition proceeding is even necessary, given the expanded opportunity to comment during the prosecution. Moreover, to the degree that opposition proceedings have the potential to create stronger standing claims for third parties over the long-term, then adopting deliberative procedures may not substantively increase third party participation beyond the initial prosecution of the patent. Any patent reform must take into account the differences between these two models and seek to clarify exactly what type of third party participation is contemplated.