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Whose Discovery Rules Shall Apply?: Resolving the Circuit Split Involving 35 U.S.C. § 23 and 35 U.S.C. § 24

Thomas C. Walsh

THOMAS C. WALSH

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ABSTRACT

When courts ignore the plain meaning of statutes, they fail to interpret the statutes in accordance with the objective intent of Congress. This has happened in relation to 35 U.S.C. §§ 23 and 24, which are statutes governing discovery rules for proceedings within the United States Patent and Trademark Office's courts. As a result, the law has been in a state of flux for nearly fifty years.

In 1952, Congress passed the Patent Act of 1952. As part of the Act, Congress passed 35 U.S.C. § 23, which gives discretionary authority to the Director of the United States Patent and Trademark Office to create discovery rules for proceedings within the United States Patent and Trademark Office's courts, and 35 U.S.C. § 24, which mandates that the Federal Rules of Civil Procedure apply under certain circumstances and that federal district courts are to become involved in proceedings before a court within the United States Patent and Trademark Office's courts. Until 1971, the federal district courts did not have trouble reconciling these seemingly conflicting statutes because no discovery rules had been created by the United States Patent and Trademark Office's courts to apply. Thus, the Federal Rules of Civil Procedure applied. However, in 1971, the Director created discovery rules for the United States Patent and Trademark Office courts. This caused the federal district courts to have difficulty reconciling 35 U.S.C. § 23 with 35 U.S.C. § 24. The federal district courts began to defer to the discovery rules created for the United States Patent and Trademark Office's courts rather than deferring to the plain meaning of 35 U.S.C. § 24.

This deferential interpretation is the Narrow View of a federal district court's powers under 35 U.S.C. § 24, while the plain meanings of 35 U.S.C.

§§ 23 and 24 represent the Broad View of a federal district court's powers under 35 U.S.C. § 24. Even though the Narrow View (and to a certain extent, the Broad View) relies on legislative history to defend its interpretation, courts should not use legislative history when reconciling 35 U.S.C. §§ 23 and 24. Legislative history is too subjective to accurately determine what Congress's intent actually was in passing the statute because legislative history includes details that may or may not have impacted the statute's passage. To interpret a statute accurately, courts should evaluate the plain meaning of the statute.

Because 35 U.S.C. § 23 uses the word "may" when discussing the Director of the United States Patent and Trademark Office's ability to create discovery rules and because 35 U.S.C. § 24 uses the word "shall" when describing when the Federal Rules of Civil Procedure apply, two conclusions can be drawn. First, the plain meaning of these statutes reveal that the Federal Rules of Civil Procedure are the minimum standard of discovery rules to apply in the affected proceedings. Second, the discovery rules that the Director creates may allow for more discovery, not less. Furthermore, 35 U.S.C. § 24 also uses the word "shall" to describe when the federal district courts must become involved in these proceedings, which indicates that the federal district courts and the courts within the United States Patent and Trademark Office are supposed to work together in the applicable cases. As a result, the legal doctrines of judicial duty and judicial power reveal what role the federal district courts are to play in these proceedings.

Judicial duty gives a court the ability to apply—but not to interpret—a statute, while judicial power gives a court the extra ability to interpret a statute while applying it. Because the Federal Rules of Civil Procedure are a creature of the United States Supreme Court, the federal district courts, not the courts within the United States Patent and Trademark Office, have judicial power over the Federal Rules of Civil Procedure. Therefore, if the courts within the United States Patent and Trademark Office misapply the Federal Rules of Civil Procedure, the federal district courts should have the opportunity to correct this misinterpretation, at least in an appellate capacity.

AUTHOR

J.D. Candidate, Liberty University School of Law. I graduated magna cum laude from the University of Georgia with a Bachelor of Business Administration in Finance. I would like to thank Professor Jeffrey C. Tuomala for inspiring this article through his Constitutional Law lectures.

COMMENT

WHOSE DISCOVERY RULES SHALL APPLY?: RESOLVING THE CIRCUIT SPLIT INVOLVING 35 U.S.C. § 23 AND 35 U.S.C. § 24

Thomas C. Walsh[†]

ABSTRACT

When courts ignore the plain meaning of statutes, they fail to interpret the statutes in accordance with the objective intent of Congress. This has happened in relation to 35 U.S.C. §§ 23 and 24, which are statutes governing discovery rules for proceedings within the United States Patent and Trademark Office's courts. As a result, the law has been in a state of flux for nearly fifty years.

In 1952, Congress passed the Patent Act of 1952. As part of the Act, Congress passed 35 U.S.C. § 23, which gives discretionary authority to the Director of the United States Patent and Trademark Office to create discovery rules for proceedings within the United States Patent and Trademark Office's courts, and 35 U.S.C. § 24, which mandates that the Federal Rules of Civil Procedure apply under certain circumstances and that federal district courts are to become involved in proceedings before a court within the United States Patent and Trademark Office's courts. Until 1971, the federal district courts did not have trouble reconciling these seemingly conflicting statutes because no discovery rules had been created by the United States Patent and Trademark Office's courts to apply. Thus, the Federal Rules of Civil Procedure applied. However, in 1971, the Director created discovery rules for the United States Patent and Trademark Office courts. This caused the federal district courts to have difficulty reconciling 35 U.S.C. § 23 with 35 U.S.C. § 24. The federal district courts began to defer to the discovery rules created for the United States Patent and Trademark Office's courts rather than deferring to the plain meaning of 35 U.S.C. § 24.

This deferential interpretation is the Narrow View of a federal district court's powers under 35 U.S.C. § 24, while the plain meanings of 35 U.S.C. §§ 23 and 24 represent the Broad View of a federal district court's powers under 35 U.S.C. § 24.

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Even though the Narrow View (and to a certain extent, the Broad View) relies on legislative history to defend its interpretation, courts should not use legislative history when reconciling 35 U.S.C. §§ 23 and 24. Legislative history is too subjective to accurately determine what Congress's intent actually was in passing the statute because legislative history includes details that may or may not have impacted the statute's passage. To interpret a statute accurately, courts should evaluate the plain meaning of the statute.

Because 35 U.S.C. § 23 uses the word "may" when discussing the Director of the United States Patent and Trademark Office's ability to create discovery rules and because 35 U.S.C. § 24 uses the word "shall" when describing when the Federal Rules of Civil Procedure apply, two conclusions can be drawn. First, the plain meaning of these statutes reveal that the Federal Rules of Civil Procedure are the minimum standard of discovery rules to apply in the affected proceedings. Second, the discovery rules that the Director creates may allow for more discovery, not less. Furthermore, 35 U.S.C. § 24 also uses the word "shall" to describe when the federal district courts must become involved in these proceedings, which indicates that the federal district courts and the courts within the United States Patent and Trademark Office are supposed to work together in the applicable cases. As a result, the legal doctrines of judicial duty and judicial power reveal what role the federal district courts are to play in these proceedings.

Judicial duty gives a court the ability to apply—but not to interpret—a statute, while judicial power gives a court the extra ability to interpret a statute while applying it. Because the Federal Rules of Civil Procedure are a creature of the United States Supreme Court, the federal district courts, not the courts within the United States Patent and Trademark Office, have judicial power over the Federal Rules of Civil Procedure. Therefore, if the courts within the United States Patent and Trademark Office misapply the Federal Rules of Civil Procedure, the federal district courts should have the opportunity to correct this misinterpretation, at least in an appellate capacity.

I. INTRODUCTION

When interpreting a statute, it is important to determine the objective meaning of the statute—not the subjective meaning—because our Republic is "[a] government of laws, not of men. Men may intend what they will; but

it is only the laws that they enact [that] bind us."[1] This method of statutory interpretation should guide the reconciliation process of the interpretations of 35 U.S.C. §§ 23 and 24. The plain meaning of these statutes reveals that some of the Federal Rules of Civil Procedure (FRCP) are supposed to apply during the discovery process in contested cases before the courts within the United States Patent and Trademark Office (USPTO).[2] This interpretation also raises a question as to what extent the federal district courts should involve themselves in these cases. The legal concepts of judicial duty and judicial power answer this question by demonstrating that because the federal district courts have judicial power over the FRCP, they must be able to correct any misapplications of the FRCP by the courts within the USPTO.[3] As a result, FRCP 26, 34, and 45 "shall" apply in all contested cases proceeding before the courts within the United States Patent and Trademark Office.[4] And the federal district courts should enforce the application of FRCP 26, 34, and 45 as necessary.[5]

II. BACKGROUND

In 2016, now-Justice Gorsuch authored an opinion for the United States Court of Appeals for the Tenth Circuit in which the court resolved a dispute over Federal Rule of Civil Procedure 45.[6] At the end of the opinion, Judge Gorsuch stated that this opinion did not "offer any views on the optimal interpretation of § 24 or its interaction (if any) with § 23. *The long lingering*

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[1] Antonin Scalia, *Common-Law Courts in a Civil-Law System: The Role of United States Federal Courts in Interpreting the Constitution and Laws, in* A MATTER OF INTERPRETATION 3, 17 (Amy Gutmann ed., 2018).

[2] 35 U.S.C. § 23; 35 U.S.C. § 24; *see* discussion *infra* Section. III.

[3] *See* discussion *infra* Section IV.

[4] 35 U.S.C. § 24; *see* discussion *infra* Section III.B.3.b.

[5] *See* discussion *infra* Section IV.B.2.

[6] El Encanto, Inc. v. Hatch Chile Co., 825 F.3d 1161, 1162, 1167 (10th Cir. 2016).

circuit split that lingers there lingers there still."[7] How did this circuit split originate? It all started with Congress's passage of the Patent Act of 1952.[8]

In one statute, the Patent Act of 1952 gives the Director of the USPTO discretionary authority to create discovery rules for the USPTO courts to use in proceedings before them.[9] In another statute, the Act mandates that the FRCP applies in certain circumstances in proceedings before the USPTO courts.[10] Jurisprudence surrounding the relationship between these two statutes began in the 1960s.[11] In the 1960s, courts typically applied the FRCP to reconcile these two statutes.[12] However, the Director of the USPTO created discovery rules in 1971 for the USPTO courts to use.[13] After this development, some courts began to apply the USPTO's discovery rules rather than the FRCP.[14] Thus, a circuit split was created.

A. *The Statutes*

Consideration of several statutes is necessary to resolve this circuit split. Two of these statutes, 28 U.S.C. §§ 2071 and 2072, involve the creation of the FRCP.[15] Another two statutes, 35 U.S.C. §§ 1 and 6, involve the creation of the USPTO and the Patent Trial and Appeal Board (PTAB).[16] Two more statutes, 35 U.S.C. §§ 23 and 24, involve discovery rules in cases proceeding before the USPTO.[17]

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[7] *Id.* at 1167 (emphasis added).

[8] *See* Robert E. Purcell & Jerry D. Voight, *The Scope of Discovery in Patent Interference Proceedings (Part I)*, 62 J. PAT. OFF. SOC'Y 160, 161 (1980). *See generally* Patent Act of 1952, Pub. L. No. 593, tit. 35, 66 Stat. 792, 792–815 (1952) (codified as amended at 35 U.S.C. §§ 1–390).

[9] 35 U.S.C. § 23.

[10] 35 U.S.C. § 24.

[11] *Discovery in Patent Interference Proceedings*, 89 HARV. L. REV. 573, 577 (1976); *see* discussion *infra* Sections II.B.1–3.

[12] *See* discussion *infra* Sections II.B.1–3.

[13] Purcell & Voight, *supra* note 8, at 162.

[14] *See, e.g.*, Frilette v. Barnes, 508 F.2d 205 (3d Cir. 1974).

[15] 28 U.S.C. §§ 2071–72.

[16] 35 U.S.C. §§ 1, 6.

[17] *Id.* §§ 23–24.

1. The Federal Rules of Civil Procedure

In 28 U.S.C. § 2071, Congress authorized the federal courts to create "rules for the conduct of their business."[18] Congress also authorized the Supreme Court "to prescribe general rules of practice and procedure . . . in the [federal] district courts . . . ."[19] The FRCP meets these requirements because the Court "oversees the creation of the" FRCP and because FRCP 1 states that the FRCP "govern[s] the procedure in all civil actions and proceedings in the [federal] district courts . . . ."[20]

Several FRCP establish discovery rules that federal district courts must follow.[21] FRCP 26 includes a mandate defining the information parties to a lawsuit are required to provide to the other party during discovery without the other party first requesting the information.[22] FRCP 34 provides the standards that parties must follow when requesting the production of documents and producing requested documents.[23] FRCP 45 discusses how subpoenas must be issued and how parties can comply with subpoenas.[24] FRCP 34 actually incorporates FRCP 45 into its rules because FRCP 34 states that "[a]s provided in [FRCP] 45, a nonparty may be compelled to produce documents and tangible things or to permit an inspection."[25]

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[18] 28 U.S.C. § 2071.

[19] *Id.* § 2072.

[20] Natasha Dasani, Note, *Class Actions and the Interpretation of Monetary Damages Under Federal Rule of Civil Procedure 23(b)(2)*, 75 FORDHAM L. REV. 165, 188 (2006); FED. R. CIV. P. 1; STAFF OF S. COMM. ON THE JUDICIARY, 116TH CONG., FED. RULES OF CIV. PROC. (Comm. Print 2020); *see* 28 U.S.C. §§ 2071–72.

[21] *See* FED. R. CIV. P. 26, 34, 45; *see also id.* at 1.

[22] *Id.* at 26(a)(1)(A).

[23] *Id.* at 34(a)–(b)(1).

[24] *Id.* at 45(a)(1), (c).

[25] *Id.* at 34(c).

2. The Creation of the USPTO and the Discovery Rules that Apply in the USPTO

In 1952, Congress passed the Patent Act of 1952.[26] It has been argued that this Act altered the status quo of the existing patent laws.[27] However, Senator McCarran of Nevada argued before the Senate that this Act merely "codifie[d] the present patent laws."[28] Regardless of what effect this Act had on the patent laws, Congress created a new institution—the USPTO.[29]

Congress created the USPTO by enacting 35 U.S.C. § 1.[30] Congress placed the USPTO under the authority of the Department of Commerce.[31] Because the President's Cabinet includes the Department of Commerce, the USPTO is located within the Executive Branch of the federal government.[32] Congress created the PTAB via 35 U.S.C. § 6 to adjudicate patent disputes.[33] Congress placed the PTAB within the USPTO, which means that the PTAB is also within the Executive Branch of the federal government.[34]

Congress addressed discovery rules for proceedings within the USPTO in 35 U.S.C. §§ 23 and 24.[35] Congress stated in § 23 that it "*may* establish rules for taking affidavits and depositions required in cases" that proceed before the USPTO, which includes the PTAB.[36] In § 24, Congress authorized the federal district courts to involve themselves "in . . . contested case[s]"

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[26] *See* Patent Act of 1952, Pub. L. No. 593, tit. 35, 66 Stat. 792, 792–815 (1952) (codified as amended at 35 U.S.C. §§ 1–390).

[27] L. James Harris, *Some Aspects of the Underlying Legislative Intent of the Patent Act of 1952*, 23 GEO. WASH. L. REV. 658, 658 (1955).

[28] 98 CONG. REC. 9323 (1952).

[29] 35 U.S.C. § 1; 98 CONG. REC. 9323 (1952); *see* Harris, *supra* note 27.

[30] *See* 35 U.S.C. § 1.

[31] *Id.*

[32] *History*, U.S. DEP'T. OF COM., https://www.commerce.gov/about/history (last visited Aug. 28, 2022).

[33] *See* 35 U.S.C. § 6(a)–(b).

[34] *Id.* § 6(a).

[35] 35 U.S.C. §§ 23–24.

[36] *Id.* § 23 (emphasis added); *see id.* § 6(a)–(b).

proceeding before the USPTO.[37] Congress stated that the district courts "*shall*, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district . . . ."[38] Congress further stated that "[t]he provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things *shall* apply to contested cases in the Patent and Trademark Office."[39] As a result of these two statutes, the United States Circuit Courts of Appeals have differed on how much power the federal district courts have in proceedings before the USPTO.[40]

B. *The Broad 1960s*

During the 1960s, "the prevailing viewpoint" among the circuit courts was a broad view of the district courts' powers under § 24 (Broad View).[41] This "broad [view] of [§ 24] . . . [would] allow both parties to a patent interference to apply for discovery [to the federal district courts] at any time during the contested proceeding."[42] Three of the circuit courts that adopted the Broad View, at least for a period of time, were the United States Courts of Appeals for the Seventh Circuit, Tenth Circuit, and Third Circuit.[43]

1. The Seventh Circuit

In *Natta v. Zletz* in 1967, the Seventh Circuit adopted the Broad View.[44] In *Zletz*, a contested case proceeded before the USPTO.[45] One of the parties (the

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[37] *Id.* § 24.

[38] *Id.* (emphasis added).

[39] *Id.* (emphasis added).

[40] *See* Purcell & Voight, *supra* note 8, at 160, 167.

[41] *Id.* at 162.

[42] Babcock & Wilcox Co. v. Combustion Eng'g, Inc., 314 F. Supp. 235, 237 (D. Conn. 1968), *aff'd per curiam*, 430 F.2d 1177 (2d Cir. 1968); *see also* Purcell & Voight, *supra* note 8, at 162 (quoting *Babcock & Wilcox Co.*, 314 F. Supp. at 237).

[43] *See* Natta v. Zletz, 379 F.2d 615, 616, 618 (7th Cir. 1967); Natta v. Hogan, 392 F.2d 686, 690 (10th Cir. 1968); *In re* Natta, 388 F.2d 215, 218 (3d Cir. 1968), *overruled by* Frilette v. Barnes, 508 F.2d 205 (3d Cir. 1974); *see also* discussion *infra* Sections II.B.1–3.

[44] *See* Natta v. Zletz, 379 F.2d 615, 616, 618 (7th Cir. 1967).

[45] *Id.* at 616.

moving party) wanted to scrutinize some of the documents that the other party (the non-moving party) possessed.[46] The moving party, therefore, "moved . . . the [federal] [d]istrict [c]ourt pursuant to . . . § 23 and § 24 for an order under [FRCP] 34 . . . to obtain the production of documents from the" non-moving party.[47] The moving party filed this motion because the deadline for obtaining discovery from the USPTO had expired, and the USPTO refused to extend this deadline.[48] The district court denied the moving party's motion.[49] On appeal, the Seventh Circuit had to determine whether the federal district court had jurisdiction to order discovery under FRCP 34 regardless of the USPTO's actions.[50]

The Seventh Circuit held that the district court could grant the moving party's motion.[51] It reasoned that FRCP 34 and "§ 24 vest[] authority in the [federal] district court[s] to require the production of documents."[52] It also reasoned that the federal district court's jurisdiction was not contingent upon any action of the USPTO.[53] In fact, it even pointed out that § 24 gave the federal district court "a jurisdiction designed to cooperatively complement [USPTO] jurisdiction as an aid to the quest for truth."[54]

2. The Tenth Circuit

In *Natta v. Hogan* in 1968, the Tenth Circuit also adopted the Broad View.[55] In *Hogan*, two parties argued before the USPTO regarding the question of which party had first received a patent in the United States.[56] The federal district court allowed one of the parties to obtain discovery through

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[46] *Id.*

[47] *Id.*

[48] *Id.*

[49] *Id.*

[50] Natta v. Zletz, 379 F.2d 615, 616 (7th Cir. 1967).

[51] *Id.* at 618.

[52] *Id.*

[53] *Id.*

[54] *Id.*

[55] *See* Natta v. Hogan, 392 F.2d 686, 690 (10th Cir. 1968).

[56] *Id.* at 688.

it.[57] Similar to the Seventh Circuit in *Zletz*, the Tenth Circuit had to determine whether § 24 allowed a federal district court to enforce FRCP 34 in a proceeding before the USPTO.[58] The party opposing the discovery raised two main arguments.[59] First, it argued that § 24 did not allow the district court to grant discovery.[60] Second, it argued that the documents were protected by either attorney–client privilege or the work product doctrine.[61]

The Tenth Circuit held that the district court could order the party opposing the discovery to produce all of the documents save one.[62] It reasoned that the structure of § 24 allows a federal district court to order discovery in a proceeding before the USPTO even if the case does not involve subpoenas.[63] It even stated that "[t]he power of the federal [district] courts to enforce . . . right[s] [under § 24] is not dependent on any particular formalism of procedure."[64] It also stated that "[§] 24 gives the parties in [USPTO] proceedings the right to secure documents in accordance with the provisions of the [FRCP]."[65] The Tenth Circuit held that attorney–client privilege protected the one document that it did not allow the district court to order the party to produce.[66] Therefore, the Tenth Circuit did not base its decision to prevent the production of the privileged document on its interpretation of § 24.[67]

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[57] *Id.* at 689.

[58] *Hogan*, 392 F.2d at 688–89; *Zletz*, 379 F.2d at 616, 618.

[59] *See Hogan*, 392 F.2d at 689–91, 693.

[60] *Id.* at 689–90.

[61] *Id.* at 693.

[62] *Id.* at 694.

[63] *Id.* at 690.

[64] *Id.*

[65] Natta v. Hogan, 392 F.2d 686, 690 (10th Cir. 1968).

[66] *Id.* at 693–94.

[67] *See id.*

3. The Third Circuit

In *In re Natta* in 1968, the Third Circuit also adopted the Broad View.[68] *In re Natta* involved the same plaintiffs as *Zletz* and *Hogan*.[69] One party moved for the district court to "grant[] [it] discovery of the books and records of" the other party.[70] The district court granted this motion.[71] The Third Circuit had to determine whether a party to the proceeding had to comply with the district court's discovery order even though the proceeding was before the USPTO.[72]

The Third Circuit held "that the [FRCP] appl[ied] to this case," which meant that the party opposing the discovery order had to comply with the discovery order.[73] The court reasoned that § 24 "manifest[ed] a clear congressional intent to make available to parties to patent interferences the broad discovery provisions of the FRCP."[74] The Third Circuit relied on a district court's interpretation of § 24, which was that "the applicable rules of civil procedure must be considered in determining the questions before the court relative to the attendance of witnesses and the production of documents. [FRCP] 26, 30, 34, and 45 . . . relating to the attendance of witnesses and the production of documents are applicable" under § 24.[75]

The Third Circuit relied on legislative history and policy concerns when making its decision.[76] It discussed how § 24 was broader than the statute it replaced—the old statute only created rules about subpoenas.[77] It reasoned

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[68] *In re* Natta, 388 F.2d 215, 218 (3d Cir. 1968), *overruled by* Frilette v. Barnes, 508 F.2d 205 (3d Cir. 1974).

[69] *Hogan*, 392 F.2d at 689.

[70] *In re Natta*, 388 F.2d at 216.

[71] *Id.*

[72] *See id.*

[73] *Id.* at 219.

[74] *Id.* at 217.

[75] *Id.* at 218 (quoting Korman v. Shull, 184 F. Supp. 928, 931 (W.D. Mich. 1960), *appeal dismissed*, 310 F.2d 373–74 (6th Cir. 1962)).

[76] *In re* Natta, 388 F.2d 215, 217 (3d Cir. 1968), *overruled by* Frilette v. Barnes, 508 F.2d 205 (3d Cir. 1974).

[77] *Id.*

that its interpretation of congressional intent in creating § 24 was correct because "[i]f Congress had desired to limit discovery to the type available under [FRCP] 45(b), it simply would have pointed to that specific rule instead of referring generally to the Federal Rules of Civil Procedure."[78] The Third Circuit added that its "approach insure[d] that the fundamental elements of procedural and substantive due process will be accorded to parties to patent interferences."[79]

C. *The Narrow 1970s*

The jurisprudence surrounding § 23 and § 24 began to change in the 1970s when some circuit courts began to adopt a narrow view of the powers of the federal district courts under § 24 (Narrow View).[80] Proponents of the Narrow View argue "that [the] federal [district] courts can do no more than enforce discovery ordered by the" USPTO.[81] This change began after the USPTO exercised its rights under § 23 by allowing the PTAB to conduct discovery.[82] Three of the circuit courts that adopted the Narrow View were the Third Circuit, First Circuit, and Fifth Circuit.[83]

1. The Third Circuit

In *Frilette v. Barnes* in 1974, the Third Circuit abandoned its previous jurisprudence on the breadth of a federal district court's powers under § 24.[84] In *Frilette*, the Third Circuit had to resolve two discovery disputes in a single opinion.[85] Both disputes involved a party seeking discovery from a district court rather than the USPTO, even though the cases were proceeding before

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[78] *Id.*

[79] *Id.*

[80] *See* Frilette v. Barnes, 508 F.2d 205, 207, 212 (3d Cir. 1974); Sheehan v. Doyle, 513 F.2d 895, 898 (1st Cir. 1975); Brown v. Braddick, 595 F.2d 961, 966 (5th Cir. 1979); Purcell & Voight, *supra* note 8, at 162–63.

[81] Purcell & Voight, *supra* note 8, at 163.

[82] 35 U.S.C. § 23; *see* Purcell & Voight, *supra* note 8, at 162.

[83] *Frilette*, 508 F.2d at 207, 212; *Sheehan*, 513 F.2d at 898; *Braddick*, 595 F.2d at 966.

[84] *Frilette*, 508 F.2d at 207, 212.

[85] *Id.* at 207.

the USPTO.[86] In both disputes, the Third Circuit had to determine whether the district court could grant discovery.[87] Even though *In re Natta* was good law in the Third Circuit, the Third Circuit chose to reexamine it.[88] One reason for this was that "the [USPTO] ha[d] developed a procedure for handling these cases[,] which required the junior party to present its evidence first. Discovery by the junior party . . . prior to or while it presents its own case, however, frustrates the order of precedence [that] the [USPTO] desires to utilize."[89]

The Third Circuit held that § 24 only made FRCP 45—the FRCP rule that governs the issuance of and compliance with subpoenas—available to parties in cases proceeding before the USPTO.[90] The Third Circuit reasoned pragmatically to defend its abandonment of its previous jurisprudence.[91] These pragmatic reasons included the need for disputes to proceed before only one judicial body and the USPTO's new discovery rules only being slightly more restrictive than the FRCP.[92] In fact, the Third Circuit based its reasoning on the USPTO's updated discovery practices, which "represent[ed] an improvement over prior administrative practice."[93] It also stated that because § 24 "does not use the word 'discovery,'" Congress did not intend the Broad View of § 24.[94]

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[86] *Id.* at 207–08.

[87] *See id.* at 207.

[88] *Id.* at 211.

[89] *Id.* at 210–11. In a proceeding before the USPTO, there are two parties—the senior party and the junior party. The Third Circuit noted that "[t]he applicant first in time is called the senior party, and the other [party] is designated the junior party." *Id.* at 207.

[90] Frilette v. Barnes, 508 F.2d 205, 212 (3d Cir. 1974); FED. R. CIV. P. 45.

[91] *See Frilette*, 508 F.2d at 211.

[92] *Id.*

[93] *Id.*

[94] *Id.* at 211–12; *see* 35 U.S.C. § 24 ("The provisions of the [FRCP] relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent and Trademark Office.").

2. The First Circuit

In *Sheehan v. Doyle* in 1975, the First Circuit followed the Third Circuit's precedent in *Frilette* and adopted the Narrow View of § 24.[95] In *Sheehan*, two parties were involved in a dispute before the USPTO as to whether one of them had legitimately received a patent.[96] One party sought a subpoena from the federal district court to obtain discoverable information.[97] The other party wanted the district court to order the first party to produce documents under FRCP 34.[98] The First Circuit had to determine whether § 24 granted the district court the power to issue discovery under FRCP 34.[99]

The First Circuit held that § 24 did not give the district court the power to issue discovery under FRCP 34.[100] Like the Third Circuit, the First Circuit reasoned pragmatically to defend its position.[101] It stated that the federal district courts do not need to get involved because the USPTO can enforce its discovery orders by removing the case from its docket if the party does not comply with its discovery orders.[102] The First Circuit also reasoned that § 24 is merely a statute "giving teeth . . . to authority conferred upon the" USPTO.[103] The First Circuit concluded by stating that it was "not inclined to impose [its] notions of fairness on the agency[,] which has been delegated primary authority to control the" case.[104]

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[95] Sheehan v. Doyle, 513 F.2d 895, 898 (1st Cir. 1975).

[96] *Id.* at 896.

[97] *Id.* at 897.

[98] *Id.*

[99] *Id.* at 898.

[100] *See id.*

[101] *See* Sheehan v. Doyle, 513 F.2d 895, 899 (1st Cir. 1975); *see also* Frilette v. Barnes, 508 F.2d 205, 211 (3d Cir. 1974).

[102] *Sheehan*, 513 F.2d at 899.

[103] *Id.* at 898.

[104] *Id.* at 899.

3. The Fifth Circuit

In *Brown v. Braddick* in 1979, the Fifth Circuit adopted the Third Circuit's *Frilette* precedent regarding how to interpret § 24.[105] In *Braddick*, one party sought an order from the USPTO that would compel the other party to produce discoverable information.[106] In accordance with its discovery rules, the USPTO "denied this discovery request."[107] After the denial, the party seeking discovery sought an order from a federal district court mandating discovery.[108] The district court granted this order.[109] The Fifth Circuit had to determine whether it should allow the district court's discovery order.[110]

The Fifth Circuit held that § 24 did not allow the district court to order discovery if the information sought was not discoverable under USPTO rules.[111] It reasoned that the First and Third Circuits represented the modern trend at the time.[112] The Fifth Circuit then adopted the Third Circuit's Narrow View approach to § 24 despite that approach not being the majority rule at that time.[113] The Fifth Circuit agreed that § 24 is ambiguous.[114] The court stated that "the language [in § 24] is not so clear as to compel the conclusion that Congress [intended] to allow discovery in district courts independent of [USPTO] control."[115]

D. *The Peculiar Case of the Second Circuit*

The Second Circuit's jurisprudence relating to § 24 is perhaps the most fascinating. Due to conflicting district court opinions and a lack of clear

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[105] Brown v. Braddick, 595 F.2d 961, 966 (5th Cir. 1979).

[106] *Id.* at 963.

[107] *Id.*

[108] *Id.* at 963–64.

[109] *Id.*

[110] *Id.* at 962.

[111] Brown v. Braddick, 595 F.2d 961, 966 (5th Cir. 1979).

[112] *See id.*

[113] *See Id.*

[114] *Id.*

[115] *Id.*

guidance from the Second Circuit on this issue, the Second Circuit's position on whether it follows the Broad View or the Narrow View is unclear.[116]

1. Pre-Third Circuit Reversal

In 1968, the United States District Court for the District of Connecticut adopted the Broad View in *Babcock & Wilcox Co. v. Combustion Engineering, Inc.*[117] In this case there was a contested case proceeding before the USPTO.[118] One party filed a motion with the District Court of Connecticut in order to obtain discovery from the other party under FRCP 34.[119] The other party opposed the motion.[120] The court had to determine whether § 24 allowed it to grant discovery in accordance with FRCP 34.[121]

The District Court of Connecticut held that it could and would grant discovery in accordance with FRCP 34.[122] At the time of the court's decision, *In re Natta* was still good law in the Third Circuit.[123] As a result, the court followed *In re Natta*'s precedent.[124] Furthermore, the court also stated that the way Congress worded § 24 "manifest[ed] an explicit congressional intent to allow both parties to a patent interference to apply for discovery at any

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[116] *See* Babcock & Wilcox Co. v. Combustion Eng'g, Inc., 314 F. Supp. 235, 237 (D. Conn. 1968), *aff'd per curiam*, 430 F.2d 1177 (2d Cir. 1968) (adopting the Broad view); Spaite v. Marsh, No. M 8–85, 1976 U.S. Dist. LEXIS 13617, at *10 (S.D.N.Y. 1976) (adopting the Narrow View); Shattuck v. Hoegl, 555 F.2d 1118, 1119–22 (2d Cir. 1977) (holding that the discovery order was not appealable because it was an interlocutory appeal; Weeks v. Shono, No. N 79–118, 1979 U.S. Dist. LEXIS 12602, at *4–6 (D. Conn. 1979) (adopting the Narrow View).

[117] *Babcock & Wilcox Co.*, 314 F. Supp. at 237.

[118] *Id.* at 236.

[119] *Id.*

[120] *Id.*

[121] *Id.* at 236–37.

[122] *Id.* at 237.

[123] *See* Babcock & Wilcox Co. v. Combustion Eng'g, Inc., 314 F. Supp. 235, 237 (D. Conn. 1968), *aff'd per curiam*, 430 F.2d 1177 (2d Cir. 1968); Frilette v. Barnes, 508 F.2d 205, 207, 212 (3d Cir. 1974); *In re* Natta, 388 F.2d 215, 218–19 (3d Cir. 1968), *overruled by Frilette*, 508 F.2d 205.

[124] *Babcock & Wilcox Co.*, 314 F. Supp. at 237; *see also* Spaite v. Marsh, No. M 8–85, 1976 U.S. Dist. LEXIS 13617, at *10 (S.D.N.Y. 1976) (noting that *Babcock & Wilcox Co.* "uncritically accepted the *Natta* rule").

time during the contested proceeding."[125] The court went on to infer that "the need for discovery as an aid in the quest for truth" favored its interpretation of § 24.[126]

Babcock & Wilcox Co. was appealed to the Second Circuit, which affirmed the federal district court's decision.[127] The Second Circuit, however, did not provide any reasoning and thus provided no additional guidance for district courts within the Second Circuit.[128] Rather, the Second Circuit merely stated that it "affirmed in open court the decision of the District Court" and adopted the District Court's reasoning.[129]

2. Post-Third Circuit Reversal

After the Third Circuit reversed its jurisprudence on the issue of how much power the federal district courts have under § 24, the issue arose again in the federal district courts of the Second Circuit.[130] This time the federal district courts within the Second Circuit held similarly to the Third Circuit's new jurisprudence and applied the Narrow View.[131] The Second Circuit, however, refused to clarify its jurisprudence on the issue.[132]

a. *Spaite v. Marsh*

In 1976, the United States District Court for the Southern District of New York had to determine whether § 24 allowed it to grant discovery even though the case was proceeding before the USPTO.[133] The USPTO set a deadline for the parties involved in this case to obtain discovery.[134] Because

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[125] *Babcock & Wilcox Co.*, 314 F. Supp. at 237.

[126] *Id.*

[127] Babcock & Wilcox Co. v. Combustion Eng'g, Inc., 430 F.2d 1177, 1178 (2d Cir. 1968).

[128] *See id.*

[129] *Id.*

[130] *See* Weeks v. Shono, No. N 79–118, 1979 U.S. Dist. LEXIS 12602, at *1–3 (D. Conn. 1979); Spaite v. Marsh, No. M 8–85, 1976 U.S. Dist. LEXIS 13617, at *2, *4–6 (S.D.N.Y. 1976).

[131] *Weeks*, 1979 U.S. Dist. LEXIS 12602, at *3–6; *Spaite*, 1976 U.S. Dist. LEXIS 13617, at *9–10.

[132] *See* discussion *infra* Section II.D.2.b.

[133] *Spaite*, 1976 U.S. Dist. LEXIS 13617, at *1–2.

[134] *Id.* at *2–3.

of this deadline, one of the parties petitioned the court to grant its discovery request.[135] The party seeking discovery wanted to prove that the other party engaged in fraudulent activity.[136]

The court held that it could not grant discovery under § 24.[137] It reasoned that it was not bound by the Second Circuit's jurisprudence on the issue because the underlying reasoning relied on *In re Natta*, which the Third Circuit overturned after the leading case in the Second Circuit was decided.[138] It also reasoned that it would be judicially expedient for discovery to proceed before one court rather than multiple courts.[139]

b. The Second Circuit's refusal to clarify its jurisprudence

In 1977, the Second Circuit had the opportunity to clarify its jurisprudence regarding whether federal district courts can grant discovery under § 24 in cases also proceeding before the USPTO.[140] In *Shattuck v. Hoegl*, a party to a case proceeding before the USPTO sought a discovery order from the United States District Court for the Western District of New York to order discovery against the opposing party.[141] However, the court refused to grant the discovery order.[142] The moving party then appealed the district court's refusal to the Second Circuit.[143]

The Second Circuit held that it could not hear the appeal because it did not have jurisdiction.[144] The court stated that "[a]s a general rule, orders granting or denying discovery are not appealable."[145] It did, however, recognize that "when . . . the only relief sought in the district court is

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[135] *Id.* at *2–4.

[136] *See id.* at *3–4.

[137] *Id.* at *12.

[138] *See id.* at *10.

[139] Spaite v. Marsh, No. M 8–85, 1976 U.S. Dist. LEXIS 13617, at *12 (S.D.N.Y. 1976).

[140] *See* Shattuck v. Hoegl, 555 F.2d 1118, 1119–22 (2d Cir. 1977).

[141] *See id.* at 1119.

[142] *Id.*

[143] *Id.*

[144] *Id.* at 1119, 1122.

[145] *Id.* at 1119.

discovery, a number of exceptions to this rule exist."[146] Nevertheless, the Second Circuit reasoned that there was not an exception here because the party seeking discovery sought it from the opposing party.[147] As a justification for refusing to hear the appeal, the Second Circuit stated that the party seeking the discovery order could obtain the discovery from the USPTO under USPTO rules.[148] In sum, the Second Circuit refused to answer the question of whether "§ 24 [should] be limited to [the] enforcement of [USPTO] orders."[149]

c. *Weeks v. Shono*

In 1979, the District Court of Connecticut had to determine whether § 24 allowed discovery to proceed in a USPTO court and a federal district court simultaneously.[150] One of the parties, Weeks, had already received the discovery that it desired.[151] The other party, Shono, wanted to take rebuttal testimony of a witness.[152] Shono issued a subpoena from the District Court of Connecticut and filed a motion in the USPTO court for the same type of discovery that Shono sought under the subpoena.[153] Weeks filed a "motion to quash the subpoena [in the District Court of Connecticut] and for a protective order [also in the district court] to prevent the taking of the testimony of" the witness.[154]

The district court held that Shono had to wait for a ruling from the USPTO court before seeking discovery.[155] The district court reasoned that it should not grant discovery "without knowing at the least the [US]PTO[] [court's] reasons for refus[ing]" to grant discovery if in fact the USPTO court decided

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[146] Shattuck v. Hoegl, 555 F.2d 1118, 1120 (2d Cir. 1977).

[147] *See id.* ("[T]he rule . . . is that collateral discovery orders are appealable only when they deny discovery against a non-party.")

[148] *See id.* at 1121.

[149] *Id.* at 1122.

[150] Weeks v. Shono, No. N 79–118, 1979 U.S. Dist. LEXIS 12602, at *1–3 (D. Conn. 1979).

[151] *Id.* at *1.

[152] *Id.*

[153] *See id.* at *1–2.

[154] *Id.* at *2.

[155] *See id.* at *6.

not to grant discovery.[156] The district court also reasoned that the Third Circuit's reversal and the Second Circuit's refusal to clarify its jurisprudence on the issue permitted the district court to deviate from precedent.[157]

E. *A Summary of the Stances of the Various Circuits*

The circuit split regarding how to reconcile §§ 23 and 24 involves two views: the Broad View and the Narrow View.[158] The Seventh and Tenth Circuits follow the Broad View.[159] Originally, the Third Circuit followed the Broad View,[160] but it reversed its precedent and adopted the Narrow View.[161] The First and Fifth Circuits also follow the Narrow View.[162] Prior to the Third Circuit's reversal of *In re Natta*, the District Court of Connecticut adopted the Broad View and the Third Circuit's reasoning from *In re Natta*.[163] The Second Circuit affirmed.[164] However, multiple district courts within the Second Circuit deviated from the Second Circuit's precedent after the Third Circuit reversed *In re Natta*.[165] The Second Circuit has declined to clarify its jurisprudence.[166] In order to have unity in the circuits on this issue, this circuit split needs to be resolved.

III. INTERPRETING §§ 23 AND 24

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[156] Weeks v. Shono, No. N 79–118, 1979 U.S. Dist. LEXIS 12602, at *6 (D. Conn. 1979).

[157] *Id.* at *3–4.

[158] *See* discussion *supra* Sections II.B–C.

[159] *See* Natta v. Hogan, 392 F.2d 686, 694 (10th Cir. 1968); Natta v. Zletz, 379 F.2d 615, 616 n.1, 618 (7th Cir. 1967).

[160] *See In re* Natta, 388 F.2d 215, 219 (3d Cir. 1968), *overruled by* Frilette v. Barnes, 508 F.2d 205 (3d Cir. 1974).

[161] *See Frilette*, 508 F.2d at 207, 212.

[162] *See* Brown v. Braddick, 595 F.2d 961, 966–68 (5th Cir. 1979) (deferring to the USPTO's view but not affirmatively adopting the Narrow View); Sheehan v. Doyle, 513 F.2d 895, 898 (1st Cir. 1975); *Frilette*, 508 F.2d at 207, 212.

[163] *See* Babcock & Wilcox Co. v. Combustion Eng'g, Inc., 314 F. Supp. 235, 237 (D. Conn. 1968), *aff'd per curiam*, 430 F.2d 1177 (2d Cir. 1968).

[164] Babcock & Wilcox Co. v. Combustion Eng'g, Inc., 430 F.2d 1177, 1178 (2d Cir. 1968).

[165] Weeks v. Shono, No. N 79–118, 1979 U.S. Dist. LEXIS 12602, at *4–6 (D. Conn. 1979); Spaite v. Marsh, No. M 8–85, 1976 U.S. Dist. LEXIS 13617, at *1, *4–6, *10 (S.D.N.Y 1976).

[166] *See* Shattuck v. Hoegl, 555 F.2d 1118, 1119–22 (2d Cir. 1977).

Sections 23 and 24 may be interpreted using two different methods of statutory interpretation.[167] One method looks to legislative history to determine the legislative intent.[168] The other method looks to the plain meaning of the text to determine the objective intent of the statute.[169] Because "the objective indication of the words, rather than the intent of the legislature [as demonstrated by legislative history], . . . constitutes the law," evaluating the plain meaning of the text is the superior method of interpretation.[170] The evaluation of the plain meaning of the text supports the Broad View.[171]

A. *Legislative History Should Not Be Used to Interpret the Statutes*

Supporters of both the Broad View and the Narrow View have used legislative history[172] to support their arguments.[173] This approach, however, is problematic for two reasons. First, supporters of both the Broad View and Narrow View can use the legislative history to support their arguments. Second, Congress may not have known the contents of the bill when it passed the bill. Therefore, this approach should not be used to resolve this circuit split.

1. The Arguments Incorporating Legislative History

Some argue that the legislative history surrounding §§ 23 and 24 supports the Narrow View.[174] This argument relies on statements governmental officials made during the creation of the statutes.[175] One USPTO official expressed his opinion to Congress regarding §§ 23 and 24—that they had

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[167] *See* discussion *infra* Sections III.A–B.

[168] *See* discussion *infra* Section III.A.

[169] *See* discussion *infra* Section III.B.1.

[170] Scalia, *supra* note 1, at 29–30.

[171] *See* discussion *infra* Sections III.B.2–3.

[172] For purposes of this Comment, legislative history includes statements made by governmental officials to Congress, statements made by the floor manager of the bill, and comparisons of previous iterations of the statutes with the new iteration of the statutes. *See* discussion *infra* Section III.A.1.

[173] *See* discussion *infra* Sections III.A.1–2.b.

[174] *See Discovery in Patent Interference Proceedings*, *supra* note 11, at 581–84.

[175] *Id.* at 583, 583–84 n.63.

"little or no changes in them."[176] In addition, Senator McCarran of Nevada—despite being the floor manager who was not in charge of the bill—stated on the Senate floor that the Patent Act of 1952 "codifie[d] the present patent laws."[177] The Narrow View claims that though the legislative history for § 24 mentions the FRCP in that section's revision notes, this referral to the FRCP is merely a "casual observation" that does not warrant the adoption of the Broad View.[178]

Even though there is an argument that the legislative history of §§ 23 and 24 defends the Narrow View, an argument also exists that the legislative history for these sections supports the Broad View.[179] In *In re Natta,* the Third Circuit argued for the Broad View by noting that the previous iteration of § 24 only addressed subpoenas while the current iteration of § 24 broadly encompasses the FRCP.[180] This argument accords with the idea that the Patent Act of 1952 altered patent law rather than maintaining the status quo.[181]

2. The Problems with Using Legislative History

Using legislative history to interpret § 24 is problematic generally.[182] The legislative history used to interpret § 24 exemplifies the problems with using legislative history to interpret statutes.

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[176] *Id.* at 583.

[177] 82 CONG. REC. 9323 (1952) (reflecting Senator McCarran's statement that Senator Wiley of Wisconsin was in charge of the bill); *Discovery in Patent Interference Proceedings*, *supra* note 11, at 583–84 n.63.

[178] *Discovery in Patent Interference Proceedings*, *supra* note 11, at 584.

[179] *Id.* at 580–81; *see* discussion *supra* Section III.A.1.

[180] *In re* Natta, 388 F.2d 215, 217 (3d Cir. 1968), *overruled by* Frilette v. Barnes, 508 F.2d 205, 212 (3d Cir. 1974).

[181] *See* Harris, *supra* note 27, at 658, 660 (not addressing § 24 but rather other sections in the Act). Proponents of the Narrow View have to concede "that the 1952 codification did make some changes in statutory patent law." *Discovery in Patent Interference Proceedings*, *supra* note 11, at 583–84 n.63 (emphasis omitted).

[182] *See generally* Scalia, *supra* note 1, at 31 ("I [Justice Scalia] object to the use of legislative history on principle[] since I reject intent of the legislature as the proper criterion of the law.").

a. General problems with using legislative history to interpret statutes

Legislative history should not be used to interpret §§ 23 and 24 because the "intent of the legislature [is not] the proper criterion of the law."[183] In fact, legislative history may not accurately represent the actual intent of the legislature, and if society were to allow legislative history to govern it rather than the law, society would experience "[g]overnment by unexpressed intent[, which] is . . . tyrannical."[184] Justice Scalia once noted that "[i]n any major piece of legislation, the legislative history is extensive, and there is something for everybody."[185] Furthermore, the use of legislative history unnecessarily complicates the interpretation process, making it difficult to interpret the statute.[186] In fact, "the manipulability of legislative history has not *replaced* the manipulabilities of . . . other techniques; it . . . has *augmented* them."[187]

Using legislative history to interpret a statute is also problematic because legislative history generally has no impact on whether a member of the House of Representatives (the House) or a member of the Senate votes for or against a bill.[188] In fact, it is "absurd" to think legislative history has any impact on any vote in Congress.[189] Legislative history typically does not have any impact on any vote in Congress because Congress as a whole does not know what the legislative history contains.[190] It is even difficult for a small number of legislators or an individual legislator to know what the legislative history

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[183] *Id.*

[184] *Id.* at 17, 31.

[185] *Id.* at 36.

[186] *See id.*

[187] *Id.*

[188] ANTONIN SCALIA & BRYAN A. GARNER, MAKING YOUR CASE: THE ART OF PERSUADING JUDGES 48 (2008).

[189] *Id.*

[190] *Id.*

contains because it is nearly impossible for either the House or the Senate to "*delegate* the details of a law to a committee or a floor manager."[191]

b. The problem with using legislative history to resolve this circuit split

Because the legislative history of the Patent Act of 1952 can support both the Narrow View and the Broad View, using legislative history to resolve this circuit split is problematic; it contains "something for everybody."[192] For example, proponents of the Narrow View can rely on statements made during the legislative process to support their argument.[193] At the same time, proponents of the Broad View can argue that the Patent Act of 1952 made substantive changes to at least parts of the patent laws.[194] Furthermore, the Third Circuit in *In re Natta* argued in favor of the Broad View by interpreting § 24 and its legislative history.[195] Therefore, the Third Circuit presents a textbook example of how interpreting legislative history makes the statutory interpretation process unnecessarily complicated.[196]

The defense of the Narrow View via the legislative history of the Patent Act of 1952 also illustrates how using legislative history to interpret §§ 23 and 24 is problematic—Congress may not have known the contents of the Act when it passed the Act. Senator McCarran was the floor manager for this Act, which would make it difficult for him to know all of its contents.[197]

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[191] *Id.* at 48–49; *Floor Manager*, UNITED STATES SENATE, https://www.senate.gov/reference/glossary_new.htm#F (last visited Sept. 1, 2022) ("Senators or representatives designated to lead consideration of a bill or other measure on the floor. Usually the chairperson and ranking minority member of the reporting committee or their designee.").

[192] Scalia, *supra* note 1, at 36; *see* discussion *supra* Section III.A.1.

[193] *See* 82 CONG. REC. 9323 (1952); *see Discovery in Patent Interference Proceedings*, *supra* note 11, at 583–84 n.63.

[194] *See* Harris, *supra* note 27, at 658, 660–61; *Discovery in Patent Interference Proceedings*, *supra* note 11, at 583–84 n.63; *see also supra* note 181 and accompanying text.

[195] *In re* Natta, 388 F.2d 215, 217, 219 (3d Cir. 1968), *overruled by* Frilette v. Barnes, 508 F.2d 205 (3d Cir. 1974).

[196] *See* Scalia, *supra* note 1, at 36.

[197] *Discovery in Patent Interference Proceedings*, *supra* note 11, at 583–84 n.63; *see* SCALIA & GARNER, *supra* note 188, at 48.

Furthermore, because Congress had an expert witness give his opinion on the effects of §§ 23 and 24, it appears that Congress did not fully understand the Act.[198] Therefore, legislative history should not be used to interpret §§ 23 and 24.

B. *A Better Method of Interpretation: Using the Plain Meaning of the Text*

Rather than using legislative history to interpret §§ 23 and 24, courts should interpret the statutes using the plain meaning of the text. Evaluating the plain meaning of the words "may" and "shall" in §§ 23 and 24 will satisfy the need for an objective standard when engaging in statutory interpretation.[199] The "principles of interpretation" aid in determining the plain meaning of the statutes.[200] Application of the canons of construction to §§ 23 and 24 reveal that the plain meaning of §§ 23 and 24 support the Broad View.[201]

1. How to Apply an Objective Standard

When a court interprets a statute, it should "look for a sort of 'objectified' intent—the intent that a reasonable person would gather from the text of the law, placed alongside the remainder of the *corpus juris*."[202] When evaluating the plain meaning of the text, a court is able to identify "a purpose or object that aids in understanding the statute's meaning and [it is able to] apply[] the statute to the facts of a given case."[203] In fact, the Supreme Court employed this analysis in the early days of the Republic when it interpreted the Constitution in *McCulloch v. Maryland*.[204]

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[198] *See Discovery in Patent Interference Proceedings*, *supra* note 11, at 583; SCALIA & GARNER, *supra* note 188, at 48.

[199] 35 U.S.C. §§ 23– 24; *see* discussion *infra* Section III.B.1.

[200] Scalia, *supra* note 1, at 37; *see* discussion *infra* Section III.B.2.

[201] *See* discussion *infra* Section III.B.3.

[202] Scalia, *supra* note 1, at 17.

[203] Jeffrey C. Tuomala, The Casebook Companion pt. 3, ch. 2, at 5 (Aug. 28, 2020) (unpublished manuscript) (on file with author).

[204] *Id.* at 2, 5.

In *McCulloch v. Maryland*, Maryland challenged Congress's authority to create a national bank.[205] After much debate, the First Congress created the national bank, and a subsequent Congress reinstated the bank after its expiration.[206] When considering Maryland's challenge, the Supreme Court interpreted the Necessary and Proper Clause (the Clause) of the Constitution.[207] Maryland argued that the Court should interpret the Clause in a way that prevented Congress from having the power to create a national bank.[208]

The Supreme Court held that Congress could create the national bank.[209] The Court reasoned that "[t]he word 'necessary[]' . . . controll[ed] the whole sentence," so it focused on "necessary" when interpreting this Clause.[210] The Court stated that "[i]t [was] essential to just construction[]" to determine what the "common usage [of 'necessary'] justifies."[211] The Court acknowledged that "necessary" can have different meanings depending upon the context of the sentence.[212] The Court, however, stated that it could "derive some aid from [the context] with which ['necessary'] is associated."[213]

The Supreme Court stated that the Clause gives "Congress . . . [the] power 'to make all laws which shall be necessary and proper to carry into execution' the powers of the government."[214] Based on the Framers' structure of the Clause, the Court rejected the notion that "necessary" had a "strict and rigorous meaning . . . ."[215] Rather, the Court stated, "[t]o employ the means necessary to an end, is generally understood as employing any means calculated to produce the end, and not as being confined to those single

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[205] McCulloch v. Maryland, 17 U.S. 316, 400–02 (1819).

[206] *Id.* at 401–02.

[207] *Id.* at 411–15.

[208] *Id.* at 412.

[209] *Id.* at 424–25.

[210] *Id.* at 413–15.

[211] McCulloch v. Maryland, 17 U.S. 316, 414 (1819).

[212] *Id.*

[213] *Id.* at 418.

[214] *Id.* (quoting U.S. CONST. art. I, § 8, cl. 18).

[215] *Id.* at 418–19.

means, without which the end would be entirely unattainable."[216] Interpreting "necessary" in this manner helped the Court in declaring that Congress could create the national bank.[217]

Even though the Supreme Court was interpreting the Constitution in *McCulloch*, its method of interpretation may be applied to statutes.[218] In fact, interpreting the Constitution differs from interpreting a statute "not because special principles of interpretation apply, but because the usual principles are being applied to an unusual text."[219] Some of these "usual principles" include the canons of construction as well as other rules of interpretation.[220]

2. The Usual Principles of Statutory Interpretation

When interpreting statutes, courts apply usual principles that help them "give an ambiguous word or phrase meaning *in the context of the* [*statute*] *in which it appears*."[221] One of these usual principles is that courts should define words in a manner consistent with "their ordinary meanings."[222] Another one of these usual principles is that courts should define words in the same statute consistently unless these words were not meant to have the same meaning.[223] A third usual principle is that courts "should . . . interpret[] [statutes] in a way that renders them harmonious, not contradictory."[224] The fourth usual principle states that courts should interpret a statute in a manner that ensures that "every word [in the statute is] given effect . . . ."[225]

The canons of construction also comprise these usual principles of statutory interpretation.[226] Two of the canons of construction are relevant for interpreting

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[216] *Id.* at 413–14.

[217] *See* McCulloch v. Maryland, 17 U.S. 316, 413–14, 418–19, 424–25 (1819).

[218] *McCulloch*, 17 U.S. at 411–15; *see* SCALIA, *supra* note 1, at 37; Tuomala, *supra* note 203, at 4–5.

[219] Scalia, *supra* note 1, at 37.

[220] *Id.*; SCALIA & GARNER, *supra* note 188, at 44–45.

[221] SCALIA & GARNER, *supra* note 188, at 44.

[222] *Id.*

[223] *Id.*

[224] *Id.*

[225] *Id.*

[226] *See id.* at 45.

§§ 23 and 24. The first of these canons of construction is *noscitur a sociis*.[227] It states that "[a] word is known by the words with which it is associated."[228] The second of the canons of construction is *inclusio unius est exclusio alterius*.[229] It states that "[t]he inclusion of one [word] implies the exclusion of others."[230]

3. Interpreting §§ 23 and 24

The plain meanings of §§ 23 and 24 reveal the proper interpretation of both statutes. The plain meaning of § 23 reveals that the USPTO has discretionary authority to create discovery rules for proceedings before its judicial bodies, while the plain meaning of § 24 reveals that, at a minimum, FRCP discovery rules apply in contested cases before the USPTO. Therefore, the plain meanings of §§ 23 and 24 taken together support the Broad View because the FRCP "shall apply."[231]

a. Interpreting § 23

Section 23 states that "[t]he Director [of the USPTO] *may* establish rules for taking affidavits and depositions required in cases in the" USPTO.[232] In § 23, "may" serves the same role as "necessary" did in *McCulloch*; it "control[s] the whole sentence[] . . . ."[233] It serves this function because it precedes the word "establish" in § 23, which means that the definition of "establish" is determined by "may."[234] Black's Law Dictionary defines "may" as "[t]o be permitted to" do something.[235] The Supreme Court echoed this definition by stating that "the word 'may[]' . . . implies discretion[] . . . ."[236] Additionally, the canon of construction *noscitur a sociis* supports this

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[227] SCALIA & GARNER, *supra* note 188, at 45.

[228] *Id.*

[229] *Id.*

[230] *Id.*

[231] 35 U.S.C. § 24.

[232] *Id.* § 23 (emphasis added).

[233] *Id.*; McCulloch v. Maryland, 17 U.S. 316, 413 (1819).

[234] 35 U.S.C. § 23; SCALIA & GARNER, *supra* note 188, at 45.

[235] *May*, BLACK'S LAW DICTIONARY (5th pocket ed. 2016).

[236] Kingdomware Techs., Inc. v. United States, 579 U.S. 162, 171 (2016).

definition.[237] If these definitions of "may" were inserted into § 23, § 23 would state that "[t]he Director [of the USPTO is permitted to or has discretion to] establish rules for taking affidavits and depositions required in cases in the [USPTO]."[238] Viewing § 23 in this manner raises a question: if the Director does not create discovery rules for proceedings before the USPTO, is there a minimum standard for discovery in cases before the USPTO, or is no discovery allowed? The answer to this question is found through proper interpretation of § 24.

b. Interpreting § 24

The proper interpretation of the first two sentences of § 24 reveals which discovery rules should apply. The first sentence states that "[t]he clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the [USPTO], shall[] . . . issue a subpoena for any witness residing or being within such district[] . . . ."[239] The second sentence states that "[t]he provisions of the [FRCP] relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the [USPTO]."[240] In both of these sentences, the word "shall" "control[s] the whole sentence," just like the words "may" in § 23 and "necessary" in *McCulloch*.[241] Black's Law Dictionary defines "shall" as "[h]as a duty to[]" and "more broadly, is required to."[242] Furthermore, the Supreme Court has stated that "the word 'shall' usually connotes a requirement."[243] The Supreme Court has also indicated that the word "shall" can indicate a

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[237] *See* SCALIA & GARNER, *supra* note 188, at 45.

[238] 35 U.S.C. § 23; *Kingdomware Techs.*, 579 U.S., at 171; *May*, BLACK'S LAW DICTIONARY (5th pocket ed. 2016).

[239] 35 U.S.C. § 24.

[240] *Id.*

[241] *Id.* §§ 23–24; McCulloch v. Maryland, 17 U.S. 316, 413 (1819).

[242] *Shall*, BLACK'S LAW DICTIONARY (5th pocket ed. 2016). Even though Black's Law Dictionary also lists two other definitions for the word "shall," it states that the definition quoted in the text of note 242 "is the mandatory sense that drafters typically intend and that *courts typically uphold*." *Id.* (emphasis added).

[243] *Kingdomware Techs., Inc.*, 579 U.S. at 171.

"mandate" of some kind, especially when "shall" appears in legislation.[244] The application of these definitions of "shall" to the use of the word in § 24 demonstrates that Congress is dictating or ordering actions related to discovery through each of the first two sentences in § 24.[245] Because Congress is giving orders related to discovery in each of the first two sentences of § 24, there is no reason not to apply the default rule that courts should define the same words in the same manner when the words are contained in the same statute.[246] The conclusion that Congress orders actions related to discovery in each of the first two sentences of § 24 raises a question: what discovery rules did Congress intend to be applied in contested cases before the USPTO?

Of the first two sentences in § 24, only the second sentence implicates the application of the FRCP.[247] In *Frilette*, the Third Circuit held that this sentence in § 24 only implicated FRCP 45 because it claimed that Congress did not make "any effort . . . to incorporate all of the" FRCP in § 24.[248] This holding would be supported by *inclusio unius est exclusio alterius* if the second sentence in § 24 had specifically mentioned FRCP 45, but this sentence only refers to the FRCP generally.[249] Therefore, *inclusio unius est exclusio alterius* cannot exclude the other FRCP relating to discovery because § 24 does not specifically discuss any single rule in the FRCP.[250]

A better interpretation of this second sentence in § 24 is that it orders FRCP 26, 34, and 45 to apply in the contested cases before the USPTO. The second sentence in § 24 specifically applies the FRCP "to the attendance of witnesses and to the production of documents and things . . . ."[251] The clause discussing "the attendance of witnesses" implicates FRCP 45 because FRCP

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[244] *Id.*

[245] 35 U.S.C. § 24; *Kingdomware Techs., Inc.*, 579 U.S. at 171; *Shall*, BLACK'S LAW DICTIONARY (5th pocket ed. 2016).

[246] SCALIA & GARNER, *supra* note 188, at 44; *see* discussion *supra* note 223.

[247] 35 U.S.C. § 24.

[248] Frilette v. Barnes, 508 F.2d 205, 211–12 (3d Cir. 1974).

[249] 35 U.S.C. § 24. *See* SCALIA & GARNER, *supra* note 188, at 45.

[250] *See* 35 U.S.C. § 24; *see also Discovery in Patent Interference Proceedings*, *supra* note 11, at 580 (discussing an argument in favor of the Broad View that "Congress . . . could simply have referred to [FRCP] 45" in § 24). *See* SCALIA & GARNER, *supra* note 188, at 45.

[251] 35 U.S.C. § 24.

45 creates rules regarding subpoenaing third parties.[252] The phrase, "the production of documents and things[,]" implicates FRCP 26 and 34 because FRCP 26 and 34 both create rules regarding what information and documents parties to a suit must provide to the other party.[253] According to the principle of statutory interpretation that requires "every word [to] be given effect[,]" the clause discussing "the production of documents and things" cannot be ignored when interpreting § 24.[254]

Because § 23 gives the Director of the USPTO discretion to create discovery rules and § 24 mandates that the FRCP apply in certain circumstances, these two statutes appear to conflict.[255] However, statutes ought to be interpreted "harmonious[ly], not [in] contradict[ion]" to one another, so there must be a way to reconcile these two statutes.[256] The Narrow View argues that "[§] 24 can be read to complement the grant" of the ability to create discovery rules imposed on the Director of the USPTO.[257] The Narrow View continues this argument by stating that "Congress referred generally to the [FRCP] in [§] 24 in order to ensure that the enforcement capability of the [federal] district courts would be coextensive with whatever regulations the Commissioner might adopt."[258] However, this argument seemingly forgets that § 24 requires FRCP 26, 34, and 45 to apply in certain

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[252] *Id.*; FED. R. CIV. P. 45. Because the second sentence of 35 U.S.C. § 24 implicates "the attendance of witnesses" and FRCP 45, the principle requiring harmonious interpretation of statutes requires that the first sentence in § 24, which implicates subpoenas, also implicates FRCP 45. 35 U.S.C. § 24; *see* discussion *supra* Section III.B.2. *See generally* SCALIA & GARNER, *supra* note 188, at 44.

[253] 35 U.S.C. § 24; FED. R. CIV. P. 26, 34. *But see Discovery in Patent Interference Proceedings*, *supra* note 11, at 581 ("[In § 24] Congress meant to establish a regime similar to that under Patent Office rule 287(c), but with [the] district court definition of good cause[] [found in FRCP 34.]").

[254] SCALIA & GARNER, *supra* note 188, at 44; 35 U.S.C. § 24.

[255] *See* 35 U.S.C. §§ 23–24.

[256] SCALIA & GARNER, *supra* note 188, at 44.

[257] *Discovery in Patent Interference Proceedings*, *supra* note 11, at 582.

[258] *Id.*

circumstances.[259] Therefore, a more "harmonious" reconciliation is needed.[260]

A more harmonious reconciliation may be found in constitutional law—it is the same principle that applies when a court must reconcile a state's constitution with the Constitution of the United States.[261] This principle is that "states may not provide fewer protections than the U.S. Constitution affords, [but] the states may provide greater protection of rights."[262] In other words, the U.S. Constitution provides the minimum standard for rights.[263] Because the same interpretative rules apply to interpretation of both the Constitution and statutes, it is appropriate to apply this same logic to § 23.[264] Therefore, § 23 creates a minimum standard for discovery because it grants the Director of the USPTO discretionary authority to create discovery rules.[265] If the Director did not create any discovery rules, such a situation would be akin to "the states [not] provid[ing] greater protections of rights," which would mean that the rights in the U.S. Constitution would apply.[266] Because Congress, via § 24, orders FRCP 26, 34, and 45 to apply in contested cases before the USPTO, § 24 is like the U.S. Constitution under these circumstances. In other words, FRCP 26, 34, and 45 are the minimum standards for discovery under these circumstances and "shall" apply if the Director of the USPTO has not created rules that allow for more discovery through his discretionary power under § 23.[267] Because the USPTO's

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[259] *See* 35 U.S.C. § 24.

[260] SCALIA & GARNER, *supra* note 188, at 44.

[261] *See generally* Jeffrey C. Tuomala, The Casebook Companion pt. 2, ch. 4, at 11 (Aug. 10, 2020) (unpublished manuscript) (on file with author) (discussing how state courts address issues that involve matters of both state and federal law).

[262] *Id.*

[263] *Id.*

[264] *See* Scalia, *supra* note 1, at 37 (noting that the distinction between constitutional interpretation and other textual interpretation is not in the principles of interpretation applied).

[265] 35 U.S.C. § 23; Tuomala, *supra* note 261, at 11; *see* discussion *supra* Section III.B.3a.

[266] Tuomala, *supra* note 261, at 11.

[267] *See* 35 U.S.C. §§ 23–24; Tuomala, *supra* note 261, at 11; *see also* discussion *supra* Section III.B.3.b.

discovery rules "stringently limit[] the circumstances in which discovery will be allowed[]" and because "the [FRCP] provide broad pretrial discovery as a matter of course[,]" the USPTO's discovery rules are more restrictive than the rules that provide the minimum standard.[268] Therefore, the FRCP "shall" still apply.[269]

However, this interpretation does not answer the question of what role the federal district courts play in discovery proceedings. That question is answered by analyzing which courts have judicial duty over the FRCP and which courts have judicial power over the FRCP.[270]

IV. JUDICIAL DUTY VS. JUDICIAL POWER IN RELATION TO THE FRCP

The legal concepts of judicial duty and judicial power reveal the role that the federal district courts play in the application of the FRCP "relating to the attendance of witnesses and to the production of documents and things" in contested cases before the USPTO.[271] The legal concept of judicial duty requires the USPTO courts to apply the FRCP when required.[272] In contrast, the legal concept of judicial power requires the federal district courts to apply the FRCP correctly if the courts within the USPTO err in doing so under the requisite circumstances.[273]

A. *Judicial Duty*

Understanding the concept of judicial duty is crucial to understanding the relationship that the courts within the USPTO have to the FRCP. The application of the concept of judicial duty here reveals that the courts within the USPTO have judicial duty over the FRCP, so these courts may only apply the FRCP, not interpret the FRCP.[274]

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[268] *Discovery in Patent Interference Proceedings*, *supra* note 11, at 577.

[269] 35 U.S.C. § 24.

[270] *See* discussion *infra* Section IV.

[271] 35 U.S.C. § 24; *see* discussion *infra* Section IV.A–B.

[272] *See* discussion *infra* Section IV.A.2.

[273] *See* discussion *infra* Section IV.B.2.

[274] *See* discussion *infra* Section IV.A.2.

1. What is Judicial Duty?

Judicial duty allows a court to apply law foreign to its jurisdiction.[275] However, a court that has judicial duty may not interpret the foreign law that it is applying.[276] Rather, such a court's responsibility is only "to pronounce the law applicable to the case in judgment."[277] Such a court achieves this by "follow[ing] authoritative . . . interpretations of [the] laws particular to the" foreign law's jurisdiction.[278] This principle not only applies to constitutional law but also to other areas of law.[279] Because this principle "ensure[s] that the administrative agency stays within the zone of discretion committed to it by its organic act," this principle also applies to courts and administrative agencies in relation to statutory law.[280] One of the best illustrations of judicial duty comes from the case of *Martin v. Hunter's Lessee*.

In *Martin*, a Virginia state court (State Court) ignored an order from the Supreme Court in a previous case in which the parties disputed proper title to a piece of real estate.[281] However, this dispute was not an ordinary land dispute because it originated from a 1794 treaty signed between the United States and Great Britain.[282] The State Court claimed "that the appellate power of the [S]upreme [C]ourt of the United States d[id] not extend to" supersede its authority.[283] Therefore, the State Court claimed that it did not have to

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[275] Tuomala, *supra* note 261, at 7.

[276] *Id.*

[277] Martin v. Hunter's Lessee, 14 U.S. 304, 340 (1816); Tuomala, *supra* note 261, at 7.

[278] Tuomala, *supra* note 261, at 7.

[279] *See* Henry P. Monaghan, *Marbury and the Administrative State*, 83 COLUM. L. REV. 1, 32–33 (1983). *See generally* Tuomala, *supra* note 261, at 7 (discussing judicial duty's application to federal law and constitutional issues).

[280] Monaghan, *supra* note 279, at 33.

[281] *Martin*, 14 U.S. at 323; Tuomala, *supra* note 261, at 1 (first citing Fairfax's Devisee v. Hunter's Lessee, 11 U.S. 603 (1813); then citing Hunter v. Fairfax's Devisee, 15 Va. 218 (1810)).

[282] Fairfax's Devisee v. Hunter's Lessee, 11 U.S. 603, 627 (1813).

[283] *Martin*, 14 U.S. at 323.

follow the Supreme Court's order.[284] However, the Supreme Court ultimately disagreed with the State Court's position.[285]

In *Martin*, the Supreme Court held that the State Court erred in holding that it did not have to follow the Supreme Court's order.[286] The Supreme Court reasoned that the Constitution gave the State Court the duty to apply the laws relating to the treaty.[287] This duty arose "[f]rom the very nature of [the State Court's] judicial duties . . . ."[288] However, because the case arose from a conflict due to a federal treaty, the State Court could not determine with finality the correct interpretation of the treaty.[289] The State Court would only have been able to interpret the law with finality if the conflict had arisen under "the laws or constitution of the state[] . . . ."[290]

2. The Application of Judicial Duty

Similar to the State Court in *Martin*, the courts within the USPTO have judicial duty over the FRCP.[291] Congress has indicated its intent for the FRCP "relating to the attendance of witnesses and to the production of documents and things [to] apply to contested cases" before the USPTO.[292] Furthermore, the USPTO did not create the FRCP.[293] As a result, the USPTO has to apply rules foreign to the USPTO, just as the State Court in *Martin* had to apply a federal treaty that was foreign to the State.[294] Therefore, the courts within the

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[284] *Id.*

[285] *Id.* at 362.

[286] *Id.* at 323–24, 362.

[287] *Id.* at 340–41.

[288] *Id.* at 340.

[289] Martin v. Hunter's Lessee, 14 U.S. 304, 340–41 (1816).

[290] *Id.*

[291] *Id.* at 340–41, 362.

[292] 35 U.S.C. § 24; *see* discussion *supra* Section III.B.3.b.

[293] *Current Rules of Practice & Procedure.*, U.S. CTS., https://www.uscourts.gov/rules-policies/current-rules-practice-procedure/federal-rules-civil-procedure (last visited Aug. 22, 2022); Dasani, *supra* note 20, at 188.

[294] *Martin*, 14 U.S. at 340–41.

USPTO may only apply the FRCP, not interpret the FRCP, in accordance with the definition of judicial duty.[295]

In practice, the courts within the USPTO would not have much difficulty applying the FRCP. Whenever these courts face an issue that implicates FRCP 26, 34, or 45 in contested cases, these courts could simply "follow [the] authoritative . . . interpretations of" the FRCP.[296] If these rules are not implicated or if the Director of the USPTO has created broader discovery rules through powers granted under § 23 than in FRCP 26, 34, and 45, then USPTO courts would not have this responsibility.[297] What would happen, though, if the courts within the USPTO misapplied FRCP 26, 34, or 45? The legal concept of judicial power answers that question.[298]

B. *Judicial Power*

Understanding the concept of judicial power is crucial to understanding the relationship between the federal district courts and the FRCP and the federal district court's role in contested cases before the USPTO. The application of the concept of judicial power here reveals that the federal district courts have judicial power over the FRCP, which empowers the federal district courts with responsibilities in contested cases before the USPTO.[299]

1. What is Judicial Power?

Judicial power allows "[a] court . . . [to] authoritatively interpret law peculiar to" its jurisdiction.[300] Courts exercising judicial duty over a law must apply the law in accordance with the interpretation set forth by a court with

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[295] *See* discussion *supra* Section IV.A.1.

[296] Tuomala, *supra* note 261, at 7.

[297] *See* discussion *supra* Section IV.A.1. *See generally* discussion *supra* Section III.B.3.b (explaining that the FRCP should be the minimum standard for discovery in contested cases before the USPTO and that the Director's discovery rules are void if more restrictive than what the FRCP provides for).

[298] *See* discussion *supra* Section IV.B.1.

[299] *See* discussion *infra* Section IV.B.2.

[300] Tuomala, *supra* note 261, at 7.

judicial power.[301] In fact, "[t]he difference between [judicial] power and [judicial] duty . . . relates to the question of which court has the final and binding authority to interpret[]" the law.[302] When courts, rather than executive agencies, exercise judicial power, "the courts [act] as the ultimate guardian[s] and assurance[s] of the limits set upon [administrative] power by the constitutions and legislatures."[303] Just as *Martin* provides a good illustration of judicial duty,[304] it also provides a good illustration of judicial power.

In *Martin*, not only did the Supreme Court have to determine whether the state court had judicial duty over a federal treaty, but the Supreme Court also had to determine whether the Supreme Court—and by extension the lower federal courts—had judicial power over this federal treaty.[305] The Supreme Court had to determine whether it could reverse a state court if the state court misinterpreted federal law.[306] The Supreme Court held that it and the other federal courts had judicial power over the federal treaty—and over federal law generally—even though the federal treaty or other federal law could create legal questions over which state courts would have to exercise judicial duty.[307] The Supreme Court also held that, as the highest court in the nation, it could overrule a misinterpretation of federal law.[308]

The Supreme Court reasoned that the Constitution granted it judicial power and appellate authority over federal law.[309] It also reasoned that because Congress did not have to create lower federal courts, the Supreme Court must be able to exercise appellate authority over state courts in matters

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[301] *Id.*

[302] *Id.*

[303] Monaghan, *supra* note 279, at 32–33 (quoting L. Jaffe, *Judicial Control of Administrative Action* 320, 321 (1965)).

[304] *See* discussion *supra* Section IV.A.1.

[305] Martin v. Hunter's Lessee, 14 U.S. 304, 323, 337–42 (1816); Fairfax's Devisee v. Hunter's Lessee, 11 U.S. 603, 627 (1813); Tuomala, *supra* note 261, at 1 (first citing Fairfax's Devisee v. Hunter's Lessee, 11 U.S. 603 (1813); then citing Hunter v. Fairfax's Devisee, 15 Va. 218 (1810)).

[306] *Martin*, 14 U.S. at 340.

[307] *Id.* at 340, 342.

[308] *Id.* at 345–46.

[309] *Id.* at 338–39.

dealing with federal law.[310] The Court further reasoned that because state courts encounter cases dealing with federal law, the federal courts must have appellate authority over those federal law issues.[311] It explained that "[f]rom the very nature of things, the absolute right of decision, in the last resort, must rest somewhere . . . ."[312]

2. The Application of Judicial Power

Similar to the federal courts in *Martin*, federal district courts have judicial power over the FRCP.[313] The Supreme Court is authorized to create rules of procedure for the federal courts to follow, and the FRCP serves this purpose.[314] In fact, because "the Supreme Court oversees the creation of the [FRCP], unlike the passage of statutes, it would be logical to assume that the Court, *and the judicial branch in general*, would not be overstepping its authority when taking an active role in interpreting" the FRCP.[315] This description of the federal judiciary's role in interpreting the FRCP comports with the definition of judicial power because it essentially argues that the federal judicial branch "can authoritatively interpret" the FRCP.[316] Therefore, the federal district courts have judicial power over the FRCP.[317]

Federal district courts' judicial power over the FRCP impacts their role in contested cases before the USPTO. The proper interpretation of § 24 is that the FRCP's discovery rules (i.e., FRCP 26, 34, and 45) "shall" apply in contested cases before the USPTO.[318] Furthermore, the courts within the USPTO have judicial duty over the FRCP, so they may only apply the FRCP, not interpret the FRCP.[319] However, these courts may misapply the FRCP,

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[310] *Id.* at 339–40.

[311] *Id.* at 342.

[312] Martin v. Hunter's Lessee, 14 U.S. 304, 345 (1816).

[313] *Id.* at 340, 342, 345; 28 U.S.C. § 2071.

[314] 28 U.S.C. §§ 2071–72; FED. R. CIV. P. 1; Dasani, *supra* note 20, at 188.

[315] Dasani, *supra* note 20, at 188 (emphasis added).

[316] Tuomala, *supra* note 261, at 7; Dasani, *supra* note 20, at 188.

[317] Dasani, *supra* note 20, at 188. *See generally* Tuomala, *supra* note 261, at 7 (providing an overview of judicial power).

[318] *See* discussion *supra* Section III.B.3.b.

[319] *See* discussion *supra* Section IV.A.2.

which would harm the parties involved in the contested cases before the USPTO. This possibility creates a situation where "[f]rom the very nature of [the situation], the absolute right of decision[] . . . must rest somewhere . . . ."[320] The federal district courts can easily serve as the entity with "the absolute right of decision."[321]

In practice, a party seeking discovery under FRCP 26, 34, or 45 in a contested case before the USPTO should move the USPTO court for discovery under the applicable FRCP rule. If this party is unable to obtain discovery through this process, the party should be able to appeal to the local federal district court for discovery under the applicable FRCP rule. This process is mostly consistent with the articulations of the Broad View from the Seventh Circuit in *Natta v. Zletz*, the Tenth Circuit in *Natta v. Hogan*, and the Third Circuit in *In re Natta*.[322] However, the Tenth Circuit in *Hogan* held that "[t]he power of the federal [district] courts to enforce . . . right[s] [under § 24] is not dependent on any particular formalism of procedure."[323] This holding is contrary to *Martin* because *Martin* requires an appeal for a court with judicial power to reverse a court with judicial duty.[324] Therefore, a party in a contested case before the USPTO should only be able to seek discovery under the applicable FRCP rule from a federal district court after the USPTO court has had the opportunity to rule on the motion. This application of judicial power is also consistent with § 24.

Proponents of both the Narrow View and the Broad View recognize that § 24 creates a situation where the courts within the USPTO and the federal district courts are supposed to work together.[325] According to the Narrow View, "Congress referred generally to the [FRCP] in [§] 24 in order to ensure that the enforcement capability of the district courts would be coextensive

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[320] Martin v. Hunter's Lessee, 14 U.S. 304, 345 (1816).

[321] *Id.*

[322] Natta v. Hogan, 392 F.2d 686, 694 (10th Cir. 1968); *In re* Natta, 388 F.2d 215, 219 (3d Cir. 1968), *overruled by* Frilette v. Barnes, 508 F.2d 205 (3d Cir. 1974); Natta v. Zletz, 379 F.2d 615, 616, 618 (7th Cir. 1967).

[323] *Hogan*, 392 F.2d at 690.

[324] *Martin*, 14 U.S. at 340; *Hogan*, 392 F.2d at 690.

[325] *Zletz*, 379 F.2d at 618; *Discovery in Patent Interference Proceedings*, *supra* note 11, at 582.

with whatever regulations the [Director of the USPTO] might adopt[]" under § 23.[326] In adopting the Broad View, the Seventh Circuit observed that Congress had given the federal district court "ancillary jurisdiction [to the USPTO]—a jurisdiction designed to cooperatively complement [USPTO] jurisdiction as an aid to the quest for truth."[327] The first sentence in § 24 specifically commands the federal district courts to issue subpoenas in contested cases before the USPTO if certain prerequisites are met.[328] Therefore, it is not a foreign concept to adopt this pseudo-appellate procedure.

V. CONCLUSION

Using the plain meaning of a statute, rather than its legislative history, is the superior method of statutory interpretation.[329] The plain meanings of §§ 23 and 24 reveal that some of the FRCP "shall" apply in contested cases before the USPTO.[330] Furthermore, the concepts of judicial duty and judicial power define the proper scope of a federal district court's involvement in these cases.[331] Combined, these concepts demonstrate that courts have judicial power over the FRCP, which gives a federal district court the power and ability to correct any misapplications, at least in an appellate capacity, of the FRCP that USPTO courts might commit. If courts were to follow this interpretation of §§ 23 and 24, as well as apply the concepts of judicial duty and judicial power to the FRCP, then this "long lingering circuit split that [still] lingers there" would be no more.[332]

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[326] *Discovery in Patent Interference Proceedings*, *supra* note 11, at 582.

[327] *Zletz*, 379 F.2d at 618.

[328] 35 U.S.C. § 24.

[329] *See* discussion *supra* Section III.A.

[330] 35 U.S.C. § 24; *see* discussion *supra* Section III.B.3.a–b.

[331] *See* discussion *supra* Section IV.

[332] El Encanto, Inc. v. Hatch Chile Co., 825 F.3d 1161, 1167 (10th Cir. 2016).