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PATENTS AND STATE CONSTITUTIONALLY PROTECTED SPEECH

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ABSTRACT

Recent American patent scholarship has begun to explore the intersection of the patent system and guarantees of expressive freedom, noting that patents may impinge on the First Amendment to the Federal Constitution and chill or prohibit protected speech. But guarantees of expressive freedom are not limited to the Federal Constitution; they are also found in state constitutional provisions, some of which offer broader protection than that guaranteed in the First Amendment. In this essay I examine the relationship between federally issued patents and the guarantees of expressive freedom found in state constitutions. State constitutions vary in their wording and interpretation, so my primary focus will be on those states that have viewed their state constitutional provisions as extending beyond the protections offered by the federal First Amendment. While the Supremacy Clause prevents states from overriding federal patent law, I argue here that state constitutional provisions can alter, shape, or even prohibit certain types of patent assertions, just as state law may moderate other uses of personal property. The discussion of this interaction highlights several previously unexplored aspects of the vertical relationship between federal patent policy and state law, and offers an alternative route to vindicating expressive rights encumbered by patents.

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TABLE OF CONTENTS

INTRODUCTION	2
I. STATE CONSTITUTIONAL GUARANTEES	4
II. SUPREMACY CLAUSE PREEMPTION.....	8
III. PERMISSIBLE STATE REGULATION	11
A. <i>Traditional State Purview</i>	12
B. <i>Regulating Federally Created Property</i>	14
IV. PATENT EASEMENTS.....	15
A. <i>Compulsory Patent Licensing</i>	16
B. <i>Reverse eBay Analysis</i>	18
V. INVITING PUBLIC ACCESS	20
VI. PETITION CLAUSE PREEMPTION	22
CONCLUSION	24

INTRODUCTION

Recent scholarship has begun to probe the relationship between utility patents and constitutional guarantees that protect free expression.¹ Intellectual property commentators have pointed out that when patents cover expressive subject matter, they may suppress or retard protected speech. Such scholarly investigation has gone on for decades in the related area of copyright, as well as in other areas where intellectual property is involved, such as trademark or right of publicity law.² But this inquiry is still nascent where patents are concerned.

The paucity of commentary regarding patents and freedom of speech likely stems in part from the sense that utility patents—unlike intellectual property such as copyright or trademarks—regulate technological rather than expressive activity. If patents have little purchase on expressive activity, it seems to follow that patent law will have little intersection with the law guaranteeing freedom of

1. See Dan L. Burk, *Content Discriminatory Patents: A Response to Professor Chiang*, 108 GEO. L.J. ONLINE 37 (2019); Tun-Jen Chiang, *Patents and Free Speech*, 107 GEO. L.J. 309 (2019); Dan L. Burk, *Patents and the First Amendment*, 96 WASH. U. L. REV. 197 (2018); Dan L. Burk, *Patenting Speech*, 79 TEX. L. REV. 99 (2000).

2. See, e.g., Lisa P. Ramsey, *Descriptive Trademarks and the First Amendment*, 70 TENN. L. REV. 1095 (2003); Roberta Rosenthal Kwall, *The Right of Publicity vs. The First Amendment: A Property and Liability Rule Analysis*, 70 IND. L.J. 47 (1994); Paul Goldstein, *Copyright and the First Amendment*, 70 COLUM. L. REV. 983 (1970); Melville B. Nimmer, *Does Copyright Abridge the First Amendment Guarantees of Free Speech and Press?*, 17 UCLA L. REV. 1180 (1970).

expression. But technology is integral to expression and communication, and this relationship is increasingly pronounced with the development and proliferation of informational processing technologies.³ Legal restrictions such as patent exclusivity on the use of communications devices, methods of advertising, or computer code inevitably restrict speech.⁴ A developing understanding of the expressive restrictions posed by patents suggests that their technical orientation still entails restrictions on freedom of speech.

A related reason for failing to examine the intersection of patent law and freedom of speech may be the various doctrinal objections to the possibility of such an intersection. Among the most pertinent objections to considering the intersection of the two is the argument that patents are a form of private property right and are enforced by private owners rather than by the state.⁵ Federal constitutional guarantees covering freedom of expression guard against governmental rather than private interference with speech.⁶ Patents are typically understood to be privately held property rights.⁷ Thus, the argument goes, because constitutional rights protect against actions by the state, they would never intersect with patent law, because patent enforcement constitutes private rather than state action.

I have detailed elsewhere a number of reasons as to why this particular argument should have little traction in the context of federal First Amendment jurisprudence.⁸ But in this article, I take up an alternative or additional response to such objections: even if considered private property, patents may violate constitutional rights to free speech because not all free speech provisions require state action. Certainly, state action is the general rule with regard to the Federal

3. See Jedidiah Purdy, *Neo-Liberal Constitutionalism: Lochnerism for a New Economy*, 77 L. & CONTEMP. PROBS. 195, 202 (2014) (noting the shift in First Amendment jurisprudence for the “information age”).

4. See Burk, *Patents and the First Amendment*, *supra* note 1, at 213; Chiang, *supra* note 1 at 327–28.

5. See Burk, *Patents and the First Amendment*, *supra* note 1, at 235; Chiang, *supra* note 1 at 331–32.

6. See Robert F. Utter, *The Right to Speak, Write, and Publish Freely: State Constitutional Protection Against Private Abridgement*, 8 U. PUGET SOUND L. REV. 157, 159–62 (1985) (summarizing federal constitutional state action doctrine).

7. *But see* Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC, 584 U.S. ___, 138 S. Ct. 1365, 1373 (2018) (characterizing patents as a type of “public franchise” for purposes of judicial review).

8. See Burk, *Patents and the First Amendment*, *supra* note 1, at 235; *see also* Chiang, *supra* note 1, at 334–35 (arguing that the action of the United States Patent Office provides state action to patent issuance).

Constitution's First Amendment provision for freedom of speech.⁹ However, most state constitutions also contain provisions guaranteeing freedom of speech, and a number of these have been interpreted to extend to private action involving private property.¹⁰ It is conceivable that these interpretations could, under defined circumstances, be extended to an intellectual property right such as a patent when that right suppresses expression guaranteed by that state.

Consequently, in this article I examine the relationship between federally issued patents and the guarantees of expressive freedom found in state constitutions. State constitutions vary in their wording and interpretation, so my primary focus will be on those states that have viewed their state constitutional provisions as extending beyond the protections offered by the federal First Amendment. While the Supremacy Clause prevents states from overriding federal patent law, I argue here that state constitutional provisions can alter, shape, or even prohibit certain types of patent assertions, just as state law may moderate other uses of personal property. The discussion of this interaction highlights several previously unexplored aspects of the vertical relationship between federal patent policy and state law, and may offer an alternative route to vindicating expressive rights encumbered by patents, including a surprising new approach to ongoing problems regarding standard-essential patents.

I. STATE CONSTITUTIONAL GUARANTEES

Although the federal constitutional guarantees of the First Amendment have been the primary source of expressive rights in the United States, they are not the only guarantee of such rights. Most state constitutions also entail provisions guaranteeing freedom of expression.¹¹ Some of these provisions merely parallel the language and protections found in the Federal Constitution, but in other cases state constitutional guarantees may offer somewhat broader protections.¹²

9. See *Hudgens v. NLRB*, 424 U.S. 507 (1976); see also Kevin Cole, *Federal and State "State Action": The Undercritical Embrace of a Hypercriticized Doctrine*, 24 GA. L. REV. 327, 329–32 (1990) (tracing the history of the federal state action doctrine).

10. See TIMOTHY ZICK, *SPEECH OUT OF DOORS: PRESERVING FIRST AMENDMENT LIBERTIES IN PUBLIC SPACES* 172–75 (2009); Jennifer Friesen, *Should California's Constitutional Guarantees of Individual Rights Apply Against Private Actors?*, 17 HASTINGS CONST. L.Q. 111, 114 (1989).

11. Monrad G. Paulsen, *State Constitutions, State Courts and First Amendment Freedoms*, 4 VAND. L. REV. 620, 622–23 (1951).

12. Sue Davis & Taunya Lovell Banks, *State Constitutions, Freedom of Expression, and Search and Seizure: Prospects for State Court Reincarnation*, 17 PUBLIUS: J. FEDERALISM 13

Significantly for this discussion, these broader state rights have sometimes been held to extend to speech expressed on private tangible property.¹³ Under the federal First Amendment, restrictions on speech exercised by private property owners on their own land have been held to lie outside the constitutional purview. But this is not necessarily the case for state constitutional provisions.¹⁴

Instead, some states have interpreted their constitutional provisions as either not requiring a state action element or in some other fashion extending guarantees for freedom of expression to private property.¹⁵ The broader rights associated with some state constitutional speech provisions logically follow from their broader language.¹⁶ Unlike the free speech provision of the Federal Constitution, which is phrased in the negative, the free speech provisions of many states are couched in the affirmative.¹⁷ Rather than declaring that “Congress shall make no law,” many states provide some variation of the language that “[e]very citizen shall have the right to freely speak, write, and publish.”¹⁸ Rather than mandating a constraint

(1987); Hans A. Linde, *First Things First: Rediscovering the States' Bills of Rights*, 9 U. BALT. L. REV. 379, 384–86 (1980).

13. See, e.g., *Dublirer v. 2000 Linwood Ave. Owners, Inc.*, 103 A.3d 249, 260 (N.J. 2014) (holding that the New Jersey state constitution guarantees the right for a member of a condominium association to exercise freedom of speech in a privately owned building); *Ralphs Grocery Co. v. United Food & Commercial Workers Union Local 8*, 290 P.3d 1116, 1120 (2012) (affirming the right to speak on privately owned shopping areas under the California constitution); *N.J. Coal. Against War in the Middle E. v. J.M.B. Realty Corp.*, 650 A.2d 757, 783–84 (N.J. 1994) (extending the right to speak to private property under New Jersey constitution); Seth F. Kreimer, *The Pennsylvania Constitution's Protection of Free Expression*, 5 U. PA. J. CONST. L. 12, 45–46 (2002) (noting that Pennsylvania state constitutional cases appear to extend expressive freedom to private action).

14. The propensity for state courts to more expansively affirm individual rights under state constitutional provisions has been sometimes labeled as “New Judicial Federalism.” See Robert F. Williams, *Rights* in STATE CONSTITUTIONS FOR THE TWENTY-FIRST CENTURY, VOL. 3: THE AGENDA OF STATE CONSTITUTIONAL REFORM 7, 8 (G. Alan Tarr & Robert F. Williams, eds., 2006); G. Alan Tarr, *The Past and Future of the New Judicial Federalism*, 24 PUBLIUS: J. FEDERALISM 63 (1994).

15. G. ALAN TARR, UNDERSTANDING STATE CONSTITUTIONS 13 (1998) (observing that many state constitutional speech clauses do not specify guarantees only against governmental incursions); see also John Ragosta, *Free Speech Access to Shopping Malls Under State Constitutions: Analysis and Rejection*, 37 SYRACUSE L. REV. 1 (1986) (reviewing several different state approaches to speech on private land).

16. See Brady C. Williamson & James A. Friedman, *State Constitutions: The Shopping Mall Cases*, 1998 WISC. L. REV. 883, 894 (1998).

17. See Williams, *supra* note 14, at 15.

18. See J. FRIESEN, STATE CONSTITUTIONAL LAW: LITIGATING INDIVIDUAL RIGHTS, CLAIMS, AND DEFENSES, VOL. 1 § 5.02[2] (4th ed. 2006).

on state action as the Federal Constitution does, the provisions provide an individual entitlement.¹⁹

Not all state constitutions follow this affirmative formula, and even among those that do, not all have been interpreted by their state courts as extending to private action.²⁰ But state constitutional provisions that extend to private action typically share the affirmative wording. For example, California's constitutional speech provision is typical of affirmatively-worded state provisions, affirmatively guaranteeing California citizens the right to freely speak, write and publish on all subjects, although also providing that legal penalties may be imposed for the abuse of that affirmative right.²¹ Because the California Constitution guarantees an affirmative entitlement to expressive freedom, the provision has been interpreted as allowing for incursion of speakers onto private property in some circumstances.²²

A minority of other states have interpreted their state constitutions similarly to provide affirmative expressive rights beyond those of the Federal Constitution.²³ Among the states that have recognized a state constitutional right to expression on private property, there has been a range of interpretations as to how often and how broadly the constitutional right may be invoked.²⁴ California, although a leader in recognizing a broadened state expressive right, has been cautious about allowing it to intrude on the right of private property owners. Oregon has been somewhat more expansive, allowing trespass and other facially neutral regulations to be challenged on an as-applied basis if

19. Frank Askin, *Free Speech, Private Space and the Constitution*, 29 RUTGERS L.J. 947, 951 (1998).

20. Shirley S. Abrahamson, *Divided We Stand: State Constitutions in a More Perfect Union*, 18 HASTINGS CONST. L.Q. 723, 736 (1991) (noting that a majority of states have declined to extend their free speech provisions to private action).

21. See CAL. CONST. art. I, § 2 (“Every person may freely speak, write and publish his or her sentiments on all subjects, being responsible for the abuse of this right.”).

22. See Joseph R. Grodin, *Freedom of Expression under the California Constitution*, 6 CAL. L. HIST. 187 (2011).

23. Williamson & Friedman, *supra* note 16, at 887.

24. See *id.* at 887–93 (reviewing a variety of approaches by state courts finding a state constitutional right to speak on private land); see also David Schuman, *State Constitutionalism: Using State Constitutions to Find and Enforce Civil Liberties*, 15 LEWIS & CLARK L. REV. 783, 788 (2011) (discussing expanded speech protections under the Oregon Constitution); Seth F. Kreimer, *The Pennsylvania Constitution's Protection of Free Expression*, 5 U. PA. J. CONST. L. 12, 45–46 (2002) (noting that Pennsylvania state constitutional cases appear to extend expressive freedom to private action); Jennifer Klear, *Comparison of the Federal Courts' and the New Jersey Supreme Court's Treatments of Free Speech on Private Property: Where Won't We Have the Freedom to Speak Next?*, 33 RUTGERS L.J. 589 (2002) (reviewing New Jersey state constitutional expressive freedom cases).

they impermissibly regulate speech.²⁵ New Jersey is notable for its relatively broad recognition of state expressive rights. New Jersey has, for example, extended its state constitutional rights of expression not only to speaking on shopping malls,²⁶ but to private college campuses²⁷ and to pamphleteering in the mailboxes controlled by a private condominium owners' association.²⁸

The division between the guarantees of federal and state constitutions is well illustrated by one of the earliest and most widely discussed cases, *Pruneyard Shopping Center v. Robins*,²⁹ in which the United States Supreme Court reviewed a California Supreme Court decision holding that the state constitution guaranteed access for political speakers to a privately owned shopping mall.³⁰ In reaching its conclusion, the California court balanced the state constitutional expressive rights of the speakers against the exclusive property rights of the shopping center owner, looking at four factors: the nature of the speech at issue, the nature of the property at issue, the availability of alternative fora, and the applicability of reasonable time, place, and manner regulations.³¹ The court was persuaded that the state expressive guarantees took preeminence for two reasons; first, because the shopping center was already open to the public, so the state constitutional requirement imposed a modest or negligible burden in addition to activity the property owner had already invited.³² Second, the state possessed plenary and police powers sufficient to regulate the

25. See Schuman, *supra* note 24 at 795–96; see also Rex Anderson, *Free Speech Fundamentalism—Justice Linde's Lasting Legacy*, 70 OR. L. REV. 855 (1991) (describing the Oregon jurisprudence on state constitutional expressive freedom as “absolutist.”). Oregon has also extended state constitutional protection to categories of speech, such as obscenity, that are unprotected by the federal First Amendment. See *State v. Henry*, 732 P.2d 9, 17 (Or. 1987).

26. *Green Party of N.J. v. Hartz Mtn. Indus., Inc.*, 752 A.2d 315, 325 (N.J. 2000); *N.J. Coal. Against War in the Middle E. v. J.M.B. Realty Corp.*, 650 A.2d 757, 783 (N.J. 1994), *cert. denied*, 516 U.S. 812 (1995).

27. *State v. Schmid*, 423 A.2d 615, 632–33 (N.J. 1980), *appeal dismissed sub nom.*, *Princeton Univ. v. Schmid*, 455 U.S. 100, 101 (1982). Pennsylvania state constitutional cases similarly extend the right to expressive exercise to private college campuses. *Commonwealth v. Tate*, 432 A.2d 1382, 1390 (Pa. 1981).

28. *Dublirer v. 2000 Linwood Ave. Owners, Inc.*, 103 A.3d 249, 260 (N.J. 2014). *Dublirer* verified the right of pamphleteers not affiliated with the property to distribute their literature in condominium mailboxes; other New Jersey cases affirm the right of tenants associated with the property to spread literature despite the landowner's objections. See, e.g., *Mazdabrook Commons Homeowners' Ass'n v. Khan*, 46 A.3d 507, 514 (N.J. 2012); *Comm. for a Better Twin Rivers v. Twin Rivers Homeowners' Ass'n*, 929 A.2d 1060, 1073–74 (N.J. 2007).

29. 447 U.S. 74, 78–79 (1980).

30. 592 P.2d 341, 345–48 (1979).

31. *Id.* at 346–47.

32. *Id.* at 347.

disposition of private property in the public interest, making constitutional impositions on the private owner similarly reasonable.³³

Reviewing the California decision, the United States Supreme Court affirmed that even though the Federal Constitution does not guarantee the right to speak on private property, state constitutional provisions may do so.³⁴ The Court held that such state provisions are not preempted by the First Amendment, nor were the mall owners deprived of property without due process given that the California holding was not arbitrary or unreasonable in relation to California's interest in promoting more expansive rights of expression.³⁵ In particular, the Court observed that mandating political expression for invitees to whom the property owner had already made access available was not a sufficient burden on the economic value of owners' exclusive rights to constitute a constitutional taking.³⁶

If state constitutional speech guarantees can extend to the exercise of private rights in real property, it seems useful to consider whether they can or should extend to exercise of private rights in intellectual property. Specifically, the broader expressive guarantees found in some state constitutions raise the question as to whether such affirmative rights might allow access to means of expression covered by intellectual property, particularly given that the state provisions may in some instances allow rights to access *real* property even where access has not been allowed under the federal First Amendment.

II. SUPREMACY CLAUSE PREEMPTION

The reflexive argument against application of state expressive guarantees to patents is that because patents are creatures of federal law, and because federal law preempts contrary state obligations, patents cannot be subjected to such state constitutional restrictions.³⁷ But we should be suspicious of such arguments at the outset, as it is clear that the disposition of patents and patented inventions is routinely subject to state law and state regulation.³⁸ The Supreme Court has certainly held that some types of state law enactments are

33. *Id.* at 343.

34. *Pruneyard Shopping Ctr.*, 447 U.S. at 80–81.

35. *Id.*

36. *Id.* at 82–83.

37. See TARR, *supra* note 15, at 43–44 (discussing how federal regulations, statutes, and constitutional provisions preempt conflicting state constitutional provisions).

38. See Paul Gugliuzza, *Patent Trolls and Preemption*, 101 VA. L. REV. 1579, 1582–83 (2015).

preempted by the operation of federal patent law.³⁹ But these problematic state statutes have typically been state enactments that in some way compete with or attempt to displace federal patent law, rather than state enactments that endorse or require a particular disposition of federal patents.

The question here would be whether state free speech provisions constitute impermissible interference with or permissible regulation of the disposition of federal patent rights. In order to separate permissible from impermissible state provisions, we look to constitutional preemption doctrines. Federal enactments may displace state enactments due to the Supremacy Clause found in the Federal Constitution.⁴⁰ Supremacy Clause preemption doctrine looks first to examine any express statement from Congress regarding the permissible interaction of state law with a given federal enactment.⁴¹ However, this first step in preemption analysis is of little assistance for patents. Unlike copyright, where Congress has enacted an explicit statutory provision spelling out the parameters of permissible state operation,⁴² the patent statute contains no express preemption language.⁴³

Thus, we have no explicit statement by Congress as to which, if any, state provisions it might have intended to displace under the Patent Act. Where Congress has not expressly preempted state enactments, the analysis then moves to consider implied preemption, gauging whether Congress intended to preclude state activity without having actually said so.⁴⁴ Implied preemption comes in two flavors: field preemption and conflict preemption.⁴⁵ Where Congress has “occupied the field” in a given area of regulation, or where alternatively a state law conflicts with Congressional purposes, the state law must give way.⁴⁶

39. *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 168 (1989); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 237–38 (1964); *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 231–32 (1964).

40. See U.S. CONST. art. VI, cl. 2; see also *Gade v. Nat’l Solid Waste Mgmt. Ass’n*, 505 U.S. 88, 108 (1992) (stating that the Supremacy Clause mandates preemption of state law that interferes with federal law).

41. *Gade*, 505 U.S. at 98.

42. 17 U.S.C. § 301 (2012); see generally Howard B. Abrams, *Copyright, Misappropriation, and Preemption: Constitutional and Statutory Limits of State Law Protection*, 1983 SUP. CT. REV. 509, 537–48 (1983) (tracing the history of the copyright preemption provision).

43. *Hunter Douglas, Inc. v. Harmonic Design, Inc.*, 153 F.3d 1318, 1332 (Fed. Cir. 1998).

44. *Retail Clerks Int’l Ass’n, Local 1625 v. Schermerhorn*, 375 U.S. 96, 103 (1963).

45. *Gade*, 505 U.S. at 98.

46. *Pac. Gas & Elec. Co. v. State Energy Res. Conservation & Dev. Comm’n*, 461 U.S. 190, 203–04 (1983).

The former type of implied preemption occurs where the regulatory structure in a given area indicates that Congress intended to exclude state activity.⁴⁷ Specifically, a reviewing court looks to see if federal regulation of the field is so pervasive or comprehensive that there is simply no latitude left for states to act.⁴⁸ The presence of pervasive federal regulation in a variety of areas—such as aviation or nuclear safety regulation—creates the inference that Congress intended to fully “occupy the field” of activity in question, leaving no room for the states to regulate.⁴⁹ This is more likely to occur in areas such as international relations or military operations, where federal rather than state interests are traditionally paramount. If the regulatory scheme appears to indicate such Congressional intent to preempt, courts infer that no state activity is permissible.

It has been well established that Congress has not occupied the field or wholly excluded the states from legislating on matters of intellectual property generally, or issues touching patent law in particular.⁵⁰ Federal patent law can and does operate concurrently with a host of state provisions that either operate on the federal patent grant or function in tandem with the federal patent grant. Sometimes state law provides alternative intellectual property options, as in the case of trade secrecy, which the Supreme Court has held is a permissible state adjunct to patent law.⁵¹ Other times state law is allowed—and even relied upon—to govern the disposition of federally created intellectual property, as in the case of state employment⁵² or state contract laws.⁵³

If Congress has not explicitly spoken to preemption, nor has it occupied the field, states may be permitted to regulate in the area assuming that they do not disrupt extant federal regulation. Preemption analysis then asks whether a given state activity impermissibly interferes with the intent of a particular overlapping federal statute.⁵⁴ Congress may have left room for state enactments, but a particular state enactment might still conflict with Congressional

47. Viet D. Dinh, *Reassessing the Law of Preemption*, 88 GEO L.J. 2085, 2105 (2000).

48. *Rice v. Santa Fe Elevator Corp.*, 331 U.S. 218, 230 (1947).

49. *English v. Gen. Elec. Co.*, 496 U.S. 72, 79 (1990).

50. See Dan L. Burk, *Protection of Trade Secrets in Outer Space Activity: A Study in Federal Preemption*, 23 SETON HALL L. REV. 560, 619–20 (1993).

51. *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 491–93 (1974).

52. See Robert P. Merges, *The Law and Economics of Employee Inventions*, 13 HARV. J.L. & TECH. 1, 4–5 (1999) (discussing state law governing employee invention and assignment).

53. See, e.g., *Aronson v. Quick Point Pencil Co.*, 440 U.S. 257, 262–64 (1979) (holding that state law licensing is not preempted by federal patent law).

54. *Fla. Lime & Avocado Growers, Inc. v. Paul*, 373 U.S. 132, 142–43 (1963).

purposes, in which case the state statute must give way. Potential conflicts between federal and state laws in the same field could occur if the state somehow stands as an obstacle to the intended outcome of federal regulation,⁵⁵ or if the state law upsets the balance that Congress has drawn in the field.⁵⁶ In the patent field, conflicting state statutes have tended to either duplicate the protections offered by federal patents,⁵⁷ or have attempted to withdraw from public use subject matter left deliberately unprotected by the patent statute.⁵⁸

III. PERMISSIBLE STATE REGULATION

In general, although the patent statute has no express preemption provision, there is ample evidence regarding Congress's intent that the statute promote innovation via pecuniary reward.⁵⁹ The Supremacy Clause question then becomes whether state constitutional provisions on expression conflict with or frustrate such Congressional purposes enacted through the patent statutes. The answer to the question depends in large measure on the particular action of the state provisions. Many avenues of state constitutional action could be preempted: the patent statute sets forth substantive requirements for accomplishing the general congressional goal that would override any contrary or variant state requirements.

For example, it seems clear that state constitutional law could not dictate the requirements for issuance of patents; such state law would be preempted by either express or implied Congressional intent as manifest in the federal patent statute.⁶⁰ Consequently, state constitutional provisions could not prevent issuance of patents implicating speech, nor could they invalidate issued patents that did so. Similarly, the Supremacy Clause would likely prevent states from meddling with patents implicating speech by attempting to dictate patentable subject matter, claim breadth, or other doctrinal characteristics intrinsic to the patent system. Federal preemption presumably cordons off not only doctrinal provisions found explicitly in the patent statute, but also federal common law provisions, such as

55. *Hines v. Davidowitz*, 312 U.S. 52, 67 (1941).

56. *City of Burbank v. Lockheed Air Terminal, Inc.*, 411 U.S. 624, 638–39 (1973).

57. *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 231 (1964).

58. *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 164–65 (1989); *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 122 (1938).

59. *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 480–81 (1974).

60. *See, e.g.*, 35 U.S.C. § 151 (2012) (stating that a patent “shall” be issued if the applicant is entitled under the law and pays the required fee).

patent law's Doctrine of Equivalents,⁶¹ or exhaustion, that constitute judicial glosses derived implicitly or explicitly from the statute.⁶²

But this leaves open a wide range of state regulatory enactments that do not necessarily conflict with Congressional intent for patents, in particular, those dealing with the *disposition* of patents. As already mentioned, the federal patent statute explicitly imbues patents with the attributes of personal property,⁶³ and personal property is unquestionably subject to state regulation. Patents are routinely bought, sold, licensed, and traded, all under the constraints of state contract law.⁶⁴ They may be otherwise devised, inherited, or encumbered under relevant state law.⁶⁵ Indeed, the application of such state law seems to have been anticipated and expected by Congress as an integral part of the patent system.⁶⁶

A. *Traditional State Purview*

Supremacy Clause jurisprudence indicates that federal preemption of state enactments is least likely in areas where states have a long history of oversight and have traditionally had wide regulatory latitude.⁶⁷ State “police powers” over health and safety regulation are the most commonly cited subjects of state privilege.⁶⁸ In the absence of any Congressional indication to the contrary, this would seem to apply to patents and patented inventions. States regularly restrict or ban the use or sale of patented devices that are dangerous, harmful, or even immoral.⁶⁹ There is good reason to believe that the States would be well

61. See Doug Lichtman, *Substitutes for the Doctrine of Equivalents: A Response to Meurer and Nard*, 93 GEO. L.J. 2013, 2013 (2005) (describing the Doctrine of Equivalents).

62. See Herbert Hovenkamp, *Patent Exhaustion and Federalism: A Historical Note*, 102 VA. L. REV. ONLINE 25 (2016) (arguing that federal judicial doctrine of exhaustion evolved so as to protect state licensing from Supremacy Clause preemption).

63. 35 U.S.C. § 100 (2012).

64. See *Aronson v. Quick Point Pencil Co.*, 440 U.S. 257, 262 (1979).

65. See *Jim Arnold Corp. v. Hydrotech Sys., Inc.*, 109 F.3d 1567, 1572 (Fed. Cir. 1997) (stating that patent ownership is a matter for state courts); *Roach v. Crouch*, 524 N.W.2d 400, 403 (Iowa 1994) (holding that ownership of a patent is properly tried in state court).

66. See 35 U.S.C. § 261 (2012) (“[P]atents shall have the attributes of personal property.”).

67. See *Gregory v. Ashcroft*, 501 U.S. 452, 460 (1991).

68. *Rice v. Santa Fe Elevator Corp.*, 331 U.S. 218, 230 (1947).

69. See, e.g., *Whistler Corp. v. Autotronics, Inc.*, 14 U.S.P.Q.2d (BNA) 1885 (N.D. Tex. 1988) (noting that use of patented radar detector would be illegal in some states, but not others); see also *Hunter Douglas Inc., v. Harmonic Design, Inc.*, 153 F.3d 1318, 1335 (Fed. Cir. 1998) (holding that state tort claims are preempted by federal patent law only when, as applied, they address conduct protected under the federal statute).

within their powers to similarly ban the assertion of patents that are fraudulent, criminal, or anticompetitive.⁷⁰

An important consideration in this regard is that the patent owner's federal rights are a collection of *exclusive* rights, that is, the right to exclude others from engaging in the manufacture, use, sale, offer, and importation of the invention set forth in the patent claims.⁷¹ The patent is not an affirmative right to practice the claimed invention. In particular, the patent owner obtains no right to practice the invention contrary to the operation of regulation or legal oversight, whether instigated at the federal, local, or state level. For example, the patent confers no right to manufacture, sell, or import embodiments of the invention that are restricted as unhealthy, unsafe, or environmentally destructive. Neither is the patented invention exempt from regulatory inspection, certification, taxation, seizure, or forfeiture. The mere presence of a patent covering a particular invention in no way endorses deployment of that invention to further nuisance, defamation, or other state-regulated damage or injury.

The legitimacy of state regulation in fields where federal regulation is also operative is strongly bolstered if states are regulating in areas where they have traditionally been active or prominent. We have already noted that state law has been the primary means for disposition of patents, but more broadly it is clear that the states have an established provenance, by legislation or otherwise, to regulate in general the use and disposition of property. The express language of the patent statute supports this conclusion; precisely because the federal statute specifies that patents are to have the character of personal property, they may presumably be regulated by the state in the same way that the state regulates such property.⁷²

70. See Christopher R. Leslie, *The Role of Consumers in Walker Process Litigation*, 13 SW. J.L. & TRADE AM. 281, 307 (2007); see also *Hunter Douglas, Inc.*, 153 F.3d at 1336 (holding that state tort actions may apply to bad faith assertion of patents).

71. See 35 U.S.C. § 154(a)(1) (2012).

72. *But cf.* Tun-Jen Chiang, *Rehabilitating the Property Theory of Copyright's First Amendment Exemption*, 89 NOTRE DAME L. REV. 521, 573 (2013) (asserting that “[t]o the extent that a state constitution attempted to create a right to infringe federal copyrights, it would be trumped by the Supremacy Clause”). A full discussion of copyright preemption is well beyond the brief of this article, so I will merely note that unlike the patent statute, the copyright statute contains an express preemption provision that prevents the states from providing rights equivalent to those of copyright. See 17 U.S.C. § 301 (2018). Beyond that, it is clear that states can regulate the disposition of copyrights in a wide variety of circumstances as property, for example by penalizing or prohibiting obscene copyrighted material, see *Mitchell Bros. Film Grp. v. Cinema Adult Theater*, 604 F.2d 852, 858 (5th Cir. 1979) (concluding that the 1909 copyright statute contained no explicit or implicit bar to the copyrighting of obscene works), or allocating

B. Regulating Federally Created Property

Ownership in tangible property is typically an entitlement under state law, so that when states balance state constitutional rights against the exclusivity of real property owners, the states are to some extent simply modifying or characterizing their own legal enactments. Similarly, to the extent that intellectual property, as a set of exclusive rights, may resemble rights in tangible property, then along with that analogy comes the caveat that the rights entailed in real or chattel property are governmental creations and are subject to governmental regulation and restriction. In the case of patents, creation and regulation are effectuated under different regimes; unlike the conventional rights in real property, patents are a grant of property rights by the federal government. But we have already noted that such rights are transferred and effectuated according to state law. There is no reason to believe that federally granted rights necessarily are immune to state regulation.

To the contrary, state property regulation may include federally created property. Certainly we can point to other examples of state regulation concerning federal endowments of exclusivity, including those that implicate speech. In previous work I have argued that useful parallels regarding the interaction of federally granted exclusivity and freedom of speech may be gleaned from the example of broadcast spectrum allocation.⁷³ Spectrum broadcast shares with patentable inventions certain “public good” characteristics that require regulation in order to encourage investment and prevent conflicting usages; spectrum allocations prevent signal congestion while encouraging productive use of a common resource. The allocation of broadcast frequencies is reserved to federal regulation. Federal spectrum allocation grants recipients an exclusive right to a public resource, allocated privately for the ultimate benefit of the public.

As in the analysis of patents and the federal First Amendment, federal spectrum governance may provide the best antecedent for

copyrights as marital assets in community property, see *Rodrigue v. Rodrigue*, 218 F.3d 432, 439 (5th Cir. 2000) (finding economic interest in federal copyright to be community property under Louisiana law); *In re Marriage of Worth*, 195 Cal. App. 3d 768, 773 (Cal. Ct. App. 1987) (finding federal copyright to constitute community property under California law). See also R. Anthony Reese, *Be Careful Where You Live When You Die: Termination of Copyright Transfers and the Road to Marriage Equality*, UC Irvine School of Law Research Paper No. 2015-58, https://papers.ssrn.com/sol3/papers.cfm?abstract_id=2608130 (discussing the impact of state marriage law on copyright reversionary interests).

73. See Burk, *Patents and the First Amendment*, *supra* note 1, at 239–43.

comparison when thinking about state constitutional rights. Federal law allocates exclusive use of a particular frequency of broadcast on the electromagnetic spectrum. Recipients of federal licenses have an effective property interest in their allocation; they can exclude others from broadcasting on the allocated frequency and can sell or sublicense communicative activity on their frequency—for example in the form of advertising. States are preempted from engaging in their own allocative preferences or procedures.⁷⁴

States cannot determine the allocation or re-allocation of spectrum exclusivity granted by federal authority. But states can surely punish use of federally allocated spectrum to engage in libel, fraud, or criminal activity.⁷⁵ By the same token, although states cannot prevent issuance of patents on inventions that could be used to damage the environment, commit fraud, or physically injure a user, they can surely regulate or even prohibit the deployment of such inventions, patented or not.⁷⁶ And if states can curtail or regulate the use of patents that facilitate bodily or reputational injury, they surely can, by the same logic, curtail or regulate the use of patents that facilitate or inflict constitutional injury.⁷⁷

IV. PATENT EASEMENTS

Patent disposition, like that of other property, may therefore be said to fall within the historical regulatory purview of the states. As I have pointed out before, the favored comparison of intellectual property to real property—a dubious analogy at best⁷⁸—carries with it the implication that easements and other public regulation may apply to intellectual property just as to real property.⁷⁹ Whether imposed by federal or state regulatory requirements, exemptions to patent exclusivity parallel easements in real property. Understanding this parallel is useful in extrapolating from existing state constitutional speech cases. State constitutional decisions allowing the exercise of expression on private property validate limitations on the property

74. 45 U.S.C. § 253(a) (2012).

75. 45 U.S.C. § 253(b) (2012).

76. See *supra* note 65 and accompanying text.

77. Cf. Friesen, *supra* note 10, at 130 (arguing that private deprivation of rights guaranteed under the California state constitution would entail a constitutional tort).

78. See Mark A. Lemley, *Property, Intellectual Property, and Free Riding*, 83 TEX. L. REV. 1031 (2005) (questioning the frequent but facile comparison between intellectual property and real property).

79. See Dan L. Burk, *Muddy Rules for Cyberspace*, 21 CARDOZO L. REV. 121, 123–24 (1999).

owner's right to exclude unwanted speakers or messages from the property owner's physical space. This might be thought of as a type of public easement for a limited purpose, intruding on the property owner's normal exclusivity to effectuate a critical public interest—indeed, this is largely how the California Supreme Court in *Pruneyard* justified the state constitutional expressive interest.⁸⁰

A. *Compulsory Patent Licensing*

Application of state constitutional guarantees to patent exclusivity would likely entail a balancing against the patent owner's right to exclude unwanted uses of the claimed invention, much like the four-part inquiry found in the California *Pruneyard* analysis. This potential dispositional easement may be thought of in terms of compulsory licensing of the affected patent.⁸¹ In intellectual property law, user privileges and exemptions, like public easements, often resemble a compulsory license at a zero royalty—the public gains access to the property, cannot be excluded, and in many cases may have no obligation to pay for access.⁸² In other cases, compulsory licenses shift the exclusive rights in property toward a liability regime, in which the owner retains a right to be paid, but surrenders the right to exclude.

Compulsory licensing, although fairly common in conjunction with federal copyright, is something of a rarity in U.S. patent law. Patent law includes a very few explicit instances of compulsory patent licensing, covering technologies considered essential to federal policies on nuclear power generation and environmental protection.⁸³ Courts have also been known to impose what are effectively compulsory licenses in situations where public health or safety is deemed to require the unauthorized use of patented technology. Thus, for example, in *City of Milwaukee v. Activated Sludge*, the Seventh Circuit denied a permanent injunction against the city's infringing use of a patented sewage treatment process, granting the patent owner only damages on grounds of the public interest.⁸⁴ By denying the injunction, the court essentially created a compulsory license at a royalty set at the measure of proven damages.

80. 592 P.2d 341, 346 (1979).

81. See Dan L. Burk, *Punitive Patent Liability: A Comparative Examination*, 37 REV. LITIG. 327, 347–48 (2018).

82. See Dan L. Burk, *Intellectual Property in the Cathedral*, 4 ZEITSCHRIFT FÜR GEISTIGES EIGENTUM/INT. PROP. J. 405, 408 (2012).

83. 42 U.S.C. §§ 2183(e), 7608 (2012).

84. 69 F.2d 577, 593 (7th Cir. 1934).

Until recently, such cases were a historical oddity due to the tight conceptual coupling between property and exclusivity. Property may entail multiple rights and privileges but is frequently characterized by the right to exclude, which is typically exercised via judicial injunctions prohibiting some type of activity deemed to infringe on the property.⁸⁵ Thus, a permanent injunction against further infringing trespasses was long considered routine upon a finding of patent infringement.⁸⁶

But although patents are intended under their statute to be treated as personal property⁸⁷ and the right to exclude is typically viewed as a key component of property entitlements, the Supreme Court has made clear that patent owners are not always entitled to exercise their exclusive rights.⁸⁸ Exclusive rights are typically exercised by means of judicial injunction, but the patent statute provides for such injunctions only after consideration of equitable principles.⁸⁹ According to the Supreme Court in *eBay v. MercExchange*, the relevant equitable factors to be considered include the adequacy of a damages remedy, the comparative balance of hardships between the parties when issuing or denying an injunction, and the public interest.⁹⁰ Where these factors do not align in favor of an injunction, the patent owner is still entitled to damages upon a finding of infringement, but may be denied exclusivity, resulting in what is effectively a compulsory license at a royalty determined by the court.⁹¹

The *eBay* injunctive calculus points toward potential free speech “easements” in the patent property right. In considering whether to allow a patent owner to exclude expressive activity involving the patented invention, we can anticipate a federal court denying the patent owner an injunction, based on the public interest prong of the *eBay* standard. Whereas in *City of Milwaukee* the injunction was denied due to the public interest in sanitation, in an expressive rights challenge

85. See Burk, *supra* note 79, at 134. *But cf.* Shyamkrishna Balganes, *Demystifying the Right to Exclude: Of Property, Inviolability, and Automatic Injunctions*, 31 HARV. J.L. & PUB. POL’Y 593, 638–39 (2008) (noting that the modern equation of property with the right to an injunction overlooks the equitable roots of injunctive relief).

86. See, e.g., *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1246–47 (Fed. Cir. 1989).

87. 35 U.S.C. § 261 (2012).

88. *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 392–93 (2006).

89. 35 U.S.C. § 283 (2012).

90. *eBay Inc.*, 547 U.S. at 391. A fourth factor listed by the Court is the likelihood of irreparable injury to the patent holder, but this seems coterminous with the adequacy of legal remedies. See THOMAS F. COTTER, *COMPARATIVE PATENT REMEDIES: A LEGAL AND ECONOMIC ANALYSIS*, 102, 102–03 (2013).

91. Burk, *supra* note 82, at 410.

an injunction might be denied due to the public interest in speech. Presumably, there is nothing that would prevent a federal court from taking into account state articulations of public policy, and, to the extent they did not conflict with Congressional intent, relying upon them as factors in determining the *eBay* public interest element. One might also formulate the interest in state constitutional expressive guarantees in terms of the other *eBay* factors; for example, in some instances the denial of speech might be considered to impose too great a hardship on the infringing party, especially where a damages remedy might offer adequate compensation for the patent holder.

B. Reverse eBay Analysis

The implications of the Supreme Court's *eBay* calculus might also open the door to state court injunctions mandating speech-related disposition of a patent, or requiring a patent holder to permit expressive use of the patented invention. *eBay* tells us that the public interest—presumably including the public interest in state constitutional guarantees—is, by federal statute, a consideration affecting the exclusivity of patent rights. This suggests that it is permissible for the states to consider this congressionally mandated equitable element in a type of “reverse *eBay*” calculus—not with regard to whether infringement of a federally issued patent deserves equitable relief, but with regard to whether a federally patented invention can permissibly be deployed to suppress state guarantees regarding speech. A state court called upon to effectuate state constitutional speech guarantees in the face of patent exclusion might properly consider whether state constitutional rights would diminish or extinguish the patent holder's ability to obtain an injunctive remedy were the patent before a federal court.

Original jurisdiction for any claim arising under federal patent statutes must lie in federal district court,⁹² but a claim regarding state constitutional relief is not a claim arising under patent law and could

92. 28 U.S.C. § 1338(a) (2012). Assertion of a patent-based counterclaim, such as for infringement damages, might be sufficient to remove the case to federal court. *See* 28 U.S.C. § 1454 (2012). However, the Supreme Court has indicated that federal statutory “arising under” subject matter jurisdiction is only triggered when is sufficiently substantial to affect a case's outcome. *See Gunn v. Minton*, 568 U.S. 251, 258–59 (2013) (holding that an issue of patent validity was not sufficiently substantial to remove a professional misconduct case from state to federal court); *see also Vermont v. MPHJ Tech. Invs., LLC*, 803 F.3d 635, 645 (Fed. Cir. 2015) (opining in dicta that patent preemption claims should be considered “arising under” federal law).

be decided in state court.⁹³ As with the equitable calculus required under *eBay*, the congressional policy in favor of patent exclusivity should weigh heavily in the consideration of a state court injunctive proceeding. And whereas under *eBay* the public policy favoring patent incentives would weigh toward an injunction restraining an infringer, in a “reverse *eBay*” proceeding it would weigh against the injunction restraining enforcement by the patent owner. But other interests such as a state policy in favor of free expression might, in certain circumstances, tip the scales in favor of effectuating state constitutional guarantees.

The outcome of such considerations might be access to, or at least the right not to be excluded from, use of the patented expressive technology. But access might not necessarily be costless; damages or a reasonable royalty might still accrue in the absence of injunctive exclusion.⁹⁴ Such compulsory licensing would preserve the economic value of the patent, if not the full exclusive rights in the patent. Not coincidentally, such preservation of economic value was a key component in the *Pruneyard* analysis, leading the California Supreme Court to conclude that the balance of interests between state constitutional guarantees and private property rights tipped toward public speech interests.⁹⁵ Similarly, preservation of the property owner’s economic interests in *Pruneyard* led the United States Supreme Court to approve the California Supreme Court’s analysis as not amounting to a taking of property.⁹⁶

Additionally, while the state constitutional requirement could not preclude federal statutory remedies, a state constitutional remedy could well be crafted in such a way as to either negate the benefit of the contemporaneous infringement remedy or to coerce the patent holder into surrendering the benefit of the federal remedy. For example, state courts can require the surrender or transfer of federally created intellectual property rights, just as they can require the surrender or transfer of any other personal property.⁹⁷ There is no

93. Cf. *Gunn*, 568 U.S. at 258 (holding that a state law patent malpractice claim did not confer original jurisdiction as it did not arise under federal patent law); *Thompson v. Microsoft Corp.*, 471 F.3d 1288, 1291–92 (Fed. Cir. 2006) (stating that state law unjust enrichment claim was not preempted by, and did not arise under federal patent law so as to confer original federal jurisdiction).

94. 35 U.S.C. § 284 (2012).

95. See 592 P.2d 341, 343–46 (1979).

96. See *Pruneyard Shopping Ctr. v. Robins*, 447 U.S. 74, 80–81 (1980).

97. See, e.g., *Sheshtawny v. Sheshtawny*, 150 S.W.3d 772, 774 (Tex. App. 2004) (dividing a patent in a divorce); see also *Enovsys LLC v. Nextel Commc’ns., Inc.*, 614 F.3d 1333, 1343 (Fed.

reason to believe that a state court injunction requiring a patent holder to allow access to a patented technology, perhaps on pain of transfer of the patent, would run afoul of the Supremacy Clause, particularly if the patent holder is paid a reasonable royalty.⁹⁸

V. INVITING PUBLIC ACCESS

The analysis to this point suggests that the argument for state constitutional guarantees would be strongest where a patent that impedes expression could be subject to an easement or compulsory license for access. Additionally, the argument for the exercise of state constitutional expressive guarantees in the patent context would likely be strongest where the circumstantial balance of public and private interests most closely parallels the circumstantial balance of interests arising in the cases validating expressive rights on private land.⁹⁹ Presumably, such circumstances would need to include some degree of public use or accommodation parallel to the use of real property such as a mall or similar publicly accessible space.¹⁰⁰ Of course, the parallel cannot be exact, but certainly one might identify situations in which either the patented technology is essential for communication to the public, or has been held out to the public for access and then withdrawn. Optimally, both of these factors would be present in order to invoke state constitutional guarantees.

One close possible parallel, in which a patent might be said to have been held out for public use or accommodation, might arise in the case of standard essential patents, or SEPs.¹⁰¹ Many situations exist in which compliance with technical standards is required for a given device to function in connection with other compatible devices, as for example in telecommunications.¹⁰² Without the common technical standard, interaction between the devices is impossible. In some cases, the

Cir. 2010) (holding that ownership of the patent in suit was determined by a California state divorce decree).

98. See Burk, *supra* note 81, at 349–50 (discussing the development of judicially determined “ongoing” patent royalties following *eBay*).

99. Cf. Friesen, *supra* note 10, at 115 (arguing that state constitutional guarantees may be properly limited by balancing against other private interests).

100. Cf. *Golden Gateway Ctr. v. Golden Gateway Tenants Ass’n*, 29 P.3d 797, 810 (Cal. 2001) (holding that a type of expressive “state action” requirement is met under the California Constitution where private property has been held open and accessible to the public).

101. Alison Jones, *Standard Essential Patents: FRAND Commitments, Injunctions, and the Smartphone Wars*, 10 EURO. COMP. J. 1 (2014).

102. *Id.*; Joseph Scott Miller, *Standard-Setting, Patents, and Access Lock-In: RAND Licensing and the Theory of the Firm*, 40 INDIANA L. REV. 351, 351–53 (2007).

essential standard will be subject to a patent. In cases where the technical standard is covered by the SEP, the potential for legal exclusion from the standard becomes highly problematic: device manufacturers who cannot incorporate the patented standard into their products are effectively shut out of the market.¹⁰³

Consequently, industry adoption of a patented standard will frequently occur only in conjunction with a public declaration by the patent holder that all users will be allowed to adopt the standard under fair, reasonable, and non-discriminatory (FRAND) licenses.¹⁰⁴ The patent is, in other words, held out to all potential licensees who are willing to pay a reasonable royalty. Disputes have arisen in which the patent holder, after making a public FRAND commitment, offers licenses that seem unfair or unreasonable.¹⁰⁵ In other cases, patent owners have attempted to enjoin unauthorized uses of the standard, despite having promised FRAND terms to all users—that is, the patent holder seeks court-enforced exclusivity in circumstances where the FRAND royalty would seem to be the proper measure of damages.¹⁰⁶

Significantly, FRAND disputes have been characteristic of telecommunications patents as a class of patents that will frequently implicate expressive interests and which may be essential for public communication. Disputes over such patents might be a fertile ground for application of state constitutional speech guarantees, paralleling past state constitutional cases, such as *Pruneyard*, that involve speech on real property. The FRAND commitment parallels the public invitation common to cases such as *Pruneyard*, in which public access to private property was held to include expressive activity. Such cases also often entail an element of expressive necessity, by which public communication would be curtailed or suppressed without access to the private property. In a similar vein, exclusion from a communication-related SEP, much like exclusion from community venues such as shopping centers, would be devastating to public communication.

Indeed, some commentators have suggested that the refusal of a previously publicly offered FRAND license should be analyzed as a

103. Joseph Farrell, *Standardization and Intellectual Property*, 30 JURIMETRICS J. 35, 43 (1989).

104. Thomas F. Cotter, *Comparative Law and Economics of Standard-Essential Patents and FRAND Royalties*, 22 TEX. INTELL. PROP. L.J. 311, 311–13 (2014).

105. *Id.*

106. See Burk, *supra* note 81, at 355; see also William F. Lee & A. Douglas Melamed, *Breaking the Vicious Cycle of Patent Damages*, 101 CORNELL L. REV. 385, 387–446 (2016).

species of fraud, or breach of contract, or promissory estoppel.¹⁰⁷ Notably, these are all state law doctrines that might be employed to penalize a “bait and switch” maneuver by an SEP owner. The fact that a patent was the subject of the fraudulent or estopped offer does not prevent state doctrines from penalizing the SEP owner. Similarly, a state constitutional right of expression might also mandate that an SEP patent owner permit public access as promised, particularly if the economic value of the patent is preserved by payment of a reasonable royalty.

VI. PETITION CLAUSE PREEMPTION

An alternative set of constitutional preemption considerations could arise from a somewhat neglected provision of the First Amendment, the Petition Clause, which prohibits governmental interference with the right to petition the government for redress of grievances.¹⁰⁸ This portion of the First Amendment forms the basis for the *Noerr-Pennington* line of cases, which interprets the Petition Clause as prohibiting an assertion of antitrust claims against defendants who have lobbied for legislation that could prove anticompetitive.¹⁰⁹ That rationale has been further extended by the Supreme Court to prohibit the use of court proceedings to assert antitrust claims against plaintiffs for asserting their own potentially anticompetitive claims in court.¹¹⁰

107. See Robert P. Merges & Jeffery M. Kuhn, *An Estoppel Doctrine for Patented Standards*, 97 CAL. L. REV. 1, 11–13 (2009); Mark A. Lemley, *Intellectual Property Rights and Standard-Setting Organizations*, 90 CAL. L. REV. 1889, 1914, 1935 (2002).

108. U.S. CONST. amend. I. I note also in passing that there is a third potential source of constitutional preemption, which is the presence of the Patent Clause itself. As I have discussed in previous work, one purpose for adding Article I, section eight, clause eight to the roster of Congressional powers was to remove from the purview of the states conflicting assertions of patents and copyrights, parallel with the purpose of the federal commerce power. See Burk, *supra* note 50, at 612–13. Jurisprudence on the operation of such a “dormant Patent Clause” has never developed, although the famous commerce power decision in *Gibbons v. Ogden* was decided on such grounds by the lower courts before the case reached the attention of Justice John Marshall. See *id.* at 609–10. In any event, this type of preemption seems inapplicable to the current discussion, as assertion of state constitutional clauses on expressive freedom does not attempt to displace the federal patent power. Cf. Jeanne Fromer, *The Intellectual Property Clause’s Preemptive Effect*, in INTELLECTUAL PROPERTY AND THE COMMON LAW 265 (Shyamkrishna Balganes, ed., 2013) (arguing that the constitution’s Intellectual Property Clause has independent preemptive force).

109. E. R.R. Presidents Conference v. Noerr Motor Freight, Inc., 365 U.S. 127, 137–38 (1961); United Mine Workers v. Pennington, 381 U.S. 657, 670 (1965); see generally David McGowan & Mark A. Lemley, *Antitrust Immunity: State Action and Federalism, Petitioning and the First Amendment*, 17 HARV. J.L. & PUB. POL’Y 293 (1994) (explaining the *Noerr-Pennington* petition cases).

110. See Cal. Motor Transp. Co. v. Trucking Unlimited, 404 U.S. 508, 510–11 (1972).

The Court has held that such immunity against antitrust penalties does not extend to the assertion of “sham” or objectively baseless claims, but the threshold for triggering the sham litigation exception is quite high.¹¹¹

Although the Supreme Court has never applied this doctrine outside the antitrust context, some lower courts have extended the Supreme Court’s *Noerr-Pennington* rationale broadly in a variety of fields to bar assertion of state tort claims, such as misappropriation or abuse of process, that might be viewed as penalizing assertion of non-frivolous court actions.¹¹² In the patent context, the Federal Circuit has embraced this rationale to shield the actions of patent holders, either in litigation or in preparation for litigation, against state penalties unless the enforcement action taken by the patent holder is objectively baseless.¹¹³

As recent commentary has pointed out, the Federal Circuit’s extension of *Noerr-Pennington* considerations beyond the antitrust context is dubious, as the Supreme Court’s original analysis was as dependent on the character of the Sherman antitrust statute as it was on the constitutional Petition Clause.¹¹⁴ The Supreme Court has additionally made clear in other cases that, as a provision of the First Amendment, the Petition Clause does not confer protections to petitioning speech that are more extensive than those conferred by more familiar provisions of the First Amendment.¹¹⁵ This suggests that where the Petition Clause is implicated, its limitation on state regulation should track the outlines of First Amendment expressive guarantees that I have traced above, and state constitutional provisions that are *more* protective of speech than the Federal Constitution have never been perceived as interfering with federal guarantees.

It seems in any event unlikely that the Petition Clause is necessarily implicated in the assertion of state constitutional guarantees. So long as the requirement of the state constitutional provision is not framed as a denial of or penalty against patent enforcement, there is no reason for the Petition Clause to apply. For example, the type of compulsory licensing remedy I have suggested above does not bar patent holders

111. *Prof'l Real Estate Inv'rs, Inc. v. Columbia Pictures Indus.*, 508 U.S. 49, 60–62 (1993).

112. *See* Gugliuzza, *supra* note 38, at 1645.

113. *Globetrotter Software, Inc. v. Elan Comput. Grp.*, 362 F.3d 1367, 1376–77 (Fed. Cir. 2004); *Golan v. Pingel Enter., Inc.*, 310 F.3d 1360, 1371 (Fed. Cir. 2002).

114. Gugliuzza, *supra* note 38, at 1612–13.

115. *See* *McDonald v. Smith*, 472 U.S. 479, 485 (1985).

from seeking redress in court, even if the outcome may not be the one preferred by a patent holder. Like other state law doctrines regarding the disposition of patents, state constitutional guarantees do not bar a patent owner from access to a tribunal, even if they may properly affect the outcome of adjudication.

CONCLUSION

State constitutional speech provisions offer a narrow pathway toward resolution of the tension between patents over expressive technologies and expressive freedom. As I have described here, only a minority of states has recognized broader protections for speech under their constitutions, and even among those states, courts have been cautious about imposing on the rights of property owners. Nonetheless, in some circumstances, a state constitutional claim to expressive freedom may be preferable to a federal constitutional claim.

Thus, for example, in a recent article discussing the federal First Amendment implications of patents, Professor Chiang speculates about the potential use of patents on methods of communication to restrict political speech.¹¹⁶ In a state such as Oregon or New Jersey, assertion of state constitutional guarantees of expression might provide relief from the exclusion of such communication that sidesteps the tricky question of First Amendment state action. Similarly, as I have outlined here, state constitutional expression might provide an alternative to antitrust claims for SEP FRAND disputes. Relying on state constitutional provisions may substitute the question of federal preemption for that of state action, but following the analysis I have laid out here, this issue may be a preferable ground to litigate depending upon the plaintiff's circumstances.

116. See Chiang, *supra* note 1, at 320–21, 323–24. Professor Chiang recommends that patent misuse doctrine should be extended to deter such discriminatory enforcement of patents. See *id.* at 361–62.