SUPREME COURT OF THE UNITED STATES

No. 92–114

CARDINAL CHEMICAL COMPANY, ETC., ET AL., PETITIONERS *v.* MORTON INTERNATIONAL, INC.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

[May 17, 1993]

JUSTICE SCALIA, with whom JUSTICE SOUTER joins, concurring in part and concurring in the judgment.

I agree that the Federal Circuit erred in holding that the invalidity claim became moot once it was determined that the patent had not been infringed. Moreover, though the Federal Circuit had discretion to reach (or not to reach) respondent's appeal of the declaratory judgment ruling, it was an abuse of discretion to decline to reach it for that erroneous "mootness" reason—constituting, in effect, a failure to exercise *any discretion at all*. I therefore join the judgment of the Court, and all of its opinion except Part IV.

In Part IV the Court determines that, upon remand, the Federal Circuit may not, "*on other grounds*," *ante*, at 15 (emphasis added), continue its practice of declining review in these circumstances, set out in *Vieau* v. *Japax, Inc.*, 823 F. 2d 1510 (1987). That point is much less tied to general principles of law with which I am familiar, and much more related to the peculiarities of patent litigation, with which I deal only sporadically. It need not be reached to decide this case, and I am unwilling to reach it because of the lack of adversary presentation.

The lack of adversariness was frankly acknowledged at oral argument. See, *e.g.*, Tr. of Oral Arg. 25, 37 ("On the limited issue before this Court, where there is a declaratory judgment held, we do not have any difference whatsoever"). Petitioners and respondent disagree only as to some hypothetical applications of the Federal Circuit's

reviewing authority—applications clearly outside the facts of this case—and are in utter agreement concerning the invalidity of the *Vieau* practice. The briefs starkly reflect this uniformity: Respondent's brief, in a mere 10 pages of argument, essentially incorporates by reference much of petitioners' brief, which in turn largely reflects Chief Judge Nies' dissent from the denial of en banc review below. Brief for Respondent 8–9. (Not surprisingly, petitioners did not bother to file a reply brief responding to their own echo.) *Amici* likewise all weighed in on the single side in this case, one of them even identifying its submission as "in support of petitioners & respondents." Brief for Federal Circuit Bar Association as *Amicus Curiae*. While this harmony is heartwarming and even (since it reduces the number and length of briefs) environmentally sound, it may encourage us to make bad law.

In the past, when faced with a complete lack of adversariness, we have appointed an *amicus* to argue the unrepresented side. See, *e.g.*, *Toibb* v. *Radloff*, 501 U. S. ——, ——, n. 4 (1991); *Bob Jones University* v. *United States*, 461 U. S. 574, 585, n. 9, 599, n. 24 (1983); *Granville-Smith* v. *Granville-Smith*, 349 U. S. 1, 4 (1955). Cf. *INS* v. *Chadha*, 462 U. S. 919, 939–940 (1983). The wisdom of that course is shown by *Cheng Fan Kwok* v. *INS*, 392 U. S. 206, 210 (1968). That case, like this one, involved a Court of Appeals' refusal to decide—the Third Circuit's determination that it lacked jurisdiction to review the INS's denial of petitioner's application for a stay of deportation. And in that case, as in this one, both parties agreed that the Court of Appeals *should* have decided the case. We appointed an *amicus* to defend the judgment below, *id.*, at 210, n. 9, and ended up *affirming* the determination rejected by the parties.

I agree with the Court that the parties' total agreement as to disposition of this case poses no constitutional barrier to its resolution. *Ante*, at 4, n. 9. For prudential reasons, however, I would frame the resolution more narrowly. I can say with confidence

that the question of the validity of the patent is not moot, so that mootness was an impermissible ground for failing to decide validity. It seems to me that is enough for us to determine for the moment. If supposed mootness was in fact the only support for the *Vieau* policy, the Federal Circuit will abandon it and we will never see the issue again. If, however, there is some other support, we should hear about it from counsel before we reject the policy out of hand.

The issue of discretionary refusal (as opposed to the issue of mootness) is, it seems to me, more than usually deserving of adversary presentation. It involves the practicalities of the Federal Circuit's specialized patent jurisdiction, rather than matters of statutory or constitutional interpretation with which we are familiar. The opinions of the Federal Circuit do not discuss the practical benefits of the *Vieau* practice, nor can we find them discussed in the opinions of other courts, the Federal Circuit's jurisdiction over patent appeals being exclusive, see 28 U. S. C. §1295(a). One must suspect, however, that some practical benefits exist, since despite the fragility of the "mootness" jurisdictional justification that we reject today, *Vieau* has enlisted the support of the experienced judges on the Federal Circuit—who denied en banc review despite criticism of *Vieau* in Chief Judge Nies' opinion dissenting from the denial, 967 F. 2d 1571 (1992), and in Judge Lourie's panel concurrence, 959 F. 2d 948, 952 (1992).

For these reasons, I concur in the judgment of the Court, and join all of its opinion except Part IV.