
*Separation of Powers — Appointment and Removal — Principal
and Inferior Officers — United States v. Arthrex, Inc.*

Thirty-three years ago, in *Morrison v. Olson*,¹ the Supreme Court announced a loose, functionalist test for distinguishing between “principal” and “inferior” “Officers of the United States.”² But the Court quickly retreated from *Morrison*’s functionalism,³ leading some observers to ask whether *Morrison* remained good law.⁴ Last Term, in *United States v. Arthrex, Inc.*,⁵ the Supreme Court held — without discussing or citing *Morrison* — that certain Patent and Trademark Office (PTO) officials exercised powers inconsistent with inferior-officer status.⁶ Although *Arthrex* did not formally overrule *Morrison*, its reasoning suggests that *Morrison*’s inferior-officer holding should be limited to its facts.

The Constitution distinguishes between principal and inferior “Officers of the United States.”⁷ Principal officers, but not inferior officers, must be appointed by the President with the advice and consent of the Senate.⁸ They must also, with exceptions not relevant here, be removable by the President at will.⁹

¹ 487 U.S. 654 (1988).

² *Id.* at 670 (quoting *Buckley v. Valeo*, 424 U.S. 1, 132 (1976) (per curiam); U.S. CONST. art. II, § 2, cl. 2); *see id.* 670–72; *see also* William N. Eskridge, Jr., *Relationships Between Formalism and Functionalism in Separation of Powers Cases*, 22 HARV. J.L. & PUB. POL’Y 21, 24 (1998) (“*Morrison* is typically taught as a functionalist opinion . . .”).

³ *See* *Edmond v. United States*, 520 U.S. 651, 661–63 (1997); Nick Bravin, Note, *Is Morrison v. Olson Still Good Law? The Court’s New Appointments Clause Jurisprudence*, 98 COLUM. L. REV. 1103, 1117–20 (1998) (arguing, in the immediate aftermath of *Edmond*, that *Edmond* had “rework[ed]” the *Morrison* test in favor of a more “formalist” rule, *id.* at 1117 & n.83).

⁴ *See, e.g.*, *NLRB v. SW Gen., Inc.*, 137 S. Ct. 929, 947 n.2 (2017) (Thomas, J., concurring) (“[I]t is difficult to see how *Morrison*’s nebulous approach survived our opinion in *Edmond*.”); *United States v. Concord Mgmt. & Consulting LLC*, 317 F. Supp. 3d 598, 617 (D.D.C. 2018) (“*Morrison* has been called into doubt by seemingly all quarters . . .” (collecting cases)); Adrian Vermeule, *Morrison v. Olson Is Bad Law*, LAWFARE (June 9, 2017, 8:14 PM), <https://www.lawfareblog.com/morrison-v-olson-bad-law> [<https://perma.cc/SPZ6-85A2>] (“*Morrison* is probably no longer good law.”).

⁵ 141 S. Ct. 1970 (2021).

⁶ *Id.* at 1985.

⁷ U.S. CONST. art. II, § 2, cl. 2 (“[The President] shall nominate, and by and with the Advice and Consent of the Senate, shall appoint Ambassadors, other public Ministers . . . and all other Officers of the United States . . . but the Congress may by Law vest the Appointment of such inferior Officers, as they think proper, in the President alone, in the Courts of Law, or in the Heads of Departments.”). The Constitution does not offer a specific term for “Officers” who are not “inferior,” but since then nineteenth-century American courts have referred to such officers as “principal” officers. *See, e.g.*, *United States v. Germaine*, 99 U.S. 508, 511 (1879) (referring to officers of the United States who are not inferior as “principal” officers); *Ex parte Hennen*, 38 U.S. (13 Pet.) 230, 234 (1839).

⁸ U.S. CONST. art. II, § 2, cl. 2; *see, e.g.*, *Lucia v. SEC*, 138 S. Ct. 2044, 2051 n.3 (2018).

⁹ *Seila L. LLC v. CFPB*, 140 S. Ct. 2183, 2192 (2020) (“Our precedents have recognized only two exceptions to the President’s unrestricted removal power. In *Humphrey’s Executor v. United*

Historically, the Supreme Court has taken two distinct approaches in deciding whether particular officers are “principal” or “inferior” under the Constitution. In *Morrison*, the Supreme Court applied an elastic, multifactor test — looking to the official in question’s “duties,” “jurisdiction,” “tenure,” and insulation from at-will removal — before deciding that an independent counsel appointed under the auspices of the 1978 Ethics in Government Act was an inferior rather than a principal officer.¹⁰ But in *Edmond v. United States*,¹¹ decided only nine years after *Morrison*, the Court took a different approach. The *Edmond* Court declared, more simply, that “[w]hether one is an ‘inferior’ officer depends on whether he has a superior.”¹²

Administrative Patent Judges (APJs) are executive branch officials who are not Senate confirmed and whom the President cannot appoint or remove at will.¹³ They sit on the Patent Trial and Appeal Board (PTAB), a subdivision of the PTO that can “reconsider” and “cancel” certain previously issued patents in a process known as *inter partes* review.¹⁴ The Director of the PTO, who is Senate confirmed,¹⁵ can summarily decline to initiate *inter partes* review¹⁶ and can decide which

States, we held that Congress could create expert agencies led by a group of principal officers removable by the President only for good cause. And in *United States v. Perkins* and *Morrison v. Olson*, we held that Congress could provide tenure protections to certain *inferior* officers with narrowly defined duties.” (emphasis omitted) (citations omitted); *accord* *Collins v. Yellen*, 141 S. Ct. 1761, 1783–84 (2021).

¹⁰ *Morrison v. Olson*, 487 U.S. 654, 671–72 (1988). The independent counsel had not been confirmed by the Senate and was not removable at will by the President. *See id.* at 660–64. Having decided that the independent counsel was an inferior officer, the Court held that she (1) had not been unconstitutionally appointed and (2) had not been unlawfully insulated from removal. *Id.* at 696–97. This Comment takes no position on whether, had the independent counsel been deemed a principal officer, the Constitution would have required her to be removable at will. *Cf. Collins*, 141 S. Ct. at 1800 (Kagan, J., concurring in part and concurring in the judgment in part) (objecting to the categorical rule in *Seila Law, LLC v. CFPB*, 140 S. Ct. 2183, that all principal officers must be removable at will).

¹¹ 520 U.S. 651 (1997).

¹² *Id.* at 662.

¹³ *See* 35 U.S.C. § 6(a) (providing that APJs are appointed by the Secretary of Commerce); *id.* § 3(c) (stating that officers and employees shall be subject to the provisions of Title Five); 5 U.S.C. § 7513(a) (providing that APJs may be removed by the Secretary “only for such cause as will promote the efficiency of the [civil] service”); *see also* *Arthrex, Inc. v. Smith & Nephew, Inc.*, 941 F.3d 1320, 1333 & n.4 (Fed. Cir. 2019) (describing the conditions under which the Secretary of Commerce may remove an APJ).

¹⁴ *Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC*, 138 S. Ct. 1365, 1370 (2018); *see* 35 U.S.C. § 6 (a)–(b); *see also* *Saint Regis Mohawk Tribe v. Mylan Pharms. Inc.*, 896 F.3d 1322, 1327–29 (Fed. Cir. 2018) (describing the *inter partes* review process in greater detail); *Oil States Energy Servs.*, 138 S. Ct. at 1370–72 (same).

¹⁵ 35 U.S.C. § 3(a)(1).

¹⁶ *See id.* § 314(b) (“The Director shall determine whether to institute an *inter partes* review [proceeding]”); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2139 (2016) (holding that such decisions are “final and non-appealable” (emphasis omitted) (quoting 35 U.S.C. § 314(d))).

APJs will preside over which *inter partes* proceedings.¹⁷ He can also promulgate general rules that all APJs must follow in adjudicating *inter partes* claims.¹⁸ But PTAB decisions are final and unappealable within the executive branch. No executive branch official, including the President, can countermand any final PTAB decision in any particular case.¹⁹

In 2017, Arthrex, Inc., appeared before the PTAB to defend one of its patents — for a “knotless suture securing assembly” — in an *inter partes* proceeding.²⁰ Arthrex lost, and the PTAB canceled the patent.²¹ Arthrex appealed to the Federal Circuit.²² On appeal, Arthrex argued that the APJs who had heard its case were principal officers and had therefore been unconstitutionally appointed.²³

The Federal Circuit agreed with Arthrex and vacated the PTAB’s decision. Applying *Edmond*, Judge Moore’s majority opinion²⁴ began by asking whether the PTAB APJs “ha[d] a superior,” or some Senate-confirmed official who “directed and supervised” their work.²⁵ Judge Moore concluded that the APJs did not, as no executive branch official could “review and reverse”²⁶ individual APJ decisions and APJs were removable only for cause.²⁷ Next, turning briefly to *Morrison*, Judge Moore found that the facts favoring inferiority in *Morrison* were “completely absent.”²⁸ Unlike the special counsel in *Morrison*, APJs did not have “limited tenure, limited duties, or limited jurisdiction.”²⁹ Thus, because neither *Edmond* nor *Morrison* could support a finding of inferiority, the APJs were principal officers and had been unlawfully appointed.³⁰ To eliminate the problem, Judge Moore severed the APJs’ removal protections from the rest of the statute, rendering APJs removable at will by the Patent Office Director and thus inferior officers.³¹

¹⁷ 35 U.S.C. § 6(c).

¹⁸ *See id.* § 316(a)(4).

¹⁹ *Arthrex*, 141 S.Ct. at 1977.

²⁰ *Smith & Nephew, Inc. v. Arthrex, Inc.*, No. IPR2017-00275, at *2 (P.T.A.B. May 2, 2018).

²¹ *Id.* at *18.

²² *Arthrex, Inc. v. Smith & Nephew, Inc.*, 941 F.3d 1320, 1325 (Fed. Cir. 2019).

²³ *Id.*

²⁴ Judge Moore was joined by Judges Reyna and Chen.

²⁵ *Arthrex*, 941 F.3d at 1328 (quoting *Edmond v. United States*, 520 U.S. 651, 662–63 (1997)). As a preliminary matter, Judge Moore rejected the argument that Arthrex had “forfeited its Appointments Clause challenge by not raising [it] before the Board,” reasoning that the Court had “discretion to decide when to” find forfeiture and that “the important structural interests and separation of powers concerns protected by the Appointments Clause” counseled against finding forfeiture in the case. *Id.* at 1326; *see id.* at 1326–27.

²⁶ *Id.* at 1329.

²⁷ *Id.* at 1329–34.

²⁸ *Id.* at 1334.

²⁹ *Id.*

³⁰ *Id.* at 1335.

³¹ *Id.* at 1338.

The Supreme Court granted certiorari, affirmed in part, and reversed in part. Writing for the Court,³² Chief Justice Roberts began by affirming the Federal Circuit's merits analysis. "*Edmond*," the Court explained, "goes a long way towards resolving this dispute."³³ "What was 'significant' in *Edmond* — "review by a superior executive officer" — was "absent" for PTAB APJs.³⁴ Nor did the Secretary of Commerce's power to remove APJs make them inferior, since the Secretary could fire APJs "only 'for such cause as [would] promote the efficiency of the service.'"³⁵ "Given the insulation of PTAB decisions from any executive review," the President could "neither oversee the PTAB himself nor 'attribute the Board's failings to those whom he [could] oversee.'"³⁶ Thus, the PTAB's structure violated the Appointments Clause.³⁷ The Court's opinion did not mention or cite *Morrison*.³⁸

Chief Justice Roberts then turned to the question of remedies. "[W]hen confronting a constitutional flaw in a statute," he wrote, "we try to limit the solution to the problem' by disregarding the 'problematic portions while leaving the remainder intact.'"³⁹ And here, the most limited remedial approach was to allow the Director of the PTO to review and reverse PTAB decisions. "In every respect save the insulation of their decisions from review within the Executive Branch, APJs appear[ed] to be inferior officers."⁴⁰ Removing that insulation was thus the most sensible remedial choice.⁴¹ Compared to the Federal Circuit's remedy, which would have made the APJs removable at will, "review by the Director better reflect[ed] the structure of supervision within the PTO and the nature of APJs' duties."⁴²

Justice Gorsuch joined the Court's merits analysis but dissented as to the remedy. Also citing *Edmond*, Justice Gorsuch agreed that "[b]y definition, an 'inferior officer . . . has a superior'" and that the APJs at

³² Chief Justice Roberts was joined by Justices Alito, Gorsuch, Kavanaugh, and Barrett on the merits and by Justices Alito, Kavanaugh, and Barrett in his discussion of remedies. See *Arthrex*, 141 S. Ct. at 1975. Justice Breyer, joined by Justices Sotomayor and Kagan, expressed "agree[ment]" with Chief Justice Roberts's "remedial holding" but did not join the remedial portion of Chief Justice Roberts's opinion. *Id.* at 1997 (Breyer, J., concurring in the judgment in part and dissenting in part).

³³ *Id.* at 1981 (majority opinion).

³⁴ *Id.* (quoting *Edmond v. United States*, 520 U.S. 651, 665 (1997)).

³⁵ *Id.* at 1982 (quoting 5 U.S.C. § 7513(a)).

³⁶ *Id.* (quoting *Free Enter. Fund v. Pub. Co. Acct. Oversight Bd.*, 561 U.S. 477, 496 (2010)).

³⁷ *Id.* at 1985.

³⁸ See *id.* at 1976–88.

³⁹ *Id.* at 1986 (quoting *Ayotte v. Planned Parenthood of N. New Eng.*, 546 U.S. 320, 328–29 (2006)).

⁴⁰ *Id.*

⁴¹ See *id.* at 1987.

⁴² *Id.*

issue did not have superiors.⁴³ But “the real question” was “what to do about” this problem.⁴⁴ No single statutory provision, Justice Gorsuch noted, made the APJs principal officers. Only a “combination” of provisions did so.⁴⁵ Plus, there were multiple ways of solving the principal-officer problem: the Court could “make PTAB decisions subject to review by the [Patent Office] Director,” “specify that PTAB panel members should be appointed by the President and confirmed by the Senate,” or “reassign the power to cancel patents to the [j]udiciary.”⁴⁶ Given this ambiguity, and following what he described as “traditional remedial principles,”⁴⁷ Justice Gorsuch would have vacated the PTAB decision and done nothing more.⁴⁸ The Court’s contrary approach, Justice Gorsuch complained, amounted to a “legislative séance[]” wherein the Court drafted a new statute *ex nihilo*.⁴⁹

Justice Thomas dissented on the merits. “[A]dministrative patent judges,” he noted, “sit at the bottom of an organizational chart, nestled under at least two levels of authority.”⁵⁰ Higher officials could “supervise and direct”⁵¹ APJs’ work by, *inter alia*, promulgating policies to which APJs were required to adhere in *inter partes* proceedings and firing APJs who did not follow those policies for insubordination.⁵² “To be sure,” the Director could not “singlehandedly reverse [PTAB] decisions.”⁵³ But there was “no precedential basis” or “historical support” for “boiling down ‘inferior-officer’ status to the way Congress structured a particular agency’s process for reviewing decisions.”⁵⁴ And “[t]he fact that” the Court had “place[d] administrative patent judges on the side of Ambassadors, Supreme Court Justices, and department heads,” Justice Thomas concluded, should have “suggest[ed]” to the Court “that something [was] not quite right.”⁵⁵

⁴³ *Id.* at 1989 (Gorsuch, J., concurring in part and dissenting in part) (quoting *Edmond v. United States*, 520 U.S. 651, 662 (1997)).

⁴⁴ *Id.* at 1990.

⁴⁵ *Id.*

⁴⁶ *Id.*

⁴⁷ *Id.*

⁴⁸ *Id.* at 1990–92.

⁴⁹ *Id.* at 1992.

⁵⁰ *Id.* at 1998 (Thomas, J., dissenting). Justices Breyer, Sotomayor, and Kagan joined Parts I and II of Justice Thomas’s opinion.

⁵¹ *Id.* at 2000.

⁵² *Id.* at 2000–01.

⁵³ *Id.* at 2002.

⁵⁴ *Id.* at 2002–03. Justice Thomas observed that the Court previously had declined to create such a “rigid test.” *Id.* at 1999 (citing *Edmond v. United States*, 520 U.S. 651, 661 (1997); *Morrison v. Olson*, 487 U.S. 654, 671 (1988)).

⁵⁵ *Id.* at 2011. In a part of his opinion that Justices Breyer, Sotomayor, and Kagan did not join, Justice Thomas suggested that *Edmond* did not align with “the Appointment Clause’s original meaning.” *Id.* at 2011; *see id.* at 2006–10. But Justice Thomas recognized that the litigants in

Justice Breyer also dissented on the merits.⁵⁶ “[I]n my view,” he wrote, “the Court should interpret the Appointments Clause as granting Congress a degree of leeway to establish and empower federal offices.”⁵⁷ Moreover, Justice Breyer continued, “when deciding cases such as these,” courts “should conduct a functional examination of the offices and duties in question rather than a formalist, judicial-rules-based approach.”⁵⁸ Here, because there were good functional reasons for Congress to want to insulate PTAB decisions from further review within the executive branch, “a functional approach” would have “undermine[d]” the Court’s result.⁵⁹ “For purposes of determining a remedy, however,” Justice Breyer “agree[d]” with the Court’s “remedial holding” and voted to permit the PTO Director to review PTAB decisions.⁶⁰

Arthrex appears to be the first case in which the Supreme Court ignored *Morrison* when it was potentially outcome determinative.⁶¹ As a result, *Arthrex* sheds new light on whether *Morrison* remains good law. And the best view, given *Arthrex*, is probably that *Morrison* should be limited to its facts.

After *Edmond*, keen observers noted that Justice Scalia’s *Edmond* opinion had essentially eviscerated the rule announced in *Morrison*.⁶² *Morrison* evaluated whether an officer was inferior by looking holistically at the officer’s role, tenure, duties, and jurisdiction.⁶³ But in *Edmond* the Court brushed that approach aside, explaining that *Morrison* “did not purport to set forth a definitive test for whether an office is ‘inferior’ under the Appointments Clause.”⁶⁴ Justice Souter, concurring in *Edmond*, specifically noted that he would have paid more attention to *Morrison*’s functional approach than the *Edmond* majority

Arthrex had not challenged the applicability of *Edmond*, see *id.* at 2006, and emphasized that “for now, we must apply the test we have,” *id.* at 2011.

⁵⁶ *Id.* at 1994 (Breyer, J., concurring in the judgment in part and dissenting in part).

⁵⁷ *Id.* In support of this view, Justice Breyer cited (inter alia) then-Judge Ginsburg’s D.C. Circuit dissent in *Morrison* — but not the Court’s own *Morrison* opinion. *Id.*

⁵⁸ *Id.* at 1995.

⁵⁹ *Id.* at 1996. As Justice Breyer explained, “the technical nature of patents, the need for expertise, and the importance of avoiding political interference” in the patent-adjudication process all cut in favor of APJ independence. *Id.*

⁶⁰ *Id.* at 1997.

⁶¹ In particular, in *Free Enterprise Fund v. Public Co. Accounting Oversight Board*, 561 U.S. 477 (2010), the Court relied on *Edmond* and only *Edmond* to hold that members of the Public Company Accounting Oversight Board (PCAOB) would be inferior officers if made removable at will by the SEC. *Id.* at 510. But because the *Free Enterprise Fund* Court found that the newly removable PCAOB members were inferior officers, it treated *Edmond* as setting out necessary rather than sufficient conditions for inferiority. See *infra* p. 397 (explaining the distinction between necessary and sufficient conditions of inferiority).

⁶² See, e.g., JOHN F. MANNING & MATTHEW C. STEPHENSON, LEGISLATION & REGULATION 637–39 (3d ed. 2017) (asking whether *Edmond* and *Morrison* are consistent).

⁶³ *Morrison v. Olson*, 487 U.S. 654, 671–72 (1988); Bravin, *supra* note 3, at 1117–20.

⁶⁴ *Edmond v. United States*, 520 U.S. 651, 661 (1997).

opinion did.⁶⁵ “What is needed” in separation-of-powers cases, he wrote, “is a detailed look” at the officer’s “powers and duties . . . to see whether reasons favoring their inferior officer status within the constitutional scheme weigh more heavily than those to the contrary.”⁶⁶ *Edmond*’s scant heed for *Morrison* has led some commentators to conclude that *Morrison* “is bad law.”⁶⁷

But *Edmond* and *Morrison* were reconcilable in a way that *Morrison* and *Arthrex* are not. In *Edmond*, the Court held that the *Morrison* test did not set out necessary conditions for an official to be “inferior.”⁶⁸ Even officials who were not obviously “inferior” under *Morrison*, potentially including the officials at issue in *Edmond*, could be inferior if they had powerful-enough superiors.⁶⁹ By contrast, the *Arthrex* Court ignored *Morrison* altogether. Instead, it relied principally on *Edmond* to conclude that APJs were principal officers, or at least exercised powers inconsistent with inferiority.⁷⁰ Thus, whereas *Edmond* held only that having superiors was a sufficient condition of inferiority, *Arthrex* appears to hold that having a superior is also necessary for an officer to be inferior. And if the test in *Edmond* lays out both necessary and sufficient conditions of inferiority, that — unlike *Edmond* standing alone — suggests that *Morrison* no longer accurately describes the rules setting out whether an officer is “inferior” or “principal.”

In particular, two alternative ways of reconciling *Morrison* and *Arthrex* are not persuasive. First, notwithstanding some contrary rhetoric from the Federal Circuit, the facts favoring inferiority in *Morrison* were not so “completely absent” in *Arthrex* that *Morrison* was simply irrelevant to the *Arthrex* Court’s analysis.⁷¹ To be sure, APJs are not “‘limited in tenure,’ as the phrase was used in *Morrison* to describe ‘appoint[ment] essentially to accomplish a single task [at the end of which] the office is terminated.’”⁷² Nor are they “‘limited in jurisdiction,’ as used in *Morrison* to refer to” a special counsel charged with investigating particular crimes or allegations thereof.⁷³ But an APJ’s “duties” are quite narrowly circumscribed. APJs make technical determinations about the validity of particular patents if and only if the head of the PTO directs the APJ to sit on a case requiring the APJ to make those

⁶⁵ See *id.* at 667–69 (Souter, J., concurring).

⁶⁶ *Id.* at 668.

⁶⁷ See, e.g., Vermeule, *supra* note 4.

⁶⁸ See *Edmond*, 520 U.S. at 661.

⁶⁹ See *id.* at 661–63. The *Edmond* Court expressed no opinion as to whether the officials there would have qualified as inferior officers under *Morrison*.

⁷⁰ See *Arthrex*, 141 S. Ct. at 1979–86.

⁷¹ *Arthrex, Inc. v. Smith & Nephew, Inc.*, 941 F.3d 1320, 1334 (Fed. Cir. 2019).

⁷² *Edmond*, 520 U.S. at 661 (alteration in original) (quoting *Morrison v. Olson*, 487 U.S. 654, 672 (1988)); see *Arthrex*, 941 F.3d at 1334.

⁷³ *Edmond*, 520 U.S. at 661 (quoting *Morrison*, 487 U.S. at 672); see *Arthrex*, 941 F.3d at 1334.

determinations.⁷⁴ And they may only do so in accordance with such rules and regulations as the PTO's head may promulgate.⁷⁵ Plus, although APJs are not as limited in jurisdiction as the special counsel in *Morrison*, their jurisdiction is far narrower than (say) that of the Secretary of Commerce.⁷⁶ This comparison is not to suggest that, under *Morrison*, APJs would be inferior officers. But if the *Morrison* test still had doctrinal purchase, it would have made sense for the Court to consider these arguments — if only, like the Federal Circuit, to dismiss them in a short paragraph.⁷⁷ That the Court saw fit to ignore *Morrison* entirely is a sign that *Morrison* now has limited “generative power,”⁷⁸ not that the facts of *Arthrex* alone made *Morrison* irrelevant.

Second, it is true that neither the United States nor the private party that had originally challenged Arthrex's patent in the *inter partes* review process relied substantially on *Morrison* in their briefing before the Supreme Court.⁷⁹ But it does not follow that *Morrison* is good law. Of course, parties can and do forfeit arguments on appeal if they do not make them cogently in their briefing.⁸⁰ But this rule did not limit the *Arthrex* Court to parroting back the exact arguments made in Arthrex's briefing. Rather, like any U.S. court, the Supreme Court's practice is to analyze issues “fairly raised” by the parties to a dispute⁸¹ and resolve those issues in accordance with the applicable rules of law. And here, if *Morrison* were in fact a relevant source of law, its relevance would have made it “fairly raised” notwithstanding the parties' failure to examine it

⁷⁴ 35 U.S.C. § 6(c); cf. *Edmond*, 520 U.S. at 660–61.

⁷⁵ See 35 U.S.C. §§ 3(a)(2)(A), 316(a)(4); *Arthrex*, 141 S. Ct. at 1999–2002 (Thomas, J., dissenting).

⁷⁶ Cf. 15 U.S.C. §§ 1501, 1503, 1505–1507 (setting out some of the Secretary of Commerce's statutory authority).

⁷⁷ *Arthrex*, 941 F.3d at 1334.

⁷⁸ Cf. BENJAMIN N. CARDOZO, THE NATURE OF THE JUDICIAL PROCESS 21–22 (1921) (“Every judgment has a generative power. . . . Every precedent . . . has a ‘directive force for future cases of the same or similar nature.’” (quoting JOSEF REDLICH, THE COMMON LAW AND THE CASE METHOD IN AMERICAN UNIVERSITY LAW SCHOOLS: A REPORT TO THE CARNEGIE FOUNDATION FOR THE ADVANCEMENT OF TEACHING 37 (1914))).

⁷⁹ See Brief for the United States at 16–32, *Arthrex*, 141 S. Ct. 1970 (Nos. 19-1434, 19-1452, 19-1458); Opening Brief for Smith & Nephew, Inc. & Arthrocare Corp. at 19–49, *Arthrex*, 141 S. Ct. 1970 (Nos. 19-1434, 19-1452, 19-1458) (making arguments predicated almost entirely on *Edmond*). But cf. Brief of Amici Curiae Computer & Communication Industry Ass'n & U.S. Manufacturers' Ass'n for Development & Enterprise in Support of United States & Smith & Nephew at 9–12, *Arthrex*, 141 S. Ct. 1970 (Nos. 19-1434, 19-1452, 19-1458) (making arguments predicated on *Morrison*).

⁸⁰ See, e.g., *Adler v. Wal-Mart Stores, Inc.*, 144 F.3d 664, 679 (10th Cir. 1998) (“Arguments inadequately briefed in the opening brief are waived.”); see also *United States v. Sineneng-Smith*, 140 S. Ct. 1575, 1579 (2020) (“[I]n both civil and criminal cases, in the first instance and on appeal . . . , we rely on the parties to frame the issues for decision” (quoting *Greenlaw v. United States*, 554 U.S. 237, 243 (2008))).

⁸¹ *Ex parte Lange*, 85 U.S. (18 Wall.) 163, 165 (1874); *Walters v. Parsons*, 729 F.2d 233, 237 (3d Cir. 1984) (per curiam).

in detail.⁸² Thus, again, the fact that the Court ignored *Morrison* in *Arthrex* indicates that *Morrison*'s scope of applicability is limited, not that the parties simply declined to raise arguments predicated on *Morrison*.

This leaves at least two conceivable paths forward. First, *Morrison* might slowly fade into obsolescence, at least outside of the independent-counsel context. The Supreme Court, pointing to *Morrison*'s incompatibility with *Arthrex*, might formally overrule *Morrison* or limit it to its facts.⁸³ Or litigants, not unlike the litigants in *Arthrex* itself, might stop citing *Morrison* in anticipation of such a result. Those who dislike *Morrison*'s approach to separation of powers issues would applaud such an outcome; those who prefer *Morrison*'s functionalism to *Edmond*'s formalism might lament it.⁸⁴ But whatever *Morrison*'s virtues or vices, this approach would at least produce a clear rule. Questions involving *Morrison*'s continued vitality would be “settled,” regardless of whether they were “settled right.”⁸⁵

Second, the *Morrison* test might hibernate for a time — only to awaken, without warning, in some future case that seems to call for its application. This outcome, by analogy, has been more or less the fate of *Lemon v. Kurtzman*⁸⁶ in the Establishment Clause context. *Lemon*, which put forward a loose, functionalist, *Morrison*-esque test for determining when state action amounts to the “establishment of religion,”⁸⁷ has appeared intermittently and without apparent rhyme or reason in

⁸² Cf., e.g., *Massachusetts v. EPA*, 549 U.S. 497, 518–19 (2007) (relying on *Georgia v. Tennessee Copper Co.*, 206 U.S. 230 (1907), a case not cited by the parties in their briefing); RICHARD J. LAZARUS, *THE RULE OF FIVE: MAKING CLIMATE HISTORY AT THE SUPREME COURT* 250 (2020) (noting that *Tennessee Copper* had not been cited in the parties' briefs).

⁸³ See generally Daniel B. Rice & Jack Boeglin, *Confining Cases to Their Facts*, 105 VA. L. REV. 865, 873–87 (2019) (describing cases in which the Supreme Court has confined prior precedents to their facts rather than formally overruling them).

⁸⁴ Compare *Testimony Before the S. Comm. on the Judiciary*, 115th Cong. 5 (2017) (testimony of Akhil Reed Amar, Professor, Yale Univ.), <https://www.judiciary.senate.gov/imo/media/doc/09-26-17%20Amar%20Testimony.pdf> [<https://perma.cc/9BFR-2NTZ>] (“The lion’s share of the constitutional law scholars who are most expert and most surefooted on this particular topic now believe that *Morrison* was wrongly decided and/or that the case is no longer ‘good law.’”), with Victoria Nourse, *The Vertical Separation of Powers*, 49 DUKE L.J. 749, 772 (1999) (objecting to Justice Scalia’s dissenting view in *Morrison*); and Richard J. Pierce, Jr., *Morrison v. Olson, Separation of Powers, and the Structure of Government*, 1988 SUP. CT. REV. 1, 4–6 (same).

⁸⁵ *Burnet v. Coronado Oil & Gas Co.*, 285 U.S. 393, 406 (1932) (Brandeis, J., dissenting) (“[I]n most matters it is more important that the applicable rule of law be settled than that it be settled right.”). This Comment expresses no view as to whether *Morrison* was correctly decided or puts forward a rule that is normatively desirable.

⁸⁶ 403 U.S. 602 (1971).

⁸⁷ U.S. CONST. amend. I. The test provides that state action violates the Establishment Clause unless it (1) has a “secular legislative purpose,” (2) “neither advances nor inhibits religion,” and (3) does not “foster ‘an excessive government entanglement with religion.’” *Lemon*, 403 U.S. at 612–13 (quoting *Walz v. Tax Comm’n*, 397 U.S. 664, 674 (1970)).

some, but not all, of the Supreme Court's Establishment Clause cases.⁸⁸ Justice Scalia, describing this phenomenon, famously compared *Lemon* to a "ghoul in a late-night horror movie that repeatedly sits up in its grave and shuffles abroad, after being repeatedly killed and buried."⁸⁹ One can imagine a similar fate for *Morrison*. *Arthrex* notwithstanding, *Morrison* might linger for years — dead, and yet not.

But, while the *Lemon*-ization of *Morrison* is a logical possibility, such an outcome would be inconsistent with fundamental principles of stare decisis. Stare decisis is meant to "promote[] the evenhanded, predictable, and consistent development of legal principles, foster[] reliance on judicial decisions, and contribute[] to the actual and perceived integrity of the judicial process."⁹⁰ Overruling past precedent willy-nilly, of course, frustrates these goals. But so too does deciding cases using two sets of books — applying one legal rule on Monday but an equal and opposite rule on Tuesday.⁹¹ Put differently, if stare decisis requires courts to avoid killing off precedents absent some "special justification,"⁹² it also requires that dead precedents stay dead and that limited precedents stay limited. And so, even if some future set of facts appears to call for the application of *Morrison*'s test, the Court should resist the urge to roust *Morrison* from its slumber.

To be clear, *Morrison* remains binding on lower courts on its facts. "If a precedent of [the Supreme] Court has direct application in a case, yet appears to rest on reasons rejected in some other line of decisions," lower courts must "follow the case which directly controls, leaving to [the Supreme] Court the prerogative of overruling its own decisions."⁹³ But, outside the independent counsel context, *Arthrex* and *Morrison* appear deeply at odds. And in that case, the reasoning of *Arthrex*, rather than of *Morrison*, must control.

⁸⁸ See, e.g., *Am. Legion v. Am. Humanist Ass'n*, 139 S. Ct. 2067, 2080 (2019) (opinion of Alito, J.) ("If the *Lemon* Court thought that its test would provide a framework for all future Establishment Clause decisions, its expectation has not been met. In many cases, this Court has either expressly declined to apply the test or has simply ignored it." (collecting cases)).

⁸⁹ *Lamb's Chapel v. Ctr. Moriches Union Free Sch. Dist.*, 508 U.S. 384, 398 (1993) (Scalia, J., concurring in the judgment).

⁹⁰ *Kimble v. Marvel Ent., LLC*, 576 U.S. 446, 455 (2015) (quoting *Payne v. Tennessee*, 501 U.S. 808, 827 (1991)); cf. BRYAN A. GARNER ET AL., *THE LAW OF JUDICIAL PRECEDENT* 300–01 (2016) (discussing how to choose between conflicting precedent).

⁹¹ See *United States v. Dixon*, 509 U.S. 688, 712 (1993) (opinion of Scalia, J.) ("We would mock *stare decisis* . . . by pretending that [a prior case] survives when it does not.").

⁹² *Halliburton Co. v. Erica P. John Fund, Inc.*, 573 U.S. 258, 266 (2014) (quoting *Dickerson v. United States*, 530 U.S. 428, 443 (2000)).

⁹³ *Rodriguez de Quijas v. Shearson/Am. Express, Inc.*, 490 U.S. 477, 484 (1989).