Appeal No. 2014-1301

United States Court of Appeals

for the

Federal Circuit

In re CUOZZO SPEED TECHNOLOGIES, LLC,

Appellant,

– v. –

MICHELLE L. LEE, Director, U.S. Patent and Trademark Office,

Intervenor.

APPEAL FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE, PATENT TRIAL AND APPEAL BOARD

AMICUS CURIAE BRIEF OF THE NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION IN SUPPORT OF PETITION FOR REHEARING EN BANC

ANTHONY F. LO CICERO
President, NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION
CHARLES R. MACEDO
Co-Chair of Amicus Committee, NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION
AMSTER ROTHSTEIN & EBENSTEIN LLP
90 Park Avenue
New York, New York 10016
(212) 336-8000

EUGENE M. GELERNTER
Counsel of Record
SCOTT B. HOWARD
IRENA ROYZMAN
PATTERSON BELKNAP WEBB & TYLER LLP
1133 Avenue of the Americas
New York, New York 10036
(212) 336-2000

Attorneys for Amicus Curiae and Movant
New York Intellectual Property Law Association

CERTIFICATE OF INTEREST

Pursuant to Fed. Cir. R. 29 and 47.4, counsel for *amicus curiae* New York Intellectual Property Law Association certifies the following:

1. The full name of the parties I represent: New York Intellectual Property Law Association

2. The name of the real parties in interest I represent: New York Intellectual Property Law Association

3. All parent corporations and any publicly held companies that own 10 percent of more of the stock of the parties I represent: N/A/

4. The names of all law firms and the partners or associates that appeared for the party now represented by me who appeared in the trial court or are expected to appear in this Court:

AMSTER ROTHSTEIN & EBENSTEIN LLP: Anthony F. Lo Cicero, Charles R. Macedo

PATTERSON BELKNAP WEBB & TYLER LLP: Eugene M. Gelernter, Scott B. Howard, Irena Royzman

Dated: April 16, 2015

/s/ Eugene M. Gelernter
Eugene M. Gelernter

INTEREST OF *AMICUS*

This *amicus curiae* brief is submitted on behalf of the New York Intellectual Property Law Association ("NYIPLA").

The NYIPLA is a professional association of approximately 1,300 attorneys whose interests and practices lie in the area of patent, trademark, copyright, trade secret and other intellectual property law. The NYIPLA's members include a diverse array of attorneys specializing in patent law, including in-house counsel for businesses that own, enforce and challenge patents, as well as attorneys in private practice who represent entities in various proceedings before the U.S. Patent and Trademark Office ("PTO"). Many of the NYIPLA's member attorneys participate actively in patent litigation, representing both patent owners and accused infringers. In addition, many of the NYIPLA's member attorneys are involved in *inter partes* review proceedings, on both sides of patent validity issues.

Because of the increasing importance of *inter partes* review proceedings, the NYIPLA and its members, and the clients they represent, have a strong interest in the standards that govern such proceedings and in the extent to which determinations in such proceedings are subject to appellate review.

No party's counsel authored any part of this brief. No party, party's counsel or other person besides the NYIPLA contributed money to fund the preparation or submission of this brief.

THIS CASE PRESENTS TWO IMPORTANT ISSUES THAT SHOULD BE RE-HEARD EN BANC

The decision by a divided panel in this case presents two important issues concerning *inter partes* review ("IPR"):

(1) Whether decisions to institute an IPR on grounds that exceed or are outside the PTO's authority are: (a) unreviewable by any court, or (b) subject to review on appeal of a final written opinion in an IPR; and

(2) Whether patent claims in IPR proceedings should be: (a) given the "broadest reasonable construction in light of the specification of the patent in which [the claim] appears," 37 C.F.R. § 42.100(b), or (b) construed under the standards set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

See ECF No. 37 at 1. Both issues are of great importance to patent owners and to IPR petitioners, and are deserving of en banc review.

A. This Court Should Grant En Banc Rehearing on the First Issue

The panel majority held that 35 U.S.C. § 314(d) "bar[s] review of all institution decisions, even after the Board issues a final written opinion." Maj. op. at 7. Under that holding, patent owners would have little recourse, if any, in situations where the PTO "clearly and indisputably exceeded its authority" in deciding to institute an IPO. *Id.* at 8.

The panel majority suggests that "mandamus may be available" to obtain judicial review in such situations. *Id*. But as the majority notes, there are stringent requirements for obtaining a writ of mandamus. *Id.* at 8-10. Those requirements would preclude judicial review for many decisions where the PTO exceeds its authority in instituting an IPR.

As the dissent points out, the holding of the panel majority raises the possibility that institution decisions outside the PTO's authority "can never be judicially reviewed, even if contrary to law, even if material to the final appealed judgment …." Dissent op. at 3. As the dissent states, "[t]his ruling appears to impede full judicial review of the PTAB's final decision, … negating the purpose of the America Invents Act to achieve correct adjudication of patent validity through Inter Partes Review in the administrative agency." *Id*.

With IPRs becoming increasingly prevalent, this issue is of great importance, both to patentees and to IPR petitioners. The importance of the issue and the divided panel decision makes en banc review appropriate.

B. This Court Should Grant En Banc Rehearing on the Second Issue for Reasons Identified by Other *Amici*

Other *amici* – including the Intellectual Property Owners Association (ECF No. 60); the Pharmaceutical Research and Manufacturers of America (PhRMA) (ECF No. 62); and 3M Company et al. (ECF No. 63) – have urged this Court to grant rehearing en banc to address the second issue. We agree that that

issue is of great importance and should be re-heard en banc. Because that issue has been discussed at length by other *amici curiae*, we do not address it here.

CONCLUSION

For the reasons set forth above, this Court should order en banc to address both of the issues identified above.

April 16, 2015

Anthony F. Lo Cicero
President, NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION
Charles R. Macedo
Co-Chair of Amicus Committee, NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION
AMSTER, ROTHSTEIN & EBENSTEIN LLP
90 Park Avenue
New York, NY 10016
(212) 336-8000

/s/ Eugene M. Gelernter
Eugene M. Gelernter
Scott B. Howard
Irena Royzman
PATTERSON BELKNAP WEBB & TYLER LLP
1133 Avenue of the Americas
New York, NY 10036
(212) 336-2000

CERTIFICATE OF COMPLIANCE

Pursuant to Fed. R.App. 29(c)(5), I certify that the foregoing *Amicus Curiae* Brief is 771 words in length, according to the word processing system used in preparing it, excluding those portions exempted by Fed. R. App. P. 32(a)(7)(B)(iii) and Fed. Cir. R. 32(b).

This brief complies with the typeface requirements of Fed. R. App. P. 32(a)(5) and the type style requirements of Fed. R. App.). 32(a)(6) because it has been prepared in a proportionally spaced typeface using Microsoft Word in 14 point Times New Roman.

Dated: April 16, 2015

/s/ Eugene M. Gelernter
Eugene M. Gelernter
PATTERSON BELKNAP WEBB & TYLER LLP
1133 Avenue of the Americas
New York, NY 10036
(212) 336-2000

Attorneys for Amicus Curiae New York Intellectual Property Law Association

CERTIFICATE OF FILING AND SERVICE

I, Kersuze Morancy, hereby certify pursuant to Fed. R. App. P. 25(d) that, on April 16, 2015 the foregoing Brief of *Amicus Curiae* The New York Intellectual Property Law Association in Support of Petition for Rehearing *En Banc* was filed through the CM/ECF system and served electronically on the individual listed below:

Kasha Law LLC
John Robert Kasha
14532 Dufief Mill Road
North Potomac, MD 20878
703-867-1886
john.kasha@kashalaw.com
Attorneys for Appellant

Hovey Williams LLP
Jennifer C. Bailey
84 Corporate Woods
10801 Mastin Boulevard
Overland Park, KS 66210
913-647-9050
jcb@hoveywilliams.com
Attorneys for Appellee

Hovey Williams LLP
Jennifer C. Bailey
84 Corporate Woods
10801 Mastin Boulevard
Overland Park, KS 66210
913-647-9050
jcb@hoveywilliams.com
Attorneys for Appellee

/s/ Kersuze Morancy
Kersuze Morancy