

No. 17-1686

IN THE
Supreme Court of the United States

RPX CORPORATION,

Petitioner,

v.

CHANBOND LLC,

Respondent.

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

**BRIEF OF NEW YORK INTELLECTUAL
PROPERTY LAW ASSOCIATION AS *AMICUS
CURIAE* IN SUPPORT OF NEITHER PARTY**

PETER THURLOW
President, NYIPLA
POLSINELLI PC
600 Third Avenue
New York, NY 10016
(212) 684-0199

FRANK DeLUCIA
*Co-Chair of PTAB
Committee, NYIPLA*
MERCHANT & GOULD PC
767 Third Avenue
New York, NY 10017
(212) 223-7240

CHARLES R. MACEDO
*Counsel of Record
Co-Chair of PTAB
Committee, NYIPLA*

DAVID P. GOLDBERG
*Co-Chair of Amicus Briefs
Committee, NYIPLA*

AMSTER, ROTHSTEIN
& EBENSTEIN LLP
90 Park Avenue
New York, NY 10016
(212) 336-8000
cmacedo@arelaw.com

*Counsel for Amicus Curiae
(Additional Counsel Listed on Inside Cover)*

July 20, 2018

ROBERT J. RANDO
THE RANDO LAW FIRM P.C.
6800 Jericho Turnpike,
Suite 120W
Syosset, NY 11791
(516) 799-9800

ROBERT M. ISACKSON
Second Vice President,
NYIPLA
LEASON ELLIS LLP
One Barker Avenue, 5th Floor
White Plains, NY 10601
(914) 821-1686

Counsel for Amicus Curiae

QUESTION PRESENTED

Can the Federal Circuit refuse to hear an appeal by a petitioner from an adverse final decision in a Patent Office *inter partes* review on the basis of lack of a patent-inflicted injury in fact when Congress has

(i) statutorily created the right to have the Director of the Patent Office cancel patent claims when the petitioner has met its burden to show unpatentability of those claims,

(ii) statutorily created the right for parties dissatisfied with a final decision of the Patent Office to appeal to the Federal Circuit, and

(iii) statutorily created an estoppel prohibiting the petitioner from again challenging the patent claims?

TABLE OF CONTENTS

	<u>Page</u>
INTEREST OF AMICUS CURIAE	1
SUMMARY OF ARGUMENTS	2
ARGUMENT	9
I. IN THE PROCEEDINGS BELOW, RPX QUALIFIED UNDER THE STATUTE TO INITIATE AN IPR PROCEEDING AND TO CHALLENGE ON APPEAL AN ADVERSE FINAL WRITTEN DECISION FROM THAT PROCEEDING	9
A. RPX Properly Filed a Petition for IPR and Participated in Those Proceedings	9
B. RPX, as a “Dissatisfied” Party, Was Denied Its Statutory Right to Appeal the Adverse Final Written Decision Entered by the PTAB.....	11
II. THE FEDERAL CIRCUIT’S DECISION BELOW IS BASED ON AN INCOMPLETE READING OF RPX’S STATUTORY RIGHTS	13
III. THIS PETITION IS THE PROPER CASE TO CONSIDER WHETHER SECTION 319 PROVIDES A SUFFICIENT CONSTITUTIONAL BASIS TO ALLOW A DISSATISFIED PETITIONER TO APPEAL AN ADVERSE FINAL WRITTEN DECISION	17

A. The Parties Are Highly Motivated and This Case Is Likely to Garner Significant Amicus Support	17
B. The Federal Circuit’s Analysis Is in Conflict with Supreme Court Decisions and Other Circuits’ Decisions	19
C. This Issue Is Ripe for this Court to Review Now Because the Federal Circuit Has Stopped Debating the Issue	23
D. This Issue Impacts Many Petitioners	24
CONCLUSION.....	25

TABLE OF AUTHORITIES**Page(s)****CASES**

<i>Atlas Roofing Co. v. Occupational Safety and Health Review Comm'n,</i> 430 U.S. 442 (1977)	15
<i>Consumer Watchdog v. Wis. Alumni Research Found.,</i> 753 F.3d 1258 (Fed. Cir. 2014).....	<i>passim</i>
<i>Cuozzo Speed Techs., LLC v. Lee,</i> 136 S. Ct. 2131 (2016)	<i>passim</i>
<i>Dep't of Air Force v. Rose,</i> 425 U.S. 352 (1976)	22
<i>Dep't of Justice v. Julian,</i> 486 U.S. 1 (1988)	22
<i>Dep't of Justice v. Reporters Comm. for Freedom of Press,</i> 489 U.S. 749 (1989)	22
<i>FBI v. Abramson,</i> 456 U.S. 615 (1982)	22
<i>Gill v. Whitford,</i> 138 S. Ct. 1916 (2018)	20

<i>Linda R.S. v. Richard D.</i> , 410 U.S. 614 (1973)	19, 21
<i>Lujan v. Defenders of Wildlife</i> , 504 U.S. 555 (1992)	<i>passim</i>
<i>Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC</i> , 138 S. Ct. 1365 (2018)	<i>passim</i>
<i>Phigenix, Inc. v. Immunogen, Inc.</i> , 845 F.3d 1168 (Fed. Cir. 2017).....	<i>passim</i>
<i>Pub. Citizen v. U.S. Dep’t of Justice</i> , 491 U.S. 440 (1989)	21, 22
<i>SAS Institute, Inc. v Iancu</i> , 138 S. Ct. 1348 (2018)	12, 16, 17, 18
<i>Spokeo, Inc. v. Robins</i> , 136 S. Ct. 1540 (2016)	<i>passim</i>
<i>United States v. Weber Aircraft Corp.</i> , 465 U.S. 792 (1984)	22
<i>Univ. of Tex. Southwestern Med. Ctr. v. Nassar</i> , 570 U.S. 338 (2013)	17
<i>Warth v. Seldin</i> , 422 U.S. 490 (1975)	19,21
<i>Zivotofsky v. Secretary of State</i> , 444 F.3d 614 (D.C. Cir. 2006)	21, 23

CONSTITUTION

U.S. CONST. art. III, § 2, cl. 1 *passim*

STATUTES

5 U.S.C. § 552..... 21, 22, 24

5 U.S.C. Appx. 1 §§ 1-16 21, 22, 24

35 U.S.C. § 311..... 3, 4, 9, 11

35 U.S.C. § 312..... 3, 9

35 U.S.C. § 313..... 3

35 U.S.C. § 314..... 3, 10, 18

35 U.S.C. § 315..... 3

35 U.S.C. § 316..... 3, 10

35 U.S.C. § 317..... 3

35 U.S.C. § 318..... 3, 11

35 U.S.C. § 319..... *passim*

Leahy Smith America Invents Act,
Pub. L. No. 112-29, 125 Stat. 284 (2011) 3, 9

RULES

Sup. Ct. R. 37.6 1
37 C.F.R. § 42.1 et seq. 3
37 C.F.R. § 42.23..... 10
37 C.F.R. § 42.70 10

OTHER AUTHORITIES

Charles R. Macedo et al., *Rethinking Article III
Standing in IPR Appeals at the
Federal Circuit*,
[http://www.ipwatchdog.com/2018/06/12/rethinkin
g-article-iii-standing-ipr-appeals-federal-
circuit/id=98347/](http://www.ipwatchdog.com/2018/06/12/rethinkin
g-article-iii-standing-ipr-appeals-federal-
circuit/id=98347/) 21

INTEREST OF AMICUS CURIAE

The New York Intellectual Property Law Association (“NYIPLA” or “Association”) respectfully submits this *amicus curiae* brief in support of neither party.¹ The arguments set forth herein were approved on July 18, 2018 by an absolute majority of the officers and members of the Board of Directors of the NYIPLA, including any officers or directors who did not vote for any reason, including recusal, but do not necessarily reflect the views of a majority of the members of the Association, or of the law or corporate firms with which those members are associated. After reasonable investigation, the NYIPLA believes that no officer or director or member of the Committee on Amicus Briefs who voted in favor of filing this brief, nor any attorney associated with any such officer, director or committee member in any law or corporate firm, represents a party in this litigation.

The NYIPLA is a bar association of more than 1,100 attorneys who practice in the area of patent, copyright, trademark, and other intellectual property (“IP”) law.² It is one of the largest regional IP bar

¹ Pursuant to Sup. Ct. R. 37.6, no counsel for a party authored this brief in whole or in part, and no counsel or party made a monetary contribution intended to fund the preparation or submission of this brief. No person other than NYIPLA, its members, or its counsel made a monetary contribution to its preparation or submission.

² Consent of all parties has been provided for the NYIPLA to file this brief. Petitioner and Respondent have provided consents to the filing of this *amicus curiae* brief in support of neither party in communications dated June 28, 2018 and July 10, 2018, respectively.

associations in the United States. The Association's members include a diverse array of attorneys specializing in patent law, from in-house counsel for businesses that own, enforce and challenge patents, to attorneys in private practice who represent inventors and petitioners in various proceedings before the United States Patent and Trademark Office ("PTO").

A substantial percentage of the Association'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. The NYIPLA thus brings an informed perspective to the issues presented.

The NYIPLA, its members, and their respective clients share a strong interest in the issues presented by this case. It is critical that the standards as to who can participate in Patent Trial and Appeal Board ("PTAB") proceedings, specifically *inter partes* review, and appeals therefrom, and in what capacity, to be clarified to ensure a smooth, predictable process.

SUMMARY OF ARGUMENTS

The Association submits this *amicus* brief arguing that this Court accept RPX's petition for writ

of certiorari to determine whether Section 319 of Title 35 of the United States Code, as set forth by Congress, has established an intangible injury-in-fact that meets the “case or controversy” requirements of Article III of the U.S. Constitution.

While the Association offers no opinions on the ultimate merits of RPX’s underlying *inter partes* review (“IPR”) petition, it supports RPX’s right as a dissatisfied party to the IPR proceeding before the PTAB to appeal the adverse decision denying RPX the relief it requested from the PTAB. RPX was denied the opportunity to argue its appeal by the Court of Appeals for the Federal Circuit (“Federal Circuit”), which found that RPX lacked sufficient injury-in-fact for standing to pursue its appeal. (App. 8).

I. RPX was a proper petitioner to the Government for relief in the proceedings below and is entitled to appeal an adverse final written decision on its IPR petition.

A. In the proceedings below, on November 20, 2015, pursuant to the relevant America Invents Act (“AIA”) statutory scheme devised by Congress and the related regulations, 35 U.S.C. §§ 311–319 and 37 C.F.R. § 42.1 et seq., RPX filed a petition requesting IPR of claims 1-31 of U.S. Patent No. 7,941,822 (“the ’822 patent”). (App. 9-10). On June 6, 2016, the PTAB instituted an IPR to review the challenged claims on four separate grounds. (App. 10). On May 25, 2017, the PTAB entered a final

written decision in which it held claims 1–31 of the '822 patent not unpatentable on the challenged grounds. (App. 9-48). As this Court has recognized, and the parties do not dispute, RPX, as petitioner, was authorized to “initiate the proceeding” by petitioning the government and participating in the proceedings below, even without “a concrete stake in the outcome; indeed, they may lack constitutional standing.” *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2143-44 (2016) (citing § 311(a); *cf. Consumer Watchdog v. Wis. Alumni Research Found.*, 753 F.3d 1258, 1261–62 (Fed. Cir. 2014)).

B. On July 26, 2017, RPX, as a dissatisfied party, filed a timely Notice of Appeal with the Director and the PTAB, as well as with the Clerk’s office of the Federal Circuit. The Notice recognized that RPX’s standing to appeal may have had to be briefed. On September 29, 2017, Patent Owner ChanBond filed a motion to terminate the appeal for lack of Article III standing. After briefing on the motion, on January 17, 2018, a panel of the Federal Circuit entered an unpublished nonprecedential Order granting ChanBond’s motion. (App. 1-8). RPX’s Petition for Writ of Certiorari challenges that Order.

II. The Federal Circuit’s Order dismissing RPX’s appeal was based on an incomplete reading of this Court’s law on standing and the relevant statutory authority governing IPRs. Led into error by the Federal Circuit’s earlier decision in *Consumer*

Watchdog, involving *inter partes* reexamination, which IPRs replaced, the panel reasoned:

“The statute at issue here allowed any third party to request [review], and, where granted, allowed the third party to participate.” *Consumer Watchdog*, 753 F.3d at 1262. “The statute did not guarantee a particular outcome favorable to the requestor.” *Id.* RPX “was permitted to request [review] and participate once the PTO granted its request. ***That is all the statute requires.***” *Id.*

(App. 5) (emphasis added). However, the Federal Circuit erred in its reading of the relevant statutory framework in both *Consumer Watchdog* and *RPX*.

As this Court recently explained, the statute requires more:

A party dissatisfied with the Board’s decision can seek judicial review in the Court of Appeals for the Federal Circuit. §319. Any party to the *inter partes* review can be a party in the Federal Circuit. *Ibid.*

Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC, 138 S. Ct. 1365, 1372 (2018).

The panel’s omission of this consideration in its analysis is significant. Indeed, nowhere in the

Order did the Federal Circuit explicitly consider the statutory rights Congress gave to any party who suffered the intangible injury of being “dissatisfied” with the final written decision to seek judicial review at the Federal Circuit. (*See* App. 1-8).

Of course, while “Congress cannot erase Article III’s standing requirements by statutorily granting the right to sue to a plaintiff who would not otherwise have standing,” nonetheless, this Court recognizes that “[i]n determining whether an intangible harm constitutes injury in fact, both history and the judgment of Congress play important roles.” *Spokeo, Inc. v. Robins*, 136 S. Ct. 1540, 1548-49 (2016). Congress may identify intangible harms that meet minimum Article III requirements, and may even “elevat[e] to the status of legally cognizable injuries concrete, *de facto* injuries that were previously inadequate in law.” *Id.* at 1549 (quoting *Lujan v. Defenders of Wildlife*, 504 U.S. 555, 578 (1992) (Kennedy, J., concurring)).

As this Court’s statements in *Cuozzo* and *Oil States* suggest, that is what Congress has in fact done here, by defining dissatisfaction with an adverse final written decision as a sufficient intangible injury allowing a party to the proceeding below to appeal.

At a minimum, the Federal Circuit’s failure to consider whether the congressionally defined concrete injury of being “dissatisfied” with an adverse final written decision of the PTAB is

constitutionally sufficient to meet Article III's standing requirement requires that the decision below be vacated and/or reversed. Indeed, the Federal Circuit's holding de facto found Section 319 violated Article III of the U.S. Constitution while neither addressing the statute nor undertaking such an analysis.

III. This is an appropriate case for this Court to address the question presented.

A. The parties are well represented by counsel and have a strong interest in resolving the issue being raised. RPX, as an active petitioner, has filed more than fifty separate IPR proceedings. To date, while RPX has received many favorable final written decisions, it has also been denied its requested relief in at least three proceedings, in addition to the present dispute. As this Court's other decisions involving IPRs have demonstrated, many *amici* are likely to weigh in if the Court takes this issue.

B. The Federal Circuit's decision is in conflict with this Court's decisions upholding Congress' authority to enact statutes creating legal rights, which confirm that the invasion of those statutory rights can confer Article III standing even though no injury would exist without the statute. It is also in conflict with precedent in the U.S. Court of Appeals for the D.C. Circuit. This Court's intervention is necessary to address this conflict.

C. As the non-precedential nature of the decision below reflects, the Federal Circuit has stopped engaging in further discourse on this subject. As was the case in *Oil States*, the time is now ripe for this Court to address the issue.

D. This issue is important. Created just five years ago, IPRs have become important proceedings in which validity disputes over patents are raised and resolved. The proper determination of which losing parties can appeal is another issue that must be resolved, because it is critical to the clear and regular function of the PTAB going forward.

Accordingly, the Association urges this Court to take this Petition and determine whether Section 319 provides a sufficient constitutional basis to allow a dissatisfied petitioner in an IPR to appeal an adverse final written decision.

ARGUMENT**I. IN THE PROCEEDINGS BELOW, RPX QUALIFIED UNDER THE STATUTE TO INITIATE AN IPR PROCEEDING AND TO CHALLENGE ON APPEAL AN ADVERSE FINAL WRITTEN DECISION FROM THAT PROCEEDING****A. RPX Properly Filed a Petition for IPR and Participated in Those Proceedings**

With the enactment of the Leahy-Smith America Invents Act of 2011 (“AIA”), Congress created IPR proceedings, where any petitioner may request the Government to take “a second look at an earlier administrative grant of a patent.” *Cuozzo*, 136 S. Ct. at 2144. As this Court has recognized, “[a]ny person other than the patent owner can file a petition for inter partes review.” *Oil States*, 138 S. Ct. at 1371 (citing 35 U.S.C. § 311(a) (2012 ed.)). Indeed, Section 311(a) allows for anyone who is not otherwise statutorily barred or estopped from bringing a petition to file such a petition with the Government. Unlike covered business method (“CBM”) proceedings, also created by the AIA, there is no requirement that a petitioner in an IPR be an accused infringer. *See* Leahy Smith America Invents Act, Pub. L. No. 112-29, § 18(a)(1)(B), 125 Stat. 284, 329-30 (2011).

Pursuant to 35 U.S.C. §§ 311-312, RPX paid a substantial governmental filing fee (more than

\$30,000) and filed a petition requesting IPR of claims 1-31 of U.S. Patent No. 7,941,822 (“the ’822 patent”). (App. 9-10). Specifically, RPX sought in its Petition to have the Government, through the PTAB, cancel the challenged claims of the ’822 Patent.

Pursuant to 35 U.S.C. § 314, on June 6, 2016, the PTAB, as the PTO Director’s delegate, found a reasonable likelihood that RPX would prevail with respect to at least one challenged claim, and instituted an IPR proceeding. (App. 10). *Oil States*, 138 S. Ct. at 1371 & n.1.

In addition to granting a petitioner the right to file a petition, Congress also entitled a petitioner the right to participate in the IPR proceeding, with both an opportunity to submit comments (35 U.S.C. § 316(a)(13); *see also* 37 C.F.R. § 42.23) and the right to participate in an oral hearing (35 U.S.C. § 316(a)(10); *see also* 37 C.F.R. § 42.70). *Oil States*, 138 S. Ct. at 1371. ChanBond filed a Patent Owner’s Response brief after institution of the IPR proceeding, to which RPX replied (App. 10) as Congress provided by statute (35 U.S.C. § 316(a)(13)). Oral hearing was then held on January 30, 2017. (App. 10). Once again, in accordance with its statutory right, RPX, as a party, participated in that hearing. *See* 35 U.S.C. § 316(a)(10); *Oil States*, 138 S. Ct. at 1371 (“During the *inter partes* review, the petitioner and the patent owner are entitled ... to receive an oral hearing before the Board, §316(a)(10).”).

Additionally, as this Court has recognized and the parties do not dispute, RPX as petitioner was authorized to “initiate the proceeding” to petition the government and participate in proceedings below, even without “a concrete stake in the outcome; indeed, they may lack constitutional standing.” *Cuozzo*, 136 S. Ct. at 2143-44 (citing § 311(a); *cf. Consumer Watchdog*, 753 F.3d 1258).

On May 25, 2017, the PTAB entered a final written decision pursuant to 35 U.S.C. § 318(a) that was unfavorable to RPX, by holding that RPX had not demonstrated by a preponderance of the evidence that the claims of the ’822 patent are unpatentable. (*See* App. 9-48). It is that denial of the relief requested by RPX in its IPR petition that RPX, dissatisfied, sought to have reviewed by the Federal Circuit.

B. RPX, as a “Dissatisfied” Party, Was Denied Its Statutory Right to Appeal the Adverse Final Written Decision Entered by the PTAB

In addition to granting the right for a petitioner to request review of previously issued patent claims and participate in the proceeding below (as the Order recognized, App. 5), Congress explicitly provided that any party that suffers the injury of being “dissatisfied” with an adverse final written decision by the PTAB may appeal to the Federal Circuit. 35 U.S.C. § 319. Congress further provided that any party to an IPR has the right to be

a party to its appeal. *Id.*; see also *Oil States*, 138 S. Ct. at 1372 (“A party dissatisfied with the Board’s decision can seek judicial review in the Court of Appeals for the Federal Circuit.” (citing 35 U.S.C. § 319)).

On July 26, 2017, pursuant to Section 319, as a dissatisfied party to the PTAB’s final written decision, RPX did what the statute authorized and filed a timely Notice of Appeal with the Director and the PTAB, as well as with the Clerk’s office of the Federal Circuit. The Notice recognized that RPX’s standing to appeal might be raised.

On September 29, 2017, Respondent ChanBond, the patent owner, filed a motion to terminate the appeal, arguing that RPX lacked Article III standing.

After briefing on the motion, on January 17, 2018, a panel of the Federal Circuit entered a non-precedential Order granting ChanBond’s motion on the grounds that RPX lacked the required injury-in-fact to satisfy Article III standing. (App. 1-8).

On its face, Section 319 indicates that Congress intended any dissatisfied party to have a right to appeal to the Federal Circuit. However, the Federal Circuit denied RPX’s right as a dissatisfied petitioner to appeal the PTAB’s adverse decision. See *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1360 (2018); *Cuozzo*, 136 S. Ct. at 2140 (“strong presumption” in favor of judicial review).

II. THE FEDERAL CIRCUIT'S DECISION BELOW IS BASED ON AN INCOMPLETE READING OF RPX'S STATUTORY RIGHTS

In the Order below, the Federal Circuit summarized its analysis in a non-precedential decision as follows:

As to a right to compel cancellation of claims on un-patentable inventions, this issue was settled in *Consumer Watchdog v. Wisconsin Alumni Research Foundation*, 753 F.3d 1258 (Fed. Cir. 2014). While that case dealt with the statutes governing inter partes reexamination proceedings, the reasoning applies equally to the relevant statutes governing IPR proceedings. *See also* [*Phigenix, Inc. v. Immunogen, Inc.*, 845 F.3d 1168, 1175–76 (Fed. Cir. 2017)] (applying the reasoning of *Consumer Watchdog* in concluding that the IPR estoppel provision does not constitute an injury in fact). “The statute at issue here allowed any third party to request [review], and, where granted, allowed the third party to participate.” *Consumer Watchdog*, 753 F.3d at 1262. “The statute did not guarantee a particular outcome favorable to the requestor.” *Id.* RPX “was permitted to request [review] and participate once

the PTO granted its request. ***That is all the statute requires.*** *Id.*

(App. 5) (emphasis added).

However, as this Court recognized in *Oil States*, Congress did more than give RPX, as a petitioner and party to the IPR proceeding, merely the right “to request [review] and participate once the PTO granted its request.” Rather:

A party dissatisfied with the Board’s decision [here, RPX, as Petitioner] can seek judicial review in the Court of Appeals for the Federal Circuit. § 319. Any party to the inter partes review can be a party in the Federal Circuit. *Ibid.*

Oil States, 138 S. Ct. at 1372. In other words, Congress gave RPX, as a dissatisfied party, the right to seek judicial review from an adverse final written decision.

Significantly, the Federal Circuit’s failure to permit the judicial review provided by Congress in 35 U.S.C. § 319 stands in stark contrast to this Court’s opinion in *Oil States* that is informed by, and relies upon in part, the Federal Circuit judicial review when finding *inter partes* review, as challenged in that case, constitutional:

[B]ecause the Patent Act provides for judicial review by the Federal Circuit, see 35 U.S.C. §319, we need not consider whether inter partes review would be constitutional “without any sort of intervention by a court at any stage of the proceedings.”

Oil States, 138 S. Ct. at 1379 (citing *Atlas Roofing Co. v. Occupational Safety and Health Review Comm’n*, 430 U.S. 442, 455 n.13 (1977)).

Thus, the Federal Circuit’s analysis omitted consideration of the congressionally defined injury-in-fact in Sections 141(c) and 319 of an unsuccessful petitioner being “dissatisfied” with a denial of a petition request, and fails to address whether the denial of the right guaranteed by Congress for a dissatisfied party to file and participate in the appeal exceeded the constitutional limits of Article III standing. *See Phigenix*, 845 F.3d at 1175-76 (discussing only Section 141(c) and ignoring the language and analysis of Section 319 and the intangible injury of being “dissatisfied”).

This omission is not insignificant. This Court explained in *Spokeo*, that Congress can define what type of intangible injury is sufficient to give Article III standing to a party in a proceeding to participate in a challenge to an adverse decision:

In addition, because Congress is well positioned to identify intangible harms

that meet minimum Article III requirements, its judgment is also instructive and important. Thus, we said in *Lujan* that Congress may “elevat[e] to the status of legally cognizable injuries concrete, de facto injuries that were previously inadequate in law.” 504 U.S. at 578, 112 S. Ct. 2130, 119 L. Ed. 2d 351. Similarly, Justice Kennedy’s concurrence in that case explained that “*Congress has the power to define injuries and articulate chains of causation that will give rise to a case or controversy where none existed before.*” Id., at 580, 112 S. Ct. 2130, 119 L. Ed. 2d 351 (opinion concurring in part and concurring in judgment).

Spokeo, 136 S. Ct. at 1549 (emphasis added).

Thus, the failure of the Federal Circuit in this case (and its other line of cases) to even consider the fact that Congress defined an intangible injury of a petitioner being “dissatisfied” as being a sufficient injury-in-fact to appeal is clear error and contrary to this Court’s directives in *Spokeo*. See, e.g., *Phigenix*, 845 F.3d at 1175-76; see also *Consumer Watchdog*, 753 F.3d at 1261-62.

As recently pointed out by this Court in *SAS*, “[j]ust as Congress’ choice of words is presumed to be deliberate’ and deserving of judicial respect, ‘so too

are its structural choices.” *SAS*, 138 S. Ct. at 1355 (citing *Univ. of Tex. Southwestern Med. Ctr. v. Nassar*, 570 U.S. 338, 353 (2013)).

III. THIS PETITION IS THE PROPER CASE TO CONSIDER WHETHER SECTION 319 PROVIDES A SUFFICIENT CONSTITUTIONAL BASIS TO ALLOW A DISSATISFIED PETITIONER TO APPEAL AN ADVERSE FINAL WRITTEN DECISION

A. The Parties Are Highly Motivated and This Case Is Likely to Garner Significant Amicus Support

The parties in this case are well funded and have a strong interest in the outcome of this action. RPX, the Petitioner, has filed and continues to file many IPRs, and has a strong interest in the outcome of this case. ChanBond has asserted the '822 Patent many times, and no doubt has a strong desire to defend its success at the PTAB. Both parties are represented by competent and experienced counsel who are fully capable of briefing and arguing this case to this Court.

It is also fair to expect that, should this Court take this Petition, it will receive substantial input from many *amici* besides the Association.

By way of illustration, this Court has recently addressed the Federal Circuit's decisions regarding IPRs in three instances in the five short years since

IPRs first came into effect, each time garnering significant *amicus* support and interest.

In *Cuozzo*, 136 S. Ct. 2131, this Court addressed the scope of 35 U.S.C. § 314(d). In that case, over thirty *amicus curiae* briefs were filed.

Similarly, when this Court was set to review the Federal Circuit's decision in *Oil States*, 138 S. Ct. 1365, over fifty-five *amicus* briefs were filed by various parties who had significant interest in the issue of the constitutionality of IPR proceedings.

Even in *SAS*, 138 S. Ct. 1348, briefed in the shadow of the then-pending *Oil States* case, two *amici* showed separate interest in the Court's review of whether the PTAB must issue a final written decision addressing each and every patent claim challenged in an IPR petition.

It is evident that many *amici* have a strong interest in the interpretation of the relatively new statutory framework governing IPR proceedings. Thus, it is likely that many *amici* will weigh in if the Court takes on the issue of whether Section 319 provides a sufficient constitutional basis to allow a dissatisfied petitioner, such as RPX, in an IPR to appeal an adverse final written decision.

B. The Federal Circuit's Analysis Is in Conflict with Supreme Court Decisions and Other Circuits' Decisions

The decision below, and the line of authority it represents at the Federal Circuit, are in conflict with this Court's decisions upholding Congress' authority to enact statutes creating legal rights, and confirming that the invasion of those statutory rights can confer Article III standing even though no injury would exist without the statute. *Warth v. Seldin*, 422 U.S. 490, 514 (1975) ("Congress may create a statutory right or entitlement the alleged deprivation of which can confer standing to sue even where the plaintiff would have suffered no judicially cognizable injury in the absence of statute."); *Linda R.S. v. Richard D.*, 410 U.S. 614, 617 n.3 (1973) ("Congress may enact statutes creating legal rights, the invasion of which creates standing, even though no injury would exist without the statute."); *see also Lujan*, 504 U.S. at 561-62 ("When the suit is one challenging the legality of government action or inaction, the nature and extent of facts that must be averred (at the summary judgment stage) or proved (at the trial stage) in order to establish standing depends considerably upon *whether the plaintiff is himself an object of the action (or forgone action) at issue. If he is, there is ordinarily little question that the action or inaction has caused him injury, and that a judgment preventing or requiring the action will redress it.*" (emphasis added)).

In *Lujan*, this Court set out a three-part test to determine standing under Article III:

1. “The plaintiff must have suffered an ‘injury in fact’—an invasion of a legally protected interest which is (a) concrete and particularized, and (b) actual or imminent, not conjectural or hypothetical;”
2. “[T]here must be a causal connection between the injury and the conduct complained of— the injury has to be fairly . . . trace[able] to the challenged action of the defendant, and not . . . th[e] result [of] the independent action of some third party not before the court;” and
3. “[I]t must be likely, as opposed to merely speculative, that the injury will be redressed by a favorable decision.”

Lujan, 504 U.S. at 560-61; *see also Spokeo*, 136 S. Ct. at 1547; *Gill v. Whitford*, 138 S. Ct. 1916, 1929 (2018).

When Congress creates a statutory right or entitlement, and a party seeking judicial relief is allegedly deprived of such right or entitlement, there is “ordinarily little question” of meeting the standing requirement. In other words, when someone petitions the government for some action³ and is

³ In the present case, this injury was compounded because RPX, as petitioner to the Government for relief, was required to pay a

allegedly wrongfully denied such relief, it is an easy case to find standing for the aggrieved petitioner. *See Warth*, 422 U.S. 490; *Linda R.S.*, 410 U.S. 614; *Lujan*, 504 U.S. 555; *Spokeo*, 136 S. Ct. 1540; *Pub. Citizen v. U.S. Dep't of Justice*, 491 U.S. 440 (1989), 491 U.S. 440; *Reporters Comm. for Freedom of Press*, 489 U.S. 749; *see also Zivotofsky v. Secretary of State*, 444 F.3d 614 (D.C. Cir. 2006).⁴

In this sense, the Federal Circuit's analysis in *Phigenix* misses the point by failing to recognize that the denial of RPX's petition here, makes RPX, as the unsuccessful petitioner, the object of the government action or inaction.

This Court has recognized such rights under the Federal Advisory Committee Act ("FACA"), 5 U.S.C. Appx. 1 §§ 1-16 (*see Pub. Citizen*, 491 U.S. at 449-50 ("As when an agency denies requests for information under the Freedom of Information Act,

fee of over \$30,000 to seek this relief, which it claims was improperly denied.

⁴ "...when Congress grants a petitioner in an IPR proceeding the right to petition the government to seek specific relief (invalidate one or more claims on the previously issued patent franchise), and when the government (arguably improperly) denies such relief, the denial of such relief is a sufficient injury in fact to provide the Courts with constitutional authority under Article III to hear appeal from that denial by the unsuccessful petitioner." Charles R. Macedo et al., *Rethinking Article III Standing in IPR Appeals at the Federal Circuit*, IPWATCHDOG (June 12, 2018) (available at <http://www.ipwatchdog.com/2018/06/12/rethinking-article-iii-standing-ipr-appeals-federal-circuit/id=98347/>).

refusal to permit appellants to scrutinize the ABA Committee's activities to the extent FACA allows constitutes a sufficiently distinct injury to provide standing to sue.”)), as well as under the Freedom of Information Act, 5 U.S.C. § 552 (see, e.g., *Dep’t of Justice v. Reporters Comm. for Freedom of Press*, 489 U.S. 749 (1989); *Dep’t of Justice v. Julian*, 486 U.S. 1 (1988); *United States v. Weber Aircraft Corp.*, 465 U.S. 792 (1984); *FBI v. Abramson*, 456 U.S. 615 (1982); *Dep’t of Air Force v. Rose*, 425 U.S. 352 (1976); see also *Pub. Citizen*, 491 U.S. at 449-50 (“Our decisions interpreting the Freedom of Information Act have never suggested that those requesting information under it need show more than that they sought and were denied specific agency records.”)).

Indeed, contrary to the reasoning offered by the Federal Circuit in its earlier decisions, (*cf. Phigenix*, 845 F.3d at 1175-76; *Consumer Watchdog*, 753 F.3d at 1261-62), the allegedly improper denial of a petitioner’s statutorily approved petition to cancel one or more claims of an issued patent is no different in kind than the allegedly improper denial of a petitioner’s request for information under the Freedom of Information Act or the Federal Advisory Committee Act. Thus, we respectfully submit that the Federal Circuit’s holding in *RPX* is in conflict with this Court’s precedent.

Additionally, in accordance with this Court’s precedents, the D.C. Circuit has determined that when Congress creates a statutory right, the

deprivation of that right is enough to satisfy Article III standing. *See Zivotofsky*, 444 F.3d at 617-19 (Appellant had standing under Article III because the individual right to have “Israel” listed as his place of birth on his passport, conferred to him by Congress, was violated). Thus, the Federal Circuit’s decision in *RPX* is not only contrary to Supreme Court precedent, but also creates a circuit split over the meaning of such precedent.

At a minimum, this Court should grant certiorari to address this conflict.

C. This Issue Is Ripe for this Court to Review Now Because the Federal Circuit Has Stopped Debating the Issue

Concern for the effects of the Federal Circuit’s misapplication of the law and disregard of legislative choices stems from the fact that the Federal Circuit has exclusive jurisdiction over appeals from the PTAB, a docket that now exceeds 500 cases annually. Since, as the *RPX* line of cases demonstrates, the Federal Circuit has continued to apply its own standing requirements, and has consistently disregarded the plain text of the requirements of Section 319, and found that Article III standing requires more than the denial of a legally protected interest, no panel may deviate from this precedent. *See Consumer Watchdog*, 753 F.3d at 1261-62; *Phigenix*, 845 F.3d at 1175-76. Thus, the case at issue is important because it is capable of repetition and runs the risk of evading future review.

That the Federal Circuit has started to issue non-precedential decisions, such as *RPX*, means that the Federal Circuit has stopped debate, and determined that the issue is no longer in dispute. Therefore, this matter is ripe for this Court to address, as was the case in *Oil States*.

D. This Issue Impacts Many Petitioners

This issue is important and impacts many petitioners. Many entities in addition to RPX have petitioned for IPR, seeking to invalidate allegedly improperly granted patent claims. These include associations like the Texas Realtor's Association, public interest groups, governmental bodies like the United States Postal Service, and inventors in individual disputes over patentability of others' claims, as well as operating companies seeking freedom to operate. Therefore this Court's guidance as to whether the statutory language stating that "dissatisfied" petitioners have a right to appeal is sufficient for standing would benefit the patent stakeholder community.

In addition, should the Federal Circuit's jurisprudence on this issue remain unchallenged, its impact may be felt not just in the patent system, but also in other settings where Congress has conferred standing on a petitioner to the government for certain relief (for example, petitioners seeking to maintain the integrity of the Freedom of Information Act or the Federal Advisory Committee Act).

CONCLUSION

The NYIPLA supports the clarification of the law of standing for petitioners on appeal from an adverse final written decision of the PTAB in an IPR. For these reasons, the NYIPLA respectfully urges the Court to grant RPX's petition for a writ of certiorari to review the constitutionality of Section 319 of Title 35 of the United States Code.

Respectfully submitted,

CHARLES R. MACEDO
*Counsel of Record,
 Co-Chair of PTAB
 Committee, NYIPLA*

DAVID P. GOLDBERG
*Co-Chair of Amicus
 Briefs Committee,
 NYIPLA*

AMSTER, ROTHSTEIN &
 EBENSTEIN LLP
 90 Park Avenue
 New York, NY 10016
 (212)336-8000
 cmacedo@arelaw.com

ROBERT J. RANDO
 THE RANDO LAW FIRM P.C.
 6800 Jericho Turnpike,
 Suite 120W
 Syosset, NY 11791
 (516)799-9800

PETER THURLOW
President, NYIPLA
 POLSINELLI PC
 600 Third Avenue
 New York, NY 10016
 (212)684-0199

FRANK DELUCIA
*Co-Chair of PTAB
 Committee, NYIPLA*
 MERCHANT & GOULD PC
 767 Third Avenue
 New York, NY 10017
 (212) 223-7240

ROBERT M. ISACKSON
*Second Vice President,
 NYIPLA*
 LEASON ELLIS LLP
 One Barker Avenue
 5th Floor
 White Plains, NY 10601
 (914) 821-1686

Counsel for Amicus Curiae

NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION
 July 20, 2018

**CERTIFICATE OF COMPLIANCE
WITH TYPE-VOLUME LIMITATION**

This brief complies with the type-volume limitation of Supreme Court Rule 33.1(h). According to the word processing system used to prepare this document, the brief contains 5,170 words.