

No. _____

In The
Supreme Court of the United States

QUEEN'S UNIVERSITY AT KINGSTON,

Petitioner,

v.

SAMSUNG ELECTRONICS CO., LTD., AND
SAMSUNG ELECTRONICS AMERICA, INC.,

Respondents.

—◆—
**On Petition For Writ Of Certiorari
To The United States Court Of Appeals
For The Federal Circuit**

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PETITION FOR WRIT OF CERTIORARI
—◆—

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QUESTION PRESENTED

A party asserting patent invalidity bears the burden of establishing that the patent is invalid. 35 U.S.C. § 282. This burden includes not only persuasion, but also the initial production of evidence. *Microsoft Corp. v. IAI Ltd. P'ship*, 564 U.S. 91, 107 (2011).

To invalidate, prior art must enable one of ordinary skill to make the claimed invention without undue experimentation. The Federal Circuit does not, however, place the initial burden of producing evidence to establish this element of invalidity on patent challengers. Instead, it requires patent owners to prove that prior art references are not enabled.

Procedurally, this approach results in the first evidence concerning enablement being presented by the patent owner after a challenger's initial showing on the other elements of invalidity during inter partes review proceedings before the Patent Trial and Appeals Board (the "Board"). The Board then permits the challenger to provide evidence of enablement in its reply.

The Administrative Procedure Act affords parties to formal adjudications the right "to submit rebuttal evidence . . . as may be required for a full and true disclosure of the facts." 5 U.S.C. § 556(d). The Board, however, denies that right to patent owners when challengers raise evidence of enablement for the first time in reply under the Federal Circuit's order of proof.

The question presented is:

Does the Federal Circuit's requirement that patent owners negate enablement of prior art

QUESTION PRESENTED – Continued

in the first instance invert the statutory burden of proving invalidity and deprive patent owners of due process by foreclosing the right to submit rebuttal evidence guaranteed by the Administrative Procedure Act?

PARTIES TO THE PROCEEDING

The parties to the proceeding are those listed on the cover: Petitioner Queen's University at Kingston and Respondents Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc.

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INTRODUCTION

The Court should hear this case because the Federal Circuit's presumption that even non-patented prior art is enabled contradicts the plain statutory text and this Court's decisions requiring patent challengers to bear the burden of proof on invalidity, and deprives patent owners of due process by preventing submission of rebuttal evidence on enablement in violation of the Administrative Procedure Act during inter partes reviews. In this case, Queen's University was denied the right to submit any evidence to rebut Samsung's evidence of enablement of an allegedly anticipating prior art reference even though Samsung bore the burden of proving that the prior art reference enabled the claimed invention.

The Board relied on this new evidence in its final written decisions while denying Queen's University's request to submit rebuttal evidence. Under Federal Circuit case law, Samsung was not required to identify in its petitions any of the evidence that the Board ultimately relied on in its final written decisions to find enablement of a claim limitation by the prior art reference.

In response to Samsung's petitions, Queen's University submitted evidence showing that an element of the prior art reference was not enabled on a cellular phone as the claims required. In reply, Samsung submitted a 68-page declaration from a new expert, relying on at least 65 other new pieces of evidence. Throughout the inter partes review proceedings, the Board denied Queen's University's requests to rebut

this new evidence with evidence of its own. In basing its determination of unpatentability on Samsung's new evidence while denying Queen's University the opportunity to present evidence in rebuttal, the Board exceeded its authority, violating the Administrative Procedure Act.

The Federal Circuit justifies this practice under a judicially created burden-shifting framework that defies the statutory allocation of the entire burden of proof on invalidity to a patent challenger. *Compare* 35 U.S.C. § 282 (“The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity.”), *with Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1354-55 (Fed. Cir. 2003) (remanding for determination “whether [a patentee] can prove . . . nonenablement”). This framework, as applied by the Board to require patent owners to anticipate evidence of enablement that challengers need only submit for the first time in reply, also wrongly deprives patent owners of their right, granted by the Administrative Procedure Act, to present “rebuttal evidence.” 5 U.S.C. § 556(d).

Because the Federal Circuit has exclusive jurisdiction over appeals from inter partes reviews, only this Court's review can correct the Federal Circuit's deprivation of patent owners' due process rights. This Court should grant the petition.



OPINIONS BELOW

The Patent Trial and Appeal Board's Final Written Decisions (App. 3-154) are unreported and available at 2016 WL 5076049 and 2016 WL 5104839, respectively. The Federal Circuit's judgment without opinion under Federal Circuit Rule 36 (App. 1-2) is also unreported and available at 708 Fed. Appx. 680. The Federal Circuit's denial of rehearing en banc is unreported and reproduced at App. 158-159.



JURISDICTION

The court of appeals denied rehearing en banc on March 27, 2018. App. 158-159. On June 19, 2018, the Chief Justice extended the time for filing a petition for a writ of certiorari to August 9, 2018. This Court has jurisdiction under 28 U.S.C. § 1254(1).



STATUTES

Section 556 of the Administrative Procedure Act, 5 U.S.C. § 556, concerning administrative hearings provides:

. . . A party is entitled to present his case or defense by oral or documentary evidence, to submit rebuttal evidence, and to conduct such cross-examination as may be required for a full and true disclosure of the facts. In rule making or determining claims for money or benefits or applications for initial licenses an agency may, when a party will not be prejudiced

thereby, adopt procedures for the submission of all or part of the evidence in written form.

5 U.S.C. § 556(d).

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STATEMENT OF THE CASE

A. Queen's University's Technology

The inventions of the patents at issue were created at a time when user interaction with technological devices, particularly mobile devices, was disruptive and inefficient. The patents disclose specific methods and apparatus for improving the effectiveness of interaction with computers and other devices. These inventions are the product of research by Dr. Roel Vertegaal on attentive user interfaces and device-initiated communications between humans and technology. At the most basic level, the patents employ sensors that detect certain physical signs that a person is paying attention to a device, convert information derived from those sensors into a signal, then use that signal to alter the device's operations on the basis of the person's attention. The inventive devices respond to human attention by acting similarly to the way humans would perceive such cues, a significant advance in the art.

B. Proceedings Before the Board

The claims of Queen's University's patents at issue in this case require a "hardware sensor in or on the device that senses attention." App. 8, App. 84. In its

petitions for inter partes review, Samsung argued that this element was met by an “eye tracking sensor” in a prior art patent application that never issued as a valid patent. App. 172-176, Pet. C.A. Br. 16-25. Samsung’s petitions, however, provided no evidence that this unpatented application enabled—that is, taught a person of ordinary skill in the art how to make—any sensor, much less the disclosed eye tracking sensor on a cellular phone, as the patent claims require.

In response, Queen’s University provided evidence that the sensor taught by the prior art reference could not be implemented on a cellular phone in the relevant time frame. In reply, Samsung submitted a 68-page declaration from a new expert, relying on at least 65 other new pieces of evidence. App. 168, App. 182, Pet. C.A. Br. 20-25. Queen’s University moved to strike the new declaration and evidence. App. 167-192. In the alternative, Queen’s University requested the opportunity to file a surreply with rebuttal evidence. *Id.* The Board refused to strike the new evidence. App. 155-157. Instead, the Board authorized a short, 10-page surreply, but forbade Queen’s University from providing any evidence of its own to rebut the new evidence that Samsung disclosed with its reply. *Id.*

In its final written decisions, the Board found the claims anticipated under 35 U.S.C. § 102(e), relying almost entirely on Samsung’s new evidence. App. 32-49, App. 108-124.

C. The Federal Circuit’s Burden-shifting Framework

Issued patents are presumed valid. 35 U.S.C. § 282. “The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity.” *Id.* “In an inter partes review . . . the petitioner shall have the burden of proving a proposition of unpatentability.” 35 U.S.C. § 316(e). “[T]hat burden never shifts to the patentee.” *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015); *cf. Microsoft Corp. v. I4I Ltd. P’ship*, 564 U.S. 91, 98 (2011) (noting conclusion of “Judge Rich, a principal drafter of the 1952 Act” that “the burden of proving invalidity on the attacker . . . is constant and never changes. . . .” (quoting *American Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 1360 (Fed. Cir. 1984))).

A patent challenger may contest the validity of a patent on several grounds, including anticipation by the prior art. 35 U.S.C. § 102; 35 U.S.C. § 282; 35 U.S.C. § 316(e); *Microsoft*, 564 U.S. at 97. In order for a reference to anticipate challenged claims, it must meet several requirements. “First, the reference must disclose each and every element of the claimed invention, whether it does so explicitly or inherently.” *In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009) (citing *Eli Lilly & Co. v. Zenith Goldline Pharms., Inc.*, 471 F.3d 1369, 1375 (Fed. Cir. 2006). “Second, the reference must ‘enable one of ordinary skill in the art to make the invention without undue experimentation.’” *Id.*;

Impax Labs., Inc. v. Aventis Pharms. Inc., 545 F.3d 1312, 1314 (Fed. Cir. 2008).

The Federal Circuit’s recognition that prior art must be enabling to anticipate derives from this Court’s early patent cases. *See Cohn v. U.S. Corset Co.*, 93 U.S. 366, 370 (1876) (“It must be admitted that, unless the earlier printed and published description does exhibit the later patented invention in such a full and intelligible manner as to enable persons skilled in the art to which the invention is related to comprehend it without assistance from the patent, or to make it, or repeat the process claimed, it is insufficient to invalidate the patent.”); *Application of LeGrice*, 301 F.2d 929, 936 (C.C.P.A. 1962) (citing *Cohn*); *Gleave*, 560 F.3d at 1334 (citing *LeGrice*). But the Federal Circuit claims no higher authority than itself for its presumption that prior art patents, including their unpatented elements, meet this requirement. *Amgen*, 314 F.3d at 1355 (“[W]e do not only rely on § 282 as the source for a presumption. Instead, relying on our precedent, we hold a presumption arises that both the claimed and unclaimed disclosures in a prior art patent are enabled.”).

Based on this presumption, the Federal Circuit has held that a patent challenger does “not bear the burden of proving enablement” of the prior art. *Id.* Rather, patent owners bear “the burden of proving the nonenablement.” *Id.* Thus, according to the Federal Circuit and the Board, Samsung had no burden to show that the prior art reference actually enabled one of skill in the art to practice the allegedly anticipating technology. Rather, following Federal Circuit

precedent, the Board shifted the burden to Queen’s University “to argue or to produce evidence that [the prior art reference] actually does not anticipate, or that its relevant disclosures are not pertinent prior art, for example, as Patent Owner argues in this case, because they are not enabled.” App. 30, App. 106.

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**REASONS THE PETITION
SHOULD BE GRANTED**

**A. Patent Owners are Entitled to Due Process
under the Administrative Procedure Act.**

An owner of a patent challenged in an inter partes review is entitled to due process under the Administrative Procedure Act (“APA”). “The core of due process is the right to notice and a meaningful opportunity to be heard.” *LaChance v. Erickson*, 522 U.S. 262, 266, 118 S. Ct. 753, 756, 139 L. Ed. 2d 695 (1998). In formal adjudications like the inter partes review proceedings here, the APA provides additional procedural safeguards which the Board is bound to follow. 5 U.S.C. § 556(d); see *Bowman Transp., Inc. v. Arkansas–Best Freight Sys., Inc.*, 419 U.S. 281, 288 n. 4, 95 S. Ct. 438, 42 L. Ed. 2d 447 (1974); *Pension Benefit Guaranty Corp. v. LTV Corp.*, 496 U.S. 633, 655, 110 S. Ct. 2668, 110 L. Ed. 2d 579 (1990); *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1080 (Fed. Cir. 2015). Importantly, the Board must afford patent owners the right “to submit rebuttal evidence, and to conduct such cross-examination as may be required for a full and true disclosure of the facts.” 5 U.S.C. § 556(d). The Board denies patent

owners that right when it applies the Federal Circuit's burden-shifting rule.

B. The Federal Circuit's Burden-shifting Rule Contradicts the Statutory Text.

Nothing in the patent statute's text authorizes shifting the burden of proving enablement from a patent challenger to a patent owner. Rather, the statute provides that, in an inter partes review, "the petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence." 35 U.S.C. § 316. A patent challenger cannot satisfy that burden in the first instance by obliging a patent owner to provide evidence of non-enablement in response to the mere identification of a piece of prior art: "[T]he same party who has the burden of persuasion also starts out with the burden of producing evidence." *Microsoft*, 564 U.S. at 107 (quoting 21B Fed. Practice § 5122, at 401) (original alteration). Yet the Federal Circuit's presumption shifts the initial burden of showing nonenablement to the patent owner.

The Federal Circuit derived this rule for invalidating issued patents without proving every element of anticipation from its precedent concerning prosecution of patent applications, which carry no presumption of validity: "In patent prosecution," it observed, "the examiner is entitled to reject application claims as anticipated by a prior art patent without conducting an inquiry into whether or not that patent is enabled" and the "applicant, however, can then overcome that

rejection by proving that the relevant disclosures of the prior art patent are not enabled.” *Amgen*, 314 F.3d at 1355 (citing *In re Sasse*, 629 F.2d 675, 681, 207 USPQ 107, 111 (C.C.P.A.1980)). The reason for this rule of patent prosecution, the Federal Circuit later explained, is “because it is procedurally convenient to place the burden on an applicant” and “overly cumbersome, perhaps even impossible, to impose on the PTO the burden of showing that a cited piece of prior art is enabling.” *In re Antor Media Corp.*, 689 F.3d 1282, 1288 (Fed. Cir. 2012). But neither *Amgen* nor its progeny explained how such considerations of relative convenience might extend to challenges of issued patents by third-parties, much less derogate from the burdens of proof that Congress has imposed on such challenges.

Moreover, even if such a presumption might justifiably arise where invalidity is asserted over a prior art patent that is itself presumed valid and therefore enabled, it would not apply here, because the Board invalidated the patents at issue in this case over a prior art patent application that never issued as a patent.

C. The Federal Circuit’s Burden-shifting Rule Deprives Patent Owners of Due Process.

The Board applies the Federal Circuit’s presumption of enablement to all prior art printed publications, not just to prior art patents. App. 29-30, App. 105-106 (citing *Antor*, 689 F.3d at 1287-88 (Fed. Cir. 2012); *Amgen*, 314 F.3d at 1355). This relieves patent challengers of any burden to address or present evidence

on enablement in their opening submissions. Instead, it places the initial burden of production respecting enablement on patent owners. *Id.* Thus, Queen’s University presented the first evidence of any kind on enablement in its patent owner response. App. 29-36, App. 105-112.

In reply, Samsung presented substantial new evidence that the Board then relied on in finding the patents invalid. App. 32-34, App. 108-110, Pet. C.A. Br. 20-25. The Board never gave Queen’s University an opportunity to rebut that evidence with evidence of its own. App. 155-157. In short, the Board utilized the Federal Circuit’s burden-shifting framework to deprive Queen’s University of its due process right—which the APA guarantees—“to submit rebuttal evidence.” 5 U.S.C. § 556(d).

Before the Federal Circuit, Samsung argued that Queen’s University should have anticipated which references Samsung was going to raise in reply, including the personal testimony of Samsung’s expert regarding his previous work. Samsung C.A. Br. at 25-30. And the Board even faulted Queen’s University and its expert for failing to address evidence that Samsung presented for the first time in reply. App. 42, App. 118.

It is not possible for patent owners to anticipate what evidence patent challengers will present in reply and preemptively address it. The APA provides patent owners, as parties to adjudicative proceedings, the right to present rebuttal evidence for this very reason. 5 U.S.C. § 556(d).

The Board was not free to rely on nearly a half-dozen pieces of newly disclosed evidence, App. 36-49, App. 112-124, that Queen's University had no opportunity to rebut with its own evidence. The presumption of enablement and burden-shifting cannot be used to deprive patent owners of their due process rights. The APA does not make an exception for the Federal Circuit's presumption of enablement.

When patent challengers present evidence of enablement for the first time in reply, the Board is required to allow patent owners to submit rebuttal evidence. 5 U.S.C. § 556(d). The Federal Circuit's burden-shifting framework deprives patent owners of that right and should be set aside.

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CONCLUSION

The Court should grant this petition to ensure that the Federal Circuit's burden-shifting framework no longer deprives patent owners of the right to present rebuttal evidence in violation of the Administrative Procedure Act's due process guarantees.

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