No. 19-1459

In the Supreme Court of the United States

Polaris Innovations Limited,

Petitioner,

v.

Kingston Technology Company, Inc.;
United States of America,

Respondents.

On Petition for a Writ of Certiorari to United States Court of Appeals for the Federal Circuit

BRIEF *AMICUS CURIAE* OF TIVO CORPORATION SUPPORTING PETITIONER

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QUESTIONS PRESENTED

1. Whether severance of the tenure protections for Administrative Patent Judges ("APJs") was unavailable to the *Arthrex* court to remedy the violation of the Appointments Clause by the IPR statute, 35 U.S.C. § 311 et seq., because Congress would have maintained such protection for APJs.

2. Whether the *Arthrex* decision's removal of APJ tenure protections is insufficient to cure the violation of the Appointments Clause by the IPR statute.

TABLE OF CONTENTS

TABLE OF AUTHORITIES

Cases

Statutes

Other Authorities

INTEREST OF *AMICUS CURIAE* [1]

TiVo Corporation is a global leader in making entertainment content easy for consumers to find, watch, and enjoy. TiVo produces and distributes products that allow users to discover what to watch, providing a personalized selection of shows from hundreds of live TV channels and digital content providers (including Netflix, Hulu, and YouTube, among others). TiVo's products use machine learning to provide consumers with content recommendations across online video, television programming, movies, and music entertainment in a unified experience.

TiVo's products and innovations are protected by patents that cover many different aspects of TiVo's proprietary technology, including content discovery, digital video recording (DVR), multi-screen viewing, mobile device video experiences, entertainment personalization, voice interaction, data analytics, and more. These innovations—and the products that practice them—have been enormously expensive to develop. TiVo's business thus depends on a strong and stable U.S. patent system. Without the promise of effective and reliable patent rights, TiVo could not make the investments necessary to continue its path-breaking innovations.

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[1] All parties have consented to the filing of this brief. No counsel for a party authored any part of this brief, and no such counsel or party made a monetary contribution intended to fund the preparation or submission of this brief. No person other than *amicus curiae*, its members, or its counsel made a monetary contribution to the brief's preparation or submission.

The questions presented here concern the constitutionality of the Patent Trial and Appeal Board. The Board hears and decides, among other proceedings, inter partes reviews—an adversarial system of post-grant patent review that Congress established in 2012 as part of the America Invents Act. Under the inter partes review regime, the administrative patent judges who comprise the Board render final decisions concerning the validity of issued patents. Those decisions are not reviewable by any higher executive-branch official. Thus, administrative patent judges—without any substantive oversight by anyone else in the executive branch—can and do invalidate patents, thereby depriving patent owners of vested and valuable property rights. The establishment of the inter partes review system, moreover, has led to a significant increase in the invalidation rate of issued patents.[2] In short, administrative patent judges wield significant power, and it is therefore critical to the stability and reliability of the U.S. patent system that administrative patent judges—and the inter partes review system as a whole—operate within constitutional bounds.

The Federal Circuit correctly held in *Arthrex, Inc. v. Smith & Nephew, Inc.* that administrative patent judges' "last word" capacity with respect to patent invalidation renders them principal officers who,

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[2] *See, e.g.*, Clark A. Joblon, *Is The Sky Falling in the US Patent Industry?*, informationdisplay.org (May/June 2020), at 2, *available at* https://onlinelibrary.wiley.com/doi/epdf/10.1002/msid.1116.

under the Appointments Clause of the Constitution, must be appointed by the President with the advice and consent of the Senate. *See* 941 F.3d 1320, 1335 (Fed. Cir. 2019). Because administrative patent judges are not so appointed, the court of appeals correctly found the inter partes review regime as established by Congress was unconstitutional. *See id.*

In attempting to remedy the constitutional problem that Congress created, however, the court of appeals went astray. The court invalidated administrative patent judges' tenure protections, thereby subjecting them to at-will removal by the Secretary of Commerce. This, the court of appeals reasoned, rendered administrative patent judges inferior officers who can validly be appointed by the Secretary of Commerce. *See id.* at 1338. The court has subsequently applied its holding in *Arthrex* to numerous pending inter partes review appeals, including the appeals below. *See* Pet. App. 2a; *id.* 4a.

As Petitioner Polaris explains, the effect of the court of appeals' remedy—subjecting administrative patent judges to removal for any reason or no reason at all—is demonstrably inconsistent with congressional intent. Even worse, this illegitimate severance does not actually fix the constitutional problem: even if removable at will, administrative patent judges remain principal officers because they retain the ability to cancel previously issued patent claims without review by any principal executive officer.

TiVo submits this amicus brief to provide further analysis of the severability issue (the first question presented in Polaris's petition for certiorari). As

Polaris explains, severing administrative patent judges' removal protections is inconsistent with Congress's intent to provide for agency adjudicators who can decide cases impartially, without fear of reprisal from their superiors.

This would be bad enough. But the court of appeals' remedy creates an additional consequence that is even worse. Severing administrative patent judges' removal protections renders them unable to preside over inter parties review proceedings consistent with the Administrative Procedure Act. This point conclusively demonstrates that the court of appeals' severability analysis cannot stand: Congress could not possibly have wished to provide for inter partes review *adjudications* without providing qualified inter partes review *adjudicators*. And until this Court steps in to correct the Federal Circuit's misguided remedy, every order or decision the Board issues will be invalid under the APA. This Court's review is urgently needed.

SUMMARY OF THE ARGUMENT

The court of appeals correctly held in *Arthrex* that the inter partes review statute as "constructed" by Congress makes administrative patent judges principal officers who must be appointed by the President with the advice and consent of the Senate. 941 F.3d at 1325. In an attempt to cure the constitutional violation, the court severed and invalidated "the portion of the Patent Act restricting removal of the APJs" and held that this severance "render[ed] the APJs inferior officers and remed[ied]

the constitutional appointment problem." *Id.* The effect of the court's ruling is that administrative patent judges are now removable at will by the Secretary of Commerce.

The court of appeals' remedy creates a critical and fundamental problem: making administrative patent judges removable at will renders them unable to preside over inter partes review proceedings consistent with the Administrative Procedure Act.

In light of this problem, the court's severability analysis cannot stand. The touchstone for severability is congressional intent: a constitutionally flawed statutory provision is severable only if "the law remains fully operative without the invalid provisions," such that the court can infer that Congress would have enacted the valid provisions independent of the invalid ones. *Murphy v. Nat'l Collegiate Athletic Ass'n*, 138 S. Ct. 1461, 1482 (2018) (quotation marks and citations omitted). Answering this "counterfactual question," *id.* at 1485 (Thomas, J., concurring), can be difficult in some cases, but it is easy here. Congress does not typically enact "self-defeating statute[s]," *Quarles v. United States*, 139 S. Ct. 1872, 1879 (2019), and it surely would not have established a system of adjudicatory proceedings without providing for qualified officials to oversee and decide them.

ARGUMENT

I. SEVERING THE REMOVAL PROTECTIONS APPLICABLE TO ADMINISTRATIVE PATENT JUDGES RENDERS THEM UNABLE TO PRESIDE OVER INTER PARTES REVIEWS.

A. Section 556 of Title 5, which governs formal adjudications under the APA, requires such adjudications to be conducted by one of three categories of actors: "(1) the agency; (2) one or more members of the body which comprises the agency; or (3) one or more administrative law judges appointed under [5 U.S.C. §] 3105." 5 U.S.C. § 556(b). Section 3105, in turn, permits agencies to "appoint as many administrative law judges as are necessary for proceedings required to be conducted in accordance with [5 U.S.C. §§] 556 and 557." Finally, another provision of Title 5, § 7521, prohibits removal of administrative law judges appointed under § 3105 except "for good cause established and determined by the Merit Systems Protection Board on the record after opportunity for hearing before the Board." 5 U.S.C. § 7521(a).

The Federal Circuit has long held that inter partes reviews are "formal administrative adjudications" subject to the requirements of 5 U.S.C. §§ 554 and 556. *See Arthrex, Inc. v. Smith & Nephew, Inc.*, 935 F.3d 1319, 1326 (Fed. Cir. 2019); *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1080 (Fed. Cir. 2015); *see generally Dickinson v. Zurko*, 527 U.S. 150 (1999) (APA governs proceedings before the Patent and

Trademark Office). This proposition follows inexorably from the statutes themselves: §§ 554 and 556 apply "in every case of adjudication required by statute to be determined on the record after opportunity for an agency hearing," 5 U.S.C. § 554(a), and inter partes reviews fit that description, *see* 35 U.S.C. § 316. That means, as explained above, that inter partes reviews must be heard by either (1) the agency; (2) members of the body comprising the agency; or (3) one or more administrative law judges.

Administrative patent judges are not the Patent and Trademark Office, and they are not members of a body comprising the Office.[3] So, if they are to hear formal adjudications under § 556, they must be administrative law judges. *See also* 154 Cong. Rec. H7233-01, 7234–35 (July 29, 2008) (statement of Rep. King) (noting that administrative patent judges are "administrative law judges"); *see also Commerce, Justice, Science, & Related Agencies Appropriations for 2012: Hearings Before the Subcomm. On Commerce, Justice, Science, & Related Agencies of the H. Comm. on Appropriations*, 112 Cong. 196 (Mar. 2, 2011) (statement of USPTO Dir. David Kappos) (similar). And administrative law judges must be

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[3] The "[m]embers of the body comprising the agency" clause applies only to agencies that—unlike the Patent and Trademark Office—are themselves multi-member bodies. For example, the "members of the body comprising the" Securities and Exchange Commission are the SEC Commissioners, and the "members of the body comprising the" International Trade Commission are the ITC Commissioners. *See R.A. Holman & Co. v. SEC*, 366 F.2d 446, 455 (2d Cir. 1966).

subject to the removal protections of 5 U.S.C. § 7521. But, because the court of appeals decreed that administrative patent judges are *not* subject to those removal protections, they are, by definition, not "administrative law judges" within the meaning of § 556. And, because they are not, they can no longer decide inter partes reviews pursuant to § 556.

The *Arthrex* panel stated—in a footnote and without offering any supporting analysis—that it "agree[d] with the government that the applicable provision to removal of APJs in Title 5 is § 7513," rather than § 7521. 941 F.3d at 1333 n.4. That is incorrect for the reasons just explained. Moreover, Congress explicitly provided that "[o]fficers and employees of the Office" would be "subject to the provisions of title 5, relating to Federal employees." 35 U.S.C. § 3(c). Those "provisions of title 5" include §§ 3105 and 7521, which, on their face, apply to *all* administrative law judges who hear formal adjudications.

Section 7513, in contrast, applies broadly to "employees" of agencies. No one disputes that administrative patent judges are more than mere employees: they are "Officers of the United States." *See Arthrex*, 941 F.3d at 1328 (noting the parties' agreement that administrative patent judges "are officers as opposed to employees"); *cf. Lucia v. SEC*, 138 S. Ct. 2044 (2018) (holding that SEC administrative law judges are "Officers of the United States," not mere employees). Accordingly, the provision of Title 5 specifically governing employment protections for administrative law judges—not the provision of Title 5 generally applicable to agency

employees—should apply here. *See Morales v. Trans World Airlines, Inc.*, 504 U.S. 374, 384–85 (1992) ("[I]t is a commonplace of statutory construction that the specific governs the general . . . .").

B. The problem with the *Arthrex* panel's remedy is no mere technicality. Congress established removal protections for administrative law judges deliberately, and for good reason. Congress wanted to ensure that administrative adjudications would be conducted either by the agency itself—which could be held accountable through the political process—or by independent, impartial decision-makers who were not beholden to the agency that appointed them. *See Wong Yang Sung v. McGrath*, 339 U.S. 33, 52 (1950).

In the years leading up to the APA's passage, many stakeholders complained that agency adjudicators "were mere tools of the agency concerned and subservient to the agency heads in making their proposed findings of fact and recommendations." *Ramspeck v. Fed. Trial Exam'rs Conference*, 345 U.S. 128, 131 (1953). In enacting the APA in 1946, one of Congress's principal goals was to ensure that these adjudicators could decide disputed matters independently and impartially, without interference by the agency. *See Wong Yang Sung*, 339 U.S. at 38–45.[4]

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[4] The idea that executive officers who perform adjudicatory functions should have a measure of independence from the executive has a long pedigree. "[A]s early as 1789 James Madison stated that 'there may be strong reasons why an' executive 'officer' such as the Comptroller of the United States 'should not hold his office at the pleasure of the Executive

To that end, Congress established certain "formal requirements to be applicable '[i]n every case of adjudication required by statute to be determined on the record after opportunity for agency hearing.'" *Wong Yang Sung*, 339 U.S. at 48 (quoting APA § 5, 60 Stat. 237, 239, 5 U.S.C. § 1004 (1946)). One of those requirements—found in the predecessor to 5 U.S.C. § 7521—was that such adjudications must be conducted by an adjudicator who is "removable by the agency in which [she is] employed only for good cause established and determined by the Civil Service Commission . . . after opportunity for hearing and upon the record thereof." *Ramspeck*, 345 U.S. at 132 (quoting APA § 11, 60 Stat. at 244, 5 U.S.C. § 1010 (1946)). These for-cause removal protections, which ensured that the adjudicators' decisions were not unduly influenced by the agency of which they were a part, were a central pillar of the APA. *See Butz v. Economu*, 438 U.S. 478, 513–14 (1978) ("Since the securing of fair and competent hearing personnel was viewed as 'the heart of formal administrative adjudication,' the Administrative Procedure Act contains a number of provisions designed to guarantee the independence of hearing examiners.") (quoting Final Report of the Attorney General's Committee on Administrative Procedure 46 (1941)); *Ramspeck*, 345 U.S. at 131–32.

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branch' if one of his 'principal duties' 'partakes strongly of the judicial character.'" *Free Enter. Fund v. Pub. Co. Accounting Oversight Bd.*, 561 U.S. 477, 530 (2010) (Breyer, J., dissenting) (citation omitted).

C. The presence of an independent adjudicator is not simply good practice as a matter of administrative law. This Court has suggested that an "impartial decision maker is [an] essential" element of due process. *Goldberg v. Kelly*, 397 U.S. 254, 271 (1970). Accordingly, if there were any doubt about whether the relevant statutes require administrative patent judges to have for-cause removal protections—and there is not—the constitutional-avoidance canon resolves it. *See Edward J. DeBartolo Corp. v. Fla. Gulf Coast Bldg. & Constr. Trades Council*, 485 U.S. 568, 575 (1988) ("The elementary rule is that every reasonable construction must be resorted to, in order to save a statute from unconstitutionality."). The court of appeals should not have invited the serious constitutional concerns that arise if administrative patent judges are "mere tools of the agency concerned and subservient to the agency heads in making their proposed findings of fact and recommendations," *Ramspeck*, 345 U.S. at 131.

D. Section 556(b) contains a savings clause providing that "[t]his subchapter does not supersede the conduct of specified classes of proceedings . . . by or before boards or other employees specially provided for by or designated under statute." This provision, however, does not alter the analysis above.

As noted above, inter partes reviews are subject to the formal-adjudication requirements of the APA, which include the requirements of § 556. *See* 35 U.S.C. § 316; *Belden*, 805 F.3d at 1080. And another provision of the APA, 5 U.S.C. § 559, provides that "[s]ubsequent statute[s] may not be held to supersede or modify . . . sections . . . 3105 . . . or 7521 of this title,

. . . except to the extent that [they] do[] so expressly." Given § 559, if Congress wished to carve out an at-will removability exception for the triers of fact in inter partes reviews, it would have had to do so expressly. But Congress did not do that. If anything, it did the opposite, providing that "[o]fficers and employees of the [Patent and Trademark] Office shall be subject to the provisions of title 5, relating to Federal employees." 35 U.S.C. § 3(c). Those "provisions" include 5 U.S.C. § 7521.

* * *

In short, in light of the court of appeals' holding that administrative patent judges are removable at will, those officers are no longer able to preside over inter partes reviews consistent with the requirements of the APA. That, in turn, has critical implications for the severability question, as discussed below.

II. ADMINISTRATIVE PATENT JUDGES' REMOVAL PROTECTIONS ARE NOT SEVERABLE FROM THE REMAINDER OF THE STATUTE.

If one provision of a statute is found unconstitutional, the remainder of the statute must also be invalidated if it is "evident that Congress would not have enacted those provisions which are within its power, independently of those which are not." *Murphy*, 138 S. Ct. at 1482 (alterations omitted) (quoting *Alaska Airlines, Inc. v. Brock*, 480 U.S. 678, 684 (1987)); *accord Seila Law LLC v. CFPB*, 140 S. Ct. 2183, 2208–09 (2020). "In conducting that inquiry, [courts] ask whether the law remains 'fully operative'

without the invalid provisions." *Murphy*, 138 S. Ct. at 1482 (quoting *Free Enter. Fund*, 561 U.S. at 509). If the answer to that question is no, severance is improper, because "Congress could not have intended a constitutionally flawed provision to be severed from the remainder of the statute if the balance of the legislation is incapable of functioning independently." *Alaska Airlines*, 480 U.S. at 684. Moreover, courts "cannot rewrite a statute and give it an effect altogether different from that sought by the measure viewed as a whole." *Murphy*, 138 S. Ct. at 1482 (quoting *Railroad Ret. Bd. v. Alton R. Co.*, 295 U.S. 330, 362 (1935)); *see also Bowsher v. Synar*, 478 U.S. 714, 735 (1986) (declining to sever a portion of a law because doing so "would lead to a statute that Congress would probably have refused to adopt").

These principles dictate that the removal protections applicable to administrative patent judges—the protections the Federal Circuit purported to remove—are not severable from the remainder of the statute. Excising those provisions renders the judges unable to perform one of their primary duties under the statute: issuing final written decisions in inter partes reviews. *See supra* Section I; 35 U.S.C. § 6(c). Even more critically, the Federal Circuit's remedy means that there is *no one*, other than the Director of the Patent and Trademark Office, who is qualified to sit on an inter partes review panel—which, in turn, means that the Board cannot issue valid final written decisions at all. *See* 35 U.S.C. § 6(c) (inter partes reviews must "be heard by at least 3 members of the Patent Trial and Appeal Board").

Congress would not have written a statute that provides for inter partes reviews to be overseen by judges who lack the authority to decide them. Accordingly, the court of appeals erred in concluding that administrative patent judges' removal protections are severable from the remainder of the statute. As this Court observed in *Alaska Airlines*, "Congress could not have intended a constitutionally flawed provision to be severed from the remainder of the statute if the balance of the legislation is incapable of functioning independently." 480 U.S. at 684.

III. THE QUESTIONS PRESENTED ARE EXCEPTIONALLY IMPORTANT AND WORTHY OF THIS COURT'S REVIEW.

Both the questions presented in Polaris's petition for certiorari are worthy of the Court's attention. The constitutionality of any federal statute is an important question of federal law. *See United States v. Kebodeaux*, 570 U.S. 387, 391 (2013). That is particularly so in this case given the outsized effect of the patent system on the nation's economy. The *Arthrex* panel itself recognized that the validity of administrative patent judges' appointments is "an issue of exceptional importance." 941 F.3d at 1327. If administrative actors are to have the power to revoke such important property rights, it is essential that the system in which they exercise that power complies with the Constitution and with principles of fundamental fairness.

TiVo's experience presents a particularly stark example of the power that administrative patent judges wield. TiVo's patents have been the subject of well over one hundred inter partes review petitions. Those petitions have led to Board decisions finding claims from over 18 TiVo patents unpatentable. In total, only about 5% of the challenged claims have survived.[5] Many of these claims had been previously upheld against validity challenges by the International Trade Commission, a body made up of properly appointed principal officers. TiVo thus has a peculiarly strong interest in ensuring that APJs exercise their considerable authority within statutory and constitutional bounds.

The need for this Court's intervention with respect to the severability question is particularly urgent. Now that the court of appeals has improperly made administrative patent judges removable at will, they are no longer qualified to preside over inter partes reviews. Accordingly, until the court of appeals' error is fixed, every single decision the Board renders will be invalid. Certiorari is warranted.

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[5] TiVo's situation is not an outlier; things are little better for the average patent owner. Approximately 80% of all final written decisions result in the invalidation of at least some challenged claims, and over 60% result in the invalidation of *all* challenged claims. *See* https://www.uspto.gov/sites/default/files/documents/Trial_Statistics_20200630_.pdf (slide 11).

CONCLUSION

Polaris's petition for a writ of certiorari should be granted.

Respectfully submitted,

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