No. 21-350

In the Supreme Court of the United States

INFINEUM USA L.P., PETITIONER

v.

CHEVRON ORONITE COMPANY LLC, ET AL.

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

MEMORANDUM FOR THE FEDERAL RESPONDENT

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In *Arthrex, Inc.* v. *Smith & Nephew, Inc.*, 941 F.3d 1320 (2019), vacated *sub nom. United States* v. *Arthrex*, 141 S. Ct. 1970 (2021), the Federal Circuit held that the statutorily prescribed method of appointing administrative patent judges—by the Secretary of Commerce acting alone—violated the Appointments Clause, U.S. Const. Art. II, § 2, Cl. 2. 941 F.3d at 1327-1335; see 35 U.S.C. 6(a). To cure that constitutional defect, the court of appeals held that statutory restrictions on the removal of officials within the United States Patent and Trademark Office (USPTO) could not validly be applied to administrative patent judges, and that the application of those restrictions should be severed so that the judges were removable at will. *Arthrex*, 941 F.3d at 1335-1338. The court then vacated the decision of the Patent Trial and Appeal Board (Board) issued in that case, remanded for "a new hearing" before the Board,

and directed that "a new panel" of administrative patent judges "be designated to hear the [proceeding] anew on remand." *Id.* at 1338, 1340; see *id.* at 1338-1340.

In proceedings below, petitioner raised a similar Appointments Clause challenge on appeal from a decision of the Board in an inter partes review. See Pet. App. 21a. Relying on the Federal Circuit's decision in *Arthrex*, petitioner asked the court of appeals to vacate the Board's decision in this case and remand for a new hearing before a new panel of administrative patent judges. See *ibid.* The Federal Circuit had issued its *Arthrex* decision, however, while the inter partes review in petitioner's case was still pending before the agency. See Pet. 7; Pet. App. 21a. In this case, the court of appeals held that, by making the administrative patent judges who ruled in petitioner's case removable at will, the Federal Circuit's *Arthrex* decision had cured any Appointments Clause violation in petitioner's case by the time the Board issued its ruling. See Pet. App. 21a. The court accordingly declined to grant petitioner any further relief. *Id.* at 21a-22a.

After the court of appeals issued its decision in this case, this Court decided *United States* v. *Arthrex*, 141 S. Ct. 1970 (2021). In *Arthrex*, the Court agreed with the Federal Circuit that "the unreviewable authority wielded by [administrative patent judges] during inter partes review [wa]s incompatible with their appointment by the Secretary to an inferior office." *Id.* at 1985. But rather than sever the statutory removal protections as applied to administrative patent judges, this Court concluded that "the appropriate remedy" was to sever a statutory provision that "prevent[ed] the Director" of the USPTO "from reviewing the decisions of the [Board] on his own," and to "remand to the" agency for

the Director to decide whether to rehear the case. *Id.* at 1987.

Petitioner contends (Pet. 10-14) that, in light of this Court's decision in *Arthrex*, the court of appeals' judgment in this case should be vacated and the case should be remanded to the Federal Circuit in order to permit petitioner to request similar relief from the court of appeals in the first instance. The government agrees. Because this Court's decision in *Arthrex* may affect the proper disposition of this case, the appropriate disposition is to grant the petition for a writ of certiorari, vacate the judgment of the court of appeals, and remand the case for further consideration in light of *Arthrex*.*

Respectfully submitted.

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* The government waives any further response to the petition unless this Court requests otherwise.