No. 21-350

IN THE

Supreme Court of the United States

INFINEUM USA L.P.,

Petitioner,

v.

CHEVRON ORONITE COMPANY LLC AND ANDREW HIRSHFELD, PERFORMING THE FUNCTIONS AND DUTIES OF THE UNDERSECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE,

Respondents.

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

REPLY BRIEF FOR THE PETITIONER

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REPLY BRIEF FOR THE PETITIONER

A. Infineum Did Not Waive Its Appointments Clause Challenge, and GVR Is Appropriate In This Case.

In response to Infineum USA L.P.'s ("Infineum") Petition, Respondent Chevron Oronite Company LLC ("Oronite") claims that Infineum waived its right to petition this Court to grant, vacate and remand based on this Court's decision in *United States v. Arthrex*. Oronite's argument, which relies upon the fact that the remedy imposed by this Court is different than the remedy requested and available to Infineum on appeal, is without any merit.

Before the Court of Appeals, there were numerous issues that were appealed, including whether there was an Appointments Clause violation and the appropriate remedy for that violation. Infineum clearly appealed the Patent Trial and Appeal Board's ("PTAB's") final written decision on the grounds that the Board's decision violated the Appointments Clause of the United States Constitution. App. 21a ("[U]nder *Arthrex, Inc. v. Smith & Nephew Inc.*, 941 F.3d 1320, 1329 (Fed. Cir. 2019), 'the [Administrative Patent Judges (APJs)] who presided over this IPR were unconstitutionally appointed.'").[1] Ruling on that argument, the United States Court of Appeals for the Federal Circuit held that there was no Appointments Clause violation. App. 22a. Because the Federal Circuit

1. In support of the Petition, the Federal Respondent acknowledged that Infineum "raised a similar Appointments Clause challenge on appeal from a decision of the Board in an inter partes review." Mem. for the Federal Resp't at 2.

did not find that there was an Appointments Clause violation, the Federal Circuit did not need to address the appropriate remedy. However, this Court's decision in *United States v. Arthrex* makes clear that there was an Appointments Clause violation in this matter. 141 S. Ct. 1970, 1988 (2021). And, it cannot be disputed that had the Federal Circuit had this Court's *Arthrex* decision at the time it considered Infineum's appeal, its decision would have been different. That the remedy ordered by this Court in *United States v. Arthrex* is different than the remedy requested by Infineum before the Federal Circuit Court of Appeals is of no moment, particularly given that such a remedy was not available to Infineum under the then-existing Federal Circuit precedent.

Before this Court's decision in *United States v. Arthrex*, the Federal Circuit held that the only remedy available to appellants that established an Appointments Clause violation was a new hearing before a new panel. *See Arthrex*, 941 F.3d at 1340 ("[O]n remand we hold that a new panel of APJs must be designated and a new hearing granted."). The Federal Circuit's precedent did not allow for rehearing before the Director. However, this Court's decision in *United States v. Arthrex* found that litigants are constitutionally entitled to the opportunity to request Director re-hearing of final written decisions. 141 S. Ct. at 1986.

Consistent with Infineum's Petition, this Court has already issued GVR Orders where petitioners raised the same issue that Infineum has here. *See Iancu v. Fall Line Pats.*, 141 S. Ct. 2843, 2844 (2021); *Polaris Innovations Ltd. v. Kingston Tech. Co.*, 141 S. Ct. 2844, 2844 (2021); *RPM Int'l Inc. v. Stuart*, 141 S. Ct. 2844, 2844 (2021);

Iancu v. Luoma, 141 S. Ct. 2845, 2847 (2021); *Hirshfeld v. Implicit, LLC*, No. 20-1631, 2021 WL 4822667, at *1 (U.S. Oct. 18, 2021). And, in those cases, like this one, the petitioners did not request the same remedy provided in *United States v. Arthrex.* Clearly, the difference in remedy fashioned by this Court and those requested below does not preclude this Court from granting, vacating and remanding this case to the Federal Circuit.

B. Infineum's Alternative Request for Certiorari Warrants Review.

Relying on the same observation that the remedy ordered by this Court is different from that ordered by the Federal Circuit, Oronite argues that this Court should not grant certiorari to remedy the Federal Circuit's misapplication of the appellate mandate and characterizes the issue as "artificial and hypothetical" and a "poor vehicle to address the question presented." Br. of Resp't at 13, 16.

If the Court determines that a GVR order is not appropriate, the Federal Circuit's ruling regarding the impact of the appellate mandate is anything but artificial or hypothetical. The Federal Circuit's precedent has resulted in Appointments Clause challenges being limited to challenges raised before the Federal Circuit's *Arthrex v. Smith & Nephew* opinion and after this Court's decision in *United States v. Arthrex*. Numerous appellants, such as Infineum, that properly raised Appointments Clause challenges before the Federal Circuit issued its mandate had their challenges improperly denied. That the Federal Circuit may now order a different remedy then it would have earlier is irrelevant.

The Federal Circuit's underlying published precedent establishes an application of the appellate mandate that is unique to the Federal Circuit and has resulted in the denial of numerous Appointments Clause challenges. If this Court does not address the mandate issue now, the Federal Circuit's precedent will continue to have far-reaching effects well beyond the constitutional issue addressed in *Arthrex v. Smith & Nephew*. Going forward, opinions issued and remedies ordered by the Federal Circuit will be held to a different standard than other circuits.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted.

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