

No. 17-1686

In the Supreme Court of the United States

RPX CORPORATION, PETITIONER

v.

CHANBOND LLC

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

BRIEF FOR THE UNITED STATES AS AMICUS CURIAE

NOEL J. FRANCISCO

Solicitor General

Counsel of Record

JOSEPH H. HUNT

Assistant Attorney General

MALCOLM L. STEWART

Deputy Solicitor General

JENNY C. ELLICKSON

*Assistant to the Solicitor
General*

MARK R. FREEMAN

MELISSA N. PATTERSON

JAMES Y. XI

Attorneys

*Department of Justice
Washington, D.C. 20530-0001
SupremeCtBriefs@usdoj.gov
(202) 514-2217*

QUESTION PRESENTED

Whether a petitioner for inter partes review has Article III standing to appeal the Patent Trial and Appeal Board's final written decision upholding the challenged patent claims, where the petitioner disagrees with the Board's decision but suffers no concrete or particularized harm from the ongoing existence of the patent.

TABLE OF CONTENTS

	Page
Interest of the United States.....	1
Statement	1
Discussion.....	8
A. Petitioner has not suffered an injury in fact and thus lacks Article III standing	9
B. The court of appeals' decision does not warrant this Court's review.....	19
Conclusion	21

TABLE OF AUTHORITIES

Cases:

<i>Applications in Internet Time, LLC v. RPX Corp.</i> , 897 F.3d 1336 (Fed. Cir. 2018), cert. denied, 139 S. Ct. 1366 (2019)	5, 6
<i>Bank of Am. Corp. v. City of Miami</i> , 137 S. Ct. 1296 (2017)	18
<i>Bond v. United States</i> , 572 U.S. 844 (2014)	18
<i>Canadian Lumber Trade Alliance v. United States</i> , 517 F.3d 1319 (Fed. Cir.), cert. denied, 555 U.S. 819 (2008).....	8
<i>Chanbond, LLC v. Atlantic Broadband Grp., LLC</i> , No. 15-cv-842, 2016 WL 7177612 (D. Del. Dec. 9, 2016)	5, 6
<i>Consumer Watchdog v. Wisconsin Alumni Research Found.</i> , 753 F.3d 1258 (Fed. Cir. 2014), cert. denied, 135 S. Ct. 1401 (2015)	7, 13
<i>Cuozzo Speed Techs., LLC v. Lee</i> , 136 S. Ct. 2131 (2016).....	1, 2, 10
<i>Diamond v. Charles</i> , 476 U.S. 54 (1986)	11, 12
<i>Federal Election Comm'n v. Akins</i> , 524 U.S. 11 (1998).....	15

IV

Cases—Continued:	Page
<i>Frank v. Gaos</i> , 139 S. Ct. 1041 (2019).....	17
<i>Hollingsworth v. Perry</i> , 570 U.S. 693 (2013)	9
<i>JTEKT Corp. v. GKN Auto. Ltd.</i> , 898 F.3d 1217 (Fed. Cir. 2018), petition for cert. pending, No. 18-750 (filed Dec. 7, 2018)	20
<i>Jones v. United States</i> , 526 U.S. 227 (1999).....	18, 19
<i>Lujan v. Defenders of Wildlife</i> , 504 U.S. 555 (1992).....	9, 11, 18
<i>Phigenix, Inc. v. Immunogen, Inc.</i> , 845 F.3d 1168 (Fed. Cir. 2017)	7
<i>Public Citizen v. United States Dep’t of Justice</i> , 491 U.S. 440 (1989).....	15
<i>Raines v. Byrd</i> , 521 U.S. 811 (1997)	9
<i>Spokeo, Inc. v. Robins</i> , 136 S. Ct. 1540 (2016)	7, 12, 14, 17
<i>Summers v. Earth Island Inst.</i> , 555 U.S. 488 (2009).....	14, 18
<i>Village of Arlington Heights v. Metropolitan Hous. Dev. Corp.</i> , 429 U.S. 252 (1977)	10

Constitution and statutes:

U.S. Const. Art. III	<i>passim</i>
§ 2	9
Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284	2
35 U.S.C. 101	2
35 U.S.C. 102	2
35 U.S.C. 103	2
35 U.S.C. 131	2
35 U.S.C. 141	16
35 U.S.C. 141(c).....	4, 16, 17, 18, 19
35 U.S.C. 154(a)(1).....	1
35 U.S.C. 311	2, 14, 16

Statutes—Continued:	Page
35 U.S.C. 311-319.....	14
35 U.S.C. 311(a)	2, 10, 12, 14
35 U.S.C. 311(b)	2
35 U.S.C. 312(a)(2).....	2
35 U.S.C. 312(a)(3).....	2
35 U.S.C. 313.....	2
35 U.S.C. 314(a)	3
35 U.S.C. 315.....	14, 16
35 U.S.C. 315(a)	3
35 U.S.C. 315(b)	3
35 U.S.C. 315(e)	14
35 U.S.C. 315(e)(1).....	4, 14
35 U.S.C. 315(e)(2).....	4
35 U.S.C. 316(a)(5).....	3, 12
35 U.S.C. 316(a)(8).....	3
35 U.S.C. 316(a)(10).....	3, 12
35 U.S.C. 316(a)(11).....	3
35 U.S.C. 316(a)(13).....	3, 12
35 U.S.C. 316(c).....	3
35 U.S.C. 316(e)	3, 12, 13
35 U.S.C. 318.....	16
35 U.S.C. 318(a)	3, 13
35 U.S.C. 318(b)	4, 13, 14
35 U.S.C. 319.....	3, 4, 16, 17, 18
35 U.S.C. 321(c).....	2

In the Supreme Court of the United States

No. 17-1686

RPX CORPORATION, PETITIONER

v.

CHANBOND LLC

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

BRIEF FOR THE UNITED STATES AS AMICUS CURIAE

INTEREST OF THE UNITED STATES

This brief is filed in response to the Court’s order inviting the Solicitor General to express the views of the United States. In the view of the United States, the petition for a writ of certiorari should be denied.

STATEMENT

1. A United States patent confers “the right to exclude others from making, using, offering for sale, or selling [an] invention throughout the United States or importing the invention into the United States.” 35 U.S.C. 154(a)(1). An inventor who seeks a patent must file an application with the United States Patent and Trademark Office (USPTO). When such an application is filed, a USPTO examiner “reviews [the] applicant’s patent claims, considers the prior art, and determines whether each claim meets the applicable patent law requirements.” *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct.

2131, 2136-2137 (2016); see 35 U.S.C. 131. Those requirements include eligibility and utility, 35 U.S.C. 101; novelty, 35 U.S.C. 102; and non-obviousness over the prior art, 35 U.S.C. 103. If the examiner determines that the applicant satisfies the statutory requirements, the USPTO issues a patent for the invention. 35 U.S.C. 131; see *Cuozzo*, 136 S. Ct. at 2137.

“For several decades,” Congress has authorized the USPTO to reconsider its own patent-issuance decisions through proceedings “to reexamine—and perhaps cancel—a patent claim that it had previously allowed.” *Cuozzo*, 136 S. Ct. at 2137. In 2011, the Leahy-Smith America Invents Act (AIA), Pub. L. No. 112-29, 125 Stat. 284, created new procedures for such challenges. The AIA established a mechanism known as post-grant review for challenges to patentability that are brought within nine months after the disputed patent was issued. 35 U.S.C. 321(c). For challenges brought more than nine months after issuance of the patent, the AIA created inter partes review. 35 U.S.C. 311.

Any person other than the patent owner may file a petition for inter partes review to assert that, at the time the patent was issued, the claimed invention was not novel or obvious in light of “prior art consisting of patents or printed publications.” 35 U.S.C. 311(a) and (b). Among other requirements, a petition for inter partes review must “identif[y] all real parties in interest,” 35 U.S.C. 312(a)(2), and set forth “each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim,” 35 U.S.C. 312(a)(3). The patent owner may file a preliminary response to the petition. 35 U.S.C. 313.

The USPTO may institute an inter partes review only if the agency finds “a reasonable likelihood that the petitioner would prevail” with respect to at least one of its challenges to the validity of the disputed patent. 35 U.S.C. 314(a). Inter partes review may not be instituted if the petitioner previously filed a civil action challenging the validity of the disputed patent, 35 U.S.C. 315(a), or if the patent owner had sued the petitioner for infringement of the disputed patent more than one year before the petition was filed, 35 U.S.C. 315(b).

When the USPTO elects to institute an inter partes review, the agency’s Patent Trial and Appeal Board (Board) conducts the review. See 35 U.S.C. 316(e). Both the petitioner for inter partes review and the patent owner are entitled to take limited discovery, 35 U.S.C. 316(a)(5); to request an oral hearing, 35 U.S.C. 316(a)(10); and to file written memoranda, 35 U.S.C. 316(a)(8) and (13). The petitioner for inter partes review bears “the burden of proving a proposition of unpatentability by a preponderance of the evidence.” 35 U.S.C. 316(e). At the conclusion of the proceeding (unless the matter has been dismissed), the Board must “issue a final written decision with respect to the patentability of any patent claim challenged by the petitioner and any new claim added” to the patent by amendment during the pendency of the inter partes review proceeding. 35 U.S.C. 318(a). The Board generally must issue its final written decision within one year after the review is instituted. 35 U.S.C. 316(a)(11).

Under the AIA, “[a] party dissatisfied with” the Board’s final written decision in an inter partes review “may appeal the decision pursuant to [35 U.S.C.] 141 through 144.” 35 U.S.C. 319. “Any party to the inter partes review shall have the right to be a party to the

appeal.” *Ibid.* As relevant here, a party to an inter partes review “who is dissatisfied with” the Board’s final written decision “may appeal the Board’s decision only to the United States Court of Appeals for the Federal Circuit.” 35 U.S.C. 141(c). If the Board issues a final written decision and the time for appeal has expired or any appeal has terminated, the Director of the USPTO must issue and publish a certificate cancelling any patent claim “finally determined to be unpatentable,” confirming any patent claim “determined to be patentable,” and incorporating in the patent “any new or amended claim determined to be patentable.” 35 U.S.C. 318(b).

If the USPTO grants inter partes review of a patent claim and issues a final written decision, the inter partes review petitioner, or the real party in interest or privy of the petitioner, thereafter is estopped from “request[ing] or maintain[ing] a proceeding” before the agency “with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review.” 35 U.S.C. 315(e)(1). The petitioner, or the real party in interest or privy of the petitioner, likewise is barred from “assert[ing] either in a civil action arising in whole or in part under [28 U.S.C.] 1338,” or in proceedings before the International Trade Commission, “that the claim is invalid on any ground that the petitioner raised or reasonably could have raised during that inter partes review.” 35 U.S.C. 315(e)(2).

2. a. Petitioner provides “patent risk management services” to clients who pay an annual subscription fee. C.A. Doc. 30-2, at 6 (Oct. 2, 2017); see *id.* at 9. In 2013, as part of a “new business initiative,” petitioner began to file petitions for inter partes review to challenge “weak patents.” Pet. App. 2 (citation omitted). Petitioner states that its goal in filing these petitions is to

“help the Patent Office cancel patents that do not claim real inventions,” thus “reduc[ing] the volume of and time spent on patent assertions and litigations, as well as the billions of dollars spent on unnecessary legal fees and settlements.” Pet. 4-5. Petitioner describes petitions for inter partes review as “an important mechanism by which third-party petitioners * * * help to curb abuses of the U.S. patent system.” Pet. 6.

In connection with its efforts to challenge the validity of patents through inter partes review, petitioner has adopted certain “best practices” to “ensure” that petitioner “is and will be deemed by the [Board] and district courts as the sole real party-in-interest in all validity challenges unless another real party-in-interest is expressly identified.” *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1340 (Fed. Cir. 2018), cert. denied, 139 S. Ct. 1366 (2019) (citation omitted); see *ibid.* (describing petitioner’s “best practices”) (citation omitted). In addition, petitioner “seeks to distinguish itself” from its competitors by filing only “high quality” petitions for inter partes review, and it “publicly markets its success” in inter partes reviews. Pet. App. 2 (citation omitted); see *id.* at 3 n.2. Petitioner contends that “it typically realizes no direct monetary benefit by virtue of filing” petitions for inter partes review, but that “it relies on the enhanced reputational goodwill generated by its success[.]” in such reviews. *Id.* at 2.

b. This case arises from a petition for inter partes review that petitioner filed in November 2015 to challenge the patentability of claims in U.S. Patent No. 7,941,822 (the ’822 patent), a patent owned by respondent that covers a device that distributes signals on a wideband signal distribution system. Pet. App. 9-10; *Chanbond, LLC v. Atlantic Broadband Grp., LLC*,

No. 15-cv-842, 2016 WL 7177612, at *1 (D. Del. Dec. 9, 2016).¹ In its petition for inter partes review, petitioner stated that it was “the sole real party-in-interest in this proceeding” and “ha[d] not communicated with any client about its intent to contest the validity of th[e] patent, or the preparation or filing of” the petition. C.A. Doc. 30-6, at 7 (Oct. 2, 2017). The petition further stated that petitioner had “complete, unilateral control of all aspects of this proceeding” and was “solely responsible for all costs and expenses associated with this proceeding.” *Ibid.* Those statements were consistent with the “best practices” that petitioner had adopted for inter partes reviews. See *Applications in Internet Time*, 897 F.3d at 1340.

Based on the information presented in that petition, the USPTO instituted inter partes review of the challenged claims in the '822 patent. Pet. App. 10. Following additional briefing and a hearing, the Board entered a final written decision holding that petitioner had not demonstrated that any of the challenged claims are unpatentable. *Id.* at 10, 48. According to petitioner, that determination “ended RPX’s record of claim cancellation in every final written decision.” *Id.* at 3 (brackets, citation, and internal quotation marks omitted).

3. Petitioner sought to appeal the Board’s final written decision to the Federal Circuit. The court of appeals dismissed petitioner’s appeal, holding that petitioner “lacks Article III standing to appeal the Board’s decision.” Pet. App. 8; see *id.* at 1-8. “To meet the constitutional minimum for standing,” the court explained,

¹ Two months before petitioner filed that petition for inter partes review, respondent sued several companies for infringement of the '822 patent. *Chanbond, LLC*, 2016 WL 7177612, at *1.

petitioner “must demonstrate that it has suffered an injury in fact,” *i.e.*, “an injury that is ‘both concrete *and* particularized.’” *Id.* at 3 (quoting *Spokeo, Inc. v. Robins*, 136 S. Ct. 1540, 1548 (2016)). The court determined that petitioner had not demonstrated such an injury in this case. *Id.* at 4-8.

Petitioner contended that it had Article III standing because the Board’s final written decision had “injured” petitioner’s statutory rights under the AIA. Pet. App. 4-6. In rejecting petitioner’s claim that it had a statutory “right to compel cancellation of claims on unpatentable inventions,” the court of appeals observed that the AIA “‘allow[s] any third party’” to request inter partes review, and that such review, “‘where granted, allow[s] the third party to participate’” but “‘d[oes] not guarantee a particular outcome favorable to the requestor.’” *Id.* at 5 (quoting *Consumer Watchdog v. Wisconsin Alumni Research Found.*, 753 F.3d 1258, 1262 (Fed. Cir. 2014), cert. denied, 135 S. Ct. 1401 (2015)). The court held that petitioner had received “all the statute requires” because petitioner “was permitted to request review and participate once the [US]PTO granted its request.” *Id.* at 5 (quoting *Consumer Watchdog*, 753 F.3d at 1262) (brackets omitted).

The court of appeals also rejected petitioner’s contention that it had suffered Article III injury because the Board’s decision impaired petitioner’s “right to file multiple petitions” for inter partes review on the same patent claims. Pet. App. 5. The court noted its prior holding that “the estoppel provision of 35 U.S.C. § 315(e)(1) did not constitute an injury in fact when the appellant ‘is not engaged in any activity that would give rise to a possible infringement suit.’” *Ibid.* (quoting *Phigenix, Inc. v. Immunogen, Inc.*, 845 F.3d 1168, 1175-1176

(Fed. Cir. 2017)). That holding disposed of petitioner’s argument because petitioner undisputedly was “not engaged in any potentially infringing activity regarding the ’822 patent.” *Ibid.*

Finally, the court of appeals held that petitioner had not demonstrated that the Board’s decision injured either petitioner’s “standing relative to competitors” or petitioner’s “reputation of successfully challenging wrongfully issued patent claims.”² Pet. App. 6-7 (citation omitted). The court observed that “[t]he doctrine of competitor standing ‘relies on economic logic to conclude that a plaintiff will likely suffer an injury-in-fact when the government acts in a way that increases competition or aids the plaintiff’s competitors.’” *Id.* at 6 (quoting *Canadian Lumber Trade Alliance v. United States*, 517 F.3d 1319, 1332 (Fed. Cir.), cert. denied, 555 U.S. 819 (2008)). The court found that petitioner’s evidence did not demonstrate that the Board’s final written decision “increased or aids the competition in the market” of “non-defendant” petitioners for inter partes review. *Id.* at 6-7. As for petitioner’s assertion that the Board’s decision injured petitioner’s “reputation of successfully challenging wrongfully issued patent claims,” the court found that petitioner’s evidentiary submissions “d[id] not demonstrate a concrete and particularized reputational injury.” *Id.* at 7.

DISCUSSION

The court of appeals correctly dismissed petitioner’s appeal of the Board’s final written decision upholding the ’822 patent. The Federal Circuit’s jurisdictional ruling does not conflict with any decision of this Court or

² Petitioner has not asked the Court to review these holdings.

another court of appeals. Neither the continued existence of the '822 patent, nor the Board's ultimate rejection of petitioner's arguments as to patentability, subjects petitioner to any Article III injury. Contrary to petitioner's contentions (Pet. 10-21), the Board's decision did not violate petitioner's rights under the AIA, and any such statutory violation would not have sufficed to confer Article III standing even if it had occurred. Further review is not warranted.

A. Petitioner Has Not Suffered An Injury In Fact And Thus Lacks Article III Standing

The “[J]udicial Power” of the United States extends only to Article III “Cases” and “Controversies.” U.S. Const. Art. III, § 2. The doctrine of Article III standing serves as “an essential and unchanging part of the case-or-controversy requirement,” *Lujan v. Defenders of Wildlife*, 504 U.S. 555, 560 (1992) (*Defenders*), and a “person[] seeking appellate review” must establish its Article III standing in order to pursue the appeal, *Hollingsworth v. Perry*, 570 U.S. 693, 705 (2013). To invoke a federal court's jurisdiction, a party must establish the “three elements” of Article III standing: (1) an “injury in fact” (2) caused by the opposing party's conduct and (3) redressable by a favorable decision. *Defenders*, 504 U.S. at 560-561. In this case, the court of appeals correctly held that petitioner had failed to show any Article III “injury in fact.” Pet. App. 3-8.

1. To establish injury in fact, a party must show “an invasion of a legally protected interest” that is “concrete and particularized” and “actual or imminent, not conjectural or hypothetical.” *Defenders*, 504 U.S. at 560 (citation and internal quotation marks omitted). In many cases, the injury-in-fact inquiry is straightforward, as when a plaintiff alleges that he has suffered economic

loss or another well-recognized form of harm as a result of the defendant's violation of law. See, e.g., *Village of Arlington Heights v. Metropolitan Hous. Dev. Corp.*, 429 U.S. 252, 262-263 (1977).

Here, however, the ongoing existence of the '822 patent causes petitioner no harm. Petitioner claims no commercial or other interest in the subject matter of the '822 patent. In particular, petitioner does not allege that the patent, and the consequent risk of infringement liability for activities that the patent covers, have prevented or will prevent petitioner from undertaking any conduct in which petitioner would otherwise engage.

Nor does petitioner assert any basis for associational or representative standing. To the contrary, in its petition for inter partes review, petitioner stated that it was "the sole real party-in-interest in this proceeding" and "ha[d] not communicated with any client about its intent to contest the validity of th[e] patent, or the preparation or filing of" the petition for inter partes review. C.A. Doc. 30-6, at 7. For all that appears in the record, petitioner is a stranger to the '822 patent and the invention it claims. Petitioner therefore concedes that it cannot show "a patent-inflicted injury in fact." Pet. 9.

2. Because the Board is not an Article III tribunal, and Congress has not required a petitioner for inter partes review to establish that it has suffered concrete injury from the existence of the challenged patent, petitioner's inability to show such an injury did not prevent it from requesting inter partes review and participating in the Board proceedings once review was instituted. See 35 U.S.C. 311(a); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2143-2144 (2016) ("Parties that initiate the [inter partes review] proceeding need not have a concrete stake in the outcome; indeed, they may

lack constitutional standing.”). Petitioner’s ability to invoke the jurisdiction of the Federal Circuit, however, does depend on such a showing. The Board’s rejection, in its final written decision, of petitioner’s legal challenges to the ’822 patent does not subject petitioner to any Article III injury.

Petitioner asserts that it files petitions for inter partes review to “help the Patent Office cancel patents that do not claim real inventions,” thus “reduc[ing] the volume of and time spent on patent assertions and litigations, as well as the billions of dollars spent on unnecessary legal fees and settlements.” Pet. 4-5. According to petitioner, its efforts “help to curb abuses of the U.S. patent system.” Pet. 6. But “a plaintiff raising only a generally available grievance about government—claiming only harm to his and every citizen’s interest in proper application of the Constitution and laws, and seeking relief that no more directly and tangibly benefits him than it does the public at large—does not state an Article III case or controversy.” *Defenders*, 504 U.S. at 573-574; see *Diamond v. Charles*, 476 U.S. 54, 62 (1986) (“The presence of a disagreement, however sharp and acrimonious it may be, is insufficient by itself to meet Art[icle] III’s requirements.”).

The fact that petitioner requested the inter partes review and participated as a party in the Board proceedings likewise does not give it standing to challenge the Board’s final written decision. In *Diamond*, an individual physician who had intervened as a defendant in the district court attempted to pursue an appeal to this Court after the Seventh Circuit declared a state statute unconstitutional and the State declined to pursue its own appeal. 476 U.S. at 57-61. The Court dismissed the physician’s appeal for lack of jurisdiction. *Id.* at 71. The

Court held that the physician could not show personal injury from the court of appeals' decision holding the challenged state law to be invalid, *id.* at 64-67, and that his "status as an intervenor below * * * d[id] not confer standing sufficient to keep the case alive in the absence of the State on this appeal," *id.* at 68. Similarly here, petitioner lacks standing to appeal the Board's decision, despite his status as a party to the Board proceedings, because petitioner has no concrete and particularized stake in whether the Board's decision was correct or whether the '822 patent remains in force.

3. The court of appeals correctly rejected petitioner's contention (Pet. 10-15) that the Board's final written decision subjected it to an Article III injury by depriving petitioner of rights conferred by the AIA. "[T]he violation of a procedural right granted by statute can be sufficient in some circumstances to constitute injury in fact." *Spokeo, Inc. v. Robins*, 136 S. Ct. 1540, 1549 (2016). For two independent reasons, however, petitioner cannot establish Article III standing on that basis here.

a. Petitioner did not suffer a deprivation of any of the procedural rights that the AIA confers. Subject to exceptions that were inapplicable to petitioner's request, any person other than the patent owner may file a petition for inter partes review of a patent claim. 35 U.S.C. 311(a). If the USPTO chooses to institute the requested inter partes review, the AIA also grants the petitioner certain procedural rights, such as the right to an oral hearing. 35 U.S.C. 316(a)(10); see also, *e.g.*, 35 U.S.C. 316(a)(5) and (13). The AIA provides that, in an inter partes review, the petitioner has "the burden of proving a proposition of unpatentability by a preponderance of the evidence." 35 U.S.C. 316(e).

The AIA does not, however, give petitioners for inter partes review “the substantive statutory right to compel the Patent Office to cancel unpatentable patent claims.” Pet. 12. Rather, the AIA provides only that, where “an inter partes review is instituted and not dismissed,” the Board “shall issue a final written decision with respect to the patentability of any patent claim challenged by petitioner,” 35 U.S.C. 318(a), and the Director “shall issue and publish a certificate” effectuating the Board’s decision, 35 U.S.C. 318(b). Because the AIA does not “guarantee a particular outcome” for a person that requests inter partes review, the court of appeals correctly held that petitioner had received “all the statute requires,” insofar as petitioner “was permitted to request review and participate once the [US]PTO granted its request.” Pet. App. 5 (quoting *Consumer Watchdog v. Wisconsin Alumni Research Found.*, 753 F.3d 1258, 1262 (Fed. Cir. 2014), cert. denied, 135 S. Ct. 1401 (2015)) (brackets omitted).

In arguing otherwise, petitioner invokes (Pet. 11) the AIA provision that places upon the petitioner for inter partes review the “burden of proving a proposition of unpatentability by a preponderance of the evidence.” 35 U.S.C. 316(e). But Congress authorized the Board to determine whether petitioner had carried that burden. See 35 U.S.C. 318(a). The USPTO’s statutory obligation to cancel a patent claim thus arises from the Board’s “final[] determin[ation]” that the claim is “unpatentable,” not from the proof offered by the petitioner for inter partes review. 35 U.S.C. 318(b). Accordingly, if a petitioner for inter partes review believes that she has proved the unpatentability of a claim, but the Board concludes that the petitioner has failed to carry her bur-

den, Section 318(b) requires the USPTO to issue a certificate confirming that patent claim once the time for appeal has expired or any appeal has terminated. 35 U.S.C. 318(b).

Petitioner is also wrong in contending (Pet. 14-15) that the Board's final written decision has "invaded" petitioner's asserted "statutory right" to file future petitions for inter partes review to challenge claims in the '822 patent. Although Section 311 authorizes "a person who is not the owner of a patent" to "file with the [USPTO] a petition to institute an inter partes review of the patent," it confers that procedural right "[s]ubject to the provisions of" 35 U.S.C. 311-319. 35 U.S.C. 311(a). Under Section 315, "[t]he petitioner in an inter partes review of a claim in a patent * * * that results in a final written decision * * * may not request or maintain a proceeding before the [USPTO] with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review." 35 U.S.C. 315(e)(1). Petitioner has thus received the statutory right afforded by Section 311: the opportunity to file petitions for inter partes review of claims in the '822 patent unless and until one of those petitions results in a final written decision. 35 U.S.C. 315(e).

b. Even if petitioner could show that the Board breached an AIA procedural requirement concerning the proper conduct of inter partes reviews, that violation would not give petitioner Article III standing. "[D]eprivation of a procedural right without some concrete interest that is affected by the deprivation—a procedural right *in vacuo*—is insufficient to create Article III standing." *Summers v. Earth Island Inst.*, 555 U.S. 488, 496 (2009); see *Spokeo*, 136 S. Ct. at 1549 (explain-

ing that a plaintiff cannot “allege a bare procedural violation, divorced from any concrete harm, and satisfy the injury-in-fact requirement of Article III”). Here, as explained above, see pp. 9-12, *supra*, petitioner has identified no concrete interest of its own that the continued existence and legal effect of the ’822 patent would impair. Absent such a particularized interest in the *outcome* of the inter partes review, petitioner could not establish that any procedural violation within that review caused it injury in fact, even if it could show that such a violation occurred.

4. Petitioner’s reliance (Pet. 14, 24) on *Federal Election Commission v. Akins*, 524 U.S. 11 (1998), and *Public Citizen v. United States Dep’t of Justice*, 491 U.S. 440 (1989), is misplaced. Those decisions confirm that a litigant must identify a “concrete and particular” injury in order to establish Article III standing. *Akins*, 524 U.S. at 21; see *Public Citizen*, 491 U.S. at 448-450. The litigants in *Akins* and *Public Citizen* established such an injury by alleging that they had been denied access to information to which they were legally entitled. *Akins*, 524 U.S. at 21-25 (determining that respondents’ inability to obtain information that would help them evaluate candidates for public office constituted a “sufficiently concrete and specific” injury for purposes of Article III); *Public Citizen*, 491 U.S. at 448-450 (holding that petitioners’ inability to obtain information that would help them monitor the workings of an American Bar Association committee and participate more effectively in the judicial-selection process constituted a “concrete and specific” injury for purposes of Article III). Petitioner, by contrast, has not been denied access to any information to which it is legally entitled.

5. The AIA provisions (35 U.S.C. 141(c), 319) that govern judicial review of Board decisions in inter partes reviews do not cast doubt on the Federal Circuit’s dismissal of petitioner’s appeal. In its reply brief, petitioner clarifies (at 3-5) that its injury-in-fact argument rests only on Sections 311, 315, and 318, and not on Sections 319 and 141. Petitioner invokes Sections 319 and 141 only to overcome limits on so-called “prudential standing.”³ Pet. Reply Br. 3-4 (citation omitted); see Pet. 16-21. As petitioner acknowledges, however, “lack of prudential standing * * * was not the basis for the [c]ourt of [a]ppeals’ decision,” Pet. Reply Br. 5, and the question presented in the petition asks only “whether §§ 318, 311 and 315 create injuries in fact sufficient to confer standing to appeal under § 319,” *id.* at 3-4. Petitioner expressly disclaims any contention that it has Article III standing by virtue of Section 319, explaining that it “did not below, and does not now, argue § 319 provides injury in fact.” *Id.* at 5.

Despite petitioner’s disavowal of the argument, at least one amicus curiae asks the Court to grant a writ of certiorari to determine whether Section 319 “has established an intangible injury-in-fact that meets the ‘case or controversy’ requirements of Article III.” N.Y. Intellectual Prop. Law Ass’n Amicus Br. (NYIPLA Br.) 3. The amicus argues that, under Sections 319 and 141(c), any party to an inter partes review that is “dissatisfied” with the Board’s final written decision may obtain appellate review in the Federal Circuit. *Id.* at 12, 14-15

³ Likewise, petitioner cited Sections 319 and 141(c) only once during the proceedings below, in support of its contention that it “need not show that it satisfies the zone of interest test, which traditionally was called ‘prudential standing.’” Pet. C.A. Opp. to Mot. to Dismiss Br. 14.

(citation omitted); see Askeladden LLC Amicus Br. 12-14. Implicit in the amicus's argument is the assumption that any party that disagrees with the Board's decision is "dissatisfied" within the meaning of those provisions.

Even when Congress has unambiguously authorized a particular class of plaintiffs to seek judicial relief, "Article III standing requires a concrete injury." *Spokeo*, 136 S. Ct. at 1549. This Court has "rejected the premise * * * that 'a plaintiff automatically satisfies the injury-in-fact requirement whenever a statute grants a person a statutory right and purports to authorize that person to sue to vindicate that right.'" *Frank v. Gaos*, 139 S. Ct. 1041, 1045 (2019) (quoting *Spokeo*, 136 S. Ct. at 1549). Congress thus would lack power to define petitioner's disagreement with the Board's decision, divorced from any concrete and particularized harm to petitioner itself, as an Article III injury. The amici's construction of Sections 319 and 141(c) therefore would render those provisions unconstitutional as applied to appeals like this one, in which the appellant disagrees with the Board's decision but suffers no concrete injury from it. But Sections 319 and 141(c) need not and should not be read in the manner that amici suggest.

Once an appeal from the Board's final written decision in an inter partes review has been filed, Section 319 states in unqualified terms that "[a]ny party to the inter partes review shall have the right to be a party to the appeal." 35 U.S.C. 319. The right to *initiate* the appeal, by contrast, is conferred not on "[a]ny party to the inter partes review," but on "[a] party dissatisfied with the final written decision of the [Board]." *Ibid.* And because any appeal by its nature is premised on disagreement with the decision being appealed, that prerequisite would have no practical effect if every party that

disagreed with the Board’s decision could invoke the Federal Circuit’s jurisdiction. To prevent that prerequisite from being superfluous, the term “dissatisfied with” should be construed to mean “aggrieved by” or “injured by.” That reading also comports with the canon of constitutional avoidance, which dictates that “where a statute is susceptible of two constructions, by one of which grave and doubtful constitutional questions arise and by the other of which such questions are avoided, [the Court’s] duty is to adopt the latter.” *Jones v. United States*, 526 U.S. 227, 239 (1999) (citation omitted).

By specifying that any “dissatisfied” party may appeal the final written decision of the Board, Sections 319 and 141(c) thus suggest “a congressional intention to define standing as broadly as is permitted by Article III,” at least with respect to parties to inter partes reviews. Cf. *Bank of Am. Corp. v. City of Miami*, 137 S. Ct. 1296, 1303 (2017) (citation omitted) (discussing the meaning of “person aggrieved” in the Fair Housing Act). The statutory text need not be read, however, to authorize appeal by a party that disagrees with a Board decision but suffers no concrete and particularized harm. Congress enacted Sections 319 and 141(c) against the backdrop of the well-settled principle that proof of an injury in fact is “an indispensable part of the plaintiff’s case” in every proceeding in an Article III tribunal. *Defenders*, 504 U.S. at 561; see also *Earth Island Inst.*, 555 U.S. at 497; *Bond v. United States*, 572 U.S. 844, 857 (2014) (explaining that “Congress legislates against the backdrop of certain unexpressed presumptions”) (citation and internal quotation marks omitted). Congress thus presumably understood that “the requirement of injury in fact is a hard floor of Article III jurisdiction that cannot be removed by statute,” *Earth Island Inst.*, 555 U.S. at

497, and further understood that it could not “erase Article III’s standing requirements by statutorily granting the right to sue to a plaintiff who would not otherwise have standing,” *Raines v. Byrd*, 521 U.S. 811, 820 n.3 (1997); see *Jones*, 526 U.S. at 239-240 (explaining that the Court adheres to the constitutional-avoidance rule “out of respect for Congress, which [the Court] assume[s] legislates in the light of constitutional limitations”) (citation omitted).

B. The Court Of Appeals’ Decision Does Not Warrant This Court’s Review

As discussed above, the court of appeals correctly held that petitioner has not suffered an injury in fact sufficient to confer Article III standing to appeal the Board’s final written decision regarding the ’822 patent. Because the Federal Circuit has exclusive jurisdiction over appeals from final written decisions of the Board, see 35 U.S.C. 141(c), no other court of appeals has addressed (or can address) whether and when a petitioner for inter partes review has Article III standing to appeal such a decision. Although petitioner contends (Pet. 24) that the decision below conflicts with various decisions of the D.C. Circuit, the rulings that petitioner cites involved the interpretation of statutes other than the AIA, and they do not establish that the D.C. Circuit (or any other court of appeals) would disagree with the Federal Circuit’s analysis here.

In addition, the practical effect of the court of appeals’ decision is limited. The Federal Circuit’s decision does not restrict the class of persons who can petition for inter partes review. See pp. 10-11, *supra*. If the Board institutes such a review and ultimately determines that the petitioner has failed to demonstrate the unpatentability of the challenged claims, the petitioner

can obtain Federal Circuit review so long as it can show Article III injury from the continued existence of those patent claims. Most obviously, the petitioner could satisfy the injury-in-fact requirement by “establish[ing] that it has concrete plans for future activity that creates a substantial risk of future infringement or likely [will] cause the patentee to assert a claim of infringement.” *JTEKT Corp. v. GKN Auto. Ltd.*, 898 F.3d 1217, 1221 (Fed. Cir. 2018), petition for cert. pending, No. 18-750 (filed Dec. 7, 2018).⁴ But the court below did not suggest that this is the *only* way a petitioner for inter partes review could show concrete harm from the Board’s decision; it simply recognized that *some* showing of Article III injury is essential.

Petitioner contends (Pet. 21-25) that “the Federal Circuit’s body of decisions” reflects an unduly narrow view of injury in fact, under which petitioners for inter partes review can establish Article III standing only by “prov[ing] that they either have been accused of infringement of the challenged patent or imminently will be.” The court of appeals has not adopted a categorical rule to that effect, but has stated that “typically,” a would-be appellant in this setting “must show that it is engaged or will likely engage ‘in an activity that would give rise to a possible infringement suit’ or has contractual rights that are affected by a determination of patent validity.” *JTEKT Corp.*, 898 F.3d at 1220 (brackets and citation omitted). In any event, petitioner has failed

⁴ *JTEKT*’s petition for a writ of certiorari, challenging the Federal Circuit’s standing analysis in the decision quoted in the text, is currently pending before this Court. See *JTEKT Corp.*, *supra* (No. 18-750).

to identify any plausible *alternative* ground for concluding that the Board's decision caused it concrete injury. This case therefore would be a poor vehicle for identifying the circumstances under which anticipated harms other than actual or imminent infringement suits could satisfy Article III.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

NOEL J. FRANCISCO
Solicitor General
JOSEPH H. HUNT
Assistant Attorney General
MALCOLM L. STEWART
Deputy Solicitor General
JENNY C. ELLICKSON
*Assistant to the Solicitor
General*
MARK R. FREEMAN
MELISSA N. PATTERSON
JAMES Y. XI
Attorneys

MAY 2019