

No.

IN THE
Supreme Court of the United States

COMCAST CABLE COMMUNICATIONS, LLC,
Petitioner,

v.

PROMPTU SYSTEMS CORPORATION,
AND ANDREW HIRSHFELD, PERFORMING THE
FUNCTIONS AND DUTIES OF THE DIRECTOR,
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**

PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

Whether administrative patent judges are “principal” or “inferior” Officers of the United States within the meaning of the Appointments Clause.

PARTIES TO THE PROCEEDING BELOW

Petitioner Comcast Cable Communications, LLC, was the petitioner in proceedings before the Patent Trial and Appeal Board and the appellant in the court of appeals in Nos. 2019-1947 & 2019-1948 (consolidated) and 2019-2287 & 2019-2288 (consolidated).

Respondent Promptu Systems Corporation was the patent owner in proceedings before the Patent Trial and Appeal Board and the appellee in the court of appeals in Nos. 2019-1947 & 2019-1948 (consolidated) and 2019-2287 & 2019-2288 (consolidated).

Respondent Andrew Hirshfeld, Performing the Functions and Duties of the Director of the United States Patent and Trademark Office, was an intervenor in the court of appeals in Nos. 2019-1947 & 2019-1948 (consolidated) and 2019-2287 & 2019-2288 (consolidated).

RULE 29.6 STATEMENT

Pursuant to this Court's Rule 29.6, petitioner states that Comcast Cable Communications, LLC, is a wholly owned, indirect subsidiary of Comcast Corporation and no other publicly held corporation owns 10% or more of the stock of petitioner.

RELATED PROCEEDINGS

The following proceedings are directly related to this case within the meaning of Rule 14.1(b)(iii):

- *Comcast Cable Commc'ns, LLC v. Promptu Sys. Corp.*, Nos. 2019-1947 & 2019-1948 (consolidated) (Fed. Cir.), judgment entered on January 4, 2021;
- *Comcast Cable Commc'ns, LLC v. Promptu Sys. Corp.*, Nos. 2019-2287 & 2019-2288 (consolidated) (Fed. Cir.), judgment entered on January 4, 2021;
- *Comcast Cable Commc'ns, LLC v. Promptu Sys. Corp.*, Case IPR2018-00340 (P.T.A.B), final written decision entered on March 29, 2019;
- *Comcast Cable Commc'ns, LLC v. Promptu Sys. Corp.*, Case IPR2018-00341 (P.T.A.B), final written decision entered on March 29, 2019;
- *Comcast Cable Commc'ns, LLC v. Promptu Sys. Corp.*, Case IPR2018-00344 (P.T.A.B), final written decision entered on June 28, 2019; and
- *Comcast Cable Commc'ns, LLC v. Promptu Sys. Corp.*, Case IPR2018-00345 (P.T.A.B), final written decision entered on June 28, 2019.

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PETITION FOR A WRIT OF CERTIORARI

Comcast Cable Communications, LLC, respectfully petitions for a writ of certiorari to review the judgments of the United States Court of Appeals for the Federal Circuit in these two cases. Pursuant to this Court's Rule 12.4, Comcast is filing a "single petition for a writ of certiorari" because the judgments "sought to be reviewed" are from "the same court and involve identical or closely related questions." Sup. Ct. R. 12.4. As explained further below, Comcast respectfully submits that this petition should be held pending the disposition of *United States v. Arthrex, Inc.* (U.S. No. 19-1434). Comcast has also separately filed a petition for a writ of certiorari in two different cases asking that its petition be held pending the disposition of *Arthrex*. Pet. for Cert. 6, *Comcast Cable Commc'ns, LLC v. Promptu Sys. Corp.*, No. 20-92 (U.S. filed July 24, 2020). The government has separately filed a petition for a writ of certiorari asking that its petition also be held pending the disposition of *Arthrex*. Pet. for Cert. 27, *United States v. Eugene H. Luoma*, No. 20-74 (U.S. filed July 23, 2020). These petitions were distributed for conference on December 4, 2020.

OPINIONS BELOW

The opinion of the court of appeals in Nos. 2019-1947 & 2019-1948 (consolidated) (Pet. App. 1a), and the final written decisions of the Patent Trial and Appeal Board in those inter partes review cases (Pet. App. 16a & 62a), are unreported.

The opinion of the court of appeals in Nos. 2019-2287 & 2019-2288 (consolidated) (Pet. App. 7a), and the final written decisions of the Patent

Trial and Appeal Board in those inter partes review cases (Pet. App. 102a & 142a), are unreported.

JURISDICTION

The court of appeals entered its judgments on January 4, 2021. Pet. App. 1a & 7a. The Court's March 19, 2020 order extended the deadline for filing a petition for a writ of certiorari in these cases to June 3, 2021. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

CONSTITUTIONAL PROVISION INVOLVED

The Appointments Clause is reproduced in the Appendix at 183a.

STATEMENT

The Patent Trial and Appeal Board (Board) entered final written decisions that Comcast failed to prove that certain claims of U.S. Patent No. 7,260,538 (the '538 patent) are unpatentable and failed to prove that certain other claims of U.S. Patent No. 7,047,196 (the '196 patent) are unpatentable. While Comcast's appeals of those decisions were pending in the Federal Circuit, the court of appeals held in *Arthrex, Inc. v. Smith & Nephew, Inc.*, that the Board's administrative patent judges (APJs) are principal Officers and, therefore, their appointment by the Secretary of Commerce pursuant to congressional directive violates the Appointments Clause. 941 F.3d 1320, 1335 (Fed. Cir. 2019). In its opening briefs, Comcast presented an Appointments Clause challenge and asked the court of appeals to vacate the Board's final written decisions and remand in light of *Arthrex*. The Federal Circuit did not address Comcast's constitutional challenge.

On the merits, the Federal Circuit affirmed both of the Board's decisions concerning the '538 patent and affirmed one decision and vacated and remanded one decision concerning the '196 patent.

1. Petitioner Comcast Cable Communications, LLC, is one of the largest suppliers of cable television programming in the United States. Comcast offers, among many other things, a voice recognition feature through its cable television service. The '538 and '196 patents, which are owned by respondent Promptu Systems Corporation, relate to voice-controlled television and other video services. *See, e.g.*, Pet. App. 18a–19a; *id.* at 104a–107a.

In December 2016, Promptu sued Comcast in the U.S. District Court for the Eastern District of Pennsylvania. *See Promptu Sys. Corp. v. Comcast Corp.*, No. 16-cv-6516 (E.D. Pa. filed Dec. 19, 2016). In December 2017, Comcast filed four inter partes review (IPR) petitions timely challenging claims 1–7, 17–24, 33–35, 37, and 40–41 of the '538 patent and claims 1, 2, 4–6, 12–15, 17–19, 25–28, 30–32, 38–42, 53–55, 61, 62, and 64–66 of the '196 patent. Pet. App. 2a; *id.* at 8a. The Director of the United States Patent and Trademark Office (USPTO) instituted review of the challenged claims and designated the same panel of three APJs to preside over each of the four review proceedings. *See id.* at 16a; *id.* at 62a; *id.* at 102a; *id.* at 142a. The panel issued final written decisions in favor of Promptu in each IPR proceeding. *Id.* at 60a; *id.* at 100a; *id.* at 139a; *id.* at 181a. The Board thus found that Comcast failed to show that any of the challenged claims are unpatentable.

In December 2017 and April 2018, Comcast also timely sought IPR and covered business method (CBM) review of a related patent asserted by Promptu

in the Pennsylvania litigation (U.S. Pat. No. RE44,326). In those proceedings, the Board found all challenged claims of the '326 patent unpatentable. *Comcast Cable Commc'ns, LLC v. Promptu Sys. Corp.*, Case IPR2018-00342, Paper 54 (P.T.A.B. July 18, 2019) (final written decision); *Comcast Cable Commc'ns, LLC v. Promptu Sys. Corp.*, Case IPR2018-00343, Paper 56 (P.T.A.B. July 18, 2019) (final written decision); *Comcast Cable Commc'ns, LLC v. Promptu Sys. Corp.*, Case CBM2018-00034, Paper 31 (P.T.A.B. Oct. 7, 2019) (final written decision).

2. Comcast timely appealed the Board's two decisions regarding the '538 patent, which the Federal Circuit consolidated, C.A. Dkt. 22 (No. 2019-1947), and the Board's two decisions regarding the '196 patent, which the Federal Circuit also consolidated, C.A. Dkt. 10 (No. 2019-2287).

While Comcast's appeals were pending, the Federal Circuit held in *Arthrex* that APJs are principal Officers and, therefore, their appointment by the Secretary of Commerce pursuant to congressional directive violates the Appointments Clause. 941 F.3d at 1335. As a remedy in that case, the court of appeals vacated the Board's final written decision and remanded for a "new hearing" before a newly designated panel of APJs. *Id.* at 1338–40 (citing *Lucia v. SEC*, 138 S. Ct. 2044, 2055 (2018)). The panel "limited" its holding to cases "where litigants present an Appointments Clause challenge on appeal." *Id.* at 1340. The court of appeals subsequently explained that litigants must present such challenges in their opening briefs or in motions filed prior to their opening briefs. See *Customedia Techs., LLC v. Dish Network Corp.*, 941 F.3d 1174, 1175 (Fed. Cir. 2019).

In its opening brief in both the '538 and the '196 patent appeals, Comcast presented an Appointments Clause challenge and asked the court of appeals to vacate the Board's final written decisions and remand in light of *Arthrex*. C.A. Dkt. 26 (No. 2019-1947); C.A. Dkt. 18 (No. 2019-2287). While Comcast maintained that *Arthrex* was wrongly decided, it preserved the constitutional challenge in the event this Court were to affirm *Arthrex* and conclude that APJs are principal Officers.

The Federal Circuit did not address Comcast's constitutional challenge. Instead, the Federal Circuit decided both of Comcast's appeals on the merits—affirming both of the Board's decisions concerning the '538 patent and affirming one decision concerning the '196 patent while vacating the other decision on the '196 patent and remanding to the Board for further proceedings. *See* Pet. App. 1a–6a; *id.* at 7a–15a.

By contrast, when Promptu appealed from the adverse Board decisions involving the '326 patent, the Federal Circuit vacated and remanded under *Arthrex* without reaching the merits. *Promptu Sys. Corp. v. Comcast Cable Commc'ns, LLC*, No. 2020-1253, 2020 WL 4544748, at *1 (Fed. Cir. Feb. 27, 2020), *cert. pending*, *Comcast Cable Commc'ns, LLC v. Promptu Sys. Corp.* (U.S. No. 20-92); *Promptu Sys. Corp. v. Comcast Cable Commc'ns, LLC*, No. 2019-2368 & 2019-2369, 2020 WL 4516080, at *1 (Fed. Cir. Feb. 27, 2020), *cert. pending*, *Comcast Cable Commc'ns, LLC v. Promptu Sys. Corp.* (U.S. No. 20-92).

3. All three parties in *Arthrex*—the United States, Smith & Nephew, and *Arthrex*—sought this Court's review, and the Court granted (and consolidated) the three petitions on October 13, 2020. *See United States v. Arthrex Inc.*, No. 19-1434; *Smith &*

Nephew, Inc. v. Arthrex, Inc., No. 19-1452; *Arthrex, Inc. v. Smith & Nephew, Inc.*, No. 19-1458. Several other petitions raising similar issues have also been filed in this Court. See, e.g., Pet. for Cert., *United States v. Eugene H. Luoma*, No. 20-74 (U.S. filed July 23, 2020); Pet. for Cert., *Comcast Cable Commc'ns, LLC v. Promptu Sys. Corp.*, No. 20-92 (U.S. filed July 24, 2020); Pet. for Cert., *Vilox Techs., LLC v. Iancu*, No. 20-271 (U.S. filed Aug. 26, 2020); Pet. for Cert., *Rovi Guides, Inc. v. Comcast Cable Commc'ns, LLC*, No. 20-414 (U.S. filed Sept. 21, 2020). These petitions are still pending and are presumably being held pending the disposition of *Arthrex*.

REASONS FOR GRANTING THE PETITION

The question presented by this petition—whether APJs are principal or inferior Officers—is directly presented in *United States v. Arthrex, Inc.* (U.S. No. 19-1434). Accordingly, this petition should be held pending final disposition of *Arthrex*, and then disposed of as appropriate. In the alternative, this petition should be granted.

1. This petition should be held pending the ultimate disposition of *Arthrex*, and then disposed of accordingly. See, e.g., *Emerson Elec. Co. v. Sipco, LLC*, No. 19-966, 2020 WL 3146672, at *1 (U.S. June 15, 2020) (petition raised a question closely related to that presented in *Thryv, Inc. v. Click-To-Call Techs., LP*, 140 S. Ct. 1367 (2020), and was held pending the Court's disposition in that case). If the Court affirms *Arthrex* across-the-board and holds that APJs are principal Officers and that the remedy of a new hearing is appropriate, even if an Appointments Clause challenge was not presented to the Board, the judgments in these cases would have to be vacated and the

cases remanded to the Federal Circuit with instructions to vacate the Board's decisions and remand for a new hearing before a properly appointed panel of APJs. On the other hand, if the Court concludes in *Arthrex* that APJs are inferior Officers, or that the remedy of a new hearing is not available where the constitutional challenge was not presented to the Board, then this petition should be denied.

2. Comcast has taken the position in other cases that *Arthrex* was wrongly decided by the Federal Circuit. See, e.g., Pet. for Cert. 8–10, *Comcast Cable Commc'ns, LLC v. Promptu Sys. Corp.*, No. 20-92 (U.S. filed July 24, 2020). Regardless of Comcast's position, however, this Court's decision in *Arthrex* will be binding on the Federal Circuit in these cases.

Although Comcast seeks a hold for *Arthrex* rather than plenary review, Comcast submits that the Federal Circuit erred in failing to address Comcast's constitutional challenge and in failing to vacate and remand the Board's decisions under *Arthrex*, as it has done for other litigants who presented such challenges in their opening briefs. Specifically, after addressing the patentability issues on the merits, the Federal Circuit said that it found Comcast's remaining arguments "unpersuasive." Pet. App. 6a; *id* at 13a. That presumably includes Comcast's constitutional challenge, which was presented to the court for decision but not explicitly addressed.

Comcast recognizes that the Federal Circuit has ruled that the remedy of a new hearing under *Arthrex* is available only to patent owners, not IPR petitioners. See *Ciena Corp. v. Oyster Optics, LLC*, 958 F.3d 1157, 1162 (Fed. Cir. 2020). But the court of appeals did not cite *Ciena* in this case, and thus the judgment cannot be affirmed (or the petition denied) on that basis even

if *Ciena* was correctly decided. In any event, IPR petitioners have the same rights and remedies as patent owners. See, e.g., *SAS Inst., Inc. v. ComplementSoft, LLC*, 825 F.3d 1341, 1351 (Fed. Cir. 2016) (“petitioners are not disinterested parties”; they “stand to lose significant rights in an instituted IPR proceeding because of the estoppel effects that trigger against them if the Board issues a final written decision”), *rev’d and remanded on other grounds sub nom. SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348 (2018).

If the APJs who decided these cases were not constitutionally appointed, that structural defect in the tribunal’s composition affects Comcast no less than Promptu. The court of appeals, therefore, should have vacated the Board’s decisions and remanded in light of its holding in *Arthrex*—just as it did in Promptu’s parallel appeals. *Promptu Sys. Corp. v. Comcast Cable Commc’ns, LLC*, No. 2020-1253, 2020 WL 4544748, at *1 (Fed. Cir. Feb. 27, 2020), *cert. pending*, *Comcast Cable Commc’ns, LLC v. Promptu Sys. Corp.* (U.S. No. 20-92); *Promptu Sys. Corp. v. Comcast Cable Commc’ns, LLC*, No. 2019-2368 & 2019-2369, 2020 WL 4516080, at *1 (Fed. Cir. Feb. 27, 2020), *cert. pending*, *Comcast Cable Commc’ns, LLC v. Promptu Sys. Corp.* (U.S. No. 20-92). At minimum, the Federal Circuit should consider the appropriate remedy in these cases in light of this Court’s disposition of *Arthrex*.

* * *

If *Arthrex* was correctly decided in both its substantive and remedial aspects, the panel in these cases erred in refusing to vacate and remand the Board’s decisions. This Court should therefore hold this petition pending ultimate disposition of *Arthrex*,

and then dispose of this petition in light of the Court's decision in that case.

CONCLUSION

The petition for a writ of certiorari should be held pending disposition of *United States v. Arthrex, Inc.* (U.S. No. 19-1434) and then disposed of accordingly. In the alternative, this petition should be granted.

Respectfully submitted.

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