

No. 20-1396

IN THE
Supreme Court of the United States

WALTER A. TORMASI,

Petitioner,

v.

WESTERN DIGITAL CORPORATION,

Respondent.

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

BRIEF IN OPPOSITION

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QUESTION PRESENTED

Federal Rule of Civil Procedure 17(b)(1) states that an individual’s capacity to sue in federal court “is determined . . . by the law of the individual’s domicile.” Petitioner is an inmate in the New Jersey State Prison (“NJSP”) in Trenton, New Jersey. New Jersey inmates are governed by N.J.A.C. 10A:4 which is promulgated by the Department of Corrections (“DOC”) Commissioner pursuant to the Commissioner’s statutory rule-making authority. *See* N.J.A.C. 10A:4, Chapter Notes (citing N.J.S.A. §§ 30:1B-6 and 30:1B-10 as “Statutory Authority”). Under N.J.A.C. 10A:4-4.1 (a)(3)(xix)(.705) (the “no business” rule), it is a “prohibited act[]” for an inmate to “commenc[e] or operat[e] a business or group for profit . . . without the approval of the Administrator.”

The questions presented are:

1. Did the Federal Circuit correctly find that the patent infringement suit of Petitioner—an NJSP inmate who purported to assign a patent from a patent holding company to himself “to ensure” that it “remained enforceable, licensable, and sellable to the fullest extent possible” and so he could “personally benefit” from it—was in furtherance of his unauthorized patent monetization business and thus that the district court did not err in holding that under New Jersey’s “no business” rule Petitioner lacked the capacity to sue for patent infringement?

2. Should this Court consider questions of U.S. constitutional law arising under the First, Fifth and Fourteenth Amendments and federal law that Petitioner did not raise and expressly disavowed in the court below and which, therefore, the court below did not consider?

CORPORATE DISCLOSURE STATEMENT

Pursuant to Sup. Ct. R. 29.6, Respondent Western Digital Corporation states that it has no parent corporation and there is no publicly held company that owns 10% or more of Western Digital Corporation's stock.

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INTRODUCTION

The Federal Circuit’s decision finding that Petitioner’s – a New Jersey State Prison (“NJSP”) inmate – patent infringement suit was in furtherance of his unauthorized patent licensing and monetization business and thus prohibited by New Jersey’s “no business” rule, addresses a context-specific application of New Jersey state law in what is essentially a one-off case. *See* Pet. App.6a-11a. The Federal Circuit’s decision is of no real consequence to anyone except the particular litigants involved, a fact that is highlighted by the Federal Circuit’s designation of its decision as “non-precedential” (Pet. App.1a) and summary denial of the Petition for panel rehearing and rehearing *en banc*. Pet. App.20a-21a.

Moreover, the Federal Circuit found that Petitioner waived the primary argument of state law interpretation he now raises in his petition to this Court—whether New Jersey’s “no business” rule can limit an inmate’s capacity to sue. Pet. App.8a, n.7. The Federal Circuit therefore did not consider it, finding instead that Petitioner had “conceded that the no business rule may limit his capacity to sue.” *Id.* Thus, even were the Court inclined to depart from its normal practice of declining to review questions of state law interpretation, such review would not be warranted here.

Petitioner speculates that the Federal Circuit’s decision will have far-reaching and “dangerous” consequences (Pet. 11-12) but relies on nothing other than his own hyperbole to support this. Petitioner’s argument is belied by his concessions in his Federal Circuit briefs that “inmate inventors are rare” (Pet. App.170a) and “prisoners lack constitutional authority to conduct businesses or file patent-infringement lawsuits.” Tormasi Fed. Cir. Reply at

15.¹ And Petitioner identifies no similar cases apart from his own prior case, *Tormasi v. Hayman*, 443 Fed. Appx. 742 (3d Cir. 2011) (“Tormasi III”), and an Alabama district court case citing Tormasi III, both of which held that prison officials’ actions— taken pursuant to the prisons’ “no business” rules – that prevented inmates from pursuing patents did not violate the inmates’ constitutional rights. Pet. 11-12 (citing *Youngblood v. Ala. Dep’t. of Corr.*, No. 2:15-cv-214, 2018 U.S. Dist. LEXIS 37371 (M.D.Ala. Mar. 6, 2018)).

The bulk of the Petition is devoted to presenting a maze of constitutional arguments and a federal preemption argument that Petitioner did not make on appeal to the Federal Circuit, and which he explicitly disavowed or abandoned. *See, e.g.*, Tormasi Fed. Cir. Reply at 15-16 (“[*JLewis v. Casey*, 518 U.S. 343 (1996), and [Tormasi III] dealt with the contours of the First, Fifth, and Fourteenth Amendments . . . Such Amendments are not at issue here.”); *Id.* at 16 (“It is therefore irrelevant whether Tormasi’s filing of his patent-infringement action was protected by the United States Constitution”); Pet. App.8a-9a, n.7 (Federal Circuit finding that Petitioner “abandon[ed] his constitutional argument” on appeal.) In any event, Petitioner’s constitutional and federal statutory arguments –which disregard Petitioner’s status as an NJSP inmate who has no liberty or property interest in operating a business while incarcerated – are without merit.

Petitioner identifies no conflict with this Court’s precedent and no conflict among the circuit courts that

1. “Tormasi Fed. Cir. Reply” refers to Reply Brief on Behalf of Appellant Walter A. Tormasi, Dkt. 30 in Federal Circuit Case No. 2020-1265.

would warrant this Court’s exercise of its discretion to review the Federal Circuit’s decision. Petitioner is simply dissatisfied with the Federal Circuit’s (perfectly correct) conclusions that his patent infringement suit was in furtherance of his unauthorized business activities, and thus he lacked the capacity to sue for infringement. The Federal Circuit’s decision should come as no surprise to Petitioner—he has spent over a decade attempting to run an unauthorized patent monetization business from prison, and has been told by prison officials, a New Jersey federal district court and the Third Circuit that he has no right to do so.

The Petition should be denied.

STATEMENT OF THE CASE

A. Petitioner Is Prohibited From Engaging In Business Activities Absent the Prison Administrator’s Authorization

Federal Rule of Civil Procedure 17(b)(1) provides that an individual’s capacity to sue in federal court “is determined . . . by the law of the individual’s domicile.” Petitioner is an NJSP inmate where he has been incarcerated since 2000. New Jersey inmates are governed by N.J.A.C. 10A:4 which is promulgated by the Department of Corrections (“DOC”) Commissioner pursuant to the Commissioner’s statutory rule-making authority. *See* N.J.A.C. 10A:4, Chapter Notes (citing N.J.S.A. §§ 30:1B-6 and 30:1B-10 as “Statutory Authority”). Under N.J.A.C. 10A:4-4.1 (a)(3) (xix)(.705) (Pet. App. 115a, 118a) (the “no business” rule)²,

2. In the latest version of New Jersey’s Administrative Code governing inmates, the “no-business” rule is codified at N.J.A.C. § 10A:4-4.1(a)(3)(xviii) (May 17, 2021).

it is a “prohibited act[]” for an inmate to “commenc[e] or operat[e] a business or group for profit . . . without the approval of the Administrator.”

B. In 2007, Pursuant to the “No-Business” Rule, Prison Officials Seized as Contraband Petitioner’s Patent Documents

While incarcerated, Petitioner filed for and was issued U.S. Patent 7,324,301 (“the ’301 Patent”) which he assigned to Advanced Data Solutions Corp. (“ADS”)—an intellectual property holding company that he allegedly founded and for which he allegedly appointed himself to serve in a variety of executive roles. Pet. App.3a, 321a-322a. In spring 2007, prison officials confiscated as contraband documents in Petitioner’s possession – including corporate paperwork, the ’301 Patent’s prosecution history and an unfiled provisional patent application – pursuant to NJSP’s “no-business” rule. Pet. App.322a; *Tormasi v. Hayman*, Civil Action No. 08-5886 (JAP), 2009 U.S. Dist. LEXIS 50560, at *1-4 (D.N.J. June 15, 2009) (“Tormasi I”)³. NJSP warned him “explicitly and unequivocally” that “continued involvement with ADS matters” would “subject[] [him] to further disciplinary action.” Pet. App. 323a, *see also* Pet. App4a.

C. Petitioner’s Prior Proceedings in New Jersey District Court and the Third Circuit

Petitioner subsequently filed a complaint in New Jersey federal district court under 42 U.S.C. § 1983 on behalf of

3. Tormasi I appears in Federal Circuit Case No. 20-1265, Dkt. 26, at SAppx. 190-197.

himself and ADS alleging various constitutional rights violations stemming from the seizure of the documents. *Tormasi I*, at *1-5. Petitioner alleged *inter alia*: (1) a violation of his constitutional right to access the courts, arguing that the confiscation of his patent documents rendered him and ADS unable to enforce their patent rights by filing patent infringement actions; and (2) the confiscation of the unfiled provisional application rendered Petitioner unable to proceed with patent prosecution before the U.S. Patent and Trademark Office (“USPTO”) thereby denying him his right of access to the USPTO and his right to just compensation for the taking of property under the Fifth and Fourteenth Amendments. *Id.* at *4.

The New Jersey court dismissed Petitioner’s claims made on behalf of ADS noting that a corporation may appear in federal court only through licensed counsel (*id.* at *11-12), and found that Petitioner had no state or federal constitutional right to conduct a business from prison, and in fact was prohibited from doing so absent authorization from the prison Administrator. *Id.* at *20-24 (citing N.J.A.C. 10A:4-4.1 .705)). The court held that Petitioner’s “Complaint fail[ed] to state a claim with respect to [Petitioner’s] desire to pursue patent violation litigation, as impairment of the capacity to litigate with respect to personal business interests is ‘simply one of the incidental (and perfectly constitutional) consequences of conviction and incarceration.’” *Id.* at *14-15 (quoting *Lewis*, 518 U.S. at 355); *see also Tormasi v. Hayman*, Civil Action No. 08-5886 (JAP), 2011 U.S. Dist. LEXIS 25849, at *16-17 (D.N.J. Mar. 14, 2011) (“*Tormasi II*”).⁴

4. *Tormasi II* appears in Federal Circuit Case No. 20-1265, Dkt. 26, at SAppx. 242-252.

Petitioner filed an amended complaint, which was also dismissed in relevant part (*see* Tormasi II at *9-17, 28-34) and Petitioner subsequently appealed the New Jersey district court’s decision concerning the seizure of his unfiled patent application to the Third Circuit. *See* Tormasi III at 744-45.⁵ The Third Circuit affirmed the district court’s decision finding that, while submission of a patent application may not involve a business activity in all circumstances, Petitioner’s “intentions regarding the unfiled patent application qualified under the regulation as ‘commencing or operating a business or group for profit.’” *Id.* at 745 (citing *Jerry-El v. Beard*, 419 Fed. Appx. 260 (3d Cir. 2011)). The Third Circuit thus held prison officials’ “confiscation of the unfiled patent application did not violate [Petitioner’s] statutory or constitutional rights.” *Id.*

D. Petitioner’s Alleged Assignments of the ’301 Patent from An Intellectual Property Holding Company to Himself

Following the seizure of his patent documents, Petitioner continued his involvement with ADS by executing a corporate resolution that contingently transferred the application for the ’301 Patent (“the ’878 application”) from ADS to himself, in June 2007. Pet. App.4a, 323a-324a, 337a-338a, 340a. Petitioner explained that the purpose of the contingent transfer was “to ensure that my intellectual property remained enforceable, licensable, and sellable to the fullest extent possible.” Pet. App.323a, *see also* Pet. App.4a.

5. Tormasi III appears in Federal Circuit Case No. 20-1265, Dkt. 26, at SAppx. 282-286.

In late 2009, having been barred from filing suit on behalf of ADS and with ADS in an “inoperative and void” status for non-payment of taxes, Petitioner, while still incarcerated, purported to direct ADS to adopt a corporate resolution to assign the ’301 Patent to himself. Pet. App.4a, 325a, 342a, 344a. Petitioner asserted that the purpose of the assignment was to allow Petitioner “to personally pursue, and to personally benefit from, an infringement action against [Respondent] and others.” Pet. App.325a; *see also* Pet. App.4a.

In January 2019, Petitioner again purported to cause ADS to assign the ’301 Patent to himself, asserting that the “purpose” of the 2019 assignment “was to provide up-to-date evidence confirming” his ownership of the ’301 Patent and authorization to sue for its infringement. Pet. App.326a-327a, 5a, 35a.

E. The Proceedings Below

1. Petitioner’s Suit in the Northern District of California

In February 2019, Petitioner filed a patent infringement suit against Respondent Western Digital Corporation (“WDC”) in federal district court in Northern California alleging infringement of the ’301 Patent. Respondent moved to dismiss the Complaint *inter alia* on the grounds that Petitioner lacked capacity to sue because the lawsuit was in furtherance of Petitioner’s unauthorized patent monetization business, and thus prohibited by New Jersey’s “no business” rule. Pet. App.62a-64a. On this point, Petitioner argued that his constitutional right of access to the courts under the First and Fourteenth

Amendments mandated that he be permitted to bring his patent infringement suit. Pet. App.85a-88a. The California court disagreed, finding that (1) Petitioner’s complaint alleging he was an “innovator and entrepreneur,” (2) Petitioner’s declaration “detailing that after being sanctioned for ‘operating [ADS] without administrative approval,’” he “did not cease such activities, but instead engaged in ‘ownership-transferring contingencies’ to continue as a sole proprietor,” and (3) Petitioner’s prior cases, “make[] clear that what underlies this case is his purported right to conduct business, not his access to the courts.” Pet. App.17a-18a.

The California court found that the fact that Petitioner filed the patent infringement suit “without ADS does not change this reality” as Petitioner was merely attempting to “monetiz[e] his patents and obtain[] \$5 billion in compensatory damages for patent infringement, in contravention of the New Jersey regulations.” Pet. App.18a. The court found that as an NJSP inmate Petitioner had no constitutional right to conduct business and held that in view of New Jersey’s “no-business” rule, Petitioner lacked the capacity to sue for patent infringement.⁶ Pet. App.18a-19a.

2. Petitioner’s Federal Circuit Appeal

On appeal to the Federal Circuit, Petitioner abandoned his arguments premised on alleged violations of his constitutional rights. *See* Pet. App.159a-167a; Pet. App.8a-

6. The California court also noted the limitations on an inmate’s right of access to the courts announced in *Lewis*. Pet. App.18a-19a (quoting *Lewis*, 518 U.S. at 355).

9a, n.7. Instead, Petitioner argued for the first time the alleged “supremacy” of New Jersey’s capacity statute (N.J. Stat. § 2A:15-1) over prison regulations governing inmate conduct, an argument the Federal Circuit found he had waived by failing to make it in the district court. Pet. App.8a, n.7. The Federal Circuit found that Petitioner’s patent infringement action “merely repackages his previous business objectives as personal activities so he may sidestep the ‘no business’ regulation,” and since his actions were “a mere continuation of his prior business activities . . . as in Mr. Tormasi’s previous lawsuit, Mr. Tormasi’s characterization of his suit as personal, as opposed to related to business” was “without merit.” Pet. App.7a. The Federal Circuit found that Petitioner’s assertions that: (1) the 2007 contingent assignment of the ’301 Patent from ADS to himself was a “precautionary measure[] to ensure that [his] intellectual property remained *enforceable, licensable, and sellable to the fullest extent possible*”; and (2) the purpose of one of his patent assignments was to permit him to “personally benefit from[] an infringement action against WDC and other entities,” evidenced “business actions purely to preserve the commercial value of his intellectual property” and showed that his “patent infringement suit [was] in furtherance of operating an intellectual property business for profit” Pet. App.9a-10a (emphasis in original).

The Federal Circuit found that Petitioner’s patent infringement suit was “therefore, prohibited under the ‘no business’ rule” (Pet. App.10a), and held that “the District Court did not err when it determined that Mr. Tormasi lacked the capacity to bring this suit for patent infringement.” Pet. App.10a-11a.

Petitioner filed petitions in the Federal Circuit for a panel rehearing and rehearing *en banc*, both of which were summarily denied. Pet. App.20a-21a.

REASONS FOR DENYING THE PETITION

A. The Case Presents No Issues of National Importance

Petitioner urges that the Federal Circuit wrongly interpreted New Jersey’s “no business” rule as limiting Petitioner’s capacity to sue for patent infringement, and wrongly found that Petitioner’s patent infringement suit was in furtherance of his unauthorized patent monetization business. Pet. 5-9. Petitioner’s argument in this regard merely raises an isolated issue of New Jersey state law interpretation in the unusual circumstance where a New Jersey inmate attempts to use the federal courts in furtherance of committing a prohibited act—*i.e.*, operating an unauthorized business in violation of the prison’s “no business” rule.

The Federal Circuit’s decision is thus of no real consequence to anyone except the particular litigants involved, a fact that is highlighted by the Federal Circuit’s designation of its decision as “non-precedential” (Pet. App.1a) and summary denial of Petitioner’s petitions for panel rehearing and rehearing *en banc*. Pet. App.20a-21a. Petitioner admits that “inmate inventors are rare” (Pet. App.170a), and “prisoners lack constitutional authority to conduct businesses or file patent-infringement lawsuits” (Tormasi Fed. Cir. Reply at 15), and fails to demonstrate that this case gives rise to any issues other than Petitioner’s dissatisfaction with the Federal Circuit’s interpretation and application of New Jersey state law and factual findings specific to his case.

Moreover, the Federal Circuit found that Petitioner waived his lead argument on this point. Petitioner concedes that under Federal Rule of Civil Procedure (“FRCP”) 17(b), Petitioner’s capacity to sue is determined by New Jersey law, and acknowledges that as a New Jersey inmate he is “bound” by New Jersey’s code governing inmate conduct. Pet. 5. Petitioner nevertheless argues that the “no business rule” codified in N.J.A.C. § 10A:4-4.1(a)(3)(xix) cannot limit the scope of New Jersey’s capacity statute (N.J.S.A. § 2A:15-1) for inmates. Pet. 5-7. Petitioner, however, did not raise this argument in the California district court. The Federal Circuit thus found that Petitioner had waived it and had already “conceded that the no business rule may limit his capacity to sue.” Pet. App.8a, n.7.

Petitioner suggests that the Federal Circuit’s factual finding that Petitioner’s patent infringement suit was part and parcel of his patent monetization business merits review. Pet. 7-9. The Federal Circuit’s finding, however, is limited to Petitioner’s specific circumstances and does not stand for any broader proposition. Pet. App.9a-10a. Petitioner tacitly admits the circumstantial nature of the inquiry with his citation to *Jerry*, 419 Fed. Appx. 260, which Petitioner asserts (albeit wrongly) is the “only authority” to have “evaluated a similar question to the one-at-hand. . .” Pet. 7. In *Jerry*, the Third Circuit found that – on the specific facts presented – an inmate’s efforts to obtain copyright protection for his children’s book did not “necessarily constitute[] engaging in a business activity.” 419 Fed. Appx. at 263.

Petitioner’s own prior case *also* before the Third Circuit – Tormasi III – which post-dates *Jerry* further demonstrates the fact-based nature of the inquiry. In

Tormasi III, the Third Circuit acknowledged its decision in *Jerry*, and “generally agree[d] that the submission of a patent application does not involve a business activity in all circumstances,” but found that in Petitioner’s case, Petitioner’s “*intentions*” concerning his unfiled patent application “qualified under the regulation as ‘commencing or operating a business or group for profit,’” and thus prison official’s seizure of the application (which precluded him from pursuing patent protection in the USPTO) “did not violate his statutory or constitutional rights.” Tormasi III at 745 (citing *Jerry*, 419 Fed. Appx. 260) (emphasis added).⁷

Petitioner urges that review of the Federal Circuit’s decision is important because it presents “dangerous authority” and “a slippery slope.” Pet. 11-12. The supposed dangers Petitioner hypothesizes, however, are simply the consequences of prohibitions on prisoners running businesses while incarcerated, something Petitioner admits he does not have the right to do. *See* Tormasi Fed. Cir. Reply at 15 (“Tormasi concedes that prisoners lack constitutional authority to conduct businesses”). Indeed, “[l]awful incarceration brings about the necessary withdrawal or limitation of many privileges and rights, a retraction justified by the considerations underlying our

7. Petitioner chastises the Federal Circuit for what Petitioner claims was the court’s failure to follow the Third Circuit’s reasoning in *Jerry*. Pet. 8-9. *Jerry*, however, is designated “not precedential,” and the Federal Circuit’s decision cites extensively to the Third Circuit’s Tormasi III decision “to demonstrate” that Petitioner’s patent infringement suit in California “is in furtherance of his intellectual property business and that business violates the ‘no business’ rule.” Pet. App.10a, n.8 (citing Tormasi III at 745); *see also* Pet. App.9a.

penal system.” *Stroud v. Swope*, 187 F.2d 850, 851 (9th Cir. 1951) (quoting *Price v. Johnston*, 334 U.S. 266, 285 (1948)). The inability to run a business while incarcerated is one such limitation. *See, e.g., French v. Butterworth*, 614 F.2d 23, 24 (1st Cir. 1980) (“a prisoner has no recognized right to conduct a business while incarcerated”).

In any event, Petitioner cites nothing to suggest that the Federal Circuit’s decision will have the outcomes Petitioner claims. Petitioner cites only two cases to support this argument, one of which is *Petitioner’s* own prior case before the Third Circuit – *Tormasi III* – discussed above. The second is an Alabama district court case where the court, citing *Tormasi III* (not the Federal Circuit’s decision at-issue here), concluded that an inmate’s attempt to obtain a patent was in furtherance of an unauthorized business and thus prison officials’ actions preventing him from doing so did not violate the inmate’s First Amendment rights. Pet. 11-12 (citing *Youngblood*, 2018 U.S. Dist. LEXIS 37371, at *23-28).

Petitioner has made no showing of a conflict with the Court’s precedent or any split among the circuit courts on this issue that would warrant the Court’s review of the Federal Circuit’s decision. *Ex parte Davenport*, cited by Petitioner (Pet. 7), has nothing to do with an inmate’s (or anyone else’s) capacity to sue, but rather involved a motion for a mandamus to permit a defendant to plead a defense of “tender” in addition to “non est factum” in a suit on a custom house bond for the payment of duties. 31 U.S. 661, 663-64 (1832). *Central of G.R. Co. v. Wright* (Pet. 7), is likewise entirely off-point involving “writs of error to the Supreme Court of the State of Georgia, in suits brought to enjoin the collection of certain taxes” in which capacity

to sue is not mentioned. 207 U.S. 127, 131 (1907). *Ross v. Blake*, 136 S. Ct. 1850 (2016), which Petitioner quotes out of context (Pet. 9), addressed the Prison Litigation Reform Act of 1995 (“PLRA”), something that is not at issue here.

Fundamentally, the Federal Circuit’s determination that Petitioner’s patent infringement suit was in furtherance of his unauthorized patent monetization business was based on sound reasoning. *See* Statement of the Case, Section E.2, *supra*. Furthermore, the Federal Circuit properly concluded that NJSP’s “no-business” rule limited his capacity to sue. A contrary result would require that the federal courts be complicit in Petitioner’s on-going violation of prison regulations and commission of prohibited acts.

B. Petitioner Did Not Raise and Expressly Disavowed or Abandoned Arguments Based on the U.S. Constitution and Federal Preemption

The Petition asks the Court to grant certiorari to review issues under the First, Fifth and Fourteenth Amendment, as well as purported issues of federal law, including federal preemption. (Pet. 9-29). Petitioner failed to raise any of these arguments in the Federal Circuit; instead, he expressly disavowed them. While Petitioner raised a First and Fourteenth Amendment right of access to the courts argument in the California district court (Pet. App.85a-88a), as the Federal Circuit noted, Petitioner “abandon[ed] his constitutional argument” on appeal. Pet. App.8a-9a, n.7; *see also* Pet. App.159a-167a. Accordingly, the Petition should be denied for the further reason that on appeal Petitioner did not raise and the Federal Circuit therefore did not address any of the

myriad of constitutional and federal statutory issues that make up the bulk of Petitioner’s petition to this Court.

Petitioner’s appeal to the Federal Circuit on the capacity issue⁸ – the only issue raised in the Petition – was limited to the question of whether Petitioner had the capacity to sue under FRCP 17(b). Since FCRP 17(b) relegates to state law the determination of whether Petitioner had the capacity to sue, the only issues raised were those of New Jersey state law interpretation, and the question of whether, under the facts of this case, Petitioner’s patent infringement suit was in furtherance of his unauthorized patent monetization business. Petitioner’s briefing to the Federal Circuit makes this clear. *See* Pet. App.130a (“Another issue in this appeal (Point II) is whether Tormasi has requisite suing capacity under N.J. Stat. Ann. § 2A:15-1 and whether prison administrative regulations are capable of superseding the capacity-to-sue statute”); Pet. App.144a (“that is, whether Tormasi has requisite suing capacity”); *see also* Pet. App.159a-167a (arguing Petitioner had capacity to sue under New Jersey state law; not raising constitutional issues).

Moreover, Petitioner expressly waived and forcefully disavowed arguments based on federal constitutional rights, instead making clear that his Federal Circuit appeal was limited to his capacity to sue under New Jersey state law. In his reply brief to the Federal Circuit, Petitioner’s heading for his capacity argument (“Point II”) emphasized that capacity was an issue that “*must be determined*” under New Jersey state law, “*not by*

8. The other issue raised on appeal – standing – was not decided by the district court or Federal Circuit, and is not raised in the Petition.

whether Tormasi has the right to conduct business-related litigation under the United States Constitution.” See Tormasi Fed. Cir. Reply at 13. (emphasis added). And Petitioner expressly “concede[d] that prisoners lack constitutional authority to conduct businesses or file patent-infringement lawsuits.” Id. at 15. (emphasis added).

Although the Petition to this Court is based on the First, Fifth and Fourteenth Amendments, Petitioner emphasized to the Federal Circuit that his appeal was *not* based on those Amendments, stating, “[*Lewis v. Casey*, 518 U.S. 343 (1996), and [Tormasi III], dealt with the contours of the First, Fifth, and Fourteenth Amendments *Such Amendments are not at issue here.*” See Tormasi Fed. Cir. Reply at 15-16 (emphasis added). Petitioner further stressed that his Federal Circuit appeal was not based on any other provision of the Bill of Rights or U.S. Constitution but only on New Jersey state law. *Id.* at 16 (citing FRCP 17(b)(1)) (“[Tormasi’s suing capacity is determined by ‘the law of [his] domicile,’ not by the Bill of Rights or by other provisions of the United States Constitution”). Indeed, Petitioner urged “[t]he capacity-to-sue inquiry is extremely limited, relating solely to Tormasi’s personal attributes under state law” (*id.*), and deemed the federal constitutional issues “irrelevant.” *Id.* (“It is therefore irrelevant whether Tormasi’s filing of his patent-infringement action was protected by the United States Constitution. It is also irrelevant whether the anti-business rule was constitutionally permissible under *Turner v. Safley*, 482 U.S. 78 (1987)”).

Nowhere in his Federal Circuit briefing did Petitioner argue that the district court’s ruling ran afoul of his rights

under the U.S. Constitution. Nor did Petitioner raise the federal preemption argument he makes for the first time in his petition to this Court. *See* Pet. 9-11. Accordingly, the Federal Circuit’s decision does not address any of these issues.

This Court should decline to review Petitioner’s arguments attacking the Federal Circuit’s decision that were not raised in and not considered by the Federal Circuit. *E.g.*, *United States v. United Foods*, 533 U.S. 405, 417 (2001) (declining to review new substantive arguments attacking a judgment “when those arguments were not pressed in the court whose opinion we are reviewing, or at least passed upon by it.”); *Kennedy v. Plan Adm’r for Dupont Sav. and Inv. Plan*, 555 U.S. 285, 290 n.2 (2009) (Petitioner “did not raise this argument in the Court of Appeals, and we will not address it in the first instance.”).

1. The Federal Circuit’s Decision Does Not Raise Federal Preemption Issues

The Federal Circuit’s decision does not give rise to federal preemption issues as Petitioner contends (Pet. 9-11) because in determining Petitioner lacked the capacity to sue for patent infringement, the Federal Circuit applied the *federal* rules – *i.e.*, FRCP 17(b) – which relegates to state law the determination of Petitioner’s capacity to sue in federal court. Pet. App.6a-8a. Nor does the Federal Circuit’s decision establish a blanket prohibition on inmates obtaining patents or bringing patent infringement suits, “revoke[] patent protection” or dedicate Petitioner’s patent to public use as Petitioner asserts. (Pet. 2, 11, 16). Rather, the Federal Circuit’s decision is limited to Petitioner’s *current* circumstances as an NJSP inmate

who does not have the Administrator's authorization to operate a patent licensing and monetization business.⁹

Petitioner cites no conflict with this Court's precedent or circuit split on the issue. Instead, Petitioner cites inapposite cases holding that state law cannot bestow patent-like protection on innovations in a way that conflicts with the federal patent statute, a principle that is not at-issue here. Pet 9-11 (citing *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964) (state unfair competition law cannot impose liability for or prohibit the copying of an article which was not patented or copyrighted); *Bonito Boats v. Thunder Craft Boats*, 489 U.S. 141 (1989) (state law could not prohibit reverse engineering and copying of an unpatented hull design). Petitioner also cites *Haywood v. Drown*, 556 U.S. 729 (2009) which addresses the Supremacy Clause in the context of section 1983 actions, contains no discussion of a prisoner's capacity to sue, and is entirely off-point.

2. Petitioner's Violation of Due Process Argument is Meritless

Petitioner's arguments that his due process rights have been violated are likewise meritless and are not a basis for review by this Court. Petitioner variously characterizes the property "right" of which he has been

9. The Federal Circuit noted, "It is conceivable that Mr. Tormasi might, in the future, attain capacity to sue, but under the circumstances of this case, the District Court did not err in concluding that he does not presently possess that capacity." Pet. App.11a, n.9. Indeed, Petitioner could be in a different position were he paroled or should he obtain the Administrator's authorization to operate a patent monetization business.

deprived as the right to bring a patent infringement action, the right of access to the courts and the '301 Patent itself (Pet. 3, 12-13, 16), and frames the supposed due process violation as refusing to provide Petitioner the opportunity to present the merits of his patent infringement case. Pet. 14. But Petitioner has already conceded that “prisoners lack constitutional authority to . . . file patent-infringement lawsuits.” *See* Tormasi Fed. Cir. Reply at 15.

Moreover, the Federal Circuit’s decision does not give rise to a claim for impairment of Petitioner’s right to access the courts as Petitioner now contends. This Court’s precedent holds that such a claim requires a showing of “actual injury,” but “the injury requirement is not satisfied by just any type of frustrated legal claim.” *Lewis*, 518 U.S. at 349, 354. In *Lewis*, the Court revisited its decision in *Bounds v. Smith*, 430 U.S. 817 (1977), and noted that “[n]early all of the access-to-courts cases in the *Bounds* line involved”: (1) inmates’ “direct appeals from the convictions for which they were incarcerated” or (2) “habeas petitions.” *Lewis*, 518 U.S. at 354 (citations omitted). *Lewis* further noted that the Court’s decision in *Wolff* “extended this universe of relevant claims *only slightly*, to ‘civil rights actions’ – *i.e.*, actions under 42 U.S.C. § 1983 to vindicate ‘basic constitutional rights.’” *Id.* (quoting *Wolff v. McDonnell*, 418 U.S. 539, 579 (1974)) (emphasis added).

Thus, *Lewis* found that “*Bounds* does not guarantee inmates the wherewithal to transform themselves into litigating engines capable of filing everything from shareholder derivative actions to slip-and-fall claims,” and an inmate’s constitutional right of access to the courts is limited to suits “attack[ing] their sentences” or “conditions

of their confinement.” *Id.* at 355. “Impairment of any *other* litigating capacity is simply one of the incidental (and perfectly constitutional) consequences of conviction and incarceration.” *Id.* (emphasis in original).¹⁰

Petitioner’s argument that he has been deprived of the ’301 Patent (Pet. 14) or that it has been dedicated to public use (Pet. 2, 16), is simply untrue. While Respondent disputes that Petitioner owns the ’301 Patent, nothing in the Federal Circuit’s decision divested him of whatever ownership interest he may have in it. And, as discussed above, the Federal Circuit’s decision found only that in his current circumstances, Petitioner does not presently have the capacity to sue for infringement of the ’301 Patent. Pet. App.11a, n.9 (“It is conceivable that Mr. Tormasi might, in the future, attain capacity to sue”)

3. Petitioner Does Not Show That He Was Treated Differently From Similarly Situated Inmates or That the Federal Circuit’s Decision was Arbitrary

Petitioner’s “class of one” equal protection argument (Pet. 17-20) is likewise meritless and does not warrant review by this Court. Citing *Baxter v. Palmigiano*, 425 U.S. 308 (1976) (inmate actions brought pursuant to 42 U.S.C. § 1983) and *Moffat v. United States DOJ*, No. 09-12067-DJC, 2012 U.S. Dist. LEXIS 4194, at *8 (D.Mass. Jan. 12, 2012) (inmate’s FOIA request), Petitioner argues an equal protection violation because inmates

10. Notably, *Lewis* does not impose a “duty” on courts to remedy official interference with inmate claims of *any* nature, as Petitioner implies by quoting *Lewis* out of context. *See* Pet. 23.

have been permitted to pursue other causes of action that included *inter alia* prayers for monetary damages whereas Petitioner was barred from bringing his patent infringement suit. Pet. 17-18.

Baxter, however, involved inmate actions brought pursuant to 42 U.S.C. § 1983 alleging that prison disciplinary hearing procedures violated their Fourteenth Amendment due process rights. 425 U.S. at 310, 313. There, the Court addressed the scope of prisoners' rights – *e.g.*, right to counsel, right to call witnesses and cross-examine witnesses – at such hearings. *Id.* at 314-324. *Moffat* involved an inmate's FOIA request seeking evidence that he believed would “exonerate him from his conviction for first degree murder.” *Moffat v. United States DOJ*, 716 F.3d 244, 247 (1st Cir. 2013). In that case, the district court explicitly found the inmate had no “conceivable *commercial* interest” in making the FOIA request. *Moffat*, 2012 U.S. Dist. LEXIS 4194, at *5 (emphasis in original).

In contrast, Petitioner's patent infringement suit was found to be in furtherance of his unauthorized patent monetization business. Pet. App.9a-10a. Petitioner is in no sense “similarly situated” with the inmates in *Baxter* and *Moffat*, or inmates bringing lawsuits that are not in pursuit of inmates' personal business interests.¹¹ Nor was the Federal Circuit's decision arbitrary or lacking in a rational basis—the Federal Circuit applied New Jersey law as required by FRCP 17(b) to determine Petitioner

11. The cases cited in the Petition at p. 20 likewise involved inmates' challenges to their conditions of confinement, not lawsuits brought in furtherance of inmates' personal business interests.

lacked the capacity to sue (Pet. App.6a) and thus did not meet a threshold requirement for bringing suit in federal court. Pet. App.11a, n.10 The Federal Circuit’s holding was grounded in its conclusion that Petitioner’s patent infringement suit was in furtherance of his unauthorized patent monetization business, and thus prohibited under the no-business rule—a conclusion that was supported by sound reasoning. *See* Pet. App.9a-10a.

The Petition ultimately devolves into a discussion of the propriety of New Jersey’s “no business” rule. Pet. 18-20. That is not an issue here. Indeed, Petitioner has “concede[d] that prisoners lack constitutional authority to conduct businesses or file patent-infringement lawsuits” (Tormasi Fed. Cir. Reply at 15) and admitted that he “is not suggesting” that New Jersey’s “anti-business rule is invalid or unenforceable.”¹² Pet. App.166a.

12. Petitioner argues that the legitimate penological concerns underlying New Jersey’s “no business” rule articulated in *Tormasi II* – *e.g.*, that inmate businesses operations “would seriously burden operation of incoming and outgoing mail procedures” and “could result in the introduction of contraband into prisons” – do not apply in this case. Pet. 18-20. Not so. As WDC noted in briefing to the district court and the Federal Circuit, Petitioner was previously found to have attempted to “subvert the security and safety of the facility” by attempting to mail “fourteen legal briefs that had been hollowed out to create hidden compartments” that “can easily be used to traffic contraband to and from the facility.” Pet. App.63a-64a; *see also* Brief of Appellee, Federal Circuit Case No. 20-1265, Dkt. 25 at 39-40, n.3.

C. The Federal Circuit’s Decision is Not an Appropriate Vehicle for this Court to Address *Lewis*

Petitioner expends substantial pages discussing the Court’s decision in *Lewis*, and an inmate’s constitutional right of access to the courts, and, although unclear, appears to suggest that the Federal Circuit’s decision is an appropriate vehicle for the Court to clarify *Lewis*. Pet. 20-27. The Federal Circuit’s decision, however, did not address *Lewis* or its scope or rely on *Lewis* in any fashion—it does not mention *Lewis*. Nor did the Federal Circuit’s decision address an inmate’s constitutional right of access to the courts, except to note that Petitioner had “abandon[ed] his constitutional argument” on appeal. Pet. App.8a-9a, n.7. Moreover, Petitioner told the Federal Circuit that *Lewis* was irrelevant to the issues raised in his appeal (Tormasi Fed. Cir. Reply at 15-16), and asserts in the Petition that *Lewis* is “inapposite.” Pet. 28. The Federal Circuit’s decision is thus an entirely unsuitable vehicle for the Court to re-consider or clarify *Lewis* or otherwise address its scope.

In any event, Petitioner’s assertion that *Lewis* has “resulted in varying, inconsistent, and draconian applications of this case” (Pet. 21) is wrong and unsupported by the cases relied upon by Petitioner. The litany of cases cited or discussed by Petitioner that pre-date *Lewis* (Pet. 21-23, 25-26, fn. 6, 27-29) are entirely irrelevant to the question of how the circuit courts have subsequently interpreted or applied *Lewis*’ holding.

The cases cited by Petitioner that do address *Lewis* (Pet. 24-27) have uniformly and consistently found that to state a claim for a violation of the right of access to the

courts a prisoner must show “actual injury” — *i.e.*, the prisoner was frustrated or impeded in efforts to pursue a nonfrivolous legal claim concerning his conviction or his conditions of confinement. Petitioner relies on a post-*Lewis* decision from the Tenth Circuit to support his assertions that “[n]ot all circuits, however, agree that the constitutional right to access the courts is limited to the underlying conviction or conditions of confinement” (Pet. 25), and that *Lewis’s* interpretation is the subject of a conflict among the circuits. Pet. 25-27 (citing *Simkins v. Bruce*, 406 F.3d 1239 (10th Cir. 2005)). *Simkins*, however, supports neither of these propositions. In *Simkins*, an inmate alleged prison officials had impeded him from pursuing a federal civil rights action concerning conditions at a county jail where he had been incarcerated, an action that falls squarely within the ambit of those which *Lewis* held may give rise to a right of access claim. *Id.* at 1240-41. Thus, the question in *Simkins* was limited to whether the inmate had adequately pled that his ability to pursue his civil rights action had been hindered by prison officials; the court had no occasion to, and did not, address the *types* of impeded prisoner claims that may give rise to a claim for violation of the constitutional right to access the courts. *Id.* at 1243-44.

Indeed, in later-decided cases the Tenth Circuit articulated *Lewis’s* holding consistent with every other circuit court. *See, e.g., Gee v. Pacheco*, 627 F.3d 1178, 1191 (10th Cir. 2010) (citing *Lewis*, 518 U.S. at 351-55) (a claim for violation of the constitutional right to access the courts requires a prisoner to “demonstrate actual injury . . . that is, that the prisoner was frustrated or impeded in his efforts to pursue a nonfrivolous legal claim concerning his conviction or his conditions of confinement.”)

The *Knop* case on which Petitioner appears to rely for the proposition that the Sixth Circuit is somehow in conflict with other circuits regarding the scope and interpretation of *Lewis* (Pet. 26) was decided in 1992—four years prior to *Lewis. Knop v. Johnson*, 977 F.2d 996 (6th Cir. 1992). It is of no relevance to the Sixth Circuit’s interpretation of *Lewis*. Moreover, in *Thaddeus-X v. Blatter*, the Sixth Circuit sitting en banc addressed *Lewis* and expressly recognized that a prisoner’s right of access to the courts “is not a generalized ‘right to litigate’ but a carefully-bounded right,” and “extends to direct appeals, habeas corpus applications, and civil rights claims only.” 175 F.3d 378, 391 (6th Cir. 1999) (en banc) (quoting *Lewis*, 518 U.S. at 355).

Moreover, the *Clewis* court evinced no confusion about the types of actions that may give rise to a violation of a right of access to the courts claim as Petitioner claims. (Pet. 25-26). In remarking that “[a]lthough ‘the precise contours of a prisoner’s right of access to the courts remain somewhat obscure, the *Supreme Court has not extended this right to encompass more than the ability of an inmate to prepare and transmit a necessary legal document to a court,*” the *Clewis* court made clear that the “precise contours” to which it referred concerned the assistance to which prisoners are entitled, not the types of actions that give rise to a claim for a violation of an inmate’s right to access the courts. *Clewis v. Hirsch*, 700 Fed. Appx. 347, 348 (5th Cir. 2017) (citations and internal quotations omitted). Indeed, in suggesting that *Clewis* stands for something broader, Petitioner’s brief eliminates the italicized portion of the quote. Pet. 26. Notably, *Clewis* followed this remark with the unequivocal statement that inmates’ right of access to the courts “encompasses only

a reasonably adequate opportunity to file nonfrivolous legal claims challenging their convictions or conditions of confinement.” 700 Fed. Appx. at 348 (citation omitted). The *Earl* case on which Petitioner relies (Pet. 26) evinces no confusion about the types of cases that give rise to a claim for a violation of the right to access the courts. See *Earl v. Fabian*, 556 F.3d 717, 726-727 (8th Cir. 2009). There, the underlying action was a prisoner’s challenge to his conviction (*id.* at 719), and the court noted only that the constitutional basis of the right of access was “unsettled.” *Id.* at 726-27.

This Court’s decision in *Bruce v. Samuels*, 577 U.S. 82, 86 (2016) cited by Petitioner (Pet. 27), concerns prisoner proceedings *in forma pauperis* as codified in 28 U.S.C. § 1915 and has no bearing on the issues in this case. In an effort to show otherwise Petitioner misquotes 28 U.S.C. § 1915(b)(4) (*see* Pet. 27) by eliminating the italicized language from the statute which reads: “In no event shall a prisoner be prohibited from bringing a civil action *or appealing a civil or criminal judgment for the reason that the prisoner has no assets and no means by which to pay the initial partial filing fee.*” *Bruce*, 577 U.S. at 86 (quoting 28. U.S.C. § 1915(b)(4)) (emphasis added).

Petitioner proffers no justifiable basis for the Court to clarify its decision in *Lewis* or consider its application in this case; the Court should decline to do so.

CONCLUSION

For the foregoing reasons, the Petition for Writ of Certiorari should be denied.

Respectfully submitted,

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