

No. 20-1631

In The
Supreme Court of the United States

ANDREW HIRSHFELD, ACTING UNDER SECRETARY OF
COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR, U.S. PATENT AND TRADEMARK OFFICE,
Petitioner,

V.

IMPLICIT, LLC, ET AL.,
Respondents.

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

**RESPONDENT APPLE INC.'S
RESPONSE IN SUPPORT OF THE
PETITION FOR WRIT OF
CERTIORARI**

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Additional Captions Listed on Inside Cover

ANDREW HIRSHFELD, ACTING UNDER SECRETARY OF
COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR, U.S. PATENT AND TRADEMARK OFFICE,
PETITIONER

v.

TRANSTEX INC., ET AL.

ANDREW HIRSHFELD, ACTING UNDER SECRETARY OF
COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR, U.S. PATENT AND TRADEMARK OFFICE,
PETITIONER

v.

NEW VISION GAMING & DEVELOPMENT, INC., ET AL.

ANDREW HIRSHFELD, ACTING UNDER SECRETARY OF
COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR, U.S. PATENT AND TRADEMARK OFFICE,
PETITIONER

v.

UNILOC 2017 LLC, ET AL.

QUESTION PRESENTED

Whether, for purposes of the Appointments Clause, U.S. Const. art. II, § 2, cl. 2, administrative patent judges of the U.S. Patent and Trademark Office are principal officers who must be appointed by the President with the Senate's advice and consent, or "inferior Officers" whose appointment Congress has permissibly vested in a department head.

CORPORATE DISCLOSURE STATEMENT

Respondent Apple Inc. has no parent corporation. To the best of Respondent's knowledge and belief, no publicly held corporation owns 10% or more of Apple Inc.'s stock.

INTRODUCTION

Pursuant to Supreme Court Rule 12.6, Respondent Apple Inc. (“Apple”) files this brief in support of the government’s petition for a writ of certiorari.¹ As the petition explains, Apple was the appellee in one of two consolidated Federal Circuit appeals that were recently remanded to the Patent Trial and Appeal Board in light of the Federal Circuit’s decision in *Arthrex, Inc. v. Smith & Nephew, Inc.*, 941 F.3d 1320 (2020). *See* Pet. II; *see also* App. 13a-14a (remand order).

This Court has granted certiorari to review *Arthrex* and, if it ultimately reverses the Federal Circuit’s decision, the ruling will almost certainly require vacatur of the remand order in Apple’s appeal. Accordingly, Apple respectfully supports the government’s request to hold the petition until this Court has issued its judgment in *United States v. Arthrex, Inc.*, No. 19-1434, and the consolidated cases (Nos. 19-1452 and 19-1458), and then dispose of this case as appropriate in light of this Court’s decision in *Arthrex*.

STATEMENT

In December 2017, Apple filed a petition for *inter partes* review with the Patent Trial and Appeal Board (“PTAB”) challenging the patentability of several claims of U.S. Patent No. 7,092,671. Following briefing and oral argument, the PTAB declared the challenged claims unpatentable in a well-reasoned decision. *Apple Inc. v. Uniloc Luxembourg, S.A.*,

¹ Apple complied with Rule 12.6’s requirement of notice to all other parties on June 10, 2021, via an email that was sent to all counsel of record.

IPR2018-00282, Paper 30 (P.T.A.B. June 4, 2019). Uniloc 2017 LLC (“Uniloc”) filed a request for rehearing of the PTAB’s decision on July 1, 2019, which the PTAB denied on February 19, 2020. *Apple Inc. v. Uniloc 2017 LLC*, IPR2018-00282, Paper 32 (P.T.A.B. Feb. 19, 2020).

On April 2, 2020, Uniloc appealed the PTAB’s unpatentability rulings to the Federal Circuit, which consolidated the appeal with another appeal from an *inter partes* review pertaining to the same patent. *See Uniloc 2017 LLC v. Unified Patents, LLC*, No. 2020-1666 (Fed. Cir.); *Uniloc 2017 LLC v. Apple Inc.*, No. 2020-1667 (Fed. Cir.). At 11:10 p.m. on April 5, 2021, the day that Uniloc’s opening merits brief was due, Uniloc moved to remand the consolidated cases in light of the Federal Circuit’s ruling in *Arthrex* because the PTAB’s rulings had been issued by (in Uniloc’s view) an unconstitutionally appointed panel of administrative judges.

Apple and the government (which is an intervenor in the appeals) both opposed Uniloc’s eleventh-hour motion, arguing that the motion should be held until this Court issued its ruling on the merits. *See Apple’s Opp’n to Appellant’s Mot. to Vacate, Uniloc 2017 LLC v. Unified Patents, LLC, Apple Inc.*, Nos. 2020-1666, 2020-1667 (Fed. Cir. Apr. 29, 2021), ECF No. 35; Intervenor’s Opp’n to Appellant’s Mot. to Vacate, *Uniloc 2017 LLC* (Fed. Cir. Apr. 15, 2021), ECF No. 33. Over five weeks after Uniloc’s motion was filed, a Federal Circuit panel granted the motion in a short order. App. 13a-14a; *see also* Pet. 7-8.

On May 21, 2021, the government filed the instant petition for certiorari, which asks this Court to hold this case pending disposition of *Arthrex* and then

to dispose of the petition as appropriate in light of the Court's *Arthrex* ruling. This Court docketed the petition the same day, on May 21, 2021.

REASONS FOR GRANTING THE PETITION

Apple adopts Petitioner's argument section in full. *See* Pet. 8-9. For the reasons stated therein, the petition should be held and disposed of following the issuance of this Court's judgment in *Arthrex*.

CONCLUSION

The petition for a writ of certiorari should be held pending the Court's decision in *United States v. Arthrex, Inc.*, No. 19-1434, and the consolidated cases (Nos. 19-1452 and 19-1458), and then disposed of as appropriate in light of the Court's decision.

Respectfully submitted,

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