

No. 20-1700

In The
Supreme Court of the United States

ULTRATEC, INC.,
Petitioner,

v.

CAPTIONCALL, LLC, ET AL.

*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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QUESTIONS PRESENTED

I. Whether Congress’s decision to authorize inter partes review of patents issued before the America Invents Act’s effective date violates the Due Process Clause.

II. Whether the Federal Circuit’s issuance of “Rule 36” summary affirmances in appeals from proceedings before the U.S. Patent and Trademark Office is unlawful.

CORPORATE DISCLOSURE STATEMENT

The parent company of Respondent CaptionCall, LLC, is Sorenson Communications, LLC. CaptionCall and Sorenson are privately held companies, and thus no publicly-held entity owns 10% or more of its stock.

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INTRODUCTION

After pursuing multiple appeals from inter partes review conducted under the Leahy-Smith America Invents Act (AIA), Petitioner Ultratec, Inc. seeks review of two questions that this Court has declined to take up on numerous occasions and that Ultratec did not timely raise (or never has until now). This Court’s precedent leaves no doubt that authorizing inter partes review of pre-AIA patents was a reasonable congressional choice that comports with the Due Process Clause; indeed, erroneously granted patents (like Ultratec’s) have been subject to curative administrative reconsideration under the same substantive standards for decades. This Court’s precedent is equally clear that courts of appeals possess “wide latitude” in deciding whether to resolve cases through summary affirmance mechanisms like Federal Circuit Rule 36—a principle that 35 U.S.C. § 144 does not displace in the context of appeals arising out of the U.S. Patent and Trademark Office (PTO). If that were not enough, Ultratec waived its due process retroactivity argument by not advancing it during the previous round of appeals in this case, and Ultratec declined to contest the validity of Rule 36 even while disputing its case-specific application on rehearing in the instant appeals. This Court should deny the petition.

STATEMENT

A. Legal Framework

“For several decades, the Patent Office has *** possessed the authority to reexamine—and perhaps

cancel—a patent claim that it had previously allowed.” *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2137 (2016). In 1980, “Congress enacted a statute providing for ‘ex parte reexamination,’” which “c[ould] lead the Patent Office to cancel [a] patent (or some of its claims).” *Id.* Thereafter, “[i]n 1999 and 2002, Congress enacted statutes that established another, similar procedure, known as ‘inter partes reexamination,’” which “granted third parties greater opportunities to participate in the Patent Office’s reexamination proceedings as well as in any appeal of a Patent Office decision.” *Id.*

Most recently, in 2011, Congress enacted the AIA and created inter partes review by modifying the preexisting administrative procedure of inter partes reexamination. *Cuozzo*, 136 S. Ct. at 2137. Inter partes review “provides a challenger with [even] broader participation rights” and “creates within the Patent Office a Patent Trial and Appeal Board” that “conducts the proceedings, reaches a conclusion, and sets forth its reasons.” *Id.* The AIA’s inter partes review provisions took effect on September 16, 2012, and expressly “apply to any patent issued before, on, or after that effective date.” Pub. L. No. 112-29, § 6(c)(2)(A), 125 Stat. 284, 304.

The foregoing administrative proceedings share a common purpose: to allow the PTO to “correct[] prior agency error of issuing patents that should not have issued in the first place.” *Celgene Corp. v. Peter*, 931 F.3d 1342, 1361 (Fed. Cir. 2019) (citing *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1353 (2018)).

B. Procedural History

1. After Ultratec sued Respondent CaptionCall, LLC and its parent company for patent infringement in district court, CaptionCall sought inter partes review of eight Ultratec patents. Pet. App. 72-73. Based on a voluminous record, extensive briefing, and a hearing, the Board issued nine separate final written decisions holding all of the challenged patent claims either anticipated or obvious in light of a variety of prior art references. *Id.* at 72.

Ultratec appealed to the Federal Circuit, raising a multitude of expert testimony, claim construction, anticipation, obviousness, and constitutional claims. As relevant here, Ultratec argued that inter partes review caused a deprivation of its “constitutional rights to see the validity of the patents-at-issue adjudicated by a trial by jury in a court of the United States, with all of the due process protections associated with federal court litigation, thus violating Article III of the Constitution and the Fifth and Seventh Amendments.” Ultratec Opening Br. 89-93, No. 16-1706 (Fed. Cir.), ECF No. 65.

The Federal Circuit vacated the Board’s decisions on the narrow ground that the Board refused to admit and consider the testimony of CaptionCall’s expert from parallel district court proceedings for alleged inconsistencies. The Federal Circuit thus remanded the cases, with instructions to admit and consider that testimony. Pet. App. 86.

2. Finding the additional district court testimony to be consistent with the expert’s prior testimony and with the Board’s original conclusions, the Board

allowed its prior final written decisions to stand. Pet. App. 67. Ultratec again appealed to the Federal Circuit, renewing certain of its arguments, dropping others, and introducing new ones as well. In particular, Ultratec raised different constitutional arguments, including that application of inter partes review to its pre-AIA patents was impermissibly retroactive. Ultratec Opening Br. 83-84, No. 19-1998 (Fed. Cir.), ECF No. 38.

After holding oral argument (Pet. App. 119-156), the Federal Circuit summarily affirmed the Board's decision under Federal Circuit Rule 36. *Id.* at 1-6. Focusing on certain claim construction, anticipation, and obviousness arguments, Ultratec sought rehearing on the ground that a Rule 36 summary affirmance was not appropriate in the context of this case based on the Federal Circuit's own criteria. Ultratec Pet. for Reh'g 5-20, No. 19-1998 (Fed. Cir.), ECF No. 73. Ultratec did not argue, however, that the Rule 36 summary affirmance procedure violated the Patent Act or was otherwise unlawful. The Federal Circuit denied rehearing. Pet. App. 87-92.

REASONS FOR DENYING THE PETITION

Inter partes review of Ultratec's patents, even though issued prior to the enactment of the AIA, is rational and consistent with this Court's precedents. The same is true of the Federal Circuit's practice—common across the courts of appeals—of issuing Rule 36 summary affirmances. Both of those questions presented, moreover, have not been adequately preserved. Accordingly, this Court should deny certiorari—just as it has done several times before with respect to these same issues.

I. SUBJECTING PRE-AIA PATENTS TO INTER PARTES REVIEW DOES NOT VIOLATE DUE PROCESS

Ultratec first asserts that subjecting pre-AIA patents to inter partes review retroactively diminishes property rights, in violation of the Due Process Clause. The Due Process Clause, however, permits Congress’s rational choice.

A. Congress’s Retroactive Application Of Inter Partes Review Was Rational And Consistent With Longstanding Practice

Due process requirements are satisfied “simply by showing that the retroactive application of the legislation is itself justified by a rational legislative purpose.” *Pension Benefit Guar. Corp. v. R. A. Gray & Co.*, 467 U.S. 717, 730 (1984). Such a rational legislative purpose is “easily identified” here. *Id.* As this Court recently explained:

Sometimes *** bad patents slip through. Maybe the invention wasn’t novel, or maybe it was obvious all along, and the patent owner shouldn’t enjoy the special privileges it has received. To remedy these sorts of problems, Congress has long permitted parties to challenge the validity of patent claims in federal court. More recently, Congress has supplemented litigation with various administrative remedies.

SAS Inst., 138 S. Ct. at 1353 (citation omitted).

Those administrative remedies—first introduced more than 40 years ago in the form of ex parte

reexamination (pp. 1-2, *supra*)—have always been understood to provide a curative “second look at an earlier administrative grant of a patent.” *Cuozzo*, 136 S. Ct. at 2144; see *Fresenius USA, Inc. v. Baxter Int’l, Inc.*, 721 F.3d 1330, 1338 (Fed. Cir. 2013) (“[E]x parte reexamination is a curative proceeding meant to correct or eliminate erroneously granted patents.”); *In re Etter*, 756 F.2d 852, 858 (Fed. Cir. 1985) (en banc) (“[T]he focus of [reexamination] is on curing defects which occurred during a proceeding in the PTO, which was responsible for original issuance of the patent.”). “Although Congress [in the AIA] changed the name from [inter partes] ‘reexamination’ to ‘review,’ nothing convince[d] [this Court] that, in doing so, Congress wanted to change its basic purposes, namely, to reexamine an earlier agency decision.” *Cuozzo*, 136 S. Ct. at 2144. Thus, in creating inter partes review as a “more efficient system for challenging patents that should not have issued,” H.R. REP. NO. 112-98, pt. 1, at 39-40 (2011), *as reprinted in* 2011 U.S.C.C.A.N. 67, 69, Congress reasonably desired to make that improved system applicable to existing patents.

Indeed, that is precisely why the Federal Circuit upheld ex parte reexamination against a retroactivity challenge decades ago. Then, as now, Congress acted with a “purpose *** to cure defects in administrative agency action with regard to particular patents and to remedy perceived shortcomings in the system by which patents are issued”—with “[a]n important factor” being “intended retroactive extension to all extant patents.” *Patlex Corp. v. Mossinghoff*, 758 F.2d 594, 603 (Fed. Cir. 1985). Recognizing that “[c]urative statutes have received relatively favored treatment

from the courts even when applied retroactively” and that “the overriding public purposes Congress articulated in enacting the reexamination law with retroactive effect are entitled to great weight,” the Federal Circuit held that “Congress did not act in an arbitrary and irrational way to achieve its desired purposes.” *Id.* The same is true for Congress’s enactment of inter partes review.

B. The Due Process Clause Does Not Shield Ultratec’s Patents From Procedural Changes To Administrative Reconsideration

Ignoring the governing rationality standard, Ultratec premises (Pet. 12-18) its retroactivity argument on the idea that patents are property imbued with specific rights—*i.e.*, presumption of validity, heightened clear-and-convincing standard of proof for invalidation, and right to amend—that cannot be impaired. But Ultratec skips over the fact that patents—including the Ultratec patents at issue—have been subject to administrative cancellation for decades under a preponderance-of-evidence standard. *See Celgene*, 931 F.3d at 1360 (“*Celgene* does not grapple with the far more significant similarities between IPRs and their reexamination predecessors. *** IPRs and reexaminations use the same preponderance of the evidence standard of proof.”).

As to any differences between inter partes reexamination and inter partes review, Ultratec does not have a vested right in a particular administrative procedure. Ultratec cites *McClurg v. Kingsland*, 42 U.S. (1 How.) 202 (1843), for the proposition that

“substantive rights vested in a patent *** cannot be violated by subsequent changes in the law.” Pet. 15, 17. Yet *McClurg* itself holds that provisions of a new statute that “prescribe[d] the rules which must govern on the trial of actions for the violation of patented rights” should apply, regardless of whether the patents were “granted before or after [the statute’s] passage.” 42 U.S. (1 How.) at 207. Furthermore, Ultratec acknowledges that the PTO recently implemented reforms in its procedural rules to mitigate the consequences of the shift from ex parte reexamination to inter partes review on patent holders, further diminishing the continuing salience of any alleged “deprivation.” Pet. 20 & n.8; see Pet. 19 n.5; cf. *Celgene*, 931 F.3d at 1360 (“IPRs do not differ sufficiently from the PTO reconsideration avenues available when the patents here were issued to constitute a Fifth Amendment taking.”).

Ultratec’s arguments (Pet. 18-24) regarding settled expectations miss the mark for the same reasons. The AIA did not “attach[] new legal consequences to events completed before its enactment.” *Landgraf v. USI Film Prods.*, 511 U.S. 244, 270 (1994). Instead, Ultratec’s patents were subject to the same substantive standards of patentability and burdens of proof as in reexamination; the only difference was in the *procedures* used. See *Celgene*, 931 F.3d at 1360. Accordingly, Ultratec at most has “diminished reliance interests in matters of procedure” that can be altered “without raising concerns about retroactivity” at all. *Landsgraf*, 511 U.S. at 275 (“Because rules of procedure regulate secondary rather than primary

conduct, the fact that a new procedural rule was instituted after the conduct giving rise to the suit does not make application of the rule at trial retroactive.”).

II. THE FEDERAL CIRCUIT’S RULE 36 SUMMARY AFFIRMANCE PRACTICE DOES NOT WARRANT REVIEW

Despite accepting the Rule 36 summary affirmance framework in petitioning the Federal Circuit for rehearing (*see pp. 13-14, infra*), Ultratec for the first time asserts that this Court should hold that practice unlawful for all appeals taken from PTO proceedings. This Court should (once again) decline to review that issue.

Consistent with its own century-old practice of issuing summary affirmances to decide cases within its mandatory jurisdiction, *see, e.g., North Carolina v. Covington*, 137 S. Ct. 2211 (2017) (mem.); *Engelhard v. Schroeder*, 258 U.S. 610 (1922) (per curiam), this Court has emphasized that “courts of appeals should have wide latitude in their decisions of whether or how to write opinions,” *Taylor v. McKeithen*, 407 U.S. 191, 194 n.4 (1972) (per curiam). “That is especially true with respect to summary affirmances.” *Id.* As even the *Taylor* dissent recognized, there is “[n]o existing statute or rule of procedure” prohibiting courts of appeals from “deciding cases without any opinion at all.” *Id.* at 195 (Rehnquist, J., dissenting).

To the contrary, since 1968, Federal Rule of Appellate Procedure 36 has expressly contemplated that a judgment may be “rendered without an opinion,” such that “no opinion was written.” FED. R. APP. P. 36(a)(2)-(b). Courts of appeals, in turn, have

enacted local rules authorizing summary dispositions. *See* 1ST CIR. R. 36.0(a); 2D CIR. R. 32.1.1; 5TH CIR. R. 47.6; 7TH CIR. R. 32.1; 8TH CIR. R. 47A, 47B; 10TH CIR. R. 36.1; FED. CIR. R. 36. And every court to confront a challenge to those rules has upheld the use of summary affirmances. *See Furman v. United States*, 720 F.2d 263, 264 (2d Cir. 1983) (per curiam) (“There is no requirement in law that a federal appellate court’s decision be accompanied by a written opinion.”); *United States v. Baynes*, 548 F.2d 481, 482 (3d Cir. 1977) (per curiam) (rejecting claim that “affirmance by judgment order without an opinion constituted a denial of due process of law”); *NLRB v. Amalgamated Clothing Workers of Am.*, 430 F.2d 966, 967 (5th Cir. 1970) (per curiam) (validating “one-word disposition”).

In the face of that authority, Ultratec hangs its hat on 35 U.S.C. § 144, which it excerpts to say that the Federal Circuit “shall issue *** its mandate and opinion.” Pet. 29 (ellipsis in original). But the provision does not require a full written opinion in every appeal from a PTO decision; it simply specifies that an opinion be sent to the agency and made part of the record. *See* 35 U.S.C. § 144 (“Upon its determination the court shall issue to the Director its mandate and opinion, which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case.”). Section 144 cannot reasonably be read to somehow displace an Article III court’s control over its own operations, including how and when to write a written opinion explaining its reasoning. Congress must speak far

more clearly if it seeks to override the longstanding prerogatives of a coordinate branch.

Rule 36 summary affirmances also do not “deprive[] patent owners challenging adverse PTO decisions of meaningful appellate review,” much less raise constitutional concerns or stymie development of patent law. Pet. 31, 34-35. Especially in an argued case like this one. Rule 36 is employed only where (as pertinent here) the challenged decision “warrants affirmance under the standard of review in the statute authorizing the petition for review” or “has been entered without an error of law.” FED. CIR. R. 36(a)(4)-(5).

III. THIS CASE IS NOT A SUITABLE VEHICLE FOR BROACHING QUESTIONS THIS COURT CONSISTENTLY HAS DECLINED TO REVIEW

That the questions presented do not warrant this Court’s review is well evidenced by the repeated and recent denials of certiorari.¹ Despite acknowledging

¹ For petitions concerning retroactivity, *see, e.g., Enzo Life Scis., Inc. v. Becton, Dickinson & Co.*, 141 S. Ct. 150 (2020) (mem.); *Collabo Innovations, Inc. v. Sony Corp.*, 141 S. Ct. 129 (2020) (mem.). For petitions concerning Rule 36 summary affirmances, *see, e.g., Straight Path IP Grp., LLC v. Apple Inc.*, 140 S. Ct. 520 (2019) (mem.); *Specialty Fertilizer Prods., LLC v. Shell Oil Co.*, 138 S. Ct. 2678 (2018) (mem.); *Celgard, LLC v. Iancu*, 138 S. Ct. 1714 (2018) (mem.); *Shore v. Lee*, 137 S. Ct. 2197 (2017) (mem.); *Concaten, Inc. v. AmeriTrak Fleet Sols., LLC*, 137 S. Ct. 1604 (2017) (mem.); *Cloud Satchel, LLC v. Barnes & Noble, Inc.*, 136 S. Ct. 1723 (2016) (mem.); *Hyundai Motor Am., Inc. v. Clear with Computers, LLC*, 571 U.S. 1010 (2013) (mem.); *Kastner v. Chet’s Shoes, Inc.*, 565 U.S. 1201 (2012) (mem.); *White*

(at least as to the Rule 36 summary affirmance issue) that “numerous petitioners to this Court have presented variations of all of the[] issues” raised here, Pet. 36, Ultratec does not provide any reason to treat this case differently.

To the contrary, this case is a particularly poor vehicle for reviewing the questions presented because Ultratec neglected to preserve or press them. “It is elementary that where an argument could have been raised on an initial appeal, it is inappropriate to consider that argument on a second appeal following remand.” *Northwestern Ind. Tel. Co. v. FCC*, 872 F.2d 465, 470 (D.C. Cir. 1989). The Federal Circuit recently applied that principle to an inter partes review appellant that swapped constitutional challenges between a first and second appeal, holding that “[o]nce its first appeal was decided, all matters which could have been raised then—but were not—were foreclosed.” *Vivint v. Alarm.com Inc.*, 856 F. App’x 300, 304 (Fed. Cir. 2021); *see also Tronzo v. Biomet, Inc.*, 236 F.3d 1342, 1348-1349 (Fed. Cir. 2001) (explaining that party that “disput[es] various rulings *** on appeal,” but “fail[s] to raise [an] issue” that is “clearly implicated in the initial decision,” is “prevent[ed] *** from raising th[at] issue on remand or in any future proceedings in th[e] litigation”); *Engel Indus., Inc. v. Lockformer Co.*, 166 F.3d 1379, 1382-1383 (Fed. Cir. 1999) (“[A]llow[ing] appellants to

v. Hitachi, Ltd., 565 U.S. 825 (2011) (mem.); *Max Rack, Inc. v. Hoist Fitness Sys., Inc.*, 564 U.S. 1057 (2011) (mem.); *Romala Stone, Inc. v. Home Depot U.S.A., Inc.*, 562 U.S. 1201 (2011) (mem.); *Wayne-Dalton Corp. v. Amarr Co.*, 558 U.S. 991 (2009) (mem.); *Tehrani v. Polar Electro*, 556 U.S. 1236 (2009) (mem.).

present appeals in a piecemeal and repeated fashion *** would lead to the untenable result that a party who has chosen not to argue a point on a first appeal should stand better as regards the law of the case than one who had argued and lost.”) (internal quotation marks omitted).

Such impermissible swapping of constitutional claims occurred here. *See* pp. 3-4, *supra*. Ultratec’s first appeal raised a due process challenge limited to the argument that patents can be invalidated only by district courts under procedures applicable in that forum. After this Court foreclosed that challenge in *Oil States Energy Services, LLC v. Greene’s Energy Group, LLC*, 138 S. Ct. 1365 (2018), Ultratec pivoted in this (second) appeal to a “retroactivity” theory. Although Ultratec insisted that its due process theories were one and the same, tellingly the word “retroactivity” (or variants) appears not once in its briefs from the first appeal. Even when (belatedly) raising “retroactivity” in its second appeal, Ultratec devoted only 11 out of 358 pages of briefing before the Federal Circuit to the newly framed due process issue, and did not make any affirmative argument on the issue at oral argument or in its rehearing petition.

Ultratec similarly failed to press the Rule 36 summary affirmance issue when it had the chance. To be sure, Ultratec argued on rehearing to the Federal Circuit that the panel “misused” and “misapplied” Rule 36 because (i) the standard for summary affirmance was not met, and (ii) summary affirmance improperly condoned various record-specific Board errors. Ultratec Pet. for Reh’g 5-20, No. 19-1998 (Fed. Cir.), ECF No. 73. But Ultratec never suggested, as it

does here, that Rule 36 violates 35 U.S.C. § 144 as applied to all appeals arising from the PTO.

In sum, Ultratec has taken a shifting-sands approach, waiting to see how certain arguments fared before trying others. Given the Federal Circuit's lack of any engagement on the questions presented, this Court should await a case in which the arguments have been fully ventilated before it grants review (if ever).

CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be denied.

Respectfully submitted.

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