

No. 20-853

IN THE

Supreme Court of the United States

ANDREI IANCU, UNDER THE SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES
PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

FALL LINE PATENTS, LLC, et al.,

Respondents,

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

**JAMES GELSIN MARX RESPONSE IN SUPPORT OF THE
PETITION FOR WRIT OF CERTIORARI**

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QUESTION PRESENTED

Given that respondent James Gelsin Marx agrees with petitioner that the Court's decision in *Arthrex* will govern the Marx case, should the petition in the Marx case be held and then disposed of as appropriate following the issuance of this Court's judgment in *Arthrex*?

CORPORATE DISCLOSURE STATEMENT

Respondent James Gelsin Marx is an individual.

I. INTRODUCTION

Respondent James Gelsin Marx agrees with petitioner that the Court's decision in *United States v. Arthrex, Inc.*, Case No. 19-1434, and the consolidated cases (Nos. 19-1452 and 19-1458), may warrant granting, vacating, and remanding to the Federal Circuit. Marx thus agrees that, in the Marx case, the Court should hold the petition for its decision in *Arthrex*, and then dispose of it accordingly.

II. STATEMENT

Respondent Marx appealed patent examiner rejections of his claims in U.S. Patent Application No. 14/231,348 to the Patent Trial and Appeal Board. The Board affirmed the examiner's rejections.

Marx appealed to the Federal Circuit and moved that the Board's decision be vacated and remanded on the ground that the Board was not properly appointed under the Appointments Clause. The Federal Circuit stayed the motion pending that court's resolution of a similar motion in *In re Boloro Global Ltd.*, 963 F.3d 1380 (Fed. Cir. 2020). After granting the motion in *Boloro*, the court granted Marx's motion, vacated the Board's decision, and remanded the case to the Board for proceedings consistent with the Federal Circuit's decisions in *Arthrex* and *Boloro*. The remanded case before the Board was stayed in view of this Court's pending *Arthrex* cases by operation of a general order previously issued by the Board. *See* Gen. Order in Cases Remanded Under *Arthrex, Inc.*, 941 F.3d 1320 (Fed. Cir. 2019) (PTAB May 1, 2020).

On December 22, 2020, the government filed this petition for certiorari, which asks the Court to hold its petition pending disposition of *United States v. Arthrex, Inc.*, No. 19-1434, and the consolidated cases (Nos. 19-1452 and 19-1458), and then to

dispose of it as appropriate in light of the Court's *Arthrex* ruling. The Court docketed the petition on December 28, 2020.

The Court called for a response to the petition on February 22, 2021. As noted by respondents Fall Line Patents, LLC and Snyders Heart Valve LLC, the Court's call appears to have been addressed only to counsel for those respondents. Fall Line Response at 3. Thus, it is not clear that the Court called for Marx's response. Nevertheless, out of caution, Marx submits this response on behalf of himself alone.

III. ARGUMENT

Marx adopts petitioner's argument section in full. *See* Pet. 9-10. For example, Marx agrees with petitioner that, if the Court reverses in *Arthrex*, then the Court should vacate the judgment of the Federal Circuit in the Marx case and remand for further proceedings. The petition in the Marx case should thus be held pending the issuance of this Court's decision in *Arthrex*, and then should be disposed of as appropriate in light of that decision.

IV. CONCLUSION

For the Marx case, the Court should hold the petition pending its decision in *Arthrex*, and then dispose of it accordingly.

Respectfully submitted,

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