No. 21-202

In the Supreme Court of the United States

MYLAN LABORATORIES LTD.,
Petitioner,
v.
JANSSEN PHARMACEUTICA, N.V.,
and
ANDREW HIRSHFELD, Performing the Functions and Duties of the Under Secretary of Commerce for Intellectual Property and Director of the 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

BRIEF OF JEREMY C. DOERRE AS *AMICUS CURIAE* IN SUPPORT OF NO PARTY

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TABLE OF CONTENTS

TABLE OF AUTHORITIES

Cases

Statutes

Other Authorities

INTEREST OF AMICUS CURIAE[1]

Amicus Curiae Jeremy C. Doerre is a registered patent attorney who practices before the United States Patent and Trademark Office, the Office's Patent Trial and Appeal Board, and the United States Court of Appeals for the Federal Circuit. Amicus has no stake in any party or in the outcome of this case. Amicus' only interest in this case is in bringing potentially relevant precedent and issues to the Court's attention.

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[1] No counsel for a party authored this brief in whole or in part, and no party or counsel for a party made a monetary contribution intended to fund the preparation or submission of this brief. No person or entity other than amicus curiae or amicus curiae's counsel made such a monetary contribution to the preparation or submission of this brief. Counsel for each of the parties provided written consent to the filing of this brief. A copy of this written consent was provided to the Clerk upon filing. Counsel of record for each of the parties received timely notice of intent to file this brief.

SUMMARY OF THE ARGUMENT

Congress has tasked "[t]he Director [with] determin[ing] whether to institute an inter partes review," 35 U.S.C. § 314, but "[t]he Director, by regulation, has delegated to the Board the authority under section 314 to decide whether to institute an inter partes review." *St. Jude Medical, Cardiology Division, Inc. v. Volcano Corp.*, 749 F.3d 1373, 1375 n.1 (Fed. Cir. 2014).

The Petition seeks to interpret the Federal Circuit's grant of jurisdiction in 28 U.S.C. § 1295 over "an appeal from a decision of… the … Board" to encompass determinations issued by the Board "on behalf of the Director." 37 CFR § 42.4.

However, the Federal Circuit's predecessor court repeatedly held, in construing the term "decision of the Board" in earlier statutes, "that an acceptable 'decision', in the jurisdictional sense, refers to an action taken by the board, in a capacity[] provided for in the statutes," and excludes situations where "the board was acting only … as an agent of the [head of the Office] — and not in any statutory capacity." *In re James*, 432 F.2d 473, 475, 476 (C.C.P.A. 1970).

Under *Lorillard v. Pons*, 434 U.S. 575, 580 (1978), Congress is presumed to have been aware of this judicial interpretation of the term "decision[] of… the Board" in an earlier jurisdictional statute when it reenacted this language in 28 U.S.C. § 1295, see Pub. L. No. 97-164, 96 Stat. 25, 38 (1982), causing the

Federal Circuit to, "in essence, inherit[] the jurisdiction of the United States Court of Customs and Patent Appeals (CCPA)." *Copelands' Enterprises, Inc. v. CNV, Inc.*, 887 F.2d 1065, 1067 (Fed. Cir. 1989) (en banc).

"Since … [there is] no reason to doubt that these cases represented settled law when Congress reenacted the '[decision of the Board]' language in [1982], … [it is appropriate to] apply the presumption that Congress was aware of these earlier judicial interpretations and, in effect, adopted them." *Keene Corp. v. United States*, 508 U.S. 200, 212 (1993).

Moreover, the Petition's desired interpretation of 28 U.S.C. § 1295 would allow the Director's regulations to expand the Federal Circuit's jurisdiction to encompass review of determinations which would not have been within the court's jurisdiction absent such regulations, thus raising a potential nondelegation question. Accordingly, the canon of avoidance also militates against the Petition's desired interpretation and in favor of the CCPA's "fairly possible" construction "by which the question may be avoided." *Crowell v. Benson*, 285 U.S. 22, 62 (1932).

ARGUMENT

The Petition asks this Court to consider whether "35 U.S.C. § 314(d) categorically preclude[s] appeal of all decisions not to institute *inter partes* review." Pet. at i.

In seeking consideration of this question, the Petition urges that "[t]he Federal Circuit has jurisdiction under 28 U.S.C. § 1295(a)(4)(A) … broad enough to encompass Mylan's appeal, which challenges … the Board['s] [] den[ial] [of] its IPR petition." Pet. at 14.

Amicus submits this brief to highlight that the Petition's interpretation of 28 U.S.C. § 1295 is contrary to an established judicial interpretation presumptively adopted by Congress, and that the canon of avoidance also militates against the Petition's interpretation.

In doing so, Amicus expresses no opinion on whether the Federal Circuit by mandamus may review a Board denial of institution, and takes no position on whether this Court should grant the Petition.

I. The Petition's desired interpretation of 28 U.S.C. § 1295 is contrary to an established judicial interpretation presumptively adopted by Congress.

A. The Federal Circuit's predecessor court interpreted the term 'decision of the Board' to not encompass decisions where the Board was acting only as an agent of the head of the Office and not in any statutory capacity.

28 U.S.C. § 1295 grants the Federal Circuit jurisdiction over "an appeal from a decision of… the Patent Trial and Appeal Board … with respect to a[n] … inter partes review."

Congress has tasked "[t]he Director [with] determin[ing] whether to institute an inter partes review." 35 U.S.C. § 314. It seems unquestionable that 28 U.S.C. § 1295 does not provide the Federal Circuit jurisdiction to review an institution determination made personally by the Director, as such a determination is clearly not "a decision of… the Patent Trial and Appeal Board." 28 U.S.C. § 1295.

Notably, though, "[t]he Director, by regulation, has delegated to the Board the authority under section 314 to decide whether to institute an inter partes review." *St. Jude Medical, Cardiology Division, Inc. v. Volcano Corp.*, 749 F.3d 1373, 1375 n.1 (Fed. Cir. 2014). Thus, in making an institution determination, the Board "is exercising the Director's section 314 authority," *Id.*, and acting "on behalf of the Director." 37 CFR § 42.4.

The Petition seeks to interpret the grant of jurisdiction in 28 U.S.C. § 1295 over "an appeal from

a decision of… the … Board" to encompass determinations issued by the Board on behalf of the Director.

However, the Federal Circuit's predecessor court repeatedly held, in construing the term "decision of the Board" in earlier statutes, "that an acceptable 'decision', in the jurisdictional sense, refers to an action taken by the board, in a capacity[] provided for in the statutes," and excludes situations where "the board was acting only … as an agent of the [head of the Office] — and not in any statutory capacity." *In re James*, 432 F.2d 473, 475, 476 (C.C.P.A. 1970).

The Court of Customs and Patent Appeals (CCPA) first confronted this issue in an interference context, where "the law impose[d] upon the [head of the Office] the duty of determining whether an interference shall be declared… and… the power to dissolve the same," but he "delegated the power to act for him." *Sundback v. Blair*, 47 F.2d 378, 380 (C.C.P.A. 1931).

The court made "clear that appeals can be taken to this court only from decisions which the Board of Appeals is specifically authorized by the statutes to make … and that any decisions not so authorized, but which are made under authority of the [head of the Office] to aid him in the performance of his duties, are not appealable to this court." *Id.*

In reaching its decision, the court expressly construed the reference to a "decision of the board of appeals" in an earlier statute to "mean a decision of

the Board of Appeals rendered by it in the performance of the duties expressly conferred upon it by statute, and … not include any decision rendered by it pursuant to any rule of the Patent Office conferring upon it a jurisdiction not expressly authorized by the statutes." *Id.* at 379, 380.

Over the next four decades, the CCPA had occasion "to reconsider its holding several times but [] never felt the need to alter it." *James*, 432 F.2d at 475. Instead, "in every case in which [the Court] discussed the meaning of that word, it [w]as [] concluded that an acceptable 'decision', in the jurisdictional sense, refers to an action taken by the board, in a capacity[] provided for in the statutes". *Id.*

While both *Sundback* and *James* focused their discussion on interpretation of the term "decision of the [B]oard" in an appeal right statute (an earlier version of 35 U.S.C. § 141 in *James*, and an even earlier predecessor thereto in *Sundback*), the CCPA made clear that this interpretation applied to its grant of jurisdiction in 28 U.S.C. § 1542 as well.

In particular, shortly after *James*, the court indicated that "[b]oth 28 U.S.C. § 1542 and 35 U.S.C. § 141 limit our jurisdiction to appeals of 'decisions' of the board," noting that "[t]he board's authority to make such 'decisions' is set forth in 35 U.S.C. § 7." *In re Haas*, 486 F.2d 1053, 1055 (C.C.P.A. 1973).

Thus, the CCPA interpreted both the term "decisions of… the Board" in 28 U.S.C. § 1542 and the term "decision of the Board" in 35 U.S.C. § 141 as

"refer[ring] to an action taken by the board, in a capacity[] provided for in the statutes," and excluding actions where "the board was acting only under authority of the rules — as an agent of the [head of the Office] — and not in any statutory capacity." *James*, 432 F.2d at 475, 476.

B. Congress presumptively adopted the established judicial interpretation in reenacting the relevant language in 28 U.S.C. § 1295.

"Congress is presumed to be aware of an administrative or judicial interpretation of a statute and to adopt that interpretation when it re-enacts a statute without change." *Lorillard v. Pons*, 434 U.S. 575, 580 (1978).

Here, then, Congress is presumed to have been aware of the CCPA interpretation of the term "decision[] of… the Board" in 28 U.S.C. § 1542 when it reenacted this language in 28 U.S.C. § 1295, see Pub. L. No. 97-164, 96 Stat. 25, 38 (1982), causing the Federal Circuit to, "in essence, inherit[] the jurisdiction of the …CCPA." *Copelands' Enterprises, Inc. v. CNV, Inc.*, 887 F.2d 1065, 1067 (Fed. Cir. 1989) (en banc).

In particular, the Federal Circuit's first grant of jurisdiction over "an appeal from a decision of… the Board of Appeals or the Board of Patent Interferences of the Patent and Trademark Office with respect to

patent applications and interferences," 28 U.S.C. § 1295 (1982), exactly mirrors the CCPA's prior grant of jurisdiction over "'appeals from decisions of… the Board of Appeals and the Board of Interference Examiners of the Patent Office as to patent applications and interferences.'" *In re Voss*, 557 F.2d 812, 816 n.7 (C.C.P.A. 1977) (quoting then 28 U.S.C. § 1542).

"Since … [there is] no reason to doubt that these cases represented settled law when Congress reenacted the '[decision of the Board]' language in [1982], … [it is appropriate to] apply the presumption that Congress was aware of these earlier judicial interpretations and, in effect, adopted them." *Keene Corp. v. United States*, 508 U.S. 200, 212 (1993); see also *Taggart v. Lorenzen*, 139 S. Ct. 1795, 1801 (2019) ("When a statutory term is obviously transplanted from another legal source, it brings the old soil with it." (internal quotation marks omitted)).

The Federal Circuit's current grant of jurisdiction in 28 U.S.C. § 1295 continues to substantially mirror these prior grants of jurisdiction except in that it has been updated to encompass new proceedings that did not exist at the time, and thus there is no reason to believe that this adopted interpretation has been disturbed.

In particular, 28 U.S.C. § 1295 has now been updated to recite "a decision of… the … Board … with respect to a patent application, derivation proceeding, reexamination, post-grant review, or inter partes

review." However, the adopted CCPA interpretation has clearly remained applicable the entire time as to "a decision of… the … Board … with respect to a patent application," 28 U.S.C. § 1295, and the term "decision of… the … Board" should have the same meaning for each type of delineated proceeding. See *Cochise Consultancy, Inc. v. United States ex rel. Hunt*, 139 S. Ct. 1507, 1512 (2019) ("In all but the most unusual situations, a single use of a statutory phrase must have a fixed meaning."); *Bankamerica Corp. v. United States*, 462 U.S. 122, 129 (1983) ("we reject as unreasonable the contention that Congress intended the phrase 'other than' to mean one thing when applied to 'banks' and another thing as applied to 'common carriers,' where the phrase 'other than' modifies both words in the same clause.")

II. The canon of avoidance also militates against the Petition's desired interpretation of 28 U.S.C. § 1295.

A. The Petition's desired interpretation would raise a nondelegation question by allowing the Director's regulations to expand the Federal Circuit's jurisdiction.

The Petition's desired interpretation of 28 U.S.C. § 1295 requires interpreting the grant of jurisdiction over "an appeal from a decision of… the … Board" to

encompass determinations issued by the Board "on behalf of the Director." 37 CFR § 42.4.

This would mean that the Director's regulations delegating institution determinations to the Board have expanded the Federal Circuit's jurisdiction to encompass review of institution determinations which would not have been within the court's jurisdiction absent such regulations.

Indeed, such an interpretation would allow the Director to expand the Federal Circuit's jurisdiction to review other Office determinations "with respect to a patent application, derivation proceeding, reexamination, post-grant review, or inter partes review" by delegating them to the Board. 28 U.S.C. § 1295. Similarly, the Director could subsequently contract the Federal Circuit's jurisdiction by reversing such delegation.

This is potentially problematic because "Congress… possess[es] the sole power of creating the tribunals (inferior to the Supreme Court) for the exercise of the judicial power, and of investing them with jurisdiction … and [] withholding jurisdiction," *Cary v. Curtis*, 44 U.S. 236, 245 (1845), and "[a]ccompanying that assignment of power to Congress is a bar on its further delegation." *Gundy v. United States*, 139 S. Ct. 2116, 2123 (2019); see also *Christianson v. Colt Indus.*, 486 U.S. 800, 818 (1988) ("Courts created by statute can have no jurisdiction but such as the statute confers.")

"While it's been some time since th[is] Court last held that a statute improperly delegated the legislative power to another branch… the Court has hardly abandoned the business of policing improper legislative delegations." *Gundy*, 139 S. Ct. at 2141 (Gorsuch, J., dissenting). Indeed, just two years ago, this Court acknowledged that if a particular view of a contested provision had been correct, then "we would face a nondelegation question." *Gundy*, 139 S. Ct. at 2123.

Further, as the Seventh Circuit has observed, "one can readily distinguish between Congress' ability to delegate its commerce power over price controls during wartime… and its ability to delegate a power as sensitive and central to our Anglo-American legal tradition as shaping a federal court's jurisdiction." *United States v. Mitchell*, 18 F.3d 1355, 1360 n.7 (7th Cir. 1994). The Seventh Circuit suggested that there is a "potential constitutional concern" as to whether "anything in the Framers' language would permit Congress to delegate such a core legislative function as its control over federal court jurisdiction to any agency or commission." *Id.*

Some other circuits have gone so far as to suggest that "it is 'axiomatic' that agencies can neither grant nor curtail federal court jurisdiction." *Carlyle Towers Condominium Ass'n v. Federal Deposit Insurance*, 170 F.3d 301, 310 (2d Cir. 1999) (quoting *Miller v. FCC*, 66 F.3d 1140, 1144 (11th Cir. 1995)); see also *Miller*, 66 F.3d at 1144 ("it is axiomatic that Congress has not

delegated, and could not delegate, the power to any agency to oust state courts and federal district courts of subject matter jurisdiction.”))

While the D.C. Circuit has suggested that “Congress may delegate the authority to the Executive Branch to make a finding of fact upon which subject matter jurisdiction depends,” it was careful to distinguish this from the situation of “delegating to the Executive the authority to define the conditions under which the courts will have jurisdiction.” *Owens v. Republic of Sudan*, 531 F.3d 884, 890, 891 (D.C. Cir. 2008).

Here, under the Petition’s desired interpretation, the Director would not simply be able to “make a finding of fact upon which subject matter jurisdiction depends,” *Id.*, but would instead be able to confer jurisdiction on the Federal Circuit to review a new type of decision by promulgating a regulation assigning that type of decision to the Board.

In *Gundy*, the Court acknowledged that if the contested “provision… [had] grant[ed] the Attorney General plenary power to determine [the Act’s] applicability to pre-Act offenders—to require them to register, or not, as she sees fit, and to change her policy for any reason and at any time … [then] we would face a nondelegation question.” *Gundy*, 139 S. Ct. at 2123.

Here, analogously, if the statutory scheme is interpreted to provide the Director “plenary power to [grant the Federal Circuit jurisdiction over various

Office determinations] or not, as she sees fit, and to change her policy for any reason and at any time … [then] we would face a nondelegation question." *Id.*

B. The established judicial interpretation offers a 'fairly possible' construction by which the nondelegation question may be avoided.

Ultimately, though, it may not actually be necessary to fully evaluate whether such a scheme would be unconstitutional, given the "rule of statutory construction… [that] where an otherwise acceptable construction of a statute would raise serious constitutional problems, the Court will construe the statute to avoid such problems unless such construction is plainly contrary to the intent of Congress." *Edward J. DeBartolo Corp. v. Florida Gulf Coast Building Constr. Trades Council*, 485 U.S. 568, 575 (1988). Indeed, "[t]his cardinal principle … has for so long been applied by this Court that it is beyond debate." *Id.*

Thus, because "a serious doubt of constitutionality is raised," it is necessary to "ascertain whether a construction of the statute is fairly possible by which the question may be avoided." *Crowell v. Benson*, 285 U.S. 22, 62 (1932).

Here, precedent of the CCPA presumptively adopted by Congress and explicitly adopted by the Federal Circuit, see *South Corp. v. United States*, 690

F.2d 1368, 1370 (Fed. Cir. 1982), offers exactly such a "fairly possible" construction, in the form of the CCPA's repeated construction of the term "decision of the Board" as "refer[ring] to an action taken by the board, in a capacity[] provided for in the statutes," and excluding actions where "the board was acting only under authority of the rules — as an agent of the [head of the Office] — and not in any statutory capacity." *James*, 432 F.2d at 475, 476.

Consequently, the avoidance canon militates against the Petition's desired interpretation and in favor of this "fairly possible" construction "by which the question may be avoided." *Crowell*, 285 U.S. at 62.

CONCLUSION

Amicus urges that the Petition's interpretation of 28 U.S.C. § 1295 is contrary to an established judicial interpretation presumptively adopted by Congress, and that the canon of avoidance also militates against the Petition's interpretation.

Respectfully submitted,

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