

No. 21-350

IN THE
Supreme Court of the United States

INFINEUM USA L.P.,
PETITIONER,

v.

CHEVRON ORONITE COMPANY LLC, *ET AL.*,
RESPONDENTS.

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

**BRIEF IN OPPOSITION OF RESPONDENT
CHEVRON ORONITE COMPANY LLC**

NAVEEN MODI
COUNSEL OF RECORD
STEPHEN B. KINNAIRD
IGOR V. TIMOFEYEV
DANIEL ZEILBERGER
PAUL HASTINGS LLP
2050 M Street, N.W.
Washington, D.C. 20036
(202) 551-1700
naveenmodi@paulhastings.com

*Counsel for Chevron Oronite
Company LLC*

CORPORATE DISCLOSURE STATEMENT

Respondent Chevron Oronite Company LLC is a wholly owned subsidiary of Chevron U.S.A. Inc., which is a wholly owned indirect subsidiary of Chevron Corporation. Chevron Corporation is a publicly traded corporation. Chevron Corporation does not have a parent corporation, and no publicly traded corporation owns ten percent or more of its stock.

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INTRODUCTION

“[N]o procedural principle is more familiar to this Court than that a constitutional right, or a right of any other sort, may be forfeited ... by the failure to make timely assertion of the right before a tribunal having jurisdiction to determine it.” *Henderson v. United States*, 568 U.S. 266, 271 (2013) (internal quotation marks and citations omitted). Petitioner Infineum USA L.P. (“Infineum”) asks this Court to disregard this settled rule when it requests vacatur of the Federal Circuit’s judgment below and remand so Infineum could pursue “the constitutional remedy provided for by *United States v. Arthrex*,” 141 S. Ct. 1970 (2021)—an ability “to request Director rehearing of the final written decision” entered by the Patent Trial and Appeal Board (and upheld by the Federal Circuit). Pet. 8-9. Infineum forfeited its right to the remedy this Court promulgated in *Arthrex*, and its petition should be denied.

Infineum did not argue below that the proper remedy for the constitutional defect in the appointment of the Board’s administrative patent judges (“APJs”) was a rehearing by the Director of the U.S. Patent and Trademark Office. Nor did Infineum reserve a right to benefit from a remedy for the constitutional violation that the Court may prescribe in *Arthrex* (No. 19-1434). Rather, Infineum only sought to preserve for this Court’s potential review two entirely different questions raised in a different *Arthrex* case (No. 19-1204)—whether the *inter partes* review statute may be applied retroactively and whether the Federal Circuit’s *Arthrex* decision constituted an intervening change in law that excuses waiver of a constitutional challenge. The

Court denied certiorari in No. 19-1204, declining to review those questions. In sum, Infineum did not adequately preserve its ability to benefit from a decision by this Court prescribing a different remedy for the Appointments Clause violation than the one previously chosen by the Federal Circuit. Vacatur and remand are therefore unwarranted.

Infineum's alternative request—that this Court grant certiorari to resolve a purported circuit conflict on the application of the mandate rule—also does not warrant review. As an initial matter, as Infineum tacitly recognizes, this Court's *Arthrex* decision renders that question moot. Because this Court in *Arthrex* prescribed a different remedy for the Appointments Clause violation, it no longer matters whether *the Federal Circuit's* original remedy (the severance of APJs' removal protections) was effective as of the date of the Federal Circuit's *Arthrex* decision or only upon the issuance of the mandate. Infineum also does not explain why it could not have informed the Board about the Federal Circuit's *Arthrex* decision *prior* to the mandate's issuance. Instead, Infineum chose to await the Board's decision, and sought a new hearing only once that decision did not turn in its favor. This is the type of "sandbagging" that this Court has sternly condemned. *Stern v Marshall*, 564 U.S. 462, 482 (2011) (internal quotation marks and citation omitted).

Moreover, the Federal Circuit's decision is correct and in full alignment with the position of the other courts of appeals. There is no circuit split for this Court to resolve. Finally, the decision below is non-precedential, and so cannot set binding circuit law. Nor does it contain any substantive discussion of the

issue Infineum presses here. The Federal Circuit’s decision would therefore be an exceedingly poor vehicle for addressing the question presented.

STATEMENT OF THE CASE

A. The Statutory Framework and the Federal Circuit’s *Arthrex* Decision.

The Patent Act of 1952 establishes the United States Patent and Trademark Office (“the Patent Office”) as an executive agency within the United States Department of Commerce “responsible for the granting and issuing of patents and the registration of trademarks.” 35 U.S.C. 2(a)(1); *see also* 35 U.S.C. 1(a). The Board is an administrative tribunal within the Patent Office that conducts a variety of patent-related adjudications. 35 U.S.C. 6(a), (b). The Board consists of the Director of the Patent Office, the Deputy Director, the Commissioners for Patents and Trademarks, and “administrative patent judges.” 35 U.S.C. 6(a). The Secretary of Commerce—not the President—appoints the administrative patent judges. *See* 35 U.S.C. 6(a). The Board typically renders its decisions in panels of three administrative patent judges. *See* 35 U.S.C. § 6(c).

In *Arthrex, Inc. v. Smith & Nephew, Inc.*, the Federal Circuit held that the administrative patent judges are principal officers of the United States for purposes of the Appointments Clause. 941 F.3d 1320, 1327-35 (Fed. Cir. 2019). The Appointments Clause requires that the principal officers be appointed by the President with the advice and consent of the Senate. *See* U.S. Const. Art. II, § 2, Cl. 2. The Federal Circuit therefore concluded that the method of appointing the administrative patent judges—

which lacks presidential nomination and Senate confirmation—violated the Appointments Clause. *Arthrex*, 941 F.3d at 1335. The Federal Circuit’s adopted remedy for this constitutional defect was to sever statutory restrictions on the administrative patent judges’ removal. *Id.* at 1335-38. Because the Board’s decision on review was made by a panel of administrative patent judges who were not constitutionally appointed at the time of the decision, the Federal Circuit in *Arthrex* vacated the Board’s decision and remanded for a new hearing before a new panel. *Id.* at 1338-40 (citing *Lucia v. S.E.C.*, 138 S. Ct. 2044, 2055 (2018)).

B. The Proceedings Below.

Petitioner Infineum holds U.S. Patent No. 6,723,685 (“the ’685 patent”), which claims lubricating oil compositions and their use in internal combustion engines. App. 2a. Respondent Chevron Oronite Company LLC (“Chevron Oronite”) filed an *inter partes* review petition challenging all claims of the ’685 patent as obvious over the prior art. App. 2a, 5a. The Board agreed and, after a detailed analysis, found all the challenged claims unpatentable over the asserted prior art. *See* App. 5a, 38a-84a. The Board also rejected Infineum’s procedural arguments, which sought to exclude certain arguments and evidence proffered by Chevron Oronite. *See* App. 84a-92a.

Before the Board issued its final written decision below, the Federal Circuit decided *Arthrex*. Infineum did not, however, request that the Board hold a new hearing before a new Board panel—the remedy that the Federal Circuit ordered in *Arthrex*. *See* 941 F.3d at 1338-40; *supra* at 4. Instead, Infineum let the Board proceed to decide whether the challenged

claims were unpatentable, and to issue a final decision.

On appeal, the Federal Circuit affirmed the Board's decision. The court of appeals first rejected Infineum's argument that the Board improperly relied on new theories and evidence that Chevron Oronite raised for the first time only in its reply. The Federal Circuit held that these were either not new theories at all, or were proper rebuttal arguments and evidence, and that the Board did not err in considering them. App. 9a-12a.

The Federal Circuit also rejected Infineum's challenge to the Board's findings as not supported by substantial evidence. As the court of appeals observed, "[s]ubstantial evidence is 'such relevant evidence as a reasonable mind might accept as adequate to support a conclusion.'" App. 13a (quoting *Consol. Edison Co. v. NLRB*, 305 U.S. 197, 229 (1938)) (additional internal quotation marks and citation omitted). The Federal Circuit found that the Board's decision was amply supported by substantial evidence, App. 13a-20a, and that Infineum's arguments either "lack[ed] merit," App. 13a-15a, were foreclosed by precedent, App. 15a-16a, or were simply "unavailing," App. 16a-19a, and "unsupported," App. 20a.

The Federal Circuit also rejected "Infineum's constitutional challenges to the Board's decision" as foreclosed by circuit precedent. App. 21a. First, the court of appeals rejected Infineum's argument that "vacatur and remand to the Board with instructions to dismiss the IPR" was required because "the remedy [the Federal Circuit] adopted in *Arthrex* did not cure the Appointments Clause violation, and

‘there is no permissible interpretation of the statute.’” App. 21a (quoting Infineum’s CAFC Br. 49). As the Federal Circuit observed, Infineum “implicitly acknowledge[d]” that its argument was foreclosed by the Federal Circuit’s *Arthrex* decision, and that Infineum presented its challenge to the Federal Circuit’s refusal to dismiss the *inter partes* review solely “in order to preserve its rights” in the event the Supreme Court rules otherwise. App. 21a (quoting Infineum’s CAFC Br. 52).

The Federal Circuit then held that (as Infineum likewise acknowledged) circuit precedent similarly foreclosed “Infineum’s alternative argument that vacatur and remand to a new panel of [APJs] is warranted because the Board issued its final written decision prior to issuance of the mandate in *Arthrex*” (but subsequent to issuance of the Federal Circuit’s *Arthrex* decision). App. 21a-22a (citing Infineum CAFC Br. 52-53). As the Federal Circuit explained, its precedent expressly limited the vacatur and remand remedy to those cases where the Board’s final written decision was issued prior to *Arthrex*. App. 22a (citing *Caterpillar Paving Prods. Inc. v. Wirtgen Am., Inc.*, 957 F.3d 1342, 1342-43 (Fed. Cir. 2020)). That is because (in the Federal Circuit’s view), the severance remedy promulgated in its *Arthrex* decision has solved the Appointments Clause violation. App. 22a (citing *Caterpillar*, 957 F.3d at 1342-43; *Arthrex*, 941 F.3d at 1340).

Finally, the Federal Circuit held that its precedent also foreclosed “Infineum’s argument that the Board’s retroactive application of IPR proceedings to invalidate the ’685 patent claims violates the Takings and Due Process Clauses of the U.S.

Constitution.” App. 22a (citing Infineum’s CAFC Br. 54-59). As the court of appeals observed, Infineum itself appeared to abandon this argument. App. 22a. Regardless, the Federal Circuit noted that it has previously rejected that argument, and this Court denied review of that decision. *Id.* (citing *Celgene Corp. v. Peter*, 931 F.3d 1342, 1362 (Fed. Cir. 2019), *cert. denied*, 141 S. Ct. 132 (2020)).

The Federal Circuit then denied Infineum’s petition for panel and en banc rehearing. App. 121a-122a.

C. This Court’s *Arthrex* Decision.

After the Federal Circuit denied en banc rehearing in this case, this Court decided *Arthrex*. The Court held that inferior officers, such as the Board’s administrative patent judges, “lack[] the power under the Constitution to finally resolve” challenges to patents on behalf of the Executive Branch. 141 S. Ct. at 1987. Rather, a presidentially appointed, Senate-confirmed principal officer—namely, the Director of the Patent Office—must have the ability to “review final PTAB decisions and, upon review, [to] issue decisions himself on behalf of the Board.” *Id.* Accordingly, the Supreme Court invalidated the statutory restriction in 35 U.S.C. § 6(c) that had “prevent[ed] the Director from reviewing final decisions rendered by APJs.” *Id.* This remedy, the Court explained, “better reflects the structure of supervision within the PTO and the nature of APJs’ duties.” *Id.*

REASONS FOR DENYING THE PETITION

Infineum argues that this Court's *Arthrex* decision "constitutes an intervening development" that entitles Infineum to vacatur and remand "so that the Federal Circuit may in turn permit Infineum to request Director rehearing of the final written decision." Pet. 14. The problem with Infineum's request is that it did not preserve this argument. Infineum never argued below that the proper remedy for the Appointments Clause violation was a severance of the statutory provision that prohibited the Director from rehearing the Board's decisions. On the contrary, Infineum argued that "there is no permissible interpretation of the statute," Infineum CAFC Br. 49, quoted at App. 21a, and that the *inter partes* proceeding initiated by Chevron Oronite had to be dismissed, App. 21a (citing Infineum CAFC Br. 49). And while Infineum sought to preserve certain issues foreclosed by the Federal Circuit precedent for this Court's review, the choice of a different remedy for the Appointments Clause violation was not one of them. Nor did Infineum reference the then-pending certiorari petition (No. 19-1458) that challenged the sufficiency of the Federal Circuit's remedy. Vacatur and remand are therefore unwarranted.

Infineum's alternative request for a certiorari on the application of the mandate rule fares no better. For starters, the question Infineum urges this Court to review is moot. Because this Court in *Arthrex* prescribed a different remedy for the Appointments Clause violation, it no longer matters whether the Federal Circuit's original remedy (the severance of APJs' removal protections) was effective as of the

date of its *Arthrex* decision or only upon the issuance of the mandate. Infineum's argument is also meritless. The courts of appeals are in agreement that their decisions become circuit law upon issuance; the mandate rule does not detract from that principle, but only governs the scope of the remand proceedings and the application of the law of the case doctrine. In any event, the Federal Circuit's non-precedential disposition did not address this question (nor set binding circuit law), and is therefore a poor vehicle.

A. Infineum Forfeited Its Grant, Vacate, and Remand Request.

This Court has cautioned that its "GVR power should be exercised sparingly." *Lawrence v. Chater*, 516 U.S. 163, 173 (1996) (per curiam). As the Court explained, "[r]espect for lower courts, the public interest in finality of judgments, and concern about our own expanding certiorari docket all counsel against undisciplined GVR'ing." *Id.* at 174. The Court further emphasized that "[j]udicial efficiency and finality are important values, and our GVR power should not be exercised for 'mere convenience.'" *Stutson v. United States*, 516 U.S. 193, 197 (1996) (per curiam) (quoting *Adams v. United States ex rel. McCann*, 317 U.S. 269, 274 (1942)). And Members of this Court have stressed that vacatur and remand are inappropriate "when independent and untainted legal grounds appear to exist that would support the judgment anyway." *Hicks v. United States*, 137 S. Ct. 2000, 2001 (2017) (Gorsuch, J., concurring).

Under this standard, vacatur and remand are inappropriate here. As this Court has explained, a personal constitutional right—including a right to a further review of an administrative law judge's

decision—“is subject to waiver.” *Commodity Futures Trading Comm’n v. Schor*, 478 U.S. 833, 848 (1986) (citations omitted). And the Court “recognized ‘the value of waiver and forfeiture rules,’” *Stern*, 564 U.S. at 481-82 (quoting *Exxon Shipping Co. v. Baker*, 554 U.S. 471, 487-88 n.6 (2008)), which “are part of the machinery by which courts narrow what remains to be decided,” *Exxon*, 554 U.S. at 487 n.6.

Here, Infineum failed to preserve an argument entitling it to the benefit of the remedy this Court prescribed in *Arthrex*. While Infineum did argue below that the Federal Circuit’s remedy—severance of the APJs’ statutory removal protections—did not cure the constitutional defect in their appointment, App. 21a, it did not argue that the proper remedy would be a rehearing of the Board’s decision by the Director. On the contrary, Infineum argued that “there is no permissible interpretation of the statute,” and that the only possible solution was a “remand to the Board with instructions to dismiss the IPR.” App. 21a (quoting Infineum CAFC Br. 49).*

The Supreme Court resolutely rejected such an argument in *Arthrex*. There, too, Arthrex, Inc. asked this Court “to hold the entire regime of inter partes review unconstitutional,” and argued that “the

* In support of its contention that the *inter partes* statute was irredeemably flawed, Infineum argued that the Federal Circuit’s severance of the APJs’ removability protections violates the Administrative Procedure Act. See Infineum CAFC Br. 49-51. That question was not at issue in *Arthrex* (and this Court prescribed a different severance remedy), and is meritless in any event.

appropriate remedy is to order outright dismissal of the proceeding below.” *Arthrex*, 141 S. Ct. at 1986. The Court disagreed, holding that “the structure of the PTO and the governing constitutional principles chart a clear course: Decisions by APJs must be subject to review by the Director” because “Congress vested the Director with the ‘powers and duties’ of the PTO, tasked him with supervising APJs, and placed the PTAB ‘in’ the PTO.” *Id.* (citing 35 U.S.C. § 3(a)(1), § 3(a)(2)(A), § 6(a)). Accordingly, this Court mandated a “tailored” remedy by holding that the statutory restriction in 35 U.S.C. § 6(c) “cannot constitutionally be enforced to the extent that its requirements prevent the Director from reviewing final decisions rendered by APJs.” *Arthrex*, 141 S. Ct. at 1987. Infineum cannot now demand to benefit from the remedy the Supreme Court enacted, when it previously argued that this remedy could not solve the *inter partes* proceedings’ constitutional infirmity.

Infineum did indicate that it was raising some challenges foreclosed by Federal Circuit precedent “in order to preserve its right in the event that these issues are resolved by the Supreme Court.” Infineum CAFC Br. 52, quoted in App. 21a. But the remedy of a Director rehearing was not one of the challenges that Infineum sought to preserve pending this Court’s review. Rather, Infineum sought to preserve “issues [that] are the subject of a [then-pending] petition for writ of certiorari [in] *Arthrex v. Smith & Nephew, Inc.*, 935 F.3d 1319 (Fed. Cir. 2019), *petition for cert. filed*, (U.S. April 9, 2020) (No. 19-1204).” Infineum CAFC Br. 51-52. The petition filed in that case, as well as the underlying Federal Circuit opinion, presented two entirely different questions: (1) “[w]hether the retroactive application of inter

partes review to patents that were applied for before the America Invents act violates the Fifth Amendment,” and (2) “[w]hether a court of appeals can invoke forfeiture principles to refuse to address a constitutional claim in a pending appeal despite an intervening change in law.” Pet. for a Writ of Certiorari at i, *Arthrex v. Smith & Nephew, Inc.*, No. 19-1204 (U.S. Apr. 6, 2020); *see also id.* at 14-33; *Arthrex*, 935 F.3d at 1331-32. The Court denied certiorari in No. 19-1204 on both of those questions, *see Arthrex v. Smith & Nephew, Inc.*, 141 S. Ct. 236 (2020), and neither was at issue in this Court’s *Arthrex* decision where it addressed the issue of the proper remedy for the Appointments Clause violation in the Board’s structure.

In its response brief below, Chevron Oronite pointed out that the certiorari petition referenced in Infineum’s opening brief (No. 19-1204) did not involve the challenge to the sufficiency of the Federal Circuit’s severance remedy (at issue in No. 19-1458), but “challenge[d] only the retroactive application of *inter partes* review and th[e Federal Circuit’s] holding that an Appointments Clause argument may be forfeited if not timely raised on appeal.” Chevron Oronite CAFC Br. 57 n.16 (citing Pet. for a Writ of Certiorari in No. 19-1204 at i). Infineum did not argue in its subsequent reply brief to the Federal Circuit that it inadvertently referenced the wrong certiorari petition.

Infineum cannot now seek to benefit from this Court’s decision prescribing a different statutory remedy for the Appointments Clause violation than the one previously chosen by the Federal Circuit violation when it did not raise that question below. A

remand in these circumstances would only needlessly waste the court of appeals' resources. Vacatur and remand are therefore unwarranted, and this Court should simply deny Infineum's petition.

B. Infineum's Alternative Request for Certiorari Does Not Warrant Review.

As an alternative relief, Infineum urges this Court—in the event it does not order vacatur and remand under *Arthrex*—to grant certiorari to resolve a purported circuit conflict on the application of the mandate rule. Pet. 19. This question is not remotely certworthy, and the petition should be denied.

First, the remedy that this Court prescribed for the Appointments Clause violation—a rehearing of the Board's decision by the Director—supersedes the prior remedy adopted by the Federal Circuit (a rehearing before a new panel composed of three APJs). The Court's *Arthrex* decision makes it clear that the earlier remedy is no longer appropriate: "Because the source of the constitutional violation is the restraint on the review authority of the Director, rather than the appointment of APJs by the Secretary, *Arthrex* is not entitled to a hearing before a new panel of APJs." 141 S. Ct. at 1988 (citing *Lucia*, 138 S. Ct. at 2055-56). Thus, irrespective of whether the Federal Circuit properly refused to grant Infineum a new hearing before a new Board panel even though the Board's decision was issued prior to the Federal Circuit's mandate in *Arthrex*, the question no longer matters. The Federal Circuit is powerless to order that remedy in any event. *See Arthrex*, 141 S. Ct. at 1988. This Court does not grant certiorari "to pass upon the purely artificial and hypothetical issue." *Conway v. California Adult*

Auth., 396 U.S. 107, 110 (1969) (per curiam) (dismissing writ of certiorari). Doing otherwise “would not only in effect be rendering an advisory opinion,” but would also constitute “an unjustifiable intrusion upon the time of this Court.” *Id.*

Second, the decision below is correct, and there is no circuit split (nor conflict with the federal appellate rules). The Federal Circuit properly concluded that its precedential decision in *Arthrex* constituted binding circuit law once it was decided, even though the mandate has not issued. *See* App. 22a (citing *Caterpillar*, 957 F.3d at 1342-43; *Arthrex*, 941 F.3d at 1340). This approach is in full alignment with the view of the other courts of appeals. As the Ninth Circuit explained, “[u]nder [the] ‘law of the circuit doctrine,’ a published decision of this court constitutes binding authority ‘which must be followed unless and until overruled by a body competent to do so.’” *In re Zermeno-Gomez*, 868 F.3d 1048, 1052 (9th Cir. 2017) (quoting *Gonzalez v. Arizona*, 677 F.3d 383, 389 n.4 (9th Cir. 2012) (en banc)) (select internal quotation marks and citation omitted). As the court observed, even “a stay of the mandate does not destroy the finality of an appellate court’s judgment,” which remains “final for such purposes as stare decisis, and full faith and credit, unless it is withdrawn by the court.” *In re Zermeno-Gomez*, 868 F.3d at 1052 (citations omitted). The Ninth Circuit accordingly rejected as “mistaken” the “suggesti[on] that a decision is not binding on lower courts until the mandate has issued.” *Id.*

Here, too, the Federal Circuit’s precedential *Arthrex* decision became law of the circuit and binding on courts and agencies subject to that court’s

appellate jurisdiction once it was issued on October 31, 2019. The fact that the Federal Circuit's mandate has not yet issued is of no moment. In fact, the mandate would not issue for nearly five months, as the Federal Circuit was considering petitions for rehearing and rehearing en banc filed by the parties. *See Arthrex, Inc. v. Smith & Nephew, Inc.*, 953 F.3d 760, 761 (Fed. Cir. 2020) (en banc) (denying rehearing and directing that “[t]he mandate of the court will issue on March 30, 2020). There is no reason—in law or in logic—for a precedential appellate decision to be denied legal effect in other cases while the court of appeals entertains petitions for rehearing.

Infineum also provides no reason why it could not inform the Board about the Federal Circuit's *Arthrex* decision once it was issued. Infineum could have requested a new hearing before a new Board panel at that time. Instead, it chose to await the issuance of the Board's decision, and sought a new hearing only once that decision did not turn in its favor. Permitting this type of gamesmanship would only encourage litigants to “sandbag[] the court” (or the agency) by “remaining silent about his objection and belatedly raising the error only if the case does not conclude in his favor.” *Stern*, 564 U.S. at 482 (citation and selected internal quotation marks omitted).

The cases Infineum invokes, *see* Pet. 15-17, are inapposite. They stand for the unremarkable proposition that, until the appellate mandate has issued, the decision may still be modified on rehearing and does not become the law of the case and binding on the court (or agency) below *in that*

case (because the jurisdiction does not return to the district court until the mandate issues). *See, e.g., In re Zermeno-Gomez*, 868 F.3d at 1053. Nor, contrary to Infineum's contention, *see* Pet. 17, is there any conflict with Federal Rule of Appellate Procedure 41. While that rule provides that a court of appeals' judgment or order becomes final, and fixes the parties' obligations in that case, once the mandate issues, Fed. R. App. 41(c) advisory committee's note to 1998 amendment, that "ha[s] no bearing on ... whether a published decision that has not been modified or withdrawn is binding on lower courts within the circuit." *In re Zermeno-Gomez*, 868 F.3d at 1053.

Finally, this case would be a poor vehicle to address the question presented. Not only is the question effectively moot, *see supra* at 13-14, but the decision below is non-precedential and does not contain any substantive discussion of the mandate rule and its interaction with the principle that a court of appeals' decision becomes binding on lower courts (and agencies) when issued. Even if, despite the lack of disagreement among the lower courts on this well-settled issue, this Court is inclined to revisit this question, it should await a case where the question would be squarely presented.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted,

NAVEEN MODI

COUNSEL OF RECORD

STEPHEN B. KINNAIRD

IGOR V. TIMOFEYEV

DANIEL ZEILBERGER

PAUL HASTINGS LLP

2050 M Street, N.W.

Washington, D.C. 20036

(202) 551-1700

naveenmodi@paulhastings.com

Counsel for Respondent

Chevron Oronite

Company LLC

November 2021