

No. 21-819

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IN THE  
**Supreme Court of the United States**

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BAXTER CORPORATION ENGLEWOOD,  
*Petitioner,*

v.

BECTON, DICKINSON AND COMPANY,  
*Respondent.*

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**On Petition for a Writ of Certiorari  
to the United States Court of Appeals  
for the Federal Circuit**

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**BRIEF OF SAURABH VISHNUBHAKAT  
AS *AMICUS CURIAE*  
IN SUPPORT OF PETITIONER**

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## INTEREST OF *AMICUS CURIAE*<sup>1</sup>

*Amicus curiae* Saurabh Vishnubhakat is a professor who writes and teaches on, among other things, the intersection of intellectual property and administrative law. He is currently a Professor of Law at the Texas A&M University School of Law and has been appointed to the faculty of the Benjamin N. Cardozo School of Law. He previously served as faculty fellow at Duke Law School, where he taught patent law, and as a researcher in the Duke Center for Public Genomics, where he studied the administrative process of patent examination in biological and software informatics innovation. Further, he began his legal career as an advisor at the United States Patent and Trademark Office (“PTO”), where he counseled the agency’s chief economist on intellectual property policy.

Professor Vishnubhakat’s interest in the case arises from his commitment to improving doctrinal clarity in patent law and in administrative law. This brief borrows from his scholarship, including *Disguised Patent Policymaking*, 76 Wash. & Lee L. Rev. 1667 (2019); *Renewed Efficiency in Administrative Patent Revocation*, 104 Iowa L. Rev. 2643 (2019); and *Strategic Decision Making in Dual PTAB and District Court Proceedings*, 31 Berkeley Tech. L.J. 45 (2016) (with Arti K. Rai & Jay P. Kesan).

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<sup>1</sup> Pursuant to Supreme Court Rule 37.6, counsel for *amicus* represent that they authored this brief in its entirety and that none of the parties or their counsel, nor any other person or entity other than *amicus* or his counsel, made a monetary contribution intended to fund the preparation or submission of this brief. Pursuant to Rule 37.2(a), counsel for *amicus* also represent that all parties were provided notice of *amicus*’s intention to file this brief at least 10 days before its due date and that the parties have consented to the filing of this brief.

## SUMMARY OF ARGUMENT

Nearly 80 years ago, this Court set forth “a simple but fundamental rule of administrative law”: “a reviewing court, in dealing with a determination or judgment which an administrative agency alone is authorized to make, must judge the propriety of such action solely by the grounds invoked by the agency.” *SEC v. Chenery Corp.*, 332 U.S. 194, 196 (1947) (“*Chenery II*”) (citing *SEC v. Chenery Corp.*, 318 U.S. 80 (1943) (“*Chenery I*”). The Court should grant the petition as to the second question presented because the Federal Circuit routinely ignores that rule’s equally fundamental corollary, the ordinary remand rule, in its review of decisions by the Patent Trial and Appeal Board (“PTAB”).<sup>2</sup>

The ordinary remand rule provides that, if a court concludes that the grounds given for agency action are erroneous, it generally should remand to the agency any unsettled issues committed to it by statute. As petitioner explains (at 28-33), the Federal Circuit has made an unreasoned departure from that principle – taking it upon itself to decide questions of patentability that rightly are the PTAB’s to resolve. It has never reconciled that practice with this Court’s precedent, and that cannot be done. That the Federal Circuit has once again broken from the “uniform approach to judicial review of administrative action” to which this Court has long been committed, *Dickinson v. Zurko*, 527 U.S. 150, 154 (1999), is reason enough to grant review.

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<sup>2</sup> *Amicus* takes no position on the first question presented or on the merits of the underlying case.



But the reasons to do so extend well beyond the restoration of uniformity for its own sake. As this Court recognized in the *Chenery* cases and has repeatedly underscored since, the ordinary remand rule’s roots run to a constitutional principle that is no less vital for its obviousness: where Congress has exercised its prerogatives to assign a particular judgment to an administrative agency, a court cannot exercise that judgment without arrogating to itself power it does not have. That the Federal Circuit has nevertheless taken to deciding disputes that Congress entrusted to the PTAB is thus no mere patent-law curiosity. It instead threatens core separation-of-powers values – and it echoes prior instances in which the Federal Circuit has erroneously exceeded generally applicable limitations on appellate courts’ powers. Because that error requires correction, the Court should grant certiorari.

## ARGUMENT

### I. THE ORDINARY REMAND RULE IS A BEDROCK PRINCIPLE OF ADMINISTRATIVE LAW

#### A. Separation-of-Powers Principles Ordinarily Require Agencies, Not Courts, To Address Questions Committed to Their Judgment Following Reversal

Throughout the existence of the modern administrative state, this Court has consistently and unambiguously held that, “[g]enerally speaking, a court of appeals should remand a case to an agency for decision of a matter that statutes place primarily in agency hands.” *INS v. Orlando Ventura*, 537 U.S. 12, 16 (2002) (per curiam). Separation-of-powers principles have underpinned that rule from its creation and have consistently informed its application.

1. The ordinary remand rule follows from the familiar principle that “[t]he grounds upon which an administrative order must be judged are those upon which the record discloses that its action was based.” *Chenery I*, 318 U.S. at 87. From the beginning, the Court has justified both rules as necessary to prevent the judiciary from exercising power that Congress has instead given to an agency.

Indeed, the *Chenery I* Court arrived at its eponymous principle of administrative law in that way. It started by analogy to the established rule that, “where the correctness of [a] lower court’s decision depends upon a determination of fact which only a jury could make but which has not been made, the appellate court cannot take the place of the jury.” *Id.* at 88. For similar reasons, the Court held that, “[i]f an order is valid only as a determination of policy or judgment which the agency alone is authorized to make and which it has not made, a judicial judgment cannot be made to do service for an administrative judgment.” *Id.* Irrespective of a case’s disposition, the Court explained, “an appellate court cannot intrude upon the domain which Congress has exclusively entrusted to an administrative agency.” *Id.*

The Court echoed this same focus in setting forth the ordinary remand rule in *Chenery II*. “If th[e] grounds [invoked by an agency] are inadequate or improper,” the Court underscored, “the court is powerless to affirm the administrative action by substituting what it considers to be a more adequate or proper basis. To do so would propel the court into the domain which Congress has set aside exclusively for the administrative agency.” 332 U.S. at 196.

The Court’s modern cases on the rule are shot through with these same separation-of-powers

concerns. In *Orlando Ventura*, for example, a court of appeals had rejected the basis of an agency adjudication, yet proceeded to resolve an issue the agency had not yet addressed. 537 U.S. at 15-16. In a per curiam opinion without noted dissent, the Court reversed. It explained that the court of appeals had “seriously disregarded the agency’s legally mandated role,” and thereby intruded into “a highly complex and sensitive matter” properly within the agency’s “own expertise.” *Id.* at 17. When that same court of appeals committed that same error thereafter, the Court summarily vacated and remanded for much the same reasons. *See Gonzales v. Thomas*, 547 U.S. 183, 187 (2006) (per curiam). And in *Smith v. Berryhill*, 139 S. Ct. 1765 (2019), the Court again reiterated the rule in terms emphasizing Congress’s prerogative to delegate certain questions to agencies, rather than leaving them to courts. *See id.* at 1779 (“Fundamental principles of administrative law . . . teach that a federal court generally goes astray if it decides a question that has been delegated to an agency if that agency has not first had a chance to address the question.”).

2. To be sure, the rule has functional benefits, as well – particularly in circumstances that call for the application of an agency’s expertise. In cases that turn on the reasonableness of an agency’s interpretation of an ambiguous statute, the “remand rule” is prudent because resolving statutory ambiguity “involves difficult policy choices that agencies are better equipped to make than courts.” *Negusie v. Holder*, 555 U.S. 511, 523 (2009) (quoting *National Cable & Telecomms. Ass’n v. Brand X Internet Servs.*, 545 U.S. 967, 980 (2005)). And in adjudications, an expert agency’s weighing of evidence and initial

determination of a case “can, through informed discussion and analysis, help a court later determine whether its decision exceeds the leeway that the law provides.” *Orlando Ventura*, 537 U.S. at 17. These benefits complement the constitutional point the Court made in announcing the rule decades ago and in enforcing it since.

The rule’s constitutional basis does not require courts to apply it inflexibly. As the Court has long recognized, “rare circumstances” may justify an exception. *Florida Power & Light Co. v. Lorion*, 470 U.S. 729, 744 (1985). Several such exceptions are plausibly compatible with the separation-of-powers principles set forth above. See Christopher J. Walker & James R. Saywell, *Remand and Dialogue in Administrative Law*, 89 Geo. Wash. L. Rev. 1198, 1216-17 (2021) (listing possibilities, including cases of harmless error). In the main, however, a court that refuses to abide the ordinary remand rule “frustrates the balance of powers between all three branches, as it was Congress in the first place that charged the Executive to interpret and implement the statute.” Christopher J. Walker, *The Ordinary Remand Rule and the Judicial Toolbox for Agency Dialogue*, 82 Geo. Wash. L. Rev. 1553, 1565 (2014).

### **B. Lower Courts, in General, Faithfully Apply the Ordinary Remand Rule**

Prevailing practice among the circuits is faithful to this Court’s precedent. The only published systematic study of the question was published in 2014. Its author examined every court of appeals decision between 2002 and 2012 that cited *Orlando Ventura*, *Thomas*, or *Negusie* for their articulations of the remand rule. The study showed that “most circuits, most of the time, faithfully followed the remand

rule.” Walker, *The Ordinary Remand Rule and the Judicial Toolbox for Agency Dialogue*, 82 Geo. Wash. L. Rev. at 1581. In many instances, the courts that did not remand understood themselves to have found the “rare circumstances” justifying an exception from it. *Id.* at 1582 (identifying cases). Further, about “80 percent of the total number of decisions refusing to remand” were accounted for by the single court of appeals that heard “the bulk of immigration adjudication petitions each year” (and whose decisions in such cases had been reversed in *Orlando Ventura* and *Thomas*). *Id.* at 1584-85.

*Amicus* is aware of no evidence that any other court of appeals has, in practice, categorically exempted a particular agency from the ordinary remand rule, as the Federal Circuit effectively has the PTAB.

## **II. THE FEDERAL CIRCUIT HAS ERRED IN FAILING TO APPLY THE ORDINARY REMAND RULE IN APPEALS FROM THE PTAB’S IPR DECISIONS**

The Federal Circuit has nevertheless often resolved PTAB appeals in a manner irreconcilable with the ordinary remand rule. As petitioner explains (at 28-32), that Court commonly goes beyond “the grounds invoked by” the PTAB, *Chenery II*, 332 U.S. at 196, and instead itself resolves factual and legal disputes on which the PTAB did not pass that are material to the ultimate patentability determination. Yet nothing justifies treating the PTAB differently from any other agency body in this respect. On the contrary, for many reasons, its decisions in inter partes review (“IPR”) cases are among the best candidates for the rule’s application.

**A. The Separation-of-Powers Principles That Animate the Ordinary Remand Rule Apply with Acute Force to the PTAB**

1. The Intellectual Property Clause grants Congress the power “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.” Art. I, § 8, cl. 8. Congress, in turn, has given the power to determine whether an invention is patentable in the first instance to the PTO. *See* 35 U.S.C. §§ 1(a), 2(a)(1).

A third party can challenge the validity of a previously issued patent in multiple ways. One way – and, for many years, the conventional way – is as a defense in infringement litigation. *See id.* § 282(b)(2). Another is in proceedings before the PTAB, “an executive adjudicatory body within the PTO established by the Leahy-Smith America Invents Act of 2011” (“AIA”). *United States v. Arthrex, Inc.*, 141 S. Ct. 1970, 1977 (2021) (citing Pub. L. No. 112-29, § 7(a)(1), 125 Stat. 284, 313).

This case concerns one variety of PTAB proceedings known as inter partes review. An IPR “allows third parties to challenge patent claims on grounds of invalidity specified by statute.” *Thryv, Inc. v. Click-To-Call Techs., LP*, 140 S. Ct. 1367, 1370 (2020). It “is an adversarial process by which members of the PTAB reconsider whether existing patents satisfy the novelty and nonobviousness requirements for inventions.” *Arthrex*, 141 S. Ct. at 1977; *see generally* 35 U.S.C. §§ 102 (claimed invention not patentable unless it is novel), 103 (claimed invention not patentable if would have been obvious to a person having ordinary skill in the art).

An IPR begins after a person (other than the patent's owner) petitions for one and the PTAB (by delegation from the PTO's Director) "determines that the petitioner is reasonably likely to prevail on at least one challenged patent claim." *Arthrex*, 141 S. Ct. at 1977. The decision whether to institute an IPR is not subject to judicial review. *See* 35 U.S.C. § 314(d).

A panel of the PTAB's members is then assembled, and "the matter proceeds before the [PTAB] with many of the usual trappings of litigation," such as discovery, briefing, and oral argument. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1353-54 (2018). When it resolves an IPR, the PTAB is required to "issue a final written decision with respect to the patentability of" the challenged claims. 35 U.S.C. § 318(a).

Congress deliberately designed IPRs to improve upon federal-court litigation in two respects. The first is expertise: the PTAB's administrative patent judges (unlike federal judges) are required by statute to "be persons of competent legal knowledge and scientific ability." *Id.* § 6(a). The second is efficiency: IPRs must be completed no later than 18 months after their institution. *See id.* § 316; *see also* H.R. Rep. No. 112-98, pt. 1, at 40 (2011) ("The legislation is designed to establish a more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs."), *reprinted in* 2011 U.S.C.C.A.N. 67, 69. These redound to the benefit not only of the parties, but also of the public. "By providing for inter partes review, Congress, concerned about overpatenting and its diminishment of competition, sought to weed out bad patent claims efficiently." *Thryv*, 140 S. Ct. at 1374; *see also Precision Instrument Mfg. Co. v. Automotive Maint. Mach. Co.*, 324 U.S. 806, 816 (1945)

(noting the public’s “paramount interest in seeing that patent monopolies . . . are kept within their legitimate scope”).

Empirical research examining a subset of recent cases suggests that this effort at efficient court-agency substitution has been successful. Of the patents challenged in AIA trial proceedings, 86.8% were also litigated in the U.S. district courts. *See* Saurabh Vishnubhakat, Arti K. Rai & Jay P. Kesan, *Strategic Decision Making in Dual PTAB and District Court Proceedings*, 31 Berkeley Tech. L.J. 45, 69 (2016). Likewise, 70% of IPR petitioners were also previously sued in a U.S. district court proceeding on the same patent. *See id.* at 73.

A losing party may appeal to the Federal Circuit. It, in turn, “reviews the PTAB’s application of patentability standards *de novo* and its underlying factual determinations for substantial evidence.” *Arthrex*, 141 S. Ct. at 1977-78 (citing *Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC*, 138 S. Ct. 1365, 1371-72 (2018)).

**2.** Several features of the PTAB compel the conclusion that the ordinary remand rule applies with full force in IPR cases.

**a.** To start, appeals from the PTAB’s IPR decisions directly implicate *Chenery II*’s core insight – that the ordinary remand rule prevents a court from interfering with a “domain which Congress has set aside exclusively for the administrative agency.” 332 U.S. at 196. From beginning (an unreviewable case-selection mechanism) to end (an appeal subject to a deferential standard of review for factual findings), IPR proceedings are the product of Congress’s design to create “credible substitutes for the federal courts in adjudicating patent validity.” Vishnubhakat,



*Renewed Efficiency in Administrative Patent Revocation*, 104 Iowa L. Rev. at 2644. One would be therefore hard-pressed to find a clearer statutory case for the application of the ordinary remand rule: the judiciary cannot make decisions that Congress entrusted to the PTAB without undermining that basic feature of the AIA.

That is all the more true in view of peculiar qualities of Congress's power under the Intellectual Property Clause highlighted in *Oil States*. In holding there that Article III does not preclude Congress from assigning the resolution of patent-revocation disputes to the PTAB (rather than to an Article III court), the Court heavily relied on the fact that patent rights are granted by Congress's grace – indeed, Congress may both “grant patents itself by statute” and “authorize[] the Executive Branch” to do so. 138 S. Ct. at 1374-75. From that discretion it followed, the Court held, that Congress is free to provide for patent-revocation disputes to be resolved outside of Article III courts in the first instance. *See id.*

Appellate courts should thus be especially reluctant to invade the particular “domain which Congress has set aside” for the PTAB. *Chenery II*, 332 U.S. at 196. *Oil States*, that is, establishes that Congress enjoys such latitude to decide how patents may be revoked that it may altogether excise Article III courts from at least the trial stage of such a proceeding.<sup>3</sup> The Federal Circuit's departure from the ordinary remand

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<sup>3</sup> The *Oil States* Court reserved the question “whether inter partes review would be constitutional ‘without any sort of intervention by a court at any stage of the proceedings.’” 138 S. Ct. at 1379 (quoting *Atlas Roofing Co. v. OSHRC*, 430 U.S. 442, 455 n.13 (1977)).

rule therefore starkly illustrates the separation-of-powers concerns that motivated the *Chenery* decisions: “an appellate court” is “intrud[ing] upon the domain which Congress has exclusively entrusted to an administrative agency” and in an area in which Congress’s rightful powers to limit the judiciary’s role are at their acme. *Chenery I*, 318 U.S. at 88.

A rule requiring remand to the PTAB promotes a related value furthered by the *Chenery* cases: that decisions within an agency’s authority should be made by politically accountable actors. See Kevin M. Stack, *The Constitutional Foundations of Chenery*, 116 Yale L.J. 952, 993 (2007) (“Whether one understands accountability as the extent to which the decision-maker can be ‘monitored and controlled,’ or as the connection between the decision-maker and the people, the *Chenery* principle promotes agency accountability.”) (footnote omitted). Just last Term, all members of the Court agreed in *Arthrex* on the importance of political accountability in patent adjudications (even as they disagreed about “*what sort of political discipline [the Constitution] requires*”). Tejas N. Narechania, *Arthrex and the Politics of Patents*, 12 Calif. L. Rev. Online 65 (2022). Setting aside disputes about how best to structure the Executive Branch itself so as to ensure political accountability, it in no sense serves that end to permit appellate courts to decide questions Congress entrusted to the Executive Branch.

Constitutional concerns aside, the Federal Circuit’s practice also disregards important benefits the rule is designed to secure: it intrudes into “a highly complex and sensitive matter” properly within the PTAB’s “expertise.” *Orlando Ventura*, 537 U.S. at 17. That is, because it prevents the PTAB’s adminis-

trative judges from deploying their comparatively greater expertise – especially in technical fields in which federal judges are generally not experts – it invites unnecessary error and process costs. *Cf. id.* (agency decision on remand “can, through informed discussion and analysis, help a court later determine whether its decision exceeds the leeway that the law provides”).

**b.** The PTAB’s IPR proceedings warrant particular judicial respect in light of the formality with which they are conducted.

Most agencies rarely conduct “formal” adjudications in the sense envisioned by the Administrative Procedure Act (“APA”) – those that bear many of the features of a civil bench trial. *See* 5 U.S.C. §§ 554-557 (setting forth the robust procedures that govern these adjudications). Instead, “Congress and agencies often deviate from the APA’s formal adjudication requirements,” including for reasons of “administrative convenience, the need to address high caseloads, and the desire to craft more protective procedures for specific populations appearing before federal agencies.” Cong. Rsch. Serv., *Informal Administrative Adjudication: An Overview* 1 (Oct. 1, 2021) (footnotes omitted), <https://crsreports.congress.gov/product/pdf/R/R46930>. Accordingly, most agency adjudications – a proportion perhaps as high as 90% – are conducted entirely outside the APA’s formal adjudication framework. *See* Christopher J. Walker & Melissa F. Wasserman, *The New World of Agency Adjudication*, 107 Calif. L. Rev. 141, 153-55 (2019).

For these reasons, the Administrative Conference of the United States has jettisoned the traditional formal/informal dichotomy for a more helpful three-part taxonomy of administrative evidentiary hearings.

“Type A” proceedings are those conducted under the APA; “Type B” adjudications “consist[] of legally required evidentiary hearings that are not regulated by” the APA’s formal-adjudication regime; and “Type C” proceedings are those “not subject to a legally required . . . evidentiary hearing” at all. Notice, Adoption of Recommendations, 81 Fed. Reg. 94,312, 94,314-15 (Dec. 23, 2016).

The PTAB’s IPR proceedings are an especially formal flavor of “Type B” adjudications. To be sure, as the Court has recognized, an IPR “is less like a judicial proceeding and more like a specialized agency proceeding.” *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 279 (2016). But “PTAB adjudication embraces the vast majority of best practices that have been identified for any adjudication that requires an evidentiary hearing.” Walker & Wasserman, *The New World of Agency Adjudication*, 107 Calif. L. Rev. at 162. Indeed, in certain respects it even has “the hallmarks of APA-governed formal adjudication,” *id.* at 163, including the right to counsel, *see* 37 C.F.R. § 42.10; formal written motion practice, *see id.* §§ 42.20-42.25; pretrial discovery, *see id.* §§ 42.51-42.65; and a right to oral argument, *see id.* §§ 42.70-42.74.

The procedures that govern IPRs reinforce the prudential case for applying the ordinary remand rule. The unusual formality of the PTAB’s adversarial procedures ensures that the PTAB is ideally positioned to apply its expertise. Accordingly, the practice of remanding unsettled questions to the PTAB is likely to in fact yield the benefits the ordinary remand rule promises.

**B. The Federal Circuit’s Failure To Adhere to the Ordinary Remand Rule Echoes Prior Departures from General Principles Governing Appellate Review**

The Federal Circuit’s error in this case echoes a number of others in which that court has improperly disregarded an important trans-substantive principle.

1. The practice at issue here closely resembles the one this Court corrected in *Dickinson*. The question there concerned the appropriate appellate standard of review for the PTO’s findings of fact in connection with patent denials: the generally applicable APA rule permitting vacatur of agency findings if they are arbitrary and capricious or are unsupported by substantial evidence, *see* 5 U.S.C. § 706(2)(A), (E), or the Federal Circuit’s stricter rule permitting it to set aside those findings (like those of a district court) for clear error. *See* 527 U.S. at 152-53. Emphasizing “the importance of maintaining a uniform approach to judicial review of administrative action,” the Court unanimously held that the Federal Circuit had erred by carving out for itself “an exception to that uniformity.” *Id.* at 154-55.

Of particular relevance here is the Court’s rejection of one purported policy justification for the Federal Circuit’s anomalous practice. The Circuit had reasoned that applying its stricter standard would “produce better agency factfinding” – in other words, the theory went, knowing that its decisions would face scrutiny more searching than that of other agencies would encourage the PTO to do better work. *Id.* at 165. But, as the Court recognized, it is the business of Congress (not the courts) to decide upon the standard of review for agency findings of fact, and there is no convincing reason “why direct review

of the PTO’s patent denials demands a stricter fact-related review standard than” the one Congress “set forth . . . in the APA.” *Id.*

That reasoning is only reinforced by the separation-of-powers principles set forth above. Again, though possibly subject to outer limits, see *Oil States*, 138 S. Ct. at 1379, Congress’s discretion regarding what degree of judicial review is appropriate for a given agency judgment is wide. This Court appropriately recognized in *Dickinson* that that is no less true of the PTO than of other agencies and that there is thus no justification for heightened judicial scrutiny of the PTO’s findings of fact. For the reasons explained, the same principle supports applying the ordinary remand rule to the PTAB’s decisions.

2. The Federal Circuit’s departure from the ordinary remand rule echoes as well other instances in which this Court has rejected Federal Circuit rules that threaten the “general consistency across substantive fields of law.” Tejas N. Narechania, *Certiorari, Universality, and a Patent Puzzle*, 116 Mich. L. Rev. 1345, 1349 (2018).

Noteworthy here, the Court has on multiple occasions corrected Federal Circuit standards that restricted others’ authority or discretion to decide significant issues in patent disputes. *Dickinson* is just one of many examples. In *eBay Inc. v. Merc-Exchange, L.L.C.*, 547 U.S. 388 (2006), the Court rejected the Circuit’s patent-case-specific rule governing the issuance of permanent injunctions as an impermissible departure from “well-established principles of equity,” which commit that question to the district court’s discretion. *Id.* at 391. In *Octane Fitness, LLC v. ICON Health & Fitness, Inc.*, 572 U.S. 545 (2014), and *Highmark Inc. v. Allcare Health*

*Management System, Inc.*, 572 U.S. 559 (2014), the Court restored to district courts their discretion regarding whether a patent case is sufficiently “exceptional” to warrant an attorney fees award, 35 U.S.C. § 285 – rejecting (in *Octane Fitness*) the Federal Circuit’s precedent limiting that discretion and (in *Highmark*) its assertion of the power to review exceptional-case determinations *de novo*. And in *Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.*, 574 U.S. 318 (2015), the Court held that findings of fact that underlie a district court’s claim-construction decisions (like other findings of fact) are to be reviewed only for clear error – not, as the Federal Circuit had (again) held, *de novo*. *Id.* at 333.

In each of these cases, the Federal Circuit had set aside generally applicable rules of law in favor of a standard that tipped the balance of decision-making authority in patent disputes in the direction of the court of appeals. In each of these cases, this Court granted certiorari to consider the appropriateness of the standard the Federal Circuit had adopted. And in each of these cases, the Court restored the uniformity that the Federal Circuit had disrupted. *See also SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC*, 137 S. Ct. 954, 963-64 (2017) (“[P]atent law is governed by the same common-law principles, methods of statutory interpretation, procedural rules as other areas of civil litigation.”).

The same should be true here: the Federal Circuit’s anomalous invasion of the PTAB’s lawful authority in IPRs will persist until this Court corrects it. Because this case presents an opportunity to do so, the Court should grant the petition as to at least that question.

**CONCLUSION**

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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