No. 24-1280

IN THE

Supreme Court of the United States

GESTURE TECHNOLOGY PARTNERS, LLC,

Petitioner,

v.

APPLE INC., LG ELECTRONICS INC., LG ELECTRONICS USA, INC., GOOGLE LLC, AND ACTING DIRECTOR OF THE U.S. PATENT AND TRADEMARK OFFICE,

Respondents.

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

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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QUESTION PRESENTED

In *Oil States Energy Services, LLC v. Greene's Energy Group, LLC*, 584 U.S. 325 (2018), this Court confirmed that inter partes review, a statutory process by which the Patent Office reviews the validity of a patent the agency previously granted, complies with Article III and the Seventh Amendment. *Id.* at 345. The Court held "that the decision to grant a patent is a matter involving public rights—specifically, the grant of a public franchise," and the Patent Office's reconsideration of that grant "falls squarely within the public-rights doctrine." *Id.* at 334-36. Petitioner Gesture Technology Partners, LLC ("Gesture"), does not challenge that holding. Instead, Gesture asks the Court to add a caveat that post-issuance review falls squarely within the public-rights doctrine, *but only for non-expired patents*. Expired patents, however, retain their character as a public monopoly because they are enforceable against the public for past infringement that occurred before the patent expired.

The question presented is whether, consistent with this Court's unchallenged holding in *Oil States*, Congress may constitutionally authorize the Patent Office to reconsider its prior grant of patent rights, regardless of whether the patent has expired?

CORPORATE DISCLOSURE STATEMENT

Respondent Apple Inc. has no parent corporation. No publicly held corporation owns 10% or more of Apple Inc.'s stock.

LG Corporation owns 10% or more of Respondent LG Electronics Inc., which is a publicly held Korean corporation. LG Electronics Inc. owns 10% or more of Respondent LG Electronics USA Inc.

Respondent Google LLC is a subsidiary of XXVI Holdings Inc., which is a subsidiary of Alphabet Inc., a publicly traded company. No publicly held company owns more than 10% of Alphabet Inc.'s stock.

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INTRODUCTION

The petition seeks review of a question this Court already resolved and on which no Federal Circuit judge has since expressed disagreement. It fails to demonstrate any error in the decision below, much less one that warrants this Court's intervention. In reviewing the Patent Office's decisions on Petitioner Gesture's patent claims, the Federal Circuit faithfully applied this Court's recent decision in *Oil States Energy Services, LLC v. Greene's Energy Group*, 584 U.S. 325 (2018). In *Oil States*, this Court concluded that Congress could constitutionally authorize the Patent Office to take a "'second look'" at the original issuance of a patent and cancel any patent claims that it determined should not have issued in the first place. *Id.* at 336-37. That is what happened here.

Gesture sued several companies—including private-party Respondents here—for allegedly infringing a host of claims across several of its patents. It filed those lawsuits after its patents had expired, but sought damages for alleged infringement that occurred during the time they were in force. Gesture was limited to damages for pre-expiration infringement, because a patent grants rights to its holder only during its lifetime (rights that can be enforced up to six years after the alleged infringement occurs). 35 U.S.C. § 286. In response to Gesture's filings, the private-party Respondents availed themselves of the inter partes review process Congress enacted more than a decade ago as part of its effort to weed out bad patents and provide a more efficient procedure for determining patent validity. The Patent Office reviewed Gesture's patents and determined in each proceeding, based on information that it did not have when it first examined them, that many of Gesture's patent claims should not have issued.

On appeal, Gesture insisted that the inter partes review proceedings were constitutionally infirm. But Gesture does not ask this Court to overturn *Oil States* or its holding. Instead, Gesture's position rests entirely on a false distinction between patents that expire before an inter partes review begins and those that have not yet expired. In Gesture's view, an expired patent immediately transforms into a species of private property that it insists an agency cannot touch, whatever its power over patents may otherwise be. Both the Patent Office and the Federal Circuit properly rejected that view, applying *Oil States*.

Undaunted, Gesture presses the same flawed constitutional arguments here. They meet the same obstacle: *Oil States* did not, as Gesture suggests, turn on any "ongoing," prospective existence of a patent, nor did it leave open the question Gesture claims is unresolved. *Oil States* definitively concluded that the grant of a patent involves public rights to exclude the general populace from otherwise lawful activity, and that any private property rights conferred by the patent are limited by the public nature of the franchise.

As a result, the patentee's private property interest in the patent is always limited by the conditions that Congress has placed on the public monopoly. One of those conditions is the Patent Office's authority to reconsider the propriety of the original decision to grant those public rights to a patentee. Such reconsideration therefore can be conducted by an executive agency rather than an Article III court without offending the separation of powers or the Seventh Amendment.

In sum, *Oil States* recognized (as Gesture implicitly concedes) that any enforcement of a patent is an exertion of a public franchise, and that such public rights are always conditional on the grantor's ability to reconsider and revoke the rights conferred. Gesture nowhere explains how any of that changes upon expiration of the patent. The Board's reconsideration of whether an expired patent should have been granted in the first place remains a matter of public rights because it concerns the propriety of the original grant. *Oil States*, 584 U.S. at 334-37. And Gesture's suggestion that an expired patent loses its public-rights character is misconceived: An expired patent remains a government-granted property right that is enforceable against other members of the public as to infringement that occurred before expiration. The public therefore retains a strong interest in whether expired patents were properly granted, and Gesture suggests no reason that Article III would permit the executive to reconsider the validity of patents during their term but not afterward. The Court should deny the petition.

STATEMENT OF THE CASE

The Patent Office issues time-limited monopolies

A patent, by its nature, is a time-limited monopoly granted by the federal government. The Constitution gives Congress the power to "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." U.S. Const. art. I, § 8, cl. 8. Exercising that power, Congress decreed that inventors of "new and useful" processes and products "may obtain a patent therefor, subject to the conditions and requirements" spelled out in Title 35 of the U.S. Code. 35 U.S.C. § 101. And it created the Patent Office to oversee "the granting and issuing of patents" and the enforcement of those conditions and requirements. *Id.* § 2(a)(1).

"Patents endow their holders with certain superpowers." *Kimble v. Marvel Ent., LLC*, 576 U.S. 446, 451 (2015). An inventor who is "willing to reveal to the public the substance of his discovery … is granted 'the right to exclude others from making, using, or selling the invention throughout the United States.'" *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 150 (1989) (citations omitted). This powerful right is time-limited, however. *Kimble*, 576 U.S. at 451. One of the conditions of a patent is its term—typically twenty years from the date of the inventor's patent application. 35 U.S.C. § 154(a)(2). That bargain—exchanging disclosure of an invention for a "public franchise" monopolizing its use for a time, *Oil States*, 584 U.S. at 338—represents Congress's chosen "balance between fostering innovation and ensuring public access to discoveries." *Kimble*, 576 U.S. at 451.

A patentee may enforce its public franchise through a civil action against those who infringe upon the exclusionary rights provided. 35 U.S.C. § 271. Notably, this enforcement right does not end upon expiration of the patent, but enforcement at that point covers only conduct that occurred before the patent expired. While the monopoly period ends with the patent's expiration, meaning prospective injunctive relief is available only before then, a patentee may seek damages later for pre-expiration infringement. Specifically, damages (along with any applicable interest and fees) may be collected for a period of "six years prior to the filing of the complaint." *Id.* § 286; *see generally id.* §§ 283-287. This six-year limitations period allows enforcement of an expired patent against pre-expiration conduct. Given the damages look-back period, it is not uncommon for patent holders to file or maintain infringement suits after the expiration date of their patent.[1]

Congress created formal procedures permitting the public to ask the Patent Office to reconsider issued patents

Because a patent represents a government-sanctioned and legally enforceable intrusion on the public's otherwise free right to use the technology disclosed, "[t]he possession and assertion of patent rights are 'issues of great moment to the public.'" *Precision Instrument Mfg. Co. v. Auto. Maint. Mach. Co.*, 324 U.S. 806, 815 (1945) (quoting *Hazel-Atlas Glass Co. v. Hartford-Empire Co.*, 322 U.S. 238, 246 (1944)). "The far-reaching social and economic consequences of a patent … give the public a paramount interest in

[1] *Cf.* Brian J. Love, *An Empirical Study of Patent Litigation Timing: Could a Patent Term Reduction Decimate Trolls Without Harming Innovators?*, 161 U. Pa. L. Rev. 1309, 1317-18 (2013) (identifying 1,180 expired patents from a 12-month issuance period alone that were asserted in litigation).

seeing that patent monopolies … are kept within their legitimate scope." *Id.* at 816.

Congress has therefore established rules to ensure that patent monopolies are conferred only on those who have truly invented something and have complied with the various conditions of patentability set out in the Patent Act. *See* 35 U.S.C. §§ 101-103, 112-115. For nearly two hundred years, Congress has charged the Patent Office with examining patent applications to ensure that they claim only novel, nonobvious subject matter, and that the inventor's disclosure complies with the law. *See, e.g.*, Act of July 4, 1836, §§ 6-7, 5 Stat. 117, 119-120; Act of July 8, 1870, §§ 24, 31, 16 Stat. 198, 201-202; Pub. L. No. 593, §§ 101-103, 66 Stat. 792, 797-798 (July 19, 1952); 35 U.S.C. § 131.

Congress long ago recognized that the Patent Office's initial look at validity need not be its last. As far back as 1836, for example, the patent laws permitted the Commissioner of Patents to resolve "interfere[nces]"—disputes between two applicants, or between an applicant and an existing patentee, over who was first to invent—by denying patent protection to the later inventor. Act of July 4, 1836, §§ 8, 12, 5 Stat. 120-122.

More recently, as this Court has noted, Congress over several decades has "created administrative processes that authorize the [Patent Office] to reconsider and cancel patent claims that were wrongly issued." *Oil States*, 584 U.S. at 330. One such process is ex parte reexamination, which allows a member of the public to request that the Patent Office review issued patent claims and reevaluate their validity. *See* Pub. L. No. 96-517, 94 Stat. 3015 (Dec. 12, 1980). In that process, the Patent Office may find claims to be unpatentable, with the result that (generally speaking) the claims are canceled.

This reexamination process has been understood from its inception to apply equally to expired and non-expired patents alike. The Manual of Patent Examining Procedure—the Patent Office's handbook for examination—noted in 1981 that an ex parte reexamination request is permitted "at any time during the period of enforceability of a patent," and specifically stated that the "period of enforceability" includes "the 6 years after the end of the [patent] term during which infringement litigation may be instituted." Manual of Patent Examining Procedure § 2211 (4th ed. July 1981), https://perma.cc/R2EF-KJAN (citing 37 C.F.R. § 1.510(a) (1981)). At that time, the agency also developed specific rules for reexamination of expired patents. *See, e.g.*, *id.* §§ 2249-2250.

Congress expanded the Patent Office's authority to review previously issued patents in 1999, establishing a new inter partes reexamination procedure that permitted the party requesting review to participate in the reexamination process. Optional Inter Partes Reexamination Procedure Act of 1999, Pub. L. No. 106-113, §§ 4601-4608, 113 Stat. 1501, 1501A-567-572 (Nov. 29, 1999).

In 2011, Congress enacted the Leahy-Smith America Invents Act (AIA). Pub. L. No. 112-29, 125 Stat. 284 (Sept. 16, 2011). The AIA made several significant changes to patent law, two of which are especially relevant here. First, it replaced the Board of Patent Appeals and Interferences with the new Patent Trial and Appeal Board (Board), which draws its members from among the heads of the Patent Office and the administrative patent judges employed by the agency. *Id.* § 7; 35 U.S.C. § 6(a). Second, it revised the agency's existing systems for reexamining previously issued patents. While it left ex parte reexamination intact, the AIA eliminated inter partes reexamination and created three new procedures for reevaluating issued patents, including, as relevant here, inter partes review. AIA § 6.

Any member of the public may request inter partes review by filing a petition. 35 U.S.C. § 311(a). If the petition demonstrates a "reasonable likelihood" that a challenged patent claim is invalid, the Patent Office will undertake review. *Id.* § 314(a). Inter partes review is conducted by the Board in the first instance, and it entails an adversarial, trial-like procedure, albeit one more limited and efficient than district court litigation. AIA § 6(a); 35 U.S.C. §§ 311-319. Indeed, Congress envisioned inter partes review as "a quick, inexpensive, and reliable alternative to district court litigation," *Cuozzo Speed Techs. v. Lee*, 579 U.S. 261, 278 (2016), designed to "weed out bad patent claims efficiently" but "limit unnecessary and counterproductive litigation costs," *Thryv, Inc. v. Click-To-Call Techs., LP*, 590 U.S. 45, 54 (2020). Like reexamination rulings, inter partes review decisions are appealable to the Federal Circuit. 35 U.S.C. § 319.

The inter partes review process is widely used. *See, e.g.*, PTAB Trial Statistics at 3 (May 2025) (noting that 941 inter partes review requests were filed between Oct. 1, 2024, and May 31, 2025, representing 96% of the Board's trials in that period), https://perma.cc/HT3D-YNYM. Congress's alternative to litigation benefits patent owners and accused infringers alike, providing an efficient way to resolve validity outside of litigation. Far from the "death squad" that some critics label it, Pet. 9, the most recent available statistics show that the Board has denied requests to institute inter partes review in about a third of all cases, and has held unpatentable some or all claims in only another third. *See* PTAB Trial Statistics at 6-7; PTAB Trial Statistics FY 25 Q2 Outcome Roundup at 10-12 (Mar. 31, 2025), https://perma.cc/F73H-DA6K.

***This Court validated inter partes review proceedings as constitutional in* Oil States**

Shortly after the AIA took effect, this Court confronted a challenge to the new inter partes review proceedings. A patent owner argued that this process "violates Article III or the Seventh Amendment of the Constitution" by permitting an executive agency, rather than a court, to review the validity of a patent. *Oil States*, 584 U.S. at 328-29. The Court rejected both constitutional challenges. *Id.* at 329.

The Court explained that it has long distinguished between "'private rights,'" which must be adjudicated in Article III courts, and "'public rights,'" which Congress has "significant latitude to assign" to other tribunals. *Id.* at 334. The Court held that inter partes review "falls squarely within the public-rights doctrine." *Id.* at 334.

The Court began with its previous holdings that the *issuance* of a patent unavoidably implicates public rights—rights that "'arise between the Government and persons subject to its authority'" in connection with otherwise constitutional functions. *Id.* at 334-35 (collecting cases). Because granting a patent "takes from the public rights of immense value and bestows them upon the patentee," it is intrinsically "a matter 'arising between the government and others.'" *Id.* at 335 (alteration adopted). And granting patents is clearly a constitutional function of the executive branch, one that "'did not exist at common law'" but was a "'creature of statute'" alone. *Id.* at 335-36. The Court concluded that inter partes review proceedings are merely a "reconsideration of [the initial] grant" of the patent, and that Congress can authorize the Patent Office "to conduct that reconsideration … without violating Article III." *Id.* at 335.

The Court expressly recognized that the private-property interests are limited by the public nature of the franchise. *Id.* at 338 ("Patents convey only a specific form of property right—a public franchise."). Patent rights thus are bounded by the statute that defines them, which means they are "qualifie[d]" by the conditions imposed in the Patent Act and the AIA. *Id.* at 338-39. Because those conditions "include inter partes review," the agency's second look at the original grant cannot offend Article III or the Seventh Amendment. *Id.* at 338. Notably, the Court's recognition of patents as public rights did not turn on, or even mention, the remedies that might be available in civil actions for infringement.

Gesture asserted its patents, and the Patent Office reconsidered their validity

This case (along with the companion case, No. 24-1281) arises out of post-issuance review proceedings conducted on three patents owned and asserted by Gesture. These patents are among many that Gesture obtained stemming from applications first filed in 1999 and 2000 by Timothy Pryor, who would later found Gesture. The patents generally relate to capturing images of people or actions and processing the image information for some further purpose. Two of the relevant applications generally discussed techniques for using light reflected off a person or object to identify gestures as input for a computer or video game. *See* Pet. App. 130a-131a; No. 24-1281 Pet. App. 33a-35a. Another generally discussed detecting a pose or gesture and triggering a digital picture capture in response. *See* Pet. App. 90a-92a. Through a series of continuation applications—a process that allows a patentee to add new claims while retaining their original priority date—Gesture obtained the three patents at issue: U.S. Patent Nos. 7,933,431 (the '431 patent); 8,553,079 (the '079 patent); and 8,878,949 (the '949 patent). The applications for these patents were filed between 2010-2013, and the patents issued between 2011-2014.

Gesture's patents claim priority back to the 1999 and 2000 applications. That allowed Gesture to obtain patent rights in the 2010s based on showing that no one else had invented its claimed subject matter back in the 1990s. It also meant, however, that Gesture's patents expired 20 years after the earliest application date. *See* 35 U.S.C. § 154(a)(2). The three patents at issue here expired in 2019 and 2020. Pet. App. 4a, 52a, 81a; No. 24-1281 Pet. App. 3a.

In February 2021, after its patents expired, Gesture sued several companies—including private-party Respondents here (or their corporate affiliates)—alleging infringement of these three patents and others and seeking damages for the portion of the six-year lookback period of § 286 that predated the patents' expiration. *See* Pet. App. 89a-90a, 129a-130a, No. 24-1281 Pet. App. 32a-33a, 71a-72a.

In response, the private-party Respondents—as well as Unified Patents, a respondent in No. 24-1281—filed a series of inter partes review petitions challenging the validity of many claims of the asserted patents. *See* Pet. App. 88a-89a, 129a; No. 24-1281 Pet. App. 32a & n.2, 71a; *see also Apple Inc. v. Gesture Tech. Partners LLC*, No. IPR2021-00923, Paper 1 (PTAB May 26, 2021); *LG Elecs., Inc. v. Gesture Tech. Partners, LLC*, No. IPR2021-01255, Paper 2 (PTAB July 15, 2021). Samsung Electronics Co., Ltd., which had also been sued for infringement, filed requests for ex parte reexamination of Gesture's patents. Pet App. 17a; No. 24-1281 Pet. App. 26a; Request for Reexamination, Reexam No. 90/014,901 (Nov. 11, 2021); Request for Reexamination, Reexam No. 90/014,903 (Nov. 11, 2021). These requests for reconsideration were based on older patents—called prior-art references—that described the same (or very similar) inventions as what Gesture's patents claimed, but which the Patent Office had not considered in its original examination, before deciding that Gesture's inventions were new.

Across these proceedings, the Patent Office reached mixed results on the validity of Gesture's patent claims. The Board refused to even institute an inter partes review of one of Gesture's asserted patents. *LG Elecs., Inc. v. Gesture Tech. Partners, LLC*, No. IPR2021-01255, Paper 7 (PTAB Jan 13, 2022). As to the three patents at issue here, the Patent Office reached mixed results in each inter partes review and ex parte reexamination, upholding some claims as valid and rejecting others. Pet. App. 28a, 57a, 88a, 129a; No. 24-1281 Pet. App. 32a, 71a.

The Federal Circuit, applying* Oil States*, rejected Gesture's challenge to the Patent Office's authority to review expired patents

Gesture appealed from the portions of the Patent Office's decisions that were adverse to it, and Apple appealed from some of the decisions adverse to the private-party Respondents. Like the Patent Office, the Federal Circuit reached mixed results on patent validity. For example, in the appeal from one inter partes review of the '431 patent, the court upheld the Board's ruling that certain claims were valid (while agreeing that the others were invalid). *See* No. 24-1281, Pet. App. 1a-2a, 25a. As to the '949 patent inter partes review, in contrast, the Federal Circuit reversed the Board's determination upholding one challenged claim and affirmed its ruling that other claims were invalid. *See* Pet. App. 1a-2a, 21a.

In each of its appeals, Gesture briefly argued to the Federal Circuit that inter partes review and ex parte reexamination proceedings are unconstitutional. Gesture based its challenge on the more limited remedies available to a patentee seeking to enforce a patent after its expiration: because the patentee can no longer seek to exclude the public prospectively through an injunction, but only collect damages for past intrusion on the public franchise, Gesture argued that Article III courts should have exclusive jurisdiction to determine validity. Pet. App. 4a.

The Federal Circuit carefully considered, and rejected, Gesture's argument in the first opinion it issued in this series of cases, addressing the appeal and cross-appeal from the inter partes review of the '949 patent. Pet. App. 4a-7a. The court recognized that its prior cases had assumed, without deciding, that the Patent Office has authority to reconsider whether a patent should have issued, even after their expiration. Pet. App. 4a-5a (citing *Immunex Corp. v. Sanofi-Aventis U.S. LLC*, 977 F.3d 1212, 1217 (Fed. Cir. 2020) and *Axonics, Inc. v. Medtronic, Inc.*, 75 F.4th 1374, 1382 n.8 (Fed. Cir. 2023)). The court therefore addressed the issue directly in a precedential opinion. Pet. App. 5a. It concluded that this Court's holding in *Oil States* resolved Gesture's challenge. The court noted this Court's holding that an inter partes review is "a second look at an earlier administrative grant of a patent," and therefore "involves the public's same 'interest in seeing that patent monopolies are kept within their legitimate scope.'" Pet. App. 6a (quoting *Oil States*, 584 U.S. at 336-37). As a result, inter partes review proceedings necessarily involve public rights and can therefore be decided by an agency without offending Article III. *Id.* The Federal Circuit also specifically explained that Gesture's argument that "the public franchise ceases to exist" once a patent expires “is incompatible with the Court’s logic in *Oil States*”; inter partes review proceedings do not examine a public franchise at the time of the agency’s second look, but instead revisit “the earlier determination of granting a public right in the first place.” Pet. App. 4a, 6a. “The review of an earlier grant of a patent thus inherently involves the adjudication of a public right, and it is irrelevant whether the patent has expired.” Pet. App. 6a.

The Federal Circuit applied its holding in Gesture’s other appeals, rejecting its jurisdictional challenges in the other inter partes review appeals as well as its parallel claim that the ex parte reexamination proceedings that have been used since 1980 are unconstitutional. *See* Pet. App. 21a, 25a, 27a; No. 24-1281 Pet. App. 24a, 26a.

REASONS TO DENY CERTIORARI

This Court has already resolved the question presented in *Oil States*, which definitively held that inter partes review complies with Article III and the Seventh Amendment. That holding did not, as Gesture suggests, “hinge[] on the ongoing nature of public patent monopolies,” Pet. 17—and Gesture’s petition makes no effort to show that it did. Gesture’s theory is irreconcilable with *Oil States* and a host of other precedents from this Court, none of which Gesture asks this Court to revisit. The Federal Circuit’s straightforward application of these controlling and unchallenged decisions does not warrant this Court’s intervention. And Gesture’s arguments are particularly ill-taken given that Gesture is still wielding its public franchises to extract payment for alleged infringement that took place during the lifetime of its patents—meaning that the public continues to have an interest in the validity of the patents and the Patent Office continues to have authority to reconsider the propriety of the original grants. This Court has repeatedly declined to take up post-*Oil States* petitions challenging the Patent Office's authority to conduct inter partes review—even with respect to questions *Oil States* expressly left open.[2] Here, where the petition instead merely raises a challenge foreclosed by *Oil States*—without asking this Court to overrule that precedent—denial is even more appropriate. Although Gesture tries to suggest that this case presents major questions of executive-agency authority, in fact the only question of executive authority it presents was resolved in *Oil States*. The question whether the Patent Office may constitutionally reconsider its prior grant of a patent that has since expired is narrow, not of compelling importance, and in any event answered by *Oil States*.

[2] *Compare Oil States*, 584 U.S. at 344 (not resolving any challenge to "the retroactive application of inter partes review, even though that procedure was not in place when [a] patent issued" or due-process or takings challenges), *with Collabo Innovations, Inc. v. Sony Corp.*, 141 S. Ct. 129 (2020) (denying certiorari on whether inter partes review of pre-AIA patents violates the Takings Clause and Due Process Clause of the Fifth Amendment); *Celgene Corp. v. Peter*, 141 S. Ct. 132 (2020) (denying certiorari on whether inter partes review of pre-AIA patents violates the Takings Clause of the Fifth Amendment).

I. The Decision Below Is A Correct And Straightforward Application Of *Oil States*.

A. Under *Oil States*, the Patent Office's power to grant patents includes the authority to reconsider the grant of a patent even after it has expired.

In *Oil States*, this Court broadly held that "inter partes review does not violate Article III or the Seventh Amendment." 584 U.S. at 345. It placed no reservation on that holding based on whether the patent under review had expired. The Court ruled that inter partes review "falls squarely within the public-rights doctrine" because the grant of a patent involves public rights—"the grant of a public franchise"—and therefore reconsideration of that grant "is a matter that Congress can properly assign to the PTO." *Id.* at 334-36, 345. The Court expressly identified certain questions it was not deciding in *Oil States*: namely, whether "other patent matters, such as infringement actions, can be heard in a non-Article III forum"; whether the procedure would be constitutional if no Article III court could ever review the outcome; the "retroactive application" of inter partes review to patents that predate the AIA; or any due-process challenge. *Id.* at 344. But the Court nowhere even hinted that it was reserving from its categorical pronouncement the possibility that review of expired patents might present a constitutional problem.

Not only does the holding of *Oil States* cover expired patents just as much as it does non-expired patents, but the logic underpinning the decision does as well. This Court reasoned that the Patent Office, as the duly authorized grantor of the right to a patent, may as a continuing exercise of its executive power conduct inter partes review to reconsider its grant. *E.g.*, *id.* at 334-36. Both the original grant and the reconsideration address whether the executive has properly granted a patent owner a statutory right to monopolize subject matter that would otherwise be in the public domain. *See id.* at 335-36 ("Inter partes review is 'a second look at an earlier administrative grant of a patent.'" (quoting *Cuozzo*, 579 U.S. at 279)). Whether the patent owner is enforcing those monopoly rights by extracting licensing fees, by obtaining injunctive relief to exclude others prospectively, or by recovering (pre- or post-expiration) money damages for past violations of the monopoly rights, they can do so solely because of the public franchise the Patent Office has granted. A patent simply is nothing more than that: "Patents convey *only* a specific form of property right—a public franchise." *Id.* at 338 (emphasis added).

Oil States decreed that the Patent Office is allowed to reconsider whether the patentee should have had that public franchise in the first place. The Office may do so, the Court reasoned, because all "[p]atent claims are granted subject to the qualification that the PTO has 'the authority to reexamine'" and "'cancel'" the grant. *Id.* at 337 (quoting *Cuozzo*, 579 U.S. at 267). Regardless of whether a patent has expired, "reconsideration" of the grant remains a matter "which arise[s] between the Government and persons subject to its authority in connection with the performance of the constitutional functions of the executive"—and thus does not "require judicial determination." *Id.* at

334 (quoting *Crowell v. Benson*, 285 U.S. 22, 50 1932)).[3]

B. The petition's central premise—that an expired patent does not implicate a public franchise—is irreconcilable with *Oil States* and many of this Court's other precedents.

Rather than challenge *Oil States*, Gesture attempts to escape its application to expired patents based on two interrelated and unfounded assertions: (1) that the Court's reasoning in *Oil States* "hinged on the ongoing nature of public patent monopolies," and (2) that expired patents implicate only "private rights." Pet. 17. According to Gesture, "challenges to the validity of expired patents are quintessentially private disputes"—not implicating "the public franchise" conveyed by the patent grant—because a patentee can only recover damages, as opposed to obtain injunctive relief, for past acts that occurred during the patent's life. Pet. 17-18; *see* Pet. 4-5. Gesture's theory is squarely foreclosed by this Court's precedents, including *Oil States*, which does not once mention—let alone turn on—the line Gesture wants to draw.

1. Gesture's argument that an expired patent loses its public character is based on a fundamental misconception of the nature of the patent grant.

[3] The logic of *Oil States*'s blessing of the Patent Office's reconsideration of patent grants also extends to ex parte reexamination. Gesture offers no argument specific to ex parte reexamination versus inter partes review and does not dispute that *Oil States* applies equally to both. *See* Pet. 4 n.2 (treating "the constitutional analysis" the same across both).

Gesture asserts that a patent has both a "public right" aspect and an independent "private right" aspect, such that when the patent expires, only the private right remains. That is completely wrong. As *Oil States* explained, a patent is a matter of public rights because it arises entirely from the government grant of the franchise—there are no separate, extra-statutory, common-law patent rights. 584 U.S. at 334-36. The property interests that a patentee enjoys in the patent therefore all arise from that government grant and are limited by the terms of the grant. That is why, *Oil States* held, the executive branch can reconsider the grant—because the possibility of government reconsideration inhered in the grant all along. *Id.* at 336-37.

As a result, there is no separate "private right" in a patent that is independent of the government-granted, public-rights character of the patent. Gesture is therefore wrong to suggest that when the patent expires, it reverts to a "private" character and the patentee somehow retains private, common-law patent rights. In fact, the patentee retains no rights at all; any infringement suit based on an expired patent is directed only to pre-expiration infringement—that is, infringement during the life of the public franchise. So for the whole of its life, a patent is a matter of public rights. It is of course true that the patentee has its own property interest in the granted patent, but that property interest is created by government grant and therefore is always a matter of public rights.

This Court in *Oil States* was exceedingly clear that the only form of property conveyed by a patent is a public franchise: "Patents convey *only* a specific form of property right—a public franchise." 584 U.S. at 338 (emphasis added). There is no private-right alternative that springs into existence from a patent upon its expiration—and Gesture cites nothing suggesting otherwise. When a patentee seeks damages or any other remedy for infringement, it is able to do so only by virtue of that public franchise, *see infra* 22-24—and always subject to the franchise's statutory conditions and limits, including its term. After all, "a patent can confer only the rights that 'the statute prescribes.'" *Oil States*, 584 U.S. at 338 (quoting *Gayler v. Wilder*, 51 U.S. (10 How.) 477, 494 (1850)); *see id.* at 335 (the patent right "'did not exist at common law'" and is a "'creature of statute law'" (quoting *Gayler*, 51 U.S. (10 How.) at 494; *Crown Die & Tool Co. v. Nye Tool & Machine Works*, 261 U.S. 24, 40 (1923)).

That is true even for actions filed (or maintained) after a patent expires. Under the Patent Act, the patentee may recover damages only for the time the patent was in force—and only for infringement occurring up to six years before the complaint was filed. 35 U.S.C. §§ 154(a)(1), (2), 284, 286. "[T]he patentee's right" to those damages must remain subject to the exact same statutory conditions for patentability that apply to unexpired patents, because the right is "'derived altogether'" from the Patent Act and thus is "to be regulated and measured by th[at] law[], and cannot go beyond [it].'" *Oil States*, 584 U.S. at 338 (quoting *Brown v. Duchesne*, 60 U.S. (19 How.) 183, 195, (1856)). At all times, the same public franchise is being asserted, and the same conditions on that franchise apply.

Gesture nowhere even attempts to show otherwise or to explain how an expired patent constitutes a private right notwithstanding this Court's unequivocal holding to the contrary. Indeed, the petition omits *Oil States*'s use of "only" when describing the relevant portion of the opinion. Pet. 16. But "only" means exactly that: A patent is and remains nothing more than a public franchise and cannot be reimagined as a private right simply because it has expired.

2. Gesture's repeated (and unsupported) suggestion that an expired patent is a private-right instrument because the owner of an expired patent can collect damages in a patent-infringement suit, *see* Pet. 4-5, 13-14, 17-19, is wrong for two additional reasons.

a. First, Gesture's argument conflicts with this Court's recognition that the right to damages is simply part of the public franchise—not evidence of some private-right alternative. As Gesture acknowledges (Pet. 15), the public franchise is the statutory right to exclude that exists during a patent's term. *E.g.*, *United Shoe Mach. Corp. v. United States*, 258 U.S. 451, 463 (1922); *Seymour v. Osborne*, 78 U.S. 516, 533 (1870); *see* 35 U.S.C. § 154(a)(1), (2). This Court has expressly held that damages are not a separate entitlement: They are merely a "remed[y] for [the] violation[]" of "th[e] statutory right to exclude." *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 392 (2006); *see Moore v. Marsh*, 74 U.S. 515, 520 (1868) (damages are compensation for the "inva[sion]" of the "exclusive right" secured by a patent).[4] Without a public franchise to infringe, there can be no damages; the two are inextricably intertwined.

Reinforcing this principle, a patentee is entitled to collect damages only for acts that occurred before its patent expired, when the public franchise still existed. *See, e.g.*, *Glendale Elastic Fabrics Co. v. Smith*, 100 U.S. 110, 111 (1879) (recognizing that a party may only be "required to pay" damages for a patent "for the use he made of it while [it] was in force"); *supra* 21. Damages for any other period would contravene the ironclad rule that, "when the patent expires, the patentee's prerogatives expire too." *Kimble*, 576 U.S. at 451; *see id.* at 463 ("[A]ll patents, and all benefits from them, must end when their terms expire."). Even Gesture concedes that a patentee may seek damages on an expired patent only "for past infringement that occurred during the period when the patent[ee] indisputably enjoyed exclusive rights." Pet. 18; *see* Pet. i ("past damages"); Pet. 4 ("damages for past infringement"); Pet. 20 ("past infringement"); Gesture Opening-Response Br. 43 (Dkt. 30, CAFC No. 23-1501) ("[T]he franchisee may be entitled to collect damages from the public franchise that formerly existed through an infringement action in district court."). This concession underscores that the right to

[4] *See also, e.g.*, *Commil USA, LLC v. Cisco Sys., Inc.*, 575 U.S. 632, 635 (2015) ("A patent holder, and the holder's lawful licensees, can recover for monetary injury when their exclusive rights are violated by others' wrongful conduct."); *Dowagiac Mfg. Co. v. Minn. Moline Plow Co.*, 235 U.S. 641, 648 (1915) (a patent confers property in the form of an "exclusive right," infringement is "a tortious taking of a part of that property," and damages should compensate for "the value of what was taken").

damages on an expired patent is nothing more than a consequence of the public right that existed during the patent's life—the public franchise consisting of the right to exclude—and does not transform an expired patent's validity into a private-right matter.

b. Second, Gesture's heavy reliance on infringement suits being tried at law is irrelevant to the constitutionality of administrative review of expired patents. *See Commil*, 575 U.S. at 643 (endorsing "the long-accepted truth—perhaps the axiom—that infringement and invalidity are separate matters under patent law"). The Patent Office cannot and does not adjudicate liability for patent infringement or its consequences, whether the patent has expired or remains in force. The *only* thing the Patent Office ever decides in administrative patent proceedings is whether to grant (or revoke, or revise) a public franchise in the form of a patent.

This Court has explicitly recognized as much. In *Oil States*, the Court explained that "[i]nter partes review is simply a reconsideration of th[e] [patent] grant"—emphasizing that, "[a]lthough inter partes review includes some of the features of adversarial litigation, it does not make any binding determination regarding 'the liability of [one individual] to [another] under the law as defined,'" but rather "remains a matter involving public rights." 584 U.S. at 335, 343 (quoting *Crowell*, 285 U.S. at 51; *Ex parte Bakelite Corp.*, 279 U.S. 438, 451 (1929)). Likewise, in *Cuozzo*, the Court stressed that "the purpose of [inter partes review] is not quite the same as the purpose of district court litigation," because the former merely "offers a second look at an earlier administrative grant of a patent." 579 U.S. at 279.

Gesture nominally accepts these statements, Pet. 16-17, yet ignores their upshot: the relief available in a private infringement lawsuit is irrelevant to the Patent Office's authority to conduct review of a previously issued patent. Contrary to the petition's (again unsupported) assertion, such review never "absorbs and displaces the patent holder's right to seek infringement damages in court." Pet. 19. In conducting inter partes review (or any other post-issuance review), the Patent Office "does not make any binding determination regarding 'the liability of [one individual] to [another]." *Oil States*, 584 U.S. at 343. To be sure, if a patent "is shown to be invalid, there is no patent to be infringed," but that fact does not justify the petition's "conflat[ion] [of] the issues of infringement and validity," which "are separate issues under the [Patent] Act." *Commil*, 575 U.S. at 642-44. For the same reason, Gesture's observation that *Oil States* "explicitly reserv[ed]" whether "'infringement actions[] can be heard in a non-Article III forum,'" Pet. 17 (quoting 584 U.S. at 344), is misplaced. That question is reserved, but it is not presented here. Gesture's petition does not (and could not) ask this Court to decide anything about the ability of a non-Article III forum to adjudicate infringement.

3. Gesture also misrelies on *Kimble*. *See* Pet. 4, 18. The Court in *Kimble* upheld the rule of *Brulotte v. Thys Co.*, 379 U.S. 29 (1964), prohibiting patentees from charging royalties for post-expiration use of a patented invention, grounding this prohibition in the "categorical principle that all patents, and all benefits from them, must end when their terms expire." 576 U.S. at 463. Thus, once the public franchise ends, so do all "the patentee's prerogatives," even those enshrined in private contracts. *Id.* at 451. *Kimble* thus makes clear that the public franchise is the be all and end all of the patent grant.

4. Finally, in *Oil States*, this Court expressly rejected Gesture's footnoted suggestion that "land patent[s]" show that modern invention patents can "eventually transform into [a] 'private right[].'" Pet. 21 n.3. The Court explained that "[m]odern invention patents … are meaningfully different from land patents … under the current Patent Act, which gives the PTO continuing authority to review and potentially cancel patents after they issued." *Oil States*, 584 U.S. at 339 n.3. Consequently, modern invention patents never wholly "pass[] from … government," as Gesture claims. Pet. 21 n.3 (internal quotation marks omitted). Rather, "the Government continues to possess some measure of control over the right in question." *Oil States*, 584 U.S. at 339 n.3 (internal quotation marks omitted).

C. The petition is incorrect that the public has no interest in whether an expired patent should have been granted.

Gesture's contention that "the public has no stake in the outcome" of administrative review of expired patents because they do not carry the threat of an injunction, Pet. 18; *see* Pet. 19-20, is also meritless. An expired patent remains enforceable against the public, for pre-expiration conduct, and therefore the question whether the government correctly granted the patent in the first place continues to be a matter of public interest—and also a matter of public rights. *See Oil States*, 584 U.S. at 335-37. The "public's paramount interest in seeing that patent monopolies are kept within their legitimate scope," *id.* at 336-37 (quoting *Cuozzo*, 579 U.S. at 279), does not depend on the risk of injunctions, as Gesture asserts. Pet. 18-20. The reason the public still has an interest in the propriety of the patent after expiration is that the patent can still be enforced against the public.

The public has an interest in seeing that damages are not paid on patents that should never have issued. This Court has repeatedly recognized that payments on invalid patents thwart "the important public interest in permitting full and free competition in the use of ideas which are in reality a part of the public domain." *Lear, Inc. v. Adkins*, 395 U.S. 653, 670-71 (1969) (holding that licensees are free to challenge the validity of licensed patents lest through royalties "the public may continually be required to pay tribute to would-be monopolists without need or justification"); *see Minerva Surgical, Inc. v. Hologic, Inc.*, 594 U.S. 559, 574 (2021) ("*Lear*'s refusal to bar a licensee's claim of invalidity showed that the Court was alert to 'the important public interest in permitting full and free competition in the use of ideas.'" (quoting 395 U.S. at 670)); *Kimble*, 576 U.S. at 451-53 (similar). Nothing about that interest changes depending on whether the patentee is seeking payment for past *and* ongoing use of a patent that is still in force, or solely for past use during the period in which a now-expired patent was in force. Administrative review of expired and unexpired patents alike serves the public interest in cracking down on "overpatenting and its diminishment of competition" by "'improv[ing] patent quality and limit[ing] unnecessary and counterproductive litigation costs'" stemming from unfounded patent-infringement suits. *Thryv,* 590 U.S. at 54 (quoting H.R. Rep. No. 112-98 at 40 (2011)); *contra* Pet. 19-20.

Moreover, the threat of damages on expired patents affects not only those members of the public who are directly targeted by damages claims, but the public as a whole. Patent-infringement suits can threaten astronomical damages—including in suits on expired patents. The possibility of having to pay exorbitant damages on any patent can increase prices and threaten to shutter businesses, especially smaller ones. *See Blonder-Tongue Lab'ys, Inc. v. Univ. of Illinois Found.*, 402 U.S. 313, 346 (1971) (royalties on a patent can put a party "at a competitive disadvantage" and lead to "higher prices for goods covered"); Michael J. Burstein, *Rethinking Standing in Patent Challenges*, 83 Geo. Wash. L. Rev. 498, 499 (2015) ("[A] judgment of infringement can have devastating effects for a business, subjecting it to crippling damages.").

In short, the public's interest in policing patent validity does not end with expiration. Allowing the Patent Office to review expired patents promotes a fair, competitive marketplace and protects the public from an exercise of monopoly rights that should never have been granted.

D. Nothing in the history or application of the AIA, or in other statutes, restricts revocation of a patent to the courts.

As its last substantive gasp, Gesture argues that the legislative history of the AIA and the copyright and trademark statutes support its cause. Pet 19-21. They do not. The petition's brief mention of the legislative history underlying the AIA is both incomplete and irrelevant to the issues Gesture seeks to address with this Court. And the other intellectual-property statutes reveal only that the political branches can choose not to provide for review of expired rights; they say nothing about whether that authority would be constitutional if exercised.

To begin, Gesture's attention to the legislative history cannot shed light on the question presented, because all agree that the AIA permits inter partes review on expired patents. The question is whether that clear statutory directive is permissible under Article III and the Seventh Amendment. Legislative history does not reveal more than Congress's intent in passing the AIA. *See, e.g.*, *Milner v. Dep't of Navy*, 562 U.S. 562, 572 (2011).

In any event, Gesture is wrong about the AIA's purpose. Gesture selectively quotes from a House Judiciary Committee Report accompanying the AIA, asserting that the "purpose" of the statute was to "better 'promote innovation'" and to "provide 'a more efficient system for challenging patents that should not have issued.'" Pet. 6, 19 (quoting H.R. Rep. No. 112-98, pt. 1, at 39-40). But the same passage reveals that Congress also sought to "reduc[e] unwarranted litigation costs and inconsistent damage awards" and, relatedly, "limit unnecessary and counterproductive litigation costs." H.R. Rep. No. 112-98, pt. 1, at 40. Litigation costs and damages awards can come from expired and unexpired patents alike, and Gesture fails to explain how its proposed exception to *Oil States* would serve this statutory purpose.

Gesture separately and mistakenly argues that Patent Office review of expired patents must be unconstitutional because Congress has not provided for similar challenges to expired trademarks or copyrights. Pet. 20-21.

Neither trademarks nor copyrights, however, are founded on a public franchise like patents are. Copyright, for example, does not protect the ideas or concepts that underlie a work, only the tangible expression of those ideas. 17 U.S.C. § 102(a), (b). An author cannot claim exclusive copyright protection for a new method of bookkeeping, even if he has invented one; he may copyright only his particular description of the system. *Baker v. Selden*, 101 U.S. 99, 102 (1879). Similarly, trademarks do not purport to prevent the public from trading in goods similar to those marked, but only from confusing the public as to their origin. Indeed, as this Court recently remarked, trademark doctrines such as fair use specifically guard against "anticompetitive effects" that might otherwise "yield [a trademark] holder a monopoly" on the words used to describe its products or services. *United States Pat. & Trademark Off. v. Booking.com B. V.*, 591 U.S. 549, 562 (2020).

Even apart from this distinction, the trademark and copyright statutes and regulations at most show only that the legislature and the agencies can choose not to revisit earlier grants. They say nothing about whether those branches could choose otherwise.

II. Gesture's Scattershot Attacks On Inter Partes Review Are Misplaced And Do Not Suggest Any Need For This Court's Review.

Gesture suggests that its petition presents significant separation-of-powers questions concerning executive authority. Pet. 21-22. That is wrong. *Oil States* answered the most significant question concerning the Patent Office's authority—whether that authority, writ large, is consistent with Article III—and Gesture does not ask the Court to overrule that decision. *Oil States* also answered the question presented here, for all the reasons already stated.

Despite Gesture's protests, this Court has already determined that the patent monopoly is not "private property" that is "relitigate[d] and revoke[d]" by an inter partes review. Pet. 22. Rather, a patent grants a public franchise that is expressly subject to administrative reconsideration from the outset. *Oil States*, 584 U.S. at 335-36. Because inter partes reviews (and other reconsideration mechanisms) merely implement the statutory qualification inherent in the original grant, they "involve[] the same basic matter" and are "on the public-rights side of the line." *Id.* at 336-37. Nor has any Federal Circuit judge suggested otherwise, notwithstanding Gesture's contention that there is an "ongoing debate over the dividing line between public and private rights." Pet. 5. Gesture's support for that statement is a dissent from an en banc denial that issued before *Oil States* settled the question. *Cascades Projection LLC v. Epson Am., Inc.*, Nos. 2017-1517, -1518, 2017 WL 1946963, at *4 (Fed. Cir. May 11, 2017) (O'Malley, J., dissenting).

The question framed by Gesture is therefore nothing like the questions this Court has considered in recent cases involving weighty concerns about the separation of powers. *See* Pet. 21-22 (citing *SEC v. Jarkesy*, 603 U.S. 109 (2024), *West Virginia v. EPA*, 597 U.S. 697 (2022), and *United States v. Arthrex, Inc.*, 594 U.S. 1 (2021)). Indeed, Gesture merely rehashes complaints about inter partes review that were also made in *Oil States*, that are more appropriately addressed to Congress, and that have even less purchase now that inter partes review has been around for over a decade and has not proven to be the patent-killer that some predicted.

Nothing in the AIA transfers "judicial power over patent cases to the [Patent Office] wholesale." Pet. 22. Inter partes reviews cannot decide most of the crucial questions in an infringement lawsuit—the Patent Office has no jurisdiction and no reason to consider whether a patent claim is infringed, nor can it adjudicate any remedy for infringement. Resolution of those issues affecting the parties to a particular dispute remains, as it should, in the Article III courts.

Nor is Gesture's one-sided view of the equities any reason to grant certiorari. Pet. 22-23. Gesture omits that the present situation is one of its own making: Gesture chose to delay its infringement suits until after its patents expired. Indeed, if Gesture's view were adopted, patentees might tactically make the same choice to delay and thus avoid administrative review of patentability, thwarting Congress's intent to "weed out bad patent claims efficiently" within the Patent Office, *Thryv*, 590 U.S. at 54. Moreover, Gesture's argument assumes that only the inter partes review proceedings stand between it and recovery. But Gesture has yet to prove that anyone infringes its patents. And it ignores that the Patent Office not only upheld one of its patents entirely but also reached mixed results in virtually all of the individual proceedings, upholding the validity of various claims over individual prior-art references under consideration. *Supra* 13. This was not an agency bent on destroying Gesture's intellectual property. It was an agency that thoughtfully considered information that was not before the original examiners, yet was critical to determining whether Gesture had actually invented anything.

Gesture's reference to the clear-and-convincing evidence standard applicable in district court also undermines its thesis. *See* Pet 23 n.4. The difference in the evidentiary burden of proving invalidity before the agency and the courts reflects only that Congress has never charged the latter with the primary determination of whether a patent should issue. *See* 35 U.S.C. § 282.

Similarly, a patentee's inability to amend its expired claims in an inter partes review, *see* Pet 23 n.4, lends no support to Gesture's position. When a claim is amended in ex parte reexamination or inter partes review, the patentee does not gain any retroactive entitlement to damages for infringement of its new claims. *See, e.g.*, *Tennant Co. v. Hako Minuteman, Inc.*, 878 F.2d 1413, 1417 (Fed. Cir. 1989). It could hardly be otherwise, as the claims are intended to serve a public-notice function. *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 909 (2014) ("a patent must be precise enough to afford clear notice of what is claimed"). It would be fundamentally unfair to the public to retroactively adjust claim scope and impose an unannounced and unavoidable liability on an unwitting infringer.

Finally, the petition's recounting of the Federal Circuit's decisions in cases concerning separate questions of Patent Office authority, *see* Pet. 24-26, is irrelevant. The petition does not argue that *Collabo Innovations, Inc. v. Sony Corp.*, 778 F. App'x 954 (Fed. Cir. 2019), *Golden v. United States*, 955 F.3d 981 (Fed. Cir. 2020), *cert. denied*, 141 S. Ct. 908 (2020), or *XY, LLC v. Trans Ova Genetics, L.C.*, 890 F.3d 1282 (Fed. Cir. 2018), were wrongly decided; it simply paints them as part of a pattern of supposed passivity by the Federal Circuit. This Court does not seem to have seen any such pattern of judicial lassitude; it denied certiorari in *Collabo Innovations, Inc. v. Sony Corp.*, 141 S. Ct. 129 (2020), and in several others that Gesture does not list. *See, e.g.*, Petition for Writ of Certiorari, *Celgene Corp. v. Peter*, No. 19-1074, 2020 WL 1433458 (U.S. filed Feb. 26, 2020), *cert. denied*, 141 S. Ct. 132 (2020); Petition for Writ of Certiorari, *Jump Rope Sys., LLC v. Coulter Ventures, LLC*, No. 22-298, 2022 WL 4585428 (U.S. filed Sept. 26, 2022), Reply Brief, 2023 WL 1798176 (U.S. filed Jan. 31, 2023), *cert. denied*, 143 S. Ct. 992 (2023); Petition for Writ of Certiorari, *Arbor Glob. Strategies, LLC v. Samsung Elecs. Co.*, No. 24-548, 2024 WL 4817379 (U.S. filed

Nov. 13, 2024), *cert. denied*, 145 S. Ct. 1127 (2025). When this Court granted certiorari in *United States v. Arthrex, Inc.*, 594 U.S. 1 (2021), it upheld the Federal Circuit's constitutional holding and vacated only the remedy the court of appeals selected. *Id.* at 23, 25. And the Federal Circuit has itself recently cut back on the issue-preclusion ruling the petition bemoans in *XY*. *See Kroy IP Holdings, LLC v. Groupon, Inc.*, 127 F.4th 1376, 1381 (Fed. Cir. 2025). In denying en banc review, the Federal Circuit clearly demonstrated its awareness that it cannot create "patent-specific departures from well-established principles" applicable in other areas of the law. *Kroy IP Holdings, Inc. v. Groupon, Inc.*, No. 2023-1359, slip op. at 1 (Fed. Cir. Aug. 1, 2025) (Moore, C.J., concurring in denial of rehearing en banc).

Similarly, it is immaterial that this Court may have reversed the Federal Circuit in cases raising unrelated issues of substantive patent law two decades ago. *See* Pet. 25. Whatever the Court's impetus in those cases, none of them sheds light on whether the decisions below require intervention now.

CONCLUSION

The Court should deny the petition.

Respectfully submitted,

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