No. 24-1280

In the Supreme Court of the United States

GESTURE TECHNOLOGY PARTNERS, LLC, PETITIONER

v.

APPLE INC., ET AL.

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

BRIEF FOR THE FEDERAL RESPONDENT IN OPPOSITION

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QUESTION PRESENTED

"Over the last several decades, Congress has created administrative processes that authorize the [United States Patent and Trademark Office] to reconsider and cancel patent claims that were wrongly issued." *Oil States Energy Servs., LLC* v. *Greene's Energy Grp., LLC*, 584 U.S. 325, 330 (2018). Those administrative mechanisms include inter partes review and ex parte reexamination. In *Oil States*, this Court held that "inter partes review does not violate Article III" because "reconsideration of the Government's decision to grant" a patent is a matter that "falls squarely within the public-rights doctrine" and thus may be done by an administrative tribunal. *Id.* at 334-335, 345. The question presented is as follows:

Whether Article III allows the use of inter partes review and ex parte reexamination to reconsider the validity of an expired patent.

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OPINIONS BELOW

The opinion of the court of appeals (Pet. App. 1a-15a) is reported at 127 F.4th 364. Additional opinions of the court of appeals (Pet. App. 16a-21a 22a-25a, 26a-27a) are available at 2025 WL 303446, 2025 WL 303650, and 2025 WL 303653. The decisions of the Patent Trial and Appeal Board (Pet. App. 28a-56a, 57a-86a, 87a-127a, 128a-156a) are not reported.

JURISDICTION

The judgment of the court of appeals was entered on January 27, 2025. On April 23, 2025, the Chief Justice extended the time within which to file a petition for a writ of certiorari to and including June 11, 2025, and the petition was filed on that date. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

STATEMENT

1. a. The Intellectual Property Clause of the Constitution authorizes Congress 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.

The Nation's first patent statute conditioned the issuance of patents on approval by an Executive Branch committee that was charged with determining whether the invention in question was sufficiently useful and novel. See Patent Act of 1790, ch. 7, § 1, 1 Stat. 109-110. Since 1836, Congress has entrusted the decision whether to grant a patent to an executive agency that is now known as the U.S. Patent and Trademark Office (USPTO or PTO). See Patent Act of 1836, ch. 357, 5 Stat. 117-118; 35 U.S.C. 2(a)(1), 131. When a putative inventor files an application with the USPTO, "[a] patent examiner with expertise in the relevant field reviews an applicant's patent claims, considers the prior art, and determines whether each claim meets the applicable patent law requirements." *Cuozzo Speed Techs., LLC* v. *Lee*, 579 U.S. 261, 266 (2016). The invention must satisfy specified statutory conditions that include eligibility and utility, 35 U.S.C. 101; novelty, 35 U.S.C. 102; and non-obviousness over the prior art, 35 U.S.C. 103.

The examination is an ex parte proceeding in which persons other than the applicant generally have no opportunity to participate. Although an applicant must disclose material prior art of which he is aware, 37 C.F.R. 1.56, he has "no general duty to conduct a prior art search" and "no duty to disclose art of which [the] applicant is unaware." *Bruno Indep. Living Aids, Inc.* v. *Acorn Mobility Servs., Ltd.*, 394 F.3d 1348, 1351 n.4

(Fed. Cir. 2005). As a result, the patent examiner evaluating an application may be unaware of information that bears on whether the requirements for patentability are satisfied. See *Kappos* v. *Hyatt*, 566 U.S. 431, 437 (2012); *Microsoft Corp.* v. *i4i Ltd. P'ship*, 564 U.S. 91, 108-112 (2011).

"If the Patent Office accepts the claim[s] and issues a patent, the patent owner generally obtains exclusive rights to the patented invention throughout the United States for 20 years." *Return Mail, Inc.* v. *United States Postal Serv.*, 587 U.S. 618, 622 (2019); see 35 U.S.C. 154(a)(1) and (2). In particular, a patent confers on its owner "the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States." 35 U.S.C. 154(a)(1). A patent owner may enforce that right through infringement actions against others who make, use, offer for sale, or sell the patented invention within the United States without authorization during the term of the patent. 35 U.S.C. 271(a), 281. In such an infringement suit, the patentee may seek remedies that include an injunction against future infringement during the remainder of the patent term, 35 U.S.C. 283, and damages for past infringement that occurred up to six years before the filing of the complaint, 35 U.S.C. 284, 286.

When a patent's 20-year term expires, the patent "is not viewed as having 'never existed.' Much to the contrary, 'a patent does have value beyond its expiration date.'" *Genetics Inst., LLC* v. *Novartis Vaccines & Diagnostics, Inc.*, 655 F.3d 1291, 1299 (Fed. Cir. 2011) (quoting *In re Morgan*, 990 F.2d 1230, 1230 (Fed. Cir. 1992)), cert. denied, 566 U.S. 939 (2012). "For example, an expired patent may form the basis of an action for past damages" for infringement that occurred during

the patent term, subject to the six-year statute of limitations on damages claims. *Ibid.*; see, *e.g.*, *Life Techs. Corp.* v. *Promega Corp.*, 580 U.S. 140, 143 n.1 (2017). A patent owner also may "license the rights or transfer title to an expired patent." *Sony Corp.* v. *Iancu*, 924 F.3d 1235, 1238 n.1 (Fed. Cir. 2019). Expiration thus means that "the patentee has fewer rights" than before but still retains a subset of the rights that the patent originally conferred. *Keranos, LLC* v. *Silicon Storage Tech., Inc.*, 797 F.3d 1025, 1033 (Fed. Cir. 2015).

b. "For several decades," Congress has authorized the USPTO to reconsider its own patent-issuance decisions through proceedings "to reexamine—and perhaps cancel—a patent claim that it had previously allowed." *Cuozzo*, 579 U.S. at 267.

i. In 1980, Congress created ex parte reexamination to restore public and commercial "confidence in the validity of patents issued by the PTO" by providing a speedy and inexpensive mechanism for eliminating patents that had been wrongly issued. *Patlex Corp.* v. *Mossinghoff*, 758 F.2d 594, 601 (Fed. Cir.), modified on other grounds on reh'g, 771 F.2d 480 (Fed. Cir. 1985); see Act of Dec. 12, 1980, Pub. L. No. 96-517, 94 Stat. 3015 (35 U.S.C. Ch. 30). "Any person at any time" may request reexamination of an issued patent based on certain prior art that bears on patentability. 35 U.S.C. 301(a), 302. The USPTO will institute an ex parte reexamination if it concludes that the petition raises a "substantial new question of patentability." 35 U.S.C. 303(a), 304. The Director of the USPTO is also authorized, "[o]n his own initiative, and [at] any time," to "determine whether a substantial new question of patentability is raised" with respect to any issued patent "by

patents and publications discovered by him." 35 U.S.C. 303(a).

The ex parte reexamination process follows the same procedures as the initial examination. 35 U.S.C. 305. Under the current statutory scheme, if the examiner rejects a claim as unpatentable, the patent owner can appeal to the Patent Trial and Appeal Board (Board), a body within the USPTO "composed of administrative patent judges, who are patent lawyers and former patent examiners, among others." *Cuozzo*, 579 U.S. at 268; see 35 U.S.C. 134, 306. The Board's decision may then be appealed to the Federal Circuit. 35 U.S.C. 141(b), 306.

ii. In 1999, Congress created inter partes reexamination—the predecessor to inter partes review—to expand the USPTO's authority to correct its erroneous patent grants. Optional Inter Partes Reexamination Procedure Act of 1999, Pub. L. No. 106-113, Div. B, App. I, Tit. IV, Subtit. F, §§ 4601-4608, 113 Stat. 1501A-567 to 1501A-572 (35 U.S.C. 311-318 (2000)). Inter partes reexamination was "similar" to ex parte reexamination but allowed "third parties greater opportunities to participate in the Patent Office's reexamination proceedings," *Cuozzo*, 579 U.S. at 267, by permitting them to respond to the patent owner's arguments, introduce evidence in response to the patent owner's evidence, and engage in motions practice. See 35 U.S.C. 311-318 (2000). Subsequent amendments to the reexamination statute allowed third parties to participate in any appeal of the agency's decision. 21st Century Department of Justice Appropriations Authorization Act, Pub. L. No. 107-273, § 13106(c), 116 Stat. 1901.

iii. In 2011, Congress enacted the Leahy-Smith America Invents Act (AIA), Pub. L. No. 112-29, 125

Stat. 284, which revised the Patent Act's post-issuance review procedures. The AIA sought to "improve patent quality and restore confidence in the presumption of validity that comes with issued patents," *Cuozzo*, 579 U.S. at 272 (citation omitted), by "establish[ing] a more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs," *Thryv, Inc* v. *Click-To-Call Techs., LP*, 590 U.S. 45, 54 (2020) (citation omitted). To that end, the AIA created a new USPTO procedure, known as post-grant review, for patentability challenges brought within nine months after the challenged patent was issued. 35 U.S.C. 321(c). And for challenges brought more than nine months after a patent was issued, the AIA created inter partes review, which replaced inter partes reexamination. 35 U.S.C. 311. Inter partes review serves the same "basic purposes" as inter partes reexamination—"namely, to reexamine an earlier agency decision" granting a patent. *Cuozzo*, 579 U.S. at 279.

As with inter partes reexamination, any person other than the patent owner may seek inter partes review on the ground that, at the time a patent was issued, the invention was not novel or would have been obvious in light of "prior art consisting of patents or printed publications." 35 U.S.C. 311(b). The statute does not generally set an outer limit on the time to seek inter partes review. But when a party has been sued for patent infringement, it has one year from the date that suit was commenced to file a petition for inter partes review. 35 U.S.C. 315(b); see *Thryv*, 590 U.S. at 47.

The Director of the USPTO may institute an inter partes review proceeding if he finds a "reasonable likelihood that the petitioner would prevail" with respect to

at least one of its challenges to the validity of a patent. 35 U.S.C. 314(a). The Board then conducts a review of the patent's validity. See 37 C.F.R. 42.4(a). The petitioner and patent owner may conduct limited discovery, submit briefs and evidence, and obtain an oral hearing. See 35 U.S.C. 316(a)(5), (8), and (10). Unless the proceeding is dismissed, the Board "shall issue a final written decision" addressing the patentability of the challenged claims. 35 U.S.C. 318(a). A party dissatisfied with the Board's decision may appeal to the Federal Circuit. 35 U.S.C. 141(c), 319. When judicial review is complete or the time for appeal has expired, the Director cancels any patent claims determined to be unpatentable. 35 U.S.C. 318(b).

2. a. Petitioner owns U.S. Patent Nos. 8,878,949 and 8,553,079, which claim systems and methods for capturing images when a camera detects certain gestures. See Pet. App. 1a-2a, 22a-23a, 28a-29a, 57a-58a. The '949 patent expired in 2020, and the '079 patent expired in 2019. See *id.* at 4a, 62a n.5. In 2021, petitioner brought a series of suits alleging that various defendants, including respondents Apple Inc., LG Electronics Inc., and LG Electronics USA, Inc., had infringed the '949 and '079 patents. See *id.* at 89a-90a, 129a-130a. After those suits were filed, Apple, LG, and respondent Google LLC petitioned for inter partes reviews of the '949 and '079 patents, and another defendant requested ex parte reexaminations of the same patents. See *id.* at 3a, 17a, 28a, 57a, 88a, 128a-129a.

The Board instituted and conducted inter partes reviews of the '949 and '079 patents. See Pet. App. 88a, 129a. In its final written decisions, the Board found certain claims of both patents unpatentable for obviousness under 35 U.S.C. 103, while rejecting the patentability

challenges to the remaining claims. Pet. App. 126a, 155a. The Board rejected petitioner's arguments that the USPTO lacked authority to reconsider the validity of expired patents. *Id.* at 124a-126a, 153a-155a.

The USPTO also granted the requests for ex parte reexamination of the '949 and '079 patents. See Pet. App. 17a-18a, 22a. An examiner rejected certain claims of both patents for anticipation under 35 U.S.C. 102 or for obviousness under 35 U.S.C. 103, while confirming the patentability of the remaining claims. See Pet. App. 28a, 30a-31a, 57a, 59a-62a. The Board affirmed the examiner's rejections, *id.* at 56a, 85a-86a, and again rejected petitioner's arguments that the USPTO lacked authority to reconsider expired patents, *id.* at 52a-55a, 81a-84a.

b. i. With respect to the inter partes review of the '949 patent, Apple appealed to the Federal Circuit as to the claims that the Board had upheld, and petitioner cross-appealed as to the claims the Board had found unpatentable. See Pet. App. 1a-2a. The court of appeals reversed with respect to one claim that the Board had upheld, but the court otherwise affirmed the Board's decision. *Ibid.*

As relevant here, the Federal Circuit held that the Board could lawfully conduct an inter partes review of the '949 patent even though that patent had expired before the petitions for inter partes review were filed. Pet. App. 4a-7a. The court observed that, in *Oil States Energy Services, LLC* v. *Greene's Energy Group, LLC*, 584 U.S. 325 (2018), this Court had "concluded that [inter partes reviews] fall within the public-rights doctrine and do not violate Article III" because the grant of a patent "involves public rights"—specifically, a "public franchise"—and inter partes review "involves a 'second look' at the earlier determination of granting a public

right in the first place." Pet. App. 5a-6a (quoting *Oil States*, 584 U.S. at 336). The Federal Circuit concluded that petitioner's proffered distinction between expired and unexpired patents was "incompatible with the Court's logic in *Oil States*." *Id.* at 6a. The court explained that the "review of an earlier grant of a patent" in an inter partes review "inherently involves the adjudication of a public right," regardless of "whether the patent has expired." *Ibid.*

The Federal Circuit further disagreed with petitioner's assertion that the "'public franchise'" conferred by a patent "'ceases to exist' after a patent expires." Pet. App. 6a (citation omitted). The court explained that an expired patent "continues to confer a limited set of rights to the patentee," including the right to seek damages for past infringement that occurred during the patent's term of exclusivity. *Ibid.* The court observed that petitioner had "fail[ed] to explain why an [inter partes review], which 'would have a consequence on any infringement that occurred during the life' of the patent, falls outside the scope of the public-rights doctrine solely because the patentee's prospective right to exclude others has terminated." *Id.* at 7a (quoting *Sony*, 924 F.3d at 1238 n.1) (citation omitted).

ii. Petitioner also appealed the Board's decisions in the inter partes review of the '079 patent and the ex parte reexaminations of both patents. The Federal Circuit affirmed in all three of those appeals. Pet. App. 16a, 22a, 26a-27a. In each one, the court rejected petitioner's arguments that the Board lacked authority to reconsider the validity of expired patents, deeming those contentions "resolved, and rejected," by the court's decision in the '949 patent inter partes review appeal. *Id.* at 21a, 25a, 27a.

ARGUMENT

Petitioner contends (Pet. 17-21) that inter partes review and ex parte reexamination of an expired patent violate Article III. The court of appeals correctly rejected that contention, which is inconsistent with this Court's decision in *Oil States Energy Services, LLC* v. *Greene's Energy Group, LLC*, 584 U.S. 325 (2018), other precedent, and constitutional text and history. And the question presented has limited practical significance, since the USPTO appears to have rarely used inter partes review or ex parte reexamination to reconsider the validity of expired patents. Further review is not warranted.

1. Article III provides that the "judicial Power of the United States, shall be vested in one supreme Court, and in such inferior Courts as the Congress may from time to time ordain and establish." U.S. Const. Art. III, § 1. "[I]n general," this provision prevents Congress from withdrawing from Article III courts "'any matter which, from its nature, is the subject of a suit at the common law, or in equity, or admiralty.'" *Stern* v. *Marshall*, 564 U.S. 462, 484 (2011) (citation omitted). This Court has long recognized, however, that Congress may authorize non-Article III tribunals to adjudicate matters "involving 'public' as opposed to 'private' rights." *Thomas* v. *Union Carbide Agric. Prods. Co.*, 473 U.S. 568, 585 (1985); see, *e.g.*, *Murray's Lessee* v. *Hoboken Land & Improvement Co.*, 59 U.S. (18 How.) 272, 284 (1856). The "mode of determining matters" involving public rights "is completely within congressional control": Congress may "reserve to itself the power to decide, may delegate that power to executive officers, or may commit it to judicial tribunals." *Crowell* v. *Benson*,

285 U.S. 22, 50 (1932) (quoting *Ex parte Bakelite Corp.*, 279 U.S. 438, 451 (1929)).

The Court's "precedents have recognized that the [public-rights] doctrine covers matters 'which arise between the Government and persons subject to its authority in connection with the performance of the constitutional functions of the executive or legislative departments.'" *Oil States*, 584 U.S. at 334 (quoting *Crowell*, 285 U.S. at 50); see *Stern*, 564 U.S. at 490-491 ("[W]hat makes a right 'public' rather than private is that the right is integrally related to particular Federal Government action."). The public-rights doctrine thus encompasses "the granting of * * * patent rights," *SEC* v. *Jarkesy*, 603 U.S. 109, 130 (2024) (citing *United States* v. *Duell*, 172 U.S. 576, 582-583 (1899)), along with diverse other matters including the "assessment of tariffs," "relations with Indian tribes," "collection of revenue," "administration of public lands," and "granting of public benefits such as payments to veterans" and "pensions," *id.* at 129-130 (citing additional cases). The federal government need not be a party to the agency adjudication. Rather, a dispute between private parties may implicate public rights if "the claim at issue derives from a federal regulatory scheme," or if "resolution of the claim by an expert Government agency is deemed essential to a limited regulatory objective within the agency's authority." *Stern*, 564 U.S. at 490.

2. In *Oil States*, this Court held that "[i]nter partes review falls squarely within the public-rights doctrine" and therefore "does not violate Article III." 584 U.S. at 334, 345.

The Court began with the long-settled and undisputed proposition that "the decision to *grant* a patent is a matter involving public rights." *Oil States*, 584 U.S.

at 334-335 (citing *Duell*, 172 U.S. at 582-583). The "grant of a patent involves a matter 'arising between the government and others.'" *Id.* at 335 (quoting *Ex parte Bakelite*, 279 U.S. at 451). Patents are "public franchises" through which the government "take[s] from the public rights of immense value and bestow[s] them upon the patentee"—including the patentee's right to exclude others, which "did not exist at common law," but rather is a "creature of statute law." *Ibid.* (citations omitted; brackets in original).

The *Oil States* Court drew "[a]dditional[]" support for these principles from constitutional text and history. 584 U.S. at 335. "[G]ranting patents is one of the constitutional functions" that Article I expressly entrusts to the political branches "without judicial determination." *Id.* at 335-336 (citation and internal quotation marks omitted); see U.S. Const. Art. I, § 8, Cl. 8. And "from the founding to today, Congress has authorized the Executive Branch to grant patents that meet the statutory requirements for patentability." *Id.* at 336. "When the PTO 'adjudicate[s] the patentability of inventions,' it is 'exercising the executive power'" under Article II, not the judicial power under Article III. *Ibid.* (quoting *Freytag* v. *Commissioner*, 501 U.S. 868, 910 (1991) (Scalia, J., concurring in part and concurring in the judgment)) (brackets in original). For all of these reasons, the Court explained, "the determination to grant a patent is a 'matter involving public rights'" that "need not be adjudicated in Article III court." *Ibid.* (brackets and citation omitted).

Applying these principles, the Court determined that inter partes review similarly concerns public rights because it "involves the same basic matter as the grant of a patent." *Oil States*, 584 U.S. at 336. Inter partes

review is merely "'a second look at an earlier administrative grant of a patent,'" in which the agency "considers the same statutory requirements that the PTO considered when granting the patent." *Ibid.* (quoting *Cuozzo Speed Techs., LLC* v. *Lee*, 579 U.S. 261, 279 (2016)). It thus "involves the same interests as the determination to grant a patent in the first instance," which include "protect[ing] 'the public's paramount interest in seeing that patent monopolies are kept within their legitimate scope.'" *Id.* at 336-337 (quoting *Cuozzo*, 579 U.S. at 279-280).

The patentee in *Oil States* argued that inter partes review involves private rights because patent rights are the "private property of the patentee." 584 U.S. at 337-338 (citation omitted). The Court rejected that argument, explaining that "[p]atents convey only a specific form of property right—a public franchise." *Id.* at 338. And "[a]s a public franchise, a patent can confer only the rights that 'the statute prescribes.'" *Ibid.* (quoting *Gayler* v. *Wilder*, 51 U.S. (10 How.) 477, 494 (1851)). The Patent Act "qualifies any property rights that a patent owner has in an issued patent, subjecting them to the express provisions of the" statute, which "include inter partes review." *Ibid.* (citing 35 U.S.C. 261). The Court concluded that, because "[p]atent claims are granted subject to the qualification that the PTO has 'the authority to reexamine—and perhaps cancel—a patent claim' in an inter partes review," patents "remain 'subject to the Board's authority' to cancel outside of an Article III court." *Id.* at 337 (brackets and citations omitted).

The *Oil States* Court also rejected the contention that, because "patent validity was often decided in English courts of law in the 18th century," inter partes review must concern private rather than public rights.

584 U.S. at 340. The Court explained that "history does not establish that patent validity is a matter that, 'from its nature,' must be decided by a court." *Ibid.* (quoting *Stern*, 564 U.S. at 484). To the contrary, a "prominent feature of the English system" in the 17th and 18th centuries was a procedure that "closely resembles inter partes review," whereby individuals could petition the Privy Council—the Crown's principal advisory body—to revoke a patent outside of court. *Id.* at 340-341. And the U.S. Constitution's Intellectual Property Clause was "'written against the backdrop' of the English system," including the "common practice" of Privy Council proceedings as a permissible "'condition[] * * * for patentability.'" *Id.* at 341-342 (quoting *Graham* v. *John Deere Co.*, 383 U.S. 1, 5-6 (1966)). Accordingly, "[i]t was well understood at the founding that a patent system could include a practice of granting patents subject to potential cancellation in [an] executive proceeding." *Id.* at 341.

3. In this case, the Federal Circuit correctly "confirm[ed]" that the reasoning of *Oil States* fully applies when the USPTO reconsiders the grant of an expired patent. Pet. App. 5a-6a. Whether or not the challenged patent has expired, the administrative proceeding "is simply a reconsideration" of the government's earlier "decision to grant a patent." *Oil States*, 584 U.S. at 334-335 (emphasis omitted). And in both circumstances, the agency "considers the same statutory requirements that the PTO considered when granting the patent." *Id.* at 336. A proceeding with these characteristics "remains a matter involving public rights" that "need not be adjudicated in [an] Article III court." *Id.* at 336, 343.

This conclusion draws further support from the continuity and overlap between the rights conferred by expired and unexpired patents. As explained, an unexpired

patent confers a broader bundle of rights (such as the right to seek injunctions to prevent future infringement) that includes, but is not limited to, the subset of rights that expired patents continue to confer (such as the right to seek damages for past infringement that occurred during the patent term). See pp. 3-4, *supra*. All of these rights are "creature[s] of statute law" that "did not exist at common law." *Oil States*, 584 U.S. at 335 (citations omitted); compare 35 U.S.C. 283 (statutory provision for injunctions), with 35 U.S.C. 284 (statutory provision for damages). And all of these rights are "granted subject to" the "express provisions of the Patent Act," including post-issuance review. *Oil States*, 584 U.S. at 337-338 (citing 35 U.S.C. 261). Although Congress established certain deadlines for post-issuance proceedings, it chose not to "limit [these proceedings] to non-expired patents," as the Board explained below. Pet. App. 125a, 154a; see *id.* at 53a, 82a-83a (similar); 35 U.S.C. 302 (authorizing ex parte reexamination of "any claim of a patent" at "any time"); 35 U.S.C. 311(c)(1), 315(b) (authorizing petitions for inter partes review at least "9 months after the grant of a patent," subject to a one-year time limit if the requesting party has been sued for infringement).

Both before and after a patent expires, the possibility of inter partes review in an administrative proceeding is "one of th[e] conditions" that Congress has permissibly placed on the initial patent grant. *Oil States*, 584 U.S. at 342. For the same reasons, ex parte reexamination of an expired patent is consistent with Article III. See Pet. App. 21a, 25a. Petitioner recognizes that "the constitutional question presented in [its] petition applies to both forms of administrative adjudication," Pet. 4 n.2, and it does not suggest that the answer to

that question could vary as between the two post-issuance review mechanisms.

4. Petitioner's contrary arguments lack merit.

a. In seeking to distinguish *Oil States*, petitioner contends (Pet. 17-18) that administrative reconsideration of an expired patent involves only "private rights" because an expired patent "no longer confers the public franchise." That is incorrect. The public franchise granted by a patent is "the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States." 35 U.S.C. 154(a)(1); see *Oil States*, 584 U.S. at 335. One of the key methods by which the Patent Act secures and effectuates those rights is by conferring on the patent owner "a right of action" to "bring a suit at law for damages * * * 'for past infringements'" that occurred during the patent term. *Crown Die & Tool Co.* v. *Nye Tool & Mach. Works*, 261 U.S. 24, 40-41 (1923) (quoting 3 William C. Robinson, *The Law of Patents for Useful Inventions* § 937 (1890)); see 35 U.S.C. 271(a), 281, 284. A patent holder does not lose that right when the patent term ends. Rather, until the statute of limitations has run, the patent holder may seek retrospective relief even after the patent expires. See pp. 3-4, *supra*.

Petitioner is similarly wrong to contend (Pet. 17) that this Court's reasoning in *Oil States* "hinged on the ongoing nature of public patent monopolies." This Court's opinion did not distinguish between expired and unexpired patents. Instead, the Court relied on features of post-issuance review—including the facts that inter partes review is a mechanism by which an executive agency reconsiders its *own* prior decisions, see *Oil States*, 584 U.S. at 336, and that the Board in inter partes review "considers the same statutory requirements that

the PTO considered when granting the patent," *ibid.*—that apply equally to expired and unexpired patents.

b. Petitioner asserts (Pet. 18) that "the public has no stake in the outcome" of administrative reconsideration of an expired patent because cancellation of an expired patent serves only "to extinguish the patentee's actual or potential claims against private parties for past infringement." But Congress intended inter partes review to serve in part as a speedier and less costly alternative to district-court litigation, see *Thryv*, 590 U.S. at 54 (noting Congress's intent, in enacting the AIA, to "limit unnecessary and counterproductive litigation costs") (citation omitted), and inter partes review can continue to serve that public purpose even after a patent has expired. Congress clearly contemplated that petitions for inter partes review might be filed by defendants in infringement suits, as evidenced by its enactment of 35 U.S.C. 315(b), which establishes special timing requirements when such defendants seek inter partes review. See *Thryv*, 590 U.S. at 56 ("The purpose of § 315(b) * * * is to minimize burdensome overlap between inter partes review and patent-infringement litigation.").

The AIA does not *require* the USPTO to institute an inter partes review under any circumstances. See *Cuozzo*, 579 U.S. at 273 (citing 35 U.S.C. 314(a)). The USPTO therefore could permissibly decide, as a matter of agency discretion, that inter partes reviews of expired patents represent a poor use of agency resources and therefore should not be instituted. Petitioner is wrong, however, in arguing that Article III bars post-issuance administrative review of such patents.

c. In claiming support from "centuries of patent practice," Pet. 2, petitioner largely recycles arguments that this Court considered and rejected in *Oil States*.

Petitioner asserts that the rights conferred by patents "historically have been adjudicated in the courts." Pet. 13. But the fact that courts have historically decided questions of patent validity (see Pet. 13-14) does not mean that *only* courts may do so. See *Oil States*, 584 U.S. at 342 (explaining that "matters governed by the public-rights doctrine 'from their nature' can be resolved in multiple ways") (citation omitted). Petitioner's historical account also omits any mention of Privy Council review and revocation, the "prominent feature" of prerevolutionary English patent practice that this Court identified as a key precedent for patent "cancellation in [an] executive proceeding." *Id.* at 341; see p. 14, *supra*. And while petitioner draws an analogy to land patents, Pet. 21 n.3, the *Oil States* Court explained that "[m]odern invention patents" are "meaningfully different from land patents" because the "current Patent Act * * * gives the PTO continuing authority to review and potentially cancel patents after they are issued," 584 U.S. at 339 n.3.

Like the unsuccessful challenger in *Oil States*, petitioner also relies on "broad declarations" in older cases that, "best read," "do not resolve Congress' authority under the Constitution to establish a different scheme." 584 U.S. at 339. Petitioner relies in part (Pet. 14) on this Court's holding in *Root* v. *Railway Co.*, 105 U.S. 189 (1882), that a court of equity lacked jurisdiction over an action for infringement of an expired patent because "an action at law for the recovery of damages" would provide an adequate remedy. *Id.* at 216-217. That proposition has no bearing on whether Congress may authorize an administrative tribunal to resolve challenges to an expired patent's validity.

d. Petitioner's analogies to "other intellectual property rights" (Pet. 20-21) likewise do not support its

constitutional argument here. Petitioner observes that the statutory procedures for the USPTO to expunge or reexamine registered trademarks "only apply to currently registered trademarks." Pet. 20 (citing 15 U.S.C. 1066a(b)(1), 1066b(c)(1)). Petitioner also asserts (Pet. 20) that the Copyright Office "will not cancel" certain copyright registrations "that ha[ve] expired." U.S. Copyright Office, *Compendium of U.S. Copyright Office Practices* § 1807.2 (3d ed. 2021); see 37 C.F.R. 201.7. But the existence of statutory and regulatory limits on administrative reconsideration of trademarks and copyrights does not suggest that Article III imposes the same restrictions on the USPTO's post-issuance review proceedings.

5. The question presented does not warrant this Court's review. Contrary to petitioner's assertion (Pet. 27), the Federal Circuit's decisions below do not "represent a massive expansion of the PTO's jurisdiction." Since Congress created ex parte reexamination 45 years ago, the USPTO has consistently maintained through regulation that an ex parte reexamination request may be filed "at any time during the period of enforceability of a patent." 37 C.F.R. 1.510(a) (1981). For purposes of this rule, "[t]he period of enforceability is the term of the patent * * * plus the 6 years after the end of the term during which infringement litigation may be instituted." U.S. Patent and Trademark Office, U.S. Dep't of Commerce, *Manual of Patent Examining Procedure* § 2211 (4th ed. Rev. 7, July 1981); see, *e.g.*, *Ex parte Papst-Motoren*, 1 U.S.P.Q.2d 1655, at *1-*2 (BPAI 1986) (addressing ex parte reexamination of expired patent).

Although the USPTO has long made clear that expiration of a patent does not *preclude* the use of ex parte reexamination, actual post-issuance reconsideration proceedings involving expired patents appear to have been

relatively infrequent. This case is the "first time" the Federal Circuit has addressed the question presented, Pet. 4, even though ex parte reexamination has existed for 45 years, and the AIA was enacted nearly 15 years ago. The apparent dearth of cases presenting this issue provides an additional reason for this Court to deny review.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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