No. 24-1281

IN THE

Supreme Court of the United States

GESTURE TECHNOLOGY PARTNERS, LLC,
Petitioner,

v.

UNIFIED PATENTS, LLC, APPLE INC., LG ELECTRONICS INC., LG ELECTRONICS USA, INC., AND GOOGLE LLC,
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.

Unified Patents Acquisition, LLC, Unified Patents Holdings, LLC, Unified Patents Management, LLC, and UP HOLDCO INC. own 10% or more of Respondent Unified Patents, LLC.

TABLE OF CONTENTS

Page

TABLE OF AUTHORITIES

Page(s)

Cases

Constitutional Provisions

Statutes

Other Authorities

INTRODUCTION

Gesture presents this petition as a follow-on to its co-pending petition in *Gesture Technology Partners, LLC v. Apple Inc., et al.*, S. Ct. No. 24-1280 ("*Gesture I*"), asking the Court to "hold its decision on a writ of certiorari" here pending the outcome of Gesture's petition there. Pet. 2. Respondents agree that the two petitions rise and fall together: Both seek review of a question this Court already resolved, on which no Federal Circuit judge has since expressed disagreement, and fail to demonstrate any error by the court of appeals, much less one that warrants this Court's intervention. Both should therefore be denied.

In the cases underlying the follow-on petition here, the Patent Office invalidated many of Gesture's patent claims, and the Federal Circuit affirmed. In doing so, the Federal Circuit faithfully applied this Court's 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 some of the Respondents here—for allegedly infringing 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 seeking 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. Respondents availed themselves of the inter partes review process, and the Patent Office determined in each proceeding that many of Gesture's patent claims should not have issued.

Gesture's petition reiterates the request in the *Gesture I* petition for this Court to rule that the inter partes review proceedings were constitutionally infirm. But *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. *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.

Because neither the *Gesture I* petition nor the follow-on petition here presents a question warranting this Court's review, the Court should deny both petitions outright. Should the Court grant certiorari in *Gesture I*, Respondents agree with Gesture that this petition should be held pending the resolution of that case.

STATEMENT OF THE CASE

The private-party Respondents' Brief in Opposition to the petition in *Gesture I* provides a detailed statement. Respondents here provide a condensed statement.

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).

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 v. Marvel Ent., LLC*, 576 U.S. 446, 451 (2015).

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.

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)).

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.

And 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).

This reexamination process has been understood from its inception to apply equally to expired and non-expired patents alike. The agency developed specific rules for reexamination of expired patents. *See, e.g.*, Manual of Patent Examining Procedure §§ 2249-2250 (4th ed. July 1981), https://perma.cc/R2EF-KJAN ("No amendment or new claims may be proposed [during reexam] for entry in an expired patent") (citing 37 C.F.R. § 1.530(d) (1981)). And the Patent Office applied these rules in practice, conducting reexaminations of expired patents. *See, e.g.*, *Ex Papst-Motoren*, 1 U.S.P.Q.2d 1655, at *1-2 (B.P.A.I. 1986).

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). As relevant here, the AIA 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). The AIA also 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, 18. 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).

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

As noted in the private-party Respondents' Brief in Opposition to the *Gesture I* petition (at 11-13) this petition concerns two sets of inter partes review appeals involving Gesture's '431 patent.

After Gesture asserted the '431 patent against them, Apple, LG, and Google each brought inter partes review challenges; the Board combined and decided these proceedings together. *See* Pet. App. 1a. Unified also brought an inter partes review challenge. *See* Pet. App. 25a. The Board issued a mixed decision on patentability in both cases. The parties sought further review before the Federal Circuit.

The Federal Circuit upheld the Board's judgment about the patentability of all affected claims. Pet. App. 1a-2a, 25a. In both sets of appeals, Gesture also

argued to the Federal Circuit that inter partes review proceedings are unconstitutional. The Federal Circuit applied its holding in *Gesture I* to reject Gesture's jurisdictional challenges in these inter partes review appeals. *See* Pet. App. 24a, 26a.

REASONS TO DENY CERTIORARI

This petition presents the same question as the petition in *Gesture I*: 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.

This Court has already resolved the question presented in *Oil States*, which definitively 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's holding in *Oil States* did not, as Gesture suggests, "hinge[] on the ongoing nature of public patent monopolies." No. 24-1280 Pet. 17; *see* Pet. 10. 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.*, 584 U.S. 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).

Gesture's theory is therefore irreconcilable with *Oil States* and a host of other precedents from this Court, none of which Gesture asks this Court to revisit. 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, 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 remains true 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. At all times, the same public franchise is being asserted, and the same conditions on that franchise apply.

Accordingly, the Federal Circuit's straightforward application of this Court's 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. 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*.

CONCLUSION

The Court should deny the petition. Should it grant Gesture's petition in *Gesture I*, the Court should hold this petition.

Respectfully submitted,

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