

No. 24-461

IN THE
Supreme Court of the United States

ISLAND INTELLECTUAL PROPERTY LLC,

Petitioner,

—v.—

TD AMERITRADE, INC., *et al.*,

Respondents.

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

**REPLY BRIEF IN SUPPORT OF PETITION
FOR WRIT OF CERTIORARI**

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QUESTIONS PRESENTED

For **Question 2**, Island is submitting an amicus brief (“IslandAB”) in support of the pending Petition for Writ of Certiorari filed by ParkerVision, Inc. (“ParkerVision Pet.”) in *ParkerVision, Inc. v. TCL Industries Holdings Co., Ltd. et al.*, No. 24-518 (Sup. Ct. filed Nov. 4, 2024) (“*ParkerVision*”).

This case (*Island*) raises the issue of Local Rule 36 affirmances in the context of appeals of district court decisions under 28 U.S.C. §1291. *ParkerVision* presents the issue of appeals from the USPTO under 35 U.S.C. §144, which requires the Federal Circuit to issue “its mandate and opinion.”

Island urges this Court to accept both Petitions together to address Question 2, which collectively ask:

- whether the Federal Circuit’s Local Rule 36 properly designates how and when summary affirmances can be used,
- when and how much information needs to be included in summary affirmances, and
- whether the differences in context between an appeal from the USPTO under 35 U.S.C. § 144 requiring issuance of a “mandate and opinion” (such as in *ParkerVision*), and a district court proceeding under 28 U.S.C. § 1291 (such as in *Island*) mandate different treatment.

ADDITIONAL RELATED CASES

In addition to the Related Cases identified at Pet. ii, Island identifies the following additional related cases:

For **Question 1**, Amicus Brumfield identified following case:

- *Brumfield, Tr. For Ascent Tr. v. IBG, LLC*, No. 22-1630, (Fed. Cir. filed March. 27, 2024), reported at 97 F.4th 854.

For **Question 2**, Island is submitting an amicus brief (“IslandAB”) in support of the pending Petition for Writ of Certiorari filed by ParkerVision, Inc.:

- *ParkerVision, Inc. v. TCL Industries Holdings Co., Ltd. et al.*, No. 24-518 (Sup. Ct. filed Nov. 4, 2024) (“*ParkerVision*”).

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INTRODUCTION

Island submits this Reply Brief to TD Ameritrade, Inc. et al. (“TD”)’s BIO.

TD asserts that “[t]his case does not present any issue that warrants this court’s review” (BIO, 1), but the arguments and evidence TD presents reveal the opposite.

On **Question 1**, TD:

- presents different facts (BIO, 4-9) than those set forth below (Pet., App. 24a, 8a-9a) for the ‘286 Patent;
- does not credit the factual assertions supported by Island’s 1400 pages of evidence (BIO, 9-11; *cf.* Pet., 10, 15-16); and
- misinterprets this Court’s holdings in *Alice/Bilski/Mayo* (BIO, 1, 13-16, 20; *cf.* Pet., 15-16, 21-22) and the Federal Circuit’s en banc holding in *Berkheimer* (BIO, 18-19; *cf.* Pet., 19-20, 40-41).

TD confirms that *Tolan*’s axiom was not followed here. (BIO, 9-12, 13-21). Such errors are widespread in patent cases under the Federal Circuit’s supervisory jurisdiction. Pet., 29-33; BAB 8-10.

On Question 2, TD:

- does not dispute that the Federal Circuit’s Local Rule 36 practice is out of step with and different from its sister circuits (Pet., 41-42; BPLAAB, 5-6; ParkerVision Pet., 33-34), but argues this is somehow not a “split” or “conflict” (BIO, 25-28);
- does not dispute that Local Rule 36 judgments are entered extensively (Pet., i, 7, 35-41), and the subject of many petitions to this Court (BIO 21-22), but argues that the Court should not take this case, because it turned down others prior (BIO, 21-22);
- asserts dicta in *Taylor* (written before the Federal Circuit’s founding) recognizing that courts have discretion on how and when to write opinions somehow resolves the issue of whether the current Local Rule 36 practice of not writing opinions (DCBAB, 5) is an abuse of discretion (BIO, 22-23); and
- argues Rule 36 Affirmances are well understood (BIO, 24), but offers an explanation contrary to the Federal Circuit’s own explanation (*cf. Rates Tech., infra*; BPLAAB, 8; FIFAB, 4, 7).

These do not counsel against granting certiorari or for continuing to ignore the overuse of Local Rule 36. (Pet., i, 7, 35-41; IslandAB, i, 6-7, 10, 13-17, 20-21; FIFAB, 4, 8-10).

TD also leaves un rebutted the ills associated with such practice (Pet, 36; *see also* IslandAB 20-21), and the well-established benefits of a court explaining to the parties and public the bases of its decisions. (Pet., 37-41; *see also* IslandAB, 17-20).

When the Federal Circuit was established, Chief Judge Markey made a solemn promise: **“In our Court there will be an opinion explaining enough to tell you what the law is in every case. *** We do not just render a one-worded decision and go away”** 100 F.R.D. 499, 511 (1983).¹

For the past decade, this promise was abandoned.

This Court’s guidance when an explanation is necessary for circuit court judgments is needed. This case is a proper vehicle to address the questions presented and certiorari should be granted (either separately, or with *ParkerVision*).

¹ All bolding added.

I. Contra *Tolan*, TD Offers a Patent-Specific Rule for Summary Judgment That Ignores Factual Disputes on Summary Judgment

Question 1 takes no issue with the *Alice/Bilski/Mayo*. Rather, the issue is how the Federal Circuit and lower courts ignore the rules of civil procedure as they apply that framework.

The *Alice/Mayo* “framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts” is simple and straightforward:

[*Alice/Mayo* Step 1]: “First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts.”

[*Alice/Mayo* Step 2]: “If so, we then ask, ‘(w)hat else is there in the claims before us?’ To answer that question, we consider the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application. We have described step two of this analysis as a search for an ‘inventive concept’ — *i.e.*, an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more

than a patent upon the [ineligible concept] itself.”

Alice Corp. v. CLS Bank Int’l, 573 U.S. 208, 217-218 (2013) (citations omitted).

Both steps involve determinations of historical fact, and both need to be considered to find claims ineligible.

For *Alice/Mayo Step 1*, TD asserts the Island claims are abstract as a matter of law by analogy to *Alice* and other cases. This argument ignores how this Court concluded “intermediated settlement” was abstract in *Alice*, and “hedging risk” was abstract in *Bilski*. (Compare BIO, 1, 15-16, 19-20, with Pet., 15-16, 21-22).

Contra TD, *Alice* did not hold the claims abstract “on their face” alone, or simply by citing *Bilski*. BIO, 19-20. Rather, *Alice* used textbooks by Emery, Yadav, and Hull. 573 U.S. at 219-220. Collectively, this evidence established that “intermediate settlement” was a “fundamental economic activity **long prevalent in our system of commerce**”. *Id.*; Pet., 15-16.

Similarly, *Bilski* used textbooks to find “hedging risk” was a “fundamental economic activity **long prevalent in our system of commerce**”. 561 U.S. 593, 611 (2010); Pet., 15-16, 21-22.

Both *Alice* and *Bilski* used historical facts to establish the claims were “long prevalent in our system of commerce”, which changes over time.

The courts below did not identify any similar evidence but instead ignored factual disputes. *Cf.* Pet., App. 24a, 8a-9a. TD’s BIO identifies specific factual disputes (misleadingly labelled “Admissions”) that should have precluded an adverse finding against Island on *Alice/Mayo* Step 1. BIO, 10, n.40 (prior art did not use “aggregated accounts”), n.43 (prior art track funds and transactions “in a different way than in the claimed invention”).

The ‘286 invention offered a technical solution overcoming “the complexity involved in computing the interest earned at each participating bank institution.” (CAFC App., 945). Far from being a “well-established practice”, American Express needed the inventors to figure this out. (*Id.* 1789-1791; Pet.,11). Even TD’s expert had never seen the claimed solution prior to the ‘286 Patent filing. (CAFC App., 1248-1258; Pet., 12).

Thus, the record reflects historical facts (or at least, material factual disputes), which when taken in the light most favorable to Island, demonstrate the invention was not abstract.

For *Alice/Mayo* Step 2, TD (like lower courts) ignores as “immaterial” material factual disputes. (BIO, 19-21). But TD’s BIO reveals material factual disputes over the nonconventionality of the

implementation of the '286 Patent elements. (BIO, 10, n.37 (“the use of tiered interest rates in aggregated accounts”), n.39 & n.40 (“using aggregated accounts to obtain extended FDIC insurance”). Other evidence (Pet., 7a-7d) illustrates material facts with evidentiary support of the non-conventionality of Island’s particular claimed solution. *Cf. Berkheimer v. HP, Inc.*, 890 F.3d 1369 (Fed. Cir. 2018) (en banc).

TD’s rebuttal, that an abstract claim element cannot also supply an inventive concept (BIO, 2, 12, 19-20), is not pertinent here.² The '286 Patent’s inventiveness goes beyond any abstract idea and extends to the **particular way** Island solved tiered interest problems using details elaborated in the claims. The claims do not implement tiered interest rates in general, but tiered interest rates in the context of a system using “aggregated accounts” (1[F]-1[G]), which was previously impracticable (CAFC App., 945, 1789-1791, Pet., 11). Here, “the use of tiered interest rates for aggregated [accounts] ... was non-routine, unconventional, and not well known.” BIO, 10 n.37.

Island solved these technical challenges by achieving non-pro-rata interest determinations in

² In the context of *Alice/Bilski* it also makes no sense. By definition “**fundamental** economic activity **long prevalent in our system of commerce**” would not be novel, so it could not be a “novel” abstract idea.

aggregated accounts in a unique and inventive way, including utilizing:

- an inventive “interest allocation procedures” (Pet., 7c; elements 1[F]/[G]/[H];
- unconventional and non-routine account structures utilizing “FDIC insured and interest-bearing aggregated deposit accounts,” (*id.*, 7d; element 1[A]); and
- unconventional and non-routine data structures in an “electronic database ... comprising a respective balance of funds for ... the respective client accounts ... and information on funds held by each ... of clients ... in the plurality of aggregated deposit accounts”, (*id.*, 7d; element 1[B]).

Each goes beyond the alleged abstract ideas of “aggregated deposit accounts” or “tiered interest rates” and provides “something more”. (Pet., 13-14, citing CAFC App. 248, 27:12-18, 28-34).

TD overreaches by asserting the claims are “invalid as a matter of law” because “their alleged improvements are in the realm of abstract financial ideas”. *Alice* admonishes:

we tread carefully in construing this exclusionary principle **lest it swallow all of patent law**. At some level, “**all inventions ... embody, use, reflect, rest upon, or apply** laws of nature, natural phenomena, or **abstract ideas**.”

Thus, an invention is not rendered ineligible for patent simply because it **involves an abstract concept**. “[A]pplication[s]” of such concepts “to a new and useful end,” we have said, **remain eligible for patent protection**.

573 U.S. at 217 (citations omitted).

* * *

Under *Tolan*, the factual disputes below (Pet., 10-14, 7a-7d) should have precluded granting summary judgment against Island. It is time for this Court to instruct that *Tolan*’s axioms apply to all civil litigation, **including patent cases**.

II. Federal Circuit’s Abusive Local Rule 36 Practice Needs to be Addressed

A. Prior Petitions Demonstrate a Problem, Not a Resolution

TD argues that “the result here should be no different” than seven previously denied petitions on Local Rule 36. (BIO, 22). But the large number of petitions (IslandAB, 24 (identifying 20); DCBAAB, 9-10n.2 (identifying 27)) demonstrates a persistent problem requiring this Court’s correction.

B. Local Rule 36 Is “Out-Of-Step” with the Sister Circuits

TD wrongly states “[t]here is no split in the lower courts” (*compare* BIO, 25, *with* Pet., 35-43; *see also* IslandAB, 9; BPLAAB, 5-6; AAC, 11-12; BAB, 13-15).

Although TD states other circuits use “brief summary affirmance[s]” (BIO, 22), these are night-and-day different from the Federal Circuit’s one-word “affirmances”. The First, Second, Third, Sixth, Seventh, Ninth, Eleventh and D.C. Circuits do not have local rules authorizing judgments without opinions and/or do not issue one-word affirmances. Pet., 41-42; *see also* BPLAAB, 5-6; IslandAB, 11. Those that do use summary affirmances, a common theme is that at least some explanation of the basis for such decision should be provided. IslandAB, 11; BPLAAB, 5-6; *see also* Charles Macedo, *Island Petition Highlights Patent Decisions Increasingly Deviate from*

Civil Procedure Norms, IPWatchdog, June 20, 2024 (collecting circuit rules and practices).

Even a summary opinion, like “we ... affirm for the reasons cited by the district court” (BIO, 27), provides a reason. But “the Federal Circuit’s Rule 36 affirmance is **not an opinion**. It offers no rationale, no factual findings, no conclusion of law, no analysis, and no explanation.” (DCBAAB, 5; IslandAB, 10, 15-16).

C. Local Rule 36 Conflicts with the Federal Circuit’s Mandate

The overuse of one-word affirmances defies the Federal Circuit’s mandate to explain patent law. It was established “to promote greater uniformity in certain areas of federal jurisdiction and relieve the pressure on the dockets of the Supreme Court and the courts of appeals....” *FCIA of 1982*, 96 Stat. 25 (Apr. 2, 1982). But “[t]he Federal Circuit can only fulfill its responsibility for the clear and consistent development of intellectual property law by the dissemination of its reasoning.” BPLAAB, 11 (citing J. Scalia).

At the Court’s inception, Chief Judge Markey explained, in response to “whether the Court [has] to provide reasons for its decisions”:

I don't think you need a rule or a statute.
It is tradition. **It is a requirement of the courts of this land**, thank God. We do not issue fiats. We do not just render

a one-worded decision and go away. We explain our decisions. It is one of the great keys to the American judicial system. It is unfortunate that there are today so many cases that each cannot be explained in detail.

100 F.R.D. at 511; *contra* BIO, 22.

He promised “[i]n our Court **there will be an opinion explaining enough to tell you what the law is in every case.** ... That is the reason for explaining decisions. You would never know what the law is otherwise.” 100 F.R.D. at 511.

The Federal Circuit is now breaking this promise: “On average, over the past ten years, the Federal Circuit has issued one-word affirmances in approximately 35% of cases appealed from a district court or the USPTO.” Pet., 41; BPLAAB, 7 (collecting statistics). The rate is over 40% for appeals from the USPTO. ParkerVision Pet., 32; FIFAB, 4, 8.

D. Local Rule 36 Practice Has Been Ignored, Not Decided

TD argues that *Taylor v. McKeithen* has “[a]lready [r]esolved” this issue, quoting:

We, of course, agree that the courts of appeals should have wide latitude in their decisions of whether or how to write opinions. That is especially true with respect to summary affirmances.

407 U.S. 191, 194 (1972) (quoted in BIO, 23).

TD’s read of *Taylor* (from 1972, before the Federal Circuit’s creation) is misplaced. Providing *discretion* on whether or how a court is to “write opinions” is not the same as granting a court leave to issue one-word decisions **without any explanation** whatsoever. Local Rule 36 judgments are not “opinions”, so *Taylor* does not exculpate the Federal Circuit’s issuance of such one-worded affirmances as TD suggests. (IslandAB, 15-16; DCBAAB, 5).

E. TD Misunderstands Local Rule 36 “Affirmances”

TD’s proffers that “[h]ere, a summary affirmance indicates that the circuit court agreed with the court below and found it unnecessary to provide an additional opinion to repeat the same bases” and are “[w]ell understood” (BIO, 23-25). But the Federal Circuit confirms the opposite:

Since there is **no opinion**, a Rule 36 judgment simply confirms that the trial court entered the correct judgment. **It does not endorse or reject any specific part of the trial court’s reasoning.**

Rates Tech., Inc. v. Mediatix Telecom, Inc., 688 F.3d 742, 750 (Fed. Cir. 2012).

Here (like all such affirmances) the Federal Circuit did not identify which of the five authorized grounds it relied upon. *See* Pet., App. A. With no opinion, it is “impossible to glean which issues th[e] court decided when [it] issued the Rule 36 judgment.” *TecSec, Inc. v. Int’l Bus. Machs. Corp.*, 731 F.3d 1336, 1341-42 (Fed. Cir. 2013); *see also* FIFAB, 9-10.

F. Proper Decision Making Requires Explanations

TD asserts that Rule 36 judgments “are no less carefully decided than the cases in which [the Federal Circuit] issue[s] full opinions”. BIO, 25 (citing *U.S.*

Surgical Corp. v. Ethicon, Inc., 103 F.3d 1553, 1556 (Fed. Cir. 1997)). Of course, *Ethicon* was written prior to the current practice.

More importantly, members of this Court have recognized “explain[ing] *why* and *how* a given rule has come to be ... restrains judges and keeps them accountable to the law and to the principles that are the source of judicial authority.” 37 *Hastings L.J.* at 435 (1986) (Brennan, Ch. J.). *See also* IslandAB, 17-18 (also citing Justices Cardozo, Ginsburg, Scalia).

“The discipline of writing even a few sentences or paragraphs explaining the basis for the judgment insures a level of thought and scrutiny by the court that a bare signal of affirmance, dismissal, or reversal does not.” Ch. J. Patricia Wald, 42 *Md. L. Rev.* 766, 782 (1983); *see also* IslandAB, 18 (quoting commentators explaining, “there is accountability in the giving of reasons”).

Appellate courts do not tolerate unexplained district court decisions. *Pet.*, 41-42. Neither should this Court. IslandAB, 15-17.

TD’s distinction of *Cardinal* (BIO, 23) misses the point. While the particular mechanism may be different, the need for this Court to supervise the Federal Circuit’s extensive use of improper procedures (like vacating invalidity holdings in *Cardinal*, and Local Rule 36 here), is justified. *Pet.*, 39-40; IslandAB, 16.

G. The Federal Circuit's Overuse of Local Rule 36 Causes a Litany of Ills

The Federal Circuit's overuse of Local Rule 36 causes problems, including:

- depriving the parties and public of an explanation of why the decision was made;
- depriving the panel with an opportunity to confirm its own summary conclusion by putting pen to paper and having to think out such conclusion;
- depriving this Court with an appropriate record to review;
- creating distorted views of the law, based on misperceptions of why the panel made its decision;
- undermining the appellate review process by biasing results towards affirmances;
- not providing substantive review, but merely being a docket management tool; and
- abdicating the Federal Circuit's responsibility to develop patent law.

Pet., 36-37; IslandAB 19-20. Yet, TD's BIO does not address these ills at all.

III. This Is a Proper Vehicle

This is an ideal case to address both Questions 1 and 2.

For **Question 1**, the facts squarely present the issue of whether *Tolan* applies in patent cases. (Pet., 10-14). TD’s misplaced “immateriality” argument demonstrates the need for this Court’s supervision to clarify *Tolan*’s application in patent law.

Whether a proper grant of summary judgment violates the Seventh Amendment (BIO, 28) is not at issue. When lower courts violate *Tolan*, however, as is the case here, the Seventh Amendment does come into play.

For **Question 2**, *Island* and *ParkerVision* together provide an ideal vehicle to examine one-word affirmances, both in the context of general appeals under 28 U.S.C §1291 and USPTO appeals under 35 U.S.C. §144. (IslandAB, 22-25).

Together, these cases exemplify how the frequent use of Local Rule 36 affirmances negatively impacts patent law by minimizing transparency, consistency, and accountability.

“In *ParkerVision*’s case, the practice allows the court to sidestep its statutory duty to oversee administrative patent judges through reasoned decision-making. For *Island IP*, the summary affirmation obscures whether the court properly reviewed the district court’s handling of disputed

factual evidence in the summary judgment context.” Dennis Crouch, *The Federal Circuit's Oracle: When Silence Speaks Louder Than Words*, Nov. 25, 2024, <https://patentlyo.com/patent/2024/11/federal-circuits-silence.html>.

Both cases feature well-developed records (IslandAB, II.A), motivated and well-represented parties, and interested amici (IslandAB, II.B). There is no reason to believe the pervasive use of Local Rule 36 will change without this Court’s supervisory review. (IslandAB, II.C).

TD offers no credible rationale for why this is not a proper vehicle for the Court to consider these important issues.

CONCLUSION

A writ of certiorari should issue for Question 1, here, and Question 2, here and in *ParkerVision*.

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