No. ____

In the Supreme Court of the United States

Rovi Guides, Inc.,

Petitioner,

v.

Comcast Cable Communications, LLC;
United States of America,

Respondents.

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

CROSS-PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

The Appointments Clause of the Constitution requires principal officers to be appointed by the President with the advice and consent of the Senate, but permits inferior officers to be appointed by department heads. This case concerns the appointment of administrative patent judges of the Patent Trial and Appeal Board. Administrative patent judges issue final decisions with respect to patentability that are not reviewable by any superior executive officer, and they are removable from office only for cause. Nonetheless, administrative patent judges are appointed by the Secretary of Commerce.

In *Arthrex, Inc. v. Smith & Nephew, Inc.*, 941 F.3d 1320 (Fed. Cir. 2019), the Federal Circuit held that administrative patent judges are principal officers and hence that their appointment by the Secretary of Commerce is unconstitutional. The court attempted to remedy the constitutional defect by severing and invalidating administrative patent judges' tenure protections, which, the court of appeals held, rendered administrative patent judges inferior officers. The court of appeals remanded these cases to the Board based on its decision in *Arthrex.*

The questions presented are:

1. Whether the severance and invalidation of administrative patent judges' tenure protections is consistent with congressional intent.

2. Whether invalidation of administrative patent judges' tenure protections is sufficient to render them inferior officers.

PARTIES TO THE PROCEEDINGS BELOW

Petitioner Rovi Guides, Inc. was the patent owner in the proceedings before the Patent Trial and Appeal Board and the appellant in the court of appeals.

Respondent Comcast Cable Communications, LLC was petitioner in the proceedings before the Patent Trial and Appeal Board and the appellee in the court of appeals.

Respondent United States of America was an intervenor in the court of appeals.

RULE 29.6 STATEMENT

Petitioner Rovi Guides, Inc. states that its parent corporations are Rovi Corporation, TiVo Corporation, and Xperi Holding Corporation.

RELATED PROCEEDINGS

The following proceedings are directly related to this case within the meaning of Rule 14.1(b)(iii):

- *United States v. Image Processing Techs., LLC, et al.*, No. 20-74 (U.S.)
- *Comcast Cable Communications, LLC v. Rovi Guides, Inc., et al.*, No. 20-273 (U.S.)

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PETITION FOR A WRIT OF CERTIORARI

Rovi Guides, Inc. respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit in these cases. Rovi files a single petition for the underlying cases because the court of appeals issued a single judgment disposing of the cases on the same ground. *See* Sup. Ct. R. 12.4. As explained below, Rovi requests that the Court hold this petition pending disposition of the petitions for writs of certiorari in *Arthrex, Inc. v. Smith & Nephew, Inc.*, 941 F.3d 1320 (Fed. Cir. 2019). The Government has filed an omnibus petition for certiorari in 39 cases (including these) and likewise requested that its petition be held pending the Court's disposition of *Arthrex*. *See* Pet. for Cert., *United States v. Image Processing Techs., LLC, et al.,* No. 20-74 (U.S. filed July 23, 2020) ("Gov't Omnibus Pet."). Comcast recently filed its own petition for certiorari in these cases, which also requests a hold pending the disposition of *Arthrex*. *See* Pet. for Cert., *Comcast Cable Commc'ns LLC v. Rovi Guides, Inc., et al.*, No. 20-273 (U.S. filed Aug. 28, 2020).

OPINIONS BELOW

The order of the court of appeals in *Rovi Guides, Inc. v. Comcast Cable Communications, LLC*, Nos. 2019-1215, 2019-1216, 2019-1218, and *Rovi Guides, Inc. v. Comcast Cable Communications, LLC*, Nos. 2019-1293, 2019-1294, and 2019-1295 is unreported but is reproduced at pages 62a–63a of the appendix to the Government's omnibus petition for certiorari. The Patent Trial and Appeal Board's final written

decisions are unreported but are reproduced at pages 3a–479a of the appendix to Comcast's petition for certiorari.

JURISDICTION

The court of appeals had jurisdiction under 28 U.S.C. § 1295(a)(4)(A) and entered judgment on April 22, 2020. On March 19, 2020, by general order, the Court extended the time to file this petition to Monday, September 21, 2020. This Court has jurisdiction under 28 U.S.C. § 1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

The Appointments Clause of the Constitution provides that the President

> shall nominate, and by and with the advice and consent of the Senate, shall appoint ambassadors, other public ministers and consuls, judges of the Supreme Court, and all other officers of the United States, whose appointments are not herein otherwise provided for, and which shall be established by law: but the Congress may by law vest the appointment of such inferior officers, as they think proper, in the President alone, in the courts of law, or in the heads of departments.

U.S. Const. art. II, § 2, cl. 2.

INTRODUCTION

In creating inter partes reviews as part of the America Invents Act, "Congress intended . . . to provide [a] 'quick and cost effective alternative[]' to

litigation in the courts." *PPC Broadband, Inc. v. Corning Optical Commc'ns RF, LLC*, 815 F.3d 734, 741 (Fed. Cir. 2016) (quoting H.R. Rep. No. 112-98(I), at 48 (2011)). As part of this effort, Congress endowed administrative patent judges of the Patent Trial and Appeal Board with the authority to issue final decisions on patentability that are not reviewable by any superior executive officer and instead must be appealed directly to the Federal Circuit. This elimination of "intermediate administrative appeals" of inter partes reviews, Congress reasoned, would "substantially accelerate the resolution" of those proceedings. *Ethicon Endo-Surgery, Inc. v. Covidien LP*, 812 F.3d 1023, 1037 (Fed. Cir. 2016) (quoting 157 Cong. Rec. S1376 (Mar. 8, 2011) (statement of Sen. Kyl)).

The resulting adjudicative regime may well achieve Congress's goal of expediency. But it did so at the intolerable price of the regime's constitutionality.

Administrative patent judges of the Patent Trial and Appeal Board stand apart from the administrative law judges of every other federal agency. The administrative law judges of the SEC, the ITC, the FCC, and other agencies make provisional decisions that are subject to review by the head of the agency. Administrative patent judges, in contrast, have the authority to render final decisions on behalf of the United States, without review by any higher executive-branch official. Under the Constitution's Appointments Clause, such a determinative act may be rendered only by a principal officer—appointed by the President and confirmed by the Senate. Administrative patent judges are not so appointed.

The inter partes review system is therefore unconstitutional.

In *Arthrex, Inc. v. Smith & Nephew, Inc.*, the Federal Circuit correctly held that administrative patent judges are principal officers and therefore that Congress's decision to vest their appointment in the Secretary of Commerce violates the Appointments Clause. 941 F.3d at 1325. In an attempt to remedy the constitutional violation, the court of appeals severed and invalidated "the portion of the Patent Act restricting removal" of administrative patent judges. *Id.* This remedy, the court reasoned, rendered the judges "inferior officers" who may validly be appointed by the Secretary of Commerce. *Id.* The full Federal Circuit denied rehearing en banc, *see* 953 F.3d 760 (Fed. Cir. 2020), and all parties to the *Arthrex* case have petitioned for certiorari. *See* No. 19-1434 (filed June 25, 2020); No. 19-1452 (filed June 29, 2020); No. 19-1458 (filed June 30, 2020).

Arthrex has petitioned for review of two questions: (i) whether the court of appeals' severance remedy was consistent with congressional intent and (ii) whether the court of appeals correctly held that elimination of administrative patent judges' tenure protections was sufficient to render them inferior officers. Both the Government and Smith & Nephew agree that the Court should grant certiorari on these questions. *See* Mem. for the United States at 5, Nos. 19-1452, 19-1457, 19-1458 (July 22, 2020); Br. for Respondents Smith & Nephew, Inc. & Arthocare Corp. at 10, Nos. 19-1434, 19-1458 (July 23, 2020). The Government has also petitioned for review on two questions: (i) whether the court of appeals correctly

held that administrative patent judges were principal officers and (ii) whether Arthrex forfeited its Appointments Clause challenge by raising it for the first time on appeal.[1]

Following the denial of rehearing en banc in *Arthrex*, the Federal Circuit vacated and remanded multiple pending cases—including these—in which the appellant had raised an Appointments Clause challenge in its opening brief in the court of appeals. *See* Gov't Omnibus Pet. App. 62a–63a. The Board has stayed all such cases, holding them "in administrative abeyance until [this] Court acts on a petition for certiorari" on the Appointments Clause issue. General Order in Cases Remanded Under *Arthrex, Inc. v. Smith & Nephew, Inc.*, 941 F.3d 1320 (Fed. Cir. 2019), 2020 WL 2119932, at *1 (P.T.A.B. May 1, 2020).

The Government's omnibus petition for certiorari encompasses many of these cases. It raises the same two questions raised in the Government's *Arthrex* petition and requests that the Court hold these cases pending disposition of the petitions for certiorari in *Arthrex*. *See* Gov't Omnibus Pet. 26. For the reasons explained in Rovi's response to that petition, Rovi agrees that the Court should review the constitutional question (the Government's question (i)) but disagrees that review of the forfeiture question (the Government's question (ii)) is warranted. *See* Mem. of Respondent Rovi Guides, Inc. at 3–11, *United*

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[1] Smith & Nephew petitioned for certiorari on the same two issues.

States v. Image Processing Techs. LLC, et al., No. 20-74 (U.S. filed Aug. 26, 2020).

Rovi now files this cross-petition for certiorari on the two issues presented in Arthrex's petition: whether the court of appeals erred in severing and invalidating administrative patent judges' tenure protections and whether the court of appeals' remedy was sufficient to fix the constitutional problem. For the reasons explained in Arthrex's petition for certiorari and below—and as the Government and Smith & Nephew agree—the *Arthrex* decision raises important questions that are worthy of this Court's review. And, as further explained in Arthrex's petition and below, the court of appeals' severance remedy was deeply flawed and requires correction by this Court.

Rovi therefore requests that the Court grant certiorari in *Arthrex* and hold this petition pending disposition of that case. In the alternative, the Court should grant this petition and address the remedial issues in this case.

STATEMENT

This case arises from six inter partes review proceedings concerning two Rovi patents. These patents cover pioneering technology that allows consumers to use a remote interactive program guide to record TV programs, set program reminders, or adjust parental controls, all from outside the home. Comcast filed a total of six petitions for inter partes review challenging the patentability of the claims of these two patents. After the Board issued final written decisions finding the challenged claims

unpatentable, Rovi appealed, arguing that the appointment of the Board's administrative patent judges by the Secretary of Commerce is unconstitutional under the Appointments Clause. Rovi also challenged the merits of the Board's unpatentability findings.

While Rovi's case was pending, the Federal Circuit decided *Arthrex*. As explained above, the *Arthrex* court agreed that "the statute as currently constructed makes the APJs principal officers" and hence that the appointment scheme established by Congress is unconstitutional. 941 F.3d at 1325. The court also held that Arthrex properly raised its Appointments Clause challenge for the first time on appeal because raising it to the Board "would have been futile." *Id.* at 1339.

In an attempt to cure the constitutional violation, the *Arthrex* court severed and invalidated "the portion of the Patent Act restricting removal of the APJs." *Id.* at 1325. Specifically, the court held that 35 U.S.C. § 3(c), which provides that "[o]fficers and employees of the Office shall be subject to the provisions of Title 5, relating to Federal employees" (provisions which include certain removal protections), was invalid as applied to administrative patent judges. *Id.* at 1337. This severance, the court held, "render[ed] the APJs inferior officers and remed[ied] the constitutional appointment problem." *Id.* at 1325. The upshot is that, as a result of the court's holding, administrative patent judges are removable at will by the Secretary of Commerce.

Following the Federal Circuit's denial of requests for rehearing en banc in *Arthrex*, the court of appeals remanded the six Rovi cases—along with many others—to the Board for hearing by a new panel. *See* Gov't Omnibus Pet. App. 62a–63a.[2] The Board has since stayed all remanded cases pending this Court's review of the Appointments Clause issue. *See* General Order, 2020 WL 2119932, at *1.

REASONS FOR GRANTING THE PETITION

I. THE PROPRIETY OF THE FEDERAL CIRCUIT'S SEVERANCE REMEDY IS AN IMPORTANT QUESTION THAT WARRANTS REVIEW.

A. The Court should grant certiorari on the remedial questions presented by the *Arthrex* decision for the reasons explained in Arthrex's petition.

As Arthrex's petition for certiorari explains (at 16–34), the severability of administrative patent judges' tenure protections is a critically important question that cries out for this Court's review. The *Arthrex* panel itself recognized that the validity of administrative patent judges' appointments is "an issue of exceptional importance." 941 F.3d at 1327. If

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[2] The six underlying Board proceedings gave rise to two sets of consolidated appeals. Appeal Nos. 2019-1215, 2019-1216, and 2019-1218 are the appeals from the three proceedings involving U.S. Patent No. 8,006,263, and Appeal Nos. 2019-1293, 2019-1294, and 2019-1295 are the appeals from the three proceedings involving U.S. Patent No. 8,578,413. The Federal Circuit disposed of both sets of consolidated appeals with a single order.

administrative actors are to have the power to revoke such important property rights, it is essential that the system in which they exercise that power complies with the law. And, while the court of appeals correctly found a constitutional violation here, its chosen remedy was doubly flawed.

First, the court of appeals' remedy creates intractable problems of its own. Elimination of administrative patent judges' tenure protections is inconsistent with congressional intent because—as the relevant statutes demonstrate—Congress intended those judges to adjudicate cases impartially and independently, free from undue influence by other agency officials. Judicial severance of those provisions is therefore impermissible. *See Murphy v. Nat'l Collegiate Athletic Ass'n*, 138 S. Ct. 1461, 1482 (2018) (constitutionally flawed statutory provision is severable only if "the law remains fully operative without the invalid provision," such that the court can infer that Congress would have enacted the valid provisions independent of the invalid ones) (internal quotations omitted); Arthrex Pet. 16–24. As Arthrex explains, the court of appeals should have left the solution to Congress rather than attempting a judicial rewrite of the inter partes review statute. *See* Arthrex Pet. 33–34.

Second, even assuming the court's remedy was permissible—and it was not—the remedy does not fix the constitutional problem. Administrative patent judges, even if removable at will, remain empowered to issue final decisions on behalf of the executive branch and therefore remain principal officers. *See, e.g.*, *Ass'n of Am. R.R.s v. U.S. Dep't of Transp.*, 821

F.3d 19, 39 (D.C. Cir. 2016) (holding that Amtrak arbitrator was a principal officer because there was no "procedure by which [an] arbitrator's decision is reviewable by" the agency head); Arthrex Pet. 25–33.

Rovi incorporates Arthrex's arguments by reference and will not repeat them in detail here. Instead, Rovi offers additional analysis concerning the flaws in the court of appeals' severability holding and the pernicious consequences that will flow from that holding if it is permitted to stand.

As explained in the following section, severing administrative patent judges' removal protections renders them unable to preside over inter partes review proceedings consistent with the Administrative Procedure Act. It follows that, unless and until this Court steps in to correct the Federal Circuit's misguided remedy, every order or decision the Board issues will be invalid under the APA. This Court's review is urgently needed.

B. The *Arthrex* court's severance remedy was impermissible because it renders administrative patent judges unable to lawfully preside over inter partes reviews.

1. Section 556 of Title 5, which governs formal adjudications under the APA, requires such adjudications to be conducted by one of three categories of actors: "(1) the agency; (2) one or more members of the body which comprises the agency; or (3) one or more administrative law judges appointed under [5 U.S.C. §] 3105." 5 U.S.C. § 556(b). Section 3105, in turn, permits agencies to "appoint as many

administrative law judges as are necessary for proceedings required to be conducted in accordance with [5 U.S.C. §§] 556 and 557." Finally, another provision of Title 5, § 7521, prohibits removal of administrative law judges appointed under § 3105 except "for good cause established and determined by the Merit Systems Protection Board on the record after opportunity for hearing before the Board." 5 U.S.C. § 7521(a).

The Federal Circuit has long held that inter partes reviews are "formal administrative adjudications" subject to the requirements of 5 U.S.C. §§ 554 and 556. *See Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1080 (Fed. Cir. 2015); *see generally Dickinson v. Zurko*, 527 U.S. 150 (1999) (APA governs proceedings before the Patent and Trademark Office). This proposition follows inexorably from the statutes themselves. Sections 554 and 556 apply "in every case of adjudication required by statute to be determined on the record after opportunity for an agency hearing," 5 U.S.C. § 554(a), and inter partes reviews fit that description. *See* 35 U.S.C. § 316 (providing that the Patent Trial and Appeal Board must decide inter partes reviews based on the papers after providing the parties an opportunity for an oral hearing). That means, as explained above, that inter partes reviews must be heard by either (1) the agency, (2) members of the body comprising the agency, or (3) one or more administrative law judges.

Administrative patent judges are not the Patent and Trademark Office, and they are not members of a

body comprising the Office.[3] So, if they are to hear formal adjudications under § 556, they must be administrative law judges. *See also* 154 Cong. Rec. H7233-01, 7234–35 (July 29, 2008) (statement of Rep. King) (noting that administrative patent judges are "administrative law judges"); *see also Commerce, Justice, Science, & Related Agencies Appropriations for 2012: Hearings Before the Subcomm. On Commerce, Justice, Science, & Related Agencies of the H. Comm. on Appropriations*, 112 Cong. 196 (Mar. 2, 2011) (statement of USPTO Dir. David Kappos) (similar). And administrative law judges must be subject to the removal protections of 5 U.S.C. § 7521. But—because the court of appeals decreed that administrative patent judges are *not* subject to those removal protections—they are, by definition, not "administrative law judges" within the meaning of § 556. And, because they are not, they can no longer decide inter partes reviews pursuant to § 556.

The *Arthrex* panel stated—in a footnote and without offering any supporting analysis—that "the applicable provision to removal of APJs in Title 5 is § 7513," rather than § 7521. 941 F.3d at 1333 n.4. That is incorrect for the reasons just explained.

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[3] The "[m]embers of the body comprising the agency" clause applies only to agencies that—unlike the Patent and Trademark Office—are themselves multi-member bodies. For example, the "members of the body comprising the" Securities and Exchange Commission are the SEC Commissioners, and the "members of the body comprising the" International Trade Commission are the ITC Commissioners. *See R.A. Holman & Co. v. SEC*, 366 F.2d 446, 455 (2d Cir. 1966).

Moreover, Congress explicitly provided that "[o]fficers and employees of the Office" would be "subject to the provisions of title 5, relating to Federal employees." 35 U.S.C. § 3(c). Those "provisions of title 5" include §§ 3105 and 7521, which, on their face, apply to *all* administrative law judges who hear formal adjudications.

Section 7513, in contrast, applies broadly to "employees" of agencies. No one disputes that administrative patent judges are more than mere employees: they are "Officers of the United States." *See Arthrex*, 941 F.3d at 1328 (noting the parties' agreement that administrative patent judges "are officers as opposed to mere employees"); *cf. Lucia v. SEC*, 138 S. Ct. 2044 (2018) (holding that SEC administrative law judges are "Officers of the United States," not mere employees). Accordingly, the provision of Title 5 specifically governing employment protections for administrative law judges—not the provision of Title 5 generally applicable to agency employees—should apply here. *See Morales v. Trans World Airlines, Inc.*, 504 U.S. 374, 384–85 (1992) ("it is a commonplace of statutory construction that the specific governs the general").

2. The problem with the court of appeals' remedy is no mere technicality. Congress established removal protections for administrative law judges deliberately and for good reason. Congress wanted to ensure that administrative adjudications would be conducted either by the agency itself—which could be held accountable through the political process—or else by independent, impartial decision-makers who were not

beholden to the agency that appointed them. *See Wong Yang Sung v. McGrath*, 339 U.S. 33, 52 (1950).

In the years leading up to the APA's passage, many stakeholders complained that agency adjudicators "were mere tools of the agency concerned and subservient to the agency heads in making their proposed findings of fact and recommendations." *Ramspeck v. Fed. Trial Exam'rs Conference*, 345 U.S. 128, 131 (1953). In enacting the APA in 1946, one of Congress's principal goals was to ensure that these adjudicators could decide disputed matters independently and impartially, without interference by the agency. *See Wong Yang Sung*, 339 U.S. at 38–45.[4]

To that end, Congress established certain "formal requirements to be applicable '[i]n every case of adjudication required by statute to be determined on the record after opportunity for an agency hearing." *Wong Yang Sung*, 339 U.S. at 48 (quoting APA § 5, 60 Stat. 237, 239, 5 U.S.C. § 1004 (1946)). One of these requirements—found in the predecessor to 5 U.S.C. § 7521—was that such adjudications must be

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[4] The idea that executive officers who perform adjudicatory functions should have a measure of independence from the executive has a long pedigree. "[A]s early as 1789 James Madison stated that 'there may be strong reasons why an' executive 'officer' such as the Comptroller of the United States 'should not hold his office at the pleasure of the Executive branch' if one of his 'principal duties' 'partakes strongly of the judicial character.'" *Free Enter. Fund v. Pub. Co. Accounting Oversight Bd.*, 561 U.S. 477, 530 (2010) (Breyer, J., dissenting) (citation omitted).

conducted by an adjudicator who is "removable by the agency in which [she is] employed only for good cause established and determined by the Civil Service Commission . . . after opportunity for hearing and upon the record thereof." *Ramspeck*, 345 U.S. at 132 (quoting APA § 11, 60 Stat. at 244, 5 U.S.C. § 1010 (1946)). These for-cause removal protections, which ensured that the adjudicators' decisions were not unduly influenced by the agency of which they were a part, were a central pillar of the APA. *See Butz v. Economu*, 438 U.S. 478, 513–14 (1978) ("Since the securing of fair and competent hearing personnel was viewed as 'the heart of formal administrative adjudication,' the Administrative Procedure Act contains a number of provisions designed to guarantee the independence of hearing examiners.") (quoting Final Report of the Attorney General's Committee on Administrative Procedure 46 (1941)); *Ramspeck*, 345 U.S. at 131–32.

3. The presence of an independent adjudicator is not simply good practice as a matter of administrative law. This Court has suggested that an "impartial decision maker is [an] essential" element of due process. *Goldberg v. Kelly*, 397 U.S. 254, 271 (1970). Accordingly, if there were any doubt about whether the relevant statutes require administrative patent judges to have for-cause removal protections—and there is not—the constitutional-avoidance canon would resolve it. *See Edward J. DeBartolo Corp. v. Fla. Gulf Coast Bldg. & Constr. Trades Council*, 485 U.S. 568, 575 (1988) ("The elementary rule is that every reasonable construction must be resorted to, in order to save a statute from unconstitutionality.").

The court of appeals should not have invited the serious constitutional concerns that arise if administrative patent judges are "mere tools of the agency concerned and subservient to the agency heads in making their proposed findings of fact and recommendations," *Ramspeck*, 345 U.S. at 131.

4. Section 556(b) contains a savings clause providing that "[t]his subchapter does not supersede the conduct of specified classes of proceedings . . . by or before boards or other employees specially provided for by or designated under statute." Comcast relied on this provision below to argue that Congress implicitly exempted administrative patent judges from the APA's tenure protections by providing for their appointment under 35 U.S.C. § 6 instead of 5 U.S.C. § 3105. Comcast is incorrect.

As explained, inter partes reviews are subject to the formal-adjudication requirements of the APA, which include the strictures of § 556. *See* 35 U.S.C. § 316; *Belden*, 805 F.3d at 1080. And another provision of the APA, 5 U.S.C. § 559, provides that "[s]ubsequent statute[s] may not be held to supersede or modify . . . sections . . . 3105 . . . or 7521 of this title, . . . except to the extent that [they] do[] so expressly." *See also Dickinson*, 527 U.S. at 155 (noting that § 559 expresses "[a] statutory intent that legislative departures from the norm must be clear"); *Five Points Rd. Joint Venture v. Johanns*, 542 F.3d 1121, 1127 (7th Cir. 2008) (APA cannot be amended "by implication").

Given § 559, if Congress wished to carve out an at-will removability exception for the triers of fact in

inter partes reviews, it would have had to do so expressly. But Congress did not do that. It did the opposite, providing that "[o]fficers and employees of the [Patent and Trademark] Office shall be subject to the provisions of title 5, relating to Federal employees," 35 U.S.C. § 3(c)—provisions which include 5 U.S.C. § 7521. The court of appeals overstepped its authority in holding administrative patent judges to be removable at will absent the requisite clear statement from Congress.

5. The foregoing analysis demonstrates that administrative patent judges are statutorily required to enjoy removal protections in order to preside over inter partes reviews. That, in turn, has critical implications for the severability question.

If one provision of a statute is found unconstitutional, the remainder of the statute must also be invalidated if it is "evident that Congress would not have enacted those provisions which are within its power, independently of those which are not." *Murphy*, 138 S. Ct. at 1482 (alterations omitted) (quoting *Alaska Airlines, Inc. v. Brock*, 480 U.S. 678, 684 (1987)); *accord Seila Law LLC v. CFPB*, 140 S. Ct. 2183, 2208–09 (2020). "In conducting that inquiry, [courts] ask whether the law remains 'fully operative' without the invalid provisions." *Murphy*, 138 S. Ct. at 1482 (quoting *Free Enter. Fund*, 561 U.S. at 509). If the answer to that question is no, severance is improper, because "Congress could not have intended a constitutionally flawed provision to be severed from the remainder of the statute if the balance of the legislation is incapable of functioning independently." *Alaska Airlines*, 480 U.S. at 684. Moreover, courts

"cannot rewrite a statute and give it an effect altogether different from that sought by the measure viewed as a whole." *Murphy*, 138 S. Ct. at 1482 (quoting *Railroad Ret. Bd. v. Alton R. Co.*, 295 U.S. 330, 362 (1935)); *see also Bowsher v. Synar*, 478 U.S. 714, 735 (1986) (declining to sever a portion of a law because doing so "would lead to a statute that Congress would probably have refused to adopt").

These principles dictate that the tenure protections applicable to administrative patent judges—the protections the Federal Circuit purported to remove—are not severable from the remainder of the statute. Excising those provisions renders the judges unable to perform one of their primary duties under the statute: issuing final written decisions in inter partes reviews. *See* 35 U.S.C. § 6(c).

Congress would not have written a statute that provides for inter partes reviews to be overseen by judges who lack the authority to decide them. Accordingly, the court of appeals erred in concluding that administrative patent judges' removal protections are severable from the remainder of the statute. As this Court observed in *Alaska Airlines*, "Congress could not have intended a constitutionally flawed provision to be severed from the remainder of the statute if the balance of the legislation is incapable of functioning independently." 480 U.S. at 684.

The consequences of the Federal Circuit's erroneous remedial holding could hardly be more serious. Now that administrative patent judges are removable at will, there is *no one*, other than the

Director of the Patent and Trademark Office (i.e., the agency head himself), who is qualified to sit on an inter partes review panel. That, in turn, means that the Board cannot issue valid final written decisions at all. *See* 35 U.S.C. § 6(c) (inter partes reviews must "be heard by at least 3 members of the Patent Trial and Appeal Board"). In other words, the Federal Circuit's cure was as bad as the disease: in attempting to fix a *constitutional* problem with the inter partes review regime, the court inadvertently created an insurmountable *statutory* obstacle to the regime's continued operation. And until that error is rectified, every single decision the Board renders will be invalid. This Court's review is urgently needed.

II. THE COURT SHOULD HOLD THIS PETITION PENDING DISPOSITION OF *ARTHREX*.

The Court should hold this petition (and the Government's and Comcast's petitions) pending resolution of *Arthrex*. As the Government explains, *see* Gov't Omnibus Pet. 26, the Court's disposition of *Arthrex* will affect the proper disposition of this case, including the resolution of these proceedings on remand to the Board. For example, if the Court holds—as Arthrex and Rovi have argued—that the *Arthrex* court correctly found an Appointments Clause violation but that its severance remedy was impermissible, administrative patent judges will remain improperly appointed principal officers who may not lawfully preside over the underlying inter partes reviews on remand.

The Board has already stayed these cases on remand from the Federal Circuit via its *Arthrex* general order, so holding this petition will not prejudice any party. On the contrary, holding this petition pending this Court's disposition of the Appointments Clause issue will ensure that the remaining proceedings comply with the Constitution and the relevant statutes. This petition should thus be held pending resolution of *Arthrex* and then disposed of accordingly. *See, e.g.*, *Emerson Elec. Co. v. Sipco, LLC*, 2020 WL 3146672, at *1 (U.S. June 15, 2020) (granting, vacating, and remanding after holding petition pending the Court's disposition of *Thryv, Inc. v. Click-To-Call Techs., LP*, 140 S. Ct. 1367 (2020)).

CONCLUSION

The petition for a writ of certiorari should be held pending this Court's disposition of the petitions for a writ of certiorari in *Arthrex* and any further proceedings in this Court, and then disposed of as appropriate in light of the Court's decision in *Arthrex*. In the alternative, the petition for a writ of certiorari should be granted.

Respectfully submitted,

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