No. 24-518

IN THE
# Supreme Court of the United States

PARKERVISION, INC.,
*Petitioner,*

v.

TCL INDUSTRIES HOLDINGS CO., LTD., *et al.*,
*Respondents.*

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

## BRIEF OF THE FAIR INVENTING FUND AS *AMICUS CURIAE* IN SUPPORT OF PETITIONER


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## QUESTION PRESENTED

Whether the Federal Circuit's practice of affirming decisions of the Patent Trial and Appeal Board "without opinion" under Federal Circuit Rule 36(a) violates 35 U.S.C. § 144's requirement that the court "shall issue" an "opinion" in all appeals from PTAB decisions.

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### INTEREST OF *AMICUS CURIAE*[1]

The Fair Inventing Fund advocates for people who invent but are too often shut out of the patent system. To ensure an open, equitable patent system that allows everyone to contribute to the "Progress of Science and useful Arts," U.S. CONST., art. I, §8, the Fund supports accountability at the Patent and Trademark Office. This case offers an opportunity to advance that vital objective.

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[1] Pursuant to this Court's Rule 37.6, *amicus* states that no counsel for a party authored this brief in whole or in part, that no such counsel or party made a monetary contribution intended to fund the preparation or submission of the brief, and that no person other than *amicus* and its counsel made such a monetary contribution.

## SUMMARY OF ARGUMENT

The petition should be granted.

That wasn't very satisfying, was it? When it comes to oversight of the bureaucracy that runs much of our patent system, Congress apparently felt the same way. That is why Congress directed the Federal Circuit to provide an "opinion" explaining its decision when it resolves an appeal from the Patent Trial and Appeal Board. 35 U.S.C. §144. Yet for years, the Federal Circuit has defied Congress's command, affirming hundreds of PTAB decisions "*without* opinion" under Federal Circuit Rule 36. That is untenable.

In this case, the Federal Circuit upheld the PTAB's decision invalidating nine claims of petitioner's patent with a single word: "Affirmed." Pet. App. 112a. The court has made clear that such dispositions neither endorse the reasoning of the decisions they affirm nor imply any explanation of their own. See, *e.g.*, *Rates Tech., Inc.* v. *Mediatrix Telecom, Inc.*, 688 F.3d 742, 750 (Fed. Cir. 2012). Section 144 demands more. It requires an *opinion*—a statement, however brief—giving the *reasons* for the judgment.

The failure to give reasons in PTAB appeals does not merely violate §144. It also hinders the development of patent law and erodes trust in the patent system. With no way to know *why* the Federal Circuit upheld the PTAB's decisions in the approximately 43% of such appeals disposed of under Rule 36, the parties and the public are deprived of judicial guidance on the proper application of the patent laws. And because there is no way to tell whether the court engaged with the parties' arguments, the public cannot be sure that the Federal Circuit is fulfilling its duty to oversee the PTAB's otherwise-unaccountable adjudicators.

## ARGUMENT

### I. THE FEDERAL CIRCUIT'S SUMMARY AFFIRMANCE OF PTAB DECISIONS "WITHOUT OPINION" VIOLATES SECTION 144

Statutory interpretation "begin[s] with the understanding that Congress 'says in a statute what it means and means in a statute what it says there.'" *Hartford Underwriters Ins. Co.* v. *Union Planters Bank, N.A.*, 530 U.S. 1, 6 (2000). There is no mystery about what Congress meant in 35 U.S.C. § 144. By requiring the Federal Circuit to issue an "opinion," the statute requires the Federal Circuit to explain itself when it decides appeals from the PTAB. The court's use of Rule 36 to dispose of such appeals "without opinion" cannot be squared with that requirement.

1. Section 144 provides that, "[u]pon its determination" of an appeal from the PTAB, the Federal Circuit "*shall* issue to the [PTO] Director its mandate *and opinion*, which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case." 35 U.S.C. § 144 (emphasis added).[2]

The statute's text speaks for itself. A court's "opinion" has long been understood as the "statement of the reasons on which the judgment rests." *Rogers* v. *Hill*, 289 U.S. 582, 587 (1933); see *Opinion*, Black's Law Dictionary (12th ed. 2024) ("A court's written statement explaining its decision in a given case."); cf. *Lehnen* v. *Dickson*, 148 U.S. 71, 73 (1893) (using "opinion" to refer to a statement of "'reasons for judgment'"). And Congress's choice of the mandatory phrase "*shall* issue" makes clear that giving reasons is not optional. See *Lexecon Inc.* v. *Milberg Weiss Bershad*

[2] The Lanham Act contains an identical provision for appeals from the Trademark Trial and Appeal Board, 15 U.S.C. § 1071(a)(4).

*Hynes & Lerach*, 523 U.S. 26, 35 (1998) ("shall" ordinarily "creates an obligation impervious to judicial discretion").

That straightforward interpretation also follows from the statute's history. Congress enacted §144's predecessor statute in 1929 when it vested jurisdiction over appeals from the Patent Office in the Court of Customs and Patent Appeals. Pub. L. 70-913, ch. 488, §3, 45 Stat. 1475, 1476 (1929). In language mirroring §144, the statute directed that the court's "opinion" in such appeals "shall be filed" as "part of the record" and transmitted to the Patent Commissioner. *Ibid.*; compare 35 U.S.C. §144 (Federal Circuit "shall issue to the [PTO] Director its mandate and opinion, which shall be entered of record" in the PTO).

Congress imposed that opinion-filing requirement against the backdrop of a longstanding judicial consensus that a similarly worded provision of the Tucker Act required courts to give reasons for their decisions. Enacted in 1887, the original version of the Tucker Act provided that, in suits against the United States, "it shall be the duty of the court to cause a written opinion to be filed in the cause." Tucker Act, ch. 359, §7, 24 Stat. 505, 506 (formerly codified at 28 U.S.C. §764 (repealed 1948)). Courts consistently read that provision to require a statement of "the basis of any judgment against the United States[.]" *United States* v. *Kelly*, 89 F. 946, 952 (9th Cir. 1898); see *P. H. & F. M. Roots Co.* v. *United States*, 17 F.2d 337, 338 (7th Cir. 1927); *United States* v. *Hyams*, 146 F. 15, 17 (1st Cir. 1906).

Congress's decision to include the "same language" requiring an opinion in the 1929 Act and, later, in §144

signals an intent to "incorporate" that settled judicial interpretation. *Bragdon* v. *Abbott*, 524 U.S. 624, 645 (1998).[3]

2. Applied to appeals from the PTAB, Rule 36 plainly violates § 114's "opinion" requirement. Contrary to the statute's plain terms, the rule purports to authorize the court to "enter a judgment of affirmance *without* opinion." Fed. Cir. R. 36(a) (emphasis added). And "[s]ince there is no opinion," a Rule 36 affirmance neither expresses nor implies any reasoning at all. *Rates Tech*, 688 F.3d at 750. It "simply confirms that the trial court entered the correct judgment" without "endors[ing] or reject[ing] any specific part of the trial court's reasoning." *Ibid.*

The Federal Circuit cannot duck the statute by invoking its own rulemaking power. The courts of appeals may "prescribe rules for the conduct of their business" only insofar as such rules are "consistent with Acts of Congress" such as § 144. 28 U.S.C. § 2071(a). Without a carve-out for PTAB appeals, Rule 36 exceeds that authority.

Hypothetical concerns over judicial economy cannot excuse compliance with the statute, either. Weighing the costs and benefits of statutory requirements is *Congress's* job. Congress has long enjoyed unquestioned "power to regulate the practice and procedure of federal courts." *Sibbach* v. *Wilson & Co.*, 312 U.S. 1, 9 (1941); see *Bank of U.S.* v. *Halstead*, 23 U.S. 51, 54 (1825). It has not hesitated to use that power to require that courts give reasons for

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[3] That understanding of the Tucker Act was even more firmly entrenched by the time Congress passed § 144 in 1984, reinserting the opinion requirement after a 30-year hiatus. See, *e.g.*, *United States* v. *Nugent*, 100 F.2d 215, 217 (6th Cir. 1938) (district court's "meagre" factual findings and legal conclusions failed to satisfy the statute, rendering the proceedings "fatally defective") (citing *United States* v. *First Wisconsin Tr. Co.*, 92 F.2d 840, 845 (7th Cir. 1937)).

decisions Congress deems important.[4] Where, as here, Congress's intent to impose such a requirement is plain, its "will must be obeyed." *Williams* v. *Norris*, 25 U.S. 117, 119 (1827).

## II. The Question Presented Is Important and Frequently Recurring

The Federal Circuit's practice of summarily affirming PTAB decisions is particularly damaging given the growing number of PTAB proceedings challenging already granted patents. The Federal Circuit has invoked Rule 36 to affirm PTAB decisions in post-grant proceedings some *580 times* since 2015—nearly *43%* of such appeals decided in that period.[5] The resulting raft of unexplained decisions deprives parties and the public of needed judicial guidance and erodes trust in the patent system.

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[4] See, *e.g.*, 18 U.S.C. § 3553(c) (requiring district courts to "state * * * the reasons for [the] imposition of the particular sentence"); § 3595 (requiring courts of appeals to "state in writing" their reasons concerning the disposition of capital sentence appeals). The Federal Rules likewise frequently require judges to give reasons. See, *e.g.*, Fed. R. Civ. P. 52(a)(1) (requiring, in bench trials, that the court "find the facts specially and state its conclusions of law separately"); Fed. R. Civ. P. 56(a) (requiring the court to "state on the record the reasons for granting or denying" any motion for summary judgment); Fed. R. App. P. 9(a)(1) (requiring district court to "state in writing, or orally on the record, the reasons for an order regarding the release or detention of a defendant in a criminal case"); Fed. R. App. P. 24(a)(2) (requiring district court to "state its reasons in writing" for any denial of a motion to proceed *in forma pauperis*).

[5] See Dan F. Klodowski *et al.*, *Federal Circuit PTAB Appeal Statistics for July, August, and September 2024* (Nov. 5, 2024), https://www.finnegan.com/en/insights/blogs/at-the-ptab-blog/federal-circuit-ptab-appeal-statistics-for-july-august-and-september-2024.html.

### A. The Routine Use of Rule 36 in PTAB Appeals Hinders the Development of Patent Law

As the exclusive appellate court for patent cases, the Federal Circuit has special responsibility for the development of patent law. See *Markman* v. *Westview Instruments, Inc.*, 517 U.S. 370, 390 (1996) (noting the Federal Circuit's intended role in "'foster[ing] technological growth and industrial innovation'"). Rule 36 affirmances abdicate that responsibility.

To make matters worse, the rate of Rule 36 affirmances has climbed at a time when Federal Circuit oversight is more important than ever. Section 7(a)(1) of the America Invents Act, 35 U.S.C. § 6(a), dramatically expanded the PTO's power over patents. Yet the Federal Circuit has vastly increased the proportion of PTO appeals it decides without opinion since the Act took effect, from just 17 (37% of all PTO appeals) in 2010 to over 100 (more than half of all PTAB appeals) in 2016. See Paul Gugliuzza & Mark A. Lemley, *Can a Court Change the Law by Saying Nothing?*, 71 Vand. L. Rev. 765, 781 fig.2 (2018).[6]

The increased use of summary dispositions is particularly harmful because the post-grant proceedings created by the AIA are often used to challenge patents that have been asserted in infringement litigation. When the PTAB cuts off such litigation by invalidating patent claims and the Federal Circuit affirms without opinion, the parties and the public are left without judicial guidance. That is

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[6] Though the rate of Rule 36 affirmances of PTAB decisions declined slightly in subsequent years, it reached 40% in both 2022 and 2023—which roughly matches the long-term average. See Dan F. Klodowski *et al.*, *Special Report: Trends in Federal Circuit PTAB Appeals Through 2023* (April 19, 2024), https://www.finnegan.com/en/insights/blogs/at-the-ptab-blog/special-report-trends-in-federal-circuit-ptab-appeals-through-2023.html.

especially true when Rule 36 is used to affirm PTAB decisions, like the one here, that invalidate patent claims on multiple grounds. Pet. App. 231a. 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, 1341-1342 (Fed. Cir. 2013).

### B. Rule 36 Affirmances Undermine Parties' and the Public's Trust in the Patent System

Affirming the PTAB without opinion has broader consequences, too. Statutes that call for courts to state their "'reasons'" reflect "sound judicial practice." *Rita* v. *United States*, 551 U.S. 338, 356 (2007). The "public statement" of the reasons for a court's decision builds "trust in the judicial institution." *Ibid.* Section 144's opinion requirement reflects that insight.

"The parties to an appeal, particularly the losers, want to know the reasons why." Ruth Bader Ginsburg, Lecture, *The Obligation To Reason Why*, 37 U. Fla. L. Rev. 205, 221 (1985). Without the opinion § 144 demands, "the parties have to take it on faith that their participation in the decision has been real, that the arbiter has in fact understood and taken into account their proofs and arguments." Lon Fuller, *The Forms and Limits of Adjudication*, 92 Harv. L. Rev. 353, 388 (1978). Indeed, the Federal Circuit has itself acknowledged the importance of "tell[ing] the losing party why its arguments were not persuasive" even in unpublished opinions. Fed. Cir. I.O.P. 10.3. Rule 36 affirmances do not do even that.

Explanations need not be long; the Federal Circuit is free to adopt "the bases of the opinion below." Ginsburg, *supra*, at 221. But dispensing with *any* explanation risks "the appearance of arbitrariness," and erodes the public's trust. *Ibid.* Those concerns have special force when a court reviews agency adjudications. That goes double for

PTAB appeals. A 2022 study by the Government Accountability Office found that a *majority* of PTAB adjudicators felt pressured to change their decisions in post-grant proceedings in response to comments from political appointees. *See* Candice Wright, U.S. Gov't Accountability Office, Patent Trial and Appeal Board: Preliminary Observations on Oversight of Judicial Decision-Making 15 tbl.2 (2022). Without robust, transparent oversight by judges insulated from such pressures, the patent system risks losing the public's confidence.

* * *

Congress requires the Federal Circuit to review the PTAB's work with reasons, not rubber stamps. Allowing it to flout that requirement disrupts our balance of powers and erodes public confidence in the administration of justice. This Court's intervention is urgently needed.

## CONCLUSION

For these *reasons*, the petition should be granted.

Respectfully submitted.

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