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 AMICUS CURIAE THE BAR ASSOCIATION FOR THE DISTRICT OF COLUMBIA SUPPORTING PETITIONER

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INTEREST OF *AMICUS CURIAE*[1]

The Bar Association of the District of Columbia ("BADC") is a non-profit organization with an Intellectual Property Section which monitors developments in intellectual property law, regulations, and practice. Members specialize in all aspects of intellectual property law and frequently represent clients before the United States Patent and Trademark Office ("USPTO"), the Federal Circuit, and federal district courts throughout the nation.

In support of its commitment to stare decisis, uniformity, and meaningful appellate guidance, the BADC submits this amicus brief. The Federal Circuit's continued and extensive use of Rule 36 affirmances prevents the intellectual property community from understanding the court's reasoning and the development of clear legal precedent.

The BADC respectfully requests this Court to consider the following and grant Petitioner's writ of certiorari.

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[1] Pursuant to Rule 37.2, *amicus* notified counsel of record for all parties of their intent to file an *amicus* brief at least ten days prior to the due date for the brief. Pursuant to Rule 37.6, *amicus* affirms that no counsel for a party authored this brief in whole or in part, and no person other than *amicus* and their counsel made a monetary contribution to its preparation or submission.

SUMMARY OF ARGUMENT

In *ParkerVision, Inc. v. TCL Industries Holdings Co.*, Nos. 2023-1415, 2023-1417, 2024 WL 2842282, 2024 WL 2842279 (Fed. Cir. June 5, 2024), the Federal Circuit issued another Rule 36 "AFFIRMED" decision, once again bypassing the statutory mandate of 35 U.S.C. § 144:

> The [Federal Circuit] shall review the decision from which an appeal is taken on the record before the USPTO. Upon its determination, the [Federal Circuit] shall issue to the Director its mandate and opinion, which shall be entered of record in the [USPTO] and shall govern the further proceedings in the case.

First, Rule 36 is an "Affirmance Without Opinion" and therefore incapable of providing an opinion, as 35 U.S.C. §144 requires. Second, a Rule 36 order and judgment is not an opinion, as indicated by federal court rules and statutes governing judicial proceedings. Third, Rule 36 disserves the intellectual property ("IP") community, including those in the BADC and their clients. By not sharing the analysis and explanation from the differing perspective, one required with a standard of review and set findings of fact. Fourth, appeals received written opinions before Rule 36 and should do so now.

ARGUMENT

I. Rule 36 Violates 35 U.S.C. §144

35 U.S.C. §144 statutorily requires that "the [Federal Circuit] shall issue to the Director its mandate and opinion."

Rule 36(a) of the Federal Circuit, however, is titled "Judgment of Affirmance Without Opinion." Rule 36(b) further requires that "when a case is disposed of by order without opinion," that affirmance "serves as the judgment when entered." *Id.* Rule 36 is in direct conflict with and contrary to the "opinion" required by 35 U.S.C. §144.

Rule 36's renunciation of the statutory obligation to provide an opinion deprives litigants, the USPTO, and the public of the court's reasoning. As the exclusive appellate body for patents, the Federal Circuit has the unique responsibility to share its legal analysis and reasoning. It is the very lifeblood of consistent and coherent patent caselaw.

II. "Affirmance Without Opinion" Cannot be an "Opinion"

"AFFIRMED" is not an opinion. Rule 36 dictates that the "AFFIRMED" order is also a judgment – thereby disposing of the appeal with one word. If AFFIRMED were considered to be an opinion, it would provide an analysis or explanation of the affirmance, just like an opinion would for a reversal or denial. An opinion should be consistent with federal court rules and statutes governing

judicial proceedings. They explain “opinion” and “order” and distinguish them in the following ways.

Rule 5(b) of the Federal Rules of Appellate Procedure (FRAP) delineates an order from “any related opinion.” *See also* FRAP Rules 21(a)(2)(c), 27(a)(2)(b)(iii), and 30(a)(1). After a court “files an opinion directing entry of judgment,” FRAP Rule 19 directs the involved agency to file “a proposed judgment conforming to the [previous] opinion” of the court. That is a judgment issuing after and based upon a separate opinion. FRAP Rule 32.1 prevents a court from prohibiting or restricting “the citation of federal judicial opinions, orders, judgments, or other written dispositions… .” Opinions and orders are again listed separately. FRAP Rule 36 requires that “when judgment is entered, the clerk must serve on all parties a copy of the opinion—or the judgment, if no opinion was written… .” A court can, of course, provide an unwritten opinion, such as orally or by recognizing a settlement, both of which can still result in a judgment.

Federal statutes describe opinions consistent with FRAP rules.

28 U.S.C. § 1291(b) requires an “opinion” to be a lower court’s written explanation for an interlocutory appeal. *Id.* (“When a district judge … shall be of the opinion that such order involves a controlling question of law as to which there is substantial ground for difference of opinion and that an immediate appeal from the order may materially advance the ultimate termination of the litigation, he shall so state in writing in such order.”). This

statute is applicable to the Federal Circuit by way of 28 U.S.C. § 1291(c).

The Administrative Procedure Act, 5 U.S.C. § 552, requires administrative agencies to publish "final opinions, including concurring and dissenting opinions, as well as orders, made in the adjudication of cases." *See also* 5 U.S.C. § 551(6)–(7) ("adjudication means agency process for the formulation of an order" and "order means the whole or a part of a final disposition"). Opinions and orders are different, and both published.

These federal statutes and rules recognize an "opinion" to be a written explanation of a legal or administrative decision and that orders differ from opinions.

Black's Law Dictionary defines "opinion" as: "A court's written statement explaining its decision in a given case, usu[ally] including the statement of facts, points of law, rationale, and dicta. Also termed judicial opinion." *Opinion*, BLACK'S LAW DICTIONARY (12th ed. 2024).

It is acknowledged that courts of appeals "should have wide latitude in their decisions of whether or how to write opinions." *Taylor v. McKeithen*, 407 U.S. 191, 194 n.4 (1972). 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. The word "affirmed" is not an opinion.

III. Rule 36 Deprives Our IP Community of Meaningful Judicial Review and Legal Precedent

As the exclusive appellate body for patent appeals, the Federal Circuit has a unique responsibility to provide meaningful judicial review and legal precedent to the IP community at large. Rule 36 decisions deprive litigants, the USPTO, this Court, and the public of the court's reasoning.

Rule 36 affirmances are those which the court deems not just non-precedential but unworthy of even explanation. By determining which cases should be affirmed without an opinion, the court preordains which analyses (factual or legal) will have no future applicability or significance. "The judicial power to determine law is a power only to determine what the law is, not to invent it. Because precedents are the 'best and most authoritative' guide of what the law is, the judicial power is limited by them." *Anastasoff v. U.S.*, 223 F.3d 898, 901, vacated as moot, 235 F.3d 1054 (8th Cir. 2000) (en banc). "To avoid an arbitrary discretion in the courts, it is indispensable that they should be bound down by strict rules and precedents, which serve to define and point out their duty in every particular case that comes before them;". Alexander Hamilton, *Federalist No. 78*. Such precedent can only be seen and appreciated with reasoned opinions.

The lack of an opinion is particularly problematic in patent cases, where disputes often involve complex legal and factual issues, significant economic stakes, and broad implications for

innovation and competition. The lack of an opinion also leaves litigants unable to assess whether further appeal is warranted, and this Court is left without a basis to proceed. Such a decision prevents meaningful review and compliance with this Court's Rule 10(a) ("A petition for a writ of certiorari is rarely granted when the asserted error consists of erroneous factual findings or the misapplication of a properly stated rule of law."). Furthermore, when a case results in a one word decision, there can be no conflict with another court or with a previous opinion. It also cannot be meaningfully used in a later case involving the patent.

The pervasive use of Rule 36 affirmances in patent appeals are seen most readily in the numbers. Of the 1,247 inter partes review, covered business method review, and post-grant review proceedings appealed to the Federal Circuit through 2023, the Federal Circuit disposed of 532 cases (43%) with Rule 36 affirmances. Dan F. Klodowski et al., Special Report: Trends in Federal Circuit PTAB Appeals Through 2023, FINNEGAN AT THE PTAB BLOG, https://www.finnegan.com/en/insights/blogs/at-the-ptab-blog/special-report-trends-in-federal-circuit-ptab-appeals-through-2023.html (last visited Nov. 19, 2024). This reliance on Rule 36 affirmances compromise the role of the Federal Circuit as the single appellate court for patents.

IV. Opinions were Written for Each Appeal Before Rule 36

Before Rule 36, the Federal Circuit required opinions.

"On October 1, 1982, when the United States Court of Appeals for the Federal Circuit (Federal Circuit) came into legal existence under The Federal Courts Improvement Act, it adopted as its Rule 18 the following: …Disposition of appeals shall be with a published opinion or an unpublished opinion." Judge Philip Nichols, Jr., *Selective Publication of Opinions: One Judge's View*, 35 Am. U. L. Rev. 909 (Summer 1986) (quoting Rule 18(a) titled "Opinions" as opposed to 18(b) titled "Orders"), *see also* Matthew J. Dowd, *Rule 36 Decisions at the Federal Circuit: Statutory Authority*, 21 VAND. J. ENT. & TECH. L. 857, 885 (Summer 2019) (citing FED CIR. R. 18(a) (July 15, 1985)). Issuing opinions in every case was the standard, reflecting the practices of the Federal Circuit's predecessor, the Court of Customs and Patent Appeals ("CCPA"). Dennis Crouch, *Wrongly Affirmed Without Opinion*, 52 Wake Forest L. Rev. 561, 565 (2017).

In addition to being contrary to 35 U.S.C. § 144, Rule 36 affirmances are a significant departure from this previous established practice and should end.

The BADC respectfully asks this Court to take note of the many, many previous petitions for

certiorari concerning this issue and at last, correct this situation.[2]

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[2] "Whether an Appeals Court may summarily affirm a judgment . . . without rendering an opinion to provide guidance regarding its reasoning", has been a consistent and persistent plea to this Court." *Donaldson Co., Inc. v. Nelson Indus., Inc.*, was 62 F.3d 1433 (Fed. Cir. 1995), cert. filed, 1995 WL 17035471, at *1 (U.S. Nov. 1, 1995) (95-734), cert. denied, 516 U.S. 1072 (1995). *See generally*, *Schwendimann v. Neenah, Inc.*, Nos. 2022-1951, 2022-1952, 2022-1953, 2023 WL 6613793, at *1 (Fed. Cir. Oct. 11, 2023), cert. filed, 2024 WL 1180159 (U.S. Mar. 14, 2024), cert. denied, 144 S.Ct. 2579 (2024); *Virentem Ventures, LLC v. Google LLC*, Nos. 2021-1805, 2021-1806, 2022 WL 17087139, at *1 (Fed. Cir. Nov. 21, 2023), cert. filed, 22-803 (U.S. Feb. 21, 2023), cert denied, 143 S.Ct. 1060 (2023); Petition for Writ of Certiorari at i, *Sec. People, Inc. v. Ojmar US, LLC*, 138 S. Ct. 2681 (2018) (No. 17-1443); Petition for Writ of Certiorari at i, *Stambler v. Mastercard Int'l Inc.*, 139 S. Ct. 54 (2018) (No. 17-1140); Petition for Writ of Certiorari at i, *In re Celgard, LLC*, 138 S. Ct. 1714 (2018) (No. 16-1526); Petition for Writ of Certiorari at 18, *Concaten, Inc., v. AmeriTrak Fleet Sols., LLC*, 137 S. Ct. 1604 (2017) (No. 16-1109); Petition for Writ of Certiorari at i–ii, *Shore v. Lee*, 137 S. Ct. 2197 (2017) (No. 16-1240); Petition for Writ of Certiorari at i, 24–29, *Leaks Survey, Inc. v. FLIR Sys., Inc.*, 138 S. Ct. 325 (2017) (No. 17-194); Petition for Writ of Certiorari at i, *Cloud Satchel, LLC v. Barnes & Noble, Inc.*,136 S.Ct. 1723 (2016) (No. 15-1161); Petition for Writ of Certiorari at 30–32, *Hyundai Motor Am., Inc. v. Clear with Computs., LLC*, 571 U.S. 1010 (2013) (No. 13-296); Petition for Writ of Certiorari at i-ii, *Romala Stone, Inc. v. Home Depot U.S.A., Inc.*, 562 U.S. 1201 (2011) (No. 10-777); Petition for Writ of Certiorari at 12, *White v. Hitachi, Ltd.*, 565 U.S. 825 (2011) (No. 10-1504); Petition for Writ of Certiorari at i, *Max Rack, Inc. v. Hoist Fitness Sys., Inc.*, 564 U.S. 1057 (2011) (No. 10-1384); Petition for Writ of Certiorari at i, *Tehrani v. Polar Electro*, 556 U.S. 1236 (2009) (No. 08-1116); Petition for Writ of Certiorari at i, *WayneDalton Corp.*

CONCLUSION

Many in the intellectual property community believe that the Federal Circuit should not be able to simply "affirm" the taking of a patent. Patents often represent major investments in dollars and hours in R&D, hopefully substantial commercial success, and substantial costs in both litigation and prosecution. The statute agrees, requiring an opinion. And yet Rule 36 provides otherwise.

The BADC respectfully requests this Court to grant Petitioner's writ of certiorari.

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DECEMBER 3, 2024