No. 24-518

IN THE

Supreme Court of the United States

PARKERVISION, INC.,
Plaintiff-Petitioner,
v.
TLC INDUSTRIES HOLDINGS CO., *et al.*
Defendants-Respondents.

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

BRIEF OF THE ASSOCIATION OF AMICUS COUNSEL AND PROFESSOR MARY ANN GLENDON AS *AMICI CURIAE* IN SUPPORT OF PETITIONER

ROBERT J. RANDO
GREENSPOON MARDER LLP
1345 Ave. of the Americas
Suite 2200
New York, NY 10022
(212) 524-5000

CHARLES E. MILLER
Counsel of Record
LEICHTMAN LAW PLLC
185 Madison Avenue
15th Floor
New York, NY 10016
(516) 641-3378
cmiller@leichtmanlaw.com

Counsel for Amici Curiae

January 15, 2025

WILSON-EPES PRINTING CO., INC. – (202) 789-0096 – WASHINGTON, D.C. 20002

TABLE OF CONTENTS

TABLE OF AUTHORITIES

TABLE OF AUTHORITIES—Continued

INTEREST OF THE *AMICI CURIAE*

The Association of Amicus Counsel and Professor Mary Ann Glendon respectfully submit this friends-of-the-Court brief[1] in support of ParkerVision, Inc.'s Petition For A Writ Of Certiorari.

The Association of Amicus Counsel ("AAC") was founded prior to the present litigation as an independent group of lawyers having diverse affiliations and law practices and who are in good standing and actively practicing in the jurisdictions in which they were admitted. By training, experience, scholarship, and discernment in their respective areas of the law, members the AAC have earned the judiciary's respect and trust in their abilities and candor in appellate advocacy, and their proficiencies in preparing and submitting amicus briefs as may be useful to tribunals in deciding issues of contention that are presented by parties in cases of controversy.

Briefs of the AAC advocate correct and balanced decision-making in adjudications that illuminate and affect the public interest and the concerns of identified amici, and other non-parties similarly situated. For

---

1 In accordance with Supreme Court Rule 37.6, the *amici* herein declare that no party or party's counsel authored this brief in whole or in part, and that no person or entity other than the *amici* or their counsel made a monetary contribution to fund the preparation or submission of this brief.

Also, in accordance with Supreme Court Rule 37.2(a), counsel for each of the parties has been notified, at least ten days in advance, of the *amicis'* intent to file this brief.

these reasons the AAC was conceived, established, and exists: to advance the science of jurisprudence through amicus briefs in support of positions and that advocate outcomes consistent with the rule of law. Toward that end, the AAC has participated in cases in other fora[2] as well as in this Court.[3]

The AAC has a significant, non-financial interest in the outcome of this case. As part of the broader community of stakeholders in the U.S. patent system, members of the AAC, their clients, and other entities are negatively affected and unfairly impacted by incorrect procedures in the adjudication of patent disputes like the present one. Such outcomes are often the result of decisions of the Federal Circuit on matters of patent eligibility and patentability that are rendered in a manner which is becoming increasingly prevalent and concerning when, as in the present case, they are issued in the form of one-word, no-opinion affirmances under Federal Circuit Rule 36, Fed.Cir.R. 36, in appeals from adverse decisions of subaltern tribunals such as the federal district courts and, as in the present case, the Patent Trial and Appeal Board ("PTAB") of the U.S. Patent and Trademark Office ("PTO" or "Patent Office.")

Professor Mary Ann Glendon is the Learned Hand Professor of Law emerita at Harvard University School of Law and has served as ambassador to the Holy See at

---

2 *See, e.g., Nantkwest, Inc. v. Iancu*, 898 F.3d 1177 (Fed. Cir. 2018).

3 *See, e.g., Oil States Energy Servs. LLC v. Green's Energy Group, LLC*, 138 S.Ct. 1365 (2018); *Peter v. Nantkwest, Inc*., 589 U.S. __(2019); *USPTO et al v. Booking.com B.V.,* 591 U.S. __ (2020); *Am. Axle & Mfg., Inc. V. Neapco Holdings LLC et al.,* No. 20-891; *Island Intellectual Property LLC, v. TD Ameritrade, Inc. et al*, No. 24-461.

the Vatican in Rome. Her professional activities and interests have included ongoing scholarship resulting in publications in the fields of human rights, comparative law, and political theory. In particular, she has written extensively on the changes that have taken place in the American legal system over the past half-century and their impact on our democratic society, including the creation of burgeoning judicial caseloads and their adverse impact on reflective justice.

In her noteworthy book, *A Nation Under Lawyers: How the Crisis in the Legal Profession is Transforming American Society,* at 147-48 (Cambridge Press 1994), Professor Glendon demonstrates her interest in the kind of proper judicial review that should have been applied to the present case when she states that the "[d]iscipline of writing out the reasons for a decision and responding to the main arguments of the losing side has proved to be one of the most effective curbs on arbitrary judicial power ever devised."

The present amici all have a particular interest in and are concerned with the conflict that exists between the operation of Rule 36 of the Federal Circuit and that of Section 144 of the Patent Act, 35 U.S.C. §144, in the judicial (Federal Circuit) review of PTAB decisions. Section 144 requires the Federal Circuit, in deciding appeals of PTAB decisions, to issue a reason-giving *opinion in every case,* whereas that same court, under its own Rule 36, has been issuing one-word summary affirmances—not opinions—of PTAB decisions in direct violation of Section 144.

Amici respectfully submit, based on their perspectives and expertise, that granting the present petition for

certiorari is not only appropriate but indeed necessary so that this Court can guide the Federal Circuit in properly interpreting and deploying the aforementioned statute and rule, and, in so doing, foster a just and uniform appellate process. Hence, this brief is submitted with the specific intendment and purpose of being useful to the Court in ensuring the avoidance of negative implications and consequences of the Federal Circuit's policy (which is not shared or promoted by either Congress or this Court) of rendering no-opinion affirmances of administrative PTAB's decisions.

SUMMARY OF ARGUMENT

Since the ratification of the U.S. Constitution in 1788, clause 18 of Article I, Section 8, gives Congress alone the exclusive authority "[to] make all laws which shall be necessary and proper for carrying into Execution," *inter alia*, the Power conferred upon Congress in clause 8 "[t]o promote . . . the Progress of . . . useful Arts, by securing for limited Times to . . . Inventors the exclusive Right to their . . .Discoveries." Congress exercised that power beginning in the 1790s with the enactment of laws establishing the nation's federal patent system.

Under Article VI, "the Laws of the United States which shall be made in Pursuance [of the U.S. Constitution] . . .shall be *the supreme Law of the Land*; . . ." and "all . . .*judicial officers* . . .of the United States . . .*shall be bound* by Oath or Affirmation, to support this Constitution; . . . ." [Emphasis added.]

In 1984, following the creation in 1982 of the U.S. Court of Appeals for the Federal Circuit, Congress enacted 35 U.S.C §144 as part of "the supreme Law of

the Land" to which all federal judges, most notably those of the Federal Circuit, have sworn to be bound.

Amici respectfully urge the granting of plaintiff ParkerVision, Inc.'s "Petition For A Writ Of Certiorari" filed November 4, 2024 in order to secure proper judicial review not only of the underlying substantive legal issues that were decided by the PTAB and which the Federal Circuit, in a single-word stroke of the pen, "Affirmed" without any opinion, but also that the Court may consider the negative implications of permitting such lower court rulings, and the manner in which they were made. Those implications have been inflicting harmful consequences upon the communities of inventors, patent owners, innovators, entrepreneurs, investors, and ultimately upon American security interests in maintaining the nation's competitive standing on the world stage of science, technology, and engineering which modern society has come to rely on for continued "Progress of Useful Arts."

Unless reversed, or vacated and remanded with remedial instructions from this Court, the Federal Circuit's use in this case of the single word "Affirmed," along with similar short-shrift disposals in other cases, will only aggravate the ongoing frustration of long-established expectations of, and diminishing traditional reliance upon, and public confidence in, the continued viability of the U.S. patent system, and the judiciary's role in it.

The public depends on a patent system characterized by the orderly development of a comprehensive, robust, and reliable body of judicial precedent and stare decisis in appellate case law governing the scope of judicial

review. Toward that end as appertains to the present case and others like it, decisions of the Federal Circuit in the appellate review of judgments of subaltern tribunals in contested cases on issues of law (reviewed de novo) and fact (reviewed for clear error) should be required in the form of reasoned opinions under Fed.R.App.P. 36(a)(1) rather than as mere single-word no-opinion disposals under Fed.R.App.P. 36(a)(2) and Federal Circuit Rule 36.

This is especially important when, as in this case, written opinions, had they been issued, could well have had precedential value (without the parties being able to know for sure whether that would be the case or not). And no-opinion disposals cannot be justified under any of the five sub-requirements of Rule 36(b) as conditions precedent to its deployment. In such circumstances, the Federal Circuit, in failing to comply with its statutory obligation to opine on the PTAB's decision in the present case, has fallen short of its purpose and mission of being the "final word" among agencies (viz., the PTO) and the lower courts on matters of patent law. Rather, the Federal Circuit should have arrived at and issued its own conclusions in a reasoned, written *opinion* rather than by mere one-word affirmances that evince a blind, unconstitutional deference to what the administrative agency (the PTAB) said.

ARGUMENT

"[M]any of our greatest judges are respected for their habit of exposing the reader to the actual grounds of their decisions and their actual reasoning processes, including their doubts and uncertainties"

Prof. Mary Ann Glendon, *Comparatve Law In The Age Of Globalization*, 52 DUQ. L. REV. 1, 11-12 (2014)

I. THE FEDERAL CIRCUIT'S RULE 36 ONE-WORD AFFIRMANCE OF ADMINISTRATIVE PTAB PATENT-INVALIDITY DECISIONS FLIES IN THE FACE OF 35 U.S.C. § 144 AND EPITOMIZES THE INJUSTICE OF UNCONSTITUTIONAL FEDERAL APPELLATE-COURT JUDGMENTS THAT ARE ISSUED WITHOUT OPINIONS.

Rule 36(a) of the Federal Circuit, Fed.Cir.R. 36(a), states that "the court may enter a judgment of affirmance **without opinion, citing this rule**, when it determines that ***any*** of the following conditions exist **and an opinion would have no precedential value**: (1) the judgment, decision, or order of the trial court appealed from is based on findings that are not clearly erroneous***;*** (2) the evidence supporting the jury's verdict is sufficient; (3) the record supports summary judgment, directed verdict, or judgment on the pleadings; **(4) the decision of an administrative agency warrants affirmance under the standard of review in the statute authorizing the petition for review*;* or (5) a** judgment or **decision has been entered without an error of law."**

To top it all off, Rule 36(b) states that "[t]he clerk of court will not prepare a separate judgment when a case is disposed of by an order without opinion. **The order serves as the judgment** when entered." [Emphasis added.] In other words, what you see in a one-word, no-opinion Rule 36 affirmance is all that the appellant is going to get.

In assessing the propriety and fairness of Rule 36 single-word affirmances of Patent Office (PTAB) decisions invalidating patents based on subject-matter patent-ineligibility under 35 U.S.C. §101, or unpatentability under § 102 or § 103, two explicit requirements must be met before the rule can be deployed in a given case. First, the Federal Circuit would have to conclude that an opinion based on the record in the PTAB would have no value as precedent in future cases. Second, at least one of the five enumerated conditions must exist, which in the present case would be either condition (4) or condition (5). Therefore, if an opinion would have no value as precedent **and** either condition (4) or (5) is satisfied, then and only then can Rule 36 can be deployed.

Patent stakeholders and the rest of the invention / innovation community are facing a two-fold problem in the use of Rule 36 in cases like this. First, the high percentage of cases decided that way implies that published Federal Circuit opinions in those cases would have lacked precedential value with no one besides the deciding panel being able to challenge that supposition on any reasoned basis. However, the Federal Circuit was established with the intention, *inter alia*, of bringing uniformity and predictability to patent law by being the sole and "final word" on the subject among the

various lower Article III courts and Article I agencies. *See*, 28 U.S.C. § 1295(a). In that way, it was thought that patent jurisprudence would develop coherently without risk of splits of authority arising among the circuits. But since then, with so many patent judgments of lower tribunals being summarily affirmed under Rule 36, and petitions to this Court for writs of certiorari in those cases being denied regularly, the original purpose and mission of the Federal Circuit are being undermined because cases that could have resulted in published precedential opinions would have contributed to the development of patent law jurisprudence. See, Dennis Crouch, *From Chief Judge Markey's Promise To Rule 36: We Do Not Just Render One-Worded Decisions,* Patently-O (Nov. 8, 2024). And amid suspicions that the use of Rule 36 has become a docket control expedient because of the Federal Circuit's workload, the patent community's confidence in the Federal Circuit has suffered.

Second, with respect to conditions (4) and (5) of Rule 36(a) that might be applicable in the present case, no-opinion affirmances make it impossible to know which of them is actually satisfied so as to justify such affirmances. And with no findings by the Federal Circuit being available in these circumstances, the only result for the present Petitioner has been crickets -- hardly the epitome of due process.

II. JUDICIAL REASON-GIVING HAS LONG BEEN RECOGNIZED AS AN IMPORTANT CHECK ON ARBITRARY JUDICIAL POWER

Judicial reasoning that underlies decisions of appellate courts in appeals of judgments by subaltern courts and administrative tribunals is one of the hallmarks of the American justice system.

Among the present amici, Professor Mary Ann Glendon of Harvard University School of Law, has for decades recognized and written about the importance of this fundamental legal precept. As she explains in *A Nation Under Lawyers: How the Crisis in the Legal Profession is Transforming American Society,* at 147-48 (Cambridge Press 1994) the "[d]iscipline of writing out the reasons for a decision and responding to the main arguments of the losing side has proved to be one of the most effective curbs on arbitrary judicial power ever devised."

Indeed, Professor Glendon specifically criticized the practice of responding to "heavier workloads" by deciding routine cases "summarily without opinion": "Since no lawsuit is routine to those involved, a litigant who gets a mere thumbs-down may understandably feel frustrated and resentful. Losing parties (and lawyers who have worked hard on briefs) are apt to wonder what goes on behind the scenes." *Id*. at 145-46. Judges, after all, "more than any other officials are expected not only to listen but to show that they have listened; not only to reason their way through to the decisions they reach, but to expose their reasoning processes to the parties

and the public." *Id.* at 146. Failing to do so crosses the line from the "authoritative to the authoritarian." *Id.*

More recently, in 2014 Professor Glendon in her article *Comparative Law in the Age of Globalization*, 52 Duq. L. Rev. 1, 11-12 pointed out "the principled, modest techniques of judicial decision-making that have traditionally been hallmarks of the American legal tradition. . . . [M]any of our greatest judges are respected for their habit of exposing the reader to the actual grounds of their decisions and their actual reasoning processes, including their doubts and uncertainties. One thinks of Robert Jackson, John Marshall Harlan, Henry Friendly, Learned Hand, and Augustus N. Hand, whose opinions were said to have been written not so much for the bench, bar, or university world as for 'the particular lawyer who was about to lose the case and the particular trial judge whose judgment was being reviewed and perhaps reversed.'"

III. RESOLVING THE SPLIT AMONG THE CIRCUITS IN THEIR USE OF NO-OPINION AFFIRMANCES WOULD RESTORE CONFIDENCE IN PROCEDURAL DUE PROCESS IN FEDERAL CIRCUIT PROCEEDINGS IN APPEALS OF ADMINISTRATIVE PTAB DECISIONS

The disparity between the Federal Circuit and other circuits in the comparative frequencies of using their respective rules (to the extent other circuits have such rules) for rendering no-opinion affirmances is noted in the instant Petition for Certiorari. The Federal Circuit's excessive reliance on Rule 36 in issuing no-opinion

affirmances of PTAB decisions is plainly evident from the court's almost routine deployment of it in disposing of those cases that come before it on a regular basis. And unfortunately, most if not all non-prevailing parties have failed in their efforts to seek judicial relief from Rule 36 decisions by petitioning the Federal Circuit for panel or en banc re-hearings, or by petitioning this Court for writs of certiorari. Up until now, both courts have apparently acquiesced with silence on the problem.

Particularly apropos to the present case is the fourth condition in Rule 36(a) which illuminates the seriousness of the problem that overuse of Rule 36 has caused for the patent community. Procedures that must be followed by the Federal Circuit in appeals from PTAB decisions are statutorily mandated by 35 U.S.C. § 144. Pursuant to the words of that statute, the "Federal Circuit *shall* review" the PTAB ruling to determine its merits and then "*shall* issue to the [Patent Office] Director its mandate *and opinion*, which *shall* be entered on the [public] record in the [Patent Office]." By comparing the fourth condition in Rule 36(a) against the predominant statute (§144), one will immediately spot the conflict: Rule 36, an example of judicial rulemaking, says that the Federal Circuit can issue no-opinion affirmances of PTAB rulings when affirmance is warranted under the "substantial evidence" standard of review governing such rulings, *Dickinson* v. *Zurko,* 527 U.S. 150 (1999). But, the statute requires the Federal Circuit to issue a written *opinion* in *every such case* regardless of whether affirmance is warranted or whether an opinion would have precedential value.

Regarding a further problem with Rule 36 in the litigation context, amici would respectfully invite the

Court to consider along with the present case the co-pending petition for a writ of certiorari filed by the plaintiff-petitioner in *Island Intellectual Property LLC* v. *TD Ameritrade, Inc. et al.,* Case No. 24-461 (docketed Oct. 23, 2024).

CONCLUSION

No principle of law is more fundamental to the proper functioning of the U.S. patent system (and indeed, the entire American judicial system) and its vital role in advancing the statutory implementation of Congress' "Power" under Art. I, Sec 8, cl. 8 of the Constitution "to promote the Progress of . . .useful Arts" than that which governs the legal requisites for the judicial review of administrative PTAB determinations of the patent-eligibility of inventions and discoveries under 35 U.S.C. § 101 and their patentability under 35 U.S.C. § 102, and § 103. And nowhere is the manifest injustice of failing to apply that principle in judging patents and patent applications more starkly on display than in the present case. Such failure reeks of reversible error.

For all of the reasons stated herein and in plaintiff's Petition For A Writ Of Certiorari, the present amici respectfully urge this Court to grant the Petition and then review the Federal Circuit's practice under Rule 36 of issuing no-opinion affirmances of decisions by an administrative PTO tribunal, namely, the PTAB.

In deciding whether to grant the instant Petition, the Court should consider broadly the ongoing negative ramifications of opaque, one-word, no-opinion Rule 36 appellate affirmances of unpatentability decisions of the PTAB which is a non-Article III administrative tribunal. The 'silent treatment' given by the Federal

Circuit in issuing such affirmances rendered pursuant to judicial rulemaking manifested in Rule 36, being in direct and unambiguous conflict with the apposite, governing statutory mandate in § 144, is an unconstitutional denial of due process and access to meaningful judicial review. In the present case, the result of such action is clear and harmful material error. The Federal Circuit's Rule 36 "affirmance" that caused it should be reversed, or vacated and remanded.

Respectfully submitted,

ROBERT J. RANDO
GREENSPOON MARDER LLP
1345 Ave. of the Americas
Suite 2200
New York, NY 10022
(212) 524-5000

CHARLES E. MILLER
Counsel of Record
LEICHTMAN LAW PLLC
185 Madison Avenue
15th Floor
New York, NY 10016
(516) 641-3378
cmiller@leichtmanlaw.com

January 15, 2025