

NO. 23-1217

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IN THE  
**Supreme Court of the United States**

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**CHESTEK PLLC,**

*Petitioner,*

v.

**KATHI VIDAL, UNDER SECRETARY OF COMMERCE  
FOR INTELLECTUAL PROPERTY AND DIRECTOR,  
UNITED STATES PATENT AND TRADEMARK OFFICE,**

*Respondent.*

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**On Petition for Writ Of *Certiorari* to the  
United States Court Of Appeals  
For The Federal Circuit**

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**BRIEF OF *AMICUS CURIAE* IEEE-USA  
IN SUPPORT OF PETITIONER**

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June 14, 2024

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## INTEREST OF *AMICUS CURIAE*<sup>1</sup>

IEEE-USA is the U.S. organizational unit of The Institute of Electrical and Electronics Engineers, Inc. (IEEE), the world's largest technical professional organization with over 460,000 engineers, scientists, and allied professionals worldwide, dedicated to advancing technology for the benefit of humanity. IEEE-USA represents the professional interests of IEEE members before U.S. governmental bodies and is responsible for coordinating and reporting all IEEE's official communications with the U.S. government. In particular, IEEE-USA represents the interests of 150,000 U.S. members of IEEE, supporting the nation's prosperity and competitiveness by fostering technological innovation for the benefit of all.

As part of its mission, IEEE-USA seeks to ensure that U.S. intellectual property law "promote[s] the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. Const. Art. I, § 8, cl. 8. IEEE-USA's members have a substantial stake in

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<sup>1</sup> Pursuant to Supreme Court Rule 37.6, counsel for the *amicus curiae* certifies that no counsel for any party authored this brief in whole or in part and that no person or entity other than the amicus, its membership, or its counsel made a monetary contribution intended to fund the preparation or submission of the brief. Rule 37.2 notice of the intent to file this *amicus* brief was timely provided to counsel of record for Petitioner, and a late notice of the intent to file this *amicus* brief has been given to Respondent's counsel, who does not object to the late notice.

the United States patent system. Our membership includes inventors who create and use cutting-edge technology, researchers who are involved in scientific discovery, authors of journal articles in the broad fields of engineering and science, entrepreneurs, individuals, and employees of firms that develop, acquire, license, and market patented technology.

IEEE-USA has always appreciated the opportunities that notice-and-comment rule-making afford the public. IEEE-USA's members and its policy committees have often responded to Requests for Comments issued by government agencies (including the PTO, as shown below) to provide important feedback to inform government agencies when they undertake or are considering taking regulatory actions. While IEEE-USA supports Petitioner's request for *certiorari*, we take no position on the ultimate question of the validity of the underlying trademark application at issue in this case.

### **SUMMARY OF ARGUMENT**

This case will resolve the question of whether the U.S. Patent and Trademark Office ("PTO") will be permitted to avoid promulgating its procedural rules by public notice-and-comment rulemaking. If left in place, the Federal Circuit's holding below that exempts the PTO from public notice-and-comment rulemaking would give a "green light" to the PTO to ignore public comments on its proposed rules, avoid publishing proposed rules, or avoid soliciting public comments in the first place.

IEEE-USA is therefore concerned that, just as other members of the public would be precluded, so would IEEE-USA no longer be able to impart the major benefits of its expertise and vast experience to inform the PTO's rulemaking process. Should the Federal Circuit's holding below be allowed to stand, there may be *no more* IEEE-USA comment letters further described below to inform the PTO. This may also deny our members the right to protect their interests through participation to prevent promulgation of arbitrary, capricious, or otherwise harmful rules.

IEEE-USA submits that this case is unique as the opportunity for this Court's review of this important issue is unlikely to arise again due to the Federal Circuit's exclusive jurisdiction on questions involving the Patent Act. For the foregoing reasons and those explained further below, this Court should grant the Petitioner *certiorari* to correct the decision below.

## ARGUMENT

### **I. IEEE-USA RELIES ON ITS RESOURCES, EXPERTISE, AND COLLECTIVE EXPERIENCES OF ITS VAST MEMBERSHIP TO BENEFICIALLY INFORM AND INFLUENCE THE PTO'S RULEMAKING**

The impact and effects of PTO rules often depend on the particular technical aspects of the patents or applications regulated by such rules, and familiarity with the technology areas of the



associated inventions is often essential for recognizing the potential impacts. A substantial number of patent applications before the PTO involve inventions of subject matter in technology areas that are well within the wide range of the IEEE's technical fields.<sup>2</sup> Indeed, the IEEE

- Has 39 Technical Societies and eight Technical Councils representing a wide range of IEEE technical interests;
- Has an active portfolio of 1,144 technical standards it has developed and more than 1,018 new standards under development, many of which involve patented technologies;
- Publishes more than 200 transactions, journals, and magazines on a wide range of technical subjects; and
- Sponsors more than 2,000 conferences and events worldwide, with more than 200,000 new papers added annually to the IEEE *Xplore*<sup>®</sup> Digital Library.

As such, members of IEEE involved in these technical activities, whether inventors or developers of inventive technologies, have gained substantial expertise and experience in bringing a broad range of technologies to market with patent protection. They have gained much experience in complying with, and assessing the impact of such PTO rules or proposed rules.

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<sup>2</sup> See [www.ieee.org/about/at-a-glance.html](http://www.ieee.org/about/at-a-glance.html)

Accordingly, there is established in IEEE-USA the Intellectual Property Committee (IPC)<sup>3</sup> to address broad IP issues of importance to the IEEE U.S. membership. The issues cover patent acquisition and protection, trademarks, and copyrights. Those include issues that encompass IP rights in fast-moving technology, technology transfer, and U.S. competitiveness and innovation. The IPC membership includes IP practitioners and attorneys, inventors, business owners and engineering managers. The IPC is informed by IEEE members' inputs, including through its IP Assistance Portal (Collabratec), and by organization-wide surveys of members' use of patents and their patenting practices. All IPC-developed positions represent a consensus of a diverse group of engineers, scientists, technologists and patent attorneys. The IPC is thus IEEE's group most suited for articulating such matters in public comments to U.S. agencies, including submission of comments to the PTO.

**I.A Public Comments Serve as an Important Conduit for IEEE-USA's Contributions to the PTO Rulemaking**

Notice-and-comment rulemaking pursuant to 5 U.S.C. § 553(b) is the optimal vehicle for ensuring the completeness, integrity, fairness, and utility of agency rules. Given its expertise and large base of patent stakeholders, IEEE-USA through its IPC has long participated in PTO's rulemaking by submitting public comments, as the list in the Exhibit shows.

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<sup>3</sup> See IEEE-USA Intellectual Property Committee (IPC), <https://ieeusa.org/committees/ipc/>

The list details only the IEEE-USA's submissions over the 12 years since the enactment of the America Invents Act<sup>4</sup> (AIA) and the establishment of AIA trials to cancel issued patents at the PTO's Patent Trial and Appeal Board (PTAB).

Those listed comments in the Exhibit related to: Inventorship Guidance for AI-Assisted Inventions, (#1); PTAB Discretion to Institute AIA Trials, (#2) ; PTAB Rules of Practice for Instituting AIA Trials, (#3); Patenting Artificial Intelligence Inventions, (#4); Claim Amendment Practice and Procedures Before the PTAB, (#5); Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the PTAB, (#6); Collection of information in Patent Processing, (#7); Update of Examination Guidance on Subject Matter Eligibility under § 101, (#8); Preliminary Examination Instructions on § 101 in view of the Supreme Court Decision in *Alice*, (#9); Requests for Continued Examination (RCE) Practice, (#10); Examination Guidelines for Implementing the First-Inventor-to-File Provisions of the AIA, (#11); Collection of information in Patent Processing, (#12); Rules of Practice for Trials Before the PTAB and Judicial Review of PTAB Decisions, (#13); Transitional Program for AIA Trials on Covered Business Method Patents, Definition of Technological Invention, (#14); and Matters Related to Administrative Patent Appeals, (#15).

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<sup>4</sup> Pub. L. 112-29, 125 Stat. 284 (2011).

Moreover, these IEEE-USA comments typically also addressed the need for PTO compliance under other general legal requirements. Agencies, including the PTO, are required by government-wide statutes other than their own organic statutes, and by the President's Executive Orders, to use the public notice-and-comment framework to promulgate rules. Some of these government-wide requirements are described below, including the relevant IEEE-USA comments.

#### **I.A.1 Requirements under the Paperwork Reduction Act**

Congress enacted the Paperwork Reduction Act, 44 U.S.C. §§ 3501 *et seq.*, (PRA), to “minimize the paperwork burden for individuals, small businesses, ... and other persons resulting from the collection of information by or for the Federal Government,” and “ensure the greatest possible public benefit from and maximize the utility of information created, collected, maintained, used, shared and disseminated by or for the Federal Government,” *id.* § 3501(1), (2).

The PRA in § 3506(c)(2)(B) provides that “for any proposed collection of information contained in a proposed rule, [the agency shall] provide notice and comment” to solicit public comments to—“(i) evaluate whether the proposed collection of information is necessary ... including whether the information shall have practical utility; (ii) evaluate the accuracy of the agency's estimate of the burden of the proposed collection of information; (iii) enhance the quality, utility, and clarity of the information to be collected; and (iv) minimize the

burden of the collection of information on those who are to respond.” § 3506(c)(2)(A).

These steps are designed to ensure that federal agencies consider the consequences of any new rules. Public notice-and-comment ensures that the public may vet the agency’s analysis. IEEE-USA submitted such public comments on PRA compliance in letters to the PTO referred to in the Exhibit as Items #3 (urging compliance with the PRA); #7 (comments on paperwork burden during prosecution of patent applications); #8 (specific recommendation for reducing paperwork burden); #9 (recommendation for §101 guidance that reduce paperwork burden); #10 (recommendation for changing RCE practice and reduce paperwork burden); #11 (recommendations for implementing the First-to-File Provisions of the AIA, reducing paperwork burden) #12 (comments on paperwork burden during prosecution of patent applications); #13 (comments on PTO’s lack of support for paperwork burden at the PTAB); #14 (urging a definition of “Technological Invention” in CBM proceedings to minimize paperwork burden); and #15 (proposing that PTO provide explanatory decisions in denials of pre-appeal requests to reduce paperwork burden).

### **I.A.2 Requirements under the Regulatory Flexibility Act**

The Regulatory Flexibility Act, 5 U.S.C. §§ 601-612, (RFA), protects small entities from excessively burdensome regulation. The RFA requires agencies to consider the impact of their regulatory proposals on small entities, analyze effective alternatives that minimize small entity impacts, and publish their

analyses for public comment in the Federal Register. 5 U.S.C. §§ 603(a), 604(b); Small Business Administration, *A Guide for Government Agencies: How to Comply with the Regulatory Flexibility Act* (August 2017 ed.)<sup>5</sup> For *de minimis* rules, the agency may opt out of the analysis if the agency certifies that the rule will not “have a significant economic impact on a substantial number of small entities.” § 605(b). When an agency fails to offer either the certification, or the statutorily required rational consideration of the effect of a rule on affected small entities, the agency cannot enforce the rule. *Harlan Land Co. v. U.S. Dept. of Agr.*, 186 F.Supp.2d 1076, 1097 (E.D. Cal. 2001).

Agencies are *required* to perform and publish initial regulatory flexibility analysis “[w]henver an agency is required by section 553 of this title, or any other law, to publish general notice of proposed rulemaking for any proposed rule.” 5 U.S.C. § 603(a). There is no such obligation, however, if the agency is not required to so publish. Therefore, should the Federal Circuit decision stand—that the PTO is not required to publish general notice of proposed rulemaking—the PTO would be given a green light to avoid the RFA entirely, to the great detriment of small businesses that patent. Small businesses are the lifeblood of the U.S. economy: they create *two-thirds of net new jobs* and drive U.S. innovation and

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<sup>5</sup> <https://advocacy.sba.gov/wp-content/uploads/2019/06/How-to-Comply-with-the-RFA.pdf>

competitiveness.<sup>6</sup> Small businesses produce *16 times more* patents per employee than large patenting firms.<sup>7</sup> RFA protection of small patenting businesses reduces their risk and increases capital flow to good ideas.

IEEE-USA submitted public comments on RFA issues in letters to the PTO referred to in the Exhibit as Items #3 (urging PTO compliance with RFA); and #11 (recommendations for implementing the First-to-File Provisions of the AIA, and noting PTO's failure to comply with the RFA).

### **I.A.3 Requirements of Executive Order 12866 and OMB Circular A-4**

The President's Executive Order 12866<sup>8</sup> is binding on all agencies, requiring them to conduct the basic benefit-cost analysis of proposed rules with public participation in the process. In relevant part, E.O. 12866 provides that each agency "shall ... propose or adopt a regulation only upon a reasoned determination that the benefits of the intended regulation justify its costs," *id.* § 1(b)(6); "shall base its decisions on the best reasonably obtainable

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<sup>6</sup> SBA Office of Advocacy, "Small Businesses Generate 44 Percent of U.S. Economic Activity," Release No. 19-1 ADV (Jan 30, 2019).

<sup>7</sup> A. Breitzman, and D. Hicks, "An Analysis of Small Business Patents by Industry and Firm Size" SBA Study (2008). At [http://rdw.rowan.edu/cgi/viewcontent.cgi?referer=&httpsredir=1&article=1011&context=csm\\_facpub](http://rdw.rowan.edu/cgi/viewcontent.cgi?referer=&httpsredir=1&article=1011&context=csm_facpub)

<sup>8</sup> E.O. 12866 of September 30, 1993, 58 *Fed. Reg.* 51735 (October 4, 1993). At [www.archives.gov/files/federal-register/executive-orders/pdf/12866.pdf](http://www.archives.gov/files/federal-register/executive-orders/pdf/12866.pdf)

scientific, technical, economic, and other information concerning the need for, and consequences of, the intended regulation,” *id.* § 1(b)(7) ; “shall identify and assess alternative forms of regulation and shall, to the extent feasible, specify performance objectives, rather than specifying the behavior or manner of compliance that regulated entities must adopt,” *id.* § 1(b)(8).

E.O. 12866 expressly requires use of public comments for rulemaking. In § 4, it requires “coordination of regulations, to maximize consultation and the resolution of potential conflicts at an early stage, to involve the public and its State, local, and tribal officials in regulatory planning.” To that end, § 6(a) states that each agency “shall ... provide the public with meaningful participation in the regulatory process. ... In addition, each agency should afford the public a meaningful opportunity to comment on any proposed regulation, which in most cases should include a comment period of not less than 60 days.”

The Office of Management and Budget (OMB) elaborated on the economic analysis required by E.O. 12866 for any regulation that may reasonably be expected to have an annual effect on the economy of \$200 million or more. That guidance and methodological implementation of E.O. 12866 are provided in OMB Circular A-4.<sup>9</sup>

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<sup>9</sup> OMB Circular No. A-4, at 71 (November 9, 2023), [www.whitehouse.gov/wp-content/uploads/2023/11/CircularA-4.pdf](https://www.whitehouse.gov/wp-content/uploads/2023/11/CircularA-4.pdf).



IEEE-USA contributed through public comments to this rulemaking process of E.O. 12866. For example, E.O. 12866 § 1(b)(2) requires the PTO to “examine whether existing regulations (or other law) have created, or contributed to, the problem that a new regulation is intended to correct.” Many of the PTO regulatory goals could be addressed by internal reforms to reduce costs, as an alternative to burdensome regulations or increased fees. IEEE-USA gave an extensive set of comments on how internal PTO processes and incentives could be restructured to reduce costs to the PTO and to applicants. See Item #12 in the Exhibit.

IEEE-USA submitted other public comments on PTO’s need for compliance with EO 12866 in letters to the PTO referred to in the Exhibit as Items #13 (comments on PTO’s underestimate of the economic effects under EO 12866) ; and #14 (urging a definition of “Technological Invention” in CBM proceedings and to comply with EO 12866) .

## **II. REASONS FOR GRANTING THE PETITION**

The Federal Circuit’s holding below squarely raises the Question Presented. The panel held that the “cross-reference to § 553” in 35 U.S.C. § 2(b)(2)(B) does not “mandat[e] notice-and-comment rulemaking.” App. 10. It thus interprets the 35 U.S.C. § 2(b)(2)’s cross-reference to 5 U.S.C. § 553 to be meaningless. It treats the exception in 5 U.S.C. § 553(b)(A) as effectively exempting the PTO from notice-and-comment rulemaking on the very rules it is empowered to promulgate under

§ 2(b)(2)—procedural rules. This would not only exempt the PTO from affording the public opportunities to participate in rulemaking, but it would also exempt the PTO from even having to *publish* proposed rules in the Federal Register as required by § 553(b) .

The Federal Circuit panel’s exemption of the PTO from public notice-and-comment rulemaking eviscerates a key check on the agency imposed by Congress to ensure reasoned rulemaking that “affords the agency a chance to avoid errors and make a more informed decision.” *Azar v. Allina Health Services*, 139 S. Ct. 1804, 1816 (2019). If left in place, this Federal Circuit’s holding would give a “green light” to the PTO to ignore public comments on its proposed rules, avoid publishing proposed rules in the Federal Register, or avoid soliciting public comments in the first place.

IEEE-USA is therefore concerned that, just as other members of the public would be precluded, so would IEEE-USA no longer be able to impart the major benefits of its demonstrated expertise and vast experience to inform the PTO’s rulemaking process. Should the Federal Circuit’s holding be allowed to stand, there may be *no more* IEEE-USA comment letters as seen in the Exhibit. This may also deny our members the right to protect their interests through participation to prevent promulgation of arbitrary, capricious, or otherwise harmful rules.

**II.A This Case is Unique as the Opportunity  
for this Court's Review is Unlikely to  
Arise Again**

The Federal Circuit has exclusive jurisdiction on questions involving the Patent Act. 28 U.S.C. § 1295(a). This will dissuade litigants from challenging the PTO's rulemaking procedures going forward, given that any such challenge would necessarily lose at the district court level and on appeal at the Federal Circuit. This Court may *never* see another vehicle raising this important issue. This is why it is imperative that this petition be granted.

## CONCLUSION

For the foregoing reasons, IEEE-USA asks this Court to grant Petitioner's request for *certiorari* to ensure this Court clarifies that the PTO must promulgate its regulations under Section 2 by public notice-and-comment rulemaking to ensure implementation of clear Congressional intent and the constitutional protections and fairness to which patent and trademark applicants and owners are entitled.

Respectfully submitted,

IEEE-USA  
*Amicus Curiae*

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JUNE 14, 2024

## **APPENDIX**

**TABLE OF EXHIBITS**

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| <b>EXHIBIT -- IEEE-USA Public<br/>Comments to PTO .....</b> | <b>1a</b> |
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**EXHIBIT - IEEE-USA Public Comments to PTO**

| <b>#</b> | <b>Date</b> | <b>Title and Subject Matter of Comments</b>   |
|----------|-------------|---|
| <b>1</b> | 7-May-24    | Inventorship Guidance for AI-Assisted Inventions.<br><a href="https://ieeusa.org/assets/public-policy/policy-log/2024/050724b.pdf">https://ieeusa.org/assets/public-policy/policy-log/2024/050724b.pdf</a>  |
| <b>2</b> | 3-Dec-20    | Discretion to Institute Trials Before the Patent Trial and Appeal Board.<br><a href="http://www.uspto.gov/sites/default/files/documents/1232020IEEEUSA.pdf">www.uspto.gov/sites/default/files/documents/1232020IEEEUSA.pdf</a>  |
| <b>3</b> | 26-Jun-20   | PTAB Rules of Practice for Instituting on All Challenged Patent Claims and All Grounds and Eliminating the Presumption at Institution Favoring Petitioner as to Testimonial Evidence.<br><a href="http://www.uspto.gov/sites/default/files/documents/06-26-20%20IEEE-USA.pdf">www.uspto.gov/sites/default/files/documents/06-26-20%20IEEE-USA.pdf</a> |
| <b>4</b> | 16-Oct-19   | Patenting Artificial Intelligence Inventions.<br><a href="http://www.uspto.gov/sites/default/files/documents/IEEE-USA_RFC-84-FR-44889.pdf">www.uspto.gov/sites/default/files/documents/IEEE-USA_RFC-84-FR-44889.pdf</a>   |
| <b>5</b> | 21-Dec-18   | Claim Amendment Practice and Procedures Before the Patent Trial and Appeal Board.<br><a href="http://www.uspto.gov/sites/default/files/documents/comment_ieee.pdf">www.uspto.gov/sites/default/files/documents/comment_ieee.pdf</a>   |

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|----|-----------|---|
| 6  | 9-Jul-18  | Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board.<br><a href="http://www.uspto.gov/sites/default/files/documents/comment-ieee-usa.pdf">www.uspto.gov/sites/default/files/documents/comment-ieee-usa.pdf</a>                       |
| 7  | 22-Jul-16 | Patent Processing (Updating) 0651-0031.<br><a href="http://www.uspto.gov/sites/default/files/documents/2016%20IEEE%20Comment%20letter%20on%20Paperwork%20Reduction%20Act%20(2).pdf">www.uspto.gov/sites/default/files/documents/2016 IEEE Comment letter on Paperwork Reduction Act (2).pdf</a>                   |
| 8  | 30-Oct-15 | Update on Subject Matter Eligibility.<br><a href="http://www.uspto.gov/sites/default/files/documents/2015ig_a_ieee_02nov2015.pdf">www.uspto.gov/sites/default/files/documents/2015ig_a_ieee_02nov2015.pdf</a>   |
| 9  | 31-Jul-14 | Preliminary Examination Instructions in view of the Supreme Court Decision in <i>Alice Corp. Pty. v. CLS Bank Int'l</i> .<br><a href="http://www.uspto.gov/sites/default/files/patents/law/comments/al-a-ieeeusa20140731.pdf">www.uspto.gov/sites/default/files/patents/law/comments/al-a-ieeeusa20140731.pdf</a> |
| 10 | 4-Feb-13  | Request for Continued Examination (RCE) Practice.<br><a href="http://www.uspto.gov/sites/default/files/patents/law/comments/ieee_20130204.pdf">www.uspto.gov/sites/default/files/patents/law/comments/ieee_20130204.pdf</a>   |



| #  | Date      | Title and Subject Matter of Comments  |
|----|-----------|---|
| 11 | 5-Nov-12  | Examination Guidelines for Implementing the First-Inventor-to-File Provisions of the Leahy-Smith America Invents Act.<br><a href="http://www.uspto.gov/sites/default/files/patents/law/comments/ieee_20121105.pdf">www.uspto.gov/sites/default/files/patents/law/comments/ieee_20121105.pdf</a>             |
| 12 | 29-May-12 | Patent Processing (Updating) 0651-0031.<br><a href="http://www.uspto.gov/sites/default/files/new/s/fedreg/comments/0651-0031_IEEE_Comment.pdf">www.uspto.gov/sites/default/files/new/s/fedreg/comments/0651-0031_IEEE_Comment.pdf</a>   |
| 13 | 17-Apr-12 | Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions.<br><a href="http://www.uspto.gov/sites/default/files/aia_implementation/comment-ieee2.pdf">www.uspto.gov/sites/default/files/aia_implementation/comment-ieee2.pdf</a> |
| 14 | 10-Apr-12 | Transitional Program for Covered Business Method Patents, Definition of Technological Invention<br><a href="http://www.uspto.gov/sites/default/files/aia_implementation/comment-ieee1.pdf">www.uspto.gov/sites/default/files/aia_implementation/comment-ieee1.pdf</a>                                       |
| 15 | 5-Mar-12  | Matters Related to Patent Appeals.<br><a href="http://www.uspto.gov/sites/default/files/new/s/fedreg/comments/0651-00xx_Matters_Comment_IEEE.pdf">www.uspto.gov/sites/default/files/new/s/fedreg/comments/0651-00xx_Matters_Comment_IEEE.pdf</a>  |