No. 23-1217

In the Supreme Court of the United States

CHESTEK PLLC, PETITIONER

v.

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

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

ELIZABETH B. PRELOGAR
Solicitor General
Counsel of Record
BRIAN M. BOYNTON
Principal Deputy Assistant Attorney General
DANIEL TENNY
JOSHUA DOS SANTOS
Attorneys

Department of Justice
Washington, D.C. 20530-0001
SupremeCtBriefs@usdoj.gov
(202) 514-2217

QUESTION PRESENTED

Whether the United States Patent and Trademark Office, in promulgating a rule that requires trademark applications to include the applicant's domicile address, was subject to the notice-and-comment rulemaking requirements of 5 U.S.C. 553(b).

TABLE OF CONTENTS

Page

Opinions below 1
Jurisdiction 1
Statement 1
Argument 8
Conclusion 16

TABLE OF AUTHORITIES

Cases:

Azar v. *Allina Health Servs.*, 587 U.S. 566 (2019) 10
Batterton v. *Marshall*, 648 F.2d 694 (D.C. Cir. 1980) 13
Cabais v. *Egger*, 690 F.2d 234 (D.C. Cir. 1982) 13
Cooper Techs. Co. v. *Dudas*,
536 F.3d 1330 (Fed. Cir. 2008) 7, 11, 12
Cuozzo Speed Techs., LLC v. *Lee*, 579 U.S. 261 (2016) 11
District of Columbia v. *Department of Agric.*,
444 F. Supp. 3d 1 (D.D.C. 2020) 13
Edelman v. *Lynchburg College*, 535 U.S. 106 (2002) 9
Electronic Privacy Info. Ctr. v. *Department of Homeland Sec.*, 653 F.3d 1 (D.C. Cir. 2011) 11
Gallegos v. *Lyng*, 891 F.2d 788 (10th Cir. 1989) 13
Gunn v. *Minton*, 568 U.S. 251 (2013) 14
Humanoids Grp. v. *Rogan*,
375 F.3d 301 (4th Cir. 2004) 14
Iancu v. *Brunetti*, 588 U.S. 388 (2019) 2
International Bhd. of Teamsters v. *Peña*,
17 F.3d 1478 (D.C. Cir. 1994) 9
JEM Broad. Co. v. *FCC*, 22 F.3d 320 (D.C. Cir. 1994) 7, 8
Klaips v. *Bergland*, 715 F.2d 477 (10th Cir. 1983) 13
Levesque v. *Block*, 723 F.2d 175 (1st Cir. 1983) 13
Perez v. *Mortgage Bankers Ass'n*, 575 U.S. 92 (2015) ... 9, 13

Cases—Continued: Page

Shell Oil Co. v. *EPA*, 950 F.2d 741 (D.C. Cir. 1991) 14, 15
SoftView LLC v. *Apple Inc.*, No. 2023-1005, 2024 WL 3543902 (Fed. Cir. 2024) 11
Supervisors v. *Stanley*, 105 U.S. 305 (1882) 14
Union of Concerned Scientists v. *Nuclear Regulatory Comm'n*, 711 F.2d 370 (D.C. Cir. 1983) 10
Vermont Yankee Nuclear Power Corp. v. *Natural Res. Def. Council, Inc.*, 435 U.S. 519 (1978)..................... 13

Statutes and regulations:

Administrative Procedure Act, 5 U.S.C. 551 *et seq.*, 701 *et seq.* 3
5 U.S.C. 553... 7, 9-13
5 U.S.C. 553(a) 12
5 U.S.C. 553(b) 9, 10,12
5 U.S.C. 553(b)(A) 4, 7-9
5 U.S.C. 553(c) 12
5 U.S.C. 553(d) 12
5 U.S.C. 553(e) 12
5 U.S.C. 703 14
5 U.S.C. 706(2)(A)... 3, 7, 10
Food Stamp Act, 7 U.S.C. 2011 *et seq.* 13
7 U.S.C. 2013(c) 13
Intellectual Property and Communications Omnibus Reform Act of 1999, Pub. L. No. 106-113, Div. B, App. I, 113 Stat. 1501A-521:
§ 4712, 113 Stat. 1501A-572 to 1501A-575..................... 10
§ 4713, 113 Stat. 1501A-575 to 1501A-578..................... 10
§ 4804(d)(2), 113 Stat. 1501A-590................................... 10
Lanham Act, ch. 540, 60 Stat. 427 (15 U.S.C. 1051 *et seq.*) 1

Statutes and regulations—Continued: Page

15 U.S.C. 1051 (2018 & Supp. II 2020) 2
15 U.S.C. 1052 2
15 U.S.C. 1071(b) (2018 & Supp. III 2021) 14
15 U.S.C. 1123 (§ 41) 3, 15
35 U.S.C. 2 .... 3, 10
35 U.S.C. 2(a) 2
35 U.S.C. 2(b)(2) 3, 8-12, 15
35 U.S.C. 2(b)(2)(B) 7, 9-11
35 U.S.C. 2(b)(2)(B)-(G) 3
35 U.S.C. 3(a)(2)(B) 10
42 U.S.C. 2000e-12(a) 9
42 U.S.C. 5403(a)(4)(B)(i) 10
37 C.F.R.:
Pt. 2 7
Section 2.2(o) 4
Section 2.11(a) 4
Section 2.11(b) 5
Section 2.22(a)(20) 4
Section 2.32(a)(2) 5, 8
Section 2.146(a)(5) 6
Section 2.148 6
Section 2.189 .... 4, 8
Pt. 11:
Section 11.1 2

Miscellaneous:

70 Fed. Reg. 10,488 (Mar. 4, 2005) 11
84 Fed. Reg. 4393 (Feb. 15, 2019) 2-4, 15
84 Fed. Reg. 31,498 (July 2, 2019) 4, 8, 14
85 Fed. Reg. 8847 (Feb. 18, 2020) 6

Miscellaneous—Continued: Page

89 Fed. Reg. 26,807 (Apr. 16, 2024) 14
89 Fed. Reg. 40,439 (May 10, 2024) 14
89 Fed. Reg. 58,660 (July 19, 2024)..................................... 14
H.R. Rep. No. 645, 116th Cong., 2d Sess. (2020).................. 2
U.S. Dep't of Justice, *Attorney General's Manual on the Administrative Procedure Act* (1947)........................ 12
U.S. Patent and Trademark Office, U.S. Dep't of Commerce, *Trademark Manual of Examining Procedure* (July 2022) 5

In the Supreme Court of the United States

No. 23-1217

CHESTEK PLLC, PETITIONER

v.

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

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The opinion of the court of appeals (Pet. App. 1-16) is reported at 92 F.4th 1105. The opinion of the Trademark Trial and Appeal Board (Pet. App. 17-26) is not reported but is available at 2022 WL 1000226.

JURISDICTION

The judgment of the court of appeals was entered on February 13, 2024. The petition for a writ of certiorari was filed on May 13, 2024. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

STATEMENT

1. a. The Lanham Act, ch. 540, 60 Stat. 427 (15 U.S.C. 1051 *et seq.*), entrusts the United States Patent and Trademark Office (USPTO or Office) with respon-

sibility for "administer[ing] a federal registration system for trademarks." *Iancu* v. *Brunetti*, 588 U.S. 388, 390 (2019); see 15 U.S.C. 1051 (2018 & Supp. II 2020), 1052; 35 U.S.C. 2(a). In recent years, the USPTO has faced a significant increase in fraudulent or inaccurate foreign trademark filings, potentially compromising the integrity of the trademark register. See H.R. Rep. No. 645, 116th Cong., 2d Sess. 9-11 (2020). In 2019, the USPTO proposed a rule to address this problem by requiring foreign-domiciled applicants, registrants, and parties appearing before the Office in trademark matters to be represented by U.S. counsel. 84 Fed. Reg. 4393, 4396 (Feb. 15, 2019).

In its notice of proposed rulemaking, the USPTO explained that, because U.S. attorneys who submit unlawful filings are potentially subject to disciplinary consequences, "requiring a qualified attorney to represent applicants, registrants, and parties whose domicile or principal place of business is not located within the U.S. or its territories is an effective tool for combatting the growing problem of foreign individuals, entities, and applicants failing to comply with U.S. law." 84 Fed. Reg. at 4396; see *id.* at 4394. The Office noted that "[t]he proposed requirement is similar to the requirement that currently exists in many other countries." *Id.* at 4396. The notice explained that "[t]he majority of countries with a similar requirement condition the requirement on [the applicant's foreign] domicile," and that "[t]he USPTO intend[ed] to follow this practice." *Ibid.*

The proposed rule accordingly stated that "[a]n applicant whose domicile or principal place of business is not located within the United States or its territories must designate an attorney as the applicant's representative." 84 Fed. Reg. at 4403; see 37 C.F.R. 11.1 (de-

fining "attorney" as "an individual who is an active member in good standing of the bar of the highest court of any State"). The proposal defined "domicile" to "mean[] the permanent legal place of residence of a natural person." 84 Fed. Reg. at 4402. The proposed rule contained a provision that would allow the Office to "require an applicant, registrant, or party to a proceeding to furnish such information or declarations as may be reasonably necessary to the proper determination of whether the applicant, registrant, or party is subject to the requirement" of representation by U.S. counsel. *Ibid.*

As statutory authority for the proposed rule, the USPTO cited 15 U.S.C. 1123 (Section 41 of the Lanham Act) and 35 U.S.C. 2. 84 Fed. Reg. at 4400. The former provision states that the Director of the USPTO "shall make rules and regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office under [the Lanham Act]." 15 U.S.C. 1123. The latter similarly authorizes the Office to "establish regulations, not inconsistent with law," that "shall govern the conduct of proceedings in the Office." 35 U.S.C. 2(b)(2). Section 2(b)(2) further specifies that such regulations "shall be made in accordance with section 553 of title 5"—the section of the Administrative Procedure Act (APA), 5 U.S.C. 551 *et seq.*, 701 *et seq.*, that governs rulemaking—and lists a number of mandatory and permissive objectives for such regulations. 35 U.S.C. 2(b)(2)(B)-(G).

The USPTO noted that the proposed rule was not required to undergo notice and comment because it fell within the APA's exception to that requirement for "rules of agency practice and procedure" (often called procedural rules) "and/or interpretive rules." 84 Fed.

Reg. at 4399; see 5 U.S.C. 553(b)(A). Nonetheless, the USPTO explained that it had "chosen to seek public comment before implementing the rule to benefit from the public's input." 84 Fed. Reg. at 4399. The Office requested that any comments be submitted within 31 days after the proposed rule was published in the Federal Register. See *id.* at 4394.

b. Several months later, the USPTO promulgated a final rule that incorporated the text of the proposed rule in all material respects. 84 Fed. Reg. 31,498, 31,507 (July 2, 2019). "To ensure clarity," the final rule defined "domicile" to include both "the permanent legal place of residence of a natural person" and "the principal place of business of a juristic entity." *Id.* at 31,500, 31,510 (37 C.F.R. 2.2(o)). To ensure that the USPTO would have sufficient information to determine whether the U.S.-counsel requirement applied, the final rule specified that an applicant or registrant must "provide and keep current the address of its domicile." *Id.* at 31,511 (37 C.F.R. 2.189). The Office noted that this domicile-address rule would help mitigate commenters' concerns "regarding efforts by foreign applicants and registrants to circumvent the proposed requirement by using temporary or fraudulent U.S. addresses." *Id.* at 31,505.

Accordingly, under the final rule, an applicant "whose domicile is not located within the United States or its territories must be represented by an attorney" who is qualified to practice under the requirements listed in the rule. 37 C.F.R. 2.11(a); see 37 C.F.R. 2.22(a)(20). To assist the USPTO in determining whether that U.S.-counsel requirement applies in particular circumstances, "[a]n applicant or registrant must provide and keep current the address of its domicile, as defined" in the rule. 37 C.F.R. 2.189; see

37 C.F.R. 2.32(a)(2). To satisfy that requirement, "[a]n applicant generally must provide its domicile street address." USPTO, U.S. Dep't of Commerce, *Trademark Manual of Examining Procedure* § 803.05(a) (July 2022). "In most cases, a post-office box, a 'care of' (c/o) address, the address of a mail forwarding service, or other similar variation cannot be a domicile address." *Ibid.* An applicant also may be required to furnish the USPTO with additional information or declarations to clarify whether the applicant is subject to the requirement. 37 C.F.R. 2.11(b).

2. a. Petitioner Chestek PLLC is a North Carolina company owned by Pamela S. Chestek. Pet. App. 18. In September 2019, Ms. Chestek submitted a petition for rulemaking to the USPTO on behalf of Software Freedom Conservancy, Inc., seeking suspension of the new rule requiring trademark applicants to provide their domicile addresses. *Id.* at 23, 27. The petition raised privacy concerns with the domicile-address rule and alleged various procedural defects, including that the rule was not a "logical outgrowth" of the USPTO's notice of proposed rulemaking and thus had been promulgated in violation of the APA's notice-and-comment requirements. C.A. App. 123-137.

In March 2020, the USPTO's Commissioner for Trademarks finalized a response denying the petition, though that response was not mailed to Ms. Chestek until August 2021. See Pet. App. 27 (explaining that the onset of the COVID-19 pandemic "had a significant impact on [the Office's] mailing operations"). The Commissioner disagreed with the petition's procedural claims and observed, among other things, that the Office had taken steps to address privacy concerns with the rule by allowing trademark applicants to submit

both a mailing address ("which can be a post-office box" or the like) and a domicile address, the latter of which "will not be displayed in the USPTO's public records." *Id.* at 36; see *id.* at 28, 30-50; 85 Fed. Reg. 8847, 8848 (Feb. 18, 2020) (explaining that, "as of December 21, 2019, the USPTO will not make publicly available the address provided in the 'Domicile Address' field on trademark forms"). The Commissioner also noted that parties can petition for a waiver of rules like the domicile-address rule. Pet. App. 36; see 37 C.F.R. 2.146(a)(5), 2.148.

b. In May 2020, petitioner filed an application for the trademark CHESTEK LEGAL. Pet. App. 18. Because that application provided only a post-office box number as its domicile address, the examining attorney refused registration based on petitioner's noncompliance with the domicile-address rule. *Id.* at 18-20. In August 2021, five days before the USPTO sent the decision denying the Software Freedom Conservancy petition discussed above, petitioner appealed that decision to the USPTO's Trademark Trial and Appeal Board. *Id.* at 27; C.A. App. 102. On appeal, petitioner "explicitly disavow[ed] any interest" in invoking the Office's measures to enable "applicants and registrants * * * to avoid making the domicile address public," and sought only "to challenge the enforcement" of the domicile-address rule. Pet. App. 19.

The Trademark Trial and Appeal Board affirmed the examining attorney's refusal of registration, based largely on the prior denial of the Software Freedom Conservancy petition, which had "raised many of the same arguments" presented in petitioner's appeal. Pet. App. 23; see *id.* at 20-26.

3. The Federal Circuit affirmed. Pet. App. 1-16.

The court of appeals held that the USPTO had not violated the APA's notice-and-comment requirements in promulgating the domicile-address rule. Pet. App. 5-11. The court first concluded that the domicile-address rule is a "rule[] of agency organization, procedure, or practice" that is exempt from notice-and-comment requirements, 5 U.S.C. 553(b)(A), because "[r]equiring different or additional information from applicants regarding their addresses merely 'alters the manner in which the applicants present themselves to the agency.'" Pet. App. 9 (brackets, ellipsis, and emphasis omitted) (quoting *JEM Broad. Co.* v. *FCC*, 22 F.3d 320, 326 (D.C. Cir. 1994)). Petitioner contended that 35 U.S.C. 2, one of the statutory provisions that the notice of proposed rulemaking had cited as authority for the rule, overrides the APA's exception to notice-and-comment requirements for such procedural rules by directing that rules governing USPTO proceedings "be made in accordance with section 553 of title 5." 35 U.S.C. 2(b)(2)(B); see Pet. App. 9-11. The court of appeals rejected that argument, relying on circuit precedent holding that the APA's procedural-rules exception applies to rules issued under 35 U.S.C. 2. Pet. App. 10-11 (citing *Cooper Techs. Co.* v. *Dudas*, 536 F.3d 1330, 1336-1337 (Fed. Cir. 2008)).

The court of appeals also rejected petitioner's claim that the domicile-address rule was arbitrary and capricious. Pet. App. 11-16; see 5 U.S.C. 706(2)(A). The court viewed the rule as a reasonable measure to address concerns about fraudulent foreign trademark applications by requiring U.S. counsel for foreign applicants. Pet. App. 12-13. The court concluded, among other things, that the USPTO had given an "adequate" explanation for "its shift in position from the proposed

rule to the final rule because, contrary to [petitioner's] position, the USPTO did not drastically shift that position." *Id.* at 14. Canvassing the proposed rule's provisions, the court explained that "the proposed rule clearly indicated that the USPTO may request" domicile information from applicants and that the rule "would require applicants to provide an address." *Id.* at 14-15.

ARGUMENT

Petitioner contends (Pet. 12-21) that the USPTO's promulgation of the domicile-address rule was subject to notice-and-comment requirements despite the rule's status as a procedural rule. That argument is incorrect, and the Federal Circuit's decision does not conflict with any decision of this Court or another court of appeals. Petitioner's claim is beside the point in any event, because the USPTO did provide for notice and comment here. Further review is not warranted.

1. The court of appeals correctly held that the APA's exception to its notice-and-comment provisions for procedural rules, 5 U.S.C. 553(b)(A), applies to USPTO procedural rules issued under 35 U.S.C. 2(b)(2). Pet. App. 9-10.

a. The rule at issue here requires trademark applicants to list a domicile address on their trademark applications. 84 Fed. Reg. 31,498, 31,511 (July 2, 2019) (37 C.F.R. 2.189, 2.32(a)(2)). It is thus a quintessential example of a procedural rule—a rule that "alter[s] the manner in which * * * parties present themselves or their viewpoints to the agency," rather than a rule that alters their "rights or interests." Pet. App. 8 (quoting *JEM Broad. Co.* v. *FCC*, 22 F.3d 320, 326 (D.C. Cir. 1994)). As the case comes to this Court, there is consequently no dispute that the domicile-address rule is a

"rule[] of agency organization, procedure, or practice" within the meaning of the APA, and so would ordinarily be exempt from notice-and-comment requirements. 5 U.S.C. 553(b)(A); see *Perez* v. *Mortgage Bankers Ass'n*, 575 U.S. 92, 101 (2015) (noting the exception for procedural rules).

Petitioner contends (Pet. 12) that the USPTO was nevertheless required to utilize notice-and-comment procedures here because 35 U.S.C. 2(b)(2) directs the USPTO to promulgate regulations "in accordance with section 553 of title 5." 35 U.S.C. 2(b)(2)(B). By its plain terms, however, Section 2(b)(2) cross-references Section 553 in its entirety, and Section 553(b)'s exceptions to the general notice-and-comment requirement—including the exception for procedural rules—are an important part of that whole. The cross-reference "do[es] no more than make § 553 applicable, its exceptions no less than its affirmative requirements." *International Bhd. of Teamsters* v. *Peña*, 17 F.3d 1478, 1486 (D.C. Cir. 1994) (construing similar language in a different statute). Indeed, this Court has reached the same conclusion in a parallel context. In *Edelman* v. *Lynchburg College*, 535 U.S. 106 (2002), the Court observed that a statute requiring the Equal Employment Opportunity Commission to issue "procedural regulations" "in conformity with the standards and limitations of" the APA did not override the APA's procedural-rules exception to notice-and-comment requirements. 42 U.S.C. 2000e-12(a); see 535 U.S. at 114 n.7.

Statutory context and common sense point in the same direction. If Congress had intended for *all* USPTO rules issued under Section 2(b)(2) to be promulgated through notice and comment, as petitioner submits (Pet. 15), it had "a much more direct path to that

destination": Congress could have included an express notice-and-comment requirement in Section 2(b)(2) itself, as it has in other federal laws. *Azar* v. *Allina Health Servs.*, 587 U.S. 566, 576 (2019); see, *e.g.*, 42 U.S.C. 5403(a)(4)(B)(i). The text introducing the exceptions in Section 553(b) expressly contemplates the existence of such statutes. 5 U.S.C. 553(b) (exceptions apply "[e]xcept when notice or hearing is required by statute"); see *Union of Concerned Scientists* v. *Nuclear Regulatory Comm'n*, 711 F.2d 370, 380-381 (D.C. Cir. 1983).

In fact, Congress enacted such a provision for the USPTO at the same time it amended Section 2(b)(2) to add the language directing that regulations governing the conduct of USPTO proceedings "shall be made in accordance with section 553." 35 U.S.C. 2(b)(2)(B); see Intellectual Property and Communications Omnibus Reform Act of 1999, Pub. L. No. 106-113, Div. B, App. I, § 4804(d)(2), 113 Stat. 1501A-590 (barring the USPTO from "ceas[ing] to maintain, for use by the public, paper or microform collections of United States patents, foreign patent documents, and United States trademark registrations, except pursuant to notice and opportunity for public comment"); see also § 4712, 113 Stat. 1501A-572 to 1501A-575 (amending 35 U.S.C. 2). In the same statute, moreover, Congress imposed certain consultation requirements when the USPTO is "changing or proposing to change * * * regulations which are subject to the requirement to provide notice and opportunity for public comment under section 553 of title 5, as the case may be." 35 U.S.C. 3(a)(2)(B); see Pub. L. No. 106-113, § 4713, 113 Stat. 1501A-575 to 1501A-578. That limitation on the scope of the consultation requirements would make little sense if all USPTO regulations were subject to notice-and-comment requirements.

It would make even less sense as a practical matter to require every USPTO regulation issued under 35 U.S.C. 2(b)(2), no matter how minor or procedural, to undergo notice and comment. See, *e.g.*, 70 Fed. Reg. 10,488, 10,488 (Mar. 4, 2005) (revising the Office's "rules of practice to update the locations and telephone numbers specified in the rules in light of [its] move to Alexandria, Virginia"; invoking the procedural-rule exception to notice and comment). Section 2(b)(2) is not reasonably read to override the APA's procedural-rules exception to notice-and-comment requirements.

b. Petitioner's counterarguments lack merit. Petitioner's principal argument (Pet. 13-17) is that, because the Federal Circuit has construed Section 2(b)(2) as authorizing the USPTO to issue *only* procedural rules, see *Cooper Techs. Co.* v. *Dudas*, 536 F.3d 1330, 1336 (2008), applying the APA's procedural-rules exception to notice-and-comment requirements would render meaningless Section 2(b)(2)'s requirement that USPTO rules be made "in accordance with section 553." 35 U.S.C. 2(b)(2)(B). That argument has multiple flaws. Section 2(b)(2) "does not clearly contain the [Federal] Circuit's claimed limitation" to procedural rules. *Cuozzo Speed Techs., LLC* v. *Lee*, 579 U.S. 261, 277 (2016); see *SoftView LLC* v. *Apple Inc.*, No. 2023-1005, 2024 WL 3543902, at *5 & n.3 (Fed. Cir. 2024). Because the line between procedural and substantive rules is not always clear-cut, see *Electronic Privacy Info. Ctr.* v. *Department of Homeland Sec.*, 653 F.3d 1, 5-6 (D.C. Cir. 2011), Section 2(b)(2)'s incorporation of Section 553 at least serves to clarify that USPTO rules issued under this authority are not categorically exempt from notice-and-comment requirements. And given the Federal Circuit's holding that Section 2(b)(2) "does not authorize

the [USPTO] to issue 'substantive' rules," *Cooper Techs.*, 536 F.3d at 1336, petitioner's argument here is irreconcilable with its acknowledgment (Pet. 20) that "'interpretive' rules issued pursuant to section 2(b)(2) are exempt from notice-and-comment requirements pursuant to section 553(b)(A)."

Even assuming that Section 2(b)(2) is confined to procedural rules, its cross-reference of Section 553 has meaningful practical import. Procedural rules are not exempted from the entirety of Section 553. Section 553(b) provides that "*this subsection* does not apply" to procedural rules, 5 U.S.C. 553(b) (emphasis added), and subsections (c) and (d) exclude such rules as well. See 5 U.S.C. 553(c) (applicable only "after notice required by this section"); 5 U.S.C. 553(d) (applicable only to "a substantive rule"). But procedural rules remain subject to the requirement that the agency "give an interested person the right to petition for the issuance, amendment, or repeal of a rule." 5 U.S.C. 553(e); see U.S. Dep't of Justice, *Attorney General's Manual on the Administrative Procedure Act* 13 n.5 (1947); cf. 5 U.S.C. 553(a) (exempting from the entire "section" matters involving, *e.g.*, "a military or foreign affairs function of the United States"). Before she initiated this litigation, petitioner's owner herself submitted such a petition as to the domicile-address rule. See p. 5, *supra*. Reading Section 2(b)(2) to mean what it says—incorporating Section 553 in its entirety, including its exceptions to notice-and-comment requirements—thus does not deprive the cross-reference to Section 553 of all practical effect.

Petitioner fares no better in invoking (Pet. 17-20) other statutes that cross-reference Section 553. Petitioner cites no authority holding that any of those stat-

utes requires notice and comment for procedural rules. And the decisions petitioner cites concerning regulations under the Food Stamp Act, 7 U.S.C. 2011 *et seq.*, only hurt its cause. See 7 U.S.C. 2013(c) (requiring promulgation of regulations "in accordance with the procedures set forth in section 553 of title 5"). Two of those decisions assume that the APA's exceptions to notice-and-comment requirements apply to such regulations. See *Levesque* v. *Block*, 723 F.2d 175, 178-185 (1st Cir. 1983); *Klaips* v. *Bergland*, 715 F.2d 477, 482-483 (10th Cir. 1983). The others do not address the exceptions at all. See *Gallegos* v. *Lyng*, 891 F.2d 788, 789, 795 (10th Cir. 1989); *District of Columbia* v. *Department of Agric.*, 444 F. Supp. 3d 1, 7 (D.D.C. 2020).

Petitioner's concerns about the effects of the USPTO's procedural rules on trademark applicants and registrants (Pet. 22-24) are likewise unavailing. The procedural-rules exception to the APA's general notice-and-comment requirement reflects Congress's judgment that agencies should "retain latitude in organizing their internal operations." *Batterton* v. *Marshall*, 648 F.2d 694, 707 (D.C. Cir. 1980); see *Perez*, 575 U.S. at 102 (Section 553 "established the maximum procedural requirements which Congress was willing to have the courts impose upon agencies in conducting rulemaking.") (quoting *Vermont Yankee Nuclear Power Corp.* v. *Natural Res. Def. Council, Inc.*, 435 U.S. 519, 524 (1978)). And while some procedural rules significantly affect how parties interact with the agency, see *Cabais* v. *Egger*, 690 F.2d 234, 237 (D.C. Cir. 1982), those parties have other means of seeking to have those rules changed. See p. 12, *supra*. The absence of a notice-and-comment requirement enables agencies to alter proce-

dural rules efficiently, including in response to concerns and objections raised by the public.

2. Further review is not warranted for several additional reasons. First, petitioner identifies no disagreement among the courts of appeals on the question presented, asserting only that "a circuit split is highly unlikely to develop" given "the Federal Circuit's unique jurisdictional authority." Pet. 24. But while the Federal Circuit has exclusive jurisdiction over appeals in *patent* cases, see *Gunn* v. *Minton*, 568 U.S. 251, 261-262 (2013), challenges to trademark rules like the one at issue here may arise in other circuits, see 5 U.S.C. 703; 15 U.S.C. 1071(b) (2018 & Supp. III 2021); cf., *e.g.*, *Humanoids Grp.* v. *Rogan*, 375 F.3d 301, 304-305 (4th Cir. 2004) (APA challenge to the Office's interpretation of a USPTO trademark regulation).

Second, even if the question presented warranted this Court's review, this case would be an unsuitable vehicle for considering it because resolution of that issue in petitioner's favor would not change the outcome here. See *Supervisors* v. *Stanley*, 105 U.S. 305, 311 (1882) (This Court does not grant a writ of certiorari to "decide abstract questions of law * * * which, if decided either way, affect no right" of the parties.). The USPTO promulgated the domicile-address rule through notice-and-comment rulemaking, even though it was not obligated to do so. See 84 Fed. Reg. at 4399; see also, *e.g.*, 89 Fed. Reg. 58,660, 58,661 (July 19, 2024); 89 Fed. Reg. 40,439, 40,445 (May 10, 2024); 89 Fed. Reg. 26,807, 26,812 (Apr. 16, 2024). Although the domicile-address rule was not included verbatim in the notice of proposed rulemaking, the final rule adopted by the agency was plainly a "logical outgrowth" of the proposed rule, *Shell Oil Co.* v. *EPA*, 950 F.2d 741, 747 (D.C. Cir. 1991) (per curiam), as

the court of appeals effectively found in rejecting petitioner's arbitrary-and-capricious challenge. See Pet. App. 14-15 ("[T]he proposed rule clearly indicated that the USPTO may request [domicile address] information from applicants and that it would require applicants to provide an address."). Even if the APA's notice-and-comment requirement applied, the rule at issue here would have satisfied it. See *Shell Oil*, 950 F.2d at 747.

In addition, the domicile-address rule was authorized not only by 35 U.S.C. 2(b)(2), but also by 15 U.S.C. 1123, which similarly authorizes the USPTO to "make rules and regulations, not inconsistent with law, for the conduct of [its] proceedings" under the Lanham Act. 15 U.S.C. 1123; see 84 Fed. Reg. at 4400. Petitioner has not disputed that Section 1123 alone provides sufficient statutory authority for the rule, nor has it contended that notice and comment is required for procedural rules issued thereunder. For that reason as well, the domicile-address rule would remain valid even if the question presented were resolved in petitioner's favor.

Finally, as petitioner recognizes, the USPTO has already taken steps to address the privacy concerns that are central to petitioner's objections to the domicile-address rule. Trademark applicants can now provide a mailing address in addition to their domicile address, and only the former will be made available to the public. See pp. 5-6, *supra*; Pet. 9-10. That change further reduces the practical significance of any question concerning the rule's validity.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

ELIZABETH B. PRELOGAR
Solicitor General
BRIAN M. BOYNTON
Principal Deputy Assistant Attorney General
DANIEL TENNY
JOSHUA DOS SANTOS
Attorneys

AUGUST 2024