

Appeal Nos. 2019-1443, -1447, -1449, -1450

**UNITED STATES COURT OF APPEALS
FEDERAL CIRCUIT**

INTEL CORPORATION, CAVIUM, LLC, and DELL INC.,

Appellants,

v.

ALACRITECH, INC.,

Cross-Appellant.

UNITED STATES,

Intervenor.

**Appeal from the United States Patent and Trademark Office,
Patent Trial and Appeal Board
IPR2017-01405**

**APPELLANTS INTEL CORPORATION, CAVIUM, LLC, AND DELL
INC.'S COMBINED PETITION FOR REHEARING AND REHEARING *EN
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court's decision in the pending appeal. *See* Fed. Cir. R. 47.4(a)(5) and 47.5(b). (The parties should attach continuation pages as necessary).

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Cavium, LLC v. Alacritech, Inc., Docket No. 20-1119 (Fed. Cir.)

Dated: April 6, 2020

/s/ Garland T. Stephens

Garland T. Stephens

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3. Parent corporations and publicly held companies that own 10% or more of stock in the party:

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Marvell Technology, Inc.

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David T. Xue of Rimon, P.C.

5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this

court's decision in the pending appeal. *See* Fed. Cir. R. 47.4(a)(5) and 47.5(b). (The parties should attach continuation pages as necessary).

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Dated: April 6, 2020

/s/ Karineh Khachatourian

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4. The names of all law firms and the partners or associates that appeared for the Party or amicus now represented by me in the trial court or agency or are expected to appear in this court (and who have not or will not enter an appearance in this case) are:

Christopher Douglas (Alston & Bird)

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court's decision in the pending appeal. *See* Fed. Cir. R. 47.4(a)(5) and 47.5(b). (The parties should attach continuation pages as necessary).

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Dated: April 6, 2020

/s/ Kirk T. Bradley

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STATEMENT OF RELATED CASES

There have been no prior appeals in or from *inter partes* review (“IPR”) proceeding number IPR2017-01405 previously before this Court or any other appellate court. This consolidated appeal involves the Final Written Decision by the Patent Trial and Appeal Board (“the Board” or “PTAB”) in IPR2017-01405, concerning U.S. Patent No. 7,124,205 (“the 205 Patent”) assigned to Appellee Alacritech, Inc. (“Alacritech”).

A number of related appeals are also pending before this Court from IPR proceedings in which Intel Corporation (“Intel”) challenged claims of other related patents owned by Alacritech. These appeals have been consolidated into three groups. The first group consists of Appeal Nos. 2019-1444, 2019-1445, and 2019-1466, which are all appeals from three Final Written Decisions entered by the Board in IPR2017-01391 (concerning U.S. Patent No. 7,237,036), IPR2017-01392 (concerning U.S. Patent No. 7,337,241), and IPR2017-1406 (concerning U.S. Patent No. 7,673,072), respectively. The second group consists of Appeal No. 2019-1464, which is an appeal from the Final Written Decision entered by the Board in IPR2017-01393 (concerning U.S. Patent No. 9,055,104). The third group consists of Appeal Nos. 2019-1467 and 2019-1468, which are appeals from two Final Written Decisions entered by the Board in IPR2017-01409 (concerning U.S. Patent No. 8,131,880) and IPR2017-01410 (concerning the same), respectively. Each of these

appeals has been designated a companion case to the present case and has been assigned to the same merits panel for oral argument.

The Court's decision in this case may affect or be affected by the following related cases pending before the U.S. District Court for the Eastern District of Texas ("the District Court"): *Alacritech, Inc., v. CenturyLink, Inc.*, Case No. 2:16-cv-00693-RWS-RSP (LEAD CASE), *Alacritech, Inc., v. Dell Inc.*, Case No. 2:16-cv-00695-RWS-RSP, and *Alacritech, Inc., v. Wistron Corp.*, Case No. 2:16-cv-00692-JRG-RSP. Intel intervened in all three cases and Cavium, Inc. ("Cavium") intervened in the case against Dell Inc. ("Dell"). The 205 Patent at issue in this appeal was asserted in all three cases, which are currently stayed.

On June 4, 2019, the Board vacated its institution decisions in IPR proceedings for the 205 Patent and two other related Alacritech patents: IPR2018-00226 (concerning the 205 Patent), IPR2018-00234 (concerning U.S. Patent No. 8,805,948), and IPR2018-00401 (concerning U.S. Patent No. 7,945,699). On October 29 and 30, 2019, Intel, Dell, and Cavium ("Appellants") filed Notices of Appeal for IPR2018-00226 and IPR2018-00234. Appellant Cavium also filed a Notice of Appeal for IPR2018-00401 on October 29, 2019. IPR2018-00226 challenged different claims of the same 205 Patent at issue in this appeal. The Court's decision in this case may affect or be affected by the IPR2018-00226 proceedings.

FEDERAL CIRCUIT RULE 35(B)(2) STATEMENT OF COUNSEL

Based on my professional judgment, I believe the panel decision is contrary to the following decision(s) of the Supreme Court of the United States: *Free Enterprise Fund v. PCAOB*, 561 U.S. 477 (2010); *Edmond v. United States*, 520 U.S. 651 (1997); and *Freytag v. Comm’r*, 501 U.S. 868 (1991).

Based on my professional judgment, this appeal requires an answer to one or more precedent-setting questions of exceptional importance:

(1) Whether the case should be allowed to proceed on the merits when no party is requesting remand based on *Arthrex, Inc. v. Smith & Nephew, Inc.*, 941 F.3d 1320 (Fed. Cir. 2019);

(2) Whether litigants who failed to raise an Appointments Clause challenge before the Patent Trial and Appeal Board (“PTAB” or “Board”) should be permitted to raise such a challenge on appeal when there is no need for timely resolution or remedial action;

(3) If administrative patent judges (“APJs”) are principal officers, what remedy is warranted for this and similarly-situated cases; and

(4) Whether APJs of the PTAB are inferior or principal officers of the United States under the Appointments Clause.

Dated: April 6, 2020

/s/ Garland T. Stephens
Garland T. Stephens
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INTRODUCTION

Intel¹ respectfully requests that this Court grant panel rehearing so that this Court may consider the merits of the appeal without an intervening remand to the PTAB. In particular, these appeals differ significantly from other cases that have been remanded based on *Arthrex* because both Appellant Intel and Cross-Appellant Alacritech now *agree* that the cases should *not* be remanded to the PTAB.² As explained in the concurrently-filed Joint Motion That This Court Should Retain the Mandate and Proceed on the Merits, both Intel and Alacritech request that this Court's order be vacated so that Alacritech can withdraw its Appointments Clause challenge. Accordingly, Intel respectfully submits that panel rehearing is warranted so that Alacritech's request to abandon its Appointments Clause Challenge can be given effect and the cases can proceed on the merits before this Court without an unnecessary remand that neither Intel nor Alacritech is seeking.

FACTUAL BACKGROUND

Alacritech did not raise an Appointments Clause challenge before the Board. Instead, Alacritech argued for the first time in its opening brief to this Court that the

¹ All Appellants also join Intel in this Petition.

² For the concurrently-filed Joint Motion That This Court Should Retain the Mandate and Proceed on the Merits, the United States does not oppose the other parties' request insofar as they are requesting that the court vacate its prior judgment vacating the Board's decisions in this appeal, hold any Appointments Clause challenge affirmatively waived, and proceed to merits of this case.

Board's decision was invalid because the APJs who rendered it were appointed in violation of the Appointments Clause, U.S. CONST. art. II, § 2, cl.2.

In its October 31, 2019 decision, the *Arthrex* panel found that APJs are “principal officers,” severed the application of Title 5’s removal restrictions to APJs, rendering them inferior officers, and then remanded the case to a new panel of APJs for a new hearing. *Id.* at 1338-1340. The Federal Circuit recently rejected the *Arthrex* parties’ petitions for *en banc* rehearing in *Arthrex*. *Arthrex*, D.I. 115.

On December 10, 2019, Alacritech submitted its reply brief in this case, acknowledging the *Arthrex* decision and its impact on Alacritech’s arguments relating to the Appointments Clause. Alacritech acknowledged that “[t]he vacatur-and-remand remedy granted in *Arthrex* is more narrow than the complete ‘reversal’ Alacritech sought in its opening brief in this case (Br. 20, 62-64), which, as a reversal, would have meant that the ’205 Patent is entirely *valid* and would not have sent the case to the PTAB for further proceedings.” D.I. 54 at 17 (emphasis in original). Alacritech then requested that the Court “vacate only as to those portions of the PTAB’s decision on which Alacritech does not prevail on its other (*i.e.*, non-Appointments Clause) arguments for reversal or vacatur (as to Claims 3, 9-10, 16, 22, 24-30, and 35-36). But if Alacritech prevails on those non-Appointments Clause arguments, this Court should resolve the dispute based on those arguments.” *Id.* at 17-18. Alacritech contended that the Court “has jurisdiction to resolve the cross-

appeal on the merits because ‘Appointments Clause challenges are nonjurisdictional’” and that the Court “should exercise its jurisdiction to resolve Alacritech’s merits arguments in the interest of judicial economy.” *Id.* at 18.

On December 12, 2019, Alacritech submitted a letter pursuant to Federal Circuit Rule 28(i) identifying *Arthrex* as supplemental authority. D.I. 55. In the letter, Alacritech requested that the Federal Circuit proceed with the merits of the appeal and only reach the Appointments Clause challenge if Alacritech loses on the merits.³

On February 20, 2019, the Court vacated this decision and “remanded to the Board for proceedings consistent with *Arthrex*.” D.I. 75 at 3.

On February 21, 2020, Alacritech filed a petition for panel rehearing, arguing that Intel forfeited any Appointments Clause challenge and the claims that Intel challenged on appeal should not be remanded under *Arthrex*. D.I. 77 at 2-4.

³ As Alacritech explained more fully in the three other consolidated cases, Alacritech requested that the Federal Circuit “resolve its arguments that the PTAB decision should be reversed or vacated on the merits” and only remand based on *Arthrex* if the Federal Circuit decided against Alacritech on the merits. *See, e.g.*, Appeal No. 2019-1444, D.I. 66. Indeed, Alacritech has now filed petitions for rehearing requesting that it be allowed to abandon its Appointments Clause challenge in the three other consolidated cases if the Federal Circuit does not invalidate the America Invents Act. *Id.*, D.I. 83. Alacritech’s earlier petition for rehearing on a different issue, related to patent claims that Intel had challenged, prevented Alacritech from filing a similar petition for rehearing in this case. D.I. 77; *see also* Fed. Cir. Rule 35(d).

Alacritech requested that the Board's finding that claims 31-33 were not unpatentable remain standing. *Id.*

On March 9, 2020, the Federal Circuit denied Alacritech's petition for panel rehearing. D.I. 79.

On April 6, 2020, Intel and Alacritech submitted the concurrently-filed Joint Motion That This Court Should Retain the Mandate and Proceed on the Merits, which requests that the Court vacate its order, allow Alacritech to withdraw its Appointment Clause challenge, and proceed on the merits.

ARGUMENT

Both Intel and Alacritech now agree that this Court should proceed to the merits of the appeal without a remand to the Board based on a violation of the Appointment Clause. Proceeding on the merits of the appeals without a remand is thus desired by both Appellant Intel and Cross-Appellant Alacritech—who are in full agreement on that critical point—and is the most efficient course of action for the parties, the Board, and the Court. The appeals are fully briefed and merely waiting for an oral argument date. Therefore, Intel respectfully submits that panel rehearing is warranted so that Alacritech's request to abandon its Appointment Clause challenge can be given effect and the appeals can simply proceed on the merits.

Although Intel wishes the Federal Circuit to decide the consolidated appeals on the merits without remand, if the panel nonetheless were to deny panel rehearing and order a remand, Intel would respectfully request *en banc* rehearing on whether Alacritech's unopposed request to abandon its Appointment Clause challenge should be given effect, whether APJs are inferior officers, whether Alacritech forfeited its Appointments Clause challenge by not raising it before the Board below, and what remedy is appropriate when the patent owner asks to proceed on the merits before the Federal Circuit even after *Arthrex* held the PTAB trials below violated the Constitution.

I. Panel Rehearing Is Warranted Because Both Appellant Intel and Cross-Appellant Alacritech Agree This Case Should Not Be Remanded And Instead Should Proceed On The Merits Absent *En Banc* Intervention

This case is unusual because both Appellant Intel and Cross-Appellant Alacritech agree that the case should not be remanded pursuant to *Arthrex*. Alacritech initially raised an Appointments Clause challenge, but has now asked to withdraw that challenge in the concurrently-filed Joint Motion That This Court Should Retain the Mandate and Proceed on the Merits.

Proceeding on the merits in this Court is the most efficient course of action and will conserve judicial resources. The PTAB and the parties have invested substantial time in these IPRs and the issues are fully briefed before this Court. All that remains is for the Court to set and hold oral argument. This will also reduce the

number of cases impacted by *Arthrex* if all seven of the instant consolidated appeals are allowed to proceed on the merits. Furthermore, it is in the public interest to resolve these disputes expeditiously to provide certainty regarding the scope of Alacritech's patent rights and reduce the demands on the PTAB and this Court. This Court has allowed other patent owners to withdraw their Appointments Clause challenges after the briefing is complete, so that their appeal can proceed on the merits before this Court. *See Koninklijke Philips N.V. v. Microsoft Corp.*, No. 19-1178, D.I. 77 (Fed. Cir. Nov. 18, 2019); *L'Oreal USA, Inc. v. Liqwd, Inc.*, No. 19-2410, D.I. 24 (Fed. Cir. Mar. 4, 2020). In light of Alacritech's withdrawal of its request for an *Arthrex* remand, Intel respectfully requests panel rehearing so that this case can be addressed on the merits.

II. If Panel Rehearing Is Denied, *En Banc* Rehearing Is Warranted On Whether The Case Should Be Remanded

Intel wishes for the Court to grant panel rehearing so that these fully briefed appeals may proceed on the merits before the Federal Circuit without a remand. To the extent that the panel denies that request and orders a remand, Intel submits that *en banc* rehearing of that order would be warranted.

While Intel recognizes that existing circuit precedent is to the contrary, Intel respectfully submits that APJs are inferior officers because of significant direction and supervision that the Director has as a "superior" over the APJs and the fact that the Supreme Court has held that similar direction and supervision renders officers

“inferior officers.” *See, e.g., Freytag*, 501 U.S. at 881-82. Indeed, the Director’s ability to both remove APJs and control the APJs’ decisions places the APJs well within the scope of inferior officers under controlling Supreme Court precedent.

Even if the proceedings below violated the Constitution’s Appointments Clause (which Intel disputes), Intel respectfully submits that the question of whether a party can forfeit its challenge and proceed on the merits warrants *en banc* review. The justification in the *Arthrex* decision for ignoring Arthrex’s forfeiture does not provide a sufficient basis to entertain Alacritech’s belated challenge given that the need for timely resolution and remedial action no longer exists.

Further, as explained by Judge Dyk in his dissent from the denial of rehearing *en banc* in *Arthrex*, when the judiciary construed the statute to permit severance, its effect should have been both retrospective and prospective. As Judge Dyk explained, “the statute here must be read as though the APJs had always been constitutionally appointed.” *Arthrex*, D.I. 115 at 36. In other words, APJs should be treated as removable at will prior to the issuance of the *Arthrex* decision. This fix should apply retrospectively, so that a remand is not required. *Arthrex*, D.I. 115 at 34 (“If the ruling were retroactive, the actions of APJs in the past would have been compliant with the constitution and the statute.”).

Finally, Intel respectfully submits that the equities do not require remanding this case and certainly not to a new set of APJs, particularly when Alacritech was

willing to proceed on the merits before this Court even after the APJs were held unconstitutional. For all these reasons, Intel respectfully submits that *en banc* review is warranted if panel review is denied.

CONCLUSION

For the foregoing reasons, Intel respectfully requests that the Court grant panel rehearing and proceed on the merits, but if the panel does not do so, then *en banc* review is warranted for the reasons set forth above.

Dated: April 6, 2020

Respectfully submitted,

/s/ Garland T. Stephens

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ADDENDUM

NOTE: This order is nonprecedential.

**United States Court of Appeals
for the Federal Circuit**

INTEL CORPORATION, CAVIUM, LLC, DELL, INC.,
Appellants

v.

ALACRITECH, INC.,
Cross-Appellant

UNITED STATES,
Intervenor

2019-1443, -1447, -1449, -1450

Appeals from the United States Patent and Trademark Office, Patent Trial and Appeal Board in Nos. IPR2017-01405, IPR2017-01735, and IPR2018-00336.

ALACRITECH, INC.,
Appellant

v.

**INTEL CORPORATION, CAVIUM, LLC, DELL, INC.,
WISTRON CORPORATION,**
Appellees

UNITED STATES,
Intervenor

2019-1444, -1445, -1466

Appeals from the United States Patent and Trademark Office, Patent Trial and Appeal Board in Nos. IPR2017-01391, IPR2017-01392, IPR2017-01406, IPR2017-01707, IPR2018-00329, and IPR2018-00375.

ALACRITECH, INC.,
Appellant

v.

INTEL CORPORATION, CAVIUM, LLC, DELL INC.,
Appellees

UNITED STATES,
Intervenor

2019-1464

Appeal from the United States Patent and Trademark Office, Patent Trial and Appeal Board in Nos. IPR2017-01393, IPR2017-01714, and IPR2018-00374.

ALACRITECH, INC.,
Appellant

v.

INTEL CORPORATION v. ALACRITECH, INC.

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INTEL CORPORATION, CAVIUM, LLC, DELL, INC.,
Appellees

UNITED STATES,
Intervenor

2019-1467, -1468

Appeals from the United States Patent and Trademark Office, Patent Trial and Appeal Board in Nos. IPR2017-01409, IPR2017-01410, IPR2017-01736, IPR2017-01737, IPR2018-00338, and IPR2018-00339.

PER CURIAM.

O R D E R

In its opening briefs in each of the above appeals and cross-appeals, Alacritech, Inc. argues that the final written decisions at issue in these appeals exceed the scope of the Patent Trial and Appeal Board's authority and violate the Constitution's Appointments Clause. In light of *Arthrex, Inc. v. Smith & Nephew, Inc.*, 941 F.3d 1320 (Fed. Cir. 2019), the court now vacates the Board decisions and remands for proceedings consistent with this court's decision in *Arthrex*. On remand, the Board may also wish to consider *Samsung Electronics America, Inc. v. Prisia Engineering Corp.*, 948 F.3d 1342 (Fed. Cir. 2020).

Accordingly,

IT IS ORDERED THAT:

(1) The Patent Trial and Appeal Board's decisions are vacated, and the cases are remanded to the Board for proceedings consistent with *Arthrex* and this order.

(2) Each side shall bear its own costs.

FOR THE COURT

February 20, 2020
Date

/s/ Peter R. Marksteiner
Peter R. Marksteiner
Clerk of Court

CERTIFICATE OF COMPLIANCE

1. This brief complies with the type-volume limitation of Federal Rule of Federal Circuit Rule 32(a) or Federal Rule of Federal Circuit Rule 28.1. This brief contains 2000 words, excluding the parts of the brief exempted by Federal Rule of Appellate Procedure 32(f).

2. This brief complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) or Federal Rule of Federal Circuit Rule 28.1 and the type style requirements of Federal Rule of Appellate Procedure 32(a)(6). This brief has been prepared in a proportionally spaced typeface using Microsoft Word 2016 in Times New Roman 14 point font.

Dated: April 6, 2020

/s/Garland T. Stephens
Garland T. Stephens

CERTIFICATE OF SERVICE

I hereby certify that on April 6, 2020, I filed or caused to be filed a copy of the foregoing with the Clerk of the United States Court of Appeals for the Federal Circuit via the CM/ECF system and served or caused to be served a copy on all counsel of record by the CM/ECF system.

Dated: April 6, 2020

/s/ Garland T. Stephens

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