

2019-2423

**In the United States Court of Appeals
For the Federal Circuit**

WATERBLASTING, LLC,
Appellant

v.

ANDREI IANCU, Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office,
Intervenor

*Appeal from the United States Patent and Trademark Office Patent Trial and Appeal Board,
Case No. IPR2018-00504 regarding U.S. Patent 7,255,116 B2*

**APPELLANT WATERBLASTING, LLC'S COMBINED PETITION
FOR PANEL REHEARING AND/OR REHEARING *EN BANC***

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CERTIFICATE OF INTEREST

Counsel for the Appellant Waterblasting, LLC hereby certifies the following:

1. The full name of every party represented by me is:

Waterblasting, LLC.
2. The full name of all real parties in interest for the entities, not including the real parties in interest which are the same as the entities, are:

None/Not Applicable.
3. The full names of all parent corporations for the entities and all publicly held companies that own 10% or more of stock in the entities are:

None/Not Applicable.
4. The names of all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency of (b) are expected to appear in this court for the entities, not including those have already entered an appearance in this court, are:

MCHALE & SLAVIN, P.A.: A. Keith Campbell, and Kenneth W. Cohen.
5. The case title and numbers of any case known 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).

None/Not Applicable.
6. Any information required under Fed. R. App. P. 26.1(b) and 26.1(c). See Fed. Cir. R. 47.4(a)(6).

None/Not Applicable.

December 21, 2020

/s/ Andrew D. Lockton

Andrew D. Lockton

Counsel for Appellant Waterblasting, LLC

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STATEMENT OF COUNSEL UNDER RULE 35(b)(2)

Based on my professional judgment, I believe the panel decision is contrary to at least the following decisions of the Supreme Court of the United States and the precedents of this court: *SEC v. Chenery Corp.*, 318 U.S. 80 (1943); *In re Zurko*, 258 F.3d 1379 (Fed. Cir. 2001).

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

Whether the Act of 1984, Pub. L. 98-620, title IV, § 414(a), Nov. 8, 1984, 98 Stat. 3335, 3362, amending the language in 35 U.S.C. § 144 to provide that this Court shall issue “its mandate and opinion” instead of “a certificate of its proceedings and decision,” requires this Court to issue an opinion, precluding Rule 36 affirmances without opinion, when reviewing appeals from the United States Patent and Trademark Office.

I. INTRODUCTION

Appellant Waterblasting, LLC (“Waterblasting”) seeks panel rehearing and/or rehearing *en banc* of the panel’s Rule 36 affirmance without opinion of the Final Written Decision (“Decision”) of the United States Patent and Trademark Office’s Patent Trial and Appeal Board (“PTAB”). In the Decision, issued in *inter partes* review Case No. IPR2018-00504, the Board found claims 1-4 and 10 of Waterblasting’s patent, United States Patent No. 7,255,116 (the “’116 patent”), obvious based on the combination of the prior art NLB and Clemons references.

The Board’s Decision was based on the necessary finding that the prior art “NLB teaches using a secondary ‘compact and maneuverable’ utility vehicle, such as the StripeJet, for ‘areas with limited access (e.g., parking lots, garages, intersections).’” Appx34-35. This finding by the Board—that the NLB reference *teaches* the StripeJet as a “secondary”, “non-self-contained vehicle”—was necessary for its obviousness determination; it was required to find a motivation to combine the references, and it was necessary for finding that the prior art teaches or suggests each of the limitations claimed in the ’116 patent. The problem, however, is that the NLB reference *expressly* teaches the opposite: the StripeJet is *not* a “secondary” vehicle, but rather a complete single-vehicle system. Before the panel, the Director conceded that the NLB reference taught that the StripeJet was a “complete system” unto itself, not a “secondary” vehicle.

The panel's affirmance, issued without opinion pursuant to Fed. R. App. P. 36, conflicts with the Supreme Court's precedent in *SEC v. Chenery Corp.*, 318 U.S. 80 (1943) and this Court's prior precedent in *In re Zurko*, 258 F.3d 1379 (Fed. Cir. 2001). In *Chenery*, the Supreme Court explained that "[t]he grounds upon which an administrative order must be judged are those upon which the record discloses that its action was based." 318 U.S. at 87. The Court expressly contrasted review of agency orders with the review appellate courts can apply to actions coming from the district court, where the ultimate decision can be affirmed based upon any ground the record provides for—even if different from the reasoning of the district court. *Id.* at 88.

Like this Court's prior precedent in *Zurko*, 258 F.3d at 1383-85, since the Board's decision here was based on a finding the Director conceded was error, the panel's affirmance could not have been based on the same grounds as the Board based its decision; thus, it necessarily violated *Chenery*—the panel was required to reverse the Board's Decision under *Chenery*, 318 U.S. at 87 and *Zurko*, 258 F.3d at 1383-85 (explaining that *Chenery* dictated rejecting the Board's obviousness determination after the Commissioner conceded the prior art references relied upon by the Board did not disclose the necessary limitation the Board based its decision on). Even though the panel's Rule 36 affirmance omits the panel's rationale for affirming the Board's decision, the Director's concession proves the panel's affirmance could not be based on the same grounds as the Board's decision.

Beyond simply preventing review of the panel's rationale for affirming the Board, the Rule 36 affirmance *without opinion* violates the Act of 1984, Pub. L. 98-620, title IV, § 414, 98 Stat. 3362-63, which amended 35 U.S.C. § 144 and requires this Court to issue *an opinion* when reviewing appeals from the Patent and Trademark Office. Because the panel affirmed the Board without the required opinion, it is contrary to the law. *See* 35 U.S.C. § 144. The panel's decision—affirming an agency on grounds that the Director concedes were incorrect—demonstrates why compliance with § 144 is necessary.

II. POINTS OF LAW OR FACT OVERLOOKED OR MISAPPREHENDED BY THE PANEL

Pursuant to Federal Circuit Rule 35(e)(1)(F) and 40(a)(5) and Federal Rule of Appellate Procedure 40(a)(2), Waterblasting submits the following points of law or fact that were overlooked or misapprehended by the court in the panel decision.

1. The panel overlooked or misapprehended the requirements of *SEC v. Chenery Corp.*, 318 U.S. 80 (1943), as further explained in this Court's prior precedent in *In re Zurko*, 258 F.3d 1379 (Fed. Cir. 2001), in reviewing the Board's decision from Waterblasting's *inter partes* review proceeding at the United States Patent and Trademark Office. In a review from an agency, the panel can only affirm the Board on the same grounds as the Board based its decision, which required the finding that the cited NLB reference disclosed the StripeJet vehicle as a *secondary* vehicle in a two-vehicle system. But as the Director conceded below, the Board's finding was

erroneous. As such, the panel could not have affirmed the Board on the same grounds as the Board’s decision was based. Further, because this was an *inter partes* review proceeding, the Board was confined to reviewing only the grounds in the IPR petition, and therefore the Board would not be able to find obviousness based on any alternative grounds. Accordingly, the panel was required to reverse the obviousness determination and remand for further proceedings on the remaining grounds the Board had not reached.

2. When Congress amended the Patent Laws in 1984—against the backdrop of the Federal Rules of Appellate Procedure, enacted in 1968, and the creation of the United States Court of Appeals for the Federal Circuit in 1982—Congress amended the law for appeals to the Federal Circuit from the Patent Office, requiring this Court to issue an *opinion*. Pub. L. 98-620, title IV, § 414(a), 98 Stat. 3335, 3363-64. The amendment and use of the terms “mandate and opinion” in place of the prior, broader authority to issue a “certificate of [the] proceedings and decision” is significant and must be understood to preclude this Court’s use of Rule 36 Judgments without an opinion.

III. STATEMENT OF RELEVANT FACTS AND PROCEDURAL BACKGROUND

Appellant Waterblasting is the owner of the ’116 patent which claims a novel two-vehicle cleaning system. The first vehicle is a prime mover truck, which includes at least the claimed liquid reservoir, high power vacuum pump and sump for removing debris once coatings are blasted from the road by the high-pressure water

pump. The second vehicle is a smaller, and more maneuverable, tractor which includes a mobile blast head which controls the precision of the water blasting operation. The two-vehicles operate together as a system, neither functions individually.

The '116 patent was challenged by petitioner Blasters, Inc. ("Blasters"). The ground relevant to the Board's Decision and this appeal was ground 4, asserting that claims 1-4 and 10 were obvious based on the combination of the prior art NLB and Clemons references. The Board's Decision agreed that this combination rendered those claims obvious. Critical to both the petition and the Board's Decision was the finding that the Clemons reference would benefit from "including a secondary 'compact and maneuverable' utility vehicle, such as the StripeJet tractor disclosed in NLB." The Board's determination was based on finding that "NLB teaches that smaller non-self-contained vehicles, such as its StripeJet vehicle, have better, tighter turning radii than large self-contained vehicles, such as its StarJet vehicle."

The Board's Decision, and the petitioner's arguments and evidence, relied on the NLB reference *teaching* that the StripeJet was a "secondary" vehicle, one that was "non-self-contained" and therefore cooperated with a primary vehicle, i.e., just as is claimed in the '116 patent. The problem, however, is that the NLB reference expressly states that the StripeJet is a "complete system"; it is *not* a "secondary" vehicle, it *is* self-contained. The Director conceded that the Board was incorrect in this necessary finding; in the briefing the Director presented other rationales to

support the Board's decision on this issue and at oral argument the Director conceded in questioning from the panel that the StripeJet is a complete system, that it is not a "secondary" vehicle,¹ and then argued that alternative prior art not relied upon could be used to support the Board's Decision.

The panel affirmed the Board's Decision without providing an opinion, citing Rule 36. Thus, Waterblasting is now prevented from addressing the panel's specific rationale for the affirmance. Nevertheless, the Director has conceded that the grounds on which the Board based its Decision were error.

IV. ARGUMENT

A. The Supreme Court's Decision in *Chenery* and This Court's Precedent in *Zurko* Required the Panel to Reverse the Board's Decision.

The Director conceded that the grounds the Board used to reach the Decision were incorrect, requiring the panel to reverse the Decision under *Chenery*. In *Chenery*, the Supreme Court explained that "[t]he grounds upon which an administrative order must be judged are those upon which the record discloses that its action was based." 318 U.S. at 87. This fundamental rule for review of agency decisions is contrasted

¹ Oral argument recording at 12:25–17:20, http://oralarguments.cafc.uscourts.gov/default.aspx?fl=19-2423_11042020.mp3; *see, e.g.* ("the two systems are complete systems, that is true. . . . So it's true that [both the NLB StarJet and StripeJet] are both complete systems, but they are different. . . . The NLB reference talks about two different vehicles, the truck and the tractor. It doesn't talk about connecting the two. . . . (Judge Bryson) [The StarJet and StripeJet] are not connected, right? (Ms. Dang) That's correct. (Judge Bryson) There's no place in which it suggests that you could put them together? (Ms. Dang) Not in the NLB reference, no.")

with review of orders from Article III courts. *Id.* at 88. When an appellate court reviews a decision from a district court, it will “affirm[] if the result is correct ‘although the lower court relied upon a wrong ground or gave a wrong reason.’” *Ibid.* (quoting *Helvering v. Gowan*, 302 U.S. 238, 245 (1937)).

Presented with a similar situation in *Zurko*, this Court applied *Chenery* where the Commissioner of Patents conceded that the prior art references relied upon by the Board for the obviousness determination did not, in fact, teach the limitation as found by the Board. 258 F.3d 1385. There, like here, the “Commissioner maintain[ed] that the Board’s findings concerning the content of the prior art are supported by four other references in the record.” *Ibid.* The Commissioner argued to this Court that the finding that the prior art disclosed the claimed limitation was still supported by substantial evidence because the other references—not relied on by the Board—still disclosed that limitation. *Ibid.* Therefore, the Commissioner argued, the ultimate conclusion of obviousness could still be affirmed. *Ibid.*

This Court rejected the Commissioner’s arguments, reversing the determination and holding that “[t]he Board’s conclusion of obviousness was based on a misreading of the references relied upon, and therefore, lacks substantial evidence support.” *Id.* at 1386. As the Court explained, the Board’s conclusion was based on the finding being in the relied-upon references, and it was not appropriate to substitute the Board’s findings for other grounds on appeal. *Id.* at 1385. Doing so “would constitute a new ground of rejection, not considered or relied upon by the Examiner

or the Board. It is well settled that it would be inappropriate for us to consider such a new ground of rejection.” *Ibid.* (citing first *In re Margolis*, 785 F.2d 1029, 1032 (Fed. Cir. 1986); then citing *Koyo Seiko Co., Ltd. v. United States*, 95 F.3d 1094, 1099 (Fed. Cir. 1996) (quoting *Chenery*, 318 U.S. at 87)). As prior precedent of this Court, *Zurko* would require the same result in this case, i.e., reversing the Board’s obviousness determination after the Director conceded the prior art did not disclose the limitation relied upon by the Board for its Decision. *See Newell Cos., Inc. v. Kenney Mfg. Co.*, 864 F.2d 757, 765 (Fed. Cir. 1988) (“This court has adopted the rule that prior decisions of a panel of the court are binding precedent on subsequent panels unless and until overturned *in banc.*”), *cert. denied*, 493 U.S. 814 (1989).

The Board’s error was “harmful” because it was necessary to the substance of the Board’s Decision and required by the IPR procedure. In *In re Watts*, 354 F.3d 1362 (Fed. Cir. 2004) this Court addressed the requirements of *Chenery* and the ability to deviate from strict application of *Chenery* based on “harmless error.” *Id.* at 1369-70. There, the appellant argued that the Court could not affirm the Board based on a substituted reference in the obviousness determination. *Id.* at 1369. The Court explained that while “in general the Board’s decision must be affirmed, if at all, on the reasons stated therein, *see [SEC v. Chenery Corp.*, 322 U.S. 194, 196 (1974) (“*Chenery I*”)], this principle does not obviate the need to consider the issue of harmless error or mechanically compel reversal ‘when a mistake of the administrative body is one that clearly had no bearing on the procedure used or the substance of the decision

reached,’ *Mass. Trs. of E. Gas & Fuel Ass’ns v. United States*, 377 U.S. 235, 248 (1964).” *Watts*, 354 F.3d at 1370 (citing cases). “In each of [this Court’s] cases refusing to consider new prior art rejections on appeal there was reason to believe that the ‘procedure used or the substance of the decision reached,’ *Mass. Trs.*, 377 U.S. at 248, by the Board might have been different upon remand.” *Watts*, 354 F.3d at 1370. Here, however, the Board’s Decision necessarily required that specific finding, which the Director now concedes was incorrect.

Further, the IPR procedure demonstrates that the error was not “harmless”; the Board was confined to only addressing the grounds in the petition, which included this argument, and it could not have deviated from the petition and find the claims obvious based on alternate prior art references or arguments. “Under 35 U.S.C. § 311(a), a party may seek inter partes review by filing ‘a petition to institute an inter partes review.’ The Supreme Court has explained that this language does not ‘contemplate a petition that asks the Director to initiate whatever kind of inter partes review he might choose.’” *Koninklijke Philips N.V. v. Google LLC*, 948 F.3d 1330, 1335 (Fed. Cir. 2020) (quoting *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1355 (2018)). As this Court and the Supreme Court have explained, in an IPR it is the “petitioner, not the Director, who gets to define the contours of the proceeding.” *SAS*, 138 S. Ct. at 1355; *Philips*, 948 F.3d at 1335 (quoting same).

In *Philips*, this Court explained that “[a]lthough the Board is not limited by the exact language of the petition, see, e.g., *Sirona Dental Sys. GmbH v. Institut Straumann AG*,

892 F.3d 1349, 1356 (Fed. Cir. 2018), the Board does not ‘enjoy[] a license to depart from the petition and institute a *different* inter partes review of its own design.’” 948 F.3d at 1336 (quoting *SAS*, 138 S. Ct. at 1356) (emphasis in *Philips*). This Court concluded that the Board erred by instituting a combination of prior art references that were not advanced in the petition. *Id.* at 1336. Here, the Board’s Decision was based on the petition and it could not have deviated to the alternative arguments raised by the Director at the oral argument after conceding the grounds the Board relied on were incorrect.

The panel was required to affirm, if at all, only on the basis that the Board used to reach its decision. *Chenery*, 318 U.S. at 87; *Chenery II*, 332 U.S. at 196; *Zurko*, 258 F.3d at 1385-88. The panel could only deviate from affirming on the same grounds as the Board if the error were harmless, but that would require the Board to have been free to adopt those alternate grounds on remand. *See Watts*, 354 F.3d at 1370. But because the IPR proceedings are strictly limited by the grounds in the petition, the Board could not have adopted the Director’s alternate obviousness arguments based on evidence and prior art not advanced in the petition. *See Philips*, 948 F.3d at 1335-36. Accordingly, compliance with *Chenery* and this Court’s prior precedent requires vacating the panel’s affirmance and reversing the Board’s Decision.

The Court should therefore grant rehearing or rehearing *en banc* to address the issues raised herein. The Board’s Decision should be reversed, and the case remanded for the Board to address the remaining grounds that it has not yet reached.

B. Section 144 Requires This Court to Issue an Opinion When Reviewing an Appeal From the Patent Office.

When this Court reviews appeals from the Patent and Trademark Office, Congress has provided: “Upon its determination the court shall issue to the Director its mandate and opinion, which shall be entered of record in the Patent and trademark Office and shall govern the further proceedings in the case.” 35 U.S.C. § 144 (2018 ed.); *accord* Act of 1984, Pub. L. 98-620, title IV, § 414(a), 98 Stat. 3363-64 (with conforming amendments). Congress’s express direction with this law—the mandatory language to issue an opinion—deviates from the ordinary review process. Indeed, searching the U.S. Code reveals only three (3) laws which address appellate courts which state the court “shall issue” an opinion: 35 U.S.C. § 144, regarding to this Court’s review of patent decisions from the USPTO; 15 U.S.C. § 1071, regarding to this Court’s review of trademark decisions from the USPTO; and 8 U.S.C. § 1535(c)(4)(B), regarding expedited appeals in certain immigration removal proceedings.

The language of the statute, “shall issue to the Director its mandate *and opinion*” requires an opinion to be issued to the Director. 35 U.S.C. § 144 (2018 ed.) (emphasis added); Pub. L. 98-620, title IV, § 414(a), 98 Stat. 3363-64. The first step in construing a statute is to look to the words written. *See, e.g., Marx v. Gen. Revenue Corp.*, 568 U.S. 371, 376 (2013) (Thomas, J.) (“As in all statutory construction cases, [the Court] ‘assum[es] that the ordinary meaning of the statutory language accurately

expresses the legislative purpose.”); *Romag Fasteners, Inc. v. Fossil Grp., Inc.*, 140 S. Ct. 1492, 1495 (2020) (Gorsuch, J.) (analyzing the Lanham Act by starting with the statutory language); *Bostock v. Clayton Cty.*, 140 S. Ct. 1731, 1337 (2020) (Gorsuch, J.) (“When the express terms of a statute give us one answer and extratextual considerations suggest another, it’s no contest. Only the written word is the law, and all persons are entitled to its benefit.”). Here, the express language chosen by Congress requires this Court to issue an “opinion” to the Director. 35 U.S.C. § 144.

The history of § 144 and the Rules of Appellate Procedure confirm this understanding. In the Patent Act of 1952 Congress provided the means for appealing to the Court of Customs and Patent Appeals from an adverse decision at the Patent Office, stating that “Upon its determination the [CCPA] shall return to the Commissioner ***a certificate of its proceedings and decision***, which shall be entered of record in the Patent Office and govern the further proceedings in the case.” Pub. L. 593, July 19, 1952, ch. 13, § 144, 66 Stat. 792, 802-03 (emphasis added); 35 U.S.C. § 144 (1958 ed.). Then in 1968 the Federal Rules of Appellate Procedure were put into effect, which included Rule 36, allowing “a judgment [to be] rendered without an opinion,” *see, e.g., United States v. Baynes*, 548 F.2d 481, 482-83 (3d Cir. 1977) (quoting Rule 36); *Furman v. United States*, 720 F.2d 263, 264 (2d Cir. 1983) (same), and Rule 41, *defining* that “[a] certified copy of the judgment *and a copy of the opinion of the court, if any*, and any direction as to costs shall constitute the mandate, unless the court directs that

a formal mandate issue,” *see* Advisory Committee on Appellate Rules, Washington, D.C., April 20-21, page 46 (“1993 Proposed Amendments”) (emphasis added).

Against the backdrop of Rule 36 allowing for judgments “without opinion” when unless the Rule would be inconsistent with Acts of Congress, *see* 28 U.S.C. § 2071, and “mandate” defined to include “the opinion of the court, if any,” *see* Fed. R. App. P. 41 (1970 ed.), *see also* 1993 Proposed Amendment, in 1984 Congress amended the law addressing this Court’s review of appeals from the USPTO, and requiring this Court to issue “its mandate *and opinion*.” Pub. L. 98-620, title IV, § 414(a), 98 Stat. 3363 (emphasis added); *accord* 35 U.S.C. § 144 (1988 ed.). The rules of statutory construction make clear the use of “and opinion” requires this Court to issue an opinion; it is superfluous otherwise, since “mandate” already includes the opinion “if any”, and “[t]he rules of statutory construction require a reading that avoids rendering superfluous any provision of a statute.” *See Ishida v. United States*, 59 F.3d 1224, 1230 (Fed. Cir. 1995) (citing *Ratzlaf v. United States*, 114 S. Ct. 655, 659 (1994) (Ginsburg, J.)); *accord TRW Inc. v. Andrews*, 534 U.S. 19, 31 (2001) (Ginsburg, J.) (“It is ‘a cardinal principle of statutory construction’ that ‘a statute ought, upon the whole, to be so construed that, if it can be prevented, no clause, sentence, or word shall be superfluous, void, or insignificant.”) (quoting *Duncan v. Walker*, 533 U.S. 167, 174 (2001) (O’Connor, J.)).

This requirement is consistent with the statutory scheme Congress has created to address patent rights. Beyond simply providing the right to appeal under the APA,

see 5 U.S.C. § 702, Congress provided for appellate review in this Court, 35 U.S.C. § 319. Further, in finding the inter partes review process constitutional, the Supreme Court expressly noted that it provides for judicial review by this Court and therefore did not consider whether it would be constitutional absent this Article III review. *Oil States Energy Servs., LLC v. Greene's Energy Grp., LLC*, 138 S. Ct. 1365, 1379 (2018) (Thomas, J.).

Congress's express requirement that this Court issues opinions in cases from the USPTO is consistent with the statutory review provision for IPRs, 35 U.S.C. § 319, the statutory review right under the APA, 5 U.S.C. § 702, and the strong presumption of judicial review, *see Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016). Accordingly, § 144 should be interpreted consistent with its clear language and the panel's issuance of an affirmance *without* opinion is inconsistent with the law.

CONCLUSION AND STATEMENT OF RELIEF SOUGHT

Panel rehearing or rehearing en banc should be granted to address the conflict between the panel's Rule 36 affirmance of the Board's Decision and the precedent in at least *Chenery* and *Zurko*. Because the grounds upon which the Board made its Decision have been conceded by Director as incorrect, the Board's Decision was required by precedent to be reversed. Further, rehearing should be granted to address

the requirement that this Court issue an opinion when reviewing an appeal from the Patent Office under 35 U.S.C. § 144.

December 21, 2020

Respectfully submitted,

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NOTE: This disposition is nonprecedential.

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

WATERBLASTING, LLC,
Appellant

v.

**ANDREI IANCU, UNDER SECRETARY OF
COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES
PATENT AND TRADEMARK OFFICE,**
Intervenor

2019-2423

Appeal from the United States Patent and Trademark Office, Patent Trial and Appeal Board in No. IPR2018-00504.

JUDGMENT

ANDREW D. LOCKTON, McHale & Slavin, P.A., Palm Beach Gardens, FL, argued for appellant. Also represented by EDWARD F. MCHALE.

MAI-TRANG DUC DANG, Office of the Solicitor, United States Patent and Trademark Office, Alexandria, VA, argued for intervenor. Also represented by THOMAS W.

KRAUSE, FARHEENA YASMEEN RASHEED, MEREDITH HOPE
SCHOENFELD.

THIS CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

PER CURIAM (PROST, *Chief Judge*, BRYSON and
STOLL, *Circuit Judges*).

AFFIRMED. See Fed. Cir. R. 36.

ENTERED BY ORDER OF THE COURT

November 6, 2020
Date

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

792

PUBLIC LAW 593—JULY 19, 1952

[66 STAT.]

Public Law 593

CHAPTER 950

AN ACT

July 19, 1952
[H.R. 7794]

To revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents".

Title 35, U.S.
Code.
Codification and
enactment into
law.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That title 35 of the United States Code, entitled "Patents", is revised, codified, and enacted into law, and may be cited, "Title 35, United States Code, section—", as follows:

TITLE 35—PATENTS

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PART I—PATENT OFFICE

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CHAPTER 1—ESTABLISHMENT, OFFICERS, FUNCTIONS

Sec.

1. Establishment.
2. Seal.
3. Officers and employees.
4. Restrictions on officers and employees as to interest in patents.
5. Bond of Commissioner and other officers.
6. Duties of Commissioner.
7. Board of Appeals.
8. Library.
9. Classification of patents.
10. Certified copies of records.
11. Publications.
12. Exchange of copies of patents with foreign countries.
13. Copies of patents for public libraries.
14. Annual report to Congress.

§ 1. Establishment

The Patent Office shall continue as an office in the Department of Commerce, where records, books, drawings, specifications, and other papers and things pertaining to patents and to trade-mark registrations shall be kept and preserved, except as otherwise provided by law.

§ 2. Seal

The Patent Office shall have a seal with which letters patent, certificates of trade-mark registrations, and papers issued from the Office shall be authenticated.

§ 3. Officers and employees

A Commissioner of Patents, one first assistant commissioner, two assistant commissioners, and nine examiners-in-chief, shall be appointed by the President, by and with the advice and consent of the Senate. The assistant commissioners shall perform the duties pertaining to the office of commissioner assigned to them by the Commissioner. The first assistant commissioner, or, in the event of a vacancy in that office, the assistant commissioner senior in date of appointment, shall fill the office of Commissioner during a vacancy in that office until a Commissioner is appointed and takes office. The

the final refusal by the Patent Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent Office.

A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

CHAPTER 13—REVIEW OF PATENT OFFICE DECISION

Sec.

141. Appeal to Court of Customs and Patent Appeals.

142. Notice of appeal.

143. Proceedings on appeal.

144. Decision on appeal.

145. Civil action to obtain patent.

146. Civil action in case of interference.

§ 141. Appeal to Court of Customs and Patent Appeals

An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Customs and Patent Appeals, thereby waiving his right to proceed under section 145 of this title. A party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority may appeal to the United States Court of Customs and Patent Appeals, but such appeal shall be dismissed if any adverse party to such interference, within twenty days after the appellant has filed notice of appeal according to section 142 of this title, files notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 146 of this title. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under section 146, in default of which the decision appealed from shall govern the further proceedings in the case.

§ 142. Notice of appeal

When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, and shall file in the Patent Office his reasons of appeal, specifically set forth in writing, within such time after the date of the decision appealed from, not less than sixty days, as the Commissioner appoints.

§ 143. Proceedings on appeal

The United States Court of Customs and Patent Appeals shall, before hearing such appeal, give notice of the time and place of the hearing to the Commissioner and the parties thereto. The Commissioner shall transmit to the court certified copies of all the necessary original papers and evidence in the case specified by the appellant and any additional papers and evidence specified by the appellee and in an ex parte case the Commissioner shall furnish the court with the grounds of the decision of the Patent Office, in writing, touching all the points involved by the reasons of appeal.

§ 144. Decision on appeal

The United States Court of Customs and Patent Appeals, on petition, shall hear and determine such appeal on the evidence produced before the Patent Office, and the decision shall be confined to the points set forth in the reasons of appeal. Upon its determination the court

shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and govern the further proceedings in the case.

§ 145. Civil action to obtain patent

An applicant dissatisfied with the decision of the Board of Appeals may unless appeal has been taken to the United States Court of Customs and Patent Appeals, have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant.

§ 146. Civil action in case of interference

Any party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority, may have remedy by civil action, if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints or as provided in section 141 of this title, unless he has appealed to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided. In such suits the record in the Patent Office shall be admitted on motion of either party upon the terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of the parties to take further testimony. The testimony and exhibits of the record in the Patent Office when admitted shall have the same effect as if originally taken and produced in the suit.

Such suit may be instituted against the party in interest as shown by the records of the Patent Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs. The Commissioner shall not be a necessary party but he shall be notified of the filing of the suit by the clerk of the court in which it is filed and shall have the right to intervene. Judgment of the court in favor of the right of an applicant to a patent shall authorize the Commissioner to issue such patent on the filing in the Patent Office of a certified copy of the judgment and on compliance with the requirements of law.

CHAPTER 14—ISSUE OF PATENT

Sec.

- 151. Time of issue of patent.
- 152. Issue of patent to assignee.
- 153. How issued.
- 154. Contents and term of patent.

§ 151. Time of issue of patent

The patent shall issue within three months from the date of the payment of the final fee, which shall be paid not later than six months after written notice to the applicant of allowance of the application,

PUBLIC LAW 98-620—NOV. 8, 1984

98 STAT. 3335

Public Law 98-620
98th Congress

An Act

To amend title 28, United States Code, with respect to the places where court shall be held in certain judicial districts, and for other purposes.

Nov. 8, 1984
[H.R. 6163]

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled.

TITLE I

Trademark
Clarification Act
of 1984.

SHORT TITLE

SEC. 101. This title may be cited as the "Trademark Clarification Act of 1984".

15 USC 1051
note.

AMENDMENT TO THE TRADEMARK ACT

SEC. 102. Section 14(c) of the Trademark Act of 1946, commonly known as the Lanham Trademark Act (15 U.S.C. 1064(c)) is amended by adding before the semicolon at the end of such section a period and the following: "A registered mark shall not be deemed to be the common descriptive name of goods or services solely because such mark is also used as a name of or to identify a unique product or service. The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the common descriptive name of goods or services in connection with which it has been used".

DEFINITIONS

SEC. 103. Section 45 of such Act (15 U.S.C. 1127) is amended as follows:

(1) Strike out "The term 'trade-mark' includes any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others." and insert in lieu thereof the following: "The term 'trademark' includes any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify and distinguish his goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown."

(2) Strike out "The term 'service mark' means a mark used in the sale or advertising of services to identify the services of one person and distinguish them from the services of others." and insert in lieu thereof the following: "The term 'service mark' means a mark used in the sale or advertising of services to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown."

98 STAT. 3362

PUBLIC LAW 98-620—NOV. 8, 1984

28 USC 124. SEC. 407. (a) Subsection (b) of section 124 of title 26, United States Code, is amended—
 (1) by striking out “six divisions” and inserting in lieu thereof “seven divisions”;
 (2) in paragraph (4) by striking out “, Hidalgo, Starr,”; and
 (3) by adding at the end thereof the following:
 “(7) The McAllen Division comprises the counties of Hidalgo and Starr.

28 USC 124 note. “Court for the McAllen Division shall be held at McAllen.”
 (b) The amendments made by subsection (a) of this section shall apply to any action commenced in the United States District Court for the Southern District of Texas on or after the effective date of this subtitle, and shall not affect any action pending in such court on such effective date.

SEC. 408. (a) Paragraph (1) of section 90(a) of title 28, United States Code, is amended—
 (1) by inserting “Fannin,” after “Dawson,”;
 (2) by inserting “Gilmer,” after “Forsyth,”; and
 (3) by inserting “Pickens,” after “Lumpkin,”.

(b) Paragraph (2) of section 90(a) of title 28, United States Code, is amended by striking out “Fannin,” “Gilmer,” and “Pickens,”.

(c) Paragraph (6) of section 90(c) of title 28, United States Code, is amended by striking out “Swainsboro” each place it appears and inserting in lieu thereof “Statesboro”.

28 USC 90 note. (d) The amendments made by this section shall apply to any action commenced in the United States District Court for the Northern District of Georgia on or after the effective date of this subtitle, and shall not affect any action pending in such court on such effective date.

SEC. 409. Section 85 of title 28, United States Code, is amended by inserting “Boulder,” before “Denver”.

SEC. 410. The second sentence of section 126 of title 28, United States Code, is amended by inserting “Bennington,” before “Brattleboro”.

Effective date. 28 USC 85 note. SEC. 411. (a) The amendments made by this subtitle shall take effect on January 1, 1985.

(b) The amendments made by this subtitle shall not affect the composition, or preclude the service, of any grand or petit jury summoned, impaneled, or actually serving on the effective date of this subtitle.

Technical Amendments to the Federal Courts Improvement Act of 1982. 28 USC 1 note.

SUBTITLE C—AMENDMENTS TO THE FEDERAL COURTS IMPROVEMENTS ACT OF 1982

This subtitle may be cited as the “Technical Amendments to the Federal Courts Improvement Act of 1982”.

SEC. 412. (a) Section 1292(b) of title 28, United States Code, is amended by inserting “which would have jurisdiction of an appeal of such action” after “The Court of Appeals”.

(b) Section 1292(c)(1) of title 28, United States Code, is amended by inserting “or (b)” after “(a)”.

SEC. 413. Section 337(c) of the Tariff Act of 1930 (19 U.S.C. 1337(c)) is amended in the fourth sentence by inserting “, within 60 days after the determination becomes final,” after “appeal such determination”.

SEC. 414. (a) Sections 142, 143, and 144 of title 35, United States Code, are amended to read as follows:

PUBLIC LAW 98-620—NOV. 8, 1984

98 STAT. 3363

“§ 142. Notice of appeal

35 USC 142.

“When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the Patent and Trademark Office a written notice of appeal directed to the Commissioner, within such time after the date of the decision from which the appeal is taken as the Commissioner prescribes, but in no case less than 60 days after that date.

“§ 143. Proceedings on appeal

35 USC 143.

“With respect to an appeal described in section 142 of this title, the Commissioner shall transmit to the United States Court of Appeals for the Federal Circuit a certified list of the documents comprising the record in the Patent and Trademark Office. The court may request that the Commissioner forward the original or certified copies of such documents during pendency of the appeal. In an ex parte case, the Commissioner shall submit to the court in writing the grounds for the decision of the Patent and Trademark Office, addressing all the issues involved in the appeal. The court shall, before hearing an appeal, give notice of the time and place of the hearing to the Commissioner and the parties in the appeal.

“§ 144. Decision on appeal

35 USC 144.

“The United States Court of Appeals for the Federal Circuit shall review the decision from which an appeal is taken on the record before the Patent and Trademark Office. Upon its determination the court shall issue to the Commissioner its mandate and opinion, which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case.”

(b) Paragraphs (2), (3), and (4) of subsection (a) of section 21 of the Act entitled “An Act to provide for the registration and protection of trademarks used in commerce, to carry out the provisions of certain international conventions, and for other purposes”, approved July 5, 1946 (15 U.S.C. 1071(a) (2), (3), and (4)), are amended to read as follows:

“(2) When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the Patent and Trademark Office a written notice of appeal directed to the Commissioner, within such time after the date of the decision from which the appeal is taken as the Commissioner prescribes, but in no case less than 60 days after that date.

“(3) The Commissioner shall transmit to the United States Court of Appeals for the Federal Circuit a certified list of the documents comprising the record in the Patent and Trademark Office. The court may request that the Commissioner forward the original or certified copies of such documents during pendency of the appeal. In an ex parte case, the Commissioner shall submit to that court a brief explaining the grounds for the decision of the Patent and Trademark Office, addressing all the issues involved in the appeal. The court shall, before hearing an appeal, give notice of the time and place of the hearing to the Commissioner and the parties in the appeal.

“(4) The United States Court of Appeals for the Federal Circuit shall review the decision from which the appeal is taken on the record before the Patent and Trademark Office. Upon its determination the court shall issue its mandate and opinion to the Commis-

98 STAT. 3364

PUBLIC LAW 98-620—NOV. 8, 1984

sioner, which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case.”.

35 USC 142 note.

(c) The amendments made by this section shall apply to proceedings pending in the Patent and Trademark Office on the date of the enactment of this Act and to appeals pending in the United States Court of Appeals for the Federal Circuit on such date.

28 USC 713 note.

SEC. 415. Any individual who, on the date of the enactment of the Federal Courts Improvement Act of 1982, was serving as marshal for the Court of Appeals for the District of Columbia under section 713(c) of title 28, United States Code, may, after the date of the enactment of this Act, so serve under that section as in effect on the date of the enactment of the Federal Courts Improvement Act of 1982. While such individual so serves, the provisions of section 714(a) of title 28, United States Code, shall not apply to the Court of Appeals for the District of Columbia.

SEC. 416. Title 28, United States Code, is amended in the following respects:

(a) There shall be inserted, after section 797 thereof, in chapter 51 thereof, the following new section 798, which shall read as follows:

28 USC 798.

“§ 798. Places of holding court; appointment of special masters

“(a) The United States Claims Court is hereby authorized to utilize facilities and hold court in Washington, District of Columbia, and in four locations outside of the Washington, District of Columbia metropolitan area, for the purpose of conducting trials and such other proceedings as may be appropriate to executing the court’s functions. The Director of the Administrative Office of the United States Courts shall designate such locations and provide for such facilities.

“(b) The chief judge of the Claims Court may appoint special masters to assist the court in carrying out its functions. Any special masters so appointed shall carry out their responsibilities and be compensated in accordance with procedures set forth in the rules of the court.”.

(b) The caption of chapter 51, title 28, shall be amended to include the following item:

“798. Places of holding court; appointment of special masters.”.

**TITLE V—GOVERNMENT RESEARCH AND DEVELOPMENT
PATENT POLICY**

SEC. 501. Chapter 18 of title 35, United States Code, is amended—

35 USC 201.

(1) by adding “or any novel variety of plant which is or may be protectable under the Plant Variety Protection Act (7 U.S.C. 2321 et seq.)” immediately after “title” in section 201(d);

(2) by adding “: *Provided*, That in the case of a variety of plant, the date of determination (as defined in section 41(d) of the Plant Variety Protection Act (7 U.S.C. 2401(d))) must also occur during the period of contract performance” immediately after “agreement” in section 201(e);

Contracts with
U.S.
Grants.
35 USC 202.

(3) in section 202(a), by amending clause (i) to read as follows:

“(i) when the contractor is not located in the United States or does not have a place of business located in the United States or is subject to the control of a foreign government,”; by striking the word “or” before “ii”, and by adding after the words “security of such activities” in the first sentence of such para-

**ADVISORY COMMITTEE
ON
APPELLATE RULES**

Washington, D.C.

April 20-21, 1993

TENTATIVE AGENDA
MEETING OF THE ADVISORY COMMITTEE ON APPELLATE RULES
APRIL 20 & 21, 1993

- I. RECONSIDERATION OF THE PUBLISHED RULES IN LIGHT OF THE COMMENTS SUBMITTED CONCERNING THEM.
- A. Item 86-10. The proposed amendment to Rule 38 affords an appellant notice and opportunity to respond before damages or costs are assessed for filing a frivolous appeal.
 - B. Item 91-2. Proposed amendments to Rules 40 and 41 lengthen the time for filing a petition for rehearing in civil cases involving the United States.
 - C. Item 91-4. Several amendments to Rule 32, governing the form of documents, were proposed and published.
 - D. Item 91-5. Rule 49 is a proposed new rule authorizing the use of special masters in the courts of appeals.
 - E. Item 91-8. The proposed amendment to Rule 25 provides that whenever service is accomplished by mailing, the proof of service shall include the addresses to which the papers were mailed.
 - F. Item 91-9. The proposed amendment to Rule 32 requires counsel to include their telephone numbers on the covers of briefs and appendices.
 - G. Item 91-11. The proposed amendment to Rule 25 provides that a clerk may not refuse to file a paper solely because the paper is not presented in the proper form.
 - H. Item 91-12. Rule 33, governing appeal conferences, was completely rewritten.
 - I. Item 91-13. The proposed amendments to Rule 41 provided that a motion for stay of mandate must show that a petition for certiorari would present a substantial question and that there is good cause for a stay.
 - J. Item 91-22. Rule 9 governing review of a release decision in a criminal case was completely rewritten and published for comment.
 - K. Item 91-26. The proposed amendment to Rule 28 requires a brief to contain a summary of argument.
 - L. Item 91-27. This item was a proposal to amend all pertinent appellate rules regarding the number of copies

of documents that must be filed with a court of appeals. Item 91-27 resulted in publication of amendments to the following rules:

1. Rule 3
2. Rule 5
3. Rule 5.1
4. Rule 13
5. Rule 25
6. Rule 26.1
7. Rule 27
8. Rule 30
9. Rule 31
10. Rule 35

IX. ITEMS REMANDED TO THE ADVISORY COMMITTEE BY THE STANDING COMMITTEE

- A. Items 89-5 and 90-1. A proposed amendment to Rule 35 was submitted to the Standing Committee at its July 1992 meeting. The proposed amendment added language to Rule 35 making it clear that the filing of a suggestion for rehearing in banc does not toll the time for filing a petition for certiorari. The Standing Committee did not approve the proposal for publication. Instead, the Standing Committee asked the Advisory Committee to reconsider an amendment that would treat a suggestion for rehearing in banc like a petition for panel rehearing. The result of such a change would be that a suggestion for a rehearing in banc would also suspend the finality of the court's judgment and thus toll the time for filing a petition for certiorari.
- B. Item 91-14. A proposed amendment to Rule 21 was submitted to the Standing Committee at its December 1992 meeting. The proposal provided that a petition for mandamus should not bear the name of the judge and that the judge would be represented pro forma by the party opposing the relief. The Standing Committee did not approve the proposal for publication. Instead, the Standing Committee asked the Advisory Committee to consider further amendment of Rule 21 to make it clear that a mandamus action really is an interparties proceeding like an appeal.
- C. Item 92-1. The proposal is to amend Rule 47 to require that local rules follow a uniform numbering system and delete repetitious language. Uniform language was developed at the December meeting by a subcommittee consisting of Chairs and Reporters of all the Advisory Committees. The Standing Committee has asked that each of the Advisory Committees integrate the language into its rules and submit the proposed amendments at the July meeting.

It is anticipated that this matter will be submitted to the Committee for a mail vote in advance of the meeting.

- D. Item 92-2. The proposal is to permit technical amendment of the national rules without need for Supreme Court of Congressional Review. Uniform language was developed at the December meeting by a subcommittee consisting of the Chairs and Reporters of all the Advisory Committees. The Standing Committee has asked that each of the Advisory Committees integrate the language into its rules and submit the proposed amendments at the July Meeting. It is anticipated that this matter will be submitted to the Committee for a mail vote in advance of the meeting.
- E. Item 92-10. The Committee must reconsider some of the language of amended Rule 4(a)(4). When the Standing Committee approved the publication of the proposed amendments to the Bankruptcy Rules that parallel the changes in 4(a)(4), the Standing Committee asked the Advisory Committee on Appellate Rules to reconsider one particular phrase in the amendments and to report back at the June meeting.

III. ACTION ITEMS

- A. Item 86-23, concerning the receipt of mail by institutionalized persons.
- B. Items 86-24 and 92-8, concerning sanctions under Rule 38. A subcommittee consisting of Judges Boggs, Mr. Froeb, Judge Hall, and Mr. Munford has been asked to consider these items and lead the discussion.
- C. Item 91-28, amendment of Rule 27 to update motions practice.
- D. Item 92-3, examine Rule 4(b) in light of § 3731.
- E. Item 92-4, amendment of Rule 35 to include intercircuit conflict as a ground for seeking a rehearing in banc.
- F. Item 92-5, amendment of Rule 25 concerning the "most expeditious form of delivery except special delivery."
- G. Item 92-6, amendment of Rule 25 to eliminate the mailbox rule for a brief or appendix.
- H. Item 92-7, amendment of Rule 30(a)(3) to require that a copy of a notice of appeal be included in an appendix.
- I. Item 92-9, amendment of Rule 10(b)(1) to conform to Rule 4(a)(4).

IV. DISCUSSION ITEMS

- A. Item 91-3, defining a final decision by rule and expanding by rule the instances in which an interlocutory decision may be appealed.
- B. Item 91-6, concerning the allocation of word processing equipment costs between producing originals and producing copies.
- C. Item 91-15, uniform effective date for local rules.
- D. Item 91-17, unpublished opinions.
- E. Item 92-11, consideration of local rules that do not exempt government attorneys from joining a court bar or from paying admission fees.

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TO: Honorable Kenneth F. Ripple, Chair
Members of the Advisory Committee on Appellate Rules and
Liaison Members

FROM: Carol Ann Mooney, Reporter 

DATE: April 9, 1993

SUBJECT: GAP Report concerning the proposed amendments published
January 1993

In January 1993, the Standing Committee published a packet of proposed amendments to the Fed. R. App. P. The period for public comment closes on April 15. At the Advisory Committee's meeting on April 20 and 21 the Committee must consider all the comments and decide if any amendments should be made in the published rules. If the Committee decides to make amendments, the Committee has the further task of deciding whether the amendments are substantial. If substantial amendments are made, it is necessary to republish the rule(s). If only minor amendments are made, republication is not necessary.

I have prepared materials dealing with all the comments received to date. There are not many. In addition to the comments received as a result of publication, I have received some "internal" comments; they are from Mr. Spaniol, Mr. Kopp, and Mr. Munford, a new member of the Advisory Committee.

As you can see from the agenda prepared for the meeting, we will consider the proposed rules in order of their advisory committee item number.

In addition to the specific comments summarized in the following pages, two general comments were received.

1. A practitioner, Mr. Green, opposes the change from "shall" to "must." He points out that unless Congress is also making the same changes, the rules and statutes will use different terminology to refer to the same thing. He also points out that the use of must is inconsistent even in the proposed rules; in some places the proposed rules use shall and in others must. As you know, the change is advocated by the Style Subcommittee. At the time of drafting these amendments the Style Subcommittee asked that "must" be used with the passive voice and "shall" with the active voice. That directive has now been changed, and "must" must be used in all instances. Throughout the amended drafts must has been changed to shall except in those instances where it is used to indicate the future tense.
2. Mr. Munford questions the wisdom of citing specific local rules in the Committee Notes. He points out not only that local rules change frequently, but also that the purpose of an

amendment in some instances is to supplant the local rule. He suggests referring generally to "local rules of the First, Sixth, and Eighth Circuits" rather than citing to specific rules. The revised drafts attached to this memorandum still contain citations to the local rules but if the Committee decides they should be removed, that can be easily accomplished.

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1 Rule 41. Issuance of Mandate; Stay of Mandate

2 (a) Date of Issuance. -- The mandate of the court shall
3 must issue ~~21~~ 7 days after the entry of judgment expiration of
4 the time for filing a petition for rehearing unless such a
5 petition is filed or the time is shortened or enlarged by order.

6 A certified copy of the judgment and a copy of the opinion of the
7 court, if any, and any direction as to costs shall constitute the
8 mandate, unless the court directs that a formal mandate issue.

9 The timely filing of a petition for rehearing will stay the
10 mandate until disposition of the petition unless otherwise
11 ordered by the court. If the petition is denied, the mandate
12 ~~shall~~ must issue within 7 days after entry of the order denying
13 the petition unless the time is shortened or enlarged by order.

14 (b) Stay of Mandate Pending ~~Application~~ Petition for
15 Certiorari.--~~A stay of mandate pending application to the Supreme~~
16 ~~Court for a writ of certiorari may be granted upon motion,~~
17 ~~reasonable notice of which shall be given to all parties. A~~
18 party who files a motion requesting a stay of mandate pending
19 petition to the Supreme Court for a writ of certiorari must file,
20 at the same time, proof of service on all other parties. The
21 motion must show that a petition for certiorari would present a
22 substantial question and that there is good cause for a stay.

23 The stay shall cannot exceed 30 days unless the period is
24 extended for cause shown. ~~If or unless~~ during the period of the
25 stay there is filed with the clerk of the court of appeals, a

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26 notice from the clerk of the Supreme Court is filed showing that
27 the party who has obtained the stay has filed a petition for the
28 writ ~~in that court,~~ in which case the stay ~~shall~~ will continue
29 until final disposition by the Supreme Court. ~~Upon the filing of~~
30 ~~a copy of an order of the Supreme Court denying the petition for~~
31 ~~writ of certiorari the mandate shall issue immediately.~~ The
32 court of appeals must issue the mandate immediately when a copy
33 of a Supreme Court order denying the petition for writ of
34 certiorari is filed. The court may require a bond or other
35 security ~~may be required~~ as a condition to the grant or
36 continuance of a stay of the mandate.

Committee Note

Subdivision (a). The amendment conforms Rule 41(a) to amendment made to Rule 40(a). The amendment keys the time for issuance of the mandate to the expiration of the time for filing a petition for rehearing, unless such a petition is filed in which case the mandate issues within 7 days after the entry of the order denying the petition. Because the amendment to Rule 40(a) lengthens the time for filing a petition for rehearing in civil cases involving the United States from 14 to 45 days, the rule requiring the mandate to issue 21 days after the entry of judgment would cause the mandate to issue while the government is still considering requesting a rehearing. Therefore, the amendment generally requires the mandate to issue 7 days after the expiration of the time for filing a petition for rehearing.

Subdivision (b). The amendment requires a party who files a motion requesting a stay of mandate to file, at the same time, proof of service on all other parties. The old rule required the party to give notice to the other parties; the amendment merely requires the party to provide the court with evidence of having done so.

The amendment also states that the motion must show that a petition for certiorari would present a substantial question and that there is good cause for a stay. The amendment is intended to alert the parties to the fact that a stay of mandate is not

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granted automatically and to the type of showing that needs to be made. The Supreme Court has established conditions that must be met before it will issue a mandate. See, e.g., Barnes v. E-Systems, Inc. Group Hospital Medical & Surgical Insurance Plan, 112 S.Ct. 1 (Scalia, Circuit Justice 1991).

PROOF OF SERVICE

I hereby certify that on December 21, 2020, I electronically filed the foregoing Appellant Waterblasting, LLC's Combined Petition for Panel Rehearing and/or Rehearing *En Banc* with the Clerk of the United States Court of Appeals for the Federal Circuit using the CM/ECF filing system, which would ordinarily send notice to all counsel of record and constitutes electronic service pursuant to Fed. Cir. R.

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CERTIFICATE OF COMPLIANCE

1. This brief complies with the type-volume limitation of Federal Rule of Appellate Procedure 35(b)(2)(A) because this brief contains 3,896 words, as counted by Microsoft Word, excluding the parts of this brief exempted by Federal Rule of Appellate Procedure 32(f) and Federal Circuit Rule 32(b)(2).

2. This brief complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) and the type style requirements of Federal Rule of Appellate Procedure 32(a)(6) because this brief has been prepared in a proportionally spaced typeface using Microsoft Word 2019 in 14-point, Garamond font.

December 21, 2020

/s/ Andrew D. Lockton

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