Nos. 2021-1614, -1616, -1617; 2021-1673, -1674, -1675; 2021-1676, -1677; 2021-1738, -1739; 2021-1740, -1741

United States Court of Appeals for the Federal Circuit

INTEL CORPORATION,

Appellant,

v.

VLSI TECHNOLOGY LLC,

Appellee,

ANDREW HIRSHFELD, Performing the Functions and Duties of the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office,

Intervenor.

2021-1614, -1616, -1617

Appeals from the United States Patent and Trademark Office, Patent Trial and Appeal Board in Nos. IPR2020-00106, IPR2020-00158, and IPR2020-00498

INTEL CORPORATION,

Appellant,

v.

VLSI TECHNOLOGY LLC,

Appellee,

ANDREW HIRSHFELD, Performing the Functions and Duties of the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office,

Intervenor.

2021-1673, -1674, -1675

Appeals from the United States Patent and Trademark Office, Patent Trial and Appeal Board in Nos. IPR2020-00112, IPR2020-00113, and IPR2020-00114

INTEL CORPORATION,

Appellant,

v.

VLSI TECHNOLOGY LLC,

Appellee,

ANDREW HIRSHFELD, Performing the Functions and Duties of the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office,

Intervenor.

2021-1676, -1677

Appeals from the United States Patent and Trademark Office, Patent Trial and Appeal Board in Nos. IPR2020-00141 and IPR2020-00142

INTEL CORPORATION,

Appellant,

v.

VLSI TECHNOLOGY LLC,

Appellee,

ANDREW HIRSHFELD, Performing the Functions and Duties of the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office,

Intervenor.

2021-1738, -1739

Appeals from the United States Patent and Trademark Office, Patent Trial and Appeal Board in Nos. IPR2020-00526 and IPR2020-00527

INTEL CORPORATION,

Appellant,

v.

VLSI TECHNOLOGY LLC,

Appellee,

ANDREW HIRSHFELD, Performing the Functions and Duties of the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office,

Intervenor.

2021-1740, -1741

Appeals from the United States Patent and Trademark Office, Patent Trial and Appeal Board in Nos. IPR2020-00582 and IPR2020-00583

BRIEF OF AMICUS CURIAE JEREMY C. DOERRE IN OPPOSITION TO APPELLANT INTEL CORPORATION'S COMBINED PETITION FOR PANEL REHEARING AND REHEARING EN BANC

August 9, 2021

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CERTIFICATE OF INTEREST

Counsel for Amicus Curiae Jeremy C. Doerre certifies the following:

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

   Jeremy C. Doerre

2. The name of any real party in interest represented by me (other than identified in question 3) is:

   Jeremy C. Doerre

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are:

   none

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:

   none

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 is (*See* Fed. Cir. R. 47. 4(a)(5) and 47.5(b)):

   The Appellant has indicated that the following cases are pending and may be directly affected by the present appeal.

   VLSI Technology LLC v. Intel Corp., No. 1:19-cv-00977 (W.D. Tex.)
   VLSI Technology LLC v. Intel Corp., No. 6:19-cv-00254 (W.D. Tex.)

VLSI Technology LLC v. Intel Corp., No. 6:19-cv-00255 (W.D. Tex.)

Counsel for Amicus is not aware of any other cases 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.

6. Any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees) is (*See* Fed. Cir. R. 47.4(a)(6)):

none

Dated: August 9, 2021

Respectfully submitted,

/s/ Jeremy C. Doerre

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RULE 29 STATEMENT

Amicus is a patent attorney whose only interest is in bringing relevant precedent and a potential constitutional question to the Court's attention. Amicus has no interest or stake in any party or in the outcome of this case, and no current client with a direct interest in the outcome of this case.

No party or counsel for a party: authored this brief in whole or in part or contributed money that was intended to fund preparing or submitting this brief. No person other than Amicus contributed money that was intended to fund preparing or submitting this brief.

By email, counsel for the Appellee indicated that the Appellee consents to filing of an amicus brief. By email, counsel for the Appellant indicated that the Appellant would not oppose a motion for leave to file an amicus brief. By email, counsel for the Intervenor indicated that the Intervenor would not oppose a motion for leave to file an amicus brief.

ARGUMENT

I. The Petition's desired interpretation of 28 U.S.C. § 1295 is contrary to an established CCPA interpretation presumptively adopted by Congress.

A. The CCPA interpreted the term 'decision of the Board' to not encompass decisions where the Board was acting only as an agent of the head of the Office and not in any statutory capacity.

28 U.S.C. § 1295 grants this Court jurisdiction over "an appeal from a decision of… the Patent Trial and Appeal Board … with respect to a[n] … inter partes review."

Congress has tasked "[t]he Director [with] determin[ing] whether to institute an inter partes review." 35 U.S.C. § 314. It seems unquestionable that 28 U.S.C. § 1295 does not provide this Court jurisdiction to review an institution determination made personally by the Director, as such a determination is clearly not "a decision of… the Patent Trial and Appeal Board." 28 U.S.C. § 1295.

Notably, though, "[t]he Director, by regulation, has delegated to the Board the authority under section 314 to decide whether to institute an inter partes review." *St. Jude Medical, Cardiology Division, Inc. v. Volcano Corp.*, 749 F.3d 1373, 1375 n.1 (Fed. Cir. 2014). Thus, in making an institution determination, the Board "is exercising the Director's section 314 authority," *Id.*, and acting "on behalf of the Director." 37 CFR § 42.4.

The Petition entreats this Court to interpret its grant of jurisdiction in 28 U.S.C. § 1295 over "an appeal from a decision of… the … Board" to encompass determinations issued by the Board on behalf of the Director.

However, this Court's predecessor court repeatedly held, in construing the term "decision of the Board" in earlier statutes, "that an acceptable 'decision', in the jurisdictional sense, refers to an action taken by the board, in a capacity[] provided for in the statutes," and excludes situations where "the board was acting only … as an agent of the [head of the Office] — and not in any statutory capacity." *In re James*, 432 F.2d 473, 475, 476 (C.C.P.A. 1970).

The Court of Customs and Patent Appeals (CCPA) first confronted this issue in an interference context, where "the law impose[d] upon the [head of the Office] the duty of determining whether an interference shall be declared… and… the power to dissolve the same," but he "delegated the power to act for him." *Sundback v. Blair*, 47 F.2d 378, 380 (C.C.P.A. 1931).

The Court made "clear that appeals can be taken to this court only from decisions which the Board of Appeals is specifically authorized by the statutes to make … and that any decisions not so authorized, but which are made under authority of the [head of the Office] to aid him in the performance of his duties, are not appealable to this court." *Id*.

In reaching its decision, the Court expressly construed the reference to a "decision of the board of appeals" in an earlier statute to "mean a decision of the Board of Appeals rendered by it in the performance of the duties expressly conferred upon it by statute, and … not include any decision rendered by it pursuant to any rule of the Patent Office conferring upon it a jurisdiction not expressly authorized by the statutes." *Id.* at 379, 380.

Over the next four decades, the CCPA had occasion "to reconsider its holding several times but [] never felt the need to alter it." *James*, 432 F.2d at 475. Instead, "in every case in which [the Court] discussed the meaning of that word, it [w]as [] concluded that an acceptable 'decision', in the jurisdictional sense, refers to an action taken by the board, in a capacity[] provided for in the statutes". *Id.*

While both *Sundback* and *James* focused their discussion on interpretation of the term "decision of the [B]oard" in an appeal right statute (an earlier version of 35 U.S.C. § 141 in *James*, and an even earlier predecessor thereto in *Sundback*), the CCPA made clear that this interpretation applied to its grant of jurisdiction in 28 U.S.C. § 1542 as well.

In particular, shortly after *James*, the Court indicated that "[b]oth 28 U.S.C. § 1542 and 35 U.S.C. § 141 limit our jurisdiction to appeals of 'decisions' of the board," noting that "[t]he board's authority to make such 'decisions' is set forth in 35 U.S.C. § 7." *In re Haas*, 486 F.2d 1053, 1055 (C.C.P.A. 1973).

Thus, the CCPA interpreted both the term "decisions of… the Board" in 28 U.S.C. § 1542 and the term "decision of the Board" in 35 U.S.C. § 141 as "refer[ring] to an action taken by the board, in a capacity[] provided for in the statutes," and excluding actions where "the board was acting only under authority of the rules — as an agent of the [head of the Office] — and not in any statutory capacity." *James*, 432 F.2d at 475, 476.

B. Congress presumptively adopted the established CCPA interpretation in reenacting the relevant language in 28 U.S.C. § 1295.

"Congress is presumed to be aware of an administrative or judicial interpretation of a statute and to adopt that interpretation when it re-enacts a statute without change." *Lorillard v. Pons*, 434 U.S. 575, 580 (1978).

Here, then, Congress is presumed to have been aware of the CCPA interpretation of the term "decision[] of… the Board" in 28 U.S.C. § 1542 when it reenacted this language in 28 U.S.C. § 1295, see Pub. L. No. 97-164, 96 Stat. 25, 38 (1982), causing this Court to, "in essence, inherit[] the jurisdiction of the …CCPA." *Copelands' Enterprises, Inc. v. CNV, Inc.*, 887 F.2d 1065, 1067 (Fed. Cir. 1989) (en banc).

In particular, this Court's first grant of jurisdiction over "an appeal from a decision of… the Board of Appeals or the Board of Patent Interferences of the Patent and Trademark Office with respect to patent applications and interferences,"

28 U.S.C. § 1295 (1982), exactly mirrors the CCPA's prior grant of jurisdiction over "'appeals from decisions of… the Board of Appeals and the Board of Interference Examiners of the Patent Office as to patent applications and interferences.'" *In re Voss*, 557 F.2d 812, 816 n.7 (C.C.P.A. 1977) (quoting then 28 U.S.C. § 1542).

"Since … [there is] no reason to doubt that these cases represented settled law when Congress reenacted the '[decision of the Board]' language in [1982], … [it is appropriate to] apply the presumption that Congress was aware of these earlier judicial interpretations and, in effect, adopted them." *Keene Corp. v. United States*, 508 U.S. 200, 212 (1993).

This Court's current grant of jurisdiction in 28 U.S.C. § 1295 continues to substantially mirror these prior grants of jurisdiction except in that it has been updated to encompass new proceedings that did not exist at the time, and thus there is no reason to believe that this adopted interpretation has been disturbed. Indeed, this interpretation has clearly remained applicable the entire time as to "a decision of… the … Board … with respect to a patent application," 28 U.S.C. § 1295, and the term "decision of… the … Board" should have the same meaning for each type of delineated proceeding. See *Cochise Consultancy, Inc. v. United States ex rel. Hunt*, 139 S. Ct. 1507, 1512 (2019) ("In all but the most unusual situations, a single use of a statutory phrase must have a fixed meaning."); *Bankamerica Corp.*

v. United States, 462 U.S. 122, 129 (1983) ("we reject as unreasonable the contention that Congress intended the phrase 'other than' to mean one thing when applied to 'banks' and another thing as applied to 'common carriers,' where the phrase 'other than' modifies both words in the same clause.")

II. The canon of avoidance also militates against the Petition's desired interpretation.

A. The Petition's desired interpretation would raise a nondelegation question by allowing the Director's regulations to expand this Court's jurisdiction.

The Petition's desired interpretation of 28 U.S.C. § 1295 requires interpreting the grant of jurisdiction over "an appeal from a decision of… the … Board" to encompass determinations issued by the Board "on behalf of the Director." 37 CFR § 42.4.

This would mean that the Director's regulations delegating institution determinations to the Board have expanded this Court's jurisdiction to encompass review of institution determinations which would not have been within this Court's jurisdiction absent such regulations.

Indeed, such an interpretation would allow the Director to expand this Court's jurisdiction to review other Office determinations "with respect to a patent application, derivation proceeding, reexamination, post-grant review, or inter partes review" by delegating them to the Board. 28 U.S.C. § 1295. Similarly, the

Director could subsequently contract this Court's jurisdiction by reversing such delegation.

This is potentially problematic because "Congress… possess[es] the sole power of creating the tribunals (inferior to the Supreme Court) for the exercise of the judicial power, and of investing them with jurisdiction … and [] withholding jurisdiction," *Cary v. Curtis*, 44 U.S. 236, 245 (1845), and "[a]ccompanying that assignment of power to Congress is a bar on its further delegation." *Gundy v. United States*, 139 S. Ct. 2116, 2123 (2019); see also *Christianson v. Colt Indus.*, 486 U.S. 800, 818 (1988) ("Courts created by statute can have no jurisdiction but such as the statute confers.")

"While it's been some time since the Court last held that a statute improperly delegated the legislative power to another branch… the Court has hardly abandoned the business of policing improper legislative delegations." *Gundy*, 139 S. Ct. at 2141 (Gorsuch, J., dissenting). Indeed, just two years ago, the Court acknowledged that if a particular view of a contested provision had been correct, then "we would face a nondelegation question." *Gundy*, 139 S. Ct. at 2123.

Further, as one of this Court's sister circuits has observed, "one can readily distinguish between Congress' ability to delegate its commerce power over price controls during wartime… and its ability to delegate a power as sensitive and central to our Anglo-American legal tradition as shaping a federal court's

jurisdiction." *United States v. Mitchell*, 18 F.3d 1355, 1360 n.7 (7th Cir. 1994). At the very least there is a "potential constitutional concern" as to whether "anything in the Framers' language would permit Congress to delegate such a core legislative function as its control over federal court jurisdiction to any agency or commission." *Id.*

Some of this Court's sister circuits have gone so far as to suggest that "it is 'axiomatic' that agencies can neither grant nor curtail federal court jurisdiction." *Carlyle Towers Condominium Ass'n v. Federal Deposit Insurance*, 170 F.3d 301, 310 (2d Cir. 1999) (quoting *Miller v. FCC*, 66 F.3d 1140, 1144 (11th Cir. 1995)); see also *Miller*, 66 F.3d at 1144 ("it is axiomatic that Congress has not delegated, and could not delegate, the power to any agency to oust state courts and federal district courts of subject matter jurisdiction.")

While the D.C. Circuit has suggested that "Congress may delegate the authority to the Executive Branch to make a finding of fact upon which subject matter jurisdiction depends," it was careful to distinguish this from the situation of "delegating to the Executive the authority to define the conditions under which the courts will have jurisdiction." *Owens v. Republic of Sudan*, 531 F.3d 884, 890, 891 (D.C. Cir. 2008).

Here, under the Petition's desired interpretation, the Director would not simply be able to "make a finding of fact upon which subject matter jurisdiction

depends," *Id.*, but would instead be able to confer jurisdiction on this Court to review a new type of decision by promulgating a regulation assigning that type of decision to the Board.

In *Gundy*, the Court acknowledged that if the contested "provision… [had] grant[ed] the Attorney General plenary power to determine [the Act's] applicability to pre-Act offenders—to require them to register, or not, as she sees fit, and to change her policy for any reason and at any time … [then] we would face a nondelegation question." *Gundy*, 139 S. Ct. at 2123.

Here, analogously, if the statutory scheme is interpreted to provide the Director "plenary power to [grant this Court jurisdiction over various Office determinations] or not, as she sees fit, and to change her policy for any reason and at any time … [then] we would face a nondelegation question." *Id.*

B. The established CCPA interpretation offers a 'fairly possible' construction by which the nondelegation question may be avoided.

Ultimately, though, it is not actually necessary to fully evaluate whether such a scheme would be unconstitutional, given the "rule of statutory construction… [that] where an otherwise acceptable construction of a statute would raise serious constitutional problems, the Court will construe the statute to avoid such problems unless such construction is plainly contrary to the intent of Congress." *Edward J. DeBartolo Corp. v. Florida Gulf Coast Building Constr.*

Trades Council, 485 U.S. 568, 575 (1988). Indeed, "[t]his cardinal principle … has for so long been applied by th[e] Court that it is beyond debate." *Id.*

Thus, because "a serious doubt of constitutionality is raised," it is necessary to "ascertain whether a construction of the statute is fairly possible by which the question may be avoided." *Crowell v. Benson*, 285 U.S. 22, 62 (1932).

Here, precedent of this Court offers exactly such a "fairly possible" construction, in the form of the CCPA's repeated construction of the term "decision of the Board" as "refer[ring] to an action taken by the board, in a capacity[] provided for in the statutes," and excluding actions where "the board was acting only under authority of the rules — as an agent of the [head of the Office] — and not in any statutory capacity." *James*, 432 F.2d at 475, 476.

Consequently, the avoidance canon militates against the Petition's desired interpretation and in favor of this "fairly possible" construction "by which the question may be avoided." *Crowell*, 285 U.S. at 62.

III. *Stare decisis* also militates against the Petition's desired interpretation.

In adopting the precedent of the CCPA, this Court emphasized that "[v]ery weighty considerations underlie the principle that courts should not lightly overrule past decisions." *South Corp. v. United States*, 690 F.2d 1368, 1370 (Fed. Cir. 1982).

Even if it was determined that Congress did not adopt the established CCPA interpretation, it would still be precedent of this Court, and "any departure from the doctrine of *stare decisis* demands special justification." *Arizona v. Rumsey*, 467 U.S. 203, 212 (1984). Indeed, "the burden borne by the party advocating the abandonment of an established precedent is greater where the Court is asked to overrule a point of statutory construction," as "[c]onsiderations of *stare decisis* have special force in the area of statutory interpretation." *Patterson v. McLean Credit Union*, 491 U.S. 164, 172 (1989).

CONCLUSION

Amicus urges that this Court should deny rehearing.

Dated: August 9, 2021

Respectfully submitted,

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CERTIFICATE OF SERVICE

I certify that I electronically filed the foregoing document using the Court's CM/ECF Filing System on August 9, 2021. All counsel of record were served via CM/ECF on August 9, 2021.

Paper copies will be filed with the Court within the time provided in the Court's rules. Paper copies will also be mailed to counsel for each party in the case at the time paper copies are mailed to the Court.

Dated: August 9, 2021

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CERTIFICATE OF COMPLIANCE

1. This brief complies with the type-volume limitation of Federal Circuit Rule 35(g)(3).

   The brief contains 2597 words, excluding the parts of the brief exempted by Federal Rule of Appellate Procedure 32(f) and Federal Circuit Rule 32(b).

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).

   The brief has been prepared in a proportionally spaced typeface using Microsoft Word from Microsoft Office 365 in Times New Roman Size 14.

Dated: August 9, 2021

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