No. 21-_____

# In the Supreme Court of the United States

WALTER A. TORMASI,

Petitioner,

v.

WESTERN DIGITAL CORPORATION,

Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

## PETITION FOR A WRIT OF CERTIORARI

THOMAS A. LEWRY
*Counsel of Record*
REZA ROGHANI ESFAHANI
DUSTIN ZAK
LEROY ASHLEY
BROOKS KUSHMAN P.C.
1000 Town Center
Twenty-Second Floor
Southfield, Michigan 48075
(248) 358-4400
tlewry@brooks.law

*Attorneys for Petitioner*

April 2, 2021

## QUESTIONS PRESENTED

Petitioner, Walter Tormasi, is the inventor and owner of U.S. Patent No. 7,324,301. In 1998, he was sentenced to life in prison and is currently serving his sentence in New Jersey state prison. Mr. Tormasi tried to enforce his patent by suing Respondent for infringement under 35 U.S.C. § 1 *et seq*. The courts below held Mr. Tormasi lacked capacity to sue, not based on age or mental capacity, but based solely on a New Jersey prison regulation that prohibits prisoners from conducting business without Administrator approval.

The Questions Presented are:

1. Does imprisonment (1) forfeit a patent owner's right not to be deprived of personal property without due process of law and (2) render a person wholly without equal protection of the law?
2. Does *Lewis v. Casey*, stating that the right of access to the courts "does not guarantee inmates the wherewithal to transform themselves into litigating engines," enable state agencies to affirmatively eliminate an inmate's access to court on general civil matters?
3. The patent statute authorizes patent owners to enforce their constitutionally recognized exclusionary rights in federal court. Did the lower courts create a dangerous slippery slope that (1) establishes a mechanism by which states can, via an administrative rule, nullify federally granted statutory rights and (2) oppresses prisoners by depriving them of property without redress?

## PARTIES TO THE PROCEEDING BELOW

Petitioner is Walter A. Tormasi, who was the appellant in the Court of Appeals for the Federal Circuit.

Respondent is Western Digital Corporation, which was the appellee in the Court of Appeals for the Federal Circuit.

## LIST OF PROCEEDINGS

United States Court of Appeals for the Federal Circuit

No. 20-1265

*Walter A. Tormasi v. Western Digital Corporation*

Judgment entered: August 20, 2020

En banc petition denied: November 3, 2020

---

United States District Court for the Northern District of California

No. 19-cv-00772-HSG

*Walter A Tormasi v. Western Digital Corporation*

Judgment entered: November 21, 2019

## TABLE OF CONTENTS

## TABLE OF CONTENTS - Continued



## APPENDIX TABLE OF CONTENTS

**APPENDIX TABLE OF CONTENTS - Continued**

## TABLE OF AUTHORITIES

Page

### Cases

**TABLE OF AUTHORITIES - Continued**

**TABLE OF AUTHORITIES - Continued**

**TABLE OF AUTHORITIES - Continued**

## TABLE OF AUTHORITIES - Continued

Page

### Statutes



### Other Authorities



### Rules

## PETITION FOR A WRIT CERTIORARI

Walter A. Tormasi petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit.

## OPINIONS BELOW

The decision of the United States Court of Appeals for the Federal Circuit affirming the district court's order granting defendant's motion to dismiss appears at 825 Fed. App'x 783 (Fed. Cir. 2020) and is reprinted in the Appendix to the Petition ("App.") at 1a-14a. The district court's order is unreported and is reprinted at App.15a-19a. The Federal Circuit's order denying the petition for rehearing en banc is unpublished and is reprinted at App.20a-21a.

## JURISDICTION

The Federal Circuit entered judgment on August 20, 2020. Walter A. Tormasi filed a timely petition for rehearing en banc, which the Federal Circuit denied on November 3, 2020. Mr. Tormasi invokes the jurisdiction of this Court under 28 U.S.C. § 1254(1) (2018).

## INTRODUCTION

This case presents an important question about the limits that the Due Process Clause of the Fifth and Fourteenth Amendments place on government

authorities to use state and local regulations to encroach on inmates' exclusionary private property rights and dedicate them to public use. Walter A. Tormasi ("Mr. Tormasi") is serving a mandatory minimum sentence of thirty years and a maximum sentence of life in a New Jersey state prison. While incarcerated, Mr. Tormasi invented a hard disk drive directed to the art of dynamically storing and retrieving information. The United States Patent and Trademark Office awarded him U.S. Patent No. 7,324,301 for his invention. Appearing *pro se*, Mr. Tormasi sued Respondent Western Digital Corporation ("Western Digital") for infringement under the Patent Statutes. The district court dismissed the complaint, concluding that Mr. Tormasi lacked capacity to sue "because New Jersey law prevents inmates from 'commencing or operating a business or group for profit . . . without the approval of the Administrator.'" App.6a.

Mr. Tormasi, still acting *pro se*, appealed to the Court of Appeals for the Federal Circuit, which affirmed, App.11a, and denied en banc review, App.20a-21a.

The lower courts' conclusion that Mr. Tormasi lacks capacity to sue, preventing him from enforcing his patent, violates due process. Due process mandates a right to be heard before deprivation of property rights. *Joint Anti-Fascist Refugee Committee v. McGrath*, 341 U.S. 123, 168 (1951). Patents are personal property. 35 U.S.C. § 261 (2018). Thus, due process mandates a hearing before deprivation of patent rights. By refusing to give Mr. Tormasi the opportunity to enforce his exclusionary patent right, the lower courts have planted a "trespass welcome" sign on his property.

Inmates, like other citizens, have a constitutional right to access the courts and present their claims. *Bounds v. Smith*, 430 U.S. 817, 821 (1977). When the underlying substantive claim is constitutional in nature, states have an affirmative duty to provide inmates with adequate tools to present their claims to courts. *Wolff v. McDonnell*, 418 U.S. 539 (1974). In contrast, when the underlying federal substantive claim is statutory in nature, states are prohibited from interfering with the federal right—a negative duty. *Bounds*, 430 U.S. at 834 (Burger, J., dissenting). Therefore, even if the Fifth Amendment did not place property on equal footing with life and liberty, states may not interfere with an inmate's right to present a claim based on a statutory granted federal right to the courts. *Id.* Interfering with Mr. Tormasi's right to present a patent infringement claim—a federally granted statutory right—violates Mr. Tormasi's constitutional right of access to courts.

The lower courts' application of the no business rule, a prison regulation prohibiting prisoners from conducting business, to Mr. Tormasi also violated his right to equal protection. N.J. ADMIN. CODE § 10A:4-4.1 (2021). The Equal Protection Clause requires the government to treat similarly situated persons alike. *City of Cleburne v. Cleburne Living Ctr.*, 473 U.S. 432, 439 (1985). In the context of incarceration, disparate treatment must be rationally related to a legitimate penological interest. *Jones v. N.C. Prisoners' Labor Union, Inc.*, 433 U.S. 119 (1977). Here, a state has no legitimate penological interest in depriving an inmate of the right to enforce a patent in federal court when other inmates are permitted to file lawsuits to enforce other federally recognized rights.

An individual's "[c]apacity to sue or be sued is determined . . . by the law of [that] individual's domicile." Fed. R. Civ. P. 17(b). Thus, when the law of the domicile affords capacity to "[e]very person who has reached the age of majority . . . and has the mental capacity," those possessing such attributes have capacity to sue under Rule 17(b), inmates or otherwise. N.J. STAT. ANN. § 2A:15-1 (2013). The lower courts' findings to the contrary, violate Rule 17(b) and the New Jersey statute governing capacity.

## STATEMENT OF THE CASE

Mr. Tormasi is an inmate at the New Jersey state prison. While incarcerated, Mr. Tormasi applied for and was awarded U.S. Patent No. 7,324,301 ("the '301 patent"). App.22a-30a. Mr. Tormasi is the sole inventor of the '301 patent. The '301 patent was assigned to Advanced Data Solutions Corp., a Delaware corporation, solely owned by Mr. Tormasi. App.31a-34a. On January 30, 2019, the '301 patent was re-assigned back to Mr. Tormasi. App.35a. Shortly thereafter, on February 12, 2019, Mr. Tormasi, *pro se*, filed a complaint against Western Digital for infringement of the '301 patent under 35 U.S.C. § 281. App.200a-212a; App.36a-39a. On November 21, 2019, the United States District Court for the Northern District of California dismissed the case concluding that Mr. Tormasi lacked capacity to sue because of the no business rule. App.15a-19a*See* N.J. ADMIN. CODE § 10A:4-4.1. This rule allows prison officials to punish inmates who conduct business activities without the Administrator's approval. Mr. Tormasi, *pro se*, appealed to the Federal Circuit, which affirmed the district court on August 20, 2020. *Tormasi*, 825 F. App'x 783 (Fed. Cir.

2020); App.1a-14a. After the Federal Circuit affirmed, Mr. Tormasi, *pro se*, petitioned for rehearing and rehearing en banc, which were denied on November 3, 2020. App.20a-21a.

## REASONS FOR GRANTING THE PETITION

## A PRISON REGULATION CANNOT DENY AN INMATE ENFORCEMENT OF PATENT RIGHTS BY ELIMINATING THE INMATE'S CAPACITY TO LITIGATE

### A. The Lower Courts Barred the Courthouse Doors to Mr. Tormasi by Ruling He Lacked Capacity to Sue

Under Rule 17(b) of the Federal Rule of Civil Procedure (FRCP) an individual's "[c]apacity to sue or be sued is determined . . . by the law of [that] individual's domicile." Fed. R. Civ. Pro. 17(b). Mr. Tormasi is domiciled in New Jersey. App.7a. New Jersey law affords capacity to "[e]very person who has reached the age of majority . . . and has the mental capacity." N.J. STAT. ANN. § 2A:15-1 (2013). Further, Mr. Tormasi has reached the age of majority and has mental capacity. App.87a. Therefore, Mr. Tormasi has capacity under FRCP 17(b) and New Jersey statute. The inquiry should have ended there—even for an inmate.

While in New Jersey, inmates are further bound by the Administrative Rules of the Department of Corrections, those rules are silent as to the issue of capacity. N.J. ADMIN. CODE. § 10A:4-1.2 (2021). Yet, respondents proposed, and the lower courts agreed, that the Department of Corrections' administrative rule prescribing sanctions for certain "prohibited acts"

affects capacity to sue. App.1a-18a. N.J. Admin. Code § 10A:4-4.1 does not address capacity, let alone reference the statute governing capacity or even use the term capacity. N.J. ADMIN. CODE § 10A:4-4.1 (2021) (attached as App.115a-123a). The no business rule lists a series of prohibited acts or offenses, in order of severity, which if committed by inmates, could subject them to "disciplinary action and a sanction that is imposed by a Disciplinary Hearing Officer or Adjustment Committee." N.J. ADMIN. CODE § 10A:4-4.1 (2021). "[C]ommencing or operating a business or group for profit or commencing or operating a nonprofit enterprise without the approval of the Administrator," on which the lower courts relied to deprive Mr. Tormasi of his capacity to sue, is a "Category C" offense carrying "a sanction of no less than 31 days and no more than 90 days of administrative segregation in addition to one or more of the sanctions listed at *N.J.A.C. 10A:4-5.1(j)*." *Id. See also* App.13a (Stoll, J., dissenting) ("On its face, the 'no business' rule does not include the loss of the capacity to sue as a punishment.").

This argument was not waived below. *See* App.85a-86a ("Defendant is certainly correct that New Jersey inmates are prohibited from operating businesses without administrative approval . . . That prohibition, however, was never intended to supersede Plaintiff's right to file civil lawsuits in his personal capacity."). *See also* App.159a ("There is no question that Tormasi is an adult. Nor is there any question that Tormasi is mentally competent. These facts establish Tormasi's suing capacity under the governing capacity-to-sue statute . . . Tormasi submits that the district court erred by relying on N.J. Admin. Code § 10A:4-4.1(a)(3)(xix)."); App.12a-14a (Stoll, J., dissenting) ("I respectfully dissent because I disagree with the

majority that Mr. Tormasi waived his argument that the 'no business' rule does not limit the scope of an inmate's capacity to sue under N.J. STAT. ANN. § 2A:15-1 (2013).").

Nothing in the rule even remotely suggests that these prohibited acts may override New Jersey's capacity statute. *Ex parte Davenport*, 31 U.S. 661, 664 (1832) ("[W]e perceive no reason to suppose that the legislature meant to bar the party from any good defence against the suit, founded upon real and substantial merits. And certainly we ought not, in common justice, to presume such an intention without the most express declarations. To deprive a citizen of a right of trial by jury, in any case, is a sufficiently harsh exercise of prerogative, not to be raised by implication from any general language in a statute."). The no business rule cannot evade Rule 17(b). *Central of G.R. Co. v. Wright*, 207 U.S. 127, 127 (1907) (noting that misconduct cannot forfeit a right that may be taken without judicial proceedings).

Nor is there any suggestion that bringing an action to enforce a substantive federal right is tantamount to running a business even if such substitution was appropriate. Indeed, the only authority that evaluated a similar question to the one-at-hand, disagreed with such interchangeability. In *Jerry v. Beard*, a prisoner attempted to submit a children's book he wrote, "Pinky Pigg," to the Library of Congress to obtain copyright privileges. 419 Fed. App'x 260, 261 (3d Cir. 2011). The prison confiscated his book. *Id.* After undergoing administrative proceedings, Jerry filed a complaint under 42 U.S.C. § 1983 alleging violation of his First and Fourteenth Amendment rights. *Id.* at 262. Siding with Jerry, the Third Circuit vacated the

lower court's ruling. *Id.* at 263. In that case, the district court for the Western District of Pennsylvania had granted defendants' motion to dismiss "reason[ing] that the sole function of a copyright is to enable an author to commercially exploit his creations," amounting to an attempt to engage in business, which a prisoner has no right to do. *Id.* at 262–63.

Acknowledging that prisoners have no right under the Constitution or federal law to engage in business, the Third Circuit nonetheless found the district court's analysis too narrow. *Id.* at 263. The court stated that "[t]he Copyright Act of 1976, 17 U.S.C. §§ 101, *et seq.*, affords the author of a literary work limited exclusive control over that work, including the right to prevent others from commercially exploiting the work." *Id.* The Court continued that "[i]t does not appear that exercising [the right to register a literary work] necessarily constitutes engaging in a business activity." *Id.* The same is true here.

The core exclusionary right of a patent is the negative right of a patentee to "exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States." 35 U.S.C. § 154(a)(1) (2018). Like exercising the right to register a literary work, exercising the right to exclude others, does not necessarily constitute engaging in business. Because the New Jersey Supreme Court has not addressed this issue, the courts below should have followed the Third Circuit's reasoning in *Jerry*. *Borman v. Raymark Indus., Inc.*, 960 F.2d 327, 331 (3d Cir. 1992) ("When the state's highest court has not addressed the [precise question presented], a federal court must predict [how

the state's highest court would resolve the issue]."). *See also Erie R.R. Co. v. Tompkins*, 304 U.S. 64 (1938).

This Court and state high courts commonly overturn "judicial rulings that impose extra-statutory limitations on a prisoner's capacity to sue." *Ross v. Blake*, 136 S. Ct. 1850, 1857 n.1 (2016). This case is no different. In *Kordis v. Kordis*, for example, the Oklahoma Supreme Court regarding depriving an inmate of his capacity to sue stated as follows:

> Oklahoma has enacted a statute which suspends the civil rights of one sentenced to imprisonment under the department of corrections. 21 O.S. 1991 § 65. To construe this statute as depriving the inmate of his capacity to sue to enforce property rights which vested before his incarceration would pose serious constitutional concerns. Such a construction would be equivalent to treating imprisonment as operating to divest the inmate of his property or working a forfeiture of his property and would violate the due process requirements of the federal and state constitutions and the access to the courts provision of the state constitution.

2001 OK 99, 7 n.4 (2001) (citing U.S. Const. amend. XIV).

Evasion of Rule 17(b) is not the only consequence of the lower court's interpretation of the no business rule. An additional consequence is a violation of the doctrine of federal preemption. "When state law touches upon the area of [federal patent law] . . . federal policy 'may not be set at naught, or its benefits denied' by the state law." *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 229 (1964) (citing *Sola. Elec. Co. v. Jefferson Elec. Co.*, 317 U.S. 173, 176 (1942)).

Congress has the exclusive authority to dictate the conditions upon which the issuance and enforcement of patents occurs. U.S. Const., Art. I. § 8, cl. 8; *Sears, Roebuck & Co.,* 376 U.S. at 229. Congress has exercised this authority since 1790 and it remains the "supreme law of the land." *Sears, Roebuck & Co.,* 376 U.S. at 229. The lower court's interpretation of the no business rule ignores this doctrine.

In *Bonito Boats v. Thunder Craft Boats*, this Court found a state statute providing patent-like protection impermissibly interfered with federal patent law and was preempted by the Eleventh Amendment. 489 U.S. 141 (1989). In doing so, the Court noted that this statute conflicted with the federal policy favoring free competition. *Id.* at 144. S*ee also Haywood v. Drown*, 556 U.S. 729 (2009) (discussing how New York law violates the Supremacy Clause because it was contrary to federal statutory law). Indeed, courts have staunchly protected against state interference with this constitutionally authorized corner of law because of the delicate balance it seeks to maintain. *Bonito Boats*, 489 U.S. at 146 ("From their inception, the federal patent laws have embodied a careful balance between the need to promote innovation and the recognition that imitation and refinement through imitation are both necessary to invention itself and the very lifeblood of a competitive economy."). Even minor state interference detrimentally affects this delicate balance thus slowing innovation and harming the public. *Id.* at 167.

Congress has not altered this balance to preclude certain inventors—inmates—from contributing to the public knowledge in exchange for the reward of a patent. 35 U.S.C. § 1 *et seq.* (2018); 35 U.S.C. § 101 (2018)

("*Whoever* invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.") (emphasis added). Likewise, the agency authorized to carry out administration of at least a portion of this delicate balance does not inquire into the incarceration status of an inventor and/or applicant. *See e.g.,* U.S. Dep't of Commerce, U.S. Patent & Trademark Office, Manual of Patent Examining Procedure § 601.05 (9th ed. Rev. 10, June 2020) (discussing the bibliographical information supplied to the USPTO). Here, however, the lower courts' application of a state regulation upends this balance by shutting the courthouse doors to one class of inventors. Instead of *granting* patent-like protection, the no business rule has *revoked* patent protection, which only Congress has the right to do.

The lower courts' actions create a slippery slope. This case presents dangerous authority on at least two fronts. *First*, it establishes a mechanism by which states can, via an administrative rule, nullify federally granted statutory rights. *Second*, it oppresses prisoners by depriving them of property without redress. While prisoners may own property, they cannot enforce their property rights. If this application of the "no business rule" stands, prisoners will be deprived of all property that is deemed "conducting business"—patents, copyrights, and even real property included.

This is not mere speculation. In *Youngblood v. Ala. Dep't of Corr.*, an inmate sought protection for an invention related to a notification system for approaching first responder and roadside assistance vehicles. No. 2:15-cv-214, 2018 U.S. Dist. LEXIS 37371, at *7 (M.D. Ala. Mar. 6, 2018). Prison officials would

not let him pay the required U.S. Patent and Trademark Office fees. *Id.* at *13. An Alabama court agreed with that decision relying on *Tormasi v. Hayman*, 443 F. App'x 742 (3d Cir. 2011)). *Id.* at *26-*28. The court found no violation because securing a patent would constitute running a business. *Id.* at *24-28 (citing *Tormasi*, 443 F. App'x 742). This is wrong.

### B. Imprisonment Does Not Render Inmates Wholly Without the Protections of the Constitution

#### 1. Inmates, Like Other Citizens, Are Entitled to Due Process of Law: Due Process Mandates a Right to be Heard

The lower courts concluded that Mr. Tormasi lacked capacity to enforce his patent. In doing so, the courts refused to give Mr. Tormasi a hearing on the merits of his patent infringement allegations, preventing him from enforcing his constitutionally recognized right to exclude.[1] Due Process mandates a right to be heard before deprivation of property rights. *Joint Anti-Fascist Refugee Committee v. McGrath*, 341 U.S. 123, 168 (1951) (The "right to be heard before being condemned to suffer grievous loss of any kind . . . is a principle basic to our society."); *Grannis v. Ordean*, 234 U.S. 385 (1914).[2] Patents are personal property.

---

[1] The Copyright and Patent Clause of the Constitution recognizes the need to give inventors exclusive rights in their intellectual property. U.S. Const., Art. I. § 8, cl. 8.

[2] The Due Process Clauses of the Constitution protect "life, liberty, or property" without qualification. U.S. Const. amend. XIV, § 1; U.S. Const. amend. V (prohibiting government deprivations

35 U.S.C. § 261 (2018). Thus, due process mandates a hearing before a patent owner may be deprived of patent rights.

Withholding a hearing to pursue a cause of action is the same as withholding the property right itself. *Logan v. Zimmerman Brush Co.*, 455 U.S. 422 (1982) ("a cause of action is a species of property protected by the Fourteenth Amendment's Due Process Clause"); *Christopher v. Harbury*, 536 U.S. 403, 415 (2002) (a right of access to courts "is ancillary to the underlying claim, without which a plaintiff cannot have suffered injury by being shut out of court."); *Central of G.R. Co. v. Wright*, 207 U.S. 127, 131 (1907) ("When the Fourteenth Amendment provided that no person shall be deprived of his property without a hearing, it also declared that he should not be deprived of a hearing as a penalty. Whatever the crime, however great the contempt, howsoever contumacious a party, he cannot be deprived of the right to be heard when his property is to be taken."). Here, the lower courts barred the courtroom doors to Mr. Tormasi, and effectively deprived him of his patent altogether by eliminating his only means of enforcing his right to exclude others from infringing his patent. 35 U.S.C. § 154(a)(1) (2018) (granting a "patentee . . . the right to exclude others from making, using, offering for sale, or selling the invention").

Incarceration does not change the equation. It is undisputed that prisoners may own property. *Hatten*

---

of "life, liberty, or property, without due process of law"); *see also United States v. Carlton*, 512 U.S. 26, 41-42 (1994) ("[T]he Due Process Clause explicitly applies to 'property.'") (Scalia, J., concurring).

*v. White*, 275 F.3d 1208, 1210 (10th Cir. 2002) ("an inmate's ownership of property is a protected property interest that may not be infringed without due process"). "Prisoners may also claim the protections of the Due Process Clause. They may not be deprived of life, liberty, or property without due process of law." *Wolff v. McDonnell*, 418 U.S. 539, 556 (1974). Mr. Tormasi is entitled to due process despite his status as an inmate.[3]

Abolishing Mr. Tormasi's capacity to sue runs afoul of procedural due process because it prevents him from entering the courthouse. *Wolff*, 418 U.S. at 557–58 ("The Court has consistently held that some kind of hearing is required at some time before a person is finally deprived of his property interests.") (citation omitted); *Ewing v. Mytinger & Casselberry, Inc.*, 339 U.S. 594, 599 (1950) (where property rights are concerned, at some stage an opportunity for a hearing and a judicial determination needs to be had). By refusing to give Mr. Tormasi any opportunity to present his patent infringement case, the lower courts' action unconstitutionally deprived Mr. Tormasi of property—his patent—without due process of law.

Indeed, the Federal Circuit's decision here is inconsistent with a Third Circuit holding that a New

---

[3] Analysis under the Fifth and Fourteenth Amendments are the same except that the Fifth Amendment is a restraint on the action of the federal government and the Fourteenth Amendment is a restraint on the states. *French v. Barber Asphalt Paving Co.*, 181 U.S. 324, 329 (1901) ("the phrase 'due process of law' is the same in both amendments . . . it cannot be supposed that, by the Fourteenth Amendment, it is intended to impose on the States . . . any more rigid or stricter curb than that imposed on the Federal government").

Jersey statute barring prisoners' rights to commence any action while imprisoned is unconstitutional because it "deprive[d] [prisoners] of a protected property interest without due process of law." *Holman v. Hilton*, 712 F.2d 854, 860 (3d Cir. 1983). Likewise, barring Mr. Tormasi's action under the no business rule is unconstitutional and cannot eliminate legal capacity of a constitutionally protected and statutorily granted right. The district court did not address Mr. Tormasi's argument that New Jersey previously had a law "preventing New Jersey inmates from suing while imprisoned," which was adjudicated unconstitutional. App.87a-88a. While Mr. Tormasi's *pro se* lower court arguments did not lay out the precise reasoning above or repeat the reasoning of *Holman*, it analogized the case-at-hand with the *Holman* case.[4] App.87a-88a. The district court should have addressed Mr. Tormasi's argument, even if not laid out word for word because "[a] court is not hidebound by the precise

---

[4] *Pro se* litigants are generally afforded leniency. *Haines v. Kerner*, 404 U.S. 519, 520 (1972).

> We tend to be flexible when applying procedural rules to pro se litigants, especially when interpreting their pleadings. The obligation to liberally construe a *pro se* litigant's pleadings is well-established. This means that we are willing to apply the relevant legal principle even when the complaint has failed to name it... We are especially likely to be flexible when dealing with imprisoned pro se litigants. Such litigants often lack the resources and freedom necessary to comply with the technical rules of modern litigation. *See Moore v. Florida*, 703 F.2d 516, 520 (11th Cir. 1983) ("Pro se prison inmates, with limited access to legal materials, occupy a position significantly different from that occupied by litigants represented by counsel").

*Mala v. Crown Bay Marina, Inc.*, 704 F.3d 239, 244 (3d Cir. 2013) (some citations and quotation marks omitted).

arguments of counsel." *United States v. Sineneng-Smith*, 140 S. Ct. 1575, 1581 (2020).

Mr. Tormasi's patent and his infringement action are his personal property. 35 U.S.C. § 261 (2018); *Logan*, 455 U.S. at 428 ("a cause of action is a species of property protected by the Fourteenth Amendment's Due Process Clause"). Without an ability to enforce and protect his property, Mr. Tormasi's patent is effectively dedicated to the public without compensation under the color of a state regulation—the no business rule. In other words, a sign reading "trespass welcome" has been planted on Mr. Tormasi's property, inviting both private and public use of his property without compensation.

The lower courts should not have applied a regulatory rule, designed to sanction certain prohibited conduct, in a manner that is so grossly unconstitutional. It is a well-recognized canon of statutory construction that "of two possible constructions, one constitutional and the other unconstitutional, the constitutional construction will be adopted." *Norfolk & W.R. Co. v. Dixie Tobacco Co.*, 228 U.S. 593, 594 (1913); *NCAA v. Governor of N.J.*, 730 F.3d 208, 233 (3d Cir. 2013) ("[A]s between two plausible statutory constructions, we ought to prefer the one that does not raise a series of constitutional problems.").

Based on the lower courts' interpretation of the no business rule, the only way for an inmate to enforce a patent is to seek approval of the Administrator. This administrative "permission" is not enough to save the lower court's construction from unconstitutionality. The Administrator may simply decline to grant permission. "The decision or finding of the Administrator . . . is the *final level of review and decision or finding*

of the New Jersey Department of Corrections." N.J. ADMIN. CODE § 10A: 1-4.6 (2021) (emphasis added). Likewise, there is no post deprivation procedure provided that saves the lower court's construction from unconstitutionality. *Hudson v. Palmer*, 468 U.S. 517, 533 (1984). Accordingly, an inmate seeking to enforce a property right has no administrative relief from the Administrator's decision.

Section 10A:4-4.1, as applied by the lower courts, violates due process.

### 2. Equal Protection Demands Similar Treatment: Disparate Treatment of Patent Infringement Actions is Unconstitutionally Arbitrary

"Prison walls do not form a barrier separating prison inmates from the protections of the Constitution . . . [P]risoners . . . are protected . . . by the Equal Protection Clause of the Fourteenth Amendment." *Turner v.* Safley, 482 U.S. 78, 84 (1987) (citing *Lee v. Washington*, 390 U.S. 333 (1968)). The Equal Protection Clause requires the government to treat similarly situated persons alike. *City of Cleburne v. Cleburne Living Ctr.*, 473 U.S. 432, 439 (1985) ("The Equal Protection Clause of the Fourteenth Amendment . . . is essentially a direction that all persons similarly situated should be treated alike"). Mr. Tormasi is, without a doubt, similarly situated with other prisoners. Yet, other prisoners have been able to access the courts and enforce their rights. *See e.g. Baxter v. Palmigiano*, 425 U.S. 308 (1976) (serving a life sentence bringing § 1983 action); *Moffat v. United States DOJ*, No. 09-12067-DJC, 2012 U.S. Dist. LEXIS 4194, at *8 (D. Mass. Jan. 12, 2012) ("serving a life sentence"

and bringing "an action under the Freedom of Information Act"). Considering Mr. Tormasi's patent enforcement action with potential monetary relief as conducting business, while allowing enforcement of other rights seeking monetary relief, is, on its face arbitrary.

Similarly situated prisoners should not be treated arbitrarily and can only be treated differently when the disparate treatment is rationally related to a legitimate state interest. *Pennsylvania v. Finley*, 481 U.S. 551 (1987) (asserting in accordance with the Equal Protection Clause there is no rational basis for assuming petitions submitted by indigents are any less meritorious); *Gulf, Colo. & Santa Fe Fy. Co. v. Ellis*, 165 U.S. 150, 165–66 (1897) (stating that a classification "based upon some reasonable ground—some difference which bears a just and proper relation to the attempted classification—and is not a mere arbitrary selection"). Indeed, the disparate treatment of inmates must be rationally related to a legitimate penological interest. *Jones v. N.C. Prisoners' Labor Union, Inc.*, 433 U.S. 119 (1977).

Western Digital, in its motion to dismiss, briefly addressed the applicable law stating as follows:

> The "rational connection between the no-business rule and the legitimate penological objective of maintaining security and efficiency at state correctional institutions," articulated by the Tormasi II court – e.g., "operating a business inside a correctional facility would seriously burden operation of incoming and outgoing mail procedures," and "could result in the introduction of contraband into prisons" (Tormasi II, at *32) – are particularly compelling here.

App.63a.

Western Digital has provided insufficient evidence that enforcing a federally granted right, via an Article III tribunal could "seriously burden operation of incoming and outgoing mail procedures" and "could result in the introduction of contraband into prisons." *Turner*, 482 U.S. at 90; *Shimer v. Washington*, 100 F.3d 506, 509–10 (7th Cir. 1996) (under *Turner*, "the prison administration must proffer some evidence to support its restriction of . . . rights. The prison administration cannot avoid court scrutiny by reflexive, rote assertions.") (citations and internal quotations omitted); *DeMallory v. Cullen*, 855 F.2d 442, 448 (7th Cir. 1988) ("Generalized security concerns, however, are insufficient to support such a ban. Instead, prison officials must come forward with evidence that the specific contact at issue threatens security and must show that less restrictive measures, such as precounseling searches, are not possible."); *Caldwell v. Miller*, 790 F.2d 589, 596 (7th Cir. 1986) ("It is critically important that the record reveal the manner in which security concerns are implicated by the prohibited activity.").

Litigation in and of itself is not a security risk or overly burdensome as evidenced by the plethora of cases litigated by prisoners, *pro se* or otherwise, and the Corrections Department's own administrative policy of facilitating access to the court. Margo Schlanger, *Inmate Litigation*, 116 HARV. L. REV. 1555 (2003). For example, Section 10A:4-3.1 provides that prisoners "have the right to unrestricted and confidential access to the courts by correspondence." N.J. ADMIN. CODE § 10A:4-3.1 (2021). Its irrational to suggest that patent litigation poses a greater security risk or is more detrimental to penological efficiency than any other

civil action such as those brought under 42 U.S.C. § 1983. *See Thomas v. Cumberland County*, 749 F.3d 217 (3d Cir. 2014); *Leamer v. Fauver*, 288 F.3d 532 (3d Cir. 2002); *Monmouth County Correctional Institutional Inmates v. Lanzaro*, 834 F.2d 326 (3d Cir. 1987); *Duran v. Merline*, 923 F.Supp.2d 702 (D. N.J. Feb. 8, 2013).

The lower courts' holding is solely based on the arbitrary determination that seeking monetary relief for patent infringement is tantamount to running a business but seeking monetary relief based on other civil actions such as §1983 is not. Accordingly, the lower courts' interpretation is unfounded and results in a violation of equal protection.

Prisoners already notoriously fare far worse than other civil litigants. *See* Margo Schlanger, *Inmate Litigation*, 116 HARV. L. REV. 1555 (2003). Failure to correct this erroneous precedent not only subjects Mr. Tormasi to manifest injustice but plagues future prisoners with unequal protection of the law in violation of the Constitution and creates a slippery slope for widespread injustice. *Kline v. Johns-Manville*, 745 F.2d 1217, 1221 (9th Cir. 1984); *Schmidt v. Polish People's Republic*, 742 F.2d 67, 70 (2d Cir. 1984). This precedent would subject the legal claims and capacity of prisoners to the mercy of administrative prison policy.

### C. *Lewis* Did Not Categorically Eliminate a Prisoner's Constitution Right to Access the Courts for General Civil Actions

It is "established beyond doubt that prisoners have a constitutional right of access to the courts." *Bounds v. Smith*, 430 U.S. 817, 821 (1977). Prisoners'

right to access to the courts requires providing "affirmative assistance in the preparation of legal papers in cases involving constitutional rights and other civil rights actions related to their incarceration, but in all other types of civil actions, states may not erect barriers that impede the right of access of incarcerated persons." *Simkins v. Bruce*, 406 F.3d 1239, 1242 (10th Cir. 2005) (citing *Snyder v. Nolen*, 380 F.3d 279, 290–91 (7th Cir. 2004)); *Bounds*, 430 U.S. at 833–34 (Burger, CJ., dissenting). This Court's decision in *Lewis v. Casey,* stating that "*Bounds* does not guarantee inmates the wherewithal to transform themselves into litigating engines capable of filing everything from shareholder derivative actions to slip-and-fall claims," has, however, resulted in varying, inconsistent, and draconian applications of this case. 518 U.S. 343, 355 (1996).

Prior to *Lewis*, this Court, in *Johnson v. Avery*, found that "it is fundamental that access of prisoners to the courts for the purpose of presenting their complaints may not be denied or obstructed." 393 U.S. 483, 485 (1969). Accordingly, the Court struck down a regulation prohibiting prisoners from assisting each other with habeas corpus petitions and other legal matters. *Id.* at 490. The Court reasoned that because prisoners had no alternative form of legal assistance available to them, a ban on jailhouse lawyers effectively prevented prisoners lacking adequate knowledge from representing themselves in challenging the legality of their confinement. *See also Ex parte Hull*, 312 U.S. 546, 549 (1941) ("[T]he state and its officers may not abridge or impair petitioner's right to apply to a federal court for a writ of habeas corpus.").

Prisoners' access to the courts is not limited to habeas corpus petitions. In *Wolff v. McDonnell*, this Court recognized that the right to access the courts covers assistance in civil rights actions. 418 U.S. 539 (1974). In doing so, the Court found that there is "no reasonable distinction" between the civil rights actions and habeas petitions. *Id.* at 580. The Court reasoned that "[t]he right of access to the courts . . . is founded in the Due Process Clause and assures that no person will be denied the opportunity to present to the judiciary allegations concerning violations of fundamental constitutional rights."[5] *Id.* at 579. Thus, the constitutional right of access to the courts, for inmates or otherwise, extends beyond habeas petitions.

Many courts have recognized that access to the courts is not limited to "constitutional and civil rights actions" and is applicable to other civil actions. In *Straub v. Mange*, for example, the Eleventh Circuit acknowledged that the right to access the courts "long precedes *Bounds,* and has from its inception been applied to civil as well as constitutional claims." 815 F.2d 1467, 1470 (11th Cir. 1987), *cert. denied*, 484 U.S. 946 (1987) (noting that "the Fifth Circuit, in *Jackson v. Procunier*, 789 F.2d 307, 311 (5th Cir. 1986), rejected the proposition that a prisoner's right of adequate, effective, and meaningful access to the courts . . . is limited to the presentation of constitutional, civil rights, and habeas corpus claims."); *Nordgren v. Miliken,* 762

[5] Property rights are fundamental rights. *See Truax v. Corrigan*, 257 U.S. 312, 327 (1921) (recognizing fundamental property rights); *W.Va. State Bd. of Educ. v. Barnette*, 319 U.S. 624, 638 (1943) ("One's right to life, liberty, and property, to free speech, a free press, freedom of worship and assembly, and other fundamental rights may not be submitted to vote; they depend on the outcome of no elections.").

F.2d 851, 853 (10th Cir. 1985) ("Access to the courts 'encompasses all the means a defendant or petitioner might require to get a fair hearing from the judiciary on all charges brought against him or grievances alleged by him.'"), *cert. denied*, 474 U.S. 1032 (1985); *Corpus v. Estelle,* 551 F.2d 68, 70 (5th Cir. 1977) ("[R]easonable access to the courts must include access in general civil legal matters including but not limited to divorce and small civil claims.").

In 1996, this Court decided *Lewis v. Casey*, a case brought by a class of inmates of various prisons in Arizona against the Arizona Department of Corrections (ADOC) officials. 518 U.S. 343, 346–47 (1996). The question presented in *Lewis* was whether under *Bounds* inmates have a freestanding right to a law library or legal assistance. *Id.* at 351. Finding no such abstract right to a law library or legal assistance, this Court reversed the judgment of the Ninth Circuit which affirmed an injunction mandating detailed, systemwide changes in prison law libraries, and legal assistance programs. *Id.* at 364. In finding so, the Court stated that "*Bounds* does not guarantee inmates the wherewithal to transform themselves into litigating engines capable of filing everything from shareholder derivative actions to slip-and-fall claims. The tools it requires to be provided are those that the inmates need in order to attack their sentences, directly or collaterally, and in order to challenge the conditions of their confinement." *Id.* at 355. But the Court did not eliminate inmates' rights to present their claims to the courts altogether. In fact, the Court emphasized that it is the courts' duty "to remedy past or imminent official interference with individual inmates' presentation of claims to the courts." *Id.* at 349.

Post *Lewis*, however, some courts, relying on the "litigating engines" language of *Lewis*, have applied an unduly narrow interpretation of the constitutional right of access to the court—effectively limiting it to claims relating to the underlying conviction or conditions of confinement. In *Clewis v. Hirsch*, for example, the Fifth Circuit, departing from its precedent in *Jackson v. Procunier,* reasoned that a constitutional right to access the courts is only applicable to nonfrivolous claims "regarding [the] underlying *conviction* or *conditions of confinement*." 700 F. App'x 347, 348–49 (2017) (emphasis added). In doing so, the court explained that *Jackson* antedated this Court's decision in *Lewis*, which now demands a different interpretation than access to the court for general civil matters. *Id.* (citing *Lewis*, 518 U.S. at 355).

The Fifth Circuit is not alone in adopting an unduly narrow interpretation of *Lewis*. *See e.g., Simmons v. Sacramento County Superior Court*, 318 F.3d 1156, 1160 (9th Cir. 2003) ("In other words, a prisoner has no constitutional right of access to the courts to litigate an unrelated civil claim."); *Ross v. Clerk of Courts of the Court of Common Pleas*, 726 F. App'x 864, 865 (3d Cir. 2018) ("As a prisoner, Ross' right of access to the courts does not extend to his medical malpractice action. '[P]risoners may only proceed on access-to-courts claims in two types of cases, challenges (direct or collateral) to their sentences and conditions of confinement.'") (quoting *Monroe v. Beard*, 536 F.3d 198, 205 (3d Cir. 2008)); *Riva v. Brasseur*, No. 15-2554, 2016 U.S. App. LEXIS 23932, at *3 (1st Cir. 2016); *Amaker v. Fischer*, 453 F. App'x 59, 63 (2d Cir. 2011) ("'The right of access to the courts requires that prisoners defending against criminal charges or convictions (either directly or collaterally) or challenging the

conditions of their confinement . . . not be impeded from presenting those defense and claims for formal adjudication by a court.'") (quoting *Bourdon v. Loughren*, 386 F.3d 88, 96 (2d Cir. 2004)).

Not all circuits, however, agree that the constitutional right to access the courts is limited to the underlying conviction or conditions of confinement. *See Simkins*, 406 F.3d at 1242 (concluding that while states do not have an affirmative duty to assist prisoners with general civil matters, they "may not erect barriers that impede the right of access of incarcerated persons.") (citing *Snyder*, 380 F.3d at 290–91). Indeed, post *Lewis*, the scope of the constitutional right of access to the courts for prisoners remains unclear.[6] *See*

---

[6] The ambiguity in defining the scope of the constitutional right to access the courts may be rooted in the source of the constitutional right. *See Knop v. Johnson*, 977 F.2d 996 (6th Cir. 1992).

> The Court's opinion in *Bounds* is silent as to the source of this right, but on other occasions the Supreme Court has said variously that it is founded in the Due Process Clause of the Fourteenth Amendment, *Wolff v. McDonnell*, 418 U.S. 539, 579 (1974); *Procunier v. Martinez*, 416 U.S. 396, 419 (1974), or the Equal Protection Clause, *Pennsylvania v. Finley*, 481 U.S. 551, 557 (1987); *Murray v. Giarratano*, 492 U.S. 1, 7, and *see id.* at 11 n. 6 (1989) (plurality opinion of Rehnquist, C.J.), or the First Amendment right to petition for a redress of grievances, *Turner v. Safley*, 482 U.S. 78, 84 (1987) (citing *Johnson v. Avery*, 393 U.S. 483 (1969)); *Hudson v. Palmer*, 468 U.S. 517, 523 (1984) (same). Lower courts have also implicated the Privileges and Immunities Clause of Article IV. *Nordgren v. Milliken*, 762 F.2d 851, 853 (10th Cir.), *cert. denied*, 474 U.S. 1032 (1985); *Smith v. Maschner*, 899 F.2d 940, 947 (10th Cir. 1990). *See generally John L. v. Adams*, 969 F.2d 228, 231-32 (6th Cir. 1992) . . . One Court of Appeals has suggested, with respect to principles developed under the "right of access" rubric, that "because their

*Clewis*, 700 F. App'x at 348 ("The precise contours of a prisoner's right of access to the courts remains somewhat obscure."); *Earl v. Fabian*, 556 F.3d 717, 726 (8th Cir. 2009) ("Access to the courts is a constitutional right whose basis is unsettled.") (citation omitted). Courts struggle to demarcate the contours of prisoners' constitutional right of access to the courts.

In *Simkins*, the Tenth Circuit attempted to clarify inmates' constitutional right to access courts. 406 F.3d 1239. In doing so, the court explained that "a meaningful right of access to the courts" requires states to (1) "provide affirmative assistance in the preparation of legal papers in cases involving constitutional rights and other civil rights action related to their incarceration" and (2) "not erect barriers that impede the right to access" the courts "in all other types of civil actions." *Id.* at 1242 (citing *Synder*, 380 F.3d at 290–91). *Simkins'* ruling parallels the Sixth Circuit's analysis in *Knop v. Johnson*. *Knop*, 977 F.2d at 996 ("Our own court, similarly, has read *Bounds* as requiring affirmative assistance for incarcerated juveniles only in 'the preparation of legal papers in cases involving constitutional rights and other civil rights action related to their incarceration' . . . [a]s to other types of civil actions . . . 'states may not erect barriers that impede the right of access."), *cert. denied*, 113 S. Ct. 1415 (1993). Accordingly, as interpreted by courts in different circuits, it remains unresolved whether this Court's

---

textual footing in the Constitution is not clear, these principles suffer for lack of internal definition and prove far easier to state than to apply." *Morrow v. Harwell*, 768 F.2d 619, 623 (5th Cir. 1985)) *cert. denied*, 113 S. Ct. 1415 (1993).

*Id.* at 1002–1003.

decision in *Lewis* clarified one-prong of the multifaceted constitutional right to access the courts or delineated the entire scope of an inmate's constitutional right to access the courts.

This Court has long recognized that access to the courts is fundamental to the fabric of a democratic society. *Lessee of Pollard's Heirs v. Kibbe*, 39 U.S. 353, 374 (1840) ("It is also agreed, that the inhabitants of the territory of each party, shall respectively have free access to the Courts of justice of the other.") (M'Lean, J., concurring). This Court's precedent is clear that indigent, condemned, or outcast individuals cannot be deprived of their rights and the constitutional foundation of redressing them—via access to the courts. *Ex parte Hull*, 312 U.S. 546 (discussing the constitutional right of access to the courts for a civil habeas corpus action); *Wolff*, 418 U.S. 539 (equating civil rights actions to habeas corpus petitions in the context of the constitutional right to access the courts); *Cruz v. Hauck*, 404 U.S. 59, 60 (1971) (Douglas, J., concurring) ("Prisoners are not statistics, known only to a computer, but humans entitled to all the amenities and privileges of other persons, save as confinement and necessary security measures curtail their activities."). *See also Bruce v. Samuels*, 577 U.S. 82, 86 (2016) (explaining that Congress intended to maintain access to the courts for nonfrivolous prisoner litigation when it enacted 28 U.S.C. § 1915 (b)(4) "[i]n no event shall a prisoner be prohibited from bringing a civil action."). The Eleventh Circuit has summarized this Court's precedent as:

> All of these decisions simply removed barriers to court access that imprisonment or indigency erected. They in effect tended to place prisoners in

> the same position as non-prisoners and indigent prisoners in the same position as non-indigent prisoners. Having held that inmates can represent themselves, if able to do so, and can help other inmates who are not so able, it was but a small step to hold that such able inmates, who presumably would have access to libraries but for imprisonment, must be given access to libraries in prison, or access to people who have access to libraries. This is a far cry from constitutionally requiring the state to provide legal counsel for the imprisoned, not available as a matter of constitutional right to the unimprisoned in civil cases.

*Hooks v. Wainwright*, 775 F.2d 1433, 1435 (11th Cir. 1985), *cert. denied*, 479 U.S. 913 (1986). The principle that "the civil courts of the United States . . . belong to the people of this country and [] no person can be denied access to the courts" is well recognized. *Cruz*, 404 U.S. at 64 (Douglas, J., concurring) (citation omitted). In *Boddie v. Connecticut*, for example, this court held that an indigent person could not be denied access to civil court for marital matters. 401 U.S. 371 (1971) ("due process requires . . . that "*wherever* one is assailed in his person or his property, there he may defend.") (quoting *Windsor v. McVeigh*, 93 U.S. 274, 277 (1876)) (emphasis added).

This Court has never opined that, upon incarceration, inmates forfeit access to the courts for civil matters altogether. Rendering *Lewis* inapposite. Rather, exercising judicial restraint, it has meticulously limited its decisions strictly to the issues before it—whether constitutional access to the courts extends to habeas corpus or civil rights actions. In *Wolff*, for example, Petitioners contended "that *Avery* [was]

limited to assistance in the preparation of habeas corpus petitions." 418 U.S. at 579. Answering that question, the Court clarified that the scope of the constitutional right to access the courts entails civil rights actions. 418 U.S. at 576. Likewise, here, it is improper, to rely on rulings like *Wolff* and *Avery* to advocate that inmates forfeit their right to access the courts for general civil actions, as Western Digital implicitly does by advocating absence of capacity. App.108a-111a. Mr. Tormasi has a constitutional right to access the court to enforce his statutorily granted property rights. And, his right should not be hindered by the application of an administrative rule.

For these reasons alone, this Court should overturn the lower courts' rulings.

## CONCLUSION

Mr. Tormasi asks the Court to reverse the judgment of the Federal Circuit and remand for further proceedings on the merits of Mr. Tormasi's patent infringement lawsuit.

Respectfully submitted,

THOMAS A. LEWRY
*Counsel of Record*
REZA ROGHANI ESFAHANI
DUSTIN ZAK
LEROY ASHLEY
BROOKS KUSHMAN P.C.
1000 Town Center, 22nd Floor
Southfield, Michigan 48075
(248) 358-4400
tlewry@brooks.law

April 2, 2021

*Attorneys for Petitioner*