

IN THE
Supreme Court of the United States

PARKERVISION, INC.,

Petitioner,

v.

TCL INDUSTRIES HOLDINGS CO., *et al.*,

Respondents.

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

PETITION FOR A WRIT OF CERTIORARI

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November 4, 2024



QUESTION PRESENTED

Section 144 of the Patent Act directs the Federal Circuit to decide appeals from the Patent Trial and Appeal Board (PTAB) by issuing “opinion[s].” 35 U.S.C. § 144. The word *opinion* is a legal term of art. It has long meant a court’s statement of reasons for a decision, and it is distinct from a *judgment*. Congress had also required the Federal Circuit’s predecessor to issue opinions in patent agency appeals. And it made sense for Congress to retain that reasoning-giving directive when it created the Federal Circuit: the court’s mandate was to clarify the legal standards for invention patents. Uncertainty stifles innovation. The Federal Circuit’s first Chief Judge, the Honorable Howard T. Markey, thus said: “In our Court there will be an opinion explaining enough to tell you what the law is in every case.” He added: “We do not just render a one-worded decision and go away.” In recent years, though, the Federal Circuit has routinely issued one-word “judgment[s] of affirmance without opinion” under Federal Circuit Rule 36(a), saying only “AFFIRMED” rather than issuing an opinion. That happened here. The PTAB invalidated claims in ParkerVision’s already issued patents through inter partes review, a peculiar process that flouts due-process principles; and the Federal Circuit summarily affirmed. So, ParkerVision has been deprived of vested property rights, yet no court has ever explained why, despite § 144’s text.

The question presented is: Whether 35 U.S.C. § 144, which requires the Federal Circuit to issue “opinion[s]” in PTAB appeals, is a reason-giving directive that prohibits the Federal Circuit’s practice, under Federal Circuit Rule 36(a), of summarily affirming PTAB decisions without issuing opinions.

PARTIES TO THE PROCEEDINGS

Petitioner

- ParkerVision, Inc.

Respondents

- TCL Industries Holdings Co., (TCL)
- LG Electronics Inc. (LGE)

RULE 29.6 STATEMENT

ParkerVision has no parent corporation and no publicly held corporation owns 10% or more of its stock.

LIST OF PROCEEDINGS

U.S. Court of Appeals for the Federal Circuit

No. 2023-1415

*ParkerVision, Inc. v. TCL Indus. Holdings Co. and
LG Electronics Inc.*

Date of Final Judgment: June 5, 2024

U.S. Court of Appeals for the Federal Circuit

No. 2023-1417

*ParkerVision, Inc. v. TCL Indus. Holdings Co. and
LG Electronics Inc.*

Date of Final Judgment: June 5, 2024

Patent Trial and Appeal Board

No. IPR2021-00985

*TCL Indus. Holdings Co. and LG Electronics Inc. v.
ParkerVision, Inc.*

Date of Final Decision: November 17, 2022

Patent Trial and Appeal Board

No. IPR2021-00990

*TCL Indus. Holdings Co. and LG Electronics Inc. v.
ParkerVision, Inc.*

Date of Final Decision: November 21, 2022

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PETITION FOR A WRIT OF CERTIORARI

ParkerVision respectfully requests a writ of certiorari to review the judgment of the U.S. Court of Appeals for the Federal Circuit.



DECISIONS BELOW

The Federal Circuit's judgments are unreported but available at *ParkerVision, Inc. v. TCL Indus. Holdings Co.*, No. 2023-1415, 2024 WL 2842282 (Fed. Cir. June 5, 2024), and No. 2023-1417, 2024 WL 2842279 (Fed. Cir. June 5, 2024). They are reprinted in the Appendix to the Petition (App.) at 1a-2a, 111a-112a. The final written decisions of the PTAB are unreported but reprinted at App.3a-86a, 113a-233a.



JURISDICTION

The Federal Circuit entered its judgments on June 5, 2024. On August 28, 2024, the Chief Justice granted ParkerVision's applications to extend the time to file this petition until November 2, 2024. This petition is thus timely filed under Sup. Ct. R. 13. This Court has jurisdiction under 28 U.S.C. § 1254(1).



STATUTORY PROVISION INVOLVED

35 U.S.C. § 144 provides:

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 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.



INTRODUCTION

Under § 144 of the Patent Act, the Federal Circuit “shall issue” an “opinion” in an appeal from a final decision by the Patent Trial and Appeal Board (PTAB), an administrative body of the U.S. Patent and Trademark Office (PTO). 35 U.S.C. § 144. The word *opinion* has deep roots in American law. It is a legal term of art. Since the founding, it has meant—and it still means—a court’s statement of reasons for its decision. It is distinct from the *judgment*, which is the final determination of the parties’ rights.

Congress understood—or must be presumed to have understood—that by requiring the Federal Circuit to issue an *opinion* in a PTAB appeal, it was requiring the Federal Circuit to give reasons for its decision. When Congress employed *opinion*, Congress swept in the word’s old soil: a rich history and tradition, in

American legal culture, of calling a court's statement of reasons an *opinion*. Indeed, reason-giving is at the heart of the cluster of ideas constituting the term.

Here, however, the Federal Circuit summarily affirmed the PTAB's patent-invalidation decisions under Federal Circuit Rule 36—without issuing opinions and saying only “AFFIRMED.” The Federal Circuit therefore violated § 144—just as it has done in 58 other PTAB appeals so far in 2024. (See *infra* at 32.) As a result of the Federal Circuit's statutory violations, no court has ever explained to ParkerVision and numerous other technology companies why claims in their already issued patents were invalidated, and why their vested property rights were canceled.

Congress had good reason to require the Federal Circuit to give reasons. From 1929 to 1982, the Federal Circuit's predecessor, the Court of Customs and Patent Appeals (CCPA), was statutorily required to issue “opinion[s]” in appeals from the PTO's predecessor, the Patent Office. 28 U.S.C. § 216 (repealed 1982). After Congress replaced the CCPA with the Federal Circuit in 1982, Congress promptly revived the statutory opinion-writing requirement. By requiring the Federal Circuit to give reasons for its decisions in patent agency appeals, Congress promoted the very point of the Federal Circuit: to bring uniformity, stability, and coherence to the legal standards for invention patents. So in 1984, Congress amended 35 U.S.C. § 144 to its current form. The Federal Circuit's first Chief Judge, the Honorable Howard T. Markey, declared: “In our Court there will be an opinion explaining enough to tell you what the law is in every case.” *The First Annual Judicial Conference of the United States Court of*

Appeals for the Federal Circuit, 100 F.R.D. 499, 511 (1983) (“We do not just render a one-worded decision and go away.”).

Interpreting § 144 as a reason-giving requirement also makes sense, and cannot be an absurd literalism, given that reason-giving serves multiple adjudicative goals: accountability, transparency, perceived legitimacy, accuracy, and dignity, to name a few. As Professor Mary Ann Glendon put it, the “[d]iscipline of writing out the reasons for a decision and responding to the main arguments of the losing side has proved to be one of the most effective curbs on arbitrary judicial power ever devised.” *A Nation Under Lawyers: How the Crisis in the Legal Profession is Transforming American Society* 147-48 (1994).

Resisting an atextual interpretation of § 144 avoids serious constitutional problems, as well. Here, the PTAB invalidated claims in ParkerVision’s patents through inter partes review, a highly idiosyncratic administrative process where a panel of PTAB members reassesses the validity of already issued patents. The PTO Director, a political appointee, decides which PTAB members will serve on a particular panel, and how many, and determines their salary. They receive bonuses based on their productivity and commitment to the PTO’s mission. They decide both (i) whether to institute an inter partes review (based on a petition, brought by anyone who does not own the patent, challenging the patent), and (ii) whether to invalidate the patent (based on the petitioner’s and the patent-holder’s papers). Additional petitioners may join the inter partes review midstream, and if all the petitioners drop out, the PTAB panel may proceed. Given inter partes review’s deviations from the principles of judi-

cial independence and justiciability that underlie our Article III courts, due process may very well demand that if a patent holder challenges, in the Federal Circuit, an inter partes review that invalidated an already issued patent, the Federal Circuit must give reasons for its decision.

Critically, construing § 144 as a reason-giving directive will not deluge the Federal Circuit with additional work. An opinion can be pithy. In ParkerVision's view, the Federal Circuit would satisfy § 144 by issuing a one-paragraph document identifying the grounds for reversal or vacatur that the appellant has raised and stating why they fail. This construction of § 144 would have required the Federal Circuit to have written sixty more paragraphs so far this year. Even if this Court disagrees with ParkerVision's position, it should grant the petition to draw the correct line, or to explain why a one-word affirmance suffices.

The question presented is important and recurring, and this case is an ideal vehicle to resolve it. Inventors, technology companies, parties before the PTAB and the Federal Circuit, the patent bar, judges (including former Federal Circuit judges), and scholars have been protesting the Federal Circuit's use of Rule 36 for several years. The chorus of criticism is only growing louder. The petition for certiorari should be granted.



STATEMENT OF THE CASE

A. ParkerVision's Patents

ParkerVision—the petitioner here, the appellant in the Federal Circuit, and the patent owner in the PTAB proceedings—develops advanced wireless solutions for communications networks. TCL and LGE—the respondents here, the appellees in the Federal Circuit, and the petitioners in the PTAB proceedings—produce electronic devices.

In the mid-1990s, inventor Jeffrey L. Parker set his sights on breaking an engineering logjam in the field of wireless communications. The fundamental architecture of the technology for wireless signal generation and reception was severely outdated—decades old in mobile phones, and a century old in receivers. Wireless products were running on super-heterodyne, a power-hungry technology that required large circuitry and numerous components. As a result, mobile phones would die quickly and process data slowly. Undeterred by the wireless industry's path dependency, and dissatisfied with the status quo, Parker formed ParkerVision. By the late 1990s, the company had a breakthrough: lead inventor David Sorrells conceived energy transfer sampling. This paradigm shift ushered in smaller, more efficient, and higher performing wireless products. Today, countless smartphones, WiFi devices, and satellite communications employ ParkerVision's energy transfer sampling technology, which enables them to accommodate lower-cost computer chips that use less power, to work over worldwide bands of radio frequencies and multiple

standards, and to process data at higher rates. App.62a-63a.

ParkerVision sought intellectual-property protection for its ground-breaking inventions, and the PTO granted its applications, issuing the '444 patent in 2006 and the '835 patent in 2007. Fed. Cir. No. 2023-1415, J.A. 143; Fed. Cir. No. 2023-1417, J.A. 101.

In broad strokes: When Person A speaks into a mobile phone during a call with Person B, Person A's phone up-converts Person A's voice—which is a low-frequency, baseband signal—into a high-frequency, carrier signal. Unlike the human voice, the carrier signal can be transmitted a long distance through the air to Person B's phone. Once the carrier signal gets there, Person B's phone down-converts the carrier signal back into a baseband signal, and Person B hears Person A's voice. Fed. Cir. No. 2023-1415, Appellant Br. (C.A.Br.) 1-5.

The ParkerVision patents at issue revolved around its revolutionary down-conversion system: energy transfer sampling. A different down-conversion system under consideration in the wireless-technology community was *voltage* sampling, which measured only a carrier signal's voltage. *Energy* transfer sampling, in contrast, transferred the carrier signal's energy so as to use the transferred energy to form a baseband signal, resulting in far greater performance. C.A.Br. 14.¹

¹ Energy transfer sampling accomplishes that feat by (i) transferring non-negligible amounts of energy during a carrier-signal sample period directly to a low-impedance load and simultaneously to a capacitor (“storage element”), and (ii) discharging, between sample periods, the stored energy to the load. The sampling performs down-conversion to a baseband signal; the

B. PTAB Proceedings

The Leahy-Smith America Invents Act (AIA) authorizes the PTAB to administer various patent-related proceedings, including inter partes review. Pub. L. No. 112-29, § 6, 125 Stat. 284, 299-313 (2011). Under this process, “a person who is not the owner of a patent” may file a petition with the PTAB seeking reconsideration and cancellation of any claim in an already issued patent on the ground that it was anticipated or obvious. 35 U.S.C. § 311; *see also id.* § 102 (novelty); *id.* § 103 (non-obviousness).

In May 2021, TCL filed a petition for inter partes review seeking to invalidate certain claims of the ’444 patent, and a second petition seeking to invalidate certain claims of the ’835 patent. The PTAB instituted the reviews. LGE then filed two petitions challenging the same patent claims on the same grounds, which the PTAB instituted and joined with the corresponding TCL inter partes reviews. App.4a, 114a-115a.

The petitions argued that certain claims in ParkerVision’s patents were obvious in light of the

continuous energy flow at the load forms a baseband signal during and between samples. Voltage sampling, however, does not transfer the carrier signal’s energy. Rather, its capacitor (“holding element”) merely holds a negligible amount of energy so as to provide an accurate voltage per sample, which is then measured to represent the baseband. Whereas a voltage sampling circuit discards energy from the sampled carrier signal without using the energy in the down-converted signal and thereby wastes energy and limits performance, an energy transfer sampling circuit uses non-negligible energy from the carrier signal to a low impedance load so that the down-converted energy itself forms the down-converted signal. An energy transfer system thus results in a higher-quality baseband signal and allows for smaller, less costly, and more efficient wireless devices. C.A.Br. 6-15.

prior art, *see* 35 U.S.C. § 103. App.7a-8a, 117a-119a. In response, ParkerVision demonstrated that the proffered prior-art references were inapposite, as they described a *voltage* sampling system that merely held energy without storing it for down-conversion—not an *energy* sampling system. C.A.Br. 62-63.

Notably absent from the petitions and the supporting declarations was any argument that capacitors in the prior art stored non-negligible amounts of energy. App.97a, 235a-236a. In fact, the petitions and supporting declarations made no mention of the terms “non-negligible,” “negligible,” or “energy.” App.92a-93a, 236a-237a; C.A.Br. 64.

In their replies, TCL and LGE argued—for the first time—that capacitors in the prior art stored non-negligible amounts of energy. App.91a-93a, 235a-236a; C.A.Br. 64-65.

In November 2022, the PTAB issued its final written decisions, which adopted TCL and LGE’s arguments and determined that the challenged patent claims in both petitions were obvious and thus invalid under 35 U.S.C. § 103. App.3a-86a, 113a-233a.

C. Federal Circuit Proceedings

Section 141 of the Patent Act authorizes a party “dissatisfied with” a final decision by the PTAB to appeal that decision to the Federal Circuit. 35 U.S.C. § 141. Sections 142 to 144 enumerate the requirements for the notice of appeal, the Federal Circuit proceedings, and the Federal Circuit’s decision. *Id.* §§ 142-44.

ParkerVision timely appealed the PTAB’s final written decisions to the Federal Circuit. Among other arguments, ParkerVision argued that the prior art

references were inapposite, and that the PTAB had improperly based its cancellation decision on forfeited arguments. C.A.Br. 62-78.

In each appeal, the Federal Circuit summarily affirmed the PTAB's decision, without opinion, under Federal Circuit Rule 36(a). App.1a-2a, 111a-112a.

This petition followed.



REASONS FOR GRANTING THE PETITION

I. THE FEDERAL CIRCUIT'S RULE 36 PRACTICE OF SUMMARILY AFFIRMING PTAB DECISIONS WITHOUT ISSUING OPINIONS VIOLATES THE PATENT ACT'S REASON-GIVING REQUIREMENT.

A. Section 144 of the Patent Act Requires the Federal Circuit to Issue an *Opinion*, a Legal Term of Art Meaning a Statement of Reasons.

Under § 144 of the Patent Act—titled “Decision on Appeal”—the Federal Circuit “shall review the decision from which an appeal is taken on the record before the [PTO],” and “[u]pon its determination, the court shall issue to the Director [of the PTO] its mandate *and opinion*, which shall be entered of record in the [PTO] and shall govern the further proceedings in the case.” 35 U.S.C. § 144 (emphasis added); *see also id.* § 141 (showing that § 144 applies to PTAB appeals).

When Congress amended § 144 of the Patent Act in 1984² to require the Federal Circuit to issue an

² See Act of Nov. 8, 1984, Pub. L. No. 98-620, title IV, § 414(a),

“opinion” in an appeal from the PTAB, Congress knew—or it must be presumed to have known—that it was requiring the Federal Circuit to issue a statement of reasons for its decision. An *opinion* is a legal term of art with a settled meaning: a court’s “expression of the reasons why a certain decision (the judgment) was reached in a case.” See BLACK’S LAW DICTIONARY 985 (5th ed. 1979). An *opinion* is distinct from a *judgment*, which is the “final decision of the court resolving the dispute and determining the rights and obligations of the parties.” *Id.* at 755. A *mandate*, meanwhile, is an appellate court’s order “directing action to be taken, or disposition to be made of case,” by the “inferior” adjudicative body, *id.* at 867; see also *Comm’r v. Bedford’s Est.*, 325 U.S. 283, 287 (1945) (distinguishing “Opinion” from “Order for Mandate”); *Rogers v. Hill*, 289 U.S. 582, 587 (1933) (“The court’s decision of a case is its judgment thereon. Its opinion is a statement of the reasons on which the judgment rests.”).

What is more, “[w]here Congress borrows terms of art in which are accumulated the legal tradition and meaning of centuries of practice, it presumably knows and adopts the cluster of ideas that were attached to each borrowed word in the body of learning from which it was taken and the meaning its use will convey to the judicial mind unless otherwise instructed.” *Molzof v. United States*, 502 U.S. 301, 307 (1992) (discussing *punitive damages*) (quoting *Morissette v. United States*, 342 U.S. 246, 263 (1952)). Put differently, “[w]hen a statutory term is obviously transplanted from another legal source, it brings the old soil with

98 Stat. 3363 (1984).

it.” *Taggart v. Lorenzen*, 587 U.S. 554, 560 (2019) (punctuation omitted).

An *opinion* is a legal term of art with a rich history and tradition, and its meaning has never wavered. As Thomas Jefferson recounted: “From the earliest ages of English law, from the date of the year-books, at least, to the end of the II^d George, the judges of England in all but self-evident cases, delivered their opinions seriatim, with the reasons and authorities which governed their decisions.” Karl M. ZoBell, *Division of Opinion in the Supreme Court A History of Judicial Disintegration*, 44 CORNELL L. REV. 186, 190 (1959) (quoting Paul L. Ford, *The Writings of Thomas Jefferson* 223-25 (1899) (quoting Letter to Justice William Johnson (1822))). The premise of Jefferson’s preference for seriatim opinion delivery was that *opinions give reasons*—in a seriatim system, no judge can hide. *Id.* at 194. As a fledgling institution, this Court adopted the tradition of the King’s Bench and delivered “opinions” seriatim, which resulted in the Court’s speaking “with multiple voices”—precisely because, again, *opinions give reasons*. William P. McLauchlan, “Opinions, Assignment and Writing Of,” in *The Oxford Companion to the Supreme Court of the United States* 705 (Kermit L. Hall, ed., 2d ed. 2005). Chief Justice Marshall stopped the seriatim custom, and during his stewardship, this Court started rendering a univocal “opinion of the Court”—a reason-giving document. *Id.*

Today, of course, “[o]pinions announce the decision(s) reached by the Supreme Court and explain the reasons for those results.” *Id.* This Court also issues concurring and dissenting opinions, which offer alternative reasons, or what to the author should

have been the reasons. *See id.* And beyond this Court, the understanding of *opinion* as a reason-giving document has remained a fixture of American legal culture more generally. *See* GARNER'S DICTIONARY OF LEGAL USAGE 636 (3d ed. 2011). The old soil therefore resolves the statutory-interpretation question presented: when Congress, in § 144, directed the Federal Circuit to issue an “opinion,” Congress was imposing a reason-giving obligation on the court.

Here, however, the Federal Circuit summarily affirmed the PTAB under Federal Circuit Rule 36. That rule provides: “The court may enter a judgment of affirmance without opinion, citing this rule, when it determines” (i) that “an opinion would have no precedential value” and (as relevant here) (ii) that either “the decision of an administrative agency warrants affirmance under the standard of review in the statute authorizing the petition for review,” or “a judgment or decision has been entered without an error of law.” Fed. Cir. R. 36(a).³

In summarily affirming the PTAB under Rule 36 without issuing an opinion, the Federal Circuit violated § 144's plain text. There is no sense in which a Rule 36 summary affirmance is an *opinion*. Rather than stating reasons, the document states “AFFIRMED.” Rule 36(a) itself says that the document it authorizes is a “judgment of affirmance” that the court may enter “without opinion.” Fed. Cir. R. 36(a). And the Federal Circuit recognizes that a Rule 36

³ The Federal Circuit promulgated its Rule 36 in 1989, five years after § 144 took its current form. *The Seventh Annual Judicial Conference of the United States Court of Appeals for the Federal Circuit*, 128 F.R.D. 409, 420 (1989).

summary affirmance (i) “simply confirms” that the adjudicative body below “entered the correct judgment” and (ii) “does not endorse or reject any specific part” of the “reasoning” under review. *Phil-Insul Corp. v. Airlite Plastics Co.*, 854 F.3d 1344, 1354-55 (Fed. Cir. 2017) (citation and punctuation omitted).

Nor may the Federal Circuit seek refuge in 28 U.S.C. § 2071(a). That statute authorizes courts to “prescribe rules for the conduct of their business,” but it proceeds to state: “Such rules shall be consistent with Acts of Congress.” *Id.* Rule 36 is inconsistent with § 144.

B. The Context Confirms That § 144 Is a Reasoning-Giving Directive.

Even if there were reason to look beyond the text, § 144’s surrounding context reinforces the conclusion that the statute means what it says.

1. Statutory history is relevant when, as here, it is an “important part” of the context. *See United States v. Hansen*, 599 U.S. 762, 775 (2023). In 1929, Congress created the Court of Customs and Patent Appeals (CCPA), the Federal Circuit’s predecessor, and directed that “[t]he opinion of the Court . . . in every case on appeal from decision of the Patent Office shall be rendered in writing, and shall be filed in such case as part of the record thereof, and a certified copy of said opinion shall be sent to the Commissioner of Patents and shall be entered of record in the Patent Office.” Act of Mar. 2, 1929, ch. 488, § 3, 45 Sta. 1475, 1476 (1929).

In 1948, that requirement was codified at 28 U.S.C. § 216. *See* Act of June 25, 1948, ch. 646, 62

Stat. 899 (1948) (codifying 28 U.S.C. § 216 (“The Court of Customs and Patent Appeals, on each appeal from a Patent Office decision, shall file a written opinion as part of the record and send a certified copy to the Commissioner of Patents who shall record it in the Patent Office.”)). That provision remained on the books until 1982, when Congress scrapped the CCPA, repealed the statutory chapter governing it, and created the Federal Circuit—which, unlike the CCPA, would have exclusive jurisdiction over patent appeals, including from district courts, and which was accordingly positioned to unify patent law. *See* Pub. L. No. 97-164, 96 Stat. 28 (1982); 28 U.S.C. § 216 (repealed 1982).

Then, in 1984, § 144 of the 1952 Patent Act was amended from (i) its prior form, which operated alongside 28 U.S.C. § 216 and required the CCPA to 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,” *see* Act of July 19, 1952, Pub. L. No. 593, § 144, 66 Stat. 792, 802 (1952), to (ii) its current form, which requires the Federal Circuit to issue to the PTO Director its “mandate and opinion,” *see* Act of Nov. 8, 1984, Pub. L. No. 98-620, title IV, § 414(a), 98 Stat. 3363 (1984).

In other words, Congress imposed on the Federal Circuit the same opinion-writing requirement that for decades had constrained the court’s predecessor, the CCPA. That requirement had become the norm. The Federal Circuit’s first Chief Judge, the Honorable Howard T. Markey, made the following assurance about the new court in 1983: “In our Court there will be an opinion explaining enough to tell you what the

law is in every case.” 100 F.R.D. at 511. He explained that this patent-appeal “tradition”—“We do not issue fiats. We do not just render a one-worded decision and go away”—reflected a foundational principle of “the American judicial system”: courts ordinarily should “explain [their] decisions.” *Id.* After all, “you would never know what the law is otherwise.” *Id.*

One year later, Congress erased any doubt that the Federal Circuit would not issue one-word decisions in patent agency appeals by reviving the opinion-writing requirement that had previously constrained the CCPA and by imposing it on the court’s new iteration. *See* Dennis Crouch, *Wrongly Affirmed Without Opinion*, 52 WAKE FOREST L. REV. 561, 565 (2017).

2. Interpreting § 144 as a reason-giving requirement promotes Congress’s objectives in creating the Federal Circuit: to “provide nationwide uniformity in patent law,” and to “make the rules applied in patent litigation more predictable.” H.R. Rep. No. 97-312, at 20 (1981); *see also* S. Rep. No. 97-275, at 2 (1981) (“to improve the administration of the patent law by centralizing appeal in patent cases”). Section 144’s reason-giving requirement advances those purposes by facilitating the Federal Circuit’s articulation, development, and clarification of the legal standards applicable to invention patents. The Federal Circuit’s explication of legal standards, through a steady stream of opinions, ensures that all patent-law adjudicators—the Federal Circuit itself, district courts, and PTAB judges—apply a uniform and predictable set of rules. A set of coherent rules, in turn, simplifies patent litigation and preempts unnecessary legal battles. Still more, a shared comprehension of what is, and what is not, patentable enables inventors to

focus their research-and-development efforts on productive pursuits, allows for effective business planning, encourages investment in new technologies, reduces barriers to entry, and supports a fair competitive environment. See *Hunter Douglas, Inc. v. Harmonic Design, Inc.*, 153 F.3d 1318, 1331 (Fed. Cir. 1998) (listing uniformity’s benefits); Paul R. Gugliuzza & Mark A. Lemley, *Can a Court Case Change the Law by Saying Nothing?*, 71 VAND. L. REV. 765, 792 (2018) (arguing that Rule 36 distorts the public perception of patent-law trends).

Through its Rule 36 practice, however, the Federal Circuit is defying Congress’s reason-giving mandate, thereby creating the precise uncertainty that Congress sought to avoid. An appellant-inventor challenging the PTAB’s invalidation of an already issued patent—along with other inventors, the patent bar, and the public—is left in the dark about what specific aspects of the PTAB’s final written decision the Federal Circuit agreed with: one aspect; some aspects; or the decision in its entirety. The Federal Circuit might even have largely disagreed with the PTAB’s decision but nonetheless affirmed because the PTAB committed no *reversible* error.

The interaction between PTAB invalidity proceedings and district court patent-infringement proceedings further exposes the uncertainty that Rule 36 has injected into patent law. A patent challenger quite often seeks an inter partes review after the patent holder has brought a patent-infringement action in district court. The challenger will then often move for, and secure, a stay of the district-court action pending the inter partes review. If the Federal Circuit affirms the PTAB’s invalidity decision in an inter

partes review, that “*affirmance* of [the] invalidity finding . . . has a collateral estoppel effect on all pending or co-pending actions.” *United Therapeutics Corp. v. Liquidia Techs., Inc.*, 74 F.4th 1360, 1372 (Fed. Cir. 2023) (emphasis added) (citation omitted). Collateral estoppel precludes re-litigation of issues “actually litigated and determined.” *Laguna Hermosa Corp. v. United States*, 671 F.3d 1284, 1288 (Fed. Cir. 2012). So, if the Federal Circuit issues a Rule 36 affirmance, the patent holder, the accused infringer, and the district court may have divergent interpretations of collateral estoppel’s scope, because what was “actually determined” is unclear. And the same PTAB decision may end up having inconsistent collateral-estoppel effect in different pending actions. All this further undermines the coherence that creating the Federal Circuit was supposed to engender.

2. In other statutes, Congress has shown that it knows how to avoid imposing reason-giving responsibilities on courts. The Copyright Act provides: “Within one month after any final order or judgment is issued in the [copyright infringement] case, the clerk of the court shall notify the Register [of Copyrights] of it, sending with the notification a copy of the order or judgment together with the written opinion, *if any*, of the court.” 17 U.S.C. § 508(b) (emphasis added). Because Congress has shown that it knows how to use language to render an opinion optional (*e.g., if any*), Congress’s decision not to use any such qualifying language in § 144 of the Patent Act should be treated as a deliberate drafting choice.

3. Reason-giving requirements are not foreign to our federal system. In *United States v. Nugent*, the Sixth Circuit held that the district court had violated

a statutory provision (since repealed) requiring courts to issue “written opinion[s]” in Tucker Act actions. 100 F.2d 215, 216 (6th Cir. 1938) (applying 28 U.S.C. § 764 (repealed 1948)). Federal Rule of Civil Procedure 52(a) requires district courts to make findings of fact and draw conclusions of law in bench trials and when adjudicating interlocutory injunctions, and Federal Rule of Civil Procedure 59 requires district courts to state reasons when they sua sponte grant new trials.

Taylor is not to the contrary. There, the Fifth Circuit summarily reversed, without issuing an opinion. *Taylor v. McKeithen*, 407 U.S. 191, 192 (1972). The appellees sought review in this Court, which granted the petition, vacated, and remanded “[b]ecause this record does not fully inform us of the precise nature of the litigation and because we have not had the benefit of the insight of the Court of Appeals.” *Id.* at 194. This Court added that, despite its direction to the Fifth Circuit, “the courts of appeals should have wide latitude in their decisions of whether or how to write opinions. That is especially true with respect to summary affirmances.” *Id.* at 194 n.4.

ParkerVision’s position comports with *Taylor*’s cautionary footnote. Nothing in the Constitution, and no statute generally applicable to the appellate courts, precludes them from issuing summary affirmances. But § 144 is a specific statute aimed at a particular court, thus disabling that background presumption in this case. As then-Justice Rehnquist noted in dissent, no “existing statute or rule of procedure” barred the Fifth Circuit from deciding the *Taylor* appeal without issuing an opinion, which to him established that the Fifth Circuit was well within its rights to withhold an opinion. *Id.* at 195-96 (Rehnquist, J., dissenting).

Section 144 is what Justice Rehnquist had in mind: it expressly and specifically obligates a particular court, the Federal Circuit, to issue an “opinion.”

4. More fundamentally, interpreting § 144 as a reason-giving requirement harmonizes with bedrock principles of our democracy. Justice Brennan observed that when a court “explain[s] *why* and *how* a given rule has come to be,” such reason-giving “serves a function within the judicial process similar to that served by the electoral process with regard to the political branches of government”: “[i]t restrains judges and keeps them accountable to the law and to the principles that are the source of judicial authority.” William J. Brennan, Jr., *In Defense of Dissents*, 37 HASTINGS L.J. 427, 435 (1986). As Judge Leventhal put the point, “there is accountability in the giving of reasons,” and “[g]rave questions are raised when a court uses ‘judgments’ and ‘orders’ to dispense with any indication of reasons”—as here. Harold Leventhal, *Appellate Procedures: Design, Patchwork, and Managed Flexibility*, 23 UCLA L. REV. 432, 438 (1976). Those grave questions concern nothing less than our government’s structure of separated and limited powers. According to Professor Glendon, *supra*, at 147-48, the “[d]iscipline of writing out the reasons for a decision and responding to the main arguments of the losing side has proved to be one of the most effective curbs on arbitrary judicial power ever devised.” Yet “[t]hose important safeguards are lost when, as is increasingly the case, decisions are rendered without written opinions.” *Id.*; accord Joseph W. Singer, *Normative Methods for Lawyers*, 56 UCLA L. REV. 899, 489-49 (2009) (“the biggest check on the use of judicial power is the duty to give public reasons for decisions, justifying choices by writing judicial

opinions”). Professor Schauer similarly noted that when an institutional designer seeks to rein in a decision-maker, a reason-giving mandate is a reasonable design choice. Frederick Schauer, *Giving Reasons*, 47 STAN. L. REV. 633, 657-58 (1995). The relevant institutional designer here—Congress—reasonably obligated the Federal Circuit, through § 144, to show its work in PTAB appeals.

Giving reasons also serves the adjudicative goal of accuracy. As Chief Judge Wald recognized, “the discipline of writing even a few sentences or paragraphs explaining the basis for the judgment insures a level of thought and scrutiny by the court that a bare signal of affirmance, dismissal, or reversal does not.” Patricia M. Wald, *The Problem with the Courts: Black-Robed Bureaucracy or Collegiality Under Challenge?*, 42 MD. L. REV. 766, 782 (1983). Judge Rubin, too, recognized that “the discipline of opinion writing does affect the result,” an empirical reality reflected in the oft-recounted judicial experience of sitting down to “prepare an opinion stating the decision and its rationale,” only to find that “it won’t write.” Alvin B. Rubin, *Book Review of The Ways of a Judge by Frank M. Coffin*, 130 U. PA. L. REV. 220, 227 (1981).

In addition, reason-giving generates a body of coherent, predictable law around which public and private actors can orient their decision-making. See Benjamin N. Cardozo, *Nature of the Judicial Process* 30 (1921). Reason-giving requirements safeguard parties’ dignity, as well. See Rachel Bayefsky, *Dignity and Judicial Authority* 118 (2024).

5. In light of the above, there is no basis to suggest that interpreting § 144 as a reason-giving directive is an absurd literalism. See *Pub. Citizen v. U.S. Dep’t*

of *Just.*, 491 U.S. 440, 470-71 (1989) (Kennedy, J., concurring in the judgment) (absurdity doctrine should be limited to the genuinely absurd).

As for the anticipated objection that interpreting § 144 as a reason-giving directive is absurd because the additional work will overwhelm the Federal Circuit, that fear is unfounded. Not even former Chief Judge Michel shares that concern: he has urged the court to cease its Rule 36 practice because it is a “dereliction of duty.”⁴ “A minimum opinion need not be unduly time consuming to write.” Wald, *supra*, at 782.

ParkerVision submits that the Federal Circuit would satisfy § 144 by issuing a one-paragraph document identifying the grounds for reversal or vacatur that the appellant has raised and stating why they fail. That document would qualify as an “opinion” under § 144, and preparing it would not add significantly to the time that the panel already would have spent analyzing the case. *See U.S. Surgical Corp. v. Ethicon, Inc.*, 103 F.3d 1554, 1556 (Fed. Cir. 1997) (“Appeals whose judgments are entered under Rule 36 receive the full consideration of the court, and are no less carefully decided than the cases in which we issue full opinions.”). Under this construction of § 144, the Federal Circuit would have been obligated to write sixty more paragraphs than it has written so far this year. (See *infra* at 32.)

⁴ Eileen McDermott, *Chief Judge Paul Michel: Patent Reform Progress Is Likely, But We Must Stay Focused on the Big Picture*, IPWatchDog.com (Sept. 15, 2019), <https://ipwatchdog.com/2019/09/15/chief-judge-paul-michel-patent-reform-progress-likely-must-stay-focused-big-picture/id=113326/>.

In any event, even if Congress’s § 144 reason-giving directive to the Federal Circuit were an unwise policy choice, “[t]he wisdom of Congress’s judgment on this matter is not [this Court’s] concern.” See *Burwell v. Hobby Lobby Stores, Inc.*, 573 U.S. 682, 736 (2014).

Equally unavailing is the anticipated objection that construing § 144 as a reason-giving directive presents a line-drawing predicament. If an opinion is too concise, a party can raise the issue whether the document qualifies as an “opinion” with the en banc Federal Circuit, which can administer the line. Appellate courts regularly determine whether district courts have rendered adequate findings of fact and conclusions of law under Fed. R. Civ. P. 52(a).

C. The Constitutional-Doubt Canon and Elemental Principles Further Counsel for Interpreting § 144 as a Reason-Giving Directive.

1. The canon of constitutional doubt is another reason to reject an atextual reading of § 144. Even if the “statutory language” were “susceptible of multiple interpretations,” “a court may shun an interpretation that raises serious constitutional doubts and instead may adopt an alternative that avoids those problems.” See *Jennings v. Rodriguez*, 583 U.S. 281, 286 (2018). Of particular relevance here, this Court has recognized that “there are occasions when an explanation of the reasons for a decision may be required by the demands of due process.” *Harris v. Rivera*, 454 U.S. 339, 344 (1981). Due process may very well demand that when a patent holder has been deprived of its vested property rights through a strange agency proceeding

that stacks the deck for the challenger, the holder is entitled to at least some judicial explanation for the property deprivation. Adopting a textual reading of § 144 would avoid this constitutional problem.

Inter partes review may *itself* violate the Fifth Amendment’s Due Process Clause. In *Oil States*, this Court emphasized the “narrowness of [its] holding” that inter partes review comports with Article III and the Seventh Amendment, and it clarified that the Due Process Clause was not at issue. *Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC*, 584 U.S. 325, 344 (2018) (“our decision should not be misconstrued as suggesting that patents are not property for purposes of the Due Process Clause”). The question is therefore open under this Court’s precedents, and the procedure may indeed fall short.

First, inter partes review empowers an executive agency “to cancel a vested property right in an already-issued patent”—a “feat that, under the Constitution, can be performed only by a judicial actor in accordance with governing law.” See Gary S. Lawson, *Appointments and Illegal Adjudication: The America Invents Act Through A Constitutional Lens*, 26 GEO. MASON L. REV. 26, 28 (2018); see also *id.* at 50 (“It requires judicial process. That is what the idea of due process of law has been about at least since Magna Carta in the thirteenth century.”).

Second, inter partes review reflects a “retreat from the promise of judicial independence.” *Oil States*, 584 U.S. at 347 (Gorsuch, J., dissenting). The Patent Office Director—a political appointee who serves at the President’s pleasure—supervises the PTAB members who hear inter partes reviews and selects which members, and how many, will hear any particular

challenge. 35 U.S.C. §§ 1(a), 6(c). If the PTAB panel reaches a result that the Director disagrees with, the Director may add members or order a rehearing. *Id.* §§ 6(a), (c). The Director also determines the PTAB members' base salary. *Id.* § 3(b)(6). Worse still, PTAB members are eligible for annual bonuses, which are based on “quality, production, support for the mission of the Board/leadership, and stakeholder interactions.” *Mobility Workx, LLC v. Unified Pats., LLC*, 15 F.4th 1146, 1155 (Fed. Cir. 2021).

Third, the same PTAB panel decides whether to institute inter partes review and proceeds to adjudicate that very case. Inter partes review thus contravenes the ancient maxim that “[n]o man is allowed to be a judge in his own cause,” see THE FEDERALIST NO. 10, p. 59 (J. Cooke ed. 1961) (J. Madison). The principle of *nemo iudex in causa sua*—an unassailable premise of any “free society,” see *In re Murchison*, 349 U.S. 133, 137 (1955)—is woven into the fabric of the Due Process Clause, see *Williams v. Pennsylvania*, 579 U.S. 1, 9 (2016). Although Congress in the AIA had assigned the institution decision to the Director, thereby lodging the investigative and adjudicative functions in different executive actors, see 35 U.S.C. § 314(a), the Director has delegated the institution power to the PTAB, see 37 C.F.R. § 42.4(a). The consequent commingling of functions casts doubt on the PTAB's objectivity. Even the most well-intentioned bureaucratic body will, upon removing the investigator's cap and donning the adjudicator's cap, experience a degree of cognitive lock-in.⁵

⁵ See Pharm. Researchers & Mfrs. of Am., *Comments on Trial Proceedings Under the America Invents Act* 14 (Oct. 16, 2014) (warning that combining functions would threaten “patent owners’

Another anomaly is that additional patent challengers who were not initially part of the petition may join the inter partes review midstream; and even if all the patent challengers drop out, the PTAB panel may continue reviewing the patent on its own. 35 U.S.C. §§ 315(c), 317(a). That power collides with the principles of standing, mootness, and party presentation that, in our Article III system, ensure that the judge is focused on resolving an actual, concrete dispute and is not stepping outside the judicial role and into matters of self-interest. *See Baker v. Carr*, 369 U.S. 186, 204 (1962).

Several other features of inter partes review may not raise due-process issues on their own but nonetheless contribute to the process's overall inadequacy. For example, the PTAB employs a preponderance-of-the-evidence standard, meaning that for a petitioner to prevail and invalidate a patent holder's already issued patent, the petitioner need only show that it is more likely than not that a patent claim is unpatentable. In district court, though, because a patent is presumed valid, *see* 35 U.S.C. § 282, a defendant in a patent-infringement action arguing patent invalidity as a defense must satisfy a higher standard of "clear and convincing evidence" to prove invalidity, *see Microsoft Corp. v. I4I Ltd. P'ship*, 564 U.S. 91, 95 (2011).

Discovery in PTAB proceedings is also "limited to (A) the deposition of witnesses submitting affidavits or declarations; and (B) what is otherwise necessary in the interest of justice." 35 U.S.C. § 316(a)(5); *see also* 37 C.F.R. § 42.51(b) ("A party is not entitled to

due process protections"), https://www.uspto.gov/sites/default/files/ip/boards/bpai/phrma_20141016.pdf.

discovery” except initial disclosures and limited items constituting “routine discovery”). By contrast, the scope of discovery in district court litigation is broad, enabling patent holders to gather comprehensive evidence and information through depositions, interrogatories, requests for production, and other mechanisms—and thereby to mount a robust defense of their vested property rights. *See Fed. R. Civ. P.* 26.

Additionally, inter partes review is decided solely on a paper record. Expert and fact-witness testimony “must be submitted in the form of an affidavit,” except for the rare circumstance when the PTAB panel authorizes live testimony. 37 C.F.R. § 42.53(a). But in deciding between battling experts who offer competing narratives, the ability to observe them in real time, and thereby to assess their credibility, can be critical. *See Power Integrations, Inc. v. Fairchild Semiconductor Int’l, Inc.*, 843 F.3d 1315, 1341 (Fed. Cir. 2016) (crediting jury’s credibility assessments of competing experts testifying on patent validity).

Although ParkerVision is not challenging, in this petition, inter partes review on due-process grounds, the point remains that the procedural infirmities of inter partes review could necessitate a single, minimal explanation why the patent holder’s already issued patent was invalidated, rendered by an independent court sitting above the fray. Congress, through § 144, has already selected the court to perform that function: the Federal Circuit. Granted, a patent holder whose already issued patent is invalidated through an inter partes review will receive a written decision from the PTAB. *See* 35 U.S.C. § 318(a). But a decision that is the product of a deficient process could not cure that process’s inadequacy. One instance of *judicial* reason-

giving—and its corresponding adjudicative benefits, such as accountability, accuracy, and dignity—could be necessary to compensate for inter partes review’s severe departures from established rules of court procedure that are designed to safeguard rights.

In *Oil States*, this Court observed that “because the Patent Act provides for judicial review by the Federal Circuit, *see* 35 U.S.C. § 319, we need not consider whether inter partes review would be constitutional without any sort of intervention by a court at any stage of the proceedings.” 584 U.S. at 344 (other citation and punctuation omitted). As mentioned, this Court noted that the Due Process Clause was not at issue there. *Id.* For due-process purposes, it may be that a Rule 36 summary affirmance is an inadequate level of “intervention” to resolve inter partes review’s due-process shortcomings. For due-process purposes, that is, more could be needed: an opinion setting forth reasons, the writing of which will obligate the Federal Circuit to carefully and thoroughly review the proceeding below.

In this vein, then-Judge Wald observed that an appellate court’s summary affirmance of an agency decision is “quite a different matter” from an appellate court’s summary affirmance of a district court opinion: “In the latter case, the parties have had the benefit of an independent judicial decision whereas in the former the parties are seeking judicial review of the agency decision in the first instance in this court.” *Nat’l Classification Comm. v. United States*, 765 F.2d 164, 174 (D.C. Cir. 1985) (Wald, J., separately stating). For that reason, continued Judge Wald, when an appellate court is reviewing an appeal from an agency decision, the court “should at least give the parties a

statement of reasons in the court’s own words, if for no other reason than to indicate that the court in fact thoughtfully reviewed the agency’s determination.” *Id.* That point is doubly true for inter partes review, a rare breed of administrative process. A plain-language reading of § 144, however, avoids the foregoing host of constitutional concerns.

2. Yet another consideration militating against an atextual reading of § 144 is the “elemental proposition,” which this Court recently addressed in *Loper Bright*, that “courts decide legal questions by applying their own judgment.” *Loper Bright Enters. v. Raimondo*, 144 S.Ct. 2244, 2261 (2024). As the framers envisioned, the “judicial function” of courts—the very purpose of them—would be to “exercise independent judgment” in determining “questions of law” and “the meaning of statutory provisions.” *Id.* at 2262; *see also* THE FEDERALIST NO. 78, p. 525 (J. Cooke ed. 1961) (A. Hamilton) (“The interpretation of the laws is the proper and peculiar province of the courts.”). This Court embraced that view in *Marbury v. Madison*, where Chief Justice Marshall pronounced: “It is emphatically the province and duty of the judicial department to say what the law is.” 1 Cranch 137, 177 (1803) (emphasis added); *see also Decatur v. Paulding*, 14 Pet. 497, 515 (1840) (holding that the judicial role is to “interpret the act of Congress, in order to ascertain the rights of the parties”). That traditional conception of the judicial function—that is, the conception that “courts must exercise independent legal judgment”—has held true from the founding era to present day. *Loper Bright*, 144 S.Ct. at 2262, 2265.

When the Federal Circuit issues a summary affirmance of a PTAB decision in an inter partes

review under Rule 36, however, it becomes impossible to determine whether the Federal Circuit has satisfied its longstanding duty to exercise independent legal judgment. In the appeals here, for example, Parker-Vision raised multiple legal issues, including whether the PTAB erred in basing its unpatentability determinations on an argument that the petitioners had forfeited by excluding it from the petitions and raising it for the first time on reply. (See *supra* at 9.) Under 32 U.S.C. § 312(a)(3), the petition must “identif[y], in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” This Court, further, has held that the petition must “guide the life of the litigation,” and that the “petitioner is the master of its complaint.” *SAS Inst., Inc. v. Iancu*, 584 U.S. 357, 363, 366 (2018). And the Federal Circuit, for its part, has held that “[a]ny marked departure from the grounds identified with particularity in the petition would impose unfair surprise on the patent owner and, consequently, violate the IPR statute.” *Corephotonics, Ltd. v. Apple Inc.*, 84 F.4th 990, 1002 (Fed. Cir. 2023) (citation and punctuation omitted).

Despite this settled law, the PTAB’s plain violation of it, and the plainly unfair surprise of the reply, the Federal Circuit summarily affirmed the PTAB under Rule 36. Consequently, it is impossible to assess whether the Federal Circuit independently applied 32 U.S.C. § 312(a)(3) and the surrounding case law. Its independent analysis of this legal issue is essential because courts possess the institutional competence to analyze legal technicalities such as

forfeiture. Legal analysis is what “[c]ourts do.” *Loper Bright*, 144 S.Ct. at 2266.

If the Federal Circuit did not exercise its independent legal judgment, the absence of an opinion denies ParkerVision the ability to challenge the Federal Circuit’s breach of its judicial role in the en banc Federal Circuit or in this Court. Because there is no record of the Federal Circuit’s breach, there is no basis for further review. *See* Fed. Cir. R. 54 Practice Notes (“A petition for rehearing en banc is rarely appropriate if the appeal was the subject of a nonprecedential opinion by the panel of judges that heard it.”). And if the Federal Circuit did exercise its independent legal judgment, the absence of an opinion causes ParkerVision the indignity of not knowing why, or how, the Federal Circuit sidestepped the weight of authority.

In this way, the Federal Circuit’s Rule 36 practice stands in tension with the elemental principle that courts must exercise independent legal judgment. But Congress has already resolved this fundamental problem: through § 144, Congress imposed a reasoning requirement on the Federal Circuit, thereby enabling parties on appeal to discern whether the Federal Circuit has fulfilled its judicial role.

II. THIS CASE IS AN IDEAL VEHICLE TO RESOLVE THE IMPORTANT AND RECURRING QUESTION PRESENTED.

This case presents no vehicle problem that would preclude this Court’s review of the question presented. The PTAB invalidated claims in ParkerVision’s already issued patents through inter partes review. ParkerVision timely appealed, and the Federal Circuit

summarily affirmed the PTAB’s decision under Rule 36, without issuing an opinion—despite § 144.

The statutory violation that occurred here is not an isolated incident. It is part of a disconcerting pattern. Since the AIA’s enactment in 2011, and as of August 22, 2024, the Federal Circuit has issued a Rule 36 summary affirmance in 43.01% of its PTAB appeals from inter partes review, post-grant review, and covered-business-method proceedings—*i.e.*, 569 out of 1,323 appeals.⁶ In addition, according to the Federal Circuit’s online database, the court so far in 2024 has issued sixty Rule 36 summary affirmances and 75 opinions in PTAB appeals, which amounts to a relative-Rule-36 frequency of 44.44%.⁷

As a consequence of the Federal Circuit’s heavy reliance on Rule 36, patent holders rarely receive a judicial explanation why their already issued patents have been invalidated. A study of 300 Federal Circuit inter-partes-review decisions from 2019 to the first half of 2020 found that “patent owner-appellants seldom succeeded at the Federal Circuit, with PTAB unpatentability determinations being affirmed 85% of the time.”⁸ Further, “[w]ith approximately 60% of

⁶ See Daniel F. Klodowski et al., *Federal Circuit PTAB Appeal Statistics for June 2024*, Finnegan PTAB Blog (Aug. 22, 2024), <https://www.finnegan.com/en/insights/blogs/at-the-ptab-blog/federal-circuit-ptab-appeal-statistics-for-june-2024.html>.

⁷ See Fed. Cir. Website, *Opinions & Orders*, <https://cafc.uscourts.gov/home/case-information/opinions-orders/> (visited Oct. 31, 2024). Counsel selected “PTO” from the webpage’s dropdown menu, restricted the date range to this year, and excluded trademark appeals.

⁸ See Larry Sandell, *What 18 Months of IPR Stats Teach Us About Winning Appeals*, Law360 (July 20, 2020), <https://www.>

such affirmances being made under Rule 36, approximately half of all patent owner IPR appeals were rejected without a substantive appellate opinion.” *Id.*

These staggering figures have prompted numerous practice-oriented and academic comments⁹ arguing that the Federal Circuit’s use of Rule 36 is unlawful. To stakeholders in the patent system, the Federal Circuit’s Rule 36 practice has become a lightning rod. It is a constant topic of conversation and, quite often, consternation.

As this Court knows, among the courts of appeals, only the Federal Circuit deploys a one-word affirmance with any meaningful degree of frequency. The First, Second, Third, Fourth, Sixth, Seventh, Ninth, Eleventh, and D.C. Circuits have no local rule authorizing one-word affirmances. The Fifth, Eighth, and Tenth Circuits have such a rule—*see* 5th Cir. R. 47.6, 8th Cir. R. 47B, and 10th Cir. R. 36.1—but in the past year, it appears that only the Fifth Circuit has applied it, and only twice.¹⁰ Yet the Federal Circuit, which is statutorily required to issue an “opinion” in PTAB

law360.com/articles/1293373/what-18-months-of-ipr-stats-teach-us-about-winning-appeals.

⁹ *See, e.g.*, Charles Macedo et al., *Justice Is Not Silent: The Case Against One-Word Affirmances in the Federal Circuit*, Patently-O (Sept. 22, 2024), <https://patentlyo.com/patent/2024/09/appellate-decision-reasoning.html>; Crouch, *supra*, at 570; Rebecca A. Lindhorst, Comment, *Because I Said So: The Federal Circuit, the PTAB, and the Problem with Rule 36 Affirmances*, 69 Case W. RES. L. REV. 247, 260-61 (2018).

¹⁰ *Merkle v. Thomas*, No. 23-50692, Doc. 65-1 (5th Cir. July 12, 2024); *Am. Longshore v. Aries Marine*, No. 23-30564, Doc. 63-1 (5th Cir. Apr. 4, 2024).

appeals, issues one-word summary affirmances at a rate that dwarfs other circuits' rates.

There is a pressing need for this Court's intervention because "[i]n the area of patents, it is especially important that the law remain stable and clear." *Bilski v. Kappos*, 561 U.S. 593, 613 (2010) (Stevens, J., concurring). The Federal Circuit's Rule 36 practice shrouds the legal principles that govern patentability, and makes it difficult for inventors to predict whether their inventions will receive and retain patent protection. (See *supra* at 16-17.) The practice thus disincentivizes inventors from investing the time and energy to invent, and undermines the purpose of patents as laid down in the Constitution: "[t]o promote the Progress of Science and useful Arts." U.S. Const. art. I, § 8, cl. 8. At bottom, "[r]eliable application of legal principles underlies the economic incentive purpose of patent law, in turn implementing the benefits to the public of technology-based advances, and the benefits to the nation of industrial activity, employment, and economic growth." *CLS Bank Int'l v. Alice Corp. Pty.*, 717 F.3d 1269, 1321 (Fed. Cir. 2013) (en banc) (Newman, J., concurring in part and dissenting in part), *aff'd*, 573 U.S. 208 (2014).

To be sure, there are plenty of circumstances where it makes perfect sense for a court not to give reasons for a decision. But here, the Federal Circuit must give reasons in PTAB appeals because—and only because—the statutory text and context demand it. And although our Article III courts *are* overburdened, the sixty or so additional opinions that the Federal Circuit would need to prepare per year need not be tomes. An opinion can be concise.

This Court should therefore intervene to stop the Federal Circuit's practice of issuing Rule 36 affirmances, without opinions, in contravention of the plain statutory text. Our nation's elected representatives chose to impose a reason-giving requirement on the Federal Circuit, and their choice, which embodies the people's will, should not be so easily and frequently brushed aside.

Even if this Court disagrees that § 144 is a reason-giving directive, there would be significant value in granting certiorari to consider the question on a fully developed record and in publicly explaining why a one-word affirmance suffices. This Court's reason-giving would—fittingly—advance the dignity of appellants who have been Rule 36-ed, including patent holders who have been deprived of their vested property rights. *See Bayefsky, supra*, at 118. They and other critics of Rule 36 would finally come to understand why the rule is compatible with the statute. An explanation would thus alleviate public apprehensions and restore public trust. Alternatively, if this Court believes that something more than a one-word affirmance is needed, but that Parker-Vision's one-paragraph proposal goes too far (see *supra* at 22), this Court could draw the line as it deems fit. This Court could also hold that reason-giving is required in only a subset of PTAB appeals, such as appeals from inter partes review, a peculiar process that diverges from foundational due-process norms.



CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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November 4, 2024