
No. 2008-1352

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

TRIANTAFYLLOS TAFAS,

Plaintiff-Appellee,

AND

SMITHKLINE BEECHAM CORPORATION (D/B/A GLAXOSMITHKLINE), SMITHKLINE
BEECHAM PLC, AND GLAXO GROUP LIMITED (D/B/A GLAXOSMITHKLINE),

Plaintiffs-Appellees,

v.

JON DUDAS, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR
OF THE UNITED STATES PATENT AND TRADEMARK OFFICE, AND UNITED STATES PATENT
AND TRADEMARK OFFICE,

Defendants-Appellants.

**Appeal from the United States District Court for the Eastern District of Virginia in consolidated
case nos. 1:07-CV-846 and 1:07-CV-1008, Senior District Judge James C. Cacheris**

**BRIEF OF *AMICI CURIAE* INTELLECTUAL VENTURES, LLC, THE
GENERAL ELECTRIC COMPANY AND DOLBY LABORATORIES, INC.,
IN SUPPORT OF APPELLEES & AFFIRMANCE**

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Counsel for the *amicus* Intellectual Ventures, LLC, certifies the following:

1. The full name of every party or amicus represented by me is:
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2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is: None.
3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are: None.
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~ SUMMARY OF ARGUMENT ~

Amici curiae Intellectual Ventures, LLC, the General Electric Company, and Dolby Laboratories, Inc. (collectively, *Amici*), support the decision of the District Court invalidating the “Final Rules” of the United States Patent & Trademark Office (PTO) principally on the grounds that they are substantive, and thus unlawful given Congress’ lack of delegation of substantive rulemaking authority to the PTO. *Amici* also support Appellees’ arguments that the Final Rules are alternatively improper for being contrary to the existing patent law, vague and retroactive.

Aside from lodging their support for those arguments, *Amici* submit this brief to assert the discrete argument that of the four independently valid grounds for affirmance available to this Court, one ground in particular—that the Final Rules contradict the existing patent law—presents unique advantages over the others. Affirming expressly on that particular ground will serve the federal policy of avoiding piecemeal litigation; safeguard the authority of Congress (not the PTO) to legislate patentability requirements; and lend predictability to future patent prosecution proceedings for the PTO and the public.

~ *AMICI CURIAE* ~

INTELLECTUAL VENTURES, GENERAL ELECTRIC, AND DOLBY LABORATORIES

Amici file this brief pursuant to Fed. R. App. P. 29(a). The undersigned counsel represents that all named parties in the captioned matter have consented.

Intellectual Ventures: IV is a company that invents and invests in invention. IV has more than 350 staff dedicated to invention, including at the doctorate level computer scientists, technical analysts, material scientists, aeronautical engineers, biomedical engineers, nuclear engineers, electrical engineers, mechanical engineers, chemists, optical engineers, software engineers, biotechnologists, physicists and mathematicians. IV operates a laboratory dedicated to testing and proto-typing in-house inventions. IV's patent prosecution team has hundreds of years of collective experience in patent prosecution, evaluation, licensing and enforcement.

While IV is a relatively small enterprise, it is an unusually high-volume customer of the PTO: IV has filed over 1,400 patent applications, been issued over 50 patents, and owns over 20,000 patents and applications. The PTO's promulgated "Final Rules," because they would so substantially affect inventor and patentee rights in their departure from the existing patent law, would have a substantial effect on IV's business operations.

General Electric: GE is one of the largest and most diversified industrial corporations in the world. Since its incorporation in 1892, GE has developed a

wide variety of products for the generation, transmission, control, and utilization of electricity. GE is also a major supplier of other major technologies and services, including healthcare products, security products for homeland security, nuclear-power support services, and commercial and military jet aircraft engines. GE is also a global leader in financial services and has a significant presence in the entertainment industry through its NBC Universal subsidiary. Total research and development expenditures at GE were \$4.1 billion in 2007. GE has a substantial active patent portfolio, with over 22,000 United States patents, 820 of which were issued last year, and over 42,000 patents worldwide.

Dolby Laboratories: Dolby develops and delivers products and technologies that make the entertainment experience more realistic and immersive. For more than four decades, Dolby has been at the forefront of defining high-quality audio and surround sound in cinema, broadcast, home audio systems, cars, DVDs, headphones, games, televisions, and personal computers. Dolby's technologies have been included in more than 3 billion products through licenses with major manufacturers throughout the world.

Dolby has over 1,100 employees, including technicians, engineers, researchers and scientists who are vital to Dolby's patent process. Its worldwide portfolio includes over 1,400 issued patents and over 1,900 pending applications. For fiscal year 2007, Dolby spent more than \$44 million for research and development.

~ ARGUMENT ~

I. This Court Should Affirm the District Court’s Finding That The Final Rules Are Substantive And Thus *Ultra Vires*, But Should Also Affirm That The Final Rules Should Be Voided Expressly On The Separate, Dispositive Basis That They Are Contrary To The Existing Patent Law

Amici urge this Court to affirm the District Court’s decision on the basis that the PTO has no authority to issue substantive rules for the reasons set forth in Appellees’ briefs. However, there are separate and independent bases for affirming the District Court’s decision, notably that the Final Rules are contrary to United States patent statutes and judicial decisions interpreting those statutes.

a. For reasons well established in the record, the Final Rules are contrary to the existing patent law

The United States Code bars the PTO from promulgating any rules contrary to existing federal law, and requires courts to invalidate any such rules. *See* 35 U.S.C. § 2(b)(2) (authorizing the PTO to “establish regulations, not inconsistent with law”) & 5 U.S.C. § 706(2)(A) (“The reviewing court shall . . . hold unlawful and set aside agency action . . . not in accordance with law.”).

Consistent with that federal Code, federal appellate courts have consistently held that an agency’s rulemaking power—even if exercised within the agency’s rulemaking jurisdiction—may not be used to traverse any relevant federal statutes. *See, e.g., Ernst & Ernst v. Hochfelder*, 425 U.S. 185, 213-14 (1976) (“The rulemaking power granted to an administrative agency charged with the

administration of a federal statute is not the power to make law. Rather, it is the power to adopt regulations to carry into effect the will of Congress as expressed by the statute.”) (quotation marks omitted); *Graham Eng’g Corp. v. United States*, 510 F.3d 1385, 1389 (Fed. Cir. 2007) (noting that an agency-promulgated rule, even if squarely within the bounds of Congress’ delegation of authority to the agency, must also be “not inconsistent with the statute,” and upholding a contested agency regulation in part by finding it “not inconsistent with the substantive requirements of” the relevant statute).

The relevant statutory framework with which PTO rules must remain consistent includes Title 35 of the United States Code. *See* 35 U.S.C. § 1 *et seq.* The record below and Appellees’ principal briefs on appeal establish in detail how the Final Rules contravene Title 35 in numerous ways. Accordingly, in lieu of submitting redundant briefing to the Court, *Amici* rely on and incorporate by reference those materials. *See Tafas v. Dudas*, Cause No. 1:07-cv-846, E.D. Va., Docket Nos. 141 & 142; *see also* Appellees’ Briefs (filed Sept. 24, 2008).

Amici note however for summary reference that the Final Rules contradict the federal Code in at least the following ways:

Final Rules 78 and 114 would limit an inventor to two continuation or continuation-in-part applications (which may then benefit from an earlier filing date corresponding to a parent application) and one request for continued examination. 72 Fed. Reg. at 46838, 46841; 37 C.F.R. §§ 1.78(d)(1)(i)–(iii),

1.114(f). Those Rules further provide that if an inventor seeks to surpass those limits, he must present a “petition and showing” to establish either (i) the infeasibility of presenting the subject matter of third-or-later continuation applications in prior-filed applications, or (ii) an injustice by application of the numerical limits.

Section 120 of 35 U.S.C., however, imposes no numerical limit on the number of continuation applications that may claim priority to a prior-filed application, and provides no authority to the PTO to impose conditions on an applicant’s rights to the benefits of Section 120 if the applicant otherwise meets the requirements of the statute. Section 132 imposes no limit on the number of requests for continued examinations, and provides authority only to prescribe regulations to accommodate requests of the applicant for continued examination—not to require the filing of a petition. In these respects, Final Rules 78 and 114 contradict the federal Code. *See In re Hogan*, 559 F.2d 595, 604 n.13 (C.C.P.A. 1977) (“[A] limit upon continuing applications is a matter of policy for Congress, not us.”); *In re Henricksen*, 399 F.2d 253 (C.C.P.A. 1968) (finding no statutory basis to limit the number of continuation applications).

Final Rule 75 would limit an inventor to five independent claims, and 25 claims total, for a single patent application. 72 Fed. Reg. at 46836; 37 C.F.R. § 1.75(b)(1). Section 112 of 35 U.S.C., however, does not impose any limit on the number of permissible claims in an application, instead bestowing on inventors the

right to present an application that “shall conclude with one or more claims” In this respect, Final Rule 75 contradicts the federal Code. *See In re Wakefield*, 422 F.2d 897, 900 (C.C.P.A. 1970) (“[A]n applicant should be allowed to determine the necessary number and scope of his claims”).

Final Rule 265 requires applicants to search for and analyze prior art for submission to the PTO if seeking to surpass the claim-number limits provided in Final Rule 75. 72 Fed. Reg. at 46842-43; 37 C.F.R. § 1.265. Sections 102, 103 and 131 of 35 U.S.C., however, place no such obligations on applicants. Indeed, this Court has repeatedly placed that burden on the PTO, *see In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992), and held that Title 35 places no obligation whatsoever on patent applicants to search for or analyze prior art, *see, e.g., Frazier v. Roessel Cine Photo Tech, Inc.*, 417 F.3d 1230, 1238 (Fed. Cir. 2005).¹ In this respect, Final Rule 265 contradicts the federal Code.

b. For numerous compelling reasons, this Court should affirm the District Court’s Order on the independent ground that the Final Rules are contrary to the existing patent law

Congress plans to consider proposed amendments to Title 35 of the United States Code which would bestow upon the PTO substantive rulemaking authority. *See Patent Reform Act of 2008*, S. 3600, 110th Cong. (2008) (the full text of which

¹ *See also Nordberg, Inc. v. Telsmith, Inc.*, 82 F.3d 394, 397 (Fed. Cir. 1996); *FMC Corp. v. Hennessy Indus., Inc.*, 836 F.2d 521, 526 n.6 (Fed. Cir. 1987); *FMC Corp. v. Manitowoc Co.*, 835 F.2d 1411, 1415 (Fed. Cir. 1987); *American Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 1362 (Fed. Cir. 1984).

is available with introduction by Senator Kyl at 154 Cong. Rec. S. 9494, S. 3600 (2008)); *see also* Patent Reform Act of 2007, S. 1145, 110th Cong. § 2 (2008) (from Senator Leahy); Patent Reform Act of 2007, H.R. 1908, 110th Cong. § 1 (2007) (from Representative Berman).

It is, accordingly, possible that Congress will soon afford the PTO expanded rulemaking authority but otherwise leave unchanged various patentability and patent-prosecution provisions of Title 35. If that possibility comes to pass, and if this Court were to affirm only on the District Court's chosen basis that the PTO previously exceeded the scope of its rulemaking authority, the PTO might then re-propose these Final Rules in their current form. However, those re-proposed Final Rules once promulgated would necessitate another court challenge to address the separate question of their substantive illegality given their violations of Title 35 U.S.C. This possibility of iterative litigation addressing the same Final Rules would waste judicial resources, and highlights the need for this Court in the present case to address separately the issue of the Final Rules' illegality.

Accordingly, *Amici* urge this Court to affirm the District Court's decision on the separate and independent basis that the Final Rules are inconsistent with substantive provisions of the existing patent law. This Court is permitted to affirm the decision below on separate, alternative grounds.² Indeed, in order to avoid

² This Court is free to affirm the District Court's decision on any ground of its choosing, so long as that ground has been preserved for appeal. *See Bailey v. Dart*

future litigation, and in cases where the issue presented is of continuing public interest and is likely to recur, it is particularly appropriate for an appeals court to affirm a trial court's holding on appropriate independent grounds.³

Reaching at this juncture the separate issue of the illegality of the Final Rules will serve at least three important purposes: (i) avoiding unnecessary future litigation on the Final Rules; (ii) preserving Congress' authority to define the boundaries of patent law, including prohibiting an agency from undermining statutes enacted pursuant to that authority; and (iii) affording predictability in patent prosecution practice for both the PTO and the public.

Container Corp. of Mich., 292 F.3d 1360, 1362 (Fed. Cir. 2002) (holding that the Court may adopt an alternative ground for affirmance, even if it was ignored by the trial court, so long as it is supported by the record and was not waived). The particular issue of the Final Rules' inconsistencies with the existing patent law was amply preserved for appeal by Appellees, and thus is available to this Court. *See Tafas v. Dudas*, Cause No. 1:07-cv-846, E.D. Va., Docket No. 142; *see also* Fed. R. App. P. 10(a)(1) (providing that a party's original papers filed with the district court comprise in part the record on appeal).

³ *Cf. Filipino Accountants' Assn. v. State Bd. of Accountancy*, 155 Cal. App. 3d 1023, 1029-1030 (Cal. App. 3 1984) ("Ordinarily, when an appellate court concludes that affirmance of the judgment is proper on certain grounds it will rest its decision on those grounds and not consider alternative grounds which may be available. However, appellate courts depart from this general rule in cases where the determination is of great importance to the parties and may serve to avoid future litigation, or where the issue presented is of continuing public interest and is likely to recur.") (internal citations omitted).

i. Affirmance on the basis of illegality will preserve judicial economy and avoid piecemeal litigation

Affirming the District Court's invalidation of the Final Rules on the basis of their inconsistencies with the patent law will serve the important federal policies of preserving judicial economy and avoiding piecemeal litigation. *See, e.g., Gurley v. Peake*, 528 F.3d 1322 (Fed. Cir. 2008) (repeatedly recognizing federal courts' policy of serving the interests of judicial economy and avoiding where practicable piecemeal litigation). If this Court affirms the District Court's decision on the separate basis that the Final Rules contradict Title 35 of the federal Code, that affirmance will remain relevant to the propriety of the Final Rules and future variations thereof, regardless whether Congress elects in the future to expand the PTO's rulemaking authority. *See* I(b), *ante* (regarding proposed legislation from Senators Leahy and Kyl, and Representative Berman).

Similarly, the PTO could remedy the retroactivity and vagueness infirmities that have been addressed by Appellees as separate, alternative bases to invalidate the Final Rules. For example, the PTO could remove the retroactive provisions of the Final Rules, and insert more specific guidance with respect to the "examination support document" requirement of Final Rule 265 to avoid ongoing vagueness concerns. *See* Appellee GSK Brief at 46-49 (filed Sept. 24, 2008). But even if the PTO resolved retroactivity and vagueness issues, the remaining provisions of the Final Rules in their current form would still be contrary to the existing patent law,

and thus would require future challenges in court. Therefore, this issue should be resolved now, while the matter is before this Court.

ii. Affirmance on the basis of illegality will safeguard Congress' authority over the patent law

This Court's explicit recognition of the Final Rules' inconsistencies with the patent law—and affirmance of the District Court's invalidation of the Final Rules on that separate basis—would safeguard Congress' exclusive, constitutional power to provide conditions for patentability. *See* U.S. Const. Art. I, § 8(8). No matter whether Congress expands the rulemaking authority of the PTO in the near future, and no matter whether the PTO might in a subsequent rulemaking proceeding ameliorate the retroactivity and/or vagueness problems of the Final Rules, Congress has set forth the substantive conditions of patentability in 35 U.S.C. §§ 102 and 103. In addition, in Section 120 Congress has identified the only requirements for an inventor's entitlement to an early filing date. In Sections 131 and 132, Congress has set forth the only conditions to an inventor's right to an examination (as well as a reexamination). As long as those statutes remain in force, neither the courts nor the PTO may take action inconsistent with their provisions.

Affirming the District Court's decision on the specific ground that the Final Rules contradict the existing patent statutes will reaffirm Congress' exclusive legislative authority for future reference by all courts considering these and related issues.

iii. Affirmance on the basis of illegality will ensure predictability for the PTO and the public regarding the patent prosecution process

Affirmance on the separate basis that the Final Rules are inconsistent with the patent law will also afford predictability in the patent prosecution process for the PTO, for *amici curiae* IV, GE and Dolby Laboratories (all three of which own substantial patent portfolios and engage in ongoing high-volume patent prosecution before the PTO) and all other U.S. inventors and companies. Indeed, all parties presenting applications to the PTO, as well as the PTO, its Director and the PTO Examiners, will benefit from separate affirmance on these grounds. As set forth above, *see* I(b)(i), *ante*, the need for affirmance on this particular ground is emphasized by the possibility of future events such as congressional changes to the PTO's rulemaking authority and/or PTO revisions to future proposed versions of the Final Rules.

Without affirmance on this basis, the possibility of such future events will have a chilling effect on the patent prosecution process. For example:

- Every inventor who prepares an application for presentation to the PTO would be faced with uncertainty regarding the number of permissible claims;
- Every inventor or assignee preparing a third or later continuation or continuation-in-part application would be faced with uncertainty about whether the application would even be examined; and
- Every inventor or assignee with any pending application would be faced with substantially increased patent prosecution costs,

such as preparing “petitions and showings” and “examination support documents.”

This Court may at this juncture, however, provide the PTO and applicants for U.S. patents certainty in the patent prosecution process by reaffirming that substantive provisions of Title 35 of the federal Code cannot be modified absent legislation from Congress. No amount of PTO rulemaking or federal-court litigation will change that constitutionally guaranteed reservation of power to Congress.

~ CONCLUSION ~

For the foregoing reasons, *Amici* respectfully request the Court to enter judgment affirming the District Court’s order nullifying and voiding the Final Rules, by relying expressly on the basis that the Final Rules are invalid by virtue of their deviations from Title 35 of the United States Code, in addition to whatever other bases the Court chooses to rely upon.

DATED: October 3, 2008

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**CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME
LIMITATION, TYPEFACE REQUIREMENTS, AND TYPE STYLE
REQUIREMENTS**

1. This brief complies with the applicable type-volume limitation of the Federal Rules of Appellate Procedure and the Federal Circuit local rules because this brief contains approximately 3,050 words, excluding portions of the brief exempted from word-count by Federal Rule of Appellate Procedure 32(a)(7)(b)(iii).

2. This brief complies with the typeface and type style requirements of Federal Rules of Appellate Procedure 32(a)(5) and 32(a)(6) because it has been prepared in a proportionally spaced typeface using Microsoft Word in the Times New Roman font.

DATED: October 3, 2008

John M. Neukom

DECLARATION OF AUTHORITY TO SIGN
FOR ATTORNEYS OF RECORD

Pursuant to Federal Circuit Rule 47.3, and under penalty of perjury pursuant to 28 U.S.C. § 1746, I, Chris Dorsey of Wilson-Epes Printing Company, Inc., do hereby declare that I have authority to sign the preceding documents for counsel of record for Amici Curiae Intellectual Ventures, LLC (John M. Neukom), General Electric Company (Buckmaster De Wolf), and Dolby Laboratories, Inc. (Heath Hogle).

DATED: October 3, 2008

Chris Dorsey