

No. 17-1243

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**In the Supreme Court of the United States**

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SPECIALTY FERTILIZER PRODUCTS, LLC, PETITIONER

*v.*

SHELL OIL COMPANY, ET AL.

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

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**BRIEF FOR THE FEDERAL RESPONDENT IN OPPOSITION**

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## QUESTIONS PRESENTED

In an inter partes reexamination proceeding under the Patent Act, 35 U.S.C. 1 *et seq.*, the U.S. Patent and Trademark Office (USPTO) concluded that petitioner's patent claims should be cancelled as obvious. The Federal Circuit affirmed in an unpublished order without a separate opinion. The questions presented are as follows:

1. Whether the USPTO violated petitioner's rights under the Due Process Clause by declining to allow petitioner to confront and cross-examine adverse expert declarants during an inter partes reexamination.
2. Whether 35 U.S.C. 144 requires the Federal Circuit to issue an opinion in every appeal from a decision of the USPTO.
3. Whether inter partes reexamination comports with Article III and the Seventh Amendment.

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**BRIEF FOR THE FEDERAL RESPONDENT IN OPPOSITION**

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## **OPINIONS BELOW**

The order of the court of appeals (Pet. App. 1a-2a) is not published in the Federal Reporter but is available at 700 Fed. Appx. 1006. The decision of the Patent Trial and Appeal Board (Pet. App. 3a-28a) is not published in the United States Patents Quarterly but is available at 2015 WL 4575081.

## **JURISDICTION**

The judgment of the court of appeals was entered on November 8, 2017. On January 25, 2018, the Chief Justice extended the time within which to file a petition for a writ of certiorari to and including March 8, 2018, and the petition was filed on March 6, 2018. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

## STATEMENT

1. Congress has created several “administrative processes that authorize the [U.S. Patent and Trademark Office (USPTO)] to reconsider and cancel patent claims that were wrongly issued.” *Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC*, 138 S. Ct. 1365, 1370 (2018). In 1980, Congress created ex parte reexamination, under which any person may request reexamination of a United States patent on the basis of qualifying prior art. 35 U.S.C. 301, 302; see Act of Dec. 12, 1980, Pub. L. No. 96-517, 94 Stat. 3015 (35 U.S.C. Ch. 30). If the Director of the USPTO finds that such a request raises a “substantial new question of patentability affecting any claim,” a patent examiner reexamines the patent “according to the procedures established for initial examination.” 35 U.S.C. 303(a), 305; see 35 U.S.C. 304.

Congress later created “another, similar procedure, known as ‘inter partes reexamination.’” *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2137 (2016); see 35 U.S.C. 311-318 (2000). The USPTO could grant an inter partes reexamination based on a “request” for such a proceeding from a third party requester that identified “a substantial new question of patentability” regarding an existing patent. 35 U.S.C. 312(a) (2000); see 35 U.S.C. 313 (2000). Inter partes reexamination differed from ex parte reexamination in that the third-party requester could participate in the inter partes proceeding. See 35 U.S.C. 314(b)(3) (2000); *Oil States*, 138 S. Ct. at 1371; *Cooper Techs. Co. v. Dudas*, 536 F.3d 1330, 1332 (Fed. Cir. 2008).

In 2011, Congress enacted the Leahy-Smith America Invents Act (AIA), Pub. L. No. 112-29, 125 Stat. 284, which “replaced inter partes reexamination with inter



partes review.” *Oil States*, 138 S. Ct. at 1371. The AIA permits third parties to seek inter partes review of any patent more than nine months after the patent’s issuance on the ground that the patent is invalid based on lack of novelty or obviousness. 35 U.S.C. 311(b).<sup>1</sup> The Director of the USPTO may institute an inter partes review if he determines that “there is a reasonable likelihood that the petitioner would prevail” with respect to at least one of its challenges to patent validity, 35 U.S.C. 314(a), and if no other provision of the AIA bars institution under the circumstances.

The challenger has “broader participation rights” in an inter partes review than the challenger would have had in an inter partes reexamination. *Cuozzo*, 136 S. Ct. at 2137. The AIA directed the USPTO to prescribe regulations “setting forth standards and procedures for discovery of relevant evidence” including “the deposition of witnesses submitting affidavits or declarations,” 35 U.S.C. 316(a)(5)(A), and the USPTO has promulgated regulations providing for such depositions, 37 C.F.R. 42.53; see 37 C.F.R. 42.51(b)(1)(ii). The final decision in an inter partes review may be appealed to the Federal Circuit. 35 U.S.C. 141, 319.

2. Petitioner owns U.S. Patent No. 6,210,459 (filed Sept. 28, 1998) (the ’459 patent), which relates to a fertilizer composition that, when applied to soil, forms low-acidity microenvironments that increase availability and plant uptake of micronutrients. Pet. App. 3a-4a. These microenvironments are formed by applying a granulated mixture of elemental sulfur, ammonium sulfate, and other micronutrients. *Ibid.*

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<sup>1</sup> The AIA created a separate mechanism, known as post-grant review, for challenges brought within the first nine months after the patent’s issuance. 35 U.S.C. 321(e).

The USPTO granted respondent Shell Oil Company's request for inter partes reexamination of the '459 patent. Pet. App. 4a-8a. During the reexamination proceeding, petitioner asked the USPTO Director to authorize subpoenas enabling petitioner to depose experts who had provided declarations supporting Shell Oil's challenge. The Director denied those requests. C.A. App. 3029-3030, 3058. At the close of the reexamination, the patent examiner concluded that all of the challenged claims were patentable. Pet. App. 4a; see *id.* at 12a-15a (summarizing patent examiner's decision).

Shell Oil appealed, and the USPTO's Patent Trial and Appeal Board (Board) reversed. Pet. App. 3a-28a. The Board concluded that all of the challenged claims of the '459 patent were obvious over the prior art. *Id.* at 15a-26a.

The Board granted petitioner's request for rehearing and then rejected petitioner's challenges to the obviousness determination. Pet. App. 29a-38a. It also "decline[d] to address" petitioner's contention that the absence of an opportunity to cross-examine expert declarants as part of inter partes reexamination proceedings violated petitioner's rights under the Due Process Clause. *Id.* at 34-35a. The Board stated that "[a] lack of ability for direct cross-examination generally does not generate due process violations in *inter partes* reexamination cases." *Id.* at 35a (citing *Abbott Labs. v. Cordis Corp.*, 710 F.3d 1318, 1328 (Fed. Cir. 2013)).

Petitioner appealed to the Federal Circuit, and the Acting Director of the USPTO intervened in that appeal. Pet. App. 1a. The court of appeals affirmed the Board's decision without opinion, in an unpublished per curiam order. *Id.* at 1a-2a.

**ARGUMENT**

Petitioner contends (Pet. 16-34) that its inability to confront and cross-examine an adverse expert declarant during inter partes reexamination violated its rights under the Due Process Clause. Petitioner also argues (Pet. 35-39) that the Federal Circuit's disposition of this case in a per curiam order issued without opinion violates 35 U.S.C. 144. Those contentions lack merit and do not implicate any conflict among courts of appeals. Further review is not warranted.

Petitioner also requests (Pet. 39-40) that the Court hold the petition pending its decision in *Oil States Energy Services, LLC v. Greene's Energy Group, LLC*, 138 S. Ct. 1365 (2018). Petitioner argues that, if this Court determines in *Oil States* that inter partes review violates Article III or the Seventh Amendment, the Federal Circuit's decision should be vacated and the case remanded for further proceedings to consider the ramifications of that holding for petitioner's case. Because this Court has rejected the constitutional challenges in *Oil States*, there is no need for further consideration of those issues by the court of appeals. The petition for a writ of certiorari should be denied.

1. Petitioner argues (Pet. 23-25) that its rights under the Due Process Clause were violated because inter partes reexamination procedures do not provide for confrontation or cross-examination of expert declarants. That argument lacks merit.

a. "The essence of due process is the requirement that a person in jeopardy of a serious loss be given notice of the case against him and opportunity to be meet it." *Mathews v. Eldridge*, 424 U.S. 319, 348 (1976) (brackets, citation, and internal quotation marks omitted). Whether particular procedures are constitutionally required to

effectuate those guarantees depends on a balancing of interests, taking into account “the fairness and reliability” of the existing procedures “and the probable value, if any, of additional procedural safeguards.” *Id.* at 343.

Under this framework, petitioner had no constitutional right to confront and cross-examine Shell Oil’s expert declarants during the inter partes reexamination. Petitioner does not “dispute that inter partes reexamination provides the patent owner with notice and an opportunity to be heard by a disinterested decisionmaker.” *Abbott Labs. v. Cordis Corp.*, 710 F.3d 1318, 1328 (Fed. Cir. 2013). Nor does petitioner dispute that the reexamination mechanism afforded it substantial procedural protections, including the opportunity to review and respond to expert declarations, see, *e.g.*, C.A. App. 2178-2184 (petitioner’s brief in response to Shell Oil’s evidentiary submissions), and the opportunity to submit its own expert declarations in rebuttal, see, *e.g.*, *id.* at 2234-2259 (first Rush declaration); *id.* at 4851-4866 (second Rush declaration); *id.* at 2387-2399 (Bokhart declaration).

Petitioner contends (Pet. 9, 13) that the agency was also constitutionally required to allow petitioner to depose Shell Oil’s experts. That argument lacks merit. Relying on the Federal Circuit’s decision in *Abbott Laboratories, supra*, the Director correctly explained that subpoenas for deposition testimony in a reexamination are not an “indispensable ingredient[] of due process.” C.A. App. 3029-3030, 3057-3058. The statute and regulations governing inter partes reexaminations protect patent owners’ due process interests through other mechanisms, by providing notice, an opportunity to submit arguments and other written materials in response

to a reexamination petition, several mechanisms for further review within the agency, and judicial review thereafter.

b. Contrary to petitioner's contention (Pet. 19-22, 25-31), the Federal Circuit's affirmance of the Board's ruling does not conflict with any decision of another court of appeals. Petitioner identifies no decision that has found a due process right to confront and cross-examine an expert declarant in an administrative proceeding in which the litigant had extensive other opportunities to contest the witness's testimony and introduce rebuttal evidence. The decisions on which petitioner relies involved factual settings significantly different from the circumstances here.

In *Nevels v. Hanlon*, 656 F.2d 372 (8th Cir. 1981), the court of appeals held that a due process violation could result from a party's inability to review all of the evidence presented to an adjudicator if the adjudicator relied on the evidence that the party was unable to review and rebut. *Id.* at 375-376. That holding is inapposite here because petitioner had ample opportunity to review and respond to Shell Oil's submissions.

The decision below likewise does not conflict with *Business Communications, Inc. v. United States Department of Education*, 739 F.3d 374 (8th Cir. 2013). The court of appeals in *Business Communications* found a right of confrontation in a particular administrative proceeding only because of the centrality of credibility judgments to the question that the agency proceeding resolved. In assessing whether the government was required to afford an opportunity for confrontation and cross-examination of employees in determining whether an employer had fired a worker in retaliation for a protected complaint, the court emphasized

that the disputed issue in that proceeding depended on the use of credibility determinations to resolve conflicting accounts. *Id.* at 378-380. The court stated that “[w]here, as here, many of the [agency’s] reasons for its decision depend on the credibility of individual witness testimony, cross-examination must be available to minimize the risk of erroneous deprivation.” *Id.* at 380.<sup>2</sup>

The other decisions that petitioner cites (Pet. 29) did not recognize a constitutional right to confront or cross-examine witnesses in the administrative proceedings that were before the court—let alone in proceedings comparable to inter partes reexamination. The court of appeals in *Cooper v. Salazar*, 196 F.3d 809 (7th Cir. 1999), stated that “there are times when due process requires” confrontation and cross-examination “even during an informal administrative investigation.” *Id.* at 815. But it emphasized that the Due Process Clause is particularly likely to require those safeguards in contexts where agencies make factual determinations that rest on credibility judgments. *Id.* at 815-816. The court did not decide whether there was a right of confrontation and cross-examination in the administrative investigations of possible civil rights violations that were at issue in the case; it determined only that the plaintiffs who had challenged the absence of those safeguards had

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<sup>2</sup> In *Tyree v. Evans*, 728 A.2d 101 (D.C. 1999), the court similarly recognized a right of confrontation and cross-examination with respect to witnesses in proceedings not analogous to a USPTO reexamination of its patent grant. After weighing multiple factors, the court there concluded that the Due Process Clause required an opportunity for cross-examination of the testifying complainant in civil-protection-order proceedings related to a domestic-violence incident. *Id.* at 105.

“demonstrated a more than negligible chance of success.” *Id.* at 816; see *id.* at 811-812, 815.

Similarly, the court of appeals in *Cuellar v. Texas Employment Commission*, 825 F.2d 930 (5th Cir. 1987), suggested that there might be a confrontation right with respect to a fact witness in a dispute over unemployment benefits, either because of the relevance of “credibility concerns” to the dispute, because the claimant had received “inadequate notice of the adverse affiant’s testimony,” or for other reasons. *Id.* at 939. After setting out those considerations, however, the court stated that the claimant might have no confrontation right in the hearing at hand, and it remanded the case to allow the district court to make that determination. *Id.* at 940. None of the decisions cited by petitioner recognize a right to confront or cross-examine expert declarants in proceedings analogous to inter partes reexamination, or otherwise indicate that inter partes reexamination proceedings do not comport with principles of procedural due process.

c. The question presented is one of limited prospective importance. Enacted in 2011, the AIA replaced inter partes reexamination with inter partes review. The statute further directed the USPTO to prescribe regulations “setting forth standards and procedures for discovery of relevant evidence” including “the deposition of witnesses submitting affidavits or declarations,” 35 U.S.C. 316(a)(5)(A), and the USPTO has promulgated regulations providing for such depositions, 37 C.F.R. 42.53; see 37 C.F.R. 42.51(b)(1)(ii). Since “[i]nter partes reexamination was phased out when the [AIA] went into effect,” *Oil States*, 138 S. Ct. at 1371, the last day for filing petitions for inter partes reexamination was September 16, 2012. See AIA § 6(c)(2)(A)

and (3)(B)(ii), 125 Stat. 304-305; 76 Fed. Reg. 59,055 (Sept. 23, 2011) (final rule). Because only a handful of inter partes reexaminations remain pending before the USPTO, the question whether participants in such reexaminations are entitled to confront and cross-examine expert declarants has little prospective significance.

2. Petitioner contends (Pet. 35-39) that the court of appeals violated 35 U.S.C. 144 by issuing a summary order under Federal Circuit Rule 36. That rule provides that “[t]he court may enter a judgment of affirmance without opinion” if “an opinion would have no precedential value” and if the decision “is based on findings that are not clearly erroneous,” has been entered without an error of law, or warrants affirmance under the standard of review in the statute authorizing the petition for review. Fed. Cir. R. 36.

Section 144 does not require the court of appeals to issue an opinion in every appeal from the Board. That provision addresses how the Federal Circuit should give notice of dispositions in Board appeals and directs that the court’s decision in a matter must govern any further agency proceedings. It specifies that, upon determination of an appeal from the USPTO, the Federal Circuit “shall issue to the Director its mandate and opinion, which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case.” 35 U.S.C. 144. Although the statute thus requires that any mandate and opinion be sent to the agency and made part of the agency record, it does not direct the court to generate an opinion in every case.

This understanding of Section 144 is supported by longstanding principles concerning courts’ control over their operations. Congress has authorized the courts of



appeals to “prescribe rules for the conduct of their business,” so long as those rules are consistent with statutory requirements and with the federal rules of procedure and evidence. 28 U.S.C. 2071(a). This Court has recognized that “the courts of appeals should have wide latitude in their decisions of whether or how to write opinions,” and that this principle is “especially true with respect to summary affirmances.” *Taylor v. McKeithen*, 407 U.S. 191, 194 n.4 (1972) (per curiam). Courts of appeals have often exercised that authority through rules that authorize unpublished summary dispositions. See 1st Cir. R. 36.0(a); 2d Cir. R. 32.1.1; 5th Cir. R. 47.6; 7th Cir. R. 32.1; 8th Cir. R. 47A, 47B; 10th Cir. R. 36.1. The longstanding tradition that appellate courts may establish their own procedures concerning when to issue opinions counsels strongly against reading Section 144 to contain an implicit prohibition on the use of summary affirmances.

The question presented is also one of limited practical significance. A Rule 36 summary affirmance is not meaningfully different from a summary affirmance in the circuits that issue brief nonprecedential opinions stating that the decision of the agency is affirmed for reasons outlined in the agency’s decision. The Federal Circuit authorizes summary affirmance only when “an opinion would have no precedential value” and no reversible error has been identified. See Fed. Cir. R. 36. Thus, when a Rule 36 summary affirmance is used to reject a legal challenge that is reviewed de novo, the affirmance communicates the court’s judgment that the agency committed no legal error. See Fed. Cir. R. 36(d) and (e) (authorizing summary affirmance when “a judgment or decision has been entered without an error of law” or when “the decision of an administrative agency

warrants affirmance under the standard of review in the statute authorizing the petition for review”). The use of Rule 36 to reject a factual challenge would similarly communicate that the court found no clear error in the underlying factual finding. See Fed. Cir. R. 36(a) (permitting summary affirmance under Rule 36 if the decision below “is based on findings that are not clearly erroneous”). An opinion that stated such a conclusion explicitly would add little to what is already implicit in the court’s Rule 36 judgment.<sup>3</sup>

Petitioner further contends (Pet. 37) that the Federal Circuit “stands alone in its rampant use of summary affirmances.” Petitioner fails to show, however, that the court’s use of Rule 36 affirmances is in any way improper in light of the court’s docket. Although the Federal Circuit has used Rule 36 affirmances more frequently as the number of appeals from USPTO decisions has skyrocketed, see U.S. Courts, *Federal Judicial Caseload Statistics 2017*, <http://www.uscourts.gov/statistics-reports/federal-judicial-caseload-statistics-2017> (describing 1183% increase in appeals from USPTO decisions between 2008 and 2017), that increase does not suggest that the court is breaching its duty to articulate the law. The Federal Circuit issues Rule 36 judgments after giving cases “the full consideration of the court,” *United States Surgical Corp. v. Ethicon, Inc.*, 103 F.3d 1554, 1556 (Fed. Cir.), cert. denied, 522 U.S. 950 (1997), and summary orders are among the tools that courts may use to resolve their cases even

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<sup>3</sup> A Rule 36 summary affirmance is a judgment of the court of appeals and is subject to this Court’s review. In *Oil States*, for example, the Court reviewed the Federal Circuit’s Rule 36 judgment. *Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC*, 639 Fed. Appx. 639 (2016), aff’d, 138 S. Ct. 1365 (2018).

though such decisions do not provide precedential guidance. See *McKeithen*, 407 U.S. at 194 n.4.

In any event, petitioner identifies no workable means by which this Court, in reviewing the *particular* unpublished disposition that is at issue in this case, could assess whether the Federal Circuit is issuing Rule 36 judgments in an inordinate number of appeals. This Court has recently and repeatedly denied challenges to the Federal Circuit’s use of summary dispositions under Rule 36,<sup>4</sup> and the same result is warranted here.

3. Petitioner contends (Pet. 39-40) that the petition for a writ of certiorari should be held pending this Court’s decision in *Oil States*. Petitioner states that, if the Court in *Oil States* “concludes that [inter partes reviews] are unconstitutional, its reasoning should apply with equal force to inter partes reexaminations.” Pet. 39 (emphasis omitted). Petitioner urges that, if this Court finds inter partes review to be constitutionally deficient, it should grant certiorari, vacate the judgment below, and remand the case for further consideration in light of *Oil States*. *Ibid.* On April 24, 2018, after the petition in this case was filed, this Court held in *Oil States* that inter partes review is consistent with Article

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<sup>4</sup> See, e.g., *Shore v. Lee*, 137 S. Ct. 2197 (2017) (No. 16-1240); *Concaten, Inc. v. AmeriTrak Fleet Solutions, LLC*, 137 S. Ct. 1604 (2017) (No. 16-1109); *Cloud Satchel, LLC v. Barnes & Noble, Inc.*, 136 S. Ct. 1723 (2016) (No. 15-1161); *Hyundai Motor Am. v. Clear with Computers, LLC*, 134 S. Ct. 619 (2013) (No. 13-296); *Kastner v. Chet’s Shoes, Inc.*, 565 U.S. 1201 (2012) (No. 11-776); *White v. Hitachi, Ltd.*, 565 U.S. 825 (2011) (No. 10-1504); *Max Rack, Inc. v. Hoist Fitness Sys., Inc.*, 564 U.S. 1057 (2011) (No. 10-1384); *Romala Stone, Inc. v. Home Depot U.S.A., Inc.*, 562 U.S. 1201 (2011) (No. 10-777); *Wayne-Dalton Corp. v. Amarr Co.*, 558 U.S. 991 (2009) (No. 09-258); *Tehrani v. Polar Electro*, 556 U.S. 1236 (2009) (No. 08-1116).

III and the Seventh Amendment. 138 S. Ct. at 1373. That decision does not cast doubt on the correctness of the judgment below.

The question whether inter partes reexamination violates Article III and the Seventh Amendment does not independently warrant this Court's review. The *Oil States* Court's determination that inter partes review is a constitutionally permissible mechanism for USPTO to reconsider its own patent grant leaves no real doubt as to the constitutionality of inter partes reexamination, an alternative means by which the agency achieves the same objective. And because the AIA replaced inter partes reexamination with inter partes review, questions concerning the constitutionality of inter partes reexamination are of diminishing importance. Finally, because petitioner did not argue in the court of appeals that inter partes reexamination violates Article III or the Seventh Amendment, this case would be a poor vehicle for considering such a challenge.

#### CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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MAY 2018