No. 08-1284

In the Supreme Court of the United States

DBC, PETITIONER

v.

PATENT AND TRADEMARK OFFICE, BOARD OF PATENT APPEALS AND INTERFERENCES

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

BRIEF FOR THE RESPONDENT IN OPPOSITION

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QUESTION PRESENTED

Whether the decision of the Board of Patent Appeals and Interferences in this case should be vacated because two of the members of the panel were appointed by the Director of the Patent and Trademark Office rather than the Secretary of Commerce, when petitioner did not raise its Appointments Clause challenge before the Board.

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OPINIONS BELOW

The opinion of the court of appeals (Pet. App. 1a-24a) is reported at 545 F.3d 1373. The opinion of the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office (Pet. App. 25a-61a) is not reported.

JURISDICTION

The judgment of the court of appeals was entered on November 3, 2008. A petition for rehearing was denied on January 16, 2009 (Pet. App. 62a-63a). The petition for a writ of certiorari was filed on April 15, 2009. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

STATEMENT

1. The United States Patent and Trademark Office (USPTO) is "responsible for the granting and issuing of patents," subject to the policy direction of the Secretary of Commerce. 35 U.S.C. 2(a)(1). The "powers and duties" of the USPTO are vested in the "Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office" (Director), who is appointed by the President with the advice and consent of the Senate. 35 U.S.C. 3(a)(1).

When a patent examiner within the USPTO makes an adverse decision on a patent application during original examination or on a patent during reexamination, the disappointed patent applicant or patent owner may appeal the decision to the Board of Patent Appeals and Interferences (Board). The Board includes, *inter alia*, the Director, the Commissioner for Patents, the Commissioner for Trademarks, and "administrative patent judges." 35 U.S.C. 6(a) and (b); 35 U.S.C. 134(a) and (b). The members of the Board who are "administrative patent judges" are required by statute to be "be persons of competent legal knowledge and scientific ability." 35 U.S.C. 6(a). Each appeal to the Board must be heard by "at least three members of the Board, who shall be designated by the Director." 35 U.S.C. 6(b). A patent owner may seek judicial review of an adverse decision of the Board in the United States Court of Appeals for the Federal Circuit. 35 U.S.C. 141, 306.

Between 2000 and 2008, administrative patent judges were "appointed by the Director." 35 U.S.C. 6(a). Since August 2008, they have instead been "appointed by the Secretary of Commerce, in consultation with the Director." Act of Aug. 12, 2008 (2008 Act), Pub. L. No. 110-313, § 1(a)(1)(B), 122 Stat. 3014 (to be codified at 35

U.S.C. 6(a)). When Congress changed the appointment method in 2008, it authorized the Secretary, "in his or her discretion, [to] deem the appointment of an administrative patent judge who, before [August 12, 2008], held office pursuant to an appointment by the Director to take effect on the date on which the Director initially appointed the administrative patent judge." *Id.* § 1(a)(1)(C), 122 Stat. at 3014 (to be codified at 35 U.S.C. 6(c)). Congress also provided that, in cases involving "a challenge to the appointment of an administrative patent judge on the basis of the judge's having been originally appointed by the Director," "[i]t shall be a defense * * * that the administrative patent judge so appointed was acting as a de facto officer." *Ibid.* (to be codified at 35 U.S.C. 6(d)). Shortly after the statute was enacted, the Secretary re-appointed all of the current administrative patent judges who were initially appointed between 2000 and 2008, effective on the respective dates they were appointed by the Director.

2. Petitioner owns a patent that was issued in May 2004 and is directed to a "nutraceutical composition[] comprising a mixture of the pulp and pericarp of the mangosteen fruit." Pet. App. 2a. In October 2004, pursuant to a request filed by a third party, a patent examiner at the USPTO reexamined the patent and invalidated it on the ground that its subject matter would have been obvious at the time of invention. *Id.* at 3a-4a.

Petitioner appealed the examiner's decision to the Board. On June 20, 2007, a three-member panel of the Board heard oral argument on the appeal. Pet. App. 27a. On August 24, 2007, the panel affirmed the examiner's decision. *Id.* at 25a-61a.

3. a. Petitioner then sought judicial review in the court of appeals, challenging the determination of obvi-

ousness. Pet. App. 5a. After the close of briefing in the court of appeals, petitioner filed a supplemental brief, arguing for the first time that the Board's decision should be vacated because two of the three administrative patent judges who had participated in the case had been appointed by the Director. *Id.* at 6a-7a & n.2. Petitioner contended that the appointment of administrative patent judges by the Director violated the Appointments Clause, which requires that inferior officers be appointed by "the President alone, * * * the Courts of Law, or * * * the Heads of Departments." U.S. Const. Art. II, § 2, Cl. 2.

The government responded that petitioner had waived any challenge to the appointment of the Board members by failing to raise the issue before the agency or in its opening and reply briefs before the court of appeals. Pet. App. 6a. The government explained that, if petitioner had raised its objection before the Board, the Board might have chosen to avoid any potential constitutional violation by convening a new panel with members whom the Secretary of Commerce had appointed prior to 2000. See *id.* at 9a. The government also argued that the 2008 Act altering the appointment of administrative patent judges had obviated petitioner's constitutional objection, both by authorizing the Secretary to appoint the administrative judges in petitioner's case and to deem their appointments to "take effect on the date on which the Director initially appointed" them, and by recognizing a defense on the ground that each of the judges had been "acting as a de facto officer" at the time the Board issued its decision. § 1(a)(1)(C), 122 Stat. at 3014 (to be codified at 35 U.S.C. 6(c) and (d)).

b. The court of appeals held that petitioner had waived its Appointments Clause challenge by failing to

raise it before the Board, explaining that "a party generally may not challenge an agency decision on a basis that was not presented to the agency." Pet. App. 7a. The court noted that even if petitioner did not learn which administrative patent judges had been assigned to its case until after its briefs were filed with the Board, it still had an opportunity to raise an Appointments Clause challenge in a post-argument submission or in a motion for reconsideration. *Id.* at 10a. The court explained that, if the challenge had been raised "before the Board, the Board could have evaluated and corrected the alleged constitutional infirmity." *Ibid.* As a result, a timely challenge before the Board could have "avoided the unnecessary expenditure of the administrative resources of the original Board panel, the judicial resources of [the court of appeals], and the substantial delay and costs incurred in prosecuting this appeal." *Id.* at 11a.

Recognizing that "excusal of [petitioner's] waiver is discretionary," the court of appeals considered several factors before declining to take the "exceptional measure" of accepting petitioner's invitation "to consider a challenge it failed to timely raise." Pet. App. 12a. The court noted that "permit[ting] litigants like [petitioner] to raise such issues for the first time on appeal would encourage * * * sandbagging." *Id.* at 13a. The court also considered the 2008 statute (which "eliminat[ed] the issue of unconstitutional appointments going forward"), the lack of "any allegation of incompetence or other impropriety regarding the administrative patent judges" in this case, the likelihood that a remand would simply result in having the case assigned "to the same panel [of the Board]" (each member of which has now been appointed by the Secretary), and the fact that the court it-

self was affirming the merits of the Board's decision. *Id.* at 13a-14a.[1]

c. On the merits, the court held that substantial evidence supports the Board's determination that the patent at issue was properly invalidated on obviousness grounds. Pet. App. 15a-24a.

ARGUMENT

Petitioner concedes (Pet. 20) that a court of appeals' decision whether to address "an Appointments Clause challenge raised for the first time on appeal is discretionary." In this case, the court of appeals' fact-bound decision not to address petitioner's forfeited argument is correct and does not conflict with any decision of this Court or any other court of appeals. Moreover, to the extent that petitioner raises additional constitutional challenges to the 2008 statute that altered the appointment of administrative patent judges, those arguments (which the court of appeals also declined to address) lack merit and do not implicate any conflicts in the courts of appeals. There is consequently no sound reason for this Court to depart from its usual practice of refraining to answer constitutional questions in the first instance.

1. Petitioner forfeited its constitutional challenge by failing to present the Appointments Clause issue either to the agency or in its opening brief or reply brief in the court of appeals. As a direct result of that forfeiture, the issue was never considered by the agency or the

[1] Because the court of appeals concluded that petitioner had waived its Appointments Clause challenge, the court declined to address the government's alternative contention that the administrative patent judges should be treated as de facto officers pursuant to the 2008 statute. Pet. App. 6a n.3, 14a.

court of appeals, and this Court should refrain from deciding the question as a matter of first impression.

a. Because "[t]his Court * * * is one of final review, 'not of first view,'" *FCC* v. *Fox Television Stations, Inc.*, 129 S. Ct. 1800, 1819 (2009) (quoting *Cutter* v. *Wilkinson*, 544 U.S. 709, 718 n.7 (2005)); see *Adarand Constructors, Inc.* v. *Mineta*, 534 U.S. 103, 110 (2001) (per curiam), it generally declines to consider arguments that have not been previously addressed. That is especially true with regard to constitutional questions. "If there is one doctrine more deeply rooted than any other in the process of constitutional adjudication, it is that [the Court] ought not to pass on questions of constitutionality . . . unless such adjudication is unavoidable." *Department of Commerce* v. *United States House of Representatives*, 525 U.S. 316, 343 (1999) (quoting *Spector Motor Serv., Inc.* v. *McLaughlin*, 323 U.S. 101, 105 (1944)). Thus, in *Fox Television*, the Court upheld certain FCC orders against a challenge under the Administrative Procedure Act, 5 U.S.C. 551 *et seq.*, but it declined to "decide their validity under the First Amendment" because the court of appeals had "not definitively rule[d] on the constitutionality of the Commission's orders." 129 S. Ct. at 1819.

The reasons for declining to consider issues that were not decided below are particularly strong when the litigant that seeks this Court's review failed to present its claims in a timely fashion to the lower court or the responsible Executive Branch agency. Requiring an issue to be timely raised in the proceedings below serves important purposes. It promotes judicial economy by ensuring that potentially dispositive issues can be resolved at the earliest possible stage, and it discourages "the practice of 'sandbagging,'" *i.e.*, allowing, "for stra-

tegic reasons," the lower court or administrative body to "pursue a certain course, and later—if the outcome is unfavorable—claiming that the course followed was reversible error." *Freytag* v. *Commissioner*, 501 U.S. 868, 895 (1991) (Scalia, J., concurring in part and concurring in the judgment); see also *Wainwright* v. *Sykes*, 433 U.S. 72, 89-90 (1977).

Both of those purposes would be served by denying review in this case. Petitioner never raised its constitutional challenge while its case was pending before the Board. Petitioner also failed to raise the issue in its opening or reply brief before the court of appeals. Allowing the decisions below to be overturned on the basis of a challenge to the Board's composition that was first raised long after petitioner knew which administrative patent judges would decide its appeal would waste judicial resources and encourage sandbagging in future cases. Because the Appointments Clause question was neither timely pressed nor passed upon below, the Court should follow its customary practice and refuse to decide the question in the first instance.

b. The court of appeals held (Pet. App. 6a) that petitioner had waived its constitutional challenge by failing to raise that issue while the case was pending before the Board. In response, petitioner contends that it would have been "impossible" to raise the claim before it knew which Board members would hear its appeal, Pet. 18, and that its failure to raise its constitutional challenge should be excused because an administrative agency cannot "entertain a claim that the statute which created it was in some respect unconstitutional." *Ibid*. (quoting *Robertson* v. *FEC*, 45 F.3d 486, 489 (D.C. Cir. 1995)). Those arguments are unpersuasive.

Petitioner does not contest the *creation* of the Board (or of the USPTO), but merely the appointment of *some* of the Board's members, each of whom serves on any particular case only upon designation by agency officials. And as the court of appeals observed (Pet. App. 10a), even if petitioner did not know the composition of the panel "until oral argument or until a decision was issued," petitioner still could have challenged the panel's composition "in a post-argument submission or in a motion for reconsideration." Oral argument before the Board was held on June 20, 2007, more than two months before the Board issued its decision. See *id.* at 25a, 27a.

If petitioner had raised its Appointments Clause challenge in a timely fashion, nothing in the governing statutes or in general principles of administrative law would have precluded the Board from remedying the alleged constitutional defect. According to the Board's standard operating procedures, which "create[] internal norms for the administration" of the Board, the Chief Judge or Vice Chief Judge "will approve a revised designation" of the judges on a panel "[w]hen satisfied that there is good reason to change the panel already designated."[2] Board of Patent Appeals and Interferences, *Standard Operating Procedure 1 (Revision 12): Assignment of Judges to Merits Panels, Motions Panels,*

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[2] Under 35 U.S.C. 6(b), a patent appeal within the USPTO is heard "by at least three members of the Board, who shall be designated by the Director." The Director has delegated the authority to designate panel members for individual cases to the Chief Administrative Patent Judge, who is also authorized to redelegate that authority to the Vice Chief Administrative Patent Judge. See U.S. Patent & Trademark Office, U.S. Dep't of Commerce, *Manual of Patent Examining Procedure* § 1002.02(f) at 1000-9 (8th ed., revision 6, Sept. 2007) <http://www.uspto.gov/web/offices/pac/mpep/mpep_e8r5_1000.pdf>.

and Expanded Panels 1, 6 (Aug. 10, 2005). As a result, if petitioner had raised its objection in a timely fashion (through, for example, a petition to the Chief Administrative Patent Judge under 37 C.F.R. 41.3), the agency would have had the power to replace the panel members to whom petitioner now objects. The Director, the Chief Judge, or the Vice Chief Judge might have determined that there was "good reason to change the panel already designated" if, for example, any of those officials wanted to avoid the uncertainty that might arise from a challenge to the constitutionality of any Board member's appointment.

Accepting petitioner's claim of futility would ratify a course of action that deprived the agency of any chance to consider measures that would have avoided the alleged constitutional problem. This is consequently an appropriate case to follow the "general rule" that "courts should not topple over administrative decisions unless the administrative body not only has erred, but has erred against objection made at the time appropriate under its practice." *Woodford* v. *Ngo*, 548 U.S. 81, 90 (2006) (emphasis and citation omitted).

c. Even if petitioner had pressed its constitutional argument before the Board, or if its failure to present that issue to the Board could be excused on the ground of futility, petitioner's failure to raise its Appointments Clause challenge in its opening brief or reply brief in the court of appeals would justify that court's decision not to address the question. A court of appeals is not required to address non-jurisdictional arguments that a party seeking appellate review forfeits by leaving them unmentioned in its opening and reply briefs. See, *e.g.*, 16AA Charles Alan Wright et al., *Federal Practice and Procedure* § 3974.1, at 232-243 & nn.13-19 (4th ed. 2008)

(citing cases). Indeed, "'[n]o procedural principle is more familiar to this Court than that a constitutional right,' or a right of any other sort, 'may be forfeited in criminal as well as civil cases by the failure to make timely assertion of the right before a tribunal having jurisdiction to determine it.'" *United States* v. *Olano*, 507 U.S. 725, 731 (1993) (quoting *Yakus* v. *United States*, 321 U.S. 414, 444 (1944)).

d. Although petitioner concedes (Pet. 20) that the court of appeals had "discretion[]" not to "hear an Appointments Clause challenge raised for the first time on appeal," petitioner contends (Pet. 18) that "[w]here a constitutional challenge is timely, it is against this Court's jurisprudence to avoid a decision on the merits of a question under the Appointments Clause." That argument is flawed for two reasons.

First, petitioner's challenge was not raised in a timely manner. Petitioner's reliance (Pet. 18) on *Ryder* v. *United States*, 515 U.S. 177 (1995), is misplaced. In *Ryder*, the Court stressed that the petitioner had "challenged the composition of the Coast Guard Court of Military Review while his case was pending before that court on direct review" and had thus "raised his objection to the judges' titles *before those very judges* and *prior to their action* on his case." *Id.* at 182 (emphases added). Here, by contrast, petitioner did not raise its Appointments Clause challenge until after the Board had ruled against it and the principal briefs had been filed in the court of appeals. Under these circumstances, petitioner's contention that the court of appeals was required to entertain his forfeited challenge directly implicates the concerns discussed above relating to judicial efficiency and the prevention of sandbagging. See pp. 7-8, *supra*.

Second, petitioner is wrong in contending (Pet. 19) that this Court's "jurisprudence" required the court of appeals to address an "untimely * * * Appointments Clause challenge on the merits." As the court of appeals explained, this Court has never adopted such a rule. Pet. App. 12a; see *Freytag*, 501 U.S. at 893-901 (Scalia, J., concurring in part and concurring in the judgment). This case is distinguishable from those "'rare cas[es]'" in which this Court has "'exercise[d] [its] discretion' to hear a waived claim based on the Appointments Clause." *Plaut* v. *Spendthrift Farm, Inc.*, 514 U.S. 211, 232 (1995) (quoting *Freytag*, 501 U.S. at 879).

Like *Plaut*, those rare cases (see Pet. 19-23) generally involved this Court's supervision and protection of uniquely judicial power, and especially Article III power. For example, in *Glidden Co.* v. *Zdanok*, 370 U.S. 530 (1962), the Court considered whether certain judges on the Court of Claims and the Court of Customs and Patent Appeals were Article III judges and thus eligible to sit on federal district courts and courts of appeals. Indeed, petitioner quotes (Pet. 19) the *Glidden* plurality's reference to "a strong policy concerning the proper administration of judicial business." 370 U.S. at 536 (opinion of Harlan, J.). In *Nguyen* v. *United States*, 539 U.S. 69 (2003), this Court prevented a non-Article-III judge from exercising Article III jurisdiction in a criminal case. In *Lamar* v. *United States*, 241 U.S. 103 (1916), the Court addressed whether a United States District Judge appointed in Michigan had jurisdiction to preside over a federal criminal trial in New York. *Id.* at 117-118. In *Freytag*, the Court addressed appointments within the Tax Court, which "exercise[d] judicial power to the exclusion of any other function" and was, unlike the Board here, determined by this Court to be "inde-

pendent of the Executive and Legislative Branches." 501 U.S. at 891.

Unlike the constitutional arguments raised in those cases, petitioner's challenge concerns the appointments of Executive Branch officials and does not affect the authority of any Article III court. See *FCC* v. *Pottsville Broad. Co.*, 309 U.S. 134, 141 (1940) (contrasting the relationship between courts in a unified Article III judicial system with the relationship between a court and an administrative agency). No compelling reason exists for excusing petitioner's failure to observe the bedrock procedural rule that a non-jurisdictional argument is forfeited unless timely asserted. See *Olano*, 507 U.S. at 731.

2. Even if petitioner had not forfeited its Appointments Clause challenge, this Court's review would be unwarranted because the question presented is one of little prospective importance. Administrative patent judges are now appointed by the Secretary of Commerce rather than by the Director of the USPTO. 2008 Act § 1(a)(1)(B), 122 Stat. 3014 (to be codified at 35 U.S.C. 6(a)). The Secretary of Commerce is indisputably a "Head[] of Department[]" under the Appointments Clause. See *Freytag*, 501 U.S. at 886; *id.* at 918-919 (Scalia, J., concurring in part and concurring in the judgment).

Petitioner takes issue (Pet. 15 n.3, 24-25) with the new requirement that the Secretary of Commerce appoint administrative patent judges "in consultation with" the Director of the USPTO (2008 Act § 1(a)(1)(B), 122 Stat. 3014 (to be codified at 35 U.S.C. 6(a))), but that consultation requirement creates no serious constitutional concern. In one of its earliest Appointments Clause decisions, this Court held that a statute under

which the Assistant Treasurer (an inferior officer in the Treasury Department) appointed clerks (also inferior officers) was constitutional because the appointments were required to be made "with the approbation of the Secretary of the Treasury." *United States* v. *Hartwell*, 73 U.S. (6 Wall.) 385, 393-394 (1868); see *United States* v. *Moore*, 95 U.S. 760, 762 (1878) (holding that the Secretary of the Navy's approval of the report of a board of examiners sufficed to appoint a "passed assistant-surgeon"); see also *Appointment and Removal of Inspectors of Customs*, 4 Op. Att'y Gen. 162, 164-165 (1843) (concluding that, under the Appointments Clause, a permanent customs inspector "can be regularly appointed by the Secretary of the Treasury on the nomination of the [district] collector [of customs]"). It follows *a fortiori* that the "consultation" requirement in the 2008 Act —which imposes fewer limits on the Secretary's appointment power, neither requiring the Director to act first nor placing any binding limit on the Secretary's ultimate selection of appointees—is consistent with the Appointments Clause.

3. Petitioner also challenges (Pet. 25-33) two other aspects of the 2008 Act: the Secretary's discretion to deem re-appointments of administrative patent judges to be effective "on the date on which the Director initially appointed" them, and Congress's express authorization of a defense that an administrative patent judge appointed by the Director before August 2008 was "acting as a de facto officer." § 1(a)(1)(C), 122 Stat. at 3014 (to be codified at 35 U.S.C. 6(c) and (d)). As with petitioner's principal constitutional argument, those questions were not addressed by the court of appeals, which is reason enough for this Court to decline to decide them in the first instance. The resolution of those questions,

moreover, would have no impact on the outcome of this case unless the Court considered and accepted petitioner's forfeited Appointments Clause challenge to the prior method of appointing administrative patent judges. In any event, petitioner's arguments lack merit and implicate no disagreement in the courts of appeals or conflict with this Court's decisions.

a. The 2008 Act authorizes the Secretary of Commerce, "in his or her discretion, [to] deem" the Secretary's appointment of that judge "to take effect on the date on which the Director initially appointed the administrative patent judge." § 1(a)(1)(C), 122 Stat. at 3014 (to be codified at 35 U.S.C. 6(c)). On August 12, 2008, the Secretary re-appointed all of the current administrative patent judges who were initially appointed between 2000 and 2008, effective on the respective dates they were appointed by the Director.

Contrary to petitioner's suggestion, it is well established that Congress may retroactively ratify executive actions, as well as authorize retroactive appointments of officers. See, *e.g.*, *Swayne & Hoyt, Ltd.* v. *United States*, 300 U.S. 297, 301-302 (1937) ("It is well settled that Congress may, by enactment not otherwise inappropriate, 'ratify . . . acts which it might have authorized.'") (citation omitted); *United States* v. *Heinszen & Co.*, 206 U.S. 370 (1907) (upholding against a due process challenge a 1906 statute that ratified duties on imports to Philippine Islands levied by the President during a period of time when Congress had not yet authorized any such tariffs); *Quackenbush* v. *United States*, 177 U.S. 20, 26-27 (1900) (recognizing Congress's power to authorize the retroactive appointment of officers of the United States).

Petitioner's reliance (Pet. 26-27) on *Plaut*, *supra*, is misplaced. That case involved retroactive legislation that would have set aside the final judgments of Article III courts. The Court in *Plaut* expressly contrasted that impermissible result with "the miscellany of decisions upholding legislation that altered rights fixed by the final judgments of non-Article III courts or administrative agencies." 514 U.S. at 232 (citations omitted). Here, the provision that petitioner challenges does not alter any final judgments of Article III courts. Indeed, it does not even alter any rights fixed by judgments of the Board. Instead, it *affirms* the expectations of the affected patent owners and licensees rooted in the Board's adjudication of their disputes.

b. The other provision of the 2008 Act that petitioner now contests states: "It shall be a defense to a challenge to the appointment of an administrative patent judge on the basis of the judge's having been originally appointed by the Director that the administrative patent judge so appointed was acting as a de facto officer." § 1(a)(1)(C), 122 Stat. at 3014 (to be codified at 35 U.S.C. 6(d)). As this Court has explained, the de-facto-officer doctrine "confers validity upon acts performed by a person acting under the color of official title even though it is later discovered that the legality of that person's appointment or election to office is deficient." *Ryder*, 515 U.S. at 180. The doctrine has deep historical roots, and it reflects this Court's longstanding recognition that "endless confusion would result if in every proceeding before * * * officers their title could be called in question." *Norton* v. *Shelby County*, 118 U.S. 425, 442 (1886).

Petitioner contends (Pet. 29) that application of the de-facto-officer doctrine in this case would "conflict[]

with the decisions of this Court," but it fails to demonstrate any actual conflict. This Court generally weighs at least four factors in considering whether to apply the doctrine. First, the doctrine rests on the "obviously sound policy of preventing litigants from abiding the outcome of a lawsuit and then overturning it if adverse upon a technicality of which they were previously aware." *Glidden Co.*, 370 U.S. at 535 (plurality opinion of Harlan, J.). In *Ryder*, the Court emphasized the importance of a timely objection, reasoning that "one who makes a timely challenge to the constitutional validity of the appointment of an officer who adjudicates his case is entitled to a decision on the merits of the question and whatever relief may be appropriate if a violation indeed occurred." 515 U.S. at 182-183. Unlike the private litigant in *Ryder*, petitioner did not raise its Appointment Clause challenge in a timely fashion. See p. 11, *supra*. In these circumstances, the de-facto-officer doctrine "prevent[s]" petitioner from "abiding the outcome of a lawsuit and then overturning it if adverse upon a technicality." *Glidden Co.*, 370 U.S. at 535 (plurality opinion of Harlan, J.).[3]

Second, the Court has "found a judge's actions to be valid *de facto* when there is a 'merely technical' defect of statutory authority." *Nguyen*, 539 U.S. at 77 (quoting *Glidden Co.*, 370 U.S. at 535 (plurality opinion of Harlan, J.)). The Court has described the difference between an appointment that was improper because of a "technical"

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[3] See *Andrade* v. *Lauer*, 729 F.2d 1475, 1499 (D.C. Cir. 1984) (holding that a plaintiff seeking to avoid application of the de-facto-officer doctrine must both "bring his action at or around the time that the challenged government action is taken * * * [and] show that the agency or department involved has had reasonable notice under all the circumstances of the claimed defect in the official's title to office").

defect and one infected by a more significant problem as "the difference between an action which could have been taken, if properly pursued, and one which could never have been taken at all." *Id.* at 79. Here, there is no dispute that the administrative patent judges in question were "persons of competent legal knowledge and scientific ability," as required by statute, 35 U.S.C. 6(a), and they were therefore eligible to serve notwithstanding any technical defect in their appointments.

Third, this Court has invoked the de-facto-officer doctrine to uphold the acts of an improperly constituted administrative commission, see *Buckley* v. *Valeo*, 424 U.S. 1, 142 (1976) (per curiam), and unconstitutionally apportioned state legislatures, see *ibid.* (citing *Connor* v. *Williams*, 404 U.S. 549, 550-551 (1972) (per curiam)). Although the Court has been reluctant to apply the doctrine when considering alleged incursions on Article III power,[4] such cases implicate the Court's role as guardian of Article III authority and supervisor of the federal courts. Here, by contrast, although the Board performs adjudicative functions, it is indisputably part of an Executive Branch agency. See *Dickinson* v. *Zurko*, 527 U.S. 150, 154 (1999). Any improper appointment of its members presents no Article III issues.

Fourth, the Court has shown great sensitivity to the practical consequences that rejection of the de-facto-officer doctrine would entail. The doctrine aims to prevent "the chaos that would result from multiple and repetitious suits challenging every action taken by every official whose claim to office could be open to question,

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[4] See *Nguyen*, *supra* (ruling on the statutory propriety of permitting a non-Article III judge to sit on a Ninth Circuit panel); *Glidden Co.*, *supra* (deciding whether two "United States Courts" were Article III or Article I courts).

and * * * to protect the public by insuring the orderly functioning of the government despite technical defects in title to office." *Ryder*, 515 U.S. at 180 (quoting 63A Am. Jur. 2d *Public Officers and Employees* § 578, at 1080-1081 (1984)). Here, refusing to give Board decisions de facto validity would unsettle the expectations of patent holders and licensees.

In addition, whereas application of the de-facto-officer doctrine typically involves a reviewing court's application of judge-made rules governing the appropriate exercise of remedial discretion, the 2008 Act expressly provides that the doctrine "shall be a defense to a challenge" like the one presented here. § 1(a)(1)(C), 122 Stat. at 3014 (to be codified at 35 U.S.C. 6(d)). That directive reflects Congress's evident desire to prevent technical challenges from disrupting settled expectations in the manner described above, and it is controlling unless the Constitution precludes Congress from mandating de-facto-officer treatment in the circumstances of this case. Petitioner cites no decision in which this Court has declared unconstitutional a federal statutory provision calling for application of the de-facto-officer doctrine. And in light of petitioner's failure to raise its Appointments Clause challenge either before the Board or in its principal briefs in the court of appeals, the relevant provision of the 2008 Act is clearly constitutional as applied to this case.

4. Finally, this Court's review of the former method of appointing administrative patent judges is not warranted because of the limited practical significance of that issue. As petitioner acknowledges (Pet. 8-9 & n.2), there is only one other case in which a party has challenged a Board decision rendered by a panel that included judges appointed under the pre-August 12, 2008

appointments scheme. And the plaintiff in that case, *In re Hickman*, No. 2008-1437, 2009 WL 899806 (Fed. Cir. Apr. 3, 2009), also failed to raise any Appointments Clause objection before the Board.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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