

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

ARTHREX, INC.,

Appellant,

– v. –

SMITH & NEPHEW, INC., ARTHROCARE CORP.,

Appellees,

UNITED STATES,

Intervenor.

*On Appeal from the United States Patent and Trademark Office,
Patent Trial and Appeal Board in No. IPR2017-00275*

**BRIEF FOR *AMICUS CURIAE* NEW YORK
INTELLECTUAL PROPERTY LAW ASSOCIATION
IN SUPPORT OF INTERVENOR’S PETITION FOR
REHEARING *EN BANC***

CHARLES R. MACEDO
*Counsel of Record
Co-Chair, PTAB Committee*

DAVID P. GOLDBERG
Co-Chair, Amicus Briefs Committee
AMSTER, ROTHSTEIN & EBENSTEIN LLP
90 Park Avenue
New York, NY 10016
(212)336-8000
Cmacedo@arelaw.com

KSENIA TAKHISTOVA
7 Ellison Avenue
East Brunswick, NJ 08816

ROBERT M. ISACKSON
*First Vice President and Board Liaison,
Amicus Briefs Committee*

LEASON ELLIS LLP
1 Barker Avenue
White Plains, NY 10601

ROBERT J. RANDO
Board Member
THE RANDO LAW FIRM P.C.
6800 Jericho Turnpike Suite 120W
Syosset, NY 11791

*Counsel for Amicus Curiae New York
Intellectual Property Law Association*

DECEMBER 30, 2019

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

ARTHREX, INC. v. SMITH & NEPHEW, INC.

No. 2018-2140

CERTIFICATE OF INTEREST

Pursuant to Federal Circuit Rules 29 and 47.4, counsel for *amicus curiae* New York Intellectual Property Law Association certifies the following:

1. The full names of every party or *amicus* represented by me are:

New York Intellectual Property Law Association

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:

New York Intellectual Property Law Association

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:

Not applicable

4. The names of all law firms and the partners or associates that appeared for any of the parties or *amicus* now represented by me in trial court or agency or are expected to appear in this Court are:

AMSTER, ROTHSTEIN & EBENSTEIN LLP: Charles R. Macedo; David P. Goldberg

LEASON ELLIS LLP: Robert M. Isackson

THE RANDO LAW FIRM P.C.: Robert J. Rando

Ksenia Takhistova

5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal are:

Uniloc 2017 LLC v. Facebook, Inc., No. 18-2251 (Fed. Cir. Oct. 31, 2019)
Bedgear, LLC v. Fredman Bros. Furniture Co., Inc., Nos. 18-2082, 18-2083, 18-2084 (Fed. Cir. Nov. 7, 2019)
Customedia Techs., LLC v. DISH Network Corp., No. 18-2239 (Fed. Cir. Nov. 1, 2019)
Customedia Techs., LLC. v. DISH Network Corp., No. 19-1001 (Fed. Cir. Dec. 23, 2019)
Polaris Innovations Ltd. v. Kingston Tech. Co., Inc., Nos. 18-1768, 18-1831 (Fed. Cir. Nov. 8, 2019)

Dated: December 30, 2019

By: /s/Charles R. Macedo
Charles R. Macedo
AMSTER, ROTHSTEIN & EBENSTEIN LLP

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I. INTEREST OF *AMICUS CURIAE*

The New York Intellectual Property Law Association (“NYIPLA”) respectfully submits this *amicus curiae* brief in support of the petition for rehearing *en banc* filed by the United States.¹ The arguments set forth herein were approved on December 27, 2019 by an absolute majority of the officers and members of the Board of Directors of the NYIPLA (including any officers or directors who did not vote for any reason, including recusal), but do not necessarily reflect the views of a majority of the members of the NYIPLA, or of the law or corporate firms with which those members are associated.

No party’s counsel authored this brief in whole or in part. No party or party’s counsel contributed money that was intended to fund preparing or submitting this brief. No person other than *amicus curiae*, its members, or its counsel contributed money that was intended to fund preparing or submitting this brief.

After reasonable investigation, the NYIPLA believes that no officer, director or member of the Committee on Amicus Briefs who voted in favor of filing this

¹ Arthrex, Inc., Smith & Nephew, Inc., ArthroCare Corp., and the United States consented in writing to the filing of the brief. Pursuant to Federal Circuit Rule 35(g), a motion for leave to file is being submitted with this brief.

brief, nor any attorney associated with any such officer, director or committee member in any law or corporate firm, represents a party in this litigation.

The NYIPLA is a professional association of approximately 1,000 attorneys whose interests and practices lie in the area of patent, trademark, copyright, and other intellectual property (“IP”) law. It is one of the largest regional IP bar associations in the United States. The NYIPLA’s members include a diverse array of attorneys specializing in patent law, including in-house counsel for businesses that own, enforce, and challenge patents, as well as attorneys in private practice who prosecute patents and represent entities in various proceedings before the U.S. Patent and Trademark Office (“PTO”).

Many of the NYIPLA’s member attorneys actively participate in patent litigation, representing both patent owners and accused infringers, as well as in *inter partes* review (“IPR”) and other post-issuance proceedings before the Patent Trial and Appeal Board (“PTAB”), and their appeals before this Court. The NYIPLA thus brings an informed perspective of stakeholders to the issues presented. The NYIPLA, its members, and their respective clients share a strong interest in the issues presented in this case.

II. THE PANEL’S DECISION IN *ARTHREX* AND QUESTIONS PRESENTED IN PETITIONS FOR REHEARING *EN BANC*

The *Arthrex* panel decision addressed whether administrative patent judges (“APJs”) serving on the PTAB were appointed in violation of the Appointments

Clause, U.S. CONST., art. II, § 2, cl. 2. *See Arthrex, Inc. v. Smith & Nephew, Inc.*, No. 18-2140 (Fed. Cir. Oct. 31, 2019) (“Opinion”). The panel held that APJs are “principal officers” under the Patent Act (Title 35) as it has been enacted and structured. Opinion at 20. As such, the appointment of APJs by the Secretary of Commerce was held to be a constitutional violation. *Id.* To “fix” this constitutional defect, the panel severed the portion of the Patent Act restricting removal of the APJs only “for cause,” thus purportedly rendering APJs “inferior officers” going forward and remedying the constitutional appointment problem. *Id.* at 25-26.

The Opinion raises important issues at the heart of practice before the PTAB and has the potential to affect numerous PTAB decisions and this Court’s determinations of appeals. As of November 2019, there have been over 10,000 trials held by the PTAB.² Indeed, forty-three percent of this Court’s caseload (over 600 appeals) in 2019 came from appeals from the PTO.³ Prompt, efficient resolution of the issues presented is warranted and requires an analysis by the Court as a whole.

² *Trial Statistics: IPR, PGR, CBM*, UNITED STATES PATENT AND TRADEMARK OFFICE, at 3 (Nov. 2019), https://www.uspto.gov/sites/default/files/documents/fy20_nov_trial_stats.pdf.

³ *United States Court of Appeals for the Federal Circuit: Appeals Filed, By Category*, UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT (2019), http://www.cafc.uscourts.gov/sites/default/files/the-court/statistics/04_-_Appeal_Filed_by_Category_2019_Final.pdf.

Significantly, all parties to this action seek review by the full Court in three separate petitions.

The NYIPLA believes that the Court should grant *en banc* review of this case and adopt the formulation of the issues as presented by the United States in its Petition, namely:

1. Whether the administrative patent judges of the Patent Trial and Appeal Board are inferior officers of the United States under the Appointments Clause, U.S. CONST. art. II, § 2, cl. 2, such that Congress permissibly vested their appointments in a department head, rather than principal officers who must be nominated by the President and confirmed by the Senate.
2. Whether this Court should entertain an Appointments Clause challenge a litigant forfeited by failing to raise it before the agency.
3. How to remedy any Appointments Clause defect in the Patent Trial and Appeal Board.

United States Pet. for Reh'g En Banc, Arthrex, Inc. v. Smith & Nephew, Inc., No. 18-2410 (Fed. Cir. Dec. 16, 2019).

Thus, the NYIPLA submits this *amicus curiae* brief in support of the full Court accepting the United States’ petition. The NYIPLA takes no position on which party should ultimately prevail on the merits of the underlying dispute.

III. THE ISSUES AS RAISED BY THE UNITED STATES ARE THE SUBJECT OF SUBSTANTIAL DEBATE AND SHOULD BE ADDRESSED BY THE FULL COURT

The issues raised by the United States in its Petition are the subject of substantial debate and should be addressed by the full Court.

A. *En Banc* Review Is Necessary to Address Whether APJs Are Principal or Inferior Officers

There is no dispute that APJs are “officers of the United States,” because they “exercise significant authority.” Opinion at 8. However, whether they are principal officers, requiring appointment by the President with the advice and consent of the Senate, or inferior officers who may be appointed by the Secretary of Commerce in accordance with the America Invents Act (“AIA”), a law passed by Congress, is subject to significant debate.

Relying upon the Supreme Court’s guidance in *Edmond v. United States*, 520 U.S. 651 (1997), the panel explained that there is no exclusive criterion for distinguishing between principal and inferior officers. Specifically, *Edmond* emphasized three factors: “(1) whether an appointed official has the power to review and reverse the officers’ decisions; (2) the level of supervision and

oversight an appointed official has over the officers; and (3) the appointed official's power to remove the officers.” *Id.* at 664-65. The panel decided that two factors weighed in favor of APJs being found principal officers, and one factor weighed in favor of APJs being found inferior officers. Opinion at 20.

Significantly, while each of the Supreme Court cases on which the panel relied supported the proposition that APJs are “officers” of the United States, every single one of those cases, in what could be characterized as analogous statutory frameworks, have concluded that the officers in question were “inferior officers” under the Appointments Clause:

- *Lucia v. SEC*, 138 S. Ct. 2044 (2018) (SEC Administrative Law Judges are inferior officers);
- *Free Enter. Fund v. Pub. Co. Accounting Oversight Bd.*, 561 U.S. 477 (2010) (Public Company Accounting Oversight Board members are inferior officers);
- *Edmond*, 520 U.S. 651 (judges of the Coast Guard Court of Criminal Appeal are inferior officers);
- *Freytag v. Commissioner*, 501 U.S. 868 (1991) (Special Trial Judges for the Tax Court are inferior officers);
- *Morrison v. Olson*, 487 U.S. 654 (1988) (independent counsel created by provisions of the Ethics of Government Act of 1978 are inferior officers);

- *Myers v. United States*, 272 U.S. 51 (1926) (post-master first class is an inferior officer); and
- *In re Hennen*, 38 U.S. 230 (1839) (clerks of district courts are inferior officers).

The sole authority relied upon by the panel to support the conclusion that APJs are principal officers was *Intercollegiate Broad. Sys. v. Copyright Royalty Bd.*, 684 F.3d 1332 (D.C. Cir. 2012), in which a 3-judge panel of the D.C. Circuit held that Copyright Royalty Judges are principal officers.

Respectfully, in view of the dearth of other supporting authority from the Supreme Court, the full Federal Circuit should address this issue.

B. *En Banc* Review Is Necessary to Determine Whether the Applied Remedy for the Purported Constitutional Defect Was Sufficient

Even if APJs are deemed to be “principal” officers, there is still a significant debate as to whether the Opinion’s solution is a proper and adequate remedy to the alleged Appointments Clause defect. Specifically, having determined that the prior appointment of APJs violates the Constitution, the Opinion severed the protections of 35 U.S.C. § 3(c) as applied to APJs (but not other officers), allowing for their removal “at will.” Opinion at 25-27. The Opinion determined that this modification converts APJs to inferior officers, thus remedying the constitutional appointment defect going forward. *Id.* The *Arthrex* Final Written Decision of the PTAB was vacated, and the case remanded, to be decided by a new panel of properly appointed APJs. *Id.* at 27.

This holding is subject to substantial debate including:

- whether the way that the panel severed the statute is an improper judicially promulgated rewrite of the statute since the severance only applied to APJs in contrast to all the officers covered by that statute;
- whether such severance is consistent with Congressional intent; and
- whether such severance is consistent with labor laws and union contracts with the PTO in general.

Congress has already held hearings on this topic and is in need of guidance in order to take appropriate action.⁴

Further, the panel stated that any Final Written Decision of the PTAB issued by APJs appointed prior to October 31, 2019 would be at risk of being vacated and remanded to be decided by a new panel of properly appointed APJs, so long as the so-called *Arthrex* challenge is made on appeal in either a motion before the opening brief is filed, or in the opening brief itself. Opinion at 29.

However, since the Opinion, and consistent with the Supreme Court decisions relied upon therein, at least two judges of this Court (Hon. Dyk and Newman) have suggested the remedy should be applied retroactively, as was the

⁴ See *The Patent Trial and Appeal Board and the Appointments Clause: Implications of Recent Court Decisions*, U.S. HOUSE COMMITTEE ON THE JUDICIARY (Nov. 19, 2019), <https://judiciary.house.gov/legislation/hearings/patent-trial-and-appeal-board-and-appointments-clause-implications-recent-court>.

case in *Free Enterprise Fund* and *Edmond*, rather than solely prospectively, as adopted by the Opinion. See *Bedgear, LLC v. Fredman Bros. Furniture Co.*, Nos. 18-2082, 18-2083, 18-2084 (Fed. Cir. Nov. 7, 2019) (Dyk, J. concurring, joined by Newman, J.) (citing *Free Enter. Fund*, 561 U.S. 477 (remedy of severing the unconstitutional provisions, rendering the appointment of the Board constitutional, applied both prospectively and retroactively, so prior actions of the Board were not invalidated); *Edmond*, 520 U.S. 651 (no remand for new hearing after the Court’s remedial construction of the provisions at issue rendered the appointment of judges of the Coast Guard Court of Appeals constitutional)).

Thus, there are questions as to whether the panel improperly declined to make its ruling retroactive, so that the appointment of the APJs is deemed constitutional from the beginning, rendering the past PTAB decisions, and this Court’s various rulings thereon, valid.

By applying its decision only prospectively, *Arthrex* has the potential of vacating and remanding for adjudication before new panels hundreds of pending PTAB decisions. Such a result would have devastating consequences for the agency, this Court, and the integrity of the United States patent system. It is also contrary to the Congressional purpose in enacting the AIA and the legislative intent behind IPRs to promote efficiency in the patent system.

Assuming the full Court agrees that APJs are, in fact, principal officers, it should then address whether the act was properly severed and applied prospectively, and, if so, whether it should also be applied retrospectively.

C. *En Banc* Review Is Necessary to Confirm Where and When an Appointments Clause Challenge Must Be Raised

While *amicus* takes no position on the subject, the *en banc* Court should also confirm where and when a party must raise an Appointments Clause challenge in order for it to be heard, for the efficient administration of justice.

Generally, federal appellate courts do not consider issues not presented at trial below, but the *Arthrex* Opinion relied upon Supreme Court precedent that considered Appointments Clause objections to appointed officers that were not raised below. Opinion at 4 (citing *Freytag*, 501 U.S. at 878-79). In deciding to deviate from the general rule, the Opinion’s authors reasoned that deciding the Appointments Clause challenge was of exceptional importance and was an appropriate exercise of its discretion. *See* Opinion at 4-5. The Opinion went on to explain that it would have been “futile to raise the Appointments Clause challenge before the [PTAB] because the [PTAB] lacked the authority to grant it relief.” *Id.* at 27.

Moreover, a constitutional infirmity, which renders the decisionmaker’s authority suspect, is an issue that arguably cannot be ignored but rather must be

addressed upon judicial review to ensure the integrity of the decision and due process.

Nevertheless, subsequent panel decisions have stated that to preserve the argument on appeal, the argument must be raised in a motion pre-opening brief or the opening brief, or be forfeited. *Compare Uniloc 2017 LLC v. Facebook, Inc.*, No. 18-2251 (Fed. Cir. Oct. 31, 2019) (order vacating and remanding when argument raised in opening brief; petition for rehearing pending); *with Customedia Techs., LLC v. DISH Network Corp.*, No. 18-2239 (Fed. Cir. Nov. 1, 2019) (order denying appellant’s motion to vacate and remand when Patent Owner “did not raise any semblance of an Appointments Clause challenge in its opening brief or raise this challenge in a motion filed prior to its opening brief”).

Given this confusion, it is important for the full Court to provide guidance for litigants (and the PTAB) on the proper means and timing to raise the Appointments Clause challenges.

IV. IMPORTANT ISSUES ARE RAISED THAT REQUIRE PROMPT RESOLUTION BY THE FULL COURT

The issues raised in the petitions here exist in many cases pending before this Court, and no doubt will impact more cases going forward.

In addition to the three petitions filed here, this Court is seeing analogous petitions filed in other cases, including:

- *Uniloc 2017 LLC v. Facebook, Inc.*, No. 18-2251 (Fed. Cir. Oct. 31, 2019) (petition for rehearing and rehearing *en banc* filed on December 2, 2019 and currently pending);
- *Customedia Techs., LLC. v. DISH Network Corp.*, No. 19-1001 (Fed. Cir. Dec. 23, 2019) (per curiam) (denying petition for rehearing and rehearing *en banc*) (Newman, J., dissenting).

Panels in still other cases have requested briefing on these subjects. *See, e.g., Polaris Innovations Ltd. v. Kingston Tech. Co., Inc.*, Nos. 18-1768, 18-1831 (Fed. Cir. Nov. 8, 2019).

Similarly, the government has now intervened in numerous other cases where these issues are being raised, opposing appellants' motions to vacate and remand pending resolution of this petition. *See, e.g.,* Intervenor's Opp'n to Appellant's Mot. to Remand, *Steuben Foods, Inc. v. Nestle USA, Inc.*, No. 20-1082 (Fed. Cir. Dec. 18, 2019); Intervenor's Opp'n to Appellant's Mot. to Remand, *VirnetX Inc. v. Cisco Sys., Inc.*, No. 19-1671 (Fed. Cir. Dec. 18, 2019).

These proceedings, and proceedings in other pending cases, indicate the existence of significant uncertainty and debate amongst the stakeholders as to the panel's decision in *Arthrex*, buttressing the importance of *en banc* review here.

The damage caused by continuing uncertainty cannot be overstated. The full Court needs to act quickly and decisively.

V. CONCLUSION

For the foregoing reasons, the NYIPLA respectfully urges the Court to grant the United States' petition for rehearing *en banc*.

Dated: December 30, 2019

By: /s/Charles R. Macedo

ROBERT M. ISACKSON
*First Vice President and Board
Liaison, Amicus Briefs Committee*
LEASON ELLIS LLP
1 Barker Avenue
White Plains, NY 10601

ROBERT J. RANDO
Board Member
THE RANDO LAW FIRM P.C.
6800 Jericho Turnpike
Suite 120W
Syosset, NY 11791

CHARLES R. MACEDO
*Counsel of Record
Co-Chair, PTAB Committee*
DAVID P. GOLDBERG
Co-Chair, Amicus Briefs Committee
AMSTER, ROTHSTEIN & EBENSTEIN LLP
90 Park Avenue
New York, NY 10016
(212)336-8000
cmacedo@arelaw.com

KSENIA TAKHISTOVA
7 Ellison Avenue
East Brunswick, NJ 08816

CERTIFICATE OF COMPLIANCE

Pursuant to Federal Rule of Appellate Procedure 29, I certify that the foregoing *Amicus Curiae* Brief complies with the applicable type-volume limitations. Excluding those portions exempted by Federal Rule of Appellate Procedure 32(f) and Federal Circuit Rule 32(b), this brief contains 2,600 words. This certificate was prepared in reliance on the word count of the word-processing system used to prepare this brief.

This brief complies with the typeface and type style requirements of Federal Rule of Appellate Procedure 32(a)(5) and (a)(6) because it has been prepared in a proportionally spaced typeface using Microsoft Office Word 2010 in 14-point Times New Roman font.

Dated: December 30, 2019

By: /s/Charles R. Macedo
Charles R. Macedo
AMSTER, ROTHSTEIN & EBENSTEIN LLP

Counsel for Amicus Curiae
New York Intellectual Property Law Association

CERTIFICATE OF SERVICE

I, Melissa Pickett, being duly sworn according to law and being over the age of 18, upon my oath depose and say that:

On **December 30, 2019**, the foregoing *Amicus Curiae* **Brief of The New York Intellectual Property Law Association in Support of the Intervenor's Petition for Rehearing En Banc** was filed with the Clerk of Court using the CM/ECF System, which will serve via e-mail notice of such filing all counsel registered as CM/ECF users including the following counsel:

Anthony P. Cho
David J. Gaskey
David L. Atallah
Jessica Zilberberg
Carlson, Gaskey & Olds, P.C.
acho@cgolaw.com
dgaskey@cgolaw.com
datallah@cgolaw.com
jzilberberg@cgolaw.com

Scott R. McIntosh
Melissa N. Patterson
Courtney Dixon
U.S. Department of Justice
scott.mcintosh@usdoj.gov
melissa.patterson@usdoj.gov
courtney.l.dixon@usdoj.gov

Mark A. Perry
Gibson, Dunn & Crutcher LLC
mperry@gibsondunn.com

Mark J. Gorman
Smith & Nephew, Inc.
Mark.gorman@smith-nephew.com

Thomas W. Krause
Farheena Y. Rasheed
Sarah E. Craven
Joseph Matal
Office of the Solicitor
U.S. Patent and Trademark Office
thomas.krause@uspto.gov
farheena.rasheed@uspto.gov
sarah.craven@uspto.gov
joseph.matal@uspto.gov

Charles T. Steenburg
Michael N. Rader
Richard F. Giunta
Nathan R. Speed
Turhan F. Sarwar
Wolf Greenfield & Sacks, P.C.
csteenburg@wolfgreenfield.com
mrader@wolfgreenfield.com
rgiunta@wolfgreenfield.com
nspeed@wolfgreenfield.com
tsarwar@wolfgreenfield.com

The required paper copies will be filed with the Court on the same date as above.

December 30, 2019

/s/ Melissa Pickett