

IN THE
Supreme Court of the United States

DAVID J. KAPPOS, UNDER SECRETARY OF
COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR, UNITED STATES PATENT AND
TRADEMARK OFFICE,

Petitioner,

v.

GILBERT P. HYATT,

Respondent.

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

**BRIEF OF *AMICUS CURIAE* NEW YORK
INTELLECTUAL PROPERTY LAW ASSOCIATION
IN SUPPORT OF NEITHER PARTY**

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September 6, 2011

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INTEREST OF *AMICUS CURIAE*

With the parties' written consents, copies of which are submitted herewith, the New York Intellectual Property Law Association ("NYIPLA") respectfully submits this brief as *amicus curiae*, in support of neither party, pursuant to Rule 37 of the Rules of this Court.¹

Amicus curiae NYIPLA has no financial stake in either party to this appeal nor any interest in its outcome other than the just and proper application of the law as it relates to the issue presented. The NYIPLA's sole purpose herein is to offer what assistance it can to the Court as it considers and decides this important case at the juncture of patent law, the rules of evidence and civil procedure, and administrative law. In particular, the NYIPLA files this brief in order to present certain observations that are intended to supplement rather than duplicate the arguments of the parties by bringing to the Court's attention material that may be quite different from that presented by the parties and which is relevant to some of the broader policy implications and heretofore unrecognized ramifications of widespread import in other contexts raised by the issue before the Court in respect to the Federal Circuit's en banc opinion for the review of which certiorari has been granted.²

1. Upon reasonable inquiry and investigation, *amicus curiae* NYIPLA believes that no party or its counsel authored or participated in preparing this brief in whole or in part, and that no one other than NYIPLA, its members, or its Counsel of Record herein made any contribution, in money or services, intended to fund or facilitate the preparation or submission of this brief.

2. The NYIPLA's silence on points and issues not addressed in this brief does not necessarily indicate agreement with positions taken by either of the parties on those points and issues.

Amicus curiae NYIPLA and its Counsel of Record appearing in this proceeding represent that they alone prepared this brief. The arguments set forth herein were approved as of September 2, 2011 by an absolute majority of the total number of officers and members of the Board of Directors of the NYIPLA (including officers and Board members 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 firms with which those members are associated. After reasonable investigation, the NYIPLA believes that no officer, or member of its Board or Amicus Committee who voted in favor of this brief, or any attorney in the law firm or corporation of such an officer, Board or Committee member, or attorney who aided in preparing this Brief, represents a party with respect to the present litigation. Some officers, Board, or Committee members, or other attorneys in their respective law firms or corporations may represent entities, including other *amici curiae*, which have an interest in other matters that may be affected by the outcome of the present appeal.

The NYIPLA is one of the largest regional intellectual property (“IP”) bar associations in the United States. Its membership consists of approximately 1,600 lawyers whose professional interests and practices lie mainly in the areas of patents, copyrights, trademarks, trade secrets and other forms of IP. NYIPLA’s members include in-house counsel serving businesses and other organizations that deal with IP rights in all technologies and disciplines, as well as attorneys in private practice who represent IP owners and their adversaries. Entities served by the NYIPLA include inventors, entrepreneurs, venture capitalists, companies, universities, and industry and trade associations. NYIPLA members represent both

plaintiffs and defendants in IP litigations and regularly participate in matters before government agencies, including the prosecution of patent applications and other proceedings before the Patent and Trademark Office (“PTO”).

Founded in 1922, the NYIPLA has achieved national recognition by its continuous, historic commitment to maintaining the integrity of the United States patent system, and to the proper application and observance of United States patent law by courts and agencies. Noteworthy in that regard are the contributions made by the Honorable Giles S. Rich, a celebrated member of the Court of Appeals for the Federal Circuit and its predecessor, the Court of Customs and Patent Appeals. While serving as the NYIPLA’s 28th President (from 1951 to 1952) he was instrumental in the drafting and enactment of, and contributed to the preparation of an official commentary on, the Patent Act of 1952 embodied in title 35 of the United States Code (hereinafter referred to in its current form as the “Patent Act”). Later, during his career both as a patent lawyer and then as a jurist, Judge Rich continued to contribute significantly to the promotion of the Patent Act’s vitality and relevance to both the American and global economies. Since then, the expeditious, efficient, and economical operation of the U.S. patent system, in accordance with sound legal principles, as embodied in the Patent Act, remains what is arguably one of the most important factors promoting the innovation-driven economy and well-being of the United States.

The NYIPLA supports the continued development of the principles and procedures governing judicial recourse from decisions of the PTO aimed at improving the process

for examining and granting patent applications, and the quality of patents issued by the Agency. However, restricting the right of patent applicants to exercise the broad, long-standing statutory right to judicial scrutiny of PTO decisions under the Patent Act is not a valid option. The NYIPLA believes that the challenges facing the U.S. patent system in the context of the judicial treatment of PTO decisions stem from issues raised by the Petitioner that can and should be addressed by applying sound jurisprudential principles.

I. INTRODUCTION

Since the early days of our Republic, the Judicial Branch has served as a recourse against unlawful conduct of the Executive. In *Marbury v. Madison*, 5 U.S. (1 Cranch) 137, 166 (1803), Chief Justice John Marshall noted that “[w]here a specific duty is assigned by law [to the Executive Branch], and individual rights depend upon the performance of that duty, it seems equally clear that the individual who considers himself injured has a right to resort to the laws of his country for a remedy”. A more distant antecedent can be found in the *Magna Carta* (1215), ¶ 61 (“[I]f . . . any one of our officers, shall in anything be at fault towards anyone, and the offense be notified to four barons, . . . [they] shall . . . petition to have that transgression redressed without delay.”)

Given the pervasive influence of the modern administrative state on the nation’s affairs, decisions of federal agencies often concern issues whose plenary judicial resolution is justified by their far-reaching economic and social consequences. It is for this reason that the recognized need for a meaningful judicial check on agency action requires full access to the courts for

those aggrieved by the acts of such agencies. That access is provided by broad statutory waiver under the *Administrative Procedure Act* (“APA”), at 5 U.S.C. § 702 (1976), of the Government’s sovereign immunity from suit by civil action seeking court adjudication of the merits of non-monetary, adverse agency-decisions. *Delano Farms, Co. v. California Table Grape Commission*, __ F.3d ___, 2011 WL 3689249 (Fed. Cir. 2011). *See also* Gregory C. Sisk, *Litigation With The Federal Government*, 4th ed., § 3.22 (American Law Institute 2006).

In the field of intellectual property respecting patents and trademarks, this principle is specifically enabled in two statutes -- 35 U.S.C. § 145, entitled “Civil action to obtain patent”, and 15 U.S.C. § 1071(b), entitled “Civil action; persons entitled to; jurisdiction of court; status of Director; procedure,” respectively.³ The importance of the right of civil action under these organic statutes as one of the two mutually exclusive avenues of judicial recourse for those adversely affected by rulings of the Patent and Trademark Office (“PTO” or “Agency”) has long been recognized and cannot be disputed.

At the interface between Article III court jurisdiction and the activities of government agencies, the word “review” connotes a type of judicial recourse which in

3. The wordings in 35 U.S.C. § 145 and 15 U.S.C. § 1071(b)(1) are essentially the same with respect to providing a remedy by “civil action”, and the two statutes may therefore be read *in pari materia* in the present context. The Federal Circuit’s en banc decision in respect to 35 U.S.C. § 145 is consistent with the interpretation of 15 U.S.C. § 1071(b)(1) in other circuits. *See* pp. 8-9 in “Brief of Amicus Curiae American Intellectual Property Law Association in Support of Neither Party” filed April 9, 2010 in the Federal Circuit en banc rehearing.

one of its aspects entails a process by which a court of appellate jurisdiction like the Federal Circuit in an appeal under 35 USC § 141, entitled “Appeal to the Court of Appeals for Federal Circuit”, or a court of original jurisdiction, like the D.C. federal district court in a § 145 action sounding in equity under the APA at 5 U.S.C. § 702 and § 706(2)(F), examines (“reviews”) the predicates in the administrative record of an agency’s decision on each issue. The absence of the word “review” from § 145 stands in contrast to 35 U.S.C. § 144 which expressly cabins the scope of Federal Circuit jurisdiction over decisions of the PTO to the “review” of the administrative record in the Agency. If a civil action is based solely on such a record, then the court can remand (set aside) the Agency’s decision on a given issue essential to the ultimate outcome if the Agency’s fact-findings thereon are not supported by evidence ‘substantial’ enough to enable a reasonable observer to infer a factual conclusion required to decide the issue. 5 U.S.C. § 706(2)(E). Also, the court can reverse the decision if the Agency’s conclusion(s) of law flowing from a substantial evidentiary record are incorrect (“erroneous”). 5 U.S.C. § 706(2)(A).

On the other hand, *because the enabling statute*, 35 U.S.C § 145, *authorizes* a “civil action” in Federal district court to “adjudicate” the Agency’s decisions, and if the parties introduce further evidence in such action, then the district court does more than simply “review” the administrative record. Rather, the court *adjudicates* the factual issues, i.e., in a “de novo” trial proceeding at a level of judicial scrutiny that accords no deference – i.e., does not accept at face value -- the administrative finding(s) of fact underlying the agency’s decision. In doing

so, the court takes a “hard look” at the agency’s findings based on the administrative record supplemented with non-cumulative new evidence and/or different evidentiary modalities pertinent to disputed question(s) of fact on each issue, as though the agency had never addressed any of the evidence. *Morsemere Sav. & Loan Ass’n v. Marston*, 500 F. Supp. 1253, 1256-7 (D.N.J. 1980) (explaining the types of judicial review of agency decisions); *Chandler v. Roudebush*, 425 U.S. 840, 845-846 (1976) (discussing trial de novo under the Civil Rights Act); *Newton County Wildlife Ass’n v. Rogers*, 141 F.3d 803, 808 (8th Cir. 1998) (discussing citizen-suit provisions of the Endangered Species Act and the Clean Water Act). The decision of the Agency will not be overturned unless the new evidence introduced, considered, and weighed in conjunction with the administrative record persuades the court that the Agency erred.

A civil action under 35 U.S.C. § 145 is a lawsuit against the PTO in the person of the “Director” [of the Agency] “in the United States District Court for the District of Columbia.” Unlike a direct appeal to the Federal Circuit under 35 U.S.C. § 141, a civil action under § 145 in which additional evidence is introduced is nothing at all like an appeal to a court of appellate jurisdiction that merely “reviews” judgments of a lower tribunal on a fixed record. Rather, § 145 provides a recourse to a specific federal district court, having original jurisdiction, in a proceeding that is adjudicatory in nature, aimed at a trial of the issues that were decided by the Agency. It is axiomatic that in absence of any legal authority to the contrary – of which there is none here -- the proceedings and the treatment of evidence in a § 145 action are governed by the *Federal*

*Rules of Civil Procedure*⁴ and the *Federal Rules of Evidence*.⁵ Thus, in order to avoid redundancy with § 141, one must read § 145 as authorizing the taking of additional evidence into account, which may be adduced by either or both parties, i.e., by the defendant PTO as well as by the plaintiff patent-applicant, by court-specific discovery mechanisms such as third-party subpoenas, or which could have been presented at the administrative stage, such as additional prior art which the PTO did not site.

That the named defendant in a § 145 civil action is the head of the PTO who is being sued in an official capacity,

4. In particular, Fed.R.Civ.P. 1 states in relevant part: “*These rules govern the procedure in all civil actions and proceedings in United States district courts . . .*” In light of Fed.R.Civ.P. 4(i)(2), “civil actions” include suits against federal agencies.

5. In particular, Fed.R.Evid. 101 (“Scope”) states in pertinent part: “*These rules govern proceedings in the courts of the United States . . . and before United States magistrate judges to the extent and with the exceptions stated in rule 1101.*” (Emphasis added). Fed.R.Evid. 1101 (“Applicability of Rules”) states in pertinent part: (a) *Courts and judges. These rules apply to the United States district courts, . . . United States courts of appeals and to . . . United States magistrate judges, in these actions, cases, and proceedings and to the extent herein after set forth . . .* (e) *Rules applicable in part. In the following proceedings, these rules apply to the extent that matters of evidence are not provided for in the statutes that govern procedures therein or in other rules prescribed by the Supreme Court pursuant to statutory authority: . . . review of agency actions when the facts are subject to trial de novo under section 706(2)(F) of title 5, United States Code; . . .*” (Emphasis added). In its “Notes to Subdivision (e)” on the 1972 Proposed Rules, the Committee states:

“[the] rules of evidence are applicable to the proceedings enumerated in this subdivision . . .”.

and that the action seeks judicial recourse from the final decision of an administrative agency, do not differentiate such lawsuits from other types of civil action insofar as the question now before this Court is concerned. As this Court held in *Federal Housing Administration, Region 4 v. Burr*, 309 U.S. 242, 245 (1940), “[w]hen Congress launched a governmental agency into the commercial world and endowed it with authority to ‘sue or be sued’, that agency is not less amenable to judicial process than a private enterprise under like circumstances would be.” The question then is: whether there is any basis, in a § 145 action, for restricting the admission of additional evidence proffered by either party (separate and apart from the weight to be accorded to it) when such evidence is relevant under Fed. R. Evid. 401 to the issue(s) decided by the BPAI, admissible under Fed. R. Evid. 402, and not excludable under Fed. R. Evid. 403? The NYIPLA respectfully submits that the answer is no.⁶

It is believed that this Court, like the Federal Circuit and its predecessor, the Court of Customs and Patent Appeals, “has [never] squarely addressed the issue of exactly what standard governs district courts in ruling on the admissibility of evidence in a § 145 action that was withheld during [prosecution] in the PTO.” *Hyatt v. Doll*, 576 F.3d 1246, 1259-60, 1269-70 (Fed. Cir. 2009) (panel decision); *Hyatt v. Kappos*, 625 F.3d 1320, 1322 (Fed.

6. An interesting “what if” would be the situation where the examiner’s rejection of a Government-owned patent application or a patent in an ex parte reexamination is affirmed by the BPAI. Since nothing in § 145 or § 306 respectively, precludes a civil action by such an applicant or patent owner against the PTO, quaere whether the government would be as enthusiastic about its present position if the shoe were on the other foot?

Cir. 2010) (decision in rehearing en banc).⁷ By granting certiorari, the Court can now definitively answer the question.⁸

In particular, the Court is urged to consider and clarify the admissibility standard(s) to be applied by the district court in § 145 actions involving newly submitted evidence when:

(i) the evidence was either unavailable to or unknown by the patent applicant during the proceedings in the PTO as in *Takeda, supra*, and in *Globe Union v. Chicago Tel. Supply Co.*, 103 F.2d 722, 288 (7th Cir. 1939), or

(ii) the evidence was available to or known by the applicant during the PTO proceedings, but the Agency lacked adequate means, resources, and/or procedures for considering such evidence (*e.g.*, oral testimony and

7. Some courts have held that evidence withheld from the PTO due to fraud, bad faith, or gross negligence, may be excluded in a district court civil action. *See DeSeversky v. Brenner*, 424 F.2d 857, 858 n.5 (D.C. Cir. 1970); *California Research Corp. v. Ladd*, 356 F.2d 813, 821 n.18 (D.C. Cir. 1966); *Monsanto Co. v. Kamp*, 269 F. Supp. 818, 822 (D.D.C. 1967); and *Killian v. Watson*, 121 U.S.P.Q. 507, 507 (D.D.C. 1958). However, none of those holdings is binding precedent on this Court or on the Federal Circuit. Hence, the present appeal presents an opportunity for this Court to establish such precedent.

8. In *Takeda Pharmaceutical Co. v. Dudas*, 511 F.Supp. 2d 81 (D.D.C. 2007), *vacated and remanded*, 561 F.3d 1372 (Fed. Cir. 2009), the district court allowed the proffer of evidence newly uncovered in a civil action under § 306 for district-court adjudication of the PTO's decision adverse to the patent owner in an ex parte patent reexamination. However, on appeal, the Federal Circuit did not reach the issue now before this Court.

cross-examination) as in *Minnesota Mining & Mfg. Co. v. Carborundum*, 155 F.2d 746 (3rd Cir. 1946), or

(iii) the applicant was negligent in failing to present evidence to the PTO which could have considered it during the administrative proceeding as in *California Research Corp. v. Ladd*, 356 F.2d 813, 820 n. 18 (D.C. Cir. 1966); *DeSeversky v. Brenner*, 424 F.2d 857, 858 n. 5 (D.C. Cir. 1970), or

(iv) the applicant knew of or had access to the newly proffered evidence during the proceeding before the Agency, but either willfully or inexplicably failed to submit it, as was deemed to be the case, for example, in *Barrett Co. v. Koppers Co.*, 22 F.2d 395 (3d Cir. 1927), or in *Killian v. Watson*, 121 USPQ 507 (D.D.C. 1958).

II. SUMMARY OF ARGUMENT

The ability to introduce new evidence in district court in furtherance of a position taken by the proffesor in traversing the PTO's fact-finding(s) on an issue of contention before the Agency is the hallmark of civil actions under 35 U.S.C§ 145. That enables district-court adjudication -- which the plaintiff must pay for entirely -- of the full merits of PTO decisions adverse to patent applicants based on evidence both in and outside the administrative record with no express restrictions on its admissibility. It is from this aspect that civil actions under § 145, as a distinct alternative to direct appellate review under § 141, derive much of their worth for inventors, companies, and many industries, as well as universities that create, develop, value, and rely upon their intellectual property portfolios to augment and protect their technology assets.

Direct appellate review in the Federal Circuit, characterized by deference to the Agency’s fact-findings (if based on a “substantial” evidentiary record), may often be sufficient to give the aggrieved party its proverbial ‘right to a “day in court”.’ Nevertheless, an across-the-board exclusionary rule that deprives all patent applicants of the full, unfettered right to introduce evidence subject only to the *Federal Rules of Evidence* through district-court adjudication and trial under the *Federal Rules of Civil Procedure* in effect leaves direct appellate review as their only effective recourse from erroneous PTO decisions. Such a rule does nothing to encourage, and indeed can only discourage investments in the obtaining and development of patent assets. It is not only unfair but also unworkable for those who, in order to secure judicial disposition of their cases on the full factual merits, and of which the statute obligates them to pay the entire cost, may need to rely on additional evidence that was available or known to the profferor during the administrative stage of the proceeding but for whatever reason was not presented at that time in one form or another to the PTO.

Because the district court possesses what historically has been recognized as equity jurisdiction over the parties appearing before it under § 145, there is a need and an opportunity presented by the facts in this case to definitively establish that parties in § 145 civil actions (and correspondingly in civil actions under 15 U.S.C. § 1071(b) relating to trademark registration applications⁹) are no less entitled than parties in other non-jury litigations to submit evidence for the court to consider in deciding cases, subject only to the strictures on admissibility based

9. See *supra* note 3.

on relevancy; probity; unfair prejudice; competency; credibility; fairness; and duplicativeness as are imposed by the *Federal Rules of Evidence*¹⁰ and the *Federal Rules of Civil Procedure*. The Federal Circuit's en banc majority opinion correctly rejected the special, restrictive, heightened standard of evidence-admissibility announced by the district court and the Federal Circuit panel majority, and urged by the present Petitioner.

For the reasons set forth below, *amicus* NYIPLA urges this Court to resolve the issue herein presented in favor of a *Federal Rules of Evidence* standard allowing the proffer of evidence in § 145 civil actions governed by the *Federal Rules of Civil Procedure*, unfettered by the fact that the evidence was available, but for whatever reason was not made of record in the proceedings before the PTO. That standard enables under § 145, and the APA does not preclude, district court adjudication of the material issues decided by the PTO on the basis of the record that was before the Agency, coupled with any new evidence (i) relevant to those issues; (ii) that might have been -- but for whatever reason was not -- presented during the administrative proceedings; and (iii) without inquiry or concern as to why such evidence was not previously presented.

10. Fed. R. Evid. 102 (“These rules shall be construed to secure fairness in administration, elimination of unjustifiable expense and delay, . . .”); Fed. R. Evid. 403 (“Although relevant, evidence may be excluded if its probative value is substantially outweighed by the danger of unfair prejudice, . . . or by considerations of undue delay, waste of time, . . .”). (Emphasis added).

III. ARGUMENT

POINT I — The APA Does Not Conflict With the Statutory Enablement of Article III Court Adjudication of Government-Agency Actions Wherein the Admission of New Evidence is Governed By the Federal Rules of Evidence

Dickinson v. Zurko, 527 U.S. 150 (1999), *held* that, direct appeals to the Federal Circuit under 35 U.S.C. § 141 must be decided on the basis of and subject to, (i) the APA’s deferential, “substantial evidence” standard of review of the BPAI’s fact-findings in the administrative record, 35 U.S.C. § 144, and (ii) a non-deferential, *de novo* standard of review of the BPAI’s conclusions of law. Thus, if the court finds that the PTO’s decision is supported by substantial evidence whereby the findings of fact are to be deemed conclusive, and if the PTO’s conclusions of law are not erroneous, then the decision should be affirmed.

Mazzari v. Rogan, 323 F.3d 1000 (Fed. Cir. 2003), *held* that, in § 145 civil actions in district court, if the only evidence presented by either party was already made of record in the PTO, then the court must examine the Agency’s decision under the same standard that the Federal Circuit would have applied if a direct appeal had been taken under §141. *Id.* at 1004-5. In such case, insofar as the likely outcome is concerned, there is no practical difference between the two routes of judicial treatment (aside from the obligation of the plaintiff to pay all the expenses of a civil action as required by the last sentence of § 145, and the appealability to the Federal Circuit from the judgment of the district court per 28 U.S.C. § 1295(a)(1) and § 1295(a)(4)(C)).

There is a difference, however, when either party – be it the plaintiff or the PTO – presents additional evidence (or presents prior evidence in a different modality, *e.g.*, live testimony, etc.) to the district court (which is not possible, of course, on direct appeal to the Federal Circuit) relevant to material fact-issues, *i.e.*, “that might affect the outcome of the suit under governing law.” *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). In such case, the “substantial evidence” standard of review of agency fact-findings does not apply; rather, the district court, whether in deciding a dispositive motion (as was the case here) or at trial, considers and weighs all of the parties’ admissible evidence relevant to the issues of contention in the case and without deference to the manner by which the BPAI arrived at its factual conclusions. In other words, such review is *de novo* both as to the facts as well as the conclusions of law (albeit not the issues which usually remain fixed as they were at the Agency level). *DeSeversky v. Brenner*, 424 F.2d 857, 858 (D.C. Cir. 1970); *In re Watts*, 354 F.3d 363, 367 (Fed. Cir. 2004)). Thus, if new evidence is admitted, “the district court takes on the roll of fact-finder and may need to make factual findings.” *Mazzari*, 323 F.2d at 1004.

Under *Morgan v. Daniels*, 153 U.S. 120 (1894) and *Barrett Co. v. Coppers, Co.* 22 Fed.2d 395 (3d cir. 1927), the trial of a bill in equity must be heard upon all competent evidence adduced, and upon the entire merits of the case, and not merely *de novo sub modo* by ignoring the administrative record. The operative language in § 145 confirms this principle:

An applicant dissatisfied with the decision of the Board of Patent Appeals and Interferences

. . . may, . . . have remedy by civil action against the Director in the United States District Court for the District of Columbia The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Patent Appeals and Interferences, as the facts in the case may appear and such adjudication shall authorize the Director to issue the patent . . .

35 USC § 145 (Emphasis added).

But neither *Morgan* nor *Barrett* involved civil actions seeking the adjudication of PTO decisions in proceedings in the examination of patent applications; rather, they involved priority contests, between competing inventors (i.e., interferences).

Most PTO proceedings are either “contested” or “non-contested.” A “contested” case is defined in the PTO’s own rules as a proceeding that does not entail an administrative appeal to the BPAI under 35 U.S.C. § 134 from an examiner’s action. *See* 37 C.F.R. § 41.2 (¶ 5, first sentence); §§ 41.100 – 41.158. Rather, the PTO’s decision emanates from a contest between adversaries conducted under the direct auspices of the BPAI. Patent interferences under 35 U.S.C. § 135 are contested cases. *See* 37 C.F.R. §§ 41.200-208, esp. § 41.200(a). Conversely, original and reissue patent application proceedings under 35 U.S.C. §§ 131-133, § 251, and § 134(a) are non-contested cases that begin with an examiner’s action and then proceed to the BPAI for an administrative ruling on an examiner’s final rejection.

Though seldom dwelt upon in discourse outside the PTO, the dichotomy between non-contested and contested cases has profound implications in the present context – both substantively and procedurally, and for this reason neither *Morgan* nor *Barrett* are apposite. For one thing, judicial recourse from PTO decisions in non-contested cases is by direct appeal to the Federal Circuit under § 141 or by adjudication through civil against the Agency, under § 145. On the other hand, judicial recourse from PTO decisions in contested cases is by direct appeal to the Federal Circuit under § 141 or by civil action between the disputants under § 146 in which the PTO is usually not a party.¹¹ Moreover, while the U.S. district court has broad subpoena power under Fed. R. Civ. P. 45 to summon witnesses and documents in § 145 civil actions as in other court litigations, under 35 U.S.C. § 24 the power of the court to issue subpoenas in PTO proceedings expressly applies only to contested cases. Hence, subpoenas are not

11. 35 U.S.C. § 146 provides in pertinent part:

§ 146 Civil Action in Case of Interference

“Any party to an interference dissatisfied with the decision of the Board of Patent Appeals and Interferences on the interference, may have remedy by civil action, . . . In such suits the record in the Patent and Trademark Office shall be admitted on motion of either party upon the terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, *without prejudice to the right of the parties to take further testimony*. The testimony and exhibits of the record in the Patent and Trademark Office when admitted shall have the same effect as if originally taken and produced in the suit.” (Emphasis added.)

available in the administrative stage of patent application proceedings. In a broader sense, patent application proceedings require an *examination* by the PTO to determine by its own analysis if the granting of a patent on an application is warranted under the law, and in which the burden of persuading the Agency shifts from the examiner to the applicant if the examiner is able to make out a *prima facie* case of unpatentability. In contrast, a contested case is in the nature of an Agency-*adjudicated, revocation/opposition* proceeding in the BPAI between adverse-parties-in-interest, wherein the opposer (e.g., a junior party in an interference) must persuade the PTO that a patent claim is undeserved, and the PTO ultimately decides whether that party has met its burden of persuasion which does not shift at any time during the proceeding.

There are reasons why a patent applicant may choose not to, or cannot, provide the PTO with all of the available evidence that supports his or her case. But regardless of what they are, the district court in a § 145 action should not be distracted and burdened with the task of divining them in a hearing-within-a-hearing initiated by an objection to its admissibility on those grounds. There is no statute, rule, or policy that would – or should – require the district court to act as gatekeeper beyond what is required by the *Federal Rules of Evidence*, and whose decision whether or not to exclude or admit evidence would depend on the facts of each case that are unrelated to the substantive issue(s). In order that § 145 can serve its purpose as a meaningful – and at times necessary – alternative to a § 141 appeal, a party – whether it be the patent applicant or the PTO – should have the same right to prove its case in conformity with the *Federal Rules of Evidence* as do the

parties in any other civil action under the *Federal Rules of Civil Procedure*.¹²

The provision in Fed. R. Civ. P. 26(a)(1)(B)(i) exempting parties in district court actions seeking review on an administrative record from the initial disclosure requirements of Fed. R. Civ. P. 26(a)(1)(A) do not apply to civil actions where a party intends to rely on additional evidence at trial. *Invitrogen Corp. v. President and Fellows of Harvard College*, 2007 U.S. Dist. LEXIS 74282 (S.D.Cal. 2007). (“The Advisory Committee Notes to the 2000 Amendments to Rule 26, state that this exemption ‘should not apply to a proceeding in a form that commonly permits admission of new evidence to supplement the record.’ The present action, filed under *35 U.S.C. § 146*, does not fall within this exemption.”) The initial disclosure of such evidence does not require that any reason(s) be given why the evidence was not adduced during the administrative proceeding, thus signaling that the district court will admit and consider such evidence, subject to whatever weight the court should choose to give it.

Citing *Citizens to Preserve Overton Park v. Volpe*, 401 U.S.402, 414-420 (1971), the dissenting judges in the en banc decision opined that § 145 actions should not depart from settled administrative law under 5 U.S.C. § 706 in that new evidence may be excluded by the district court only if it could have been introduced and considered by the agency during the administrative proceeding, for example, when agency procedures are inadequate to do

12. The fact that the Government’s motion for summary judgment in the § 145 civil action was grounded on Fed. R. Civ. P. 56 suggests that the Government is correct not to dispute the point.

so (e.g., direct and cross-examination of live witnesses, inter partes tests and replications, and the like). They were concerned that the majority opinion would lead to the deliberate withholding of evidence from the PTO by patent applicants seeking “a more hospitable forum” in the district court where non-expert judges would be more likely to accept it on face value. But that is a fallacy. In order to buttress it, the dissenting judges took it upon themselves to try and take judicial notice of what they assert to be the superior technical and patent law expertise of the PTO Corps of Examiners and the BPAI compared to the district court. 625 F.3d at 1342-44. No mention was made, however, of the ability of either or both parties in a § 145 civil action to present the testimony of expert witnesses under Fed. R. Evid. 702 as well as the ability of the court itself under Fed. R. Evid. 706 to appoint its own expert(s) – all at the patent applicant’s expense as required by the last sentence in § 145 (“All expenses of the proceeding shall be paid by the applicant”). If anything, this shows that plaintiff-applicants do not embark on such proceedings lightly – which accounts for the relatively infrequent resort to § 145 actions in comparison to § 141 appeals.

The commencement of a § 145 action does not signal the “termination” of the application proceeding. Rather, it continues the prosecution of the application, and the court proceedings will become part of the prosecution record. The overall process is not seamless since the principle of administrative exhaustion of the applicant’s recourse against the Agency’s rejection of the application requires that the case be decided on the *issue(s)* by the BPAI before the district court can acquire jurisdiction. After that, the proceeding lies beyond the reach of the PTO’s

rulemaking authority which is limited by 35 U.S.C. § 2(b) (2) to “establish[ing] regulations, not inconsistent with law, which . . . shall govern proceedings in the Office, . . .” The PTO recognizes this in its own official pronouncements in the *Manual of Patent Examining Procedure* (M.P.E.P.) at § 1216VI (8th ed., rev. 8, July 2010) (“During judicial review, the involved application or reexamination is not under the jurisdiction of the examiner or the Board, unless remanded to the U.S. Patent and Trademark Office by the court. Any amendment can be admitted only under the provisions of. . .”). That is not to say that the PTO hasn’t tried to extend its influence into the judicial process and shape PTO stakeholders’ understanding of the law by ultra vires pronouncements on the issue before this Court which merits no deference under *Chevron, U.S.A., Inc. v. National Resources Defense Council, Inc.*, 467 U.S. 837 (1984). See M.P.E.P. § 1260.02 (“In an action under 35 U.S.C. § 145, the plaintiff may introduce evidence not previously presented to the U.S. Patent and Trademark Office. However, new evidence is not admissible in district court where it was available to the parties but was withheld from the U.S. Patent and Trademark Office as a result of fraud, bad faith, or gross negligence”) citing the cases mentioned herein at *supra* note 7.

While the language in § 145 is not as explicit as that in § 146 which explicitly allows parties to “take further testimony,” i.e., to seek to admit additional evidence,¹³ § 145 nevertheless cannot be validly interpreted or understood in any way other than to authorize parties (be it a plaintiff patent applicant or the defendant PTO) to proffer new evidence for the trial court to consider

13. See *supra* note 11.

and weigh pursuant to the *Federal Rules of Evidence*. Logic requires this. After all, withholding evidence from the PTO that would support the allowance of a patent application is the antithesis of inequitable conduct in withholding prejudicial information from the PTO contra to 37 C.F.R. § 1.56 in order to avoid the negative impact on the examination of the application that would be adverse to the applicant. It would be counterintuitive to think that an applicant – particularly when represented (as is usually the case) by and with the sage advice and judgment of a patent lawyer or agent licensed by the PTO to represent others before the Agency¹⁴ – to knowingly refuse to respond to an examiner’s rejection by not supplying requested information, or to intentionally suppress or negligently to withhold from the PTO non-redundant, non-cumulative evidence that supports the merits of the application so as to avoid building an administrative record that might persuade the BPAI to rule in the applicant’s favor. Doing so in order to present it later on in a costly civil action in which the applicant (as plaintiff) would be obligated to pay all the expenses – including the defendant PTO’s expenses – makes no sense. It simply defies credulity and it is certainly not conducive to “gamesmanship”. And the boundary condition that drives home the point is when the evidence presented to the district court was simply not available or did not exist when the case was pending before the BPAI.

14. Such may not have been the case here. Respondent is an electrical engineer, businessman, and registered patent agent who prosecuted his present application *pro se* in the PTO. See ¶¶ 1-8 Respondent’s evidentiary declaration filed in district court, a copy of which is Appendix H to the Government’s petition for certiorari.

As a logical subset of the principle that civil actions under § 145 are subject to and are conducted in accordance with the *Federal Rules of Civil Procedure*, where there is a court proceeding involving the validity of an issued patent having a related pending application which is involved in a § 145 action, the court in the § 145 action has the discretion under Fed. R. Civ. P. 24(b)(1)(B) to order the joinder of the party challenging the patent in the validity litigation, in situations where both actions share a common question of law or fact (e.g., patentability in view of the prior art). *Moore's Federal Practice*, 3d ed., § 24.10 (2008). The same applies to a patent involved in a civil action under § 306 for de novo review of the BPAI's adverse decision in an ex parte reexamination requested by any party, including the patent owner or defendant in the enforcement action. In either of these scenarios (i.e., patent applications and patents in ex parte reexaminations) the intervener would have the right, not only to make legal arguments on issues already presented to the court in the civil action, but also to introduce evidence (e.g., published prior art) in support of those arguments that had come to light in the patent validity litigation but which was not of record in the PTO proceedings involving the related patent application(s). Therefore, it would be inconsistent with the even-handed interpretation of the operative statutes and rules, to preclude the plaintiff in a § 145 action from introducing evidence that for whatever reason was not made of record in the PTO, while permitting an intervener to do so.

**POINT II — The Patent Act at 35 U.S.C. § 145 Enables
a Full Trial De Novo in a District Court for
Adjudication of PTO Decisions in Other Settings**

The Petitioner has asserted that a district court should exclude evidence on grounds referred to in this case and in *Barrett Co. v. Koppers Co.*, 22 F.2d 395 (3d Cir. 1927). *Hyatt v. Doll*, 576 F.3d at 1275 n.31. However, if the Federal Circuit’s en banc decision is not affirmed, then the antecedent panel majority’s broad holding that “evidence owed, requested, and willfully withheld from the PTO” may be excluded from a subsequent § 145 action involving patent applications, *Id.* at 1278, will apply by analogy to actions under 35 U.S.C. § 306/§ 145 seeking adjudication of PTO rejections in ex parte reexaminations of issued patents.

It is no secret that civil actions in relation to patent applications under 35 U.S.C. § 145 and in relation to ex parte patent reexaminations under 35 U.S.C. § 306,¹⁵ whose administrative procedures are similar under 35 U.S.C. § 305, are odious to the PTO. This is evident from

15. 35 U.S.C. § 306 reads as follows:

§ 306. Appeal.

The patent owner involved in a reexamination proceeding under this chapter may appeal under the provisions of section 134 of this title, and may seek court review under the provisions of sections 141 to 145 of this title, with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent. [Emphasis added].

identical provisions in both the Senate- and House-passed versions of the *America Invents Act*, S.23 and H.R. 1249. In particular, SEC. 5 (h)(2)(A) of S.23 and SEC. 6(h)(2)(A) of H.R. 1249 would abolish district-court jurisdiction over PTO decisions in ex parte reexaminations – a right that has existed since the inception of ex parte reexamination in 1980 – by means of a seemingly simple amendment of § 306:

The patent owner involved in a reexamination proceeding under this chapter may . . . seek court review under the provisions of sections 141 to ~~144~~ 145 of this title

SEC. 6(c)(1) of S.23 and SEC. 7(c)(1) of H.R. 1249 would rewrite 35 U.S.C. § 141 in four parts, (a) - (d). Part (b) of § 141 would read as follows:

(b) REEXAMINATIONS.—A patent owner who is dissatisfied with the final decision in an appeal of a reexamination to the Patent Trial and Appeal Board under section 134(b) may appeal the Board’s decision only to the United States Court of Appeals for the Federal Circuit.

See Charles E. Miller and Daniel P. Archibald, *The “America Invents Act” and its Restriction on Judicial Recourse*, 39 AIPLA Q. J. 397 (Summer 2011).

The concern now is that the present legislation foreshadows the further enlargement of the PTO’s decision-making power and influence over the patent system at the expense of the Judiciary, by the eventual

undoing of trial-court jurisdiction over original and reissue patent application proceedings.¹⁶ *Id.*

Because of the aforementioned procedural similarities between the prosecution of patent applications and that of ex parte patent reexaminations, particularly with respect to judicial recourse from BPAI decisions, this Court's decision will have implications for civil actions under 35 U.S.C. § 306 which otherwise will continue to enable district-court trial de novo jurisdiction over PTO decisions in ex parte reexaminations until such time as the *America Invents Act* is signed into law. Given the increasing resort to post-patent-grant review in the PTO as an adjunct to patent validity litigation in the courts, it is important that the law governing district-court trial de novo jurisdiction over PTO examination proceedings remain fully available to patent owners in all non-contested cases.¹⁷

16. The aforementioned aversion of the PTO to civil actions against it in the context of patent application proceedings was discussed by the dissent from the Federal Circuit's en banc decision, 625 F.3d at 1349-52. Other rights of adjudication of PTO decisions that may soon appear on the legislative horizon can be found in 35 U.S.C. § 32 (suspension or exclusion of persons from practicing before the PTO); 35 U.S.C. § 154(b)(4) (final PTO determinations of patent term adjustments); and in the aforementioned 15 U.S.C. § 1071(b) (PTO Trademark, Trial & Appeal Board decisions affirming examiners' rejections of trademark registration and renewal applications).

17. The PTO has argued in other settings, and its own erroneous interpretive rulemaking presupposes, that 35 U.S.C. § 141, third sentence, and § 306 as currently written are to be read *in pari materia* such that § 141 somehow trumps § 306, whereby district court jurisdiction over the Agency's decisions in ex parte

IV. CONCLUSION

Amicus curiae NYIPLA respectfully urges the Court, upon considering all the submissions in this case, to hold that 35 U.S.C. § 145 enables trial de novo in Federal district court of BPAI decisions affirming examiners' rejections of patent applications, wherein the admissibility of newly-proffered evidence is determined solely in accordance with the *Federal Rules of Civil Procedure* and the *Federal Rules of Evidence*, with no judicially imposed obligation on patent applicants to present such

reexaminations requested post-November 28, 1999 was eliminated by the *American Inventors Protection Act* of 1999 and the *21st Century Department of Justice Appropriations Authorization Act* of 2002, and that the current legislation merely serves as a clarification of the PTO's view of the present state of affairs. But such rulemaking and the PTO's supporting argument are grounded on the false premise that the 1999 and 2002 legislative enactments had anything to do with judicial review in *ex parte* reexaminations, and are refuted in a recently-published analysis. See Charles E. Miller and Daniel P. Archibald, *Interpretive Agency-Rulemaking vs. Statutory District Court Review Jurisdiction in Ex Parte Patent Reexaminations*, 92 J. Pat. & Trademark Off. Soc'y, 498-535 (2011). In any event, the PTO's position is being tested in the courts in a number of pending § 306 civil actions. See *Teles A.G. v. Kappos*, Civil Action 1:11-cv-0476 (D.D.C.); *Dome Patent L.P. v. Kappos*, Civil Action 07-cv-1695 (D.D.C.); *Tse v. Kappos*, Civil Action 1:11-cv-1127 (D.D.C.); *Bally Gaming, Inc. v. Kappos*, Civil Action 1:10-cv-1906 (D.D.C.); and *Power Integrations, Inc. v. Kappos*, Civil Action 1:11-cv-1254. The issue of subject matter jurisdiction raised by Section 145/306 cases will be mooted if the *American Invents Act* becomes law. Yet, if the PTO's interpretation of existing law is already correct, then why would the Agency try to vindicate it through legislation? It is believed the answer lies in the PTO's desire to forestall adverse judicial interpretation by pressing its views in Congress.

evidence to the PTO in the administrative stage. To rule otherwise would stymie the use of § 145 in providing a meaningful and necessary *adjudicatory* alternative to direct *appellate* review under 35 U.S.C. § 141 based solely on the PTO's evidentiary record as required by § 144.

Respectfully submitted,

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September 6, 2011