Getting Ready for *Arthrex*: What the *Amici* Are Saying

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The U.S. Supreme Court has agreed to hear, on March 1, 2021, whether administrative patent judges (APJs) of the Patent Trial and Appeal Board (PTAB) of the U.S. Patent and Trademark Office (USPTO) are "inferior" officers properly appointed under the Appointments Clause of the U.S. Constitution (U.S. Const., art. II, § 2, cl. 2), and, if not, whether the "fix" by the Federal Circuit in *Arthrex v. Smith & Nephew,* 941 F.3d 1320 (Fed. Cir. 2019) worked.

In separate petitions (now consolidated) from the same panel decision of the Federal Circuit in *Arthrex*, the U.S. and Smith & Nephew, as petitioners, are challenging the Federal Circuit's declaration that PTAB APJs are principal officers of the United States and thus were appointed in violation of the Appointment's Clause. Arthrex, as respondent, is defending the Federal Circuit's conclusion that PTAB APJs are principal officers, but is itself challenging whether the "fix" of severing Title 5 protection of APJs after October 31, 2019 works.

Thirty-one separate amicus briefs on the merits were submitted in this matter, and they present a wide variety of views on how the Supreme Court should handle the questions presented.

On February 25, 2021, the New York Intellectual Property Law Association (NYIPLA), will be presenting a special webinar titled "Getting Ready for Arthrex Oral Arguments," which will summarize the issues presented and include presentations by representative *amici* on their respective positions.

QUESTION 1

The first question accepted by the Supreme Court is: Whether, for purposes of the Appointments Clause, U.S. CONST. art. II, § 2, cl. 2, administrative patent judges of the U.S. Patent and Trademark Office are principal officers who must be appointed by the President with the Senate's advice and consent, or "inferior Officers" whose appointment Congress has permissibly vested in a department head.

Twenty-nine of the 31 amicus briefs submitted addressed this question.

Seventeen of the amicus briefs argued that the Federal Circuit erred in finding that PTAB APJs are principal officers, and 12 supported the position that PTAB APJs are principal officers.

The 17 amicus briefs that we think argue that APJs are inferior officers include those submitted by: Association for Accessible Medicine (AAM); Acushnet Company & Roger Cleveland Golf Inc.; American Intellectual Property Law Association (AIPLA); Apple Inc.; Askeladden LLC; Coalition Against Patent Abuse (CAPA); Computer & Communications Industry Association (CCIA); Cross-Industry Groups; eComp Consultants; Engine Advocacy and Electronic Frontier Foundation (EFF); High Tech Inventors Alliance (HTIA); Intel Corp.; Intellectual Property Law Association of Chicago (IPLAC); Administrative, Constitutional & Intellectual Property Law Professors; Jason V. Morgan; Niskanen Center; and Unified Patents.

In the NYIPLA's upcoming webinar, five of these *amici*, namely eComp Consultants, AIPLA, Administrative, Constitutional & Intellectual Property Law Professors, Acushnet Company & Roger Cleveland Golf Inc., and Niskanen Center will summarize their respective positions in support of reversal on the first question.

The 12 amicus briefs arguing that APJs are principal officers include: 39 Aggrieved Inventors; Americans for Prosperity Foundation (APF); B.E. Technology, LLC; Cato Institute and Professor Gregory Dolin; Jeremy C. Doerre; Fair Inventing Fund (FIF); Joshua J. Malone; New Civil Liberties Alliance (NCLA); Pacific Legal Foundation (PLF); TiVo Corporation; US Inventor, Inc.; and US Lumber Coalition.

In the NYIPLA webinar, five of these *amici,* namely Jeremy C. Doerre, Cato Institute, NCLA, B.E. Technology, and Joshua J. Malone will summarize their respective positions as to why the Federal Circuit should be affirmed on the first question.

QUESTION 2

The second question accepted by the Supreme Court is: Whether, if administrative patent judges are principal officers, the court of appeals properly cured any appointments clause defect in the current statutory scheme prospectively by severing the application of 5 U.S.C. § 7513(a) to those judges.

With respect to the second question presented, 25 of the amicus briefs submitted addressed this question.

Seven of the amicus briefs argued that the Federal Circuit's "fix" should be affirmed if the Court gets to the issue, two of the amicus briefs argued that the "fix" should have been applied not only prospectively, but also retrospectively, and 16 amicus briefs argued for a different solution.

The seven amicus briefs which argued that, to the extent it is necessary, the Supreme Court should affirm the "fix" offered by the Federal Circuit included: AAM; Apple Inc.; CCIA; Cross-Industry Groups; EFF; HTIA; and Intel Corp.

The two amicus briefs which argued that, to the extent a "fix" was necessary, the Federal Circuit's fix should also be retrospectively applied include those of Professor John Harrison and Professor Andrew Michaels. Both Professors will be sharing a summary of their arguments at the NYIPLA Webinar.

The 16 amicus briefs which argued for a different solution include: 39 Aggrieved Inventors; AIPLA; APF; B.E. Technology; CAPA; Cato Institute; FIF; Law Professors; Joshua Malone; Jason Morgan; NCLA; PLF; TiVo; UP; US Inventor; and US Lumber.

Of these, Unified Patents, AIPLA, 39 Aggrieved Inventors, Cato Institute, NCLA and US Inventor will be presenting summaries of their arguments in the NYIPLA webinar.