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Two Years in Review: Rehearing Petitions in Patent Cases

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The U.S. Court of Appeals for the Federal Circuit has not granted a petition for en banc rehearing in a patent case in more than six years.[1] In 2021 and 2022, the court granted only a handful of petitions for panel rehearing in patent cases. Notwithstanding the overall low success rate of rehearing petitions, the Federal Circuit is more likely to call for a response to a petition when an amicus curiae files a brief in support of the petitioner. Whether or not this impact is causal (or merely correlative), it suggests that parties seeking rehearing are well-advised to muster amicus support.

This article provides a brief overview of the Federal Circuit's rehearing procedures, examines how the court has acted on petitions for panel rehearing and/or en banc rehearing filed in 2021 and 2022, and presents key takeaways for parties and interested industry players.

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OVERVIEW OF FEDERAL CIRCUIT'S REHEARING PROCEDURES

This section describes the nuts and bolts of the Federal Circuit's rehearing procedures.

A petition for rehearing is an optional procedure available to parties after the Federal Circuit enters judgment in an appeal.[2] A party can either ask for panel rehearing (by the original three-judge panel) or en banc rehearing (by the full Federal Circuit) – or both.[3] Petitioners seeking panel rehearing must state "with particularity" each point of law or fact that the court has overlooked or misapprehended.[4]

Petitioners seeking en banc rehearing must state that either (a) the panel decision is contrary to Supreme Court or Federal Circuit precedent such that en banc consideration is necessary "to secure or maintain uniformity of the court's decisions," or (b) the appeal involves "a question of exceptional importance."[5]

Once filed, rehearing petitions go through a two-stage review process. At the first stage, the court distributes all rehearing petitions to the panel, regardless of whether the petition is styled as a petition for panel rehearing, a petition for en banc rehearing, or a combined petition for panel and en banc rehearing.[6] The panel has 10 working days – roughly two weeks – to consider whether to act on the petition.[7] Any single panel member may invite a response from the non-petitioning parties,

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i.e., calling for a response.[8] After the court receives a response, the panel has another 10 working days to consider whether to grant or deny the rehearing petition.[9] If no panel member calls for a response or if a majority of the panel does not vote to grant, the panel rehearing petition fails.[10]

Then, if the petition requests en banc action, the court proceeds to the second stage and distributes the petition to the active judges of the court.[11] The full court also has 10 working days to consider whether to call for a response, and any single judge may do so.[12] If no one calls for a response, the en banc rehearing petition fails as a matter of course.[13] If a response is requested and filed, the full court then has 10 more working days to consider whether to initiate a poll on en banc rehearing.[14] Any single judge may request a poll, but a majority of the active judges must vote to rehear the appeal en banc in order for the petition to be granted.[15] At any point in the second stage, the panel may retrieve the petition from the full court, and the two-stage review process repeats.[16]

The Federal Circuit Rules permit amici curiae to seek leave to file amicus briefs in support of the petitioner, the respondent, or neither party.[17] Motions for leave to file must be accompanied by the amicus curiae's brief.[18] If, at either stage, the court grants rehearing, it might simply reissue a revised decision, or call for additional briefing and/or oral argument before issuing another decision.[19]

REHEARING PETITIONS IN 2021 AND 2022

In 2021 and 2022, the Federal Circuit received and resolved 129 petitions for panel rehearing, en banc rehearing, or both in patent cases.[20] The court called for a response to 45 of the 129 petitions – approximately 35%. But the court granted, at least in part, only six petitions – a grant rate of about 4.7%. All six were petitions for panel rehearing.

Table 1

Year	Petitions (Grants/Total)	Calls for Response (Calls/Total)
2021	**1 / 79** (1.3%)	**24 / 79** (30.4%)
2022	**5 / 50** (10.0%)	**21 / 50** (42.0%)
Both (2021 and 2022)	**6 / 129** (4.7%)	**45 / 129** (34.9%)

Comparing the two years, the number of petitions for rehearing of patent cases decreased from 79 petitions in 2021 to 50 petitions in 2022.[21] At the same time, the number of calls for a response stayed roughly the same – 24 in 2021 and 21 in 2022. Ultimately, as seen in Table 1, the court granted one panel rehearing petition in 2021 and five in 2022. Each of those grants occurred after a call for response.

Overall, in 2021 and 2022, the court took an average of 44.7 ± 28.9 days to rule on a rehearing petition.[22] As one would expect, the court ruled much more quickly on petitions that were denied without a call for a response (30.9 ± 8.8 days) than it did on petitions that were denied after a call for a response (67.2 ± 28.6 days) or the six petitions that it granted after a call for response (91.0 ± 64.5 days).

In the 45 cases in which the court called for a response, it generally did so 17.5 ± 11.8 days after the filing of the rehearing petition. Eighteen of these 45 calls for a response (or 40%) occurred within 14 days after the filing of the rehearing petition (i.e., during the first stage of the court's review process, when the panel reviews the petition).[23] In 2021 and 2022, the quickest call for a response was the same day as the filing of the petition, and the slowest call for a response was 52 days after the filing of the petition.

As seen in Table 2, the court's pace in calling for a response and ruling on a petition did not vary significantly between 2021 and 2022:

The Amicus Effect

Based on our review of rehearing petitions in patent cases in the last two years, the Federal Circuit is more likely to call for a response in cases with an amicus brief filing than in cases without. However, no amicus briefs were filed in support of the six petitions that were granted.

In 2021 and 2022, amici curiae filed briefs supporting the petitioner in 18 patent cases and supporting the respondent in one patent case. In five of the 19 cases (including the case with an amicus brief supporting the respondent), the Federal Circuit called for a response to the petition for rehearing before any amicus curiae moved for leave to file an amicus brief. For these five cases, therefore, the amicus brief(s) obviously could not have encouraged the court to call for a response.

Of the remaining 14 cases with at least one amicus brief filing, the court called for a response in 10 cases – a call rate of about 71.4%. By contrast, in

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Table 2

Year	Time From Petition to Call for Response (Days)	Time From Petition to Ruling (Days)			
		Denials With No Call for Response	Denials After Call for Response	Grants After Call for Response	All Petitions
2021	**15.5 ± 12.1** (n = 24)	**31.9 ± 8.2** (n = 55)	**73.8 ± 34.3** (n = 23)	**49.0 ± 0.0** (n = 1)	**44.3 ± 27.3** (n = 79)
2022	**19.7 ± 11.3** (n = 21)	**29.1 ± 9.6** (n = 29)	**57.6 ± 13.6** (n = 16)	**99.4 ± 68.4** (n = 5)	**45.2 ± 31.5** (n = 50)
Both (2021 and 2022)	**17.5 ± 11.8** (n = 45)	**30.9 ± 8.8** (n = 84)	**67.2 ± 28.6** (n = 39)	**91.0 ± 64.5** (n = 6)	**44.7 ± 28.9** (n = 129)

the 110 cases with no amicus brief filing, the court called for a response in only 30 cases – a call rate of about 27.3%.[24] That is a stark difference, although whether the relationship is causal or correlative – or a bit of both – is unclear. On the other hand, there were no amicus briefs in the six granted petitions.

THE SIX GRANTED PETITIONS FOR PANEL REHEARING

The grounds for rehearing asserted in the six granted petitions reinforce the Federal Circuit's general stance that rehearing petitions are rarely successful.[25] Again, these six represent 4.7% of all rehearing petitions in patent cases that the Federal Circuit received and resolved in 2021 and 2022. For the majority of these six petitions, the basis for the court's grant appears to be reasons other than a rote recitation of previously presented and rejected arguments.

In three of the six petitions, after the petitioner identified discrete factual or legal errors in the panel opinion – "point[s] of law or fact that . . . the court has overlooked or misapprehended"[26] – the panel granted (at least in part) the rehearing petition and issued a modified opinion, albeit reaching the same outcome. These three cases are:

- *Nature Simulation Systems Inc. v. Autodesk, Inc.*, No. 20-2257
  - *Original Opinions*: A panel reversed a district court ruling of invalidity for indefiniteness and remanded for further proceedings.[27] One panel member dissented.[28]
  - *Grounds for Rehearing*: The petitioner identified and took issue with specific language in the original majority decision about (1) the deference accorded to U.S. Patent and Trademark Office (PTO) examiner determinations of definiteness during prosecution and (2) the relevance of written description, enablement, and best mode to the indefiniteness inquiry.[29]
  - *Modified Opinions*: The same panel issued modified majority and dissenting opinions.[30] The modified majority opinion removed the specific language objected to in the rehearing petition and bolstered the disposition with additional reasoning, to which the dissent responded.[31]
- *Polygroup Ltd. MCO v. Willis Electric Company*, Nos. 21-1401, -1402
  - *Original Opinions*: A panel reversed-in-part, vacated-in-part, and remanded a Patent Trial and Appeal Board (PTAB) final written decision of patentability.[32] One panel member dissented in part.[33]
  - *Grounds for Rehearing*: The petitioner objected to the inclusion of an unappealed patent claim in the original opinions' list of reviewed claims.[34]
  - *Modified Opinions*: The same panel of judges issued modified majority and dissenting in part opinions removing references to the unappealed patent claim.[35]
- *Edgewell Personal Care Brands v. Munchkin, Inc.*, No. 20-1203

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- *Original Opinion*: A panel vacated-in-part, reversed-in-part, and remanded a district court's grant of summary judgment of noninfringement.[36]

- *Grounds for Rehearing*: The petitioner asserted that the panel overlooked its arguments on an additional, independent basis for affirming the district court's grant of summary judgment of noninfringement.[37]

- *Modified Opinion*: The same panel of judges issued a modified opinion disposing of the purportedly overlooked argument.[38]

In a fourth granted petition, the outcome likewise did not change. There, the petitioner identified a conflict of interest with one of the judges on the initial panel that summarily affirmed under Federal Circuit Rule 36(a).[39] Two judges on the panel recused, and the court constituted a new panel that issued a short, non-precedential per curiam opinion affirming.[40] The newly constituted panel also admonished the petitioner for its delay in raising the conflict until after oral arguments and entry of judgment in the appeal.[41]

The remaining two granted petitions are the only ones that changed the outcome. In one, a panel affirmed a PTAB final written decision of patentability solely based on its affirmance in a companion appeal of a district court judgment that overlapping claims of the same patent were invalid for lack of written description.[42] The petitioner asserted that the court should have vacated the PTAB final written decision because, in these circumstances, the appeal was moot.[43] The panel agreed with the petitioner and issued per curiam orders vacating the original opinion and the PTAB final written decision.[44]

Filing an amicus brief in support of a petitioner is a good way for non-parties to draw the Federal Circuit's attention to particular issues.

In the other case, an initial panel ruled 2-1 to affirm a district court judgment finding written description support for a negative limitation.[45] Following the rehearing petition and response (and one panel member's retirement), a modified panel ruled 2-1 to reverse the district court judgment.[46]

TAKEAWAYS FOR PETITIONERS/ PARTIES THAT LOSE ON APPEAL

Petitioners face a steep uphill climb when trying to convince a panel or the full court to rehear their case. Securing a different outcome is even more difficult. Indeed, in the past two years, petitioners in only two patent cases persuaded the court to reach a different result.

Petitioners should refrain from viewing rehearing petitions as a second chance to present their best arguments on appeal. Indeed, several members of the court have urged litigants to be more selective.[47] General disagreements with the panel's application of the law to facts or exaggerated conflicts with precedent are unlikely to gain traction.

TAKEAWAYS FOR RESPONDENTS/ PARTIES THAT WIN ON APPEAL

If at least one judge is interested in a rehearing petition, parties that prevail on appeal should expect a call for a response within a few weeks of the filing of the rehearing petition. Responses provide a valuable opportunity to counterbalance the petitioner's (and any amicus curiae's) framing of the panel opinion.

In any event, the vast majority of petitions are denied, even when the court calls for a response. In such cases, the petition is typically denied within two or three months after the petition is filed. If the court does not call for a response, the denial typically takes about one month.

TAKEAWAYS FOR INTERESTED INDUSTRY PLAYERS

Filing an amicus brief in support of a petitioner is a good way for non-parties to draw the Federal Circuit's attention to particular issues. The court is generally receptive to receiving amicus briefs, and the court appears more willing to call for a response to a rehearing petition if an amicus brief has been filed.

CONCLUSION

- In 2021 and 2022, the U.S. Court of Appeals for the Federal Circuit called for a response to more than one-third of rehearing petitions filed in patent cases, but granted fewer than 5% of them.

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- The court called for a response in more than 70% of cases with at least one amicus brief in support of the petitioner.

- The court granted panel rehearing in only six patent cases, and only changed its disposition twice.

- The court did not grant en banc rehearing in any patent case.

Notes

1. See En Banc Cases, Fed Circuit Blog, https://fedcircuitblog.com/en-banc/cases/ (last visited Jan. 27, 2023). The Federal Circuit last granted a petition for en banc rehearing in 2017 in Wi-Fi One, LLC v. Broadcom Corp, 851 F.3d 1241 (Fed. Cir. 2017) (mem.). See id. (January 4, 2017 order granting petition for en banc rehearing). Since Wi-Fi One, in patent cases, the Federal Circuit has sua sponte ordered rehearing en banc and issued an opinion with an en banc footnote. NantKwest, Inc. v. Matal, 869 F.3d 1327 (Fed. Cir. 2017) (mem.) (August 31, 2017 order for sua sponte rehearing en banc); Click-to-Call Techs., LP v. Ingenio, Inc., 899 F.3d 1321, 1328 n.3 (Fed. Cir. 2018) (en banc footnote). But it has yet to grant a petition for en banc rehearing in a patent case since Wi-Fi One.
2. See Fed. Cir. R. 35, 40.
3. See Fed. R. App. P. 35(b), 40(a); Fed. Cir. R. 35(d).
4. See Fed. R. App. P. 40(a)(2); Fed. Cir. R. 40(a)(5).
5. See Fed. R. App. P. 35(a), (b); Fed. Cir. R. 35(b)(2).
6. See Internal Operating Procedures (hereinafter, IOP) #12(1)(b), #14(2)(a), U.S. Ct. of Appeals for the Fed. Cir., https://cafc.uscourts.gov/wp-content/uploads/RulesProceduresAndForms/InternalOperatingProcedures/InternalOperatingProcedures.pdf (last updated July 22, 2022).
7. Id. #12(1)(b).
8. See id. #12(4)(b). A party may decline to respond, id., although in practice that is rare. See Order, VDPP LLC v. VIZIO, Inc., No. 21-2040 (Fed. Cir. June 29, 2022), ECF No. 61.
9. See IOP #12(4)(b).
10. See id. #12(2), (3)(a).
11. See id. #12(1)(a), #14(2)(a).
12. See id. #14(2)(a).
13. See id. #14(2)(b).
14. See id. #14(2)(c).
15. See id. #14(2)(c), (5).
16. See id. #14(2)(e).
17. See Fed. Cir. R. 35(g), 40(g).
18. See id.
19. See IOP #12(3)(b), #14(2)(f).
20. The Federal Circuit struck one of the 129 petitions for noncompliance with its rules, and a petitioner withdrew a second petition prior to the court ruling on it. See Order, Pop Top Corp. v. Rakuten Kobo Inc., No. 21-2174 (Fed. Cir. Aug. 23, 2022), ECF No. 53 (striking rehearing petition); Order, Bio-Rad Lab'ies, Inc. v. ITC, No. 20-1475 (Fed. Cir. July 28, 2021), ECF No. 84 (granting motion to withdraw rehearing petition). As of December 31, 2022, another four petitions remained pending, and this article does not address them. Our review also does not include an additional two petitions for initial en banc hearing in patent cases, both of which were denied. See Order, Jump Rope Sys., LLC v. Coulter Ventures, LLC, No. 22-1264 (Fed. Cir. May 5, 2022), ECF No. 11; Roku, Inc. v. Universal Elecs., Inc., No. 22-1216 (Fed. Cir. Dec. 30, 2021), ECF No. 12.
21. The marked decrease in filings of rehearing petitions in patent cases may, in part, be the result of comments made by Federal Circuit judges at a conference in March 2022 urging attorneys to be more selective in seeking rehearing. See Ryan Davis, Fed. Cir. Judges Say Cool It with the Rehearing Petitions, Law360 (Mar. 17, 2022, 8:08 PM), https://www.law360.com/articles/1475014.
22. Unless otherwise noted, all plus-minus values are mean ± sample standard deviation.
23. Although calls for a response ordered within 14 days after the filing of a rehearing petition are likely made by a panel member, we cannot say conclusively whether a panel member or judge on the full court made the call. A judge on the full court may have taken interest in a case, as can happen during the 10-day full-court review of any precedential opinions prior to their issuance. Federal holidays and administrative procedures may give the panel more than 14 days to consider a rehearing petition. And, sometimes, the panel has discretion to extend the review period. See Letter to Appellee Biogen MA Inc., Mylan Pharms. Inc. v. Biogen MA Inc., No. 20-1673 (Fed. Cir. Mar. 21, 2022), ECF No. 66 (calling for a response 52 days after the filing of a petition for panel rehearing only).
24. Even if the 110 cases were added to the five cases in which the court called for a response before a motion for leave to file an amicus brief, the call rate of 30.4% (or 35/115) would still be substantially lower.
25. Petitions for Rehearing & Rehearing En Banc, U.S. Ct. of Appeals for the Fed. Cir., https://cafc.uscourts.gov/home/case-information/case-filings/petitions-for-rehearing-rehearing-en-banc/ (last visited Jan. 27, 2023).
26. See Fed. R. App. P. 40(a)(2); Fed. Cir. R. 40(a)(5).

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27. Nature Simulation Sys. Inc. v. Autodesk, Inc., 23 F.4th 1334, 1336 (Fed. Cir. 2022).
28. Id. at 1344 (dissent).
29. Autodesk, Inc.'s Combined Petition for Panel & En Banc Rehearing, Nature Simulation Sys. Inc. v. Autodesk, Inc., No. 20-2257 (Fed. Cir. Mar. 21, 2022), ECF No. 35.
30. Nature Simulation Sys. Inc. v. Autodesk, Inc., 50 F.4th 1358, 1360 (Fed. Cir. 2022); id. at 1368 (dissent).
31. See id. at 1367–68; id. at 1371 (dissent).
32. Polygroup Ltd. MCO v. Willis Elec. Co., Nos. 21-1401, -1402, 2022 WL 167466, at *1 (Fed. Cir. Jan. 19, 2022).
33. Id. at *5 (dissent in part).
34. Combined Petition of Appellee Willis Electric Co., Ltd. for Panel Rehearing or Rehearing En Banc, Polygroup Ltd. MCO v. Willis Elec. Co., Nos. 21-1401, -1402 (Fed. Cir. Feb. 18, 2022), ECF No. 46.
35. See Polygroup Ltd. MCO v. Willis Elec. Co., Nos. 21-1401, -1402, 2022 WL 1183332, at *1 (Fed. Cir. Apr. 20, 2022); id. at *5 (dissent in part).
36. Edgewell Pers. Care Brands, LLC v. Munchkin, Inc., 989 F.3d 1358, 1361 (Fed. Cir. 2021).
37. Petition for Rehearing of Defendant-Appellee, Edgewell Pers. Care Brands, LLC v. Munchkin, Inc., No. 20-1203 (Fed. Cir. Apr. 7, 2021), ECF No. 48.
38. Edgewell Pers. Care Brands, LLC v. Munchkin, Inc., 998 F.3d 917, 919 (Fed. Cir. 2021).
39. W. Plastics, Inc. v. DuBose Strapping, Inc., Nos. 21-1371, -1372, 2021 WL 5985361, at *1 (Fed. Cir. Dec. 17, 2021); Defendant-Appellant's Petition for Rehearing En Banc, W. Plastics, Inc. v. DuBose Strapping, Inc., Nos. 21-1371, -1372, (Fed. Cir. Jan. 18, 2022), ECF No. 44; Order, W. Plastics, Nos. 21-1371, -1372 (Fed. Cir. Feb. 25, 2022), ECF No. 50.
40. W. Plastics, 2022 WL 576218, at *1.
41. W. Plastics, 2022 WL 576218, at *1 n.1.
42. Mylan Pharms. Inc. v. Biogen MA Inc., No. 20-1673, 2021 WL 5571658, at *1 (Fed. Cir. Nov. 30, 2021).
43. Appellant's Petition for Panel Rehearing, Mylan Pharms. Inc. v. Biogen MA Inc., No. 20-1673 (Fed. Cir. Jan. 28, 2022), ECF No. 64.
44. Mylan Pharms. Inc. v. Biogen MA Inc., No. 20-1673, 2022 WL 1089900, at *1 (Fed. Cir. Apr. 8, 2022); Mylan Pharms. Inc. v. Biogen MA Inc., No. 20-1673, 2022 WL 14461991, at *1 (Fed. Cir. Oct. 25, 2022).
45. Novartis Pharms. Corp. v. Accord Healthcare, Inc., 21 F.4th 1362, 1365 (Fed. Cir. 2022).
46. Novartis Pharms. Corp. v. Accord Healthcare, Inc., 38 F.4th 1013, 1015 (Fed. Cir. 2022).
47. See Davis, supra note 21.

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