No. 24-_____

IN THE
Supreme Court of the United States

GESTURE TECHNOLOGY PARTNERS, LLC,
Petitioner,

v.

APPLE INC., LG ELECTRONICS INC.,
LG ELECTRONICS USA, INC., GOOGLE LLC,
AND ACTING DIRECTOR OF THE U.S. PATENT
AND TRADEMARK OFFICE,
Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

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QUESTION PRESENTED

This Court long has recognized that a patent is the private property of its owner, who has the constitutional right to pursue an injunction to stop infringers of the patent and to seek infringement damages before a jury in a court of law. In *Oil States Energy Services, LLC v. Greene's Energy Group, LLC*, 584 U.S. 325 (2018), the Court held that Congress constitutionally could authorize the U.S. Patent and Trademark Office ("PTO") to take "a second look at an earlier administrative grant of a patent" and reconsider the patentability of its claims during the life of the patent monopoly. *Id.* at 336. Administrative re-adjudication of the validity of existing patents is justified under Article III of the Constitution insofar as it allows the government to vindicate the public's "interest in seeing that patent monopolies are kept within their legitimate scope." *Id.* at 336-37. But claims by a holder of an expired patent for past damages from infringements do not raise the same public-interest concern because the government is not being used to stop potential innovations in the marketplace. The question presented is:

Whether the PTO has the authority to conduct administrative adjudications regarding the validity of expired patents, and thereby extinguish private property rights through a non-Article III forum without a jury, even though the patent owner no longer possesses the right to exclude the public from its invention.

PARTIES TO THE PROCEEDINGS

Petitioner Gesture Technology Partners, LLC was the patent owner in the proceedings before the Patent Trial and Appeal Board, the appellant in Nos. 2023-1463, 2024-1037, and 2024-1038 in the proceedings in the Federal Circuit, and the cross-appellant in Nos. 2023-1501 and 2023-1554 in the proceedings in the Federal Circuit.

Respondent Apple Inc. was a petitioner in the proceedings before the Patent Trial and Appeal Board, an appellant in Nos. 2023-1501 and 2023-1554 in the proceedings in the Federal Circuit, and an appellee in No. 2023-1463 in the proceedings in the Federal Circuit.

Respondents LG Electronics Inc., LG Electronics USA, Inc., and Google LLC were petitioners in the proceedings before the Patent Trial and Appeal Board and appellees in Nos. 2023-1463, 2023-1501 and 2023-1554 in the proceedings in the Federal Circuit.

Respondent Acting Director of the U.S. Patent and Trademark Office was the appellee in Nos. 2024-1037 and 2024-1038 in the proceedings in the Federal Circuit.

RULE 29.6 STATEMENT

Petitioner Gesture Technology Partners, LLC is a private limited liability company that has no parent company; no publicly held company holds 10% or more of its stock.

RELATED CASES

Decisions Under Review

Apple Inc. v. Gesture Tech. Partners, LLC, 127 F.4th 364 (Fed. Cir. Jan. 27, 2025) (Nos. 2023-1501, 2023-1554) (affirming and reversing in part inter partes review of final written decision of the Patent Trial and Appeals Board)

In re Gesture Tech. Partners, LLC, 2025 WL 303650 (Fed. Cir. Jan. 27, 2025) (No. 2024-1037) (affirming *ex parte* reexamination of final written decision of the Patent Trial and Appeals Board)

In re Gesture Tech. Partners, LLC, 2025 WL 303446 (Fed. Cir. Jan. 27, 2025) (No. 2024-1038) (affirming *ex parte* reexamination of final written decision of the Patent Trial and Appeals Board)

Gesture Tech. Partners, LLC v. Apple Inc., 2025 WL 303653 (Fed. Cir. Jan. 27, 2025) (No. 2023-1463) (affirming inter partes review of final written decision of the Patent Trial and Appeals Board)

Ex parte Gesture Tech. Partners, LLC, 2023 Pat. App. LEXIS 2535 (Patent Tr. & App. Bd. Aug. 8, 2023) (Appeal 2023-001713)

Ex parte Gesture Tech. Partners, LLC, 2023 Pat. App. LEXIS 2536 (Patent Tr. & App. Bd. Aug. 8, 2023) (Appeal 2023-001857)

Apple Inc. v. Gesture Tech. Partners, LLC, 2022 WL 17254070 (Patent Tr. & App. Bd. Nov. 28, 2022) (Nos. IPR2021-00922, IPR2022-00090, IPR2022-00360)

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Unified Pats., LLC v. Gesture Tech. Partners, LLC, 2022 WL 17096296 (Patent Tr. & App. Bd. Nov. 21, 2022) (No. IPR2021-00917)

Apple Inc. v. Gesture Tech. Partners, LLC, 129 F.4th 1367 (Fed. Cir. Mar. 4, 2025) (Nos. 2023-1475, 2023-1533) (affirming inter partes review of final written decision of the Patent Trial and Appeals Board)

Apple Inc. v. Gesture Tech. Partners, LLC, 2022 WL 17364390 (Patent Tr. & App. Bd. Nov. 30, 2022) (Nos. IPR2021-00920, IPR2022-00091, IPR2022-00359)

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Petitioner Gesture Technology Partners, LLC petitions for a writ of certiorari to review the judgments of the Federal Circuit in this case.

OPINIONS BELOW

The court of appeals' opinion in Nos. 2023-1501 and 2023-1554 (App. 1a-15a) is reported at 127 F.4th 364. The court of appeals' opinions in No. 2024-1038 (App. 16a-21a), No. 2024-1037 (App. 22a-25a), and No. 2023-1463 (App. 26a-27a) are not reported (but are available at 2025 WL 303446, 2025 WL 303650, and 2025 WL 303653, respectively).

The decisions of the Patent Trial and Appeal Board (App. 28a-56a, 57a-86a, 87a-127a, 128a-156a) are not reported (but are available at 2023 Pat. App. LEXIS 2536, 2023 Pat. App. LEXIS 2535, 2022 WL 17418636, and 2022 WL 17254070, respectively).

JURISDICTION

The Federal Circuit entered its judgments on January 27, 2025. On April 23, 2025, Chief Justice Roberts extended the time for filing a petition for a writ of certiorari to and including June 11, 2025. This Court's jurisdiction is invoked under 28 U.S.C. § 1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

Relevant provisions of Article III and the Seventh Amendment to the United States Constitution and the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011), are set forth at App. 157a-169a.

INTRODUCTION

This case involves an extraordinary arrogation of administrative power over patents that the Federal Circuit upheld. The Patent Trial and Appeal Board ("PTAB"), an adjudicatory body within the U.S. Patent and Trademark Office ("PTO"), asserted the power to invalidate *expired* patents – patents whose period of exclusivity has ended but that still could be the subject of monetary infringement claims if the infringement occurred during the patent's period of exclusivity. Several centuries of patent practice, however, ensure patent holders the right to a jury trial and full judicial process over infringement claims concerning expired patents. The PTAB decisions, as upheld by the Federal Circuit, mean that constitutional jury trial and judicial process rights for those patent holders now may be replaced by the discretion of an administrative agency at the behest of infringement defendants.[1]

Patents create valuable property rights that persist even after the expiration of the patent. An "expired patent is not viewed as having never existed. Much to the contrary, a patent does have value beyond its expiration date." *Genetics Inst., LLC v. Novartis Vaccines & Diagnostics, Inc.*, 655 F.3d 1291, 1299 (Fed. Cir. 2011) (cleaned up). When a patent expires, the owner no longer can exclude the public from using the invention through a court-ordered injunction, but still may seek damages for infringement that

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[1] The PTAB is "an adjudicatory body within the PTO created to conduct inter partes review." *Oil States Energy Servs., LLC v. Greene's Energy Grp., LLC*, 584 U.S. 325, 331 (2018). *See* 35 U.S.C. §§ 6, 316(c). The PTAB also has been authorized to decide appeals from ex parte reexamination decisions. *See id.* § 134(b). Because the PTAB is a sub-agency within the PTO, all references in this petition to the PTO are inclusive of the PTAB.

occurred during the life of the patent. Like all patent-infringement actions, infringement actions involving expired patents "must be tried to a jury, as their predecessors were more than two centuries ago." *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 377 (1996); *see*, *e.g.*, *Root v. Lake Shore & M.S. Ry. Co.*, 105 U.S. 189, 216-17 (1882) (proper remedy for infringement of expired patent is "an action at law for the recovery of damages").

Seeking to make patent litigation more efficient, Congress in 2010 passed the Leahy-Smith America Invents Act, which streamlined the processes by which private parties could challenge and the PTO could reconsider the validity of previously issued patents. In *Oil States*, this Court upheld the constitutionality of one new mode of administrative adjudication called "inter partes review" under the "public-rights" exception to Article III. The Court reasoned that inter partes review involves "a second look at an earlier administrative grant" of the public franchise, and thus implicates the public's "interest in seeing that patent monopolies are kept within their legitimate scope." 584 U.S. at 336-37. For patents within their exclusivity period, inter partes review, like the related ex parte reexamination process that exists alongside it, affords the patent holder a full opportunity to participate and to submit alternative claims language to satisfy PTO concerns, so that the patent may remain valid. *See* 35 U.S.C. §§ 305 (ex parte reexamination), 316(d)(1)(B) (inter partes review).

In this case, no one challenged the validity of petitioner's patents through any form of administrative adjudication during the patent's period of exclusivity. In the decisions below, the Federal Circuit addressed a circumstance that *Oil States* did not: whether the PTO's authority to take "a second look" extends to

expired patent claims, which no longer confer the government-granted right to exclude use of the patented innovation. For the first time, the Federal Circuit held that the PTO could cancel *expired* patents through an administrative adjudication process where the patent holder has limited procedural and remedial rights – notwithstanding Article III and the Seventh Amendment.[2]

That decision lacks merit and warrants this Court's review. Expired patents do not implicate the right to exclude or the public's interest in policing a patentee's exercise of that right. *See Kimble v. Marvel Ent., LLC*, 576 U.S. 446, 451 (2015) ("[W]hen the patent expires, the patentee's prerogatives expire too, and the right to make or use the article, free from all restriction, passes to the public."). The end of the inventor's exclusive monopoly likewise ends the need for an administrative process to protect the public interest by maintaining that monopoly within its legitimate scope. *See Oil States*, 584 U.S. at 336-37.

At the same time, holders of an expired patent still retain valuable private rights, including the right to seek monetary damages for past infringement. The only practical purpose served by an administrative challenge to the validity of an *expired* patent is to

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[2] The four decisions below encompass appeals by Gesture from both inter partes review proceedings and ex parte reexamination proceedings. The Federal Circuit analyzed and rejected Gesture's Article III challenge in the context of an appeal from an inter partes review proceeding, but subsequently cross-applied its analysis to all of the related cases, including the ex parte reexamination appeals. Consistent with the Federal Circuit's approach, the constitutional question presented in this petition applies to both forms of administrative adjudication. Thus, while this petition occasionally refers to inter partes review, the constitutional analysis applies to ex parte reexamination as well.

extinguish the patentee's right to seek such damages – fundamentally, a dispute between *private* parties over *property* rights. The public, which is now free to use the patentee's invention, has no stake in the outcome. As such, disputes over expired patents have no "connection with the performance of the constitutional functions of the executive or legislative departments" required for adjudication in a non-Article III forum. *Id.* at 334. Once the public franchise is gone, the owner of an expired patent has the right to vindicate her vested private interests in an Article III forum.

In holding that disputes involving expired patents fall under the public-rights exception to Article III, the Federal Circuit sanctioned the extinguishment of private rights by politically appointed administrative panels. It weighed in on the ongoing debate over the dividing line between public and private rights – limiting rights-holders' access to Article III fora and putting millions of dollars of property rights at stake. These decisions thus "raise[] exceptionally important questions of constitutional law and separation of powers principles" that warrant this Court's review. *See Cascades Projection LLC v. Epson Am., Inc.*, 2017 WL 1946963, at *4 (Fed. Cir. May 11, 2017) (O'Malley, J., dissenting from denial of hearing en banc).

The Federal Circuit already has entrenched its error in a number of related decisions, institutionalizing the PTO's power to invalidate expired patents. Because of the Federal Circuit's exclusive jurisdiction over patents and PTAB decisions, there is no prospect of a circuit conflict. The Federal Circuit's approach departs from this Court's decisions and fundamental constitutional principles protecting vested private property rights. Certiorari is warranted.

STATEMENT

A. Legal Background

The Constitution empowers Congress "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." Art. I, § 8, cl. 8. Under this authority, Congress created the PTO, which is "responsible for the granting and issuing of patents." 35 U.S.C. § 2(a)(1).

In the last half century, Congress has created certain administrative processes that allow the PTO to review and cancel patents that were wrongly issued. First, in 1980, Congress established "ex parte reexamination," which permits any person to request that the PTO reconsider the patentability of an existing patent, using the same procedures as the initial examination. *See* 35 U.S.C. §§ 301-307. In 1999, Congress created an additional process called "inter partes reexamination," which is similar to ex parte reexamination but allows the requester and patent owner limited participation in the proceedings. *See id.* § 314 (2006).

In 2011, Congress passed the America Invents Act. *See* 35 U.S.C. §§ 311-319. The purpose of the Act was to update the patent system to better reflect Congress's "constitutional imperative" to "promote innovation by granting inventors temporally limited monopolies on their inventions in a manner that ultimately benefits the public" and provide "a more efficient system for challenging patents that should not have issued." H.R. Rep. No. 112-98, pt. 1, at 39-40 (2011). As this Court has explained, "Congress, concerned about overpatenting and its diminishment of competition, sought to weed out bad patent claims efficiently." *Thryv, Inc. v. Click-To-Call Techs., LP*, 590 U.S. 45, 54 (2020).

The America Invents Act amended the relevant statute in several respects material to this case. First, the Act created the PTAB as a new sub-agency within the PTO authorized to adjudicate issues of patentability. Members of the PTAB are primarily administrative patent judges, and all PTAB members, except the PTO Director, are appointed by the Secretary of Commerce. *See* 35 U.S.C. §§ 3(b)(1), (b)(2)(A), 6(a). The PTAB sits in three-member panels. *See id.* § 6(a).

Second, the Act amended 35 U.S.C. § 306 to eliminate the right of patent owners to obtain judicial review of adverse ex parte reexamination decisions by civil actions in district court. Instead, the Act provided that appeals from ex parte reexamination decisions would be decided by the PTAB. *See id.* § 134(b). After the PTAB's decision on an ex parte reexamination appeal, patent owners may appeal directly to the Federal Circuit as their sole remaining judicial recourse. *See id.* § 141(b).

Third, the Act replaced inter partes reexamination with a new adjudicatory process called "inter partes review." Inter partes review is "an adversarial process" that allows the PTO to "reconsider whether existing patents satisfy the novelty and nonobviousness requirements for inventions." *United States v. Arthrex, Inc.*, 594 U.S. 1, 8 (2021). Any person other than the patent owner can file a petition requesting cancellation of 1 or more "claims" (i.e., specific aspects) of a patent on the ground that the claim fails the requirements for patentability. *See* 35 U.S.C. § 311(a)-(b).

If the PTO Director determines "that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged," the Director has the discretion to grant inter partes review of the claims. *Id.* § 314(a). Once review is

instituted, the PTAB examines the patent's validity. *See id.* §§ 6, 316(c). To successfully challenge a patent claim, the petitioner must prove unpatentability by a preponderance of the evidence. *See id.* § 316(e); *In re Swanson*, 540 F.3d 1368, 1377 (Fed. Cir. 2008). The statute entitles the petitioner and the patent owner to limited discovery, to file affidavits, declarations, and written memoranda, and to receive an oral hearing. *See* 35 U.S.C. § 316(a). "Both discovery and trial proceed at a rapid pace." *PPC Broadband, Inc. v. Corning Optical Commc'ns RF, LLC*, 815 F.3d 734, 741 (Fed. Cir. 2016). During the proceedings, the patent owner can amend the patent by voluntarily canceling a claim or, if the patent is not expired, by "propos[ing] a reasonable number of substitute claims." 35 U.S.C. § 316(d)(1)(B).

Absent extension for good cause, the PTAB must issue a final written decision on whether the patent claims should be invalidated no later than one year after it noticed the institution of review. *See id.* §§ 316(a)(11), 318(a). After the PTAB's decision becomes final, the PTO must "issue and publish a certificate" that cancels any patent claims "finally determined to be unpatentable," confirms patent claims "determined to be patentable," and incorporates into the patent "any new or amended claim determined to be patentable." *Id.* § 318(b); *see also id.* § 307(a). Parties may seek judicial review in the Federal Circuit. *See id.* §§ 141, 319.

In *Oil States*, petitioner Oil States Energy Services, LLC sought to enforce its existing patent monopoly against respondent Greene's Energy Group, LLC, and Greene's responded by challenging the validity of the patent in an inter partes review proceeding before the PTAB. *See* 584 U.S. at 332-33. On appeal, this Court held that such a proceeding did not violate

Article III of the Constitution because the government retains the right to police the bounds of existing patent monopolies. The Court "emphasize[d] the narrowness of [its] holding," which it expressly limited to "the precise constitutional challenges" presented in Oil States' petition. *Id.* at 344.

In recent years, the PTAB has invalidated thousands of challenged patents through inter partes review, earning the nickname the patent "death squad" from former Federal Circuit Chief Judge Randall Rader. *See* Greg Stohr & Susan Decker, *'Death Squad' That Tossed 2,000 Patents Challenged at High Court*, Bloomberg (Feb. 27, 2021), *available at* https://www.bloomberg.com/news/articles/2021-02-27/-death-squad-that-tossed-2-000-patents-challenged-at-high-court.

B. Factual And Procedural Background

Petitioner Gesture Technology Partners, LLC ("Gesture") was founded in 2013 by Dr. Timothy Pryor. Dr. Pryor is a named inventor on more than 200 patents and patent applications, primarily involving laser sensing technology, motion sensing technology, machine vision technology, and camera-based interactive technology. Dr. Pryor began developing these technologies in the mid- to late-1990s.

In 2014, petitioner obtained U.S. Patent No. 8,878,949 (the "'949 Patent"), titled "Camera Based Interaction and Instruction," which is directed to camera technology for use in cellphones and other portable devices. The '949 Patent describes a portable device that detects physical gestures by the user that trigger the camera to capture an image. In the years after the '949 Patent was issued, several large technology companies recognized the immense commercial value of Dr. Pryor's invention and began implementing

the patented technology in their products without authorization.

The ’949 Patent expired in May 2020. None of the infringing companies – or anyone else – challenged the validity of the ’949 Patent during its life.

In early 2021, Gesture filed a series of infringement suits against some of the largest technology companies in the world. Beginning in June 2021, Apple, LG Electronics, and Google sought to undercut Gesture’s pending claims against them by filing petitions for inter partes review of the ’949 Patent. Samsung then filed a request for ex parte reexamination of the ’949 Patent. The PTO Director authorized review and reexamination, and the PTAB found all claims unpatentable aside from one dependent claim.

Apple appealed the PTAB’s determination as to the surviving dependent claim. Gesture cross-appealed, arguing that the PTAB erred in finding the remaining claims unpatentable and that the PTAB lacked jurisdiction because the ’949 Patent expired before Apple filed its petition. Gesture also appealed the PTAB’s decision in the ex parte reexamination.

On January 27, 2025, the Federal Circuit upheld the PTAB’s jurisdiction to conduct administrative adjudications of expired patents. App. 4a-7a. Relying on *Oil States*, the court concluded that the PTAB’s “second look” at the earlier administrative grant of a patent is consistent with the public-rights doctrine, even when the patent has expired. App. 6a-7a. The court rejected Gesture’s argument that disputes over expired patents do not implicate public rights because when a patent expires “the public franchise ceases to exist and the patent owner no longer has the right to exclude others.” App. 4a. The court held that “it is irrelevant whether the patent has expired, since the patent itself

continues to confer a limited set of rights to the patentee." App. 6a. As to Apple's appeal of the PTAB's determination that a single dependent claim of the '949 Patent was patentable, the court reversed.

That same day, the Federal Circuit issued three decisions in related appeals by Gesture presenting the same constitutional question. In each of these cases, Gesture raised an identical constitutional challenge to the PTO's administrative re-adjudication of its expired patent claims. In each of those decisions, the Federal Circuit rejected Gesture's constitutional challenge by reference to its reasoning in the lead opinion and without further analysis. *See* App. 21a (No. 2024-1038) ("Gesture argues that the [PTAB] lacked jurisdiction over this reexamination proceeding because the '949 patent has expired. That issue has been resolved, and rejected, in the separate opinion of *Apple*, No. 23-1501, [App. 1a-15a]."); App. 25a (No. 2024-1037) (same); App. 27a (No. 2023-1463) (same).

REASONS FOR GRANTING THE PETITION

I. THE FEDERAL CIRCUIT'S DECISION ERRONEOUSLY EXPANDS THE PTO'S JURISDICTION INTO THE REALM OF EXPIRED PATENTS, ENCROACHING ON THE JUDICIARY'S ARTICLE III POWER TO ADJUDICATE PRIVATE RIGHTS

A. While Agencies May Adjudicate Certain "Public Rights," Private-Rights Holders Are Entitled To The Protections Of An Article III Court

Article III vests the judicial power of the United States "in one supreme Court, and in such inferior Courts as the Congress may from time to time ordain and establish." U.S. Const. art. III, § 1. Accordingly, Congress cannot "withdraw from judicial cognizance

any matter which, from its nature, is the subject of a suit at the common law, or in equity, or admiralty." *Murray's Lessee v. Hoboken Land & Improvement Co.*, 59 U.S. (18 How.) 272, 284 (1856). As this Court has "repeatedly explained," "matters concerning private rights may not be removed from Article III courts." *SEC v. Jarkesy*, 603 U.S. 109, 127-28 (2024). A matter concerns private rights when it is "made of 'the stuff of the traditional actions at common law tried by the courts at Westminster in 1789.'" *Stern v. Marshall*, 564 U.S. 462, 484 (2011) (quoting *Northern Pipeline Constr. Co. v. Marathon Pipe Line Co.*, 458 U.S. 50, 90 (1982) (Rehnquist, J., concurring in the judgment)). "If a suit is in the nature of an action at common law, then the matter presumptively concerns private rights, and adjudication by an Article III court is mandatory." *Jarkesy*, 603 U.S. at 128.

Beyond disputes involving private rights, this Court has recognized "a category of cases involving 'public rights' that Congress could constitutionally assign to 'legislative' courts for resolution." *Stern*, 564 U.S. at 485 (quoting *Northern Pipeline*, 458 U.S. at 67 (plurality)). Although the Court "has not 'definitively explained' the distinction between public and private rights," its precedents make clear that the public-rights doctrine "covers matters 'which arise between the Government and persons subject to its authority in connection with the performance of the constitutional functions of the executive or legislative departments.'" *Oil States Energy Servs., LLC v. Greene's Energy Grp., LLC*, 584 U.S. 325, 334 (2018) (quoting *Crowell v. Benson*, 285 U.S. 22, 50 (1932)). Put another way, certain matters are "so closely integrated into a public regulatory scheme as to be a matter appropriate for agency resolution with limited involvement by

the Article III judiciary." *Thomas v. Union Carbide Agric. Prods. Co.*, 473 U.S. 568, 593-94 (1985).

The Seventh Amendment provides that "[i]n Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved." U.S. Const. amend. VII. "The right of trial by jury thus preserved is the right which existed under the English common law when the amendment was adopted." *Baltimore & Carolina Line, Inc. v. Redman*, 295 U.S. 654, 657 (1935). This Court has recognized that the jury right also extends to "actions brought to enforce statutory rights that are analogous to common-law causes of action ordinarily decided in English law courts." *Granfinanciera, S.A. v. Nordberg*, 492 U.S. 33, 42 (1989).

B. Patents Confer Private Property Rights That Are Properly Adjudicated In The Courts Of Law

Patents confer private property rights that historically have been adjudicated in the courts of law. As Chief Justice Marshall explained, the "constitution and law, taken together, give to the inventor, from the moment of invention, an inchoate property therein." *Evans v. Jordan*, 8 F. Cas. 872, 873 (C.C.D. Va. 1813) (No. 4,564), *aff'd*, 13 U.S. (9 Cranch) 199 (1815). This Court long has recognized that "the rights of a party under a patent are his private property." *Brown v. Duchesne*, 60 U.S. (19 How.) 183, 197 (1857); *see also Florida Prepaid Postsecondary Educ. Expense Bd. v. College Sav. Bank*, 527 U.S. 627, 642-43 (1999) (holding that patent rights are property rights protected by the Due Process Clause).

A patent is, "in effect, a bundle of rights," and among these rights is the right to seek damages for patent infringement. *Alfred E. Mann Found. for Sci. Rsch. v.*

Cochlear Corp., 604 F.3d 1354, 1360 (Fed. Cir. 2010); *see* 35 U.S.C. § 281; *Waterman v. Mackenzie*, 138 U.S. 252, 255-56 (1891). At common law, "[a]n action for patent infringement is one that would have been heard in the law courts of old England." *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 992-93 (Fed. Cir. 1995) (Mayer, J., concurring in the judgment), *aff'd*, 517 U.S. 370 (1996). As a result, patent-infringement actions "today must be tried to a jury, as their predecessors were more than two centuries ago." *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 377 (1996).

Historically, disputes involving patent rights were adjudicated in equity only when the patentee sought injunctive relief. *See Tegal Corp. v. Tokyo Electron Am., Inc.*, 257 F.3d 1331, 1340-41 (Fed. Cir. 2001); *In re Lockwood*, 50 F.3d 966, 973 (Fed. Cir.) (discussing history), *vacated on other grounds sub nom. American Airlines, Inc. v. Lockwood*, 515 U.S. 1182 (1995). Because owners of expired patents can seek only damages, only courts of law can resolve disputes involving expired patents. *See Root v. Lake Shore & M.S. Ry. Co.*, 105 U.S. 189, 216-17 (1882) (proper remedy for infringement of expired patent is "an action at law for the recovery of damages"); *see also Ross v. City of Ft. Wayne*, 63 F. 466, 467 (7th Cir. 1894). As this Court explained in *Root*, this distinction can be traced to English patent and copyright cases: In a case involving an expired patent or copyright, a court of equity "'has no jurisdiction to give to a plaintiff a remedy for an alleged piracy,'" and so "'his remedy, as in the case of any other injury to his property, must be at law.'" *Root*, 105 U.S. at 209-10 (quoting *Smith v. The London & South-Western Ry. Co.* (1854) 69 Eng. Rep. 173, 176, Kay 408, 415).

C. This Court Recognized In *Oil States* That Patents Also Create Public Rights To The Extent They Confer A "Public Franchise," Authorizing Certain Forms Of Administrative Adjudication

Notwithstanding patents' status as private property rights subject to adjudication in courts of law, the Court has recognized that patents also confer "public rights" to a limited but important extent. In addition to the right to seek infringement damages, patents also confer a "public franchise" – or the right to exclude the public from using the patentee's invention – for their period of validity. Congress, therefore, can legislate to prevent patentees from misusing the patent monopoly vis-à-vis the public.

Article I gives Congress the power "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. Const. art. I, § 8, cl. 8. Under that authority, Congress has authorized the PTO to grant patents that meet the statutory requirements for patentability. *See* 35 U.S.C. § 2(a)(1). The grant of a patent confers the public franchise – "the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States." *Id.* § 154(a)(1). In this way, the grant of a patent is a matter between "the public, who are the grantors, and . . . the patentee." *U.S. ex rel. Bernardin v. Duell*, 172 U.S. 576, 586 (1899); *see United States v. American Bell Tel. Co.*, 128 U.S. 315, 370 (1888) (explaining that, "by issuing . . . patents," the government "take[s] from the public rights of immense value, and bestow[s] them upon the patentee").

Congress authorized the PTO to take a "second look" at an earlier grant of the public franchise through forms of administrative adjudication such as inter partes review. *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 279 (2016). Concerned about the "diminishment of competition," *Thryv, Inc. v. Click-To-Call Techs., LP*, 590 U.S. 45, 54 (2020), Congress empowered the agency to reconsider the validity of an existing patent and, if appropriate, return the invention to the public domain. As this Court explained in *Cuozzo*, the "basic purpose[]" of inter partes review is to "protect the public's 'paramount interest in seeing that patent monopolies . . . are kept within their legitimate scope.'" 579 U.S. at 279-80 (quoting *Precision Instrument Mfg. Co. v. Automotive Maint. Mach. Co.*, 324 U.S. 806, 816 (1945)) (ellipsis in *Cuozzo*). While the procedure may "resolve concrete patent-related disputes among parties," "the purpose of the proceeding is not quite the same as the purpose of district court litigation," and rather focuses on policing patentees' exercise of their exclusivity rights vis-à-vis the public. *Id.*

This Court upheld the validity of inter partes review in *Oil States*, explaining that "inter partes review involves the same interests as the determination to grant a patent in the first instance." 584 U.S. at 337-38. As the Court explained, patents create "a specific form of property right—a public franchise," which is derived from statute and therefore can "confer only the rights that the statute prescribes." *Id.* at 338 (cleaned up). As a result, Congress may qualify patent rights, including by authorizing administrative re-adjudication of patent validity. *Id.* In upholding the constitutionality of inter partes review, the *Oil States* Court emphasized that the proceeding at issue

"does not make any binding determination regarding 'the liability of [one individual] to [another] under the law as defined,'" but rather "remains a matter involving public rights . . . 'between the government and others.'" *Id.* at 343 (citation omitted).

D. An Expired Patent Loses Its "Public" Character When The Public Franchise Terminates, So Its Owner Is Entitled To Vindicate Any Remaining Private Rights In A Judicial Forum

This Court in *Oil States* addressed only the "public" aspect of patent rights and did not consider whether private rights associated with patents – and retained by holders of an expired patent – may be adjudicated outside of Article III. Indeed, the Court "emphasize[d] the narrowness of [its] holding," which did "not address whether other patent matters, such as infringement actions, can be heard in a non-Article III forum." 584 U.S. at 344.

But the Court's reasoning hinged on the ongoing nature of public patent monopolies and the public's interest in policing those monopolies. As the Court explained, "the decision to grant a patent is a matter involving public rights—specifically, the grant of a public franchise," and "[i]nter partes review is simply a reconsideration of that grant." *Id.* at 334-35. The proper exercise of the public franchise "is a matter between 'the public, who are the grantors, and . . . the patentee.'" *Id.* at 335 (quoting *Duell*, 172 U.S. at 586) (ellipsis in *Oil States*). *Oil States*, then, addressed only the "public" aspect of patent rights – the right to a patent monopoly – and did not address the other rights of patent holders, explicitly reserving "whether other patent matters, such as infringement actions, can be heard in a non-Article III forum." *Id.* at 344.

Consistent with the reasoning of *Oil States* and this Court's "public rights" cases, the PTO's jurisdiction cannot extend to administrative proceedings where the challenged patent has expired and no longer confers the public franchise. When a patent expires, the "public" part of the patent right ceases to exist, and "the right to make or use the article, free from all restriction, passes to the public." *Kimble v. Marvel Ent., LLC*, 576 U.S. 446, 451 (2015) (citing *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 230 (1964)). As such, disputes involving expired patents do not implicate the public's interest in "seeing that patent monopolies are kept within their legitimate scope." *Cuozzo*, 579 U.S. at 279-80 (cleaned up).

Instead, challenges to the validity of expired patents are quintessentially private disputes. Without the public franchise, the owner of an expired patent retains only the limited, but valuable, right to bring infringement actions against private parties for damages. *See Genetics Inst., LLC v. Novartis Vaccines & Diagnostics, Inc.*, 655 F.3d 1291, 1299 (Fed. Cir. 2011); *Root*, 105 U.S. at 216-17 (remedy for infringement of expired patent is "an action at law for the recovery of damages"). In cases where the at-issue patent has expired, the only possible purpose of an administrative adjudication of patent validity would be to extinguish the patentee's actual or potential claims against private parties for past infringement that occurred during the period when the patent indisputably enjoyed exclusive rights.

In those circumstances, the public has no stake in the outcome – at its core, administrative adjudication of an expired patent takes up a dispute between private parties. As this Court recognized in *Cuozzo*, resolving such disputes is not the goal of inter partes

review, which is instead to protect the public. *See* 579 U.S. at 279 ("[T]he purpose of the proceeding is not quite the same as the purpose of district court litigation."). As a result, there is no "connection with the performance of the constitutional functions of the executive or legislative departments" required for a non-Article III forum to adjudicate disputes. *Oil States*, 584 U.S. at 334. The proceeding simply absorbs and displaces the patent holder's right to seek infringement damages in court. Nothing in *Oil States* suggests *that* dispute is subject to adjudication in a non-Article III forum.

E. Neither The History Of The America Invents Act Nor Analogous Intellectual-Property Regimes Support Agency Adjudication Of Expired Patents

Likewise, nothing in the America Invents Act suggests that the PTO should be permitted to aggrandize its jurisdiction to encompass the private rights of patentees to sue for infringement damages when they can no longer exercise the "public" right of a patent monopoly. To the contrary, the legislative history reveals that the purpose of the Act was to better "promote innovation by granting inventors temporally limited monopolies on their inventions in a manner that ultimately benefits the public" and to provide "a more efficient system for challenging patents that should not have issued." H.R. Rep. No. 112-98, pt. 1, 39-40. Congress was concerned about the "diminishment of competition" caused when owners of invalid patents exclude competitors from using inventions and technologies that should be in the public domain. *Thryv*, 590 U.S. at 54.

Expired patents are already in the public domain. And there is no reason to believe that lawsuits brought

by owners of expired patents for past infringement would diminish competition. The infringing party has not been stopped by an injunction through patent exclusivity. Its product also is on the market. Therefore, when the at-issue patent has expired, the need for "efficient" resolution of its validity – the animating purpose behind the creation of the inter partes review process – loses any real force.

Treatment of other intellectual property rights further indicates that the PTAB's authority to invalidate patents should not extend past the life of the patent. Trademarks provide a helpful example: per congressional delegation, the PTO has the authority to register trademarks according to statutory criteria. *See* 15 U.S.C. § 1051; *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 143 (2015). Parties can petition the PTO to expunge or reexamine existing trademarks on the grounds that the trademark holder has not used the trademark or only used the trademark after registration. *See* 15 U.S.C. §§ 1066a (expungement), 1066b (reexamination). Like administrative adjudication of existing patents, the expungement and examination procedures provide a way to cancel trademarks that do not serve the public interest. However, these procedures only apply to currently registered trademarks. *See id.* §§ 1066a(b)(1), 1066b(c)(1). Likewise, the Copyright Office may cancel currently registered copyrights, *see* 37 C.F.R. § 201.7, but will not cancel registrations that have expired, *see* U.S. Copyright Office, Chapter 1800: Post-Registration Procedures, ch. 1807.2 (Jan. 28, 2021), https://www.copyright.gov/comp3/chap1800/ch1800-post-registration.pdf. Thus, the Federal Circuit's decision below would make patents an outlier. *Only* patent rights – the most important and valuable of these intellectual-property

rights – could be extinguished by the government at will even after the expiration of the public franchise.[3]

II. THE QUESTION PRESENTED IS EXCEEDINGLY IMPORTANT

The constitutional violation perpetuated by the administrative re-adjudication of expired patents inherently warrants this Court's review. But this violation is also part of a larger trend of congressional and administrative encroachments upon the Constitution's separation of powers, which have claimed increasing authority for an administrative bureaucracy unaccountable to the electorate or the Executive. In recent Terms, this Court has rightly prioritized guarding against those encroachments. *See*, *e.g.*, *Jarkesy*, 603 U.S. at 124-25 (holding that Seventh Amendment prevents SEC from imposing civil penalties for securities

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[3] Outside the intellectual-property context, other species of property are "public rights" when granted by the government but eventually transform into "private rights" that cannot be dispossessed without judicial process. Perhaps the most salient example is grants of American public lands. In the 1800s, Congress established "land offices" within the Executive Branch that applied statutory criteria for disposition of federal land to private citizens. *See* Caleb Nelson, *Adjudication in the Political Branches*, 107 Colum. L. Rev. 559, 577-78 (2007). The offices were considered to exercise executive, not judicial, power in conveying land grants. *See Lewis v. Lewis*, 9 Mo. 183, 188 (1845). However, "[o]nce private individuals could claim vested rights in the land . . . the executive branch's authority to act conclusively ran out," and "the government had to go to court to establish the grounds for cancellation; because claims of core private rights now hung in the balance." Nelson, 107 Colum. L. Rev. at 578. As this Court recognized, the cancellation of a land patent "is a judicial act[] and requires the judgment of a court." *United States v. Stone*, 69 U.S. (2 Wall.) 525, 535 (1865); *see Johnson v. Towsley*, 80 U.S. (13 Wall.) 72, 83-87 (1871) (referring to courts' role "after the title had passed from the government, and the question became one of private right").

fraud without a jury trial); *West Virginia v. EPA*, 597 U.S. 697, 732-35 (2022) (rejecting EPA's attempt to impose generation-shifting requirements under the major questions doctrine); *United States v. Arthrex, Inc.*, 594 U.S. 1, 23 (2021) (holding that the unreviewable authority wielded by PTAB's administrative patent judges during inter partes review proceedings is incompatible with their appointment by the Secretary of Commerce under the Appointments Clause).

But unlike other recent cases involving separation of powers and the administrative state, this case presents an even stronger candidate for review because the PTO has encroached on the traditional authority of the federal judiciary. By allowing administrative adjudication of expired patents, the Federal Circuit has permitted the putatively innocuous "second look at an earlier administrative grant of a patent," *Cuozzo*, 579 U.S. at 279, to transform into an administrative option to relitigate and revoke this species of private property at any point in time. That effectively transfers judicial power over patent cases to the PTO wholesale, as the most consequential aspect of patent litigation – an authoritative judgment on the validity of the patent – now rests with the PTO in all cases. Only the Supreme Court can countermand this incursion on the judiciary's rightful Article III domain.

And if the institutional victim of this decision is the federal judiciary, the real-world victim is the small patent holder like Gesture whose rights the judiciary exists to vindicate. For these small businesses, a patent is often the company's most valuable asset. These inventors rely on the federal judiciary to protect the property rights inherent in that patent and enforce

them against large infringers who otherwise would profiteer off the labors of others.[4]

Without an independent judicial forum to enforce those rights, small patent holders are relegated to an administrative quagmire where well-heeled corporations like Apple and their armies of lobbyists can navigate the halls of power and bring influence to bear. Meanwhile, the Gestures of the world can only hope that some portion of their livelihood will survive in the aftermath. In short, if the Court declines review here, the decision below will only take us "another step down the road of ceding core judicial powers to agency officials and leaving the disposition of private rights and liberties to bureaucratic mercy." *Thryv*, 590 U.S. at 62. The Founders did not envision that system, and this Court should not allow Congress and the PTO to create it unchecked.

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[4] The need for an Article III forum to adjudicate disputes over expired patents is not merely symbolic or abstract, but comes from concrete differences between how these disputes play out in the courts versus in administrative tribunals. For example, in Article III litigation, issued patents are presumed valid, *see* 35 U.S.C. § 282(a), and an invalidity defense in an Article III court must be proved by clear and convincing evidence, *see Microsoft Corp. v. i4i Ltd. P'ship*, 564 U.S. 91, 95 (2011). By contrast, the standard of proof in PTAB proceedings is "preponderance of the evidence." 35 U.S.C. § 316(e); *see In re Swanson*, 540 F.3d 1368, 1377 (Fed. Cir. 2008). In PTAB review proceedings over an unexpired patent, the patent holder, although disadvantaged by the standard of proof, can amend its patent claims to retain validity. But holders of an expired patent are not afforded that flexibility. If the PTAB finds, by only a preponderance of the evidence, that their claims are invalid, they are cancelled outright.

III. THE COURT SHOULD CORRECT THE FEDERAL CIRCUIT'S EXCESSIVE DEFERENCE TO THE PTO'S ADMINISTRATIVE AUTHORITY

The Federal Circuit's role in facilitating these developments provides an independent reason for this Court's review. Since the passage of the America Invents Act, the Federal Circuit has zealously embraced the PTO's administrative adjudication authorities and has done little to police their constitutional boundaries. These cases are the latest in a line of Federal Circuit decisions swatting down constitutional challenges to the inter partes review framework in particular and greenlighting increased administrative review.

Indeed, while the decisions below are the first to hold expressly that the PTAB may conduct administrative adjudication proceedings regarding expired patents, multiple Federal Circuit decisions have "previously reviewed [inter partes] decisions involving expired patents, implicitly assuming that the [PTAB] had jurisdiction in such cases." App. 4a-5a. *See*, *e.g.*, *Axonics, Inc. v. Medtronic*, Inc., 75 F.4th 1374, 1382 n.8 (Fed. Cir. 2023); *Immunex Corp. v. Sanofi-Aventis U.S. LLC*, 977 F.3d 1212, 1217 (Fed. Cir. 2020); *Wasica Fin. GmbH v. Cont'l Auto. Sys., Inc.*, 853 F.3d 1272, 1279 (Fed. Cir. 2017). That the Federal Circuit would bless these novel proceedings without analysis into the administrative encroachment on constitutional judicial powers speaks to the lightness of the constitutional scrutiny being applied.

Since this Court's decision in *Oil States*, the Federal Circuit has shown increasingly little patience for constitutional challenges to the PTAB's administrative jurisdiction. Recent Federal Circuit decisions have held that: inter partes review proceedings can be

constitutionally applied to patents issued prior to the passage of the America Invents Act, *see Collabo Innovations, Inc. v. Sony Corp.*, 778 F. App'x 954, 961 (Fed. Cir. 2019); cancellation of patent claims in inter partes review proceedings cannot constitute an unconstitutional taking under the Fifth Amendment, *see Golden v. United States*, 955 F.3d 981, 989 (Fed. Cir. 2020); and a finding of unpatentability in inter partes review proceedings has issue-preclusive effect in parallel federal-court proceedings, even where the district court already has entered final judgment to the contrary, *see XY, LLC v. Trans Ova Genetics, L.C.*, 890 F.3d 1282, 1294 (Fed. Cir. 2018). Whatever the merits of these decisions on the specific questions presented therein, they demonstrate an unmistakable pattern of a court of appeals unable or unwilling to enforce meaningful constitutional limitations on the PTO's newfound statutory authorities.

That pattern further necessitates this Court's intervention. Absent certiorari review, the PTAB will continue to aggrandize its own jurisdiction, the Federal Circuit will continue to bless those expansions, and the judiciary's Article III domain will shrink by equal measures. In a recent era of this Court's jurisprudence, repeated interventions were required to bring the Federal Circuit's patent-law decisions into line with this Court's interpretive methodologies and case law. *See*, *e.g.*, *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 739 (2002) (Federal Circuit "ignored the guidance" of most on-point Supreme Court precedent); *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 415-16 (2007) (Court "reject[ed] the rigid approach of the [Federal Circuit]" and redirected it to "earlier instructions" from Supreme Court precedents "over a half century" old); *see also Laboratory Corp. of Am. Holdings v. Metabolite Lab'ys, Inc.*, 548 U.S. 124, 138 (2006) (Breyer, J., dissenting)

(suggesting that "a decision from this generalist Court" could help bring better balance to U.S. patent law). A similar challenge now presents itself, this time with constitutional dimensions. When it comes to the constitutional limitations on the PTO's administrative proceedings, it is becoming increasingly difficult to escape the conclusion that the Federal Circuit alone wields the power to say, "I don't like the Supreme Court [precedents] so I'm not going to apply [them]." Oral Arg. Tr. 18:11-12, *Carlsbad Tech., Inc. v. HIF Bio, Inc.*, 556 U.S. 635 (2009) (No. 07-1437, Feb. 24, 2009) (Roberts, C.J.).

IV. THIS CASE IS AN IDEAL VEHICLE TO RESOLVE THE QUESTION PRESENTED

This petition presents a pure issue of constitutional interpretation in an ideal posture for Supreme Court resolution. The issue was fully preserved and squarely presented to both the PTAB and the Federal Circuit, and both tribunals addressed it directly (albeit incorrectly). Reversal on this issue would require dismissal of the various administrative proceedings and would allow Gesture to resume pursuit of its infringement claims in federal court. No threshold issues will prevent this Court from reaching the issue or Gesture from benefiting from a favorable ruling on remand.

The time for this Court's review is now. Further percolation will yield no benefit. The Federal Circuit has exclusive jurisdiction over appeals from inter partes review and ex parte reexamination proceedings, *see* 35 U.S.C. § 141, so no other court of appeals can or will weigh in. This Court often grants certiorari even in the absence of a circuit conflict when the Federal Circuit has exclusive jurisdiction, and it has done so on multiple occasions in recent Terms. *See*, *e.g.*, *Rudisill v. McDonough*, 601 U.S. 294 (2024)

(No. 22-888); *Amgen Inc. v. Sanofi*, 598 U.S. 594 (2023) (No. 21-757); *Arellano v. McDonough*, 598 U.S. 1 (2023) (No. 21-432); *George v. McDonough*, 596 U.S. 740 (2022) (No. 21-234).

Given the Federal Circuit's exclusive jurisdiction, the decisions below will govern all cases presenting this issue going forward. And they represent a massive expansion of the PTO's jurisdiction, carved directly out of the federal judiciary's Article III domain, with acute prejudice to small property holders like Gesture that are deprived of the independent judicial forum that properly exists to secure their rights.

CONCLUSION

The Court should grant the petition for a writ of certiorari.

Respectfully submitted,

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June 11, 2025