

2016-1794

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

NANTKWEST, INC.,

Plaintiff-Appellee,

v.

JOSEPH MATAL, Performing the Functions and Duties of
the Under Secretary of Commerce for Intellectual Property and
Director, U.S. Patent and Trademark Office,

Defendant-Appellant.

*Appeal from the United States District Court for the Eastern District of
Virginia in No. 1:13-cv-01566-GBL-TCB, Judge Gerald Bruce Lee.*

**CORRECTED BRIEF OF INTELLECTUAL PROPERTY
OWNERS ASSOCIATION AS AMICUS CURIAE IN
SUPPORT OF PLAINTIFF-APPELLEE**

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January 17, 2018

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

NantKwest, Inc.

v.

Matal,

Case No. 2016-1794

CERTIFICATE OF INTEREST

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(petitioner) (appellant) (respondent) (appellee) (amicus)
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Intellectual Property Owners Association

certifies the following (use “None” if applicable; use extra sheets if necessary):

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Intellectual Property Owners Association	Intellectual Property Owners Association	None

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court (**and who have not or will not enter an appearance in this case**) are:

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5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court’s decision in the pending appeal. See Fed. Cir. R. 47. 4(a)(5) and 47.5(b).

None

<p align="center"><u>January 16, 2018</u> Date</p>	<p align="center"><u>/s/ Gregory A. Castanias</u> Signature of counsel</p>
<p>Please Note: All questions must be answered</p>	<p align="center"><u>Gregory A. Castanias</u> Printed name of counsel</p>
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Intellectual Property Owners Association (“IPO”) submits this brief as an *amicus curiae* pursuant to Federal Rule of Appellate Procedure 29, Federal Circuit Rule 29, and the Court’s Order dated August 31, 2017, authorizing *amicus* briefs in this case. This brief supports NantKwest, Inc.’s position.

INTEREST OF AMICUS CURIAE

IPO is a trade association representing companies and individuals in all industries and fields of technology that own or are interested in intellectual-property rights.¹ IPO’s membership includes nearly 200 companies and more than 10,000 individuals who are involved in the association either through their companies or as an inventor, author, executive, law firm, or attorney member. IPO regularly represents the interests of its members before Congress and the United States Patent and Trademark Office (the “Patent Office”) and has filed *amicus curiae* briefs in this Court and other courts on significant issues of intellectual-property law. The members of IPO’s Board of Directors, which approved the filing of this brief, are listed in the Appendix.²

¹ No counsel for a party authored this brief in whole or in part, and no counsel for a party made a monetary contribution intended to fund the preparation or submission of this brief. IPO files this brief in accordance with the Order issued on August 31, 2017, which states that briefs may be filed without consent or leave of the Court.

² IPO procedures require approval of positions in briefs by a two-thirds

Many of IPO's members, individual inventors and corporations alike, are involved in obtaining patents in the normal course of their businesses. Adopting the view of the now-vacated panel decision in *Nantkwest, Inc. v. Matal*, 860 F.3d 1352 (Fed. Cir.), *reh'g en banc granted, opinion vacated*, 869 F.3d 1327 (Fed. Cir. 2017), will expose individual inventors and corporations to uncertain and potentially crushing attorneys' fees should they exercise their statutory right to seek district-court relief under 35 U.S.C. § 145 and chill their opportunity to seek *de novo* review in the district courts from adverse patentability decisions by the Patent Office.

majority of directors present and voting.

SUMMARY OF THE ARGUMENT

Section 145’s final sentence, providing that “[a]ll the expenses of the proceedings shall be paid by the applicant” in civil actions to obtain a patent, does not provide the “explicit statutory authority” needed to overcome “the bedrock principle known as the American Rule: Each litigant pays his own attorney’s fees, win or lose.” *Baker Botts LLP v. ASARCO LLC*, 135 S. Ct. 2158, 2164 (2015). In 1839, when the predecessor statute to 35 U.S.C. § 145 was enacted, and continuing to this day, “expenses” of litigation proceedings have been generally understood as distinct from “attorneys’ fees.” Consistent with this understanding, when Congress wishes to allow for fee shifting, it does so clearly, by calling out “attorneys’ fees” explicitly, and in a manner typically separate from “expenses.” Moreover, even when Congress intends to view attorneys’ fees as a component of “expenses,” Congress explicitly calls out “attorneys’ fees” as a component of such expenses. Section 145 contains no reference whatsoever to “attorneys’ fees” or anything equally clear; Congress did not silently intend such fees to be shifted as part of “the expenses of the proceeding.”

For 174 years, this was the Patent Office’s uniform practice and understanding. But in 2013, that Office adopted what it admits is a “novel,” and aggressive, interpretation of section 145’s final sentence. This late-coming interpretation is wrong as a legal matter and threatens to impose a serious financial

burden upon patent applicants. In many cases, particularly for individual inventors and small- and micro-entities, the burden can be crippling: These inventors and entities would not only have to pay for their own counsel, but, under the Patent Office's interpretation, they would have to pay for the government's defense as well just to gain access to the federal district courts—even where the Patent Office's decisions are found to be wrong. Requiring the payment of the Patent Office's attorney's fees will also chill the rights of such inventors to seek *de novo* review in district court. The statutory language, history, common sense, and good patent policy all compel rejection of the Patent Office's interpretation of section 145.

ARGUMENT

I. “ALL THE EXPENSES OF THE PROCEEDINGS,” AS USED IN SECTION 145 OF THE PATENT ACT, DOES NOT INCLUDE ATTORNEYS' FEES

The American Rule's presumption that litigants pay their own attorneys' fees applies and is not overcome by section 145.

A. “The Bedrock Principle Known As The American Rule” Applies

The “basic point of reference when considering the award of attorney's fees is the bedrock principle known as the American Rule: Each litigant pays his own attorney's fees, win or lose, unless a statute or contract provides otherwise.”

Baker Botts, 135 S. Ct. at 2164 (quoting *Hardt v. Reliance Standard Life Ins. Co.*,

560 U.S. 242, 252-53 (2010)). The Supreme Court has “recognized departures from the American Rule only in ‘specific and explicit provisions for the allowance of attorneys’ fees under selected statutes.’” *Id.* (quoting *Alyeska Pipeline Serv. Co. v. Wilderness Soc’y*, 421 U.S. 240, 260 (1975)). Statutes that depart from the American Rule “tend to authorize the award of ‘a reasonable attorney’s fee,’ ‘fees,’ or ‘litigation costs,’ and usually refer to a ‘prevailing party’ in the context of an adversarial ‘action.’” *Id.* The Patent Act is no exception. *See Octane Fitness, LLC v. ICON Health & Fitness, Inc.*, 134 S. Ct. 1749, 1753 (2014) (“Prior to 1946, the Patent Act did not authorize the awarding of attorney’s fees to the prevailing party in patent litigation. Rather, the ‘American Rule’ governed.”).

The vacated panel decision here expressed “substantial doubts” whether section 145 even implicates the American Rule, because there is “no reference to prevailing parties.” *Nantkwest*, 860 F.3d at 1355 (citing *Shammas v. Focarino*, 784 F.3d 219, 223 (4th Cir. 2015)). The Patent Office likewise makes much of the fact that section 145 applies independent of a prevailing party. *See Br. for Appellant on Rehearing En Banc at 30-37, NantKwest, Inc. v. Matal*, No. 16-1794 (Fed. Cir. Nov. 15, 2017) (“Patent Office Br.”).

That logic is exactly backwards. Supreme Court precedent both before and after *Shammas* (Apr. 23, 2015) is clear that the presumption of the American Rule is only *stronger* where the award of fees would be independent of prevailing-party

status. In *Ruckelshaus v. Sierra Club*, the Supreme Court explained that “when Congress has chosen to depart from the American rule by statute, *virtually every one* of the more than 150 existing federal fee-shifting provisions predicates fee awards on some success by the claimant.” 463 U.S. 680, 684 (1983) (emphasis added). The Solicitor General in that case declared that his office “ha[d] not found” any case to the contrary and noted that Congress rejected a proposal to allow for such fees in the Equal Access for Justice Act, because it was “‘radical’ and ‘unacceptable.’” Br. for Petitioner, *Ruckelshaus v. Sierra Club*, 463 U.S. 680 (1983) (No. 82-242), 1982 U.S. S. Ct. Briefs LEXIS 920, at *24; *id.* at n.6 (quoting *Equal Access to Courts: Hearing on S. 2354 Before the Senate Subcomm. on Improvements in Judicial Machinery of the Comm. on the Judiciary, 95th Cong., 2d Sess.* 31 (1978)). *Baker Botts* similarly explained that statutes that depart from the American Rule “usually refer to a ‘prevailing party.’” 135 S. Ct. at 2164 (June 15, 2015). As a consequence, it would be “particularly unusual” to conclude, as the Patent Office suggests here, that it should be compensated for attorneys’ fees for an “*unsuccessful* defense.” *Id.* at 2166.

In trying to shore up its position, the Patent Office describes the American Rule as providing that “‘the prevailing litigant is ordinarily not entitled to collect a reasonable attorneys’ fee from the loser.’” Patent Office Br. at 30-31 (quoting *Alyeska*, 421 U.S. at 247). The Patent Office interprets this to mean that the

American Rule’s presumption against attorneys’ fees is limited to statutes that depend on a “loser.” *Id.* But that is incorrect: *Alyeska* presented an *application* of what the American Rule prohibits, but it never suggested that the American Rule is *limited* to fee shifting from the loser. The Supreme Court has been clear and consistent in holding that the American Rule simply means this—no fee shifting. Under the ““American Rule: Each litigant pays his own attorney’s fees, win or lose, unless a statute or contract provides otherwise.”” *Baker Botts*, 135 S. Ct. at 2164 (quoting *Hardt*, 560 U.S. at 243). That definition does not depend on a losing party. Any shifting of attorneys’ fees, whether premised on success or not, is in derogation of the presumption created by the American Rule that “[e]ach litigant pays his own attorney’s fees.”

B. Section 145 Does Not Provide The “Explicit Statutory Authority” Required To Deviate From The American Rule

The American Rule can be overcome only with “explicit statutory authority.” *Baker Botts*, 135 S. Ct. at 2164. Section 145 is not that. Its last sentence contains only an oblique reference to “all the expenses of the proceeding,” a phrase that is at best ambiguous as to attorneys’ fees. The sentence’s further limitation to “expenses of the proceeding” makes it outright clear that attorneys’ fees are not to be shifted under this section.

1. “Expenses” Is At Best Ambiguous As To Attorneys’ Fees

In the first half of the nineteenth century, when the 1839 predecessor to section 145 was first enacted, American courts and litigants alike commonly spoke of “expenses” as being separate from “attorneys’ fees.” See *Morris v. Way*, 1847 WL 65, at *1 (Ohio Dec. 1847) (referring to a statement of accounts that listed “attorney’s fees and expenses”); *Hayden v. Sample*, 10 Mo. 215, 221 (1846) (defendant asking that the jury be instructed to ignore the testimony regarding “the expenses incurred . . . and the fees paid counsel and attorneys”); *Anderson v. Farns*, 7 Blackf. 343, 343 (Ind. 1845) (citing the party’s request for indemnity from all “attorney’s fees, and expenses”); *State v. Williams*, 1844 WL 53, at *2 (Ohio Dec. 1844) (providing that trustees had the authority to settle “the expense of prosecuting suits, attorney’s fees, etc.”); *Bishop v. Day*, 13 Vt. 81, 83 (1841) (referencing a contract that required that one party “fully indemnify and save harmless the said Benjamin from any costs, lawyers’ fees, and expenses he may have been at in the business aforesaid”); *Overton v. Overton’s Adm’r*, 10 La. 472, 473 (1836) (noting that the defendant claimed damages of “eight hundred dollars damages, for attorneys’ fees, by this proceeding, and one hundred dollars for costs and expenses”); *Hickman v. Quinn*, 14 Tenn. 96, 107 n.1 (1834) (noting that defendants had deducted “their expenses, attorney’s fees, etc.”).

That understanding continues to this day, where courts regularly hold that “[t]he terms ‘costs’ or ‘expenses’ when used in a statute do not ordinarily include attorney’s fees.” *Ark. Dep’t of Human Servs., Div. of Econ. & Med. Servs. v. Kistler*, 320 Ark. 501, 509 (1995); *see Tracy v. T & B Constr. Co.*, 182 N.W.2d 320, 322 (S.D. 1970) (“Ordinarily the terms ‘costs’ and ‘expenses’ as used in a statute are not understood to include attorney’s fees.” (citations omitted)); *accord McAdam v. Dean Witter Reynolds, Inc.*, 896 F.2d 750, 774 (3d Cir. 1990); *Wolf v. Mut. Ben. Health & Accident Ass’n*, 188 Kan. 694, 700 (1961); *Prudential Ins. Co. of Am. v. Goldsmith*, 239 Mo. App. 188, 197 (1945); *Hardware Mut. Cas. Co. v. Butler*, 116 Mont. 73 (1944); *Hayman v. Morris*, 37 N.Y.S.2d 884, 891 (Sup. Ct. 1942).

Congress, too, understands that “expenses” do not include attorneys’ fees. When Congress wishes to award attorneys’ fees, it does so expressly—using the words “attorneys’ fees.” There are at least eight instances in title 12 of the United States Code alone where Congress allows “reasonable expenses and attorneys’ fees” (with “attorneys’ fees” expressly listed separately). *See* 12 U.S.C. §§ 1464(d)(1)(B)(vii); 1786(p); 1818(n); 1844(f); 2273; 3108(b)(5); 4588(d); 4641(d). Other titles of the Code disclose similar usage. *See, e.g.*, 11 U.S.C. § 363(n) (a trustee may recover certain “costs, attorneys’ fees, or expenses”); 15 U.S.C. § 77z-1(a)(6) (restricting “attorneys’ fees and expenses” in certain class-

action securities litigations). Likewise, when the Patent Act wishes to allow “attorneys’ fees,” it provides for them explicitly. *See* 35 U.S.C. §§ 271(e)(4); 273(f); 285; 296(b); 297(b)(1); *see also* 15 U.S.C. § 1117(a)(3) (allowing “attorney fees” in exceptional trademark cases).

To be sure, some statutes define “expenses” as including attorneys’ fees, but they do so explicitly, by using the phrase “attorneys’ fees.” *See, e.g.*, 12 U.S.C. § 5005(b)(2) (allowing “interest and expenses (including costs and reasonable attorney’s fees and other expenses of representation)”); 12 U.S.C. § 5009(a)(1)(B) (same). This is true even for statutes that use the inclusive “all expenses,” such as 50 U.S.C. § 4531(b)(4) (requiring reimbursement “for all expenses . . . including . . . attorneys’ fees and expenses of litigation”). “These statutes confirm that Congress knows how to” award attorneys’ fees “when it so desires,” *Marx v. Gen. Revenue Corp.*, 568 U.S. 371, 384 (2013), and confirms that Congress did not see the word “expenses,” standing on its own—or even preceded by the inclusive “all”—as unambiguously including attorneys’ fees. Thus, the word “expenses” and the phrase “all the expenses,” on their own, are not the “specific and explicit provisio[n]” required to depart from the American Rule. *Baker Botts*, 135 S. Ct. at 2161 (quoting *Alyeska*, 421 U.S. at 260).

The Patent Office ignores the need for specific and explicit provisions, and argues that the fact that Congress sometimes expressly provides for “expenses,

including attorneys' fees . . . establish[es] that the term 'expenses' includes attorney's fees." Patent Office Br. at 18. That is exactly the wrong inference to draw. Rather, those statutes demonstrate that when Congress wishes to shift attorneys' fees, it either lists them as separate from "expenses," or, at least, expressly defines "expenses" as "including attorneys' fees."

Moreover, by the Patent Office's logic, "costs" would also include attorneys' fees, as there are no fewer than 63 different statutes that refer to "attorney's fees" as "costs." *Marek*, 473 U.S. at 44-48 (Brennan, J., dissenting) (cataloguing statutes). Yet, even the Patent Office concedes that the unelaborated term "costs" does not encompass attorneys' fees. Patent Office Br. at 17.

For similar reasons, the Patent Office places too much weight on the 1836 Patent Act's provision requiring that patent-application fees be paid into a "patent fund" to pay "'expenses of the Patent Office,' including 'the salaries of the officers and clerks herein provided for.'" Patent Office Br. at 27 (quoting Act of July 4, 1836, 5 Stat. 117, 121 § 9). That broad usage of the word "expenses," in a statute making no reference to litigation or fee shifting—and thus not implicating the strong presumption of the American Rule—simply confirms that the word "expenses," on its own, "is broad enough to encompass" attorneys' fees, but it "does not establish that the word is *ordinarily* understood in that sense."

Taniguchi v. Kan Pac. Saipan, Ltd., 566 U.S. 560, 568 (2012) (emphasis in

original). Where attorneys' fee shifting is sought, a clearer and more definitive statement than simply "expenses" is required to derogate from the American Rule.

The sources introduced by the Patent Office similarly do not aid its cause. In terms of treatises, the Patent Office cites 10 CHARLES ALAN WRIGHT ET AL., FEDERAL PRACTICE AND PROCEDURE § 2666 (3d ed. 1998) ("WRIGHT"), BLACK'S LAW DICTIONARY 698 (10th ed. 2014) ("BLACK'S 10TH EDITION"), and NOAH WEBSTER, AMERICAN DICTIONARY OF THE ENGLISH LANGUAGE (1st ed. 1828) ("WEBSTER"). Patent Office Br. at 17. WEBSTER is not a legal dictionary at all, and the other two references are not even close to contemporaneous with the 1839 enactment of the original provision allowing "expenses." And all three suffer from the inherent limitation of a dictionary definition—the absence of statutory context. Although "expenses," standing alone, might include "expenditures of money, time, labor, or resources," as the Patent Office argues, when it is used in the context of litigation, it refers to something quite different than attorneys' fees—particularly when the background expectation of the American Rule establishes that attorneys' fees are not ordinarily shifted.

There are, fortunately, dictionaries that provide more contextual definitions. The First Edition of Black's Law Dictionary, published in 1891—which is at least closer to contemporaneous with the statute—defines "*Expensæ Litis*" (literally, "expenses of litigation," which is similar to section 145's "expenses of the

proceeding”) as “Costs or expenses of the suit, which are generally allowed to the successful party.” BLACK’S LAW DICTIONARY 461 (1st ed. 1891) (“BLACK’S 1ST EDITION”). James Whishaw’s 1829 dictionary, which is even more contemporaneous with the 1839 statute, likewise translates “*Expensæ Litis*” as “costs of suit allowed a plaintiff or defendant recovering in his action.” JAMES WHISHAW, A NEW LAW DICTIONARY 14 (1829). BLACK’S 1ST EDITION and WHISHAW’s “generally allowed” costs do not include attorneys’ fees. *See Baker Botts*, 135 S. Ct. at 2164 (explaining that the presumption against fee shifting “reach[es] back to at least the 18th century”).

2. Attorneys’ Fees Are Not Expenses “Of The Proceeding”

Any lingering doubt about section 145’s interpretation is quickly removed by the sentence’s further requirement that expenses be limited to those “of the proceeding.” By its terms, section 145 only applies to variable expenses that exist because “of the proceeding.” That has been understood as including “[r]easonable printing expenses,” and “traveling expenses.” *See Cook v. Watson*, 208 F.2d 529, 531 (D.C. Cir. 1953); *Robertson v. Cooper*, 46 F.2d 766, 769 (4th Cir. 1931). But for “the proceeding,” those expenses would not exist. By contrast, the attorneys’ fees or the prorated salaries of the Patent Office’s attorneys are not “of the proceeding.” The Patent Office pays its attorneys the same salary whether the attorneys work on this case, another case, or no case at all. The salaries are fixed.

The Patent Office makes much of the inclusive word “all,” in section 145. *See* Patent Office Br. at 15, 40-41. But “all” is no help to the Patent Office unless “expenses of the proceeding” includes attorneys’ fees in the first place. Attorneys’ fees and prorated salaries are not. In any event, as noted above, even Congress understands that “all expenses”—with no reference to “of the proceeding”—needs further clarification to include attorneys’ fees. *See* 50 U.S.C. § 4531(b)(4).

3. Historically, Section 145 Has Been Understood As Not Allowing Attorneys’ Fees

The Patent Office has been authorized to collect its “expenses” in district-court patent cases since 1839, and in district-court trademark cases since at least 1905. *See* 5 Stat. 353-355 § 2 (1839); *Am. Steel Foundries v. Robertson*, 262 U.S. 209 (1923) (holding that the Trademark Act of 1905, 33 Stat. 724, 727, allowed disappointed trademark applicants to seek district court relief under the same conditions as patent applicants); *see also* 15 U.S.C. § 1071 (1946) (providing that disappointed trademark applicants could rely on proceedings similar to those permitted in patent cases).

Yet, it was only in 2013 that the Patent Office first suggested that either of these “expenses” provisions allows attorneys’ fees. *See* Defendant’s Motion for Fees & Expenses, *Shammas v. Focarino*, 990 F. Supp. 2d 587 (E.D. Va. 2014) (No. 1:12-cv-1462), ECF No. 44 (Nov. 11, 2013). As the Patent Office effectively

concedes, for the previous *174 years* it had never sought attorneys' fees under statutes that, it now argues, allowed for them. *See* Patent Office Br. at 29-30 (accepting that the position it espouses is "novel" and based on "recent efforts"); Br. for Appellee at 25, *Shammas v. Focarino*, 784 F.3d 219 (4th Cir. 2015) (No 14-1191), 2014 WL 3728930, at *25 (Patent Office noting that its request for attorneys' fees in the trademark analog to section 145 created "a case of first impression" reflecting its "recent efforts" to recover personnel expenses). The Patent Office's *earlier* understanding is consistent with the fact that even the cases the Patent Office relies on to prove that the expense-shifting can be "harsh" awarded only classic expenses—not attorneys' fees. *See* Patent Office Br. at 26. *Cook* awarded "printing expenses," 208 F.2d at 531-32, and *Robertson* awarded "traveling expenses." 46 F.2d at 769. The Patent Office's *earlier* understanding is consistent with Justice Brennan's cataloguing of 119 statutes that allow attorneys' fees—none of which were section 145. *See Marek v. Chesny*, 473 U.S. 1, 44-51 (1985) (Brennan, J., dissenting). And the Patent Office's *earlier* understanding is consistent with the bar's understanding that "that the recovery of expenses afforded to the USPTO under [the trademark analogue to section 145] related to third-party costs, such as travel expenses or the cost of an expert," not to "salary or other fixed operating costs of the USPTO." Ralph G. Fischer, *Supporting Trademark Claims Up Front Is Less Expensive and Risky Than Later Appeal*, RECENT TRENDS IN

TRADEMARK PROTECTION, 2015 ED., 2015 WL 2407520, at *7. Here, as in so many cases, “a page of history is worth a volume of logic.” *New York Tr. Co. v. Eisner*, 256 U.S. 345, 349 (1921) (Holmes, J.).

C. Both The Doctrine Of Constitutional Avoidance And Basic Notions Of Fairness Preclude The Patent Office From Receiving Attorneys’ Fees

Section 145 proceedings are generally the only way that applicants can access a federal district court and introduce live testimony in support of their efforts to obtain a United States patent. *See Hyatt*, 566 U.S. at 435 (“the PTO generally does not accept oral testimony”). The importance of *live* testimony to the judicial process cannot be gainsaid. In criminal cases, the right to “live testimony” is protected by the Sixth Amendment, “because of the importance of cross-examination, the greatest legal engine ever invented for the discovery of truth.” *White v. Illinois*, 502 U.S. 346, 356 (1992) (citations omitted). In civil cases too, “[i]n almost every setting where important decisions turn on questions of fact, due process requires an opportunity to confront and cross-examine adverse witnesses.” *Goldberg v. Kelly*, 397 U.S. 254, 269 (1970). Written submissions can be inadequate, the Supreme Court has explained, because they “do not afford the flexibility of oral presentations; they do not permit the recipient to mold his argument to the issues the decision maker appears to regard as important.” *Id.* at 269; *see Oshodi v. Holder*, 729 F.3d 883, 896 (9th Cir. 2013) (en banc) (“*Mathews*

[*v. Eldridge*, 424 U.S. 319 (1976),] teaches us that cases that hinge on credibility are precisely the types of cases where the probable value of oral testimony is high and the lack of oral testimony significantly raises the risk of an erroneous decision.”). Though this Court has never ruled on the question of whether patent applicants have a constitutional right to have experts provide oral testimony, the D.C. Circuit has suggested that it would be case-dependent. *See Cogar v. Schuyler*, 464 F.2d 747, 755 (D.C. Cir. 1972) (“[I]t is our opinion that this case is not one in which a personal interview with the Examiner or other oral hearing was necessary as an element of due process.”). Certainly, the right to an oral hearing is “significant.” *Hyatt*, 566 U.S. at 435.

In light of the importance of oral testimony, the Patent Office’s “general” reluctance to “accept oral testimony,” *id.*; *see* 37 C.F.R. § 1.2, would raise Constitutional concerns but for section 145. That provision allows dissatisfied applicants to introduce live testimony in district court, and the district court then makes *de novo* findings. *Hyatt*, 566 U.S. at 435.

The Patent Office’s interpretation of section 145, however, would make such proceedings an “unrealistic option” for most applicants, which does not suffice. *Goldberg*, 397 U.S. at 269. In this case, for example, the Patent Office is asking for \$78,592.50 in attorneys and paralegals’ fees, which would nearly triple the applicant’s expenditure on the Patent Office’s fees. *See* Appx080 (Patent Office

requesting \$33,103.89 in other expenses); Appx084 (Patent Office requesting \$78,592.50 in attorneys and paralegals' fees). In the few other reported patent cases, the Patent Office has likewise asked for large sums. *See Realvirt, LLC v. Lee*, 220 F. Supp. 3d 704, 705 (E.D. Va. 2016) (\$48,454.62 in attorneys' fees); Patent Office Memorandum of Law at 4 n.2, *Taylor v. Matal*, No. 1:15-cv-1607 (E.D. Va. Sept. 22, 2017), ECF 104 (Patent Office requesting \$80,827.92 based on attorney time). The applicant would have to pay these fees "regardless of the outcome." *Hyatt v. Kappos*, 625 F.3d 1320, 1337 (Fed. Cir. 2010) (en banc), *aff'd and remanded*, 566 U.S. 431 (2012). This will deter applicants from seeking district court review of the patent Office's decisions, the only opportunity that applicants have to present live evidence (expert testimony, demonstrations, or fact witness testimony) and get a *de novo* review of their case, because they will have to pay such large fees no matter the outcome.

Effectively, the Patent Office is precluding access to federal district court, and the oral presentation of key patentability evidence, for anyone that cannot afford to pay potentially hundreds of thousands of dollars: The Patent Office does not allow expert testimony, demonstrations, or fact-witness testimony in its own proceedings and demands attorneys' fees that are prohibitively high (at least for individual inventors and smaller corporations) in section 145 proceedings.

Interpreting section 145 to allow the Patent Office to effectively block an

applicant's right to introduce such evidence in person is not only unfair to applicants, it also "raise[s] serious constitutional doubts. It is therefore incumbent upon [courts] to read the statute to eliminate those doubts so long as such a reading is not plainly contrary to the intent of Congress." *United States v. X-Citement Video, Inc.*, 513 U.S. 64, 78 (1994).

The Patent Office seeks to downplay the significance of these fees by describing section 145 as "an extension of the *ex parte* patent application process" and its attorneys' fees as "a direct counterpart to the application fees that are designed to defray the PTO's examination expenses." Patent Office Br. at 33, 34. The failure of this analogy is telling.

Congress has ensured that the *ex parte* application process is affordable, tailoring reduced prices for small- and micro-entities. *See* 35 U.S.C. §§ 41(h), 123. An independent inventor who qualifies as a micro-entity pays \$70.00 for filing; \$150.00 for a utility search; and \$180.00 for an examination. If the applicant is dissatisfied with the result, she can appeal to the Board for an additional \$200. Total, \$600. (The total standard fee would be \$2,400.) *USPTO Fee Schedule*, <https://goo.gl/ELTn39> (last visited Oct. 23, 2017). If the applicant is still dissatisfied, she can appeal to this Court for an additional \$500, without having to compensate the Patent Office for the salaries of the Patent Office attorneys. *United States Court of Appeals for the Federal Circuit, Fees* <https://goo.gl/d9fNbr> (last

visited Oct. 23, 2017). (Any “costs” she might potentially have to pay under Federal Rule of Appellate Procedure 39 and Circuit Rule 39 are small and only accrue if she loses.)

Contrast this with section 145 proceedings. The cost to get a Board decision remains the same, between \$600-\$2,400. But, from there, the costs explode. Here, the Patent Office is requesting more than \$100,000. Although “expenses,” even properly construed, certainly constitute a “heavy economic burden,” *Hyatt*, 625 F.3d at 1337, the Patent Office’s approach would be outright prohibitive for individual inventors and small companies, especially given that the section 145 expense shifting applies independent of whether the applicant prevails. Congress has worked hard to ensure that the other aspects of *ex parte* examinations are affordable. The Patent Office’s suggested approach would not be.

The Patent Office’s draconian approach appears to be based on its low esteem for section 145 proceedings. Such proceedings, it believes, “divert[]” resources from its “principal mission.” Patent Office Br. at 23. The Patent Office regards section 145 proceedings as based on potential “gamesmanship” and “tactical litigation choices.” Patent Office Br. at 24, 25.

But section 145 proceedings are an important part of the Congressional design and an important avenue for applicants to present all evidence regarding the patentability of their inventions. Section 145 proceedings provide a safeguard for

applicants to present evidence (evidence often not allowed to be presented in the Patent Office) before an independent Article III judge with *de novo* review as to the patentability of their important inventions. Unlike the Patent Office’s recently espoused disdain for section 145 procedures, Congress did not seek to deter applicants from accessing such proceedings.³ Rather, section 145 is one of the “two options” Congress provided for seeking relief from adverse decisions. *Hyatt*, 566 U.S. at 434. Notably, in 1929, when the Patent Office wanted Congress to create a higher-paid position for a Solicitor, Commissioner of Patents Robertson listed three jobs the Solicitor had to fulfill: (1) arguing in the Court of Appeals; (2) “act[ing] as counsel in all suits under section 4915” (the predecessor to section 145); and (3) representing the Patent Office in mandamus actions. *Hearing on H.R. 210 To Increase the Force and Salaries in the Patent Office and for Other Purposes* at 18 (Statement of Commissioner Robertson, May 12, 1921). Congress agreed, listing those same three reasons “for giving one of the law examiners the

³ See Charles E. Miller, *The USPTO’s Ongoing Campaign to Suppress the Right to U.S. District Court De Novo Review of Administrative Decisions in Patent Applications and of the Agency’s Post-Grant Review of Issued Patents*, Metro. Corp. Counsel (Nov. 18, 2013). After the *Hyatt* decision, the Patent Office was a supporter of the repeal of section 145 proceedings. This attempt was rebuffed by the House of Representatives on the floor. See H. Amendment 526, 113th Congress (Dec. 5, 2013).

title of ‘Solicitor’ and increasing his pay.” H.R. Rep. 67-172 at 5 (1921).

Congress and Commissioner Robertson recognized section 145 proceedings as part of the Patent Office’s principal mission of ensuring adequate process before rejecting a patent application.

The Patent Office’s suggestion that section 145 proceedings should be viewed with skepticism because they are, purportedly, based on “tactical litigation choices” and “gamesmanship” is the same argument it made in *Hyatt*. It lost there, and it should lose here. The Patent Office in *Hyatt* suggested that a liberal approach to section 145 would “encourage patent applicants to withhold evidence from the PTO intentionally with the goal of presenting that evidence for the first time to a nonexpert judge,” but the Supreme Court found that “unlikely.” *Hyatt*, 566 U.S. at 445. “An applicant who pursues such a strategy would be intentionally undermining his claims before the PTO on the speculative chance that he will gain some advantage in the § 145 proceeding.” *Id.* Yet the Patent Office repeats that discredited argument here, virtually *in haec verba*. Patent Office Br. at 24.

The Patent Office’s disdain for section 145 proceedings has also manifested itself in earlier attempts to chill the filing of section 145 proceedings. In 2012, the Patent Office ruled that 37 C.F.R. § 41.37 (c)(1)(iv) (“Rule 41.37”) restricted the broad scope of section 145 actions. However, Judge Trenga of the U.S. District Court for the Eastern District of Virginia rejected this attempt and held that Rule

41.37 improperly limits section 145 actions. *BTG Int'l Ltd. v. Kappos*, No. 1:12-cv-00682, 2012 WL 6082910 (E.D. Va. Dec. 6, 2012). Judge Trenga rejected the Patent Office's contention that the applicant could not offer evidence on "new issues or arguments not made before the Board" and that the applicant was entitled to "present all evidence admissible under the rules of evidence as to all claims." *Id.* at *5, *6 (footnote omitted). The request for attorneys' fees in this case is just another attempt by the Patent Office to deter the filing of section 145 actions.

D. This Court Has Already Rejected The Patent Office's Proportional-Share Approach As Not "Practical"

Perhaps recognizing the major problems with seeking market-rate attorneys' fees, the Patent Office suggests that it should receive the "the pro rata share of the salaries of the two attorneys and one paralegal who worked on the case." Patent Office Br. at 11; *see id.* at 35. These represent lost "opportunity costs," it argues. *Id.* at 19.

This Court en banc rejected such "pro rata" approaches as not "practical." *Raney v. Fed. Bureau of Prisons*, 222 F.3d 927, 934 (Fed. Cir. 2000) (en banc). *Raney* addressed the Back Pay Act, which expressly grants certain aggrieved employees "reasonable attorney fees." 5 U.S.C. § 5596. The government argued that the Back Pay Act only allowed for "the percentage of each attorney's salary that was attributable to the total number of hours worked on [the] case," similar to

its position here. *Raney*, 222 F.3d at 930. In addition to the statutory problems with this approach, this Court held en banc that there is a “practical objection” to such “pro-rata allocation.” *Id.* at 934. A proper pro-rata allocation would have to allocate not only salaries but the pro-rata “benefits for the attorneys, support services, equipment, office space, attorney recruitment, attorney training and continuing education, and administrative overhead.” *Id.* The “difficulty” in making such allocations suggests that Congress never intended such a result. *Id.*

Those very same concerns are present here, even if the Patent Office (wisely) has not yet sought prorated allocations of everything related to the attorneys’ work on the case. If prorated attorneys’ fees are allowed as expenses, why not prorated benefits for the attorneys, support services, equipment, office space, attorney recruitment, attorney training, continuing education, administrative overhead or other lost opportunity costs? Yet it would be impossible to untangle which of these expenses, fees, and costs are “of the proceeding.” 35 U.S.C. § 145. “[T]he common mandate of statutory construction to avoid absurd results,” *Rowland v. Cal. Men’s Colony, Unit II Men’s Advisory Council*, 506 U.S. 194, 200 (1993), dictates that section 145 should not be interpreted as requiring such an absurd result. (Surprisingly, the Patent Office suggests that *Raney* supports its position. *See Patent Office Br.* at 18-20.)

* * * *

The American Rule holds that each side in litigation pays for its own lawyers. To overcome that “bedrock principle,” a statute must say so in a specific and explicit provision. “All the expenses of the proceedings shall be paid by the applicant” is not such a specific and explicit provision. Accordingly, section 145 provides no basis for shifting attorneys’ fees.

CONCLUSION

For these reasons, the en banc Court should hold that “all the expenses of the proceeding” does not allow for attorneys’ fees, and affirm the order of the district court denying the Patent Office’s request for such fees.

Dated: January 16, 2018

Respectfully submitted,

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APPENDIX

Appendix

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Nantkwest, Inc. v. Matal, 2016-1794

CERTIFICATE OF SERVICE

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

Counsel Press was retained by INTELLECTUAL PROPERTY OWNERS ASSOCIATION, Amicus Curiae to print this document. I am an employee of Counsel Press.

On **January 17, 2018**, counsel has authorized me to electronically file the foregoing **Corrected Brief of Intellectual Property Owners Association as Amicus Curiae in Support of Plaintiff-Appellee** with the Clerk of Court using the CM/ECF System, which will serve via e-mail notice of such filing to all counsel registered as CM/ECF users, including the following principal counsel for the parties:

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Additionally, 2 copies will be served by mail on the above counsel. All Counsel for Amici Curiae, appearing at the time of this filing, will be served by CM/ECF notice only.

Thirty-one (31) paper copies will be filed with the Court within the time allowed by rule or Court order. The brief was originally filed and served on January 16, 2018.

January 17, 2018

/s/ Melissa Pickett
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CERTIFICATE OF COMPLIANCE

Pursuant to Federal Rule of Appellate Procedure 32(g), the undersigned certifies that this brief complies with the type-volume limitations of Circuit Rule 32(a).

1. Exclusive of the exempted portions of the brief, as provided in Federal Rule of Appellate Procedure 32(f) and Circuit Rule 32(b), this brief includes 5,738 words.

2. This brief has been prepared in proportionally spaced typeface using Microsoft Word 2016 in 14 point Times New Roman font. As permitted by Federal Rule of Appellate Procedure 32(g)(1), the undersigned has relied on the word count of this word-processing system in preparing this certification.

Dated: January 16, 2018

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