

In Support of Arthrex – Amicus Briefs Urge Court To Leave Remedy To Congress

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In the wake of Arthrex's initial merits brief, amicus briefs in support of Arthrex's position were filed December 29th and 30th. In the *Arthrex* cases (docketed as [19-1434](#)), the parties have persuaded the Supreme Court to review a [decision](#) by the Federal Circuit holding that administrative patent judges (APJs) are principal officers and that their appointments violate the Appointments Clause of the Constitution. Previous articles on the PTAB Trial Insights blog have discussed the initial briefs from [Smith & Nephew and the United States](#), and from [Arthrex](#). Unlike the 19 [amicus briefs filed in support of Smith & Nephew and the United States](#) (or in support of no party), which contained a wide array of arguments and positions, most of the 12 briefs filed in support of Arthrex adhered to Arthrex's position in the case.

Expanding on Arthrex's Arguments

In its initial merits brief, Arthrex argued that the key characteristic of principal officers is that their decisions are not reviewable by another officer before they take effect. Arthrex goes on to reason that because the Director of the USPTO lacks sufficient authority to review decisions rendered by APJs, the judges are principal officers. Furthermore, Arthrex argues that the remedy should be left to Congress because the remedy created by the Federal Circuit—eliminating the for-cause dismissal protections enjoyed by patent judges—does little to correct the issue of reviewability.

Several of the amicus briefs directly support or augment Arthrex's argument that APJs' decisions are not subject to sufficient review.¹ One amicus, registered patent attorney [Jeremy C. Doerre](#), argues that the Director lacks sufficient review power of APJs' decisions because overriding a final written decision by convening a new panel (as suggested by the initial brief of the United States) would violate the Director's obligation to perform his duties in a fair manner, and the lack of retroactive rulemaking authority prevents the Director from influencing an ongoing IPR.²

Several briefs also support Arthrex's argument that the remedy should come from Congress and not the courts. [Americans for Prosperity Foundation and TechFreedom](#) suggest that severing for-cause

removal protections “would run the risk of turning the PTAB into ‘a court of politicians enforcing a policy, not a court of judges administering the law’” and so a remedy should come from Congress.³ New Civil Liberties Alliance (NCLA) relies on *Booker* to argue that the Federal Circuit lacked authority to sever the for-cause removal provisions from the statute because the severance is not consistent with Congress’ objectives in passing the AIA.⁴ NCLA also argues that the Federal Circuit’s remedy addresses the wrong issue. The problem, according to NCLA, is not that APJs could only be fired for cause, but that they were not appointed by the President with the advice and consent of the Senate.⁵

Briefs by [Joshua Malone](#) and by the [Fair Inventing Fund](#) support leaving APJs as principal officers, subject to the requirements of the Appointments Clause. In his brief, Joshua Malone, an independent inventor, voices concerns about the amount of power APJs have over the patent system and suggests that the political accountability inherent in appointment by the President with advice and consent of the Senate is necessary to keep APJs from abusing their authority.⁶ Fair Inventing Fund notes that minority inventors are more likely to have their patents invalidated in IPRs or other proceedings and argues that political accountability of APJs would ensure that the patent system does not treat minorities unfairly.⁷

Discontent with IPRs and Due Process Concerns

Other amici take the opportunity to point out flaws in the IPR system. For example, [TiVo](#) and [39 Aggrieved Inventors](#) point to the high institution and claim invalidation rates of IPR procedures as evidence that the system is flawed and not operating as Congress envisioned.⁸ [US Inventor](#) goes one step further, suggesting that APJs are financially and politically motivated to invalidate patents.⁹ The brief by [B.E. Technology, LLC](#) suggests that IPRs amount to due process violations, as APJs are not Article III judges.¹⁰ This argument relies on large swaths of the dissent from Justice Gorsuch and Chief Justice Roberts in *Oil States*.

Next Steps

Smith & Nephew and the United States are slated to submit their respective consolidated response and reply briefs on January 22, 2021. Afterward, Arthrex may submit its own reply brief before February 21, 2021. And oral arguments for the case were recently set for Monday, March 1, 2021.

¹ See Brief of [U.S. Lumber Coalition](#), Brief of [Cato Institute](#), and Brief of [Pacific Legal Foundation](#) (advocating that APJs be held to be *superior* officers, in the middle tier of a three-tier taxonomy).

² Brief of Jeremy C. Doerre at 12, 29.

³ Brief of Americans for Prosperity Foundation and TechFreedom at 19 (quoting Philip Hamburger, *Is Administrative Law Unlawful?* 237 (2014) (quoting F.W. Maitland, *Constitutional History of England*, 263 (1990))) (internal quote omitted).

⁴ “Severance is appropriate only when a court can retain those portions of the Act that are (1) constitutionally valid, (2) capable of ‘functioning independently,’ and (3) consistent with Congress’ basic objective in enacting the statute.” *United States v. Booker*, 543 U.S. 220, 258-59 (2005) (internal citations omitted, internal quotations omitted).

⁵ “APJs are principal officers under Title 35 as currently constituted. As such, they must be appointed by the President and confirmed by the Senate; because they are not, the current structure of the

Board violates the Appointments Clause.” Pet. App. 21a

⁶ A solution to the current problem “require[s] highly qualified, transparently vetted and independent Officers of the United States to preside over any revocation.” Brief of Joshua J. Maloney at 19-20. See *also* Brief of 39 Aggrieved Inventors.

⁷ “Congress is mindful of the impact on minorities and small inventors. To further those policy objectives, Congress should maintain legislative review of the AIA to ensure judicial independence and a fair forum for all inventors.” Brief of Fair Inventing Fund at 23-24.

⁸ Brief of TiVo at 13 and Brief of 39 Aggrieved Inventors at 3.

⁹ Brief of US Inventor at 12.

¹⁰ Brief of B.E. Technology, LLC at 11.

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