
In the
United States Court of Appeals
for the
Federal Circuit

NANTKWEST, INC.,

Plaintiff-Appellee,

v.

JOSEPH MATAL,

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

Defendant-Appellant.

*Appeal from a Decision of the United States District Court for the Eastern District of Virginia
No. 1:13-cv-01566-GBL-TCB · Honorable Gerald Bruce Lee, U.S. District Judge*

**CORRECTED BRIEF OF AMICUS CURIAE
AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION
IN SUPPORT OF NEITHER PARTY ON REHEARING EN BANC**

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CERTIFICATE OF INTEREST

In accordance with FED. CIR. R. 47.4, 47.5 and FED. R. APP. P. 26.1, counsel for Amicus Curiae American Intellectual Property Law Association certifies the following:

1. The full name of every party represented by me is:

American Intellectual Property Law Association.
2. The name of the real party in interest represented by me is:

N/A.
3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the parties represented by me are:

None.
4. The names of all law firms and the partners or associates that appeared for the party now represented by me and that are expected to appear in this Court are:

Lisa K. Jorgenson, American Intellectual Property Law Association;

Kevin Tottis, Monica L. Thompson, Rachel M. Vorbeck, TottisLaw.
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:

None.

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/s/ Kevin Tottis

TABLE OF CONTENTS

CERTIFICATE OF INTEREST ii

TABLE OF CONTENTS..... iv

I. STATEMENT OF INTEREST OF AMICUS CURIAE1

II. INTRODUCTION2

III. SUMMARY OF ARGUMENT3

IV. ARGUMENT5

 A. No Principle of Statutory Construction Allows the PTO to Read
 into Section 145 a Right to Reimbursement of its Staff Salaries.....6

 1. Absent “clear” and “explicit” direction from Congress,
 Section 145 cannot be read to provide for attorney’s fees.....7

 2. Other basic statutory construction principles render the
 PTO’s interpretation untenable.10

 3. *Shammas* was decided on a faulty premise.....11

 4. The PTO interpretation of Section 145, in any case,
 deviates from the American Rule.12

 B. No Reading of “All Expenses of the Proceedings” Can Mean
 Reimbursement of Staff Salaries.....13

 C. The PTO’s Position Creates a Significant Barrier to Exercise of
 an Important Right.....16

V. CONCLUSION.....20

CERTIFICATE OF COMPLIANCE21

CERTIFICATE OF SERVICE.....22

TABLE OF AUTHORITIES

CASES

	<u>PAGE(S)</u>
<i>Alyeska Pipeline Service Co. v. Wilderness Society</i> , 421 U.S. 240, 247-248 (1975)	8, 12
<i>Baker Botts L.L.P. v. ASARCO LLC</i> , 135 S.Ct. 2158, 2164 (2015)	9
<i>Boddie v. Connecticut</i> , 401 U.S. 371, 381-82 (1971)	19
<i>Booking.com, B.V., v. Matal</i> , No. 1:16-cv-425 (LMB/IDD), 2017 WL 4853755 (E.D. Va. October 26, 2017) ..	17
<i>Fogerty v. Fantasy, Inc.</i> , 510 U.S. 517, 527 (1994).....	10
<i>Hardt v. Reliance Standard Life Ins. Co.</i> , 560 U.S. 242, 253 (2010).....	13
<i>Hyatt v. Kappos</i> , 625 F.3d 1320, 1336-37 (2010)	2, 16, 18
<i>NantKwest, Inc. v. Matal</i> , 860 F.3d 1352, 1360, 1363-64 (2017)	14, 15
<i>Nken v. Holder</i> , 556 U.S. 418, 433 (2009).....	8
<i>Norfolk Redevelopment and Housing Authority v. Chesapeake and Potomac Telephone company of Virginia</i> , 464 U.S. 30, 35 (1983).....	8
<i>Russello v. United States</i> , 464 U.S. 16, 23 (1983)	11
<i>Samantar v. Yousuf</i> , 560 U.S. 305, 320 (2010).....	8

<i>Shammas v. Focarino</i> , 784 F.3d 219 (4 th Cir. 2015)	<i>passim</i>
<i>Taniguchi v. Kan Pacific Saipan, Ltd.</i> , 566 U.S. 560, 564, 568 (2012).....	7, 8, 14
<i>U.S. v. Texas</i> , 507 U.S. 529, 534 (1993).....	8
Statutes	
15 U.S.C. §1071(b)(3).....	11
35 U.S.C. § 134(a)	2
35 U.S.C. § 145	<i>passim</i>

I. STATEMENT OF INTEREST OF AMICUS CURIAE

The American Intellectual Property Law Association (“AIPLA”) is a national bar association of approximately 13,500 members engaged in private and corporate practice, in government service, and in the academic community. AIPLA’s members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. AIPLA’s mission includes providing courts with objective analysis to promote an intellectual property system that stimulates and rewards invention while balancing the public’s interest in healthy competition, reasonable costs, and basic fairness.

AIPLA has no stake in any of the parties to this litigation or in the result of this case.¹ AIPLA’s only interest is in seeking correct and consistent interpretation of the law as it relates to intellectual property issues.²

¹ After reasonable investigation, AIPLA believes that (a) no member of its Board or Amicus Committee who voted to prepare this brief, or any attorney in the law firm or corporation of such a member, represents a party to this litigation in this matter, (b) no representative of any party to this litigation participated in the authorship of this brief, and (c) no one other than AIPLA, its members who authored this brief, and their law firms or employees, made a monetary contribution to the preparation or submission of this brief.

² Permission to file amicus briefs in this case without the consent of the parties was given in the *en banc* Court’s order dated August 31, 2017.

II. INTRODUCTION

Under 35 U.S.C. § 134(a), a patent applicant whose claims have twice been rejected by a patent examiner may appeal to the Patent Trial and Appeal Board (“PTAB”). If unsuccessful before the PTAB, the applicant has the option of bringing an action for review in the U.S. District Court for the Eastern District of Virginia under 35 U.S.C. § 145. In *Hyatt v. Kappos*, 625 F.3d 1320 (2010), *aff’d* 566 U.S. 431 (2012), this Court recognized the importance of this right of district court review with the opportunity to introduce new evidence as “the hallmark of a § 145 action.” *Id.* at 1322. This decision also recognized that Section 145 is not without its burdens. In particular, the statute provides that an applicant—win or lose—is responsible for paying, “[a]ll the expenses of the proceedings....”

Since the mid-Nineteenth Century, the PTO has interpreted this language as covering only out-of-pocket expenses, including printing costs, counsel’s deposition travel costs, court reporter fees and expert witness fees, but not attorney’s fees. In 2013, however, the PTO concluded that its long-held reading of the statutory language was incorrect and that the required payment of “[a]ll the expenses of the proceedings” also includes *pro rata* reimbursement for PTO staff time. As the PTO now reads the statute, even an applicant who proves in district court that the Office was wrong in rejecting its claims must pay for the privilege of vindicating these

rights by reimbursing the PTO for *pro rata* staff salaries incurred by the Office in the district court proceedings.

As detailed below, no reasonable application of basic statutory interpretation principles supports this reading. Congress did not articulate any intent, let alone clearly express such intent as required by law, to impose on Section 145 plaintiffs a *pro rata* reimbursement of PTO staff salaries. This Court should reject the PTO's new-found position. It is critically important that intellectual property owners of all means have equal opportunity to exercise all rights and remedies provided by Congress in the Patent Act. The PTO's sudden attempt to shift a portion of its fixed costs to Section 145 plaintiffs will effectively bar many applicants from exercising an important congressionally created right.

III. SUMMARY OF ARGUMENT

On its face, the statutory phrase "all expenses of the proceedings" does not include attorneys' fees. Nor does Section 145 define "expenses" or otherwise indicate that the word includes reimbursement of PTO fixed costs. Because the statutory language is silent on the issue of attorneys' fees, the Court must determine the applicable principle of statutory interpretation before it construes the language of the statute.

A critical statutory interpretation principle is that in certain circumstances a clear and express statement of Congressional intent is required to support a proffered

interpretation. Two such circumstances relevant here are where the interpretation would contravene common law, and where the interpretation would contravene the strong presumption favoring the American Rule that parties pay their own attorneys' fees. In this case, the PTO's interpretation can be rejected on the basis of the former principle alone, but it also fails under the latter principle.

The Supreme Court has repeatedly held that Congress must be clear and explicit when it intends legislation to deviate from common law. Because cost shifting of any stripe was unknown at common law, legislation to require cost shifting must do so with clear and explicit language. The PTO's interpretation of Section 145 to require that plaintiffs pay the fees of PTO staff attorneys participating in the proceeding, win or lose, is the kind of dramatic departure from common law that must be supported by a clear and express statement of Congressional intent to do so. This statutory interpretation principle provides an independent basis for rejecting the PTO's interpretation, dispensing with the need to decide whether the American Rule on fee shifting is implicated by this provision.

Notwithstanding the force of this statutory interpretation principle, the second principle referenced above applies with equal force to repudiate the PTO's interpretation of Section 145. As with deviations from common law, deviations from the American Rule's bar against fee shifting may not be sustained without specific and explicit evidence that Congress intended such a deviation. There is no explicit

reference to attorneys' fees in Section 145, and the phrase "all expenses" relied on by the PTO is not sufficiently specific or explicit to overcome the strong presumption that the American Rule applies.

As explained in the dissenting opinion at the panel stage of this case, the terms of a statute must be given their ordinary meaning as understood when Congress enacted the statute. When Section 145's precursor was adopted in 1839, the words "expense," "costs" and "damage" were considered synonymous. Because the Supreme Court has held that the word "damages" does not include attorneys' fees, there is no basis to conclude that the synonym "expense" includes them either. Moreover, the Supreme Court has noted that in construing the words of a statute a court should look at how they are used in common parlance. The best available evidence of 1839 "common parlance" are the actions of the Patent Office in 1839. There is no evidence to suggest that in 1839 (or at any time since), Patent Office employees—the people skilled in the language of 1839—viewed the term "expenses" as including reimbursement of its staff's salaries.

IV. ARGUMENT

This case involves the statutory interpretation of language in 35 U.S.C. § 145, which has been in force for well over a century: "All the expenses of the proceedings shall be paid by the applicant." Until 2013, the PTO read those words as entitling it to recover only its outlays incurred in district court proceedings, such as expert

fees, transcript costs, and the like. Whatever the merits of the PTO's new interpretation, this much is indisputable: for decades, reasonable minds at the PTO did not read the statute as including PTO staff time.

Moreover, imposing the *pro rata* costs of a government agency's staff on a private party seeking to enforce a constitutionally grounded property right is unusual. Indeed, other than the ruling on a similar provision under the Lanham Act in *Shammas v. Focarino*, 784 F.3d 219 (4th Cir. 2015), AIPLA has been unable to find any court decision that interprets a statutory provision to require litigants to pay government salaries when asserting such rights in the district court.

A. No Principle of Statutory Construction Allows the PTO to Read into Section 145 a Right to Reimbursement of its Staff Salaries.

The plain language in Section 145 does not expressly provide for an award of attorney's fees. It merely states that an applicant must pay "all expenses of the proceedings," but neither defines nor details just what "expenses" means. The statute is silent on whether such expenses include the "value of the PTO staff time," "attorney's fees" or a *pro rata* share of the PTO's attorney's salaries. Accordingly, in discerning whether Congress intended the words "[a]ll expenses of the proceedings" to include "reimbursement of PTO fixed costs" as advanced by the Office, the first step is to determine the relevant rule of construction to apply to that language. Under these statutory interpretation principles, the absence of a clear directive by Congress handily refutes the PTO's position.

1. Absent “clear” and “explicit” direction from Congress, Section 145 cannot be read to provide for attorney’s fees.

Much of the focus in earlier submissions and in the few cases construing this part of Section 145 or similar language in other statutes has centered on whether the “all expenses” language runs afoul of the American Rule, which requires parties in lawsuits to bear their own attorney’s fees.³ If so, the argument goes, the statutory construction principles attendant to the American Rule apply and “Congress may displace it only by expressing its intent to do so ‘clearly and directly.’” *Shammas*, 784 F.3d at 223.

However, there is another reason for requiring a clear and direct statement of Congressional intent in this case. For purposes of statutory construction, an interpretation of a statute that contravenes the common law must be supported by a clear and direct statement by Congress that it intended to do so. Thus, the PTO interpretation must be supported by a clear and direct statement by Congress that it intended to impose attorneys’ fees on Section 145 plaintiffs, and this requirement exists independent of any consideration of the American Rule.

That is because the Supreme Court has made clear that cost-shifting of any stripe did not exist at common law. *Taniguchi v. Kan Pacific Saipan, Ltd.*, 566 U.S. 560, 564 (2012) (citing *Alyeska Pipeline Service Co. v. Wilderness Society*, 421 U.S.

³ See, e.g. panel decision and *Shammas*, 784 F.3d 219.

240, 247-248 (1975)). Accordingly, this Court need not decide whether the American Rule applies, an issue that has bedeviled earlier tribunals. Any statute awarding costs, expenses or fees departs from the common law, and, accordingly, must be strictly construed.

The Supreme Court has repeatedly emphasized that interpretations of statutes that conflict with the common law must be supported by clear and explicit language that Congress intended to displace the common law. *Norfolk Redevelopment and Housing Authority v. Chesapeake and Potomac Telephone Company of Virginia*, 464 U.S. 30, 35 (1983). *Norfolk* involved eminent domain law, but the same principle has been applied or discussed in numerous contexts. *See, e.g., U.S. v. Texas*, 507 U.S. 529, 534 (1993) (Federal Debt Collection Act) (Statutes which invade common law presume “favor[ing] the retention of long-established and familiar principles, *except when the statutory purpose to the contrary is evident*.... In order to abrogate a common-law principle, the *statute must ‘speak directly’* to the question addressed by the common law.”) (emphasis added) (citations omitted); *Samantar v. Yousuf*, 560 U.S. 305, 320, n.13 (2010) (sovereign immunity) (“We interpret the statute with the presumption that Congress intended to retain the substance of common law.”); *Nken v. Holder*, 556 U.S. 418, 433 (2009) (immigration) (government failed to overcome presumption that common law prevailed absent “evident” statutory expression to the contrary).

This principle has been repeatedly applied in fee-shifting cases as well. *See, Baker Botts L.L.P. v. ASARCO LLC*, 135 S.Ct. 2158, 2164 (2015) (collecting cases) (“The American Rule has roots in our common law reaching back to at least the 18th century... and ‘[s]tatutes which invade the common law are to be read with a presumption favoring the retention of long-established and familiar [legal] principles.’”) (citations omitted). Thus, the “explicit expression” requirement in the American Rule cases discussed at the panel level and by the Fourth Circuit in *Shammas* exists because it is at odds with the common law and not simply because it may or may not involve application of the American Rule.

As the foregoing representative cases show, statutes which deviate from the common law must “speak directly,” be “clear and explicit” and “clearly express” how they are meant to stray from the common law. That deviation also must be “evident.” It is not enough that the phrase “all the expenses of the proceedings...” *may* be read to include the reimbursement of the *pro rata* share of PTO staff salaries or *could* mean that PTO staff salaries are included; rather, the repayment of staff salaries *must* be evident.

The PTO’s own conduct in changing its interpretation of this language in Section 145 shows that the statute is not clear and explicit. If, in fact, Section 145’s requirement that “all expenses of the proceeding shall be paid by the applicant” “clearly expressed” an obligation to repay the Office for staff time, the PTO would

not have taken nearly two centuries to recognize it. Whatever arguments the PTO may employ today to conclude that Section 145 requires applicants to pay staff wages, the fact remains that for decades the PTO read the same words and thought otherwise. There are no words in the statute that expressly mandate shifting the PTO's internal costs to applicants.

2. Other basic statutory construction principles render the PTO's interpretation untenable.

Other fundamental principles of statutory construction also make the PTO's interpretation incorrect. When Congress adopted the America Invents Act, it made substantive changes to Section 145 (*e.g.*, changing the venue from the District of Columbia to the Eastern District of Virginia). Nevertheless, it kept the language "all the expenses of the proceedings shall be paid by the applicant." That occurred in 2011, two years before the PTO adopted its current position. Congress knew then that the PTO was not interpreting "all the expenses of the proceedings" to include PTO staff salaries and Congress did nothing to change this language. "Congress is presumed to be aware of an administrative or judicial interpretation of a statute and to adopt that interpretation when it reenacts a statute without change...." *Fogerty v. Fantasy, Inc.*, 510 U.S. 517, 527 (1994) (citations omitted). If Congress sought to expand the definition of "expenses of the proceedings," it would have said so.

Moreover, when it intends to do so, Congress knows how to express a party's obligations to pay attorney's fees. Section 285 of the patent statute expressly

provides for attorneys' fees, and Congress could have also provided for attorneys' fees when it amended Section 145 in 2011. "Where Congress includes particular language in one section of a statute but omits it in another section of the same Act, it is generally presumed that Congress acts intentionally and purposely in the disparate inclusion or exclusion." *Russello v. United States*, 464 U.S. 16, 23 (1983) (citation omitted). Of particular significance under the Patent Act, Congress expressly provided for awards of attorneys' fees to prevailing parties under 35 U.S.C. §285, and limited such awards to cases deemed "exceptional" by the courts. Congress could easily have explicitly provided for attorneys' fees when it amended Section 145 in 2011, *but it did not*.

3. *Shammas* was decided on a faulty premise.

The panel majority relied heavily on *Shammas*, 784 F.3d 219. In *Shammas*, the Fourth Circuit construed Section 21(b)(3) of the Lanham Act, 15 U.S.C. § 1071(b)(3), a trademark provision that is very similar to Section 145. Under that section, a trademark applicant who is unsuccessful before the PTO has the right to file an action in district court. The statute provides that "all the expenses of the proceeding shall be paid by the party bringing the case, whether the final decision is in favor of such party or not." 15 U.S.C. § 1071(b)(3).

There, like here, the PTO sought to transfer its in-house fixed costs to the applicant. And there, like here, the parties focused on the faulty premise that a court

must strictly construe the statutory language only if the statute violates the American Rule. *Id.* at 223. The *Shammas* court concluded that the American Rule did not apply because, in its view, the American Rule refers to prevailing parties only, whereas the trademark statute in that case shifted costs regardless of outcome. *Id.* However, the *Shammas* court readily acknowledged that if the American Rule applied, the PTO’s argument would fail: “To be sure, where the American Rule applies, Congress may displace it only by expressing its intent ‘clearly and directly.’” *Id.*

As explained above, the requirement of a “clear and explicit” expression by Congress applies not only where a statutory interpretation is at odds with the American Rule, but also where that interpretation conflicts with the common law. In *Alyeska Pipeline*, the Supreme Court recognized that cost shifting did not exist at common law: “At common law, costs were not allowed; but for centuries in England there had been statutory authorization to award costs, including attorneys’ fees.” 421 U.S. at 247. Had the Fourth Circuit applied the proper statutory construction standard, it could not have reached the decision it did. *Shammas* was wrongly decided.

4. The PTO interpretation of Section 145, in any case, deviates from the American Rule.

The language of Section 145 as read by the PTO also departs from the American Rule. In *Hardt v. Reliance Standard Life Ins. Co.*, 560 U.S. 242, 253 (2010), the Supreme Court identified a range of deviations from the American Rule,

citing statutes for awarding attorneys' fees to the prevailing party, to a substantially prevailing party, to a successful litigant, or where appropriate, in the district court's discretion. The Court held that the statute at issue, which allowed fees to be awarded to either party in the district court's discretion, while not limited to a prevailing party, nonetheless required "some degree of success on the merits." *Id.* at 253-255.

Hardt discusses the statutory conditions that Congress has applied to awards of attorneys' fees, but none of the examples on that spectrum of "deviations" from the American Rule approaches the radical deviation of unconditional fee awards to the government that is advocated by the PTO.

B. No Reading of "All Expenses of the Proceedings" Can Mean Reimbursement of Staff Salaries.

Congress has the power to shift a portion of PTO fixed costs to an applicant, but the issue is whether the phrase "all expenses of the proceedings" "expressly" and "clearly" provides for that reimbursement. The panel majority pointed to cases in which attorney's fees were awarded *pro rata* on behalf of government lawyers. In those cases, however, the issue was whether the government could recover fees under statutes that expressly provide for attorney's fees. That is not at issue here.

As the panel dissent explained, in construing terms in a statute, the words should be interpreted as taking their ordinary, contemporary, common meaning at the time Congress enacted the statute. *NantKwest, Inc. v. Matal*, 860 F. 3d 1352, 1360 (Fed. Cir. 2017). When the section initially was adopted in 1839, however, the

words “expense,” “cost” and “damage” were considered synonymous. *Id.* The Supreme Court has held at least twice that “damages” does not include attorney’s fees. *Id.* at 1363. If “damages” cannot mean attorney’s fees as a matter of law, then nothing suggests the synonym “expense” includes them.

Moreover, the Supreme Court has noted that in construing the words of a statute, a court should look at how that word is used in common parlance. “That a definition is broad enough to encompass one sense of a word does not establish that the word is *ordinarily* understood in that sense.” *Taniguchi*, 566 U.S. at 568 (emphasis in original). In most cases, the best available evidence of 1839 “common parlance” would be an 1839 dictionary. Here, however, the Court has something even better: the actions of the Patent Office. Not only did the people in the Patent Office in 1839 not read “expense of the proceedings” as including the *pro rata* cost of the office’s staff, but apparently nobody did when the Patent Act was amended in 1870, 1927, 1952 or 2011. That, in 2013, some in the Office seek to reinterpret the statute after a different part of the statute was amended in 2011 to include staff salary reimbursement hardly constitutes evidence that this is what the drafters of the original and unchanged language had in mind nearly 200 years ago.

The panel pointed to a contemporary edition of Black’s Law Dictionary as defining “expenses” as “expenditure[s] of money, time, labor or resources to accomplish a result.” *Id.* at 1356. That definition, of course, simply begs the question

because it fails to define “expenditure.” Black’s actually defines “expenditure” as “spending or payment of money; the act of expending, disbursing or laying out of money; payment.” *Black’s Law Dictionary* 698 (10th ed. 2014). Moreover, in “common parlance” “expenses” is almost always defined in terms of payments made or specific outlays or out-of-pocket payments, not fixed costs like salaries.

Similarly, whenever Congress believed that the term “expenses” should include attorney’s fees, it has made that distinction apparent. The panel dissent cited well over a dozen examples from the U.S. Code showing that Congress either stated “expenses and attorneys’ fees” or “expenses ... including reasonable attorneys fees” when it chose to provide for attorney’s fees. *Nantkwest*, 860 F.3d at 1363-64. That Congress, at times, has stated that “expenses” includes attorneys’ fees, does not mean the definition of “expenses” ordinarily includes such fees; on the contrary, the need to elucidate “attorneys’ fees” as part of “expenses” underscores that, in common parlance, one would not expect “expenses” to include those charges. This is particularly true where Congress has expressly provided for attorneys’ fees elsewhere in the statute, as in Section 285. It certainly does not suggest that “expenses” could ever mean *pro rata* reimbursement of the Office’s fixed costs. Nor does the modifier “all” extend the term “expenses” to include attorneys’ fees where there is no basis for concluding that Congress intended that term, modified or unmodified, to include attorneys’ fees.

In short, even a plain reading of the phrase “All the expenses of the proceedings” does not lead to the PTO’s desired conclusion. The strict construction necessary here shows that reading to be incorrect.

C. The PTO’s Position Creates a Significant Barrier to Exercise of an Important Right.

Section 145 provides important rights to a patent applicant that are otherwise unavailable under the Act. As this Court recognized in *Hyatt*, Section 145 not only permits an applicant to introduce new evidence in the district court action, it also allows the district court judge to make *de novo* fact findings if the evidence conflicts with any related Patent Office finding. *Hyatt*, 625 F.3d at 1336. Adoption of the PTO’s staff-reimbursement reading of the statute will make it impossible for some applicants to pursue an action in the district court.

According to the *AIPLA 2017 Report of the Economic Survey*, the average cost of the preparation and filing of an original patent application, amendment, and appeal to the Board with oral argument totals roughly \$25,000 in a relatively complex biotechnology/chemical matter. *Survey* at I-94 to I-97. On the high end (90th percentile), the total cost runs roughly \$38,000 and, on the low end (10th percentile), about \$15,000. The costs for complex electrical computer and mechanical are fairly consistent with those numbers as well. *Id.* In short, the average applicant should expect to spend \$25,000 in costs through appeal and rarely more than \$40,000.

In the current case, the PTO sought reimbursement of nearly \$112,000. 860 F. 3d at 1354, n.1. Nearly \$79,000 of that reimbursement constituted the *pro-rata* share of the salaries of two PTO attorneys and a paralegal. Assuming this case reflects typical PTO reimbursement costs, an applicant seeking to exercise its Section 145 rights easily could expect to pay the PTO multiple times the cost of what it already had paid to prosecute its patent application, not including the cost of its own attorneys in pursuing the appeal.⁴

The PTO's reimbursement request here does not appear to be an anomaly. In the recently decided *Booking.com, B.V., v. Matal*, No. 1:16-cv-425 (LMB/IDD), 2017 WL 4853755 (E.D. Va. October 26, 2017), the PTO sought a little over \$51,000 in attorney's fees, reflecting the cost of *five* PTO lawyers and one paralegal who worked on the matter. Notably, *Booking.com* was a trademark case, which may be less time intensive for the PTO than a patent case. (*Cf. Survey* at I-175; I-120. Average attorneys' fees for typical \$1 million to \$10 million trademark case total \$626,000 vs. \$1.4 million for patent case of same size.)

The PTO's position renders a practitioner's ability to counsel a client on basic budgeting extraordinarily difficult. Rarely does a client tell its lawyer to proceed regardless of cost. Counsel has no control over how the PTO will staff a matter, let

⁴ PTO reimbursement fees alone were three times the amount of an average prosecution.

alone how many hours the Office will spend on a given matter. Thus, the lawyer's ability to estimate costs for the client will be based on guesswork. Absent a clear directive from Congress, no applicant should be exposed to such financial uncertainty.

The long history and importance of the rights contained in Section 145 were recognized by this Court and by the Supreme Court in *Hyatt*, particularly with respect to the ability to introduce new evidence in the proceeding. *Hyatt* acknowledged the risk of procedural gamesmanship presented by the options of district court or Federal Circuit review. However, it concluded that the imposition of expenses on the plaintiff in the district court was the statute's way of addressing that risk, and rejected the PTO's position that prohibiting new evidence would provide additional necessary deterrence. *Hyatt*, 625 F.2d at 1337. Nothing in *Hyatt* (nor in the PTO's 2010 submissions in that case) suggests that the risk of gamesmanship should also be deterred by expanding the understanding of "expenses" to include attorneys' fees. Imposing the costs of experts and transcripts on applicants is one thing; exponentially inflating the cost of exercising a statutory right is quite another. As noted in *Boddie v. Connecticut*, 401 U.S. 371 (1971), pricing a court action out of reach for an applicant is an inappropriate bar to court access:

[O]ther alternatives exists to fees and cost requirements as a means for conserving the time of courts and protecting parties from frivolous

litigation, such as penalties for false pleading or affidavits, and actions for malicious prosecution or abuse of process, to mention only a few.

Boddie, 401 U.S. at 381-82. Today, the PTO also has Fed. R. Civ. P. 11 to protect itself from frivolous litigation. Without a clear direction of Congress, the PTO should not be permitted to set the price of admission so high that many applicants will be forced to choose not to exercise their rights.

V. CONCLUSION

For the reasons set forth above, AIPLA respectfully requests that this Court find that 35 U.S.C. § 145 does not provide for attorneys' fees or *pro rata* reimbursement of PTO staff salaries.

Date: November 22, 2017

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

Pursuant to Fed. R. App.P. 32(a)(7)(C), I certify that according to the word-processing system used in preparing it, the foregoing BRIEF OF AMICUS CURIAE AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION IN SUPPORT OF NEITHER PARTY ON REHEARING EN BANC is 4,556 words in length, excluding those portions exempted by Fed. R. App. P. 32(a)(7)(B)(iii) and Fed. Cir. R. 32(b), and therefore complies with the type-volume limitation set forth in Fed. R. App. P. 29(d).

Date: November 22, 2017

/s/ Kevin Tottis
KEVIN TOTTIS

CERTIFICATE OF SERVICE

I certify that on this 22nd day of November, 2017, the foregoing CORRECTED BRIEF OF AMICUS CURIAE AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION IN SUPPORT OF NEITHER PARTY ON REHEARING EN BANC was served upon registered counsel, including counsel for the parties set forth below, by operation of the Court's CM/ECF system on the date set forth below:

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