

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

REGENTS OF THE UNIVERSITY OF MINNESOTA,
Appellant,

v.

LSI CORPORATION, AVAGO TECHNOLOGIES U.S. INC.,
Appellees,

GILEAD SCIENCES, INC.,
Intervenor.

(Lead) Appeal from the U.S. Patent and Trademark Office,
Patent Trial and Appeal Board in No. IPR2017-010

(caption continued on inside cover)

**BRIEF OF *AMICI CURIAE* THE COMPUTER & COMMUNICATIONS
INDUSTRY ASSOCIATION, THE HIGH TECH INVENTORS ALLIANCE,
THE INTERNET ASSOCIATION, L BRANDS, INC., NEWEGG INC.,
RED HAT, INC., SAP AMERICA, INC., SAS INSTITUTE INC.,
THE SOFTWARE & INFORMATION INDUSTRY ASSOCIATION,
SYMMETRY LLC, and XILINX IN SUPPORT OF APPELLEES**

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August 7, 2018

REGENTS OF THE UNIVERSITY OF MINNESOTA,
Appellant,

v.

ERICSSON INC., TELEFONAKTIEBOLAGET LM ERICSSON,
Appellees,

GILEAD SCIENCES, INC.,
Intervenor.

Appeals from the U.S. Patent and Trademark Office,
Patent Trial and Appeal Board in Nos. IPR2017-01186, IPR2017-01197,
IPR2017-01200, IPR2017-01213, IPR2017-01214, and IPR2017-01219

CERTIFICATE OF INTEREST

Counsel for *amici curiae* certifies the following:

1. The full name of every party represented by undersigned counsel:

**The Computer & Communications Industry Association (“CCIA”)
The High Tech Inventors Alliance (“HTIA”)
The Internet Association (“IA”)
L Brands, Inc.
Newegg Inc.
Red Hat, Inc.
SAP America, Inc.
SAS Institute Inc.
The Software & Information Industry Association (“SIIA”)
Symmetry LLC
Xilinx**

2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by undersigned counsel:

Not applicable

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party represented by undersigned counsel:

***Amici* do not have any parent corporations, and no publicly held companies own 10 percent or more of their stock, except that (1) T. Rowe Price Associates and Vanguard Group each owns greater than 10 percent of the stock of Red Hat, Inc., and (2) SAP AG owns 10 percent or more of the stock of SAP America, Inc. CCIA’s membership list is available at <https://www.ccianet.org/about/members>. HTIA’s members are as follows: Adobe Systems, Inc.; Amazon.com, Inc.; Cisco Systems, Inc.; Dell Inc.; Google Inc.; Intel Corporation; Oracle Corporation; and salesforce.com, inc. IA’s membership list is available at <https://internetassociation.org/our-members/>. SIIA’s membership list is available at <https://www.sii.net/About/SIIA-Member-Companies>.**

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 are:

John Thorne, Gregory G. Rapawy, Ariela M. Migdal, and Daniel S. Guarnera are expected to appear in this Court on behalf of *amici* CCIA, HTIA, IA, L Brands, Inc., Newegg Inc., Red Hat, Inc., SAP America, Inc., SAS Institute Inc., SIIA, Symmetry LLC, and Xilinx. None appeared before the Patent Trial and Appeal Board in this litigation.

Dated: August 7, 2018

/s/ John Thorne

John Thorne
Counsel for Amici

TABLE OF CONTENTS

	Page
CERTIFICATE OF INTEREST	i
TABLE OF AUTHORITIES	iv
INTEREST OF <i>AMICI CURIAE</i>	1
INTRODUCTION AND SUMMARY	2
ARGUMENT	6
I. STATES CANNOT ASSERT SOVEREIGN IMMUNITY TO BAR INTER PARTES REVIEW	6
A. Inter Partes Review Is Not an Agency Proceeding to Which Sovereign Immunity Applies	6
1. State Sovereign Immunity Does Not Bar Discretionary Federal Enforcement Actions	7
2. Inter Partes Review Is More Like a Discretionary Federal Enforcement Action Than Like a Private Civil Action	9
B. Inter Partes Review Also Embodies the Agency’s Reconsideration of Its Own Grant of a Public Franchise	15
1. A Patent Is the Grant of a Public Franchise	16
2. Inter Partes Review Is a Procedure Through Which the Patent Office Checks Its Own Work of Awarding Patents	18
II. A STATE WAIVES ANY IMMUNITY FROM INTER PARTES REVIEW WHEN IT SUES FOR INFRINGEMENT IN FEDERAL COURT	21
CONCLUSION	27
CERTIFICATE OF SERVICE	
CERTIFICATE OF COMPLIANCE	

TABLE OF AUTHORITIES

	Page
CASES	
<i>A123 Sys., Inc. v. Hydro-Quebec</i> , 626 F.3d 1213 (Fed. Cir. 2010).....	25
<i>Alden v. Maine</i> , 527 U.S. 706 (1999)	6, 7
<i>Cuozzo Speed Techs., LLC v. Lee</i> , 136 S. Ct. 2131 (2016)	3, 10, 11, 14, 19, 20, 21
<i>Federal Maritime Comm’n v. South Carolina State Ports Auth.</i> , 535 U.S. 743 (2002).....	2, 3, 4, 6, 7, 8, 9, 10, 11, 13, 14, 15
<i>Gayler v. Wilder</i> , 51 U.S. (10 How.) 477 (1851)	16
<i>Gunter v. Atlantic Coast Line R.R. Co.</i> , 200 U.S. 273 (1906).....	22
<i>Halo Elecs., Inc. v. Pulse Elecs., Inc.</i> , 136 S. Ct. 1923 (2016)	11
<i>Idaho v. Coeur d’Alene Tribe</i> , 521 U.S. 261 (1997)	21
<i>Lapides v. Board of Regents of the Univ. Sys. of Georgia</i> , 535 U.S. 613 (2002).....	5, 22, 23, 24, 25
<i>Magoun v. Illinois Trust & Sav. Bank</i> , 170 U.S. 283 (1898).....	18
<i>MCM Portfolio LLC v. Hewlett-Packard Co.</i> , 812 F.3d 1284 (Fed. Cir. 2015), <i>cert. denied</i> , 137 S. Ct. 292 (2016).....	20
<i>Octane Fitness, LLC v. ICON Health & Fitness, Inc.</i> , 134 S. Ct. 1749 (2014).....	11
<i>Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC</i> , 138 S. Ct. 1365 (2018).....	10, 11, 16, 18, 20
<i>Pennhurst State Sch. & Hosp. v. Halderman</i> , 465 U.S. 89 (1984).....	24
<i>Precision Instrument Mfg. Co. v. Automotive Maint. Mach. Co.</i> , 324 U.S. 806 (1945).....	17
<i>Regents of the Univ. of New Mexico v. Knight</i> , 321 F.3d 1111 (Fed. Cir. 2003).....	22, 23

<i>SAS Inst. Inc. v. Iancu</i> , 138 S. Ct. 1348 (2018)	11
<i>Sears, Roebuck & Co. v. Stiffel Co.</i> , 376 U.S. 225 (1964)	16
<i>Seminole Tribe of Florida v. Florida</i> , 517 U.S. 44 (1996).....	6
<i>St. Regis Mohawk Tribe v. Mylan Pharm., Inc.</i> , Case Nos. 2018-1638 et al., 2018 WL 3484448 (Fed. Cir. July 20, 2018).....	1, 2, 3, 4, 6, 7, 9, 11, 12, 13, 14, 15, 19, 20, 21
<i>Tegic Commc'ns Corp. v. Board of Regents of the Univ. of Texas Sys.</i> , 458 F.3d 1335 (Fed. Cir. 2006)	21, 25
<i>Teva Pharm. USA, Inc. v. Sandoz, Inc.</i> , 135 S. Ct. 831 (2015)	16
<i>United States v. American Bell Tel. Co.</i> , 128 U.S. 315 (1888)	16
<i>Vas-Cath, Inc. v. Curators of the Univ. of Missouri</i> , 473 F.3d 1376 (Fed. Cir. 2007).....	14, 15, 23, 24
<i>Wheaton v. Peters</i> , 33 U.S. (8 Pet.) 591 (1834).....	16-17, 18

ADMINISTRATIVE DECISIONS

<i>Ericsson Inc. v. Regents of the Univ. of Minnesota</i> , Case IPR2017- 01186 (Patent 8,774,309 B2) (lead), 2017 WL 6517563 (PTAB Dec. 19, 2017)	4, 14, 23
<i>Reactive Surfaces Ltd. v. Toyota Motor Corp.</i> , IPR2017-00572, Paper 32 (PTAB July 13, 2017).....	12
<i>Securus Techs., Inc. v. Profanchik</i> , IPR2016-00268, 2016 WL 8969932 (PTAB Aug. 17, 2016)	12

CONSTITUTION, STATUTES, REGULATIONS, AND RULES

U.S. Const.:

Art. I.....	17
§ 8, cl. 8	17
Art. III.....	10, 12
Amend. XI	21, 22, 24
Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011)	19
Patent Act of 1790, ch. 7, § 1, 1 Stat. 109-10.....	17
Patent Act (35 U.S.C.)	12, 17, 18
§ 41(b).....	18
§ 100 <i>et seq.</i>	19
§§ 101-103	17
§ 102	12
§ 103	12
§ 261	18
§ 311(b).....	12
§ 313	13
§ 314(b).....	11
§ 315(b).....	23
§ 317(a).....	12
§ 317(b).....	12
Shipping Act of 1984, 46 U.S.C. app. § 1701 <i>et seq.</i> (1994 & Supp. V).....	7, 8

37 C.F.R.:

§ 1.607(b) (2004) 15
§ 42.108(c) 12
§ 42.120(a) 12

Fed. Cir. R. 29(c) 1

Fed. R. App. P.:

Rule 29(a)(2)..... 1
Rule 29(a)(4)(E)..... 1

LEGISLATIVE MATERIALS

H.R. Rep. No. 96-1307, pt. 1 (1980) 1
H.R. Rep. No. 112-98, pt. 1 (2011)..... 11-12, 26

ADMINISTRATIVE MATERIALS

U.S. Gov't Accountability Office, GAO-16-490, *Patent Office Should Define Quality, Reassess Incentive, and Improve Clarity* (June 2016) 19
U.S. Patent & Trademark Office, *Performance & Accountability Report* (2017)..... 19

OTHER AUTHORITIES

Br. for the Fed. Resp., *Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC*, 138 S. Ct. 1365 (2018) (No. 16-712) (U.S. filed Oct. 23, 2017), 2017 WL 480523010, 12, 17

Richard A. Epstein, *No New Property*, 56 Brook. L. Rev. 747 (1990)16

Malathi Nayak, *Cost of Patent Infringement Litigation Falling Sharply*, Bloomberg BNA (Aug. 10, 2017), <https://www.bna.com/cost-patent-infringement-n73014463011>26

PwC, *The 2017 Global Innovation 1000 Study*, available at <https://www.strategyand.pwc.com/innovation1000>1

INTEREST OF *AMICI CURIAE*¹

Amici are leading technology companies and their trade associations comprising a large portion of the high tech industry of the United States. We have a collective market capitalization of more than \$5 trillion; we hold hundreds of thousands of U.S. patents; and we are the world’s very largest investors in innovation, *see* PwC, The 2017 Global Innovation 1000 Study, *available at* <https://www.strategyand.pwc.com/innovation1000>. We have a strong interest in supporting the processes Congress has created to “strengthen[] investor confidence in the certainty of patent rights by creating a system of administrative reexamination of doubtful patents,”” *St. Regis Mohawk Tribe v. Mylan Pharm., Inc.*, Case Nos. 2018-1638 et al., 2018 WL 3484448, at *7 (Fed. Cir. July 20, 2018) (Dyk, J., concurring) (quoting H.R. Rep. No. 96-1307, pt. 1, at 3 (1980)) – a public interest that is equally important when a patent is held by a state or state entity.

¹ No counsel for any of the parties authored any portion of this brief. No entity other than *amici* monetarily contributed to the preparation or submission of this brief. *See* Fed. R. App. P. 29(a)(4)(E). The parties do not oppose the filing of this brief. *See* Fed. R. App. P. 29(a)(2); Fed. Cir. R. 29(c).

INTRODUCTION AND SUMMARY

Although the Patent Trial and Appeal Board ultimately reached the correct result by rejecting the attempt of Appellants (the “Regents”) to assert state sovereign immunity in this case, it erred by concluding that, as a general matter, sovereign immunity permits state entities to evade the Patent Office’s review of its decision to grant a patent. The Board’s decision can be affirmed both because state sovereign immunity does not apply to inter partes review at all and because (as the Board correctly concluded) the Regents waived any such immunity when they filed a patent-infringement action in district court.

In the erroneous part of its reasoning, the Board lacked the benefit of this Court’s recent decision in *St. Regis Mohawk Tribe v. Mylan Pharmaceuticals, Inc.*, Case Nos. 2018-1638 et al., 2018 WL 3484448 (Fed. Cir. July 20, 2018), which involved an assertion of sovereign immunity by an Indian tribe. This Court applied the rationale of *Federal Maritime Commission v. South Carolina State Ports Authority*, 535 U.S. 743 (2002) (“*FMC*”), a case on state sovereign immunity before federal administrative tribunals, to hold that “tribal sovereign immunity cannot be asserted” in an inter partes review proceeding. *St. Regis*, 2018 WL 3484448, at *2. Both the Board and the Regents rely heavily on *FMC* for their arguments that state sovereign entities can assert immunity from inter partes review. But *St. Regis* makes clear that such reliance is fatally misplaced. It is now

settled in this Circuit that, under *FMC*, sovereign immunity from suit does not bar inter partes review.

As *St. Regis* explains, *FMC* equates the ultimate question of immunity to whether a particular agency process is one “from which the Framers would have thought the States possessed immunity when they agreed to enter the Union.” *FMC*, 535 U.S. at 756, *quoted in St. Regis*, 2018 WL 3484448, at *2. If an agency process is sufficiently similar to “civil litigation in federal courts” – that is, an “adjudicative proceeding[] brought against a state by a private party” – then immunity applies. *St. Regis*, 2018 WL 3484448, at *2. But if that process is instead more like an “agency-initiated enforcement proceeding[],” in which the administrative decisionmaker has “authority to decide whether to proceed,” then immunity does not apply. *Id.* Inter partes review lies between those two extremes: a “‘hybrid proceeding’” with some “‘adjudicatory characteristics’ similar to court proceedings,” but other attributes that resemble “‘a specialized agency proceeding.’” *Id.* (quoting *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2143-44 (2016)).

St. Regis reasoned that inter partes review “is more like an agency enforcement action than a civil suit brought by a private party,” *id.* at *3 – especially in the ways that matter most to the sovereign immunity analysis. The most important of those ways is that the Director of the Patent Office – not a

private party – has “broad discretion in deciding whether to institute [inter partes] review.” *Id.* The involvement of a “politically accountable[] federal official” in determining whether review should take place means that no “private party c[an] unilaterally hale a sovereign before a tribunal,” *id.* – a key distinction between inter partes review and both civil litigation and the administrative complaints at issue in *FMC*. *See FMC*, 535 U.S. at 764 (relying on the FMC’s lack of “discretion to refuse to adjudicate complaints brought by private parties”). Another important distinction is the Board’s ability to proceed even if the private parties challenging the patent drop out of the case. Other dissimilarities between inter partes review and civil litigation include sharp limits on discovery and general avoidance of live testimony. *See St. Regis*, 2018 WL 3484448, at *3.

So far as this case is concerned, *St. Regis* is not only persuasive but also controlling. Although there are, in general, differences between states’ and tribes’ sovereign immunities, *see id.* at *2, the reasoning of *St. Regis* turned heavily on *FMC*, which specifically concerned state immunity. Indeed, both the Board in its decisions and the Regents in their present brief treat *FMC* as controlling. *See Ericsson Inc. v. Regents of the Univ. of Minnesota*, Case IPR2017-01186 (Patent 8,774,309 B2) (lead), 2017 WL 6517563, at *2 (PTAB Dec. 19, 2017); Appellant’s Br. 30-36. There is no principled basis to distinguish *St. Regis* here.

The Board's result was also correct for the alternative reason – on which the Board relied in its opinion – that a state or state entity waives any defense of sovereign immunity against inter partes review when it files an infringement action in federal district court. A state's voluntary invocation of federal jurisdiction waives its immunity from suit to the extent necessary to avoid "inconsistency, anomaly, and unfairness." *Lapides v. Board of Regents of the Univ. Sys. of Georgia*, 535 U.S. 613, 620 (2002). Here, the Regents' filing of an infringement action triggered the running of a statutory time clock that would permanently have barred Appellees from using the inter partes review proceeding to ask the Board to review the patents in suit. It would indeed be anomalous and unfair if the Regents could start and run out that clock while asserting immunity to prevent their litigation adversaries from invoking inter partes review within the period prescribed by statute.

The Regents argue that a state can use sovereign immunity to choose the forum where it will be sued. That proposition may be true in the abstract, but it does not permit a state to use its immunity as a mechanism to obtain an unfair litigation advantage. Rather, when a state voluntarily invokes federal jurisdiction, it must accept the consequences of the procedure it has chosen. And due to the relationship that Congress has created between district court litigation and inter partes review, one of the consequences of a patent-infringement suit in district

court is the potential that the accused infringer may invoke review before the Board. That is how Congress set up the system to work, and this Court should reaffirm that is how the system works today.

ARGUMENT

I. STATES CANNOT ASSERT SOVEREIGN IMMUNITY TO BAR INTER PARTES REVIEW

A. Inter Partes Review Is Not an Agency Proceeding to Which Sovereign Immunity Applies

State sovereign immunity shields nonconsenting states from “suits by private parties.” *Seminole Tribe of Florida v. Florida*, 517 U.S. 44, 72 (1996). It does not exempt states from compliance with federal law or provide a defense against federal actions to enforce that law. *See Alden v. Maine*, 527 U.S. 706, 755-56 (1999) (“In ratifying the Constitution, the States consented to suits brought by . . . the Federal Government.”); *FMC*, 535 U.S. at 768 (noting that, where permitted by statute, federal agencies may bring administrative enforcement proceedings or bring suit in district court against state entities for violations of federal law). As *St. Regis* recognizes, inter partes review is a discretionary administrative procedure in which the federal government (through the Patent Office) enforces the requirements of federal law concerning patent validity, rather than adjudicating grievances of private parties. A state may be immune (absent consent or waiver) from a private district court action challenging the validity of the state’s patent,

but it does not have the prerogative to shield a patent from reconsideration by the federal sovereign that granted the patent in the first place.

1. State Sovereign Immunity Does Not Bar Discretionary Federal Enforcement Actions

FMC sets forth the standard for determining when an administrative proceeding amounts to an adjudication of a private party's complaint against a state – and thus is barred by a state's sovereign immunity. *FMC* concerned a complaint filed by a private party against a state ports authority before the Federal Maritime Commission ("FMC") for alleged violations of the federal Shipping Act of 1984, 46 U.S.C. app. § 1701 *et seq.* (1994 & Supp. V). The *FMC* Court instructed that, to determine whether an administrative proceeding is the "type of proceeding[] from which the Framers would have thought the States possessed immunity when they agreed to enter the Union," it is essential to examine whether the federal agency possesses "the discretion to refuse to adjudicate complaints brought by private parties." 535 U.S. at 756, 764. If, as in *FMC* itself, the federal agency lacks any such discretion, then it becomes clear that the United States "has impermissibly effected 'a broad delegation to private persons to sue nonconsenting States.'" *Id.* at 764 (quoting *Alden*, 527 U.S. at 756). In highlighting this factor, "the Court recognized a distinction between adjudicative proceedings brought against a state by a private party and agency-initiated enforcement proceedings." *St. Regis*, 2018 WL 3484448, at *2 (discussing *FMC*).

In holding that state sovereign immunity barred a private cruise ship company's complaint against a state ports authority before the FMC, the Supreme Court made clear that a federal action or investigation to enforce the Shipping Act would not have been similarly barred. *See* 535 U.S. at 768 (noting that the federal agency remained free "to investigate alleged violations of the Shipping Act, either upon its own initiative or upon information supplied by a private party, and to institute its own administrative proceeding against a state-run port") (citation omitted). The Court further underscored that the participation of private parties in a federal investigation or administrative proceeding did not, on its own, violate a state's sovereign immunity. To the contrary, "private parties remain perfectly free to complain to the Federal Government about unlawful state activity and the Federal Government [remains] free to take subsequent legal action . . . consistent with th[e] Court's sovereign immunity jurisprudence," so long as the federal agency does not "adjudicate a dispute between a private party and a nonconsenting State." *Id.* at 768 n.19 (first alteration in original).

The Supreme Court in *FMC* also focused on the "remarkably strong resemblance" that "FMC administrative proceedings bear . . . to civil litigation in federal courts." *Id.* at 757-58. In particular, the Court focused on the similarity between the FMC's rules and discovery procedures and the Federal Rules of Civil Procedure. *Id.* Because of these similarities, which the Court characterized as

“overwhelming,” it held that requiring states to defend against proceedings before the FMC brought by private parties would have been unacceptable to the Framers as an affront to states’ dignity. *Id.* at 759-60.

2. Inter Partes Review Is More Like a Discretionary Federal Enforcement Action Than Like a Private Civil Action

In *St. Regis*, this Court applied *FMC*’s state sovereign immunity analysis to inter partes review and determined that such review “is more like an agency enforcement action than a civil suit brought by a private party.” 2018 WL 3484448, at *3. As a result, the Court held that Indian tribes do not have sovereign immunity from inter partes review. *See id.*² Inter partes review differs from ordinary civil litigation in four main ways: (1) in basic purpose, (2) in the Patent Office’s discretion to commence review, (3) in the limited role played by private parties, and (4) in its abbreviated and un-trial-like procedures. Each of those distinctions reinforces the conclusion that the analysis of inter partes review in *St. Regis* is persuasive and correct. And while the *St. Regis* Court expressly reserved judgment on the question whether *state* sovereign immunity bars inter partes review, there is no reason to reach a different conclusion with respect to state, as opposed to tribal, immunity.

² The *St. Regis* Court recognized that “the precise contours of tribal sovereign immunity differ from those of state sovereign immunity,” but nonetheless found that “the *FMC* analysis is instructive.” 2018 WL 3484448, at *2. *FMC* itself involved a claim of sovereign immunity by a state, not a tribe.

First, the purpose of inter partes review is to “offer[] a second look at an earlier administrative grant of a patent.” *Cuozzo*, 136 S. Ct. at 2144; *see also Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC*, 138 S. Ct. 1365, 1373 (2018) (“Inter partes review involves . . . reconsideration of the Government’s decision to grant a public franchise.”); *infra* pp. 18-20 (discussing the history of administrative post-grant patent review procedures). As the Solicitor General put it in *Oil States*, inter partes review is concerned not with “determining the respective rights of adverse litigants” but rather with whether the Patent Office correctly granted “a patent monopoly as against the world.” Br. for the Fed. Resp. at 36, *Oil States*, No. 16-712 (U.S. filed Oct. 23, 2017) (“Gov’t *Oil States* Br.”), 2017 WL 4805230. Consistent with that purpose, filing a petition for inter partes review does not require any showing of the injury-in-fact necessary for Article III standing in federal court. *See Cuozzo*, 136 S. Ct. at 2143-44. That is, the petitioner need not have any cognizable individual right of its own – it is sufficient that it is calling the agency’s attention to an error in carrying out its statutory mandate, which the agency has its own interest in correcting.

Second, the Patent Office – unlike the FMC – possesses “the discretion to refuse to adjudicate complaints brought by private parties.” *FMC*, 535 U.S. at 764. In inter partes review, after the petitioner brings the disputed patent claims to the

Patent Office's attention, the Director exercises discretion to decide whether to undertake the review:

[I]nter partes review is not initiated by private parties in the way that a common-law cause of action is. To be sure, a private party files the petition for review. 35 U.S.C. § 311(a). But the decision to institute review is made by the Director and committed to his unreviewable discretion.

Oil States, 138 S. Ct. at 1378 n.5 (citing *Cuozzo*, 136 S. Ct. at 2140); *see also SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1355 (2018) (citing 35 U.S.C. § 314(b)) (the choice “whether to institute an inter partes review” is within the Director’s discretion). Unlike in *FMC*, the state cannot be forced to undergo adjudication as the direct consequence of a private party’s filing of a complaint. Instead, “the Director, [a] politically appointed executive branch official, . . . ultimately decides whether to proceed against the sovereign.” *St. Regis*, 2018 WL 3484448, at *3. “In this way, IPR is more like cases in which an agency chooses whether to institute a proceeding on information supplied by a private party.” *Id.*

To be sure, “discretion is not whim” and “is rarely without limits.” *Halo Elecs., Inc. v. Pulse Elecs., Inc.*, 136 S. Ct. 1923, 1931 (2016) (brackets omitted). The Director has a duty to exercise his discretion “‘in light of the considerations’ underlying the grant of that discretion,” *id.* (quoting *Octane Fitness, LLC v. ICON Health & Fitness, Inc.*, 134 S. Ct. 1749, 1756 (2014)), which here include Congress’s mandate “to improve patent quality and restore confidence in the presumption of validity that comes with issued patents in court.” H.R. Rep. No.

112-98, pt. 1, at 48 (2011); *see also id.* at 39-40 (inter partes review is an “efficient system for challenging patents that should not have issued”). His discretion is also channeled by substantive and procedural limits set by statute.³ Despite those limits, the Director’s discretion is more than “broad” enough that the decision whether to institute an inter partes review proceeding is fairly characterized as the agency’s decision to make. *St. Regis*, 2018 WL 3484448, at *3.

Third, private parties play a different role in inter partes review than they do in litigation. The “role of the parties in IPR suggests immunity does not apply in these proceedings” because the Board – unlike a district court hearing an ordinary civil case – “may choose to continue review even if the petitioner chooses not to participate.” *Id.*; *see* 35 U.S.C. § 317(a).⁴ That – like the absence of any requirement for Article III standing, *see supra* p. 10 – shows that the petitioner’s role in inter partes review is to “assist” the Patent Office “in making a decision within its bailiwick.” *Gov’t Oil States* Br. 11.

³ For example, the Patent Office may consider only particular statutory grounds of unpatentability in its review (§ 102 or § 103 of the Patent Act) and only based on prior art consisting of patents or printed publications. *See* 35 U.S.C. § 311(b).

⁴ Similarly, review may also continue without the participation of the patent owner. *See, e.g., Reactive Surfaces Ltd. v. Toyota Motor Corp.*, IPR2017-00572, Paper 32, at 11-12 (PTAB July 13, 2017) (citing 37 C.F.R. §§ 42.108(c), 42.120(a)); *Securus Techs., Inc. v. Profanchik*, IPR2016-00268, 2016 WL 8969932 (PTAB Aug. 17, 2016) (after the patent owner indicated it would not participate in the hearing, the PTAB indicated that a decision would nonetheless issue unless the parties decided to file a settlement agreement under 35 U.S.C. § 317(b)).

Finally, the procedural rules governing inter partes review diverge from the Federal Rules of Civil Procedure in “substantial” respects. *St. Regis*, 2018 WL 3484448, at *3. For example, a patent owner can seek leave to amend its patent claims in response to inter partes review – an option not available in federal court litigation; but, unlike complaints in federal court, petitions for inter partes review cannot be substantively amended. *Id.* Discovery is limited, live testimony is rare, and hearings are short. *Id.* For all of these reasons, as this Court concluded in *St. Regis*, “[i]n IPR, the agency proceedings are both functionally and procedurally different from district court litigation,” and “the agency procedures in *FMC* much more closely approximated a civil litigation than those in IPR.” *Id.* Thus, under *FMC*, a state cannot assert its sovereign immunity to bar inter partes review.⁵

The Regents concede (at 21-22) that *FMC* articulates the relevant test for sovereign immunity, but point (at 23-24) to similarities between adversary-initiated litigation and inter partes review, such as limits on the Director’s authority to reshape a petition once filed and the impartiality expected from judges of the Board once review has been initiated. There is no dispute that inter partes review

⁵ There are also other dissimilarities between inter partes review and the commission proceedings in *FMC*. For example, the proceeding in *FMC* was coercive: the state was required to answer the complaint, and, if it did not, the federal commission could enter a default judgment against it. *See* 535 U.S. at 757. In contrast, a patent owner need not respond to a petition for inter partes review, and the petitioner retains the burden of proof. *See* 35 U.S.C. § 313.

is a “‘hybrid proceeding,’” *St. Regis*, 2018 WL 3484448, at *2 (quoting *Cuozzo*, 136 S. Ct. at 2144), not a perfect analog to either agency enforcement or private civil litigation. Despite those hybrid characteristics, however, “[t]he Director’s important role as a gatekeeper and the Board’s authority to proceed in the absence of the parties” demonstrate that “the USPTO is acting as the United States in its role as a superior sovereign to reconsider a prior administrative grant and protect the public interest in keeping patent monopolies ‘within their legitimate scope.’” *Id.* at *4 (quoting *Cuozzo*, 136 S. Ct. at 2144). Therefore, under *FMC*, states cannot assert their sovereign immunity to insulate them from the federal government’s reexamination of its decision to grant a patent franchise.

The Board also relied primarily on *FMC* in concluding that sovereign immunity applies to inter partes review. See *Ericsson*, 2017 WL 6517563, at *2. It cited this Court’s observation in *Vas-Cath, Inc. v. Curators of the University of Missouri*, 473 F.3d 1376, 1382 (Fed. Cir. 2007), that *interference* proceedings bore some marks of private litigation similar to those in *FMC*. See *Ericsson*, 2017 WL 6517563, at *2. But *Vas-Cath* held only (and correctly, see *infra* Part II) that a state waived any claim of sovereign immunity against appellate review of an interference proceeding that the state itself initiated, not that sovereign immunity generally applied to interference proceedings. See 473 F.3d at 1383. The purpose of the proceeding in *Vas-Cath* was to determine which of two applicants was the

prior inventor, *see id.* at 1379, not whether the patent rights being sought met the statutory (and constitutional) requirements for patentability. Its holding was limited to the waiver issue, and the Court did not decide whether the state could otherwise have asserted immunity.⁶ *St. Regis*, not *Vas-Cath*, is the controlling precedent regarding the application of *FMC* to inter partes review.

B. Inter Partes Review Also Embodies the Agency’s Reconsideration of Its Own Grant of a Public Franchise

Inter partes review is also distinct from ordinary civil litigation because of its focus on the government’s reconsideration of its own grant of a public franchise. Patents are public franchises, granted by the federal government to all patentees – including states – subject to conditions. They are not common-law property rights, but grants subject to constitutionally informed limitations set by Congress. Just as the federal government has the authority to grant such franchises, it may reconsider its decision to do so. Inter partes review is one mechanism whereby the government considers whether it mistakenly granted a

⁶ In any event, under regulations in effect at the time of the events in *Vas-Cath*, the decision whether to begin an interference proceeding (unlike the decision whether to institute an inter partes review) was *not* discretionary, making interferences more akin to litigation and therefore more amenable to sovereign immunity. *See* 37 C.F.R. § 1.607(b) (2004) (providing that, when “an applicant seeks an interference with a patent,” the patent “examiner *shall* determine whether there is interfering subject matter”; if so, “an interference *will be* declared”) (emphases added); *Vas-Cath*, 473 F.3d at 1379 (noting availability of the § 1.607 procedure).

patent in the first place. States cannot (and should not be able to) block that error-correction process by asserting an immunity that applies to private litigation.

1. A Patent Is the Grant of a Public Franchise

“Invention patents originated not as private property rights, but as royal prerogatives” and “sovereign grants.” *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 135 S. Ct. 831, 847 (2015) (Thomas, J., dissenting). In the United States today, patents are recognized as “a specific form of property right – a public franchise.” *Oil States*, 138 S. Ct. at 1375. “By ‘issuing patents,’ the PTO ‘take[s] from the public rights of immense value, and bestow[s] them upon the patentee.’” *Id.* at 1373 (quoting *United States v. American Bell Tel. Co.*, 128 U.S. 315, 370 (1888)) (alterations added in *Oil States*). Patent rights “‘did not exist at common law,’” *id.* at 1374 (quoting *Gayler v. Wilder*, 51 U.S. (10 How.) 477, 494 (1851)), and patents confer rights that “exist only by virtue of statute,” *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 229 n.5 (1964). *See also* Richard A. Epstein, *No New Property*, 56 *Brook. L. Rev.* 747, 754 (1990) (recognizing that the “creation of . . . patents is in derogation of common law rights of property and labor”).

Important limits on patent holders’ rights derive from patents’ historically understood origins as federally granted franchises. One set of limits stems from the long recognition that patent rights are subject to the parameters established by the sovereign – today, Congress. *See Wheaton v. Peters*, 33 U.S. (8 Pet.) 591,

663-64 (1834) (noting that Congress has “the power to prescribe the conditions on which such right shall be enjoyed”). Another important limit is that, because of the significant imposition on the rights of the public, the granting sovereign – today, the executive branch acting through the Patent Office – has a “paramount interest in seeing that patent monopolies . . . are kept within their legitimate scope.”

Precision Instrument Mfg. Co. v. Automotive Maint. Mach. Co., 324 U.S. 806, 816 (1945).

From the first Patent Act, Congress has limited patents to inventions that met standards of novelty and utility. *See* Patent Act of 1790, ch. 7, § 1, 1 Stat. 109-10. Today, inventions must, to be awarded a patent, meet criteria of utility, novelty, and non-obviousness over prior art. *See* 35 U.S.C. §§ 101-103. Those statutory constraints on patent scope have “constitutional underpinnings,” *Gov’t Oil States Br.* 19, because Congress’s Article I power to grant patents in the first instance is tethered to “promot[ing] 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. Therefore, Congress has both the constitutional authority and the constitutional duty to define the scope of patent rights in a way that promotes “the Progress of Science and useful Arts.” *Id.*

Article I gives Congress the “[p]ower” – but no obligation – to grant patents. Neither a state nor any other patent holder has a natural entitlement to a patent.

See Wheaton, 33 U.S. (8 Pet.) at 661 (“[I]t has never been pretended by any one, either in this country or in England, that an inventor has a perpetual right, at common law, to sell the thing invented.”). Instead, an entity that accepts a patent does so subject to Congress’s “authority . . . [to] impose conditions” on the grant of the franchise. *Magoun v. Illinois Trust & Sav. Bank*, 170 U.S. 283, 288 (1898); *see also Oil States*, 138 S. Ct. at 1375 (“Congress can grant a franchise . . . but qualify the grant by reserving its authority to revoke or amend the franchise.”); 35 U.S.C. § 261 (“patents shall have the attributes of personal property,” but only “[s]ubject to the provisions of” the Patent Act). Such conditions include, for example, the requirement that the patent holder (including states) pay a fee to maintain the patent. *See* 35 U.S.C. § 41(b). Another such condition is that the granting sovereign has the prerogative “to reconsider and cancel patent claims that were wrongly issued.” *Oil States*, 138 S. Ct. at 1370. With the power to award a patent franchise comes the power to revoke the franchise if it was granted in error.

2. Inter Partes Review Is a Procedure Through Which the Patent Office Checks Its Own Work of Awarding Patents

Congress has established a series of procedural devices to enable the Patent Office to correct any errors in granting patents. Its ongoing review of patents enables the Patent Office to enforce statutory limits on patent scope derived from the constitutional grant of authority to issue patents. Those statutory limits, enforced through post-grant review procedures like inter partes review, apply to

all patent holders – regardless of whether they are states or private entities – as conditions on the receipt of a patent franchise.

In *Cuozzo*, the Supreme Court catalogued the history and evolution of patent reexamination procedures, all of which give “the Patent Office . . . the authority to reexamine – and perhaps cancel – a patent claim that it had previously allowed.” 136 S. Ct. at 2137 (describing *ex parte* reexamination and *inter partes* reexamination). As Judge Dyk explained in his concurrence in *St. Regis*, each of those procedures for post-grant administrative review of patents has aimed to address “longstanding concerns about the reliability of the original examination process” driven by the high volume of patent applications, the short amount of time examiners have to review applications, and the “adverse effect[.]” that too many “bad patents” issue. *St. Regis*, 2018 WL 3484448, at *5 (Dyk, J., concurring) (explaining that the Patent Office receives about 600,000 applications per year and that 70% of examiners believe they do not have sufficient time to evaluate applications) (citing U.S. Patent & Trademark Office, *Performance & Accountability Report* 169 tbl. 2 (2017); U.S. Gov’t Accountability Office, GAO-16-490, *Patent Office Should Define Quality, Reassess Incentive, and Improve Clarity* 10, 25-26 (June 2016)).

Inter partes review, established by Congress in the Leahy-Smith America Invents Act and codified at 35 U.S.C. § 100 *et seq.*, shares the same “basic

purpose[.]” as its predecessors: “to reexamine an earlier agency decision.” *Cuozzo*, 136 S. Ct. at 2144; *see St. Regis*, 2018 WL 3484448, at *5 (Dyk, J., concurring) (inter partes review “shares many of the same procedural features and is designed to address the same problems” as earlier post-grant review mechanisms). Although inter partes review relies more heavily than other mechanisms on interested members of the public to alert the Patent Office to erroneously issued patents – and, in most cases, to establish that an error was made – it is ultimately a means for advancing the public interest in patent quality rather than for resolving private disputes. That is why the Supreme Court held in *Oil States* that inter partes review “falls squarely within the public-rights doctrine,” 138 S. Ct. at 1373, and why this Court held in *St. Regis* that such review involves “the USPTO . . . acting as the United States in its role as a superior sovereign to reconsider a prior administrative grant and protect the public interest in keeping patent monopolies ‘within their legitimate scope,’” 2018 WL 3484448, at *4 (quoting *Cuozzo*, 136 S. Ct. at 2144).

The “important public purpose” of inter partes review in allowing the Patent Office “to correct the agency’s own errors in issuing patents in the first place,” *MCM Portfolio LLC v. Hewlett-Packard Co.*, 812 F.3d 1284, 1290 (Fed. Cir. 2015), *cert. denied*, 137 S. Ct. 292 (2016), underscores why it is not barred by state sovereign immunity merely because a particular patent happens to be held by a

state. States and their universities have every right to participate in the patent system. And when they do so they maintain their general immunities (subject to waiver, *see infra* Part II) against purely private litigation. But nothing in the logic or purpose of the state sovereign immunity doctrine suggests that, when a state acquires a federally authorized public franchise, it should be able to block the federal government’s decision to take “a second look at [its] earlier administrative grant,” *Cuozzo*, 136 S. Ct. at 2144, of that franchise. In this particular area, states are not and should not be treated differently from any other patent holders.

II. A STATE WAIVES ANY IMMUNITY FROM INTER PARTES REVIEW WHEN IT SUES FOR INFRINGEMENT IN FEDERAL COURT

Although the recent decision in *St. Regis* marks a clear path to affirming the Board’s result, the ground on which the Board relied is also correct: under traditional principles governing the waiver of state sovereign immunity, a state waives any immunity when it invokes federal jurisdiction to enforce the patent that is the subject of the inter partes review. Where the Eleventh Amendment applies, it “enacts a waivable immunity from suit, not ‘a nonwaivable limit on the federal judiciary’s subject-matter jurisdiction.’” *Tegic Commc’ns Corp. v. Board of Regents of the Univ. of Texas Sys.*, 458 F.3d 1335, 1340 (Fed. Cir. 2006) (quoting *Idaho v. Coeur d’Alene Tribe*, 521 U.S. 261, 267 (1997)). A state waives its immunity when it voluntarily invokes jurisdiction, because it “cannot escape the

result of its own voluntary act by invoking the prohibitions of the 11th Amendment.” *Gunter v. Atlantic Coast Line R.R. Co.*, 200 U.S. 273, 284 (1906).

The Supreme Court applied these principles in *Lapides v. Board of Regents of the University System of Georgia*, 535 U.S. 613 (2002). *Lapides* held that a state that had been sued in state court but “voluntarily agreed to remove the case to federal court . . . voluntarily invoked the federal court’s jurisdiction” such that “the general legal principle requiring waiver ought to apply,” even though the case was one for money damages – “the heart of the Eleventh Amendment’s concern.” *Id.* at 620. The Court reasoned that allowing states “both (1) to invoke federal jurisdiction . . . and (2) to claim Eleventh Amendment immunity . . . in the same case could generate seriously unfair results.” *Id.* at 619. Because states may not employ “selective use of ‘immunity’ to achieve litigation advantages,” the decision to remove a case to federal court operates as a waiver of immunity. *Id.* at 620-21.

This Court applied that holding to the patent context in *Regents of the University of New Mexico v. Knight*, 321 F.3d 1111 (Fed. Cir. 2003). It held that, “when a state files suit in federal court to enforce its claims to certain patents, the state shall be considered to have consented to have litigated in the same forum all compulsory counterclaims, *i.e.*, those arising from the same transaction or occurrence that gave rise to the state’s asserted claims.” *Id.* at 1125-26. The fairness principle at play emerges, in part, from the recognition that, when a

patentee files suit on the patent in federal court, the alleged infringer must assert certain defenses or counterclaims or lose the right to do so in the future. *See id.*; *accord Vas-Cath*, 473 F.3d at 1383-84 (where a state “requested the PTO to conduct litigation-type activity,” namely, an adversarial interference proceeding, “[p]rinciples of fairness and consistency” prevented the state from claiming sovereign immunity from judicial review of the resulting decision).

As the Board correctly recognized, the procedural context of inter partes review mandates a similar result here. *See Ericsson*, 2017 WL 6517563, at *4. A patent owner’s service of an infringement complaint starts the running of a one-year time period created by 35 U.S.C. § 315(b). If the accused infringer (including any privy or real party in interest of that infringer) does not seek inter partes review by the end of that period, it is permanently barred from doing so. Allowing a state to achieve such a permanent bar while asserting immunity to prevent accused infringers from actually going forward with inter partes review would endorse the kind of “selective use of ‘immunity’ to achieve litigation advantages” that the Supreme Court disallowed in *Lapides*, 535 U.S. at 620, and this Court likewise rejected in *Knight*.

Indeed, the potential for abuse and unfairness here goes beyond merely losing a counterclaim. Nothing in § 315(b) requires the patent owner to prosecute the district court action to completion; and nothing in that statute suggests that the

bar goes away if the patent later changes hands. Thus, by merely serving a complaint and waiting a year, a state or state university might seek to eliminate any risk of an accused infringer ever seeking inter partes review of a particular patent, and then later sell or license that patent with the argument that it is has been “review-proofed” against as many potential infringement defendants as the state entity cared to name. The potential for unfairness and abuse in this scenario is obvious, and the doctrine of state sovereign immunity – which incorporates the “belief that neither those who wrote the Eleventh Amendment nor the States themselves (insofar as they authorize litigation in federal courts) would intend to create . . . unfairness,” *Lapides*, 535 U.S. at 622 – does not require it.

The Regents err in relying on the Supreme Court’s statement in *Pennhurst State School & Hospital v. Halderman*, 465 U.S. 89 (1984), that sovereign immunity “encompasses not merely *whether* [a state entity] may be sued, but *where* it may be sued.” *Id.* at 99. *Pennhurst* was referring merely to the principle that a state may waive immunity in its own courts without waiving immunity in federal courts. *See id.* at 99 n.9. In this case, as in *Lapides*, the Regents have waived immunity through voluntarily invoking federal jurisdiction. The scope of the resulting waiver is appropriately assessed by considering the “[p]rinciples of fairness and consistency,” *Vas-Cath*, 473 F.3d at 1384, that apply in such a situation.

Similarly, *Tegic*, on which the Regents rely, is not to the contrary. In *Tegic*, this Court held that a state university had voluntarily invoked federal jurisdiction by suing alleged infringers and had waived immunity with respect to its claims and any compulsory counterclaims. But it refused to extend that waiver to a separate federal lawsuit filed in a separate forum against the state for a declaratory judgment by a manufacturer that was not party to the state’s original infringement action. 458 F.3d at 1342. In reaching that result, the *Tegic* Court specifically determined that a broader waiver was not necessary to “avoid ‘inconsistency, anomaly, and unfairness’ in litigation,” *id.* at 1344 (quoting *Lapides*, 535 U.S. at 620), because the manufacturer could intervene in the university’s action and assert its claim for declaratory judgment relief. Here, by contrast, the Board found that the Regents’ voluntary invocation of federal jurisdiction followed by selective assertion of immunity would create inconsistency and unfairness by permanently barring Appellees from invoking the inter partes review procedure.⁷

Finally, applying waiver here also does not injure the interests that the doctrine of state sovereign immunity seeks to protect. As for sovereign dignity, the Regents do not explain why it is a greater affront to Minnesota’s dignity to be

⁷ *A123 Systems, Inc. v. Hydro-Quebec*, 626 F.3d 1213 (Fed. Cir. 2010), which the Regents also cite, similarly observed in passing that the declaratory judgment plaintiff in that case had an “adequate remedy” in that it could seek a judgment of invalidity in an existing district court proceeding. *Id.* at 1222.

required to argue the validity of a patent before the Board than to be required to do so in district court, which they agree is the consequence of their decision to bring an infringement action. Indeed, for the reasons given in Part I, the affront, if there is any at all, is considerably less. And as for the expense and inconvenience of an inter partes review proceeding, inter partes review is designed to be (and in practice is) less costly and burdensome than district court review.⁸ A patent owner's only real reasons for preferring district court to inter partes review are that it wishes to avoid the Board's expert scrutiny or wishes to increase the costs of an invalidity challenge for its litigation adversaries. Neither of those reasons is a legitimate use for state sovereign immunity.

⁸ See H.R. Rep. No. 112-98, pt. 1, at 48 (describing inter partes review as a “quick and cost effective alternative[] to litigation”); Malathi Nayak, *Cost of Patent Infringement Litigation Falling Sharply*, Bloomberg BNA (Aug. 10, 2017) (reporting that, according to a 2017 survey of members of the American Intellectual Property Law Association, patent-infringement litigation with \$1 million to \$10 million at stake costs about \$1.7 million, whereas the median cost of an inter partes review proceeding is \$250,000), <https://www.bna.com/cost-patent-infringement-n73014463011>.

CONCLUSION

The Court should affirm the decision of the Board denying the Regents' Motion to Dismiss and should hold both that a state may not raise sovereign immunity to avoid inter partes review and that any such immunity is waived by a voluntary invocation of federal jurisdiction in a district court infringement action.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that, on August 7, 2018, I electronically transmitted this **BRIEF OF *AMICI CURIAE* THE COMPUTER & COMMUNICATIONS INDUSTRY ASSOCIATION, THE HIGH TECH INVENTORS ALLIANCE, THE INTERNET ASSOCIATION, L BRANDS, INC., NEWEGG INC., RED HAT, INC., SAP AMERICA, INC., SAS INSTITUTE INC., THE SOFTWARE & INFORMATION INDUSTRY ASSOCIATION, SYMMETRY LLC, and XILINX IN SUPPORT OF APPELLEES** to the Clerk of the Court using the Court's ECF system. I further certify that all counsel of record are being served with a copy of this Brief by electronic means via the Court's ECF system.

/s/ John Thorne

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CERTIFICATE OF COMPLIANCE

1. This brief complies with the type-volume limitation of Federal Rule of Appellate Procedure 29(a)(5). This brief, excluding the parts of the brief exempted by Federal Rule of Appellate Procedure 32(f) and Federal Circuit Rule 32(b), contains 6,579 words.

2. This brief complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) and the type style requirements of Federal Rule of Appellate Procedure 32(a)(6). This brief has been prepared in a proportionally spaced typeface using Microsoft Word 2013, in 14-point Times New Roman.

Dated: August 7, 2018

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