The PTO does not have the authority to bind subsequent PTAB panels to a statutory interpretation of AIA provisions, based upon a POP opinion

By Rick Neifeld, Neifeld IP Law, PLLC
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I thank David Boundy, bringing this issue to my attention, by the filing of an Amicus brief, in Apple Inc. v. Vidal, Federal Circuit docket No 2024-1864, available at: https://papers.ssrn.com/sol3/Delivery.cfm/5016833.pdf?abstractid=5016833&mirid=1

You can the *Windy City* II decision from the Federal Circuit's website, here: https://cafc.uscourts.gov/opinions-orders/18-1400.opinion.9-4-2020_1647920.pdf

In *Facebook, Inc. v. Windy City Innovations, LLC*, 2018-1400 et al (Fed. Cir. 9/4/2020)(*Windy City* II), Federal Circuit panel included a unanimous "Additional views" section, to expressly point out that use of POP opinions to undertake statutory interpretation of AIA provisions, to bind subsequent PTAB panels, was ultra vires. I do not recall any other decision of the Federal Circuit including a unanimous Additional views section.

Quoting from the "Additional views" section:

> Notably absent from the AIA, accordingly, is any congressional authorization, for either the Director or the Board, to undertake statutory interpretation through POP opinions. Thus, just as we give no deference to nonprecedential Board decisions, we see no reason to afford deference to POP opinions. [Document page 52, Additional views page 8.]

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> To the extent that Facebook or the government argues that this is comparable to notice-and-comment rulemaking, we disagree. While the POP in Proppant issued an order listing the issues it intended to review, solicited briefs from the parties and amici, and held an oral hearing, the POP procedure falls short of traditional notice-and-comment rulemaking that could receive *Chevron* deference. [Document page 56, Additional views page 12.]

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> The law has long been clear that the Director has no substantive rule making authority with respect to interpretations of the Patent Act. *Cooper Techs. Co. v. Dudas*, 536 F.3d 1330, 1336 (Fed. Cir. 2008). The Board, similarly, historically has been given adjudicatory authority—similar to that given to courts—to decide the issues presented to it. The Director's new delegation of authority in the AIA to establish procedures by regulation for the conduct of IPRs does not confer new statutory interpretive authority to the Board or change the

> standard under which we review their conclusions. And, the Board's authority to adjudicate IPRs does not confer rulemaking authority upon the Director that extends to all legal questions the Board adjudicates. As noted above, the PTO's structure has never been the type of unitary structure at issue in the cases upon which the government relies. [Document page 58, Additional views page 14.]

The second quoted paragraph is relevant, despite *Chevron* deference having since been overruled, because it points out that the PTO's issuance of POP opinions is insufficient to satisfy the legal requirements for rulemaking interpreting statutory provisions of the AIA.