2016-1794

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

NANTKWEST, INC.,

Plaintiff-Appellee,

v.

JOSEPH MATAL, PERFORMING THE FUNCTION AND DUTIES OF THE UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, U.S. PATENT AND TRADEMARK OFFICE,

Defendant-Appellant.

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

BRIEF OF *AMICUS CURIAE* THE AMERICAN BAR ASSOCIATION SUPPORTING PLAINTIFF-APPELLEE

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Case No. 16-1794 NantKwest, Inc. v. Matal

CERTIFICATE OF INTEREST

Pursuant to Federal Circuit Rule 47.4, Counsel for *Amicus Curiae* The American Bar Association certifies the following:

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

   The American Bar Association

2. The American Bar Association has no interest in the outcome of the case as between the parties.

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or *amicus curiae* represented by me are:

   None

4. The names of all law firms and the partners or associates that appeared for the party or *amicus* now represented by me in the trial court or agency or are expected to appear in this court are:

   None of the law firms and partners or associates of the *amicus* appeared for anyone in the trial court or agency. The names of all law firms and the partners or associates that are expected to appear in this court for the *amicus* are as follows:

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5. Counsel for *Amicus Curiae* are not aware of any case pending in this or any other court or agency that will be directly affect or be directly affected by this court's decision in the pending appeal.

January 23, 2018 __/s/Charles W. Shifley_____
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STATEMENT OF INTEREST[1]

The American Bar Association ("ABA") submits this brief as *amicus curiae* in support of plaintiff-appellee NantKwest, Inc. ("NantKwest"). The ABA is the leading national organization of the legal profession, with more than 400,000 members from all 50 states, the District of Columbia, and the U.S. territories. Membership is voluntary and includes attorneys in the judiciary, private practice, government service, corporate law departments, educational institutions, and public interest organizations. Members represent the full spectrum of public and private litigants and interests. Since its inception more than 100 years ago, the ABA has consistently worked to improve the administration of justice and the judicial process. Its history reflects an unwavering commitment to the principle that society must provide its citizens with equal access to justice in adversarial proceedings.

The ABA Section of Intellectual Property Law ("IPL Section"), established in 1894, is the world's largest organization of intellectual property professionals. The IPL Section has approximately 20,000 members, including attorneys who represent patent owners, accused infringers, small corporations, universities, and research institutions across a wide range of industries. These constituent groups

[1] This brief has not been authored in whole or in part by counsel for a party, and no person or entity other than *amicus*, its members, or its counsel, has made a monetary contribution to the preparation or submission of this brief.

represent different perspectives on intellectual property issues, and provide the IPL Section with unique opportunities to fully develop consensus on issues. The IPL Section promotes the development and improvement of intellectual property law and takes an active role in addressing important legal issues, proposed legislation, administrative rule changes, and international initiatives regarding intellectual property. It also develops and presents resolutions to the ABA House of Delegates for adoption as ABA policy to foster necessary changes to the law. These policies are the basis for ABA *amicus curiae* briefs on intellectual property law topics, which are filed primarily in the United States Supreme Court and this court.

The ABA submits that imposing governmental attorneys' fees on patent applicants who choose civil actions under 35 U.S.C. § 145 will hamper equal access to justice and chill the assertion of meritorious claims. It is also contrary to the express language of Section 145, which does not overcome the presumption of the American Rule that each party pays its own fees. To record its consensus view on this issue, on February 8, 2016, the ABA's House of Delegates adopted a formal policy opposing interpretations of intellectual property laws that would "impose the payment of the government's attorneys' fees on a party challenging a decision of the United States Patent and Trademark Office in federal district court, unless the statute

in question explicitly directs the courts to award attorney fees."[2] The ABA policy not only addresses 35 U.S.C. § 145, but also 15 U.S.C. § 1071(b)(3), relating to trademarks. Both statutes use the term "expenses," and the ABA policy urges that this term be interpreted not to include the government's attorneys' fees.

INTRODUCTION AND SUMMARY OF ARGUMENT

Congress created an express pathway for patent applicants to obtain *de novo* review of the denial by the U.S. Patent and Trademark Office ("PTO") of their applications: a civil action in district court under 35 U.S.C. § 145. Section 145 provides an alternative to a direct appeal of PTO decisions to this court. Congress imposed only one qualification on an applicant's choice of using that pathway: "All expenses of the proceedings shall be paid by the applicant." 35 U.S.C. § 145. For nearly two centuries, the phrase "all expenses of the proceedings" has been understood universally to mean that the applicant must pay only the PTO's out-of-pocket expenses for the proceedings, like travel costs and expert witness fees. The PTO now urges a radical, novel departure from that longstanding interpretation: that the provision actually requires the applicant to pay for the government's salaried attorneys any time the applicant invokes Section 145, even if the applicant prevails against the government in the proceedings.

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[2] *See* ABA Resolution 108A, at: https://www.americanbar.org/news/reporter_resources/midyear-meeting-2016/house-of-delegates-resolutions/108a.html.

An interpretation of Section 145 that requires the payment of such fees would shut the door to the Congressionally created Section 145 pathway for all except those who can afford to pay not only their own legal fees but also those of the federal government. Applicants who lack sufficient funds to pay for their adversary's lawyers would be blocked from the benefits of the Section 145 pathway—including *de novo* review of the denial of their applications and the ability to introduce new evidence in district court—solely because of their inability to pay for the federal government's lawyers. Meanwhile, those benefits would remain open to large corporations and affluent individuals who can afford to shoulder the burden of paying for the government's lawyers. The PTO's newfound interpretation, if accepted, would have intolerable results. The doors of justice should be open to all, regardless of individual prosperity. The "expenses" provision in Section 145 should be interpreted and applied so that applicants' wealth does not determine their access to the district court pathway that Congress provided.

Moreover, the statutory text does not show Congressional intent to require patent applicants to pay the government's attorneys' fees. Indeed, under traditional rules of construing fee-shifting provisions, the "expenses of the proceedings" provision in Section 145 should be read to exclude attorneys' fees. The background presumption is the American Rule: each litigant pays its own attorneys' fees, win or lose. Congress can depart from that rule and enact fee-shifting provisions, but it

must do so in a clear and explicit manner. The phrase "expenses of the proceedings" is not the type of clear and explicit statement required to overcome the presumption that the American Rule applies. Moreover, the mere word "expenses" falls far short of the level of clarity that would be required to enact a novel statute that would shift only the government's attorneys' fees onto private litigants, and that would do so in every case, regardless of outcome.

Where Congress has enacted fee-shifting provisions in other statutes, it has generally done so to promote access to justice—for example, provisions in civil rights statutes allowing prevailing plaintiffs to obtain fees. To amicus's knowledge, Congress has never enacted a fee-shifting provision that shifts only the government's fees onto private parties, much less a provision that does so even if the government loses the litigation. To read Section 145 in such an unprecedented way requires far more clarity than the mere word "expenses." Congress does not hide elephants in mouseholes; it did not hide a government-fee-shifting intent in the word "expenses." There is no evidence Congress intended Section 145 to be a roadblock to justice, and this court should not interpret it that way.

ARGUMENT

I. The PTO's Proposed Interpretation of Section 145 Would Erect an Insurmountable Roadblock to Justice for Many Patent Applicants.

Adopting the PTO's position will close the Section 145 avenue to many, if not most, individuals, small businesses, and non-profit organizations. The implications of doing so are of grave concern to the ABA.

Equal access to justice is not merely an aspiration, but the cornerstone of the American justice system. As Justice Powell noted in an August 10, 1976, speech during a program, at the 1976 ABA annual meeting, entitled "Legal Services Corporation: A Presidential Program of the Annual Meeting of the American Bar Association:[3]

> Equal justice under law is not merely a caption on the façade of the Supreme Court building; it is perhaps the most inspiring ideal of our society. It is one of the ends for which our entire legal system exists. It is fundamental that justice should be the same, in substance and availability, without regard to economic status.

Critical to the notion of equal access is that those with fewer resources not be dissuaded from seeking redress from the courts by financial impediments to justice. It is pursuant to this principle that courts waive filing, court, and transcript fees for

[3] Justice Powell August 10, 1976, speech, pp. 2-3, found at: http://law2.wlu.edu/deptimages/powell%20archives/PowellSpeech_LegalServicesCorporationAug10,1976.pdf

the indigent. *See, e.g., Griffin v. Illinois,* 351 U.S. 12, 17-18 (1956) ("Plainly, the ability to pay costs in advance bears no rational relationship to a defendant's guilt or innocence, and could not be used as an excuse to deprive a defendant of a fair trial."); *Jafar v. Webb,* 303 P.3d 1042 (Wash. 2013) (requiring waiver of all court fees and local surcharges for indigent litigants).

Fee shifting is treated in a similar fashion, and it is usually permitted under statutes designed to *increase* access to justice, rather than limit it. Where Congress permits fee shifting by statute, it generally does so to correct an imbalance of power by permitting a successful plaintiff to collect attorneys' fees. Robert V. Percival & Geoffrey P. Miller, *The Role of Attorney Fee Shifting in Public Interest Litigation*, 47 Law and Contemporary Problems 233, 241 (Winter 1984) ("Fee shifting is designed to remove some of the disincentives facing public interest litigants, thus increasing access to the courts for groups who otherwise might be unrepresented or underrepresented."). For example, provisions in civil rights statutes, such as the Equal Justice Act, allow prevailing plaintiffs to obtain fees. *See* Pub. L. No. 96-481, 94 Stat. 2325 (1980) (at 28 U.S.C. § 2412 and 5 U.S.C. § 504). That Act levels the litigation playing field between the government, on the one hand, and individuals and small businesses, on the other. *See* H.R. Rep. No. 99-120 (I), p. 4 (1985) ("The Act reduces the disparity in resources between individuals, small businesses, and other organizations with limited resources and the Federal Government."). Indeed,

Congress has expressly articulated its concern that well-funded governmental agencies not target small businesses because of their inability to pay for expensive litigation. *See* H.R. Rep. No. 96-1418, p. 10 (1980) ("In fact, there is evidence that small businesses are the target of agency action precisely because they do not have the resources to fully litigate the issue" with the well-funded government.).

Contrary to these foundational principles, the interpretation advocated by the PTO would shut the door to the Congressionally created Section 145 pathway for all except those who can afford to pay not only their own legal fees but also those of the federal government, and regardless of the outcome. The expenditures required of applicants to pursue actions to overcome adverse PTO decisions in district court are already high. Those plaintiffs must introduce new evidence and pay for experts and other expenses, as well as their own attorneys' fees. On top of the already high costs of a civil action, an additional hurdle of reimbursing the PTO for potentially tens of thousands of dollars in fees will be insurmountable for many applicants and a significant deterrent to even more of them. Applicants who lack sufficient funds to pay for their adversary's lawyers would be blocked from the benefits of the Section 145 pathway—including *de novo* review of the denial of their applications and the ability to introduce new evidence in district court—solely because of their inability to pay. This will disproportionately impact individuals, small businesses, and non-profit organizations. Meanwhile, those benefits would remain open to large

corporations and affluent individuals who can afford to shoulder the burden of paying for the government's lawyers.

As a practical matter, the government's attorneys' fees in *de novo* actions can be substantial. A recent decision from the Eastern District of Virginia imposed attorneys' fees of $51,472.53 in a 15 U.S.C. § 1071(b)(3) trademark case—a case in which the applicant was *successful*. *Booking.com B.V. v. Matal,* No. 1:16-cv-00425-LMB-IDD 2017 WL 4853755, at * 9 (E.D. Va. October 26, 2017) (basing its award on a salary chart prepared by the PTO). Another decision required the applicant to post a "conservative bond of $40,000" before permitting a Section 145 action to proceed, based partly on the PTO's estimate that it would spend $45,000 in attorney time on the case. *See Taylor v. Lee*, Nos. 1:15-cv-1607(LMB/JFA), 1:15-cv-1684(LMB/JFA), 1:16-cv-12(LMB/JFA), 2016 WL 9308420, at *2 (E.D. Va., July 12, 2016). Under that decision, the patent applicant must essentially pre-pay the government's lawyer fees even before the plaintiff can conduct any aspect of the litigation.

There is no discernible, legitimate policy rationale for requiring litigants challenging a PTO decision to pay the government's legal fees regardless of outcome. One court has suggested that Congress enacted the expense provision "to discourage applicants from undertaking this type of proceeding, which enables them to introduce new evidence . . . thereby raising the potential for gamesmanship."

Taylor, supra, 2016 WL 9308420, at *1. But new evidence may be necessary in the district court for a variety of reasons other than "gamesmanship." In fact, the Supreme Court in *Kappos v. Hyatt*, 132 S. Ct. 1690, 1700 (2012), was not persuaded by the proposition that an applicant would intentionally withhold evidence from the PTO with the goal of presenting that evidence for the first time to a non-expert judge at the district court. "An applicant who pursues such a strategy would be intentionally undermining his claims before the PTO on the speculative chance that he will gain some advantage in the § 145 proceeding by presenting new evidence to a district court judge." *Id.*

Congress made the civil action route available to patent applicants for a reason—to allow them to persuade a district court, in a trial setting and limited only by the Federal Rules of Civil Procedure and the Federal Rules of Evidence, that they deserved patents denied by the PTO. Congress surely did not provide this route to patent applicants and then erect a roadblock that would eliminate its use. A decision favoring that roadblock would have an unjust chilling effect on small businesses, sole inventors, and others who cannot afford the additional costs of the agency's attorneys' fees, regardless of the merits of their inventions and civil actions. These implications must be avoided; the doors of justice must be open to all, regardless of individual prosperity.

II. "Expenses of the proceedings" Does Not Include the Government's Attorneys' Fees.

Cases interpreting potentially fee-shifting statutes must begin with the foundational presumption that fees are *not* shifted. As the Supreme Court has explained, "[o]ur basic point of reference when considering the award of attorney's fees is the bedrock principle known as the 'American Rule.' Each litigant pays his own attorneys' fees, win or lose, unless a statute or contract provides otherwise." *Hardt v. Reliance Standard Life Ins. Co.*, 560 U.S. 242, 252–53 (2010) (internal quotation marks omitted). The American Rule is a intentional departure from the English rule, which authorizes fee awards to prevailing parties in litigation, *i.e.*, "loser pays." *Fleischmann Distilling Corp. v. Maier Brewing Co.*, 386 U.S. 714, 717 (1967). Early in our history, the Supreme Court resolved that the American Rule is "entitled to the respect of the court, till it is changed, or modified, by statute." *Arcambel v. Wiseman*, 3 U.S. 305, 3 Dall. 306 (1796).

Congress codified the American Rule in 1853, explicitly permitting *only* the shifting of docket fees up to twenty dollars, absent other statutory authorization. *See* John F. Vargo, *The American Rule on Attorney Fee Allocation: The Injured Person's Access to Justice*, 42 Am. U. L. Rev. 1567, 1578 (1993) (citing Act of Feb. 26, 1853, ch. 80, 10 Stat 161 (codified as amended at 28 U.S.C. § 1923)). The 1853 Act was explicitly passed to overcome the "unequal, extravagant, and often oppressive system" of fee-shifting, when there were no constraints on the amounts lawyers

could charge for services. *Id.* Since then, the American Rule has been reaffirmed many times. *See Alyeska Pipeline Service Co. v. Wilderness Society*, 421 U.S. 240, 250 (1975) (citing cases from 1852, 1872, 1873, 1879, 1967, and 1974 by which the "Court has consistently adhered to [the] early holding [of *Arcambel*]").

Departures from the American Rule have been recognized only in "specific and explicit provisions for the allowance of attorneys' fees under selected statutes." *Baker Botts, LLP v. ASARCO LLC*, 135 S. Ct. 2158, 2164 (2015) (quoting *Alyeska*, *supra*, 421 U.S. at 260). The Supreme Court has made clear that there should be no deviation from the American Rule unless "explicit statutory authority" exists to do so. *Id.* (quoting *Buckhannon Board & Care Home, Inc. v. West Virginia Dept. of Health and Human Resources*, 532 U.S. 598, 602 (2001)).

This principle is consistent with the underlying rationale of the American Rule itself—promoting fair access to the legal system: "[O]ne should not be penalized for merely defending or prosecuting a lawsuit, and . . . the poor might be unjustly discouraged from instituting actions to vindicate their rights . . . ." *Fleischman Distilling Corp.*, *supra*, 386 U.S. at 718. As Justice Goldberg noted in *Farmer v. Arabian Am. Oil Co.*, "[i]t has not been accident that the American litigant must bear his own cost of counsel and other trial expense save for minimal court costs, but a deliberate choice to ensure that access to the courts be not effectively denied those

of moderate means." *Farmer v. Arabian Am. Oil Co.*, 379 U.S. 227, 237 (1964) (Goldberg, J., concurring).

Courts must therefore look carefully at statutory language before departing from the American Rule, and a party seeking such a departure bears a heavy burden to overcome the "deeply rooted" adherence to the American Rule. *Roadway Exp., Inc. v. Piper,* 447 U.S. 752, 761 (1980) (examining the legislative history and finding "nothing" to support the inclusion of attorneys' fees in the "taxable costs" of litigation); *Alyeska, supra,* 421 U.S. at 271 (declining to depart from the American Rule because it "is deeply rooted in our history and in congressional policy"); *F.D. Rich Co., Inc. v. U.S. for Use of Indus. Lumber Co., Inc.*, 417 U.S. 116, 128-31 (1974) (declining to interpret "costs" and "sums justly due" to include "attorney's fees").

As Judge Stoll explained in dissent in the panel decision in this case, there is no support in the text or legislative history of Section 145 for the proposition that Congress intended the mere word "expenses" to require a departure from the American Rule and shift the PTO's attorneys' fees to the patent applicant. Indeed, over 200 federal statutes and almost 2000 state statutes provide for shifting of attorneys' fees, *Vargo*, *supra*, 42 Am. U. L. Rev., at 1588, and neither the PTO nor the courts have located a single one that does so by referring only to "expenses." *See NantKwest, Inc. v. Matal*, 860 F.3d 1352, 1363 (Fed. Cir. 2017) (Stoll, J.,

dissenting) (listing 18 independent examples of statutes distinguishing between "expenses" and "attorney's fees"). Adopting the PTO's position would therefore make Section 145 unique among all fee-shifting laws.

That Section 145 is not designed to shift fees from one party to the other is also evident from the fact that it provides for an award of "all expenses" whether the patent applicant wins or loses. This non-discretionary feature of the statute undermines rather than supports the proposition that Congress intended the term "expenses" to encompass attorneys' fees. As the Supreme Court has explained, "generations of American judges, lawyers, and legislators, with [the American Rule] as the point of departure, would regard it as quite 'inappropriate' to award the 'loser' an attorney's fee from the 'prevailing litigant.'" *Ruckelshaus v. Sierra Club,* 463 U.S. 680, 683-84 (1983). Moreover, Section 145 and its predecessors have had this feature from the 1800s. *See*, *e.g.*, *Butterworth v. Hill*, 114 U.S. 128, 129-30 (1885) (quoting § 4915 Rev. stat.). Yet a Section 145 civil action, as with its predecessor "bill in equity," has long been known as "a suit according to the ordinary course of equity practice and procedure." *Kappos, supra*, 132 S. Ct., at 1698 (quoting *Butterworth v. United States ex rel. Hoe*, 112 U.S. 50, 61 (1884)); *see* P.J. Federico, *Evolution of Patent Office Appeals*, 22 J. Pat. Off. Soc'y 920, 937 (1940) (explaining the equitable nature of Section 145's predecessor statute).

As the Supreme Court noted in *Baker Botts*, departures from the American Rule "tend to authorize the award of 'a reasonable attorney's fee,' 'fees,' or 'litigation costs' and usually refer to a 'prevailing party' in the context of an adversarial action." *Baker Botts, supra*, 135 S. Ct. at 2164. By contrast, Section 145: (1) requires only the payment of "expenses," not "fees"; (2) provides for payment only of the government's expenses, never the applicant's; and (3) does so in *every* Section 145 action, regardless of which party prevails. Any *one* of these features makes Section 145 unlike any other fee-shifting provision. The presence of *all three* compels interpreting the provision to exclude attorneys' fees.

The Fourth Circuit has expressed doubt that the American Rule applies where, as here, the relevant statutory language makes no reference to "prevailing parties." *Shammas v. Focarino*, 784 F.3d 219, 223-24 (4th Cir. 2015), *cert denied*, 136 S. Ct. 1376 (2016). But that does not follow. Fee-shifting statutes generally contain a reference to the "prevailing party." *Baker Botts*, 135 S. Ct. at 2164. The absence of "prevailing parties" in Section 145 is strong indication that it is not a fee-shifting statute at all.[4]

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[4] The PTO's interpretation is not supported by *Taniguchi v. Kan Pacific,* 566 U.S. 560 (2012). *Taniguchi* held only that the word "interpreter" in 28 U.S.C. § 1920 does not include "translator," nothing more. *Id.* at 568. *Taniguchi* did not interpret the word "expenses."

Moreover, that the provision would shift only the PTO's fees, and never the applicant's, strongly suggests it is not a fee-shifting statute. The PTO is not a typical litigant that requires an award of attorneys' fees to be made whole. The agency's annual appropriations are determined in accordance with its collection of user fees, which it uses to pay its attorneys and other employees and cover other overhead costs, including those related to litigation. 35 U.S.C. § 42(c)(3)(A). The PTO is designed to be a self-funding agency that pays its staff without resort to reimbursement of attorneys' fees.

Indeed, for nearly two centuries, the phrase "expenses of the proceedings" in Section 145 has been understood to mean that the applicant must pay only the PTO's out-of-pocket expenses for the proceedings. The PTO itself has historically not interpreted "expenses" in Section 145 to include attorneys' fees but only typical expenses, such as agency travel costs, expert witness fees, and the like. As the PTO has acknowledged, it did not seek reimbursement of the salaries of its legal staff under Section 145 or its predecessor until 2013. *Shammas, supra,* 784 F.3d at 230, n.4.[5] Throughout this time, the PTO sought to recover its actual "expenses," such as travel expenses that its employees incurred travelling to depositions, *Robertson v. Cooper*, 46 F.2d 766, 769 (4th Cir. 1931), and expenses for printing the briefs and joint appendix on appeal, *Watson v. Allen*, 274 F.2d 87, 88 (D.C. Cir. 1959). *See*

[5] *See also* ABA Resolution 108A, *supra*, n.2.

also Aktiebolag v. Samuels, No. 89-3127-LFO, 1991 WL 25774, at *1 (D.D.C. Feb. 7, 1991) (expert witness fees); *Cook v. Watson*, 208 F.2d 529, 531 (D.C.C. 1953) (printing expenses).

The PTO is not alone in historically interpreting "expenses" as not including fees. There is no indication in the history of interpreting Section 145 that Congress had the intention of awarding fees. Section 145 was carried forward into current law in 1952, *see Kappos supra,* 132 S. Ct., at 1697, against a backdrop of 82 years of no known relevant departure by judges, lawyers, and legislators from requiring the PTO to pay its own attorneys' fees. The equity statute that preceded Section 145—and included identical "all expenses" language—was invoked approximately 1,170 times between 1927 and 1940, and at no time was the language interpreted to require fee shifting. *See* P.J. Federico*, supra*, 22 J. Pat. Off. Soc'y, at 941. There has been no change to the language of Section 145 that would justify a departure from this longstanding interpretation.

CONCLUSION

For the foregoing reasons, "all the expenses of the proceedings" in 35 U.S.C. § 145 should be interpreted as not authorizing an award of the United States Patent and Trademark Office's attorneys' fees.

Respectfully submitted,

January 23, 2018 __/s/Charles W. Shifley_____
Charles W. Shifley

CERTIFICATE OF COMPLIANCE

Pursuant to Federal Rule of Appellate Procedure 32(a)(7)(B), Counsel for *Amicus Curiae* The American Bar Association certifies that, according to the Microsoft Word® processing program used to prepare this brief, this brief contains 4,019 words, not including the table of contents, table of citations, and certificates of counsel, and was prepared in proportionally spaced typeface in 14 point Times Roman New font.

January 23, 2018 __/s/Charles W. Shifley_____
Charles W. Shifley

CERTIFICATE OF SERVICE

I, Charles W. Shifley, certify that on January 23, 2018, a copy of the **BRIEF OF *AMICUS CURIAE* THE AMERICAN BAR ASSOCIATION SUPPORTING PLAINTIFF-APPELLEE**, was served upon the following in the manner indicated:

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