

No. 16-712

---

---

**In the Supreme Court of the United States**

---

OIL STATES ENERGY SERVICES, LLC, PETITIONER

*v.*

GREENE'S ENERGY GROUP, LLC, ET AL.

---

*ON WRIT OF CERTIORARI  
TO THE UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT*

---

**BRIEF FOR APPLE INC. AS AMICUS CURIAE  
IN SUPPORT OF RESPONDENTS**

---

JAMES R. BATCHELDER  
ROPES & GRAY LLP  
1900 University Avenue  
Palo Alto, CA 94303

SAMUEL BRENNER  
ROPES & GRAY LLP  
Prudential Tower  
800 Boylston Street  
Boston, MA 02199

DOUGLAS HALLWARD-DRIEMEIER

*Counsel of Record*

SCOTT MCKEOWN

MATTHEW RIZZOLO

JONATHAN FERENCE-BURKE

ROPES & GRAY LLP

2099 Pennsylvania Avenue, NW

Washington, DC 20006

(202) 508-4600

*Douglas.Hallward-Driemeier*

*@ropesgray.com*

TABLE OF CONTENTS

	Page
Interest of amicus curiae .....	1
Summary of argument .....	3
Argument:	
I. IPR benefits the patent system because the PTAB can reassess previous determinations of patentability .....	4
A. Recognizing the limitations inherent in the patent examination process, Congress enacted the AIA to allow the PTO to review its own decisions .....	5
B. By enacting the AIA, Congress allowed the PTO to address critical clarifications in patent law regarding the patentability of claims.....	7
C. Precedent and common sense support the PTAB’s robust intra-agency review of the initial examination decisions made by PTO examiners in an ex parte process ....	9
D. The structure and process Congress designed for the PTAB in the AIA make well-informed and correct outcomes likely .....	11
II. The AIA benefits litigants and the patent litigation system .....	17
A. Adjudication of patentability before the PTAB saves litigants substantial time and money and conserves judicial resources.....	17

II

Table of Contents—Continued	Page
1. <i>SightSound Technologies, LLC v. Apple, Inc.</i> .....	21
2. <i>Jongerius Panoramic Technologies, LLC v. Apple, Inc.</i> .....	22
3. <i>Global Touch Solutions, LLC v. Apple Inc.</i> .....	24
B. Even where the litigation is not resolved by proceedings before the PTAB, the IPR process will often focus the parties' disputes and conserve judicial resources....	25
C. The PTAB's transparent procedures create indirect benefits for the PTO that improve the patent system .....	27
Conclusion.....	28

III

TABLE OF AUTHORITIES

	Page(s)
Cases:	
<i>Alice Corp. v. CLS Bank Int'l</i> , 134 S. Ct. 2347 (2014) .....	9
<i>Apple, Inc. v. Aylus Networks, Inc.</i> , No. IPR2014-01565, 2015 WL 1870710 (P.T.A.B. Apr. 22, 2015) .....	25
<i>Apple, Inc. v. Aylus Networks, Inc.</i> , No. IPR2014-01566, 2015 WL 1870711 (P.T.A.B. Apr. 23, 2015) .....	25
<i>Aylus Networks, Inc. v. Apple Inc.</i> , 856 F.3d 1353 (Fed. Cir. 2017) .....	26
<i>Bilski v. Kappos</i> , 561 U.S. 593 (2010) .....	9
<i>Carroll v. President &amp; Comm'rs of Princess Anne</i> , 393 U.S. 175 (1968) .....	6
<i>Cuozzo Speed Techs., LLC v. Lee</i> , 136 S. Ct. 2131 (2016) .....	13
<i>EmeraChem Holdings, LLC v. Volkswagen Grp. of Am., Inc.</i> , 859 F.3d 1341 (Fed. Cir. 2017) .....	15
<i>Executive Benefits Ins. Agency v. Arkison</i> , 134 S. Ct. 2165 (2014) .....	16
<i>Google Inc. v. Jongerius Panoramic Techs., LLC</i> , No. IPR2013-00191, 2014 WL 4059861 (P.T.A.B. Aug. 12, 2014) .....	23
<i>Homeland Housewares, LLC v. Whirlpool Corp.</i> , 865 F.3d 1372 (Fed Cir. 2017) .....	14
<i>Kaley v. United States</i> , 134 S. Ct. 1090 (2014) .....	6

IV

Cases—Continued:	Page(s)
<i>KSR Int’l Co. v. Teleflex, Inc.</i> , 550 U.S. 398 (2007) .....	8
<i>Lear, Inc. v. Adkins</i> , 395 U.S. 653 (1969).....	8
<i>McKart v. United States</i> , 395 U.S. 185 (1969).....	10
<i>Mercoid Corp. v. Mid-Continent Inv. Co.</i> , 320 U.S. 661 (1944).....	8
<i>Microsoft Corp. v. i4i Ltd. P’ship</i> , 564 U.S. 91 (2011) .....	8
<i>In re Nuvasive, Inc.</i> , 842 F.3d 1376 (Fed Cir. 2016).....	14
<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005) (en banc), cert. denied, 546 U.S. 1170 (2008) .....	13
<i>Pregis Corp. v. Kappos</i> , 700 F.3d 1348 (Fed. Cir. 2012).....	10
<i>SightSound Techs., LLC v. Apple, Inc.</i> , 809 F.3d 1307 (Fed. Cir. 2015), cert. denied, 137 S. Ct. 813 (2017) .....	22
<i>Ultratec, Inc. v. CaptionCall, LLC</i> , 872 F.3d 1267 (Fed. Cir. 2017) .....	15
<i>Unwired Planet, LLC v. Google Inc.</i> , 841 F.3d 995 (Fed. Cir. 2016) .....	14
<i>Woodford v. Ngo</i> , 548 U.S. 81 (2006).....	3, 10, 17
Constitution, statutes and regulations:	
U.S. Const. Art. I, § 8.....	8
Act of Dec. 12, 1980, Pub. L. No. 96-517, 94 Stat. 3015 (35 U.S.C. Ch. 30) 35 U.S.C. 301 <i>et seq.</i> .....	5

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.