

Nos. 20-1295, 20-1296

**United States Court of Appeals
for the Federal Circuit**

NORTH STAR INNOVATIONS, INC.,

Appellant,

v.

MICRON TECHNOLOGY, INC.,

Appellee.

*Appeals from the Patent and Trademark Office,
Patent Trial and Appeal Board in Inter Partes Review Nos. IPR2018-00998 and
IPR2018-00999, Honorable Michelle N. Wormmeester, Garth D. Baer, and Steven
M. Amundson*

APPELLANT’S MOTION TO VACATE AND REMAND

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Pursuant to Federal Circuit Rule 27(f), and in light of this Court’s precedential decision in *Arthrex, Inc. v. Smith & Nephew, Inc.*, 941 F.3d 1320 (Fed. Cir. 2019), Appellant North Star Innovations, Inc. (“North Star”) respectfully moves to vacate the Final Written Decisions issued in IPR2018-00998 and IPR2018-00999 (the “FWDs”) by the Patent Trial and Appeal Board (the “Board”), and to remand these proceedings to the Board for rehearing and reassignment to new panels of Administrative Patent Judges (“APJs”).

Arthrex addressed the constitutionality of the appointment of the Board’s APJs as of the time of the Board’s Final Written Decision that was at issue in that appeal. This Court held that “APJs are principal officers under Title 35 as currently constituted. As such, they must be appointed by the President and confirmed by the Senate; because they are not, the current structure of the Board violates the Appointments Clause.” *Id.* at 1335. To remedy the constitutional violation, this Court severed the applicability of Title 5’s removal provisions as applied to APJs under 35 U.S.C. §3(c). *Id.* at 1338.

The Court explained that for cases in which “the final decision was rendered by a panel of APJs who were not constitutionally appointed and where the parties presented an Appointments Clause challenge on appeal, [the case] must be vacated and remanded.” *Id.* at 1340. This Court further held that a new panel of APJs must be designated to hear the *inter partes* review on remand. *Id.*

This Motion follows this Court's decisions in other post-*Arthrex* cases where the Court has already vacated and remanded other Board decisions in accordance with *Arthrex* where an Appointments Clause challenge was raised in an opening brief or a motion filed prior to the opening brief. *See, e.g., VirnetX Inc., v. Cisco Systems, Inc.*, No. 2019-1671 (Fed. Cir. Jan. 24, 2020); *VirnetX Inc. v. Cisco Systems, Inc.*, No. 2019-1725 (Fed. Cir. Jan. 24, 2020); *Concert Pharmaceuticals, Inc. v. Incyte Corporation*, No. 2019-2011 (Fed. Cir. Jan 24, 2020); *Agrofresh, Inc. v. UPL Limited*, No. 2019-2243 (Fed. Cir. Jan. 24, 2020); *Vaporstream, Inc. v. Snap Inc.*, Nos. 2019-2231, 2019-2290, 2019-2337, 2020-1030 (Fed. Cir. Jan. 23, 2020); *Document Security Systems, Inc. v. Seoul Semiconductor Co., Ltd.*, No. 2019-2281 (Fed. Cir. Jan. 23, 2020); *Uniloc 2017 LLC v. Cisco Systems, Inc.*, Nos. 2018-2431, 2019-1064 (Fed. Cir. Jan. 23, 2020); *Vilox Technologies, LLC v. Unified Patents Inc.*, No. 2019-2057 (Fed. Cir. Jan. 21, 2020); *Pfizer v. Merck Sharp & Dohme Corp.*, Nos. 2019-1871, 2019-1873, 2019-1875, 2019-1876, 2019-2224 (Fed. Cir. Jan. 21, 2020); *Stuart v. Rust-Oleum Corporation*, Nos. 2019-1994, 2019-2238 (Fed. Cir. Jan. 21, 2020); *Luoma v. GT Water Products, Inc.*, No. 2019-2315 (Fed. Cir. Jan. 17, 2020); *Mirror Imaging, LLC v. Fidelity Information Services*, Nos. 2019-2026, 2019-2027, 2019-2028, 2019-2029 (Fed. Cir. Jan. 15, 2020); *Bedgear, LLC v. Fredman Bros. Furniture Co., Inc.*, Nos. 2018-2082, 2018-2083, 2018-2084 (Fed.

Cir. Nov. 7, 2019); *Uniloc 2017 LLC v. Facebook, Inc.*, No. 2018-2251 (Fed. Cir. Oct. 31, 2019) (per curiam).

On the basis of this Court's precedential decision in *Arthrex*, North Star hereby asserts that the FWDs in the present cases were issued at a time when the APJs were unconstitutionally appointed. Specifically, the FWDs were issued on October 22, 2019, prior to this Court's decision in *Arthrex*. At the time the FWDs were issued, these APJs were, under the *Arthrex* decision, principal officers of the United States who were not appointed by the President and confirmed by the Senate. Because these APJs were not properly appointed and confirmed, these APJs lacked the constitutional authority to issue the FWDs in these cases. This challenge to the validity of the FWDs is based on the violation of the Appointments Clause as already determined by *Arthrex*, and is appropriately raised in a motion filed prior to North Star's opening brief.

Because the FWDs were issued by panels of unconstitutionally appointed APJs, North Star requests that this Court vacate the FWDs and remand these cases with an order to designate new panels of APJs and grant new hearings in accordance with its decision in *Arthrex*. By making this motion, North Star does not concede that severing the application of Title 5's removal restrictions as applied to APJs under 35 U.S.C. § 3(c), as determined by *Arthrex*, remedies the violation of the

Appointments Clause. North Star reserves its rights to make all arguments as to the applicability of *Arthrex* and any other applicable decisions.

Moreover, since this motion, if granted, would terminate the appeal, the briefing schedule for this appeal should be suspended. Fed. Cir. R. 31(c); *see also Vilox Technologies, LLC v. Unified Patents Inc.*, No. 2019-2057 (Fed. Cir. Nov. 12, 2019).

North Star's counsel has conferred with counsel for Appellee Micron Technology, Inc. ("Micron"), and informed counsel of its intent to file this motion. Micron has responded that it opposes the motion.

Date: January 29, 2020

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CERTIFICATE OF INTEREST

Counsel for Appellant North Star Innovations, Inc. certifies the following:

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

North Star Innovations, Inc.

2. The name of the real party in interest represented by me is:

North Star Innovations, Inc.

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

Wi-Lan Technologies, Inc.

4. The names of all law firms and the partners or associates that appeared for the party now represented by me in the trial court or agency or are expected to appear in this court and who are not already listed on the docket for the current case are:

Eckert Seamans Cherin & Mellott, LLC (Edward C. Flynn, Philip E. Levy, Nathaniel C. Wilks)

5. The titles and numbers of all cases known to counsel to be pending in this or any other court or agency that will directly affect or be affected by the Court's decision in the pending appeal are:

North Star Innovations, Inc. v. Micron Technology, Inc., Civil Action No. 17-cv-00506-LPS (D. Del)

Dated: January 29, 2020

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Attorney for Appellant

North Star Innovations, Inc.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on January 29, 2020, I electronically filed the foregoing MOTION TO VACATE AND REMAND with the Clerk of the Court for the United States Court of Appeals for the Federal Circuit by using the CM/ECF system. I certify that all participants in the case are registered CM/ECF users and that service will be accomplished by the CM/ECF system.

Dated: January 29, 2020

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CERTIFICATE OF COMPLIANCE

This motion complies with the requirements of Fed. R. App. P. 27(d)(2)(A). According to the word processing system used to prepare it, the motion contains 804 words, excluding the parts of the motion exempted by Fed. R. App. P. 32(f) and Fed. Cir. R. 27(d). The motion complies with the typeface requirements of Fed. R. App. P. 32(a)(5) and the type-style requirement of Fed. R. App. P. 32(a)(6) because it has been prepared in a proportionally spaced typeface using Microsoft Word 2016 in Times New Roman 14-point font.

Dated: January 29, 2020

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