

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

BRIEF FOR THE FEDERAL RESPONDENT IN OPPOSITION

JEFFREY B. WALL
*Acting Solicitor General
Counsel of Record*

CHAD A. READLER
*Acting Assistant Attorney
General*

MARK R. FREEMAN
WILLIAM E. HAVEMANN
Attorneys

*Department of Justice
Washington, D.C. 20530-0001
SupremeCtBriefs@usdoj.gov
(202) 514-2217*

QUESTIONS PRESENTED

1. Whether inter partes review comports with Article III and the Seventh Amendment.
2. Whether the Patent Trial and Appeal Board properly denied petitioner's motion to amend its patent during the inter partes review.
3. Whether the Patent Trial and Appeal Board correctly cancelled the disputed patent claims as anticipated by the prior art.

(I)

TABLE OF CONTENTS

| | Page |
|----------------------|------|
| Opinions below | 1 |
| Jurisdiction | 1 |
| Statement | 2 |
| Argument..... | 7 |
| Conclusion | 22 |

TABLE OF AUTHORITIES

Cases:

| | |
|---|---------------|
| <i>Aqua Prods., Inc., In re</i> , 833 F.3d 1335 (Fed. Cir. 2016) | 20, 22 |
| <i>Atlas Roofing Co. v. Occupational Safety & Health Review Comm'n</i> , 430 U.S. 442 (1977) | 13, 14 |
| <i>Block v. Hirsh</i> , 256 U.S. 135 (1921) | 13 |
| <i>Cooper v. Lee</i> , 137 S. Ct. 291 (2016) | 7, 16 |
| <i>Cooper v. Square, Inc.</i> , 137 S. Ct. 475 (2016) | 7, 16 |
| <i>Cooper Techs. Co. v. Dudas</i> , 536 F.3d 1330 (Fed. Cir. 2008) | 3 |
| <i>Crown Die & Tool Co. v. Nye Tool & Mach. Works</i> , 261 U.S. 24 (1923) | 10 |
| <i>Cuozzo Speed Techs., LLC v. Lee</i> , 136 S. Ct. 2131 (2016) | <i>passim</i> |
| <i>Cutter v. Wilkinson</i> , 544 U.S. 709 (2005) | 21 |
| <i>Feltner v. Columbia Pictures Television, Inc.</i> , 523 U.S. 340 (1998)..... | 15 |
| <i>Gayler v. Wilder</i> , 51 U.S. (10 How.) 477 (1851) | 10 |
| <i>Granfinanciera, S. A. v. Nordberg</i> , 492 U.S. 33 (1989) | 8, 13, 14 |
| <i>Idle Free Sys., Inc. v. Bergstrom, Inc.</i> , IPR2012-00027, 2013 WL 5947697 (P.T.A.B. June 11, 2013)..... | 5, 19 |

(III)

IV

| Cases—Continued: | Page |
|---|---------------|
| <i>Iron Silver Mining Co. v. Campbell</i> , 135 U.S. 286 (1890)..... | 11 |
| <i>Joy Techs., Inc. v. Manbeck</i> , 959 F.2d 226 (Fed. Cir.), cert. denied, 506 U.S. 829 (1992) | 12 |
| <i>Kappos v. Hyatt</i> , 566 U.S. 431 (2012) | 9 |
| <i>McCormick Harvesting Mach. Co. v. Aultman</i> , 169 U.S. 606 (1898)..... | 11 |
| <i>MCM Portfolio LLC v. Hewlett-Packard Co.</i> : | |
| 137 S. Ct. 292 (2016) | 7 |
| 812 F.3d 1284 (Fed. Cir. 2015), cert. denied, 137 S. Ct. 292 (2016) | 7, 10, 15, 16 |
| <i>Microsoft Corp. v. Proxyconn, Inc.</i> , 789 F.3d 1292 (Fed. Cir. 2015) | 5, 17, 19, 20 |
| <i>Mowry v. Whitney</i> , 81 U.S. (14 Wall.) 434 (1872) | 15 |
| <i>Murray’s Lessee v. Hoboken Land & Improvement Co.</i> , 59 U.S. (18 How.) 272 (1856) | 8 |
| <i>Patlex Corp. v. Mossinghoff</i> , 758 F.2d 594 (Fed. Cir.), modified on other grounds on reh’g, 771 F.2d 480 (Fed. Cir. 1985)..... | 2, 12 |
| <i>Pernell v. Southall Realty</i> , 416 U.S. 363 (1974) | 13 |
| <i>Precision Instrument Mfg. Co. v. Automotive Maint. Mach. Co.</i> , 324 U.S. 806 (1945) | 9 |
| <i>Sears, Roebuck & Co. v. Stiffel Co.</i> , 376 U.S. 225 (1964)..... | 9, 10 |
| <i>Stern v. Marshall</i> , 564 U.S. 462 (2011)..... | 8, 9 |
| <i>Thomas v. Union Carbide Agric. Prods. Co.</i> , 473 U.S. 568 (1985)..... | 8, 12 |
| <i>Tull v. United States</i> , 481 U.S. 412 (1987) | 13 |

| Constitution, statutes, and regulations: | Page |
|---|-------------------|
| U.S. Const.: | |
| Art. I, § 8, Cl. 8 | 9 |
| Art. III..... | <i>passim</i> |
| § 1 | 8 |
| Amend. VII | 7, 13, 14, 15, 16 |
| Act of Dec. 12, 1980, Pub. L. No. 96-517, | |
| 94 Stat. 3015 (35 U.S.C. Ch. 30)..... | 2 |
| 35 U.S.C. 303(a) | 2 |
| 35 U.S.C. 304..... | 2 |
| 35 U.S.C. 311(a) | 3 |
| 35 U.S.C. 311(b)..... | 3 |
| 35 U.S.C. 311-318 (2000) | 2 |
| 35 U.S.C. 312(a) (2000)..... | 3 |
| 35 U.S.C. 313 (2000) | 3 |
| 35 U.S.C. 314(a) | 4 |
| 35 U.S.C. 315(b)..... | 4 |
| 35 U.S.C. 316(a)(5)..... | 4 |
| 35 U.S.C. 316(a)(8)..... | 4 |
| 35 U.S.C. 316(a)(9)..... | 4, 17 |
| 35 U.S.C. 316(a)(10)..... | 4 |
| 35 U.S.C. 316(d) | 4 |
| 35 U.S.C. 317(a) | 5 |
| 35 U.S.C. 318..... | 19 |
| 35 U.S.C. 318(a) | 5 |
| 35 U.S.C. 318(b) | 5 |
| 35 U.S.C. 319..... | 5 |
| 35 U.S.C. 321(c) | 3 |
| Leahy-Smith America Invents Act, | |
| Pub. L. No. 112-29, 125 Stat. 284 | 3 |
| 5 U.S.C. 8470 | 12 |
| 35 U.S.C. 102..... | 6 |

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.