

NOTE: This order is nonprecedential.

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

ARTHREX, INC.,
Appellant

v.

SMITH & NEPHEW, INC., ARTHROCARE CORP.,
Appellees

UNITED STATES,
Intervenor

2018-2140

Appeal from the United States Patent and Trademark Office, Patent Trial and Appeal Board in No. IPR2017-00275.

ON MOTION

Before MOORE, REYNA, and CHEN, *Circuit Judges*.

PER CURIAM.

ORDER

The United States seeks a stay of the mandate while Supreme Court review of this court's October 31, 2019

decision in *Arthrex* is sought and under way if obtained. We deny the requested stay.

The United States does not suggest that a stay would undermine the forward-looking curative effect of the remedy adopted by the *Arthrex* decision. Specifically, it does not dispute the premise that if that decision (a) is correct as to the constitutional violation and the remedy and (b) eliminates any Appointments Clause problem with final written decisions issued by the Board after October 31, 2019, the decision has that problem-eliminating effect whether or not the mandate is stayed. If that premise were in any doubt, *i.e.*, if a stay would undermine the curative effect of the *Arthrex* remedy as of October 31, 2019, that would be a compelling reason to deny the stay, because in that event the Appointments Clause problem identified in the *Arthrex* decision would be present in an ever-increasing number of Board decisions throughout the extended period of any Supreme Court review. But the United States does not suggest that a stay would have such a problem-extending effect.

Rather, the United States suggests simply that, while Supreme Court review of this court's decision in *Arthrex* is sought and (if secured) is under way, the Board should remain free to defer conducting the limited remand proceedings in such cases required by the *Arthrex* decision. That suggestion, however, does not justify a stay of the mandate here or in similar cases.

The delay contemplated by the United States could cause harm. All the cases in this court that are in posture similar to that of *Arthrex* involve patent claims deemed unpatentable by the Board. The delay contemplated by the United States would cause the continuation of stays in those proceedings and in related proceedings in district courts. Those stays have the effect of leaving the patent claims in force and also could cause the continued obligation to pay fees under license agreements that (as is

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common) require payment until a final adjudication of invalidity. At the same time, the limited remand proceedings required by the *Arthrex* decision (in no more than 81 cases) do not seem especially burdensome, given the resources of the Board, which has more than 250 members.

In any event, while the requested stay of the mandate would foreclose the Board from conducting the remand proceedings pending Supreme Court review, denial of the requested stay leaves the question of timing of such proceedings, at least as an initial matter, in the Board's hands. We do not know whether review of any such decisions will be sought from this court, and we do not prejudge the availability of such review or the merits if review is available. We do not believe this court should deviate from the normal practice and stay the mandate when such a stay has the potential to leave in force patents which were determined invalid by earlier panels of the Board. We conclude that the public interest under these circumstances favors denying the stay.

IT IS ORDERED THAT:

The motion to stay mandate is denied.

FOR THE COURT

March 30, 2020

Date

/s/ Peter R. Marksteiner

Peter R. Marksteiner
Clerk of Court