

**Questions for the Record from
Senator Thom Tillis for
Ms. Tiffany Patrice Cunningham**

- 1. Please describe your understanding of the workload of the Federal Circuit. If confirmed, how do you intend to manage your caseload?**

Response: As a former clerk for the Federal Circuit, I am generally familiar with the Court's workload and the types of cases that come before the Court. The Federal Circuit also reports statistics identifying the court or agency of origin for pending matters. *See, e.g.,* <http://www.cafc.uscourts.gov/sites/default/files/the-court/statistics/YTD-Activity-May-2021.pdf>. If I am fortunate enough to be confirmed, I would use many of the best practices that I saw during my clerkship regarding how to manage my caseload along with the case management strategies that I have developed during my almost 20-year intellectual property litigation career. Such practices include working closely and effectively with chambers staff to prepare for and resolve each matter presented. I would thoroughly analyze the parties' arguments and the accompanying record, identify the key issues to resolving each appeal along with any open questions to probe during oral argument, and seek to prepare well-reasoned and researched opinions, together with my colleagues, as efficiently as possible. As an intellectual property litigator for almost 20 years, I have seen firsthand how important it is to litigants to receive timely decisions from trial and appellate courts.

- 2. The Federal Circuit jurisdiction is based upon subject matter rather than geographic location. How has your background prepared you to address the variety of issues, including appeals from administrative agencies, which you will hear?**

Response: During my clerkship at the Federal Circuit, I saw the breadth of the Federal Circuit's jurisdiction including numerous appeals from administrative agencies. I have also appeared in cases before the International Trade Commission and frequently collaborated with attorneys regarding filings before the Patent Office, such as filings in inter partes review proceedings and ex parte reexaminations, as well as their interplay with parallel litigation proceedings in district courts. If confirmed, I would bring all these experiences to the bench, along with my technical background and ability to quickly get up to speed on any new issues.

- 3. Do you believe that a judge's personal views are irrelevant when it comes to interpreting and applying the law?**

Response: Yes.

4. What is judicial activism? Do you consider judicial activism appropriate?

Response: Judicial activism may involve injecting one's personal views into judicial decision-making, which is not appropriate. Regardless of one's personal views, a judge needs to faithfully apply the law to the facts of each case.

5. Do you believe impartiality is an aspiration or an expectation for a judge?

Response: Impartiality is an expectation, duty, and requirement for judges. *See, e.g.,* Code of Conduct for United States Judges, Canon 3.

6. Should a judge second-guess policy decisions by Congress or state legislative bodies to reach a desired outcome?

Response: No. A judge is not in a policymaking role and should not second-guess policy decisions. Instead, a judge should focus on faithfully applying the law to the facts of each case before him or her.

7. Does faithfully interpreting the law sometimes result in an undesirable outcome? How, as a judge, do you reconcile that?

Response: Yes, it may result in an undesirable outcome. If confirmed, I would address each matter on a case-by-case basis and apply controlling precedent to the facts presented by that case, regardless of my personal views.

8. Should a judge interject his or her own politics or policy preferences when interpreting and applying the law?

Response: No.

9. Throughout the past decade, the Supreme Court has repeatedly waded into the area of patent eligibility, producing a series of opinions in cases that have only muddled the standards for what is patent eligible. The current state of eligibility jurisprudence is in abysmal shambles. What are your thoughts on the Supreme Court's patent eligibility jurisprudence?

Response: Patent eligibility jurisprudence remains one of the hottest and most debated topics in patent law, seven years after the Supreme Court's decision in *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 573 U.S. 208 (2014) and nine years after its decision in *Mayo Collaborative Servs. v. Prometheus Labs. Inc.*, 566 U.S. 66 (2012). In my experience pre-*Mayo/Alice*, motions were less frequently filed seeking to invalidate patent claims under 35 U.S.C. § 101. Post-*Mayo/Alice*, there was a significant uptick in the number and the success of section 101 motions to invalidate patent claims, including motions to dismiss and motions for summary judgment. According to a LegalMetric Nationwide Report, the

overall win rate on section 101 motions was 50.6% between June 2014 and June 2020. I am aware that the Supreme Court is considering a petition for certiorari after the Federal Circuit denied a petition for rehearing en banc in another section 101 case. *See American Axle & Manufacturing Inc. v. Neapco Holdings LLC*, 966 F.3d 1347 (Fed. Cir. 2020) (denying petition for rehearing en banc). While I understand the concerns that you have raised, as a nominee, it is generally inappropriate for me to comment on whether any given Supreme Court precedent is correctly decided. If confirmed, I would faithfully apply all controlling Supreme Court precedent to the facts of any case, and I would also strive for clarity in the opinions that I authored to best serve future litigants.

10. Do you believe the current jurisprudence provides the clarity and consistency needed to incentivize innovation? How would you apply the Supreme Court’s ineligibility tests—laws of nature, natural phenomena, and abstract ideas—to cases before you?

Response: The Supreme Court has set forth a two-step framework to determine whether a patent will survive a section 101 challenge. “In *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. —, 132 S. Ct. 1289, 182 L.Ed.2d 321 (2012), we set forth a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts. First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts. If so, we then ask, ‘[w]hat else is there in the claims before us?’ To answer that question, we consider the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application. We have described step two of this analysis as a search for an ‘inventive concept’ —i.e., an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 573 U.S. 208, 217-18 (2014) (internal citations omitted). *See also Mayo Collaborative Servs. v. Prometheus Labs. Inc.*, 566 U.S. 66, 92 (2012) (“[W]e conclude that the patent claims at issue here effectively claim the underlying laws of nature themselves. The claims are consequently invalid.”).

If confirmed and presented with a case raising a section 101 challenge, I would apply the two-step framework in conjunction with all other on point Supreme Court or Federal Circuit precedent, including the progeny of *Alice*. All parties either defending or asserting a section 101 challenge appreciate clarity and consistency with respect to determining whether the claims at issue will be deemed patent ineligible. If confirmed, I would apply all controlling Supreme Court precedent, including any additional Supreme Court precedent further clarifying section 101 jurisprudence.

11. Over the past year or two, stakeholders have increasingly been expressing concerns about litigation in the Western District of Texas. Most of these concerns appear to be driven by the explosive growth of litigation in a single division – the Waco Division – of WD Tex. The Waco Division had only one patent case in 2016, and

again had only one in 2017, but last year there were almost 800 patent cases filed in Waco. The result is that around 20% of the patent cases filed in the U.S. are assigned to a single district court judge. Do you see that kind of concentration of patent litigation as a problem? And, if so, what – if anything – should be done about it?

Response: During my hearing, I testified that district court judges “need to be bound by the rule of law and just being focused on applying the law to the facts of each case without really taking into consideration regarding what sorts of cases they might want to appear before them.” The Supreme Court and the Federal Circuit have also considered the requirements under the patent venue statute. *TC Heartland LLC v. Kraft Foods Group Brands LLC*, 137 S. Ct. 1514, 1521 (2017) (“As applied to domestic corporations, ‘reside[nce]’ in § 1400(b) refers only to the State of incorporation.”); *In re Cray*, 871 F.3d 1355, 1360 (Fed. Cir. 2017) (“[O]ur analysis of the case law and statute reveal three general requirements relevant to the inquiry: (1) there must be a physical place in the district; (2) it must be a regular and established place of business; and (3) it must be the place of the defendant. If any statutory requirement is not satisfied, venue is improper under § 1400(b).”). I recognize that Congress may also weigh the policy considerations associated with the distribution of patent cases in courts across the United States. Litigants continue to use motions to transfer or motions to dismiss for improper venue as tools to move cases between venues. Recently, the Federal Circuit has also considered the extraordinary remedy of petitions for writ of mandamus relating to patent venue. Depending on the specific facts of the case, the Federal Circuit has either granted or denied mandamus in patent venue cases. *See, e.g., In re Google LLC*, 949 F.3d 1338, 1341-43, 1347 (Fed. Cir. 2020) (granting petition for mandamus and directing the district court to dismiss or transfer the case as appropriate); *In re HTC Corporation*, 889 F.3d 1349, 1352-54, 1361 (Fed. Cir. 2018) (denying petition for writ of mandamus).

12. The fact that around 20% of the patent cases in the U.S. are assigned to just one of the more than 600 district court judges raises concerns about the level of forum shopping that seems to occur in patent litigation. Do you see “judge shopping” and “forum shopping” as a problem in patent litigation? If so, what is required to address this?

Response: Over the course of my career, I have represented both plaintiffs and defendants. In many of the cases where I have represented defendants, those cases have been filed in the most popular jurisdictions for patent litigation. The Federal Circuit has previously described Congress’ goal for the predecessor to the patent venue statute. *See, e.g., In re Cray*, 871 F.3d 1355, 1361 (Fed. Cir. 2017) (“Congress adopted the predecessor to § 1400(b) as a special venue statute in patent infringement actions to eliminate the ‘abuses engendered’ by previous venue provisions allowing such suits to be brought in any district in which the defendant could be served.’ *Schnell v. Peter Eckrich & Sons, Inc.*, 365 U.S. 260, 262, 81 S. Ct. 557, 5 L.Ed.2d 546 (1961)”). *See also* response to Question No. 11.

13. **It's no secret that I've been a strong supporter of the policies that former PTO Director Iancu put in place, especially with respect to the operation of the Patent Trial and Appeal Board or "PTAB." But some stakeholders seem to have raised potentially legitimate concerns about how some of these policies are being applied in practice. One example of this involves the application of the *Fintiv* test in the context of so-called discretionary denials. Under *Fintiv*, the PTAB applies a multi-factor test to determine whether to exercise its discretion to refuse to review a challenged patent. The factor that often seems to be given the most weight in applying this test is factor two, which considers the proximity of the court's trial date to the projected statutory deadline for the PTAB's final written decision. The logic of this factor is simple: If the PTAB isn't going to render a decision until after the district court has already ruled on the validity of the same patent, then the PTAB's decision may essentially be rendered moot, so it may not make sense for the PTAB to move ahead with its review. I wholeheartedly agree *with that principle*.**

But, the complaint that I've heard repeatedly from stakeholders is that the scheduled trial date for the district court case is often changed to a later date after the PTAB has issued its decision refusing to move ahead with review. As a result, the PTAB is frequently denying review based on a trial date that later turns out not to be accurate. Now, I support the goal of minimizing the burdens of parallel proceedings, but I find it troubling that the PTAB relies so heavily on a piece of information that is known to be inaccurate in most cases. Can you share your views on this as a litigator and how would you address this issue if you are confirmed to the Federal Circuit?

Response: Thank you for raising this important issue. Over the course of my career, many of my trials have been rescheduled from the initial trial date set by the court. As you noted, the PTAB has provided for a six-factor test regarding discretionary denial of inter partes review petitions, based on a parallel proceeding. *See, e.g., Apple Inc. v. Fintiv, Inc.*, No. IPR2020-00019, 2020 WL 2126495, at *2 (PTAB Mar. 20, 2020) ("As with other non-dispositive factors considered for institution under 35 U.S.C. § 314(a), an early trial date should be weighed as part of a 'balanced assessment of all relevant circumstances of the case, including the merits.' Indeed, the Board's cases addressing earlier trial dates as a basis for denial under *NHK* have sought to balance considerations such as system efficiency, fairness, and patent quality. When the patent owner raises an argument for discretionary denial under *NHK* due to an earlier trial date, the Board's decisions have balanced the following factors: 1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted; 2. proximity of the court's trial date to the Board's projected statutory deadline for a final written decision; 3. investment in the parallel proceeding by the court and the parties; 4. overlap between issues raised in the petition and in the parallel proceeding; 5. whether the petitioner and the defendant in the parallel proceeding are the same party; and 6. other circumstances that impact the Board's exercise of discretion, including the merits.") (citations omitted); *see also, e.g., Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2141 (2016) ("Our

interpretation of the ‘No Appeal’ provision here has the same effect. Congress has told the *Patent Office* to determine whether inter partes review should proceed, and it has made the agency’s decision ‘final’ and ‘nonappealable.’ § 314(d). Our conclusion that courts may not revisit this initial determination gives effect to this statutory command.”); *Mylan Labs. Ltd. v. Janssen Pharmaceutica, N.V.*, 989 F.3d 1375, 1382-83 (Fed. Cir. 2021) (“Mylan lacks a clear and indisputable right to review of the Patent Office’s determination to apply the *Fintiv* factors or the Patent Office’s choice to apply them in this case through adjudication rather than notice-and-comment rulemaking. Given the limits on our reviewability, Mylan’s *ultra vires* argument cannot be a basis for granting the petition for mandamus.”). While I understand the concerns that you have raised, as a nominee, it is generally inappropriate for me to comment on whether any given precedent is correctly decided. If confirmed, I would faithfully apply all controlling precedent to the facts of any case before me.