**U.S. Department of Justice**
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August 1, 2019

Peter R. Marksteiner
Clerk of Court
U.S. Court of Appeals for the Federal Circuit
717 Madison Place, N.W.
Washington, D.C. 20439

RE: *AbbVie Biotech., Ltd. v. United States*,
Nos. 17-2304, -2305, -2306, -2362, -2363 (Fed. Cir.)

Dear Mr. Marksteiner:

Pursuant to Federal Rule of Appellate Procedure 28(j) and Circuit Rule 28(i), we write to inform the Court of *Celgene Corp. v. Peter*, No. 2018-1167 (July 30, 2019). In *Celgene*, the Court held that the application of the inter partes review provisions of the America Invents Act (AIA) to pre-AIA patents does not violate the Takings Clause.

The Court held that inter partes review does not "differ from the pre-AIA review mechanisms significantly enough, substantively or procedurally, to effectuate a taking." *Id.* The Court noted that inter partes review is only "the most recent legislative modification to the PTO's longstanding reconsideration procedures." Op. 28-29. The Court observed that "IPRs serve essentially the same purposes as their reexamination predecessors"—to offer "a second look at an earlier administrative grant of a patent"—while providing a "more robust" and "more efficient system for challenging patents." Op. 32-33 (quotations omitted). The Court concluded that the "similarities between IPRs and their reexamination predecessors" are "far more significant" than their differences. Op. 30-35. To the extent that the procedures differ, the Court noted "the longstanding recognition that '[n]o one has a vested right in any given mode of procedure.'" Op. 33 (citation omitted).

*Celgene* observed that the Court's earlier decisions in *Patlex* and *Joy Technologies* "control the outcome" of the takings challenge, while holding that the challenge fails "even apart" from those decisions. Op. 27. The Court explained that those decisions held that the retroactive application of ex parte reexamination did not violate the Due Process Clause, the Seventh Amendment, or Article III. Op. 27-28 n.13. The Court explained that the constitutional argument rejected in *Patlex* and *Joy Technologies* was "a stronger argument than" the one here,

"because, before the creation of *ex parte* reexaminations, there were no PTO reexamination procedures." *Id.*

*Celgene*'s reasoning regarding the purposes of inter partes review, the modest differences between inter partes review and prior procedures, and the import of *Patlex* and *Joy Technologies*, is directly at odds with claims that the AIA is unconstitutionally retroactive.

Sincerely,

/s/ *Dennis Fan*
DENNIS FAN
Attorney for Intervenor

**CERTIFICATE OF SERVICE**

I hereby certify that on August 1, 2019, I electronically filed the foregoing with the Clerk of the Court by using the appellate CM/ECF system. I certify that the participants in the case are registered CM/ECF users and that service will be accomplished by the appellate CM/ECF system.

/s/ *Dennis Fan*
DENNIS FAN
Attorney for Intervenor