

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

CATERPILLAR PAVING PRODUCTS INC.,
Appellant

v.

WIRTGEN AMERICA, INC., JOSEPH VOGELE AG,
Appellees

**ANDREI IANCU, UNDER SECRETARY OF
COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES
PATENT AND TRADEMARK OFFICE,**
Intervenor

2020-1261

Appeal from the United States Patent and Trademark
Office, Patent Trial and Appeal Board in No. IPR2018-
01200.

ON MOTION

JOSHUA GOLDBERG, Finnegan, Henderson, Farabow,
Garrett & Dunner, LLP, Washington, DC, for appellant.
Also represented by DANIEL CRAIG COOLEY, Reston, VA.

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RALPH WILSON POWERS, III, Sterne Kessler Goldstein & Fox, Washington, DC, for appellees. Also represented by DONALD BANOWIT, TYLER DUTTON, JON WRIGHT; MARK ANDREW KILGORE, RYAN D. LEVY, SETH R. OGDEN, Patterson Intellectual Property Law, PC, Nashville, TN.

MONICA BARNES LATEEF, Office of the Solicitor, United States Patent and Trademark Office, Alexandria, VA, for intervenor. Also represented by THOMAS W. KRAUSE, FARHEENA YASMEEN RASHEED, DANIEL KAZHDAN.

Before LOURIE, DYK, and REYNA, *Circuit Judges*.

DYK, *Circuit Judge*.

ORDER

At the behest of Wirtgen America, Inc., the Director of the United States Patent and Trademark Office, acting through the Patent Trial and Appeal Board, instituted *inter partes* review of Caterpillar Paving Products Inc.'s patent. The Board held a hearing on July 30, 2019 and issued its final written decision on November 13, 2019. Caterpillar has appealed and now moves to vacate and remand for a new hearing before a differently constituted panel in light of *Arthrex, Inc. v. Smith & Nephew, Inc.*, 941 F.3d 1320 (Fed. Cir. 2019) issued on October 31, 2019.

The court concludes that Caterpillar has not demonstrated that *Arthrex* compels a remand. Unlike in prior cases in which this court has recently vacated and remanded, *Arthrex* issued before the Board's final written decision in this case. The Director and Wirtgen argue that the Board judges were constitutionally appointed as of the date that this court issued its decision in *Arthrex* and that no remand is required. Caterpillar contends that even if the panel members became constitutional immediately prior to issuing the final written decision, that "does not

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cure a year's worth of constitutional violations influencing the Board's thinking and conclusions." The court in *Arthrex* considered and rejected that argument, expressly limiting its holding "to those cases where final written decisions were issued." 941 F.3d at 1340. *See also Arthrex, Inc. v. Smith & Nephew, Inc.*, 953 F.3d 760, 764 (Fed. Cir. 2020) (Moore, J., concurring in denial of rehearing) ("Because the APJs were constitutionally appointed as of the implementation of the severance, *inter partes* review decisions going forward were no longer rendered by unconstitutional panels.").

Accordingly,

IT IS ORDERED THAT:

- (1) The motion to vacate and remand is denied.
- (2) Caterpillar's opening brief is due within 30 days from the date of filing of this order.

FOR THE COURT

May 6, 2020
Date

/s/ Peter R. Marksteiner
Peter R. Marksteiner
Clerk of Court