NOTE: This order is nonprecedential.

United States Court of Appeals for the Federal Circuit

LG ELECTRONICS, INC.,
Appellant

v.

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

2017-1765

Appeal from the United States Patent and Trademark Office, Patent Trial and Appeal Board in No. IPR2015-01411.

Before LOURIE, CHEN, and STOLL, *Circuit Judges.*

PER CURIAM.

O R D E R

The United States Patent and Trademark Office ("PTO") has filed a request for a bill of costs in the amount of $387.60 in this appeal. For the reasons that follow, we decline the PTO's request for costs.

Advanced Micro Devices, Inc. ("AMD") petitioned for *inter partes* review of claims 1, 9–13, 15, 19, and 20 of U.S. Patent 7,664,971 owned by LG Electronics Inc. ("LG"). The PTO Patent Trial and Appeal Board ("the Board") determined that all of the challenged claims would have been obvious over the prior art. *See Advanced Micro Devices, Inc. v. LG Elecs. Inc.*, No. IPR2015-01411, 2017 WL 378524, at *12 (P.T.A.B. Jan. 4, 2017).

LG appealed to this court from the Board's final written decision, and shortly after LG filed its opening brief, AMD moved to withdraw as a party to the appeal. The PTO then timely exercised its right to intervene. *See* 35 U.S.C. § 143. After oral argument, we affirmed the decision of the Board pursuant to Federal Circuit Rule 36. *LG Elecs., Inc. v. Iancu*, 738 F. App'x 1019, 1019 (Fed. Cir. 2018). The PTO then filed a bill of costs for $387.60 pursuant to Federal Circuit Rule 39 and its practice notes.

Under Federal Rule of Appellate Procedure 39(a)(2), "if a judgment is affirmed, costs are taxed against the appellant." However, when costs are for or against the United States, the costs "will be assessed under Rule 39(a) *only if authorized by law*." Fed. R. App. P. 39(b) (emphasis added). Our practice notes to Rule 39 cite as one such authorization 28 U.S.C. § 2412(a), which states that costs "*may be* awarded to the prevailing party in any civil action *brought by or against the United States* . . . ." 28 U.S.C. § 2412(a) (emphases added). Thus, costs for or against the United States are permitted (but not required) in civil actions brought by or against the United States. *Id.*

This appeal was not brought by or against the United States. It was a dispute arising between two private parties, AMD and LG. The PTO was an intervenor, which, although having a right to intervene, *see* 35 U.S.C. § 143, had no obligation to intervene. No one asked it to

intervene. It was in effect a volunteer. Section 2412(a) is therefore not applicable to this case.

While 35 U.S.C. § 143 does give the PTO the right to intervene in an appeal from an *inter partes* review, it is silent regarding costs. We do not interpret this silence as an entitlement to costs, especially when Congress has expressly accounted for costs in other situations. For example, 28 U.S.C. § 2403 expressly states that the United States as an intervenor "shall . . . have all the rights of a party and be subject to all liabilities of a party as to court costs to the extent necessary for a proper presentation of the facts and law" in an action "wherein the constitutionality of any Act of Congress affecting the public interest is drawn into question." Congress has not similarly acted with respect to 35 U.S.C. § 143.

We therefore decline to award costs in these circumstances.

IT IS ORDERED THAT:

The intervenor's request for costs is denied.

FOR THE COURT

November 5, 2018
Date

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