

No. 19-455

In the Supreme Court of the United States

ARRIS INTERNATIONAL LIMITED, PETITIONER

v.

CHANBOND, LLC, ET AL.

*ON PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT*

**BRIEF FOR THE FEDERAL RESPONDENT
IN OPPOSITION**

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QUESTION PRESENTED

In the Leahy-Smith America Invents Act (AIA), Pub. L. No. 112-29, 125 Stat. 284, Congress authorized the U.S. Patent and Trademark Office (USPTO) to reconsider the patentability of an issued patent at the request of a third party through an administrative process called inter partes review. The AIA authorizes judicial review of the Board's "final written decision with respect to the patentability" of the challenged patent claims, which is issued "[i]f an inter partes review is instituted and not dismissed." 35 U.S.C. 318(a), 319. The question presented is as follows:

Whether the USPTO's decision not to institute an inter partes review on the ground that the petition was time-barred under 35 U.S.C. 315(b) is judicially reviewable by the Federal Circuit.

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OPINIONS BELOW

The order of the court of appeals (Pet. App. 1a-4a) is not published in the Federal Reporter but is reprinted at 773 Fed. Appx. 605. The redacted decisions of the United States Patent and Trademark Office (Pet. App. 5a-30a, 31a-55a, 56a-80a, 81a-105a, 106a-130a) are unreported.

JURISDICTION

The judgment of the court of appeals was entered on December 27, 2018. A petition for rehearing was denied on April 26, 2019 (Pet. App. 131a-132a). The petition for a writ of certiorari was filed on July 25, 2019. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

STATEMENT

1. a. The Patent Act of 1952 (Patent Act), 35 U.S.C. 1 *et seq.*, charges the U.S. Patent and Trademark Office (USPTO) with examining applications for patents, and it directs the USPTO to issue a patent if the statutory criteria are satisfied. 35 U.S.C. 131. Federal law has long permitted the USPTO to reconsider the patentability of the inventions claimed in issued patents. In the Leahy-Smith America Invents Act (AIA), Pub. L. No. 112-29, 125 Stat. 284, Congress substantially expanded those procedures. See *Oil States Energy Servs., LLC v. Greene's Energy Grp., LLC*, 138 S. Ct. 1365, 1370 (2018); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2137-2138 (2016). Congress enacted the AIA to “establish a more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs.” H.R. Rep. No. 98, 112th Cong., 1st Sess. Pt. 1, at 39-40 (2011).

The AIA established new procedures for third parties to challenge the patentability of claims in issued patents. Such challenges are heard and decided by a Patent Trial and Appeal Board (Board). For challenges to patentability brought within nine months after the disputed patent was issued, the AIA established a procedure known as post-grant review, which allows challenges to patentability on any ground that could be asserted as a defense to a claim of infringement. 35 U.S.C. 321(b)-(c); see 35 U.S.C. 321-329. For challenges brought after that nine-month period, the AIA established inter partes review, which is limited to challenges based on prior art consisting of patents and printed publications. 35 U.S.C. 311(b)-(c); see 35 U.S.C. 311-319. Any “person who is not the owner of a patent” may

petition for either post-grant review or inter partes review. 35 U.S.C. 311(a), 321(a). This case concerns inter partes review.¹

b. Inter partes review proceeds in two phases. When a petition for inter partes review is filed, the USPTO first must determine whether to institute a review. 35 U.S.C. 314(a). The institution decision is made on the basis of the petition and any response that the patent owner files, and it must be made within three months after the USPTO receives the patent owner's response or, if no response is filed, "the last date on which such response may be filed." 35 U.S.C. 314(b). The Director has delegated this responsibility to the Board. 37 C.F.R. 42.4(a).

The AIA does not require the agency to grant inter partes review in any circumstance, but it identifies certain circumstances in which the agency *may not* institute such review. See *Cuozzo*, 136 S. Ct. at 2137, 2140. The USPTO may not institute review unless the agency determines that "there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. 314(a). Inter partes review also "may not be instituted" if (1) "before the date on which the petition for such a review is filed, the petitioner or real party in interest filed

¹ The AIA introduced an additional mechanism for reconsidering the patentability of claims for "covered business method[s]." AIA § 18, 125 Stat. 329-331 (capitalization omitted). Covered-business-method (CBM) review proceedings generally "employ the standards and procedures of[] a post-grant review," § 18(a)(1), 125 Stat. 329, but a party may file a petition for CBM review at any time during the term of the patent, see § 18(a)(1)(A), 125 Stat. 329. The CBM-review program is scheduled to expire on September 16, 2020. See § 18(a)(3)(A), 125 Stat. 330; 77 Fed. Reg. 48,680, 48,687 (Aug. 14, 2012).

a civil action challenging the validity of a claim of the patent”; or (2) “the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent.” 35 U.S.C. 315(a)(1)-(b). The determination “whether to institute an inter partes review” is “final and nonappealable.” 35 U.S.C. 314(d).

If the USPTO elects to institute inter partes review, the Board conducts a trial-like proceeding to determine the patentability of the claims at issue. See 35 U.S.C. 316; 37 C.F.R. Pt. 42, Subpt. A. During this second phase, both parties are entitled to take limited discovery, 35 U.S.C. 316(a)(5); to file affidavits and declarations, 35 U.S.C. 316(a)(8); to request an oral hearing, 35 U.S.C. 316(a)(10); and to file written memoranda, 35 U.S.C. 316(a)(8) and (13). At the end of the proceeding (unless the matter has been dismissed), the Board must “issue a final written decision with respect to the patentability of any patent claim challenged by the petitioner.” 35 U.S.C. 318(a). A party aggrieved by the Board’s final written decision may appeal that decision to the Federal Circuit. 35 U.S.C. 141(e), 319.

2. In September 2015, respondent ChanBond, LLC sued several telecommunications companies in federal district court, alleging infringement of U.S. Patent Nos. 7,941,822, 8,341,679, and 8,984,565. Pet. App. 2a. In February 2018, petitioner filed five petitions requesting that the Board institute inter partes review of various claims in the same three patents owned by ChanBond. *Ibid.*

The Board declined to institute inter partes review. Pet. App. 5a-30a, 31a-55a, 56a-80a, 81a-105a, 106a-130a.²

² The Board offered substantially identical explanations for its denial of each of petitioner’s five inter partes review petitions. For

The Board determined in each case that Section 315(b) barred institution of inter partes review because “the petition requesting the proceeding [wa]s filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner [wa]s served with a complaint alleging infringement of the patent.” 35 U.S.C. 315(b); see, *e.g.*, Pet. App. 6a-7a. The Board found that, although petitioner was not a named defendant in the earlier-filed litigation, it was “the supplier for at least one of the allegedly infringing products” and had entered into indemnification agreements that gave it “‘sole control’” of at least some defendants’ defenses. Pet. App. 18a-19a (citation and emphasis omitted). The Board determined that petitioner’s relationship with the defendants in that litigation was thus “‘sufficiently close’” to create “a privity relationship.” *Id.* at 11a (citation omitted). Because “those defendants were served with a complaint[] * * * alleging infringement * * * more than one year prior to the filing of the instant [p]etition[s]” for inter partes review, the Board concluded that the petitions were “time-barred under § 315(b).” *Id.* at 24a.

3. Petitioner appealed all five of the Board’s non-institution decisions to the Federal Circuit, and the court consolidated the appeals. Pet. App. 1a. Respondent ChanBond moved to dismiss, and the Director of the USPTO intervened under 35 U.S.C. 143 to support dismissal. Pet. App. 2a. In an unpublished order, the court of appeals dismissed petitioner’s appeal for lack of jurisdiction. *Id.* at 1a-4a.

Relying on its earlier decision in *St. Jude Medical, Cardiology Division, Inc. v. Volcano Corp.*, 749 F.3d

ease of reference, we cite only to the Board’s resolution of case number IPR2018-570. Pet. App. 5a-30a.

1373 (2014), the Federal Circuit held that “a ‘determination * * * whether to institute’ [an inter partes review] proceeding” is not a “‘final written decision’” under Section 318(a), and that the court’s “review authority under 28 U.S.C. 1295(a)(4)(A) does not extend to appeals from decisions not to institute.” Pet. App. 3a (citation omitted). The court distinguished its recent en banc decision in *Wi-Fi One, LLC v. Broadcom Corp.*, 878 F.3d 1364 (Fed. Cir. 2018), in which the court had reviewed the Board’s Section 315(b) determination on appeal from the Board’s final written decision. The court explained that, unlike in this case, the Board decision that was appealed in *Wi-Fi One* was “not a decision denying institution.” Pet. App. 3a. The court distinguished *Arthrex, Inc. v. Smith & Nephew, Inc.*, 880 F.3d 1345 (Fed. Cir. 2018), on similar grounds, explaining that “[f]ar from review over a non-institution decision, *Arthrex* concerned the issue of whether a party could appeal from a final adverse judgment entered under 37 C.F.R. § 42.73(b).” Pet. App. 3a-4a.

4. The court of appeals denied rehearing en banc without noted dissent. Pet. App. 131a-132a.

ARGUMENT

Petitioner contends (Pet. 16-27) that a USPTO decision declining to institute inter partes review based on the time bar in Section 315(b) is appealable to the Federal Circuit. Under the AIA, however, it is “the final written decision of the [Board] under section 318(a)” that is subject to judicial review. 35 U.S.C. 319. And under Section 318(a), the Board issues a “final written decision” only “[i]f an inter partes review is instituted and not dismissed.” 35 U.S.C. 318(a). The Federal Circuit thus correctly dismissed petitioner’s appeals of the

Board's determinations not to institute inter partes review in this case. Further review is not warranted.

1. a. The Federal Circuit correctly dismissed petitioner's appeals of the USPTO's decisions declining to institute inter partes review. Inter partes review proceeds in two phases—institution and trial. “A party dissatisfied with the final written decision of the [Board] * * * may appeal the decision pursuant to sections 141 through 144.” 35 U.S.C. 319. Sections 141 through 144 establish the procedures for appeals from the USPTO to the Federal Circuit, including the manner by which such an appeal is initiated, that the Director of the USPTO may participate, and that the record for review is transmitted from the agency to the court of appeals. 35 U.S.C. 141-144. Section 141(c) reiterates that “[a] party to an inter partes review * * * who is dissatisfied with the final written decision of the [Board] under section 318(a) * * * may appeal the Board's decision only to the United States Court of Appeals for the Federal Circuit.” 35 U.S.C. 141(c).

Section 318(a) in turn provides that, “[i]f an inter partes review is instituted and not dismissed[,] * * * the [Board] shall issue a final written decision with respect to the patentability” of the challenged patent claims. 35 U.S.C. 318(a). A USPTO decision *not* to institute an inter partes review at the initial stage of the process is not a “final written decision * * * under section 318(a),” 35 U.S.C. 319, and therefore is not appealable under Sections 319 and 141(c). “[T]he statutory provisions addressing *inter partes* review contain no authorization to appeal a non-institution decision” to the Federal Circuit or to any other court. *St. Jude Med., Cardiology Div., Inc. v. Volcano Corp.*, 749 F.3d 1373, 1375 (Fed. Cir. 2014). In addition, Section 314(d) states

that “[t]he determination by the Director whether to institute an inter partes review under this section shall be final and nonappealable.” 35 U.S.C. 314(d).

b. Contrary to petitioner’s contention (Pet. 22-25), 28 U.S.C. 1295(a)(4)(A) does not independently provide a right to appeal the Board’s non-institution decisions. Section 1295 grants the Federal Circuit “exclusive jurisdiction” over an “appeal from a decision of * * * [the Board] with respect to a patent application, derivation proceeding, reexamination, post-grant review, or inter partes review under title 35.” 28 U.S.C. 1295(a)(4)(A). That provision addresses jurisdiction but does not confer a right to appeal. It “is most naturally read” to grant the Federal Circuit exclusive jurisdiction over whatever appeals are separately authorized by the Patent Act, including appeals of the Board’s final written decisions in inter partes reviews as authorized by Sections 319 and 141(c). *St. Jude*, 749 F.3d at 1376; see *GTNX, Inc. v. INTTRA, Inc.*, 789 F.3d 1309, 1312 (Fed. Cir. 2015) (concluding, in the context of covered-business-method review, that a Board decision vacating an earlier institution decision was “outside 28 U.S.C. § 1295(a)(4)(A)”). As explained above, no provision of the Patent Act authorizes an appeal of the USPTO’s decision not to institute an inter partes review.

Arthrex, Inc. v. Smith & Nephew, Inc., 880 F.3d 1345 (Fed. Cir. 2018), is not to the contrary. *Arthrex* did not involve a non-institution decision. In that case, the patent owner responded to a petition for inter partes review by disclaiming all of the challenged patent claims. *Id.* at 1347; see 35 U.S.C. 253(a). Rather than declining to institute inter partes review under 37 C.F.R. 42.71(a) on that basis, the Board entered a final judgment

against the patent owner under 37 C.F.R. 42.73. *Arthrex*, 880 F.3d at 1347. As a result, estoppel attached to the Board’s decision, precluding the patent owner “from taking action inconsistent with the adverse judgment” in its three pending patent continuation applications. *Ibid.* (citation omitted).

The Federal Circuit held that, at least taken together, Section 1295 and the Administrative Procedure Act (APA), 5 U.S.C. 701 *et seq.*, gave the patent owner a right to appeal “a final decision that disposes of an [inter partes review] proceeding in the form of an adverse judgment.” *Arthrex*, 880 F.3d at 1349; see *id.* at 1348 n.1 (“We need not decide whether the right to appeal comes directly from § 1295 or in conjunction with § 704 of the APA.”); see 5 U.S.C. 701-706 (conferring a right to judicial review to persons aggrieved by certain final agency actions). The court distinguished *St. Jude* on the ground that *St. Jude* “did not involve a similar situation” and did not address “the availability of appeal of final adverse judgment decisions.” *Arthrex*, 880 F.3d at 1349.

c. Petitioner contends that the APA similarly supplies “a cause of action * * * to challenge the Director’s discretionary decision” against instituting inter partes review. Pet. 27. That argument lacks merit. The APA’s cause of action does not apply to the extent that an agency action is “committed to agency discretion by law,” 5 U.S.C. 701(a)(2), and the USPTO’s “decision to deny a petition [for inter partes review] is a matter committed to [its] discretion.” *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (citing 5 U.S.C. 701(a)(2)).

For purposes of Section 701(a)(2), it is irrelevant that the Board’s decision not to institute review in this case was based on its determination that Section 315(b)

barred institution, rather than on an avowed exercise of agency discretion. The AIA contains “no mandate to institute review” under any circumstances. *Cuozzo*, 136 S. Ct. at 2140. And where a type of action is “committed to agency discretion” under Section 701(a)(2), an agency’s stated reasons for taking that action cannot make it reviewable. “[I]t is the [agency’s] formal action, rather than its discussion, that is dispositive.” *ICC v. Brotherhood of Locomotive Eng’rs*, 482 U.S. 270, 281 (1987); see *id.* at 283 (rejecting “the principle that if the agency gives a ‘reviewable’ reason for otherwise unreviewable action, the action becomes reviewable”).

Contrary to petitioner’s assertion (Pet. 26), *Weyerhaeuser Co. v. United States Fish & Wildlife Service*, 139 S. Ct. 361 (2018), does not stand for the proposition that an agency action “committed to agency discretion” is nevertheless reviewable under the APA. In *Weyerhaeuser*, this Court considered whether an agency’s decision to designate or exclude certain lands as “critical habitat” under the Endangered Species Act was committed to agency discretion and therefore unreviewable. See *id.* at 369-372. The Court noted the “tension” between Section 701(a)(2)’s command that the APA does not apply to agency actions “committed to agency discretion by law,” and Section 706(2)(A)’s authorization for courts to set aside agency action that is “an abuse of discretion.” *Id.* at 370 (citations omitted). It observed that, in order “[t]o give effect to § 706(2)(A),” the Court has “read the exception in § 701(a)(2) quite narrowly,” rather than as covering every case in which an agency possesses some discretion whether to take the challenged action. *Ibid.*

The *Weyerhaeuser* Court concluded that the Secretary’s critical-habitat determination was not “committed to agency discretion by law” under Section 701(a)(2). 139 S. Ct. 370-372 (citation omitted). The Court explained that a critical-habitat determination was the sort of agency action “affecting the rights of a private party” that has traditionally been regarded as reviewable. *Id.* at 370. And it observed that, although the Secretary possessed some discretion in determining whether to exclude certain area from a critical-habitat designation, the statute “mandated * * * the Secretary to consider the economic and other impacts of designation when making his exclusion decisions.” *Id.* at 371. The Court concluded on that basis that the decision was not “committed to agency discretion by law” within the meaning of Section 701(a)(2), and therefore was reviewable under the APA. *Id.* at 370-371 (citation omitted).

Non-institution decisions do not carry similar effects for the rights of private parties. In contrast with a final written decision, the USPTO’s decision not to institute an inter partes review leaves the petitioner with the same ways to challenge the validity of a patent—such as petitioning for ex parte reexamination by the agency, seeking a declaratory judgment from a district court, or asserting unpatentability as an affirmative defense in a patent-infringement suit—that were available before the non-institution decision was made. Indeed, although petitioner makes several passing references to “estoppels that follow a petitioner,” *e.g.*, Pet. 16, under the AIA estoppel flows from only those inter partes review proceedings that “result[] in a final written decision under section 318(a).” 35 U.S.C. 315(e). Although other adjudicatory bodies sometimes may choose to rely on a USPTO non-institution order as persuasive authority,

administrative proceedings have preclusive effect only “if the ordinary elements of issue preclusion are met,” including that the issue “is actually litigated and determined by a valid and final judgment.” *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 1299, 1303 (2015) (quoting Restatement (Second) of Judgments § 27, at 250 (1982)). *Weyerhaeuser* thus provides no basis to question this Court’s earlier conclusion that non-institution decisions are committed to agency discretion by law. See *Cuozzo*, 136 S. Ct. at 2140 (citing 5 U.S.C. 701(a)(2)).³

2. Properly construed, Section 314(d) of Title 35 provides an independent basis for the Federal Circuit’s dismissal of petitioner’s appeal. Section 314(d) states that “[t]he determination by the Director whether to institute an inter partes review under this section shall be final and nonappealable.” 35 U.S.C. 314(d). Section 314—*i.e.*, “this section”—provides the only authority under which the Director “shall determine whether to institute an inter partes review.” 35 U.S.C. 314(b); see *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1353 (2018).

³ Petitioner has no legal entitlement to inter partes review under any circumstances, see *Cuozzo*, 136 S. Ct. at 2140, and the USPTO’s determination not to initiate a review did not deprive it of any cognizable property or liberty right. There is consequently no merit to petitioner’s assertions (Pet. *i*, 3, 14, 16, 19, 21, 28) that it has been denied due process. See *Mathews v. Eldridge*, 424 U.S. 319, 332 (1976) (“Procedural due process imposes constraints on governmental decisions which deprive individuals of ‘liberty’ or ‘property’ interests within the meaning of the Due Process Clause of the Fifth or Fourteenth Amendment.”). In any event, petitioner did not raise any due process argument in the Federal Circuit until its petition for rehearing en banc, and the court below did not address the issue in the unpublished decision of which petitioner seeks review.

Section 315(b) speaks directly and exclusively to the Director’s institution decision, providing that “[a]n inter partes review *may not be instituted* if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent.” 35 U.S.C. 315(b) (emphasis added). Accordingly, the USPTO’s decisions not to institute inter partes reviews at petitioner’s behest are “not appealable” because “that is what § 314(d) says.” *Cuozzo*, 136 S. Ct. at 2139.

As petitioner observes (Pet. 18), the Federal Circuit has held that Section 314(d) does not preclude that court from considering, on an appeal from the USPTO’s final written decision addressing the merits of the parties’ patentability dispute, whether Section 315(b) should have barred the institution of that inter partes review. *Wi-Fi One, LLC v. Broadcom Corp.*, 878 F.3d 1364, 1374 (Fed. Cir. 2018). In *Thryv, Inc., fka Dex Media, Inc. v. Click-to-Call Technologies, LP*, cert. granted, No. 18-916 (June 24, 2019), the Court has granted review to consider that question. The government has filed a brief in *Thryv*, disagreeing with the *Wi-Fi One* court’s determination. Briefing in *Thryv* is complete, and the Court has scheduled oral argument for December 9, 2019.

If this Court concludes in *Thryv* that Section 314(d) precludes judicial review of the USPTO’s Section 315(b) determinations on appeal from a final written decision, that holding would provide an additional ground for concluding that the Federal Circuit lacked jurisdiction to review petitioner’s challenges to the USPTO’s non-institution decisions here. But even if this Court renders a contrary holding in *Thryv*, its decision is unlikely

to cast doubt on the Federal Circuit's dismissal of petitioner's appeals. The question in *Thryv* is whether, in exercising its jurisdiction to review the Board's final written decision on the merits of patentability, the court of appeals can consider the patent holder's contention that Section 315(b) barred the review. Here, by contrast, the Board never issued an appealable final written decision because the USPTO declined to institute the requested review.

Because the Board never issued a final written decision, this case (unlike *Thryv*) does not present any questions concerning the scope of the Federal Circuit's review authority under Section 319. And as explained above, the Federal Circuit's decision in this case rests on the independent ground that no provision in the AIA or the APA affirmatively authorizes judicial review of the USPTO's non-institution decision. Dismissal of the appeals on that ground was correct, regardless of whether or how Section 314(d) applies to Section 315(b) determinations. There is accordingly no need for the Court to hold the petition in this case pending the Court's disposition of *Thryv*.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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