

No. 18-916

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**In the Supreme Court of the United States**

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THRYV, INC., FKA DEX MEDIA, INC., PETITIONER

*v.*

CLICK-TO-CALL TECHNOLOGIES, LP, ET AL.

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

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**BRIEF FOR THE FEDERAL RESPONDENT  
SUPPORTING REVERSAL**

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### **QUESTION PRESENTED**

Whether, in an appeal from the final written decision of the Patent Trial and Appeal Board in an inter partes review, the Federal Circuit is authorized to vacate the Board's decision as to patentability on the ground that the review was improperly instituted because the petition was time-barred by 35 U.S.C. 315(b).

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## **OPINIONS BELOW**

The first opinion of the court of appeals (Pet. App. 1a-5a) dismissing for lack of jurisdiction is not published in the Federal Reporter but is reprinted at 622 Fed. Appx. 907. The second opinion of the court of appeals (Pet. App. 6a-28a) dismissing for lack of jurisdiction is not published in the Federal Reporter but is available at 2016 WL 6803054. An order of the court of appeals (Pet. App. 29a-32a) granting panel rehearing is not published in the Federal Reporter but is reprinted at 710 Fed. Appx. 447. The opinion of the court of appeals (Pet. App. 33a-106a) addressing the merits and vacating the final written decision of the Patent Trial and Appeal Board (Board) is reported at 899 F.3d 1321. The final written decision of the Board (Pet. App. 107a-138a) is not published but is available at 2014 WL 5490583. The Board's decision (Pet. App. 144a-176a) to institute inter

partes review is not published but is available at 2013 WL 11311788.

#### JURISDICTION

The judgment of the court of appeals was entered on August 16, 2018. On November 7, 2018, the Chief Justice extended the time within which to file a petition for a writ of certiorari to and including December 14, 2018. On November 20, 2018, the Chief Justice further extended the time to and including January 11, 2019, and the petition was filed on that date. The petition for a writ of certiorari was granted on June 24, 2019, as to the first question presented. The jurisdiction of this Court rests on 28 U.S.C. 1254(1).

#### STATUTORY PROVISIONS INVOLVED

The pertinent statutory provisions are reprinted in an appendix to this brief. App., *infra*, 1a-23a.

#### STATEMENT

##### A. Statutory Background

1. 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. See *Oil States Energy Servs., LLC v. Greene's Energy Grp., LLC*, 138 S. Ct. 1365, 1370 (2018). In the Leahy-Smith America Invents Act (AIA), Pub. L. No. 112-29, 125 Stat. 284, Congress expanded those administrative reconsideration procedures in an effort 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) (House Report).

The AIA established three new procedures, to be conducted before the USPTO’s Patent Trial and Appeal Board (Board), through which third parties may challenge the patentability of claims in issued patents. 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 lack of novelty (35 U.S.C. 102) or obviousness (35 U.S.C. 103), and only on the basis of prior-art patents and printed publications. 35 U.S.C. 311(b)-(c); see 35 U.S.C. 311-319. And for challenges to “covered business method” (CBM) patents, the AIA created a special “transitional post-grant review proceeding,” which generally “employ[s] the standards and procedures of[] a post-grant review,” but may be requested at any time during the term of the CBM patent. AIA § 18(a)(1), 125 Stat. 329.<sup>1</sup>

This case concerns inter partes review. To implement that new administrative-review scheme, Congress granted the USPTO new rulemaking authority. See 35 U.S.C. 316(a); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2142 (2016). Among other things, Con-

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<sup>1</sup> The CBM review program is scheduled to expire on September 16, 2020. See AIA § 18(a)(3)(A), 125 Stat. 330; 77 Fed. Reg. 48,680, 48,687 (Aug. 14, 2012).

gress authorized the USPTO to issue regulations “establishing and governing inter partes review” and “the relationship of such review to other proceedings,” as well as regulations “setting forth the standards for the showing of sufficient grounds to institute a review under section 314(a).” 35 U.S.C. 316(a)(2) and (4). Pursuant to that authority, the USPTO has promulgated regulations governing the initiation, conduct, and disposition of inter partes review proceedings. See 37 C.F.R. Pt. 42, Subpts. A-B.

2. Under the AIA and the USPTO regulations, inter partes review proceeds in two phases—institution and trial.

a. When a petition for review is filed, the USPTO first must determine whether to institute review. 35 U.S.C. 314. Under the AIA, the agency is not *required* to institute review in any circumstance. See *Cuozzo*, 136 S. Ct. at 2137, 2140. The AIA identifies certain circumstances, however, in which the agency may *not* institute review. The USPTO may not institute inter partes review unless the Director 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 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 institution decision is made on the basis of the petition and any response that is filed by the patent owner, and it must be made within three months after the agency receives the patent owner's response or, if no such response is submitted, "the last date on which such response may be filed." 35 U.S.C. 314(b)(2). By regulation, the Director has delegated to the Board his authority to determine whether particular inter partes reviews should be instituted. 37 C.F.R. 42.4(a). To enable the Board to make that determination, the USPTO requires a petitioner to set forth in any petition for inter partes review (1) "a statement of the precise relief requested" for each challenged patent claim, including the statutory grounds on which the challenge is based and how the challenged claim is unpatentable under those grounds; and (2) a certification that "the patent for which review is sought is available for inter partes review and that the petitioner is not barred or estopped from requesting an *inter partes* review challenging the patent claims on the grounds identified in the petition." 37 C.F.R. 42.104(a)-(b).

A party dissatisfied with the decision whether to institute inter partes review may request rehearing by the Board within 14 days of a decision to institute review or within 30 days of a decision not to institute review. See 37 C.F.R. 42.71(c)-(d). If the institution decision presents significant policy or procedural issues, the party may also suggest review by the USPTO's Precedential Opinion Panel—a panel of the Board generally consisting of the Director, the Commissioner for Patents, and the Chief Administrative Patent Judge, or their delegates. Patent Trial and Appeal Board, USPTO, *Standard Operating Procedure 2 (Rev. 10)*:

*Precedential Opinion Panel to Decide Issues of Exception Importance Involving Policy or Procedure 3-5* (Sept. 20, 2018), <https://go.usa.gov/xVBsS>. With respect to judicial review, however, the AIA provides that the USPTO’s “determination \* \* \* whether to institute an inter partes review under this section shall be final and nonappealable.” 35 U.S.C. 314(d).

b. If the agency institutes inter partes review, the Board then conducts the proceeding to determine the patentability of the claims at issue with “many of the usual trappings of litigation.” *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1354 (2018); see 35 U.S.C. 316; 37 C.F.R. Pt. 42, Subpt. A. During this second phase, the parties are entitled to take limited discovery, 35 U.S.C. 316(a)(5); 37 C.F.R. 42.51-42.53; to file affidavits and declarations, 35 U.S.C. 316(a)(8); 37 C.F.R. 42.63; to request an oral hearing, 35 U.S.C. 316(a)(10); 37 C.F.R. 42.70; and to file written memoranda, 35 U.S.C. 316(a)(8) and (13); 37 C.F.R. 42.120. 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 dissatisfied with the final written decision of the Patent Trial and Appeal Board under [S]ection 318(a) may appeal the decision” to the Federal Circuit. 35 U.S.C. 319; see 35 U.S.C. 141(c), 144.

#### **B. The Present Controversy**

1. Petitioner Thryv, Inc. (formerly known as Dex Media, Inc.) is the successor in interest to Ingenio, Inc., a company formed through a 2003 merger of Inforocket.Com, Inc. and Keen, Inc. Pet. 5. In September 2001, Inforocket had previously served on Keen a complaint alleging infringement of U.S. Patent No.

5,818,836 (the '836 patent). Pet. App. 35a. After Keen acquired Inforocket, however, the companies stipulated to a voluntary dismissal of the suit without prejudice. *Id.* at 36a.

In 2011, respondent Click-to-Call Technologies, LP acquired ownership of the '836 patent. Pet. App. 37a; Pet. 5. In May 2012, Click-to-Call sued Ingenio, among others, for infringement of that patent. Pet. App. 37a. Less than one year later, Ingenio petitioned the Board for inter partes review of the '836 patent. *Id.* at 37a-38a.

As noted, the AIA bars institution of inter partes review when “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). Click-to-Call argued that Section 315(b) barred institution pursuant to Ingenio’s petition because Inforocket had served Ingenio’s predecessor-in-interest Keen with a complaint alleging infringement of the '836 patent 12 years earlier. The Board rejected that contention and instituted inter partes review on several of the challenged claims. Pet. App. 144a-176a. The Board concluded that the voluntary dismissal without prejudice of the earlier suit had “le[ft] the parties as though the action had never been brought,” and that the service of the 2001 complaint therefore did not trigger Section 315(b)’s one-year time bar. *Id.* at 161a-162a; see *id.* at 139a-143a (denying rehearing). After conducting the inter partes review, the Board issued a final written decision, in which it found unpatentable each of the claims on which it had instituted review. *Id.* at 107a-138a.<sup>2</sup>

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<sup>2</sup> The Board’s final written decision was issued before this Court held in *SAS Institute* that a final written decision in an inter partes

2. Click-to-Call appealed the Board’s decision to the Federal Circuit, seeking review exclusively “of the Board’s decision to institute” inter partes review. Pet. App. 2a. The government intervened, see 35 U.S.C. 143, arguing that the Board’s application of Section 315(b) in the institution decision was unreviewable and that the Board’s application of that provision was correct.

Initially, the court of appeals dismissed Click-to-Call’s appeal for lack of jurisdiction based on 35 U.S.C. 314(d). Pet. App. 2a-5a. That provision, entitled “NO APPEAL,” 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). Relying on its earlier decision in *Achates Reference Publishing, Inc. v. Apple Inc.*, 803 F.3d 652 (Fed. Cir. 2015), cert. dismissed, 136 S. Ct. 998 (2016), the court of appeals held that Section 314(d) “prohibits [the court] from reviewing the Board’s determination to initiate [inter partes review] proceedings based on its assessment of the time-bar of § 315(b).” Pet. App. 3a (quoting *Achates*, 803 F.3d at 658). It further held that the Board’s decision did not amount to ultra vires agency action that might fall into the “implicit and narrow exception” to statutory bars on judicial review. *Ibid.* (quoting *Achates*, 803 F.3d at 658).

In 2016, this Court granted Click-to-Call’s petition for a writ of certiorari, vacated the court of appeals’ judgment, and remanded the case for further consideration in light of the Court’s intervening decision in *Cuozzo*. 136 S. Ct. 2508.

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review “must address every claim” challenged in the inter partes review petition. 138 S. Ct. at 1354 (emphasis omitted). No party has challenged the Board’s final written decision on those grounds.



On remand from this Court, the court of appeals again dismissed for lack of jurisdiction. Pet. App. 6a-28a. The court relied on its then-recent holding in *Wi-Fi One, LLC v. Broadcom Corp.*, 837 F.3d 1329 (Fed. Cir. 2016), that “*Cuozzo* did not overrule [the court’s] previous decision in *Achates* and that later panels of the court remain bound by” the holding in *Achates* that Section 314(d)’s reviewability bar applies to Section 315(b) determinations. Pet. App. 9a.

3. Shortly thereafter, the Federal Circuit agreed to rehear en banc its *Wi-Fi One* decision. *Wi-Fi One, LLC v. Broadcom Corp.*, 878 F.3d 1364 (2018). The en banc court held that the Board’s determinations regarding the time bar in Section 315(b) are reviewable by the court of appeals notwithstanding Section 314(d). *Id.* at 1367. The majority reasoned that, read in light of “the ‘strong presumption’ favoring judicial review of administrative actions,” *id.* at 1371 (citation omitted), Section 314(d) is best understood as limited to “the determination by the Director whether to institute [inter partes review] as set forth in § 314,” *id.* at 1372. It concluded that Section 314(d) does not preclude review of the Director’s Section 315(b) determination because, in its view, Section 315(b) is not “‘closely related’ to the institution decision addressed in § 314(a).” *Id.* at 1374 (quoting *Cuozzo*, 136 S. Ct. at 2142).

Judge O’Malley concurred, concluding that Section 314(d) bars review only of the substantive adequacy of a petition for inter partes review. *Wi-Fi One*, 878 F.3d at 1375-1377. She stated that judicial review of other determinations is necessary to “prevent the agency from ‘act[ing] outside its statutory limits.’” *Id.* at 1377 (citation omitted; brackets in original).

Judge Hughes, joined by Judges Lourie, Bryson, and Dyk, dissented. *Wi-Fi One*, 878 F.3d at 1377-1382. Judge Hughes would have held that the plain text of Section 314(d) makes Congress's intent to preclude judicial review of the Board's time-bar determinations "clear and unmistakable." *Id.* at 1378. He found confirmation of that reading in the *Cuozzo* Court's statement that Section 314(d) prohibits judicial review of at least those "questions that are closely tied to the application and interpretation of statutes related to the Patent Office's decision to initiate inter partes review." *Ibid.* (quoting *Cuozzo*, 136 S. Ct. at 2141). He noted that Section 315(b), "which describes when an [inter partes review] may be 'instituted,'" is if anything "even more closely related to institution decisions than § 312(a)(3)," the provision at issue in *Cuozzo*. *Id.* at 1377. He concluded that the majority's contrary interpretation ran "counter to the AIA's purpose of 'providing quick and cost effective alternatives to litigation.'" *Id.* at 1382 (citation omitted).

4. Following the en banc court's decision in *Wi-Fi One*, the panel in this case granted rehearing and issued a revised opinion, holding that the Board had erred in instituting inter partes review because the petition was time-barred under Section 315(b). See Pet. App. 29a-32a (rehearing order); *id.* at 33a-106a (revised opinion). The panel held that Section 315(b) "unambiguously precludes the Director [of the USPTO] from instituting an [inter partes review] if the petition seeking institution is filed more than one year after the petitioner \* \* \* 'is served with a complaint' alleging \* \* \* infringement" of the patent at issue, "irrespective of subsequent events." *Id.* at 47a. The court therefore vacated the Board's final written decision and remanded for the

agency to dismiss the petition for inter partes review. *Id.* at 73a.

In a footnote in the panel’s opinion, the court of appeals noted that the en banc court had *sua sponte* considered whether Section 315(b)’s time bar “applies to bar institution when an [inter partes review] petitioner was served with a complaint for patent infringement more than one year before filing its petition, but the district court action in which the petitioner was so served was voluntarily dismissed without prejudice.” Pet. App. 43a n.3. It stated that “[t]he *en banc* court holds that § 315(b)’s time bar applies in such a scenario.” *Ibid.*

Judge Taranto issued a separate opinion, concurring in the panel’s opinion and in footnote 3 of that opinion. Pet. App. 74a-92a. Judge Dyk, joined by Judge Lourie, dissented from footnote 3. *Id.* at 93a-106a. Those judges would have held that the statutory phrase “served with a complaint” is ambiguous as to whether it includes a complaint later dismissed without prejudice; that background principles concerning the effect of voluntary dismissals without prejudice supported the Board’s reading of the statute; and that Section 315(b)’s text and history provided no clear indication that Congress intended to depart from those background principles. *Ibid.*

5. Petitioner filed a petition for a writ of certiorari to review the Federal Circuit’s judgment in this case. In its response to the certiorari petition, the government informed this Court that the Board’s interpretation of Section 315(b) in the institution decision no longer reflected the USPTO’s considered judgment on the proper understanding of that provision. Gov’t Br. in Opp. 10. The government argued, however, that the Federal Circuit lacked jurisdiction to review the

institution decision on that basis. *Ibid.* The Court granted certiorari limited to the jurisdictional question. 139 S. Ct. 2742.

#### SUMMARY OF ARGUMENT

The USPTO’s determination whether a petition for inter partes review is time-barred under 35 U.S.C. 315(b) is not judicially reviewable.

A. The text, structure, and history of the AIA demonstrate that the USPTO’s Section 315(b) determinations are not reviewable. First and foremost, Section 314(d) of the AIA states that the Director’s determination “whether to institute an inter partes review under this section shall be final and nonappealable.” 35 U.S.C. 314(d). Section 315(b) speaks directly and exclusively to the Director’s decision whether to institute inter partes review. A contention that the Director unlawfully instituted review based on a misapplication of section 315(b) is thus “nonappealable” under the plain text of Section 314(d). 35 U.S.C. 314(d).

The broad scope of Section 314(d) is confirmed by a comparison to Section 303(c), which precludes judicial review of the Director’s decision to institute a different form of post-issuance review known as *ex parte* reexamination. Section 303(c) precludes review only of the Director’s determination that “no substantial new question of patentability has been raised.” 35 U.S.C. 303(c). In enacting Section 314(d), Congress used markedly different and more expansive language.

The broad scope of Section 314(d) is also clear from the history of similar provisions in the AIA. Former Section 312(c) of the Patent Act, for example, similarly limited judicial review of the Director’s decision to institute the pre-cursor to inter partes review—known as inter partes reexamination. But former Section 312(c)

precluded review only of the Director’s determination “whether a substantial new question of patentability” had been raised about the challenged patent. 35 U.S.C. 312(a) (2000); see 35 U.S.C. 312(c) (2000).

In the AIA, Congress created a host of prerequisites for instituting inter partes review that did not exist for ex parte or inter partes reexamination. See 35 U.S.C. 311-315, 324. In the same statute, Congress directed 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). If Congress had intended to preclude judicial review only of the Director’s threshold patentability determination—and not the other prerequisites to institution—it could easily have adapted the language of former Section 312(c) to Section 314(a)’s new “reasonable likelihood” standard. Instead, it chose the broader language of Section 314(d). This Court should respect that choice.

B. The Court’s decision in *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131 (2016), confirms that the USPTO’s Section 315(b) determinations are not reviewable. In that case, the Court made clear that Section 314(d) “applies where the grounds for attacking the decision to institute inter partes review consist of questions that are closely tied to the application and interpretation of statutes related to the Patent Office’s decision to initiate inter partes review.” *Id.* at 2141. Accordingly, the Court found that a challenge to the USPTO’s institution decision based on an alleged misapplication of the “particularity” requirement in Section 312(a)(3) was unreviewable on appeal from the Board’s final written decision. 35 U.S.C. 312(a)(3). Like Section 312(a)(3)’s particularity requirement, Section 315(b) involves a “question[] that [is] closely tied to the

application and interpretation of statutes related to the Patent Office’s decision to initiate inter partes review.” *Cuozzo*, 136 S. Ct. at 2141. Indeed, Section 315(b) addresses *only* the institution decision. Section 314(d) “must, at the least, forbid an appeal that attacks a ‘determination . . . whether to institute’ review by raising th[at] kind of legal question and little more.” *Id.* at 2139 (quoting 35 U.S.C. 314(d)).

*SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018), is not to the contrary. There, this Court held that the Board had violated Section 318(a) by failing to address in its final written decision all of the patent claims that had been challenged in the petition for inter partes review. Here, Click-to-Call does not contend that the USPTO violated any statutory provision that governs the conduct or ultimate disposition of inter partes review proceedings after those proceedings have been instituted. Moreover, the Court in *SAS Institute* held that Section 314 authorizes the Director to determine “‘whether’ to institute the requested review—not ‘whether *and to what extent*’ review should proceed”—and it noted that SAS Institute did not challenge the agency’s determination whether review should be instituted, but only the scope of that review. *Id.* at 1356, 1359 (citation omitted). By contrast, Click-to-Call argues that the review at issue here should not have been instituted at all—*i.e.*, whether, not to what extent, inter partes review should have been instituted. That is precisely the determination that Section 314(d) precludes from judicial review.

C. Precluding review of the USPTO’s Section 315(b) determination is consistent with the AIA’s purposes. Allowing judicial review of Click-to-Call’s challenge to

the Board’s institution decision would undermine Congress’s objective to give the USPTO “significant power to revisit and revise earlier patent grants,” by permitting the Federal Circuit to unwind the Board’s final decision on patentability on the basis of an unrelated threshold determination. *Cuozzo*, 136 S. Ct. at 2139-2140. Enforcing Section 314(d) in accordance with its broad literal terms, on the other hand, would further Congress’s efforts to improve patent quality by focusing judicial review on the merits of the Board’s patentability determinations—the only issue that matters to the patent system as a whole.

Finally, the Federal Circuit’s interpretation of Section 314(d) does not meaningfully serve the purposes of Section 315(b)’s time bar. The purpose of Section 315(b) and related provisions is not to prevent the USPTO from reconsidering the validity of any particular patent, but to manage the burden on patent owners and minimize the wasted resources that duplicative judicial and administrative proceedings might entail. Vacating the Board’s final written decision on a patent’s validity *after* arguably duplicative proceedings have been completed, based on a court’s determination that proper application of Section 315(b) *would have* prevented those proceedings, does nothing to further that purpose.

#### ARGUMENT

#### THE USPTO’S DETERMINATION WHETHER A PETITION FOR INTER PARTES REVIEW IS TIME-BARRED UNDER 35 U.S.C. 315(b) IS NOT JUDICIALLY REVIEWABLE

Respondent Click-to-Call argued below, and the Federal Circuit agreed, that the Board’s institution of inter partes review in this case was inconsistent with Section 315(b)’s time bar. The plain text of 35 U.S.C. 314(d) demonstrates that the court of appeals lacked

jurisdiction to review that challenge to the Board’s institution decision. The structure of the AIA, the history of the Patent Act’s similar provisions, and the Court’s decision in *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131 (2016), confirm that conclusion. That reading is also consistent with the purpose of both Section 315(b) and the AIA as a whole. The court of appeals’ contrary judgment should be reversed.

**A. The Text, Structure, And History Of The AIA Demonstrate That The USPTO’s Section 315(b) Determinations Are Not Reviewable**

1. First and foremost, the text of Section 314(d) makes clear that the USPTO’s Section 315(b) determinations are not judicially reviewable. 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). 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, a contention that the Director’s institution of inter partes review was unlawful because the petition was time-barred under Section 315(b) is “not appealable” because “that is what § 314(d) says.” *Cuozzo*, 136 S. Ct. at 2139.



Click-to-Call emphasizes that Section 314(d) precludes review of the Director’s determination “whether to institute an inter partes review *under this section*.” Click-to-Call Br. in Opp. 3 (quoting 35 U.S.C. 314(d)). Click-to-Call contends that the italicized phrase limits Section 314(d) to the Director’s threshold determination under Section 314(a) that “there is a ‘reasonable likelihood’ that the claims are unpatentable.” *Id.* at 4 (citation omitted); see also *Wi-Fi One, LLC v. Broadcom Corp.*, 878 F.3d 1364, 1376 (Fed. Cir. 2018) (O’Malley, J., concurring) (stating that “Section 314(d)’s bar on appellate review is directed to the Director’s assessment of the substantive adequacy of a timely filed petition”). But the phrase “under this section” cannot bear the weight that Click-to-Call ascribes to it. Rather, that phrase “simply refers to the fact that inter partes review is instituted under § 314.” *Wi-Fi One*, 878 F.3d at 1380 (Hughes, J., dissenting).

Section 314(a) instructs the Director, in determining whether an inter partes review should be instituted, to consider all of the “information presented in the petition filed under [S]ection 311 and any response filed under [S]ection 313.” 35 U.S.C. 314(a). That information includes the petitioner’s certification that it “is not barred or estopped from requesting an *inter partes* review challenging the patent claims,” 37 C.F.R. 42.104(a), as well as any information in the patent holder’s response that calls that certification into question, see 35 U.S.C. 313 (providing that the patent owner’s preliminary response may explain “why no inter partes review should be instituted based upon the failure of the petition to meet any requirement of this chapter”); 77 Fed. Reg. 48,756, 48,764 (Aug. 14, 2012) (explaining that a patent owner’s preliminary response under Section 313 may

argue that “[t]he petitioner is statutorily barred from pursuing a review”). A challenge to the Director’s determination to institute review based on his application of Section 315(b) thus is just as much a challenge to the Director’s determination under Section 314 as a challenge based on the Director’s threshold patentability finding.

2. Section 314(d)’s broad scope is confirmed by a comparison to Section 303(c), which limits judicial review of the Director’s decision to institute a different form of post-issuance review known as *ex parte* reexamination. See *Block v. Community Nutrition Inst.*, 467 U.S. 340, 345 (1984) (“Whether and to what extent a particular statute precludes judicial review is determined not only from its express language, but also from the structure of the statutory scheme.”). Section 303 authorizes the USPTO to conduct *ex parte* reexamination of any patent claim, if the Director determines that “a substantial new question of patentability is raised by patents and publications discovered by” the agency or provided by a third party. 35 U.S.C. 303(a). As with *inter partes* review, the Patent Act provides for judicial review of the final decision in an *ex parte* reexamination, but shields from review the Director’s decision whether to institute an *ex parte* reexamination. 35 U.S.C. 141(b), 303(c), 306.

The preclusion of judicial review in Section 303(c), however, is narrower than in Section 314(d). Section 303(c) states that “[a] determination by the Director pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable.” 35 U.S.C. 303(c). It thus precludes judicial review of the Director’s resolution of a specific *issue* (whether the petition raises a

“substantial new question of patentability,” *ibid.*), and only when the Director determines that no such substantial new question exists.

In enacting Section 314(d), by contrast, “Congress used markedly different language for inter partes review \* \* \* proceedings.” *Wi-Fi One*, 878 F.3d at 1381 (Hughes, J., dissenting). Section 314(d) precludes judicial review of “a specific *action* by the Director,” *ibid.* (emphasis altered)—the decision “whether to institute an inter partes review,” 35 U.S.C. 314(d)—without regard to what subsidiary issues the USPTO must resolve before taking that action in a particular case. And unlike Section 303(c), Section 314(d) applies regardless of the outcome of the institution decision. “[W]here Congress includes particular language in one section of a statute but omits it in another section of the same Act, it is generally presumed that Congress acts intentionally and purposely in the disparate inclusion or exclusion.” *Sebelius v. Cloer*, 569 U.S. 369, 378 (2013) (citation omitted). That presumption is particularly salient here, since Congress amended Section 303 in the AIA, but left the differences with Section 314(d) intact. See § 6(h)(1), 125 Stat. 312 (amending Section 303(a)). Congress’s use of different language in the two provisions should be given its natural effect.

3. The history of Section 314(d) and similar provisions reinforces the conclusion that Section 314(d) broadly precludes judicial review of the Director’s institution decisions. In construing similar preclusion-of-review provisions, the Court has often found the statutory history particularly relevant. See, *e.g.*, *Kucana v. Holder*, 558 U.S. 233, 249-251 (2010); *Gutierrez de Martinez v. Lamagno*, 515 U.S. 417, 425-426 (1995); *Lindahl v. OPM*, 470 U.S. 768, 780-790 (1985). The AIA’s post-

issuance review procedures built on a long history of similar mechanisms for reconsidering issued patents, see, e.g., *Oil States Energy Servs., LLC v. Greene's Energy Grp., LLC*, 138 S. Ct. 1365, 1370 (2018), and the development of those mechanisms is instructive here.

a. Over the past several decades, Congress has established and modified several administrative mechanisms by which the agency may revisit existing patents. See *Oil States*, 138 S. Ct. at 1370; House Report 45-46. In 1980, Congress authorized the USPTO to conduct ex parte reexamination of existing patent claims. Act of Dec. 12, 1980 (1980 Act), Pub. L. No. 96-517, 94 Stat. 3015-3017 (35 U.S.C. 301-307 (Supp. IV 1980)). That statute authorized any person to cite to the USPTO “prior art \* \* \* which that person believes to have a bearing on the patentability of any claim of a particular patent.” 35 U.S.C. 301 (Supp. IV 1980). It authorized the USPTO to conduct an ex parte reexamination of any patent claim, either at the request of any person or on the agency’s “own initiative,” if the Director determined that prior art raised a “substantial new question of patentability.” 35 U.S.C. 302, 303(a) (Supp. IV 1980).

The 1980 Act required the Director to determine, within three months after a request for ex parte reexamination was filed, “whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request.” 35 U.S.C. 303(a) (Supp. IV 1980). The statute established no other prerequisites to review. If the Director “f[ound] that a substantial new question of patentability” had been raised, the agency was required to order “reexamination of the patent for resolution of th[at] question.” 35 U.S.C. 304 (Supp. IV 1980). If reexamination was instituted, the proceedings were largely “conducted according to the

procedures established for initial examination,” in which only the USPTO and the patent owner participated. 35 U.S.C. 305 (Supp. IV 1980); see 35 U.S.C. 304 (Supp. IV 1980) (allowing the requester to file one reply to the patent owner’s initial statement). At the conclusion of the proceedings, the patent owner had the right to appeal the USPTO’s final decision. 35 U.S.C. 306 (Supp. IV 1980).

Similar to Section 303(c) today, see p. 18, *supra*, the 1980 Act provided that a “determination by the Commissioner pursuant to subsection (a) of this section that no substantial new question of patentability ha[d] been raised” was “final and nonappealable.” 35 U.S.C. 303(c) (Supp. IV 1980). The Act did not explicitly preclude review of an affirmative determination that such a question *had* been raised or any other aspect of the institution decision. See, e.g., *In re Portola Packaging, Inc.*, 110 F.3d 786, 788 (Fed. Cir. 1997) (reviewing whether *ex parte* reexamination correctly identified a substantial new question of patentability); *Heinl v. Godici*, 143 F. Supp. 2d 593, 596 (E.D. Va. 2001) (noting that Section 303(c) “explicitly addresses only a *denial* of a petition for reexamination, not the *grant* of such a petition”).<sup>3</sup>

b. In 1999, Congress created *inter partes* reexamination—the direct precursor to *inter partes* review. Optional Inter Partes Reexamination Procedure Act of 1999 (1999 Act), Pub. L. No. 106-113, Div. B, Tit. IV,

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<sup>3</sup> Some courts have determined, however, that review of the Director’s decision whether to institute *ex parte* reexamination is largely unavailable, based on the absence of any affirmative statutory authorization to review that decision, and on other aspects of the broader statutory scheme. See *In re Hiniker Co.*, 150 F.3d 1362, 1367 (Fed. Cir. 1998); *Synopsys, Inc. v. Matal*, 280 F. Supp. 3d 823, 831 (E.D. Va. 2017).

Subtit. F, §§ 4601-4608, 113 Stat. 1501A-567 to 1501A-572 (35 U.S.C. 311-318 (2000)). That mechanism afforded “third parties greater opportunities to participate in the [USPTO’s] reexamination proceedings.” *Cuozzo*, 136 S. Ct. at 2137. Under the 1999 Act, as under the 1980 Act, any person could request that the USPTO reexamine the patentability of claims in existing patents on the basis of prior art cited to the USPTO under Section 301. 35 U.S.C. 311(a) (2000). And as under the 1980 Act, the Director was required to determine, within three months of such a request, “whether a substantial new question of patentability affecting any claim of the patent concerned [wa]s raised by the request.” 35 U.S.C. 312(a) (2000).

The 1999 Act established minimal requirements for a request for inter partes reexamination beyond the requirement that it raise a substantial new question of patentability. See 35 U.S.C. 311 (2000) (requiring that the request be in writing, identify the real party in interest, and be accompanied by the requisite fee); 35 U.S.C. 317 (2000) (prohibiting certain subsequent requests by the same parties). The 1999 Act further provided that, if the Director found that a “substantial new question of patentability affecting a claim of a patent is raised, the determination shall include an order for inter partes reexamination of the patent for resolution of the question.” 35 U.S.C. 313 (2000).

Inter partes reexamination was also generally conducted “according to the procedures established for initial examination” of a patent, 35 U.S.C. 314(a) (2000), though it granted the third-party requester further opportunities to participate throughout those reexamination proceedings, see 35 U.S.C. 314(b)(3) (2000) (permit-

ting the requester to respond “[e]ach time that the patent owner file[d] a response to an action on the merits from the Patent and Trademark Office”). After a further statutory amendment in 2002, either the patent owner or the third-party requester could appeal the agency’s final decision to the Federal Circuit. See 21st Century Department of Justice Appropriations Authorization Act, Pub. L. No. 107-273, Div. C, Tit. III, §§ 13106, 13202, 116 Stat. 1900-1902.

Like the 1980 Act, the 1999 Act contained a preclusion-of-review provision concerning the Director’s initial institution decision. 35 U.S.C. 312(c) (2000). Unlike Section 303(c), however, former Section 312(c) was not limited to the Director’s determination that “*no* substantial new question of patentability had been raised,” 35 U.S.C. 303(c) (Supp. IV 1980) (emphasis added). Instead, it provided that “[a] determination by the Director under subsection (a)—*i.e.*, the agency’s “determin[ation] *whether* a substantial new question of patentability” was raised, 35 U.S.C. 312(a) (2000) (emphasis added)—“shall be final and non-appealable.” 35 U.S.C. 312(c) (2000). Former Section 312(c) thus unambiguously precluded review of the Director’s threshold determination even in cases where the Director had found that a substantial new question of patentability *had* been raised. See *Belkin Int’l, Inc. v. Kappos*, 696 F.3d 1379, 1383-1384 (Fed. Cir. 2012). Some courts concluded, however, that former Section 312(c) precluded review of *only* the “substantial new question of patentability” determination, not of other USPTO determinations related to the institution of inter partes reexamination. See, *e.g.*, *Callaway Golf Co. v. Kappos*, 802 F. Supp. 2d 678, 685 (E.D. Va. 2011) (“Section 312(c)

only exempts from judicial review the PTO's substantive determination that a reexamination application raises 'a substantial new question of patentability.'").

c. When Congress replaced inter partes reexamination with inter partes review in the AIA, it made significant changes to the procedures. On the one hand, Congress imposed a host of new or expanded prerequisites to instituting inter partes review. In addition to Section 315(b)'s new time bar for initiating review, the Director must consider whether the petition is filed later than nine months after the challenged patent was granted or reissued, 35 U.S.C. 311; whether the petition is accompanied by payment of the required fee, 35 U.S.C. 312(a)(1); whether the petition identifies all "real parties in interest," 35 U.S.C. 312(a)(2); whether the petition identifies, "in writing and with particularity," each of the challenged patent claims, along with the grounds on which each claim is challenged and the evidence that supports each ground, 35 U.S.C. 312(a)(3); whether the patent owner has been properly served with those materials, 35 U.S.C. 312(a)(5); whether those materials, considered along with any preliminary response from the patent owner, show 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); whether the petitioner had previously participated in an inter partes review in which the same ground for invalidity was raised or could have been raised, 35 U.S.C. 315(e)(1); and whether the petitioner had previously participated in a post-grant review in which the same ground for invalidity was raised or could have been raised, 35 U.S.C. 324(e)(1).

In the same statute that established those numerous prerequisites to agency review, Congress directed 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). If Congress had intended to preclude judicial review only of the Director’s threshold patentability determination, it could easily have adapted the language of former Section 312(c) to Section 314(a)’s new “reasonable likelihood” standard. Congress instead enacted language notably broader than had appeared in earlier preclusion-of-review provisions. 35 U.S.C. 314(a). This Court should “give effect to Congress’ choice.” *University of Texas S.W. Med. Ctr. v. Nassar*, 570 U.S. 338, 354 (2013) (citation omitted).

4. In support of its narrow reading of Section 314(d), the Federal Circuit relied in part on the “‘strong presumption’ favoring judicial review of administrative actions.” *Wi-Fi One*, 878 F.3d at 1371 (quoting *Cuozzo*, 136 S. Ct. at 2140). The Federal Circuit viewed that presumption as requiring a “clear and convincing” indication that Congress intended to prohibit review. *Id.* at 1372. But “[t]he presumption favoring judicial review of administrative action is just that—a presumption.” *Block*, 467 U.S. at 349. Like all presumptions used in interpreting statutes, it “may be overcome by specific language or specific legislative history that is a reliable indicator of congressional intent.” *Ibid.* “[T]he Court has found the standard met, and the presumption favoring judicial review overcome, whenever the congressional intent to preclude judicial review is fairly discernible in the statutory scheme.” *Id.* at 351 (citation and internal quotation marks omitted); see *Mach Mining, LLC v. EEOC*, 135 S. Ct. 1645, 1651 (2015) (explaining that the presumption “fails when a statute’s language or structure demonstrates that Congress wanted an agency to police its own conduct”); *Abbott Labs. v.*

*Gardner*, 387 U.S. 136, 140 (1967) (requiring a “persuasive reason” to conclude that Congress precluded review).

It is more than “fairly discernible” from the text, structure, and history of the AIA that Congress intended a broad preclusion of judicial review of the USPTO’s institution decisions. See *Cuozzo*, 136 S. Ct. at 2140-2141. By making the USPTO’s institution decision “final and nonappealable,” 35 U.S.C. 314(d), Congress unambiguously expressed its intent that the USPTO should “police its own conduct” at the institution phase of an inter partes review. *Mach Mining*, 135 S. Ct. at 1651; see *Cuozzo*, 136 S. Ct. at 2141 (“Congress has told the *Patent Office* to determine whether inter partes review should proceed,” and the Court’s “conclusion that courts may not revisit this initial determination gives effect to this statutory command.”). Although Click-to-Call insists that its interpretation of Section 314(d) “protects the proper role of the judiciary,” Click-to-Call Br. in Opp. 6, “[t]he judicial power of the United States conferred by Article III of the Constitution is upheld just as surely by withholding judicial relief where Congress has permissibly foreclosed it, as it is by granting such relief where authorized by the Constitution or by statute,” *Dalton v. Specter*, 511 U.S. 462, 477 (1994). Section 314(d) permissibly forecloses judicial review of the Director’s Section 315(b) determination here.

**B. This Court’s Decision In *Cuozzo* Confirms That The USPTO’s Section 315(b) Determinations Are Not Reviewable**

The Court has addressed the scope of Section 314(d) in two prior decisions: *Cuozzo Speed Technologies, LLC v. Lee*, *supra*, and *SAS Institute Inc. v. Iancu*, *su-*

*pra.* The Court’s decision in *Cuozzo* confirms the natural reading of Section 315(b)’s text. And while the Court in *SAS Institute* found Section 314(d) inapplicable to the challenge raised in that case, that challenge is readily distinguishable from the one that Click-to-Call asserts here.

1. a. In *Cuozzo*, the Court considered whether Section 314(d) precluded review, on an appeal from the Board’s final written decision, of the Board’s determination that a petition for inter partes review satisfied Section 312(a)(3)’s particularity requirement. Section 312(a)(3) states that any petition for inter partes review must identify, “in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. 312(a)(3). In *Cuozzo*, Garmin International, Inc. and Garmin USA, Inc. had filed a petition seeking inter partes review of several claims of a patent describing a type of speedometer. 136 S. Ct. at 2138. The petition argued that claim 17 of the patent was obvious in light of three specific prior patents, but it did not “expressly challenge[] claim 10 and claim 14 on the same obviousness ground.” *Ibid.*

The Board nevertheless instituted review of all three claims on the obviousness ground identified in the petition for claim 17. *Cuozzo*, 136 S. Ct. at 2138. After additional proceedings, it concluded that all three claims were obvious. *Ibid.* On appeal, *Cuozzo* argued that the agency had improperly instituted inter partes review with respect to claims 10 and 14 “because the agency found that Garmin had only *implicitly* challenged those two claims on the basis of the [prior] patents, while the statute required petitions to set forth the grounds

for challenge ‘with particularity.’” *Id.* at 2139 (citation omitted).

This Court concluded that “Cuozzo’s contention that the Patent Office unlawfully initiated its agency review [wa]s not appealable.” *Cuozzo*, 136 S. Ct. at 2139. The Court described the controversy before it as “an ordinary dispute about the application of certain relevant patent statutes concerning the Patent Office’s decision to institute inter partes review,” specifically whether that Office had complied with “a related statutory section, § 312, which says that petitions must be pleaded ‘with particularity.’” *Ibid.* The Court concluded that “the ‘No Appeal’ provision’s language must, at the least, forbid an appeal that attacks a ‘determination . . . whether to institute’ review by raising th[at] kind of legal question and little more.” *Ibid.* (quoting 35 U.S.C. 314(d)). The Court also observed that permitting review in this context would undermine Congress’s effort to “giv[e] the Patent Office significant power to revisit and revise earlier patent grants.” *Id.* at 2139-2140 (citing House Report 45, 48). The Court “doubt[ed] that Congress would have granted the Patent Office this authority \* \* \* if it had thought that the agency’s final decision could be unwound under some minor statutory technicality related to its preliminary decision to institute inter partes review.” *Ibid.*

In response to Justice Alito’s dissent, the Court explained that its interpretation of Section 314(d) “applie[d] where the grounds for attacking the decision to institute inter partes review consist of questions that are closely tied to the application and interpretation of statutes related to the Patent Office’s decision to initiate inter partes review.” *Cuozzo*, 136 S. Ct. at 2141. The

Court emphasized that it “need not, and d[id] not, decide the precise effect of § 314(d) on appeals that implicate constitutional questions, that depend on other less closely related statutes, or that present other questions of interpretation that reach, in terms of scope and impact, well beyond [Section 314].” *Ibid.* (citing *Johnson v. Robison*, 415 U.S. 361, 367 (1974), and *Traynor v. Turnage*, 485 U.S. 535, 544 (1988)). But the Court concluded that, “where a patent holder grounds its claim in a statute closely related to that decision to institute inter partes review, § 314(d) bars judicial review.” *Id.* at 2142.

b. In *SAS Institute*, the Court considered the scope of Section 318(a)’s “final written decision” requirement, 35 U.S.C. 318(a), and whether Section 314(d) precluded judicial review of a claim that the Board had not complied with that requirement. Section 318(a) states 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 any patent claim challenged by the petitioner.” *Ibid.* The Board in *SAS Institute* had instituted inter partes review of some but not all of the patent claims challenged in SAS Institute’s petition, and its final written decision had addressed only those claims as to which review was previously instituted. 138 S. Ct. at 1354. SAS Institute “argued that 35 U.S.C. § 318(a) required the Board to decide the patentability of *every* claim SAS challenged in its petition, not just some.” *Ibid.* The Court agreed, concluding that, “when § 318(a) says the Board’s final written decision ‘shall’ resolve the patentability of ‘any patent claim challenged by the petitioner,’ it means the Board *must* address *every* claim the petitioner has challenged” in the inter partes review petition. *Ibid.*

The Court then addressed the question whether the USPTO’s contrary approach to the “final written decision” requirement was subject to judicial review.<sup>4</sup> The Court noted its prior statement in *Cuozzo* that Section 314(d)’s preclusion-of-review provision “does not ‘enable the agency to act outside its statutory limits.’” *SAS Inst.*, 138 S. Ct. at 1359 (quoting *Cuozzo*, 136 S. Ct. at 2141). The Court also noted SAS Institute’s “content[ion] that the Director exceeded his statutory authority by limiting the review to fewer than all of the claims SAS challenged,” and it concluded that “nothing in § 314(d) \* \* \* withdraws our power to ensure that an inter partes review proceeds in accordance with the law’s demands.” *Ibid.*

2. a. *Cuozzo* confirms that the Board determination that Click-to-Call challenged in this case—*i.e.*, the determination that Section 315(b) did not bar the institution of inter partes review—is unreviewable on appeal from the final written decision. Like Section 312(a)(3)’s particularity requirement, Section 315(b) involves a “question[] that [is] closely tied to the application and interpretation of statutes related to the Patent Office’s decision to initiate inter partes review.” *Cuozzo*, 136 S. Ct. at 2141. Indeed, Section 315(b) addresses

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<sup>4</sup> The government argued in *SAS Institute* that the AIA permitted the USPTO to institute inter partes review of some but not all of the patent claims that were challenged in an inter partes review petition. 138 S. Ct. at 1356. The government further contended that, if the USPTO chose that course, Section 318(a) required its final written decision to address only those claims as to which it had previously instituted review. *Id.* at 1357. Under that theory, the government argued that SAS Institute’s challenge to the scope of the final written decision was in substance a challenge to the government’s partial-institution decision, and that Section 314(d) barred judicial review of that challenge. *Id.* at 1359.

*only* the institution decision, specifying a circumstance in which an inter partes review “may not be instituted.” 35 U.S.C. 315(b). Justice Alito thus correctly recognized in his *Cuozzo* dissent that the majority’s interpretation of Section 314(d) rendered the USPTO’s Section 315(b) determinations unreviewable. See 136 S. Ct. at 1354 (Alito, J., concurring in part and dissenting in part) (criticizing the majority for leaving “courts powerless to correct” any misapplication of Section 315(b)).

In the mine run of cases, the Director’s application of Section 315(b) will not implicate any “constitutional questions,” such as the claims that the Court concluded were reviewable in *Johnson*, 415 U.S. at 367. See *Cuozzo*, 136 S. Ct. at 2141 (citing *Johnson*, 415 U.S. at 367). Nor will it implicate any “statute applicable to all federal agencies,” such as the Rehabilitation Act claim that the Court in *Traynor* concluded was reviewable notwithstanding a similar bar on judicial review, 485 U.S. at 543. See *Cuozzo*, 136 S. Ct. at 2141 (citing *Traynor*, 485 U.S. at 544-545). Rather, challenges to the Board’s application of Section 315(b) will generally (as here) present nothing more than an “ordinary dispute about the application of certain relevant patent statutes concerning the Patent Office’s decision to institute inter partes review.” *Id.* at 2139. Section 314(d) “must, at the least, forbid an appeal that attacks a ‘determination . . . whether to institute’ review by raising th[at] kind of legal question.” *Ibid.* (quoting 35 U.S.C. 314(d)).

b. *SAS Institute* is not to the contrary. Taken in isolation, some language in that decision might suggest that Section 314(d) precludes judicial review only of the USPTO’s determination whether, if inter partes review were instituted, “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); see *SAS Inst.*, 138 S. Ct. at 1359; Click-to-Call Br. in Opp. 4. Limiting Section 314(d) in that way, however, would be inconsistent with the text and history of that provision, and with this Court’s holding in *Cuozzo* that Section 314(d) barred review of the Board’s “particularity” determination under Section 312(a)(3). In any event, the Court’s jurisdictional ruling in *SAS Institute* is not controlling here, since the petitioner’s challenge in that case differed from Click-to-Call’s current challenge in two important respects.

First, SAS Institute argued, and this Court agreed, that the Board had violated Section 318(a) by failing to address in its final written decision all of the patent claims that SAS Institute had challenged in its petition for inter partes review. See *SAS Inst.*, 138 S. Ct. at 1354. Although Section 314(d) bars appeal of the Director’s determination “whether to institute an inter partes review,” 35 U.S.C. 314(d), Section 319 *authorizes* an appeal of the “final written decision of the [Board] under section 318(a).” 35 U.S.C. 319; see *SAS Inst.*, 138 S. Ct. at 1359 (“[N]othing in § 314(d) or *Cuozzo* withdraws our power to ensure that an inter partes review *proceeds* in accordance with the law’s demands.”) (emphasis added). Unlike SAS Institute, Click-to-Call does not contend that the USPTO violated any statutory provision that governs the conduct or ultimate disposition of inter partes review proceedings after those proceedings have been instituted.

Second, in its merits discussion, the Court in *SAS Institute* observed that Section 314 authorizes the Director to determine “‘whether’ to institute the requested review—not ‘whether *and to what extent*’ review should proceed.” 138 S. Ct. at 1356 (quoting 35 U.S.C. 314(b)).



Section 314(d)'s preclusion language similarly refers to the Director's "determination \* \* \* whether to institute an inter partes review." 35 U.S.C. 314(d). In finding Section 314(d) to be inapplicable, the Court noted that SAS Institute did not challenge the agency's determination that a review should be instituted, but instead "contend[ed] that the Director exceeded his statutory authority by limiting the review to fewer than all of the claims SAS challenged." 138 S. Ct. at 1359. Click-to-Call, by contrast, does not quarrel with the *scope* of the inter partes review at issue here, but instead argues that the review should not have been instituted at all.

**C. Precluding Review Of The USPTO's Section 315(b) Determinations Is Consistent With The AIA's Purposes**

1. As in *Cuozzo*, allowing judicial review of Click-to-Call's current challenge to the Board's institution decision "would undercut one important congressional objective" underlying the AIA, "namely, giving the [USPTO] significant power to revisit and revise earlier patent grants." 136 S. Ct. at 2139-2140 (citing House Report 45, 48). The Court in *Cuozzo* "doubt[ed] that Congress would have granted the [USPTO] this authority \* \* \* if it had thought that the agency's final decision could be unwound under some minor statutory technicality related to its preliminary decision to institute inter partes review." *Id.* at 2140. A judicial order vacating the Board's final decision as to patentability, based on the court's judgment that the Board had committed legal error on a preliminary question unrelated to its patentability analysis, would similarly "squander the time and resources spent adjudicating the actual merits of the petition." *Wi-Fi One*, 878 F.3d at 1382 (Hughes, J., dissenting); *Cuozzo*, 136 S. Ct. at 2140.

2. Enforcing Section 314(d) in accordance with its broad literal terms would also further Congress's efforts to "improve patent quality and limit unnecessary and counterproductive litigation costs," House Report 40, by focusing judicial review on the merits of the Board's patentability determinations. Although the agency's decision whether to institute a particular inter partes review carries significant consequences for the parties involved, only the ultimate patentability decision matters to the patent system as a whole. See *Cuozzo*, 136 S. Ct. at 2144 ("[I]nter partes review helps protect the public's 'paramount interest in seeing that patent monopolies . . . are kept within their legitimate scope.") (citation omitted).

When the Board conducts a review and concludes that a challenged patent claim is invalid, a judicial order setting aside that decision based on Section 315(b) or similar procedural grounds can have significant adverse effects on the patent system and patent-reliant industries. The effect of such an order is that, although the USPTO has found the contested patent claim to be invalid and no court has disagreed, the claim remains in effect unless and until it is found invalid again, either by the USPTO (at the behest of a different challenger) or by a court. That result deprives potential infringers and the public of the clarity that a judicial ruling on the merits of the patentability dispute would have brought. And rather than further the AIA's purpose of providing "quick and cost effective alternatives to litigation," House Report 48, that approach spawns duplicative litigation and has enmeshed the Federal Circuit in a

range of additional legal and factual disputes concerning the AIA’s restrictions on the Director’s institution authority.<sup>5</sup>

3. The Federal Circuit’s interpretation of Section 314(d) also does not meaningfully serve the purposes of Section 315(b)’s time bar. Section 315(b) appears in a section of the AIA entitled “Relation to other proceedings or actions.” 35 U.S.C. 315. The provisions of Section 315 deal with the relationship and management of civil actions and inter partes review proceedings challenging the same patent’s validity. Section 315(a)(1) precludes inter partes review pursuant to a petition from a party that first filed a civil action challenging the same patent. 35 U.S.C. 315(a)(1). Section 315(a)(2) imposes an automatic stay of a civil action that challenges the patent’s validity and is filed on or after the date when the petition for inter partes review is filed. 35 U.S.C. 315(a)(2). And Section 315(c) authorizes the Director to

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<sup>5</sup> See, e.g., *WesternGeco LLC v. ION Geophysical Corp.*, 889 F.3d 1308, 1319-1322 (Fed. Cir. 2018) (determining, based on a “non-exhaustive list” of six considerations, that substantial evidence supported the Board’s conclusion that two parties were not in privity for purposes of Section 315(b)), cert. denied, 139 S. Ct. 1216 (2019); *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1351, 1358 (Fed. Cir. 2018) (vacating Board’s final written decision on the ground that it had not correctly applied the appropriate “flexible approach” to identifying real parties in interest, “tak[ing] into account both equitable and practical considerations, with an eye toward determining whether the non-party is a clear beneficiary that has a preexisting, established relationship with the petitioner”), cert. denied, 139 S. Ct. 1366 (2019); *Wi-Fi One, LLC v. Broadcom Corp.*, 887 F.3d 1329, 1340-1341 (Fed. Cir. 2018) (rejecting a substantial-evidence challenge to the Board’s determination of real parties in interest and privies for purposes of Section 315(b) based on indemnity agreements), cert. denied, 139 S. Ct. 826 (2019).

join multiple inter partes review petitioners into one inter partes review. 35 U.S.C. 315(c).

The purpose of these provisions is not to prevent the USPTO from reconsidering the validity of any particular patent. Even when Section 315(b) bars the agency from instituting inter partes review at the behest of a particular challenger, the USPTO may institute review pursuant to a petition filed by another person. See 35 U.S.C. 315(b)-(c). Rather, the restrictions imposed by Section 315 are intended to manage the burden on patent owners and minimize the wasted resources that duplicative judicial and administrative proceedings might entail. Vacating the Board's final written decision on a patent's validity *after* arguably duplicative proceedings have been completed, based on a court's determination that proper application of Section 315(b) *would have* prevented those proceedings, does nothing to further that purpose. To the contrary, setting aside the Board's final patentability determination after an inter partes review has been completed, on the basis of a preliminary question unrelated to the merits of that decision, will exacerbate rather than reduce the potential burdens associated with patent-related controversies.

To be sure, precluding judicial review of Section 315(b) determinations may allow some errors in the application of that provision to go uncorrected. The Director has come to the view that the proceedings in this case should not have been instituted under the best interpretation of Section 315(b). It does not follow, however, that the Board's patentability determination should be set aside, based on an agency procedural error unrelated to Click-to-Call's entitlement to a patent, after the Board and the parties have expended substantial resources on the proceedings.

The USPTO has established procedures for agency rehearing of institution decisions. And since the decision in this case, it has created a mechanism for interested parties to request that the Director himself review Board decisions that present significant questions of policy and procedure. See pp. 5-6, *supra*. Section 314(d) reflects Congress's judgment that the costs of providing further rounds of judicial review of the preliminary questions presented by Section 315(b) and related provisions outweigh the benefits of more comprehensive error correction. The Court should respect and enforce that judgment.

#### CONCLUSION

The judgment of the court of appeals should be reversed.

Respectfully submitted.

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## APPENDIX

1. 35 U.S.C. 141 provides:

### **Appeal to Court of Appeals for the Federal Circuit**

(a) **EXAMINATIONS.**—An applicant who is dissatisfied with the final decision in an appeal to the Patent Trial and Appeal Board under section 134(a) may appeal the Board’s decision to the United States Court of Appeals for the Federal Circuit. By filing such an appeal, the applicant waives his or her right to proceed under section 145.

(b) **REEXAMINATIONS.**—A patent owner who is dissatisfied with the final decision in an appeal of a reexamination to the Patent Trial and Appeal Board under section 134(b) may appeal the Board’s decision only to the United States Court of Appeals for the Federal Circuit.

(c) **POST-GRANT AND INTER PARTES REVIEWS.**—A party to an inter partes review or a post-grant review who is dissatisfied with the final written decision of the Patent Trial and Appeal Board under section 318(a) or 328(a) (as the case may be) may appeal the Board’s decision only to the United States Court of Appeals for the Federal Circuit.

(d) **DERIVATION PROCEEDINGS.**—A party to a derivation proceeding who is dissatisfied with the final decision of the Patent Trial and Appeal Board in the proceeding may appeal the decision to the United States Court of Appeals for the Federal Circuit, but such appeal shall be dismissed if any adverse party to such derivation proceeding, within 20 days after the appellant has filed notice of appeal in accordance with section 142, files notice with the Director that the party elects to

have all further proceedings conducted as provided in section 146. If the appellant does not, within 30 days after the filing of such notice by the adverse party, file a civil action under section 146, the Board's decision shall govern the further proceedings in the case.

2. 35 U.S.C. 144 provides:

**Decision on appeal**

The United States Court of Appeals for the Federal Circuit shall review the decision from which an appeal is taken on the record before the Patent and Trademark Office. Upon its determination the court shall issue to the Director its mandate and opinion, which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case.

3. 35 U.S.C. 303 provides:

**Determination of issue by Director**

(a) Within three months following the filing of a request for reexamination under the provisions of section 302, the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. On his own initiative, and any time, the Director may determine whether a substantial new question of patentability is raised by patents and publications discovered by him or cited under the provisions of section 301 or 302. The existence of a substantial new question of patentability is not precluded by the fact that a patent

or printed publication was previously cited by or to the Office or considered by the Office.

(b) A record of the Director's determination under subsection (a) of this section will be placed in the official file of the patent, and a copy promptly will be given or mailed to the owner of record of the patent and to the person requesting reexamination, if any.

(c) A determination by the Director pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable. Upon such a determination, the Director may refund a portion of the reexamination fee required under section 302.

4. 35 U.S.C. 311 provides:

**Inter partes review**

(a) **IN GENERAL.**—Subject to the provisions of this chapter, a person who is not the owner of a patent may file with the Office a petition to institute an inter partes review of the patent. The Director shall establish, by regulation, fees to be paid by the person requesting the review, in such amounts as the Director determines to be reasonable, considering the aggregate costs of the review.

(b) **SCOPE.**—A petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.



(c) FILING DEADLINE.—A petition for inter partes review shall be filed after the later of either—

- (1) the date that is 9 months after the grant of a patent; or
- (2) if a post-grant review is instituted under chapter 32, the date of the termination of such post-grant review.

5. 35 U.S.C. 312 provides:

**Petitions**

(a) REQUIREMENTS OF PETITION.—A petition filed under section 311 may be considered only if—

- (1) the petition is accompanied by payment of the fee established by the Director under section 311;
- (2) the petition identifies all real parties in interest;
- (3) the petition identifies, in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim, including—
  - (A) copies of patents and printed publications that the petitioner relies upon in support of the petition; and
  - (B) affidavits or declarations of supporting evidence and opinions, if the petitioner relies on expert opinions;
- (4) the petition provides such other information as the Director may require by regulation; and

(5) the petitioner provides copies of any of the documents required under paragraphs (2), (3), and (4) to the patent owner or, if applicable, the designated representative of the patent owner.

(b) PUBLIC AVAILABILITY.—As soon as practicable after the receipt of a petition under section 311, the Director shall make the petition available to the public.

6. 35 U.S.C. 313 provides:

**Preliminary response to petition**

If an inter partes review petition is filed under section 311, the patent owner shall have the right to file a preliminary response to the petition, within a time period set by the Director, that sets forth reasons why no inter partes review should be instituted based upon the failure of the petition to meet any requirement of this chapter.

7. 35 U.S.C. 314 provides:

**Institution of inter partes review**

(a) THRESHOLD.—The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

(b) **TIMING.**—The Director shall determine whether to institute an inter partes review under this chapter pursuant to a petition filed under section 311 within 3 months after—

(1) receiving a preliminary response to the petition under section 313; or

(2) if no such preliminary response is filed, the last date on which such response may be filed.

(c) **NOTICE.**—The Director shall notify the petitioner and patent owner, in writing, of the Director’s determination under subsection (a), and shall make such notice available to the public as soon as is practicable. Such notice shall include the date on which the review shall commence.

(d) **NO APPEAL.**—The determination by the Director whether to institute an inter partes review under this section shall be final and nonappealable.

8. 35 U.S.C. 315 provides:

**Relation to other proceedings or actions**

(a) **INFRINGER’S CIVIL ACTION.**—

(1) **INTER PARTES REVIEW BARRED BY CIVIL ACTION.**—An inter partes review may not be instituted if, before the date on which the petition for such a review is filed, the petitioner or real party in interest filed a civil action challenging the validity of a claim of the patent.

(2) **STAY OF CIVIL ACTION.**—If the petitioner or real party in interest files a civil action challenging the validity of a claim of the patent on or after the

date on which the petitioner files a petition for inter partes review of the patent, that civil action shall be automatically stayed until either—

(A) the patent owner moves the court to lift the stay;

(B) the patent owner files a civil action or counterclaim alleging that the petitioner or real party in interest has infringed the patent; or

(C) the petitioner or real party in interest moves the court to dismiss the civil action.

(3) TREATMENT OF COUNTERCLAIM.—A counterclaim challenging the validity of a claim of a patent does not constitute a civil action challenging the validity of a claim of a patent for purposes of this subsection.

(b) PATENT OWNER'S ACTION.—An 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. The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).

(c) JOINDER.—If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

(d) MULTIPLE PROCEEDINGS.—Notwithstanding sections 135(a), 251, and 252, and chapter 30, during the pendency of an inter partes review, if another proceeding or matter involving the patent is before the Office, the Director may determine the manner in which the inter partes review or other proceeding or matter may proceed, including providing for stay, transfer, consolidation, or termination of any such matter or proceeding.

(e) ESTOPPEL.—

(1) PROCEEDINGS BEFORE THE OFFICE.—The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or the real party in interest or privy of the petitioner, may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review.

(2) CIVIL ACTIONS AND OTHER PROCEEDINGS.—The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or the real party in interest or privy of the petitioner, may not assert either in a civil action arising in whole or in part under section 1338 of title 28 or in a proceeding before the International Trade Commission under section 337 of the Tariff Act of 1930 that the claim is invalid on any ground that the petitioner raised or reasonably could have raised during that inter partes review.

9. 35 U.S.C. 316 provides:

**Conduct of inter partes review**

(a) REGULATIONS.—The Director shall prescribe regulations—

(1) providing that the file of any proceeding under this chapter shall be made available to the public, except that any petition or document filed with the intent that it be sealed shall, if accompanied by a motion to seal, be treated as sealed pending the outcome of the ruling on the motion;

(2) setting forth the standards for the showing of sufficient grounds to institute a review under section 314(a);

(3) establishing procedures for the submission of supplemental information after the petition is filed;

(4) establishing and governing inter partes review under this chapter and the relationship of such review to other proceedings under this title;

(5) setting forth standards and procedures for discovery of relevant evidence, including that such discovery shall be limited to—

(A) the deposition of witnesses submitting affidavits or declarations; and

(B) what is otherwise necessary in the interest of justice;

(6) prescribing sanctions for abuse of discovery, abuse of process, or any other improper use of the proceeding, such as to harass or to cause unnecessary delay or an unnecessary increase in the cost of the proceeding;

(7) providing for protective orders governing the exchange and submission of confidential information;

(8) providing for the filing by the patent owner of a response to the petition under section 313 after an inter partes review has been instituted, and requiring that the patent owner file with such response, through affidavits or declarations, any additional factual evidence and expert opinions on which the patent owner relies in support of the response;

(9) setting forth standards and procedures for allowing the patent owner to move to amend the patent under subsection (d) to cancel a challenged claim or propose a reasonable number of substitute claims, and ensuring that any information submitted by the patent owner in support of any amendment entered under subsection (d) is made available to the public as part of the prosecution history of the patent;

(10) providing either party with the right to an oral hearing as part of the proceeding;

(11) requiring that the final determination in an inter partes review be issued not later than 1 year after the date on which the Director notices the institution of a review under this chapter, except that the Director may, for good cause shown, extend the 1-year period by not more than 6 months, and may adjust the time periods in this paragraph in the case of joinder under section 315(c);

(12) setting a time period for requesting joinder under section 315(c); and

(13) providing the petitioner with at least 1 opportunity to file written comments within a time period established by the Director.

(b) CONSIDERATIONS.—In prescribing regulations under this section, the Director shall consider the effect of any such regulation on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings instituted under this chapter.

(c) PATENT TRIAL AND APPEAL BOARD.—The Patent Trial and Appeal Board shall, in accordance with section 6, conduct each inter partes review instituted under this chapter.

(d) AMENDMENT OF THE PATENT.—

(1) IN GENERAL.—During an inter partes review instituted under this chapter, the patent owner may file 1 motion to amend the patent in 1 or more of the following ways:

(A) Cancel any challenged patent claim.

(B) For each challenged claim, propose a reasonable number of substitute claims.

(2) ADDITIONAL MOTIONS.—Additional motions to amend may be permitted upon the joint request of the petitioner and the patent owner to materially advance the settlement of a proceeding under section 317, or as permitted by regulations prescribed by the Director.

(3) SCOPE OF CLAIMS.—An amendment under this subsection may not enlarge the scope of the claims of the patent or introduce new matter.

(e) EVIDENTIARY STANDARDS.—In an inter partes review instituted under this chapter, the petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence.



10. 35 U.S.C. 317 provides:

**Settlement**

(a) **IN GENERAL.**—An inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed. If the inter partes review is terminated with respect to a petitioner under this section, no estoppel under section 315(e) shall attach to the petitioner, or to the real party in interest or privy of the petitioner, on the basis of that petitioner’s institution of that inter partes review. If no petitioner remains in the inter partes review, the Office may terminate the review or proceed to a final written decision under section 318(a).

(b) **AGREEMENTS IN WRITING.**—Any agreement or understanding between the patent owner and a petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of an inter partes review under this section shall be in writing and a true copy of such agreement or understanding shall be filed in the Office before the termination of the inter partes review as between the parties. At the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved patents, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause.

11. 35 U.S.C. 318 provides:

**Decision of the Board**

(a) FINAL WRITTEN DECISION.—If an inter partes review is instituted and not dismissed under this chapter, the Patent Trial and Appeal Board shall issue a final written decision with respect to the patentability of any patent claim challenged by the petitioner and any new claim added under section 316(d).

(b) CERTIFICATE.—If the Patent Trial and Appeal Board issues a final written decision under subsection (a) and the time for appeal has expired or any appeal has terminated, the Director shall issue and publish a certificate canceling any claim of the patent finally determined to be unpatentable, confirming any claim of the patent determined to be patentable, and incorporating in the patent by operation of the certificate any new or amended claim determined to be patentable.

(c) INTERVENING RIGHTS.—Any proposed amended or new claim determined to be patentable and incorporated into a patent following an inter partes review under this chapter shall have the same effect as that specified in section 252 for reissued patents on the right of any person who made, purchased, or used within the United States, or imported into the United States, anything patented by such proposed amended or new claim, or who made substantial preparation therefor, before the issuance of a certificate under subsection (b).

(d) DATA ON LENGTH OF REVIEW.—The Office shall make available to the public data describing the length of time between the institution of, and the issuance of a final written decision under subsection (a) for, each inter partes review.

12. 35 U.S.C. 319 provides:

**Appeal**

A party dissatisfied with the final written decision of the Patent Trial and Appeal Board under section 318(a) may appeal the decision pursuant to sections 141 through 144. Any party to the inter partes review shall have the right to be a party to the appeal.

13. 35 U.S.C. 311 (2000) provides:

**Request for inter partes reexamination**

(a) IN GENERAL.—Any person at any time may file a request for inter partes reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.

(b) REQUIREMENTS.—The request shall—

(1) be in writing, include the identity of the real party in interest, and be accompanied by payment of an inter partes reexamination fee established by the Director under section 41; and

(2) set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.

(c) COPY.—Unless the requesting person is the owner of the patent, the Director promptly shall send a copy of the request to the owner of record of the patent.

14. 35 U.S.C. 312 (2000) provides:

**Determination of issue by Director**

(a) REEXAMINATION.—Not later than 3 months after the filing of a request for inter partes reexamination under section 311, the Director shall determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. On the Director's initiative, and at any time, the Director may determine whether a substantial new question of patentability is raised by patents and publications.

(b) RECORD.—A record of the Director's determination under subsection (a) shall be placed in the official file of the patent, and a copy shall be promptly given or mailed to the owner of record of the patent and to the third-party requester, if any.

(c) FINAL DECISION.—A determination by the Director under subsection (a) shall be final and non-appealable. Upon a determination that no substantial new question of patentability has been raised, the Director may refund a portion of the inter partes reexamination fee required under section 311.

15. 35 U.S.C. 313 (2000) provides:

**Inter partes reexamination order by Director**

If, in a determination made under section 312(a), the Director finds that a substantial new question of patentability affecting a claim of a patent is raised, the determination shall include an order for inter partes reexamination of the patent for resolution of the question. The

order may be accompanied by the initial action of the Patent and Trademark Office on the merits of the inter partes reexamination conducted in accordance with section 314.

16. 35 U.S.C. 314 (2000) provides:

**Conduct of inter partes reexamination proceedings**

(a) **IN GENERAL.**—Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133. In any inter partes reexamination proceeding under this chapter, the patent owner shall be permitted to propose any amendment to the patent and a new claim or claims, except that no proposed amended or new claim enlarging the scope of the claims of the patent shall be permitted.

(b) **RESPONSE.**—(1) This subsection shall apply to any inter partes reexamination proceeding in which the order for inter partes reexamination is based upon a request by a third-party requester.

(2) With the exception of the inter partes reexamination request, any document filed by either the patent owner or the third-party requester shall be served on the other party. In addition, the third-party requester shall receive a copy of any communication sent by the Office to the patent owner concerning the patent subject to the inter partes reexamination proceeding.

(3) Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues

raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

(c) SPECIAL DISPATCH.—Unless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

17. 35 U.S.C. 315 (2000) provides:

**Appeal**

(a) PATENT OWNER.—The patent owner involved in an inter partes reexamination proceeding under this chapter—

(1) may appeal under the provisions of section 134 and may appeal under the provisions of sections 141 through 144, with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent; and

(2) may be a party to any appeal taken by a third-party requester under subsection (b).

(b) THIRD-PARTY REQUESTER.—A third-party requester may—

(1) appeal under the provisions of section 134 with respect to any final decision favorable to the patentability of any original or proposed amended or new claim of the patent; or

(2) be a party to any appeal taken by the patent owner under the provisions of section 134, subject to subsection (c).

(c) CIVIL ACTION.—A third-party requester whose request for an inter partes reexamination results in an order under section 313 is estopped from asserting at a later time, in any civil action arising in whole or in part under section 1338 of title 28, United States Code, the invalidity of any claim finally determined to be valid and patentable on any ground which the third-party requester raised or could have raised during the inter partes reexamination proceedings. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

18. 35 U.S.C. 316 (2000) provides:

**Certificate of patentability, unpatentability, and claim cancellation**

(a) IN GENERAL.—In an inter partes reexamination proceeding under this chapter, when the time for appeal has expired or any appeal proceeding has terminated, the Director shall issue and publish a certificate canceling any claim of the patent finally determined to be unpatentable, confirming any claim of the patent determined to be patentable, and incorporating in the patent any proposed amended or new claim determined to be patentable.

(b) **AMENDED OR NEW CLAIM.**—Any proposed amended or new claim determined to be patentable and incorporated into a patent following an inter partes reexamination proceeding shall have the same effect as that specified in section 252 of this title for reissued patents on the right of any person who made, purchased, or used within the United States, or imported into the United States, anything patented by such proposed amended or new claim, or who made substantial preparation therefor, prior to issuance of a certificate under the provisions of subsection (a) of this section.

19. 35 U.S.C. 317 (2000) provides:

**Inter partes reexamination prohibited**

(a) **ORDER FOR REEXAMINATION.**—Notwithstanding any provision of this chapter, once an order for inter partes reexamination of a patent has been issued under section 313, neither the patent owner nor the third-party requester, if any, nor privies of either, may file a subsequent request for inter partes reexamination of the patent until an inter partes reexamination certificate is issued and published under section 316, unless authorized by the Director.

(b) **FINAL DECISION.**—Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, United States Code, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an inter partes reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its



privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

20. 35 U.S.C. 318 (2000) provides:

**Stay of litigation**

Once an order for inter partes reexamination of a patent has been issued under section 313, the patent owner may obtain a stay of any pending litigation which involves an issue of patentability of any claims of the patent which are the subject of the inter partes reexamination order, unless the court before which such litigation is pending determines that a stay would not serve the interests of justice.

21. 35 U.S.C. 303 (Supp. IV 1980) provides:

**Determination of issue by Commissioner**

(a) Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Commissioner will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request,

with or without consideration of other patents or printed publications. On his own initiative, and any time, the Commissioner may determine whether a substantial new question of patentability is raised by patents and publications discovered by him or cited under the provisions of section 301 of this title.

(b) A record of the Commissioner's determination under subsection (a) of this section will be placed in the official file of the patent, and a copy promptly will be given or mailed to the owner of record of the patent and to the person requesting reexamination, if any

(c) A determination by the Commissioner pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable. Upon such a determination, the Commissioner may refund a portion of the reexamination fee required under section 302 of this title.

22. 35 U.S.C. 304 (Supp. IV 1980) provides:

**Reexamination order by Commissioner**

If, in a determination made under the provisions of subsection 303(a) of this title, the Commissioner finds that a substantial new question of patentability affecting any claim of a patent is raised, the determination will include an order for reexamination of the patent for resolution of the question. The patent owner will be given a reasonable period, not less than two months from the date a copy of the determination is given or mailed to him, within which he may file a statement on such question, including any amendment to his patent and new claim or claims he may wish to propose, for consideration in the reexamination. If the patent owner files such

a statement, he promptly will serve a copy of it on the person who has requested reexamination under the provisions of section 302 of this title. Within a period of two months from the date of service, that person may file and have considered in the reexamination a reply to any statement filed by the patent owner. That person promptly will serve on the patent owner a copy of any reply filed.

23. 35 U.S.C. 305 (Supp. IV 1980) provides:

**Conduct of reexamination proceedings**

After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter. All reexamination proceedings under this section, including any appeal to the Board of Appeals, will be conducted with special dispatch within the Office.

24. 35 U.S.C. 306 (Supp. IV 1980) provides:

**Appeal**

The patent owner involved in a reexamination proceeding under this chapter may appeal under the provisions of section 134 of this title, and may seek court review under the provisions of sections 141 to 145 of this title, with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent.