

No. 19-

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IN THE  
**Supreme Court of the United States**

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ARRIS INTERNATIONAL LIMITED,

*Petitioner,*

*v.*

CHANBOND, LLC

AND

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

*Respondents.*

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

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**PETITION FOR A WRIT OF CERTIORARI**

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## QUESTIONS PRESENTED

1. Whether the Federal Circuit has appellate jurisdiction to review a decision by the Patent Trial and Appeal Board ("PTAB") denying institution of an *inter partes* review based on the time-bar of 35 U.S.C. § 315(b).

2. Whether the inability of the Petitioner to appeal the PTAB's finding that the Petitioner is a "privy" of a third party, thereby affecting a substantive right of the Petitioner, is a denial of due process because of the substantive estoppels arising from that finding in the context of the AIA / IPR statutory scheme.

## **PARTIES TO THE PROCEEDING BELOW**

ARRIS International plc was the appellant below and the petitioner before the Patent Trial and Appeal Board. ARRIS International plc was renamed ARRIS International Limited, the petitioner.

Respondent ChanBond LLC, was an appellee below and a respondent before the PTAB.

Respondent Andrei Iancu, Under Secretary of Commerce for Intellectual Property and Director of The United States Patent and Trademark Office was an intervenor in the Federal Circuit.

## **RULE 29.6 DISCLOSURE STATEMENT**

CommScope Holding Company, Inc. is a publicly held company that owns 10% or more of the stock of petitioner ARRIS International Limited.

## **DIRECTLY RELATED PROCEEDINGS**

*ARRIS Int'l plc v. ChanBond, LLC*, Nos. 18-2426, -2427, -2428, -2429, -2430, U.S. Court of Appeals for the Federal Circuit. Judgement entered Dec. 27, 2018.

## TABLE OF CONTENTS

	<i>Page</i>
QUESTIONS PRESENTED .....	i
PARTIES TO THE PROCEEDING BELOW .....	ii
RULE 29.6 DISCLOSURE STATEMENT .....	ii
DIRECTLY RELATED PROCEEDINGS.....	ii
TABLE OF CONTENTS.....	iii
TABLE OF APPENDICES .....	vi
TABLE OF CITED AUTHORITIES .....	viii
INTRODUCTION.....	1
OPINIONS BELOW.....	4
JURISDICTION.....	4
STATUTORY PROVISIONS INVOLVED.....	4
STATEMENT OF THE CASE .....	7
A. The America Invents Act .....	9
B. The Patent Infringement Cases .....	11
C. The IPR Proceedings Before The PTAB .....	11

Table of Contents

	Page
D. The Federal Circuit Appeals .....	13
REASONS FOR GRANTING THE PETITION.....	14
I. The Federal Circuit's Decision that it Does Not Have Jurisdiction to Review a PTAB Decision Affecting the Substantive Rights of a Petitioner – a Decision Unrelated to the Director's Discretion to Institute Review – Leaves the Reviewability of the PTAB's Decisions in a State of Confusion .....	16
A. The Federal Circuit Contravened <i>Cuozzo</i> , <i>Wi-Fi One</i> and <i>Arthrex</i> .....	16
1. The en banc Court in <i>Wi-Fi One</i> , Relying on <i>Cuozzo</i> , Held that Time-Bar Determinations Under § 315(b) are Reviewable.....	17
2. <i>Arthrex</i> Held that 35 U.S.C. § 319 Does Not Provide Exclusive Jurisdiction for Appeals from PTAB Decisions.....	22
3. The Federal Circuit's Continued Reliance On <i>St. Jude</i> To Artificially Restrict Its Jurisdiction to Review Certain PTAB Institution Decisions Should Be Overruled in view of <i>Cuozzo</i> , <i>Wi-Fi One</i> and <i>Arthrex</i> .....	23

*Table of Contents*

	<i>Page</i>
B. Even if the PTAB's Decision to Deny Institution is Committed to Agency Discretion, the Decision is Available for Review Under <i>Weyerhaeuser</i> .....	25
II. This Case is an Ideal Vehicle to Resolve the Jurisdiction of the Federal Circuit to Review PTAB Decisions Denying Institution Based on the Time-bar of 35 U.S.C. § 315(b) .....	28
CONCLUSION .....	29

**TABLE OF APPENDICES**

	<i>Page</i>
APPENDIX A — ORDER OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT, FILED DECEMBER 27, 2018 .....	1a
APPENDIX B — REDACTED DECISION OF THE UNITED STATES PATENT AND TRADEMARK OFFICE, CASE IPR2018-00570, DATED JULY 20, 2018.....	5a
APPENDIX C — REDACTED DECISION OF THE UNITED STATES PATENT AND TRADEMARK OFFICE, CASE IPR2018-00572, DATED JULY 20, 2018 .....	31a
APPENDIX D — REDACTED DECISION OF THE UNITED STATES PATENT AND TRADEMARK OFFICE, CASE IPR2018-00573, DATED JULY 20, 2018.....	56a
APPENDIX E — REDACTED DECISION OF THE UNITED STATES PATENT AND TRADEMARK OFFICE, CASE IPR2018-00574, DATED JULY 20, 2018.....	81a
APPENDIX F — REDACTED DECISION OF THE UNITED STATES PATENT AND TRADEMARK OFFICE, CASE IPR2018-00575, DATED JULY 20, 2018 .....	106a

*Table of Appendices*

	<i>Page</i>
APPENDIX G — DENIAL OF REHEARING OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT, FILED APRIL 26, 2019 .....	131a
APPENDIX H — PETITION FOR REHEARING AND ADDENDUM OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT, FILED FEBRUARY 11, 2019 .....	133a



## TABLE OF CITED AUTHORITIES

	<i>Page</i>
<b>CASES</b>	
<i>Abbott Lab. v. Gardner</i> , 387 U.S. 136 (1967).....	26
<i>Arthrex, Inc., v. Smith &amp; Nephew, Inc.</i> , 880 F.3d 1345 (Fed. Cir. 2018) .....	13, 14, 22, 23, 25
<i>B&amp;B Hardware, Inc. v. Hargis Indus.</i> , 135 S. Ct. 1293 (2015).....	14, 21
<i>Cuozzo Speed Techs., LLC v. Lee</i> , 136 S. Ct. 2131 (2016) .....	<i>passim</i>
<i>Dex Media, Inc., v.</i> <i>Click-To-Call Techs., LP</i> , No. 18-916 (2019).....	3, 28
<i>Lincoln v. Vigil</i> , 508 U.S. 182 (1993).....	27
<i>MaxLinear, Inc. v. CF CRESPE LLC</i> , 880 F.3d 1373 (Fed. Cir. 2018) .....	21
<i>Oil States Energy Servs., LLC v.</i> <i>Greene's Energy Grp., LLC</i> , 138 S. Ct. 1365 (2018).....	9, 10
<i>SAS Inst. Inc. v. Iancu</i> , 138 S. Ct. 1348 (2018).....	10

*Cited Authorities*

	<i>Page</i>
<i>St. Jude Med., Cardiology Div., Inc. v. Volcano Corp.</i> , 749 F.3d 1373 (Fed. Cir. 2014).....	13, 24, 25
<i>Weyerhaeuser Co. v. U.S. Fish &amp; Wildlife Service</i> , 139 S. Ct. 361 (2018).....	13, 24, 26, 27
<i>Wi-Fi One, LLC v. Broadcom Corp.</i> , 878 F.3d 1364 (Fed. Cir. 2018).....	<i>passim</i>

**STATUTES AND REGULATIONS**

5 U.S.C. § 701 .....	6
5 U.S.C. § 701(a)(1).....	6, 26
5 U.S.C. § 701(a)(2).....	6, 26, 27
5 U.S.C. § 702.....	26
5 U.S.C. § 706.....	6
5 U.S.C. §§ 706(2)(A)-(D) .....	1, 18
16 U.S.C. § 1533(b)(2) .....	26
28 U.S.C. § 1254(1).....	4
28 U.S.C. § 1295.....	5, 22, 23
28 U.S.C. § 1295(a)(4)(A).....	<i>passim</i>

*Cited Authorities*

	<i>Page</i>
35 U.S.C. § 141(c) .....	10
35 U.S.C. § 311(a) .....	9
35 U.S.C. § 312 .....	17
35 U.S.C. § 312(a)(3) .....	9
35 U.S.C. § 313 .....	9
35 U.S.C. § 314 .....	4, 18
35 U.S.C. § 314(a) .....	<i>passim</i>
35 U.S.C. § 314(d) .....	<i>passim</i>
35 U.S.C. § 315(b) .....	<i>passim</i>
35 U.S.C. § 315(e) .....	21
35 U.S.C. § 318(a) .....	10
35 U.S.C. § 319 .....	1, 5, 10, 22
37 C.F.R. § 42.4(a) .....	9

**OTHER AUTHORITIES**

H.R. Rep. No. 112-98 (2011) .....	9
Pub. L. No. 112-29, 125 Stat. 284 (2011) .....	7

## INTRODUCTION

The America Invents Act created “*inter partes* review” (“IPR”), an agency procedure for challenging a patent before the Patent Trial and Appeal Board (“PTAB”). This Court first addressed the scope of reviewability of institution decisions for IPRs in *Cuozzo Speed Technologies, LLC v. Lee*, 136 S. Ct. 2131 (2016), based on the appeal bar set forth in 35 U.S.C. § 314(d), which 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). In *Cuozzo*, this Court held that the § 314(d) appeal bar applies to, and thus precluded review of, the Patent Office’s institution decisions made under 35 U.S.C. § 314(a), *i.e.*, decisions based on the underlying merits of the challenge to a patent. *Cuozzo*, 136 S. Ct. at 2142. However, the Court emphasized that the § 314(d) appeal bar applies *only* to cases “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,” and declined to “decide the precise effect of § 314(d)” on appeals that implicate constitutional questions or depend on less closely related statutes. *Id.* at 2141. In so holding, this Court expressly recognized exceptions allowing review when “there is a due process problem” or the PTAB “act[ed] outside of its statutory limits,” noting that “[s]uch ‘shenanigans’ may properly be reviewable” under 35 U.S.C. § 319 or the Administrative Procedure Act. *Id.* at 2141-42 (citing 5 U.S.C. §§ 706(2) (A)-(D)).

In the *Wi-Fi One* case, the Federal Circuit addressed whether it had appellate jurisdiction to review a decision by the PTAB that a petitioner was not time-barred by 35 U.S.C. § 315(b), which requires that a petitioner and its privies must file a petition within one year of being sued on the patent in district court. *Wi-Fi One, LLC v. Broadcom Corp.*, 878 F.3d 1364 (Fed. Cir. 2018) (en banc). Based on the holding of *Cuozzo*, the en banc Federal Circuit held that a PTAB decision under the § 315(b) time-bar was not “closely related” to the PTAB decision whether to institute review under § 314(a), and therefore the appeal bar set forth in § 314(d) did not apply to a time-bar determination. *Id.* at 1373.

The Federal Circuit addressed the same statutory provision – the § 315(b) time-bar – in the instant case but held that it did not have jurisdiction to hear an appeal when the PTAB issues a ruling on the § 315(b) time-bar in a *denial* of institution decision. Thus, the Federal Circuit’s decision below artificially limits the reviewability of time-bar decisions based on a procedural happenstance, even though a time-bar decision can (as in this case) be based on a privity finding that impacts a petitioning party’s substantive rights beyond the PTAB proceeding. The Federal Circuit’s decision has thus created an exception to its en banc decision in *Wi-Fi One* that both defies the underlying logic of the en banc decision and disregards the directive in *Cuozzo* on the importance of permitting review of agency decisions that violate due process.

Specifically, the Federal Circuit treats appeals from institution decisions based on the time-bar of 35 U.S.C. § 315(b) differently depending on the procedural happenstance of whether or not the appeal is made after the issuance of a Final Written Decision. Even though

the statutory and constitutional bases for requiring appellate review are exactly the same in either scenario, the Federal Circuit has created an exception to the “strong presumption in favor of judicial review” that is ungrounded in statutory or case law. *See Cuozzo*, 136 S. Ct. at 2140 (internal quotation marks omitted).

The scope and limits of the appeal bar of § 314(d), specifically as it applies to the PTAB’s decisions of the time-bar under § 315(b), is a continuing challenge for the PTAB and the courts. The en banc *Wi-Fi One* ruling addressed the reviewability of a § 315(b) ruling when the PTAB institutes review, thereby protecting the due process rights of the Patent Owner. The Federal Circuit decision below introduces confusion by not acknowledging that the decision by the PTAB holding ARRIS subject to the time-bar based on a “privity” finding affects the substantive rights of ARRIS that follows ARRIS outside the confines of the PTAB proceeding. This outcome is in sharp contrast to a PTAB decision not to institute an IPR based on its discretionary evaluation of the underlying merits of the patent challenge.

This Court already has recognized the importance of the scope of the appeal bar under § 314(d) as it applies to the time-bar under § 315(b) in its recent grant of a petition for a writ of certiorari in *Dex Media, Inc., v. Click-To-Call Technologies, LP*, No. 18-916 (2019), which is challenging the *Wi-Fi One* holding. The Court should grant this petition for a writ of certiorari and address the questions presented in this case together with the *Dex Media* case to expand its review of the scope of the appeal bar under § 314(d) to consider time-bar decisions under § 315(b) of the PTAB that deny institution to fully address the due process concerns of petitioners.

## OPINIONS BELOW

The order of the United States Court of Appeals for the Federal Circuit dated December 27, 2018, which dismissed the appeal for lack of jurisdiction, is unpublished and reprinted in the Appendix to this Petition (“App.”) at App. 1a-4a. The PTAB’s decisions to deny institution of *inter partes* review are reprinted at App. 5a-130a and SA1-SA130<sup>1</sup>.

## JURISDICTION

The judgment of the United States Court of Appeals for the Federal Circuit was entered on December 27, 2018. App. 1a-4a. A petition for en banc rehearing was filed on February 11, 2019, App. 133a-156a, and the United States Court of Appeals for the Federal Circuit denied the rehearing request on April 26, 2019, App. 131a-132a. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

## STATUTORY PROVISIONS INVOLVED

35 U.S.C. § 314 provides, in relevant part:

(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

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1. The Supplement Appendix (“SA”) contains the non-public versions of the PTAB’s decisions to deny institution of *inter partes* review.

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.

...

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

35 U.S.C. § 315(b) provides, in relevant part:

(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.

35 U.S.C. § 319 provides:

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.

28 U.S.C. § 1295 provides, in relevant part:

(a) The United States Court of Appeals for the Federal Circuit shall have exclusive jurisdiction—



...

(4) of an appeal from a decision of—

(A) the Patent Trial and Appeal Board of the United States Patent and Trademark Office with respect to a patent application, derivation proceeding, reexamination, post-grant review, or inter partes review under title 35, at the instance of a party who exercised that party's right to participate in the applicable proceeding before or appeal to the Board, except that an applicant or a party to a derivation proceeding may also have remedy by civil action pursuant to section 145 or 146 of title 35; an appeal under this subparagraph of a decision of the Board with respect to an application or derivation proceeding shall waive the right of such applicant or party to proceed under section 145 or 146 of title 35;

5 U.S.C. § 701 provides, in relevant part

(a) This chapter applies, according to the provisions thereof, except to the extent that—

(1) statutes preclude judicial review; or

(2) agency action is committed to agency discretion by law.

5 U.S.C. § 706 provides, in relevant part:

To the extent necessary to decision and when presented, the reviewing court shall

decide all relevant questions of law, interpret constitutional and statutory provisions, and determine the meaning or applicability of the terms of an agency action. The reviewing court shall—

...

(2) hold unlawful and set aside agency action, findings, and conclusions found to be—

(A) arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law.

### STATEMENT OF THE CASE

In 2011, Congress enacted the Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284 (2011). The statute has two provisions relevant here.

First, 35 U.S.C. § 315(b) provides 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 . . . is served with a complaint alleging infringement of the patent.” Pursuant to 28 U.S.C. 1295(a)(4)(A) and the “strong presumption in favor of judicial review,” *Cuozzo*, 136 S. Ct. at 2140 (internal quotation marks omitted), a decision against institution would be reviewable unless such review were prohibited by statute.

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

and nonappealable.” In *Cuozzo*, this Court addressed this appeal bar, but did 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 ‘this section.’” *Cuozzo*, 136 S. Ct. at 2141. In *Wi-Fi One*, the en banc Federal Circuit held that a PTAB decision under the § 315(b) time-bar was not “closely related” to the PTAB decision whether to institute review under 35 U.S.C. § 314(a), and therefore the appeal bar set forth in § 314(d) did not apply to a time-bar determination. *Wi-Fi One*, 878 F.3d at 1373. In the appeal below, however, the Federal Circuit grafted an exception into the directive of the statute and the case law: the Federal Circuit rescinded the reviewability of time-bar decisions based on the procedural happenstance of whether the PTAB (i) did not find a time-bar, and thus instituted the *inter partes* review (in which case nothing could be reviewed until the PTAB’s issuance of a Final Written Decision), or (ii) did find a time-bar, and thus did not institute the *inter partes* review (in which case PTAB never issues a Final Written Decision). The fundamental problem with the Federal Circuit’s approach is that the procedural timing – and the issuance of a Final Written Decision – would only be relevant if the appeal bar of § 314(d) applied to the § 315(b) time-bar, but *Wi-Fi One* (based on *Cuozzo*) established that the appeal bar § 314(d) is categorically inapplicable to a review of the § 315(b) time bar. Accordingly, 28 U.S.C. § 1295(a)(4)(A) provides appellate jurisdiction, and no statute excludes it.

### A. The America Invents Act

With the AIA, Congress intended to provide a “quick and cost effective alternative[] to litigation” and to “improve patent quality and restore confidence in the presumption of validity that comes with issued patents in court.” H.R. Rep. No. 112-98, pt. 1, at 45, 48 (2011). The AIA replaced the former system of *inter partes* reexamination with a new adjudicatory proceeding called *inter partes* review (“IPR”). See *Cuozzo*, 136 S. Ct. at 2137. An IPR is “a second look at an earlier administrative grant of a patent.” *Id.* at 2144. Within the Patent and Trademark Office (“PTO”), the AIA created the Patent Trial and Appeal Board (“PTAB” or “Board”), which “conducts the proceedings, reaches a conclusion, and sets forth its reasons.” *Id.* at 2137.

The AIA established a two-step process for IPR proceedings. First, “[a]ny person other than the patent owner can file a petition for inter partes review.” *Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC*, 138 S. Ct. 1365, 1371 (2018); see 35 U.S.C. § 311(a).<sup>2</sup> The PTAB, acting on behalf of the Director of the PTO, see 37 C.F.R. § 42.4(a), determines whether to “institute” an IPR. See 35 U.S.C. § 314(a). The PTAB may institute an IPR if it concludes that “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1

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2. The AIA requires the petition to identify “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). The patentee then has “the right to file a preliminary response to the petition” containing “reasons why no inter partes review should be instituted based upon the failure of the petition to meet any requirement of this chapter.” 35 U.S.C. § 313.

of the claims challenged in the petition.” *Id.* “The decision whether to institute inter partes review is committed to the Director’s discretion.” *Oil States*, 138 S. Ct. at 1371. The one-year time-bar of § 315(b), however, circumscribes the Director’s discretion if there has been prior litigation in court over the patent: “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.” 35 U.S.C. § 315(b).

Second, if the PTAB institutes an IPR, the Board conducts a trial to determine if any of the challenged patent claims should be cancelled. *See Oil States*, 138 S. Ct. at 1371–72.<sup>3</sup> The PTAB must “issue a final written decision with respect to the patentability of any patent claim challenged by the petitioner and any new claim added” by amendment. 35 U.S.C. § 318(a). Any party “who is dissatisfied with the final written decision of the Patent Trial and Appeal Board . . . may appeal the Board’s decision” to the Federal Circuit. 35 U.S.C. § 141(c); *see also* 35 U.S.C. § 319. But, Congress limited the ability of the patent owner to appeal the PTAB’s decision to institute an IPR in the first place: “The 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).

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3. The trial process includes “many of the usual trappings of litigation,” as “[t]he parties conduct discovery and join issue in briefing and at an oral hearing.” *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1354 (2018).

## **B. The Patent Infringement Cases**

On September 21, 2015, Respondent ChanBond, LLC (“ChanBond”) sued thirteen defendants (the “Delaware Defendants”)<sup>4</sup> in separate actions for infringement of three patents<sup>5</sup> in the District of Delaware. Petitioner ARRIS International Limited<sup>6</sup> (“ARRIS”) is not now, nor has it ever been, a Delaware Defendant, nor has it been sued in any other action for infringement of any of the three patents. The thirteen actions were consolidated into a single action that is presently pending in the district court.

## **C. The IPR Proceedings Before The PTAB**

On February 2, 2018, ARRIS filed two IPR petitions challenging the ’565 Patent on grounds of obviousness, two IPR petitions challenging the ’679 Patent on grounds of obviousness, and a single IPR petition challenging the

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4. The named defendants are Atlantic Broadband Group, LLC, Bright House Networks, LLC, Cable One, Inc. LLC, Cablevision Systems Corp., Cequel Communications, LLC, Charter Communications, LLC, Comcast Corp., Cox Communications, Inc., Mediacom Communications Corp., RCM Telecom Services, LLC, Time Warner Cable, Inc., WaveDivision Holdings, LLC, and WideOpen West Finance, LLC.

5. The three patents were U.S. Patent Nos. 7,941,822 (the “822 Patent”), 8,341,679 (the “679 Patent”) and 8,984,565 (the “565 Patent”) (collectively, the “Asserted Patents”).

6. Through a corporate merger and reorganization during the proceedings below, ARRIS International plc underwent a name change to ARRIS International Limited, which is now the petitioner in this case.

'822 Patent on grounds of obviousness. App. 6a, 31a-32a, 57a, 82a, 107a, SA2, SA28, SA54, SA80, and SA106.

On June 13, 2018, ChanBond filed its preliminary responses in the IPRs arguing that ARRIS was time-barred under 35 U.S.C. § 315(b) because ARRIS was in privity with the Delaware Defendants that were served with a complaint for infringement of the Asserted Patents more than one year before the filing date of ARRIS's petitions.<sup>7</sup> App. 8a, 34a, 59a, 84a, 109a, SA4, SA30, SA56, SA82, and SA108.

On July 20, 2018, the PTAB denied institution of all five petitions. The PTAB held that ARRIS was time-barred under 35 U.S.C. § 315(b) because "[o]ne or more of the defendants in the Delaware actions was in privity with [ARRIS], and those defendants were served with a complaint, alleging infringement of the [Asserted Patents] more than one year prior to the filing of the instant Petition." App. 24a, 50a, 75a, 100a, 125a, SA20-SA21, SA46-SA47, SA72-SA73, SA98-SA99, and SA124-SA125.

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7. On May 25, 2018, ChanBond had filed a motion in each of the five IPRs seeking discovery as to ARRIS's involvement with the Delaware Defendants, in support of ChanBond's allegation that ARRIS was a real party-in-interest or in privity with the Delaware Defendants. The PTAB issued its decision denying institution while ChanBond's motion for additional discovery was pending, and weeks before the institution decisions were due. The PTAB did not address the parties' ongoing discovery dispute and dismissed the motion for additional discovery as moot. App. 25a-26a, 50a-51a, 76a-77a, 101a-102a, 125a-126a, SA21-SA22, SA47-SA48, SA73-SA74, SA99-SA100, and SA125-SA126.

#### D. The Federal Circuit Appeals

On September 20, 2018, ARRIS filed a notice of appeal in each of the five IPRs, seeking review of the PTAB's decision that ARRIS was a privy of at least one of the Delaware Defendants.

On October 12, 2018, ChanBond filed a motion to dismiss each of the appeals for lack of appellate jurisdiction.

On December 27, 2018, the Federal Circuit dismissed ARRIS's appeal for lack of appellate jurisdiction under 35 U.S.C. § 314(d). The court, relying on its decision in *St. Jude Medical, Cardiology Division, Inc. v. Volcano Corp.*, 749 F.3d 1373 (Fed. Cir. 2014), held that "our review authority under 28 U.S.C. § 1295(a)(4)(A) does not extend to appeals from decisions not to institute." App. 3a (citing *St. Jude*, 749 F.3d at 1375-76). With respect to the *Wi-Fi One* decision, the Federal Circuit noted that "the agency's decision to deny a petition is a matter committed to the Patent Office's discretion" and stated that the *Wi-Fi One* holding "reiterated" that "[i]f the Director decides not to institute, for whatever reason, there is no review." App. 3a.

On February 11, 2019, ARRIS filed a petition for en banc rehearing, arguing that (1) the en banc decision in *Wi-Fi One* held that time-bar determinations under § 315 are reviewable; (2) the decision in *Arthrex, Inc., v. Smith & Nephew, Inc.*, 880 F.3d 1345 (Fed. Cir. 2018) held that 35 U.S.C. § 319 does not provide exclusive jurisdiction for appeals from PTAB decisions; and (3) the PTAB's discretionary decision not to institute was reviewable under *Weyerhaeuser Co. v. U.S. Fish & Wildlife Service*, 139 S. Ct. 361 (2018).



On April 26, 2019 the petition for en banc rehearing was denied. App. 131a-132a.

### REASONS FOR GRANTING THE PETITION

The exception to appellate jurisdiction applied by the Federal Circuit in this case has sweeping effects on the application of the law of privity and real-party-in-interest under the AIA. This case thus addresses whether the Federal Circuit has jurisdiction to hear an appeal of the PTAB's determination that a party is a "privy" under § 315(b) – and is therefore time-barred – when that decision results in the non-institution of an IPR. The Federal Circuit's decision that § 314(d) deprives it of jurisdiction to review the PTAB's determination that Petitioner ARRIS is a privy to the Delaware Defendants under § 315(b) – and that ARRIS is therefore time-barred – is contrary to this Court's decisions in *Cuozzo* and *Weyerhaeuser*, and also contrary to the Federal Circuit's decisions in *Wi-Fi One* and *Arthrex*.

The Federal Circuit's decision also deprives ARRIS of due process, because the PTAB's decision impacts ARRIS's substantive rights in view of estoppels that attach to "privies" of IPR petitioners, and in view of the preclusive effect of the PTAB's privy finding that goes beyond the estoppel provisions of the AIA pursuant to this Court's holding in *B&B Hardware, Inc. v. Hargis Industries*, 135 S. Ct. 1293 (2015). In the words of the *Wi-Fi One* court, a decision under § 315(b) "governs the relation of IPRs to other proceedings or actions, including actions taken in district court." *Wi-Fi One*, 878 F.3d at 1374.

Following this Court's decision in *Cuozzo*, the Federal Circuit's en banc decision in *Wi-Fi One* rightly relied on "the 'strong presumption' favoring judicial review of administrative actions, including the Director's IPR institution decisions" and found "no clear and convincing indication in the specific statutory language in the AIA, the specific legislative history of the AIA, or the statutory scheme as a whole that demonstrates Congress's intent to bar judicial review of § 315(b) time-bar determinations." *Id.* at 1371-72 (quoting *Cuozzo*, 136 S. Ct. at 2140). The court distinguished the time-bar determination under § 315(b) (which is not a discretionary decision and not subject to an appeal bar) from the merits-based analysis of § 314(a) (which is discretionary and is subject to an appeal bar): "[t]he time-bar determination . . . is not akin to either the non-initiation or preliminary-only merits determinations for which unreviewability is common in the law." *Id.* at 1373.<sup>8</sup> But the Federal Circuit has now carved out an exception that swallows the rule: if the decision was adverse to the petitioner – and thus denied institution based on finding that the petitioner is a "privy" of a party who was earlier sued and thus subject to the time-bar – then the Federal Circuit no longer applies this Court's guidance in *Cuozzo* or its own rule in *Wi-Fi One*. Moreover, the logical end to this new Federal Circuit exception is that only the patent owner can appeal an institution decision based 315(b), since a petitioner would never have an instituted proceeding from which to appeal. This exception defies the rationale of those cases, and is

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8. Moreover, the Federal Circuit held that unreviewability is "limited to the Director's determinations closely related to the preliminary patentability determination or the exercise of discretion not to institute," and "[w]hether a petitioner has complied with § 315(b) is not such a determination." *Id.*

exactly backwards from the standpoint of due process: the PTAB's finding that a petitioner is a privy of another party has a substantive effect on rights based on the resulting estoppels that follow a petitioner after termination of the IPR, and so this is precisely the type of decision that must be subject to review.

This case is an ideal vehicle for addressing the question regarding the Federal Circuit's jurisdiction to hear issues affecting the substantive rights of parties unrelated to the Director's exercise of discretion under §314(a). The Court should therefore grant the petition.

**I. The Federal Circuit's Decision that it Does Not Have Jurisdiction to Review a PTAB Decision Affecting the Substantive Rights of a Petitioner – a Decision Unrelated to the Director's Discretion to Institute Review – Leaves the Reviewability of the PTAB's Decisions in a State of Confusion**

**A. The Federal Circuit Contravened *Cuozzo*, *Wi-Fi One* and *Arthrex***

This case presents the opportunity for the Court to clarify the proper scope and application of § 314(d), and to eliminate the improper exception that the Federal Circuit has imposed on the principles of reviewability articulated by this Court in *Cuozzo* and the en banc Federal Circuit in *Wi-Fi One*. This Court should confirm that the procedural juncture at which the PTAB decides the applicability of the § 315(b) time-bar is irrelevant to its reviewability, particularly given the denial of due process that occurs by (i) imposing a substantive estoppel by an administrative agency's determination that a party is a "privy" under the

AIA's IPR scheme but (ii) denying any the opportunity for appellate review of that determination.

**1. The en banc Court in *Wi-Fi One*, Relying on *Cuozzo*, Held that Time-Bar Determinations Under §315(b) are Reviewable**

The specific issue in *Cuozzo* was the ability to review the PTAB's decision to institute an IPR under § 314(a), in light of *Cuozzo*'s assertion that the petition lacked the "particularity" required by 35 U.S.C. § 312. *Cuozzo*, 136 S. Ct. at 2142. In *Cuozzo*, this Court expressly limited its holding to the facts of that case, and left it for the Federal Circuit to decide the proper application of § 314(d) to other IPR appellate issues, such as the § 315(b) time-bar issue, in light of the guidance provided by *Cuozzo*:

[W]e emphasize that our interpretation 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. See § 314(d) (barring appeals of "determinations . . . to initiate an inter partes review *under this section*" (emphasis added)). This means that we need not, and do 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 "this section."

*Id.* at 2141 (emphasis in original). The Court also expressly recognized exceptions allowing review when “there is a due process problem” or the PTAB “act[ed] outside of its statutory limits,” noting that “[s]uch ‘shenanigans’ may properly be reviewable” under 35 U.S.C. § 319 or the Administrative Procedure Act. *Id.* at 2141-42 (citing 5 U.S.C. §§ 706(2)(A)-(D)).

Following *Cuozzo*, the en banc Federal Circuit considered the scope of § 314(d) as it applied to a review of a PTAB decision under § 315(b) after a final written decision was issued in *Wi-Fi One*. The Federal Circuit stated that “[t]he [*Cuozzo*] Court made clear that its holding was limited; it expressly left open the potential for review, under certain circumstances of decisions to institute IPR.” *Wi-Fi One*, 878 F.3d at 1369-70. Thus, the *Wi-Fi One* court considered whether the § 315(b) time-bar issue was closely related to § 314 such that the appeals bar of § 314(d) should apply.

In conducting its review, the en banc Federal Circuit recognized that there is a “‘strong presumption’ favoring judicial review of administrative actions, including the Director’s IPR institution decisions,” and noted that “[f]inal decisions of the PTO are reviewable according to the standard provided by the Administrative Procedures Act,” and that “28 U.S.C. 1295(a)(4)(A) provides exclusive jurisdiction over an appeal from a decision of the Patent Trial and Appeal Board . . . with respect to inter partes review under title 35.” *Id.* at 1371-72 n.6.

In view of this strong presumption of judicial review, the Federal Circuit reviewed the statutory language and legislative history of AIA. It held “[t]he parties have not

cited, nor are we aware of, any specific legislative history that clearly and convincingly indicates congressional intent to bar judicial review of § 315(b) time-bar determinations.” *Id.* at 1372.

With respect to the language of the statute, the *Wi-Fi One* court correctly noted that § 314(a) identifies a threshold merits requirement “focused on the patentability merits of particular claims,” and it grants the Director discretion to not institute *even when* the threshold is met. *Id.* The Federal Circuit then contrasted the language of § 314(a) with the language of § 315(b), holding that § 315(b) is “unrelated to the Director’s preliminary patentability assessment or the Directors’ discretion not to initiate an IPR even if the threshold ‘reasonable likelihood’ is present.” *Id.* at 1373. Absent such a bar, the ordinary reviewability of administrative decisions from the PTAB pursuant to 28 U.S.C. § 1295(a)(4)(A) controls; there is no further limitation to consider. The Federal Circuit ruled that the bar under § 314(d) does not apply to § 315(b) time-bar determinations: “time-bar determinations under § 315(b) are reviewable by this court.” *Id.* at 1374.

The distinction between the merits-based, discretionary decision under §314(a) and the non-merits based, non-discretionary decision under § 315(b) comports with the dictates of due process. A decision not to institute a petition based on a discretionary decision applying the “reasonable likelihood” threshold does not impose any substantive estoppel in the district court or any other hardship on a party (and thus the absence of appellate review does not necessarily implicate due process). On the other hand, a decision finding that a petitioner is a privy of another (as the sole basis for finding that a petition is

time-barred) does impose a substantive estoppel that is not based on the Director's discretionary authority.

Here, however, the Federal Circuit has imposed a distinction based on the procedural juncture at which the time-bar decision was issued, even though that procedural distinction has nothing to do with the statutory or constitutional basis for the reviewability of time-bar decisions under § 315(b). Thus, the Federal Circuit panel here, consistent with the position of the Director as Intervenor below, seized on the procedural happenstance that *Wi-Fi One* involved a decision to institute that was challenged after issuance of a final written decision. But, the question of whether a final written decision has issued is only relevant if § 314(d) applies to time-bar decisions under § 315(b). And the entire point of *Wi-Fi One* – based on the guidance from this Court in *Cuozzo* – is that § 314(d) *is not applicable to time-bar decisions under § 315(b)*. Again, the rationale utilized by this Court for why § 314(d) is not an absolute bar to appeal applies equally to a denial of institution because § 315(b) “is not closely related to § 314(d)” regardless of whether the § 315(b) decision is made at the time of institution or in a final written decision.<sup>9</sup> Accordingly, the question of whether a final written decision has issued has nothing to do with the existence of jurisdiction to review time-bar decisions under § 315(b). That jurisdiction exists under 28 U.S.C. § 1295(a)(4)(A), and is not excluded by any other statute. It should be of no import whether the PTAB decision

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9. The *Wi-Fi One* court held that the §315(b) time-bar is fundamentally different than a procedural requirement and is unrelated to the question of patentability being addressed by the institution decision. *Wi-Fi One*, 878 F.3d at 1374.

affects the substantive rights of ARRIS at the institution stage, or whether it does so at the final written decision stage. Both situations require that the PTAB's decision be reviewable so that the ARRIS is not deprived of its right to due process.

Here, the panel decision denying review affects the substantive rights of ARRIS as it relates to the previous IPR filed by Cisco Systems, Inc. (and naming the Delaware Defendants as real parties in interest), as well as the actions taken by the Delaware Defendants in the district court litigation. The Federal Circuit has already established this point, as a decision under § 315(b) “governs the relation of IPRs to other proceedings or actions, including actions taken in district court.” *Wi-Fi One*, 878 F.3d at 1374. For example, the estoppel provision of 35 U.S.C. § 315(e) that arises from a final written decision in an IPR impacts a real-party-in-interest's or privy's ability to challenge the validity of the asserted patents in a district court action. Moreover, decisions from the PTAB may be given preclusive effect that go beyond the estoppel provisions of the AIA pursuant to this Court's holding in *B&B Hardware*. See also *MaxLinear, Inc. v. CF CRESPE LLC*, 880 F.3d 1373 (Fed. Cir. 2018) (holding that the *B&B Hardware* decision regarding issue preclusion arising from administrative decisions applies to proceeding before the PTAB). Thus, a finding by the PTAB that a petitioner is a privy of defendants in a district court litigation may be given preclusive effect in the litigation – such that a finding of infringement can be binding on a real-party-in-interest or privy.



**2. *Arthrex* Held that 35 U.S.C. § 319 Does Not Provide Exclusive Jurisdiction for Appeals from PTAB Decisions**

In the appeal below, ChanBond and the Intervenor argued that § 319 – which states that “[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” – provides the sole basis for review of a PTAB decision. The Federal Circuit should have rejected that argument in view of *Arthrex* and held that the language of 28 U.S.C. § 1295 on its face provides an appeal right for a PTAB decision made pursuant to § 315(b).

In *Arthrex*, the Federal Circuit considered whether an adverse final judgment by the PTAB that terminated an IPR before an institution decision issued is appealable. *Arthrex*, 880 F.3d at 1345. The Federal Circuit started its analysis by citing the general rule “that judicial review is presumed to be available with respect to final agency action,” and noted the strong presumption that Congress intends judicial review of administrative actions. *Id.* at 1348 (citing *Cuozzo* and the APA). The Federal Circuit then found that the adverse judgment was not an institution decision under § 314, and thus that the appellate bar of § 314(d) did not apply. *Id.* at 1348-49. The Federal Circuit held that the adverse judgment was a final determination because the judgment terminated the IPR proceedings. *Id.* at 1348. The Federal Circuit rejected the argument that § 319 created the exclusive means for appeal and held “[o]n its face, § 319 does not cabin the appeal rights by § 1295.” *Id.* Based on these findings, the Federal Circuit held:

Here, the language of 28 U.S.C. § 1295 appears to provide for appeal. Section 1295(a)(4)(A) provides the Federal Circuit with jurisdiction over “an appeal from a decision of the Patent Trial and Appeal Board of the United States Patent and Trademark Office with respect to . . . inter partes review under title 35. The adverse judgment in this case is a decision of the Board, and the decision is “with respect to” an inter partes review proceeding. The judgment is also final, as the judgment terminated the IPR proceeding. *See In re Arunachalam*, 824 F.3d 987, 988 (Fed. Cir. 2016) (holding that §1295(a)(4)(A) incorporates a finality requirement); *Copelands’ Enters., Inc. v. CNV, Inc.*, 887 F.2d 1065, 1067-68 (Fed. Cir. 1989)(en banc)(same).

*Id.*

The time-bar decision in this case is a decision of the PTAB, and the decision is “with respect to” an *inter partes* review proceeding. The judgment is also final, as the judgment terminated the IPR proceeding. It is therefore subject to 28 U.S.C. § 1295, and there is no statute excluding review of such a decision.

**3. The Federal Circuit’s Continued Reliance On *St. Jude* To Artificially Restrict Its Jurisdiction to Review Certain PTAB Institution Decisions Should Be Overruled in view of *Cuozzo*, *Wi-Fi One* and *Arthrex***

During the appeal below, ChanBond argued, and the Federal Circuit agreed, that the Federal Circuit’s prior

decision in *St. Jude* foreclosed ARRIS's appeal. App. 2a-3a. *St. Jude* held that (1) a review of the PTAB's decision under the time-bar of § 315(b) is barred by § 314(d), and (2) 28 U.S.C. § 1295(a)(4)(A) provides the Federal Circuit with jurisdiction only over final written decisions from the PTAB. *St. Jude*, 749 F.3d at 1376. However, both holdings from *St. Jude* are no longer viable in view of subsequent decisions from this Court in *Cuozzo* and *Weyerhaeuser*, and from the Federal Circuit in *Wi-Fi One* and *Arthrex*.

In light of *Wi-Fi One*, it is clear that the *St. Jude* court did not properly frame the issue of whether the appeal bar of § 314(d) applied to the time-bar of § 315(b). The *St. Jude* decision granted a motion to dismiss at the onset of an appeal of a denial of institution based on a § 315(b) time-bar decision. The *St. Jude* decision issued before *Cuozzo* and *Wi-Fi One*, and was premised upon the court's finding that the § 314(d) appeal bar "may well preclude all review by any route." *St. Jude*, 749 F.3d at 1376. Thus, the *St. Jude* court did not have the guidance from the *Cuozzo* and *Wi-Fi One* decisions that now limit the applicability of § 314(d).

Under the *Cuozzo* framework, the *St. Jude* court's analysis should have aligned with the analysis by the *Wi-Fi One* court to determine whether the § 315(b) time-bar was "closely related" to the § 314(d) appeal bar. Moreover, the *Wi-Fi One* decision highlights the point that *St. Jude* did not consider the applicable authorities from this Court in connection with its decision to preclude all review of the PTAB's § 315(b) determination. Specifically, the *St. Jude* panel did not consider the strong presumption of reviewability of agency action under the APA, or related cases from this Court cited by the en banc Federal Circuit

in *Wi-Fi One*. And, unlike the *Wi-Fi One* court, the *St. Jude* panel also failed to recognize that a decision under § 315(b) affects the substantive rights of the parties.

The *St. Jude* panel also held that pursuant to § 319, “[t]he final written decision is the only decision that the statute authorizes a dissatisfied party to appeal,” 749 F.3d at 1374, and that 28 U.S.C. § 1295(a)(4)(A) is “most naturally read to refer precisely to the Board’s decision under section 318(a) on the merits of the *inter partes* review, after it ‘conducts’ the proceeding that the Director has ‘instituted.’” *Id.* at 1376. The *St. Jude* panel thus did not have the guidance of *Arthrex* that held that final written decisions under § 318(a) are not the only decisions that may be appealed, and that 28 U.S.C. § 1295(a)(4)(A) provides jurisdiction to a final determination that terminates the IPR proceedings. *Arthrex*, 880 F.3d at 1349.

For all of the foregoing reasons, the Court should overrule the decision of the Federal Circuit below that was based on *St. Jude*, which is no longer viable in view of *Cuozzo*, *Wi-Fi One* and *Arthrex*.

**B. Even if the PTAB’s Decision to Deny Institution is Committed to Agency Discretion, the Decision is Available for Review Under *Weyerhaeuser***

While the *Cuozzo* Court stated that “the agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion,” *Cuozzo*, 136 S. Ct. at 2140, this does not foreclose review of the agency’s determination of whether the § 315(b) time-bar applies, as the *Wi-Fi One* court held that the time-bar is “unrelated” to

the Director's discretion. *Wi-Fi One*, 878 F.3d at 1377. Nevertheless, as made clear in the recent *Weyerhaeuser* decision, the fact that a matter is committed to agency discretion does not make it unreviewable. *Weyerhaeuser*, 139 S. Ct. at 361.

*Weyerhaeuser* considered a property owner's ability to challenge the Secretary of the Interior's designation of the property owner's land as a critical habitat under 16 U.S.C. § 1533(b)(2) of the Endangered Species Act. *Weyerhaeuser*, 139 S. Ct. at 368. The Endangered Species Act provides discretionary authority to the Secretary to designate a "critical habitat" but also requires that the Secretary consider the economic and any other relevant impact in making its discretionary determination of critical habitat. *Id.* at 368-69.

This Court noted that the APA creates a "basic presumption of judicial review [for] one 'suffering legal wrong because of agency action.'" *Id.* at 370 (citing *Abbott Lab. v. Gardner*, 387 U.S. 136, 140 (1967) (quoting 5 U.S.C. § 702)). The Court further noted that "[t]he presumption may be rebutted only if the relevant statute precludes review, 5 U.S.C. § 701(a)(1), or if the action is 'committed to agency discretion by law,' § 701(a)(2)." *Id.*

*Weyerhaeuser* recognized the tension between the APA's "prohibition of judicial review for actions committed to agency discretion" under 5 U.S.C. § 701(a)(2), and "the command in § 706(2)(A) that courts set aside any agency action that is arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with the law." *Id.* (internal quotation marks omitted).

The Court found that the property owner was not foreclosed from seeking review of the Secretary's decision, holding even though the use of the word "may" in the statute "certainly confers discretion on the Secretary," this discretion does not relieve the Secretary from the statutory requirement to consider the economic impact. *Id.* at 371.

In so holding, the Court reiterated its position that it reads the exception to judicial review in § 701(a)(2) narrowly, restricting it to "those rare circumstances where the relevant statute is drawn so that a court would have no meaningful standard against which to judge the agency's exercise of discretion." *Id.* at 370 (citing *Lincoln v. Vigil*, 508 U.S. 182, 191 (1993)). This case is not one of those rare circumstances. Courts are well-equipped to address the § 315(b) issues of privity, real party in interest, and time limits – even more so than the PTAB.

Here, like the statute in *Weyerhaeuser*, the Patent Statute provides relevant factors under § 315(b) to guide the PTAB in the exercise of its discretion under § 314(a). Thus, this case is not one of those rare instances in which an agency's exercise of discretion is not reviewable. Rather, contrary to the position adopted by the Federal Circuit below, the APA does provide a cause of action under § 706(2)(A) to challenge the Director's discretionary decision under § 314(a) with respect to the relevant factors set forth in § 315(b), and the Federal Circuit has jurisdiction to hear that cause of action under 28 U.S.C. § 1295(a)(4)(A).

**II. This Case is an Ideal Vehicle to Resolve the Jurisdiction of the Federal Circuit to Review PTAB Decisions Denying Institution Based on the Time-bar of 35 U.S.C. § 315(b)**

This case presents an ideal opportunity to address the reviewability of PTAB decisions that affect the substantive rights of a party unrelated to the Director's decision whether to institute review under § 314(a). This issue was squarely presented below. This case presents the opportunity for the Court to clarify the proper scope of § 314(d) post-*Cuozzo*, post-*Wi-Fi One* and post-*Arthrex*, and specifically to decide the applicability of § 314(d) to the § 315(b) time-bar issue at the institution stage. Clarification of this issue is particularly needed given that the imposition of a substantive estoppel by an administrative agency without the opportunity for appellate review deprives a party of its due process rights. The Court already has recognized the importance of the scope of the appeal bar under § 314(d) as it applies to the time-bar under § 315(b) in its recent grant of a petition for a writ of certiorari in *Dex Media, Inc., v. Click-To-Call Technologies, LP*, No. 18-916 (2019). Because of the importance of the questions presented, and because this petition is an ideal vehicle for addressing it, the Court should grant this petition for a writ of certiorari and address the questions presented in this case together with the *Dex Media* case to expand review of the scope of the appeal bar under § 314(d) to consider time-bar decisions under § 315(b) when the PTAB denies institution.

**CONCLUSION**

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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