

No. 21-118

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

APPLE INC.,

*Petitioner,*

v.

OPTIS CELLULAR TECHNOLOGY, LLC, ET AL.,

*Respondents.*

On Petition for a Writ of Certiorari  
to the United States Court of Appeals  
for the Federal Circuit

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**BRIEF FOR THE PRIVATE RESPONDENTS  
IN OPPOSITION**

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## QUESTION PRESENTED

“Congress has committed the decision to institute inter partes review to the . . . unreviewable discretion” of the Director of the U.S. Patent and Trademark Office. *United States v. Arthrex, Inc.*, 141 S. Ct. 1970, 1976 (2021). Specifically, “the determination by the Director whether to institute an inter partes review under [35 U.S.C. § 314] shall be final and nonappealable.” 35 U.S.C. § 314(d). Here, the Director’s delegate decided not to institute inter partes review of three patents Apple sought to challenge. Apple sought to appeal the decisions not to institute.

The question presented is as follows:

Whether Apple’s appeal of the decisions not to institute inter partes review is barred by the statute providing that “the determination by the Director whether to institute an inter partes review” is “final and nonappealable.”

## **PARTIES TO THE PROCEEDING**

Petitioner Apple Inc. was the appellant in the Federal Circuit and the petitioner before the Patent Trial and Appeal Board.

The private respondents, which were appellees in the Federal Circuit and patent owners in the proceedings before the Patent Trial and Appeal Board, are Optis Cellular Technology, LLC (Fed. Cir. No. 21-1043), Optis Wireless Technology, LLC (Fed. Cir. No. 21-1044), and Unwired Planet International Limited (Fed. Cir. No. 21-1046).

The federal respondent, who was a statutory intervenor in the Federal Circuit, is the Director of the United States Patent and Trademark Office, in official capacity.

## **RULE 29.6 STATEMENT**

No publicly traded company owns 10% or more of any private respondent. Optis Wireless Technology, LLC, is wholly owned by Optis WT Holdings, LLC. Optis Cellular Technology, LLC, is wholly owned by Optis CT Holdings, LLC. Unwired Planet International Limited is wholly owned by H57 Acquisition, LLC.

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## INTRODUCTION

Apple has tried to invalidate three patents owned by respondents<sup>1</sup> in district court, but has so far been unsuccessful. It has also persuaded the Patent Office to reexamine the same three patents, but so far has been unsuccessful there, too. This petition is about its attempt to resurrect its challenge of the same three patents, on essentially the same grounds, through a third avenue—inter partes review (IPR).

As this Court has repeatedly recognized, the decision whether to institute an IPR is discretionary. The Patent and Trademark Office (PTO) declined to exercise its discretion in Apple’s favor. So Apple argues that appellate courts can *force* the Executive Branch to institute an IPR by disapproving its reasons for declining to do so.

That is exactly what Congress did not allow. IPR is only one of several procedures, both judicial and administrative, to challenge patents’ validity. As a result, a petitioner whose request for an IPR is denied has not lost anything of substance. And judicial review of which IPRs to conduct would waste resources better spent on IPRs themselves.

Congress therefore decided that “[t]he determination by the [PTO] Director whether to institute an inter partes review under [35 U.S.C. § 314] shall be final and nonappealable.” Apple cannot appeal a determination that is “nonappealable.” That holding is not certworthy—or even complicated.

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<sup>1</sup> This brief refers to the private respondents as “respondents” and to the federal respondent as “the government.”



Nor is there any reason to stretch the statute as Apple wants. The substance of Apple's attack on the PTO's criteria for exercising discretion is this: Apple claims that the criteria for IPR institution should *never* take into account whether the same challenges to the same patents are already pending in district court—not even when, as here, the district court has held a jury trial. Even treating it as one of many factors, Apple says, is arbitrary and capricious and warrants a formal rulemaking.

If that sounds like an administrative-law challenge to agency decisionmaking, rather than an appeal of a single decision, Apple thought so too. That is why Apple and several other giant technology companies are pursuing an APA action raising the same criticisms of the PTO's multifactor test—plus other arguments that Apple basically acknowledges (*see* Apple Reply 6) it cannot raise in an appeal from individual institution decisions. And while the government is resisting that action, Apple is pursuing it in the Federal Circuit—where it will continue to argue that the APA action can proceed even if appeals are barred. Indeed, the Federal Circuit has previously noted that litigants' ability to litigate these issues in an APA action is a reason *not* to hear them on mandamus. This Court should not entertain Apple's extraordinary pitch to make “nonappealable” orders appealable, ostensibly to ensure that agency action does not go unreviewed, while Apple itself is still actively pursuing judicial review by more ordinary means.

Nor is it even clear that the PTO will retain the multifactor *NHK/Fintiv* approach to which Apple objects. The PTO has solicited and received hun-

dreds of comments on discretionary denials of IPR petitions, and the President’s nominee for the PTO Director position recently expressed her “commit[ment] to considering whether *Fintiv* should be modified.” P. 9, *infra*. Apple’s contention that the questions presented are certworthy is just a repackaging of its criticisms of the *NHK/Fintiv* factors. If the PTO is revisiting how it makes institution decisions, there is no reason for this Court to revisit the statute making institution decisions “nonappealable”—a statute this Court construed just two years ago.

Apple’s arguments are best raised to the PTO itself, and to the extent the PTO rejects them, the APA is a more natural pathway to challenge that decision than an appeal from a “nonappealable” decision. All the Federal Circuit has done is to treat those “nonappealable” decisions as nonappealable. That straightforward application of the statute does not warrant further review by this Court.

### STATEMENT

1. Nearly a year into litigation against respondents and less than six months before the trial date, Apple filed petitions for inter partes review asking the Patent Trial and Appeal Board to review and cancel various claims of three of the patents asserted against Apple in the district court. Under the ordinary schedule, the Board’s institution decision is due six months after an IPR petition receives a filing date. 35 U.S.C. § 314(b); 37 C.F.R. § 42.107(b). Thus, Apple knew when it filed the petition that the Board likely would not even decide whether to institute an IPR until after the trial date. That is exactly

what happened: the jury rejected Apple’s invalidity arguments about a month before the Board rendered its institution decisions. Pet. App. 6a n.1, 19a, 38a, 55a.

The Board requested briefing on the overlap between the grounds Apple asserted at trial and the grounds Apple wanted to assert in the IPRs. Apple’s IPR petitions targeted all of the same claims respondents were asserting at trial (and others). The IPR petitions all raised a ground of invalidity that Apple also litigated at trial—obviousness under 35 U.S.C. § 103. And as the Board subsequently explained, the content of the obviousness arguments in the IPR petitions overlapped substantially with Apple’s case at trial. For instance, with respect to the ’833 patent: “[T]wo of the references, including the primary reference Qualcomm, are the same in both combinations. And, to the extent the other two references in each combination are different, [Apple] treated the respective pairs of references interchangeably.” Pet. App. 25a; *accord* Pet. App. 41a-42a (finding “substantial overlap in the claimed subject matter challenged in the Petition and the parallel proceeding”); *see also* Pet. App. 60a (same claim-construction issue on different prior-art references).

After receiving that briefing, the Board denied Apple’s petitions to institute IPRs on the three patents. In each case, while the Board did not rule on the “reasonable likelihood” of invalidity necessary to permit an IPR, it did consider the strength of the petition in its analysis. 35 U.S.C. § 314(a); *see, e.g.*, Pet. App. 62a.<sup>2</sup> The Board held that it would not ex-

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<sup>2</sup> For example, the Board noted what appeared to be missing from the references and (consistent with arguments made by

ercise its discretion to institute an IPR on any of the three, because to do so would be “an inefficient use of Board resources.” Pet. App. 29a, 46a, 62a. The Board did so while applying the multifactor, non-exclusive balancing test set out in two precedential decisions, *NHK* and *Fintiv*. *E.g.*, Pet. App. 17a-18a.

The Board emphasized that the same parties, and the district court, had already “expended considerable time and effort” litigating the validity of the same patents at a jury trial, and that the jury had upheld all the claims-in-suit. *E.g.*, Pet. App. 29a; *accord* Pet. App. 26a. If the Board were to institute an IPR, it would not reach a final written decision for more than a year after the jury verdict. *E.g.*, Pet. App. 19a, 29a. The Board recognized that Apple disagreed with the jury’s verdict, but noted that there were “ample procedural safeguards” available through the litigation process, “including the availability of an appeal to the U.S. Court of Appeals for the Federal Circuit once post-trial proceedings have been completed.” Pet. App. 28a.<sup>3</sup>

2. Thereafter, Apple asked the PTO to review the same three patents through the alternative procedure of *ex parte* reexamination. *See* 35 U.S.C. §§ 301 *et seq.*; *Return Mail, Inc. v. U.S. Postal Serv.*, 139

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respondents) that the IPR petition’s showing on the merits was not strong enough to outweigh the reasons for discretionary denial. *E.g.*, Pet. App. 45a.

<sup>3</sup> The district court subsequently ordered a partial new trial on damages, but did not disturb the jury’s verdict on validity or infringement. The parties retried the issue of damages to a second jury, which reached a verdict on August 13, 2021. *Optis Wireless Tech., LLC v. Apple Inc.*, No. 2:19-cv-00066, ECF No. 684 (E.D. Tex. filed Aug. 13, 2021). Post-verdict motions are pending.

S. Ct. 1853, 1859-60 (2019) (describing *ex parte* reexamination). Just as it had at trial and in its IPR petitions, Apple contended that various claims of the three patents were invalid as obvious, in light of the prior art. Apple's requests for reexamination were substantively identical to its petitions for IPRs, relying on the same prior art.

Two of those reexaminations have concluded, and in both instances, the examiners rejected Apple's obviousness arguments and confirmed that the claims were patentable. See Gov't Opp. 12 n.3; Reexamination Control No. 90/014,613 (Nov. 20, 2011) (reexamination of U.S. Patent No. 9,001,774). The third reexamination, of the '557 patent, is ongoing.<sup>4</sup>

3. In parallel, Apple and several other technology companies have sued the PTO Director in the Northern District of California under the APA. That action contends that *NHK* and *Fintiv* amount to agency rules and that they are both substantively and procedurally flawed on numerous grounds. *Apple Inc. v. Iancu*, No. 5:20-cv-6128, ECF No. 1 (N.D. Cal. filed Aug. 31, 2020). The district court dismissed that action on the ground that review is precluded by statute, and Apple and its fellow plaintiffs have appealed to the Federal Circuit. *Apple Inc. v. Iancu*, No. 5:20-cv-6128, 2021 WL 5232241, at \*5-6 (N.D. Cal. Nov. 10, 2021), *appeal docketed sub nom. Apple Inc. v. Hirshfeld*, No. 22-1249 (Fed. Cir.).

4. While pursuing its challenges in district court and seeking the *ex parte* reexaminations, Apple appealed to the Federal Circuit from the three orders

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<sup>4</sup> This is the patent on which the Board commented most negatively on the merits of Apple's arguments. See Pet. App. 45a.

declining to institute IPR. The Federal Circuit dismissed all three, and declined Apple’s alternative request for mandamus, “[f]or the same reasons” given in two earlier decisions. Pet. App. 3a. In one of those earlier decisions, the Federal Circuit had noted the pendency of the same APA action as a reason why the extraordinary remedy of mandamus was not warranted: the APA action “clearly” was “a readily available alternative legal channel to raise its arguments.” Pet. App. 73a (*In re Cisco Sys. Inc.*, 834 F. App’x 571, 573-74 (Fed. Cir. 2020)).

### REASONS FOR DENYING THE WRIT

Because this Court already has extensive briefing on the merits and certworthiness of the questions presented, both from the government and from Janssen as respondent in the companion *Mylan* case, No. 21-201, respondents focus this brief on recent developments that bear on certworthiness and aspects of the merits that the government does not emphasize.

#### **I. Review of the questions presented would be premature irrespective of the merits.**

Apple does not seriously suggest that the questions presented have any significance outside the context of efforts to challenge the Board’s *NHK/Fintiv* factors. *See* Pet. 30-33.<sup>5</sup> Indeed, Apple’s arguments for

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<sup>5</sup> Apple’s only attempt to suggest that the question presented would have lasting significance is the conclusory assertion that the issue would matter “when the Board denies an IPR petition based on any rule that exceeds the agency’s statutory bounds and violates the APA.” Apple Reply 10. But Apple does not identify even a single example of that type of challenge other than to the *NHK/Fintiv* factors. *Id.*; Pet. 33. And this Court

reviewability are closely bound up with the arguments it wants to make against those factors specifically. *See* Apple Reply 6. But it is far from clear that the PTO will retain those factors in their present form, even in the short term. Even if it does, their significance is declining. And Apple and its fellow plaintiffs continue to pursue their APA challenge, the viability of which remains undetermined.

1. The new Administration is on the verge of swearing in a new PTO Director, who during her confirmation hearing expressed not just willingness to reconsider the *NHK/Fintiv* factors but an understanding that such reconsideration is already underway. Apple acknowledges that the PTO has already solicited and received public comments on these matters, but complains that it has not formally initiated a rulemaking. Apple omits, however, that the PTO has been in transition—awaiting the new Administration and a new Director—since before the close of the comment period on December 2, 2020, *see* 85 Fed. Reg. 73,437 (Nov. 18, 2020).

Asked whether “*Fintiv* should be modified” to address concerns that echo some of Apple’s, the nominee for the PTO Director position, Katherine Vidal, told the Senate Judiciary Committee that “there is the preliminary work for that going on right now” and that “it definitely warrants consideration,” “given the debate over *Fintiv* and its application and ...

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has already rejected the notion that a party can create appellate jurisdiction just by asserting that the PTO has exceeded its statutory bounds. *See Thryv, Inc. v. Click-to-Call Techs., LP*, 140 S. Ct. 1367, 1376 (2020). Apple’s claim that the questions presented are “recurring” thus just means that the Board continues to apply *NHK* and *Fintiv*.

how it impacts different stakeholders.” *Senate Judiciary Committee Holds Hearings on Pending Nominations*, CQ Congressional Transcripts, at 58 (Dec. 1, 2021). Ms. Vidal told the Committee more bluntly in her response to written questions: “I commit to considering whether *Fintiv* should be modified.”<sup>6</sup> And she specifically acknowledged the same criticism about shifting trial dates that Apple makes in its petition (at 31-32).<sup>7</sup> By contrast, she declined one Senator’s invitation to “commit to continue applying the *Fintiv* factors.”<sup>8</sup>

Moreover, even before a new Director takes office, the PTAB has been relying less often on the *NHK/Fintiv* factors to deny petitions for IPR. See Britain Eakin, *As Attys Sharpen Strategies, Fintiv Denials Are Falling*, Law360, Oct. 27, 2021, <https://www.law360.com/articles/1434925/as-attys-sharpen-ptab-strategies-fintiv-denials-are-falling>.

Apple and Mylan are pursuing these petitions for one reason: they want the Federal Circuit, or this Court, to force the PTO to abandon the *NHK/Fintiv* factors. Mylan even wants the Court to grant certiorari on the question whether the factors themselves are invalid. 21-202 Pet. ii. None of the questions presented warrants review by this Court while the factors themselves are under review at the PTO.

2. Even if the PTO remains committed to the factors and Apple remains aggrieved by them, Apple is actively challenging them in another way: its APA

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<sup>6</sup> <https://www.ipwatchdog.com/wp-content/uploads/2021/12/Vidal-Answers-to-QFRs-FINAL.pdf>, at 36.

<sup>7</sup> *Id.* at 35-36.

<sup>8</sup> *Id.* at 35.



action. And while the PTO contends that that door is closed, too, that is far from settled. At a minimum, Apple's APA action faces fewer jurisdictional obstacles than its appeals do, and an APA action would concededly allow Apple to raise more of its arguments than an appeal would. It would be especially premature to assess the availability of mandamus—a last-ditch remedy—so long as the APA avenue potentially remains open.

Apple's appeal is barred by the statute making institution decisions "nonappealable." But its APA action is not an appeal. As Apple briefly notes (Reply 9 n.2), the district court recently dismissed its APA action because it "cannot deduce a principled reason why preclusion of judicial review under § 314(d) would not extend to the Director's determination that parallel litigation is a factor in denying IPR." *Apple*, 2021 WL 5232241, at \*6. But the district court cited no on-point Federal Circuit case, and Apple and its fellow plaintiffs have now appealed to the Federal Circuit—indicating that they, too, think the issue remains open there. At a minimum, the Federal Circuit will have to address whether § 314(d) reaches far enough to bar APA litigation; Apple contends that its APA challenge to the *NHK/Fintiv* factors "does not challenge any non-institution decision." Reply 9 n.2; *see* Apple Opp. to Mot. to Dismiss, No. 5:20-cv-6128, ECF No. 92, at 17-18 (N.D. Cal. filed Jan. 21, 2021). Here, by contrast, Apple *does* challenge specific non-institution decisions, so the question is easy—a "nonappealable" decision may not be appealed.

It is particularly important to settle the question whether relief is available under the APA before ad-

addressing the availability of mandamus. Apple’s pitch on mandamus is that it has no other way of challenging the *NHK/Fintiv* factors. But whether that is right depends on whether its APA appeal succeeds.

Notably, as Apple and its co-plaintiff Cisco emphasized in the district court (Apple Opp. to Mot. to Dismiss at 20), the Federal Circuit has previously pointed to Apple and Cisco’s APA action as a reason to deny Cisco’s petition for mandamus (similar to Apple’s here). “Without drawing any definitive conclusions on the issue,” the court “note[d] that Cisco is also pursuing alternative legal channels to raise its substantive and procedural arguments concerning that precedent, [citing Apple and Cisco’s APA complaint], and clearly has *a readily available alternative legal channel* to raise its arguments concerning the validity of the asserted patents.” Pet. App. 73a (*In re Cisco*, 834 F. App’x at 573-74) (emphasis added). “For the same reasons set forth in” that decision, the Federal Circuit denied Apple’s mandamus petition here. Pet. App. 3a. Apple attacks other elements of the Federal Circuit’s mandamus reasoning, but its only response regarding the APA action is the conclusory assertion that the pendency of that suit “does not support the denial of mandamus.” Pet. 29 n.6. Apple conspicuously does not argue that its APA action is not a “readily available alternative” to the extraordinary remedy of mandamus.

The government understandably does not want to suggest that Apple’s APA action might be justiciable. But it is incontrovertible that Apple is raising all the same arguments in its APA action. Indeed, it may even be raising *more*, because in this case it is now trying to downplay one of those arguments—that the

*NHK/Fintiv* factors conflict with various provisions of the AIA and its legislative history—because it recognizes that that argument requires consideration of the IPR statute and thus supports the government’s view that the appeals are barred. *Compare* Pet. 7, 30-31 (spelling out that argument) *with* Apple Reply 6 (acknowledging that this argument requires consideration of institution-related statutes). And, as noted, Apple’s APA action does not actually seek to “appeal” any specific institution decision. Thus, Apple’s APA action raises more arguments and has a more arguable basis for evading § 314(d).

To be clear: none of this is to say that Apple has a *meritorious* APA action. There are numerous reasons why Apple’s challenge to the *NHK/Fintiv* factors is likely to fail on the merits.<sup>9</sup> But even if its underlying challenge to the Board’s policy were more substantial, that would not mean the challenge should proceed *via appeal*—of individual orders Congress designated “nonappealable.”

## **II. Apple has no right to appeal a decision that Congress made “nonappealable.”**

The government and, in the companion case, Janssen have ably explained why the Federal Circuit’s jurisdictional ruling is correct, straightforward, faithful to the statute, and not certworthy. Respond-

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<sup>9</sup> In particular, Apple’s argument that the PTO is virtually *never* allowed to consider whether an IPR would be duplicative and wasteful, in light of other litigation on the same patent that is farther along and closer to resolution, rests on an insubstantial combination of dubious inferences and floor statements from individual Senators.

ents adopt those arguments but offer the following additional points.

Apple’s jurisdictional theory rests on two propositions: that Congress granted jurisdiction to review institution decisions in 28 U.S.C. § 1295(a)(4), and that Congress did not bar appeals like this one in 35 U.S.C. § 314(d). Both propositions are wrong. Read together, the two statutes permit no appellate review of institution decisions. Apple’s contrary reading would make jurisdiction turn on distinctions about what the parties plan to argue that appear nowhere in the statute.

1. The consideration of a petition to institute an IPR is not itself an “inter partes review.” And the statute assigns the institution decision to the Director, not the Board. For both reasons, Apple is incorrect in arguing that Congress granted jurisdiction over appeals *from institution decisions* when it granted jurisdiction over “an appeal from a decision of ... *the Patent Trial and Appeal Board* ... with respect to a[n] ... inter partes review under title 35.” 28 U.S.C. § 1295(a)(4) (emphasis added).

The statute carefully distinguishes between the inter partes review itself and the petition stage. At the petition stage, the decision to be made is “whether to institute an inter partes review.” 35 U.S.C. § 314(b), (d). Only after a favorable decision does “the review” itself “commence.” *Id.* § 314(c). And only “if an inter partes review is instituted” can there be a final written decision or estoppel for the losing party. *Id.* § 318(a); *see id.* §§ 315(e), 317(a); *see also* 77 Fed. Reg. 48,680, 48,703-04 (Aug. 14, 2012) (determination not to institute IPR “does not trigger the estoppel provisions”).

Moreover, wherever the statute refers to the decision “whether to institute,” it consistently refers to the Director as the official who makes it. *E.g.*, § 314(a), (b), (c), (d). By contrast, decisions in the “inter partes review” itself are made by the Board. *See, e.g., id.* §§ 316(c), 318.

To be sure, *after* Congress adopted the statute, the then-Director decided to delegate his institution authority to panels of the Board. The Federal Circuit has upheld that delegation (over a dissent). *Ethicon Endo-Surgery, Inc. v. Covidien LP*, 812 F.3d 1023, 1031-33 (Fed. Cir. 2016), *cert. denied*, 137 S. Ct. 625 (2017). But whether or not the Director can delegate his authority to subordinates, the point is that the statute refers to the authority as the Director’s. And any mention in the statute to the institution decision invokes the Director, not to the Board.

Thus, not surprisingly, the IPR statute’s only reference to appeal from an IPR is to appeal from “the final written decision of the Patent Trial and Appeal Board.” 35 U.S.C. § 319. So too in the Patent Act’s general appeal provision: “A party to an inter partes review ... who is dissatisfied with the final written decision of the Patent Trial and Appeal Board under section 318(a) ... may appeal the Board’s decision only to the United States Court of Appeals for the Federal Circuit.” *Id.* § 141(c).<sup>10</sup> By contrast, “the determination by the *Director* whether to institute an inter partes review under [§ 314] shall be final and nonappealable.” *Id.* § 314(d) (emphasis added).

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<sup>10</sup> For the reasons already explained, pp. 13-14, *supra*, if the petition to institute an IPR is denied, the inter partes review never commences and there is no “party to an inter partes review” who can appeal under § 141(c).

Apple’s jurisdictional argument therefore depends on reading § 1295(a)(4) in a manner completely divorced from the statutory structure. When a petition seeking to institute an IPR is denied, no inter partes review ever “commence[s].” 35 U.S.C. § 314(c). A decision not to institute therefore is not a “decision with respect to an inter partes review” in the relevant sense, just as a decision by this Court to deny certiorari would not be naturally called a “decision with respect to a merits case.” And if there were any doubt about that, it is dispelled by the fact that the statute never refers to the decision “whether to institute” as a “decision of ... the Patent Trial and Appeal Board.” It is a decision of the Director.

Worse still, Apple’s reading suggests that the Director, an Executive Branch subcabinet official, can determine the appellate jurisdiction of the federal courts. Apple’s argument would fail even on its own terms if the Director had never delegated the institution decision to the Board—or if the Director rescinded the delegation tomorrow. There is certainly no reason to read the statute as allowing the Director’s delegation to (unintentionally) create an avenue for appeal that Congress did not.

2. Apple’s disregard for the statutory structure extends to its reliance on this Court’s decisions interpreting § 314(d). Every one of those cases arose from a final written decision by the Board that was appealed under § 319; the question was whether review of that final written decision could *extend* to particular decisions that had been made at the institution stage. *Mylan Laboratories Ltd. v. Janssen Pharmaceutica, N.V.*, 989 F.3d 1375, 1379 (Fed. Cir. 2021) (21-202 Mylan Pet. App. 7a). And in the one

case in which the Court did not find the argument barred, the defect was in the final written decision, not the institution decision. *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1359-60 (2018) (IPR petitioner was “entitled to a final written decision addressing all the claims it has challenged”); *see id.* at 1354, 1355, 1357.

The other cases Apple cites found particular decisions the Board made at the institution stage barred from judicial review after a final written decision. To the extent the Court suggested that some hypothetical agency “shenanigans” could still be appealed under its view, it said explicitly that “[s]uch ‘shenanigans’ may be properly reviewable *in the context of* § 319 and under the Administrative Procedure Act.” *Cuozzo Speed Technologies, Inc. v. Lee*, 136 S. Ct. 2131, 2142 (2016) (emphasis added). Section 319, of course, deals exclusively with appeals from final written decisions by the Board.

Apple insists that the context does not matter and that anything reviewable in an appeal from a final written decision (such as “shenanigans”) must be reviewable in an appeal from an institution denial. Pet. 23-24. But as explained above, the jurisdictional statutes distinguish between those two categories of decisions: appeals from final written decisions are permitted except to the extent the right to appeal is withdrawn by § 314(d). Appeals from institution decisions are not permitted at all: not only is there no jurisdictional grant that authorizes them, but even if there were, the text of § 314(d)’s bar “encompasses the entire determination ‘whether to institute an inter partes review.’” *Thryv, Inc. v. Click-to-Call Techs., LP*, 140 S. Ct. 1367, 1375 (2020). Moreover,

it makes sense to permit broad judicial review of final written decisions, which take away patent rights (if the petitioner wins) or take away the right to challenge patents in court (if the patent owner wins, *see* 35 U.S.C. § 315(e)(2)). *Cf. Thryv*, 140 S. Ct. at 1375 (permitting appeal was not “necessary to protect patent claims from wrongful invalidation, for patent owners remain free to appeal final decisions on the merits”). Denials of institution have no such consequences. *See* p. 13, *supra*.

Because appeals from final written decisions have a sound jurisdictional basis, it makes sense to apply § 314(d) to particular lines of argument in those cases, as *Cuozzo* and *Thryv* did. Only arguments that challenge the institution decision are impermissible. In an appeal from a decision not to institute, by contrast, there is nothing else to challenge, and no need to engage in this kind of jurisdictional parsing: *every* argument challenges the “determination ... whether to institute an inter partes review.” Thus, every appeal from an institution denial is postured like *Thryv*, in which the appellant had no arguments directed to the final written decision—only the institution decision. 140 S. Ct. at 1373. The result there was “dismiss[al] for lack of appellate jurisdiction.” *Id.* at 1377. So too here.

As the Court said in *Thryv*, the “contention ... that the agency should have refused to institute inter partes review” is “unreviewable.” 140 S. Ct. at 1377; *accord id.* at 1373. So is the contention that the agency should *not* have refused to institute inter partes review. But that is exactly the contention Apple wants to raise on appeal. The Federal Cir-



cuit's decision that it cannot do so is correct and does not warrant any further review.

**III. This case would be a poor vehicle to examine the reviewability of discretionary denials.**

Apple's criticisms of the Board's discretionary denials do not reflect its own experience in this case. The three patents that Apple seeks to challenge had all been upheld in a jury verdict weeks before the Board denied Apple's petitions. Apple responded to those denials by returning to the PTO for another bite; it persuaded the PTO to initiate reexamination of all three patents. Apple, thus, has enjoyed multiple different chances to challenge respondents' patents—before a lay jury *and* before PTO experts. Its real gripe appears to be simply that it has not succeeded and wants a *third* bite. At this point, even if the Federal Circuit had jurisdiction to review the denial of institution, that denial could not possibly be an abuse of discretion even under the standard Apple proposes.

Whatever the merits and demerits of the *NHK/Fintiv* factors, this is a case in which an IPR clearly was not warranted. The same patents had already been through a jury trial, on overlapping prior art, before the Board even made its institution decisions. This therefore is not a case like those Apple criticizes (Pet. 31), in which IPR is denied based on “speculation” about the trial date and then the district court moves the trial back. Apple had a trial date, but waited until the last minute to file IPR petitions—perhaps for strategic reasons, given that an adverse final written decision would have estopped it

from raising the same arguments at trial. 35 U.S.C. § 315(e)(2). It would have been surprising to *allow* IPR under those circumstances.

Furthermore, the PTO has now finished reexamining two of the patents and has confirmed that the claims are patentable. The third reexamination is ongoing, on the patent for which the Board has already noted holes in Apple's obviousness case. *See* p. 6, *supra*. The reexamination outcomes and the Board's skepticism on the merits are still further reason to doubt that the Board would choose to institute an IPR today. And that has nothing to do with *NHK/Fintiv* factors: the statute expressly allows the Director to "reject" a petition to institute an IPR for the sole reason that "the same or substantially the same prior art or arguments previously were presented to the [PTO]." 35 U.S.C. § 325(d) (applying this rule to, *inter alia*, any "petition" seeking to "institute ... a proceeding under ... chapter 31," *i.e.*, an IPR); *see* Pet. 7. That is now the case here.

Thus, what Apple hopes to achieve is far from clear. For it to prevail, it would have to (1) convince this Court that the Federal Circuit has jurisdiction; (2) convince the Federal Circuit that the Board erred in applying the *NHK/Fintiv* factors to deny institution; (3) convince the Board that it should now grant institution, even two to three years after the first jury trial and even after agreeing to conduct *ex parte* reexamination on the same grounds; and (4) convince the Board to invalidate respondents' patents, which would take approximately a year from institution, *see* 35 U.S.C. § 316(a)(11). And recall that the jury has upheld all three patents and the PTO has more recently upheld two, with the third pending. The

Board has never suggested that there is any “reasonable likelihood,” *id.* § 314(a), that it would reach a different outcome as to any claim Apple challenges.<sup>11</sup>

Apple will no doubt argue that none of this matters—that any Board decision citing the *NHK/Fintiv* factors must be set aside and remanded for a new Board decision without those factors. Apple no doubt would seek to appeal that decision, too. The result would be *multiple* appeals of a “nonappealable” decision—all of them nitpicking the Board’s reasonable judgment that giving Apple yet another forum to challenge these three patents is not the best use of the Board’s resources. The better course is not to take up Apple’s invitation at all.

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<sup>11</sup> The Board has also denied, on the merits, another petition to institute an IPR of the ’833 patent based on different prior art. *Huawei Device Co. Ltd. v. Optis Cellular Tech. LLC*, No. IPR2018-00807, Paper 10 (P.T.A.B. Nov. 5, 2018).

**CONCLUSION**

The petition for a writ of certiorari should be denied.

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