

No. 21-888

IN THE
Supreme Court of the United States

INTEL CORPORATION,
Petitioner,

v.

VLSI TECHNOLOGY LLC,
Respondent.

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

REPLY BRIEF FOR PETITIONER

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INTRODUCTION

Twice this Court has emphasized that 35 U.S.C. §314(d) “does not ‘enable the [PTO] to act outside its statutory limits,’” and that “judicial review” of decisions whether to institute IPR “remains available” despite §314(d) “[i]f a party believes the Patent Office has engaged in ‘shenanigans’ by exceeding its statutory bounds.” *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359 (2018) (quoting *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 275 (2016)). The Federal Circuit has rendered those words meaningless. By construing §314(d) to bar review in precisely the circumstances in which this Court said review would “remain[] available,” the court of appeals has given the PTO free rein to deny IPR petitions—hundreds so far—based on a rule that contradicts the AIA, is irrational, and did not go through the required notice-and-comment process. The court’s approach shrinks the cardinal principle of judicial review to the vanishing point.

The government’s opposition understandably relies on this Court’s denial—after the petition was filed in this case—of other petitions presenting the same question. See *Apple Inc. v. Optis Cellular Tech., LLC*, 142 S. Ct. 859 (2022) (Mem.) (No. 21-118); *Mylan Labs. Ltd. v. Janssen Pharmaceutica, N.V.*, 142 S. Ct. 874 (2022) (Mem.) (No. 21-202). Respectfully, the Court should not follow that course again. This Court often grants petitions even when it has recently denied petitions addressing the same issue, and the pressing—and undisputed—importance of the question presented warrants doing so here. Given the role Congress intended IPR to play in rebalancing the patent system, the Federal Circuit’s decision threatens the patent system’s ability to promote innovation and economic growth, as well as

courts' ability to enforce the legal boundaries of PTO actions and rules. Fresh empirical studies confirm the harmful effects of the PTO's unlawful effort to constrict the availability of IPR. And the Federal Circuit continues to sanction that effort, to the patent system's detriment.

The government does not deny the importance of the question presented. It defends the decision below on the merits, but it offers no way to square that decision with this Court's precedent short of treating the Court's preservation of judicial review as a hollow promise. The government also argues that ongoing agency proceedings militate against review, but there is no such proceeding. The agency has not commenced a rulemaking or any other relevant proceeding, and it has given no indication that it is going to do so. The solicitation of comments that the government characterizes as a "pending agency process" to "reconsider[]" the *NHK-Fintiv* Rule (Opp. 8, 11) was nothing more than an open-ended request for views on whether the agency should conduct a rulemaking to address various institution-related standards. That stale request provides no basis to allow the question presented here to continue festering.

ARGUMENT

I. THE ISSUE'S IMPORTANCE IS UNDISPUTED AND GROWING

The government does not deny that Intel's petition raises a pressing question with broad implications for the proper functioning of the patent system and for courts' ability to ensure that the PTO does not exceed its authority or violate the APA. *See* Pet. 6, 29-34. The Federal Circuit's abdication of that responsibility

empowers the PTO to take unlawful actions that undermine or even nullify a key component of the patent-review system that Congress crafted.

As explained (Pet. 2-3, 6-8, 29-30), Congress created IPR because it recognized that district court litigation and preexisting administrative mechanisms were inadequate for “weed[ing] out bad patent claims” that threaten innovation. *Thryv, Inc. v. Click-To-Call Techs., LP*, 140 S. Ct. 1367, 1374 (2020). The *NHK-Fintiv* Rule has dramatically undercut the availability of IPR precisely when it is most needed and when Congress intended it to be available: when the challenged patent claims have been asserted against the IPR petitioner in pending patent-infringement litigation. *See* Pet. 29-34. Congress expressly provided that IPR and litigation can proceed in parallel in that situation, even when they involve overlapping issues, and it directed when and how that should occur and when the Director has discretion to avoid parallel proceedings. *See* Pet. 6-8, 29-30; 35 U.S.C. §§315(a)(1), (a)(2)(B), (a)(3), 315(b), (d), 325(d). Nowhere did Congress indicate that the PTO could deny institution of IPR based on its own judgment that IPR would be inefficient due to parallel litigation—a judgment that directly contradicts Congress’s judgment as expressed in the AIA.

The PTO has applied the Rule to deny hundreds of IPR petitions, and it continues to do so, even where the IPR petition meets all statutory prerequisites and raises meritorious challenges to patentability. *See* Pet. 5, 11, 32-33.¹ Further, the Rule has proved counterpro-

¹ *See also, e.g., Immersion Sys. LLC v. Midas Green Techs., LLC*, No. IPR2021-01176, 2022 WL 93850, at *10 (P.T.A.B. Jan. 6, 2022); *Samsung Elecs. Co. v. Evolved Wireless LLC*, No. IPR2021-00950, 2021 WL 6338401, at *8 (P.T.A.B. Nov. 29, 2021).

ductive in many ways, and those pernicious effects—and the studies documenting them—have continued to accumulate.

For example, the Rule has encouraged abusive forum-shopping by patent-infringement plaintiffs. Since the Rule was adopted, the number of infringement suits filed in the Western and Eastern Districts of Texas—two jurisdictions widely recognized as patent “rocket docket”—has increased dramatically, and correspondingly those suits have accounted for a whopping number of denials of IPR petitions under the Rule. Pet. 32. More recent studies confirm that those tandem developments were not a coincidence.

The situation in the Waco Division of the Western District of Texas, home to a single judge, presents the case-in-point. Pursuant to a standing order governing patent cases, that court issues trial schedules at the early stages of infringement suits that are “faster than even other fast-to-trial district courts.” Anderson & Gugliuzza, *Federal Judge Seeks Patent Cases*, 71 Duke L.J. 419, 455-459 (2021); see Albright, D.J., Order Governing Proceedings – Patent Case (W.D. Tex. standing order).² The court has stated that it does so with the specific aim of resolving patent cases “more quickly than the PTAB can.” Eakin, *West Texas Judge Says He Can Move Faster Than PTAB*, Law360 (Nov. 27, 2019).³ And the court has said it will rarely stay litigation in favor of IPR, and indeed it has done so in only

² <https://www.txwd.uscourts.gov/wp-content/uploads/Standing%20Orders/Waco/Albright/Order%20Governing%20Proceedings%20-%20Patent%20Cases%20022620.pdf>.

³ <https://www.law360.com/articles/1224105/west-texas-judge-says-he-can-move-faster-than-ptab>.

“one or two” cases. Davis, *Albright Says He’ll Very Rarely Put Cases On Hold For PTAB*, Law360 (May 11, 2021).⁴ These practices play perfectly into the hands of patent-infringement plaintiffs seeking to avoid IPR by relying on the *NHK-Fintiv* Rule, which calls for denial of institution where there is an early trial date and no litigation stay. See Anderson & Gugliuzza, 71 Duke L.J. at 466-467 (“Judge Albright’s aggressive default schedule helps ensure that, in most cases, the *Fintiv* factors will favor denying institution.”). As a result, infringement plaintiffs have flocked to Waco—about 25 percent of all patent suits are now filed there. See Unified Patents, *2021 Patent Dispute Report: Year in Review* (Jan. 3, 2022) (Fig. 3).⁵ And those tactics in turn have driven many of the denials under the *NHK-Fintiv* Rule. See Pet. 32.

This dynamic is insidious because infringement trials—including in the Waco Division—are routinely postponed, often after the Board has denied the IPR petition in reliance on the original schedule. Pet. 12-13, 31. Multiple recent studies confirm that the trial dates on which the Board has relied in applying the *NHK-Fintiv* Rule are “almost always wrong.” Dufresne et al., *How reliable are trial dates relied on by the PTAB in the Fintiv analysis?*, 1600 PTAB & Beyond (Oct. 29, 2021).⁶ Out of 48 cases between February 2019 and September 2020 in which the Board applied the *NHK-*

⁴ <https://www.law360.com/ip/articles/1381597/albright-says-he-ll-very-rarely-put-cases-on-hold-for-ptab>.

⁵ <https://www.unifiedpatents.com/insights/2022/1/3/2021-patent-dispute-report-year-in-review>.

⁶ <https://www.1600ptab.com/2021/10/how-reliable-are-trial-dates-relied-on-by-the-ptab-in-the-fintiv-analysis/>.

Fintiv Rule to deny an IPR petition, “[o]nly one of the trial dates used ... was accurate.” Weber, Note, *Balancing Purpose, Power, and Discretion Between Article III Courts and the Patent Office*, 86 Mo. L. Rev. 1019, 1038 (2021).

Given the *NHK-Fintiv* Rule’s emphasis on the trial schedule, infringement defendants have increasingly filed IPR petitions as quickly as possible after being served with an infringement complaint in a bid to avoid denial under the Rule. See Eakin, *As Attys Sharpen PTAB Strategies, Fintiv Denials Are Falling*, Law360 (Oct. 27, 2021).⁷ But Congress deliberately sought to avoid pressuring infringement defendants to hastily file half-baked IPR petitions by allowing a one-year filing window after the service of the infringement complaint. See 35 U.S.C. §315(b); 157 Cong. Rec. 13,152, 13,187 (2011) (Sen. Kyl) (explaining one-year deadline provided defendants “reasonable opportunity to identify and understand the patent claims that are relevant to the litigation” before having to file IPR petition); Pet. 30.

The *NHK-Fintiv* Rule’s distorting effects on the patent-review system are also seen in how infringement defendants have increasingly split their patentability challenges between litigation and IPR—asserting some patentability challenges as defenses to infringement and others as grounds for instituting IPR while stipulating in court that they will forgo overlapping challenges. One recent study found that over the past year, IPR petitioners have embraced that tactic—which the PTAB has expressly encouraged—with broader stipulated waivers being more effective at

⁷ <https://www.law360.com/articles/1434925/as-attys-sharpen-ptab-strategies-fintiv-denials-are-falling>.

averting denial under the Rule. Glass & Adickman, *How Fintiv Stipulations Affect IPR Institution, By The Numbers*, Law360 (Feb. 17, 2022)⁸; see *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, 2020 WL 7049373, at *7 (P.T.A.B. Dec. 1, 2020) (designated precedential Dec. 17, 2020) (encouraging splitting under *NHK-Fintiv* Rule). This sort of splitting undermines the effectiveness of IPR. See Pet. 6, 30. To promote efficient resolution of patentability challenges in IPR, Congress required IPR petitioners to show “a reasonable likelihood” of success on the merits, 35 U.S.C. §314(a), and it adopted an estoppel provision potentially precluding them from raising in litigation any invalidity arguments that they raised “or reasonably could have raised” during an IPR that reaches final written decision, *id.* §315(e)(2). At the same time, Congress nowhere indicated that IPR petitioners should have to withhold those patentability challenges as defenses to infringement in litigation. Yet the *NHK-Fintiv* Rule has continued to pressure infringement defendants into splitting their patentability challenges in a piecemeal manner that undercuts the very efficiency the Rule was supposedly intended to promote. See Pet. 9-10.

In a normal case, when an agency adopts a rule that exceeds the agency’s statutory authority, violates the APA, and produces this sort of harmful systemic consequences, and then applies that rule to take final action that injures a party in a specific case, the courts are available to provide relief to that party. Yet the Federal Circuit’s application of §314(d) has allowed the PTO to continue applying the *NHK-Fintiv* Rule to deny IPR petitions with no judicial scrutiny. And the

⁸ <https://www.law360.com/articles/1465967/how-fintiv-stipulations-affect-ipr-institution-by-the-numbers>.

court’s approach insulates not only institution decisions made pursuant to the *NHK-Fintiv* Rule, but any other institution decision based on a similarly lawless or irrational rule. The Director has adopted other rules governing institution—many without notice and comment.⁹ Under the court of appeals’ interpretation, the agency could adopt rules decreeing that IPR petitions must be resolved by a coin flip; that IPR petitions must be denied unless filed within 30 days after service of an infringement complaint; or that all IPR petitions should be denied automatically. The government does not deny that decisions refusing to institute IPR pursuant to any such rules would be unreviewable under the Federal Circuit’s approach—notwithstanding this Court’s declaration that judicial review would “remain[] available.” *SAS*, 138 S. Ct. at 1359.

This Court therefore should not follow the course it took in *Apple* and *Mylan*. The denial of certiorari in those cases is not controlling. See *Teague v. Lane*, 489 U.S. 288, 296 (1989). The Court often grants certiorari on an issue after having previously—even recently—denied review of the same issue. Compare *NCAA v. Alston*, 141 S. Ct. 2141 (2021) (decision on the merits), with *NCAA v. O’Bannon*, 137 S. Ct. 277 (2016) (Mem.) (denying certiorari); compare *The Dutra Grp. v. Batteredton*, 139 S. Ct. 2275 (2019) (decision on the merits), with *American Triumph LLC v. Tabingo*, 138 S. Ct. 648 (2018) (Mem.) (denying certiorari); compare *Hurst v. Florida*, 577 U.S. 92 (2016) (decision on the merits), with *Opp. 16 & n.3, Hurst*, No. 14-7505 (U.S. Jan. 12, 2015) (collecting prior certiorari denials). It should do

⁹ See PTO, *Precedential and informative decisions*, <https://www.uspto.gov/patents/ptab/precedential-informative-decisions>.

so here. As shown, the need for this Court’s intervention continues to grow. The PTO’s continued application of the *NHK-Fintiv* Rule will not only continue to thwart meritorious patentability challenges, but also increasingly to misshape the patent-review system that Congress intended to create.

II. THE GOVERNMENT’S DEFENSE OF THE DECISION BELOW LACKS MERIT

As explained (Pet. 17-25), the Federal Circuit has jurisdiction under 28 U.S.C. §1295(a)(4)(A) to review “decision[s] of ... [the] Board ... with respect to ... inter partes review,” and, under *Cuozzo* and *SAS*, §314(d) does not withdraw that jurisdiction because Intel plausibly claims that the denial of its IPR petitions exceeded the PTO’s statutory authority and violated the APA’s substantive and procedural requirements. Moreover, if the Federal Circuit lacked appellate jurisdiction, it should have granted mandamus relief to correct the Board’s decisions. Pet. 25-29. In response, the government simply repeats the Federal Circuit’s erroneous analysis.¹⁰

A. With respect to appellate jurisdiction, the government first contends that the AIA expressly authorizes appeal only from “final written decisions” of the Board rendered at the conclusion of IPR. *See* Opp. 9 (citing 35 U.S.C. §319). That is irrelevant. As explained (Pet. 23-24), §1295(a)(4)(A) independently confers appellate jurisdiction, and neither that statute’s grant of jurisdiction nor the exceptions to §314(d)’s bar

¹⁰ To the extent the government made additional arguments in opposition to the *Apple* and *Mylan* petitions, Apple refuted them, *see* Reply 2-9, *Apple Inc., supra*, No. 21-118 (U.S. Nov. 15, 2021), and the government does not repeat them.

recognized in *Cuozzo* and *SAS* are limited to appeals from final written decisions. Even the Federal Circuit agrees that §1295(a)(4)(A)’s jurisdictional grant extends to any final Board “decision” concerning IPR, even if not a “final written decision.” *Arthrex, Inc. v. Smith & Nephew, Inc.*, 880 F.3d 1345, 1348-1349 (Fed. Cir. 2018).

The government counters (Opp. 10) that §1295(a)(4)(A) “grants the Federal Circuit ‘exclusive jurisdiction’ over specified types of appeals, but it does not confer a right to appeal any particular category of decision.” That disregards the statute’s plain language. Section 1295(a)(4)(A) provides that the Federal Circuit “shall have” jurisdiction over Board decisions concerning IPR. It does not say, as the government contends, that the Federal Circuit “shall *not* have” jurisdiction “unless” some other statute separately authorizes appeal. The government cites no authority supporting its atextual interpretation. Even the Federal Circuit has acknowledged that “§1295 provides a right to appeal” and that “§319 does not cabin the appeal rights conferred by §1295.” *Arthrex*, 880 F.3d at 1348-1349.

Moreover, if any independent “right” to review were needed, the APA provides it, and under § 314(d), “judicial review remains available consistent with the [APA].” *SAS*, 138 S. Ct. at 1359; *see* 5 U.S.C. §702 (a “person suffering legal wrong because of agency action, or adversely affected or aggrieved by agency action ... is entitled to judicial review thereof”); 5 U.S.C. §704 (“final agency action for which there is no other adequate remedy in a court [is] subject to judicial review”); *Arthrex*, 880 F.3d at 1348 n.1.

Finally, the government asserts (at 10) that §1295(a)(4)(A) “does not ... override Section 314(d)’s

explicit bar.” That is not Intel’s contention. Rather, as the petition makes clear (at 18-22), Intel contends that §314(d) does not apply here because this appeal fits squarely within the exceptions to §314(d) recognized in *Cuozzo* and *SAS* and that §314(d) therefore does not withdraw the appellate jurisdiction granted by §1295(a)(4)(A).

B. As for mandamus, the government argues (at 10) it is unavailable because “the AIA contains ‘no mandate to institute review’” and Intel therefore cannot establish a “clear and undisputable right to relief,” except perhaps for a “colorable constitutional claim[.]” But, as explained (Pet. 28), Intel does not claim it was entitled to institution of IPR. Intel claims it was entitled to have its IPR petitions evaluated consistent with the legal boundaries that the AIA and the APA set. And it is well established that mandamus is available to correct even discretionary action that violates a statutory limit—including the “fail[ure] to giv[e] appropriate public notice and an opportunity for comment.” *Hollingsworth v. Perry*, 558 U.S. 183, 191-192 (2010) (per curiam) (quotation marks omitted); *see* Pet. 29. The government cites no authority suggesting otherwise.

III. NO AGENCY PROCEEDINGS COUNSEL AGAINST REVIEW

The government finally contends (at 8, 11) that certiorari is unwarranted because the PTO is conducting a “[p]ending ... proceeding[.]” to “reconsider[.]” the *NHK-Fintiv* Rule. It is not. To be clear, the agency has not proposed any rule or initiated any rulemaking on the subject. What the government characterizes as an ongoing reconsideration proceeding was merely an open-ended request by the PTO, issued in October 2020, for comments on whether it should initiate a rulemaking to

address various standards for instituting IPR, 85 Fed. Reg. 66,502, 66,503, 66,506 (Oct. 20, 2020)—including potentially to “promulgat[e] rules based on” the *NHK-Fintiv* Rule or “a modified” version of it, *id.* at 66,504. For more than a year since the comment period closed, the PTO has taken no action on the matter, and there is little reason to think it will. Unified Patents Amicus Br. 13-16.

Moreover, the question presented concerns not the content of the *NHK-Fintiv* Rule but rather whether judicial review is available when the Board denies an IPR petition based on the *NHK-Fintiv* Rule or any other PTO rule that is plausibly claimed to exceed the agency’s statutory authority and violate the APA. The irrationality of the *NHK-Fintiv* Rule and its significant negative effects only underscore the need for this Court to correct the Federal Circuit’s mistaken view that the Board has unfettered, unreviewable power to make institution decisions based on agency rules that contravene the AIA and violate the fundamental substantive and procedural requirements of the APA.

CONCLUSION

The petition should be granted.

Respectfully submitted.

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