

No. 22-203

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

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APPLE INC., BROADCOM LIMITED NKA  
BROADCOM INC., BROADCOM CORPORATION,  
AVAGO TECHNOLOGIES LIMITED  
NKA AVAGO TECHNOLOGIES  
INTERNATIONAL SALES PTE LIMITED,

*Petitioners,*

v.

CALIFORNIA INSTITUTE OF TECHNOLOGY,

*Respondent.*

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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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**BRIEF OF PATENT LAW PROFESSORS  
AS AMICI CURIAE  
IN SUPPORT OF PETITIONERS**

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## **INTEREST OF AMICI CURIAE**

Amici are law professors with an interest in patent law and patent administrative procedure.<sup>1</sup> They have an interest in the proper interpretation and application of patent law statutes. The statutory interpretation adopted by the Federal Circuit in the opinion below is inconsistent with the statutory text and the canon of consistent usage. Therefore, amici believe this Court should reverse the Federal Circuit and hold that statutory estoppel applies only to grounds that were raised or reasonably could have been raised during the inter partes review proceeding. A list of amici appears in Appendix A.



## **SUMMARY OF THE ARGUMENT**

This Court should reverse the Federal Circuit and hold that estoppel following inter partes review (IPR) extends only to grounds that a party “raised or reasonably could have raised during that inter partes review,” with “during that inter partes review” meaning the time period between institution and final decision, as

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<sup>1</sup> Pursuant to Supreme Court Rule 37, counsel for amici represent that this brief was authored solely by amici and their counsel. No part of this brief was authored by the parties or their counsel, and no person other than amici or their counsel made a monetary contribution to the preparation or submission of this brief. Affiliations are provided for identification purposes; this brief does not purport to present the institutional views, if any, of their employers. Counsel for petitioners and respondent received timely notice of amici’s intent to file and have consented to the filing of this brief.

indicated by the statutory text. Specifically, the statute delineates the process of deciding whether to “institute” review from the “proceeding” where the Board will “conduct” the “review.” The statute notes the date “on which the review shall commence” and says that the “length of review” is the “time between the institution . . . and . . . final written decision.”

A broad reading of the estoppel provision also raises questions of procedural fairness in light of the Board’s practices. By regulation, the Patent Office imposes strict page limits on petitions, such that petitioners cannot raise all potential grounds for invalidity. Then, in future proceedings, the petitioner might face a billion-dollar infringement verdict on a patent where legitimate grounds for invalidity are barred from consideration despite never being decided before. A broad reading also complicates future proceedings by requiring a determination of what prior art a petitioner should have known about at the time of its petition. This is an important issue; innovation markets cannot function efficiently with uncertainty on whether a party facing a patent infringement lawsuit is barred from defending against it on grounds of invalidity of the patent.



## ARGUMENT

### I. THE DURATION OF REVIEW IS THE TIME FROM INSTITUTION TO DECISION

The Leahy-Smith America Invents Act (AIA)<sup>2</sup> established a procedural framework for new forms of adversarial challenges to issued patents before the Patent Trial and Appeal Board (PTAB), including inter partes review (IPR).<sup>3</sup> In an IPR, the Board may review the validity of a patent based on lack of novelty or obviousness. 35 U.S.C. § 311. The type of prior art that may be raised in an IPR is limited to patents or printed publications. *Id.* Before an IPR can “commence,” 35 U.S.C. § 314(c), the Director considers a petition for review and any response and thereafter will “determine whether to institute an inter partes review.” 35 U.S.C. § 314(b). The Director delegated the IPR institution decision to the Board by regulation. 37 C.F.R. § 42.4(a) (2020).

“The statute separates the Director’s decision to ‘institute’ the review, § 314, on one hand, from the Board’s ‘conduct’ of the review ‘instituted’ by the Director, § 316(c). . . .” *St. Jude Med., Cardiology Div., Inc. v. Volcano Corp.*, 749 F.3d 1373, 1375 (Fed. Cir. 2014). Any person (other than the patent owner) may file a petition seeking institution of inter partes review of a

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<sup>2</sup> Pub. L. No. 112-29, 125 Stat. 284 (2011) (codified as amended in scattered sections of 35 U.S.C.).

<sup>3</sup> The goals of the AIA included “improving patent quality and providing a more efficient system for challenging” patents. See H.R. REP. NO. 112-98, pt. 1, at 39–40, 46–48, 54.



patent. 35 U.S.C. § 311(a). However, under current Patent Office procedure, a petition for review is subject to strict page limitations, including a 14,000-word limit, which may limit the total number of grounds for invalidity and depth of analysis that a petitioner can include in a petition for IPR. *See* 37 C.F.R. § 42.24 (2020). The Director may institute review if and only if she determines that the petitioner is reasonably likely to prevail on at least one challenged patent claim. 35 U.S.C. § 314(a).

If the Director determines that institution is appropriate, the Patent Office will issue a Notice of Institution, which “shall indicate the date on which the review shall commence.” 35 U.S.C. § 314(c). If the Director denies institution, no IPR proceeding will occur. After the IPR commences, the Board will “conduct” the IPR proceeding, following procedures set forth by statute, *e.g.*, 35 U.S.C. § 316, and procedures set by regulation, *e.g.*, 37 C.F.R. § 42.24 (2020). The proceeding concludes when the Board issues a final written decision. 35 U.S.C. § 317. In the statute, the term “Length of Review” is used to mean “the length of time between the institution of, and the issuance of a final written decision.” 35 U.S.C. § 317(d).

## **II. “DURING THAT INTER PARTES REVIEW” MEANS DURING THE PROCEEDING**

### **A. Estoppel Applies Narrowly to Insti- tuted Grounds in Light of Textual Meaning and Statutory Context**

The AIA provided that, after the Board issues a final written decision as to the validity of a patent claim in an IPR, the petitioner or the party bringing the challenge, or its privy, is estopped from asserting in any later USPTO proceeding, civil litigation, or section 337 investigation before the International Trade Commission (ITC) that the patent claim is invalid “on any ground that the petitioner raised or reasonably could have raised during that inter partes review.” 35 U.S.C. § 315(e)(2). The core interpretive question is whether “raised or reasonably could have been raised during that . . . review” refers to grounds that could have been raised in the petition, or only grounds that could have been raised once the proceeding was instituted. If the “review” begins only after institution, then grounds not raised in the petition or not subject to institution will not be subject to estoppel because they were not raised “during that . . . review.” However, if the “review” begins with the petition, then estoppel will apply to any grounds that the petitioner raised or could have raised in its petition for review.

The AIA’s statutory framework provides critical context to answer this interpretive question. “[T]he normal rule of statutory interpretation [is] that identical words used in different parts of the same statute are generally presumed to have the same meaning.”

*IBP, Inc. v. Alvarez*, 546 U.S. 21, 34 (2005). The statute delineates the duration of review as the time period between the institution of review and the Board’s final written decision. 35 U.S.C. §§ 316, 317(d). Specifically, the statute defines the “length of review” as “the length of time between the institution of, and the issuance of a final written decision.” 35 U.S.C. § 317(d). And it also states that the review shall “commence” on the date stated in the Notice of Institution. 35 U.S.C. § 314(c). Read according to its plain terms, the statutory term “review” therefore means the period between the institution of review and the final written decision. “[W]hen the statute’s language is plain, the sole function of the courts—at least where the disposition required by the text is not absurd—is to enforce it according to its terms.” *Lamie v. U.S. Tr.*, 540 U.S. 526, 534 (2004) (internal quotation omitted). Under this narrow reading of the estoppel provision, a petitioner would only be barred from raising grounds in a later litigation which were instituted in proceedings before the Patent Office. Christa J. Laser, *The Scope of IPR Estoppel: A Statutory, Historical, and Normative Analysis*, 70 FLA. L. REV. 1127 (2018).

### **B. If Congress Intended to Refer to the Petition, It Knew How to Do So**

If Congress had intended the estoppel provision to apply to grounds that “were raised or reasonably could have been raised in the *petition for review*,” it knew how to do so. Several other provisions in the statute refer to the “petition” and its contents: Section 311

describes a “petition to institute an inter partes review.” 35 U.S.C. § 311. In Section 314, the statute states that the Director shall consider “the information presented in the petition filed under section 311” when deciding whether to institute an inter partes review. 35 U.S.C. § 314(a). Elsewhere in the statute, Congress repeatedly used the word “petition” when referring to the petition for review. *E.g.*, 35 U.S.C. § 312. An argument that Congress intended a provision to be read differently than the plain meaning of the text is particularly unpersuasive where obvious alternative language like this is available to convey the alternate reading but was not used. *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018) (“[I]f Congress wanted to adopt the Director’s approach it knew exactly how to do so.”).

### **C. “Could Have Raised” Is Not Superfluous Because Petitioners Might Not Raise Instituted Grounds During the Proceeding**

Some might caution that a reading of “during that inter partes review” that is limited to the duration of the review proceeding renders the phrase “reasonably could have raised” superfluous. However, this argument ignores the strategic and procedural realities of practice before the PTAB. There are many instances where a petitioner could raise a ground during the proceeding, because it was one of the grounds on which the patent office instituted review, but nonetheless might choose not to do so. For example, a petitioner might simply choose, for strategic reasons or because of limitations on space or time, to focus on certain

grounds for unpatentability during the course of the review, such as if the institution decision provides insight on which grounds are most likely to succeed before the Board. *Laser*, 70 FLA. L. REV. at 1144. Indeed, in the pending case, the parties filed a joint motion to limit the scope of the review to only certain grounds. *Apple Inc. v. California Inst. of Tech.*, IPR2017-00219, Paper 72 (P.T.A.B. June 5, 2018). Because the petitioner chose not to litigate other instituted grounds during the proceeding, it would be estopped from raising those grounds again in a later proceeding, provided that the review resulted in a final written decision.

Moreover, if the estoppel provision is read broadly in order to accommodate a reading of the word “raised” to mean “raised in the petition,” then either the word “during” would have an even more unusual reading that includes “not during,” or the phrase “inter partes review” would carry a different meaning than used throughout the rest of the statute, i.e., the time period between institution and final written decision. “Raised,” within the context of this provision, could alternatively mean when the petitioner presents its arguments at the hearing before the PTAB. Because “during” and “inter partes review” can have no other broader meaning, but “raised” could ordinarily refer to issues presented to the PTAB for consideration during the review, any apparent conflict between these meanings should be resolved in favor of conserving the ordinary meaning of the term “during” and the statutory meaning of the term “inter partes review.”

### **III. A BROAD READING OF ESTOPPEL POSES RISKS**

#### **A. Procedural Fairness Concerns**

Petitioners cannot raise all potential grounds that they might have to render a patent claim invalid in a petition for inter partes review. PTAB procedural rules substantially limit the contents of a petition: under current rules, petitions for IPR are limited to 14,000 words. 37 C.F.R. § 42.24 (2020). Particularly if a patent has hundreds of pieces of prior art that anticipate the patent or render it obvious, petitioners are frequently unable to include and adequately explain all possible grounds for unpatentability in a petition of only 14,000 words. The Patent Office's procedures effectively limit the number of grounds a petitioner may include in a petition for review. This differs from court proceedings, where parties may include all possible grounds for invalidity in their pleadings, subject only to the limits of Rule 11. Fed. R. Civ. P. 11. Although petitioners could spread the grounds across multiple petitions, the PTO then might be more likely to issue a discretionary denial of all the petitions. *See Greg Reilly, Patent Office Power & Discretionary Denials* (August 11, 2022), available at <https://ssrn.com/abstract=4188185>.

#### **B. Effects on Other Statutory Provisions**

If the Court were to read the IPR estoppel provision broadly such that “raised or reasonably could have raised during that inter partes review” means “raised or reasonably could have raised in a petition

for inter partes review,” then the Court would have to do the same throughout the statute. The AIA also created other post-grant proceedings, including Post-Grant Review (PGR). A petition for PGR may challenge patentability on any ground that may serve as an invalidity defense under § 282, including obviousness, novelty, indefiniteness, and patentable subject matter, with no limitations on the type of prior art that may be raised. 35 U.S.C. § 321(b). The estoppel provision applicable to PGR is substantially identical to that applicable in IPR: the petitioner or the party bringing the challenge, or its privy, is estopped from asserting in any later USPTO proceeding, civil litigation, or section 337 investigation before the International Trade Commission (ITC) that the patent claim is invalid “on any ground that the petitioner raised or reasonably could have raised during that post-grant review.” 35 U.S.C. § 325(e). Applying broad estoppel to PGR would have even more severe effects on litigation because it would bar all defenses on invalidity grounds, not just those for lack of novelty and obviousness.

#### **IV. THE SCOPE OF IPR ESTOPPEL IS IMPORTANT AND NEEDS URGENT CLARIFICATION**

##### **A. Confusion on the Scope of IPR Estoppel**

Before the Federal Circuit’s opinion below, district courts were hotly divided on the topic of the scope of IPR estoppel. *Laser*, 70 FLA. L. REV. at 1162-64; *California Inst. of Tech. v. Broadcom Ltd.*, 25 F.4th 976, 990

(Fed. Cir. 2022) (collecting cases). Moreover, district courts that adopted a broad interpretation of estoppel then had to assess what prior art a petitioner could have raised in the petition, using varying tests like whether a “skilled searcher” could reasonably uncover the prior art from a “diligent search.” *Laser*, 70 FLA. L. REV. at 1163. The Federal Circuit is the only appellate court that decides patent issues, leaving no room for a circuit split. However, there is disagreement among prior Federal Circuit panels and judges as to the scope of IPR estoppel and disagreement on how to interpret this Court’s precedent in *SAS Institute. Compare California Inst.*, 25 F.4th at 991 *with Laser*, 70 FLA. L. REV. at 1159-61 (*citing, e.g., HP Inc. v. MPHJ Tech. Inv., LLC*, 817 F.3d 1339, 1347 (Fed. Cir. 2016)). Without resolution by this Court, confusion as to the scope of estoppel and how to apply it will continue.

**B. Clarification of Estoppel Is Important Because Billion-Dollar Infringement Verdicts Can Rise and Fall on Its Scope**

The more anticipated a claim is by extensive prior art, the more likely, under the Federal Circuit’s interpretation, that potentially successful grounds for challenging the patent will never be heard by any tribunal. With the Federal Circuit’s approach to estoppel, a billion-dollar patent infringement verdict can stand on a patent that might have been found invalid if



challenged, but the parties were prevented from raising it. This has dramatic effects on business interests.



### CONCLUSION

This Court should reverse the Federal Circuit and hold that IPR estoppel extends only to grounds that were raised or could have been raised during the IPR proceeding. Estoppel would therefore extend to instituted grounds, whether raised during the proceeding or not. Estoppel would not extend to uninstituted grounds, such as grounds which might have been challenged in the petition for review but were not.

Respectfully submitted,

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