

No. 22-203

IN THE
Supreme Court of the United States

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.

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

**BRIEF IN OPPOSITION TO
PETITION FOR A WRIT OF CERTIORARI**

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December 14, 2022

QUESTION PRESENTED

Is a party in a patent infringement action arising under 28 U.S.C. § 1338 estopped under 35 U.S.C. § 315(e)(2) from asserting a ground for invalidity of a patent claim that it knew of and reasonably could have raised in a prior petition for inter partes review that resulted in a final written decision by the Patent Trial and Appeal Board determining the validity and patentability of the claim?

CORPORATE DISCLOSURE STATEMENT

The California Institute of Technology has no parent corporation. No publicly held corporation holds 10% or more of the California Institute of Technology's stock.

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INTRODUCTION

Respondent The California Institute of Technology (“Caltech”) respectfully submits this brief in opposition to the petition for a writ of certiorari filed by Petitioners Apple Inc., Broadcom Inc., Broadcom Corp., and Avago Technologies International Sales Pte. Limited.

The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011), created a proceeding known as inter partes review that allows administrative challenges to the validity of claims in issued patents. Congress intended inter partes review to provide an efficient alternative to costly district court litigation over patent validity. To further that end, and to ensure that patent holders would not be subject to repeat validity challenges, the Act contains an estoppel provision that provides:

The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or the real party in interest or privy of the petitioner, may not assert ... in a civil action arising in whole or in part under section 1338 of title 28 ... that the 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) (emphasis added). The decision below correctly interpreted that plain language and unanimously applied it to find estoppel here based on undisputed facts. The Federal Circuit denied rehearing en banc without dissent. This Court should deny the petition for multiple reasons.

First, the decision below correctly interpreted and applied the statute’s plain text, which precludes parties from raising in district court invalidity grounds they knew of and thus “reasonably could have raised” in a prior inter partes review. Apple undisputedly knew of its later-asserted prior art references at the time it filed its inter partes review petitions challenging the three Caltech patents at issue here. And Apple had ample and reasonable opportunity to raise those references “during th[e] inter partes review[s]”: it filed a total of **eight** petitions spanning **112,000** words, and the Patent Trial and Appeal Board (“PTAB”) instituted review of **seven** of those petitions. Apple nonetheless withheld its later-asserted invalidity grounds from its copious filings before the PTAB, which issued final written decisions rejecting all the invalidity grounds that Apple did raise with respect to the claims at issue here.

On this undisputed record, the statutory text clearly precludes Petitioners’ attempt to raise the withheld grounds in later litigation. In sum, Apple “reasonably could have raised” its later-asserted “ground” for invalidity “during th[e] inter partes review,” 35 U.S.C. § 315(e)(2), but it declined to do so. Under the plain text of the statute, Apple “may not assert” that ground for invalidity in district court. *Id.*¹

¹ While Apple alone filed the inter partes review petitions, it identified Broadcom as a real party interest to those petitions, and it is undisputed that estoppel applies equally to all Petitioners. *See* Pet. App. 61a, 90a.

In the face of such a clear and proper application of the statutory language, Petitioners' only response is to propose an alternative reading of the statute that would limit estoppel to grounds *actually* raised in the inter partes review petitions. But that reading is unnatural and illogical, and would render the phrase "or reasonably could have raised" meaningless surplusage.

Moreover, the statute's legislative purpose and history overwhelmingly support the Federal Circuit's correct interpretation of the statutory text. Congress added the estoppel provision to the statute for the explicit purpose of curtailing abusive practices of serial litigation by which challengers attacked the same patent claims repeatedly both in court and in administrative proceedings. As the proponents of the estoppel provision explained, its absence was a weakness in prior legislation that threatened to undermine the efficiency of inter partes review proceedings and turn them into "tools for harassment" of patent holders. Petitioners' serial attacks on Caltech's patents here are a textbook example of the abusive conduct Congress was trying to prevent.

Second, this case does not present any issue of exceptional importance to the patent system. Contrary to Petitioners' exaggerated suggestions, the decision below has extremely narrow application. It affects the outcome of only the limited set of patent infringement cases where (i) the PTAB institutes inter partes review, (ii) the PTAB issues a final written decision, (iii) that decision rejects the petitioner's asserted invalidity grounds, (iv) the petitioner knowingly withheld other second-string

invalidity grounds from its petitions, (v) the petitioner asserts those second-string grounds in a later proceeding, (vi) those second-string grounds would have prevailed in the later proceeding, and (vii) invalidity based on the second-string grounds then would have survived appeal. But only about 160 petitions for inter partes review a year ever result in final written decisions confirming the validity of some or all of the challenged patent claims. Only a subset of those is later part of litigation with the petitioner. And only a further subset of those involves any second-string invalidity grounds that the petitioner knowingly withheld from inter partes review. Accordingly, the number of cases where Petitioners' arguments would have any real-world consequences is vanishingly small.

Third, even if this Court were otherwise inclined to consider the proper interpretation of the inter partes review estoppel statute, the record here makes this case a poor vehicle to do so. The case is in an interlocutory posture pending a retrial on damages. Moreover, Apple had ample opportunity to raise its later-asserted invalidity grounds in its eight petitions to the PTAB and the PTAB did not block any effort by Apple to do so. And the Federal Circuit has not yet had the opportunity to consider or address Petitioners' conjectural scenarios in which the PTAB supposedly might prevent a party in the future from raising all possible invalidity grounds by deeming petitions overlong or multiplicative.

For all these reasons, the Court should deny the petition.

STATEMENT

A. Factual Background

Caltech is one of the world's leading research universities, particularly in science and technology. Founded in 1891 and located in Pasadena, it boasts approximately 2,400 students and 300 faculty members. Caltech is where Albert Einstein taught when he came to the United States, the DNA sequencer was invented, the Richter scale was developed, and the quantum computer was conceived. Its research is funded, in part, from royalties generated by patent licensing.

Caltech owns U.S. Patents Nos. 7,116,710 (“the ’710 patent”), 7,421,032 (“the ’032 patent”), and 7,916,781 (“the ’781 patent”). The patents claim inventions that correct errors in data transmissions (*e.g.*, between wireless devices) resulting from noise or interference. They describe generating codewords and parity bits by repeating the information bits a variable number of times (*i.e.*, “irregularly”), scrambling the information bits, summing subsets of information bits, and accumulating the information bits to generate parity bits, which serve as a check on the transmitted information bits. The invention transmits the codewords to a receiving device. Because noise or interference may introduce errors into the codewords during transmission, the receiving device uses a decoder to correct the received codeword using the parity bits and outputs the information bits in their original form. By improving error correction, the patents allow for faster speeds, increased range, reduced computational load, reduced chip temperature, reduced power consumption, extended battery life,

reduced chip size, and improved reliability for Wi-Fi-enabled devices.

B. The Statutory Text, Purpose And History

The inclusion of inter partes review in 2011 as part of the Leahy-Smith America Invents Act was not Congress's first attempt at a means for administrative review of the validity of claims in issued patents. In 1980, as part of the Bayh-Dole Act, Congress created the ex parte patent reexamination process. *See* 35 U.S.C. § 302. Ex parte reexamination allowed members of the public to challenge the validity of patents based on prior art patents and printed publications. The goal of ex parte reexamination was to "permit efficient resolution of questions about the validity of issued patents without recourse to expensive and lengthy infringement litigation." H.R. Rep. No. 96-1307, pt. 1, at 3-4 (1980). The Bayh-Dole Act did not, however, include an estoppel provision to bar accused infringers from reasserting in later litigation the same invalidity grounds that they had included or could have included in an ex parte reexamination petition.

This absence of preclusion came to be viewed as a weakness in ex parte reexamination. *See generally* Gregory Dolin, *Dubious Patent Reform*, 56 B.C. L. Rev. 881, 904-09 (2015). Rather than increasing efficiency by administratively resolving the validity of patents without recourse to litigation, the process often forced patentees to defend the validity of their patents multiple times: first in an ex parte reexamination proceeding and then again in court.

In 1999, Congress enacted an alternative inter partes reexamination process (now obsolete and replaced by inter partes review). Optional Inter Partes Reexamination Procedure Act of 1999, Pub. L. No. 106-113, 113 Stat. 1501, 1501A-567 (codified at 35 U.S.C. §§ 311-18 (2006)) (repealed 2012). Under inter partes reexamination proceedings, a petitioner could seek review of the patentability of an issued patent based on prior art identified in the petition.

To address criticisms of the earlier ex parte reexamination process, Congress included in the inter partes reexamination process an estoppel provision that prevented a party from later asserting in litigation “the invalidity of any claim finally determined to be valid and patentable on any ground which the third-party requester *raised or could have raised* during the inter partes reexamination proceedings.” 35 U.S.C. § 315(c) (2006) (repealed 2012) (emphasis added).²

Congress passed the Leahy-Smith America Invents Act against this backdrop. Like the inter partes reexamination provisions it replaced, the Act included an express “raised or could have raised” estoppel provision. Proponents described the estoppel provision as designed to ensure that the new inter partes review system was an alternative,

² Several unpassed patent-reform bills sought to limit the estoppel effect of an inter partes reexamination review to only those issues that were actually raised and decided. *See* S. 515, 111th Cong. § 5(f), (h) (2009); H.R. 1260, 111th Cong. § 6(f), (h) (2009); S. 1145, 110th Cong. § 5(b), (c) (2008); H.R. 1908, 110th Cong. § 6(d), (f) (2007).

not an adjunct, to invalidity litigation and to protect patent holders from abusive serial challenges to their patents.

The House Judiciary Committee Report, for example, explained:

The Committee recognizes the importance of quiet title to patent owners to ensure continued investment resources. While this amendment is intended to remove current disincentives to current administrative processes, the changes made by it are not to be used as tools for harassment or a means to prevent market entry through repeated litigation and administrative attacks on the validity of a patent. Doing so would frustrate the purpose of the section as providing quick and cost effective alternatives to litigation. Further, such activity would divert resources from the research and development of inventions.

H.R. Rep. No. 112-98, pt. 1, at 48 (2011).

Senators supporting the bill agreed. Senator Sessions stated, “The bill also includes many protections that were long sought by inventors and patent owners. It preserves estoppel against relitigating in court those issues that an inter partes challenger *reasonably could have raised* in his administrative challenge.” 157 Cong. Rec. S1326 (daily ed. Mar. 7, 2011) (emphasis added). Senator Kohl stated that, after enactment, “[p]atent protection will be stronger with the inclusion of ‘*could have raised*’ estoppel.” 157 Cong. Rec. S1367 (daily ed. Mar. 8, 2011) (emphasis added).

Senator Grassley, a cosponsor, similarly stated that the bill “include[s] a strengthened estoppel standard to prevent petitioners from raising in a subsequent challenge the same patent issues that were raised or *reasonably could have been raised* in a prior challenge. The bill would significantly reduce the ability to use post-grant procedures for abusive serial challenges to patents.” 157 Cong. Rec. S952 (daily ed. Feb. 28, 2011) (emphasis added).

C. The Proceedings Below

In May 2016, Caltech filed a patent infringement lawsuit against Petitioners alleging infringement of the '710, '032, and '781 patents.³ Pet. App. 2a, 6a-7a. In response, between November 2016 and January 2017, Apple filed eight petitions for inter partes review raising multiple different invalidity grounds against Caltech's asserted patent claims. Pet. App. 7a, 46a & n.5, 89a-90a. Apple's petitions against claims in the '710 patent totaled 236 pages and asserted various permutations of six prior-art references. Apple's petitions against claims in the '032 patent spanned 233 pages and asserted combinations of five prior-art references. And Apple's petitions challenging claims in the '781 patent covered 133 pages and raised combinations of four prior-art references. It is undisputed that, at the time Apple filed its petitions, Apple was aware of the other prior art references it excluded from its petitions but later sought to raise as invalidity grounds in district court. Pet. App. 20a, 25a, 61a.

³ Caltech withdrew its assertion of infringement of a fourth patent. Pet. App. 46a n.4.

The PTAB instituted inter partes review between June and August 2017 in response to seven of Apple's eight petitions. Pet. App. 46a, 89a. The parties conducted discovery, submitted expert declarations, filed briefs and motions, and participated in oral hearings before the PTAB. The PTAB issued final written decisions in December 2018, finding with respect to every Caltech patent claim at issue that Apple had failed to prove unpatentability. Pet. App. 46a, 89a.⁴

Caltech accordingly moved for partial summary judgment that Petitioners were estopped under 35 U.S.C. § 315(e)(2) from asserting the new invalidity defenses that Apple knew of and thus could have raised in the inter partes reviews. The district court agreed and granted partial summary judgment to Caltech on Petitioners' invalidity defenses based on statutory estoppel. Pet. App. 41a-79a, 81a-100a.

The case proceeded to trial, where the jury found that Petitioners infringed Caltech's patents and awarded damages in an amount exceeding \$1 billion. Pet. App. 8a-12a.

D. The Federal Circuit Decision

On appeal to the Federal Circuit, Petitioners raised eleven supposed errors, devoting only four pages of their sixty-eight-page appeal brief to the district court's supposed error in granting summary

⁴ The Federal Circuit affirmed the PTAB's final written decisions in separate appeals. *Apple Inc. v. Cal. Inst. of Tech.*, 796 F. App'x 743 (Fed. Cir. 2020); *Apple Inc. v. Cal. Inst. of Tech.*, 784 F. App'x 759 (Fed. Cir. 2019).

judgment in favor of Caltech as to their invalidity defenses. Petitioners argued that the estoppel issue was controlled by *Shaw Industries Group, Inc. v. Automated Creel Systems, Inc.*, 817 F.3d 1293 (Fed. Cir. 2016). In *Shaw* (which issued before this Court's decision in *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348 (2018)), the PTAB partially instituted inter partes review on only a subset of the grounds raised in the inter partes review petition. Under those circumstances, the Federal Circuit held that the petitioner was not estopped from asserting in a subsequent proceeding an invalidity ground raised in its petition but on which the PTAB declined to institute review. 817 F.3d at 1300.

The Federal Circuit unanimously rejected Petitioners' *Shaw* argument. Declining to adopt Caltech's argument that *Shaw* was distinguishable because here Apple never raised the later-asserted invalidity grounds in its petition, the panel took the occasion to "overrule *Shaw* and clarify that estoppel applies not just to claims and grounds asserted in the petition and instituted for consideration by the Board, but to all grounds not stated in the petition but which reasonably could have been asserted against the claims included in the petition." Pet. App. 24a. While *Shaw* was "perhaps correct at the time," the court held that it could not survive *SAS Institute*, which made clear "that there is no partial institution authority conferred on the Board." Pet. App. 23a-24a. The Federal Circuit thus affirmed the district court's summary judgment of no invalidity based on statutory estoppel. Pet. App. 32a.

The Federal Circuit also rejected nearly all of Petitioners' other arguments, affirming the

infringement liability judgment in favor of Caltech on all but one claim and remanding for a new trial on damages. Pet. App. 32a.

Petitioners petitioned for rehearing or rehearing en banc. The Federal Circuit denied the petition without any dissent by any member of that court. Pet. App. 101a-102a.

REASONS FOR DENYING THE PETITION

I. THE DECISION BELOW CORRECTLY INTERPRETS AND APPLIES 35 U.S.C. § 315(e)(2)

The Federal Circuit correctly held below that estoppel under 35 U.S.C. § 315(e)(2) precludes Petitioners from asserting in district court that Caltech's patent claims are invalid in light of prior art that Apple knowingly excluded from its inter partes review petitions. Petitioners err in contending (Pet. 13-19) that such estoppel extends only to those grounds that a challenger *actually* included in its inter partes review petitions, even where it knowingly withholds that prior art for later use in district court litigation. Petitioners' narrow reading of the statute contradicts the plain statutory language as well as the statute's legislative history and purpose.

A. The Plain Text Of The Statute Supports The Decision Below

The decision below interprets 35 U.S.C. § 315(e)(2) consistent with its plain text and ordinary meaning. That statute states:

The petitioner in an inter partes review of a claim in a patent under this chapter that

results in a final written decision under section 318(a), or the real party in interest or privy of the petitioner, may not assert ... in a civil action arising in whole or in part under section 1338 of title 28 ... that the 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) (emphasis added). As the decision below correctly held, such “estoppel applies not just to claims and grounds asserted in the petition and instituted for consideration by the Board, but to all grounds not stated in the petition but which reasonably could have been asserted against the claims included in the petition.” Pet. App. 24a. That is the natural and straightforward reading of the statute’s plain text.

As the decision below likewise correctly held, that plain statutory text precludes Petitioners’ new invalidity grounds when applied to the facts of this case. The district court properly found after extensive briefing that Apple reasonably could have asserted its new invalidity grounds in its inter partes review petitions because it undisputedly knew of all those grounds at the time of filing its petitions.

In contrast to these natural and straightforward conclusions, Petitioners propose an unnatural and implausible reading of the statute that would limit estoppel to those grounds that a patent challenger *actually* included in its inter partes review petitions, even where it withholds other prior art for later use in district court litigation. That reading makes no sense.

First, Petitioners’ argument would effectively render superfluous the statutory phrase “reasonably could have raised.” If Congress had meant to adopt Petitioners’ interpretation, it could have left “reasonably could have raised” out of the statute. But under the canon against surplusage, a statute should be interpreted so that each portion retains independent meaning. *See Ysleta Del Sur Pueblo v. Texas*, 142 S. Ct. 1929, 1939 (2022) (“[W]e must normally seek to construe Congress’s work ‘so that effect is given to all provisions, so that no part will be inoperative or superfluous, void or insignificant.’” (quoting *Corley v. United States*, 556 U.S. 303, 314 (2009))).

Petitioners and some of their *amici* try (Pet. 21-23; Law Profs. Br. 7-8; *but see* Unified Patents Br. 4) to rebut the surplusage problem and salvage the phrase “reasonably could have raised” by hypothesizing that a party might include an invalidity ground in the petition but then change its mind and withdraw that ground at some point “during th[e] inter partes review” prior to the PTAB’s final written decision. But the statutory language fails to support such a far-fetched reading.

To begin with, such abandoned grounds are not grounds that the petitioner “reasonably could have raised during that inter partes review.” They are instead grounds the petitioner *actually* “raised during that inter partes review”—regardless of whether the petitioner voluntarily withdrew them before the PTAB’s final written decision. Such abandoned grounds might even have been heavily litigated up to the eve of final decision given the availability of extensive procedural protections like

post-institution discovery (35 U.S.C. § 316; 37 C.F.R. § 42.51), additional briefing (35 U.S.C. § 316(a)(8); 37 C.F.R. § 42.23), motion practice (37 C.F.R. § 42.20), and oral argument before the Board (35 U.S.C. § 316(a)(10)).

It is no answer to suggest that a hypothetical petitioner might withdraw an invalidity ground soon after institution and before such proceedings are complete. Under this Court's decision in *SAS Institute*, the PTAB must institute review "pursuant to a petition" as drafted and filed by the petitioner. 35 U.S.C. § 314(b); *see SAS Inst.*, 138 S. Ct. at 1355-56. Therefore, once the PTAB institutes review, the grounds contained in the petition are the grounds that have *actually* been "raised during that inter partes review," regardless of whether the petitioner abandons them prior to the PTAB's final written decision. They are not grounds that "could have been raised."

Further, if Congress had intended "could have raised" estoppel to apply only to invalidity grounds that were abandoned, as Petitioners implausibly suggest, it could have drafted the statute to provide that estoppel applies to "any ground that the petitioner raised or ~~reasonably could have raised~~ abandoned during that inter partes review." The fact that it did not suggests that it meant something much broader

The legislative history confirms that Congress did not intend to confine "reasonably could have raised" estoppel to grounds an inter partes review petitioner raised but abandoned. Proponents of the estoppel provision stated that it would prevent relitigation of issues an inter partes review petitioner raised or

reasonably could have raised “in his administrative *challenge*,” 157 Cong. Rec. S1326 (daily ed. Mar. 7, 2011) (Statement of Sen. Sessions) (emphasis added), or “in a prior *challenge*,” 157 Cong. Rec. S952 (daily ed. Feb. 28, 2011) (Statement of Sen. Grassley) (emphasis added). The term “challenge” subsumes all aspects of inter partes review from the petition through the subsequent proceedings. Thus, contrary to Petitioners’ suggestion, Congress intended the estoppel provision to preclude new invalidity grounds that a petitioner knows of but omits from a prior inter partes review petition, as Apple did here.⁵

Second, Petitioners’ implausible reading of the statute places unnatural weight (Pet. 15-17) on the phrase “during that inter partes review.” Just as the contours of a complaint determine what a plaintiff may argue “during” pre-trial and trial proceedings, so too the contours of a petition determine what a petitioner may argue “during” an inter partes review. Put another way, the petitioner itself determines what the PTAB considers “during that inter partes review” by how it drafts its petition. “If a party does not include an invalidity ground in its petition that it reasonably could have included, it necessarily has not raised a ground that it ‘reasonably could have

⁵ Nor do the inter partes review proceedings here provide an “example” of Petitioners’ far-fetched abandoned-grounds scenario, as Petitioners misleadingly suggest (Pet. 22). Apple did not abandon the invalidity grounds in question during inter partes review, and it litigated the validity of every patent claim Petitioners were found to infringe all the way to final written decisions by the PTAB. *See* Pet. App. 46a-48a, 83a-84a, 89a-90a.

raised during . . . IPR.” *Oil-Dri Corp. of Am. v. Nestlé Purina Petcare Co.*, No. 15-CV-1067, 2017 WL 3278915, at *8 (N.D. Ill. Aug. 2, 2017). As the district court thus correctly noted, “the issue goes back to the choices made by the petitioner itself,” for “prior art references that a petitioner reasonably could have raised, but chose not to raise, in an IPR petition are also prior art references that reasonably could have been raised during actual IPR had the PTAB been given the opportunity (based on the petitioner’s raising them) to consider those references.” Pet. App. 56a.

Accordingly, the decision below does not warrant certiorari because it correctly interpreted the statute’s plain text.

**B. The Statute’s Purpose And
Legislative History Support The
Decision Below**

The decision below is faithful not only to the text of 35 U.S.C. § 315(e)(2), but also to its purpose. The legislative history refutes Petitioners’ argument that the statute leaves petitioners free to strategically withhold prior art from their inter partes review petitions so that they can later relitigate validity of the same claims. The purpose and history of the statute thus provide further reason to deny the petition.

This Court “generally presume[s] that Congress legislates against the backdrop of the common law.” *Comcast Corp. v. Nat’l Ass’n of Afr. Am.-Owned Media*, 140 S. Ct. 1009, 1016 (2020), including the common law doctrine of claim preclusion, see *Simmons v. Himmelreich*, 578 U.S. 621, 630 n.5

(2016) (interpreting the judgment bar provision of the Federal Torts Claims Act “by analogy to the common-law doctrine of claim preclusion”). The estoppel rule that Congress enacted in Section 315(e)(2) is closely analogous to the familiar common law of claim preclusion. It is no objection to the application of common law claim preclusion in a second proceeding that the plaintiff did not plead the claim for relief in question in its complaint in the first proceeding, so long as it had a full and fair opportunity to do so. *See, e.g., Lucky Brand Dungarees, Inc. v. Marcel Fashions Grp., Inc.*, 140 S. Ct. 1589, 1594 (2020) (“[C]laim preclusion prevents parties from raising issues that could have been raised and decided in a prior action—even if they were not actually litigated.”). Petitioners’ argument would inject into inter partes review the kind of inefficiency and opportunity for serial litigation that long-settled claim preclusion principles were developed to avoid.

And Congress did intend for the statute to prevent exactly that type of inefficiency. As explained above (at pp. 6-9), Congress intended the estoppel provision of 35 U.S.C. § 315(e)(2) to prevent “abusive serial challenges to patents” that had persisted under prior administrative regimes. 157 Cong. Rec. S952 (daily ed. Feb. 28, 2011) (Statement of Sen. Grassley). Under *ex parte* reexamination procedures, which lacked an estoppel provision, litigants could employ a strategy of “using one set of prior art in the reexam, and saving a second set of prior art for use in litigation,” which one Senate Report characterized as a “way[] in which re-examination can be used to abuse patent owners.” S. Rep. No. 111-18, at 56 (2009). Congress thus

intended the estoppel provision to prevent patent validity challenges from becoming “tools for harassment . . . through repeated litigation and administrative attacks on the validity of a patent.” H.R. Rep. No. 112-98, pt. 1, at 48 (2011). As then-Director of the Patent Office David Kappos testified to Congress about the advantages of the estoppel provision:

I believe there are significant advantages for patentees who successfully go through the post-grant system . . . because of those estoppel provisions. Those estoppel provisions mean that your patent is largely unchallengeable by the same party.

America Invents Act: Hearing on H.R. 1249 Before the House Comm. on the Judiciary, 112th Cong. 52-53 (2011).

The legislative history thus refutes Petitioners’ argument that Apple could avoid estoppel by withholding prior art that it actually knew about. To the contrary, as Senator Kyl (one of the architects of the Act) explained, the estoppel provision precludes invalidity arguments based on prior art that was known to the petitioner or that “a skilled searcher conducting a diligent search reasonably could have been expected to discover.” 157 Cong. Rec. S1375 (daily ed. Mar. 8, 2011). Senator Kyl also emphasized that, “if an inter partes review is instituted while litigation is pending, that review will completely substitute for at least the patents-and-printed-publications portion of the civil litigation.” *Id.* at S1376. That complete substitution would be impossible if petitioners could knowingly

withhold invalidity grounds from their petition and assert them later in litigation.

The estoppel provision in the predecessor provisions for inter partes reexamination further supports the view that “could have raised” estoppel extends to all invalidity grounds a party knows about at the time of its administrative challenge. That provision made “availability” the touchstone of “could have raised” preclusion. While that provision did “not prevent the assertion of invalidity based on newly discovered prior art *unavailable* to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings,” 35 U.S.C. § 315(c) (2006) (repealed 2012) (emphasis added), the provision did apply to both the prior-art invalidity grounds raised in the petition and those that were *available* but not raised. It would make no sense to read 35 U.S.C. § 315(e)(2) as weaker than the predecessor provision it was intended to strengthen. *See SAS Inst.*, 138 S. Ct. at 1355 (noting that, when interpreting the America Invents Act, “[i]t’s telling, too, to compare this structure with what came before”).

C. The Decision Below Comports With This Court’s Precedent

Contrary to Petitioners’ suggestion (Pet. 20-23), the decision below also correctly construed this Court’s decision in *SAS Institute*, 138 S. Ct. 1348, and that decision provides no basis to grant review. Prior to that decision, the PTAB asserted discretion to institute partial inter partes review on only some invalidity grounds asserted in a petition. *Id.* at 1354. Such partial institution could leave unadjudicated some of the invalidity grounds raised in the petition.

In such circumstances, the Federal Circuit reasoned in *Shaw Industries*, 817 F.3d 1293, it would be unfair to estop the petitioner from asserting later in litigation the invalidity grounds that it included in its petition but on which the PTAB declined to institute inter partes review.

As the Federal Circuit correctly reasoned in the decision below, however, this Court's decision two years later in *SAS Institute* effectively eliminated the situation at issue in *Shaw*. *SAS Institute* held that, under the plain language of the inter partes review statute, the PTAB must institute or deny a petition for inter partes review in its entirety. *See* 138 S. Ct. at 1354, 1357. After *SAS Institute*, therefore, there can no longer be any partial institution, eliminating the possibility that an invalidity ground might be raised but not instituted in an otherwise instituted inter partes review petition. Thus, as the decision below correctly concluded, *Shaw* was no longer good law. After *SAS Institute*, the PTAB no longer has the authority to institute an inter partes review on only a subset of the grounds raised in the petition. Therefore, "any ground that could have been raised in a petition is a ground that could have been reasonably raised 'during inter partes review.'" Pet. App. 23a.

Petitioners fail to show that anything in *SAS Institute* contradicts the Federal Circuit's reasoning or supports Petitioners' argument. For example, Petitioners argue (Pet. 20) that "*SAS Institute* did not change the statutory text of Section 315(e) or its plain meaning." But nothing in the decision below is premised on the assumption that *SAS Institute* altered Section 315(e). Petitioners also argue (Pet.

21) that *SAS Institute* increases the likelihood that a petitioner will abandon some of its petitioned-for unpatentability grounds before a final written decision. But as explained above, nothing in the statute's text, purpose, or legislative history suggests that "reasonably could have raised" estoppel is limited to grounds that a petitioner raises but abandons prior to the PTAB's final written decision.

Moreover, the Federal Circuit's overruling of *Shaw* in light of *SAS Institute* was proper and provides no basis for this Court to grant certiorari. Contrary to the suggestion of Petitioners' *amicus* (see Unified Patents Br. 13-18), settled Federal Circuit procedure allows a panel of that court to overrule that court's own precedent where the precedent has been undermined by an intervening decision from this Court. See, e.g., *Troy v. Samson Mfg. Corp.*, 758 F.3d 1322, 1326 (Fed. Cir. 2014). That power is not limited to circumstances where this Court decided an identical issue. *Id.* This case provides no reason for this Court to depart from its customary reluctance to police the procedures by which the circuit courts conform their precedents to this Court's decisions. See *Joseph v. United States*, 574 U.S. 1038 (2014) (statement of Kagan, J., respecting the denial of certiorari) ("We do not often review the circuit courts' procedural rules."). Nor is there any intra-circuit division here warranting this Court's concern, as the Federal Circuit did not even call for a response to Petitioners' en banc petition, and no judge on that Court dissented from its denial. Ultimately, much of Petitioners' complaint is with the Federal Circuit's treatment of its own prior precedent. But that is an issue for the Federal Circuit, not this Court.

II. THE DECISION BELOW WILL HAVE NO SIGNIFICANT EFFECT ON THE PATENT SYSTEM

Contrary to Petitioners' exaggerated suggestions (Pet. 23-32), the Federal Circuit's decision will have little impact on the patent system, and this case presents no question of exceptional importance warranting certiorari.

First, Petitioners overstate the number of cases that the decision below implicates. Petitioners contend that 1,300 petitions for inter partes review are filed each year and argue (Pet. 24) that the decision below will result in "a large number of prior art challenges that never get considered on the merits *by anyone*" (emphasis in original). But the decision below will, in fact, prevent from being heard only a vanishingly small set of invalidity challenges.

Specifically, as Petitioners' own *amicus* notes (Unified Patents Br. 6-8), only 160 inter partes review petitions in 2021 resulted in final written decisions confirming that some or all claims are patentable. The remaining petitions do not estop any grounds for invalidity either because the PTAB issued no final written decision or invalidated all of the challenged patent claims. And many of the final written decisions confirming the patentability of one or more claims involve patents without parallel district court litigation. The Federal Circuit's ruling will affect district court infringement cases within that narrow group only where the petitioner had additional, prior-art-based invalidity arguments that it knew about but omitted from its petitions. And even within that narrow subset, the ruling will affect the outcome of a case only in the unlikely event that

the PTAB rejects all of the petitioner’s first-string invalidity arguments during the inter partes review, but the second-string invalidity arguments that the petitioner did not include in the petition would have, if not estopped, prevailed in the subsequent litigation.

On its face, that is an unlikely scenario. Petitioners identify (Pet. 25-26) only a single case, *Click-to-Call Technologies LP v. Ingenio, Inc.*, 45 F.4th 1363 (Fed. Cir. 2022), where it has allegedly occurred. As the Federal Circuit noted, that case concerned “a rather unusual set of facts,” *id.* at 1365, and an “unusual procedural posture,” *id.* at 1369, that is unlikely to reoccur frequently.⁶

Second, Petitioners and *amici* overstate the difficulty in applying the decision below. Petitioners argue (Pet. 28) that the decision “will . . . be difficult to administer in practice” because “[t]he PTO is not obligated to institute inter partes review even when there is a ‘reasonable likelihood’ that the petitioner

⁶ The petitioner sought inter partes review based on two invalidity grounds, but the PTAB instituted review on only one ground. 45 F.4th at 1365. This Court then issued its decision in *SAS Institute* overruling the PTAB’s practice of partial institution. *Id.* The petitioner elected not to seek remand in light of *SAS Institute* during pendency of the appeal of the PTAB’s final written decision because the petitioner believed the non-instituted ground would not prevail before the PTAB. *Id.* at 1369-70. *Click-to-Call*, is, therefore, confined to the limited set of cases where “[t]he Board instituted pre-*SAS* and did not institute on all grounds. And when given the opportunity to do so post-*SAS*, [the petitioner] did not seek remand for institution on the non-instituted grounds.” *See id.* at 1365-66.

may succeed on a claim.” But Petitioners’ argument ignores that estoppel is triggered only if the petition “results in a final written decision under section 318(a).” 35 U.S.C. § 315(e)(2). Where the PTO does not institute inter partes review, it issues no final written decision. 35 U.S.C. § 318(a) (“*If an inter partes review is instituted* and not dismissed under this chapter, the Patent Trial and Appeal Board shall issue a final written decision” (emphasis added)). Estoppel does not apply, therefore, when the PTAB declines to institute any review of the challenged patent claim.

Amici similarly err in arguing that the decision below will be too difficult for district courts to apply. Contrary to their suggestion (Law Profs. Br. 11), Congress clearly understood that district courts would have to determine what prior art a petitioner reasonably could have raised in the petition. *See* 157 Cong. Rec. S1375 (daily ed. Mar. 8, 2011) (Statement of Sen. Kyl) (explaining that the estoppel provision would preclude prior art that was known or that “a skilled searcher conducting a diligent search reasonably could have been expected to discover”). Indeed, Congress enacted a similar standard in the now-defunct inter partes reexamination statute. *See* 35 U.S.C. § 315(c) (2006) (repealed 2012) (the estoppel provision did “not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings”). District courts, in any event, are routinely tasked with applying countless “reasonableness” standards. The estoppel provision of § 315(e)(2) is no different.

Third, Petitioners err in arguing (Pet. 30; *see* Law Profs. Br. 9) that the decision below “presents patent challengers with an untenable choice” because the Patent Office may exercise its discretion to enforce word limits or deny a petition for inter partes review that contains too many poorly developed invalidity grounds. Nothing in the America Invents Act prevents the PTAB from applying word limits or other procedural rules. Instead, for estoppel to apply, the statute simply requires that the petitioner “reasonably could have raised” the invalidity grounds in question.

The PTAB’s word-count limitations do not prevent petitioners generally—nor Apple specifically in this case—from reasonably raising invalidity grounds. The PTAB allows 14,000 words per petition, far more than the 9,000 words this Court allows for a petition for a writ of certiorari. *Compare* 37 C.F.R. § 42.24(a)(1)(i), *with* Sup. Ct. R. 33(1)(g). If that is insufficient to fully explain the invalidity grounds in a concise, well-organized manner, a petitioner may file “a motion to waive the word counts.” 37 C.F.R. § 42.24(a)(2). Although Petitioners and *amici* characterize the word-limitation as “strict,” they do not cite a single PTAB decision denying a motion to exceed the word count. Even if a petitioner exceeds the word count without leave, the PTAB seldom denies a petition on that basis. *See St. Jude Med., LLC v. Snyders Heart Valve LLC*, No. IPR2018-00105, 2018 WL 1633823, at *2 (P.T.A.B. Apr. 3, 2018) (stating it was “not aware of any Board case dismissing a petition because it exceeded the word count limit”). Instead, the PTAB typically accepts the petition but grants the patentee additional words for its response. *See*

id. More important, if a petitioner believes a request to expand the word count is insufficient, it may file more than one petition and then “seek to consolidate multiple proceedings challenging the same patent.” *Intuitive Surgical, Inc. v. Ethicon LLC*, 25 F.4th 1035, 1041 (Fed. Cir. 2022) (citing 35 U.S.C. § 315(d)).

This case illustrates the breadth and generosity of these procedures. Apple challenged Caltech’s patents by filing *eight* petitions giving it a total of **112,000** available words. Contrary to Petitioners’ suggestion (Pet. 31), the practice of filing multiple petitions against the same patent is explicitly permitted. Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions, 77 Fed. Reg. 48,612, 48,635 (Aug. 14, 2012) (stating that, where the word-limit cannot be complied with, “the filing of multiple petitions directed to subsets of related claims should be considered”); *see also Apple Inc. v. Qualcomm Inc.*, No. IPR2018-01279, 2019 WL 445554, at *4 (P.T.A.B. Feb. 1, 2019) (declining to deny institution of Apple’s multiple petitions because “[t]here is nothing *per se* improper with filing multiple petitions at the same time to avoid issues associated with the word limit”). And the PTAB here did not deny any of Apple’s many petitions against the Caltech patent claims at issue on this basis.⁷

⁷ Petitioners cite the Patent Trial and Appeal Board Consolidated Trial Practice Guide 59 (Nov. 2019), <https://www.uspto.gov/TrialPracticeGuideConsolidated>, for the proposition that the PTAB discourages the filing of multiple

The hypothetical possibility that the PTAB's procedural rules could cause a petitioner to forgo an invalidity argument does not support Petitioners' atextual reading of the statute. Even if, for example, the PTAB instituted review on only one of multiple petitions and denied the rest because they were multiplicative, estoppel would not necessarily apply to the grounds in those denied petitions. The petitioner would be free to argue that, due to the PTAB's decision to institute only a single petition, the grounds in the denied petitions were not grounds it "reasonably could have raised during that inter partes review." *See, e.g., Biscotti Inc. v. Microsoft Corp.*, No. 2:13-CV-1015, 2017 WL 2526231, at *6 (E.D. Tex. May 11, 2017) ("[I]f the petitioner tries to raise a ground but is precluded from further pursuing that ground during subsequent IPR proceedings solely because of PTAB procedures, then the petitioner should not be barred from asserting the merits of that same ground in a later PTAB or district court proceeding."). Here, the PTAB did not deny any of Apple's many petitions on this basis.

Nor, contrary to Petitioners' arguments, does this hypothetical possibility pose an unfair dilemma to parties seeking to challenge a patent claim's validity. The fact that Congress created an option to pursue inter partes review as an alternative to litigating invalidity arguments in district court does not relieve litigants of the consequences of making the sort of

petitions (Pet. 31), but the Guide explicitly authorizes the filing of multiple petitions. It simply requires a party filing multiple petitions to rank them and explain how they differ. *Id.* at 59-60.

strategic decisions that parties make in every case. “A patent infringement defendant does not have to take the IPR option; it can get a full hearing of its validity challenge in district court. If the defendant pursues the IPR option, it cannot expect to hold a second-string invalidity case in reserve in case the IPR does not go [the] defendant’s way.” *Douglas Dynamics, LLC v. Meyer Prods. LLC*, No. 14-CV-886, 2017 WL 1382556, at *4 (W.D. Wis. Apr. 18, 2017); *see also Great W. Cas. Co. v. Intellectual Ventures II LLC*, No. IPR2016–01534, 2017 WL 11139840, at *6 (P.T.A.B. Feb. 15, 2017) (“[A] petitioner makes an affirmative choice to avail itself of *inter partes* review only on certain grounds. That choice, however, comes with consequences, most prominently, that grounds petitioner elects not to raise in its petition for *inter partes* review may be subject to the consequences of Section 315(e)(1).”).

Fourth, contrary to *amici*’s argument (Law Profs. Br. 10-11), there is no “[c]onfusion on the [s]cope of IPR [e]stoppel” or “disagreement among prior Federal Circuit panels and judges as to the scope of IPR estoppel.” Even before *SAS Institute*, the position Petitioners and *amici* advocate had been rejected by the PTAB and was a minority view in the district courts. *See Palomar Techs., Inc. v. MRSI Sys., LLC*, 373 F. Supp. 3d 322, 331 (D. Mass. 2019) (“Prior to *SAS*, a minority of district courts had held that only those grounds actually raised in the petition could count as grounds that ‘reasonably could have been raised.’”); *Great W. Cas. Co.*, 2017 WL 11139840, at *6. Support for Petitioners’ minority view largely evaporated after *SAS Institute*. *See Wi-LAN Inc. v. LG Elecs., Inc.*, 421 F. Supp. 3d 911, 924 (S.D. Cal. 2019) (“[E]very post-*SAS* district

court decision the Court has found addressing IPR estoppel and *Shaw* has rejected the contention that IPR estoppel does not apply to non-petitioned grounds.”). To the extent any support for Petitioners’ position remained, the Federal Circuit dispensed with it in this case. No judge on that court dissented from that portion of the decision or from the denial of Petitioners’ petition for rehearing en banc. The supposed confusion *amici* conjure thus does not exist.

III. THIS CASE PRESENTS A POOR VEHICLE FOR INTERPRETING 35 U.S.C. § 315(e)(2)

Even if this Court were inclined to interpret 35 U.S.C. § 315(e)(2), this is not an appropriate case for doing so. To begin with, the interlocutory posture of the case weighs against certiorari. The Federal Circuit remanded the case for a new trial on damages (Pet. App. 32a), which has not yet occurred. Following that trial and any subsequent appeal, Petitioners will be free to seek review of the question presented in a petition for en banc review or a petition for certiorari based on a final judgment. *See Major League Baseball Players Ass’n v. Garvey*, 532 U.S. 504, 508 n.1 (2001).

Moreover, Petitioners failed to develop the arguments they and their *amici* now make in the briefing below, and the Federal Circuit thus has not yet had the opportunity to apply “reasonably could have raised” estoppel to the hypothetical factual scenarios that the petition envisions. Petitioners did not contend below that any statute or procedural rule prevented Apple from raising the estopped invalidity grounds in its eight inter partes review petitions. And as Petitioners do not dispute, the

PTAB did not deny institution of any invalidity ground here on the basis that Apple filed too many inter partes review petitions or that the petitions exceeded the PTAB's word-count limitations. Petitioners' asserted concerns thus remain entirely conjectural.

Nor did the briefing below raise or give the Federal Circuit the opportunity to consider the dictionary definitions (Pet. 15-16) and new statutory provisions they and their *amici* now raise (Pet. 5-6, 14, 16-19; Law Profs. Br. 6-7, 10; Unified Patents Br. 20-21 (citing 35 U.S.C. §§ 311, 314, 316, 317, 318, and 321)). And Petitioners did not argue to the Federal Circuit any of *amicus's* suggestions (Unified Patents Br. 20-21) that the court should have considered the effect of the Director's discretion and the patent owners' ability to amend the claims on the interpretation of the phrase "reasonably could have raised."

Accordingly, if this Court were inclined to consider the scope of "reasonably could have raised" estoppel under 35 U.S.C. § 315(e)(2), it should do so only in a future case after the Federal Circuit has had the opportunity to consider the question presented in a case where Petitioners' new arguments are more fully presented and Petitioners' conjectural concerns have actually materialized—for example, where the PTAB (unlike here) actually denies an inter partes review petition as multiplicative or overlong.

In the meantime, this case presents a poor vehicle for review of the scope of the estoppel statute.

CONCLUSION

The petition should be denied.

Respectfully submitted,

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December 14, 2022