NO. 25-1230

IN THE
Supreme Court of the United States

GOOGLE LLC,

Petitioner,

v.

VIRTAMOVE, CORP., ET AL.,

Respondents.

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

BRIEF IN OPPOSITION

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July 13, 2026

QUESTIONS PRESENTED

Whether the PTO retains statutory authority to deny institution based on the "settled expectations" factor, where discretion is committed to the PTO and no statutory provision prohibits consideration of settled expectations.

Whether the "drastic and extraordinary" remedy of mandamus is appropriate where Google identifies no statutory text that has been violated and the Federal Circuit has held that an alternative vehicle—a notice-and-comment rulemaking challenge—remains available.

RULE 29.6 STATEMENT

VirtaMove, Corp. does not have a parent entity, is not publicly traded, and no publicly held company owns 10% or more of its stock/equity.

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INTRODUCTION

Google asks this Court to deploy the extraordinary writ of mandamus to overturn a decision that Congress committed to the Patent Office's discretion and expressly made "final and nonappealable." 35 U.S.C. § 314(d). The Federal Circuit correctly declined that invitation, and nothing in the Petition warrants this Court's intervention.

As an initial matter, Google identifies no statutory text that the Director's decision even arguably violates. The AIA imposes a number of mandatory duties on the Director, but not a single provision requires him to institute inter partes review, and none restricts the factors he may weigh in declining to do so. That is why this Court has recognized that "[t]he agency's decision to deny a petition is a matter committed to the Patent Office's discretion." *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 273 (2016). There is certainly no violation that presents the "clear and indisputable" right to relief required for a writ of mandamus. *Cheney v. U.S. Dist. Ct. for D.C.*, 542 U.S. 367, 381 (2004).

Furthermore, the Petition rests on a false factual premise: that the PTO has "conjur[ed] from whole cloth" a six-year "limitations period" that "foreclose[s]" review of older patents. *See* Petition at 2–3. The data concerning Google's own petitions for IPR refute that characterization. The rate at which the PTO exercises discretion for patents more than six years old differs from the overall rate at which the PTO exercises its discretion by less than four percentage points (80.4% compared to 76.6%), clearly showing that the PTO has not enacted a de facto statute of limitations on inter partes review.

Finally, this case is a uniquely poor vehicle for review. Because the denial below rested on a holistic assessment of multiple factors, the Court cannot determine whether "settled expectations" was dispositive here without guessing at what motivated the agency, such that any resulting decision would amount to an advisory opinion. Meanwhile, the better vehicle the Federal Circuit has identified—an APA notice-and-comment rulemaking challenge before a district court, where a factfinder could develop the record Google's rule-based theory requires—remains open to Google.

In short, there has been no statutory violation, much less one that would present a clear and indisputable right to the mandamus relief sought by Google. And if Google *were* correct that the PTO's consideration of a patent's age is a de facto limitations period, the appropriate vehicle for review would be a district court APA action, not Google's flawed request for mandamus.

STATEMENT OF THE CASE

In 2011, Congress enacted the Leahy-Smith America Invents Act ("AIA"), Pub. L. No. 112-29, 125 Stat. 284 (2011), which made various changes to the Patent Act. 35 U.S.C. § 1 *et seq*. Among those changes was the creation of a new proceeding before the U.S. Patent and Trademark Office ("PTO") called an inter partes review ("IPR"). This new IPR process allowed private parties the opportunity to request that the PTO reconsider, on specific grounds, the validity of a patent that had previously been fully issued by the Office. *See* 35 U.S.C. § 311. Nothing in the Act changed or withdrew the ability of anyone sued for infringement of a patent to challenge its validity in a district court action. The AIA set forth various rules and procedures for IPR proceedings. Among those procedures, the Act required that a party seeking to pursue such a challenge file a petition identifying the validity challenge and that the Director of the PTO determine whether or not to institute an IPR proceeding to review the challenged patent. *Id.* §§ 312(a), 314(b). The statute committed this determination of whether to review the patent to the discretion of the Director and explicitly indicated that the decision to institute or not institute an IPR proceeding was not reviewable by any court. *Id.* § 314(a) (imposing no requirement to institute any inter partes review); *id.* § 314(d) ("The determination by the Director whether to institute an inter partes review under this section shall be final and nonappealable.").

In 2025, Google filed petitions for inter partes review challenging patents that VirtaMove had asserted against Google in parallel district court infringement litigation. In response, VirtaMove requested that the PTO exercise its discretion to deny several petitions for IPR filed by Google. *E.g.*, *Google LLC v. VirtaMove, Corp.*, Case No. IPR2025-00487, Paper No. 8 (May 12, 2025). Those requests identified numerous factors supporting exercise of the Director's discretion, including the fact that Google filed numerous parallel petitions (*id.* at 18–19), the substantive weakness of Google's IPR petition (*id.* at 15–17), the lack of relevant changed legal standards since issuance of the claims (*id.* at 15), Google's extensive over-reliance on expert testimony to establish the presence of claim elements in the prior art (*id.* at 3–5) and the presence of parallel district court litigation (*id.* at 5–14). VirtaMove also identified its settled expectations as relevant, given that the challenged claims had been in effect for nearly fifteen years. *Id.* at 17–18.

Google responded to VirtaMove's request for discretionary denial, disagreeing with VirtaMove's application of the relevant discretionary factors. *See Google LLC v. VirtaMove, Corp.*, Case No. IPR2025-00487, Paper No. 9 (June 10, 2025). As part of its response, Google reserved the right to challenge "the Director's March 26, 2025 memorandum"—which articulated the "settled expectations" factor—as "legally invalid as . . . adopted without notice-and-comment rulemaking." *Id.* at 31 n.12.

After considering VirtaMove's arguments requesting discretionary denial as well as Google's responsive arguments, the Acting Director's delegee exercised her discretion to deny institution. *Google LLC v. VirtaMove, Corp.*, Case No. IPR2025-00487, Paper No. 10 (July 11, 2025). The PTO stated that because the patent had "been in force for more than 14 years" there were "strong settled expectations," and further noted that Google did "not provide any persuasive reasoning why an *inter partes* review is an appropriate use of Board resources." *Id.* at 2. The order denying institution further noted that the "determination is based on the ***totality*** of the evidence and arguments the parties have presented," and not limited to the "certain arguments . . . highlighted above." *Id.*

On Google's request for a writ of mandamus, the Federal Circuit found mandamus was not an appropriate vehicle to challenge "the PTO's use of 'settled expectations' as a factor in denying institution of *inter partes* review." *In re Google LLC*, No. 2026-111, 2026 WL 204945, at *1 (Fed. Cir. Jan. 27, 2026) . The Federal Circuit's opinion noted that the court had previously decided the same issues in *In re Cambridge Indus. USA Inc.*, No. 2026-101, 2025 WL 3526129 (Fed. Cir. Dec. 9, 2025), and that Google had not presented reasoning that would support a different outcome. 2026 WL 204945, at *1. In the *In re Cambridge* opinion cited in denying Google's mandamus request, the Federal Circuit held that the "factors the Director may consider when deciding whether to institute IPR" "focus directly and expressly on institution standards," and are thus not reviewable under this Court's precedent. *In re Cambridge*, 2025 WL 3526129, at *3.

In re Cambridge further noted that a challenge to the PTO's use of the "settled expectations" factor as creating a de facto rule would more appropriately be brought "in an APA action in federal district court" than a mandamus petition. *Id.* at *2. Despite alleging that the PTO's actions and guidance constitute "a rule that, like any limitations period, affects parties' substantive rights" (Petition at 23), Google has not pursued an APA action in district court challenging the PTO's actions as inconsistent with notice-and-comment rulemaking.

REASONS FOR DENYING THE PETITION

Google's Petition should be denied for numerous reasons. First, Google cannot satisfy any of the requirements for the extraordinary relief of mandamus: Google has adequate alternative means of relief (including invalidity challenges in the parallel district court proceedings and a district court APA notice-and-comment rulemaking action that Google has not yet pursued) and it has no clear and indisputable right to relief. Second, Google identifies no statutory provision that the Director's decision violates; the AIA commits denial of institution to the Director's discretion and supplies no law by which to review discretionary denial. Third, the central premise of Google's Petition—that the PTO has enacted a de facto six-year limitations period—is false, as the data concerning Google's own petitions for IPR demonstrate. Fourth, this case is a poor vehicle for review because the PTO's denial of institution rested on a holistic assessment of multiple factors, and the better vehicle that Google has declined to pursue remains open to Google.

A. Google Is Not Entitled to Mandamus Relief.

A writ of mandamus is "one of the most potent weapons in the judicial arsenal," and each of "three conditions must be satisfied before it may issue." *Cheney v. U.S. Dist. Ct. for D.C.*, 542 U.S. 367, 380–81 (2004) (cleaned up).

First, in order to ensure that mandamus "will not be used as a substitute for the regular appeals process," the party seeking mandamus must "have no other adequate means to attain the relief he desires." *Id.* at 380–81. Second, the party seeking relief bears the burden of showing a "clear and indisputable" right to relief. *Id.* at 381. Finally, "even if the first two prerequisites have been met," the issuing court must find the writ to be "appropriate under the circumstances." *Id.*

All three requirements are lacking here. First, Google—at least under its own characterization of the record wherein the PTO's consideration of settled expectations acts as a rule rather than a legitimate exercise of discretion (*see* Petition at 23)—has an alternative right to relief in the form of an APA notice-and-comment rulemaking action before a district court. *See In re Cambridge Indus. USA Inc.*, No. 2026-101, 2025 WL 3526129 (Fed. Cir. Dec. 9, 2025) ("Cambridge's contention that the PTO was required to promulgate relevant considerations for institution through notice-and-comment rulemaking procedures can be raised in an APA action in federal district court; thus, it has failed to demonstrate lack of available alternatives for relief.").

Google also has a second, and even more direct, alternative avenue of relief: it may simply litigate its invalidity contentions in the parallel district court infringement litigation. Denial of institution deprives Google of nothing but a supplementary administrative forum. Every invalidity defense that Google raised in its IPR petitions remains fully available to Google in the parallel district court litigation. *See* 35 U.S.C. § 282(b) ("The following shall be defenses in any action involving . . . the infringement of a patent: . . . Invalidity of the patent . . . ."). A party that retains a complete opportunity to litigate the very issue on which it sought agency action cannot show that it has "no other adequate means to attain the relief" it seeks. *Cheney*, 542 U.S. at 380.

Second, Google cannot identify any statutory provision that has even potentially been violated, much less establish a "clear and indisputable" right to relief. *Cheney*, 542 U.S. at 381. As discussed in further detail in Section B, *infra*, Google's challenge at most presents policy considerations that it attempts to glean from the overall structure of the statutory scheme (such as Congress's decision not to impose a limitations period based on a patent's age), rather than identify any specific text of any statutory provision that the PTO's consideration of settled expectations violates. Nor does Google show (or even *attempt* to show) that there is any law set forth in the statute regarding how the Director must exercise his discretion, because there is none. The lack of law governing review of the Director's exercise of discretion is precisely why the Federal Circuit has stated that "it is difficult to imagine a mandamus petition that challenges a denial of institution and identifies a clear and indisputable right to relief." *See*

Mylan Labs. Ltd. v. Janssen Pharmaceutica, N.V., 989 F.3d 1375, 1382 (Fed. Cir. 2021).

Indeed, Google itself concedes that the APA precludes review of an agency's exercise of discretion when "the relevant statute is drawn so that a court would have no meaningful standard against which to judge the agency's exercise of discretion." *Weyerhaeuser Co.* v. *U.S. Fish & Wildlife Serv.*, 586 U.S. 9, 23 (2018) (cited by Petition at 21). This is precisely the case here, because no aspect of the AIA sets forth any guidelines for ***how*** the Director must exercise discretion.

For the same reason, the Director's refusal to institute review is agency inaction of the kind this Court has long treated as presumptively unreviewable. *See Heckler v. Chaney*, 470 U.S. 821, 831–32 (1985). An agency's decision not to act "often involves a complicated balancing of a number of factors which are peculiarly within its expertise," including "whether agency resources are best spent on this violation or another." *Id.* at 831. A decision declining institution is precisely such a refusal to act: the Director must weigh the strength of the petition, the demands on the Board's resources, the posture of any parallel litigation, and the parties' reliance interests. That is the same balancing of priorities that *Heckler* commits to agency judgment—and it is why this Court cited 5 U.S.C. § 701(a)(2) in recognizing that the denial of a petition "is a matter committed to the Patent Office's discretion." *Cuozzo*, 579 U.S. at 273.

Google's attempt to distinguish *Heckler* on the ground that Google alleges a statutory violation (Petition at 22 n.11) is circular; while Google superficially *alleges* a statutory violation, Google identifies no portion of the statute that sets forth any requirement that has purportedly been violated. Google's assertion that "there is, of course, 'law to apply'—the statute" (Petition at 21) rings hollow when Google identifies nothing *in* the statute that provides any such law. Because no provision of the AIA constrains the factors the Director may weigh in denying institution, there is no more law to apply here than there is to any other exercise of enforcement discretion.

Because the AIA provides no law to apply in reviewing the Director's exercise of discretion, this case is readily distinguishable from the cases cited by Google, all of which involved statutory provisions describing the bounds of the agency's discretion. *See Rodriguez v. Mayorkas*, No. 23-435-CV, 2024 WL 4023841, at *2 (2d Cir. Sept. 3, 2024) ("[R]ather than challenging a discretionary determination, Rodriguez questions *whether the agency adhered to* ***express directives*** given to it by Congress. This is squarely within our constitutional mandate for review of agency action, even if the agency's ultimate decision on the matter is otherwise committed to its discretion.") (emphasis added); *Ward v. Skinner*, 943 F.2d 157, 160 (1st Cir. 1991) (statute specified discretionary waiver could be applied only "if the Secretary determines that such waiver is not contrary to the public interest and is consistent with the safe operation of motor vehicles"); *Farmworker Just. Fund,* *Inc. v. Brock*, 811 F.2d 613, 619 (D.C. Cir. 1987) (discretion to set standards was limited "to serve the purposes of the Act") (cleaned up). This distinction is even clearer in view of the AIA's nonappealability provision, 35 U.S.C. § 314 (d). *See Mullin v. Doe*, 609 U.S. ____, slip op. at 13 (2026) (holding that a "judicial-review bar very clearly overcomes the general presumption in favor of judicial review" pertaining to an agency's determination).

Third, a writ of mandamus is not "appropriate under the circumstances" because it would circumvent the AIA's express insulation of institution decisions from appellate review. *See* 35 U.S.C. § 314(d) ("No Appeal.—The determination by the Director whether to institute an inter partes review under this section shall be *final and nonappealable*.") (emphasis added). The statutorily mandated nonappealability of institution decisions, coupled with the AIA's inclusion of no standards by which to judge the Director's exercise of discretion, shows that issuing a writ of mandamus would be inappropriate because it would require the Judiciary to second-guess a decision that Congress expressly left to the Executive.

Accordingly, Google is not entitled to its requested writ of mandamus.

B. Because Denial of Institution Is Committed to the PTO's Discretion With No Law to Apply in Reviewing Such Denial, There Is No Statutory Violation.

1. Denial of Institution Is Entirely Committed to the Director's Discretion.

The Director of the PTO is never commanded to institute any IPR. *Cuozzo Speed Techs., LLC* v. *Lee*, 579 U.S. 261, 273 (2016) ("[T]he agency's decision to deny a petition is a matter committed to the Patent Office's discretion.").

This understanding follows from the statutory scheme itself. For instance, the America Invents Act ("AIA") *does* require the Director to "determine whether to institute an inter partes review" according to a specified timeline. 35 U.S.C. § 314(b) ("The Director ***shall determine*** whether to institute an inter partes review… within 3 months after—(1) receiving a preliminary response to the petition . . . or (2) . . . the last date on which such response may be filed.") (emphasis added). The AIA further requires the Director to notify the parties of the Director's determination whether to institute. 35 U.S.C. § 314(c) ("The Director ***shall notify*** the petitioner and patent owner, in writing, of the Director's determination . . . .") (emphasis added). And *if* an IPR is instituted, the Board "shall issue" a final written decision regarding patentability. *See* 35 U.S.C. § 318(a).

In stark contrast to these mandatory requirements, the AIA places only *restrictions*, not *requirements*, on which IPRs are instituted. 35 U.S.C. § 314(a) ("The Director ***may not authorize*** an inter partes review to be instituted *unless* the Director determines . . . that there is a reasonable likelihood that the petitioner would prevail . . . .") (emphasis added).

The contrast between what the Director *must* do under the AIA, and what the Director is *prevented* from doing is clear from the text of the AIA. Despite numerous mandatory acts placed on the Director and the Board, there is not a single provision of the AIA that *requires* the Director to institute any IPR. Nor is there any provision of the AIA restricting what factors the Director may consider in the exercise of his discretion to deny institution.

The Director's discretion on denial of institution is further reinforced by the statute's express provision that institution decisions be shielded from appellate review. 35 U.S.C. § 314(d) ("The determination by the Director whether to institute an inter partes review under this section shall be final and nonappealable."); *Thryv, Inc. v. Click-To-Call Techs., LP*, 590 U.S. 45, 60 (2020) (explaining that "§ 314(d) makes" an attempt to "overturn the Board's" decision regarding institution "unreviewable").

Importantly, because this grant of discretion to deny institution flows from the text of the statute itself, the Director's discretion is distinct from the type of discretion agencies have previously asserted under

Chevron, which discretion purported to flow from statutory ambiguity. *See Loper Bright Enters. v. Raimondo*, 603 U.S. 369, 455 (2024) ("The *Chevron* deference rule is to the same effect: The Court generally assumes that Congress intends to confer *discretion on agencies to handle statutory ambiguities or gaps*, absent a direction to the contrary.") (Kagan, J., dissenting) (emphasis added). With regard to denial of institution, the statute does not have any ambiguity; rather, the grant of discretion to the Director directly follows from unambiguous statutory text which imposes only *limits*, not *mandates*, on institution of an IPR. Accordingly, this Court has recognized that the AIA itself, independent from any application of *Chevron* deference, grants the Director discretion. *Cuozzo*, 579 U.S. at 273 ("[T]he agency's decision to deny a petition is a matter committed to the Patent Office's discretion.").

Consistent with this Court's precedent, the AIA's direct grant of statutory discretion has been exercised to deny institution based on a wide range of factors that are not mentioned in the AIA, well beyond the "settled expectations" factor Google's Petition addresses. For instance, the PTO routinely exercises discretion to deny institution of IPRs involving serial or follow-on petitions for IPR. *E.g.*, *Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, Case No. IPR2016-01357, Paper No. 19 at 8–11 (Sept. 6, 2017) (precedential) (setting forth seven factors to be considered in evaluating discretionary denial in view of serial or follow-on petitions).

Likewise, the PTO routinely exercises discretion to deny institution where "proceeding in parallel with the district court litigation is an inefficient use of our time and resources." *E.g.*, *NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, Case No. IPR2018-00752, Paper No. 8 at 11 (P.T.A.B. Sept. 12, 2018) (precedential); *Apple Inc. v. Fintiv, Inc.*, Case No. IPR2020-00019, Paper No. 11, at 5–16 (P.T.A.B. Mar. 20, 2020) (precedential) (laying out six factors for consideration in evaluating discretionary denial involving parallel district court litigation). The PTO subsequently emphasized its consideration of whether a petitioner has entered into a "stipulation" which "mitigates any concerns of duplicative efforts between the district court and the Board" as weighing "strongly in favor of not exercising discretion to deny institution under 35 U.S.C. § 314(a)." *Sotera Wireless, Inc. v. Masimo Corp.*, Case No. IPR2020-01019, Paper No. 12 (P.T.A.B. Dec. 1, 2020) (precedential).

More recently, the PTO stated that it intends to consider additional factors in exercising discretion, including the "[s]ettled expectations of the parties" as well as "[w]hether there have been changes in the law . . . since issuance of the claims that may affect patentability," and "[w]hether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims." Acting Director Coke Morgan Stewart, *Memorandum Regarding Interim Processes for PTAB Workload Management* (Mar. 26, 2025) (reproduced at Pet. App. 8a–11a). And earlier this year, the PTO stated that it intends to consider whether "any products accused of infringement in a parallel proceeding" or "any products made, sold, or licensed by the patent owner that compete with the accused products" are "manufactured in the United States." John A. Squires, *Additional Discretionary Institution Considerations—U.S. Manufacturing and Small Business Use of AIA Proceedings* (Mar. 11, 2026).[1]

None of the discretionary factors discussed above are mentioned in the statutory text of the AIA. Instead, they represent the PTO's independent assessment of a variety of underlying policy considerations, including whether institution is an efficient use of PTO resources and whether the public interest will be served by institution, in furtherance of the exercise of discretion that Congress granted the agency.

2. The Director's Exercise of Congressionally Granted Discretion Cannot Constitute a Statutory Violation.

Google fails to identify any statutory provision of the AIA that has been violated by the Director's decision not to institute in the proceedings below. Google's failure to do so is a direct result of the statute providing only *limits*, not *requirements*, on when the Director may institute an IPR. *See* Section B.1, *supra*; 35 U.S.C. § 314(a) ("The Director may not authorize an inter partes review to be instituted unless . . . .").

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[1] *Available at* https://www.uspto.gov/sites/default/files/documents/Additional_Discretionary_Institution_Considerations_US_Manufacturing_and_Small_Business_Use_of_AIA_Proceedings.pdf.

Specifically, Google contends that the Director's exercise of discretion based on a patent owner's "settled expectations" "conflicts with Congress's decision not to impose any limitations period based on patent age." Petition at 14. But tellingly, Google does not identify any statutory provision *prohibiting* the consideration of a patent's age in the discretionary analysis.

The fact that Congress did not *mandate* that the Director limit review of patents that have been in force for a lengthy period of time does not mean that the Director cannot even *consider* this as a factor in the exercise of his discretion under § 314(a). Google's failure to identify *any* statutory provision limiting the Director's authority in this regard establishes that no statutory violation has occurred.

In effect, Google's argument is that because the AIA contains no provision *requiring* the Director to deny institution based on a patent's age, the Director is *prohibited* from doing so. *See* Petition at 17 (implying that Congress's omission of "an age-based limitations period from the AIA" means that the Director cannot even *consider* a patent's age in denying institution).[2] But this ignores the fact that

[2] An alternative reading of Google's argument is that the Director has imposed a de facto rule that operates like a statute of limitations period. *See* Petition at 17. But that is not correct, as explained in Section C, *infra*. And if it *were* correct, the appropriate avenue for obtaining relief would be a notice-and-comment rulemaking challenge before a district court under the APA, not the mandamus relief Google seeks here. *See* Section A, *supra;* Section D, *infra*.

denial of institution is committed to agency discretion by statute. *Cuozzo*, 579 U.S. at 273 (citing both 5 U.S.C. § 701(a)(2) and 35 U.S.C. § 314(a) for the proposition that "the agency's decision to deny a petition is a matter committed to the Patent Office's discretion").

Nor is Google aided by this Court's statements that judicial review may remain available where the agency "act[s] outside its statutory limits," *Cuozzo*, 579 U.S. at 275, or engages in "shenanigans," *SAS Institute, Inc. v. Iancu*, 584 U.S. 357, 371 (2018). *See* Petition at 25–28. Those reservations address institution of review in excess of statutory constraints, such as "canceling a patent claim for indefiniteness under § 112 in an inter partes review" despite 35 U.S.C. § 311(b) limiting the scope of IPR to invalidity under Sections 102 and 103. *See Cuozzo*, 579 U.S. at 275 (internal quotation marks omitted). A *denial* of institution cannot transgress the statute's limits, because no provision of the AIA ever requires institution; there is simply no statutory command to violate. Indeed, in *Thryv* this Court held that even an alleged violation of an express statutory *prohibition* on institution—the one-year time limit of 35 U.S.C. § 315(b)—was unreviewable. 590 U.S. at 53–54. That same conclusion applies with even more force here because the AIA never requires the Director to institute IPR and contains no provision prohibiting consideration of a patent's age in the Director's exercise of discretion.

It is *Google's* interpretation, not the Federal Circuit's or VirtaMove's, that would ignore the statutory text, because Google's view would invite courts to second-guess *every* exercise of discretion to determine whether or not such an exercise relied only upon factors explicitly *allowed* by the statute. (There is no dispute that no provision of the AIA *prohibits* any factors from being considered in the Director's exercise of discretion.) If Google's position were adopted, it would open the floodgates to judicial review of discretionary denial decisions (despite the AIA expressly prohibiting appeal of such decisions) and would further require judicial review despite the statute providing no law to govern such review.[3]

Furthermore, Google's contention that "[t]he AIA itself prevents patentholders from ever acquiring 'settled expectations' against administrative challenge" (Petition at 17) conflates two distinct concepts. It is certainly true that no provision of the AIA itself *grants* patentholders "settled expectations" based on a patent's age. But it is equally true that no provision of the AIA *prevents* patentholders from reasonably expecting that, if a patent has been issued for many years and no one has challenged the patent, the patentholder may have the validity of its patent decided before an Article III court rather than agency proceedings. Nor does any provision of the AIA prevent the Director from considering these reasonable expectations in the exercise of his discretion.

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[3] The AIA provides no law to apply in judicial review, presumably because such review is expressly prohibited by the statute itself.

Google's view would also have sweeping implications for every other express delegation of discretion to agencies beyond the PTO. The natural implication of Google's argument is that if a statute does not *grant* a party a legally enforceable interest, then the agency is *prohibited from considering* any practical (non-legally enforceable) interest that party might have. Google presents no authority supporting such a proposition, and this proposed exception to the rule that Congress may grant discretion to an agency would threaten to subsume that rule entirely, by preventing agencies from considering any factors other than those explicitly articulated by a statute.

Rather than identify any plausible statutory violation, Google's Petition presents only a *policy disagreement* with the Director of the type that is not suitable for review. For instance, whether or not consideration of a patent's age is consistent *as a policy matter* with 35 U.S.C. § 286's "approach[] to settled expectations" (Petition at 19) is purely a question of policy—whether the policies underlying Congress's decision to create a particular statutory provision are the same policies underlying the Director's independent decision to exercise his discretion under certain circumstances. There is certainly no dispute that Section 286 itself has no provision *prohibiting* a patent's age from being considered in the Director's exercise of discretion.

Similarly, whether "settled-expectations denials" are "intended to protect property rights" (Petition at 19) is a policy issue of how and when property rights are subject to agency review. Google's argument that "if a patent was wrongly granted . . . it confers no valid property rights *at all*" (Petition at 19–20) ignores the *procedural* question of how the validity of the property rights are determined. Specifically, it is the Director's policy view that by allowing patentholders to defend their patent rights before an Article III court—rather than before the PTO with a different standard of proof—patentholders' valid rights will be more reliably respected. Google's disagreement with that policy view does not amount to a plausible allegation that exercise of the Director's discretion violates the AIA itself.

C. The USPTO Has Not Enacted a Statute of Limitations as Google Suggests.

Google's Petition relies extensively on a significant misrepresentation regarding how the PTO has evaluated patent age in exercising its discretion.

As discussed above, exercise of discretion on a case-by-case basis is committed to the Director's discretion and is shielded from judicial review. This is presumably why Google chooses to repeatedly characterize the PTO's settled expectation denials as a "rule" or a "limitations period" that "foreclose[s] inter partes review based on patent age." Petition at 2–3; *see also, e.g.*, *id.* at 2 (alleging "the PTO has . . . conjur[ed] from whole cloth a limitations period" which corresponds to a "patent's six-year age"); *id.* at 3 (alleging an "overarching presumptive rule at issue here"); *id.* at 13 ("The PTO has no authority to create a limitations period where Congress did not . . . ."); *id.* at 15 (discussing the PTO's "patent-age rule"); *id.* at

23 (alleging the PTO's consideration of patent age "is much more akin to a *rule* than to an exercise of case-by-case discretion," and "it is a rule . . . like any limitations period"); *id.* (conceding the PTO has the power "to promulgate such rules," but "courts [do not] lack power to review those rules for compliance with statutory limits"); *id.* at 27 ("Google challenges the PTO's rule-like use of patent age as a justification for denying institution in cases involving six-year-old patents.").

Google's characterization of the PTO's practice is false, because a patent's age is far from dispositive in the PTO's exercise of discretion. This is apparent from an analysis of publicly available data concerning Google's own petitions for IPR.

Specifically, since "settled expectations" has been articulated as a factor relevant to the PTO's exercise of discretion, the PTO has decided 77 requests for discretionary denial involving IPR petitions filed by Google.[4] Of those 77 decided requests, 59 were granted, reflecting a 76.6% rate at which the PTO has exercised discretion. For patents that were more than six years old at the time of the decision (the duration that Google contends constitutes a "limitations period" which "foreclose[s] inter partes review based on patent age"—Petition at 2–3), there have been 46 decisions, with 37 granting discretionary denial, reflecting an

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[4] The statistics addressed in this analysis were derived from an analysis of opinions where the PTO has rendered an opinion on discretionary denial requests through July 10, 2026, as obtained from DocketNavigator. For ease of analysis, the data considered was limited to IPRs involving Google itself.

80.4% rate at which the PTO has exercised discretion for these older patents.

Thus, the rate at which the PTO exercises discretion for patents more than six years old (80.4%) differs from the overall rate at which the PTO exercises discretion (76.6%) by less than 4 percentage points with respect to Google. This difference is not entirely insignificant, but it is also not consistent with the PTO having created a "limitations period." *See* Petition at 13–14 (alleging that the "PTO's practice . . . conflicts with Congress's decision not to impose any limitations period"). Among other things, it shows that the Director has declined to discretionarily deny institution in at least nine IPRs involving patents older than six years—and that is counting Google's petitions alone. If the Director had a rigid "rule" against challenges to patents older than six years, that number would be zero. This fact alone shows the falsity of Google's argument.

Furthermore, even if Google's characterization *were* correct and a rule *had* effectively been issued, this case should be handled via an APA notice-and-comment rulemaking challenge before a district court, not mandamus relief, as the Federal Circuit has explicitly invited parties to pursue. *See In re Cambridge Indus. USA Inc.*, No. 2026-101, 2025 WL 3526129 (Fed. Cir. Dec. 9, 2025) ("Cambridge's contention that the PTO was required to promulgate relevant considerations for institution through notice-and-comment rulemaking procedures can be raised in an APA action in federal district court; thus, it has failed to demonstrate lack of available alternatives for relief."); *see also Apple Inc. v. Vidal*, 63 F.4th 1, 15 (Fed. Cir. 2023) (noting that litigants may pursue a "challenge to the Director's instructions as invalid for want of notice-and-comment rulemaking" before a district court).

Thus, a central premise of Google's challenge—that the PTO has established a rule that operates as a de facto limitations period on when an IPR may be brought—is false. And if that premise *were* correct, a district court APA action, rather than mandamus, would be the proper vehicle for relief, as further discussed in the following Section.

D. This Case Is a Poor Vehicle for Review.

1. Google's Mandamus Action Is a Uniquely Poor Vehicle.

As discussed above in Section A, none of the three requisite conditions for mandamus are satisfied. Google's requested mandamus relief is additionally flawed here, because the PTO's decision denying institution of Google's IPRs was explicit that despite VirtaMove's "strong settled expectations" being one factor, that was not the only factor. For instance, the PTO noted that Google did "not provide any persuasive reasoning why an *inter partes* review is an appropriate use of Board resources." *Google LLC v. VirtaMove, Corp.*, No. IPR2025-00487, 2025 WL 1913566, at *1 (P.T.A.B. July 11, 2025). And the PTO further stated that "the determination to exercise discretion to deny institution is based on a holistic assessment of *all* of the evidence and arguments presented." *Id.*

In essence, Google asks the Court to guess at what motivated the instant denial of institution and render an advisory opinion on that basis. Because of the uncertainty as to whether the PTO's consideration of settled expectations was dispositive as to non-institution in this specific case, Google's mandamus action is a poor vehicle for evaluating any broader pattern that exists within the PTO's consideration of settled expectations.

2. A Far Better Vehicle Exists, But Google Has Declined to Pursue It.

A better vehicle is available because Google has an alternative avenue of relief which the Federal Circuit has already blessed. Specifically, Google may bring an APA notice-and-comment rulemaking challenge before a district court, a course of action that the Federal Circuit has made clear is the appropriate vehicle for parties such as Google to challenge the PTO's "settled expectations" policy. *In re Cambridge Indus. USA Inc.*, No. 2026-101, 2025 WL 3526129 (Fed. Cir. Dec. 9, 2025) ("Cambridge's contention that the PTO was required to promulgate relevant considerations for institution through notice-and-comment rulemaking procedures can be raised in an APA action in federal district court; thus, it has failed to demonstrate lack of available alternatives for relief.").

Specifically, Google's challenge is based on the allegation that the agency has "adopt[ed] [an] overarching presumptive rule," which is "a rule that, like any limitations period, affects parties' substantive rights." Petition at 3, 23. Indeed, Google explicitly alleges that the Director's actions are "much more akin to a *rule* than to an exercise of case-by-case discretion." Petition at 23 (emphasis in original). And Google *expressly reserved* "the right to challenge" the Director's policy as "legally invalid as" being "adopted without notice-and-comment rulemaking." *Google LLC v. VirtaMove, Corp.*, Case No. IPR2025-00487, Paper No. 9, at 31 n.12 (June 10, 2025) (Google's opposition to VirtaMove's request for discretionary denial).

If Google is in fact correct that the Director is not merely exercising his discretion (which would be unreviewable by any court) but instead has enacted a de facto rule, the appropriate challenge would be an APA notice-and-comment rulemaking challenge "brought against the Director in district court under the Administrative Procedure Act (APA), 5 U.S.C. §§ 701–706." *See Apple Inc. v. Vidal*, 63 F.4th 1, 14 (Fed. Cir. 2023) ("Whether notice-and-comment rulemaking procedures had to be employed for an agency action presents a matter 'quite apart from the matter of substantive reviewability' of the action for being contrary to statute or arbitrary and capricious.") (quoting *Lincoln v. Vigil*, 508 U.S. 182, 195 (1993)).

Indeed, the Federal Circuit previously reached this same conclusion in *Apple v. Vidal*, where that court rejected a challenge to a non-institution decision but allowed a notice-and-comment rulemaking challenge to continue before the district court. *Id.* at 5–6, 17 ("[W]e conclude that Apple has standing to press the claim that the [alleged rule was] improperly put in place without notice-and-comment rulemaking."). Google was well aware of this result, as it was a party to the *Apple v. Vidal* action. *See id.* at 5.

An APA notice-and-comment rulemaking challenge would additionally be more appropriate than mandamus because it far better matches the facts as Google alleges them—that the Director has imposed a de facto statute of limitations that acts as a rule. And the notice-and-comment rulemaking challenge would allow a district court to properly act as a factfinder in addressing whether the evidence supports Google's contention that the Director *has* in fact instituted a rule. In contrast, the relevant record of the impact of a patent's age on discretionary denial decisions has not been developed by any finder of fact in the present action.

CONCLUSION

For all of the reasons set forth above, this Court should deny Google's Petition.

Respectfully submitted,

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July 13, 2026