

No. 25-1230

In the Supreme Court of the United States

GOOGLE, LLC, PETITIONER

v.

VIRTAMOVE, CORP., ET AL.

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

**BRIEF FOR THE FEDERAL RESPONDENT
IN OPPOSITION**

D. JOHN SAUER
*Solicitor General
Counsel of Record*
BRETT A. SHUMATE
Assistant Attorney General
MELISSA N. PATTERSON
SAMUEL B. GOLDSTEIN
Attorneys
*Department of Justice
Washington, D.C. 20530-0001
SupremeCtBriefs@usdoj.gov
(202) 514-2217*

QUESTION PRESENTED

The Leahy-Smith America Invents Act (AIA), Pub. L. No. 112-29, 125 Stat. 284, authorizes the Director of the U.S. Patent and Trademark Office to institute an inter partes review of an issued patent at the request of a third party, subject to certain conditions. 35 U.S.C. 311, 312, 314(a). But the statute imposes “no mandate to institute review” under any circumstances. *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 273 (2016). Rather, “Congress has committed the decision to institute inter partes review to the Director’s unreviewable discretion,” *United States v. Arthrex, Inc.*, 594 U.S. 1, 8-9 (2021), and has provided that “[t]he determination by the Director whether to institute an inter partes review * * * shall be final and nonappealable,” 35 U.S.C. 314(d). The question presented is as follows:

Whether the court of appeals abused its discretion in declining to grant a writ of mandamus based on petitioner’s contention that the Director, in determining not to institute inter partes review, had considered a factor that is inconsistent with the AIA.

TABLE OF CONTENTS

	Page
Opinions below	1
Jurisdiction.....	1
Statement	1
Argument.....	10
Conclusion	23

TABLE OF AUTHORITIES

Cases:

<i>Apple Inc. v. Allani</i> , No. IPR2025-856, 2025 WL 3908118 (Acting Director Sept. 5, 2025).....	8, 21
<i>Apple Inc. v. Fintiv, Inc.</i> , No. IPR2020-19, 2020 WL 2126495 (P.T.A.B. Mar. 20, 2020).....	5
<i>Apple Inc. v. Optis Cellular Tech., LLC</i> : No. 2021-1043, 2020 WL 7753630 (Fed. Cir. Dec. 21, 2020), cert. denied, 142 S. Ct. 859 (2022)	6
142 S. Ct. 859 (2022)	10
<i>Apple Inc. v. Squires</i> , 166 F.4th 1349 (Fed. Cir. 2026), petition for cert. pending, No. 26-73 (filed July 13, 2026).....	5, 6, 13, 14, 16
<i>Apple Inc. v. Vidal</i> , 63 F.4th 1 (Fed. Cir. 2023), cert. denied, 144 S. Ct. 548 (2024)	5, 6, 16
<i>Cambridge Indus. USA Inc., In re</i> , No. 2026-101, 2025 WL 3526129 (Fed. Cir. Dec. 9, 2025).....	9, 12, 14, 17
<i>Cheney v. United States Dist. Court</i> , 542 U.S. 367 (2004).....	11, 14, 15
<i>Commil USA, LLC v. Cisco Sys., Inc.</i> , 575 U.S. 632 (2015).....	2, 11
<i>Cuozzo Speed Techs., LLC v. Lee</i> , 579 U.S. 261 (2016).....	2-4, 13-15, 17, 18

IV

Cases—Continued:	Page
<i>Dabico Airport Solutions Inc. v. AXA Power ApS</i> , No. IPR2025-408, 2025 WL 1710857 (Acting Director June 18, 2025)	7, 21
<i>Fahey, Ex parte</i> , 332 U.S. 258 (1947)	11
<i>Farmworker Justice Fund, Inc. v. Brock</i> , 811 F.2d 613 (D.C. Cir.), vacated as moot, 817 F.2d 890 (1987)	22
<i>Fornaro v. James</i> , 416 F.3d 63 (D.C. Cir. 2005).....	12
<i>Heckler v. Chaney</i> , 470 U.S. 821 (1985).....	16
<i>Home Depot U.S.A., Inc. v. H2 Intellect LLC</i> , No. IPR2025-480, 2025 WL 3908177 (Acting Director Sept. 4, 2025)	7, 8, 21
<i>Intel Corp. v. Vidal</i> , 144 S. Ct. 548 (2024)	10
<i>Intel Corp. v. VLSI Tech. LLC</i> : No. 2021-1614, 2021 WL 5968443 (Fed. Cir. May 5, 2021), cert. denied, 142 S. Ct. 1363 (2022)	6
142 S. Ct. 1363 (2022)	10
<i>Kerr v. United States Dist. Court</i> , 426 U.S. 394 (1976).....	11
<i>MedImmune, Inc. v. Genentech, Inc.</i> , 549 U.S. 118 (2007).....	2
<i>Mullin v. Doe</i> , 146 S. Ct. 2121 (2026)	18
<i>Mylan Labs. Ltd. v. Janssen Pharmaceutica, N.V.</i> : 989 F.3d 1375 (Fed. Cir. 2021), cert. denied, 142 S. Ct. 874 (2022)	6, 10, 12, 13, 16, 19
142 S. Ct. 874 (2022)	10
<i>Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC</i> , 584 U.S. 325 (2018).....	2
<i>Patchak v. Zinke</i> , 583 U.S. 244 (2018).....	18
<i>Rodriguez v. Mayorkas</i> , No. 23-435, 2024 WL 4023841 (2d Cir. Sept. 3, 2024)	22

Cases—Continued:	Page
<i>SAS Inst. Inc. v. Iancu</i> , 584 U.S. 357 (2018)	3, 4, 17
<i>Sandisk Techs., Inc., In re</i> , No. 2025-152, 2025 WL 3526507 (Fed. Cir. Dec. 9, 2025)	9, 14
<i>Thryv, Inc. v. Click-to-Call Techs., LP</i> , 590 U.S. 45 (2020)	4, 10, 17, 18
<i>United States v. Arthrex, Inc.</i> , 594 U.S. 1 (2021)	3, 5, 15
<i>VirtaMove, Corp. v. Google LLC</i> , No. 25-cv-860, 2026 WL 1539255 (N.D. Cal. June 1, 2026)	8
<i>Ward v. Skinner</i> , 943 F.2d 157 (1st Cir. 1991), cert. denied, 503 U.S. 959 (1992)	22
<i>Webster v. Doe</i> , 486 U.S. 592 (1988)	13
Statutes and regulations:	
Administrative Procedure Act, 5 U.S.C. 701 <i>et seq.</i>	22
5 U.S.C. 701(a)(2)	4, 22
Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284	2
Patent Act of 1952, 35 U.S.C. 1 <i>et seq.</i>	1
35 U.S.C. 3(a)(2)(A)	2
35 U.S.C. 131	1
35 U.S.C. 141(c)	4, 12
35 U.S.C. 282(b)(2)	2
35 U.S.C. 302	2
35 U.S.C. 311(a)	3
35 U.S.C. 311(b)	3
35 U.S.C. 314(a)	3, 12, 15, 20
35 U.S.C. 314(d)	4, 10, 12, 13, 16-18, 23
35 U.S.C. 315(a)(1)	3, 12
35 U.S.C. 315(b)	3, 12
35 U.S.C. 315(e)(1)	4
35 U.S.C. 315(e)(2)	4

VI

Statutes and regulations—Continued:	Page
35 U.S.C. 316.....	4
35 U.S.C. 316(b).....	2, 7
35 U.S.C. 318(a).....	4
35 U.S.C. 319.....	4, 12
37 C.F.R. Pt. 42.....	4
Section 42.4(a).....	5
Miscellaneous:	
Patent Trial and Appeal Board, <i>Standard Operating Procedure 2 (Revision 11): Designation or De-Designation of Decisions as Precedential or Informative</i> (July 24, 2023), https://perma.cc/EF2C-PDHA	5
USPTO, <i>USPTO designates discretionary consider- ations decisions as precedential and informative</i> (Jan. 9, 2026); https://perma.cc/276F-JKVV	7

In the Supreme Court of the United States

No. 25-1230

GOOGLE LLC, PETITIONER

v.

VIRTAMOVE, CORP., ET AL.

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

**BRIEF FOR THE FEDERAL RESPONDENT
IN OPPOSITION**

OPINIONS BELOW

The order of the court of appeals (Pet. App. 1a-2a) is available at 2026 WL 204945. The decision of the United States Patent and Trademark Office (Pet. App. 3a-5a) is available at 2025 WL 1913566.

JURISDICTION

The judgment of the court of appeals was entered on January 27, 2026. The petition for a writ of certiorari was filed on April 27, 2026. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

STATEMENT

1. a. The Patent Act of 1952, 35 U.S.C. 1 *et seq.*, charges the U.S. Patent and Trademark Office (USPTO or PTO) with examining applications for patents, and it directs the agency to issue a patent if the statutory criteria are satisfied. 35 U.S.C. 131. As the agency head,

the Director of the USPTO is “responsible for providing policy direction and management supervision for the Office and for the issuance of patents.” 35 U.S.C. 3(a)(2)(A).

Once a patent is issued, third parties “who believe a patent is invalid have various proper ways to obtain a ruling to that effect.” *Commil USA, LLC v. Cisco Sys., Inc.*, 575 U.S. 632, 645 (2015). “They can file a declaratory judgment action asking a federal court to declare the patent invalid.” *Ibid.* (citing *MedImmune, Inc. v. Genentech, Inc.*, 549 U.S. 118, 137 (2007)). They also “may raise the affirmative defense of invalidity” in an infringement suit. *Ibid.* (citing 35 U.S.C. 282(b)(2)). “[T]hey can * * * seek *ex parte* reexamination of the patent by the Patent and Trademark Office.” *Ibid.* (citing 35 U.S.C. 302). Or, as particularly relevant here, “[t]hey can seek *inter partes* review at the Patent Trial and Appeal Board,” *ibid.*, a body within the USPTO “composed of administrative patent judges, who are patent lawyers and former patent examiners, among others,” *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 268 (2016).

Inter partes review is one of several “administrative processes that authorize the PTO to reconsider and cancel patent claims.” *Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC*, 584 U.S. 325, 330 (2018). Congress created that review mechanism as part of the Leahy-Smith America Invents Act (AIA), Pub. L. No. 112-29, 125 Stat. 284, which further authorized the Director of the USPTO to issue regulations governing the inter partes review process while “consider[ing] the effect of any such regulation on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings,” 35 U.S.C. 316(b).

Under the AIA, any person other than the patent owner may file a petition to institute inter partes review alleging that, at the time the patent was issued, the claimed invention was not novel or was obvious in light of “prior art consisting of patents or printed publications.” 35 U.S.C. 311(a) and (b). When a petition for inter partes review is filed, the Director of the USPTO first must determine whether to institute a review. 35 U.S.C. 314(a). The AIA imposes several prerequisites for instituting an inter partes review. The Director “may not” authorize a review to be instituted unless he finds “a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” *Ibid.* Inter partes review also “may not be instituted” if (1) “before the date on which the petition for such a review is filed, the petitioner or real party in interest filed a civil action challenging the validity of a claim of the patent”; or (2) “the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent.” 35 U.S.C. 315(a)(1) and (b).

Even if the petition satisfies those statutory requirements, the AIA imposes “no mandate to institute review.” *Cuozzo*, 579 U.S. at 273; see *SAS Inst. Inc. v. Iancu*, 584 U.S. 357, 366 (2018) (explaining that the AIA “doesn’t *require* [the Director] to institute an inter partes review even after he finds the ‘reasonable likelihood’ threshold met”). Instead, “Congress has committed the decision to institute inter partes review to the Director’s unreviewable discretion.” *United States v. Arthrex, Inc.*, 594 U.S. 1, 8-9 (2021); see *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.”)

(citing 5 U.S.C. 701(a)(2)). And under the AIA, the Director’s determination “whether to institute an inter partes review” is “final and nonappealable.” 35 U.S.C. 314(d). This Court has held that “Section 314(d)’s review bar is not confined to the agency’s application of § 314[]”; “[r]ather, it encompasses the entire determination ‘whether to institute an inter partes review’” and so “extends to challenges grounded in ‘statutes related to’ the institution decision,” even where challengers “label[]” their claims differently. *Thryv, Inc. v. Click-to-Call Techs., LP*, 590 U.S. 45, 56-57, 60 (2020) (first quoting 35 U.S.C. 314(d), then quoting *Cuozzo*, 579 U.S. at 275). The Court has “not decide[d] whether mandamus” review of an institution decision “would be available in an extraordinary case.” *Id.* at 54 n.4.

If the Director elects to institute an inter partes review, the Board conducts a trial-like proceeding to determine the patentability of the challenged claims. See 35 U.S.C. 316; 37 C.F.R. Pt. 42. At the end of the proceeding, unless the matter has been dismissed, the Board must “issue a final written decision with respect to the patentability of any patent claim challenged by the petitioner.” 35 U.S.C. 318(a). A party aggrieved by the Board’s final written decision may appeal that decision to the Federal Circuit. 35 U.S.C. 141(c), 319. The reviewing court may consider claims that, for example, the USPTO “exceed[ed] its statutory bounds” in its conduct of the proceeding after institution. *SAS Inst.*, 584 U.S. at 371. A final written decision in an instituted review estops the petitioner from subsequently challenging a patent in administrative proceedings or in district court on any ground that reasonably could have been raised during the inter partes review. 35 U.S.C. 315(e)(1) and (2). The Director also may designate a past decision

as “precedential” in future cases, *Arthrex*, 594 U.S. at 14 (citation omitted), or as “informative,” meaning that it identifies “norms that should be followed in most cases,” Patent Trial and Appeal Board, *Standard Operating Procedure 2 (Revision 11): Designation or De-Designation of Decisions as Precedential or Informative* 7 (July 24, 2023), <https://perma.cc/EF2C-PDHA>.

If the Director elects not to institute an inter partes review, then the “non-institution decision has no legal effect on the underlying patent rights and obligations.” *Apple Inc. v. Squires*, 166 F.4th 1349, 1361 (Fed. Cir. 2026), petition for cert. pending, No. 26-73 (filed July 13, 2026). The petitioner remains free to raise in litigation, or in other administrative proceedings, the grounds of invalidity that were asserted in its unsuccessful petition. *Ibid.*

b. Over the years since the AIA’s enactment, the USPTO has changed its approach to the assignment of responsibility for institution decisions. Originally, the Director delegated to the Board the responsibility to determine whether a petition for inter partes review should be granted and an inter partes review thus instituted. 37 C.F.R. 42.4(a); see *Apple Inc. v. Vidal*, 63 F.4th 1, 7 (Fed. Cir. 2023), cert. denied, 144 S. Ct. 548 (2024). Past Directors used several mechanisms to guide the Board regarding the proper exercise of its delegated authority to institute inter partes reviews. For example, they designated as precedential Board decisions identifying various discretionary factors for the Board to consider in determining whether to institute inter partes review in particular cases. See, e.g., *Apple Inc. v. Fintiv, Inc.*, No. IPR2020-19, 2020 WL 2126495, at *2 (P.T.A.B. Mar. 20, 2020) (identifying several “non-dispositive factors” regarding the significance of parallel

district-court litigation to the institution decision). The Federal Circuit repeatedly rejected attempts to challenge those factors, including by mandamus, and this Court denied petitions for certiorari in several of those cases. See, e.g., *Squires*, 166 F.4th at 1362-1363; *Vidal*, 63 F.4th at 11-14, cert. denied, 144 S. Ct. 548; *Intel Corp. v. VLSI Tech. LLC*, No. 2021-1614, 2021 WL 5968443, at *1 (Fed. Cir. May 5, 2021), cert. denied, 142 S. Ct. 1363 (2022); *Mylan Labs. Ltd. v. Janssen Pharmaceutica, N.V.*, 989 F.3d 1375 (Fed. Cir. 2021), cert. denied, 142 S. Ct. 874 (2022); *Apple Inc. v. Optis Cellular Tech., LLC*, No. 2021-1043, 2020 WL 7753630, at *1 (Fed. Cir. Dec. 21, 2020), cert. denied, 142 S. Ct. 859 (2022).

In 2025, the USPTO modified those institution procedures to “improve [Board] efficiency, maintain [Board] capacity to conduct AIA proceedings,” “reduce pendency” in other matters, and “promote consistent application of discretionary considerations in the institution of AIA proceedings.” Pet. App. 10a; see *id.* at 8a-14a. Under the current procedures the Director, in consultation with Board judges, “determine[s] whether discretionary denial of institution is appropriate.” *Id.* at 8a; see *id.* at 13a. In any institution-stage briefing, “consistent with the discretionary considerations enumerated in existing Board precedent (including *Fintiv*),” the parties are “permitted to address all relevant considerations, which may include”:

- “Whether the [Board] or another forum has already adjudicated the validity or patentability of the challenged patent claims”;
- “Whether there have been changes in the law or new judicial precedent issued since issuance of the claims that may affect patentability”;

- “The strength of the unpatentability challenge”;
- “The extent of the petition’s reliance on expert testimony”;
- “Settled expectations of the parties, such as the length of time the claims have been in force”;
- “Compelling economic, public health, or national security interests; and”
- “Any other considerations bearing on the Director’s discretion.”

Id. at 9a-10a; see *id.* at 14a. “The Director will also consider the ability of the [Board] to comply with pendency goals for [other proceedings], its statutory deadlines for AIA proceedings, and other workload needs.” *Id.* at 10a (citing 35 U.S.C. 316(b)).

The Director has recently designated as informative several agency decisions that have applied those discretionary factors. See USPTO, *USPTO designates discretionary considerations decisions as precedential and informative* (Jan. 9, 2026); <https://perma.cc/276F-JKVV>. With regard to the fifth bulleted factor above (settled expectations), those decisions explain that, “[a]lthough there is no bright-line rule on when expectations become settled, in general, the longer the patent has been in force, the more settled expectations should be,” weighing against institution of inter partes review. *Dabico Airport Solutions Inc. v. AXA Power ApS*, No. IPR2025-408, 2025 WL 1710857, at *1 (Acting Director June 18, 2025). But even when a patent “has been in force for over twelve years, creating strong settled expectations,” other considerations favoring institution may nonetheless “outweigh” the settled-expectations factor. *Home Depot U.S.A., Inc. v. H2 Intellect LLC*, No. IPR2025-480, 2025 WL 3908177, at *1 (Acting Director

Sept. 4, 2025); see *Apple Inc. v. Allani*, No. IPR2025-856, 2025 WL 3908118, at *1 (Acting Director Sept. 5, 2025) (similar). In any event, “the determination not to exercise discretion to deny institution is based on a holistic assessment of all of the evidence and arguments presented.” *E.g.*, *Home Depot*, 2025 WL 3908177, at *2.

2. a. Respondent VirtaMove, Corp. owns U.S. Patent No. 7,519,814, which was issued in 2009 and claims systems and methods for managing software applications on a computer server. See C.A. App. 67-70, 388. In 2024, respondent sued petitioner Google LLC in federal district court, alleging that petitioner had infringed the ’814 patent and other patents. See *id.* at 65. That litigation remains ongoing. See *VirtaMove, Corp. v. Google LLC*, No. 25-cv-860, 2026 WL 1539255, at *1 (N.D. Cal. June 1, 2026) (granting in part and denying in part petitioner’s motion to dismiss).

In 2025, petitioner filed two petitions for inter partes review of the ’814 patent. See Pet. App. 1a; C.A. App. 48-277. The USPTO declined to institute a review, Pet. App. 3a-5a, concluding that “discretionary denial of institution is appropriate in these proceedings,” *id.* at 4a.

The agency determined that “[s]ome factors counsel against discretionary denial” of institution, such as the fact that “there is currently no trial date set for the parallel district court proceeding involving Petitioner and the challenged patents.” Pet. App. 4a. The agency further explained that “[o]ther factors, however, weigh in favor of discretionary denial.” *Ibid.* For one, the challenged patent had “been in force for more than 14 years, creating strong settled expectations, and Petitioner d[id] not provide any persuasive reasoning why an *inter partes* review is an appropriate use of Board resources.” *Ibid.* In denying the petitions, the agency emphasized

that, although “certain arguments are highlighted” in its decision, “the determination to exercise discretion to deny institution is based on a holistic assessment of all of the evidence and arguments presented.” *Ibid.*

b. Petitioner filed a petition for a writ of mandamus in the Federal Circuit. See Pet. App. 1a. Petitioner contended that the agency’s consideration of the “‘settled expectations’” factor in determining not to institute an *inter partes* review “exceeds the USPTO’s statutory authority.” C.A. Mand. Pet. 20. Petitioner sought an order “vacating [the] discretionary-denial decisions” and directing the agency “to reconsider whether to institute [review] without regard to the challenged patent’s age.” *Id.* at 2, 4.

The Federal Circuit issued an unpublished order denying the mandamus petition. Pet. App. 1a-2a. The court explained that in previous unpublished orders, it had “considered and rejected similar challenges, by way of mandamus relief, to the PTO’s use of ‘settled expectations’ as a factor in denying institution of *inter partes* review.” *Id.* at 1a; see *In re Cambridge Indus. USA Inc.*, No. 2026-101, 2025 WL 3526129, at *2-*3 (Fed. Cir. Dec. 9, 2025) (per curiam) (concluding that the petitioner in that case had not met the “‘especially difficult’ mandamus standard,” including the requirement “to show a clear and indisputable right to the relief requested given the limits on [courts’] review of the PTO’s decision to deny institution”) (citation omitted); *In re Sandisk Techs., Inc.*, No. 2025-152, 2025 WL 3526507, at *1 (Fed. Cir. Dec. 9, 2025) (per curiam) (similar). The court determined that petitioner “has not shown a right to a different conclusion here.” Pet. App. 2a.

ARGUMENT

Petitioner contends (Pet. 14-29) that the court of appeals should have issued a writ of mandamus vacating the USPTO’s decision not to institute inter partes review and directing the agency to reconsider that decision without taking the patent’s age into account. The court correctly held that petitioner was not entitled to mandamus relief, and its unpublished, nonprecedential decision does not conflict with any decision of this Court or another court of appeals. This Court has denied previous petitions raising similar questions. See *Intel Corp. v. Vidal*, 144 S. Ct. 548 (2024) (No. 23-135); *Intel Corp. v. VLSI Tech. LLC*, 142 S. Ct. 1363 (2022) (No. 21-888); *Mylan Labs. Ltd. v. Janssen Pharmaceutica, N.V.*, 142 S. Ct. 874 (2022) (No. 21-202); *Apple Inc. v. Optis Cellular Tech., LLC*, 142 S. Ct. 859 (2022) (No. 21-118). The Court should follow the same course here.

1. a. The court of appeals acted correctly in denying mandamus relief.

This Court has not decided whether mandamus relief is ever available to review the USPTO’s determination whether to institute inter partes review. See *Thryv, Inc. v. Click-to-Call Techs., LP*, 590 U.S. 45, 54 n.4 (2020). The AIA states that “[t]he determination by the Director whether to institute an inter partes review * * * shall be final and nonappealable.” 35 U.S.C. 314(d). Because that provision declares the Director’s institution decision to be “nonappealable” rather than “nonreviewable,” that provision might plausibly be read not to foreclose mandamus review. See *Mylan Labs. Ltd. v. Janssen Pharmaceutica, N.V.*, 989 F.3d 1375, 1380 (Fed. Cir. 2021) (concluding that, while Section 314(d) “prevents any direct appeal,” that provision “is silent with respect to mandamus”), cert. denied, 142 S. Ct. 874.

Even assuming that Section 314(d) is best read to draw that distinction, however, mandamus is a “‘drastic and extraordinary’ remedy ‘reserved for really extraordinary causes.’” *Cheney v. United States Dist. Court*, 542 U.S. 367, 380 (2004) (quoting *Ex parte Fahey*, 332 U.S. 258, 259-260 (1947)). “[T]hree conditions must be satisfied before it may issue.” *Ibid.* “First, ‘the party seeking issuance of the writ must have no other adequate means to attain the relief he desires.’” *Ibid.* (quoting *Kerr v. United States Dist. Court*, 426 U.S. 394, 403 (1976)) (brackets omitted). “Second, the petitioner must satisfy the burden of showing that his right to issuance of the writ is clear and indisputable.” *Ibid.* (brackets and internal quotation marks omitted). “Third, even if the first two prerequisites have been met, the issuing court, in the exercise of its discretion, must be satisfied that the writ is appropriate under the circumstances” by identifying “exceptional circumstances amounting to” a “clear abuse of discretion.” *Id.* at 380-381 (citations and internal quotation marks omitted). When a lower court denies a petition for mandamus, the question for this Court is whether that lower court “abused its discretion by failing to issue the writ.” *Id.* at 391.

On the facts of this case, petitioner does not satisfy any of the three prerequisites to mandamus relief. *First*, petitioner has multiple “other adequate means to attain the relief [it] desires.” *Cheney*, 542 U.S. at 380 (citation omitted). Like other parties “who believe a patent is invalid,” petitioner has “various proper ways to obtain a ruling to that effect,” either in federal district court or in other administrative proceedings. *Commil USA, LLC v. Cisco Sys., Inc.*, 575 U.S. 632, 645 (2015); see p. 2, *supra* (discussing avenues for district-court litigation or ex parte reexamination). Indeed, petitioner is

currently engaged in district-court litigation concerning alleged infringement of the same patent, in which petitioner remains “free to litigate the [challenged] patent claims’ validity.” *Mylan*, 989 F.3d at 1383; see p. 8, *supra*. That alone precludes mandamus relief because the parallel litigation “affords [petitioner] an adequate remedy,” even if petitioner finds that procedural avenue “unsatisfactory” or “less efficient[.]” *Fornaro v. James*, 416 F.3d 63, 69 (D.C. Cir. 2005) (Roberts, J.).

To be sure, petitioner has no alternative means to obtain judicial review of the Director’s decision denying its petition for inter partes review. But the absence of alternative review mechanisms with respect to that specific agency decision reflects a considered congressional judgment. The Patent Act states that the Director’s decision “whether to institute an inter partes review” is “final and nonappealable.” 35 U.S.C. 314(d). And while the Patent Act authorizes an appeal to the Federal Circuit of the Board’s final written decision in an *instituted* review, see 35 U.S.C. 141(e), 319, no statutory provision authorizes an appeal of the Director’s determination that a review should *not* be instituted. Petitioner’s decision to seek mandamus relief in this case, rather than to pursue an appeal, presumably reflects petitioner’s awareness of those features of the statutory scheme.

Second, and most fundamentally, petitioner “has failed to show a clear and indisputable right to the relief requested.” *In re Cambridge Indus. USA Inc.*, No. 2026-101, 2025 WL 3526129, at *3 (Fed. Cir. Dec. 9, 2025) (per curiam). The AIA identifies various circumstances in which the USPTO “may not” institute an inter partes review. See 35 U.S.C. 314(a), 315(a)(1) and (b). But no AIA provision “compels institution” under any circumstances, “even when the statutory preconditions are

present.” *Apple Inc. v. Squires*, 166 F.4th 1349, 1353, 1360 (Fed. Cir. 2026), petition for cert. pending, No. 26-73 (filed July 13, 2026); see *MyLAN*, 989 F.3d at 1382 (explaining that “the Patent Office’s decision to deny a petition is a matter committed to the Patent Office’s discretion”) (quoting *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 273 (2016)) (brackets omitted); p. 3, *supra*.

Thus, even if the Director’s denial of institution were reviewable by way of appeal, no petitioner would be able to establish that a denial violated the statute. And the demanding “clear and indisputable right” standard that governs mandamus review creates a further obstacle to petitioner’s request for mandamus relief. It is at least possible to imagine hypothetical circumstances—*e.g.*, a denial of institution that is explicitly based on the race or religion of the petitioner—in which the denial violates a clear *constitutional* command. But given the absence of statutory language requiring institution under any circumstances, it is unclear how any statutory challenge to an institution denial could satisfy the mandamus standard. In any event, petitioner has not established any “clear and indisputable right” to relief here.*

* The Federal Circuit, with the government’s agreement, has recognized its authority to entertain mandamus petitions where the denial of a petition for inter partes review is alleged to violate the Constitution. *MyLAN*, 989 F.3d at 1382-1383 (citing *Webster v. Doe*, 486 U.S. 592, 603-604 (1988)); see *id.* at 1380 n.4. The court in *MyLAN* observed that “[t]he Director is permitted, but never compelled, to institute an [inter partes review],” and that “no petitioner has a right to such institution.” *Id.* at 1382. Based on the absence of any statutory constraints on the Director’s authority to deny institution, and on Section 314(d)’s bar to appeal of such decisions, the court “conclude[d] that there is no reviewability of the Director’s exercise of his discretion to deny institution except for colorable constitutional claims.” *Ibid.* Petitioner here presents only “statutory”

Third, petitioner has not shown that the circumstances here warrant the extraordinary remedy of mandamus. The USPTO’s discretionary decision not to institute inter partes review simply “leaves a patent challenger’s actual legal rights and obligations unchanged.” *Squires*, 166 F.4th at 1361. As Justice Alito has observed, a “patent challenger does not have nearly as much to lose from an erroneous *denial* of inter partes review” because “it remains free to challenge the patent’s validity” in other forums. *Cuozzo*, 579 U.S. at 294 n.6 (opinion concurring in part and dissenting in part). And petitioner’s allegation that the agency considered an impermissible factor in making that discretionary decision is merely a commonplace claim of statutory error, not the sort of “really extraordinary cause[]” for which mandamus is reserved. *Cheney*, 542 U.S. at 380 (citation omitted).

Petitioner likewise has not carried its additional burden to show that “the Court of Appeals abused its discretion by failing to issue the writ.” *Cheney*, 542 U.S. at 391. The court noted the agency’s findings that the challenged patent had “‘been in force for more than 14 years, creating strong settled expectations,’” and that petitioner “‘had not shown review would be an appropriate use of PTO resources.” Pet. App. 1a (quoting *id.* at 4a). And as explained below (see pp. 15-17, *infra*), petitioner does not attempt to show that it satisfies any of the

challenges to the Director’s denial of inter partes review. Pet. i. In two recent unpublished decisions, the Federal Circuit has denied petitions for mandamus that raised statutory challenges to USPTO non-institution decisions, based on the petitioners’ “fail[ure] to show a clear and indisputable right to the relief requested.” *Cambridge*, 2025 WL 3526129, at *3; see *In re Sandisk Techs., Inc.*, No. 2025-152, 2025 WL 3526507, at *1 (Dec. 9, 2025) (per curiam).

mandamus requirements. Petitioner identifies no plausible basis for concluding that the court abused its discretion by denying mandamus relief on these facts.

b. The petition for a writ of certiorari does not acknowledge the demanding mandamus standard or address any of the “three conditions” that “must be satisfied” for a writ of mandamus to issue, nor does it attempt to show an abuse of discretion in the court of appeals’ denial of that extraordinary writ. *Cheney*, 542 U.S. at 380; see *id.* at 391. As noted above (see p. 12, *supra*), petitioner’s decision to seek mandamus relief in the Federal Circuit presumably reflected an awareness that the statutory scheme foreclosed an appeal of the Director’s non-institution decision. In the certiorari petition, however, petitioner faults the court of appeals for failing to apply the standard of review that would have been appropriate in an ordinary appeal. Petitioner’s failure to engage with the mandamus standard provides an independently sufficient reason for this Court to deny certiorari here.

i. This Court has repeatedly recognized that the AIA “committed the decision to institute inter partes review to the Director’s unreviewable discretion.” *United States v. Arthrex, Inc.*, 594 U.S. 1, 8-9 (2021). The reference to “unreviewable discretion” reflects two complementary but distinct aspects of the statutory scheme. *First*, although the AIA specifies that inter partes review may *not* be instituted in certain circumstances, it does not identify any circumstance where institution is *required*. See *Cuozzo*, 579 U.S. at 273 (explaining that Section 314(a) imposes “no mandate to institute review”); p. 3, *supra*. And apart from forbidding institution in certain circumstances, the statute says nothing about what factors the agency must or must not consider in deciding

whether institution is appropriate in a particular case. Thus, in cases where institution would be *permissible*, the statute places no constraints on the USPTO's discretion to decide whether a review should be instituted.

Second, Section 314(d) provides that “[t]he determination by the Director whether to institute an inter partes review under this section shall be final and non-appealable.” 35 U.S.C. 314(d). As applied to the decision that petitioner seeks to challenge here, in which the Director declined to institute a review, Section 314(d) accords with the “traditional[]” principle that “an agency’s decision not to take enforcement action should be presumed immune from judicial review.” *Heckler v. Chaney*, 470 U.S. 821, 832 (1985). As the Federal Circuit has explained, the decision not to institute inter partes review resembles other circumstances in which “agencies generally are free * * * to choose not to initiate enforcement proceedings,” with “no reviewability of the [agency’s] exercise of [its] discretion.” *Mylan*, 989 F.3d at 1382 (citing *Chaney*, 470 U.S. at 830-832 (1985); see *Apple Inc. v. Vidal*, 63 F.4th 1, 14 n.6 (Fed. Cir. 2023) (“Non-institution determinations are a species of non-enforcement decisions, which are among the few recognized categories of agency action that are generally ‘committed to agency discretion by law.’”) (citation omitted), cert. denied, 144 S. Ct. 548 (2024); *Squires*, 166 F.4th at 1360 (similar)).

As explained above (see p. 10, *supra*), this Court has not addressed the question whether the Director’s denial of an inter partes review petition is reviewable by way of mandamus. But while petitioner filed a mandamus petition in the Federal Circuit, petitioner makes no effort to demonstrate that it satisfies the distinct requirements for that form of relief. Rather, the clear thrust of

petitioner’s argument is that the Federal Circuit should have conducted the same review for legal error that the court would have conducted in a garden-variety appeal. See, *e.g.*, Pet. 22 (arguing that the court of appeals had “the ability and obligation to determine the bounds of the PTO’s statutory authority”). As the statutory text and this Court’s precedents make clear, Section 314(d) unambiguously bars that form of appellate review.

Under this Court’s precedent, Section 314(d)’s bar on appeal “encompasses the entire determination ‘whether to institute an inter partes review’” and so “extends to challenges grounded in ‘statutes related to’ the institution decision,” even where challengers seek to “label[]” their claims differently. *Thryv*, 590 U.S. at 56-57, 60 (first quoting 35 U.S.C. 314(d), then quoting *Cuozzo*, 579 U.S. at 275). Section 314(d) thus plainly bars an appeal “about what factors the Director may consider when deciding whether to institute” an inter partes review, which (similar to the claims held unreviewable in *Cuozzo* and *Thryv*) “turn[s] on ‘the application and interpretation of statutes related to the Patent Office’s decision to initiate inter partes review.’” *Cambridge*, 2025 WL 3526129, at *3 (quoting *Cuozzo*, 579 U.S. at 275).

Petitioner attempts (Pet. 25-29) to distinguish *Cuozzo* and *Thryv* by invoking this Court’s statements that parties may seek review of certain claims alleging that the USPTO “exceed[ed] its statutory bounds.” *SAS Inst. Inc. v. Iancu*, 584 U.S. 357, 371 (2018) (citing *Cuozzo*, 579 U.S. at 275). Those statements, however, concerned the scope of judicial authority to review a “final decision” of the Board “in the context of § 319,” on an appeal at the conclusion of an instituted inter partes review—not at the institution stage. *Cuozzo*, 579 U.S. at 275; see *SAS Inst.*, 584 U.S. at 1359 (addressing a claim of error

in a “final written decision”); p. 12, *supra*. Those statements are “inapplicable here, for [petitioner] challenges not the manner in which the agency’s review ‘proceeds’ once instituted, but whether the agency should have instituted review at all.” *Thryv*, 590 U.S. at 58. Indeed, the Court in *Thryv* recognized that Section 314(d) barred review of a claim based on “Section 315(b)’s time limitation” even if that provision were characterized as a “limit on the Board’s institution authority.” *Id.* at 53-54 (citation omitted). Those decisions reflect the fact that the Director’s determination “whether to institute an inter partes review” is the agency action that Section 314(d) makes “final and nonappealable.” 35 U.S.C. 314(d).

This Court’s precedent also forecloses petitioner’s reliance (Pet. 25-29) on the presumption of judicial review. See *Thryv*, 590 U.S. at 54 (“§ 314(d) overcomes the presumption favoring judicial review”); *Cuozzo*, 579 U.S. at 273-274 (similar); cf. *Mullin v. Doe*, 146 S. Ct. 2121, 2134 (2026) (“[T]he text of [another statute’s] judicial-review bar very clearly overcomes the general presumption in favor of judicial review.”). Nor does this Court’s interpretation of Section 314(d) raise “Article III concerns.” Pet. 28. Rather, the Court has long “held that Congress generally does not violate Article III when it strips federal jurisdiction over a class of cases.” *Patchak v. Zinke*, 583 U.S. 244, 253 (2018) (plurality opinion) (collecting cases). Congress’s power to foreclose review is especially clear with respect to agency decisions *not* to commence enforcement proceedings, for which non-reviewability is the norm. See p. 16, *supra*.

ii. On the merits (see Pet. 14-20), petitioner asserts (Pet. 1-2) that the USPTO “exceeds [its] statutory authority” by considering a patentee’s “‘settled expectation[s]’”—as measured by the length of time the challenged patent

has been in force—in determining whether to institute an inter partes review. Petitioner identifies no statutory provision, and none exists, that expressly bars consideration of that factor. As explained, the AIA identifies *no* criteria that the Director must or must not consider in making discretionary institution decisions. Rather, it leaves the Director “free, as in this case, to determine that for reasons of administrative efficiency [a review] will not be instituted.” *Mylan*, 989 F.3d at 1382; see pp. 5-7, *supra*; Pet. 9 (acknowledging that “[t]he PTO has traditionally used that discretion to prioritize resources”).

In arguing that the Director was foreclosed from considering the age of the challenged patent in making the institution decision, petitioner relies on Congress’s failure to enact “any statute of limitations for inter partes review based on the time elapsed since the patent’s issuance,” Pet. 15, combined with the presence of statutory time limits in other AIA provisions, see Pet. 15, 16. Even in an ordinary appeal, that sort of negative inference would be a clearly inadequate basis for imposing the limit on agency discretion that petitioner advocates. But it is especially farfetched to suppose that petitioner can establish a “clear and indisputable right” to relief based on Congress’s mere failure to identify patent age as a factor relevant to the institution decision.

Indeed, petitioner’s approach, taken to its logical conclusion, would fundamentally transform the legal regime that governs the Director’s discretionary institution decisions in cases where no statutory bar to institution applies. In petitioner’s view, the absence of any statutory age-of-patent limitation on inter partes review indicates that Congress viewed the patent’s age as an impermissible consideration in making the institution decision, and therefore impliedly precludes the

Director from invoking that factor as a ground for denying review. But as explained, in cases where no statutory bar to institution applies, the AIA identifies *no* criteria that the Director must or must not consider in deciding whether a review should be instituted. Thus, *any* factors that the Director might invoke as grounds for a discretionary denial will *necessarily* be factors that Congress did not require the Director to consider in making the institution decision. Petitioner’s argument therefore implies that, whenever institution of an inter partes review would be legally *permissible*, a review *must* be instituted. That rule would be directly contrary to this Court’s precedents, which have repeatedly recognized that institution is never legally required even when the statutory prerequisites are satisfied. See pp. 15-16, *supra*.

Petitioner purports to acknowledge that “the PTO has some discretion to deny institution under 35 U.S.C. 314(a).” Pet. 22. But the only circumstances it identifies where a discretionary denial would be permissible are cases “where the agency concludes that a petition has been filed for harassing reasons or is incomprehensible.” *Ibid*. The ability to deny institution in those rare and idiosyncratic circumstances would scarcely constitute the broad discretion that this Court’s precedents have recognized. That is particularly so because petitioner does not explain how the Director could infer an intent to harass, or find a petition for inter partes review to be “incomprehensible” (*ibid.*), while simultaneously finding “a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. 314(a). Petitioner’s only examples of permissible “discretion[ary]” institution denials

(Pet. 22) thus appear to involve circumstances where a key statutory prerequisite to institution is absent.

Relying on extra-record information from a “study” of USPTO institution decisions issued over “several months in 2025,” petitioner repeatedly characterizes (Pet. 2, 11, 15, 23) the settled-expectations factor as a “rule” or “presumption that [the USPTO] will refuse to review the validity of a patent more than six years old.” In fact, however, the Director has designated as informative decisions indicating that “there is no bright-line rule on when expectations become settled,” *Dabico Airport Solutions Inc. v. AXA Power ApS*, No. IPR2025-408, 2025 WL 1710857, at *1 (Acting Director June 18, 2025), and that other considerations favoring institution may “outweigh” settled expectations even when a patent has been in force much longer than six years, *Home Depot U.S.A., Inc. v. H2 Intellect LLC*, No. IPR2025-480, 2025 WL 3908177, at *1 (Acting Director Sept. 4, 2025) (“over twelve years”); see *Apple Inc. v. Allani*, No. IPR2025-856, 2025 WL 3908118, at *1 (Acting Director Sept. 5, 2025) (“thirteen years”); pp. 7-8, *supra*.

In this case, too, the agency did not rely solely on patent age, let alone attach dispositive weight to the fact that the patent was more than six years old. Rather, the agency based its decision on a “holistic assessment of all of the evidence and arguments presented,” including the fact that the challenged patent “ha[d] been in force for more than 14 years” when petitioner sought inter partes review. Pet. App. 4a. In any event, petitioner did not ask the court of appeals simply to disapprove a purported USPTO rule categorically forbidding institution of reviews involving older patents (however defined). Rather, petitioner advocated its own categorical rule, “ask[ing] the Federal Circuit to hold that patent age

is a statutorily impermissible consideration in the institution analysis and to ‘order the Director of the USPTO to reconsider whether to institute [review] without regard to the challenged patent’s age.’” Pet. 27 (quoting C.A. Mand. Pet. 4).

2. Petitioner does not identify any circuit conflict warranting further review in this case. Contra Pet. 23-25. The two published decisions on which petitioner relies merely held, more than 30 years ago, that judicial review was available under the Administrative Procedure Act (APA), 5 U.S.C. 701 *et seq.*, for claims arising under different statutory schemes that, unlike the AIA here, “clearly articulated” statutory prohibitions on the challenged agencies’ conduct. *Farmworker Justice Fund, Inc. v. Brock*, 811 F.2d 613, 627 (D.C. Cir.) (Secretary of Labor’s withholding of regulation), vacated as moot, 817 F.2d 890 (1987); *Ward v. Skinner*, 943 F.2d 157, 160 (1st Cir. 1991) (reviewing claim that Department of Transportation’s denial of waiver “violates a specific statute”), cert. denied, 503 U.S. 959 (1992). Similarly, the unpublished summary order in *Rodriguez v. Mayorkas*, No. 23-435, 2024 WL 4023841 (2d Cir. Sept. 3, 2024), merely allowed review where a plaintiff, “rather than challenging a discretionary determination, * * * question[ed] whether the [Citizenship and Immigration Service] adhered to express directives given to it by Congress.” *Id.* at *2.

Petitioner views those APA decisions as inconsistent with a purported “Federal Circuit[] holding that [5 U.S.C.] 701(a)(2) bars courts from reviewing the limits on an agency’s discretion.” Pet. 23. But the court below did not cite or rely on Section 701(a)(2), and this case does not directly implicate that APA provision. Rather, the pertinent restrictions on judicial review here are im-

posed by the AIA’s directive that institution decisions “shall be final and nonappealable,” 35 U.S.C. 314(d), and by the stringent standards that govern mandamus relief (even assuming that the Director’s non-institution decision is reviewable by way of mandamus).

Petitioner also asserts that “the Court will not have a better vehicle to address whether the patent-age rationale is reviewable and lawful.” Pet. 34. But given the absence of any statutory language that even arguably precludes the Director from considering patent age in making a discretionary institution decision, there is no reason to suppose that the question presented will ever warrant this Court’s review. And at the very least, a petition that acknowledged the standard that governs mandamus review, and that attempted to show how the petitioner satisfies that standard, would provide a better vehicle than the petition here.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

D. JOHN SAUER
Solicitor General
 BRETT A. SHUMATE
Assistant Attorney General
 MELISSA N. PATTERSON
 SAMUEL B. GOLDSTEIN
Attorneys

SEPTEMBER 2026