

In the Supreme Court of the United States

TESLA, INC., PETITIONER

v.

GRANITE VEHICLE VENTURES LLC, 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. Fintiv, Inc.</i> , No. IPR2020-19, 2020 WL 2126495 (P.T.A.B. Mar. 20, 2020).....	6, 21
<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)	7
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, 7, 13, 14, 17
<i>Apple Inc. v. Vidal</i> , 63 F.4th 1 (Fed. Cir. 2023), cert. denied, 144 S. Ct. 548 (2024)	5, 7, 17
<i>Cambridge Indus. USA Inc., In re</i> , No. 2026-101, 2025 WL 3526129 (Fed. Cir. Dec. 9, 2025).....	14
<i>Cheney v. United States Dist. Court</i> , 542 U.S. 367 (2004).....	9, 11, 12, 15
<i>Commil USA, LLC v. Cisco Sys., Inc.</i> , 575 U.S. 632 (2015).....	2, 12
<i>Cuozzo Speed Techs., LLC v. Lee</i> , 579 U.S. 261 (2016).....	2-4, 13, 14, 16-19
<i>Fahey, Ex parte</i> , 332 U.S. 258 (1947)	11

IV

Cases—Continued:	Page
<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, 17
<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)	7
142 S. Ct. 1363 (2002)	10
<i>Intel Corp. v. Vidal</i> , 144 S. Ct. 548 (2024)	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)	19
<i>Mylan Labs. Ltd. v. Janssen Pharmaceutica, N.V.</i> :	
989 F.3d 1375 (Fed. Cir. 2021), cert. denied, 142 S. Ct. 874 (2022)	7, 9, 11-14, 17, 19
142 S. Ct. 874 (2022)	10
<i>NHK Spring Co. v. Intri-Plex Techs., Inc.</i> , No. IPR2018-752, 2018 WL 4373643 (P.T.A.B. Sept. 12, 2018)	6
<i>Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC</i> , 584 U.S. 325 (2018).....	2
<i>Rodriguez v. Mayorkas</i> , No. 23-435, 2024 WL 4023841 (2d Cir. Sept. 3, 2024)	22
<i>SAS Inst. Inc. v. Iancu</i> , 584 U.S. 357 (2018)	3, 4, 18
<i>Sandisk Techs., Inc., In re</i> , No. 2025-152, 2025 WL 3526507 (Fed. Cir. Dec. 9, 2025)	14
<i>Thryv, Inc. v. Click-to-Call Techs., LP</i> , 590 U.S. 45 (2020)	4, 10, 17-19
<i>United States v. Arthrex, Inc.</i> , 594 U.S. 1 (2021)	3, 5, 16

V

Cases—Continued:	Page
<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).....	14
Statutes and regulations:	
Administrative Procedure Act, 5 U.S.C. 701 <i>et seq.</i>	21
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	2
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, 13, 16
35 U.S.C. 314(d).....	4, 11, 12, 14, 16-18, 22
35 U.S.C. 315(a)(1).....	3, 13
35 U.S.C. 315(b).....	3, 13
35 U.S.C. 315(e)(1).....	5
35 U.S.C. 315(e)(2).....	5
35 U.S.C. 316.....	4
35 U.S.C. 316(b).....	3, 8
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

VI

Miscellaneous:	Page
Memorandum from John A. Squires to All PTAB Judges, <i>Director Institution of AIA</i> <i>Trial Proceedings</i> (Oct. 17, 2025), https://perma.cc/MZ99-X26J	7
Memorandum from Coke Morgan Stewart to All PTAB Judges, <i>Interim Processes for PTAB</i> <i>Workload Management</i> (Mar. 26, 2025), https://perma.cc/G6VM-GFGU	7, 8
Patent Trial and Appeal Board, <i>Standard Operating</i> <i>Procedure 2 (Revision 11): Designation or</i> <i>De-Designation of Decisions as Presidential</i> <i>or Informative</i> (July 24, 2023), https://perma.cc/EF2C-PDHA	5

In the Supreme Court of the United States

No. 26-136

TESLA, INC., PETITIONER

v.

GRANITE VEHICLE VENTURES LLC, 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-3a) is available at 2026 WL 555080. The decisions of the United States Patent and Trademark Office (Pet. App. 4a-7a, 8a-10a) are unreported.

JURISDICTION

The judgment of the court of appeals was entered on February 27, 2026. On May 26, 2026, the Chief Justice extended the time within which to file a petition for a writ of certiorari to and including July 27, 2026, and the petition was filed on that date. 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); see 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. i. 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 *Vidal*, 63 F.4th at 8.

As relevant here, a previous Director designated as precedential two Board decisions regarding the significance of parallel district-court litigation to the institution decision. See *NHK Spring Co. v. Intrix-Plex Techs., Inc.*, No. IPR2018-752, 2018 WL 4373643 (P.T.A.B. Sept. 12, 2018); *Apple Inc. v. Fintiv, Inc.*, No. IPR2020-19, 2020 WL 2126495 (P.T.A.B. Mar. 20, 2020). In *NHK*, the Board explained that efficiency weighed in favor of declining to institute review when a “district court proceeding will analyze the same issues and will be resolved before any trial on the [inter partes review] [p]etition concludes.” 2018 WL 4373643, at *7.

In *Fintiv*, the Board identified six “non-dispositive factors” to consider when “the patent owner raises an argument for discretionary denial under *NHK* due to an earlier trial date.” 2020 WL 2126495, at *2. The factors are: (1) “whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted”; (2) “proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision”; (3) “investment in the parallel proceeding by the court and the parties”; (4) “overlap between issues raised in the petition and in the parallel proceeding”; (5) “whether the petitioner and the defendant in the parallel proceeding are the same party”; and (6) “other circumstances that impact the Board’s exercise of discretion, including the merits.” *Ibid.* The Board explained that these factors “relate to whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding.” *Id.* at *3. And they “should be weighed as part of a ‘balanced assessment of all relevant circumstances of the case, including the merits.’” *Id.* at *2 (citation omitted).

The Federal Circuit has repeatedly rejected attempts to challenge the *Fintiv* factors, including by mandamus, and this Court has 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, 1381-1383 (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).

ii. In 2025, the USPTO modified the agency’s 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.” Memorandum from Coke Morgan Stewart to All PTAB Judges, *Interim Processes for PTAB Workload Management* 3 (Mar. 26, 2025), <https://perma.cc/G6VM-GFGU>. Under the current procedures, the Director, in consultation with Board judges, “determine[s] whether discretionary denial of institution is appropriate.” *Id.* at 1; see Memorandum from John A. Squires to All PTAB Judges, *Director Institution of AIA Trial Proceedings* 1 (Oct. 17, 2025), <https://perma.cc/MZ99-X26J>. 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” factors such as “[w]hether the [Board] or another forum has already adjudicated the validity or patentability of

the challenged patent claims” and “[s]ettled expectations of the parties, such as the length of time the claims have been in force.” *Interim Processes for PTAB Workload Management* 2. “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 3 (citing 35 U.S.C. 316(b)).

2. a. Respondent Granite Vehicle Ventures LLC owns U.S. Patent Nos. 11,597,402, 11,738,765, and 12,037,004, which relate to self-driving vehicles. See C.A. App. 55, 156. In 2024, respondent sued petitioner Tesla, Inc. in federal district court, alleging that petitioner had infringed those patents. See *id.* at 135, 373, 610. That litigation remains ongoing. See 26-cv-1457 D. Ct. Doc. 213 (N.D. Cal. July 28, 2026) (denying petitioner’s motion to stay district-court litigation).

In 2025, petitioner filed petitions for inter partes review of these patents. See Pet. App. 1a; C.A. App. 47-146, 275-387, 498-625, 739-848. The USPTO declined to institute reviews, Pet. App. 4a-6a, 8a-9a, concluding that “discretionary denial of institution is appropriate in these proceedings,” *id.* at 5a, 9a.

The agency determined that it was “unlikely that a final written decision” in the inter partes review would issue “before the district court trial occurs” given the “scheduled trial date” at the time and relevant “time-to-trial statistics.” Pet. App. 5a. And the agency explained that there was “insufficient evidence that the district court is likely to stay its proceeding even if the Board were to institute trial.” *Ibid.* The agency thus found that instituting inter partes reviews would “result[] in significant duplication of effort, additional expense for the parties, and a risk of inconsistent decisions.” *Ibid.*

Although the patents “ha[d] not been in force for a significant period of time,” that “fact alone d[id] not tip the balance against discretionary denial.” *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.” *Id.* at 6a.

b. Petitioner filed a petition for a writ of mandamus in the Federal Circuit. See Pet. App. 2a. Petitioner contended that the USPTO’s consideration of the “time-to-trial” factor in determining not to institute inter partes reviews “exceed[s] its statutory authority.” C.A. Mand. Pet. 12. Petitioner sought an order “vacat[ing] the non-institution decision[s]” and “direct[ing] the USPTO to reconsider institution solely under the statutory criteria * * * without the USPTO’s time-to-trial criteria.” *Id.* at 25.

The Federal Circuit issued an unpublished order denying the mandamus petition. Pet. App. 1a-3a. The court determined that petitioner had failed to show a “clear and indisputable right” to the “‘drastic and extraordinary remedy’” of mandamus. *Id.* at 2a (quoting *Cheney v. United States Dist. Court*, 542 U.S. 367, 380 (2004)). The court explained that the USPTO “here merely concluded that instituting [inter partes review] would not be an efficient use of agency resources given the progress of the civil litigation between the parties at the time.” *Id.* at 2a-3a. “In circumstances like these,” the court had “not exercised mandamus authority to disturb a denial of institution decision,” and the court saw “no basis to do so here either.” *Id.* at 3a (citing *Myland*, 989 F.3d at 1382).

c. While its mandamus petition was pending before the Federal Circuit, petitioner requested ex parte reexaminations of the same three patents at issue here. See 26-cv-1457 D. Ct. Doc. 185, at 4 (N.D. Cal. June 2, 2026). The USPTO granted petitioner’s request to institute ex parte reexamination of two of the patents. *Ibid.* Petitioner then filed another request for ex parte reexamination of the third patent. *Ibid.*

ARGUMENT

Petitioner contends (Pet. 11-22) that the court of appeals should have issued a writ of mandamus vacating the USPTO’s decisions not to institute inter partes reviews and directing the agency to reconsider those decisions without taking into account the expected time to trial in parallel district-court litigation. The court of appeals 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.” *Id.* at 381 (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 patents, in which petitioner remains “free to litigate the [challenged] patent claims’ validity.” *Mylan*, 989 F.3d at 1383; see p. 8, *supra*. And the USPTO has granted petitioner’s requests to institute ex parte reexamination of at least two of these patents. See p. 10, *supra*. That alone precludes mandamus relief because the parallel litigation and ex parte reexaminations “afford[] [petitioner] an adequate remedy,” even if petitioner finds those procedural avenues “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 decisions denying its petitions 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 disturb the non-institution decisions” by the USPTO. Pet. App. 3a. 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 man-

damus standard. In any event, petitioner has not established any “clear and indisputable right” to relief here.*

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

* 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 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.” *In re Cambridge Indus. USA Inc.*, No. 2026-101, 2025 WL 3526129, at *3 (Fed. Cir. Dec. 9, 2025) (per curiam); see *In re Sandisk Techs., Inc.*, No. 2025-152, 2025 WL 3526507, at *1 (Dec. 9, 2025) (per curiam).

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 instituting inter partes review likely would result in “significant duplication of effort, additional expense for the parties, and a risk of inconsistent decisions” given “the progress of the civil litigation between the parties at the time.” Pet. App. 1a-3a (quoting *id.* at 5a). And as explained below (see pp. 15-17, *infra*), petitioner does not attempt to show that it satisfies any of the 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. 13, *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); 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 pp. 10-11, *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. 18 (arguing that the court of appeals had “the ‘obligation’ to ‘police the outer statutory boundaries’” of the USPTO’s “discretionary authority”) (brackets and citation omitted). 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 USPTO may consider when deciding whether to institute an inter partes review, which (similar to the claims held unreviewable in *Cuozzo* and *Thryv*) turns on “the application and interpretation of statutes related to the Patent Office’s decision to initiate inter partes review.” *Id.* at 53 (quoting *Cuozzo*, 579 U.S. at 275).

Petitioner attempts (Pet. 14-17) 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 359 (addressing a claim of error in a “final written decision”); pp. 12-13, *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 non-appealable.” 35 U.S.C. 314(d).

This Court’s precedent also forecloses petitioner’s reliance (Pet. 14) 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.”). Indeed, non-reviewability is the norm with respect to agency decisions *not* to commence enforcement proceedings. See pp. 16-17, *supra*.

ii. Although petitioner does not directly ask this Court to review its merits arguments (see Pet. i), it nonetheless asserts that the USPTO “has no power” to consider the expected trial date in parallel district-court litigation in determining whether to institute an inter partes review, Pet. 20; see Pet. 19-22, 27-29. 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. App. 3a (noting that the USPTO here “merely concluded that instituting [inter partes review] would not be an efficient use of agency resources given the progress of the civil litigation between the parties at the time”).

In arguing that the Director was foreclosed from considering the expected district-court trial date in making the institution decision, petitioner relies on Congress’s failure to enact any “time-to-trial limit on [inter partes review],” Pet. 27, combined with the presence of statutory “filing deadlines” and grants of “specific discretionary power” in other AIA provisions, Pet. 19; see Pet. 20-21, 27. 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 time to trial 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 time-to-trial limitation on inter partes review indicates that Congress viewed the timing of parallel district-court trial proceedings as irrelevant to 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 p. 16, *supra*.

Nor is petitioner correct to characterize (Pet. 3, 5-6, 9, 24, 27-29) the time-to-trial factor as a strict “rule” or

“limit” on when the USPTO will institute inter partes review. In fact, the Director has established as a matter of agency precedent that the *Fintiv* factors, which include “proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision,” are “non-dispositive” and “should be weighed as part of a ‘balanced assessment of all relevant circumstances of the case, including the merits.’” *Apple Inc. v. Fintiv, Inc.*, No. IPR2020-00019, 2020 WL 2126495, at *2 (P.T.A.B. Mar. 20, 2020) (citation omitted). In this case, too, the agency did not rely solely on the expected district-court trial date. Rather, the agency based its decision on “a holistic assessment of all of the evidence and arguments presented,” including the agency’s finding that it was “unlikely that a final written decision” would “issue before the district court trial occurs” based on the status of the district-court proceedings at the time. Pet. App. 5a-6a. In any event, petitioner did not ask the court of appeals simply to disapprove a purported USPTO rule categorically forbidding institution of reviews based on an expected district-court trial date. Rather, petitioner advocated its own categorical rule, asking the Federal Circuit to “direct the USPTO to reconsider institution without” relying on the time-to-trial factor. C.A. Mand. Pet. 25.

2. Petitioner does not identify any circuit conflict warranting further review in this case. Contra Pet. 18-19 (cross-referencing *Google LLC v. VirtaMove, Corp.*, petition for cert. pending, No. 25-1230 (filed Apr. 27, 2026), to which petitioner asserts that this is a “companion” case, Pet. 29). 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 statutory limits of an agency’s discretion.” Pet. 18. 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 imposed 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 “future chances to decide the reviewability of the PTO’s institution criteria may not arise.” Pet. 27. But given the absence of any statutory language that even arguably precludes the Director from considering an expected district-court trial date 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