

In the Supreme Court of the United States

FEDERAL EXPRESS CORPORATION,
PETITIONER

v.

QUALCOMM INCORPORATED, 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**

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QUESTIONS PRESENTED

A petition to institute an inter partes review of an issued patent may be considered by the Director of the United States Patent and Trademark Office only if (among other requirements) the petition “identifies all real parties in interest,” 35 U.S.C. 312(a)(2), and “identifies * * * the grounds” for review, 35 U.S.C. 312(a)(3). “The determination by the Director whether to institute an inter partes review * * * shall be final and nonappealable.” 35 U.S.C. 314(d). This Court has held that Section 314(d) bars judicial review of “challenges grounded in ‘statutes related to’ the institution decision,” including challenges to “the agency’s application of § 312(a)(3).” *Thryv, Inc. v. Click-to-Call Techs., LP*, 590 U.S. 45, 56 (2020) (quoting *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 275 (2016)). The question presented is as follows:

Whether 35 U.S.C. 314(d) bars judicial review of petitioner’s challenge to the agency’s application of 35 U.S.C. 312(a)(2).

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OPINIONS BELOW

The opinion of the court of appeals (Pet. App. 1a-16a) is reported at 174 F.4th 910. The final written decision of the Patent Trial and Appeal Board (Pet. App. 17a-42a) is unpublished.

JURISDICTION

The judgment of the court of appeals was entered on April 29, 2026. The petition for a writ of certiorari was filed on July 28, 2026. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

STATEMENT

1. “For several decades,” the United States Patent and Trademark Office (USPTO) has “possessed the authority to reexamine—and perhaps cancel—a patent claim that it had previously allowed.” *Cuozzo Speed*

Techs., LLC v. Lee, 579 U.S. 261, 267 (2016). In 2011, Congress established the procedure at issue here, inter partes review, as part of the Leahy-Smith America Invents Act (AIA), Pub. L. No. 112-29, 125 Stat. 284. Inter partes review “allows a third party to ask the [USPTO] to reexamine the claims in an already-issued patent and to cancel any claim that the agency finds to be unpatentable in light of prior art.” *Cuozzo*, 579 U.S. at 265; see 35 U.S.C. 311.

Any person other than the patent owner may file a petition to institute inter partes review on the grounds 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). The USPTO may consider a petition only if it meets certain requirements, including that the petition “identifies all real parties in interest [(RPIs)],” 35 U.S.C. 312(a)(2); that the petition “identifies, in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim,” 35 U.S.C. 312(a)(3); and that specified documents are provided to the patent owner, 35 U.S.C. 312(a)(5). The USPTO is required to make the petition available to the public as soon as practicable. 35 U.S.C. 312(b).

When presented with a petition, the Director of the USPTO must decide whether to institute review. 35 U.S.C. 314; see *Thryv, Inc. v. Click-to-Call Techs., LP*, 590 U.S. 45, 48 (2020). Among other conditions, “[a]n inter partes review may not be instituted if, 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,” 35

U.S.C. 315(a)(1), or if the petition “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(b). “The determination by the Director whether to institute an inter partes review * * * shall be final and nonappealable.” 35 U.S.C. 314(d).

If the agency institutes an inter partes review, the Patent Trial and Appeal Board (Board or PTAB), a body within the USPTO “composed of administrative patent judges, who are patent lawyers and former patent examiners, among others,” *Cuozzo*, 579 U.S. at 268, conducts a proceeding to evaluate the challenged claims’ validity, 35 U.S.C. 6, 316(c). The Board “shall issue a final written decision with respect to the patentability of any patent claim challenged by the petitioner,” 35 U.S.C. 318(a), which the Director of the USPTO may review, *United States v. Arthrex, Inc.*, 594 U.S. 1, 25-26 (2021) (opinion of Roberts, C.J.). “A party dissatisfied with the final written decision * * * may appeal the decision” to the United States Court of Appeals for the Federal Circuit. 35 U.S.C. 319.

Following any appeal of a final written decision, the USPTO issues and publishes a certificate canceling any claim finally determined to be unpatentable and confirming any claim determined to be patentable. 35 U.S.C. 318(b). A final written decision also estops the “petitioner * * * or the real party in interest or privy of 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 may designate a past decision as “precedential” for future cases. *Arthrex*, 594 U.S. at 14.

2. Over the years since the AIA’s enactment, the USPTO has changed its approach to Section 312(a)(2)’s requirement that a petition for inter partes review must identify all real parties in interest. Originally, the Board often resolved disputes concerning real parties in interest before instituting an inter partes review, even when resolution of such disputes would not implicate the estoppel or time-bar provisions of Sections 315(a)(1), (b), and (e). See *Corning Optical Commc’ns RF, LLC v. PPC Broadband, Inc.*, No. IPR2014-440, 2015 WL 14109211, at *10 (P.T.A.B. Aug. 18, 2015) (collecting cases). In 2020, however, the Director designated as precedential the Board’s contrary decision in *SharkNinja Operating LLC v. iRobot Corp.*, No. IPR2020-734, 2020 WL 5938681 (P.T.A.B. Oct. 6, 2020), in which the Board declined to resolve whether a petition for inter partes review had correctly named all real parties in interest. The Board found it unnecessary to resolve that issue because, in the circumstances of that case, identification of the real parties in interest “would not create a time bar or estoppel,” *id.* at *7, and therefore “would not impact the Board’s institution decision,” USPTO, *PTAB designates three decisions as precedential* (Dec. 4, 2020), <https://perma.cc/EM9F-BPYS>.

In late 2025, the USPTO returned to its original approach. USPTO, *Memorandum to All PTAB Judges* 1 (Oct. 28, 2025), <https://perma.cc/GAY2-B467>. The agency determined that the AIA is “best understood to require the Director to resolve disputes concerning real parties in interest * * * before considering a petition, even when the issue will not affect the statute’s estoppel or time-bar provisions.” C.A. Doc. 100, at 1 (Oct. 28, 2025). The USPTO removed the precedential status of *SharkNinja* and designated as precedential the relevant portions of

the Board's decision in *Corning*, which reflected the agency's original approach. See USPTO, *PTAB de-designates a decision* (Sept. 26, 2025), <https://perma.cc/7KPV-RW8T>; USPTO, *PTAB designates a precedential decision* (Oct. 28, 2025), <https://perma.cc/Z3RQ-NNBA>.

3. Petitioner owns U.S. Patent No. 8,766,797, which describes “systems and methods for providing access to information about shipments from sensors.” Pet. App. 2a; see *id.* at 2a-3a. In February 2022, respondent Qualcomm petitioned to institute inter partes review of the '797 patent. *Id.* at 4a. Qualcomm's petition acknowledged that in a related district-court suit, the same patent had been asserted against another entity, Roambee Corp.; but the petition identified Qualcomm itself as the only real party in interest. C.A. App. 144.

Petitioner opposed institution, contending that Roambee should have been listed as a real party in interest, and petitioner sought discovery to support its theory. C.A. App. 245-246. The Board denied the discovery request. *Id.* at 248. Consistent with the USPTO's then-applicable approach to disputes concerning a petitioner's compliance with Section 312(a)(2), the Board found it unnecessary to determine whether Roambee should have been listed as a real party in interest, on the ground that institution would be legally permissible regardless of the answer to that question. *Ibid.* Petitioner had acknowledged that Qualcomm's petition was filed before Roambee's statutory deadline for seeking inter partes review, and petitioner had not argued that treating Roambee as a real party in interest would preclude institution under the estoppel rule set forth in 35 U.S.C. 315(e)(1) and (2). C.A. App. 245, 247-248.

The Board instituted inter partes review of the '797 patent. C.A. App. 391-426. In granting institution, the

Board reiterated its prior position that it need not resolve whether Roambee was a real party in interest. *Id.* at 402-404. The Board explained that treating Roambee as a real party in interest would not trigger the statutory time-bar, and that the preliminary evidence did not show that Qualcomm had engaged in “bad faith” in listing itself as the sole real party in interest. *Id.* at 406. Accordingly, consistent with the then-precedential decision in *SharkNinja*, the Board declined to “deny institution on the basis that Qualcomm had allegedly failed to identify all real parties in interest.” *Id.* at 407.

After additional discovery, petitioner renewed its real-party-in-interest arguments in a motion to terminate the proceedings. C.A. App. 906-908. The Board denied the motion, reiterating its prior view of the real-party-in-interest dispute. Pet. App. 26a-28a, 41a. The Board explained that, even if Roambee should have been identified as a real party in interest, Qualcomm could easily “amend its mandatory notices to add a real party in interest” while “maintain[ing the] original filing date.” *Id.* at 26a. The Board acknowledged that a finding of bad faith, gamesmanship, or prejudice might prevent such an amendment, but it determined that the record evidence did not support such a finding here. *Id.* at 27a, 41a.

At the conclusion of the review, the Board issued a final written decision on patentability in Qualcomm’s favor, holding that all challenged claims (claims 1-33) were unpatentable over the asserted prior art. Pet. App. 6a; C.A. App. 51. The final written decision did not discuss any real-party-in-interest issues, deeming them sufficiently addressed in the Board’s prior denial of petitioner’s motion to terminate. C.A. App. 2.

4. Petitioner appealed to challenge the Board’s denial of petitioner’s motion to terminate the inter partes review, as well as the merits of the Board’s obviousness determination for three of the 33 claims that the Board had held to be unpatentable. Pet. App. 2a, 7a. The USPTO intervened in the Federal Circuit proceedings, arguing that 35 U.S.C. 314(d) barred the court from adjudicating the real-party-in-interest challenge. See Pet. App. 8a.* The court of appeals declined to review petitioner’s challenge to the Board’s denial of the motion to terminate, holding that Section 314(d) barred judicial review of that denial. The court vacated the Board’s obviousness determination, and remanded for further proceedings, on grounds not relevant here. *Id.* at 16a.

a. The court of appeals agreed with the USPTO and Qualcomm that petitioner’s “challenges grounded in § 312(a)(2) fall within § 314(d)’s scope and are thus unreviewable.” Pet. App. 11a. The court explained that “Section 312(a) describes the requirements for a petition to be considered for institution,” and that “Section 312(a)(2)’s real party in interest requirement clearly serves as a prerequisite for and is ‘integral to’ institution.” *Ibid.* (quoting *Thryv*, 590 U.S. at 53). The court noted the Federal Circuit’s prior holding “that challenges to the Board’s § 312(a)(2) determinations are unreviewable because § 312(a)(2) is ‘an institution-related statute.’” *Ibid.* (quoting *ESIP Series 2, LLC v. Puzhen Life USA, LLC*, 958 F.3d 1378, 1386, cert. denied, 141 S. Ct. 557 (2020) (in turn quoting *Thryv*, 590 U.S. at 54)).

* The USPTO initially defended the Board’s refusal to resolve the real-party-in-interest issue, but the agency later withdrew that defense in light of the Director’s change in position regarding the best understanding of Section 312(a)(2). See Pet. App. 8a n.5; see also pp. 4-5, *supra*.

The court concluded that petitioner’s “§ 312(a)(2)-focused challenges ‘necessarily target’ the decision to institute and are beyond our review.” *Ibid.* (brackets omitted) (quoting *Ethanol Boosting Sys., LLC v. Ford Motor Co.*, 162 F.4th 1151, 1159 (Fed. Cir. 2025)).

b. Petitioner relied in part on this Court’s holding in *SAS Institute Inc. v. Iancu*, 584 U.S. 357 (2018), that Section 314(d) does not bar an appeal alleging noncompliance with Section 318(a)’s requirement that a “final written decision” must resolve the patentability of all challenged claims. *Id.* at 371; see Pet. App. 12a. The court distinguished *SAS Institute* on the ground that “[t]he challenge in *SAS* concerned how the Board’s review would proceed after institution and not whether the choice to grant institution was correct.” Pet. App. 12a. The court further explained that petitioner’s “challenge that the Board exceeded its authority resembles” other challenges that the Federal Circuit had previously rejected. *Ibid.* (citing *Ethanol*, 162 F.4th at 1159, and *SIPCO, LLC v. Emerson Elec. Co.*, 980 F.3d 865, 869 (Fed. Cir. 2020)).

c. The court of appeals concluded that petitioner’s “challenge, although framed to be a challenge over the ‘manner’ in which the Board’s review proceeded—i.e., conducting the proceeding without making a real party in interest determination, thus exceeding its authority under § 312(a)—ultimately still boils down to a challenge over whether there should have been institution at all.” Pet. App. 13a. The court observed that “a conclusion that there should not have been institution is precisely what [petitioner] would likely seek on remand if we were to hear and agree with its § 312(a)(2) arguments.” *Ibid.* The court therefore held that petitioner’s

“real party in interest-related challenges are unreviewable under 35 U.S.C. § 314(d).” *Ibid.*

ARGUMENT

Petitioner challenges the court of appeals’ ruling that 35 U.S.C. 314(d)’s express bar on judicial review precludes petitioner’s appeal. The court decided this issue correctly, and its decision does not conflict with any decision of this Court or another court of appeals. The USPTO’s recent return to its original interpretation of 35 U.S.C. 312(a)(2) has also greatly reduced the significance of petitioner’s claims, and this case would be a poor vehicle to address them in any event. This Court has consistently denied petitions raising very similar questions. See *Dolby Labs. Licensing Corp. v. Unified Patents, LLC*, 146 S. Ct. 2745 (2026) (No. 25-1011); *ESIP Series 2, LLC v. Puzhen Life USA, LLC*, 141 S. Ct. 557 (2020) (No. 20-228). The Court should follow the same course here.

1. The court of appeals’ decision is correct and follows directly from this Court’s precedent interpreting Section 314(d). Section 314(d) provides 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); see pp. 7-8, *supra*. “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.” *Thryv, Inc. v. Click-To-Call Techs., LP*, 590 U.S. 45, 56-57 (2020) (first quoting 35 U.S.C. 314(d), then quoting *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 275 (2016)).

Accordingly, the Court in *Cuozzo* “held unreviewable the agency’s application of § 312(a)(3),” which “require[s]

that the grounds for challenging patent claims must be identified” in the petition to institute inter partes review. *Thryv*, 590 U.S. at 52, 56 (citing *Cuozzo*, 579 U.S. at 270, 275). Similarly in *Thryv*, the Court held unreviewable “[t]he agency’s application of § 315(b)’s time limit,” which “is closely related to its decision whether to institute inter partes review and is therefore rendered nonappealable by § 314(d).” *Id.* at 48. Although the challenger in *Thryv* sought to “label[]” its argument “as an appeal from the final written decision,” the Court concluded that the appeal “is still barred by § 314(d)” because “§ 315(b)’s sole office is to govern institution,” so that the challenger’s “contention remains, essentially, that the agency should have refused to institute inter partes review.” *Id.* at 60. By contrast, in *SAS Institute Inc. v. Iancu*, 584 U.S. 357 (2018), the Court held that Section 314(d) does not bar an appeal alleging non-compliance with Section 318(a)’s requirement that a “final written decision”—which is the only Board decision from which an appeal is authorized, 35 U.S.C. 319—must resolve the patentability of all challenged claims. *SAS Institute*, 584 U.S. at 371.

In this case, the court of appeals correctly recognized that petitioner’s “challenges grounded in § 312(a)(2) fall within § 314(d)’s scope and are thus unreviewable.” Pet. App. 11a. As the Federal Circuit had previously explained in a precedent cited in the decision below, “[i]n view of *Cuozzo* and [*Thryv*],” there is “no principled reason why preclusion of judicial review under § 314(d) would not extend to a Board decision concerning the ‘real parties in interest’ requirement of § 312(a)(2).” *ESIP Series 2, LLC v. Puzhen Life USA, LLC*, 958 F.3d 1378, 1386 (Fed. Cir.), cert. denied, 141 S. Ct. 557 (2020). Just like the challenges based on Sections 312(a)(3) and

315(b) that this Court previously held to be unreviewable, a “contention that the Board failed to comply with § 312(a)(2) is ‘a contention that the agency should have refused to institute an inter partes review,’” which Section 314(d) precludes. *Ibid.* (quoting *Thryv*, 590 U.S. at 54); see *Dolby Labs. Licensing Corp. v. Unified Patents, LLC*, 138 F.4th 1363, 1367 (Fed. Cir. 2025) (explaining that “the AIA bars judicial review of [inter partes review] institution decisions, which includes decisions concerning the RPI requirement under 35 U.S.C. § 312(a)(2)”), cert. denied, 146 S. Ct. 2745 (2026).

2. Petitioner contends (Pet. 15) that the ruling below conflicts with this Court’s decision in *SAS Institute*. That argument lacks merit. *SAS Institute*’s “reviewability holding is inapplicable” where, as here, an appeal effectively challenges “whether the agency should have instituted review at all.” *Thryv*, 590 U.S. at 58. Unlike the challenger in *SAS Institute*, petitioner does not invoke Section 318(a)’s requirements governing the contents of a “final written decision.” 35 U.S.C. 318(a). Indeed, neither Section 318(a) nor any other provision requires that the Board’s final written decision identify all real parties in interest. Instead, like the challenger in *Cuozzo*, petitioner invokes the requirements of Section 312(a), which governs a “petition filed under section 311,” 35 U.S.C. 312(a)—that is, a “petition to institute an inter partes review,” 35 U.S.C. 311(a).

As in *Thryv*, “even labeled as an appeal from” a post-institution decision denying petitioner’s motion to terminate, “[petitioner’s] attempt to overturn the Board’s § [312(a)(2)] ruling is still barred by § 314(d),” because Section 312(a)(2)’s “sole office is to govern institution.” *Thryv*, 590 U.S. at 60; see *Dolby*, 138 F.4th at 1367 (concluding that “decisions concerning the RPI requirement

under 35 U.S.C. § 312(a)(2)” are “bar[red]” from “judicial review”); *ESIP*, 958 F.3d at 1386 (“[T]he Board’s § 312(a)(2) real-party-in-interest determination is final and non-appealable.”). Petitioner observes (Pet. 18-19) that real-party-in-interest determinations made under Section 312(a)(2) may have consequences beyond the institution decision itself because such determinations may “trigger estoppel effects” in other proceedings pursuant to 35 U.S.C. 315(e). Pet. 19. But petitioner does not argue in this Court, and did not argue in the Board proceedings below, that Section 315(e)’s estoppel rule is implicated here. See Pet. App. 27a (Board observes that “neither party asserts that estoppel under 35 U.S.C. § 315(e)(1) applies”). Instead, petitioner’s evident objective is to invoke Qualcomm’s purported failure to identify all real parties in interest as a ground for undoing the Board’s institution decision. See *id.* at 13a (court of appeals explains that “a conclusion that there should not have been institution is precisely what [petitioner] would likely seek on remand if we were to hear and agree with its § 312(a)(2) arguments”).

3. Petitioner seeks to reframe its challenge as a reviewable dispute regarding whether the Board exceeded its statutory authority. Pet. 10-12. That effort likewise fails. Section 312(a) provides that a petition to institute an inter partes review “may be considered only if” the petition satisfies various conditions. 35 U.S.C. 312(a). This Court in *Cuozzo* held that Section 314(d) barred judicial review of the patent holder’s contention that the inter partes review petitioner had not set forth its challenges with the “particularity” that 35 U.S.C. 312(a)(3) requires. See *Cuozzo*, 579 U.S. at 271-272. Here, petitioner vigorously disputes both the accuracy of Qualcomm’s representation under Section 312(a)(2) that it was the sole

real party in interest, and the propriety of the USPTO's decision not to investigate that representation further. See Pet. App. 41a. For present purposes, however, the crucial question is not whether the Board *correctly* applied Section 312(a)(2), but whether the agency's alleged statutory breach has a sufficient nexus to the institution decision to trigger Section 314(d)'s bar to appeal. See *Cuozzo*, 579 U.S. at 275 (holding that Section 314(d) precludes appeal of "questions that are closely tied to the application and interpretation of statutes related to the Patent Office's decision to initiate inter partes review").

4. Petitioner is likewise wrong in arguing that "prudential reasons support" a grant of certiorari here. Pet. 21; see Pet. 21-24. That the USPTO has returned to its original approach regarding Section 312(a)(2) counsels against further review, not in favor of it. The USPTO now agrees with petitioner that Section 312(a)(2) is best understood to require the Director to resolve disputes concerning real parties in interest, even if resolution of such disputes does not affect the institution decision, and the agency has established precedential authority prescribing that approach in future proceedings. See pp. 4-5, *supra*. Those developments, which postdate petitioner's appeal to the Federal Circuit but predate the court's decision below, have greatly reduced the practical significance of the question presented here. Indeed, petitioner's other concerns—that the Board's decision not to resolve the real-party-in-interest dispute before instituting trial will allegedly "force[] patent owners to relitigate patent validity" and invite "gamesmanship" (Pet. 22-23)—are all premised on the USPTO's prior interpretation, which is no longer in force.

Petitioner urges the Court to preemptively “settle” the Board’s obligations under Section 312(a)(2) in order to foreclose the possibility that the USPTO will change its position again. Pet. 22. But the question presented in the certiorari petition (see Pet. i) asks solely whether Section 314(d) bars judicial review here. It does not encompass the distinct question whether the USPTO’s current view of its obligations under Section 312(a)(2), or instead the contrary view reflected in *SharkNinja Operating LLC v. iRobot Corp.*, No. IPR2020-734, 2020 WL 5938681 (P.T.A.B. Oct. 6, 2020), reflects the better reading of the statute.

Even if petitioner had sought review on the latter question, this Court could resolve that issue only if the Court first rejected the Federal Circuit’s holding that Section 314(d) bars appeal on that question. But “Congress has told the *Patent Office* to determine whether inter partes review should proceed, and it has made the agency’s decision ‘final’ and ‘nonappealable.’” *Cuozzo*, 579 U.S. at 274 (citation omitted). The question whether the Board must resolve disputes concerning the proper identification of real parties in interest before instituting an inter partes review is the type of question that this Court has held is nonappealable under Section 314(d). *Id.* at 274-275 (holding that Section 314(d) applies where the “grounds for attacking the decision to institute inter partes review consist of questions that are closely tied to the application and interpretation of statutes related to the Patent Office’s decision to initiate inter partes review”). Further review is not warranted.

CONCLUSION

The petition for a writ of certiorari should be denied.
Respectfully submitted.

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