No. 26-170

IN THE

Supreme Court of the United States

FEDERAL EXPRESS CORPORATION,

Petitioner,

v.

QUALCOMM INCORPORATED, *ET AL.*,

Respondents.

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

PETITIONER'S REPLY IN SUPPORT OF PETITION FOR CERTIORARI

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TABLE OF CONTENTS

	Page
TABLE OF AUTHORITIES	ii
INTRODUCTION	1
ARGUMENT	1
I. Nothing in *Cuozzo*, *Thryv*, or Any Statute Precludes Judicial Review of This Case...	1
II. Respondents' Prudential Arguments Confirm the Need for Certiorari	8
CONCLUSION	12

TABLE OF AUTHORITIES

CASES Page(s)

Boumediene v. Bush,
553 U.S. 723 (2008) 7

Cuozzo Speed Techs., LLC v. Lee,
579 U.S. 261 (2016) 1-4, 6, 7, 10, 11

Dolby Lab'ys Licensing Corp. v. Unified Patents, LLC,
138 F.4th 1363 (Fed. Cir. 2025) 10

ESIP Series 2, LLC v. Puzhen Life USA, LLC,
958 F.3d 1378 (Fed. Cir. 2020) 10, 11

Fed. Express Corp. v. Qualcomm Inc.,
No. 2024-1235, 2026 WL 1162769
(Fed. Cir. Apr. 29, 2026) 8

Fed. Express Corp. v. Qualcomm Inc.,
No. 2024-1237, 2026 WL 1162773
(Fed. Cir. Apr. 29, 2026) 8

GE Energy Power Conversion Fr. SAS v. Outokumpu Stainless USA, LLC,
590 U.S. 432 (2020) 6

Halo Elecs., Inc. v. Pulse Elecs., Inc.,
579 U.S. 93 (2016) 10

KSR Int'l Co. v. Teleflex Inc.,
550 U.S. 398 (2007) 10

Loper Bright Enters. v. Raimondo,
603 U.S. 369 (2024) 9

Medtronic, Inc. v. Robert Bosch Healthcare Systems, Inc.,
839 F.3d 1382 (Fed. Cir. 2016) 4

TABLE OF AUTHORITIES—Continued

Page(s)

Octane Fitness, LLC v. ICON Health & Fitness, Inc., 572 U.S. 545 (2014) 10

SAS Inst., Inc. v. Iancu, 584 U.S. 357 (2018) 1-3, 6, 7, 10

Thryv, Inc. v. Click-To-Call Techs., LP, 590 U.S. 45 (2020) 1-8

P.T.A.B. CASES

Accord BioPharma, Inc. v. Janssen Biotech, Inc., IPR2026-00256, Papers 19, 20 (P.T.A.B. Aug. 6, 2026; Sept. 9, 2026). 9

Corning Optical Commc'ns RF, LLC v. PPC Broadband, Inc., IPR2014-00440, Paper 40 (Aug. 18, 2015) 9

Merck Sharp & Dohme LLC v. Halozyme, Inc., IPR2026-00312, Papers 22, 23 (P.T.A.B. Aug. 19, 2026; Sept. 9, 2026) 9

Qualcomm Inc. v. FedEx Corp. Servs., Inc., IPR2022-00585, Paper 74 (P.T.A.B. Oct. 11, 2022) 2

Qualcomm Inc. v. FedEx Corp. Servs., Inc., IPR2022-00586, Paper 78 (P.T.A.B. Oct. 6, 2023) 8

Qualcomm Inc. v. FedEx Corp. Servs., Inc., IPR2022-00587, Paper 14 (P.T.A.B. Oct. 11, 2022) 8

TABLE OF AUTHORITIES—Continued

Page(s)

Samsung Elecs. Co. v. Netlist, Inc., IPR2025-01431, Papers 19, 21 (P.T.A.B. Dec. Jan. 9, 2026; Feb. 18, 2026) 9

Unified Patents, LLC v. MemoryWeb, LLC, IPR2021-01413, Paper 76 (P.T.A.B. May 22, 2023) 9

STATUTES

5 U.S.C. § 706(2) 2

28 U.S.C. § 1295(a)(4) 6

35 U.S.C. § 311 3

35 U.S.C. § 312 ..... 3, 5

35 U.S.C. § 312(a) 6, 7

35 U.S.C. § 312(a)(2) 1, 2, 4-7, 9-11

35 U.S.C. § 312(a)(3) 2, 4-6

35 U.S.C. § 314 3

35 U.S.C. § 314(d) 1, 3, 4, 7, 11

35 U.S.C. § 315 7

35 U.S.C. § 315(b) 2, 4-6

35 U.S.C. § 315(e) 4-6

35 U.S.C. § 315(e)(1) 6

35 U.S.C. § 315(e)(2) 5, 6

35 U.S.C. § 316 3

35 U.S.C. § 317 5

35 U.S.C. § 318 3

TABLE OF AUTHORITIES—Continued

RULES Page(s)

Sup. Ct. R. 10 8

Sup. Ct. R. 12.4 8

COURT FILINGS

Accord BioPharma, Inc. v. Janssen Biotech, Inc., IPR2026-00256, Papers 11, 15 (P.T.A.B. May 11, 2026; July 10, 2026) 9

Fed. Express Corp. v. Qualcomm Inc., No. 24-1236, ECF 57 (Fed. Cir. Oct. 28, 2024) 5

Fed. Express Corp. v. Qualcomm Inc., No. 24-1236, ECF 99 (Fed. Cir. Oct. 13, 2025) 10

Merck Sharp & Dohme LLC v. Halozyme, Inc., IPR2026-00312, Papers 13, 21 (P.T.A.B. June 26, 2026; Aug. 14, 2026) .. 9

Qualcomm Inc. v. FedEx Corp. Servs., Inc., IPR2022-00585, Paper 6 (P.T.A.B. July 5, 2022) 5

Qualcomm Inc. v. FedEx Corp. Servs., Inc., IPR2022-00585, Paper 9 (P.T.A.B. July 13, 2022) 5

Samsung Elecs. Co. v. Netlist, Inc., IPR2025-01431, Papers 9, 16 (P.T.A.B. Dec. 9, 2025; Dec. 18, 2025) 9

OTHER AUTHORITIES

ANTONIN SCALIA & BRYAN A. GARNER, READING LAW (2012) 6

INTRODUCTION

Respondents ask this Court to accept something extraordinary. A federal agency admits to violating a statute. A petitioner seeks judicial review. Respondents say no court can correct this wrong. One might expect Respondents to have clear textual or doctrinal justification for such an unjust conclusion. They supply neither.

Certainly no statute compels it. The Director agrees § 312(a)(2) imposes a prohibition he did not heed. Federal Brief (FBr.) 13. And neither Respondent claims the text of § 314(d) alone controls this case.

That leaves Court precedent. Here, too, Respondents struggle to answer. Both point to *Cuozzo* and *Thryv*, but neither case precludes review of an agency's refusal to obey statutory commands. *See* FBr. 9-10; Qualcomm Brief (QBr.) 8-9; *Thryv, Inc. v. Click-To-Call Techs., LP*, 590 U.S. 45 (2020); *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261 (2016). Instead, as in *SAS*, the Office here issued decisions in excess of its statutory authority. *See SAS Inst.*, *Inc. v. Iancu*, 584 U.S. 357 (2018). That extrastatutory conduct is what makes this case different and certiorari necessary.

ARGUMENT

I. Nothing in *Cuozzo*, *Thryv*, or Any Statute Precludes Judicial Review of This Case

Throughout their briefs, both Respondents rely on *Cuozzo* and *Thryv* to argue this appeal is not reviewable. *See* FBr. 9-10; QBr. 8-13. Yet neither Respondent once confronts this case's fundamental difference from those rulings. Pet. 13-21.

In *Cuozzo* and *Thryv*, the Board resolved the disputed statutory issue at institution. *See Thryv*, 590 U.S. at 50 (§ 315(b) resolved at institution); *Cuozzo*, 579 U.S. at 269-70 (same for § 312(a)(3)). The Board here never made that determination. As the Director concedes, the Office did not do so at institution (FBr. 5-6) or by final decision (*id.*).[1] *See also* App.40a. By "consider[ing]" Qualcomm's petitions without deciding whether they "identifie[d] all real parties in interest," the Board exceeded its statutory authority. 35 U.S.C. § 312(a)(2). These types of challenges remain reviewable under the APA. *See SAS*, 584 U.S. at 371 (quoting 5 U.S.C. § 706(2)).

Respondents try to minimize this distinction by improperly reframing FedEx's appeal as attacking the Board's institution decisions. FBr. 12; QBr. 10. This is wrong. FedEx cannot dispute whether the Board's RPI or institution decision is correct because there is no RPI decision to challenge. Rather, this appeal asks whether the Office can decide IPRs without satisfying a mandatory condition for their consideration at all. Pet. 13. The Office admits it does not have this power. FBr. 4, 13. That difference sets this case apart from *Cuozzo* and *Thryv*.

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[1] Qualcomm incorrectly suggests the Board decided RPI at institution or final decision. *See* QBr. 9-11 & n.3. It did not. *See* App.40a ("[A] determination should not be made as to whether Roambee is a[n RPI]."); *Qualcomm Inc. v. FedEx Corp. Servs., Inc.*, IPR2022-00585, Paper 74, at 16 (P.T.A.B. Oct. 11, 2022) ("*SharkNinja* does not require us to engage in a full real-party-in-interest analysis at the institution stage."). Nor do the Director or Federal Circuit think so. FBr. 5-6 ("In granting institution, the Board reiterated its prior position that it need not resolve whether Roambee was a[n RPI]."); App.5a-6a.

So does FedEx's requested relief. While the petitioners in *Cuozzo* and *Thryv* sought to unwindthe Board's institution decisions, FedEx seeks an instruction to resolve the Office's omitted RPI determination. Pet. 13. The merits of that future decision are unknown and not before the Court. *Id.* And though the parties may debate the potential consequences of that future ruling,[2] this does not transform the nature of FedEx's present claim. As *SAS* made clear, not all "legal questions bearing on" institution are unappealable. 584 U.S. at 370. When the Office abandons statutory requirements, § 314(d) does not stand in the way. *Id.* at 370-71. Courts may always ensure IPRs "proceed[] in accordance with the law's demands." *Id.* at 371. These IPRs did not do so. FBr. 13.

Respondents' only answer is to confine *SAS* to reviews of post-institution conduct under § 318. *See* FBr. 11; QBr. 10-11. This goes too far and not far enough. It goes too far because *SAS* analyzed §§ 311, 312, 314, 316, and 318 to support its holding. *See SAS*, 584 U.S. at 364-68. It is not § 318 alone that confers reviewability, but whether the agency "act[s] outside its statutory limits." *SAS*, 584 U.S. at 371 (quoting *Cuozzo*, 579 U.S. at 275). And the argument does not go far enough because this case implicates the very post-institution conduct Respondents require. Here, the Office declined to resolve the parties' statutory dispute at any point during trial. *See* FBr. 4-6. Issuing final decisions after refusing to resolve RPI by trial's

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[2] Qualcomm asserts a "good-faith belief" under the Office's prior policy. QBr. 2, 4, 11, 13-14. But the Office never adjudicated RPI (making any finding incomplete), nor would that belief matter under the new policy or § 312(a)(2) (making it irrelevant). *See* FBr. 4-5, 13. Similarly immaterial is Qualcomm's putative offer to amend its RPI listing. QBr. 11. It never amended, the Board never made it amend, nor can it amend under *Corning*.

end is appealable post-institution conduct. *See* Pet. 13, 15, 19. The Office admits it had no power to do this. FBr. 13. It did so anyway. That conduct raises questions about the Office's authority, not a dispute over facts decided at institution.

It thus misses the point for Respondents to claim the Board's final decision "reiterated its conclusion" on RPI. QBr. 10; *see also* FBr. 10. There was no "conclusion" on RPI to reiterate. *See* FBr. 4-6. Respondents analogize this case to *Cuozzo*'s "application of § 312(a)(3)" (FBr. 9; QBr. 9) and *Thryv*'s § 315(b) time-bar "ruling" (FBr. 10; QBr. 10). But again, there is no RPI "application" or "ruling" to challenge. And in *Medtronic, Inc. v. Robert Bosch Healthcare Systems, Inc.*, 839 F.3d 1382, 1384 (Fed. Cir. 2016), the Board vacated institution after an RPI decision. This case lacks that decision. Neither Respondent argues the Board's refusal to decide RPI is itself a "determination" under § 314(d) shielded from review.

Similarly unavailing is Respondents' misreading of *Cuozzo* and *Thryv* to bar any challenge "grounded in 'statutes related to' the institution decision." FBr. 9, 13; QBr. 8-9, 11-12. As FedEx explained, this paraphrase omits the subject of the quoted passage. Pet. 17. *Cuozzo* did not insulate all appeals "relat[ing] to" institution from review—only those "attacking the decision to institute." *Id.* (quoting *Cuozzo*, 579 U.S. at 274-75). *Thryv*'s § 315(b) time-bar ruling is one such example, as § 315(b) "governs institution and nothing more." 590 U.S. at 54.

Here, § 312(a)(2) governs far more than institution. The RPI identifications in § 312(a)(2) set the scope of estoppel in § 315(e). Pet. 18-19. *Cuozzo*'s "particularity" statute in § 312(a)(3) has no such

analogue. *See* 35 U.S.C. § 312(a)(3). Instead, § 312(a)(3) reflects a merits-based judgment call subsumed into the Office's merits decision, not a procedural binary ("all") like § 312(a)(2). *Cf. Thryv*, 590 U.S. at 66-67 (Gorsuch, J., dissenting) (discussing this concept).

Respondents have no credible response to § 312(a)(2)'s estoppel effects reaching beyond institution. Pet. 18-19. The Director incorrectly claims FedEx "did not argue . . . Section 315(e)'s estoppel rule is implicated here." FBr. 11-12. FedEx has argued—at every stage—that § 315(e)(2)'s estoppel provision should apply to Roambee as an unnamed RPI. *See* App.27a-28a (Board noting this argument after institution); C.A. App.[3] 246-47 (same argument before institution), 312, 317; *Fed. Express Corp. v. Qualcomm Inc.*, No. 24-1236, ECF 57, at 41 (Fed. Cir. Oct. 28, 2024); Pet. 22. Indeed, one key motivation driving FedEx's RPI challenge was ensuring "§ 315(e)(2) would estop Roambee from challenging the[same] claims a second time in district court." Pet. 22.

For its part, Qualcomm claims time bar decisions under § 315(b) "could" have similar estoppel effects as § 312(a)(2). QBr. 12. *Thryv* rejects this idea. "[Subsection] 315(b) expressly governs institution and nothing more." 590 U.S. at 54. The time bar has no meaning outside institution. By contrast, the "real party in interest" designations from § 312(a)(2) define

[3] FedEx adopts the Director's citation format for pages from the Court of Appeals Joint Appendix. Page 246 refers to *Qualcomm Inc. v. FedEx Corp. Servs., Inc.*, IPR2022-00585, Paper 6, at 3-4 (P.T.A.B. July 5, 2022). Pages 312 and 317 refer to *Qualcomm Inc. v. FedEx Corp. Servs., Inc.*, IPR2022-00585, Paper 9, at 23, 28 (P.T.A.B. July 13, 2022).

the scope of estoppel in § 315(e).[4] *See* 35 U.S.C. § 315(e)(1)-(2). It is § 312(a)(2) and § 315(e)—never § 315(b)—that effectuate estoppel in other proceedings. And unlike § 315(b), neither § 312(a)(2) nor § 315(e) uses the word "institute." 35 U.S.C. §§ 312(a)(2), 315(e).

Qualcomm contends *Cuozzo* construed *consider* in § 312(a) to mean *institute* (QBr. 9), but this again overreads *Cuozzo*. *Cuozzo* had no occasion to opine on the meaning of *consider* because the Office adjudicated § 312(a)(3) at institution. *See Cuozzo*, 579 U.S. at 270. With the statutory condition met, no further construction was needed. Neither *Cuozzo* nor *Thryv* addresses situations where, as here, the Office refuses to resolve a statutory dispute all trial. That issue was simply not before the Court. "[A] matter not covered is to be treated as not covered." ANTONIN SCALIA & BRYAN A. GARNER, READING LAW 93 (2012); *see GE Energy Power Conversion Fr. SAS v. Outokumpu Stainless USA, LLC*, 590 U.S. 432, 440 (2020) (same). Only *SAS* dealt with statutory omissions, and it ruled them reviewable. *SAS*, 584 U.S. at 370-71. So too here.

* * *

Qualcomm raises several cursory arguments opposing certiorari, but none warrants significant attention.

For example, Qualcomm refers to the absence of a circuit split. QBr. 8. This is unremarkable, given the Federal Circuit's exclusive jurisdiction over IPR appeals. Pet. 12 (citing 28 U.S.C. § 1295(a)(4)). The Court took *Cuozzo*, *SAS*, and *Thryv* over this objection,

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[4] While Qualcomm highlights its reference to the Roambee litigation as a "related case" (QBr. 2-3), it did not identify Roambee as an RPI (*id.*). Only the latter triggers estoppel. 35 U.S.C. §§ 312(a)(2), 315(e)(2).

and this case raises issues of administrative abdication extending beyond patent law.

Nor can Qualcomm dismiss *Cuozzo*'s warning about "not categorically preclud[ing] review" of certain cases as mere "dicta." QBr. 12. That statement reflects a limiting principle on *Cuozzo*'s holding. Such statements "integral to" an opinion are not dicta. *See Boumediene v. Bush*, 553 U.S. 723, 762-63 (2008). In any event, *SAS* adopted this reasoning as a core feature of its decision. *SAS*, 584 U.S. at 370-71. *SAS* makes this exception operative, not dicta.

Qualcomm elsewhere disputes the Office's construction of § 312(a)(2). *See* QBr. 3, 14 n.5. To Qualcomm, the Office must resolve RPI disputes only when it would "have [an] effect" on the IPR due to some preclusive operation from § 315. *Id.* Nothing supports this construction, hence the Director's rejection of it. FBr. 13. The RPI requirement in § 312(a)(2) is absolute. *See* 35 U.S.C. § 312(a)(2) ("A petition . . . may be considered only if . . . [it] identifies all real parties in interest."). The statute nowhere mentions qualifiers from § 315. Nor is Qualcomm correct to suggest § 312(a)(2) restricts only petitioners. QBr. 14 n.5. The statute governs when a petition "may be considered." 35 U.S.C. § 312(a)(2). Considered by whom? The Board. Petitioners do not "consider[]" their own papers. So while § 312(a) imposes a "duty" on petitioners (QBr. 14 n.5), it also binds Board action.

Nor does FedEx render § 314(d) a "dead letter." QBr. 12. The Office can rely on § 314(d) if it resolves statutory requirements at institution as it did in *Cuozzo* and *Thryv*. FBr. 13. But when the Office never resolves that dispute, such an omission remains appealable under *SAS*.

Finally, Qualcomm labels FedEx's patents "bad" and critiques FedEx for not seeking certiorari on the Board's patentability determinations.[5] QBr. 13 (quoting *Thryv*, 590 U.S. at 55). This is an odd criticism. FedEx limited its petition to a question of "compelling" legal importance rather than the Board's "erroneous factual findings" for specific patents. Sup. Ct. R. 10. And on the merits, FedEx prevailed on some claims while Qualcomm won on others.[6] This mixed result proves the Office's statutory violations can affect good patents.

II. Respondents' Prudential Arguments Confirm the Need for Certiorari

Respondents' prudential arguments confirm certiorari is warranted. Both Respondents claim the Office's change in procedure "greatly reduce[s]" (FBr. 13) if not

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[5] Qualcomm wonders in its fact section whether FedEx should have appealed more judgments. QBr. 7-8, 13. But Rule 12.4 addresses cases with different parties and explains when one petition "suffices" to cover multiple judgments. Sup. Ct. R. 12.4. Here, the Federal Circuit decided the RPI issue in this case (24-1236). FedEx was not required to petition other cases or patentability rulings to preserve this issue. The Federal Circuit's opinion is not law of the case.

[6] The Office denied institution for one patent. *Qualcomm Inc. v. FedEx Corp. Servs., Inc.*, IPR2022-00587, Paper 14 (P.T.A.B. Oct. 11, 2022). For another, it confirmed the patentability of certain claims and had other unpatentability decisions vacated on appeal. *Qualcomm Inc. v. FedEx Corp. Servs., Inc.*, IPR2022-00586, Paper 78 (P.T.A.B. Oct. 6, 2023); *Fed. Express Corp. v. Qualcomm Inc.*, 2026 WL 1162773 (Fed. Cir. Apr. 29, 2026). In a third case, the Federal Circuit reversed the Board's unpatentability ruling. *Fed. Express Corp. v. Qualcomm Inc.*, 2026 WL 1162769 (Fed. Cir. Apr. 29, 2026). And here, the Federal Circuit vacated the Board's unpatentability determinations for multiple claims. App.16a.

"precludes" (QBr. 14-15) the chance this issue arises again. But Respondents overstate the durability of their parchment guarantee. Nor has the Office appeared to faithfully adhere to its promise in practice.

The Director admits the Office's treatment of § 312(a)(2) has been a moving target for a decade. FBr. 4. These interpretations have swung from one extreme (*Corning*) to another (*Unified*). *See* Pet. 2-4 (chronicling these changes). Qualcomm goes so far as to defend the Office's old policy on the merits. QBr. 3, 14 & n.5. Such warring interpretations impacting thousands of IPRs each year cry out for this Court's stabilizing review. Pet. 12. And neither Respondent acknowledges—let alone allays—how the Office could reverse course again tomorrow. Pet. 21-22. It did so by fiat in this case. App.8a n.5. It will do so again.

Equally uncertain is the Office's fidelity to its new commitment. In several pending cases, the Office has appeared to institute review without resolving RPI disputes. *See, e.g.*, *Accord BioPharma, Inc. v. Janssen Biotech, Inc.*, IPR2026-00256 (P.T.A.B.) (Papers 11, 15, 19, 20); *Merck Sharp & Dohme LLC v. Halozyme, Inc.*, IPR2026-00312 (P.T.A.B.) (Papers 13, 21, 22, 23); *Samsung Elecs. Co. v. Netlist, Inc.*, IPR2025-01431 (P.T.A.B.) (Papers 9, 16, 19, 21). The Federal Circuit's ruling here would make these types of omissions nonjusticiable. This Court's intervention is thus necessary to define the Office's power the Federal Circuit refuses to referee. "Courts must exercise their independent judgment in deciding whether an agency has acted within its statutory authority." *Loper Bright Enters. v. Raimondo*, 603 U.S. 369, 412 (2024).

That judgment is needed here. The panel's decision adopts a categorical rule barring review of any legal

challenge implicating § 312(a)(2). *See* Pet. 16-21; App.11a-13a. *Cuozzo* rejects such an expansive interpretation of its holding, and *SAS* exemplifies those limits. *See Cuozzo*, 579 U.S. at 275 (cautioning it "do[es] not categorically preclude review" of questions "enabl[ing] the agency to act outside its statutory limits"); *SAS*, 584 U.S. at 370-71. The Federal Circuit's overly rigid test here resembles others this Court has had to mediate in the past. *See, e.g.*, *Halo Elecs., Inc. v. Pulse Elecs., Inc.*, 579 U.S. 93 (2016); *Octane Fitness, LLC v. ICON Health & Fitness, Inc.*, 572 U.S. 545 (2014); *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007).

Respondents point to the Court's certiorari denials in *Dolby* and *ESIP* as reason to follow suit here. FBr. 9; QBr. 2. But once again, this ignores what makes FedEx's case different. *See* Pet. 12 & n.3 (citing *Dolby Lab'ys Licensing Corp. v. Unified Patents, LLC*, 138 F.4th 1363 (Fed. Cir. 2025); *ESIP Series 2, LLC v. Puzhen Life USA, LLC*, 958 F.3d 1378 (Fed. Cir. 2020)). The petitioner in *Dolby* had a latent standing problem and thus sought a freestanding "informational right" in § 312(a)(2) to bring an action against the Office. 138 F.4th at 1367-68. Here, Qualcomm admits "no party has challenged FedEx's standing." *Fed. Express Corp. v. Qualcomm Inc.*, No. 24-1236, ECF 99, at 1 (Fed. Cir. Oct. 13, 2025). And FedEx's relief rests on resolving § 312(a)(2) "in the context of IPR proceedings"—a right *Dolby* assumes exists. 138 F.4th at 1367.

ESIP is just the RPI retread of *Cuozzo*. In both cases, the Office resolved the disputed statutory issue at institution. *See Cuozzo*, 579 U.S. at 270; *ESIP*, 958 F.3d at 1386. This left the petitioners consigned to argue the Board "should have refused to institute."

ESIP, 958 F.3d at 1386; *see also Cuozzo*, 579 U.S. at 270 ("[T]he Patent Office improperly instituted inter partes review.").

FedEx's petition is different. Pet. 13. The Board here never resolved the parties' statutory dispute—at institution or otherwise. App.40a. There is thus no RPI determination for FedEx to challenge. Rather, this appeal asks whether the Office has the power to decide IPR petitions without confirming they satisfy § 312(a)(2) whatsoever. FedEx says no, and the Director agrees. FBr. 13. *ESIP* itself recognizes the importance of these statutory decisions for § 314(d) purposes. *See* 958 F.3d at 1386 (discussing the Board's "decision" and "determination" on RPI). There is no such decision here.

And that, after all, is what makes this case ripe for review. The Office has violated a statute. It has admitted its mistake. Nothing in any statute or Court precedent precludes judicial review of these errors, and nothing in any fair sense of justice does either.

CONCLUSION

The Court should grant the petition.

Respectfully submitted,

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