

No. 26-73

IN THE
Supreme Court of the United States

Intel Corporation, Google LLC,
Petitioners,
v.

John A. Squires, Under Secretary of Commerce for
Intellectual Property and Director of the United
States Patent and Trademark Office,
Respondent.

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

BRIEF OF TEODOR HOLMBERG AS *AMICUS CURIAE*
IN SUPPORT OF PETITIONER

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QUESTIONS PRESENTED

1. What is the proper scope of 35 U.S.C. §314(d)'s shield of preclusion from judicial review? More specifically, does the *Fintiv* rule at issue here fall within that scope and thus cannot be substantively reviewed by any court, including this Court?

2. Is the all-encompassing scope of §314(d)'s preclusion of judicial review, as presently interpreted by the Federal Circuit in *Apple v. Vidal*, 63 F.4th 1 (Fed. Cir. 2023) (in the instant matter), inappropriately broad in light of *Loper Bright Enters. v. Raimondo*, 603 U.S. 369 (2024)?

3. As part of Question #2, should this Court re-appraise and modify its holding in *Thryv, Inc. v. Click-to-call Techs.*, 590 U.S. 45 (2020), the precedent establishing the greatest scope of preclusion for 35 U.S.C. §314(d) (and arguably at odds with other precedents of this Court), in light of *Loper Bright Enters. v. Raimondo*, 603 U.S. 369 (2024)?

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INTEREST OF AMICUS CURIAE

Amicus is a patent attorney of over 25 years' experience, who has been involved in patent litigation all over the United States and written over 200 patents. *Amicus* is a member of the patent bar (Reg. No. 50,140), and the bars of Massachusetts, New York, and, of course, the U.S. Supreme Court.¹

Amicus believes that the pretense in many briefs that all of the precedents make sense and are in perfect harmony with each other is not helpful. In this particular case, there are tensions and contradictions between the precedents which should be identified and reconciled in order to properly resolve the issues.

This brief tries to present the most relevant of the twists and turns, inconsistencies, vagaries, and contradictions in the history of 35 U.S.C. §314(d)—the statutory provision concerning *inter partes* review (IPR) which is the foundational problem in this and other petitions for *certiorari* before this Court. By pointing out those tensions, this brief “brings to the attention of the Court relevant matter not already brought to its attention by the parties,” and *amicus* hopes it “may be of considerable help to the Court,” thereby fulfilling its purpose under this Court’s Rule 37.1.

¹ Pursuant to this Court’s Rule 37.2, on August 4, 2026, all counsel of record listed in the docket received *amicus curiae*’s notice of intention to file this brief.

Pursuant to Rule 37.6, no counsel for any party authored this brief in whole or in part, and no counsel, party, or person other than *amicus curiae* made a monetary contribution intended to fund the preparation or submission of this brief.

INTRODUCTION AND SUMMARY OF ARGUMENT

The question here is simple: what does 35 U.S.C. §314(d) protect from judicial review? The answer from the Federal Circuit (and the Patent and Trademark Office (PTO)) is that **anything** related to or concerning the decision whether to institute an *inter partes* review (IPR) proceeding, including the *Fintiv* rule² specifically at issue here, is shielded from judicial review. See *Apple v. Vidal*, 63 F.4th 1, 10 (Fed. Cir. 2023) *cert. denied, sub nom. Intel Corp. v. Vidal*, 144 S. Ct. 548 (2024)³ (“... we conclude the IPR statute’s preclusion of review ... must encompass preclusion of review of the content-focused challenges to the instructions at issue here.”).

This characterization is not an exaggeration—the Federal Circuit has made it clear that, in addition to PTO instructions/guidance (such as the *Fintiv* rule at issue here), any PTO determinations or actions related in any way to granting or denying an IPR petition are also untouchable because of §314(d). For example:

² This 6-factor test for considering related co-pending court proceedings when making an IPR institution decision is also called the *NHK-Fintiv* test after the two precedential PTO Board decisions establishing it. Since the Petition uses the term “*Fintiv* rule,” that term is used here as well.

³ As discussed in the Petition, *Apple v. Vidal* was the first appeal to the Federal Circuit in this matter, while the present Petition is technically from the second appeal, *i.e.*, *Apple, Inc., v. Squires*, 166 F.4th 1349 (Fed. Cir. 2026). See, *e.g.*, Pet., pp. 33-34. However, the driving issue in this and the other cases before this Court is the preclusive scope of 35 U.S.C. §314(d), as reflected in *Apple v. Vidal*.

- in *Hafeman v. Google*, 177 F.4th 1191 (Fed. Cir. 2026), even though a District Court subsequently found that the party had broken its *Sotera* stipulation,⁴ which had been required for the grant of the IPR petition, PTO refused to consider that fact and continued with the IPR proceeding—the PTO’s decision was unreviewable because of §314(d) (citing *Apple v. Vidal*);
- in *Federal Express v. Qualcomm*, 2026 WL 1735367 (Fed. Cir. 2026), the PTO effectively ignored the requirement under 35 U.S.C. §312(a)(2)⁵ that all of the real parties in interest have to be identified in the IPR petition—the PTO’s decision was unreviewable because of §314(d);
- in *In re Google LLC*, 2026 WL 204945 (Fed. Cir. Jan. 27, 2026),⁶ pursuant to the new “discretionary denial” (DD) system set up in the PTO’s 3/26/25 DD Memo,⁷ the PTO denied an

⁴ In a *Sotera* stipulation, the IPR petitioner agrees not to pursue in a co-pending litigation any ground that was “raised or reasonably could have been raised” in the IPR proceeding.

⁵ §312(a)(2) states that the IPR petition “may be considered *only if* ... the petition identifies *all real parties in interest*” (emphasis added).

⁶ This is the subject of the pending petition for *certiorari* in Sup. Ct. Dckt. No. 25-1230 (hereinafter, the “Google Petition”).

⁷ The PTO’s March 26, 2025 Memorandum entitled “Interim Processes for PTAB Workload Management” (hereinafter, “the 3/26/25 DD Memo”) established non-merit “discretionary considerations” for the IPR institution decision, including the “settled expectations of the parties, such as the length of time the claims have been in force” and “any other considerations bearing on the Director’s discretion.” See Appendix E to the Google Petition.

IPR petition on the non-statutory basis that the “patent has been in force for more than 14 years”—the PTO’s decision was unreviewable because of §314(d); and

- in *In re Tesla, Inc.*, Dckt. No. 2026-116 (Fed. Cir. Feb. 27, 2026),⁸ pursuant to the 3/26/25 DD Memo, the PTO denied an IPR petition on the non-statutory basis that the “it is unlikely that a [FWD]⁹ in this proceeding will issue before the district court trial occurs”—the PTO’s decision was unreviewable because of §314(d) (citing *Apple v. Vidal*).

The issue is not whether these PTO decisions were correct or not, but rather whether the Federal Circuit/PTO’s position that §314(d) is an absolute bar to judicial review of any of these decisions is correct or not. See, e.g., Transcript of the Oral Argument in *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261 (2016), p. 50 (“Why would Congress tell the PTO don’t do it [*i.e.*, institute an IPR] except in these limited circumstances, but *nobody’s going to ever watch over you to make sure that’s what you’re doing?*”) (Sotomayor, J.; emphasis added).

The path to the Federal Circuit/PTO’s absolutist position on §314(d)’s preclusive scope is a long and winding one, starting with some overbroad dicta in *Cuozzo*, but it is *Thryv, Inc. v. Click-to-call Techs.*, 590

⁸ This is the subject of the pending petition for *certiorari* in Sup. Ct. Dckt. No. 26-136 (hereinafter, the “Tesla Petition”).

⁹ For purposes of clarity, the term “IPR institution decision,” as used here refers to the initial decision whether to grant or deny the IPR petition, while the terms “FWD” or “Final Written Decision” refer to the final decision of an instituted IPR proceeding.

U.S. 45 (2020), that is the cause of the present dilemma.

The proper interpretation of §314(d)’s scope limits its preclusion of judicial review to the “threshold” determination in §314(a)—the core finding whether any of the obviousness arguments in the IPR petition shows “a reasonable likelihood” of success. *Thryv* expanded §314(d)’s preclusive scope to include any statutory provision which may be considered as part of granting or denying an IPR petition. It is respectfully submitted that *Thryv* was wrong: the PTO’s specific findings and interpretations of statutory requirements like the timing of the IPR petition in §315(b), or the identity of the real party of interest (RPI) in §312(a)(2), should not be shielded from judicial review by §314(d) because such determinations have nothing to do with the “reasonable likelihood” of obviousness in §314(a)—the only PTO determination protected by §314(d).

The dissent in *Thryv* predicted where the majority’s holding would lead. *Thryv*, 590 U.S., at 68 (2020) (Gorsuch, J. dissenting, joined by Sotomayor, J.). (“... under [the Court’s interpretation], *all* questions related to the Director’s institution decision should be insulated from review, no matter where those rules are found.”) (emphasis in original). *Thryv* enabled the Federal Circuit/PTO’s current absolutist interpretation, as set forth in *Apple v. Vidal* (which cites *Thryv* a record 14 times).

Loper Bright, which was decided after *Thryv* and *Apple v. Vidal*, re-affirmed the primacy of judicial review. It is the courts, not executive agencies, which ultimately decide what statutes mean—and how much power an agency wields. *Loper Bright Enters.*

v. Raimondo, 603 U.S. 369, 392 (2024) (“ ... it thus remains the responsibility of the court to decide whether the law means what the agency says.”).

The decisions in both *Thryv* and *Apple v. Vidal* represent impermissible abdications of judicial responsibility under *Loper Bright* and should be reversed. *Loper Bright*, 603 U.S., at 401 (“ ... when the ambiguity is about the scope of an agency’s own power ... [is] ... the occasion in which abdication in favor of the agency is *least* appropriate.”) (emphasis in original); see also *Thryv*, 590 U.S., at 79 (Gorsuch, J. dissenting) (the majority’s holding is an “abdication of our judicial duty”).

This Court should grant *certiorari* in this case in order to determine the true scope of §314(d)’s preclusion of judicial review and, *inter alia*, whether *Thryv* and *Apple v. Vidal* should be reversed under *Loper Bright*.

ARGUMENT

I. The Statutory Framework

A. §314(d) shields the §314(a) “threshold” determination from judicial review

Pertinent parts of 35 U.S.C. §314 reproduced below (emphasis added):

35 U.S.C. §314—Institution of inter partes review.

(a) THRESHOLD.—The Director¹⁰ may not authorize an inter partes review to be instituted unless the Director ***determines*** that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

...

(d) NO APPEAL.—The ***determination*** by the Director whether to institute an inter partes review ***under this section*** shall be final and nonappealable.

¹⁰ Although there are significant differences in purpose, constituents, and power between the PTO Director, the PTO Board or PTAB, and the PTO (generally), these various entities are referred to herein equivalently and interchangeably because those differences are irrelevant in this specific matter. For example, §§314(a) and (d) above refer to the PTO Director, but the following discussion refers to the “PTO” as interchangeable and equivalent to “Director.”

On its face, the “determination whether to institute [IPR] under this section” in §314(d) appears to refer to what the PTO “determines” in §314(a), *i.e.*, the core “threshold” determination of the IPR petition showing a reasonable likelihood of obviousness. This is supported by the phrase “under this section” in §314(d), which clearly refers to §314. The word “section” is used 5 times in §314, and each time it is referring to a specific statute, and each time the word is used elsewhere in the IPR statute,¹¹ it is referring to a single statute section. See *IBP, Inc. v. Alvarez*, 546 U.S. 21, 34 (2005) (“[T]he normal rule of statutory interpretation [is] that identical words used in different parts of the same statute are generally presumed to have the same meaning.”).

The interpretation of “under this section” is one of the splits within the precedential history of 314(d). In *SAS Institute* (and in the Federal Circuit before *Thryv*), “this section” means §314, and, more specifically, §314(a). In *Thryv* (and in some overly broad sentences in *Cuozzo*), “this section” means the entire IPR statutory framework. This is the debate in a nutshell: the limited scope interpretation of §314(d), where §314(d) is primarily limited to §314(a) (as argued herein), and the absolutist interpretation, where §314(d) encompasses anything possibly considered when granting or denying an IPR petition.

¹¹ Herein, the “IPR statute” refers to Chapter 31, §§311-319 of Title 35, the Patent Act.

**B. Congress gave the PTO Discretion
regarding Related PTO Proceedings,
Not Related Court Proceedings**

In every instance, the IPR statute explicitly circumscribes the PTO's scope of discretion/authority to *within* the IPR statute and/or *within* the PTO. For example, §315(c) gives the Director the authority to join together different IPRs; §315(d) gives the Director the discretion to “determine the manner in which” the IPR and any other related PTO “proceeding or matter may proceed;” and §325(d) gives the Director the discretion to consider related PTO proceedings when granting or denying an IPR petition. No statutory provision gives the Director the authority to create his own considerations—such as the *Fintiv* rule or a rule to deny an IPR based on “settled expectations”—when making the IPR institution decision under §314(a).

**(1) §316(a) Lists the Subjects/Areas of
the PTO's IPR Rule-Making Authority**

Regarding IPRs, Congress provided a long and detailed list of areas/subjects in 35 U.S.C. §316(a) where the Director may exercise rule-making authority. §316(a)(2) gives the Director rule-making authority regarding the IPR institution decision, and §316(a)(4) gives the Director the broadest rule-making authority; both are discussed below. The remainder mostly concern the authority to make rules concerning the minutiae of having a public trial-like procedure, *e.g.*: rules about discovery in the IPR proceeding (§316(a)(5)); rules for discovery sanctions (§316(a)(6)); rules for protective orders (§316(a)(7)); rules for the patent owner's response (§316(a)(8));

rules for how the patent owner can amend under §316(d) (§316(a)(9)); and rules for requiring the FWD to issue within a year (§316(a)(11)).¹² No provision in §316(a) gives the PTO the power to independently create its own discretionary considerations for denying IPR petitions.

Under §316(a)(2), the Director’s rule-making authority regarding the IPR institution decision is limited to the §314(a) “threshold” determination—specifically for “setting forth standards for the showing of sufficient grounds to institute a review under section 314(a).” As written, this is a very limited power. It also indicates the importance of the §314(a) threshold determination to the IPR institution decision, thereby reinforcing the interpretation that §314(d)’s scope of preclusion is primarily limited to the §314(a) threshold determination. Under §316(a)(4), Congress gave the PTO the power to make the rules “establishing and governing inter partes review **under this chapter** and the relationship of such review to other proceedings **under this title**” (emphasis added), but not for creating its own substantive requirements in addition to what Congress established.

¹² Which begs the question: why would Congress draft such a detailed list of subjects where the PTO has rule-making authority, and not include the authority for the PTO to make its own rules for considering related court cases when making the IPR institution decision (if Congress actually wanted the PTO to have such power)?

**(2) §325(d) gives the PTO the Discretion
to Deny an IPR based on related PTO
Proceedings**

The last sentence in §325(d)¹³ reads: “In determining **whether to institute** or order a proceeding under this chapter, chapter 30, or chapter 31 [the IPR statute], **the Director may take into account** whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office” (emphasis added). This clearly gives the PTO broad authority to make substantive rules and guidelines concerning how to treat an IPR in relation to other PTO proceedings.

There is no similar sentence in the IPR statute giving the PTO such authority in regards to related court proceedings. That alone is substantial proof that Congress did not intend the PTO to have substantive rule-making authority for considering related court proceedings when making the IPR institution decision. See *City of San Francisco v. EPA*, 604 U.S. 334, 344 (2025) (“[W]here Congress includes particular language in one section of a statute but omits it in another section of the same Act, it is generally presumed that Congress acts intentionally and purposely in the disparate inclusion or exclusion.”).

¹³ §325 is part of Chapter 32, §§321-329, which is directed to the post-grant review (PGR); however, as shown above, Congress drafted the last sentence in §325(d) so that it applies to *ex parte* reexaminations (Chapter 30), IPRs (Chapter 31), and PGRs (“this chapter”).

***(3) The PTO’s Consideration of Related
Court Proceedings in an IPR
Institution Decision is Limited to
Ministerially Applying the Statutory
Limitations of §315***

Congress listed how exactly IPR proceedings and related court proceedings should be treated by the PTO in §315, entitled “Relation to other proceedings or actions.” See *Dubin v. United States*, 599 U. S. 110, 120–121 (2023) (the title of a statutory provision can inform its interpretation). Related court proceedings are dealt with in §§315(a), (b), and (e)(2), while related PTO proceedings are in §§315(c), (d), and (e)(1).

Initially, one sees a difference in the language used in the different provisions. In §§315(c) and (d), which deal with relationships between PTO proceedings, the Director is given a lot of leeway. See, e.g., §315(c) (“... the Director, in his or her discretion, may join ...”) and §315(d) (“... the Director may determine the manner in which the [IPR] or other matter of proceeding may proceed, ...”). By contrast, the Director isn’t mentioned at all in the other provisions of §315, but rather Congress appears to direct the PTO in how the related proceedings will be treated. See, e.g., §315(a)(1) (“... an [IPR] may not be instituted ...”), §315(b) (“An [IPR] may not be instituted ...”), and §315(e)(1) (once an FWD has issued, the IPR petitioner “may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or could have raised” in the IPR).

Thus, in §315, the PTO’s ability to consider related court proceedings when making the IPR

institution decision is limited to the ministerial application of the guidelines set by Congress in §315. There is no indication of an intention to give the PTO the power to make *its own* substantive rules for considering a related court proceeding when making the IPR institution decision. See *Utility Air Regulatory Group v. EPA*, 573 U.S. 302, 320 (2014) (it is a “fundamental canon of statutory construction that the words of a statute must be read in their context and with a view to their place in the overall statutory scheme.”).

II. Pre-*Thryv* Precedents

A. *Cuozzo* has language which opens the door for §314(d)’s expansion, but that language is best considered dicta

In *Cuozzo*, the patent owner tried to undo a Final Written Decision (FWD) which cancelled his patent claims by attacking the initial decision to grant the IPR petition because the IPR petition wasn’t pled “with particularity” under §312(a)(3). *Cuozzo*, 579 U.S., at 272. In other words, the patent owner attacked “some minor statutory technicality” in the initial paperwork. *Id.* In this respect, *Cuozzo* may be seen as an example of bad facts making bad law—or at least bad facts making unnecessary and overbroad dicta. The patent owner’s argument was weak and would have failed regardless of §314(d)’s statutory bar.

The majority found that: “in light of §314(d)’s own text and the presumption favoring review, ... [§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." *Id.*, at 274-5. *Cuozzo* provides no guidance on which statutes are "related to" the IPR institution decision and how to assess if a question was "closely tied" to those statutes.

The decision/holding in *Cuozzo* is the same when analyzed under the limited scope interpretation that §314(d) primarily shields §314(a). §314(a) recites that its threshold determination is based on "the information presented in the" IPR petition. The patent owner's attack in *Cuozzo* was essentially against "the information presented in" the IPR petition as recited in §314(a), just clothed in the language of §312(a)(3). *Id.*, at 276 ("In this case, *Cuozzo's* claim that *Garmin's* petition was not pleaded "with particularity" under §312 is little more than a challenge to the Patent Office's conclusion, under §314(a), that the 'information presented in the petition' warranted review.").

In other words, to obtain the result in *Cuozzo*, §314(d) does not need to expand to include separate sections/clauses from outside of §314, such as §312(a)(3). A better interpretation is that §314(d)'s scope remains limited to the core "threshold" obviousness determination in §314(a), and the patent owner's attempt to "camouflage" his attack in the words of another statutory section should be rejected as just that—a weak effort to get around §314(d)'s statutory bar.

Accordingly, the broad and vague language in *Cuozzo* expanding §314(d)'s scope to include any "questions that are closely tied to the application and interpretation of statutes related to the Patent

Office’s decision to initiate inter partes review” is best considered dicta unnecessary and separate from its holding. This was the view taken in *Thryv*’s dissent. *Thryv*, 590 U.S., at 59 fn. 6 (“According to the dissent, that statement [in *Cuozzo*] is dicta later repudiated in *SAS Institute*.”).

B. *SAS Institute* modifies *Cuozzo* by expressly limiting §314(d)’s scope to §314(a)’s threshold determination

When first establishing the rules to implement the new IPR proceeding in 2012, the PTO promulgated 37 CFR §42.108(a) which allowed the PTO to institute an IPR on “all or some of the challenged claims” in the IPR petition. In other words, the PTO gave itself the power to institute an IPR on less than all of the claims challenged in the IPR petition—a so-called “partial institution.”

In *SAS Institute*, an unhappy IPR petitioner of a partial institution challenged §42.108(a) on statutory grounds, *i.e.*, because §318(a) states that the PTO “shall issue a [FWD] with respect to **any** patent claim challenged by the petitioner ...” (emphasis added), the PTO, if it institutes an IPR, must review **all** of the claims in the IPR petition. *SAS Institute, Inc. v. Iancu*, 584 U.S. 357, 362 (2018).

In response, the PTO essentially argued the present Federal Circuit/PTO position. Mainly, making such a rule was within the PTO’s discretionary power, regardless of the lack of statutory authority. *SAS Institute*, 584 U.S., at 363-6. In any event, “[e]ven if the statute forbids [its] partial institution practice, the [PTO] suggests [this Court] lack[s] the power to say so.” *Id.*, at 370. The

PTO asserted that *Cuozzo* and §314(d) precluded “judicial review of any legal question bearing on the institution of inter partes review—including whether the statute permits [the PTO’s] ‘partial institution’ practice.” *Id.*

This Court brushed the PTO’s arguments aside and struck down §42.108(a) as an agency action beyond statutory authority. “We find that the plain text of §318(a) supplies a ready answer. ... *any patent claim challenged by the petitioner* ... means that the Board *must* address *every* claim the petitioner has challenged.” *Id.*, at 362-3 (emphasis in original). Regarding the PTO’s supposed discretion, this Court pointed out “[t]he trouble is, nothing in the statute says anything like that.” *Id.*, at 363; see also, *e.g.*, 366 (“... while § 314(a) invests the Director with discretion on the question *whether* to institute review, it doesn’t follow that the statute affords him discretion regarding *what* claims that review will encompass.”) (emphasis in original).

In response to the PTO’s argument about *Cuozzo* and §314(d)’s preclusive scope, this Court effectively modified the holding in *Cuozzo*: “Given the strength of th[e] presumption [in favor of judicial review] and the statute’s text, *Cuozzo* concluded that §314(d) precludes judicial review **only** of the Director’s “initial determination” under §314(a) that “there is a ‘reasonable likelihood’ that the claims are unpatentable on the grounds asserted” and review is therefore justified.” *Id.*, at 370 (emphasis added). Admittedly, *Cuozzo* said more than that,¹⁴ but *SAS Institute’s*

¹⁴ A fact later recognized by the author of this decision:

holding is still an accurate statement of §314(d)'s preclusive scope, and, in terms of judicial restraint, it's better to view any of *Cuozzo*'s statements to the contrary as non-limiting dicta.

In *SAS Institute*, because SAS did “not seek to challenge the Director’s conclusion that [the IPR petition] showed a “reasonable likelihood” of success ...,” but rather contended “that the Director exceeded his statutory authority by limiting the review to fewer than all of the claims SAS challenged,” SAS’s arguments were not barred by §314(d). *Id.*, at 371 (“And nothing in §314(d) or *Cuozzo* withdraws our power to ensure that an [IPR] proceeds in accordance with the law’s demands”). Similarly in the present matter, Intel does not challenge the PTO’s “threshold determination” under §314(a), but rather challenges the PTO’s *Fintiv* rule for considering related court proceedings when making an IPR institution decision, and §314(d) should not bar such a challenge.

[In *Cuozzo*], the Court suggested that §314(d) could preclude review in cases: (1) where a litigant challenges the Director’s reasonable likelihood of success determination under § 314(a), or (2) where a litigant “grounds its claim in a statute closely related to that decision to institute inter partes review.” ... That first path is faithful to the plain language of §314(d). The second appears nowhere in the statute but is, instead, a product of the judicial imagination.

Thryv, 590 U.S. at 75 (Gorsuch, J., dissenting).

III. The Unsupported and Unjustifiable Expansion of 35 U.S.C. §314(d)'s Scope of Preclusion from Judicial Review

A. *Thryv* all but overturns *SAS Institute*, expanding §314(d)'s scope to shield “statutes related to” the IPR institution decision

In *Thryv*, the patent owner had filed a lawsuit in 2001 against the IPR petitioner which was subsequently voluntarily dismissed without prejudice.¹⁵ *Thryv*, 590 U.S., at 49. ***Twelve years later***, the IPR petition was filed, and the patent owner challenged the IPR petition on the basis of §315(b)'s 1-year time limit. *Id.*, at 50; see also 65. The PTO decided §315(b) didn't apply to lawsuits which were dismissed without prejudice, and instituted the IPR proceeding, in which many of the patent claims were cancelled. *Id.* The patent owner appealed, challenging the PTO's decision regarding §315(b)'s time limit. *Id.*

A proper analysis begins with the words of the statute. *Exxon Mobil Corp. v. Allapattah Servs., Inc.*, 545 U.S. 546, 568 (2005) (“the authoritative statement is the statutory text, not the legislative history or any other extrinsic material.”). §315(b), in pertinent part, is reproduced below (emphasis added):

¹⁵ This is a simplification for convenience: the previous lawsuit had been brought by a licensee of the patent owner against a previous incarnation of 1 of the 4 IPR petitioners. See, *e.g.*, *Thryv*, 590 U.S., at 49.

35 U.S.C. 315 – Relation to other proceedings or actions.

...

(b) PATENT OWNER'S ACTION.— An inter partes review may not be instituted if 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. ...

The statute is crystal-clear: once you are warned that a patent owner believes you are infringing their patent (by service of a complaint saying so), you have a year to try to use the alternative IPR proceeding. The implication is also clear: service of the complaint operates as notice to the alleged infringer of the allegation—what happens next in the lawsuit is irrelevant. The PTO has no discretion besides simply ministerially applying §315(b).

The Court in *Thryv* reproduced the text of §315(b), but never performed any analysis of the text. Instead, the substantive analysis in *Thryv* begins “by defining §314(d)’s scope” in order to “determine whether §314(d) precludes judicial review of the agency’s application of §315(b)’s time prescription.” *Thryv*, 590 U.S., at 52. The Court then ruled that: “[w]e need not venture beyond *Cuozzo*’s holding that §314(d) bars review at least of matters “closely tied to the application and interpretation of statutes related to” the institution decision ... for a § 315(b) challenge easily meets that measurement.” *Id.*, at 52.

This is extraordinary. The Court interpreted the wording of *Cuozzo*—***not*** the wording of the statute

itself—as requiring §314(d)’s prohibition be extended to decisions about §315(b). §314(d) is cited, but only in terms of supporting this result. See, *e.g.*, *Thryv*, 590 U.S., at 54 (“Because §315(b) expressly governs institution and nothing more, a contention that a petition fails under § 315(b) is a contention that the agency should have refused ‘to institute an inter partes review,’” citing §314(d)).

Click-to-call argued that §314(d)’s “bar on judicial review applies only to the agency’s threshold determination under §314(d),” as was held in *SAS Institute*. *Id.*, at 56,58. The Court responded that *Cuozzo* held “that the bar extends to challenges grounded in ‘statutes related to’ the institution decision.” *Id.*, at 56. With that, the genie is let out of the bottle, and the PTO is free to argue that anything involved with an IPR institution decision is barred from judicial review ‘because of §314(d).’ See, *e.g.*, *Thryv*, 590 U.S., at 66 (Gorsuch, J., dissenting, joined in most part by Sotomayor, J.)¹⁶ (“So the Board can err; it can even act in defiance of plain congressional limits on its authority. But ... a court can do nothing about it.”)

Concerning the phrase “under this section” in §314(d), the Court argued that if Congress had intended it to be limited to §314(a), it would have written “under subsection (a).” *Thryv*, 590 U.S., at 57. Regarding the contrary holding in *SAS Institute*, the Court responded with some rather formalistic logic distinguishing the two cases because *SAS Institute*

¹⁶ Justice Sotomayor’s joining in the dissent is noted here because of the consistency of Justice Sotomayor’s approach and concerns in both *Cuozzo* and *Thryv*.

challenged “the manner in which the agency’s review ‘proceeds’ once instituted,” whereas Click-to-call challenged “whether the agency should have instituted review at all.” *Id.*, at 58.

The dissent in *Thryv* disclaimed the majority’s holding, and reiterated the finding in *SAS Institute*: “the *only* thing §314(d) insulates from judicial review is “[t]he determination” made “by the Director” “under this section”—that is, a determination discussed *within* §314. Nothing in the statute insulates agency interpretations of other provisions *outside* §314, including those involving §315(b).” *Thryv*, 590 U.S., at 66 (Gorsuch, J., dissenting) (emphasis in original). In the dissent’s view, *stare decisis* required the *Thryv* majority to explicitly overrule *SAS Institute*, but instead the “majority quibbles with a few sentences [about *SAS Institute*] and quietly walks away.” *Id.*, at 76. Because of this, future litigants and lower courts will be left with the question: “Whether [§314(d)] is limited to the §314(a) determination (as *SAS Institute* held and parts of *Cuozzo* suggested) or also reaches to challenges in ‘closely related’ statutes (as other parts of *Cuozzo* suggested and the Court insists today)—who can say?” *Id.*, at 77.

The dissent also noted that §315(b) “stands as an affirmative limit on the agency’s authority, ... like a statute of limitations,” but, unlike §314(a)’s threshold determination, which may “be effectively reviewed both by the Board and courts [if] the case progresses,” the PTO’s §315(b) timeliness determination has now become absolute and unreviewable: “[u]nder *Thryv*’s interpretation, a provision that reads like an affirmative limit on the agency’s authority reduces to

a mere suggestion. No matter how wrong or even purposefully evasive, the Director's assessment of a petition's timeliness is always immune from review." *Id.*, at 68.

B. *Apple v. Vidal*, following *Thryv*, expands §314(d)'s scope to shield instructions/guidance for making the IPR institution decision

In *Apple v. Vidal*,¹⁷ Apple had challenged, under the APA, two precedential PTAB decisions which established the *Fintiv* rule for considering parallel court proceedings when deciding whether to institute an IPR. Those two "decisions, designated as precedential, constitute[d] instructions from the Director regarding how the Board is to exercise the Director's institution discretion." *Apple v. Vidal*, 63 F.4th 1, 4 (Fed. Cir. 2023).

The Federal Circuit made no attempt to identify any statutory authority for promulgating the *Fintiv* rule, but rather found the PTO's power in the fact that Congress did ***not*** say otherwise:

Congress enacted no provision for this scenario that directs the court to stay its case in light of a pending request for IPR or an instituted IPR. Nor did Congress enact a provision prescribing how the Director is to address such an overlapping pending court

¹⁷ This was the present matter's first appeal to the Federal Circuit. See footnote 3 *supra*. There has been a revolving cast in this matter, and the roles of Apple and Vidal have now been taken by Intel and Squires, respectively, in the present appeal.

case in exercising the discretion whether to institute an IPR.

Apple v. Vidal, 63 F.4th, at 4.

An argument for agency power from statutory silence is clearly disfavored after *Loper Bright*. See *Loper Bright*, 630 U.S., at 400 (“Of course, when faced with a statutory ambiguity in such a case, the ambiguity is **not** a delegation to anybody, ...”) (emphasis added); and 401 (“... when the ambiguity is about the scope of an agency’s own power ... [is] ... the occasion in which abdication in favor of the agency is *least* appropriate.”) (emphasis in original).

Moreover, Congress was not silent: to the extent Congress wanted related court proceedings to affect the grant or denial of an IPR petition, Congress spelled it out in §§315(a) and (b). See Sect. I.B(3) *supra*. Congress granted neither the authority nor the discretion for the PTO to create *ab initio* its own rules for considering related court cases when making the IPR institution decision. See Sect. I.B *supra*. Indeed, since Congress explicitly gave the PTO the discretion to consider related **PTO** proceedings when denying an IPR petition in §315(d) and §325(d), the presumption from Congress’s silence must be that Congress did **not** intend to give the PTO the discretion to consider related court proceedings (besides ministerially applying §§315(a)/(b)). See Sect. I.B(2) *supra*.

The Federal Circuit discussed the holdings in *Cuozzo*, *SAS Institute*, and *Thryv*, mostly following the same analysis and interpretation as the *Thryv* majority. *Apple v. Vidal*, 63 F.4th, at 8-10 (citing *Thryv* eight times). In the end, the Federal Circuit did not have to find statutory authority for PTO to

promulgate the *Fintiv* rule because any type of substantive analysis was barred by §314(d): “we conclude the IPR statute’s preclusion of review, as now settled by the Supreme Court based on statutory text, legislative history, and structure, must encompass preclusion of review of the content-focused challenges to the instructions at issue here.” *Id.*, at 10.

IV. *Loper Bright* re-affirms that the Courts cannot Abdicate their Judicial Duty to Interpret Statutes for themselves

Loper Bright overturned *Chevron* because *Chevron* deference interfered with the right to judicial review under the APA. *Loper Bright*, 603 U.S., at 396 (“[t]he deference that *Chevron* requires of courts reviewing agency action cannot be squared with the APA.”); see also, *e.g.*, 398 (“*Chevron* defies the command of the APA that “the reviewing court”—not the agency whose action it reviews—is to “decide all relevant questions of law” and “interpret . . . statutory provisions.””).

As stated above, *Loper Bright* re-affirmed that the courts must independently decide what statutes mean and whether an agency is acting within its statutory authority. *Id.*, at 406-7 (“At best, our intricate *Chevron* doctrine has been nothing more than a distraction from the question that matters: Does the statute authorize the challenged agency action? And at worst, it has required courts to violate the APA by yielding to an agency the express responsibility, vested in “the reviewing *court*,” to “decide all relevant questions of law” and “interpret .

. . statutory provisions.””) (emphasis in original); see also 412 (“Courts must exercise their independent judgment in deciding whether an agency has acted within its statutory authority, as the APA requires”).

Regarding Congressional delegations of discretionary authority, this Court stated:

..., judges need only fulfill their obligations under the APA to independently identify and respect such delegations of authority, police the outer statutory boundaries of those delegations, and ensure that agencies exercise their discretion consistent with the APA. By forcing courts to instead pretend that ambiguities are necessarily delegations, *Chevron* does not prevent judges from making policy. **It prevents them from judging.**

Loper Bright, 603 U.S., at 404 (emphasis added)

Simply put, the present Federal Circuit/PTO absolutist interpretation of §314(d) is preventing the courts from judging.

CONCLUSION

The petition for *certiorari* should be granted.

Respectfully Submitted,

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