

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

REPLY BRIEF FOR PETITIONERS

NATHAN K. KELLEY
ASHURST PERKINS
COIE US LLP
700 Thirteenth Street, NW
Washington, DC 20005

ANDREW DUFRESNE
ASHURST PERKINS
COIE US LLP
33 East Main Street
Madison, WI 53703
Attorneys for Google LLC

MARK C. FLEMING
Counsel of Record
WILMER CUTLER PICKERING
HALE AND DORR LLP
60 State Street
Boston, MA 02109
(617) 526-6000
mark.fleming@wilmerhale.com

MARK D. SELWYN
WILMER CUTLER PICKERING
HALE AND DORR LLP
2600 El Camino Real
Suite 400
Palo Alto, CA 94306
*Attorneys for Intel
Corporation*

ADDITIONAL COUNSEL LISTED ON INSIDE COVER

ALYSON ZUREICK
WILMER CUTLER PICKERING
HALE AND DORR LLP
7 World Trade Center
250 Greenwich Street
New York, NY 10007

JANE E. KESSNER
WILMER CUTLER PICKERING
HALE AND DORR LLP
2100 Pennsylvania Ave., NW
Washington, DC 20037

*Attorneys for Intel
Corporation*

TABLE OF CONTENTS

	Page
TABLE OF AUTHORITIES	ii
INTRODUCTION	1
ARGUMENT.....	2
I. THE DECISION BELOW CONFLICTS WITH DECISIONS OF THIS COURT AND OTHER COURTS	2
II. THE DIRECTOR’S CLAIM OF UNREVIEWABLE DISCRETION CONFIRMS THE NEED FOR REVIEW	6
III. THE QUESTION IS LIVE, IMPORTANT, AND CLEANLY PRESENTED.....	8
CONCLUSION	11

TABLE OF AUTHORITIES

CASES

	Page(s)
<i>American Clinical Laboratory Association v. Azar</i> , 931 F.3d 1195 (D.C. Cir. 2019)	3, 6
<i>Bowen v. Michigan Academy of Family Physicians</i> , 476 U.S. 667 (1986)	2, 3, 4
<i>City of Los Angeles v. Lyons</i> , 461 U.S. 95 (1983)	11
<i>Cuozzo Speed Technologies, LLC v. Lee</i> , 579 U.S. 261 (2016)	3, 4, 5, 7
<i>Department of Homeland Security v. Regents of the University of California</i> , 591 U.S. 1 (2020)	2, 8
<i>Heckler v. Chaney</i> , 470 U.S. 821 (1985).....	8
<i>Loper Bright Enterprises v. Raimondo</i> , 603 U.S. 369 (2024)	4
<i>McNary v. Haitian Refugee Center, Inc.</i> , 498 U.S. 479 (1991)	2, 3
<i>Motor Vehicle Manufacturers Association v. State Farm Mutual Automobile Insurance Company</i> , 463 U.S. 29 (1983).....	8
<i>Mylan Laboratories Ltd. v. Janssen Pharmaceutica, N.V.</i> , 989 F.3d 1375 (Fed. Cir. 2021)	7
<i>NCAA v. Smith</i> , 525 U.S. 459 (1999).....	8
<i>ParkView Medical Associates, L.P. v. Shalala</i> , 158 F.3d 146 (D.C. Cir. 1998)	6

TABLE OF AUTHORITIES—Continued

	Page
<i>SAS Institute, Inc. v. Iancu</i> , 584 U.S. 357 (2018)	1, 5, 6
<i>Summers v. Earth Island Institute</i> , 555 U.S. 488 (2009)	11
<i>Thryv, Inc. v. Click-To-Call Technologies, LP</i> , 590 U.S. 45 (2020)	5
<i>Whitman v. American Trucking Associations</i> , 531 U.S. 457 (2001)	8
<i>Yee v. City of Escondido</i> , 503 U.S. 519 (1992)	7

DOCKETED CASES

<i>Google LLC v. VirtaMove, Corporation</i> , No. 25-1230 (U.S.)	10
---	----

STATUTES, RULES, AND REGULATIONS

5 U.S.C. § 701	8
35 U.S.C.	
§ 314	1, 4, 5
§ 315	7, 8
§ 316	3
§ 325	8
37 C.F.R. § 42.4	9
85 Fed. Reg. 66,502 (Oct. 20, 2020)	9
88 Fed. Reg. 24,503 (Apr. 21, 2023)	9

TABLE OF AUTHORITIES—Continued

	Page
90 Fed. Reg. 48,335 (Oct. 17, 2025).....	9

OTHER AUTHORITIES

<i>Oversight of the United States Patent and Trademark Office: Hearing Before the Subcomm. on Intellectual Property of the Senate Committee on the Judiciary, 119th Cong. (Sept. 29, 2026).....</i>	9
---	---

INTRODUCTION

The decision below gives the PTO unfettered power to adopt rules without risk or fear of judicial scrutiny. Unless this Court grants certiorari, no court will be able to consider whether the *Fintiv* rule, the parallel-litigation rule the PTO has proposed, or any other standard governing institution of inter partes review is contrary to statute—no matter how arbitrary, unlawful, or pernicious the agency’s rule might be.

The Director cannot reconcile that result with the text of 35 U.S.C. § 314(d), which bars review only of “[t]he determination by the [PTO] Director whether to institute an inter partes review.” As the Federal Circuit recognized, this case “does not involve a petition-specific challenge.” Pet. App. 72a. And this Court has repeatedly held that statutes barring review of specific agency decisions do not bar review of the rules governing them.

The Director wishes to expand § 314(d) to bar any challenge “closely tied” to statutes “related to” institution. Opp. 14-15. But this Court rejected that argument in *SAS Institute, Inc. v. Iancu*, when the Director tried to read § 314(d) as “foreclosing judicial review of any legal question bearing on the institution of inter partes review,” 584 U.S. 357, 370-371 (2018). The Director’s efforts to distinguish petitioners’ cases all assume his own disputed conclusion: that the America Invents Act (AIA) gives him unreviewable discretion to deny institution for any reason. He identifies no statutory text conferring that power, and this Court has never ruled that Congress implicitly granted him such broad discretion.

None of the Director’s remaining arguments justifies denying certiorari. Although he emphasizes that his

“current” practice is to decide institution himself, Opp. 24-25, he does not contend that this case is moot, and the Federal Circuit held, with his agreement, that it is not. Pet. App. 9a. *NHK* and *Fintiv*, meanwhile, “currently remain on the books.” Opp. 25. The PTO’s rulemaking efforts, which are now in their seventh inconclusive year, are no reason to wait longer. And the district court found that petitioners have standing—a conclusion neither the Federal Circuit nor the Director gives cause to doubt. Lastly, the agency’s adoption of new institution standards, each shielded from review by the decision below, makes review more urgent, not less.

ARGUMENT

I. THE DECISION BELOW CONFLICTS WITH DECISIONS OF THIS COURT AND OTHER COURTS

This Court has long held that statutes barring review of specific agency actions do not bar review of agency standards governing those actions. Pet. 14-19. In *Bowen v. Michigan Academy of Family Physicians*, 476 U.S. 667, 675 (1986), a bar on review of benefit-amount determinations “d[id] not speak to challenges mounted against the method by which such amounts are to be determined rather than the determinations themselves.” In *McNary v. Haitian Refugee Center, Inc.*, 498 U.S. 479, 492 (1991), a bar on review of “a determination respecting an application” described “a single act rather than a group of decisions or a practice or procedure employed in making decisions.” And in *Department of Homeland Security v. Regents of the University of California*, 591 U.S. 1, 19 (2020), a bar on review of immigration removal proceedings was “certainly not a bar where ... the parties [were] not challenging any removal proceedings.” Section 314(d), which bars review

only of “[t]he determination ... whether to institute an inter partes review,” is indistinguishable.

The Director responds that those decisions turned on the “text, structure, and purpose” of the statutes at issue. Opp. 17. That does not help the Director, because the text, structure, and purpose of § 314(d) point the same way as the statutes in *Bowen* and other cases. Pet. 15-18. Section 314(d)’s judicial-review bar reaches only “[t]he determination” whether to institute “an” inter partes review, which is “a single act.” *McNary*, 498 U.S. at 492. The AIA separately directs the Director to “prescribe regulations ... establishing and governing inter partes review ... and the relationship of such review to other proceedings,” 35 U.S.C. § 316(a)(4), and nothing in § 314(d) immunizes those rules from review. This Court has described § 314(d)’s purpose as preventing a final written decision from being “unwound under some minor statutory technicality related to [the] preliminary decision to institute.” *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 272 (2016). Prospective challenges to institution rules that are arbitrary, capricious, and contrary to statute do not qualify.

The Director separately attempts to distinguish *Bowen* because there is supposedly no “evidence of congressional intent to allow review of the Director’s guidance regarding factors his delegatee should consider,” Opp. 18, and *American Clinical Laboratory Ass’n v. Azar*, 931 F.3d 1195 (D.C. Cir. 2019), because “nothing in the AIA speaks to the discretionary criteria the USPTO should apply in making institution decisions,” Opp. 24. The first inverts the presumption of reviewability, which requires “clear and convincing evidence” to preclude judicial review, not evidence to permit it. *Bowen*, 476 U.S. at 681. And both presume the

Director’s desired conclusion that he is free to deny institution for any reason—the very disputed conclusion the Federal Circuit reached and that warrants this Court’s review. Pet. 22-26. As the petition explains (at 25), § 314(a) does not grant the Director unreviewable authority to bypass the AIA. Rather, courts must “police the outer statutory boundaries” of the Director’s ability to deny meritorious IPR petitions. *See Loper Bright Enters. v. Raimondo*, 603 U.S. 369, 404 (2024).

The Director offers the non sequitur that because Congress expected him to delegate institution decisions to the Board, his instructions to the Board must be as unreviewable as his own decisions. Opp. 15-17. Again, the Director is incorrect. In *Bowen*, Congress “delegated” the unreviewable determinations to carriers acting “in conformity with the regulations and instructions of the Secretary,” yet “challenges to the validity of the Secretary’s instructions and regulations” were “not impliedly insulated from judicial review.” 476 U.S. at 678. Nor do petitioners ask courts to “probe the Director’s thought processes,” Opp. 16, or make reviewability “turn arbitrarily on differences in internal decision-making procedures,” Opp. 17. Petitioners challenge established rules. The line petitioners draw is the same one § 314(d)’s text draws: between a challenge to an individual “determination” and a challenge to rules governing all determinations.

The court of appeals’ decision also conflicts with this Court’s decisions applying § 314(d) itself. Taking *Cuozzo*’s language out of context, the Director argues that § 314(d) bars any challenge raising questions “closely tied to the application and interpretation of statutes related to the Patent Office’s decision to initiate inter partes review.” Opp. 14 (quoting *Cuozzo*, 579 U.S. at 274-275). But *Cuozzo* explained that § 314(d) “applies

where *the grounds for attacking the decision to institute inter partes review* consist of questions that are closely tied” to institution-related statutes. 579 U.S. at 274-275 (emphasis added). And *Thryv* similarly rejected an attack on a specific decision to institute, holding that “a party generally cannot contend on appeal that the agency should have refused ‘to institute an inter partes review.’” *Thryv, Inc. v. Click-To-Call Techs., LP*, 590 U.S. 45, 52 (2020). Neither case extended § 314(d) to suits like this one, which do not challenge an institution decision. Pet. App. 72a.

The Director invokes “the ‘congressional expectation’ that the Director might delegate the institution decision” (Opp. 15 (quoting Pet. App. 72a)), but that does not change the fact that *Cuozzo* and *Thryv* were patent owners’ efforts to challenge particular decisions to grant institution. Pet. 21, 25. Neither involved a challenge to rules governing institution, and neither considered the scope of the Director’s authority to deny it. Any broader statements about the Director’s discretion were, at most, dicta. Pet. 25; *see infra* Section II.

SAS Institute, Inc. v. Iancu confirms as much. This Court held that the Director’s reading of § 314(d) “overreads both the statute and our precedent,” § 314(d) does not “enable the agency to act outside its statutory limits,” and a party that believes the PTO has exceeded “its statutory bounds” may obtain “judicial review ... consistent with the Administrative Procedure Act.” 584 U.S. 357, 370-371 (2018) (quoting *Cuozzo*, 579 U.S. at 275). The Director (Opp. 17) repeats the Federal Circuit’s characterization of *SAS* as addressing only how review “proceeds” once instituted. But the Court unquestionably construed institution-related provisions in ruling that the Director could not “institute[] review on only some” challenged patent claims “and den[y] review

on the rest,” 584 U.S. at 362; *see* Pet. 19-21. Under the Federal Circuit’s rule that § 314(d) bars “any challenge ... where the invoked provisions of law directly govern institution,” Pet. App. 70a, *SAS* would have come out the other way.

The Federal Circuit’s decision also conflicts with decisions of other courts of appeals. Pet. 18-19. The D.C. Circuit has held that a bar on review of “the establishment of payment amounts” did not reach a rule governing “the data collection practices that precede and inform the setting of those amounts.” *American Clinical Lab.*, 931 F.3d at 1204-1205. It has also held that a bar on review of individual denials “leaves hospitals free to challenge the general rules leading to denial.” *ParkView Med. Assocs., L.P. v. Shalala*, 158 F.3d 146, 148 (D.C. Cir. 1998). The Director’s complaint that the D.C. Circuit reached that decision without “textual or structural analysis,” Opp. 24, does not deny a conflict in circuit precedent; it means simply that the government prefers the Federal Circuit’s approach to the D.C. Circuit’s. That is exactly when this Court’s review is needed.

II. THE DIRECTOR’S CLAIM OF UNREVIEWABLE DISCRETION CONFIRMS THE NEED FOR REVIEW

Many of the Director’s arguments rest on his assumption that the AIA gives him unreviewable discretion to deny institution. Opp. 18-23. Besides being wrong, that is exactly the issue this Court should consider on certiorari.

As an initial matter, the Director asserts that petitioners challenge that premise “[f]or the first time in this litigation.” Opp. 21. But he does not argue forfeiture, and for good reason. Petitioners have contended from the outset that the AIA forbids the Director from denying timely petitions based on parallel litigation. C.A.J.A.

1144-1146; Pet. App. 69a. “Once a federal claim is properly presented, a party can make any argument in support of that claim; parties are not limited to the precise arguments they made below.” *Yee v. City of Escondido*, 503 U.S. 519, 534 (1992). Moreover, the Federal Circuit’s published precedent resolved this question against petitioners. *Mylan Labs. Ltd. v. Janssen Pharmaceutica, N.V.*, 989 F.3d 1375, 1382 (Fed. Cir. 2021) (holding that the Director “is permitted, but never compelled, to institute an IPR”). Raising the point earlier would have been futile.

On the merits, the Director identifies no statutory text granting him the power to deny institution on any ground he chooses. He relies instead on statutory silence, invoking the Federal Circuit’s observation that the AIA “uses no language commanding institution.” Opp. 20 (quoting Pet. App. 59a). He also invokes language from *Cuozzo*, *Thryv*, and *Arthrex*, which he says support a “necessary implication.” Opp. 21-22. But he does not deny that those cases did not concern the scope of the Director’s authority to deny institution: *Cuozzo* and *Thryv* involved patent owners’ challenges to specific decisions instituting IPR, and *Arthrex* involved the Appointments Clause. Pet. 22 & n.5, 25. *Cuozzo*’s statement that denial is “committed to the Patent Office’s discretion” was offered in response to the dissent’s superfluity assertion, and its reference to “no mandate to institute review” described § 314(a), not the AIA as a whole. 579 U.S. at 273; *contra* Opp. 21. Justice Alito, though agreeing that “one can infer” discretion, cautioned that “the law does not say so directly.” 579 U.S. at 294 (opinion concurring in part and dissenting in part).

Congress specified when IPR may and may not proceed alongside infringement litigation, 35 U.S.C. § 315(a)-(b), and granted express but limited discretion

elsewhere, *id.* §§ 315(c), 325(d). Pet. 24-25. This Court has never decided whether Congress, by mere implication, also gave the Director power to override those judgments. Congress “does not, one might say, hide elephants in mouseholes.” *Whitman v. American Trucking Ass’n*, 531 U.S. 457, 468 (2001).

The same reasoning disposes of the Director’s alternative argument under 5 U.S.C. § 701(a)(2). Opp. 18-21. The Federal Circuit did not reach it, Pet. App. 73a-74a n.6, and this Court does “not decide in the first instance issues not decided below,” *NCAA v. Smith*, 525 U.S. 459, 470 (1999). In any event, § 701(a)(2) does not commit anything to agency discretion. It applies only where some other “law” does, and this Court reads it “quite narrowly.” *Regents*, 591 U.S. at 17. The only “law” the Director purports to identify is the AIA’s silence. Opp. 19-20. And petitioners’ objection is not merely that the *Fin-tiv* rule yields “too many denials,” Opp. 20 (quoting Pet. App. 58a); it is that the rule relies on factors Congress foreclosed, *see* 35 U.S.C. § 315(b), and is arbitrary and capricious. Courts routinely decide whether an agency “has relied on factors which Congress has not intended it to consider.” *Motor Vehicle Mfrs. Ass’n v. State Farm Mut. Auto. Ins. Co.*, 463 U.S. 29, 43 (1983). And *Heckler v. Chaney*, 470 U.S. 821 (1985), concerned an agency’s refusal to take enforcement actions requested by particular petitioners, *id.* at 823-825. Institution is not enforcement; it is the threshold of an adjudicative process that a private party initiates and that Congress structured in detail. Pet. 23-24.

III. THE QUESTION IS LIVE, IMPORTANT, AND CLEANLY PRESENTED

Though noting that he now makes institution decisions himself (Opp. 24), the Director does not and cannot

argue mootness. The Federal Circuit held, with his agreement, that his October 2025 announcements “leave the dispute here a live one.” Pet. App. 9a. As the Director told the Federal Circuit, “if PTAB panels were to again exercise the Director’s discretion to institute, *NHK* and *Fintiv* would remain precedent.” C.A. Dkt. 104, at 1-2 (Jan. 2, 2026); *see* Pet. App. 9a-10a. The Director thus repeatedly refers to his “current” practice, Opp. 11-12, 16, 24-25; acknowledges that the regulation granting the Board institution authority remains in force, Opp. 24 (citing 37 C.F.R. § 42.4(a)); and concedes that *NHK* and *Fintiv* “currently remain on the books,” Opp. 25. The Director ventures that he “may de-designate them ... at any time,” *id.*, but does not say he will. Indeed, the Director recently told the Senate that he is “considering” a plan to return the merits portion of institution decisions to the Board. *Oversight of the United States Patent and Trademark Office: Hearing Before the Subcomm. on Intellectual Property of the S. Comm. on the Judiciary*, 119th Cong. (Sept. 29, 2026). A “current” process the Director can change at will is no reason to deny review; that will remain true even should the Director de-designate the decisions during these proceedings.

Nor does the pending rulemaking diminish the need for review. The PTO first solicited comments on institution standards a remarkable six years ago, 85 Fed. Reg. 66,502 (Oct. 20, 2020); issued an advance notice in 2023, 88 Fed. Reg. 24,503 (Apr. 21, 2023); and proposed a parallel-litigation rule a year ago, 90 Fed. Reg. 48,335 (Oct. 17, 2025). The comment period on that proposal closed in December 2025, yet the agency “has not yet issued a final rule.” Opp. 12. If protracted and inconclusive rulemaking procedures sufficed to defeat review,

any agency could insulate binding standards from judicial scrutiny by proposing a rule and never finalizing it.

The Director invokes prior denials of certiorari, but he acknowledges that those petitions “challenged individual decisions in which the Board declined to institute inter partes reviews.” Opp. 12-13.¹ And the earlier petition in this case was interlocutory. Pet. 33-34. By contrast, this petition arises from a final judgment and squarely presents the question whether § 314(d) bars review of institution rules when no institution decision is challenged.

Finally, the Director “questions” petitioners’ standing (Opp. 25), without acknowledging that the district court held that all plaintiffs, including petitioners, have standing: Their injury “is not that they were denied IPR, but that the Director is using unlawful considerations that increase the risk of denial, thereby depriving them of the benefits of IPR.” Pet. App. 91a-92a. It also held that enjoining the rule “would redress the Plaintiffs’ injuries.” Pet. App. 93a.

The Federal Circuit did not disturb those holdings; it addressed Apple alone only to avoid “aggregating the plaintiffs’ asserted threatened harms.” Pet. App. 77a. While that court applied a “relaxed” redressability standard to the procedural claim, Opp. 26 (quoting Pet. App. 78a), its injury holding did not depend on it. The court found that Apple, a “repeat player” regularly sued for infringement that then petitions for IPR, faces “a substantial risk that the harm will occur” and that the injury “is concrete and legally protected, because of

¹ The same is true of *Google LLC v. VirtaMove, Corp.*, No. 25-1230 (U.S. Oct. 19, 2026), which arose from a petition for mandamus challenging denial of institution of particular IPR petitions.

the infringement suit.” Pet. App. 79a-80a. The same is true of Intel and Google, which also face repeated infringement suits, petition for IPR of asserted patents, and have had petitions denied under *NHK* and *Fintiv*. C.A.J.A. 1140-1143; *see* Opp. 7. That concrete interest distinguishes a bare “deprivation of a procedural right,” *Summers v. Earth Island Inst.*, 555 U.S. 488, 496 (2009). Nor is the risk of future denials speculative. Opp. 26-27. Petitioners face an institution rule that the agency has repeatedly applied to deny their petitions and that, as the Director concedes, “remain[s] on the books.” Opp. 25; *see City of Los Angeles v. Lyons*, 461 U.S. 95, 102 (1983) (“Past wrongs” are “evidence bearing on ‘whether there is a real and immediate threat of repeated injury.’”).

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted.

NATHAN K. KELLEY
ASHURST PERKINS
COIE US LLP
700 Thirteenth Street, NW
Washington, DC 20005

ANDREW DUFRESNE
ASHURST PERKINS
COIE US LLP
33 East Main Street
Madison, WI 53703

Attorneys for Google LLC

MARK C. FLEMING
Counsel of Record
WILMER CUTLER PICKERING
HALE AND DORR LLP
60 State Street
Boston, MA 02109
(617) 526-6000
mark.fleming@wilmerhale.com

MARK D. SELWYN
WILMER CUTLER PICKERING
HALE AND DORR LLP
2600 El Camino Real
Suite 400
Palo Alto, CA 94306

ALYSON ZUREICK
WILMER CUTLER PICKERING
HALE AND DORR LLP
7 World Trade Center
250 Greenwich Street
New York, NY 10007

JANE E. KESSNER
WILMER CUTLER PICKERING
HALE AND DORR LLP
2100 Pennsylvania Ave., NW
Washington, DC 20037

*Attorneys for Intel
Corporation*

OCTOBER 2026