

No. 2019-1342

**United States Court Of Appeals
for the Federal Circuit**

KINGSTON TECHNOLOGY COMPANY, INC.,
Appellant,

v.

SPEX TECHNOLOGIES, INC.,
Appellee.

APPEAL FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE,
PATENT TRIAL AND APPEAL BOARD IN INTER PARTES REVIEW NO. IPR2018-01002

**COMBINED PETITION FOR PANEL REHEARING
AND REHEARING EN BANC**

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September 18, 2019

CERTIFICATE OF INTEREST

1. The full name of every party represented by me is: Kingston Technology Company, Inc.
2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is: None.
3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party represented by me are: Kingston Technology Corporation.
4. The names of all law firms and the partners or associates that appeared for the party now represented by me in the trial court or agency or are expected to appear in this Court (and who have not entered an appearance in this Court) are: Law Offices of S.J. Christine Yang; Christine Yang, Martha Hopkins.
5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal: Kingston Technology Company, Inc. v. SPEX Technologies Inc., CAFC Case No. 19-1256; SPEX Technologies Inc. v. Kingston Technology Corp., et al., CACD Case No. 8:16-CV-01790 JVS (ARGx); SPEX Technologies Inc. v. Western Digital Corp., et al., CACD Case No. 8:16-CV-01799 JVS (ARGx); SPEX Technologies Inc. v. Toshiba America Electronics Components, Inc., et al., CACD Case No. 8:16-CV-01800 JVS (ARGx); SPEX Technologies Inc. v. Apricorn, CACD Case No. 2:16-CV-07349 JVS (ARGx).

Dated: September 18, 2019

/s/ Oliver J. Richards

Oliver J. Richards

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STATEMENT OF COUNSEL

Based on my professional judgment, I believe this appeal requires an answer to one or more precedent-setting questions of exceptional importance:

1. Whether this Court must interpret and apply the words “under this section” as used in the No-Appeal bar, 35 U.S.C. § 314(d), without regard to whether appeal is taken by a patent owner or by a petitioner.

2. Whether this Court must evaluate the Board’s decision on the basis of what the Board did as opposed to what the Board could have done, as mandated by binding Supreme Court law.

3. Whether and to what extent this Court’s *en banc* decision in *Wi-Fi One, LLC v. Broadcom Corp.*, 878 F.3d 1364 (Fed. Cir. 2018), which held that decisions not made “under this section” do not fall within the scope of the No-Appeal bar, overruled prior panel decisions of this Court holding that non-institution decisions not made “under this section” do fall within the scope of the No-Appeal bar, *see, e.g., St. Jude Med., Cardiology Div., Inc. v. Volcano Corp.*, 749 F.3d 1373 (Fed. Cir. 2014).

Based on my professional judgment, I believe the panel decision is contrary to this Court’s *en banc* decision in *Wi-Fi One, LLC v. Broadcom Corp.*, 878 F.3d 1364 (Fed. Cir. 2018); the Supreme Court decision from which that decision stems, *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131 (2016); and this Court’s decision in *Arthrex, Inc. v. Smith & Nephew, Inc.*, 880 F.3d 1345 (Fed. Cir. 2018). I also believe that the panel decision is contrary to the rule that agency decisions should be reviewed on the basis

set out by the agency rather than what an agency could have decided, as set forth by the Supreme Court in decisions such as *Burlington Truck Lines, Inc. v. United States*, 371 U.S. 156, 169 (1962) and *Sec. & Exch. Comm'n v. Chenery Corp.*, 332 U.S. 194, 196 (1947).

Lastly, underlying the importance of the questions raised above, I note that various panels of this Court are or likely will be confronting the same or similar issues in other cases pending before this Court, including at least *Ventex Co., Ltd. v. Columbia Sportswear*, Case No. 19-1705 and *Apple Inc. v. IXI IP, LLC*, Case No. 19-2250; and that the Supreme Court will be addressing the scope of the No-Appeal bar in *Thryv, Inc. v. Click-To-Call Technologies, LP*, Case No. 18-916.

/s/ Oliver J. Richards

Oliver J. Richards

*Attorney for Appellant,
Kingston Technology Company, Inc.*

INTRODUCTION

This case raises important questions regarding the “No Appeal” provision for IPR institution decisions in 35 U.S.C. § 314(d). This Court held *en banc* in *WiFi One* that the “natural reading” of the phrase “under this section” contained in this provision “limits the reach of § 314(d) to the determination by the Director whether to institute IPR as set forth in § 314.” Thus, under *WiFi One*, the Director’s preliminary merits evaluation and “closely related” determinations are not appealable, but determinations that “ha[ve] nothing to do with the patentability merits or discretion not to institute,” *e.g.*, decisions relating to the agency’s power to act under section 315, are not made “under this section” and are thus appealable.

The panel decision that dismissed this appeal makes *WiFi One* apply only when the Board errs in a petitioner’s favor, but not when the Board errs in a patent owner’s favor. The decision on appeal has nothing to do with the merits of Kingston’s petition or any exercise of discretion by the Board. Rather, the Board concluded it was powerless to hear Kingston’s IPR because, in its view, § 315(e) estopped Kingston from bringing a petition for IPR. Had the Board decided in Kingston’s favor and against the patent owner, *Wi-Fi One* holds that the patent owner could have challenged that determination because it is *not* made “under this section.” Yet the panel decided that *Wi-Fi One* apparently did not apply because the Director decided in favor of the patent owner and against the petitioner. In essence, the panel decided

that the phrase “under this section” has a different meaning depending on *who* appeals.

Congress made no such distinction in the statute, and *WiFi One*—which rested on a conclusion that Section 314(d)’s “[no appeal] under this section” language is limited to patentability determinations—does not permit it. Indeed, despite Kingston’s jurisdictional argument resting almost entirely on this Court’s *Wi-Fi One* decision and its interpretation of section 314(d), the panel did not mention *Wi-Fi One* once. This absence is conspicuous and telling. The analysis that led to *WiFi One* leaves no room for the “under this section” language to apply for some appellants but not others.

As such, this Court should act *en banc* to ensure that *WiFi One*’s interpretation of the No-Appeal provision is faithfully followed by panels of this Court and to address how that holding applies to appeals brought by petitioners rather than patent owners.

RELEVANT BACKGROUND

Kingston's appeals from a Board decision dismissing an IPR petition based solely on the fact that Kingston previously brought another IPR, *see* 35 U.S.C. § 315(e)(2). (*See generally* D.I. 9, Exhibit A.) Kingston's response to the motion panel's Order to Show Cause describes in detail the procedural posture at the Board. (*See* D.I. 9, at 2–7.) What matters now, though, is that the Board's decision finally resolved Kingston's IPR petition not based on the merits or on any purported exercise of discretion. (*See id.* at 5–9.) Rather, the Board thought Section 315(e)(2) took away its ability to hear the petition because of Kingston's prior IPR. (*See id.*)

After Kingston appealed, the motions panel issued an Order to Show Cause, directing Kingston to explain “why this appeal should not be dismissed for lack of jurisdiction.” (D.I. 6.) The panel asked Kingston to address the No-Appeal provision of Section 314(d), and cases applying the No-Appeal provision before the *Wi-Fi One* decision. (*See* D.I. 6.)

Kingston's February 19, 2019, response explained that under well-established and long-standing Supreme Court precedent, parties should be able to seek judicial review of adverse agency determinations absent an explicit and express Congressional intent to the contrary. (*See* D.I. 9, at 9 (citing, for example, *Mach Mining, LLC v. E.E.O.C.*, 135 S. Ct. 1645, 1651 (2015).) Kingston also noted that this Court had repeatedly recognized this strong presumption, including recognizing that 28 U.S.C. § 1295(a)(4)(A) gives this Court jurisdiction over appeals from adverse final Board

decisions in IPRs, without restricting that jurisdiction to only Final Written Decisions. (*See id.* at 9–11 (citing *Arthrex, Inc. v. Smith & Nephew, Inc.*, 880 F.3d 1345, 1348 (Fed. Cir. 2018))).

Kingston’s response also directly addressed the No-Appeal provision. (*See* D.I. 9 at 12–17.) As Kingston explained, and as this Court expressly held in *Wi-Fi One*, the “under this section” language “limits the reach of § 314(d) to the determination by the Director whether to institute IPR as set forth in § 314.” (*See id.* at 12 (citing and quoting *Wi-Fi One*, 878 F.3d at 1372).) The decision on appeal is not a determination made “under this section” because it has nothing to do with the patentability merits or discretion to institute, but rather turned on the Board’s determination that Kingston was estopped. (*See id.*)

Lastly, Kingston warned that drawing a distinction between appeals brought by patent owners and appeals brought by petitioners “would set up an untenable situation where only a patent owner has the ability to challenge a Board determination under section 315 ...” (*Id.* at 14–15.)

Almost six months later, the panel dismissed Kingston’s appeal for lack of jurisdiction. (*See* D.I. 12 (“Order”).) The panel held¹ that because the Board’s

¹ This Court’s order also addressed another appeal filed by Kingston, seeking review of the Board’s decision to dismiss the IPR Kingston sought to join by filing the petition that is the subject of this appeal. (*See* D.I. 12, at 3, 12–13); *see also* *Kingston Technology Co. v. SPEX Technologies*, Case No. 19-1599. Kingston did not seek

decision was, in essence, a decision not to institute review, § 314(d) barred the appeal. (*See id.* at 4–5.) Notably, though, the panel opinion makes no mention of *Wi-Fi One* or its interpretation of that provision. Instead, the panel seized on a distinction between “review of the Director’s decision not to institute review proceedings . . . and the Board’s review and conduct after institution,” focusing on the “final and non-appealable” language of § 314(d) but ignoring the “under this section” language that was the linchpin in *Wi-Fi One*. (*See id.* at 2.) “In drawing that distinction,” the panel explained, this Court “ha[s] consistently resisted limiting § 314(d)’s bar on appellate review to the denial of a petition for failure to establish a reasonable likelihood of success”—ignoring *Wi-Fi One*’s clear holding that the phrase “under this section” “limits the reach of § 314(d) to the determination by the Director whether to institute IPR as set forth in § 314,” *i.e.*, § 314(a) which sets the threshold merits determination. (*See Order at 4*); *see also Wi-Fi One*, 878 F.3d at 1372.

Because the panel’s decision bars petitioners from seeking review of this Court where patent owners may do so, Kingston now petitions this Court to vacate the panel’s opinion and address the important questions raised in the present petition *en banc*.

rehearing in that appeal, and this Court issued its mandate on September 10, 2019, thus the issues surrounding that appeal have no bearing on the present petition.

ARGUMENT

I. The Court Has Jurisdiction To Hear This Appeal

A. The Court’s En Banc *Wi-Fi One* Decision Unambiguously Holds That Section 314(d) Is Limited To Determinations Made “Under” Section 314, Regardless Of When Those Determinations Are Made Or Who Appeals Them

The panel’s decision in this case is contrary to the unambiguous reasoning of *Wi-Fi One*. *Wi-Fi One* interprets the text of the No-Appeal provision governing IPR, and holds that the phrase “under this section” “limits the reach of § 314(d) to” determinations “closely related” to the threshold patentability merits determination. *Wi-Fi One*, 878 F.3d at 1372–74. In contrast, section 314(d) does not bar this Court’s review of determinations made by the Board “unrelated to the Director’s preliminary patentability assessment or the Director’s discretion not to initiate an IPR even if the threshold ‘reasonable likelihood’ is present.” *Wi-Fi One*, 878 F.3d at 1373. This holding, as this Court recognized, follows directly from Supreme Court’s *Cuozzo* decision which “strongly point[ed] toward unreviewability being limited to the Director’s determinations closely related to the preliminary patentability determination or the exercise of discretion not to institute.” *Id.* (citing and discussing *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131 (2016)).

Notably, nothing in *Wi-Fi One* limits its holding to only determinations made by the Board in Final Written Decisions. This Court explained that determinations that were not made “under this section” should still be reviewable by this Court, even

if those decisions are “decided fully and finally at the institution stage.” *See Wi-Fi One*, 878 F.3d at 1373. Indeed, in *Wi-Fi One*’s IPR, the issue the Court decided was reviewable (whether the petitioner was time-barred) was decided entirely at the institution stage of the proceeding. *See Wi-Fi One, LLC v. Broadcom Corp.*, 837 F.3d 1329, 1332 (Fed. Cir. 2016) (summarizing the procedural history of the IPR) (vacated and abrogated by this Court’s *en banc* decision). Thus, according to *Wi-Fi One*, a determination made by the Director not “under this section” is still reviewable by this Court, even if that determination is made at the institution stage and never mentioned again.

Yet, in the present appeal, the panel held that because the determination made by the Director was made at institution, § 314(d) precluded review. How the panel squared this decision with the clear holding of *Wi-Fi* is unclear, as the panel never mentioned *Wi-Fi One* in its decision. The result, however, is clear. Following the panel’s decision in this case, while a patent owner who loses on an issue fully and finally decided at institution may raise that issue on appeal (provided it is not a determination made “under this section”), a petitioner who loses at institution cannot.

Nothing in *Wi-Fi One* nor in the statute’s text makes the phrase “under this section” a part-time provision depending on the identity of the party appealing. Rather, *Wi-Fi One* turned entirely on the type of determination made by the Director. If the determination is made “under this section,” *i.e.*, a determination closely related to the Director’s preliminary determination regarding likelihood of success, it falls

within § 314(d) and is thus unreviewable. *Wi-Fi One*, 878 F.3d at 1372. If the determination is not made “under this section,” *i.e.*, is “unrelated to the Director’s preliminary patentability assessment or the Director’s discretion not to initiate an IPR,” the determination is reviewable. *Id.* Thus whether a determination is reviewable, according to the statute’s text as interpreted by *Wi-Fi One*, turns on whether the determination is made “under this section” and not who appeals that determination.

Even if policy reasons justify making “under this section” a part-time provision (such as a desire to review only where the Board exceeds its authority), this Court may not “substitute [its] view of . . . policy” for the text of legislation “which has been passed by Congress.” *Florida Dept. of Revenue v. Piccadilly Cafeterias, Inc.*, 554 U.S. 33, 52 (2008); *see also Pac. Operators Offshore, LLP v. Valladolid*, 565 U.S. 207, 220 (2012) (holding that “policy concerns cannot justify an interpretation” of a statute “that is inconsistent with the text”); *Barnhart v. Sigmon Coal Co.*, 534 U.S. 438, 462 (2002) (“We will not alter the text in order to satisfy [] policy preferences”). Indeed, underlying the folly of allowing policy to control over text, there are serious concerns regarding the fundamental unfairness of an approach that would allow a patent owner to seek judicial review of a determination but would prohibit a petitioner from seeking judicial review of the exact same type of determination. Rather what controls here is the text of the statute as interpreted by this Court—text that must have the same meaning regardless of the identity of the appellant.

B. This Court Must Consider What The Board Did, Not What The Board Could Have Done

In reaching its determination, the panel appears to suggest that review of the Board's decision (which unquestionably did not turn on an exercise of discretion) is unreviewable because the Board *could* have denied institution on other grounds. *See* Order at 4–5 (citing *Saint Regis Mohawk Tribe v. Mylan Pharm. Inc.*, 896 F.3d 1322, 1327 (Fed. Cir. 2018)). As an initial matter, *Saint Regis* did not address this Court's jurisdiction, nor did it hold that this Court could ignore what the Board did decide in a decision in favor of what the Board might have done. Rather, *Saint Regis* simply noted the unremarkable proposition that the Director may exercise his discretion to deny institution even if the Director determines that the threshold determination set forth in § 314(a) is met. *See Saint Regis Mohawk Tribe*, 896 F.3d at 1327.

That's not what the Director did here. Long-standing Supreme Court precedent dictates that “it is a simple but fundamental rule of administrative law . . . that a reviewing court, in dealing with a determination or judgment which an administrative agency alone is authorized to make, must judge the propriety of such action solely by the grounds invoked by the agency.” *Burlington Truck Lines, Inc. v. United States*, 371 U.S. 156, 169 (1962); *see also Sec. & Exch. Comm'n v. Chenery Corp.*, 332 U.S. 194, 196 (1947) (holding same). Thus, this Court cannot ignore that a Board determination is not a determination made “under this section” simply because the Board may have reached the same result by making a different determination.

The need for this Court to exercise review based on what the Board actually decided here is particularly acute, because the Board’s decision turns on whether the Board has the power to hear Kingston’s petition. As this Court has repeatedly found, such a determination is far different than the ordinary preliminary merits determination normally insulated from judicial review. *Wi-Fi One*, 878 F.3d at 1373 (distinguishing between “preliminary-only merits determinations for which unreviewability is common in the law” with determinations relating to the “Director’s authority to institute IPR”). Indeed, according to traditional legal principles, “[a]n agency may not finally decide the limits of its statutory power.” *See Soc. Sec. Bd. v. Nierotko*, 327 U.S. 358, 369 (1946); *see also SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359 (holding “nothing in § 314(d) or *Cuozzo* withdraws our power to ensure that an *inter partes* review proceeds in accordance with the law’s demands”). To the contrary, that is a judicial function—a function that this Court must not abdicate. *See id.*

C. *Wi-Fi One* And Other Recent Decisions Are Irreconcilably Inconsistent With This Court’s Pre-*Wi-Fi One* Decisions, Including *St. Jude*

Lastly, the panel’s reliance on this Court’s pre-*Wi-Fi One* decision in *St. Jude Medical, Cardiology Division, Inc. v. Volcano Corp.*, 749 F.3d 1373 (Fed. Cir. 2014), is misplaced because the reasoning for that decision is irreconcilably inconsistent with this Court’s holding in *Wi-Fi One* and other binding precedent.

The *St. Jude* panel gave two reasons for its result: (a) § 319 explains how to appeal from a Final Written Decision but does not mention appeal from an Initial

Decision, and (b) Section 314(d) blocks appeals. The latter, of course, was removed by *WiFi One*. And the former cannot stand on its own because this Court has rejected this rationale, explicitly holding that “§ 319 does not cabin the appeal rights conferred by § 1295,” which provides general appeal rights to any adverse Board decision that finally resolves an IPR. *Arthrex, Inc. v. Smith & Nephew, Inc.*, 880 F.3d 1345, 1348 (Fed. Cir. 2018). Though § 1295 is trumped by the more-specific “under this section” limit of § 314(d), *WiFi One* confines that limit to only patentability determinations and closely related determinations (not § 315 determinations). But it is not cabined explicitly or implicitly by Section 319, as *Arthrex* explained.

Reading these provisions otherwise would run contrary to the “strong presumption” in favor of judicial review of agency actions. *E.g. Mach Mining, LLC v. E.E.O.C.*, 135 S. Ct. 1645, 1651 (2015). *Wi-Fi One* explained that this Court “will abdicate judicial review only when Congress provides a ‘clear and convincing’ indication that it intends to prohibit review.” *Wi-Fi One*, 878 F.3d at 1372 (quoting *Cuozzo*, 136 S.Ct. at 2140). Binding Supreme Court precedent and decisions of sister circuits hold that Congressional silence is not enough to rebut this presumption. *Estep v. United States*, 327 U.S. 114, 119 (1946) (“[t]he silence of Congress as to judicial review is not necessarily to be construed as a denial of the power of the federal courts to grant relief in the exercise of the general jurisdiction which Congress has conferred upon them”); *see also, e.g., Am. Civil Liberties Union v. Clapper*, 785 F.3d 787, 810 (2d Cir. 2015) (rejecting “inferences from silence” as a basis to preclude judicial review); *Dugan*

v. Ramsay, 727 F.2d 192, 195 (1st Cir. 1984) (holding that “[i]t runs counter to the strong presumption in the law that favors reviewability and almost never implies statutory preclusion of review from congressional silence”).

Of course, Congress was not silent—it explicitly gave this Court jurisdiction to hear appeals from any adverse decision reached by the Board in an IPR. *See* 28 U.S.C. § 1295(a)(4)(A). This Court must not render this provision a nullity. *See Hibbs v. Winn*, 542 U.S. 88, 101 (2004) (a court should construe statutes “so that effect is given to all its provisions, so that no part will be inoperative or superfluous, void or insignificant”). And this Court must not read in additional exceptions to this jurisdiction beyond the one Congress already wrote, especially in light of the strong presumption in favor of judicial review. *See Lindb v. Murphy*, 521 U.S. 320, 330 (1997) (explaining that the rule that Congressional expression of a specific cases gives rise to “negative implications” concerning other cases is strongest, as here, where Congress considered the provisions together); *Morris v. Gressette*, 432 U.S. 491, 510 (1977) (holding that “normal ‘strong’ presumption” in favor of judicial review is “strengthened” where Congress writes an “express prohibition” which does not reach the decision sought to be reviewed).

Following these binding rules of statutory interpretation, § 1295 gives jurisdiction to this Court to hear any appeal from a decision in an IPR, consistent with the APA’s background providing judicial review of adverse agency actions. *See* 5 U.S.C. § 704; *see also Cuozzzo Speed Techs.*, 136 S. Ct. at 2140 (reading section 314(d) to

be consistent with background APA principles); *SAS Inst.*, 138 S. Ct. at 1359 (same). Section 319 explains how to appeal a Final Written Decision, and § 314(d) provides the only exception to this Court’s jurisdiction. The latter section, as discussed above, only precludes review of determinations closely related to the preliminary merits determination (i.e. “under this section”).

Thus, while *Wi-Fi One* only touched one reason underlying this Court’s *St. Jude* decision, its reasoning eviscerated the decision completely. Without § 314(d), *St. Jude* cannot stand, and this Court should take this case *en banc* to recognize the natural result of *Wi-Fi One*—that determinations not made “under this section” are appealable without regard to when those decisions are made or who appeals them.

CONCLUSION

For the reasons stated above, this Court should vacate the panel’s decision and rehear this case *en banc* to ensure consistent interpretation and application of the No-Appeal provision.

Dated: September 18, 2019

Respectfully submitted,

/s/ Oliver J. Richards

Oliver J. Richards

Attorney for Appellant

Kingston Technology Company, Inc.

ADDENDUM

NOTE: This order is nonprecedential.

**United States Court of Appeals
for the Federal Circuit**

KINGSTON TECHNOLOGY COMPANY, INC.,
Appellant

v.

SPEX TECHNOLOGIES, INC.,
Appellee

2019-1342

Appeal from the United States Patent and Trademark
Office, Patent Trial and Appeal Board in No. IPR2018-
01002.

KINGSTON TECHNOLOGY COMPANY, INC.,
Appellant

v.

SPEX TECHNOLOGIES, INC.,
Appellee

**ANDREI IANCU, Director, U.S. Patent and Trade-
mark Office,**
Intervenor

2 KINGSTON TECHNOLOGY COMPANY v. SPEX TECHNOLOGIES, INC.

2019-1599

Appeal from the United States Patent and Trademark Office, Patent Trial and Appeal Board in Nos. IPR2018-00084 and IPR2018-01068.

ON MOTION

Before MOORE, O'MALLEY, and HUGHES, *Circuit Judges*.
MOORE, *Circuit Judge*.

O R D E R

Kingston Technology Company, Inc. appeals from a decision of the Patent Trial and Appeal Board rejecting its petition to institute inter partes review (IPR) and request to join a related IPR. It also appeals from the Board's decision that terminated the related IPR after all the parties to that case had reached a settlement agreement. We *dismiss* both appeals and *deny* all motions.

BACKGROUND

SPEX Technologies, Inc. owns U.S. Patent No. 6,003,135. In September 2016, SPEX sued Kingston, Western Digital Corporation, Apricorn, Toshiba Corporation, and Toshiba America Electronic Components, Inc., alleging infringement of that patent. In March 2017, Kingston filed its first petition for IPR of claims 55–58. The Board elected to institute review of those claims and issued a final written decision concluding that Kingston had only shown claim 58 to be unpatentable. Kingston appealed that decision (Appeal No. 2019-1256), which is pending before this court but not directly at issue here.

While Kingston's first IPR was pending, Western Digital filed its own petition, IPR2018-00084, to review claims

55–58 of the patent based on references that were not cited in Kingston’s previous petition. A week after the Board instituted review in those proceedings, Kingston filed its second petition, IPR2018-01002, that was substantively identical to Western Digital’s petition, and moved to join IPR2018-00084. The Toshiba defendants and Apricorn also filed a similar petition and request for joinder with Western Digital’s case.

In November 2018, the Board dismissed Kingston’s second petition as barred under 35 U.S.C. § 315(e)(1). In concluding that Kingston reasonably could have raised the same grounds in its first IPR that it was seeking to assert in its petition underlying IPR2018-01002, the Board noted that Kingston “does not dispute having knowledge of these additional prior art references at the time of filing of its earlier petition” and “could have filed contemporaneously multiple petitions to argue persuasively additional grounds that it determined could not be effectively argued within the word limit of the first petition.” Kingston appeals that decision (Appeal No. 2019-1342).

Meanwhile, the Board instituted the Toshiba defendants’ and Apricorn’s petition and granted their request for joinder with IPR2018-00084. All the parties to that IPR (the Toshiba defendants, Apricorn, Western Digital, and SPEX) subsequently agreed to enter into a settlement agreement and jointly moved for the Board to terminate proceedings. On January 30, 2019, the Board granted the motion to terminate the IPR without reaching a final written decision on patentability. In doing so, the Board noted that Kingston had requested in an email message to the Board and in a conference call that the motion be dismissed or stayed pending its other appeals, but the Board denied that request because Kingston was not a party to the instant proceedings and no party supported that request. Kingston filed a notice of appeal from that decision (Appeal No. 2019-1599) and also moves to intervene in the very appeal it filed, a strange scenario indeed.

DISCUSSION

To exercise review over Kingston’s appeal from the Board decision dismissing its own IPR petition (IPR2018-01002) would be contrary to precedent. This court and the Supreme Court have distinguished between review of the Director’s decision not to institute review proceedings, which is “final and nonappealable” under 35 U.S.C. § 314(d), and the Board’s review and conduct after institution. *See Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (stating the “decision to deny a petition is a matter committed to the Patent Office’s discretion”); *St. Jude Med., Cardiology Div., Inc. v. Volcano Corp.*, 749 F.3d 1373, 1375–76 (Fed. Cir. 2014) (holding that review under 28 U.S.C § 1295(a)(4)(A) does not extend to appeals from Patent Office decisions not to institute IPR).¹

In drawing that distinction, we have consistently resisted limiting § 314(d)’s bar on appellate review to the denial of a petition for failure to establish a reasonable likelihood of success. *See, e.g., St. Jude*, 749 F.3d at 1375–76 (dismissing appeal from Board’s decision denying petition on timeliness grounds); *Saint Regis Mohawk Tribe v. Mylan Pharm. Inc.*, 896 F.3d 1322, 1327 (Fed. Cir. 2018) (noting that “[w]hile [the Director] has the authority not to institute review on the merits of the petition, he could deny

¹ *Arthrex, Inc. v. Smith & Nephew, Inc.*, 880 F.3d 1345 (Fed. Cir. 2018) is not to the contrary. *Arthrex* concerned the issue of whether a party could appeal from a final adverse judgment entered under 37 C.F.R. § 42.73(b) after institution. *Arthrex* itself distinguished *St. Jude*, stating that “*St. Jude* did not involve a similar situation, and the availability of appeal of final adverse judgment decisions was not directly addressed in that case.” *Id.* at 1349.

review for other reasons” and “[i]f the Director decides not to institute, for whatever reason, there is no review”).

In arguing against application of § 314(d)’s appeal bar, Kingston seizes on the fact that the Board referenced in its decision “dismiss[ing]” the petition rather than declining review. But, under the circumstances, this is a distinction without a difference. *See GTNX, Inc. v. INTTRA, Inc.*, 789 F.3d 1309, 1311–12 (Fed. Cir. 2015) (refusing to distinguish for purposes of § 314(d) between the Patent Office’s initial decision to institute and the Patent Office’s decision to reconsider and vacate its decision to institute proceedings). As even Kingston recognizes, the Board’s bottom line was to not institute the IPR petition. *See* Kingston’s Resp. in Appeal No. 2019-1342 at 5 (acknowledging that “the Board denied institution”).²

We also conclude that Kingston can make no non-frivolous argument that it should have been permitted to join the Western Digital IPR (IPR2018-00084) after the Board dismissed Kingston’s own petition. The provision on which Kingston requested joinder, 35 U.S.C. § 315(c), states that the Director may “join as a party to that inter partes review any person who properly files a petition under section 311 that the Director . . . determines warrants the institution of an inter partes review under section 314.” Because the Board determined that Kingston’s petition did not warrant institution under § 314 and we must take that

² Kingston alternatively contends that we should treat its notice of appeal as a petition for a writ of mandamus. But even if we were to do so, we would have to deny such a request because Kingston cannot demonstrate a clear and indisputable right to relief. *See In re Dominion Dealer Sols., LLC*, 749 F.3d 1379, 1381 (Fed. Cir. 2014) (denying mandamus based on the absence of a clear and indisputable right to relief in view of the statutory scheme precluding review of non-institution decisions).

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determination to be final and conclusive, it follows from the plain terms of § 315(c) that joinder also had to be denied.

It also follows that we must reject Kingston's attempts to appeal from the Western Digital IPR and intervene for purposes of appeal. Kingston's right to appeal, if any, comes from 35 U.S.C. § 141(c), which states that "[a] party to an inter partes review . . . who is dissatisfied with the final written decision of the Patent Trial and Appeal Board under section 318(a) . . . may appeal the Board's decision only to the United States Court of Appeals for the Federal Circuit" (emphasis added); *see also* 35 U.S.C. § 319 ("A party dissatisfied with the final written decision . . . may appeal the decision pursuant to [§ 141].").

Because Kingston is absolutely not a party under section 141, it has no right to appeal. *Cf. Mylan Pharm. Inc. v. Research Corp. Techs., Inc.*, 914 F.3d 1366, 1373 (Fed. Cir. 2019) (holding that a petitioner that was joined may appeal the Board's decision in part because "party" in §§ 141 and 315(c) should be given the same meaning); *see also Ala. Power Co. v. FCC*, 311 F.3d 1357, 1366 (11th Cir. 2002) ("A 'party aggrieved' [within the meaning of 28 U.S.C. § 2344] is one who participated in the agency proceeding."); *In re Chi., Milwaukee, St. Paul & Pac. R.R. Co.*, 799 F.2d 317, 335 (7th Cir. 1986) ("The statute limits review to petitions filed by parties, and that is that.").

The cases cited by Kingston do not involve a similar statutory scheme and in any event are distinguishable. In *Searcy v. Philips Electronics North America Corp.*, 117 F.3d 154, 157–58 (5th Cir. 1997), the court held that the unique structure of the False Claims Act in giving the United States the right to veto a settlement entered into by a qui tam relator justified the unusual step of allowing an appeal even though the United States was never formally made a party in the district court. Kingston does not suggest it has

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a similar stake in the outcome of this appeal.³ Kingston's reliance on *Kenny v. Quigg*, 820 F.2d 665, 668 (4th Cir. 1987), and *Carhart v. Carhart-Halaska International, LLC*, 788 F.3d 687, 690 (7th Cir. 2015), is similarly misplaced because, unlike in those cases, Kingston was not treated as a de facto party.

Accordingly,

IT IS ORDERED THAT:

(1) The stay of the briefing schedule in these appeals is lifted.

(2) The official caption for Appeal No. 2019-1599 has been revised to reflect that the Director of the United States Patent and Trademark Office has intervened in that appeal.

(3) The appeals are dismissed, and all pending motions are denied.

(4) Kingston shall bear costs.

³ In fact, Kingston appears to have filed this appeal merely to preserve its attempted challenges to the Board's denial of its own IPR and request for joinder. *See* Kingston's Resp. in Appeal No. 2019-1599 at 8 (arguing that "the Board's premature dismissal [of the Western Digital IPR] threatens the viability of [Kingston's] earlier appeal"); 11 ("At most, Kingston seeks in this appeal to have the Board's decision dismissing the [Western Digital] IPR stayed until adequate resolution of Kingston's earlier appeal."); and 19 ("The only way for Kingston to protect its interests is for Kingston to be allowed to intervene to appeal the Board's decision dismissing the Western Digital IPR while Kingston's request to join that IPR is still pending on appeal to this Court.").

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FOR THE COURT

July 19, 2019
Date

/s/ Peter R. Marksteiner
Peter R. Marksteiner
Clerk of Court

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CERTIFICATE OF COMPLIANCE

The undersigned attorney certifies that Combined Petition for Rehearing and Rehearing *En Banc* complies with the type-volume limitation set forth in Federal R. App. P. 35(b)(2)(A). The relevant portions of the petition, including all footnotes, contain 3,613 words, as determined by Microsoft Word.

Dated: September 18, 2019

/s/Oliver J. Richards

CERTIFICATE OF SERVICE AND FILING

I certify that I electronically filed the foregoing document using the Court's CM/ECF filing system on September 18, 2019. Counsel was served via CM/ECF on September 18, 2019.

/s/ Oliver J. Richards
Oliver J. Richards