APPENDIX A — ORDER OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT, FILED DECEMBER 27, 2018

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

2018-2426, -2427, -2428, -2429, -2430

ARRIS INTERNATIONAL PLC,

Appellant,

v.

CHANBOND, LLC,

Appellee.

ANDREI IANCU, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE,

Intervenor.

Appeals from the United States Patent and Trademark Office, Patent Trial and Appeal Board in Nos. IPR2018-00570, IPR2018-00572, IPR2018-00573, IPR2018-00574, and IPR2018-00575.

Appendix A

ON MOTION

Before PROST, *Chief Judge*, O'MALLEY and STOLL, *Circuit Judges.*

O'MALLEY, *Circuit Judge.*

ORDER

ChanBond, LLC moves to dismiss these appeals for lack of jurisdiction. ARRIS International PLC opposes the motion. ChanBond replies. The Director of the United States Patent and Trademark Office moves out of time to intervene in support of dismissal.

ChanBond is the owner of U.S. Patent Nos. 7,941,822; 8,341,679; and 8,984,565. In September 2015, ChanBond sued various telecommunications companies in the United States District Court for the District of Delaware for infringing those patents. In February 2018, ARRIS filed five petitions requesting *inter partes* review (IPR) of various claims of those patents. In its preliminary responses, ChanBond argued that the petitions were time-barred under 35 U.S.C. § 315(b) because ARRIS was in privity with the defendants in the Delaware action and ARRIS filed its petitions more than a year after the filing of that complaint. The Board agreed and denied institution of all five petitions. ARRIS then filed these appeals from the denial of institution decisions.

ChanBond argues that ARRIS's appeals are foreclosed under *St. Jude Medical, Cardiology Division,*

Inc. v. Volcano Corp., 749 F.3d 1373 (Fed. Cir. 2014). We agree. As is the case here, the petitioner in *St. Jude* appealed from the Board's decision to deny institution of IPR based on the Board's determination that the petition was time-barred under § 315(b). We explained the statutory contrast between a "determination . . . whether to institute" a proceeding, which is "final and nonappealable," 35 U.S.C. § 314(d), and the "final written decision" determining patentability, 35 U.S.C. § 318(a), and we held that our review authority under 28 U.S.C. § 1295(a)(4)(A) does not extend to appeals from decisions not to institute. *St. Jude*, 749 F.3d at 1375–76.

Nothing in *Wi-Fi One, LLC v. Broadcom Corp.*, 878 F.3d 1364 (Fed. Cir. 2018) (*en banc*), undermines that holding. *Wi-Fi One* concerned review of the Board's § 315(b) determination in a final written decision, not a decision denying institution. *See id.* at 1371. As both *Wi-Fi One* and subsequent precedent have reiterated, "[i]f the Director decides not to institute, for whatever reason, there is no review." *Saint Regis Mohawk Tribe v. Mylan Pharm. Inc.*, 896 F.3d 1322, 1327 (Fed. Cir. 2018); *see also Wi-Fi One*, 878 F.3d at 1372 (noting that "the agency's decision to deny a petition is a matter committed to the Patent Office's discretion" (quoting *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016))).

ARRIS's reliance on *Arthrex, Inc. v. Smith & Nephew, Inc.*, 880 F.3d 1345 (Fed. Cir. 2018), in support of jurisdiction over these appeals is also misplaced. Far from review over a non-institution decision, *Arthrex* concerned the issue of whether a party could appeal from a final

adverse judgment entered under 37 C.F.R. § 42.73(b). *Arthrex* 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.

In view of the foregoing, we conclude that we lack jurisdiction to hear ARRIS's appeals.

Accordingly,

IT IS ORDERED THAT:

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

(2) The Director's motion to intervene is granted. The revised official caption is reflected above.

(3) ChanBond's motion to dismiss is granted. The appeals are dismissed.

(4) Each side shall bear its own costs.

FOR THE COURT

Dec. 27, 2018
Date

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

ISSUED AS A MANDATE: December 27, 2018