

Nos. 2021-1043, -1044, -1046

**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

APPLE INC.,

Appellant,

v.

OPTIS CELLULAR TECHNOLOGY, LLC,

Appellee,

ANDREI IANCU, Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office,

Intervenor.

Appeal from the United States Patent and Trademark Office,
Patent Trial and Appeal Board in No. IPR2020-00465

APPLE INC.,

Appellant,

v.

OPTIS WIRELESS TECHNOLOGY, LLC,

Appellee,

ANDREI IANCU, Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office,

Intervenor.

Appeal from the United States Patent and Trademark Office,
Patent Trial and Appeal Board in No. IPR2020-00466

APPLE INC.,

Appellant,

v.

UNWIRED PLANET INTERNATIONAL LIMITED,

Appellee,

ANDREI IANCU, Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office,

Intervenor.

Appeal from the United States Patent and Trademark Office,
Patent Trial and Appeal Board in No. IPR2020-00642

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January 26, 2021

CERTIFICATE OF INTEREST

Counsel for Appellant Apple Inc. certifies the following:

1. Represented Entities. Fed. Cir. R. 47.4(a)(1). Provide the full names of all entities represented by undersigned counsel in this case.

Apple Inc.

2. Real Party in Interest. Fed. Cir. R. 47.4(a)(2). Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities.

None.

3. Parent Corporations and Stockholders. Fed. Cir. R. 47.4(a)(3). Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities.

None.

4. Legal Representatives. List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

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5. Related Cases. Provide the case titles and numbers of any case known to be pending in this court or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. Do not include the originating case number(s) for this case. Fed. Cir. R. 47.4(a)(5). See also Fed. Cir. R. 47.5(b).

Google LLC v. Uniloc 2017 LLC, No. 20-2040 (Fed. Cir.)

Cisco Systems Inc. v. Ramot at Tel Aviv University, Nos. 20-2047, -2049 (Fed. Cir.)

Apple Inc. v. Maxell, Ltd., Nos. 20-2132, 20-2211, 20-2212, 20-2213, 21-1033 (Fed. Cir.)

Optis Wireless Technology, LLC et al. v. Apple Inc., No. 2:19-cv-00066 (E.D. Tex.)

6. Organizational Victims and Bankruptcy Cases. Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

None.

Dated: January 26, 2021

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STATEMENT OF COUNSEL

Based on my professional judgment, I believe the panel decision is contrary to the following decisions: *Cuozzo Speed Technologies, LLC v. Lee*, 136 S. Ct. 2131 (2016), *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348 (2018), *Thryv, Inc. v. Click-To-Call Technologies, LP*, 140 S. Ct. 1367 (2020), and *Arthrex, Inc. v. Smith & Nephew, Inc.*, 880 F.3d 1345 (Fed. Cir. 2018).

Based on my professional judgment, I also believe this appeal requires an answer to the following precedent-setting question of exceptional importance:

Whether the Court has jurisdiction to review a decision of the U.S. Patent and Trademark Office denying a petition for inter partes review where the appeal argues that the decision was based on an agency rule that exceeds the Office's statutory authority, is arbitrary and capricious, and was adopted without observance of required procedures.

/s/ Mark D. Selwyn
MARK D. SELWYN

INTRODUCTION

Apple challenges decisions by the Patent Trial and Appeal Board (“Board”) denying Apple’s petitions for inter partes review (“IPR”) of patents asserted against Apple in a pending infringement lawsuit. In those decisions, the Board applied a rule adopted by the Director of the U.S. Patent and Trademark Office (“Office”)—the “*NHK-Fintiv* rule”—that permits denial solely because pending litigation involves the same patent claims. Apple argues that the rule exceeds the Office’s statutory authority, is arbitrary and capricious, and violates the rulemaking requirements of the Administrative Procedure Act (“APA”).

A motions panel dismissed Apple’s appeals for lack of jurisdiction under 28 U.S.C. §1295(a)(4)(A) and 35 U.S.C. §314(d). The panel reasoned that those provisions permit appellate review of an institution decision only on appeal from a final written decision issued after IPR, and only if the appeal involves a matter not closely tied to the interpretation and application of an institution-related statute. This ruling conflicts with Supreme Court precedent, creates intra-circuit confusion, and raises an issue of exceptional importance.

The ruling conflicts with *Cuozzo Speed Technologies, LLC v. Lee*, 136 S. Ct. 2131 (2016), *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348 (2018), and *Thryv, Inc. v. Click-To-Call Technologies, LP*, 140 S. Ct. 1367 (2020), which make clear that (1) §314(d) does not bar appeals arguing that an institution decision exceeded the

Office's authority, even if that argument depends on the interpretation and application of an institution-related statute; (2) §314(d) does not bar appeals arguing that an institution decision violated the substantive or procedural requirements of the Administrative Procedure Act ("APA"); and (3) these limits on §314(d) apply even when the appeal does not arise from a final written decision issued after IPR.

The ruling also creates intra-circuit confusion. Before *Cuozzo*, this Court held in *St. Jude Medical, Cardiology Division, Inc. v. Volcano Corp.*, 749 F.3d 1373 (Fed. Cir. 2014), that §1295(a)(4)(A) confers appellate jurisdiction only over final written decisions. But *Arthrex, Inc. v. Smith & Nephew, Inc.*, 880 F.3d 1345, 1348-1349 (Fed. Cir. 2018), later held that §1295(a)(4)(A) authorizes appeals from any final judgment by the Board relating to IPR, even if not a final written decision, provided that §314(d) does not apply. Thus, under *Arthrex*, this Court has jurisdiction where an appeal from a non-institution decision avoids §314(d) on the grounds identified in *Cuozzo* and its progeny. By failing to address *Arthrex*, the motions panel leaves Circuit law unclear.

Finally, this is an exceptionally important issue. The Board has applied the *NHK-Fintiv* rule to deny dozens of IPR petitions, and will continue to do so, depriving Apple and other leading innovators of the efficient patent-review process that Congress viewed as integral to the patent system. The motions panel's ruling

leaves that unlawful action immune from this Court’s scrutiny, and would bar this Court’s review even if the Office purported to cancel the IPR program entirely.

The Court recently invited responses to a rehearing petition Apple filed in another case that presents issues identical to this petition. *Apple Inc. v. Maxell, Ltd.*, Nos. 20-2132, -2211, -2212, -2213, 2021-1033, ECF No. 41 (Fed. Cir. Oct. 30, 2020). The Court should therefore at a minimum hold this petition pending disposition of the petition in *Maxell*.

BACKGROUND

A. The *NHK-Fintiv* Rule

Congress established IPR as a specialized administrative procedure to “weed out bad patent claims efficiently.” *Thryv*, 140 S. Ct. at 1374. The America Invents Act (“AIA”) contains detailed rules governing the Office’s determination whether to institute IPR, including mandatory preconditions and discretionary factors. 35 U.S.C. §§311(c)(1)-(2), 312(a)(1)-(5), 314(a), 315(a)(1)-(2), 315(b), & 325(d).

In two decisions, the Board articulated a new, non-statutory standard under which it may deny IPR petitions if litigation involving the same patent is pending. In *NHK Spring Co. v. Intri-Plex Technologies, Inc.*, the Board declared: “[T]he advanced state of ... district court proceeding[s]” is an “additional factor that weighs in favor of denying” IPR petitions. No. IPR2018-00752, Paper 8, at 20 (P.T.A.B. Sept. 12, 2018). Elaborating on *NHK* in *Apple Inc. v. Fintiv, Inc.*, the

Board explained it would “weigh” six non-statutory “factors” in deciding whether to deny IPR petitions due to pending litigation. *Fintiv*, No. IPR2020-00019, Paper 11, at 5 (P.T.A.B. Mar. 20, 2020).

The Director designated *NHK* and *Fintiv* as “precedential” and therefore “binding” on the Board “in subsequent matters involving similar facts or issues,” Patent Trial and Appeal Board, Standard Operating Procedure 2 (Rev. 10) (“SOP-2”), at 11 (Sept. 20, 2018).¹ By doing so, the Director adopted those decisions as a “rule”—*i.e.*, “an agency statement of general or particular applicability and future effect,” 5 U.S.C. §551(4). The designation process afforded no public notice or opportunity for public comment. SOP-2 at 8-11.

B. Prior Proceedings

These appeals arise from the Board’s application of the *NHK-Fintiv* rule to deny three Apple IPR petitions. Apple seeks remand for the Board to reconsider the petitions without applying the *NHK-Fintiv* rule, which Apple challenges as unlawful because: (1) the Office lacks authority to deny timely IPR petitions based on overlapping infringement litigation; (2) the rule’s factors are arbitrary and capricious because they call for speculation about district court proceedings, undermine the rule’s ostensible efficiency goal, and yield inconsistent results; and

¹ <https://www.uspto.gov/sites/default/files/documents/SOP2%20R10%20FINAL.pdf>.

(3) the rule was adopted without the notice-and-comment rulemaking that the APA and the AIA each require. Dkt. No. 12 at 9-16.

The Court ordered Apple to show cause why its appeals should not be dismissed for lack of jurisdiction. Dkt. No. 10. Apple responded that the Court has jurisdiction under 28 U.S.C. §1295(a)(4)(A) because these are “‘appeal[s] from’ Board ‘decision[s] ... with respect to ... inter partes review.’” Dkt. No. 12 at 1 (quoting §1295(a)(4)(A)). Apple explained that under Supreme Court precedent, “‘judicial review remains available’” despite 35 U.S.C. §314(d) “‘[i]f a party believes’ the PTO’s decision ‘exceed[ed] its statutory bounds’ or was ‘arbitrary [and] capricious,’ or ‘where the grounds for attacking the decision’ ‘depend on ... statutes’ that are ‘less closely related’ to the statutes governing institution.” Dkt. No. 12 at 1, 8 (quoting *Cuozzo*, 136 S. Ct. at 2141-2142 (citing 5 U.S.C. §706(2)(A)-(D)), and *SAS*, 138 S. Ct. at 1359, and citing *Thryv*, 140 S. Ct. at 1373). Apple argued that §314(d) does not bar its appeals because they argue the Office exceeded its statutory authority and involve the application of a statute unrelated to institution decisions—the APA. Dkt. No. 12 at 9-16.

The motions panel dismissed Apple’s appeals, Dkt. No. 19 at 3, concluding that the Court lacks jurisdiction “for the same reasons set forth in” the motions panels’ orders dismissing the appeals in *Apple Inc. v. Maxell, Ltd.*, No. 20-2132, ECF No. 38 at 2 (Fed. Cir. Oct. 30, 2020), and *In re Cisco Systems, Inc.*, No. 2020-

148, 2020 WL 6373016 (Fed. Cir. Oct. 30, 2020). Like Apple, Cisco had appealed the Board's denial of IPR petitions based on the *NHK-Fintiv* rule. 2020 WL 6373016, at *1. The *Cisco* motions panel concluded that it "lack[ed] jurisdiction" over Cisco's appeals. *Id.* at *2.

The *Cisco* panel allowed that *Cuozzo*, *SAS*, and *Thryv* "left open the possibility that §314(d) may not bar appeals that implicate constitutional questions or concerns that the agency acted outside its statutory limits." 2020 WL 6373016, at *2. But the panel thought those cases did not support jurisdiction for two reasons. First, unlike Cisco's (and Apple's) appeals, those cases "involved appeals from a final written decision after a decision to institute." *Id.* Second, according to the panel, "§314(d) bars review of matters 'closely tied to the application and interpretation of statutes related to the Patent Office's decision to initiate inter partes review'"—even where the matter implicates the extent of the Office's statutory authority. *Id.* (quoting *Cuozzo*, 136 S. Ct. at 2141). Thus, although Cisco was "challenging whether the Board has authority to consider the status of parallel district court proceedings ... in deciding whether to deny institution," the panel concluded that Cisco's appeals were barred by §314(d) because "such challenges, both procedural and substantive, rank as questions closely tied to the application and interpretation of statutes relating to the Patent Office's decision whether to initiate review." *Id.*

In *Maxell*, a motions panel applied *Cisco* to dismiss appeals brought by Apple that are identical to these appeals. *Maxell*, ECF No. 38 at *1. Apple sought rehearing, *Maxell*, ECF No. 40, and the Court has invited responses from Maxell and the Director, *id.*, ECF No. 41.

ARGUMENT

I. THE RULING CONTRADICTS SUPREME COURT PRECEDENT

The motions panel’s dismissal conflicts with *Cuozzo*, *SAS*, and *Thryv* in three ways.

A. The Panel Erroneously Concluded That Appeals Claiming That The Office Exceeded Its Authority Under An Institution-Related Statute Are Barred

Apple’s grounds for appeal argue that the Office exceeded its statutory authority—an attack the Supreme Court has held reviewable despite §314(d). The motions panel nonetheless concluded that §314(d) bars such appeals if the claim is closely tied to the application and interpretation of an institution-related statute. That conclusion contravenes the Supreme Court’s rulings that the “closely tied” standard is a threshold issue—*i.e.*, that §314(d) applies only if the matter is closely tied to an institution-related statute, but that even if the relevant statute is institution-related, §314(d) does not apply if the appeal argues the agency exceeded its authority. Indeed, because questions of the Office’s statutory

authority to institute (or not) always implicate institution-related statutes, the panel's approach erases the limits of §314(d) that the Supreme Court recognized.

In *Cuozzo*, the Supreme Court “interpret[ed]” §314(d) to “appl[y] 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 institution decisions. 136 S. Ct. at 2141. The Court cautioned, however, that this “interpretation” does not “enable the agency to act outside its statutory limits.” *Id.* As an example of a reviewable challenge, the Court offered a case where the Office instituted IPR to “cancel[] a patent claim for indefiniteness under §112”—an impermissible ground for conducting IPR under §311(b). *Id.* at 2141-2142; *see id.* at 2155 (Alito, J., dissenting) (describing hypothetical to which majority was responding). Although §311(b) is closely tied to institution, the Court nonetheless held that “[s]uch ‘shenanigans’ may be properly reviewable ... under the Administrative Procedure Act, which enables reviewing courts to ‘set aside agency action’ that is ... ‘in excess of statutory jurisdiction.’” *Id.* at 2142 (quoting 5 U.S.C. §706(2)(C)). In contrast, the Court held, §314(d) barred review of “Cuozzo’s claim that [the IPR] petition was not pleaded ‘with particularity’ under §312” because that claim was “little more than a challenge to the Patent

Office’s conclusion, under §314(a), that the ‘information presented in the petition’ warranted review.” *Id.*²

Drawing on *Cuozzo*, *SAS* similarly held that §314(d) did not bar review of a claim that the Office had exceeded its institution authority, even though the claim arose under the AIA’s institution-related provisions. *SAS* had petitioned for IPR of sixteen patent claims. 138 S. Ct. at 1354. The Office instituted review on only some claims pursuant to a “regulation that purported to recognize a power of ‘partial institution.’” *Id.* The government argued that §314(d) “foreclos[es] judicial review of any legal question bearing on the institution of inter partes review,” but the Court rejected that view. *Id.* at 1359. Noting that *Cuozzo* “emphasize[s] that §314(d) does not enable the agency to act outside its statutory limits,” the Court determined that that was “exactly the sort of question we are called upon to decide today”: “*SAS* contends that the Director exceeded his statutory authority by limiting the review to fewer than all of the claims *SAS* challenged.” *Id.* (quotation marks omitted). Therefore, “nothing in §314(d) or *Cuozzo*,” the Court concluded, “withdraws our power to” hear *SAS*’s appeal. Far from “le[aving] open the possibility” that §314(d) allows appeals arguing the

² *Thryv* similarly held that §314(d) barred review of a “challenge to [a] petition’s timeliness under §315(b)” because the challenge “raise[d] an ordinary dispute about the application of an institution-related statute.” 140 S. Ct. at 1373 (quotation marks omitted).

Office’s institution decision exceeded its statutory authority (as the motions panel erroneously stated, *Cisco*, 2020 WL 6373016, at *2), *SAS* definitively held that §314(d) does not bar such appeals.³

Notably, *SAS*’s appeal argued that the Director had exceeded his authority under statutory provisions closely related to institution of IPR. The issue was whether the Director had authority to partially institute under an array of institution-related provisions of the AIA—§§311(a), 312(a)(3), 314(b), 316(a)(8), 318(a)—and the Court held the Director had only “a binary choice—either institute review or don’t” and had thus exceeded his authority under those institution-related provisions. *SAS*, 138 S. Ct. at 1354-1357. Consequently, *SAS* makes clear that §314(d) does not bar appeals claiming that a non-institution decision exceeded the Office’s authority, even under institution-related provisions of the AIA.

These recognized limits of §314(d) reflect the general principle that statutory review bars do not preclude review of ultra vires actions—a principle that applies even when the statute whose bounds the agency exceeded is the same statute under

³ The government is wrong that the discretionary nature of institution decisions forecloses review. ECF No. 17 at 10-12. The Court’s jurisdiction turns only on the nature of the “grounds for attacking” the Board’s decisions, not on whether those grounds ultimately succeed. *Cuozzo*, 136 S. Ct. at 2141; *see SAS*, 138 S. Ct. at 1359. As is ordinarily the case, unless “a claim is wholly insubstantial and frivolous,” the jurisdictional inquiry is not a vehicle to resolve the merits. *Bell v. Hood*, 327 U.S. 678, 682-683 (1946).

which the agency would ordinarily take unreviewable actions. *See Lindahl v. OPM*, 470 U.S. 768, 772 (1985); *Leedom v. Kyne*, 358 U.S. 184, 187-188 (1958); *Aid Association for Lutherans v. USPS*, 321 F.3d 1166, 1172-1173 (D.C. Cir. 2003). The motions panel’s treatment of §314(d) contravenes these holdings.

B. The Panel Erroneously Concluded That All Of Apple’s Challenges Relate To An Institution-Related Statute

The motions panel further contravened *Cuozzo* and its progeny by treating two of Apple’s challenges as involving “questions closely tied to the application and interpretation of” institution-related statutes, *Cisco*, 2020 WL 6373016, at *2, when in fact they do not. Those challenges instead contend that the *NHK-Fintiv* rule (1) is arbitrary and capricious, as defined by the APA, and (2) was adopted without the notice-and-comment rulemaking required by the APA. *See supra* p.5; *see also* 5 U.S.C. §553(b), (c); *Kisor v. Wilkie*, 139 S. Ct. 2400, 2420 (2019).

In *Cuozzo*, the Supreme Court stated that §314(d) does not bar review of claims brought “under the Administrative Procedure Act,” including claims that the agency’s decision was ““arbitrary [and] capricious.”” 136 S. Ct. at 2142 (quoting 5 U.S.C. §706(2)(A)). The Court also cited 5 U.S.C. §706(2)(D), which permits a court to “set aside agency action” taken “without observance of procedure required by law.” *Id.* *SAS* reaffirmed that “judicial review remains available consistent with the Administrative Procedure Act.” 138 S. Ct. at 1359.

C. The Panel Erroneously Concluded That §314(d) May Be Avoided Only If The Appeal Arises From A Final Written Decision

The motions panel also contradicted Supreme Court precedent by concluding that the limits of §314(d) identified in *Cuozzo* and its progeny have effect only where the appeal arises from a final written decision after IPR.

Although *Cuozzo*, *SAS*, and *Thryv* arose from final written decisions, the panel's view is irreconcilable with the Supreme Court's analysis of §314(d)'s scope.

By its terms, §314(d) applies to “determination[s] ... *whether* to institute”—that is, to determinations both for and against institution. And it is silent as to whether the appeal arises from a final written decision. Indeed, *Cuozzo* rejected the view that §314(d)'s application depends on whether there was a final written decision, a view that “reads into the provision a limitation (to interlocutory decisions) that the language nowhere mentions.” 136 S. Ct. at 2140.

Correspondingly, §314(d)'s limits must be the same regardless of whether the appealed decision was to institute or not to institute and regardless of whether the appeal arises from a final written decision or some other decision.

Nothing in the Supreme Court's analysis of §314(d) indicates otherwise. The Court never suggested that §314(d)'s limits apply only in appeals from final written decisions or that appeals from non-institution decisions are categorically barred by §314(d) even if they argue that the Office's action exceeded its authority or was arbitrary and capricious. Rather, those limits derive from the scope of

review under the APA and the background principle (discussed above) that statutory bars on judicial review do not apply to questions of agency authority. *See Cuozzo*, 136 S. Ct. at 2141-2142 (citing 5 U.S.C. §706(2)(A)-(D) and *Johnson v. Robison*, 415 U.S. 361, 367 (1974)); *Leedom*, 358 U.S. at 187-188. Neither rationale turns on whether a challenge arises in the context of a final written decision after institution.

SAS is particularly instructive. Again, the IPR petitioner challenged the Office's decision to institute review of (and correspondingly render a final written decision on) only some claims and not others, and the Supreme Court held that §314(d) did not bar the appeal because the appeal claimed the Office had exceeded its statutory authority. *See supra* pp.10-11. Although the appeal arose from a final written decision, that posture was irrelevant to the Court's analysis. *See SAS*, 138 S. Ct. at 1359. It would be absurd for §314(d)'s application to turn on the presence of a final written decision because that would mean that Congress intended to permit judicial review of non-institution decisions despite §314(d) only in one narrow situation that Congress intended never to occur—*i.e.*, cases of partial institution. Thus, contrary to the panel's view, the Supreme Court has made clear that if this Court otherwise has appellate jurisdiction, §314(d) applies, or not, in the

same way irrespective of whether the appealed decision denied institution or granted it and yielded a final written decision.⁴

II. THE RULING CREATES INTRA-CIRCUIT CONFUSION

In concluding that this Court “lack[s] jurisdiction under §1295(a)(4)(A),” the motions panel cited this Court’s pre-*Cuozzo* decision in *St. Jude* for the proposition that “this court’s review authority under §1295(a)(4)(A) does not extend to appeals from non-institution decisions.” *Cisco*, 2020 WL 6373016, at *2. But the panel did not account for this Court’s later decision in *Arthrex*, which held that where §314(d) does not apply, this Court has jurisdiction under §1295(a)(4)(A) to review the Board’s final IPR-related decisions even absent a final written decision. The motions panel’s ruling therefore creates intra-circuit confusion about the scope of appellate jurisdiction under §1295(a)(4)(A).

St. Jude held that the court lacked jurisdiction to review a non-institution decision because (it said) chapter 31 of title 35—specifically §§314(d) and 319—“authorizes appeals to this court only from the final written decision” and “the statutory grant of jurisdiction [under §1295(a)(4)(A)] matches the appeal right in

⁴ The presence of a final written decision can be relevant to reviewability if it supplies the final agency action ordinarily required for judicial review. *Cuozzo*, 136 S. Ct. at 2140 (if §314(d) barred only immediate review of decisions to institute IPR, §314(d) would be “unnecessary” because such decisions are “preliminary, not final,” and therefore are unreviewable anyway). But decisions denying institution are final actions in and of themselves and are thus reviewable so long as §314(d) does not apply. *See infra* pp. 16-17.

chapter 31.” 749 F.3d at 1375-1376. *Arthrex*, however, held that as long as §314(d) does not apply, §1295(a)(4)(A) “provides a right to appeal a final adverse judgment” of the Board, even if that judgment is not a “final written decision.” 880 F.3d at 1348-1349. Citing *St. Jude*, the *Arthrex* appellees had moved to dismiss, arguing that §319 “created the exclusive means of appeal” and required a final written decision. *Id.* at 1348. The Court rejected that argument. It held that §319 “does not ... provide the exclusive means for appeal over IPR decisions” that are “not subject to the appeal bar” in §314(d). *Id.* at 1349. Rather, “§1295(a)(4)(A) on its face provide[d] a right to appeal,” and therefore “a final decision that disposes of an IPR proceeding” and is not subject to §314(d) is reviewable under §1295(a)(4)(A) even without a final written decision. *Id.*

Arthrex shows that, notwithstanding *St. Jude*, §1295(a)(4)(A) creates appellate jurisdiction over non-institution decisions falling outside §314(d)’s scope as defined in *Cuozzo* and its progeny. Such decisions are final judgments by the Board “with respect to” IPR and thus fall within the plain language of §1295(a)(4)(A). By relying on *St. Jude* without considering *Arthrex*, the panel’s ruling casts doubt about which precedent reflects the law of the Circuit and how §314(d) intersects with §1295(a)(4)(A).

Saint Regis Mohawk Tribe v. Mylan Pharmaceuticals, Inc., 896 F.3d 1320 (Fed. Cir. 2018), does not clarify matters or support the motions panel’s ruling; it

has nothing to do with the issues presented here. When the *Saint Regis* Court wrote, “If the Director decides not to institute, for whatever reason, there is no review,” 896 F.3d at 1327, *quoted in Cisco*, 2020 WL 6373016, at *2, it was using “review” to refer to inter partes review, not judicial review. *Saint Regis* did not involve a question of appellate jurisdiction or §314(d).

III. REVIEW OF THE RULING IS EXCEPTIONALLY IMPORTANT

Judicial review of the *NHK-Fintiv* rule is imperative. The rule has dramatically reduced the availability of IPR and will continue to do so, depriving accused infringers of the efficient procedure Congress created to promote the integrity of the patent system. By allowing that rule to go unreviewed, the motions panel’s decision empowers the Office to restrict IPR even further, including by denying IPR petitions based on a coin flip or a binding policy of categorically denying *all* IPR petitions.

The Office’s denials under the *NHK-Fintiv* rule have generated numerous appeals presenting the same questions as these cases—all dismissed by a motions panel—and many more will likely arise. If this Court is to conclude that it cannot review denials based on the *NHK-Fintiv* rule or any other arbitrary or unlawful ground—if it is to conclude that Congress intended to let the Office break or cancel an important program without this Court’s scrutiny—the Court should do so only

with the well-informed authority that comes from full briefing and en banc consideration.

CONCLUSION

The Court should grant rehearing. At a minimum, the Court should hold the petition pending disposition of the rehearing petition in *Apple v. Maxell*.

Respectfully submitted,

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January 26, 2021

ADDENDUM

NOTE: This order is nonprecedential.

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

APPLE INC.,
Appellant

v.

OPTIS CELLULAR TECHNOLOGY, LLC,
Appellee

**ANDREI IANCU, Under Secretary of Commerce for
Intellectual Property and Director of the United
States Patent and Trademark Office,**
Intervenor

2021-1043

Appeal from the United States Patent and Trademark
Office, Patent Trial and Appeal Board in No. IPR2020-
00465.

APPLE INC.,
Appellant

v.

OPTIS WIRELESS TECHNOLOGY, LLC,
Appellee

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APPLE INC. v. OPTIS CELLULAR TECHNOLOGY, LLC

**ANDREI IANCU, Under Secretary of Commerce for
Intellectual Property and Director of the United
States Patent and Trademark Office,**
Intervenor

2021-1044

Appeal from the United States Patent and Trademark
Office, Patent Trial and Appeal Board in No. IPR2020-
00466.

APPLE INC.,
Appellant

v.

UNWIRED PLANET INTERNATIONAL LIMITED,
Appellee

**ANDREI IANCU, Under Secretary of Commerce for
Intellectual Property and Director of the United
States Patent and Trademark Office,**
Intervenor

2021-1046

Appeal from the United States Patent and Trademark
Office, Patent Trial and Appeal Board in No. IPR2020-
00642.

ON MOTION

Before PROST, *Chief Judge*, LOURIE and CHEN, *Circuit Judges*.

LOURIE, *Circuit Judge*.

O R D E R

Apple Inc. appeals from the Patent Trial and Appeal Board's decisions denying its petitions to institute *inter partes* review ("IPR") after concluding that such review would not be a proper use of resources given parallel district court proceedings. Apple alternatively seeks a writ of mandamus to review those decisions. The Director of the United States Patent and Trademark Office informs the court that he exercises the right under 35 U.S.C. § 143 to intervene, which the court construes as a motion for leave to file the notice of intervention out of time, *see* Fed. R. App. P. 15(d), and files a response urging dismissal.

In response to this court's October 29, 2020 show cause order, Apple reiterates the same arguments in favor of jurisdiction and mandamus that this court recently considered and rejected in *Apple Inc. v. Maxell, Ltd.*, No. 20-2132, slip op. at 2 (Fed. Cir. Oct. 30, 2020) and more generally in *Cisco Systems Inc. v. Ramot at Tel Aviv University Ltd.*, Appeal Nos. 2020-2047, -2049 (Fed. Cir. Oct. 30, 2020). For the same reasons set forth in those decisions, we conclude that this court lacks jurisdiction over Apple's appeals and must deny Apple's requests for mandamus.

Accordingly,

IT IS ORDERED THAT:

- (1) The Director's motion to intervene is granted. The Director is added as an intervenor and the revised official captions are reflected above.
- (2) The appeals are dismissed.
- (3) The requests for mandamus are denied.

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APPLE INC. v. OPTIS CELLULAR TECHNOLOGY, LLC

(4) Each side shall bear its own costs.

FOR THE COURT

December 21, 2020
Date

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

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CERTIFICATE OF SERVICE

I hereby certify that, on this 26th day of January 2021, I filed the foregoing with the Clerk of the United States Court of Appeals for the Federal Circuit via the CM/ECF system, which will send notice of such filing to all registered CM/ECF users.

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**CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME
LIMITATIONS**

The foregoing filing complies with the relevant type-volume limitation of the Federal Rules of Appellate Procedure and Federal Circuit Rules because:

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January 26, 2021