

No. 2020-1601

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

**SLING TV, L.L.C., SLING MEDIA, L.L.C., DISH NETWORK L.L.C., DISH
TECHNOLOGIES L.L.C.,**

Appellants,

v.

REALTIME ADAPTIVE STREAMING LLC,

Appellee,

**ANDREW HIRSHFELD, Performing the Functions and Duties of
the Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office,**

Intervenor.

2020-1601

APPEAL FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE,
PATENT TRIAL AND APPEAL BOARD IN NOS. IPR2018-01331

APPELLANTS' PETITION FOR REHEARING EN BANC

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Dated: April 29, 2021

DISH AMENDED CERTIFICATE OF INTEREST

Counsel for Appellants Sling TV L.L.C., Sling Media L.L.C., DISH Network L.L.C., DISH Technologies L.L.C. certifies the following:

1. Provide the full names of all entities represented by undersigned counsel in this case.

Sling TV L.L.C., Sling Media L.L.C., DISH Network L.L.C., DISH Technologies L.L.C.

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. 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.

DISH Network L.L.C.:	DISH DBS Corporation DISH Orbital Corporation DISH Network Corporation
DISH Technologies L.L.C.:	DISH Technologies Holding Corporation DISH Network L.L.C. DISH DBS Corporation DISH Orbital Corporation DISH Network Corporation
Sling Media L.L.C.:	DISH Technologies L.L.C. DISH Technologies Holding Corporation DISH Network L.L.C. DISH DBS Corporation DISH Orbital Corporation DISH Network Corporation

Sling TV L.L.C.:	Sling TV Holding L.L.C. DISH Technologies L.L.C. DISH Technologies Holding Corporation DISH Network L.L.C. DISH DBS Corporation DISH Orbital Corporation DISH Network Corporation
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4. 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).

None

5. 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).

Realtime Adaptive Streaming, LLC v. Sling TV L.L.C., Case No. 1:17-cv-02097-RBJ (D. Colo). This co-pending district court case involves the '610 patent at issue in the present appeal of an inter partes review proceeding. The district court case had been stayed when this appeal was filed, but the district judge recently terminated the stay and set the case for trial in August 2021.

Realtime Adaptive Streaming v. Netflix, Inc., No. 20-1603 (Fed. Cir.);
Realtime Adaptive Streaming v. Google LLC, No. 20-1809 (Fed. Cir.)

6. 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).

N/A

Dated: April 29, 2021

/s/ Ruffin B. Cordell
Ruffin B. Cordell

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STATEMENT OF COUNSEL

Based on my professional judgment, I believe the panel decision is contrary to the following decisions of the Supreme Court of the United States and the precedent of this Court:

- *Thryv, Inc. v. Click-To-Call Techs., LP*, 140 S. Ct. 1367, 1374 (2020);
- *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348 (2018);
- *Tokyo Kikai Seisakusho, Ltd. v. United States*, 529 F.3d 1352 (Fed. Cir. 2008).

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

- Whether the Board may terminate an instituted IPR proceeding on the eve of a merits-based final written decision to reassess institution when 35 U.S.C. § 314(d) instructs that a decision to institute is “final”?

Dated: April 29, 2021

/s/ Ruffin B. Cordell
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DISH Network L.L.C.,
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I. INTRODUCTION

DISH successfully petitioned for IPR of Realtime’s ’610 patent. The post-trial, merits-based final written decision was about to issue. At that late stage, the same Board panel that instituted IPR terminated the proceeding. The Board flip-flopped to find that the proceeding was time barred under 35 U.S.C. § 315(b), even though it explicitly reached the exact opposite conclusion when it instituted IPR.

This appeal requested that the panel construe and apply 35 U.S.C. § 314(d), which mandates that institution decisions are both “*final* and nonappealable.”¹ On appeal, however, the merits panel declined to construe the statute and hold the Board to this statutory directive. Instead, the panel applied a line of cases that collapses the meaning of § 314(d)’s statutory dictates, “final and nonappealable,” to just mean “nonappealable,” concluding that this Court lacks jurisdiction over the Board’s termination. That conclusion conflicts with the Supreme Court’s decisions in *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348 (2018), and *Thryv, Inc. v. Click-To-Call Techs., LP*, 140 S. Ct. 1367, 1374 (2020), which hold that this Court has jurisdiction to review how an instituted IPR proceeds. The panel decision stands further at odds with Supreme Court precedent that the term “final” is binding on the executive agency itself and does not mean “nonappealable.” *Shaughnessy v. Pedreiro*, 349 U.S. 48, 51 (1955).

¹ Unless otherwise noted, all emphasis herein is added.

The panel’s conclusion that the termination was merely a reconsidered institution decision is also fundamentally flawed, as the IPR statute sets strict deadlines for when an institution decision must issue. The Board’s termination came well after that window closed. It also elevates form over substance, which is particularly inappropriate as *Thryv* explains how Congress crafted the IPR statutes to encourage resolution of patent validity on the merits.

Allowing the panel’s ruling to stand effectively insulates the Board from review of any final determination upholding patent validity. Rather than issue a final written decision, in future cases, the Board could simply terminate the proceeding—like it did here—and evade review. It would also create dual circuit splits: an intra-Circuit split with this Court’s *Tokyo* decision, and an inter-circuit split with the Fifth Circuit in *Macktal*, both holding that any implied authority for an agency rehearing must yield to a statute directing otherwise, like § 314(d) here.

This case presents significant legal questions with profound consequences. The Court should rehear this case en banc to construe § 314(d), reverse the Board’s termination, and overrule past decisions of this Court. Those decisions are improperly applied on the facts of this appeal to rewrite § 314(d) to grant the Board limitless inherent authority to revisit institution decisions that does not exist because the statute compels that they are “final.”

II. BACKGROUND

In July 2018, Appellants Sling TV L.L.C., Sling Media L.L.C., DISH Network L.L.C., and DISH Technologies L.L.C. (collectively, “DISH”) filed an IPR petition against Appellee Realtime Adaptive Streaming, LLC’s U.S. Patent No. 8,867,610. Appx700-785. Realtime’s preliminary patent owner response urged the Board not to institute review, arguing that DISH’s petitions were time-barred under 35 U.S.C. § 315(b). Appx3277. Realtime’s argument was premised on a district court complaint served by a non-owner of the challenged patents, which undisputedly lacked standing and which later dismissed the case voluntarily for want of ownership. Appx3392.²

The Board instituted review, agreeing with DISH that § 315(b) (“Patent Owner Action”) did not bar review based on the defective non-patent owner complaint. Appx3652-3665. Realtime did not request rehearing on institution. The IPR proceeded in its usual manner with the Board conducting its typical IPR trial. Appx4599-4657.

Meanwhile, in a subsequent IPR with a different patent and parties, the Patent Office’s Precedential Opinion Panel (“POP”) determined that a complaint served by a party without standing starts the § 315(b) time bar clock. *See GoPro, Inc. v. 360heros, Inc.*, No. IPR2018-01754, 2019 WL 3992792 (P.T.A.B. Aug. 23, 2019). Having foregone its opportunity to petition for rehearing of institution, *see* 37 C.F.R. § 42.71(d)(1), Realtime instead filed a motion to terminate the ’610 patent IPR, making the same arguments

²Appellee Realtime (the patent owner) later served a complaint on Appellants. Appx3393. Appellants filed the IPR nine months thereafter. *Id.*

that the Board rejected at institution but now citing the POP *GoPro* decision. Appx4402-4412. DISH opposed, arguing that the Board must proceed to final written decision upon instituting an IPR. Appx4438-4441.

Following the IPR trial, the Board completely reversed course, finding this time that the petition was time-barred under § 315(b). Appx1-10. It held that § 315(b) (“Patent Owner Action”) is triggered by a non-patent-owner action alleging patent infringement. Appx4-7; Appx14-18. Hence, the Board terminated the proceeding without issuing a final written decision.

DISH’s appeal argued that 35 U.S.C § 314(d)—which makes institution decisions “final”—prohibits the panel from terminating the instituted proceeding during the merits phase. DISH also argued that the Supreme Court’s *SAS* and *Thryv* decisions specifically recognized this Court’s jurisdiction to review how an *instituted* IPR “proceeds.” *Thryv*, 140 S. Ct. 1367 at 1376; *SAS*, 138 S. Ct. at 1359. The panel declined to find jurisdiction. Without analyzing the impact of the term “final” in § 314(d), it held that the Board may revisit its nonappealable institution decision at any time. Panel Op. 3-4.

III. ARGUMENT

A. The IPR Statute Establishes That the Board May Not Upend Instituted IPR Proceedings

1. Section 314(d) Defines Institution Decisions as “Final,” Separate From “Nonappealable”

Under the IPR statutes, a non-patent owner (i.e., the petitioner) files a petition seeking IPR, 35 U.S.C. § 311(a), and the Director determines whether to institute an IPR, *id.* § 314(b).³ But once the agency decides whether to institute, that determination “shall be *final* and nonappealable.” 35 U.S.C. § 314(d). Congress therefore unambiguously imposed two *distinct* limitations on the Board’s institution decision in § 314(d). First, it is “final.” *Id.* Second, but separately, it is “nonappealable.” *Id.*

The plain and unambiguous statutory command: “final,” bars the Board from revisiting its determination on whether to institute the IPR once the proceeding is underway. Thus, a straightforward application of the IPR statute prohibited the Board’s termination of this IPR based on the § 315(b) time-bar issue—an argument that it had duly rejected almost twelve months earlier in the “final” institution decision.

The panel did not reach this conclusion, however. By disposing of DISH’s appeal on jurisdictional grounds, the panel ignored DISH’s main argument regarding what it means for an institution decision to be “final”—separate and distinct from

³ The Director has delegated that authority to the Board. 37 C.F.R. § 42.4(a).

“nonappealable.” Panel Op. 3-4. Instead, the panel conflated the terms, assuming that both do nothing more than preclude appeal of an institution decision.

But by adding the word “final” to § 314(d) in addition to “nonappealable,” Congress added meaning. *See Bennett v. Spear*, 520 U.S. 154, 173 (1997) (explaining the “cardinal principle of statutory construction . . . to give effect, if possible, to every clause and word of a statute” (citations omitted)). Otherwise the term “final” becomes surplusage, a result disfavored when interpreting statutes. *See Dunn v. Commodity Futures Trading Comm’n*, 519 U.S. 465, 472 (1997) (“[L]egislative enactments should not be construed to render their provisions mere surplusage.”). Indeed, this Court’s other decisions have recognized that the “final” proviso is separate from the “nonappealable” proviso. *See In re Cuozzzo Speed Techs., LLC*, 793 F.3d 1268, 1273 (Fed. Cir. 2015), *aff’d*, 136 S. Ct. 2131 (2016) (“Section 314(d) provides that the decision is **both** ‘nonappealable’ and ‘final,’ i.e., not subject to further review.”).

2. “Final” Relates to Further Agency Review

There is no dispute that “nonappealable” refers to judicial review. “Final” must refer to something **other than** judicial review. And its meaning is apparent in view of Supreme Court precedent, which, in administrative contexts, has interpreted “final” as a **limit on agency review**.

In *Shaughnessy v. Pedreiro*, the Court examined the meaning of “final” in the 1952 Immigration and Nationality Act, which provided that “deportation orders of the Attorney General shall be ‘final.’” 349 U.S. 48, 51 (1955). While the Government

argued that the word “final” precluded judicial review, the Supreme Court disagreed. *Id.* Instead, the Court held that the Immigration Act’s use of the word “final” “referr[ed] to *finality in administrative procedure* rather than as cutting off the right of judicial review in whole or in part.” *Id.*

Shaughnessy’s determination that “final” cuts off administrative review, not judicial review, applies to § 314(d). First, Congress presumably understood earlier Supreme Court precedent, including *Shaughnessy*’s interpretation of “final” in an agency context. *See Midlantic Nat’l Bank v. N.J. Dep’t of Env’tl. Prot.*, 474 U.S. 494, 501 (1986) (holding Congress must be specific when it intends to change judicial interpretation). Second, unlike *Shaughnessy*, Congress here expressly addressed appealability with different language.

Section 314(d) thus reflects Congress’s decision to purposefully cut off *all* review of institution decisions by first precluding the *Board’s* review with the word “final” and then *judicial* review through the added phrase “and nonappealable.”

B. The Panel Erred in Concluding It Lacked Jurisdiction Over This Case

1. SAS and *Thryv* Dictate That Jurisdiction Exists to Review How an Instituted IPR “Proceeds”

The panel sidestepped construing the “final” provision of § 314(d) by concluding that it did not have jurisdiction over this appeal. According to the panel, the § 314(d) proviso making institution decisions “nonappealable” also precludes this Court from reviewing the Board’s termination in the context of how the IPR proceeded. Panel.

Op. 3-4. This is wrong. The Supreme Court firmly established that this Court has jurisdiction in appeals from *instituted* proceedings—like this one—to ensure that they proceed according to law.

SAS, in particular, settled any dispute about whether appellate courts have jurisdiction over instituted proceedings: “[N]othing in § 314(d) or *Cuozzoku* withdraws *our power to ensure that an inter partes review proceeds [post-institution] in accordance with the law’s demands.*” 138 S. Ct. at 1359. Exercising that jurisdiction, the Court held that the petitioner was “*entitled to a final written decision* addressing all of the claims it has challenged” and “*nothing suggests we lack the power to say so.*” *Id.* at 1360.

Thryv further supports jurisdiction by distinguishing between (a) a merits review of an initial decision to institute, for which appeal is barred, and (b) a procedural review of whether an instituted IPR proceeds according to the law, for which appeal is permitted:

[O]nce the agency institutes an *inter partes* review, it must resolve all of the claims in the case [under § 318(a)] . . . **[Section] 314(d) d[oes] not bar judicial review of § 318(a)’s application** . . . to ensure that an *inter partes* review proceeds in accordance with the law’s demands.

Thryv, 140 S. Ct. at 1376 (citing *SAS*, 138 S. Ct. at 1353, 1358-60).

In reaching this distinction, *Thryv* recognizes that IPRs have two phases: institution and trial. *Id.*; see also *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1364-65 (Fed. Cir. 2016) (“IPR proceedings involve *two distinct phases*: (1) the institution

phase . . . and, if instituted, (2) the merits phase.”). The IPR statute establishes this framework, with the institution decision as the gating event between the two phases. *See* 35 U.S.C. §§ 314 (“Institution of inter partes review”), 316 (“Conduct of inter partes review”). *Thryv* differentiates appeals over “whether the agency should have instituted review at all,” which is not appealable under § 314(d), and “the manner in which the agency’s review **‘proceeds’ once instituted,**” which is appealable. 140 S. Ct. at 1376 (2020).

The two-phase framework illustrates the logic behind the “final and nonappealable” proviso. During the institution phase, the agency maintains broad discretion. *SAS*, 138 S. Ct. at 1356 (“§ 314(a) invests the Director with discretion on the question ***whether*** to institute review.” (emphasis in original)). In exercising that discretion, the Director ultimately has “a binary choice—either institute review or don’t.” *Id.* at 1355. But once the Director determines whether to institute, his institution discretion ends. *Thryv*’s essence is that instituting IPR is a gating decision that—along with subsidiary determinations, i.e., applicability of the § 315(b) time bar—may not be revisited during the IPR by the Board or on appeal.⁴

⁴ The Government itself adopted this reasoning in its *Thryv* Supreme Court briefing, arguing that “[b]y making the USPTO’s institution decision ‘final and nonappealable,’ 35 U.S.C. § 314(d), Congress unambiguously expressed its intent that the USPTO should ‘police its own conduct’ ***at the institution phase*** of an inter partes review.” Br. for the Federal Resp’t, *Thryv*, 140 S. Ct. 1367, 2019 WL 4201258, at *26. The Government emphasized that time-bar decisions must be made during the institution phase, not during the trial phase, explaining that the time bar under “[s]ection

Congress had good reason for drafting the statute this way. Congress established IPR proceedings as “a more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs.” *Thryv*, 140 S. Ct. at 1374 (quoting H.R. Rep. No. 112-98, pt. 1, p. 40 (2011)). As *Thryv* describes, Congress enacted § 314(d) to support this goal of efficiently reviewing and eliminating bad patents. *Id.* By limiting both agency and judicial review, Congress made a legislative choice to prioritize “weed[ing] out bad patent claims efficiently” and avoid “wasting the resources spent resolving patentability” by focusing energy on the statute’s ministerial and claim processing rules. *Id.*; see also *Cuozzo Speed Techs., LLC v Lee*, 136 S. Ct. 2131, 2139-40 (2016). Congress wanted the focus of instituted IPRs to be “a thoroughgoing determination about a patent’s validity,” rather than collateral attacks on the decision to institute “that would frustrate efficient resolution of patentability.” *Thryv*, 140 S. Ct. at 1376.

SAS and *Thryv* thus make clear that the Board’s trial phase conduct, i.e., the manner in which the IPR proceeds, is reviewable even if its one-time institution decision is not. So putting aside § 314(d)’s bar on appeal of whether a proceeding should have instituted, once instituted, the Court has jurisdiction over whether the IPR “proceeds” to a final written decision, as the statute commands. *Id.*

315(b) . . . ***does not affect any other aspect of the inter partes review proceeding after institution occurs.***” Br. for the Federal Resp’t in Opp’n, *Thryv*, 140 S. Ct. 1367, 2019 WL 1972722, at *16.

2. The Court Has Jurisdiction Over This Appeal of an Instituted IPR

This appeal is indisputably one where the Board already issued a decision instituting IPR, and thus under *SAS* and *Thryv*, jurisdiction to review exists. The panel’s decision does not dispute that *SAS* and *Thryv* establish jurisdiction over instituted IPRs. Instead, the panel recast the Board’s termination decision as a decision reconsidering institution, or “deinstitution decision,” and equated it to an institution decision. Panel Op. 3-4. This conception of the Board’s termination decision is a flawed premise for several reasons.

The plain terms of the statute and the Board’s rules, enacted under notice-and-comment rulemaking, prevent the panel’s conception of the Board’s decision as one on institution. Section 314(b) requires a decision on “whether to institute an inter partes review” within three months of either receiving the patent owner’s preliminary response to a petition or the deadline for this preliminary response lapsing. As already noted, the Board waited almost twelve months after the institution decision—and fourteen months after Realtime served its preliminary response—to terminate. Further, the Board’s rules only give parties fourteen days to request rehearing institution. 37 C.F.R. § 42.71(d)(1). Recasting the termination decision as a fourteenth-month institution decision ignores the clear violation of § 314(b)’s three-month time limit. The post-trial termination decision thus cannot be, and is not, a decision whether to institute IPR.

Treating the Board's termination as a renewed institution decision also frustrates Congress's goals for IPR. Over twelve months, the parties and the Board expended significant resources moving towards a "thoroughgoing determination" on patent validity during the IPR's trial phase. *Thryv*, 140 S. Ct. at 1376. The termination decision swept all of that away, "wasting the resources spent resolving patentability." *Id.* Despite the fact that "Congress prioritized patentability over § 315(b)'s timeliness requirement," *id.*, the untimely termination decision necessarily undermined resolution of patentability by applying the § 315(b) time bar on the eve of a final written decision. As such, the unreasonable timing of the termination decision renders it incapable of being a valid reconsideration of institution.

If the panel's characterization of the Board's termination decision stands, it allows the Board the untoward ability to evade review in any IPR where it finds a challenged patent valid. That is, in any IPR that proceeds through the trial phase and is on the verge of a final written decision, the Board could simply issue a "deinstitution decision" rather than a final written decision on the merits. Doing so would effectively confirm validity of the patent, but eliminate appellate scrutiny, which cuts against "the strong presumption that Congress intends judicial review of administrative action," *Bowen v. Mich. Acad. of Family Physicians*, 476 U.S. 667, 670 (1986).

The panel's decision attempted to navigate *Thryv* by holding that the Court's "precedent equating a deinstitution decision with an initial decision to deny institution" was not "implicitly overruled" by *Thryv*. Panel Op. 4. That is not, however, what DISH

has argued. Instead, DISH’s argument is that *Thryv* recognizes that jurisdiction exists over instituted IPRs, like this one. To assess its jurisdiction, the Court also needed to construe “final” in § 314(d) to recognize that the termination order here, nearly twelve months post-institution, cannot have been a non-appealable institution decision because “final” means “final”—just as the Supreme Court instructed in *Shaughnessy*.

Thus, there can be no doubt that the Board’s termination decision was just that, and not a decision reconsidering institution. Under *SAS* and *Thryv*, this Court has jurisdiction to review how that instituted IPR proceeded. At the very least, for the panel to bless the Board’s decision to issue a “deinstitution decision” following institution, that necessarily required the panel to construe the meaning of “final” in § 314(d). Since this Court “has inherent jurisdiction to determine its own jurisdiction,” it should have resolved the threshold question of the meaning of the word “final,” yet it did not. *C.R. Bard, Inc. v. Schwartz*, 716 F.2d 874, 877 (Fed. Cir. 1983).

C. The Precedent the Panel Relied Upon Must Be Set Aside

In recasting the Board’s termination as a decision on institution, the panel cited a series of this Court’s related pre-*Thryv* decisions: *Medtronic, Inc. v. Robert Bosch Healthcare Systems, Inc.*, 839 F.3d 1382, 1383 (Fed. Cir. 2016); *GTNX, Inc. v. INTTRA, Inc.*, 789 F.3d 1309, 1311–13 (Fed. Cir. 2015); and *BioDelivery Sciences Int’l, Inc. v. Aquestive Therapeutics, Inc.*, 935 F.3d 1362, 1366 (Fed. Cir. 2019). Panel Op. 3. If these cases

permit the Board’s limitless reconsideration of IPR institution—which is the consequence of the panel’s ruling—they must be reconsidered en banc and reversed.⁵

As an initial matter, these cases violate the very precedent upon which they stand, establishing an intra-Circuit split. Each case cites *Tokyo Kikai Seisakusho, Ltd. v. United States*, 529 F.3d 1352 (Fed. Cir. 2008), for the proposition that a tribunal has inherent authority to reconsider its decisions. See *Medtronic*, 839 F.3d at 1385 (quoting *Tokyo*, 529 F.3d at 1360); *GTNX*, 789 F.3d at 1313 (same); *BioDelivery*, 935 F.3d at 1366 (same). *Tokyo*, however, explained several “uncontroversial” limits on an agency’s authority to reconsider its decisions:

- 1) “[a]n agency cannot . . . exercise its inherent authority in a manner that is contrary to a statute”; and
- 2) when available at all, “reconsideration must occur within a reasonable time.”

Tokyo, 529 F.3d at 1361. These limits circumscribe any inherent reconsideration authority relating to institution, and the termination decision violated both of them.

First, the Court in *Tokyo* explained, “[a]n agency cannot . . . exercise its inherent authority in a manner that is contrary to a statute” and “[t]hus, ***an agency obviously lacks power to reconsider where a statute forbids the exercise of such power.***”

Id. Here, § 314(d) requires that institution decisions “shall be ***final*** and nonappealable.”

⁵ The panel’s citations to *Mylan Laboratories Ltd. v. Janssen Pharmaceutica, N.V.*, 989 F.3d 1375 (Fed. Cir. 2021), are misplaced. *Mylan* was indisputably a direct appeal from an institution decision, *id.* at 1377, whereas here DISH argues the termination decision was not an institution decision.

The cases the panel cited did not ascribe meaning to the “final” proviso. Inherent authority must give way to this clear statutory directive, which extinguishes any inherent authority the Board would have otherwise had to reconsider institution decisions.

An instructive case for this point is *Macktal v. Chao*, 286 F.3d 822 (5th Cir. 2002), which *Tokyo* cites with favor. *See Tokyo*, 529 F.3d at 1360-61. In holding that agencies may revisit their earlier decisions, with certain limitations, the *Macktal* court distinguished *Brennan v. Occupational Safety & Health Review Commission*, 502 F.2d 30 (5th Cir. 1974). *Macktal* explained that in *Brennan*, the agency “did not have authority to reconsider an order that had become final under the Occupational Safety and Health Act” because the statute provided that “a hearing examiner’s report **shall** become the **final** order of the Commission unless within thirty days” further review was requested. *Macktal*, 286 F.3d at 826. “Under that statutory scheme . . . once the thirty-day review period had expired and the order had become **final**, no further consideration **by the Commission** was allowed.” *Id.*; *see Brennan*, 502 F.2d at 32.

The same logic applies here. Congress provided that institution decisions are “final.” § 314(d). Realtime did not request rehearing, and thus the statute forecloses Board reconsideration. Failing to recognize that the statute limits the Board’s inherent authority places this Court in a circuit split with the Fifth Circuit’s *Macktal* decision.

Second, the Board’s termination violates *Tokyo*’s other “uncontroversial” limitation on the Board’s reconsideration authority, that “reconsideration must occur within a reasonable time.” *Tokyo*, 529 F.3d at 1361. Here, almost twelve months passed

since institution, and the IPR was beyond the IPR trial, Appx4599-4657, and just shy of the statutory deadline requiring a final determination within one year from institution. 35 U.S.C. § 316(a)(11).

Moreover, § 314(b) requires that institution decisions occur within three months of a patent owner's preliminary response. Yet, this proceeding was fourteen months removed from that pleading. 35 U.S.C. § 314(b). Section 314(b) represents the outer edge of what Congress considered to be a "reasonable" period of time to make an institution determination. The Board's rules only give parties fourteen days to request rehearing after a decision to institute. 37 C.F.R. § 42.71(d)(1). If *this* reconsideration can be deemed reasonable, which the panel decision blesses, then *Tokyo* and *Macktal's* "reasonableness" requirement would be meaningless.

Thus, the precedents the panel relies upon extend *Tokyo* beyond its express limitations, making them inconsistent with *Tokyo*. And by failing to heed to *Tokyo's* "uncontroversial" limitation that agencies do not enjoy inherent authority to reconsider where otherwise barred by statute, this Court departs from other circuits, such as the Fifth Circuit. *See Macktal*, 286 F.3d at 826. En banc review must be granted to correct this legal error and bring this Court's precedent back into line with other circuits and that of the Supreme Court.

IV. CONCLUSION

For the foregoing reasons, Appellants request that the Court rehear this appeal en banc and reverse the Board's termination.

Dated: April 29, 2021

Respectfully submitted,

/s/ Ruffin B. Cordell

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Addendum

NOTE: This disposition is nonprecedential.

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

**SLING TV, L.L.C., SLING MEDIA, L.L.C., DISH
NETWORK L.L.C., DISH TECHNOLOGIES L.L.C.,**
Appellants

v.

REALTIME ADAPTIVE STREAMING LLC,
Appellee

**ANDREW HIRSHFELD, PERFORMING THE
FUNCTIONS AND DUTIES OF THE UNDER
SECRETARY OF COMMERCE FOR
INTELLECTUAL PROPERTY AND DIRECTOR OF
THE UNITED STATES PATENT AND TRADEMARK
OFFICE,**
Intervenor

2020-1601, 2020-1602

Appeals from the United States Patent and Trademark
Office, Patent Trial and Appeal Board in Nos. IPR2018-
01331, IPR2018-01342.

Decided: March 16, 2021

RUFFIN B. CORDELL, Fish & Richardson P.C., Washington, DC, argued for appellants. Also represented by MICHAEL JOHN BALLANCO, BRIAN JAMES LIVEDALEN, MATTHEW MOSTELLER, ADAM SHARTZER.

PHILIP WANG, Russ August & Kabat, Los Angeles, CA, argued for appellee. Also represented by C. JAY CHUNG, REZA MIRZAIE, NEIL RUBIN.

MICHAEL S. FORMAN, Office of the Solicitor, United States Patent and Trademark Office, Alexandria, VA, argued for intervenor. Also represented by THOMAS W. KRAUSE, FARHEENA YASMEEN RASHEED, PETER JOHN SAWERT.

Before TARANTO, CHEN, and STOLL, *Circuit Judges*.

TARANTO, *Circuit Judge*.

Sling TV, LLC, Sling Media, LLC, Dish Network, LLC, and Dish Technologies, LLC (together, Sling) directly appeal the Patent Trial and Appeal Board's determination to deinstitution two inter partes review proceedings, IPR2018-01342 and IPR2018-01331, which involve, respectively, U.S. Patent Nos. 8,934,535 and 8,867,610, owned by Realtime Adaptive Streaming, LLC. See J.A. 11–24 (Jan. 17, 2020 deinstitution in IPR2018-01342); J.A. 1–9 (Jan. 17, 2020 deinstitution in IPR2018-01331). Sling also alternatively petitions for a writ of mandamus. We dismiss in part and deny in part.

This court's docket No. 20-1602 is Sling's direct appeal and mandamus petition challenging the Board's actions in IPR2018-01342, which involves the '535 patent. The dispute in No. 20-1602 is moot because, in separate proceedings, all patent claims at issue in this matter have already been finally determined to be unpatentable (Realtime dropped its appeals from the Board decisions so

determining) and are now set for the ministerial act of cancellation under 35 U.S.C. § 318(b). See *Netflix, Inc. v. Realtime Adaptive Streaming, LLC*, No. IPR2018-01169, 2020 WL 120083, at *1 (P.T.A.B. Jan. 10, 2020); No. 20-1603, ECF No. 30 (Fed. Cir. Sept. 14, 2020) (Netflix); *Google LLC v. Realtime Adaptive Streaming, LLC*, No. IPR2018-01342, 2020 WL 959190, at *1 (P.T.A.B. Feb. 27, 2020); No. 20-1809, ECF No. 25 (Fed. Cir. Oct. 1, 2020) (Google and Comcast). We therefore dismiss both the appeal and the mandamus petition in No. 20-1602.

This court's docket No. 20-1601 is Sling's direct appeal and mandamus petition challenging the Board's decision to deinstitution IPR2018-01331, which involves the '610 patent. We have held that the Board has the inherent authority to reconsider institution decisions (beyond the regulatory time for a patentee's entitlement to seek reconsideration) and that a resulting decision to deinstitution is, like an original decision not to institute, "final and nonappealable" under 35 U.S.C. § 314(d). See, e.g., *Medtronic, Inc. v. Robert Bosch Healthcare Systems, Inc.*, 839 F.3d 1382, 1383 (Fed. Cir. 2016); *GTNX, Inc. v. INTTRA, Inc.*, 789 F.3d 1309, 1311–13 (Fed. Cir. 2015); *BioDelivery Sciences Int'l, Inc. v. Aquestive Therapeutics, Inc.*, 935 F.3d 1362, 1366 (Fed. Cir. 2019). Section 314(d)'s rule of nonappealability, we have also held, confirms the general unavailability of jurisdiction under 28 U.S.C. § 1295(a)(4) to hear an appeal from a decision not to institute. See *Mylan Labs. Ltd. v. Janssen Pharmaceutica, N.V.*, No. 2021-1071, 2021 WL 936345, at *2–3 (Fed. Cir. Mar. 12, 2021). As for a mandamus petition challenging a decision not to institute, we recently held that this court has jurisdiction to entertain such a petition under 28 U.S.C. § 1651, see *Mylan*, 2021 WL 936345, at *3–5, but we made clear that, given the commitment of non-institution decisions to agency discretion, we did not foresee the strict mandamus standards for granting relief being met except by constitutional claims, *id.* at *5–6.

In this matter, we see no basis for a disposition different from the one in *Mylan*: We dismiss the appeal and deny the mandamus petition. Sling has not shown that our precedent equating a deinstitution decision with an initial decision to deny institution was implicitly overruled by the Supreme Court in *Thryv, Inc. v. Click-To-Call Technologies, LP*, 140 S. Ct. 1367 (2020), which did not involve or address such a deinstitution decision, or by our decision in *Arthrex, Inc. v. Smith & Nephew, Inc.*, 880 F.3d 1345 (Fed. Cir. 2018), which could not overrule our precedent and did not involve a deinstitution decision (under 37 C.F.R. § 42.72) but entry of an adverse judgment (under 37 C.F.R. § 42.73). Nor has Sling presented a colorable constitutional claim. And Sling likewise has not identified a non-constitutional claim that newly suggests a persuasive justification for granting mandamus or for providing an available basis for direct-appeal jurisdiction that we did not foresee in *Mylan*: Sling's challenges here, as in *Mylan*, are to an exercise of discretion not to institute. *See* J.A. at 5, 8 (exercising discretion, even aside from any binding Board precedent); J.A. 15–18 (same). In these circumstances, we dismiss Sling's appeal and deny its petition in No. 20-1601.

DISMISSED IN PART AND DENIED IN PART

CERTIFICATE OF SERVICE

I certify that on April 29, 2021, I electronically filed the foregoing Appellants' Petition for Rehearing En Banc using the Court's CM/ECF filing system. Counsel for Appellee and Intervenor were electronically served by and through the Court's CM/ECF filing system per Fed. R. App. P. 25 and Fed. Cir. R. 25.

/s/ Ruffin B. Cordell

Ruffin B. Cordell

CERTIFICATE OF COMPLIANCE

Appellants' Petition for Rehearing En Banc is submitted in accordance with the type-volume limitation of Fed. R. App. P. 35(b)(2), Fed. R. App. P. 32(a), (f) & (g), and Fed. Cir. R. 32(b). The Brief contains 3,894 words, excluding the parts of the brief exempted by Fed. R. App. P. 32(f) and Fed. Cir. R. 32(b). This Brief has been prepared in a proportionally spaced typeface using Microsoft Word in Garamond, 14 Point.

Dated: April 29, 2021

/s/ Ruffin B. Cordell

Ruffin B. Cordell