

**Nos. 2021-1614, -1616, -1617; 2021-1673, -1674, -1675; 2021-1676, -1677;
2021-1738, -1739; 2021-1740, -1741**

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

INTEL CORPORATION,

Appellant,

v.

VLSI TECHNOLOGY 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.

2021-1614, -1616, -1617

Appeals from the United States Patent and Trademark Office, Patent Trial and
Appeal Board in Nos. IPR2020-00106, IPR2020-00158, and IPR2020-00498

INTEL CORPORATION,

Appellant,

v.

VLSI TECHNOLOGY 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.

2021-1673, -1674, -1675

Appeals from the United States Patent and Trademark Office, Patent Trial and
Appeal Board in Nos. IPR2020-00112, IPR2020-00113, and IPR2020-00114

INTEL CORPORATION,

Appellant,

v.

VLSI TECHNOLOGY 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.

2021-1676, -1677

Appeals from the United States Patent and Trademark Office, Patent Trial and
Appeal Board in Nos. IPR2020-00141 and IPR2020-00142

INTEL CORPORATION,

Appellant,

v.

VLSI TECHNOLOGY 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.

2021-1738, -1739

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INTEL CORPORATION,

Appellant,

v.

VLSI TECHNOLOGY 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.

2021-1740, -1741

Appeals from the United States Patent and Trademark Office, Patent Trial and
Appeal Board in Nos. IPR2020-00582 and IPR2020-00583

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June 21, 2021

CERTIFICATE OF INTEREST

Counsel for Appellant Intel Corporation. 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.

Intel Corporation

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).

WILMER CUTLER PICKERING HALE AND DORR LLP: Richard Goldenberg, R. Gregory Israelsen, Mary (“Mindy”) V. Sooter, David L. Cavanaugh, Daniel S. Perry

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).

VLSI Technology LLC v. Intel Corp., No. 1:19-cv-00977 (W.D. Tex.)

VLSI Technology LLC v. Intel Corp., No. 6:19-cv-00254 (W.D. Tex.)

VLSI Technology LLC v. Intel Corp., No. 6:19-cv-00255 (W.D. Tex.)

VLSI Technology LLC v. Intel Corp., No. 6:19-cv-00256 (W.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: June 21, 2021

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STATEMENT OF COUNSEL

Based on my professional judgment, I believe the panel's 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, or was adopted without observance of procedure required by law.

/s/ Gregory H. Lantier
GREGORY H. LANTIER

INTRODUCTION

Intel challenges decisions by the Patent Trial and Appeal Board (“Board”) denying Intel’s petitions for inter partes review (“IPR”) of patents asserted against Intel 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. Intel argues that the Board’s denial of its IPR petitions was unlawful because the *NHK-Fintiv* rule applied by the Board exceeds the Office’s statutory authority, is arbitrary and capricious, and violates the rulemaking requirements of the Administrative Procedure Act (“APA”).

Relying on the prior precedential ruling by a motions panel of this Court in *Mylan Laboratories Ltd. v. Janssen Pharmaceutica, N.V.*, 989 F.3d 1375 (Fed. Cir. 2021), the motions panel here dismissed Intel’s appeals for lack of jurisdiction under 28 U.S.C. §1295(a)(4)(A) and 35 U.S.C. §314(d). *Mylan* reasoned that those provisions permit appellate review of an institution decision only on appeal from a final written decision issued after IPR. That ruling conflicts with Supreme Court precedent, heightens 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; (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 increases intra-circuit confusion. Before *Cuozzo*, this Court had 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 after *Cuozzo*, this Court held in *Arthrex, Inc. v. Smith & Nephew, Inc.*, 880 F.3d 1345, 1348-1349 (Fed. Cir. 2018), 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. *Mylan* asserted that there was no conflict between *St. Jude* and *Arthrex*, even though both *Arthrex* and *Mylan* itself elsewhere in the decision rejected *St. Jude*’s central premise—that §1295(a)(4)(A) creates jurisdiction only for appeals from final written decisions. *Mylan* thus leaves Circuit law regarding the scope of jurisdiction under §1295(a)(4)(A) even muddier than it was after *Arthrex*.

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 Intel and other leading innovators of the efficient patent-review process that Congress viewed as integral to the patent system. The 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.¹

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. Intrix-Plex Technologies, Inc.*, the Board declared: “[T]he advanced state of ... district court proceeding[s]” is an “additional factor that

¹ Before this Court decided *Mylan*, it denied rehearing petitions in two other cases raising related issues. See Order, *Apple Inc. v. Optis Cellular Tech., LLC*, No. 21-1043, ECF No. 22 (Feb. 26, 2021); Order, *Apple Inc. v. Maxell, Ltd.*, No. 20-2132, ECF No. 49 (Feb. 22, 2021).

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).² 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 twelve IPR petitions Intel filed challenging patent claims that VSLI Technology LLC asserted in infringement litigation against Intel. *VLSI Tech. LLC v. Intel Corp.*, Nos. 19-cv-254, 19-cv-255, 19-cv-256, 19-cv-977 (W.D. Tex.). Intel’s appeals seek remand for the Board to reconsider the petitions without

² <https://www.uspto.gov/sites/default/files/documents/SOP2%20R10%20FINAL.pdf>.

applying the *NHK-Fintiv* rule, which Intel challenges as unlawful because: (1) the Office lacks authority under the AIA to deny timely IPR petitions based on overlapping infringement litigation; (2) the rule’s factors are arbitrary and capricious in violation of the APA because they call for speculation about district court proceedings, undermine the rule’s ostensible efficiency goal, and yield inconsistent results; and (3) the rule was adopted without the notice-and-comment rulemaking that the APA requires. No. 21-1614 Dkt. No. 17, at 8-12.

After Intel appealed to this Court to review the denials, VLSI moved to dismiss for lack of jurisdiction, citing the nonprecedential order in *Cisco Systems Inc. v. Ramot at Tel Aviv University Ltd.*, 834 F. App’x 571 (Fed. Cir. 2020). That decision was subsequently subsumed by this Court’s precedential order in *Mylan*, which dismissed an appeal like Intel’s on the grounds that appeal was barred by §314(d) and that mandamus was inappropriate. 989 F.3d 1375. In *Mylan*, this Court recognized that its jurisdiction in an appeal like these would be free from doubt if §1295(a)(4)(A) stood alone. *Id.* at 1378. But it concluded that “§314(d), the more specific statute, dispels any such notion.” *Id.*

Intel opposed VLSI’s motion to dismiss, arguing that *Mylan* was decided incorrectly. Intel explained that under Supreme Court precedent, judicial review remains available despite §314(d) “[i]f a party believes’ the PTO’s decision ‘exceed[ed] its statutory bounds’ or was ‘arbitrary or capricious,’ or ‘where the

grounds for attacking the decision’ raise questions that are not ‘closely tied to the application and interpretation of statutes related to the Patent Office’s decision to initiate inter partes review.’” No. 21-1614 Dkt. No. 17, at 1, 6-7 (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). Consequently, Intel argued, §314(d) did not bar its appeals because its grounds for appeal are that the *NHK-Fintiv* rule the Board applied to deny Intel’s petitions exceeds the Office’s authority under the AIA, is arbitrary and capricious, and was adopted in violation of the APA, which is a statute unrelated to institution. No. 21-1614 Dkt. No. 17, at 6-14.

Mylan had said that these limits on the scope of §314(d) apply only to “an appeal from a final written decision—not an institution decision.” 989 F.3d at 1378. In its opposition to the motion to dismiss, Intel explained why *Mylan* was incorrect. No. 21-1614 Dkt. No. 17, at 14-20. The motions panel, however, dismissed Intel’s appeals, concluding that the Court lacks jurisdiction “[f]or the same reasons” stated in *Mylan*. Dkt. No. 21 at 5.

ARGUMENT

I. THE RULING CONTRADICTS SUPREME COURT PRECEDENT IN CONCLUDING THAT §314(d) MAY BE AVOIDED ONLY IF THE APPEAL ARISES FROM A FINAL WRITTEN DECISION

The panel 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” (emphasis added)—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 because that view “reads into the provision a limitation ... that the language nowhere mentions.” 136 S. Ct. at 2140. Thus, §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 the appeals argue that the Office’s action exceeded its authority, was arbitrary and capricious, or violated the APA. Rather, those limits derive from the scope of review under the APA and the background principle that statutory bars on judicial review do not preclude review of ultra vires actions. *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)); *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). Neither rationale turns on whether a challenge arises in the context of a final written decision after institution.

SAS is particularly instructive. *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.* After the Board rendered a final written decision on only the claims for which it had instituted IPR, *SAS* appealed, “contend[ing] that the Director exceeded his statutory authority by limiting the review to fewer than all of the claims *SAS* challenged.” *Id.* at 1359. The Director, *SAS* argued, was required “to decide the patentability of *every* claim *SAS* challenged in its petition, not just some.” *Id.* at 1354. The Director countered that §314(d) “foreclos[ed] judicial review of any legal question bearing on the institution of inter partes review.” *Id.* at 1359.

The Supreme Court rejected the Director’s position, holding in *SAS* that “nothing in §314(d) or *Cuozzo* withdraws our power to” hear *SAS*’s appeal. 138 S. Ct. at 1359. Although the appeal in *SAS* arose from a final written decision, that posture was irrelevant to the Court’s analysis. *See id.* In fact, *SAS* forecloses *Mylan*’s position that the limits on the scope of §314(d) identified in *Cuozzo* and

applied in *SAS* have effect only for appeals from final written decisions. 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) in only one narrow situation that, according to *SAS*, Congress intended never to occur—*i.e.*, cases of partial institution. In other words, because partial institution can never occur (per *SAS*), the limits on §314(d)’s bar on review of non-institution decisions would be, under *Mylan*’s reading, a null set. Nothing in the text or history of §314(d) or in the Supreme Court’s interpretation of that provision suggests those limits should apply only to review of decisions affirmatively to institute IPR; indeed, *SAS* applied those limits to review the *refusal* to institute IPR on certain patents. 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.³

³ The presence of a final written decision can be relevant to reviewability if it supplies the final agency action ordinarily required for judicial review. *See 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.

Mylan stated that jurisdiction in *Cuozzo* and *SAS* was established under 35 U.S.C. §319, which expressly authorizes appeal from a final written decision, and therefore “there was no reason [for the Supreme Court] to consider how §314(d) affects §1295(a)(4).” 989 F.3d at 1379. That is a distinction without a difference. Section 314(d) does not purport to apply differently to cases arising under §319 or §1295(a)(4). Thus, as long as the appeal is within the scope of §1295(a)(4)—and Intel’s appeals are—the limits on §314(d) that the Supreme Court has identified apply just the same.

Mylan also stated that “decisions denying institution” are different because they are ““committed to agency discretion”” and therefore “unreviewable.” *Mylan*, 989 F.3d at 1379 (quoting *Cuozzo*, 136 S. Ct. at 2140). That argument fails for several reasons. First, that could not justify a different scope for §314(d), whose text, again, does not distinguish between decisions to institute and decisions not to institute, but rather refers neutrally to decisions “whether to institute.” §314(d).

Second, as an independent basis for denying review, it is incorrect. For starters, whether an agency action is “committed to agency discretion by law” goes to the merits of the claim, not to jurisdiction. *See* 5 U.S.C. §701(a)(2); *Stewart v. McPherson*, 955 F.3d 1102, 1104 (D.C. Cir. 2020). Moreover, whatever discretion the Director has to deny an IPR petition, that discretion does not extend to the grounds invoked by the Office to deny Intel’s IPR petitions at issue here. Agencies

must exercise their discretion within statutory bounds, and “courts are normally available to reestablish th[ose] limits” when an agency exceeds them. *Sierra Club v. Trump*, 963 F.3d 874, 891 (9th Cir. 2020); see *Utility Air Regulatory Grp. v. EPA*, 573 U.S. 302, 326 (2014); *Tokyo Kikai Seisakusho, Ltd. v. United States*, 529 F.3d 1352, 1361 (Fed. Cir. 2008). As the Supreme Court has held, even when a decision is otherwise committed to agency discretion, “an agency is not free simply to disregard statutory responsibilities.” *Lincoln v. Vigil*, 508 U.S. 182, 193 (1993). That is because an exercise of agency discretion is unreviewable only in “rare circumstances where the relevant statute is drawn so that a court would have no meaningful standard against which to judge the agency’s exercise of discretion.” *Weyerhaeuser Co. v. U.S. Fish & Wildlife Serv.*, 139 S. Ct. 361, 370 (2018). But where a statute defines a boundary that the agency has exceeded, that statutory boundary supplies the law for the court to apply. For example, if the PTO denied an IPR petition based on a coin flip, the race of the IPR petitioner, or a blanket policy of denying all IPR petitions, §314(d) would not shield such irrational or ultra vires actions from judicial review.

This fundamental limitation on agency discretion is, in fact, embodied in the limits on §314(d) that *Cuozzo* and its progeny have identified. Although *Cuozzo* observed in passing that institution decisions are “committed to the Patent Office’s discretion,” 136 S. Ct. at 2140, *Cuozzo* simultaneously made clear that judicial

review remains available where the PTO is claimed to have “act[ed] outside its statutory limit” or contrary to a statute unrelated to those governing institution decisions, *id.* at 2141; *see also SAS*, 138 S. Ct. at 1354. *Cuozzo* nowhere suggested that the Director’s institution discretion renders his decisions wholly unreviewable, even when the institution decision is claimed to have exceeded the Director’s legal authority. Otherwise, there would have been no point in *Cuozzo*’s identifying that boundary on the scope of §314(d).

II. THE RULING CREATES INTRA-CIRCUIT CONFUSION

In concluding that this Court lacks jurisdiction under §1295(a)(4)(A), *Mylan* cited this Court’s pre-*Cuozzo* decision in *St. Jude* for the proposition that “§314(d) bar[s] an appeal of [a] non-institution decision.” 989 F.3d at 1378 (quotation marks omitted). But *St. Jude*’s sweeping pronouncement must be read more narrowly in light of the 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. In *Mylan*, this Court saw “no conflict between” *St. Jude* and *Arthrex*, *id.* at 1379 n.3, but its treatment of the tension between those two cases only exacerbates the intra-circuit confusion about the scope of appellate jurisdiction under §1295(a)(4)(A).

St. Jude held that this Court lacks 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” of the Board and “the statutory grant of jurisdiction [under §1295(a)(4)(A)] matches the appeal right in 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.* Thus, *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).

Mylan creates further doubt about which precedent reflects the law of the Circuit and how §314(d) intersects with §1295(a)(4)(A). As noted, *St. Jude* held

that jurisdiction under §1295(a)(4)(A) extends only to appeals from final written decisions, 749 F.3d at 1375-1376, but *Arthrex* clearly concluded otherwise, 880 F.3d at 1349, and so did *Mylan* itself, in that it recognized (as noted above, *supra* p.6) that §1295(a)(4)(A) provides jurisdiction for appeals from a non-institution decision unless barred by §314(d), 989 F.3d at 1378. Thus, *Mylan* is internally inconsistent regarding the scope of jurisdiction under §1295(a)(4)(A). *Mylan*'s attempt to limit *Arthrex* to appeals of “an adverse judgment under 37 C.F.R. §42.73(b),” 989 F.3d at 1379 n.3, does not help matters. That distinction does not account for the reasoning of *Arthrex*, which recognized that §1295(a)(4)(A) creates appellate jurisdiction over any final Board “decision ... with respect to ... inter partes review”—which, as *Mylan* elsewhere observed, includes the denial of an IPR petition, 989 F.3d at 1378—unless barred by §314(d). *Arthrex*, 880 F.3d at 1348-1349.

III. PERMITTING REVIEW OF DENIAL DECISIONS 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 by this Court, the 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 motions panels—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—that is, 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.

Respectfully submitted,

/s/ Gregory H. Lantier

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*Attorneys for Appellant Intel
Corporation*

June 21, 2021

ADDENDUM

NOTE: This order is nonprecedential.

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

INTEL CORPORATION,
Appellant

v.

VLSI TECHNOLOGY 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

2021-1614, -1616, -1617

Appeals from the United States Patent and Trademark
Office, Patent Trial and Appeal Board in Nos. IPR2020-
00106, IPR2020-00158, and IPR2020-00498.

INTEL CORPORATION,
Appellant

v.

VLSI TECHNOLOGY 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

2021-1673, -1674, -1675

Appeals from the United States Patent and Trademark
Office, Patent Trial and Appeal Board in Nos. IPR2020-
00112, IPR2020-00113, and IPR2020-00114.

INTEL CORPORATION,
Appellant

v.

VLSI TECHNOLOGY 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

2021-1676, -1677

Appeals from the United States Patent and Trademark
Office, Patent Trial and Appeal Board in Nos. IPR2020-
00141 and IPR2020-00142.

INTEL CORPORATION v. VLSI TECHNOLOGY LLC

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INTEL CORPORATION,
Appellant

v.

VLSI TECHNOLOGY 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

2021-1738, -1739

Appeals from the United States Patent and Trademark
Office, Patent Trial and Appeal Board in Nos. IPR2020-
00526 and IPR2020-00527.

INTEL CORPORATION,
Appellant

v.

VLSI TECHNOLOGY 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

2021-1740, -1741

Appeals from the United States Patent and Trademark Office, Patent Trial and Appeal Board in Nos. IPR2020-00582 and IPR2020-00583.

ON MOTION AND PETITION

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

PROST, *Chief Judge*.

O R D E R

Intel Corporation directly appeals from the Patent Trial and Appeal Board's decisions denying institution of *inter partes* review proceedings. VLSI Technology LLC moves to dismiss. Intel opposes the motions and alternatively seeks writs of mandamus to review the Board's decisions. The United States Patent and Trademark Office ("Patent Office") responds, urging dismissal.

Intel here challenges the Board's application of the so-called *Fintiv* factors, which are used to assess whether instituting Patent Office review would be an inefficient use of resources given parallel district court proceedings. Intel contends that the use of those factors in assessing institution exceeds the Patent Office's authority and that the "rule" encompassing those factors was adopted without the notice-and-comment rulemaking required under the Administrative Procedure Act. *See* Intel's Resp. in Appeal Nos. 2021-1614 et al. at 2.

In *Mylan Laboratories Ltd. v. Janssen Pharmaceutica, N.V.*, 989 F.3d 1375, 1379 (Fed. Cir. 2021), we recently

INTEL CORPORATION v. VLSI TECHNOLOGY LLC

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confirmed that 35 U.S.C. § 314(d) bars the availability of jurisdiction under 28 U.S.C. § 1295(a)(4) to hear appeals from non-institution decisions. *Mylan* furthermore concluded that a petitioner raising the same *ultra vires* challenges that Intel raises has failed to establish the high standard necessary for mandamus relief. *Id.* at 1382–83. *Mylan* clearly controls this case. For the same reasons, this court dismisses Intel’s appeals for lack of jurisdiction and denies its requests for mandamus relief.

Accordingly,

IT IS ORDERED THAT:

- (1) The motions are granted. The appeals are dismissed.
- (2) The requests for mandamus are denied.
- (3) Each side shall bear its own costs.

FOR THE COURT

May 05, 2021
Date

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

s32

ISSUED AS A MANDATE: May 05, 2021

CERTIFICATE OF SERVICE

I hereby certify that, on this 21st day of June 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:

1. The filing has been prepared using a proportionally spaced typeface and includes 3,595 words.
2. The brief has been prepared using Microsoft Word for Office 365 in 14-point Times New Roman font. As permitted by Fed. R. App. P. 32(g), the undersigned has relied upon the word count feature of this word processing system in preparing this certificate.

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June 21, 2021