

Appeal 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

2021-1614, -1616, -1617

INTEL CORPORATION,
Appellant,
v.

VLSI TECHNOLOGY,
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.

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

2021-1673, -1674, -1675

INTEL CORPORATION,
Appellant,
v.

VLSI TECHNOLOGY,
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.

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

2021-1676, -1677

INTEL CORPORATION,
Appellant,
v.

VLSI TECHNOLOGY,
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.

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

2021-1738, -1739

INTEL CORPORATION,
Appellant,
v.

VLSI TECHNOLOGY,
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.

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

2021-1740, -1741

INTEL CORPORATION,
Appellant,
v.

VLSI TECHNOLOGY,
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.

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

**INTERVENOR’S RESPONSE TO APPELLANT’S COMBINED PETITION FOR
PANEL REHEARING AND REHEARING EN BANC**

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TABLE OF CONTENTS

I.	INTRODUCTION.....	1
II.	BACKGROUND.....	2
III.	NEITHER PANEL REHEARING NOR REHEARING EN BANC IS WARRANTED.....	3
A.	This Court Has Consistently Held That USPTO Decisions Declining to Institute Inter Partes Reviews Are Not Appealable.....	4
1.	This Court’s Controlling Precedent Clearly and Correctly Bars Appeals From Non-Institution Decisions.....	4
2.	Intel’s Attempt To Manufacture A Conflict With Supreme Court Precedent Is Unavailing.....	7
3.	There is No Confusion Regarding This Court’s <i>St. Jude</i> and <i>Arthrex</i> Decisions.....	10
4.	Intel’s APA Claims Do Not Confer Jurisdiction.....	11
B.	The Panel’s Order Leaves the Parties’ Rights Unaffected and Does Not Raise a Question of Exceptional Importance.....	12
IV.	CONCLUSION.....	16

TABLE OF AUTHORITIES

Cases

<i>Apple Inc. v. Fintiv, Inc.</i> , No. IPR2020-00019, 2020 WL 2126495, Paper No. 11 (PTAB Mar. 20, 2020).....	2
<i>Apple Inc. v. Maxell, Ltd.</i> , No. 20-2132, ECF No. 49 (Fed. Cir. Feb. 22, 2021) .	4
<i>Apple Inc. v. Optis Cellular Tech., LLC</i> , No. 21-1043, ECF No. 22 (Fed. Cir. Feb. 26, 2021)	4
<i>ARRIS Int’l PLC v. ChanBond, LLC</i> , 773 F. App’x 605 (Fed. Cir. 2018) .	5, 6, 11
<i>Arthrex, Inc. v. Smith & Nephew, Inc.</i> , 880 F.3d 1345 (Fed. Cir. 2018).....	10, 11
<i>BioDelivery Scis. Int’l, Inc. v. Aquestive Therapeutics, Inc.</i> , 935 F.3d 1362 (Fed. Cir. 2019)	5, 6
<i>Cuozzo Speed Techs., LLC v. Lee</i> , 136 S. Ct. 2131 (2016)	passim
<i>GEA Process Eng’g, Inc. v. Steuben Foods, Inc.</i> , 618 F. App’x 667 (Fed. Cir. 2015)	5
<i>GTNX, Inc. v. INTTRA, Inc.</i> , 789 F.3d 1309 (Fed. Cir. 2015).....	12
<i>Heckler v. Chaney</i> , 470 U.S. 821 (1985).....	13, 15
<i>In re Cisco Sys. Inc.</i> , Nos. 2020-148, 2020-2047, 2020-2049, 2020 WL 6373016 (Fed. Cir. Oct. 30, 2020).....	4
<i>Intel Corp. v. VLSI Tech. LLC</i> , No. 21-1614, ECF No. 21 (Fed. Cir. May 5, 2021)	3
<i>Intel Corp. v. VLSI Tech. LLC</i> , No. IPR2020-00106, 2020 WL 2201828 (PTAB May 5, 2020)	2, 3
<i>Lindhahl v. OPM</i> , 470 U.S. 768 (1985).....	9
<i>Medtronic, Inc. v. Robert Bosch Healthcare Sys., Inc.</i> , 839 F.3d 1382 (Fed. Cir. 2016)	5

Mylan Labs. Ltd. v. Janssen Pharmaceutica, N.V., 989 F.3d 1375 (Fed. Cir. 2021) passim

Oil States Energy Servs., LLC v. Greene’s Energy Group, LLC, 138 S. Ct. 1365 (2018)..... 7

Saint Regis Mohawk Tribe v. Mylan Pharm. Inc., 896 F.3d 1322 (Fed. Cir. 2018) 7

SAS Inst., Inc. v. Iancu, 138 S. Ct. 1348 (2018) 9

St. Jude Medical, Cardiology Division, Inc. v. Volcano Corp., 749 F.3d 1373 (Fed. Cir. 2014)..... 5, 10

Thryv, Inc. v. Click-to-Call Techs., LP, 140 S. Ct. 1367 (2020) passim

Wi-Fi One, LLC v. Broadcom Corp., 878 F.3d 1364 (2018) (en banc) 6

Statutes

35 U.S.C. § 141(c) 1

35 U.S.C. § 313 14

35 U.S.C. § 314 14

35 U.S.C. § 314(a) 1

35 U.S.C. § 314(d) 1, 7

35 U.S.C. § 315(e) 13

35 U.S.C. § 318(a) 1

35 U.S.C. § 318(b) 13

35 U.S.C. § 319 1

5 U.S.C. § 701(a)(1)..... 12

5 U.S.C. § 701(a)(2)..... 12

Other Authorities

157 Cong. Rec. S1375-76 (Mar. 8, 2011) (Sen. Kyl)..... 14
H.R. Rep. 112-98 (2011)..... 15
S. Rep. 111-18 (2009) (Minority Views of Sens. Kyl, Feingold, and Coburn) . 14

Rules

Fed. Cir. R. 35(b)(2) 3
Fed. Cir. R. 40(a)(5)..... 3
Fed. R. App. P. 35(a) 3
Fed. R. App. P. 40(a)(2)..... 3

Regulations

37 C.F.R. § 42.107 15

I. INTRODUCTION

Consistent with the plain text of the America Invents Act (AIA), this Court has never entertained an appeal from the USPTO’s decision *not* to conduct an inter partes review (IPR) to reconsider the patentability of an issued patent. That result follows directly from the statute’s clear language providing that the agency’s decision “whether to institute an inter partes review under this section shall be final and nonappealable,” 35 U.S.C. § 314(d), and its provision limiting appeals from IPR proceedings to the *culmination* of an instituted and completed IPR: a “final written decision” regarding patentability, 35 U.S.C. §§ 141(c), 318(a), 319. Moreover, this Court’s consistent rulings reflect Congress’s choice to empower—but never require—the USPTO to institute an IPR. 35 U.S.C. § 314(a). As both this Court and the Supreme Court have explained, these provisions mean that the USPTO’s decision to forgo an IPR proceeding is committed to the agency’s discretion.

The statute thus reflects Congress’s unremarkable choice to place an agency decision *not* to undertake an administrative proceeding—thus leaving all parties’ rights unaffected—beyond appellate review. Intel, however, contends that the Court should sit en banc to reverse course and permit the first-ever appeal from the USPTO’s decision declining to institute an IPR. But there is no conflict or “confusion” in this Court’s unbroken line of cases barring such appeals, which are

supported by the Supreme Court’s recent decisions. *See Mylan Labs. Ltd. v. Janssen Pharmaceutica, N.V.*, 989 F.3d 1375, 1379 (Fed. Cir. 2021) (noting that “[w]hen the Supreme Court discussed decisions denying institution . . . it suggested such decisions are unreviewable”). Nor does the agency’s exercise of its discretion in favor of inaction implicate any exceptionally important issue. This Court should deny the petition.

II. BACKGROUND

This appeal arose from inter partes review petitions filed by Intel seeking review of VLSI’s patents, which were already the subject of infringement suits between the parties. The USPTO exercised its discretion under 35 U.S.C. § 314(a) to deny the petitions, thus declining to institute the IPR proceedings. Although the statute has no requirement that the agency explain its institution decisions, the Board analyzed the factors the Director has established to guide the discretionary institution decisions where there exists parallel district court litigation involving the same patent. *See, e.g., Intel Corp. v. VLSI Tech. LLC*, No. IPR2020-00106, 2020 WL 2201828 (PTAB May 5, 2020) (citing *Apple Inc. v. Fintiv, Inc.*, No. IPR2020-00019, 2020 WL 2126495, Paper No. 11 at 5-6 (PTAB Mar. 20, 2020) (precedential) (setting out six non-exclusive factors regarding potentially duplicative district court litigation)). After holistic consideration of the relevant

facts, the Board determined that “it would be an inefficient use of Board, party, and judicial resources to institute the present proceeding.” *Id.* at *6.

Intel appealed the agency’s decision not to initiate the administrative proceeding to this Court. A panel of this Court (Judges Prost, O’Malley, Wallach) dismissed the appeal, finding that the Court lacked jurisdiction over appeals from non-institution decisions. *See Intel Corp. v. VLSI Tech. LLC*, No. 21-1614, ECF No. 21 (Fed. Cir. May 5, 2021). The panel applied this Court’s *Mylan* decision to find that 35 U.S.C. § 314(d) bars the availability of jurisdiction to hear an appeal from a non-institution decision, and that Intel did not demonstrate that it was entitled to mandamus relief. *Id.*

III. NEITHER PANEL REHEARING NOR REHEARING EN BANC IS WARRANTED

The panel’s decision neither conflicts with precedent nor presents an issue of exceptional importance warranting en banc review. *See* Fed. R. App. P. 35(a); Fed. Cir. R. 35(b)(2); Fed. R. App. P. 40(a)(2); Fed. Cir. R. 40(a)(5). On the contrary, the panel followed this Court’s unwavering refusal to permit disappointed IPR petitioners to appeal non-institution decisions, a result supported by the Supreme Court’s decisions, as well as the AIA’s express language and underlying policy.

A. This Court Has Consistently Held That USPTO Decisions Declining to Institute Inter Partes Reviews Are Not Appealable

1. This Court's Controlling Precedent Clearly and Correctly Bars Appeals From Non-Institution Decisions

The panel here followed controlling precedent holding that this Court lacks jurisdiction over appeals of decisions denying inter partes review based on the *Fintiv* factors. *Mylan*, 989 F.3d at 1378-79; *see also In re Cisco Sys. Inc.*, Nos. 2020-148, 2020-2047, 2020-2049, 2020 WL 6373016 (Fed. Cir. Oct. 30, 2020) (nonprecedential); *Apple Inc. v. Optis Cellular Tech., LLC*, No. 21-1043, ECF No. 22 (Fed. Cir. Feb. 26, 2021) (denying petition for panel rehearing and rehearing en banc of the dismissal of Apple's *Fintiv* challenge); *Apple Inc. v. Maxell, Ltd.*, No. 20-2132, ECF No. 49 (Fed. Cir. Feb. 22, 2021) (same).

As this Court explained in *Mylan*, multiple features of the AIA establish this Court's lack of jurisdiction over an appeal from a USPTO decision declining to conduct an inter partes review. First, no provision of the AIA authorizes appellate review of non-institution decisions. *Mylan*, 989 F.3d at 1379. Next, the statute establishes that institution decisions like those appealed here are final and nonappealable. *Id.* at 1378. Finally, as the Supreme Court and this Court have noted, the statute provides the Director with unfettered discretion to deny review even when the statutory prerequisites for institution are met. *Id.* at 1379.

Accordingly, beyond challenges addressing the Board's application of the *Fintiv*

factors, this Court has repeatedly found that it lacks jurisdiction to review Board decisions declining to conduct an IPR. *See, e.g., BioDelivery Scis. Int'l, Inc. v. Aquestive Therapeutics, Inc.*, 935 F.3d 1362, 1366 (Fed. Cir. 2019); *ARRIS Int'l PLC v. ChanBond, LLC*, 773 F. App'x 605, 606 (Fed. Cir. 2018) (nonprecedential); *Medtronic, Inc. v. Robert Bosch Healthcare Sys., Inc.*, 839 F.3d 1382, 1384-85 (Fed. Cir. 2016); *GEA Process Eng'g, Inc. v. Steuben Foods, Inc.*, 618 F. App'x 667, 669 (Fed. Cir. 2015) (nonprecedential); *St. Jude Medical, Cardiology Division, Inc. v. Volcano Corp.*, 749 F.3d 1373, 1375 (Fed. Cir. 2014).

The Supreme Court's decisions underscore the propriety of *Mylan's* holding. In *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131 (2016), the Court explained that under § 314(d), "Congress has told the Patent Office to determine whether inter partes review should proceed," and "courts may not revisit this initial determination." *Id.* at 2141. Thus, the Supreme Court held that § 314(d) bars judicial review "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 the Patent Office's decision to initiate inter partes review." *Id.* at 2140-41.

In *Thryv, Inc. v. Click-to-Call Techs., LP*, 140 S. Ct. 1367 (2020), the Supreme Court reinforced the plain language of § 314(d)'s appeal bar, reversing this Court's conclusion that the USPTO's application of the statutory time bar on

instituting IPR was subject to review. The Court explained § 314(d) barred appeal of the institution decision even where a party asserted that the agency exceeded the statutory “limit[]” on “the agency’s institution authority in [35 U.S.C.] § 315(b).” *Id.* at 1376. “Congress entrusted the institution decision to the agency,” *id.*, and § 314(d) “preclud[es] review of the Patent Office’s institution decisions with sufficient clarity to overcome the strong presumption in favor of judicial review,” *id.* at 1373 (quotations omitted).¹

In both *Cuozzo* and *Thryv*, the Supreme Court found it unnecessary to address “whether § 314(d) would bar appeals reaching well beyond the decision to institute inter partes review,” but made clear that this provision does indeed bar attacks on institution decisions themselves. *Thryv*, 140 S. Ct. at 1373 (quoting *Cuozzo*, 136 S. Ct. at 2141-42). And the Supreme Court has left no doubt that decisions to deny rather than grant institution do not somehow escape § 314(d). Indeed, given that § 314(a) contains “no mandate to institute review” under any circumstance, the Court has explained that “the agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.” *Cuozzo*, 136 S.

¹ Notably, even during the period when this Court had given § 314(d) a narrower reading than that the Supreme Court did in *Thryv*, see *Wi-Fi One, LLC v. Broadcom Corp.*, 878 F.3d 1364 (2018) (en banc), this Court properly dismissed appeals from noninstitution decisions. See *BioDelivery*, 935 F.3d at 1365; *ARRIS*, 773 Fed. App’x at 606 (explaining that “[n]othing in *Wi-Fi One* ... undermines [*St. Jude*’s] holding”).

Ct. at 2140; *see also Saint Regis Mohawk Tribe v. Mylan Pharm. Inc.*, 896 F.3d 1322, 1327 (Fed. Cir. 2018) (stating that the Director “has complete discretion to decide not to institute review”) (citing *Oil States Energy Servs., LLC v. Greene’s Energy Group, LLC*, 138 S. Ct. 1365, 1371 (2018)).

Here, Intel’s challenge is not merely “closely tied” to a statute “related” to the USPTO’s “decision to initiate inter partes review”—Intel is directly challenging the Director’s decision not to institute review under the very statute that authorizes (but does not require) institution, 35 U.S.C. § 314(a). That decision is, by definition, an institution decision, and Intel’s challenge to it undoubtedly “ranks as an appeal of the agency’s decision” whether “to institute an inter partes review.” *Thryv*, 140 S. Ct. at 1373 (quoting 35 U.S.C. § 314(d)).

2. Intel’s Attempt To Manufacture A Conflict With Supreme Court Precedent Is Unavailing

Intel suggests that this Court’s dismissal of appeals from non-institution decisions conflicts with various Supreme Court decisions, arguing that it must be able to appeal because it contends that the agency exceeded its statutory authority. Pet. 8-13. That argument is impossible to reconcile with *Thryv*, where the Supreme Court made clear that merely alleging that USPTO acted in excess of statutory authority does not confer jurisdiction over challenges to the Director’s institution decision. There, the patent owner alleged (and the dissent agreed) that the time limit in § 315(b) was an “affirmative limit on the agency’s authority,” 140

S. Ct. at 1381 (Gorsuch, J., dissenting), but the majority nonetheless held that § 314(d) barred review of the patent owner’s challenge to the institution decision, *see id.* at 1373. The Court explained that the patent owner’s assertion that the USPTO exceeded its authority under § 315(b) is simply an argument “that the agency should have refused ‘to institute an inter partes review,’” and therefore “raises ‘an ordinary dispute about the application of’ an institution-related statute” that is barred under § 314(d). *Id.* (citations omitted). As discussed, Intel’s argument that the USPTO exceeded its statutory authority under § 314(a) in deciding whether to institute IPR is barred by § 314(d) for the same reason.

Intel’s reliance on *Cuozzo* is equally misplaced. In *Cuozzo*, the Court stated that it was not “categorically preclud[ing] review of a *final decision*” where a party challenges the institution decision on the basis of, *e.g.*, constitutional questions or allegations that the agency canceled a patent outside of its statutory authority. 136 S. Ct. at 2141-42 (emphasis added). The Court noted that such “shenanigans” may be reviewable “in the context of § 319 and under the Administrative Procedure Act.” *Id.* at 2142. But the Court nowhere suggested that USPTO decisions *not* to conduct a proceeding—which affect no one’s legal rights—were appealable on the same terms as “final decisions” under § 319, which leave petitioners estopped and could leave a patent owner’s claims either canceled or amended. *Id.* at 2141-42. On the contrary, even the two Justices who would have interpreted § 314(d) more

narrowly than the *Cuozzo* majority agreed that it “prevents an appeal from a decision not to institute inter partes review.” *Cuozzo*, 136 S. Ct. at 2153 & n.6 (Alito, J., joined by Sotomayor, J., concurring-in-part and dissenting-in-part).²

Nor does *SAS* assist Intel. *See* Pet. 9-10. Like *Thryv* and *Cuozzo*, *SAS* involved an appeal of a final written decision under § 319. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1354 (2018). And the Court explicitly stated that “§ 314(a) invests the Director with discretion on the question *whether* to institute.” *Id.* at 1356 (emphasis in original). In *SAS*, the Court did not consider the institution decision at issue, instead characterizing the challenge as one to ensure that, once instituted, “an inter partes review proceeds in accordance with the law’s demands.” *Id.* at 1359. The Court further explained in *Thryv* that *SAS*’s “reviewability holding is inapplicable” when an “appeal challenges not the manner in which the

² *Cuozzo* also demonstrates Intel’s error in relying on cases regarding the strong presumption of judicial review or the general proposition that allegations of ultra vires agency actions are subject to such review. *See* Pet. 8-9. The *Cuozzo* majority distinguished cases like *Lindahl v. OPM*, 470 U.S. 768 (1985), explaining that the factors cited there “all point in favor of precluding review of the Patent Office’s institution decisions” under § 314(d). 136 S. Ct. at 2141. And Intel gets *Cuozzo* backwards in arguing (Pet. 12-13) that it held that § 314(d) allows for an appeal when there is no final written decision. Rather, the majority in *Cuozzo*, addressing the dissent, pointed out that if § 314(d) disallowed only appeals from interlocutory decisions, the “nonappealable” provision would do no work, as interlocutory appeals are disallowed by default. 136 S. Ct. at 2140.

agency’s review ‘proceeds’ once instituted, but whether the agency should have instituted review at all.” 140 S. Ct. at 1376.

3. There is No Confusion Regarding This Court’s *St. Jude* and *Arthrex* Decisions

Intel argues that rehearing is warranted because of the alleged “intra-circuit confusion” over the scope of this Court’s jurisdiction under 28 U.S.C.

§ 1295(a)(4)(A) created by this Court’s decision in *Arthrex, Inc. v. Smith & Nephew, Inc.*, 880 F.3d 1345 (Fed. Cir. 2018). Pet. 13. But this Court has repeatedly distinguished that case due to its unique circumstances; accordingly, there is no confusion.

In *St. Jude*, this Court held that the reference to “inter partes review” in § 1295(a)(4)(A) does not confer jurisdiction over appeals from a non-institution decision, reading that provision in light of the limited “appeal right in chapter 31 and section 141(c).” 749 F.3d at 1376 (explaining that an institution denial is not a final written decision under § 318(a), and thus is outside both chapter 31 and section 141(c)).

Contrary to Intel’s argument, this Court did not depart from *St. Jude* in *Arthrex*—nor could it, consistent with *Cuozzo* and *Thryv*’s interpretation of § 314(d). Far from involving an institution denial, *Arthrex* concerned a *final adverse judgment* against the patent owner. *Arthrex*, 880 F.3d at 1347-48 (making clear that there was “no contention that the statutory appeal-bar provision” in

§ 314(d) regarding institution decisions applied). That “final adverse judgment” was issued before the agency decided whether to institute an IPR, based upon the patent owner’s disclaimer of all challenged claims. *Id.* The “adverse judgment” canceled the challenged claims and carried estoppel effects for the patent owner. *Id.* at 1347. Under these circumstances, the Court concluded that § 1295(a)(4)(A), either alone or in conjunction with § 704 of the APA, permitted an appeal to this Court. *Id.* at 1348-50.

This Court has already considered and rejected the argument that there is a conflict between *Arthrex* and *St. Jude*. In *Mylan*, the Court explained that “*Arthrex*’s holding that an adverse judgment under 37 C.F.R. § 42.73(b) is appealable pursuant to § 1295 does not conflict with *St. Jude*’s holding that non-institution decisions are nonappealable.” 989 F.3d at 1379, n.3; *see also Arthrex*, 880 F.3d at 1348-49 (distinguishing *St. Jude*); *ARRIS*, 773 F. App’x at 606 (distinguishing *St. Jude* and *Arthrex*). And in any event, Intel concedes (Pet. 14) that § 1295(a)(4)(A) does not grant jurisdiction in cases where § 314(d) bars review. As discussed, § 314(d)’s jurisdictional bar applies here, so the scope of § 1295(a)(4)(A) is irrelevant to the issue before this Court.

4. Intel’s APA Claims Do Not Confer Jurisdiction

Intel protests the dismissal of its appeal based on its claims under the APA that the *Fintiv* factors are arbitrary and capricious and were erroneously adopted

without notice-and-comment rulemaking. Pet. 6. But Intel’s invocation of the APA does not change the jurisdictional analysis; the APA is not a jurisdiction-conferring statute. *Mylan*, 989 F.3d at 1379; *GTNX, Inc. v. INTTRA, Inc.*, 789 F.3d 1309, 1313 (Fed. Cir. 2015). Moreover, the APA’s cause of action is unavailable when another statute precludes judicial review or the challenged “agency action is committed to agency discretion by law.” 5 U.S.C. § 701(a). As discussed, § 314(d) (as confirmed by *Thryv*) precludes judicial review of institution decisions, and the “decision to deny a petition [for inter partes review] is a matter committed to the Patent Office’s discretion.” *Cuozzo*, 136 S. Ct. at 2140 (citing 5 U.S.C. § 701(a)(2)).³

B. The Panel’s Order Leaves the Parties’ Rights Unaffected and Does Not Raise a Question of Exceptional Importance

Congress’s decision to provide judicial review only after the USPTO has entered a final decision in an IPR is an unsurprising and integral aspect of the statute. Only if the Board issues such a decision has the agency taken any action affecting the parties’ rights. Final decisions regarding patentability estop a petitioner in future proceedings and can alter a patent owner’s claims. *See* 35

³ Intel’s argument that the AIA requires the USPTO to undergo notice-and-comment rulemaking to be able to deny a category of petitions (Pet. 6), is likewise an impermissible attack on the institution decision process, which Intel has also made in district court. *Apple Inc. v. Hirshfeld*, No. 20-cv-6128, ECF No. 65 at 23-25 (N.D. Cal. Aug. 31, 2020).

U.S.C. § § 315(e) (estopping a “petitioner in an inter partes review ... that results in a final written decision under section 318(a)” from raising certain issues in future USPTO or judicial proceedings); *id.* § 318(b) (directing the USPTO to amend or cancel patent claims “[i]f ... [the Board] issues a final written decision” under section 318(a)). But a USPTO decision declining to initiate an IPR leaves the patent owner in possession of unaltered patent claims and the petitioner free to challenge those claims in district court, just as it was before filing a petition. No one has a right to an IPR, and the petitioner remains able to challenge those claims in district court or by filing for ex parte reexamination. There is nothing exceptionally important or extraordinary about a party’s failure to persuade the agency to initiate a discretionary proceeding; this type of agency “inaction” is routinely beyond the scope of judicial review. *See Heckler v. Chaney*, 470 U.S. 821, 832 (1985) (“[W]hen an agency refuses to act it generally does not exercise its coercive power over an individual’s liberty or property rights, and thus does not infringe upon areas that courts often are called upon to protect.”).

On the contrary, it is Intel’s novel view of its appeal rights that would work a startling change. The non-reviewability of institution denials is an important element of the AIA’s statutory policy and structure. Congress coupled the AIA’s expanded administrative procedures for challenging issued patents with certain procedural protections for patent owners. Among other things, the AIA (i)

imposed an elevated threshold for instituting review as compared to pre-AIA inter partes reexamination (§ 314(a)); (ii) placed time limits on the duration of review (§ 316(a)(11)); (iii) limited challenges in all other fora following the completion of a review (§ 315(e)); and (iv) eliminated intermediate administrative appeals of post-issuance review (§ 319).

The AIA's authors were critical of the pre-AIA system, noting that “[t]he fact that an inter partes re-examination is pending . . . substantially undermines a patent owner's ability to enforce his patent.” S. Rep. 111-18, p.55 (2009) (Minority Views of Sens. Kyl, Feingold, and Coburn). They emphasized that “[t]hese problems are compounded by the fact that it typically takes three or four years before the PTO decides an inter partes re-examination.” *Id.* As a result of these delays, even a patent that is “perfectly valid and enforceable” can be “greatly devalue[d], if not effectively nullif[ied].” *Id.* The AIA's new procedural protections addressed these problems. *See* 157 Cong. Rec. S1375-76 (Mar. 8, 2011) (Sen. Kyl); *see also id.* at S1376 (noting that the AIA's “eliminat[ion] [] of administrative appeals” will “substantially accelerate the resolution of inter partes cases”).

Because institution denials have always been considered unreviewable, the IPR process effectively concludes, for these patent owners, upon the agency's decision to forgo review, usually within six months (*see* 35 U.S.C. §§ 313, 314; 37

C.F.R. § 42.107), at which point they can return to enforcing or licensing their patents. By committing non-institution decisions to the agency's unappealable discretion, the AIA promoted "the importance of quiet title to patent owners," H.R. Rep. 112-98, p.48 (2011), an outcome that Intel's contrary view would undermine.

Indeed, Intel's challenge here illustrates the ways in which Congress's decision to leave institution decisions within the agency's discretion advances the AIA's purposes. Intel argues that it is being cut off from the most efficient way to challenge the patentability of Intel's patents, *see* Pet. 4, but the Board instead found that, given the advanced state of the parallel litigation, the most efficient and cost-effective forum for this dispute is the district court. *See Mylan*, 989 F.3d at 1382 (stating that "the Director is free . . . to determine that for reasons of administrative efficiency an IPR will not be instituted").

It makes sense that Congress walled off this type of determination from judicial review. There can be reasonable debates about how to best balance effectuating the AIA's various efficiency-related goals while attending to the efficiency of agency operations. But this is the sort of decision for the USPTO to make, given that the "agency is far better equipped than the courts to deal with the many variables involved in the proper ordering of its priorities." *Heckler*, 470 U.S. at 831-32 (explaining that factors such as "whether agency resources are best spent on this violation or another" and "whether the particular enforcement action

requested best fits the agency's overall policies” “are peculiarly within [agency] expertise”).

IV. CONCLUSION

The Director respectfully requests that this Court deny Intel’s petition for panel rehearing and rehearing en banc.

August 10, 2021

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

I certify that the foregoing document complies with the type-volume limitation required by the Court's rule. The total number of words in the foregoing document is 3,666 words as calculated using the Microsoft Word 2016 software program.

/s/ Michael S. Forman
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CERTIFICATE OF SERVICE

I hereby certify that on August 10, 2021, the foregoing INTERVENOR'S RESPONSE TO APPELLANT'S COMBINED PETITION FOR PANEL REHEARING AND REHEARING EN BANC was electronically filed using the Court's electronic filing system. Counsel for the parties was electronically served by and through the Court's electronic filing system per Fed. Cir. R. 25(e).

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