

No. 2026-105

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

IN RE: MAPLEBEAR INC.,
Petitioner.

On Petition for Writ of Mandamus
from the United States Patent and Trademark Office,
Patent Trial and Appeal Board in No. IPR2025-00958

DIRECTOR'S RESPONSE TO PETITION FOR WRIT OF MANDAMUS

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INTRODUCTION

“Given Congress committed institution decisions to the Director’s discretion and protected that exercise of discretion from judicial review by making such determinations final and nonappealable, mandamus is ordinarily unavailable for review of institution decisions.” *In re Motorola Solutions, Inc.*, No. 2025-134, 2025 WL 3096514, at *3 (Fed. Cir. Nov. 6, 2025) (precedential) (cleaned up); *see also In re Google LLC*, No. 2025-144, 2025 WL 3096849, at *1 (Fed. Cir. Nov. 6, 2025), *In re SAP America, Inc.*, No. 2025-132, 2025 WL 3096788, at *2 (Fed. Cir. Nov. 6, 2025). The *only* circumstance in which this Court can review—on mandamus—the Director’s decision to deny IPR institution is when there exist colorable claims that the Director exercised his discretion in an unconstitutional manner. *See Mylan Lab’ys Ltd. v. Janssen Pharmaceutica, N.V.*, 989 F.3d 1375, 1382 (Fed. Cir. 2021). And to obtain the “drastic and extraordinary” mandamus remedy, a petitioner must show that it has (1) a “clear and indisputable” right to relief; (2) no “alternative avenues of relief”; and (3) that “the writ is appropriate under the circumstances.” *Cheney v. U.S. Dist. Ct. for D.C.*, 542 U.S. 367, 379-81 (2004) (quotation marks omitted).

This Court’s decisions in *Motorola*, *Google*, and *SAP* rejecting similar mandamus petitions largely answer this petition. As in those cases, here Petitioner seeks the extraordinary remedy of mandamus based on its dissatisfaction with Acting Director Stewart’s application of institution criteria—described in agency guidance—to deny institution of its IPR petition.¹ Petitioner does not claim that it lacked notice of the institution criteria. Nor does Petitioner dispute having opportunities to be heard on how the institution criteria should affect the exercise of institution discretion. Rather, Petitioner contends that Acting Director Stewart’s application of the institution criteria violates the America Invents Act (AIA), the Administrative Procedure Act (APA), and the Constitution. This Court has already denied nearly identical legal arguments in *Motorola*, *Google*, and *SAP* and should do the same here,

¹ Deputy Director Coke Morgan Stewart was the Acting Director at the time of the challenged agency actions. Appx1. On September 22, 2025, John A. Squires was sworn in as the Director. *See* <https://www.uspto.gov/about-us/news-updates/uspto-welcomes-new-director-john-squires> (last visited, Nov. 19, 2025). This brief refers to Acting Director Stewart when describing her actions taken at the time she was Acting Director.

as Petitioner's arguments do not approach the very high bar for mandamus relief.

To begin, much of Petitioner's argument is barred by 35 U.S.C. § 314(d), which precludes judicial review of claims that the USPTO's institution decisions violate a statute, including the AIA and APA. Petitioner suggests that § 314(d) has no role in this Court's jurisdiction over a petition for a writ of mandamus. But this Court has clearly recognized that its mandamus jurisdiction to review decisions denying institution is limited to colorable *constitutional* claims. The petition addresses statutory grievances which are nonjusticiable in this mandamus action. *See Motorola*, 2025 WL 3096514, at *5.

Petitioner's due-process complaints are equally unavailing. Petitioner cannot evade the limits on this Court's mandamus jurisdiction by simply putting a "due-process" label on its APA arguments. And even insofar as the petition identifies a constitutional due-process claim, Petitioner cannot establish a clear and indisputable right to relief. Petitioner fails to establish a protected property interest in having its petition considered under any particular set of criteria the

agency might use to determine if institution is warranted. Even if Petitioner could establish the type of entitlement that might support a constitutionally protected interest, Petitioner received the due-process requisites of notice and the opportunity to be heard; the USPTO afforded Petitioner opportunities to make its case for institution under the agency guidance. *Id.* at *3-4.

Petitioner's separation-of-powers arguments fail because they are, at bottom, simply assertions that the agency exceeded its statutory authority, not constitutional claims. And those assertions are in any event meritless. Petitioner seeks to read out § 314's broad grant of discretion to the Director—and read in limitations on that discretion that have no foundation in the relevant statutory text—in contradiction of settled precedent from this Court and the Supreme Court. *See Google*, 2025 WL 3096849, at *2.

Petitioner similarly cannot satisfy the mandamus standard's other requirements. Petitioner says that it has no other avenue for relief because this Court has said that review of institution decisions is available only through mandamus. But that just highlights the fact

that Petitioner is attempting to obtain judicial review of decisions this Court has recognized are within the USPTO's unreviewable discretion. Petitioner claims no independent harm from any asserted constitutional violation, asserting only a desire to invalidate patent claims in its preferred forum. Petitioner has several "alternative avenues of relief" through which it may seek invalidation of the challenged patent claims, as Petitioner remains free to avail itself of district court litigation or ex parte reexamination.

Petitioner cannot otherwise show that mandamus relief would be appropriate. Congress gave the Director wide latitude to manage IPR proceedings, insulating institution decisions from appellate review. The Acting Director's action here reflects the practical reality that each Director must balance requests for administrative review of patent claims against the other needs of the USPTO and the patent system more generally. When Acting Director Stewart took office in February 2025, she faced a significantly different situation than existed in 2022: the backlog and pendency of ex parte appeals that the Board needed to address was higher, the number of Administrative Patent

Judges was lower, and the agency was subject to a hiring freeze.

Petitioner's request for a judicial order forcing the Director to adhere to a particular rubric for discretionary institution of IPR proceedings is not an "appropriate" use of the writ.

BACKGROUND

1. When Congress created inter partes review, it set out various statutory bars precluding the USPTO Director from instituting an IPR, but no set of circumstances in which institution is required. *See* 35 U.S.C. §§ 314(a), 315. Congress further provided that although the agency's final written decision with respect to patentability is subject to appeal in this Court, *see id.* §§ 318, 319, the determination by the Director whether to institute an IPR is "final and nonappealable," *id.* § 314(d). Both this Court and the Supreme Court have repeatedly made clear that the USPTO is under "no mandate to institute review" and the "decision to deny [an IPR] petition is a matter committed to the Patent Office's discretion." *Mylan*, 989 F.3d at 1382 (quoting *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 273 (2016)). Thus, "[t]he Director is permitted, but never compelled, to institute an IPR," and "no petitioner has a right to ... institution." *Id.*

2. Historically, the Director delegated broad discretion over whether to institute IPR proceedings to the Board, *see* 37 C.F.R. § 42.4(a), and Directors have set out various criteria for the Board to use in employing that delegated authority, *see, e.g., General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, No. IPR2016–01357, 2017 WL 3917706 (P.T.A.B. Sept. 6, 2017) (precedential) (discussing discretionary factors for multiple IPR petitions). Because IPR proceedings often coincide with parallel district court litigation, for years Directors have instructed the Board to consider a non-exhaustive list of factors to address concerns about redundancy or wastefulness. These factors are set forth in *Apple Inc. v. Fintiv, Inc.*, No. IPR2020-00019, 2020 WL 2126495 (P.T.A.B. Mar. 20, 2020) (precedential). On June 21, 2022, former USPTO Director Katherine Vidal issued a memorandum (June 2022 Memo) setting out “interim” guidance, pending formal rule making, regarding the Board’s application of the *Fintiv* factors for the Board to follow when exercising the Director’s delegated institution discretion. Appx12-20. On February 28, 2025, Acting Director Stewart rescinded the June 2022

Memo (Rescission). Appx80. On March 24, 2025, then-Chief Administrative Patent Judge Scott Boalick issued a memorandum providing additional guidance as to how the Board should proceed considering the Rescission. Appx82-84.

3. On March 26, 2025, Acting Director Stewart issued a memorandum entitled “Interim Processes for PTAB Workload Management,” in order “[t]o ensure that the PTAB continues to meet its statutory obligations as to *ex parte* appeals, while continuing to maintain its capacity to conduct AIA proceedings.” Appx85. The memo outlined a new briefing schedule that bifurcated briefing between (1) discretionary considerations and (2) merits and other non-discretionary statutory considerations. Appx85-87. The briefing on discretionary considerations would “address all relevant considerations,” including parallel litigation, serial petitions, and other considerations including “[w]hether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims” and “[s]ettled expectations of the parties, such as the length of time the claims have been in force.” Appx86. The guidance

outlined in the memo applied prospectively to “IPR and PGR proceedings where the deadline for the patent owner to file a preliminary response has not yet passed.” Appx87.²

Later, Acting Director Stewart discretionarily denied institution in *Dabico Airport Solutions Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 (Acting Director Jun. 18, 2025) (*Dabico*). Appx88-92. In *Dabico*, Acting Director Stewart “exercise[d] discretion to deny institution [] based on a holistic assessment of all of the evidence and arguments presented.” Appx90. *Dabico* further noted that there, “the challenged patent has been in force almost eight years, creating settled expectations.” Appx89. Because in its briefing, Petitioner did not provide “persuasive reasons why the Office should review the

² The new USPTO Director, John Squires, temporarily delegated his discretion over IPR institution decisions to now-Deputy Director Stewart. <https://www.uspto.gov/sites/default/files/documents/deshpande-delegation-letter.pdf> (last visited Nov. 19, 2025). On October 17, 2025, the Director announced that going forward, although the bifurcated briefing process in the Interim Processes memo would remain in place, he would both (1) directly exercise his discretion over IPR institution decisions and (2) perform the merits-based institution determination. See <https://www.uspto.gov/subscription-center/2025/director-institution-aia-trial-proceedings> (last visited Nov. 19, 2025).

challenged patent . . . the Office is disinclined to disturb the settled expectations of Patent Owner in this instance.” Appx90. Acting Director Stewart also discretionarily denied institution in *Amazon Web Services, Inc. v. Croga Innovations, Ltd.*, IPR2025-00884, Paper 9 (Acting Director Sept. 3, 2025) (*Croga*). Appx93-96. In *Croga*, the Acting Director denied institution, in part, because the challenged patent had already faced serial challenges, including where the Board denied institution on the merits. Appx94. In *Croga*, the petitioner’s IPR sought to address deficiencies identified by the Board in earlier challenges to the same patent, which the Acting Director found “raises concerns of road mapping and weighs in favor of discretionary denial.” *Id.*

4. This mandamus petition concerns an IPR petition filed by Petitioner Maplebear Inc. (Maplebear) challenging claims of a patent held by Fall Line Patents, LLC (Fall Line). *See* Appx2. Following the bifurcated briefing schedule, Fall Line filed a brief arguing that the Acting Director should exercise her discretion to deny institution. Patent Owner’s Brief in Support of Discretionary Denial, *Maplebear*

Inc. v. Fall Line Patents, LLC, No. IPR2025-00958 (P.T.A.B. Aug. 11, 2025) (Paper 6). Fall Line argued that the Acting Director should deny institution because, among other things, (1) the underlying litigation brought by Fall Line against Petitioner’s customers will go to trial before a final written decision in the IPR (*id.* at 4-5), (2) the presence of settled expectations because the challenged patent has been in force for nearly nine years (*id.* at 9-10), and (3) in a prior final written decision, the Board found claim 7 of the challenged patent unpatentable (*id.* at 2.).³

Petitioner substantively responded to all three arguments. Petitioner’s Brief Against Discretionary Denial, *Maplebear Inc. v. Fall Line Patents, LLC*, No. IPR2025-00958 (P.T.A.B. Sept. 12, 2025) (Paper 7). Petitioner argued that (1) the trial date of the underlying litigation is irrelevant for institution purposes because Petitioner is not a party to that litigation (*id.* at 13-15), (2) there are no settled expectations because the challenged patent “has *always* existed under a

³ Patent Owner statutorily disclaimed all other challenged claims, leaving only claim 7 at issue. *Id.*

cloud of invalidity” (*id.* at 6 (emphasis in original)), and (3) the Board previously found claim 7 not unpatentable only because the petitioner in that case forfeited obviousness arguments for certain limitations (*id.* at 6-8).

Acting Director Stewart issued a decision (Appx1-5) denying institution “based on the totality of the evidence and arguments the parties have presented.” Appx2. The decision noted that a final written decision would not issue before trial in the case brought by Fall Line against Petitioner’s customers. Appx2. The decision also explained, citing *Dabico*, that “the challenged patent has been in force for approximately nine years, creating settled expectations for Patent Owner.” *Id.* Finally, the decision, citing *Croga*, highlighted concerns with road mapping, i.e., using prior Board decisions regarding a challenged patent to guide strategy for subsequent challenges to the same patent. Appx3. Petitioner’s conduct raised road mapping concerns because Petitioner relied on the same prior art as the prior IPR, but purportedly addressed deficiencies identified by the Board in the prior proceeding. *Id.* Thus, the Acting Director concluded that

discretionary denial was appropriate. The Acting Director noted that “[a]lthough certain arguments are highlighted” in her decision “the determination to exercise discretion to deny institution is based on a holistic assessment of all of the evidence and arguments presented.” *Id.* at 3. Petitioner now seeks a writ of mandamus to overturn Acting Director Stewart’s decision.

ARGUMENT

I. Petitioner’s Statutory Complaints Are Barred By 35 U.S.C. § 314(d).

In § 314(d), Congress expressly precluded judicial review of the Director’s “determination ... whether to institute an inter partes review,” providing that the decision is “final and nonappealable.” 35 U.S.C. § 314(d). While various statutory strictures preclude the Director from granting a petition to institute an IPR, *see, e.g.*, 35 U.S.C. § 315(a), (b), the Supreme Court in *Cuozzo* held that the “decision to *deny* a petition [for IPR] is a matter committed to the Patent Office’s discretion,” *Cuozzo*, 579 U.S. at 273 (emphasis added). Accordingly, “no petitioner has a right to ... institution.” *Mylan*, 989 F.3d at 1382. And the Supreme Court further clarified in *Thryv, Inc. v. Click-to-Call*

Technologies, LP, 590 U.S. 45 (2020), that § 314(d)'s bar on appeals from institution decisions means that there is no judicial review of “challenges grounded in statutes related to the institution decision.” *See id.* at 56 (cleaned up).

This Court has recognized that § 314(d) does not bar this Court from “protect[ing] [its] prospective jurisdiction through mandamus” where the USPTO issues “[a] decision denying institution,” which “prevents the Board from issuing any final decision that falls within [this Court’s] direct appellate jurisdiction.” *Mylan*, 989 F.3d at 1380. But importantly, this Court has recognized that its mandamus jurisdiction is limited by Congress’s decision to commit the institution decision to the Director’s discretion and to prohibit appeals of such decisions: “[T]here is no reviewability of the Director’s exercise of [her] discretion to deny institution except for colorable constitutional claims.” *Id.* at 1382. “Given the limits on [the Court’s] reviewability,” *ultra vires* or other statutory arguments “cannot be a basis for granting [a] petition for mandamus” over a decision denying IPR institution. *Id.* at 1382-83. The Court reiterated this holding in *Motorola, Google, and SAP*, stating

that “mandamus is ordinarily unavailable for review of institution decisions,” including the type of purported constitutional claims and statutory challenges lodged here. *Motorola*, 2025 WL 3096514, at *3; *Google*, 2025 WL 3096849, at *1-2; *SAP*, 2025 WL 3096788, at *2.

These principles foreclose Petitioner’s mandamus petition insofar as it raises claims regarding statutory requirements, including those in the AIA and APA. Whatever constitutional claims § 314(d) might permit litigants to raise regarding institution denial through a mandamus petition, they do not include “run-of-the-mill statutory interpretation” questions reframed as constitutional violations. *Apple Inc. v. Vidal*, 63 F.4th 1, 13 (Fed. Cir. 2023); see *Mylan*, 989 F.3d at 1381-83 (rejecting two statutory challenges “[g]iven the limits on [the Court’s] reviewability” through mandamus of decisions not to institute IPR). In *Motorola*, the Court reiterated *Mylan*’s holding that such statutory arguments rooted in the APA are not available for mandamus relief. *Motorola*, 2025 WL 3096514, at *5. Thus, Petitioner’s claims that the USPTO violated the AIA and APA by imposing limitations on institution without notice-and-comment rulemaking (Pet. 11-15),

violated the APA by considering settled expectations and road mapping (Pet. 15-19), violated the APA's change-in-position doctrine (Pet. 19-22), and violated the APA by exceeding its authority (Pet. 22-29) necessarily fail.

Petitioner attempts to circumvent *Mylan* by relying on *SAS Institute, Inc. v. Iancu*, which stated that consistent with the APA, “judicial review remains” available if the USPTO has engaged in shenanigans “by exceeding its statutory bounds.” 584 U.S. 357, 371 (2018). But *SAS* neither involved mandamus jurisdiction nor sought review of an institution decision. *See id.* (specifically noting that “*SAS* does not seek to challenge the Director’s conclusion that” institution was warranted). Under this Court’s holdings in *Mylan* and *Motorola*—both issued against the backdrop of *SAS*—Petitioner cannot use mandamus to bring an APA challenge to the agency’s consideration of settled expectations and prior validity challenges as criteria for institution. *Mylan*, 989 F.3d at 1379-82 (explaining that the “extraordinary circumstances” for which mandamus is available to review “a denial of institution” are limited to “colorable constitutional

claims” regarding “the Director’s exercise of his discretion to deny institution”); *Motorola*, 2025 WL 3096514, at *5 (explaining that a petitioner’s “request is nothing but an attempted end run around § 314(d)’s bar on review”). This Court’s reliance on the holding from *Mylan* in *Motorola* to reject virtually identical arguments to those made here undercuts Petitioner’s suggestion that *Mylan*’s holding on the limits of mandamus review was somehow case specific. Pet. 31. This argument from Petitioner also fails based on the clear language from *Mylan* quoted above and this Court’s explanation in *Mylan* that the limit of mandamus review necessarily follows from “the statute’s bestowal of discretion on the Director combined with its prohibition on appeal of such decisions.” 989 F.3d at 1382.

Contrary to Petitioner’s attempt to expand mandamus to cover statutory APA claims, this Court has held that a party may raise certain APA arguments through a district-court action where the party, as a plaintiff, establishes standing to seek “prospective relief only,” rather than relief in connection with any prior institution-related decision. *See Motorola*, 2025 WL 3096514, at *5 (explaining that *Apple*

involved “a challenge to whether the PTO has complied with APA’s notice-and-comment rulemaking requirements ‘apart from the reviewability of a specific institution decision’” (quoting *Apple*, 63 F.4th at 14); *Apple*, 63 F.4th at 10; *see id.* at 14-17 (concluding plaintiff adequately demonstrated standing to bring a notice-and-comment challenge by showing “a substantial risk that the harm will occur in the future because of the instructions” it contended should have gone through notice-and-comment procedures) (quotation marks omitted)). As a remedy, this Court did not contemplate reversal of past institution denials, but rather a “change[] in a way favorable to” the plaintiff in the challenged “instructions” the Director issued to guide the future exercise of delegated institution discretion. *Apple*, 63 F.4th at 17. Importantly, however, this Court in *Apple* reiterated that § 314(d) bars APA challenges to even “content-focused challenges,” whether those challenges target an institution decision “the Director personally made ... accompanied by an explanation containing the” reasoning a plaintiff contends is unlawful, or an institution decision made by the Director’s delegate. 63 F.4th at 13. Here, to the extent Petitioner can

challenge any aspect of the USPTO's institution-related practices under the APA and AIA, it raises its arguments in the wrong court, through the wrong type of action, seeking the wrong sort of relief.

II. Petitioner's Due-Process Claims Are Simply Meritless Statutory Claims.

To be eligible for mandamus relief, a petitioner must show a "clear and indisputable" right to relief. *In re Dominion Dealer Sols., LLC*, 749 F.3d 1379, 1381 (Fed. Cir. 2014) (quotation marks omitted); *see also Cheney*, 542 U.S. at 380-81. Petitioner cannot establish a "clear and indisputable" constitutional violation warranting a writ of mandamus, much less one requiring the agency to revisit Acting Director Stewart's decision to deny IPR institution under Petitioner's preferred instructions. To the contrary, Petitioner's contention that the USPTO violated due-process principles in exercising its discretion to deny the relevant IPR petition is entirely without merit.

A. To begin with, Petitioner does not advance a viable constitutional due-process claim. Although Petitioner styles its arguments as "due process," it relies exclusively on the "change-in-position doctrine," which is an APA construct. *FDA v. Wages*

& *White Lion Invs., LLC*, 604 U.S. 542, 567 (2025). Petitioner’s purported due-process arguments, therefore, are merely APA claims barred under *Mylan*.

B. Even if Petitioner articulated a constitutional due-process claim, Petitioner has not identified the requisite interest to support a due-process challenge. The Due Process Clause protects against the deprivation “of life, liberty, or property, without due process of law.” U.S. Const. amend. V. “The first inquiry in every due process challenge is whether the plaintiff has been deprived of a protected interest” in liberty or property. *American Mfrs. Mut. Ins. Co. v. Sullivan*, 526 U.S. 40, 59 (1999).

As in *Motorola*, Petitioner cannot demonstrate a constitutionally protected interest in having the Director apply a particular set of discretionary criteria when determining whether to grant IPR institution. *See Motorola*, 2025 WL 3096514, at *3-4. In *Motorola*, the Court determined that the June 2022 Memo does not convey a protected property interest because it did not limit the Director’s discretion to deny institution. *Id.* at *4. The Court further determined that:

(1) there is no history or tradition supporting a constitutionally protected right to require the Director to consider any particular set of discretionary criteria and (2) Motorola’s “own unilateral expectation” of the Director applying a particular set of discretionary criteria does not support a due process claim. *Id.* Thus, like the petitioner in *Motorola*, Petitioner here has identified no constitutionally protected interest that could be the basis for a due-process claim.

C. Even if Petitioner could demonstrate a protected property interest in IPR institution, it still could not establish a due-process violation. “Once a property interest is shown, all due process requires is notice and an opportunity to be heard.” *Alberico v. United States*, 783 F.2d 1024, 1027 (Fed. Cir. 1986) (citing *Cleveland Bd. of Educ. v. Loudermill*, 470 U.S. 532, 546 (1985)). Here, the Acting Director issued a memo providing notice that she would consider settled expectations and prior challenges to patent validity when determining whether to institute review. Appx86. The Acting Director also issued decisions in *Dabico* and *Croga* that identified circumstances in which settled expectations and prior challenges to patent validity resulted in

institution denial. Petitioner took advantage of opportunities to be heard in its briefing, and argued for institution despite the presence of settled expectations and prior validity challenges. *Supra* at pp. 11-12.

Accordingly, the USPTO satisfied any due-process rights Petitioner had in the IPR institution process. *See Motorola, 2025 WL 3096514*, at * 4 (assuming “principles [regarding surprise] are applicable to this context” and explaining that nonetheless “Motorola did not experience anything close to the kind of unfair surprise that might raise a due process violation”). The relief Petitioner seeks is not to be heard on its IPR petition in light of institution criteria applied by Acting Director Stewart—because it was heard—but for the Acting Director Stewart to apply a former Director’s discretionary criteria and reach a different outcome. *See Pet. 2*. The Due Process Clause requires no such remedy and certainly does not guarantee Petitioner a specific outcome once heard. *See Motorola, 2025 WL 3096514*, at *4.

III. Petitioner’s Separation-Of-Powers Claims Are Simply Meritless Statutory Claims.

Petitioner contends that the Acting Director “invented IPR institution criteria untethered to the AIA” that violated “the

Constitution’s separation of powers.” Pet. 4. But this argument simply puts a constitutional label on arguments that are based solely on Petitioner’s view of the AIA. *See* Pet. 22-29. The Director’s weighing of discretionary institution criteria “does not raise any colorable constitutional challenge and is otherwise unreviewable.” *Google*, 2025 WL 3096849, at *2. The Supreme Court has carefully distinguished “between claims of constitutional violations and claims that an official has acted in excess of his statutory authority.” *Dalton v. Specter*, 511 U.S. 462, 472 (1994). The Constitution is implicated if executive officers rely on it as an independent source of authority to act, as in *Youngstown Sheet & Tube Co. v. Sawyer*, 343 U.S. 579 (1952), or if the officers rely on a statute that itself violates the Constitution, *see Dalton*, 511 U.S. at 473 & n.5. But claims alleging simply that an official has “exceeded his statutory authority are not ‘constitutional’ claims.” *Id.* at 473. Petitioner’s arguments that Acting Director Stewart’s reasons for discretionarily denying the petitions contravene the AIA do not state a constitutional claim and are thus not cognizable in this mandamus action. *See supra* pp. 13-19.

In any event, Petitioner’s statutory arguments are meritless. Petitioner’s contentions that Congress limited the Director’s discretion to deny institution (Pet. 23-27) contradict settled precedent. The Supreme Court, invoking both 5 U.S.C. § 701(a)(2) of the APA and 35 U.S.C. § 314(a) of the AIA held that “the agency’s decision to deny a petition is a matter *committed to the Patent Office’s discretion.*” *Cuozzo*, 579 U.S. at 273 (emphasis added); *see also United States v. Arthrex, Inc.*, 594 U.S. 1, 8 (2021).

Petitioner acknowledges that the Director has broad discretion to institute review under *Cuozzo* but argues that Congress provided “markers” and “boundaries” in §§ 325(d) and 315(d) limiting that discretion. Pet. 24-25. But Petitioner identifies no actual limitations in these provisions’ language, instead seeking to transform language reflecting the breadth of the Director’s flexibility in managing duplicative proceedings into a fetter on the Director’s discretion to deny institution. It is unsurprising that the Supreme Court and this Court have repeatedly examined the AIA and failed to find such extratextual strictures on the Director’s ability to decline to initiate an

administrative proceeding. *See Cuozzo*, 579 U.S. at 273 (relying on § 701(a)(2) to find that denying institution is committed to the USPTO’s discretion); *see also Mylan*, 989 F.3d at 1382; *Apple Inc.*, 63 F.4th at 15 (referencing “[t]he general rule that non-enforcement choices are committed to agency discretion by law.”); *Motorola*, 2025 WL 3096514, at *3; *see also Heckler v. Chaney*, 470 U.S. 821, 831–32, 836 (1985) (explaining that “an agency’s decision not to take enforcement action should be presumed immune from judicial review under § 701(a)(2)”).

Moreover, the language of §§ 325(d) and 315(d) is not superfluous in light of the broad discretion granted in § 314. Rather, the language of §§ 325(d) and 315(d) affords the Director specific authorities to address “Multiple Proceedings,” including “providing for stay, transfer, consolidation, or termination” of such matters. 35 U.S.C. § 315(d); *see id.* § 325(d) (same). And § 325(d)’s reference to the Director’s ability to decline to initiate various proceedings is not limited to IPR, and only emphasizes the Director’s discretion across multiple forms of USPTO processes, rather than limiting the Director’s discretion to deny IPR. Indeed, Petitioner’s suggestion that the Director’s ability to apply

“discretionary considerations” in denying IPR institution is limited to “§ 315(d)’s docket-management authority and § 325(d)’s anti-duplication authority” (Pet. 24) is in square conflict with decisions of this Court and the Supreme Court. *See Mylan*, 989 F.3d at 1382 (noting as an “example” that “the Director is free ... to determine that for reasons of administrative efficiency an IPR will not be instituted); *Cuozzo*, 579 U.S. at 273 (institution denial committed to USPTO discretion by law).⁴

Petitioner argues that the text of § 314 cannot provide the Director with broad discretion because § 314(a) “speaks in the negative” and does not mimic discretionary language elsewhere in the AIA in § 135(a)(1) and § 315(c). Pet. 26-27. But as discussed above, the Supreme Court has already held that the decision not to institute IPR proceedings is “committed to agency discretion by law.” *Cuozzo*,

⁴ Even if §§ 325(d) and 315(d) were redundant of the Director’s broad discretion in § 314, “redundancy in one portion of a statute is not a license to rewrite or eviscerate another portion of the statute contrary to its text.” *Barton v. Barr*, 590 U.S. 222, 239 (2020); *see also id* (“redundancies are common in statutory drafting—sometimes in a congressional effort to be doubly sure, sometimes because of congressional inadvertence or lack of foresight, or sometimes simply because of the shortcomings of human communication.”).

579 U.S. at 273. Petitioner’s argument that the settled expectations guidance or an “age cap,” akin to the one for post-grant reviews, is not written in the statute (Pet. 27-28) is similarly inapposite in view of congressional intent to provide the Director with discretion over IPR institution.

IV. Petitioner Cannot Satisfy The Other Mandamus Factors.

Even if it could meet the mandamus standard’s demanding merits bar, Petitioner could not satisfy the remaining two factors: the absence of “adequate alternative means to obtain the relief” sought and a showing that “the writ is appropriate under the circumstances.”

Dominion Dealer Sols., 749 F.3d at 1381 (quotation marks omitted); *see also Cheney*, 542 U.S. at 380-81.

A. Petitioner Has Alternate Means of Relief.

In a single sentence, Petitioner contends that it has no alternative means of relief because this Court has stated that “there is no adequate remedy by way of direct appeal.” Pet. 34 (quoting *In re Palo Alto Networks, Inc.*, 44 F.4th 1369, 1374 (Fed. Cir. 2022)). But the only harm Petitioner claims is the denial of one avenue for challenging

patent claims.⁵ There is no question that there are other avenues for Petitioner to pursue validity challenges, including in district court⁶ or ex parte reexamination. *Cf. Motorola*, 2025 WL 3096514, at *4 (recognizing that IPR institution denial does not affect petitioner's ability to raise patentability issues elsewhere). Petitioner's abbreviated discussion does not address these obvious alternative means of relief, so Petitioner cannot carry its burden to show that the alternatives are inadequate. And the fact that the alternate relief available is not a party's preferred type does not make that relief inadequate or support a grant of mandamus. *See Fornaro v. James*, 416 F.3d 63, 69 (D.C.

⁵ In a hypothetical case, a petitioner might contend that the USPTO violated the Constitution in the course of denying institution in a way that inflicted some independent harm, e.g., by violating the Equal Protection Clause. But here, Petitioner asserts no such harm.

⁶ Maplebear filed a complaint against Fall Line seeking a declaratory judgement of non-infringement. *Maplebear, Inc. v. Fall Line Patents, LLC*, No. 4:25-cv-00137-SEH-MTS (N.D. Okla. Mar. 25, 2025) (ECF No. 2.). Maplebear also sought to dismiss Fall Line's infringement counterclaims, arguing that the claims are invalid under § 101 (*id.* at ECF No. 48), but has not yet argued in district court that the claims are invalid over the prior art cited in its IPR petition. As of the filing of this brief, the district court has not issued a scheduling order (*id.* at ECF No. 46) and, therefore, Maplebear may seek to amend its pleadings to allege that the claims are invalid over the prior art. Fed. R. Civ. P. 15(a)(2).

Cir. 2005); *Barnhart v. Devine*, 771 F.2d 1515, 1527 (D.C. Cir. 1985); *Bryan v. McDonald*, 615 F. App'x 681, 684 (Fed. Cir. 2015) (unpublished).

B. Mandamus Relief Is Inappropriate Under the Circumstances.

Finally, “even if the first two prerequisites [for mandamus] have been met, the issuing court, in the exercise of its discretion, must be satisfied that the writ is appropriate under the circumstances.” *Cheney*, 542 U.S. at 381. For the reasons discussed above, (1) Petitioner has not advanced any colorable constitutional claims for this Court to hear on mandamus; (2) Petitioner had notice and an opportunity to be heard regarding the institution criteria applied by Acting Director Stewart in its IPR; and (3) Petitioner may still pursue its invalidity defenses in the district court litigation or file ex parte reexamination requests.

But even beyond Petitioner’s inadequate legal showing and multiple other routes to challenging patent claims, Petitioner seeks an inappropriate exercise of this Court’s mandamus authority. Petitioner asks this Court to force the current USPTO leadership to abandon its policy guidance in favor of a prior Director’s view of how to exercise the

broad discretion Congress entrusted to the USPTO Director. Petitioner casts this Director's policy determinations as conflicting with "statutory criteria" for institution (Pet. 35) and seeks to reverse policy determinations reflected by the relevant guidance. *See* Appx85-96. That is not the system Congress enacted. Issuing the writ Petitioner requests would not only inappropriately encroach on the Director's statutory discretion, it would raise political-accountability concerns, hamstringing the current Director from responding to evolving conditions facing the agency and making his own policy judgments. *See Arthrex*, 594 U.S. at 21. Nothing in these circumstances indicates that this is the sort of extraordinary situation that could warrant this Court's issuance of an extraordinary writ.

CONCLUSION

The Court should deny the petition for a writ of mandamus.

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November 19, 2025

CERTIFICATE OF COMPLIANCE

I certify that the foregoing Director's Response to Petition for Writ of Mandamus complies with the type-volume limitation of Federal Rule of Appellate Procedure 21(d)(1) because it contains 5,482 words, excluding the table of contents, table of authorities, and signature block, as measured by the word-processing software used to prepare this filing.

Dated: November 19, 2025

/s/ Fahd H. Patel

Fahd H. Patel