No. 26-_____

IN THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

IN RE INTEL CORPORATION and LENOVO (UNITED STATES) INC.,

Petitioners.

PETITION FOR A WRIT OF MANDAMUS

On Petition for a Writ of Mandamus to the United States Patent and Trademark Office, Patent Trial and Appeal Board, in No. IPR2025-00838

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November 21, 2025

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CERTIFICATE OF INTEREST

Case Number	26-____
Short Case Caption	In re Intel Corporation and Lenovo (United States) Inc.
Filing Party/Entity	Intel Corporation; Lenovo (United States) Inc.

Instructions: Complete each section of the form. In answering items 2 and 3, be specific as to which represented entities the answers apply; lack of specificity may result in non-compliance. **Please enter only one item per box; attach additional pages as needed and check the relevant box**. Counsel must immediately file an amended Certificate of Interest if information changes. Fed. Cir. R. 47.4(b).

I certify the following information and any attached sheets are accurate and complete to the best of my knowledge.

Date: November 21, 2025 Signature: */s/ Debra J. McComas*

Name: Debra J. McComas

1. Represented Entities. Fed. Cir. R. 47.4(a)(1).	**2. Real Party in Interest.** Fed. Cir. R. 47.4(a)(2).	**3. Parent Corporations and Stockholders.** Fed. Cir. R. 47.4(a)(3).
Provide the full names of all entities represented by undersigned counsel in this case.	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.	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/Not Applicable	__None/Not Applicable	__ None/Not Applicable
Intel Corporation	Motorola Mobility LLC	Lenovo Holding Company, Inc.
Lenovo (United States) Inc.	Lenovo Group Limited	Lenovo Group Limited
		Legend Holdings Corporation

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).

___ None/Not Applicable __ Additional pages attached

David M. O'Dell (Haynes and Boone, LLP)	David McCombs (Haynes and Boone, LLP)	Clint Wilkins (Haynes and Boone, LLP)

5. Related Cases. Other than the originating case(s) for this case, are there related or prior cases that meet the criteria under Fed. Cir. R. 47.5(a)?
_X_ Yes (file separate notice; see below)__ No __ N/A (amicus/movant)
If yes, concurrently file a separate Notice of Related Case Information that complies with Fed. Cir. R. 47.5(b). **Please do not duplicate information.** This separate Notice must only be filed with the first Certificate of Interest or, subsequently, if information changes during the pendency of the appeal. Fed. Cir. R. 47.5(b).

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).

_X_ None/Not Applicable ___ Additional pages attached

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STATEMENT OF RELATED CASES

No other appeal in or from the same *inter partes* review ("IPR") proceeding (IPR2025-00838) was previously before this or any other appellate court.

The patent at issue in this proceeding (U.S. Patent No. RE47,720 ("the '720 patent")) is or was involved in the following cases:

- *USTA Technology, LLC v. Lenovo Group Limited*, 4-24-cv-00515 (EDTX)
- *USTA Technology, LLC v. Google LLC f/k/a Google Inc.*, 6-22-cv-01214 (WDTX)
- *USTA Technology, LLC v. Google LLC*, 4-23-cv-03748 (NDCA)
- *USTA Technology, LLC v. Samsung Electronics Co., Ltd.*, 4-24-cv-00517 (EDTX)
- *USTA Technology, LLC v. LG Electronics, Inc.*, 4-24-cv-00516 (EDTX)
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- *AT&T Services, Inc. v. USTA Technology, LLC*, IPR2025-01166 (PTAB)

RELIEF SOUGHT

Intel Corporation and Lenovo (United States) Inc. ("Petitioners") respectfully request a writ of mandamus vacating the non-institution decision in IPR2025-00838. The Court should direct the U.S. Patent and Trademark Office ("USPTO") to reconsider institution solely under the statutory criteria, not the agency's extra-statutory framework. At a minimum, the Court should direct the USPTO to reconsider institution without the rationale it applied here.

INTRODUCTION

The USPTO denied Petitioners' request for *inter partes* review ("IPR") due to the availability of *ex parte* reexamination ("EPR"). Appx2. But EPR is always an alternative to IPR. This rationale, if upheld, would allow the USPTO to deny IPR in any case just because EPR exists.

Congress established IPR to supplement other avenues for challenging patent validity, including EPR. Here, rejecting IPR in favor of EPR, the USPTO exceeded the authority granted by Congress, violating the separation of powers and the statutes governing IPR.

The agency also exceeded its authority and violated due-process anti-retroactivity restrictions by applying this new rationale post-hoc—after Petitioners already chose IPR over EPR and surrendered tens of thousands of dollars to the agency in filing fees. Moreover, the USPTO's rationale here violates the Fifth Amendment and the Administrative Procedure Act ("APA") because it is irrational. In *every* case, IPR petitioners could try EPR instead. The USPTO had no basis to force Petitioners to take that path. And, in any event, the USPTO's decision here violates the Fifth Amendment and the APA because it contradicts the USPTO's own precedent. In seeking denial of institution, the patent owner relied on agency

precedent establishing certain conditions for denying institution. The Director expressly found those conditions absent here, yet denied institution anyway.

While 35 U.S.C. §314(d) generally bars appeals attacking institution determinations in "ordinary" case-specific "dispute[s]," §314(d) does not bar review of agency "shenanigans," including rulings that violate constitutional rights or exceed statutory authority. *Cuozzo Speed Techs. v. Lee*, 579 U.S. 261, 274-75 (2016). That standard applies here. Mandamus is the sole mechanism available to compel the USPTO to comply with its statutory obligations in deciding Petitioners' IPR petition, and Petitioners respectfully request that the Court grant mandamus relief.

ISSUES PRESENTED

1. Did the USPTO violate the Constitution's separation of powers, the America Invents Act ("AIA"), and the APA by denying institution based solely on a preference for *ex parte* reexamination?

2. Did the USPTO exceed its authority and violate the Fifth Amendment's Due Process Clause by applying a novel rationale retroactively?

3. Is the USPTO's basis for denying IPR here arbitrary and irrational, contrary to the Fifth Amendment and the APA?

4. Did the USPTO violate the Fifth Amendment and the APA by disregarding its own precedent?

BACKGROUND

I. Congress established IPR to promote challenges to questionable patents.

In enacting the AIA, Congress believed "questionable patents" were "too easily obtained" and "too difficult to challenge." H.R. Rep. No. 112-98, at 39 (2011). It therefore established IPR, allowing anyone to petition the USPTO to conduct a limited review of granted patents. 35 U.S.C. §311.

To decide whether to institute an IPR, Congress instructed the Director to determine whether "there is a reasonable likelihood that the petitioner would prevail." §314(a). The USPTO "may not" institute IPR unless that requirement is met. §314(a). Congress also established other conditions that bar institution if not met (*e.g.*, §315(b)) and specific criteria for the USPTO to consider at its discretion (*e.g.*, §315(d)). But the AIA does not give the USPTO discretion to create new institution criteria beyond those identified by Congress.

In establishing IPR, Congress added to a pre-existing avenue for challenging patent validity that already included EPR. 35 U.S.C. §§301-305. EPR has existed since 1981 and has always been a limited remedy. Pub. L. No. 96-517 (enacted 1980). Unlike IPR, EPR does not allow the patent challenger to participate beyond the initial

filing of a request for review; instead, the discourse is between the USPTO and the patent owner only. §305. In the AIA, Congress retained EPR but also added IPR. Pub. L. No. 112-29 §6 (2011). It created this modern scheme, with multiple avenues for reviewing granted patents, with the purpose of "providing a more efficient system for challenging patents that should not have issued." H.R. Rep. 112-98, at 39-40.

II. Petitioners sought IPR.

Over the last three years, USTA Technology, LLC (USTA) has filed more than ten patent infringement lawsuits alleging infringement of U.S. Patent No. RE47,720 (the '720 patent), which issued in 2019. Appx107-108; *supra* 1. One such lawsuit was brought against Lenovo entities, including Petitioner Lenovo (United States), Inc.[1] Appx227. There is no pending trial date in the current iteration of that lawsuit. Appx220-226.

[1] USTA sued Petitioner Lenovo (United States), Inc., Lenovo Global Technology (United States) Inc., and their corporate parent, Lenovo Group Limited. Appx227-228. USTA later amended its complaint, naming the corporate parent alone as the defendant, while alleging infringement by "subsidiaries, affiliates, retail partners and customers" and specifically naming products sold by Lenovo (United States), Inc., incorporating chips provided by Intel. Appx240-244, Appx250-251, Appx263-270.

In October 2024, a third party not involved in this case, Unified Patents, filed an EPR request on certain claims of the '720 patent. Appx202-203. An EPR Certificate issued August 26, 2025. Appx164 n.1.

In April 2025, Petitioners filed an IPR petition challenging claims 53 and 95 of the '720 patent. Appx20, Appx25 [Petition]. They paid $23,750 in non-refundable filing fees (Appx9) and incurred substantial costs preparing the petitions and supporting declarations.

III. The USPTO denied institution here based on the availability of *ex parte* reexamination.

In mid-September, the then-Acting Director issued a Decision Denying Institution of *Inter Partes* Review (the "Decision"). At the time of the Decision, there was no pending EPR involving the '720 patent. The Decision acknowledged the prior EPR (the one sought by a third party and not involving Petitioners here). Appx2. But it identified ways in which the EPR had not covered issues central to this IPR petition. First, "[o]f the two claims challenged in the Petition," one was not "subject to reexamination" in the EPR. Appx2 n.1. Second, the Decision identified "evidence demonstrating that" in the EPR, "the patent examiner did not consider" a prior art reference (Walton), raised in this IPR petition, that "is material to the patentability of the challenged claim." Appx2.

Yet the then-Acting Director denied institution, with the only stated reason being that (after "a holistic assessment") she believed it would be "most efficient" "for Petitioner to file a reexamination request that includes Walton." Appx2. This mandamus petition followed.

STANDARD OF REVIEW

This Court has "jurisdiction to review any petition for a writ of mandamus denying institution of an IPR." *Mylan Lab'ys Ltd. v. Janssen Pharmaceutica, N.V.*, 989 F.3d 1375, 1381 (Fed. Cir. 2021). A petitioner must show "a clear and indisputable legal right," the lack of "other adequate method of obtaining relief," and the writ's "appropriate[ness]" "under the circumstances." *Id.* at 1382.

REASONS WHY THE WRIT SHOULD ISSUE

I. The USPTO's errors are clear and indisputable.

Petitioners respectfully request that the USPTO's rationale be set aside for multiple independent reasons. *First*, it violates the constitutional separation of powers, the AIA, and the APA by sidestepping the IPR scheme that Congress established. *Second*, it exceeds the agency's authority and violates due process because it is retroactive and impairs Petitioners' interest without notice and opportunity to be heard. *Third*, the USPTO's basis for denying IPR here is irrational and thus violates the Fifth Amendment and the APA. *Fourth*, in denying institution

here, the USPTO disregarded its own precedent in violation of the Fifth Amendment and the APA.

A. The USPTO's rationale forecloses access to IPR.

In declining to consider the merit of this IPR petition because EPR exists as another avenue to challenge patent validity, the USPTO exceeded its authority—thus usurping Congress's legislative power, violating the AIA and the APA (*see* 5 U.S.C. §706(2)(A)-(C)).

1. The USPTO lacks authority to deny IPR merely because EPR exists as an alternative.

The USPTO's decision here denied IPR because a patent challenger can seek EPR instead. Yet EPR has always been an alternative to IPR. The USPTO's rationale would empower it to deny IPR in every case, thereby contradicting the congressional scheme.

Congress established IPR and EPR to co-exist. It created IPR as a supplement to EPR: EPR had already existed for decades, but Congress—believing "questionable patents" were "too difficult to challenge"—additionally established IPR. H.R. Rep. No. 112-98. Congress gave patent challengers the statutory right to seek IPR, EPR, or both. §§302, 311. And while Congress gave the USPTO tailored authority to manage its dockets, §§315(d), 325(d), it did not authorize the USPTO to decide whether IPR should exist as an avenue for patent challenges. Whatever

discretion Congress gave the USPTO over IPR institution, it did not empower the agency to delete IPR from the U.S. Code. *W. Virginia v. EPA*, 597 U.S. 697, 723 (2022) ("Agencies have only those powers given to them by Congress, and enabling legislation is generally not an open book to which the agency may add pages and change the plot line." (alterations omitted)).

2. Congress did not empower the Director to create extra-statutory institution criteria.

The USPTO's rationale here also exceeds its authority for a more fundamental reason. Congress did not give the USPTO power to create new reasons to deny institution, like denying institution because EPR exists as an alternative. Congress instead outlined specific institution criteria for the Director to consider. *E.g.*, §§314(a), 315(d), 325(d). It granted discretion in applying some of *those* criteria, as well as limited authority to promulgate "regulations" implementing *those* criteria, which the agency has failed to do (§316(a)(2), (b)).

In the AIA, Congress instructed the agency to *apply* statutory requirements, not create new ones. It specified the core merits threshold in §314(a); it instructed parties to address the "requirement[s] *of this chapter*" (§313 (emphasis added)); and it set forth other reticulated considerations. Some are firm bars (§315(b)'s time limit and §315(e)'s estoppel). Some are discretionary considerations (§315(d)'s docket-

management authority and §325(d)'s anti-duplication authority). Those are the criteria the USPTO must apply when deciding whether to institute IPR.

To be sure, the Director has broad "discretion" within the AIA's statutory markers. *Cuozzo*, 579 U.S. at 273. But discretion *within* markers is not discretion to fashion new boundaries. And the AIA nowhere grants the USPTO power to ignore Congress's framework and invent *new* criteria. "Administrative agencies are creatures of statute"; they "possess only the authority that Congress has provided." *Nat'l Fed'n of Indep. Bus. v. Dep't of Lab., Occupational Safety & Health Admin.*, 595 U.S. 109, 117 (2022).

And Congress carefully specified when the Director may exercise discretion in IPR institution. In §325(d), Congress provided that, in instituting certain proceedings (including IPRs), the Director "may" consider whether "the same or substantially the same prior art or arguments previously were presented to the Office." §325(d). Congress granted the Director discretion in applying that criterion (the Director "may" reject a petition) and further authorized accompanying regulations to flesh out the standard. §316(a)(2). Those regulations must consider effects on "the patent system" (by avoiding inconsistent outcomes on the same prior art or arguments) and "efficient [agency] administration" (by avoiding redundant proceedings). §316(b). But none of this matters under the USPTO's current

position. If the USPTO already has unfettered discretion to consider anything it chooses at institution, it would render §325(d)'s authority redundant. That express section should not be read as a mere suggestion (at best) or superfluous (at worst). *See Gustafson v. Alloyd Co.*, 513 U.S. 561, 574 (1995) (avoiding such "redundan[cy]"); *Indep. Ins. Agents of Am., Inc. v. Hawke*, 211 F.3d 638, 643-44 (D.C. Cir. 2000) (rejecting agency's attempt to read broad authority into statute where specific provisions conferred only a subset of the claimed authority); *Halverson v. Slater*, 129 F.3d 180, 185 (D.C. Cir. 1997).

Similarly, in §315(d), Congress authorized the USPTO to "stay, transfer, consolidat[e], or terminat[e]" related proceedings. §315(d). This expressly authorizes the Director to manage the agency's docket when overlapping proceedings are pending before the agency. Again, Congress granted discretion in applying that criterion (the Director "*may* determine" how such proceedings "may proceed" (emphasis added)), and authorized implementing regulations. §316(a)(2), (b). Yet under the USPTO's view, those tailored provisions are unnecessary because the agency has complete discretion over institution already.

The USPTO invokes §314(a) as the source of the Director's discretion. *See* AD's Resp., *In re SAP Am., Inc.*, No. 25-132, ECF No. 39 at 12; *see also* Appx3 (denying petition under §314(a)). But that subsection grants no such authority.

Section 314(a) textually imposes a direct requirement for institution: the USPTO "may not authorize an [IPR] to be instituted unless" there is "a reasonable likelihood that the petitioner would prevail." §314(a). This provision, speaking in the negative, sets the critical threshold. *Id.* It does not grant the Director authority to impose *any* criteria the Director wishes. It is implausible that Congress, in a provision setting forth what the Director "may not" do (§314(a)), hid the vast power to redefine the conditions for instituting IPR—a scheme at the heart of the patent system and the national economy.

Nor does it help the USPTO that §314(a) does not *mandate* institution when the merits threshold is met. Even for petitions meeting that threshold, Congress supplied other criteria *outside* §314(a) that could still defeat institution. *E.g.*, §§315(b), (d), (e), 325(d). But it was *Congress* that chose these additional criteria.

Congress's express grant of discretion in two accompanying AIA sections confirms it did not grant broader discretion here. For derivation proceedings, Congress provided "the Director *may* institute" if the requisite "standards . . . are met." §135(a)(1) (emphasis added). Similarly, for joinder petitions, "the Director, *in his or her discretion*, *may* join" parties otherwise satisfying §314. §315(c) (emphases added). Yet no comparable authority exists for IPR institution. "When Congress includes particular language in one section of a statute but omits it from a neighbor,

we normally understand that difference in language to convey a difference in meaning." *Bittner v. United States*, 598 U.S. 85, 94 (2023); *see also Gallo v. Dep't of Transp.*, 725 F.3d 1306, 1310 (Fed. Cir. 2013) (expressio unius); *Hawke*, 211 F.3d at 643-44; *Halverson*, 129 F.3d at 185. Congress expressly conferred discretion elsewhere in the AIA, but not for inventing IPR institution criteria; the Court should enforce that congressional choice.

B. Retroactively imposing the rationale exceeds the USPTO's power and violates due process.

Petitioners had no way to anticipate that their IPR petition would be denied because the USPTO preferred EPR over IPR. No such rule existed when Petitioners filed their IPR petition, or when the parties argued before the agency about whether institution should be granted. Instead, the USPTO introduced this rationale in its decision here and imposed it retroactively—too late for Petitioners to recover the tens of thousands of dollars paid in filing fees.

An agency lacks "power to promulgate retroactive rules unless that power is conveyed by Congress in express terms." *Bowen v. Georgetown Univ. Hosp.*, 488 U.S. 204, 208 (1988); *see Bd. of Cnty. Comm'rs of Weld Cnty. v. EPA*, 72 F.4th 284, 292 (D.C. Cir. 2023). The AIA confers no power to make IPR rules retroactive. Yet here, the USPTO retroactively imposed a rule that did not exist when Petitioners filed their petition.

Moreover, the USPTO's retroactive application of its EPR rule violates due process. "Retroactivity is not favored in the law." *Princess Cruises, Inc. v. United States*, 397 F.3d 1358, 1362 (Fed. Cir. 2005) (citation omitted). "The Due Process Clause limits the extent to which the Government may retroactively alter the legal consequences of an entity's or person's past conduct." *PHH Corp. v. CFPB*, 839 F.3d 1, 46-47 (D.C. Cir. 2016) (Kavanaugh, J.), *order vacated* (Feb. 16, 2017), *reinstated in relevant part*, 881 F.3d 75, 83 (D.C. Cir. 2018). "Due process therefore requires agencies to 'provide regulated parties fair warning of the conduct a regulation prohibits or requires.'" *Id.* (citation omitted). And "an administrative agency may not apply a new rule retroactively when to do so would unduly intrude upon reasonable reliance interests." *Heckler v. Cmty. Health Servs. of Crawford Cnty., Inc.*, 467 U.S. 51, 61 n.12 (1984).

This Court, applying the "retroactivity doctrine," examines the "'nature and extent of the change in the law,' 'the degree of connection between the operation of the new rule and a relevant past event,' and 'familiar considerations of fair notice, reasonable reliance, and settled expectations.'" *Princess Cruises*, 397 F.3d at 1362, 1364 (quoting *Landgraf v. USI Film Prods.*, 511 U.S. 244, 270 (1994)). "If, under this test, a rule or regulation appears to have a retroactive effect, then the rule or

regulation cannot be applied to cases pending at the time of its promulgation." *Rodriguez v. Peake*, 511 F.3d 1147, 1153 (Fed. Cir. 2008).

For example, in *Princess Cruises*, this Court held it impermissible to apply an agency ruling to conduct preceding the ruling (which imposed a new standard governing cruise-ship taxes and a new evidentiary presumption). 397 F.3d at 1363-67. The new ruling qualified as a significant change in law because it established an evidentiary presumption "nowhere to be found in" the "statute or regulations." *Id.* at 1365. The ruling disadvantaged parties for past conduct: cruise lines had not kept records to meet the new evidentiary presumption. *Id.* at 1366. And it would have been unfair to apply the new rule too late for parties to change their behavior to comply. *Id.*[2]

Similarly, a "new rule concerning the filing of complaints would not govern an action in which the complaint had already been properly filed under the old regime." *Landgraf*, 511 U.S. at 275 & n.29. So too for a new limit on notices of appeal

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[2] In *Princess Cruises*, the agency also sent the party a letter indicating that one rule would apply before imposing a new one retroactively. 397 F.3d at 1366. But that fact was not essential; even without it, retroactive application was unlawful. *Carnival Cruise Lines, Inc. v. United States*, 404 F.3d 1312, 1319 (Fed. Cir. 2005). And the entire point of public agency guidance is to assure regulated stakeholders what to expect; the USPTO's retroactive shift here is just as invalid as in *Princess Cruises* and *Carnival Cruise Lines*.

"if it would render invalid a notice that was valid when filed." *Durr v. Nicholson*, 400 F.3d 1375, 1380 (Fed. Cir. 2005); *see also Woodward v. DOJ*, 598 F.3d 1311, 1315 (Fed. Cir. 2010) (new burden of proof cannot be applied to already-pending case).

The USPTO violated those anti-retroactivity principles here. It did what the Supreme Court and this Court have denounced: just as imposing a new constraint on already-filed complaints or notices of appeal is impermissible, so is doing so for already-filed IPR petitions. *See Landgraf*, 511 U.S. at 275; *Durr*, 400 F.3d at 1380.

Applying the EPR rule here fails under every prong of this Court's retroactivity framework. To begin, a preference for EPR over IPR is "nowhere to be found in" the "statutes or regulations" and thus "changes the law in a significant way." *Princess Cruises*, 397 F.3d at 1365.

Next, applying this change disadvantaged Petitioners for past events. *See id.* at 1366. The USPTO's divert-to-EPR rule penalizes them for seeking IPR instead of EPR. Yet Petitioners had no idea they needed to proceed by EPR instead of IPR. To the contrary, as in *Princess Cruises*, there was a "common [industry] understanding" that parties "had no need to" do what the agency's new rule requires. *Id.*

The resulting unfairness is evident. Imposing a new rule at a time when it "cannot possibly be met" (too late for Petitioners to have avoided a futile IPR petition by seeking EPR instead) "strongly implicates fairness considerations." *Id.*

Had Petitioners known sooner, they could have avoided expending substantial resources on this IPR petition.

The USPTO's new rule also destroyed reasonable reliance interests. Petitioners detrimentally relied on the institution standards existing when they filed for IPR. Under those standards, the petition was meritorious. The USPTO's decision shows as much: it articulated no specific reason for denying institution besides the new divert-to-EPR rule. Appx2. Indeed, Petitioners had an especially strong expectation that those pre-existing standards would hold, because the USPTO had repeatedly indicated that any change would come through notice-and-comment rulemaking—and the proposed rules never mentioned that institution would be denied simply because EPR exists. *See* 88 Fed. Reg. 24,503, 24,505 (2023) (discussing institution discretion and stating "USPTO intends to make policy changes through notice-and-comment rulemaking"); 89 Fed. Reg. 28,693 (2024) (proposing rules for institution discretion). Petitioners had no way to anticipate that their petition would be denied simply because EPR continues to exist.

The USPTO never acknowledged its retroactive application of a novel rationale for denying institution. Nor is any rational justification possible. It is unreasonable to induce parties to pay the agency tens of thousands of dollars in fees

by announcing one set of institution standards, to deny petitions under a new, unmeetable standard.

The above is more than enough to establish a violation of due-process anti-retroactivity principles. *Princess Cruises*, 397 F.3d at 1362; *Rodriguez*, 511 F.3d at 1153. No analysis of other due-process frameworks is necessary. *GPX Int'l Tire Corp. v. United States*, 780 F.3d 1136, 1141 (Fed. Cir. 2015) (when party challenges a law "because it operates retroactively," "we do not think that the outcome of the due process analysis depends upon a determination that a vested right exists").

But the USPTO also impaired protected interests. Money is property, and Petitioners lost property—substantial, non-refundable filing fees—they would not have surrendered had they known of the new rule. Petitioners received no notice or opportunity to be heard "at a time when the deprivation c[ould] still be prevented"—that is, before filing the IPR petition. *Fuentes v. Shevin*, 407 U.S. 67, 81 (1972). Moreover, Petitioners did not even have notice of the newfound rule before the decision. Whether assessed as a deprivation of property and liberty without notice and opportunity to be heard, or as a violation of anti-retroactivity doctrine, the post-hoc reason for denying institution here was impermissibly retroactive.

The violations of anti-retroactivity constraints here go beyond the claim this Court rejected in *In re Motorola Sols., Inc.*, —F.4th—, 2025 WL 3096514 (Fed. Cir.

Nov. 6, 2025). *Motorola* did not confront a claim that the USPTO lacks authority to regulate retroactively. *Supra* 14. And *Motorola*'s due-process claim involved different analysis. For one, that petitioner did not invoke this Court's anti-retroactivity test from *Princess Cruises*. For another, the only potential "property right" addressed in *Motorola* was "consideration of [IPR] petitions on the merits without risking discretionary denial based on parallel district court proceedings." *Id.* at *4 (quotation marks omitted). Here, Petitioners' claim under *Princess Cruises* obviates any vested-right analysis. *Princess Cruises*, 397 F.3d at 1362; *Rodriguez*, 511 F.3d at 1153; *GPX*, 780 F.3d at 1141; *supra* 9. And in any event, Petitioners invoke different protected interests: substantial, non-refundable filing fees, which are undeniably property. *Motorola*'s rejection of a *different* asserted interest is therefore inapplicable here. And because relief in this proceeding is the only way Petitioners can get what they were promised in exchange for those fees—fair consideration of their IPR petition—it is irrelevant that the *Motorola* petitioner could redress its different asserted harm by pursuing patentability defenses elsewhere (2025 WL 3096514, at *5).

And the situation here is also different from *Motorola* because Petitioners were never "on notice" the USPTO would deny a petition simply because EPR exists as an alternative. *Motorola*, 2025 WL 3096514, at *4; *supra* 18. Deploying this novel

basis for denying IPR here violates the basic due-process principle *Motorola* reaffirmed: "individuals should have an opportunity to know what the law is and to conform their conduct accordingly." *Id.* (quoting *Landgraf*, 511 U.S. at 265).

C. The USPTO violated the Fifth Amendment and the APA by applying its rationale with no rational basis for distinguishing this case from others.

If valid, the USPTO's rationale would give it license to deny IPR in every case merely because EPR exists as an alternative. But the USPTO has not in practice deployed that rationale in every case. Instead, the USPTO wields this purported authority selectively, arbitrarily denying institution here while permitting it elsewhere (even though EPR is equally available in those other cases). No rational justification exists for sending Petitioners (but not other patent challengers) to EPR. The USPTO's application of its rationale violates the Fifth Amendment and the APA.

The Constitution forbids the government from "rely[ing] on a classification whose relationship to an asserted goal is so attenuated as to render the distinction arbitrary or irrational." *City of Cleburne, Tex. v. Cleburne Living Ctr.*, 473 U.S. 432, 446 (1985). Due process and equal protection require a rational basis for government action, and that scrutiny "is not a toothless one." *Mathews v. Lucas*, 427 U.S. 495, 510 (1976); *see Romer v. Evans*, 517 U.S. 620, 631-35 (1996). Similarly, the APA

prevents agency action that is "arbitrary, capricious, [or] an abuse of discretion" (5 U.S.C. §706(2)(A)), which requires a "rational connection between the facts found and the choice made." *In re Brunetti*, 151 F.4th 1367, 1378 (Fed. Cir. 2025).

The USPTO had no rational basis for requiring EPR over IPR in this case but not others. The USPTO routinely grants institution when, as here, the IPR petition raised obviousness challenges that could also be raised in EPR. *E.g.*, *Advanced Micro Devices, Inc. v. XtreamEdge, Inc.*, IPR2025-00223, Paper 14 (PTAB Nov. 6, 2025); *Zhuhai Cosmx Battery Co. v. Ningde Amperex Tech.*, IPR2025-00389, Paper 10 (Sept. 9, 2025). Likewise, it grants institution specifically when, as here, a prior art reference was previously submitted to the Office but the examiner failed to consider it. *E.g.*, *Anthony Inc. v. ControlTec, LLC*, IPR2025-00559, Paper 12, at 2 (Acting Director July 16, 2025); *id.* Paper 13 (PTAB Aug. 25, 2025). The USPTO could not identify any principle distinguishing this case from those to justify diverting this case to EPR.

Instead, the USPTO's discussion of case-specific facts here only highlights the absence of any rational distinction between this case and any other IPR case. The Decision admits that the IPR petition's key contentions were *not* previously considered in EPR. For one, the IPR petition challenges two patent claims, but only one was previously subject to EPR. Appx2 n.1. For another, the decision finds

evidence that the primary prior-art reference in the IPR petition (Walton) is "material to patentability" yet the USPTO "did not consider" it during EPR. Appx2. So for the very reasons the USPTO emphasized, the previous EPR is immaterial: this IPR petition raises invalidity issues the EPR did *not* address. There is no reason why it would be more "efficient" (Appx2) here, but not in other cases, to raise new issues in EPR over IPR. That is especially so when the USPTO's standard practice is *not* to assign a new EPR to an examiner who already reviewed the patent (whether in prosecution or a prior EPR). USPTO, *Manual of Patent Examining Procedure* §2236, https://www.uspto.gov/web/offices/pac/mpep/s2236.html. Nothing rationally separates this case from any other in which the USPTO could direct an IPR petitioner "to file a reexamination request" (Appx2).

D. The USPTO violated the Fifth Amendment and the APA by ignoring its own precedent.

The Decision violated another bedrock legal constraint by disregarding the agency's own precedent. The parties litigated their dispute before the agency under binding USPTO precedent. But the Decision never mentions that precedent—and instead contradicts it.

Although the Decision cited no authority at all for requiring Petitioner to seek EPR instead of IPR (Appx2), the patent owner sought discretionary denial based on

§325(d) (Appx148-153). That provision addresses denial of institution based on "prior art or arguments previously . . . presented to the Office." §325(d). The patent owner invoked §325(d) in light of the prior EPR on the same patent. Because the USPTO never mentioned §325(d), any post-hoc attempt to justify its decision using §325(d) would fail. *See SEC v. Chenery Corp.*, 318 U.S. 80, 95 (1943). But focusing on §325(d) underscores that the USPTO abandoned its own precedent without explanation.

The USPTO has precedent governing when prior art or arguments previously presented to the Office justify denying institution. *See Ecto World, LLC v. RAI Strategic Holdings, Inc.*, No. IPR2024-01280, 2025 WL 1528304, at *2-4 (PTAB May 19, 2025) (precedential); *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, 2020 WL 740292, at *3-4 (PTAB Feb. 13, 2020) (precedential). The parties litigated under that precedent, and the USPTO *agreed with Petitioners* that the precedential conditions for denying institution were *not* met (because "the patent examiner did not consider [the prior art] during the reexamination proceeding," and that prior art "is material to the patentability of the challenged claim," Appx2; *see Ecto World*, 2025 WL 1528304, at *2-4). Yet the USPTO denied institution without mentioning its precedent, let alone justifying the departure.

An agency's unexplained departure from precedent violates the Fifth Amendment's Due Process Clause and its equal-protection component. *Teamsters Loc. Union No. 455 v. NLRB*, 765 F.3d 1198, 1204 (10th Cir. 2014) (Gorsuch, J.) (For "an administrative agency" to "depart from a prior policy *sub silentio*" violates "the most basic of law's guarantees, due process and equal treatment."); *see also, e.g.*, *Billeke-Tolosa v. Ashcroft*, 385 F.3d 708, 711-12 (6th Cir. 2004) (an agency has "no discretion to ignore its own precedent," which would deny "fair notice" and thus impair the "'constitutional right to due process'" (quoting *Wilson v. Comm'r of Soc. Sec.*, 378 F.3d 541, 545 (6th Cir. 2004)); *Sameena, Inc. v. U.S. Air Force*, 147 F.3d 1148, 1153 (9th Cir. 1998). This is so even as to discretionary matters—if an agency sets out precedent guiding its discretion, it must follow it. *NLRB v. Welcome-Am. Fertilizer Co.*, 443 F.2d 19, 20 (9th Cir. 1971) (even where agency guidelines govern a matter "within the [agency's] sound discretion" and generally "not a question subject to [judicial] review," "[f]ailure to follow such guidelines tends to cause unjust discrimination and deny adequate notice contrary to fundamental concepts of fair play and due process"); *see also Service v. Dulles*, 354 U.S. 363, 388 (1957); *Vitarelli v. Seaton*, 359 U.S. 535, 540 (1959); *Ballard v. Comm'r*, 544 U.S. 40, 59 (2005) ("all" "decisionmaking tribunals" are "obliged to follow [their] own Rules").

Equally, unexplained departure from precedent violates the APA. *Schucker v. FDIC*, 401 F.3d 1347, 1354-55 (Fed. Cir. 2005) ("An agency is obligated to follow precedent, and if it chooses to change, it must explain why." (citation omitted)); *ABM Onsite Servs.-W., Inc. v. NLRB*, 849 F.3d 1137, 1146 (D.C. Cir. 2017) (calling this rule "well-settled").

Here, the USPTO had precedent governing "whether" denial of institution "is warranted" based on prior art or arguments previously presented to the USPTO. *Ecto World*, 2025 WL 1528304, at *2-4; *see Advanced Bionics*, 2020 WL 740292, at *3-4. This precedent applies a "two-part framework": (1) whether the same or substantially similar prior art or argument was previously presented, and (2) whether the Office materially erred. *Advanced Bionics*, 2020 WL 740292, at *3. The petitioner bears a "burden" to show material error at the second step, allowing the petitioner "to demonstrate that discretionary denial is inappropriate." *Ecto World*, 2025 WL 1528304, at *3-4 & n.2.

The parties' dispute here centered on this precedent. USTA, in requesting discretionary denial based on the prior EPR, specifically invoked *Advanced Bionics* as the governing standard. Appx148-153. Petitioners responded by showing that, at *Advanced Bionics*' second step, the Office had erred: although a prior art reference (Walton) had been presented to the Office in the EPR, the examiner failed to

consider it. Appx163-173.[3] Petitioners further argued that the error was material: Walton was material to patentability (because it teaches the very claim limitation the USPTO had previously found absent in other prior art). Appx167-171.

The then-Acting Director agreed with Petitioners—which, under agency precedent, should have resolved the matter. The then-Acting Director sided with Petitioners on each disputed point, finding evidence that "the patent examiner did not consider Walton during the reexamination proceeding," and "Walton is material to the patentability of the challenged claim." Appx2. Petitioners thus carried their "burden" and satisfied the criteria the agency had established for "demonstrat[ing] that discretionary denial is inappropriate" based on prior art presented in another USPTO proceeding. *Ecto World*, 2025 WL 1528304, at *4, *6. Discretionary denial on that basis was, according to agency precedent, unwarranted. *Id.*

Yet the then-Acting Director abandoned that precedent and denied institution anyway. Appx2. She did not mention the *Ecto World* and *Advanced Bionics* line of precedent—nor attempt to justify departing from it. Appx2.

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[3] The examiner expressly indicated that he did *not* consider Walton by drawing a line through that reference. Appx165-167; Appx211. In fact, the patent owner (not the patent challenger) was at fault: the patent owner presented Walton in the EPR in a procedurally defective manner. Appx172-173.

That violates basic rule-of-law principles. Agencies must give fair notice, act consistently, and justify their conduct. Petitioners chose to expend significant resources on an IPR petition on the understanding that—under agency precedent—Walton would not be a basis for denying IPR institution (if the Office had not considered Walton and Walton was material to patentability). Petitioners made that showing, as the agency found. Yet without explanation, the agency denied institution anyway. That violates the agency's constitutional and APA obligations.

II. The remaining mandamus criteria are satisfied.

A. The USPTO's errors are reviewable in mandamus.

There is a "'strong presumption'" that agencies cannot escape judicial review. *Guerrero-Lasprilla v. Barr*, 589 U.S. 221, 229 (2020). When the USPTO exceeds legal constraints in denying institution, this Court applies mandamus review. *Mylan*, 989 F.3d at 1380. "In fact, when the Board denies institution, our mandamus jurisdiction is especially important." *Id.* Although "the appeal bar in §314(d) prevents any direct appeal," it does not "divest[] [this Court] of mandamus jurisdiction." *Id.* Section 314(d) therefore does not bar mandamus review of Petitioners' claims.

To begin, the USPTO's violations of constitutional constraints (the Fifth Amendment and separation of powers) are reviewable in mandamus. *Mylan*, 989 F.3d at 1382-83.

In addition, "§314(d) does not 'enable the agency to act outside its statutory limits,'" and such "shenanigans" are reviewable notwithstanding §314(d). *SAS Inst., Inc. v. Iancu*, 584 U.S. 357, 371 (2018) (quoting *Cuozzo*, 579 U.S. at 275); *see* 5 U.S.C. §706(2). This reflects a deeply rooted principle: "courts have recognized that an implicit and narrow exception to [a] bar on judicial review exists for claims that the agency exceeded the scope of its delegated authority or violated a clear statutory mandate." *Hanauer v. Reich*, 82 F.3d 1304, 1307 (4th Cir. 1996); *see Leedom v. Kyne*, 358 U.S. 184 (1958).

Thus, as this Court recently confirmed, mandamus review exists for certain "challenges to the applicable factors" that the USPTO considers in denying institution, even if "non-constitutional." *Motorola*, 2025 WL 3096514, at *5. §314(d) bars review of "'an ordinary dispute about the application of' an institution-related statute." *Thryv, Inc. v. Click-to-Call Techs., LP*, 590 U.S. 45, 54 (2020). But the Supreme Court and this Court have preserved review for statutory challenges "depend[ing] on other less closely related statutes," or that present questions of broader "scope and impact." *Cuozzo*, 579 U.S. at 275; *Apple Inc. v. Vidal*, 63 F.4th 1, 12 n.5 (Fed. Cir. 2023).

The claims here fall within that preservation of judicial review. They go well beyond case-specific interpretation or application of institution criteria and concern

questions of fundamental scope and impact regarding the agency's authority to create institution standards in the first place. The then-Acting Director's rejection of the IPR scheme, and her creation of new, extra-statutory criteria, are " violations of" "legal constraints" that activate judicial review. *See IGT v. Zynga Inc.*, 144 F.4th 1357, 1367 (Fed. Cir. 2025).

So too, despite §314(d), "judicial review remains available consistent with the [APA], which directs courts to set aside agency action 'not in accordance with law' or 'in excess of statutory jurisdiction, authority, or limitations.'" *SAS*, 584 U.S. at 371 (quoting 5 U.S.C. §706(2)(A), (C)). The APA's prohibitions on arbitrary agency action and departure from agency precedent are fundamental, universal administrative-law limits with broad "scope and impact" and not "closely related" to IPR institution. *Cuozzo*, 579 U.S. at 275.

The questions here are more fundamental and far-reaching, *see id.*, than those this Court has previously declined to resolve in institution-related challenges. This Court has rejected challenges to the USPTO's weighing of parallel litigation in institution decisions—claims that merely contested "the weighing of the relevant factors." *Motorola*, 2025 WL 3096514, at *5; *see Mylan*, 989 F.3d at 1382-83; *Apple*, 63 F.4th at 11-14. Here, however, the claims concern the more fundamental question of what factors the USPTO can permissibly consider at all. *See Motorola*, 2025 WL

3096514, at *5 (preserving mandamus review of some "non-constitutional challenges to the applicable factors"). Similarly, while prior decisions have assumed that the USPTO has broad discretion over institution criteria, this Court has yet to confront the arguments here addressing the extent of that discretion. *See, e.g.*, *Mylan*, 989 F.3d at 1382; *Apple*, 63 F.4th at 7; *see also Taylor Energy Co. v. Dep't of the Interior*, 990 F.3d 1303, 1310 n.1 (Fed. Cir. 2021) ("[W]hen an issue is not argued or is ignored in a decision, such decision is not precedent to be followed in a subsequent case in which the issue arises." (citation omitted)).

B. Petitioners have no other adequate means of relief.

Mandamus is the proper mechanism for "judicial review" of "decisions denying institution," "[g]iven that there is no adequate remedy by way of direct appeal," which this Court holds is barred by §314(d). *In re Palo Alto Networks, Inc.*, 44 F.4th 1369, 1374 (Fed. Cir. 2022) (citation omitted). The relief Petitioners seek—for the USPTO to comply with its obligations in deciding their IPR petition, and to correct the abuse of their filing fees—cannot be sought elsewhere.

C. Mandamus is appropriate under the circumstances.

Mandamus is a critical check on unlawful agency action. It is appropriate "to decide 'basic' and 'undecided' questions" and "to further supervisory or instructional goals where issues are unsettled and important." *In re BigCommerce, Inc.*, 890 F.3d 978, 981 (Fed. Cir. 2018). Mandamus is also warranted when

"important to 'proper judicial administration.'" *In re Cray Inc.*, 871 F.3d 1355, 1358-59 (Fed. Cir. 2017).

This Court's mandamus review is needed here, where the petition raises questions regarding the USPTO's authority to create institution criteria and to exceed limits that agencies must obey. *See BigCommerce*, 890 F.3d at 981. This Court should clarify the limits on the USPTO's authority now to ensure the agency's future decisions adhere to constitutional and statutory obligations.

CONCLUSION

The Court should grant the petition and vacate the non-institution decision. The Court should direct the USPTO to reconsider institution solely under the statutory criteria, not the agency's extra-statutory framework. At a minimum, the Court should direct the USPTO to reconsider institution without the USPTO's new divert-to-EPR rationale.

Dated: November 21, 2025

Respectfully Submitted,

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/s/ Debra J. McComas
Debra J. McComas

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I certify that on November 21, 2025, I caused a paper copy of this document (and the attached appendix, entry of appearance, certificate of interest, and notice of related cases) to be sent by express carrier to lead counsel for respondent USTA Technology, LLC at the following address:

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/s/ Debra J. McComas
Debra J. McComas