No. 2026-117

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

IN RE: TESSELL, INC.
Petitioner.

On Petition for Writ of Mandamus
from the United States Patent and Trademark Office,
Patent Trial and Appeal Board in Nos. IPR2025-00298,
IPR2025-00322, IPR2025-00732, and IPR2025-00733

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.*, 159 F.4th 30 (Fed. Cir. 2025) (precedential) (cleaned up); *see also In re Cambridge Indus. USA Inc.*, No. 2026-101, 2025 WL 3526129, at *2 (Fed. Cir. Dec. 9, 2025); *In re HighLevel, Inc.*, No. 2025-148, 2025 WL 3527144, at *1 (Fed. Cir. Dec. 9, 2025), *In re Sandisk Techs., Inc.*, No. 2025-152, 2025 WL 3526507, at *1 (Fed. Cir. Dec. 9, 2025) (relying on *Cambridge*), *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*, *Cambridge*, *HighLevel*, *Sandisk*, *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 her discretion to deny institution of its IPR petitions.[1] Petitioner contends that Acting Director Stewart's exercise of her discretion violates the America Invents Act (AIA), the Administrative Procedure Act (APA), and the Constitution. This Court has already denied very similar legal arguments in *Motorola*, *Google*, *SAP*, *Cambridge*, *HighLevel*, and

[1] Deputy Director Coke Morgan Stewart was the Acting Director at the time of the challenged agency actions. Exs. A-C. 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, Jan. 12, 2026). This brief refers to Acting Director Stewart when describing her actions taken at the time she was Acting Director.

Sandisk and should do the same here, 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*, 159 F.4th at 38.

Petitioner argues that the Acting Director's decision is reviewable under *Arista Networks, Inc. v. Cisco Sys. Inc.*, 908 F.3d 792 (Fed. Cir. 2018), because she improperly applies assignor estoppel to decline to institute IPR proceedings. *Arista* does not support Petitioner's jurisdictional argument. *Arista* relied on *Wi-Fi One, LLC v. Broadcom Corp.*, 878 F.3d 1364 (Fed. Cir. 2018) (en banc), to avoid § 314(d)'s bar on reviewability (*see* 908 F.3d at 800-801), but the Supreme Court later

abrogated *Wi-Fi One* in *Thryv, Inc. v. Click-to-Call Technologies, LP*, 590 U.S. 45 (2020). Thus, the jurisdictional holding from *Arista* is no longer good law. *Arista* is also not a mandamus case from a denial of institution and, therefore, cannot undercut this Court's subsequent clear holding from *Mylan* that it will only hear colorable constitutional claims on mandamus. *Arista* is also inapplicable because here the Acting Director is exercising her discretion to decline to institute an IPR under § 314(a)—which she could do for any constitutionally permissible reason—rather than applying assignor estoppel or interpreting § 311(a).

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 infers limits on the Director's ability to decline to institute an IPR from the language of § 311(a)—language that the Acting Director made clear she did not rely upon. Both this Court and the Supreme Court have declined to limit the Director's discretion on whether to institute IPR proceedings and have repeatedly

found that IPR institution is entirely discretionary. And as explained above, the Acting Director stated that she was not relying on assignor estoppel or § 311(a) to deny institution, but on her discretion under § 314(a). Petitioner points to nothing in § 311(a) that limits the Acting Director's § 314(a) discretion.

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 or statutory 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 constitutionally protected property interest. And even assuming 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.

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 their preferred forum. Petitioner has "alternative avenues of relief" through which they may seek invalidation of the challenged patent claims, as Petitioner remains free to avail itself of another forum (e.g., 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. Acting Director Stewart executed that responsibility based upon the conditions existing when she rendered these institution decisions in June and August 2025. 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); *Apple Inc. v. Fintiv, Inc.*, No. IPR2020-00019, 2020 WL 2126495 (P.T.A.B. Mar. 20, 2020) (precedential) (discussing a non-exhaustive list of factors to address concerns about redundancy or wastefulness based upon parallel district court litigation).

3. On March 26, 2025, Acting Director Stewart issued a memorandum entitled "Interim Processes for PTAB Workload Management" (Workload Memo), 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." Ex. E at 1. The memo provided that "the Director, in consultation with at least three PTAB judges, will determine whether discretionary denial of

institution is appropriate." *Id.* The memo outlined a new briefing schedule that bifurcated briefing between (1) discretionary considerations and (2) merits and other non-discretionary statutory considerations. *Id.* The briefing on discretionary considerations would "address all relevant considerations" and "considerations bearing on the Director's discretion" such that the briefing "processes aim to improve PTAB efficiency." *Id.* at 2-3. 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." *Id.* at 3.[2]

4. This mandamus petition concerns discretionary denials in four IPR petitions filed by Petitioner Tessell, Inc. against patents owned by Nutanix, Inc. in the following cases:

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[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 Jan. 12, 2026). 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. Ex. F.

- IPR2025-00298 (the "-298 IPR");
- IPR2025-00322 (the "-322 IPR);
- IPR2025-00732 (the "-732 IPR"); and
- IPR2025-00733 (the "-733 IPR").

Institution proceedings in the -298 IPR began before the March 2025 Workload Memo. In the -298 IPR, Nutanix argued in its preliminary response that the Board should deny institution because of the inventors' unfair dealings. Ex. G at 17-19. According to Nutanix, the patent inventors profited by assigning their rights to Nutanix while employed there and then founded or joined Tessell to profit a second time from their invention by competing with Nutanix. *Id.* at 18. Nutanix argued that the inventors, i.e., Tessell, should not be permitted to challenge the patent's validity based on these unfair dealings. *Id.* at 19. Nutanix stated that its argument was based on the Board's discretion to deny institution under § 314(a) and it was not arguing for the Board to apply assignor estoppel under § 311(a), which this Court precluded in *Arista*, 908 F.3d 792. Ex. G at 17 n.2. Tessell did not respond to this argument. Petitioner's Authorized Reply to Patent

Owner's Preliminary Response, *Tessell, Inc. v. Nutanix, Inc.*, No. IPR2025-00298 (P.T.A.B. Apr. 11, 2025) (Paper 9).

The Board granted institution in the -298 IPR and rejected Nutanix's argument, viewing it as no different from an attempt to apply assignor estoppel in IPRs under § 311(a) as prohibited by *Arista*. Ex. D at 21-23. Nutanix sought Director Review and reiterated its argument that the Director should deny institution in view of Tessell's unfair dealings under § 314(a) and that *Arista* does not apply. Ex. H at 2-5. Tessell responded, denying that there were unfair dealings. Authorized Response to Director Review Request at 4, *Tessell, Inc. v. Nutanix, Inc.*, No. IPR2025-00298 (P.T.A.B. Jun. 24, 2025) (Paper 14). The Acting Director granted review and denied institution finding that although "[a]ssignor estoppel does not apply in [IPRs] under 35 U.S.C. § 311(a)" the Director can still deny institution under the broad discretion granted by 35 U.S.C. § 314(a). Ex. A at 2. The Acting Director determined that "[i]t is not an efficient use of Office resources to institute an IPR on a patent where the inventors of that patent now advocate for its unpatentability." *Id.* at 3. Petitioner sought rehearing,

arguing that "[t]he Director does not have discretion to effectively apply assignor estoppel to deny institution." Ex. L at 3. The Director denied rehearing. Ex. P.

In the -322 IPR, Nutanix sought discretionary denial with the Acting Director for the same reasons as in the -298 IPR, i.e., the inventors' unfair dealings. Ex. I at 2-4. Tessell responded, arguing that § 311(a) precluded the Director from denying institution based on unfair dealings and that, regardless, Tessell did not engage in unfair dealings. Petitioner's Response to Patent Owner's Request for Discretionary Denial of Institution at 5-9, *Tessell, Inc. v. Nutanix, Inc.*, No. IPR2025-00322 (P.T.A.B. May 27, 2025) (Paper 13). The Acting Director sided with Nutanix and denied institution, finding that "the Office may consider unfair dealings as a factor when determining whether to exercise discretion to deny institution under 35 U.S.C. § 314(a)." Ex. B at 2. Tessell reiterated its arguments and sought Director Review (Ex. M), which the Acting Director denied (Ex. Q).

The -732 IPR and the -733 IPR unfolded similarly, with Nutanix asking the Acting Director to deny institution based on unfair dealings,

Tessell contesting the arguments, the Acting Director denying institution, and the Director denying review. Exs. C, J, K, N, O, R; Petitioner's Opposition to Patent Owner's Request for Discretionary Denial of Institution at 7-11, *Tessell, Inc. v. Nutanix, Inc.*, No. IPR2025-00732 (P.T.A.B. Jul. 17, 2025) (Paper 8); Petitioner's Opposition to Patent Owner's Request for Discretionary Denial of Institution at 6-10, *Tessell, Inc. v. Nutanix, Inc.*, No. IPR2025-00733 (P.T.A.B. Jul. 17, 2025) (Paper 8).

Tessell now petitions for a writ of mandamus to overturn Acting Director Stewart's discretionary decision declining to institute IPRs.

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* 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." 590 U.S. 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*, *SAP, Cambridge, HighLevel, and Sandisk,* stating that "mandamus is ordinarily unavailable for review of institution decisions," including the type of purported constitutional claim and statutory challenges lodged here. *Motorola*, 159 F.4th at 36; *Google*, 2025 WL 3096849, at *1-2; *SAP*, 2025 WL 3096788, at *2; *Cambridge*, 2025 WL 3526129, at *2; *HighLevel*, 2025 WL 3527144, at *1; *Sandisk*, 2025 WL 3526507, at *1 (applying *Cambridge*).

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* and *Cambridge*, the Court reiterated *Mylan*'s holding that statutory arguments are not available for mandamus relief. *Motorola*, 159 F.4th at 38; *Cambridge*, 2025 WL 3526129, at *2-3. Thus, Petitioner's claims that the USPTO exceeded its statutory authority under the AIA (Pet. 10-17) and violated the APA (Pet. 17-25) necessarily fail.

Petitioner relies on *Arista's* holding that this Court may review the Board's interpretation of § 311(a) in an institution decision as part of this Court's review of a final written decision issued under § 318(a). Pet. 13; *Arista*, 908 F.2d at 800-801. *Arista* does not help Petitioner for several reasons. First, *Arista's* determination that § 314(d) did not bar this Court's review of an institution decision interpreting § 311(a) is no longer good law. In *Arista*, the Court premised its § 314(d) conclusion on *Wi-Fi One, LLC v. Broadcom Corp.*, 878 F.3d 1364, 1373 (Fed. Cir. 2018) (en banc), in which the Court held that the Board's time-bar determination under § 315(b) was reviewable because § 315(b) is not "closely related" to a decision to institute review. *Arista*, 908 F.2d at

799-801. Relying directly on *Wi-Fi One*, *Arista* concluded that § 311(a), like § 315(b), is also not "closely related" to institution, and a decision to institute under § 311(a) is reviewable. *Id.* at 800-801. But the Supreme Court abrogated *Wi-Fi One* in *Thryv*, explaining that an institution decision involving the § 315(b) time bar *is* closely related to institution and *is not* reviewable. *Thryv*, 590 U.S. 45 at 53-56; *see also id.* at 57 (explaining that the "No Appeal" provision under § 314(d) "*encompasses the entire determination* whether to institute an inter partes review.") (emphasis added); *see also Husky Injection Molding Syst. Ltd. v. Athena Automation, Ltd.*, 838 F.3d 1236, 1245-46 (Fed. Cir. 2016) ("[W]e conclude that the question whether assignor estoppel [under § 311(a)] applies in full force at the [USPTO]" is not reviewable.)[3]

Even if *Arista*'s jurisdictional holding was still good law, it would not apply. Petitioner here challenges the Acting Director's *denial* of institution, not, as in *Arista*, a decision to institute resulting in a final

[3] *Arista* rejected *Husky*'s application of *Cuozzo* to apply § 314(d) in favor of the now-abrogated holding in *Wi-Fi One*. 908 F.3d at 800.

written decision. *Arista*, 908 F.2d at 795. Nor did the Acting Director rely on or interpret § 311(a) in exercising her discretion. Exs. A-C.

Petitioner relies on *Cuozzo, SAS Institute, Inc. v. Iancu*, 584 U.S. 357, 371 (2018), and *In re Power Integrations*, 899 F.3d 1316, 1321 (Fed. Cir. 2018) to argue that it may invoke statutory arguments on mandamus. Pet. 13-15. But neither *Cuozzo* nor *SAS* involved mandamus jurisdiction or sought review of a decision to *deny* institution. *Cuozzo*, 579 U.S. at 275-76; *SAS*, 584 U.S. at 371. And *Power Integrations* goes the other way, denying mandamus review of a denial of institution without definitively answering the question of what is reviewable on mandamus. 899 F.3d at 1320-1321. Under this Court's holding in *Mylan*—issued against the backdrop of the Supreme Court's decisions *Cuozzo* and *SAS*, and after *Power Integrations*—Petitioner cannot use mandamus to bring statutory challenges to the Director's denial of IPR 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"); *see also Motorola*, 159 F.4th at 38 (explaining that a petitioner's "request is nothing but an attempted end run around § 314(d)'s bar on review").[4]

Contrary to Petitioner's attempt to expand mandamus to cover statutory claims, this Court has held that a party may raise certain

[4] This Court in *Motorola* referenced a possible exception for "certain statutory challenges," 159 F.4th at 36 (citing *Apple v. Vidal*, 63 F.4th 1, 12 n.5 (Fed. Cir. 2023), and similarly referenced a "limited category of non-constitutional challenges," *id.* at 38. *See also Cambridge*, 2025 WL 3526129, at *2 & 3. No such possible exceptions exist here. *Motorola* explicitly rejected statutory challenges, like the ones here, that "challenge the Director's exercise of discretion to deny institution." 159 F.4th at 38 (quoting *Mylan*, 989 F.3d at 1382 (cleaned up)). And *Cambridge* makes clear that challenges to the particular factors considered when rendering institution decisions are not subject to mandamus jurisdiction. 2025 WL 3526129, at *3. Furthermore, the *Apple* footnote cited in *Motorola* and *Cambridge* simply recognized that *Cuozzo* left open the possibility that § 314(d) may not bar review of statutes "less closely related" to institution "or that present other questions of interpretation that reach, in terms of scope and impact, well beyond" § 314(d). *Apple*, 63 F.4th at 12 n.5 (quoting *Cuozzo*, 579 U.S. at 275); *see also Cambridge*, 2025 WL 3526129, at *2 (same). *Apple* and *Cuozzo* did not involve questions of mandamus jurisdiction, and *Cuozzo* did not involve a denial of institution. Neither the Supreme Court nor this Court has identified an example of a statutory interpretation question in the *non-institution* context that could be subject to mandamus review. In contrast, this Court stated in *Mylan*, without further exception, that "there is no [mandamus] reviewability of the Director's exercise of his discretion to *deny* institution except for colorable constitutional claims." 989 F.3d at 1382 (emphasis added).

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. *Motorola*, 159 F.4th at 38 (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, they raise their arguments in the wrong court, through the wrong type of action, seeking the wrong sort of relief.

II. Petitioner Establishes No Colorable Constitutional 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. There can be no review of the USPTO Director's exercise of discretion to deny institution "except for colorable constitutional claims." *Mylan*, 989 F.3d at 1382. Here, Petitioner fails to establish a "clear and indisputable" constitutional violation warranting a writ of mandamus.

A. Petitioner's Separation-Of-Powers Claims Are Meritless Statutory Claims.

A. Petitioner's contention that the USPTO violated separation-of-powers principles by exceeding the authority granted by Congress (Pet. 11-12) lacks merit and has already been rejected by this Court. The Director's exercise of discretion based on the specific facts of a case "does not raise any colorable constitutional challenge and is otherwise unreviewable." *Google*, 2025 WL 3096849, at *2; *Cambridge*, 2025 WL 3526129, at *2 n.1 (determining that an allegation of the executive exceeding statutory authority "presents no colorable constitutional claim."). Similarly, arguments about "what factors the Director may consider when deciding whether to institute an IPR" are statutory challenges unreviewable on mandamus. *Cambridge*, 2025 WL 3526129, at *3.

B. Petitioner's argument puts a constitutional label on arguments that are based solely on Petitioner's view of the AIA. *See* Pet. 10-17. 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; *see also*, *Cambridge*, 2025 WL 3526129, at *2 n.1 (quoting same). 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. 13-21.

C. Even if properly brought as a constitutional claim, Petitioner's argument lacks merit. Petitioner's contention that Congress limited the Director's discretion to deny institution contradicts 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). It is unsurprising that the Supreme Court and this Court have repeatedly examined the AIA and failed to find extratextual strictures on the Director's ability to decline to initiate an administrative proceeding. *See Cuozzo*, 579 U.S. at 273; *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*, 159 F.4th at 37; *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)").

Petitioner argues that "Section 311(a) unambiguously leaves no room for assignor estoppel in the IPR context." Pet. 11, quoting *Arista*, 908 F.3d at 803. But the Acting Director did not apply assignor estoppel, and acknowledged that this common-law doctrine does not apply to IPR proceedings under § 311(a) and *Arista*. Exs. A-C. Rather, the Acting Director exercised her discretion to deny institution under § 314(a)'s discretionary authority to deny institution. *See, e.g.,* Ex. A at 3 ("It is not an efficient use of Office resources to institute an IPR on

a patent where the inventors of that patent now advocate for its unpatentability.") Nothing in the language of § 311(a) limits the Director's discretion to deny institution under § 314(a). *Cuozzo*, 579 U.S. at 273 (the "decision to deny a petition [for IPR] is a matter committed to the Patent Office's discretion.") (cleaned up). And even if the Acting Director had looked to the assignor-estoppel doctrine to deny institution, Petitioner's argument would still miss the mark; the fact that it is statutorily *permissible* for the Director to institute an IPR despite assignor estoppel does not mean the Director would be barred from considering assignor estoppel in the exercise of his discretion to decline to institute an IPR, which the statute permits him to do for any constitutionally permissible reason.

B. Petitioner's Due-Process Claims Are Meritless Statutory Claims.

Petitioner's contention that the USPTO violated due-process principles in exercising its discretion to deny the relevant IPR petition (Pet. 23-25) is entirely without merit.

A. To begin with, it is far from clear that Petitioner has 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).

This Court's decisions in *Motorola* and *Cambridge* highlight that Petitioner has not identified a constitutionally protected interest in having the Director apply particular discretionary criteria when determining whether to grant IPR institution. *See Motorola*, 159 F.4th at 37-38; *Cambridge* 2025 WL 3526129, at *2. In *Motorola*, the Court 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. 159 F.4th at 37-38. In *Cambridge*, this Court echoed both holdings from *Motorola*, further explaining that "like Motorola, Cambridge identifies no constitutionally protected right for its petition to be considered based on

certain criteria and certainly no constitutional right to an IPR." *Cambridge* 2025 WL 3526129, at *2 (cleaned up.) Thus, Petitioner here has not established any constitutionally protected interest that could be the basis for a due-process claim.

Petitioner claims that the Board's decision in *Athena Automation Ltd. V. Husky Injection Molding Sys. Ltd.*, No. IPR2013-00290, 2013 WL 8595976 (P.T.A.B. Oct. 25, 2013) (precedential) provides it a constitutionally protected interest because the decision limited the Director's discretion to apply assignor estoppel to IPR proceedings. Pet. 24; *see also id.* at 12-13. This is incorrect for two reasons. First, a precedential Board decision represents the Director's instructions to the Board about how to exercise his delegated discretion; such precedential decisions bind the Board, not the Director, who remains free to change how he will exercise his discretion. *Athena*'s decision to "decline to deny this Petition based on the doctrine of assignor estoppel," 2013 WL 8595976, at *7, does not commit the Director to the same discretionary choice. Both granting IPRs and addressing institution criteria are wholly discretionary matters, and Petitioner does not have a

due-process protected right to a particular set of criteria. *See Motorola*, 159 F.4th at 36-37; *Mylan*, 989 F.3d at 1382 ("The Director is permitted, but never compelled, to institute an IPR. And no petitioner has a right to such institution.").

Next, as with this Court's *Arista* decision, the Board's decision in *Athena* is inapplicable here. *Athena* interprets § 311(a) and does not speak to discretionary institution under § 314(a). The Acting Director did not deny institution here based upon § 311(a) or apply the common-law doctrine of assignor estoppel, but rather exercised her § 314(a) institution discretion based on her determination that institution under the circumstances would be inefficient. *See* Ex. A at 3. Because *Athena* does not address § 314(a) institution discretion, even if it bound the Director in some way, it could not bind his institution discretion or otherwise create a protectible property right regarding discretionary action.

B. 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, Patent Owner made its arguments clear from the outset of all four proceedings. Exs. G-K. Petitioner had multiple opportunities to respond to Patent Owner's arguments. Petitioner's Authorized Reply to Patent Owner's Preliminary Response, *Tessell, Inc. v. Nutanix, Inc.*, No. IPR2025-00298 (P.T.A.B. Apr. 11, 2025) (Paper 9); Authorized Response to Director Review Request at 4, *Tessell, Inc. v. Nutanix, Inc.*, No. IPR2025-00298 (P.T.A.B. Jun. 24, 2025) (Paper 14); Petitioner's Response to Patent Owner's Request for Discretionary Denial of Institution at 5-9, *Tessell, Inc. v. Nutanix, Inc.*, No. IPR2025-00322 (P.T.A.B. May 27, 2025) (Paper 13); Petitioner's Opposition to Patent Owner's Request for Discretionary Denial of Institution at 7-11, *Tessell, Inc. v. Nutanix, Inc.*, No. IPR2025-00732 (P.T.A.B. Jul. 17, 2025) (Paper 8); Petitioner's Opposition to Patent Owner's Request for Discretionary Denial of Institution at 6-10, *Tessell, Inc. v. Nutanix, Inc.*, No. IPR2025-00733

(P.T.A.B. Jul. 17, 2025) (Paper 8). Petitioner also took advantage of opportunities to challenge the Acting Director's decisions. Exs. L-O.

Accordingly, the USPTO satisfied any due-process rights Petitioner had in the IPR institution process. *See Motorola*, 159 F.4th at 37 (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—because it was heard—but for the Acting Director Stewart to apply different discretionary criteria and reach a different outcome. The Due Process Clause requires no such remedy and certainly does not guarantee Petitioner a specific outcome once heard. *Motorola*, 159 F.4th at 37.

III. Petitioner Cannot Satisfy The Other Mandamus Factors.

Even if they 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.

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. 25 (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 Petitioner may pursue validity challenges in another forum like ex parte reexamination. *Cf. Motorola*, 159 F.4th at 37 (recognizing that IPR institution denial does not affect petitioner's ability to raise patentability issues elsewhere). Petitioner's abbreviated discussion does not address this 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

[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 denying a petition for reasons triggering heightened scrutiny. But here, Petitioner asserts no such harm.

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. 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's constitutional claims are repackaged unreviewable APA claims without merit; and (3) Petitioner may still pursue its invalidity defenses by filing ex parte reexamination requests.

But even beyond Petitioner's inadequate legal showing and another route 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 how

it exercises the broad discretion Congress entrusted to the USPTO Director. Petitioner casts this Director's exercise of discretionary criteria as infringing upon "Congress's power to legislate" (Pet. 26) and seeks to reverse policy determinations reflected by the Acting Director's denial of institution. 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.

/s/ Fahd H. Patel

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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 6,100 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: January 13, 2026

/s/ Fahd H. Patel
Fahd H. Patel