

No. 26-1519, -1520

United States Court of Appeals
for the Federal Circuit

GOOGLE LLC,
Appellant
v.

CELLULAR SOUTH, INC.
Appellee

JOHN A. SQUIRES, Under Secretary of Commerce for Intellectual
Property and Director of the United States Patent and Trademark
Office,
Intervenor

On Appeal from the U.S. Patent and Trademark Office Patent Trial
and Appeal Board in IPR2025-00875, -00976

**CORRECTED BRIEF OF US*MADE, NATIONAL RETAIL
FEDERATION, THE HIGH TECH INVENTORS ALLIANCE, THE
ALLIANCE FOR AUTOMOTIVE INNOVATION, THE COMPUTER
& COMMUNICATIONS INDUSTRY ASSOCIATION,
ASSOCIATION FOR COMPETITIVE TECHNOLOGY (ACT), THE
SOFTWARE & INFORMATION INDUSTRY ASSOCIATION, AND
UNIFIED PATENTS, LLC, IN SUPPORT OF GOOGLE AND
REVERSAL**

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August 5, 2026

CERTIFICATE OF INTEREST

Pursuant to Federal Circuit Rules 29(a) and 47.4, counsel for amici certifies that:

1. The full names of the parties that I represent are the US Manufacturers Association for Development and Enterprise, National Retail Federation, the High Tech Inventors Alliance, the Alliance for Automotive Innovation, the Computer & Communications Industry Association, Association for Competitive Technology (ACT), the Software & Information Industry Association, and Unified Patents, LLC
2. There are no real parties in interest of parties that I represent
3. There are no parent corporations or publicly held companies that own ten percent or more of the stock of the parties that I represent
4. No other law firms, partners, or associates who have not entered an appearance in this appeal either appeared for the parties that I represent in the originating court or are expected to so appear in this Court
5. I do not know of any case in this or any other court or agency that will directly affect or be directly affected by this Court's decision in this case

6. No disclosure regarding organizational victims in criminal cases or debtors or trustees in bankruptcy cases is required under Fed. R. App. P. 26.1(b) or (c).

August 5, 2026

/s/ Joseph Matal

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INTEREST OF AMICI CURIAE

The U.S. Manufacturers Association for Development and Enterprise is a nonprofit association representing companies manufacturing diverse goods in the United States.

National Retail Federation is the world's largest retail trade association.

The Alliance for Automotive Innovation represents the full automotive industry, including the manufacturers producing most vehicles sold in the U.S. and equipment suppliers.

The High Tech Inventors Alliance represents leading technology providers and includes some of the most innovative companies in the world.

The Computer & Communications Industry Association is an international, not-for-profit trade association representing a broad cross section of communications and technology firms.

Association for Competitive Technology (ACT) is a global policy trade association that represents entrepreneurs, innovators, and independent developers within the app ecosystem that engages with verticals across every industry.

The Software & Information Industry Association is the principal trade association for the software and digital information industries.

Unified Patents, LLC is a membership organization dedicated to deterring non-practicing entities, particularly patent assertion entities, from extracting nuisance settlements from operating companies based on likely-invalid patents.¹

¹ No counsel for any party wrote any part of this brief. No party other than amici curiae's members contributed money that was intended to fund the preparation or submission of this brief. Although Google is a member of HTIA and CCIA, it did not participate in the decision to file this brief. Google has consented to the filing of this brief; the USPTO does not object; Cellular South has not indicated whether it will object or consent. This brief is accompanied by a motion seeking leave to file.

ARGUMENT

I. Introduction

In June 2025, the USPTO announced a new rule that six years after the grant of a patent, the patent owner acquires “settled expectations” that prevent anyone from challenging the patent in an *inter partes* review. In the ensuing months, the agency applied this rule retroactively to reject virtually every single petition before it that sought to challenge a patent that was more than five years old. An appendix linked to this brief lists the 201 *inter partes* review petitions that the USPTO expressly denied on “settled expectations” grounds without considering the merits.² Amici are aware of only a handful of cases in which a petition challenging a patent that was more than five years old was able to overcome this new bar.³

In *Intel Corp. v. Proxense LLC*,⁴ the USPTO provided “guidance” that older patents can be reviewed despite “settled expectations” if the petitioner either identifies “a significant change in the law” or

² Available at <https://perma.cc/87GY-NLXK>.

³ See Jones, F., Unpacking the PTAB’s Patent Age Denial Doctrine Data, Aug. 29, 2025, available at <https://perma.cc/M65X-UCW9> (“For patents six years and older, the vast majority has settled expectations supporting denial. Conversely, for patents four years and younger, almost all supported referral for an institution decision. For five-year-old patents, the decisions remain split.”) (analyzing 249 petition decisions).

⁴ IPR2025-00327 (Jun. 26, 2025).

shows that the patent was never “commercialized” or “licensed.”⁵ As one commentator has noted, however, these exceptions “have proven to be largely ineffective in practice.”⁶ The latter exemption appears to have been successfully invoked only three times,⁷ and the “change in the law” proviso even less⁸—amici are not aware of *any* case in which it has been applied to allow PTAB review of a utility patent that is more than five years old.⁹

Thus as a practical matter, under the USPTO’s “settled expectations” rule, a patent’s validity cannot be contested in an AIA review once the patent is six years old. Notably, the *average* age of all the patents that have been challenged in an *inter partes* review in

⁵ *Id.*

⁶ Boetticher, E., Unsettling Expectations: Avoiding Discretionary Denial of IPR Petitions, Sep. 9, 2025, available at <https://perma.cc/AQ9E-VV6J>.

⁷ *See id.*

⁸ *See id.* (“To date, no petitioner has successfully applied [the ‘change in the law’ exception] to overcome settled expectations.”).

⁹ Similarly, although the USPTO has designated as “informative” its decision in *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217 (June 13, 2025), which allowed “settled expectations” to be overcome by a showing that the patent owner had asserted “a large number of patents from different families”—a common scenario in patent litigation—few if any additional petitioners appear to have benefited from this administrative grace.

the nearly decade and a half since the AIA was enacted is 6.7 years.¹⁰ About half of these challenged patents would have been immune from review under the USPTO's new rule.¹¹

The USPTO's actions are deeply prejudicial to amici's members, who face billions of dollars in potential liability for asserted patents that the agency improperly issued—and now refuses to correct. It was Congress itself that decided that the opportunity to raise invalidity defenses during infringement litigation is not enough—that a more predictable, technically expert validity review is needed, particularly when critical technologies are at stake.

It would be hard to overstate the violence that the USPTO's leadership has done to America Invents Act patent reviews during the past year. This Court's intervention is badly needed.

¹⁰ See DeFosse, J., Data Undermines USPTO's "Settled Expectations" Doctrine, Law360, Aug. 29, 2025.

¹¹ See *id.*

II. The USPTO’s new “settled expectations” rule is irrational.

The USPTO’s “settled expectations” rule effectively bars all PTAB validity review of a patent once it is six years old—and sometimes earlier.¹² The USPTO’s leadership has stated that the rule is intended to compel “early challenges” to a patent, such as via a post-grant review or an *inter partes* review that is filed in the first few years of the life of the patent.¹³

Because the USPTO has applied this new rule retroactively, Appellant Google had no way to know that it must comply with the rule. Google filed its PTAB petitions in May 2025. The “settled expectations” rule was subsequently announced in June 2025.¹⁴

¹² See Ryan Davis, “Stewart Says New Patent Policies Aim to Bring Stability,” Law360, Sep. 8, 2025 (noting that although “settled expectations have often been cited in denials when a patent was issued over six years ago, [that] . . . ‘does not mean that a patent owner cannot establish strong settled expectations on a younger patent.’”) (quoting Acting Director Stewart); see also *Amazon.com, Inc. v. Audio Pod IP, LLC*, IPR2025-00768 (Aug. 14, 2025) (applying “settled expectations” to deny review of a patent that is less than five years old); *Alliance Laundry Sys., LLC v. PayRange LLC*, IPR2025-00950 (Sep. 19, 2025) (same).

¹³ Ryan Davis, “Stewart Says New Policies Seek Fairness for Patent Owners,” Law360, Sep. 15, 2025; Davis, *supra* n. 12; see also Gene Quinn, “Stewart Says USPTO Wants Early Validity Challenges, Not Late IPRs,” IPWatchdog, Jun. 10, 2025.

¹⁴ See *Dabico Airport Solutions Inc v. AXA Power ApS*, IPR2025-00408 (Jun. 18, 2025). The patent at issue in *Dabico* was eight

The asserted patents, however, were issued in April 2018 and February 2019—and thus the “settled expectations” rule, even liberally interpreted, retroactively closed the window for review of these patents in April 2024 and February 2025.

Let us suppose, however, that the “settled expectations” rule had been imposed years earlier and thus retroactivity were not a barrier to compliance. How would “settled expectations” operate in practice? Apparently the USPTO expects that makers of video-content generation systems such as Google would monitor issued patents and published applications in their field, determine which of them might one day read on products that they may manufacture in the next decade and a half (products that may not even have been invented yet!), and then file post-grant and early *inter partes* review challenges against those patents that they believe to be invalid.¹⁵

years old. The agency appears to have first applied the “settled expectations” rule to a patent that is only six years old in *Amgen, Inc. v. Bristol-Meyers Squibb Co.*, IPR2025-00601, -00602 (Jul. 24, 2025).

¹⁵ As the Secretary of Commerce has apparently stated, the new policy amounts to “speak now or forever hold your peace.” Davis, *supra* n. 3.

Let us further suppose that the only patents that may read on Google's products are those assigned to the same classifications as would apply to the patents at issue in this case. U.S. Patents Nos. 9,940,972 and 10, 218,954, which were challenged by Google in the proceedings below, were issued in 2018 and 2019, respectively. The patents would likely belong to USPC Class 704, "Data Processing: Speech Signal Processing, Linguistics, Language Translation, and Audio Compression/Decompression," Class 382, "Image Analysis," and Class 345, "Computer Graphics Processing and Selective Visual Display Systems."¹⁶

In 2015 (the closest year for which data are available), 1,622 patents were assigned a classification to Class 704, 5,801 patents to Class 382, and 8,711 patents to Class 345.¹⁷

¹⁶ The '972 and '954 patents were issued after the USPTO's transition from the United States Patent Classification ("USPC") system to the Cooperative Patent Classification ("CPC") system, and the USPTO has not compiled data for patents issued by classification under the CPC system. For his field of classification search for these patents, however, the examiner relied on USPC Classes 704, 382, and 345. For present purposes, we will assume that the patents would have been assigned to those Classes had they issued when the USPC was still in use.

¹⁷ See USPTO, "Patent Counts by Class by Year," available at <https://perma.cc/6CL8-L46Z>. (This data has recently become unavailable on the USPTO's website. The preceding URL links to a

In a typical year, about three times as many patent-infringement lawsuits are filed as there are PTAB petitions filed.¹⁸ The correspondence between these numbers and the likelihood that an asserted patent will be challenged at the PTAB is not exact. Nevertheless, the best available data indicate that in the decade after the America Invents Act was enacted, the share of patents asserted in court that were subsequently challenged at the PTAB was 28%.¹⁹

Thus under the USPTO's proposed reimagining of the post-issuance review system, Google would have been expected to review the 16,134 patents that issued in the field of its technology in the relevant year and decide which of them appear to be invalid as

Perma.cc record of the original USPTO webpage as captured by the Internet Archive.)

¹⁸ In fiscal year 2023, for example, 3259 patent infringement suits and 1239 PTAB petitions were filed. See United States Courts, "Judicial Facts and Figures: Civil Cases Filed, by Nature of Suit," available at <https://www.uscourts.gov/data-table-report-names/judicial-facts-and-figures>; USPTO, "PTAB Trial Statistics: FY23 End of Year Outcome Roundup," available at https://www.uspto.gov/sites/default/files/documents/ptab_aia_fy_2023__roundup.pdf.

¹⁹ See RPX, "The Overlap Between Patents Asserted in District Court and Challenged at the PTAB," Jun. 1, 2023, available at <https://perma.cc/5YTN-3QQZ>.

obvious. Assuming that Google identified PTAB-worthy challenges to these patents at the same rate as defendants do when patents are asserted in court, Google would then be expected to file 4,517 post-grant or early *inter partes* review challenges to these patents.

Notably, this analysis accounts for only three of the 475 USPC technology classes—and only one of the thousands of parties that are sued for patent infringement every year. Even assuming some level of coordination among potential defendants in the filing of petitions, one might nevertheless conservatively estimate that the USPTO’s new “settled expectations” framework would require the filing of almost 100,000 post-grant and *inter partes* review petitions each year.

The burden and expense of filing these petitions is not the only disadvantage that potential defendants would face under the “settled expectations” framework. Because PTAB petitioners would be required to file their challenges within six years of the patent’s issuance, in many cases they would be filing years before they make a product that potentially infringes the patent. Although PTAB proceedings themselves are available to any party that is “not the owner of [the] patent,” 35 U.S.C. §§ 311(a), 321(a), a party must have Article III standing to appeal the outcome of a PTAB

proceeding to this Court. For PTAB petitioners, standing generally requires concrete plans of future activity that creates a substantial risk of infringement; this Court has repeatedly dismissed appeals by petitioners who have not yet made substantial investments in an infringing product.²⁰

The USPTO’s new “settled expectations” framework thus effectively requires potential future defendants to file pre-emptive challenges to patents and obtain final patentability decisions from the agency for which they would be unable to seek any form of judicial review.

Amici submit that the USPTO’s new “settled expectations” system is absurd. No rational governmental decisionmaker could have determined that such a rule serves the “efficient administration of the Office” or “the integrity of the patent system.” 35 U.S.C. § 316(b).

²⁰ See, e.g., *Incyte Corp. v. Sun Pharm. Indus., Inc.*, 136 F.4th 1096 (Fed. Cir. 2025); *Allgenesis Biotherapeutics Inc. v. Cloudbreak Therapeutics, LLC*, 85 F.4th 1377 (Fed. Cir. 2023); *Apple Inc. v. Qualcomm Inc.*, 992 F.3d 1378 (Fed. Cir. 2021); *Argentum Pharms. LLC v. Novartis Pharmaceuticals Corp.*, 956 F.3d 1374 (Fed. Cir. 2020); *General Electric v. United Techs.*, 928 F.3d 1349 (Fed. Cir. 2019); *Pfizer Inc. v. Chugai Pharm. Co., Ltd.*, 812 F. App’x 979 (Fed. Cir. Apr. 27, 2020).

All statutes and regulations are subject to rational-basis review—a rule must bear “a rational relation to some legitimate end.” *United States v. Skrmetti*, 145 S.Ct. 1816, 1828 (Jun. 18, 2025). There must be at least “a plausible policy reason for the [rule’s] classification.” *Armour v. City of Indianapolis, Ind.*, 566 U.S. 673, 681 (2012). It must appear that “the legislative facts on which the [rule] is apparently based rationally may have been considered to be true by the governmental decisionmaker.” *Id.*; *see also Vance v. Bradley*, 440 U.S. 93, 111 (1979) (“[A rule is irrational only if] the legislative facts on which the [rule] is apparently based could not reasonably be conceived to be true by the governmental decisionmaker.”)

No governmental decisionmaker could have “reasonably conceived to be true” that American businesses might file, and the USPTO would decide, nearly 100,000 PTAB petitions every year. Nor could businesses reasonably be expected to seek binding agency proceedings whose outcome they cannot appeal. The USPTO’s “settled expectations” rule is fundamentally irrational.

III. The USPTO's summary denial of PTAB petitions without explanation violates the APA.

Even the USPTO does not contend that it has discretion to ignore constitutional limits on executive power. Yet agency officials have taken actions that attempt to make such constitutional guarantees unenforceable.

In response to legal challenges to the USPTO's new institution policies, agency officials had hinted that they "could just issue one-word decisions denying review without explanation."²¹ And in a rule subsequently adopted by memo, the Director has followed through on this threat: he has indicated that he will personally decide whether to institute each of the 1,200 to 1,700 PTAB petitions that are filed each year, and if he "determines that institution is not appropriate, whether based on discretionary considerations, the merits, or other non-discretionary considerations, the Director will issue a summary notice denying institution."²² Since then, the USPTO has summarily denied hundreds of PTAB petitions.

This procedure is plainly illegal. The Supreme Court has "frequently reiterated that an agency must cogently explain why it

²¹ Ryan Davis, "Stewart Says New Policies Seek Fairness for Patent Owners," Law360, Sep. 15, 2025.

²² Director Institution of AIA Trial Proceedings, October 17, 2025, available at <https://perma.cc/DQ5J-X5G4>.

has exercised its discretion in a given manner,” *Motor Vehicle Mfrs. Ass’n of the U.S., Inc. v. State Farm Mutual Auto. Ins. Co.*, 463 U.S. 29, 48 (1983)—a rule that is plainly essential to the effective review of agency actions. Applying this rule, the regional U.S. Courts of Appeals have consistently required a reasoned explanation for all agency decisions. They have emphasized that “[i]t is axiomatic that the APA requires an agency to explain its basis for a decision.” *Physicians for Social Responsibility v. Wheeler*, 956 F.3d 634, 644 (D.C. Cir. 2020). “When an agency acts, it must examine the relevant data and articulate a satisfactory explanation for its action.” *Logic Tech. Dev. LLC v. FDA*, 84 F.4th 537, 549 (3d Cir. 2023). “If it does not, the agency has failed to engage in reasoned decisionmaking, and the APA requires the agency action be set aside.” *Id.* (citations omitted).²³

²³ See also *Deep v. Barr*, 967 F.3d 498, 503 (5th Cir. 2020) (“[A]n agency is not required to write an exegesis on every contention. What is required is merely that it consider the issues raised, and announce its decision in terms sufficient to enable a reviewing court to perceive that it has heard and thought and not merely reacted.”); *Louisville Gas & Elec. Co. v. Fed. Energy Regul. Comm’n*, 988 F.3d 841, 846 (6th Cir. 2021) (“[I]n all cases agencies must engage in reasoned decisionmaking. They must . . . articulate a satisfactory explanation for their action.”) (citations omitted); *Xia v. Scott*, 129 F.4th 1084, 1087 (8th Cir. 2025) (“An agency decision is arbitrary and capricious if it . . . provides no meaningful explanation for its conclusions.”); *Immigrant Def. Law Ctr. v. Noem*, 145 F.4th 972, 992 (9th Cir. 2025) (“[T]he agency must examine relevant data and articulate a

Notably, the requirement for an agency to explain its actions applies even when the underlying decision is discretionary. In *Physicians for Social Responsibility*, for example, the D.C. Circuit reviewed an EPA directive that barred the recipients of EPA grants from serving on EPA advisory committees. See 956 F.3d at 638. The Court noted that the relevant regulations provided that advisory committee members “serve at the pleasure of the [agency]” and that their “membership terms are at the sole discretion of the agency.” *Id.* at 640 (quoting 41 C.F.R. § 102-3.130(a)). The district court had dismissed the action on the basis that the agency’s decision “was committed to agency discretion by law.” *Id.* at 641.

The Court of Appeals reversed. Rejecting the notion that there was ‘no law to apply,’ it emphasized that it had found a basis for judicial review in “far more permissive and indeterminate language”—such a statute that provided that an agency “may excuse a failure to file if it finds it to be in the interests of justice.” *Id.* at 643 (discussing *Dickson v. Secretary of Defense*, 68 F.3d 1396, 1398 (D.C. Cir. 1995)). The D.C. Circuit reviewed the EPA’s decision and found

satisfactory explanation for its action.”); *Constellation Mystic Power, LLC v. FERC*, 45 F.4th 1028, 1055 (D.C. Cir. 2022) (“[W]hen an agency fails to provide an intelligible explanation for its decision, it has failed to engage in reasoned decisionmaking and we remand for further explanation.”) (citations omitted).

that the agency had failed to “articulate a satisfactory explanation for its action.” *Id.* at 644 (quoting *State Farm*, 463 U.S. at 43).

Similarly, *Multicultural Media, Telecom and Internet Council v. FCC*, 873 F.3d 932 (D.C. Cir. 2017), reviewed a challenge to the FCC’s decision to gather more information before issuing a regulation requiring broadcasters to issue emergency alerts in multiple languages. *See id.* at 935. Despite its conclusion that “the FCC has discretion” as to whether to require broadcasters to translate emergency messages, *id.*, the Court of Appeals nevertheless held that “the agency’s exercise of discretion must be . . . reasonably explained.” *Id.* at 937.

Even a decision as to how to spend a lump-sum appropriation—one of the types of inherently unreviewable decisions, *see Lincoln v. Vigil*, 508 U.S. 182, 191-2 (1993)—is nevertheless required to be reasonably explained. *Prairie Band Potawatomi Nation v. Yellen*, 63 F.4th 42 (D.C. Cir. 2022), heard a challenge to the distribution of COVID relief funds to Indian tribes. *See id.* at 44. The agency proposed additional allocations from available funds to tribes that had been undercounted in the previous year. *See id.* at 44. A tribe challenged how the undercount was calculated, noting that it received less money per capita than another tribe. *See id.* at 45, 46.

The D.C. Circuit held that even when agencies have “wide discretion,” they still “must cogently explain why discretion was exercised in a given manner.” *Id.* at 46 (quoting *State Farm*, 463 U.S. at 48). It reversed and remanded the Treasury Department’s allocation, holding that “[a]bsent further explanation,” the agency’s distribution of funds “treats similar situations in dissimilar ways contrary to the principles of reasoned decisionmaking.” *Id.* at 47 (quoting *Garrett v. FCC*, 513 F.2d 1056, 1060 (D.C. Cir. 1975)).²⁴

Under the USPTO’s new policy of refusing to explain institution decisions, it will be impossible to determine if an institution decision treats “similar situations in dissimilar ways,” *Prairie Band*, 64 F.4th at 47, was entirely arbitrary, or was influenced by an improper motive. Even constitutional limits are unenforceable if the USPTO is not required to give a reason for its decisions. This Court should enforce the rule that is applied in every other U.S. Court of Appeals and require the USPTO to explain its institution decisions.

²⁴ See also *United Airlines, Inc. v. TSA*, 20 F.4th 57, 63-64 (D.C. Cir. 2021) (requiring explanation of a discretionary decision); *New Mexico Health Connections v. U.S. Dep’t of Health & Hum. Servs.*, 946 F.3d 1138, 1167 (10th Cir. 2019) (“The APA’s requirement that an agency explain its decision applies when the agency exercises its discretion.”).

IV. PTAB petitioners—and the public—have legitimate interests in AIA reviews that are entitled to legal protection.

As a result of the USPTO’s extra-statutory restrictions on access to AIA reviews, there are now *hundreds* of patent-infringement lawsuits going forward in the United States in which the defendant prepared and filed a PTAB petition challenging the validity of the asserted patent, but the agency refused to consider the petition on its merits.²⁵

There is no need to speculate as to the likely consequences of the USPTO’s actions; recent experience shows us exactly what will happen. During 2020, when the USPTO previously experimented with another rule limiting access to AIA reviews, the agency denied review of a series of patents that had been asserted against Intel Corporation. During the next two years, two of those patents, after “discretionary” denial of review by the agency, went to trial and resulted in \$2.3 billion in damages awards against Intel to VLSI Technology LLC, a non-practicing entity controlled by Fortress

²⁵ Historically, the Board has found a “reasonable likelihood” that a patent is invalid and institutes review for about two-thirds of petitions and then found all claims invalid in a final written decision for about 65% of those instituted petitions. See PTAB Trial Statistics: 2025 End of Year Outcome Roundup, slides 7, 11, available at <https://perma.cc/2NAR-9LGK>.

Investment Group, which is owned by financial interests in Abu Dhabi.²⁶

The next year, however, the USPTO allowed *other* entities to challenge the same patents, on the same grounds that Intel had tried to present—and concluded that all the challenged claims are invalid as obvious.²⁷

In other words, the “discretionary” denial of review allowed VLSI to go to trial and seek billions in damages from America’s leading-edge chip manufacturer based on two patents that the USPTO has now determined are invalid. This type of litigation diverts resources away from investment in building new chip fabs and in maintaining America’s leadership in this critical technology. Immunizing such suits from validity review risks the unjustified transfer of money to entities that contribute nothing to the United States manufacturing economy.

And again, this experience is now being repeated in hundreds of lawsuits across the country—cases in which frequently hundreds of millions, and at times billions, of dollars are at stake. As a broad

²⁶ See Reuters, Intel loses U.S. patent trial, ordered to pay \$2.18 billion to VLSI Tech, Mar. 2, 2021; Britain Eakin, Intel Hit With \$949M Verdict In Latest VLSI Patent Fight, Law360, Nov. 5, 2022.

²⁷ See *Intel Corp. v. VLSI Tech. LLC*, IPR2021-01064 (May 12, 2023); *Patent Quality Assurance, LLC v. VLSI Tech. LLC*, IPR2021-01229 (June 13, 2023).

coalition of businesses recently warned, “[i]f these Patent Office policies remain unchecked, they will lead to a systematic looting of the American industrial economy.”²⁸

Intel’s experience shows that defendants that are sued on invalid patents claiming complex technologies can suffer real prejudice when the USPTO imposes arbitrary and retroactive restrictions on access to AIA reviews—even when they remain free “to properly raise [their] patentability defenses elsewhere.”²⁹

AIA reviews are the *only* contested proceedings in which an issued patent can be evaluated by the USPTO’s technical experts. Courts have long recognized the benefits of applying such expertise to the difficult scientific questions that often arise in patent cases.³⁰

²⁸ See Adam Lidgett, Industry Groups Want Trump Admin To Stop PTAB Changes, Law360, Nov. 4, 2025 (letter available at <https://us-made.org/usmade-joins-industry-coalition-demanding-uspto-restore-fair-patent-challenges-for-american-manufacturers/>).

²⁹ *In re Motorola Sols.*, 159 F.4th 30, 38 (Fed. Cir. 2025).

³⁰ See, e.g., *Cochrane v. Deener*, 94 U.S. 780, 784 (1876) (“Neither courts nor ordinary juries are perfectly adapted to the investigation of mechanical and scientific questions”—“it would, perhaps, be desirable if all cases of this sort could be referred to a commission of intelligent experts and practical men”); *Parke-Davis & Co. v. H. K. Mulford Co.*, 189 F. 95, 115 (C.C.S.D.N.Y. 1911) (Hand, J.) (noting the challenges of ruling on a chemical patent case “without any knowledge of even the rudiments of chemistry,” and suggesting the creation of a tribunal of “technical judges to whom technical questions are submitted”); the Honorable Alan D Albright, U.S. District Judge (W.D. Tex.) (“[N]ever, ever, ever, ever, ever offer an

And more fundamentally, it is Congress itself that decided that the opportunity to raise validity defenses during infringement litigation is not enough. Although civil litigation over patent validity has always been available, since 1980, Congress has authorized—and repeatedly reenacted and refined—post-issuance review at the USPTO.³¹ The proceedings serve the “important congressional objective” of applying the USPTO’s expertise to “revisit and revise earlier patent grants,” *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 272 (2016), thereby addressing “overpatenting and its diminishment of competition.” *Thryv, Inc v. Click-To-Call Techs., LP*, 590 U.S. 45, 54 (2020).

obviousness argument to a jury,” as the jury will not understand it.) (quoted in Dani Kass, What Judges Want You to Know: Litigate Smarter, Law360, Feb. 11, 2025).

³¹ See H.R. Rep. No. 96-1307, 96th Cong., at 4 (1980) (emphasizing the need “to have the validity of patents tested in the Patent office where the most expert opinions exist and at a much reduced cost”) (report to accompany H.R. 6933, authorizing reexamination of patents); Weekly Compilation of Presidential Documents, President Jimmy Carter, Dec. 12, 1980, Vol. 16, No. 50 (Statement on Signing H.R. 6933 into Law) (“Patent reexamination will . . . improve the reliability of reexamined patents, thereby reducing the costs and uncertainties of testing patent validity in the courts.”).

CONCLUSION

The USPTO's decision to deny institution based on "settled expectations" should be reversed.

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

Pursuant to Federal Rule of Appellate Procedure 32(g), the undersigned counsel for amici curiae certifies that this brief:

(1) complies with the type-volume limitation of Federal Rule of Appellate Procedure 29(a)(5) and Federal Circuit Rule 29(b) because it contains 4,426 words, including footnotes and excluding the parts of the brief exempted by Federal Rule of Appellate Procedure 32(f) and Federal Circuit Rule 32(b); and

(2) complies with the typeface and style requirements of Federal Rule of Appellate Procedure 32(a)(5) and (a)(6) because this document has been prepared using Microsoft Office Word and is set in the Bookman Old Style font in a size equivalent to 14 points or larger.

Dated: August 5, 2026

/s/ Joseph Matal