

No. 2026-1519, -1520

IN THE 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 United States Patent and Trademark Office,
Patent Trial and Appeal Board, Nos. IPR2025-00875, IPR2025-00876

BRIEF FOR INTERVENOR

Of Counsel:

AUSTIN P. MAYRON
Deputy Solicitor

ROBERT J. MCMANUS
Senior IP Legal Counsel

PETER J. SAWERT
BRIAN RACILLA
Associate Solicitors

SAIF M. ASKAR
Senior Legal Advisor

U.S. Patent and Trademark Office

BRETT A. SHUMATE

Assistant Attorney General

BRAD HINSHELWOOD
SAMUEL B. GOLDSTEIN

*Attorneys, Appellate Staff
Civil Division, Room 7242
U.S. Department of Justice
950 Pennsylvania Avenue NW
Washington, DC 20530
(202) 514-0718*

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STATEMENT OF RELATED CASES

No other appeal in or from this agency proceeding has previously been before this or any other appellate court. The government is not aware of any related cases within the meaning of Federal Circuit Rule 47.5(a)(2).

INTRODUCTION

In the Leahy-Smith America Invents Act (AIA), Pub. L. No. 112-29, 125 Stat. 284 (2011), Congress created inter partes review as a discretionary administrative proceeding for the U.S. Patent and Trademark Office (USPTO or PTO) to reconsider the patentability of claims in issued patents. Congress established certain criteria that must be met before the agency can institute an inter partes review, but it granted the USPTO's Director unfettered discretion to decline to institute a review regardless whether these preconditions are satisfied. And Congress made the Director's decisions whether to institute an inter partes review "final and nonappealable." 35 U.S.C. § 314(d). That is in part because a decision not to institute an inter partes review leaves both the petitioner and the patent owner's legal rights and obligations unchanged, and the petitioner remains free to raise any validity challenges in district-court litigation or in other agency proceedings.

Google LLC nonetheless seeks to appeal the USPTO's decision denying institution of two inter partes review petitions it filed challenging patents owned by Cellular South, Inc. (CSI). Google takes issue with the USPTO's reliance on CSI's "settled expectations," including the length of time those patents have been in force, as part of the totality of circumstances the agency considered in deciding not to devote its finite resources to inter partes review proceedings here. But this Court has already denied multiple mandamus petitions asserting that the agency's consideration of settled expectations exceeds its statutory authority and contravenes the separation

of powers. *In re Cambridge Indus. USA Inc.*, No. 2026-101, 2025 WL 3526129, at *2-3 & n.1 (Fed. Cir. Dec. 9, 2025) (per curiam); *In re Sandisk Techs., Inc.*, No. 2025-152, 2025 WL 3526507, at *1 (Fed. Cir. Dec. 9, 2025) (per curiam); *In re Google LLC*, No. 2026-111, 2026 WL 204945, at *1 (Fed. Cir. Jan. 27, 2026). Google here attempts to avoid these decisions—and the demanding mandamus standard—by directly appealing the USPTO’s institution denial and characterizing its challenge as a claim that the USPTO’s decision violated equal-protection principles.

This Court lacks jurisdiction over Google’s appeal for two independent reasons. First, Google’s appeal is barred under the plain text of 35 U.S.C. § 314(d), as it is seeking to “appeal” a “determination by the [USPTO] whether to institute an inter partes review.” This Court has already concluded that the result does not change merely because an appeal from an institution denial involves “constitutional” claims. *Mylan Lab’s Ltd. v. Janssen Pharmaceutica, N.V.*, 989 F.3d 1375, 1378-79 (Fed. Cir. 2021). Second, Congress specified that a party to an inter partes review generally may appeal only from a “final written decision with respect to the patentability of any patent claim challenged,” 35 U.S.C. § 318(a); *see id.* §§ 141(c), 319, and there is no final written decision for Google to appeal here.

Jurisdictional defects aside, Google’s equal-protection challenge is meritless. Google concedes that the highly deferential rational-basis standard governs here. And it is eminently rational—or at a minimum, not unconstitutionally irrational—for the USPTO to consider whether an inter partes review would disturb the patentee’s

settled expectations in making discretionary judgments about how best to allocate its finite resources and how best to accomplish agency policy priorities.

Google's alternative request for mandamus falls far short of the high bar for that extraordinary relief. Its meritless equal-protection claim does not establish a clear and indisputable right to mandamus relief. Moreover, Google has several alternative avenues to invalidate the challenged claims, as it can still avail itself of district court litigation or ex parte reexamination. Nor can Google show that mandamus would be appropriate. In committing institution decisions to the Director's unreviewable discretion, Congress recognized that the USPTO and its politically accountable Director are best positioned to balance administrative review of patent claims against the agency's other needs and the integrity of the patent system more generally. Google's invitation to second-guess the Director's discretionary determination about how best to allocate limited agency resources is not an appropriate use of the writ.

STATEMENT OF JURISDICTION

The USPTO denied institution on October 17, 2025. Appx1-3. The Director denied Director review on January 12, 2026. Appx5-6. Google filed notices of appeal on March 11, 2026. Appx52-54; Appx57-59. Google invokes this Court's jurisdiction under 28 U.S.C. § 1295(a)(4)(A). Br. 2. As explained below, this Court lacks jurisdiction over Google's appeal. *Infra* pp. 14-29.

STATEMENT OF THE ISSUES

1. Whether this Court lacks jurisdiction over Google’s appeal because 35 U.S.C. § 314(d) bars appeal of the USPTO’s decision not to institute inter partes reviews, and no statutory provision authorizes an appeal of that decision.
2. If this Court has jurisdiction over Google’s appeal, whether the USPTO’s decision not to institute inter partes reviews satisfies rational-basis review under the Fifth Amendment’s equal-protection component.
3. Whether Google’s alternative request for mandamus should be denied because Google has no clear and indisputable right to mandamus relief, Google has alternative avenues of relief, and mandamus would be inappropriate under the circumstances here.

STATEMENT OF THE CASE

A. Statutory and Regulatory Background

1. In the AIA, Congress created inter partes review, which “allows a third party to ask the [USPTO] to reexamine the claims in an already-issued patent and to cancel any claim that the agency finds to be unpatentable in light of prior art.” *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 265 (2016).

Any person other than the patent owner can file a petition requesting inter partes review of a patent. 35 U.S.C. § 311(a). After receiving the petition and any response, the USPTO’s Director “shall determine whether to institute an inter partes review.” *Id.* § 314(b). The AIA sets out “certain preconditions” that “must be met”

for the Director to institute an inter partes review. *Apple Inc. v. Vidal* (*Apple I*), 63 F.4th 1, 6 (Fed. Cir. 2023). Under Section 314(a), the Director “may not authorize an inter partes review to be instituted” unless he finds a “reasonable likelihood that the petitioner would prevail with respect to” at least one challenged claim. 35 U.S.C. § 314(a). Nor may the Director institute an inter partes review if the petition “is filed more than 1 year after the date on which the petitioner . . . is served with a complaint alleging infringement of the patent.” *Id.* § 315(b).

“Even when such requirements are met, however, the statute uses no language commanding institution.” *Apple I*, 63 F.4th at 6. Accordingly, the AIA “grants the Director discretion not to institute even when the threshold is met” based on considerations such as “administrative efficiency.” *BioDelivery Scis. Int’l, Inc. v. Aquestive Therapeutics, Inc.*, 935 F.3d 1362, 1365 (Fed. Cir. 2019) (quotation marks omitted); *see also SAS Inst. Inc. v. Iancu*, 584 U.S. 357, 366 (2018) (noting that “§ 314(a) invests the Director with discretion on the question whether to institute review” (emphasis omitted)).

Congress not only “committed institution decisions to the Director’s discretion,” it also “protected that exercise of discretion from judicial review.” *In re Motorola Sols., Inc.*, 159 F.4th 30, 36 (Fed. Cir. 2025). In particular, Section 314(d) specifies that the “determination by the Director whether to institute an inter partes review under this section shall be final and nonappealable.” 35 U.S.C. § 314(d). Section 314(a) and (d) together “commit[] the decision to institute inter partes review

to the Director’s unreviewable discretion.” *United States v. Arthrex, Inc.*, 594 U.S. 1, 8-9 (2021).

If the Director chooses to institute an inter partes review, the Patent Trial and Appeal Board conducts a proceeding to determine the challenged claims’ patentability. *See* 35 U.S.C. § 316; 37 C.F.R. pt. 42. Unless the inter partes review is “dismissed,” the Board must “issue a final written decision with respect to the patentability of any patent claim challenged by the petitioner.” 35 U.S.C. § 318(a). “A party dissatisfied with the final written decision of the [Board] under section 318(a) may appeal the decision” to this Court. *Id.* § 319; *see id.* § 141(c). On the other hand, if the Director declines to institute an inter partes review, the petitioner remains free to raise in litigation the invalidity grounds that were asserted in its petition. *See id.* § 315(e) (imposing estoppel effects on a petitioner only if an inter partes review “results in a final written decision under section 318(a)”).

2. Historically, the Director delegated to the Board the responsibility to determine whether a petition for inter partes review should be granted and an inter partes review thus instituted. 37 C.F.R. § 42.4(a); *see Apple I*, 63 F.4th at 7. Past Directors identified various discretionary factors for the Board to consider in determining whether to institute inter partes review in particular cases. *See, e.g., Apple Inc. v. Fintiv, Inc.*, No. IPR2020-00019, 2020 WL 2126495, at *2-3 (P.T.A.B. Mar. 20, 2020) (precedential) (setting forth several “non-dispositive factors” based on parallel district-court litigation).

In March 2025, the then-Acting Director of the USPTO modified the institution procedures for inter partes reviews to “improve [Board] efficiency,” “maintain [Board] capacity to conduct AIA proceedings,” and “reduce pendency” in appeals during the examination process, for which the Board has “statutory obligations.” Memorandum from Coke Morgan Stewart to All PTAB Judges, *Interim Processes for PTAB Workload Management* 1, 3 (Mar. 26, 2025), <https://perma.cc/G6VM-GFGU>. Under these procedures, the Director, in consultation with Board judges, would first “determine whether discretionary denial of institution is appropriate.” *Id.* at 1. In any briefing on discretionary considerations, parties would be “permitted to address all relevant considerations,” including “[w]hether the [Board] or another forum has already adjudicated” the challenged claims’ validity; “[c]ompelling economic, public health, or national security interests”; and, as relevant here, “[s]ettled expectations of the parties, such as the length of time the claims have been in force.” *Id.* at 2. If the Director determined that discretionary denial of institution “is not appropriate,” the Director would refer the petition to a Board panel to “handle the case in the normal course[,] including by issuing a decision on institution addressing the merits and other non-discretionary statutory considerations.” *Id.* at 1.¹

¹ John A. Squires was sworn in as the USPTO’s Director in September 2025. In October 2025, Director Squires announced that, going forward, the Director generally would make institution decisions himself, in consultation with Board judges, *Continued on next page.*

The Director has since designated several USPTO decisions applying the settled-expectations factor as “informative,” thereby setting forth “norms that should be followed in most cases, absent justification.” *See* Pat. Trial & Appeal Bd., *Standard Operating Procedure 2 (Revision 11)*, at 7 (July 24, 2023), <https://perma.cc/326H-K8ER>. In one such decision, the agency explained that “in general, the longer the patent has been in force, the more settled expectations should be,” though it emphasized that “there is no bright-line rule on when expectations become settled.” *Dabico Airport Sols. Inc. v. AXA Power ApS*, No. IPR2025-00408, 2025 WL 1710857, at *1 (Acting Director June 18, 2025) (informative). And the agency has recognized that a patentee may develop settled expectations not only through the length of time since a patent’s issuance, but also through circumstances such as “investment, time, and resources dedicated to research, development, trials, and regulatory approval” of the patented invention. *Amgen Inc. v. Bristol-Myers Squibb Co.*, No. IPR2025-00601, 2025 WL 2086050, at *1 (Acting Director July 24, 2025) (informative).

The Director has also made clear that other discretionary considerations may support institution despite the patent owner’s settled expectations. *See Magnolia Med. Techs., Inc. v. Kurin, Inc.*, No. IPR2026-00097, 2026 WL 1348926, at *4 (Director

rather than referring petitions to a Board panel where the Director has determined that discretionary denial is not warranted. Memorandum from John A. Squires to All PTAB Judges, *Director Institution of ALA Trial Proceedings* 1-2 (Oct. 17, 2025), <https://perma.cc/MZ99-X26J>. Director Squires indicated that the “process for briefing discretionary considerations” as outlined in the Acting Director’s March 2025 memorandum would “remain the same.” *Id.* at 2.

May 14, 2026) (precedential) (stressing that “[s]ettled expectations of *either party* may be a factor in determining whether to institute an AIA review” (emphasis added)). For instance, the USPTO has rejected a request for discretionary denial where the petitioner “did not have reason to anticipate assertion of the patent against it” because “the challenged patent has not been commercialized, asserted, marked, licensed, or otherwise applied” in the petitioner’s “technology space.” *Home Depot U.S.A., Inc. v. H2 Intellect LLC*, No. IPR2025-00480, 2025 WL 3908177, at *1 (Acting Director Sept. 4, 2025) (informative). The agency determined that the “[p]etitioner’s expectations . . . outweigh[ed]” the patent owner’s “strong settled expectations” from the challenged patent having “been in force for over twelve years.” *Id.* Similarly, the USPTO has rejected a request for discretionary denial—despite the patent owner’s “strong settled expectations” from the patent having “been in force for thirteen years”—where the patent owner “did not assert the challenged patent against [the petitioner] until eleven years after the parties’ discussion about that patent” and after the patent had “expired.” *Apple Inc. v. Allani*, No. IPR2025-00856, 2025 WL 3908118, at *1 (Acting Director Sept. 5, 2025) (informative).

B. Factual and Procedural Background

1. CSI owns U.S. Patent Nos. 9,940,972, 10,218,954, and 11,126,853, which claim methods and systems for generating text descriptions of video files. Appx15; Appx25-26; Appx27; Appx44-45; *see* Appx150. The ’972 patent was issued in 2018, the ’954 patent was issued in 2019, and the ’853 patent was issued in 2021. Appx15;

Appx27; *see* Appx2. In 2024, CSI sued Google, alleging infringement of these patents. *See* Appx73; Appx151; Appx239. On the last day of the one-year period after service of the complaint, *see* 35 U.S.C. § 315(b), Google petitioned for inter partes reviews of all three patents, Appx49; Appx51; *see* Appx152.

The USPTO’s Acting Chief Administrative Patent Judge—acting by delegation due to the Acting Director’s recusal—denied institution of the petitions challenging the ’972 and ’954 patents but declined discretionary denial as to the petition challenging the ’853 patent and referred that petition to the Board. Appx1-3. The Acting Chief explained that “[s]ome factors counsel[ed] against discretionary denial” for all three patents; for instance, any final written decision would be due before the scheduled trial date in the district court infringement suit. Appx2. And the ’853 patent had “not been in force for a significant amount of time”—just over four years. Appx2. Google’s “[e]arly challenge[]” to the ’853 patent “favor[ed] robust, predictable patent rights” and further “weigh[ed] against discretionary denial” for that patent. Appx2.²

But the Acting Chief concluded that the ’972 and ’954 patents “present[ed] different circumstances.” Appx2. These patents had “been in force for seven and six

² A Board panel subsequently denied institution on the ’853 patent, finding that Google had “not demonstrated a reasonable likelihood that at least one claim” was unpatentable. Decision Denying Institution of *Inter Partes* Review at 2, *Google LLC v. Cellular S., Inc.*, No. IPR2025-00877 (P.T.A.B. Nov. 21, 2025), Paper 11. Google has not attempted to appeal that decision.

years, respectively, creating settled expectations for [CSI].” Appx2. Google had not provided any “persuasive reasoning why an *inter partes* review” that would “disturb the settled expectations of [CSI]” would be “an appropriate use of Board resources.”

Appx2-3. The Acting Chief emphasized that, although the decision “highlighted” certain considerations, it reflected a “holistic assessment” based on “the totality of the evidence and arguments the parties ha[d] presented.” Appx2-3.

Director Squires, who was sworn in after the Acting Chief’s decision, denied Google’s requests for Director review. Appx5-6.

2. Google appealed the decision denying institution on the ’972 and ’954 patents. Appx52-54; Appx57-59. This Court granted the Director leave to intervene, Dkt. 20, and directed the parties to address any “jurisdictional and merits issues” together in their merits briefs, Dkt. 28.

SUMMARY OF ARGUMENT

I. For two independent reasons, this Court lacks jurisdiction over Google’s appeal of the USPTO’s decision not to institute *inter partes* reviews. First, in Section 314(d), Congress provided that the USPTO’s “determination . . . whether to institute an *inter partes* review” is “final and nonappealable.” 35 U.S.C. § 314(d). In *Mylan Laboratories Ltd. v. Janssen Pharmaceutica, N.V.*, 989 F.3d 1375 (Fed. Cir. 2021), this Court held that Section 314(d) precluded it from exercising jurisdiction over an appeal from a decision denying institution—even though the petitioner challenged the institution denial on “constitutional” grounds. *Id.* at 1378-79. *Mylan* forecloses

Google’s attempt to avoid Section 314(d) based on the constitutional nature of its challenge to an institution decision. At the same time, *Mylan* made clear that mandamus remains available if a petitioner raises “colorable constitutional claims” challenging a denial of institution. *Id.* at 1382. Interpreting Section 314(d) to encompass constitutional claims, as its plain text indicates, thus does not improperly “deny *any* judicial forum for a colorable constitutional claim.” *Webster v. Doe*, 486 U.S. 592, 603 (1988) (emphasis added).

Second, no statutory provision affirmatively authorizes Google to appeal the USPTO’s decision denying institution. Only a final written decision with respect to the patentability of the challenged claims may be appealed under Section 319, and this Court has held that its jurisdiction under 28 U.S.C. § 1295(a)(4)(A) is generally coextensive with Section 319’s appeal right. The agency’s decision here declined to institute a trial and made no determinations about the patentability of the challenged claims, so there is no final written decision for Google to appeal.

II. Even if this Court had jurisdiction over Google’s appeal, Google’s equal-protection challenge to the USPTO’s institution denial lacks merit. Google concedes that the highly deferential rational-basis standard governs its equal-protection claim. And it was entirely rational for the USPTO to consider the patentee’s settled expectations—including the length of time the challenged patents have been in force—as part of the totality of circumstances the agency considered here in determining whether to devote its limited resources to discretionary *inter partes*

review proceedings. After all, the AIA's text and context are replete with indications of Congress's concern with the timing and consequences of administrative challenges to patentability. Google fails to show that the USPTO acted with unconstitutional irrationality in accounting for similar concerns in the decision here.

III. Google alternatively requests a writ of mandamus if this Court lacks jurisdiction over Google's appeal, but Google cannot meet any of the requirements for that extraordinary relief. Because its equal-protection claim is meritless, Google fails to show any right to relief, let alone a clear and indisputable right. Google also has adequate alternative means of relief, as it can assert its patentability challenges in CSI's infringement suit against Google or by requesting ex parte reexamination. Nor does Google demonstrate that granting mandamus here would be an appropriate use of the writ. Google improperly asks this Court to second-guess the policy determination by the USPTO and its politically accountable Director about how best to allocate limited agency resources between discretionary review proceedings and the agency's other needs.

STANDARD OF REVIEW

This Court "decide[s] legal issues de novo, including whether a statute precludes judicial review and whether challenged agency action is not in accordance with the law or without observance of procedure required by law." *Federal Express Corp. v. Qualcomm Inc.*, 174 F.4th 910, 913 (Fed. Cir. 2026) (quotation marks omitted).

ARGUMENT

As explained more fully below, this Court lacks jurisdiction over Google’s appeal from the USPTO’s decision denying institution. But in any event, Google’s equal-protection challenge to that decision is meritless.

I. This Court Lacks Jurisdiction Over Google’s Appeal

This Court lacks jurisdiction over Google’s appeal from the USPTO’s decision denying institution of inter partes reviews. Google invokes 28 U.S.C. § 1295(a)(4)(A), which gives this Court jurisdiction over “an appeal from a decision of . . . the [Board] . . . with respect to” an “inter partes review.” *See* Br. 2. But several “more specific” provisions of the AIA “limit[]” this Court’s “§ 1295 jurisdiction.” *Mylan Lab’s Ltd. v. Janssen Pharmaceutica, N.V.*, 989 F.3d 1375, 1378-79 (Fed. Cir. 2021); *see also St. Jude Med., Cardiology Div., Inc. v. Volcano Corp.*, 749 F.3d 1373, 1375-76 (Fed. Cir. 2014) (similar). Section 314(d) bars appeal of the Director’s “determination . . . whether to institute an inter partes review.” 35 U.S.C. § 314(d). And Section 319 authorizes appeal from only a “final written decision of the [Board] under section 318(a),” *id.* § 319, that is, “a final written decision with respect to the patentability of any patent claim challenged,” *id.* § 318(a). Each of these limitations on this Court’s jurisdiction independently precludes Google’s attempt to appeal the institution denials here. And no different result holds merely because Google’s appeal purports to raise a constitutional challenge to the decision denying institution.

A. Section 314(d) Precludes Google’s Appeal Of The USPTO’s Decision Denying Institution

1. Section 314(d) provides that the “determination by the Director whether to institute an inter partes review under this section shall be final and nonappealable.” 35 U.S.C. § 314(d). The statutory text reflects a “broadly worded bar on appeal” of decisions related to institution. *St. Jude*, 749 F.3d at 1376. It precludes an appeal of the institution decision not only when the Director declines to institute, but also when raised “in a proper appeal of a final written decision reached by the Board after a positive institution determination.” *Apple Inc. v. Vidal (Apple I)*, 63 F.4th 1, 7 (Fed. Cir. 2023). Moreover, Section 314(d) “is not confined to” the Director’s “threshold determination” of “whether the petitioner has a reasonable likelihood of prevailing.” *Thryv, Inc v. Click-to-Call Techs., LP*, 590 U.S. 45, 56 (2020). Rather, the statute “bars review at least of matters ‘closely tied to the application and interpretation of statutes related to’ the institution decision.” *Id.* at 53 (quoting *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 275 (2016)). Those matters include the Director’s “exercise of [his] discretion whether to institute [inter partes review].” *BioDelivery Scis. Int’l, Inc. v. Aquestive Therapeutics, Inc.*, 935 F.3d 1362, 1367 (Fed. Cir. 2019).

Applying these principles, this Court in *Mylan* held that it lacked jurisdiction over an appeal from a decision denying institution, even where the petitioner challenged that decision on constitutional grounds. 989 F.3d at 1377-79. The petitioner contended that the Board violated its “constitutional . . . due process rights”

by denying institution based on an upcoming trial in a district-court suit to which the petitioner was not a party. *Id.* at 1378. And the petitioner asserted that its “constitutional” claim “distinguishe[d]” its appeal from previous cases where this Court dismissed appeals from institution denials. Opp’n to Mot. to Dismiss at 2, *Mylan Lab’s Ltd. v. Janssen Pharmaceutica, N.V.*, No. 21-1071 (Fed. Cir. Dec. 7, 2020).

This Court nonetheless held that it “lack[ed] jurisdiction” over the petitioner’s appeal. *Mylan*, 989 F.3d at 1379. The Court reasoned that “Section 314(d) prevents ‘appeal’ from a decision denying institution,” and “[w]ithout the ability to ‘appeal,’ parties cannot make use of § 1295(a)(4)’s jurisdictional grant.” *Id.* at 1378. Accordingly, the Court “grant[ed]” the patent owner’s motion to dismiss the appeal for “lack of jurisdiction” and “dismiss[ed]” the petitioner’s “direct appeal.” *Id.* at 1377, 1379. The Court went on to explain that “[w]hile there is no avenue for direct appeal of decisions denying institution, . . . judicial review is available in extraordinary circumstances by petition for mandamus.” *Id.* at 1379. But given the AIA’s “bestowal of discretion on the Director combined with its prohibition on appeal of such decisions,” the Court concluded that mandamus is unavailable to challenge “the Director’s exercise of his discretion to deny institution except for colorable constitutional claims.” *Id.* at 1382. And the Court concluded that the petitioner there “fail[ed] to state a colorable claim for constitutional relief” because it had no protected property right in institution of an inter partes review. *Id.* at 1383.

This Court lacks jurisdiction over Google’s appeal for the same reasons it lacked jurisdiction over the appeal in *Mylan*. Google’s core contention is that the USPTO improperly declined to institute inter partes reviews based on CSI’s “settled expectations.” Br. 19. And it seeks an order “vacat[ing] the PTO’s non-institution decision and direct[ing] the PTO to reconsider Google’s petitions” without considering CSI’s “settled expectations.” Br. 18. Google thus plainly challenges the “determination by the [USPTO] whether to institute an inter partes review,” which Section 314(d)’s text makes “final and nonappealable.” 35 U.S.C. § 314(d). Were that not enough, Google’s claim involves “matters ‘closely tied to the application and interpretation of statutes related to’ the institution decision,” *Thryv*, 590 U.S. at 53—namely, the USPTO’s exercise of its “discretion” under Section 314(a) not to institute inter partes reviews, *see Mylan*, 989 F.3d at 1379 (quotation marks omitted). Just as in *Mylan*, “Section 314 bars direct appeal from a decision denying institution,” even if the appeal involves a constitutional challenge. *Id.*

2. Google provides no sound basis to depart from this Court’s interpretation of Section 314(d) in *Mylan*.

a. Google suggests that *Mylan* should be read “narrow[ly]” as dismissing the petitioner’s appeal on the ground that the appeal “did not present colorable constitutional claims.” Br. 29. Such a reading finds no support in *Mylan* itself. In concluding that the Court lacked jurisdiction over the petitioner’s “direct appeal,” it relied on the “language of section 314(d),” the “structure of the [inter partes review]

provisions,” and Section 1295(a)(4) “read in light of those provisions.” *Mylan*, 989 F.3d at 1378 (quoting *St. Jude*, 749 F.3d at 1375). Nothing in the Court’s analysis of the petitioner’s appeal turned on—or even mentioned—whether the constitutional claim raised in the appeal was colorable. Rather, the Court addressed “colorable constitutional claims” only in explaining that “mandamus” may be available when such claims are raised. *Id.* at 1382. And the Court determined that the *Mylan* petitioner “fail[ed] to state a colorable claim for constitutional relief” only in holding that the petitioner had not “identifie[d] a clear and indisputable right to relief” warranting mandamus. *Id.* at 1382-83. This Court has accordingly understood *Mylan* as recognizing that ““colorable constitutional claims”” present a “possible exception[]” to the principle that “*mandamus* is ordinarily unavailable for review of institution decisions.” *In re Motorola Sols., Inc.*, 159 F.4th 30, 36 (Fed. Cir. 2025) (emphasis added) (quoting *Mylan*, 989 F.3d at 1382). *Mylan* does not purport to recognize any exceptions to the rule that “the appeal bar in § 314(d) prevents any direct appeal” when “institution is denied.” 989 F.3d at 1380.

b. Even if *Mylan* did not foreclose Google’s appeal, Google’s efforts to avoid Section 314(d) do not withstand scrutiny. Google asserts that Congress’s “intent” to “preclude judicial review of constitutional claims” must be “clear.” Br. 21 (quoting *Webster v. Doe*, 486 U.S. 592, 603 (1988)). But even if a clear statement were necessary, Section 314(d)’s text provides it. The statute specifies that the Director’s “determination . . . whether to institute an inter partes review” is “final and

nonappealable.” 35 U.S.C. § 314(d). Section 314(d) thus forecloses any attempt to “appeal” an institution decision—even an appeal raising a constitutional challenge.

Google thus errs in relying on cases where courts deemed it “fairly possible” to read a judicial-review bar not to encompass the constitutional claims at issue. Br. 21. For instance, in *Webster*, a statute provided that the “Director of Central Intelligence may, in his discretion, terminate the employment of any officer or employee of the [Central Intelligence] Agency whenever he shall deem such termination necessary or advisable in the interests of the United States.” 486 U.S. at 594 (quoting 50 U.S.C. § 403(c) (1988)). Because the statute provided no “meaningful judicial standard” against which to review termination decisions, the Supreme Court held that it committed such decisions to agency discretion and thus “preclude[d] judicial review” under the Administrative Procedure Act (APA). *Id.* at 600-01 (citing 5 U.S.C. § 701(a)(2)). But the statutory text did not clearly indicate that “Congress meant to preclude consideration of colorable constitutional claims” arising out of such decisions. *Id.* at 603. Similarly, in *Woodward v. United States*, 871 F.2d 1068 (Fed. Cir. 1989), a statute specified that the Secretary of the Navy “may at any time release a Reserve under his jurisdiction from active duty.” *Id.* at 1071 (quoting 10 U.S.C. § 681(a) (1982)). While this statute conferred “generally unfettered” discretion on the Secretary, it did not clearly indicate an intent to preclude constitutional challenges to such employment decisions. *Id.* at 1072. Neither *Webster* nor *Woodward* involved an

express judicial-review bar—much less one like Section 314(d) whose plain text encompasses even constitutional claims.

Moreover, in *Johnson v. Robison*, 415 U.S. 361 (1974), a statute rendered “final and conclusive” any “decisions of the Administrator [of Veterans’ Affairs] on any question of law or fact under any law administered by the Veterans’ Administration.” *Id.* at 365 n.5 (quoting 38 U.S.C. § 211(a) (1974)). The Supreme Court concluded that this provision covered only challenges to individual “decisions” under the veterans’ benefits scheme—not the plaintiff’s facial challenge to the constitutionality of the scheme itself. *Id.* at 367. The plaintiff’s “constitutional challenge [was] not to any such decision of the Administrator, but rather to a decision of Congress” in enacting the statutory scheme. *Id.* Likewise, in *Lepre v. Department of Labor*, 275 F.3d 59 (D.C. Cir. 2001), the relevant statute provided that any “action of the Secretary [of Labor] . . . in allowing or denying a payment under this subchapter” was “final and conclusive.” *Id.* at 64 (quoting 5 U.S.C. § 8128(b) (1994)). The D.C. Circuit determined that this statute did not preclude review of a due-process challenge to the agency’s “mailbox rule” establishing a presumption that individuals have received notices mailed to them. *Id.* at 62. The plaintiff’s challenge to “the Secretary’s generic use of the mailbox rule” was not “barred by [the statute’s] bar on review of specific ‘action’ of the Secretary” denying a payment. *Id.* at 68.

Here, by contrast, Google does not raise a facial constitutional challenge to the AIA. Instead, it challenges a “determination by the [USPTO] whether to institute an

inter partes review” based on its individual petitions. 35 U.S.C. § 314(d); *see* Br. 32 (contending that the “PTO’s *application* of the settled expectations rule violated the equal protection component of the Fifth Amendment” (emphasis added)); Br. 38, 41 (similar). And the agency’s “determination” not to institute reviews was plainly made “under this section,” *i.e.*, Section 314. 35 U.S.C. § 314(d); *contra* Br. 25-26. “That phrase indicates that § 314 governs the Director’s institution of inter partes review”; thus, “every decision” whether to institute an inter partes review “is made ‘under’ § 314.” *Thryv*, 590 U.S. at 57. Accordingly, Section 314(d) makes the USPTO’s determination not to institute reviews here “final and nonappealable.” 35 U.S.C. § 314(d). To the extent Google occasionally purports to challenge some broadly applicable “settled expectations rule” itself, *see, e.g.*, Br. 33 n.8, 56, the result would be no different. Section 314(d) bars any “appeal” of an institution decision; it makes no exception where the appellant seeks to challenge broadly applicable agency guidance in that appeal. *See Apple I*, 63 F.4th at 13 (explaining that Section 314(d)’s “preclusion of review” is not limited to “petition-specific challenge[s]”).

Further, a key reason for permitting judicial review in Google’s cited cases was to “avoid the ‘serious constitutional question’ that would arise if a federal statute were construed to deny *any* judicial forum for a colorable constitutional claim.” *Webster*, 486 U.S. at 603 (emphasis added); *see also Elgin v. Department of Treasury*, 567 U.S. 1, 9 (2012) (explaining that a “necessary predicate to the application of *Webster*’s heightened standard” is “a statute that purports to ‘deny any judicial forum for a

colorable constitutional claim”). Indeed, the judicial-review bars in *Johnson* and *Lepre* both encompassed even actions for “mandamus.” *Johnson*, 415 U.S. at 365 n.5; *Lepre*, 275 F.3d at 64. Thus, if those provisions “reached constitutional challenges . . . then absolutely no judicial consideration of the issue would be available.” *Weinberger v. Salfi*, 422 U.S. 749, 762 (1975) (discussing *Johnson*). Here, by contrast, Section 314(d) is “silent with respect to mandamus,” and this Court made clear in *Mylan* that mandamus remains available when a petitioner challenges an institution denial and raises “colorable constitutional claims.” 989 F.3d at 1380, 1382. The AIA thus leaves open a judicial forum for such claims, and constitutional-avoidance principles provide no basis to construe Section 314(d) more “narrow[ly]” than its plain text requires.

Br. 30.

Google insists that “[a]llowing constitutional claims to be raised only in mandamus petitions does not preserve meaningful review” because a mandamus petitioner must show a “clear and indisputable” right to the writ. Br. 31. But in emphasizing that mandamus remains available for “colorable constitutional claims,” this Court in *Mylan* cited the passage in *Webster* noting the “constitutional question[s]” that might arise if a “federal statute were construed to deny any judicial forum for a colorable constitutional claim.” *Mylan*, 989 F.3d at 1382; *Webster*, 486 U.S. at 603-04 (quotation marks omitted). *Mylan*’s discussion would make little sense if the availability of mandamus were insufficient to avoid the very concern identified in *Webster*. Nor does Google point to any authority holding that mandamus does not

provide meaningful judicial review. Google relies (Br. 31-32) on *McNary v. Haitian Refugee Center, Inc.*, 498 U.S. 479 (1991), but that case, like *Johnson*, merely interpreted a statute barring review of a particular agency “determination” not to preclude constitutional challenges to the “practices and policies used by the agency” in making that determination. *Id.* at 491-92. *McNary* does not even mention mandamus, much less hold that mandamus is not a “sufficient vehicle for vindicating constitutional rights.” Br. 31.

c. Google’s other attempts to evade Section 314(d)’s plain text fare no better. Contrary to Google’s suggestion (Br. 19), *Cuozzo* did not “expressly” recognize an exception for “appeals that implicate constitutional questions.” Rather, the Supreme Court stated that it “need not, and d[id] not, decide the precise effect of § 314(d) on appeals that implicate constitutional questions.” *Cuozzo*, 579 U.S. at 275. For instance, the Supreme Court suggested that a “final decision where a petition fails to give ‘sufficient notice’ such that there is a due process problem with the entire proceeding . . . may be properly reviewable in the context of § 319.” *Id.* Here, by contrast, the USPTO denied institution, and there is no final written decision reviewable under Section 319. *See infra* pp. 26-27. And in any event, Google “confuses a reservation of decision with a holding on the merits.” *Dental Monitoring SAS v. Align Tech., Inc.*, --- F.4th ---, No. 2025-1752, 2026 WL 2291181, at *3 (Fed. Cir. Aug. 10, 2026). As Google elsewhere recognizes, *Cuozzo* “did not have occasion

to decide” Section 314(d)’s effect on “appeals that present constitutional claims.”

Br. 26.

Nor is Google correct to suggest that Section 314(d) does not bar appeal of constitutional challenges to institution decisions because constitutional claims are outside the agency’s “competence and expertise.” Br. 26 (quoting *Axon Enter., Inc. v. FTC*, 598 U.S. 175, 194 (2023)). In assessing whether Congress “implicitly” precluded district-court jurisdiction over challenges to agency action by channeling such challenges through the agency itself, courts consider whether the particular claims are within the agency’s “expertise.” *Axon*, 598 U.S. at 195. But that inquiry has no bearing on the scope of an “explicit[]” judicial-review bar like Section 314(d). *See id.* at 185. Regardless, the Supreme Court has recognized that an agency’s decisions about how “agency resources are best spent” are “peculiarly within its expertise.” *Heckler v. Chaney*, 470 U.S. 821, 831 (1985). Here, where Google’s appeal challenges how the USPTO has chosen to allocate its finite resources to discretionary inter partes review proceedings, it is hardly surprising that Congress has chosen to insulate such decisions from judicial review.

3. Even if Section 314(d) did not preclude appeals of institution decisions involving colorable constitutional claims, Google’s appeal raises no such claim in substance. This Court has previously rejected an attempt to recast “disagreements” with the USPTO’s exercise of its institution discretion as claims that the agency “had no rational basis” for denying institution in violation of equal-protection principles.

In re Intel Corp., No. 2026-113, 2026 WL 506045, at *2 (Fed. Cir. Feb. 24, 2026) (per curiam) (denying mandamus petition). Such claims “amount to nothing more than” attacks on “how the PTO may have applied (or not applied) certain statutes related to institution,” which “do not present reviewable challenges” or any “colorable equal protection claim.” *Id.*

The same is true here. As Google’s equal-protection arguments makes clear, the gravamen of its claims is that “no statute related to institution . . . gives the PTO authority to deny institution based on the age of the relevant patent.” Br. 35; *see also*, *e.g.*, Br. 46 (asserting that “[t]he settled expectations rule . . . funnels challenges into demonstrably inferior forums that the AIA was enacted specifically to avoid”). But as Google acknowledges, “this Court has held that it lacks jurisdiction to review such arguments.” Br. 33 n.8; *see, e.g., In re Cambridge Indus. USA Inc.*, No. 2026-101, 2025 WL 3526129, at *2-3 & n.1 (Fed. Cir. Dec. 9, 2025) (per curiam) (denying mandamus petition raising statutory-authority and separation-of-powers challenges to USPTO’s consideration of settled expectations). Google’s “characterization” of its challenge as “constitutional in nature” cannot “confer upon [this Court] jurisdiction that [it] otherwise lack[s].” *Helper v. West*, 174 F.3d 1332, 1335 (Fed. Cir. 1999).

B. Google Identifies No Statutory Right To Appeal The USPTO's Institution Denial

This Court separately lacks jurisdiction over Google's appeal because no statutory provision authorizes Google to appeal the USPTO's decision denying institution.

Section 319 provides that a “party dissatisfied with the final written decision of the [Board] under section 318(a) may appeal the decision pursuant to sections 141 through 144.” 35 U.S.C. § 319. Section 318(a), in turn, specifies a particular type of “final written decision”—one “with respect to the patentability of any patent claim challenged.” *Id.* § 318(a). Section 141 similarly specifies that a “party to an inter partes review . . . who is dissatisfied with the final written decision of the [Board] under section 318(a) . . . may appeal the Board's decision” to this Court. *Id.* § 141(c). As this Court has explained, the “statutory grant of jurisdiction” under 28 U.S.C. § 1295(a)(4)(A) “matches the appeal right in” Sections 319 and 141(c). *St. Jude*, 749 F.3d at 1376; *cf. Mylan*, 989 F.3d at 1378 (noting that “more specific statute[s]” limit “the ‘appeal from a decision’ language in § 1295(a)(4)”). Thus, appeals from decisions other than “the Board's decision under section 318(a) on the merits of the *inter partes* review” are generally “outside” this Court's jurisdiction. *St. Jude*, 749 F.3d at 1376; *see also Cuno*, 579 U.S. at 272 (Section 319 “limit[s] appellate review to the ‘final written decision’”); *Medtronic, Inc. v. Robert Bosch Healthcare Sys., Inc.*, 839 F.3d 1382, 1385 (Fed. Cir. 2016) (explaining that “appeals from final decisions” in inter partes reviews “will

generally be limited to a ‘decision with respect to . . . patentability’” (quoting 35 U.S.C. § 318(a)).

Here, the USPTO “denied” Google’s petitions for inter partes review and indicated that “no trial is instituted.” Appx3. The agency did not issue any “final written decision with respect to the patentability of any patent claim challenged by the petitioner.” 35 U.S.C. § 318(a). Accordingly, there is no “final written decision . . . under section 318(a)” from which Google could appeal under Section 319. *Id.* § 319.

This Court’s decision in *Arthrex, Inc. v. Smith & Nephew, Inc.*, 880 F.3d 1345 (Fed. Cir. 2018), is not to the contrary. There the Board entered an adverse judgment against the patent owner under 37 C.F.R. § 42.73(b) after the patent owner disclaimed the claims challenged in a petition for inter partes review. *Id.* at 1347-48. This Court in *Arthrex* held that “the language of 28 U.S.C. § 1295 appears to provide for appeal” because the Board’s “adverse judgment” reflecting the cancellation of the challenged claims was “a decision of the Board . . . ‘with respect to’ an inter partes review proceeding.” *Id.* at 1348 (quoting 28 U.S.C. § 1295(a)(4)(A)). But the Court there addressed a Board decision giving legal effect to the cancellation of patent claims, and it emphasized that its holding was limited to “final adverse judgment decisions.” *Id.* at 1349. And this Court has subsequently clarified that *Arthrex* “did not involve a deinstitution decision” and “could not overrule [this Court’s] precedent” holding that the Court lacks jurisdiction over appeals from deinstitution decisions. *Sling TV, LLC v. Realtime Adaptive Streaming LLC*, 840 F. App’x 598, 599 (Fed. Cir. 2021); *see also*

Mylan, 989 F.3d at 1379 n.3. Further, to the extent *Arthrex*’s holding was informed by the fact that “an estoppel effect attached” to the Board’s adverse judgment against the patent owner, 880 F.3d at 1347, only a proceeding that “results in a final written decision under section 318(a)” estops the petitioner from taking certain actions before the USPTO or in district court, 35 U.S.C. § 315(e).

Google identifies no other source of authority to appeal the USPTO’s institution denials here. This Court has already recognized that the APA “cannot confer jurisdiction over decisions denying institution.” *Mylan*, 989 F.3d at 1379. After all, the APA’s default cause of action, 5 U.S.C. § 704, is unavailable when other “statutes preclude judicial review,” *id.* § 701(a)(1), or when “agency action is committed to agency discretion by law,” *id.* § 701(a)(2). Both limitations apply here. Section 314(d) “preclu[des] . . . review” of decisions relating to institution within the meaning of the APA. *Apple I*, 63 F.4th at 13-14. And through Section 314(a) and (d), “Congress has committed the decision to institute inter partes review to the Director’s unreviewable discretion.” *United States v. Arthrex, Inc.*, 594 U.S. 1, 8-9 (2021); *see Cuozzco*, 579 U.S. at 273; *Apple Inc. v. Squires (Apple II)*, 166 F.4th 1349, 1360-61 (Fed. Cir. 2026).³

³ To the extent that APA review is available regarding the USPTO’s actions under the AIA, such review must be initiated through a district-court action, not an action in this Court. *See Apple I*, 63 F.4th at 14-18 (remanding an APA rulemaking claim to district court).

Nor can Google rely on any “judge-made remedy” authorizing litigants to “sue to enjoin unconstitutional actions by . . . federal officers.” *Armstrong v. Exceptional Child Ctr., Inc.*, 575 U.S. 320, 327 (2015). Google has not sued in district court seeking an injunction against the USPTO or any of its officials; rather, Google has appealed the agency’s institution denials and requested that this Court “vacate the non-institution decisions.” Br. 6. In any event, the Supreme Court has made clear that any such cause of action in equity is “subject to express and implied statutory limitations.” *Armstrong*, 575 U.S. at 327. As explained, Section 314(d) expressly bars appeals of institution decisions, and Section 319 specifies the “final written decision with respect to . . . patentability” as the only appealable decision within the inter partes review scheme. *Supra* pp. 15-17, 26-27. These restrictions demonstrate that Congress intended to “preclude” any equitable cause of action to challenge decisions denying institution. *Armstrong*, 575 U.S. at 328.

II. The USPTO’s Institution Denial Comports With Equal-Protection Principles

Even if this Court had jurisdiction over Google’s direct appeal of the USPTO’s decision denying institution, that decision was fully consistent with the equal-protection component of the Due Process Clause.⁴

⁴ Under this Court’s precedent, the Court need not decide “statutory jurisdictional disputes” before “reaching other dispositive issues.” *Minesen Co. v. McHugh*, 671 F.3d 1332, 1337 (Fed. Cir. 2012); *see also Etchegoinberry v. United States*, 132 F.4th 1374, 1378 (Fed. Cir. 2025) (noting that under *Minesen*, “some statutory

Continued on next page.

1. A governmental classification that “neither proceeds along suspect lines” such as race or sex “nor infringes fundamental constitutional rights” is assessed only under “rational-basis review.” *FCC v. Beach Commc’ns, Inc.*, 508 U.S. 307, 313-14 (1993). Under that standard, courts “will uphold a statutory classification so long as there is ‘any reasonably conceivable state of facts that could provide a rational basis for the classification.’” *United States v. Skremetti*, 605 U.S. 495, 522 (2025). “Rational-basis review affords the policy choices of the political branches ‘a strong presumption of validity.’” *Sanchez v. Office of State Superintendent of Educ.*, 45 F.4th 388, 395 (D.C. Cir. 2022) (quoting *Beach*, 508 U.S. at 314). The “burden is on [the challenger] to negate every conceivable basis that might support” the challenged action, “regardless of whether the basis has a foundation in the record.” *Almond Bros. Lumber Co. v. United States*, 721 F.3d 1320, 1328 (Fed. Cir. 2013).

The USPTO’s institution decision easily satisfies that highly deferential standard. The agency recognized that “[s]ome factors,” such as the distant trial date in CSI’s district-court infringement suit against Google, “counsel[ed] against discretionary denial” on all three patents challenged in Google’s petitions. Appx2. Google’s “[e]arly challenge[]” to the ’853 patent, which had issued just over four years

requirements may not be ‘jurisdictional’ such that they must be answered prior to addressing the merits of a dispute”). This Court’s lack of “jurisdiction over appeals from decisions denying institution” presents a “statut[ory]” jurisdictional issue. *Mylan*, 989 F.3d at 1379. Accordingly, this Court’s precedent indicates that it could reject Google’s constitutional claim without conclusively resolving the jurisdictional dispute here.

earlier, “favor[ed] robust, predictable patent rights” and further “weigh[ed] against discretionary denial” on that patent. Appx2. But the Acting Chief concluded that the ’972 and ’954 patents “present[ed] different circumstances.” Appx2. These patents had “been in force for seven and six years, respectively, creating settled expectations for [CSI].” Appx2. Google had not provided any “persuasive reasoning why an *inter partes* review” that would “disturb the settled expectations of [CSI]” would be “an appropriate use of Board resources.” Appx2-3. Thus, based on the “totality of the evidence and arguments” presented, the agency decided not to institute *inter partes* reviews of the ’972 and ’954 patent but referred the petition challenging the ’853 patent to a Board panel to assess the merits of the patentability challenges. Appx2-3.

The USPTO’s consideration of Board resources was consistent with agency guidance governing the institution process. The agency invited parties to address “all relevant considerations”—including “[s]ettled expectations of the parties,” among several other enumerated considerations—as part of the agency’s efforts to “improve [Board] efficiency,” “maintain [Board] capacity to conduct AIA proceedings,” and “reduce pendency in *ex parte* appeals” during the examination process. *Interim Processes for PTAB Workload Management, supra*, at 2-3. Here, given the agency’s assessment of its “workload needs,” *id.* at 3, it was entirely rational for the agency to decide to devote its limited resources to further consideration of the petition challenging the ’853 patent—which raised an “[e]arly challenge[]” to patentability and thus promoted “robust, predictable patent rights,” Appx2—but not to expend further resources

reconsidering the '972 and '954 patents, which had been in force for a longer period of time.

2. Google concedes that the “rational basis” standard governs its equal-protection challenge to the USPTO’s institution decision. Br. 34; *see* Br. 38-39. But Google scarcely even acknowledges the “Board resources” rationale underlying the agency’s decision not to institute on the '972 and '954 patents and the agency guidance that decision applied. Appx2. Google thus falls far short of meeting its burden to “negate every conceivable basis” for the challenged action. *Almond Bros.*, 721 F.3d at 1328.⁵

Instead, Google’s main contention is that “encouraging early challenges to patent validity” is “irrational” because it fails to align with Google’s view of the “economics” related to inter partes reviews. Br. 47. Even if that were a freestanding basis for the USPTO’s exercise of its discretion here, it would not be unconstitutionally arbitrary. To the contrary, the AIA’s text, structure, and legislative history all reflect Congress’s concern with the timing and availability of patent-validity challenges. The AIA’s drafters “recognize[d] the importance of quiet title to patent

⁵ Google is also wrong that the USPTO’s consideration of settled expectations categorically “renders [inter partes review] unavailable for any patent that is more than six years old.” Br. 4; *see* Br. 38 (similar). The agency has made clear that “there is no bright-line rule on when expectations become settled,” *Dabico Airport Sols. Inc. v. AXA Power ApS*, No. IPR2025-00408, 2025 WL 1710857, at *1 (Acting Director June 18, 2025) (informative), and that settled expectations are just one consideration among many that the agency may consider in exercising its institution discretion, *Interim Processes for PTAB Workload Management*, *supra*, at 2-3; *see supra* pp. 7-9.

owners to ensure continued investment resources.” H.R. Rep. No. 112-98, pt. 1, at 48 (2011). And they stressed that “repeated litigation and administrative attacks on the validity of a patent” would “frustrate the purpose” of the AIA and “divert resources from the research and development of inventions.” *Id.* Similarly, some members of Congress criticized pre-AIA administrative review proceedings as “cast[ing] a cloud over a patent” and “greatly devalu[ing], if not effectively nullify[ing], a patent for most of its useful life.” S. Rep. No. 111-18, at 55 (2009) (minority views of Sens. Kyl, Feingold, and Coburn).

These concerns are reflected particularly clearly in the AIA provisions governing post-grant reviews, which permit patentability challenges on broader grounds than inter partes reviews. *See* 35 U.S.C. § 321(b). The relevant House committee cautioned against subjecting “the rights of inventors and patent owners against new patent challenges unbounded in time and scope.” H.R. Rep. No. 112-98, at 48. Accordingly, Congress required post-grant review petitions to be filed within nine months of a patent’s issuance to encourage “early challenges to patents” and “restore confidence in the presumption of validity that comes with issued patents in court.” *Id.* at 47-48; *see* 35 U.S.C. § 321(c). Although Congress did not impose a similar filing deadline for inter partes reviews, *see* 35 U.S.C. § 311(c), it would hardly be unconstitutionally irrational for the USPTO to consider these concerns in exercising its “broad and protected discretion not to launch an [inter partes review], even when the statutory preconditions are present.” *Apple II*, 166 F.4th at 1360; *cf.* 35

U.S.C. § 316(b) (requiring the Director to “consider the effect of any . . . regulation on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings instituted under this chapter” in prescribing regulations governing inter partes reviews).

Indeed, the Supreme Court has recognized that “classifications serving to protect legitimate expectation and reliance interests do not deny equal protection of the laws.” *Nordlinger v. Hahn*, 505 U.S. 1, 13 (1992). Thus, in *Nordlinger*, the Supreme Court upheld under rational-basis review a state tax regime that imposed lower property taxes on persons who had less recently acquired their properties. *Id.* at 11-14. Such a classification “rationally further[ed]” the state’s “legitimate[]” interest in protecting a property owner’s “vested expectations in his property.” *Id.* at 12-14 & n.5; see also *City of New Orleans v. Dukes*, 427 U.S. 297, 305 (1976) (per curiam) (upholding ban on newer street vendors because “[t]he city could reasonably decide that newer businesses were less likely to have built up substantial reliance interests in continued operation” than older businesses). The USPTO’s consideration of settled expectations similarly furthers a rational and legitimate purpose of protecting patent owners’ reliance interests.

Google’s remaining contentions are similarly flawed. Google asserts that consideration of the patentee’s settled expectations in deciding whether to institute inter partes reviews does not actually “provide patent owners with repose” because their patents can still be challenged in litigation or through ex parte reexamination.

Br. 43. This policy attack falls far short of identifying any constitutional concern. It is not irrational for the USPTO to consider—in deciding whether and how to allocate its resources to discretionary inter partes review proceedings—the effect of such a proceeding on the patentee’s rights, even if patent validity may also be challenged through other avenues. *Cf. Heller v. Doe*, 509 U.S. 312, 321 (1993) (explaining that an “imperfect fit between means and ends” does not “fail rational-basis review”).

Google also paradoxically speculates that consideration of a patent owner’s settled expectations will force putative infringement defendants to “file preemptive [inter partes review] petitions before litigation is even on the horizon.” Br. 47. As just explained, however, encouraging “early challenges” to patent validity is both rational and consistent with Congress’s intent in enacting the AIA. *See supra* pp. 32-34. And litigants sued for patent infringement remain “free to litigate” the asserted claims’ “validity in their own district court case” or seek ex parte “reexamination,” whether or not they seek (and the USPTO institutes) an inter partes review. *Apple II*, 166 F.4th at 1361 (alteration and quotation marks omitted).

At bottom, it is apparent that Google’s equal-protection challenge amounts to no more than an attempt to second-guess the USPTO’s policy judgments about how best to allocate its finite resources and the effects of its decisions on “the patent system and the economy.” Br. 53. But Congress expressly empowered the USPTO and its Director—not litigants or the judiciary—to balance these competing concerns. *See* 35 U.S.C. § 316(b). After all, the “agency is far better equipped than the courts to

deal with the many variables involved in the proper ordering of its priorities”—including “whether agency resources are best spent” on particular actions and whether a “particular enforcement action requested best fits the agency’s overall policies.” *Heckler*, 470 U.S. at 831-32. The USPTO and its politically accountable Director “bear[] the political responsibility of determining which [inter partes reviews] should proceed.” *Saint Regis Mohawk Tribe v. Mylan Pharms. Inc.*, 896 F.3d 1322, 1327 (Fed. Cir. 2018). “[E]qual protection is not a license for courts to judge the wisdom, fairness, or logic” of such decisions. *Beach*, 508 U.S. at 313.

III. Google Cannot Satisfy The Stringent Standard For Mandamus Relief

Google alternatively requests that this Court “constru[e] this appeal as a petition for mandamus” if it concludes that it lacks jurisdiction over Google’s direct appeal. Br. 37. But mandamus is a “drastic” remedy “to be invoked only in extraordinary situations.” *Kerr v. U.S. Dist. Ct. for N. Dist. of Cal.*, 426 U.S. 394, 402 (1976). Because mandamus “is one of the most potent weapons in the judicial arsenal, three conditions must be satisfied before it may issue.” *Cheney v. U.S. Dist. Ct. for D.C.*, 542 U.S. 367, 380 (2004) (citation and quotation marks omitted). A mandamus petitioner must show that (1) it has a “clear and indisputable” right to relief, (2) it has no “alternative avenues of relief,” and (3) “the writ is appropriate under the circumstances.” *Id.* at 379-81 (quotation marks omitted). Google cannot satisfy any of these requirements, let alone all three.

1. For all the reasons just given, Google has failed to show a clear and indisputable right to mandamus relief. Its equal-protection claim simply repackages in constitutional terms a “disagreement[]” with how the USPTO “applied” the statutes governing its discretion over institution, which “do[es] not present” a “reviewable challenge[.]” *Intel*, 2026 WL 506045, at *2. The agency’s decision reflects the kind of multi-factor discretionary judgment that cannot give rise to a clear and indisputable right to mandamus—particularly where the agency weighed considerations in both directions and reached a determination based on the “totality of the evidence and arguments” presented. Appx2-3. And even on its own terms, Google’s equal-protection challenge does not present even a “colorable” claim—let alone a meritorious one—that the USPTO’s decision here violates rational-basis review. *Mylan*, 989 F.3d at 1383; *see supra* pp. 29-36. At a minimum, Google fails to identify any “grave abuse of the [inter partes review] procedure” that could potentially warrant mandamus relief. *In re Power Integrations, Inc.*, 899 F.3d 1316, 1321 (Fed. Cir. 2018).

2. Google contends that it has “no other adequate” means of relief because if direct appeal is not available, mandamus is the only remaining mechanism to obtain “merits review of its [inter partes review] petition.” Br. 37 (quotation marks omitted). But the only harm Google asserts is the denial of one avenue for challenging patent claims. There is no question that there are other avenues for Google to pursue validity challenges, including in CSI’s pending infringement suit against Google or in ex parte reexamination. *See Apple II*, 166 F.4th at 1361. Google thus cannot carry its

burden to show that the alternatives are inadequate. In any event, the fact that the alternate relief available is not a party's preferred type does not make that relief inadequate or support a grant of mandamus. *See Fornaro v. James*, 416 F.3d 63, 69 (D.C. 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).

3. 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. Google's only asserted injury is an inability to challenge patent validity through its preferred avenue of an inter partes review. That interest is particularly minimal given that Google may still pursue its invalidity defenses in the district court litigation and file an ex parte reexamination request. *See supra* p. 37. The USPTO's denial of Google's inter partes review petitions triggers no estoppel effects, *see* 35 U.S.C. § 315(e), and leaves Google's “actual legal rights and obligations unchanged—what they would be if Congress had not enacted the [inter partes review] regime,” *Apple II*, 166 F.4th at 1361; *see also Cuozzo*, 579 U.S. at 294 n.6 (Alito, J., concurring in part and dissenting in part) (observing that a “patent challenger does not have nearly as much to lose from an erroneous *denial* of inter partes review” because “it remains free to challenge the patent's validity in litigation”).

On the other side of the ledger, granting mandamus relief here would hamstring the USPTO's ability to control its own resources and carry out agency

priorities. Google points to no case where this Court has ordered the USPTO to undertake an inter partes review that the agency declined to institute—thus requiring the USPTO to devote its finite resources to a discretionary administrative proceeding the agency would like to forgo. That is unsurprising, as Congress committed such decisions to the Director’s “unreviewable discretion.” *Arthrex*, 594 U.S. at 8-9. Google identifies no consideration that would make such an unprecedented judicial directive appropriate here.

CONCLUSION

For the foregoing reasons, this Court should dismiss Google’s appeal, or in the alternative, affirm the USPTO’s decision denying institution. This Court should deny Google’s request for a writ of mandamus.

Respectfully submitted,

Of Counsel:

AUSTIN P. MAYRON
Deputy Solicitor

ROBERT J. MCMANUS
Senior IP Legal Counsel

PETER J. SAWERT
BRIAN RACILLA
Associate Solicitors

SAIF M. ASKAR
Senior Legal Advisor

U.S. Patent and Trademark Office

BRETT A. SHUMATE
Assistant Attorney General
BRAD HINSHELWOOD

/s/ Samuel B. Goldstein
SAMUEL B. GOLDSTEIN
Attorneys, Appellate Staff
Civil Division, Room 7242
U.S. Department of Justice
950 Pennsylvania Avenue NW
Washington, DC 20530
(202) 514-0718
samuel.b.goldstein@usdoj.gov

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CERTIFICATE OF COMPLIANCE

This brief complies with the type-volume limit of Federal Circuit Rule 32(b)(1) because it contains 9727 words. This brief also complies with the typeface and type-style requirements of Federal Rule of Appellate Procedure 32(a)(5)-(6) because it was prepared using Microsoft Word in Garamond 14-point font, a proportionally spaced typeface.

/s/ Samuel B. Goldstein

Samuel B. Goldstein

ADDENDUM

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35 U.S.C. § 141

§ 141. Appeal to Court of Appeals for the Federal Circuit

(a) Examinations.—

An applicant who is dissatisfied with the final decision in an appeal to the Patent Trial and Appeal Board under section 134(a) may appeal the Board's decision to the United States Court of Appeals for the Federal Circuit. By filing such an appeal, the applicant waives his or her right to proceed under section 145.

(b) Reexaminations.—

A patent owner who is dissatisfied with the final decision in an appeal of a reexamination to the Patent Trial and Appeal Board under section 134(b) may appeal the Board's decision only to the United States Court of Appeals for the Federal Circuit.

(c) Post-Grant and Inter Partes Reviews.—

A party to an inter partes review or a post-grant review who is dissatisfied with the final written decision of the Patent Trial and Appeal Board under section 318(a) or 328(a) (as the case may be) may appeal the Board's decision only to the United States Court of Appeals for the Federal Circuit.

(d) Derivation Proceedings.—

A party to a derivation proceeding who is dissatisfied with the final decision of the Patent Trial and Appeal Board in the proceeding may appeal the decision to the United States Court of Appeals for the Federal Circuit, but such appeal shall be dismissed if any adverse party to such derivation proceeding, within 20 days after the appellant has filed notice of appeal in accordance with section 142, files notice with the Director that the party elects to have all further proceedings conducted as provided in section 146. If the appellant does not, within 30 days after the filing of such notice by the adverse party, file a civil action under section 146, the Board's decision shall govern the further proceedings in the case.

35 U.S.C. § 314

§ 314. Institution of inter partes review

(a) Threshold.—

The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

(b) Timing.—The Director shall determine whether to institute an inter partes review under this chapter pursuant to a petition filed under section 311 within 3 months after—

- (1) receiving a preliminary response to the petition under section 313; or
- (2) if no such preliminary response is filed, the last date on which such response may be filed.

(c) Notice.—

The Director shall notify the petitioner and patent owner, in writing, of the Director's determination under subsection (a), and shall make such notice available to the public as soon as is practicable. Such notice shall include the date on which the review shall commence.

(d) No Appeal.—

The determination by the Director whether to institute an inter partes review under this section shall be final and nonappealable.

35 U.S.C. § 318

§ 318. Decision of the Board

(a) Final Written Decision.—

If an inter partes review is instituted and not dismissed under this chapter, the Patent Trial and Appeal Board shall issue a final written decision with respect to the patentability of any patent claim challenged by the petitioner and any new claim added under section 316(d).

(b) Certificate.—

If the Patent Trial and Appeal Board issues a final written decision under subsection (a) and the time for appeal has expired or any appeal has terminated, the Director shall issue and publish a certificate canceling any claim of the patent finally determined to be unpatentable, confirming any claim of the patent determined to be patentable, and incorporating in the patent by operation of the certificate any new or amended claim determined to be patentable.

(c) Intervening Rights.—

Any proposed amended or new claim determined to be patentable and incorporated into a patent following an inter partes review under this chapter shall have the same effect as that specified in section 252 for reissued patents on the right of any person who made, purchased, or used within the United States, or imported into the United States, anything patented by such proposed amended or new claim, or who made substantial preparation therefor, before the issuance of a certificate under subsection (b).

(d) Data on Length of Review.—

The Office shall make available to the public data describing the length of time between the institution of, and the issuance of a final written decision under subsection (a) for, each inter partes review.

35 U.S.C. § 319

§ 319. Appeal

A party dissatisfied with the final written decision of the Patent Trial and Appeal Board under section 318(a) may appeal the decision pursuant to sections 141 through 144. Any party to the inter partes review shall have the right to be a party to the appeal.