

2026-1519, 2026-1520

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

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SEPTEMBER 23, 2026

TABLE OF CONTENTS

	Page
INTRODUCTION	1
ARGUMENT	2
I. This Court Has Jurisdiction Over This Appeal.....	2
A. Section 1295(a)(4)(A) Confers Jurisdiction Over All IPR Decisions To Which Section 314(d) Does Not Apply.....	3
B. Section 314(d) Does Not Apply To This Appeal	8
1. Section 314(d) Does Not Apply To Appeals That Raise Colorable Constitutional Claims	8
2. Google’s Equal Protection Claim Is A Colorable Constitutional Claim.....	16
C. Mandamus Is Warranted In Any Event	18
II. The PTO’s Denial Of Google’s IPR Petitions Violated Equal Protection	19
A. The PTO Denied Google’s Petitions Based On The Age Of The Challenged Patents	20
B. There Is No Rational Basis For The PTO’s Decision	22
CONCLUSION.....	29

TABLE OF AUTHORITIES

	Pages
Cases	
<i>Allegheny Pittsburgh Coal Co. v. Cnty. Comm’n of Webster Cnty.</i> , 488 U.S. 336 (1989).....	17, 28
<i>Allied Chem. Corp. v. Daiflon, Inc.</i> , 449 U.S. 33 (1980).....	14
<i>Arthrex, Inc. v. Smith & Nephew, Inc.</i> , 880 F.3d 1345 (Fed. Cir. 2018)	4-7, 9
<i>BioDelivery Scis. Int’l, Inc. v. Aquestive Therapeutics, Inc.</i> , 935 F.3d 1362 (Fed. Cir. 2019)	19
<i>Bread Pol. Action Comm. v. Fed. Election Comm’n</i> , 455 U.S. 577 (1982).....	3
<i>In re Cambridge Industries USA Inc.</i> , 2025 WL 3526129 (Fed. Cir. Dec. 9, 2025).....	17
<i>Cuozzo Speed Techs., LLC v. Lee</i> , 579 U.S. 261 (2016).....	12
<i>Engquist v. Or. Dep’t of Agric.</i> , 553 U.S. 591 (2008).....	16
<i>Hawkins v. United States</i> , 469 F.3d 993 (Fed. Cir. 2006)	3
<i>Heckler v. Chaney</i> , 470 U.S. 821 (1985).....	15
<i>Illinois v. Lidster</i> , 540 U.S. 419 (2004).....	9
<i>In re Intel Corp.</i> , 2026 WL 506045 (Fed. Cir. Feb. 24, 2026)	16, 17
<i>Johnson v. Robison</i> , 415 U.S. 361 (1974).....	9, 11-15

<i>Judulang v. Holder</i> , 565 U.S. 42 (2011).....	23
<i>Lackey v. Stinnie</i> , 604 U.S. 192 (2025).....	24
<i>Lepre v. Dep’t of Lab.</i> , 275 F.3d 59 (D.C. Cir. 2001).....	11-13, 15
<i>McNary v. Haitian Refugee Ctr., Inc.</i> , 498 U.S. 479 (1991).....	13-15
<i>Medrad, Inc. v. Tyco Healthcare Grp. LP</i> , 466 F.3d 1047 (Fed. Cir. 2006)	3
<i>In re Motorola Sols., Inc.</i> , 159 F.4th 30 (Fed. Cir. 2025)	10
<i>Mullin v. Doe</i> , 146 S. Ct. 2121 (2026).....	8
<i>Mylan Laboratories Limited v. Janssen Pharmaceutica, N.V.</i> , 989 F.3d 1375 (Fed. Cir. 2021)	4, 6-10, 14, 17, 18
<i>Nordlinger v. Hahn</i> , 505 U.S. 1 (1992).....	25-26, 28
<i>Nuclear Regul. Comm’n v. Texas</i> , 605 U.S. 665 (2025).....	7
<i>Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC</i> , 584 U.S. 325 (2018).....	27
<i>In re Plavix Mktg., Sales Pracs. & Prods. Liab. Litig. (No. II)</i> , 974 F.3d 228 (3d Cir. 2020)	10
<i>Reed v. Reed</i> , 404 U.S. 71 (1971).....	23
<i>Rotkiske v. Klemm</i> , 589 U.S. 8 (2019).....	24

<i>SAS Institute, Inc. v. Iancu</i> , 584 U.S. 357 (2018).....	13, 19
<i>SEC v. Chenery Corp.</i> , 318 U.S. 80 (1943).....	21
<i>St. Jude Medical, Cardiology Division, Inc. v. Volcano Corp.</i> , 749 F.3d 1373 (Fed. Cir. 2014)	4-7
<i>Thryv, Inc. v. Click-To-Call Techs., LP</i> , 590 U.S. 45 (2020).....	16, 17
<i>United States v. Sanchez-Gomez</i> , 584 U.S. 381 (2018).....	14
<i>Webster v. Doe</i> , 486 U.S. 592 (1988).....	12-15
<i>Woodward v. United States</i> , 871 F.2d 1068 (Fed. Cir. 1989)	13-15

Statutes

35 U.S.C.	
§ 141(c)	4, 5
§ 314(a)	12
§ 314(d)	<i>passim</i>
§ 319.....	4, 5, 6
§ 321(c)	23
§ 1295(a)(4)(A).....	<i>passim</i>

Miscellaneous

H.R. Rep. No. 112-98	24
<i>Maintaining a Speedy and Robust IPR Process Should Be a Major Focus of John Squires’ Patent Quality Efforts</i> , PatentlyO (June 6, 2025)	27
<i>Pedram Sameni, Patexia Chart 44 — 80 Percent of IPR Filings Are for Defensive Purposes</i> , Patexia (Nov. 8, 2017).....	26
S. Rep. No. 111-18 (2009).....	24

INTRODUCTION

According to CSI and the PTO (collectively, Appellees), Section 314(d) of the America Invents Act bars this Court from even considering appeals of blatant constitutional violations. Under Appellees' reading of the statute, the PTO may decline to institute an inter partes review (IPR) based on a protected characteristic (such as the race or sex of the petitioner) or based on a wholly arbitrary factor (such as a coin flip) and nevertheless require the petitioner to proceed under the demanding mandamus standard to obtain any relief. That cannot be right. Section 314(d) does not purport to—and does not—render colorable constitutional claims unreviewable by this Court. Appellees' arguments to the contrary overread this Court's cases and contradict established principles of reviewability and jurisdiction.

Appellees press these positions because they have not managed to articulate a rational basis for the “settled expectations” rule. For its part, CSI proposes post-hoc justifications for the PTO's denial of Google's IPR petitions that even the PTO does not invoke. Those arguments are irrelevant because the PTO's only proffered justification, which it continues to invoke today, is the age of the challenged patents. That distinction lacks a rational basis, and Appellees' putative policy justifications for the settled expectations rule ignore the realities of the patent system. The PTO's denial of Google's petitions should be vacated and the case should be remanded for reconsideration of those petitions on their merits.

ARGUMENT

I. This Court Has Jurisdiction Over This Appeal

The America Invents Act (AIA) grants this Court exclusive jurisdiction over all “appeal[s]” of PTO “decision[s]” “with respect to” “inter partes review[s].” 35 U.S.C. § 1295(a)(4)(A). It also renders “final and non-appealable” a subset of those decisions: “determination[s] by the Director whether to institute an inter partes review under this section.” 35 U.S.C. § 314(d). Whatever the scope of that jurisdictional bar, Section 314(d) says nothing about precluding review of constitutional claims—and therefore should be understood not to strip jurisdiction over such claims. Thus, because this appeal raises a colorable constitutional challenge to the PTO’s non-institution decisions, this Court has jurisdiction.

Appellees attempt to avoid this conclusion through two arguments. First, the PTO alone argues that Section 1295(a)(4)(A) does not confer jurisdiction over appeals of non-institution decisions on the theory that it confers jurisdiction only over the PTO’s final written decisions. Second, Appellees argue that Section 314(d) strips this Court of jurisdiction to consider appeals of all non-institution decisions—including decisions that violate the Constitution. Both arguments lack merit.

A. Section 1295(a)(4)(A) Confers Jurisdiction Over All IPR Decisions To Which Section 314(d) Does Not Apply

The PTO contends (at 26-29) that this Court lacks jurisdiction over any IPR decision that is not set forth in a final written decision—including the non-institution decisions at issue here. That claim finds no footing in the statute’s text or structure.

Section 1295(a)(4)(A)’s text clearly confers jurisdiction over *all* PTO decisions concerning IPR. When “construing a statute,” this Court “begin[s] with its literal text, giving it its plain meaning.” *Hawkins v. United States*, 469 F.3d 993, 1000 (Fed. Cir. 2006). And when “the words are unambiguous, no further inquiry is . . . required.” *Medrad, Inc. v. Tyco Healthcare Grp. LP*, 466 F.3d 1047, 1051 (Fed. Cir. 2006) (citation omitted). This is especially true of “[j]urisdictional statutes,” which “are to be construed with precision and with fidelity to the[ir] terms.” *Bread Pol. Action Comm. v. Fed. Election Comm’n*, 455 U.S. 577, 580 (1982) (citation omitted). Here, Section 1295(a)(4)(A) grants this Court “exclusive jurisdiction” over any “appeal from a decision of” “the Patent Trial and Appeal Board . . . with respect to . . . inter partes review.” By its plain terms, that jurisdictional grant applies to *all* IPR “decision[s],” including the PTO’s decision not to institute an IPR. Indeed, the PTO does not dispute that a non-institution is a “decision” “with respect to” IPR. Nothing more is required for the Court to conclude that this appeal falls within Section 1295(a)(4)(A)’s jurisdictional grant.

Given the breadth of Section 1295(a)(4)(A)’s text, the only limits on this Court’s jurisdiction over appeals from IPR decisions come from the AIA’s specific jurisdictional bars. The most important is Section 314(d), which, as discussed, deems the Director’s decision “whether to institute an [IPR] under [Section 314] . . . final and nonappealable.” 35 U.S.C. § 314(d). Accordingly, Section 1295(a)(4)(A) broadly confers jurisdiction over appeals of decisions concerning IPR, and Section 314(d) then renders some of those decisions unreviewable—though it does not preclude review of colorable constitutional claims, *see* Opening Br. 20-32.

The PTO’s contrary position (at 26-28) relies entirely on *St. Jude Medical, Cardiology Division, Inc. v. Volcano Corp.*, 749 F.3d 1373 (Fed. Cir. 2014), and *Mylan Laboratories Limited v. Janssen Pharmaceutica, N.V.*, 989 F.3d 1375 (Fed. Cir. 2021). But neither case can bear the weight the PTO gives it. On the contrary, both cases addressed how to read Section 1295(a)(4)(A) *in light of* Section 314(d)—not how to read Section 1295(a)(4)(A) in isolation. In fact, the PTO’s proposed rule—that Section 1295(a)(4)(A) provides jurisdiction only over appeals of “final written decisions”—was expressly rejected in *Arthrex, Inc. v. Smith & Nephew, Inc.*, 880 F.3d 1345 (Fed. Cir. 2018).

This Court first considered Section 1295(a)(4)(A)’s scope in *St. Jude*. There, the question was whether this Court had jurisdiction over an appeal of the PTO’s decision to deny an IPR petition based on Section 315(b)’s time bar. 749 F.3d at

1375. In a brief opinion, the Court first held that the non-institution decision was not a “final written decision” appealable under 35 U.S.C. § 319 or 35 U.S.C. § 141(c). *Id.* at 1375. It then held that review was precluded by Section 314(d) because the appeal concerned a “determination . . . whether to institute . . . under this section.” *Id.* at 1376. Finally, the Court held that Section 314(d), read in conjunction with the provisions authorizing appeals of final written decisions, carved out an exception to Section 1295(a)(4)(A)’s broad jurisdictional grant. *Id.* The Court’s decision that Section 1295(a)(4)(A) did not apply was thus based on its decision that Section 314(d) *did* apply.

Then, in *Arthrex*, this Court addressed Section 1295(a)(4)(A)’s scope in a case where Section 314(d) did *not* apply. There, a patent owner disclaimed patent claims following the filing of an IPR petition and then appealed the PTO’s issuance of a resulting “adverse judgment.” *Arthrex*, 880 F.3d at 1348. As in *St. Jude*, the PTO decision was not a “final written decision,” so it was not appealable under Section 319 or Section 141(c). *Id.* But unlike in *St. Jude*, Section 314(d) was not at issue because the adverse judgment had nothing to do with institution. *Id.* Nevertheless, the appellee argued that Section 1295(a)(4)(A) did not provide the Court with jurisdiction. *Id.*

This Court rejected that jurisdictional argument and held that Section 1295(a)(4)(A) confers jurisdiction even where there is no final written decision. The

Court began with the “general rule” that “judicial review is presumed to be available with respect to final agency action.” *Id.* It then explained that “the statutory appeal-bar” in Section 314(d) did not apply because the appeal did not involve an “institution decision.” *Id.* Accordingly, the Court concluded, Section 1295(a)(4) provided jurisdiction because the PTO’s decision was “with respect to . . . inter partes review.” *Id.* at 1348-49. The Court further explained that *St. Jude*’s jurisdictional holding was limited to those appeals that “fall within the ‘broadly worded bar on appeal’ under § 314(d).” *Id.* at 1349.

In *Mylan*, the Court confirmed *St. Jude*’s rule. There, as in *St. Jude*, an IPR petitioner appealed a decision by the PTO not to institute an IPR. 989 F.3d at 1377-78. And, as in *St. Jude*, the Court held that when put “together” with Section 314(d), Section 1295(a)(4)(A) did not confer jurisdiction over an appeal of a non-institution decision to which Section 314(d) applied. *Id.* at 1378-79. But *Mylan* did not walk back *Arthrex*’s rule that Section 1295(a)(4)(A) grants jurisdiction where Section 314(d) does *not* apply. And as discussed below, *Mylan* stated that Section 314(d) does not apply to appeals that raise colorable constitutional claims. *See infra* at 9.

The PTO’s contrary position is irreconcilable with those cases. The PTO makes the very argument (at 26) that the *Arthrex* Court rejected—that jurisdiction under Section 1295(a)(4)(A) (and any corresponding “right to appeal”) extends only to the limited appeal right in Section 319, which applies to “final written decisions.”

See Arthrex, 890 F.3d at 1348. But if the PTO is right, then *Arthrex* is wrong. *Arthrex* held that Section 1295(a)(4)(A) confers both the right to appeal and jurisdiction over an appeal that was clearly outside the bounds of Section 319. *See id.*¹ According to the PTO, there should have been no jurisdiction in that case. And the PTO ignores that *St. Jude* declined to hold that Section 314(d) “preclude[d] all review by any route” of non-institution decisions. 749 F.3d at 1376. If Section 1295(a)(4)(A) never conferred jurisdiction over such appeals, then that question would be irrelevant.

In contrast, Google’s position harmonizes the Court’s cases. Section 1295(a)(4)(A) broadly confers jurisdiction over appeals concerning IPR, but Section 314(d) then strips some (but not all) of that jurisdiction away. Thus, the Court lacks jurisdiction over appeals in which Section 314(d) and Section 1295(a)(4)(A) must be “[r]ead together,” like *Mylan* and *St. Jude*. *Mylan*, 989 F.3d at 1378. In cases where Section 314(d) does not apply, however, nothing “cabin[s] the appeal rights conferred by § 1295.” *Arthrex*, 880 F.3d at 1348.²

¹ *Arthrex* held that the “right to appeal” PTO decisions concerning IPR comes either “directly from § 1295 or in conjunction with § 704 of the APA.” 890 F.3d at 1348 n.1. To the extent the PTO seeks to separately argue that Google has no right to appeal, that too would contradict *Arthrex*.

² Because Section 1295(a)(4)(A) provides a jurisdictional basis for Google’s appeal, the Court need not address whether Google additionally can invoke “a right to equitable relief” because “no statutory relief [is] available.” *Nuclear Regul. Comm’n v. Texas*, 605 U.S. 665, 680 (2025); *see* PTO Br. 29.

B. Section 314(d) Does Not Apply To This Appeal**1. Section 314(d) Does Not Apply To Appeals That Raise Colorable Constitutional Claims**

Appellees maintain that Section 314(d) bars this Court from considering an appeal that raises a colorable constitutional challenge to a decision not to institute an IPR. In doing so, they give short shrift to the longstanding presumption that jurisdiction-stripping statutes do not apply to colorable constitutional claims. *See, e.g., Mullin v. Doe*, 146 S. Ct. 2121, 2137 (2026). The text of Section 314(d) does not come close to overcoming that presumption—and as a result neither this Court nor the Supreme Court has held that Section 314(d) applies to such claims. The PTO’s contrary position would mean that even if the Director declined to institute an IPR based on a suspect classification (like race or sex) or an arbitrary factor (like a coin flip), appeal would be unavailable. This Court should not accept that startling proposition.

The PTO (at 15) and CSI (at 10) primarily argue that this Court already held in *Mylan* that Section 314(d) applies to appeals involving colorable constitutional claims. According to the PTO, *Mylan* necessarily resolved the issue because the appellant “challenged [the PTO’s] decision on constitutional grounds” and this Court held that it “lacked jurisdiction over [the] appeal.” PTO Br. 15 (citing *Mylan*, 989 F.3d at 1377-79).

That argument ignores two critical aspects of *Mylan*. First, this Court expressly held in *Mylan* that the appellant “fail[ed] to state a colorable claim for constitutional relief.” 989 F.3d at 1383 (emphasis added). The Court therefore had no occasion to determine whether Section 314(d) applies to appeals involving colorable constitutional claims, and its decision should be “read . . . as referring in context to circumstances similar to the circumstances then before the Court and not referring to quite different circumstances that the Court was not then considering.” *Illinois v. Lidster*, 540 U.S. 419, 424 (2004). Indeed, in *Arthrex*, this Court emphasized that a “prior decision” about the scope of Section 314(d) “d[id] not ‘squarely address[]’” the jurisdictional issue before it and the Court was therefore “‘free to address the issue on the merits.’” 880 F.3d at 1349. Second, to the extent this Court addressed the issue in *Mylan*, it strongly suggested that Section 314(d) *does not* apply to appeals involving colorable constitutional claims. The Court stated that the “prohibition on appeal of [non-institution] decisions”—*i.e.*, Section 314(d)—bars “review[] of the Director’s exercise of his discretion to deny institution *except for colorable constitutional claims.*” *Mylan*, 989 F.3d at 1382 (emphasis added). In other words, the Court recognized that Section 314(d) does not contain the “‘clear and convincing’ evidence of congressional intent required” to bar review of colorable constitutional claims entirely. *Johnson v. Robison*, 415 U.S. 361, 373-74 (1974).

Accordingly, the PTO concedes (at 16) that Section 314(d) does not bar this Court from reviewing all constitutional challenges to non-institution decisions. Instead, it insists that *Mylan* limited such challenges to mandamus review because the discussion of Section 314(d) is in the portion of the opinion addressing the appellant’s mandamus petition. But “[j]udicial opinions are not statutes, from which we squeeze all we can out of every last word.” *In re Plavix Mktg., Sales Pracs. & Prods. Liab. Litig. (No. II)*, 974 F.3d 228, 235 (3d Cir. 2020). And as the PTO itself recognizes (at 17), the key takeaway from *Mylan* is that any limit on this Court’s jurisdiction to review non-institution decisions comes from “the language of § 314(d).” Nothing in the text of Section 314(d) differentiates between direct appeals and mandamus, so *Mylan*’s discussion of Section 314(d) should not be read as imposing such a limitation.³

Without *Mylan*, Appellees offer little argument that Section 314(d) can be read as barring review of colorable constitutional claims. The PTO contends that the text of Section 314(d) expressly bars review of such claims because it “specifies that the Director’s ‘determination . . . whether to institute an inter partes review’ is

³ The PTO observes (at 18) that this Court has subsequently said that “colorable constitutional claims” might be an “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). But the Court made that statement in denying a petition for mandamus. It therefore has no negative implications for direct appeals, which were not at issue.

‘final and nonappealable.’” PTO Br. 18-19 (alteration in original). But that selective quotation omits the key statutory phrase: Section 314(d) applies only to a “determination by the Director whether to institute an inter parties review *under this section*.” 35 U.S.C. § 314(d) (emphasis added). A jurisdiction-stripping provision that is limited to an officer’s decisions “under” a statute only bars claims challenging the officer’s “interpretation or application of a particular provision of the [relevant] statute to a particular set of facts.” *Johnson*, 415 U.S. at 367. Such a provision does not “rule out judicial review of constitutional challenges.” *Lepre v. Dep’t of Lab.*, 275 F.3d 59, 67 (D.C. Cir. 2001); *Johnson*, 415 U.S. at 373-74 (same).

The PTO’s attempts to distinguish *Lepre* and *Johnson* lack merit. According to the PTO (at 20), those cases did not involve challenges to decisions made “under” a statute—and therefore, the relevant jurisdiction-stripping provisions did not apply—because the challenges were to broad policies rather than individual agency decisions. By contrast, the PTO claims, a decision not to institute an IPR is a decision “under” Section 314. That argument fails because, like this case, both *Lepre* and *Johnson* involved challenges to specific agency decisions implementing a broader agency policy. In *Lepre*, the plaintiff argued that the agency’s application of a “mailbox presumption” to his “claim for disability benefits” violated due process. 275 F.3d at 61, 63. Similarly, in *Johnson*, the plaintiffs challenged the reliance on an agency policy to deny their “application[s] for educational

assistance.” 415 U.S. at 364. Those claims parallel Google’s claim, which is that the PTO’s application of its “settled expectations” rule to Google’s IPR petitions violates equal protection. Accordingly, as in *Lepre* and *Johnson*, Section 314(d)’s bar on appeals of the Director’s decisions “under” Section 314 “does not rule out judicial review of [Google’s] constitutional challenge[.]” *Lepre*, 275 F.3d at 67.

Appellees also suggest that—unlike the plaintiffs in *Lepre* and *Johnson*—Google is challenging the PTO’s decision “under” the relevant statute because every non-institution decision relies on the discretion granted by Section 314. PTO Br. 21; CSI Br. 9-10. Accordingly, they contend, every challenge to a non-institution decision raises “questions closely tied to the application and interpretation of” Section 314. But *Webster v. Doe*, 486 U.S. 592 (1988), forecloses that argument. In *Webster*, the Supreme Court held that, even where an “agency action is committed to agency discretion by law,” a party may challenge that action on constitutional grounds unless the statute expressly “preclude[s] consideration of colorable constitutional claims.” *Id.* at 592, 593. The fact that a statutory provision commits an officer’s decisions under the statute to his discretion does not mean that his decisions are immune from constitutional challenge.

Moreover, the Supreme Court has already recognized that the Director’s exercise of discretion under Section 314 is subject to judicial review. To be sure, Section 314(a) encompasses discretion by authorizing—but not “mandat[ing]”—the

institution of IPRs. *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 273 (2016). In combination with Section 314(d), Section 314(a) therefore gives the Director leeway to decline institution of IPRs even when the statutory predicates for institution are satisfied. But in *SAS Institute, Inc. v. Iancu*, 584 U.S. 357 (2018), the Supreme Court made clear that Section 314 does not “enable the agency to act outside its statutory limits,” and that “judicial review remains available” if the PTO engages in “shenanigans” that violate the law. *Id.* at 371. Accordingly, Appellees are incorrect that the Director’s non-institution decisions are *never* subject to judicial review, even when they involve “shenanigans” or, worse, a blatant constitutional violation. Otherwise, the Director would be able to make non-institution decisions based on entirely arbitrary considerations like a coin flip and his decisions would still be insulated from judicial review.

The PTO also asserts (at 22-23) that *Lepre* and *Johnson* are distinguishable because the statutes in those cases expressly barred both direct appeals and mandamus. According to the PTO (*id.*), because “mandamus remains available,” the presumption of reviewability for constitutional claims is inapplicable to Section 314(d). That argument ignores the numerous cases in which courts have applied the presumption of reviewability notwithstanding the availability of mandamus as a backstop. *See, e.g., Webster*, 486 U.S. at 603; *Woodward v. United States*, 871 F.2d 1068, 1072 (Fed. Cir. 1989); *McNary v. Haitian Refugee Ctr., Inc.*, 498 U.S. 479,

497 (1991). In each of those cases, mandamus was available, and the court still held that the jurisdiction-stripping statutes at issue had to be construed narrowly to account for the background presumption that constitutional claims are reviewable. *See McNary*, 498 U.S. at 497-98. That is unsurprising because mandamus relief is “discretionary” and available only in “exceptional circumstances.” *United States v. Sanchez-Gomez*, 584 U.S. 381, 390 (2018); *Allied Chem. Corp. v. Daiflon, Inc.*, 449 U.S. 33, 35 (1980). Mandamus is therefore no substitute for a direct appeal.

The PTO erroneously contends (at 19-20) that *Webster* and *Woodward* are inapplicable because neither case “involved an express judicial-review bar.” That argument runs counter to the federal government’s usual position that the APA provision exempting actions “committed to agency discretion”—the provision at issue in *Webster*—categorically renders those actions “immune from judicial review.” *See, e.g., Br. for Appellees 24, Louis Brandeis Ctr., Inc. v. Dep’t of Educ.* No. 25-5363 (D.C. Cir. June 22, 2026). In any event, this Court has itself recognized *Webster* and *Woodward* as paradigmatic examples where review of constitutional claims was available despite an express bar on review of other claims. *See Mylan*, 989 F.3d at 1382.

The PTO’s position regarding mandamus also defies common sense. According to the PTO, statutes barring both direct appeals and mandamus should be interpreted as allowing full appellate review of constitutional claims, whereas

statutes (like Section 314(d)) that do not expressly bar mandamus should be interpreted as channeling constitutional claims to mandamus review. There is no principle of interpretation that supports reading a broader bar on review to have a broader exception, and the PTO cites none—let alone an example of another provision that operates this way. That is unsurprising because a jurisdiction-stripping statute can be read as applying to constitutional claims only if an “explicit provision . . . bars judicial consideration of . . . constitutional claims.” *Johnson*, 415 U.S. at 367. So if a statute does not contain such a provision, it simply does not apply to constitutional claims—whether raised on direct appeal or mandamus. That is why courts have uniformly interpreted general bars on judicial review not to apply to colorable constitutional claims. *See id.*; *Lepre*, 275 F.3d at 67; *Webster*, 486 U.S. at 603; *Woodward*, 871 F.2d at 1072; *McNary*, 498 U.S. at 497.

Finally, the PTO argues (at 24) that § 314(d) must bar review of Google’s equal protection claims because they are “peculiarly within” the PTO’s “expertise.” But the PTO’s reliance on *Heckler v. Chaney*, 470 U.S. 821 (1985), is misplaced. That case concerned prosecutorial discretion, *id.* at 838, which is different in kind from an institution decision. And even in *Heckler*, the Court said that “[n]o colorable claim” was made that “the agency’s refusal to institute proceedings violated any constitutional rights”—so the Court did “not address the issue that would be raised in such a case.” *Id.*

2. Google’s Equal Protection Claim Is A Colorable Constitutional Claim

It is a bedrock principle of equal protection that the government cannot draw classifications without a rational basis. *Engquist v. Or. Dep’t of Agric.*, 553 U.S. 591, 601 (2008). Accordingly, Google’s argument that the PTO violated equal protection by arbitrarily classifying IPR petitions based on the age of the challenged patents is a colorable constitutional claim. Opening Br. 32-37.

Both CSI (at 18) and the PTO (at 24-25) contend that Google’s challenge is a “statutory interpretation question[] dressed up as [a] constitutional issue” on the theory that Google is challenging the PTO’s exercise of discretion under Section 314. But *every* equal protection challenge is a claim that the government exercised its statutory authority in an arbitrary or irrational way. Opening Br. 36. It does not follow that every provision barring statutory challenges to an agency’s discretionary exercise of statutory authority also bars equal protection claims. The fact that the PTO lacks express authority to consider patent age simply shows that the PTO has not attempted to ground its decision in anything besides its general discretion to deny IPR petitions—and for that reason, Google cannot be challenging the PTO’s “application and interpretation of statutes related to [its] decision to initiate inter partes review.”” *Thryv, Inc. v. Click-To-Call Techs., LP*, 590 U.S. 45, 53 (2020).

Both CSI (at 18-20) and the PTO (at 24-25) also assert that this Court’s decisions in *In re Intel Corp.*, 2026 WL 506045 (Fed. Cir. Feb. 24, 2026), and *In re*

Cambridge Industries USA Inc., 2025 WL 3526129 (Fed. Cir. Dec. 9, 2025), demonstrate that Google’s equal protection claim is not a colorable constitutional claim. Neither case is relevant here. *Cambridge Industries* involved a due process challenge to a non-institution decision. 2025 WL 3526129, at *2. But this Court had previously held in *Mylan* that a non-institution decision does not implicate a protected property interest, so “any procedural due process challenge” was “foreclosed.” *Mylan*, 989 F.3d at 1383. And as Google has explained (Opening Br. 35), the equal protection claim in *Intel* was in essence a challenge to the PTO’s application of § 315(d) and thus sought review of the PTO’s “interpretation of [a] statute[] related to [its] decision to initiate inter partes review.” *Thryv, LP*, 590 U.S. at 53.

Google’s equal protection claim is distinct from both of those challenges. Because Google does not raise a procedural due process challenge, it has no need to identify a protected property interest that the PTO has infringed; instead, the absence of any justification for the PTO’s actions suffices to establish the constitutional violation. *Allegheny Pittsburgh Coal Co. v. Cnty. Comm’n of Webster Cnty.*, 488 U.S. 336, 344 (1989). And unlike in *Intel*, Google’s challenge to the PTO’s actions is completely divorced from the PTO’s application of any statute. As explained above, there is no statute that addresses denying an IPR petition based on the age of the challenged patents. *See supra* at 12. Accordingly, neither case stands in the way

of this Court considering Google’s “colorable claim for constitutional relief.” *Mylan*, 989 F.3d at 1383.

C. Mandamus Is Warranted In Any Event

Even if the Court concludes it lacks jurisdiction over Google’s direct appeal, it should grant Google’s request for mandamus. The PTO’s arguments fail to rebut Google’s entitlement to that relief.

First, the PTO says (at 37) that a “multi-factor discretionary judgment” cannot give rise to a clear and indisputable right to relief. But the challenged PTO decisions identify only a *single* factor to justify non-institution: the PTO’s sole explanation for why it discretionarily denied institution as to the ’972 and ’954 patents but allowed the ’853 patent to proceed to a merits determination was the difference in the age of the patents.

Next, the PTO argues (at 37-38) that IPR petitioners can litigate their patents in court. But this argument proves too much. If this were correct, the PTO could expressly deny IPR petitions based on a suspect classification like race, and petitioners would have no right to seek any relief even through mandamus. Moreover, the right Google seeks to vindicate is not the right to the invalidation of CSI’s patents. Rather, it is the right to have the IPR petitions considered without regard to a wholly arbitrary factor—the age of the patents that Google is challenging. That right cannot be enforced in any forum but this one.

Finally, the PTO says (at 38-39) that the writ is inappropriate under these circumstances because granting Google mandamus would hamstring the PTO's ability to control its resources. But the PTO is not entitled to conserve resources by drawing arbitrary, constitutionally invalid lines between IPR petitioners. The PTO's assertion that there is no case where a court has ordered the PTO to undertake IPR misses the point. Google is not seeking a court order mandating institution, but rather asks only that the PTO reconsider Google's IPR petitions while complying with federal law.

This Court has ordered that very relief before. For example, after the Supreme Court's decision in *SAS Institute*, this Court vacated several PTO decisions and remanded cases for the PTO to consider whether to institute IPRs as to all the challenged claims or to decline to institute as to all of them. *See, e.g., BioDelivery Scis. Int'l, Inc. v. Aquestive Therapeutics, Inc.*, 935 F.3d 1362 (Fed. Cir. 2019). This Court's power to remand to the PTO under those circumstances is "beyond debate." *Id.* at 1368 (Newman, J., dissenting). There is thus no question that the relief Google seeks is both available and appropriate.

II. The PTO's Denial Of Google's IPR Petitions Violated Equal Protection

The PTO barely contests that it denied Google's petitions based purely on the age of the challenged patents, and the Court should take the PTO at its word. With

the basis of the PTO's actions established, Appellees' halfhearted attempts to justify the settled expectations rule cannot withstand scrutiny.

A. The PTO Denied Google's Petitions Based On The Age Of The Challenged Patents

CSI rewrites history (at 7, 15-16) by asserting that the PTO's denial of Google's petitions was based on a "holistic assessment" of evidence, such as the fact that the '972 and '954 patents are not in the same family as the '853 patent and supposedly implicate different "knowledge issues." The PTO has never suggested this rationale had any bearing on its non-institution decisions—and this Court need not consider CSI's hypothetical and post hoc justifications.

Instead, as Google has explained, this case is the perfect vehicle for assessing the validity of the settled expectations rule because the age of the challenged patents was the only specific reason provided for the denial of Google's petitions. *See* Opening Br. 41. The PTO's decision first acknowledged that several factors counseled in favor of granting IPR as to all three patents. Appx2. But then the PTO drew a line: The '853 patent "ha[d] not been in force for a significant amount of time" because it was "issued in 2021," Appx2., whereas the '972 and '954 patents "present[ed] different circumstances" because they had "been in force for seven and six years, respectively, creating settled expectations for Patent Owner." Appx2. Because of that difference in patent age, the PTO concluded that Google had not

“provide[d] persuasive reasoning why an *inter partes* review is an appropriate use of Board resources” for the ’972 and ’954 patents. Appx2.

It is long-settled that an agency’s actions “cannot be upheld” on grounds other than those “upon which the agency acted in exercising its powers.” *SEC v. Chenery Corp.*, 318 U.S. 80, 95 (1943). And the PTO does not deny that its decision as to the ’972 and ’954 patents was based on those patents’ age. Just the opposite: far from embracing CSI’s hypothetical justifications for differential treatment, the PTO doubles down on the age-based rationale in this Court. *See* PTO Br. 31-32. The Court should therefore accept the PTO’s representation that it classified Google’s IPR petitions based on the age of the challenged patents and resolve the question whether that classification lacks a rational basis. CSI’s alternative reasons why the PTO could have reached the same conclusion have no basis in the agency’s action and should be disregarded.

For the same reasons, the Court should reject CSI’s arguments (at 16-17) based on isolated instances where the PTO has instituted IPRs involving older patents. While the PTO’s regular practice of declining to institute IPRs based on patent age underscores the pernicious effects of the settled expectations rule that was applied here, Google’s equal protection claim is based on the arbitrary line that was drawn in *this* case. And the PTO’s brief reiterates that line, stating that the Director denied the IPR petitions as to the ’954 and ’972 patents because those patents “had

been in force for a longer period of time,” while the IPR petition as to the ’853 patent was allowed to proceed because it was a comparatively “early challenge.” PTO Br. 31-32.

Cases where different lines might have been drawn are therefore irrelevant. Google need not show that any of those other petitions were denied based on settled expectations, or that the PTO will continue to apply the settled expectations rule in the same way forever. Rather, Google need only show that the PTO denied *Google’s* petitions based on the age of the challenged patents and that the classification applied here lacked a rational basis.

B. There Is No Rational Basis For The PTO’s Decision

Appellees fail to justify the settled expectations rule. The PTO’s argument that it can deny IPR petitions based on any classification if doing so conserves Board resources misunderstands its obligations under equal protection principles to draw classifications on a rational basis. And the other justifications Appellees propose are disconnected from the realities of the patent system.

The PTO argues (at 31-32) that its denial of Google’s petition based on the age of the challenged patents comports with equal protection because it was aimed at balancing “workload needs” and conserving “Board resources.” That argument misunderstands basic principles of equal protection—the Constitution does not allow the PTO to conserve resources by discriminating or acting arbitrarily.

Under black-letter law, regardless of how many IPRs the PTO decides to institute based on resource constraints, the lines that the PTO draws between petitions that it accepts and petitions that it denies cannot be arbitrary. It is the *classification* that requires justification, not the non-institution decision. And every government classification “must be reasonable, not arbitrary, and must rest upon some ground of difference having a fair and substantial relation to the object of the legislation.” *Reed v. Reed*, 404 U.S. 71, 76 (1971). The PTO’s position implies that it could discretionarily deny IPR petitions based on a coin flip to conserve “Board resources” by dividing the number of petitions to be considered in half. *But see Judulang v. Holder*, 565 U.S. 42, 56 (2011). Equal protection forbids that government action—the Board’s decision to grant or deny an IPR petition cannot be wholly arbitrary.

Once again, the distinction between the ’853 patent on one hand and the ’972 and ’954 patents on the other highlights the issue. Any arguments about the PTO’s efficient use of Board resources apply equally to all three patents: denying any of them would save Board resources, and instituting any of them would require the expenditure of Board resources. But the PTO discretionarily denied Google’s petition as to the six- and seven-year-old patents and not as to the four-year-old patent. That classification based on patent age demonstrates that the conservation of Board resources cannot alone justify the settled expectations rule.

The PTO is also wrong that the AIA’s text, structure, or history supports the settled expectations rule. First, the nine-month window for post-grant review cannot justify the PTO’s newly manufactured six-year window for IPRs. PTO Br. 33 (citing 35 U.S.C. § 321(c)). If anything, the express time bar for post-grant reviews underscores that Congress chose *not* to include a similar time bar for IPRs and that the PTO’s decision to just now make one up is arbitrary. Indeed, courts regularly rely on existing statutory procedures as evidence that an agency’s newly created statutory procedures are *not* permitted. *See, e.g., Lackey v. Stinnie*, 604 U.S. 192, 205 (2025) (stating that “supplementation” of a statutory scheme is “particularly inappropriate” when “Congress has shown that it knows how to adopt the omitted language or provision” but chose not to (quoting *Rotkiske v. Klemm*, 589 U.S. 8, 14 (2019))). Accordingly, the PTO’s reliance on the nine-month window for post-grant review gets it exactly backwards.

The PTO’s reliance on legislative history is similarly misguided. The PTO first cites (at 32-33) a House Committee report acknowledging “the importance of quiet title to patent owners.” But that same paragraph notes how Congress chose to accomplish that “purpose of the [AIA]”: “providing quick and cost effective alternatives to litigation” through processes like IPR. H.R. Rep. No. 112-98, pt. 1, at 48 (2011). The PTO additionally attempts to rely on a Senate report that accompanied an unenacted bill from two years earlier, explaining the problems with

the system that the AIA replaced. PTO Br. 33 (citing S. Rep. No. 111-18, at 55 (2009)). To the extent this report shows anything, it is that the PTO is attempting to unravel Congress’s solution to those problems.

Appellees also argue that the settled expectations rule “protect[s] legitimate expectation and reliance interests.” PTO Br. 34. But as Google has explained (Opening Br. 42-46), the settled expectations rule is directly contrary to those interests. Congress enacted the AIA and created the IPR system to allow both patent challengers and patent owners to quickly, efficiently, and inexpensively resolve questions about the validity of patents. *Id.* at 44. The alternative—litigating all aspects of a patent’s validity as a defense to infringement actions in district court—is worse by every measure. *Id.* at 44-45. Litigating patent validity in district court takes longer and costs more for both patent challengers *and* patent owners. These concerns were front-and-center when the AIA was drafted. *Id.* at 44.

For that reason, the PTO’s reliance (at 34) on *Nordlinger v. Hahn*, 505 U.S. 1 (1992), is inapposite. In *Nordlinger*, the Supreme Court addressed a California taxation regime that levied a higher tax rate on more recently purchased properties. *Id.* at 6. The Court rejected an equal protection challenge to the law, holding that it was rational for two reasons. First, the law furthered “local neighborhood preservation, continuity, and stability” by “discourag[ing] rapid turnover in ownership of homes.” *Id.* at 12. Second, the law protected the “reliance interest” of

the long-term homeowner. *Id.* at 13. As the Court explained, every new home purchaser would have “full information” about the tax rate that would be applied to them at the time of their purchase, and they could “decide not to complete the purchase” if the rate were too high. *Id.* By contrast, long-term homeowners might be forced to “sell [their] home[s]” or forgo purchasing “food, clothing, and other necessities” if their tax burdens increased dramatically year after year. *Id.*

The rational concerns that animated the California legislature in *Nordlinger* carry no weight here. First, the settled expectation rule does not create a system of “continuity and stability”—it merely funnels patent validity challenges back into district court litigation. Opening Br. 43-44. Patents are overwhelmingly challenged through IPR only when a patent owner invokes those patents in an infringement suit. Pedram Sameni, *Patexia Chart 44 — 80 Percent of IPR Filings Are for Defensive Purposes*, Patexia (Nov. 8, 2017), <https://tinyurl.com/259k85wv>. And the settled expectations rule will not prevent defendants from challenging the validity of the asserted patents as a defense in those infringement suits. In other words, patent validity will continue to be litigated, just at a higher cost and in a less efficient manner. Opening Br. 44.

The settled expectations rule also does not protect the “reliance interests” that the Court invoked in *Nordlinger*. Here, it is patent owners suing for infringement who are operating with “full information.” Patents are, and always have been, a

“public franchise[],” *Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC*, 584 U.S. 325, 335 (2018), and their validity has been subject to challenge since the earliest days of the patent system, Opening Br. 42. Indeed, the entire patent system is built around the availability of patent challenges. As Google has explained, the PTO’s limited resources mean that a substantial proportion of patent applications are erroneously granted. *Id.* at 54. Currently, almost 40% of litigated patents are at least partially invalidated. *Maintaining a Speedy and Robust IPR Process Should Be a Major Focus of John Squires’ Patent Quality Efforts*, PatentlyO (June 6, 2025), <https://perma.cc/A4S4-Y5ZN>. And as just explained, patent owners do not expect IPR challenges to happen preemptively, early in the patent term; instead, IPR petitions are generally filed only after a patent owner initiates litigation against an alleged infringer. *See supra* at 26.

CSI’s reference (at 21) to IPR petitioners’ “delay” in bringing challenges after they gain “knowledge of [the] patent” is thus irrational. As Google has explained, there are likely hundreds of thousands of invalid patents. Opening Br. 54-55. But most of those patents are not challenged because doing so costs money, and the patents do not matter until a patent owner alleges infringement. *Id.* at 47. The alternative Appellees imagine is an economic impossibility: billions of dollars of preemptive patent litigation concerning largely irrelevant patents. *Id.* at 47-48. The

PTO's suggestion that patent owners have the same expectations of permanence that owners of real property have in their homes simply blinks reality.

For those reasons, this case is less like *Nordlinger* and more like *Allegheny Pittsburgh Coal Co. v. County Commission of Webster County*, 488 U.S. 336 (1989), which involved a taxation scheme that violated the Equal Protection Clause. As the Court explained in *Nordlinger*, the tax scheme in *Allegheny Pittsburgh* was invalid because there was no “indication that the [stated] policies . . . could conceivably have been the purpose for the . . . scheme.” *Nordlinger*, 505 U.S. at 14-15. The same is true here. Finality, reliance interests, and commercial expectations cannot conceivably be the purpose of the settled expectations rule because patents remain subject to challenge.

In sum, the settled expectations rule violates equal protection because it does not further the PTO's claimed interests and there is no indication that those interests motivated the rule in the first place. Although the Constitution permits the PTO to treat different petitioners differently, it demands that the line drawn between them correspond to a rational and legitimate governmental purpose. The settled expectations rule fails that test.

CONCLUSION

The Court should vacate the PTO's decisions declining to institute IPR as to the '954 and '972 patents and direct the PTO to reconsider Google's petitions without adhering to the settled expectations rule.

Dated: September 23, 2026

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

I certify that this Motion complies with the type-volume limitation of Fed. R. App. P. 27(d)(2)(A). This Reply brief contains 6,764 words, excluding the parts of the Motion exempted by Fed. R. App. 27 (d) and Fed. Cir. R. 27(d). This Motion complies with the typeface requirements of Fed. R. App. P. 32(a)(5) and the type style requirements of Fed. R. App. 32(a)(6). This Motion has been prepared in a proportionally spaced typeface using Microsoft Word in 14-point Times New Roman font.

/s/ Elizabeth B. Prelogar
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CERTIFICATE OF SERVICE

I hereby certify that on September 23, 2026, I filed or caused to be filed the foregoing with the Clerk of the United States Court of Appeals for the Federal Circuit via the CM/ECF system and served or caused to be served a copy on all counsel of record by the CM/ECF system.

/s/ Elizabeth B. Prelogar
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