

No. 25-1230

IN THE
Supreme Court of the United States

GOOGLE LLC,

Petitioner,

v.

VIRTAMOVE, CORP., *et al.*,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED
STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

**BRIEF OF US*MADE, THE ALLIANCE FOR
AUTOMOTIVE INNOVATION, THE HIGH TECH
INVENTORS ALLIANCE, THE COMPUTER &
COMMUNICATIONS INDUSTRY ASSOCIATION,
THE SOFTWARE & INFORMATION INDUSTRY
ASSOCIATION, AND NATIONAL RETAIL
FEDERATION AS *AMICI CURIAE*
IN SUPPORT OF PETITIONER**

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QUESTION PRESENTED

The America Invents Act (AIA) authorizes administrative proceedings for the review of the validity of issued patents. The Act authorizes post-grant review, in which a patent may be challenged on all validity grounds during the period between the patent’s issuance and “the date that is 9 months after th[at] date.” 35 U.S.C. § 321(c). It authorizes *inter partes* review, in which a patent may be challenged on printed prior art grounds during the period “after the later of . . . the date that is 9 months after the grant of a patent” or “the termination of [an instituted] post-grant review.” *Id.* § 311(c). The Act prohibits the filing of a petition for *inter partes* review “more than 1 year after the date on which [the challenger] is served with a complaint alleging infringement of the patent.” *Id.* § 315(b). And the Act estops further challenges to a patent by either the petitioner in a completed review or its “real party in interest or privy.” *Id.* §§ 315(e), 325(e).

The Act also states that a review “may not . . . be instituted unless” these conditions are met, *id.* §§ 314(a), 324(a), and it provides that the decision “whether to institute a . . . review” is “final and nonappealable.” *Id.* §§ 314(d), 324(e).

The question presented by this case is whether the latter two provisions render all the other statutory provisions described here merely advisory and optional for the agency to follow—that is, may the Patent Office redefine the temporal scope of the patents that may be challenged in AIA proceedings, may it impose a shorter filing deadline than that provided by § 315(b), and may it apply an estoppel to third parties that are unrelated to the petitioner in the completed proceeding?

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Adam Lidgett, Industry Groups Want Trump Admin To Stop PTAB Changes, Law360, Nov. 4, 2025.....	19
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Cited Authorities

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INTEREST OF AMICI CURIAE

The U.S. Manufacturers Association for Development and Enterprise is a nonprofit association representing companies manufacturing diverse goods in the United States.¹

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

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

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

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

National Retail Federation is the world's largest retail trade association, representing retailers of all sizes, formats, and channels of distribution and spanning all industries.

1. Per this Court's Rule 37.2, counsel for the parties were timely notified of amici's intention to file this brief. No counsel for a party wrote any part of this brief and no one other than amici made a monetary contribution in relation to the brief. Although Google is a member of several amici, it did not participate in the decision to file this brief.

Amici's member companies are frequent targets of assertions of improperly issued patents and make routine use of the post-issuance review proceedings authorized by the America Invents Act.

SUMMARY OF ARGUMENT

The USPTO makes a breathtaking claim of authority: that it can literally rewrite the terms of its enabling statute. Post grant review is available by law for patents during the first “9 months after” the “grant of the patent,” 35 U.S.C. § 321(c), and *inter partes* review is available “after the later of . . . 9 months after the grant” or “termination of [a] post-grant review.” *Id.* § 311(c). Patents last for 20 years and are enforceable for another six years after they expire. Since Congress enacted the America Invents Act in 2011, the USPTO had understood that *inter partes* review is available for the entirety of this period of enforceability (“after” the availability of post-grant review).

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

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

The USPTO continues to apply this rule today, albeit without explaining its actions. Several months ago, in an admitted attempt to evade judicial review, the agency switched to a practice of summarily denying *inter partes* and post-grant review petitions, without providing any explanation at all for its decisions.

“Settled expectations” is not the only way in which the USPTO has abused the supposed “unreviewability” of its institution decisions and policies. It has invoked the same immunity from review to shorten a statutory deadline that was the subject of intra-house congressional negotiations on the AIA; to extend estoppel to third parties that are unrelated to (and unaware of) prior proceedings—far beyond statutory and due-process privity limits; and to broaden the assignor-estoppel defense that this Court recently narrowed.

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

The lower court’s decision would afford the USPTO discretion to ignore the statutory framework—all based on a statute that never actually uses the word “discretion.” The decision would also unsettle longstanding understandings of the many other federal statutes that use the same formulation the Federal Circuit now interprets as the source of boundless discretion. And

most fundamentally, when Congress enacts a reticulated statutory scheme—with limited safety valves—it cannot plausibly be understood to have intended that these statutory standards and rules would be treated as merely optional for the agency to follow.

ARGUMENT

I. The USPTO’s actions violate its authorizing statute and are dismantling the congressionally enacted system of patent validity review.

It would be hard to overstate the violence that the USPTO’s leadership has done to America Invents Act patent reviews during the past year.

On June 18, 2025, the agency announced and began applying the rule at issue in this case: that once a certain number of years have passed since a patent has issued, the patent owner acquires “settled expectations” that the patent’s validity cannot be challenged in AIA proceedings.³

A patent’s term runs twenty years from its filing date⁴ and a patent can be enforced for up to six years after it has expired.⁵ Prior to the USPTO’s adoption of the “settled expectations” rule, the agency had followed the statutory framework:⁶ it allowed patents to be challenged

3. *See Dabico Airport Solutions Inc v. AXA Power ApS*, IPR2025-00408 (Jun. 18, 2025).

4. *See* 35 U.S.C. § 154(a)(2).

5. *See* 35 U.S.C. § 286.

6. *See* 35 U.S.C. §§ 321(c), 311(c).

in post-grant reviews during the first nine months after their issuance, and in *inter partes* reviews throughout the remainder of the time that the patent can be enforced.⁷

The USPTO has not stated how old a patent must be before “settled expectations” attach,⁸ but in practice, the rule appears to be six years. In the months after the rule was announced, the USPTO denied 201 petitions for *inter partes* review based on “settled expectations.”⁹ Amici are aware of only a handful of cases in which a petition challenging a patent that was more than five years old was able to overcome this new bar.¹⁰

7. See USPTO, PTAB Trials: Inter Partes Review, available at <https://perma.cc/9KGM-3UTL>; *Apple Inc. v. Gesture Technology Partners, LLC*, 127 F.4th 364, 368-69 (Fed. Cir. 2025) (affirming that “the Board has jurisdiction over [*inter partes* reviews] concerning expired patents”).

8. See *Dabico*, *supra* n.3 (“Although there is no bright-line rule on when expectations become settled, in general, the longer the patent has been in force, the more settled expectations should be.”).

9. See Appendix of Denied PTAB Petitions, available at <https://perma.cc/87GY-NLXK>.

10. See Jones, F., Unpacking the PTAB’s Patent Age Denial Doctrine Data, Aug. 29, 2025, available at <https://perma.cc/M65X-UCW9> (“For patents six years and older, the vast majority has settled expectations supporting denial. Conversely, for patents four years and younger, almost all supported referral for an institution decision. For five-year-old patents, the decisions remain split.”) (analyzing 249 petition decisions). Thus the rule is sometimes arbitrarily applied to deny review of patents that are less than six years old. See, e.g., *Kahoot! AS v. Interstellar Inc.*, IPR2025-00696 (Jul. 31, 2025).

In *Intel Corp. v. Proxense LLC*,¹¹ the USPTO provided “guidance” that older patents can be reviewed despite “settled expectations” if the petitioner either identifies “a significant change in the law” or shows that the patent was never “commercialized” or “licensed.”¹² As one commentator has noted, however, these exceptions “have proven to be largely ineffective in practice.”¹³ The latter exemption appears to have been successfully invoked only three times,¹⁴ and the “change in the law” proviso even less¹⁵—*amici* are not aware of *any* case in which it has been applied to allow PTAB review of a utility patent that is more than five years old.¹⁶

11. IPR2025-00327 (Jun. 26, 2025).

12. *Id.*

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

14. *See id.*

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

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

Thus as a practical matter, under the USPTO’s “settled expectations” rule, a patent’s validity cannot be contested in an AIA review once the patent is six years old. Notably, the *average* age of all the patents that have been challenged in an *inter partes* review in the nearly decade and a half since the AIA was enacted is 6.7 years.¹⁷ About half of these challenged patents would have been immune from review under the USPTO’s new rule.¹⁸

The 201 *inter partes* review petitions that were expressly rejected by the USPTO based on “settled expectations” were all denied between June 18, 2025, and October 17, 2025. After this period, the USPTO did not suspend its application of this rule—instead, it simply stopped providing *any* explanation of its decisions to reject AIA petitions. In September 2025, in response to court challenges to the legal justifications for the USPTO’s new rules, agency officials stated that they “could just issue one-word decisions denying review without explanation.”¹⁹ In a subsequent policy memorandum, the USPTO Director followed through on this threat: he announced that he will personally decide each PTAB petition, and if he “determines that institution is not appropriate, whether based on discretionary considerations, the merits, or other non-

17. *See* DeFosse, J., Data Undermines USPTO’s “Settled Expectations” Doctrine, Law360, Aug. 29, 2025.

18. *See id.*

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

discretionary considerations, the Director will issue a summary notice denying institution.”²⁰

The first such summary denials were issued on October 31, 2025. On that date, 13 separate petitions for *inter partes* review—each of which included up to 14,000 words of legal analysis and was accompanied by a \$23,750 nonrefundable filing fee—were summarily denied in a notice that simply listed the docket numbers of the petitions. Here is what these notices look like:

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

Trials@uspto.gov
571-272-7822

Paper 14
Date: October 31, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

NOTICE OF DECISIONS ON INSTITUTION

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

NOTICE

Pursuant to 35 U.S.C. § 314(a), institution of *inter partes* review is
denied in the following proceedings¹:

IPR2025-01014
IPR2025-01105
IPR2025-01106
IPR2025-01114
IPR2025-01117
IPR2025-01118
IPR2025-01137
IPR2025-01139
IPR2025-01154
IPR2025-01166
IPR2025-01167
IPR2025-01221
IPR2025-01240

¹ See Memorandum entitled "Director Institution of AIA Trial Proceedings."
Available at [https://www.uspto.gov/sites/default/files/documents/
Director_Institution_of_AIA_Trial_Proceedings.pdf](https://www.uspto.gov/sites/default/files/documents/Director_Institution_of_AIA_Trial_Proceedings.pdf).

Since this initial batch of summary denials, the USPTO has summarily denied an additional 302 petitions for *inter partes* and post-grant review for what it has designated as “discretionary” reasons. No further explanation has been provided by the agency as to why it denied these petitions.

In addition to “settled expectations,” the USPTO has invoked the unreviewability of its decisions to impose several other procedural rules in the past year that override the AIA’s statutory framework and make review proceedings inaccessible for broad classes of litigation defendants.

Section 315(b) of the Patent Act sets a one-year deadline for seeking patent validity review at the PTAB once infringement litigation has commenced: “An *inter partes* review may not be instituted if the petition . . . is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent.” 35 U.S.C. § 315(b).

Congress specifically chose a one-year deadline to ensure that litigation defendants would have a reasonable opportunity to seek review once they have been sued—indeed, this time limit was one of the last issues to be resolved in the final negotiations on the AIA. The bill that first passed the Senate in 2011 would have set this deadline at six months.²¹ The House, however, extended the period to one year. The Senate then acceded to this change, and

21. See S.23, America Invents Act, 112th Congress (2011), § 5 (proposed 35 U.S.C. § 315(b)).

it was codified in the final law. When the bill returned to the Senate, the bill managers explained why they agreed to the change: they concluded that it was “appropriate to extend the section 315(b) deadline to one year” in order to “afford defendants a reasonable opportunity to identify and understand the patent claims that are relevant to the litigation,” especially “in light of the present bill’s enhanced estoppels.”²²

One might think that once Congress has negotiated and enacted a deadline for filing a validity-review petition that runs one year from when litigation is served, that statutory deadline would control the question of whether the petition is timely in relation to the litigation. On February 28, 2025, however, the USPTO adopted a rule that an *inter partes* review petition is untimely and will be “discretionarily denied,” with no exceptions, if the timing of its filing is such that the district court case will likely go to trial before the review is completed.²³

22. 157 Cong. Rec. S5429 (daily ed. Sep. 8, 2011).

23. The USPTO had adopted a version of this rule in 2020, see *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019 (Mar. 20, 2020), but in response to public outcry, it soon created an exception to the rule providing that a petition would *not* be denied if the petitioner stipulated that it would not raise any invalidity grounds in district court that it could have raised in the *inter partes* review. See *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019 (Dec. 1, 2020). This approach was later formalized in a June 21, 2022, memorandum. See USPTO, Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings With Parallel District Court Litigation, Jun. 21, 2022, available at <https://perma.cc/ZN92-T3SN>. During the 2020 to 2025 period, the stipulation exception to the time-to-trial rule was more or less absolute: petitioners are aware of only one case in which a set of petitions was denied despite the entry

On March 28, 2025, the USPTO began applying this new deadline retroactively to petitions that had been filed the previous year.²⁴ Between that date and October 17, 2025, the USPTO denied at least 280 *inter partes* and post-grant review petitions based on this new time limit.²⁵ And again, the USPTO did not suspend its application of this rule after October 2025—it simply stopped providing any explanation at all for its petition decisions.

In practice, this new time-to-trial rule overwhelmingly bars patent defendants from seeking validity review if they have been sued in the Eastern District of Texas. Under the AIA and its implementing regulations, an *inter partes* review is scheduled to be completed 18 months after the petition is filed.²⁶ The USPTO has concluded, however, that the average time to trial in the Eastern District of Texas is about 22 months²⁷—which means that once a defendant is sued there, it has only four months to prepare and file a petition under the USPTO’s new time-to-trial rule. Of the 280 petitions that have been expressly denied under this rule, 217 petitions—about 77%—have been denied

of such a stipulation. Under the approach adopted by the USPTO in March 2025, however, stipulations no longer provide any relief from the new time-to-trial rule.

24. See *Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, -01206, -01207, -01208 (Mar. 28, 2025).

25. See Appendix, *supra* n.9, at 6.

26. See 37 C.F.R. § 42.107(b); 35 U.S.C. § 314(b); *id.* § 316(a)(11).

27. See *Charter Commc’ns, Inc. v. Adaptive Spectrum and Signal Alignment, Inc.*, IPR2024-01379, at 9-11 (Apr. 17, 2025); *Dell Inc. v. Universal Connectivity Techs., Inc.*, IPR2024-01479, -01478, at 5-6 (Apr. 7, 2025).

because of copending litigation in the Eastern District of Texas.²⁸ In effect, the *plaintiff's* choice of litigation venue determines whether the *defendant* can seek validity review at the USPTO.

The agency's new time-to-trial rule also bars review based on the timing of a copending investigation at the International Trade Commission. Such investigations are expedited—they usually are completed in less than 18 months.²⁹ Thus although only a limited number of these proceeding are filed each year,³⁰ in 2025 they accounted for the denial of 25 *inter partes* review petitions. Notably, the USPTO bars review based on ITC proceedings despite the fact that such investigations lack the authority to cancel invalid patent claims or to preclude their enforcement in district court.³¹

28. For this and other reasons, this district is a favorite venue of non-practicing patent plaintiffs, who usually acquire their patents on the secondary market and whose patents tend to be of low quality. The Eastern and Western Districts of Texas account for two-thirds of all non-practicing patent plaintiff litigation in the United States. *See* Unified Patents, Patent Dispute Report: Q3 in Review, Oct. 9, 2025, available at <https://www.unifiedpatents.com/insights/2025/10/9/patent-dispute-report-q3-2025-in-review>.

29. *See* USITC, Section 337 Statistics: Average Length of Investigations (updated Feb. 3, 2026), available at https://www.usitc.gov/intellectual_property/337_statistics_average_length_investigations.htm.

30. *See* USITC, Section 337 Statistics: Number of New, Completed, and Active Investigations By Fiscal Year (updated Feb. 3, 2026), available at https://www.usitc.gov/intellectual_property/337_statistics_number_new_completed_and_active.htm.

31. *See Hyosung TNS Inc. v. ITC*, 926 F.3d 1353, 1358 (Fed. Cir. 2019).

Another provision of the Patent Act estops the petitioner in a completed *inter partes* or post-grant review from challenging the same patent claims in a future judicial or administrative proceeding.³² This statutory estoppel is applied to the petitioner and to its “real parties in interest and privies.”³³ As this Court has noted, while it would ordinarily violate due process “to bind litigants to a judgment rendered in an earlier litigation to which they were not parties,”³⁴ “there is an exception when it can be said that there is ‘privity’ between a party to the second case and a party who is bound by an earlier judgment.”³⁵ The Court of Appeals has recognized that Congress consciously adopted these common-law exceptions to the due-process limits on third party estoppel when it incorporated the words “privity” and “real party in interest” into the America Invents Act.³⁶

On May 2, 2025, however, the USPTO implemented and began applying a new rule that if a patent’s validity is challenged in any forum by any party, all other parties are thereafter estopped from challenging the patent in an AIA

32. See 35 U.S.C. §§ 315(e), 325(e).

33. *Id.*

34. *Richards v. Jefferson County, Ala.*, 517 U.S. 793, 794 (1996).

35. *Id.* at 798; see also Fed. Prac. & Proc. § 4448 (“Exceptions to the rule that nonparties cannot be bound were traditionally expressed by statements that a judgment is binding on parties and persons in ‘privity’ with them.”).

36. See *Wi-Fi One, LLC v. Broadcom Corp.*, 887 F.3d 1329, 1335, 1336 (Fed. Cir. 2018).

proceeding.³⁷ This new estoppel extends to third parties with no relationship at all to the earlier challenger, and includes third parties who were first sued—or even first learned of the patent—years after the earlier proceedings had been completed. During 2025, the USPTO denied at least 21 petitions based on this new third-party estoppel.³⁸ It has even applied the new rule to deinstitution a petition that was filed in June 2023 and that had already resulted in a final written decision that claims are invalid.³⁹

The USPTO also has adopted and applied several other extra-statutory rules to bar petitions for AIA review. For example, despite the fact that the Court of Appeals has determined that equitable defenses such as assignor estoppel do not apply in *inter partes* and post-grant reviews,⁴⁰ and despite the fact that this Court has narrowed the scope of assignor estoppel,⁴¹ the USPTO has begun applying the pre-2021 version of assignor estoppel to bar petitions for AIA review.⁴²

37. See *Verizon Connect Inc. v. Omega Patents LLC*, IPR2023-01162 (May 2, 2025).

38. See Appendix, *supra* n.9, at 10.

39. See *Verizon Connect Inc v. Omega Patents LLC*, IPR2023-01162 (Jun. 3, 2025).

40. See *Arista Networks, Inc. v. Cisco Systems, Inc.*, 908 F.3d 792, 803-04 (Fed. Cir. 2018).

41. See *Minerva Surgical, Inc. v. Hologic, Inc.*, 594 U.S. 559, 576-77 (2021).

42. See Appendix, *supra* n.9, at 11.

By amici’s count, since March 28, 2025, the USPTO has denied 770 petitions for *inter partes* or post-grant review for non-statutory “discretionary” reasons.

Every single one of these petitions cost over \$100,000 to prepare and file. Virtually all of them were an important part of the petitioner’s defense to an allegation of patent infringement.⁴³ And all these petitions have now been denied because of ad hoc rules that not only are contrary to the statutory framework, but in most cases did not even exist when the petitions were filed.

In the past, the institution rate for AIA proceedings was consistently about 67% and almost all petition denials were based on the evidentiary merits.⁴⁴ But since October 2025, the petition institution rate has plummeted to 25%.⁴⁵ Unsurprisingly, “[t]he number of America Invents Act petitions [filed has] continued to crater . . . as [these]

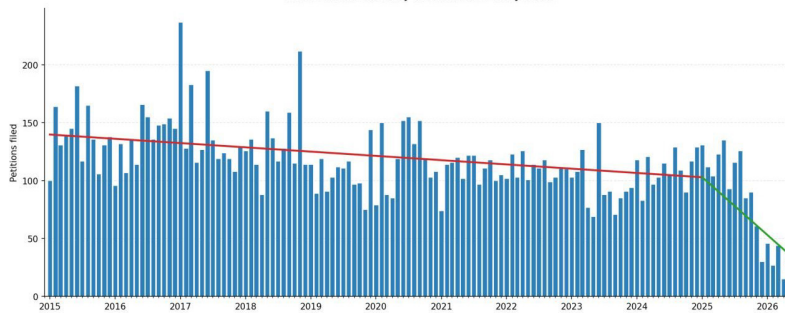
43. The vast majority of AIA review petitions are filed in response to litigation over the asserted patents. *See* PTAB Parallel Litigation Study June 2022, available at <https://perma.cc/8KJV-V5WY> (noting that 80% or more of PTAB petitioners have been sued by the patent owner prior to the filing of their petition). In amici’s experience, the bulk of the remaining petitions arise from situations in which litigation has either been threatened or is otherwise highly likely.

44. *See* PTAB Trial Statistics: 2025 End of Year Outcome Roundup, slide 7, available at <https://perma.cc/2NAR-9LGK>; Wilson Sonsini, 2023 PTAB Year in Review, at 2, available at <https://perma.cc/77D8-SLGU>.

45. *See* Theresa Schliep, Squires Snubs 10 IPRs While 4 Pass Muster In Latest Order, Law360, April 29, 2026.

policies . . . [have] settled in”⁴⁶ and it has become clear that the USPTO has “effectively shut down *inter partes* review for most filers.”⁴⁷ The following chart, which tracks all petitions filed since 2015, illustrates the recent decline in filings:⁴⁸

IPR Petitions Filed by Month, 2015-May 2026



“Practitioners have done the math: if [*inter partes* review] petitions are denied at the front end regardless of merit, the cost-benefit calculus no longer works.”⁴⁹ By administrative fiat, the congressionally enacted system of patent validity review has been “functionally suspended.”⁵⁰

46. Theresa Schliep, PTAB Petitions Continue To Plummet As Reexams Surge, Law360, April 17, 2026.

47. Dennis Crouch, Borrowing from the Board: District Court Obviousness in the Post-IPR Era, May 21, 2026, available at <https://perma.cc/UAC8-CNGX>.

48. See Dennis Crouch, Inter Partes Review in 2026, May 24, 2026, available at <https://perma.cc/QE34-RUTC>.

49. *Id.*

50. *Id.*

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

As a result of the USPTO’s retroactive application of its new PTAB rules, there are now *hundreds* of patent-infringement lawsuits going forward in the United States in which the defendant prepared and filed a PTAB petition challenging the validity of the asserted patent, but the agency refused to consider the petition on its merits.⁵¹

There is no need to speculate as to the likely consequences of the USPTO’s actions; recent experience shows us exactly what will happen. During 2020, when the USPTO experimented with an earlier version of its time-to-trial rule,⁵² the rule was applied retroactively to bar review of a series of patents that had been asserted against Intel Corporation. During the next two years, two of those patents, after “discretionary” denial of review by the agency, went to trial and resulted in \$2.3 billion in damages awards against Intel to VLSI Technology LLC, a non-practicing entity controlled by Fortress Investment Group, which is owned by financial interests in Abu Dhabi.⁵³

51. Historically, the Board has found a “reasonable likelihood” that a patent is invalid and institutes review for about two-thirds of petitions and then found all claims invalid in a final written decision for about 65% of those instituted petitions. *See* PTAB Trial Statistics: 2025 End of Year Outcome Roundup, slides 7, 11, *supra* n.44.

52. *See generally supra* n.23.

53. *See* Reuters, Intel loses U.S. patent trial, ordered to pay \$2.18 billion to VLSI Tech, Mar. 2, 2021; Britain Eakin, Intel Hit

The next year, however, the USPTO allowed *other* entities to challenge the same patents, on the same grounds that Intel had tried to present—and concluded that all the challenged claims are invalid as obvious.⁵⁴

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

And again, this experience is now being repeated in hundreds of lawsuits across the country—cases in which frequently hundreds of millions, and at times billions, of dollars are at stake. As a broad coalition of businesses recently warned, “[i]f these Patent Office policies remain unchecked, they will lead to a systematic looting of the American industrial economy.”⁵⁵

With \$949M Verdict In Latest VLSI Patent Fight, Law360, Nov. 5, 2022.

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

55. See Adam Lidgett, Industry Groups Want Trump Admin To Stop PTAB Changes, Law360, Nov. 4, 2025.

Nevertheless, the Federal Circuit has determined that defendants that are sued on invalid patents do not suffer any prejudice from the USPTO’s arbitrary restrictions on access to AIA reviews—even when these rules are applied retroactively—because a defendant remains free “to properly raise its patentability defenses elsewhere.”⁵⁶

AIA reviews, however, are the *only* contested proceedings in which an issued patent can be evaluated by the USPTO’s technical experts. Courts have long recognized the benefits of applying such expertise to the difficult scientific questions that often arise in patent cases.⁵⁷

And more fundamentally, it is Congress itself that decided that the opportunity to raise validity defenses during infringement litigation is not enough. Although civil litigation over patent validity has always been available, since 1980, Congress has authorized—and

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

57. *See, e.g., Cochrane v. Deener*, 94 U.S. 780, 784 (1876) (“Neither courts nor ordinary juries are perfectly adapted to the investigation of mechanical and scientific questions”—“it would, perhaps, be desirable if all cases of this sort could be referred to a commission of intelligent experts and practical men”); *Parke-Davis & Co. v. H. K. Mulford Co.*, 189 F. 95, 115 (C.C.S.D.N.Y. 1911) (Hand, J.) (noting the challenges of ruling on a chemical patent case “without any knowledge of even the rudiments of chemistry,” and suggesting the creation of a tribunal of “technical judges to whom technical questions are submitted”); the Honorable Alan D Albright, U.S. District Judge (W.D. Tex.) (“[N]ever, ever, ever, ever, ever offer an obviousness argument to a jury,” as the jury will not understand it.) (quoted in Dani Kass, *What Judges Want You to Know: Litigate Smarter*, Law360, Feb. 11, 2025).

repeatedly reenacted and refined—post-issuance review at the USPTO.⁵⁸ The proceedings serve the “important congressional objective” of applying the USPTO’s expertise to “revisit and revise earlier patent grants,” *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 272 (2016), thereby addressing “overpatenting and its diminishment of competition.” *Thryv, Inc v. Click-To-Call Techs., LP*, 590 U.S. 45, 54 (2020).

III. The statutory framework for patent-validity reviews is not merely advisory or optional for the agency to follow.

Section 314—“the section housing the command to the Director to ‘determine whether to institute,’” *Thryv*, 590 U.S. at 57—does not actually use the word “discretion.” The Court of Appeals has nevertheless identified unbounded discretion in the statute because its institution-threshold determination is stated in the negative—the Director “may not authorize an *inter partes* review to be instituted . . . unless [the merits threshold is met].” 35 U.S.C. § 314(a). Because of this language, the Federal Circuit has concluded that “the Director is . . . *never* compelled[] to institute [review].” *Mylan Labs. Ltd. v.*

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

Janssen Pharm., N.V., 989 F.3d 1375, 1382 (Fed. Cir. 2021) (emphasis added). Under this construction, the law merely sets a floor that can be revised upward—the agency has discretion to impose conditions more demanding than those that Congress enacted.

A. The Federal Circuit’s interpretation would wreak havoc with other federal statutes.

The “may not . . . unless” statutory formulation is hardly unique to the America Invents Act. Many other federal statutes that establish rules for agencies to follow employ the same language. And particularly when these statutes set rules for regulating private parties’ conduct or proceedings, it should be obvious that Congress did *not* intend that its codified criteria for agency decisionmaking would serve as a mere polite suggestion to the agency.

Several statutes use this formulation to set rules for an agency to apply when regulating the licensure of various businesses and professions. The words “may not . . . unless” govern the application of the statutory standards that determine who may operate the businesses of providing passenger transportation between maritime ports,⁵⁹ processing or catching fish,⁶⁰ providing certain

59. *See* 46 U.S.C. § 55103(a) (“A vessel may not transport passenger between ports or places . . . unless”); *see also id.* § 40901(a).

60. *See* 46 U.S.C. § 4503(a) (“A vessel to which this subsection applies may not be operated unless”); *see also* 16 U.S.C. § 5503(a) (“No high seas fishing vessel shall engage in harvesting operations on the high seas unless”).

telecommunication or information services,⁶¹ broadcasting low-power television signals,⁶² operating an insured State bank,⁶³ originating loans,⁶⁴ or selling motor vehicles.⁶⁵ The same statutory formulation also governs whether health-care professionals under military jurisdiction may work in their professions.⁶⁶

The persons regulated under these statutes may believe that their right to pursue their livelihoods is determined by the conditions established in the statutes. Under the Federal Circuit's construction, however, the regulating agency "is never compelled" to allow them to do so. *Mylan*, 989 F.3d at 1382. The agencies would be free to elevate the statutory requirements or to impose

61. *See* 47 U.S.C. § 272(a)(1) ("A Bell operating company (including any affiliate) which is a local exchange carrier that is subject to the requirements of section 251(c) of this title may not provide any service described in paragraph (2) unless").

62. *See* 47 U.S.C. § 336(f)(7) ("The Commission may not grant a class A license . . . unless").

63. *See* 12 U.S.C. § 1831a ("an insured State bank may not engage as principal in any type of activity that is not permissible for a national bank unless").

64. *See* 12 U.S.C. § 5103(a) ("an individual may not engage in the business of a loan originator without first").

65. *See* 49 U.S.C. § 30112(a)(1) ("a person may not manufacture for sale, sell, offer for sale, introduce or deliver for introduction in interstate commerce, or import into the United States, any motor vehicle or motor vehicle equipment . . . unless").

66. *See* 10 U.S.C. § 1094(a)(1) ("A person under the jurisdiction of the Secretary of a military department may not provide health care independently as a health-care professional under this chapter unless").

additional conditions—a fishing vessel, for example, could also be required by the agency to pay for and carry a government-certified third-party observer to ensure compliance with the agency’s rules—regardless of what the statute says.

Persons facing federal or state criminal punishment may also find themselves at a disadvantage under the Federal Circuit’s interpretive approach. Such persons may believe that they can appeal their conviction or sentence upon making “a substantial showing of the denial of a constitutional right,”⁶⁷ but the relevant statutes’ use of “may not . . . unless” would indicate, per the decision below, that this is only a floor—other conditions may also be imposed on the right to appeal.⁶⁸

Private landlords could find that they are never allowed to increase rents;⁶⁹ candidates for office that they can never use campaign funds to travel by air;⁷⁰ certain overseas tort claimants could never seek relief;⁷¹

67. 28 U.S.C. § 2253(c)(2).

68. *See id.* § 2253(c)(1) (“Unless a circuit justice or judge issues a certificate of appealability, an appeal may not be taken to the court of appeals from . . . the final order in a habeas corpus proceeding [challenging State or Federal detention]”).

69. *See* 42 U.S.C. § 1490j (“The Secretary may not approve any increase in rental payments . . . unless”).

70. 52 U.S.C. § 30114(c)(1) (“a candidate for election for Federal office . . . or any authorized committee of such a candidate, may not make any expenditure for a flight on an aircraft unless”).

71. *See* 7 U.S.C. § 2262a(b) (“A claim may not be allowed under this section unless”).

and customer claims could never be subordinated in bankruptcy⁷²—all because Congress gave an agency or tribunal discretion to depart from statutory standards by using the words “may not . . . unless.”

The same statutory wild card even applies to other aspects of intellectual-property law. The Copyright Claims Board would *never* be required to entertain a claim⁷³ and the USPTO would never be required to allow a patent applicant to claim priority to its provisional application⁷⁴ under the Federal Circuit’s statutory construction.

If the decision below is correct, then all these statutes vest their administrators with unbridled power over the American people. For all these statutory schemes to operate within the specified legal constraints—as was obviously intended—then only the decision below need be wrong.

72. 11 U.S.C. § 747 (“unless all other customer net equity claims have been paid in full, the trustee may not pay . . . any net equity claim of a customer”).

73. 17 U.S.C. § 1505(a) (“A claim or counterclaim alleging infringement of an exclusive right in a copyrighted work may not be asserted before the Copyright Claims Board unless”); *id.* § 1504(b)(1) (“A proceeding may not be maintained before the Copyright Claims Board unless”).

74. *See* 35 U.S.C. § 119(e)(2) (“A provisional application filed under section 111(b) may not be relied upon in any proceeding in the Patent and Trademark Office unless”).

B. *Inter partes* review’s statutory safety valve confirms that broad “resources” discretion was not intended by Congress.

The USPTO has suggested that “resource constraints” compel it to arbitrarily restrict access to AIA reviews.⁷⁵ That justification is inconsistent with the structure Congress established. The statute itself requires the agency to set fees for the proceedings that are adequate to cover the “aggregate costs” of conducting the reviews.⁷⁶ There is no question that the fees that the USPTO has been collecting have been sufficient for this purpose.

Moreover, AIA proceedings are not enforcement proceedings in which the agency investigates and prepares its case. They are adjudicative proceedings in which the *petitioner* develops the evidence and brings the case to the agency—the PTAB simply decides whether the petitioner has met its burden of proof. There can be no dispute that the USPTO *can* address the merits of every PTAB petition that is presented to it—it *did* address the merits of almost every petition prior to the agency’s recent enthusiasm for “discretionary denials.”

Finally, the statute itself provided a resources safety valve during the initial years of standing up the proceedings. Titled “Graduated Implementation,” this provision authorized the Director to “impose a limit on the number of inter partes reviews that may be instituted . . . during each of the first 4 1-year periods [that the

75. *See, e.g.*, USPTO Brief in Federal Circuit Appeal No. 2025-148, at 32.

76. *See* 35 U.S.C. §§ 311(a), 321(a).

proceedings] are in effect.”⁷⁷ The fact that Congress enacted this provision—which was never used and expired in 2016—confirms that it did not understand the AIA to otherwise vest the Director with unlimited authority to impose extra-statutory restrictions on access to AIA proceedings.

CONCLUSION

The petition for certiorari should be granted.

Respectfully submitted,

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⁷⁷. AIA, Pub. L. No. 112-29, § 6(c)(2)(B).