SUPREME COURT
OF THE UNITED STATES

IN THE SUPREME COURT OF THE UNITED STATES

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THRYV, INC., FKA DEX MEDIA, INC.,)

Petitioner,)

v.) No. 18-916

CLICK-TO-CALL TECHNOLOGIES, LP,)

ET AL.,)

Respondents.)

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Washington, D.C.

Monday, December 9, 2019

The above-entitled matter came on for oral argument before the Supreme Court of the United States at 11:05 a.m.

APPEARANCES:

ADAM H. CHARNES, ESQ., Dallas, Texas;

on behalf of the Petitioner.

JONATHAN Y. ELLIS, Assistant to the Solicitor General, Department of Justice, Washington, D.C.;

on behalf of the federal Respondent, supporting reversal.

DANIEL L. GEYSER, ESQ., Dallas, Texas;

on behalf of the private Respondent.

C O N T E N T S

P R O C E E D I N G S

(11:05 a.m.)

CHIEF JUSTICE ROBERTS: We'll hear argument next in Case 18-916, Thryv Incorporated versus Click-To-Call Technologies.

Mr. Charnes.

ORAL ARGUMENT OF ADAM H. CHARNES

ON BEHALF OF THE PETITIONER

MR. CHARNES: Mr. Chief Justice, and may it please the Court:

The text of the America Invents Act, the statutory history, the statute's policy goals, and this Court's decision in Cuozzo all confirm that Section 314(d) precludes judicial review of the director's time-barred determination under Section 315(b).

Begin with the text of the statute. Congress drafted the appeal bar to apply to "the determination whether to institute an inter partes review under this section." Congress could have written Section 314(d) to review only the determination whether there was a reasonable likelihood that the petition -- petitioner would prevail, but Congress wrote the provision more broadly to apply to the institution decision as

a whole.

Further, Section 314 itself instructs the director to look beyond that section in making the institution determination in at least two ways. First, subsection (b) instructs the director to "determine whether to institute an inter partes review under this chapter." And more expressly, subsection (a) tells the director to consider the patent owner's response in determining whether to institute review. And Section 313 says the patent owner in that response can present reasons explaining why the petition fails to meet any requirements of the chapter.

In other words, the text of the statute makes clear that the institution determination occurs under Section 314 based on the prerequisites in the entire chapter. And because subsection (d) provides the institution determination cannot be judicially reviewed, the agency's application of those prerequisites located elsewhere in the chapter cannot be appealed, including Section 315(b).

Now the statutory history confirms this reading. Congress knew how to limit the

appeal bar just to the preliminary patentability determination. That is, after all, how it wrote the similar -- the analogous limits on judicial review for ex parte reexaminations in former Section 312 and inter partes reexaminations in Section 313.

The inter partes reexamination statute, former 312, although now repealed, is particularly instructive. Like with IPRs, Congress included several prerequisites to institution in former Section 311. But, when it wrote the appeal bar, it wrote it narrowly focused on "the determination under subsection (a)."

Subsection (a) contained the preliminary patentability standard, which is a substantial new question of patentability. That -- by writing it that way, Congress excluded from the appeal bar the agency's determination of the statutory prerequisites. With the America Invents Act, however, Congress broadened the appeal bar in Section 314(d) to apply to the institution decision as a whole.

And this deliberate drafting decision essentially refutes Respondents' reading of the

statute. This reading -- our reading of the statute is also confirmed by this Court's decision in Cuozzo.

Now Cuozzo dealt with a prerequisite to institution that was not in 314(a). It was in 312(a)(3), the particularity requirement. Nonetheless, this Court held that it was subject to the -- the Board's assessment of -- the particularity requirement was subject to the appeal bar in Section 314(d).

And it's important to focus on what the Court explained -- why the Court explained it was subject to that. The Court said the appeal bar applies to two different things. It applies to the preliminary patentability determination in 314(a). That is the Board's assessment about whether it was reasonably likely that the petitioner would prevail. And it also applied, this Court said in Cuozzo, to statutes that are closely related to the institution decision.

And in our view, Section 315(b) is by definition closely related to the institution decision. After all, 315(b) begins with the words "an inter partes review may not be

instituted if."

JUSTICE KAVANAUGH: Cuozzo had a part that, of course, responded to concerns that have been raised, I -- I think in the dissent, and says we -- our interpretation does not enable the agency to act outside its statutory limits, for example; such shenanigans may be properly reviewable and focused really on the narrow issue before it. So how do we take into account that language from the decision?

MR. CHARNES: Right. Well, the question is -- what the Court explained in Cuozzo was, for example, if the Board vacated -- invalidated a patent on grounds that were beyond the scope of an IPR, that that would be a shenanigan that -- that could be reviewed. That's a merits decision. That's a step two decision. That's not an institution decision.

And I think it's important to focus on the fact -- on really the limited nature of Section 315(b) within the statutory scheme. 315(b) is not a merits determination. 315(b) is not a statute of repose, as it's traditionally understood. Instead, it's a limited forum selection provision.

And it's a limited forum selection provision in two different ways.

JUSTICE GORSUCH: But, Mr. Charnes, let's -- let's -- just to follow up on this, let's just hypothesize that someone has tried to undo this patent four times or maybe even more in a court of law, failed for various reasons every single time, and then comes to the director of patents, who has a political mission, perhaps, to kill patents, let's just say. And it is clearly time-barred under the statute. Let's just hypothesize that. And yet, the director goes ahead and does it anyway.

Under your submission to the Court, I believe you're saying that is a shenanigan this Court cannot review.

MR. CHARNES: Well, I think it would be -- it's correct that our submission is that's not reviewable. The time bar is not reviewable and not immediate --

JUSTICE GORSUCH: You just disagree that it's a shenanigan?

MR. CHARNES: Well, I'm not sure exactly what the Court meant in a shenanigan. As we pointed out in our brief, shenanigan -- I

think it was a good-faith application by the Board of the legal standard, and I think --

JUSTICE GORSUCH: I'm asking you in my hypothesis.

MR. CHARNES: Yes.

JUSTICE GORSUCH: All right. The hypothesis, there's no good faith, okay? The director of patent has a political desire for whatever reason to destroy this patent and many others.

MR. CHARNES: But --

JUSTICE GORSUCH: Just hypothesize that, okay?

In your circumstance, you're telling the Court there's no review of that decision, I believe, or maybe it's not a shenanigan even in your -- your view perhaps.

MR. CHARNES: Well, I think there is -- there is no review under -- under 314(d). It may be that it's an appropriate case for mandamus relief if the circumstances are as egregious as you suggest in your hypothetical.

JUSTICE GORSUCH: How would it be if it's not -- if it's not reviewable under 314(b)?

MR. CHARNES: Well, mandamus is only

available when there's no appellate review to begin with. So the fact that there is no appellate review --

JUSTICE GORSUCH: So we're going to just channel all these cases to mandamus? Is that -- is that the upshot of your position?

MR. CHARNES: No, because mandamus is a rare relief. I mean, it would only be reserved for really egregious circumstances like your hypothetical. The mine-run cases where the Board applies 315(b) and makes a determination would not be appropriate for mandamus relief.

And part of the reason is, as I was alluding to, is that 315(b) is --

JUSTICE GORSUCH: If the institution decision is not reviewable at all, how would it be mandamus-able?

MR. CHARNES: Well, if it's an egregious decision and where --

JUSTICE GORSUCH: So it's not reviewable unless it's egregious?

MR. CHARNES: Well, mandamus is only available in circumstances where there is no review. That's the first step -- first step for the -- mandamus. If there's -- if you can

review it on appeal, then mandamus is not available. So I don't think that excludes mandamus.

I think in the circumstance where the director says, for example, yeah, we think this is time-barred, but I want to kill this patent for political reasons, that may be egregious enough. And the Federal Circuit has indicated in a couple of different cases that mandamus may be appropriate in truly egregious cases in the context as to --

JUSTICE GORSUCH: Do you agree with those decisions?

MR. CHARNES: Yes.

JUSTICE GORSUCH: Okay. If that's the case, what does the work of -- of the presumption of judicial review do here in -- in your view?

MR. CHARNES: Well, I don't -- surely, we don't dispute that there is a presumption of judicial review.

JUSTICE GORSUCH: Okay. You agree with the government in the last case that it's based on separation of powers and it is designed to ensure people that they're not subject to

whimsical executive decisions?

MR. CHARNES: Well, in -- in general terms, yes. But I think it's important to recognize, as this Court held in Dalton versus Specter, that separation of powers requires this Court to respect Congress's withdrawal of jurisdiction to the courts as much as implying jurisdiction where it should exist.

Here, it would be one thing -- it would be a different case, for example, like in the first case, where the ultimate merits decision Congress tries to put or may put or the question is whether they put beyond judicial review. This is just a -- this is a forum selection provision. The question is, are these parties going to fight in the agency or are they going to fight in court?

It doesn't restrict the time-barred IPR petitioner's ability to challenge the validity of the patent in court, and it doesn't restrict the ability of the director of the PTO to institute other mechanisms that are available, ex parte reexamination, for example, under Section 303, to invalidate this patent.

So it's --

JUSTICE GINSBURG: What do you -- what do you do with the sentence in this Court's SAS decision that says 314(d) precludes judicial review only of the Board's initial determination under 314(a) that there is a reasonable likelihood that the claims are unpatentable?

MR. CHARNES: Yes, Justice Ginsburg, we -- we think that that's not a complete description of Cuozzo, and the reason is because SAS Institute, the rationale for why there was judicial review was completely different.

SAS held that Section 318 prohibited the agency's practice of only reviewing some of the challenged claims and not all of the challenged claims.

Section 318 is a step two merits statute. And --

JUSTICE GINSBURG: But it -- but just this sentence sounds like it's saying what 314(d) precludes, and it does say only a Board's initial -- initial determination under 314(a).

MR. CHARNES: I -- I agree that it sounds that way. We don't think that's a complete summary of what Cuozzo said.

JUSTICE GINSBURG: So you -- you think

that that was just a -- a wrong -- a wrong sentence?

MR. CHARNES: I wouldn't say it was wrong. What I'd say is that the Court had no need to describe Cuozzo more broadly, analyzing exactly what institution stage step one decisions would be precluded from of you because that was not the factual circumstance of SAS.

SAS clearly involved the question of whether the final written decision addressed all the claims that were being challenged. So that's the reason why reviewability was allowed in 314.

JUSTICE KAVANAUGH: I think you are saying it's wrong, to pick up on Justice Ginsburg's question, at least the use of the word "only."

MR. CHARNES: I -- I think it's not a complete description. I think that's -- let me, Justice Kavanaugh -- I think it's not -- that's not the only basis that this Court explained in Cuozzo. I think that's -- that's a fair point.

JUSTICE KAVANAUGH: If we took it that -- sorry.

CHIEF JUSTICE ROBERTS: Thank you,

counsel.

MR. CHARNES: Thank you.

CHIEF JUSTICE ROBERTS: Mr. Ellis.

ORAL ARGUMENT OF JONATHAN Y. ELLIS ON BEHALF OF THE FEDERAL RESPONDENT, SUPPORTING REVERSAL

MR. ELLIS: Mr. Chief Justice, and may it please the Court:

Congress established inter partes review as a quick and efficient means for the PTO to revisit issued patents and to cancel unpatentable claims. It proceeds in two steps, institution and trial. To prevent duplicative proceedings between the agency and the courts, Congress established a series of prerequisites to the institution of such a trial.

But, to maintain the efficiency of the process and ultimately to -- to preserve the resources of the agency and the parties, it focused judicial review on the issue that matters most to the system as a whole, the final patentability analysis and the final written decision after trial.

Respondents' argument to the contrary is inconsistent with the plain text of 314(d),

with the structure of the Act, and with this Court's decision in Cuozzo, and, ultimately, would give 314(d) the exact same meaning as its direct predecessor in Section -- former Section 312, despite Congress's use of markedly different language.

Section 314(d) on its face precludes judicial review of the determination whether to institute inter partes review. Because Respondents' challenge in this case is directed solely at that determination, the Federal Circuit lacked authority to review.

JUSTICE ALITO: I think you have --

CHIEF JUSTICE ROBERTS: I want --

JUSTICE ALITO: Chief.

CHIEF JUSTICE ROBERTS: I want to pose for you the same question that Mr. Charnes was asked about the separation of powers.

As I understand his answer, at least part of it is more or less that this is small potatoes. It's just about timing for -- for the institution of the matter and that the basic issue of the patent validity is something you're going to get to. You have a number of avenues to get to it.

Is that your -- do you agree with that view?

MR. ELLIS: I -- I do largely agree with that view. I -- I think that the -- the presumption of judicial reviewability is primarily about congressional intent. And so I do think that in a case where you have an express bar on judicial review, you've gone a long way down the road.

That doesn't mean that it drops out entirely. But I also think it's important in this case, and it would mitigate any separation of powers concerns, that you do get review at the end of the day of the patentability analysis, the -- the issue that matters most to that system and to the parties themselves.

And I -- I do think it's important to think about the fact that Section 315(b) isn't a limit at all on the director's ability to revisit the patentability of any particular patent.

And so, Mr. -- Justice Gorsuch, when you offered a hypothetical about the director who was just bent on reviewing the -- the patentability of a particular patent, I -- I

think one thing to address that concern is that you're going to get review, judicial review of the patentability, that is to say whether the director's decision is correct or not.

JUSTICE GORSUCH: But you're not going to get review, though, of the question of whether the director could institute that proceeding in the first place, are you, especially after -- I mean, as I understand it, this patent has been challenged four times before, unsuccessfully.

MR. ELLIS: Even --

JUSTICE GORSUCH: And, here, it was challenged successfully only because it was filed out of time.

MR. ELLIS: Even -- well, I'm not sure that last part is -- is entirely true. Even where --

JUSTICE GORSUCH: I thought the government had conceded that the -- that the institution of proceedings here was untimely?

MR. ELLIS: That's right. So 314 -- 315(b) --

JUSTICE GORSUCH: And that there's no review of that decision in this proceeding at

all?

MR. ELLIS: That's right. And that -- but the reason that it doesn't mean that the director was precluded from -- from reviewing the patentability of that determination is what my friend alluded to, that 3 -- Section 315(b) doesn't bar the director from revisit -- or from revisiting an issued patent.

They could -- could have -- the director could have taken the exact same materials that was submitted with a petition for inter partes review, decided that the review, inter partes review, was time barred but then instituted an ex parte reexamination.

JUSTICE GORSUCH: Sure. There are a million other things that could happen, but this is what happened and we can't review it. Right?

MR. ELLIS: I -- I agree, yes. It's --

JUSTICE GORSUCH: And nobody will. And the patent has now been killed. And there is no way to review it on the basis of its timeliness.

MR. ELLIS: What was open for review was that patentability analysis. Now Respondent

opted not to challenge that patentability analysis. But, if it had merit, that would be judicially reviewable and then the patent wouldn't be canceled. I think that --

JUSTICE SOTOMAYOR: So how about a situation where it's only discovered during the proceeding that's been instituted that a privy of the Petitioner was served with a complaint alleging infringement in -- that would bar this action if it had been known at the time it was instituted. Is that appealable?

MR. ELLIS: No, it's not. I -- I think that the Board --

JUSTICE SOTOMAYOR: Why?

MR. ELLIS: Because 315(b) determines -- speaks only and exclusively to the determination whether to institute inter partes review. And so --

JUSTICE SOTOMAYOR: No, it has -- it doesn't talk anything about whether to institute it. It speaks in a -- in a prohibitive sense. An inter partes review may not be instituted if the petition requesting the proceeding is filed more than one year.

So it doesn't talk about the

director's decision. It talks about barring the action if it is --

MR. ELLIS: Well, with respect, Your Honor, it talks about barring of the institution of the action, and the only --

JUSTICE SOTOMAYOR: I don't see the word "institution." May not be -- you're right, may not be instituted.

MR. ELLIS: Okay. So -- so it bars -- and the only actor who is authorized by the statute to institute inter partes review is the director. So I think it fits very closely with 314(d) that makes clear that the determination --

JUSTICE SOTOMAYOR: So if he learns during the proceeding. So this is not sort of a jurisdiction -- this is not an issue that he can determine based on the papers necessarily.

MR. ELLIS: So he -- the Board at -- at that point does accept a motion to terminate inter partes review on the basis of newly discovered information.

If the Board finds that 315(b) should have barred institution of review, it can then vacate its institution decision.

But, importantly, what it does is vacate its institution decision. It does not issue a final written decision. And then that is a determination whether to institute inter partes review --

JUSTICE ALITO: Mr. Ellis --

MR. ELLIS: -- that is not reviewable.

JUSTICE ALITO: -- I think you have a -- a -- a strong argument under Cuozzo. But what do you do with the language that Justice Ginsburg read from SAS and how would you reconcile SAS with your position here?

MR. ELLIS: So I think, as far as reconciling the decision itself, I agree with my colleague that it just wasn't at issue in that case. The -- the limit on the Board's authority in that case was 318(a), the provision that -- that dictates the -- the contents of the final written decision. So I think 314(d) --

JUSTICE ALITO: But why would it not be at issue? Why couldn't you characterize the issue in SAS whether it was proper to institute review of only some of the claims?

MR. ELLIS: To be sure, that's the way the government did characterize it. The Court

rejected that -- that understanding of what was at issue and said that 318(a), a provision that -- that speaks to the final written decision, had been violated in that stay -- case. And it wasn't very hard for the Court then to conclude that 314(d), which only discusses the determination of whether to institute, wouldn't bar review of that.

And I want to directly address this sentence that is -- that has been discussed about. I do think that sentence is wrong, and I think it's incomplete. I think it starts -- it's important to note the sentence actually says Cuozzo concluded that Section 314(d) only precludes the 314(a) determination.

Cuozzo concluded more than that. And I think, if you look at the decision, you'll see that. I don't -- but the reason that's not a problem is that it just wasn't at issue in SAS. And nobody flagged that because the -- the -- the statute that was challenged or that was -- on which the Court's decision was based in SAS was not either 314(a) or a closely related --

JUSTICE BREYER: Look at --

MR. ELLIS: -- provision.

JUSTICE BREYER: -- look at Cuozzo, and look at SAS. Everybody -- I think several of us have the same problem. In Cuozzo, I mean, the object of this thing, those words, seem to be that -- that -- that, look, there is a Patent Office making a decision about this claimed patent, and the closer relationship between the appeal and the issue on which it's being appealed to this decision, the more clearly barred it is.

But you could have a reason for throwing out the patent that is terribly important, that has all kinds of implications, constitutional, a different unrelated statute, or maybe there's some others which perhaps none of us could actually think of, but we could characterize them generally.

All right. Then SAS doesn't say that's wrong. It's just nervous about the open language. And so it tries to take that and -- and narrow it somewhat by focusing really on the heart of what that was about, which is this individualized decision, which we know is barred, and now we have a statute.

And this statute, well, it's not

exactly just about this decision, is it? But it's sort of close, isn't it? And so what do we do with this statute? Because this statute talks about the general problem of complaints that were dismissed without prejudice. And do they fall or don't they fall within those words serving a complaint?

And that is a general question, and it goes well beyond this -- or well beyond it? I mean, I don't know. So I'm saying, if you were me and you read it that way, what would you say? Let's look at this statute. Is it a statute closely related, Cuozzo, or is it a statute closely related under SAS? And SAS doesn't use the words "closely related." But that's what it -- I think it's driving at.

MR. ELLIS: So I do think that this is a closely related decision. As we've discussed, it only speaks to institution. And if you have doubts --

JUSTICE BREYER: Yes, of course, it only speaks to institution, but you could have a statute that said anyone who's 6'2" can't institute. That would only speak to institution, all right? That would be an

important statute or an important decision.

MR. ELLIS: And so I --

JUSTICE BREYER: So -- so the fact that it only speaks to institution isn't quite catching the point. The point is, how general and important is it above and beyond this particular proceeding, this particular claim?

MR. ELLIS: So if that -- if what you're driving at is sort of what was happening -- discussed in the first case this morning, that questions of law should be able to be reviewed, I just think, unlike the provision at the first -- in the first case, there is no basis to draw that distinction.

So, if you, at the end of the day, conclude it's just too difficult to figure out, as my -- as Respondent says, it's unworkable to figure out how close is close enough, then what I'd urge the Court to do is apply the provision as it's written.

JUSTICE GORSUCH: Well, how about --

MR. ELLIS: If it's about the determination whether to institute inter partes review, then it's not reviewable.

JUSTICE KAVANAUGH: Under this

section.

JUSTICE GORSUCH: Well, how about -- how about -- under this section, yes. How about that? How about the fact that, traditionally, executive branch agencies have considerable discretion in evaluating the merits of claims in deciding whether to proceed with enforcement actions, and, traditionally, statutes of limitations or repose were deadlines that are clear and written in law, tend to afford enforceable judicial rights to citizens? How about that?

MR. ELLIS: So, as I -- as I mentioned before, this is not a statute of repose. This Petitioner could challenge in the courts. This Petitioner could -- could join another IPR that was already proceeding. The director could institute review on the behalf of any other person.

JUSTICE GORSUCH: There are other proceedings, I accept that, okay, but there's always like state proceedings. We don't do double jeopardy between states and federal law anymore.

MR. ELLIS: I --

JUSTICE GORSUCH: So there's always another proceeding available to -- to -- to -- there's always another way to skin the cat.

MR. ELLIS: But this is the exact same thing.

JUSTICE GORSUCH: But this is what Congress wrote in this cat for this cat. And -- and -- and I guess I'm just wondering again, with Justice Breyer, in terms of close, how close it is, isn't there always a traditional distinction there that we recognize in our law governing judicial review?

MR. ELLIS: This -- maybe there -- there is a tradition, I agree. And, actually, Respondent argues that his reading of 314(d) would do nothing at all; in fact, would just reinforce those provisions. But I don't think that's a plausible reading of the statute.

And to address the "under this section" language, that language is used throughout the AIA; indeed, throughout 314 itself.

JUSTICE KAVANAUGH: But "under this chapter" is used in the same provision. If we had "under this chapter" here, that would solve

your problem.

MR. ELLIS: I -- I don't think we need that. I mean, I think if you talk about -- just look at the text before that, the determination whether to institute inter partes review, nobody doubts that the 314(a) determination is part of that. But no one also doubts that there are other parts -- aspects that go into that determination.

So, for example, if you were thinking about a decision -- a court's decision whether to grant a preliminary injunction, no one would reasonably say that the threshold merits determination on a PI, that whether there's a likelihood of success, is the determination whether to grant a PI, even if you say the determination whether to grant a PI under whatever authorization statute you're providing. And that's what "under this section" does. It does it here and it does it everywhere else.

All it says is the petition filed under 311, the response filed under 313, the -- the final written decision filed under -- under -- or issued under 318(a). That's what "under this section" does here. It does not -- they

don't use this language in a way that isn't used -- it's not used anywhere else in the Act.

And if you have any doubt about the scope of this provision, I would urge you to look at the former Section 312. It's laid out in our appendix, but it's also block-quoted at page 8 of our reply. Petitioner -- Respondents' reading of 314(d) is to -- exactly what 312(c) said, that the determination under subsection (a) is final and non-appealable.

But, if Congress wanted to do that, there's just no reason at all for it to have changed the language and for it to have used a phrase that just doesn't sensibly describe only the threshold merits determination.

So you really have a choice of giving "under this section" not a great deal of meaning that clarifies the authority, or you have a choice of giving a meaning that it has nowhere else in the code and then renders 314(d) largely superfluous in its entirety.

We don't think there's a -- that the -- that the former would -- the latter, rather, would respect Congress's choice. In this case, it's undoubtedly a choice to preclude judicial

review.

JUSTICE KAVANAUGH: Do you think it's ambiguous?

MR. ELLIS: I don't think it's ambiguous, no. I think if there was any ambiguity in this provision, it was the one that was addressed in Cuozzo, whether it only applies for interlocutory appeals or after final written decisions. The Court decided that -- that question in Cuozzo, no one is asking to revisit it.

I don't think -- and no one took -- it was taken as a given in Cuozzo that it would preclude 315(b). Justice Alito in his dissent said as much. And I don't think the -- the -- at the end of the decision he was going back on that. He just said this is the problem, and I don't agree with the Court's decision.

JUSTICE KAGAN: But maybe one way to read Cuozzo -- and I take this to be the point of Justice Breyer's question -- is that it -- it goes beyond 314 but that it only goes to questions that are closely related to the reasonable likelihood determination. So, there, the particularity requirement was reasonably

related -- was related, closely related, to that reasonable likelihood of patentability determination, but timing is -- is less so.

MR. ELLIS: So I -- I -- I grant you that's one way to read that one particular passage. I think if you look elsewhere in Cuozzo, you'll see that what the Court says, for example, on page 2141, is that it's the questions that are closely tied to the application and interpretation of statutes, plural, related to the Patent Office's decision to institute inter partes review. So I don't think that's a plausible reading of what was going on in Cuozzo. And I would point out --

JUSTICE GINSBURG: But what about the --

MR. ELLIS: -- that it was 312(a)(3) that was at issue there, not 314(a).

JUSTICE GINSBURG: -- the -- in Cuozzo, it was a particularity requirement, and that was described as a minor statutory tech -- technicality. But, here, we're not dealing with a minor statutory technicality; we're dealing with a time bar.

So does that expression in Cuozzo that

it was a minor statutory technicality limit it so that a time bar is -- is -- is -- could not be characterized that way?

CHIEF JUSTICE ROBERTS: Briefly, Mr. Ellis.

MR. ELLIS: No, Your Honor, it does not. For one, 312(a) was a meaningful limit on the director's decision to even institute at all. So we think it is -- to the extent that's a minor technicality, this one fits into the same bucket. It doesn't actually preclude the director from reaching the final decision.

And I take the point of that passage in Cuozzo to be that we shouldn't throw out the Board's final written decision on patentability. The major -- the major question on a ground that's completely unrelated to that decision, 315(b) is exactly that.

CHIEF JUSTICE ROBERTS: Thank you, counsel.

Mr. Geyser.

ORAL ARGUMENT OF DANIEL L. GEYSER

ON BEHALF OF THE PRIVATE RESPONDENT

MR. GEYSER: Thank you, Mr. Chief Justice, and may it please the Court:

I respectfully waive my two minutes but would otherwise start by underscoring the truly extraordinary nature of the top side argument.

As we've heard today, as my friends read this statute, Congress delegated the judicial function to an administrative agency, gave that agency the unfettered discretion to say what the law is, and then instructed that no Article III court at any time at any level may review the agency's interpretation of the statutory limits on its own power.

CHIEF JUSTICE ROBERTS: Well, if you're going to waive your two minutes, I'm not going to sit back.

(Laughter.)

CHIEF JUSTICE ROBERTS: The -- the point's been made, and it's an important one, about the separation of powers. And I -- I will repeat a question that has been asked this -- this morning.

But is that really implicated here when you're talking about a -- a time bar on something that a party is going to get review of anyway? I mean, the question of patentability

could be put at issue in any number of ways. And I wonder if those types of very significant concerns, concerns that it is importantly our job to be concerned -- to be vigilant about, really do come into play when it's simply a question do you go this route or can you go that route and that the fundamental question that's at issue about patentability is -- is going to be reached. That's not being foreclosed.

MR. GEYSER: Well, the -- the ultimate question isn't being foreclosed. That's true. But the -- the 315(b) bar, this is not a minor statutory technicality. This is one of the substantive safeguards that Congress put into the Act in implementing this very new procedure that is adversarial in nature.

And it understood that this is a significant protection for patent owners. And it's a significant way to divide the authority between the courts on the one hand and the agency on the other.

So this isn't the type of provision that just is out there and it doesn't really have any effect in the real world.

CHIEF JUSTICE ROBERTS: Well, but, I

mean, I don't think it's what we were fighting over at Yorktown. I mean, it's just a question of whether --

(Laughter.)

CHIEF JUSTICE ROBERTS: -- as you said, the ultimate question, the ultimate issue that affects the property rights in a patent, it's going to be reached. It's just a question of whether you use one procedure or another.

MR. GEYSER: Well, Congress viewed it otherwise, Your Honor. Congress definitely could have put in the inter partes review scheme, something like it did in Section 303(c), and so the director can institute sua sponte if it wants to. Instead required a proper petition and it categorically cut off the agency's authority to act if the petition is filed after that one-year deadline in 315(b).

JUSTICE KAGAN: Well, it does, but you don't contest, right, that one -- if this Petitioner is thrown out, somebody else can bring another petition, right?

MR. GEYSER: Oh, hypothetically, they -- they could, Your Honor, but you would need a hypothetical future party raising a hypothetical

future petition. It hasn't happened yet. And there's nothing in the statute that says that --

JUSTICE KAGAN: Well, but it wouldn't be rare to have such a party. Quite the opposite, it would be common to have another party who would pick it up.

And what your solution would -- would happen is that we go through the entire process, soup to nuts, and then we get to the end and somebody says, you know, the time bar wasn't applied correctly. We throw it all out and we start all over again on something that we know by now is an invalid patent.

MR. GEYSER: Well, we -- first, we don't necessarily know that it is an invalid patent. The patent office --

JUSTICE KAGAN: Well, we know that the Board held that it was an invalid patent.

MR. GEYSER: And it -- and it is reversed a quarter of the time. But I think the important point is that Congress did say that the agency cannot exercise its review power for inter partes review in those circumstances.

And it may be true that there might be a future party, but we don't know that yet.

Congress could have excluded that.

JUSTICE KAGAN: Well, Congress also said that there's no judicial review of the decision whether to institute.

And, presumably, Congress said that for exactly this reason, that once that decision is made and you go through the entire process and you get a merits determination, given that throwing it all out is just going to land you at square one doing the exact same thing, that it was, you know, a little bit silly to go back to square one.

MR. GEYSER: Your Honor, I -- I don't think that Congress thought that Section 315(b) was -- was insignificant. I think it -- they wanted it to have teeth.

And just to be absolutely clear, the petition that my friends are raising on the other side says that no court can construe what that language means.

This is a provision that Congress used to calibrate important interests.

JUSTICE GINSBURG: But, if we're -- if we're in doubt about, we think it's ambiguous, doesn't the nullification of the determination

that this patent is no good, that's out there, that's what the Board thinks, that this should not have been patented, and we wipe that out, then you get another challenger and where the Board has already made the decision that the patent is no good. There's something unseemly about nullifying the determination on the merits.

MR. GEYSER: I -- I disagree, Your Honor, and for the reason that if the -- if the patent, in fact, is invalid, then it can be invalidated in a proper proceeding. And, again, it's subject to judicial review on the merits.

And so it's not entirely sure that that patent, in fact, is invalid. What we do know is that Congress did not want the proceeding to start if the -- the petitioner is filing it after the year deadline.

Often what happens -- and this is not just a question of wasted resources, although we would submit that construing this provision correctly will spare unauthorized future proceedings that will far make up any resources wasted in this individual case.

JUSTICE BREYER: Well, what is -- what

is the -- the -- the analogy that floats around in my mind on this is that judges and agencies start down a road and then they say, oh, my God, I made a mistake.

And -- and we give them lots of power in the law to call back what they did and correct the mistake. The obvious example last week was Rule 59. All right?

Now a judge, when faced with a 59 motion, says, my goodness, you're right, I made a mistake, and he changes it. Now, in fact, the party filed that 59 motion one day too late. Okay?

Now can there be an appeal to an appeals court that this mistake which was recognized by the judge shouldn't have been recognized because the Rule 59 motion was filed a day late? My guess is the court of appeals will not consider that kind of thing. You get one appeal from the ultimate thing.

Now this is highly analogous. You see, they're saying, oh, we think that -- we think that, given all the other ways of filing, getting this in front of us, this issue, of whether we made a mistake, it's not what

Congress meant that we can't hear it when there is a -- when there is a complaint filed and the parties say throw it out without prejudice, that that shouldn't stop us from hearing it.

They might be wrong about that. But that's like filing the 59 motion a day too late.

And we shouldn't have review of that kind of thing. All it was was an effort to correct a mistake. What do you think?

MR. GEYSER: Well, this -- this is what I think, Justice Breyer. I think that this is the construction of a federal statute. So the question is not how do we apply a given rule with a given construction on a given day for a certain set of facts.

This is what does an act of Congress mean? And, again, this is --

JUSTICE BREYER: Well, that's true, of course, or could be true in many matters governing instances where judges or agencies call back something they did because they think they did it wrong.

MR. GEYSER: Well --

JUSTICE BREYER: Would that make it somehow more reviewable?

MR. GEYSER: Well, I -- I think what makes it reviewable is the strong presumption favoring judicial review. Again, it is exceedingly rare for Congress to enact a highly reticulated scheme that's restricting the agency's core authority for significant policy objectives and then says, agency, you figure out what those provisions mean.

No court --

JUSTICE KAGAN: Well, you're -- you're right, it is rare. And that's why we have this presumption and we usually don't think that Congress wants it.

But this language is pretty broad. It's the decision to institute is final and unappealable. And you're going to tell me it's in this section. And I'm going to tell you, I mean, in this section is just the decision to institute, is in this section, but the decision to institute is final and unappealable.

MR. GEYSER: Well, a -- a couple key points, Your Honor. I am going to tell you that it says under this section, but I do think it says that for a very important reason. And under my friend's reading, that phrase, "under

this section," has absolutely no meaning. You can take it out of the statute and it means exactly the same thing.

In fact, you can replace the word section with the word chapter. These are two very different terms. And Congress knows the difference because, if you look to 314(b), they used the phrase "institute under this chapter."

JUSTICE ALITO: Well, I don't want to interrupt the rest of your answer to Justice Kagan, but would it be possible for the director to institute inter partes review under some other section?

Could the director say, I don't want to invoke 314, I want to institute inter partes review under some other provision of law? Can he do that?

MR. GEYSER: Well, this is -- and there's an oddity with this statute, Justice Alito, in that there is not an express provision anywhere in Chapter 31 that expressly authorizes the director to institute review. It's not in 314. The institution takes place implicitly under this chapter, which is why, if you look through Chapter 31, you'll see repeated

instances.

And I think 314(b), which is "under this section," is a great illustration. It talks about institute an inter partes review under this chapter. It is not as my friend from the government says. It's just describing where something happens.

JUSTICE KAGAN: But, Mr. Geyser, I think 314(a) does. I mean, it does it in a little bit of a backhand way, I understand that, but it says it gives -- 314(a) is what tells the director when he should institute. And so it's 314(a) that authorizes the director to institute, and then 314(d) says the decision to institute under this section, in other words, under 314(a), is final and unappealable.

MR. GEYSER: I -- I almost agree, but there's a very important predicate step, and that's, in order to get to Section 314, you first have to clear the gateway prerequisites under 315, including 315(b).

And as my friend from the government concedes in the reply brief, this is on page 6 of the government's reply, they concede that if the prerequisite under 315(b) is not met, the

director has nothing else to do, which means that the director doesn't make any determination under Section 314.

And you're right that Section 314(d) is linking the determination, under this section whether to institute, to that determination under (a), which is entitled to threshold consideration. It's looking on the merits. If you have an eligible petition, does it satisfy the -- does the director determine that the information presented shows that it's reasonably tolerable --

JUSTICE KAGAN: But, if you're right, Mr. Geyser, what does this unappealability bar really amount to? When does it bar anything that anybody would want to raise as an argument?

Because, if you are right, it's just limited to the substantive determination at the threshold stage. But, by the time this is going to get to appeal, the substantive determination at the threshold stage has been subsumed by the substantive determination -- the final substantive determination. So, if you're right, you're basically saying, you know, there's this unappealability -- there's this bar on appeals

that applies only to something that nobody would raise.

MR. GEYSER: Your Honor, what -- what I'm saying is exactly what Congress did in Section 303(c) --

JUSTICE KAGAN: Well, you're saying --

MR. GEYSER: -- and in 312(c).

JUSTICE KAGAN: -- that Congress wrote that silliest provision that the bar on appeals applies only to something that nobody would raise --

MR. GEYSER: It --

JUSTICE KAGAN: -- because it's been totally mooted out.

MR. GEYSER: It's -- it's not silly because Congress has a good reason to make absolutely clear that people will not interrupt the inter partes review while it's going on with a disruptive interlocutory appeal. And at the end of the day, they won't waste the court's time with that preliminary initial threshold decision.

But, again, Congress is repeating the exact same pattern that it did in Section 303(c) and that it did in former Section 312(c). This

is one area --

JUSTICE KAVANAUGH: Do you disagree with Justice Kagan that it does no work under your reading?

MR. GEYSER: No. It clarifies what the likely outcome is, and I think clarifying does give it significance.

JUSTICE KAVANAUGH: But does the clarifying do any work?

MR. GEYSER: The -- I think that --

JUSTICE KAVANAUGH: In the real world? Which is what I took to be the -- her question.

MR. GEYSER: This -- this is -- all I can say is that we know that Congress thought it was doing work because everyone agrees that is all that Congress did in 303(c) and 312(c). So I'm not making this up.

If you look back and see what has Congress done in the past in this very area, it's done exactly how we're reading 314(d). And this is an area, again, that all -- I think all parties to this case agree, everyone agrees that 303(c) and 312(c), former Section 312(c), accomplish only what Justice Kagan has pointed out.

JUSTICE KAGAN: I think Mr. Ellis would say, well, that's true, but those provisions were -- specifically said exactly that. If you take a provision that's now written much more broadly and limit it to that set of applications, which is essentially nothing, I mean, isn't Congress's intent being flouted?

MR. GEYSER: I -- I don't think at all, Your Honor. And, first of all, the language is not markedly different. And I think one would expect that if you're going to expand an appeal bar -- which, again, we're -- we're in very rarified territory, as we heard both earlier today and in the top side of the argument, of cutting off the court's ability to say what a -- a provision of the United States Code means. No court at any time will have the power to read this and say what it means. That's --

JUSTICE KAVANAUGH: Can you give any real-world example of when the bar would do work?

MR. GEYSER: The -- the bar would do work if a party came -- let's say that a

petition says I think that this patent is invalid, as -- as obvious, in light of a certain prior art reference A. And then the agency says, you know what, we agree; we're going to institute review. And then, in the course of review, they say, oh, my goodness, we were entirely wrong; that argument was actually frivolous, but you know what, there's actually a different argument that would invalidate the patent at the end of the day. Then I could see a party saying, well, wait a minute, then institution was improper under (a), because they're conceding that, in fact, the petition should not have been instituted, there wasn't --

JUSTICE KAGAN: So you think that Congress wanted, in a case like that where the Patent Board has found a good reason why the patent is invalid, to go back and do the entire thing over again because its initial theory was not the one that it ended up with?

MR. GEYSER: Well, what I think, Your Honor, is that Congress was not focused in a single-minded way on a single objective when they wrote this statute. These provisions were heavily negotiated. And I think if you see the

amici on our side, you can see why they thought that the 315 bar is a fundamental safeguard to protect patent owners from both harassment and abuse.

It avoids a situation where someone litigates in district court, they test the waters, it turns out they don't like how it's going, and they try to uproot the proceeding to the agency after the fact. This is very important substantive protections for a patent owner whose property rights are subject to review in an Article I tribunal.

And my friends have even conceded that that tribunal is truncated. It is not providing an equivalent process that you would get in a -- in a normal Article III proceeding.

JUSTICE KAVANAUGH: But --

MR. GEYSER: So I think Congress didn't look at this as some minor statutory technicality.

JUSTICE KAVANAUGH: Well, it -- it doesn't have to be characterized as minor just because it's not judicially reviewable. We presume that the executive officials are going to follow the laws set forth by Congress,

whether or not there's judicial review.

MR. GEYSER: We -- we do presume that, but we also presume that -- that they're more likely to follow the law correctly when someone knows they're checking their homework.

JUSTICE KAVANAUGH: That's true in practice, I -- I grant you that --

MR. GEYSER: And --

JUSTICE KAVANAUGH: -- but it's not that it does no work without judicial review. I'm just pushing a little bit on that point.

MR. GEYSER: Well, Your Honor, I fully agree that we -- we -- we have every belief that the agency will exercise the utmost good faith in adjudicating cases under this scheme, but what we do know from Mach Mining and from other cases of this Court --

JUSTICE KAVANAUGH: But that's a way -- sorry to interrupt. But that's a way to make the whole thing do some work under the theory that it's an important provision, 315. It does work in telling the agency don't do this. There may not be judicial review, but don't do this, and the agency is presumably going to listen to that.

Then the appeal bar, though, also does some work under this in that it knocks out claims -- it says certain kinds of claims are not appealable at the end, even if they happened in the rare instance, or maybe not so rare, to violate that bar.

So both provisions do substantial work then. What's wrong with that, looking at it that way?

MR. GEYSER: Well, I think -- I think what's wrong with it, again, is that you're removing any ordinary, traditional, normal function of judicial review to ensure that the agency's constructing the outer limits on its own power correctly.

And, again, that's not a small thing --

JUSTICE KAGAN: But, you know, you --

MR. GEYSER: -- I would submit.

JUSTICE KAGAN: -- you cited Mach Mining, but Mach Mining was very clear to say, again, we usually think that Congress wants the court to police a -- a -- a congressional statute, but sometimes Congress wants the agency to self-police because it doesn't think that the

costs of judicial review, and there are some, are worth it, given the subject matter, given the fact that in this case there's going to be review of the principal question anyway, and, you know, in the end, this is not -- it's not unconstitutional if Congress wants to say that the decision to institute is not reviewable. And Congress appears to have said that.

MR. GEYSER: Well, they appear to say it with respect to something, but the question is as to what. And, again, I think it's highly unusual that Congress put this no appeal bar in Section 314, said it applies to a determination under this section, and there -- there's a ready candidate for what Congress had in mind, and then is --

JUSTICE GINSBURG: But, under this section, the only section that deals with institution of inter partes review, any -- any institution of inter partes review would be under this section because there is no other section that deals with institution of inter partes review.

MR. GEYSER: Well, again, Your Honor, though, in order to even get to Section 314, you

first have to clear the gateway prerequisites elsewhere in this chapter, including Section 315. And, again, we're simply reading 314(d) to say exactly what this Court in SAS said it meant, which is it is limited to only the initial patentability threshold in 314(a).

Now my friend from the government now concedes that they think that was wrong. I don't believe they've asked this Court to overturn SAS. We don't think that the Court was wrong.

JUSTICE KAGAN: Well, it's not a question of overturning. It's just -- I think what they were saying is that SAS dealt with one issue in which it was unnecessary to recite Cuozzo's full test, but Cuozzo has a broader test than SAS quoted.

MR. GEYSER: Well, to be very clear, I -- I think that we win under Cuozzo as well, but I don't think that -- that the reasoning in that statement, which is a very plain statement in SAS, can be limited in that way.

SAS was addressing the government's argument that 314(d) precluded any issue bearing on the institution decision. That is -- that is

taking on exactly the same contention that they're raising in this case. Their contention ultimately is that this Court might have adopted a different rationale and ruled more narrowly in order to reject that argument, but that is an absolute part of the core holding of the case in rejecting what the government eventually framed as their primary submission in SAS.

But I also want to be clear about how to reconcile SAS with Cuozzo because I think SAS has already given us the pathway on how to do that. Cuozzo was absolutely clear that if you have a fundamental challenge to the 314(a) determination, but it is using the tools of other provisions of the Act that are designed to get information to the director to make that determination, then that's what's barred.

And I think it's clear that when Cuozzo said it precludes the initial patentability determination and any other statute that's challenging that determination, it specifically used the phrase "that determination," that patentability question, that's what's knocked out.

And because the -- that's because the

ultimate challenge is to 314(a). And that makes good sense because no party in their right mind would say I have no problem at all with the reasonable patentability determination. The threshold was met.

What I'm really upset about is the way that the petition was written. That's a claim that will fail every single time. There's no conceivable prejudice to that. But that is the opposite of what happens if someone is violating a strict statutory time bar that, again, is phrased very differently than the phrasing that you see under Section 314.

315(b) is phrased as an outright ban on the -- on the authority of the agency to institute. It says an inter partes review may not be instituted if those conditions are met. When you look to 314, it's asking what does the director think. This is something that the director has the power to determine.

Now that's something that the director can do if the gateway prerequisite under 315(b) has been satisfied. If it hasn't, then the director has no power to proceed, which, again, we agree with the government on this narrow

point; on page 6 of their reply, they say plainly that if that prerequisite is not met, the director has nothing else to do.

And at that point, the only determination made by the director is -- is not --

JUSTICE SOTOMAYOR: Mr. Geyser --

MR. GEYSER: -- happening under 314.

JUSTICE SOTOMAYOR: -- I -- I do have some sympathy for your argument that a petitioner should be given an avenue of judicial review on a legal question, like the timeliness of -- of the application, but some amici point out a potential problem under your view, which is, if the PTO agrees with you on the legal question and throws this complaint out, that the other side won't have an opportunity to challenge that because the only power to appeal is under 319, and 319 requires a full hearing for appealability.

So what do we really -- one way or another, we're going to preclude judicial review, the argument goes.

MR. GEYSER: Let me state --

JUSTICE SOTOMAYOR: Of a legal

question.

MR. GEYSER: Let me see if I can give you some comfort on that. There are always two questions that come up in these cases. The first is, is there a provision that affirmatively authorizes judicial review, and the second, is there a provision that affirmatively precludes judicial review? So we're talking about 314(d).

Now our contention is that let's say the patent office misreads 315(b) to say it doesn't have authority when, in fact, it does. It -- it reads one year to mean six months, so it's cutting off lots --

JUSTICE SOTOMAYOR: No --

MR. GEYSER: -- of time --

JUSTICE SOTOMAYOR: -- just this case.

MR. GEYSER: Or -- or --

JUSTICE SOTOMAYOR: It reads -- it reads it this way, and the other side says you're wrong --

MR GEYSER: Okay.

JUSTICE SOTOMAYOR: -- for all the reasons it earlier gave, okay?

MR. GEYSER: So -- so our contention,

again, is that 314(d) would not preclude review. The question is what is the affirmative power to review. Now it won't come under 319, you're right, there's no final written decision, but that doesn't take away the -- the potential to raise this under the APA, which provides judicial review for decisions where there's no other adequate means of doing it.

It potentially could get review under mandamus, depending on the egregiousness of the decision. And there is a provision in Title 28, it's 12 -- it's 1295(a)(4)(A), that gives the federal circuit jurisdiction over a decision of the -- of the patent -- of the PTAB in -- in the inter partes review setting.

So there are lots of different ways that someone who feels aggrieved by a misreading that cuts off power that otherwise exists, and I don't think that would also fall within the exception, just to make sure I'm rounding out the answer, for decisions that are committed to agency discretion, because, if the determination is we lack the authority to do something because they misread one of the outer limits on their power as opposed to we're declining to review,

for reasons of agency resources or we just don't think this is important enough to spend our time on, that's a different type of question.

So I think that the amici on the other side are wrong in that respect.

JUSTICE BREYER: So what's so terrible about reading the "in this section" to mean what it says, which is that where -- where the director -- where the director -- what is the exact word -- where the director decides to institute an inter partes review, under this section, that's it, you can't appeal that decision. That's the norm.

And, after all, the director could do this on his own, couldn't he?

MR. GEYSER: The -- the director could institute --

JUSTICE BREYER: Yeah.

MR. GEYSER: -- an ex parte reexamination.

JUSTICE BREYER: So -- so this then is basically a way, a little complicated way, but of the agency saying: Oh, my God, we made a mistake. And what that section has is about (d), subsection (d), is don't review the

decision, oh, my God, I made a mistake. Judge, you review whether it was a mistake. You review whether the patent should have been canceled or not canceled, but it's up to the director, really, whether he decides to look at it once, twice, or three times.

Indeed, how do we know the director didn't look at it 10 times before he ever decided to grant it? So that -- that's a simple way of looking at it.

MR. GEYSER: Well --

JUSTICE BREYER: And that -- that -- that -- that leads you to pretty broad language about what's -- what's pretty broad category of what you can't review.

MR. GEYSER: Well, again, I don't think it is -- is so broad. And I do want to make one thing very clear. The ex parte reexamination under 303 does not proceed the same way that an inter partes reexam or inter partes review does.

It -- it mimics the initial examination process, it gives the patent owner vastly greater rights. They get to interact with the office. They have additional amendment

rights.

JUSTICE BREYER: Yeah, yeah.

MR. GEYSER: So the process looks absolutely nothing like inter partes review. It's not just that they can say, you know what, we made a mistake. We'll just switch -- we'll scratch off --

JUSTICE BREYER: Right.

MR. GEYSER: -- inter partes review and rewrite ex parte reexamination. It doesn't work that way at all.

And it's --

CHIEF JUSTICE ROBERTS: Well, it's -- it's different, I'll give you that, but, I mean, it's focused on the same ultimate question.

MR. GEYSER: Well, sure, Your Honor, but -- but Congress decided in granting this new procedure that has a potent -- you know, a potent danger to patent rights that the -- the patent owners are entitled to significant safeguard and the main safeguard that they implemented are the ones in 315.

JUSTICE GORSUCH: Well, I guess the question, though, that -- that we're struggling with is, so what's the big deal? If you're

stuck going to ex parte review anyway, why should we care? What's your answer to that?

MR. GEYSER: Well, I -- I think you should care because inter partes review is a very different process than ex parte reexamination. And, again, if Congress wanted --

JUSTICE KAGAN: But somebody else can --

JUSTICE GORSUCH: Spell that out. Spell that out. Why?

MR. GEYSER: It's because, instead of having an opportunity for a single response, truncated discovery, you're in an adversarial proceeding. You're before a panel of three PTAB judges who might give you an hour oral hearing.

You get a long, iterative process with -- with a talented patent examiner who can say this is what I think is wrong, and then you have lots of opportunities to show them exactly why that concern is unfounded.

And, again, the PTAB is reversed a fourth of the time. It's not like this process, because it's so truncated, I'm assuming, is perfect or without error.

CHIEF JUSTICE ROBERTS: Well --

JUSTICE KAGAN: But, if it's not with this Petitioner, it can be another petitioner.

MR. GEYSER: And -- and if --

JUSTICE KAGAN: And, indeed, even when a petitioner drops out under this statute, the Board can keep the proceeding going without the petitioner. So the fact that it's this Petitioner seems utterly unimportant under this statute.

MR. GEYSER: Not at all, Your Honor. And I think the key is that if Congress thought that the Board -- that the Board can do whatever it wants, it would have mimicked the same language it had in 303 saying they have a sua sponte right to institute review. This is a procedure that is keyed directly on there being a proper, timely petition.

JUSTICE KAGAN: You -- you don't deny that another petitioner can just step into the shoes of this Petitioner.

MR. GEYSER: If they file a timely petition, they can seek review. I absolutely concede that --

JUSTICE KAGAN: And you don't deny

that if a petitioner drops out for any reason, the Board can go on without any petitioner?

MR. GEYSER: Assuming that it was a properly filed petition in the first place. We don't disagree with that. But, again --

JUSTICE KAGAN: It just doesn't seem as though this Petitioner makes all that much difference.

MR. GEYSER: Well, Congress felt otherwise in this heavily negotiated process that produced 315(b) as a fundamental safeguard for patents.

JUSTICE GORSUCH: But, again, why would it have made that judgment, I guess is the question? Why does it matter whether it's one petitioner or another petitioner?

MR. GEYSER: Well, because Congress felt that it was important in this adversarial scheme.

JUSTICE GORSUCH: Why?

MR. GEYSER: To -- to make sure that you don't have someone gaming the system, waiting out over a year or even in this case 10 years before they seek review, where you don't have repeated inter partes review petitions

filed by multiple people trying to hold up the patent and prevent a legitimate litigation in an Article III court seeking recourse for infringement.

There are lots of reasons that Congress would have had in mind. But, typically, the -- the way the system works is Congress passes a law, the agency gets to enforce it, but this Court ultimately gets to say what those provisions mean.

Congress thought this was an important provision. Congress could have said: You know what, it doesn't really matter if it's timely or not, do your best, agency, and then we'll -- we'll move on. But they limited this, located it in a specific section, keying it to a specific determination, as this Court has already recognized in SAS, and it said that only that determination, the one under this section, not under this chapter, is a thing cut off from appellate review.

So I -- I don't think it's enough simply to -- to throw up our hands and say maybe someone else could come along. Maybe they can, but maybe they won't. And, even if they do,

they still need to mount a challenge that the director is willing to accept.

So -- and I would like to say one other point about the statutory history. Again, I do think that this is actually pointing in our favor, not my friend's. It shows exactly Congress following a -- the same pattern in cutting off a similar type of appellate review. It's very narrow.

And I think that it would be extraordinary to presume that Congress expanded that in such an oblique, indirect way as they did here.

When Congress wants to cut off appellate review and say that the -- the usual Article III function is delegated exclusively to an agency, where no court at any time gets to look through any of these provisions that Congress took care to articulate to limit the agency's power, Congress presumably writes in a clear and unmistakable way.

I would submit that I'm not aware of any case that this Court has ever decided that -- may I finish?

CHIEF JUSTICE ROBERTS: Sure.

MR. GEYSER: -- that would find Article III review cut off entirely based on language as indirect as this.

CHIEF JUSTICE ROBERTS: Thank you, counsel.

Three minutes, Mr. Charnes.

REBUTTAL ARGUMENT OF ADAM H. CHARNES
ON BEHALF OF THE PETITIONER

MR. CHARNES: Thank you. I'd like to make four points.

First, with respect to the language under the section in 314(d), other provisions of the -- of Chapter 31 make perfectly clear that Congress viewed the institution decision under 314.

For example, 315(c) says -- refers to "the institution of an IPR under Section 314." There's similar language in 316(a)(2).

So -- so we believe that's all Congress meant by that, those three words, is that institution occurs under 314. The title of 314 is Institution of Inter Partes Review. And there's no other provision of the statute that could plausibly involve institution.

The second point, my -- my friend

referred to several times the Section 303 and former Section 312 and suggested that they're analogous to what Congress did here in 314. But that -- that's simply not true.

If you look at former Section 312(c), what it says is "a determination by the director under subsection (a) shall be final and non-appealable."

If Congress meant to limit the preclusion of judicial review to the preliminary patentability determination in subsection (a) of Section 314, there is no reason it would not have used the language that was already in the statute, that it was replacing, when it drafted the America Invents Act. It did not do that. It specifically changed the language. And that change has to have some -- some meaning.

Third, my friend also mentioned, when asked, I believe, what work Section 314(d) did, said that, well, it bans interlocutory review. Well, that rationale was specifically rejected by this Court in Cuozzo, where it said it was not limited to simply prohibiting, you know, interlocutory review. In fact, it would have been superfluous if that was the purpose of --

of the statute -- of the -- of the provision.

And, fourth, going to your question, Justice Sotomayor, we -- we disagree that there's not -- we think there is an asymmetry here if -- if Respondent is correct. This Court in Cuozzo said clearly that denial of an IPR petition is committed to the agency's discretion.

And that means it's unreviewable. And that's how the federal circuit in several decisions has interpreted it. In the Wi-Fi One case, which is the en banc case that was applied below, the court said that a denial cannot be reviewed. And in the Saint -- more recently in the Saint Regis Mohawk case, it said the same thing.

So I think you've got an asymmetry here, which is that legal determinations made by the Board in the course of granting review, if Respondent is right, can be reviewed after final written decision on appeal.

But, if the -- if the Board denies review on the basis of a legal determination, that will never be reviewed.

So here, for -- here, for example, if

the Board came to the opposite conclusion, it would not be reviewable.

Thank you.

CHIEF JUSTICE ROBERTS: Thank you, counsel. The case is submitted.

(Whereupon, at 12:08 p.m., the case was submitted.)