No. _____

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 U.S. Court of Appeals for the Federal Circuit

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

Congress has long provided that a patent may be held invalid at any point during its term, including when the U.S. Patent and Trademark Office (PTO) determines that the patent should not have been issued in the first place—that is, that it never met the requirements for patentability. In the America Invents Act, Congress created inter partes review to enable third parties to petition the PTO to adjudicate the validity of, and potentially cancel, a patent.

The PTO recently announced that a patent owner acquires "settled expectations" in a patent when that patent has been in force for six years—regardless of whether it is invalid—and, further, that such "settled expectations" provide a justification for refusing to institute inter partes review and therefore refusing to adjudicate whether the patent is invalid.

The questions presented are:

1. Whether the PTO lacks statutory authority to deny institution based on "settled expectations" where the patent statutes allow for administrative review at any time during the life of a patent.

2. Whether courts have power to review a PTO decision denying inter partes review on grounds that are contrary to statute.

PARTIES TO THE PROCEEDINGS

Petitioner Google LLC was the petitioner below. Petitioner's ultimate parent company Alphabet Inc. trades under the ticker symbols GOOG and GOOGL on the NASDAQ exchange.

Respondents VirtaMove, Corp., and John A. Squires, Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, were respondents below.

RULE 29.6 STATEMENT

Petitioner Google LLC is a subsidiary of XXVI Holdings Inc., which is a subsidiary of Alphabet Inc., a publicly traded company; no publicly traded company holds more than 10% of Alphabet Inc.'s stock.

RELATED PROCEEDINGS

In re Google LLC, No. 2026-111 (Fed. Cir. Jan. 27, 2026).

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PETITION FOR A WRIT OF CERTIORARI

Petitioner Google LLC respectfully petitions for a writ of certiorari to review the judgment of the U.S. Court of Appeals for the Federal Circuit.

OPINIONS BELOW

The opinion of the court of appeals (App. 1a-2a) is available at 2026 WL 204945. The opinion of the Patent and Trademark Office denying Google LLC's petitions for inter partes review (App. 3a-5a) is available at 2025 WL 1913566.

JURISDICTION

The judgment of the court of appeals was entered on January 27, 2026. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

STATUTE INVOLVED

The relevant provision is reproduced in the appendix. App. 15a.

INTRODUCTION

In a stark departure from the Patent Act and decades of administrative practice, the Patent and Trademark Office has recently announced that it will ordinarily refuse to evaluate the validity of patents over six years old on the ground that patentees are entitled to rely on them regardless of their validity. This case presents two questions: first, whether that unprecedented and unsupported action exceeds the PTO's statutory authority, and second, whether the Article III courts are powerless to review that pure question of law. The Federal Circuit has held that courts lack *any* power whatsoever to review whether the PTO has violated the patent statutes in denying inter partes re-

view (IPR)—no matter how outrageous the PTO's violation of its statutory authority. That abdication of judicial review flies in the face of the bedrock Article III principle that it is the federal courts, not administrative agencies, that have the authority and duty to determine the bounds of agency discretion. See *Loper Bright Enters.* v. *Raimondo*, 603 U.S. 369 (2024). And the Federal Circuit's posture has left the PTO free to sharply reduce administrative review of patent validity on grounds that are directly contrary to Congress's statutory design. This Court's review is urgently needed.

The PTO has exceeded its statutory authority by adopting the frequently dispositive presumption that it will refuse to review the validity of a patent more than six years old—thus conjuring from whole cloth a limitations period that Congress deliberately withheld. The PTO's stated justification for its presumption—that the patent's six-year age gives the patentee a "settled expectation" of avoiding administrative reconsideration—contradicts a fundamental premise of the patent system. Under the Patent Act, patentees *never* obtain any "settled expectation" against administrative reconsideration because patents are granted subject to the statutory condition that they may be administratively canceled at any point *throughout their term*. Accordingly, despite providing certain time limits governing IPR petitions, Congress conspicuously did *not* establish any limitations period based on patent age. That was for good reason. An invalid patent confers no valid property rights regardless of age. And older invalid patents fall within the heartland of the problem Congress sought to address by creating inter partes review: such patents are often used by nonpracticing entities to stymie innovation and competition. The PTO therefore had no authority to foreclose inter

partes review based on patent age, and no authority to expand patentees' rights by granting an immunity from administrative reconsideration that Congress withheld.

The Federal Circuit held that it was powerless to review whether the PTO's "settled expectations" presumption exceeds its statutory authority. That conclusion rested on several fundamental legal errors. Although the decision to decline to institute inter partes review is generally committed to the PTO's discretion, agency discretion is always bounded by statute. No agency has discretion to exceed the statutory limits Congress places on its power—and, as the Court made clear in *Loper Bright*, the courts presumptively retain the responsibility to determine the bounds of agency discretion. For those reasons, 5 U.S.C. 701(a)(2), which renders unreviewable decisions "to the extent" they are committed to the agency's discretion, does not prevent courts from determining the *extent* of the agency's discretion—particularly in adopting the sort of overarching presumptive rule at issue here. Several courts of appeals have held just that, in direct conflict with the Federal Circuit.

The Federal Circuit also believed that 35 U.S.C. 314(d), which provides that the decision "whether to institute * * * review" is "final and nonappealable," entirely precludes courts from reviewing the PTO's legal conclusions regarding its own statutory authority to deny institution. But this Court has recognized that judicial review should remain available where, as here, an agency "has engaged in 'shenanigans' by exceeding its statutory bounds." *SAS Inst., Inc.* v. *Iancu*, 584 U.S. 357, 371 (2018) (citation omitted). Indeed, any other construction of Section 314(d) would raise significant Article III concerns.

The questions presented concern matters of exceptional importance for the patent system and for administrative law generally. Emboldened by the Federal Circuit's grant of unchecked authority over institution of inter partes review, the PTO has sharply reduced the procedure's availability in order to promote the "reliability" of issued patents; "settled expectations" denials are the linchpin of that effort. But as Congress determined, invalid patents should not be relied on; they cause significant real-world harm that inter partes review is supposed to address. The PTO has nonetheless given patentholders—including nonpracticing entities whose business is to enforce patents against innovative companies—a roadmap to circumvent the procedure entirely. And the PTO need not stop there; it could eliminate inter partes review altogether by refusing to institute review in *all* cases, or it could (and indeed has begun to) categorically exclude disfavored petitioners from the procedure. Making matters worse, all of those arrogations of authority would be equally unreviewable under the Federal Circuit's view.

This Court's review is therefore necessary to establish that the PTO lacks authority to deny institution based on patent age and that the Article III courts remain the arbiters of the scope of agency authority.

STATEMENT OF THE CASE

A. 1. A patent is a "public franchise" that the government grants to an inventor, conferring on him the exclusive right to make and use the invention disclosed in the patent. *Oil States Energy Servs., LLC* v. *Greene's Energy Grp., LLC*, 584 U.S. 325, 335 (2018). Under the Patent Act of 1952, the PTO may issue patents to those inventions that satisfy the Act's condi-

tions for patentability, including novelty (i.e., the invention was not previously "available to the public"), 35 U.S.C. 102, and nonobviousness in light of "the differences between the claimed invention and the prior art," 35 U.S.C. 103. See *Cuozzo Speed Techs., LLC* v. *Lee*, 579 U.S. 261, 266 (2016).

2. Congress has long recognized that the PTO makes mistakes and that "[s]ometimes * * * bad patents slip through." *SAS Inst.*, 584 U.S. at 360. Indeed, one forthcoming study estimates that 39 percent of recently litigated patents have been at least partially invalidated as non-novel or obvious. Shawn Miller, *Maintaining a Speedy and Robust IPR Process Should Be a Major Focus of John Squires' Patent Quality Efforts*, PatentlyO (June 6, 2025).[1] Because the PTO receives hundreds of thousands of patent applications every year, and patent examiners spend only 20 hours on average with each application, examiners often miss prior art and erroneously grant patents. Gov't Accountability Off., GAO-25-107218, *Patent Office Should Strengthen Its Efforts to Address Persistent Examination and Quality Challenges* 9 (2025).[2]

Invalid patents impose significant costs on third parties in the same technical domain, as those parties must license the patent or design around it—or risk a costly and lengthy infringement suit. See Am. Intell. Prop. L. Ass'n, *Report of the Economic Survey* 41 (2017) (median cost of litigating one claim of a high-value patent is $3 million). Older invalid patents—those nearing the end of their 20-year term—can be particularly harmful to innovation. While patentees

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[1] https://patentlyo.com/patent/2025/06/maintaining-process-quality.html.

[2] https://www.gao.gov/assets/gao-25-107218.pdf.

who obtain patents in the course of developing actual products "predominantly enforce their patents soon after they issue," Brian J. Love, *An Empirical Study of Patent Litigation Timing*, 161 U. Pa. L. Rev. 1309, 1312 (2013), "nonpracticing" entities (NPEs) that acquire patents for the purpose of monetizing them via litigation tend to focus on acquiring and asserting late-term patents. See *ibid.*; Fed. Trade Comm'n, *Patent Assertion Entity Activity* 139 (Oct. 2016) (FTC investigation finding that patents owned by litigation-focused NPEs average nearly 14 years old).[3] According to some calculations, NPE lawsuits cost society "billions of dollars." James Bessen et al., *The Private and Social Costs of Patent Trolls*, 34 Regulation 26, 26-28, 34-35 (Winter 2011-2012).[4]

3. a. Since the very first patent statutes, Congress has provided for both judicial and administrative processes to address such "bad patents." A defendant sued for infringement can raise a defense of patent invalidity. *E.g.*, Act of Apr. 10, 1790, ch. 7, § 6, 1 Stat. 109, 111. Administrative avenues have existed since 1836, when Congress first gave the PTO authority to declare an "interference" to determine inventorship. *Morgan* v. *Daniels*, 153 U.S. 120, 125 (1894).

In the past 50 years, Congress established various forms of administrative "reexamination," all of which permitted the PTO to reexamine a patent's validity at any time during the patent's term. Pub. L. No. 96-517, § 1, 94 Stat. 3015, 3015-3016 (1980); Pub. L. No. 106-

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[3] https://www.ftc.gov/system/files/documents/reports/patent-assertion-entity-activity-ftc-study/p131203_patent_assertion_entity_activity_an_ftc_study_0.pdf.

[4] https://www.cato.org/sites/cato.org/files/serials/files/regulation/2012/5/v34n4-1.pdf.

113, § 4604, 113 Stat. 1501, 1501A-567 (1999); see generally *Oil States*, 584 U.S. at 330. Although their procedural details differed, the aim was to provide "an effective and efficient alternative to often costly and protracted district court litigation." H.R. Rep. No. 112-98, at 45 (2011); see also H.R. Rep. No. 96-1307, at 3 (1980). In practice, however, procedural limitations made reexamination proceedings cumbersome, time-consuming, and underused. H.R. Rep. No. 112-98, at 45. Accordingly, by 2011, Congress recognized that "questionable patents are too * * * difficult to challenge" through either litigation or existing reexamination procedures. *Id.* at 39, 45.

b. Congress therefore created inter partes review as an "efficient system for challenging patents that should not have issued." H.R. Rep. No. 112-98, at 39-40; Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (AIA). As this Court has explained, inter partes review protects "the public's paramount interest in seeing that patent monopolies are kept within their legitimate scope." *Oil States*, 584 U.S. at 336-337 (citation omitted).

Consistent with Congress's desire for a more streamlined, widely available means of canceling invalid patents, inter partes review can be sought by any "person"; it is available for all patents, regardless of issue date; and it can be sought beginning nine months after patent issuance, through the patent's full remaining term and even after its expiration.[5] 35 U.S.C. 311; H.R. Rep. No. 112-98, at 47. The only time limit that Congress elected to impose is that when a party

[5] For nine months after issuance, patents may be challenged in a distinct proceeding, "post-grant review," as invalid on any statutory ground. 35 U.S.C. 321.

that has been sued for infringement seeks inter partes review of the asserted patents, the IPR petition must be filed within one year of service of the complaint. 35 U.S.C. 315(b). The purpose of that deadline "is to minimize burdensome overlap between" the two proceedings. *Thryv, Inc.* v. *Click-To-Call Techs., LP*, 590 U.S. 45, 56 (2020).

Inter partes review begins with a petition to cancel a patent for obviousness or lack of novelty based on patents or printed prior art. 35 U.S.C. 311. The PTO "may not authorize an inter partes review to be instituted unless the Director determines" that the petitioner has shown "a reasonable likelihood that the petitioner would prevail" in establishing invalidity. 35 U.S.C. 314(a). If inter partes review is instituted, the Patent Trial and Appeal Board (PTAB) adjudicates validity. 35 U.S.C. 318(a).

c. Consistent with its focus on efficiency, Congress limited judicial review of the institution decision, providing that "whether to institute an inter partes review under this section shall be final and nonappealable." 35 U.S.C. 314(d). This Court has held that Section 314(d) precludes review of "ordinary" "questions that are closely tied to the application and interpretation of statutes related to the Patent Office's decision to initiate inter partes review," but does not categorically foreclose review where the PTO has "act[ed] outside its statutory limits." *Cuozzo*, 579 U.S. at 275; see also *Thryv*, 590 U.S. at 53-54.

The Court has further stated that because Section 314(a) does not *require* the PTO to institute inter partes review, "the agency's decision to deny a petition is a matter committed to the Patent Office's discretion." *Cuozzo*, 579 U.S. at 273 (citing 5 U.S.C.

701(a)(2)). The PTO has traditionally used that discretion to prioritize resources, for instance, by limiting potentially serial petitions. See, *e.g.*, *Gen. Plastic Indus. Co.* v. *Canon Kabushiki Kaisha*, 2017 WL 3917706, at *7 (P.T.A.B. Sept. 6, 2017).

The Federal Circuit has extended *Cuozzo* and *Thryv* to hold that the PTO's denial of institution cannot be reviewed even when the challenger claims that the PTO has exceeded its statutory authority or acted ultra vires. See *Mylan Lab'ys Ltd*. v. *Janssen Pharmaceutica, N.V.*, 989 F.3d 1375, 1382 (Fed. Cir. 2021) (only constitutional claims are reviewable).

B. 1. From the AIA's enactment until 2025, the PTO instituted inter partes review in approximately 65% of cases. Since 2025, that rate has "plummeted" to 37%, coinciding with the PTO's implementation of significant measures designed to reduce the availability and frequency of inter partes review. Eileen McDermott, *USPTO Stats Show IPR Institution Rate Has Plummeted by 43%*, IP Watchdog (Apr. 8, 2026).[6]

The PTO has asserted that inter partes review undermines the "reliability of patent rights"—even though the only patents for which review may be instituted under 35 U.S.C. 314(a) are those for which the agency concludes that there is a "reasonable likelihood" that the patent is invalid. See Revision to Rules of Practice before the Patent Trial and Appeal Board, 90 Fed. Reg. 48,335, 48,336-48,337 (Oct. 17, 2025). The PTO's leadership has also publicly stated that inter partes review's provision of "reconsideration by anyone at any time" impairs the "stability" that purportedly should be enjoyed by patentholders. See Ryan

[6] https://ipwatchdog.com/2026/04/08/uspto-stats-show-ipr-institution-rate-plummeted/.

Davis, *Stewart Says New Patent Policies Aim To Bring Stability*, Law360 (Sept. 8, 2025).[7]

The PTO has accordingly used its ability to discretionarily deny institution to make fewer patents subject to inter partes review. In March 2025, for instance, the PTO announced that in response to every petition, the PTO Director would first decide whether to deny institution for discretionary reasons without considering the petition's merits, and reach the "reasonable likelihood" question only if the petition was not discretionarily denied first. App. 8a-9a (March memorandum). That process was later collapsed into one step. App. 12a-13a (October memorandum). The PTO has also proposed to discretionarily deny institution unless petitioners agree to waive the right to assert *in court* those validity challenges that are available only in court. See, *e.g.*, 90 Fed. Reg. 48,335.

2. As relevant here, the PTO also announced that it would begin denying institution based on the age of the challenged patent, or what it describes as the "[s]ettled expectations" of the patentholder based on "the length of time the [patent] claims have been in force." App. 10a (March memorandum). Specifically, the PTO now holds that expectations become "settled" six years after a patent's issuance. See *Kahoot! AS* v. *Interstellar Inc.*, 2025 WL 2176613, at *1 (U.S.P.T.O. July 31, 2025) ("[T]he challenged patent has been in force for over six years, creating strong settled expectations."). The PTO appears to have drawn the six-year benchmark from an analogy to the six-year limitations period for seeking damages in district-court patent infringement actions. *Dabico Airport Solutions Inc.* v. *AXA Power ApS*, 2025 WL 1710080 (U.S.P.T.O.

[7] https://www.law360.com/articles/2364638/.

June 18, 2025); 35 U.S.C. 286. The PTO has designated *Dabico* and several other "settled expectations" decisions as "informative" for future cases, thus solidifying the doctrine. U.S. Pat. & Trademark Off., *USPTO Designates Discretionary Considerations Decisions as Precedential and Informative* (Jan. 9, 2026).[8]

The PTO has now denied hundreds of IPR petitions based on the patentholder's purportedly "settled expectations," and in many of those cases, the age of the challenged patent alone was the dispositive factor. See Brief of US*Made, Addendum, No. 2026-111 (Fed. Cir. Jan. 27, 2026) (compiling cases); *e.g.*, *Yangtze Memory Techs. Co.* v. *Micron Tech., Inc.*, 2025 WL 2369973, at *1 (U.S.P.T.O. Aug. 14, 2025).

Subsequent decisions establish that the PTO applies "settled expectations" as a frequently dispositive presumption in favor of discretionary denial. One study showed that over several months in 2025, the PTO discretionarily denied the overwhelming majority of IPR petitions involving patents at least six years old, based at least in part on "settled expectations." Forrest A. Jones et al., *Unpacking the PTAB's Patent Age Denial Doctrine Data*, Finnegan (Aug. 29, 2025) (chart).[9] In addition, a patentholder need not provide any *evidence* of its settled expectations, but need only cite patent age (as happened here). The petitioner must then persuade the PTO that inter partes review should nonetheless be instituted. The PTO's examples of reasons that might overcome a patent's six-year age—namely, a material post-issuance change in law,

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[8] https://www.uspto.gov/subscription-center/2026/uspto-designates-discretionary-considerations-decisions-precedential-and.

[9] https://www.finnegan.com/en/insights/articles/unpacking-the-ptabs-patent-age-denial-doctrine-data.html.

or the existence of concrete reasons that the petitioner did not seek review even before the patent was enforced against it—indicate that extraordinary or at least unusual circumstances are necessary. See *Intel Corp.* v. *Proxense LLC*, 2025 WL 1776674 (U.S.P.T.O. June 26, 2025).

In sum, the PTO treats patent age over six years as warranting denial of institution in virtually all cases. Unsurprisingly, that has had a significant impact on inter partes review. As noted, since 2025, the institution rate has decreased significantly. Between the October 2025 proposed rulemaking and the end of 2025, the PTO processed 105 IPR petitions, denied *99* of those on discretionary grounds, denied two on the merits, and instituted review in only four. Dennis Crouch, *So You're Telling Me There's a Chance*, PatentlyO (Dec. 1, 2025).[10]

C. On January 31, 2025, Google filed IPR petitions challenging (as relevant here) a patent that respondent VirtaMove, Corp., had asserted against Google in litigation. That patent issued in 2010. VirtaMove urged the PTO to discretionarily deny institution, arguing that it had "settled expectations." C.A. App. 299, 323. Apart from that argument in its brief, VirtaMove did not introduce any evidence of its expectations. See *ibid.*

The PTO denied institution on the ground that "the challenged patent[] ha[s] been in force for more than 14 years, creating strong settled expectations." App. 4a. The PTO identified no other factors supporting its decision.

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[10] https://patentlyo.com/patent/2025/12/telling-theres-institution.html.

In accordance with Federal Circuit precedent, Google sought judicial review by filing a mandamus petition. See *Mylan*, 989 F.3d at 1381-1382. The Federal Circuit denied relief based on prior decisions, in particular, *In re Cambridge Industries USA Inc*. App. 1a-2a.

In *In re Cambridge*, the Federal Circuit held that it was powerless to review whether the PTO's settled-expectations denials exceeded its statutory authority. Because "Congress committed institution decisions to the Director's discretion," and "protected exercise of that discretion from judicial review" through Section 314(d), the court stated, "we do not decide * * * whether the use of this factor"—i.e., patent age—"exceeds the PTO's authority." 2025 WL 3526129, at *2-*3 (Fed. Cir. Dec. 9, 2025). In the court's view, the PTO's denial of institution could be reviewed, if at all, only for constitutional claims. *Id*. at *2.

In addressing Google's petition, the Federal Circuit held that "Google ha[d] not shown a right to a different conclusion here" than in *In re Cambridge*. App. 2a.

REASONS FOR GRANTING THE PETITION

This Court should grant certiorari because the PTO has asserted sweeping authority to vitiate the inter partes review system by refusing to institute review based on patent age, and the Federal Circuit has held that Article III courts are powerless to police that blatant transgression of the PTO's statutory authority. The PTO has no authority to create a limitations period where Congress did not, and it has no authority to expand patent rights beyond what Congress provided. And contrary to the Federal Circuit's decisions, 5 U.S.C. 701(a)(2) and 35 U.S.C. 314(d) do not render courts helpless to address the PTO's disregard of its statutory bounds. The Federal Circuit's construction

of Section 701(a)(2) conflicts with precedents of this Court and other courts of appeals. And its similarly sweeping reading of Section 314(d)—immunizing all PTO legal conclusions, no matter how outlandish, from any judicial review—cannot be reconciled with the Article III presumption of review. This Court's review is urgently needed.

I. The PTO Lacks Statutory Authority To Deny Institution Based On A Patentholder's Purportedly "Settled Expectations" In Exploiting A Potentially Invalid Patent.

The PTO's practice of refusing to institute review based on the patentee's "settled expectations" in exploiting its patent—regardless of validity—contravenes the statutory scheme in at least two respects. The practice conflicts with Congress's decision not to impose any limitations period based on patent age. And it contradicts a fundamental premise of the patent system: patents are *always* subject to the statutory conditions on which they were granted, one of which is susceptibility to administrative review *throughout the patent's full term*. Patentees therefore never obtain any "settled expectation" of being free of administrative review. The PTO is impermissibly purporting to expand the rights conferred by a patent beyond what Congress provided.

A. 1. The PTO's now-habitual practice of denying institution for patents issued six or more years earlier is materially indistinguishable from a statute of limitations. The practice assures patentholders that if their patents are not administratively challenged within six years of issuance, they can ordinarily enjoy repose. See *Lozano* v. *Montoya Alvarez*, 572 U.S. 1, 14 (2014) (limitations periods promote "a 'policy of repose'

* * * and certainty"). Indeed, the PTO has justified its settled-expectations denials as promoting "stability" and "reliability" of granted patents (regardless of their validity). See p. 9, *supra*. And although the PTO has stated that it can decline to enforce its patent-age rule in unusual cases, the same is true of limitations periods, which are generally subject to equitable exceptions.

Congress, however, quite deliberately omitted from the AIA any statute of limitations for inter partes review based on the time elapsed since the patent's issuance. Instead, the sole deadline that applies to inter partes review is based on the interaction of inter partes review with litigation: when an IPR petitioner challenges a patent in response to infringement litigation, that petition must be filed within one year of service of the infringement complaint. See 35 U.S.C. 315(b); *NHK Spring Co.* v. *Intri-Plex Techs., Inc.*, 2018 WL 4373643, at *7 (P.T.A.B. Sept. 12, 2018). The purpose of that time limit has nothing to do with fostering repose: instead, it "minimize[s] burdensome overlap" between the two proceedings. *Thryv*, 590 U.S. at 56.

The fact that the AIA's sole filing deadline runs from the commencement of infringement litigation reflects a critical insight: because the vast majority of patents are never enforced and have little commercial value, commercial actors have no reason to challenge a patent—*and may not even know the patent exists*—until the patentee enforces it or threatens to enforce it. S. Rep. No. 110-259, at 21 n.98 (2008). In other words, Congress fully anticipated that patents might not be challenged until years after they were issued—because no one would have any reason to do so—and it chose to enact a filing deadline keyed to patent *enforcement* rather than patent *issuance*.

Indeed, Congress knew well how to establish an administrative-review time limit that runs from patent issuance. The AIA establishes post-grant review as a separate avenue for challenging a patent shortly after its issuance, enabling third parties to immediately challenge a patent on any ground of invalidity. 35 U.S.C. 321. A petition for post-grant review must be filed within 9 months of the patent's issuance. 35 U.S.C. 321(c). After that point, a patent challenger may file a petition for inter partes review at any point throughout the life of the patent (and even after it has expired). 35 U.S.C. 311(c). Congress thus deliberately created a system in which a patent's validity can be challenged before the PTO at any time—without any age-based time limit. See *Corner Post, Inc*. v. *Bd. of Governors of Fed. Rsrv. Sys*., 603 U.S. 799, 812 (2024) (Congress knows how to choose different accrual rules, and its choice of one over another is significant).

The AIA thus reflects a congressional policy judgment that patentees do *not* have any traditional interest in repose with respect to invalidity challenges—that is, the patent's age never gives rise to an expectation that the patent will not be subject to administrative review. That makes sense. A patent that should not have been granted in the first place is no less invalid in the nineteenth year of its term than it was in the first—and that patent remains enforceable (and thus able to stymie innovation and competition) through six years after its expiration. Indeed, older invalid patents may well inflict *more* harmful effects than newer patents. See pp. 5-6, *supra*. The importance of correcting the PTO's initial error in granting the patent thus does not diminish with time.

In addition, none of the traditional concerns underlying limitations periods are present in the patent-validity context. As Congress's choice of an enforcement-based time limit reflects, the fact that a party challenges a patent years after issuance does not mean that the challenger's claim is "stale." It serves no interest within the patent system to foreclose a challenge to a patent simply because the patentee did not assert it until more than six years after issuance. And the invalidity grounds tried in inter partes review—all based on patents and printed prior art, 35 U.S.C. 311(b)—do not become more difficult to prove or disprove over time.

Congress thus deliberately omitted an age-based limitations period from the AIA—meaning that the AIA itself prevents patentholders from ever acquiring "settled expectations" against administrative challenge. The PTO therefore lacks authority to impose a limitations period—whether through formal rule or, as here, consistent practice. See, *e.g.*, *Mohasco Corp.* v. *Silver*, 447 U.S. 807, 825 (1980) (agency may not supplement or extend Congress's statutory limitations period); *Schneider* v. *Chertoff*, 450 F.3d 944, 958 (9th Cir. 2006). Indeed, this Court has held in the patent context that "courts are not at liberty to jettison Congress' judgment on the timeliness of suit" using judicial timeliness doctrines. *SCA Hygiene Prods. Aktiebolag* v. *First Quality Baby Prods., LLC*, 580 U.S. 328, 335 (2017). That conclusion applies a fortiori to an administrative agency like the PTO.

2. The PTO's practice of denying institution based on "settled expectations" contravenes the Patent Act in a second respect: it eliminates a condition of the patent grant, effectively conferring on patentholders a new right against administrative challenge.

"[T]he patentee's rights are 'derived altogether' from statutes, 'are to be regulated and measured by these laws, and cannot go beyond them.'" *Oil States*, 584 U.S. at 338 (quoting *Brown* v. *Duchesne*, 60 U.S. (19 How.) 183, 195 (1856)). Congress therefore may establish "conditions" that limit the rights conferred on the patentee. *Graham* v. *John Deere Co. of Kansas City*, 383 U.S. 1, 6 (1966). "[I]nter partes review is one of those conditions"—and, as noted, Congress placed no time bar on seeking inter partes review. *Oil States*, 584 U.S. at 342. As a result, the rights conferred by a patent are *always* subject to administrative cancellation on the ground that the agency made a mistake in granting the patent in the first place. See *ibid*.

By refusing to institute inter partes review solely based on patent age, the PTO grants patentees a new and distinct right or expectation that the Patent Act withholds: a right to be free of administrative cancellation after six years. But there is no adverse possession in patent law—and the agency has no authority to create such a doctrine. Because patents are entirely creatures of statute, a patentholder only acquires rights by operation of the Patent Act—not by PTO fiat.

The PTO's assertion of authority is particularly problematic because the purpose of inter partes review is to enable the agency to correct its own mistakes. See 35 U.S.C. 318. Congress has recognized that the PTO often errs in granting patents, and that those errors inflict real-world harms on competitors and would-be innovators in the field. See pp. 5-7, *supra*. Indeed, when the PTO wrongly grants a patent, it erroneously takes technology that should be in the "public domain," and permits a single party—who did not actually invent anything deserving a patent—to exploit that technology and exclude the public for decades.

See *Graham*, 383 U.S. at 6. Yet the PTO is now refusing to correct its own errors on the ground that those errors have persisted for long enough that the errors' beneficiaries should be able to rely on them. That flies in the face of Congress's policy judgment—and it represents an extraordinary assertion of administrative authority to determine private parties' rights regardless of statutory direction.

B. The PTO's efforts to justify its settled-expectations denials all fail.

First, the PTO has analogized its settled-expectations approach to the six-year limitations period for infringement damages under 35 U.S.C. 286, saying that barring inter partes review based on a patent's age "aligns" with Section 286's "approach[] to settled expectations." *Dabico*, 2025 WL 1710080, at *1. That is a non sequitur. Section 286 is a traditional limitations period applicable to *infringement* actions, reflecting Congress's judgment that infringers should be liable only for six years of damages. *SCA Hygiene*, 580 U.S. at 334. But Congress declined to provide even that limited sort of repose for administrative challenges to patent *validity*. Section 286 is irrelevant in the context of inter partes review.

Second, the PTO's former Acting Director described settled-expectations denials as intended to protect property rights. Davis, *Stewart Says New Patent Policies Aim To Bring Stability* (analogizing patent to "the title to [one's] home"). That justification is equally misconceived. Again, any property rights conferred by a patent are limited by the potential for administrative cancellation—so a patentholder has no property right as against inter partes review. Just as fundamentally, if a patent was wrongly granted, it is invalid, and it confers no valid property rights *at all*—and the

whole point of inter partes review is to determine whether the patent was properly granted. Declining to institute inter partes review on the basis of a settled property right improperly assumes the conclusion in the patentholder's favor—and preserves a public franchise that should never have been granted.

II. The Federal Circuit Erred In Holding That The PTO's Transgression Of Statutory Limits Is Never Subject To Judicial Review.

The Federal Circuit has held that the PTO has unreviewable discretion to deny institution on any ground whatsoever—and that, absent constitutional concerns, the courts are powerless to step in even if the PTO blatantly exceeds its statutory authority. App. 1a (citing *In re Cambridge*, 2025 WL 3526129, at *3); *Mylan*, 989 F.3d at 1382. But defining the statutory limits on agency discretion is the fundamental province and duty of the Article III courts. Neither Section 701(a)(2) nor Section 314(d) prohibits courts from reviewing the statutory extent of the PTO's authority—certainly not with the explicitness that the presumption of review and Article III would require.

A. Section 701(a)(2) of the APA does not prevent courts from reviewing the statutory limits on agency discretion.

1. Contrary to the Federal Circuit's view, this Court's observation that denying institution "is a matter committed to the Patent Office's discretion," *Cuozzo*, 579 U.S. at 273 (citing 5 U.S.C. 701(a)(2)), is the beginning of the inquiry, not the end. Section 701(a)(2) makes unreviewable actions within the scope of agency discretion. It does not forbid courts from determining the *extent* of that discretion.

Section 701(a)(2) provides that judicial review is not available "*to the extent that* * * * agency action is committed to agency discretion by law." 5 U.S.C. 701(a)(2) (emphasis added). The provision thus recognizes that there are *always* limits to agency discretion: because "[a]dministrative agencies are creatures of statute," they "possess only the authority that Congress has provided." *NFIB* v. *Dep't of Lab.*, 595 U.S. 109, 117 (2022) (per curiam). Even where an agency has broad discretion to make a particular decision, the outer limits of that discretion are always defined by statute. See *Heckler* v. *Chaney*, 470 U.S. 821, 833 (1985); *Citizens to Pres. Overton Park, Inc.* v. *Volpe*, 401 U.S. 402, 415 (1971) (a court must determine whether an agency "acted within the scope of [its] authority").

The Court has accordingly "read the exception" to judicial review "in § 701(a)(2) quite narrowly," holding that it forecloses review only in the "rare circumstances" where there is no "law to apply" in judging the agency's exercise of discretion. *Weyerhaeuser Co.* v. *U.S. Fish & Wildlife Serv.*, 586 U.S. 9, 23 (2018); *Heckler*, 470 U.S. at 834. Where the claim is that an agency's action contravened a statute, there is, of course, "law to apply"—the statute. *Heckler*, 470 U.S. at 834. Indeed, as this Court has long held, courts can review agency action to determine whether the agency "has relied on factors which Congress has not intended it to consider." *Motor Vehicle Mfrs. Ass'n* v. *State Farm Mut. Auto. Ins. Co.*, 463 U.S. 29, 43 (1983).

This Court reaffirmed those principles in *Loper Bright*. There, the Court acknowledged that Congress may "confer discretionary authority on agencies," including to engage in "discretionary policymaking." 603 U.S. at 404. But the Court emphasized that courts

retain an "obligation[] under the APA" and under Article III principles to "police the outer statutory boundaries of those delegations and ensure that agencies exercise their discretion consistent" with statutory constraints. *Ibid*.; *id*. at 395 (explaining that where a statute "delegates discretionary authority to an agency," a court's role "is, as always, to independently interpret the statute" and "'fix[] the boundaries of [the] delegated authority'").

The Federal Circuit's refusal to "police the outer statutory boundaries" of the PTO's discretion to deny institution cannot be reconciled with *Loper Bright*. 603 U.S. at 404. To be sure, the PTO has some discretion to deny institution under 35 U.S.C. 314(a)—for instance, where the agency concludes that a petition has been filed for harassing reasons or is incomprehensible. Nothing in the Patent Act suggests that the agency may not deny institution for such reasons, leaving no "law to apply" in reviewing such a denial. *Heckler*, 470 U.S. at 834. But where, as here, the claim is that the PTO has exceeded its statutory authority by denying institution based on a factor that contradicts the statute, the reviewing court has ample law to apply—and therefore the ability and obligation to determine the bounds of the PTO's statutory authority. *Loper Bright*, 603 U.S. at 404; *Weyerhaeuser,* 586 U.S. at 23.[11]

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[11] The Federal Circuit has analogized the PTO's decision to deny institution to an agency's decision not to institute enforcement proceedings. *Mylan*, 989 F.3d at 1382. But the two are completely different. Because enforcement decisions rest on "complicated" policy balancing, there is generally no law to apply in assessing such decisions. *Heckler*, 470 U.S. at 831. That is not true of the statutory question presented here. In addition, here

(footnote continued)

Indeed, it should be particularly clear that Section 701(a)(2) does not bar review here. The PTO's "settled expectations" practice—announced as the PTO's overarching position and presumptively applied in cases involving patents over six years old, including this one—is much more akin to a *rule* than to an exercise of case-by-case discretion. And it is a rule that, like any limitations period, affects parties' substantive rights. Even where agencies have statutory discretion to promulgate such rules, no one would think that the courts lack power to review those rules for compliance with statutory limits. *Loper Bright*, 603 U.S. at 404.

2. The Federal Circuit's holding that Section 701(a)(2) bars courts from reviewing the limits of an agency's discretion conflicts with the decisions of other circuits.

In *Farmworker Justice Fund, Inc.* v. *Brock*, the D.C. Circuit held that courts must adjudicate whether an agency has exceeded the *scope* of its discretion even when Congress has committed some discretion to the agency. 811 F.2d 613, *vacated on mootness grounds*, 817 F.2d 890 (1987). There, the court emphasized that Section 701(a)(2) provides that agency decisions are not subject to review "*to the extent*" that they are committed to agency discretion, and that "[w]hatever the extent of a particular agency's discretion under a particular statute, it does not encompass the authority to contravene statutory commands." *Id*. at 622. As a re-

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the agency has "infringe[d] upon areas that courts often are called upon to protect." *Id.* at 832. The PTO's determination directly affects *Google's* property rights because the PTO's grant of patents to VirtaMove carved out "from the public rights of immense value and bestow[ed] them upon" VirtaMove. *Oil States*, 584 U.S. at 335; see pp. 4-5, 18-19, *supra*.

sult, the court concluded, even when it would be "impossible" for a court to review an agency's consideration of factors within its discretion, "the court can—and must—review the agency's decision to determine that the agency has acted 'within the scope of [its] authority,' and did not rely on "'factors that the Congress has not intended it to consider.'" *Ibid*. (citing *Heckler*, *Overton Park*, and *State Farm*). The court therefore proceeded to review (and agree with) the challenger's contention that the agency had exercised its discretion based on a statutorily impermissible factor.

The First and Second Circuits have reached the same conclusion about Section 701(a)(2). In *Ward* v. *Skinner*, the First Circuit explained that despite the Transportation Department's very broad discretion as to whether to waive certain statutory requirements, the petitioner contended that the Secretary had declined to issue a waiver based on a consideration that was statutorily impermissible. 943 F.2d 157, 160 (1991). The court therefore concluded that there was "law to apply," and that the "legal issue is simply whether the denial of a waiver for this reason violated the Act." *Ibid*.

In *Rodriguez* v. *Mayorkas*, the Second Circuit rejected the argument that Section 701(a)(2) barred review of the government's refusal to waive a noncitizen's inadmissibility where the noncitizen argued that the agency had failed to consider a statutorily required factor. 2024 WL 4023841, at *2 (Sept. 3, 2024). The court explained that the legal question concerning the agency's compliance with Congress's "directive[]" fell "squarely within our constitutional mandate for review of agency action, even if the agency's ultimate decision on the matter is otherwise committed to its discretion." *Ibid*.

The Federal Circuit's decision squarely conflicts with those decisions. After observing that institution was to some extent committed to the PTO's discretion, the Federal Circuit went no further. But the D.C., First, and Second Circuits would have examined the statutory scope of that discretion. Indeed, in both *Brock* and *Rodriguez*, the courts concluded that despite Congress's conferral of broad discretion on the agencies in question, the agencies had exercised their discretion based on a statutorily impermissible factor—exactly what Google contends the PTO has done here, and what the Federal Circuit has refused to adjudicate.

B. Section 314(d) of the AIA does not bar review here.

This Court also should review the Federal Circuit's holding that Section 314(d) bars review of whether the PTO exceeded its statutory authority here. App. 1a-2a.

1. Section 314(d) provides that "[t]he determination by the Director whether to institute an inter partes review under this section shall be final and non-appealable." 35 U.S.C. 314(d). In interpreting the preclusive scope of such provisions, courts apply a "'strong presumption' in favor of judicial review." *Cuozzo*, 579 U.S. at 273 (citation omitted).

This Court has found Section 314(d) applicable twice. In both *Cuozzo* and *Thryv*, a patentee whose patent was canceled in inter partes review contended that the PTO should not have instituted review in the first place, raising an "ordinary" challenge to the PTO's "application" of the statutory requirements for institution. *Cuozzo*, 579 U.S. at 273; *Thryv*, 590 U.S. at 54. The Court held that Section 314(d) bars review

"where the grounds for attacking the decision to institute inter partes review consist of questions that are closely tied to the application and interpretation of statutes related to the Patent Office's decision to initiate inter partes review." *Cuozzo*, 579 U.S. at 274-275. At the same time, in light of the presumption of judicial review, the Court explained that Section 314(d) likely would not "categorically preclude review" in a way that would "enable the agency to act outside its statutory limits." *Id.* at 275. Instead, where "a party believes the Patent Office has engaged in 'shenanigans' by exceeding its statutory bounds, judicial review remains available." *SAS Inst.*, 584 U.S. at 371 (quoting *Cuozzo*, 579 U.S. at 275); *ibid.* ("[N]othing in § 314(d) or *Cuozzo* withdraws our power to ensure that an inter partes review proceeds in accordance with the law's demands.").

That description fits Google's statutory-authority claim to a tee—and thus under *Cuozzo* and *Thryv* themselves, Section 314(d) does not bar Google's challenge. That conclusion is reinforced by the fact that Google's challenge does not implicate Congress's concerns in enacting that provision. Section 314(d)'s direction that the decision "whether to institute an inter partes review" is final should be construed to prohibit second-guessing the institution decision *itself*. See *Thryv*, 590 U.S. at 53. After all, Congress was concerned that frequent appeals of mine-run institution decisions would prevent streamlined reconsideration of invalid patents. *Ibid.*; *Cuozzo*, 579 U.S. at 272. The challenges held to be barred in *Cuozzo* and *Thryv* were of that sort: they asked the courts to reverse institution decisions by reviewing the PTO's granular consideration of factors that the agency undisputedly had authority to consider. *Thryv*, 590 U.S. at 48; *Cuozzo*, 579 U.S. at 270.

By contrast, Google does not challenge the up-or-down decision (in Section 314(d)'s words) "whether to institute an inter partes review." 35 U.S.C. 314(d); *Cuozzo*, 579 U.S. at 274-275. Rather, Google challenges the PTO's rule-like use of patent age as a justification for denying institution in cases involving six-year-old patents. Google accordingly asked the Federal Circuit to hold that patent age is a statutorily impermissible consideration in the institution analysis and to "order the Director of the USPTO to reconsider whether to institute IPR without regard to the challenged patent's age." Mandamus Petition 4, No. 2026-111 (Fed. Cir. Nov. 20, 2025); see also *id.* at 37. Google's argument was thus not that the agency should have instituted inter partes review based on a correct application of permissible factors, but that the agency exceeded its authority by relying on a statutorily impermissible factor. Nothing in Section 314(d) requires the latter challenge to be immunized from judicial review. See *Bowen* v. *Mich. Acad. of Fam. Physicians*, 476 U.S. 667, 675 (1986) (under presumption of review, "statutory scheme" that "limits * * * review" of one determination should be construed not to limit challenges to others).

2. The Federal Circuit has nevertheless held that Section 314(d) bars all judicial review of whether the PTO has "act[ed] outside its statutory limits" with respect to the institution decision. *Cuozzo*, 579 U.S. at 275; see *In re Cambridge*, 2025 WL 3526129, at *2-*3. That construction goes well beyond *Cuozzo* and *Thryv*, which allow for the possibility of review of statutory-authority questions. The Federal Circuit has justified its contrary holding by overreading *Thryv*'s statement that under *SAS Institute*, courts may review the PTO's compliance with statutes governing the conduct of inter partes review *after* institution. See *Apple* v. *Vidal*,

63 F.4th 1, 12 n.5 (Fed. Cir. 2023); *Thryv*, 590 U.S. at 58-59. But *Thryv* did not thereby suggest that courts may not review the PTO's institution decisionmaking where, as here, the contention is that the PTO has exceeded its statutory authority by considering, in *all* cases, a statutorily impermissible factor.[12]

3. In all events, the Federal Circuit's construction of Section 314(d) cannot be reconciled with either the presumption of judicial review or Article III principles, and this Court should reject it.

Under Article III, the "final 'interpretation of the laws'" is "'the proper and peculiar province of the courts.'" *Loper Bright*, 603 U.S. at 385 (citation omitted). The "traditional conception of the judicial function" is that it is the *court* that must "'fix[] the boundaries of [the] delegated authority.'" *Id*. at 395-396 (citation omitted). Thus, the question whether the PTO has exceeded its authority by basing institution decisions on a factor that is inconsistent with the statutory scheme is a question of law that, under Article III, presumptively falls to the courts.

Congress could not possibly have intended to preclude all judicial review even where the agency has acted well outside of its statutory authority. Given the Article III concerns raised by stripping courts of power to review pure questions of law concerning an agency's statutory authority, Congress should have—and would have—been more explicit if it intended to override "the traditional understanding of the judicial function." *Loper Bright*, 603 U.S. at 394.

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[12] To the extent that this Court agrees with the Federal Circuit's understanding of *Thryv*'s construction of Section 314(d), that decision should be overruled for the reasons stated in text.

Indeed, the Federal Circuit's construction of Section 314(d) results in a breathtaking arrogation of unchecked authority to the PTO. The agency now enjoys free rein to remake inter partes review in any way it pleases. The PTO could conclude that certain disfavored categories of corporations are not "person[s]" entitled to seek inter partes review under Section 311(a) (and, indeed, has done so, see p. 32, *infra*), or that certain favored categories of patents (e.g., software patents) are not "patents" subject to inter partes review under Section 311(a). Cf. *Thryv*, 590 U.S. at 79 (Gorsuch, J., dissenting) (expressing concern about system that would allow PTO Director to "insulat[e] his favorite firms and industries from [IPR] entirely"). Or the PTO could simply refuse to institute inter partes review in *any* case—perhaps on the ground that "settled expectations" in a patent arise at issuance—simply because the agency disagrees with Congress's judgment that inter partes review is necessary and advisable. If the Article III presumption of review means anything, Section 314(d) must be construed to give way in those and other situations in which the agency exceeds its statutory limits.

III. The Petition Presents An Excellent Vehicle To Address Recurring Issues Of Exceptional Importance.

A. The questions presented are critically important.

1. The question whether the PTO has statutory authority to deny institution based on the age of the subject patent is of overriding importance to the patent system as a whole and the inter partes review framework in particular.

The central purpose of inter partes review is to provide an efficient alternative pathway for resolving validity issues that the challenger otherwise could bring only in litigation. At the time of the AIA's enactment, Congress understood that infringement litigation—in particular, over-enforcement of weak patents by nonpracticing entities—was imposing severe costs on innovative companies, especially companies active in areas of emerging technology. See pp. 5-7, *supra*; see generally Robert P. Merges & Richard R. Nelson, *On the Complex Economics of Patent Scope*, 90 Colum. L. Rev. 839, 867 n.119, 881-882 (1990).

Critically, Congress determined that litigation was not adequate to address the costs imposed by invalid patents: litigating validity costs millions of dollars and ordinarily takes years. See pp. 5-7, *supra*. Many companies accordingly may choose to execute settlements—leaving broad, vague, and invalid patents on the books to be enforced against others—rather than rolling the dice on litigation. See *Commil USA, LLC* v. *Cisco Sys., Inc.*, 575 U.S. 632, 646 (2015). Congress therefore created a streamlined means of administrative validity review—and it made that review available *at any time* starting nine months into a patent's term.

The PTO's denial of institution based on patent age is thus contrary to the very premise of the inter partes review system. The PTO's approach exempts a sweeping category of patents from administrative review for validity, relegating a significant portion of patent challenges to the very litigation route Congress deemed inadequate. Making matters worse, older patents are more likely to be used by nonpracticing entities to extract settlements regardless of validity—and thus they

are the patents for which a streamlined administrative avenue is most important and necessary. See p. 6, *supra*. The PTO's approach vitiates the very benefits Congress sought to achieve.

In addition, the PTO's arbitrary six-year benchmark provides a roadmap for avoiding inter partes review. An entity that wants to assert dubious patents without subjecting those patents to administrative review may simply wait until the six-year mark—a delay that will come easily to nonpracticing entities in particular, as they do not compete in the market, and that will not meaningfully reduce potential damages given the six-year damages window, *SCA Hygiene*, 580 U.S. at 346. It is no answer to say patent challengers should monitor newly issued patents and immediately challenge them: companies do not have the resources to monitor vast numbers of newly issued patents and predict those that might be asserted against them in the future, and the resulting flood of protective IPR petitions would swamp agency resources.

2. The question whether the courts are powerless to review the PTO's transgression of its statutory bounds in denying institution is also critically important.

This case provides a stark illustration of the dangers of insulating the PTO (or any agency) from judicial review. Buoyed by the Federal Circuit's decisions, the PTO has vastly expanded its discretionary denial practice, sharply reducing the availability of inter partes review. See pp. 9-10, *supra*. That unreviewable authority creates obvious risks of abuse. See p. 29, *supra*; *Thryv*, 590 U.S. at 79-80 (Gorsuch, J., dissenting). But the PTO's actual departures are troubling enough. The PTO has asserted authority to discretionarily

deny review without even considering whether the petition raises strong arguments of invalidity—thus raising the possibility that the agency will deny review in the cases that most warrant it. It has asserted discretionary authority to categorically exclude private entities affiliated with foreign governments from benefiting from inter partes review, even though private entities unquestionably are "persons" statutorily entitled to petition. *Tianma Microelectronics Co.* v. *LG Display Co.*, IPR2025-01579, Paper 12 (U.S.P.T.O. Mar. 18, 2026). That rationale carries clear potential for abuse. And it has asserted authority to deny review on a "settled expectations" ground that contradicts a fundamental premise of the patent system—that patents are granted on the conditions Congress provided, one of which is that patents are always subject to administrative cancellation on the basis that they should not have been granted in the first place.

Congress could not possibly have intended to give the PTO unreviewable authority to vastly alter the situations in which inter partes review is available and the categories of patents to which it applies. *Whitman* v. *Am. Trucking Ass'ns* 531 U.S. 457, 468 (2001) (Congress does not hide "elephants" in statutory "mouseholes"). Those are the quintessential sorts of questions that should at minimum be subject to judicial review for consistency with Congress's design.

The reviewability question also has significant administrative-law importance beyond the patent context. Under the Federal Circuit's reasoning, Section 701(a)(2) shields from judicial review *any* agency action pertaining to subject matter over which Congress has given the agency *some* discretion—leaving courts powerless to police the boundaries of that discretion.

That approach allows agencies to use delegated discretion as carte blanche to rewrite their statutes. And the U.S. Code is filled with provisions that, like Section 314(d), preclude or limit judicial review; the Federal Circuit's dismissive approach to the presumption of judicial review, if adopted more widely, could close courthouse doors to litigants bringing all manner of challenges to administrative action. The Court's review is needed to correct the Federal Circuit's misconceived approach to judicial review.

B. This case is an ideal vehicle, and the Court may not have many additional opportunities to address the questions presented.

This case is an ideal vehicle to address the questions presented. The Court regularly reviews legal issues presented in the context of mandamus petitions. *E.g.*, *TC Heartland LLC* v. *Kraft Foods Grp. Brands LLC*, 581 U.S. 258 (2017). The issues are squarely and cleanly presented: the PTO identified VirtaMove's "settled expectations" based on patent age as its sole basis for denying review, even after acknowledging that other considerations militated *against* discretionary denial. App. 4a. And both questions presented are unlikely to receive further ventilation in the Federal Circuit given its settled precedent and consequent refusal to review the legality of settled-expectations denials. See, *e.g.*, *In re Cambridge Indus.*, 2025 WL 3526129, at *2; *In re Sandisk Techs., Inc.*, 2025 WL 3526507, at *1 (Fed. Cir. Dec. 9, 2025).

In addition, there may not be suitable vehicles in the future. The PTO has now begun regularly denying institution in a summary fashion without any explanation. See App. 12a (October memorandum); Dennis

Crouch, *An Era of No: The USPTO's New 0% Institution Rate* (Nov. 12, 2025) (summary institution decisions following October 2025 memorandum "provide no reasoning or analysis").[13] In other words, the PTO has taken steps to *further* insulate its denial decisions from review, refusing to provide any explanation so that courts cannot determine whether the agency has overstepped its statutory bounds. Cf. *Overton Park*, 401 U.S. at 420 (agency explanation necessary to permit review). Going forward, decisions explaining that the PTO relied on a patent-age rationale (or any other rationale) will be increasingly rare.

In short, the Court will not have a better vehicle to address whether the patent-age rationale is reviewable and lawful under the patent statutes. And if the Court does not act now, it may not have *any* vehicle to do so. Given the importance of those questions—both to the patent system and to administrative law more broadly—the Court's immediate review is warranted.

[13] https://patentlyo.com/patent/2025/11/usptos-institution-rate.html.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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April 27, 2026

APPENDICES

APPENDICES

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APPENDIX A

No. 2026-111

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

In Re GOOGLE LLC,
Petitioner,

On Petition for Writ of Mandamus to the
United States Patent and Trademark Office in
Nos. IPR2025-00487 and IPR2025-00488.

January 27, 2026

ON PETITION AND MOTION

Before LOURIE, WALLACH, and STOLL, *Circuit Judges*.

Wallach, *Circuit Judge*.

The United States Patent and Trademark Office (PTO) denied Google LLC's petitions for *inter partes* review of VirtaMove, Corp.'s patent, reasoning the "patent[] ha[s] been in force for more than 14 years, creating strong settled expectations" and Google had not shown review would be an appropriate use of PTO resources. Appx2. Google now seeks a writ of mandamus directing the PTO to vacate that decision and to reconsider its petitions for IPR without consideration of those "settled expectations." The Director of the PTO and VirtaMove oppose the petition.

In recent decisions, this court considered and rejected similar challenges, by way of mandamus relief, to the PTO's use of "settled expectations" as a factor in denying institution of *inter partes* review. *See In re Cambridge Indus. USA Inc.*, No. 2026-101, 2025 WL 3526129 (Fed. Cir. Dec. 9, 2025) (denying mandamus relief based on arguments that use of "settled

expectations" violates separation of powers, exceeds statutory authority, and is arbitrary and capricious); *In re Sandisk Techs., Inc.*, No. 2025-152, 2025 WL 3526507 (Fed. Cir. Dec. 9, 2025) (same). Google has not shown a right to a different conclusion here based on *Celgene Corp. v. Peter*, 931 F.3d 1342, 1362 (Fed. Cir. 2019)—a case that did not involve or address the limits on our review of a denial-of-institution determination but rather whether final written decisions invalidating the challenged patent claims violated the Takings Clause.

Accordingly,

IT IS ORDERED THAT:

(1) The petition is denied.

(2) The unopposed motion at ECF No. 7 for leave to file a brief as amicus curiae is granted and the corresponding brief is accepted for filing.

FOR THE COURT

[Court Seal]

Jarrett B. Perlow
Clerk of Court

January 27, 2026
Date

APPENDIX B

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

GOOGLE LLC,
Petitioner,

v.

VIRTAMOVE, CORP.,
Patent Owner

IPR2025-00487 (Patent 7,519,814 B2)
IPR2025-00488 (Patent 7,519,814 B2)
IPR2025-00489 (Patent 7,784,058 B2)
IPR2025-00490 (Patent 7,784,058 B2)

Paper 11

July 11, 2025

Before KALYAN K. DESHPANDE,[1] *Acting Deputy Chief Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review

VirtaMove, Corp. ("Patent Owner") filed a request for discretionary denial of institution (Paper 8, "DD

[1] Coke Morgan Stewart, Acting Under Secretary of Commerce for Intellectual Property and Acting Director of the United States Patent and Trademark Office, is recused and took no part in this decision. The Acting Director has delegated her authority in a Notice of Delegation. *See* https://www.uspto.gov/sites/default/files/documents/deshpande-delegationletter.pdf.

Req.") in the above-captioned cases, and Google LLC filed an opposition (Paper 9, "DD Opp.").[2]

After considering the parties' arguments and the record, and in view of all relevant considerations, discretionary denial of institution is appropriate in these proceedings. This determination is based on the totality of the evidence and arguments the parties have presented.

Some factors counsel against discretionary denial. For example, there is currently no trial date set for the parallel district court proceeding involving Petitioner and the challenged patents. DD Opp. 6–7.

Other factors, however, weigh in favor of discretionary denial. In particular, the challenged patents have been in force for more than 14 years, creating strong settled expectations, and Petitioner does not provide any persuasive reasoning why an *inter partes* review is an appropriate use of Board resources. *Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 at 2–3 (Director June 18, 2025). In the absence of any such reasoning, the Office is disinclined to disturb Patent Owner's strong settled expectations.

Although certain arguments are highlighted above, the determination to exercise discretion to deny institution is based on a holistic assessment of all of the evidence and arguments presented. Accordingly, the Petitions are denied under 35 U.S.C. § 314(a).

In consideration of the foregoing, it is:

ORDERED that Patent Owner's request for dis-

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[2] Citations are to papers in IPR2025-00487. The parties filed similar papers in IPR2025-00488, IPR2025-00489, and IPR2025-00490.

cretionary denial is *granted*; and

FURTHER ORDERED that the Petitions are *denied*.

APPENDIX C

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

GOOGLE LLC,
Petitioner,

v.

VIRTAMOVE, CORP.,
Patent Owner

IPR2025-00487 (Patent 7,519,814 B2)
IPR2025-00488 (Patent 7,519,814 B2)
IPR2025-00489 (Patent 7,784,058 B2)
IPR2025-00490 (Patent 7,784,058 B2)[1]

Paper 14

October 1, 2025

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

ORDER

The Office received a request for Director Review of the Decision denying institution in each of the above-captioned cases and an authorized response to each

[1] This order applies to each of the above-listed proceedings.

request. *See* Papers 12, 13.[2]

Having reviewed the requests and responses, it is:

ORDERED that the requests for Director Review are denied.

[2] Citations are to the record in IPR2025-00487. The parties filed similar papers in IPR2025-00488, IPR2025-00489, and IPR2025-00490.

APPENDIX D

MEMORANDUM

To: All PTAB Judges

From: Coke Morgan Stewart [/s]
Acting Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office

Subject: Interim Processes for PTAB Workload Management

Date: October 1, 2025

The Patent Trial and Appeal Board (PTAB) is tasked with several statutory duties under 35 U.S.C. § 6(b), including deciding *ex parte* appeals from adverse examiner decisions by patent applicants and conducting America Invents Act (AIA) trial proceedings, such as *inter partes* reviews (IPRs) and post-grant reviews (PGRs). To ensure that the PTAB continues to meet its statutory obligations as to *ex parte* appeals, while continuing to maintain its capacity to conduct AIA proceedings, the Director will exercise her discretion on institution of AIA proceedings under 35 U.S.C. §§ 314(a) and 324(a) as outlined below.

First, decisions on whether to institute an IPR or PGR will be bifurcated between (i) discretionary considerations and (ii) merits and other non-discretionary statutory considerations. Under this interim procedure, the Director, in consultation with at least three PTAB judges, will determine whether discretionary denial of institution is appropriate. If it is appropriate, the Director will issue a decision denying institution. If it is not appropriate, the Director will issue a decision regarding that determination and refer the

petition to a three-member panel of the PTAB assigned according to Standard Operating Procedure (SOP) 1 (Rev. 16). The three-member panel will then handle the case in the normal course including by issuing a decision on institution addressing the merits and other non-discretionary statutory considerations.

Second, to facilitate this bifurcated approach, the USPTO will permit parties to file separate briefing on requests for discretionary denial of institution. The discretionary denial briefing shall proceed as follows: (1) within two months of the date on which the PTAB enters a Notice of Filing Date Accorded to a petition, a patent owner may file a brief explaining any applicable bases for discretionary denial of institution; and (2) a petitioner may file an opposition brief no later than one month after the patent owner files its brief. Leave to file further briefing may be permitted for good cause. Consistent with 37 C.F.R. § 42.24, discretionary denial briefing will be limited to 14,000 words. A reply brief, if any, will be limited to 5,600 words. The merits briefing schedule and the schedule for requesting rehearing or Director Review as to a decision on institution remain unchanged.

Third, consistent with the discretionary considerations enumerated in existing Board precedent (including *Fintiv, General Plastic,* and *Advanced Bionics*[*]) and the Consolidated Trial Practice Guide (Nov. 2019), the parties are permitted to address all relevant considerations, which may include:

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[*] *Apple Inc. v. Fintiv, Inc.,* IPR2020-00019, Paper 11 (Mar. 20, 2020) (precedential); *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha,* IPR2016-01357, Paper 19 (Sept. 6, 2027) (precedential as to § II.B.4.i); *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH,* IPR2019-01469, Paper 6 (Feb. 13, 2020) (precedential).

- Whether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims;
- Whether there have been changes in the law or new judicial precedent issued since issuance of the claims that may affect patentability;
- The strength of the unpatentability challenge;
- The extent of the petition's reliance on expert testimony;
- Settled expectations of the parties, such as the length of time the claims have been in force;
- Compelling economic, public health, or national security interests; and
- Any other considerations bearing on the Director's discretion.

The Director will also consider the ability of the PTAB to comply with pendency goals for *ex parte* appeals, its statutory deadlines for AIA proceedings, and other workload needs. *See* 35 U.S.C. § 316(b).

These processes aim to improve PTAB efficiency, maintain PTAB capacity to conduct AIA proceedings, reduce pendency in *ex parte* appeals, and promote consistent application of discretionary considerations in the institution of AIA proceedings. The processes described herein will be implemented in IPR and PGR proceedings where the deadline for the patent owner to file a preliminary response has not yet passed. In that situation, if the time for filing discretionary denial briefing as described herein has already elapsed, the patent owner may submit discretionary denial briefing within one month of the date of this memorandum.

The processes described herein are temporary in nature due, in part, to the current workload needs of the PTAB.

APPENDIX E

MEMORANDUM

To: All PTAB Judges

From: John A. Squires [/s]
Under Secretary of Commerce for
Intellectual Property and Director of the
United States Patent and Trademark Office

Subject: Director Institution of AIA Trial Proceedings

Date: October 17, 2025

To improve efficiency, consistency, and adherence to the statutory requirements for institution of trial, effective October 20, 2025, the Director will determine whether to institute trial for *inter partes* review ("IPR") and post-grant review ("PGR") proceedings.[1] This process will maintain PTAB's capacity to conduct IPR and PGR trials and promote consistent application of considerations for institution of trial proceedings before the PTAB. This approach to institution

[1] Congress provided that the Director determines whether to institute trials under the America Invents Act. *See* 35 U.S.C. § 314(a) ("The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition."); *id.* § 314(b) ("The Director shall determine whether to institute an inter partes review under this chapter pursuant to a petition . . . ."); *id.* § 314(c) ("The Director shall notify the petitioner and patent owner, in writing, of the Director's determination under subsection (a), and shall make such notice available to the public as soon as is practicable."); *see also id.* § 324(a), (c), (d) (similar).

flows from the processes outlined in the March 26, 2025 memorandum entitled "Interim Processes for PTAB Workload Management" ("Interim Processes"),[2] under which the Director determines whether or not to deny a petition based on discretionary considerations.

Similar to the discretionary considerations process, the Director, in consultation with at least three PTAB judges, will determine whether to institute trials in all IPR and PGR proceedings. Upon review of discretionary considerations, the merits, and non-discretionary considerations, if the Director determines that institution is appropriate on at least one ground for one challenged claim, the Director will issue a summary notice to the parties granting institution. *See* 35 U.S.C. §§ 314(c), 324(d). Similarly, if the Director determines that institution is not appropriate, whether based on discretionary considerations, the merits, or other non-discretionary considerations, the Director will issue a summary notice denying institution. In proceedings involving novel or important factual or legal issues, the Director may issue a decision on institution addressing those issues. Additionally, where the Director determines detailed treatment of issues raised in a petition is appropriate (e.g., complex claim construction issues, priority analysis, or real party in interest determination), the Director may refer the decision on institution to one or more members of the PTAB. The Office has issued more than 580 decisions under the Interim Processes, providing substantial guidance on how the Director will handle discretionary considerations. Any instituted IPR or PGR proceeding will be referred to a three-member panel of the PTAB to

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[2] Available at https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf.

conduct the trial and that panel will be assigned according to PTAB Standard Operating Procedure (SOP) 1 (Rev. 16).[3]

This Memorandum supersedes the Interim Processes to the extent that (1) routine decisions on institution will be limited to summary notices, and (2) merit-based decisions on whether to institute petitions will not be referred to a three-member panel of the PTAB. The process for briefing discretionary considerations, as outlined in the Interim Processes and the Discretionary Decisions webpage,[4] and the process for briefing the merits and non-statutory considerations will remain the same. Further, all petitions referred to the PTAB for consideration of the merits and non-discretionary considerations under the Interim Processes prior to October 20, 2025 will remain with a three-member panel.

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[3] Available at https://www.uspto.gov/sites/default/files/documents/sop1_r16_final.pdf.

[4] Available at https://www.uspto.gov/patents/ptab/interim-director-discretionary-process.

APPENDIX F

Statutory Provision

35 U.S.C. 314: Institution of inter partes review

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

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

(1) receiving a preliminary response to the petition under section 313; or

(2) if no such preliminary response is filed, the last date on which such response may be filed.

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

(d) No Appeal.—The determination by the Director whether to institute an inter partes review under this section shall be final and nonappealable.