

No. 15-1075

IN THE
Supreme Court of the United States

GEA PROCESS ENGINEERING, INC.,

Petitioner,

v.

STEUBEN FOODS, INC.,

Respondent.

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

REPLY BRIEF

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REPLY BRIEF FOR THE PETITIONER

Contrary to Respondent’s assertions, this Court’s recent decision in *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. ___ (2016) does not provide an answer to the issue presented here. In *Cuozzo*, the Court recognized that the patent owner sought review of the Patent Trial and Appeal Board’s (“PTAB”) decision to institute an *inter partes* review (“IPR”) proceeding because the IPR petitions at issue were allegedly not pled with particularity. Here, the issue that GEA Process Engineering, Inc. (“GPNA”) is seeking to appeal is a final written decision terminating GPNA’s IPR proceedings without deciding patentability, nine months after granting institution (“Termination Decision”). Pet. App. at 9a-33a. GPNA is not appealing or seeking to change those institution decisions. Those decisions to institute, which found that Steuben Foods, Inc.’s (“Steuben”) claims were reasonably likely to be found invalid, were correct. *See e.g.*, Pet. App. 35a.

The Termination Decision was based upon the panel’s *legal error* in assuming that 35 U.S.C. § 312(a)(2) stated a jurisdictional requirement, the failure of which nullified the validity of the proceeding. The panel thought that simply because GPNA had not named an alleged, second real party in interest, the proceeding was fatally flawed, thereby requiring the Petitioner to start the IPR process over -- an option which by that later date had become time-barred.¹ Pet. App. 33a. The PTAB’s Termination

1. Steuben spends much of its Opposition focusing on the facts of the dispute before the Patent Office. GPNA disagrees with Steuben’s mischaracterizations and the PTAB’s decision of it, but leaves those arguments for the merits of its appeal.

Decision was a final written decision. It was not an institution decision. And, it was not a final written decision on patentability.

This Petition seeks an answer to the remaining judicial reviewability question left open by *Cuozzo*: whether one can appeal a final written decision in an instituted IPR proceeding that does not end with a decision on patentability. The Federal Circuit is denying jurisdiction, holding that there is no appeal available.

This lack of judicial review has led to an inconsistent, legally erroneous decision in GPNA's IPR proceedings on an issue of law having no relation to patentability. In a decision that the PTAB itself deemed precedential in May of this year, the PTAB determined that 35 U.S.C. § 312(a)(2) is not a jurisdictional requirement and cannot be used as grounds to terminate an ongoing IPR Proceeding:

Contrary to Patent Owner's argument that, under § 312(a)(2), the Board lacked jurisdiction to institute inter partes review in this proceeding, Patent Owner has not shown that § 312(a) is jurisdictional. . . . Simply stated, § 312(a) sets forth requirements that must be satisfied for the Board to give consideration to a petition, however, a lapse in compliance with those requirements does not deprive the Board of jurisdiction over the proceeding, or preclude the Board from permitting such lapse to be rectified. Applying Patent Owner's contrary logic that § 312(a) is jurisdictional would lead to absurd results.

Compare Lumentum Holdings v. Capella Photonics, IPR2015-00739, Paper 38, at 4-5 (P.T.A.B. March 4, 2016, precedential on May 10, 2016) (Reply App. 1a-9a) with Pet. App. 32a-33a (“Thus, the Petitions are incomplete pursuant to § 312(a), which dictates that we cannot consider the Petitions.”). As *Lumentum Holdings* proves, even the PTAB now belatedly agrees that GPNA’s IPR proceedings should not have been terminated under § 312(a)(2), as was done in the Termination Decision.

This Court has the ability to correct this “absurd result” because: (1) unlike *Cuozzo*, this is not an appeal of an institution decision; (2) 35 U.S.C. § 319 does not bar review of decisions unrelated to patentability; and (3) the PTAB exceeded its statutory authority by terminating GPNA’s IPR proceedings. Therefore, this Petition addresses an agency action that is *not* barred from review by § 314(d) and it presents a legal issue as to which the salutary “presumption of reviewability” should apply. The Federal Circuit erred in summarily refusing jurisdiction, both by appeal and writ of mandamus, and this Petition should be granted.

I. GPNA APPEALS A LEGAL ERROR - NOT A CUOZZO ISSUE, NOT AN INSTITUTION DECISION

Steuben first argues that GPNA’s appeal is barred by § 314(d)’s institution decision bar based upon *Cuozzo*. Opp. at 7. *Cuozzo*’s holding is inapplicable because the issue presented here has nothing to do with a decision “whether to institute.

A. Steuben Does Not Assert that GEA is Seeking a Review of a Threshold Patentability Determination Under § 314(a)

In the GPNA institution decisions, the PTAB found that GPNA demonstrated a reasonable likelihood of prevailing on its patentability challenges. Pet. App. at 35a. The Termination Decision does not address this threshold question of patentability. Pet. at 15-17. And, Steuben's Opposition does not contest this. *See generally* Opp. at 5-15. Instead, Steuben argues that the *Cuozzo* decision should extend the § 314(d) appellate bar on institution decisions to § 312(a)(2), as this is the basis of the Termination Decision. Steuben is incorrect about the breadth of *Cuozzo* because *Cuozzo* does not extend to final decisions which are unrelated to preliminary findings in institution decisions.

B. Unlike *Cuozzo*, GPNA Is Not Appealing a PTAB Conclusion in GPNA's Petition

While *Cuozzo* and this case present questions regarding the judicial reviewability of PTAB decisions, the facts are very different. In *Cuozzo*, a patent owner tried to appeal the propriety of an actual decision whether to institute. *Cuozzo*, slip op. at 6-7. Specifically, the patent owner claimed that the PTAB "improperly instituted inter partes review" and "unlawfully initiated agency review." *Id.* Attempting to avoid § 314(d)'s appeal bar, the patent owner claimed that the PTAB was statutorily barred from instituting IPR proceedings because the IPR petitions did not explicitly list all of the challenged patent claims and § 312(a)(3) requires that "petitions must be pleaded 'with particularity.'" *Id.* at 7. This Court saw through the Patent Owner's artificial § 312(a)(3) claim:

In this case, Cuozzo’s claim that Garmin’s petition was not pleaded “with particularity” under §312 is little more than a challenge to the Patent Office’s conclusion, under §314(a), that the “information presented in the petition” warranted review. Cf. *United States v. Williams*, 504 U. S. 36, 54 (1992) (“A complaint about the quality or adequacy of the evidence can always be recast as a complaint that the . . . presentation was ‘incomplete’ or ‘misleading’”).

Id. at 12.

In this case, however, the Termination Decision addressed whether GPNA properly identified all RPIs to the IPR proceedings and whether a failure to do so was fatal to the PTAB’s jurisdiction to continue an IPR proceeding. Pet. App. at 10a. The Termination Decision did not conclude that GPNA’s IPR petitions failed to meet the “reasonably likely to succeed” threshold to institute an IPR proceeding, and neither GPNA nor Steuben are challenging the PTAB’s threshold decision finding a “reasonable likelihood that it would prevail” on invalidity. *See* Pet. App. 35a.

Unlike the § 312(a)(3) challenge in *Cuozzo*, the Termination Decision’s discussion of the RPI requirement led to complex briefing over whether GPNA (and the alleged additional RPI) had standing to file an IPR petition and whether the PTAB lost jurisdiction over an alleged statutory defect. *Id.* These legal issues are far outside the PTAB’s area of expertise and “core statutory function,” which is to “improve patent quality.” *Cuozzo*,

slip op. at 8, 10. Instead, jurisdiction and standing issues are “less closely related statutes” and require “other questions of interpretation that reach, in terms of scope and impact, well beyond [Section 314].” *Id.* at 11.

A defect in an RPI list can be easily remedied. This Court should not allow such an alleged defect to terminate five IPR proceedings over patents that the PTAB has found are likely to be invalid. *See* Pet. App. at 35a. Such a result is the exact opposite of the PTAB’s “core statutory function.”

C. Failure to Satisfy the RPI Requirement Is Now Recognized by the PTAB as Irrelevant To Jurisdiction Over IPR Petitions

The PTAB’s new precedential decision in *Lumentum Holdings* explains why the RPI requirement is unrelated to the PTAB’s decision to institute an IPR proceeding. In *Lumentum Holdings*, the patent owner argued that the petitioner’s IPR petitions were incomplete under § 312(a)(2) for failing to name all RPIs in the IPR petition. Reply App. at 4a. The patent owner claimed that because the IPR Petitions were incomplete, the Board should not have considered the petitions when it instituted review. *Id.*

The PTAB rejected the patent owner’s “jurisdictional argument” that § 312(a)(2) had any bearing on the PTAB’s consideration of an IPR Petition:

Patent Owner has not shown that § 312(a) is jurisdictional. . . . Simply stated, § 312(a) sets forth requirements [but] a lapse in compliance with those requirements does not deprive the Board of jurisdiction over the proceeding . . .

Id. at 5a-7a (citing *Sebelius v. Auburn Reg'l Med. Ctr.*, 133 S. Ct. 817, 824 (2013) and *Henderson ex rel. Henderson v. Shinseki*, 562 U.S. 428, 439 (2011)). *Lumentum Holdings* thus joined this Court in rejecting the notion that “all mandatory prescriptions, however emphatic, are properly typed jurisdictional.” *Henderson ex rel. Henderson v. Shinseki*, 562 U.S. at 439; Pet. App. at 10a-33a (GPNA making same non-jurisdictional arguments).

D. The PTAB’s Inconsistent Interpretation of Its Own Jurisdiction Demonstrates the Importance of GPNA’s Question Presented

The *Lumentum Holdings* facts closely parallel those in this case. Yet the panel below reached the opposite conclusion by assuming, erroneously, that the requirements of § 312(a)(2) were jurisdictional in deciding GPNA’s IPRs. Compare Reply App. at 1a-9a with Pet. App. 53a-54a. Steuben’s Opposition would have this Court deny this petition and thereby expand § 314(d)’s appellate review bar to RPI issues, and any other post-institution issue, without explicit statutory support. That would be unwise, ensure more inconsistent decisions from the PTAB like the one at issue here, and run counter to this Court’s presumption of appellate review of agency decision. *Mach Mining, LLC v. E.E.O.C.*, 135 S. Ct. 1645, 1651 (2015); *Cuozzo*, slip op. at 3-9 (Alito, J.) (dissent).

II. 35 U.S.C. § 319 DOES NOT LIMIT IPR APPEALS TO DECISIONS ON PATENTABILITY

Steuben also contends that GPNA cannot appeal the Termination Decision because 35 U.S.C. § 319, in conjunction with 35 U.S.C. § 141 and § 318, authorize PTAB

appeals of only final written decisions on patentability. To reach this conclusion, Steuben, like the Federal Circuit, combines three permissive statutes into a “statutory scheme” that allegedly prevents GPNA from appealing the Termination Decision. This contrived statutory scheme has no basis in Congressional intent and cannot set aside this Court’s strong presumption in favor of the reviewability of agency decisions and basic elements of statutory construction.

Congress knew how to restrict the judicial reviewability of individual PTAB decisions. It unambiguously did so in § 314(d). 35 U.S.C. § 314(d) (“No appeal: . . . [Institution decisions] shall be final and nonappealable.”) (emphasis added). Congress used no such language in § 319, instead using the permissive “may appeal”). 35 U.S.C. § 319 (emphasis added).

A. Sections 141, 318, and 319 are Permissive Statutes That Direct Appeals to The Proper Federal Court

GPNA’s Petition explained that 35 U.S.C. §§ 141, 318, and 319 do not restrict the types of PTAB decisions that may be appealed to the Federal Circuit. Pet. at 18-20. These are either permissive statutes explaining what decisions “may” be appealed or which court those appeals should be directed to. *Id.* Steuben offers no rebuttal to these points other than quoting the applicable statutes and conclusion of the Federal Circuit opinion below. Opp. at 9-10.

B. The Federal Circuit Improperly Reads an “Only” into 35 U.S.C. § 319

The Federal Circuit committed legal error in holding that § 319 restricts appeals to “only” final written decisions on patentability. The Federal Circuit inserted an “only” into that statute where none exists. Pet. App. at 5a-6a, 59a-60a, 80a-82a. The source of this error can be traced to its decision in *St. Jude*, where the Federal Circuit failed to recognize that IPR proceedings can end with decisions other than the typical two: (1) non-institution or (2) a final written decision on patentability. *St. Jude Med., Cardiology Div., Inc. v. Volcano Corp.*, 749 F.3d 1373, 1375-76 (Fed. Cir. 2014) (“The statute thus establishes a two-step procedure for inter partes review: [(1)] the Director’s decision whether to institute a proceeding, followed (if the proceeding is instituted) by [(2)] the Board’s conduct of the proceeding and decision with respect to patentability.”). Correctly concluding below that institution decisions could not be appealed, the Federal Circuit then incorrectly found that “only” final written decisions with respect to patentability could be appealed. This refusal of jurisdiction ignores any other final written decisions that the PTAB could choose to enter. This Petition needs to be granted in order to correct that legal error by the Federal Circuit of reading “only” into § 319.

C. Steuben’s Contrived “Statutory Scheme” Does Not Meet the High Burden Needed to Prevent Appellate Review

Neither Steuben nor the Federal Circuit analyzed its “statutory scheme” against this Court’s strong

presumption of favoring judicial review of agency action. Opp. at 9-10; Pet. App. at 5a-8a; *Cuozzo*, slip op. at 3-9 (Alito, J.) (dissent). In fact, neither Steuben’s Opposition nor the Federal Circuit opinions even address the “strong presumption” standard. *See generally* Opp. at 1-15. Pet. App. at 1a-8a. Section 319 cannot be read to bar all appeals of a final written decision from the PTAB, other than those that address patentability.

III. THE PTAB EXCEEDED ITS STATUTORY AUTHORITY BY VACATING FINAL AND NONAPPEALABLE INSTITUTION DECISIONS AND INTERPRETING § 312(a)(2) AS A JURISDICTIONAL REQUIREMENT

GPNA’s Petition should alternatively be granted due to the legal error in the Termination Decision regarding: (1) the treatment of § 312(a) as a jurisdictional statute; and (2) the ensuing *ex post facto* vacating of the institution decisions. *Cuozzo*, slip op. at 11 (“[W]e do not categorically preclude review of a final decision where . . . the agency [acts] outside its statutory limits. . .”); Opp. at 10 (“PTAB orders not addressing the patentability of any claim are still reviewable through a petition for writ of mandamus in order to determine whether the PTAB had lawful authority to issue certain decisions in the first place. *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1274 (Fed. Cir. 2015).”).

A. The PTAB Committed Clear Legal Error in Terminating GPNA’s IPR Proceedings under § 312(a)(2)

This Court should grant GPNA’s Petition due to the PTAB’s clear legal error in treating § 312(a)(2) as a jurisdictional statute. *See* Reply App. at 4a-9a. At most, the PTAB should have remedied a “minor statutory technicality” by allowing GPNA to update its RPI list to add the second, alleged RPI. *See Cuozzo*, slip op. at 8; *Henderson ex rel. Henderson v. Shinseki*, 562 U.S. at 439.

B. The PTAB Did Not Have Authority to Terminate GPNA’s IPRs

In addition to being “nonappealable,” Section 314(d) statutorily mandates that such institution decisions are also “final.” 35 U.S.C. § 314(d). Therefore, first, the PTAB legally erred in reviewing and vacating a “final and nonappealable” decision under § 314(b) and (d).

Second, § 314(b) requires the PTAB to issue an institution decision “within 3 months” after receiving a patent owner’s preliminary response to an IPR petition. Here, the Termination Decision issued over nine months after the statutory deadline afforded to PTAB to determine whether to institute. *Id.* at 16. Steuben’s Opposition does not dispute that the Termination Decision was untimely under § 314(b). Instead, the Opposition asserts that 35 U.S.C. § 6 and a PTAB regulation grants the PTAB the inherent power to review a previous decision.

Steuben’s Opposition is wrong because specific statutes (such as § 314(b) and § 314(d)) trump general

statutes. *Frederick Rodgers v. United States*, 185 U.S. 83, 89 (1902). Section 6 generally states that “only the [PTAB] may grant rehearings” in IPR proceedings. 35 U.S.C. § 6. Section 6 does not state that the PTAB can conduct rehearings over institution decisions. Section 314’s specific bar on reconsidering institution decisions, or at least on untimely rehearings, overrules § 6. Steuben is also wrong that the PTAB’s regulations grant the PTAB the authority to rehear institution decisions. Administrative agency regulations cannot contravene their statutory authority. 5 U.S.C. § 706.

The PTAB’s obvious legal error in terminating GPNA’s IPR proceedings before reaching a final written decision on patentability should not punish GPNA and be used as the basis for insulating the PTAB from appellate review. Petitions for a Writ of Certiorari and a Writ of Mandamus were created to remedy such legal error.

CONCLUSION

This Court should grant GPNA's Petition because the PTAB committed legal error by finding § 312(a) to be a jurisdictional statute and improperly terminated GPNA's IPR proceedings. GPNA's appeal is not barred by § 314(d) because GPNA is appealing an issue other than an institution decision. And, § 319 does not bar GPNA's appeal because it is a permissive statute ("may appeal") that does not limit appeals at all. This Petition should be granted or, at the very least, remanded to the Federal Circuit with instructions for that court to accept jurisdiction.

Respectfully submitted,

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APPENDIX

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APPENDIX — DECISION OF THE UNITED
STATES PATENT AND TRADEMARK OFFICE,
DATED MARCH 4, 2016 (PAPER 38)



UNITED STATES PATENT
AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL
AND APPEAL BOARD

LUMENTUM HOLDINGS, INC., LUMENTUM,
INC., AND LUMENTUM OPERATIONS LLC,

Petitioner,

v.

CAPELLA PHOTONICS, INC.,

Patent Owner.

Case IPR2015-00739
Patent RE42,678 E

Before JOSIAH C. COCKS, KALYAN K. DESHPANDE,
and JAMES A. TARTAL, *Administrative Patent Judges.*

Appendix

TARTAL, *Administrative Patent Judge*.

DECISION

Motion to Terminate
37 C.F.R. § 42.71(a)

Patent Owner Capella Photonics, Inc. was authorized to file a motion to terminate “limited only to Patent Owner’s contention that the Board lacked jurisdiction to institute *inter partes* review in this proceeding.” Paper 31, 5. Patent Owner filed a Motion to Terminate, and, as the moving party, has the burden of proof to establish that it is entitled to the requested relief, here, termination of the proceeding. Paper 35 (“Motion” or “Mot.”), *see also* 37 C.F.R. § 42.21(c). Upon consideration of Patent Owner’s arguments, for the reasons discussed below, the Motion is *denied*.

By way of background, the Petition was filed on February 14, 2015, and identified JDS Uniphase Corporation (“JDSU”) as the petitioner and real party-in-interest. Paper 1, 1. During late July and early August, 2015, as part of a reorganization, JDSU was renamed Viavi Solutions Inc. (“Viavi”). Ex. 1048, 345. Additionally, certain assets and obligations associated with communications and commercial optical products were spun out to Lumentum Holdings Inc., Lumentum, Inc. and Lumentum Operations LLC. Paper 21, 1–5; Ex. 1048, 2–3 (stating that pursuant to a series of agreements entered July 31, 2015, Viavi transferred certain business segments to Lumentum Holdings Inc. pursuant to a distribution effective August 1, 2015).

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On August 25, 2015, a decision instituting trial in this proceeding was entered. Paper 7. On September 15, 2015, an updated mandatory notice was filed stating that, as a result of a reorganization involving JDSU, the real parties-in-interest to this proceeding are now Lumentum Holdings Inc., Lumentum, Inc. and Lumentum Operations LLC. Paper 10. Petitioner's updated mandatory notice was not filed within 21 days of the change in name of the real parties-in-interest, as required by 37 C.F.R. § 42.8(a)(3). On January 15, 2016, we conducted a teleconference with the parties in response to a request by Petitioner to re-caption the proceeding to reflect the change in name of the real parties-in-interest. During that call we authorized Petitioner to file a motion to re-caption the proceeding, and accepted Petitioner's late-filing of the updated mandatory notice. *See* 37 C.F.R. § 42.5(c)(3). On January 22, 2016, Petitioner filed a Motion to Re-Caption the Proceeding (the "Re-Caption Motion"). Paper 21. Patent Owner did not oppose the Re-Caption Motion. The Re-Caption Motion was granted on January 29, 2016. Paper 27. During a teleconference on February 2, 2016, Patent Owner conceded that it has no evidence to dispute the identification of the real parties-in-interest provided by Petitioner.

Patent Owner contends that "Petitioner failed to meet its statutory requirements under § 312(a)(2) and that the petition was incomplete," and reasons that "[s]ince the Board should not have considered the petition when it instituted review, this proceeding should be terminated." Mot. 1. We disagree.

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The statutory provision at issue, 35 U.S.C. § 312(a), states:

A petition filed under section 311 may be considered only if-

(1) the petition is accompanied by payment of the fee established by the Director under section 311;

(2) the petition identifies all real parties in interest;

(3) the petition identifies, in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim, including-

(A) copies of patents and printed publications that the petitioner relies upon in support of the petition; and

(B) affidavits or declarations of supporting evidence and opinions, if the petitioner relies on expert opinions;

(4) the petition provides such other information as the Director may require by regulation; and

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(5) the petitioner provides copies of any of the documents required under paragraphs (2), (3), and (4) to the patent owner or, if applicable, the designated representative of the patent owner.

Contrary to Patent Owner's argument that, under § 312(a)(2), the Board lacked jurisdiction to institute *inter partes* review in this proceeding, Patent Owner has not shown that § 312(a) is jurisdictional. In *Elekta, Inc. v. Varian Medical Systems, Inc.*, IPR2015-01401, slip op. 6–7, (December 31, 2015) (Paper 19) (“*Elekta*”), the decision explained, and we agree, that:

[T]he [Supreme] Court has “adopted a readily administrable bright line for determining whether to classify a statutory limitation as jurisdictional.” *Sebelius v. Auburn Reg'l Med. Ctr.*, 133 S. Ct. [817,] 824 [(2013)] (internal quotation marks omitted). That determination turns on “whether Congress has clearly stated that the rule is jurisdictional; absent such a clear statement, . . . courts should treat the restriction as nonjurisdictional in character.” *Id.* (internal quotation marks and alteration omitted). Section 312(a)'s emphatic “may be considered only if” language does not make those requirements jurisdictional. *See Henderson [ex rel. Henderson v. Shinseki]*, 562 U.S. [428,] [] 439 [(2011)] (“[W]e have rejected the notion that all mandatory prescriptions, *however emphatic*, are properly typed jurisdictional.”)

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(internal quotation marks and alterations omitted, emphasis added). Because Congress has not clearly stated that it is jurisdictional, we treat § 312(a) as nonjurisdictional in character. In particular, § 312(a)'s "Requirements of the Petition" are "[a]mong the types of rules that should not be described as jurisdictional" because they are "claim-processing rules . . . that seek to promote the orderly progress of litigation by requiring that the parties take certain procedural steps at certain specified times." *Henderson*, 562 U.S. at 435; *see id.* at 438 (holding that a statutory notice of appeal deadline required "[i]n order to obtain review by the Court of Appeals for Veterans Claims" was not jurisdictional); *see also Achatas Reference Publ'g, Inc. v. Apple Inc.*, 803 F.3d 652, 658 (Fed. Cir. 2015) (holding that the § 315(b) time-bar does not implicate the Board's jurisdiction because the time bar "does not itself give the Board the power to invalidate a patent").

Simply stated, § 312(a) sets forth requirements that must be satisfied for the Board to give consideration to a petition, however, a lapse in compliance with those requirements does not deprive the Board of jurisdiction over the proceeding, or preclude the Board from permitting such lapse to be rectified. Applying Patent Owner's contrary logic that § 312(a) is jurisdictional would lead to absurd results. For example, if § 312(a) were jurisdictional, a patent owner could show at the conclusion

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of trial that a petitioner failed to attach to the petition a copy of a patent “relied upon in support of the petition,” as required by § 312(a)(3)(A), and we would have no choice but to terminate the proceeding. Such a result contrary to the interests of justice weighs heavily against Patent Owner’s contention that § 312(a) is jurisdictional.

The Board’s rules further make clear that jurisdiction is not “lost” the moment a petition no longer identifies “all real parties in interest,” as required by § 312(a)(2). It is apparent readily that over the course of a trial the identity of a real party in interest may change. Accordingly, 37 C.F.R. § 42.8(a)(3) allows a party 21 days to provide the Board notice of a change in its identification of the real party in interest, without the loss of “jurisdiction” over the proceeding.

Patent Owner provides no argument in its Motion to undermine the reasoning in *Elekta*, with which we agree, that § 312(a) is not jurisdictional. Patent Owner contends that *Elekta* is “distinguishable” because in that case the “Board was able to consider the new [real party in interest] listed in the mandatory notice before it instituted review,” is “not controlling” (as it is not a precedential decision), and “is inconsistent with many other Board cases that treat § 312(a) as a threshold issue.” Mot. 8–10. None of these arguments demonstrate that § 312(a) is jurisdictional, the very premise upon which Patent Owner’s Motion is founded. Patent Owner directs us to no decision finding § 312(a) is jurisdictional, and simply stating that an issue is a “threshold” issue does not make it “jurisdictional,” nor does the timing of the institution decision. Thus, having

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failed to demonstrate that § 312(a) is jurisdictional, Patent Owner has not shown it is entitled to the relief requested.

Patent Owner's additional arguments generally fall outside the scope of what was authorized for the Motion, but do not otherwise support Patent Owner's request that the proceeding be terminated. Mot. 1–13. Patent Owner's argument that the Petition was incomplete is not correct. *Id.* at 1–5. There is no dispute that the Petition, when filed, identified all real parties in interest, and, therefore, the Petition was complete, was properly accorded a filing date, and was available to be “considered” under § 312(a). Accordingly, Patent Owner's argument that the Petition cannot be “corrected” under 37 C.F.R. § 42.106(b) is misplaced, as there was no need to “correct” the Petition (as opposed to updating the Petition with additional information concerning circumstances that arose after the Petition was filed). Thus, Patent Owner has not shown a need to assign a new filing date to the Petition. *Id.* at 3–4.

Fundamentally, Patent Owner seeks to create an obligation on Petitioner to notify the Board of any change in the identity of a real party in interest before the Board issues an institution decision, notwithstanding that Petitioner does not know the date such a decision will be issued, and in disregard of our rule which provides 21 days to provide such notice. *See id.* at 6–8; *see also* 37 C.F.R. § 42.5(c)(3) (providing the Board discretion to permit late-filing of the updated mandatory notice). Patent Owner has shown no sufficient support for imposing such an obligation, much less a jurisdictional requirement that would compel us to do so.

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Similarly, Patent Owner's contention that the Board is offering Petitioner "a fully furnished opportunity for gamesmanship" has no merit. *See* Mot. 10–11. Petitioner disclosed on September 15, 2015, the new name of the real party in interest following the corporate reorganization. Patent Owner raised no issue with that disclosure for over four months, waiting until after we granted Petitioner's Re-Caption Motion, *without opposition from Patent Owner*, on January 29, 2016. We have considered all of Patent Owner's arguments and conclude that Patent Owner has failed to make the necessary showing that it is entitled to the extraordinary relief it seeks of termination of this proceeding.

Accordingly, it is:

ORDERED that Patent Owner's Motion to Terminate is *denied*.