No. 25-132 and 25-133

United States Court of Appeals for the Federal Circuit

In re SAP America, Inc.

Petitioner

On Petition for Writ of Mandamus to the
United States Patent and Trademark Office in No. IPR2024-01495

Motion of *Amicus Curiae* PTAARMIGAN LLC for Leave to File a Brief as Amicus Curiae

July 14. 2025

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Pursuant to Federal Circuit Rule 21(e) and Federal Rules of Appellate Procedure 27 and 29(a)(3), PTAAARMIGAN LLC (Patent and Trademark Attorneys, Agents, and Applicants for Restoration and Maintenance of Integrity in Government) moves for leave to file a brief as *amicus curiae* opposing SAP's mandamus petition.

On Thursday July 10, PTAAARMIGAN sent an email requesting consent to counsel for SAP, the Patent and Trademark Office, and Cyanida. The PTO responded to indicate no objection. SAP and Cyanida have not replied. It is unknown whether petitioner SAP o respondent Cyanida will oppose this motion.

PTAAARMIGAN advocates on behalf of intellectual property attorneys, agents and owners, and on behalf of IP-owning clients. PTAAARMIGAN focuses on issues where the administrative law provides protections against agency overreach. PTAAARMIGAN's special interest and expertise is in administrative law as it applies to the U.S. Patent and Trademark Office. PTAAARMIGAN believes that the administrative law sets ground rules that would improve functioning of the patent system by improving the predictability and reducing costs of proceedings before the U.S. Patent and Trademark Office.

The accompanying brief is desirable and relevant to the Court's consideration of mandamus relief in this case because it provides a discussion of administrative law principles that govern the PTO's issuance and use of guidance, from a central viewpoint that is unlikely to be presented by any of the parties. The brief explains that while SAP points out a pattern of lapse in the PTO's legal compliance, possibly challengeable in other proceedings in other forums on other jurisdictional bases, are not appropriate for mandamus relief.

Conclusion

PTAAARMIGAN believes that its perspective on these issues may assist the Court's consideration of whether to grant mandamus relief in this case. PTAAARMIGAN therefore requests leave to file PTAAARMIGAN's accompanying brief as *amicus curiae*.

Date: July 14. 2025

By: /s/ David E. Boundy

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CERTIFICATE OF INTEREST

Counsel for *amicus curiae* certifies the following:

1. The full name of every party or *amicus* represented by me is PTAAARMIGAN LLC.

2. The names of the real parties in interest represented by me as *amici* are as named in 1.

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the *amici* represented by me are: None

4. The names of all law firms, partners, and associates that have appeared for the party or *amici* now represented by me in the trial court or agency or are expected to appear in this court are: David E. Boundy, Pierson Ferdinand LLC.

5. Related Cases, Fed. Cir. R. 47.4(a)(5) and 47.5(b): None.

   Though not "related" under the definition of Fed. Cir. R. 47.4(a), Apple, Inc. et al. v. Stewart, Appeal No. 24-1864 (Nov. 4, 2024) presents related subject matter.

6. This is neither a criminal case with organizational victims, nor a bankruptcy.

Date: July 14. 2025

/s/ David E. Boundy
David E. Boundy

For *Amicus Curiae*
PTAAARMIGAN LLC

CERTIFICATE OF COMPLIANCE
WITH TYPE-VOLUME LIMITATION, TYPEFACE REQUIREMENTS, AND TYPE STYLE REQUIREMENTS

I certify that the body of this motion contains 295 words, which is within the limit prescribed by the rules of this Court.

2. This brief complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) or Federal Circuit Rule 28.1 and the type style requirements of Federal Rule of Appellate Procedure 32(a)(6). This brief has been prepared using Microsoft Word 2003, in Century Schoolbook 14 pt, a proportionally spaced typeface.

Date: July 14. 2025

By: /s/ David E. Boundy
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PTAAARMIGAN LLC

No. 25-132 and 25-133

United States Court of Appeals for the Federal Circuit

In re SAP America, Inc.

Petitioner

On Petition for Writ of Mandamus to the
United States Patent and Trademark Office in No. IPR2024-01495

Brief of *Amicus Curiae* PTAARMIGAN LLC in Support of Denial of Mandamus

July 14. 2025

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Date: July 14. 2025

/s/ David E. Boundy
David E. Boundy
Amicus Curiae

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IDENTITY AND INTEREST OF AMICUS CURIAE

PTAAARMIGAN LLC (Patent and Trademark Attorneys, Agents, and Applicants for Restoration and Maintenance of Integrity in Government) advocates on behalf of intellectual property attorneys, agents and owners, and on behalf of IP-owning clients. PTAAARMIGAN focuses on issues where the substantive or procedural law provides protections against agency overreach, and a federal agency acts in contravention of that law.

This brief brings a view of administrative law that may be helpful to the Court. This brief provides a central viewpoint that is unlikely to be presented by any of the parties.

STATEMENT UNDER FRAP 29(a)(4)(E)

No party or party's counsel authored this brief in whole or in part.

No party or party's counsel contributed money that was intended to fund preparing or submitting this brief.

No person, other than *amici*, their members, and counsel, contributed money intended to fund preparing or submitting this brief.

On Thursday July 10, PTAAARMIGAN sent an email requesting consent to counsel for SAP, the Acting Director of the Patent and Trademark Office, and Cyanida. The PTO responded to indicate no

objection. SAP and Cyanida have not replied. It is unknown whether petitioner SAP or respondent Cyanida will oppose this motion.

ARGUMENT

I. No matter how SAP's ambiguous petition is interpreted, the Court lacks mandamus jurisdiction

A court only has mandamus jurisdiction if there is "no other adequate means to seek the relief [that the petitioner] desires." *Allied Chemical Corp. v. Daiflon, Inc.*, 449 U.S. 33, 35 (1980).

As a preliminary observation, SAP's petition is oddly and ambiguously framed. The cover page of SAP's petition and Appx4-15 seek remedy for IPR2024-01495. The body of SAP's petition never mentions that IPR, and instead appears to be a challenge to a rule.

However SAP's petition is construed, the Court has no mandamus jurisdiction.

If the petition is construed to seek set aside of a rule, then statute provides SAP with adequate means to that end. Assuming all other jurisdictional prerequisites are met, SAP can challenge a change to guidance that is insufficiently explained, "arbitrary and capricious," or "contrary to constitutional right" under APA § 706(2) in district court.

Alternatively, if the petition seeks review of non-institution of a specific IPR, then SAP has an alternative remedy—all SAP has to do is slot its request into the "shenanigans" pigeonholes of 5 U.S.C. § 706(2)

rather than patent law. *Cuozzo Speed Technologies, LLC v. Lee*, 579 U.S. 261, 275 (2016) ("arbitrary and capricious" is one class of "shenanigans" on which an institution decision may be challenged). Mandamus review is precluded by 35 U.S.C. ¶ 314(d).

No matter how SAP's puzzling petition is construed, there's an alternative adequate means to the result SAP seeks. So mandamus relief is unavailable.

II. SAP's petition presents no "indisputable" due process right

Not only are SAP's ends not remediable by mandamus, the underlying legal means identify no indisputable legal right. SAP's due process rationales (retroactivity, reliance interest, etc.) fail at the starting gate. For any due process right to attach, the claimant must show a life, liberty, or property interest. *Cleveland Bd. of Educ. v. Loudermill*, 470 U.S. 532, 541 (1985).

An IPR petition is none of the three.

Likewise, the 2022 Vidal memorandum (Appx25-33) set no "settled expectation," and thus no cognizable property interest. If the PTO skips the statutory procedural formalities of legislative "regulation," 35 U.S.C. §§ 2(b)(2), 316(a), 326(a), including all the

formalities of the Administrative Procedure Act (especially 5 U.S.C. §§ 552(a)(1) and 553), Paperwork Reduction Act (44 U.S.C. § 3501 *et seq.*), its implementing regulations at 5 C.F.R. Part 1320, the Regulatory Flexibility Act (5 U.S.C. § 601 *et seq.*), etc., then its rule is not binding against the public. The 2022 Vidal memo—like almost all other subregulatory guidance of almost all agencies—slots into the "general statements of policy" or "interpretative rule" pigeonholes of 5 U.S.C. § 553(b).[1] Neither "interpretative rules" (when issued without notice-and-comment procedure under the § 553(b)(A) opt-out) nor "general statements of policy" are binding against the public. *Perez v. Mortgage Bankers Assn.*, 575 U.S. 92, 97 (2015) ("[Interpretative] rules do not have the force and effect of law"); *Batterton v. Marshall*, 648 F.2d 694, 702-03 (D.C. Cir. 1980) (an agency may not rely on an interpretative rule to foreclose consideration of positions advanced by parties); *Association of Flight Attendants-CWA, AFL-CIO v. Huerta*, 785 F.3d 710, 718 (D.C. Cir. 2015) ("Policy statements are binding on neither the public nor the agency, and the agency retains the discretion

[1] Guidance documents that bind only against agency personnel, in *ex parte* matters where there's no winner-vs-loser effect that requires more formal rulemaking, are generally valid and binding as "housekeeping rules" under 5 U.S.C. § 301. But that cannot apply to an *inter partes* rule as in this case.

and the authority to change its position ... in any specific case," cleaned up).

The Vidal 2022 memorandum was only subregulatory guidance, therefore not binding in any *inter partes* context. If not binding, no "settled expectation." If no settled expectation, no property interest. If no property interest, no due process right. If no due process right, no "clear and indisputable right" that can be remedied by mandamus.

The body of SAP's petition repeatedly refers to "binding agency guidance." That's an oxymoron. The PTO's years-long misunderstanding of the law of guidance does not turn nonbinding subregulatory guidance into an indisputable right.

III. The Boalick Memo is not unlawful *per se*, but future reliance by a PTAB panel may be—but in neither posture is the error reviewable by mandamus

Finally, SAP and several of SAP's *amici* challenge the Boalick Memo (Appx82-84) based on a misunderstanding of the law regarding guidance and amendment of guidance. When an agency initially promulgates a rule by subregulatory guidance, the agency can modify it with the same procedural informality. *Perez*, 575 U.S. at 101. There's nothing fundamentally wrong in rescinding or amending the 2022 Vidal

memo via a 2025 memo. (Guidance can be procedurally defective, but that's remediable under the APA, not mandamus.)

Similarly, the Boalick Memo is no more unlawful than any other guidance—as long as the PTO properly treats it as ordinary subregulatory guidance. The Boalick Memo cannot (lawfully) foreclose parties' offering alternatives or relieve the PTO's obligation to respond to those alternatives non-arbitrarily and non-capriciously. *E.g.*, *Appalachian Power Co. v. EP*A, 208 F.3d 1015, 1023 (D.C. Cir. 2000); *Flight Attendants*, 785 F.3d at 718. The PTAB will act unlawfully if it ever relies on the Boalick Memo to brush off those alternatives when presented. If the Boalick Memo used binding language, that would be unlawful under the APA, *Appalachian Power*, 208 F.3d at 1023; *see also* Administrative Conference of the United States, Recommendation 2017-5, *Agency Guidance Through Policy Statements*, 82 Fed. Reg. 61734 (Dec. 29, 2017), and would violate direct orders from the President, Executive Orders 13891 and 13892. But the language is all soft-edge "general statement of policy" language, such as "more likely," "less likely," "not dispositive," "holistic," and the like. Guidance written in such language sets no enforceable legal standard, and is therefore not reviewable. *National Mining Ass'n v. McCarthy*, 758 F.3d 243, 252-53 (D.C. Cir. 2014). Replacing the 2022 Vidal memo—which itself was

written in hortatory, "general statement of policy"—with the 2025 Boalick Memo presents no "clear and indisputable" shift of legal rights amenable to mandamus.

When an agency uses its guidance powers within the law, guidance documents set no binding standard of agency conduct. So long as the agency respects its non-binding legal status, guidance documents are almost never reviewable. *Valero Energy Corp. v. EPA*, 927 F.3d 532, 537-39 (D.C. Cir. 2019). Not under the APA, not by mandamus.

Only if the PTAB errs by treating the Boalick Memo as if it had force of law and, on that basis, refuses to consider plausible alternatives without a non-arbitrary, non-capricious explanation, will the aggrieved party be able seek review of § 706(2) "shenanigans" under *Cuozzo*. *Valero*, 927 F.3d at 537; *Union Neighbors United, Inc. v. Jewell*, 831 F.3d 564, 576 (D.C. Cir. 2016) (failure to consider plausible alternative is arbitrary and capricious). But that's the future, in a different procedural posture, on a different jurisdictional basis, not now in SAP's mandamus petition.

To be sure, an agency must give an explanation (and follow any other obligations of the Paperwork Reduction Act and its implementing regulations, the Regulatory Flexibility Act, and several executive orders), both when it promulgates any new rule—even a rule by

guidance—and when it changes course. *F.C.C. v. Fox Television Stations, Inc.*, 556 U.S. 502, 515 (2009) ("To be sure, the requirement that an agency provide reasoned explanation for its action would ordinarily demand that it display awareness that it *is* changing position. An agency may not, for example, depart from a prior policy *sub silentio* or simply disregard rules that are still on the books."); *Motor Veh. Mfrs. Ass'n v. State Farm Ins.,* 463 U.S. 29, 43 (1983) ("the agency must examine the relevant data and articulate a satisfactory explanation for its action including a 'rational connection between the facts found and the choice made.'"). PTAAARMIGAN takes no position on whether the PTO's explanations were adequate, but only notes that a mandamus petition is the wrong vehicle. Like any other rulemaking procedural defect, those issues are petitionable intra-agency under § 553(e), and (to the degree all jurisdictional prerequisites are established) reviewable in district court as "arbitrary and capricious" under APA § 706(2)(A). But not by mandamus here.

IV. If this mandamus petition is not dismissed outright on jurisdictional grounds, PTAAARMIGAN's brief in a similar case on similar issues may be helpful

Another case pending before this Court, *Apple v. Stewart*, Appeal No. 24-1864, presents similar challenges to Trump administration amendments to Biden-era guidance documents. PTAAARMGAN's

amicus brief provides a deeper background in the law of guidance, the PTO's consistent misuse of guidance, the PTO's failure to implement multiple decisions of this Court that have reminded the PTO of the limits on proper bounds of guidance, the PTO's defiance of several decades of Presidential authority, and a narrow exception that offers the PTO greater leeway for guidance relating to *denial* of IPR and PGR institution. Brief of *Amicus* PTAAARMIGAN, *Apple, Inc. et al. v. Stewart*, Appeal No. 24-1864, ECF 57 (Nov. 4, 2024). If SAP's petition survives dismissal for lack of jurisdiction, that brief will likely be helpful in addressing the merits.

V. Conclusion

The petition presents no issue remediable by mandamus, and should be denied.

Date: July 14. 2025

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1. This brief complies with the type-volume limit of Federal Circuit Rule 29(b) because it contains 1548 words, excluding the parts of the brief exempted by Federal Rule of Appellate Procedure 32(f), less than the 7000 words authorized.

2. This brief complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) or Federal Circuit Rule 28.1 and the type style requirements of Federal Rule of Appellate Procedure 32(a)(6). This brief has been prepared using Microsoft Word 2003, in Century Schoolbook 14 pt, a proportionally spaced typeface.

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