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Distinguished by [In re Cuozzo Speed Technologies, LLC](#), Fed.Cir., July 8, 2015

749 F.3d 1376

United States Court of Appeals,
Federal Circuit.

In re the PROCTER & GAMBLE COMPANY, Petitioner.

Misc No. 121.

|

April 24, 2014.

Synopsis

Background: **Patent** holder petitioned for writ of mandamus that would direct the **Patent** and Trademark Office (PTO) to withdraw orders instituting inter partes reviews of three of holder's **patents**.

[Holding:] The Court of Appeals, [Taranto](#), Circuit Judge, held that decision to institute an inter partes review of **patents** is not immediately reviewable through the extraordinary means of mandamus.

Petition denied.

West Headnotes (4)

[1] Mandamus 🔑 Nature and scope of remedy in general

The remedy of mandamus is a drastic one, to be invoked only in extraordinary situations. [28 U.S.C.A. § 1651](#).

[2 Cases that cite this headnote](#)

[2] Mandamus 🔑 Nature and scope of remedy in general

Mandamus 🔑 Discretion as to grant of writ

Mandamus 🔑 Nature and existence of rights to be protected or enforced

Three conditions must be satisfied before a writ of mandamus may issue: first, petitioner must show a clear and indisputable right to relief, second, petitioner must lack adequate alternative means to obtain the relief it seeks, and third, even if the first two prerequisites have been met, the issuing court, in the exercise of its discretion, must be satisfied that the writ is appropriate under the circumstances. [28 U.S.C.A. § 1651](#).

[4 Cases that cite this headnote](#)

[3] Mandamus 🔑 Proceedings relating to **patents**

Patents 🔑 Inter partes review

A decision by the Director of **Patent** and Trademark Office (PTO) to institute an inter partes review of **patents** is not immediately reviewable by Court of Appeals through the extraordinary means of mandamus. 35 U.S.C.A. § 314(a, b).

[7 Cases that cite this headnote](#)

[4] **Patents** 🔑 In general;utility

US **Patent** 5,891,453, US **Patent** 5,894,017, US **Patent** 7,122,199. Cited.

[Cases that cite this headnote](#)

Attorneys and Law Firms

*1377 Gregory A. Castania, [Jones Day](#), of Washington, DC, for petitioner. With him on the petition were [David M. Maiorana](#), of Cleveland, OH, and [David M. Weirich](#), The Procter & Gamble Company, of Cincinnati, OH.

[William H. Oldach III](#), Vorys, Sater, Seymour and Pease, LLP, of Washington, DC, for respondent Clio USA, Inc. With him on the response was [Louis Gubinsky](#).

[Nathan K. Kelley](#), Solicitor, United States **Patent** and Trademark Office, of Alexandria, VA, for respondent United States **Patent** and Trademark Office. With him on the response were [Jeremiah S. Helm](#) and Joseph Matal, Associate Solicitors.

Before [LOURIE](#), [PROST](#), and [TARANTO](#), Circuit Judges.

ON PETITION

ORDER

[TARANTO](#), Circuit Judge.

Clio USA, Inc., petitioned the Director of the United States **Patent** & Trademark Office to institute *inter partes* reviews of three **patents** owned by The Procter & Gamble Company (P & G). The Director, through her delegee, granted the petitions. P & G now petitions this court to issue a writ of mandamus that would direct the PTO to withdraw the orders instituting *inter partes* reviews of the three P & G **patents**.

In today's decision in *St. Jude Medical, Cardiology Div., Inc. v. Volcano Corp.*, No. 2014–1183, 749 F.3d 1373, 2014 WL 1623676 (Fed.Cir.2014), we describe the statutory scheme governing *inter partes* reviews, 35 U.S.C. §§ 311–319, and conclude that a decision by the Director *not* to institute an *inter partes* review may not be appealed to this court. In *In re Dominion Dealer Solutions, LLC*, No. 2014–109, 749 F.3d 1379, 2014 WL 1673823 (Fed.Cir.2014), also issued today, we conclude that a non-institution decision may not be directly reviewed by this court through the extraordinary means of mandamus. The present case involves a decision by the Director *to* institute an *inter partes* review. We conclude that immediate review of such a decision is not available in this court. We therefore deny P & G's petition for mandamus relief.

BACKGROUND

P & G owns three **patents** that claim systems or methods for whitening teeth—U.S. **Patent** Nos. 5,891,453, 5,894,017, and 7,122,199. Those **patents** have been involved in two district-court actions relevant here. First, P & G sued Team Technologies, Inc., alleging infringement of the three **patents**, in the United States District Court for the Southern District of Ohio. Clio then filed a declaratory-judgment action against P & G in the United States District Court for the District of New Jersey, alleging that the same **patents** were invalid, unenforceable, or not infringed. *1378 In its declaratory-judgment action, Clio asserted that it manufactured the tooth-whitening products accused in the Ohio action.

P & G quickly amended its complaint in the Ohio action to add Clio as a defendant. When Team Technologies and Clio then moved in that action for a stay or a transfer to the District of New Jersey, the district court in Ohio denied both motions. Two days later, Clio filed a motion with the New Jersey district court to dismiss its declaratory-judgment action there without prejudice, under [Federal Rule of Civil Procedure 41\(a\)\(1\)\(B\)](#). On January 2, 2013, the New Jersey district court granted that motion.

In July 2013, Clio timely petitioned the Director to institute *inter partes* reviews of the three **patents** under [35 U.S.C. §§ 311–319](#). P & G responded to Clio's three petitions, arguing that Clio's earlier declaratory-judgment action involving the same three **patents**, though it had been voluntarily dismissed, barred the institution of *inter partes* reviews under section 315(a).¹ The Director, through the **Patent** Trial and Appeal Board as her delegee, disagreed and granted all three petitions, deciding under [section 314\(a\) & \(b\)](#) to institute the requested *inter partes* reviews.² The Board explained that, because Clio's declaratory-judgment action was dismissed without prejudice, “[i]n the context of § 315(a)(1), the action never existed.” J.A. 8 (Board decision granting Clio's petition for *inter partes* review of the #017 **patent**); *see also* J.A. 31 (#453 **patent**); J.A. 49 (#199 **patent**).

P & G asked for rehearing, which the Board denied. In February 2014, P & G filed the present petition for a writ of mandamus in this court under [28 U.S.C. § 1651](#).

DISCUSSION

[1] [2] “The remedy of mandamus is a drastic one, to be invoked only in extraordinary situations.” *Kerr v. U.S. Dist. Court for N. Dist. of Cal.*, 426 U.S. 394, 402, 96 S.Ct. 2119, 48 L.Ed.2d 725 (1976). Accordingly, “three conditions must be satisfied before it may issue.” *Cheney v. U.S. Dist. Court for D.C.*, 542 U.S. 367, 380, 124 S.Ct. 2576, 159 L.Ed.2d 459 (2004). The petitioner must show a “‘clear and indisputable’” right to relief. *Id.* at 381, 124 S.Ct. 2576 (quoting *Kerr*, 426 U.S. at 403, 96 S.Ct. 2119). The petitioner must “lack adequate alternative means to obtain the relief” it seeks. *Mallard v. United States District Court*, 490 U.S. 296, 309, 109 S.Ct. 1814, 104 L.Ed.2d 318 (1989); *Cheney*, 542 U.S. at 380, 124 S.Ct. 2576; *Kerr*, 426 U.S. at 403, 96 S.Ct. 2119. And “even if the first two prerequisites have been met, the issuing court, in the exercise of its discretion, must be satisfied that the writ is appropriate under the circumstances.” *Cheney*, 542 U.S. at 381, 124 S.Ct. 2576.

[3] Our analysis in *St. Jude* and *Dominion*, in which we reject requests for immediate review of the Director's decision not to institute an *inter partes* review, applies equally to the Director's decision to institute such a review. In particular, what we explained in *St. Jude* about chapter 31 generally, [section 314\(d\)](#) particularly, and our jurisdictional statute requires that we may not hear an appeal from the *1379 Director's decision to institute an *inter partes* review. Nor is there a clear and indisputable right to this court's immediate review of a decision to institute an *inter partes* review, as would be needed for mandamus relief, just as *Dominion* holds that there is no such right with respect to a non-institution decision. Moreover, this is not one of the rare situations in which irremediable interim harm can justify mandamus, which is unavailable simply to relieve P & G of the burden of going through the *inter partes* review. *Cf. In re Roche Molecular Sys., Inc.*, 516 F.3d 1003, 1004 (Fed.Cir.2008) (petitioner's “hardship [and] inconvenience” in going through trial did not provide a basis for mandamus”).

It is a separate question whether [section 314\(d\)](#) means that the decision to institute the review is unchallengeable later—if the Board reaches a decision under [section 318\(a\)](#) and an appeal is taken under [section 319](#). Perhaps [section 314\(d\)](#)'s broad language precludes all judicial review of the institution decision, even in an eventual [section 319](#) appeal. We need not decide that question, which can be addressed in a [section 319](#) appeal. Nor need we address whether an immediate challenge could be brought in district court.

In sum, P & G's mandamus petition is not a proper vehicle for challenging the institution of *inter partes* review.

Accordingly,

IT IS ORDERED THAT:

The petition is denied.

All Citations

749 F.3d 1376, 110 U.S.P.Q.2d 1782

Footnotes

- 1 [35 U.S.C. § 315\(a\)\(1\)](#) states: “An inter partes review may not be instituted if, before the date on which the petition for such a review is filed, the petitioner or real party in interest filed a civil action challenging the validity of a claim of the **patent**.”
- 2 [Section 314](#) assigns the decision to institute an *inter partes* review to the “Director.” [35 U.S.C. § 314\(a\), \(b\)](#). The Director, by regulation, has delegated that decision to the Board. [37 C.F.R. §§ 42.4 & 42.108](#). The Board, in making the review-instituting decision, is exercising the Director's [section 314](#) authority.