

Misc. No. 2016-119

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

IN RE VIRNETX INC.,
Petitioner.

On Petition for Writ of Mandamus to the United States Patent and
Trademark Office in Nos. IPR2015-01046 and IPR 2015-01047.

**RESPONSE OF THE DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE**

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STATUTORY BACKGROUND

Section 315(c) of title 35 allows the Director, in her discretion, to join as a party to an existing inter partes review any party who properly files a petition that meets the evidentiary threshold for institution. Section 315(c) provides:

(c) JOINDER.—If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

Section 315(b) generally precludes the institution of an inter partes review if the petition was filed more than one year after the petitioner was sued for infringement of the patent. Section 315(b)'s second sentence, however, provides an exception for requests for joinder under § 315(c):

(b) PATENT OWNER'S ACTION.—An inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent. The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).

Section 316(a) directs the USPTO to “prescribe regulations . . . setting forth the standards for the showing of sufficient grounds to institute a review under section 314(a)” and “establishing and governing inter partes review under this chapter.” 35 U.S.C. § 316(a)(2), (4). Pursuant to this authority, the USPTO

has issued a regulation that implements § 315(b)'s one-year deadline. *See* 37 C.F.R. § 42.101(b). USPTO regulations also address the exception created by the second sentence of § 315(b); they provide that the one-year time limit “shall not apply when the petition is accompanied by a request for joinder.” 37 C.F.R. § 42.122(b). In addition, the regulations require that a request for joinder must be filed “no later than one month after the institution date of any inter partes review for which joinder is requested.” *Id.*

Finally, § 314(d) provides that “[t]he determination by the Director whether to institute an inter partes review under this section shall be final and nonappealable.” 35 U.S.C. § 314(d).

PROCEDURAL BACKGROUND

On October 7, 2015, the Patent Trial and Appeal Board instituted inter partes reviews¹ for two patents² owned by mandamus petitioner VirnetX Inc. These reviews were instituted on petitions filed by Mangrove Partners Master Fund, Ltd. (“Mangrove”). Within the one-month period required by 37 C.F.R. § 42.122(b), Apple, Inc. filed its own IPR petitions and an accompanying motion to join the Mangrove IPRs.³ VirnetX opposed Apple’s motions and

¹ IPR2015-01046 and IPR2015-01047.

² U.S. Patents Nos. 6,502,135 and 7,490,151 (“the patents”).

³ IPR2016-00062 and IPR2016-00063.

petitions, arguing that “[t]he request-for-joinder exception of § 315(b) applies only when two timely petitions are filed, but the request for joinder is made more than a year after being served with a complaint.”⁴ The Board disagreed. On January 25, 2016, it instituted the Apple petitions, finding that the regulations permit joinder of an otherwise-time-barred petition and that they do not conflict with the statute.⁵

SUMMARY OF THE ARGUMENT

This Court lacks jurisdiction to entertain this petition: the Court’s precedents unequivocally bar any challenge to the Board’s § 315(b) determinations in particular, and bar the use of mandamus review to challenge institution decisions in general. VirnetX does not challenge joinder in order to compel Apple’s IPRs to proceed separately from the Mangrove IPRs; rather, it attacks joinder as a gateway to challenging the institution of the Apple IPRs, an

⁴ IPR2016-00062, Paper 9, at p.6; IPR2016-00063, Paper 9, at p.6. On August 11, 2010—five years before the Apple petitions were filed, and one year before the AIA was enacted—VirnetX sued Apple for infringement of the patents. The case resulted in a judgment for VirnetX of \$369,160,000. *See VirnetX, Inc. v. Cisco Sys., Inc.*, 767 F.3d 1308, 1313-14 (Fed. Cir. 2014). On appeal, this Court affirmed the district court’s findings that the patents are not invalid and that some claims are infringed, vacated the damages award, and remanded for further proceedings. *See id.* The case remains pending before the district court. *See VirnetX Inc. v. Apple Inc.*, Case No. 6:10-cv-00417-RWS (E.D.T.X.).

⁵ IPR2016-00062, Paper 14, at p.4; IPR2016-00063, Paper 13, at p.4.

attack clearly barred by § 314(d).

The USPTO regulation exempting a petition accompanied by a joinder motion from the one-year bar is a reasonable interpretation of § 315(b), and therefore is entitled to this Court's deference. Indeed, this Court has characterized the exception in § 315(b)'s second sentence for a "request for joinder" as encompassing the petition that accompanies a motion for joinder: it has noted that the second sentence of § 315(b) "means that an otherwise time-barred party may nonetheless participate in an *inter partes* review proceeding if another party files a proper petition." *Achates Reference Publ'g, Inc. v. Apple Inc.*, 803 F.3d 652, 657 (Fed. Cir. 2015). The second-sentence exception necessarily applies to the filing of the petition, because the *first* sentence of § 315(b) states only that the one-year deadline applies with respect to "the petition requesting the proceeding." In other words, the *only* thing that the second sentence can exempt from the one-year deadline is the petition for IPR, because that is the only thing to which the one-year deadline is applied in the first place. Were VirnetX's contrary interpretation correct—that the second sentence's exception encompasses only the filing of the motion for joinder, but not the filing of the accompanying petition—there would be no need for the second sentence at all, since the motion for joinder, divorced from its accompanying petition, is not subject to the one-year deadline.

Finally, mandamus relief and a stay are not appropriate for cases of this nature. This Court has made clear that requiring a patentee to defend its patent in an IPR does not qualify as the type of irreparable injury that justifies mandamus relief. In light of these precedents, and the USPTO's obligation to timely complete IPRs, the Director respectfully requests that this Court in the future deny motions for a stay of Board proceedings that accompany mandamus petitions.

ARGUMENT

Mandamus relief is a “drastic” remedy that is “to be invoked only in extraordinary situations.” *In re Procter & Gamble Co.*, 749 F.3d 1376, 1378 (Fed. Cir. 2014) (quoting *Kerr v. U.S. Dist. Court for N. Dist. of Cal.*, 426 U.S. 394, 402 (1976)). Such relief requires a showing of a “clear and indisputable right to relief,” a “lack of adequate alternative means to obtain the relief,” and—even when these prerequisites are met—“the issuing court, in the exercise of its discretion, must be satisfied that the writ is appropriate under the circumstances.” *Id.* (citations omitted). The USPTO's regulations implementing the IPR statute must be upheld if they are a reasonable interpretation of the statute. *See Chevron, U.S.A., Inc. v. Natural Res. Def. Council, Inc.*, 467 U.S. 837 (1984); *Harmonic Inc. v. Avid Tech., Inc.*, No. 2015-1072, 2016 WL 798192, at *9 (Fed. Cir. Mar. 1, 2016).

A. Review is barred by § 314(d)

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 nonappealable.” 35 U.S.C. § 314(d). VirnetX contends that institution of the Apple petitions is barred by § 315(b). Pet. at 13-20. This Court’s precedents make clear, however, that § 314(d) bars *any* challenge based on § 315(b), and additionally bars the use of mandamus to challenge an institution decision.

“IPR proceedings occur in two distinct phases: (1) an institution phase; and (2) a merits phase.” *Harmonic*, 2016 WL 798192, at *8. This Court has “jurisdiction to hear appeals from parties ‘dissatisfied with the final written decision’ from the merits phase” of an IPR, but it “do[es] not . . . have jurisdiction to review an institution decision.” *Id.* at *5 (quoting 35 U.S.C. § 141(c)).

This review framework requires the Court to distinguish between those issues that relate to institution and those that relate to the Board’s final written decision. Under this Court’s precedents, the final decision includes the merits of the Board’s final patentability determination and “fundamental questions about the scope of the Board’s statutory authority to deem patents unpatentable.” *Id.* at *7. Institution includes the determination that a sufficient preliminary showing of unpatentability has been made, and at least additionally includes the

application of those rules that “only bar[] particular petitioners from challenging the [patent] claim.” *Id.* at *6 (quoting *Achates Reference Publ’g, Inc. v. Apple Inc.*, 803 F.3d 652, 657 (Fed. Cir. 2015)). Section 314(d) at a minimum thus bars all “procedur[al]” challenges to institution—those that do not contest that a review *could* have been instituted “via a properly filed petition from another petitioner.” *Achates*, 803 F.3d at 657; *see also id.* (review is barred if “a proper petition could have been drafted”) (quoting *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1274 (Fed. Cir. 2015)).

Achates particularly “hold[s] that . . . § 314(d) prohibits this [C]ourt from reviewing the Board’s determination to initiate IPR proceedings based on its assessment of the time-bar of § 315(b).” *Id.* at 658; *see also Synopsys, Inc. v. Mentor Graphics Corp.*, No. 2014-1516, 2016 WL 520236, at *11 (Fed. Cir. Feb. 10, 2016) (“the PTO’s decisions concerning the § 315(b) time bar, including determinations of the real party in interest and rulings on discovery related to such determinations, are non-appealable”); *MCM Portfolio LLC v. Hewlett-Packard Co.*, No. 2015-1091, 2015 WL 7755665, at *3 (Fed. Cir. Dec. 2, 2015) (same). Section 315(b), of course, is the very bar that VirnetX seeks to apply to secure the dismissal of Apple’s IPR petitions. VirnetX’s challenge is barred by § 314(d) under this Court’s precedents.

VirnetX attempts to evade these precedents by characterizing its petition

as challenging only the joinder decision, not institution. Pet. at 26. VirnetX is not seeking, however, simply to reverse the joinder of the petitions and allow Apple's IPRs to proceed independently of the Mangrove IPRs. Rather, it attacks joinder as a backdoor to challenging the decision to institute the IPRs. VirnetX's challenge is part and parcel of an attack on institution and is thus within the scope of § 314(d)'s judicial-review bar.

This conclusion is confirmed by the reasoning of *Achates*. That case describes joinder under § 315(c), and the exception in the second sentence of § 315(b), as *part of the reason* why § 315(b) decisions are not reviewable. *Achates* quotes the second sentence's statement that "the time limitation does not apply to a request for joinder," and concludes: "This means that an otherwise time-barred party may nonetheless participate in an inter partes review proceeding if another party files a proper petition." *Achates*, 803 F.3d at 658 (citing 35 U.S.C. § 315(c)). In other words, the § 315(b) issue is procedural, and § 314(d) bars review of such determinations, because "the timeliness issues here could have been avoided if . . . a petition identical to Apple's were filed by another party" and Apple had joined that IPR. *Id.*⁶ Rather than being an unrelated event, as VirnetX would have it (Pet. at 15), joinder (and its exception

⁶ Both *Achates* and this case involve Apple as the IPR petitioner.

to the one-year limit) is part of what makes the § 315(b) decisions nonreviewable. VirnetX's contention that joinder can be attacked on appeal and forms a pathway to attacking institution cannot be reconciled with *Achates*'s reasoning.

Moreover, even if joinder were deemed a matter that is separate and distinct from institution, joinder itself is clearly procedural. Even if a particular petitioner is barred from seeking joinder—because, for example, joinder was sought more than one month after institution, in contravention of 37 C.F.R. § 42.122(b)—it is clear that a proper motion *could* have been brought, either by a different party or by the same party acting earlier. *See Achates*, 803 F.3d at 657. Because joinder “is simply a procedural rule governing the proceedings, and does not itself give the Board the power to deem a patent unpatentable,” *Harmonic*, 2016 WL 798192, at * 6, “it is not a ‘defining characteristic’ of the Board’s authority” and is not subject to review. *Id.* (quoting *Achates*, 803 F.3d at 657-58).

Finally, because VirnetX attacks the Board’s institution decision, it is particularly barred from seeking mandamus relief. “[C]hapter 31 generally, section 314(d) particularly, and [this Court’s] jurisdictional statute require[] that [the Court] may not hear an appeal from the Director’s decision to institute an *inter partes* review.” *Procter & Gamble*, 749 F.3d at 1378-79. As a result,

there is no “clear and indisputable right to this [C]ourt’s immediate review of a decision to institute an *inter partes* review, as would be needed for mandamus relief.” *Id.* at 1379.

B. USPTO regulations reasonably construe the second sentence of § 315(b) to suspend the one-year time bar for petitions

“[T]he PTO has explicit authority to promulgate regulations ‘setting forth the standards for the showing of sufficient grounds to institute’ *inter partes* review.” *Synopsys*, 2016 WL 520236, at *5 (quoting 35 U.S.C. § 316(a)(2)); *see also Harmonic*, 2016 WL 798192, at *8 (noting that the USPTO also has authority to promulgate regulations “establishing and governing *inter partes* review”) (quoting 35 U.S.C. § 316(a)(4)). *VirnetX* does not contest that the relevant USPTO regulation allows filing a petition for IPR outside of the one-year deadline “when the petition is accompanied by a request for joinder” (37 C.F.R. § 42.122(b))—and thus allows Apple’s petition to be filed. This regulation must be upheld so long as it “is a reasonable interpretation of the statutory provision.” *Synopsys*, 2016 WL 520236, at *5; *see also Chevron*, 467 U.S. at 842-43; *Harmonic*, 2016 WL 798192, at *9.

The USPTO’s determination that a petition may be filed outside of the one-year deadline if it is accompanied by a motion for joinder is a reasonable interpretation of § 315(b). As noted previously, this is exactly how this Court has characterized § 315(b) as operating: the second sentence of § 315(b)

“means that *an otherwise time-barred party* may nonetheless participate in an *inter partes* review proceeding if another party files a proper petition.” *Achates*, 803 F.3d at 657 (citing 35 U.S.C. § 315(c)) (emphasis added). In other words, “the [§315(b)] timeliness issue could have been avoided” if “a petition identical to Apple’s were filed by another party”—as were the Mangrove petitions in this case—and Apple joined those proceedings. *Id.*

Even if § 315(b)’s second sentence could have been more clearly drafted to make express that the one-year deadline is suspended for the IPR petition itself when that petition is accompanied by a motion for joinder, the legislative purpose nevertheless is apparent from the statutory scheme. The second sentence necessarily exempts the petition, because that is the only thing to which the one-year deadline is applied in the first place. If the second sentence were intended only to allow late motions to join petitions that already had been filed within the one-year limit, as VirnetX contends (Pet. at 19), that second sentence

would be wholly unnecessary, since the first sentence regulates petitions, not motions for joinder.⁷

VirnetX insists that § 315(b) must be construed to bar Apple's petitions so that the provision can more thoroughly fulfill its purpose of preventing serial challenges and harassment of patent owners. Pet. at 23-24. "But no legislation pursues its purposes at all costs." *Rodriguez v. United States*, 480 U.S. 522, 526-27 (1987). Section 315(b), like the IPR statute as a whole, balances the goal of providing patent owners with protection against late or serial challenges against the goal of "encourag[ing] . . . meritorious patentability challenges . . . in an effort to further improve patent quality." *Coalition for Affordable Drugs VI, LLC, v. Celgene Corp.*, IPR2015-01092, Paper No. 19, 2015 WL 5657273, at *4 (PTAB Sept. 25, 2015) (citing H.R. Rep. No. 112-98, at 85 (2011)). The second sentence of § 315(b) simply reflects a legislative judgment that while a patentee generally should be protected against a defendant's filing an IPR petition more than a year after litigation has commenced, the patent owner's

⁷ A separate provision, at § 316(a)(12), authorizes the Director to set a deadline for filing a motion for joinder. (This provision is the source of the USPTO's authority to promulgate the one-month deadline imposed by 37 C.F.R. § 42.122(b).) The second sentence of § 315(b) does not suspend *that* limit. By its terms, the second sentence suspends only "[t]he time limitation set forth in the preceding sentence"—*i.e.*, the one-year deadline for "the petition requesting the proceeding." 35 U.S.C. § 315(b).

interest in quiet title is substantially diminished—and is outweighed by the countervailing interest in the “authoritative testing of patent validity,” *Blonder-Tongue Labs., Inc. v. U. of Illinois Found.*, 402 U.S. 313, 344 (1971)—when the patent in question *already* is the subject of an ongoing IPR.

Finally, the Director’s interpretation of § 315(b) is consistent with how the provision was understood during the congressional debates leading to the AIA’s enactment. In the Senate floor debate, Senator Kyl characterized § 315(c) as allowing joinder of follow-on petitions:

The Office anticipates that joinder will be allowed as of right—if an inter partes review is instituted on the basis of a petition, for example, a party that files an identical petition will be joined to that proceeding, and thus allowed to file its own briefs and make its own arguments. If a party seeking joinder also presents additional challenges to validity that satisfy the threshold for instituting a proceeding, the Office will either join that party and its new arguments to the existing proceeding, or institute a second proceeding for the patent.

157 Cong. Rec. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl).

Senator Kyl’s statements confirm that joinder was not simply understood as a means of uniting previously instituted, independently filed IPRs, as VirnetX would have it. Pet. at 19. Rather, § 315(c) was understood to allow a party that learns of an instituted IPR to *then* file its own similar petition and join that proceeding. Not only is this *exactly* what occurred in this case, but the contemplation of successive rather than simultaneous filing, and the possibility

that the Director may not even join the two petitions in a common proceeding, also tends to confirm that *the whole point* of joinder, and the suspension of the one-year deadline, is to allow an otherwise-barred defendant to participate when an IPR proceeding is ongoing.⁸

C. VirnetX is not entitled to mandamus relief or a stay

Procter & Gamble precludes resort to interlocutory mandamus relief to attack an ongoing IPR. That case involved an attempt to invoke § 315(a), which bars filing a petition for IPR after an action for a declaratory judgment of invalidity has been filed. *See* 749 F.3d at 1377-78. Not only did the Court hold that § 314(d) precludes the existence of a “clear and indisputable” right to review, as would be required for mandamus relief; *Procter & Gamble* also concluded that challenges to institution do not present “one of the rare situations in which irremediable interim harm can justify mandamus”—because such extraordinary relief “is unavailable simply to relieve [the patent owner] of the burden of going through the inter partes review.” *Id.* at 1379 (citing *In re Roche Molecular Sys., Inc.*, 516 F.3d 1003, 1004 (Fed.Cir.2008) (petitioner’s “hardship

⁸ VirnetX’s emphasis on Senator Kyl’s statement that joinder petitions must be properly filed and thus timely, Pet. at 20-23, simply begs the question of which deadline governs joinder and accompanying petitions. Because Apple’s petitions were filed within the one-month deadline of 37 C.F.R. § 42.122(b), they were timely.

[and] inconvenience” in going through trial did not provide a basis for mandamus)).⁹

Even if judicial review *were* available to challenge the Board’s institution decision, and even if the Director’s regulations *were* “clear[ly] and indisputabl[y]” unreasonable in their interpretation of the statute, the “drastic” remedy of mandamus relief simply is not available to relieve a patentee of the burden of defending its patent in an IPR. *P & G*, 749 F.3d at 1378.

Because this form of relief is unavailable, a request for such relief does not establish a basis for a stay of the Board’s proceedings. Such a stay also is in tension with the statutory mandate that the Board timely complete IPR proceedings.¹⁰ In the related context of reexamination, this Court has held that the general statutory directive to conduct those proceedings “with special

⁹ *See also F.T.C. v. Standard Oil Co. of California*, 449 U.S. 232, 241-42 (1980) (agency action is not final and reviewable when it “is a determination only that adjudicatory proceedings will commence,” and has no effect “except to impose upon [a party] the burden of responding to the charges made against it”); *Automated Merchandizing Sys., Inc. v. Lee*, 782 F.3d 1376, 1381 (Fed. Cir. 2015).

¹⁰ Although the deadline for completing an IPR may be adjusted when joinder is granted, *see* 35 U.S.C. § 316(a)(11), the Board in all cases operates under a statutory command to “timely complete proceedings.” 35 U.S.C. § 316(b). Moreover, if VirnetX were to obtain the relief it seeks, and joinder and institution of the Apple IPRs were vacated, the Mangrove IPRs would again be governed by the specific statutory deadlines of § 316(a)(11).

dispatch” compels the conclusion, in the absence of legislative history to the contrary, “that Congress contemplated that PTO proceedings would not be stayed.” *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1426 (Fed. Cir. 1988). The IPR statute’s specific deadlines for completing reviews, and the evident congressional purpose to avoid the delays that plagued the previous system,¹¹ compel the same conclusion here. In order to allow the Board to comply with its statutory obligations, and because mandamus relief is in any event unavailable to relieve of party of the burden of defending itself in an IPR, the Director respectfully requests that this Court decline to stay of Board proceedings that are the subject of petitions for mandamus relief, at least absent a compelling showing of an immediate, irreparable injury that is a cognizable basis for mandamus relief.

CONCLUSION

For the foregoing reasons, this Court should deny the petition for mandamus relief and vacate the stay of the Board’s proceedings.

¹¹ See 157 Cong. Rec. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl).

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on March 14, 2016, I electronically filed the foregoing RESPONSE OF THE DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE using the Court's CM/ECF filing system. Counsel for the petitioner and respondent was electronically served by and through the Court's CM/EMF filing system per Fed. R. App. 25 and Fed. Cir. R. 25(a) and 25(b).

/s/ Joseph Matal

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