

Thryv, Inc. v. Click-To-Call Technologies, Inc., 140 S. Ct. 1367 (2020)

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In *Thryv, Inc. v. Click-To-Call Technologies, LP*, 140 S. Ct. 1367 (2020), the Supreme Court held that patent owners cannot appeal determinations by the Patent Trial and Appeal Board declining to apply the time bar of 35 U.S.C. § 315(b). In reaching this conclusion, the Supreme Court had to reconcile this outcome in *Thryv* with its decision in *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018). In *SAS*, the Court rejected the argument that the appeal bar of 35 U.S.C. § 314(d) precluded judicial review of the Board's then widely utilized partial-institution practice. The majority opinion in *Thryv* (authored by the late Justice Ginsburg) distinguished the issue raised in *SAS*—namely, whether the Board can properly institute an *inter partes* review (IPR) on some, but not all, claims challenged in a petition—as relating to “the manner in which the agency's review ‘proceeds’ once instituted” as opposed to “whether the agency should have instituted review at all.”

The *Thryv* majority reasoned that “[b]ecause § 315(b)'s sole office is to govern institution...[the] contention remains, essentially, that the agency should have refused to institute *inter partes* review,” and, “§ 314(d) makes that contention unreviewable.” Justice Gorsuch, joined in part by Justice Sotomayor, dissented from the majority's interpretation of § 314(d) on the grounds that its scope is expressly limited, consistent with the presumption of judicial review.

In the wake of *Thryv*, the Federal Circuit has aligned related aspects of its precedent. In *ESIP Series 2, LLC v. Puzhen Life USA, LLC*, 958 F.3d 1378, 1384 (Fed. Cir. 2020), the patent owner appealed a final determination by the Board that the petitioner had named “all real parties in interest” as required by 35 U.S.C. § 312(a)(2). In declining to review the real party in interest issue, the Federal Circuit held that, based on *Thryv*, “we find no principled reason why preclusion of judicial review under § 314(d) would not extend to a Board decision concerning the ‘real parties in interest’ requirement.” In *SIPCO, LLC v. Emerson Elec. Co.*, 980 F.3d 865, 873 (Fed. Cir. 2020), the Federal Circuit held that covered-business-method eligibility is likewise unreviewable.

Similarly, in *In re Cisco Sys. Inc.*, 2020 WL 6373016 (Fed. Cir. Oct. 30, 2020), the Federal Circuit rejected the petitioner's bid to prevent the Board's reliance on its

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own precedents, which look to the stage of any parallel proceedings in assessing whether to deny institution of an IPR. The court explained, “[a]t bottom, Cisco is challenging whether the Board has authority to consider the status of parallel district court proceedings as part of its decision under § 314(a) in deciding whether to deny institution,” noting that “[s]uch challenges, both procedural and substantive, rank as questions closely tied to the application and interpretation of statutes relating to the Patent Office's decision whether to initiate review, and hence are outside of our jurisdiction.”

However, *Thryv* still permits challenges to “the manner in which the agency's review ‘proceeds’ once instituted.” This distinction was critical to the Federal Circuit's decision in *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321 (Fed. Cir. 2020), which rejected the Board's interpretation of the joinder provision of 35 U.S.C. § 315(c). Facebook had argued that *Thryv* precludes appellate review of the Patent and Trademark Office's “decision to institute a second IPR and join it to an existing IPR,” emphasizing that § 315(c) requires a request for joinder to be accompanied by a petition for IPR. According to Facebook, “Windy City's attack on joinder is that the follow-on IPRs should not have been instituted at all,” making it among the issues that *Thryv* categorized as non-appealable under Section 314(d). The Federal Circuit disagreed, holding that “[t]he statute makes clear that the joinder decision is made *after* a determination that a petition warrants institution, thereby affecting the manner in which an IPR will proceed,” and, because the joinder decision is a separate and subsequent to the institution decision, “[n]othing in § 314(d), nor any other statute, overcomes the strong presumption that we have jurisdiction to review that joinder decision.”