

Nos. 25-132, 25-133

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*In the*  
**United States Court of Appeals**  
*for the*  
**Federal Circuit**

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In re: SAP AMERICA, INC.,  
*Petitioner*

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*On Petitions for Writ of Mandamus to the United States Patent  
and Trademark Office in Nos. IPR2024-01495 and IPR2024-01496*

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**BRIEF OF AMICUS CURIAE ALLIANCE OF U.S. STARTUPS &  
INVENTORS FOR JOBS (“USIJ”) SUPPORTING RESPONDENT  
THE UNITED STATES PATENT AND TRADEMARK OFFICE AND  
URGING DENIAL OF THE PETITION FOR WRIT OF MANDAMUS**

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July 14, 2025

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**UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT****CERTIFICATE OF INTEREST**

**Case Number** 25-132, 25-133

**Short Case Caption** In re SAP America, Inc.

**Filing Party/Entity** Alliance of U.S. Startups & Inventors for Jobs ("USIJ")

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- BioCardia
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## STATEMENT OF INTEREST OF *AMICUS CURIAE*

The Alliance of U.S. Startups and Inventors for Jobs (“USIJ”) is a coalition of 22 startup companies and their affiliated executives, inventors and investors, all of whom share a common dependence on stable and reliable patent protection for their businesses. A list of USIJ members is attached to the Certificate of Interest.<sup>1</sup> USIJ was formed in 2012 to address concerns that legislation, policies and practices adopted by Congress, the Federal Judiciary and Federal agencies place inventors and small companies in a Sisyphean position relative to their larger incumbent rivals, both domestic and foreign, and others that would misappropriate their inventions. Independent inventors, entrepreneurs, startups and the investors who finance them (“USIJ Cohort”) are responsible for a disproportionately large number of breakthrough innovations and should be rewarded as such.

USIJ’s fundamental mission is to assist and educate Members of Congress, the Federal Judiciary, and leaders in the Executive branch regarding the critical role that patents and other intellectual property rights play in our nation’s economic system and the particular importance of startups and small companies to our country’s dominance of strategically critical technologies for more than a century.

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<sup>1</sup> No party’s counsel authored this amicus brief in whole or in part; no party or party’s counsel contributed money that was intended to fund preparing or submitting the brief; and, no person – other than the *amicus curiae*, its members, or its counsel – contributed money to fund the preparation or submission of this brief.

## SUMMARY OF ARGUMENT

USIJ opposes SAP America Inc.’s Petition for a Writ of Mandamus (Dkt. 25-132). At bottom, Petitioner complains about internal processes used by the Patent Trial & Appeal Board (“PTAB”) and Acting Director of the U.S. Patent and Trademark Office (“USPTO”) in handling matters that – by statute – fall entirely within the discretion of the agency. The USIJ Cohort is particularly concerned with any ruling that would limit the Director’s broad discretionary power to deny institution of an Inter Partes Review (“IPR”), because in many instances that discretionary power is the *only* legal mechanism that can prevent the abusive use of IPRs by large infringers to suppress inventors and small companies and to discourage the enforcement of their patents.

The PTAB and its IPR procedures were created by the Leahy-Smith America Invents Act (“AIA”) in 2011, and were implemented by the USPTO in 2012. From the outset, the PTAB was heavily biased in favor of accused infringers – allowing multiple challenges to the same patent by the same petitioner, allowing challenges to a patent on which this Court had already ruled in favor of the patent owner on validity, subjecting the same patent to serial challenges from entities acting on behalf of one another, using claim construction rules that encompassed more prior art than

they would have if applied to infringing products, etc.<sup>2</sup> Fourteen years of abuse of inventors has caused a significant decline in the number of startups willing to challenge large incumbents as emerging competitors, with devastating impact on competition and the kinds of innovation that only small companies and individual can provide to our nation.<sup>3</sup>

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<sup>2</sup> See, e.g., Adam Mossoff, BIG TECH’S ABUSE OF PATENT OWNERS IN THE PTAB MUST END, Legal Memorandum published by The Heritage Foundation (2023) <https://www.heritage.org/sites/default/files/2023-06/LM336.pdf>. Professor Mossoff describes in detail the pattern of inventor abuse that a few large electronic companies have carried out with the assistance of the PTAB. It is shameful outcome for what was intended to be just a more efficient way for all parties to resolve patent disputes.

<sup>3</sup> While many large technology companies, such as those that comprise the membership of the so-called Innovation Inventors’ Alliance (“HTIA”), for example, often pretend that they are responsible for much of the innovation that our country has enjoyed over the last three decades, in reality most breakthrough innovation is the product of individual inventors and startups. Numerous studies have shown that the internal profit and bonus dynamics of large companies rarely tolerate disruptive innovation, so that what passes for “innovation” is really just marginal improvements on existing technologies. See, e.g., Clayton Christensen, “INNOVATORS DILEMMA,” Harvard Business Review Press (1997), whose studies describe a number of industries where disruptive innovation caused the company’s failure. Accord: Chris Miller, “CHIP WARS,” Simon & Schuster (2022), pp. 191-97, describing Intel’s inability to innovate and enter the market for mobile processing until after smaller companies successfully developed low power chips necessary for smartphones. Accord: Michael Hiltzik, “DEALERS OF LIGHTNING,” Harper Collins Publishing (1999), describing Xerox’s recognition in 1970 that the dawn of digital imaging ultimately would destroy its analog copier business and so created Xerox Parc staffed with some of the most brilliant young inventors and scientists in the world, only to discover that the institutional forces within the company still would not allow much of the resulting innovation to come to market.

Part I describes the dispositive impact of 35 U.S.C. § 314, which is not subject to any exceptions – institution of an IPR is a determination for the PTO Director as a matter of discretion, following which there is no appeal by either party. This Petition for an extraordinary writ is simply an effort by a large provider of enterprise software to avoid the clear language of Section 314(d). One of the primary prerequisites for mandamus is that the petitioner would be left without a remedy if the petition were denied.<sup>4</sup> Certainly that is not the case here; Petitioner retains the full right to assert invalidity in the district court where it was sued.

Part II describes the legislative history of IPRs and the PTAB, showing that some members of Congress were extremely concerned that creating IPRs would allow large companies to harass brilliant inventors and startups by attacking the validity of their patents at any time during the patents' effective lives. To address this concern, Congress gave broad discretionary power to the Director to prevent such abuse by refusing to institute IPRs, thereby leaving an accused infringer to establish invalidity in the district court, which was the normal practice for more than two centuries prior to enactment of the AIA.

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<sup>4</sup> *E.g., United States ex rel. Girard Trust Co. v. Helvering*, 301 U.S. 540, 544 (1937) (“settled rule that the writ of mandamus may not be employed to secure the adjudication of a disputed right for which an ordinary suit affords a remedy equally adequate, and complete”).

Part III addresses Petitioner’s assertions that the PTAB’s denial of institution resulted from a retroactive withdrawal of its earlier guidance and thus was a denial of due process. Petitioner’s claims that it “relied” on the prior Director’s guidance in deciding to challenge Cyandia’s patents, was unfounded and meaningless. Former Director Vidal’s Memorandum of June 21, 2022, on its face, was merely an “interim procedure” until the PTO promulgated a formal regulation, which it never succeeded in doing.<sup>5</sup> The Vidal Memorandum specifically noted, in its penultimate sentence, that it would remain in place only until further notice. That notice was given on February 28, 2025, the day that Hon. Howard Lutkin was confirmed as Secretary of Commerce and began to implement his publicized objective of reducing the PTO’s backlog as rapidly as possible.

Moreover, there was nothing improperly “retroactive” about the restoration of the *Fintiv* factors to address pending cases. Courts and administrative agencies often announce changes in existing rules of law that then are applied both to the parties before them and also to other pending matters.<sup>6</sup> Although perhaps disappointing to

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<sup>5</sup> Kathy Vidal, Memorandum on Interim Process for Director Review (USPTO June 21, 2022), <https://www.uspto.gov/sites/default/files/documents/interim-proc-dir-review-20220621.pdf>.

<sup>6</sup> See, e.g., *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 76-77 (2012) wherein the Supreme Court held for the first time that diagnostic tests were not eligible for patent coverage. That decision was not only applicable to the two parties but to hundreds of existing patents and patent applications covering

Petitioner, there was no denial of due process, because Petitioner never had a cognizable right to the institution of its IPR. The statutory scheme for IPR procedure, from the very outset, gave the Director ample discretion to deny institution as part of the Director's overall task of running the agency. Petitioner's cited cases apply other statutes differing significantly from 35 U.S.C. § 311, *et seq.*, wherein Congress created a comprehensive statutory framework allowing the defendant in a pending district court case – with the discretionary approval of the Director and the PTAB – to litigate validity before the federal agency that issued the patent. That is unlike any of the other situations relied on by Petitioner.

In Part IV, we address Petitioner's argument that denial of its IPR petition by the PTAB and the Acting Director's confirmation of that action violated the separation of powers. This argument is difficult to understand and certainly is not persuasive. The PTAB did not "mandate" that Petitioner "accept a more expansive estoppel," as Petitioner argues. The PTAB, in assessing the weight to be accorded each of the *Fintiv* factors, merely noted that the existing stipulation between SAP and Cyandia did not separate fully the IPR from the district court litigation in terms

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inventions developed at the cost of years of human endeavor and millions of dollars in research in reliance on the viability of the US Patent system. By comparison, any inconvenience to Petitioner, whose preparation for an IPR will still remain useful in its district court case, becomes vanishingly insignificant – hardly a disappointment rising to the level of a denial of due process.

of the evidence and witnesses that would be testifying. The PTAB's denial of institution does not suggest that it would have reached a different result if the stipulation between Petitioner and the patent owner had fully separated the two cases. Conversely, the same outcome might have been reached by former Director Vidal based on the same incompleteness of the separation. The denial of institution was entered after the PTAB considered and weighed each of the *Fintiv* factors, a determination that under Section 314(a) was well within the discretion of the Director and under Section 314(d) became final and not appealable. SAP's Petition should be denied.

## ARGUMENT

### **I. 35 U.S.C. § 314 Governs the Outcome of the Petition.**

The impact of 35 U.S.C. § 314 is dispositive of this Petition. This section provides the USPTO Director the discretion to determine whether to institute an IPR proceeding, and provides in subsection (d) that all such determinations are final and not appealable. *See* 35 U.S.C. § 314(d). Any ambiguity about the full scope of the Director's discretion was resolved unequivocally by the Supreme Court's decision in *Cuozzo Speed Technology LLC v Lee*, 579 U.S. 261 (2016), holding that the AIA precludes judicial review of a Director's determination as to institution of an IPR "where the grounds for attacking the decision to institute ... consist of questions that

are closely tied to the application and interpretation of the statute [related to that determination].” 579 U.S. at 274-75. And in *Thryv, Inc. v. Click-To-Call Technologies, LP*, 590 U.S. 45 (2020), where the Supreme Court again emphasized that judicial review of the Director’s decision to institute an IPR would not be proper, even if based on an untimely petition filed in violation of Section 315(b). See 590 U.S. at 47. Justice Ginsburg, writing for the majority, followed the Court’s earlier ruling in *Cuozzo*, holding that a PTAB determination as to whether an IPR is time-barred under 35 U.S.C. § 315(b) cannot be appealed in light of “Cuozzo’s holding that § 314(d) bars review of matters ‘closely tied to the application and interpretation of statutes related to [the institution decision].” 579 U.S. at 274-75. And since Section 315 deals specifically with the relationship between a district court action and an IPR, Petitioner similarly cannot contest that this matter is “closely tied to the application and interpretation” of the IPR statute.

## **II. Congress Provided the Director with Broad Discretionary Powers to Prevent Abuse and Harassment of Inventors and Small Companies.**

The legislative history of the AIA and the policies behind the creation of the PTAB’s post-issuance review processes provide an important foundational basis for why Congress decided to give such broad discretionary powers to the Director. In providing for a post-issuance proceeding, Congress initially proposed to create only a procedure similar to the post-issuance opposition procedure used by a number of

countries in Europe – the Post-Grant Review (“PGR”) procedures set forth in 35 USC §§ 321-329. PGRs allow anyone wishing to challenge the validity of a newly issued patent, on any ground, to do so within the 9-month period following issuance. After that, the 9-month window closes and further challenges to validity are barred.

Before enactment of the AIA, however, a number of digital technology companies and others that would benefit from weaker patent protection managed to include in the bill a so-called “second window” that would allow a more limited challenge lasting for the life of a patent.<sup>7</sup> The second window matured into what is now the IPR procedure found in 35 U.S.C. §§ 311-319. Initially, many members of Congress remained concerned about the potential for abuse of inventors and patent owners,<sup>8</sup> but Congress was told that IPRs would be used only rarely, and that the primary use of the new procedures would be in PGRs that were time limited.<sup>9</sup>

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<sup>7</sup> The legislative process enacting the AIA was described in detail in an article entitled “A Look Back to the Legislative Origins of IPRs,” <https://ipwatchdog.com/2017/09/20/look-back-legislative-origin-iprs/id=88075>. The author, Philip S. Johnson, was at the time Senior Vice President – Intellectual Property Policy & Strategy for Johnson & Johnson and played a significant role in the negotiations that led to the final wording of the AIA. The article traces the stark departure of the actual implementation from what Congress intended.

<sup>8</sup> Additional details of the legislative history are set forth in a 2018 USIJ White Paper showing Congress’s clear intent to ensure that serial and multiple attacks on the same patent would be avoided. <https://usij.org/wp-content/uploads/2024/07/FINALUSIJSerialIPRWhitePaper-Oct1720181.pdf>.

<sup>9</sup> The House Judiciary Committee report on the AIA makes the Committee’s intent very clear:

To carry out these congressional expectations, the PTO Director was given exceptionally broad discretion with respect to the institution and outcomes of IPRs, a grant that empowers that office to refuse institution without review and to preclude the very kinds of abuse with which Congress was concerned.<sup>10</sup> By including Section

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The intent of the post-grant review process is to enable early challenges to patents, while still protecting the rights of inventors and patent owners against new patent challenges unbounded in time and scope. ... The Committee recognizes the importance of quiet title to patent owners to ensure continued investment resources. While this amendment is intended to remove current disincentives to current administration processes, the changes made by it are not to be used as tools for harassment or a means to prevent market entry through repeated litigation and administration attacks on the validity of a patent. Doing so would frustrate the purposes of the section as providing quick and cost-effective alternatives to litigation. Further, such activity would divert resources from the research and development of inventions.

H.R. Rept. 112-98, at 47–48 (2011).

<sup>10</sup> Unfortunately, the history of IPRs during the first 14 years since enactment of the AIA reflects a great deal of the very kinds of abuse of startups and small companies that concerned Congress from the outset. On average, more than 70% of patents for which IPRs are instituted have resulted in some or all claims being invalidated. See Stephen Schreiner, Recent Statistics Show PTAB Invalidation Rates Continue to Climb, *IP Watchdog* (June 25, 2024), <https://ipwatchdog.com/2024/06/25/recent-statistics-show-ptab-invalidation-rates-continue-climb/id=178226>.

Many patent owners have been forced to endure successive challenges to the same patent claim, the most egregious example being claim 16 of U.S. Patent No. 7,619,912 issued to Netlist in 2007. That patent has been subjected to demands for reexamination and IPRs for nearly 18 years, first by Google and then by Samsung, Google's supplier for the infringing product. After multiple failures over the period, the Samsung IPR finally hit the right PTAB panel and prevailed after a mistaken claim construction, a matter now on appeal to this Court (Dkt. 24-2304).

314(d) and cutting off any opportunity for appeal, Congress made certain that petitioners for IPRs did not have the ability to prolong costly litigation by filing appeals from denials (as Petitioner here is doing).

### **III. Acting Director Stewart’s Withdrawal of Former Director Vidal’s Interim Memorandum Did Not Result in a Violation of Due Process.**

At bottom, the petition is a disguised effort to circumvent the intentionally broad sweep of 35 U.S.C § 314(d). As noted in Section I, that provision states unambiguously and without qualification that the determination of whether or not to institute an IPR is final and nonappealable. Such grant of statutory authority should, in and of itself, spell the end of the discussion. Further, while the PTAB and the Acting Director were not required by the statutory scheme of the AIA to justify a determination decision, the written denial here nevertheless shows that the agency did in fact assess carefully each of the *Fintiv* factors and further addressed the impact of Petitioner’s so-called *Sotera* stipulation.

Petitioner appears to contend, however, that the PTAB should not have applied the *Fintiv* factors to its IPR petition, because the *Apple v Fintiv* precedential decision<sup>11</sup> was supplemented in 2022 by interim guidance from former Director Vidal and that Petitioner “relied” to its detriment on the 2022 guidance in preparing

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<sup>11</sup> *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5-6 (PTAB Mar. 20, 2020) (precedential).

its IPR petition, the loss of which Petitioner purports to be a denial of due process. There are several answers to that contention. First, it is difficult to see how anyone confronting the broad discretionary regime for institution created by the AIA could actually have expected institution as a matter of right and protected by the due process clause of the Fifth Amendment. In *Oil States*, the Supreme Court held that the statutory scheme created by the AIA did not violate the constitutional rights of the patent owner, even though the institution of an IPR threatened permanently to extinguish patent owner's property right. See *Oil States Energy Servs., LLC v. Greene's Energy Grp., LLC*, 584 U.S. 325, 333-34 (2018). An even stronger case for preserving the statutory scheme exists here, where Petitioner has lost *only* the opportunity to challenge the Cyandia patents in an administrative proceeding but may continue to challenge those same rights in the district court action, which is unaffected by the denial.

Moreover, a careful reading of the PTAB's denial of institution shows not only a thoughtful and thorough application of each of the six *Fintiv* factors, the PTAB also addressed what it considered to be shortcomings in Petitioner's *Sotera* stipulation, in that a significant portion of the evidence of invalidity would still be offered in both the IPR and the district court proceeding. The PTAB considered that duplication to be a waste of resources. Given the broad discretion accorded the Director in determining how best to deploy limited resources and whether to institute

any given IPR, Petitioner had no guarantee that Director Vidal might not have reached the same decision while her guidance was still in effect. Justice Ginsburg’s opinion in *Thryv* seems particularly applicable to Petitioner’s contention here: “*Cuozzo*’s holding that § 314(d) bars review at least of matters ‘closely tied to the application and interpretation of statutes related to [the institution decision].’” 579 U.S. at 274-75.

Additionally, the concept of “due process” is used in the 5th Amendment to protect “life, liberty and property.” It borders on the preposterous to argue that an opportunity to initiate an IPR falls into one of those categories.

As part of its due process argument, Petitioner also claims that Acting Director Stewart’s February 28, 2025 withdrawal of Director Vidal’s June 2022 Memorandum<sup>12</sup> while Petitioner’s IPR petition was pending amounts to a “retroactive” law. Petitioner also is wrong on this point. Numerous civil law rules adopted by courts and administrative tribunals rulings are allowed to take effect immediately upon adoption without regard to the impact of such rulings on pending matters. This point is readily apparent in the very PTO policy memorandum on which Petitioner relies; the document entitled “Interim Procedure for Discretionary

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<sup>12</sup> See e.g. Scott Boalick, Memorandum on Guidance on USPTO’s rescission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation” (USPTO March 24, 2025).

Denials in AIA Post-grant Proceedings with Parallel District Court Litigation,” issued by former Director Vidal, dated June 21, 2022. That policy took effect as soon as it was released, no doubt pleasing some parties in pending matters and displeasing others. The same was true of the precedential decisions of the PTAB in *Apple v. Fintiv*, and *NHK Spring Co. v. Intra-Plex Technologies, Inc.*, IPR2018-00752, Paper 8 (2018), on which the PTAB in *Fintiv* relied. In *NHK*, the PTAB stated (for the first time) that where parallel litigation is pending between the same two parties, the status of the district court litigation could be considered in determining whether or not to institute an IPR. And as noted here in the Summary, footnote 6, rulings of the Supreme Court that make significant changes in the law become applicable to pending litigation in countless areas of jurisprudence. There simply is no denial of due process when changes are made in the civil law, however disappointing they may be to civil litigants.<sup>13</sup>

#### **IV. Because SAP Can Assert the Same Invalidity Defenses at District Court, the PTAB’s Denial of SAPs Petition for IPR is not a Violation of Separation of Powers.**

Petitioner argues that denial of its IPR petition by the PTAB and the Acting Director’s confirmation of that action violated the separation of powers in that an administrative agency, as a condition of institution, mandated its relinquishment of

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<sup>13</sup> Obviously, criminal statutes that carry sanctions for previously lawful behavior are applied only prospectively.

rights created by Congress to assert defenses. The argument is difficult to understand and certainly is not persuasive. The PTAB did not “mandate” that Petitioner “accept a more expansive estoppel,” as Petitioner argues. The PTAB, in assessing the weight to be accorded each of the *Fintiv* factors, noted that the existing stipulation between SAP and Cyandia did not separate fully the IPR from the district court litigation in terms of the evidence and witnesses that would be testifying. Such a separation, of course, was one of the underlying reasons for giving effect to the *Sotera* stipulation in the first place. The denial did not mandate any action by Petitioner. Indeed, Petitioner was not required to commence an IPR at all; it could have litigated all validity issues in district court, as those accused of infringement have done for years. Moreover, the PTAB’s denial of institution does not even suggest that it would have reached a different result if the stipulation between Petitioner and the patent owner had fully separated the two cases. The PTAB denied institution after considering and weighing each of the *Fintiv* factors, a determination that under Section 314(a) was well within the Director’s discretion and under Section 314(d) became final and not appealable.

## CONCLUSION

SAP's Petition for Mandamus should be denied. For reasons set forth above, *amicus curie* USIJ urges denial of the request for extraordinary relief and confirmation that the PTAB and Acting Director's decision on institution remain in place.

Dated: July 14, 2025

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**UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT**

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