NOTE: This order is nonprecedential.

United States Court of Appeals for the Federal Circuit

RUIZ FOOD PRODUCTS, INC.,
Appellant

v.

MACROPOINT, LLC,
Appellee

ANDREI IANCU, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE,
Intervenor

2019-2113, -2114

Appeals from the United States Patent and Trademark Office, Patent Trial and Appeal Board in Nos. IPR2017-02016 and IPR2017-02018.

Before MOORE, O'MALLEY, and STOLL, *Circuit Judges*.

O'MALLEY, *Circuit Judge*.

O R D E R

Having received the parties' responses and supplemental responses to this court's October 17, 2019 and May

21, 2020 orders, we now dismiss Ruiz Food Products, Inc.'s appeals and deny its request for mandamus.

BACKGROUND

Ruiz Food appeals decisions of the Patent Trial and Appeal Board ("the Board") terminating *inter partes* review ("IPR") proceedings based on 35 U.S.C. § 315(a)(1). That statutory provision, entitled "Inter partes review barred by civil action," provides that "[a]n 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." 35 U.S.C. § 315(a)(1).

MacroPoint, LLC is the owner of the two patents at issue in these matters. FourKites, Inc. filed a declaratory judgment action challenging the validity of those patents, which was dismissed without prejudice. Ruiz Food subsequently petitioned the Patent Office for IPR of the patents, identifying FourKites as a real party in interest. The Director of the United States Patent and Trademark Office, acting through the Board, instituted review in March 2018. In doing so, the Board relied on its belief at the time that, for § 315(a)(1) purposes, a dismissal without prejudice nullified the effect of the filing of a declaratory judgment complaint.

In September 2018, however, the Board allowed MacroPoint leave to file a motion to dismiss based on this court's intervening decision in *Click-to-Call Technologies, LP v. Ingenio, Inc.*, 899 F.3d 1321 (Fed. Cir. 2018) (en banc in relevant part), *rev'd sub nom. Thryv, Inc. v. Click-to-Call Technologies, LP*, 140 S. Ct. 1367 (2020). In February 2019, the Board granted MacroPoint's motions and terminated the proceedings without addressing any issues of patentability. The Board noted that there was no dispute that FourKites was a real party in interest. The Board further concluded that, under the reasoning of this court's decision in *Click-to-Call* as applied to 35 U.S.C. § 315(b),

FourKites had filed a civil action that triggered § 315(a)(1), even though that complaint was subsequently dismissed. Notably, the Director has since explained that the Board's original understanding of the impact of a dismissal without prejudice on the application of § 315(a)(1) was erroneous and that he agrees with this court's merits determination to the contrary in *Click-to-Call*. These appeals followed, and proceedings were stayed pending the Supreme Court's review in *Thryv*.

DISCUSSION

In appeals arising from the Board in IPR, we do not have jurisdiction to review determinations concerning whether proceedings should or should not have been instituted. Section 314(d) of title 35 of the U.S. Code specifically provides that "[t]he determination by the Director whether to institute an inter partes review under this section shall be final and nonappealable." That bar on appellate review, we have explained, extends beyond the initial determination to cover circumstances, like those presented here, where the Board reconsidered its decision to institute and terminated the proceeding. *See GTNX, Inc. v. INTTRA, Inc.*, 789 F.3d 1309, 1312 (Fed. Cir. 2015).

Thryv did not overrule our precedent on this point, as Ruiz Foods argues. In *Thryv*, the Court reaffirmed its holding in *Cuozzo Speed Technologies, LLC v. Lee*, 136 S. Ct. 2131, 2141 (2016) that § 314(d) bars review of matters "closely tied to the application and interpretation of statutes related to the Patent Office's decision to initiate inter partes review." The issue in *Thryv* was whether § 314(d) barred judicial review of a challenge to the Board's institution of proceedings under § 315(b). The Supreme Court held that the Board's decision could not be challenged on that ground because "Section 315(b)'s time limitation is integral to, indeed a condition on, institution." *Thryv*, 140 S. Ct. at 1373.

Thryv is fully consistent with our long-standing precedent that decisions to terminate an instituted IPR are not reviewable. Like the provision at issue in *Thryv*, § 315(a)(1) is clearly "a condition on" institution. *Id.* It provides that review "may not be instituted" if before the petition is filed, a real party in interest, such as FourKites, "filed a civil action challenging the validity of a claim of the patent." § 315(a)(1). *See also ESIP Series 2, LLC v. Puzhen Life USA, LLC*, 958 F.3d 1378, 1386 (Fed. Cir. 2020). Ruiz Food's claim that the Board's dismissal was driven by the mistaken understanding that this court's en banc decision in *Click-to-Call* was binding upon it amounts to nothing more than "an ordinary dispute about the application of an institution-related statute." *Thryv*, 140 S. Ct. at 1373 (internal quotation marks and citation omitted).

Ruiz Food alternatively requests that we treat its appeals as petitions seeking mandamus. But Ruiz Food has not established any clear and indisputable right that would have precluded the Board from terminating proceedings. *See Cheney v. U.S. Dist. Ct. for Dist. of Columbia*, 542 U.S. 367, 381 (2004) (requiring that a petitioner seeking mandamus show that the right to relief is "clear and indisputable" (internal quotation marks and citations omitted)). Ruiz Food points to nothing that would prevent the Board from reconsidering its precedent after *Click-to-Call*. Nothing in *Thryv* draws into question this court's view of the merits in *Click-to-Call* or the Board's subsequent agreement with that view. Mandamus for Ruiz Food's other contention, that dismissal was based on what it believes was an "erroneous appellate decision that was subsequently vacated by the Supreme Court," Appellant's Supp. Br. at 10, ECF No. 31-1, also does not merit mandamus relief. The fact that this court may have erroneously exercised jurisdiction over the appeal in *Click-to-Call* does not justify using the vehicle of mandamus in this case to make the same mistake. *See In re Power Integrations, Inc.*, 899 F.3d 1316, 1319 (Fed. Cir. 2018) (noting that "the statutory

prohibition on appeals from decisions not to institute IPR cannot be sidestepped simply by styling the request for review as a petition for mandamus" (citations omitted)).

Accordingly,

IT IS ORDERED THAT:

(1) The stay is lifted and these appeals are dismissed.

(2) The request for mandamus is denied.

(3) Each side shall bear its own costs.

s31