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** Pro hac vice application forthcoming*

*A complete list of parties and counsel appears
on the signature page per Local Rule 3-4(a)(1)*

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16 **UNITED STATES DISTRICT COURT**
17 **FOR THE NORTHERN DISTRICT OF CALIFORNIA**
18 **SAN JOSE DIVISION**

19
20 APPLE INC., CISCO SYSTEMS, INC.,
21 GOOGLE LLC, and INTEL CORPORATION,

22 Plaintiffs,

23 v.

24 ANDREI IANCU, in his official capacity as
25 Under Secretary of Commerce for Intellectual
26 Property and Director, United States Patent and
27 Trademark Office,

28 Defendant.

Case No.: 5:20-cv-6128

**COMPLAINT FOR DECLARATORY
AND INJUNCTIVE RELIEF**

Administrative Procedure Act Case

1 INTRODUCTION

2 1. This action under the Administrative Procedure Act (“APA”) challenges a rule
3 adopted by the Director of the U.S. Patent and Trademark Office (“PTO”) governing that agency’s
4 consideration of petitions to institute inter partes review (“IPR”)—an administrative proceeding for
5 determining the patentability of previously issued patent claims.

6 2. A strong patent system is vital to protecting the massive research and development
7 investments that fuel Plaintiffs’ innovative products and services. And a crucial element of any
8 strong patent system is a mechanism for “weeding out” weak patents that never should have been
9 granted because the claimed invention was not novel or would have been obvious in light of prior art.
10 *Thryv, Inc. v. Click-To-Call Techs., LP*, 140 S. Ct. 1367, 1374 (2020). Such patents threaten
11 innovation—particularly in the hands of non-practicing entities that use the patent system not to spur
12 their own inventions, but to extract monetary returns by asserting weak patents in infringement suits.
13 As frequent targets of such tactics, Plaintiffs have a strong interest in having an efficient and
14 accessible means for challenging weak patents that should never have issued to ensure that such
15 patents cannot hamper innovation.

16 3. IPR was a centerpiece of Congress’s efforts to strengthen the U.S. patent system in the
17 Leahy-Smith America Invents Act (“AIA”). In enacting the AIA in 2011, Congress recognized that
18 innovation is inhibited when invalid patents are issued and then deployed in litigation against
19 technology inventors and developers. And Congress found existing procedures for challenging
20 already-issued patents, including litigation, to be insufficient to protect the patent system. Congress
21 accordingly created IPR to provide a more efficient and streamlined administrative alternative to
22 litigation for determining patentability before specialized patent judges. IPR has served to enhance
23 the U.S. patent system and strengthen U.S. technology and innovation by weeding out thousands of
24 invalid patent claims.

25 4. To ensure that IPR fulfills its purpose as a superior alternative to litigation over patent
26 validity, the AIA specifically contemplates that IPR will be available to determine the patentability of
27 patent claims that are also the subject of pending patent infringement litigation.

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1 5. In the agency action challenged in this suit (referred to here as the “*NHK-Fintiv* rule”),
2 however, the Director determined that the PTO could deny a petition for IPR based on a balancing of
3 discretionary factors relating to the pendency of parallel patent infringement litigation—factors that
4 appear nowhere in the AIA. The agency’s application of that rule has dramatically reduced the
5 availability of IPR, regardless of the weakness of the patent claims being challenged, thereby
6 undermining IPR’s central role in protecting a strong patent system.

7 6. The *NHK-Fintiv* rule violates the AIA, which allows IPR to proceed in tandem with
8 infringement litigation involving the same patent claims so long as the IPR petition is filed within one
9 year after the petitioner was served with the complaint in the infringement suit. Congress dictated in
10 the AIA exactly when litigation should take precedence over IPR and vice versa, and the *NHK-Fintiv*
11 rule contravenes Congress’s judgment. Indeed, the *NHK-Fintiv* rule defeats the purpose of IPR,
12 which is to provide a streamlined and specialized mechanism for clearing away invalid patents that
13 never should have issued, and to do so without the substantial costs, burdens, and delays of litigation.

14 7. The *NHK-Fintiv* rule is also arbitrary and capricious because its vague factors lead to
15 speculative, unpredictable, and unfair outcomes and will not advance the agency’s stated goal of
16 promoting administrative efficiency.

17 8. Finally, even if it were not contrary to law, the *NHK-Fintiv* rule is procedurally invalid
18 because it was not adopted through notice-and-comment rulemaking. Both the APA and the AIA
19 obligated the Director to follow that procedure, yet the Director instead propounded the *NHK-Fintiv*
20 rule through an internal process within the PTO for establishing binding rules by designating select
21 decisions of the Patent Trial and Appeal Board as “precedential”—a process that provides for no
22 opportunity for or consideration of public input.

23 9. The Court should therefore declare the *NHK-Fintiv* rule unlawful and set it aside under
24 the APA. The Court should further permanently enjoin the Director from applying the rule or the
25 non-statutory factors it incorporates to deny institution of IPR.

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JURISDICTION AND VENUE

10. This case arises under the Administrative Procedure Act (“APA”), 5 U.S.C. § 701 *et seq.* This Court has subject matter jurisdiction under 28 U.S.C. § 1331.

11. Pursuant to 5 U.S.C. § 702, Defendant has waived sovereign immunity for purposes of this suit.

12. Plaintiffs’ claims for declaratory and injunctive relief are authorized by 28 U.S.C. §§ 2201 and 2202, by 5 U.S.C. §§ 702-706, by Federal Rules of Civil Procedure 57 and 65, and by the inherent equitable powers of this Court.

13. Venue is proper in this District under 28 U.S.C. § 1391(e) and 5 U.S.C. § 703 because at least one Plaintiff maintains its headquarters in this District.

14. The *NHK-Fintiv* rule is final agency action subject to judicial review under 5 U.S.C. § 704.

INTRADISTRICT ASSIGNMENT

15. This action arises in the San Jose Division because a substantial part of the events giving rise to Plaintiffs’ claims occurred in Santa Clara County, California, where all Plaintiffs maintain their headquarters.

PARTIES

16. Plaintiff Apple Inc. (“Apple”) is a California corporation having its principal place of business at One Apple Park Way, Cupertino, California, 95014.

17. Plaintiff Cisco Systems, Inc. (“Cisco”) is a California corporation having its principal place of business at 170 West Tasman Drive, San Jose, California, 95134.

18. Plaintiff Google LLC (“Google”) is a Delaware limited liability company having its principal place of business at 1600 Amphitheatre Parkway, Mountain View, California, 94043.

19. Plaintiff Intel Corporation (“Intel”) is a Delaware corporation having its principal place of business at 2200 Mission College Boulevard, Santa Clara, California, 95054.

20. Defendant Andrei Iancu is the Under Secretary of Commerce for Intellectual Property and Director of the PTO. The Director oversees the operations of the PTO and is statutorily vested

1 with the authority to decide whether to institute IPR of a patent claim. 35 U.S.C. § 314. Defendant
2 Iancu is being sued in his official capacity. His principal place of business is in Alexandria, Virginia.

3 **FACTUAL ALLEGATIONS**

4 **The Patent System**

5 21. “To promote the progress of science and useful arts,” the Constitution empowers
6 Congress to “secur[e] for limited times to ... inventors the exclusive right to their ... discoveries.”
7 U.S. Const., art. I, § 8, cl. 8. The U.S. patent system has long fueled American economic growth and
8 innovation. Plaintiffs each strongly support and rely on a strong patent system that lends robust legal
9 protection to meritorious patent claims.

10 22. Apple is an American success story and developer of iconic consumer devices and
11 software that have transformed the American economy. With more than 90,000 employees in the
12 United States, Apple is one of the country’s largest employers in the high-technology business sector.
13 Overall, Apple supports 2.4 million jobs in all 50 states. Last year, Apple spent over \$60 billion with
14 more than 9,000 domestic suppliers across the country, including at manufacturing locations in 36
15 states. Apple invests billions of dollars annually in U.S. research and development, and it owns more
16 than 22,000 U.S. patents that protect that investment.

17 23. Cisco is an American and worldwide leader in information technology, networking,
18 communications, and cybersecurity solutions. Cisco is a strong supporter of the U.S. patent system,
19 owning more than 16,000 U.S. patents, which protect more than \$6 billion in annual spending on
20 research and development. Cisco’s 20,000 worldwide engineers constantly invent new ways to better
21 connect the world. As a result of its commitment to innovation and intellectual property, Cisco files
22 more than 700 patent applications each year seeking protection for those inventions.

23 24. Google is a diversified American technology company whose mission is to organize
24 the world’s information and make it universally accessible and useful. Google offers leading web-
25 based products and services that are used daily around the world. With over 100,000 employees,
26 Google invests over \$20 billion annually to invent and develop its products and services, and it relies
27 on a strong and balanced patent system to protect them—owning more than 25,000 U.S. patents.

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