

CLIENT ALERT

Federal Circuit Has Jurisdiction To Review Mandamus Challenges to Decisions Denying Institution of IPR Proceedings—But Is Unlikely To Grant

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Mylan Laboratories Ltd., v. Janssen Pharmaceutica, N.V., No. 21-1071 (Fed. Cir. Mar. 12, 2021)

Mylan directly appealed and sought mandamus relief on a Patent Trial and Appeal Board (PTAB) decision exercising discretion to deny *inter partes* review (IPR) institution based on application of the factors set forth in *Apple v. Fintiv*, IPR2020-00019 (PT.B Mar. 20, 2020). Janssen moved to dismiss Mylan's appeals for lack of jurisdiction. The Patent Office intervened in support of Janssen's motion. The Federal Circuit held that it did not have jurisdiction over the direct appeal, and although the court had jurisdiction to consider the request for mandamus, Mylan failed to show a clear right to mandamus relief.

The court's analysis first addressed whether it had jurisdiction over Mylan's direct appeal and noted that its jurisdiction is limited to those cases and controversies delineated in Article III of the Constitution, or to those subjects encompassed within a statutory grant of jurisdiction. The court contrasted 28 U.S.C. § 1295(a)(4), which grants jurisdiction only over final written decisions, and 35 U.S.C. § 314(d), which bars appeal from a decision denying institution. Thus, the court dismissed Mylan's direct appeal.

The court held, however, that judicial review is still available in extraordinary circumstances by petition for mandamus. The Federal Circuit reasoned that the All Writs Act empowers the court to issue writs of mandamus necessary to protect its prospective jurisdiction and is especially important when the PTAB denies institution, because a denial precludes a final written decision that would trigger the court's direct appellate jurisdiction under 28 U.S.C. § 1295(a)(4). Thus, the court found it had jurisdiction to consider Mylan's request for mandamus relief.

Mylan's mandamus request challenged "(1) that the PTAB's determination to deny institution . . . based on the timing of a separate district court litigation to which the petitioner is not a party, undermines the petitioner's constitutional and other due process rights; and (2) the PTAB's continued adoption and application of non-statutory institution standards through *ad hoc* proceedings lie in contrast to congressional intent." In addressing this challenge, the court explained that a petitioner must: (1) show that it has a clear and indisputable legal right; (2) show it does not have any other adequate method of obtaining relief; and (3) convince the court that the writ is appropriate under the circumstances. In emphasizing that institution decisions are committed to agency discretion and a petitioner has no right to an institution, the court rejected Mylan's statutory and constitutional challenges and held that Mylan had

failed to show a clear right to relief. The court also noted that “it is difficult to imagine a mandamus petition that challenges a denial of institution and identifies a clear and indisputable right to relief.”

Read the decision [here](#).

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