NOTE: This order is nonprecedential.

United States Court of Appeals for the Federal Circuit

MEDTRONIC, INC.,
Appellant

v.

ROBERT BOSCH HEALTHCARE SYSTEMS, INC.,
Appellee

2015-1977, -1986, -1987

Appeals from the United States Patent and Trademark Office, Patent Trial and Appeal Board in Nos. IPR2014-00488, IPR2014-00607, and IPR2014-00691.

ON MOTION

Before LOURIE, DYK, and HUGHES, *Circuit Judges*.

DYK, *Circuit Judge*.

O R D E R

Robert Bosch Healthcare Systems, Inc. moves to waive the requirements of Federal Circuit Rule 27(f) and dismiss Medtronic, Inc.'s appeals for lack of jurisdiction. Medtronic opposes the motion. Bosch replies to the response.

BACKGROUND

Bosch owns two patents, U.S. Patent Nos. 7,769,605 and 7,870,249, relating to systems and methods for remote patient monitoring. In April 2013, Bosch sued Cardiocom, LLC, Medtronic's subsidiary, in the United States District Court for the Northern District of California, alleging infringement of the two patents.

Cardiocom petitioned the Patent and Trademark Office for *inter partes* review of those two patents, but its petitions were denied by the PTO in January 2014.* A few months later, Medtronic filed its own petitions seeking *inter partes* review of the two Bosch patents. It stated in each of those petitions that Medtronic was the sole real party-in-interest, failing to list Cardiocom.

The Patent Trial and Appeal Board granted Medtronic's petitions and instituted trials with respect to both Bosch patents. But after commencing proceedings, the Board allowed Bosch leave to file a motion to terminate on the grounds that 35 U.S.C. § 312(a)(2) barred review because Medtronic's petitions failed to "identif[y] all real parties in interest."

On March 16, 2015, the Board granted Bosch's motion. Determining that Cardiocom should have been named a real party-in-interest in the proceedings, the Board concluded that Medtronic's petitions were incomplete and therefore vacated the institution decisions and terminated proceedings.

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* Medtronic announced that it acquired Cardiocom while Cardiocom's petitions were pending before the Board. Cardiocom provided notice to the Board, indicating that it became a wholly-owned subsidiary of Medtronic and that Medtronic should be included as an additional real party-in-interest.

After its request for rehearing was denied, Medtronic filed these appeals, which this court consolidated. On September 4, 2015, Medtronic filed its opening brief, arguing that this court has jurisdiction over these appeals, or, in the alternative, that this court should treat these appeals as a petition for a writ of mandamus. Bosch moves to dismiss for lack of jurisdiction.

DISCUSSION

This court lacks jurisdiction over Medtronic's appeals.

Read together, 35 U.S.C. §§ 319 and 141(c) authorize appeals only from a "final written decision of the [Board] under section 318(a)," which in turn refers only to "a final written decision *with respect to the patentability of any patent claim challenged by the petitioner and any new claim added under section 316(d)*." 35 U.S.C. § 318(a) (emphasis added). Here, the Board made no decision "with respect to the patentability" of any claim.

Medtronic argues that this court has authority under 28 U.S.C. § 1295(a)(4)(A) to review the Board's decision. But we have explained that § 1295(a)(4)(A) "is most naturally read to refer precisely to the Board's decision under 318(a) on the merits of the *inter partes* review." *St. Jude Med., Cardiology Div., Inc. v. Volcano Corp.*, 749 F.3d 1373, 1376 (Fed. Cir. 2014). The Board's decision did not make a merits determination, and therefore these appeals are outside the scope of §§ 141(c), 318(a), 319 and, in turn, outside § 1295(a)(4)(A).

The Board's decision to reconsider and vacate its initial institution determination and terminate proceedings is instead fairly characterized as a decision whether to institute proceedings that is "final and nonappealable" under 35 U.S.C. § 314(d). In *GTNX, Inc. v. INTTRA, Inc.*, we explained that "[i]t is strained to describe this as anything but a 'determination . . . whether to institute' proceedings—statutory language that is not limited to an

initial determination to the exclusion of a determination on reconsideration" and that such a decision is "final and nonappealable." 789 F.3d 1309, 1312 (Fed. Cir. 2015) (citations omitted).

Medtronic cites the presumption in favor of judicial review of Board decisions. This court, however, has held that this presumption has been rebutted when it comes to the review of the PTO's determinations at the institution stage. *See Versata Dev. Grp., Inc. v. Lee*, 793 F.3d 1352, 1354 (Fed. Cir. 2015); *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1272–75 (Fed. Cir. 2015); *GTNX*, 789 F.3d at 1312; *St. Jude*, 749 F.3d at 1376; *see also Bowen v. Mich. Acad. of Family Physicians*, 476 U.S. 667, 672–73 (1986) ("Congress can, of course, make exceptions to the historic practice whereby courts review agency action.").

Nor are we convinced by Medtronic's other attempts to explain why *GTNX* is not controlling here. It tries to distinguish *GTNX* on the grounds that it was undisputed in *GTNX* that the petitioner was statutorily barred from pursuing review and the defect was uncurable. This difference, however, does not affect our analysis, which is based on the statutory provisions that preclude review of the Board's decision.

Alternatively, Medtronic requests that we treat this appeal as a petition for writ of mandamus, arguing that the Board committed a number of substantial errors, including (1) failing to accord Medtronic fair notice; (2) improperly finding Cardiocom to be a real-party-in-interest; and (3) failing to allow Medtronic to amend its petitions to add Cardiocom. But it has not demonstrated entitlement to mandamus relief.

In *In re Dominion Dealer Solutions, LLC.*, 749 F.3d 1379 (Fed. Cir. 2014), which also involved a requested *inter partes* review, we denied mandamus based on the absence of a "clear and indisputable" right to relief in view of the statutory scheme precluding review of non-

institution decisions. *Id.* at 1381 (citation and internal quotation marks omitted). Given the same statutory provisions preclude Medtronic from appealing the Board's decision, here too it cannot be said that Medtronic has a clear and indisputable right for this court to hear its challenges to the Board's decision.

Accordingly,

IT IS ORDERED THAT:

(1) Bosch's motion to waive Federal Circuit Rule 27(f) and motion to dismiss are granted. The appeals are dismissed and mandamus relief is denied.

(2) Each side shall bear its own costs.

FOR THE COURT

/s/ Daniel E. O'Toole
Daniel E. O'Toole
Clerk of Court

s32

ISSUED AS A MANDATE: November 17, 2015