

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

MAXPOWER SEMICONDUCTOR, INC.,

Appellant

v.

ROHM SEMICONDUCTOR USA, LLC,

Appellee

**NOTICE OF APPEAL FROM INSTITUTION DECISION
IPR2020-1675**

Notice is hereby given that Patent Owner MaxPower Semiconductor, Inc. (MaxPower) appeals from the Patent Trial and Appeal Board (PTAB)'s April 15, 2021 decision in IPR2020-01675 to institute a trial of MaxPower's U.S. Patent No 8,076,719 B2. MaxPower has filed a mandamus petition challenging the same decision.

Explanation of Issues

MaxPower's appeal presents the following questions:

1. When parties to an arbitration agreement within the scope of 35 U.S.C. §294 have delegated the threshold question of arbitrability to the arbitrator, is the Patent Trial and Appeal Board free to institute *inter partes* review (implicitly

deciding the arbitrability issue) despite the Supreme Court’s admonition that, in “those circumstances, a court possesses no power to decide the arbitrability issue”? *Henry Schein, Inc. v. Archer and White Sales, Inc.*, 139 S. Ct. 524, 529 (2019).

2. By enacting the IPR provisions of the America Invents Act (AIA), 35 USC §§311 *et seq.*, without including mention of arbitration, did Congress intend to override 35 U.S.C. §294 by implication, despite the Supreme Court’s instruction in *Epic Systems Corp. v. Lewis*, 138 S.Ct. 1612 (2018), that “Congress will specifically address preexisting law when it wishes to suspend its normal operations in a later statute,” *id.*, 138 S.Ct. at 1624, so that “the absence of any specific statutory discussion of arbitration [in the IPR statute] ...is an important and telling clue that Congress has not displaced [Section 294]”? *Id.*, 138 S.Ct. at 1627.

Sources of Jurisdiction

The Court of Appeals for the Federal Circuit has jurisdiction to consider MaxPower’s interlocutory appeal under 28 U.S.C. §1295(a)(4)(A) because this is not a “mine run” case where the Board is enforcing the IPR statute. *Cuozzo Speed Technologies LLC v. Lee*, 136 S. Ct. 2131 (2016). Here, MaxPower challenges the PTAB’s interpretation of 35 U.S.C. §294, a statute unrelated to the IPR statute, whose wayward construction (an effective repeal of §294 in the IPR context) reverberates, “in terms of scope and impact, well beyond [the IPR context.]” *Id.* at 2141. MaxPower’s claims must be considered immediately or be mooted because,

even if they are subject to review as part of the Board’s “final written decision,” *id.*, 136 S.Ct. at 2140-2141, as the Supreme Court suggests they should be, “[w]hen that time comes, it will be too late effectively to review [them] and the rights conferred by [Section 294 – including, in this case, the right to have all disputes decided efficiently and privately by an arbitrator whose award on validity would resolve that issue between the parties but have no effect on anyone else] ... will have been lost, probably [and here, where the small licensor bargained with its behemoth licensee for the broad right to efficiently resolve all disputes, without carveout exceptions, in a single arbitral proceeding, most assuredly] irreparably.” *Cohen v. Beneficial Indus. Loan Corp.*, 337 U.S. 541, 546 (1949); *Regents of the Univ. of Minn. v. LSI Corp.*, 926 F.3d 1327, 1343, fn. 2 (Fed. Cir. 2019) (recognizing need for collateral-order review in that case).

Alternatively, the Court may exert jurisdiction under the All Writs Act, 28 U.S.C. §1651, *see Mylan Laboratories Ltd. v. Janssen Pharmaceutica, N.V.*, 989 F.3d 1375, 1377, fn. 1 (Fed. Cir. 2021), and issue a writ of mandamus “to correct a clear abuse of discretion or usurpation of judicial power by [the Board].” *In re Calmar, Inc.* 854 F.2d 461, 464 (Fed. Cir. 1988). Because MaxPower “has a clear and indisputable legal right,” and (if appeal is barred by 35 U.S.C. §314(d)), no “other adequate method of obtaining relief,” “the writ is appropriate under the

circumstances.” *see id.*; *Mylan Labs.*, 989 F.3d at 1381 (granting mandamus relief to correct “clear abuse of discretion”).

Dated this 13th day of May, 2021.

/s/ Roger L. Cook

ROGER COOK LAW

Roger L. Cook

roger@cookrlaw.com

415.378.2301

Nancy L. Tompkins

nancy@cookrlaw.com

415.248.6799

Two Embarcadero Ctr., Ste. 800

San Francisco, CA 94111

Attorneys for Appellant

MaxPower Semiconductor, Inc.

CERTIFICATE OF SERVICE

Case Numbers:

IPR2020-01674; IPR2020-01675; IPR2020-01676; IPR2020-01677

I certify that I served a copy of the foregoing filing on May 13, 2021 by FedEx on the below individuals at the following locations:

Drew Hirshfeld, Acting Director
United States Patent and Trademark Office,
Office of the General Counsel,
10B20, Madison Building East,
600 Dulany Street,
Alexandria, Virginia 22314

Thomas W. Krause, Solicitor
United States Patent and Trademark Office
Office of the Solicitor
600 Dulany Street,
Alexandria, Virginia 22314

Date: May 13, 2021

Signature: /s/ Nancy Tompkins

Name: Nancy Tompkins