

Following Up after Oral Argument in *Thryv, Inc. fka Dex Media Inc. v. Click-to-Call Technologies, LP*

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On June 24, 2019, the Supreme Court granted the petition for certiorari in *Thryv, Inc. fka Dex Media Inc. v. Click-to-Call Technologies, LP* on the question of whether 35 U.S.C. § 314(d) permits appeal of the Patent Trial and Appeal Board's decision to institute *inter partes* review (IPR) upon finding that 35 U.S.C. § 315(b)'s time bar did not apply. Our prior article, "[Reading the Supreme Court Tea Leaves in Dex Media Inc. v. Click-to-Call Technologies LP](#)," discussed the facts of the case, our predictions, and the potential implications of the decision. We now reexamine the implications in light of oral argument in the case and further PTAB precedent on the time bar issue.

Oral Argument

On December 9, 2019, the Supreme Court heard oral argument in the case. Oral argument is usually an unreliable predictor of the outcome of the case, and the argument in *Click-to-Call* made it particularly difficult to forecast the Court's decision because many of the Justices asked pointed questions to both sides.

Adam Charnes, attorney for Petitioner Thryv, Inc., began the argument discussing the text of § 314(d), stating that it clearly prohibits appellate review of both the substantive institution decision as well as the agency's application of prerequisites to review located elsewhere in the chapter, including § 315(b). Justices Kavanaugh and Gorsuch were the first Justices to question Mr. Charnes, focusing on the reviewability of any "shenanigans" by the PTO, such as a situation where the PTO has a political mission to "kill patents" and institutes review in cases that are clearly time-barred. Mr. Charnes argued that there should be no review under § 314(b), but that mandamus relief would be available in egregious cases. Justice Gorsuch pushed back with the presumption of judicial review.

Justice Ginsburg then turned to a point that many of the Justices were grappling with – language in *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348 (2018), that limited the Court's earlier decision in *Cuozzo Speed Technologies, LLC v. Lee*, 136 S. Ct. 2131 (2016), to finding "that § 314(d) precludes judicial review *only* of the Director's 'initial determination' under § 314(a) that 'there is a 'reasonable likelihood' that the claims are unpatentable on the grounds asserted.'" SAS 138 S. Ct. at 1359 (citing *Cuozzo*, 136 S. Ct. at 2140) (emphasis added). Mr. Charnes toed the line arguing that

the statement was not complete, but Jonathan Ellis, attorney for the United States (which took the position that § 314(d) completely prohibits review of an institution decision, including on the time bar question) characterized the statement as wrong, noting that *Cuozzo* concluded more than just determinations under § 314(a) are shielded from appellate review by § 314(d). In response to questions from Justice Gorsuch regarding review of executive action, Mr. Ellis argued that there are other avenues for challenging the validity of a patent other than an IPR, such as through the district court, *ex parte* reexamination, or a petition by another entity that is not time-barred.

Daniel Geyser, attorney for Click-to-Call, also faced myriad questions regarding his position that § 314(d) only prohibits appellate review of the substantive findings associated with an initial determination under § 314, and not of the time bar determination under § 315(b). When asked by Chief Justice Roberts and Justice Kagan about the availability of other avenues to challenge the validity of a patent, Mr. Geyser noted both that the prospect of a future party who can petition for an IPR is uncertain, and that there are meaningful differences in procedure in IPRs and *ex parte* reexamination. In response, Chief Justice Roberts and Justice Gorsuch implied that those procedural distinctions may not be significant if the ultimate determination is the same. Justices Ginsburg, Breyer, and Kagan raised concerns about a situation, such as this case, where the PTO has found that the patent is invalid but that result is being nullified on a technicality. Mr. Geyser also defended the statement in *SAS* limiting *Cuozzo*. Justice Sotomayor noted that under *Click-to-Call*'s position, there would be no judicial review of the legal question regarding the time bar if the PTO fails to institute on that basis because there is no final written decision.

Implications of the Ruling

The landscape for assessing implications of the ruling has shifted a bit since our earlier article. In August 2019, the PTAB's Precedential Opinion Panel ("POP") in *GoPro, Inc. v. 360Heros, Inc.*, IPR2018-01754, Paper No. 38 (Aug. 23, 2019), adopted the Federal Circuit's holding in *Click-to-Call* and found, "The one-year time period is triggered regardless of whether the serving party lacked standing to sue or the pleading was otherwise deficient." Thus, the PTAB's view on the one-year time bar is now consistent with that of the Federal Circuit. It remains critical for PTAB practitioners to perform a due diligence review of all "real parties-in-interest" before filing a petition in order to avoid any time bar traps.

It is also still important for PTAB practitioners to continue to monitor the Supreme Court's decision carefully. If the Supreme Court determines that § 315(b) determinations are appealable, then it is likely only a matter of time before the Supreme Court addresses the follow-on question regarding when the clock starts running on the time bar. Further, resolution of the scope of § 314(d) may also affect the appealability of the PTAB's rulings on other procedural institution issues, such as compliance with the requirements of § 312.

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