

Docket No. _____

In the
United States Court of Appeals
for the
Federal Circuit

IN RE MAXPOWER SEMICONDUCTOR, INC.,
Petitioner.

*On Petition for a Writ of Mandamus to the United States Patent and Trademark Office,
Patent Trial and Appeal Board Inter Partes Review Nos. IPR2020-01674, IPR2020-01675,
IPR2020-01676 and IPR2020-01677 • Honorable Garth D. Baer, Honorable Aaron W. Moore
and Honorable Michael T. Cygan, Administrative Patent Judges*

PETITION FOR WRIT OF MANDAMUS

ROGER L. COOK
NANCY L. TOMPKINS
ROGER COOK LAW
Two Embarcadero Center, Suite 800
San Francisco, California 94111
(415) 378-2301 Telephone
roger@cookrlaw.com
nancy@cookrlaw.com

*Attorneys for Petitioner,
MaxPower Semiconductor, Inc.*



FORM 9. Certificate of Interest

Form 9 (p. 1)
July 2020

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

CERTIFICATE OF INTEREST

Case Number _____

Short Case Caption IN RE MAXPOWER SEMICONDUCTOR, INC.

Filing Party/Entity MAXPOWER SEMICONDUCTOR, INC. (Petitioner)

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Form 9 (p. 2)
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1. Represented Entities. Fed. Cir. R. 47.4(a)(1).	2. Real Party in Interest. Fed. Cir. R. 47.4(a)(2).	3. Parent Corporations and Stockholders. Fed. Cir. R. 47.4(a)(3).
Provide the full names of all entities represented by undersigned counsel in this case.	Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities. <input checked="" type="checkbox"/> None/Not Applicable	Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities. <input checked="" type="checkbox"/> None/Not Applicable
MaxPower Semiconductor, Inc.		

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FORM 9. Certificate of Interest

Form 9 (p. 3)
July 2020

4. Legal Representatives. List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

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5. Related Cases. Provide the case titles and numbers of any case known to be pending in this court or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. Do not include the originating case number(s) for this case. Fed. Cir. R. 47.4(a)(5). See also Fed. Cir. R. 47.5(b).

☐ None/Not Applicable ☒ Additional pages attached

ROHM Semiconductor USA, LLC v. MaxPower Semiconductor, Inc.	Patent Trial & Appeal Board, United States Patent and Trademark Office	IPR2020-01674
ROHM Semiconductor USA, LLC v. MaxPower Semiconductor, Inc.	Patent Trial & Appeal Board, United States Patent and Trademark Office	IPR2020-01675
ROHM Semiconductor USA, LLC v. MaxPower Semiconductor, Inc.	Patent Trial & Appeal Board, United States Patent and Trademark Office	IPR2020-01676

6. Organizational Victims and Bankruptcy Cases. Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

☒ None/Not Applicable ☐ Additional pages attached

ATTACHMENT A
(Additional Page in Response to Item 5. Related Cases)

ROHM Semiconductor USA, LLC v. MaxPower Semiconductor, Inc.	Patent Trial & Appeal Board, United States Patent and Trademark Office	IPR2020-01677
ROHM Semiconductor USA, LLC v. MaxPower Semiconductor, Inc.	Patent Trial & Appeal Board, United States Patent and Trademark Office	IPR2021-1709

TABLE OF CONTENTS

TABLE OF AUTHORITIES	ii
STATEMENT OF RELATED CASES	v
I. INTRODUCTION	1
II. ISSUES PRESENTED	7
III. SUMMARY OF ARGUMENT	8
IV. FACTS	10
V. ARGUMENT	16
A. MaxPower’s Legal Right to Relief is Clear and Indisputable	16
1. The Board Should Have Followed <i>Schein</i>	16
2. The Board Abused Its Discretion By Ignoring <i>Epic Systems</i>	17
3. Section 294 Provides No “Superior Sovereign” Exemption Permitting the United States to Initiate IPRs	21
4. The Parties’ Agreement “Clearly and Unmistakably” Delegates the Question of Arbitrability to the Arbitrator	23
5. ROHM USA Failed to Show That the TLA is Not an Agreement Contemplated by Section 294. Moreover, This is a Question for the Arbitrator	27
B. MaxPower Lacks Adequate Alternative Means to Obtain the Relief Sought	28
C. Issuance of the Writ is Appropriate Under the Circumstances	29
CERTIFICATE OF SERVICE	
CERTIFICATE OF COMPLIANCE	

TABLE OF AUTHORITIES

CASES

<i>Allentown Mack Sales & Service, Inc. v. NLRB</i> , 522 U.S. 35 (1998).....	17
<i>Applied Med. Distrib. Corp. v. Surgical Co.</i> , 587 F.3d 909 (9th Cir. 2009)	22
<i>AT&T Technologies, Inc. v. Communications Workers</i> , 475 U.S. 643 (1985).....	17, 25
<i>Cohen v. Beneficial Indus. Loan Corp.</i> , 337 U.S. 541 (1949).....	29
<i>CompuCredit Corp. v. Greenwood</i> , 565 U.S. 95 (2012).....	20
<i>Cuozzo Speed Technologies, LLC v. Lee</i> , 136 S.Ct. 2131 (2016).....	9, 28, 31, 32
<i>Dream Theater, Inc. v. Dream Theater</i> , 124 Cal.App.4th 547 (2004)	26
<i>Engalla v. Permanente Med. Grp., Inc.</i> , 15 Cal. 4th 951 (1997).....	25
<i>Epic Systems Corp. v. Lewis</i> , 138 S.Ct. 1612 (2018).....	<i>passim</i>
<i>General Protecht Group, Inc. v. Leviton Mfg. Co., Inc.</i> , 651 F.3d 1355 (Fed. Cir. 2011)	30
<i>GTNX, Inc. v. INTTRA, Inc.</i> , 789 F.3d 1309 (Fed. Cir. 2015)	9
<i>Henry Schein, Inc. v. Archer and White Sales, Inc.</i> , 139 S. Ct. 524 (2019).....	1, 3, 5, 7, 8, 14, 17, 26
<i>In re Calmar, Inc.</i> , 854 F.2d 461 (Fed. Cir. 1988)	16
<i>In re Princo Corp.</i> , 478 F.3d 1345 (Fed. Cir. 2007)	28, 29

<i>In re Regents of Univ of Cal.,</i> 101 F.3d 1386 (Fed. Cir. 1996)	29
<i>Lear v. Adkins,</i> 395 U.S. 653 (1969).....	23
<i>Michigan v. EPA,</i> 576 U.S. 743 (2015).....	17
<i>Mylan Labs. v. Janssen Pharmaceutica, N.V.,</i> 989 F.3d 1375 (Fed. Cir. 2021)	9, 16
<i>Oil States Energy Servs. LLC v. Greene’s Energy Grp. LLC,</i> 138 S. Ct. 1365, 1374 (2018).....	5, 29
<i>Oracle America, Inc. v. Myriad Group A.G.,</i> 724 F.3d 1069 (9th Cir. 2013)	25, 26
<i>Qualcomm, Inc. v. Nokia Corp.,</i> 466 F.3d 1366 (Fed. Cir. 2006)	26
<i>Regents of the Univ. of Minn. v. LSI Corp.,</i> 926 F.3d 1327 (Fed. Cir. 2019)	5, 9, 22, 29
<i>Sanofi-Aventis Deutschland GmbH v. Genentech, Inc.,</i> 716 F.3d 586 (Fed. Cir. 2013)	22, 30, 31
<i>Santa Clara Pueblo v. Martinez,</i> 436 U.S. 49 (1978).....	20
<i>Shearson/American Express Inc. v. McMahon,</i> 482 U.S. 220 (1987).....	20
<i>Texas Instruments, Inc. v. Tessera, Inc.,</i> 231 F.3d 1325 (Fed. Cir. 2000)	30
<i>Texas v. United States,</i> 523 U.S. 296 (1998).....	27
<i>Trivascular, Inc. v. Samuels,</i> 812 F.3d 1056 (Fed. Cir. 2016)	28
<i>Volt Info. Scis. v. Bd. Of Trustees of Leland Stanford Jr. University,</i> 489 U.S. 468 (1989).....	22

STATUTES

9 U.S.C. §2	19
28 U.S.C. §1295	9
28 U.S.C. §1651	9
35 U.S.C. §294	<i>passim</i>
35 U.S.C. §311	2, 4, 7, 8, 14, 18, 19, 30
35 U.S.C. §314	9, 28
35 U.S.C. §316	18
Cal. Civ. Proc. Code §1280	25
Cal. Civ. Proc. Code §1281.2	24
Cal. Civ. Proc. Code §1284.2	25
Cal. Civ. Proc. Code §1297.13	24
Cal. Civ. Proc. Code §1297.15	24
Cal. Civ. Proc. Code §1297.16	24
Cal. Civ. Proc. Code §1297.17	25
Cal. Civ. Proc. Code §1297.161	25, 26

OTHER AUTHORITIES

Statement on Signing the Patent and Trademark Office Appropriations Bill, II Pub. Papers 1087 (Aug. 28, 1982)	18
UNCITRAL rule, Article 23, paragraph 1	25

STATEMENT OF RELATED CASES

This mandamus petition challenges decisions instituting *inter partes* review (IPR) of four United States Patents owned by Petitioner, MaxPower Semiconductor, Inc. (MaxPower) — (IPR 2020-01674 (U.S.P. 7,843,004B2); IPR 2020-01675 (U.S.P. 8,076,719B); IPR 2020-01676 (U.S.P. 8,466,025B2); and IPR 2020-01677 (U.S.P. 8,659,076B2)) — issued by the Patent Trial and Appeal Board (PTAB) of the United States Patent and Trademark Office (USPTO) on April 15, 2021.

MaxPower filed a timely notice of appeal from each of the same four institution decisions on May 13, 2021, citing both 28 U.S.C. §1295(a)(4) and the All Writs Act, 28 U.S.C. §1651, as alternative bases for jurisdiction. These interlocutory appeals are as yet undocketed.

MaxPower's present mandamus petition (or interlocutory appeals) will directly affect ROHM Semiconductor USA, LLC's pending appeal no. 2021-1709, challenging an order of the United States District Court for the Northern District of California compelling ROHM USA to arbitration and dismissing its complaint for a declaratory judgment of noninfringement.

I. INTRODUCTION

Petitioner, MaxPower Semiconductor, Inc. (MaxPower) seeks a writ of mandamus¹ directing the Patent Trial and Appeal Board (PTAB) to vacate orders instituting *inter partes* review (IPR) of four patents owned by MaxPower.² The Board abused its discretion by assuming jurisdiction over a patentability dispute between parties to an international technology license agreement (TLA) who had committed to arbitrate all disputes according to the California Arbitration Act (the CAA). When international agreements call for arbitration, the CAA allocates jurisdiction over the question of arbitrability³ to the arbitral tribunal. And, 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).

The Board further abused its discretion by instituting IPRs at the instance of a party to the TLA, MaxPower’s licensee ROHM USA, LLC (ROHM USA). The Supreme Court has unequivocally declared that a congressional mandate to enforce arbitration agreements (such as 35 U.S.C. §294, enacted in 1982 to further the

¹ MaxPower has also filed four notices of appeal in the event the Court chooses to exercise interlocutory appellate jurisdiction to review the PTAB’s orders.

² The orders pertain to IPR 2020-01674 (U.S.P. 7,843,004B2); IPR 2020-01675 (U.S.P. 8,076,719B); IPR 2020-01676 (U.S.P. 8,466,025B2); and IPR 2020-01677 (U.S.P. 8,659,076B2).

³ Questions of arbitrability (*i.e.*, the arbitrator’s jurisdiction) include “whether the parties have agreed to arbitrate or whether their agreement covers a particular [dispute].” *Schein, supra*, 139 S. Ct. at 529.

policies of the Federal Arbitration Act in patent disputes) is not overridden by subsequent legislation (such as the IPR statute, 35 U.S.C. §§311 *et seq.*) absent a “clearly expressed congressional intention that such a result should follow.” *Epic Systems Corp. v. Lewis*, 138 S.Ct. 1612, 1624 (2018).

This case presents questions of first impression regarding the relationship between 35 U.S.C. §294 and §§311 *et seq.* MaxPower spent nearly four years developing industry-best RFP/RSFP power transistor technology meeting exacting performance goals proposed by ROHM Co. Ltd. (ROHM Japan), and licensed that technology to ROHM Japan and its subsidiaries⁴ in 2007. In return, ROHM agreed to pay a running royalty on sales of any products it might make using the developed technology.

The parties’ development agreement (DSA) and technology license agreement (TLA) broadly require that all disputes arising out of or in relation to the agreements be settled by arbitration in Santa Clara County, California. If not for this agreement, MaxPower would not have committed to developing this technology for license on extended payment terms to ROHM, a much bigger foreign company with relatively unlimited resources for litigation.

⁴ ROHM Japan and its subsidiaries, including IPR petitioner ROHM USA, are sometimes referenced collectively herein as “ROHM.”

ROHM has paid royalties on its sales of silicon RFP/RSFP transistors since 2012. In 2019, however, a dispute arose as to whether the TLA covers ROHM's silicon carbide RFP/RSFP products. In September 2020, after many months of fruitless discussions, MaxPower notified ROHM Japan that it would initiate arbitration in 30 days. Two weeks later, in violation of the parties' agreement to arbitrate, ROHM Japan's wholly-owned subsidiary, ROHM USA, filed IPR petitions challenging four MaxPower patents licensed under the TLA (the patents at issue) in the Patent Trial and Appeal Board and a complaint for a declaratory judgment of noninfringement of the same patents in the Northern District of California (NDCA).

The district court (Judge Chaabria) granted MaxPower's petition to compel ROHM USA to arbitration, holding that ROHM USA is a party to the TLA, and that the parties had "clearly and unmistakably delegate[d] the threshold question of arbitrability to the arbitrator." Recognizing he had "no power" in this circumstance "to decide the arbitrability issue" (*Schein, Inc.*, 139 S. Ct. at 529) — let alone to assume jurisdiction over ROHM USA's noninfringement claims — Judge Chaabria compelled ROHM USA to arbitration, and dismissed its declaratory-judgment suit without prejudice. Appx001.⁵

⁵ The Appendix accompanying this petition includes all four institution orders — which are identical in relevant part. The parties' relevant briefs (MaxPower's Preliminary Opposition, ROHM USA's Authorized Reply, and MaxPower's

MaxPower urged the PTAB to follow suit and forego instituting review because, just like the infringement questions ROHM USA had presented to the district court, the invalidity questions ROHM USA had presented to the Board could not be addressed until an arbitrator had answered the threshold arbitrability question. Instead — while acknowledging it was not itself competent to construe the TLA, and purporting to accept the district court’s construction of that agreement, at least for the sake of argument — the Board concluded that “[there is no] statute, rule, or policy that would preclude [it] from acting on” ROHM USA’s petitions, and it instituted review on each one. Appx013.⁶

MaxPower also argued that 35 USC §294 requires arbitration agreements to be enforced, and that the later-enacted IPR statute, 35 U.S.C. §§311 *et seq.*, makes no exception to this rule. MaxPower cited *Epic Systems Corp. v. Lewis*, 138 S.Ct. 1612, which explains 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

Authorized Surreply) are also identical in relevant part. To avoid flooding the Court with redundant papers, MaxPower has included in the Appendix only one copy (pertaining to IPR2020-01674) of each brief. Upon the Court’s request, MaxPower will file a Supplemental Appendix presenting the entire record.

⁶ For ease of reference, Appendix citations to the institution decisions in this petition all pertain to the institution decision in IPR2020-01674, Appx003-037.

294],” *id.*, 138 S.Ct. at 1627. Yet, the Board dismissed this argument, granting ROHM USA’s IPR petitions without even acknowledging, let alone distinguishing, *Epic Systems*.

The PTAB explained its surprising decision, not very clearly, by suggesting that the Supreme Court’s pronouncements — including those meant to guide the interpretation of federal law — govern “civil actions,” but have no bearing on *inter partes* review. Appx014. The Board declared that Section 294 is like state sovereign immunity, a “bar[] to civil litigation that d[oes] not bar...USPTO proceedings,” because the PTAB is an agency of the United States. Appx015, fn 4. ROHM USA had never made these arguments, but the Board found support for its conclusions in one case holding that the PTAB has the authority to cancel patent claims (*Oil States Energy Servs. LLC v. Greene’s Energy Grp. LLC*, 138 S. Ct. 1365, 1374 (2018)) and another suggesting that *inter partes* review is an *in rem* proceeding between the United States and the patent owner, and thus “distinct from ordinary litigation” (*Regents of the Univ. of Minn. v. LSI Corp.*, 926 F.3d 1327, 1339 (Fed. Cir. 2019)). Appx014-015.

But these holdings shed no light on this case. *Schein* and *Epic Systems* follow decades of judicial decisions reinforcing the adamant federal policy favoring private arbitration agreements. This policy is embodied in Section 294, endorsing the resolution of disputed patent issues by arbitration. There is no basis for concluding

that the reach of this policy is limited to private civil litigation. In fact, Section 294 itself applies not just to lawsuits, but to all “dispute[s] relating to patent validity,” of which IPR is clearly a species. 35 U.S.C. §294. There is, further, no “superior sovereign” exemption from Section 294 that would allow the Board to institute IPRs in violation of an arbitration agreement.

Yet the Board has presumed it may do as it will until it is otherwise directed by a “statute, rule, or policy” that, by the Board’s reckoning, does not exist so far. Appx013. If the PTAB is correct, then the risk of costly, expert-intensive IPR proceedings, backed by the Board’s own patent-canceling powers, lurks as a “wild card” in technology licensing disputes, playable at the licensee’s option, even for a patent owner like MaxPower, which developed the licensed technology expressly for ROHM and insisted upon an arbitration clause in an agreement negotiated years before passage of the IPR statute specifically to level the playing field in “any” dispute that might arise with its outsized licensee.

This petition raises the question whether the PTAB, in fact, operates outside the legal constraints that bind the Article III courts. MaxPower, a small domestic technology company, agreed to accept a running royalty payment in return for years spent developing leading-edge technology for ROHM, a major foreign semiconductor company. MaxPower is now forced to spend hundreds of thousands of dollars to defend nearly all of its RFP/RSFP patent claims as the “price of poker”

for having sought to arbitrate whether ROHM is in breach of the parties' longstanding technology license agreement — a royalty agreement expressly embracing ROHM's use of the technology "whether or not patentable." The Board has overreached, threatening irreparable harm to MaxPower and disrupting the predictability this Court has recognized is necessary not just to promote progress in science, but also to foster international trade relations. MaxPower asks the Court to grant all appropriate relief.

II. ISSUES PRESENTED

1. When parties to a valid arbitration agreement 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"? *Schein*, 139 S. Ct. at 529.

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, even though the Supreme Court has explained that "Congress will specifically address preexisting law when it wishes to suspend its normal operations in a later statute"? *Epic Systems*, 138 S.Ct. at 1624.

III. SUMMARY OF ARGUMENT

MaxPower and ROHM USA are parties to an international agreement, the TLA, that requires all related questions to be decided in binding arbitration in Santa Clara County, California. The America Invents Act (AIA) declares this agreement to be “valid, irrevocable, and enforceable, except on grounds that exist at law or in equity for revocation of a contract.” 35 U.S.C., §294 (emphasis added). These grounds do not include the filing of a petition for *inter partes* review, and nothing in the IPR provisions of the AIA, 35 U.S.C. §§311 *et seq.*, or anywhere else, suggests that *inter partes* review should supersede the parties’ agreement to arbitrate.

Yet, the PTAB granted ROHM USA’s petitions for IPR challenging four MaxPower patents licensed under the TLA. The Board thus not only refused to enforce (or even interpret) the TLA as required by Section 294; by assuming jurisdiction to hold a patent trial, it ignored a federal judge’s conclusion that the TLA requires the threshold question of jurisdiction (*i.e.*, arbitrability) to be arbitrated, and the Supreme Court’s admonition that, “[i]n those circumstances, a court possesses no power to decide the arbitrability issue.” *Schein*, 139 S. Ct. at 529. The Board then further abused its discretion by interpreting the IPR statute as overriding Section 294, ignoring the Supreme Court’s consistent message that Congress does not repeal statutes by implication. *Epic Systems*, 138 S.Ct. at 1624.

The Board mistakenly likened 35 U.S.C. §294 to sovereign immunity, which this Court discussed in *Regents of the University of Minnesota v. LSI Corp.*, 926 F.3d 1327 (Fed. Cir. 2019), and concluded, based on this comparison, that Section 294 poses no bar to IPR. But the holding in *Minnesota Regents* turns on a singular feature of sovereign immunity: it “does not apply to suits brought by the United States, including agency proceedings commenced by the United States.” *Id.*, 926 F.3d at 1337. Section 294 contains no comparable exemption permitting the United States to initiate IPRs. Moreover, the United States is firmly on record as supporting the enforcement of private agreements to arbitrate. Even if Section 294 allowed the Board to initiate these IPRs, it should not have done so because it is the resounding policy of the United States to enforce arbitration agreements, not to abet foreign corporations in breaching them.

If 35 U.S.C. §314(d) bars MaxPower’s interlocutory appeal,⁷ then mandamus review is appropriate because MaxPower has a clear and indisputable legal right to relief and no other adequate method for obtaining it. MaxPower will suffer

⁷ As this Court has noted, the Supreme Court left open the possibility that some institution decisions could be appealable when it decided *Cuozzo Speed Technologies, LLC v. Lee*, 136 S.Ct. 2131 (2016). See *Mylan Labs. v. Janssen Pharmaceutica, N.V.*, 989 F.3d 1375, 1382, fn.5 (Fed. Cir. 2021). In addition to 28 U.S.C. §1295(a)(4), MaxPower cited the All Writs Act, 28 U.S.C. §1651, in its notices of appeal. If immediate interlocutory review is unavailable under 35 U.S.C. §314(d), then MaxPower asks the Court to consider this petition for writ of mandamus. See *Mylan Labs.*, 989 F.3d 1375, 1377, fn.1; *GTNX, Inc. v. INTTRA, Inc.*, 789 F.3d 1309, 1312 (Fed. Cir. 2015). See fn. 18, *infra*, for further discussion.

irreparable harm — the very harm it bargained to avoid — if it is forced to defend its patents before the PTAB while: trying to arbitrate its contract claims in California; fighting ROHM USA’s pending appeal from the district court’s order compelling arbitration; and prosecuting its own mandamus petition (or appeal) in this Court. MaxPower will suffer further harm if the Board proceeds once and for all to cancel its challenged patent claims. If the validity of those claims were successfully contested in the arbitration, any award to that effect “would have no force or effect on any other person.” 35 U.S.C. §294(c).

MaxPower respectfully asks the Court to review its claims and stay or terminate the IPR proceedings without prejudice to later institution if an arbitrator decides that IPR proceedings are appropriate. Finally, MaxPower requests an award of all fees and costs reasonably incurred to bring this petition in accordance with §13.6 of the TLA. Appx410 (“In any...proceeding to enforce rights under this Agreement, the prevailing party shall be entitled to recover its costs and reasonable attorneys’ fees.”).

IV. FACTS

MaxPower is a small, private “fabless” semiconductor company that develops and designs innovative power transistors for sale and for licensing. Appx353, ¶3. The company was founded in 2007 by Mohamed Darwish, a preeminent power semiconductor technology engineer. Appx353, ¶4. Dr. Darwish holds a PhD in

Electrical Engineering, and is a named inventor on more than 100 issued and pending patents, including the four patents at issue. Appx353-354, ¶¶4, 5.

In 2007, ROHM Japan — a multi-billion-dollar, publicly-traded semiconductor company headquartered in Kyoto — agreed that, if MaxPower could develop new power MOSFET technology meeting exacting performance goals proposed by ROHM, then ROHM would license that technology, “whether or not patentable,” from MaxPower for payment of a running royalty. Appx355-356, ¶8.

Negotiations yielded a Development and Stock Purchase Agreement (DSA)⁸ and a Technology Licensing Agreement (TLA), both binding ROHM Japan and its subsidiaries. Appx356, ¶9. The TLA commits ROHM to pay per-unit royalties on products using the “Developed Technology” and “Modifications” thereof, both defined terms. For payment of the same royalty, the TLA allows ROHM to practice MaxPower patents, including the patents at issue, when ROHM makes or sells devices incorporating the licensed technology. Appx388, ¶2.

Recognizing that, if a dispute arose, a tiny company like MaxPower would be at a disadvantage against a corporate behemoth like ROHM, MaxPower insisted on the inclusion of an arbitration clause in both agreements. Appx359-360, ¶19, Appx372, ¶35. Both the DSA and TLA, therefore, bind the parties, in the broadest possible terms, to arbitrate disputes that are in any way related to the agreements.

⁸ The DSA is not at issue in this dispute.

The arbitration clause of the TLA, Paragraph 13.6, as amended in 2011, reads, in relevant part:

Arbitration: Any dispute, controversy, or claim arising out of or in relation to this Agreement or at law, or the breach, termination or invalidity thereof, that cannot be settled amicably by agreement of the parties hereto, shall be finally settled by arbitration in Santa Clara County, California, USA in accordance with the provisions of the California Code of Civil Procedure by one or more arbitrators appointed in accordance with said Code..... In any arbitration action or proceeding to enforce rights under this Agreement, the prevailing party shall be entitled to recover its costs and reasonable attorneys' fees. The award rendered shall be final and binding upon both parties.

Appx359-360, ¶19, Appx410.

MaxPower worked tirelessly over several years, ultimately succeeding in developing and disclosing exemplars of both Recessed Field Plate (RFP) and Recessed Shielded Field Plate (RSFP) power MOSFETs. Appx360-361, ¶20. ROHM Japan and its subsidiaries began selling RFP/RSFP MOSFETs in 2012, paying royalties on purportedly all of their RFP/RSFP MOSFET products, which, until 2015, were made on silicon semiconductor wafers. Appx362, ¶21.

In 2015, however, ROHM introduced a further line of RFP/RSFP power MOSFETs made on silicon carbide wafers. Rather than pay royalties on this line, ROHM concealed its incorporation of the RFP/RSFP MOSFET technology by illustrating the “new” product in promotional and technical publications with false drawings suggesting it used other technology ostensibly covered by ROHM’s own patents. Appx362, ¶22.

In December 2018, MaxPower discovered wholly by chance that ROHM's silicon carbide products used the licensed RFP/RSFP technology. Appx362-366, ¶¶22-26. When MaxPower confronted ROHM with its breach of the TLA, in January 2019, ROHM disputed the allegation. Appx366-367, ¶¶26-27. After eighteen months of confidential discussions failed to settle the matter, on September 10, 2020, MaxPower sent ROHM 30-day notice that it was terminating talks so it could begin arbitration on October 10, 2020. Appx367, ¶¶28, 29.

On September 23, 2020, ROHM USA, an entity with no prior involvement in the dispute, sued MaxPower in the Northern District of California for a judgment declaring it does not infringe the patents at issue.⁹ Appx368, ¶31. On the same day, ROHM USA filed petitions for IPR, challenging the validity of the same patents, in the Patent Trial and Appeal Board.¹⁰ Appx367-368, ¶30. ROHM Japan has used its subsidiary's filings to stall arbitration of MaxPower's contract claims,¹¹ and convert

⁹ MaxPower has consistently maintained that ROHM's silicon carbide RFP/RSFP products do not infringe MaxPower's patents because they are licensed. Appx368, ¶31. They would infringe only if, as ROHM USA argues, they are not licensed, which MaxPower firmly disputes. Appx358-359, ¶18.

¹⁰ The sheer volume of paper ROHM USA filed in the PTAB — hundreds of pages of new argument and purported evidence — mere weeks after the parties' settlement discussions ended confirmed MaxPower's impression that the discussions had been a sham. ROHM USA's IPR petitions had obviously been in the works for many months.

¹¹ As of the filing date of this petition, more than three months since the district court compelled ROHM USA to arbitration, ROHM still has not agreed to appointment of

what should have been a straightforward matter for arbitration in Santa Clara County into a costly multi-front war of attrition in which ROHM has an undeserved advantage over small MaxPower.

MaxPower served its arbitration complaint against both ROHM entities (who are represented by the same counsel) and moved the district court to compel ROHM USA to arbitration. Appx368, ¶32. After a hearing, on February 4, 2021, the district court granted MaxPower's motion, holding that ROHM USA is bound by the TLA and that the parties had delegated the threshold question of arbitrability to the arbitrator. Recognizing that, in this circumstance, "a court possesses no power to decide the arbitrability issue," *Schein*, 139 S. Ct. at 529, the district court dismissed ROHM USA's lawsuit without prejudice on February 4, 2021. Appx001. ROHM USA appealed on February 23.

MaxPower also opposed ROHM USA's IPR petitions, pointing out that the district court's conclusion that the TLA assigns arbitrability to the arbitrator applies to the issues of validity ROHM USA had presented to the PTAB the same as it applied to the issues of infringement ROHM USA had presented to the district court. MaxPower also argued that 35 USC §294 requires arbitration agreements to be enforced, and that the later-enacted IPR statute, 35 U.S.C. §§311 *et seq.*, makes no

an arbitrator. MaxPower's motion for the Santa Clara Superior Court to appoint an arbitrator is scheduled for hearing on June 1, 2021.

exception to this rule. MaxPower cited *Epic Systems*, 138 S.Ct. 1612, the Supreme Court’s most recent adamant command to enforce arbitration contracts, which explains 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.

The PTAB instituted all four IPRs on April 15, 2021. Appx003-101. Declaring it had no jurisdiction “to construe or enforce [the TLA’s] arbitration clause[],” Appx017, the Board nonetheless ignored the district court’s construction of that clause. Instead, by instituting the IPRs in contravention of the arbitration agreement, the Board implicitly claimed “the power to decide the arbitrability issue” — without explaining why *Schein* would bind the district court, but not the PTAB.

Then, faulting MaxPower for not citing “any Board decisions refusing to institute in view of Section 294,” the PTAB concluded that Section 294 does not apply to IPRs. Appx014. The Board suggested this was so because the IPR statute appears in an “entirely different Chapter” of the United States Code from that in which Section 294 appears and because the “IPR procedure is ... distinct from ordinary civil litigation.” Appx014-015. In the face of *Epic Systems*, and without

even acknowledging that case, the Board concluded, in effect, that the IPR statute has preempted Section 294. MaxPower timely appealed on May 12, 2021.

V. ARGUMENT

The Board’s errors warrant immediate intervention. The writ of mandamus may issue “to correct a clear abuse of discretion or usurpation of judicial power by a trial court.” *In re Calmar, Inc.* 854 F. may issue. [Citation.]” *Mylan Labs.*, 989 F.3d at 1381-1382. “The petitioner must: (1) show that is 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.” *Id.*

A. MaxPower’s Legal Right to Relief is Clear and Indisputable.

1. The Board Should Have Followed *Schein*.

The Board declined to interpret the TLA, explaining that was “not [its] place.” Appx017. Instead, for the sake of argument, it purported to accept the district court’s determination that the contract “clearly and unmistakably” delegated arbitrability to the arbitrator — meaning that an arbitrator must decide which parties and issues are subject to arbitration — and even acknowledged that in this circumstance, “the Supreme Court has held, ‘a court possesses no power to decide the arbitrability issue.’” Appx013. (quoting *Schein*, 139 S.Ct. at 529.) But then the Board implicitly

decided the arbitrability issue by assuming jurisdiction to consider the merits of ROHM USA's IPR petitions, surely exceeding the scope of its lawful authority.

These contradictory actions also violated all procedural logic. Federal administrative agencies must engage in "reasoned decision making." *Allentown Mack Sales & Service, Inc. v. NLRB*, 522 U.S. 359, 374. "Not only must an agency's decreed result be within the scope of its lawful authority, but the process by which it reaches that result must be logical and rational." *Michigan v. EPA*, 576 U.S. 743, 750 (2015). As Judge Chaabria implicitly recognized, matters like ROHM USA's IPR petitions are not ripe for determination until after an arbitrator's decision on "the arbitrability issue." The Board was wrong to assume jurisdiction over the underlying invalidity questions based on its own speculations about what an arbitrator might decide. (Appx016.) *AT&T Technologies, Inc. v. Communications Workers*, 475 U.S. 643, 649-650 (1985) (court may not "rule on the potential merits of the underlying" claim assigned by contract to an arbitrator, "even if it appears to the court to be frivolous.")

2. The Board Abused Its Discretion By Ignoring *Epic Systems*.

The PTAB concluded there was "no statute, rule, or policy" to "preclude" it from instituting IPRs in this case. Appx013. But the Board overlooked the patent statute itself, to which the IPR provisions are but a brief and recent (2011) amendment. The patent statute provides an explicit defense to institution in Section

294, a much older (1982) amendment, which, in this case, unconditionally commands enforcement of agreements to arbitrate patent invalidity and infringement disputes. See 35 U.S.C. § 294(a) (“A contract involving a patent or any right under a patent may contain a provision requiring arbitration of any dispute relating to patent validity or infringement arising under the contract.... Any such provision...shall be **valid, irrevocable, and enforceable**, except for any grounds that exist at law or in equity for revocation of a contract.”) (emphasis added)).

Sections 294 and 316 do not conflict. In fact, nothing in the IPR statute appears intended to undermine Section 294. Rather, the 2011 amendments to the patent statute present *inter partes* review in the same way that section 294 presents arbitration, as a more efficient alternative to litigation.¹² IPR is nowhere advocated as a more efficient alternative to arbitration. Taken together, Sections 294 and 311 *et seq.* are harmonized to mean that parties may initiate involuntary IPRs against parties other than those with whom they have agreed voluntarily to arbitrate such disputes. The Board’s own standing order, in fact, “strongly encourages parties who

¹² As one justification for enacting Section 294, President Ronald Reagan cited the “inordinately high cost of patent litigation.” Statement on Signing the Patent and Trademark Office Appropriations Bill, II Pub. Papers 1087 (Aug. 28, 1982). Congress passed the IPR statute in 2011 to address the same concern — the “unnecessary and counterproductive...costs” of patent litigation. See PTAB November 2019 Consolidated Trial Practice Guide at 56 (quoting the House and Senate reports underlying passage of the 2011 statute). Appx163.

are considering settlement to consider alternative dispute resolution [including arbitration] as a means of settling the issues that may be raised in an AIA trial proceeding.” Appx241-242.

The Supreme Court has explained, “When confronted with two Acts of Congress allegedly touching on the same topic, this Court ... must ... strive to give effect to both. A party seeking to suggest that two statutes cannot be harmonized, and that one displaces the other bears the heavy burden of showing a clearly expressed congressional intention that such a result should follow.” *Epic Systems*, 138 S.Ct. at 1624 (internal citation omitted). Neither ROHM USA nor the Board even tried to carry this heavy burden.

The Board should not have ignored the parties’ election to settle disputes by arbitration. By doing so, it effectively misinterpreted Sections 311 *et seq.* (a later amendment to Title 35) as overriding Section 294 (an earlier amendment), a mistake the Supreme Court has repeatedly condemned. See *Epic Systems*, 138 S.Ct. at 1627 (“[T]his Court has heard ... [many] efforts to conjure conflicts between the [Federal] Arbitration Act¹³ and other federal statutes,” and “rejected every such effort to date.”).

¹³ It is from Title 9, the Federal Arbitration Act (FAA) that Congress imported wholesale into Section 294 the broad command to enforce private arbitration agreements according to their terms. *Compare* 9 U.S.C. §2 with 35 U.S.C. §294.

It does not help ROHM USA that the IPR statute makes no specific reference to arbitration because there is a “stron[g] presum[ption] that repeals by implication are disfavored and 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. Thus, “the absence of any specific statutory discussion of arbitration...is an important and telling clue that Congress has not displaced the Arbitration Act.” *Epic Systems*, 138 S.Ct. at 1627 (internal quotations and citations omitted) (citing *CompuCredit Corp. v. Greenwood*, 565 U.S. 95, 102-104 (2012) (when Congress restricts arbitration, it does so clearly and expressly); *Shearson/American Express Inc. v. McMahon*, 482 U.S. 220 (1987) (when legislative history and statutory text are silent concerning arbitration, no repeal of the AAA can be inferred) see also *Santa Clara Pueblo v. Martinez*, 436 U.S. 49, 60 (1978) (“Although Congress clearly has power to [abrogate tribal sovereign immunity], a proper respect ... for the plenary authority of Congress in this area cautions that we tread lightly in the absence of clear indications of legislative intent.”))

Because the IPR statute says nothing about private agreements to arbitrate patent-invalidity disputes, the Board should not have concluded that it overrides Section 294, or releases ROHM USA from its agreement to arbitrate this dispute. Finally, *Epic Systems* makes no exemption for statutes that appear in different

chapters of the United States Code, as the Board supposed. Appx014. If the IPR statute were intended to abrogate Section 294, Congress would have said so. *See id.*

3. Section 294 Provides No “Superior Sovereign” Exemption Permitting the United States to Initiate IPRs.

Likening Section 294 to sovereign immunity, the Board called the statute another “bar[] to civil litigation that d[oes] not bar...USPTO proceedings.” Appx015, fn. 4. But the Board’s comparison is inapt. First, Section 294 is not a bar to IPR (or any) proceedings. Nor is its reach limited to civil litigation.¹⁴ Section 294 simply requires that agreements to arbitrate patent disputes be enforced, even if their enforcement precludes IPR in a particular case. Here, the parties broadly agreed to settle “any” dispute “arising under or in relation to” the TLA by arbitration in Santa Clara County, applying California law, and California procedures — assuring that even questions of arbitrability would be decided by the arbitrator. Upon considering the “arbitrability issue” in this case, the arbitrator may yet decide the IPRs may go forward.

Second, a longstanding “superior sovereign” exemption ensures that sovereign immunity “does not apply to [bar] suits brought by the United States,

¹⁴ 35 USC §294 (a) provides, in relevant part “A contract involving a patent or any right under a patent may contain a provision requiring arbitration of **any dispute** relating to patent validity or infringement arising under the contract. ... Any such provision or agreement shall be valid, irrevocable, and enforceable,....”

including agency proceedings [like IPR] commenced by the United States.” *Regents of the Univ. of Minn.*, 926 F.3d at 1337; *see also id.*, 926 at 1340 (“these proceedings are not barred by state sovereign immunity since sovereign immunity does not bar proceedings brought by the United States.”) The Board cites no similar exemption from Section 294’s firm, neutral mandate that arbitration agreements “shall be valid, irrevocable, and enforceable” (35 U.S.C. §294) that would permit it to institute IPRs in this case.

Indeed, conceptualizing IPR as an *in rem* proceeding initiated by the United States only lends further force to MaxPower’s position, given the scope and impact of the Board’s institution decisions. Thus, even if the Board were permitted to prosecute these IPRs against MaxPower’s patents, it should not do so here in light of the staunch “federal policy favoring arbitration,” *Volt Info. Scis. v. Bd. Of Trustees of Leland Stanford Jr. University*, 489 U.S. 468, 475 (1989), and the equally “strong policy in favor of forum selection clauses,” *Sanofi-Aventis Deutschland GmbH v. Genentech, Inc.*, 716 F.3d 586, 594 (Fed. Cir. 2013). These policies ensure predictability in international trade relations and foster a domestic environment that encourages innovators to invent and license their technology. *See id.*; *Applied Med. Distrib. Corp. v. Surgical Co.*, 587 F.3d 909, 916 (9th Cir. 2009). The PTAB’s institution decision — which was triggered by and relies entirely upon the invalidity allegations of arbitration-bound ROHM USA — defeats every one of these

policies.¹⁵ In fact, the United States should be the last party to lend its heft and authority to a foreign corporation trying to avoid its own contractual commitment to arbitrate, especially when doing so will predictably discourage American innovators from inventing and licensing new technology.

In fact, it is beyond ironic that the salutary IPR statute – designed to provide a less expensive alternative to civil court litigation – in this case, has been perverted into a more expensive alternative to arbitration, harshly requiring a small technology licensor to defend against cancellation of its patents as the price of attempting to arbitrate a royalty dispute with its behemoth licensee, who agreed to pay royalties on the technology “whether or not patentable.”

4. The Parties’ Agreement “Clearly and Unmistakably” Delegates the Question of Arbitrability to the Arbitrator.

The Court is being asked to consider in the first instance the pure question of law whether the TLA “clearly and unmistakably” delegates the question of arbitrability to the arbitrator.¹⁶ Applying both federal (9th Circuit) and California law, the district court had no trouble concluding that it does. The California Code of

¹⁵ MaxPower does not suggest that ROHM is estopped from challenging MaxPower’s patents, as the licensor claimed in *Lear v. Adkins*, 395 U.S. 653 (1969). ROHM is free to challenge MaxPower’s patents *in arbitration*.

¹⁶ Although it did not contest Judge Chaabria’s reading of the TLA before the PTAB (Appx320-330), ROHM USA raises this issue in its co-pending and related appeal (no. 2021-1709) from the district court’s order granting MaxPower’s motion to compel arbitration.

Civil Procedure (CCCP), which expressly governs the parties’ agreement to arbitrate (Appx409, ¶13.6), encompasses the California Arbitration Act (CAA). In this case, according to California Code of Civil Procedure §1297.16, the arbitration agreement is decidedly “commercial” because “it arises out of a relationship of a commercial nature including ... (i) Licensing ... (l) Consulting ... (m) Engineering ... (p) The transfer of data or technology... [and] (q) Intellectual...property, including ... patents...” (CCCP §§1297.16(i), (l), (m), (p), and (q).)

Further, at least two of the parties to the arbitration agreement, MaxPower and ROHM Japan, “have... their places of business in different states”¹⁷ (CCCP §1297.13(a)); “a substantial part of the obligations of the commercial relationship [between the parties] is to be performed” in Japan (CCCP §1297.13(b)(ii); and “[t]he subject matter of the arbitration...agreement [a nonexclusive, worldwide technology license] is otherwise related to commercial interests in more than one state” (CCCP § 1297.13(d)). The CAA thus establishes that the dispute must be resolved by an international commercial arbitration. CCCP § 1297.13.

When the parties’ agreement contemplates a domestic arbitration, a court need only apply the criteria set forth in Civil Procedure Code section 1281.2 to determine by a preponderance of the evidence that “a valid arbitration agreement” exists, and

¹⁷ As explained in California Code of Civil Procedure section 1297.15, “For the purposes of Section 1297.13, the states of the United States, including the District of Columbia, shall be considered one state.”

no exception applies to defeat its enforcement. *Engalla v. Permanente Med. Grp., Inc.*, 15 Cal. 4th 951, 972 (1997). If that were the standard here, it would clearly be met. But in the case of international commercial arbitration, Civil Procedure Code sections 1280 to 1284.2, inclusive, are superseded (CCCP § 1297.17), and the Court’s task is even easier. In a proceeding like this, “[t]he arbitral tribunal may rule on its own jurisdiction, including ruling on any objections with respect to the existence or validity of the arbitration agreement” (CCCP §1297.161), so long as the parties’ agreement “clearly and unmistakably” delegates to the arbitrator the threshold question of arbitrability. *AT&T Techs.*, 475 U.S. at 649.

By expressly incorporating the California Code of Civil Procedure into their agreement, the parties made this “clear and unmistakable” delegation of authority to the arbitrator. In fact, the language of the incorporated CCCP rule on international arbitration, CCCP Section 1297.161, is almost word-for-word identical to the UNCITRAL rule that ROHM USA conceded in the district court “exclusively delegated arbitrability to arbitrators,” Appx252, as the Ninth Circuit held in *Oracle America, Inc. v. Myriad Group A.G.*, 724 F.3d 1069, 1074-1077 (9th Cir. 2013) (“Incorporation of the UNCITRAL arbitration rules into the parties’ commercial contract constitutes clear and unmistakable evidence that [the parties] agreed to arbitrate arbitrability.”). The UNCITRAL rule, Article 23, paragraph 1, reads:

The arbitral tribunal shall have the power to rule on its own jurisdiction, including any objections with respect to the existence or validity of the arbitration agreement.

The Code of Civil Procedure rule, section 1297.161, reads:

The arbitral tribunal may rule on its own jurisdiction, including ruling on any objections with respect to the existence or validity of the arbitration agreement...

As the district court recognized, these words convey a clear and unmistakable delegation of authority to the arbitrator to rule on arbitrability. *Oracle America*, 724 F.3d at 1075; see also *Dream Theater, Inc. v. Dream Theater*, 124 Cal. App. 4th 547 (2004); *Qualcomm, Inc. v. Nokia Corp.*, 466 F.3d 1366, 1373 (Fed. Cir. 2006) (abrogated by *Henry Schein, Inc. v. Archer and White Sales, Inc.*, 139 S. Ct. 524, 529 (2019)) (agreement's incorporation of AAA Rules was clear and unmistakable evidence of agreement to delegate arbitrability to arbitrator). And, as the Supreme Court has held, "In those circumstances, a court possesses no power to decide the arbitrability issue. That is true even if the court thinks that the argument that the arbitration agreement applies to a particular dispute is wholly groundless." *Id.*, 139 S. Ct. at 529. The district court thus correctly compelled ROHM USA to arbitration.

Applying the same law, the Board should have deferred to the arbitrator and denied institution. Instead, by instituting trials, the Board assumed jurisdiction over the invalidity issues ROHM USA has raised before the arbitrator has determined whether the arbitrator — or the Board, or any court — in fact, has jurisdiction to

consider those issues. *Texas v. United States*, 523 U.S. 296, 300 (1998) (claim not ripe for adjudication if contingent upon “future events that may not occur as anticipated, or indeed may not occur at all.”)

The Board defers only to itself. While faulting MaxPower for having failed to cite “any Board decisions refusing to institute in view of Section 294” (Appx014), it cited with approval its own pre-*Epic* and pre-*Schein* decision in *Ford Motor Co. v. Paice LLC*, IPR2014-00579, Paper 12 (P.T.A.B. Sept. 30, 2014). Appx015. In *Ford*, the Board “reject[ed the Patent Owner’s] attempt to frame [an] unresolved breach-of contract issue [still pending in the district court] as a standing issue ripe for [the Board’s] review.” *Id.* But, the present case is nothing like *Ford*. Here, as the district court concluded, the parties clearly and unmistakably agreed to delegate arbitrability to the arbitrator. By comparison, in *Ford*, there was no challenge to the Board’s right to decide arbitrability, let alone a district court decision that the parties had delegated that right to the arbitrator.

5. ROHM USA Failed to Show That the TLA is Not an Agreement Contemplated by Section 294. Moreover, This is a Question for the Arbitrator.

Once again defending its refusal to apply the law by adverting to its self-assessed incompetence to read contracts, the Board stated, “in order to apply Section 294, we would need to interpret the arbitration clause...as one that falls with[in] the scope of Section 294. Our mandate does not include contract interpretation.”

Appx015-016. But in fact, this case did not require the Board to “resolve any contractual dispute between the parties” (Appx017), because the burden was on ROHM USA to prove a “reasonable likelihood of success at institution,” *Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1068 (Fed. Cir. 2016), and ROHM USA defaulted on that burden — never addressing MaxPower’s arguments as to the scope and meaning of the arbitration clause, and never showing that the district court’s interpretation of that clause was wrong. But, more important, none of this matters because the question whether the TLA incorporates an agreement to arbitrate patent invalidity contemplated by Section 294 is another “arbitrability” question to be answered by the arbitrator.

B. MaxPower Lacks Adequate Alternative Means to Obtain the Relief Sought

If there is no right of appeal,¹⁸ then MaxPower clearly “lacks adequate alternative means to obtain the relief sought.” *In re Princo Corp.*, 478 F.3d 1345,

¹⁸ The Supreme Court has interpreted 35 U.S.C. §314(d) as precluding review of institution decisions, even after final judgment, in the “mine run” case where the Board is enforcing the IPR statute. *Cuozzo Speed Technologies*, 136 S. Ct. 2131. But, recognizing that “[a] patent challenger does not have nearly as much to lose from an erroneous *denial* of *inter partes* review as a patent owner stands to lose from an erroneous *grant* of *inter partes* review,” *id.* at 2153, fn.6, *Cuozzo* leaves open whether review is allowed in this case, which 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, however, must be considered now, interlocutorily, or be mooted because, even if they are subject to review as part of the Board’s “final written decision,” *id.*,

1353 (Fed. Cir. 2007); *In re Regents of Univ. of Cal.*, 101 F.3d 1386, 1387 (Fed. Cir. 1996). Even if MaxPower were allowed to challenge the Board’s institution decision after the Board issues its final written order, its “right to [arbitrate patent invalidity] could not be vindicated by ordinary direct appeal from the [Board’s] ultimate [invalidity] determination since [§ 294] is designed to prevent the [IPR trials] from occurring at all. [MaxPower] thus lacks adequate alternative means to obtain the relief sought.” *Princo*, 478 F.3d at 1353 (granting the writ of mandamus).

C. Issuance of the Writ is Appropriate Under the Circumstances

ROHM Japan, a corporate giant, secured the services of MaxPower, a private California company, to develop and design products having industry-best performance in an area where ROHM’s own engineers had fallen behind ROHM’s competitors. Appx354, ¶6. Because of its superior expertise, MaxPower had the leverage to insist on a broad arbitration clause and did so expressly to correct the gross and obvious disparity between the parties’ resources to engage in no-holds-barred litigation. Appx359-360, ¶19, Appx372, ¶35.

Having agreed to arbitrate, ROHM USA is bound to live with the remedies available under Section 294. That statute provides that “[a]n award by an arbitrator”

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] ... will have been lost, probably irreparably.” *Cohen v. Beneficial Indus. Loan Corp.*, 337 U.S. 541, 546 (1949); see also *Regents of Univ. of Minn.*, 926 F.3d at 1346, fn. 2 (recognizing need for collateral-order review in that case).

– even an award invalidating one party’s patents – “shall be final and binding between the parties to the arbitration but shall have no force or effect on any other person.” 35 U.S.C. §294. In contrast, the IPR statute, at 35 U.S.C. §311(b), allows petitioners to “cancel” patent claims.²⁰

Holding ROHM to its choice of law imposes no unfair hardship. As this Court has noted, “[W]hen [the parties] negotiated the terms of their licensing agreement, this court attributes to them adequate knowledge of the basic patent law actions and remedies available to litigants, including the available forums and venues. Both parties would have been fully aware of the [options] for resolution of future controversies arising from the license agreement.” *Texas Instruments, Inc. v. Tessera, Inc.*, 231 F.3d 1325, 1330 (Fed. Cir. 2000). Further, as the court observed in *General Protecht Group, Inc. v. Leviton Mfg. Co., Inc.*, 651 F.3d 1355, 1366 (Fed. Cir. 2011), “There is no public interest served by excusing a party’s violation of its previously negotiated contractual undertaking to litigate in a particular forum.” The Board, likewise, should not have excused ROHM’s evasion of the TLA.

Like the appellee in *Sanofi-Aventis*, MaxPower “remained faithful” to the parties’ agreement, initially preparing to arbitrate in 2019 after ROHM asserted that its silicon carbide MOSFETs “were not licensed articles” under the TLA. *Sanofi-*

²⁰ This remedy is available in IPR because, having granted patent claims, the PTO has the authority to cancel them. Arbitrators have no such authority.

Aventis, 716 F.3d at 594. By seeking *inter partes* review, however, ROHM “effectively asked [the PTAB] to relieve it of its obligation to settle such disputes [by arbitration in Santa Clara County, California].” *Id.* As this Court has recognized, predictability of contract is critical in international transactions; it is even more so in an international technology development contract like the TLA. This was not a mere cash transaction, where the entire *quid pro quo* is exchanged all at once. Instead, MaxPower invested years of work in reliance upon the enforceability of the TLA, of which the arbitration clause was an essential part. If MaxPower had understood that, for attempting to enforce its license to technology, “whether or not patentable,” ROHM could drag it into the PTAB to defend the validity of its patents, MaxPower may not have contracted with ROHM at all.

Issuance of the writ is appropriate because, if uncorrected, the PTAB will repeat the striking errors it committed in this case, with the potential to render Section 294, a valid enactment of Congress, a dead letter. As Justice Alito trenchantly observed, albeit in dissent from the majority’s view in *Cuozzo*, “Nothing

in the [IPR] statute suggests that Congress wanted to improve patent quality at the cost of fidelity to the law.” *Cuozzo*, 136 S. Ct. at 2152.

Dated this 13th day of May, 2021 ROGER COOK LAW

By: /s/ Roger L. Cook

Roger L. Cook

Nancy L. Tompkins

*Attorneys for Defendant/Petitioner,
MaxPowers Semiconductor, Inc.*

FORM 30. Certificate of Service

Form 30
July 2020**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT****CERTIFICATE OF SERVICE****Case Number** _____**Short Case Caption** IN RE MAXPOWER SEMICONDUCTOR, INC.

NOTE: Proof of service is only required when the rules specify that service must be accomplished outside the court's electronic filing system. See Fed. R. App. P. 25(d); Fed. Cir. R. 25(e). Attach additional pages as needed.

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Person Served	Service Location (Address, Facsimile, Email)
James Hannah	Kramer Levin Naftalis & Frankel LLP, 990 Marsh Road, Menlo Park, CA 94025; Tel: (650) 752-1712; Fax: (650) 752-1812; jhannah@kramerlevin.com
Aaron Frankel	Kramer Levin Naftalis & Frankel LLP, 1177 Avenue of the Americas, New York, NY; Tel: (212) 715-7793; Fax: (212) 715-8363; afrankel@kramerlevin.com
Jeffrey H. Price	Kramer Levin Naftalis & Frankel LLP, 1177 Avenue of the Americas, New York, NY; Tel: (212) 715-7502; Fax: (212) 715-8302; jprice@kramerlevin.com

☒ Additional pages attached.Date: 05/13/2021Signature: /s/ Roger L. CookName: Roger L. Cook

SERVICE LIST (Attachment)

I certify that I served a copy of the foregoing filing on May 13, 2021, by U.S. Mail, 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

FORM 19. Certificate of Compliance with Type-Volume Limitations

Form 19
July 2020

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

CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITATIONS

Case Number: _____

Short Case Caption: IN RE MAXPOWER SEMICONDUCTOR, INC.

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Date: 05/13/2021

Signature: /s/ Roger L. Cook

Name: Roger L. Cook