

## Appealing Patent Trial and Appeal Board Final Written Decisions

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This Practice Note discusses procedural and strategic considerations involved in appealing final written decisions of the Patent Trial and Appeal Board (PTAB) in inter partes review (IPR), post-grant review (PGR), and covered business method (CBM) patentability challenges under the Leahy-Smith America Invents Act (AIA). It discusses grounds, timelines, and practical considerations for requesting rehearing of a final written decision before the PTAB and appeal to the US Court of Appeals for the Federal Circuit.

**In 2020 the USPTO issued several notices concerning the extension of certain patent-related timing deadlines and fee waivers under the Coronavirus Aid, Relief, and Economic Security Act (CARES Act). For more information, see [Article, COVID-19: Intellectual Property & Technology Practice Changes: USPTO](#).**

Since the Leahy-Smith America Invents Act (AIA) became effective in pertinent part in 2012, post-issuance patentability challenges including *inter partes* review (IPR), post-grant review (PGR), and the transitional program for covered business method review (CBM) at the US Patent and Trademark Office (USPTO) before the Patent Trial and Appeal Board (PTAB) have become an integral part of patent litigation and patent disputes.

As these proceedings continue to progress to final written decisions on patentability of the challenged and instituted patent claims, practitioners and stakeholders face multiple options for challenging and appealing a ruling. This Note discusses:

- Options to challenge a final written decision by the PTAB in an IPR, PGR, or CBM proceeding, including:
  - requesting rehearing before the PTAB; and
  - appealing to the US Court of Appeals for the Federal Circuit.
- Grounds for Federal Circuit appeals challenging the PTAB's:
  - institution decision; and
  - final written decision.
- Procedure on remand.

For a discussion of typical timelines, milestones, and procedures in IPR, PGR, and CBM proceedings, see [Practice Note, Understanding PTAB Trials: Key Milestones in IPR, PGR, and CBM Proceedings](#).

For a collection of additional resources concerning PTAB proceedings, see [PTAB Proceedings Toolkit](#).

For a collection of representative PTAB decisions, see [USPTO America Invents Act Trial Tracker \(PTAB\)](#).

### Options to Challenge a PTAB Final Written Decision

After a PTAB final written decision, a party may either (or both):

- Request a rehearing at the PTAB (see [Rehearing Requests](#)).
- Appeal to the Federal Circuit (see [Federal Circuit Appeals](#)).

A party may only appeal PTAB decisions to the Federal Circuit. Under the AIA and unlike other USPTO proceedings, there is no option to file a civil action against the USPTO in district court (35 U.S.C. §§ 141 and 319). Similarly, a party may not collaterally attack a PTAB



## Appealing Patent Trial and Appeal Board Final Written Decisions

decision in a district court action (see *Security People, Inc. v. Iancu*, 2020 WL 4873762 (Fed. Cir. Aug. 21, 2020) (affirming dismissal of patent owner's district court Administrative Procedure Act challenge of a previously affirmed PTAB invalidation in IPR)).

In *United States v. Arthrex, Inc.*, to remedy a constitutional defect regarding the appointment of Administrative Patent Judges, the Supreme Court granted the USPTO Director authority to review PTAB IPR decisions (2021 WL 2519433 (U.S. June 21, 2021); see Constitutionality of PTAB Judge Appointments – *United States v. Arthrex, Inc.*). The AIA had stated that “only the [PTAB] may grant rehearings (35 U.S.C. § 6(c)).

### Rehearing Requests

A party dissatisfied with the PTAB's final written decision may request a panel rehearing of the decision within 30 days of entry of the decision (37 C.F.R. § 42.71(d)(2)). Unlike other motions before the PTAB, the PTAB does not require its prior authorization for a rehearing request. The challenging party has the burden of showing that the decision should be modified and must specifically identify:

- All matters the party believes the PTAB misapprehended or overlooked.
- The place where each matter was previously addressed in a motion, opposition, or reply.

(37 C.F.R. § 42.71(d).)

The rehearing request is “not intended as a vehicle simply to disagree with [the] outcome or to provide new arguments” (*Captioncall, Inc. v. Ultratec, Inc.*, IPR2014-00780, Paper No. 40 (PTAB Dec. 1, 2015)).

Unless leave is otherwise obtained, the rehearing request is limited to 15 pages (37 C.F.R. § 42.24(a)(1)(v)). The party requesting rehearing may submit new evidence only for good cause, which the party may raise on a conference call with the Board before filing the rehearing request, or in the rehearing request itself (*Huawei Device Co., Ltd. v. Optis Cellular Technology, LLC*, 2019 WL 137151 (PTAB Jan. 8, 2019) (precedential) (denying rehearing)).

Except as noted below, a rehearing request generally does not toll the time for taking other action (37 C.F.R. § 42.71(d)).

### Rehearing Request Timeline

Once a party files a request for rehearing, the PTAB does not permit a response (or reply) without authorization. Therefore, unless the PTAB requests a response, or the party opposing the rehearing request seeks (and obtains)

permission to file a response, the PTAB rules do not allow for an opposition (or reply).

If authorized, the default time for filing an opposition is one month from service of the motion for rehearing (37 C.F.R. § 42.25(a)(1)). As with the motion, the opposition is limited to 15 pages (37 C.F.R. § 42.24(b)(3)).

With PTAB authorization, the moving party may file a reply within one month from service of the opposition (37 C.F.R. § 42.25(a)(2)). Any reply is limited to five pages (37 C.F.R. § 42.24(c)(2)).

If a party wishes to deviate from these default times or page limits, it must request PTAB approval.

### Rehearing Request Practical Considerations

It is unlikely, but possible, that a PTAB panel may change its decision in a motion for rehearing, as suggested by USPTO bulk data on rehearing decisions available on its [website](#) (click on “PTAB API page” for previous decisions).

There have been few decisions in which the PTAB has granted any motion for rehearing let alone a motion for rehearing of a final written decision. In one of the rare instances where the PTAB granted rehearing of a final written decision, the panel acknowledged its failure to recognize that an argument made about a specific element in a dependent claim would also address the broader element in the claim from which it depends. Therefore, while the panel granted rehearing regarding the dependent claims, it did not grant rehearing on the non-instituted claims from which they depended under notions of fairness (*Square, Inc. v. REM Holdings 3, LLC*, IPR2014-00312 (Paper No. 68) (PTAB Nov. 20, 2015), *app. dismissed*, No. 16-1650 (Fed. Cir. June 30, 2016) and No. 16-1651 (Fed. Cir. Aug. 31, 2016)).

Another panel granted rehearing of a final written decision in a converse situation, where it found a dependent claim invalid but the claim from which it depended not invalid. The PTAB granted rehearing to correct this clear error of logic (*Valeo N. Am. v. Magna Elecs., Inc.*, IPR2014-00220 (Paper No. 61) (PTAB July 14, 2015), *app. dismissed*, Nos. 15-2004, 15-2005, 15-2006 and 16-1119 (Fed. Cir. Jan. 8, 2016)).

To the extent the PTAB has otherwise entertained rehearing requests earlier in a proceeding, it has granted requests for rehearing in the following exemplary situations:

- The petition included a typographical error in a heading misidentifying claims addressed in the

## Appealing Patent Trial and Appeal Board Final Written Decisions

asserted unpatentability grounds (*Milwaukee Elec. Tool Corp. v. Irwin Indus. Tool Corp.*, IPR2015-01462 (Paper No. 13) (PTAB Jan. 15, 2016)).

- The PTAB's institution decision included obvious typographical errors, such as a misplaced decimal point (*Boston Sci. Corp. v. UAB Research Found.*, IPR2015-00918 (Paper No. 14), 2016 WL 1019300 (PTAB Mar. 7, 2016)).
- The PTAB's institution decision included clear factual errors on what was stated in the petition, such as:
  - misanalysing expert testimony referenced in the petition (*Genband US LLC v. Metaswitch Networks, Ltd.*, IPR2015-01457, Paper No. 17 (PTAB Feb. 22, 2016)); or
  - missing the significance of a portion of the prior art in the PTAB's analysis (*Merial v. Virbac*, IPR2014-01279 (Paper No. 18) (PTAB Apr. 15, 2015)).
- The PTAB overlooked an argument under an alternative claim construction adopted by the Board, which was supported by the petition (*AVX Corp. v. Greatbatch*, IPR2015-00710 (Paper No. 13 (PTAB Jan. 13, 2016)).
- The PTAB's rationale for declining institution misapprehended the significance of certain arguments and other information raised in the petition, and rehearing was necessary to address the deficiencies (*Daicel Corp. v. Celanese Int'l Corp.*, IPR2015-00173 (Paper No. 15), 2015 WL 3934090 (PTAB June 26, 2015)).

Counsel should therefore primarily consider requesting rehearing where either:

- The PTAB made an obvious error (such as a typographical error or clear factual mistake that would impact the opinion).
- A party to the proceeding may not have standing to challenge the decision on appeal to the Federal Circuit (see Article III Standing Requirement to Appeal to the Federal Circuit).

### USPTO Post-*Arthrex* Director Review

On June 29, 2021, the USPTO implemented an [interim procedure](#) for a Director review, consistent with the *Arthrex* decision. In this interim procedure, Director review may be:

- Initiated *sua sponte* by the Director.
- Requested by a party. Parties may request Director review of a final written decision in an inter parties review or a post-grant review by concurrently:
  - entering a Request for Rehearing by the Director into the USPTO's PTAB E2 page; and

- submitting a notification of the Request for Rehearing by the Director to the Office by email to [Director\\_PTABDecision\\_Review@uspto.gov](mailto:Director_PTABDecision_Review@uspto.gov), copying counsel for all parties by email.

The USPTO also issued post-*Arthrex* procedure [Q&A's](#). Key takeaways include:

- If the Director institutes review *sua sponte*, the parties will be given notice and may be given an opportunity for briefing.
- The Director's review may address any issue, including issues of fact and issues of law, and will be *de novo*.
- Parties will also be able to request Director review. The request:
  - must satisfy the timing requirements of 37 C.F.R. 42.71(d) by filing within 30 days of the entry of a final written decision or a decision on rehearing by a PTAB panel; and
  - will be considered a request for rehearing under 37 C.F.R. 90.3(b) and will reset the time for appeal or civil action as set forth in that rule.
- After a final written decision, a party may request Director review or, in the alternative, rehearing by the original PTAB panel. However, if a party requests:
  - Director review only, and it is not granted, the party may not then request PTAB panel rehearing.
  - PTAB panel rehearing, and the Board grants it, the parties will still be permitted to request Director review of the panel rehearing decision following the interim procedure above, whether or not they originally requested Director review.
- Regarding ongoing proceedings, a party must request rehearing within 30 days of the entry of a final written decision (37 C.F.R. § 42.71(d)). The same time requirement applies to a request for Director review.
- As a general matter, the Director will not consider untimely requests for rehearing of decisions. However, the Director may choose to extend the rehearing deadline for good cause if a party requests such an extension before the due date for a request for rehearing. Parties whose deadline for requesting rehearing had expired at the time the *Arthrex* decision issued may request a waiver of the deadline, provided they request the waiver before the due date for filing a notice of appeal under 37 C.F.R. § 90.3.
- Third parties may not:
  - request Director review; or
  - submit comments to the Director regarding review of a particular case unless the Director requests it.

## Appealing Patent Trial and Appeal Board Final Written Decisions

- The PTAB is not changing its Precedential Opinion Panel (POP) process at this time. However, the Office will be reviewing the POP process in view of the Director review process and welcomes public suggestions regarding potential changes.
- The USPTO will not charge a fee for a Request for Rehearing by the Director during implementation of the interim procedure. The USPTO will consider fees in the future.
- Parties may submit case-specific questions (such as request a call with the Board) by email to [trials@uspto.gov](mailto:trials@uspto.gov).

### Federal Circuit Appeals

Under 35 U.S.C. § 141(c), a party may only appeal a PTAB final written decision in an IPR, PGR, or CBM proceeding to the Federal Circuit (see also 35 U.S.C. §§ 319 (IPRs) and 329 (PGRs, including CBMs)). Section 141(c) states that a party dissatisfied with a PTAB final written decision may appeal “only to” the Federal Circuit.

For more information on Federal Circuit appeal procedure, see [Federal Circuit Civil Appeals Toolkit](#).

### Article III Standing Requirement to Appeal to the Federal Circuit

Under the statute, as the Supreme Court recently explained, a party dissatisfied with the Board’s review may seek judicial review at the Federal Circuit. Any party to the IPR may be a party at the Federal Circuit. (35 U.S.C. § 319 and *Oil States Energy Services, LLC v. Green Energy Grp., LLC, et al.*, 138 S. Ct. 1365, 1372 (2018).)

Nevertheless, the Federal Circuit has decided that while Article III standing is not required to bring a post-grant challenge before the PTAB, it is required to appeal a PTAB decision to the Federal Circuit:

- In *Consumer Watchdog v. Wisconsin Alumni Research Foundation*, the Federal Circuit dismissed the third-party requester’s appeal from a PTAB decision on *inter partes* reexamination because it had only alleged a general grievance concerning the challenged patent (753 F.3d 1258, 1263 (Fed. Cir. 2014)). The court determined that the requester’s status as a non-profit consumer rights organization concerned about the challenged patent’s reach and burden on taxpayer-funded research was not enough to make the dispute justiciable (see [Legal Update, Third Party Challengers Must Establish Injury in Fact to Appeal PTAB Decisions: Federal Circuit](#)).
- In *Personal Audio, LLC v. Electronic Frontier Foundation*, however, the Federal Circuit held that a non-profit consumer advocacy group was not constitutionally excluded from appearing before the court to defend a PTAB decision in its favor because the appellant patent owner had Article III standing (see 867 F.3d 1246 (Fed. Cir. 2017), *cert. denied*, 138 S. Ct. 1989 (2018) and [Legal Update, Federal Circuit Determines That EFF Has Standing to Defend PTAB Decision in Its Favor](#)).
- In *Altaire Pharm. v. Paragon Biotech*, a divided Federal Circuit held that the petitioner in a PGR proceeding had Article III standing to appeal based on its intent to file an Abbreviated New Drug Application implicating the challenged patent (889 F.3d 1274 (Fed. Cir. 2018) (noting that the petitioner’s injury was compounded by the PGR estoppel provision of 35 U.S.C. § 325(e)), *remand order modified by stipulation on other grounds*, 738 F. App’x 1017 (Fed. Cir. 2018)).
- In *E.I. DuPont De Nemours & Company v. Synvina, C.V.*, the Federal Circuit held that “a petitioner who appeals from an IPR decision need not face a specific threat of infringement litigation by the patentee to establish jurisdiction,” but instead “must generally show a controversy of sufficient immediacy and reality to warrant the requested judicial relief” (citations and internal quotation marks omitted). In this case, the Federal Circuit held that “[s]uch a controversy exists here because [the petitioner] currently operates a plant capable of infringing the [patent].” The Federal Circuit concluded that the petitioner met the injury in fact requirement for Article III standing because the petitioner “has concrete plans for present and future activity that create[ ] a substantial risk of future infringement or likely cause the patentee to assert a claim of infringement” (citations and internal quotation marks omitted). (904 F.3d 996, 1004-05 (Fed. Cir. 2018).)
- In *General Electric Company v. Raytheon Technologies Corp.*, the Federal Circuit held that the petitioner had standing to appeal the Board’s holding that the challenged claims were not unpatentable because the petitioner-appellant alleged sufficient facts to show that it engaged in activity that creates a substantial risk of future infringement. The court noted that to show the required injury following an IPR final written decision, an appellant does not need to concede infringement or face a specific threat of infringement litigation, but instead must show it has, is, or will engage in activity that would give rise to a potential infringement suit. (2020 WL 7635982, at \*4-7 (Fed. Cir. Dec. 23, 2020) (citations omitted) (finding that petitioner/appellant had made concrete plans for future potentially infringing activity, including development and investment in the product at issue and informal offer for sale in an ongoing bidding process).)

## Appealing Patent Trial and Appeal Board Final Written Decisions

The Federal Circuit also declined to address the appellant's arguments regarding patent owner estoppel for taking "action inconsistent with [an] adverse judgment" under 37 C.F.R. 42.73(d)(3) because the Board found the claims at issue in the IPR to be patentably distinct from the previously disclaimed claim (*Gen. Elec. Co.*, 2020 WL 7635982, at \*14 n. 6 (citing the Board's Final Written Decision, 2018 WL 3105491, at \* 4 (PTAB June 22, 2018))).

The Federal Circuit has also found that Article III standing does not exist based on 35 U.S.C. § 141(c) alone, even though the petitioner had been permitted to file an appeal. The court determined that the petitioner did not face a risk of infringing the challenged patent, and there was no injury in fact based on the challenged patent's alleged encumbrance of its licensing efforts (*Phigenix, Inc. v. ImmunoGen, Inc.*, 845 F.3d 1168, 1173-74 (Fed. Cir. 2017) and see [Legal Update, Party Who Does Not Face Infringement Risk Lacks Standing to Appeal Adverse PTAB Decision: Federal Circuit](#)). Similarly, in *AVX Corporation v. Presidio Components, Inc.*, the court held that an appellant's status as the patent owner's competitor, without a showing of non-speculative plans to engage in conduct arguably covered by claims upheld in an IPR, is not an injury in fact sufficient to confer Article III standing (2019 WL 2079178 (Fed. Cir. May 13, 2019) see also *Pfizer, Inc. v. Chugai Pharm. Co., Ltd.*, 2020 WL 1983197 (Fed. Cir. Apr. 27, 2020) (nonprecedential) (Section 315(e) estoppel does not create injury in fact against biosimilar sponsor where the appellant was or is not engaged in activity that would give rise to a potential infringement suit)).

The Federal Circuit has also dismissed an appeal for lack of Article III where all petitioner-appellants with standing settled their respective appeals mid appeal (see *Argentum Pharm. LLC v. Novartis Pharm. Corp.*, 2020 WL 1944759 (Fed. Cir. Apr. 23, 2020) (remaining appellant's manufacturing partner's ANDA preparation, speculative lost profits, and potential estoppel do not create injury in fact)).

The Federal Circuit has also found standing to appeal for parties who had joined an IPR proceeding beyond the one-year time bar period under 35 U.S.C. § 315(b), even where the original IPR petitioner lacked Article III standing (see *Mylan Pharms. Inc. v. Research Corp. Techs., Inc.*, 914 F.3d 1366, 1372-73 (Fed. Cir. 2019)).

### State and Tribal Sovereign Immunity

In *Covidien LP v. Univ. of Florida Research Foundation*, the PTAB held that state sovereign immunity applies to IPR proceedings (2017 WL 4015009 (PTAB Jan. 25, 2017)). There, the PTAB granted a motion to dismiss three petitions against the University of Florida Research

Foundation's ("UFRF") patent claims because, as an arm of the State of Florida, the UFRF was entitled to a sovereign immunity defense against review of the challenged claims. However, in *Regents of the University of Minnesota v. LSI Corporation*, the Federal Circuit held that state sovereign immunity does not apply in IPRs (2019 WL 2479596 (Fed. Cir. Jun. 14, 2019)).

The PTAB and Federal Circuit have likewise held that tribal sovereign immunity does not apply to IPR proceedings (*Mylan Pharms. Inc., et al. v. Saint Regis Mohawk Tribe*, IPR2016-01127, Paper 129 (PTAB Feb. 23, 2018)). The St. Regis Mohawk Tribe that lost this decision appealed to the Federal Circuit under the collateral order doctrine. The Federal Circuit affirmed (896 F.3d 1322 (Fed. Cir. 2018) and the US Supreme Court denied certiorari (139 S.Ct. 1547). In the related district court litigation, the district court had issued a final judgment holding each of the representative asserted claims as obvious (*Allergan v. Teva Pharm. USA, Inc.*, 2017 WL 4803941 (E.D. Tex. Oct. 16, 2017). The Federal circuit summarily affirmed (742 Fed. Appx. 511 (Fed. Cir. 2018)) and on June 3, 2019, the US Supreme Court denied certiorari (2019 WL 1558485).

### Constitutionality of PTAB Judge Appointments – *United States v. Arthrex, Inc.*

On June 21, 2021, the Supreme Court ruled that, under the AIA, Administrative Patent Judges (APJs) act as principal officers in *inter partes* review proceedings who therefore should be appointed by the President and confirmed by the Senate. To remedy this constitutional defect, the court granted the USPTO Director authority to review PTAB IPR decisions, which had been prohibited by 35 U.S.C. § 6(c). (*United States v. Arthrex, Inc.*, 2021 WL 2519433 (U.S. June 21, 2021).)

The court vacated and remanded the decision to the Federal Circuit, which had similarly held that that the statutory appointment of APJ to the PTAB by the Secretary of Commerce is an unconstitutional appointment of a principal officer in violation of the Appointments Clause, but provided a different constitutional remedy by severing the statutory restrictions on removing APJs, rendering them inferior officers. (941 F.3d 1320 (Fed. Cir. 2019).) For more information, see [Legal Update, Supreme Court: Administrative Patent Judge Decisions in IPRs Must Be Subject to Review by USPTO Director](#).

### PTAB Violations of the Administrative Procedures Act

Litigants may also challenge PTAB decisions for violations of the Administrative Procedures Act (APA) such as failing

## Appealing Patent Trial and Appeal Board Final Written Decisions

to give notice and opportunity to respond to new theories. For example, in *Nike, Inc. v. Adidas AG*, No. 2019-1262 (Fed. Cir. Apr. 9, 2020) (*Nike II*), the Federal Circuit held that the Board violated the APA by failing to provide notice and opportunity to respond to unpatentability grounds of record that the Board raised *sua sponte* to reject a proposed substitute claim on a motion to amend. The court therefore vacated the Board's decision denying the claim as obvious based on prior art raised in the petition but not addressed in the parties' motion to amend briefing.

### Federal Circuit Appeal Timeline

A party must file any notice of appeal with the Director of the USPTO within 63 days after the date of the final written decision (or a decision on a motion for rehearing of a final written decision) (35 U.S.C. § 142 and 37 C.F.R. §§ 90.3(a)(1), (b)(1) (resetting for timely rehearing request)).

The Director of the USPTO or the Director's designee may grant an extension of time to file a notice of appeal on a showing of either:

- Good cause, if made before time has expired.
- Excusable neglect for the failure to act, if made after time has expired.

(37 C.F.R. §§ 90.3(c)(1)(i), (ii) and see also 37 C.F.R. § 104.2 (for rules governing filing of request)).

A late request for more time, however, has been fatal in other contexts (see, for example, *Two-Way Media LLC v. AT&T, Inc.*, 782 F.3d 1311, 1317 (Fed. Cir. 2011) (affirming the district court's refusal to extend or reopen the appeal period due to counsel's neglect in docketing and filing a timely notice of appeal)).

A party may file a notice of cross-appeal within 14 days of the notice of appeal or within the time to appeal, whichever is later (Federal Rules of Appellate Procedure (FRAP) 4(a)(3) and 37 C.F.R. § 90.3(a)(1)).

The USPTO Director must send "a certified list and a copy of the decision or order appealed" to the Federal Circuit within 40 days after receiving the notice of appeal (Fed. Cir. Rule 17(b)(1)). The USPTO Director may send a second certified list based on the cross-appeal.

By the time the parties file the Joint Appendix, each party must:

- File a certificate of compliance confirming that they have reviewed the record to determine if any portion of it previously sealed under a protective order can be unsealed.
- Seek the other side's agreement to that effect.

(Fed. Cir. Rule 25.1(c).)

### Appeal Briefing

Fed. Cir. Rule 31(a) sets the following briefing schedule:

- **Appellant Brief Due (Blue Brief):** 60 days after service of the certified list (Fed. Cir. Rule 31(a)(1)(B)). This brief has a 14,000-word maximum (Fed. Cir. Rule 32(a)).
- **Appellee Brief Due (Red Brief):**
  - if there is no cross-appeal, 40 days after service of the appellant's brief (Fed. Cir. Rule 31(a)(2)). This brief has a 14,000-word maximum (Fed. Cir. Rule 32(b)); or
  - in a cross-appeal, 40 days after service of the appellant's brief (Fed. Cir. Rule 31(a)(2)). The appellee's principal and response brief has a 16,500-word maximum (Fed. Cir. Rule 28.1(b)(2)(A)).
- **Appellant's Rely Brief Due (Yellow Brief):**
  - if there is no cross-appeal, 21 days after service of the appellee's brief and at least seven days before oral argument (FRAP 31(a)(1)). This brief has a 7,000-word maximum (Fed. Cir. Rule 32(a)); and
  - in a cross-appeal, 40 days after service of cross-appellant's brief (Fed. Cir. Rule 31(a)(3)(A)). The appellant's response and reply brief has a 14,000-word maximum (Fed. Cir. Rule 28.1(b)(1)(A)).
- **Cross-Appellant's Reply Brief Due (Gray Brief):** 21 days after service of the appellant's reply brief (Fed. Cir. Rule 31(a)(3)(B)). This brief has a 7,000-word maximum (Fed. Cir. Rule 28.1(b)(3)(A)).
- **Joint Appendix Due (White Filing):** Seven days after the last reply is served and filed. If there is no cross-appeal and the appellant does not file a reply brief, the appendix is due within the time for filing the reply brief. In a cross-appeal, if the cross-appellant does not file a reply brief, the appendix is due within seven days after the time for filing the cross-appellant's reply brief has expired. (Fed. Cir. Rule 30(a).)

### Oral Argument at the Federal Circuit

The Federal Circuit generally sits for oral argument the first week of each month. Court session dates are published at the Federal Circuit [website](#). The court sometimes sets special hearings on non-court session dates, but this is unusual.

The Federal Circuit's Practice Notes for Fed. Cir. Rule 34 appear after the text of the rule and address oral argument and explain that the court:

- Usually calendars appeals for oral argument or submission without argument within four months after the parties file their briefs and joint appendix.

## Appealing Patent Trial and Appeal Board Final Written Decisions

- Advises counsel of the firm hearing date approximately six weeks before the session.

(Fed. Cir. Rule Practice Note 34.)

Once the case has been fully briefed, the clerk typically issues a Notice of Docket Activity (NDA). Within seven days of the NDA, counsel must identify any scheduling conflicts for at least the next three court weeks (Fed. Cir. Rule 34(d)(2)).

The court only considers conflicts by arguing counsel, who:

- Must attach to its response to the Notice to Advise of Scheduling Conflicts an explanation showing good cause for each submitted conflict.
- Is limited to ten total days of unavailability during the six consecutive court weeks identified in the Notice to Advise of Scheduling Conflicts.

(See [December 10, 2018 Revision to Process for Advising of Scheduling Conflicts](#).)

Beginning April 8, 2019, the court will note only accepted conflict dates in its docket (see [March 22, 2019 New Process for Notifying Counsel of Accepted Scheduling Conflicts](#)). Once oral argument is scheduled, the court does not postpone it except on a showing of good cause (Fed. Cir. Rule 34(d)(3)).

Where, due to scheduling conflicts, oral argument is delayed by more than three months, the court may require additional supplemental letters from counsel regarding conflicting dates. The rules emphasize that the parties should report any potential conflicts as soon as they are known and should not wait until actual conflicts arise (Fed. Cir. Rule 34(d)(2)).

If both parties elect to submit the case on the briefs and therefore waive oral argument, the case may be presented earlier to a panel for disposition.

### Post-Scheduling Oral Argument Procedure

Usually around the 20th to 22nd of each month, the Federal Circuit publishes the scheduled oral arguments for the corresponding court week two months later. The parties typically receive an ECF notice of the oral argument schedule, listing the first argument scheduled in the subject line. Counsel should not ignore this notice because, at first glance, it may appear not to relate to counsel's case.

When oral argument is scheduled, each party is asked to submit a form identifying:

- Counsel who will make the oral argument.
- The time requested to be reserved for each party.

If counsel or a party needs the courtroom to be accessible to the disabled for oral argument, counsel should notify the clerk when filing the entry of appearance.

The Federal Circuit typically schedules 15 minutes of oral argument per side (not per party or attorney) even in consolidated cases, although this time may vary depending on the nature of the cases (Fed. Cir. Rule Practice Note 34). At times, when there are appeals or cross-appeals from related but distinct PTAB proceedings, the court may consolidate the appeals by issue and have oral argument scheduled before the same panel on the same day for each appeal.

It is not uncommon for the court to grant more time during oral argument to counsel to answer the court's questions or to finish a point raised. The extra time is typically also provided to the other side. The court may also terminate an oral argument early in its discretion, although this is not a common practice.

In the typical oral argument, the appellant argues first and reserves a portion of its time for rebuttal. The respondent, assuming there is no cross-appeal, then makes its argument, without the option of reserving time for rebuttal. The appellant is then allowed to use its remaining time in rebuttal.

While the rules allow for the use of visual aids at oral argument (Fed. Cir. Rule 34(c)), it is not commonly done and tends to be an inefficient use of oral argument time. The more typical practice is instead to direct the panel to pages of a parties' brief or the joint appendix. Therefore, when briefing the appeal, counsel should consider what demonstrative evidence to reference at oral argument to ensure it is readily available to the court.

On the day of the oral argument, the court posts the panel sitting in each courtroom, which is the earliest the parties can know the specific judges deciding the appeal. Counsel making the oral argument must check in with the clerk's office at least 30 minutes before the scheduled session and before proceeding to the courtroom (Fed. Cir. Rule Practice Note 34).

The Federal Circuit typically issues a decision within 90 days of oral argument. However, the court may issue a summary disposition under Fed. Cir. Rule 36 as quickly as the day after oral argument or within two weeks after oral argument (see Fed. Cir. Rule 36).

For more information, see [Practice Note, Federal Circuit Appeals: Oral Argument, Disposition, and Rehearing](#).

### Confidentiality Considerations

Unless held in camera, oral arguments are open to the public. Recordings of each oral argument are available on the court's [website](#), free of charge. Counsel should listen to oral argument raising similar issues before making their own oral argument. Since oral argument is public, the Federal Circuit discourages parties from unnecessarily designating material in the briefs and appendix as confidential because this may hinder the court's preparation and issuance of opinions. Where necessary, however, counsel must be prepared to justify at oral argument any claim of confidentiality (Fed. Cir. Rule Practice Note 34).

### USPTO Intervention

The USPTO has the right to intervene in the appeal of an IPR, PGR, or CBM proceeding (35 U.S.C. § 143 and see *Oil States*, 138 S. Ct. at 1372 ("The Director can intervene to defend the Board's decision, even if no party does.")). In particular, the USPTO may exercise this right when a successful petitioner has settled with a patent-owner appellant such that no dispute remains between the parties in the proceeding (see, for example, *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268 (Fed. Cir. 2015), *aff'd* 136 S. Ct. 2131 (2016) and see [Legal Update, Supreme Court Affirms Federal Circuit in Cuozzo, Upholding USPTO Procedure in IPR Proceedings](#)).

When the USPTO elects to participate or the Federal Circuit requests the USPTO's participation, it typically receives its own allotment of 15 minutes for oral argument. In contrast, amicus curiae generally are not allowed to participate in oral argument, although in some rare cases, the Federal Circuit has invited such arguments.

### Amicus Briefs (Green Briefs)

FRAP 29 and Fed. Cir. Rule 29 govern amicus briefs, which may be filed either on consent of all parties or by leave of the court.

Attorneys representing amici must file Notices of Appearance and may participate in oral argument only by leave of the court (FRAP 29(a)(8)).

Amicus briefs on the merits are due seven calendar days after the principal brief of the party supported. If the amicus brief is in support of no party, then it is due seven calendar days after the appellant's principal brief. These amicus briefs may be up to 7,000 words long (about 14 pages). (FRAP 29(a)(5), (6).)

Amicus briefs supporting petitions for rehearing or rehearing *en banc* must be:

- Accompanied by a motion for leave to file.
- Filed within seven calendar days of the petition.
- No more than 2,600 words long (about five pages). (FRAP 29(b).)

Amicus briefs must contain various disclosures, including:

- A FRAP 26.1 disclosure statement (if amicus is a corporation) (FRAP 29(a)(4)(A)).
- A certificate of interest under Fed. Cir. Rule 47.4 (Fed. Cir. Rule 29(a)).
- A general statement of interest of the amicus and affirmative statements clarifying whether any parties other than the amicus helped to draft or fund the preparation and filing of the brief (FRAP 29(a)(4)(D), (E)).

## Grounds for Federal Circuit Review

Not every PTAB decision is appealable. For example, PTAB institution decisions generally are not reviewable at least in the first instance (see [Generally No Review of Institution Decisions](#)).

The Federal Circuit has, however, held several categories of PTAB rulings in final written decisions to be appealable, including the PTAB's:

- Claim construction (see [Reviewability of Wrong Claim Construction](#)).
- Failure to consider evidence presented in the proceeding (see [Failure to Consider Evidence](#)).
- Failure to explain the rationale behind its determination (see [No or Inadequate Explanation of Rationale](#)).
- Obviousness determinations (see [Reviewability of Obviousness Determination](#)).
- Consideration of a new ground raised by the petitioner in its reply (see [Reviewability of New Patentability Challenge Ground](#)).
- Application of the one-year bar to an IPR petition under 35 U.S.C. 315(b) (see [Reviewability of One-Year Bar](#)).
- Decision regarding the application of Section 315(e)(1) estoppel, where the alleged estoppel-triggering event occurs after institution (see [Legal Update, PTAB IPR Estoppel Decisions Reviewable if Alleged Estoppel-Triggering Event Occurs After Institution: Federal Circuit](#)).

The Federal Circuit has also held certain categories to PTAB rulings not to be appealable, including the PTAB's:

## Appealing Patent Trial and Appeal Board Final Written Decisions

- Decision not to institute on certain grounds asserted in the petition (see Reviewability of Non-Instituted Grounds).
- Decision on institution regarding assignor estoppel (see Reviewability of Wrong Decision on Assignor Estoppel).

These rulings, as discussed below, are subject to further reconsideration, as a result of the Supreme Court's recent decision in *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348 (2018).

The Supreme Court has also left open the possibility for reversal of PTAB decisions for due process violations (see Due Process and APA Violations).

### Standard of Review

#### PTAB Factual and Legal Determinations

The Federal Circuit reviews the PTAB's factual determinations for substantial evidence and its legal determinations de novo. Substantial evidence is something less than the weight of the evidence but more than a mere scintilla of evidence. It is "such relevant evidence as a reasonable mind might accept as adequate to support a conclusion." (*In re Nuvasive, Inc.*, 842 F.3d 1376, 1380 (Fed. Cir. 2016).)

Therefore, counsel should focus appeal points on issues that can meet these highly deferential standards.

#### PTAB Trial Management

Separately, the Federal Circuit reviews the PTAB's decisions on how it manages its permissive rules of trial proceedings for abuse of discretion. This occurs where a PTAB decision:

- Is clearly unreasonable, arbitrary, or fanciful.
- Is based on an erroneous conclusion of law.
- Rests on clearly erroneous fact findings.
- Involves a record that contains no evidence on which the Board could rationally base its decision.

(*Ultratec, Inc. v. CaptionCall, LLC*, 872 F.3d 1267, 1272 (Fed. Cir. 2017).)

### Mootness on Appeal

The Federal Circuit addressed the issue of mootness on appeal in *Uniloc 2017 LLC v. Hulu, LLC* (2020 WL 4197750 (Fed. Cir. Jul. 22, 2020)). The court affirmed the PTAB's precedential decision in *Amazon.com, Inc. v. Uniloc Lux. S.A.*, 2019 WL 343802 (PTAB. Jan. 18, 2019), holding that the Board may consider Section 101 eligibility of proposed substitute claims on a motion to amend. In a split decision,

the court noted that the issue was not moot on appeal despite the fact that the Federal Circuit had affirmed the invalidity of the original claims on a separate appeal from a district court decision. The court reasoned that reversing the PTAB's decision invalidating the proposed substitute claims under Section 101 would give the patent owner relief.

In *ABS Global, Inc. v. Cytonome/ST, LLC*, the US Court of Appeals for the Federal Circuit affirmed a PTAB decision dismissing an IPR appeal as moot because the patentee unilaterally elected not to appeal a noninfringement finding in a parallel district court proceeding (2021 WL 42266 (Fed. Cir. Jan. 6, 2021) and see [Legal Update, Patentee's Unilateral Action Thwarts Challenger's Opportunity to Appeal IPR Decision: Federal Circuit](#)).

### Generally No Review of Institution Decisions

PTAB institution decisions generally are not appealable to the Federal Circuit. In *Cuozzo*, the US Supreme Court held that 35 U.S.C. § 314(d) barred Cuozzo's challenge to the USPTO's decision to institute an IPR (136 S. Ct. at 2142). In particular, the Court noted that Section 314(d)'s text expressly states that the USPTO's IPR institution decisions "shall be final and nonappealable" and that construing it otherwise would undercut Congress's intent to give the USPTO significant power to revisit earlier patent grants.

Specifically, the Court held that there is no ground for appeal where the patent holder:

- Merely challenges the USPTO's determination that the information presented in the petition satisfies the standard for instituting an IPR.
- Grounds its claim in a statute closely related to the decision to institute an IPR, such as 35 U.S.C. § 312(a)(3), which requires that the petition is pleaded "with particularity."

However, in *Cuozzo*, the Court also noted that there may be other grounds for appealing PTAB decisions, including appeals that:

- Implicate constitutional questions.
- Depend on other less closely related statutes.
- Present other questions of interpretation that reach, in terms of scope and impact, well beyond Section 314(d).
- Stem from:
  - a petition failing to give sufficient notice such that there is a due process issue with the entire proceeding; or

## Appealing Patent Trial and Appeal Board Final Written Decisions

- the USPTO acting outside its statutory limit by, for example, canceling a patent claim for indefiniteness under 35 U.S.C. § 112 in an IPR.

In this regard, the Court noted that the Administrative Procedure Act (APA) enables reviewing courts to “set aside agency action” that is “contrary to constitutional right,” “in excess of statutory jurisdiction,” or “arbitrary [and] capricious.” For more information on this decision, see [Legal Update, Supreme Court Affirms Federal Circuit in \*Cuozzo\*, Upholding USPTO Procedure in IPR Proceedings.](#)

The Federal Circuit has noted that it would violate *Cuozzo* to require the court to “un-wind the Board’s institution decision and compare it to the particular language used in [the] petition. . . , which is precisely the kind of analysis the Supreme Court cautioned against” (*Lonestar Silicon Innovations, LLC v. Iancu*, 2020 WL 1487265, at \*5 (Fed. Cir. Mar. 25, 2020) (non-precedential)).

Further, as a result of *SAS Inst.*, the Supreme Court has reversed the PTAB’s prior practice of instituting partial institution decisions as contrary to the statute (138 S. Ct. 1348). Thus, if the PTAB decides to institute at least one claim, the PTAB, under *SAS Inst.*, must address each “claim” challenged in the petition to the extent the petitioner maintains the challenge. However, in *BioDelivery Sciences International, Inc. v. Aquestive Therapeutics, Inc.*, the Federal Circuit held that 35 U.S.C. § 314(d) barred review of the PTAB’s decision to terminate previously-instituted IPRs that had been remanded to the PTAB following *SAS*, where the PTAB had instituted based only on one ground in each of the three petitions (2019 WL 4062525 (Fed. Cir. Aug. 29, 2019) (petition for cert. filed, No.19-1381 (June 16, 2020))).

In interim guidance issued after *SAS Inst.*, the USPTO confirmed that, at least for now, if instituted, the PTAB will consider each claim and “challenge” raised in the petition as part of the proceeding (see [USPTO, Guidance on the Impact of SAS on AIA Proceedings \(Apr. 26, 2018\)](#)).

### Grounds for Final Written Decision Review

The Federal Circuit’s reversals of PTAB final written decisions have focused on the following grounds:

- Erroneous claim constructions.
- Failure to consider evidence.
- Inadequate explanation by the PTAB of its rationale.
- Erroneous application of the law.

- Lack of due process and/or denial of APA rights.
- Improper consideration of the argument.
- Applying an improper burden of persuasion in a motion to amend.

### Reviewability of Wrong Claim Construction

The Federal Circuit reviews the PTAB’s ultimate claim constructions de novo and its underlying factual determinations involving extrinsic evidence for substantial evidence (*Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1297 (Fed. Cir. 2015), *overruled on other grounds by Aqua Prods., Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017)).

On October 11, 2018, the USPTO issued Final Rules regarding the claim construction standard in IPR, CBM, and PGR proceedings. Before the 2018 Rules, the PTAB construed unexpired patent claim terms according to their broadest reasonable construction (*Cuozzo*, 136 S. Ct. at 2144). Under the 2018 Rules, for proceedings where a petition is filed on or after November 13, 2018, the PTAB will:

- Construe claims using the standard set out in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc), which is applied in federal district courts and ITC proceedings.
- Consider prior claim constructions from district court or ITC proceedings if they are timely made of record in the proceeding.

The PTAB will continue to apply the broadest reasonable interpretation standard for construing unexpired patent claims and proposed substitute claims in the proceedings where a petition was filed before November 13, 2018. (Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51340 (Oct. 11, 2018) (amending 37 C.F.R. §§ 42.100(b), 42.200(b), 42.300(b)).)

The Federal Circuit explained that the correct inquiry in giving a claim term its broadest reasonable interpretation in light of the specification was “not whether the specification proscribes or precludes some broad reading of the claim term adopted by the examiner” and “not simply an interpretation that is not inconsistent with the specification.” Rather, it was “an interpretation that corresponds with what and how the inventor describes his invention in the specification, [which is] an interpretation that is ‘consistent with the specification.’” A “reasonable” construction must have support in the specification or extrinsic evidence and cannot be “divorced from the specification and the record evidence.” (*In re Smith Int'l, Inc.* 871 F.3d 1375, 1382-83 (Fed.

## Appealing Patent Trial and Appeal Board Final Written Decisions

Cir. 2017) (quoting *Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1298 (Fed. Cir. 2015))). Likewise, the broadest reasonable construction may not be so broad as to be inconsistent with the specification or render the claim term meaningless (*In re Power Integrations Inc.*, 884 F.3d 1370, 1376-77 (Fed. Cir. 2018)).

Therefore, where the Board adopts an “erroneous” claim construction to find claims “unpatentable,” the Federal Circuit may reverse and remand for reconsideration under the correct claim construction. For example, see:

- *Netlist, Inc. v. Diablo Techs., Inc.*, 701 F. App’x 1001 (Fed. Cir. 2017) (non-precedential) (reversing claim construction which was not reasonable in view of context of patent claim).
- *Hitachi Metals, Ltd. v. All. of Rare-Earth Permanent Magnet Indus.*, 699 F. App’x 929 (Fed. Cir. 2017), *cert. denied*, 138 S. Ct. 1695 (2018) (non-precedential) (reversing and remanding obviousness determination based on incorrect claim construction).
- *In re NuVasive, Inc.*, 693 F. App’x 893 (Fed. Cir. 2017) (non-precedential) (reversing claim construction where the PTAB’s decision was based solely on an unreasonable interpretation of expert testimony).
- *Nestle USA, Inc. v. Steuben Foods, Inc.*, 686 F. App’x 917 (Fed. Cir. 2017) (non-precedential) (reversing the PTAB’s construction of “aseptic packaging” which was broader than FDA regulation consistent with specification).
- *L.A. Biomedical Research Inst. at Harbor-UCLA Med. Ctr. v. Eli Lilly & Co.*, 849 F.3d 1049 (Fed. Cir. 2017) (reversing a finding of invalidity because, among other things, the Board adopted two erroneous claim constructions).

*D’Agostino v. MasterCard Int’l, Inc.*, 844 F.3d 945 (Fed. Cir. 2016) (holding that it was an error for the Board to adopt an interpretation that falls outside claim limitation of “single merchant”). While the Federal Circuit has held that institution decisions generally are not reviewable, statements the PTAB makes in its institution decision and later relies on in its final written decision are reviewable on appeal (*In re Magnum Oil Tools, Int’l, Ltd.*, 829 F.3d 1364, 1374 (Fed. Cir. 2016)). The Supreme Court in *SAS Inst.* was consistent with *Magnum Oil* but took the decision one step further: “[W]hile § 314(a) invests the Director with discretion on the question *whether* to institute review, it doesn’t follow that the statute affords him discretion regarding *what* claims that review will encompass.” (*SAS Inst.*, 138 S. Ct. at 1356).

The Federal Circuit has also held that the PTAB cannot adopt a new claim construction in the final written

decision that is different from the one in the institution decision without providing the parties an opportunity to present argument under the new claim construction, even if the new claim construction is correct (*SAS Inst., Inc. v. ComplementSoft, LLC*, 825 F.3d 1341, 1350-52 (Fed. Cir. 2016), *rev’d on other grounds sub nom. SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348 (2018)). This portion of the Federal Circuit decision was not appealed or addressed by the Supreme Court.

### Failure to Consider Evidence

The Federal Circuit may reverse a PTAB final written decision where the PTAB has failed to consider evidence in the proceeding. For example, in *Ultratec, Inc. v. CaptionCall LLC*, the Federal Circuit reversed a PTAB decision to invalidate all of the claims in several related IPR petitions because the Board “failed to consider material evidence and failed to explain its decisions to exclude the evidence” (872 F.3d at 1269). In *Ultratec*, the patent owner sought to introduce supplemental evidence of a witnesses’ trial testimony shortly after the trial testimony was taken. The Federal Circuit found that the PTAB’s refusal to accept the such evidence was an abuse of discretion and reversed and remanded the decisions instructing the Board to “admit and consider” this additional evidence. The Federal Circuit further instructed the PTAB that if it “finds [the witness] gave inconsistent testimony, the [PTAB] shall consider the impact on the specific patents at issue in the trial testimony as well as on his credibility as a whole.” The PTAB’s error included failing to properly apply the PTO’s regulations as well as failing to provide a “reasoned explanation” for its decision. (*Ultratec*, 872 F.3d at 1272-73, 1275.)

The Federal Circuit has also reversed PTAB decisions concerning evidence where:

- The PTAB “was too dismissive and erred in refusing to consider [conception] evidence” (see *Intellectual Ventures II LLC v. Motorola Mobility LLC*, 692 F. App’x 626, 627 (Fed. Cir. 2017) (non-precedential)).
- In finding the challenged claims not unpatentable, the PTAB failed to consider arguments advanced by the petitioner (see *Microsoft Corp. v. Parallel Networks Licensing, LLC*, 715 F. App’x 1013 (Fed. Cir. 2017) (non-precedential) (remanding for the Board to address allegation of anticipation by UNIX sockets modification method, which was not addressed in the final written decision)).
- The petitioner introduced new evidence in its reply as a “legitimate reply to evidence introduced by the patent owner” (*Apple Inc. v. Andrea Elecs. Corp.*, 2020 WL 593661, at \*7 (Fed. Cir. Feb. 7, 2020) (PTAB abused

## Appealing Patent Trial and Appeal Board Final Written Decisions

its discretion in rejecting Apple's reply arguments regarding another example of a previously-cited prior art algorithm, noting that the petitioner cannot be expected to discuss every permutation of an algorithm cited in the petition)).

### No or Inadequate Explanation of Rationale

The Federal Circuit may also reverse and remand where the PTAB fails to explain its rationale adequately in its final written decision (see, for example, *Google Inc. v. Intellectual Ventures II LLC*, 701 F. App'x 946, 953 (Fed. Cir. 2017) (non-precedential) (reversing the PTAB's determination of no invalidity for anticipation and obviousness because the PTAB "failed to adequately explain its findings" on two points), *Rovalma, S.A. v. Bohler-Edelstahl GmbH & Co. KG*, 856 F.3d 1019, 1021 (Fed. Cir. 2017) (reversing because the Board "did not set forth its reasoning in sufficient detail for [the court] to determine what inferences it drew from the petitioner's submissions"), and *Securus Techs., Inc. v. Global Tel\*Link Corp.*, 685 F. App'x 979 (Fed. Cir. 2017) (non-precedential) (reversing and remanding a portion of decision for which the Board provided no explanation for finding several claims obvious)).

Consistent with APA, the PTAB "must, as to issues made material by the governing law, set forth a sufficiently detailed explanation of its determinations both to enable meaningful judicial review and to prevent judicial intrusion on agency authority" (*Rovalma*, 856 F.3d at 1024).

The Federal Circuit has also reversed the PTAB where it invalidated dependent claims that were argued separately without explaining the basis for its decision (see, for example, *Paice LLC v. Ford Motor Co.*, 681 F. App'x 885 (Fed. Cir. 2017) (non-precedential) (reversing invalidity finding of dependent Claim 3, which was not separately addressed in the final written decision)).

### Reviewability of Obviousness Determination

The Federal Circuit has given the PTAB's factual findings substantial deference in reviewing obviousness determinations, which makes the PTAB's obviousness determinations based on factual queries generally difficult to overturn on appeal (see, for example, *Apple Inc.*, 2020 WL 593661, at \*9 (declining to overrule the Board's fact-intensive inquiry as to whether a person of skill in the art would have been motivated to combine references)). The Federal Circuit has also affirmed an obviousness determination based on the totality of evidence supporting the Board's finding that a primary reference was published and publicly accessible before

the challenged patent's priority date (see *VidStream LLC v. Twitter, Inc.*, 2020 WL 6937853 (Fed. Cir. Nov. 25, 2020) (affirming prior art status based on copyright registration date, archived webpage, and supporting testimony)).

However, the Federal Circuit has noted that the PTAB still "must provide some reasoned basis for finding the claims obvious in order to permit meaningful review by this court." (*Securus Techs.*, 685 F. App'x at 987 (non-precedential)). In *Securus Techs.*, the Federal Circuit vacated in part and remanded the PTAB's obviousness decision, holding that when determining obviousness the PTAB must:

- First, make the necessary findings and have an adequate evidentiary basis for its findings.
- Second, examine the relevant data and articulate a satisfactory explanation for its action, including a rational connection between the facts found and the choice made.

(685 F. App'x at 987.)

In *Securus Techs.*, the PTAB found certain dependent claims obvious and merely provided the following generic sentence as its reasoning: "After consideration of the language recited in [the claims], the Petition, the Patent Owner Response, and the Petitioner's Reply, as well as the relevant evidence discussed in those papers, we find that one of ordinary skill in the art would have considered these dependent claims obvious over [the asserted art]." The Federal Circuit agreed with the patent owner that "the Board failed to articulate any reasoning for reaching its [obviousness] decision" and remanded for further proceeding. (685 F. App'x at 987.)

The Federal Circuit has also reversed a PTAB obviousness finding where, among other things, the PTAB failed to make factual findings as to whether:

- There was an apparent reason to combine the prior art references.
- A person of ordinary skill in the art would have had a reasonable expectation of success from such a combination.

(*L.A. Biomedical*, 849 F.3d at 1067-68.)

Although the Federal Circuit applies a deferential standard on the PTAB's fact finding on appeal, it will nonetheless reverse incorrect findings, such as whether an argument was presented in a petition or whether an argument was withdrawn. For example, in *EMC Corp. v. Clouding Corp.*, the Federal Circuit found the PTAB

erred in making both findings and reversed a decision of invalidity and remanded for further proceedings (686 F. App'x 857 (Fed. Cir. 2017) (non-precedential)).

The Federal Circuit has also overturned PTAB obviousness rulings that lacked substantial evidence to support a finding of motivation to combine. For example, in *IPR Licensing, Inc. v. ZTE Corp.*, the Federal Circuit reversed an obviousness finding where the record did not provide a reason or show why the references cited or the knowledge of one of skill in the art at the time of the invention would motivate a skilled artisan to alter the standards with a reasonable expectation of success (685 F. App'x 933 (Fed. Cir. 2017) (non-precedential)). Likewise, the Federal Circuit has affirmed a non-obviousness finding where the petitioner failed to prove that a skilled artisan would have been motivated to combine prior art references (see *Arctic Cat, Inc. v. Polaris Indus., Inc.*, 2019 WL 7050133 (Fed. Cir. Dec. 23, 2019) (non-precedential)).

Likewise, the Federal Circuit has reversed obviousness determinations where the PTAB failed to adequately explain its rationale to support an obviousness combination (see, for example, *PersonalWeb Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 993-94 (Fed. Cir. 2017)).

In its September 4, 2020 panel rehearing decision in *Facebook, Inc. v. Windy City Innovation, LLC*, the Federal Circuit provided insight on PTAB obviousness determinations, holding that:

- The Board correctly rejected arguments where:
  - the petitioner failed to explain why a skilled artisan would have incorporated the feature into the prior art;
  - the petitioner cited no supporting evidence; and
  - the argument was based on attorney argument rather than evidence.
- An obviousness argument that is based on an argument that it “would be straightforward and predictable choice” was appropriate even if the combination would not be bodily incorporated into the prior art.

(2020 WL 5267975 (Fed Cir. Sep. 4, 2020) (finding that substantial evidence supports Board’s obviousness determinations that were not otherwise vacated).)

The Federal Circuit has vacated and remanded the Board’s obviousness determination for lack of substantial evidence regarding alleged teaching away and motivation to combine (*Gen. Elec. Co.*, 2020 WL 7635982, at \*8-14 (noting that the fact that a person of ordinary skill would need to use some creativity to carry out the prior art combination does not defeat a finding of obviousness)).

### Reviewability of New Patentability Challenge Ground

The Federal Circuit has held that the PTAB violated the APA by not permitting the patent owner to file a sur-reply or provide oral argument at the hearing to address the petitioner’s new factual assertion raised for the first time in the reply (*In re Nuvasive, Inc.*, 841 F.3d 966 (Fed. Cir. 2016) and see [Legal Update, PTAB Must Give Patent Owner an Opportunity to Respond to New Assertions Raised in Petitioner’s Reply: Federal Circuit](#)).

### Reviewability of One-Year Bar

On April 20, 2020, the Supreme Court held in *Thryv, Inc. v. Click-to-Call Technologies, LP* that 35 U.S.C. § 314(d) prohibits judicial review of PTAB time bar decisions under 35 U.S.C. § 315(b). The court reasoned that:

- Section 314(d)’s text and the court’s *Cuozzo* ruling preclude appeal of institution decisions where the grounds of review are closely tied to the PTAB’s decision to institute review.
- The time bar question is closely tied to the decision to institute, under the holding of *Cuozzo*.
- Allowing time bar appeals would cut against the AIA’s purpose and design of efficiently eliminating bad patent claims.
- Section 314(d)’s no appeal language is not limited to the PTAB’s determination under Section 314(a) of whether the petition has shown a reasonable likelihood of succeeding on the merits.

(2020 WL 1906544 (Apr. 20, 2020); see also *Koninklijke Philips v. Iancu*, 2020 WL 6735647 (Fed. Cir. Nov. 17, 2020) (non-precedential) (declining to entertain patent owner’s APA challenge as an improper challenge of the Board’s institution decision under *Thryv*).)

In view of *Thryv*, the Supreme Court granted *certiorari*, vacated, and remanded cases regarding:

- The definition of a “covered business method” patent, suggesting that the Federal Circuit can no longer review the PTAB’s determination of this issue (*Emerson Elec. v. SIPCO*, 2020 WL 3146672 (S. Ct. June 15, 2020)). On remand, the Federal Circuit held that the threshold determination a patent qualifies for CBM review is a decision that is non-appealable under 35 U.S.C. § 324(e) (*SIPCO v. Emerson Elec.*, 2020 WL 6733482 (Fed. Cir. Nov. 17, 2020)).
- Application of the time bar after involuntary dismissal of a civil action (*Atlanta Gas Light Co. v. Bennett Regulator Guard Inc.*, 2020 WL 1978924 (S. Ct. April 27, 2020)).

- Application of the time bar after voluntary dismissal of a civil action (*Superior Communications Inc. v. Voltstar Techs. Inc.*, 2020 WL 1978923 (S. Ct. April 27, 2020)).

### Reviewability of Real Parties In Interest Determination

The Federal Circuit has also applied *Thryv* to preclude judicial review under Section 314(d) to the PTAB's determinations regarding the real parties in interest requirement of Section 312(a)(2), indicating the Board's decisions in this regard are closely related to institution and judicial review is therefore precluded (*ESIP Series 2 LLC v. Puzhen Life USA LLC*, 958 F.3d 1378 (Fed. Cir. 2020) cert. denied 2020 WL 6037248 (U.S. Oct. 13, 2020)).

### Reviewability of Motions to Terminate Decisions

The Federal Circuit has denied an appeal under *Thryv* where the PTAB granted a motion to terminate the proceedings without addressing patentability after dismissal of a declaratory judgment action without prejudice, holding that the dispute was related to institution (*Ruiz Food Prods Inc. v. MacroPoint LLC*, No. 19-2113 (Fed. Cir. June 24, 2020)). This decision suggests that *Thryv* applies to motions to terminate in addition to institution decisions.

### Reviewability of Non-Instituted Grounds

The Federal Circuit has held that the PTAB's decision not to institute certain asserted grounds as redundant is not reviewable (*Shaw Indus. Grp., Inc. v. Automated Creel Sys., Inc.*, 817 F.3d 1293, 1297-99 (Fed. Cir. 2016) and [Legal Update, No Jurisdiction to Review PTAB Decision That Some IPR Grounds Are Redundant: Fed. Cir.](#)). Notably, the court held that 35 U.S.C. § 315(e) did not estop the petitioner from bringing its non-instituted arguments in either the USPTO or the district courts (*Shaw Indus.*, 817 F.3d at 1300).

On April 24, 2018, the Supreme Court held that when the USPTO institutes an IPR it must issue a final written decision addressing the patentability of all of the claims the petitioner challenged in the petition (*SAS Inst.*, 138 S. Ct. 1348). For more information on the effect of the Supreme Court's decision on PTAB proceedings, see [Legal Update, USPTO Releases Guidance Concerning PTAB Proceedings After SAS v. Iancu](#).

### Reviewability of Wrong Decision on Assignor Estoppel

In *Husky Injection Molding System v. Athena Automation Ltd.*, the Federal Circuit dismissed an appeal from the PTAB for lack of jurisdiction, finding that under 35 U.S.C.

§ 314(d) it could not review the question of whether assignor estoppel prevented the appellee from seeking an IPR (838 F.3d 1236, 1246-47 (Fed. Cir. 2016) and compare *Oil States*, 138 S. Ct. at 1372 ("When reviewing the Board's decision, the Federal Circuit assesses the Board's compliance with governing legal standards de novo and its underlying factual determinations for substantial evidence." (internal quotations omitted))).

### Due Process and APA violations

In *Cuozzo*, the Supreme Court made it clear that it left open the possibility for review of a final written decision where a petition fails to give "sufficient notice" creating a due process problem with the entire proceeding. In particular, the *Cuozzo* court noted that:

- Its interpretation of the AIA does not enable the USPTO to act outside its statutory limits by, for example, canceling a patent claim for "indefiniteness under Section 112" in *inter partes* review.
- Such "shenanigans" may be properly reviewable in the context of 35 U.S.C. § 319 and under the APA, which enables reviewing courts to set aside agency action that is "contrary to constitutional right," "in excess of statutory jurisdiction," or "arbitrary [and] capricious."

(136 S. Ct. at 2141-42.)

Since the *Cuozzo* decision, the Federal Circuit has followed the Supreme Court's guidance and found that such violations are reversible error. In *Rovalma*, the Federal Circuit reaffirmed its prior holding rejecting "the Director's broad assertion that the Board could raise any argument that could have been included in a petition." Nonetheless, in *Rovalma*, the Federal Circuit confirmed that the PTAB "may use a party's own submissions against it, even if the opposing party bears the burden of persuasion." (856 F.3d at 1027-28 (citing *In re Magnum Oil Tools Int'l Ltd.*, 829 F.3d 1364 (Fed. Cir. 2016)).)

A key concern is whether the parties had "notice" and "an adequate opportunity to address" arguments being relied upon by the PTAB in its final written decision. In *Belden Inc. v. Berk-Tek LLC*, the Federal Circuit ruled that the PTAB "'may not change theories in midstream without giving respondents reasonable notice of the change' and 'the opportunity to present argument under the new theory'" (805 F.3d 1064, 1080 (Fed. Cir. 2015)). The Federal Circuit therefore has reversed decisions that rely on grounds that were not the subject of proper notice to the parties and which the parties had no adequate opportunity to address (see, for example, *EmeraChem Holdings, LLC v. Volkswagen Group of Am., Inc.*, 859 F.3d 1341, 1348-52 (Fed. Cir. 2017)).

The Federal Circuit has, however, declined to accept a patent owner's APA challenge, which it held amounted to an improper challenge of an institution decision under *Thryv v. Click-to-Call (Koninklijke Philips v. Iancu)*, 2020 WL 6735647 (Fed. Cir. Nov. 17, 2020) (non-precedential)).

### Improper Denial of Motion to Amend

In *Aqua Products, Inc. v. Matal*, the Federal Circuit reversed the PTAB for systematically applying the wrong "burden of persuasion" on motions to amend (872 F.3d 1290 (Fed. Cir. 2017) (en banc) and see [Legal Update, PTAB Must Consider IPR Motions to Amend Without Placing Burden of Proof on Patent Owner: Federal Circuit](#)). Therefore, there will likely be more challenges under *Aqua Products* to prior denials of motions to amend that applied the wrong burden of persuasion. For a useful discussion of PTAB practice after *Aqua Products*, see *Western Digital Corp. v. SPEX Technologies, Inc.*, IPR2018-00082, IPR2018-00083, Order, *Information and Guidance on Motions to Amend* 37 C.F.R. § 42.5, Paper 13 (PTAB Apr. 25, 2018); see also USPTO, Memorandum "Guidance on Motions to Amend in view of *Aqua Products*" (Nov. 21, 2017)).

### Review of PTAB Joinder Decisions: *Facebook v. Windy City*

In March, 2019, the PTAB issued its first Precedential Opinion Panel (POP) order in *Proppant Express Investments, LLC v. Oren Technologies, LLC*, holding that 35 U.S.C. § 315(c) permits the PTAB to join the same party or new issues to an existing IPR proceeding (2019 WL 1283948 (PTAB Mar. 13, 2019)). Petitioners subsequently used *Proppant* to add new patentability challenges to earlier-filed IPRs, even if the new challenges were otherwise time barred, because the time bar does not apply to petitions filed with a joinder request (35 U.S.C. § 315(b)).

In *Facebook, Inc. v. Windy City Innovations, LLC*, however, the Federal Circuit overruled the POP's *Proppant* ruling, holding that the clear and unambiguous language of 35 U.S.C. § 315(c) does not authorize same-party or issue joinder in IPR proceedings (2020 WL 1285039 (Fed. Cir. Mar. 18, 2020)). The Federal Circuit relied in part on the Supreme Court's *Microsoft Corp. v. i4i Ltd. Partnership* decision, 564 U.S. 91, 101 (2011), to reason that:

- Statutes must be construed according to their customary and ordinary meaning, absent a strong reason not to.
- Section 315(c)'s plain language does not permit joining two proceedings or adding a person to a proceeding in which it is already a party.

(*Facebook*, 2020 WL 1285039, at \*6.)

Notably, the Federal Circuit issued a separate concurring opinion, finding that the POP's statutory interpretation of Section 315(c) in *Proppant* would not have been entitled to any deference even if the statute were ambiguous because Chevron deference only applies where an agency is exercising express congressionally delegated rulemaking or adjudication authority and the AIA does not include authorization to undertake statutory interpretation through POP opinions (*Facebook*, 2020 WL 1285039, at \* 20).

On September 4, 2020, the Federal Circuit denied *en banc* rehearing but issued a modified panel opinion confirming that 35 U.S.C. § 315(c) prohibits same-party and issue joinder, and further holding that 35 U.S.C. § 314(d) **does not preclude** appellate review of a PTAB joinder decision because it is a "separate and subsequent decision" to the institution decision (953 F.3d 1313 (Fed. Cir. 2020)). In a separate, "additional views" opinion, the court noted that the Board's POP procedure violates the APA as inappropriate rulemaking, and that POP decisions are entitled to no deference.

On July 8, 2020, in *Fitbit, Inc. v. Valencell, Inc.*, the Federal Circuit held that a joined party's right to appeal a PTAB decision applies to the entire IPR proceeding, including the PTAB's patentability ruling on claims that the joined party did not challenge but that were challenged by the original petitioner (2020 WL 3815662 (Fed. Cir. Jul. 8, 2020)). The court also held that the patent owner's objection to petitioner's tardy filing of an IPR petition was not reviewable on appeal under *Thryv*.

### *Facebook v. Windy City* – Joinder and Estoppel

In *Facebook v. Windy City*, the Federal Circuit confirmed that joinder under Section 315(c) only applies to joinder of new parties. It does not authorize a petitioner to join its own previously-filed IPR or add new claims or grounds (973 F.3d 1321 at 1333-38; see Review of PTAB Joinder Decisions: *Facebook v. Windy City*). In a follow-on decision, the Federal Circuit further elaborated that since Section 315(c) does not allow for joinder of new grounds, a petitioner who joins a IPR proceeding under section 315(c) is **not estopped** from raising district court validity challenges that are not at issue in the IPR (*Network-1 Technologies, Inc. v. Hewlett-Packard Co.*, 2020 WL 5666893, at \*8-9 (Fed. Cir. Sep. 25, 2020)).

## Procedure on Remand

In November 2017, the USPTO released a revised Standard Operating Procedure No. 9 (SOP 9) to provide guidelines on how the PTAB will handle decisions on

## Appealing Patent Trial and Appeal Board Final Written Decisions

cases from remand from the Federal Circuit (see [SOP 9 \(rev. 1\)](#)) available on the [PTAB's Resources and Guidance](#) webpage). In particular, the revised SOP 9 addresses when the PTAB should consider taking additional briefing,

additional evidence, and additional oral argument, depending upon the type of error found by the Federal Circuit requiring appeal. The following chart included in SOP 9 summarizes this guidance:

Remand Scenario	Additional Briefing	Additional Evidence	Oral Argument
<b>Erroneous Claim Construction</b>	Yes, unless the claim interpretation to be applied on remand was proposed by one of the parties and the effect thereof has been fully briefed	No, unless the evidence is insufficient to afford due process	No
<b>Failure to Consider the Evidence</b>	Yes, unless the evidence was fully briefed on the record	No	No
<b>Inadequate Explanation by the Board</b>	No, unless the briefing on the issues is inadequate for the Board to have made a decision in the first instance	No	No
<b>Erroneous Application of Law</b>	Yes, unless the law was fully briefed on the record but not reflected in Board decision	No	No
<b>Lack of Due Process/ Denial of APA rights</b>	Yes	Yes, for parties whose rights have been violated, unless additional briefing on evidence of record is sufficient to afford due process	Yes, if necessary to afford due process
<b>Improper Consideration of the Arguments</b>	Yes, unless argument is fully briefed in the record	No	No

SOP 9 cautions that these particular remand scenarios:

- Are provided for exemplary guidance only.
- Do not reflect all scenarios that have been or may result from remands by the Federal Circuit.

As a result of the Federal Circuit's decision in *Aqua Products v. Matal*, the Court upheld the motion to amend practice before the PTAB, which in turn results

in another scenario not contemplated by SOP 9 (872 F.3d 1290 and see [Legal Update, PTAB Must Consider IPR Motions to Amend Without Placing Burden of Proof on Patent Owner: Federal Circuit](#)).

Finally, as a result of the Supreme Court's decision in *SAS Inst.* (138 S. Ct. 1348), it is unclear how remands for appeals of partially instituted cases will be handled where the petitioner did not appeal the failure of the PTAB to issue a final written decision on the non-instituted claims and/or challenges.

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