In The Press:
IPWATCHDOG Turns To Partner Charles R. Macedo For Insight on SAS Institute Decision

SAS: When the Patent Office institutes IPR it must decide patentability of all challenged claims

By **Gene Quinn** & **Renee C. Quinn**

Yesterday the United States Supreme Court issued decisions in both *Oil States v. Green Energy*and *SAS Institute v. Iancu*. In Oil States the Supreme Court upheld the constitutionality of inter partes review (see here, here and here). In *SAS Institute*, a 5-4 majority ruled that there is no authorization in the statute for the Patent Trial and Appeal Board (PTAB) to partially institute a petition for inter partes review. Thus, the Supreme Court held that when the Patent Office institutes an inter partes review it must decide the patentability of all of the claims the petitioner has challenged.

To provide instant reaction to the Supreme Court's decision in *SAS Institute* we've reached out to an All-Star panel of industry experts for their take on this important decision. Their analysis follows.

***

Charles R. Macedo
Amster Rothstein & Ebenstein LLP

In *SAS Institute v. Iancu*, a split Supreme Court found that "When the Patent Office

institutes an inter partes review, it must decide the patentability of all of the claims the petitioner has challenged." The majority rejected the current practice of the PTAB to grant partial institutions, as extra-statutory. Based on the plain terms of the statute: the Patent Office must "issue a final written decision with respect to the patentability of *any* patent claim challenged by the petitioner." 35 U. S. C. §318(a) (emphasis added), the Court recognized that "any" means "every". From the majority's reading the statute: "In all these ways, the statute tells us that the petitioner's contentions, not the Director's discretion, define the scope of the litigation all the way from institution through to conclusion." While the opinion suggests that upon institution all grounds raised, in addition to each claim challenged, must be addressed in the Final Written Decision,, the decision is vague in addressing this aspect current PTAB practice. Perhaps next term the Supreme Court will answer that question.

Charles Macedo is a partner with Amster Rothstein & Ebenstein LLP. He litigates in all areas of intellectual property law, including patent, trademark and copyright law, with a special emphasis in complex litigation and appellate work.

http://www.ipwatchdog.com/2018/04/25/sas-patent-office-institutes-ipr/id=96297/