

NYIPLA

PTAB and Young Lawyers Committees

August 2, 2022

## PTAB Bootcamp: A Primer Review of PTAB Decisions

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Greenspoon Marder LLP

Fifteen Hundred and Twenty-two

# NYIPLA

The New York Intellectual Property Law Association®

PTAB Committee & Young Lawyers Committee

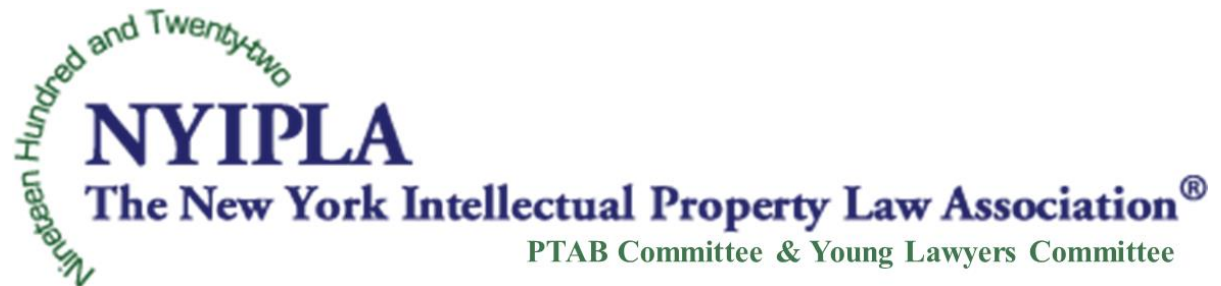


## Patent Trial And Appeal Board

# Disclaimer

The following presentation reflects the personal opinions of its authors and does not necessarily represent the views of their respective clients, partners, employers or of the New York Intellectual Property Law Association, the PTAB Committee, the Young Lawyers Committee, the PTAB Committee or its members.

Additionally, the following content is presented solely for the purposes of discussion and illustration, and does not comprise, nor is to be considered, as legal advice.



# Agenda

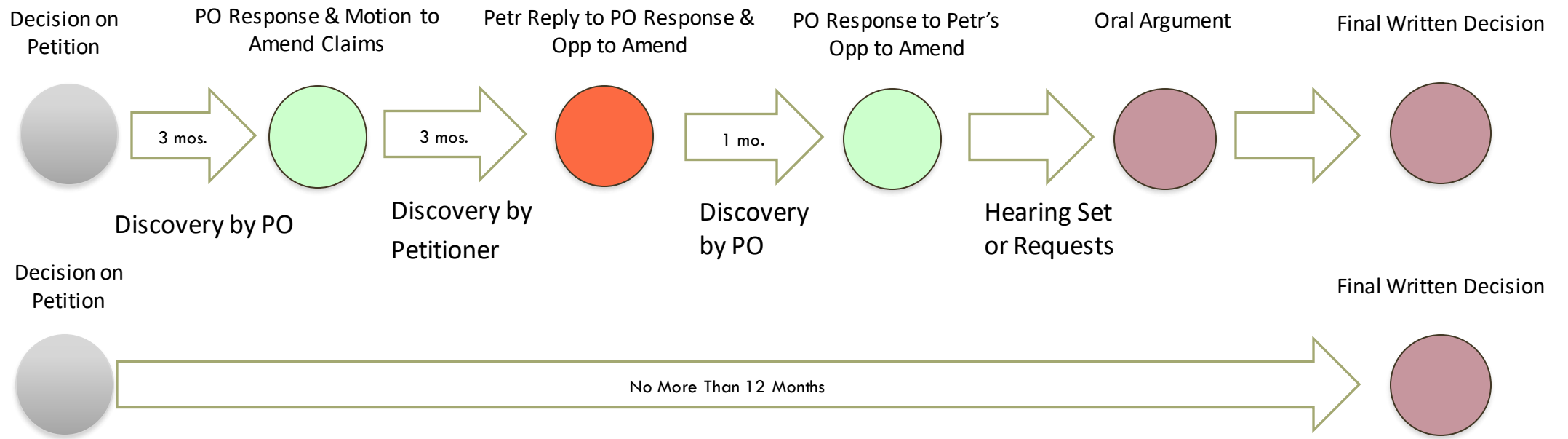
- Overview of Appeals
- Rehearing Requests
- POP Panel Review
- Review by Director
- Appeals at the Federal Circuit

# Agenda

- Overview of Appeals

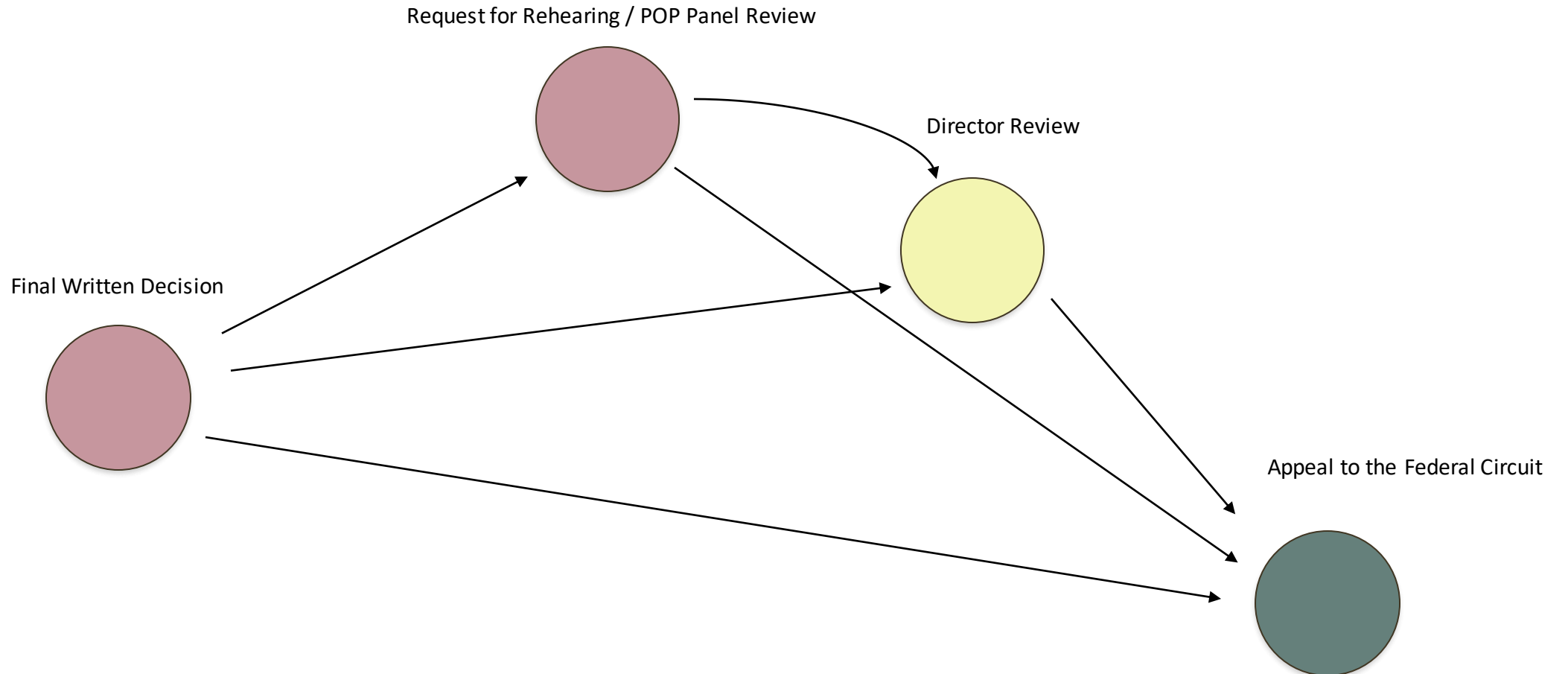
# Last Time: Overview of PTAB Trials

We discussed the timeline of a PTAB Trial up to the final written decision but did not discuss the rehearing or appeals process.



# Overview of Appeals and Rehearings

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# Agenda

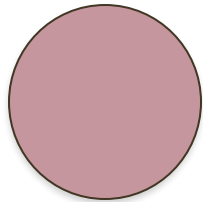
- Overview of Appeals
- Rehearing Requests



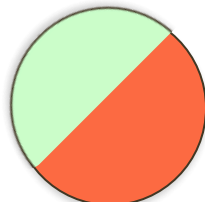
# Request for Rehearing

Parties dissatisfied with a Board decision may, within 30 days of entry of the decision, seek a request for rehearing from the Board.

Final Written Decision



Request for Rehearing



37 C.F.R. § 42.71(d)(2)



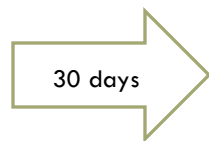
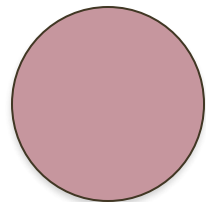
# Request for Rehearing

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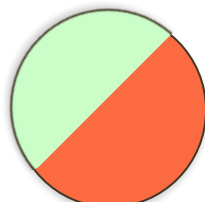
## Rehearing requests:

- Are limited to 15 pages
- May only submit new evidence for good cause
  - Parties can raise this issue on a conference call or in the rehearing request itself. *Huawei Device Co., Ltd. v. Optis Cellular Technology, LLC*, 2019 WL 137151 (PTAB Jan. 8, 2019) (precedential).
- Do not generally toll the time for taking other actions.

Final Written Decision



Request for Rehearing



37 C.F.R. §§ 42.24(a)(1)(v), 42.71(d)

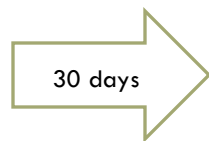
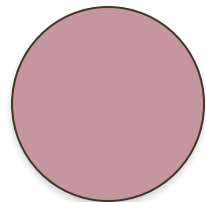
# Request for Rehearing

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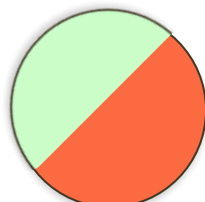
Rehearing requests:

- Must specifically identify all matters the party believes the PTAB misapprehended or overlooked, and
- Must specifically identify where in the record each matter was previously addressed in a motion, opposition, or reply.

Final Written Decision



Request for Rehearing



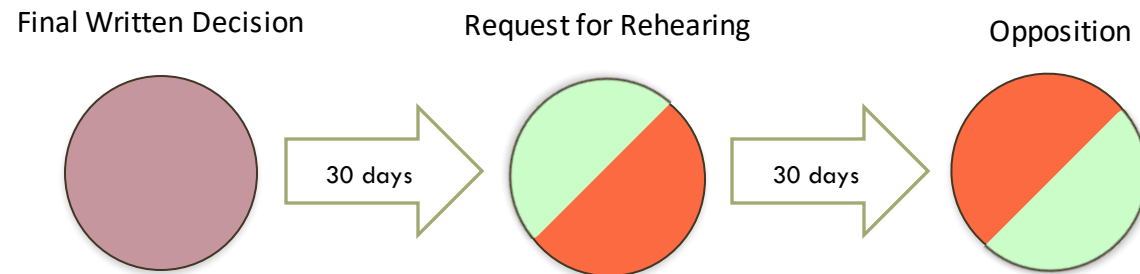
37 C.F.R. § 42.71(d)(2)

# Opposition to Request for Rehearing

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Oppositions must be approved by the Board, and like the Rehearing Request:

- Must be made within 30 days from service of the motion for rehearing (default timing)
- Are limited to 15 pages in length



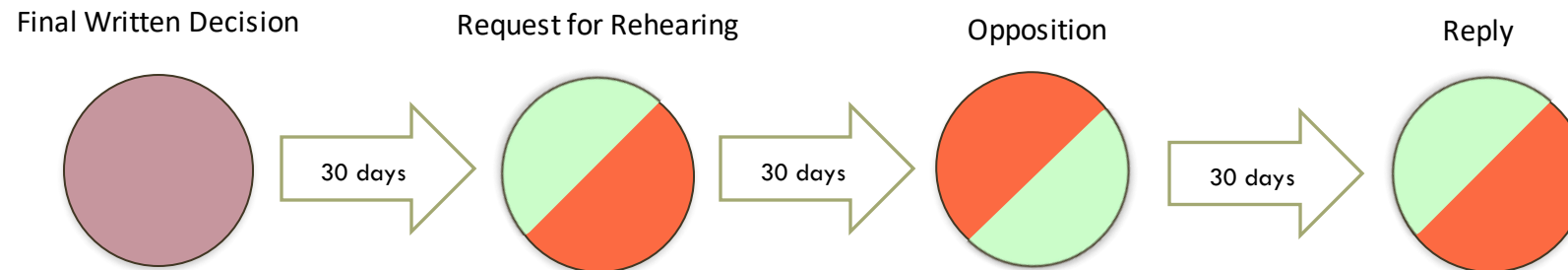
37 C.F.R. §§ 42.24(b)(3), 42.25(a)(1)

# Reply to Opposition

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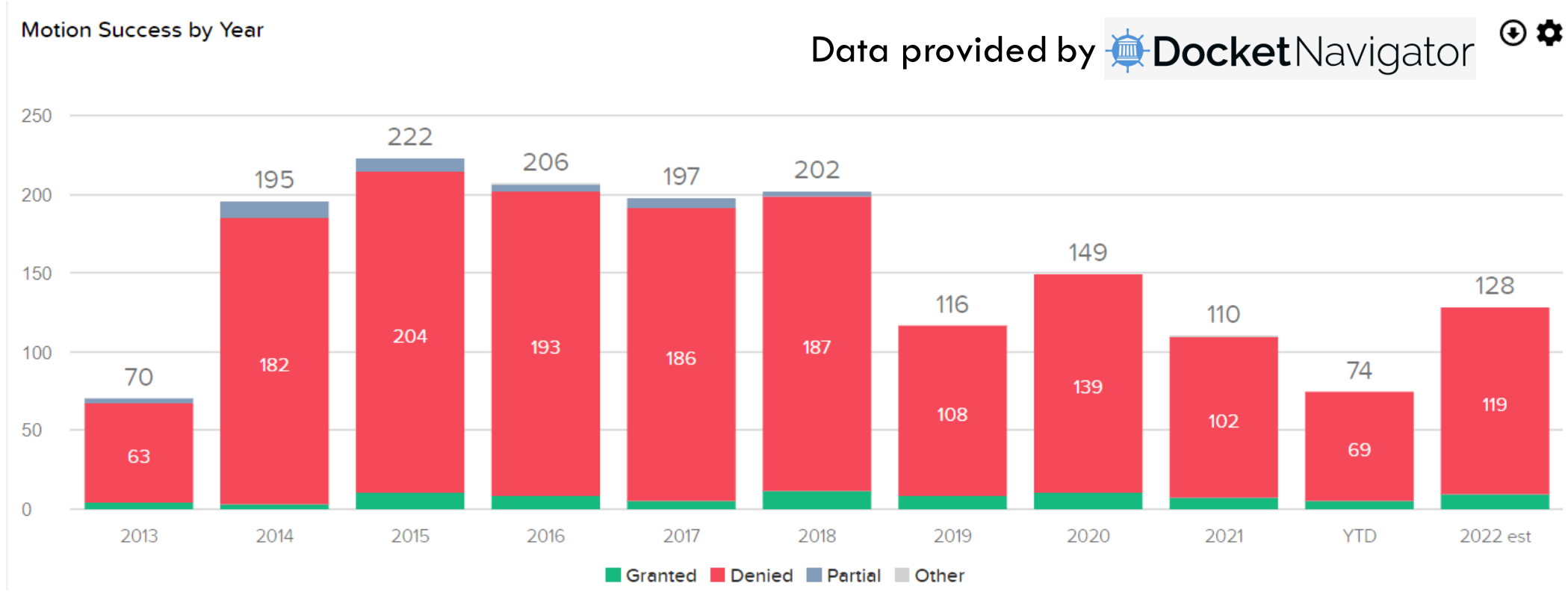
Reply must be authorized by the Board, and:

- Must be filed within one month of service of the opposition
- Is limited to five pages



37 C.F.R. §§ 42.25(a)(2), 42.24(c)(2)

# Docket Navigator— Rehearing Success Rate



For more PTAB data, see a copy of the presentation at the event: <https://www.nyipla.org/assnfe/ev.asp?ID=1434>.

The Summer 2022 NYIPLA Report will also feature a de-brief on some of these statistics!

Be sure to follow NYIPLA on Linked-In to stay up-to-date on the latest webinars and publications!

# Agenda

- Overview of Appeals
- Rehearing Requests
- **POP Panel Review**

# POP Panels

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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.

# POP Panels

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UNDER SOP2:

Any party to a proceeding may recommend Precedential Opinion Panel review of a particular Board decision in that proceeding by sending an email to:

[Precedential Opinion Panel Request@uspto.gov](mailto:Precedential%20Opinion%20Panel%20Request@uspto.gov)

which identifies with particularity the reasons for recommending Precedential Opinion panel review.

Such a request is to be filed at the same time as a request for rehearing, and must be accompanied by such a request.

There is no right to further review of a recommendation for Precedential Opinion Panel Review that is not granted.



# POP Panel Certifications

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Based on my professional judgment, I believe the Board panel decision is contrary to the following decision(s) of the Supreme Court of the United States, the United States Court of Appeals for the Federal Circuit, or the precedent(s) of the Board: (cite specific decisions).

Based on my professional judgment, I believe the Board panel decision is contrary to the following constitutional provision, statute, or regulation: (cite specific provision, statute, or regulation).

Based on my professional judgment, I believe this case requires an answer to one or more precedent-setting questions of exceptional importance (set forth each question in a separate sentence).

/s/ [signature] ATTORNEY OF RECORD FOR [list party/parties].

# Agenda

- Overview of Appeals
- Rehearing Requests
- POP Panel Review
- **Review by Director**

# Director Review – Origins

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- *United States v. Arthrex, Inc.*, 141 S.Ct. 1970 (June 12, 2021)
  - Supreme Court case concerning the constitutionality of administrative patent judge (APJ) appointments
  - The Court ruled that for APJ appointments to satisfy the U.S. Constitution, they had to be considered "inferior officers"
  - Decisions by such officers must be reviewable by officer "...appointed by Presidential nomination with the advice and consent of the Senate." *Edmond v. United States*, 520 U.S. 651, 663 (S.Ct., May 19, 1997)
  - This level of review of APJs was not available at the time of this case

# Director Review – Overview

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- Procedure implemented in accordance with decision in *United States v. Arthrex*
  - Empowered the Director to review decisions made by APJs
- Can request director review or panel rehearing – not both!
  - However, can request director review of panel rehearing decision
  - Director review does not alter POP review process
- USPTO recently released updated guidance on this topic (June 2022)



# Director Review – Initiating Review

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- Review process can be requested by a party or initiated *sua sponte* by the Director
  - Party requesting review submits Request for Rehearing through PTAB E2E system
    - Must be party to an America Invents Act (AIA) proceeding – no third-party requests!
    - Must also email USPTO at [Director\\_PTABDecision\\_Review@uspto.gov](mailto:Director_PTABDecision_Review@uspto.gov), and copy counsel for all parties
  - Internal review team alerts Director to decisions that may warrant review
- If *sua sponte* review is initiated, parties will be given notice and may be given the opportunity to provide briefs
  - If briefing is requested, USPTO will set forth procedures to be followed
- Petitions for review made by parties are evaluated by USPTO for compliance
  - Will work with timely non-compliant requests to rectify areas of non-compliance

# Director Review – Timing

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- Request for Rehearing must be filed within 30 days of the entry of final written decision or decision granting rehearing by PTAB panel
  - A timely Request is considered a request for rehearing under 37 CFR 90.3
- Director may initiate review at any point before a notice of appeal under 37 CFR 90.3 or before the time for filing such a notice has passed
- Rehearing deadline may be extended by Director for good cause if requested
  - Extension must be requested *before* deadline

# Director Review – Request Procedure

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- Currently no fee for a Request for Rehearing
  - This may change in the future
- Request for Rehearing has a 15-page maximum
- Formatting must adhere to requirements of 37 CFR 42.6(a)
  - 14-point Times New Roman font, 1-inch margins
- *May not* introduce new evidence or arguments
  - *May not* enter Exhibits in support; should avoid citing cases not in official record
  - Exceptions: issues of first impression or changes in law/USPTO procedure

# Director Review – Scope

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- Director may review *any* issue of law or fact issued by PTAB AIA proceeding
  - *Inter partes* review, post-grant review, covered business method review
  - Review of other decisions (e.g. institution decisions of AIA proceedings, *ex parte* appeals) will be handled by POP review
- All issues are reviewed *de novo*



# Director Review – Comments

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- Decisions are generally made based upon the existing record
  - No responsive briefing
  - No *amicus* briefing
  - No comments by third parties concerning the review of a decision
- Director may request responsive or *amicus* briefing
  - Procedures to follow would be set by USPTO

# Director Review – Procedure

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- Request for Rehearing routed to Advisory Committee
  - Will review Request and make recommendation
- Request, arguments, evidence, and recommendation are presented to Director
  - Director may rely on other individuals in the USPTO on an as-needed basis
- Director decides whether to grant or deny Request
  - Granted Requests are posted on Status of Director Review Requests webpage
  - Denied Requests are posted monthly on Director review status spreadsheet
- Timelines for decision on Request
  - Granted Request – 6 weeks or more
  - Denied Request – 4-6 weeks

# Director Review – Advisory Committee

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- 11-member panel from various units of the USPTO
  - Office of the Under Secretary – not including Director
  - PTAB – not including original panel members
  - Office of the Commissioner for Patents – not including any examiners involved in patent
  - Office of the General Counsel
  - Office of Policy and International Affairs
- Uses a system similar to that of the "cert. pool" used by the Supreme Court
- Can proceed with less than its full membership

# Director Review – Decisions

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- Review decisions can be designated as precedential, informative, or routine
  - Precedential and informative decisions are added to webpage
  - Email notification is used to inform the public about them
- Routine decisions can be nominated for precedential or informative status
  - Can be done through email or anonymous web form
- Director review decisions are not precedential by default
  - Only if designated as such by the Director

# Director Review – Conflicts

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- If the Director has a conflict of interest with parties, counsel, or patent(s) in the decision, she will be recused
  - Deputy Director will take required action
- If Deputy Director position is vacant or Deputy Director also has a conflict, Commissioner of Patents will take required action
- No member of Advisory Committee with conflict of interest will participate in recommendation
  - Advisory Committee members that are also APJs will follow Standard Operating Procedure 1

# Director Review – Request for Comments

- USPTO issued a Request for Comments on Director Review on July 20, 2022
  - Request also seeks comments on POP review
  - Deadline: Sept. 19, 2022
- [Link for formal comment submission](#)



Federal Register / Vol. 87, No. 138 / Wednesday, July 20, 2022 / Notices

43249

2008. Differentiating Serious and Non-Serious Injury of Marine Mammals: Report of the Serious Injury Technical Workshop, 10–13 September 2007, Seattle, Washington. U.S. Dep. Commer., NOAA Tech. Memo. NMFS–OPR–39. 94 p.  
Angliss, R.P. and D.P. DeMaster. 1998. Differentiating Serious and Non-Serious Injury of Marine Mammals Taken Incidental to Commercial Fishing Operations. NOAA Tech Memo. NMFS–OPR–13, 48 p.

**Catherine Marzin,**  
*Deputy Director, Office of Protected Resources, National Marine Fisheries Service.*  
[FR Doc. 2022–15284 Filed 7–19–22; 8:45 am]  
BILLING CODE 3510–22–P

## DEPARTMENT OF COMMERCE

### Patent and Trademark Office

[Docket No. PTO–P–2022–0023]

### Request for Comments on Director Review, Precedential Opinion Panel Review, and Internal Circulation and Review of Patent Trial and Appeal Board Decisions

**AGENCY:** Patent Trial and Appeal Board, United States Patent and Trademark Office, U.S. Department of Commerce.

**ACTION:** Request for Comments.

on the current interim process for PTAB decision circulation and internal PTAB review. These processes, implemented by the PTAB prior to issuing decisions and implemented without Director input, are modeled after practices of the U.S. Court of Appeals for the Federal Circuit.

**DATES:** *Comment Deadline Date:* Written comments must be received on or before September 19, 2022, to ensure consideration.

**ADDRESSES:** For reasons of Government efficiency, comments must be submitted through the Federal eRulemaking Portal at [www.regulations.gov](http://www.regulations.gov). To submit comments via the portal, enter docket number PTO–P–2022–0023 on the homepage and click “Search.” The site will provide a search results page listing all documents associated with this docket. Find a reference to this Request for Comments and click on the “Comment Now!” icon, complete the required fields, and enter or attach your comments. Attachments to electronic comments will be accepted in ADOBE® portable document format or MICROSOFT WORD® format. Because comments will be made available for public inspection, information that the submitter does not desire to make public, such as an address or phone number, should not be included in the

Director, the USPTO Commissioner for Patents, and the USPTO Commissioner for Trademarks. 35 U.S.C. 6(a). The Director is appointed by the President, by and with the advice and consent of the Senate. 35 U.S.C. 3(a)(1). APJs are appointed by the Secretary of Commerce in consultation with the Director. *Id.* 6(a). The PTAB hears and decides *ex parte* appeals of adverse decisions by examiners in applications for patents; appeals of reexaminations; and proceedings under the AIA, including IPRs, PGRs, covered business method (CBM) patent reviews,<sup>1</sup> and derivation proceedings, in panels of at least three members. *Id.* 6(b), (c). Under the statute, the Director designates the members of each panel. *Id.* 6(c). The Director has delegated that authority to the Chief Judge of the Board. *See* PTAB Standard Operating Procedure 1 (Rev. 15) (SOP1), Assignment of Judges to Panels, <https://go.usa.gov/xtdt2>.

35 U.S.C. 6(c) states that “[o]nly the Patent Trial and Appeal Board may grant rehearings” of Board decisions. In *United States v. Arthrex, Inc.*, the U.S. Supreme Court (Court) held that the Appointments Clause of the Constitution (art. II, sec. 2, cl. 2) and the supervisory structure of the USPTO require that the Board’s final decisions must be subject to review by the Director, a principal officer of the

# Agenda

- Overview of Appeals
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# Standing to Appeal

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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.



# Notice of Appeal

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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.

# Notice of Appeal (Timing)

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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)).

# Extension of Time for Notice of Appeal

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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)).

# Notice of Cross-Appeal

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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)).

# Record on Appeal

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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.

# Appearances

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Counsel retained prior to docketing must file an entry of appearance within fourteen (14) days after the court docketing the case, and one counsel must be designated as the “principal counsel.” Counsel retained after initial docketing must file an entry of appearance within fourteen (14) days after being retained or admitted to the court’s bar, whichever is later. All counsel must file an entry of appearance, except for government officials, who, by reason of their status as supervisors or heads of offices, may be listed on filings in their ex officio capacity.

Fed. Cir. R. 47.3(b)

# Joint Appendix

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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).)

# Appellant's Brief (Blue Brief)

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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(b)(1)).



# Appellee's Brief (Red Brief)

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–If there is no cross-appeal, 30 days after service of the appellant's brief (FRAP 31(a)(1)).

The appellee's principal and response brief has a 14,000-word maximum (Fed. Cir. Rule 32(b)(1)).

–If there is a cross-appeal, 40 days after service of the appellant's brief (Fed. Cir. Rule 31(2)).

The appellee's principal and response brief has a 16,500-word maximum (Fed. Cir. Rule 28.1(b)(2)(A)).

# Appellant's Reply Brief (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)

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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)

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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).)

# U.S. PTO intervention

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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)).

# Amicus Briefs (Green Briefs)

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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 (Green Briefs)

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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)).

# Oral Argument

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT COURT SESSIONS CALENDAR OCTOBER 2022 - SEPTEMBER 2023																					
Court Session							Federal Holiday														
October 2022				November 2022				December 2022				January 2023									
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\*Notes: January court week is not the first full week of the month due to the end-of-year holidays and potential travel associated therewith.  
November, July, and September court weeks are not the first full weeks of the month due to where the holidays fall.

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.



# Notice of Conflicts

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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.



# Oral Argument

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.

## UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

### SCHEDULED CASES August 2022 (Revised July 28, 2022)

#### Panel A: Monday, August 1, 2022, 10:00 A.M., Courtroom 201

19-1484	PTO	Polaris Innovations Limited v. Hirshfeld	[argued]
19-1483	PTO	Polaris Innovations Limited v. Hirshfeld	[argued]
21-1903	PTO	Nike, Inc. v. Adidas AG	[argued]
21-1967	DCT	Arendi S.A.R.L. v. LG Electronics Inc.	[argued]
21-2154	MSPB	Alguard v. Department of Agriculture	[on the briefs]

#### Panel B: Tuesday, August 2, 2022, 10:00 A.M., Courtroom 201

21-1900	DCT	VR Optics, LLC v. Peloton Interactive, Inc.	[argued]
21-2064	ITC	Philips North America, LLC v. ITC	[argued]
21-2121	PTO	Mylan Pharmaceuticals Inc. v. Merck Sharp & Dohme Corp.	[argued]
22-1171	DCT	Treehouse Avatar LLC v. Valve Corporation	[argued]
22-1417	CAVC	Randolph v. McDonough	[on the briefs]

#### Panel C: Wednesday, August 3, 2022, 10:00 A.M., Courtroom 201

21-1488	MSPB	American Federation v. Air Force	[argued]
21-1851	PTO	Provisur Technologies, Inc. v. Weber, Inc.	[argued]
21-1883	PTO	Provisur Technologies, Inc. v. Weber, Inc.	[argued]
21-1942	PTO	Provisur Technologies, Inc. v. Weber, Inc.	[argued]

#### Panel D: Thursday, August 4, 2022, 10:00 A.M., Courtroom 201

21-2173	DCT	Sanderling Management Ltd. v. Snap Inc.	[argued]
21-2208	PTO	Philanthropist.com, Inc. v. General Conference Corp. of Seventh-Day Adventists	[argued]
21-2370	DCT	Grace Instrument Industries, LLC v. Chandler Instruments Company, LLC	[argued]
22-1197	DCT	Doe v. Biden	[argued]
22-1565	CAVC	Keel v. McDonough	[on the briefs]

# Oral Argument

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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.

# Oral Argument

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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).

# Oral Argument

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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.

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.

# Decisions on Appeal

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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).

# Typical Grounds for Appeal

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

- Claim construction.
- Failure to consider evidence presented in the proceeding.
- Failure to explain the rationale behind its determination.
- Obviousness determinations.
- Consideration of a new ground raised by the petitioner in its reply.
- Application of the one-year bar to an IPR petition under 35 U.S.C. 315(b)
- Decision regarding the application of Section 315(e)(1) estoppel, where the alleged estoppel-triggering event occurs after institution

# Not Grounds for Appeal

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

- Decision not to institute on certain grounds asserted in the petition.
- Decision on institution regarding assignor estoppel.



# SOP 9

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## Procedures on Remand to PTAB

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

# Questions?

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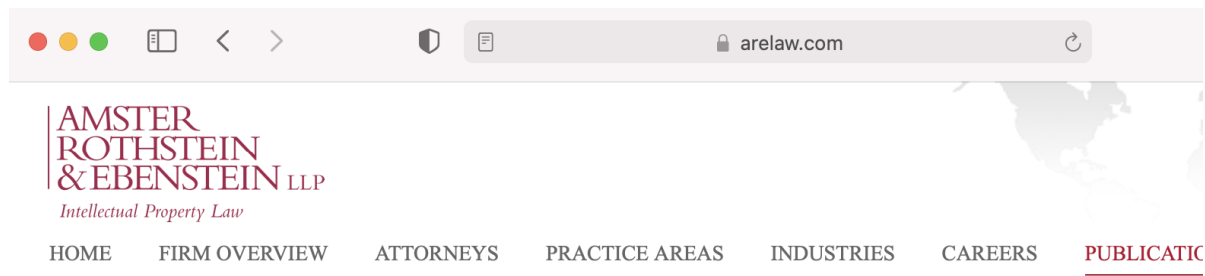
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# Resources



## Practical Law Practice Note By Charles R. Macedo On Appealing Patent Trial And Appeal Board Final Written Decisions

*Practical Law, February 2, 2018, Revised July 6, 2021*

Author(s): [Charles R. Macedo](#)

This Practical Law Practice Note by Charley Macedo 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).

The article also explores grounds, timelines and practical considerations for requesting rehearing of a final written decision before the PTAB and appeal to the U.S. Court of Appeals for the Federal Circuit.

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### Appealing Patent Trial and Appeal Board Final Written Decisions

by Charles R. Macedo, Amster, Rothstein & Ebenstein LLP, with Practical Law Intellectual Property & Technology

Status: **Maintained** | Jurisdiction: **United States**

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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

# Resources

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- [E-mail address to request Director review](#)
- [PTAB's precedential and informative decision webpage](#)
- [Status of Director Review Requests webpage](#)
- [PTAB Decision Nomination Web Form](#)
- [PTAB Decision Nomination Email](#)
- [Email for additional questions regarding Director Review](#)