

Federal Circuit Appeals From the PTAB: A New Game or Just the Same Old Practice'

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The America Invents Act (?AIA?) revamped the former Board of Patent Appeals and Interferences (?BPAI?) into the new Patent and Trademark Appeal Board (?PTAB?).¹ Since the AIA?s effective date, an average of one petition per day has been filed with the PTAB under the new inter partes review and covered business method post-grant review procedures.² The PTAB has started granting these petitions and instituting trials, and given the expected pace of the proceedings, it is likely that some will be appealable to the Federal Circuit within the next twelve months.³

Here, we address the new game of PTAB appellate practice by examining strategies and issues related to PTAB proceedings, parallel proceedings occurring among the different patent dispute venues, and the Federal Circuit. For PTAB proceedings, we will examine building a proper record in the PTAB, appealing PTAB discovery decisions, and the expected appellate standards of review for PTAB decisions. With respect to parallel proceedings among the district court, Federal Circuit, and PTAB, we will discuss the effect of divergent decisions, obtaining a stay of district court litigation, and the issue of estoppel. Lastly, for Federal Circuit appeals, we will look at the requirements for a notice of appeal from the PTAB, the anticipated timing with respect to Federal Circuit rulings, and obtaining a stay of Federal Circuit review.

To read the full white paper, click on the PDF linked below.

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If you have any questions, please feel free to contact one of the attorneys listed below.

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¹ See 35 U.S.C. ? 6. While some things have changed considerably under the AIA, other things have not. Where a rule or assertion applies equally to both the former BPAI and the new PTAB, this

paper refers to them interchangeably as the "Board."

² See AIA, Pub. L. No. 112-29, § 35 (making amendments effective one year after statute's enactment date, which was September 16, 2011).

³ See, e.g. SAP Am., Inc., Case CBM2012-00001 (MPT) (Jan. 9, 2013); Garmin Int'l, Inc., Case IPR2012-00001 (JL) (Jan. 9, 2013).