

Eugene Goryunov, David McCombs and Jonathan Bowser in Westlaw: 'IPR Tricks of the Trade: Not all Appeals From Patent Board are Made Equal'

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PRACTICES Intellectual Property Litigation, Patent Litigation, Patents, Patent Prosecution and Counseling, Intellectual Property

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Eugene Goryunov, David McCombs and Jonathan Bowser, of Haynes Boone, explore the nuances of appellate review from findings of the Patent Trial and Appeal Board.

Post-grant patent validity challenges — inter partes review (IPR) and post-grant review (PGR) — at the Patent Trial and Appeal Board (PTAB) are now household terms in patent litigation. What may not be common knowledge, however, is that various issues in a PTAB appeal to the U.S. Court of Appeals for the Federal Circuit are reviewed under different legal standards, sometimes depending on how the issues on appeal are framed.

Generally speaking, there are three types of issues that can arise in a PTAB appeal: procedural, fact finding, and conclusions of law. We explore these nuances below.

Procedural rulings

Procedural appeals ask the Federal Circuit to review the PTAB's evidentiary rulings and decisions that reflect the PTAB's administration of its own rules. The Federal Circuit reviews such challenges under an abuse of discretion standard, to the extent that they are even appealable under the U.S. Supreme Court's SAS/Click-to-Call line of cases.

An abuse of discretion occurs if the PTAB's ruling is "clearly unreasonable, arbitrary, or fanciful," is based on an "erroneous conclusion of law," rests on "clearly erroneous fact finding," or results from a record that contains no evidence on which the PTAB "could rationally base its decision." VidStream LLC v. Twitter, Inc. (Federal Circuit, 2020).

In practice, a party that challenges the PTAB's procedural rulings is generally arguing that the PTAB would have reached a different result in its final written decision had it excluded new arguments presented for the first time in a reply brief, for example. The Federal Circuit has substantial leeway to affirm the PTAB's procedural rulings, but it goes without saying that the court provides recourse where it finds that the PTAB should have reached a different result, especially where the result may well turn out to be case dispositive.

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