McCombs, Bowser and Goryunov in Westlaw Today: Patents IPR Year in Review

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Haynes Boone Lawyers David McCombs, Jonathan Bowser and Eugene Goryunov authored an article for *Westlaw Today* reviewing the year in inter partes reviews.

Read an excerpt below:

Inter partes reviews (IPRs) are a frequent component of patent litigation disputes. For example, a party accused of patent infringement in U.S. district court may challenge the validity of claims of the asserted patent in an IPR. The Patent Trial and Appeal Board (PTAB) of the U.S. Patent and Trademark Office (USPTO) adjudicates IPRs. Within the statutory guidelines set forth in the America Invents Act (AIA), the USPTO Director has authority to implement changes to the conduct of IPR proceedings. This article reviews several of the notable changes to IPR practice in 2023.

The PTAB issues two main decisions during an IPR: (1) a decision whether to institute trial based on the challenger's IPR petition and any preliminary response filed by the patent owner, and (2) if trial is instituted, a final written decision at the conclusion of the trial explaining whether the petitioner has proven whether the issued claims are unpatentable based on the prior art cited in the IPR petition.

Expansion of director review
In June 2021, the USPTO created an interim Director review procedure in response to the U.S. Supreme Court's decision in United States v. Arthrex, Inc., 141 S.Ct. 1970 (2021). In Arthrex, the Supreme Court held that the USPTO Director must have the authority and opportunity to review a PTAB final written decision before it becomes the final decision of the agency.

Under the Director review procedure, parties to an IPR may request the Director to review the PTAB's final decision, rather than request the original PTAB panel to rehear the final decision.

The original Director review procedure was limited to requesting review of the PTAB's final written decision. A party dissatisfied with an institution decision could not seek Director review under the original Director review procedure. Notably, the AIA specifies that the PTAB's decisions whether to institute trial are final and non-appealable. Consequently, the only avenue for reconsideration of an institution decision was the original PTAB panel that decided to institute trial.

In July 2023, the USPTO announced a "Revised Interim Director Review Process" (https://bit.ly/3Orn6O8) in which the scope of Director review was expanded to include the PTAB's " (1) decision whether to institute a trial, (2) final written decision, or (3) decision granting a request for rehearing."

The expansion of Director review to include institution decisions is a big deal. Practitioners should be aware, however, that parties may not seek Director review of erroneous findings of material fact or erroneous conclusions of law in an institution decision.

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The Director has actively used Director review to address issues of importance. In 2023, the Director granted Director review (https://bit.ly/3QL4KKK) in 18 post-grant proceedings before the PTAB.

To read the full article in *Westlaw Today*, click here.

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