David McCombs, Eugene Goryunov, Jonathan Bowser in Thomson Reuters Westlaw Today: 'IPR Tricks of the Trade: Options to Obtain Review of PTAB Decision'

By David L. McCombs, Jonathan R. Bowser | October 28, 2022

RELATED PRACTICES Intellectual Property Litigation, Patent Litigation, Patent Office Trials, Patents, Intellectual Property

Haynes Boone Partners David McCombs and Eugene Goryunov and Counsel Jonathan Bowser authored an article in Thomson Reuters *Westlaw Today*. Read an excerpt below:

The Patent Trial and Appeal Board (PTAB) adjudicates disputes over the validity of an issued patent. Parties accused of infringement often file a petition for *inter partes* review (IPR) to challenge the validity of an asserted patent.

During an IPR proceeding, the PTAB first issues a decision whether to institute trial. 35 U.S.C. § 314(a). If trial is instituted and the parties do not settle their dispute, the PTAB issues a final written decision at the conclusion of the trial. *Id.* § 318(a). A final written decision sets forth the PTAB's reasoning on whether the petitioner successfully proved that the challenged claims are unpatentable.

A party dissatisfied with the PTAB's institution decision or final written decision has several options to obtain review of that decision. This article addresses the various options and the differences between those options. The options for obtaining review of a final written decision are addressed first because there are more options available.

There are four options to request review of a final written decision:

(1) Appeal to the U.S. Court of Appeals for the Federal Circuit
(2) Rehearing by the original PTAB panel
(3) Precedential Opinion Panel (POP)
(4) Director review

Congress authorized a party dissatisfied with a final written decision to appeal the decision to the Federal Circuit. 35 U.S.C. § 319. The Federal Circuit reviews legal issues such as claim construction and obviousness de novo, i.e., without deference to the PTAB's legal conclusions. However, the Federal Circuit reviews factual findings underlying the PTAB's legal determinations under the deferential "substantial evidence" standard.

Thus, if the PTAB's factual findings support the PTAB's legal conclusion, the Federal Circuit might not reverse the PTAB's legal conclusion, even though the Federal Circuit may have weighed the evidence differently. Parties are generally more successful at the Federal Circuit when they can show legal error, or a violation of administrative law principles, rather than when attempting to gain reconsideration of the facts in evidence.

Excerpted from Thomson Reuters *Westlaw Today.* To read the full article, click here.

© 2026 Haynes and Boone, LLP

© 2026 Haynes and Boone, LLP