David McCombs, Eugene Goryunov, Jonathan Bowser, and Angela Oliver in IP & Technology Law Journal: 'Drawing the Line: Appealability of Issues in PTAB Institute Decisions'

April 28, 2021 David McCombs, Jonathan Bowser, Angela Oliver

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Congress created *inter partes* reviews ("IPRs") to provide a cheaper, faster alternative to district court litigation to contest patent validity. A "No Appeal" bar is included in 35 U.S.C. § 314(d), which provides that the determination by the Patent Trial and Appeal Board ("Board") whether to institute an IPR trial "shall be final and nonappealable." The U.S. Supreme Court and the U.S. Court of Appeals for the Federal Circuit have heard numerous appeals testing the boundaries of the "No Appeal" bar.

This article reviews those decisions and attempts to harmonize them to identify and provide guidance on what issues in the Board's institution decision may or may not be appealable. As one may expect, the answer is nuanced.

The first step is to determine whether the Federal Circuit has jurisdiction to hear the appeal – that is, whether the issue on appeal is even appealable. If the issue is tied to or relates to the Board's determination as to whether to institute review, then the issue is likely not appealable.

If not, the second step is to determine whether the issue relates to the Board's statutory authority over how it conducts the instituted trial once it has determined to institute review in the first place, which is likely appealable.

Excerpted from *Intellectual Property & Technology Law Journal*. To read the full article, click on the PDF below:

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