

Eugene Goryunov, Clint Wilkins, Jonathan Bowser, Angela Oliver, David McCombs in IP Magazine: 'Ringing the Changes'

October 1, 2020 Clint Wilkins, Jonathan Bowser, Angela Oliver, David McCombs

PRACTICES Intellectual Property, Intellectual Property Litigation

Andrei Iancu was sworn in as Under Secretary of Commerce for Intellectual Property and Director of the US Patent and Trademark Office (USPTO) on 23 February 2018, after being unanimously confirmed by the Senate. Shortly after his confirmation, Iancu stated that under his leadership, the PTAB would “take a holistic approach to fully implement the intent” of the America Invents Act (AIA) so that PTAB trials would “be a true alternative to district court litigation, not a consistent multiple bite at the apple.”

Change began swiftly under Iancu’s leadership, whether as a necessary reaction to court decisions or as a concerted effort to update (or wholesale change) PTAB trial practice. And while many stakeholders have applauded the changes made to PTAB trial practice change, of course, is almost never without controversy.

One of the first major changes to PTAB practice during Iancu’s tenure was prompted not by any agency-initiated action, but by a significant U.S. Supreme Court decision. Shortly after the Senate confirmed Iancu, the court decided *SAS Institute Inc. v. Iancu*. There, the court struck down the PTAB’s “partial institution” practice – a practice where a panel could institute an inter partes review (IPR) on less than all challenged claims – holding that the petitioner, not the USPTO, controls the scope of the petitioner’s challenge.

Excerpted from *Intellectual Property Magazine* To read the full article, login [here](#). (Subscription only)

