Dietze, Wolfson, Zhu: Some PTAB Procedural Decisions Can Be Appealed

By Jeffrey A. Wolfson | March 29, 2018

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In January 2018, the United States Court of Appeals for the Federal Circuit issued its en banc decision in *Wi-Fi One, LLC v. Broadcom Corp.*, holding that Patent Trial and Appeal Board (PTAB) time-bar determinations (the one-year statutory time bar) in an *inter partes* review (IPR) proceeding are appealable. The en banc decision overrules a panel's earlier decision in *Achates Reference Publishing Inc. v. Apple Inc.*

A procedural background and discussion of the implications of this ruling are set out below.

Broadcom petitioned the PTAB to institute IPRs challenging the validity of various claims of three patents owned and asserted by Wi-Fi One. In its preliminary response, Wi-Fi One argued that the IPR should not be instituted because Broadcom's petition was barred under the one-year statutory time bar. Specifically, Wi-Fi One asserted that, although the defendants in a district court litigation regarding the same patents were not petitioners in the IPR, the defendants were a real part-in-interest or a privy of petitioner Broadcom as to these patents. Thus, the one-year statutory time bar for filing a petition applied.

The PTAB disagreed and instituted the IPR proceedings. Wi-Fi One's motion requesting additional discovery to determine if any of the defendants were a real party-in-interest or a privy of Broadcom was denied by the PTAB, as was Wi-Fi One's request for a rehearing on the order denying discovery. A request for writ of mandamus filed by Wi-Fi One's predecessor-in-interest asking the Federal Circuit to compel that discovery was also denied.

Ultimately, the IPR proceedings concluded with a determination that the challenged claims of the Wi-Fi One patents were unpatentable. A request for rehearing was denied, and Wi-Fi One appealed the PTAB's final ruling to the Federal Circuit. …

Excerpted from *Today's General Counsel*. To read the full article, click here.

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