

CLIENT ALERT

USPTO's Procedural Decisions Were Not Final Actions Under APA and Facial Challenge to Procedural Amendment Was Untimely

MAY 22, 2020

Odyssey Logistics and Tech. Corp. v. Iancu, No. 2019-1066 (Fed. Cir. May 22, 2020)

Plaintiff challenged the legality of three United States Patent and Trademark Office (USPTO) actions under the Administrative Procedures Act. The district court dismissed the first two for lack of subject matter jurisdiction, and the third as barred by the six-year statute of limitations for claims against the United States. The plaintiff appealed and the Federal Circuit affirmed on all grounds.

The first two grounds concerned the same issue: whether there was a final agency decision necessary to confer subject matter jurisdiction on the district court. In one appeal, the examiner's request for rehearing had been granted over the plaintiff's opposition. In another, the plaintiff's petition to designate portions of the examiner's appellate brief as new grounds for rejection was dismissed. Because the underlying appeals of the patent applications were ongoing in both instances, there was no final agency action to confer subject matter jurisdiction on the district court.

The third ground was the plaintiff's facial challenge to amendments to the USPTO's rules for ex parte appeals. The statute of limitations for claims against the United States is six years from when the claim accrues. The amendments were published on November 22, 2011, but were effective only for appeals after January 23, 2012. The plaintiff argued that its suit was timely because it was within six years of the effective date, which was the first possible application of the amended rules. Under controlling Fourth Circuit law, however, the limitations period for facial challenges runs from when the agency publishes the regulation. Applying this law, the plaintiff's claims were barred.

A copy of the opinion can be found [here](#).

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