

Petitioner Cannot Appeal PTAB Decision to Reconsider Institution and Terminate Pending IPR Proceedings

AUGUST 30, 2019

Biodelivery Sciences Int'l v. Aquestive Therapeutics, Inc., Nos. 2019-1643, 2019-1644, 2019-1645 (Fed. Cir. Aug. 29, 2019)

The petitioner filed multiple petitions for *inter partes* review (IPR) of the same patent, with each petition asserting several grounds of invalidity. The Patent Trial and Appeal Board (PTAB) instituted review on a subset of the challenged claims based on a single ground in each petition. In its final written decisions, the PTAB sustained the patentability of all claims for which review had been instituted. Following an appeal by the petitioner, the Federal Circuit remanded the matter back to the PTAB based on the Supreme Court's intervening decision in *SAS Institute* requiring that the PTAB's final written decision for each instituted IPR address every challenged claim. On remand, the PTAB reconsidered instituting any IPR and terminated the proceedings without issuing a final decision. Petitioner appealed the termination.

The Federal Circuit dismissed the appeal as barred by 35 U.S.C. § 314(d), which establishes that any determination of the PTAB whether to institute an IPR is "final and nonappealable." The Federal Circuit emphasized that the PTAB has discretion not to institute review, even if a petitioner has met the threshold for institution by showing a reasonable likelihood of prevailing on at least one of the challenged claims. The Federal Circuit rejected any requirement that "once instituted, IPRs must proceed through final decisions."

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

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