

International reports

Federal Circuit allows appeal of PTAB time-bar decisions

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On January 8 2018 the US Court of Appeals for the Federal Circuit held *en banc* that Patent Trial and Appeal Board (PTAB) time-bar decisions relating to *inter partes* review petitions can be appealed. The nine-to-four ruling in *Wi-Fi One LLC v Broadcom Corp* overturned previous Federal Circuit decisions which denied such appeals.

By statute, an *inter partes* review petition seeking to review a patent cannot be filed more than one year after the date on which the petitioner, or a company it has a legal relationship with, is served in an infringement lawsuit involving that patent.

Broadcom filed an *inter partes* review petition which sought to review Wi-Fi One's messaging patent more than one year after Wi-Fi One had filed a patent infringement lawsuit against several companies. While Broadcom was not named as a defendant in the lawsuit, Wi-Fi One challenged the *inter partes* review petition on the grounds that Broadcom worked with the defendants, and thus had a legal relationship with them.

In its decision, the PTAB:

- refused discovery on Broadcom's relationship with the defendants;
- granted the petition; and
- invalidated the patent.

A Federal Circuit panel affirmed, holding that the time-bar issue could not be appealed.

The Federal Circuit majority reversed, affirming the "strong presumption in favour of judicial review of agency actions". The court held that "the time-bar is not a technicality... but a substantive limit on [the] PTAB's authority".

The decision is beneficial to patent owners which have raised or will raise the time-bar issue. While the decision did not confirm whether other issues were subject to appeal, it essentially invited *inter partes* review participants to appeal other threshold issues (eg, the identification of all interested parties) that are required when instituting an *inter partes* review or related proceeding.

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