

Supreme Court Reaffirms Non-Appealability of Patent Office Decisions to Review Issued Patents

Any person may challenge the validity of a U.S. patent on the basis that previously issued patents or publications render the patent's claims invalid as being anticipated by the prior art or obvious in view of the prior art, by filing a petition for inter partes review (IPR) in the U.S. Patent and Trademark Office (USPTO). A party sued for patent infringement has one year from the date it is served with the complaint to file a petition for an IPR. The IPR procedure was designed to provide a "quick and effective alternative[] to litigation" to resolve a dispute over the validity of an issued patent. H.R. Rep. No. 112-98 at 48 (2011). Note that the entire IPR proceeding, from initiating petition to final written decision, is designed to last no more than 18 months.

Following the filing of the IPR petition and a response from the patent owner, the USPTO may decide to institute an IPR, but only where the information presented "shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a). By statute, the USPTO's decision to institute an IPR is "final and nonappealable." 35 U.S.C. § 314(d).

In *Thryv, Inc. v. Click-to-Call Tech., LP*, No. 18-916, 2020 U.S. Lexis 2406, *13-14 (April 20, 2020), the U.S. Supreme Court reaffirmed the IPR procedure's goal of providing an efficient mechanism by which to eliminate bad patent claims. In its decision, the Supreme Court held that courts are precluded from hearing claims that the USPTO improperly initiated an IPR over one year after the petitioner was served with a patent infringement complaint, since the USPTO's decision to institute an IPR is "final and nonappealable" under statute. Because the time bar issue is closely related to the decision whether to institute an IPR, these types of claims fall within the statute's prohibition against court review of such decisions by the USPTO.

The Court wrote that its decision is strongly supported by Congress' intent in creating the IPR mechanism, which was designed to address the problem of "overpatenting and its diminishment of competition" by creating a procedure that "weed[s] out bad patent claims efficiently." *Thryv*, 2020 U.S. Lexis 2406 at *14. Allowing appeals challenging the USPTO's decision to institute an IPR based on a time-bar argument would defeat that objective. Besides, the Court reasoned, the same patent claims could be challenged later by another person who is not subject to the one-year bar. *Id.*

Persons seeking a lower-cost, more efficient way to challenge the validity of issued U.S. Patents should be encouraged that the Supreme Court supports the finality of USPTO decisions to initiate IPRs, and that "final and nonappealable" means what it says.

If you have questions about challenging issued patents, please contact [John Jackson](#) or any member of our [Intellectual Property](#) team.

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