Insights: Alerts

Are PTAB Non-Institution Decisions Based on Indefiniteness Defensible post-SAS?

MAY 10, 2018 Written by John C. Alemanni and Michael T. Morlock

The PTAB has declined to institute proceedings on challenged claims on the basis that one or more of the challenged claims is indefinite. *See*, *e.g.*, IPR2015-00662, IPR2013-00036. While this may seem like a positive outcome for a Petitioner, the finding does not have the force of law, and the patent is still valid and enforceable. Further, depending on the timing, the PTAB's finding may not impact a parallel litigation on the challenged patent.

This practice has been criticized, including by Director Iancu in a 2016 article. *Indefiniteness in Inter Partes Review Proceedings*, 98 J. Pat. & Trademark Off. Soc'y 4 (2016). Further, the Supreme Court's recent decision in *SAS* suggests that this practice would not survive scrutiny by the Supreme Court. *SAS* held that the AIA statute requires that the petitioner, not the Board, define the contours of the review. Slip Op. at 2.

Where the PTAB finds that the claims are indefinite and declines to institute, the PTAB is resting on a ground that could not have been raised by the Petitioner, i.e., indefiniteness. *See* 35 USC 311(b). The Supreme Court in *SAS* suggested that such a decision would be reviewable, noting that "[a]s *Cuozzo* recognized, we begin with the strong presumption in favor of judicial review." Slip Op. at 13. The Supreme Court went on to note "that §314(d) does not enable the agency to act outside its statutory limits." *Id*.

Thus, the question of whether the Board may decline to institute based on indefiniteness grounds may be ripe for consideration. Further, given his past commentary, Director Iancu may be amenable to rule changes addressing how the PTAB deals with indefiniteness.

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