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Supreme Court Holds That PTAB's Timeliness Decisions For Instituting Inter Partes Review Are Not Judicially Reviewable

Thryv, Inc. v. Click-To-Call Technologies, LP
No. 18-916

Decided April 20, 2020

Today, the Supreme Court held 7-2 that the Patent Trial and Appeal Board's decision whether a petition for inter partes review is time-barred is not judicially reviewable.

Background:

The Leahy-Smith America Invents Act permits any person who is not the patent owner to petition the Patent Trial and Appeal Board (the "Board") for inter partes review ("IPR") to reexamine claims in an existing patent and cancel any claim the Board finds unpatentable in light of prior art. The Board may institute an IPR if certain conditions are met, including that the petition was not "filed more than 1 year after the date on which the petitioner . . . is served with a complaint alleging infringement." 35 U.S.C. § 315(b). The Board's decision whether to institute an IPR is "final and nonappealable." *Id.* § 314(d).

Click-to-Call owns a patent that was previously the subject of an infringement complaint filed in 2001 against Thryv and later voluntarily dismissed. In 2012, Click-to-Call again sued Thryv for infringing the patent, and Thryv petitioned for IPR less than a year later. Click-to-Call challenged the petition as untimely under § 315(b), but the Board, disagreeing, instituted IPR and issued a final written decision finding several claims unpatentable. Click-to-Call appealed the institution decision to the Federal Circuit, which ruled that § 314(d) does not apply to timeliness determinations and held that the petition for IPR had been untimely.

"The agency's application of § 315(b)'s time limit, we hold, is closely related to its decision whether to institute inter partes review and is therefore rendered nonappealable by § 314(d)."

Justice Ginsburg,
writing for the Court

Issue:
Whether 35 U.S.C. § 314(d) permits judicial review of the Board's determination that a petition for IPR was timely under § 315(b).

Court's Holding:
No. The Board's determination of timeliness under § 315(b) is closely related to its decision whether to institute IPR and is therefore rendered nonappealable by § 314(d).

What It Means:

- The Court reaffirmed the holding of *Cuozzo Speed Technologies, LLC v. Lee*, 136 S. Ct. 2131 (2016), that § 314(d) bars review of questions "closely tied to the application and interpretation of statutes related to" the decision to institute IPR. That category includes § 315(b) timing decisions.
- As in *Cuozzo*, the Court did not establish the outer boundary of § 314(d)'s prohibition against appealability or foreclose the possibility of mandamus review in extraordinary cases. But the Court again disapproved review of Board decisions preceding the issuance of a final written decision.
- Today's ruling extends a series of decisions interpreting the America Invents Act, a statute in which the Court continues to take particular interest (deciding six cases in the last five Terms).

The Court's opinion is available here.

Gibson Dunn's lawyers are available to assist in addressing any questions you may have regarding developments at the Supreme Court. Please feel free to contact the following practice leaders:

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