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FEDERAL CIRCUIT CASES

Denial of Petition for *Inter Partes* Review Is Not Appealable

A Federal Circuit panel has granted a motion to dismiss an appeal from a Patent Trial and Appeal Board (PTAB) order denying institution of an *inter partes* review (IPR) petition. The petitioner in the IPR proceeding had filed a petition that the PTAB determined was time-barred. Upon denial by the PTAB, the petitioner filed an appeal to the Federal Circuit asserting that the court had jurisdiction under 28 U.S.C. § 1295 to review the merits of the PTAB's denial order. In its analysis of the issue, the panel explained that the statute governing IPRs authorizes appeals to the Federal Circuit only "from the final written decision of the [PTAB] under" 35 U.S.C. § 318(a). According to the panel, the statute establishes a two-step procedure for IPRs. First, the PTAB must decide whether to institute the proceeding. And, second, if the proceeding is instituted, the PTAB must then conduct a proceeding and issue a decision with respect to patentability. The panel held that the statute provides for an appeal to the Federal Circuit only of the PTAB's decision at the second step, not the first. The court, therefore, dismissed the appeal.
Author: Rubén H. Muñoz

St. Jude Medical, Cardiology Division v. Volcano Corp., 2014-1183 (Fed. Cir. April 24, 2014) [Prost; O'Malley; Taranto, opinion]

PATENT TRIAL AND APPEAL BOARD

Lack of Threshold Evidence Undermines Request for Additional Discovery in IPR

A PTAB panel has denied a patent owner's (owner) motion to compel additional discovery in an *inter partes* review proceeding. Under the AIA, the statutory standard for permitting additional discovery is "necessary in the interest of justice." In determining whether this standard is met, the Board considers several factors, including whether the discovery request presents more than a mere possibility of finding something useful; seeks discovery of information that is unavailable by other means; and is narrowly tailored and not overly burdensome to answer. See *Garmin Int'l. Inc. v Cuozzo Speed Tech.*, IPR2012-00001, Paper 26 (March 5, 2013). In this case, the owner sought additional discovery relating to secondary considerations of non-obviousness, including long-felt but unmet need, industry praise and copying by others. The Board denied the owner's request, explaining that "[a] motion to compel additional discovery from a party is not an opportunity to enter into a 'fishing expedition' in the hopes that something will emerge that will aid a party's case." In this instance, the Board found that the owner "has not demonstrated that it possesses the requisite threshold evidence or offers reasoning beyond mere allegation that [petitioner] and its employees tried and failed…and necessarily copied or derived an approach that was laid out in [owner's] patent." Furthermore, the Board emphasized that the additional information sought by the owner was already available in published patent documents.
Author: Matthew G. Hartman

ACCO Brands Corp. v. Fellowes, Inc., IPR2013-00566 (PTAB April 18, 2014) [Cocks (opinion), Wood, Rice]