

## Timeliness Determinations for Inter Partes Review Now Subject to Appellate Review

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On January 8, 2018, the *en banc* Federal Circuit, in *Wi-Fi One, LLC v. Broadcom Corp.*, held that a PTAB decision upon institution as to whether a petition for inter partes review is timely under 35 U.S.C. § 315(b) is reviewable on appeal. In doing so, the *en banc* court overruled the Federal Circuit's prior decision in *Achates Reference Publishing, Inc. v. Apple Inc.*, 804 F.3d 652 (Fed. Cir. 2015).

In *Wifi One*, the PTAB determined that IPR petitions filed by Broadcom were not time-barred and instituted review. *Wifi One* argued that the petitions were time-barred because Broadcom was in privity with defendants to a prior infringement action filed by the prior owner of the *Wifi One* patents. The PTAB then conducted a review and issued final written decisions on the merits.

On appeal of the final written decisions on patentability, a panel of the Federal Circuit held that the timeliness determination made at institution was not reviewable on appeal, applying prior Federal Circuit precedent in *Achates*. The panel also held that the intervening Supreme Court decision in *Cuozzo Speed Technologies, LLC v. Lee*, 136 S. Ct. 2131 (2016), which held that the PTAB's substantive reasons for institution were not reviewable on appeal, but which left the door open for appellate review of other determinations, did not implicitly overrule *Achates*, and proceeded to apply *Achates* and denied appellate review.

On review *en banc*, the full Federal Circuit reversed the panel decision, with nine judges siding with the majority and four judges dissenting. Judge Reyna's majority opinion stated that there was no "clear and convincing evidence" of Congressional intent to prohibit appellate review of timeliness determinations. The majority read *Cuozzo* narrowly, applying the appellate review bar only to "determinations closely related to the patentability determination or the exercise of discretion not to institute." Since timeliness determinations were not "closely related" to the patentability determination, the majority determined they did not fall within the ambit of non-reviewable issues under *Cuozzo*.

Judge Hughes' dissent stated that *Cuozzo* dictates that the timeliness determination is not reviewable. Congress enacted a statute that prohibits review of the determination "whether to institute," and does not thereby limit itself to issues of patentability. Timeliness determinations are sufficiently close to the institution determination, and should thus not be reviewable under *Cuozzo*, according to the dissent.

The decision in *WiFi-One* will now provide an opportunity to raise timeliness on appeal, after a final written decision. We should expect a petition for *certiorari* seeking to clarify the scope of *Cuozzo*.

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