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PTAB Need Not Review Every Challenged Claim, Federal Circuit Says

A recent Federal Circuit majority opinion found that the PTAB can exercise its authority under the America Invents Act ("AIA") to institute trial on less than all the challenged claims. (*Synopsis, Inc. v. Mentor Graphics v. Lee*, Fed. Cir., 2014-1516, Feb. 10, 2016). Synopsis had filed a petition for *inter partes* review of claims 1-15 and 20-33 of U.S. Patent No. 6,240,376. The Board instituted review of only claims 1-9, 11, and 28-29, and ultimately issued a final written decision finding against patentability for claims 5, 8, and 9, but in favor of patentability for claims 1-4, 6 7, 11, 28, and 29.

On appeal, Synopsis argued, *inter alia*, that the Board erred in issuing a final decision that did not address the validity of all claims raised in the petition. The PTO intervened as an interested party to defend its interpretation of the AIA. The Federal Circuit disagreed with Synopsis, stating that the AIA gives the PTAB authority to choose whether to institute *inter partes* review on a claim-by-claim basis, as well as to issue its final written decision on only those claims instituted for review.

Judge Pauline Newman dissented, arguing that the PTAB's interpretation of the AIA allowing it to issue final written decisions on less than all of the challenged claims leads to duplicative proceedings in the PTAB and the district courts. Judge Newman argued that "[t]his absence of finality negates the AIA's purpose of providing an alternative and efficient forum for resolving patent validity issues." Instead, she interprets the AIA to require a final written decision for each of the claims challenged.

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