

Public Interest Petitioner Lacks Standing for Appeal from PTO Reexamination Proceeding - Patent and Trademark Office

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Various administrative proceedings are now available through the **U.S. Patent and Trademark Office (PTO)** for members of the public wishing to challenge one or more claims of an issued patent, including adversarial proceedings in which the challenger participates as a party. While those seeking to cancel a patent through such *inter partes* proceedings may ordinarily appeal from a PTO decision upholding the claims, the Federal Circuit held this week that not all such disappointed petitioners are entitled to judicial review.

In [*Consumer Watchdog v. Wisconsin Alumni Research Foundation*](#) (WARF), the court addressed an appeal filed by a consumer advocacy group after an unsuccessful attempt to cancel claims to embryonic stem cell cultures via *inter partes* reexamination. Consumer Watchdog, a “not-for-profit public charity dedicated to providing a voice for taxpayers and consumers in special interest-dominated public discourse, government, and politics,” stated that it had initiated *inter partes* reexamination of WARF’s U.S. Patent 7,029,913 out of concern over the breadth of the ’913 patent and the perceived burden it imposed on taxpayer-funded research within California. When the PTO reaffirmed the challenged claims, Consumer Watchdog filed an appeal before the Federal Circuit as set forth under pre-AIA 35 U.S.C. § 315(b).

Although § 315(b) specified that a petitioner in an *inter partes* reexamination “may appeal . . . any final decision favorable to the patentability” of the challenged claims, the Federal Circuit held it could not entertain Consumer Watchdog’s appeal. The court held that even where a statute provides the right to appeal from an administrative decision, federal courts must observe the constitutional requirement for standing, which requires that the party seeking court action has suffered a concrete, personal harm. In other words, standing requires more than an abstract injury or general grievance. In this case, the court noted that Consumer Watchdog did not identify any injury beyond dissatisfaction with the outcome of reexamination, it does not conduct any research or activities at risk of infringing or in any way associated with the ’913 patent. Nor did Consumer Watchdog have any legal right to a favorable outcome before the PTO. Under those circumstances, the court held that a statutory, procedural right to appeal was insufficient to confer standing, and the appeal was dismissed.

Although *Consumer Watchdog* involved *inter partes* reexamination, a proceeding made obsolete by the AIA, its standing analysis will likely have broader reach. In particular, the post-grant proceedings established by the AIA to supplant *inter partes* reexamination, such as *inter partes* review and post-grant review, include analogous statutory appeal provisions. Accordingly, parties considering (or responding to) such an appeal should not overlook standing as a threshold issue going forward.

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