

Supreme Court to Consider (1) PTAB AIA Claim Construction and Reviewability of Institution Decisions and (2) Attorney Fee Awards in Copyright Cases

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The U. S. Supreme Court granted *certiorari* to review a panel decision of the U.S. Court of Appeals for the Federal Circuit’s decision that the U.S. Patent and Trademark’s Patent Trial and Appeal Board (PTAB or Board) was entitled to perform claim construction in *inter partes* review proceedings using the broadest reasonable interpretation standard. The basic rational of the panel decision was that the PTAB can use the broadest reasonable interpretation standard because the PTO has used that standard in other post-grant proceedings (such as *inter parte* reexamination) for decades. The Supreme Court also agreed to consider the extent to which a PTAB decision to institute an IPR is reviewable in situations where the Board, in its institution decision, does not confine itself to the art and grounds asserted in the IPR petition. *Cuozzo Speed Technologies, LLC v. Lee*, U.S. No. 15-446, cert. granted Jan. 15, 2016.

In a 6-5 decision, the Federal Circuit refused to reconsider the question *en banc*, with Judges Dyk, Lourie, Chen, Wallach, Taranto and Hughes voting against rehearing and Chief Judge Prost and Judges Newman, Moore, O’Malley and Reyna dissenting. In her dissent, Prost wrote that Congress “could not have been clearer” that America Invents Act (AIA) reviews are an alternative to district court litigation and should be subject to the same claim construction standard.

Cuozzo’s *certiorari* petition followed, having the following questions presented:

1. Whether the court of appeals erred in holding that, in IPR proceedings, the Board may construe claims in an issued patent according to their broadest reasonable interpretation rather than their plain and ordinary meaning.
2. Whether the court of appeals erred in holding that, even if the Board exceeds its statutory authority in instituting an IPR proceeding, the Board’s decision whether to institute an IPR proceeding is judicially unreviewable.

The Supreme Court also granted *certiorari* in a case challenging a summary order issued by the U.S. Court of Appeals for the Second Circuit, which found that a district court had the right to deny fees where the plaintiff had pursued an objectively reasonable litigation position in its copyright

infringement suit. *Kirtsaeng v. John Wiley & Sons, Inc.*, U.S. No. 15-374, cert granted Jan. 15, 2016.

Kirtsaeng argued the 2nd Circuit's decision is predicated on whether the losing party's claim or defense was objectively unreasonable, an emphasis not grounded in the Copyright Act's fee provision. In deciding this case, the justices will need to resolve a circuit split on the appropriate standard for awarding attorneys' fees to a prevailing party under § 505 of the Copyright Act. In his petition, Kirtsaeng noted that the precedent of different circuits varied widely on the issue.

The question presented is:

What is the appropriate standard for awarding attorneys' fees to a prevailing party under § 505 of the Copyright Act?

This case last reached the Supreme Court in 2013 when a six-justice majority led by Justice Stephen G. Breyer reversed and remanded the Second Circuit's ruling that the Copyright Act's first-sale doctrine—which says that once a copy is sold the first time, it is out of the copyright owner's control—applies only to goods made in the United States.

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