

Supreme Court to Review Whether PTAB Must Address All Issues Raised in IPR Petition

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Echoing Judge Newman's dissent in the US Court of Appeals for the Federal Circuit's decision in *SAS Institute, Inc. v. ComplementSoft, LLC*, Case Nos. 15-1346; -1347 (Fed. Cir., Nov. 7, 2016) (*per curiam*) (Newman, J, dissenting), the **Supreme Court** of the United States granted *certiorari* to consider the issue of whether the **Patent Trial and Appeal Board (PTAB)** must address all patentability issues raised in a petition for *inter partes* review (IPR). [*SAS Institute Inc. v. Lee*](#), Case No. 16-969 (Supr. Ct., May 22, 2017) (*cert* granted).

Over the objections of the US Patent and Trademark Office, represented by the US Department of Justice (DOJ), the Supreme Court granted SAS Institute's *cert* petition. The DOJ argued that the statute (35 USC § 318(a)) only requires the PTAB, in its final written decision, to address the claims for which review was granted, a practice that follows the congressional intent of the America Invents Act.

The DOJ position follows that of the Federal Circuit in the underlying case, where the Federal Circuit, citing its own decision in *Synopsis*, concluded that the statute only requires the PTAB to address the claims "as to which review was granted." SAS filed a petition for rehearing and thereafter a petition for rehearing *en banc*, both of which were denied *per curiam*.

Issue: Whether 35 USC § 318(a), which provides that the PTAB in an IPR "shall issue a final written decision with respect to the patentability of any patent claim challenged by the petitioner," requires the PTAB to issue a final written decision as to every claim challenged by the petitioner, or whether it allows the PTAB to issue a final written decision with respect to the patentability of only some of the patent claims challenged by the petitioner, as the Federal Circuit held.

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