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**From PTAB to the Federal Circuit:
Strategies in the PTAB to Best Position Your Case for Appeal**

**Debbie McComas
Angela M. Oliver**

Debbie McComas
Haynes Boone
Dallas, TX

debbie.mccomas@haynesboone.com
214.651.5375

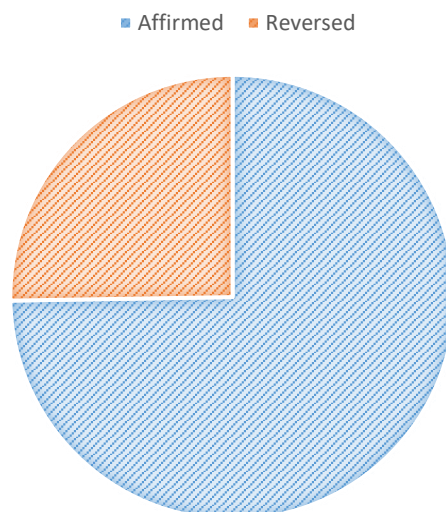
Angela M. Oliver
Haynes Boone
Washington, D.C.

angela.oliver@haynesboone.com
202.654.4552

When considering whether to appeal an adverse ruling from the Patent Trial and Appeal Board, the client's first question is often: "What are my chances of success on appeal?" The answer to this question depends on the type of error identified in the Board's Final Written Decision and how well that issue is preserved. Nonetheless, some general statistics may serve as a helpful starting point in analyzing chances of success on appeal.

The following analysis roughly summarizes the Federal Circuit's decisions in appeals from the PTAB between January 1, 2022, and September 30, 2022 (the "Sample Period").

2022 REVERSAL RATE (IPR AND IPX)



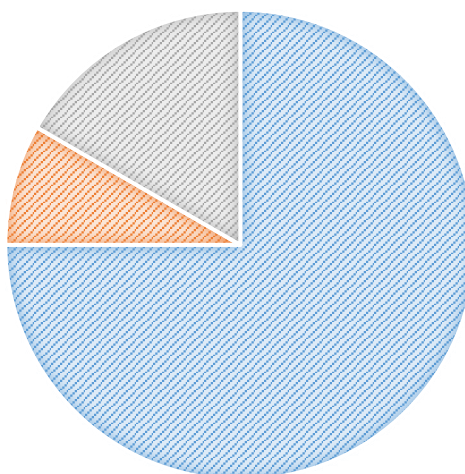
During this nine-month Sample Period, the Federal Circuit issued 99 opinions involving *inter partes* review or reexamination, 74 of which (75%) were affirmed. The Federal Circuit granted affirmative relief to an appellant in only 25 of the 99 cases. In other words, based on this Sample Period, the overall odds of reversing the Board's decision are 1 in 4.

But these general statistics do not tell the whole story. Some types of appellate challenges are stronger than others. For instance, legal errors, such as a misapplication of the law of obviousness or mistakes in claim construction, are more likely to be successful due to the favorable *de novo* standard of review. During the Sample Period, these types of legal challenges were successful about 77% of the time (in 18 out of 22 appeals where the issue was raised). In fact, almost three quarters (18 out of 25, or 72%) of the successful appeals involved pure legal errors in the Board's decision.

Other successful appeals in the Sample Period arose from the Board's failure to adequately support its decision or failure to address arguments raised by the petitioner (2 cases) and basic questions governing the appellate court's jurisdiction, the appellant's standing, mootness of the appeals, or estoppel (4 cases). While challenges to the Board's alleged failure to comply with the Administrative Procedure Act or to otherwise provide adequate due process during *inter partes* review (such as in the allowance of new arguments in reply or the failure to exclude or strike evidence) are frequently asserted on appeal, only once during the Sample Period did the Federal Circuit award relief on this ground. The following chart further depicts this breakdown of grounds for success on appeal.

SUCCESSFUL APPELLATE CHALLENGES

■ Legal Error ■ Inadequate Reasoning ■ Jurisdiction, Standing, Mootness, Estoppel



In contrast to the successful appeal arguments discussed above, by far the most often argued—and least successful—theory on appeal is a challenge to the Board's factual findings, which are reviewed for substantial evidence. These arguments take many forms in appellate briefs, from arguing that the Board should have credited one expert's testimony over that of another, that the Board failed to properly understand a certain prior art reference, or that the Board failed adequately to consider the relevant secondary considerations. But in 20 out of 20 opinions where the appellate arguments were founded on substantial evidence during the Sample Period, the Federal Circuit affirmed the Board's decision.

Notably, none of this analysis takes into account the 41 summary affirmances issued during the Sample Period in which the Federal Circuit simply affirmed without an

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