

PTAB's Minor Variation in Language in Final Written Decision Did Not Amount to Changing Theories in a Manner Inconsistent With the Administrative Procedures Act

AUGUST 22, 2019

Arthrex, Inc. v. Smith & Nephew, Inc., No. 2018-1584 (Fed. Cir. Aug. 21, 2019)

The Federal Circuit affirmed a Patent Trial and Appeal Board (PTAB) *inter partes* review (IPR) decision, finding that the PTAB did not violate the Administrative Procedures Act (APA) when it re-phrased the petitioner's explanation of a motivation to combine the prior art. In its petition, the petitioner described a disclosed method as "well-known" and "accepted." However, in invalidating the asserted claims on grounds that they were obvious over two references and anticipated by a third, the PTAB described the disclosed method as "preferred." The patent owner challenged the decision, arguing that the PTAB's decision characterizing the method as "preferred" constituted an impermissible reliance on a new theory of motivation to combine in violation of the APA, which does not permit the PTAB to change theories without giving patent owners reasonable notice of the change and an opportunity to respond. The Federal Circuit disagreed, explaining that the minor variation in language did not amount to changing theories in a manner inconsistent with the APA or applicable precedent. Specifically, the PTAB did not introduce new issues or theories into the proceeding by using different language than the petitioner in its discussion of motivation to combine.

[A copy of the opinion can be found here.](#)

1 Min Read

Authors

[David Enzminger](#)

[Ivan Poullaos](#)

[Mike Rueckheim](#)

[Danielle Williams](#)

Related Locations

Charlotte

Chicago

Los Angeles

Silicon Valley

Related Topics

Patent Trial and Appeal Board (PTAB)

Inter Partes Review (IPR)

Administrative Procedure Act

Related Capabilities

Intellectual Property

Patent Litigation

Related Regions

North America

Related Professionals



David Enzinger



Ivan Poullaos



Mike Rueckheim



Danielle Williams