
In late 2014, BioDelivery filed three IPR petitions collectively asserting 17 different invalidity grounds against a single patent owned by Aquestive Therapeutics. For each petition, the PTAB partially instituted IPR proceedings based on a single invalidity ground, but ultimately upheld the patentability of all claims. BioDelivery appealed those decisions and the Federal Circuit remanded in view of the Supreme Court’s decision against partial institutions in *SAS Institute v. Iancu* (*IP Update, Vol. 21, No. 5*). On remand, the PTAB vacated its earlier partial institutions and instead denied institution of all three petitions. BioDelivery again appealed and a Federal Circuit panel affirmed by a 2-1 ruling that the denial was a proper implementation of its mandate, which the majority interpreted as an instruction to the PTAB to reconsider its institution decisions (*IP Update, Vol. 22, No. 9*). Judge Newman dissented based on the view that the PTAB had violated its mandate, which she
interpreted as an order to convert the partial institutions to full institutions.

BioDelivery sought rehearing of that decision both at the panel level and *en banc*, which the Federal Circuit has now denied. Judge Newman again wrote in dissent. In Judge Newman’s view, the panel’s affirmance was incorrectly premised on the non-reviewability of IPR institution decisions when it should have held that the institution decision was foreclosed by the remand order. According to Judge Newman, the panel opinion thus ratified a PTAB decision refusing to comply with the Court’s mandate.

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