



Expired Patents Are Not Immune to Challenges at the Patent Trial and Appeal Board

June 6, 2025

Reading Time : **2 min**

By: Matthew George Hartman, Rubén H. Muñoz, Shivani Prakash

In a precedential opinion, the Federal Circuit definitively held that the Patent Trial and Appeal Board has jurisdiction over IPRs that concern expired patents.

The appellant in this case filed an IPR petition against the challenged patent, arguing that the claims were unpatentable as obvious. Notably, at the time appellant filed its IPR, the challenged patent had already expired. Ultimately, the PTAB determined that several of the claims were unpatentable, while others were not unpatentable. Both the patent owner and appellant appealed the PTAB's final written decision.

On appeal, the patent owner argued that because the challenged patent had already expired, the PTAB could not exercise jurisdiction over the IPR. Citing the Supreme Court's decision in *Oil States Energy Services, LLC v. Greene's Energy Group, LLC*, 584 U.S. 325 (2018), patent owner alleged that while the decision to grant a patent is the grant of a public franchise, once a patent expires, the public right ceases to exist. Accordingly, owners of an expired patent only have the right to collect past damages through infringement claims in an Article III court, and therefore only Article III courts have jurisdiction over issues concerning expired patents.

While the Federal Circuit acknowledged that it had never squarely addressed whether the PTAB has jurisdiction over expired patents, it noted that it had previously reviewed IPR decisions involving expired patents and therefore had implicitly held that the PTAB had jurisdiction. However, the court took the opportunity here to explicitly state that the PTAB has jurisdiction over IPRs of expired patents. In reaching that determination, the court first noted that under the public-rights doctrine, Congress can assign matters involving public rights to either the Article III judiciary, or a non-Article III forum such as the PTAB. The court

then reiterated the Supreme Court’s determination in *Oil States* that IPRs fall within the public-rights doctrine. Specifically, the Supreme Court in *Oil States* explained that the grant of a patent inherently involves public rights since rights of immense value are removed from the public and conferred upon the patent holder. And because an IPR is a second look at that grant, it involves the same public rights, namely, the public’s “interest in seeing that patent monopolies are kept within their legitimate scope.”

Next, the Federal Circuit addressed patent owner’s argument that the “public franchise ceases to exist” after a patent expires and determined that it was incompatible with the Supreme Court’s rationale in *Oil States*. Specifically, because an IPR involves a “second look” at an earlier grant of a patent, it inherently involves adjudication of a public right and it is irrelevant whether the patent has expired. Further, the court explained that although patent owners have **fewer** rights once their patents have expired, they still maintain **some** rights, such as the right to bring an action for past damages. Those rights create a live case or controversy, which can then be adjudicated through IPRs and appellate proceedings even where the challenged patent is expired.

Practice Tip: Parties facing potential liability for past damages based on infringement of an expired patent should consider filing an IPR at the PTAB. The Federal Circuit has made clear that the PTAB has jurisdiction over an IPR and can determine patentability of the claims, regardless of whether the patent is expired.

Apple Inc. v. Gesture Tech. Partners, LLC, 127 F.4th 364 (Fed. Cir. 2025)

Categories

Patent Trial & Appeal Board

IPRs

© 2025 Akin Gump Strauss Hauer & Feld LLP. All rights reserved. Attorney advertising. This document is distributed for informational use only; it does not constitute legal advice and should not be used as

such. Prior results do not guarantee a similar outcome. Akin is the practicing name of Akin Gump LLP, a New York limited liability partnership authorized and regulated by the Solicitors Regulation Authority under number 267321. A list of the partners is available for inspection at Eighth Floor, Ten Bishops Square, London E1 6EG. For more information about Akin Gump LLP, Akin Gump Strauss Hauer & Feld LLP and other associated entities under which the Akin Gump network operates worldwide, please see our Legal Notices page.