



Institution of a Subset of the Claims Challenged in an IPR Does Not Thwart Congress' Efficiency Goal

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The DOJ argued, *inter alia*, that the PTAB's decision to institute review on some, but not all, of the claims thwarts Congress' intent that the IPR process be an "efficient system for challenging patents that should not have issued." The DOJ relied heavily on statements from the legislative history of the America Invests Act (AIA), including views from senators who stated that, in order to meet the efficiency goal, IPR proceedings "should generally serve as a complete substitute for at least some phase of the litigation." Because the DOJ would be required to litigate both in district court (for at least Claim 13) and before the PTAB, it argued that Congress' goals were not met.

The PTAB disagreed and stated that it had discretion to institute on fewer than all grounds "for reasons of administrative expediency to ensure timely completion of the instituted proceeding." The PTAB also cited Federal Circuit precedent, stating that the regulations were an exercise of the PTO's rulemaking authority and that its interpretation of the statute was reasonable. In sum, the PTAB held that it had not "overlooked or misapprehended Congress' goal of creating an 'efficient system for challenging patents that should not have issued.'"

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