

***Atlanta Gas Light Co. v. Bennett Regulator Guards*, 33 F.4th 1348 (Fed. Cir. 2022) (Newman (dissenting), Lourie, and Stoll)**

BY JON E. WRIGHT

Atlanta Gas petitioned for inter partes review of Bennett's '029 patent. The Board initially rejected Bennett's argument that Atlanta Gas was time barred from petitioning for inter partes review under 35 U.S.C. § 315(b) and instituted review. The Board then determined that the challenged claims were unpatentable over the prior art. On Bennett's appeal to the Federal Circuit, the court disagreed with the Board's time-bar determination and vacated the Board's unpatentability determination. It then remanded the case for the Board to consider a not-yet-finalized sanctions order against Bennett for failing to disclose real parties in interest. *Bennett Regul. Guards, Inc. v. Atlanta Gas Light Co.*, 905 F.3d 1311, 1314–15 (Fed. Cir. 2018) (*Bennett I*).

Because the Federal Circuit's jurisdiction to hear time-bar determinations was, at that time, under review by the Supreme Court, Atlanta Gas sought a grant, vacatur, and remand (GVR) order from the *Bennett I* decision. While the remanded *Bennett I* case was before the Board, the Supreme Court held that time-bar determinations were unreviewable. See *Thryv, Inc v. Click-To-Call Technologies, LP*, 140 S. Ct. 1367 (2020). The court then granted Atlanta Gas' GVR request, and remanded *Bennett I* to the Federal Circuit for consideration on the merits. The Federal Circuit then proceeded to review and affirm the Board's unpatentability decision. The court again remanded the case to the Board to "further consider" its still-unfinalized sanctions order and to "quantify any [monetary] sanctions" against Bennett. *Bennett Regul. Guards, Inc. v. Atlanta Gas Light Co.*, 825 F. App'x 773 (Fed. Cir. 2020) (*Bennett II*).

On remand from *Bennett II*, the Board vacated both its final written decision and its institution decision and terminated Atlanta Gas' IPR. It did so, in part, due to its changed interpretation of the § 315(b) time bar. The Board also changed its mind on sanctioning Bennett, explaining that its termination "most effec-

The Board may always review its institution decisions, even on remanded IPRs. And when it does, § 314(d)'s no-appeal bar prevents Federal Circuit review.

tively resolve[d] the issues on remand by operating as a sufficient sanction while also conforming [its] Decision to current Office policy." This time, Atlanta Gas appealed, arguing that the Board abused its discretion and violated the court's mandate in *Bennett II* when it changed its mind on sanctioning Bennett. The Federal Circuit dismissed Atlanta Gas's appeal for lack of jurisdiction. (*Bennett III*).

The court first considered whether it had jurisdiction to hear Atlanta Gas's appeal from the Board's decision to vacate both its final written decision and institution decision and terminate the IPR. Atlanta Gas argued that the Board's decision was "a final sanctions decision" and thus reviewable under 35 U.S.C. § 1295(a)(4). Bennett countered that the Board's decision was a termination decision under 35 U.S.C. § 314(d) and thus unreviewable under the Supreme Court's decision in *Thryv*. The Federal Circuit recognized that the Board's decision was "multifaceted" and involved both a sanctions issue and an IPR termination. But the court ultimately determined that the decision vacated an institution decision based on, as the Board put it, "a holistic evaluation of multiple considerations." The court viewed the time-bar issue as "central to" and "at the core of" the Board's decision. The court thus concluded that "the Board's decision was [not] a purely sanctions decision over which we ordinarily would have jurisdiction." The court also determined that "[t]he fact that the Board's termination decision occurred on remand from our court does not change our conclusion that we lack jurisdiction." It recognized the Board's "inherent authority to reconsider its decisions" and explained

that, when the Board chooses to vacate an institution decision, “even on remand, § 314(d)’s no-appeal bar makes clear that it is outside of our jurisdiction to review.”

The court then turned to Atlanta Gas’s argument that the Board violated the court’s mandate in *Bennett II*. Under the court’s mandate rule, “only the issues actually decided—those within the scope of the judgment appealed from, minus those explicitly reserved or remanded by the court—are foreclosed from further consideration.” According to Atlanta Gas, the Board’s termination violated the mandate rule by effectively reversing the court’s unpatentability decision, rendering it “merely advisory.” The court agreed that the unpatentability issues were “locked in on remand,” but it disagreed that the decision foreclosed the Board’s ability to reconsider its time-bar decision. The court acknowledged that “the result here is unusual and would be inappropriate in most cases.” But the Board left untouched the court’s decision on patentability, and, in the absence of any “shenanigans,” the Board’s decision to terminate the IPR remained outside the court’s purview on appeal.



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