

The Federal Circuit recently ruled that Fisher & Paykel Healthcare Limited (“Fisher”) lacked standing to appeal an *inter partes* review (“IPR”) decision that Fisher had instituted against ResMed Limited (“ResMed”), finding Fisher failed to satisfy its burden of asserting future plans which would create “a substantial risk of future infringement” or be likely to “cause the patentee to assert a claim of infringement.”[1]

ResMed owns U.S patent 9,027,556 (“’556 patent”) which covers masks used in the treatment of sleep disordered breathing. After ResMed accused Fisher of infringement, Fisher petitioned the Board for an IPR on the ’556 patent. The Board, in its Final Written Decision, found Fisher failed to establish any of the claims of the ’556 patent were unpatentable. *After Fisher appealed the Board’s Final Written Decision*, the parties settled the underlying infringement suit and ResMed motioned to dismiss Fisher’s appeal based on Fisher’s lack of standing.

On appeal, the Federal Circuit noted that under Article III of the Constitution, a courts judicial power is limited to “Cases” or “Controversies.”[2] The court held that while a party does not need Article III standing to file an IPR petition, an appellant bears the burden of establishing Article III standing to appeal a decision from the Board. Furthermore, Article III standing on appeal from a Final Written Decision requires an appellant, who is not currently facing a suit of infringement or immediate threat of suit for infringement, demonstrate current or planned use of features found in the patent at issue.

Fisher was unable to satisfy its Article III burden. The decision does not address the fact that Fisher appears to have had standing at the time it filed its appeal. Rather, Fisher claimed it was continuing to develop products which might cause ResMed to bring an infringement suit in the future, Fisher did not provide the Federal Circuit with any details on how Fisher’s future products would incorporate features of the ’556 patent to create a substantial risk of future infringement. As such, the Federal Circuit granted ResMed’s motion to dismiss Fisher’s appeal and maintained the Board’s Final Written Decision.

Parties filing IPR petitions should remember while anyone may file an IPR petition, not every party can prove standing to appeal an IPR Final Written Decision. Until the Supreme Court or Congress decides otherwise, petitioners may attempt to satisfy Article III standing on appeal by delaying settlement of its infringement suit, or demonstrating concrete plans to pursue

allegedly infringing conduct.

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