

NOTE: This order is nonprecedential.

**United States Court of Appeals  
for the Federal Circuit**

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**BASF CORPORATION,**  
*Appellant*

v.

**ANDREI IANCU, UNDER SECRETARY OF  
COMMERCE FOR INTELLECTUAL PROPERTY  
AND DIRECTOR OF THE UNITED STATES  
PATENT AND TRADEMARK OFFICE,**  
*Intervenor*

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2017-1425, 2017-1426, 2017-1427, 2017-1428

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Appeals from the United States Patent and Trade-  
mark Office, Patent Trial and Appeal Board in Nos.  
IPR2015-01121, IPR2015-01123, IPR2015-01124,  
IPR2015-01125.

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Before REYNA, LINN, and CHEN, *Circuit Judges*.

PER CURIAM.

**O R D E R**

IT IS ORDERED THAT:

BASF Corporation (“BASF”) appeals the Patent Trial and Appeal Board’s determination, in four inter partes reviews (IPRs), that certain claims of U.S. Patents No.

7,601,662 and 8,404,203 (“662” patent and “203” patent) are unpatentable on certain grounds. For the ’203 patent, the Board instituted review on all challenges to the claims that the petitioner had included in the IPR petitions (IPR2015-01123, -01124). For the ’662 patent, the Board declined to include in the reviews challenges to certain claims that the petitioner had included in the IPR petitions (IPR2015-01121, -01125).<sup>1</sup> In its final written decisions in the IPRs, the Board ruled for the petitioner on the challenges and claims included in the instituted reviews. Both BASF and the petitioner appealed. Early in the appeal process before this court, the petitioner withdrew from the appeals. The Director of the PTO intervened.

The Supreme Court recently held in *SAS Institute Inc. v. Iancu*, 584 U.S. \_\_ (2018), that the statute does not permit a partial institution leading to a partial final written decision. On April 27, 2018, we issued a letter to BASF and the Director asking the parties to address the impact of *SAS* on the disposition of this appeal. On May 3, 2018, this court heard oral argument in this case. Both BASF and the Director have stated that this case should not be affected by *SAS*. Neither party disputed or plans to dispute the claims of the ’662 patent that were included in the petitions but not included in the reviews instituted by the Board. Neither party has requested relief based on *SAS*. The Director has suggested that waiver could apply in this case and that the issue of partial institution was likely waived because it was not raised before the Board

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<sup>1</sup> Umicore challenged the same set of claims (claims 1–24, 30, and 32–50) of the ’662 patent in IPR2015-01123 and IPR2015-01124, citing different prior art references. In IPR2015-01123, the Board denied institution on claims 9–11. In IPR2015-01124, the Board denied institution on claims 3, 4, 7–11, and 39–50.

BASF CORPORATION AS v. IANCU

3

or in this appeal by any party. BASF has also stated that the issue was likely not preserved.

BASF and the Director are directed to file simultaneous supplemental briefs that fully explain the legal basis for their positions. Among the issues to be discussed are (i) whether this court has jurisdiction over these appeals under 28 U.S.C. § 1295(a)(4)(A); and (ii) whether the Board's final written decisions should be deemed ultra vires in light of *SAS* and, if so, what the consequence of such a conclusion would be for what this court may do in these appeals, considering that no party has requested relief based on *SAS*.

Each brief is limited to 3900 words and should be filed no later than May 21, 2018.

FOR THE COURT

May 4, 2018

Date

/s/ Peter R. Marksteiner

Peter R. Marksteiner  
Clerk of Court

NOTE: This order is nonprecedential.

**United States Court of Appeals  
for the Federal Circuit**

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**PGS GEOPHYSICAL AS,**  
*Appellant*

v.

**ANDREI IANCU, UNDER SECRETARY OF  
COMMERCE FOR INTELLECTUAL PROPERTY  
AND DIRECTOR OF THE UNITED STATES  
PATENT AND TRADEMARK OFFICE,**  
*Intervenor*

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2016-2470, 2016-2472, 2016-2474

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Appeals from the United States Patent and Trade-  
mark Office, Patent Trial and Appeal Board in Nos.  
IPR2015-00309, IPR2015-00310, IPR2015-00311.

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Before WALLACH, TARANTO, and STOLL, *Circuit Judges*.

PER CURIAM.

**O R D E R**

PGS Geophysical AS appeals the Patent Trial and Appeal Board's determination, in three inter partes reviews (IPRs), that certain claims of U.S. Patent No. 6,906,981 are unpatentable on certain grounds. When the Board instituted the IPRs as delegate of the Patent and Trademark Office's Director, the Board declined to in-

clude in the reviews certain challenges, including certain claims, that the petitioner had included in the IPR petitions. In its final written decisions in the IPRs, the Board ruled partly for PGS and partly for the petitioner on the challenges and claims included in the instituted reviews.

Both PGS and the petitioner appealed. The petitioner withdrew from the appeals. The Director intervened.

The Supreme Court recently held in *SAS Institute Inc. v. Iancu*, 584 U.S. \_\_ (2018), that the statute does not permit a partial institution leading to a partial final written decision. On April 27, 2018, PGS and the Director filed a joint comment to address the effect of *SAS* on these appeals. They have suggested that this court (a) has jurisdiction to decide, and should decide, the issues raised by PGS in these appeals and (b) should neither remand nor take any other action with respect to the challenges that were included in the petitions but not included in the reviews instituted by the Board.

IT IS ORDERED THAT:

PGS and the Director are directed to file simultaneous supplemental briefs that fully explain the legal basis for their agreed-on position. Among the issues to be discussed are (i) whether this court has jurisdiction over these appeals under 28 U.S.C. § 1295(a)(4)(A) and (ii) whether the Board's final written decisions should be deemed ultra vires in light of *SAS* and, if so, what the consequence of such a conclusion would be for what this court may do in these appeals, considering that no party has requested relief based on *SAS*. Each brief is limited to 3,900 words and should be filed no later than May 21, 2018.

May 4, 2018  
Date

FOR THE COURT  
/s/ Peter R. Marksteiner  
Peter R. Marksteiner  
Clerk of Court

NOTE: This order is nonprecedential.

**United States Court of Appeals  
for the Federal Circuit**

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**PGS GEOPHYSICAL AS,**  
*Appellant*

v.

**ANDREI IANCU, UNDER SECRETARY OF  
COMMERCE FOR INTELLECTUAL PROPERTY  
AND DIRECTOR OF THE UNITED STATES  
PATENT AND TRADEMARK OFFICE,**  
*Intervenor*

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2017-1582

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Appeal from the United States Patent and Trademark Office, Patent Trial and Appeal Board in No. IPR2015-00313.

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Before LOURIE, CLEVINGER, and REYNA, *Circuit Judges*.

PER CURIAM.

**ORDER**

PGS Geophysical AS appeals the Patent Trial and Appeal Board's determination, in an inter partes review (IPR), that certain claims of U.S. Patent No. 6,026,059 are unpatentable on certain grounds. When the Board instituted the IPR as delegate of the Patent and Trademark

Office's Director, the Board declined to include in the reviews certain challenges, including certain claims, that the petitioner had included in the IPR petition. In its final written decision, as modified by its rehearing decision, in the IPR, the Board ruled partly for PGS and partly for the petitioner on the challenges and claims included in the instituted review.

PGS appealed. The petitioner withdrew from the appeal. The Director intervened.

The Supreme Court recently held in *SAS Institute Inc. v. Iancu*, 584 U.S. \_\_ (2018), that the statute does not permit a partial institution leading to a partial final written decision. On April 27, 2018, PGS and the Director filed a joint comment to address the effect of *SAS* on this appeal. They suggested that this court (a) has jurisdiction to decide, and should decide, the issues raised by PGS in this appeal and (b) should neither remand nor take any other action with respect to the challenges that were included in the petition but not included in the review instituted by the Board.

IT IS ORDERED THAT:

PGS and the Director are directed to file simultaneous supplemental briefs that fully explain the legal basis for their agreed-on position. Among the issues to be discussed are (i) whether this court has jurisdiction over this appeal under 28 U.S.C. § 1295(a)(4)(A) and (ii) whether the Board's final written decision should be deemed ultra vires in light of *SAS* and, if so, what the consequence of such a conclusion would be for what this court may do in this appeal, considering that no party has requested relief based on *SAS*. Each brief is limited to 3,900 words and should be filed no later than May 21, 2018.

PGS GEOPHYSICAL AS v. IANCU

3

FOR THE COURT

May 4, 2018

Date

/s/ Peter R. Marksteiner

Peter R. Marksteiner

Clerk of Court