

Practice and Issues Before the PTAB

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The 16th
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UT LAW CLE

TEXAS
The University of Texas at Austin
School of Law

Practice and Issues Before the PTAB



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Discretionary denials of institution

(All slides prepared by Haynes and Boone, LLP; some incorporate public USPTO materials.)

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Discretionary Denials

Discretionary denials versus getting to the merits.

- *Fintiv*: deny review because of jury trial
- *Valve* and *General Plastic*: deny review because of earlier petitions

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Fintiv “discretionary denial” factors

(*Apple Inc. v. Fintiv, Inc.*, IPR 2020-00019, Mar. 20, 2020)

- *District court stay*
- *District court trial date*
- *“Investment” in district court proceeding*
- *Overlap of issues*
- *Same party*
- *Merits*

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The “Albright doctrine”

“It’s my job to give people the opportunity to have their cases tried in a federal court ... and I probably can get a patent trial resolved more quickly than the PTAB can.”

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