

UT Advanced Patent Law Institute

Practice Before the PTAB, Part I: Changes to the Director Review Procedures and Discretionary Denial Practice

Michael Tierney, Vice Chief Administrative Patent Judge
Amanda Wieker, Acting Senior Lead Administrative Patent Judge

March 23, 2023



**Interim procedure for discretionary denials
in AIA proceedings with parallel district
court litigation**

Discretionary denials in AIA cases based on parallel litigation - background

- *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019 (PTAB March 20, 2020) (Paper 11) (Precedential)
 - Designated precedential on May 5, 2020
- Order discussed factors that should be considered for institution
- Designed to reduce system costs and inefficiencies and avoid harassment by preventing unnecessary repetitious proceedings, taking into account parallel proceedings in both PTAB and district court



3

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Fintiv factors

1. whether the **court** granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. ***proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;***
3. investment in the parallel proceeding by the **court** and the parties;
4. ***overlap between issues raised in the petition and in the parallel proceeding;***
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. ***other circumstances that impact the Board's exercise of discretion, including the merits.***



4

4

Interim guidance for denials under *Fintiv*

- Director Vidal issued interim guidance on June 21, 2022
 - https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621.pdf
- The interim guidance:
 - is based on the comments received from stakeholders, including individuals
 - reflects the Director's consideration of feedback received from all forums, e.g., Congress, academics, small and individual inventors
 - solidifies and provides further clarifications regarding current practices
 - makes clear how some of the factors will be applied so that parties have certainty and avoid wasting resources



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Interim guidance for denials under *Fintiv*

- The interim guidance addresses:
 - Applicability of *Fintiv* factors 1-6 to ITC proceedings
 - *Fintiv* factor 4: *Sotera* stipulation
 - *Fintiv* factor 6: compelling merits
 - *Fintiv* factor 2: trial date
- The interim guidance became effective on June 21, 2022
- The Office is exploring potential rulemaking on proposed approaches through an Advanced Notice of Proposed Rulemaking



6

6

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First appeared as part of the conference materials for the
18th Annual Advanced Patent Law Institute session

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