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

uspto

UNITED STATES PATENT AND TRADEMARK OFFICE ®

1

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

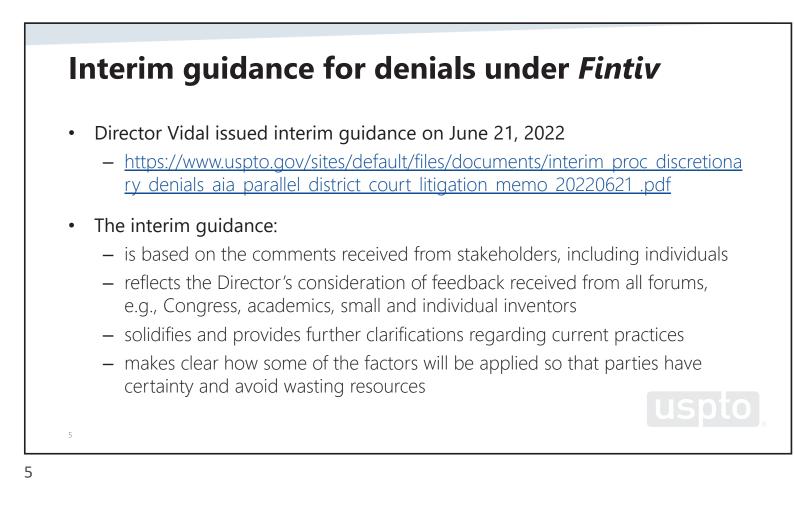
Fintiv factors

3

3

- 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



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

Find the full text of this and thousands of other resources from leading experts in dozens of legal practice areas in the <u>UT Law CLE eLibrary (utcle.org/elibrary)</u>

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

Also available as part of the eCourse <u>PTAB Practice and Issues (2023)</u>

First appeared as part of the conference materials for the 18th Annual Advanced Patent Law Institute session "Practice Before the PTAB, Part I: Changes to the Director Review Procedures and Discretionary Denial Practice"