

## Joe Matal in World IP Review: 'NHK-Fintiv: As PTAB Denials Mount, Petitioners Seek a Remedy'

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March 23, 2021

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PRACTICES Intellectual Property, Patent Office Trials

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Haynes Boone Partner Joe Matal talked with *World IP Review* about how the Patent Trial and Appeal Board (PTAB) has declined to review patents, citing the “NHK-Fintiv” rule.

Here is an excerpt:

Established under former U.S. Patent and Trademark Office director Andrei Iancu, the NHK-Fintiv rule emerged from *NHK Spring v. Intri-Plex* (2018) in which the PTAB held that the existence of a parallel district court lawsuit should preclude an *inter partes* review.

In May 2020, *Apple v. Fintiv* outlined six scenarios for PTAB to consider before instituting a review, including the trial date in the parallel case, whether the court has stalled its case for the PTAB review, and any overlap between the issues in both proceedings.

Joseph Matal, partner at Haynes Boone, argued that jury trials are not an adequate substitute for PTAB reviews, pointing to the decision in *VLSI v. Intel* (2020).

Earlier this month Intel was hit with a \$2.18 billion damages verdict after a federal jury in Texas ruled that the chipmaker had infringed two patents owned by VLSI Technology. The PTAB had declined to review the patents, citing the “NHK-Fintiv” rule.

“That case upheld a manifestly weak patent to impose a \$2 billion damages award against the nation’s premier chip manufacturer. If we want businesses to continue to invest in making advanced products in the U.S., we need to provide them with reliable access to expert review at the PTAB,” said Matal.

He added that it is hard to reconcile this rule with the decisions handed down by Federal Circuit in cases such as *Facebook v. Windy City* (2020) and *Aqua Products v. Matal* (2017), which hold that the USPTO cannot make policy through PTAB adjudications.

“If the agency cannot even assign the burden of proof for amendments in this way, how can it impose the extra-statutory restrictions of Fintiv without at least going through notice-and-comment rulemaking?” queried Matal.

To read the full article, click [here](#).