

David McCombs, Eugene Goryunov, and Jonathan Bowser in Reuters on Fintiv Challenge in Patent Litigation

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PRACTICES Patent Litigation

Post-grant validity challenges — *inter partes* review (IPR) and post-grant review (PGR) — at the Patent Trial and Appeal Board (PTAB) are frequent components of patent litigation disputes. As part of a defense strategy, district court patent infringement defendants often file IPRs or PGRs challenging the validity of the asserted patent(s).

The PTAB has broad discretion whether to institute an IPR or PGR and may deny institution for reasons other than the merits. For example, in recent years the PTAB has increasingly been using its discretion to deny institution when a district court will decide validity issues before the PTAB would. This development has become controversial, in part, because the PTAB has denied petitions based on the speed of the forum where the patent owner chose to bring its infringement action, a new consideration in forum selection.

This timing-based discretion came out of the PTAB's March 2020 precedential order in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (Mar. 20, 2020). There, the PTAB set out six non-exhaustive factors that the PTAB considers when deciding whether to exercise its discretion to institute an IPR or PGR if the challenged patent is asserted in a co-pending district court litigation.

These factors seek to balance considerations of efficiency and fairness based on the advanced state of a co-pending proceeding. Two of the most impactful factors have proven to be (1) the proximity of the district court trial date to the PTAB's projected statutory deadline for issuing a final written decision, and (2) the degree of overlap between the issues raised in the IPR or PGR as compared to the issues involved in the co-pending case.

Excerpted from *Reuters*. To read the full article, click [here](#).