

David McCombs, Eugene Goryunov, Jonathan Bowser in Thomson Reuters Westlaw: ‘IPR Tricks of the Trade: Director Vidal Implements Changes to Discretionary Institution Policies at PTAB’

September 14, 2022 David McCombs, Jonathan Bowser

PRACTICES Intellectual Property, Patents, Patent Litigation, Patent Office Trials, Intellectual Property Litigation

Haynes Boone Partners [David McCombs](#) and Eugene Goryunov and Counsel [Jonathan Bowser](#) authored another installment of IPR Tricks of the Trade in *Thomson Reuters Westlaw*. Read an excerpt below:

Kathi Vidal has implemented significant policy changes for the Patent Trial and Appeal Board (PTAB) since becoming Director of the U.S. Patent and Trademark Office approximately four months ago. One of those changes included a clarification of the circumstances in which the PTAB may exercise its discretion to deny institution of a petition for *inter partes* review (IPR) or post-grant review (PGR) of a patent that is involved in parallel litigation in U.S. federal district court or the International Trade Commission (ITC).

In May 2020, the PTAB designated precedential *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (Fintiv), which sets forth several factors PTAB judges consider when deciding to exercise discretion to deny institution of a petition if the challenged patent is involved in parallel litigation. The factors include, for example, whether the trial date in the parallel litigation would occur before the PTAB would issue a final written decision, and the amount of overlap in invalidity issues between the petition and the invalidity grounds raised in the parallel litigation.

The PTAB's Fintiv policies have been controversial and have led to several legal challenges by parties that file petitions. One argument against *Fintiv* is that the PTAB may deny institution of a petition based on an earlier scheduled trial date in a parallel proceeding, but that trial date may be rescheduled to occur after the PTAB would have issued a final written decision.

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