

Joseph Matal in Law360: 'Mapping the Contours of PTAB Discretionary Denials in 2020'

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PRACTICES Intellectual Property, Patents, Patent Office Trials

Over the course of 2020, application of the new policy of using discretion to reject petitions for *inter partes* and post-grant review has exploded at the U.S. Patent and Trademark Office

The multifactor tests announced in *Apple Inc. v. Fintiv Inc.* and *Valve Corp. v. Electronic Scripting Products Inc.* have become a major source of denials of Patent Trial and Appeal Board review. This article maps the contours and evolution of these policies, highlighting recent developments of which PTAB practitioners need to be aware.

In particular, these new policies have become more restrictive over the last few months. Discretionary denials now create significant blackout zones in which it will not be possible for a litigation defendant to use PTAB review. Defendants who are sued in districts that schedule early trials, who are sued in the later stages of a plaintiff's enforcement campaign, or who are the subject of U.S. International Trade Commission or Hatch-Waxman proceedings are unlikely to be able to secure validity review of patents at the PTAB.

Although the *Fintiv* decision articulates six factors that govern its version of discretionary denial, in practice the most important factor is whether a district court has scheduled trial for a date before the PTAB would issue a final written decision. In *Fintiv* itself, IPR was denied on account of a trial that was set to occur two months before the end of PTAB review. Recent cases confirm that three months' advance is enough to bar review, although a mere one-month advance has been deemed a neutral factor.

The *Fintiv* decision hinted that a petitioner's diligence in seeking review, such as by filing a petition promptly after the patent owner identifies its asserted claims and responds to invalidity contentions, would favor review. As the policy has evolved, however, such diligence has proven insufficient to overcome an early trial date.

Excerpted from *Law360*. To read the full article, click [here](#). (Subscription required)