



A Conversation with PTAB Judges on Recent Developments, Trends, and What to Expect from the PTAB Moving Forward

September 19, 2024



FINNEGAN

Your Presenters

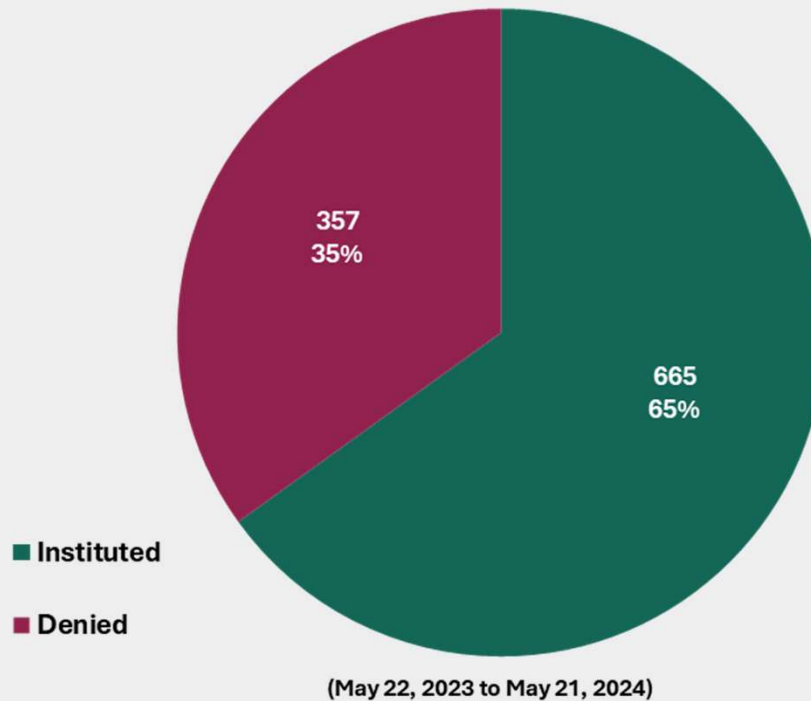
Vice Chief Judge Michael Tierney, Patent Trial and Appeal Board
U.S. Patent and Trademark Office

Acting Senior Lead Judge James Worth, Patent Trial and Appeal Board
U.S. Patent and Trademark Office

Arpita Bhattacharyya, Ph.D., Managing Partner, Palo Alto
Finnegan

Institution Overview

Total decisions: 1,022



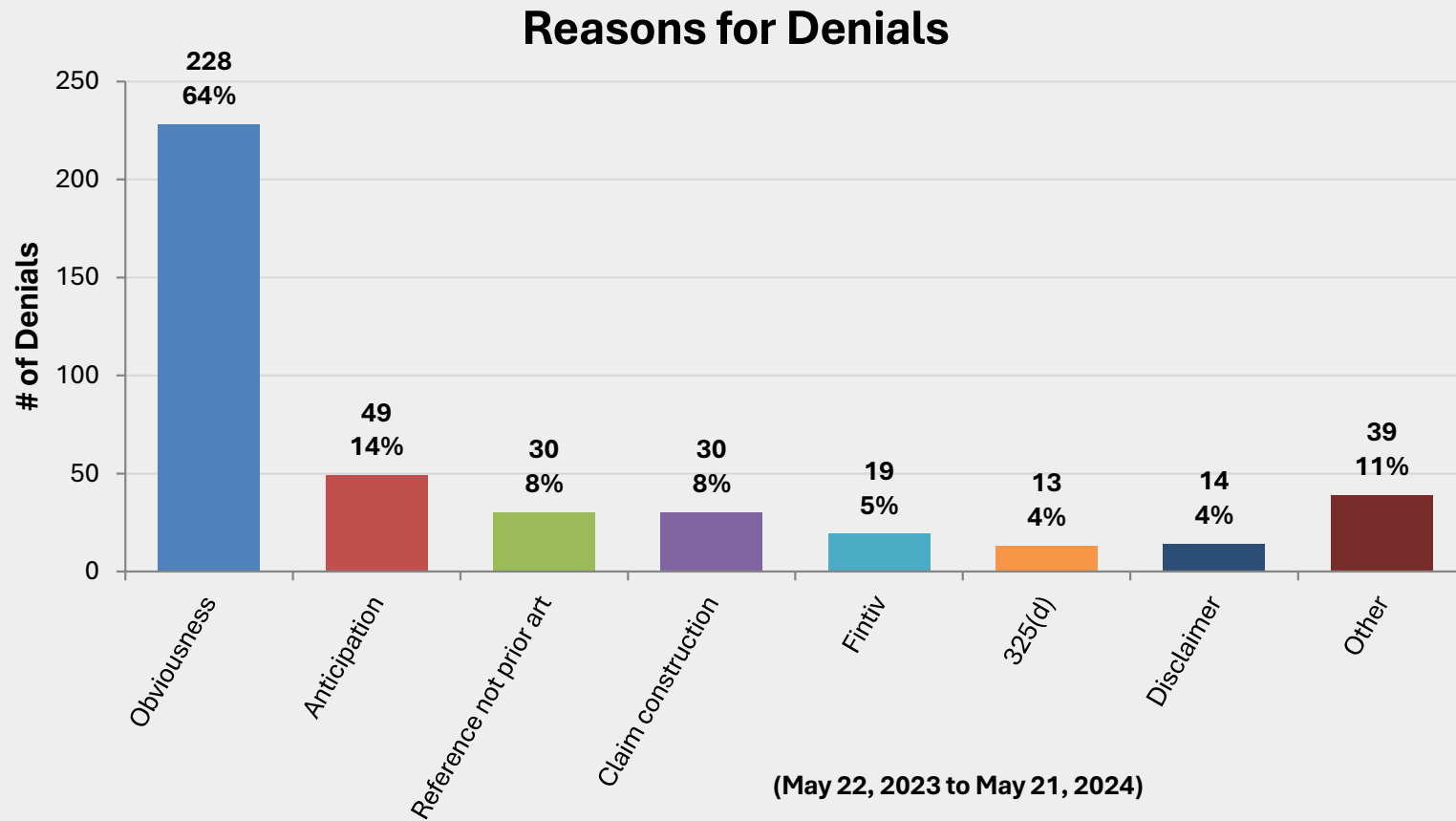
(May 22, 2023 to May 21, 2024)

Reasons for Denials

Categories of denials for institution decisions:

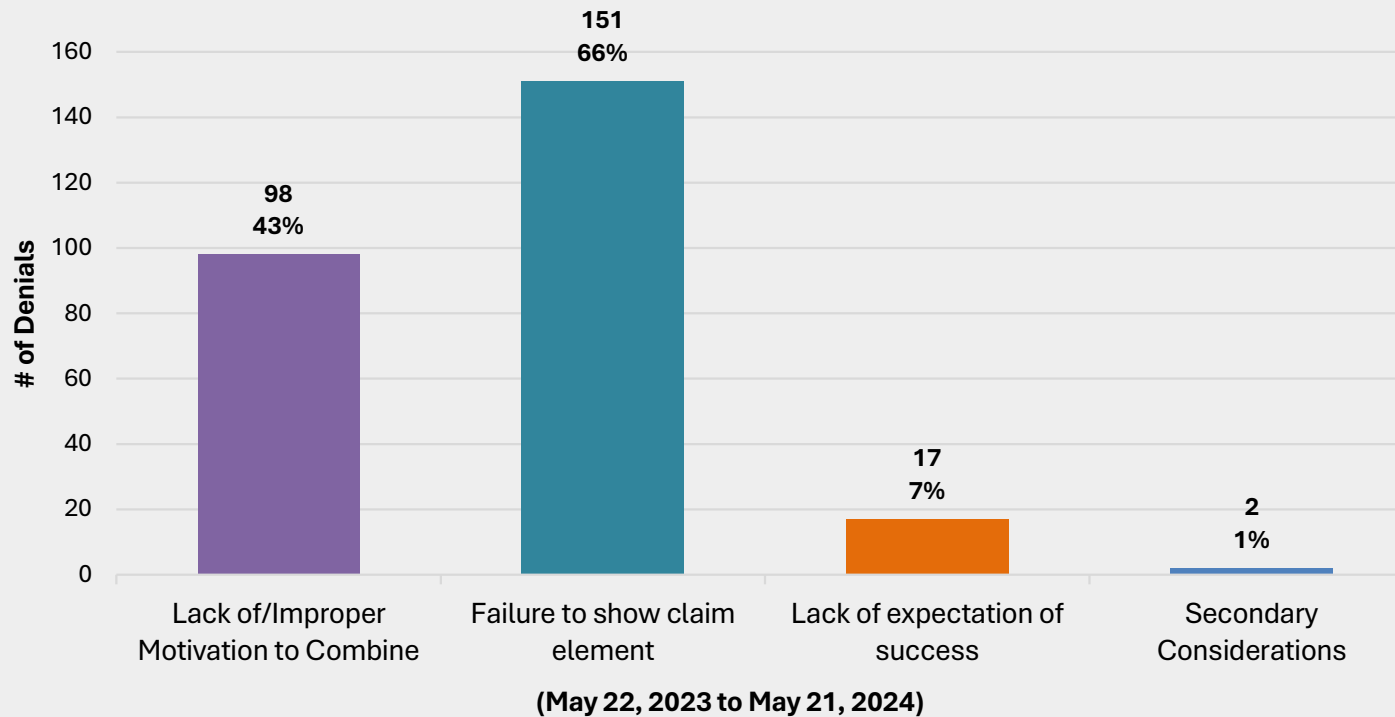
- Obviousness: Failure to establish claimed subject matter was obvious
- Anticipation: Failure to show an element disclosed by single reference
- Claim construction: Construction of claim term was dispositive
- Reference not prior art: Failure to show reference qualified as prior art under Section 102
- Fintiv: Discretionary denial based on parallel litigation
- 325(d): Same or substantially similar prior art or arguments previously considered
- Disclaimer: Patent owner disclaimed the challenged claims
- Other: Reasons not encompassed by preceding categories (e.g., serial petitions)

Reasons for Denials (Contd.)



Data sourced from Docket Navigator and reviewed manually by Finnegan

Obviousness Denials



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Fintiv Stipulations

Used by petitioners to mitigate the possibility of discretionary denial when there is parallel district court litigation

- *Sand Revolution* Stipulation: If review is instituted, petitioner will not pursue **the same instituted grounds** in the parallel proceeding
- *Sotera* Stipulation: If review is instituted, petitioner will not pursue any grounds **raised in the petition or that could have reasonably been raised** in the instituted petition, in the parallel proceeding
- Intermediate Stipulation: Between *Sand Revolution* and *Sotera* stipulations
 - For example, petitioner agrees not to pursue the same primary references asserted in the petition in the parallel litigation

Notice of Proposed Rulemaking (NPRM)

Released April 19, 2024

Proposes modifications to the IPR and PGR rules for:

- Briefing discretionary denial issues,
- Section 325(d) considerations,
- Instituting parallel and serial petitions, and
- Terminating proceedings after a settlement agreement.

Director Review

- The U.S. Supreme Court's 2021 decision in *U.S. v. Arthrex* held that the Director of the USPTO has the authority to review PTAB decisions
- The USPTO has developed a process for the Director to review PTAB decisions involving:
 - An abuse of discretion
 - Important issues of law or policy
 - Erroneous findings of material fact, and/or
 - Erroneous conclusions of law
- Director review may take place *sua sponte*, or granted in response to a party's request

Questions?

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