



Director Vidal's Lasting Mark on the PTAB: How It Impacts Your Overall Litigation Strategy

October 12, 2023

Your Presenters

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

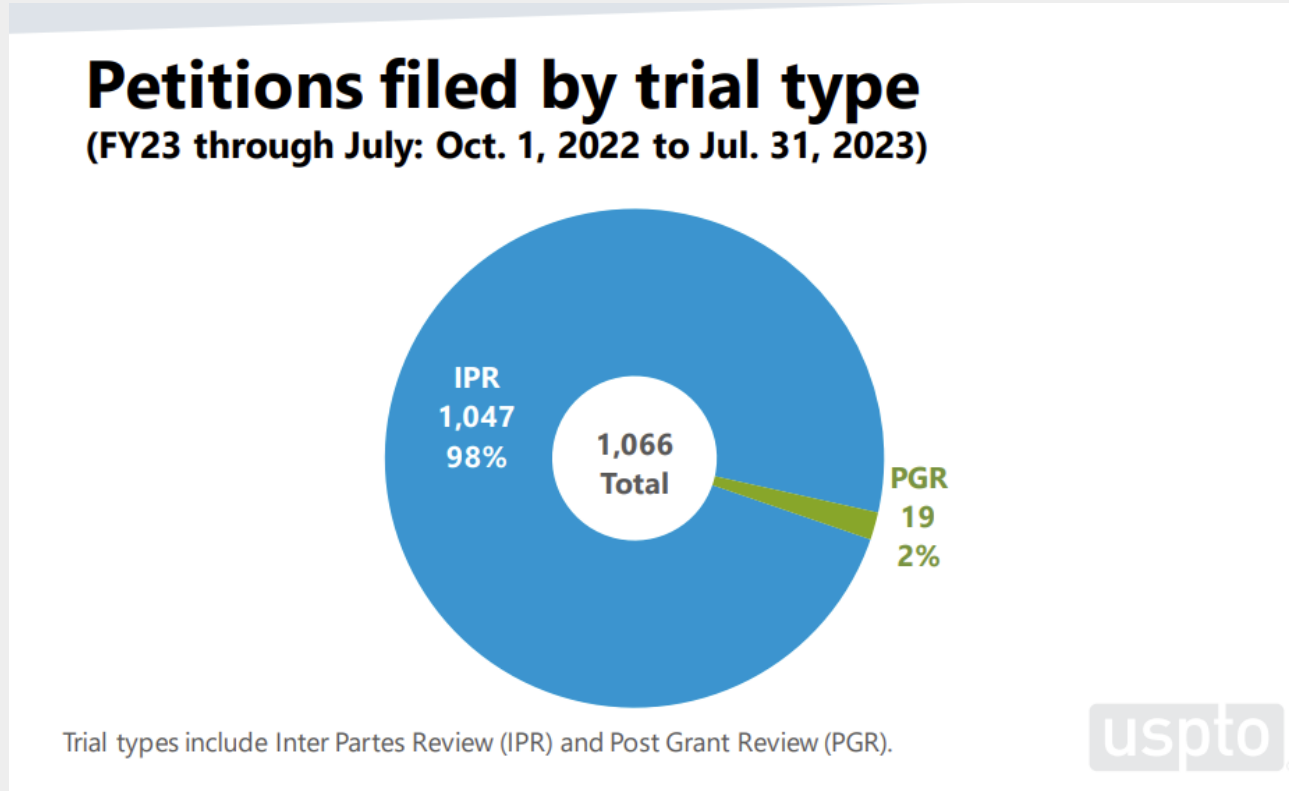
Ashok Pinto, Director, IP Policy Group
Intel

Shawna Yashar, Director of Global IP Litigation
Lenovo

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Finnegan

PTAB Trial Statistics

IPR vs. PGR

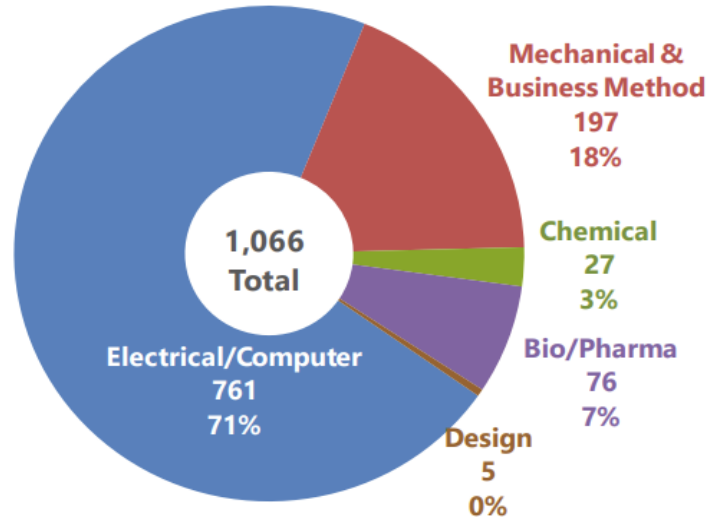


PTAB Trial Statistics

Petitions by technology

Petitions filed by technology

(FY23 through July: Oct. 1, 2022 to Jul. 31, 2023)

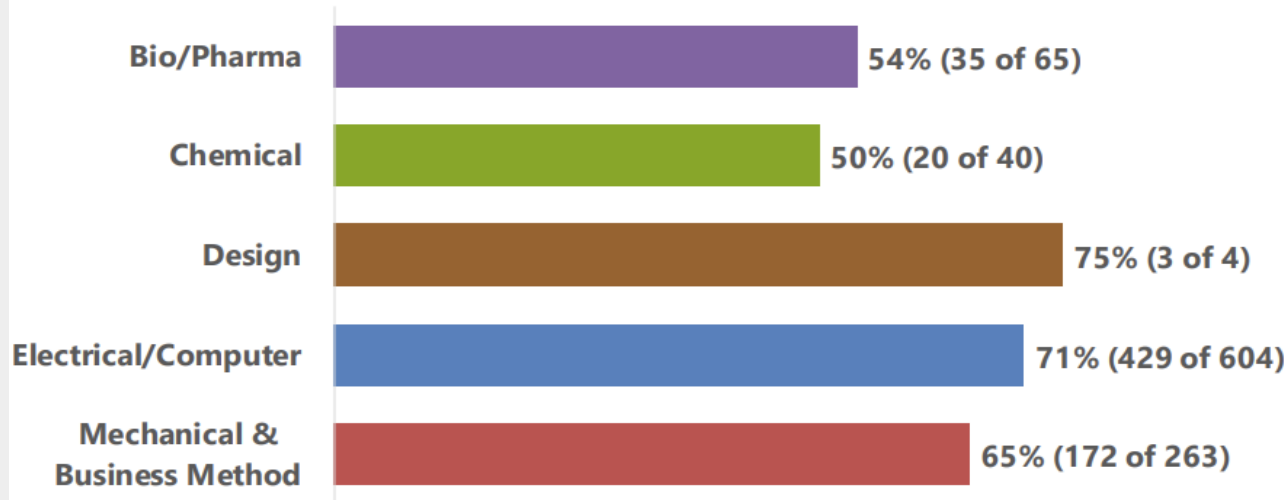


PTAB Trial Statistics

Institution rates by technology

Institution rates by technology

(FY23 through July: Oct. 1, 2022 to Jul. 31, 2023)



Institution rate for each technology is calculated by dividing petitions instituted by decisions on institution (i.e., petitions instituted plus petitions denied). The outcomes of decisions on institution responsive to requests for rehearing are excluded.



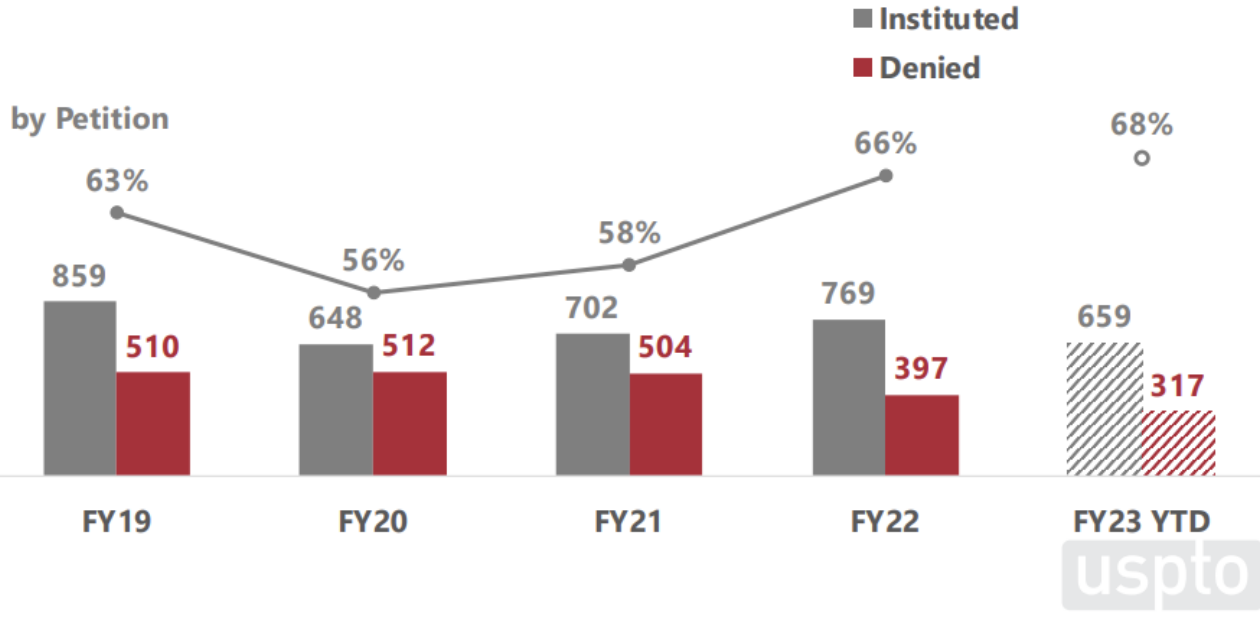
https://www.uspto.gov/sites/default/files/documents/ptab_aia_20230731_.pdf

PTAB Trial Statistics

Institution rate

Institution rates by petition

(FY19 to FY23 through July: Oct. 1, 2018 to Jul. 31, 2023)



https://www.uspto.gov/sites/default/files/documents/ptab_aia_20230731_.pdf

FINNEGAN

Fintiv Interim Guidance

- June 21, 2022: Director Vidal issued “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation”
- Under Interim Guidance, PTAB will not deny institution when:
 1. Petitioner stipulates not to pursue in district court the same grounds or any grounds that could have reasonably been raised in the petition (i.e., *Sotera* stipulation; *Fintiv* Factor 4);
 2. Petitioner presents compelling merits of unpatentability (*Fintiv* Factor 6);
or
 3. A request for denial is based on a parallel ITC proceeding
- Proximity to trial (*Fintiv* Factor 2) assessed based on most recent statistics for median time-to-trial in the district court, not scheduled trial date

Types of *Fintiv* Stipulations

Sotera: petitioner agrees not to pursue **any ground raised or that could have been reasonably raised** in an IPR

- *Sotera Wireless, Inc. v. Masimo Corporation*, IPR2020-01019, Paper 12 at 13-14 (PTAB Dec. 1, 2020)
- Tracks estoppel that attaches after FWD
- Interim Guidance: PTAB will not exercise discretion to deny institution

Sand Revolution: petitioner agrees not to pursue the **same grounds** in district court as in IPR

- *Sand Revolution II, LLC v. Cont'l Intermodal Group-Trucking LLC*, IPR2019-01393, Paper 24 at 12 (PTAB June 16, 2020)

Intermediate stipulations: *E.g.*, Petitioner agrees not to pursue the **same grounds as in IPR** and any invalidity grounds including **any of the same references as in the petition**

Advance Notice of Proposed Rulemaking (ANPRM)

ANPRM areas

- Discretionary Denials
 - Non-market entities, under-resourced patent owners, claims previously held valid, RPI+, limiting Section 325(d)
- Discretionary Denials Based on Parallel Litigation
 - Clear, predictable rules
 - Streamlined *Fintiv* factors
 - Safe harbors
- Separate Briefing and Page/Word Limitations
- Settlement Agreements

Advance Notice of Proposed Rulemaking (ANPRM)

Discretionary denials based on parallel litigation

Where discretionary denial is available, the Office is considering two alternatives for applying that discretion:

- First: Discretionary denial is governed solely by a clear, predictable rule
 - Time to trial, or early filing of petition
- Second: Discretionary denial determinations will consider a streamlined version of the *Fintiv* factors
 - Past/future investment by court and parties; degree of overlap; other circumstances
- Under either, the safe harbor exceptions to denial would exist
 - Stipulation (Sotera)
 - District court stay
 - Compelling merits

PREVAIL Act

Proposed reform to PTAB rules and procedures

- Require standing in IPRs
- Remove joinder for time-barred parties
- Apply estoppel as soon as petition is filed
- Require PTAB to apply clear and convincing evidence standard
- Require challengers to pick between PTAB and district court
- Limit multiple petitions against the same patent
- Separating institution judges from trial judges
- Miscellaneous other changes

Questions?

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