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# *The Rising Tide of Discretionary Denial at the Patent Trial and Appeal Board*

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## **Introduction**

In the time since the America Invents Act (AIA) created the Patent Trial and Appeal Board (PTAB), *inter partes* review (IPR) and other PTAB proceedings for challenging patents' validity have proven to be powerful tools for those accused of infringement. But increasingly, the PTAB's exercise of its discretion to deny institution of review for non-merits-based reasons has become a powerful counter-defense for patent owners. Although discretionary denial has been a feature of PTAB proceedings since their inception, the range of circumstances in which the PTAB discretionarily denies institution and the frequency with which it does so are increasing. Discretionary denial has thus become a disputed issue in an increasingly large proportion of PTAB proceedings.

Among the PTAB's rationales for discretionarily denying a petition are the goals of protecting "the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings."<sup>1</sup> Until recently, the PTAB had other means to accomplish those goals—including its frequent practice of partially instituting review on only a subset of challenges in a petition that the PTAB found merited review, and denying the rest as lacking merit or being redundant over the instituted issues.

The PTAB, however, lost the ability to partially institute trials with the Supreme Court's decision in *SAS Institute Inc. v. Iancu*.<sup>2</sup> *SAS* held that once the PTAB institutes a trial, it must address all challenged claims.<sup>3</sup> Subsequent decisions from the Federal Circuit confirmed that an instituted trial must address all claims on all grounds presented in the petition.<sup>4</sup> As a consequence, the PTAB can no longer partially institute an AIA trial.

The loss of partial institution has coincided with an increase in the PTAB's use of discretionary denial. In the time since *SAS*, the PTAB has discretionarily denied 10% of petitions, up from 4% of petitions in the four and a half years that the PTAB existed before *SAS*.<sup>5</sup>

With the increased use of discretionary denial has come an increased focus on the PTAB's standards for determining when discretionary denial will occur. Unlike other PTAB practices that are set by statute or regulation, discretionary denial is largely a product of the PTAB's case decisions and informal guidance, such as the Trial Practice Guide.<sup>6</sup> The PTAB has designated some of its decisions concerning discretionary denial "precedential," setting the standards that PTAB judges must apply.<sup>7</sup> But like a common-law court, the PTAB has also revisited some of those standards with subsequent precedential decisions that refine the prior tests.

More than ever before, parties before the PTAB must consider and account for the possibility of discretionary denial. Petitioners should seek to understand and, where possible, proactively avoid situations that could lead to petitions being discretionarily denied institution. Patent owners would do well to recognize when discretionary denial may be a path to avoiding institution altogether. With rates of discretionary denial on the rise, the

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potential risks to petitioners and benefits to patent owners are too high to overlook.

This article investigates where the PTAB's practice on discretionary denial currently stands and provides practice pointers and tips along the way.

## The PTAB's Authority to Discretionarily Deny Institution

The PTAB's authority for discretionary denial flows from two statutory provisions.

First, Section 314(a) states that an IPR "may not" be instituted "unless" the petition shows "a reasonable likelihood" of prevailing on at least one challenged claim.<sup>8</sup> Because Section 314(a) "does not specify any particular circumstance in which review *must* be authorized," it has been interpreted as implicitly affording the PTAB discretion to decline to institute IPR even on petitions meeting the "reasonable likelihood" requirement.<sup>9</sup>

Second, Section 325(d) permits the PTAB to "take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office."<sup>10</sup> Before *SAS*, Section 325(d) accounted for about two-thirds of the PTAB's discretionary denials, while Section 314(a) accounted for the other third. Since *SAS*, those proportions have reversed, with the PTAB's exercise of Section 314(a) denials approximately doubling those under Section 325(d).<sup>11</sup>

The Supreme Court has observed that the "decision to deny a petition is a matter committed to the Patent Office's discretion" because there is "no mandate to institute review" in Section 314(a).<sup>12</sup> Likewise, the Federal Circuit has agreed that "the PTO is permitted, but never compelled, to institute an IPR proceeding."<sup>13</sup> But while the PTAB's discretion to deny institution is widely accepted, it remains to be seen whether the courts might articulate some limits on what constitutes a proper exercise of that discretion. Due in large part to Section 314(d)'s bar against appealing institution decisions, the question of whether a particular exercise of discretionary denial was proper has not yet been squarely presented on appeal.<sup>14</sup>

A group of petitioners, however, have recently filed a district court lawsuit under the Administrative Procedures Act challenging the PTAB's exercise of discretionary denial in the context of parallel litigation.<sup>15</sup> Thus, parties should keep in mind that the courts may yet constrain PTAB's rationales for discretionary denial, and indeed, parties should consider whether to seek that review.<sup>16</sup> There, however, may come a time

when a petitioner concerned by a specific rationale for discretionary denial might seek review of the PTAB's decision. The Supreme Court left open the possibility of review in some cases.<sup>17</sup> Whether a discretionary denial decision would qualify for such review has not yet been made clear. Thus, parties should keep in mind that the PTAB's rationales for discretionary denial may yet be tested in court, and indeed, parties should consider whether to seek that review, such as via an appeal or a writ of mandamus.

Pending possible guidance from the courts, parties need to be aware of the evolving rationales that the PTAB applies now, which can and do form the basis for discretionary denial of institution in many cases before the PTAB.

## The PTAB's Current Rationales for Discretionary Denial

### Parallel Litigation

An increased focus at the PTAB on the status of parallel litigation (*e.g.*, in district court) as a basis for discretionary denial of IPR institution has emerged recently as an issue of intense interest for practitioners. Given that a large proportion of patents challenged at the PTAB have also been asserted in litigation, this rationale for discretionary denial has the potential to affect most PTAB proceedings. Indeed, being sued for infringement is often the impetus for the petitioner to seek PTAB review of the patent, so the notion that the litigation's existence could be a reason to deny institution has the potential to force parties to reevaluate their strategies.

The PTAB's precedent for discretionary denial based on parallel litigation began with *NHK Spring Co. v. Intri-Plex Technologies, Inc.*<sup>18</sup> The PTAB's reasoning for discretionary denial in *NHK* largely focused on Section 325(d), finding the petition's challenges too similar to the issues raised during prosecution to warrant institution.<sup>19</sup> The PTAB, however, also added that the "advanced state" of the parallel district court proceeding was an "additional factor" favoring discretionary denial for reasons of efficiency under Section 314(a), since the district court was set to consider the same prior art and arguments in a trial scheduled for six months before the PTAB's final written decision (FWD) deadline in the IPR.<sup>20</sup>

After *NHK*, the PTAB clarified its standards for assessing whether to discretionarily deny institution based on parallel litigation. In *Apple Inc. v. Fintiv, Inc.*, the PTAB identified six non-exclusive factors which assess "whether efficiency, fairness, and the merits support the exercise of

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authority to deny institution in view of an earlier trial date in the parallel proceeding”:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board’s exercise of discretion, including the merits.<sup>21</sup>

*Fintiv* clarified that although Congress allowed for an IPR petition to be filed up to one year from when the petitioner was served with an infringement complaint, taking that long to file may subject the petition to discretionary denial if, for example, the district court has invested significant time and work in resolving issues overlapping with the IPR and will be going to trial earlier than the IPR’s projected FWD deadline.<sup>22</sup>

Parties are used to comparing the schedules of PTAB proceedings and parallel district court litigation to understand how the PTAB’s final decision might affect the litigation. But the prospect of the PTAB declining to institute if its FWD will not beat the court to the finish line raises new issues in many cases. For example, different district courts have historically conducted proceedings at different speeds. In the Eastern District of Texas’s Marshall division (historically a popular venue for plaintiffs), the average time to a jury trial for patent suits is about 22 months, and the date initially set on the schedule might be even sooner.<sup>23</sup> Given that the PTAB’s statutory FWD deadline is typically at least 18 months after filing of the petition, and given the time it takes to prepare a petition for filing, some defendants in some districts may have difficulty controlling whether the court’s scheduled trial date will be earlier than any IPR’s FWD deadline.

District court practices may affect how the *Fintiv* factors weigh in favor of or against discretionary denial. In *Fintiv*, the PTAB denied institution, noting the district court’s early scheduled trial date and the amount of investment in the district court proceeding before the PTAB’s institution decision, as well as the overlapping issues between the proceedings and weaknesses in the petition’s merits.<sup>24</sup>

On the other hand, in *Sand Revolution II, LLC v. Continental Intermodal Group—Trucking LLC*, the PTAB initially discretionarily denied institution under *NHK Spring*, but reconsidered and instituted in light of *Fintiv*.<sup>25</sup> In *Sand Revolution*, the PTAB noted that the district court’s schedule had been extended several times, creating uncertainty about whether the court would proceed as quickly as the current schedule would suggest.<sup>26</sup> And the PTAB noted that the court’s investment by that point on issues relevant to the IPR had not been so significant to warrant denying the IPR.<sup>27</sup>

Another factor in *Sand Revolution*’s determination to institute was a stipulation by the petitioner not to raise the same invalidity grounds in the district court if the PTAB instituted the IPR.<sup>28</sup> The PTAB noted the stipulation “mitigates to some degree the concerns of duplicative efforts” and overlapping issues between the IPR and the district court trial.<sup>29</sup> As of this article’s writing, stipulations similar to that in *Sand Revolution* have begun to be offered by petitioners in later cases, and the PTAB’s treatment of those stipulations will be a matter of interest to practitioners.

*Fintiv* indicated that discretionary denial due to parallel litigation is not limited to parallel *district court* litigation. It can be based as well on a parallel investigation by the U.S. International Trade Commission (ITC), even though the PTAB recognizes that the ITC’s decisions on invalidity do not have preclusive effect.<sup>30</sup> ITC investigations involve fast schedules that may often conclude before a parallel PTAB proceeding would.<sup>31</sup>

Discretionary denial based on parallel litigation remains an issue where the PTAB’s practice is evolving. Petitioners should consider carefully when to file a petition and how to structure the petition to avoid discretionary denial. Patent owners should consider whether the likely schedule of the court in which they choose to assert the patent will increase the likelihood of discretionary denial. The presence of *Fintiv* factor 6 (“other circumstances ... including the merits”) emphasizes as well that petitioners may help themselves avoid discretionary denial by raising strong patentability challenges, and patent owners seeking discretionary denial may benefit from attacking the petition’s merits.

## Follow-on Petitions

So-called “follow-on petitions”—that is, petitions that challenge the same patent as a previous petition—can create “the potential for abuse of the review process by repeated attacks on patents.”<sup>32</sup> The PTAB therefore articulated in *General Plastic* seven non-exclusive factors to decide whether to exercise its discretion to deny a follow-on petition:

1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
3. whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition;
4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
6. the finite resources of the Board; and
7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.<sup>33</sup>

The *General Plastic* factors reflect the PTAB's concerns with follow-on petitions. On the one hand, PTAB proceedings are intended to offer "an effective and efficient alternative to district court litigation," so the factors allow the petitioner to address whether it had a good reason for not filing the follow-on petition earlier.<sup>34</sup> On the other hand, the *General Plastic* factors recognize that "undue inequities and prejudice to Patent Owner" may result if the petitioner waits to learn from the patent owner's preliminary response or the PTAB's institution decision before formulating a serial attack.<sup>35</sup> The factors also consider the PTAB's interest in controlling its docket.<sup>36</sup>

Although the first *General Plastic* factor refers expressly to the situation where "the same petitioner previously filed a petition," subsequent decisions have extended the possibility of discretionary denial to follow-on petitions filed by a different party than the prior petition. In *Valve Corp. v. Electronic Scripting Products, Inc.*, the PTAB explained that it will "consider any relationship between [the previous and current] petitioners when weighing the *General Plastic* factors."<sup>37</sup> In *Valve*, the fact that both petitioners were co-defendants accused of infringement based on technology that the prior petitioner licensed from the subsequent petitioner was a "significant relationship" sufficient to tip the first *General Plastic* factor in favor of discretionary denial.<sup>38</sup>

Some PTAB panels have distinguished *Valve* on the basis that *Valve* involved co-defendants sued in the same case over the same accused devices. For example, *Mercedes-Benz USA, LLC v. Carucel Investments, L.P.* found the fact that Mercedes-Benz and Volkswagen were market competitors sued on different theories of infringement showed "a lack of any relationship between the parties" and weighed against discretionary denial of Mercedes-Benz's IPR based on Volkswagen's prior IPR.<sup>39</sup>

Other PTAB panels have found certain other relationships between petitioners to be insufficient to warrant discretionary denial of the second petitioner's follow-on petition. In *Netflix Inc. v. Divx, LLC*, although the petitioners were members of Unified Patents which had filed a prior petition on the same patent, the PTAB found this relationship insufficient to warrant discretionary denial.<sup>40</sup> In *LG Electronics, Inc. v. Bell Northern Research, LLC*, the PTAB found no sufficient relationship between petitioners who shared counsel in the parallel litigation.<sup>41</sup>

However, even in the absence of a relationship outside of the IPRs, a subsequent petition on the same patent as a prior petition may not always be safe from discretionary denial. For example, in *Ericsson Inc. v. Uniloc 2017, LLC*, the PTAB found a relationship sufficient to warrant discretionary denial because the follow-on petitioner had essentially copied portions of its petition from another party's prior petition.<sup>42</sup> And the PTAB may discretionarily deny follow-on petitions based on the weight of the other *General Plastic* factors, notwithstanding a lack of relationship between the petitioners.<sup>43</sup>

The scenarios in which the PTAB may discretionarily deny follow-on petitions continue to evolve. Petitioners may consider addressing prior petitions against the same patent with, for example, evidence about the lack of any relationship with the previous petitioner, about how new prior art was not reasonably accessible previously, or about some other reason the later petition was filed when it was. Patent owners should highlight similarity and fairness factors that would lead the PTAB to conclude a serial attack should be discretionarily denied.

## Parallel Petitions

Given the PTAB's word-count limits on petitions, some petitioners file multiple petitions in parallel on the same patent to ensure the desired coverage of claims and grounds. When these parallel petitions are filed at around the same time, the fairness concerns that *General Plastic* addresses regarding "follow-on petitions" should not be present. Nevertheless, for the ever-present reasons of efficiency, the PTAB may discretionarily deny one or more concurrently filed petitions on the same patent unless the petitioner can explain why multiple parallel petitions are needed.

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The PTAB recently updated its Trial Practice Guide (TPG) to explain its practices.<sup>44</sup> The TPG explained that “one petition should be sufficient to challenge the claims of a patent in most situations,” and that additional parallel petitions “may place a substantial and unnecessary burden on the Board and the patent owner and could raise fairness, timing, and efficiency concerns.”<sup>45</sup>

The TPG recognized that certain “rare” circumstances may necessitate multiple (e.g., two) parallel petitions, such as “when the patent owner has asserted a large number of claims in litigation or when there is a dispute about priority date requiring arguments under multiple prior art references.”<sup>46</sup> But the TPG added, “it unlikely that circumstances will arise where three or more petitions by a petitioner with respect to a particular patent will be appropriate.”<sup>47</sup>

That is not to say that challenging a large number of claims or raising a priority date dispute will necessarily entitle the petitioner to institution on two parallel petitions. For example, in *Square, Inc. v. 4361423 Canada Inc.*, the petitioner sought to justify two petitions on the basis that one contained a priority dispute.<sup>48</sup> The PTAB responded by instituting only the petition that did not depend on the priority dispute, explaining that the “TPG does not contemplate that whenever there is a priority dispute, Petitioner is justified in filing two petitions against the same patent.”<sup>49</sup>

The petitioner seeking to file parallel petitions should carefully explain the need. The TPG instructs petitioners to rank parallel petitions in the order the PTAB should consider them and provide “a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions.”<sup>50</sup> The TPG encourages patent owners to respond to this statement with their preliminary response.<sup>51</sup>

The PTAB will decide whether to discretionarily deny parallel petitions based on the information the parties provide. As the example in *Square* demonstrates, the petitioner should be as specific as possible about why each of the multiple petitions is needed. There, the PTAB faulted the petitioner for failing to “adequately explain why two petitions in the circumstance here in fact are necessary.”<sup>52</sup>

The PTAB may also reward parties who attempt to streamline the proceedings. For example, the TPG encourages stipulations that avoid the need for multiple petitions,<sup>53</sup> and the PTAB may fault parties who do not do so. In *Microsoft Corp. v. IPA Techs. Inc.*, the PTAB instituted five parallel petitions in view of the huge number of asserted claims and the patent owner’s refusal to stipulate to narrow the dispute.<sup>54</sup>

## Weak Petitions

Before the Supreme Court’s decision in *SAS*, when faced with a petition that raises some meritorious challenges and some non-meritorious challenges, the PTAB might have chosen to partially institute on only the meritorious portion. With partial institution unavailable post-*SAS*, the PTAB may exercise its discretion not to institute at all.<sup>55</sup>

## Prior Art and Arguments Previously Presented to the PTO

Since the PTAB’s creation by the AIA, Section 325(d) has permitted discretionary denial where “the same or substantially the same prior art or arguments previously were presented to the Office” during prosecution. The PTAB’s test for determining when to exercise that discretion, however, has recently evolved. In *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, the PTAB articulated a two-step test for discretionary denial under Section 325(d):

- (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and
- (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.<sup>56</sup>

This two-part test clarified the PTAB’s existing test from *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, which weighs six factors in deciding whether to deny institution under Section 325(d).<sup>57</sup> *Advanced Bionics* explained that three of the six *Becton, Dickinson* factors pertain to whether “the same or substantially the same” prior art or arguments were previously presented to the PTO:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- (b) the cumulative nature of the asserted art and the prior art evaluated during examination; ... [and]
- (d) the extent of the overlap between the arguments made during examination and the manner in which petitioner relies on the prior art ....<sup>58</sup>

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The other three *Becton, Dickinson* factors relate to whether the petitioner has demonstrated a material error by the PTO:

(c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection; ...

(e) whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art; and

(f) the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments.<sup>59</sup>

The facts of *Advanced Bionics* provide a window into some situations that can warrant discretionary denial under Section 325(d). Of the four prior art references the petition cited, three were not of record during prosecution.<sup>60</sup> Nevertheless, the PTAB looked closely at whether the petition cited those three additional references for disclosing anything materially different from what the examiner had already considered in the fourth reference.<sup>61</sup> Finding that it did not, the PTAB concluded that the three new references were “substantially the same art” as was previously presented during prosecution, and denied institution.<sup>62</sup>

On this issue of whether prior art is “substantially the same,” petitioners can benefit from finding disclosures that go beyond those in the references considered during prosecution, ideally directed toward limitations the examiner failed to identify in the references already considered. For example, in *CallMiner, Inc. v. NICE Ltd.*, the PTAB concluded that *Advanced Bionics*’ first prong for discretionary denial was not met because the new reference disclosed a system that met the claimed limitations in a different way and disclosed a limitation that the reference cited in prosecution did not.<sup>63</sup>

Petitioners should also be aware that even references not used as a basis for rejection during prosecution may be considered “previously ... presented to the Office” under *Advanced Bionics*.<sup>64</sup> For example, in *Boragen, Inc. v. Syngenta Participations Ag*, the PTAB concluded that a reference that was not of record during prosecution was nevertheless “previously presented” for purposes of discretionary denial because it was cumulative to two references that were cited in an Information Disclosure Statement (IDS), though never relied on in any rejection during prosecution.<sup>65</sup> There are other examples, however, where PTAB panels have not considered a reference cited in an IDS but not specifically discussed by the examiner to have been “previously presented” for purposes of Section 325(d).<sup>66</sup>

If the petition’s art or arguments were previously presented, the petitioner must then show material error by the examiner. According to *Advanced Bionics*, such error must go beyond merely disagreeing with the examiner’s conclusion on a question where “reasonable minds can disagree.”<sup>67</sup> *Advanced Bionics* explained that sufficient errors may include the examiner “misapprehending or overlooking specific teachings” of the art or “misconstruing a claim term.”<sup>68</sup>

The PTAB has in some instances been willing to find the examiner erred where the PTAB is convinced of the substantive merit of the petition’s grounds. Some decisions affirmatively find that “reasonable minds cannot disagree that the Office erred,”<sup>69</sup> while other decisions simply rely on finding that the “[p]etitioner has shown a reasonable likelihood” of success notwithstanding that the art was previously presented during examination.<sup>70</sup>

The lesson for practitioners is that the challenged patent’s prosecution history matters in the context of discretionary denial. Indeed, the PTAB may even discretionarily deny petitions based on art or arguments having been presented in the challenged patent’s parent applications.<sup>71</sup> Also, discretionary denial under Section 325(d) is not limited to art and arguments presented during prosecution, and additionally covers art and arguments presented in prior IPRs and other post-grant proceedings. Indeed, *Advanced Bionics* explained that Section 325(d) and the *Becton, Dickinson* factors apply to art or arguments “previously presented to the Office during any proceeding, including prior AIA proceedings.”<sup>72</sup>

Petitioners should expect many of the same concerns to arise regarding prior PTAB petitions as arise regarding the prosecution history. For example, *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.* denied institution of a petition that relied on substantially the same art as prior petitions.<sup>73</sup> By contrast, in *Microsoft Corp. v. Uniloc 2017 LLC*, the PTAB granted institution where the petition’s new primary reference had “critical disclosures” lacking from the art considered in a previous IPR.<sup>74</sup>

Whether because of art or arguments raised in a prior post-grant proceeding, or because of art or argument raised during prosecution, Section 325(d) may be a useful argument for patent owners. The PTAB reported in 2019 that it had historically denied institution in about 23% of decisions that addressed Section 325(d).<sup>75</sup> Thus, Section 325(d) may be a powerful tool to increase the chance of discretionary denial.

## Conclusions

The scope of the PTAB’s authority to discretionarily deny institution is critical for parties to understand. Few

other arguments can defeat an entire petition irrespective of the substantive strength of the petition's challenges. With the increasing rate at which the PTAB has been exercising discretionary denial, both petitioners and patent owners should consider addressing the issue proactively. Petitioners that face risks—either because of what has happened in other proceedings, or because of the nature of arguments in the petition—should consider addressing discretionary denial in the petition. Likewise, patent owners should not neglect to investigate and raise all discretionary denial arguments in the preliminary response. The continuously evolving nature of the PTAB's discretionary denial practices means there is no substitute for

keeping a watchful eye on the PTAB's case decisions and guidance in this area.

While parties should carefully consider the PTAB's various legal standards, they likewise should remain mindful of the PTAB's underlying motivations for discretionary denial. The PTAB is concerned with ensuring fairness and efficiency, as well as achieving the correct result in terms of patentability. Parties should tell a compelling story about why their efforts have been reasonable, equitable, and promoting efficiency, and why the merits of their grounds and arguments are worthy of the PTAB's consideration and a favorable decision.

1. 35 U.S.C. §§ 316(b), 326(b). *See also* Consolidated Trial Practice Guide, November 2019 at 55–56 U.S.P.T.O. (Nov. 2019), available at <https://www.uspto.gov/about-us/news-updates/consolidated-trial-practice-guide-november-2019> (citing Sections 316(b) and 326(b) when explaining the PTAB's rationale for discretionary denial).
2. 138 S. Ct. 1348 (2018).
3. *Id.* at 1359–60.
4. *E.g.*, *AC Techs. S.A. v. Amazon.com, Inc.*, 912 F.3d 1358, 1364–65 (Fed. Cir. 2019) (collecting cases).
5. Based on information collected from DocketNavigator (<https://www.docketnavigator.com/>).
6. Consolidated Trial Practice Guide, November 2019, U.S.P.T.O. (Nov. 2019), available at <https://www.uspto.gov/about-us/news-updates/consolidated-trial-practice-guide-november-2019>.
7. *See* Precedential and Informative Decisions, U.S.P.T.O., <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/precedential-informative-decisions>.
8. 35 U.S.C. § 314(a). 35 U.S.C. § 324(a) contains the corresponding language for post-grant review (PGR).
9. *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 18–19 (Sept. 6, 2017) (precedential in relevant part) (emphasis added).
10. 35 U.S.C. § 325(d); *see* *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17 (Dec. 15, 2017) (precedential in relevant part).
11. Based on information collected from DocketNavigator (<https://www.docketnavigator.com/>).
12. *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016).
13. *E.g.*, *Harmonic Inc. v. Avid Tech, Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016).
14. *See* *BioDelivery Scis. Int'l, Inc. v. Aquestive Therapeutics, Inc.*, 935 F.3d 1362, 1366 (Fed. Cir. 2019) (holding that the PTAB's decision to discretionarily deny institution is unappealable).
15. Complaint for Declaratory and Injunctive Relief, *Apple Inc. v. Iancu*, No. 5:20-cv-6128 (N.D. Cal. Aug. 31, 2020).
16. The Supreme Court also left open the possibility of appellate review in some circumstances. *Cuozzo*, 136 S. Ct. at 2141–42 (declining to rule that § 314(d) bars “appeals that implicate constitutional questions, that depend on other less closely related statutes, or that present other questions of interpretation that reach, in terms of scope and impact, well beyond ‘this section.’”); *id.* at 2151 n.5 (Alito, J., concurring in part and dissenting in part) (declining to address whether a writ of mandamus might be available in “extraordinary cases”); *see* *Thryv, Inc v. Click-To-Call Techs., LP*, 140 S. Ct. 1367, 1373 (2020) (relying on *Cuozzo* and noting that it declined to decide the effect of § 314(d) in such situations).
17. *Cuozzo*, 136 S. Ct. at 2141–42 (declining to rule that § 314(d) bars “appeals that implicate constitutional questions, that depend on other less closely related statutes, or that present other questions of interpretation that reach, in terms of scope and impact, well beyond ‘this section.’”); *id.* at 2151 n.5 (Alito, J., concurring in part and dissenting in part) (declining to address whether a writ of mandamus might be available in “extraordinary cases”); *see* *Thryv, Inc v. Click-To-Call Techs., LP*, 140 S. Ct. 1367, 1373 (2020) (relying on *Cuozzo* and noting that it declined to decide the effect of § 314(d) in such situations).
18. IPR2018-00752, Paper 8 (Sept. 12, 2018) (precedential).
19. *Id.* at 11–18.
20. *Id.* at 19–20.
21. IPR2020-00019, Paper 11 at 5–6 (Mar. 20, 2020) (precedential).
22. *Id.* at 9–13.
23. Based on information collected from DocketNavigator (<https://www.docketnavigator.com/>).
24. IPR2020-00019, Paper 15 at 12–17 (May 13, 2020) (informative).
25. IPR2019-01393, Paper 24 (June 16, 2020) (informative).
26. *Id.* at 8–10.
27. *Id.* at 10–11.
28. *Id.* at 11–12.
29. *Id.* at 12.
30. IPR2020-00019, Paper 11 at 8–9.
31. *E.g.*, *Bio-Rad Labs., Inc. v. 10X Genomics, Inc.*, IPR2019-00567, Paper 23 at 26–29 (Aug. 8, 2019) (denying institution in part because of the advanced stage of a parallel ITC investigation). *But see* *Samsung Elecs. Co. v. Dynamics Inc.*, IPR2020-00499, Paper 41 at 13–14 (Aug. 12, 2020) (applying the *Fintiv* factors to a parallel ITC investigation but instituting IPR in part because the petition challenged more claims than were asserted in the ITC investigation).
32. *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16–17 (Sept. 6, 2017) (precedential in relevant part).
33. *Id.* at 16.
34. *Id.* at 16–18.
35. *Id.*
36. *Id.*
37. IPR2019-00062, Paper 11 at 9 (Apr. 2, 2019) (precedential).
38. *Id.* at 10.
39. IPR2019-01404, Paper 12 at 11–12 (Jan. 22, 2020) (granting institution).
40. IPR2020-00052, Paper 42 at 8–12 (May 14, 2020).
41. IPR2020-00319, Paper 15 at 7 (June 23, 2020).
42. IPR2019-01550, Paper 8 at 12 (Mar. 17, 2020). By contrast, in *Apple Inc. v. Uniloc 2017 LCC*, the PTAB did not discretionarily deny institution where the second petitioner copied and sought joinder with the prior petition in a “completely inactive” role. IPR2020-00224, Paper 10 at 4 (Apr. 6, 2020).
43. *See, e.g.*, *Ericsson Inc. v. Uniloc 2017 LLC*, IPR2020-00420, Paper 7 at 6–10 (June 18, 2020) (disagreeing with the PTAB panel in IPR2019-01550 that copying material from the prior petition creates a sufficient relationship under factor 1, but discretionarily denying institution based on the weight of the other factors).
44. Trial Practice Guide Update, USPTO (July 2019), available at <https://www.uspto.gov/sites/default/files/documents/trial-practice-guide-update3.pdf>. The July 2019 update was incorporated into the Consolidated Trial Practice Guide, *supra*.
45. Consolidated Trial Practice Guide, *supra*, at 59.
46. *Id.*
47. *Id.*
48. IPR2019-01626, Paper 14 at 7–8 (Mar. 30, 2020).
49. *Id.* at 8–11.
50. Consolidated Trial Practice Guide, *supra*, at 60.
51. *Id.* at 28.
52. IPR2019-01626, Paper 14 at 9. *See also* *Volkswagen Grp. of Am., Inc. v. Carucel Investments, L.P.*, IPR2019-01106, Paper 8 at 10 (Dec. 2, 2019) (denying institution of petitioner's lower-ranked parallel petition challenging same claims using different art, noting that the petitioner's statement ranking the petitions “convince[d]” the PTAB that the higher-ranked petition was stronger).
53. Consolidated Trial Practice Guide, *supra*, at 61.
54. IPR2019-00810, Paper 12 at 11–15 (Oct. 16, 2019). *See also* *Chegg Inc. v. Netsoc, LLC*, IPR2019-01165, Paper 14 at 9–10 (Dec. 5, 2019) (instituting a parallel petition where patent owner declined to stipulate that certain



- references were prior art, and where seven parties combined efforts to present just two petitions to promote efficiency).
55. *See, e.g.*, *Chevron Oronite Co. v. Infineum USA L.P.*, IPR2018-00923, Paper 9 at 11 (Nov. 7, 2018) (informative) (denying institution where “Petitioner demonstrates, at most, a reasonable likelihood of prevailing with respect to two dependent claims out of a total of twenty challenged claims.”); *Deeper, UAB v. Vexilar, Inc.*, IPR2018-01310, Paper 7 at 42–43 (Jan. 24, 2019) (informative) (denying institution where “Petitioner demonstrates a reasonable likelihood of prevailing with respect to only two claims on one asserted ground” out of four grounds attacking 23 claims).
  56. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (Feb. 13, 2020) (precedential).
  57. IPR2017-01586, Paper 8 at 17–18 (Dec. 15, 2017) (precedential in relevant part).
  58. IPR2019-01469, Paper 6 at 9–10 & 9 n.10 (quoting the factors from *Becton, Dickinson*, IPR2017-01586, Paper 8 at 17–18).
  59. *Id.*
  60. *Id.* at 13–14.
  61. *Id.* at 14–19.
  62. *Id.* at 19.
  63. IPR2020-00221, Paper 11 at 29–34 (June 17, 2020) (granting institution).
  64. IPR2019-01469, Paper 6 at 7–8.
  65. IPR2020-00124, Paper 16 at 21–22 (May 5, 2020).
  66. *See, e.g.*, *H-E-B, LP v. Digital Retail Apps, Inc.*, IPR2020-00347, Paper 17 at 9–11 (July 6, 2020) (finding that a reference was not previously presented despite being cited to the examiner).
  67. IPR2019-01469, Paper 6 at 9.
  68. *Id.* at 8–9 n.9.
  69. *Apple Inc. v. Omni Medsci, Inc.*, IPR2020-00029, Paper 7 at 55 (Apr. 22, 2020).
  70. *Versa Prods. C. Varidesk, LLC*, IPR2020-00387, Paper 13 at 16–18 (July 10, 2020).
  71. *See, e.g.*, *Becton, Dickinson*, IPR2017-01586, Paper 8 at 22–23.
  72. IPR2019-01469, Paper 6 at 10.
  73. IPR2013-00324, Paper 19 at 4–7 (Nov. 21, 2013) (informative).
  74. IPR2019-00973, Paper 7 at 9 (Nov. 19, 2019).
  75. 2019 Patent Public Advisory Committee (PPAC) Annual Report, available at [https://www.uspto.gov/sites/default/files/documents/PPAC\\_2019\\_Annual\\_Report.pdf](https://www.uspto.gov/sites/default/files/documents/PPAC_2019_Annual_Report.pdf) (data through April 28, 2018).

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