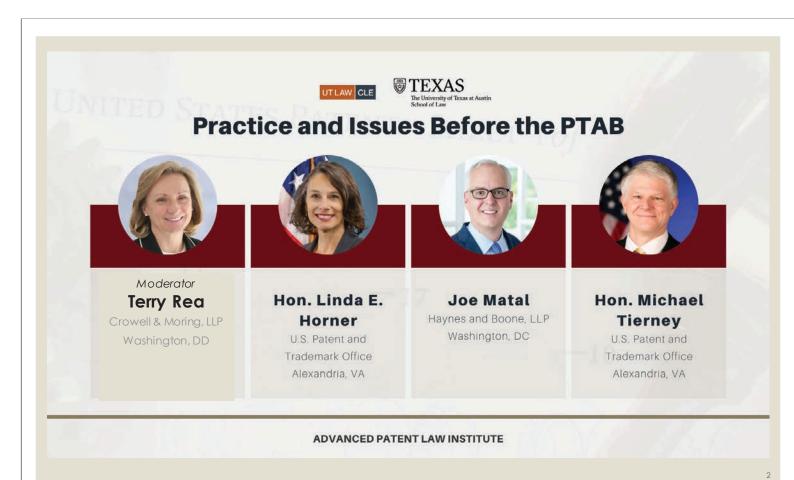
## Practice and Issues Before the PTAB

March 25, 2021

The 16th
Annual
Advanced
Patent
Law
Institute



## Discretionary denials of institution

(All slides prepared by Haynes and Boone, LLP; some incorporate public USPTO materials.)

## **Discretionary Denials**

Discretionary denials versus getting to the merits.

- Fintiv: deny review because of jury trial
- Valve and General Plastic: deny review because of earlier petitions

## Fintiv "discretionary denial" factors

(Apple Inc. v. Fintiv, Inc., IPR 2020-00019, Mar. 20, 2020)

- District court stay
- District court trial date
- "Investment" in district court proceeding
- Overlap of issues
- Same party
- Merits

The "Albright doctrine"

"It's my job to give people the opportunity to have their cases tried in a federal court ... and I probably can get a patent trial resolved more quickly than the PTAB can."

6





Find the full text of this and thousands of other resources from leading experts in dozens of legal practice areas in the <u>UT Law CLE eLibrary (utcle.org/elibrary)</u>

Title search: Practice and Issues Before the PTAB

Also available as part of the eCourse 2021 Advanced Patent Law (USPTO) eConference

First appeared as part of the conference materials for the  $16^{th}$  Annual Advanced Patent Law Institute session "Practice and Issues Before the PTAB"