

Practice and Issues Before the PTAB

March 25, 2021

The 16th
Annual
Advanced
Patent
Law
Institute

UT LAW CLE

TEXAS
The University of Texas at Austin
School of Law

Practice and Issues Before the PTAB



Moderator
Terry Rea

Crowell & Moring, LLP
Washington, DD



Hon. Linda E. Horner

U.S. Patent and
Trademark Office
Alexandria, VA



Joe Matal

Haynes and Boone, LLP
Washington, DC



Hon. Michael Tierney

U.S. Patent and
Trademark Office
Alexandria, VA

ADVANCED PATENT LAW INSTITUTE

Discretionary denials of institution

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

3

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

4

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*

5



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 [UT Law CLE eLibrary \(utcle.org/elibrary\)](https://utcle.org/elibrary)

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
16th Annual Advanced Patent Law Institute session

"Practice and Issues Before the PTAB"