

2021 PTAB Annual Conference Takeaways

From September 22-24, 2021, Choate was a sponsor of the PTAB Bar Association Annual Conference in Washington D.C., where more than 150 practitioners, in-house counsel, and attorneys from law firms gathered to hear the latest updates and trends.

The conference kicked off with a keynote speech from PTAB Chief Judge Scott Boalick and concluded with a panel of Federal Circuit judges providing tips for how patent owners and petitioners can improve their odds for success on appeal. The conference also included a discussion with Acting Director of the USPTO, Drew Hirshfeld.

Below are key takeaways from the conference.

Discretionary Denials

The hot topic was discretionary denials of AIA proceedings at the institution stage. The PTAB's IPR institution rate has been declining while procedural denials have been rising. Discretionary denials may be the result of multiple (or serial) petitions, or in the interest of efficiency based on 35 U.S.C. § 325(d). However, the most heavily scrutinized category at the conference was denials of IPR petitions based on parallel proceedings.

- Parallel proceedings may restrict a patent challenger's opportunities to pursue AIA trials, particularly where a parallel litigation is filed in a district with a rapid schedule (e.g., E.D. Tex., W.D. Tex., or (according to statistics) D. Mass.), or where the parallel proceeding is before the International Trade Commission (ITC).
- The PTAB considers six non-exclusive factors, including the proximity of the trial date in the other proceeding and the overlap in issues between the petition and the parallel proceeding. *See NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential); *Apple v. Fintiv*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential).
- So-called *Sotera* stipulations may increase a petitioner's chance of avoiding discretionary denial on parallel-proceeding grounds. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-0109, Paper 12 (PTAB Dec. 1, 2020). These stipulations provide that the petitioner will not pursue its §102 or §103 invalidity arguments in the parallel district court proceeding—indicating to both the court and the PTAB that the parties wish to have those issues decided by the PTAB alone. It remains to be seen how the language of these stipulations evolves, and how much weight the PTAB gives them moving forward.

Director Review Post-Arthrex

On June 21, 2021, the Supreme Court held in *United States v. Arthrex, Inc.* that the Director of the USPTO "may review final PTAB decisions and, upon review, may issue decisions himself on behalf of the Board." 141 S. Ct. 1970, 1987 (2021).

- To date there have been 44 director review requests. 16 were denied and 28 remain pending.
- Despite the low likelihood of director review, parties should not be discouraged from applying.

Diversity Initiatives

While the percentage of woman-led arguments at the PTAB has increased from 10% to 12%, additional work on the “pipeline” will be key to keep that number trending in the right direction. In-house counsel have been collaborating with law firms on diversity initiatives and these efforts have been well received.

PTAB Practice Tips and Updates

- Chief Judge Boalick indicated that moving forward, the PTAB intends to allow fully remote hearings.
- The motion to amend pilot program has been extended to September 2022.
- The PTAB offers a boardside chat webinar series, including one from July 2021 on post-*Arthrex* implications ([available here](#)).
- In October, the PTAB will release their FY2021 round-up statistics, which will be available [on their website](#).
- Chief Judge Boalick also announced an upcoming Pro Bono Program.

For more information about the evolving landscape at the PTAB as discussed at the conference, please contact one of the following attorneys.

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