

UNITED STATES
PATENT AND TRADEMARK OFFICE



Patent Trial and Appeal Board (PTAB) USPTO Hour: Interim processes relating to institution in AIA proceedings

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UNITED STATES
PATENT AND TRADEMARK OFFICE ®

Notice

This content is for informational purposes only and is not legal advice. Please consult the March 26, 2025 Interim Processes Memorandum and the Interim Director Discretionary Process webpage for guidance on these matters.

Question/comment submission

To send in questions or comments during the webinar, please email:

- USPTOHour@uspto.gov

Agenda

1. Interim processes for PTAB workload management overview (“Interim processes”)
2. FAQs
3. Statistics
4. Exemplary fact patterns
5. Updates
6. Takeaways
7. Q&A

Interim processes for PTAB workload management

Interim processes

- Acting Director Stewart issued a memorandum on new PTAB interim processes on March 26, 2025.
 - www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf
- Processes aim to improve PTAB efficiency, maintain capacity to conduct AIA proceedings, reduce pendency in *ex parte* appeals, and promote consistent application of discretionary considerations in the institution of AIA proceedings.

Interim processes (cont'd)

- Decisions on whether to institute an AIA trial are bifurcated between:
 - i. discretionary considerations and
 - ii. merits and other non-discretionary considerations.

Interim processes (cont'd)

- The Director (in consultation with at least three senior PTAB judges) determines whether discretionary denial of institution is appropriate.
- If not appropriate, a Board panel addresses the merits and other non-discretionary considerations and determines whether to institute.

Interim processes (cont'd)

- Parties may file briefs to address discretion to institute review in AIA proceedings in which the deadline to file a preliminary response (POPR) occurs after March 26, 2025.
 - A patent owner may file a discretionary denial brief within 2 months after the PTAB issues a Notice of Filing Date Accorded (NFDA) (or a Notice of Defective Petition) and the PTAB accepts a patent owner's Mandatory Notice.
 - A petitioner may file an opposition brief within 1 month after the due date for patent owner's discretionary denial brief.

Interim processes (cont'd)

- Consistent with existing precedent and guidance, the parties are permitted to address in their briefs all relevant discretionary considerations, including:
 - Whether PTAB or another forum has already adjudicated validity or patentability of the challenged patent claims
 - Whether there have been changes in the law or new judicial precedent issued since issuance of the claims that may affect patentability
 - The strength of the unpatentability challenge
 - The extent of the petition's reliance on expert testimony
 - Settled expectations of parties, such as the length of time the claims have been in force
 - Compelling economic, public health, or national security interests
 - Any other considerations bearing on the Director's discretion

Interim processes (cont'd)

- The Director issues a discretionary decision based on a holistic review of the facts and circumstances and may highlight certain considerations.
- Each discretionary decision will either (1) deny the petition or (2) refer the petition to the Board to handle the case in normal course.
 - If a discretionary decision denies the petition, no trial is instituted.
 - If a discretionary decision refers the petition to the Board, a Board panel will issue an institution decision addressing the merits and other non-discretionary considerations.



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Interim processes – FAQs

FAQs

- In April 2025, the USPTO published Frequently Asked Questions for the interim processes.
 - www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management
- The FAQs provide information about:
 - Availability and timing
 - Procedures/processes
 - Briefing requirements
 - Requests for rehearing or Director Review
 - Conflicts of Interest
 - New paper types for filing briefs



FAQs - updates

- The Office subsequently updated the FAQs to add the following:
 - FAQ 8 explains that the Director will consult with USPTO personnel with relevant technical expertise when the parties present arguments regarding the strength of the merits.
 - New FAQ 10 explains that while the Director ordinarily will rely on facts and circumstances the parties raise in the briefs, the director will consider additional circumstances where appropriate, e.g.,
 - To maintain consistency with already-issued discretionary decisions,
 - Where there are facts and circumstances within the purview of the Office or Office operations that the parties are not in a position to raise, or
 - Where there are facts and circumstances in the record or the public domain that are relevant to the determination.

Interim processes – statistics

Statistics

Cases Eligible for DSCO Decision	
632	cases with DD Request brief due by 8/11/25
521	DD Requests filed (82.4%)

DSCO Decisions (cumulative)	
294	cases with DSCO Decision mailed
	178 Deny (60.5%)
	116 Refer (39.5%)

DSCO Cases by Month Decision Due								
Month	Eligible	PO Reqs	% Filed	Decided	Denied	% Deny	Referred	% Refer
June	122	83	68%	80	44	55%	36	45%
July	143	132	92%	118	79	67%	39	33%
Aug	218	180	83%	96	55	57%	41	43%
Sept	140	117	84%	-	-	-	-	-

Interim processes – exemplary fact patterns

Exemplary fact patterns

- Supporting referral
 - Apparent material error during examination, *see, e.g., Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12 (July 16, 2025).
 - Early challenge to patentability in a PGR, which is close in time to examination and occurs before expectations in patent rights are strongly settled, *see, e.g., Multi-Color Corp. v. Brook & Whittle Ltd.*, PGR2025-00025, Paper 10 (July 16, 2025).
 - Evidence that the challenged patent has never been “commercialized, asserted, marked, licensed or otherwise applied” in Petitioner’s “particular technology space,” *see, e.g., Shenzhen Tuozhu Tech. Co., Ltd. v. Stratasys, Inc.*, IPR2025-00438, Paper 10 (July 17, 2025).

Exemplary fact patterns

- Supporting denial
 - Unfair dealings when inventors advocate for unpatentability of their own patent, *see, e.g., Tessell, Inc. v. Nutanix, Inc.*, IPR2025-00322, Paper 14 (June 12, 2025).
 - Settled expectations based on length of time patent in force and Petitioner provides no persuasive reasoning why IPR is appropriate use of resources, *see, e.g., Dabico Airport Sols. v. AXA Power ApS*, IPR2025-00408, Paper 21 (June 18, 2025).
 - Setting forth non-exclusive examples that provide considerations weighing against a patent owner's claim of settled expectations, such as a change in law or a patent that has not been commercialized, asserted, marked, licensed or applied in Petitioner's technology space, *see, e.g., Intel Corp. v. Proxense, LLC*, IPR2025-00327, Paper 12 (June 26, 2025).

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Interim processes – updates

Interim processes webpage

- Today, the Office is retiring the FAQs and publishing an interim processes webpage to serve as a guide to parties.
 - www.uspto.gov/patents/ptab/interim-director-discretionary-process
- The webpage provides information about the following:
 - General information about the process
 - Availability, timing, and content of a patent owner brief and a petitioner brief
 - Additional briefing and how to request it
 - Director discretionary decisions
 - Conflicts of interest
 - Where to submit questions ([Director Discretionary Decisions@uspto.gov](mailto:Director_Discretionary_Decisions@uspto.gov))

New page limits

- Under the interim processes memorandum, 14,000 words were permitted for patent owner and petitioner briefs.
- In practice, the briefs generally have been much shorter than 14,000 words.
- Based on this experience, the Office is adjusting the briefs to move from words to page limits, with all briefs filed on or after September 1, 2025, limited to 20 pages.
 - Follow general formatting requirements of 37 § C.F.R 42.6(a)
 - Parties may request additional pages by demonstrating good cause and emailing Director_Discretionary_Decision@uspto.gov

Locating Director discretionary decisions

- A Director discretionary decision will be entered into the record of a proceeding. To find Director Discretionary Decisions on the [PTAB website](#):
 - Select "[All PTAB decision data](#)"
 - Select the "[Documents](#)" tab on the "[PTAB Decisions](#)" page
 - Search for "Director Discretionary Decision" under "Document type."
 - Select both "Director Discretionary Decision: Refer" and "Director Discretionary Decision: Deny"
 - Choose "Apply"



Interim processes - takeaways

Takeaways

- **Process: Increased efficiency**
 - Team of 10-12 reviewing and making recommendations vs. > 100 judges
- **Process: Increased consistency**
 - Smaller team leads to consistent handling of similar fact patterns
- **Statistics: discretionary briefs filed in most (82%) eligible cases**
 - All decisions have issued within 1 month of the due date of the last relevant paper
- **Updates: New website, FAQs retired, and 20-page limit for briefs**
- **Stay tuned for designated decisions and rulemaking**

Questions

Questions

For any questions, please email:

Director_Discretionary_Decision@uspto.gov or

call 571-272-7822.



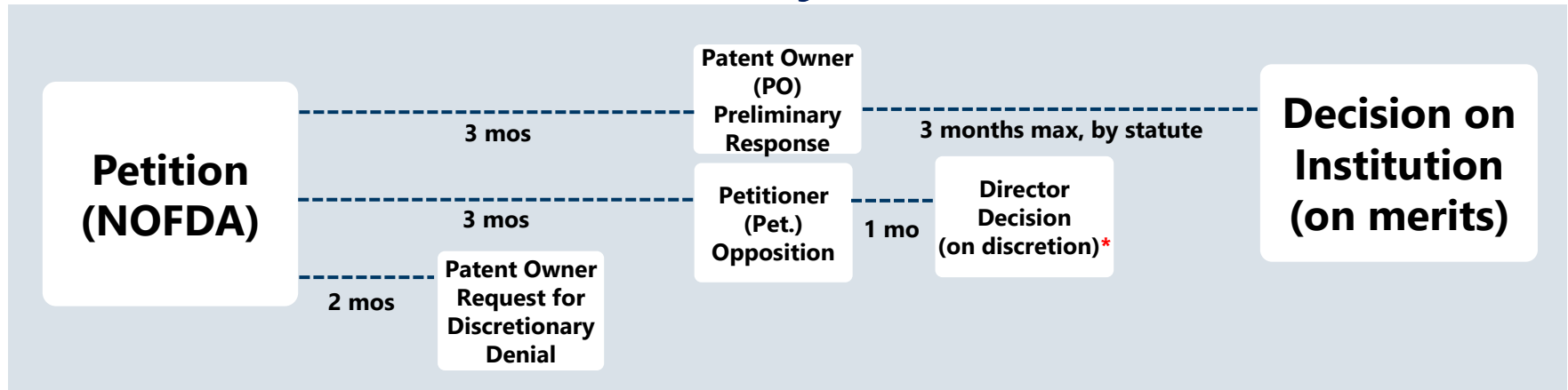


Appendix – Interim processes operations

Timeline: AIA proceedings

Interim processes

Preliminary Phase



* If the Director does not exercise discretion to deny institution, a Board panel determines whether to institute based on merits

Filing discretionary considerations briefs in P-TACTS

- On April 11, the PTAB introduced two new paper types in P-TACTS:
 - PO Discretionary Denial Brief
 - PET Opposition to Discretionary Denial Brief
- For timely consideration, parties should use these new paper types to file discretionary considerations briefs.

Filing discretionary considerations briefs in P-TACTS (cont'd)

- To file a patent owner discretionary denial brief:
 - Log into P-TACTS.
 - Go to My Docket and select the AIA Review case number to open Case Viewer.
 - Select the "+Add" button and File Other Document modal from the menu option.
 - Select "PO Discretionary Denial Brief" from the list of paper types.
 - Enter information into all required fields marked by a red asterisk beginning with paper type.
 - Select "PO Discretionary Denial Brief"; and
 - Click on "Add to List" and then "Submit."

Filing discretionary considerations briefs in P-TACTS (cont'd)

- To file a petitioner opposition to a discretionary denial brief:
 - Log into P-TACTS.
 - Go to My Docket and select the AIA Review case number to open Case Viewer.
 - Select the "+Add" button and File Other Document modal from the menu option.
 - Select "PET Opposition to Discretionary Denial Brief" from the list of paper types.
 - Enter information into all required fields marked by a red asterisk beginning with paper type.
 - Select "PET Opposition to Discretionary Denial Brief"; and
 - Click on "Add to List" and then "Submit."