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PTAB Leader Urges Specificity In Discretionary Denial Briefs

By [Ryan Davis](#) · [Listen to article](#)

Law360, San Diego (September 9, 2025, 9:26 PM EDT) -- The [Patent Trial and Appeal Board](#)'s acting chief judge urged litigants Tuesday to support the arguments they make in the board's new discretionary denial process with specific details about their cases, during a panel where lawyers expressed both frustration about and praise for the system.

Acting Chief Administrative Patent Judge Kal Deshpande, who became the board's acting leader last month, said

at the [Intellectual Property Owners Association](#) annual meeting in San Diego that parties filing briefs arguing that patent challenges should or should not be denied for discretionary reasons should "really explain the facts and circumstances, and support it with as much evidence as you can."

"A lot of the briefing at times comes in with just arguments that are unsupported or directed to the specific facts of those cases," he said, adding that "every case has its own facts and its own circumstances, so highlighting that it's similar to another case may be ineffective."

Rather than broad arguments, like those focused on a company's importance to a given industry, briefs tailored to details of the case have a better chance of prevailing, Judge Deshpande said. He advised litigants to "tell the story of what is going on and why you should prevail" and "give a great reason as to why a particular patent should be reviewed or shouldn't be reviewed."

Acting [U.S. Patent and Trademark Office](#) Director Coke Morgan Stewart created a [bifurcated process](#) this year in which she makes decisions about whether petitions challenging patents should be denied for discretionary reasons.

Those that aren't denied are referred to the board for review on the merits. The patent owner and the challenger can file briefs explaining why a petition does or does not warrant discretionary denial.

Judge Deshpande said a total of 425 decisions on discretionary issues have been made to date, and 258 petitions, or nearly 61%, have been denied. The other 167 cases have proceeded to the PTAB. Decisions by Stewart, and by Judge Deshpande and others who make rulings when she has a conflict, have cited many reasons why petitions should be denied for discretionary reasons.

Unsettled Expectations

Those include that a district court trial would take place before the board's decision is due, and that the length of time the patent has been in force has given the owner "[settled expectations](#)" that it would not be challenged. Attorneys on the panel with Judge Deshpande said dealing with the growing list of discretionary factors that can result in denial has been challenging.

Under the new system, there is a "high probability of discretionary denial ... but there's not a ton of guidance," said Peter Jovanovic, legal director for intellectual property at [Dell](#). He added that "it really does mess with what we were expecting, so it is problematic for us."

"Luckily, some guidance has been trickling out, and I thank [Judge Deshpande] for his comments right now," Jovanovic said. "But generally we're very uncertain of what to do right now. As a whole, you don't want to have uncertainty when litigation is pending, so hopefully there will be more instruction coming forward."

Consideration of the patent owner's settled expectations, which had never before been a factor in discretionary denials, is a "sea change," that has left litigants struggling to understand when expectations are settled and could result in denial, Jovanovic said. More guidance is needed from the office on that, he said, because "at this point, it is very chaotic."

Likewise, Unified Patents general counsel Jonathan Stroud said companies facing patent litigation that are considering PTAB challenges "are feeling very unsettled right now" by the addition of the settled expectations consideration, leading to "a fair amount of consternation."

"One of the supreme ironies, I think, about the settled expectations doctrine is the retroactive use of it," Stroud added, since it has been cited to deny petitions filed before the new policy had been implemented.

Stroud, whose organization frequently files patent challenges, said that since the new policies were announced, he has fielded a "remarkable" amount of questions from companies asking why the changes are being made and

whether they should even still file petitions, and "I don't really have a lot of answers."

Both Stroud and Jovanovic said a [decision last week](#) by Stewart involving [Home Depot](#) provided useful guidance that they would like to see more of. Stroud said it started to "scratch at this itch" for more insight into the settled expectations factor.

Stewart held that Home Depot's petition did not warrant denial, even though the content delivery patent it challenged had been in force for 12 years, since the owner had previously accused makers of smartphones and tablets of infringement, not hardware stores. That meant the retailer "did not have reason to anticipate" being sued, she found.

Drug Patent Impact

The new discretionary policies were welcomed by panel member David Roadcap, senior counsel for intellectual property and litigation at [Amgen](#), who said, "I personally view it as a positive and a move in the right direction, because it offers more certainty for policy-based reasons."

Denying patent challenges based on how long a patent has been in force is helpful for drugmakers, he said, noting that pharmaceutical patents are often challenged much later in their lifespan compared to other industries, since generic companies develop competing products once a branded drug has been on the market for some time.

The new policies are therefore "a sea change where most petitions related to pharmaceutical patents are now not going to get past the institution phase," Roadcap said.

That "allows us the comfort level and the certainty we need to proceed with our business model," he added. "We're throwing massive amounts of investment into these candidate therapeutics, and this allows us to recoup the investment towards the end of the patent term."

In a [speech on Sunday](#) at the IPO conference, Stewart said her policies aim to bring stability to the patent system. She urged litigants to bring early challenges to patents, such as post-grant reviews, which must be filed within nine months of when a patent issues, rather than inter partes reviews after being sued.

Some members of Tuesday's panel said that approach sounds good in theory, but could be very difficult in practice. Stroud noted that there are tens of thousands of patents on the 4G wireless standard alone and similarly vast numbers of patents in other high-tech fields, so "there's not enough money in the world" to challenge all of them.

Companies also have no way of knowing which one they might be sued over years in the future, possibly after it is acquired by someone other than the original owner, he added.

"In a vacuum, it would be wonderful if people could do earlier challenges," Stroud said. "But it's just practically and financially an impossibility to do that."

Offering a "peek behind the curtain" of how the hundreds of discretionary denial decisions are made, Judge Deshpande said the office has a team of people that reviews all the briefs and breaks down each case, and then meets with Stewart, who makes the final decision in each one.

"When her name goes on it, that's definitely her opinion that's being issued out there," Judge Deshpande said. "I know it's a large volume of cases with her name on it, but she's definitely involved in every one of them."

--Editing by Jay Jackson Jr.

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