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The Continuing Evolution of the PTAB's Fintiv Decision – A Brief Update

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Much attention has been focused on the Board's discretionary denial of petitions based on the factors set out in the *Fintiv* decision.[1] The focus is well-deserved—since the *Fintiv* decision issued last year, over 150 petitions have been denied based, at least in part, on the *Fintiv* factors. Factors 2 and 4 of the *Fintiv* decision focus on the proximity of the district court's trial date in relation to the statutory deadline for the PTAB to issue a final written[2] decision and overlap of the issues between the district court and PTAB proceeding.[3] And there have been some recent developments in relation to these two factors.

First, in relation to Factor 2, the Board has held that even a trial occurring very shortly before the final written decision is due may favor discretionary denial. This can be a particularly challenging issue for petitioners who are defendants in the Western District of Texas, which has a default scheduling order that is fairly abbreviated. In a recent decision denying Petitioner's request to rehear the denial of institution, a panel found that even though the district court had not set a firm trial date, an email from the court indicated that the trial date would likely occur on June 7, 2021.[4] Further, the deadline for issuing a final written decision could be no earlier than February 2022 and thus trial would still occur many months before any final written decision would issue.[5] The trial date for that case was recently postponed to December.[6] It is unclear whether the most-recent delay would affect the panel's conclusion or more broadly affect the Board's consideration of cases pending in the Western District.

Second, the Board has required less than complete overlap in deciding that *Fintiv* factor 4 favors denial of institution. For example, in a recent case, the PTAB denied institution of a petition for which only four of twenty challenged claims were at issue in the district court.[7] Other factors were found to weigh in favor of discretionary denial, including that the district court trial would occur almost a year before the final written decision would issue and because the court and parties had invested significant time, including discovery, claim construction, pre-trial disclosures, and evidentiary motions.[8] However, this decision illustrates that even minimal overlap of the claims at issue may still result in a discretionary denial.

In light of these recent changes, it is important that the parties, and petitioners in particular, monitor not only the schedule in their own district court cases but also other similarly-situated cases in the district. And if it appears that a particular district may be delaying trials, petitioners should seek to put that information before the PTAB as it may be a persuasive factor in a panel's determination of whether to institute a PTAB trial.

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[1] IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential).

[2] *Id.*, at 9.

[3] *Id.*, at 11.

[4] *Intel Corp. v. VLSI Technology LLC*, IPR2020-00582, Paper 26 at 4 (Feb. 11, 2021).

[5] *Id.*

[6] *VLSI Technology LLC v. Intel Corp.*, 6:19-cv-00255 (WDTX).

[7] *KeyMe LLC v. The Hillman Group, Inc.*, IPR2020-01485, Paper 11 (Mar. 31, 2021).

[8] *Id.*