

### 3 KEY TAKEAWAYS

## PTAB Update: Recent Developments in IPR and PGR Practice

[Kilpatrick Townsend](#) attorneys [Allison Dobson](#), [Nicki Kennedy](#), and [Troy Petersen](#) recently presented “PTAB Update: Recent Developments in IPR and PGR Practice” at the firm’s [Kilpatrick Townsend Intellectual Property Seminar \(KTIPS\)](#). KTIPS is an intensive, two-day patent strategy and protection seminar designed to provide insightful and in-depth training related to current developments in patent law, and how those impact patent procurement and enforcement strategies

Below are key takeaways from their presentation:

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#### Director Review

The post-Arthrex remedy of Director Review before the Patent Trial and Appeal Board (“PTAB”) has been requested in more than 50% of final written decisions issued since it became available. Yet only four requests have been granted and of those, three related to decisions where a similar case had been decided differently in related appeal or litigation. There is currently a Request for Comment open to the public so changes may be coming to the Director Review option. Currently, it is limited to only final written decisions and cannot be requested concurrently with a Request for Rehearing.

***Practice Tip: Request Director Review when there is a clear error or when a court in a co-pending case reaches a different conclusion.***

#### Fintiv Update

Director Kathi Vidal issued interim guidance regarding Fintiv, announcing that the PTAB will no longer take court trial dates at face value and instead will consider additional factors such as the median time-to-trial in the relevant district court, and also that the PTAB will not discretionarily deny institution of an IPR or PGR in three specific instances. These are when a petition presents compelling evidence of unpatentability, when the parallel proceeding occurs in the ITC, or where a petitioner stipulates not to pursue in a parallel district court proceeding the same grounds or any grounds that could have reasonably been raised before the PTAB.

***Practice Tip: Fintiv denial can be avoided by Petitioners.***

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#### Secondary Considerations

Secondary considerations before the PTAB require a showing of nexus and objective evidence in support. The PTAB often decides arguments regarding secondary considerations based on lack of nexus or finds that the evidence submitted is not strong. Where secondary considerations were found persuasive, Patent Owners clearly mapped the claim features to the evidence and included more than attorney argument.

***Practice Tip: As Petitioner, argue that Patent Owner has failed to show nexus, that the secondary considerations are directed to an unclaimed feature, or that the case of obviousness outweighs the secondary considerations. As Patent Owner, map claim limitations to the secondary consideration and include objective evidence rather than attorney argument, unsupported expert declarations, or self-serving press releases.***

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