



PTAB Applies Director's Guidance and Holds That Compelling Evidence of Unpatentability Precludes *Fintiv* Denial

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The petitioner challenged several claims of a patent as obvious over a single prior art reference and supported its positions with expert testimony. In response, the patent owner declined to address the merits, instead requesting that the PTAB exercise its discretion to deny institution under 35 U.S.C. § 314(a) because of the accelerated schedule of parallel litigation pending in district court, and under 35 U.S.C. § 325(d) because the asserted prior art reference was considered during prosecution.

The PTAB addressed each challenged claim limitation and determined that the petition and supporting expert testimony sufficiently established that the prior art reference taught the limitations. For each claim limitation, the PTAB observed that the patent owner did not address the merits of petitioner's contentions. Despite the co-pending district court litigation, the PTAB instituted review based on the petition's presentation of compelling evidence of unpatentability. In coming to its conclusion, the PTAB relied on the USPTO's recent interim guidance, which explains that a "compelling unpatentability challenge" alone forecloses the PTAB's discretion to deny institution under *Fintiv*. The guidance defines a "compelling unpatentability challenge" as one where the evidence, if unrebutted in trial, would plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence. The PTAB concluded that the standard was met and therefore could not exercise its discretion to deny institution under *Fintiv*. The PTAB also refused to exercise its discretion to deny institution under 35 U.S.C. § 325(d), finding that petitioner's compelling unpatentability challenge likewise demonstrated that the patent

examiner erred during prosecution in a manner material to patentability of the challenged claims.

Practice Tip: Following the USPTO’s recent interim guidance on discretionary *Fintiv* denials, patent owners seeking discretionary denial should address the merits of the petition and explain why the petition and any accompanying evidence fails to show that the challenged claims are unpatentable.

STMicroelectronics, Inc. v. The Trustees of Purdue Univ., IPR2022-00309, Paper 14 (PTAB Jul. 6, 2022).

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