

USPTO Issues Rulemaking on PTAB Discretionary Denials

Media Mentions

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On April 18, the US Patent and Trademark Office announced the upcoming publication of a new rule-making notice that will formalize the Patent Trial and Appeal Board's practices on discretionary denial of inter partes reviews. The rules touch upon parallel petitions, serial petitions, and 325(d) discretionary denials.

Bracewell's partner **Kit Crumbley**, a former PTAB lead administrative patent judge, stated to *IAM* that this new rule-making notice is scaled-back and just codifies existing discretionary denial policies with slight tweaks to factors the PTAB can consider.

"One of the most notable changes to discretionary denial in the NPRM is a procedural one: under the proposed rules, parties have the ability to address discretionary denial issues in separate briefing, which should address the concerns of many stakeholders that discretionary denial issues had begun to consume a disproportionate share of the pre-institution merits briefing in an IPR," Crumbley commented.

"Petitioners should also welcome the ability to provide a separate response on discretionary denial issues only in the event a patent owner raises those issues, rather than having to pre-emptively address the issues in their petitions without even knowing if a patent owner will make a discretionary denial argument."

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