

PTO Reverts to Prior Post-Grant Guidelines for Cases Involving Parallel District Court Litigation

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On February 28, 2025, the acting director of the US Patent & Trademark Office (PTO) [announced](#) that the agency will revert to previous guidelines for discretionary denials of petitions for post-grant proceedings where there is ongoing district court litigation.

This announcement rescinds the PTO's June 21, 2022, memorandum entitled "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation." The memorandum stated that the Patent Trial & Appeal Board "will not deny institution of an IPR or PGR under *Fintiv* (i) when a petition presents compelling evidence of unpatentability; (ii) when a request for denial under *Fintiv* is based on a parallel ITC proceeding; or (iii) where a petitioner stipulates not to pursue in a parallel district court proceeding the same grounds as in the petition or any grounds that could have reasonably been raised in the petition." The memorandum effectively limited the discretion granted in [Fintiv](#), which outlined six factors for the Board to consider when making decisions on post-grant proceedings involving parallel district court litigation.

Now that the 2022 memorandum has been rescinded, parties to post-grant proceedings should refer to Board precedent, including *Fintiv* and [Sotera Wireless v. Masimo](#), for guidance when there are parallel district court proceedings. In accordance with prior guidelines, the PTO's objective is to achieve greater consistency in its decision-making processes, especially in situations where patent validity is contested both in the courts and before the Board. The PTO emphasized that any portions of future Board decisions that rely on the 2022 memorandum will not be binding or persuasive.

Practice Note: Because of this action, the Board will now enjoy greater discretion when ruling on post-grant petitions, which may result in an increase of discretionary denials.

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