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UNITED STATES PATENT AND TRADEMARK OFFICE

FAQs for Interim Processes for PTAB Workload Management

On March 26, 2025, the United States Patent and Trademark Office (USPTO or Office) issued a memorandum on interim processes for PTAB workload management (Process Memorandum). Under the Process Memorandum, decisions on whether to institute *inter partes* reviews (IPR) and post-grant reviews (PGR) will be bifurcated between (i) discretionary considerations and (ii) merits and other non-discretionary considerations.

To help facilitate briefing, this page provides answers to frequently asked questions (FAQs) the Office has received about the bifurcated process and the discretionary considerations. The Office may update the FAQs after some experience with the interim processes, so please check back frequently for updates. The information presented in the FAQs controls the interim processes.

FAQs

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Availability and timing

1. In which *inter partes* review (IPR) and post-grant review (PGR) proceedings is the bifurcated process available?

The bifurcated process is available in IPRs and PGRs in which patent owner files a preliminary response, or the deadline for patent owner to file a preliminary response occurs, after March 26, 2025.

2. What are the timing requirements for briefing on discretionary considerations under the bifurcated process?

A patent owner may file a brief explaining any applicable bases for discretionary denial of institution within two months of the date on which the PTAB enters a Notice of Filing Date Accorded to a petition. The petitioner may file an opposition brief no later than 1 month after the due date for the patent owner discretionary denial brief (i.e., on the due date for the patent owner preliminary response (POPR)). Leave to file further briefing may be permitted by the Director for good cause.

EUNSUNG 1032
Eunsung v. HydraFacial
IPR2025-00445

3. What happens if the time for filing a discretionary denial brief has not yet elapsed, but will elapse in 1 month or less after the issuance of the Process Memorandum?

In such cases, the Board has or will issue a notice extending the deadline for a discretionary denial brief. In this situation, the patent owner may file a discretionary denial brief within 1 month of the date of the notice. The petitioner may file an opposition to the discretionary denial brief no later than 1 month after the due date for the patent owner discretionary denial brief.

4. What happens if the time for filing a discretionary denial brief has elapsed, but the deadline for filing a POPR has not yet passed?

As the March 26, 2025 Process Memorandum states, in this situation, the patent owner may file a discretionary denial brief within 1 month of the date of the Process Memorandum. The petitioner may file an opposition to the discretionary denial brief no later than 1 month after the due date for the patent owner discretionary denial brief.

5. What is the process if a patent owner filed a POPR, or the deadline for filing a POPR passed, on or before the Process Memorandum issued on March 26, 2025?

In this situation, the bifurcated process is not available, and a Board panel will proceed as it would have before the Process Memorandum issued. Thus, during the preliminary phase of an AIA proceeding, a Board panel will address any discretionary considerations and merits and other non-discretionary considerations the parties raise (e.g., in a petition or a POPR), as enumerated in previously existing Board precedent (including *Fintiv*, *General Plastic*, and *Advanced Bionics*) and the Consolidated Trial Practice Guide (Nov. 2019). The panel will not address any new factors outlined in the Process Memorandum, nor consider a request for rehearing based on those new factors.

6. Can the parties stipulate to later due dates for discretionary considerations briefing?

To ensure statutory deadlines are met, the parties may not stipulate to later due dates for filing the discretionary considerations briefing. A party, however, may file its discretionary denial brief or an opposition before the due date.

7. How will the timing change if a patent owner files its discretionary denial brief early? For example, if a patent owner files its discretionary denial brief early enough, will a petitioner's opposition brief be due, and the Director's decision on discretionary considerations issue, before the POPR due date?

The timing will not change if a patent owner files its discretionary denial brief early. A petitioner opposition will be due within 1 month of the due date for a patent owner discretionary denial brief (i.e., on the POPR due date) and the Director's decision will not issue until after a patent owner files its POPR or the deadline for filing the POPR has passed.

Procedures/processes

8. What procedures will the Director follow if a patent owner timely files a discretionary denial brief?

The Director will receive each petition, discretionary denial brief, opposition brief, and POPR, as well as any evidence the parties have made of record in support of their papers. Similar to the Director Review process, once received, the Director will determine, in consultation with at least three senior PTAB judges who will be separate from judges addressing the merits, whether discretionary denial is appropriate, as set forth in the Process Memorandum. In deciding whether to exercise discretion to institute IPR, the Director may consult with other USPTO employees as needed, as long as those individuals do not have a conflict of interest.

(UPDATED May 7, 2025) When parties present arguments regarding the strength of the merits, the Director will consult with USPTO personnel with relevant technical expertise.

Absent good cause, the Director will issue a decision on discretionary considerations within 1 month of the due date of the last relevant paper filed. The Director's decision will explain why the Director has decided to exercise discretion to deny institution or why a discretionary denial is not appropriate.

9. In cases where the bifurcated process is available, will the Director issue a decision on discretionary considerations in every case, or only those where patent owner files a discretionary denial brief?

If a patent owner chooses not to file a discretionary denial brief, the Director will not issue a decision on discretionary considerations. In that situation, the Office will enter a notice into the docket indicating the case is now before a Board panel to consider the non-discretionary issues.

After such a notice is entered, a Board panel will issue a decision on institution addressing the merits and other non-discretionary considerations the parties have raised in the petition, a POPR, and any additional briefing that the Board panel has authorized. Unless otherwise authorized by the Director, the Board panel will not address discretionary considerations, except where the petition presents an insufficient number of challenges that meet the reasonable likelihood standard indicating that institution is an inefficient use of resources, as explained in *Chevron Oronite Co. LLC v. Infineum USA L.P.*, IPR2018-00923, Paper 9 (PTAB Nov. 7, 2018) (informative) ("*Chevron*") and *Deeper, UAB v. Vexilar, Inc.*, IPR2018-01310, Paper 7 (PTAB Jan. 24, 2019) (informative) ("*Deeper*").

10. How is responsibility for institution decisions allocated during the bifurcated process?

Under the bifurcated process, the Director retains authority over institution decisions but delegates certain responsibilities depending on whether a patent owner files a discretionary denial brief.

If a patent owner timely files a discretionary denial brief, unless the Director states otherwise, the Director retains responsibility for resolving whether the proceeding should be denied on discretionary grounds.

If the Director issues a decision determining that discretionary denial is not appropriate, responsibility for preparing the institution decision on the merits and other non-discretionary issues is delegated to a panel of the Board. The Board panel will typically have 2 months to issue the decision on institution.

If a patent owner does not file a discretionary denial brief, responsibility will pass to a Board panel the day after the due date for such a brief. In that situation, after the due date for a discretionary

denial brief has passed, the Office will enter a notice into the record indicating the case is before a Board panel.

If a party has a question about a proceeding before the due date for a discretionary denial brief, they may contact the Board at 571-272-9797, from 8:30 a.m. to 5 p.m. ET on weekdays, or email Director_Discretionary_Decision@uspto.gov.

11. What are examples of "discretionary considerations" versus merits or other non-discretionary considerations, as mentioned in the Process Memorandum?

The Process Memorandum includes a non-exhaustive list of issues that may be raised in discretionary briefing. Parties are encouraged to address any fact or circumstance they believe bears on the Director's discretion to institute, including reasons not discussed in current Board precedent or in the Process Memorandum.

The "merits" considerations refer to whether there is a reasonable likelihood that a petitioner would prevail with respect to at least one of the claims challenged in an IPR petition, or whether it is more likely than not that at least one of the claims challenged in a PGR petition is unpatentable or the PGR petition raises a novel or unsettled legal question that is important to other patents or patent applications.

In addition to the discretionary considerations involving whether a petition presents a sufficient number of grounds/challenges of claims that meet the reasonable likelihood standard, as discussed in FAQ 9 (*see Chevron* and *Deeper*), non-discretionary considerations include those relevant to, for example, 35 U.S.C. §§ 311, 312, 315(a), (b), and (e), 322, and 325(a) and (e). Such considerations also may include, for example: (1) claim construction issues (*see*, *e.g.*, *Cambridge Mobile Telematics, Inc. v. Sfara, Inc.*, IPR2024-00952, Paper 12 (PTAB Dec. 13, 2024)); or (2) whether a petition meets the requirements of 37 C.F.R. § 42.104(b) (*see*, *e.g.*, *Adaptics Ltd. v. Perfect Co.*, IPR2018-01596, Paper 20 (PTAB Mar. 6, 2019) (informative)).

12. If a patent owner argues merits in a discretionary denial brief, and the Director determines that discretionary denial is not appropriate, will the Board panel consider merits arguments made in a discretionary denial brief or related briefing, such as an opposition brief by a petitioner?

No. Once the Director determines that discretionary denial is not appropriate, the Board panel will not consider papers filed by parties relating to discretionary considerations. Parties must make all their arguments (citing evidence, as needed) on the merits and other non-discretionary considerations in the petition, POPR, and any authorized reply or sur-reply. A Board panel will consider only arguments and evidence cited in those papers when determining whether to grant or deny institution.

However, the Director will consider the merits in the merits briefing if the parties ask the Director to do so. Parties should not repeat their merits arguments verbatim but should briefly explain why the merits are relevant.

13. If the Director's discretionary consideration decision addresses the strength of the merits in a petition (e.g., as part of *Fintiv* factor 6), is the Board panel bound by such findings or conclusions

in rendering a decision on institution?

A Board panel is not bound by merit findings or conclusions in a discretionary consideration decision but must explain in the decision on institution why the panel's findings and/or determination are different (citing the parties' evidence of record as relevant), if that occurs.

14. When should a petitioner file a *Sotera* or *Sand* stipulation if they wish to do so? What happens if a petitioner files a *Sotera* or *Sand* stipulation after the Director issues a decision on discretionary considerations?

A petitioner should file a *Sotera* or *Sand* stipulation as soon as practicable, so that a patent owner may address the impact of the stipulation in its discretionary denial brief. The Director will take into account whether the stipulation materially reduces overlap between the proceedings. Where the petitioner is relying on corresponding system art in a co-pending proceeding and/or several other invalidity theories, a stipulation may not be particularly meaningful because the efficiency gained by any AIA proceeding will be limited.

15. Will cases involving motions for joinder be handled differently with respect to processes or timing?

No, such cases will be handled the same way as discussed above. Thus, in a proceeding involving a motion for joinder, if a patent owner files a POPR (or the deadline for filing a POPR passes) after March 26, 2025, the bifurcated process is available. By contrast, if a patent owner had filed a POPR (or the deadline for filing a POPR had passed) on or before March 26, 2025, the bifurcated process is not available.

A decision on whether to grant a joinder motion and join a party to an instituted proceeding will be decided by a Board merits panel. To the extent a party disagrees with the Board's decision, that party may file a request for Director Review.

16. What is the process for requesting a reply brief to a petitioner's discretionary denial opposition brief?

A patent owner who wants to request a reply should send an email request, with a copy to counsel for all parties, to Director_Discretionary_Decision@USPTO.gov.

17. Who determines whether good cause exists for a petitioner to file a reply to a POPR, or for a patent owner to file a sur-reply to such a reply?

The Board panel. For example, as noted in the Consolidated Trial Practice Guide (Nov. 2019) (pp. 51–52), submission of patent owner testimonial evidence at the preliminary stage may warrant granting the petitioner a reply to such evidence. A request to file a reply to a POPR must make a showing of good cause. A decision concerning whether the petitioner will be afforded a reply and the appropriate scope of such a reply rest with the Board panel.

18. Who decides pro hac vice motions and other procedural motions that do not relate to discretionary considerations?

The Board panel will decide procedural motions that do not relate to discretionary considerations regardless of when those motions are filed. To facilitate resolution of procedural motions, the PTAB will assign a Board panel to the case before the Director issues a decision on discretionary decisions. That Board panel will decide all procedural motions.

Briefing requirements

19. What are the word limits for the discretionary considerations briefs?

As set forth in the Process Memorandum, a patent owner's discretionary denial brief is limited to 14,000 words and a petitioner's opposition brief is limited to 14,000 words.

20. What types of issues should the parties address in their discretionary considerations briefing?

Parties are encouraged to address any fact or circumstance they believe bears on whether the Office should or should not institute trial, including reasons not discussed in current Board precedent or the Process Memorandum.

21. How does the extent of the petition's reliance on expert testimony bear on discretion to institute IPR or PGR?

While the Board may consider expert testimony, as a matter of efficiency, extensive reliance on expert testimony and/or reasonable disputes between experts on dispositive issues may suggest that the questions are better resolved in an Article III court. The statute and our reviewing court require that petitions be based on prior art patents and printed publications. As the judges have technical and legal expertise, it is not necessary for an expert to explain every aspect of the prior art. It is most helpful if an expert is providing focused testimony, for example to provide helpful context or to explain terms of art. The failure to provide focused expert testimony may weigh against institution.

22. If the bifurcated process is available, is a patent owner required to address discretionary denial issues in a discretionary denial brief, or may it address such issues in a POPR instead?

If a patent owner wishes to raise any applicable bases for discretionary denial, it must do so in a discretionary denial brief. Absent extraordinary circumstances, the Director and the Board panel will not consider arguments relating to discretionary denial raised in a POPR.

If a patent owner does not file a discretionary denial brief, a Board panel will address any merits and other non-discretionary considerations raised by the parties in the petition, POPR, and, as applicable, any related papers, such as a reply and sur-reply (if authorized for good cause). Unless otherwise authorized by the Director, the Board panel will not address any discretionary considerations presented in the Process Memorandum.

23. If a patent owner's discretionary denial brief is due after the due date of the POPR in view of an extension notice (or by operation of the 1-month extension provided in the Process Memorandum), should the patent owner address discretionary issues in its POPR or only address such issues in its discretionary denial brief?

If a patent owner would like the Office to consider discretionary denial arguments, it must file a discretionary denial brief and address such issues in that brief, even if that brief is due after a POPR due date. As noted above in response to FAQs 9 and 22, absent extraordinary circumstances, a Board panel will not address any discretionary considerations presented in a POPR.

24. Should a petitioner address discretionary issues in its petition?

No. The petition should not address discretionary issues. A petitioner should raise any discretionary issues in its opposition to a patent owner's discretionary denial brief, including issues relating to 35 U.S.C. § 325(d), parallel proceedings, parallel petitions, serial petitions, and any other matter bearing on the Director's discretion to institute.

25. May a discretionary denial brief or opposition include arguments relating to merits or claim construction?

The parties should not treat a discretionary denial brief or opposition as an additional opportunity for merits briefing.

Notwithstanding the prohibition on incorporation by reference in 37 C.F.R. § 42.6(a)(3), when filing a brief for discretionary denial, a patent owner may direct attention to an anticipated POPR and evidence for a discussion of the merits. Similarly, in arguing about the strengths or weaknesses of the merits, the parties may refer to arguments made in the petition and cite to record evidence. As explained above in response to FAQ 8, the Director will receive the petition, the POPR, and the parties' discretionary briefing. Thus, the Director will consider the merits arguments made in the petition and the POPR when relevant to the discretion determination.

The parties' discretionary briefing may also address claim construction if it is relevant to the discretionary considerations.

26. Can parties introduce evidence with their discretionary briefing and, if so, what evidence can they introduce?

Yes. The parties may introduce evidence relevant to the discretionary issues raised in their briefing. However, parties should keep in mind that the Director will consider the petition, the POPR, and the evidence cited therein in determining whether discretionary denial is appropriate.

Requests for rehearing by the Board panel or Director Review

27. May I file a request for rehearing with the Board panel where the request raises issues regarding both (i) discretionary considerations and (ii) merits or other non-discretionary considerations?

No. A party may request rehearing by a Board panel only if the request raises issues regarding the merits and other non-discretionary considerations. A party may request rehearing by the Director if the request only raises discretionary considerations. If a party would like to request rehearing where the request will raise (i) discretionary considerations and (ii) merits or other non-discretionary considerations, that party must file a request for Director Review.

If the Director exercises discretion to deny institution, then a party may file a request for rehearing or Director Review within 30 days of the Director's decision. If the Director issues a decision determining that discretionary denial is not appropriate, a party should file a single request for rehearing or Director Review after the Board panel issues its decision. If the party is requesting Director review, the party shall file its request under the procedures set forth in 37 C.F.R. § 42.75(c) and submit the fee as set forth in 37 C.F.R. § 42.15(f).

If a party incorrectly files a request for rehearing by the Board panel, the Office will treat that request as a request for Director Review, and the party will be notified that it must refile the request as a request for Director Review and pay the Director Review fee.

28. May I file a request for rehearing of a decision on institution where the request raises issues regarding merits or other non-discretionary considerations, but does not raise discretionary considerations?

Yes, a party may file either a request for rehearing by the Board panel or a request for Director Review (but not both).

29. If circumstances change after the Director issues a decision on discretionary considerations (*e.g.*, a trial date changes), can a party raise that fact in a request for rehearing or a request for Director Review?

Yes, a party may raise changed circumstances in a request for rehearing or a request for Director Review filed within the applicable time period in exceptional cases.

Conflicts of interest

30. How will conflicts of interest be handled for the bifurcated process?

If the Director, a consulting member of the PTAB, or any other USPTO employee has a conflict of interest, they shall recuse themselves from the case.

In determining whether a conflict of interest exists, the USPTO follows the guidance set forth in the Standards of Ethical Conduct for Employees of the Executive Branch at 5 C.F.R. Part 2635 and will consult with the Department of Commerce Ethics Law and Programs Office, as necessary, to resolve any questions pertaining to conflicts of interest. Conflicts may include, for example, involvement in the examination or prosecution of the underlying patent or a related patent at issue. Further information is available in the U.S. Department of Commerce USPTO Summary of Ethics Rules.

As a matter of policy, the PTAB judges who consult with the Director will additionally follow the guidance on conflicts of interest set forth in the PTAB's SOP 1.

New paper types for discretionary denial briefing

31. How do I file a patent owner discretionary denial brief in P-TACTS?

After the PTAB issues a Notice of Filing Date Accorded (or a Notice of Defective Petition) and the PTAB accepts a patent owner's Mandatory Notice, the new paper type "PO Discretionary Denial Brief" will be available. To select the new paper type, a patent owner should: (1) log into P-TACTS; (2) go to My Docket and select the AIA review case number to open Case Viewer; (3) select the "+Add" button and File Other Document modal from the menu option; (4) select "PO Discretionary Denial Brief" from the list of paper types; (5) enter information into all required fields marked by a red asterisk beginning with paper type; (6) select "PO Discretionary Denial Brief"; and (7) click on "Add to List" and then "Submit."

32. How do I file a petitioner opposition to the patent owner discretionary denial brief in P-TACTS?

After a patent owner files its discretionary denial brief, the new paper type "PET Opposition to Discretionary Denial Brief" will be available. To select the new paper type, a petitioner should: (1) log into P-TACTS; (2) go to My Docket and select the AIA review case number to open Case Viewer; (3) select the "+Add" button and File Other Document modal from the menu option; (4) select "PET Opposition to Discretionary Denial Brief" from the list of paper types; (5) enter information into all required fields marked by a red asterisk beginning with paper type; (6) select "PET Opposition to Discretionary Denial Brief"; and (7) click on "Add to List" and then "Submit."

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