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UNITED STATES PATENT AND TRADEMARK OFFICE

Home > Patents > PTAB > Interim Director Discretionary Process

Interim Director Discretionary Process

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) are bifurcated between (i) discretionary considerations and (ii) merits and other non-discretionary considerations.

This webpage provides information on the discretionary considerations process and serves as a guide to parties on when and how to file discretionary briefing, and the process by which the Under Secretary of Commerce for Intellectual Property and Director of the USPTO (Director) will render decisions on discretion. All questions about the Director's Discretionary Process can be submitted to Director_Discretionary_Decision@uspto.gov.

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I. Interim director discretionary process

A. Overview

The Director has broad authority to determine whether to exercise discretion to institute a petition for IPR or PGR. When determining whether to exercise discretion to deny institution, the Director will consider existing **precedent** at the Patent Trial and Appeal Board (PTAB or Board), the **Consolidated Trial Practice Guide**, other considerations enumerated in the **Process Memorandum**, and any other fact or circumstance a party believes bears on the Director's discretion. The Director's decision will be based on a holistic review of the facts and circumstances. While the Director ordinarily will rely on facts and circumstances that the parties raise in their briefs, the Director will consider additional facts and circumstances where appropriate, for example:

- To maintain consistency with Discretionary Decisions that the Director has already issued
- Where there are facts and circumstances within the purview of the Office or Office operations that the parties are not in a position to raise
- Where there are facts and circumstances in the record or in the public domain that are

relevant to the determination

B. Discretionary considerations

The Process Memorandum includes a non-exhaustive list of considerations that may be raised in discretionary briefing, including *Fintiv*, *General Plastic*, *Advanced Bionics*, guidance from the **Consolidated Trial Practice Guide** (Nov. 2019), and the following exemplary circumstances:

- Whether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims
- Whether there have been changes in the law or new judicial precedent issued since issuance of the claims that may affect patentability
- The strength of the unpatentability challenge
- The extent of the petition's reliance on expert testimony
- Settled expectations of the parties, such as the length of time the claims have been in force
- Compelling economic, public health, or national security interests
- Any other considerations bearing on the Director's discretion

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.

C. Briefing

The petitioner and the patent owner are permitted to file briefs addressing discretionary considerations. The patent owner may file a brief that explains the facts and circumstances that warrant discretionary denial of the petition. The petitioner may file a brief that opposes the patent owner's request and explains why the Office should review the challenged patent in view of discretionary considerations. Each brief should provide a thorough explanation of the outcome that the party is advocating for, supported with facts and evidence. Additional details on party briefs are provided in Sections II–IV.
The petitioner and patent owner should not present discretionary considerations in the petition or the Patent Owner Preliminary Response (POPR), respectively. 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.

D. Stipulations

If a petitioner chooses to file a stipulation, such as a *Sotera* stipulation, they should file it as soon as practicable, so that the 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 in an AIA proceeding will be limited.

E. Decisions

The Director will issue a decision in every case where a patent owner has filed a brief requesting discretionary denial. The Director's decision in each case will be based on a holistic review of the facts and circumstances and may highlight certain considerations. Each decision will either (1) deny the petition or (2) refer the petition to the Board to handle in case in normal course.
If the Director's decision refers the Petition to the Board, 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.

F. Merits, non-discretionary considerations, and motions

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, whether a patent is eligible for PGR, 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 considerations involving whether a petition presents a sufficient number of grounds/challenges of claims that meet the reasonable likelihood standard, (*see Chevron Oronite Co. LLC v. Infineum USA L.P.*, IPR2018-00923, Paper 9 (PTAB Nov. 7, 2018) (informative) and *Deeper, UAB v. Vexilar, Inc.*, IPR2018-01310, Paper 7 (PTAB Jan. 24, 2019) (informative)), 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) (informative)); 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)).

The Board will decide procedural motions that do not relate to discretionary considerations regardless of when those motions are filed.

G. How to file

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."
7. Click on "Add to List" and then "Submit."

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."
7. Click on "Add to List" and then "Submit."

H. Optional process

A patent owner is not required to file a discretionary denial brief. However, if a patent owner wishes to raise any applicable bases for discretionary denial, it must do so in a discretionary denial brief. If a patent owner chooses not to file a discretionary denial brief, the Director typically will not issue a decision on discretionary considerations and responsibility will pass to a Board panel the day after the due date for such a brief. In that situation, the Office will enter a notice into the docket indicating the case is now before a Board panel to consider the merits and 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 that the parties have raised in the petition, a POPR, and any additional briefing that the Board panel has authorized.

II. Patent owner's discretionary denial brief

A. Availability

The bifurcated process for decisions on institution is available in all IPR and PGR proceedings in which the deadline for a patent owner to file a POPR is after March 26, 2025. In these proceedings, the patent owner may file a brief requesting discretionary denial of the petition.

B. Timing

A patent owner must file a discretionary denial brief within two months of the date on which a Notice of Filing Date Accorded (NFDA) is entered into the record of the proceeding. To ensure statutory deadlines are met, the parties may not stipulate to a later due date for a patent owner discretionary denial brief.

C. Content

In its brief, the patent owner should argue with particularity the circumstances that warrant discretionary denial. The patent owner may argue circumstances that warrant denial based on existing PTAB precedent, the Consolidated Trial Practice Guide, relevant considerations enumerated in the Process Memorandum, and any other consideration or circumstance that the patent owner believes bears on the Director's discretion.

i. Arguments directed to the strength of the merits

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, a patent owner may refer to arguments made in the petition and cite to record evidence. A patent owner should not repeat its merits arguments verbatim but should briefly explain why the merits are relevant. A patent owner should not treat a discretionary denial brief as an additional opportunity for merits briefing.

ii. Evidence

A patent owner may submit evidence in support of its discretionary arguments. However, a patent owner 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.

iii. Page limit

Effective on September 1, 2025, a patent owner's discretionary denial brief is limited to 20 pages. A patent owner may request additional pages and shall demonstrate good cause for the additionally requested pages.

III. Petitioner's brief opposing discretionary denial

A. Availability

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. The petition should not address discretionary issues.

B. Timing

A brief opposing a patent owner's discretionary denial request must be filed by the petitioner within one month after the due date for the patent owner discretionary denial brief, which is typically the POPR due date. To ensure statutory deadlines are met, the parties may not stipulate to a later due date for a petitioner brief.

C. Content

A petitioner brief should be responsive to the arguments raised in patent owner's discretionary denial brief and should raise any discretionary issues, 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. A petitioner brief should also explain why, notwithstanding discretionary considerations, the Office should institute review of the challenged patent, including all facts or circumstances, such as those set forth in current Board precedent or the Process Memorandum.

i. Arguments directed to the strength of the merits

Notwithstanding the prohibition on incorporation by reference in 37 C.F.R. § 42.6(a)(3), when filing an opposition to a brief for discretionary denial, a petitioner may direct attention to its petition and evidence for a discussion of the merits. A petitioner should not repeat its merits arguments verbatim but should briefly explain why the merits are relevant. A petitioner should not treat an opposition as an additional opportunity for merits briefing.

ii. Evidence

A petitioner may submit evidence in support of its discretionary arguments. However, a petitioner 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.

iii. Page limit

Effective on September 1, 2025, a petitioner's opposition to the patent owner's discretionary denial brief is limited to 20 pages. A petitioner may request additional pages and shall demonstrate good cause for the additionally requested pages.

IV. Additional briefing

A. General

A reply and a sur-reply to discretionary briefs are not authorized by default. A patent owner must demonstrate good cause for authorization to file a reply. Similarly, a petitioner must demonstrate good cause for authorization to file a sur-reply.

B. How to request

Parties should request authorization to file a reply or sur-reply as soon as practicable due to the time constraints on the discretionary considerations process. A party requesting briefing should send an email request, with a copy to counsel for all parties, to Director_Discretionary_Decision@USPTO.gov.

V. Director Discretionary Decisions

A. Process

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. The Director retains responsibility for resolving whether the proceeding should be denied on discretionary grounds, unless the Director otherwise states. 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 an IPR or a PGR, the Director may consult with other USPTO employees as needed, as long as those individuals do not have a conflict of interest.

B. Strength of the merits arguments

When parties present arguments regarding the strength of the merits, the Director will consult with USPTO personnel with relevant technical expertise. A Board panel is not bound by the Director's assessment of the merits 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.

C. Changes in circumstances

A party may raise changed circumstances, for example, a change in trial date, in a request for rehearing or a request for Director Review filed within the applicable time period.

D. How to locate Director Discretionary Decisions

A Director Discretionary Decision will be entered into the record of a proceeding. To find Director Discretionary Decisions on the **PTAB webpage**:

1. Select "**All PTAB decision data**".
2. Select the "**Documents**" tab on the "**PTAB Decisions**" page.
3. Search for "Director Discretionary Decision" under "Document type."
4. Select both "Director Discretionary Decision: Refer" and "Director Discretionary Decision: Deny".
5. Choose "Apply."

VI. Conflicts of interest

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**.

When the Director has a conflict in a proceeding involving a request for discretionary denial, the Director will delegate the authority to exercise discretion. A decision in such a proceeding will

identify that the Director took no part in the decision making.

VII. Questions

All questions relating to the discretionary denial process should be submitted to Director_Discretionary_Decision@uspto.gov.

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