

# Fintiv and the Resurgence of PTAB Discretionary Denials Involving the ITC

A photograph of a modern building's curved glass facade, showing multiple stories of windows reflecting the sky. The building is on the right side of the page, curving towards the center.

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On March 24, 2025, the United States Patent and Trademark Office (“USPTO”) issued a new Memorandum providing guidance on discretionary denials (or “*Fintiv* denials”) for inter partes review (“IPR”) challenges based on co-pending patent litigation. Notably, the 2025 Memo states that the Patent Trial and Appeal Board (“PTAB”) will again apply the *Fintiv* factors when there is a parallel proceeding before the International Trade Commission (“ITC”).

According to the Chief Administrative Patent Judge, even though an ITC decision does not have preclusive effect, the PTAB may still exercise discretion to deny institution when the ITC’s target date for a final determination precedes the PTAB’s final written decision deadline. See 2025 Memo at 2. The Board stated that in such cases multiple tribunals may adjudicate patent validity simultaneously, leading to increased “duplication and expenses for the parties and the tribunals.” *Id.*

This guidance reverses the USPTO’s 2022 Memorandum, which had categorically barred *Fintiv* denials based on parallel ITC investigations. That 2022 shift had temporarily opened the door for IPRs even in fast-moving ITC matters, but the 2025 Memo suggests a return to more aggressive discretionary denials.

For a time—and potentially once again—*Fintiv* was among the most consequential PTAB decisions. While the PTAB has discretion to deny the institution of IPR proceedings, statutory

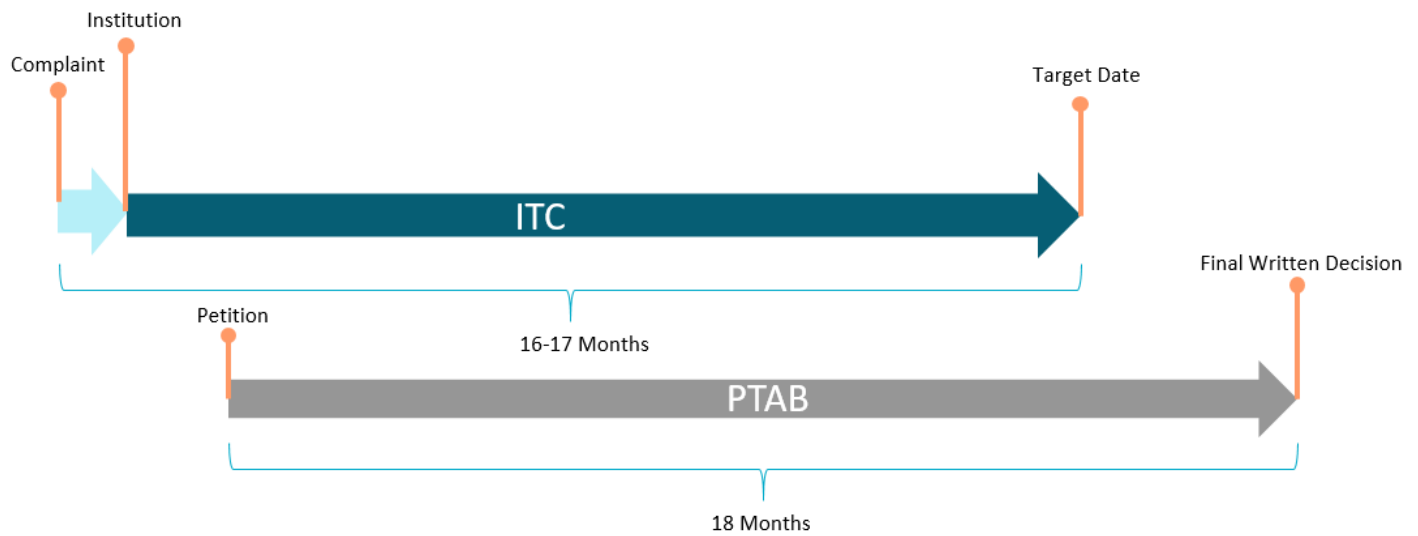
guidance on how to exercise this discretion was limited. The Board's precedential decisions in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) ("*Fintiv*") and *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) ("*Sotera*") stepped in to provide that missing framework. In *Fintiv*, six factors were identified for assessing whether to exercise discretionary institution denials when the PTAB's final written decision is expected around or after a co-pending district court trial date.

These decisions significantly impacted PTAB institution determinations, particularly in cases involving the ITC. Prior to the 2022 Memorandum, discretionary denials occurred in 38 such cases at a 71.7% denial rate. This result should not be surprising when you consider the first three *Fintiv* factors in light of typical ITC practice:

- (1) **Whether the district court has granted a stay.** The ITC is very seldom stayed for an IPR.
- (2) **Proximity of the court's trial date to the PTAB's Final Written Decision Deadline.** The ITC's target date is frequently 15-16 months from institution, meaning that it will generally move faster than any subsequently filed IPR proceeding.
- (3) **Investment in the parallel proceeding by the court.** The ITC's accelerated procedural schedule forces early engagement in substantive issues, including invalidity arguments, making PTAB intervention less justifiable under *Fintiv*.

With the return of *Fintiv* in the ITC context, petitioners face renewed urgency when faced with an ITC complaint. For instance, the PTAB has stated that a target date occurring eight months before a final written decision weighed "heavily in favor" of a discretionary denial. See *Roku, Inc. v. Universal Electronics Inc.*, PTAB-IPR2021-00263, Paper 11 (PTAB July 12, 2021). By contrast, a delta of two months only weighed "at least slightly" in favor, making it more likely to be outweighed by other factors. See *Stanley Black & Decker, Inc. et al v. Zircon Corporation*, PTAB-IPR2020-01572, Paper 10 (PTAB April 19, 2021).

In the 15 instituted cases reviewed, the ITC target date was generally no more than three months earlier than the PTAB's final written decision deadline. To achieve this, as illustrated below, petitioners may need to file an IPR within 1-2 months of an ITC complaint. That's not easy to achieve without advance notice of the infringement allegations.



As a result of this policy shift, the ITC may become the venue of choice for patent holders. While the return of prior *Fintiv* guidance also creates advantages for patent owners in several venues, no patent court in the United States matches the ITC’s speed and timing certainty. Given its ability to issue powerful exclusion orders and its historically high rate of discretionary denials for IPR challenges, the ITC may now be the most strategic venue for patent holders.

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