
Patents

How law firms manage USPTO director review requests

Rani Mehta October 17, 2024



Discussions about whether to seek director reviews can come up frequently with clients, even though actual grant rates are rare

Law firms don't seek director reviews at the USPTO often, but they have frequent conversations with clients about the procedure and have developed strategies around when to seek them.

The USPTO implemented its director review procedure in June 2021, shortly after the US Supreme Court **ruled** in *US v Arthrex* that the office needed to give the director more power to overturn Patent Trial and Appeal Board (PTAB) decisions.

The office, which had previously outlined interim rules regarding the process, issued a **final rule** on September 30.

With more than three years having gone by since director review was first introduced, **Managing IP** caught up with four firms about how they're using the process.

Trenton Ward, shareholder at **Greenberg Traurig** in Atlanta, says discussions about director reviews come up quite often with clients once the PTAB has issued a final written decision.

"The discussion is almost always present when that final written decision is released regardless of which side you're on," he says.

"If you're on the winning side, you're evaluating whether there's sufficient basis for the other side to request director review. If you're on the losing side, there's a discussion about whether there's sufficient basis for you to request director review."

But he notes that it's not that often that parties go ahead with the process.

"It's difficult and rare to be granted director review. So, there are typically only certain circumstances in which it's appropriate to pursue director review on behalf of a client."

Bigger picture

There are a few factors that firms look to when making these decisions.

First, they consider USPTO's criteria.

According to the USPTO, parties can seek director review of a decision to institute or not institute a PTAB proceeding when there was an abuse of discretion or an important issue of law and policy.

They can also request a review of a final written decision that involved an abuse of discretion, an important issue of law or policy, an erroneous finding of material fact, or an erroneous conclusion of law.

Thomas Rozylowicz, principal at [Fish & Richardson](#) in Washington DC, says he would be more likely to advise clients to seek director review when there's a significant issue of law or policy that's implicated.

"It should affect several other cases, not just your case," he says.

Ward at Greenberg Traurig agrees that he would be more likely to recommend director review to clients when there are policy considerations that would be of interest to the USPTO.

"If there are factual issues concerning a particular case, those are circumstances which are not likely to be able to gain the attention of the director," he says.

"But if you have an issue that's relevant to a policy consideration – especially one that's on the mind of the agency, perhaps that's a situation in which you would want to consider a director review."

He adds that policy considerations can change with time.

"Something that may not be a significant concern for policy reasons today may be a concern for policy reasons a year from now."

Practitioners also seek to understand how the issues for which a director review is sometimes granted are evolving.

Jessica Kaiser, partner at [Perkins Coie](#) in Colorado, says she's recently seen director reviews on more fact-bound issues such as how the panel applies the obviousness standard to the particular evidence in a case.

"Initially, we saw more director review decisions related to discretionary institution [of PTAB proceedings] and now we're starting to see more different kinds of issues."

Firms may also advise their clients to take advantage of appeal options that existed before the director review process came into effect.

Parties can appeal final written PTAB decisions to the US Court of Appeals for the Federal Circuit.

They can also ask the original panel of PTAB judges who heard their cases to rehear them – both for final written decisions and institution decisions.

Chris Kelly, principal at [Meunier Carlin & Curfman](#) in Atlanta, says his firm hasn't encountered many final written decisions that it has been dissatisfied with.

"But some don't go our way and have had issues related to prior art or claim construction. In some cases, we have requested [panel] rehearing," he says.

He notes that most panel hearing and director review requests aren't granted, however.

Kaiser at Perkins Coie says parties should also consider whether a panel understood the arguments before seeking panel review.

"If they did and just disagreed with you, you likely don't want to go back to the panel again. So, then you're looking to see whether a different audience would give a potentially better result."

Client conversations

Though firms often discuss director reviews with clients, many don't usually do so until later in a particular PTAB matter.

Rozyłowicz at Fish & Richardson says that he typically wouldn't discuss director review with clients until after there's an adverse decision from the PTAB.

He says clients are usually aware that director review is an option.

However, it's typically not clear whether a director review is appropriate until after an institution decision or a final written decision.

What's in these decisions is key to helping firms and clients determine whether to seek director review or panel review, according to Rozyłowicz.

"The basis by which you would choose one vehicle or the other only comes about after analysing the issues that come out in the board's order," says Rozyłowicz.

Ward at Greenberg Traurig adds that director review conversations don't usually come up at the beginning of the case.

"It's only when you feel that the PTAB has incorrectly decided an issue that you would consider filing a director review request."

It's not that often that these conversations will lead to parties filing director review and even rarer that a review is granted.

But firms that can help their clients navigate this process at least have one more option when they feel that the PTAB got it wrong.

Topics

Analysis

United States

Patents

Greenberg Traurig

Fish & Richardson

Perkins Coie

Meunier Carlin & Curfman



Rani Mehta

SENIOR REPORTER Managing IP

Rani reports on all aspects of IP in the US and the Americas, particularly trademarks and copyright. Based in New York, she covers in-house and private practice lawyers' concerns and insights into the market.
