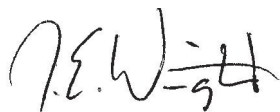

Editors' Introduction

A review of 2023 reveals it was an active and impactful year in shaping the policy and practice before the Patent Trial and Appeal Board (PTAB or Board) at the U.S. Patent and Trademark Office (USPTO). In fact, all three branches of the U.S. Government were actively addressing PTAB policy and practice. As it has for the past decade, the U.S. Court of Appeals for the Federal Circuit provided guidance on important issues that arise during PTAB trials, such as the appropriate scope of reply briefing, as well as issues at the interface between PTAB and district court litigation, such as estoppels stemming from PTAB proceedings. Congress, again, proposed legislation that would significantly alter the current state of PTAB practice, if passed. And last, but certainly not least, Director Vidal—in her first full year at the helm of the USPTO—used her Director Review authority to provide real-time guidance to the Board and to practitioners. In parallel, the Director also engaged with stakeholders through the administrative rulemaking process to help shape future policy.

This *Year in Review* synthesizes key events and decisions from 2023 into a digestible guide that we hope will serve as a helpful reference for those who practice before, or adjacent to, the PTAB. As in the past, many of our articles follow a data-driven approach in order to sift out trends and to identify best practices for parties on both sides of the “v.”

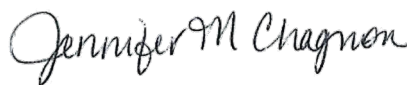
In the first half of our review, we provide in-depth analysis of discretionary denial of IPR and PGR petitions. One article covers the Director’s broad discretion under Section 314(a) as elucidated by the Director’s guidance on how to apply the *Fintiv* factors. A second article examines the more specific statutory discretion under Section 325(d) with respect to previous USPTO proceedings. We also provide a summary of the new Director Review procedures available to parties dissatisfied with institution decisions or final written decisions. And we summarize key precedential Board decisions from 2023, as well as decisions coming out of the Director Review process. We then provide some key PTAB statistics from 2023. In the second half of our review, we cover the latest in statutory estoppels, as well as highlight key Federal Circuit decisions impacting Board procedure. We also take a close look at developments in *ex parte* reexamination practice as an alternative to AIA challenges. Finally, we revisit and update our 2021 analysis of the intersection between post grant proceedings and standard essential patents (SEPs).

As in our past *Year in Review* publications, we encourage you to not simply read the articles, but also to critically challenge our analysis and consider the impacts on your patent litigation and portfolio development strategies. We thank our authors and our entire PTAB trials team—which was named the 2023 Post-Grant Firm of the Year for the United States at IAM’s Global IP Awards—for making this publication possible. We appreciate your interest in this report and welcome the opportunity to discuss PTAB matters and how they may impact your business. If you have questions or comments, please do not hesitate to contact us directly to start the conversation.



Jon E. Wright*

Director, Trial & Appellate Practice Group,
PTAB Trials Practice Co-Chair



Jennifer Meyer Chagnon

Counsel, Electronics Practice Group



Jason A. Fitzsimmons

Director, Mechanical Design Practice Group



Richard M. Bembien

Director, Electronics Practice Group