

Still Looking for Breadcrumbs to Navigate Through the Maze of IPR Discretionary Denials

A photograph of a modern building with a curved glass facade, showing multiple floors and windows, set against a light blue sky.

1 MIN READ

January 30, 2024, 10:42 AM

USPTO Director Vidal continues to take an active role in *inter partes* reviews, granting Director review of a set of discretionary denials of institution under § 325(d). In *Nokia v. Soto*, IPR2023-00680-682, the PTAB denied institution, finding that even while the asserted grounds relied on prior art not previously presented to the Patent Office, previously cited references were asserted in the same way, i.e., primary references targeted the claimed electrical components and secondary references were cited for the claimed form factor. The PTAB relies on a two-part test to determine whether discretionary denial is appropriate: (1) whether the same or substantially similar art or arguments were previously presented; and (2) if so, whether there was a material error in considering the previously presented art or arguments.

Even though the grounds raised by the petitions may have been combined similarly with respect to the challenged limitations, the Petitioner's request for review stressed the differences between the way those references disclosed electrical components and form factors, and the different motivations to combine those references over previously presented motivations. Further specific guidance on what differences are material to the discretionary denial analysis would shed light for Petitioners, Patent Owners, and PTAB panels alike.

[S]imilar to these other proceedings before the Office, Petitioner relies on Wei for its teaching of a pluggable form factor and proposes to combine that

teaching with those of a reference cited for electrical signal processing components.

 www.uspto.gov/...



Related Services

Intellectual Property

To subscribe to our publications, [click here](#).

News & Insights

- ACI Forum on Pharma & Biotech Patent Litigation USA 2025

SPEAKING ENGAGEMENT INTELLECTUAL PROPERTY

- CCWC 21st Annual Career Strategies Conference
SPEAKING ENGAGEMENT
- Fordham 52nd Annual Conference on International Antitrust Law and Policy
SPEAKING ENGAGEMENT ANTITRUST
- Kisaco Research Trade Secret Legal Protection Conference 2025
SPEAKING ENGAGEMENT INTELLECTUAL PROPERTY
- SCCE 23rd Annual Compliance & Ethics Institute
SPEAKING ENGAGEMENT ANTITRUST
- 29th Annual IBA Competition Conference
SPONSORSHIP ANTITRUST
- Key Appellate Decisions Shaping Antitrust Strategy
WEBINAR ANTITRUST
- New Frontiers of Antitrust – 16th Annual International Conference of Concurrences Review
SPEAKING ENGAGEMENT ANTITRUST
- MCCA Pathways Conference
SPONSORSHIP ANTITRUST
- HNBA/VIA Annual Convention 2025
SPONSORSHIP ANTITRUST