



April 17, 2025

The Honorable Coke Morgan Stewart
Acting Under Secretary of Commerce for Intellectual Property and
Acting Director of the United States Patent and Trademark Office
U.S. Department of Commerce
1401 Constitution Avenue, NW
Washington, DC 20230

Dear Acting Under Secretary Stewart:

On behalf of the Innovation Alliance, I write to thank you for your leadership in ensuring Patent Trial and Appeal Board (PTAB) proceedings are “quick and cost effective alternatives to litigation.”¹ Specifically, the Innovation Alliance commends the U.S. Patent and Trademark Office (USPTO), under your leadership, for rescinding the June 21, 2022, USPTO memorandum regarding discretionary denials in PTAB post-grant proceedings² (“2022 Memo”) and for your March 26, 2025 memorandum clarifying the Director’s role in oversight of the PTAB³ (“2025 Memo”). These changes—which provide needed guidance for patent holders and PTAB petitioners—restore certainty and clarity to the process of Director review of PTAB petitions.

The Innovation Alliance is a coalition of U.S.-based research and development-focused technology companies representing innovators, patent owners, and stakeholders from a wide range of industries that believes in the critical importance of maintaining a strong patent system that supports innovative enterprises of all sizes. We are committed to strengthening the U.S. patent system to promote innovation, economic growth, and job creation, and we support legislation and policies that help to achieve those goals.

The 2022 Memo added significant uncertainty to PTAB petitions involving patents subject to parallel federal district court litigation. The memo constrained the USPTO Director’s statutory discretion to deny such PTAB petitions, declaring that the PTAB will not deny a petition that “presents compelling evidence of unpatentability,” even if the petition satisfies the factors that would justify discretionary denial, as set forth in the PTAB’s precedential decision in *Apple v. Fintiv*. Rescinding this guidance

¹ H.R. Rep. No. 112–98 (2011), at 48.

² Mem. from Katherine K. Vidal to Members of the PTAB re Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation, June 21, 2022, https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621.pdf.

³ Mem. from Coke Morgan Stewart to All PTAB Judges re Interim Processes for PTAB Workload Management, March 26, 2025, <https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf>.

eliminates the ambiguous “compelling evidence” standard and is consistent with the PTAB’s mandate and statutory scheme.

Your 2025 Memo further clarifies the discretionary denial process to ensure patent owners are not subject to unfair and duplicative proceedings in both the PTAB and federal district courts. By bifurcating decisions on whether to institute a PTAB proceeding “between (i) discretionary considerations and (ii) merits and other non-discretionary statutory considerations,” your updated guidance expedites the discretionary denial review process, and, for petitions allowed to proceed, clarifies that the *Fintiv* factors still apply. Clarifying the Director’s discretion to deny these kinds of petitions is imperative for the PTAB to function as it was intended and for the USPTO to continue achieving its mission to advance American innovation.

In addition to a fair and efficient PTAB, the Innovation Alliance supports strong and professional examination of patents. As a fee-funded agency, the USPTO has the resources to maintain a fully staffed corps of patent examiners at no cost to the taxpayers. We encourage you to preserve patent examiner staffing levels to ensure the U.S. patent system operates uninterrupted to issue high-quality patents.

Thank you again for your work to protect inventors and strengthen the PTAB. We look forward to continuing to work with you to promote U.S. global innovation leadership.

Sincerely,

A handwritten signature in black ink, appearing to read "Brian Pomper", written over a horizontal line.

Brian Pomper
Executive Director

cc: Secretary Howard Lutnick, United States Department of Commerce