

USPTO ISSUES TWO NOTICES SIGNIFICANTLY AFFECTING IPR PROCESS

On Oct. 17, 2025, the United States Patent and Trademark Office (USPTO) issued two significant notices. First, the newly appointed Director of the USPTO, John Squires, issued an open letter and memorandum to the public and the Patent Trial and Appeal Board (PTAB), reclaiming authority on whether to institute an *inter partes* review (IPR) or post-grant review (PGR) proceeding on the merits. The PTAB had previously determined whether or not to allow petitioners to proceed with IPR petitions. IPRs are a procedure for challenging the validity of an issued U.S. patent before the USPTO by a third party. The PTAB decides whether or not to institute a review by determining if the petition has a reasonable likelihood of success on at least one claim.

According to the memorandum, Squires will personally decide whether to institute proceedings, issuing determinations through concise “summary notices.” If the Director determines that review is appropriate based on discretionary, merits-based, or other considerations, the USPTO will issue a summary notice granting institution. If the Director determines review is not appropriate, the USPTO will issue a summary notice denying institution. For cases involving novel or complex issues, the Director may issue a detailed decision or refer the matter to one or more PTAB judges. According to the Director, this policy shift aims to reduce duplicative patent challenges and reinforce administrative efficiency.

That same day, the Federal Register also issued a [Notice of Proposed Rulemaking](#) to change access to IPR proceedings. The Notice proposes amending 37 C.F.R. 42.108 to limit when IPR proceedings may be instituted, and in particular would bar institution of IPRs in three circumstances:

1. when claims of the challenged patent have been previously found valid in other proceedings;
2. where parallel litigation involving the patent will likely reach a validity decision first; and
3. where petitioners refuse to stipulate against raising any anticipation or obviousness challenge against the patent in other venues.

Comments to this proposed rule are due on Nov. 17, 2025.

The newly proposed subsection (e) would prohibit institution of IPR proceedings if there is a prior adjudication of validity by a district court, the

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Court of Appeals for the Federal Circuit, the International Trade Commission (ITC) or the PTAB. Newly proposed subsection (f) would prohibit institution of IPR proceedings if it is “more likely than not” that a district court or the ITC will issue a decision on the claims being challenged, or if the PTAB issues a final written decision in another proceeding on the claims being challenged.

These new subsections would prevent a party from filing an IPR petition if one has already been filed for the same claims—even if the parties are different and/or the prior art is different.

The proposed new subsection (d) would introduce new mandatory stipulation requirements. Specifically, institution of an IPR would be prohibited unless a petitioner files a stipulation stating that it will not raise any invalidity challenges under U.S.C. §102 or §103 in any other proceeding. This would significantly alter litigation strategies for parties, including limiting the type of invalidity challenges that the petitioner can preserve at trial in district court. IPRs can only be based on patents and printed publications. Thus, this new rule would prevent petitioners from raising other invalidity bases in court.

Both of these notices are important because they represent potentially significant changes to PTAB proceedings and will significantly change litigation strategies for many clients.

KEY TAKEAWAYS FOR CLIENTS:

- No IPR will be instituted or maintained where a parallel proceeding is “more likely than not” to reach a decision before the final written decision in the IPR. Thus, petitioners will need to be prepared to file IPR petitions very early after a district court action is filed, to ensure that a final written decision from the PTAB will precede the likely date the action will be resolved.
- Institution of IPR is prohibited unless each petitioner files a stipulation with both the PTAB and any other tribunal where the parties are, or may become, litigants regarding the challenged patent. The required stipulation forecloses invalidity challenges in other venues that could not have been brought as grounds for an IPR (e.g., prior sale, public use and prior art systems).
- An IPR will not be instituted where a determination of invalidity at the district court has been reversed by the Federal Circuit.
- Any determinations on an independent claim automatically extend to its dependent claims.
- Given that some petitioners will not receive substantive reasons for denial of their petitions (instead, “summary notices”), they may also not have a basis on which to request rehearing.
- No IPR will be instituted when there has been a prior finding that the



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patent is not invalid by a district court, the ITC or USPTO, regardless of the parties to that earlier proceeding or the prior art reviewed. This will require increased diligence in monitoring institutions and proceedings.

We will continue to monitor changes with the USPTO and provide you with updates. For further guidance, please contact your regular AT attorney or one of the listed authors.