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Expert Analysis

Trending At The PTAB: A Potential Barrier To Serial Challenges

By Reinaldo Franqui Machin and Forrest Jones · [Listen to article](#)

Law360 (October 31, 2025, 6:37 PM EDT) -- This article is part of a [monthly column](#) that reviews the latest issues facing attorneys practicing before the [Patent Trial and Appeal Board](#). In this installment, we examine how the [U.S. Patent and Trademark Office](#) is seeking to expand restrictions on post-grant proceedings.

The U.S. Patent and Trademark Office under the Trump administration has made its goal to limit inter partes review usage clear by, for example, rescinding the interim discretionary denial memo of prior Director Kathi Vidal and implementing a new bifurcated discretionary denial process.

Together, these moves have dramatically increased the institution denial rate of these post-grant proceedings.

The agency's latest proposed rulemaking, issued Oct. 16, seeks to expand these restrictions, while making them more permanent via a proposed rulemaking limiting post-grant proceedings only to patents that have never been adjudicated on validity or patentability, with some exceptions.

The proposed rulemaking would also require petitioners to file a stipulation, broader than *Sotera*, never to pursue invalidity challenges to the patent under either Title 35 of the U.S. Code, Section 102, or Section 103, in order for the USPTO to consider instituting a post-grant proceeding on a previously unchallenged patent. These significant changes would greatly affect PTAB practice and strategy.

Proposed New Rules

On Oct. 16, the USPTO issued a notice of proposed rulemaking, published the following day in the Federal Register, seeking "modifications to the rules of practice for inter partes review," and providing a 30-day comment period for the public ending on Nov. 17.[1]

The notice explains that IPRs were meant to be "a quick and cost-effective alternative[]" to district court patent litigation," but "[w]hen IPR proceedings cover the same ground as district court litigation, they cease to be an 'alternative' and can substantially increase litigation costs," arguing this contravenes Congress' intention.[2]

According to the notice, "[a]pproximately 54% of all IPR petitions filed since the passage of the AIA are one of multiple petitions against the same patent." [3] So, the view of the USPTO is that "[e]ven extremely strong patents become unreliable when subject to serial or parallel validity challenges." [4]

Responsive to these stated concerns, the USPTO proposes significant changes in the notice regarding when



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IPRs will and will not be instituted. For example, key changes advanced in the proposed rules include:[5]

- Requiring all petitioners to file a stipulation that they "will not raise grounds of invalidity or unpatentability with respect to the challenged patent under 35 U.S.C. 102 or 103 in any other proceeding;"
- Barring institution against any patent previously considered or adjudicated to be valid or not unpatentable in any of a U.S. district court trial, U.S. district court summary judgment, [U.S. International Trade Commission](#) investigation, PTAB final written decision, ex parte reexamination or Federal Circuit decision; and
- Barring proceedings where any U.S. district court, the ITC or the PTAB is likely to make a validity or patentability determination before the projected PTAB's final written decision.

Although these proposed changes are in line with recent PTAB practice developments, if implemented, these would have broader impact and would be less subject to change with a new administration.

Sotera+ Stipulation Now a Requirement

According to the proposed Title 37 of the Code of Federal Regulations, Section 42.108(d),

Inter partes review shall not be instituted or maintained unless each petitioner files a stipulation with the Board and any other tribunal where it is litigating or later litigates regarding the challenged patent, stating that if a trial is instituted, the petitioner and any real party in interest or privy of the petitioner will not raise grounds of invalidity or unpatentability with respect to the challenged patent under 35 U.S.C. 102 or 103 in any other proceeding.

At first glance, this new requirement looks similar to what many petitioners already file in a post-grant proceeding: a Sotera stipulation agreeing to not raise the same grounds or grounds that could have raised in the first petition if institution is granted.[6]

However, the proposed stipulation is noticeably broader. Under these proposed rules, a petitioner and any corresponding real party-in-interest would have to agree to never raise any challenges under Section 102 or Section 103 against the same patent — in any other proceeding — if instituted.

This would give petitioners one shot to challenge a patent, regardless of whether there is additional evidence that statutorily cannot be considered at the PTAB, such as system art, or new evidence surfaces after a first petition is filed that there was no way for a petitioner to have been aware of.

Given that the standard for unpatentability is lower at the PTAB (preponderance) than the standard for invalidity is in district court (clear and convincing), many petitioners may still favor challenging a patent at the PTAB in lieu of district court.

However, if this rule change is implemented, the stakes are higher, as a petitioner choosing the PTAB would likely have to forgo all other avenues for challenging the same patent under Section 102 or Section 103.

Barring Institution Against a Patent Previously Challenged in Any Forum

According to the proposed Section 42.108(e),

Inter partes review shall not be instituted or maintained if a challenged claim or an independent claim from which a challenged claim depends:

- (1) U.S. District Court Trial — Was found not invalid under 35 U.S.C. 102 or 103 by a district court or jury following a bench trial or jury trial in a decision or verdict that has not been vacated or reversed in relevant part;
- (2) U.S. District Court Summary Judgment — Was found not invalid by a district court in a summary judgement decision finding no dispute of material fact under 35 U.S.C. 102 or 103 that has not been vacated or reversed in relevant part;
- (3) U.S. International Trade Commission — Was found not invalid under 35 U.S.C. 102 or 103 in initial or final determination of the U.S. International Trade Commission that has not been vacated or reversed in relevant part;
- (4) PTAB Final Written Decision — Was found not unpatentable in a final written decision of the Board under 35 U.S.C. 318(a) or 328(a) that has not been vacated or reversed;
- (5) Ex Parte Reexamination — Was found patentable in an office action or decision by the Board following a reexamination request filed under Chapter 30 of Title 35 United States Code by someone other than the patent owner, the patent owner's real party in interest or privy; or
- (6) Federal Circuit — Was found unpatentable or invalid under 35 U.S.C. 102 or 103 in a decision, but that decision was reversed in relevant part by the [U.S. Court of Appeals for the Federal Circuit](#)

According to the proposed rules, "Inter partes review shall not be instituted or maintained" if the claims were found not invalid under Section 102 or Section 103 by any of the listed tribunals, including district courts, the ITC, the USPTO in either PTAB or ex parte reexamination proceedings, or the Federal Circuit.

Like the new stipulation requirement proposal described above, this proposed rule would also have a broader effect than it seems at first glance.

For example, where the new discretionary denial process considered prior adjudications as part of a holistic approach for discretionary denials, it was not necessarily a stand-alone basis for a denial. This proposed rule would simply bar a would-be petitioner from challenging a patent if it had been found not unpatentable or not invalid by the PTAB, district courts, ITC or reexaminations.

Two of these are particularly notable: the ITC and ex parte reexaminations.

First, while the ITC will assess patent validity issues as part of its investigations, it cannot invalidate patents. So, while difficult, a patent owner can still assert a patent found to be likely invalid by the ITC, and an accused infringer can still challenge the validity of a patent the ITC has determined is likely valid.[7] This rule seems to foreclose an avenue for challenge that is available elsewhere after a ITC investigation is complete.

Second, for reexaminations, as the rule contemplates, patent owners can and do submit requests for

reexamination themselves. While the rules state they only apply to requests filed by someone other than the patent owner, it seems likely there could be instances where discovery is needed to establish the connection between previous requesters, which can be anonymous, and the patent owner.

Barring Institution When Another Forum Is More Likely to Adjudicate First

According to the proposed Section 42.108(f),

Inter partes review shall not be instituted or maintained if, more likely than not, any of the following will occur, with respect to a challenged claim or an independent claim from which a challenged claim depends, before the due date for the final written decision pursuant to 35 U.S.C. 316(a)(11):

- (1) U.S. District Court — A district court trial in which a party challenges the patent under 35 U.S.C. 102 or 103;
- (2) U.S. International Trade Commission — an initial or final determination of the U.S. International Trade Commission with respect to 35 U.S.C. 102 or 103; or
- (3) PTAB Final Written Decision — issuance of a final written decision by the Board under 35 U.S.C. 318(a) or 328(a).

As with the other proposed rules, this one also expands what has been implemented in the new bifurcated discretionary denials.

Currently, the holistic approach considers whether it is more likely than not that another proceeding will make a determination before the PTAB's final written decision. This proposed rule takes it a step further and makes this factor determinative for institutions.

Nonetheless, based on the language of this proposed rule and current PTAB practice, petitioners would likely still be able to present and argue trial statistics to secure institution.

Ultimately, though, a patent owner's strategic reliance in forums with speedier patent dockets, such as the ITC or the [U.S. District Court for the Eastern District of Texas](#), will likely foreclose a petitioner's ability to secure institution in many instances.

Instituting in Extraordinary Circumstances

According to the proposed Section 42.108(g),

If a panel of the Board determines that extraordinary circumstances warrant institution notwithstanding paragraphs (d), (e), or (f) the Panel shall refer to matter to the Director who may personally institute inter partes review. Extraordinary circumstances may include a determination by the Director that the prior challenge barring institution was initiated in bad faith, e.g., for the purpose of preventing future challenges, or that the prior challenge is rendered irrelevant in view of a substantial change in a statute or precedent of the [Supreme Court of the United States](#). Unusual and extraordinary circumstances shall not include new or additional prior art, new expert testimony, new caselaw (except as provided above) or new legal argument, or a prior challenger's failure to appeal. Neither the Director nor the Board shall waive the requirements of paragraphs (d), (e), or (f) of this section except as provided in this paragraph. Frivolous or abusive petitions under this paragraph may be appropriately sanctioned, including with an award of attorneys' fees.

To undermine potential gamesmanship with the new rules by patent owners or other interested parties, the notice includes a provision allowing the director to personally institute an IPR in instances considered extraordinary.[8]

Examples of what constitutes extraordinary circumstances are limited, and notable "shall not include new or additional prior art, new expert testimony, new caselaw (except as provided above) or new legal argument, or a prior challenger's failure to appeal."

It is also unclear from the rule what the precise mechanism for requesting an exception for extraordinary circumstances will be. Given the limited examples and broad discretion the director is relying on, case law will likely be necessary to determine what other considerations fall under the exceptional circumstances exception.

Implementation Is Not a Given

Although the USPTO submitted these proposed rules, their ultimate implementation is not a given.

For example, in May 2024, then-Director Vidal published a proposed rule seeking to dramatically shift terminal disclaimer practices. The proposal drew over 300 public comments, including letters by former USPTO directors pushing hard against the changes, and then it was formally withdrawn in December of the same year, and the rules were never implemented nor pursued via other avenues.

In these proposed rules, the USPTO has provided a 30-day period for the public to comment, so the overall support or opposition remains to be seen. As the public comment period progresses, the fate of these rules will depend on stakeholder feedback and the agency's response to diverse perspectives.

Regardless of the outcome, the proposed rules underscore the evolving nature of PTAB practice and the ongoing debate over how to balance innovation incentives with fair and efficient patent adjudication.

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[1] Revision to Rules of Practice Before the Patent Trial and Appeal Board, 90 Fed. Reg. 48335 (proposed Oct. 17, 2025) (to be codified at 37 CFR Part 42) (reciting the substance of the October 16, 2025, Notice) (hereinafter referred as "Notice").

[2] Id. at 48335 (quoting H.R. Rep. No. 112-98, at 48 (2011)).

[3] Id. at 48336.

[4] Id. at 48335.

[5] Id. at 48338.

[6] [Sotera Wireless Inc. v. Masimo Corporation](#) , IPR2020-01019, Paper 12 (December 1, 2020)

(Precedential as to § II.A).

[7] 19 U.S.C. § 1337 (1994); [Texas Instruments Inc. v. Cypress Semiconductor Corp.](#) , 90 F.3d 1558, 1568-69 (Fed. Cir. 1996) (relying on statute and legislative history of the Trade Reform Act of 1974, amending the Tariff Act of 1930, to state that "Congress did not intend decisions of the ITC on patent issues to have preclusive effect") (citing, inter alia, [Tandon Corp. v. United States Int'l Trade Comm'n](#) , 831 F.2d 1017, 1019 (Fed.Cir.1987)).

[8] Notice at 48341.

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[The 2025 Regional Powerhouses](#)

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- [3Amgen Again Challenges Colo. Price Cap For Arthritis Drug](#)
- [4J&J's Janssen Says 3rd Circ. Should Reverse \\$1.6B FCA Win](#)
- [5Hawaii Judge Declares FDA's Mifepristone Regs Unlawful](#)
- [6FDA Unveils Plan To Speed Biosimilar Drugs To Market](#)
- [7Ga. Panel Says McClain Standard Applies In Sterigenics Case](#)
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