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Tracking Challenges To USPTO's Discretion

Policy

By [Dani Kass](#) · [Listen to article](#)

Law360 (December 11, 2025, 7:21 PM EST) -- Leaders at the [U.S. Patent and Trademark Office](#) have significantly altered the [Patent Trial and Appeal Board](#) playing field since March, making changes to institution reviews that have led to unprecedented levels of petition denials. A steady stream of companies has challenged those changes through mandamus petitions to the Federal Circuit, and here Law360 tracks where those petitions stand.

In 2025, institution rates at the PTAB [dropped](#) from 68% in the first quarter of 2025 to 51% in the second and 35% in the third, according to data published by RPX. The institution rate had not dropped below 60% since 2021.

Challenges to USPTO's Discretionary Denial Approach

There has been a steady stream of mandamus petitions asking the Federal Circuit to address significant changes the current administration has made to PTAB practice.

Case status: [Granted](#) [Response filed](#) [Response due](#) [Denied](#)

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Petitioner(s)	Case number	Date filed	Question	Status
Tessell	26-117	Dec. 8, 2025	Can the USPTO deny petitions based on assignor estoppel?	Response due December 22
Tesla	26-116	Dec. 2, 2025	Can the USPTO deny challenges based on time-to-trial statistics in parallel litigation?	Response due December 16
Intel; Lenovo	26-113	Nov. 24, 2025	Can the USPTO deny petitions based on the existence of ex parte reexaminations as an alternative?	Response due December 22
Kangxi	26-115	Nov. 24, 2025	Can the USPTO deny challenges to older patents based on "settled expectations" and can it deny petitions based on parallel litigation at the U.S. International Trade Commission?	Response filed
Google	26-111	Nov. 20, 2025	Can the USPTO deny challenges to older patents based on "settled expectations"?	Response due December 12

Disclaimer: This chart updates to show the real-time status of the petitions, rather than the status at the time of this story's publication.

Table: Ben Jay • Created with Datawrapper

The America Invents Act gives the director the ability to turn away PTAB petitions for discretionary reasons, and the bounds of that discretion have been questioned for years. The discretion analysis has focused on multiple or serial petitions challenging one patent, and whether the timing of related litigation made an inter partes review or post-grant review a good use of agency resources.

The latter has been the subject of debate since the first Trump administration, when then-USPTO Director Andrei Iancu set precedent in the agency's Fintiv case that laid out factors for when a petition would likely

be denied. His successor, Kathi Vidal, made Fintiv denials much harder, but used the same framework. Iancu and Vidal both left the discretion review up to administrative patent judges, who would also decide the merits of the petition.

They also both allowed a challenger to pass the Fintiv review if they submitted so-called Sotera stipulations in parallel litigation stating they wouldn't raise the same or similar arguments if the PTAB institutes the petition.

USPTO Deputy Director Coke Morgan Stewart, while serving as acting director, announced in March that she would be taking over the discretionary part of the review in a new bifurcated process. When she deemed a petition worthwhile, she referred it to the PTAB for administrative patent judges to make a call on the merits. She didn't issue official guidance on how she would approach that analysis, instead rolling it out through hundreds of short institution decisions.

She made two large changes, the first significantly strengthening Fintiv and the second introducing a new concept.

With Sotera stipulations, parties only gave up the right to assert arguments they could have made at the PTAB, which in IPRs are limited to obviousness and anticipation arguments, supported by earlier patents and printed publications. Stewart now requires challengers to give up the rights to all arguments, including patent eligibility, enablement and written description based on prior art that can't be raised at the PTAB, such as physical devices referred to as system art.

The second change, drawing huge applause from patent owners and outcry from alleged infringers, was the creation of a settled expectations factor. Ultimately, Stewart held that a patent owner earns the right to assume its patent won't be challenged, largely after six years of being in force.

There were some exceptions allowing older patents to be challenged, such as if there was no reason for an alleged infringer to have that patent on its radar or if it compellingly asserts that the patent examiner made an error during prosecution. On the other side, there were exceptions where patents that were part of a larger family gained settled expectations within their first years of life.

John Squires, who became the USPTO director in September, took over the discretion decision-making in October and assumed the additional role of reviewing merits. His decisions are listed in a document citing only the case numbers, not any analysis. He denied 100% of petitions in October and November before finally clearing six in December for administrative patent judges to hold trial over.

Each of these decisions is final and unappealable under the AIA, which is why patent challengers have turned to mandamus petitions, raising questions about the constitutionality of settled expectations, the application of the Sotera stipulation change to already pending petitions and various other parts of the analysis.

Squires initiated a rulemaking process in October for feedback on these changes and received nearly 11,000 comments by the USPTO's December due date.

--Editing by Adam LoBelia.

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