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JANUARY 2026 PTAB REVIEW

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Introduction

Wilson Sonsini Goodrich & Rosati is pleased to present our *January 2026 PTAB Review*.

We begin with a review of notable developments at the Patent Trial and Appeal Board (PTAB), including changes to institution procedures, and precedential and informative decisions. Next, we explore several appellate decisions relevant to PTAB trials. Finally, we examine potential rule changes submitted for comment.

We hope you find our *January 2026 PTAB Review* to be a useful resource for insight on recent, meaningful developments at the PTAB. As always, should you have any questions or comments on any of the matters discussed in this report, please contact a member of the firm's Post-Grant practice or your regular Wilson Sonsini attorney.

Notable Developments at the PTAB

Updates to Institution Procedures

Starting in early 2025, the U.S. Patent and Trademark Office (USPTO) introduced significant changes to the pre-institution process for *inter partes* reviews (IPRs) and post-grant reviews (PGRs), including changes to the discretionary factors the Director considers in deciding whether to grant institution. In the first quarter of 2025, the USPTO issued memoranda changing the pre-institution process for IPRs and PGRs, with the Director taking direct control over the discretionary part of institution decisions and modifying the standards applied when deciding whether to exercise that discretion.[1]

One modification was to adjust the impact of *Sotera* stipulations, in which a petitioner stipulates that it will raise no arguments in district court that reasonably could have been raised at the PTAB. During the previous administration, these stipulations allowed petitioners to categorically avoid discretionary denial due to overlap of issues under *Fintiv*. Under the current administration, *Sotera* stipulations are weighed against other factors that may still favor denial.

A second modification was to introduce a new basis for the USPTO to exercise discretion and deny a petition: settled expectations. The Director has subsequently held that patents that issued at least six years earlier than the filing of an IPR petition are entitled to settled expectations, meaning that challenges to such patents will generally be denied absent special considerations such as a showing of examiner error.[2]

The manner in which pre-institution arguments are presented to the PTAB was also updated. Previously, after a petition was filed and received a Notice of Filing Date Accorded, a patent owner would have three months to file its Patent Owner Preliminary Response, providing reasons to deny institution both for discretionary reasons and on the merits of the case. The briefs would then be considered by the PTAB Panel for an institution decision. Under the new procedure, following the Notice of Filing Date Accorded, the patent owner first files a brief solely concerning discretionary reasons to deny institution. Then, the petitioner files an opposition to the request for discretionary denial, and in tandem the patent owner files its Patent Owner Preliminary Response, focusing on the merits. The Director evaluates both discretionary and merits-based arguments and issues a summary notice concerning institution. If instituted, the case is then forwarded to the PTAB Panel.

Though the updated procedure is relatively new, numerous decisions have issued that provide guidance. In January 2026, USPTO Director John Squires designated several PTAB decisions as precedential or informative. Each concerns issues relating to discretionary denial or institution of challenges at the PTAB. These designated decisions provide direction on important aspects relating to institutions of future challenges.

Precedential Decisions

- The PTAB will institute multiple petitions challenging a patent only in rare circumstances. In *PacifiCorp v. Birchtech Corp.*,[3] for each challenged patent, one petition relied on prior art predating the earliest asserted priority date and a second petition used intervening prior art. On review, the Director concluded the panel abused discretion in granting two petitions that challenge the same claims. Each petition presented multiple (10-13) grounds, indicating there was ample room to present multiple grounds within one petition. Director Squires concluded, "this was not a 'rare' circumstance that justified the filing of multiple petitions against each patent." Instead, the PTAB should have decided the priority issue or instituted only the first-ranked petition challenging each patent.
- A time-barred petitioner generally may not join an ongoing PTAB proceeding. In *Elong Int'l USA Inc. v. Feit Electric Co., Inc.*,[4] a petitioner attempted to join a previously instituted proceeding. Factors favoring discretionary denial of the Elong challenge included parallel litigation and the fact that—if joinder were granted—the USPTO would have to maintain a proceeding even if the original petitioner settled or was no longer involved in the proceeding, potentially imposing a burden on the PTAB. In *Realtek Semiconductor Corp. v. ParkerVision, Inc.*,[5] a time-barred petitioner's attempt to join an IPR as expressly permitted by 35 U.S.C. §315(c) was rejected for failure to show "exceptional circumstances."

- Non-institution of a PGR does not weigh in favor of discretionary denial of an IPR challenge. In *LifeVac LLC v. DCSTAR Inc.*,[6] LifeVac challenged a patent in an IPR after being denied institution of a PGR on the same patent. Then-Acting Director Coke Morgan Stewart declared that "petitions for inter partes review will generally not be discretionarily denied because of an earlier petition for post-grant review when the post-grant review was not instituted."
- Discretionary denial is not favored against PGRs. In *Multi-Color Corp. v. Brook & Whittle Ltd.*,[7] while some factors weighed in favor of discretionary denial, the challenge was nonetheless referred to the PTAB. Then-Acting Director Stewart explained, "[p]etitions for post-grant review are favored because they must be filed no later than nine months from the grant of the patents…, are close in time to examination, and occur before expectations in the patent rights are strongly settled."

Informative Decisions

- A petitioner's failure to provide clarity on real parties in interest can be fatal to its petition, particularly in cases raising questions about involvement of foreign governments. In *Yangtze Memory Techs. Co., Ltd. V. Micron Tech., Inc.*,[8] the patent owner argued, *inter alia*, that the petitioner failed to identify all real parties in interest (RPIs) including a foreign government that purportedly controlled the petitioner. Director Squires issued an Order to Show Cause for parties to brief the matter further, and the petitioner failed to provide clarity as to actual identity of RPIs. "With its identification of RPIs in dispute, it was Petitioner's burden to bring forth evidence or arguments demonstrating that it named all RPIs….Here, Petitioner failed to carry that burden." Director Squires thus concluded the petitions "are not in condition for consideration" and denied institution.
- A significant change in patent law may overcome a patent owner's settled expectations. In *Top Glory Trading Group Inc. v. Cole Haan LLC*,[9] Top Glory challenged a design patent that had been examined and issued under an obviousness standard that the U.S. Court of Appeals for the Federal Circuit had since abrogated. Director Squires explained, "it is an appropriate use of Office resources to consider the merits of Petitioner's challenge despite any settled expectations Patent Owner may have."
- Discretionary denial should not be exercised to deny a second petition challenging a patent where the second challenge is necessitated by the patent owner's assertion of additional claims in district court. In *Savant Techs. LLC v. Feit Electric Co., Inc.*,[10] the PTAB had instituted the petitioners' previous IPR challenging a patent. The patent owner then asserted two new claims in district court. Within three months, the petitioners filed a second petition. Then-Acting Director Stewart concluded that the patent owner's later assertion of additional claims justified the filing of the second petition.
- A large number and vast scope of patents weighs against discretionary denial. In *Tesla, Inc. v. Intellectual Ventures II LLC*,[11] parallel district court litigation involved 11 patents spanning nine different families with a range of subject matter. Then-Acting Director Stewart concluded that "the Board is better suited to review a large number of patents involving diverse subject matter."
- Issuance eight years before IPR challenge favors discretionary denial. In *Dabico Airport Sols. Inc. v. AXA Power ApS*,[12] then-Acting Director Stewart exercised discretionary denial where the challenged patent had been in force for almost eight years, creating settled expectations. Although there was no bright-line rule, she indicated that the longer a patent has been in force, the more settled a patent owner's expectations should be.
- Material error by the USPTO counsels against discretionary denial. In *Padagis US LLC v. Neurelis, Inc.*,[13] the petitioner persuasively demonstrated that material error had occurred during prosecution of the challenged patent. Then-Acting Director Stewart concluded that where a "Petitioner appears to show a material error by the Office, [] it is an appropriate use of Office resources to review the potential error."
- Settled expectations may arise even with a patent that has been in force for a short period of time. In *Amgen Inc. v. Bristol-Myers Squibb Co.*,[14] the challenged patent had been in force only three years. Then-Acting Director Stewart explained that there may still be good reasons why a patent owner

has strong settled expectations in a recently issued patent, "for example an explanation of how an extraordinary amount of investment, time, and resources dedicated to research, development, trials, and regulatory approval correlates to settled expectations." In *Amgen*, the patent owner did not sufficiently demonstrate such reasons; nonetheless the USPTO has designated this decision as informative for this teaching.

- A patent that has not previously been applied to a petitioner's technology space creates settled expectations for the petitioner and may outweigh the patent owner's settled expectations. In *Home Depot U.S.A., Inc. v. H2 Intellect LLC*,[15] the challenged patent had been in force for over 12 years, creating strong settled expectations. Nonetheless, the petitioner persuasively argued that "the challenged patent has not been commercialized, asserted, marked, licensed, or otherwise applied in its technology space." This weighed against the patent owner's settled expectations and "weigh in favor of Petitioner's expectations."
- A petitioner's expectations of non-enforcement of a patent counsels against discretionary denial. In *Apple Inc. v. Ferid Allani*,[16] the petitioner showed it "'did not expect enforcement' of the patent" because it had previously discussed the patent with the patent owner but the patent owner did not assert the patent against the petitioner for another 11 years. Additionally, the challenged patent had since expired. These considerations counseled against discretionary denial.
- Unexplained inconsistent claim construction favors discretionary denial. In *Sun Pharm. Indus., Inc. v. Nivagen Pharm., Inc.*,[17] the patent challenger had taken different claim construction positions in IPR than in the parallel district court proceeding. Then-Acting Director Stewart concluded that while "a party is not necessarily precluded from arguing different claim construction positions before a district court and the Board, a party should explain why different positions are warranted." Where a petitioner does not sufficiently explain why it advanced different claim construction, this favors discretionary denial.
- Licensing of the challenged patent demonstrates a patent owner's settled expectations. In *Alliance Laundry Sys., LLC v. PayRange LLC*,[18] then-Acting Director Stewart determined that though "the challenged patent has not been in force for a significant period of time..., Patent Owner presents evidence that it has licensed the challenged patent, which creates some settled expectations," which favored discretionary denial.

Appellate Review of America Invents Act (AIA) Post-Grant Proceedings

The Federal Circuit issued several important decisions in the latter half of 2025, including clarifications on permissible uses of applicant-admitted prior art in IPRs, on the scope of estoppels from PTAB decisions, and on the scope of review for institution decisions, among other issues. Summaries of select decisions appear below.

Prior Art

In *Shockwave Medical, Inc. v. Cardiovascular Systems, Inc.*, 142 F.4th 1371 (Fed. Cir. 2025), the court considered how applicant-admitted prior art may be used to support a petition for IPR. The court held that, under 35 U.S.C. § 311(b), applicant-admitted prior art may be used to show general background knowledge supporting a petition but cannot itself be part of a ground for unpatentability. Petitioner CSI filed an IPR on Shockwave's patent directed to angioplasty balloon catheters that use electronic pulses to treat atherosclerosis i.e., the thickening or hardening of the arteries. The PTAB determined all challenged claims but one (claim 5) were unpatentable as obvious. The parties appealed and cross-appealed accordingly. The court affirmed the PTAB's decision with respect to all but claim 5 and reversed the PTAB on claim 5.

On appeal, Shockwave had argued the applicant-admitted prior art should not have been allowed to form the basis for the PTAB's determination. The court disagreed and differentiated this case from *Qualcomm Incorporated v. Apple Inc.*, 24 F.4th 1367 (Fed. Cir. 2022) *("Qualcomm I")*, and *Qualcomm Incorporated v. Apple Inc.*, 134 F.4th 1355 (Fed. Cir. 2025) *("Qualcomm II")*. In *Qualcomm I and II*, the court held that only patents and printed publications may form the basis for an IPR petition and thus the IPR petitions expressly grounded on applicant-admitted prior art are improper. While *Shockwave* reaffirmed that only patents and

printed publications may form the basis for a petition, the court distinguished *Qualcomm I* and *II* because CSI never used applicant-admitted prior art as the basis for its petition—it only used the admissions as background to show the knowledge of a "Person Having Ordinary Skill in the Art," or POSA. The court rejected Shockwave's argument that the PTAB treated the applicant-admitted prior art as a ground, holding that it is how the petitioner, and not the PTAB, describes the prior art that controls. Because CSI's petition never phrased the applicant admitted prior art as the basis for any obviousness arguments, the court affirmed the PTAB's final determination on all challenged claims besides claim 5.

In *Merck Sereno S.A. v. Hopewell Pharma Ventures, Inc.*, 159 F.4th 10 (Fed. Cir. 2025), the court addressed whether, under pre-AIA 35 U.S.C. §102(e), a reference can be prior art when it names a subset of the inventors listed on a subsequently filed patent application. The court held the implicated reference was prior art because it did not evince the joint work of all named inventors on the patent application.

Merck argued that the PTAB improperly required complete identity of the joint inventors and the authors of a previous reference to exclude it as prior art. The court rejected that argument, explaining that while no bright-line rule applies, "the portions of the reference disclosure relied upon must reflect the collective work of the same inventive entity identified in the patent to be excluded as prior art." Though that showing might "be made by fewer than all the inventors," it "must evince the joint work of them all to avoid being considered a work 'by another' under the statute."[20] Indeed, "[a]ny incongruity in the inventive entity between the inventors of a prior reference and the inventors of a patent claim renders the prior disclosure 'by another,' regardless of whether inventors are subtracted from or added to the patent."[21] The court rejected Merck's argument that it lacked sufficient notice because the PTAB's holding is contrary to the USPTO's Manual of Patent Examining Procedure (MPEP). The court explained that its holdings govern over the MPEP but, regardless, the MPEP was not contrary to the case law in this situation.

Estoppel, Interferences, and Derivation Proceedings

In re Gesture Techs Partners, LLC, No. 25-1075 (Fed. Cir. Dec. 1, 2025) addressed whether a party is estopped from "maintaining a proceeding" under 35 U.S.C.§ 315(e)(1) when the proceeding in question is an ex parte reexamination. The court held that a party does not "maintain" an ex parte reexamination and thus cannot be estopped from doing so. Samsung Electronics had requested an ex parte reexamination of a Gesture Techs patent, which the USPTO granted. Concurrently, two IPRs (one by Samsung) against claims of the same patent were ongoing, which eventually led to final written decisions cancelling multiple claims. Gesture Techs argued that Samsung, as a party to one of the IPRs, was estopped from maintaining the ex parte reexamination under 35 U.S.C. §315(e)(1) because of the final written decision from its IPR. But the court rejected that argument, reasoning that a party requesting an ex parte reexamination does not "maintain" the proceeding—the USPTO does. The requester's sole input is the request and an optional reply. After those inputs, the USPTO takes over and the requester does not have any further involvement; therefore, the requester cannot be estopped from "maintaining" the proceeding.

In *IGT v. Zynga Inc.*, 144 4th 1357 (Fed. Cir. 2025), the court held that the PTAB's decision to decline to apply interference estoppel was unreviewable. In 2010, the PTAB had declared an interference between IGT's patent and Zynga's application, in which Zynga argued the claims of IGT's patent were obvious, but the PTAB terminated the interference because Zynga's claims lacked adequate written description. Years later, Zynga filed an IPR citing a new combination of prior art not previously presented to the PTAB in the interference proceeding. IGT argued Zynga was estopped from its arguments because it could have raised them in the interference but chose not to. The PTAB declined to estop the IPR because 1) the interference had been terminated; and 2) estopping Zynga would be unfair because the interference began before the post-AIA rules on IPR proceedings were promulgated. The USPTO Director upheld this outcome, holding that interference estoppel does not apply to IPR proceedings. The Federal Circuit concluded that IGT's appeal of that decision was barred under 35 U.S.C. §314(d) as an appeal of an institution decision, even though the PTAB addressed interference estoppel arguments in its final written decision.

In *Global Health Solutions LLC v. Selner*, 148 F.4th 1363 (Fed. Cir. 2025), the court issued its first decision

on an AIA derivation proceeding. The court affirmed the PTAB's decision that appellant-petitioner Global Health Solutions LLC (GHS) did not prove that the earlier applicant, Marc Selner, derived his application from GHS's inventor, Bradley Burnham. GHS brought the derivation proceeding after Selner filed an application for a method of treating wounds with a nanodroplet ointment. The PTAB determined that, although Burnham conceived of the invention and communicated it to Selner via email, Selner had had already conceived of the invention and communicated it to Burnham via email earlier the same day; thus, GHS failed to prove its derivation claim.

The court affirmed, explaining that the essential elements of a derivation claim have not changed with the adoption of the AIA. Thus, a later-filing petitioner still must show conception of the invention and communication of the conception to the respondent before the respondent files its patent application. However, in AIA derivation proceedings, the focus is on whether petitioner conceived and communicated the invention first rather than who was the first to invent. The respondent, however, can rebut this prima facie case by showing it independently conceived the invention prior to receiving the communication regarding the invention from the petitioner. The court acknowledged that the PTAB erred by focusing on the pre-AIA derivation proceeding consideration—who was first to invent—but determined the error was harmless because the PTAB indirectly determined Selner independently conceived of the invention and thus did not derive his invention from GHS when the PTAB found Selner was the first to invent.

Patentable Weight and Subject Matter

In *Bayer Pharma Aktiengesellschaft v. Mylan Pharmaceuticals Inc.*, 152 F.4th 1400 (Fed. Cir. 2025), Bayer appealed the PTAB's decision finding all claims of Bayer's patent on methods administrating rivaroxaban with aspirin to prevent major cardiac events unpatentable as anticipated or obvious. The court affirmed the PTAB's decision for broader claims 1-4 (administrating rivaroxaban and aspirin) but remanded claims 5-8, which specified a dose form.

Bayer argued the PTAB erred by construing "in amounts clinically proven effective" to be not limiting; instead, Bayer contended the term requires clinical proof of efficacy shown, for instance, through clinical trial results. The court declined to determine whether "clinically proven effectively" is limiting because, regardless, the term is a functionally unrelated limitation that would fail to make the claims patentable. Citing *King Pharmaceuticals, Inc. v. Eon Labs, Inc.*, 616 F.3d 1267, 1277–79 (Fed. Cir. 2010), the court held that a patent owner cannot patent a previously known method of administering the drug by also requiring it to perform well. In other words, even if the limitation was limiting, it would not make the challenged claims patentable because it would still lack a new and unobvious functional relationship with the rest of the method the PTAB already determined to be unpatentable. The court distinguished *Allergan Sales, LLC v. Sandoz, Inc.*, 935 F.3d 1370 (Fed. Cir. 2019), where certain "wherein" clauses were deemed material to patentability, because in *Allergan*, the "wherein" clauses modified the overall composition such that they were functional limitations restricting the universe of potential compositions having the claimed ingredients in the claimed amounts. In *Bayer*, however, the term "clinically proven effective" in the term modifies the actual amounts of rivaroxaban and aspirin to be administered to a patient—yet these amounts are already specified in the claim—so "clinically proven effective" does not further define the administered dosage. The court thus concluded "clinically proven effective" is not material to patentability regardless of whether it is limiting.

In *Rideshare Displays, Inc. v. Lyft, Inc.*, No. 23-2033 (Fed. Cir. Sept. 29, 2025), the court reversed the PTAB's decision that had allowed Rideshare to amend some of its claims. The PTAB considered the amended claims to be directed to eligible subject matter under 35 U.S.C. §101. Significantly, the PTAB had applied USPTO policy guidance to conclude the amended claims were directed to an abstract idea but nonetheless provided a technical solution to a technical problem such that the claims are directed to patent eligible subject matter. The court disagreed and concluded that, at *Alice* step 2, the claims involved nothing more than invoking a computer as a tool in claims covering an abstract idea. The court, in a footnote, acknowledged that the PTAB used the USPTO guidelines, but expressly declined to adopt the USPTO framework and instead evaluate the situation under *Alice* two-step test.

Ability to Appeal

In general, the USPTO's decisions regarding institution are not reviewable on appeal.[22] In *Ethanol Boosting Systems, LLC v. Ford Motor Company*, 162 F.4th 1151 (Fed. Cir. 2025), the court rejected the patent owner's appeal of IPR decisions finding challenged claims unpatentable. The appeal was premised on the duration of the 15-month pendency of a rehearing request filed by the petitioner after institution was initially denied. While the request was pending, the Federal Circuit reversed a district court claim construction decision for the same claims. The rehearing request was granted and the case instituted because of the change in claim construction. The patent owner attacked the proceeding on the basis that the 15-month pendency of the rehearing request constituted an improper "stay." The court concluded the appeal was barred under 35 U.S.C. §314(d) as a challenge to the PTAB's institution decision. The court reasoned that PTAB rehearing requests have no particular deadline and also that the PTAB had a perfectly good reason to await the court's decision on the construction of the claims at issue.

Mandamus Petitions

In an attempt to secure court review of the USPTO's policy changes on the use of discretion to deny institution of IPR petitions (discussed above), at least 15 mandamus petitions have been filed at the Federal Circuit. So far, the court has repeatedly affirmed that the type of mandamus relief sought in these cases may be available for constitutional claims, but has uniformly rejected arguments that applying the new policies to petitions that had already been filed violated the petitioner's due process rights under the Fifth Amendment or the Administrative Procedures Act.[23] The court also rejected mandamus petitions challenging the USPTO's "settled expectations" policy.[24] One further mandamus petition challenging the USPTO's consideration of "road-mapping" as a discretionary factor was withdrawn prior to issuance of a decision.[25]

The Federal Circuit has yet to address a further seven mandamus petitions challenging the USPTO's discretionary policies. Three advance further challenges to the USPTO's "settled expectations" policy.[26] Three others raise challenges to the USPTO's consideration of ex parte reexaminations,[27] the use of time-to-trial statistics as part of the Fintiv analysis,[28] and assignor estoppel[29] as bases for discretionary denial. The most recent mandamus petition, filed by Volkswagen on January 6, 2026, challenges the constitutionality of U.S. Congress's grant of "unfettered discretion" to deny institution, arguing that it violates the nondelegation doctrine.[30]

Article III Standing

In *U.S. Inventor, Inc. v. USPTO*, 156 F.4th 1306 (Fed. Cir. 2025), the court revisited the question of associational standing to sue with respect to discretionary denials at the USPTO and found appellants U.S. Inventor, Inc. and National Small Business United (collectively, USI) lacked Article III standing. USI initially petitioned the USPTO for rulemaking that would limit the Director's discretionary authority to institute IPRs and PGRs. When the USPTO denied the petition, USI sued the USPTO in district court. But the district court dismissed, concluding USI lacked both organizational and associational standing. For associational standing, the district court agreed the alleged harm from the denial of USI's petition was too speculative to describe the requisite concrete injury necessary to confer standing.

USI only appealed the associational-standing holding. The court affirmed, concluding USI lacked associational standing because they failed to show at least one member suffered a nonspeculative injury as a result of the USPTO's denial of USI's petition. The court distinguished *Apple Inc. v. Vidal*, 63 F.4th 1 (Fed. Cir. 2023), where the court decided Apple did have standing to challenge the USPTO Director's guidance to consider certain factors when instituting petitions with parallel proceedings because Apple's injuries were not speculative.

Potential Rules Package

As one of his first actions following confirmation as the new Director of the USPTO, Director Squires requested comment on sweeping changes to the rules that govern institution of an IPR before the PTAB.[31] Published for public comment in October 2025, the proposed changes would revise 37 C.F.R. § 42.108 by adding four subsections expanding requirements for a petition seeking institution.[32]

More specifically, under potential subsection (d), an IPR would not be instituted or maintained unless a petitioner files a stipulation with the PTAB and any other tribunal where it is litigating the challenged patent.[33] The stipulation would have to state 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."[34] This rule change, if proposed and adopted, would limit petitioners to challenging validity of a patent under §§ 102 or 103 at only one of either the PTAB or in another tribunal. Should a petitioner choose to litigate a patent's validity at the PTAB, the petitioner would be barred from raising any grounds under §§ 102 or 103 before other tribunals, including grounds that cannot be brought before the PTAB, such as challenges based on public use, the on-sale bar, or product art. Moreover, the potential stipulation would apply to the challenged patent as a whole, not limited to only the claims challenged in a petition.

Potential subsection (e) would establish that an IPR could not be instituted or maintained for claims that previously survived validity or patentability challenge in district court, the International Trade Commission (ITC), in an IPR, or in an ex parte reexamination filed by someone other than the patent owner.[35] Under the published language, the IPR would not be instituted or maintained at the PTAB if any one of the challenged claims falls into one of these categories.[36]

Proposed subsection (f) would bar instituting or maintaining an IPR if it would be "more likely than not" that a district court, ITC, or PTAB decision addressing the validity of a challenged claim under §§ 102 or 103 would issue before the due date for a final written decision.[37]

Finally, potential subsection (g) would allow a panel to ask the Director for an exception to the foregoing bars for "extraordinary circumstances." Extraordinary circumstances would include earlier challenges brought in bad faith (e.g., to prevent future challenges) or vitiated by a substantial change in law.[39] Circumstances that would not be deemed "extraordinary" include challenges based on new or additional prior art, new expert testimony, new caselaw or legal argument, or a prior challenger's failure to appeal.[40]

Director Squires's reasons for considering rule changes include prevention of serial and parallel challenges to patents, which Director Squires identifies as "a significant problem for the patent system," with the changes intended to "enhance fairness, efficiency, and predictability in patent disputes."[41] The period for receiving comments on the proposed rule closed on December 2, 2025. It is anticipated that the USPTO's response to comments and adoption of a final rule, whether as currently proposed or otherwise, will occur sometime in early 2026.

About Wilson Sonsini's Post-Grant Practice

The professionals in Wilson Sonsini Goodrich & Rosati's Post-Grant practice are uniquely suited to navigate the complex trial proceedings at the United States Patent and Trademark Office (USPTO). We have extensive experience before the PTAB, representing clients in numerous new trial proceedings and in countless reexaminations and patent interference trials. Our practice includes professionals with decades of experience at the PTAB, including former USPTO personnel. Our core team leverages firmwide intellectual property expertise to provide comprehensive IP solutions for clients that cover strategy, prosecution, licensing, enforcement, and defense.

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Endnotes

1. See Memorandum, Coke Morgan Stewart, Acting Director of the USPTO, Interim Processes for PTAB Workload Management (Mar. 26, 2025), *available at* https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf; Memorandum, Scott R. Boalick, Chief Administrative Patent Judge, Guidance on USPTO's Recission of "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation" (Mar. 24, 2025), *available at* https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_recission_20250324.pdf. The Director subsequently took direct control of the merits portion of institution decisions as well. See Memorandum, John A. Squires, Director of the USPTO, Director Institution of AIA Trial Proceedings (Oct. 17, 2025), *available at* https://www.uspto.gov/sites/default/files/documents/Director_Institution_of_AIA_Trial_Proceedings.pdf.
2. *See, e.g.*, *Taiwan Semiconductor Mfg. Co. v. Marlin Semiconductor, Inc.*, IPR2025-00847, Paper 11 at 3-4 (Sep. 3, 2025).
3. IPR2025-00687, -00688, -00717, -00718, Paper 40 (Jan. 12, 2026) (precedential) (designated Jan. 12, 2026).
4. IPR2025-00258, Paper 16 (June 25, 2025) (precedential) (designated Jan. 9, 2026).
5. IPR2025-00324, Paper 11 (June 25, 2025) (precedential) (designated Jan. 9, 2026).
6. IPR2025-00454, Paper 11 (July 11, 2025) (precedential) (designated Jan. 9, 2026).
7. PGR2025-00025, Paper 10 (July 16, 2025) (precedential) (designated Jan. 9, 2026).
8. IPR2025-00098 and -00099, Paper 38 (Jan. 15, 2026) (informative) (designated Jan. 16, 2026).
9. IPR2025-01395, Paper 18 (Jan. 12, 2026) (informative) (designated Jan. 12, 2026).
10. IPR2025-00260, Paper 16 (June 12, 2025) (informative) (designated Jan. 9, 2026).
11. IPR2025-00217, Paper 9 (June 13, 2025) (informative) (designated Jan. 9, 2026).
12. IPR2025-00408, Paper 21 (June 18, 2025) (informative) (designated Jan. 9, 2026).
13. IPR2025-00464, -00465, -00466, Paper 12 (July 16, 2025) (informative) (designated Jan. 9, 2026).
14. IPR2025-00601, -00602, -00603, Paper 9 (July 24, 2025) (informative) (designated Jan. 9, 2026).
15. IPR2025-00480, Paper 11 (Sept. 4, 2025) (informative) (designated Jan. 9, 2026).
16. IPR2025-00856, Paper 11 (Sept. 5, 2025) (informative) (designated Jan. 9, 2026).
17. IPR2025-00893, Paper 18 (Sept. 19, 2025) (informative) (designated Jan. 9, 2026).
18. IPR2025-00950, Paper 11 (Sept. 19, 2025) (informative) (designated Jan. 9, 2026).
19. *Merck*, 159 F.4th at 23.
20. *Id.*
21. *Id.*
22. 35 U.S.C. §314(d).
23. *In re SAP Am., Inc.*, Nos. 25-132, 25-133 (Fed. Cir. Jun. 16, 2025); *In re Motorola Sols., Inc.*, No. 25-134 (Fed. Cir. June 23, 2025); *In re Google LLC*, No. 25-144 (Fed. Cir. Aug. 18, 2025); *In re HighLevel, Inc.*, No. 25-148 (Aug. 28, 2025); *Motorola*, 159 F.4th 30 (Fed. Cir. 2025); *HighLevel*, 2025 U.S. App. LEXIS 32065 (Dec. 9, 2025)
24. *In re Cambridge Indus. USA Inc.*, No. 26-101 (Dec. 9, 2025); In re SanDisk Techs., Inc., No. 25-152 (Dec. 9, 2025).
25. *In re Maplebear Inc.*, No. 26-105 (Oct. 22, 2025), voluntarily dismissed (Dec. 30, 2025).

Endnotes (cont.)

26. *In re Google LLC*, No. 26-111 (Nov. 20, 2025); In re Kangxi Commc'n Techs. Co., No. 26-115 (Nov. 24, 2025); In re Kahoot! *AS, No. 26-119 (Dec. 29, 2025).*
27. *In re Intel Corp.*, No. 26-113 (Nov. 24, 2025).
28. *In re Tesla, Inc.*, No. 26-116 (Dec. 2, 2025).
29. *In re Tessell, Inc.*, No. 26-117 (Dec. 8, 2025).
30. *In re Volkswagen Grp. of Am., Inc.*, No. 26-123 (Jan 6, 2026).
31. Revision to Rules of Practice Before the Patent Trial and Appeal Board, 90 Fed. Reg. 48335 (Oct. 17, 2025) (to be codified at 37 C.F.R. § 42.108).
32. *Id.*at 48341.
33. *Id.*
34. *Id.*
35. *Id.*
36. *Id.*
37. *Id.*
38. Revision to Rules of Practice Before the Patent Trial and Appeal Board, 90 Fed. Reg. at 48341.
39. *Id.*
40. *Id.*
41. *Id.* at 48336-37.

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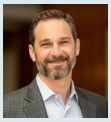

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