

Finally, the USPTO is biting the IPR bullet

Roberto Dini

15 November 2025



USPTO Director John Squires

New USPTO Director John Squires has taken several important steps to improve the *inter partes* review process since taking on the role in September. This is good news for the US patent system and for innovation.

In the space of 24 hours in mid-October, for example, he not only gave notice that he would be playing a more central role in decisions on whether to institute an IPR, but the USPTO also issued a **Notice of Proposed Rulemaking** modifying the PTAB trial practice on the institution of IPRs.

The stated objective of the proposed rule is to “enhance fairness and efficiency in patent disputes by focusing IPR proceedings on cases where the patent has not previously been challenged in litigation or where prior litigation was resolved via settlement at an early stage”.

In other words, the USPTO’s goal is to stop the practice of using IPRs to launch duplicative attacks against an issued patent.

The proposal addresses a key factor undercutting patent holders’ rights in the United States: the difficulty of certainty of value of a patent even after its issuance because of the risk of repeated challenges by infringers through IPRs and parallel judicial proceedings.

Vexatious IPR petitions

Despite the intentions of the US Congress when adopting the AIA, the use of IPRs has become vexatious and a procedural nightmare for patent holders.

Congress's expectation was that an IPR would be instituted shortly after patent issuance, and well before any judicial proceedings for infringement before a US District Court. In fact, though, an accused infringer often brings an IPR contemporaneously with a court case on the same patent. Congress also failed to foresee that an accused infringer or its affiliates would launch serial IPRs on a single patent; for example, based on different claims of prior art.

In its proposal, the USPTO lists the abuses it wishes to correct: multiple petitions against the same patent ("54% of all IPR petitions"), comprising serial and parallel challenges and challenges using substantially the same prior art or arguments. For the USPTO, these remain a significant problem.

New rule: just one bite at the apple – and we mean it

In drafting its proposed rule, the USPTO has drawn from PTAB jurisprudence, the text of the AIA, and the AIA's legislative history. The goal is to confirm estoppel to decisions on prior art, whether finally decided by PTAB, a district court or the ITC.

The proposed rule, to be reflected in new paragraphs (d) and (e) of 37 CFR 42.108 (Institution of inter partes review), provides:

- First (and most notably), a petitioner submits a *stipulation* that if an IPR is instituted it will not raise in any other proceeding grounds of invalidity or unpatentability with respect to the patent based on prior art.
- Second, it agrees that its stipulation is *binding also on its affiliates* (that is, "any real party in interest or privy of the petitioner").
- Third, a petitioner may not seek an IPR if the challenged claim was found to be valid in a prior final decision issued by the US Federal courts, the ITC or PTAB.

Moreover, the proposed rule would prohibit *parallel litigation*: an IPR will not be instituted or maintained "if, more likely than not, . . . before the due date for the final written [PTAB] written decision" (under the AIA, generally one year after institution), in respect of the same prior art challenge, there will have occurred a district court trial, an ITC determination, or a PTAB final written decision (in this case, by another petitioner).

Note that the stipulation covers the challenged *patent*, precluding challenges brought by the petitioner and affiliates. This is not surprising because this appears to be in line with general notions of collateral estoppel.

What is noteworthy is the prohibition of challenges of *claims* that are the subject of a final decision of PTAB, a Federal district court or the ITC (in each case "a final decision"). Here, IPR is not available to the petitioner even though it was not a party to the earlier proceeding.

As proposed by the USPTO, the prohibition against instituting a petition can also be applied when a third party, not an affiliate of the petitioner, has previously brought a challenge to the same claim but the challenge failed and the claim found valid

In the view of the USPTO, then, once the final decision of the proceeding brought by that third party has been issued, if resulting in a finding of validity in respect of a claim, there is no need, absent extraordinary circumstances, to adjudicate the question of prior art validity again. If a party is disappointed by the unavailability of IPR to bring a claim of invalidity based on newly discovered prior art, it remains free to bring its challenge to the Federal district court.

Legislation also needed

In proposing the Rule, Director Squires has taken an early step in correcting some of the abuses raised by IPRs. As the supplementary materials accompanying the proposed Rule make clear, he is drawing on the broad discretion that the AIA provides to the director on the institution and nature of proceedings of IPRs and the relationship of IPRs to other adjudicatory proceedings.

However, while the USPTO can do something, it cannot do everything. This is where legislation comes into play. A bill has been reintroduced in the present Congress, the PREVAIL Act S.1553. A measure long under consideration, the PREVAIL Act presents a codified solution to multiple/duplicative IPRs that largely mirrors the proposals made by Squires. But it goes further by requiring PTAB to apply the federal court standard of “clear and convincing” evidence to establish invalidity.

The PREVAIL Act is a vital legislative counterpart to the USPTO’s ongoing regulatory initiatives, ensuring that administrative processes remain aligned with Congressional intent. It is to be hoped that the USPTO, the Department of Commerce and the whole Administration will publicly support the legislation and work with Congress to secure its passage.



Roberto Dini

Founder

Sisvel Group

roberto@dini.com

[**View full biography**](#)