

Letter of __ Law Professors and Public Citizen in Opposition to "USPTO's proposed rule changes for inter partes review, Docket No. PTO-P-2025-0025."

November 30, 2025

As professors and scholars of intellectual property law, we oppose the proposed changes to severely narrow the ability of the public to challenge a patent's validity through inter partes review (IPR) proceedings at the U.S. Patent and Trademark Office (PTO). Those proposed rule changes would violate the law, increase the cost of innovation, and harm the quality of patents.

The IPR process has been an extraordinary success. In the fourteen years of the program, the PTAB has resolved more than 14,000 petitions, many more disputes than have been resolved in court during that period. The IPR process is much cheaper than litigation (roughly 20% of the cost of trial), faster than litigation, and produces overall results (a 40-45% total invalidity rate depending on how one counts) that are indistinguishable from the results in court cases.¹ See Christian Helmers & Brian J. Love, *Patent Law Reform and Innovation: An Empirical Assessment of the Last 20 Years*, International Review of Law & Economics, vol. 79, article 106210 (2024), <https://www.sciencedirect.com/science/article/abs/pii/S0144818824000309> (empirical research finding that PTAB had a positive effect on innovation, as measured by R&D spending and patent filings by publicly traded companies).

Unfortunately, the new leadership of the PTO seems determined to undo this dramatic success story. The proposed rules violate the law and common sense.

The proposed addition of paragraph (d) to amend 37 CFR § 42.108 would deny IPR petitions unless a challenger waived their prerogative to challenge the patent's validity in litigation. Disturbingly, this would bar validity challenges that petitioners could not even argue in an IPR proceeding. This is inconsistent with 35 U.S.C. § 315, which provides for a significantly narrower scope of impermissible overlap. This proposed rule is also contrary to cases interpreting that statute (see *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354 (Fed. Cir. 2025)).

The proposed additions of paragraphs (e) and (g) to amend 37 CFR § 42.108 would make it almost impossible for anyone to challenge patents after one prior validity ruling in U.S. district court, the U.S. International Trade Commission, a Patent Trial and Appeal Board (PTAB) final written decision, or an ex parte reexamination. The

¹ Since the beginning of the IPR process challengers have won in whole or in part 5,181 out of 11,511 completed proceedings, or 45.0%. If we exclude patents that are partially upheld (which is arguably a patent owner win rather than a challenger win) challengers win 4,234 out of 10,564 cases, or 40.1%. Data calculated from law.lexmachina.com/ptab/ on September 20, 2025. Those numbers are essentially indistinguishable from the invalidity rate in court, which is 42.4%. John R. Allison, Mark A. Lemley & David L. Schwartz, *Understanding the Realities of Modern Patent Litigation*, 92 Tex. L. Rev. 1769 (2014) (finding 42.4% invalidity rates in cases decided 2009-2013).

proposed revision would prevent everyone else from initiating an IPR proceeding even if the decision was not final, even if new or additional prior art was discovered or if new caselaw were established, and even if the challenger could not have brought a petition earlier.

The proposed additions of paragraphs (f) and (g) to amend 37 CFR § 42.108 would completely prevent an IPR proceeding if parallel litigation (U.S. district court, U.S. International Trade Commission, or a PTAB final written decision) were likely to conclude before the "due date for the final written decision" in an IPR proceeding. There is some merit to denying late petitions filed solely in order to open a second front after losing in court. Unfortunately, as dozens of Federal Circuit mandamus petitions have already documented, timing rules like the one proposed have repeatedly been abused by a few district judges seeking to retain control over patent cases. Courts that set unrealistic schedules and refuse to stay pending an IPR even after institution end up blocking even IPR proceedings the PTO has already determined are meritorious.

The proposed rule changes are merely the latest part of that attack on the Congressionally approved IPR process:

- The PTO has adopted a new, legally-unsupported "settled expectations" rule that prevents filing a challenge at all against 2/3 of issued patents and nearly ¾ of the patents that are actually being enforced;
- The Director has refused to institute a meritorious claim – one that the Patent Trial and Appeal Board (PTAB) judges and even his own deputy found worthy of review – because while some claims were likely invalid other claims in the patent might not be. That too directly contradicts 35 U.S.C. § 314, which provides for review if at least one of the claims of the patent is likely invalid. And it undermines the Supreme Court's reading of the statute in *SAS v. Iancu*, which held that the AIA "suggests a regime where a reasonable prospect of success on a single claim justifies review of them all."
- The Director has suggested he will refuse to institute IPRs because of the nationality of the petitioner, a clear violation of the Constitution and due process.
- The Director has removed the PTAB from the role of deciding whether to institute IPRs at all. Instead, he announced that he would decide all the petitions himself, perhaps in consultation with PTAB judges in certain complex cases, while giving no explanation for the denials. It is not possible for the Director to make all the decisions in complex patent cases – unless the goal is to ignore the statute and just get rid of IPRs altogether. And indeed the Director has denied *every* one of the 91 petitions since taking review away from the PTAB.

The above proposed rule changes combined with the PTO administration's decision to disregard Congressionally enacted IPR procedures and the director's announcement that he will remove the PTAB from decisions on instituting IPR proceedings, demonstrate that the PTO administration desires to effectively eliminate IPRs by making it practically impossible to challenge a patent through initiating an IPR

proceeding. Indeed, Deputy Director Stewart quite clearly stated that that was her goal. Eliminating IPRs is against existing law. It is also terrible policy. It would reduce innovation and harm the quality of patents because fewer bad patents would be challenged, given the increase in time and money to do so. And it would significantly increase the cost and delay the owners of good patents face to resolve the validity of their rights. The only beneficiaries of this policy are the owners of invalid patents who hope to take advantage of that cost and uncertainty to extort nuisance-value settlements. That is not and should not be the purpose of the patent system, and the PTO should not encourage bad patents at the expense of good ones.

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