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PTAB Committee

PTAB Committee Meeting:

Monthly Update from the PTAB Committee

Amster Rothstein & Ebenstein LLP

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December 16 2025

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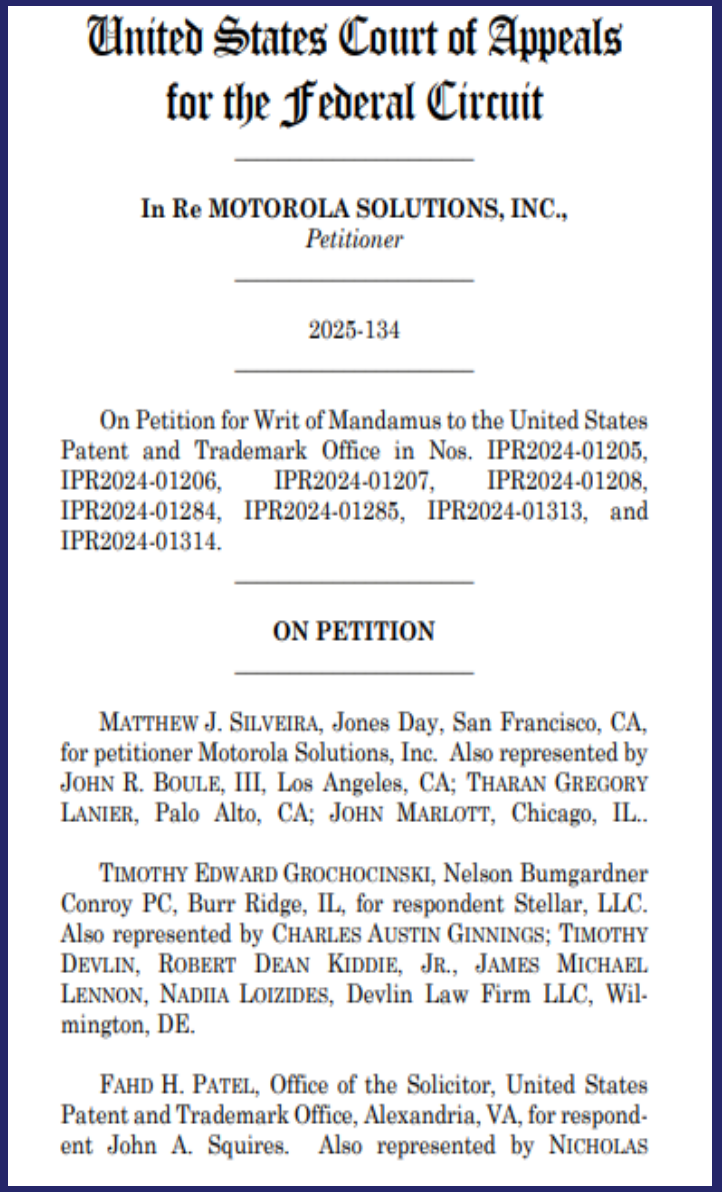
Agenda

- Update on Federal Circuit Review
- Update on Discretionary Denials
- Update on Director Review
- General USPTO Updates
- USPTO Issues New Trial Practice Guide

Update on Federal Circuit Review: Mandamus Decisions



United States Court of Appeals
for the Federal Circuit

In Re MOTOROLA SOLUTIONS, INC.,
Petitioner

2025-134

On Petition for Writ of Mandamus to the United States Patent and Trademark Office in Nos. IPR2024-01205, IPR2024-01206, IPR2024-01207, IPR2024-01208, IPR2024-01284, IPR2024-01285, IPR2024-01313, and IPR2024-01314.

ON PETITION

MATTHEW J. SILVEIRA, Jones Day, San Francisco, CA, for petitioner Motorola Solutions, Inc. Also represented by JOHN R. BOULE, III, Los Angeles, CA; THARAN GREGORY LANIER, Palo Alto, CA; JOHN MARLOTT, Chicago, IL..

TIMOTHY EDWARD GROCHOCINSKI, Nelson Bumgardner Conroy PC, Burr Ridge, IL, for respondent Stellar, LLC. Also represented by CHARLES AUSTIN GINNINGS; TIMOTHY DEVLIN, ROBERT DEAN KIDDIE, JR., JAMES MICHAEL LENNON, NADIIA LOIZIDES, Devlin Law Firm LLC, Wilmington, DE.

FAHD H. PATEL, Office of the Solicitor, United States Patent and Trademark Office, Alexandria, VA, for respondent John A. Squires. Also represented by NICHOLAS

In re Motorola Solutions, Inc.

- The Federal Circuit denied a Petition for Mandamus, holding that under 35 U.S.C. § 314(d) institution decisions are committed to the Director's discretion and are generally non-appealable.

Instead, Motorola's request for relief is premised on the argument that the Vidal Memorandum created a "constitutionally protected interest" in having its petitions considered without regard to the discretionary *Fintiv* factors. Pet. at 34. That is so, Motorola says, because the Vidal Memorandum imposed "substantive limits" on the PTO's "official discretion" to deny an IPR petition based on the existence of parallel litigation so long as a petitioner provides a *Sotera* stipulation. Reply at 14 (emphasis omitted). But this argument runs into at least two obstacles.

First, our precedent distinguishes between applications for discretionary benefits and those for non-discretionary benefits in which a particular outcome is mandated "upon a showing that [the applicant] meets the eligibility requirements set forth in the governing statutes and regulations." *Cushman*, 576 F.3d at 1298. While we have held the latter can involve a property interest protected by the Due Process Clause, *id.*, the Vidal Memorandum did not limit the PTO's discretion in this way. The Vidal Memorandum did not direct the Board to reach any particular outcome on a petition. It merely directed the Board not to rely on certain criteria to deny review, and even then, only until further notice by the PTO.

Second, Motorola has not shown its identified property right—entitlement to "consideration of its petitions on the merits without risking discretionary denial based on parallel district court proceedings," Pet. at 34—is protected under the Due Process Clause. In *Mylan*, we rejected a similar argument that the Board had violated a petitioner's due process rights by denying IPR based on parallel litigation to which the petitioner was not a party. *Mylan*, 989 F.3d at 1383. We concluded that the petitioner had no constitutionally protected "right for its petition to be considered without reference to" that district court litigation "and no right to an IPR." *Id.* We similarly see no "history or tradition" that supports recognizing for these purposes a constitutionally protected right to have the Board consider Motorola's petitions without regard to the *Fintiv* factors, even if it stipulates to not raising the challenges in parallel district court proceedings. *Id.* (cleaned up).

Nor do we see any meaningful way to distinguish between that purported right and the desired process requested to protect that right. The Supreme Court has long held that "[p]rocess is not an end in itself" and "expectation of receiving [certain] process is not, without more," an "interest protected by the Due Process Clause." *Olim v. Wakinekona*, 461 U.S. 238, 250 & n.12 (1983); *cf. Mumford v. Godfried*, 52 F.3d 756, 759 (8th Cir. 1995) (noting a contractual right to have procedures followed "does not create a property interest in the procedures themselves" (emphasis omitted)); *Clemente v. United States*, 766 F.2d 1358, 1364 (9th Cir. 1985) ("A mere command to follow certain procedures, however, does not create an underlying property interest, even when the command is derived from the Constitution."). As in those cases, Motorola here relies on nothing more than its own unilateral expectation based on the prior interim procedural guidance—not any separate property interest—to support its due process claim.

We likewise see no due process violation by the Acting Director applying the recission of the Vidal Memorandum to the petitions. To be sure, "[e]lementary considerations of fairness dictate that individuals should have an opportunity to know what the law is and to conform their conduct accordingly." *Landgraf v. USI Film Prods.*, 511 U.S. 244, 265 (1994). But even if those principles are applicable to this context, Motorola did not experience anything close to the kind of unfair surprise that might raise a due process violation. Motorola was aware of the Board precedent on discretionary denial when it filed its petitions and on notice that the interim guidance about how to apply that precedent in cases where a party provides a *Sotera* stipulation could be modified at any time. Even if Motorola relied on the Vidal Memorandum when it undertook the expense of filing the petitions, Pet. at 2, 35, that "reliance alone is insufficient to establish a constitutional violation." *United States v. Carlton*, 512 U.S. 26, 33 (1994). Moreover, recission of the interim guidance did not affect Motorola's ability to properly raise its patentability defenses elsewhere as the *Sotera* stipulation only conditioned Motorola's ability to raise its patentability challenges in an IPR.

In re Motorola Solutions, Inc.

- Motorola did not have a constitutionally protected property interest in having its IPR petitions considered under the prior Vidal guidance.
  - The Court held Vidal Memorandum was guidance, not a binding entitlement that limits the Director's statutory→ no due process rights.

In re Motorola Solutions, Inc.

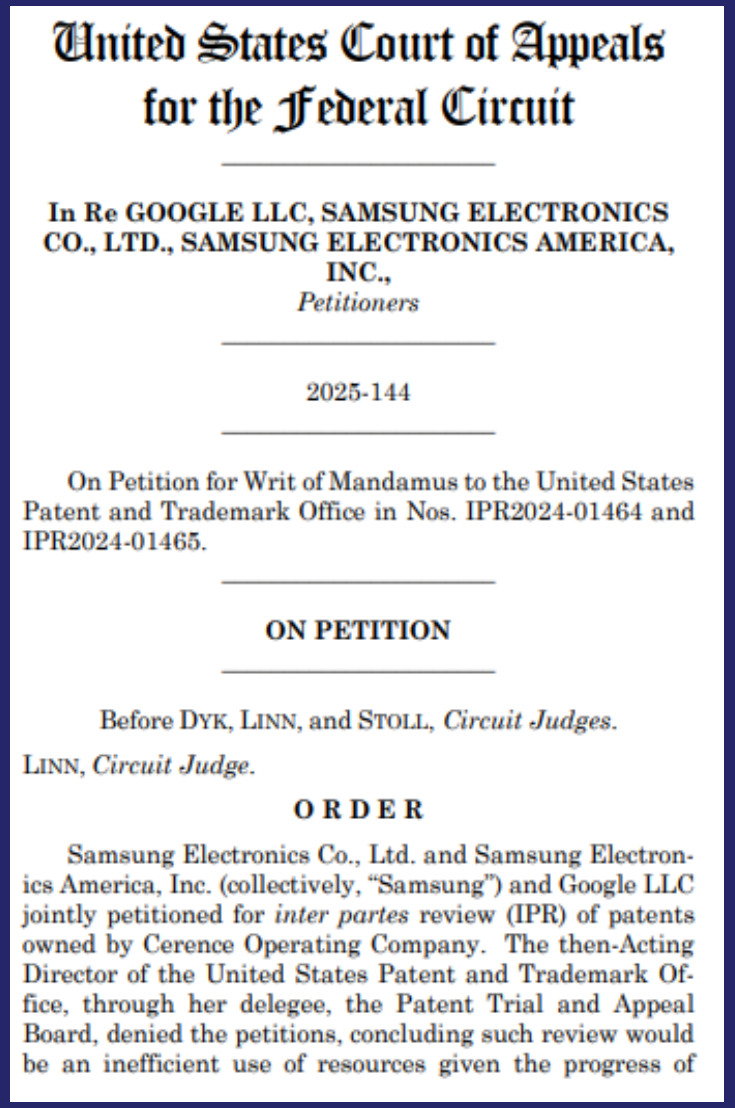
- Motorola argued that Acting Director Stewart's rescission was arbitrary
- The court held that the arguments were unreviewable because they challenged the Director's discretionary weighing of factors in deciding whether to institute review, which § 314(d) places beyond judicial review

> Motorola next argues that the Acting Director acted arbitrarily and capriciously in applying the recission by, among other things, failing to "offer any reasons for the change" and failing to give proper "consideration of the reliance interests engendered by the June 2022 Memo." Pet. at 30–32 (emphasis omitted). But these arguments are the kinds of arguments that we have said are not reviewable in light of § 314(d) because, at bottom, they challenge "the Director's exercise of [] discretion to deny institution" (the weighing of the relevant factors), *Mylan*, 989 F.3d at 1382, and thus do not fall within the limited category of non-constitutional challenges to the applicable factors appropriate to review on limited mandamus relief.

In re Motorola Solutions, Inc.

- Footnote 2: The court took no position on the issue of the Director, in consultation with at least three Board judges, determining whether to institute IPRs. However, the decision to highlight it signals a recognition of possible issues.

> 2 In the past, the Director has generally delegated the responsibility of deciding whether to institute IPR to the Board. *See* 37 C.F.R. § 42.4; *Ethicon Endo-Surgery, Inc. v. Covidien LP*, 812 F.3d 1023, 1028 (Fed. Cir. 2016). On October 17, 2025, however, the Director announced—without any change to 37 C.F.R. § 42.4—that he, in consultation with at least three Board judges, will determine whether to institute IPR. John A. Squires, Open Letter from America's Innovation Agency and Memorandum (Oct. 17, 2025), https://www.uspto.gov/sites/default/files/documents/open-letter-and-memo_20251017.pdf (last visited Oct. 22, 2025).



United States Court of Appeals
for the Federal Circuit

In Re GOOGLE LLC, SAMSUNG ELECTRONICS CO., LTD., SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioners

2025-144

On Petition for Writ of Mandamus to the United States Patent and Trademark Office in Nos. IPR2024-01464 and IPR2024-01465.

ON PETITION

Before DYK, LINN, and STOLL, *Circuit Judges*.

LINN, *Circuit Judge*.

ORDER

Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively, "Samsung") and Google LLC jointly petitioned for *inter partes* review (IPR) of patents owned by Cerence Operating Company. The then-Acting Director of the United States Patent and Trademark Office, through her delegee, the Patent Trial and Appeal Board, denied the petitions, concluding such review would be an inefficient use of resources given the progress of

In re Google LLC

- The Federal Circuit denied a Petition for Mandamus, holding that under 35 U.S.C. § 314(d) institution decisions are committed to the Director's discretion and are generally non-appealable.
- The Federal Circuit concluded Google's due process and APA arguments did not justify relief.

Given Congress committed institution decisions to the Director's discretion, *SAS Inst., Inc. v. Iancu*, 584 U.S. 357, 366 (2018), and protected that exercise of discretion from judicial review by making such determinations "final and nonappealable," 35 U.S.C. § 314(d), mandamus is ordinarily unavailable for review of institution decisions—including decisions denying institution based on the progress of parallel district court proceedings involving the same patents. *See Mylan Lab'ys Ltd. v. Janssen Pharmaceutica, N.V.*, 989 F.3d 1375, 1378–79 (Fed. Cir. 2021). We have noted possible exceptions for "colorable constitutional claims," *id.* at 1382, and certain statutory challenges, *see Apple Inc. v. Vidal*, 63 F. 4th 1, 12 n.5 (Fed. Cir. 2023). But no such claims have been presented here.

Petitioners assert that the PTO violated the Due Process Clause and the Administrative Procedure Act by denying IPR based on the parallel district court proceedings despite Samsung's stipulations. They focus on interim guidance from the Director in place at the time they filed their petitions instructing the Board until further notice not to "deny institution in view of parallel district court litigation where a petitioner presents a stipulation not to pursue in a parallel proceeding the same grounds or any grounds that could have reasonably been raised before the PTAB," Appx39—guidance the Acting Director rescinded just before denying their IPR petitions here.

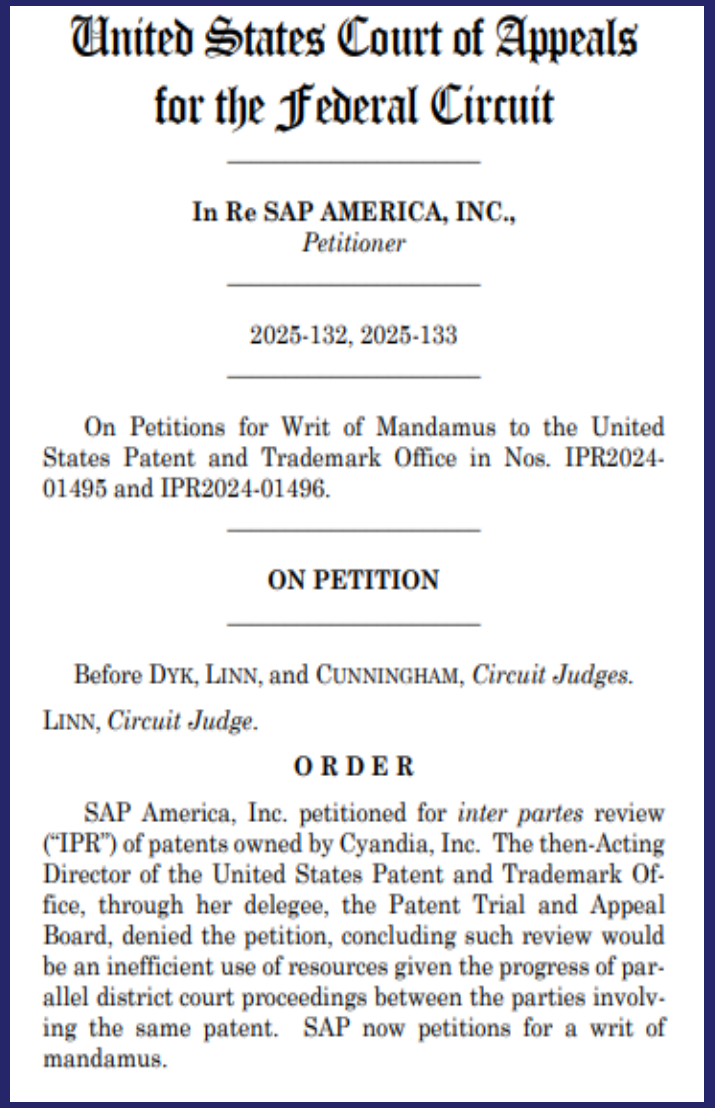
In a separate order issued today, we denied a petition raising materially similar challenges to the recission of the Director's interim guidance, *In re Motorola Sols., Inc.*, No. 2025-134 (Fed. Cir. Nov. 6, 2025), ECF No. 44. We explained that the interim guidance did not create a constitutionally-protected property interest and that reliance on that guidance when undertaking the expense of filing petitions was insufficient to establish a constitutional violation. We further found that APA-based arguments that the recission required notice and comment rulemaking and that the PTO acted arbitrarily and capriciously in applying the recission retroactively were not cognizable statutory challenges that entitled petitioner to mandamus relief. Those conclusions likewise support denial of Petitioners' similar due process and APA challenges here.[1]

In re Google LLC

- The court explains that because Congress made PTAB institution decisions discretionary and "final and nonappealable," mandamus review is generally unavailable, including for denials based on parallel district court litigation, absent narrow exceptions for colorable constitutional or certain statutory claims.
- Petitioners argued that the PTO violated due process and the APA by denying IPR despite stipulations, relying on interim Director guidance (June 21, 2022 "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation") that discouraged such denials.
  - However, that guidance was rescinded before their petitions were decided.
- Relying on its decision in *In re Motorola Solutions*, the court concluded that the interim guidance created no protected property interest and that the APA challenges to its rescission were not cognizable for mandamus, warranting denial of relief.

In re SAP America, Inc.

- The Federal Circuit denied a Petition for Mandamus, holding that under 35 U.S.C. § 314(d) institution decisions are committed to the Director's discretion and are generally non-appealable.



United States Court of Appeals
for the Federal Circuit

In Re SAP AMERICA, INC.,
Petitioner

2025-132, 2025-133

On Petitions for Writ of Mandamus to the United States Patent and Trademark Office in Nos. IPR2024-01495 and IPR2024-01496.

ON PETITION

Before DYK, LINN, and CUNNINGHAM, *Circuit Judges*.

LINN, *Circuit Judge*.

ORDER

SAP America, Inc. petitioned for *inter partes* review ("IPR") of patents owned by Cyandia, Inc. The then-Acting Director of the United States Patent and Trademark Office, through her delegee, the Patent Trial and Appeal Board, denied the petition, concluding such review would be an inefficient use of resources given the progress of parallel district court proceedings between the parties involving the same patent. SAP now petitions for a writ of mandamus.

In re SAP America, Inc.

- The Federal Circuit again explained that Congress granted the USPTO Director discretion over IPR institution decisions and made them "final and non-appealable" under 35 U.S.C. § 314(d).
- Further, exceptions exist for colorable constitutional claims or certain statutory challenges, but SAP did not raise such claims.

> Given Congress committed institution decisions to the Director's discretion, *SAS Inst., Inc. v. Iancu*, 584 U.S. 357, 358 (2018), and protected that exercise of discretion from judicial review by making such determinations "final and nonappealable," 35 U.S.C. § 314(d), mandamus is ordinarily unavailable for review of institution decisions—including decisions based on the standard for evaluating whether to institute in view of parallel civil litigation, *see Mylan Lab'ys Ltd. v. Janssen Pharmaceutica, N.V.*, 989 F.3d 1375, 1381 (Fed. Cir. 2021). We have noted possible exceptions for "colorable constitutional claims," *id.* at 1382, and certain statutory challenges, *see Apple Inc. v. Vidal*, 63 F. 4th 1, 12 n.5 (Fed. Cir. 2023). But SAP failed to raise its challenges before the agency. *See In re DBC*, 545 F.3d 1373, 1378 (Fed. Cir. 2008) ("It is well-established that a party generally may not challenge an agency decision on a basis that was not presented to the agency"). And our decision in *In re Motorola Sols., Inc.*, No. 2025-134 (Fed. Cir. Nov. 6, 2025), ECF No. 44, forecloses relief on those issues.

NOTE: This order is nonprecedential.

United States Court of Appeals for the Federal Circuit

In Re CAMBRIDGE INDUSTRIES USA INC.,
Petitioner

2026-101

On Petition for Writ of Mandamus to the United States Patent and Trademark Office in Nos. IPR2025-00433 and IPR2025-00435.

ON PETITION

Before PROST, CHEN, and HUGHES, *Circuit Judges*.

PER CURIAM.

ORDER

Cambridge Industries USA Inc. petitioned for *inter partes* review ("IPR") of Applied Optoelectronics, Inc.'s patents. Applied Optoelectronics asked the United States Patent and Trademark Office ("PTO") to exercise its discretionary authority and deny institution. The PTO agreed as to two of Cambridge's petitions based on the "Patent Owner's settled expectations as to the [challenged] patents" that "have been in force for nine and seven years." Appx3. Cambridge now petitions for a writ of mandamus

In re Cambridge Industries USA Inc.

- The Federal Circuit denied a Petition for Mandamus challenging PTAB's denial of institution (per Stewart) based on "settled expectations", where challenged patents "have been in force for nine and seven years."

- The Court held that because *institution decisions are committed to the Director's discretion* under the AIA and are final and nonappealable under 35 U.S.C. § 314(d), mandamus is generally unavailable except in narrow circumstances (e.g. colorable constitutional claims).

- "Given Congress committed institution decisions to the Director's discretion, *SAS Inst., Inc. v. Iancu*, 584 U.S. 357, 366 (2018), and protected exercise of that discretion from judicial review by making such determinations "final and nonappealable," 35 U.S.C. § 314(d), **mandamus is ordinarily unavailable for review of institution decisions**. *Mylan Lab'ys Ltd. v. Janssen Pharmaceutica*, N.V., 989 F.3d 1375, 1382 (Fed. Cir. 2021). **That general prohibition bars review of decisions denying institution of IPR proceedings for efficiency reasons based on parallel district court litigation involving the same patents**, *id.* at 1378–79, 1381. We have noted **possible exceptions for "colorable constitutional claims,"** *id.* at 1382, and certain statutory challenges, see Apple Inc. v. Vidal, 63 F. 4th 1, 12 n.5 (Fed. Cir. 2023). But no such claims have been presented here."

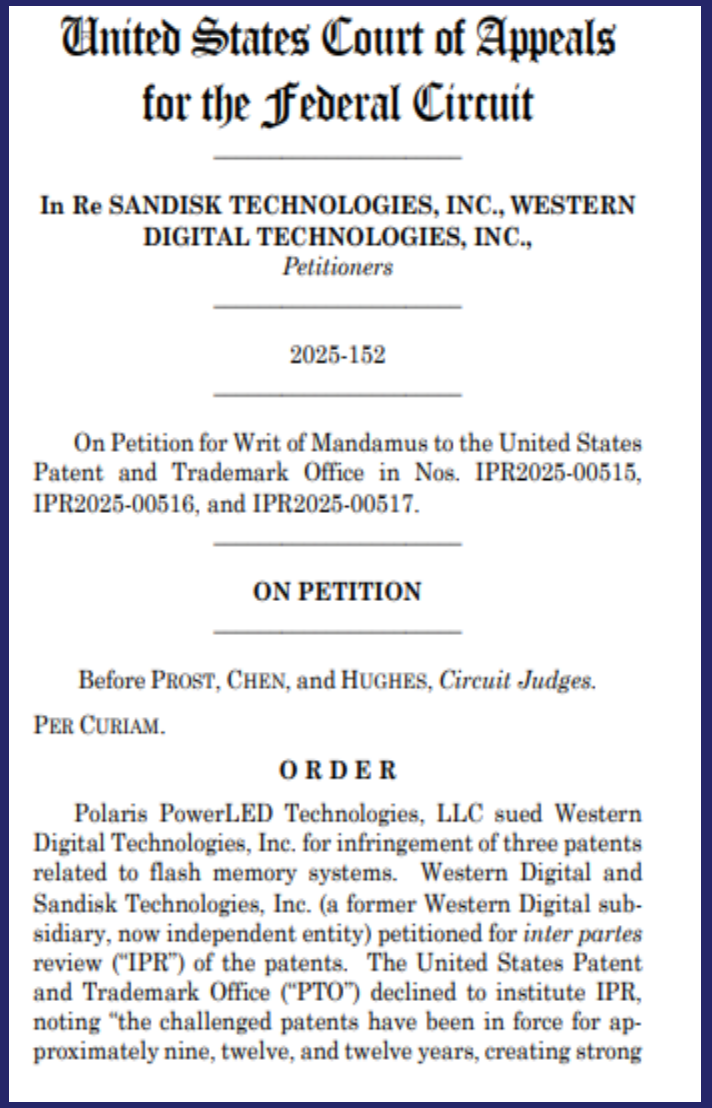
https://www.cafc.uscourts.gov/opinions-orders/26-101.ORDER.12-9-2025_2616340.pdf

At bottom, Cambridge's arguments are about what factors the Director may consider when deciding whether to institute IPR. Unlike Cambridge's assertions regarding the failure to employ notice and comment rulemaking, these contentions appear to "focus directly and expressly on institution standards," *Apple*, 63 F.4th at 12, and turn on "the application and interpretation of statutes related to the Patent Office's decision to initiate inter partes review," which are not generally reviewable. *Cuozzo Speed Techs. v. Lee*, 579 U.S. 261, 274–75 (2016); *see Thryv, Inc. v. Click-To-Call Techs., LP*, 590 U.S. 45, 58–59 (2020); *Apple*, 63 F.4th at 13 (holding § 314(d) encompasses not only petition-specific challenges but also the substantive instructions and guidance from the Director about how to make the institution decisions on the Director's behalf).

We reiterate that we do not decide whether the PTO's actions are correct or whether the use of this factor is permitted under the statutes. Nor do we address the availability of mandamus relief for other challenges to institution decisions based on non-constitutional grounds. We decide only that Cambridge has failed to show a clear and indisputable right to the relief requested given the limits on our review of the PTO's decision to deny institution.

In Re Cambridge Industries USA Inc. CAFC Decision

- The court reiterated that challenges to what factors the Director may consider in institution decisions are generally not judicially reviewable, including via mandamus.
- The Federal Circuit did not rule on the lawfulness of settled expectations or the USPTO's authority→ they only held that Cambridge did not meet the mandamus requirements.



United States Court of Appeals
for the Federal Circuit

In Re SANDISK TECHNOLOGIES, INC., WESTERN DIGITAL TECHNOLOGIES, INC.,
Petitioners

2025-152

On Petition for Writ of Mandamus to the United States Patent and Trademark Office in Nos. IPR2025-00515, IPR2025-00516, and IPR2025-00517.

ON PETITION

Before PROST, CHEN, and HUGHES, *Circuit Judges*.

PER CURIAM.

ORDER

Polaris PowerLED Technologies, LLC sued Western Digital Technologies, Inc. for infringement of three patents related to flash memory systems. Western Digital and Sandisk Technologies, Inc. (a former Western Digital subsidiary, now independent entity) petitioned for *inter partes* review ("IPR") of the patents. The United States Patent and Trademark Office ("PTO") declined to institute IPR, noting "the challenged patents have been in force for approximately nine, twelve, and twelve years, creating strong

In re SanDisk Technologies, Inc.

- The Federal Circuit denied a Petition for Mandamus, holding that under 35 U.S.C. § 314(d) institution decisions are committed to the Director's discretion and are generally non-appealable.

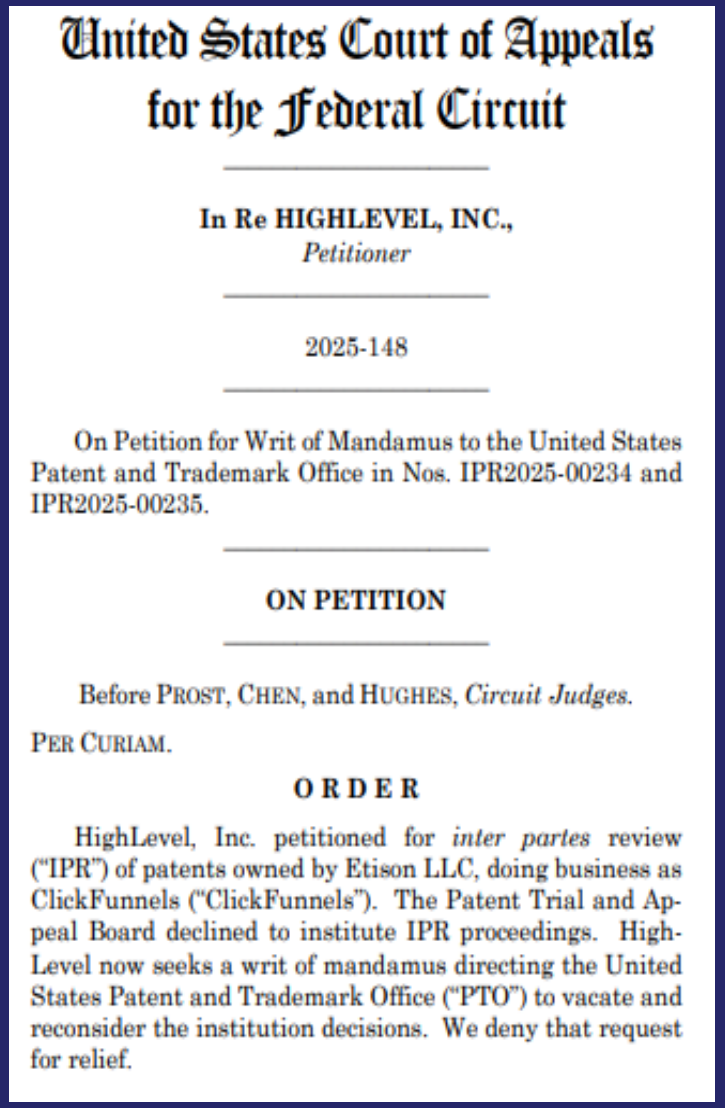
In re SanDisk Technologies, Inc.

- The Federal Circuit held petitioners failed to identify any colorable constitutional claim or property interest, and their non-constitutional challenges (objections to the PTO's consideration of "settled expectations" in denying IPR) did not demonstrate a right to relief.

> A petitioner seeking mandamus relief must ordinarily satisfy three requirements: (1) a clear and indisputable right to relief; (2) a lack of adequate alternative means to obtain the relief sought; and (3) a showing that issuance of the writ is appropriate under the circumstances. *Cheney v. U.S. Dist. Ct. for D.C.*, 542 U.S. 367, 380–281 (2004). Applying those requirements, we arrive at the same conclusion we reached today in *In re Cambridge Industries USA Inc.*, 2026-101 (Fed. Cir. Dec. 9, 2025). Here, as there, Petitioners raise challenges to certain factors considered by the PTO in denying institution of IPR. As with the petitioner in *Cambridge*, Petitioners here have failed to identify the kind of property rights or retroactivity concerns that might give rise to a colorable constitutional claim. And, for the same reasons provided in *Cambridge*, Petitioners' non-constitutional challenges to the PTO's consideration of "settled expectations" as a factor in declining to institute IPR do not establish a clear and indisputable right to relief. 2026-101, slip op. at 5–6 (citing *Cuozzo Speed Techs. v. Lee*, 579 U.S. 261, 274–75 (2016); *Thryv, Inc. v. Click-To-Call Techs., LP*, 590 U.S. 45, 58–59 (2020)).

In re HighLevel, Inc.

- The Federal Circuit denied a Petition for Mandamus, holding that under 35 U.S.C. § 314(d) institution decisions are committed to the Director's discretion and are generally non-appealable.



United States Court of Appeals
for the Federal Circuit

In Re HIGHLEVEL, INC.,
Petitioner

2025-148

On Petition for Writ of Mandamus to the United States Patent and Trademark Office in Nos. IPR2025-00234 and IPR2025-00235.

ON PETITION

Before PROST, CHEN, and HUGHES, *Circuit Judges*.

PER CURIAM.

ORDER

HighLevel, Inc. petitioned for *inter partes* review ("IPR") of patents owned by Etison LLC, doing business as ClickFunnels ("ClickFunnels"). The Patent Trial and Appeal Board declined to institute IPR proceedings. HighLevel now seeks a writ of mandamus directing the United States Patent and Trademark Office ("PTO") to vacate and reconsider the institution decisions. We deny that request for relief.

Given Congress committed institution decisions to the Director's discretion, *SAS Inst., Inc. v. Iancu*, 584 U.S. 357, 366 (2018), and protected exercise of that discretion from judicial review by making such determinations "final and nonappealable," 35 U.S.C. § 314(d), mandamus is ordinarily unavailable for review of institution decisions. *Mylan Lab'ys Ltd. v. Janssen Pharmaceutica, N.V.*, 989 F.3d 1375, 1382 (Fed. Cir. 2021). That general prohibition bars review of decisions denying institution of IPR proceedings for efficiency reasons based on parallel district court litigation involving the same patents, *id.* at 1378–79, 1381. We have noted possible exceptions for "colorable constitutional claims," *id.* at 1382, and certain statutory challenges, *see Apple Inc. v. Vidal*, 63 F. 4th 1, 12 n.5 (Fed. Cir. 2023). But no such claims have been presented here.

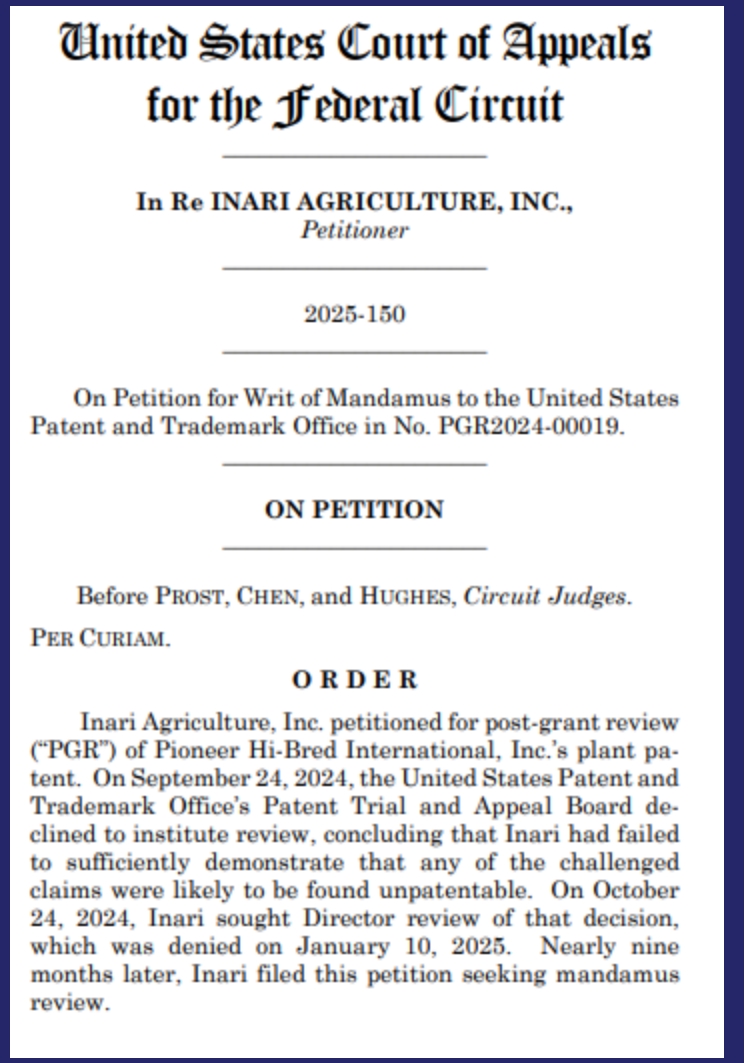
HighLevel's constitutional challenges, like those raised in *In re Motorola Solutions, Inc.*, No. 2025-134, 2025 WL 3096514 (Fed. Cir. Nov. 6, 2025), fail to present the kind of property rights or retroactivity concerns that might give rise to a cognizable Due Process Clause claim. *See Mylan*, 989 F.3d at 1383. Like Motorola, HighLevel identifies no "constitutionally protected right for its petition to be considered" based on only certain criteria and certainly "no [constitutional] right to an IPR." *Motorola*, 2025 WL 3096514, at *4 (quoting *Mylan*, 989 F.3d at 1383). HighLevel's mere reliance that the PTO would evaluate its petition without regard to efficiency concerns based on parallel litigation, moreover, is insufficient to establish a constitutional due process violation. *Id.* (citing *United States v. Carlton*, 512 U.S. 26, 33 (1994)).

HighLevel likewise has not presented a non-constitutional claim that is mandamus-worthy. The Board reviewed the petitions based on its discretionary factors for determining whether to deny IPR in situations where there are parallel civil proceedings. The Board concluded that, in light of the district court's § 101 decision, conducting IPR would not be an efficient use of agency and party resources. In circumstances like these, we have not exercised mandamus authority to disturb a denial of institution decision and see no basis to do so here either. *See Mylan*, 989 F.3d at 1382 (holding a petitioner has no right to mandamus relief when non-constitutional challenge is to "the Director's exercise of [] discretion to deny institution").

HighLevel argues the PTO was required to promulgate such considerations for institution through notice-and-comment rulemaking procedures. But that challenge, like the related challenge in *Motorola*, can be raised in an APA action in federal district court, such that there appears to be an adequate alternative avenue for relief. *Motorola*, 2025 WL 3096514 at *5 ("[O]n that issue, there appears to be no dispute that an APA action in federal district court affords Motorola an available avenue to raise this same challenge"); *see also Apple*, 63 F.4th at 14. While HighLevel seeks to use this challenge to vacate the non-institution decisions and reconsider institution based on only certain criteria, as explained in *Motorola*, "that request is nothing but an attempted end run around § 314(d)'s bar on review" and foreclosed by precedent. *Motorola*, 2025 WL 3096514 at *5. We thus reject that challenge as well.

In re HighLevel, Inc.

- The HighLevel decision reinforces that issuing a writ of mandamus is an extraordinary remedy
- HighLevel contended that relying on § 101 rulings to automatically deny institution of prior art challenges went beyond the USPTO's statutory authority
  - The court, applying the *Cambridge* framework, rejected this argument but clarified that challenges under APA could still be pursued in district court.



United States Court of Appeals
for the Federal Circuit

In Re INARI AGRICULTURE, INC.,
Petitioner

2025-150

On Petition for Writ of Mandamus to the United States Patent and Trademark Office in No. PGR2024-00019.

ON PETITION

Before PROST, CHEN, and HUGHES, *Circuit Judges*.

PER CURIAM.

ORDER

Inari Agriculture, Inc. petitioned for post-grant review ("PGR") of Pioneer Hi-Bred International, Inc.'s plant patent. On September 24, 2024, the United States Patent and Trademark Office's Patent Trial and Appeal Board declined to institute review, concluding that Inari had failed to sufficiently demonstrate that any of the challenged claims were likely to be found unpatentable. On October 24, 2024, Inari sought Director review of that decision, which was denied on January 10, 2025. Nearly nine months later, Inari filed this petition seeking mandamus review.

In re Inari Agriculture, Inc.

- The Federal Circuit denied a Petition for Mandamus, holding that mandamus is reserved for extraordinary circumstances.

In re Inari Agriculture, Inc.

- The Federal Circuit denied mandamus on procedural grounds, finding that Inari raised only constitutional arguments that it failed to present to the PTO and that its nearly nine-month delay in filing the petition weighed against exercising discretion to reach novel issues.

Mandamus is "reserved for extraordinary situations." *Gulfstream Aerospace Corp. v. Mayacamas Corp.*, 485 U.S. 271, 289 (1988) (citation omitted). Under the well-established standard for such relief, a petitioner must: (1) show that he has a clear and indisputable right to relief; (2) show he does not have any other adequate method of obtaining relief; and (3) convince the court that the "writ is appropriate under the circumstances." *Cheney v. U.S. Dist. Ct. for D.C.*, 542 U.S. 367, 380–81 (2004) (citation omitted).

Inari's petition raises only constitutional challenges that it did not directly raise before the Patent Office.[1] "It is well-established that a party generally may not challenge an agency decision on a basis that was not presented to the agency." *In re DBC*, 545 F.3d 1373, 1378 (Fed. Cir. 2008). Although this court has discretion to reach an issue raised for the first time, *see id.* at 1379, we cannot say it would be appropriate to do so here, particularly given the significant inexcusable delay in filing this petition, *see*

United States v. Braasch, 542 F.2d 442, 444 (7th Cir. 1976) (citing cases denying mandamus based on filing delay); *see also Chapman v. Cnty. of Douglas*, 107 U.S. 348, 355 (1883) ("The writ may well be refused when the relator has slept upon his rights for an unreasonable time[.]").

Update on Federal Circuit Review: Rule 36

NOTE: This disposition is nonprecedential.

United States Court of Appeals for the Federal Circuit

SAMSUNG ELECTRONICS CO., LTD.,
Appellant

v.

NETLIST, INC.,
Appellee

2025-1378

Appeal from the United States Patent and Trademark Office, Patent Trial and Appeal Board in No. IPR2023-00847.

JUDGMENT

MICHAEL HAWES, Baker Botts LLP, Houston, TX, argued for appellant. Also represented by LORI DING; THEODORE W. CHANDLER, Los Angeles, CA; ELIOT DAMON WILLIAMS, Washington, DC; PILSEON YOO, San Francisco, CA.

WILLIAM MILLIKEN, Sterne Kessler Goldstein & Fox PLLC, Washington, DC, argued for appellee. Also represented by RICHARD M. BEMBEN, RICHARD CRUDO.

Samsung Electronics Co., LTD., v. Netlist, Inc.

- Federal Circuit issued a Rule 36 judgment, affirming the PTAB's decision in IPR2023-00847 upholding Netlist's claims

https://www.cafc.uscourts.gov/opinions-orders/25-1378.RULE_36_JUDGMENT.12-9-2025_2616472.pdf

SUMMARY OF ARGUMENT

The Board incorrectly interpreted claim language describing "*a data path* ***corresponding to*** *each data signal line in the respective set of data/strobe signal lines*" as requiring that the recited "*data path*" must be "***in*** the data signal line" and "***not in*** a strobe signal line," contrary to the ordinary meaning of "corresponding to." By imposing that requirement, the Board excluded all "*strobe signal[s]*" from the "*data path*," despite (i) claim 1 expressly requiring "*a delay circuit configured to delay* ***a signal*** *through the data path*," which dependent claim 10 shows can be "*a* ***strobe*** *signal*," and (ii) the undisputed fact that strobe signals have a close functional relationship with data signals under the JEDEC standard. The Board erred by adopting a construction contrary to the ordinary meaning of "corresponding to" as "having a functional relationship with." Applying the ordinary meaning of "corresponding to" results in a claim construction that fits with the dependent claims as well as with the understanding of persons of ordinary skill in the art about the close functional relationship between strobe signals and data signals.

The Board expressly relied on its claim interpretation as the sole reason for rejecting Ground 2 and as the primary reason for rejecting Ground 1. Given the importance of that interpretation, vacatur and remand to reconsider the petition's grounds for unpatentability in view of the proper construction is appropriate.

Samsung Electronics Co., LTD., v. Netlist, Inc.

- Appellant argued the Board improperly construed "corresponding to" in the claim phrase "a data path corresponding to each data signal line".
- Appellant argued because an erroneous construction was the basis for rejecting the asserted grounds of unpatentability, vacatur and remand to reconsider are appropriate.

The Board also erred by failing to apply its previous factual findings against Netlist about materially identical prior art in an unappealed decision regarding the parent '035 patent. Under both caselaw and the Restatement (Second) of Judgments § 27, "an issue of fact" is preclusive regardless of whether legal conclusions in the same decision are also preclusive. The Board focused on alleged differences between the '608 Patent claims and '035 patent claims—an analysis that would need to be revisited if the interpretation of the '608 Patent is corrected. However, the teachings of the prior-art Hiraishi reference is an independent factual issue that does not depend on claim language or unpatentability theories. The Board erred when it linked those issues and refused to consider factual preclusion based on its conclusion regarding legal preclusion. The Board's contrary factual findings should be vacated, both because the Board failed to properly consider preclusion and because those findings contradict key disclosures in Hiraishi and the JEDEC industry standard adopted as part of the ordinary skill in the art.

Samsung Electronics Co., LTD., v. Netlist, Inc.

- Appellant argued the Board erred by failing to apply prior factual findings.
- Appellant argued the Board reached contrary factual findings that should be vacated because they ignored binding preclusion principles and their findings conflict with Hiraishi's disclosures and the JEDEC standard adopted as part of the ordinary skill in the art.

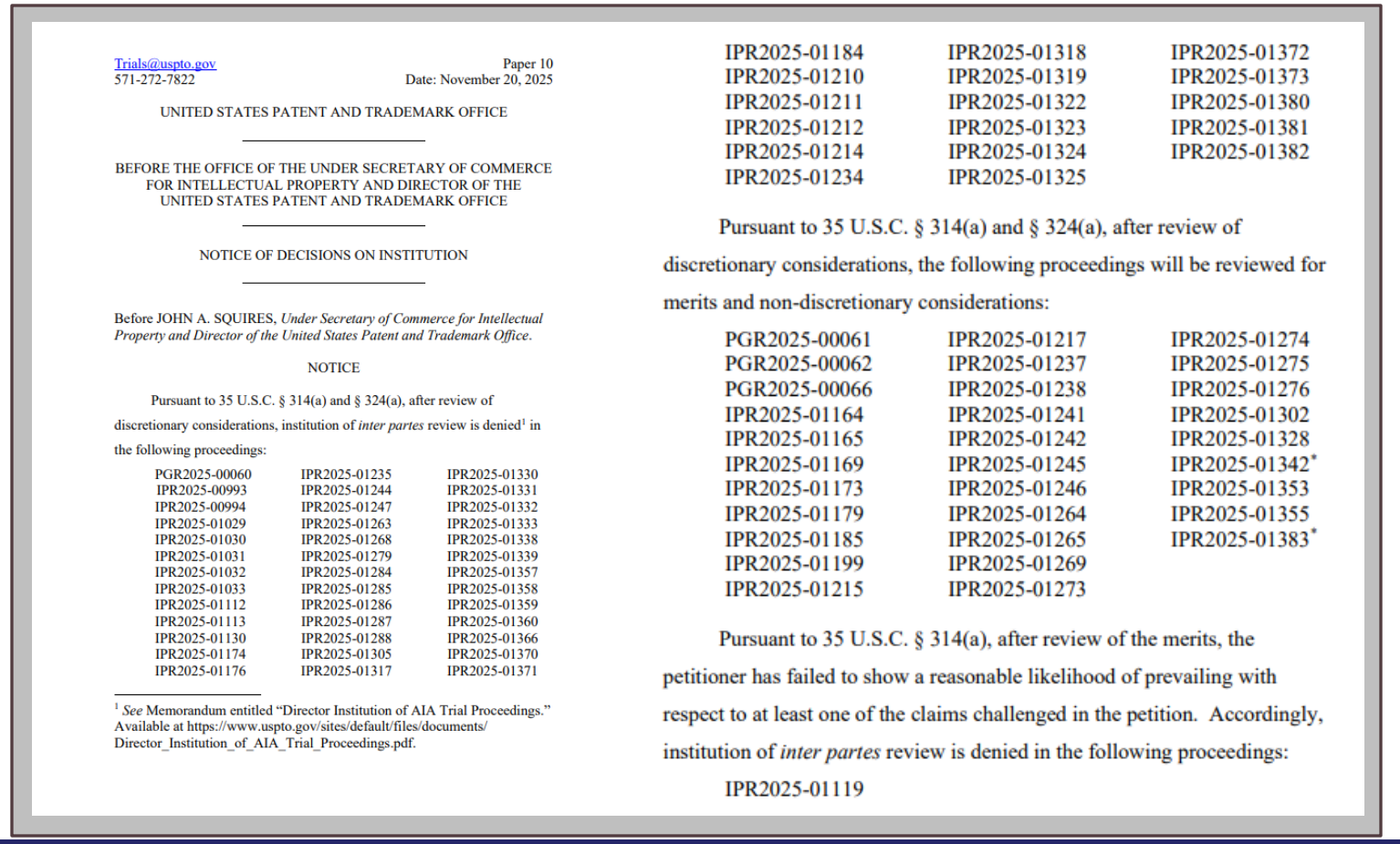
Independent of the improper claim interpretation and factual findings contrary to the Board's previous decision, the Board failed to follow the APA when it ignored an obviousness theory put forward by Samsung for Ground 2 in its petition, expert declaration, reply, and at argument. Throughout the IPR, Samsung argued that a person of ordinary skill would be motivated to replace Hiraishi's FIFO circuit with a delay element physically on the data signal line as a suitable configuration for reducing the risk of misaligned signals in a high-speed memory circuit. Given the Board's restrictive claim interpretation, that obviousness argument was particularly important because it satisfied the Board's narrow construction of "*corresponding to each data signal line*" as meaning "in the data signal line." However, the Board simply did not address this obviousness theory, despite Samsung asserting it at every stage and Netlist failing to rebut it. At minimum, the Board's decision should be vacated and remanded to consider Samsung' argument.

Samsung Electronics Co., LTD., v. Netlist, Inc.

- Appellant argued the Board violated the APA by failing to address Samsung's obviousness theory that a person of ordinary skill would be motivated to replace Hiraishi's FIFO circuit with a delay element on the data signal line.
- Because the Board ignored this unrefuted argument, Appellant argued the decision should be vacated and remanded for proper consideration.

Update on Discretionary Review Decisions

Discretionary Review Decisions (November 20, 2025)



Trials@uspto.gov
571-272-7822

Paper 10
Date: November 20, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

NOTICE OF DECISIONS ON INSTITUTION

Before JOHN A. SQUIRES, *Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office*.

NOTICE

Pursuant to 35 U.S.C. § 314(a) and § 324(a), after review of discretionary considerations, institution of *inter partes* review is denied[1] in the following proceedings:

PGR2025-00060	IPR2025-01235	IPR2025-01330
IPR2025-00993	IPR2025-01244	IPR2025-01331
IPR2025-00994	IPR2025-01247	IPR2025-01332
IPR2025-01029	IPR2025-01263	IPR2025-01333
IPR2025-01030	IPR2025-01268	IPR2025-01338
IPR2025-01031	IPR2025-01279	IPR2025-01339
IPR2025-01032	IPR2025-01284	IPR2025-01357
IPR2025-01033	IPR2025-01285	IPR2025-01358
IPR2025-01112	IPR2025-01286	IPR2025-01359
IPR2025-01113	IPR2025-01287	IPR2025-01360
IPR2025-01130	IPR2025-01288	IPR2025-01366
IPR2025-01174	IPR2025-01305	IPR2025-01370
IPR2025-01176	IPR2025-01317	IPR2025-01371
IPR2025-01184	IPR2025-01318	IPR2025-01372
IPR2025-01210	IPR2025-01319	IPR2025-01373
IPR2025-01211	IPR2025-01322	IPR2025-01380
IPR2025-01212	IPR2025-01323	IPR2025-01381
IPR2025-01214	IPR2025-01324	IPR2025-01382
IPR2025-01234	IPR2025-01325	

[1] *See* Memorandum entitled "Director Institution of AIA Trial Proceedings." Available at https://www.uspto.gov/sites/default/files/documents/Director_Institution_of_AIA_Trial_Proceedings.pdf.

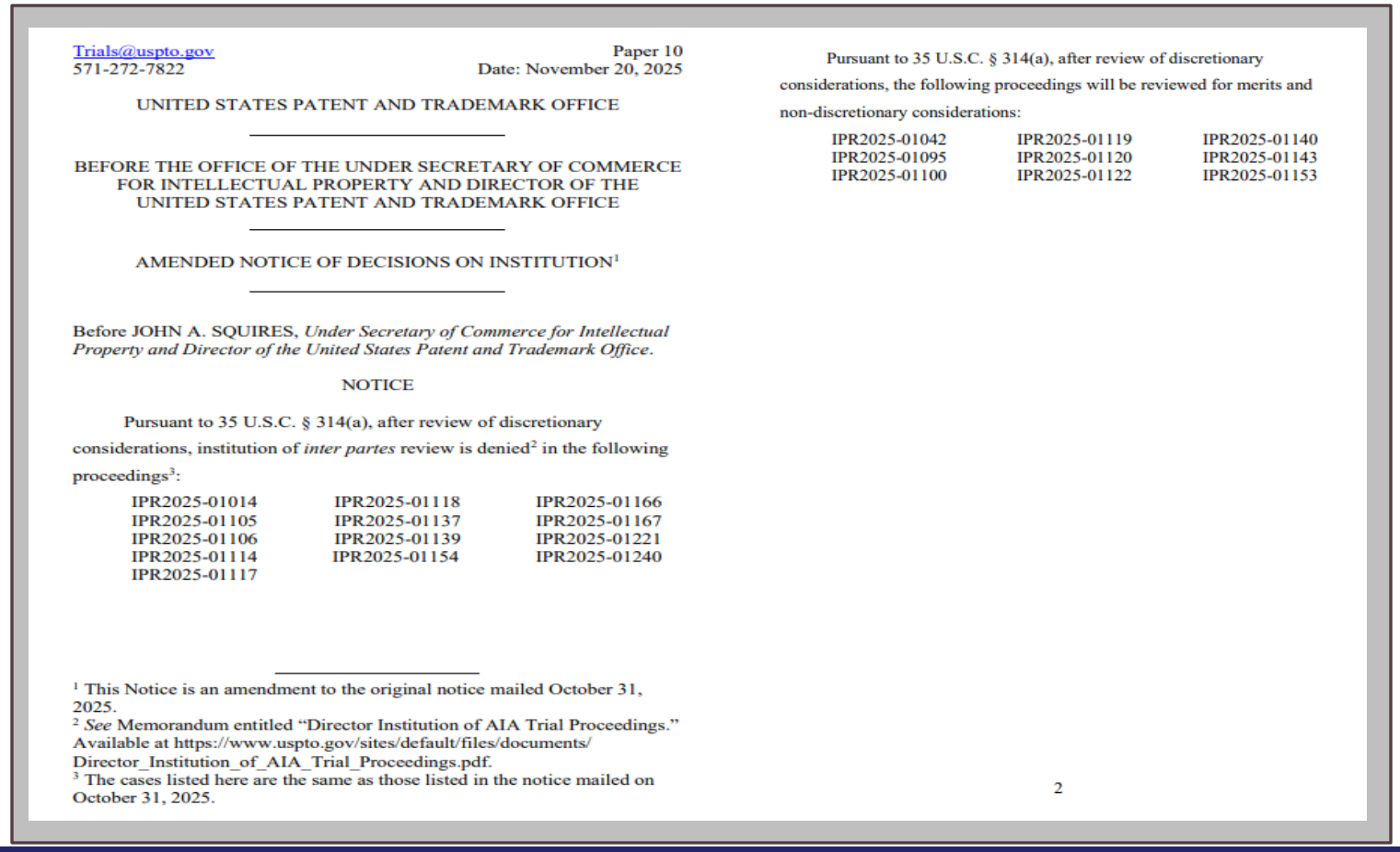
Pursuant to 35 U.S.C. § 314(a) and § 324(a), after review of discretionary considerations, the following proceedings will be reviewed for merits and non-discretionary considerations:

PGR2025-00061	IPR2025-01217	IPR2025-01274
PGR2025-00062	IPR2025-01237	IPR2025-01275
PGR2025-00066	IPR2025-01238	IPR2025-01276
IPR2025-01164	IPR2025-01241	IPR2025-01302
IPR2025-01165	IPR2025-01242	IPR2025-01328
IPR2025-01169	IPR2025-01245	IPR2025-01342*
IPR2025-01173	IPR2025-01246	IPR2025-01353
IPR2025-01179	IPR2025-01264	IPR2025-01355
IPR2025-01185	IPR2025-01265	IPR2025-01383*
IPR2025-01199	IPR2025-01269	
IPR2025-01215	IPR2025-01273	

Pursuant to 35 U.S.C. § 314(a), after review of the merits, the petitioner has failed to show a reasonable likelihood of prevailing with respect to at least one of the claims challenged in the petition. Accordingly, institution of *inter partes* review is denied in the following proceedings:

IPR2025-01119

Discretionary Review Decisions (November 20, 2025)



Trials@uspto.gov
571-272-7822

Paper 10
Date: November 20, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

AMENDED NOTICE OF DECISIONS ON INSTITUTION[1]

Before JOHN A. SQUIRES, *Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office*.

NOTICE

Pursuant to 35 U.S.C. § 314(a), after review of discretionary considerations, institution of *inter partes* review is denied[2] in the following proceedings[3]:

IPR2025-01014	IPR2025-01118	IPR2025-01166
IPR2025-01105	IPR2025-01137	IPR2025-01167
IPR2025-01106	IPR2025-01139	IPR2025-01221
IPR2025-01114	IPR2025-01154	IPR2025-01240
IPR2025-01117		

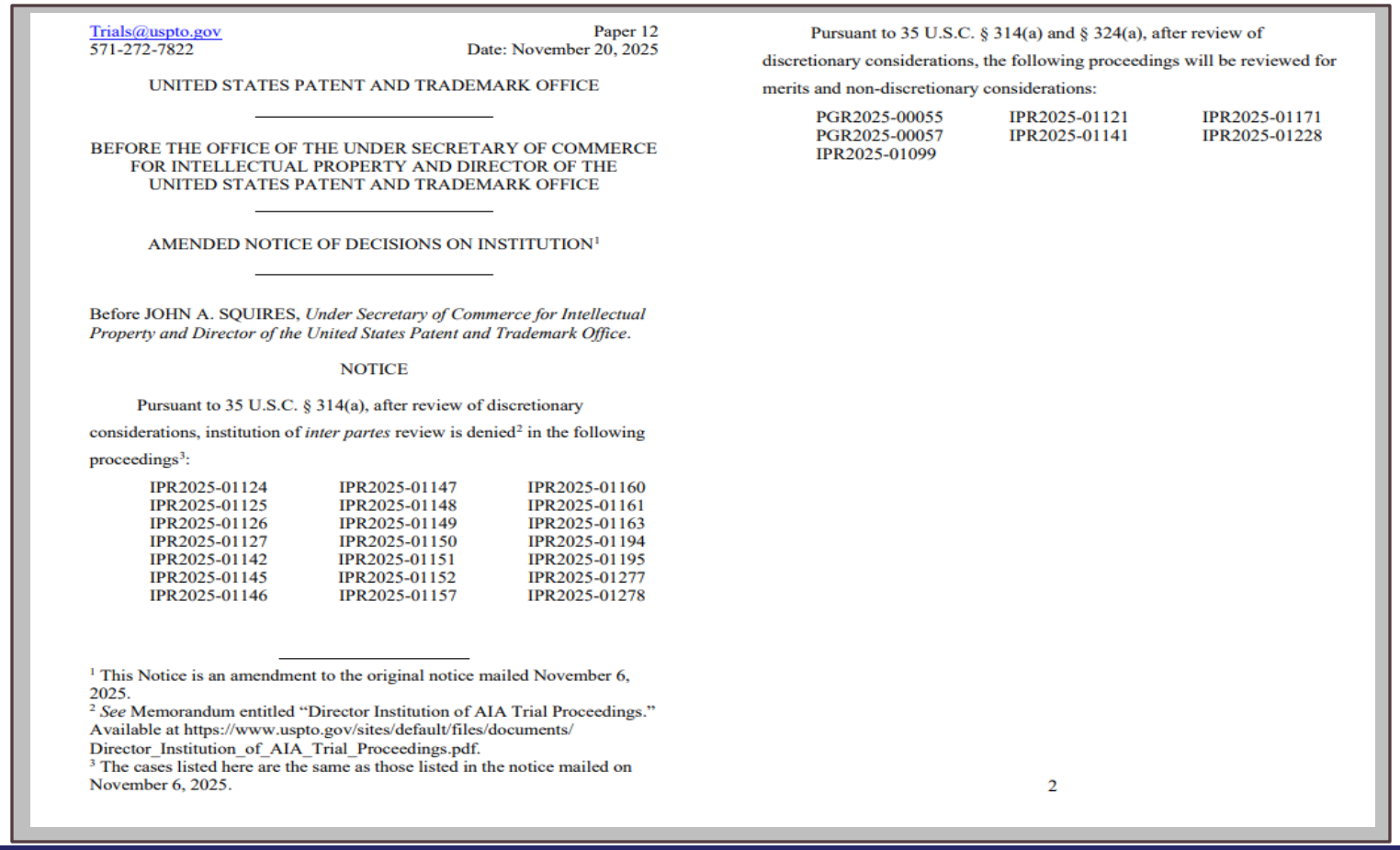
[1] This Notice is an amendment to the original notice mailed October 31, 2025.
[2] *See* Memorandum entitled "Director Institution of AIA Trial Proceedings." Available at https://www.uspto.gov/sites/default/files/documents/Director_Institution_of_AIA_Trial_Proceedings.pdf.
[3] The cases listed here are the same as those listed in the notice mailed on October 31, 2025.

Pursuant to 35 U.S.C. § 314(a), after review of discretionary considerations, the following proceedings will be reviewed for merits and non-discretionary considerations:

IPR2025-01042	IPR2025-01119	IPR2025-01140
IPR2025-01095	IPR2025-01120	IPR2025-01143
IPR2025-01100	IPR2025-01122	IPR2025-01153

2

Discretionary Review Decisions (November 20, 2025)



Trials@uspto.gov
571-272-7822

Paper 12
Date: November 20, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

AMENDED NOTICE OF DECISIONS ON INSTITUTION[1]

Before JOHN A. SQUIRES, *Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office*.

NOTICE

Pursuant to 35 U.S.C. § 314(a), after review of discretionary considerations, institution of *inter partes* review is denied[2] in the following proceedings[3]:

IPR2025-01124	IPR2025-01147	IPR2025-01160
IPR2025-01125	IPR2025-01148	IPR2025-01161
IPR2025-01126	IPR2025-01149	IPR2025-01163
IPR2025-01127	IPR2025-01150	IPR2025-01194
IPR2025-01142	IPR2025-01151	IPR2025-01195
IPR2025-01145	IPR2025-01152	IPR2025-01277
IPR2025-01146	IPR2025-01157	IPR2025-01278

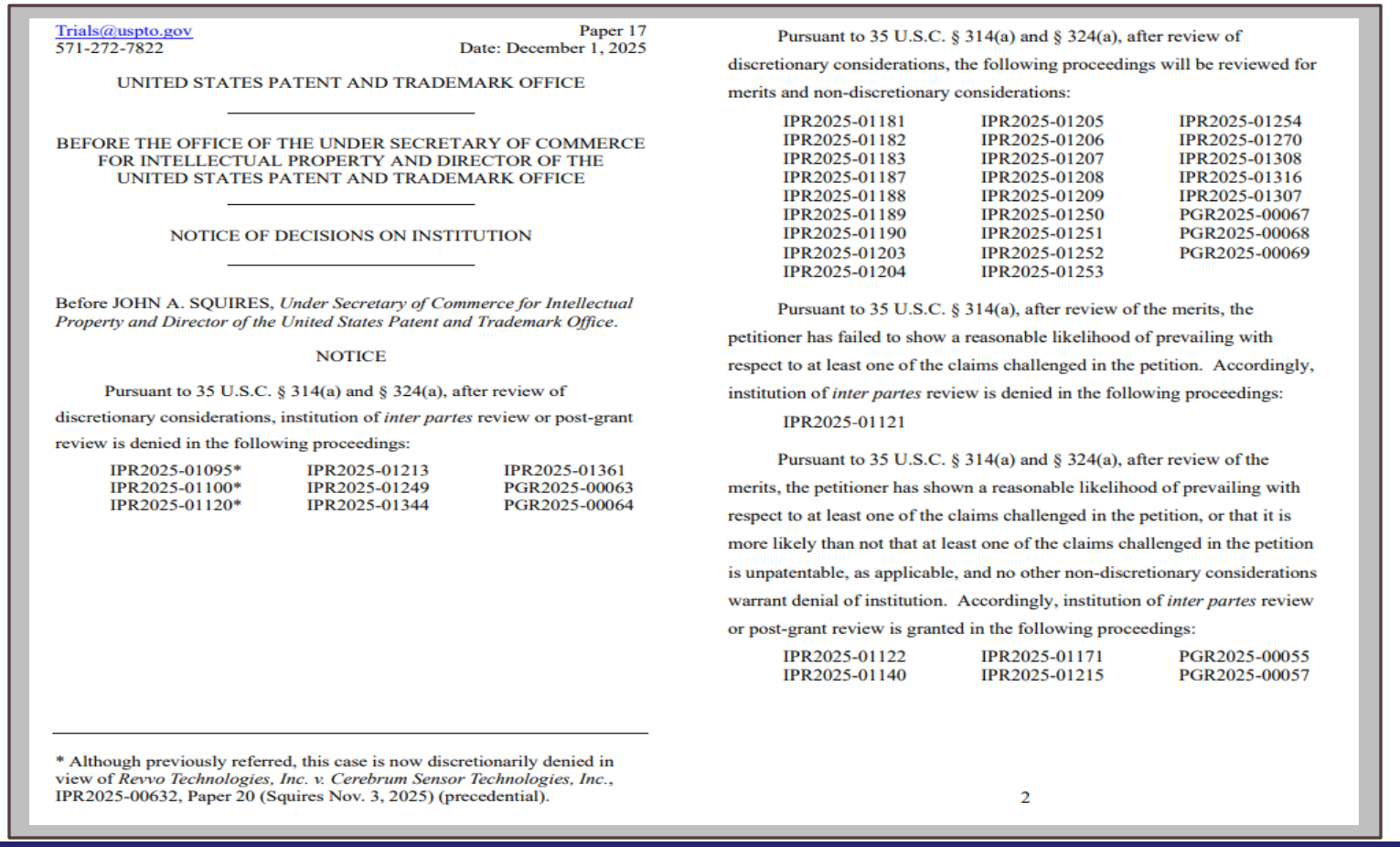
[1] This Notice is an amendment to the original notice mailed November 6, 2025.
[2] *See* Memorandum entitled "Director Institution of AIA Trial Proceedings." Available at https://www.uspto.gov/sites/default/files/documents/Director_Institution_of_AIA_Trial_Proceedings.pdf.
[3] The cases listed here are the same as those listed in the notice mailed on November 6, 2025.

Pursuant to 35 U.S.C. § 314(a) and § 324(a), after review of discretionary considerations, the following proceedings will be reviewed for merits and non-discretionary considerations:

PGR2025-00055	IPR2025-01121	IPR2025-01171
PGR2025-00057	IPR2025-01141	IPR2025-01228
IPR2025-01099		

2

Discretionary Review Decisions (December 1, 2025)



Trials@uspto.gov
571-272-7822

Paper 17
Date: December 1, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

NOTICE OF DECISIONS ON INSTITUTION

Before JOHN A. SQUIRES, *Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office*.

NOTICE

Pursuant to 35 U.S.C. § 314(a) and § 324(a), after review of discretionary considerations, institution of *inter partes* review or post-grant review is denied in the following proceedings:

IPR2025-01095*	IPR2025-01213	IPR2025-01361
IPR2025-01100*	IPR2025-01249	PGR2025-00063
IPR2025-01120*	IPR2025-01344	PGR2025-00064

* Although previously referred, this case is now discretionarily denied in view of *Revvo Technologies, Inc. v. Cerebrum Sensor Technologies, Inc.*, IPR2025-00632, Paper 20 (Squires Nov. 3, 2025) (precedential).

Pursuant to 35 U.S.C. § 314(a) and § 324(a), after review of discretionary considerations, the following proceedings will be reviewed for merits and non-discretionary considerations:

IPR2025-01181	IPR2025-01205	IPR2025-01254
IPR2025-01182	IPR2025-01206	IPR2025-01270
IPR2025-01183	IPR2025-01207	IPR2025-01308
IPR2025-01187	IPR2025-01208	IPR2025-01316
IPR2025-01188	IPR2025-01209	IPR2025-01307
IPR2025-01189	IPR2025-01250	PGR2025-00067
IPR2025-01190	IPR2025-01251	PGR2025-00068
IPR2025-01203	IPR2025-01252	PGR2025-00069
IPR2025-01204	IPR2025-01253	

Pursuant to 35 U.S.C. § 314(a), after review of the merits, the petitioner has failed to show a reasonable likelihood of prevailing with respect to at least one of the claims challenged in the petition. Accordingly, institution of *inter partes* review is denied in the following proceedings:

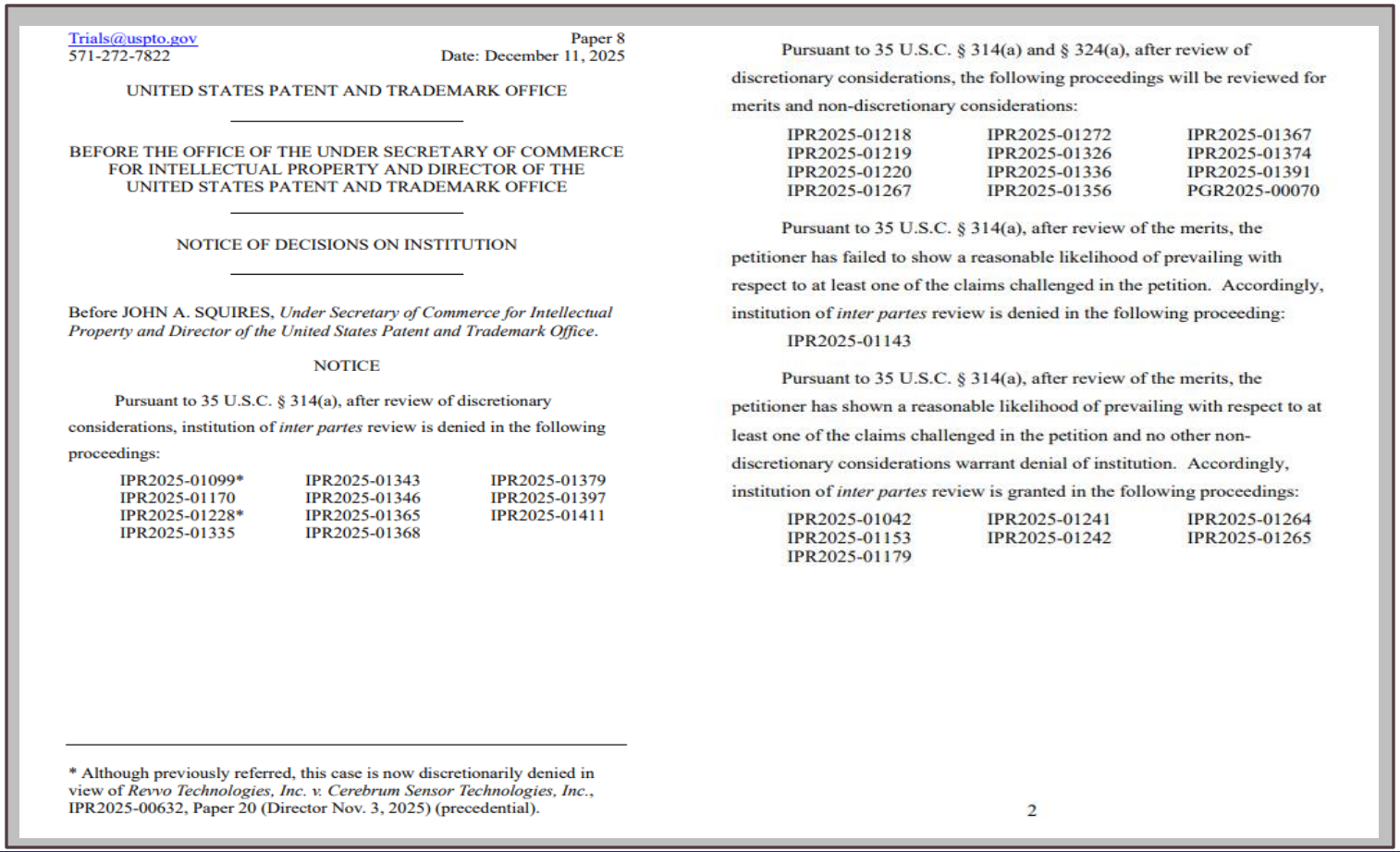
IPR2025-01121

Pursuant to 35 U.S.C. § 314(a) and § 324(a), after review of the merits, the petitioner has shown a reasonable likelihood of prevailing with respect to at least one of the claims challenged in the petition, or that it is more likely than not that at least one of the claims challenged in the petition is unpatentable, as applicable, and no other non-discretionary considerations warrant denial of institution. Accordingly, institution of *inter partes* review or post-grant review is granted in the following proceedings:

IPR2025-01122	IPR2025-01171	PGR2025-00055
IPR2025-01140	IPR2025-01215	PGR2025-00057

2

Discretionary Review Decisions (December 11, 2025)



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571-272-7822

Paper 8
Date: December 11, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

NOTICE OF DECISIONS ON INSTITUTION

Before JOHN A. SQUIRES, *Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office*.

NOTICE

Pursuant to 35 U.S.C. § 314(a), after review of discretionary considerations, institution of *inter partes* review is denied in the following proceedings:

IPR2025-01099*	IPR2025-01343	IPR2025-01379
IPR2025-01170	IPR2025-01346	IPR2025-01397
IPR2025-01228*	IPR2025-01365	IPR2025-01411
IPR2025-01335	IPR2025-01368	

* Although previously referred, this case is now discretionarily denied in view of *Revvo Technologies, Inc. v. Cerebrum Sensor Technologies, Inc.*, IPR2025-00632, Paper 20 (Director Nov. 3, 2025) (precedential).

Pursuant to 35 U.S.C. § 314(a) and § 324(a), after review of discretionary considerations, the following proceedings will be reviewed for merits and non-discretionary considerations:

IPR2025-01218	IPR2025-01272	IPR2025-01367
IPR2025-01219	IPR2025-01326	IPR2025-01374
IPR2025-01220	IPR2025-01336	IPR2025-01391
IPR2025-01267	IPR2025-01356	PGR2025-00070

Pursuant to 35 U.S.C. § 314(a), after review of the merits, the petitioner has failed to show a reasonable likelihood of prevailing with respect to at least one of the claims challenged in the petition. Accordingly, institution of *inter partes* review is denied in the following proceeding:

IPR2025-01143

Pursuant to 35 U.S.C. § 314(a), after review of the merits, the petitioner has shown a reasonable likelihood of prevailing with respect to at least one of the claims challenged in the petition and no other non-discretionary considerations warrant denial of institution. Accordingly, institution of *inter partes* review is granted in the following proceedings:

IPR2025-01042	IPR2025-01241	IPR2025-01264
IPR2025-01153	IPR2025-01242	IPR2025-01265
IPR2025-01179		

2

Summary of Discretionary Review Decisions (Since November 18th)

- Denied institution on **sixty-two (62)** pending inter partes review proceedings pursuant to 35 U.S.C. § § 314(a) and 324(a).
- Denied institution on **three (3)** pending post-grant review proceedings pursuant to 35 U.S.C. § § 314(a) and 324(a).
- Denied institution on **forty-eight (48)** pending inter partes review proceeding pursuant to 35 U.S.C. § 314(a).
- Allowed **eight (8)** pending post-grant review proceedings to proceed to review for merits and non-discretionary considerations pursuant to 35 U.S.C. § § 314(a) and 324(a).
- Allowed **sixty-seven (67)** pending inter partes review proceedings to proceed to review for merits and non-discretionary considerations pursuant to 35 U.S.C. § § 314(a) and 324(a).
- Allowed **nine (9)** pending inter partes review proceedings to proceed to review for merits and non-discretionary considerations pursuant to 35 U.S.C. § 314(a).
- Granted institution on **eleven (11)** pending inter partes review proceedings.
- Granted institution on **two (2)** pending post-grant review proceedings.

December 2025 Decisions in Proceedings Where Director Review Was Granted

Decisions in Proceedings Where Director Review Was Granted (Since November 18)

- ***Harbor Freight Tools USA Inc., Generac Powers Systems, Inc, and MWE Investments, LLC v. Champion Power Equipment, Inc.*, IPR2025-00805**
  - Order Initiating *Sua Sponte* Director Review – Paper 30 (Squires December 10, 2025)

- ***Harbor Freight Tools USA Inc., Generac Powers Systems, Inc, and MWE Investments, LLC v. Champion Power Equipment, Inc.*, IPR2025-00951**
  - Order Initiating *Sua Sponte* Director Review – Paper 26 (Squires December 9, 2025)

Director_PTABDecision_Review@uspto.gov
571.272.7822

Paper 30
Date: December 10, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

HARBOR FREIGHT TOOLS USA, INC.
GENERAC POWERS SYSTEMS, INC. and
MWE INVESTMENTS, LLC,
Petitioner,

v.

CHAMPION POWER EQUIPMENT, INC.,
Patent Owner.

IPR2025-00805
Patent 10,393,034 B2

Before JOHN A. SQUIRES, *Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.*

ORDER
Initiating *Sua Sponte* Director Review

➢ *Harbor Freight Tools USA Inc., Generac Powers Systems, Inc, and MWE Investments, LLC v. Champion Power Equipment, Inc.*, IPR2025-00805

➢ Order Initiating *Sua Sponte* Director Review – Paper 30 (Squires December 10, 2025)

On November 13, 2025, the Board issued a Decision granting institution of inter partes review in the above-referenced proceeding. Paper 24 ("Decision"). Patent Owner requested rehearing of that Decision on November 26, 2025 (Paper 26), and the Board denied that request on December 8, 2025 (Paper 29 ("Decision on Rehearing")).

I have reviewed the Board's decisions, the relevant papers, and the relevant exhibits of record and, given recent precedential and informative designations, determine **that sua sponte Director Review of the Board's Decision and the related Decision on Rehearing is appropriate to address the claim construction issues raised. An opinion will issue in due course**.

Accordingly, based on the foregoing, it is:

ORDERED that a sua sponte Director Review of the Board's Decision granting institution of inter partes review (Paper 24) and the Decision on Rehearing (Paper 29) is initiated; and

FURTHER ORDERED that an opinion will issue in due course.

Director_PTABDecision_Review@uspto.gov
571.272.7822

Paper 26
Date: December 9, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

HARBOR FREIGHT TOOLS USA, INC.
GENERAC POWERS SYSTEMS, INC. and
MWE INVESTMENTS, LLC,
Petitioner,

v.

CHAMPION POWER EQUIPMENT, INC.,
Patent Owner.

IPR2025-00951
Patent 10,598,101 B2

Before JOHN A. SQUIRES, *Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.*

ORDER
Initiating *Sua Sponte* Director Review

➢ *Harbor Freight Tools USA Inc., Generac Powers Systems, Inc, and MWE Investments, LLC v. Champion Power Equipment, Inc.*, IPR2025-00951

➢ Order Initiating *Sua Sponte* Director Review – Paper 26 (Squires December 9, 2025)

On November 20, 2025, the Board issued a Decision granting institution of inter partes review in the above-referenced proceeding. Paper 22.

I have reviewed the Board's Decision, the relevant papers, and the relevant exhibits of record, and given recent precedential and informative designations, determine that **sua sponte Director Review of the Board's Decision is appropriate to address the claim construction issues raised**. An opinion will issue in due course.

Accordingly, based on the foregoing, it is:

ORDERED that a sua sponte Director Review of the Board's Decision granting institution of inter partes review (Paper 22) is initiated; and

FURTHER ORDERED that an opinion will issue in due course.

CLE Code

General USPTO Updates

USPTO Launches Data-Driven Quality Initiative to Address Areas of Highest Deviation

- On November 21, 2025, the U.S. Patent and Trademark Office (USPTO) announced it is launching a data-driven initiative to enhance patent quality by focusing examination resources on areas showing the greatest statistical deviation, aiming to ensure consistent treatment across similarly situated applications
- Starting in Fiscal Year 2026, this approach will prioritize strategic reviews in high-variation areas, reducing variability in outcomes and reinforcing confidence in the strength and reliability of issued patents

https://www.uspto.gov/subscription-center/2025/revised-inventorship-guidance-ai-assisted-inventions

Joint Comment on the Public Interest of the United States Patent and Trademark Office and the United States Department of Justice

- On November 25, 2025, the USPTO and DOJ issued a joint comment on the U.S. International Trade Commission's (USITC) enforcement of Section 337 of the Tariff Act of 1930 (issuing exclusion orders to bar the importation of articles that infringe valid U.S. patents)
  - Public interest considerations have only served as narrow exceptions in extraordinary circumstances
  - The USITC has consistently upheld this statutory framework, rejecting attempts to use public interest factors as preliminary obstacles to enforcement or as excuses to deny meritorious complaints
- The USPTO and DOJ stress that enforcing valid patent rights through exclusion orders promotes innovation, competition, and the public interest, and the USITC should continue applying public interest exceptions *narrowly and only after finding infringement*

https://www.justice.gov/atr/media/1419496/dl

USPTO Issues Revised Inventorship Guidance

- On November 26, 2025, the USPTO issued Revised Inventorship Guidance for AI-Assisted Inventions, replacing the February 2024 guidance and clarifying that AI systems are solely tools, not inventors
- The new guidance withdraws the prior application of the Pannu factors to AI-assisted inventions and reinforces that the traditional legal standard for inventorship applies uniformly

https://www.uspto.gov/subscription-center/2025/revised-inventorship-guidance-ai-assisted-inventions

USPTO Issues New Trial Practice Guide

USPTO Issues New Trial Practice Guide

- On December 12, 2025, section II.B.4 and II.D.1.C were deleted and section II.M. and Appendix A-1 were updated.

USPTO Issues New Trial Practice Guide–Deleted Section II.B.4: Covered Business Method/Technological Invention

- A petitioner in a CBM proceeding must demonstrate that the patent for which review is sought is a covered business method patent. 37 C.F.R. § 42.304(a). Covered business method patents by definition do not include patents for technological inventions.
- The following claim drafting techniques would not typically render a patent a technological invention: (a) Mere recitation of known technologies, such as computer hardware, communication or computer networks, software, memory, computer-readable storage medium, scanners, display devices or databases, or specialized machines, such as an ATM or point of sale device. (b) Reciting the use of known prior art technology to accomplish a process or method, even if that process or method is novel and non-obvious. (c) Combining prior art structures to achieve the normal, expected, or predictable result of that combination.
- The following are examples of covered business method patents that are subject to a CBM review proceeding: (a) A patent that claims a method for hedging risk in the field of commodities trading. (b) A patent that claims a method for verifying validity of a credit card transaction.
- The following are examples of patents that claim a technological invention that would not be subject to a CBM review proceeding: (a) A patent that claims a novel and non-obvious hedging machine for hedging risk in the field of commodities trading. (b) A patent that claims a novel and non-obvious credit card reader for verifying the validity of a credit card transaction.

https://www.uspto.gov/patents/ptab/trial-practice-guide#step1

USPTO Issues New Trial Practice Guide–Deleted Section II.D.1.C: Covered Business Method Patent Review

- Generally, the Director may institute a proceeding where a petitioner meets the threshold standards. There is a different statutory threshold standard for institution of each type of proceeding. Each of the statutory threshold standards is summarized below.

- Section 18(a)(1) of the AIA provides that the transitional proceeding for covered business method patents will be regarded as, and will employ the standards and procedures of, a post-grant review under chapter 32 of title 35 United States Code, subject to certain exceptions. Section 18(a)(1)(B) of the AIA specifies that a person may not file a petition for a transitional proceeding with respect to a covered business method patent unless the person or person's real party-in-interest or privy has been sued for infringement of the patent or has been charged with infringement under that patent. A covered business method patent means a patent that claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, except that the term does not include patents for technological inventions.

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USPTO Issues New Trial Practice Guide– Updated Section II.M.: Oral Hearing

- [PREVIOUS VERSION]
  - A pre-hearing conference call will be held at either party's request and will generally occur no later than three business days prior to the oral hearing. Prior to making such a request, the parties should meet and confer and, when possible, send a joint request to the Board with an agreed upon set of limited issues for discussion. A request for a pre-hearing conference may be made by email and shall include a list of issues to be discussed during the call, including, e.g., identification of a limited number of objections for early resolution as discussed above. The time for making the request will be set in the Scheduling Order, but generally will be required to be sent to the Board no later than the due date set for a reply to an opposition to motion to exclude evidence.
  - The purpose of the pre-hearing conference is to afford the parties the opportunity to preview (but not argue) the issues to be discussed at the oral hearing, and to seek the Board's guidance as to particular issues that the panel would like addressed by the parties. The parties may also discuss with the Board any pending motions to strike, request an early decision on the admissibility of a limited number of exhibits subject to a motion to exclude, and discuss any unresolved issues with demonstrative exhibits. The Board will preferably rule on pending motions and limited numbers of objections and disputed exhibits during the pre-hearing conference (or after the pre-hearing conference but before the oral hearing), but may also defer ruling until the oral hearing or thereafter.

- [NEW VERSION]
  - The Board will hold a pre-hearing conference call with both parties, which will occur no later than fifteen days prior to the oral hearing. The purpose of the pre-hearing conference is for the Board panel to provide guidance as to particular issues that the panel would like the parties to address at the oral hearing, for example, claim construction issues, reason to combine prior art teachings, or objective indicia of nonobviousness. The pre-hearing conference also provides the parties the opportunity to identify (but not argue) any issues the parties would like to address at the oral hearing. The parties may also discuss with the Board any pending motions, request an early decision on the admissibility of a limited number of exhibits subject to a motion to exclude, and discuss any unresolved issues with demonstrative exhibits. The Board will preferably rule on pending motions and limited numbers of objections and disputed exhibits during the pre-hearing conference (or after the pre-hearing conference but before the oral hearing), but may also defer ruling until the oral hearing or thereafter.

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USPTO Issues New Trial Practice Guide– Updated Appendix A-1 Initial and Additional Conference Calls

- [PREVIOUS VERSION]
  - The parties are directed to contact the Board within a month of this Order if there is a need to discuss proposed changes to this Scheduling Order or proposed motions that have not been authorized in this Order or other prior Order or Notice. See Office Patent Trial Practice Guide ("Practice Guide") (guidance in preparing for the initial conference call). A request for an initial conference call shall include a list of proposed motions, if any, to be discussed during the call.

- [NEW VERSION]
  - The parties are directed to contact the Board within a month of this Order if there is a need to discuss proposed changes to this Scheduling Order or proposed motions that have not been authorized in this Order or other prior Order or Notice. *See* Consolidated Trial Practice Guide ("Consolidated Practice Guide")[1] at 9–10, 65 (guidance in preparing for a conference call); see also 84 Fed. Reg. 64,280 (Nov. 21, 2019). A request for an initial conference call shall include a list of proposed motions, if any, to be discussed during the call.

    [The parties may request additional conference calls as needed. Any email requesting a conference call with the Board should: (a) copy all parties, (b) indicate generally the relief being requested or the subject matter of the conference call, (c) include multiple times when all parties are available, (d) state whether the opposing party opposes any relief requested, and (e) if opposed, either certify that the parties have met and conferred telephonically or in person to attempt to reach agreement, or explain why such meet and confer did not occur. The email may not contain substantive argument and, unless otherwise authorized, may not include attachments. *See* Consolidated Practice Guide at 9–10.]

USPTO Issues New Trial Practice Guide– Updated Appendix A-1 Related Matter Updates

[NEW SECTION]

The parties must keep the Board apprised of developments regarding adjudication of validity or patentability of the challenged patent claims, or substantially similar patent claims, such as claim construction, findings of fact, or conclusions of law, in "any other judicial or administrative matter that would affect, or be affected by, a decision in the proceeding" and is identified as a related matter under 37 C.F.R. § 42.8(b)(2). The parties must alert the Board to any such developments within five business days, by sending an email to **Trials@uspto.gov**, and file in the docket of this proceeding relevant materials from the related matter(s).

USPTO Issues New Trial Practice Guide– Updated Appendix A-1 Protective Order

[NEW ADDITION]

No protective order shall apply to this proceeding until the Board enters one. If either party files a motion to seal before entry of a protective order, a jointly proposed protective order shall be filed as an exhibit with the motion. It is the responsibility of the party whose confidential information is at issue, not necessarily the proffering party, to file the motion to seal.[2] The Board encourages the parties to adopt the Board's default protective order if they conclude that a protective order is necessary. *See* Consolidated Practice Guide at 107–122 (App. B, Protective Order Guidelines and Default Protective Order). If the parties choose to propose a protective order deviating from the default protective order, they must submit the proposed protective order jointly along with a marked-up comparison of the proposed and default protective orders showing the differences between the two and explain why good cause exists to deviate from the default protective order.

USPTO Issues New Trial Practice Guide–Updated Appendix A-1 Motion to Amend

- [NEW SECTION]

- Patent Owner may file a motion to amend without prior authorization from the Board. Nevertheless, Patent Owner must confer with the Board before filing such a motion. 37 C.F.R. 42.121(a). [3] To satisfy this requirement, Patent Owner should request a conference call with the Board no later than two weeks prior to DUE DATE 1. See Section B below regarding DUE DATES.

Any motion to amend and briefing related to such a motion shall comply with the rules pertaining to motions to amend (37 C.F.R. § 42.121) and the practices and procedures described in *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 15 (PTAB Feb. 25, 2019) (precedential).

Patent Owner has the option to receive preliminary guidance from the Board on its motion to amend. See 37 C.F.R. § 42.121(e). If Patent Owner elects to request preliminary guidance from the Board on its motion, it must do so in its motion to amend filed on DUE DATE 1. *Id.* § 42.121(a)(1)(ii).

At DUE DATE 3, Patent Owner may file a reply to the opposition to the motion to amend and/or the preliminary guidance. 37 C.F.R. § 42.121(e)(3). In lieu of a reply, Patent Owner has the option to file a revised motion to amend that addresses the issues raised in the preliminary guidance or in petitioner's opposition to the motion to amend. *Id.* § 42.121(f)(1)–(2). Patent Owner may elect to file a revised motion to amend even if Patent Owner did not request to receive preliminary guidance on its motion to amend. A revised motion to amend must include one or more new proposed substitute claims in place of the previously presented substitute claims, where each new proposed substitute claim presents a new claim amendment. *Id.*

If Patent Owner files a revised motion to amend, the Board may determine whether to request the Chief Administrative Patent Judge to extend the final written decision deadline more than one year from the date a trial is instituted in accordance with § 42.100(c) and whether to extend any remaining deadlines under § 42.5(c)(2). 37 C.F.R. § 42.121(f)(1). Typically the Board will enter a revised scheduling order setting the briefing schedule for that revised motion and adjusting other due dates as needed.

At DUE DATE 5, Petitioner may file a sur-reply that is limited to responding to the preliminary guidance and/or arguments made in the patent owner's reply brief. *Id.* § 42.121(e)(3). The sur-reply may not be accompanied by new evidence, but may comment on any new evidence filed with the reply and/or point to cross-examination testimony of a reply witness, if relevant to the arguments made in the reply brief. *Id.*

If the Board issues preliminary guidance on the motion to amend, and Patent Owner files neither a reply to the opposition to the motion to amend nor a revised motion to amend at DUE DATE 3, Petitioner may file a reply to the Board's preliminary guidance, no later than three (3) weeks after DUE DATE 3 or at any other DUE DATE that the Board specifies in a revised scheduling order. The reply may only respond to the preliminary guidance and may not be accompanied by new evidence. 37 C.F.R. § 42.121(e)(4). Patent Owner may file a sur-reply in response to Petitioner's reply to the Board's preliminary guidance. Id. The sur-reply may only respond to petitioner's reply and may not be accompanied by new evidence. *Id.* The sur-reply must be filed no later than three (3) weeks after Petitioner's reply or at any other DUE DATE that the Board specifies in a revised scheduling order.

In the event the Board requests examination assistance pursuant to 37 C.F.R. § 42.121(d)(3)(ii), the parties will be notified of the request and may adjust the scheduling order as needed.

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USPTO Issues New Trial Practice Guide–Updated Appendix A-1 Pre-Hearing Conference

- [NEW SECTION]

- The Board will hold a pre-hearing conference call with both parties. The purpose of the pre-hearing conference is for the Board panel to provide guidance as to particular issues that the panel would like the parties to address at the oral hearing, for example, claim construction issues, reason to combine prior art teachings, or objective indicia of nonobviousness. The pre-hearing conference also provides the parties the opportunity to identify (but not argue) any issues the parties would like to address at the oral hearing. The parties may also discuss with the Board any pending motions, request an early decision on the admissibility of a limited number of exhibits subject to a motion to exclude, and discuss any unresolved issues with demonstrative exhibits.

USPTO Issues New Trial Practice Guide– Updated Appendix A-1 Oral Arguments

[PREVIOUS VERSION]

Requests for oral argument must comply with 37 C.F.R. § 42.70(a). To permit the Board sufficient time to schedule the oral argument, the parties may not stipulate to an extension of the request for oral argument beyond the date set forth in the Due Date Appendix. Unless the Board notifies the parties otherwise, oral argument, if requested, will be held at [the USPTO headquarters in Alexandria] [the Detroit, Michigan, USPTO Regional Office] [the Dallas, Texas, USPTO Regional Office] [the Denver, Colorado, USPTO Regional Office] [the San Jose, California, USPTO Regional Office]. The parties may request that the oral argument instead be held at [the USPTO headquarters in Alexandria] [the Detroit, Michigan, USPTO Regional Office] [the Dallas, Texas, USPTO Regional Office] [the Denver, Colorado, USPTO Regional Office] [the San Jose, California, USPTO Regional Office], or [the USPTO headquarters in Alexandria] [the Detroit, Michigan, USPTO Regional Office] [the Dallas, Texas, USPTO Regional Office] [the Denver, Colorado, USPTO Regional Office] [the San Jose, California, USPTO Regional Office]. The parties should meet and confer, and jointly propose the parties' preference at the initial conference call, if requested. Alternatively, the parties may jointly file a paper stating their preference for the hearing location within one month of this order. Note that the Board may not be able to honor the parties' preference of hearing location due to, among other things, the availability of hearing room resources and the needs of the panel. The Board will consider the location request and notify the parties accordingly if a request for change in location is granted.

Seating in the Board's hearing rooms may be limited, and will be available on a firstcome, first-served basis. If either party anticipates that more than five (5) individuals will attend the argument on its behalf, the party should notify the Board as soon as possible, and no later than the request for oral argument. Parties should note that the earlier a request for accommodation is made, the more likely the Board will be able to accommodate additional individuals.

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USPTO Issues New Trial Practice Guide– Updated Appendix A-1 Oral Arguments

[NEW VERSION]

Requests for oral argument must comply with 37 C.F.R. § 42.70(a). To permit the Board sufficient time to schedule the oral argument, the parties may not stipulate to an extension of the request for oral argument beyond the date set forth in the Due Date Appendix.

All oral arguments will be held in person, and both parties are expected to be physically present, absent a showing of good cause. Good cause will generally be limited to circumstances such as financial hardship, medical emergencies, or other comparable obstacles to in-person attendance. Approval for virtual appearance is determined on a party-by-party basis. An approved request for one party does not constitute good cause for others; each party must independently demonstrate good cause.

The parties may request that the oral argument be held at [the USPTO headquarters in Alexandria] [the Detroit, Michigan, USPTO Regional Office] [the Dallas, Texas, USPTO Regional Office] [the San Jose, California, USPTO Regional Office. [For the parties' information in making this decision [[x number of judge(s) will appear remotely by video], [y number of judge(s) will appear in-person from [the USPTO headquarters in Alexandria] [the Detroit, Michigan, USPTO Regional Office] [the Dallas, Texas, USPTO Regional Office] [the San Jose, California, USPTO Regional Office]] and [z number of judge(s) will appear in-person from [the USPTO headquarters in Alexandria] [the Detroit, Michigan, USPTO Regional Office] [the Dallas, Texas, USPTO Regional Office] [the San Jose, California, USPTO Regional Office]]. The parties should state in the request for oral argument, DUE DATE 4, (1) which of the location(s) named above the parties would prefer or (2) whether good cause exists for a party to appear virtually. To the extent the parties disagree, they should meet and confer; if the dispute cannot be resolved by meeting and conferring, the parties should inform the Board of each party's individual preferences.

Note that the Board may not be able to honor the parties' preferences due to, among other things, the availability of hearing room resources, the needs of the panel, and USPTO policy at the time of the hearing. The Board will consider the parties' request and notify the parties of how and where the hearing will be conducted.

For in-person hearings, seating in the Board's hearing rooms may be limited, and will be available on a first-come, first-served basis. If either party anticipates that more than five (5) individuals will attend the argument on its behalf, the party should notify the Board as soon as possible, and no later than the request for oral argument. Parties should note that the earlier a request for accommodation is made, the more likely the Board will be able to accommodate additional individuals.

The Board has established the "Legal Experience and Advancement Program," or "LEAP," to encourage advocates before the Board to develop their skills and to aid in succession planning for the next generation. The Board defines a LEAP practitioner as a patent agent or attorney having three (3) or fewer substantive oral arguments in any federal tribunal, including PTAB. Parties are encouraged to participate in the Board's LEAP program.[4] The Board will grant up to fifteen (15) minutes of additional argument time to that party, depending on the length of the proceeding and the PTAB's hearing schedule. A party should submit a request, no later than at least five (5) business days before the oral hearing, by email to the Board at PTABHearings@uspto.gov. [5]

All practitioners appearing before the Board shall demonstrate the highest professional standards. All practitioners are expected to have a command of the factual record, the applicable law, and Board procedures, as well as the authority to commit the party they represent. The Board discerns that it is often LEAP practitioners who have the best understanding of the facts of the case and the evidence of record, and the Board encourages their participation.

Next Month (November PTAB Committee)

On Tuesday, January 20, 2025, the next PTAB Committee Meeting for the NYIPLA will continue to provide a monthly update on the evolution of the PTAB.

Please make sure to join us every month on the third Tuesday of each month, at 4:00 p.m. ET for our virtual PTAB Committee meetings.