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Monthly Update from the PTAB Committee

Amster Rothstein & Ebenstein LLP

PTAB Committee

Featuring guest speaker:

Joshua Jacobson, *Law Clerk,*
Amster Rothstein & Ebenstein LLP

Moderated by

Charles Macedo

Ken Adamo

ZOOM WEBINAR

January 20th 2026

4-5 PM ET

RSVP: ADMIN@NYIPLA.ORG | 1.0 NY/NJ CLE AVAILABLE FOR ATTENDEES

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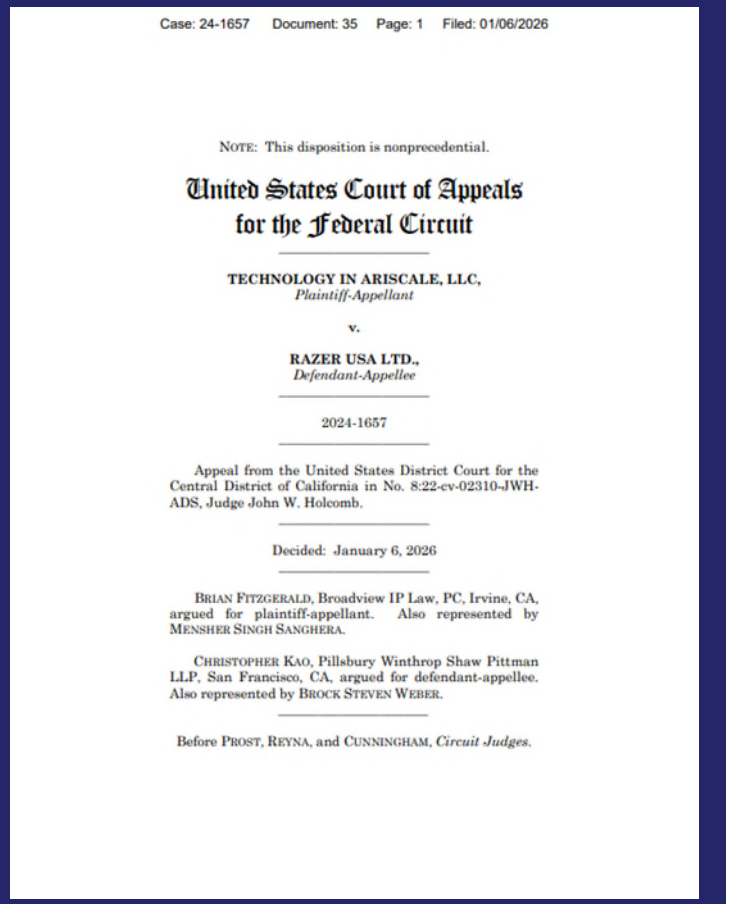
Additionally, the following content is presented solely for the purposes of discussion and illustration, and does not comprise, nor is to be considered, as legal advice.

Agenda

- Update on Federal Circuit Review
- Update on Discretionary Denials
- Update on Director Review
- General USPTO Updates

Update on Federal Circuit Review since December 17



Case: 24-1657 Document: 35 Page: 1 Filed: 01/06/2026

NOTE: This disposition is nonprecedential.

United States Court of Appeals
for the Federal Circuit

TECHNOLOGY IN ARISCALE, LLC,
Plaintiff-Appellant

v.

RAZER USA LTD.,
Defendant-Appellee

2024-1657

Appeal from the United States District Court for the Central District of California in No. 8:22-cv-02310-JWH-ADS, Judge John W. Holcomb.

Decided: January 6, 2026

BRIAN FITZGERALD, Broadview IP Law, PC, Irvine, CA, argued for plaintiff-appellant. Also represented by MENSHER SINGH SANGHERA.

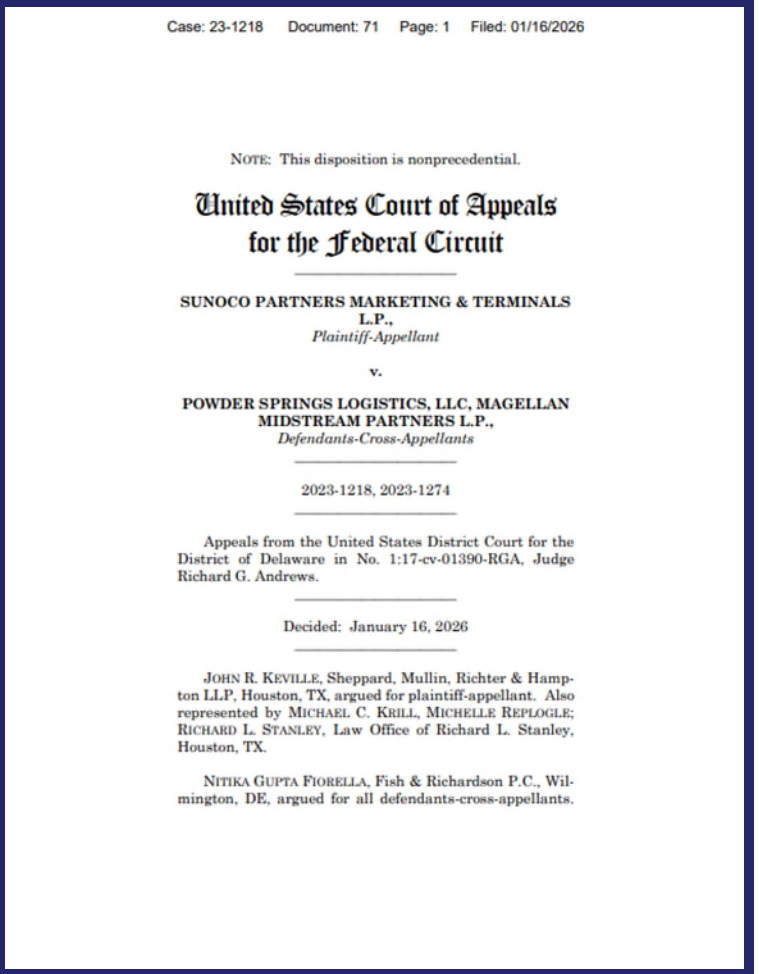
CHRISTOPHER KAO, Pillsbury Winthrop Shaw Pittman LLP, San Francisco, CA, argued for defendant-appellee. Also represented by BROCK STEVEN WEBER.

Before PROST, REYNA, and CUNNINGHAM, *Circuit Judges*.

Technology in Ariscale, LLC v. Razer USA Ltd., Federal Circuit (Nonprecedential, Jan. 6, 2026)

- The Federal Circuit affirmed the Central District of California's judgment that claims 1 and 14 of U.S. Patent No. 8,139,652 are invalid under 35 U.S.C. § 101
- Held the method for decoding a transmission signal is directed to the abstract idea of receiving, manipulating, and decoding data using generic computer functions
  - The court found no inventive concept in the ordered combination of steps because the claimed sequence did not add meaningful technical detail beyond conventional processing and the specification's described benefits were not captured in the claim language
- Merely performing data manipulation, signal decoding, or other generic computational steps is insufficient to overcome § 101, even if framed as a technical method

Sunoco Partners Marketing & Terminal L.P. v. Powder Springs Logistics LLC (Nonprecedential, Jan. 16, 2026)



Case: 23-1218 Document: 71 Page: 1 Filed: 01/16/2026

NOTE: This disposition is nonprecedential.

United States Court of Appeals for the Federal Circuit

SUNOCO PARTNERS MARKETING & TERMINALS L.P.,
Plaintiff-Appellant

v.

POWDER SPRINGS LOGISTICS, LLC, MAGELLAN MIDSTREAM PARTNERS L.P.,
Defendants-Cross-Appellants

2023-1218, 2023-1274

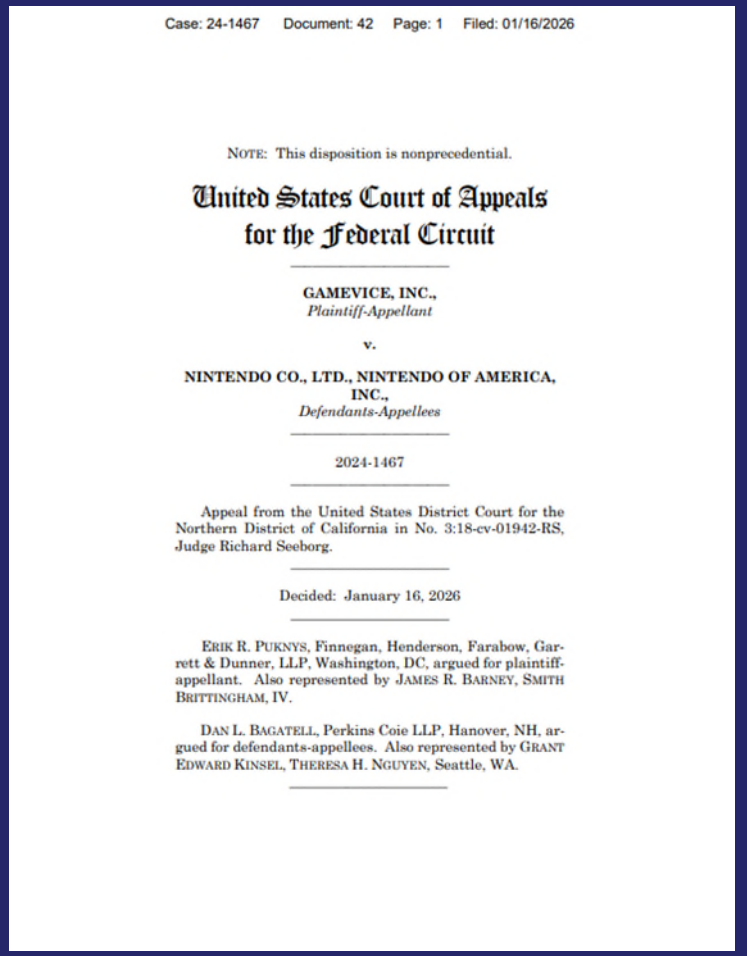
Appeals from the United States District Court for the District of Delaware in No. 1:17-cv-01390-RGA, Judge Richard G. Andrews.

Decided: January 16, 2026

JOHN R. KEVILLE, Sheppard, Mullin, Richter & Hampton LLP, Houston, TX, argued for plaintiff-appellant. Also represented by MICHAEL C. KRILL, MICHELLE REPLOGLE; RICHARD L. STANLEY, Law Office of Richard L. Stanley, Houston, TX.

NITIKA GUPTA FIORELLA, Fish & Richardson P.C., Wilmington, DE, argued for all defendants-cross-appellants.

- Patent infringement suit concerning systems and methods for blending butane with gasoline
- Federal Circuit affirmed the district court's damages decisions, affirm the district court's JMOL of no infringement, and affirm-in-part and reverse-in-part the district court's eligibility decision



Case: 24-1467 Document: 42 Page: 1 Filed: 01/16/2026

NOTE: This disposition is nonprecedential.

United States Court of Appeals for the Federal Circuit

GAMEVICE, INC.,
Plaintiff-Appellant

v.

NINTENDO CO., LTD., NINTENDO OF AMERICA, INC.,
Defendants-Appellees

2024-1467

Appeal from the United States District Court for the Northern District of California in No. 3:18-cv-01942-RS, Judge Richard Seeborg.

Decided: January 16, 2026

ERIK R. PUKNYS, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP, Washington, DC, argued for plaintiff-appellant. Also represented by JAMES R. BARNEY, SMITH BRITTINGHAM, IV.

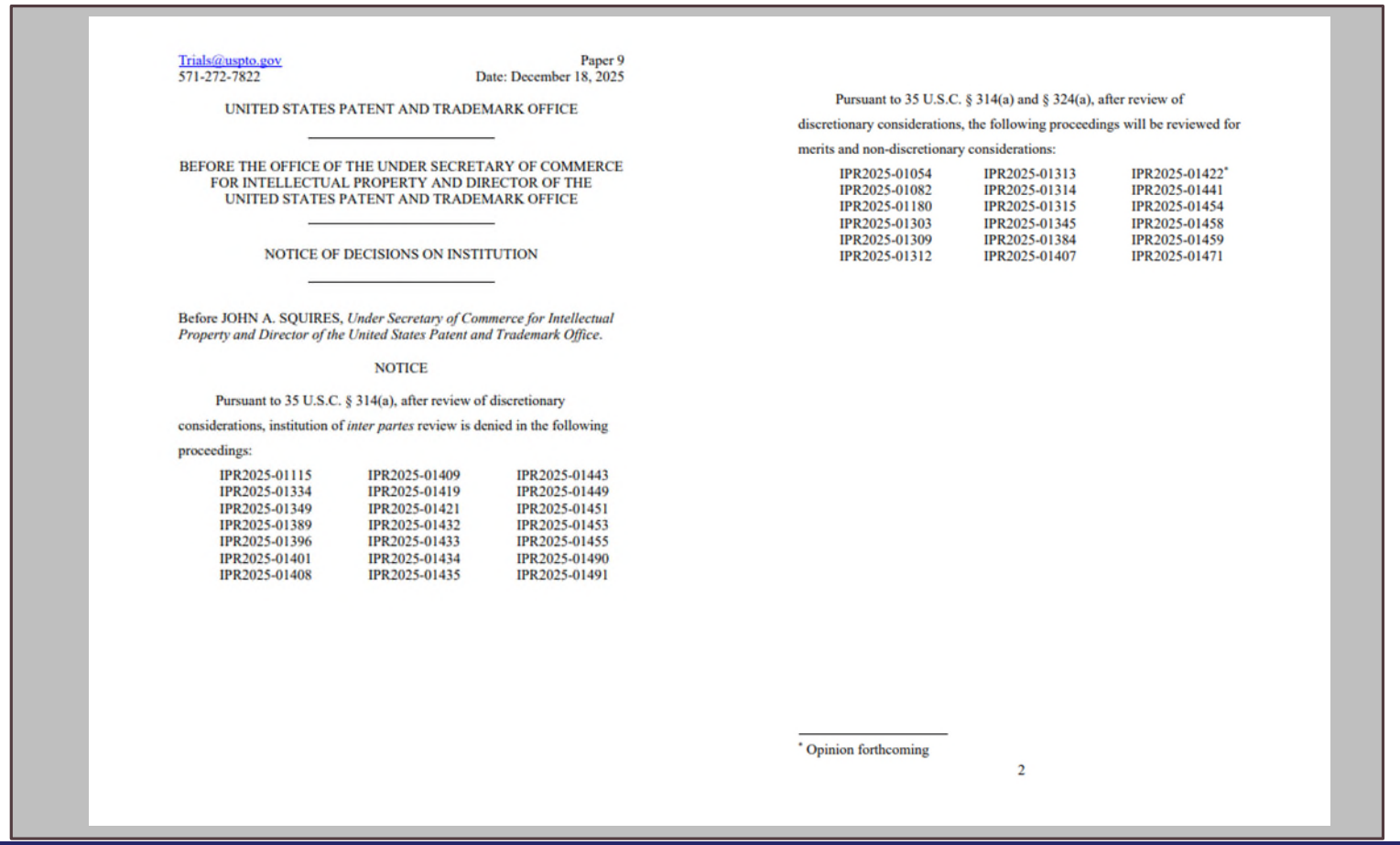
DAN L. BAGATELL, Perkins Coie LLP, Hanover, NH, argued for defendants-appellees. Also represented by GRANT EDWARD KINSEL, THERESA H. NGUYEN, Seattle, WA.

Gamevice, Inc. v. Nintendo Co., Ltd. (Nonprecedential, Jan. 16, 2026)

- Federal Circuit affirmed the Northern District of California's grant of summary judgment that the Nintendo Switch does not infringe Gamevice's patents
  - The Federal Circuit held the accused product lacks the claimed "confinement structures" and "apertures" that secure input devices as required by the claim limitations

Update on Discretionary Review Decisions Since December 17

Discretionary Review Decisions (December 18, 2025)



Trials@uspto.gov
571-272-7822

Paper 9
Date: December 18, 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:

IPR2025-01115	IPR2025-01409	IPR2025-01443
IPR2025-01334	IPR2025-01419	IPR2025-01449
IPR2025-01349	IPR2025-01421	IPR2025-01451
IPR2025-01389	IPR2025-01432	IPR2025-01453
IPR2025-01396	IPR2025-01433	IPR2025-01455
IPR2025-01401	IPR2025-01434	IPR2025-01490
IPR2025-01408	IPR2025-01435	IPR2025-01491

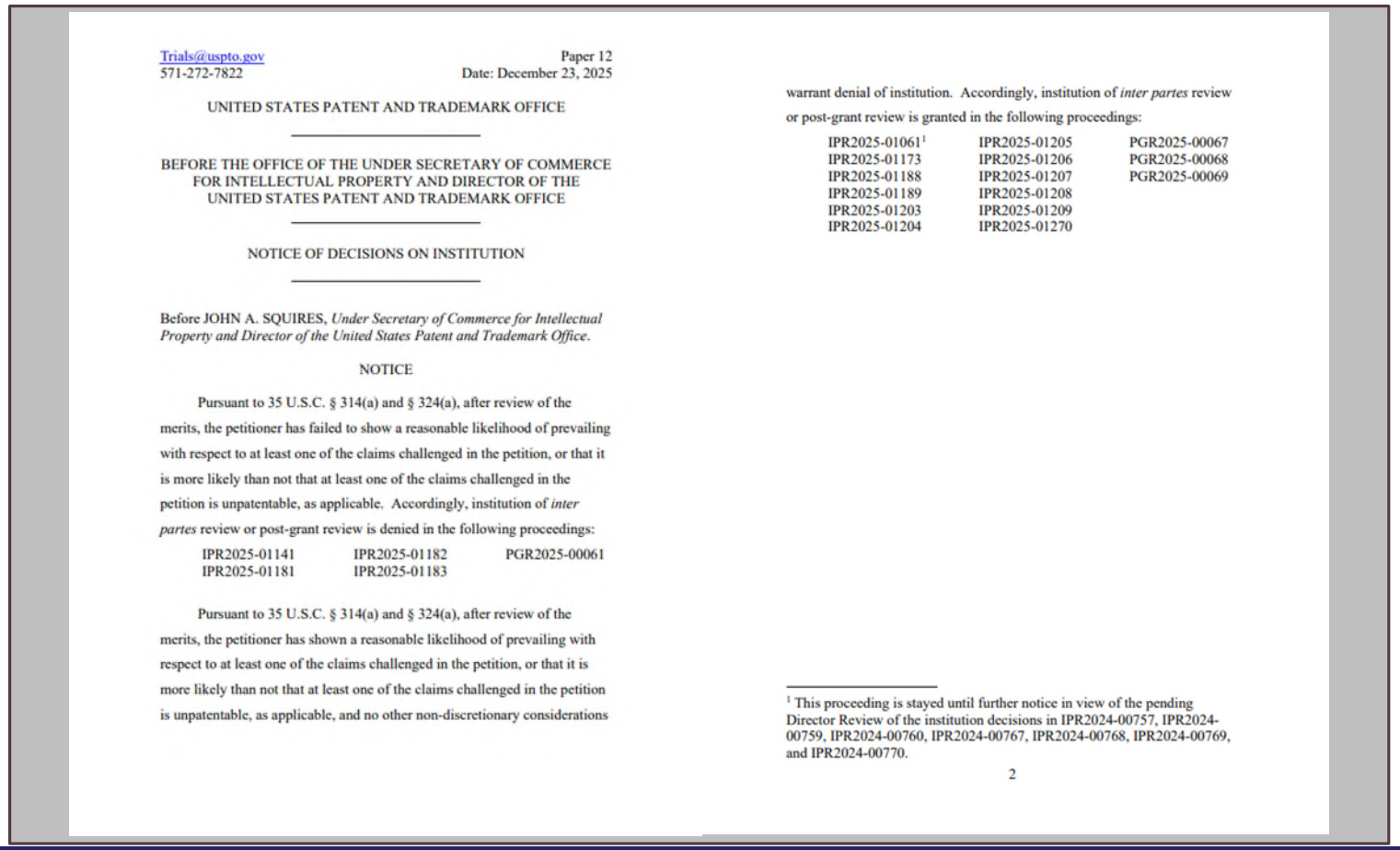
Pursuant to 35 U.S.C. § 314(a) and § 324(a), after review of discretionary considerations, the following proceedings will be reviewed for merits and non-discretionary considerations:

IPR2025-01054	IPR2025-01313	IPR2025-01422*
IPR2025-01082	IPR2025-01314	IPR2025-01441
IPR2025-01180	IPR2025-01315	IPR2025-01454
IPR2025-01303	IPR2025-01345	IPR2025-01458
IPR2025-01309	IPR2025-01384	IPR2025-01459
IPR2025-01312	IPR2025-01407	IPR2025-01471

* Opinion forthcoming

2

Discretionary Review Decisions (December 23, 2025)



Trials@uspto.gov
571-272-7822

Paper 12
Date: December 23, 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 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, or that it is more likely than not that at least one of the claims challenged in the petition is unpatentable, as applicable. Accordingly, institution of *inter partes* review or post-grant review is denied in the following proceedings:

IPR2025-01141	IPR2025-01182	PGR2025-00061
IPR2025-01181	IPR2025-01183	

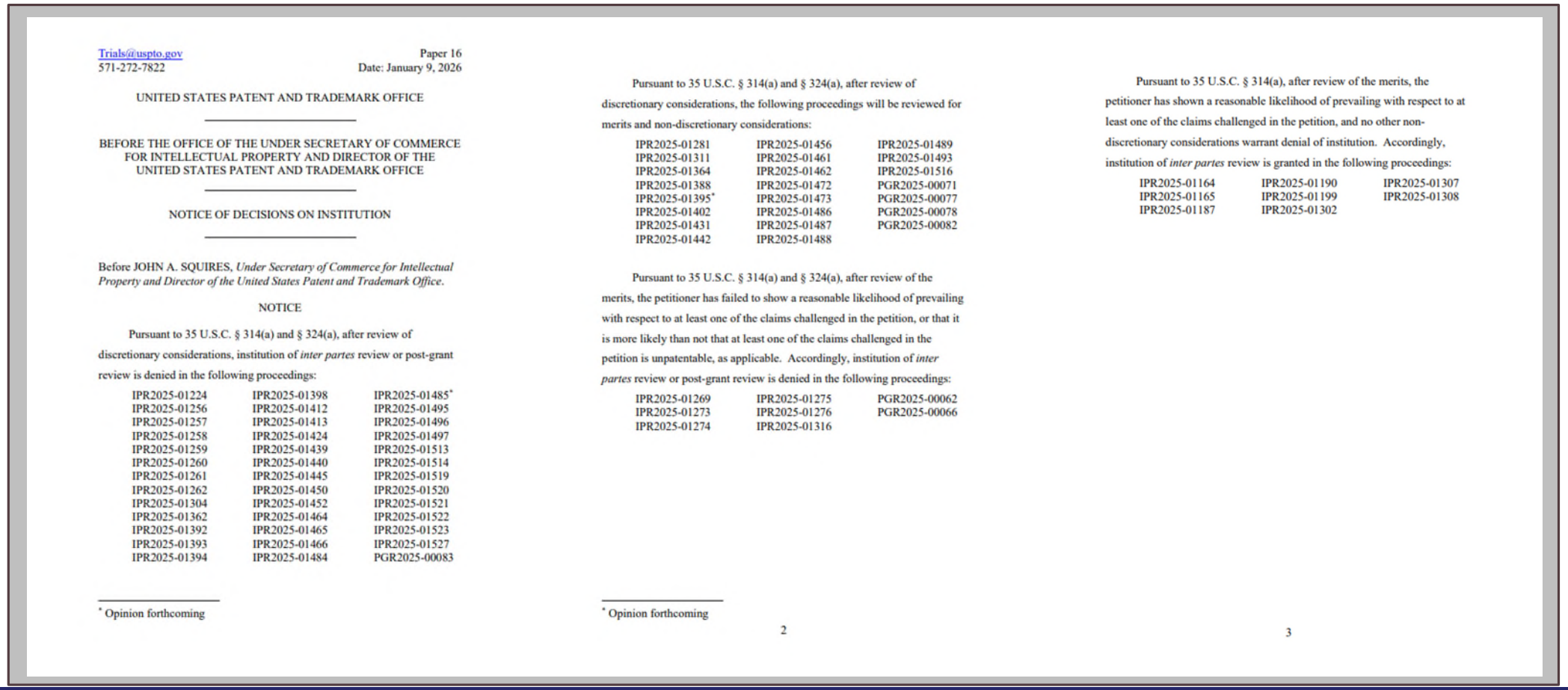
Pursuant to 35 U.S.C. § 314(a) and § 324(a), after review of the merits, the petitioner has shown a reasonable likelihood of prevailing with respect to at least one of the claims challenged in the petition, or that it is more likely than not that at least one of the claims challenged in the petition 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:

IPR2025-01061[1]	IPR2025-01205	PGR2025-00067
IPR2025-01173	IPR2025-01206	PGR2025-00068
IPR2025-01188	IPR2025-01207	PGR2025-00069
IPR2025-01189	IPR2025-01208	
IPR2025-01203	IPR2025-01209	
IPR2025-01204	IPR2025-01270	

[1] This proceeding is stayed until further notice in view of the pending Director Review of the institution decisions in IPR2024-00757, IPR2024-00759, IPR2024-00760, IPR2024-00767, IPR2024-00768, IPR2024-00769, and IPR2024-00770.

2

Discretionary Review Decisions (January 9, 2025)



Trials@uspto.gov
571-272-7822

Paper 16
Date: January 9, 2026

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:

IPR2025-01224	IPR2025-01398	IPR2025-01485*
IPR2025-01256	IPR2025-01412	IPR2025-01495
IPR2025-01257	IPR2025-01413	IPR2025-01496
IPR2025-01258	IPR2025-01424	IPR2025-01497
IPR2025-01259	IPR2025-01439	IPR2025-01513
IPR2025-01260	IPR2025-01440	IPR2025-01514
IPR2025-01261	IPR2025-01445	IPR2025-01519
IPR2025-01262	IPR2025-01450	IPR2025-01520
IPR2025-01304	IPR2025-01452	IPR2025-01521
IPR2025-01362	IPR2025-01464	IPR2025-01522
IPR2025-01392	IPR2025-01465	IPR2025-01523
IPR2025-01393	IPR2025-01466	IPR2025-01527
IPR2025-01394	IPR2025-01484	PGR2025-00083

* Opinion forthcoming

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:

IPR2025-01281	IPR2025-01456	IPR2025-01489
IPR2025-01311	IPR2025-01461	IPR2025-01493
IPR2025-01364	IPR2025-01462	IPR2025-01516
IPR2025-01388	IPR2025-01472	PGR2025-00071
IPR2025-01395*	IPR2025-01473	PGR2025-00077
IPR2025-01402	IPR2025-01486	PGR2025-00078
IPR2025-01431	IPR2025-01487	PGR2025-00082
IPR2025-01442	IPR2025-01488	

Pursuant to 35 U.S.C. § 314(a) and § 324(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, or that it is more likely than not that at least one of the claims challenged in the petition is unpatentable, as applicable. Accordingly, institution of *inter partes* review or post-grant review is denied in the following proceedings:

IPR2025-01269	IPR2025-01275	PGR2025-00062
IPR2025-01273	IPR2025-01276	PGR2025-00066
IPR2025-01274	IPR2025-01316	

* Opinion forthcoming

2

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:

IPR2025-01164	IPR2025-01190	IPR2025-01307
IPR2025-01165	IPR2025-01199	IPR2025-01308
IPR2025-01187	IPR2025-01302	

3

Summary of Discretionary Review Decisions (Since December 17)

- Denied institution on **forty-eight (48)** pending inter partes review proceedings pursuant to 35 U.S.C. § § 314(a) and 324(a).
- Denied institution on **four (4)** pending post-grant review proceedings pursuant to 35 U.S.C. § § 314(a) and 324(a).
- Denied institution on **twenty-one (21)** pending inter partes review proceeding pursuant to 35 U.S.C. § 314(a).
- Allowed **four (4)** 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 **thirty-seven (37)** 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).
- Granted institution on **twenty (20)** pending inter partes review proceedings.
- Granted institution on **three (3)** pending post-grant review proceedings.

CLE Code

Decisions in Proceedings Where Director Review Was Granted Since December 17

Decisions in Proceedings Where Director Review Was Granted (Since December 17)

- ***PacifiCorp v. Birchtech Corp.*, IPR2025-00687, IPR2025-00688, IPR2025-00717, IPR2025-0718**
  - Order Granting Director Review, Vacating the Decisions Granting Institution, and Remanding to the Board for Further Proceedings– **Paper 40** (Squires January 12, 2026)
- ***Sinclair Pharma Limited et al. v. HydraFacial LLC*, IPR2025-00145**
  - Order Initiating *Sua Sponte* Review and Staying Proceeding– **Paper 40** (Squires December 22, 2025)
- ***Zhuhai Cosmix Battery Co., LTD. v. Ningde Amperfex Technology LIMITED*, IPR2025-00524**
  - Order Granting Director Review, Affirming-in-Part and Vacating-in-Part the Decision Granting Institution of *Inter Partes* Review– **Paper 17** (Squires December 22, 2025)

Director_PTABDecision_Review@uspto.gov
571.272.7822

Paper 17
Date: December 22, 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

ZHUHAI COSMX BATTERY CO., LTD.,
Petitioner,

v.

NINGDE AMPEREX TECHNOLOGY LIMITED,
Patent Owner.

IPR2025-00524
Patent 12,015,118 B2

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

ORDER
Granting Director Review, Affirming-in-Part and Vacating-in-Part the Decision Granting Institution, and Maintaining Institution of *Inter Partes* Review

Zhuhai Cosmix Battery Co., LTD. v. Ningde Amperfex Technology LIMITED, IPR2025-00524

- Order Granting Director Review, Affirming-in-Part and Vacating-in-Part the Decision Granting Institution of *Inter Partes* Review– **Paper 17** (Squires December 22, 2025)

The Board is reminded that **inter partes review is "a party-directed, adversarial process," not an "agency-led, inquisitorial process for reconsidering patents."** SAS Inst., Inc. v. Iancu, 584 U.S. 357, 364 (2018). In determining whether to institute review, as here, **it is inappropriate for the Board to introduce its own evidence into the record**. The Board's proper role and function is to focus on "the information presented in the petition filed under section 311 and any response filed under section 313." 35 U.S.C. § 314(a). That said, **panels are entitled to, on occasion, take judicial notice of adjudicative facts that are "not subject to reasonable dispute**." Fed. R. Evid. 201. But particle size distributions and conversions, as have been plucked from the Hutin reference's definitions, are not such facts. Further, although Petitioner argues that Hutin merely "corroborate[d]" the Board's evaluation, the Board's credibility determination is based on Hutin. Decision 32 ("In view of the record as presently developed and understood with Hutin's definitions, we find Petitioner's Declarant more credible than Patent Owner's Declarant with respect to Ishigaki.") (emphasis added). Thus, the **Board erred in introducing its own evidence with respect to the Ishigaki-based grounds following its own extra-record factfinding, and that unforced error is not harmless with respect to those grounds**. As a result, the portion of the Decision addressing the Ishigaki-based grounds is herewith vacated. Patent Owner's other arguments for vacating or reversing the Decision, however, are not persuasive and the remainder of the Board's Decision is affirmed. Because the affirmed portion of the Decision found that Petitioner showed a reasonable likelihood of success in prevailing on at least one challenged claim for those other grounds, the Board's decision to institute this inter partes review is affirmed.

Accordingly, it is:

ORDERED that Director Review is granted;

FURTHER ORDERED that the Board's Decision granting institution of inter partes review is affirmed-in-part and vacated-in-part; and

FURTHER ORDERED that the Board's decision to institute trial is affirmed.

Director_PTABDecision_Review@uspto.gov
571.272.7822

Paper 40
Date: December 22, 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

SINCLAIR PHARMA LIMITED, SINCLAIR PHARMA US, INC., VIORA, INC., EMA AESTHETICS LTD., AESTHETIC MANAGEMENT PARTNERS, LLC, and AESTHETIC MANAGEMENT PARTNERS, INC.
Petitioner,

v.

HYDRAFACIAL LLC,
Patent Owner.

IPR2025-00145
Patent 11,865,287 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 and Staying Proceeding

Sinclair Pharma Limited et al. v. HydraFacial LLC, IPR2025-00145

- Order Initiating *Sua Sponte* Review and Staying Proceeding– **Paper 40** (Squires December 22, 2025)

On September 16, 2025, a **memorandum was issued to the Board explaining that the Board will consider prior findings of fact and conclusions of law when patent claims being challenged before the Board have already been adjudicated at the Office or in another forum, such as the ITC**. See Memorandum, "PTAB Consideration of Prior Findings of Fact and Conclusions of Law" (Sept. 16, 2025).1 Subsequently, Patent Owner requested to file a public Initial Determination ("ID") from the ITC proceeding, and the Board granted that request. See Papers 26, 32.2 In the ID, the ITC determined that the asserted claims—all of which are challenged in this IPR—were not invalid over the same prior art references and combinations that Petitioner asserts in this IPR. See Ex. 2161, 99–184. The ITC also found that Patent Owner established that products practicing the claims of the challenged patent are a commercial success. Id. at 174–84. I have reviewed the ID and determine that **sua sponte Director Review is appropriate to determine whether this IPR should be de-instituted and terminated in view of the findings in the ID that Patent Owner has established commercial success and that the claims are not invalid**. See 35 U.S.C. § 314(a); 37 C.F.R. § 42.72; Sling TV, L.L.C. v. Realtime Adaptive Streaming LLC, 840 F. App'x 598 (Fed. Cir. 2021); BioDelivery Scis. Int'l, Inc. v. Aquestive Therapeutics, Inc., 935 F.3d 1362 (Fed. Cir. 2019). This IPR will be stayed until further notice, and 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 12) is initiated;

FURTHER ORDERED that this IPR is stayed until further notice; and

FURTHER ORDERED that an opinion will issue in due course.

Director_PTABDecision_Review@uspto.gov
571.272.7822

Paper 40
Date: January 12, 2026

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

PACIFICORP and
MIDAMERICAN ENERGY COMPANY,
Petitioner,

v.

BIRCHTECH CORP.,
Patent Owner.

IPR2025-00687 (Patent 10,933,370 B2)
IPR2025-00688 (Patent 10,933,370 B2)
IPR2025-00717 (Patent 10,926,218 B2)
IPR2025-00718 (Patent 10,926,218 B2)[1]

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

ORDER
Granting Director Review, Vacating the Decisions Granting Institution, and Remanding to the Board for Further Proceedings

[1] This order applies to each of the above-listed proceedings.

PacifiCorp v. Birchtech Corp., IPR2025-00687, IPR2025-00688, IPR2025-00717, IPR2025-0718

- Order Granting Director Review, Vacating the Decisions Granting Institution, and Remanding to the Board for Further Proceedings– **Paper 40** (Squires, January 12, 2026)

The Board abused its discretion in granting institution of two petitions that each challenge the same claims of the '370 patent and '218 patent. See Decisions 3. The Board's Trial Practice Guide explains that **"one petition should be sufficient to challenge the claims of a patent in most situations" and "multiple petitions by a petitioner are not necessary in the vast majority of cases."** See Patent Trial and Appeal Board Trial Practice Guide ("TPG") § II.D.2 (Dec. 12, 2025). 4 The TPG further explains that **multiple petitions may be necessary in "rare" cases,** such as a "priority dispute requiring arguments under multiple prior art references." TPG § II.D.2. . .
Given that Petitioners had ample room in each petition to present multiple grounds challenging the claims of each patent, this was not a "rare" circumstance that justified the filing of multiple petitions against each patent.
In any event, absent exceptional circumstances, in a case where there is a dispute over priority date, the Board should either resolve the priority date issue or institute, at most, the first-ranked petition. Instituting more than one petition to challenge the same claims under two different priority dates effectively expands the permitted word count, places "a substantial and unnecessary burden on the Board and the patent owner[,] and could raise fairness, timing, and efficiency concerns." See TPG § II.D.2 (citing 35 U.S.C. § 316(b)).
Here, the Board should have decided the priority date issue or instituted only the first-ranked petition challenging each of the '370 and '218 patents. Cf. CrowdStrike, Inc. v. GoSecure, Inc., IPR2025-00068, Paper 25 at 3–4 (Director June 25, 2025) (informative) (explaining that the Board should institute review of, at most, one petition challenging a patent). As the parties have already briefed the priority date issue, and the Board has made preliminary findings on priority, see Paper 29, 25–26; IPR2025-00718, Paper 34 at 23, the proper course is to remand for the Board to determine which petition challenging each patent to institute. Accordingly, Director Review is granted, and the cases are remanded to the Board panel to determine which of the two petitions challenging each of the '370 and '218 patents to institute. Absent good cause, the Board panel shall issue its decisions on remand within 30 days.

Having considered the requests and responses, it is:

ORDERED that the requests for Director Review are granted;

FURTHER ORDERED that the Board's Decisions granting institution of inter partes review (Paper 29; IPR2025-00688, Paper 29; IPR2025- 00717, Paper 35; IPR2025-00718, Paper 34) are vacated; and

FURTHER ORDERED that the cases are remanded to the Board for further proceedings consistent with this decision.

General USPTO Updates

USPTO Designates Decisions as Precedential

- The USPTO designated as precedential *PacifiCorp v. Birchtech Corp.*, IPR2025-00687
  - The Director vacated and remanded the Board's decisions instituting multiple parallel IPR petitions that challenged the same patent claims based on different asserted priority dates
  - The decision emphasizes that parallel petitions should be instituted only in rare circumstances, and the mere presence of alternative priority-date theories does not justify parallel proceedings (especially where each petition already presents multiple grounds challenging the same claims)
  - The decision further clarifies that when a priority dispute is central to institution, the Board should address and resolve the priority issue at the institution stage or, at most, institute only the first-ranked petition rather than allowing parallel petitions to proceed.

- The USPTO designated as precedential *Elong Int'l USA Inc. v. Feit Electric Co., Inc.*, IPR2025-00258
  - Director Stewart exercised her discretion to deny institution of the IPR
  - Emphasized that the petition was largely duplicative of an ongoing IPR and considered both the standalone and joinder scenarios, concluding that proceeding would waste agency resources and potentially create unfairness

- The USPTO designated as precedential *Realtek Semiconductor Corp. v. ParkerVision, Inc.*, IPR2025-00324
  - Director Coke Morgan Stewart exercised her discretionary authority to deny institution of Realtek's IPR petition, which was filed after the statutory one-year time-bar under 35 U.S.C. § 315(b)
  - Petitions filed by time-barred parties should proceed only in exceptional circumstances, and concluded that Realtek had not shown any such exceptional circumstances warranting institution

https://www.uspto.gov/patents/ptab/precedential-informative-decisions

USPTO Designates Decisions as Precedential

- The USPTO designated as precedential *LifeVac LLC v. DCSTAR Inc.*, IPR2025-00454
  - Director Coke Morgan Stewart declined to exercise her discretion to deny institution of LifeVac's IPR petition, even though LifeVac had previously filed a post-grant review (PGR) on the same patent that was denied institution
  - An earlier PGR that did not result in an instituted trial or final written decision generally does not justify discretionary denial of a later IPR, especially where the IPR raises different arguments and prior art
  - Referred the petition to the Board for a normal institution decision on the merits

- The USPTO designated as precedential *Multi-Color Corp. v. Brook & Whittle Ltd.*, PGR2025-00025
  - Director Coke Morgan Stewart declined to exercise her discretion to deny institution of the post-grant review (PGR) petition, explaining that PGRs are generally *favored* because they are filed early in a patent's life and before expectations in patent rights are strongly settled
  - The arguments and evidence presented by Multi-Color provided persuasive reasoning against discretionary denial, and that the factors weighing against denial outweighed those in favor of it
  - Petition was referred to the PTAB for consideration on the merits

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USPTO Designates Decisions as Informative

- The USPTO designated as informative *Top Glory Trading Group Inc. v. Cole Haan LLC,* IPR2025-01395
  - The Director denied the patent owner's request for discretionary denial based on a change in design patent law following the Federal Circuit's decision in *LKQ Corp. v. GM Global Technology Operations LLC*
  - The decision explains that a change in governing law, standing alone, does not justify discretionary denial of institution, even where the patent owner argues that its settled expectations are disrupted
- The USPTO designated as informative *Yangtze Memory Technologies Company, Ltd. v. Micron Technology, Inc.*, IPR2025-00098
  - USPTO Director intervened after institution and ultimately vacated and denied the petition based on YMTC's failure to properly identify all real parties in interest, without reaching broader national-security or Entity List issues
- The USPTO designated as informative *Savant Techs. LLC d/b/a GE Lighting v. Feit Electric Co., Inc.*, IPR2025-00260
  - Director Coke Morgan Stewart denied the patent owner's request for discretionary denial and referred the IPR petition to the Board for normal institution and merits consideration
  - The facts did not show an abuse of the review process through repeated attacks, because the second petition was necessitated by Feit's assertion of additional claims in district court after the first petition was filed
  - A stay of the related district court litigation further supported proceeding with the IPR rather than denying it on discretionary grounds

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USPTO Designates Decisions as Informative

- The USPTO designated as informative *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217
  - Director Coke Morgan Stewart denied the patent owner's request for discretionary denial and referred Tesla's IPR petitions to the Board for merits consideration instead of stopping them at the discretionary stage
  - The complex and diverse parallel district court litigation, involving many patents across multiple families and subject matters, *weighed against* discretionary denial because the PTAB is better suited to review such a broad set of patents
  - The IPR petitions proceeded toward institution and merits review rather than being denied based on discretionary considerations
- The USPTO designated as informative *Damico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408
  - Acting Director Coke Morgan Stewart granted the patent owner's request for discretionary denial and declined to institute the IPR, finding that the discretionary considerations in favor of denial outweighed those against it
  - The challenged patent had been in force for nearly eight years, creating *settled expectations* that made using Office resources for review inappropriate absent persuasive reasons to disturb those expectations
  - Actual prior notice of the patent by the petitioner was not necessary for settled expectations to arise, and that the petitioner failed to demonstrate why an IPR would be an appropriate use of USPTO resources

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USPTO Designates Decisions as Informative

- The USPTO designated as informative *Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, -00465, -00466
  - Director Coke Morgan Stewart declined to exercise her discretion to deny institution and instead referred all three IPR petitions to the Board for merits consideration
  - Although a scheduled district court trial might delay a Final Written Decision, the petitions raised an apparent material error by the Office during examination regarding entitlement to a provisional priority date that conflicted with earlier Board decisions, making review an appropriate use of USPTO resources
  - Because two of the challenged patents had only recently issued and the third was in the same family, the patents' relatively short time in force meant settled expectations did not strongly favor discretionary denial
- The USPTO designated as informative *Amgen Inc. v. Bristol-Myers Squibb* Co., IPR2025-00601, -00602, -00603
  - Director Coke Morgan Stewart granted the patent owner's requests for discretionary denial and denied institution of IPR2025-00601 and IPR2025-00602, finding that the challenged patents had been in force for six and seven years and thus created strong "settled expectations" that weighed against using USPTO resources for review
  - Director Stewart did not deny discretionary institution of IPR2025-00603 and instead referred that petition to the Board because the challenged patent had only been in force for about three years and the patent owner had not sufficiently shown strong settled expectations for i

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USPTO Designates Decisions as Informative

- The USPTO designated as informative *Home Depot U.S.A., Inc. v. H2 Intellect LLC*, IPR2025-00480
  - Director Coke Morgan Stewart declined to exercise her discretion to deny institution of Home Depot's IPR petition, meaning she referred it to the PTAB for a merits decision rather than stopping it at the discretionary stage
  - Although she acknowledged factors favoring discretionary denial—such as the challenged patent's age, a likely overlap with a district court trial, and strong "settled expectations" from being in force for over 12 years—she found that Home Depot's arguments about the patent's lack of commercialization or assertion in its technology space weighed against denial
  - Held that discretionary denial was not appropriate and allowed the petition to proceed to the Board
- The USPTO designated as informative *Apple Inc. v. Ferid Allani*, IPR2025-00856
  - The Director declined to exercise discretionary denial and referred Apple's IPR petitions to the Board for merits consideration rather than stopping them at the discretion stage
  - Although some factors (like the long-in-force status of one patent and parallel proceedings) favored denial, Stewart found that Apple's *reasonable expectation of non-enforcement*—because it believed it didn't need a license and the patent owner hadn't asserted the patent against Apple for over a decade, and only asserted it after expiration—counseled against denial
  - Under these *settled expectations* circumstances, discretionary denial was not appropriate and the petitions were referred for institution analysis

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USPTO Designates Decisions as Informative

- The USPTO designated as informative *Sun Pharm. Indus., Inc. v. Nivagen Pharm., Inc.*, IPR2025-00893
  - Director Coke Morgan Stewart granted the patent owner's request for discretionary denial and denied institution of the IPR petition, concluding that discretionary considerations favored denial overall
  - The petitioner had taken inconsistent claim construction positions in the PTAB proceeding and the parallel district court litigation and failed to sufficiently justify the broader constructions in its petition
  - Although some factors weighed against discretionary denial, the Director found that the balance of considerations supported denying institution
- The USPTO designated as informative *Alliance Laundry Sys., LLC v. PayRange LLC*, IPR2025-00950
  - Director Coke Morgan Stewart exercised her discretion to deny institution of the IPR petition, agreeing with the patent owner that discretionary denial was appropriate
  - This was the third petition challenging the same patent and that prior petitions had already been denied on the merits, raising road-mapping concerns about repetitive challenges using the same primary reference
  - Evidence of licensing the challenged patent supported some level of "settled expectations" favoring the patent owner, tipping the balance toward discretionary denial

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USPTO Proposes to Amend the Rules of Practice

- The USPTO proposes to amend the Rules of Practice in patent cases to require patent applicants and patent owners whose domicile is outside the United States or its territories to be represented by a registered patent practitioner

https://www.govinfo.gov/content/pkg/FR-2025-12-29/pdf/2025-23917.pdf

Next Month (February PTAB Committee)

On Tuesday, February 17, 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.