

Insights

PATENT OFFICE PROPOSES RULES RESTRICTING THE AVAILABILITY OF REVIEW OF GRANTED PATENTS

Oct 17, 2025

On Friday, October 17, 2025, the United States Patent and Trademark Office (USPTO) published proposed rule changes^[1] that would serve to limit the availability of patentability reviews of granted U.S. patents using the *Inter Partes* Review procedure created by the America Invents Act. The Notice of Proposed Rulemaking sets a deadline of **November 17, 2025** for the submission of comments on the proposed rules.

The proposed rule changes limit the circumstances under which the USPTO would agree to institute *inter partes* review. These changes include:

- Requiring petitioners to stipulate that, if trial is instituted, ***the petitioner will not raise any grounds*** of invalidity or unpatentability with respect to the challenged patent under 35 USC 102 or 103 ***in any other proceeding***;
- Refusing to institute or maintain an *inter partes* review if a challenged claim^[2] (or any claim from which the challenge claim depends) ***has been found not invalid***^[3] under 35 USC 102 or 103 ***in prior proceedings***, namely by district court trial, district court summary judgment, an ITC initial or final determination, a final written decision issued by the Patent Trial Appeal Board (PTAB), an *ex parte* reexamination decision, or by a Federal Circuit reversal of a finding of invalidity or unpatentability ; and
- Refusing to institute or maintain an *inter partes* review if it is more likely than not that any challenged claim will be, before the due date of a final written decision, the ***subject of parallel proceedings***, namely a district court trial, an ITC initial or final determination, or issuance of a final written decision by the PTAB involving the same challenged claim.

The proposed rule change would also introduce the possibility of institution if a panel of the PTAB determines that extraordinary circumstances warrant institution, and refers the matter to the Director who then may personally institute *inter partes* review, notwithstanding the requirements of these new provisions.

The proposed rule changes are a first since Director Squires assumed responsibility as head of the USPTO. The memo points to "broad discretion" conferred by Congress to the USPTO in determining when to institute review in such proceedings when it passed the AIA as authority for the proposed changes. The proposed rule changes lodge a number of criticisms of the current post grant review system, alleging a weakening of patent rights and related economic harm resulting from abuses of the current system.

The proposed rule changes do not seek to change the current rules governing institution of post grant review (PGR) proceedings, raising a number of interesting strategic questions and considerations that may influence overall patent litigation and freedom to operate strategies if the proposed rule changes are implemented.

Please contact our experienced post-grant team to discuss any specific questions or impacts you believe may be relevant to your current or future patent litigation strategies, or of your organization is interested in submitting comments on the proposed rule changes.

-

[1] 90 Fed. Reg. 48335 (Oct. 17, 2025) (<https://federalregister.gov/d/2025-19580>).

[2] Challenged claim includes any claim from which a challenged claim depends.

[3] The proposed rule includes a caveat that none of these decisions have been vacated or reversed in relevant part.

RELATED CAPABILITIES

- Patents: Counseling, Prosecution & Practical Business Services
- Patents: Litigation
- Intellectual Property & Technology Disputes

MEET THE TEAM



Scott W. Cummings

Washington

scott.cummings@bclplaw.com

+1 202 508 6018

This material is not comprehensive, is for informational purposes only, and is not legal advice. Your use or receipt of this material does not create an attorney-client relationship between us. If you require legal advice, you should consult an attorney regarding your particular circumstances. The choice of a lawyer is an important decision and should not be based solely upon advertisements. This material may be “Attorney Advertising” under the ethics and professional rules of certain jurisdictions. For advertising purposes, St. Louis, Missouri, is designated BCLP’s principal office and Kathrine Dixon (kathrine.dixon@bclplaw.com) as the responsible attorney.