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IP MATTERS: UNITED STATES PATENT OFFICE MAKES CHANGES TO PATENT TRIAL APPEAL BOARD (PTAB) PETITIONS

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The United States Patent and Trademark Office (USPTO) has instituted significant changes to the rules and procedures governing inter partes review (IPR) and post-grant review (PGR) proceedings before the Patent Trial and Appeal Board (PTAB). These changes affect both the substantive requirements for IPR petitions and the procedural deadlines and briefing opportunities for parties, particularly with respect to discretionary denial and the use of general knowledge or applicant-admitted prior art. Applicants and petitioners must carefully adhere to these new requirements to ensure compliance and to avoid summary denial of their petitions or forfeiture of arguments.

As of March 26, 2025, the USPTO has implemented an interim process for managing the PTAB's workload by bifurcating the decision on whether to institute an IPR or PGR into two distinct phases: (i) discretionary considerations and (ii) merits and other non-discretionary statutory considerations. The Director, in consultation with at least three PTAB judges, will first determine whether discretionary denial of institution is appropriate. If discretionary denial is not appropriate, the Director will issue a decision to that effect and refer the petition to a three-member PTAB panel, which will then address the merits and other statutory considerations in the normal course. In seeking discretionary denial of a PTAB petition, parties may address all relevant discretionary considerations, including but not limited to, prior adjudication of validity or patentability, changes in law or precedent, strength of the unpatentability challenge, reliance on expert testimony, settled expectations of the parties, compelling economic or public interests, and any other factors bearing on the Director's discretion. To comply with this process, parties have two months from the date on which the PTAB enters a Notice of Filing Date Accorded to a petition. This filing deadline is non-extendable.

The second memo issued by the USPTO, dated July 31, 2025, announced that, effective for IPR petitions filed on or after September 1, 2025, the USPTO will strictly enforce 37 C.F.R. § 42.104(b)(4). This rule requires that a petition for inter partes review "must specify where each element of the claim is found in the prior art patents or printed publications relied upon." The USPTO will no longer waive this requirement, reversing prior guidance that allowed for some flexibility in the use of general knowledge, expert testimony, or applicant admitted prior art (AAPA) to supply missing claim limitations. Instead, the petition must identify, with particularity, where each claim element is found in the cited patents or printed publications. If a petition fails to do so, the Board is required to deny the petition under 35 U.S.C. § 312(a)(4). To this end, petitioners must ensure that every element of each challenged claim is expressly mapped to a specific location in a cited patent or printed publication within the petition. The use of general knowledge or AAPA should only be used to support arguments regarding motivation to combine or the understanding of a person of ordinary skill, and not as a substitute for prior art disclosure of claim elements.

Berger Singerman's attorneys are well-versed in the evolving rules governing PTAB proceedings, including the new requirements for IPR and PGR petitions. Please reach out to Geoffrey Lottenberg, David Colls or any other member of our Intellectual Property group for guidance on IPR proceedings, intellectual property

litigation, or to discuss how else we can help you protect your intellectual property business interests.

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