



December 2, 2025

**Comment of Innovation Alliance in Response to USPTO Notice of Proposed Rulemaking  
on Revision to Rules of Practice Before the Patent Trial and Appeal Board**

Docket No. PTO-P-2025-0025

The Innovation Alliance appreciates the opportunity to submit these comments in response to the notice of proposed rulemaking issued by the United States Patent and Trademark Office (“USPTO”) regarding Revision to the Rules of Practice Before the Patent Trial and Appeal Board (“Proposed Rule” or “NPRM”).<sup>1</sup> The Innovation Alliance strongly supports the Proposed Rule and urges the USPTO to finalize it with just a few small changes, which we detail below.

The Innovation Alliance is a coalition of research and development (R&D)-based technology companies representing innovators, patent owners, and stakeholders from a diverse range of industries that believes in the critical importance of maintaining a strong patent system that supports innovative enterprises of all sizes. The Innovation Alliance is committed to strengthening the patent systems around the world to promote innovation, economic growth, and job creation here at home, and we support legislation, rules, and policies that help to achieve those goals.<sup>2</sup>

The Innovation Alliance applauds the USPTO, under the leadership of Commerce Secretary Howard Lutnick, USPTO Director John Squires, and USPTO Deputy Director Coke Morgan Stewart, for its unwavering commitment to advancing rules and guidance that strengthen the U.S. patent system, ensuring that the United States can continue to lead the world in the innovation of critical and emerging technologies. The USPTO is providing much-needed clarity as to what inventions are patentable, and long-overdue updates to the rules governing challenges to patents before the Patent Trial and Appeal Board (“PTAB”) that will restore Congressional intent and ensure innovators have a fair opportunity to defend their patents. These actions clearly demonstrate that the USPTO is delivering on Director Squires’s promise to make sure “the door to the patent office is wide open to transformative technologies.” As Director Squires has said, the “USPTO is the running engine of American ingenuity.”

A strong patent system, grounded in predictable rules, is essential to incentivizing investment in the cutting-edge R&D that drives U.S. global leadership in foundational technologies essential to our national security and economic competitiveness. President Trump has directed the Administration to pursue policies that “enhance[] our Nation’s industrial and technological advantages [and] defend[] our

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<sup>1</sup> U.S. Patent & Trademark Off., *Revision to Rules of Practice Before the Patent Trial & Appeal Bd.*, 90 Fed. Reg. 48335 (Oct. 17, 2025).

<sup>2</sup> <http://innovationalliance.net>.

economic and national security.”<sup>3</sup> The U.S. patent system plays a major role in fulfilling this mandate, encouraging advanced industries, including manufacturing, to grow and develop in the United States, reducing our dependency on foreign countries, and strengthening our economic security.<sup>4</sup> Leadership by U.S. companies over generations of technological R&D and standards-setting has also enabled the United States to anticipate potential security risks more effectively and proactively take the necessary steps to protect U.S. national security interests.

By returning predictability, balance, and consistency into the PTAB process, the Proposed Rule promotes a strong, reliable patent system central to ensuring that the benefits of innovation are captured by U.S. innovators, and that innovative small and medium businesses can contribute to the innovation and manufacturing base that underpins U.S. economic and national security.<sup>5</sup>

The changes proposed in the NPRM will substantially improve the PTAB’s practices for reviewing challenges to patents by better protecting inventors and patent holders from abusive and duplicative attacks on the validity of their patents. We strongly support the spirit of the NPRM and urge the USPTO to finalize most of the Proposed Rule as drafted, with certain suggested changes to the Proposed Rule for clarity as noted below.

#### **Innovation Alliance Comments on the Proposed Rule**

***Required Stipulation for Efficiency.*** The Proposed Rule would amend 37 C.F.R. § 42.108(d) to prohibit the PTAB from instituting or maintaining an *inter partes* review

unless each petitioner files a stipulation with the Board and any other tribunal where it is litigating or later litigates regarding the challenged patent, stating that if a trial is instituted, the petitioner and any real party in interest or privy of the petitioner will not raise grounds of invalidity or unpatentability with respect to the challenged patent under 35 U.S.C. 102 or 103 in any other proceeding.<sup>6</sup>

This language would further Congressional intent that IPRs serve as an alternative to litigation. The Proposed Rule would promote efficiency by encouraging petitioners to bring all available prior art challenges in a single PTAB proceeding and ensure patent owners not have to endure multiple challenges to their patent by the same or related entities before the PTAB or other tribunals. By requiring petitioners to file the stipulation with both the Board and all tribunals where the petitioner is challenging or later will challenge the patent, this rule will provide inventors with certainty that they will not face the same or similar challenges in multiple fora.

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<sup>3</sup> Donald J. Trump, *America First Trade Policy*, Jan. 20, 2025, <https://www.whitehouse.gov/presidential-actions/2025/01/america-first-trade-policy/>.

<sup>4</sup> Kirti Gupta, Andrei Iancu, Walter G. Copan, and Chris Borges, *Protecting Intellectual Property for National Security*, Center for Strategic and International Studies (March 2025), [https://csis-website-prod.s3.amazonaws.com/s3fs-public/2025-03/250325\\_Gupta\\_Intellectual\\_Property.pdf](https://csis-website-prod.s3.amazonaws.com/s3fs-public/2025-03/250325_Gupta_Intellectual_Property.pdf)

<sup>5</sup> 90 Fed. Reg. at 47337.

<sup>6</sup> 90 Fed. Reg. at 48341.

The Innovation Alliance strongly supports protecting inventors and patent holders from repetitive challenges to their patents. In finalizing the Proposed Rule, however, we recommend the USPTO clarify that the stipulation required by section 42.108(d) need only be filed in proceedings that exist *at the time of the stipulation*. The stipulation could specify that the obligation to file in “any other proceeding” includes future proceedings, but that it cannot be filed in those proceedings unless and until those proceedings are initiated.

**Claims Found Valid in Prior Proceedings.** The Proposed Rule would prohibit the PTAB from instituting or maintaining an *inter partes* review against a patent if “a challenged claim or an independent claim from which a challenged claim depends” has been upheld in previous proceedings, including following a trial or on summary judgment in district court (if the verdict or ruling has not been vacated or reversed), in an initial or final determination at the U.S. International Trade Commission (“ITC”), by the PTAB in a final written decision or *ex parte* reexamination, or, if the claim was initially found invalid, if the Federal Circuit has reversed the decision.<sup>7</sup>

This Proposed Rule would restore Congressional intent that patent owners enjoy “quiet title” in their patent rights. The Innovation Alliance strongly supports prohibiting serial proceedings at PTAB after a court, the ITC, or the PTAB have already determined that a patent is valid. These types of proceedings require a substantial expenditure of time, resources, and expense to vet a patent’s validity, and subjecting patent owners to further validity challenges would not only waste the resources that have already been spent but compound the burden and cost with each subsequent proceeding. When the public cannot rely upon a judgment that a patent is valid, it creates uncertainty and unpredictability in the patent system, incentivizing implementers to continue challenging validity notwithstanding prior results, risking inconsistent rulings, and discouraging investments in patented technologies. The Proposed Rule would fix these problems by ensuring that patent claims are subject to only “one bite at the apple” at the PTAB.

**Parallel Litigation.** The Proposed Rule would prohibit the PTAB from instituting or maintaining an *inter partes* review if it is more likely than not that, “with respect to a challenged claim or an independent claim from which a challenged claim depends,” a parallel proceeding in district court, the ITC, or a different PTAB case is likely to conclude before the final written decision in the PTAB case.<sup>8</sup> This approach would protect patent holders against the risk of having to defend their patents in multiple proceeding simultaneously and reduce the risk of inconsistent validity determinations, under different standards of proof, across different fora.

This proposal would ensure that an *inter partes* review may only proceed if it would conclude faster than proceedings before other tribunals. This proposal would help restore the PTAB to the intent of the America Invents Act, as a faster and cheaper alternative to district court or ITC litigation, rather than an additional, duplicative venue patent owners must clear to defend their patent’s validity.

The Innovation Alliance strongly supports this proposal but encourages the USPTO to ensure the Final Rule gives the Board discretion to deny institution in or terminate all cases where necessary to eliminate the risk of disparate validity decisions across venues, even if it initially appeared as though the PTAB would conclude its proceeding first.

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<sup>7</sup> *Id.* (proposed amendment to 37 C.F.R. § 42.108(e)).

<sup>8</sup> *Id.* (proposed amendment to 37 C.F.R. § 42.108(f)).

***Institution in Extraordinary Circumstances.*** This provision would allow the PTAB, in “extraordinary circumstances,” to refer a petition to the USPTO Director, even if the Proposed Rule would otherwise prohibit institution. The NPRM explains that such circumstances may include prior challenges initiated in bad faith or a significant change in statute or controlling Supreme Court precedent but does not include “new or additional prior art, new expert testimony, new caselaw (except [Supreme Court precedent]) or new legal argument, or a prior challenger’s failure to appeal.”<sup>9</sup> Upon referral, the Director has discretion to “personally institute” the proceeding.

This language ensures fairness in the revised rules of practice. The Innovation Alliance supports this provision as an appropriate reservation of the Director’s statutory discretion to institute *inter partes* reviews<sup>10</sup> and an important check to ensure that potentially meritorious petitions can proceed when warranted.

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The Innovation Alliance supports the Proposed Rule and appreciates the USPTO’s leadership in ensuring that Patent Trial and Appeal Board procedures reflect the true intent of the America Invents Act. Appropriate use of PTAB proceedings is critical to ensuring strong patent protections continue to incentivize U.S. innovators to invest in the research, development, and commercialization necessary for continued U.S. global leadership in innovation and technology, and the protection of U.S. economic and national security.

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<sup>9</sup> *Id.* (proposed amendment to 37 C.F.R. § 42.108(g)).

<sup>10</sup> 35 U.S.C. § 314.