IN THE MATTER OF Revision to Rules of Practice Before the Patent Trial and Appeal Board

Docket No. PTO-P-2025-0025

COMMENTS OF THE ELECTRONIC FRONTIER FOUNDATION

The Electronic Frontier Foundation ("EFF") submits this comment in response to the United States Patent and Trademark Office's ("USPTO") Notice of Proposed Rulemaking, Docket No. PTO-P-2025-0025, published on October 17, 2025 ("NPRM").[1]

EFF is a nonprofit civil liberties organization that has worked for 35 years to protect consumer interests, innovation, and access to knowledge in the digital world. EFF and its more than 30,000 active members care deeply about ensuring that patent law in this country serves the constitutional goal of promoting the progress of science and technological innovation by granting limited exclusive rights.

To ensure the voices of consumers, end users, and developers are heard, EFF routinely submits comments regarding USPTO policies and procedures that affect the patent system's ability to achieve these goals, including Patent Trial and Appeal Board ("PTAB") trial practice and procedures. The PTAB plays a critical role in the public's ability to mitigate the harmful effects of invalid patents, and inter partes review ("IPR") proceedings remain one of the most important tools available to challenge those patents. EFF therefore takes a special interest in ensuring the IPR process is not weakened or rendered inaccessible through rules that undermine Congress's intent or empower abusive patent litigation practices. The proposed rules would do exactly that.

The combined effect of the proposed stipulation requirement, the prior-decision bar, and the expanded parallel-litigation bar would fundamentally alter the IPR system in ways Congress did not intend. Rather than preserving an expert, merits-focused mechanism to correct examination errors, the NPRM would make institution so difficult that IPRs would become a rarity. A process designed to safeguard the public from invalid patents would instead become structurally unavailable in many of the cases where rigorous review is most needed. This outcome contradicts the American Invents Act ("AIA")'s text, structure, and purpose, which envisioned the PTAB as an accessible forum for evaluating prior art on the merits—an alternative, not a

[1] Revision to Rules of Practice Before the Patent Trial and Appeal Board, 90 Fed. Reg. 48335 (Oct. 17, 2025) (https://www.federalregister.gov/documents/2025/10/17/2025-19580/revision-to-rules-of-practice-before-the-patent-trial-and-appeal-board)

subordinate, to district-court litigation.

These changes would strip away important protections against patent trolls that rely on low-quality patents and litigation pressure to extract settlements from innovators, small businesses, and the public. The rulemaking would make bad patents nearly untouchable and invite a new wave of opportunistic legal abuse. EFF opposes multiple proposed changes for the reasons below.

Mandatory Stipulation Conflicts with the AIA and Undermines Petitioners' Rights

The NPRM would require petitioners to stipulate that, if an IPR is instituted, the petitioner and any real party in interest or privy will not raise 35 U.S.C. § 102 or § 103 invalidity arguments regarding the challenged patent in any other forum.[2] This requirement far exceeds the voluntary "Sotera" framework and would chill petitions to the PTAB by forcing defendants to forfeit core litigation defenses simply to access IPR. The stipulation must also be filed in "any other tribunal where [the petitioner] is litigating or later litigates,"[3] effectively waiving invalidity challenges everywhere, including for claims not addressed in the IPR.

Such an expansive, mandatory waiver is not supported by statute, conflicts with Congress's design of IPR as a parallel and complementary route for invalidity review, and would especially harm small companies and developers who already face disproportionate pressure from patent trolls. This rule would make IPR too risky to pursue, allowing patent trolls to rely on litigation leverage rather than patent quality—an outcome inconsistent with the purpose of the AIA.

Nothing in the AIA authorizes the USPTO to condition access to IPR on a petitioner's agreement to surrender all invalidity defenses across all forums. The statute imposes estoppel only after a final written decision and only as to arguments that reasonably could have been raised in the IPR. Transforming that limited, post-decision estoppel into a sweeping, pre-institution waiver exceeds the Office's rulemaking authority. Making this waiver mandatory—rather than a voluntary tool available when strategically appropriate—would convert IPR from a parallel option into a high-risk gamble, discouraging many petitioners from using the system Congress created to address poor-quality patents.

Prior-Decision Bar Imposes an Improper One-and-Done Rule

The proposed prior-decision bar would prohibit institution or continuation of an IPR if any prior proceeding—including district-court litigation, ITC investigations, PTAB trials, or even ex parte reexaminations—has upheld the challenged claim on § 102 or § 103 grounds[4], absent

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[2] 37 C.F.R. § 42.108(d).
[3] *Id*.
[4] 37 C.F.R. § 42.108(e).

"extraordinary circumstances."[5] This sweeping bar eliminates case-specific discretion and applies even when prior challenges were underdeveloped, based on weaker prior art, or decided under fundamentally different evidentiary standards.

In practice, the rule creates a "first-mover veto" that particularly benefits patent trolls, allowing them to race to favorable forums and foreclose later, stronger PTAB challenges—even those brought by unrelated third parties. This undermines the PTAB's corrective function and would leave many invalid patents in force. Ex parte reexaminations are especially ill-suited to generate binding outcomes of this kind because they are non-adversarial and often lack robust prior-art analysis. Converting any such decision into a bar on public access to IPR would severely weaken a system meant to identify and eliminate erroneously granted patents.

The NPRM's requirement that an already-instituted IPR "shall not be maintained" if a prior proceeding later results in a favorable outcome for the patent owner adds further uncertainty and procedural unfairness. Terminating proceedings mid-stream—after substantial resources have been invested and after the Board has begun its merits review—contradicts the AIA's structure, which presumes that once instituted, an IPR proceeds to a final written decision unless the parties settle.[6] Allowing late-breaking events in unrelated proceedings to derail an IPR invites the kind of gamesmanship Congress sought to avoid.

Expanded Parallel-Litigation Bar Extends *Fintiv* and Limits Institution

The NPRM would expand and codify discretionary denials under *Fintiv* into a rigid rule providing that the PTAB "shall not" institute when a parallel validity determination in any forum is "more likely than not" to conclude before the PTAB's final written decision.[7] This change replaces a flexible factor-based inquiry with a mandatory preclusion standard. It shifts the institution decision away from the merits and onto scheduling uncertainties and strategic behavior entirely outside the petitioner's control.

Such a rule invites gamesmanship: patent owners can choose forums with accelerated timetables solely to trigger preclusion, while accused infringers must prepare for parallel proceedings until one forum becomes unavailable. Rather than promoting efficiency, the change increases costs, reduces predictability, and encourages forum shopping and rushed litigation—all contrary to Congress's intent for IPR to provide a lower-cost, expert-driven alternative.

By elevating scheduling predictions above substantive analysis, the rule would further shift the PTAB away from its role as an expert tribunal charged with evaluating prior art and toward a procedural gatekeeping body. Congress did not intend the PTAB to deny access based on speculation about whether a court or the ITC might reach a decision first. The Board's expertise

[5] 37 C.F.R. § 42.108(g).
[6] 35 U.S.C. § 318(a).
[7] 37 C.F.R. § 42.108(f).

lies in assessing technical disclosures and determining patentability—not in forecasting litigation timelines. Turning timing into the decisive factor undermines the very rationale for having an expert administrative forum at all.

These structural changes would disproportionately benefit patent trolls that exploit litigation asymmetry. Patent trolls already rely on the high cost of district-court litigation to pressure defendants into settlement regardless of patent quality. The proposed rules would intensify that dynamic by creating new opportunities to generate early or strategically manufactured rulings that block PTAB review. This is not a speculative concern; it reflects established patterns of forum shopping and accelerated filing strategies, particularly against small and resource-constrained targets.

These concerns are not unique to EFF. Public commentary and widespread stakeholder criticism reflect long-standing objections to efforts that curtail PTAB access.[8] The proposed "one-and-done" framework will not "promote fairness, efficiency, and predictability in patent disputes," as the NPRM suggests. Instead, it would convert discretionary denial into categorical exclusion, encourage procedural manipulation, and allow early rulings—regardless of depth or quality—to foreclose all future invalidity review.

The threat to economic growth and innovation is significant. When Congress created the IPR system under the America Invents Act, it sought "to ensure that poor-quality patents can be weeded out through administrative review rather than costly litigation."[9] The proposed changes reverse that intent. They would steer litigants away from the expert-driven PTAB forum and force disputes into district courts that lack the PTAB's technical expertise, are far more expensive, and lack procedures for efficiently evaluating large volumes of prior art. Litigation costs would rise across the board, and uncertainty around patent scope would increase. Companies—particularly small innovators—would be pressured into settlements not because a patent is valid, but because the review mechanisms have been artificially closed off.

PTAB pathways for patent review exist precisely because district-court litigation is slow, burdensome, and expensive. The Board's technical expertise and streamlined procedures offer a far more efficient venue for testing patentability. While parallel proceedings can occasionally create redundancy, those situations are the exception, and the appropriate remedy is improved procedural coordination—not the near-elimination of IPR. The NPRM instead moves in the opposite direction. It primarily benefits entities that assert patents for financial leverage, not inventors or the public seeking clarity and quality. Patent owners "should enjoy the benefit of their invention without a cloud of uncertainty[10]," but the public must have equally robust mechanisms to clear out invalid patents. Allowing strategic patent troll behavior to foreclose

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[8] https://www.regulations.gov/docket/PTO-P-2020-0022.
[9] 157 Cong. Rec. S5409 (Sept. 8, 2011) (Sen. Schumer).
[10] S. Rep. No. 110-259 at 71 (Sen. Kyl).

PTAB review deprives the public of that protection.

If adopted, the NPRM would deprive the public of its most effective mechanism for challenging invalid patents. IPR is not merely a dispute-resolution tool for private litigants; it is a safeguard for the public at large, ensuring that mistakenly granted monopolies do not distort markets, suppress competition, or burden technological progress. The proposed rules would eliminate that safeguard across a broad swath of cases, leaving the public exposed to patents that have never undergone robust, adversarial scrutiny. Congress created IPR precisely because litigation alone cannot reliably or efficiently perform that function. The NPRM would reverse that judgment and restore the very problems the AIA sought to remedy.

EFF asks the USPTO to reconsider the NPRM in its current form. Ensuring that PTAB proceedings remain accessible, merits-focused, and effective is vital for innovation, competition, and the public interest. These proposed rules, individually and collectively, would undermine those goals and should not be adopted.

Respectfully submitted,

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December 1, 2025