



PREVAIL in Comparison to the Current and Previous Administration's Procedures for PTAB

Notes:

- “Petitioners” usually include privies & RPLs, but this is omitted for brevity
- Information provided at the end includes:
 - An explanation of §§ 102/103 (all bases) versus §§ 102/103 (printed publications)
 - A list of abbreviations
 - An explanation of *Fintiv* factors and *Sotera* stipulations

Issue	Previous Administration	PREVAIL 2025	Current Administration	Oct. 2025 NPRM
Director review & delegations of authority	Institution decisions delegated to a 3-APJ panel that also is responsible for conducting the trial Director may be petitioned to review institution and final written decisions 37 C.F.R. § 42.75 (Director review)	Institution decisions delegated to a 3-APJ panel, but trial must be conducted by 3 different APJs Director may review and modify any decision of the Board, provided that the decision is in writing and sets forth the reasons for the review (PREVAIL, §§ 3(2), 4(g)(2))	Director decides institution, in consultation with APJs; different APJs will handle the trial (Squires Oct 17 memo) (USPTO Hour, Oct. 29, 2025)	Institution decisions will normally be made based (at least in part) on the proposed rules, with unusual follow-on petitions referred to the Director who can personally decide if “extraordinary circumstances” justify institution (NPRM, proposed § 42.108(g))
Institution barred based on other proceedings	(1) Petitioner already challenged the patent in a civil action (i.e., DJ of invalidity in district court); (2) Petitioner was sued for patent infringement over a year ago 35 U.S.C. § 315(a)(1), (b) (“existing statutory bars”)	Existing statutory bars + Prior decisions on §§ 102/103 (printed publications) where petitioner is a party, including: • district court final decision; • ITC final decisions (PREVAIL, § 4(d)(1)(G))	Existing statutory bars + Any factor the Director considers to be absolute bars (Squires Oct 17 memo)	Existing statutory bars + Prior decisions upholding validity on §§ 102/103 grounds (all bases), regardless of affiliation of the parties to the petitioner, including: • District court trial or summary judgement; • ITC initial or final determination; • PTAB final written decision in an earlier PGR or IPR • Ex parte reexam office action • Federal Circuit reversal of a lower tribunal invalidity decision under §§ 102/103 (all bases) (NPRM, proposed § 42.108(e))

Issue	Previous Administration	PREVAIL 2025	Current Administration	Oct. 2025 NPRM
Denial of institution based on ongoing parallel proceedings	<i>Fintiv</i> factors will be considered in determining whether to deny based on parallel proceedings; <i>Fintiv</i> factors do not apply where there is “compelling evidence of unpatentability”; Parallel ITC proceedings will not factor into the analysis; <i>Fintiv</i> does not apply where the petitioner provides a <i>Sotera</i> stipulation not to pursue §§ 102/103 (printed publications) grounds in district court (Vidal 2022 memo)	Director may not deny based on parallel proceedings; Petitioner must choose the single forum in which to raise challenges on §§ 102/103 (printed publications) (PREVAIL, § 4(d)(1)(C))	Interim procedures suggest that the Director may consider parallel proceedings in determining whether to deny institution (Squires Oct 17 memo) (referring to the guidance provided under the interim decisions as instructive) Interim process webpage (setting forth factors that may be considered)	Institution will be denied based on parallel proceedings (district court, ITC, other PTAB) where it is “more likely than not” that the other proceeding will reach a decision first on §§ 102/103 grounds Petitioner does not need to be the same party that is in the parallel proceeding (NPRM, proposed § 42.108(f))
Required stipulations where there are parallel proceedings	<i>Sotera</i> stipulation is sufficient for institution of an IPR where the petitioner is in a parallel proceeding (Vidal 2022 memo)	No stipulation required, but by statute, a petitioner will not be able to proceed with identical challenges in both IPRs and district court or the ITC (or grounds that reasonably could have been raised) If new claims of the patent are later asserted against the petitioner, the petitioner may seek to have those claims joined in the IPR challenge, subject to a rebuttable presumption against joinder (PREVAIL, § 4(d)(1)(F))	Stipulation may be helpful but is not dispositive (Squires Oct 17 memo) (referring to the guidance provided under the interim decisions as instructive) Interim process webpage (setting forth factors that may be considered)	Where the petitioner is involved in parallel proceedings, it will be required to file a stipulation in each tribunal not to raise any §§ 102/103 (all bases) argument in the other forum; The stipulation will apply to the whole patent, not just the claims being challenged in the IPR (NPRM, proposed 42.108(d))
Director discretion to deny institution based on prior art previously before the Office	Denial appropriate where the same or substantially the same art or arguments were previously presented to the Office and the petitioner demonstrated material error 35 U.S.C. § 325(d); <i>Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH</i>, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential)	For a serial IPR, the Director shall not institute based on the same or substantially the same prior art, unless there are “exceptional circumstances” (PREVAIL, § 4(d)(1)(E))	May factor in the Director’s discretion (Squires Oct 17 memo)	New prior art is provided as an example of what does NOT constitute “extraordinary circumstances” for the Director to authorize a serial IPR (NPRM, proposed § 42.108(g))

Issue	Previous Administration	PREVAIL 2025	Current Administration	Oct. 2025 NPRM
Director discretion to deny institution based on other factors	N/A	N/A	Factors noted on the interim processes webpage: • Settled expectations of the patent owner based on the age of the patent • National security, public health, or economic interests • Substantial changes in the law • Strength of the merits challenge • Extent of the petitioner's reliance on expert testimony (Squires Oct 17 memo) (referring to the guidance provided under the interim decisions as instructive) Interim process webpage (setting forth factors that may be considered)	N/A
Standing to bring an IPR	Anyone who is not the owner of the patent (NPOs) 35 U.S.C. § 311(a)	Limits standing to: (A) nonprofits not financially connected to potential infringers; (B) NPO that has a bona fide intent to engage in conduct that could reasonably be infringing; (C) NPO that has Art. III standing; (D) NPO was sued for infringement (PREVAIL, § 4(b))	No change from previous administration (any NPO)	N/A
Evidentiary standard for proving unpatentability	Preponderance for issued and proposed amended claims 35 U.S.C. § 316(e) (issued claims) 37 C.F.R. § 42.121(d) (proposed amended claims)	Clear and convincing evidence for issued claims; Preponderance for proposed amended claims (PREVAIL, § 4(e)(2))	No change from previous administration (preponderance for all)	N/A
Claim construction standard	Phillips (district court claim construction standard) for issued claims and proposed amended claims 37 C.F.R. § 42.100(b)	Codifies the current regulations (district court claim construction for all) (PREVAIL, § 4(e)(3))	No change from previous administration (district court claim construction for all)	N/A

Issue	Previous Administration	PREVAIL 2025	Current Administration	Oct. 2025 NPRM
Real party in interest (RPI) practice	RPI definition: “[A]t a general level, the “real party-in-interest” is the party that desires review of the patent. Thus, the “real party-in-interest” may be the petitioner itself, and/or it may be the party or parties at whose behest the petition has been filed.” 2019 Trial Practice Guide (p. 14) RPI analysis is not required at the institution phase unless the patent owner alleges that the petition would be time-barred or estopped based on an unnamed RPI <i>SharkNinja Operating LLC v. iRobot Corp.</i>, IPR2020-00734, Paper 11, at 16–20 (PTAB Oct. 6, 2020))	RPI definition broadened so that an entity that financially contributes to an IPR is considered an RPI Does not address <i>Corning Optical</i> or <i>SharkNinja</i> Provides for greater discovery to verify RPIs (PREVAIL, § 4(a), 4(e)(1)(C))	No change to RPI definition All RPIs must be listed for institution to be proper (<i>Corning Optical Comms.</i>), overturning the <i>SharkNinja</i> precedent, which made RPI errors correctable (Oct. 28, 2025 memo)	N/A
Other notable practices or provisions	N/A	• Joinder practice revised; • Director required to decide how multiple provisions before the USPTO are coordinated; • Patent claim amendment process altered to require that patent owners be given feedback on their original proposed amendments; • Eliminates the prohibition on estoppel attaching against a petitioner if an IPR is terminated by settlement • (PREVAIL, §§ 4(d)(1)(A), (D), (E), (F))	N/A	N/A

Abbreviations

- APJ – administrative patent judge
- DJ – declaratory judgement
- FWD – final written decision
- IPR – inter partes review
- ITC – International Trade Commission
- NPO – non-patent owner
- RPI – real party in interest

Other Explanations

- *Fintiv* factors – a set of non-exclusive factors that the PTAB considers on a case-by-case basis in determining whether to institute a proceeding, including (1) whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted; (2) proximity of the courts trial date to the Board’s projected statutory deadline for a final written decision; (3) investment in the parallel proceeding by the court and the parties; (4) overlap between issues raised in the petition and in the parallel proceeding; (5) whether the petitioner and the defendant in the parallel proceeding are the same party; (6) other circumstances that impact the Board’s exercise of discretion, including the merits.
- *Sotera* stipulations – where the petitioner presents a stipulation not to pursue in a parallel proceeding the same grounds or any grounds that could have reasonably been raised before the PTAB
- 102/103 (all bases) versus 102/103 (printed publications)
 - “All bases” = novelty based on printed publications, public use, or prior sales & obviousness based on what was previously known publicly
 - “Printed publications” = novelty and obviousness based only on printed publications as evidence