



December 2, 2025

USIJ COMMENTS re NPRM – Dkt. No. PTO-P-2025-0025

A. Introduction.

The Alliance of U.S. Startups and Inventors for Jobs (“USIJ”) responds herein to Notice of Proposed Rulemaking, dated October 17, 2025 (90 FR 48335-41) (“NPRM”), whereby the U.S. Patent and Trademark Office (“USPTO” or “PTO”) proposes corrective changes in the procedures used by the PTO Director for managing the Patent Trial and Appeal Board (“PTAB”) and the statutory duties set forth in 35 U.S.C. §§ 311 *et seq* as to the institution and conduct of Inter Partes Reviews (“IPRs”). The NPRM requests comments and suggestions from all quarters of the patent stakeholder community as to these changes proposed by the PTO. The stated purpose of the proposed changes is to rebalance competing interests regarding institution and outcomes and to increase “fairness, efficiency, and predictability in patent disputes.” NPRM at p. 5. USIJ believes that such a rebalancing is sorely needed and long overdue, and we commend PTO Director John A. Squires for addressing a number of significant flaws in the manner in which Inter Partes Reviews (“IPRs”) have been managed in the past.

USIJ is a coalition of over 20 startups, entrepreneurs, inventors and venture investors – all of which depend on stable and reliable patent protection as a foundational prerequisite for making long term commitments of capital and human resources to high-risk efforts to commercialize new technologies. Because such commitments often consume periods of years, USIJ members rely heavily on patents to justify these investments. There is no viable commercial reason for spending time and effort over long periods of time inventing a new product or technology, if – once the invention is proven economically feasible – larger companies and foreign competitors with far greater resources, entrenched market positions, better known brands, and established sales channels can simply copy it. USIJ is committed to the restoration of a U.S. patent system that protects innovation and rewards disruption and risk-taking, all of which have been eroded severely over the past 15 or 20 years. Our mission is to ensure that the U.S. patent system continues to thrive for the benefit of American startups and inventors, and most importantly, America’s leadership in science and technology of the future. The changes proposed in the NPRM reflect a major step in the right direction.

B. USIJ Strongly Supports the Proposed Changes in the Procedures Used by the Director to Manage Inter Partes Reviews.

USIJ **strongly** supports the proposed changes to CFR §42.108 and their underlying rationale as described in the NPRM. We urge their prompt approval and implementation. These changes represent a long-awaited course correction that will help bring integrity, predictability, and fairness to the post-grant review process that heretofore have been missing. For the USIJ community – indeed for the vast majority of American inventors, startups and their venture investors – the implementation of these new rules will formalize the most significant and positive step yet taken to align the operation of the PTAB with the stated congressional objectives in creating it. Congress believed it was establishing a cost-effective **alternative** to district-court litigation, a far cry from the duplicative and abusive operation that in actual practice was implemented by the PTO that has enabled large, well-capitalized infringers to increase both the cost and the risk facing smaller, disruptive competitors seeking to enforce or license their patents and, in many cases, to undermine the value of those patents altogether. This weaponization of the PTAB is described in the NPRM:

Congress passed the [AIA] to “provide a quick and effective cost alternative” to District Court patent litigation, most notably through Inter Partes Review proceedings. H.R. Rep. No. 112-98, at 48 (2011). IPR proceedings ... are not appropriate in every circumstance. When IPR proceedings cover the same ground as district court litigation, they cease to be an “alternative” and can substantially increase litigation cost. That is the **opposite of what Congress intended**. ... [M]ultiple challenges to the same patent through IPRs jeopardize the reliability of patent rights and incentives to invest in new technologies. This proposed rule is intended to focus IPR proceedings on the most appropriate disputes. NPRM, p. 3 (emphasis supplied).

The proposed rules reflect, to a large extent, the culmination of over a decade of sustained advocacy by USIJ and its members, along with many others similarly situated who have been alerting the PTO to the realities of the abuse of the IPR system. This entire cohort has consistently urged the PTO to (a) curb multiple attacks on the same patent, (b) eliminate parallel proceedings whereby the same patent is challenged in both district court and before the PTAB, and (c) force the identification of real parties in interest in proxy challenges calculated to circumvent the estoppel effect of 35 U.S.C. §315(e). Under the current rules, unrelated third parties with opaque connections to a given case and often with monetary support from large infringers are allowed to file petitions asserting the invalidity of patents in the PTAB without identifying their actual clients, the sole purpose being to provide the client with additional shots at challenging validity if the PTAB attack fails.¹ The foregoing and other routine practices currently allowed by current PTAB

¹ It is difficult to envision any other *raison d'être* for Unified Patents, Inc. and other bounty hunters that spend large amounts of money challenging the validity of patents that they do not infringe. They purport merely to be providing a public service in challenging invalid patents, but given the source of their funding is it clear this is not the case. USIJ published a White Paper in 2018 identifying the parasitic activities of these bounty hunters as part of the epidemic of multiple attacks on the same patent claim. See, e.g., “How One Bite at the Apple Became Serial Attacks on High Quality Patents,” <https://www.usij.org/research/2018/serial-attacks>.

rules have imposed extremely costly and risky burdens on legitimate patent owners, deterring many from trying to license their inventions or assert their patents in this country, and discouraging others from even trying to invent new technologies.² In our view, the proposed IPR reforms advance a framework that will reward invention, encourage investment, and help restore balance in the nation’s innovation ecosystem while at the same time not threatening the competitive options of incumbent companies. USIJ urges the USPTO to finalize these rules substantially as proposed. The objective is to preserve the principles of reliability, efficiency, and one-forum finality that are indispensable to a robust intellectual property system and a thriving innovation economy that is fair to both the least resourced participants and the largest resourced participants.

One extremely important point, not be overlooked, is that any company charged with infringing a U.S. patent can always assert the invalidity of the patent in district court in the event an IPR challenge is not instituted by the PTO. The unsuccessful petitioner can also request an *ex parte* reexamination through which the PTO can take a second look at a patent it previously granted. Nothing in the proposed changes set forth in the NPRM will diminish those rights. For 225 years prior to the creation of the PTAB and IPR procedures, patent owners faced and dealt routinely with such challenges in judicial proceedings and *ex parte* reexaminations. Additionally, such companies always have had and will continue to have the ability to design around or license a patent as was routinely done until the establishment of “efficient infringement” tactics enabled by the formation of the IPR system.

C. The NPRM Is Transparent as to the Reasons for the Proposed Changes in the Director’s Management of PTAB Proceedings.

1. Startups and Small Companies Are Critically Important to Real Innovation

The explanatory materials that accompany the proposed rule changes (NPRM, pp. 2-7) describe the PTO’s reasons for the proposals and some of the circumstances wrought by the agency’s past failures to implement, or even to acknowledge, the congressional intent that led to the creation of the PTAB and post-grant review processes in the first place. At bottom, these agency failures have been the primary source of most or all of the abuse that the PTAB has allowed to be visited on small companies and individual inventors by – primarily – a handful of large digital technology companies. The NPRM notes (p.5), for example:

² In 2020, USIJ published a Policy Report entitled “The Importance of an Effective and Reliable Patent System to Investment in Critical Technologies,” confirming the serious adverse economic effect of a weakened U.S. patent system. The study found that as post-grant proceedings and other legal changes made U.S. patents less reliable, the share of venture capital funding going to firms in patent-intensive industries fell from over 50% in 2004 to about 28% in 2017. Funding for semiconductors, medical devices, and pharmaceuticals declined sharply in relative terms, while capital flowed toward less patent-dependent sectors such as social networking and consumer finance. Interviews with leading investors and inventors traced this shift to the growing unpredictability of the U.S. patent system. This shift of capital away from strategically critical industries imperils the security and welfare of our nation.

By far, the most frequent users of IPR proceedings are large technology companies. When a large company is free to copy a patented invention because it believes it can invalidate the patent through multiple validity challenges, the large company's other advantages such as superior brand recognition and manufacturing scale will often give it an edge over smaller competitors. Thus, weakened patent rights can contribute to market concentration in innovative industries. *See* Professor Jonathan Barnett, *Why big tech likes weak IP, Regulation* (Spring 2021).³

To flesh out the point, the NPRM (p. 5) focuses on the critical significance of innovation in our nation and the need for startups and small companies to be protected from predatory conduct by large incumbents with which they would compete. The NPRM calls attention to a 2023 report of the National Economic Council entitled, "The Economics of Investing in America," which notes that startups and small to medium sized companies are the primary source of innovation in this nation – not the entrenched corporate giants that falsely claim that role. The NEC report states:

The evidence is clear that new small and medium-sized businesses are drivers of innovation. Yet when a few firms (or one single firm) dominate a market, they can stifle and stymie disruptive startups and other new businesses (p. 12) <https://bidenwhitehouse.archives.gov/wp-content/uploads/2023/07/Economics-of-Investing-in-America.pdf>

In the same vein, the NPRM calls attention to a 2022 report of the National Bureau of Economic Research entitled, "Of Academics and Creative Destruction: Startup Advantage in the Process of Innovation," https://www.nber.org/system/files/working_papers/w30362/w30362.pdf (pp. 4-5), which finds:

First, startup innovation will be more valuable and ultimately more impactful than that of either universities or large firms, and second, startups will generate innovations that are more radical and disruptive than those of incumbent firms. We provide descriptive statistics consistent with these hypotheses using a sample of patents generated in the vicinity of the top 25 research universities in the United States from 2000 to 2015. ... Overall, our findings suggest that startup innovation is qualitatively different from the

³ Dr. Barnett's observation is entirely consistent with the conclusion of a report released in 2022 by the House Judiciary Subcommittee on Antitrust, Commercial and Administrative Law entitled "Investigation of competition in digital markets" ("House Report"), a 451-page assessment of the state of competition in the digital technologies. Although the Report is primarily concerned with the impact that Google, Facebook, Amazon and Apple are having on privacy and competition in the digital technologies, much of the report is equally applicable to some of the other corporate giants that work in the digital technology space. An important finding of the Subcommittee confirms a substantial decline in the number of startups and entrepreneurs willing to start companies to compete with large incumbents:

"In recent decades, however, there has been a sharp decline in new business formation as well as early-stage startup funding. The number of new technology firms in the digital economy has declined, while the entrepreneurship rate—the share of startups and young firms in the industry as a whole—has also fallen significantly in this market. Unsurprisingly, there has also been a sharp reduction in early-stage funding for technology startups." House Report at p.46.

innovation in other organizational settings: there is a clear “startup advantage” in the quality and impact of startup patents relative to established firms.⁴

2. Multiple Challenges Can Destroy the Strongest and Most Deserving Patents.

In a section of the NPRM entitled “Even extremely strong patents become unreliable when subject to serial or parallel validity challenges,” the agency recognizes in simple, straightforward language, the inescapable arithmetic that attends multiple challenges to the same patent claim. NPRM, p. 3. All litigation is probabilistic in nature, because outcomes are decided by people who receive only a narrow and highly artificial view of the facts, about which they usually lack personal experience to evaluate. This means that some percentage of all litigation outcomes will simply be wrong, and for patent litigation, this is more so because of the technical complexity of the subject matter, thus making errors even more likely.⁵ When any patent is subjected to multiple challenges, this risk of error grows exponentially, particularly when the attack is based on obviousness under Section 103, a determination that is both highly subjective and is inherently fraught with the danger of hind-sight bias.⁶ Section 103, of course, is the basis of the vast majority of IPR invalidations of issued patents.

Notwithstanding the common sense validity of this point, it was developed more rigorously several years ago in a scholarly essay by Matteo Sabatini https://papers.ssrn.com/sol3/papers.cfm?abstract_id=366821, but despite multiple efforts by USIJ and others to call the agency’s attention to Dr. Sabatini’s analysis, the point has been ignored by the PTO until the current NPRM.

USIJ believes that the ultimate reason for having a government supported patent system in the first place should be to incentivize entrepreneurs, inventors and risk-tolerant investors to dedicate

⁴ USIJ has identified a significant body of scholarship that supports the same conclusion. Numerous studies have shown that the internal profit and bonus dynamics of large companies rarely tolerate disruptive innovation, so that what they call “innovation” is really just marginal improvements on existing technologies. *See, e.g.*, Clayton Christensen, “INNOVATORS DILEMMA,” Harvard Business Review Press (1997), whose studies describe a number of industries where disruptive innovation caused the company’s failure. *Accord*: Chris Miller, “CHIP WARS,” Simon & Schuster (2022), pp. 191-97, describing Intel’s inability to innovate and enter the market for mobile processing until after smaller companies were able successfully to develop low power microprocessors necessary for smartphones. *Accord*: Michael Hiltzik, “DEALERS OF LIGHTNING,” Harper Collins Publishing (1999), describing how the senior management at Xerox recognized in 1970 that the dawn of digital imaging ultimately would destroy its analog copier business, and so created Xerox Parc, staffed with some of the most brilliant young inventors and scientists in the world, only to discover that the institutional forces within the company still would not allow much of the resulting innovation to come to market.

⁵ In *Blonder Tongue v. University of Illinois Foundation*, 402 U.S. 313 (1971), the Supreme Court held that a single finding of invalidity is normally sufficient to invalidate a patent claim for all time and all purposes, whereas a contrary finding is binding only on the challenger. The asymmetrical aspect of this long-standing principle makes multiple attacks on a small company’s patents particularly unfair.

⁶ *Safety Car Heating & Lighting Co. v. General Elec. Co.*, 155 F.2d 937, 939 (2d Cir. 1946) (Learned Hand, J.) (“Substantially all inventions are for the combination of old elements; what counts is the selection, out of all their possible permutations, of that new combination which will be serviceable. No objective standard is practicable. ... Courts, made up of laymen as they must be, are likely either to underrate, or to overrate, the difficulties in making new and profitable discoveries in fields with which they cannot be familiar; and, so far as it is available, they had best appraise the originality involved by the circumstances which preceded, attended and succeeded the appearance of the invention.”)

financial and human capital to innovation. The newly proposed rules described in the NPRM will give life to that objective by minimizing harassment and abuse of any company attempting to license or enforce its patents. USIJ is particularly pleased to see the explicit recognition in the NPRM that allowing multiple attacks on the same patent claim can destroy the very best of patents.⁷ We urge the USPTO to finalize this rule substantially as proposed and thereby restore the reliability, efficiency, and one-forum finality that are indispensable to a robust intellectual property system and a thriving economy.

D. The Rules Proposed in the NPRM Address Fundamental and Well-Documented Flaws in IPRs That Have Allowed Harassment and Abuse of Inventors from the Outset.

1. Single Forum Stipulation – 37 CFR Part 42.108(d)

Forcing an adversary to fight on multiple fronts is a time-honored military strategy and is especially effective when one adversary is 4 or 5 orders of magnitude larger than the other, as is true of the vast majority of IPRs. The proposed change to 42.108(d) is designed to confine the role of IPRs to that of a true “alternative” to district court litigation, as Congress intended, and to put an end to litigating validity of the same patent in multiple tribunals. The Rule would require a petitioner to stipulate that, irrespective of the outcome of the IPR, the petitioner will not challenge the subject patent in future litigation any prior art ground, and further require the petitioner to file a copy of such stipulation in any district court proceeding involving the same patent.

USIJ suggests that consideration be given to a possible clarification to Rule 108(d). Given the inclination of the U.S. Supreme Court (and therefore lower courts) – when they are unable to find a patent ineligible under the language of Section 101 – to incorporate lack of novelty under Section 102 or lack of an inventive feature or step under Section 103 to reach their desired outcome of ineligibility. Given this approach to eligibility, the proposed rule may not be entirely clear as to whether the stipulation required by §108(d) to not assert claims under Sections 102 and 103 would also limit challenges to eligibility under Section 101 based on prior art.⁸ The

⁷ The pending Federal Circuit case between Netlist and Samsung illustrates the stunningly devastating effect of allowing multiple challenges to the same patent claim. Fed. Cir. Dkt. 24-2304. Plaintiff’s Opening Brief shows that Claim 16 of U.S. Patent No. 7,619,912 survived multiple *ex parte* reexams, an IPR brought by Google that went to the Federal Circuit and was affirmed in favor of Netlist, only then to face yet another IPR brought by Google’s supplier of the infringing product. In this latest attempt, Samsung was assigned to a different panel of PTAB judges that was allowed to adopt a different claim construction to find the claim invalid. That decision is now on appeal, but by the time the case ends, the Netlist patent, which covers highly innovative data storage technology, will have expired after spending its entire life in multiple reexaminations by the PTO. The proposed rule promises to put a stop to this monumental injustice and perhaps rekindle the incentive to invest time and resources in developing new technologies.

⁸ Thus, in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S.Ct 1289, 1303 - 1305 (2012) the Supreme Court made clear that intends to use the requirements of novelty and non-obviousness from Sections 102 and 103 to evaluate patent eligibility under Section 101, rejecting both the patent owner’s argument and the advice of Solicitor General not to conflate the two concepts. The Court’s opinion contains multiple references to the need for an “inventive” step as a condition of eligibility, and specifically rejects the argument that “the Court should

Rule does seem clear that a petitioner will remain free to challenge validity under Section 112, and this would be entirely consistent with the intention of Congress.

USIJ strongly endorses and supports this change to 48.108(d). A patent owner is severely disadvantaged by having to defend the validity of a patent in two tribunals, particularly given the differing standards against which invalidity can be measured. In creating the PTAB, Congress made the assumption that the PTO, because of its greater expertise in patent matters, should be allowed to use a preponderance of the evidence standard instead the clear and convincing evidence standard for judicial challenges implied by the Patent Act's presumption of validity.⁹ Soon after commencement of IPR proceedings, however, infringers began to play these separate standards against one another, arguing, for example, that a defendant in district court faced a higher burden in court than in the PTAB, so that even after a failure in court to invalidate the patent, they were still entitled to attempt invalidation under the lesser standard specified in the AIA.¹⁰ The addition to Section 48.108(d) should put a stop to that.

2. A Single Validity Challenge for a Claim – 37 CFR Part 42.108(e)

The principle of *res judicata*, also called claim preclusion, is a long standing and foundational feature of the American legal system. The principle is applied for three primary reasons – conservation of both judicial resources and those of the parties, basic fairness to litigants, and the avoidance of inconsistent judgements. The PTAB, however, has refused to recognize any aspect of “finality” as to a patent claim challenged in that tribunal. Patents that have been held not invalid by district courts, even those affirmed by the Federal Circuit, have frequently been subsequently cancelled by a panel of Article I judges. This lack of finality extends even to decisions of the PTAB itself, and is grossly unfair to patent owners, rendering their patents always at risk and severely diminishing the value of patents as a foundation for raising capital or attracting entrepreneurs to enter a new business.

Exemplary is a dispute between Netlist (the patent owner) with Samsung and Google (alleged infringers) over digital storage and retrieval technology invented and patented by Netlist and copied by Samsung to make a component sold to and resold by Google. In that case, currently awaiting oral argument in the Federal Circuit (Dkt. 2023-24-2304), Google was permitted to challenge U.S. Patent No. 7,619,912 on multiple occasions, losing each time as to Claim 16, but not barred from trying again. When that string of efforts finally failed, Samsung, the supplier of the accused device, was then permitted to initiate still another IPR proceeding, this time with a different PTAB panel, which rendered a different claim construction and a different outcome. Resources of the PTO and the patent owner dedicated to this ridiculous scenario were staggering. Worse, the Netlist story exposes – for the entire cohort of inventors, startups and their investors, the cruel hoax of a viable and enforceable U.S. patent backed by presumption of validity. It is

not invalidate these patents under §101 because the Patent Act's other validity requirements will screen out overly broad patents.”

⁹ *Microsoft Corp. v. i4i Ltd. Partnership*, 564 U.S. 91 (2011) confirming the need for a clear and convincing evidentiary standard based on the presumption of validity found in Section 282 of the Patent Act.

¹⁰ *See*, fn.15, *supra*, describing the IPR prosecuted successfully by Intel **after** it lost on the same issues in district court litigation that ended in a large verdict.

impossible for anyone to make a case justifying this type of treatment of a highly innovative small company at the hands of two corporate Goliaths that have consumed the entire life of its patent with highly profitable infringement benefits, leaving nothing for the inventor.¹¹

3. Reducing Abuse of Startups and Inventors by Bounty Hunters Without Any Actual Interest in the Patents on Which They File Petitions.

One of the primary shortcomings in the AIA is the absence of a requirement that an IPR petitioner must have standing to bring the petition, *i.e.*, an actual interest in the validity of the property right it is trying to cancel.¹² Although Congress may have chosen to allow anyone to file an IPR petition – which at bottom is essentially a form of quasi-litigation – Section 314 does not require that the Director institute a trial of such a petition or dedicate time and resources to such. There are numerous reasons for scrutinizing the actual reason for filing where the petitioner has not been threatened by the patent owner or cannot demonstrate an intent to enter a business where the patent might block it from doing so. Without such scrutiny, the existing absence of a standing requirement has given rise to multiple forms of trickery and abuse.

Shortly after the PTAB was created, for example, an avaricious stock manipulator began filing IPR petitions against small public companies whose patents were extremely important to the viability of the patent owner, after shorting shares of the stock. News of the IPR petition triggered an immediate and predictable drop in the price of the shares, allowing the predator to cover the short sale and pocket a tidy profit. Petitioner's motivation was inexplicably sanctioned by the PTAB in 2015, and presumably by then Director Lee, as appropriate since "Profit is at the heart of nearly every patent and nearly every inter partes review. As such, an economic motive for challenging a patent claim does not itself raise abuse of process issues."¹³

In another exemplary incident, following a jury verdict of nearly \$2B in favor of VLSI and against Intel, two entities with no interest in the patent case filed IPRs challenging the validity of the VLSI patent that had been litigated, their purpose being to extort money from one or both of the parties. *OpenSky Industries LLC et al. v. VLSI Technology LLC*, IPR 2021-01064. Intel, the losing party in the litigation, saw this IPR filing as a second opportunity to attack the validity of the VLSI patent in the PTAB, and filed a joinder request under Section 315(c), which the Director granted even though she dismissed to initial petition as improperly filed.¹⁴ In the Open Sky LLC case, the predatory filing of an unwarranted IPR petition was done primarily for the purpose of extorting

¹¹ Dr. Bowman Heiden, a professor of intellectual property economics at UC Berkeley, has used the analogy to the parable of David and Goliath, insightfully pointing out that in their matchup, Goliath did not need to learn how to use a slingshot, but merely how to take David's away.

¹² Standing has been a fundamental requirement for the initiation of litigation since the outset of the American judicial system. In part, the requirement exists because Article III specifies that courts are limited to the resolution of disputes between parties with something personal at stake. *E.g.*, *DaimlerChrysler Corp v. Cuno*, 547 U.S. 332, 341 (2006) ("No principle is more fundamental to the judiciary's proper role in our system of government than the constitutional limitation of federal-court jurisdiction to actual cases or controversies").

¹³ See, e.g., <https://www.businessinsider.com/no-sanctions-for-kyle-bass-ipr-2015-9> (Quoting PTAB "We take no position on the merits of short-selling as an investment strategy other than it is legal, and regulated.")

¹⁴ See, <https://www.ptablitigationblog.com/director-vidal-removes-opensky-and-pqa-from-vlsi-iprs-orders-sanctions>.

money from which ever of the litigants would pay for it. The Director imposed sanctions on the petitioner, but nevertheless allowed the IPR to go forward with Intel now as the lead petitioner.¹⁵ And, of course, the PTAB ultimately found the patent invalid.

Perhaps the most destructive example is that of Unified Patents and other bounty hunters that file IPR petitions challenging issued patents claiming to be the only Real Party in Interest (RPI). These filing are intended to allow the entity that pays for the IPR (and the actual RPI) to remain in the shadows, so that if the challenge is unsuccessful the RPI can avoid the estoppel effect of Section 315(e) in a subsequent challenge in district court or before the PTAB. The Unified Patents website states that “Unified is the ONLY entity that DETERS abusive NPEs (aka Patent Trolls) and NEVER pays.” <https://www.unifiedpatents.com>. The site does not tell us what a “troll” is, but even a cursory look at Unified’s actual behavior suggests that the term refers to any entity asserting or about to assert a patent against one or more of Unified’s well-financed contributors. The recent petition by Unified Patents against Dolby Laboratories, LLC (IPR 2021-00275), one of America’s most creative and innovative companies, is exemplary. One of Dolby’s patents was challenged by Unified and instituted by the previous Director, Kathy Vidal. Dolby won the PTAB trial as to all challenged claims and asked the PTO to require Unified to comply with § 312(a)(2) and identify the real parties behind the petitions. Dolby needed the information, because the estoppel provisions apply – in addition to the actual petitioner – to all Real Parties in Interest and their privies (§ 315(e)(1)). The Director refused to require such disclosure, because Dolby had been successful in defeating the petitioner, ignoring Dolby’s statutory right to know the identities of the RPIs.¹⁶

Proposed Rule 42.108(d) will require a petitioner, in the interest of efficient use of resources, to stipulate that if a PTAB trial is instituted, neither petitioner nor any real party in interest or privy will subsequently challenge validity under Section 102 or Section 103 in the PTAB or any other tribunal. USIJ fully supports this rule, with the cautionary observation that it necessarily means that any petitioner that has not itself been accused of infringement, either directly or indirectly, must be forthcoming and identify other entities that are covering the cost of the petition and trial, with the patent owner given ample discovery to explore the RPI issue in detail.

E. Conclusion

USIJ respectfully urges prompt adoption of the modest changes set forth in the NPRM that will go a long way toward aligning the actual procedures for IPRs with the congressional expectations at the time of the AIA. None of the changes to 42 C.F.R. §108 will eliminate the proper use of IPRs, nor will they prevent proper challenges to patent validity in Federal Court or by *ex parte* reexamination. The changes merely prevent multiple attacks on the same patent claim, which have had the long-term impact of making patents essentially irrelevant to a large number of startups and entrepreneurs and their venture capital investors.

¹⁵ See, “4 Takeaways From OpenSky’s PTAB Sanctions,” <https://www.sterneckessler.com/news-insights/news/4-takeaways-openskys-ptab-sanctions>

¹⁶ See, <https://www.knobbbe.com/updates/federal-circuit-review-june-2025>; Federal Circuit Order dated 9.23.25 in *Dolby Laboratories v. Unified Patents and USPTO*, Dkt. No. 2023-2110, denying rehearing en banc.