

## PTAB/USPTO Update - April 2025

APRIL 7, 2025

### *USPTO Leadership*

- On March 10, John Squires was officially [nominated](#) to be Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.
- [Valencia Martin Wallace](#) will serve as the Acting Commissioner for Patents. See Delegation of Authority, 1532 OG 119 (March 4, 2025).
- [William Covey](#) will serve as the Acting Deputy Under Secretary of Commerce for Intellectual Property and Acting Deputy Director of the United States Patent and Trademark Office. See Delegation of Authority, 1532 OF 357 (March 18, 2025).
- [Dan Vavonese](#) will serve as the Acting Commissioner for Trademarks.

### *USPTO News*

- On March 27, the USPTO [announced](#) that it would add ID.me as a verification option for logging into [Patent Center](#). More information is available on the USPTO's [getting started](#) page.
- On March 26, Acting Under Secretary of Commerce for Intellectual Property and Acting Director of the United States Patent and Trademark Office Coke Morgan Stewart sent a [memorandum](#) to all Patent Trial and Appeal Board (PTAB) Judges regarding a new [Interim Processes for PTAB Workload Management](#). Under the new process, “decisions on whether to institute an IPR or PGR will be bifurcated between (i) discretionary considerations and (ii) merits and other non-discretionary statutory considerations.” The discretionary considerations phase will proceed as follows:
  - Patent Owner may file a 14,000-word brief addressing discretionary denial issues within two months of the Notice of Filing Date Accorded.
  - Petitioner may file a 14,000-word opposition brief addressing the same issues within one month of Patent Owner’s brief.
  - Additional briefing may be authorized for good cause (5,600 words per Reply brief).
  - The Director, with consultation of at least three PTAB judges, will issue a determination whether to discretionarily deny the petition. The determination will consider discretionary factors articulated under the precedential [Fintiv](#), [General](#)

*Plastic*, and *Advanced Bionics* decisions; considerations in the [Consolidated Trial Practice Guide](#); as well as other factors articulated in the memorandum, including:

- “Whether the PT AB or another forum has already adjudicated the validity or patentability of the challenged patent claims;
  - Whether there have been changes in the law or new judicial precedent issued since issuance of the claims that may affect patentability;
  - The strength of the unpatentability challenge;
  - The extent of the petition’s reliance on expert testimony;
  - Settled expectations of the parties, such as the length of time the claims have been in force;
  - Compelling economic, public health, or national security interests; and
  - Any other considerations bearing on the Director’s discretion.”
- If institution is not denied for discretionary reasons, the Director will refer the matter to a three-judge panel for consideration on the merits.
- The USPTO is [seeking nominations](#) for its [Patent Public Advisory Committee \(PPAC\)](#) and [Trademark Public Advisory Committee \(TPAC\)](#). On March 18, Secretary of Commerce Howard Lutnick terminated all prior appointments to the PPAC and TPAC.
  - The [First-Time Filer Expedited Examination Pilot Program](#) expired [as scheduled](#) on March 11.
  - On March 7, the USPTO [announced](#) that effective March 14, all Patent Trial and Appeal Board (PTAB) judges will appear from PTAB [hearing](#) rooms at USPTO offices for virtual hearings, absent special circumstances.
  - On March 7, the USPTO [announced](#) that it redesigned the [Patents Dashboard](#) based on public feedback, including by adding more data on patent filings.
  - On March 4, the USPTO [announced](#) the regional winners from the 2025 [National Patent Application Drafting Competition](#).
  - The USPTO will be hosting a four-day [Stakeholder Training on Examination Practice and Procedure \(STEPP\)](#) course from April 22-25.

### ***General Notices***

- [Relief Available to Patent and Trademark Applicants, Patentees, Reexamination Parties, and Registered Trademark Owners Affected by the Wildfires in California](#), 1532 OG 351 (March 18, 2025) (deeming “the effects of the wildfires in California beginning on January 7, 2025, to be an ‘extraordinary situation’ within the meaning of 37 CFR 1.183, 2.146(a)(5), and 2.148 for affected patent and trademark applicants, patentees, reexamination parties, and registered trademark owners” and providing corresponding relief)

### ***Final Rules***

- There are no new final rules.

### ***Interim Rules***

- There are no new interim rules.

### ***Proposed Rules***

- There are no new proposed rules.

### ***Legislation***

- On March 24, Sens. Richard J. Durbin, Thomas Tillis, Chuck Grassley, Christopher A. Coons, and Peter Welch introduced the [Interagency Patent Coordination and Improvement Act of 2025](#) “[t]o amend title 35, United States Code, to establish an interagency task force between the United States Patent and Trademark Office and the Food and Drug Administration for purposes of sharing information and providing technical assistance with respect to patents, and for other purposes.”
- On March 13, Sens. John Cornyn, Richard Blumenthal, Chuck Grassley, and Richard Durbin introduced the [Affordable Prescriptions for Patients Act](#) “[t]o amend title 35, United States Code, to address the infringement of patents that claim biological products, and for other purposes.

### ***PTAB Decisions***

- *New Precedential PTAB Decisions*
  - [Cambridge Mobile Telematics, Inc. v. Sfara, Inc.](#), IPR2024-00952, Paper 12 (December 13, 2024) (designated precedential: March 20, 2025) (determining that a petitioner seeking to construe a term as means-plus-function term in district court but not in an *inter partes* review should, at a minimum, explain why the different constructions are justified).
- *New Informative PTAB Decisions*
  - There are no new informative PTAB decisions
- *New Director Review Decisions*
  - *Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, IPR2024-01206, IPR2024-01207 & IPR2024-01208
    - Decisions subject to Director review – [Paper 11](#) (February 13, 2025) [Decision Granting Institution citing to Interim Procedure For Discretionary Denials In AIA Post-Grant Proceedings With Parallel District Court Litigation, issued June 21, 2022], [Paper 11](#) (February 13, 2025) (same), [Paper 11](#) (February 13, 2025) (same), [Paper 11](#) (February 13, 2025) (same).
    - Order Granting Director Review, Vacating the Decision Granting Institution, and Denying Institution of Inter Partes Review – [Paper 19](#) (Stewart March 28, 2025) [determining that institution of inter partes review should be discretionarily denied under the *Fintiv* framework and that “[t]he Board’s analysis of factors 3 and 4, and

overall weighing of the *Fintiv* factors was erroneous” for failing to “give enough weight to the investment in the parallel proceeding and giv[ing] too much weight to Petitioner’s *Sotera* stipulation.” “[B]y the time Patent Owner filed its Preliminary Response ... the parties had served extensive infringement and invalidity contentions, served opening and rebuttal expert reports, filed claim construction briefs, and conducted several depositions” and “[t]he court also had held a claim construction hearing and construed the disputed claim terms.”].

- *Mercedes-Benz USA, LLC v. Daedalus Prime LLC*, IPR2023-01343
  - Decision subject to Director review – [Paper 21](#) (January 7, 2025) [Final Written Decision Determining No Challenged Claims Unpatentable].
  - Order Granting Director Review, Delegating Director Review to a Delegated Rehearing Panel – [Paper 24](#) (Stewart March 25, 2025) [delegating Director review to Delegated Rehearing Panel to “determine whether the Board: (1) misapprehended or overlooked Petitioner’s claim construction arguments ... and erred in construing the term, and (2) misapprehended or overlooked [a reference’s] disclosure in finding that [it] does not teach” two claim limitations.].
  - Order, Delegated Rehearing Panel Identification – [Paper 25](#) (March 27, 2025) [designating Chief Administrative Patent Judge Scott R. Boalick, Deputy Chief Administrative Patent Judge Jacqueline Wright Bonilla, and Vice Chief Administrative Patent Judge Michael P. Tierney to Delegated Rehearing Panel].
- *Cisco Systems, Inc. v. Portsmouth Network Corp.*, IPR2024-00954
  - Decision subject to Director review – [Paper 7](#) (December 13, 2024) [Decision Denying Institution of *Inter Partes* Review].
  - Order Granting Director Review, Delegating Director Review to a Delegated Rehearing Panel – [Paper 9](#) (Stewart March 13, 2025) [delegating Director review to Delegated Rehearing Panel to “determine: (1) whether the Board engaged in an implicit claim construction of [a] claim limitation ... and if so, whether that construction was correct; and (2) whether the Board properly considered Petitioner’s argument that [a prior art reference] reads on [that] limitation.”].
  - Order, Delegated Rehearing Panel Identification – [Paper 10](#) (March 18, 2025) [designating Chief Administrative Patent Judge Scott R. Boalick, Deputy Chief Administrative Patent Judge Jacqueline Wright Bonilla, and Vice Chief Administrative Patent Judge Michael W. Kim to Delegated Rehearing Panel].
- *Tesla, Inc. v. Autonomous Devices, LLC*, IPR2023-01055
  - Decision subject to Director review – [Paper 47](#) (December 12, 2024) [Final Written Decision Determining All Challenged Claims Unpatentable Granting-in-Part and Denying-in-Part Patent Owner’s Motion to Amend].
  - Decision Granting Director Review, Remanding for Further Proceedings – [Paper 49](#) (Stewart March 13, 2025) [remanding for the Board to “explain more fully its

findings as to claim 12 and proposed substitute claim 21.”].

- *Crusoe Energy Systems, LLC v. Upstream Data Inc.*, PGR2023-00039
  - Decision subject to Director review – [Paper 45](#) (January 21, 2025) [Final Written Decision Determining Some Challenged Claims Unpatentable].
  - Order Initiating *Sua Sponte* Director Review – [Paper 46](#) (Stewart March 7, 2025) [Ordering *sua sponte* director review to “address the Board’s determination that claims 1 and 24 are unpatentable under § 101.”].
  - Order Delegating Director Review to a Delegated Rehearing Panel – [Paper 47](#) (Stewart March 13, 2025)
  - Order, Delegated Rehearing Panel Identification – [Paper 48](#) (March 27, 2025) [designating Deputy Chief Administrative Patent Judge Jacqueline Wright Bonilla, Vice Chief Administrative Patent Judge Michael P. Tierney, and Vice Chief Administrative Patent Judge Michael W. Kim to Delegated Rehearing Panel].
- *Siemens Mobility, Inc. v. Metrom Rail, LLC*, IPR2024-00947
  - Decision subject to Director review – [Paper 12](#) (November 19, 2024) [Decision Denying Institution of *Inter Partes* Review].
  - Order Delegating Director Review to a Delegated Rehearing Panel – [Paper 14](#) (Stewart March 6, 2025) [delegating Director review to Delegated Rehearing Panel to determine: (1) whether a reference appearing only in an Examiner’s search history is deemed previously presented art under 35 U.S.C. § 325(d)...; and (2) whether [a prior art reference] is substantially the same as [another], and, if not, whether the same or substantially the same obviousness arguments were previously presented to the Office....].

### ***USPTO Employees***

- The deadline for USPTO employees (which excludes patent and trademark examiners) to accept early retirement offers is April 17. USPTO leadership have indicated that staff reductions will follow, including for PTAB Administrative Patent Judges.

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