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EXECUTIVE SERIES:
INTELLECTUAL PROPERTY



An Ever Evolving USPTO — Updates and Insights

Presented by:
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Insights into the New USPTO's Philosophy on IP

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The New Head of the USPTO: John Squires

Trump nominates ex-Goldman Sachs lawyer to head US patent agency

By Blake Brittain

March 11, 2025 3:47 PM EDT - Updated March 11, 2025



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The Squires' Team

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Deputy Under Director: Coke Stewart



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Upcoming IPW Programs PTAB LIVE AI Patent Masters Life Sciences Women's IP Forum Industry Events

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Trump Names Coke Stewart Acting Director of the USPTO

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JANUARY 20, 2025, 12:01 PM 11

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Stewart: Bifurcated Responsibility of IPR Institution Decisions

First, 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. Under this interim procedure, the Director, in consultation with at least three PTAB judges, will determine whether discretionary denial of institution is appropriate. If it is appropriate, the Director will issue a decision denying institution. If it is not appropriate, the Director will issue a decision regarding that determination and refer the petition to a three-member panel of the PTAB assigned according to Standard Operating Procedure (SOP) 1 (Rev. 16). The three-member panel will then handle the case in the normal course including by issuing a decision on institution addressing the merits and other non-discretionary statutory considerations.

More on this later!



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Stewart: “Settled Expectations” Factor in Patentability



USPTO Acting Director Denies IPR Institution Based on “Settled Expectations”

JUNE 2025 | COMMENTARY

In Short

The Situation: Under a new U.S. Patent and Trademark Office (“USPTO”) policy issued in March 2025, pre-institution *inter partes* review (“IPR”) proceedings are now bifurcated, consisting of a first phase in which the director considers discretionary bases to deny institution, before a second phase where the merits of the case are potentially considered.

The Result: In two recent decisions (*Rhythm* and *Dabico*), the USPTO acting director for the first time discretionarily denied institution based on the “settled expectations” of the parties, in view of the time the challenged patents had been in force and the petitioners’ knowledge of the patents.

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Apple v. Squires: (nearly) Absolute Discretion

- *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, 2020 WL 2126495 (P.T.A.B. Mar. 20, 2020) (“*Fintiv*” factors created)
 - (1) whether a stay exists in the parallel litigation or would likely be granted if a proceeding is instituted;
 - (2) proximity of the court’s trial date to the PTAB’s projected statutory deadline for resolution of the post-grant proceeding;
 - (3) investment in the parallel proceedings by the court and parties;
 - (4) overlap between issues raised in the petition and in the parallel litigation;
 - (5) whether the petitioner and the defendant in the parallel litigation are the same party; and
 - (6) other circumstances that impact the PTAB’s exercise of discretion, including the merits.
- Suit under the Administrative Procedure Act (“APA”) to prohibit the PTAB from applying *Fintiv* factors in the absence of notice-and-comment rulemaking, as well as because they exceeded the Director’s statutory authority.
- Ruling that notice-and-comment rulemaking will not be required for any “instructions” to the PTAB for making institution decisions.
- Director has unbounded discretion (short of some Constitutional infirmity) to reject institution.



**Apple Inc. v. Squires (Fed. Cir. 2026) (decision Feb. 13, 2026)*

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Wild Card: Secretary Lutnick

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Secretary Lutnick on “Patent Tax”

Commerce Department and U.S. Patent and Trademark Office Exploring a Patent Tax and Patent Fee Changes

By Holly Fechner, Matthew Shapanka & Samuel Klein on September 30, 2025

POSTED IN INTELLECTUAL PROPERTY PROTECTION, PATENT, POLICY AND LEGISLATION, UNITED STATES



The Trump Administration is considering multiple proposals to raise revenue from patent holders, including direct assessments on patent holders, changes to the existing patent fee schedule, and potentially a new mechanism for sharing profits from university-owned patents obtained through federal research funds.

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Is a Patent Tax Forthcoming?

Second, USPTO Deputy Director Coke Morgan Stewart (then the Acting Director) signaled that the Commerce Department is moving forward with updates to the schedule of patent fees, [stating](#) at the annual meeting of the Intellectual Property Owners Association in September that there is a “disconnect” between patent fees and the value of certain patents—echoing [similar statements](#) from Lutnick.



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Squires: Reigning in §101

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Bilski Brief: Reigning in §101 Challenges

2007-1130
(Serial No. 08/833,892)

United States Court of Appeals
for the
Federal Circuit

IN RE BERNARD L. BILSKI and RAND A. WARSAW

Appeal from the United States Patent and Trademark Office,
Board of Patent Appeals and Interferences

BRIEF OF *AMICUS CURIAE* REGULATORY DATACORP, INC.
IN SUPPORT OF NEITHER PARTY

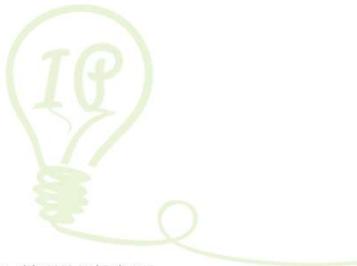
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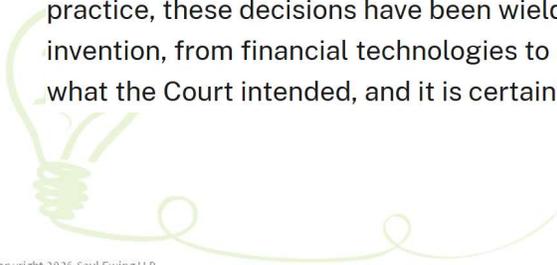
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Statements to Senate Subcommittee: Frustration Over § 101 Law

The Supreme Court's later decisions in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*[7] and *Alice Corp. v. CLS Bank International*[8] have been widely misinterpreted. Properly read, they do not narrow eligibility beyond the established judicial exceptions — laws of nature, natural phenomena, and abstract ideas. Yet in practice, these decisions have been wielded as bludgeons to exclude entire classes of invention, from financial technologies to artificial intelligence to diagnostics. That is not what the Court intended, and it is certainly not what Congress ever authorized.



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Statements to Senate Subcommittee: Signaling Expansive § 101 Approach

Patentable subject matter was once summarized as “*anything under the sun made by man.*”[10] Save for perpetual motion machines and the judicial exceptions, the principle was broad, clear, and inclusive. That principle should remain the guiding star today.



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Statements to Senate Subcommittee: Role of USPTO in Stimulating Economy

The USPTO is not just an administrative agency; we are the Department of Commerce’s Central Bank of Innovation. Every piece of IP we put into circulation is a potential job, a new business, a competitive advantage, or an investible asset. And yet another win for both society and the Constitutional foresight of our Founders.



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Squires: Patentable Subject Matter

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Statements to Senate Subcommittee: Signaling Crypto and AI Patentability

As I said then, “The onrush of technology knows no bounds. From crypto and AI to quantum computing and diagnostics, these are applied, patent-eligible technologies driving the frontiers of knowledge.” I want inventors and entrepreneurs to know: the USPTO is open for business — not only for the technologies of today, but especially for those of tomorrow.



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Statements to Senate Subcommittee: Signaling AI Patentability

The decision emphasized a critical point: the proper statutory tools for limiting the scope of patents are §§ 102 (novelty), 103 (obviousness), and 112 (written description and enablement). Section 101 should not be misused as a blunt instrument to exclude entire technological fields. To do so risks disqualifying exactly the kinds of advances America needs most — advances in artificial intelligence, biotechnology, and data science. Artificial intelligence in particular illustrates the stakes: without reliable patent protection, AI start-ups cannot secure the venture capital needed to compete against state-backed giants in China and elsewhere. Eligibility is the difference between an ecosystem of American innovators and a future where leadership in AI is ceded abroad.

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Statements to Senate Subcommittee: Signaling AI, Quantum Computing, Clean Energy, and Advanced Materials Focus

Geopolitically, leadership in innovation translates directly into leadership on the world stage. Nations that dominate in emerging technologies wield not just economic power, but diplomatic and military leverage. Artificial intelligence, quantum computing, clean energy, advanced materials — these are the arenas in which the next century's balance of power will be determined.

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But... Reversion to Standard System for “Green” Technology



USPTO formally terminates Climate



USPTO formally terminates Climate Change Mitigation Pilot Program

Published on: 04/17/2025 10:45 AM

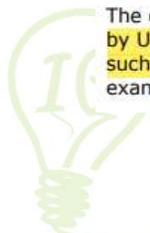
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Hope for AI Patent Applicants

In a **ruling** issued on Dec. 31, the PTAB faulted an examiner's finding that an application by AI company 6Sense Insights Inc. seeking a patent on methods of using AI to orchestrate sales and marketing covered nothing more than an abstract idea. **The board instead found that the invention was a patent-eligible improvement in training AI models.**



The decision, known as **Ex parte Carmody** after one of the inventors, **cited a September ruling by U.S. Patent and Trademark Office Director John Squires and other agency officials holding that such improvements can make AI inventions eligible for patents.** The director's **decision** warned examiners against equating AI with algorithms applied on generic computers.

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Legislative Activity

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Pending Legislation: Promoting and Respecting Economically Vital American Innovation Leadership (PREVAIL) Act

- Aims to bring PTAB procedures in line with those of District Courts.
- Aims to reduce potential overlap between proceedings in both forums.
 - Adds standing requirement to bring an *inter partes* review (IPR) or post-grant review (PGR) petition.
 - Imposes presumption of validity and requiring a showing of invalidity by “clear and convincing” evidence.
- Precludes defendants in District Court proceedings and respondents in ITC proceedings from later bringing IPR challenges at the PTAB.
- Attaches estoppel upon the filing of an IPR or PGR petition.
- Limits multiple challenges against the same patent.



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Pending Legislation:

Patent Eligibility Restoration Act (PERA)

- Aims to restore clarity, predictability, and competitiveness to U.S. patent system
- Aims to amend 35 U.S.C. § 101:
 - Eliminate Supreme Court-mandated judicial exceptions (e.g., Alice/Mayo tests), such as “abstract ideas” or “laws of nature”.
 - Introduce five specific statutory exclusions, restoring patent eligibility to diagnostics, software, and AI inventions:
 - 1) mathematical formulas not part of a useful invention,
 - 2) mental processes,
 - 3) non-technical processes,
 - 4) unmodified human genes, and
 - 5) unmodified natural materials.
- Processes that cannot be practically performed without machine or manufacture are eligible.



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Updates and Changes at the USPTO: Patent Prosecution Considerations

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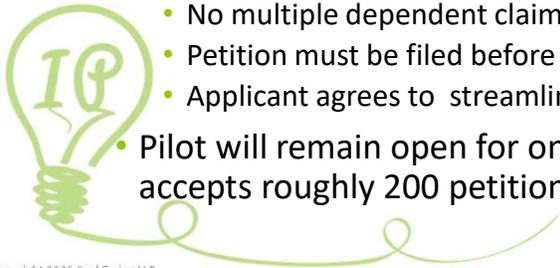
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Improving Examination Efficiency & Reducing Pendency Times

Streamlined Claim Set Pilot Program

- Applicant petitions to have applications “made special,” expediting prosecution towards issuance of a first Office Action.
- Requirements:
 - Noncontinuing original utility nonprovisional filed before October 27, 2025;
 - Only one independent claim and 10 total claims;
 - No multiple dependent claims;
 - Petition must be filed before the first Office Action;
 - Applicant agrees to streamlined claim limits throughout prosecution.
- Pilot will remain open for one year or until each technology center accepts roughly 200 petitions, whichever comes first.



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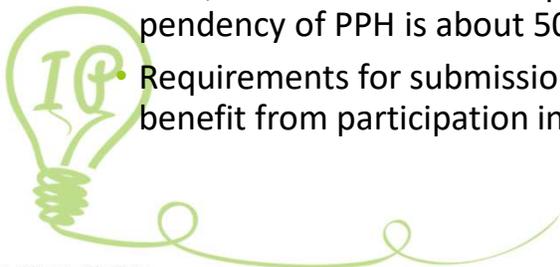
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Improving Examination Efficiency & Reducing Pendency Times

PPH Acceleration Program

- Fast-track US examination based on allowable claims from corresponding foreign application.
- Historically, average first-Action pendency of about 7.5 months, vs. >22 months for non-PPH applications.
- Now, examination of PPH applications is docketed so that first-Action pendency of PPH is about 50% of non-PPH applications.
- Requirements for submission to PPH still same, but smaller timewise benefit from participation in program.



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Improving Examination Efficiency & Reducing Pendency Times

"Historical" Programs

- **Track I program:**

- Pay additional fee of \$903 / \$1,806 / \$ 4,515.
- Original non-provisional utility application filed under 35 U.S.C. 111(a), national stage entry under 35 U.S.C. 371, and/or filed with RCE.
- Four or less independent claims, thirty or less total claims, no multiple dependent claims.
- Request for an extension of time causes Track I status discontinued.
- Resolution (Final Action / Notice of Allowance) expected within 12 months.



- **Petition to Make Special:**

- Inventor over the age of 65 or in poor health.

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Updates and Changes in the Law: Selected upcoming cases

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Supreme Court

Hikma Pharmaceuticals USA Inc. v. Amarin Pharma, Inc. (No. 24-889)

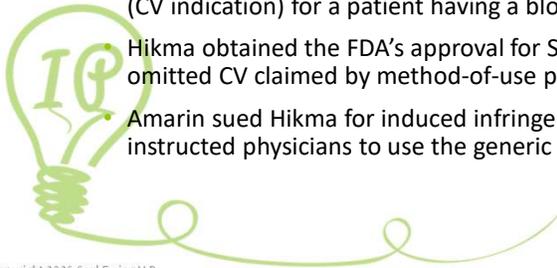
- “Skinny Label” (or Section viii carve-out): FDA-approved drug label for generic product that “carves out” patented, branded-drug indications.
- Under Hatch-Waxman Act; allows for generic, lower-cost alternatives to enter the market for non-patented uses, before all patents on a drug expire.

Selected Facts

- Amarin’s Vascepa (icosapent ethyl) is approved for treating severe hypertriglyceridemia (SH indication) with a blood triglyceride at least 500 mg/dL and cardiovascular risk reduction (CV indication) for a patient having a blood triglyceride at least 150 mg/dL.

Hikma obtained the FDA’s approval for SH and launched its generic product with a carveout that omitted CV claimed by method-of-use patents to Amarin.

- Amarin sued Hikma for induced infringement, arguing that Hikma’s label and public statements instructed physicians to use the generic product for the patented indication.



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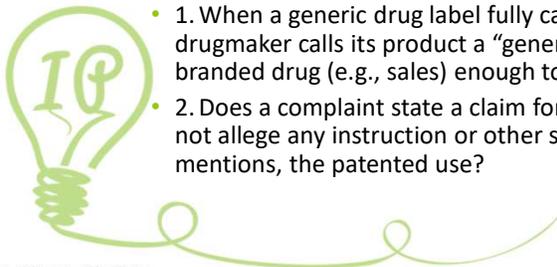
Supreme Court

Hikma Pharmaceuticals USA Inc. v. Amarin Pharma, Inc. (No. 24-889)

Selected Facts

- DC Delaware (2022): Dismissal at pleadings stage.
- Federal Circuit (2024): Reversed even if the skinny label alone may not encourage any infringing use for the patented CV indication, inducement was plausibly pled when the label was evaluated alongside the alleged nonlabelled materials, allowing the case to proceed.
- SC: Petition granted Jan 16, 2026

1. When a generic drug label fully carves out a patented use, are allegations that the generic drugmaker calls its product a “generic version” and cites public information about the branded drug (e.g., sales) enough to plead induced infringement of the patented use?
2. Does a complaint state a claim for induced infringement of a patented method if it does not allege any instruction or other statement by the defendant that encourages, or even mentions, the patented use?



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Appealed to Supreme Court

***Agilent Technologies, Inc. v. Synthego Corp.*, No. 25-570, 139 F.4th 1319**

- Technology relates to modified guide RNAs used in CRISPR-Cas9 gene editing, but question before Court relates to burden of proving enablement of prior art references.

Selected Facts

- Synthego challenged Agilent's patents at PTAB as allegedly being anticipated by a patent application to Pioneer Hybrid:
 - The Pioneer Hybrid patent application had been abandoned, recited only purely prophetic examples, and (according to Agilent) majority of examples simply did not work.
 - But: *Rasmusson v. SmithKline Beecham Corp.*, 413 F.3d 1318 (Fed. Cir. 2005): "proof of efficacy is not required" for a reference to anticipate.
 - PTAB/Fed. Cir.: Agilent's patents are invalid in view of Pioneer Hybrid patent applications.

Agilent's argument:

- Earlier printed publications used to challenge patent are improperly presumed to be enabling.
- Burden is improperly shifted to patent owner to prove that earlier printed publication is **not** enabling.
- *Rasmusson* decision should be vacated or narrowed.



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Federal Circuit

***Verizon Connect Inc. v. Omega Patents, LLC*, No. 25-1994**

Federal Circuit will hear challenge to a newly instituted USPTO policy.

Selected Facts

- Verizon challenged validity of Omega Patents' vehicle tracking patent at PTAB.
- PTAB found patent to be invalid.
- USPTO deputy director Coke Morgan Stewart vacated PTAB's final decision and terminated case:
 - Patent had previously been challenged seven times.
 - PTAB review was not efficient use of resources and should not have been instituted.
- Verizon filed appeal to Federal Circuit.
- USPTO asked Federal Circuit to dismiss appeal:
 - USPTO's vacate order was a decision on whether to institute review, which is unappealable.
- Verizon stated that USPTO adopted unlawful position:
 - Once a review is instituted, a final decision must be issued.
 - USPTO is effectively shielding itself from review by the Court.



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Updates and Changes at the USPTO: *Inter Partes* Reviews

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Discretionary Denials: Precedential

January 22, 2026

USPTO Designates New Precedents on PTAB Discretionary Denial

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 Matthew Johnson

 Carl Kukkonen III

On January 9, 2026, USPTO Director John A. Squires designated four recent discretionary-denial rulings as precedential and nine more as informative, formalizing a developing framework for how and when the Office will exercise discretion to institute AIA trials. The designations crystallize themes

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Discretionary Denials: Supported by Fed. Cir.



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Fed. Circ. Snubs Google's 'Settled Expectations' Challenge

By **Theresa Schliep**

Law360 (January 27, 2026, 1:36 PM EST) -- The Federal Circuit on Tuesday turned down Google's challenge to the U.S. Patent and Trademark Office's policy of denying patent reviews based on the owner's "settled expectations," marking the latest failed case disputing the agency's changes to the Patent Trial and Appeal Board.



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Discretionary Denials: Non-Exhaustive Considerations

- Whether the PTAB 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
- Any other considerations bearing on the Director's discretion



90 FR 48335

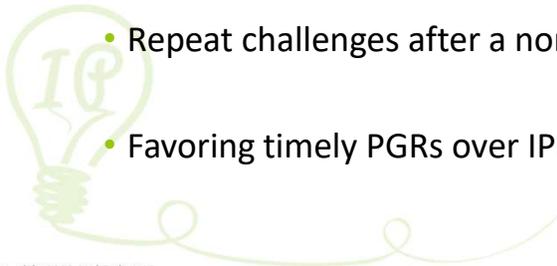
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Discretionary Denials: Four Recurring Scenarios

- Joinder “copycat” petitions.
- One-year time-bar fairness (will only proceed in “exceptional circumstances”).
- Repeat challenges after a non-instituted PGR.
- Favoring timely PGRs over IPRs for newly issued patents .



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Discretionary Denials: Settled Expectations

- Strongest predictor of discretionary denial.
- Context-dependent.
 - Younger patents typically lack strong-settled expectations.
- Well-supported showing can overcome age-based expectations (*e.g.*, asserted against a different type of product).
- New claims not previously at issue will favor institution.



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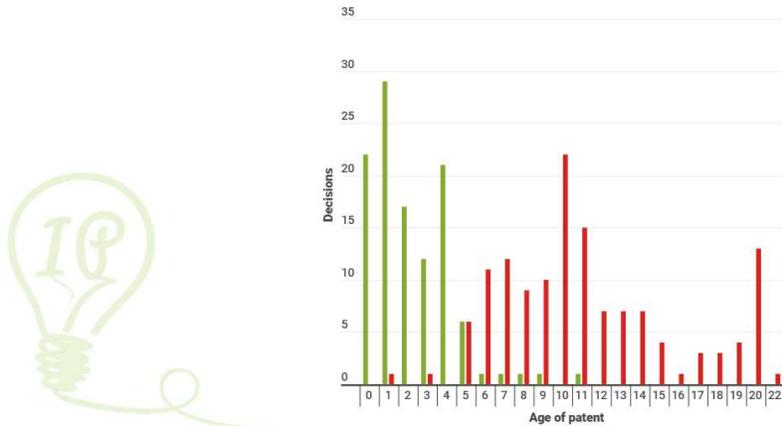
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Discretionary Denials: Length of Time for Settled Expectations

As of August 2025, IPRs generally denied for patents older than 6 years

Outcome of settled expectations v discretionary denial decisions (6 June to 22 August 22)



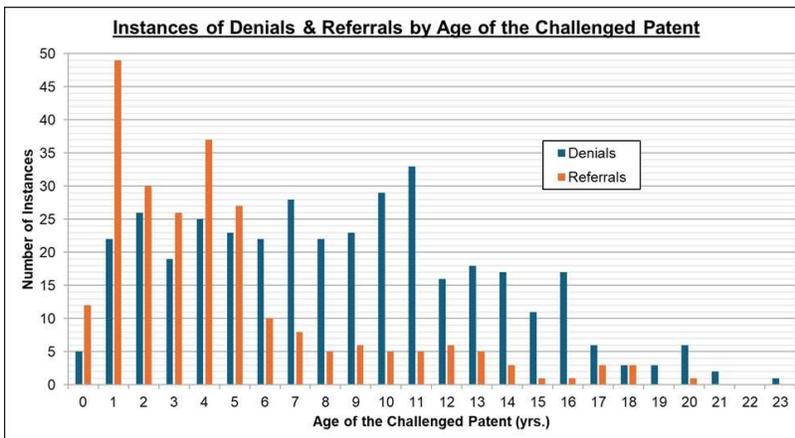
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Discretionary Denials: The Data

Instances of Denials & Referrals by Age of the Challenged Patent



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Discretionary Denials: The Data

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A Seismic Shift at the USPTO: What Happened in 2025

The institution rate for IPRs, about 68% in 2024, dropped to less than 40%. As of November, the rate of granting discretionary denial was over 60%. This is a near reversal of the institution rate from just a year ago. The institution statistics are updated on a regular basis at the excellent Bunsow De Mory “Dig Deeper” [website](#).

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Discretionary Denials: The Data

- 61% denial rate for USPTO, majority of which were discretionary.
- Institution rate 50%, 5-year low.

All Cases: Denial Rate (61%)

Denials	243
Referrals	377

Institution rates by petition

FY 21 to FY 25: Oct. 1, 2020 to Sep. 30, 2025

Fiscal Year	Instituted	Denied	DSCO Denied	Institution Rate (%)
FY 21	702	504	0	58%
FY 22	769	398	0	66%
FY 23	752	375	0	67%
FY 24	740	347	0	68%
FY 25 YTD	620	315	304	50%

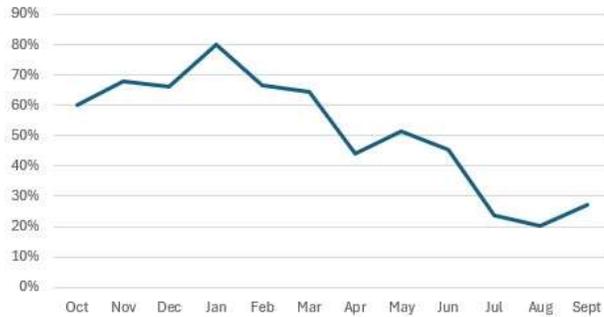
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Discretionary Denials: The Data



2025 Institution Rates By Month



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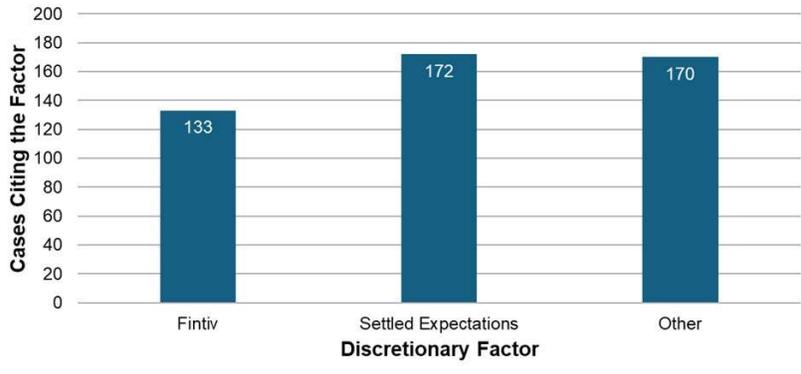
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Discretionary Denials: The Data



Discretionary Factors Favorable to Petitioners in Cases Avoiding Discretionary Denial

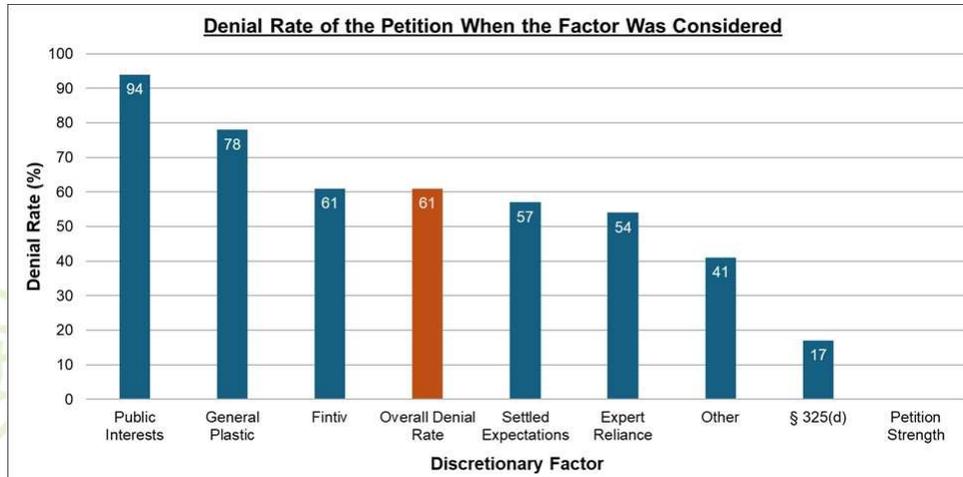


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Discretionary Denials: The Data



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Proposal: New Rules Not to Challenge §§ 102/103 in Parallel Proceedings



USPTO advances proposed rule governing inter partes review

Published on: 10/16/2025 9:37 AM

- Require an IPR petitioner to file a stipulation not to pursue invalidity challenges under 35 U.S.C. §§ 102 or 103 in other forums;
- Provide that the USPTO will not institute an IPR when the USPTO or another forum already has adjudicated patentability or validity of the claims;
- Provide that the USPTO will not institute an IPR when another proceeding is likely to determine patentability or validity of the claims under §§ 102 or 103 first; and
- Permit the USPTO to institute an IPR notwithstanding a prior adjudication or expected earlier determination on patentability or validity when exceptional circumstances exist.

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Pushback on New USPTO Policies

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Town Halls and Special Interest Groups

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Squires Reluctantly Grants 15-Day Extension on Comments to Proposed IPR Practice Rule

EILEEN MCDERMOTT
NOVEMBER 6, 2025, 12:15 PM 5

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Town Halls and Special Interest Groups

December 18, 2025

The Public Has Spoken – Again: For a Second Time, Stakeholders Overwhelmingly Oppose Agency Proposals that Would Restrict Access to Inter Partes Review



97% of all comments—and 90% of unique comments—in response to the U.S. Patent and Trademark Office's (USPTO) Revision to Rules of Practice Before the Patent Trial and Appeal Board (PTAB) oppose the proposed changes.

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Town Halls and Special Interest Groups

Chipmaking industry pushes back on U.S. Patent Office considering imposing annual fee based on assessed value — “tax on innovation” draws strong opposition from Semiconductor Industry Association



News By Jowi Morales published November 8, 2025

The federal government wants a bigger slice of the semiconductor pie through patents.

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Mandamus Briefing on IPR Institution Decision Rules- Unsuccessful (for now)

Federal Circuit Limits Mandamus Relief for IPR Institution Decisions

By: [Kevin X. McGann](#) , [Johnson Kuncheria](#) , [Daniel Rabinowitz](#)

What You Need To Know

- The Federal Circuit reaffirmed that IPR institution denials are “final and nonappealable” under 35 U.S.C. §314(d), with mandamus relief only possible in rare cases involving colorable constitutional or specific statutory claims.

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Federal Circuit: AI Patent Eligibility

AI, Algorithms and Abstract Ideas: Federal Circuit Reinforces Limits in *Recentive v. Fox*

The Patent Playbook on **June 26, 2025**



In April, the Federal Circuit issued a significant patent law ruling involving artificial intelligence. In *Recentive Analytics, Inc. v. Fox Corp.*, the Court addressed a core question facing many AI-driven businesses: When are solutions applying machine learning to real-world problems inventive and patentable? The Federal Circuit affirmed the trial court’s dismissal of the underlying case at the pleading stage under § 101 and held that applying generic machine learning models to scheduling and programming tasks—without disclosing any technological advances to the underlying machine learning techniques—failed to meet the eligibility standards under 35 U.S.C. § 101.

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