December 2, 2025

Submitted via Regulations.gov

John A. Squires
Under Secretary of Commerce for Intellectual Property
Director, United States Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314

AUTM's Comments on the Revision to Rules of Practice Before the Patent Trial and Appeal Board (Docket No. PTO-P-2025-0025)

Dear Director Squires:

Please accept AUTM's comments on the USPTO's "Revision to Rules of Practice Before the Patent Trial and Appeal Board" (the "NPRM").

Introduction

AUTM is the non-profit leader in efforts to educate, promote, and inspire professionals to support the further development and deployment of innovations arising from academic research. Our community is comprised of more than 3,000 members who work in more than 800 universities, research centers, hospitals, businesses, and government organizations around the globe.

AUTM's membership has traditionally stemmed—and continues to draw primarily—from academic settings. AUTM members in such academic settings are focused on advancing early-stage inventions and other technologies to the marketplace, primarily through licensing and further development with partners (i.e., implementers). Between 2005 and 2024, our skilled professionals filed over 288,000 new patent applications for academic inventors and negotiated over 122,000 intellectual

property license agreements on behalf of U.S. universities and academic research institutions. About 70% of these licenses are to start-ups and small companies. One model estimates that technology transfer activities carried out by AUTM members over the past 30+ years contributed $2 trillion to the U.S. gross industry output.[1] In the pharmaceutical space, it is estimated that since the Bayh-Dole Act was signed into law in 1980, over 200 drugs and vaccines that originated from U.S. public research institutions were developed and approved by the FDA.[2] Many of these public-private partnerships involved university technologies.

As such, AUTM members are key players at the genesis of innovation, helping to translate early-stage inventions into new products and services through commercialization so that all Americans can benefit from them. We appreciate your consideration of AUTM's views on this important issue, as strong protections for intellectual property are critical to our technology transfer and commercialization activities, and the products and services that result from our activities have powerful and positive impacts on human lives, economic development, global competitiveness, and national security.

The Proposed Rules Will Improve Patent Reliability and Support Innovation.

AUTM strongly agrees with the USPTO's stated concern that "even extremely strong patents become unreliable when subject to serial or parallel challenges."[3] AUTM appreciates the NPRM's recognition that reliable patent rights are necessary to incentivize the investment required to bring new, patent-dependent products to market.[4] It follows that PTAB rules that improve patent reliability, such as the rules proposed in the NPRM, will result in more innovative products and services. This is because reliable patents reduce the inherent risk associated with the long, expensive, and sometimes unpredictable process of product testing and development.

Conversely, unreliable patent rights hinder innovation. When issued patent claims can be repeatedly attacked and reconsidered, investment in the underlying technology is more risky and

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[1] *Economic Contributions of University/Nonprofit Inventions in the United States 1996-2020*, Lori Pressman, Mark Planting, Carol Moylan and Jennifer Bond, available at https://autm.net/AUTM/media/About-Tech-Transfer/Documents/BIO-AUTM-Economic-Contributions-of-University-Nonprofit-Inventions_14JUN2022.pdf. This model is based on reported earned royalties and estimated domestically manufactured product sales.

[2] *The Role of Public-Sector Research in the Discovery of Drugs and Vaccines*, Stevens, A.J., Benson, D.E., Dodson, S.E. *et al.*, J Technol Transf 49, 857–867 (2024), available at https://www.nejm.org/doi/full/10.1056/NEJMsa1008268. See, for example, Table 1 (The Number of Drug Products Approved by the Food and Drug Administration and Originating from Public-Sector Research, According to Therapeutic Area, 1970–2009).

[3] *USPTO advances proposed rule governing PTAB inter partes review practices*, October 16, 2025, available at https://content.govdelivery.com/accounts/USPTO/bulletins/3f734cb.

[4] The NPRM states "These serial and parallel patentability challenges have undermined the reliability of patent rights and deterred investment in new technologies."

thus less likely to occur. Subjecting an issued U.S. patent—which has already been examined by the USPTO and deemed patentable—to repeated, additional challenges before the USPTO is analogous to attempting to saddle the horse after it has left the barn. At some point, industry partners should be able to rely on the statutory presumption of patent validity to attract investment and commercialize patented innovations. Repeatedly reopening validity disrupts the commercial certainty necessary to justify investment in new technologies and weakens confidence in the patent system.

AUTM urges the USPTO to adopt the proposed revisions to the PTAB rules of practice. As AUTM has previously noted, the current IPR system acts as a cloud over the title of issued patents because there are no meaningful limits on the total number of post-grant attacks that can be directed at a patent during its term.[5] USPTO data demonstrate the prevalence of parallel and serial PTAB challenges to issued patents. The revised rules will correct this persistent problem by requiring patent challengers to put forth their strongest arguments and to select the forum that is best situated to evaluate those arguments. For example, requiring an IPR petitioner to stipulate that it will not pursue invalidity challenges under 35 U.S.C. § 102 or 103 in other forums promotes efficiency by requiring the petitioner to identify its strongest § 102 or 103 arguments up front and present them to one forum—rather than repeatedly trying different arguments in front of different adjudicators.

The Proposed Rules Will Promote Efficiency and Patent Quality.

The revised rules will go a long way in making the PTAB what it was intended to be: a faster, less expensive, and reliable alternative to district court litigation to resolve certain questions of patent validity.[6] As the NPRM notes, the proposed rules will streamline the PTAB's work by preventing repetitive analyses of the same or similar patent challenges. This will allow the PTAB to focus on new, different challenges to patents, and it creates an opportunity to redirect resources in ways that address the current patent examination backlog (e.g., allowing PTAB judges more time to resolve ex parte appeals from examination).

[5] *AUTM's Comments on the USPTO's Notice of Proposed Rulemaking re Patent Trial and Appeal Board Rules of Practice for Briefing Discretionary Denial Issues, and Rules for 325(d) Considerations, Instituting Parallel and Serial Petitions, and Termination Due to Settlement Agreement (Docket No. PTO–P–2023–0048)*, June 17, 2024, available at https://autm.net/AUTM/media/About-Tech-Transfer/Documents/AUTM-Comments-on-Docket-No-PTO-P-2023-004.pdf.

[6] *AUTM's Comments in Response to the USPTO's Advance Notice of Proposed Rulemaking (ANPRM) Regarding Changes Under Consideration to Discretionary Institution Practices, Petition Word-Count Limits, and Settlement Practices for America Invents Act Trial Proceedings Before the Patent Trial and Appeal Board (Docket ID Number: PTO-P-20200022)*, June 20, 2023, available at https://autm.net/AUTM/media/About-Tech-Transfer/Documents/AUTM-Comments.pdf.

Moreover, curbing repetitive litigation will minimize waste and allow the USPTO to prioritize its efforts to issue higher-quality patents. Strengthening front-end efforts—such as examiner training and resource allocation—is a more effective way to enhance patent quality than repeatedly reexamining claims the USPTO has already examined and issued.

The Proposed Rules Will Strengthen National Security, Economic Growth, and Global Leadership.

In your statement before the Intellectual Property Subcommittee of the U.S. Senate Committee on the Judiciary, you called the USPTO the Department of Commerce's Central Bank of Innovation.[7] You noted that "every piece of IP we put into circulation is a potential job, a new business, a competitive advantage, or an investible asset." AUTM could not agree more. Universities create and refine the "currency" of ideas and intellectual property through research and discovery. When universities secure patent rights and license them to companies, we are collectively putting that intellectual currency into circulation, fueling new industries, products, and technologies.

While university technology transfer offices endeavor to generate revenue when licensing university-developed technologies, that is not the objective of what we do. Rather, our primary goal is to identify the best mechanism to deploy each university-created technology for public benefit. Sometimes, this is accomplished by publishing the results of university research; other times, it is accomplished through testing and development agreements to assess whether the technology is ready for incorporation into a product or service.

This objective—deploying university-created technology for public benefit—is what the National Institute of Standards and Technology (NIST) called "the underlying social and public mission inherent in the development of Federal research into products and services benefiting American taxpayers."[8] As breakthrough innovations in artificial intelligence, cybersecurity, biotechnology, and clean energy emerge from university laboratories at an unprecedented pace, now is the time to strengthen partnerships among universities, private investors, and commercial enterprises—partnerships built on strong U.S. patents. Because the proposed rule changes will result in

[7] *Statement by Director Squires before the United States Senate Subcommittee on Intellectual Property Committee on the Judiciary*, October 9, 2025, available at https://www.uspto.gov/about-us/news-updates/statement-director-squires-united-states-senate-subcommittee-intellectual.

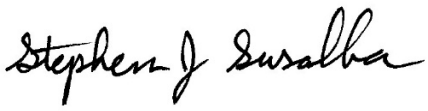
[8] Natl. Inst. Stand. Technol. Spec. Publ. 1234, (April 2019), available at https://nvlpubs.nist.gov/nistpubs/SpecialPublications/NIST.SP.1234.pdf. The Green Paper further states, "The "return" is interpreted to encompass a wide variety of benefits of technology transfer, both tangible and intangible to the investor, namely American citizens. It should not be viewed in the narrow context of revenue generation, but rather as contributions to broader economic prosperity, national security, and societal impact." *Id.* at p.20

stronger and more reliable patents, they will enhance such partnerships and bring industries back to America, create jobs, and enhance national security.

Conclusion

AUTM believes the proposed rule strikes the appropriate balance between efficiency, fairness, and stability in the patent system. AUTM thanks the USPTO for its efforts to promote innovation by making patent rights more reliable, which in turn incentivizes investment in promising technologies and encourages their development into tangible products and services. We appreciate the opportunity to respond to the NPRM and look forward to a continued productive dialog on this and other matters critical to the growth of American innovation and the health and economic well-being of Americans.

Sincerely,



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