

USPTO Acting Director Denies PTAB Petitions Filed with Joinder Motions

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On June 25, Acting Director Stewart issued six decisions that declined institution for petitions that included a motion for joinder. These decisions signal that USPTO policy is in transition, underscoring new considerations for both patent owners and petitioners navigating the IPR landscape.

Background. In an IPR, joinder allows additional parties to join an existing proceeding under 35 U.S.C. § 315(c). With joinder, parties—even if time-barred—may file a petition that is identical in substance to an already-instituted petition and then join it as a petitioner, typically in a backup or “understudy” role. The USPTO has historically tended toward granting IPR petitions with joinder motions.

Additionally, on March 26, the Acting Director issued a memorandum creating a new process for discretionary denial. Under this process, the Acting Director will decide discretionary issues in every post-grant proceeding. Her decisions so far have shifted the approach to discretionary denial on many issues.

If you have any questions concerning this memorandum, please reach out to your regular firm contact or to the Cleary authors below.

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I. Time-Barred Joinder Motions Denied Absent “Exceptional Circumstances.”

The Acting Director has implemented a stricter standard for companies seeking to join an existing IPR proceeding after the § 315(b) one-year bar has passed. In *Realtek Semiconductor Corp. v. ParkerVision, Inc.*,¹ Acting Director Stewart acknowledged that the statute allows joinder after a petitioner’s one-year deadline, but

stated that the USPTO can still “consider whether it is fair” to institute under such circumstances. Importantly, however, the Acting Director went on to state that “Petitions filed by time-barred parties should proceed only in exceptional circumstances.” Finding no such “exceptional circumstances” in the case before her, she denied institution. The decision did not identify

¹ IPR2025-00324, Paper 11 (Stewart, June 25, 2025).
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examples of what could constitute “exceptional circumstances.”

This “exceptional circumstances” standard represents a shift from previous PTAB practice. Previously, no additional showing was required to obtain joinder after expiration of a statutory time bar. For petitioners seeking such joinder, this shift means identifying “exceptional circumstances” beyond typical invalidity arguments. For patent owners, this shift provides new defensive opportunities, as time-barred joinder attempts now face a significantly higher burden than under previous USPTO leadership.

II. Joinder Petitions Face A *Fintiv* Analysis.

The Acting Director has also issued five decisions denying petitions with joinder motions even when they were filed before the one-year bar. Her approach to such cases also signals a change in USPTO policy.

In these situations, the Acting Director has articulated a two-step framework: “discretionary considerations are first reviewed for the Petition on its own, and then reviewed if joinder were to be granted.”² This is notable because the discretionary analysis can lead to different outcomes—i.e., different deadlines for final written decision—depending on whether there is joinder to a previously-instituted case.

In these early decisions under the newly-created bifurcated process, the already-instituted proceeding had been instituted before the new bifurcated process. The Acting Director indicated, however, that she might have now *denied* institution in those previous cases. The Acting Director then noted that if the original petitioner settles, “the Office would have to maintain a proceeding that it would not have instituted with respect to Petitioners here, even if they would have filed their Petition at the same time as the petitioner in [the already-instituted case].”³

In all five decisions where the Acting Director has applied this analysis, the petitions have been denied.⁴

III. Key Implications. For those considering IPR petitions with joinder motions, this shift warrants a reevaluation of joinder strategy that includes a careful assessment of whether the Petition would be instituted absent joinder and whether the USPTO would have applied discretion against the Petition if it were filed at the same time as the already-instituted case.

For petitioners, early action has become all the more important because joinder after a one-year bar will require a showing of “exceptional circumstances.” Petitioners can no longer rely on earlier-filed IPRs to cure timing problems that arise from late filing relative to parallel proceedings. Petitioners may explore filing joinder petitions well before institution of the to-be-joined case to obtain better timing facts to avoid discretionary denial, but it is not yet clear how the Acting Director will handle such cases.

For patent owners, the Acting Director’s current approach provides a new framework to oppose joinder. Additionally, patent owners can settle instituted cases with less of a chance that a time-barred petitioner can join and keep the cases alive.

Patent owners and petitioners must adapt their strategies, with a renewed focus on early filing and careful coordination between IPR and parallel proceedings. The Acting Director’s stated approach to joinder requires recalibration of IPR strategy.

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² *SportRadar AG v. SportsCastr Inc.*, IPR2025-00265, Paper 19 at 2 (Stewart June 25, 2025).

³ *Id.* at 3.

⁴ *Ultrahuman Healthcare v. Ouraring, Inc.*, IPR2025-00411, Paper 12 at 2-3 (Stewart June 25, 2025); *see also SportRadar,*

supra note 1, Paper 19; *RingConn LLC v. Ouraring, Inc.*, IPR2025-00412, Paper 11 (Stewart June 25, 2025); *Elong Int’l v. Feit Electric Co.*, IPR2025-00258, Paper 16 (Stewart June 25, 2025); *RingConn LLC v. Ouraring, Inc.*, PGR2025-00018, Paper 11 (Stewart June 25, 2025).