

McCombs and Bowser in Westlaw Today: New PTAB Guidance on Prior Adjudications of Patent Claims

October 2, 2025 David McCombs, Jonathan Bowser

PRACTICES Intellectual Property, Patents, Patent Prosecution and Counseling, Patent Office Trials

In the latest IPR Tricks of the Trade for *Westlaw Today*, Haynes Boone Partners [David McCombs](#) and [Jon Bowser](#) discuss new guidance requiring the Patent Trial and Appeal Board to provide a detailed justification when it reaches a different conclusion for patent claims that were "already adjudicated" in another proceeding.

Read an excerpt below.

On Sept. 16, 2025, Acting Director Coke Morgan Stewart issued a [memorandum](#) requiring the Patent Trial and Appeal Board (PTAB) to provide a detailed justification when it reaches a different conclusion for patent claims that were "already adjudicated" in another proceeding. This new guidance appears to provide patent owners greater leverage at the PTAB to maintain prior favorable adjudications on the validity of their patent claims.

In the America Invents Act (AIA), Congress created inter partes review (IPR) and post-grant review (PGR) proceedings for third parties to challenge the validity of issued patent claims before the PTAB. IPR or PGR petitions are often filed in response to being accused of patent infringement in U.S. district court or the International Trade Commission (ITC). Sometimes, the asserted patent claims being challenged in an IPR or PGR proceeding have been previously adjudicated in district court, the ITC, or in another proceeding at the U.S. Patent and Trademark Office (USPTO).

When the PTAB adjudicates the validity of a claim that was previously upheld in another proceeding, the petitioner may rely on different prior art and evidence at the PTAB. Nevertheless, PTAB critics have objected to decisions by the PTAB that invalidate claims previously upheld in another proceeding, focusing on inconsistent results between the PTAB and other forums.

The U.S. Court of Appeals for the Federal Circuit has held that even if the record before the PTAB was the same as in district court, "the PTAB properly may reach a different conclusion based on the same evidence" because the PTAB applies a different burden of proof than district courts or the ITC. *Novartis AG v. Noven Pharms. Inc.*, 853 F.3d 1289, 1294 (Fed. Cir. 2017).

In an IPR or PGR, the petitioner must prove unpatentability by a preponderance of the evidence (35 U.S.C. §§ 316(e), 326(e)) rather than by clear and convincing evidence as required in district court or ITC litigation. As explained by the Supreme Court, "[t]hese different evidentiary burdens mean that the possibility of inconsistent results is inherent to Congress' regulatory design." *Cuozzo Speed Techs. v. Com. for Intell. Prop.*, 579 U.S. 261, 283 (2016).

To read the full article from *Westlaw Today*, click [here](#).