



USPTO Director: Board Abused Discretion by Instituting Two IPRs on Same Patent Based on Competing Claim Constructions

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In a recent decision designated as Informative, the USPTO Director determined that the Patent Trial and Appeal Board abused its discretion by instituting two inter partes review proceedings challenging the same patent, based on petitions advancing different constructions of the same claim term. The Director expressed concerns that permitting multiple petitions based on alternative claim constructions effectively circumvents word count limitations, strains board resources, and undermines procedural efficiency.

The two petitions primarily presented two different constructions of a certain claim term—one broader and one narrower. Each petition advanced obviousness grounds according to the respective construction. In total, the two petitions presented eight grounds of unpatentability with significant overlap between them. Patent owner did not take a position on the proper construction of the term in its preliminary response, arguing instead that the claims were not unpatentable under either interpretation. The board instituted review based on both petitions because of the large number of claims and the complex subject matter, which was further complicated by the fact that the patent owner might argue for a narrow construction of the claim term petitioner identified.

The patent owner sought Director Review, arguing that the board abused its discretion in instituting both proceedings against the same claims of the same patent where no exceptional circumstances justified a second proceeding. The petitioner argued that institution was proper because each petition was based on a distinct interpretation of the claim term, and the patent owner had not taken a position on its meaning.

The Director determined that the board abused its discretion in granting institution of both petitions. Citing the board's Consolidated Trial Practice Guide, the Director emphasized that "one petition should be sufficient to challenge the claims of a patent in most situations" and multiple petitions are not necessary in the vast majority of cases. The director found that allowing two petitions challenging the same claims under alternate claim constructions effectively expands the word count limits, increases the burden on the board, and raises concerns about fairness, timing, and efficiency.

Importantly, the director rejected the board's rationale that the patent owner not advancing a claim construction position was a reason to institute both petitions. Rather, the Director stated that the board should have construed the claim term and instituted review of only one, if any, of the petitions. The Director remanded and authorized the patent owner to submit a brief addressing how the board should construe the claim term, to which the petitioner was authorized a reply. In its brief on remand, patent owner argued, among other things, that both petitions violated the requirement that a petitioner explain how the claim is to be construed under 37 C.F.R. § 42.104(b)(3). According to patent owner, the petitioner here attempted to shift that burden to the board and the patent owner.

Practice Tip:

Advancing alternate claim constructions in separate petitions, without more, is unlikely to justify multiple IPRs targeting the same patent. Petitioners should provide their proposed construction in their petition and, if necessary, can address an alternative construction that patent owner might seek. Conversely, patent owners should consider whether taking a position on claim construction could bolster non-institution arguments.

CrowdStrike, Inc. v. GoSecure, Inc., Nos. IPR2025-00068 & IPR2025-00070, Paper 25 (P.T.A.B. June 25, 2025)

Categories

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