

IP & Technology Litigation Update

December 2025

Patent Office Invites Petitioners to Trade Disclosures for Favorable Treatment in Post-Grant Proceedings

Key Notes:

- The United States Patent and Trademark Office (USPTO) is inviting petitioners in proceedings before the Patent Trial and Appeal Board (PTAB) to submit information about their prior art search methods. These “Search Disclosure Declarations” (SDDs) are intended to improve the quality of patent application examinations.
- To promote this initiative, the Director will favorably consider the petitioner’s submission of an SDD in deciding whether to institute an *inter partes* review (IPR) or post-grant review (PGR). In a year of significant change at the USPTO—change that has so far led to increased institution denials—the SDD process provides a mechanism for petitioners to strengthen their case for institution.
- The USPTO’s SDD policy is effective immediately. Parties should consider whether the USPTO-identified benefits have import to their proceeding and then weigh the strategic advantages of including an SDD with the risks associated with disclosing potentially sensitive (or privileged) information.

USPTO Introduces New Optional Disclosure to Improve Examination Quality

In an [open memorandum](#) to “all PTAB users,” USPTO Director John A. Squires introduced a new mechanism for IPR and PGR petitioners to submit information concerning their prior art search efforts. These submissions, called “Search Disclosure Declarations,” or SDDs for short, aim to “meaningfully improve Office search practices and, over

time, improve examination quality” by discovering “sophisticated search methodologies, repository knowledge, and/or analytics not routinely used by the Office.”

An SDD must include the following:

1. A list of databases and repositories in which the asserted prior art was located;
2. The general search approach used, including search terms, filters, queries, or classification pathways;
3. An explanation of any “other analytics or publicly accessible resources consulted;”
4. The amount of time spent searching for prior art; **and**
5. The amount of time spent reviewing search results.

Beyond these mandatory disclosures, the Director encourages petitioners to include “any other information relevant” to their prior art searches.

To encourage parties to adopt this new submission, the Director announced that the voluntary submission of an SDD will weigh favorably in the petitioner’s favor when considering whether the petition should be discretionarily denied. This is true, “particularly where the SDD reveals new or underutilized pathways relevant to Office search practice.”

Strategic Considerations for Patent Challengers

Search Disclosure Declarations present a strategic fork in the road for petitioners in IPR or PGR proceedings. Parties must carefully weigh the risk of filing potentially sensitive

and privileged materials against the perceived benefit to their discretionary and non-discretionary arguments.

The SDD's requirements arguably implicate privileged attorney work product. For example, petitioners must include "the general search approach, search terms, filters, queries, or classification pathways employed." The search terms an attorney used to find prior art, especially if catalogued sequentially, may provide insights into the attorney's mental impressions, such as invalidity theories or strategies. In traditional litigation, courts typically strive to safeguard these mental impressions even in instances where the attorney's factual work product is discoverable.

The PTAB advises petitioners to file a motion to seal the SDD and a request for in camera review under 37 C.F.R. § 42.14, noting that "if filed as confidential, the SDD will not be publicly disclosed except as required by law." However, practitioners should remember that § 42.14 carries a presumption of public availability "except as otherwise ordered." By regulation, even if a motion to seal is filed concurrent with the SDD, the SDD will only be "provisionally" sealed "pending the outcome of the decision on the motion." While the Director's memorandum indicates that motions to seal an SDD will be granted, the plain reading of the regulation suggests that there could be exceptions or outliers.

Furthermore, petitioners must allow the USPTO to use the SDD content "for internal training, improving examination processes, and analytics." At the time of writing, it is unclear exactly what each of these categories entails or how many individuals will have access to the potentially privileged information. Practitioners should ensure that their clients understand these risks before submitting an SDD.

Against this backdrop, petitioners must weigh the benefits outlined by the USPTO. According to the USPTO, submitting an SDD that reveals "new or underutilized pathways relevant to Office search practice" may weigh in the petitioner's favor even more. Still, it is unclear how specifically submission of an SDD will be weighed, and there is currently no decisional authority that provides guidance. Recent policy changes at the PTAB have led to a sharp decline in the institution rate of IPR petitions. As we noted

in a previous [article](#), the Director now personally reviews each petition and determines whether the petition should be denied on a discretionary basis or on the merits. It remains unclear how specifically submission of an SDD will be weighed, particularly considering the Director's statement that previous discretionary denial decisions—which have turned on "settled expectations" and the time-to-trial in any parallel proceeding—will continue to provide "substantial guidance on how the Director will handle discretionary considerations." A petitioner whose IPR petition presents a close discretionary denial case—perhaps due to the age of the challenged patent or the status of parallel litigation—will want to carefully consider the pros and cons of an SDD.

Petitioners contemplating an SDD will also want to consider how the SDD impacts other discretionary denial issues. For example, an SDD may help a petitioner demonstrate Examiner error under Section 325(d). Examiner error is a powerful discretionary consideration for petitioners to address; many Director Decisions analyzed this factor before ultimately denying a patent owner's request for discretionary denial. Information provided in an SDD could be juxtaposed against the Examiner's assessment of the prior art in a manner favorable to petitioners. For example, even in technologies with high volumes of prior art, some applications receive few prior art rejections; some receive none at all. This is occasionally true even when applicants submit Information Disclosure Statements containing dozens, if not hundreds, of references. If the petitioner submits an SDD explaining that the prior art search was a long, arduous process, this may support an argument that the Examiner simply "rubber-stamped" the application.

The SDD is to be filed as a separate exhibit at the same time as the petition. This carries potential strategic benefits. First, because it is filed before the parties brief discretionary denial issues, the SDD may tee up a petitioner's favorable arguments, such as Examiner error. Second, its contents will not count towards the page limit for the petitioner's discretionary denial briefing (currently 20 pages).

The extent to which petitioners use SDDs remains to be seen. There is no one-size-fits-all approach to deciding what information to include in an SDD—or whether to file one at all. Practitioners should pay close attention to new Notices

of Decisions on Institution to estimate the impact of SDDs on a petitioner's likelihood of success. And parties contemplating PTAB proceedings should consult with their counsel to carefully evaluate the role of SDDs in their case.

FOR MORE INFORMATION

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