

## IPR Uncertainty: *Sotera* Stipulations No Longer “Dispositive”

*In re Motorola Solutions, Inc.*, No. 25-134, 2025 WL 3096514 (Fed. Cir. Nov. 6, 2025)

Authors: Joe Marinelli & Nick Wheeler | Editor: Barry Irwin | November 14, 2025

If you were hoping a *Sotera* stipulation would bulletproof your Inter Partes Review (“IPR”) petition from a discretionary denial, the Federal Circuit (“CAFC”) just poured cold water on that plan. In *In re Motorola*, the CAFC denied Motorola Solutions, Inc.’s (“Motorola’s”) arguments that the United States Patent and Trademark Office (“PTO”) Director’s decision to deinstitution Motorola’s IPRs was a violation of Motorola’s due process rights. The CAFC held that Motorola’s expectation that its IPR petitions would be instituted if it submitted a *Sotera* stipulation under previous PTO IPR guidance was not an interest protected under the Fifth Amendment.



In June 2022, then PTO Director, Katherine Vidal issued a memorandum (“Vidal Memo”) announcing guidance on how the PTO should determine whether to institute a party’s IPR petition in situations where there is a parallel district court litigation. Under the Vidal Memo, the PTO would not “discretionarily deny institution” when a petitioner presented a *Sotera* stipulation: “a stipulation not to pursue in a parallel proceeding the same [invalidity] grounds or any [invalidity] grounds that could have reasonably been raised before the [PTAB].” On February 28, 2025, following a change in Presidential administrations, the new PTO Director rescinded the Vidal Memo. On March 25, 2025, the PTO’s Chief Administrative Patent Judge Boalick instructed the PTO not to consider a *Sotera* stipulation as “dispositive” in its institution decisions but rather as “highly relevant.” Before the Vidal Memorandum was rescinded, Motorola filed IPR petitions in 2024 including *Sotera* stipulations relating to its parallel district court litigation. The PTO initially instituted IPRs on Motorola’s petitions. The PTO Director later deinstitutioned the IPRs concluding that the PTO gave too much weight to Motorola’s *Sotera* stipulations and not enough weight to the efficiency of the agency’s resources given the investment of resources in the parallel district court litigation. Motorola filed a mandamus petition to the CAFC arguing that the rescission of the Vidal Memo violated the Due Process Clause of the Fifth Amendment because the memo imposed “substantive limits” on the PTO’s “official discretion” to deny a petition if the petitioner provided a *Sotera* stipulation.

The CAFC rejected Motorola’s argument and held that the Vidal Memo did not limit the PTO’s discretion in denying an IPR petition and did not mandate that the PTO reach any particular outcome on an IPR petition. The CAFC also held that Motorola’s expectation of institution based on the Vidal Memo was not an “interest protected by the Due Process Clause” where the PTO stated its guidance on institutions could change and given that Motorola could still pursue invalidity defenses in its district court litigation.

This decision highlights the uncertainty around the PTO’s IPR institution process, and the PTO’s open goal of reducing the volume of IPRs instituted. The PTO Director recently stated that he will individually decide whether to institute all future IPRs in hopes of eliminating the public “concern that the [PTAB] may be filling its own docket” through “extraordinarily high institution rates.”<sup>1</sup> The PTO’s attempt to lower IPR institution rates is in addition to the Director’s recent IPR policy changes such as providing institution decisions through “summary notices” with no detailed explanation as to why a petition was granted or denied; enforcing that all real parties in interest be identified in an IPR petition; and ending the bifurcation process for an institution decision under discretionary or merit based considerations.

<sup>1</sup> John A. Squires, [Open Letter from America's Innovation Agency and Memorandum](#) (Oct. 17, 2025).