

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



PTAB update

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November 14, 2019

Patent Public Advisory Committee quarterly meeting

UNITED STATES
PATENT AND TRADEMARK OFFICE



Agenda

- Highlights of annual report: PTAB section
- PTAB accomplishments in FY19
- PTAB FY19 close-out on appeal and trial filings, pendency, and inventory
- Recent PTAB developments

PTAB section

Highlights of annual report

PTAB accomplishments in FY19

PTAB accomplishments in FY19

- New standard operating procedures, including new procedures to designate PTAB decisions precedential or informative
- Recent precedential and informative decisions
- Rule changing claim construction standard in AIA proceedings
- Motion to amend pilot program
- Notice regarding options for amendments through reissue or reexamination during a pending AIA trial proceeding
- Trial Practice Guide updates
- Studies
- 2019 Revised Patent Subject Matter Eligibility Guidance
- Pendency of ex parte appeal cases



Standard operating procedures

- SOP 1: Paneling judges to cases
- SOP 2: Issuing precedential and informative decisions

Standard operating procedure 2

September 2018 update

- Provides new Precedential Opinion Panel (POP) for creating binding Board precedent on rehearing
 - Provides notice to the parties when POP review takes place, as well as the identification of the POP members in a particular case
 - Explains the standards, procedures, and timing for requesting POP review in a pending case on rehearing
- Provides for designation and de-designation of precedential opinions by the director

POP decisions and orders

Case/Appeal Name	Case/Appeal Number	Topic	Status	Date Decided
<i>Proppant Express Invs., LLC v. Oren Techs., LLC</i>	IPR2018-00914, Paper 38	AIA - Joinder - 315(c)	Decided (POP)	3/13/2019
<i>GoPro, Inc. v. 360Heros, Inc.</i>	IPR2018-01754, Paper 38	AIA - 315(b) - Time Bar	Decided (POP)	8/23/2019

Case/Appeal Name	Case/Appeal Number	Topic	Status	Date Order Issued
<i>Hulu, LLC v. Sound View Innovations, LLC</i>	IPR2018-01039, Paper 15	AIA - Printed Publications	Pending (POP)	4/3/2019

Precedential and informative decisions

Precedential decisions (16)

- AIA - RPI - 312(a)(2), 315(b) (2)
- AIA - RPI - 322(a)(2) (1)
- AIA - Institution - 314(a) (2)
- AIA - Institution - 314(a), 325(d) (1)
- AIA - Institution - 325(d) (1)
- AIA - Bar - 315(a)(1) (1)
- AIA - Time Bar - 315(b) (1)
- AIA - MTA - 316(d) (2)
- AIA - Oral Argument (2)
- AIA - Pre-institutions Disclaimer (1)
- AIA - Request for Rehearing (1)
- AIA - Witness Testimony (1)

Informative decisions (10)

- AIA - Institution - 312(a)(3) (1)
- AIA - Institution - 314(a) (2)
- 101 (5)
- Design Choice - 103 (2)

Recent decisions designated precedential

Case/Appeal Name	Case/Appeal Number	Topic	Date Issued	Date Designated
<i>Proppant Express Invs., LLC v. Oren Techs., LLC</i>	IPR2017-01917, Paper 86	AIA - RPI - 312(a)(2), 315(b)	2/13/2019	4/16/2019
<i>Ventex Co., Ltd v. Columbia Sportswear North America, Inc.</i>	IPR2017-00651, Paper 152	AIA - RPI - 312(a)(2), 315(b)	1/24/2019	4/16/2019
<i>Adello Biologics LLC v. Amgen Inc.</i>	PGR2019-00001, Paper 11	AIA - RPI - 322(a)(2)	2/14/2019	4/16/2019
<i>Valve Corp. v. Elec. Scripting Prods., Inc.</i>	IPR2019-00062, -00063, -00084, Paper 11	AIA - Institution - 314(a)	4/2/2019	5/7/2019
<i>Valve Corp. v. Elec. Scripting Prods., Inc.</i>	IPR2019-00064, -00065, -00085, Paper 10	AIA - Institution - 314(a)	5/1/2019	8/2/2019
<i>NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.</i>	IPR2018-00752 , Paper 8	AIA - Institution - 314(a), 325(d)	9/12/2018	5/7/2019
<i>Becton, Dickinson and Company v. B. Braun Melsungen AG</i>	IPR2017-01586, Paper 8	AIA - Institution - 325(d)	12/15/2017	8/2/2019
<i>Cisco Systems, Inc. v. Chrimar Systems, Inc.</i>	IPR2018-01511, Paper 11	AIA - Bar - 315(a)	1/31/2019	8/29/2019
<i>Infiltrator Water Techs., LLC, v. Presby Patent Trust</i>	IPR2018-00224, Paper 25	AIA - Time Bar - 315(b)	10/1/2018	9/9/2019

Recent decisions designated precedential (cont.)

Case/Appeal Name	Case/Appeal Number	Topic	Date Issued	Date Designated
<i>Lectrosonics, Inc. v. Zaxcom, Inc.</i>	IPR2018-01129, -01130, Paper 15	AIA - MTA - 316(d)	2/25/2019	3/7/2019
<i>Amazon.com, Inc. v. Uniloc Luxembourg S.A.</i>	IPR2017-00948, Paper 34	AIA - MTA - 316(d)	1/18/2019	3/18/2019
<i>DePuy Synthes Prods., Inc. v. MEDIDEA, L.L.C.</i>	IPR2018-00315, Paper 29	AIA - Oral Argument	1/23/2019	3/18/2019
<i>K-40 Elecs., LLC v. Escort, Inc.</i>	IPR2013-00203, Paper 34	AIA - Oral Argument	5/21/2014	3/18/2019
<i>General Electric Co. v. United Techs. Corp.</i>	IPR2017-00491, Paper 9	AIA - Pre-institution Disclaimer	7/6/2017	9/9/2019
<i>Huawei Device Co., Ltd. v. Optis Wireless Tech., LLC</i>	IPR2018-00816, Paper 19	AIA - Request for Rehearing	1/8/2019	4/5/2019
<i>Focal Therapeutics, Inc. v. SenoRx, Inc.</i>	IPR2014-00116, Paper 19	AIA - Witness Testimony	7/21/2014	7/10/2019



Recent decisions designated informative

Case/Appeal Name	Case/Appeal Number	Topic	Date Issued	Date Designated
<i>Adaptics Limited v. Perfect Company</i>	IPR2018-01596, Paper 20	AIA - Grounds - 312(a)(3)	3/6/2019	8/2/2019
<i>Deeper, UAB v. Vexilar, Inc.</i>	IPR2018-01310, Paper 7	AIA - Institution - 314(a)	1/24/2019	4/5/2019
<i>Chevron Oronite Company LLC v. Infineum USA L.P.</i>	IPR2018-00923, Paper 9	AIA - Institution - 314(a)	11/7/2018	4/5/2019
<i>Ex Parte Smith</i>	2018-000064	101	2/1/2019	3/19/2019
<i>Ex Parte Olson</i>	Appeal 2017-006489	101	3/25/2019	7/1/2019
<i>Ex Parte Kimizuka</i>	Appeal 2018-001081	101	5/15/2019	7/1/2019
<i>Ex Parte Savescu</i>	Appeal 2018-003174	101	4/1/2019	7/1/2019
<i>Ex Parte Fautz</i>	Appeal 2019-000106	101	5/15/2019	7/1/2019



Recent decisions designated informative

Case/Appeal Name	Case/Appeal Number	Topic	Date Issued	Date Designated
<i>Ex Parte Maeda</i>	Appeal 2010-009814	Design Choice - 103	10/23/2012	10/15/2019
<i>Ex Parte Spangler</i>	Appeal 2018-003800	Design Choice - 103	2/20/2019	10/15/2019

PTAB website, decisions

The screenshot shows the top of the USPTO website. On the left is the 'uspto' logo and 'UNITED STATES PATENT AND TRADEMARK OFFICE'. On the right are links for 'About Us', 'Jobs', 'Contact Us', and 'MyUSPTO'. Below these is a search bar with the text 'Search uspto.gov' and a magnifying glass icon. A navigation menu contains 'Patents', 'Trademarks', 'IP Policy', and 'Learning and Resources', with a 'Find It Fast' button to the right. Below the menu is a breadcrumb trail: 'Home > Patents: Application Process > Patent Trial and Appeal Board > Patent Trial and Appeal Board'. A paragraph of introductory text follows: 'The Patent Trial and Appeal Board (PTAB) conducts trials, including inter partes, post-grant, and covered business method patent reviews and derivation proceedings, hears appeals from adverse examiner decisions in patent applications and reexamination proceedings, and renders decisions in interferences.'

Trials



Manage or review pending inter parte review, post-grant review, covered business method, derivation, and interference proceedings.

Appeals



Manage or review proceedings directed to adverse decisions of examiners in patent applications, reissue applications, and reexaminations of issued patents.

Decisions



Browse public final agency decisions of PTAB, including decisions designated as precedential or informative.

Hearings



Review guidance, schedules, and inclement weather advisories for oral arguments for appeals, interferences, and trials.

Resources and guidance



Learn about the Patent Trial and Appeal Board or find key policies, procedures, forms, and guidance.

Statistics



View performance benchmarks of the PTAB, including dispositions, pendency, inventory, and other tracking measures.

PTAB Data Tools and IT Systems



Stay informed regarding maintenance events, obtain direct access to PTAB automated information sharing platforms, subscribe for updates, or provide feedback.

PTAB Events



Find where our judges are speaking and learn more about events sponsored by PTAB.

About PTAB



Discover the history of the PTAB and map out its modern structure and mission.

Notice of Proposed Rulemaking on allocation of burdens for motion to amend **NEW**

New Precedential and Informative Decisions

Trial Practice Guide July 2019 Update **NEW**

Notice regarding options for amendments through reissues or reexaminations **NEW**

New Pilot Program Concerning Motions to Amend **NEW**

Claim Construction Final Rule **NEW**

SOP 1 (rev. 15): Assignment of judges to panels **NEW**

SOP 2 (rev. 10): Precedential opinion panel to decide issues of exceptional importance involving policy or procedure **NEW**

www.uspto.gov/patents-application-process/patenttrialandappealboard

Claim construction standard

- Board changed the claim construction standard used in AIA trials, commonly called the “broadest reasonable interpretation” standard, to match that applied by the federal district courts, commonly called the “Phillips” standard
- Permits Board to make better use of federal court claim constructions
- Increases the likelihood that claims are not argued one way before the office to maintain their patentability (or to show that the claims are unpatentable) and in a different way against an opposing party in an infringement case before the federal courts
- Effective November 13, 2018, and applies to AIA trial petitions filed on or after that date

Motion to amend pilot program

- Provides patent owners with two options not previously available:
 - Option 1: patent owner may choose to receive preliminary guidance from the Board on its motion to amend
 - Option 2: patent owner may choose to file a revised motion to amend after receiving petitioner's opposition to the original motion to amend and/or after receiving the PTAB's preliminary guidance (if requested)
- Option 1 is not a predicate for Option 2
- Effective on March 15, 2019



Reexam and reissue notice

- Explains alternative ways that patent owners might secure amended claims outside the trial process through the use of reissue and reexamination procedures
- Addresses factors that the PTAB considers when determining whether to stay or suspend a reissue proceeding, or stay a reexamination, that involves a patent involved in an AIA proceeding, and also when and whether to lift such a stay or suspension
- Published April 4, 2019

Trial Practice Guide (TPG)

July 2019 update

Provides guidance on:

1. Factors that may be considered by the Board in determining when additional discovery will be granted;
2. The submission of testimonial evidence with a patent owner preliminary response;
3. Procedures for parties to request modifications to the default protective order;
4. Factors that may be considered by the Board in determining whether to grant a motion for joinder;
5. Procedures to be followed when a case is remanded; and
6. Information to be provided by the parties if there are multiple petitions filed at or about the same time challenging the same patent



TPG July update: multiple petitions

- One petition should be sufficient
- Two or more petitions should be “rare”
- Unlikely that three or more petitions will be appropriate
- Justification for more than one petition may include, e.g.,
 - When the patent owner has asserted a large number of claims in litigation (id.)
 - When there is a dispute about priority date (id.) (or other need to compartmentalize art that may turn on a dispositive issue)

Studies

- Orange Book and Purple Book study of AIA trials involving pharmaceutical patents
- Orange Book and Purple Book study of district court litigation for pharmaceutical patents
- Parallel proceedings at the USPTO (e.g., AIA proceedings, reexamination, and reissue) involving issued patents

2019 Revised Patent Subject Matter Eligibility Guidance

- Conducted extensive training for judges on new 101 guidance
- Designated five decisions as informative to showcase how to apply the guidance in 101 determinations

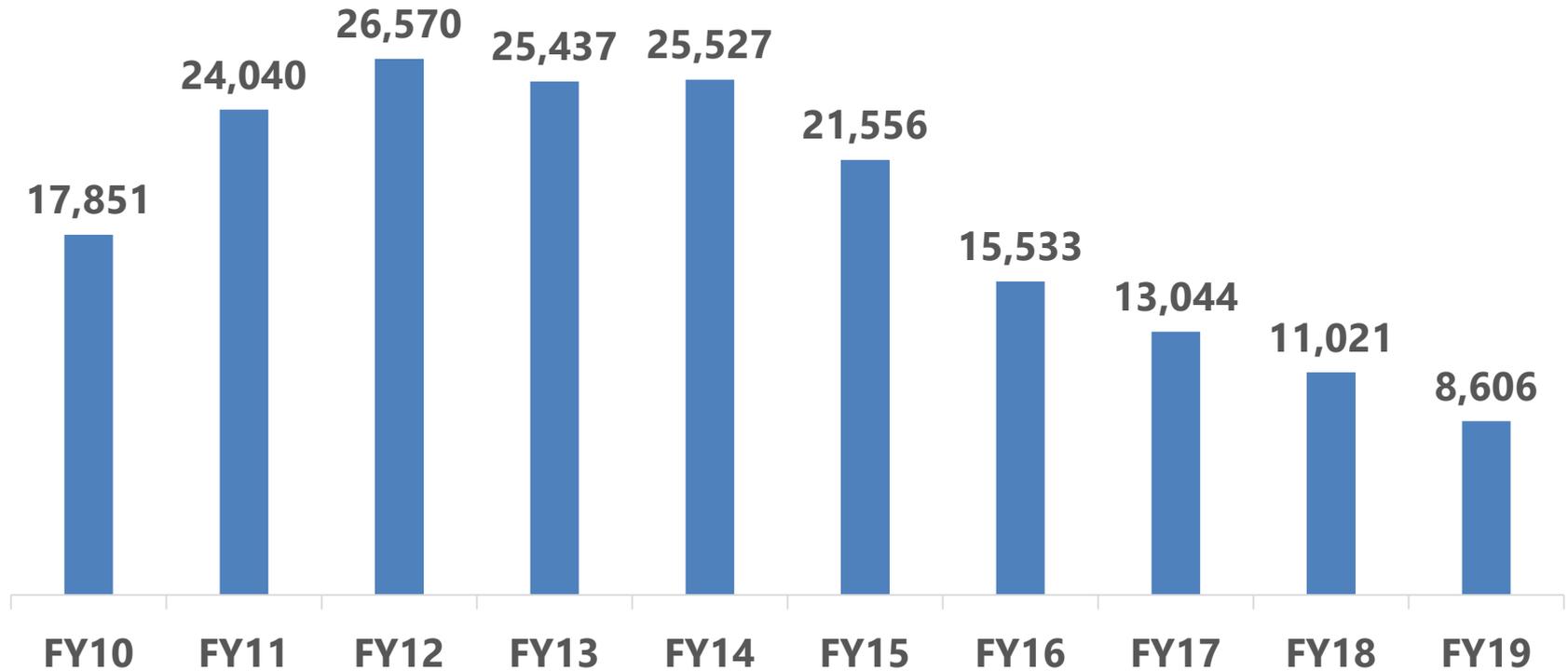
Close-out on appeal and trial filings, pendency, and inventory

PTAB FY19

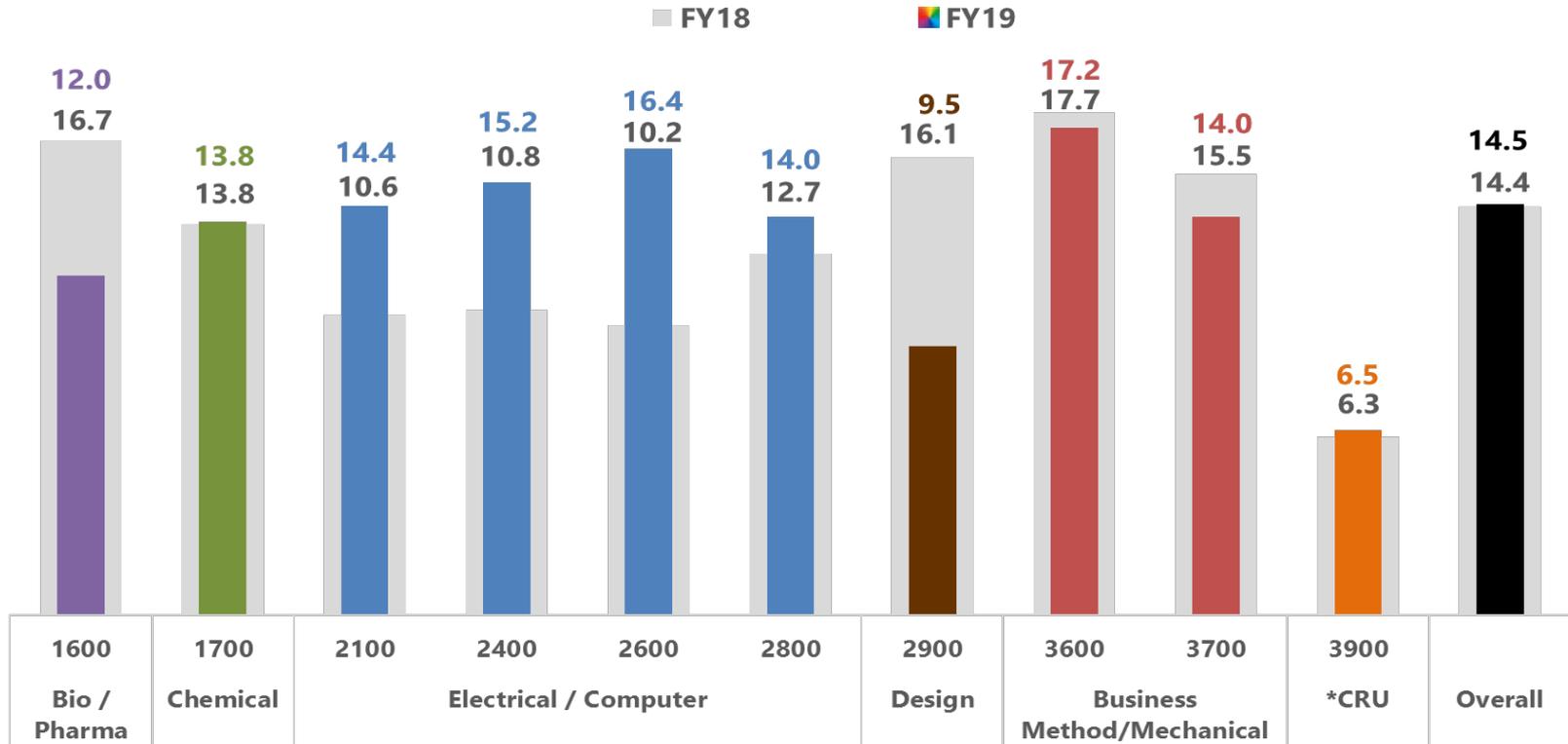
Appeal statistics

- Inventory
- Average pendency

Pending appeals FY10 to FY19 (Sept. 30, 2010 – Sept. 30, 2019)



Pendency of decided appeals in FY18 and FY19 (Jul. – Sept. FY18 compared to Jul. – Sept. FY19)



Pendency is calculated as average months from Board receipt date to final decision.

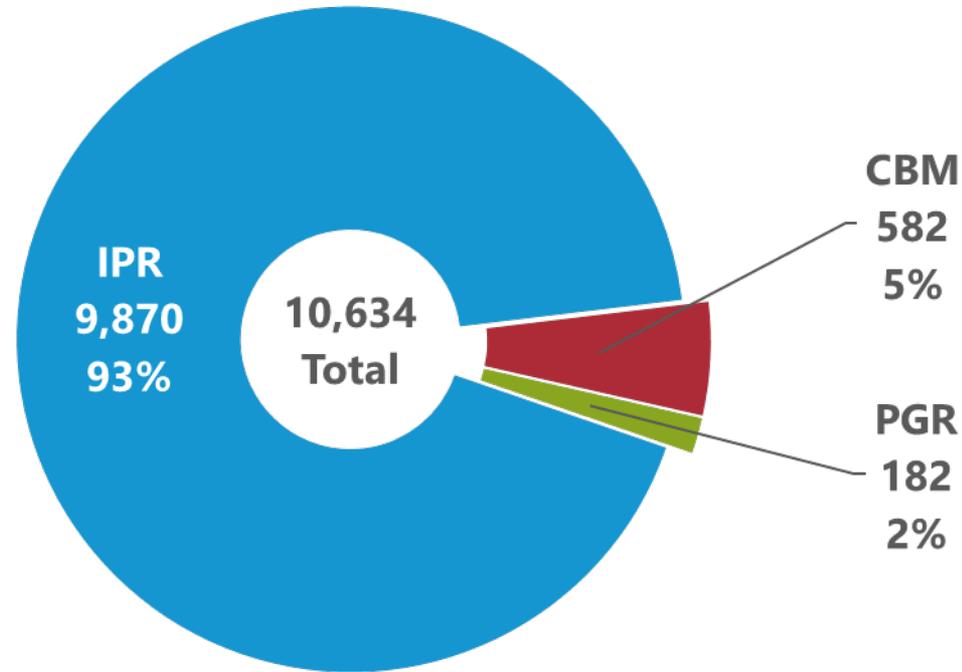
Pendency is calculated for a three month period compared to the same period the previous year.

26 *CRU (Central Reexamination Unit) decisions include *ex parte* reexam, *inter partes* reexam, supplemental examination review, and reissues from all technologies.

AIA trial statistics

- Number of petitions
- Institution rate
- FWD outcomes

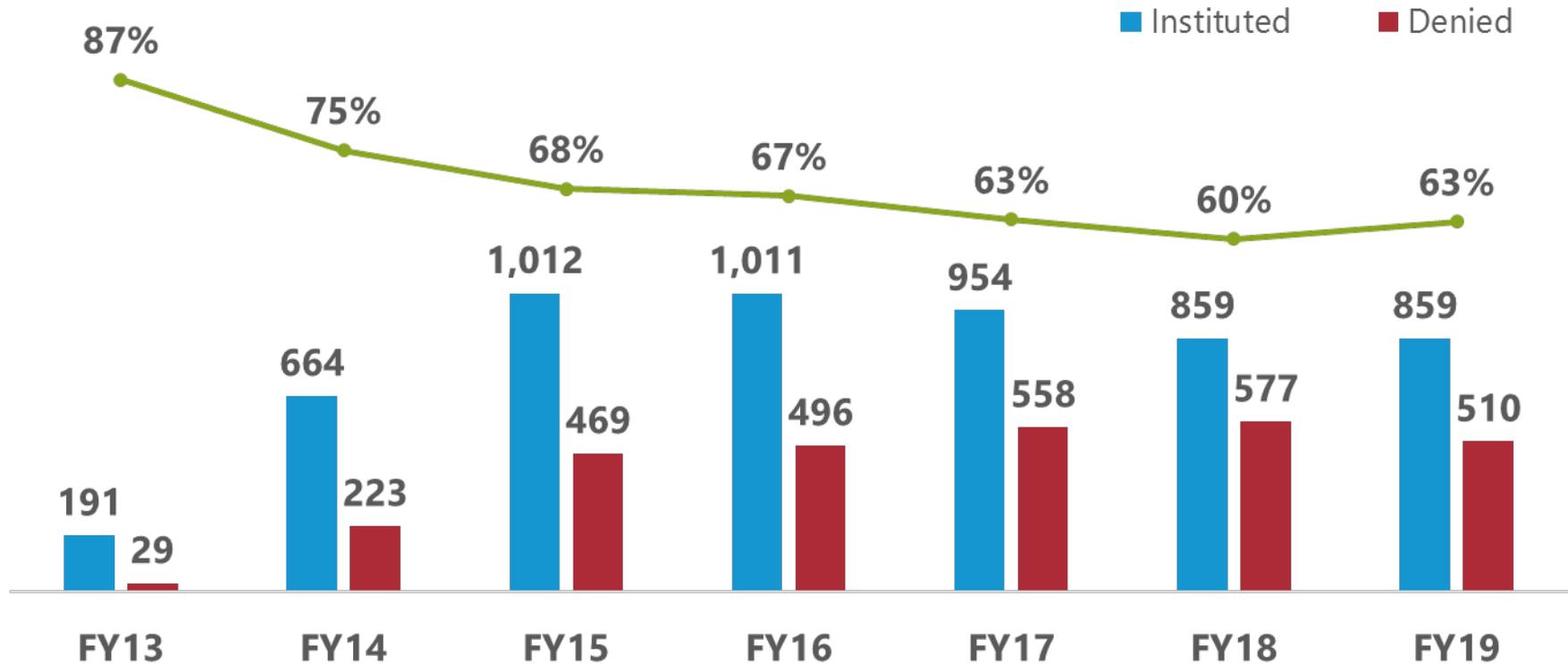
Petitions by trial type (all time: Sept. 16, 2012 to Sept. 30, 2019)



Trial types include Inter Partes Review (IPR), Post Grant Review (PGR), and Covered Business Method (CBM).

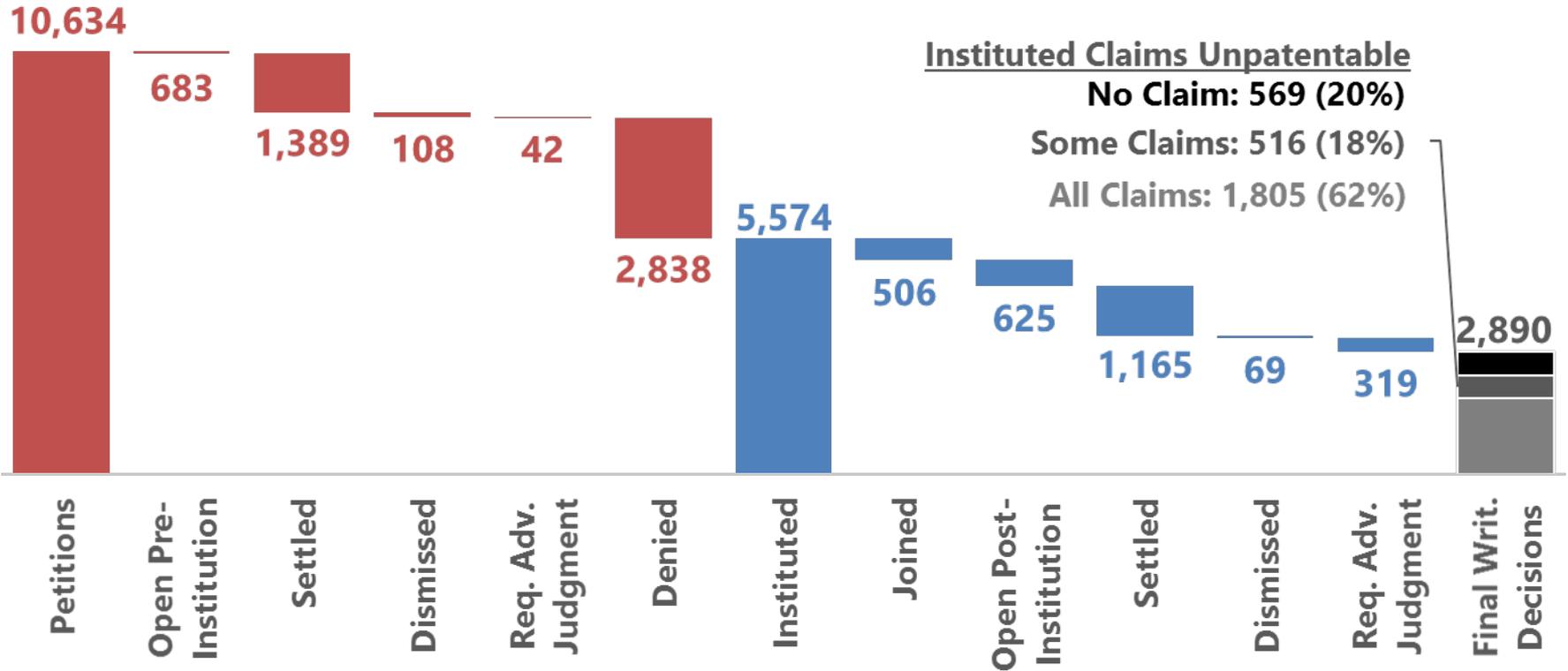


Institution rates (FY13 to FY19: Oct. 1, 2012 to Sept. 30, 2019)



Institution rate for each fiscal year is calculated by dividing petitions instituted by decisions on institution (i.e., petitions instituted plus petitions denied). The outcomes of decisions on institution responsive to requests for rehearing are excluded.

Status of petitions (all time: Sept. 16, 2012 to Sept. 30, 2019)



These figures reflect the latest status of each petition. The outcomes of decisions on institution responsive to requests for rehearing are incorporated. Once joined to a base case, a petition remains in the Joined category regardless of subsequent outcomes.

Recent PTAB developments

Notice of proposed rulemaking on allocation of burdens for motion to amend

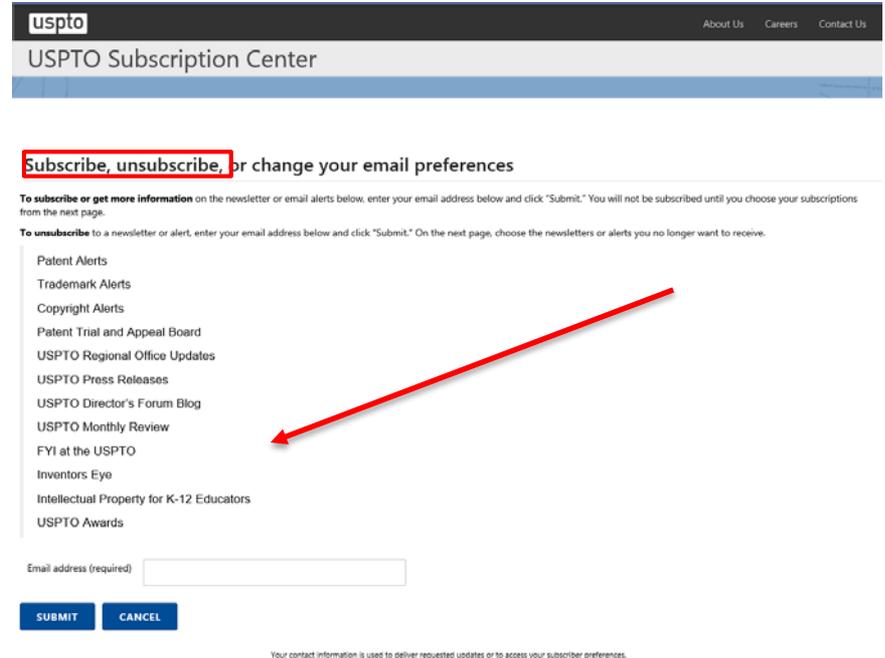
- Published October 22, 2019
- Proposes
 - petitioner bears the burden to show the unpatentability of substitute claims proposed in a motion to amend;
 - patent owner bears the burden to show that a motion to amend complies with certain statutory and regulatory requirements; and
 - the Board may, in the interests of justice, make a determination regarding the patentability of substitute claims based on the record in the proceeding regardless of the burdens assigned to any party.
- Comments due December 23, 2019



Subscription center

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The screenshot shows the USPTO Subscription Center page. At the top, there is a dark header with the 'uspto' logo on the left and 'About Us', 'Careers', and 'Contact Us' links on the right. Below the header, the page title 'USPTO Subscription Center' is displayed. The main content area features a red-bordered box containing the text 'Subscribe, unsubscribe, or change your email preferences'. Below this box, there are two paragraphs of instructions: 'To subscribe or get more information on the newsletter or email alerts below, enter your email address below and click "Submit." You will not be subscribed until you choose your subscriptions from the next page.' and 'To unsubscribe to a newsletter or alert, enter your email address below and click "Submit." On the next page, choose the newsletters or alerts you no longer want to receive.' A list of newsletters follows, including 'Patent Alerts', 'Trademark Alerts', 'Copyright Alerts', 'Patent Trial and Appeal Board', 'USPTO Regional Office Updates', 'USPTO Press Releases', 'USPTO Director's Forum Blog', 'USPTO Monthly Review', 'FYI at the USPTO', 'Inventors Eye', 'Intellectual Property for K-12 Educators', and 'USPTO Awards'. Below the list is an 'Email address (required)' input field. At the bottom of the form are two buttons: 'SUBMIT' and 'CANCEL'. A red arrow points from the right side of the page towards the 'USPTO Monthly Review' item in the list. At the very bottom, a small line of text reads: 'Your contact information is used to deliver requested updates or to access your subscriber preferences.'



Questions and comments

- Scott R. Boalick
 - Chief administrative patent judge
 - (571) 272-9797
 - scott.boalick@uspto.gov

Appendix of reference materials

Federal register notices

- Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 197 (Oct. 11, 2018), available at: www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/procedures/ptab-issues-claim-construction
- Notice Regarding a New Pilot Program Concerning Motion To Amend Practice and Procedures in Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board, 84 Fed. Reg. (Mar. 15, 2019), available at: www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/new-pilot-program-concerning-motions

Federal register notices (cont.)

- Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding (April 2019), 84 Fed. Reg. 77 (Apr. 22, 2019), available at: www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/notice-regarding-options-amendments
- 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 4 (Jan. 7, 2019), available at: www.govinfo.gov/content/pkg/FR-2019-01-07/pdf/2018-28282.pdf
- Rules of Practice To Allocate the Burden of Persuasion on Motions To Amend in Trial Proceedings Before the Patent Trial and Appeal Board, 84 Fed. Reg. 56401 (Oct. 22, 2019), available at: www.federalregister.gov/documents/2019/10/22/2019-22768/rules-of-practice-to-allocate-the-burden-of-persuasion-on-motions-to-amend-in-trial-proceedings

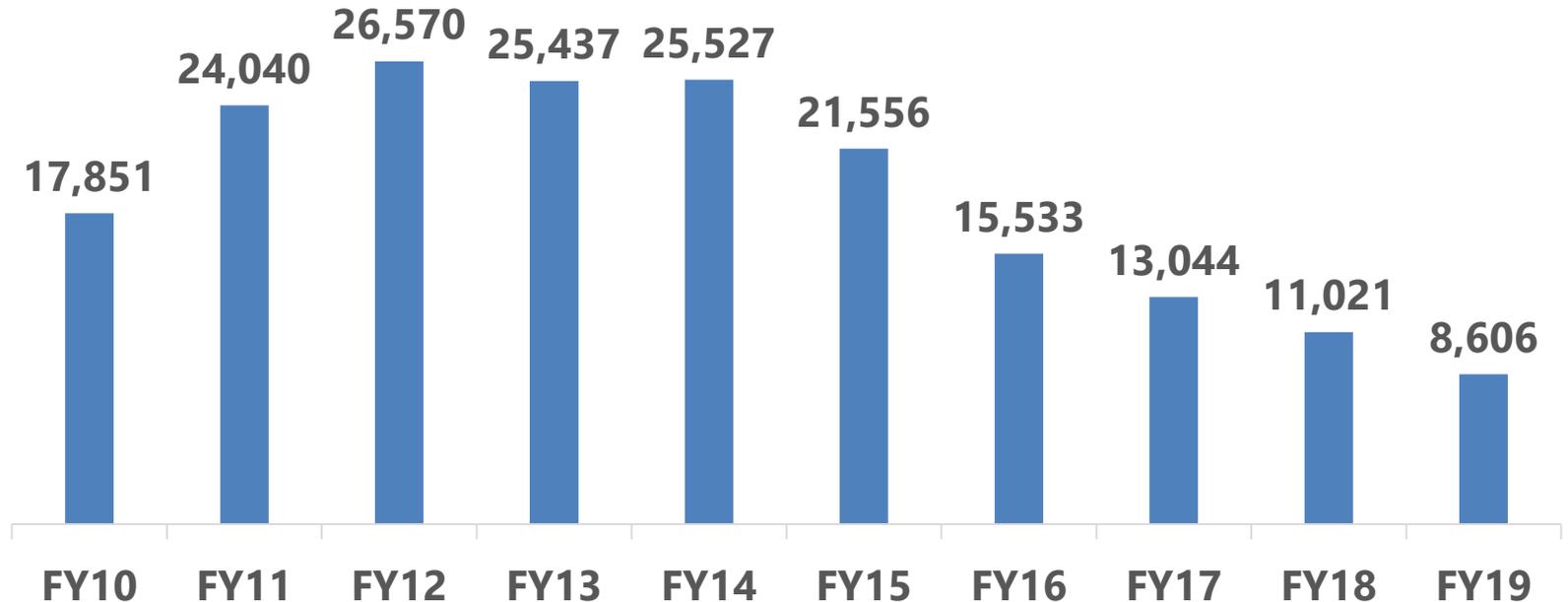
Other documents and sources

- Trial Practice Guide Update (July 2019), available at: www.uspto.gov/sites/default/files/documents/trial-practice-guide-update3.pdf
- Standard Operating Procedures, available at: www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/resources
- Studies, available at: www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/statistics
- Statistics, available at: www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/statistics

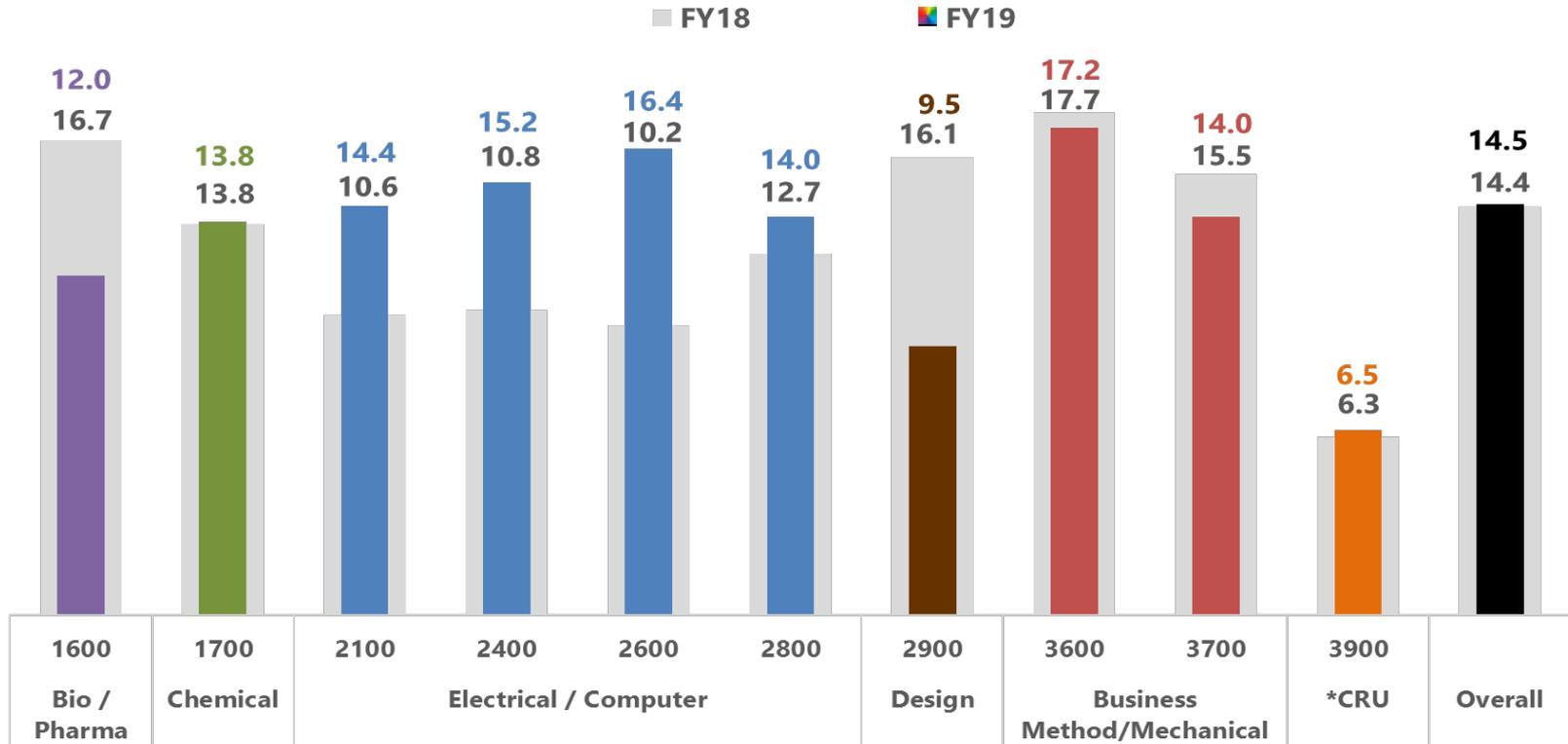
Patent Trial and Appeal Board
September 30, 2019

Appeal and interference statistics

Pending appeals FY10 to FY19 (Sept. 30, 2010 – Sept. 30, 2019)



Pendency of decided appeals in FY18 and FY19 (Jul. – Sept. FY18 compared to Jul. – Sept. FY19)

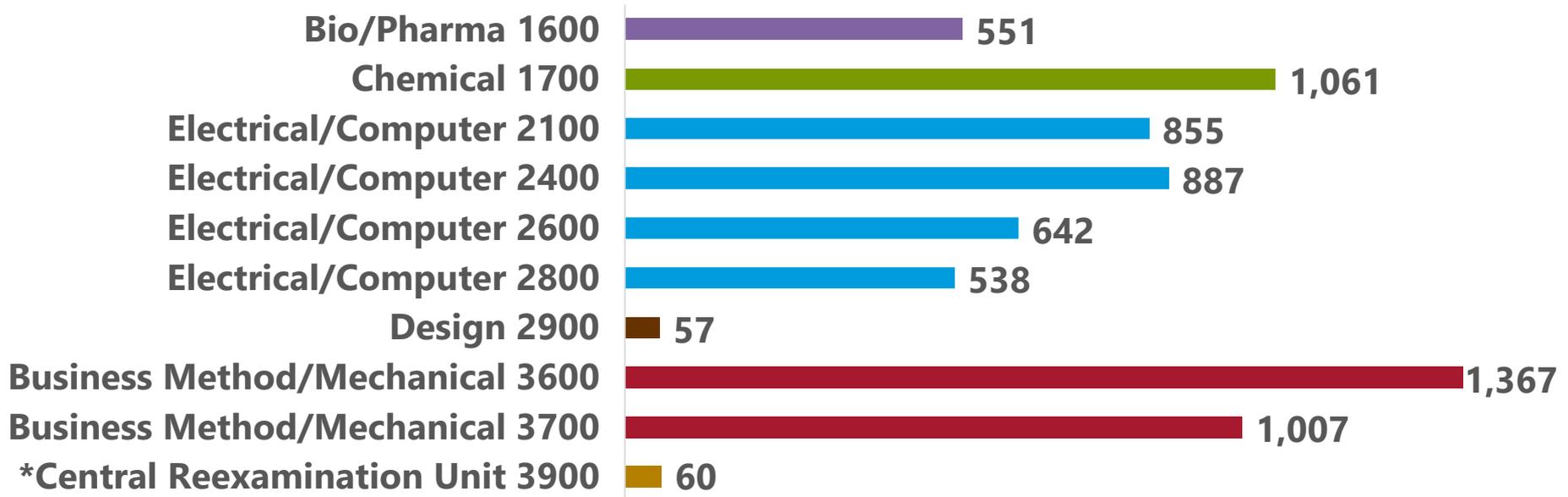


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Pendency is calculated for a three month period compared to the same period the previous year.

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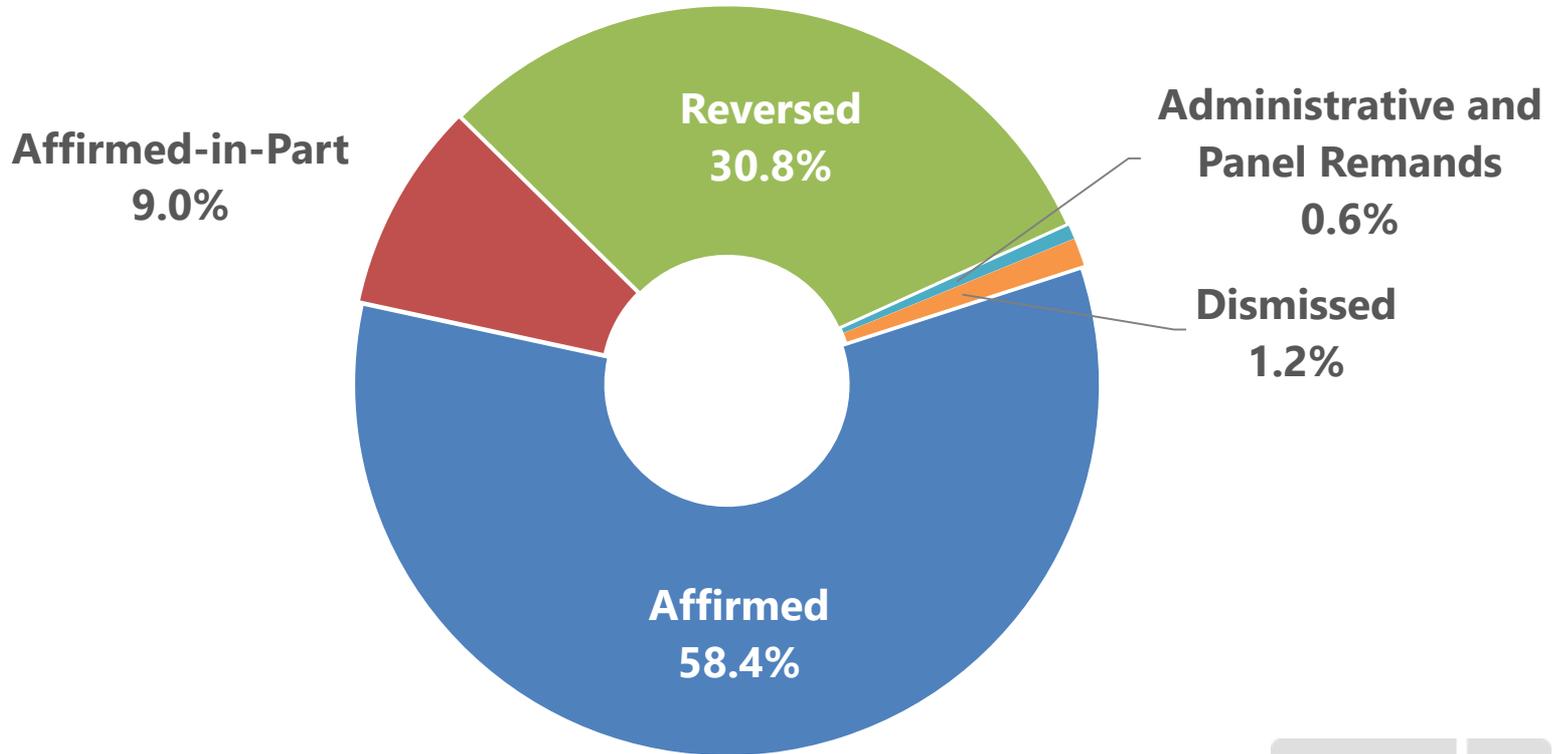
Appeal intake in FY19 (Oct. 1, 2018 – Sept. 30, 2019)



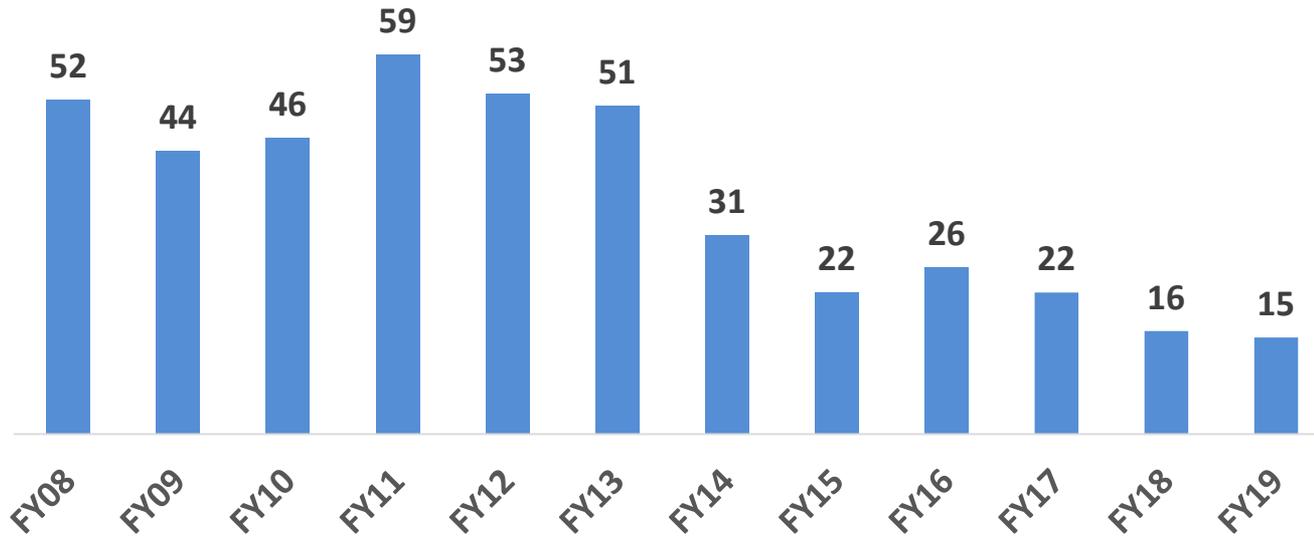
*The Central Reexamination Unit includes ex parte reexams, inter partes reexams, supplemental examination reviews and reissues from all technologies.



Appeal outcomes in FY19 (Oct. 1, 2018 - Sept. 30, 2019)



Interference inventory (Sept. 30, 2008 – Sept. 30, 2019)

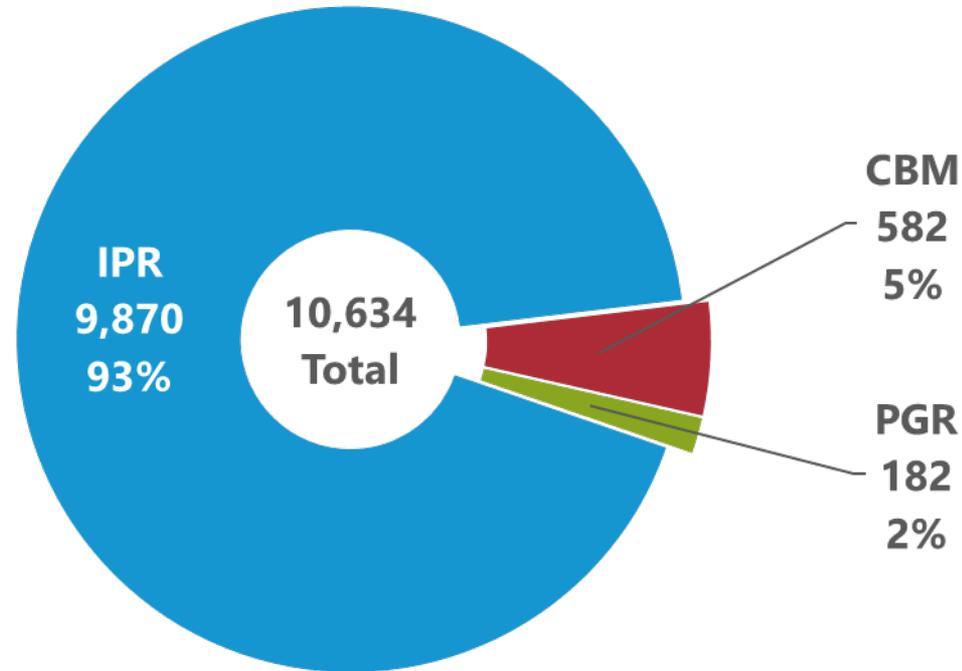


Patent Trial and Appeal Board
September 2019

Trial statistics

IPR, PGR, CBM

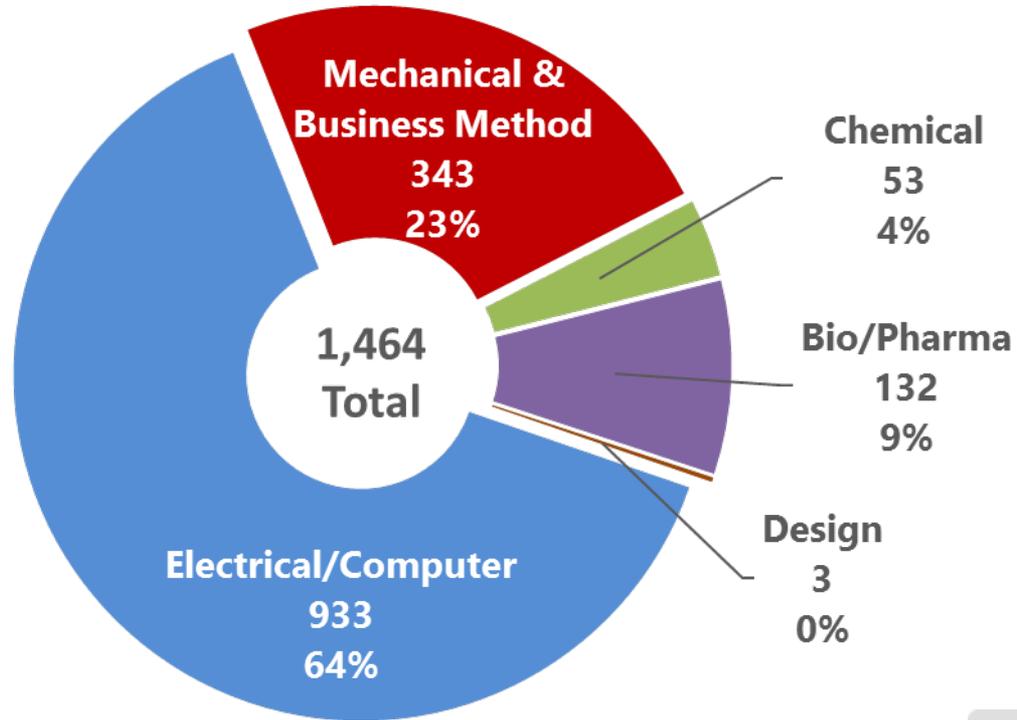
Petitions by trial type (all time: Sept. 16, 2012 to Sept. 30, 2019)



Trial types include Inter Partes Review (IPR), Post Grant Review (PGR), and Covered Business Method (CBM).



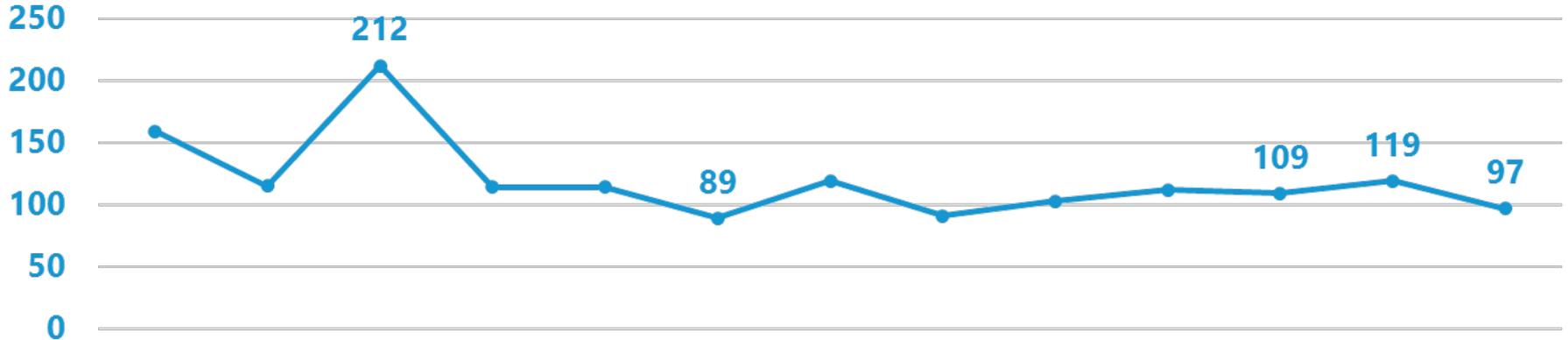
Petitions filed by technology in FY19 (FY19: Oct. 1, 2018 to Sept. 30, 2019)



Petitions filed by month

(Sept. 2019 and Previous 12 Months: Sept. 1, 2018 to Sept. 30, 2019)

(1,394 IPRs in FY19)



Sep-18

IPR

Sep-19

(48 PGRs in FY19)



Sep-18

PGR

Sep-19

(22 CBMs in FY19)



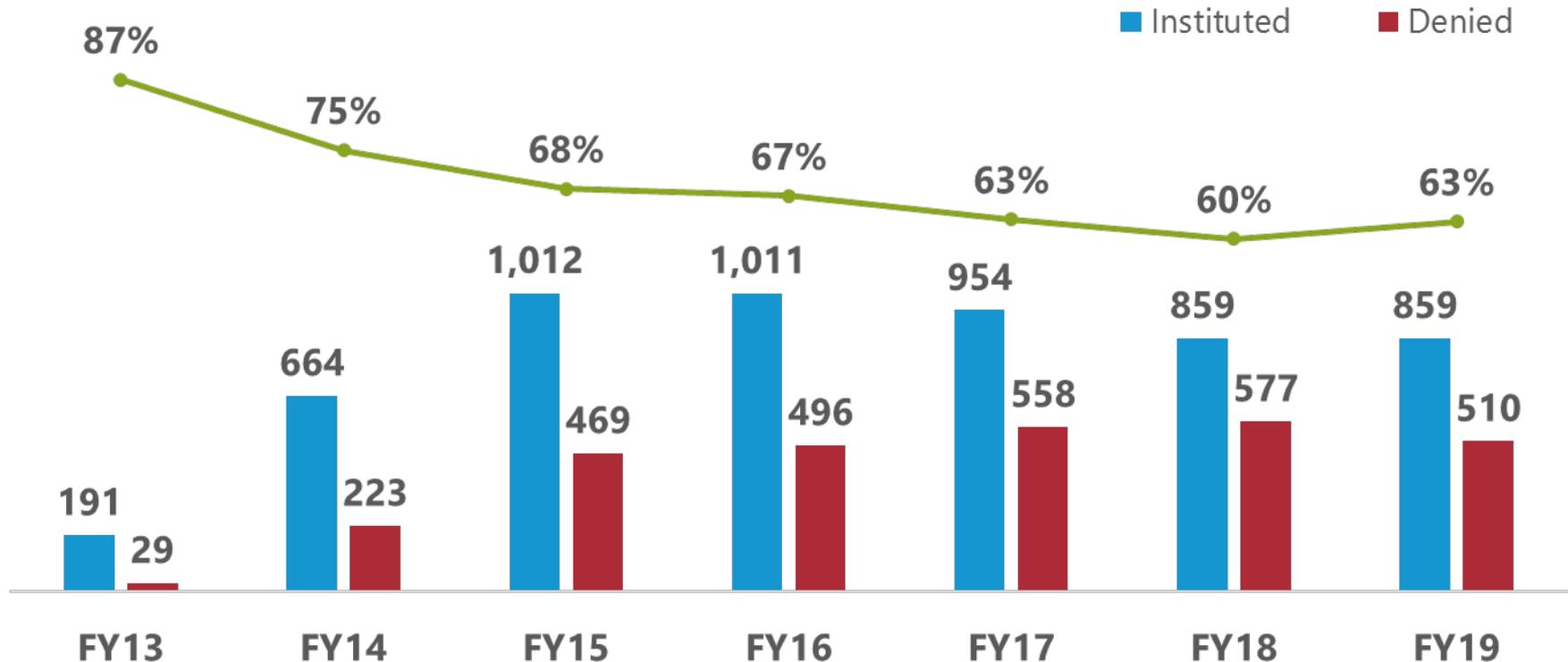
Sep-18

CBM

Sep-19



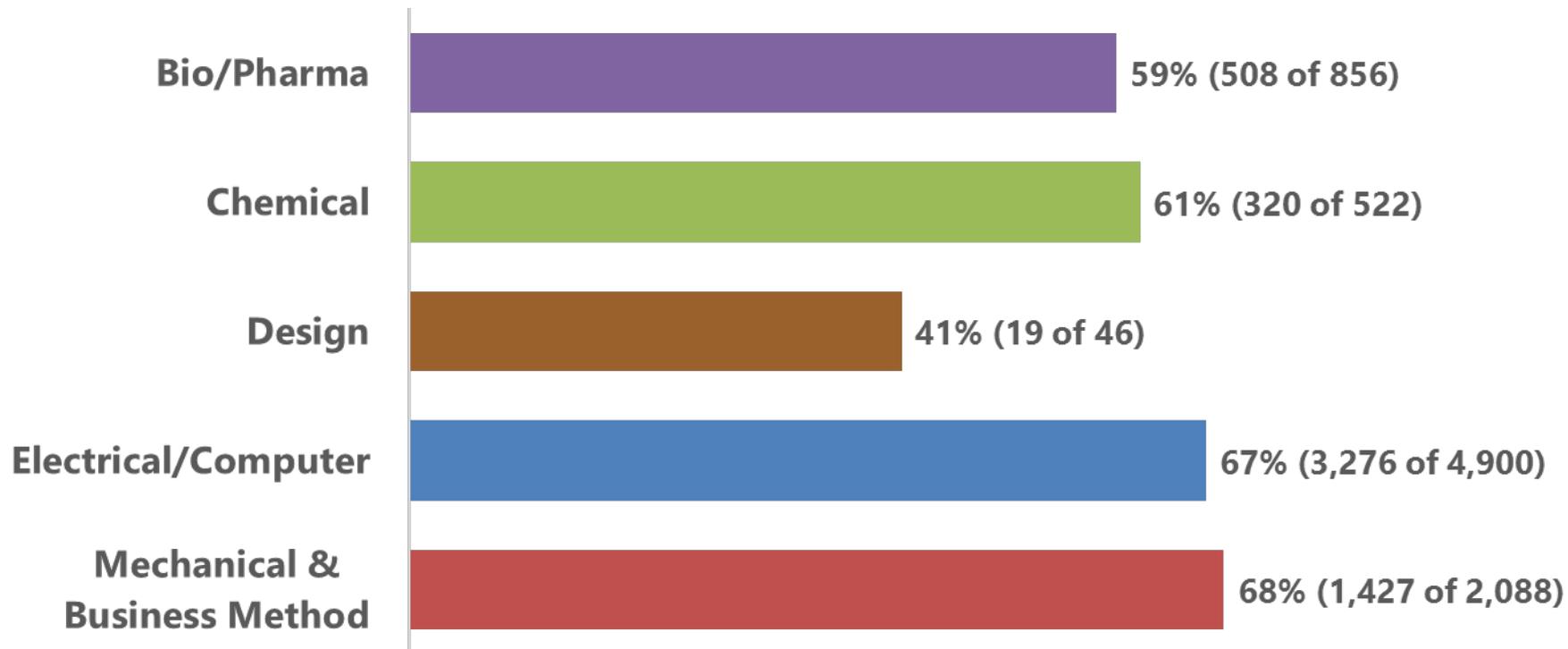
Institution rates (FY13 to FY19: Oct. 1, 2012 to Sept. 30, 2019)



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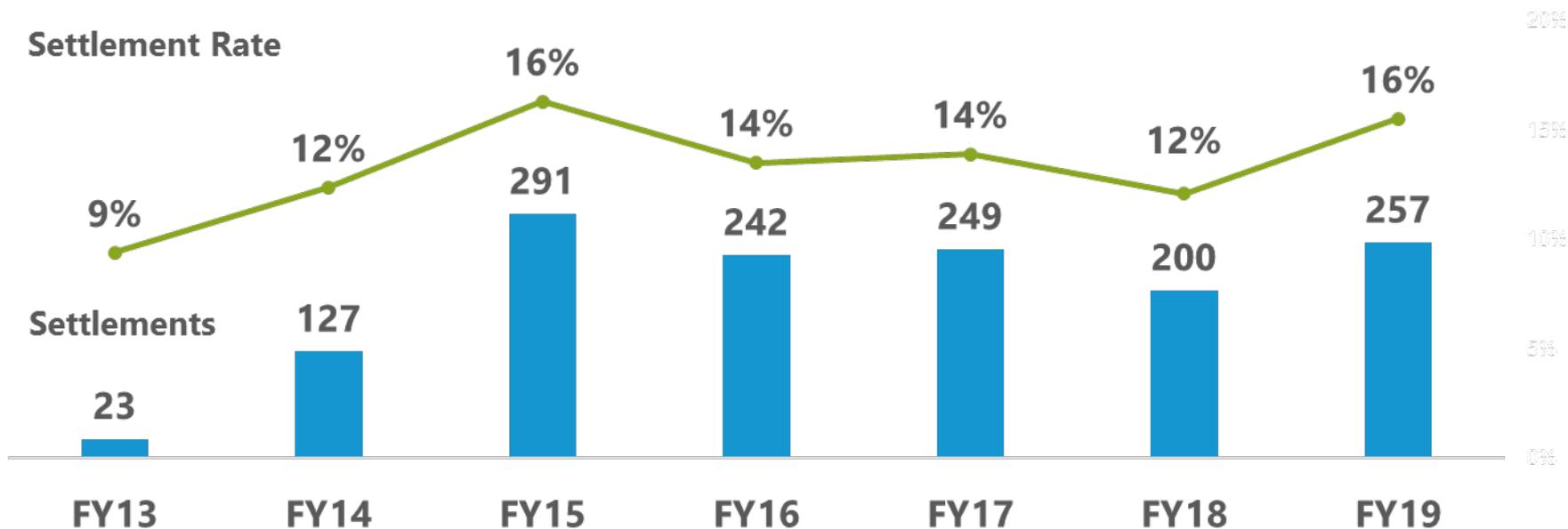
Institution rates by technology

(All Time: Sept. 16, 2012 to Sept. 30, 2019)



Institution rate for each technology is calculated by dividing petitions instituted by decisions on institution (i.e., petitions instituted plus petitions denied). The outcomes of decisions on institution responsive to requests for rehearing are excluded.

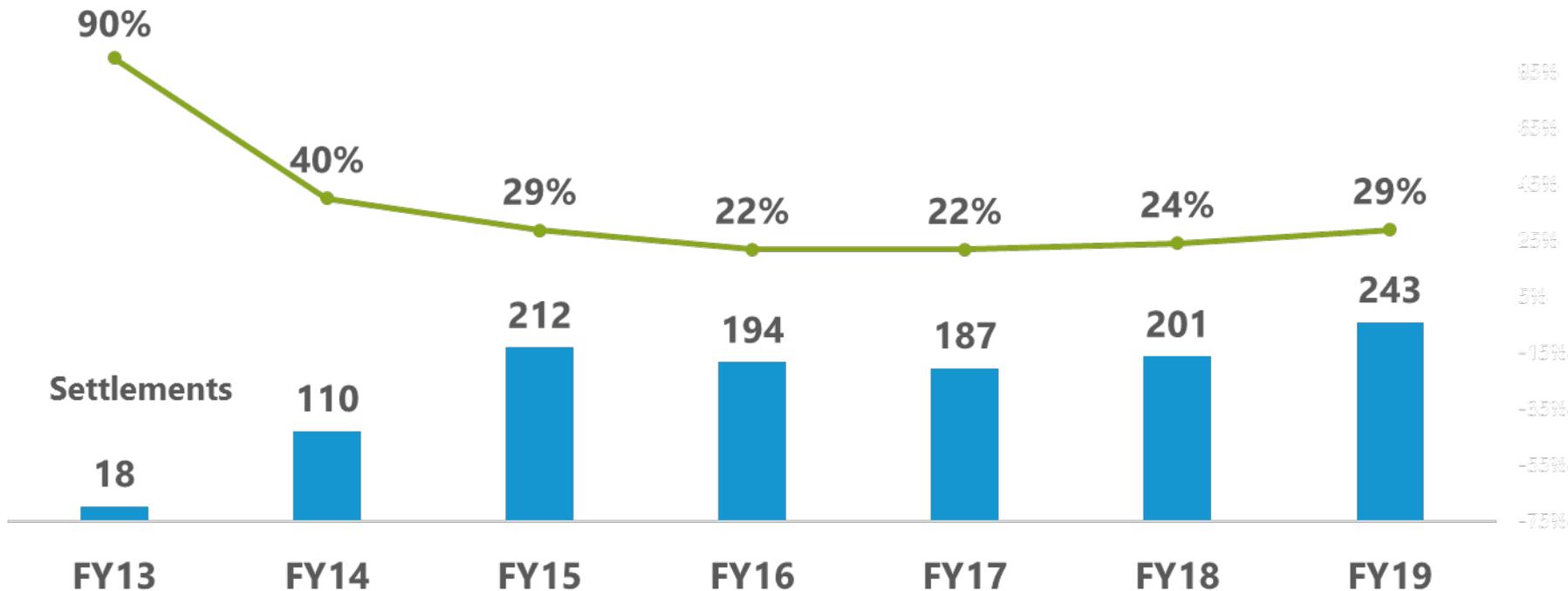
Pre-institution settlements (FY13 to FY19: Oct. 1, 2012 to Sept. 30, 2019)



Settlement rate for each year is calculated by dividing pre-institution settlements by the sum of proceedings instituted, denied institution, dismissed, terminated with a request for adverse judgment, and settled before decision on institution.

Post-institution settlements (FY13 to FY19: Oct. 1, 2012 to Sept. 30, 2019)

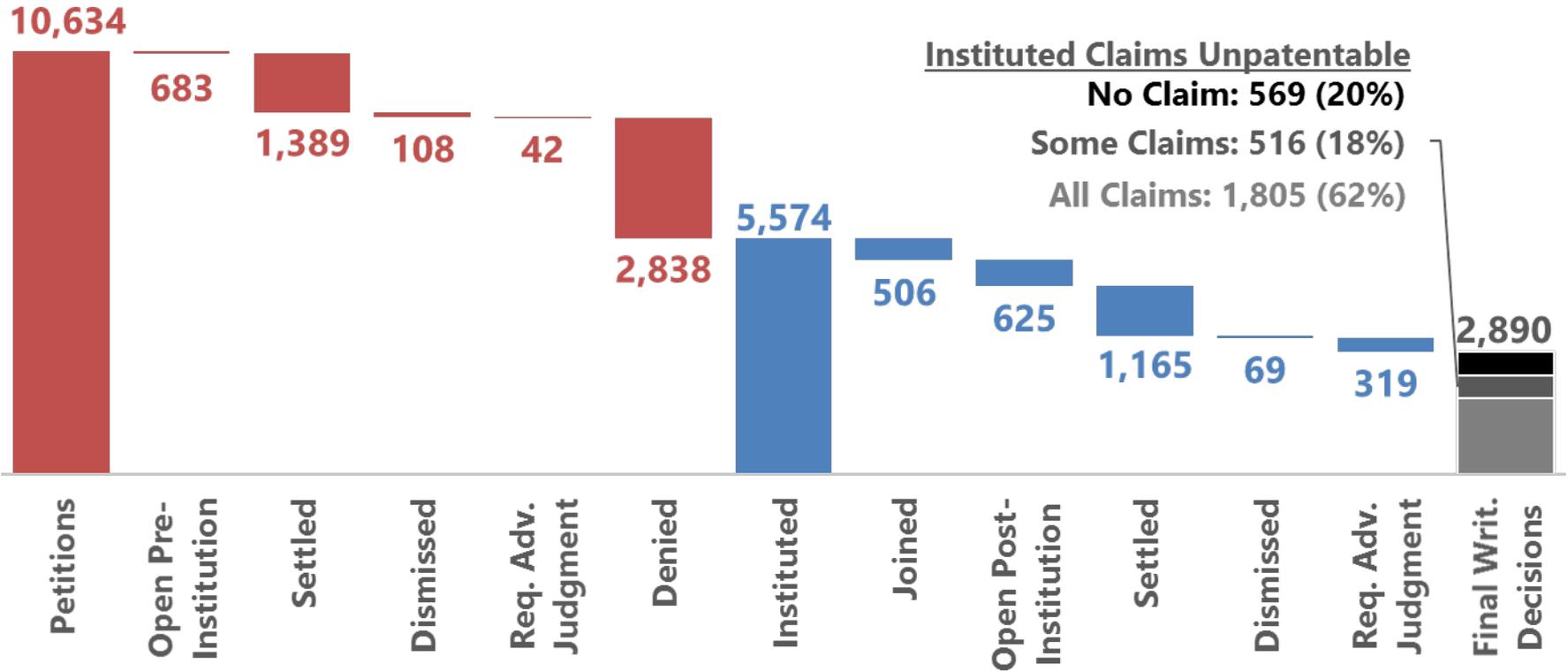
Settlement Rate



Settlement rate for each year is calculated by dividing post-institution settlements by proceedings terminated post-institution (i.e., settled, dismissed, terminated with a request for adverse judgment, and final written decision), excluding joined cases.



Status of petitions (All Time: Sept. 16, 2012 to Sept. 30, 2019)



These figures reflect the latest status of each petition. The outcomes of decisions on institution responsive to requests for rehearing are incorporated. Once joined to a base case, a petition remains in the Joined category regardless of subsequent outcomes.



Questions and comments

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