Patent Quality Chat
AIA Trial Statistics from PTAB
and Using AIA Trials to Enhance Patent Examination
August 14, 2018

Email questions to PatentQuality@uspto.gov
To send in questions or comments during the webinar, please email:

**PatentQuality@uspto.gov**
Patent Quality

Providing high-quality, efficient examination of patent applications is paramount to our mission at USPTO. To ensure we continue to issue high-quality patents that will fuel innovation well into the future, the Office of the Deputy Commissioner for Patent Quality, along with our partners across the Patents organization, promotes and supports the continuous improvement of patent products, processes and services through collaboration with internal and external stakeholders of the intellectual property community.

Highlights

**Patent Quality Chat**

Our next Patent Quality Chat will be on August 14th on “AIA Trial Statistics from PTAB and Using AIA Trials to Enhance Patent Examination.”

**Quality Metrics**

See our new metrics approach, categorizing into product, process and perception indicators.

**Stakeholder Training on Examination Practice and Procedure (STEPP)**

Sign up for an upcoming training developed for those interested in a better understanding of the examination process at the USPTO.

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### 2018 Chat Series

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<tr>
<th>Date</th>
<th>Topic</th>
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| Tuesday, August 14    | AIA Trial Statistics from PTAB and Using AIA Trials to Enhance Patent | • **Janet Gongola**  
                        | Examination                                                           |  
| Noon - 1 p.m. ET     |                                                                       | Vice Chief Judge for Engagement, Patent Trial and Appeal Board                                     |
|                       |                                                                       | • **Jack Harvey**  
                        |                                                                       |  
|                       |                                                                       | Assistant Deputy Commissioner for Patent Operations                                              |
|                       |                                                                       | **Speakers**                                                                                                                                               |
| Tuesday, July 10      | Improving Access to Global Patent Data                                 | • Nelson Yang  
                        | Noon - 1 p.m. ET                                                      |  
|                       |                                                                       | Acting Director of International Patent Business Solutions in the Office of International Patent  |
|                       |                                                                       | Cooperation                                                                                       |
|                       |                                                                       | • Jocelyn Ram  
                        |                                                                       |  
|                       |                                                                       | Patent Business Analyst in the Office of International Patent Cooperation                         |

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Patent Quality Chat
AIA Trial Statistics from PTAB and Using AIA Trials to Enhance Patent Examination

Janet Gongola
Vice Chief Judge for Engagement, Patent Trial and Appeal Board

Jack Harvey
Assistant Deputy Commissioner for Patent Operations, Office of the Commissioner for Patents

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Patent Trial and Appeal Board (PTAB) - Overview

• AIA Trial Statistics
• Upcoming Studies
• Recent AIA Trial Developments
Petitions by Trial Type
(All Time: 9/16/12 to 7/31/18)

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

- IPR: 8,190 (92%)
- CBM: 557 (6%)
- PGR: 127 (2%)

Total: 8,874

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Petitions Filed by Technology in FY18
(FY18 to date: 10/1/17 to 7/31/18)

- Mechanical & Business Method: 293 (22%)
- Electrical/Computer: 800 (61%)
- Bio/Pharma: 142 (11%)
- Chemical: 80 (6%)
- Design: 2 (0%)

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Petitions Filed by Month
(July 2018 and Previous 12 Months: 7/1/17 to 7/31/18)

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The rule to allow new testimonial evidence was effective May 2, 2016.
Institution Rates
(FY13 to FY18: 10/1/12 to 7/31/18)

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.

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Institution Rates by Technology
(All Time: 9/16/12 to 7/31/18)

- **Bio/Pharma**: 60% (419 of 695)
- **Chemical**: 64% (291 of 453)
- **Design**: 41% (17 of 41)
- **Electrical/Computer**: 68% (2,700 of 3,974)
- **Mechanical & Business Method**: 69% (1,147 of 1,672)

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.

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Pre-Institution Settlements
(FY13 to FY18: 10/1/12 to 7/31/18)

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.

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Post-Institution Settlements
(FY13 to FY18: 10/1/12 to 7/31/18)

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.

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Motions to Amend Filed by Fiscal Year
(FY13 to FY18: 10/1/12 to 3/31/18)

Filings in the first half of FY18 (post-Aqua Products) have exceeded the entire previous fiscal year.

<table>
<thead>
<tr>
<th>Fiscal Year</th>
<th>Filings</th>
</tr>
</thead>
<tbody>
<tr>
<td>FY13</td>
<td>49</td>
</tr>
<tr>
<td>FY14</td>
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<tr>
<td>FY15</td>
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<tr>
<td>FY17</td>
<td>50</td>
</tr>
<tr>
<td>FY18</td>
<td>54</td>
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</tbody>
</table>

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Reasons for Denial of Motions to Amend (FY13 to FY18: 10/1/2012-3/31/2018)

All Reasons

- Procedural: 12%
- Statutory: 88%

Statutory Reasons

- §101: 8%
- Multiple: 27%
- §102, §103: 46%
- §112: 11%
- §316: 8%

* All but one of the cases in which multiple statutory reasons were provided for denying entry of substitute claims included §§ 102, 103 and/or 112 as a reason for denial.

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Status of Petitions
(All Time: 9/16/12 to 7/31/18)

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.

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Parallel Proceeding Study

• Goal = explore the interaction between parallel proceedings at the USPTO (e.g., AIA trials, reexam, and reissue) involving issued patents

• Joint effort between PTAB and Central Reexamination Unit (CRU)

• Study will consider:
  – Number of proceedings filed against each patent;
  – Identity of the party filing each proceeding;
  – Timing of each proceeding; and
  – Whether any proceeding is/was stayed pending outcome of the AIA trial

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Section 325(d) Study

• Goals
  – Evaluate the extent to which AIA proceedings are revisiting issues previously addressed by the USPTO;
  – Understand the reasons for the different results in cases with fully or partially overlapping art, with those results perhaps usable to improve original prosecution; and
  – Assess why panels do or do not accept § 325(d) arguments

• Coordinating with Patents

• Study uses cases in which a patent owner raised a § 325(d) argument as a proxy for the set of cases in which similar or the same issues might exist

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Claim Construction Notice of Proposed Rule Making (NPRM)
83 Fed. Reg. 21,221 (May 9, 2018)

• Proposed to apply the same claim construction standard in an AIA trial proceeding as that used in a civil action to invalidate a patent

• Also proposed that PTAB will consider any prior claim construction determination concerning a term of the claim in a civil action, or a proceeding before the International Trade Commission, that is timely made of record

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Claim Construction NPRM con’t
83 Fed. Reg. 21,221 (May 9, 2018)

• Public comments were due on or before July 9

• 374 comments received:
  • 297 from individuals;
  • 45 from associations;
  • 31 from corporations; and
  • 1 from a law firm

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Trial Practice Guide,

- Provide further guidance about standard practices during AIA trials, accounting for almost six years of experience with trials
- Original Trial Practice Guide published in August 2012, concurrent with the promulgation of the AIA Trial Rules
- May be additional updates in the future

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Trial Practice Guide - Highlights

(August 2018 Update)

• Use of expert testimony;

• Consideration of various non-exclusive factors in the determination of whether to institute a trial;

• Sur-replies to principal briefs as a matter of right;

• Distinction between motions to exclude and motions to strike, and the proper use of each;

• Procedures for oral hearing before the Board, including the use of live testimony, sur-rebuttal, and default time for the hearing; and

• Pre-hearing conference and potential early resolution of issues

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Learn More about PTAB

https://www.uspto.gov/patents-application-process/patenttrialandappealboard
Post Grant Outcomes Program - Overview

- AIA Proceedings Overview
- Examiner Navigation and Usage
- Post Grant Outcomes Statistics

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AIA Proceedings: Overview

On September 16, 2012, the America Invents Act (AIA) established four new Patent Trial and Appeal Board (PTAB) proceedings:

- Inter Partes Review (IPR),
- Post Grant Review (PGR),
- Transitional Program for Covered Business Method Patents (CBM), and
- Derivation (DER).

These proceedings allow third-party petitioners to challenge claims in an issued patent at the PTAB without resorting to litigation.

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AIA Proceedings: The Petition

- Each type of AIA proceeding (IPR, PGR, CBM, and DER) begins with the filing of a petition for instituting a trial.

- For examiners of related applications (i.e., CONs, CIPs, DIVs), there may be prior art in the petition that will lead to a more informed patentability decision in the related application(s) currently pending before them.

- The Post Grant Pilot revealed that IPR petitions are highly relevant for locating prior art for use in related child applications.

- Petitions in AIA proceedings are accessed using the Patent Trial and Appeal Board End-to-End system (PTAB-E2E).

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Examiner Notification

• To bring the AIA trial petitions to the examiner, the examiners’ docket management tool, PE2E-DAV, has been updated to include an indicator to notify examiners whenever they have a case related to an issued patent undergoing an AIA trial.

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New Indicator

• When an application is opened in PE2E-DAV, the orange colored IPR box in the top center of the image below is visible if an AIA petition has been filed in a related patent.

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Two Level Notification

• Also, under the Application Data tab, the orange View IPR tab box is highlighted
Accessing the Trial Proceedings

• Clicking either orange button opens a new window listing all AIA trials in related patents:

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Accessing PTAB-E2E

• The link in the “PTAB Proceeding #” column leads directly to the contents of the corresponding AIA trial in PTAB-E2E:

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Accessing the Petition

- The Petition is usually among the first documents in the file wrapper.
- By selecting Download, the Petition will open as a PDF.

<table>
<thead>
<tr>
<th>Document Name</th>
<th>Document Type</th>
<th>Exhibit/Paper Number</th>
<th>Filing Date</th>
<th>Filing Party</th>
<th>Availability</th>
</tr>
</thead>
<tbody>
<tr>
<td>Petition for Inter Partes Review of U.S. Patent No.</td>
<td>PAPER</td>
<td>1</td>
<td>02/27/2015</td>
<td>petitioner</td>
<td>PUBLIC</td>
</tr>
</tbody>
</table>

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Navigating the Petition

Petitions can be long, but the Post Grant Outcomes pilot revealed that examiners found the following sections to be particularly useful:

• Exhibit List
• Detailed Explanations of the Challenges

The Exhibit List features all the documents (e.g., Patents, Printed Publications, expert declarations) being used to challenge the claims in the issued patent.

• PDFs of each of the exhibits are available in the PTAB E2E file wrapper:

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Other Relevant Documents in the AIA Trial File Wrapper

- In addition to the Petition, the Post Grant Outcomes pilot revealed that examiners found **Expert Declarations** helpful for understanding the state of the art.
- Not all AIA Trials will have an expert declaration.
Petitioner’s Relevance Exhibit

- Often times petitioners add a detailed chart on how their submitted art reads on the patented claims

<table>
<thead>
<tr>
<th>Ground</th>
<th>35 USC</th>
<th>Index of References</th>
<th>Claims</th>
</tr>
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<tbody>
<tr>
<td>1</td>
<td>§ 102</td>
<td>Smith</td>
<td>61-65</td>
</tr>
<tr>
<td>2</td>
<td>§ 103</td>
<td>Smith in view of Carr</td>
<td>1-4, 9, 10, 13, 17, 19-23, 27, 29, 44-46 and 53</td>
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</table>
High Level Statistics from the Post Grant Outcome Program

• To date, over 1400 AIA trial proceedings have been linked to related applications undergoing examination.

• In a random sample of these related applications, nearly 50% of examiners cited at least one prior art reference from the AIA trial in their Office action – citing it either of record or in a rejection.

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Learn More…

• Post Grant Outcomes
  https://www.uspto.gov/patent/initiatives/post-grant-outcomes

• Post Grant Outcomes Pilot
  https://www.uspto.gov/patent/initiatives/post-grant-outcomes-pilot

• Contact Us
  PostGrantOutcomes@uspto.gov

Email questions to PatentQuality@uspto.gov
Let’s Chat about
AIA Trial Statistics from PTAB and
Using AIA Trials to Enhance
Patent Examination

Janet Gongola
Vice Chief Judge for Engagement, Patent Trial and Appeal Board

Jack Harvey
Assistant Deputy Commissioner for Patent Operations, Office of the Commissioner for Patents

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Next Patent Quality Chat
TBD

September 11, 2018

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Other Patent Quality-Related Events

[https://www.uspto.gov/about-us/events](https://www.uspto.gov/about-us/events)

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<th>Location</th>
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<td>August 17-18</td>
<td>Invention-Con 2018 (in Alexandria)</td>
<td></td>
</tr>
<tr>
<td>Sept 24</td>
<td>Biotechnology/Chemical/Pharmaceutical Customer Partnership (in Alexandria and virtual)</td>
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Thank you for joining us today!

Patent Quality Chat
Webinar Series 2018
August 14, 2018

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