Chat with the Chief

New PTAB Studies in AIA Proceedings: Expanded Panels and Trial Outcomes for Orange Book-listed Patents

David P. Ruschke
Chief Administrative Patent Judge

Michelle N. Ankenbrand
Lead Administrative Patent Judge

Jason Repko
Administrative Patent Judge

March 13, 2018
Agenda

• Expanded Panel Study (Chief and Lead Judge Ankenbrand)
  • Questions

• Orange Book-Listed Patent Study (Chief and Judge Repko)
  • Questions
Expanded Panel Study
SOP 1: Reasons for Panel Expansion

• Chief has discretion to expand a panel per authority delegated from Director

• Expanded panel is rare and “ordinarily will not be used”

• Reasons for expanding a panel:
  • Issue of exceptional importance (Guidance)
  • Maintain uniformity of Board decisions (Consistency)
  • Written request from Commissioner for Patents or the Commissioner’s delegate identifying an issue:
    o Of first impression; or
    o Governed by a prior Board decision where Commissioner has determined it would not be in the public interest to follow the prior Board decision
SOP 1: Suggestion for Panel Expansion

- Who may suggest the need for the designation of an expanded panel?
  - Judge
  - Merits panel
  - Interlocutory panel
  - Applicant or patent owner in an \textit{ex parte} appeal
  - Party in an \textit{inter partes} reexam, interference, or AIA trial

- Suggestion must be in writing with reasons and basis for expansion
Current Expanded Panel Practice

• Current panel expansion practice ensures:
  • Predictable and uniform application of agency policy
  • Similarly situated parties, under the same facts, are treated the same
  • Notice to the public

• Current preferred panel expansion practice (see General Plastic):
  • All expanded panel decisions include Chief Judge and Deputy Chief Judge
  • All expanded panel decisions explain the basis for expansion
  • Panel expanded without changing the underlying result
    • Emphasizes the underlying result or reasoning to provide guidance
  • Potential designation of decision as informative, and
  • May consider the decision for precedential designation

• Early AIA practice expanded panels in families for case resource management
  • Now discontinued
What Did PTAB Study?

• **Question 1:** How common are expanded panels?

• **Question 2:** When were panels expanded?

• **Question 3:** Why were panels expanded?

• **Question 4:** What was the result of the expansion?
Methodology

• Reviewed IPR, PGR, and CBM proceedings filed on or before 12/31/2017, which covers 7,930 Petitions and their associated:
  • 6,033 Decisions on Institution
  • 1,912 Final Written Decisions
  • Thousands of Interlocutory Orders

• Used a manual process to identify expanded panel decisions

• Excluded families in which the panel was expanded for case resource management
  • Example: Apple Inc. v. Smartflash LLC – 14 individual cases all administered by a 4-or 5-judge panel (see Case CBM2014-00102, et al.)
Highlights

• Expanded panels are very rare

• Most expanded panel decisions issued as original decisions, not decisions on rehearing

• Panels were expanded for guidance and consistency:
  • to provide forward-looking guidance on reoccurring issues; and/or
  • to treat similarly situated parties the same

• Underlying result remained the same after panel expansion on rehearing, except for Target and Nidec, both of which address same-party joinder
Question 1:
How Common Are Expanded Panels?
Expanded Panels Are Rare
(7930 Total Petitions through 12/31/2017)

- Decision on Institution (DI): 13
- Rehearing DI: 10
- Interlocutory Order: 31
- Final Written Decision: 0
- Multiple Stages: 5

- 23 out of 6,033 Decisions on Institution
- 31 out of thousands of Orders
- 0 out of 1,912 Final Written Decisions
Question 2: When Were Panels Expanded?
Majority of Panels Were Expanded In Original Decision

• About 80% of panels expanded in original decision

• About 20% of panels expanded on request for rehearing
Question 3:
Why Were Panels Expanded?
Panels Were Expanded For Guidance and Consistency (Individual Cases)

- DI - Statutory Interpretation: 21
- DI - Petition Requirements: 5
- Motion Procedure: 4
- Sanctions: 12
- Sovereign Immunity: 7
- Request of PTAB Panel: 10
## Reason 1: DI Procedure – Statutory Interpretation Issues

<table>
<thead>
<tr>
<th>Specific Issue Addressed</th>
<th>Number of Individual Cases</th>
<th>Lines of Cases</th>
</tr>
</thead>
<tbody>
<tr>
<td>35 U.S.C. § 314(a) multiple petitions</td>
<td>5</td>
<td>1</td>
</tr>
<tr>
<td>35 U.S.C. § 315(b) time bar</td>
<td>3</td>
<td>2</td>
</tr>
<tr>
<td>35 U.S.C. § 315(b) and real party in interest</td>
<td>5</td>
<td>1</td>
</tr>
<tr>
<td>35 U.S.C. § 315(c) same-party joinder</td>
<td>6</td>
<td>2</td>
</tr>
<tr>
<td>35 U.S.C. § 325(d) same art or arguments</td>
<td>1</td>
<td>1</td>
</tr>
<tr>
<td>AIA § 18 CBM pre-institution disclaimer</td>
<td>1</td>
<td>1</td>
</tr>
<tr>
<td><strong>Total</strong></td>
<td><strong>21</strong></td>
<td><strong>8</strong></td>
</tr>
</tbody>
</table>
Reason 1: Recent Example Expanded Panel Decisions

- **314(a) Multiple Petitions: General Plastic v. Canon**, Case IPR2016-01357, -01358, -01359, -01360, -01361 (PTAB Sept. 6, 2017) (Paper 19) (precedential) (vote from 3-0 to 7-0 with expansion on rehearing)
  - Emphasizes the factors that the Board considers in deciding whether to exercise its discretion to deny a follow-on Petition in an AIA proceeding under 35 U.S.C. § 314(a).

- **325(d) Similar Art/Arguments: Neil Ziegmann v. Carlis G. Stephens**, Case IPR2015-01860 (PTAB Sept. 6, 2017) (Paper 13) (vote from 3-0 to 5-0 with expansion on rehearing)
  - Emphasizes that prior art or arguments may be considered “substantially the same” under 35 U.S.C. § 325(d) if they are “cumulative to or substantially overlap with issues previously considered by the Office with respect to the patent.”

- **CBM Pre-Institution Disclaimer: Facebook v. Skky**, Case CBM2016-00091 (PTAB Sept. 28, 2017) (Paper 12) (precedential) (vote from 3-0 to 5-0 with expansion on rehearing)
  - Emphasizes that CBM patent review eligibility is determined based on the claims of the challenged patent as they exist at the time of the decision to institute, and that statutorily disclaimed claims must be treated as if they never existed for the purpose of institution.
## Reason 2: DI Procedure – Petition Requirements

<table>
<thead>
<tr>
<th>Specific Issue Addressed</th>
<th>Number of Individual Cases</th>
<th>Lines of Cases</th>
</tr>
</thead>
<tbody>
<tr>
<td>Corrected Petition untimely, no excuse</td>
<td>2</td>
<td>1</td>
</tr>
<tr>
<td>Petition insufficient under 37 C.F.R. § 42.104</td>
<td>2</td>
<td>2</td>
</tr>
<tr>
<td>Petition sets forth redundant grounds</td>
<td>1</td>
<td>1</td>
</tr>
<tr>
<td><strong>Total</strong></td>
<td><strong>5</strong></td>
<td><strong>4</strong></td>
</tr>
</tbody>
</table>
## Reason 3: Motion Procedure

<table>
<thead>
<tr>
<th>Specific Issue Addressed</th>
<th>Number of Individual Cases</th>
<th>Lines of Cases</th>
</tr>
</thead>
<tbody>
<tr>
<td>Motion to amend requirements</td>
<td>2</td>
<td>2</td>
</tr>
<tr>
<td>Motion for pro hac vice requirements</td>
<td>2</td>
<td>2</td>
</tr>
<tr>
<td><strong>Total</strong></td>
<td><strong>4</strong></td>
<td><strong>4</strong></td>
</tr>
</tbody>
</table>
### Reason 4: Sanctions

<table>
<thead>
<tr>
<th>Specific Issue Addressed</th>
<th>Number of Individual Cases</th>
<th>Lines of Cases</th>
</tr>
</thead>
<tbody>
<tr>
<td>PTAB may impose sanctions for continued course of conduct</td>
<td>7</td>
<td>2</td>
</tr>
<tr>
<td>Denying motion for sanctions alleging abuse of process</td>
<td>5</td>
<td>1</td>
</tr>
<tr>
<td><strong>Total</strong></td>
<td><strong>12</strong></td>
<td><strong>3</strong></td>
</tr>
</tbody>
</table>
Reason 4: Recent Example Expanded Panel Decisions

  - Parties were not authorized to request a teleconference or file papers on the merits of the cases, which had been terminated with all appeals exhausted.
Reason 5: Constitutional Issue

• Sovereign immunity (7 individual cases, 2 lines of cases)

• Recent Example Expanded Panel Decisions
  • *LSI Corporation v. Regents of the University of Minnesota*, Case IPR2017-01068 (PTAB Dec. 19, 2017) (Paper 19) (6-1 decision)
  • *Ericsson, Inc. v. Regents of the University of Minnesota*, Case IPR2017-01186, -01197, -01200, -01213, -01214, -01219 (PTAB Dec. 19, 2017) (Paper 14) (6-1 expanded panel decision)
    – Panels expanded in all 7 proceedings to address whether a patent owner can invoke and waive sovereign immunity in an AIA proceeding, and to ensure uniformity in decision as to the same patent owner.
Reason 6: Request of PTAB Panel

• Ensure consistent application of 35 U.S.C. § 112(f) (10 individual cases, 1 line of cases)

• Recent Example Expanded Panel Decision
    – Original panel suggested expansion to maintain uniformity due to substantial difference of opinion among the judges on a group of 10 related cases regarding an issue arising under 35 U.S.C. § 112(f).
Question 4:
What Was The Result of the Expansion If On Rehearing?
Expanded Panels Reach Same Underlying Result

- Exception: *Target* and *Nidec*
- Both addressed same-party joinder
- Both were decided more than 3 years ago
- Both were expanded to ensure consistency
  - All decisions pre-*Target* permitted same-party joinder
  - All decisions post-*Nidec* have permitted same-party joinder
Expanded Panels Reach Same Underlying Result

• Exception: *Target* and *Nidec*

• Both addressed same-party joinder

• Both were decided more than 3 years ago

• Both were expanded to ensure consistency
  • All decisions pre-*Target* permitted same-party joinder
  • All decisions post-*Nidec* have permitted same-party joinder
Recap

• Expanded panels are very rare

• Most expanded panel decisions issued as original decisions, not decisions on rehearing

• Panels were expanded for guidance and consistency:
  • to provide forward-looking guidance on reoccurring issues; and/or
  • to treat similarly situated parties the same

• Underlying result remained the same after panel expansion on rehearing, except for Target and Nidec, both of which address same-party joinder
Questions?
Orange Book-listed Patent Study
What Are Orange Book-listed Patents?

• Short-hand for patents covering FDA-approved drug products that are listed in the publication Approved Drug Products With Therapeutic Equivalence Evaluations (commonly known as the Orange Book)

• Orange Book-listed patents are governed under the provisions of the Hatch-Waxman Act, which created an abbreviated regulatory approval pathway for generic drug products
What Is the Hatch-Waxman Act?

• Allows a generic company to secure quicker FDA approval without repeating expensive and lengthy clinical trials that were conducted on brand drug

• In exchange, a generic company must certify to FDA that:
  • Generic version of approved drug will not interfere with any patents that branded pharmaceutical company has listed in the Orange Book; or
  • Patents that branded pharmaceutical company has listed in the Orange Book are not infringed and/or invalid
Highlights

• 83% of all petitions challenging Orange Book-listed patents result in patent being unchanged by PTAB

• The cumulative institution rate for Orange Book petitions (66%) is essentially the same as the cumulative overall institution rate (68%)

• Just over half of all final written decisions for petitions challenging Orange Book-listed patents find all claims patentable

• 80% of all challenged Orange Book-listed patents have 1 or 2 petitions, compared to 87% of all challenged patents

• 85% of all challenged Orange Book-listed patents have 1 or 2 petitioners, compared to 94% of all challenged patents
Methodology

• PTAB classified a petition as challenging an Orange Book-listed patent by comparing the petition’s filing date with data from the FDA’s electronic Orange Book indicating when the patent was listed.

• Statistics depict data through the end of FY 2017.

• Unless otherwise noted, statistics were calculated the same way as the monthly trial statistics published on PTAB’s website: https://www.uspto.gov/patents-application-process/appealing-patent-decisions/statistics/aia-trial-statistics
What Did PTAB Study?

- **Question 1:** What are the filing trends for petitions challenging Orange Book-listed patents?

- **Question 2:** How does the institution rate on petitions challenging Orange Book-listed patents compare to those of other technologies?

- **Question 3:** What are the outcomes of challenges to Orange Book-listed patents?

- **Question 4:** What is the status of every petition ever filed that challenged an Orange Book-listed patent?

- **Question 5:** What is the status of each challenged Orange Book-listed patent when the results of multiple challenges are combined?
Question 1: What are the filing trends for petitions challenging Orange Book-listed patents?
Petitions Filed by Technology
(as of End FY17: 9/16/12 to 9/30/17)

- Mechanical & Business Method: 1,793 (24%)
- Electrical/Computer: 4,462 (59%)
- Chemical: 488 (6%)
- Design: 42 (1%)
- Misc. Bio/Pharma: 383 (5%)
- Orange Book: 389 (5%)

Includes all trial types.
Petitions Filed by Technology in FY17 Only
(FY17: 10/1/16 to 9/30/17)

- Electrical/Computer: 1,122 (59%)
- Mechanical & Business Method: 417 (22%)
- Chemical: 126 (7%)
- Design: 14 (1%)
- Misc. Bio/Pharma: 142 (7%)
- Orange Book: 80 (4%)

Includes all trial types.
No petitions challenging Orange Book-listed patents were filed in FY12.
Petitions Challenging Orange Book-listed Patents Filed by Month
(September 2017 and Previous 12 Months: 9/1/16 to 9/30/17)

(78 IPRs in FY17)

(2 PGRs in FY17)
Question 2: How does the institution rate on petitions challenging Orange Book-listed patents compare to those of other technologies?
Institution Rates by Technology
(As of End FY17: 9/16/12 to 9/30/17)

<table>
<thead>
<tr>
<th>Technology</th>
<th>Rate (Apps of Total)</th>
</tr>
</thead>
<tbody>
<tr>
<td>Mechanical &amp; BM</td>
<td>70% (958 of 1,376)</td>
</tr>
<tr>
<td>Electrical/Computer</td>
<td>69% (2,256 of 3,270)</td>
</tr>
<tr>
<td>Chemical</td>
<td>68% (251 of 369)</td>
</tr>
<tr>
<td>Overall</td>
<td>68% (3,833 of 5,607)</td>
</tr>
<tr>
<td>Orange Book</td>
<td>66% (211 of 318)</td>
</tr>
<tr>
<td>Misc. Bio/Pharma</td>
<td>60% (141 of 234)</td>
</tr>
<tr>
<td>Design</td>
<td>40% (16 of 40)</td>
</tr>
</tbody>
</table>
Question 3: What are the outcomes of challenges to Orange Book-listed patents?
Status of Instituted Claims in Final Written Decisions
(As of End FY17: 9/16/12 to 9/30/17)

**Orange Book-listed Patents**
- No Claims Patentable: 38 (46%)
- All Claims Patentable: 42 (51%)
- Some Claims Patentable: 2 (3%)

82 Total FWDs

**All Other Technologies**
- No Claims Patentable: 1,115 (66%)
- Some Claims Patentable: 285 (17%)
- All Claims Patentable: 289 (17%)

1,689 Total FWDs
Outcomes for Petitions Challenging Orange Book-listed Patents
(as of End FY17: 9/16/12 to 9/30/17)

268 Petitions

- Patent Unchanged By PTAB: 222 (83%)
- Patent Owner Requests Adverse Judgment: 6 (2%)
  - PTAB Finding Some Instituted Claims Unpatentable: 2 (1%)
  - PTAB Finding All Instituted Claims Unpatentable: 38 (14%)

The patent being unchanged by PTAB includes final written decisions with all claims patentable, settlements, dismissals, and petitions denied institution.
Outcomes for Petitions Challenging Orange Book-listed Patents
(As of End FY17: 9/16/12 to 9/30/17)

“By petition” accounts for whether a particular petition results in any unpatentable claims
“By patent” accounts for whether any one petition against a particular patent results in any unpatentable claims
Question 4:
What is the status of every petition ever filed that challenged an Orange Book-listed patent?
### Status of Petitions Challenging Orange Book-listed Patents
(as of End FY17: 9/16/12 to 9/30/17)

<table>
<thead>
<tr>
<th>Petition Status</th>
<th>Orange Book</th>
<th>All Other Technologies</th>
</tr>
</thead>
<tbody>
<tr>
<td>Reached Final Written Decision</td>
<td>21% (82)</td>
<td>24% (1,689)</td>
</tr>
<tr>
<td>Settled</td>
<td>17% (68)</td>
<td>22% (1,585)</td>
</tr>
<tr>
<td>Denied Institution</td>
<td>27% (106)</td>
<td>23% (1,651)</td>
</tr>
<tr>
<td>Dismissed</td>
<td>2% (6)</td>
<td>1% (103)</td>
</tr>
<tr>
<td>Joined</td>
<td>17% (65)</td>
<td>4% (289)</td>
</tr>
<tr>
<td>Open</td>
<td>14% (56)</td>
<td>22% (1,587)</td>
</tr>
<tr>
<td>Request for Adverse Judgment</td>
<td>2% (6)</td>
<td>4% (264)</td>
</tr>
<tr>
<td><strong>Total Petitions</strong></td>
<td><strong>100% (389)</strong></td>
<td><strong>100% (7,168)</strong></td>
</tr>
</tbody>
</table>
Status of Petitions Challenging Orange Book-listed Patents
(As of End FY17: 9/16/12 to 9/30/17)

- Petitions: 389
- Open Pre-Institution: 28
- Settled: 38
- Dismissed: 5
- Denied: 106
- Instituted: 212
- Joined: 65
- Open Post-Institution: 28
- Settled: 30
- Dismissed: 1
- Final Writ. Decisions: 82

Petitions wherein
Instituted Claims are Patentable
All Claims: 42 (51%)
Some Claims: 2 (2%)
No Claim: 38 (46%)
Question 5:
What is the status of each challenged Orange Book-listed patent when the results of multiple challenges are combined?
Status of Orange Book-listed Patents Considering Multiple Challenges
(as of End FY17: 9/16/12 to 9/30/17)

- 210 Patents
- 16 Open Pre-Institution
- 19 Settled
- 3 Dismissed
- 0 Req. Adv. Judgment
- 53 Denied
- 119 Instituted
- 23 Open Post-Institution
- 17 Settled
- 0 Dismissed
- 73 Final Writ. Decisions

Patents wherein Instituted Claims are Patentable
- All Claims: 36 (49%)
- Some Claims: 5 (7%)
- No Claims: 32 (44%)
**Percent of Challenged Patents by Number of Petitions**
*(as of End FY17: 9/16/12 to 9/30/17)*

<table>
<thead>
<tr>
<th>Petitions</th>
<th>Orange Book</th>
<th>All Patents</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Per Patent</strong></td>
<td><strong>#</strong></td>
<td><strong>%</strong></td>
</tr>
<tr>
<td>1</td>
<td>122</td>
<td>58.1%</td>
</tr>
<tr>
<td>2</td>
<td>45</td>
<td>21.4%</td>
</tr>
<tr>
<td>3</td>
<td>21</td>
<td>10.0%</td>
</tr>
<tr>
<td>4</td>
<td>8</td>
<td>3.8%</td>
</tr>
<tr>
<td>5</td>
<td>10</td>
<td>4.8%</td>
</tr>
<tr>
<td>6</td>
<td>2</td>
<td>1.0%</td>
</tr>
<tr>
<td>7 or more</td>
<td>2</td>
<td>1.0%</td>
</tr>
<tr>
<td><strong>Total</strong></td>
<td>210</td>
<td>100%</td>
</tr>
</tbody>
</table>
Percent of Challenged Patents by Number of Petitioners
(as of End FY17: 9/16/12 to 9/30/17)

<table>
<thead>
<tr>
<th>Petitioners</th>
<th>Orange Book</th>
<th>All Patents</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>#</td>
<td>%</td>
</tr>
<tr>
<td>1</td>
<td>140</td>
<td>66.7%</td>
</tr>
<tr>
<td>2</td>
<td>38</td>
<td>18.1%</td>
</tr>
<tr>
<td>3</td>
<td>16</td>
<td>7.6%</td>
</tr>
<tr>
<td>4</td>
<td>6</td>
<td>2.9%</td>
</tr>
<tr>
<td>5</td>
<td>8</td>
<td>3.8%</td>
</tr>
<tr>
<td>6</td>
<td>2</td>
<td>1.0%</td>
</tr>
<tr>
<td>7 or more</td>
<td>0</td>
<td>0.0%</td>
</tr>
<tr>
<td>Total</td>
<td>210</td>
<td>100%</td>
</tr>
</tbody>
</table>
Recap

• 83% of all petitions challenging Orange Book-listed patents result in patent being unchanged by PTAB

• The cumulative institution rate for Orange Book petitions (66%) is essentially the same as the cumulative overall institution rate (68%)

• Just over half of all final written decisions for petitions challenging Orange Book-listed patents find all claims patentable

• 80% of all challenged Orange Book-listed patents have 1 or 2 petitions, compared to 87% of all challenged patents

• 85% of all challenged Orange Book-listed patents have 1 or 2 petitioners, compared to 94% of all challenged patents
Questions?
Mark Your Calendars for Free PTAB Events

- **Thursday, April 5**, noon to 1 pm: Boardside Chat webinar on AIA Motion Practice

- **Thursday, June 7**, noon to 1 pm: Boardside Chat webinar on Motions to Exclude and Motions to Strike

- **Thursday, June 28**, 9 to 5 pm: Judicial Conference
Thank You
Appendix of Expanded Panel Cases
1. DI Procedure Involving Statutory Interpretation

- **35 U.S.C. § 314(a) multiple petitions**
    – Emphasizes the factors that the Board considers in deciding whether to exercise its discretion to deny a follow-on Petition in an AIA proceeding under 35 U.S.C. § 314(a).

- **35 U.S.C. § 315(b) time bar**
    – Expanded panel reaffirmed original panel’s decision that Petition was untimely under 35 U.S.C. § 315(b), even though prior infringement action had been dismissed.

    – Denied Petition under 35 U.S.C. § 315(b) that was not filed within one year of service of counterclaim alleging infringement of patent.
Forward-Looking Guidance

• 35 U.S.C. § 315(b) and real party in interest

    – Service of amended complaint attached as an exhibit to a motion for leave to file the amended complaint did not trigger one-year time period under 35 U.S.C. § 315(b);
    – Petitioner’s identification of two entities as being “related to Petitioner” did not contradict Petitioner’s certification as to a different real party in interest.

• 35 U.S.C. § 315(c) same-party joinder*

    – Original majority decision of 5-judge panel denied institution and motion for joinder of same party to already-instituted proceeding; dissenting opinion would have granted institution and joinder motion;
    – Expanded panel to 7 judges and majority instituted review and granted joinder motion.

    – Original majority decision denied institution and motion for joinder of same party to already-instituted proceeding; dissenting opinion would have granted institution and joinder motion;
    – Expanded majority instituted review and granted joinder motion.

* The cases to which Petitioners were joined are included in the total of individual cases with expanded panel decisions.
Forward-Looking Guidance

- **35 U.S.C. § 325(d) substantially same prior art during examination**

    - Emphasizes that prior art or arguments may be considered “substantially the same” under 35 U.S.C. § 325(d) if they are “cumulative to or substantially overlap with issues previously considered by the Office with respect to the patent.”

- **AIA § 18 CBM pre-institution disclaimer**

    - Emphasizes that CBM patent review eligibility is determined based on the claims of the challenged patent as they exist at the time of the decision to institute, and that statutorily disclaimed claims must be treated as if they never existed for the purpose of institution.
Forward-Looking Guidance

2. Decisions Involving Petition Requirements

• Untimely response to deficiency notice
    – Dismissed Petitions where the Petitioner was 74 days and 64 days late in correcting defects in the Petitions, and did not take prompt remedial action after recognizing the missed deadlines.

• Petition insufficient under 37 C.F.R. § 42.104
    – Denied institution on Petition that presented 127 grounds of unpatentability relying on one or more of 14 references, underdeveloped unpatentability arguments, and proposed claim constructions unsupported by evidence.

    – Declined to consider arguments not made in the Petition and incorporated by reference from expert declaration;
    – Denied institution where the Petition did not specify sufficiently where each claim element was found in the applied references, did not explain in detail the significance of the quotations and citations from the applied references, and provided conclusory obviousness assertions.

• Redundant grounds in petition
    – Ordered the Petitioner to select subsets of 422 asserted grounds to maintain in the proceeding, where the grounds were redundant.
Forward-Looking Guidance

3. Motion Procedure

• Motion to amend requirements
  
    – Emphasizes requirements under 35 U.S.C. § 316(d) and 37 C.F.R. §§ 42.20(c), 42.121 for a patent owner’s motion to amend claims, as well as the need to show patentable distinction over the prior art of record and prior art known to the patent owner.

    – Clarifies *Idle Free* references to “prior art of record” and “prior art known to the patent owner” to include no more than the material prior art made of record in the proceeding, prosecution history, and any other proceeding before the Office involving the patent.

• Pro hac vice motion requirements
  
    – Sets forth requirements for filing motions for pro hac vice admission under rule 37 C.F.R. § 42.10(c).

    – Sets forth requirements for filing motions for pro hac vice admission under rule 37 C.F.R. § 42.10(c).
Forward-Looking Guidance

4. Sanctions issues

- **PTAB may impose sanctions for continued course of conduct**
    - E-mail from counsel attaching evidence and reiterating arguments from teleconference with panel, and e-mail from opposing counsel providing substantive response were unauthorized and inappropriate.
    - Parties were not authorized to request a teleconference or file papers on the merits of the cases, which had been terminated with all appeals exhausted.

- **Denying motion for sanctions alleging abuse of process**
    - Economic motive for challenging a patent does not itself raise abuse of process issues, and *inter partes* reviews not limited to parties having a competitive interest in the challenged patent.
Forward-Looking Guidance and Treat Similarly Situated Parties the Same

5. Constitutional issue

• Sovereign immunity
  
  • *LSI Corp. v. Regents of the University of Minnesota*, Case IPR2017-01068 (PTAB Dec. 19, 2017) (Paper 19)
  
    – Panels expanded in all 7 proceedings to emphasize that a patent owner that is an arm of the state can invoke and waive sovereign immunity in an *inter partes* review; concurring opinions that sovereign immunity does not apply to *inter partes* review.
Expanded Panel Decisions Breakdown: Treat Similarly Situated Parties the Same

  - Original panel suggested expansion to maintain uniformity in Decision on Institution due to substantial difference of opinion among the judges regarding claim interpretation under 35 U.S.C. § 112, sixth paragraph.