

**UNITED STATES
PATENT AND TRADEMARK OFFICE**

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Summary of enhancements made to PTAB procedures in FY2019

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UNITED STATES
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Question/comment submission

To send in questions or comments during the webinar, please email:

PTABBoardsideChat@uspto.gov

Overview of recent PTAB changes

- 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

Recent 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 (8)

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

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>Infiltrator Water Techs., LLC v Presby Patent Trust</i>	IPR2018-00224, Paper 25	AIA - Time bar - 315(b)	10/1/2018	9/9/2019
<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. Chromar Systems, Inc.</i>	IPR2018-01511, Paper 11	AIA – Institution 315(a)(1)	1/31/2019	8/29/2019

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>General Electric Co. v. United Techs. Corp.</i>	IPR2017-00491, Paper 9	AIA – Statutory Disclaimer	7/6/2017	9/9/2019
<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>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 - Depositions	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

PTAB website, decisions

The screenshot shows the USPTO Patent Trial and Appeal Board website. The header includes the USPTO logo, navigation links (About Us, Jobs, Contact Us, MyUSPTO), and a search bar. The main navigation menu has links for Patents, Trademarks, IP Policy, and Learning and Resources. The breadcrumb trail is: Home > Patents: Application Process > Patent Trial and Appeal Board > Patent Trial and Appeal Board. The main heading is "Patent Trial and Appeal Board" with a sub-heading: "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." Below this are several sections: Trials, Appeals, Decisions (highlighted with a red box), Hearings, Resources and guidance, Statistics, PTAB Data Tools and IT Systems, PTAB Events, and About PTAB. On the right side, there are three news items: "Notice regarding options for amendments through reissues or reexaminations NEW", "New Pilot Program Concerning Motions to Amend NEW", and "Claim Construction Final Rule NEW". At the bottom right, there are two more news items: "SOP 1 (rev. 15): Assignment of judges to panels NEW" and "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)

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

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

Appeal statistics

- Inventory
- Average pendency

AIA trial statistics

- Number of petitions
- Institution rate
- FWD outcomes

Question/comment submission

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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

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



Thank you!

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