

Patent Trial and Appeal Board (PTAB) update

Scott Boalick, Chief Administrative Patent Judge

Jacqueline Bonilla, Senior Legal Advisor to the Director of the USPTO

Michael Tierney, Acting Deputy Chief Administrative Patent Judge

Janet Gongola, Acting Deputy Chief Administrative Patent Judge

Melissa Haapala, Vice Chief Administrative Patent Judge

Miriam Quinn, Acting Vice Chief Administrative Patent Judge

Amanda Wieker, Acting Senior Lead Administrative Patent Judge

November 16, 2022

Patent Public Advisory Committee meeting



UNITED STATES
PATENT AND TRADEMARK OFFICE ®

P-TACTS portal features

- Patent Trial and Appeal Case Tracking System (P-TACTS) new and improved features:
 - P-TACTS sign-on through MyUSPTO account for increased ease of use by allowing a single account to access multiple USPTO systems
 - Lead Counsel can add Staff, a new user role, allowing them to file all document types
 - Better workflow for petition submission to reduce common errors
 - Case Viewer Interface with enhanced functionality
 - Improved accessibility to access information related to a case
 - New interface provides more detailed information
 - Easy to file documents
 - Linking motion, opposition, reply, and any associated exhibits together for easy access
 - Granting all back-up counsel filing privileges
 - Linking of joined cases in the Case Viewer for easy access
 - Simplified rehearing request submission process to reduce errors
 - Pre-populating paper types with the most relevant choices



Motion to Amend (MTA) Pilot Program extension

- [MTA Pilot Program extended](#) until September 16, 2024
 - Provides a patent owner who files an MTA with options to request preliminary guidance from the PTAB on the MTA and to file a revised MTA; provides timelines for briefing to accommodate these options
 - Efficient and effective opportunity for patent owners to preserve their patent rights by providing feedback on their amended claims
- Intend to publish a Request for Comments seeking the public's input on the MTA Pilot Program and to explore making the program, or a revised version of the program, final through notice and comment rulemaking

MTA Study

- [MTA Study Update \(Installment 7; covers March 15, 2019–March 31, 2022\)](#)
 - Of the 2,028 AIA trials conducted during the MTA Pilot Program (both completed trials and pending trials), patent owners sought to amend claims in 10% of them.
 - Of the 155 AIA trials with an MTA completed during the pilot program, the PTAB decided the substantive merits of 99 MTAs. In the remaining 56 MTAs, the PTAB did not reach the substantive merits for various reasons explained in the study.
 - Of the 99 pilot MTAs decided on the merits, 25% were granted or granted-in-part. By comparison, 14% of pre-pilot MTAs were granted or granted-in-part.
 - Since the pilot began, when MTAs were denied, 58% of those denials were because the petitioner met its burden to show unpatentability, 16% of those denials were because the patent owner failed to meet statutory and/or regulatory requirements, and 27% of those denials were for both reasons.
- www.uspto.gov/patents/ptab/motions-amend-study



Fast-Track Appeals Pilot Program extension

- [Fast-Track Appeals Pilot Program extended](#) through July 2, 2024
- Initiated on July 2, 2020, and previously extended on July 12, 2021
- Permits appellants with a docketed *ex parte* appeal to file a petition to expedite the review of the appeal
- Target of reaching decisions on appeals within six months from the date they enter the program
- www.uspto.gov/ptabfasttrack



Expanding opportunities to appear before the PTAB

- Published a [Request for Comments](#) on October 18, 2022
 - Seeking public input on the requirements to practice before the PTAB, to ensure quality representation in AIA proceedings without creating undue restrictions or barriers to entry for practitioners
 - Goal is to expand the admission criteria to practice before the PTAB so more Americans, including those from traditionally under-represented and under-resourced communities, can participate, while maintaining the USPTO's high standards necessary for the issuance and maintenance of robust and reliable intellectual property rights
- Comment period closes January 17, 2023



Director review, Precedential Opinion Panel review, and internal circulation and review of PTAB decisions

- The USPTO implemented a number of interim processes that promote accuracy, consistency, and integrity of PTAB decision-making AIA proceedings, including:
 - The current interim Director review process
 - The Precedential Opinion Panel (POP) process
 - The current interim process for PTAB decision circulation and internal PTAB review
- Plan to formalize those processes through notice and comment rulemaking
- Published a [Request for Comments](#) seeking public input to inform rulemaking on July 20, 2022
- Comment period closed October 19, 2022



Recent precedential decisions

- [Code200, UAB v. Bright Data, Ltd., IPR2022-00861, Paper 18 \(Aug. 23, 2022\)](#)
 - This Director review decision orders *sua sponte* rehearing, vacates the PTAB panel decision denying institution, and remands to the panel for proceedings consistent with this decision. This decision clarifies that when a follow-on petition (also known as a “serial” petition) has substantial overlap with an original petition, which was denied based on discretionary considerations, “road-mapping” concerns are minimized, and General Plastic factors 1–3 weigh against discretionary denial of institution in view of the prior petition.
- [NXP USA, Inc. v. Impinj, Inc., IPR2021-01556, Paper 13 \(Sept. 7, 2022\)](#)
 - This Decision grants *sua sponte* Director review and affirms the PTAB panel's decision denying rehearing. The decision holds that the Board correctly determined that a stipulation not to pursue certain invalidity grounds in district court, offered by a petitioner for the first time after a decision denying institution, is not a proper basis for granting rehearing of the decision on institution. The decision identifies that the only appropriate time for a petitioner to offer a stipulation related to the *Fintiv* factor 4 analysis is prior to the Board’s decision of whether to institute review.
- [OpenSky Industries, LLC v. VLSI Technology LLC, IPR2021-01064, Paper 102 \(Oct. 4, 2022\)](#)
 - The Director review decision holds that Petitioner OpenSky abused the inter partes review (“IPR”) process by (1) filing an IPR in an attempt to extract payment from both Patent Owner VLSI and joined Petitioner Intel, and (2) proposing to undermine the proceeding to extract the payment from VLSI. The Director sanctions OpenSky by precluding OpenSky from actively participating in the IPR and temporarily elevating Intel to the lead petitioner. The Director further orders OpenSky to show cause why it should not be ordered to pay compensatory damages to VLSI. Finally, in an effort to balance the competing interests at issue in this case and determine whether to maintain or dismiss the underlying proceeding, the Director remands to the Board to determine whether the Petition, based only on the record before the Board prior to institution, presents a compelling, meritorious challenge.
- www.uspto.gov/patents/ptab/precedential-informative-decisions

