Patent Public Advisory Committee Quarterly Meeting
Patent Trial and Appeal Board Update

Scott R. Boalick, Acting Chief Administrative Patent Judge
Jacqueline Wright Bonilla, Acting Deputy Chief Administrative Patent Judge
February 7, 2019
Patent Trial and Appeal Board Organizational Structure
Board size over time
(Calendar year)
Locations of PTAB Judges

*Alexandria, Va. count includes judges who participate in TEAPP.

** The number in parenthesis next to each location indicates the number of judges in that location.
AGENDA

• **PTAB statistics**
  • Appeal and interference statistics (December 2018)
  • Trial statistics (December 2018)

• **PTAB updates**
  • Precedential Opinion Panel
  • Motion to amend practice
PTAB STATISTICS

• Appeal and interference statistics (December 2018)
• Trial statistics (December 2018)
### Pending appeals
*(FY10 to FY19: Sept. 30, 2010 to Dec. 31, 2018)*

<table>
<thead>
<tr>
<th>Year</th>
<th>Cases</th>
</tr>
</thead>
<tbody>
<tr>
<td>FY10</td>
<td>17,851</td>
</tr>
<tr>
<td>FY11</td>
<td>24,040</td>
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<tr>
<td>FY12</td>
<td>26,570</td>
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<tr>
<td>FY13</td>
<td>25,437</td>
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<tr>
<td>FY14</td>
<td>25,527</td>
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<tr>
<td>FY15</td>
<td>21,556</td>
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<tr>
<td>FY16</td>
<td>15,533</td>
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<tr>
<td>FY17</td>
<td>13,044</td>
</tr>
<tr>
<td>FY18</td>
<td>11,021</td>
</tr>
<tr>
<td>FY19</td>
<td>10,378</td>
</tr>
</tbody>
</table>
Pendency of decided appeals in FY18 and FY19
(Pendency of appeals decided in FY18 Q1 compared to FY19 Q1 in months)

Pendency is calculated as average months from Board receipt date to final decision.
*CRU (Central Reexamination Unit) includes ex parte reexams, inter partes reexams, supplemental examination reviews and reissues from all technologies.
Appeal intake in FY19
(Oct. 1, 2018 to Dec. 31, 2018)

*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 to Dec. 31, 2018)

- Affirmed 57.8%
- Reversed 30.6%
- Affirmed-in-Part 9.7%
- Administrative and Panel Remands
- Dismissed 1.1%
Interference inventory
(FY08 to FY19: Sept. 30, 2008 to Dec. 31, 2018)
PTAB STATISTICS

- Appeal and interference statistics (December 2018)
- Trial statistics (December 2018)
Petitions by trial type
(All time: Sept. 16, 2012 to Dec. 31, 2018)

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 Dec. 31, 2018)

- Electrical/Computer: 292 (61%)
- Mechanical & Business Method: 136 (29%)
- Chemical: 12 (2%)
- Bio/Pharma: 36 (8%)
- Design: 0 (0%)
Petitions filed by month
(December 2018 and previous 12 Months: Dec. 1, 2017 to Dec. 31, 2018)
Institution rates

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.
Institution rates by technology
(All time: Sept. 16, 2012 to Dec. 31, 2018)

- **Bio/Pharma**: 60% (441 of 740)
- **Chemical**: 63% (305 of 486)
- **Design**: 40% (17 of 42)
- **Electrical/Computer**: 67% (2,880 of 4,267)
- **Mechanical & Business Method**: 69% (1,245 of 1,816)

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.
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.
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 Dec. 31, 2018)

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.
PTAB UPDATES

• Precedential Opinion Panel
• Motion to amend practice
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
Precedential Opinion Panel

- Criteria:
  - Constitutional questions
  - Important questions regarding statutes, rules, regulations
  - Important issues regarding precedential case law
  - Issues of broad applicability to Board
  - Resolve conflicts between Board decisions
  - Promote certainty and consistency
- Default composition
  - Director
  - Commissioner for Patents
  - PTAB Chief Judge
Standard Operating Procedure 2

SOP2 URL:
https://www.uspto.gov/sites/default/files/documents/SOP2%20R10%20FINAL.pdf
Standard Operating Procedure 2

Resources and guidance

Policies, procedures, rules, guides, tools and manuals associated with proceedings before the Patent Trial and Appeal Boards.

Expand all | Collapse all

› Appeals

› Trials

› Reexams and Interferences

› Standard operating procedures

• SOP 1 (rev. 15): Assignment of judges to panels (20 Sept 2018)

• SOP 2 (rev. 10): Precedential opinion panel to decide issues of exceptional importance involving policy or procedure (20 Sept 2018)

› Guidance

› Statutes, rules, and references

› Rulemaking

› FAQs
PTAB UPDATES

- Precedential Opinion Panel
- Motion to amend practice
Request for comment on proposed changes to motion to amend (MTA) practice in AIA trials

• Published on October 29, 2018
• Sought input regarding:
  1. New process involving a preliminary non-binding Board decision addressing a MTA, and an opportunity for a patent owner to revise its MTA thereafter
  2. Burden of persuasion regarding the patentability of substitute claims, as set forth in *Western Digital* order
• Included 17 questions of particular interest
• Comment period closed December 21, 2018
Proposed timeline for proposed motion to amend process
Request for comment on MTA practice

- 49 stakeholders provided comments (as of December 21, 2018):
  - 11 from companies (covering a range of technology areas)
  - 9 from IP/bar associations (e.g., AIPLA, IPL Section of the ABA, NYIPLA, Boston Patent Law Association, similar associations in Japan)
  - 11 from trade organizations (e.g., IPO, Internet Association, Computer & Communications Industry Association, PhRMA, BIO, similar organizations in Japan)
  - 4 from other organizations
  - 14 from individuals
Comments on motion to amend practice

Comments on motion to amend URL: https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/comments-motion-amend-practice-and
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Questions and comments

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