Patent Public Advisory Committee Quarterly Meeting

PTAB Update

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August 8, 2019
Agenda

• POP cases
• Ratification decisions
• MTA Pilot Program status
• Updates
POP cases
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
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
Precedential Opinion Panel (POP)

• Outlined in PTAB standard operating procedure 2 (SOP2), available at https://go.usa.gov/xPMqx

• 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
Precedential Opinion Panel (POP)

• Default composition
  – Director
  – Commissioner for Patents
  – PTAB Chief Judge

• Issued first decision on March 13, 2019
## POP decisions and orders

<table>
<thead>
<tr>
<th>Case/Appeal Name</th>
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<th>Topic</th>
<th>Status</th>
<th>Date Decided</th>
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<tr>
<th>Case/Appeal Name</th>
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<th>Topic</th>
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<th>Date Order Issued</th>
</tr>
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<tbody>
<tr>
<td><em>GoPro, Inc. v. 360Heros, Inc.</em></td>
<td>IPR2018-01754, Paper 23</td>
<td>AIA - Time Bar - 315(b)</td>
<td>Pending (POP)</td>
<td>5/10/2019</td>
</tr>
</tbody>
</table>
Hulu, LLC v. Sound View Innovations, LLC

IPR2018-01039 (PTAB Apr. 3, 2019) (Paper 15)

• Precedential Opinion Panel (POP) ordered review to address the following issue:
  • What is required for a petitioner to establish that an asserted reference qualifies as “printed publication” at the institution stage?

• Oral hearing held on June 18, 2019.
GoPro, Inc. v. 360Heros, Inc.

IPR2018-01754 (PTAB May 10, 2019) (Paper 23)

• Precedential Opinion Panel (POP) ordered review to address the following issue:
  • Whether the service of a pleading asserting a claim alleging infringement, where the serving party lacks standing to sue or the pleading is otherwise deficient, triggers the 1 year time period for a petitioner to file a petition under 35 U.S.C. § 315(b).
  • Oral hearing held on June 25, 2019.
Ratification decisions
## Recent precedential and informative decisions

### Precedential decisions (11)
- AIA - RPI - 312(a)(2), 315(b) (2)
- AIA - RPI - 322(a)(2) (1)
- AIA - Institution - 314(a) (1)
- AIA - Institution - 314(a), 325(d) (1)
- AIA - MTA - 316(d) (2)
- AIA - Oral Argument (2)
- AIA - Request for Rehearing (1)
- AIA - Witness Testimony (1)

### Informative decisions (7)
- 101 (5)
- AIA - Institution - 314(a) (2)
## Recent decisions designated precedential

<table>
<thead>
<tr>
<th>Case/Appeal Name</th>
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<tbody>
<tr>
<td>Ventex Co., Ltd v. Columbia Sportswear North America, Inc.</td>
<td>IPR2017-00651, Paper 152</td>
<td>AIA - RPI - 312(a)(2), 315(b)</td>
<td>1/24/2019</td>
<td>4/16/2019</td>
</tr>
<tr>
<td>NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.</td>
<td>IPR2018-00752 , Paper 8</td>
<td>AIA - Institution - 314(a), 325(d)</td>
<td>9/12/2018</td>
<td>5/7/2019</td>
</tr>
<tr>
<td>Amazon.com, Inc. v. Uniloc Luxembourg S.A.</td>
<td>IPR2017-00948, Paper 34</td>
<td>AIA - MTA - 316(d)</td>
<td>1/18/2019</td>
<td>3/18/2019</td>
</tr>
</tbody>
</table>
Recent decisions designated precedential (cont.)

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Valve Corp. v. Elec. Scripting Prods., Inc.


• Designated precedential on May 7, 2019.

• Denied institution of *inter partes* review after applying the *General Plastic* factors.

• Explained that the Board’s application of the *General Plastic* factors is not limited to instances when multiple petitions are filed by the same petitioner.

• When different petitioners challenge the same patent, the Board considers any relationship between those petitioners when weighing the *General Plastic* factors.
NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.

IPR2018-00752 (PTAB Sept. 12, 2018) (Paper 8) (Precedential)

- Designated precedential on May 7, 2019.
- Denied institution under 35 U.S.C. § 325(d) after applying Becton, Dickinson factors.
- Denied institution under 35 U.S.C. § 314(a) after determining that instituting review would be an inefficient use of Board resources where:
  - District court proceeding was nearing final stages, and
  - Board proceeding would involve:
    - same claim construction standard as in district court,
    - same prior art references as in district court, and
    - same arguments as in district court.
Focal Therapeutics, Inc. v. SenoRx, Inc.

IPR2014-00116 (PTAB July 21, 2014) (Paper 19) (Precedential)

- Designated precedential on July 10, 2019.

  
  - Once the cross-examination of a witness has commenced, and until cross-examination of the witness has concluded, counsel offering the witness on direct examination shall not: (a) consult or confer with the witness regarding the substance of the witness’ testimony already given, or anticipated to be given, except for the purpose of conferring on whether to assert a privilege against testifying or on how to comply with a Board order; or (b) suggest to the witness the manner in which any questions should be answered.

- Clarified that the prohibition of conferring with the witness ends once cross-examination concludes, and, if relevant, begins again when re-cross commences, and continues until re-cross concludes.
Recent decisions designated informative

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<tr>
<td><strong>Chevron Oronite Company LLC v. Infineum USA L.P.</strong></td>
<td>IPR2018-00923, Paper 9</td>
<td>AIA - Institution - 314(a)</td>
<td>11/7/2018</td>
<td>4/5/2019</td>
</tr>
<tr>
<td><strong>Ex Parte Smith</strong></td>
<td>Appeal 2018-000064</td>
<td>101</td>
<td>2/1/2019</td>
<td>3/19/2019</td>
</tr>
<tr>
<td><strong>Ex Parte Olson</strong></td>
<td>Appeal 2017-006489</td>
<td>101</td>
<td>3/25/2019</td>
<td>7/1/2019</td>
</tr>
<tr>
<td><strong>Ex Parte Kimizuka</strong></td>
<td>Appeal 2018-001081</td>
<td>101</td>
<td>5/15/2019</td>
<td>7/1/2019</td>
</tr>
<tr>
<td><strong>Ex Parte Savescu</strong></td>
<td>Appeal 2018-003174</td>
<td>101</td>
<td>4/1/2019</td>
<td>7/1/2019</td>
</tr>
<tr>
<td><strong>Ex Parte Fautz</strong></td>
<td>Appeal 2019-000106</td>
<td>101</td>
<td>5/15/2019</td>
<td>7/1/2019</td>
</tr>
</tbody>
</table>
Ex Parte Olson

Appeal 2017-006489 (PTAB Mar. 25, 2019) (Informative)

• Designated informative on July 1, 2019.

• Applied the revised guidance published in the USPTO’s January 7, 2019 Memorandum, 2019 Revised Patent Subject Matter Eligibility Guidance.

• Concluded that the claims recite a judicial exception, a mathematical concept, but that the claims recite additional elements that integrate the judicial exception into a practical application.
Ex Parte Kimizuka

Appeal 2018-001081 (PTAB May 15, 2019) (Informative)

• Designated informative on July 1, 2019.

• Applied the revised guidance published in the USPTO’s January 7, 2019 Memorandum, 2019 Revised Patent Subject Matter Eligibility Guidance.

• Concluded that the claims recite a judicial exception, a mental process, and determined that the claims do not integrate the exception into a practical application or provide an inventive concept.
Ex Parte Savescu

Appeal 2018-003174 (PTAB Apr. 1, 2019) (Informative)

• Designated informative on July 1, 2019.

• Applied the revised guidance published in the USPTO’s January 7, 2019 Memorandum, *2019 Revised Patent Subject Matter Eligibility Guidance*.

• Concluded that the claims recite a judicial exception, a method of organizing human activity, and determined that the claims do not integrate the exception into a practical application or provide an inventive concept.
Ex Parte Fautz

Appeal 2019-000106 (PTAB May 15, 2019) (Informative)

• Designated informative on July 1, 2019.

• Applied the revised guidance published in the USPTO’s January 7, 2019 Memorandum, 2019 Revised Patent Subject Matter Eligibility Guidance.

• Concluded that the claims recite a judicial exception, a mathematical concept, but that the claims recite additional elements that integrate the judicial exception into a practical application.
PTAB decisions

https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/decisions

Decisions

Links to all public, final decisions of the Patent Trial and Appeal Board, including decisions designated as precedential or informative.

- Precedential and informative decisions
- Representative AIA trial orders, decisions, and notices

NOTE: Some material listed on this page may require a plug-in or viewer.
Precedential and informative decisions

MTA Pilot Program status
Request for comment on proposed changes to motion to amend (MTA) practice in AIA trials

• October 29, 2018 motion to amend (MTA) request for comments (RFC)
  – Proposed a new MTA process and pilot program
  – Sought input regarding burden of persuasion when determining patentability of substitute claims, after *Aqua Products*
  – Included 17 questions of interest, but also solicited feedback regarding MTA practice generally

• Office received 49 comments from stakeholders (as of Dec. 21, 2018)

• Office carefully considered all comments and revised pilot program in response
MTA pilot program notice

• In response to comments, the office issued a notice regarding a new pilot program concerning MTA practice and procedures in AIA trials.

• Published in Federal Register at 84 Fed. Reg. 9497 (March 15, 2019)

• Notice also provides responses to comments
  – Topics include timelines, retroactivity of applying pilot, Board preliminary decision, opportunity to file a revised MTA, contingent MTAs, and opting-out of pilot
  – Comments also included requests for clarification regarding existing reissue and reexamination procedures at the USPTO
  – Stakeholder comments to October MTA RFC are available at https://go.usa.gov/xEXS2
Highlights of MTA pilot program

• New program provides patent owner (PO) with two options not previously available:

  1. PO may choose to receive preliminary guidance (PG) from Board on its MTA.

  2. PO may choose to file a revised MTA after receiving petitioner’s opposition to initial MTA and/or after receiving Board’s PG (if requested).
If PO does not elect either option:

AIA trial practice, including MTA procedure, is essentially unchanged from prior practice, especially regarding timing of due dates for already existing papers in an AIA trial

- One small exception: times between due dates for certain later-filed papers are extended slightly
Highlights of MTA pilot program

• Upon institution of an AIA trial, Board will issue the same scheduling order in every case
  – Due dates are similar to prior practice
  – Due dates are calculated in weeks

• If PO chooses to file a revised MTA after receiving petitioner’s opposition and Board’s PG (if requested), Board will issue a revised scheduling order soon thereafter
Schedule entered at institution
(Appendix 1A)
Revised schedule if revised MTA (Appendix 1B)

- **Parties**
  - 12 weeks PO Response
  - 12 weeks Pet Reply
  - 6 weeks PO Sur-reply
  - 10 weeks Motions to Exclude
  - 1 wk MTE Opp.
  - 1 wk MTE Reply
  - 1 wk Oral Hearing (10 Mo.)
  - 9 weeks Final Written Decision

- **USPTO**
  - Institution Decision (8 Scheduling Order)
  - Oral Hearing (10 Mo.)
  - Final Written Decision

- **Parties**
  - 12 weeks Opposition to MTA
  - 6 weeks PO Revised MTA (rMTA)**
  - 3 wks Petitioner Opp. to rMTA
  - 3 wks PO Reply to Opp. to rMTA
  - 1 wk Pet Sur-reply

- **USPTO**
  - Institution Decision (6 Scheduling Order)
  - Preliminary Guidance on MTA (if requested)
  - Oral Hearing (10 Mo.)
  - Final Written Decision

**New Procedures in Black and Grey**
**Existing Procedures in White**

* PO indicates in MTA whether it requests Preliminary Guidance
** If PO files a rMTA, Board adjusts schedule to this revised timeline
Highlights of MTA pilot program

- MTA and revised MTA are contingent unless PO indicates otherwise, e.g., by canceling original claims
- If PO does not request PG in initial MTA, no PG
- Changes if/after PO files a revised MTA:
  - One additional paper for each party
  - New briefing and oral hearing schedule to accommodate
- Final written decision addresses only substitute claims at issue in latest filed MTA
Pilot program implementation

• Effective date is publication date of notice (March 15, 2019)
• Applies to all AIA trials instituted on or after that date
• USPTO anticipates it will reassess pilot program approximately 1 year from effective date
  – Potentially may terminate program at any time or continue program (with or without modifications) depending on stakeholder feedback and effectiveness of program
MTA Pilot Program


New Pilot Program Concerning Motions to Amend

The United States Patent and Trademark Office (USPTO) has published a notice of a pilot program for motion to amend practice and procedures in trial proceedings under the America Invents Act (AIA) before the PTAB.

The pilot program provides patent owners with two options not previously available. The first option is that a patent owner may choose to receive preliminary guidance from the Board on its motion to amend. The second option is that a 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). If a patent owner does not elect either of those options, the motion to amend practice is essentially unchanged from current practice. The notice sets forth the details of the pilot program, including motion to amend procedures that will be in effect for the duration of the pilot program.

The full text of the notice is published in the Federal Register.

As of the closing date for comments (December 21, 2018), the USPTO received a total of 49 comments from individuals, corporations, and associations in response to its October 29, 2018, request for comments (RFC) on proposed procedure for motions to amend in AIA trials. The USPTO carefully considered all of the comments to the RFC when developing the pilot program. For example, several comments suggested the USPTO reconsider the timelines of due dates presented in the RFC. In response to this comment, the USPTO modified the proposal in the RFC to provide parties more time to prepare certain filings and evidence, among other things. The USPTO made other minor revisions as reflected in the final notice, and otherwise provides responses to the comments received as appropriate.
Notice regarding options for amendments through reissue or reexamination during pending AIA proceeding
Notice regarding options for reissue or reexamination during pending AIA proceeding

• Published in Federal Register at 84 Fed. Reg. 16654 (April 22, 2019).

• Notice provides:

  • A summary of current practice regarding existing USPTO procedures that apply to reissue and reexamination, including after a petitioner files an AIA petition challenging claims of same patent, after Board institutes a trial, and after Board issues a final written decision (FWD).

  • Summary information about factors currently considered when determining:

    - Whether to stay or suspend a reissue proceeding, or stay a reexamination proceeding, that involves a patent at issue in an AIA proceeding; and

    - When and whether to lift such a stay or suspension.
Options for amendments on PTAB

Notice regarding options for amendments through reissue or reexamination

The United States Patent and Trademark Office (USPTO) has published a notice of information regarding existing office practice available to a patent owner during the pendency of a trial proceeding under the America Invents Act (AIA), pertaining to reissue and reexamination procedures available for amending claims involved in the trial.

This notice provides a summary of current practice regarding reissue and reexamination options in which patent owners may amend claims before and after the Patent Trial and Appeal Board (PTAB) issues a final written decision in an AIA trial proceeding. This notice also provides summary information about factors the USPTO currently 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.

The full text of the notice is published in the Federal Register.

On October 28, 2018, the USPTO published a notice requesting comments on proposed modifications to current motion to amend practice and procedures in AIA trial proceedings. In response to that notice, the USPTO received a number of comments and questions requesting clarification regarding existing reissue and reexamination procedures at the USPTO. The USPTO carefully considered those comments and questions and issued this notice of information in response.
Trial Practice Guide July 2019 update

• Guidance in the July 2019 update includes
  – Factors that may be considered by the Board in determining when additional discovery will be granted
  – The revised claim construction standard to be used in IPR, PGR, and CBM proceedings
  – The submission of testimonial evidence with a patent owner preliminary response
  – Information to be provided by the parties if there are multiple petitions filed at or about the same time challenging the same patent
  – Motion to amend practice
  – Factors that may be considered by the Board in determining whether to grant a motion for joinder
  – Procedures to be followed when a case is remanded
  – Procedures for parties to request modifications to the default protective order
Trial Practice Guide update on PTAB webpage

Updates
Subscription Center
www.uspto.gov/subscribe

Sign up to receive the latest news and updates from the USPTO conveniently via e-mail
Questions and comments

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