

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



PTAB update

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February 6, 2020

Patent Public Advisory Committee quarterly meeting

UNITED STATES
PATENT AND TRADEMARK OFFICE



Agenda

- Motion to amend NPRM and pilot program update
- Precedential and informative case update
- Multiple challenges
- New AIA data visualization
- “New to PTAB” toolkit

**Motion to amend NPRM and pilot
program update**

Notice of proposed rulemaking on allocation of the burden of persuasion on motions to amend

- Published in Federal Register at 84 Fed. Reg. 56401 (October 22, 2019).
- The office proposes changes to the rules of practice governing motions to amend:
 - To assign to the patent owner the burden of showing that a motion to amend complies with certain statutory and regulatory requirements.
 - To assign to the petitioner the burden of showing the unpatentability of substitute claims proposed in a motion to amend.
 - To provide that the Board itself may, in the interests of justice, exercise its discretion to grant or deny a motion to amend for any reason supported by the evidence of record.
- The proposed rule is consistent with the burdens as described in the precedential Board decision *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, -01130, Paper 15 (PTAB February 25, 2019).
- Comment period closed on December 23, 2019; received 18 comments.

Highlights of MTA pilot program

- Provides patent owner (PO) with two options not previously available:
 - Option 1: PO may choose to receive preliminary guidance (PG) from Board on its motion to amend (MTA).
 - Option 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).
- Option 1 is not a predicate for Option 2.
- Applies to all AIA trials instituted on or after publication date of the notice (i.e., March 15, 2019).

Current MTA pilot status

- MTA pilot has been effective since March 15, 2019 for cases instituted on or after that date.
- First opportunity to file an MTA was June 7, 2019.
 - First MTA requesting preliminary guidance was filed June 25.
- First opportunity to file a revised MTA was mid-October.
 - First revised MTA was filed October 30.

Precedential and informative case update

New POP decision

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
<i>Hulu, LLC v. Sound View Innovations, LLC</i>	IPR2018-01039, Paper 29	AIA - Printed Publications	Decided (POP)	12/20/2019

Case/appeal name	Case/appeal number	Topic	Status	Date order issued
<i>Hunting Titan, Inc. v. DynaEnergetics GmbH & Co. KG</i>	IPR2018-00600, Paper 46	AIA - Motion to Amend	Pending (POP)	11/7/2019

Hulu, LLC v. Sound View Innovations, LLC

- IPR2018-01039 (PTAB Dec. 20, 2019) (Paper 29)
- 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?
- The POP accepted additional briefing from the parties and amici and held an oral hearing on June 18, 2019. The POP issued a precedential decision on December 20, 2019.

Hulu, LLC v. Sound View Innovations, LLC

- IPR2018-01039 (PTAB Dec. 20, 2019) (Paper 29)
- The POP concluded:
 - At institution, a petitioner must identify with particularity sufficient evidence to establish a reasonable likelihood that an asserted reference was publicly accessible before the critical date of the challenged patent and thus qualifies as a printed publication.
 - Applying this standard, the POP reversed the panel decision, concluding that, based on the totality of the evidence currently in the record, petitioner submitted sufficient evidence. The POP further clarified that there was no presumption in favor of institution or in favor of finding that a reference is a printed publication.

New informative decisions

Ex Parte Hannun

- Appeal 2018-003323 (PTAB April 1, 2019)
 - Designated informative on December 11, 2019.
 - Reversed the examiner's eligibility rejection of a method for transcribing speech, where the Board found that the steps were not a mental process.

Hulu, LLC v. Sound View Innovations, LLC

- IPR2018-00582 (PTAB Aug. 5, 2019) (Paper 34)
 - Designated informative on December 11, 2019.
 - Final written decision determined that petitioner failed to show challenged claims were unpatentable because the petitioner failed to show a sufficient rationale for combining the references.

Johns Manville Corp. v. Knauf Insulation, Inc.,

- IPR2018-00827 (PTAB Oct. 16, 2018) (Paper 9)
 - Designated informative on December 11, 2019.
 - Denied institution based on 35 U.S.C. § 314(a).
 - Determined that showing that the references are analogous and could be combined does not establish a sufficient rationale for combining the references.

Multiple challenges

Serial petitions:

General Plastic and Valve

- *General Plastic v. Canon*
 - Sets for a multi-factor test to assess whether a serial petition should be denied under § 314(a)
 - IPR2016-01357 (Sept. 6, 2017) (Paper 19) (precedential)
- *Valve Corp. v. Elec. Scripting Prods., Inc.*
 - *Valve* builds on *General Plastic* by clarifying that *General Plastic* is applicable to a serial petition by a second party if there is a close relationship between the parties
 - Institution denied for petition filed by co-defendant and licensor of technology of accused products, after institution denied for earlier petition filed by HTC
 - IPR2019-00062, -00063, -00084 (PTAB Apr. 2, 2019) (Paper 11) (precedential)

Parallel court proceedings: *NHK*

- *NHK Spring Co. Ltd. v. Intri-Plex Techs., Inc.*
 - Sets forth new basis for discretionary denials under § 314(a): advanced district court proceedings.
 - Jury trial scheduled to begin approx. six months before any FWD “an additional factor that weighs in favor of denying the Petition under § 314(a).”
 - IPR would involve same references and arguments presented in district court
 - District court proceeding was in advanced state having already issued a claim construction ruling
 - § 325(d) also relied on as independent basis for denying institution
 - IPR2018-00752 (PTAB Sept. 12, 2018) (Paper 8) (precedential)

Parallel petitions: Trial practice guide, July 2019 update

- Parallel petitions challenging the same patent
 - One petition should be sufficient to challenge a patent in most situations.
 - At times, more than one petition may be necessary, for example, when:
 - a large number of claims have been asserted in litigation, or
 - there are priority disputes requiring multiple prior art references.
 - Based on Board's prior experience, it is unlikely that three or more petitions for same patent will be appropriate.

Parallel petitions: Trial practice guide, July 2019 update

- If a petitioner files two or more petitions challenging the same patent, then the petitioner should, in its petition or in a separate paper (no more than five pages):
 - Rank the petitions in the order in which it wishes the Board to consider the merits,
 - Explain the differences between the petitions and why the differences are material, and
 - Explain why the Board should exercise its discretion to institute additional petitions.
- Patent owner can respond in its preliminary response or in a separate paper (no more than five pages)

SAS-related denials: Chevron and Deeper

- Board retains discretion to deny institution under 35 U.S.C. §§ 314(a) and 325(d) even when a petition includes at least one claim that meets the criteria for institution
 - *Deeper, UAB v. Vexilar, Inc.*, Case IPR2018-01310 (PTAB Jan. 24, 2019) (Paper 7) (informative);
 - *Chevron Oronite Co. v. Infineum USA L.P.*, Case IPR2018-00923 (PTAB Nov. 7, 2018) (Paper 9) (informative)

§ 325(d): *Becton Dickinson*

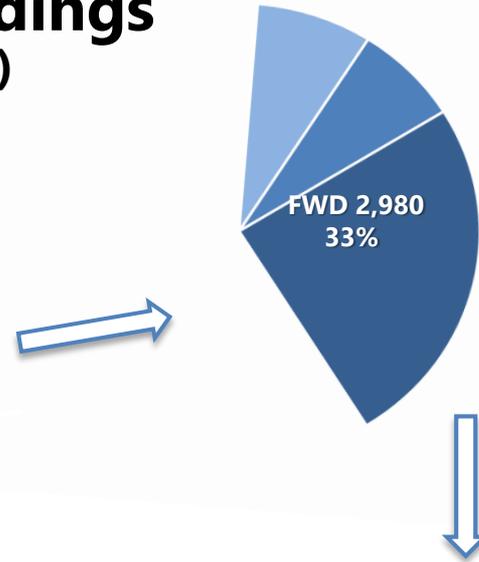
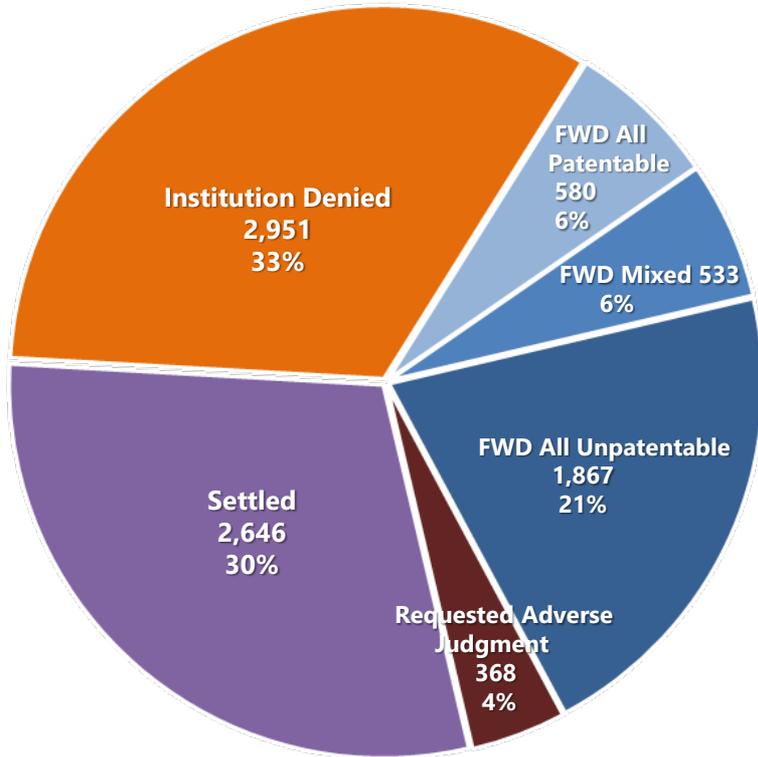
- Identifies six non-exclusive factors that the Board considers in evaluating whether to exercise discretion, under 35 U.S.C. § 325(d), including:
 - the similarities and material differences between the asserted art and the prior art involved during examination;
 - the extent of the overlap between the arguments made during examination and the manner in which petitioner relies on the prior art or patent owner distinguishes the prior art; and
 - whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art
 - IPR2017-01586 (PTAB Dec. 15, 2017) (Paper 8) (precedential as to the first paragraph of Section III.C.5 only; informative for the rest)

Consolidated trial practice guide, November 2019

- Consolidates recent updates into a single document.
- Includes considerations under 35 U.S.C. §§ 314(a) and 325(d) when instituting an *inter partes* review:
 - Serial petitions – *General Plastic and Valve*
 - Parallel petitions – new case management procedure
 - Parallel court proceedings – *NHK*
 - SAS-related denials – *Chevron and Deeper*
 - § 325(d) – *Becton Dickinson*

New AIA data visualization

Outcome of concluded proceedings (All time: Sept. 16, 2012 to Dec. 31, 2019)



Percentage of the Final Written Decisions



Joined and dismissed cases are excluded.

“New to PTAB” toolkit

New to PTAB page on USPTO website

<https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/ptab-inventors>

Trials



Manage or review pending inter parte review, post-grant review, covered business method, derivation, and interference proceedings.

Appeals



Manage or review proceedings directed to adverse decisions of examiners in patent applications, reissue applications, and reexaminations of issued patents.

Decisions



Browse public final agency decisions of PTAB, including decisions designated as precedential or informative.

Hearings



Review guidance, schedules, and inclement weather advisories for oral arguments for appeals, interferences, and trials.

Resources and guidance



Learn about the Patent Trial and Appeal Board or find key policies, procedures, forms, and guidance.

Statistics



View performance benchmarks of the PTAB, including dispositions, pendency, inventory, and other tracking measures.

PTAB Data Tools and IT Systems



Stay informed regarding maintenance events, obtain direct access to PTAB automated information sharing platforms, subscribe for updates, or provide feedback.

PTAB Events



Find where our judges are speaking and learn more about events sponsored by PTAB.

New to PTAB



Discover the history of the PTAB and map out its modern structure and mission.

The screenshot shows the USPTO website's navigation and content. The top navigation bar includes 'uspto UNITED STATES PATENT AND TRADEMARK OFFICE', 'About Us', 'Jobs', 'Contact Us', and 'MyUSPTO'. A search bar is present with the text 'Search uspto.gov'. Below the navigation bar are tabs for 'Patents', 'Trademarks', 'IP Policy', and 'Learning and Resources', along with a 'Find It Fast' button. The breadcrumb trail reads 'Home > Patents: Application Process > Patent Trial and Appeal Board > New to PTAB'. The main content area is titled 'New to PTAB' and includes a 'What is PTAB?' section with a tree diagram. The sidebar on the left contains a list of links, with 'New to PTAB' highlighted by a red box. The main content area also has a red box around the 'New to PTAB' section header and its description.

Application process

- Search for patents
- Learn about patent classification
- Filing online
- Checking application status
- Responding to Office actions
- Petitions
- Patent Trial and Appeal Board
- Trials
- Appeals
- Decisions
- Hearings
- Resources
- Statistics
- About PTAB
- PTAB Help

New to PTAB

What is PTAB?

The Patent Trial and Appeal Board (PTAB or Board) is a tribunal within the United States Patent and Trademark Office (USPTO) that reviews rejections made by examiners in proceedings called "ex parte appeals" and decides patentability questions for "issued patents raised by third parties in proceedings called "AIA trials." "AIA" stands for America Invents Act, which created the PTAB (previously known as the Board of Patent Appeals and Interferences or BPAI). The Board includes statutory members and administrative patent judges. The statutory members of the Board are the USPTO director, deputy director, commissioner for patents, and commissioner for trademarks.

Administrative patent judges are appointed by the secretary of commerce and are legally and technically trained. Judges have extensive patent legal experience prior to their appointment on the Board, for example, in private practice, in government practice (e.g. at Department of Justice or International Trade Commission) and/or as in-house counsel in companies. Many also have served as USPTO examiners and/or judicial law clerks.

The Board also includes patent attorneys, law clerks, and paralegals along with support staff to administer proceedings and hearings.

[Learn more](#) about the Board, its composition, history, and areas of jurisdiction.

What are ex parte appeals?

If a patent examiner twice rejects or issues a final rejection in a patent application, the applicant can seek review of the rejection by the Board. The Board calls such an applicant by the title "appellant." An appellant and the examiner may submit written papers called "briefs" to explain their respective positions. The appellant also may request to make an oral presentation to the Board in what is called an "oral hearing." The Board will review the briefs, attend the oral hearing, and then render a decision. The Board will either affirm or reverse, in part or whole, the examiner's rejection. If the appellant is not successful in securing reversal of the examiner's rejection from the Board, the appellant may seek reconsideration by the Board or federal court review or both.

The [appeal process](#) involves nine steps and is explained in the videos below:

- [INVENTOR CHAT \(Appealing a Final Rejection to the Patent Trial and Appeal Board: What you need to know August 15, 2019\)](#)
- [BOARDSIDE CHAT \(Appeals Made Easy, November 7, 2019\)](#)

Find out more information about ex parte appeals on the [PTAB's Appeal](#) webpage.

What are AIA proceedings?

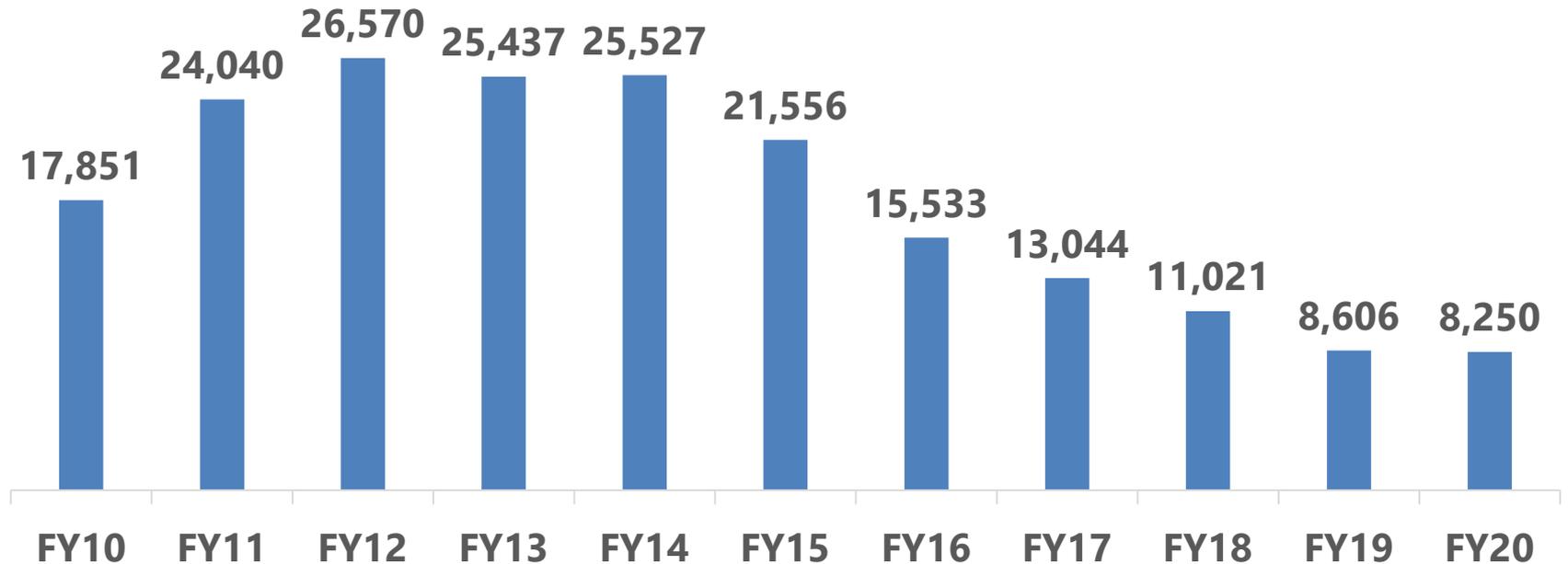
Questions and comments

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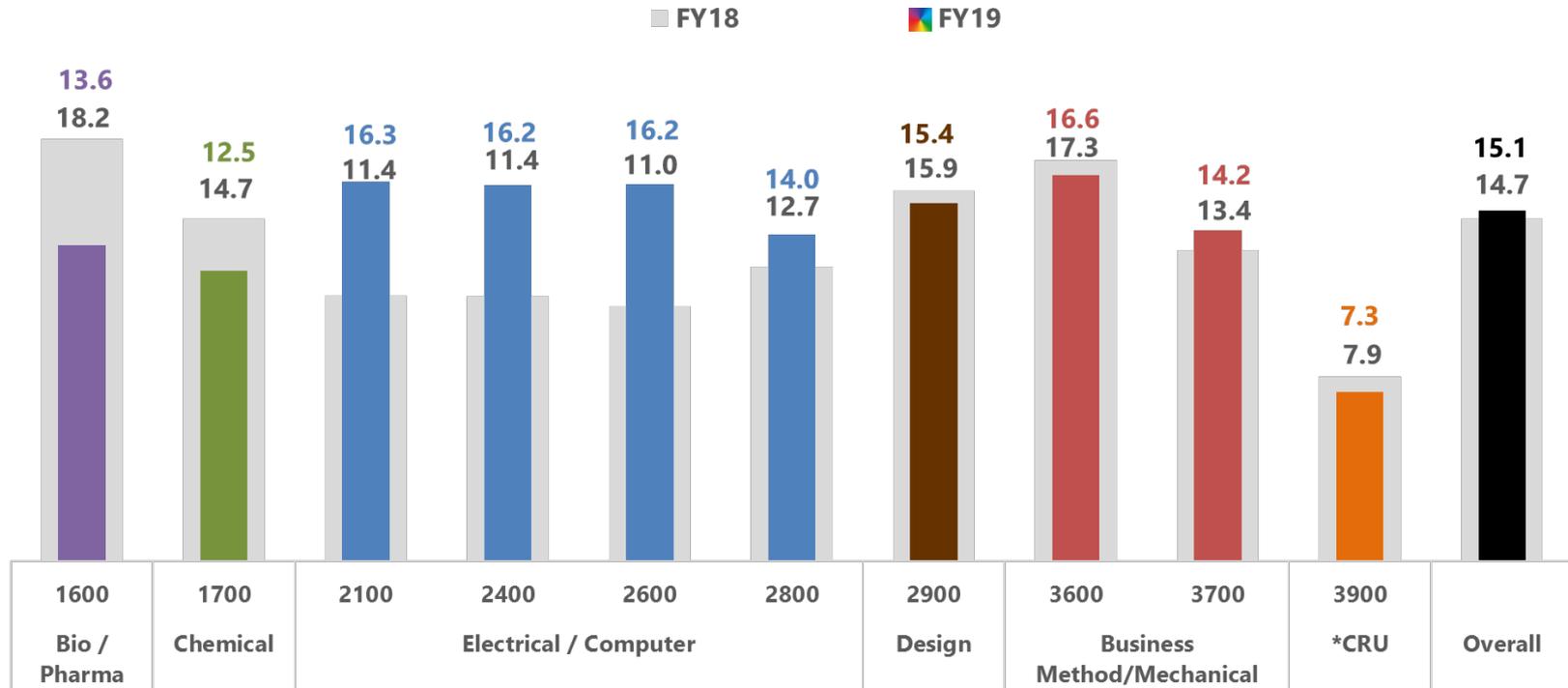
Patent Trial and Appeal Board
December 31, 2019

Appeal and interference statistics

Pending appeals FY10 to FY20 (Sept. 30, 2010 – Dec, 31, 2019)



Pendency of decided appeals (Oct. – Dec 2018 compared to Oct. – Dec. 2019)



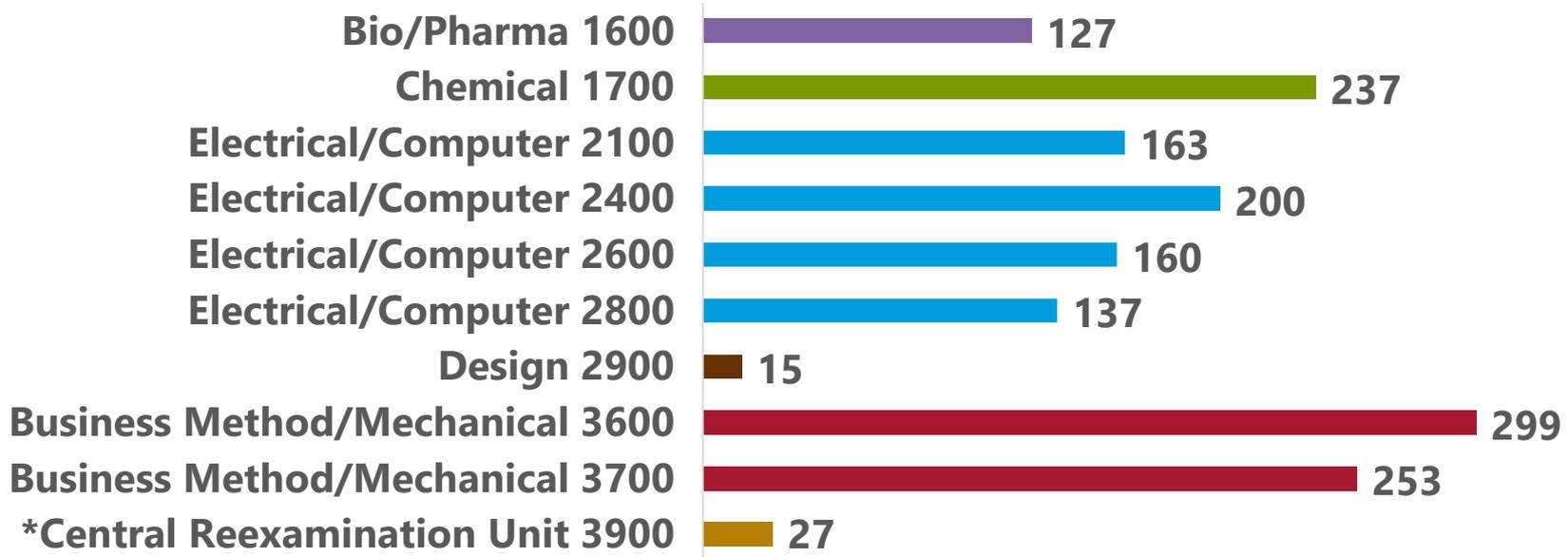
Pendency is calculated as average months from Board receipt date to final decision.

Pendency is calculated for a three month period compared to the same period the previous year.

*CRU (Central Reexamination Unit) decisions include 8 *ex parte* reexams, 1 *inter partes* reexams, 0 supplemental examination reviews, and 5 reissues from all technologies for Aug. – Oct. 2019.

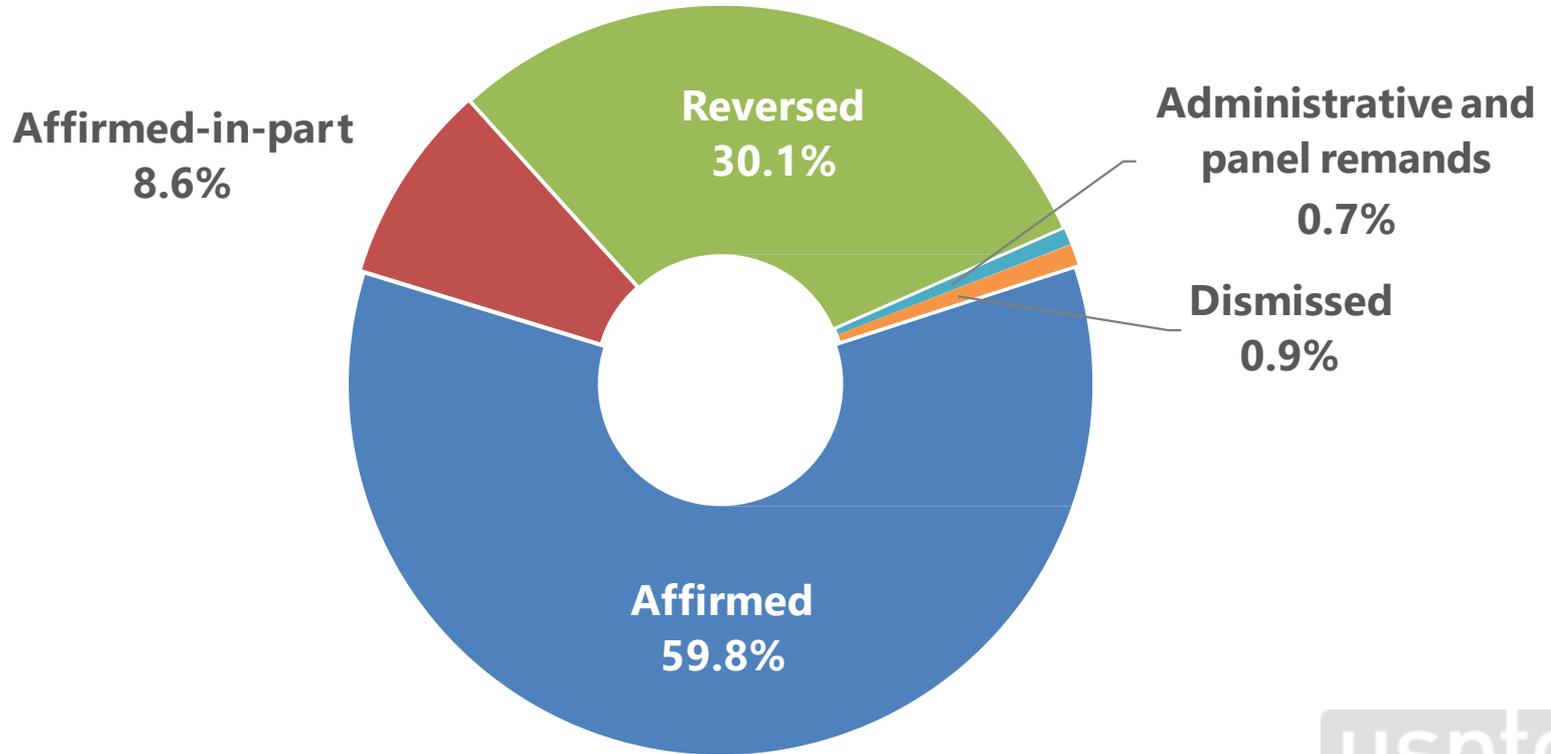


Appeal intake in FY20 (Oct. 1, 2019 – Dec. 31, 2019)

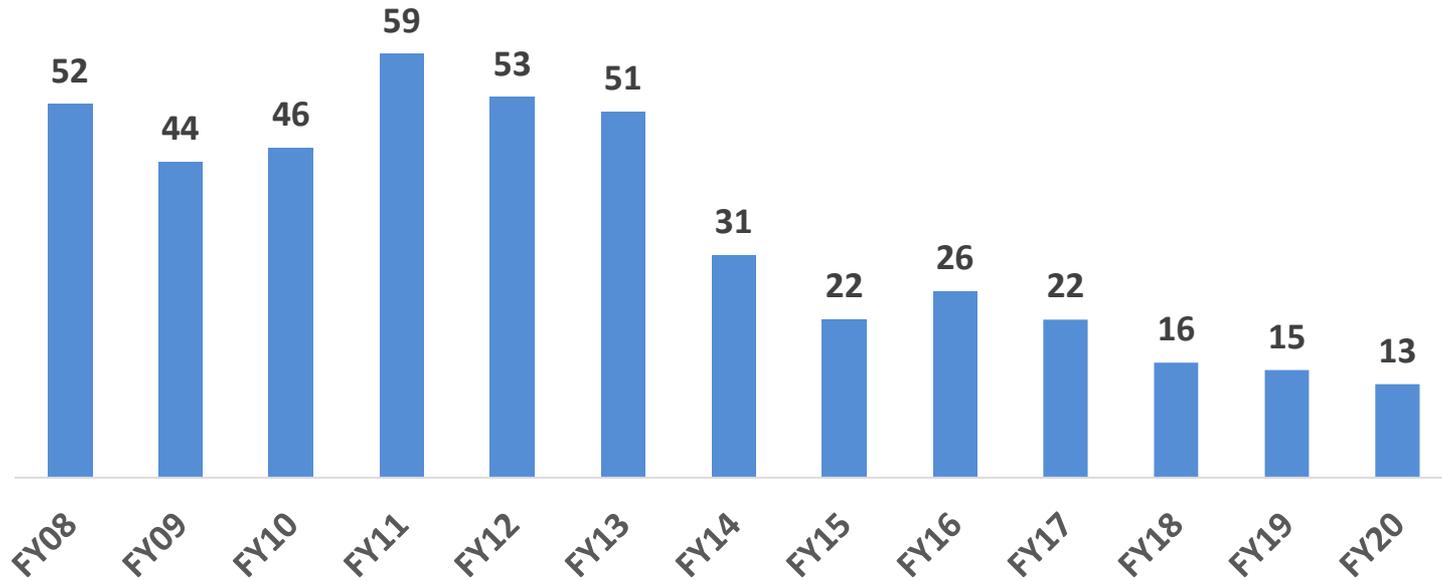


*The Central Reexamination Unit includes ex parte reexams, inter partes reexams, supplemental examination reviews and reissues from all technologies.

Appeal outcomes in FY20 (Oct. 1, 2019 - Dec. 31, 2019)



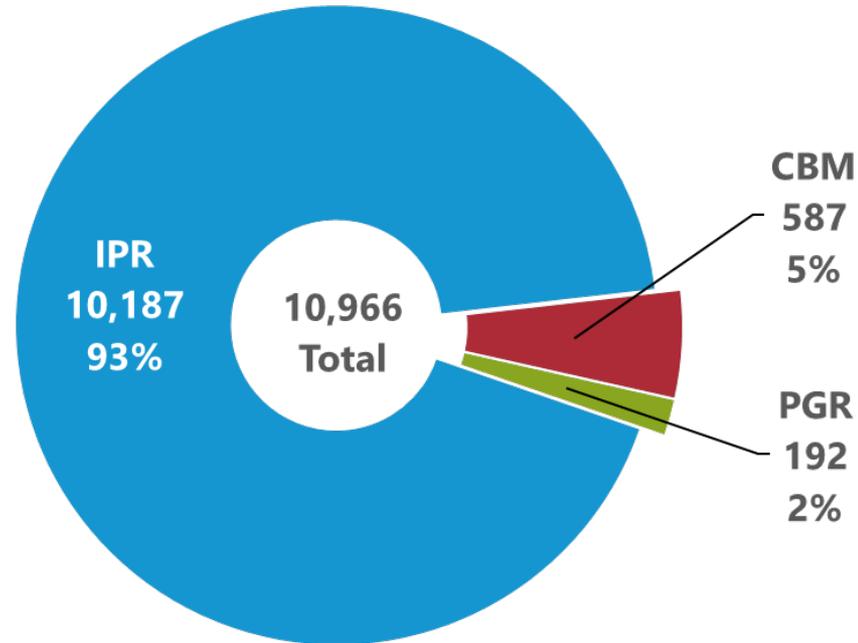
Interference inventory (Sept. 30, 2008 – Dec. 31, 2019)



Patent Trial and Appeal Board
December 31, 2019

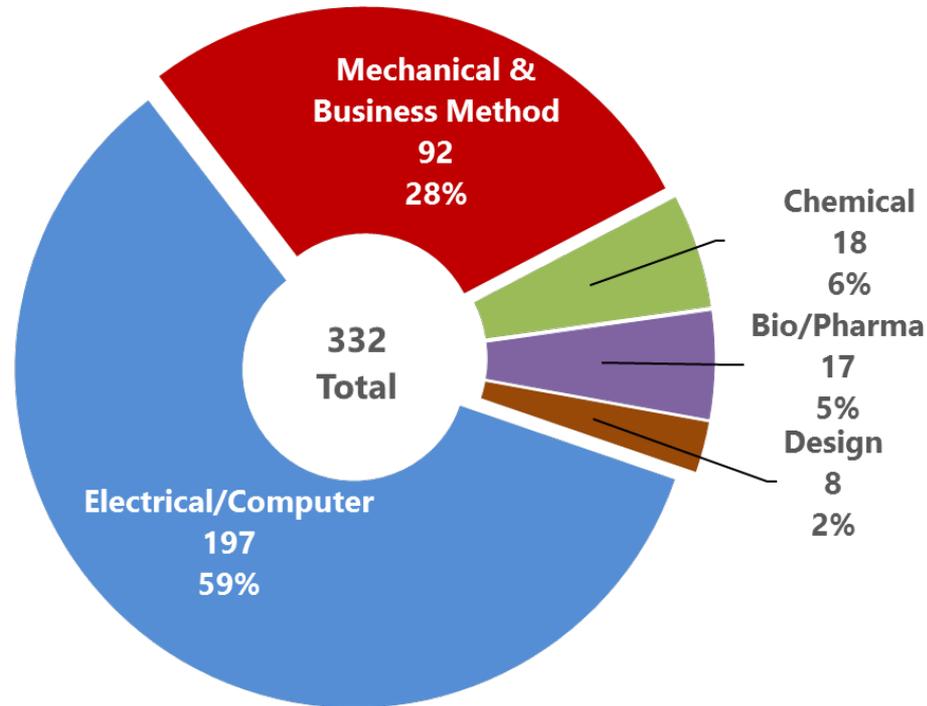
Trial statistics: IPR, PGR, CBM

Petitions by trial type (All time: Sept. 16, 2012 to Dec. 31, 2019)



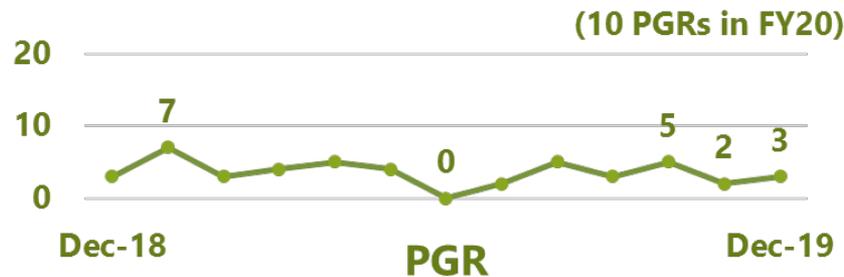
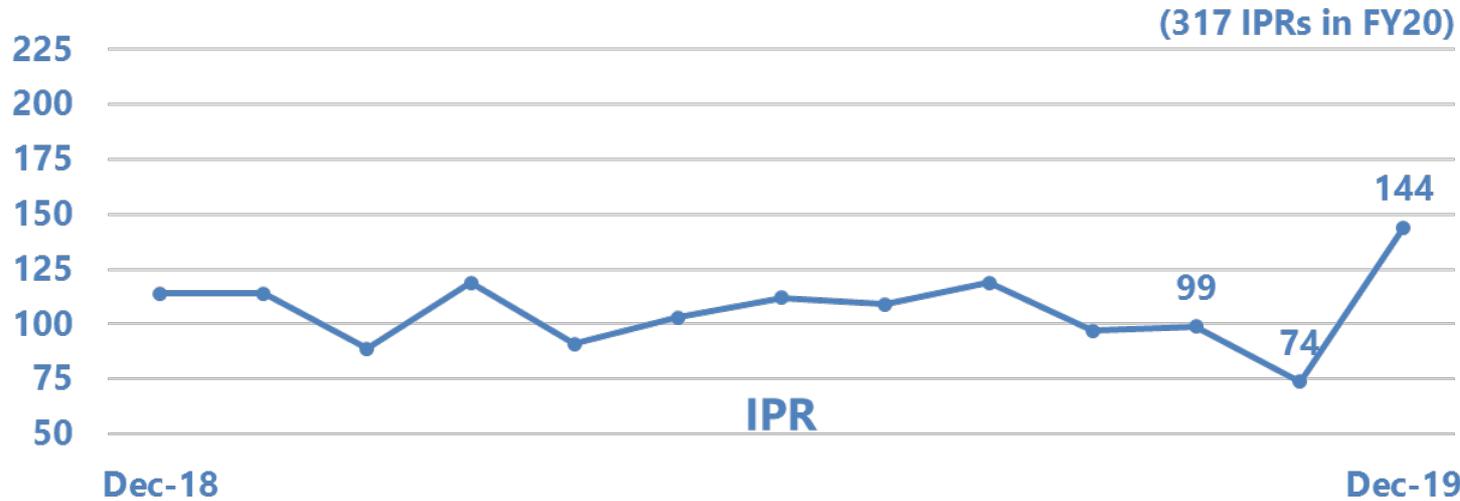
Trial types include Inter Partes Review (IPR), Post Grant Review (PGR), and Covered Business Method (CBM).

Petitions filed by technology in FY20 (FY20: Oct. 1, 2019 to Dec. 31, 2019)



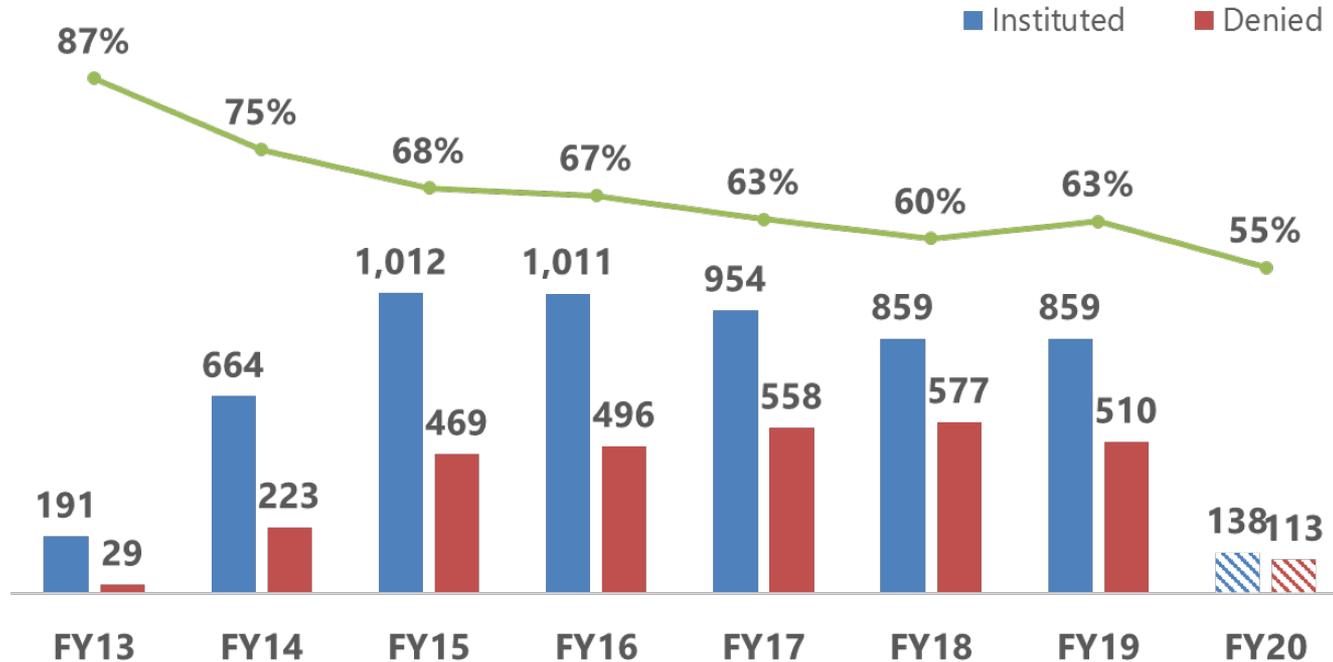
Petitions filed by month

(Dec. 2019 and previous 12 Months: Dec. 1, 2018 to Dec. 31, 2019)



Institution rates

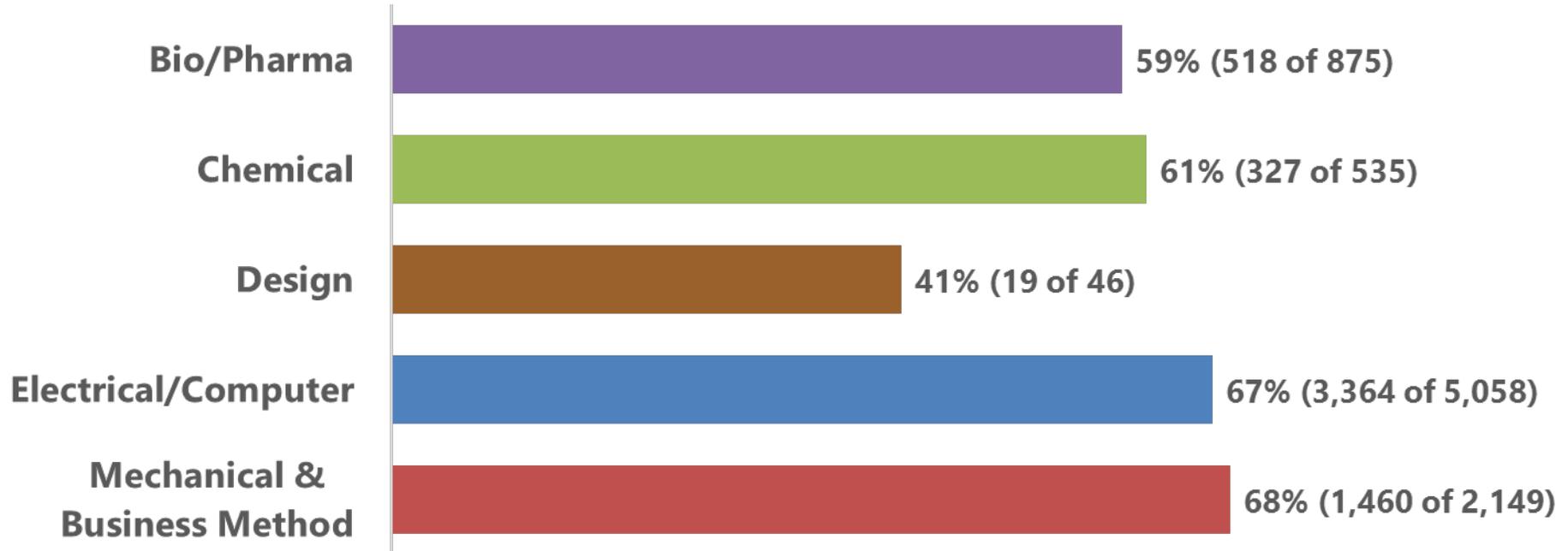
(FY13 to FY20: Oct. 1, 2012 to Dec. 31, 2019)



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

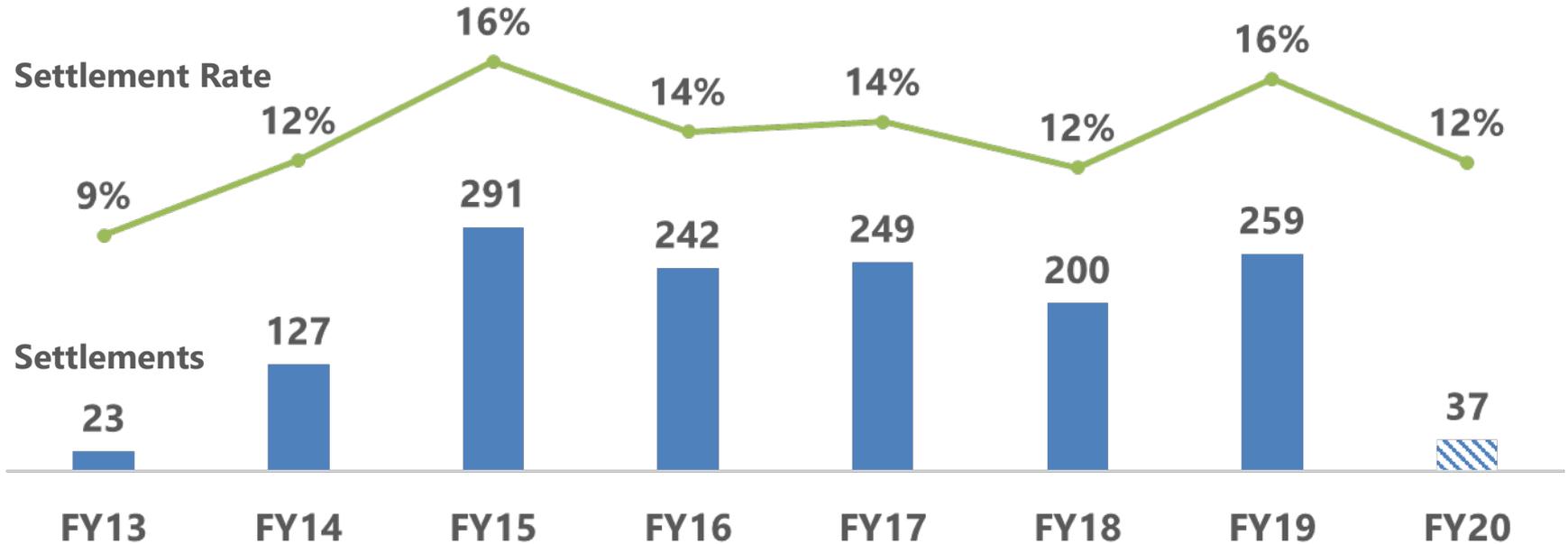
(All time: Sept. 16, 2012 to Dec. 31, 2019)



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.

Pre-institution settlements

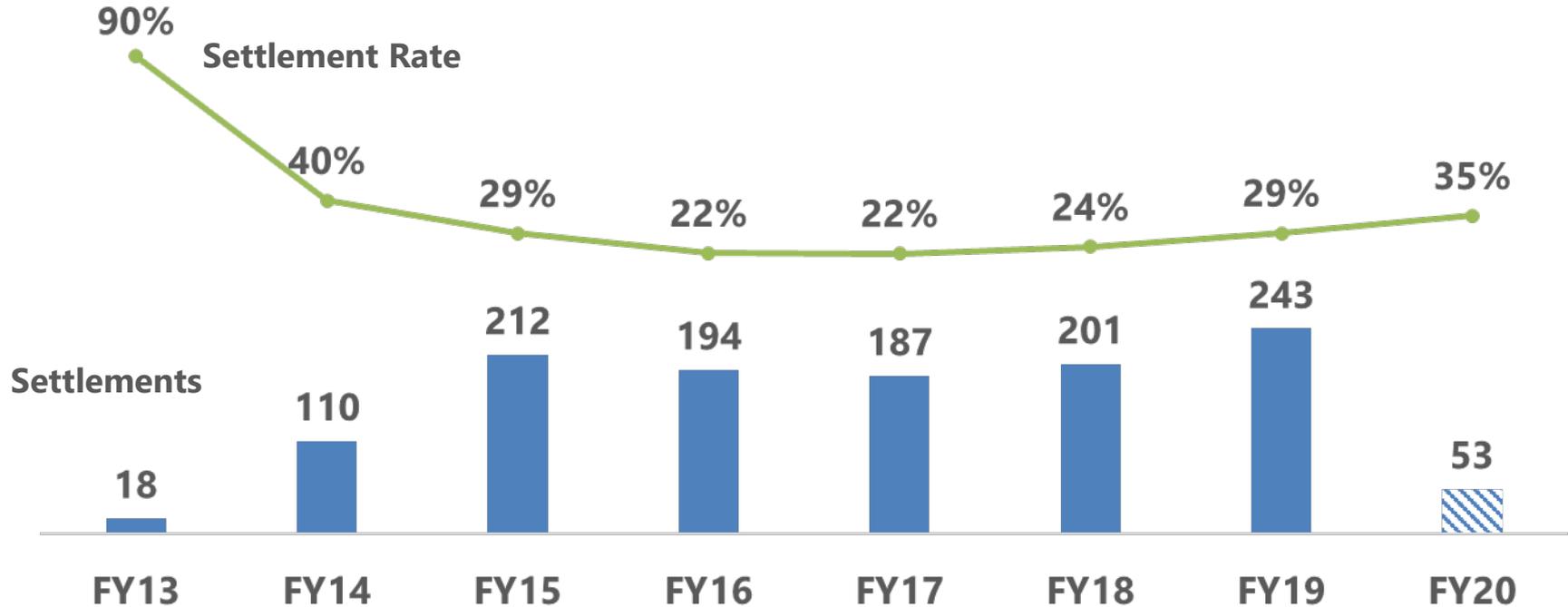
(FY13 to FY20: Oct. 1, 2012 to Dec. 31, 2019)



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.

Post-institution settlements

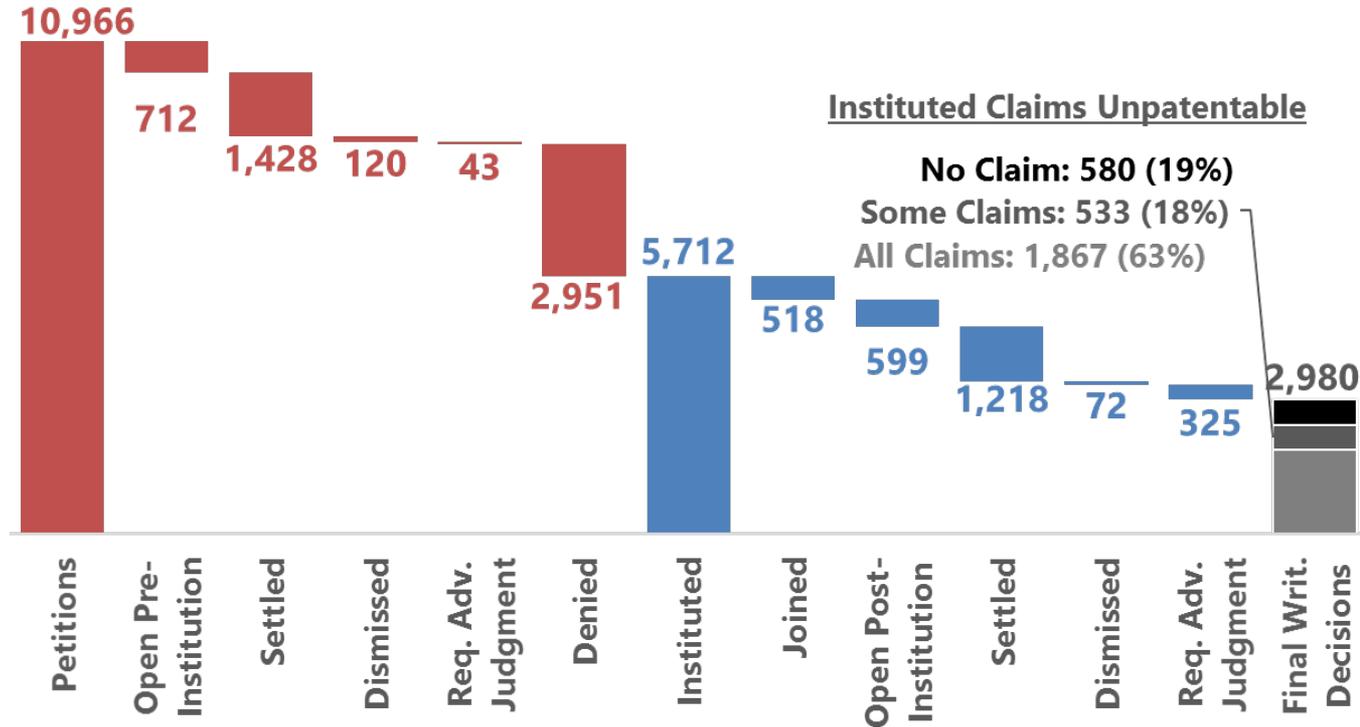
(FY13 to FY20: Oct. 1, 2012 to Dec. 31, 2019)



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.

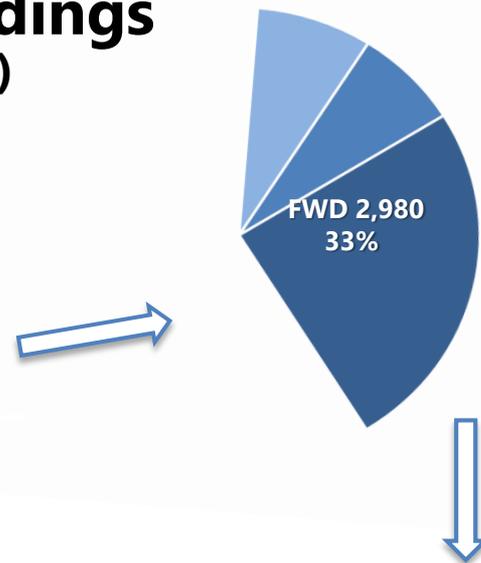
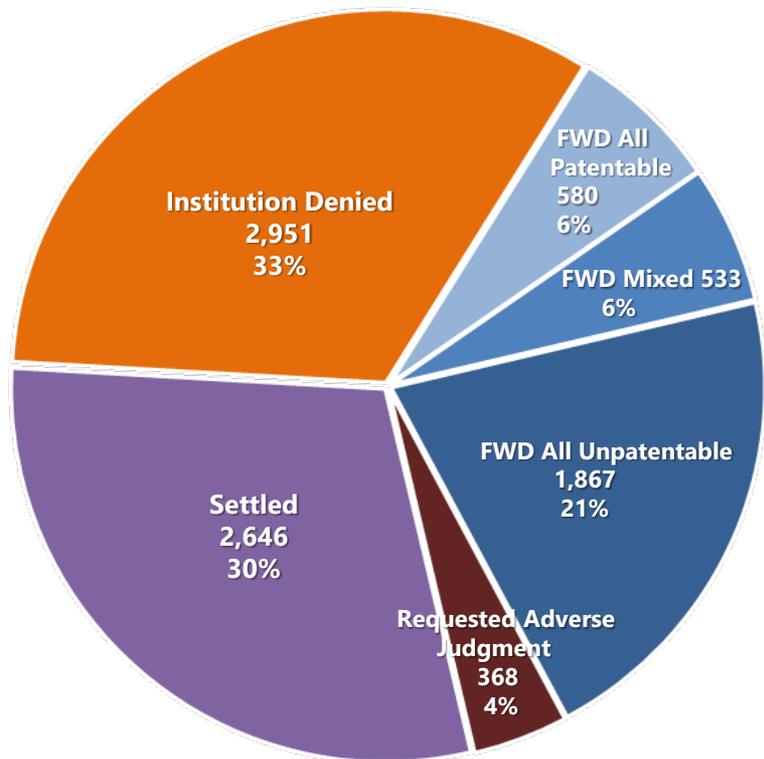
Status of petitions

(All time: Sept. 16, 2012 to Dec. 31, 2019)



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.

Outcome of concluded proceedings (All time: Sept. 16, 2012 to Dec. 31, 2019)



Percentage of the Final Written Decisions



Joined and dismissed cases are excluded.

Questions and comments

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