Patent Trial and Appeal Board (PTAB) update

Scott R. Boalick, Chief Administrative Patent Judge
Jacqueline W. Bonilla, Deputy Chief Administrative Patent Judge
November 19, 2020
Patent Public Advisory Committee quarterly meeting
Agenda

• Highlights of annual report
• Advanced Bionics
• Multiple petitions
• Overview of CBM
Highlights of annual report
PPAC Annual Report - PTAB

- Ex parte appeals
- AIA trials
- New procedures and improvements
- Designated decisions
- Operational efforts
Advanced Bionics
Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH


• Designated precedential on March 24, 2020.
• Denied institution based on 35 U.S.C. § 325(d).
  – Explained that the Board uses a two-part framework for exercising discretion under § 325(d).
    • whether the same or substantially the same art previously was presented to the office or
    whether the same or substantially the same arguments previously were presented to the
    office; and
    • if either condition of first part of the framework is satisfied, whether the petitioner has
      demonstrated that the office erred in a manner material to the patentability of challenged
      claims.
  – After applying the framework, the Board determined that the petition presented the same or
    substantially the same prior art previously presented to the office and that the petitioner failed to
    show that the examiner materially erred as to the patentability of challenged claims.
Multiple petitions
Multiple petitions

• How “successful” are multiple petition strategies for petitioners?

• “Challenge”: one petitioner vs. one patent

• Serial petitions
  – Same petitioner vs. same patent, filed > 90 days apart

• Parallel petitions
  – Same petitioner vs. same patent, filed <= 90 days apart
# Serial petition: Petitioner’s result

Filed > 90 days apart

<table>
<thead>
<tr>
<th>First petition</th>
<th>Serial petition</th>
<th>Reported result of attempt</th>
</tr>
</thead>
<tbody>
<tr>
<td>Inst</td>
<td>+</td>
<td>Inst</td>
</tr>
<tr>
<td>Deny</td>
<td>+</td>
<td>Inst</td>
</tr>
<tr>
<td>Inst</td>
<td>+</td>
<td>Deny</td>
</tr>
<tr>
<td>Deny</td>
<td>+</td>
<td>Deny</td>
</tr>
</tbody>
</table>

- Inst = Success
- Deny = Failure
Serial petitions

• *General Plastic* designated FY17
• Compare FY16 with FY17
• Compare to current
# Serial petitions

Metrics for analysis:

<table>
<thead>
<tr>
<th>FY</th>
<th>Challenges</th>
<th>Serial petition attempts</th>
<th>Attempt rate</th>
<th>Serial petition successes</th>
<th>Success rate</th>
</tr>
</thead>
</table>

## Serial petitions

<table>
<thead>
<tr>
<th></th>
<th>Challenges</th>
<th>Serial petition attempts</th>
<th>Attempt rate</th>
<th>Serial petition successes</th>
<th>Success rate</th>
</tr>
</thead>
<tbody>
<tr>
<td>FY16</td>
<td>1232</td>
<td>89</td>
<td>7%</td>
<td>46</td>
<td>52%</td>
</tr>
<tr>
<td>FY17</td>
<td>1160</td>
<td>86</td>
<td>7%</td>
<td>26</td>
<td>30%</td>
</tr>
<tr>
<td>FY20</td>
<td>938</td>
<td>21</td>
<td>2%</td>
<td>7</td>
<td>33%</td>
</tr>
</tbody>
</table>
Serial petitions

What made a successful serial petition in FY20?

• Patent Owner (PO) asserts new claims in D.Ct (2).
• PO does not contest adding one or two claims (2).
• Filing an IPR after CBM found ineligible and merits not reached (3).
Serial petitions

Observations

• Success rate dramatically dropped after *General Plastic*.

• Attempt rate dropped after success rate dropped.

• Serial petitions were successful when the scope of D.Ct litigation is in flux, or to correct minor errors and omissions.
Parallel petition: Petitioner’s result

Filed $\leq$ 90 days apart

- Inst Inst Inst = Success
- Inst Deny Deny = Failure
- Inst Inst Deny = Success
- Deny Deny Deny = Failure

[order does not change result]
Parallel petitions

- *Comcast v. Rovi*: mid-FY19
- *Trial Practice Guide* update: late FY19
- Compare FY18, FY19, FY20
## Parallel petitions

<table>
<thead>
<tr>
<th></th>
<th>Challenges</th>
<th>Parallel petition attempts</th>
<th>Attempt rate</th>
<th>Parallel petition successes</th>
<th>Success rate</th>
</tr>
</thead>
<tbody>
<tr>
<td>FY18</td>
<td>1178</td>
<td>182</td>
<td>15%</td>
<td>89</td>
<td>49%</td>
</tr>
<tr>
<td>FY19</td>
<td>1033</td>
<td>206</td>
<td>20%</td>
<td>112</td>
<td>54%</td>
</tr>
<tr>
<td>FY20</td>
<td>938</td>
<td>145</td>
<td>15%</td>
<td>43</td>
<td>30%</td>
</tr>
</tbody>
</table>

Note: The average number of petitions filed in a serial petition attempt was 2.22 in FY18; 2.37 in FY19; and 2.28 in FY20.
Parallel petitions

What made a successful parallel petition in FY20?

- Large number of claims / complex claim set (11)
- Prior art eligibility / Antedation Issues (12)
- PO did not contest (20)
- PO asserted new claims in DCt (1)
Parallel petitions

Observations

• Attempt and success rate has fallen
• Over 2/3 of parallel petitions were to cover non-overlapping claim sets on the same art
• About 1/3 of parallel petitions were to cover uncertain prior art status (e.g., antedation or prior art eligibility)
• If a parallel petition is granted, 90% of the time two petitions were instituted in total.
Overview of CBM
CBM proceedings

• Under § 18(a) of the AIA, the transitional program for post-grant review of CBM patents sunset on September 16, 2020.
• Although the program has sunset, existing CBM proceedings, based on petitions filed before September 16, 2020, are still pending.
• The filing of CBM petitions has steadily declined since FY 2014, when filings peaked at 177 CBM petitions. By contrast, in FY 2020, petitioners filed only 20 CBM petitions, with 8 being filed right before the program sunset last month. The year before, in FY 2019, petitioners likewise filed only 22 CBM petitions.
CBM petition filings by fiscal year

CBMs filed
CBM petition filings by month

- **20 CBMs in FY20**
  - Oct 2019: 0
  - Nov 2019: 5
  - Dec 2019: 0
  - Jan 2020: 0
  - Feb 2020: 2
  - Mar 2020: 2
  - Apr 2020: 0
  - May 2020: 1
  - Jun 2020: 1
  - Jul 2020: 0
  - Aug 2020: 1
  - Sept 2020: 8

- **22 CBMs in FY19**
  - Oct 2018: 2
  - Nov 2018: 10
  - Dec 2018: 7
  - Jan 2019: 0
  - Feb 2019: 0
  - Mar 2019: 3
  - Apr 2019: 0
  - May 2019: 0
  - Jun 2019: 0
  - Jul 2019: 0
  - Aug 2019: 0
  - Sep 2019: 0

- **36 CBMs in FY18**
  - Oct 2017: 6
  - Nov 2017: 6
  - Dec 2017: 3
  - Jan 2018: 6
  - Feb 2018: 6
  - Mar 2018: 3
  - Apr 2018: 3
  - May 2018: 0
  - Jun 2018: 3
  - Jul 2018: 3
  - Aug 2018: 2
  - Sep 2018: 1
Questions and comments

Scott R. Boalick
Chief administrative patent judge
(571) 272-9797
scott.boalick@uspto.gov

Jacqueline W. Bonilla
Deputy Chief administrative patent judge
(571) 272-9797
jacqueline.bonilla@uspto.gov