

# **AIPLA-USPTO Roadshows: Enhancing Patent Quality and Conducting AIA Trials**

**August 24 to 28, 2015  
Santa Clara, Dallas, and Alexandria**

**AIPLA**

American Intellectual Property Law Association  
Serving America's Legal and Creative Community

UNITED STATES  
PATENT AND TRADEMARK OFFICE

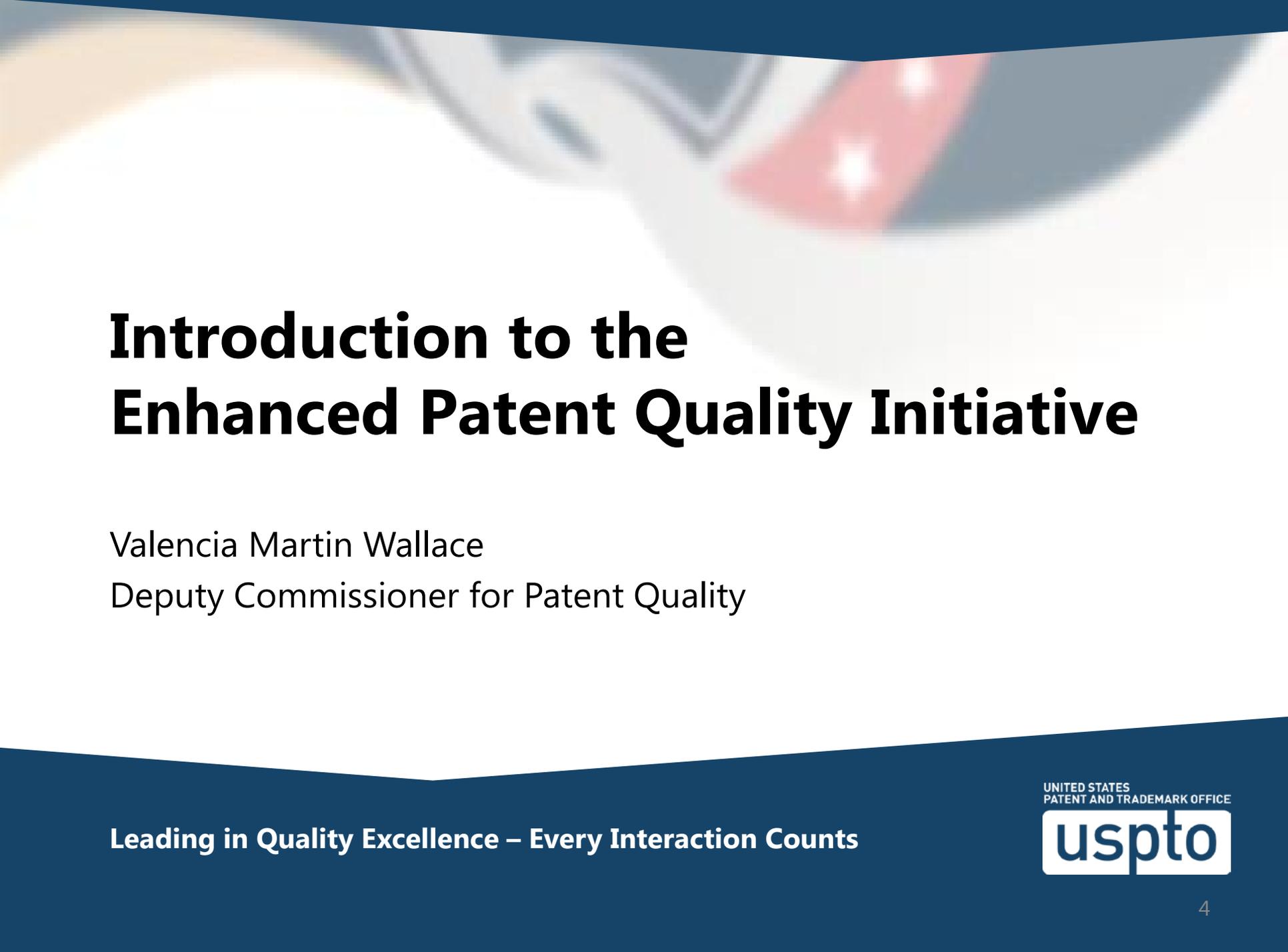
**uspto**

# Opening Remarks

Sharon Israel, Mayer Brown, AIPLA President  
Janet Gongola, Senior Advisor

# Agenda

Time	Topic
9:10 am	USPTO's Enhanced Patent Quality Initiative
9:45 am	Achieving Clarity of the Record
10:45 am	Break
11:00 am	Improving Patent Quality Through Remote Examiner Interviews
11:30 am	USPTO's Quality Metrics
Noon	Lunch with Keynote Speaker: Russell Slifer, Deputy Director
1:30 pm	State of the Patent Trial and Appeal Board (PTAB)
1:50 pm	Overview of Proposed Rule Changes for AIA Trials
2:20 pm	The Bar's Response to Proposed Rule Changes for AIA Trials
2:45 pm	Hot Issues in AIA Trials
3:30 pm	Break
3:50 pm	Live AIA Trial Hearing



# Introduction to the Enhanced Patent Quality Initiative

Valencia Martin Wallace

Deputy Commissioner for Patent Quality

Leading in Quality Excellence – Every Interaction Counts

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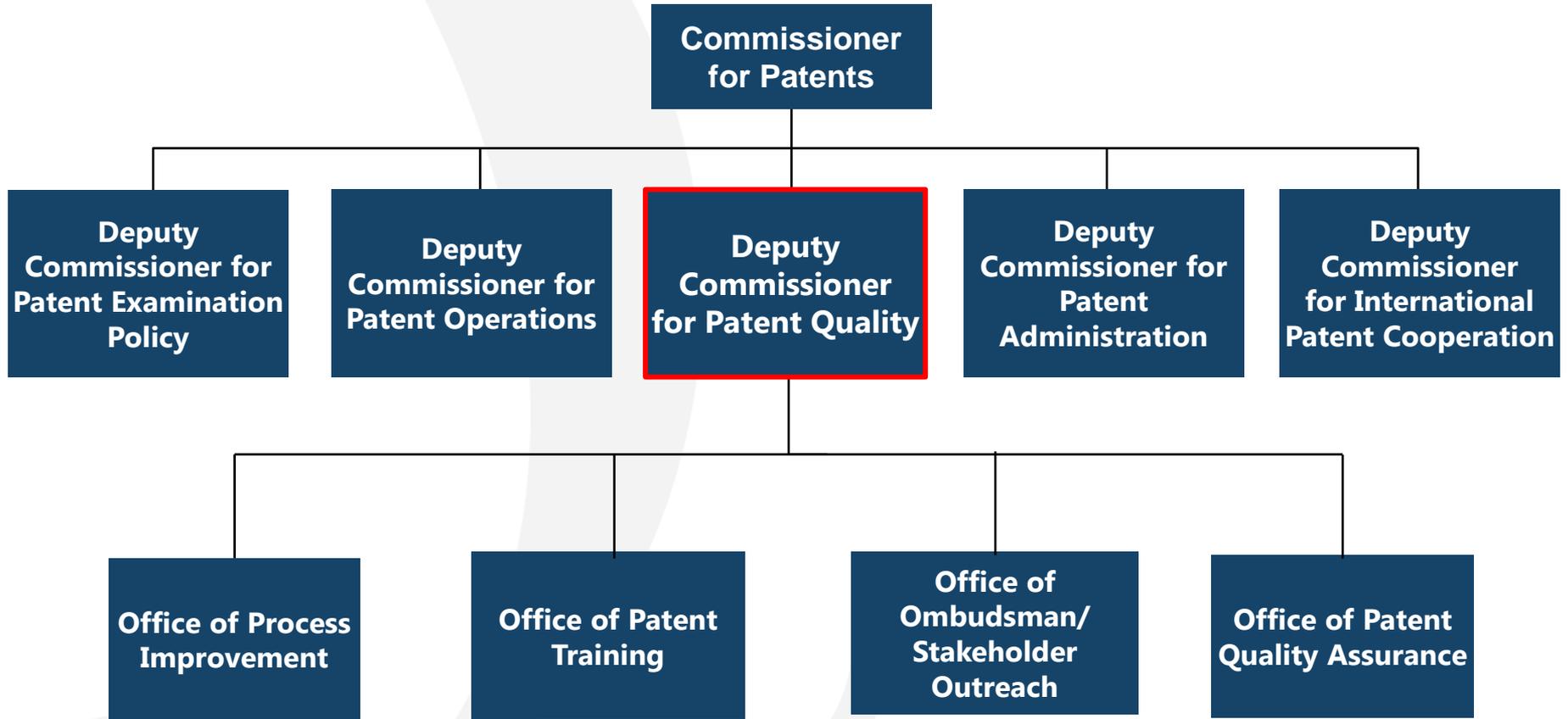
# Creating a World-Class Patent System

*This is the Right Time for a Greater Focus on Quality*

- America Invents Act (AIA) provides USPTO with a stable budget
- USPTO continues to reduce patent application inventory and pendency
- On-going investments in IT and training provide an opportunity to improve quality in our patent system
- USPTO has always made patent quality a priority



# Patents Organization



# Office of Quality Management

## Office of Process Improvement

- Processes Audits & Recommendations
- Provides Coordinated Analysis and Monitoring
- Advises on Process Improvements
- Analyzes Trends
- Defines Standards/Metrics

**Office of Process Improvement (OPI)**

## Office of Patent Training

- Provides Training Assistance
- Provides Enhanced Practices/Procedures
- Recommends Corrective Action & Preventive Action, as needed
- Analyzes Trends
- Defines Standards/Metrics
- Advances Legal and Technical Training

**Office of Patent Training (OPT)**

**Office of Patent Quality Assurance (OPQA)**

## Office of Patent Quality Assurance

- Performs Quality Reviews
- Ensures ISO Compliance
- Analyzes Trends
- Defines Standards/Metrics
- Provides Feedback

**Office of Ombudsman/ Stakeholder Outreach**

## Office of Ombudsman and Stakeholder Outreach

- Performs Incident Management
- Handles Complaints
- Provides Internal/External feedback
- Performs Trend Analysis
- Defines Standards/Metrics
- Handles External Partnering/Engagement



# Current Patent Quality Initiatives

## Internal

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- QAS Details
- GS-14 Trainer Program Expansion
- Search Analysis Program
- Peer Interaction Meetings
- QAS Assistance in TCs
- Interview Specialists
- Training
  - 35 USC § 112(f)
  - 35 USC § 101

## External

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- Patent Quality Chat Webinar Series
- Ombudsman Hours by Time Zone
- Patent Quality Roadshows (Fall 2015)
- Federal Register Public Comments Analysis
- Patent Quality Summit Comments Analysis

# Proposed Enhanced Patent Quality Initiative

- In February, the USPTO proposed six initiatives to enhance patent quality (80 Fed. Reg. 6475 (Feb. 5, 2015))
- These six initiatives are built around three pillars:
  - I. Excellence in Work Product
  - II. Excellence in Measuring Patent Quality
  - III. Excellence in Customer Service



# Enhanced Patent Quality Initiative

## I. Excellence in work products

1. Applicant requests prosecution review of selected applications
2. Automated pre-examination search
3. Clarity of the record

## II. Excellence in measuring patent quality

4. Review/improvements to quality metrics

## III. Excellence in customer service

5. Review of current compact prosecution model and effect on quality
6. In-person interview capability with all examiners



# Comments on the Enhanced Patent Quality Initiative

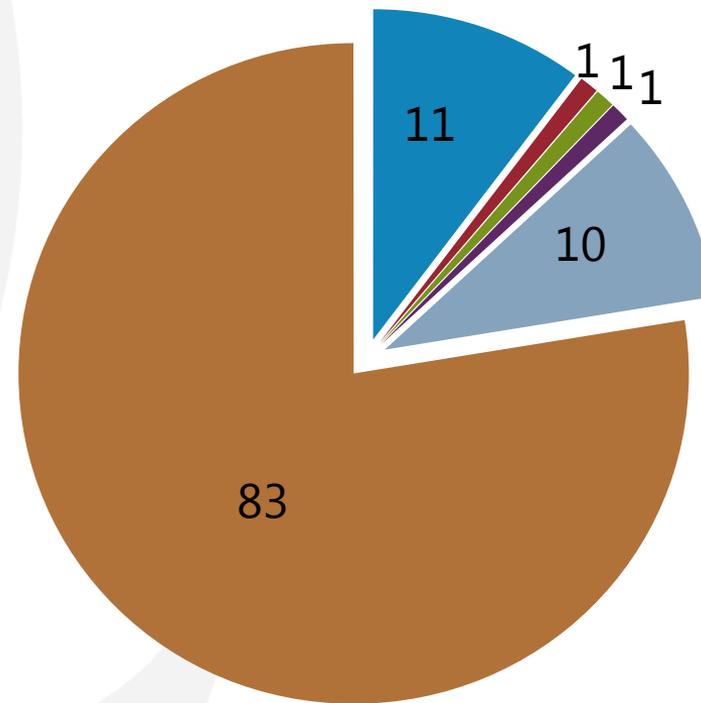
- Comments and suggestions on the enhanced patent quality initiative have been collected from a variety of sources:
  - Two-Day Patent Quality Summit (held on March 25-26, 2015)
  - Federal Register Notice Comment Period (closed May 20, 2015)
  - Internal examiner forums
- We are still collecting comments and suggestions through our World Class Patent Quality (WCPQ) mailbox ([worldclasspatentquality@uspto.gov](mailto:worldclasspatentquality@uspto.gov))



# Official Federal Register Responses

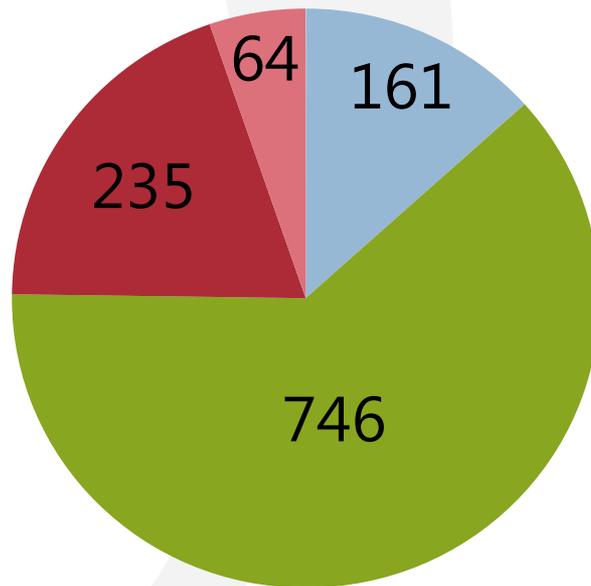
## 107 Responses/Emails

- IP Organizations and Associations
- Government Agencies
- Academic and Research Institutions
- Law Firms
- Companies
- Individuals



# Submissions – All Sources

**1206 Submissions\***



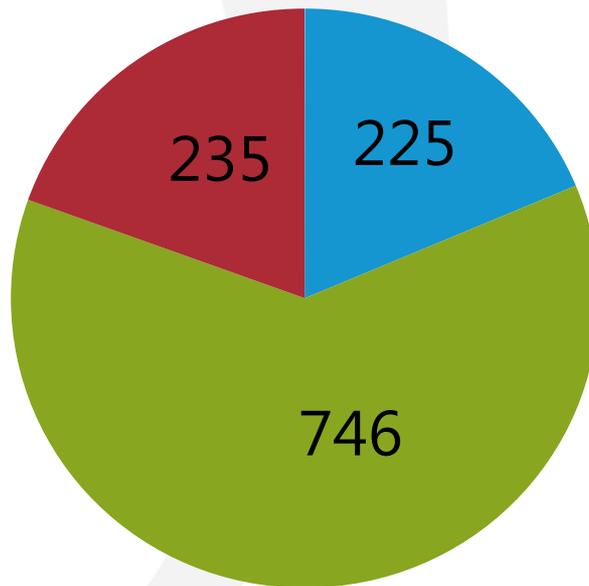
- Examiner
- Forum/Feedback
- Patent Quality Summit
- WCPQ - External
- WCPQ - Internal



\* Response/emails were broken into submissions based on proposal categories. Each email/response, therefore, may map to more than one submission.

# Submissions – All Sources

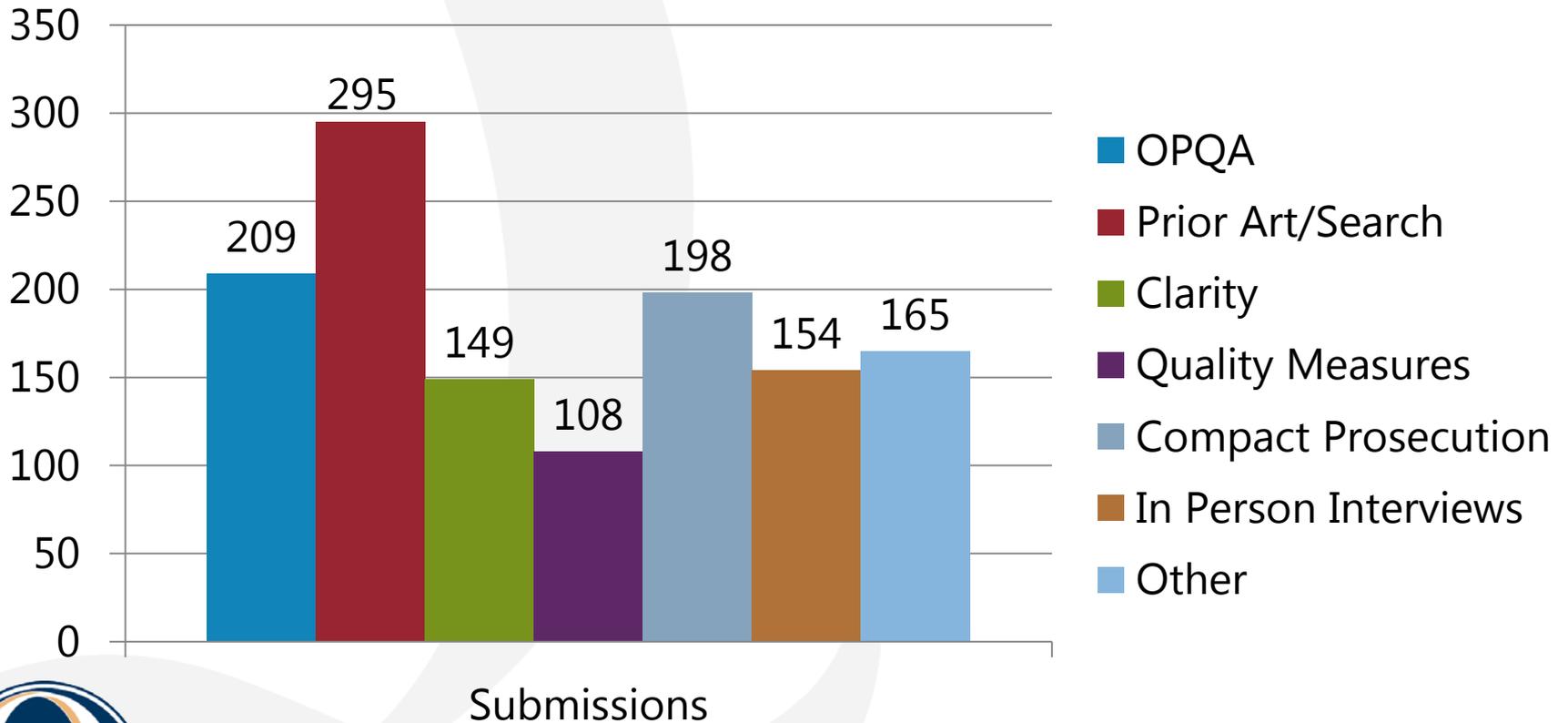
1206 Submissions



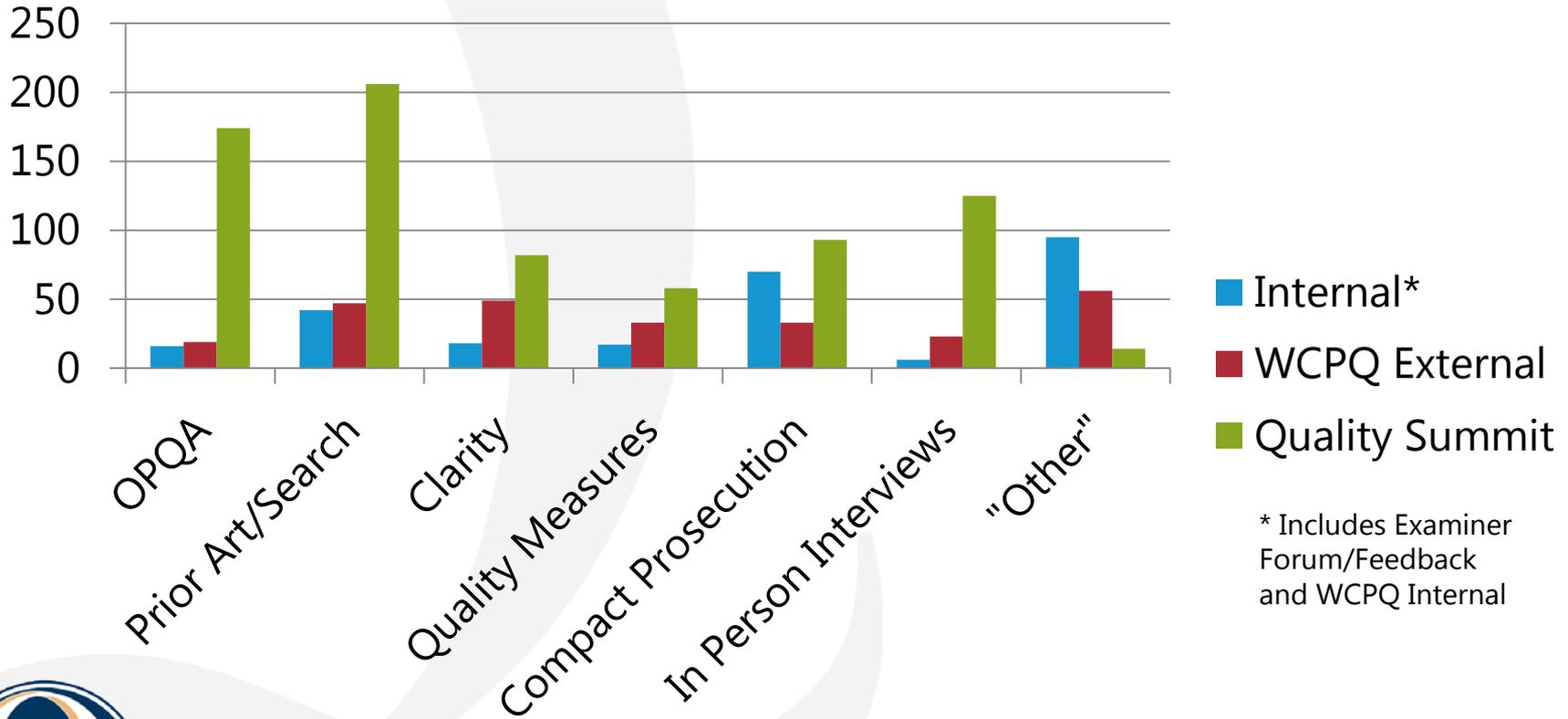
- Internal  
Includes Examiner Forum/Feedback and WCPQ Internal
- Patent Quality Summit
- WCPQ - External



# Topic Distribution – All Sources



# Topic Distribution – By Source



# “Other” Topic Distribution

- Additional Examiner/SPE Resources
- More Time for Examiners
- Improved/Additional Examiner Training
- Examiner PAP/Awards
- Miscellaneous



# Emerging Themes from Comments

- Having examiners clearly articulate their position on the record is a critical component of quality
- The USPTO needs to differentiate between measures of patent process and patent product
- The quality of the interview is much more important than the type of the interview (e.g., telephonic, video conferencing, in-person)



# Next Steps

- We will continue to collect comments through:
  - [WorldClassPatentQuality@uspto.gov](mailto:WorldClassPatentQuality@uspto.gov) email box
  - Patent Quality Chat Webinar Series
- We will analyze the comments and develop recommendations for moving forward



# Achieving Clarity of the Record

Bob Bahr, Acting Deputy Commissioner for Patent Examination Policy

Ken Nigon, RatnerPrestia (Dallas and Alexandria)

Tom Irving, Finnegan Henderson

Courtenay Brinckerhoff, Foley & Lardner, LLP

Wayne Sobon, Inventergy (Santa Clara)

# Best Practices

- Drafting claims
- Prosecuting claims
- Drafting applications
- Claim construction

# Break

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# Improving Patent Quality Through Remote Examiner Interviews

Timothy Callahan, Director, Technology Center 2400

Kathleen Bragdon, Quality Assurance Specialist

Tom Irving, Finnegan Henderson

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# Overview

- Interview Survey Results
- WebEx Interviews
- Authorization Policy
- Interview Resources
  - Interview Specialist
  - Public Interview Rooms
  - Website & Email box



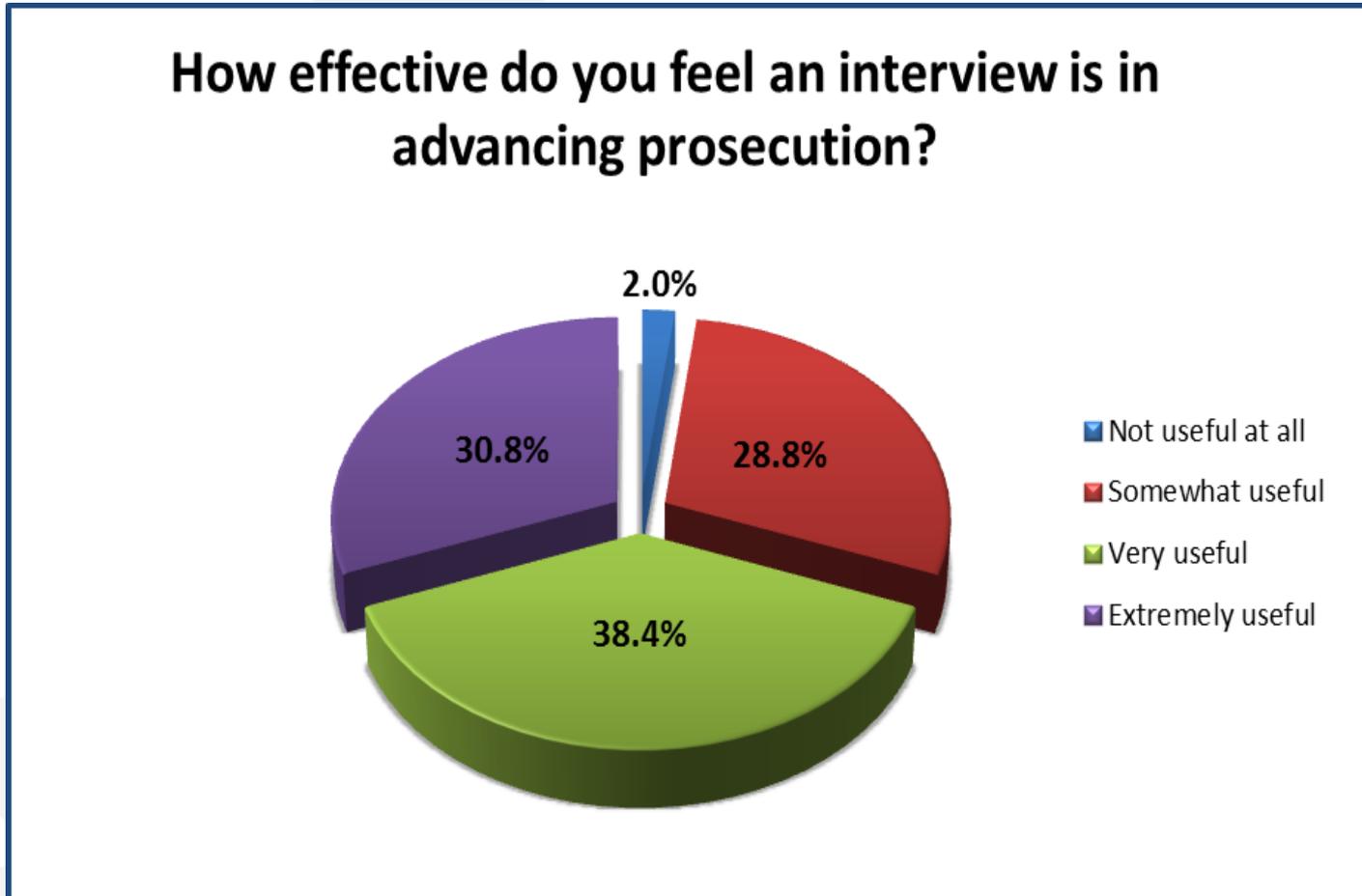
# Interview Surveys

- Surveys on interviews for both Examiners and Applicants were conducted in 2014
- Learn more about interview practice during prosecution
- Identify training opportunities



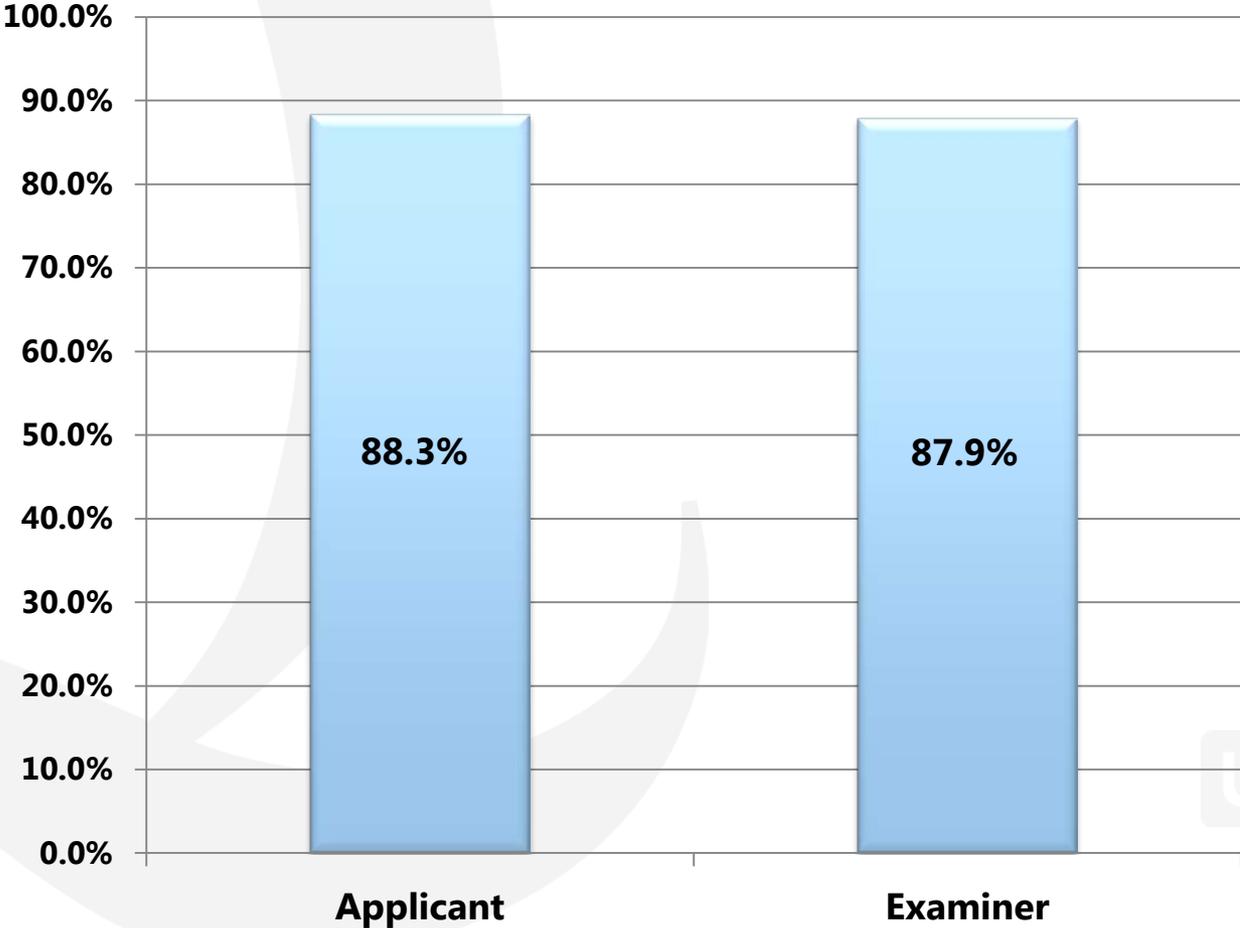
# Interview Survey Results

- For advancing prosecution, Applicants were very positive.



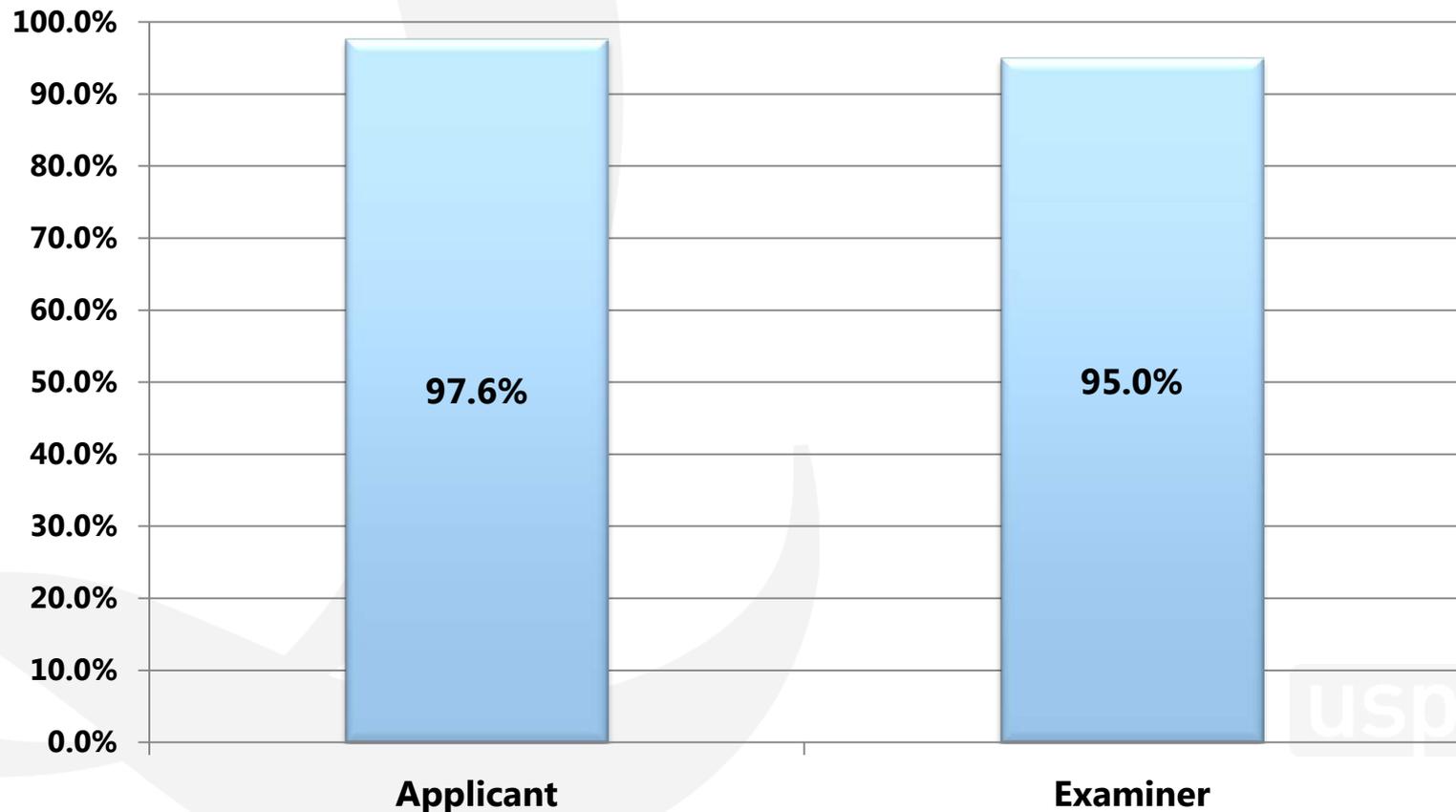
# Interview Survey Results

How often do you get an explanation of the rejection during an interview?



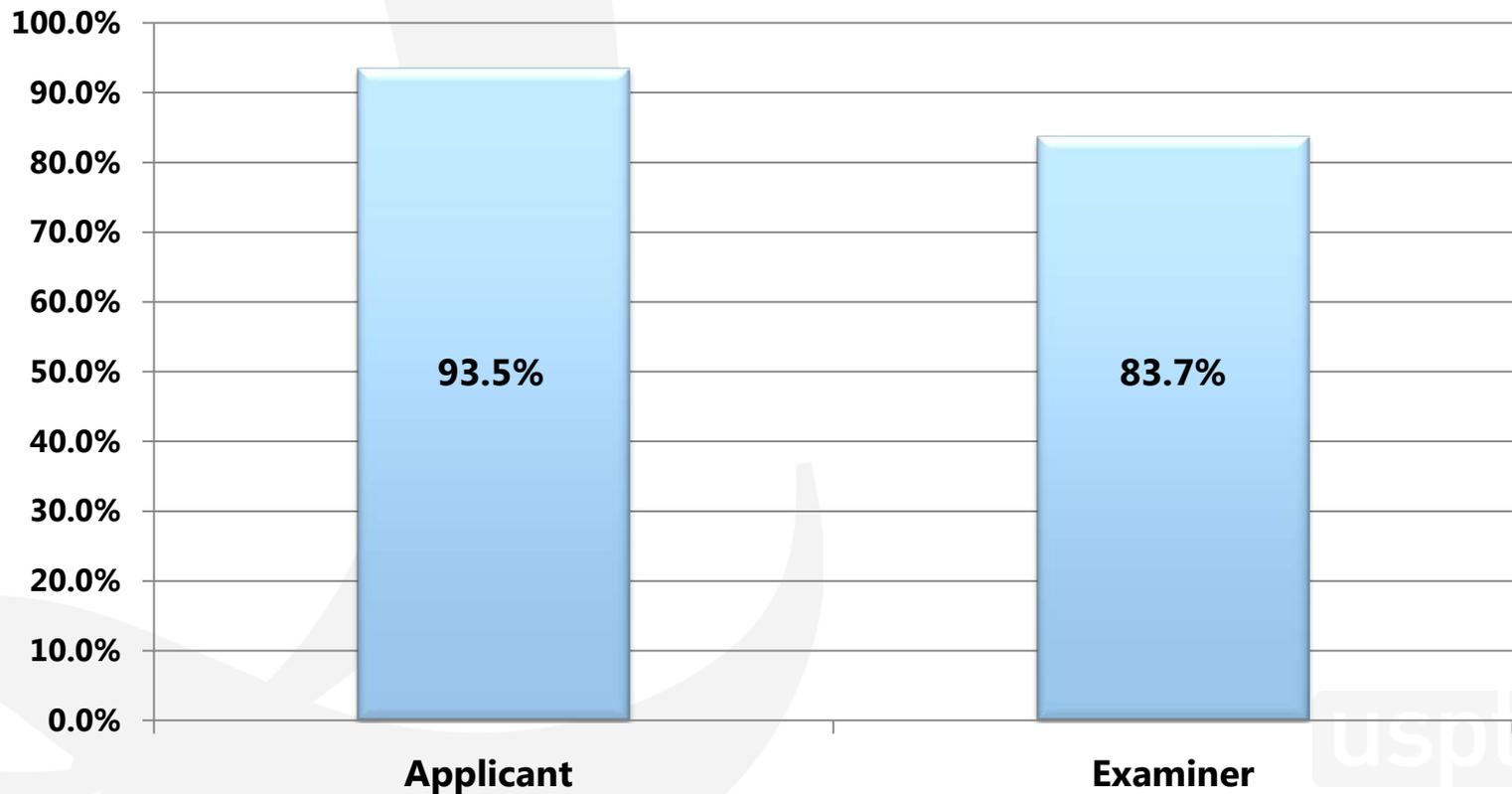
# Interview Survey Results

How often do clarification or better understanding of positions occur during an interview?



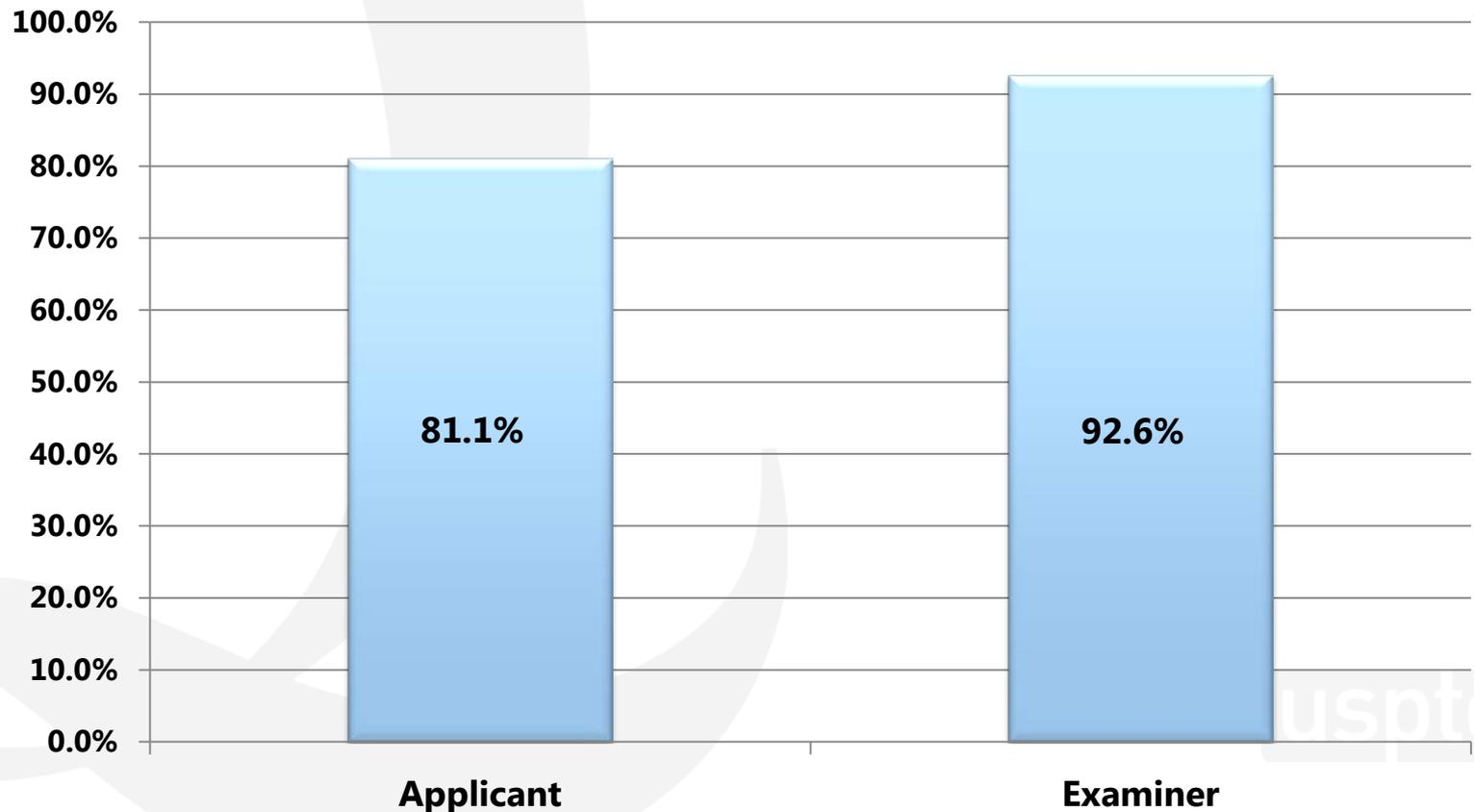
# Interview Survey Results

How often does a better understanding of the claimed invention occur during an interview?



# Interview Survey Results

**How often reaching an agreement or advancing prosecution occur during an interview?**

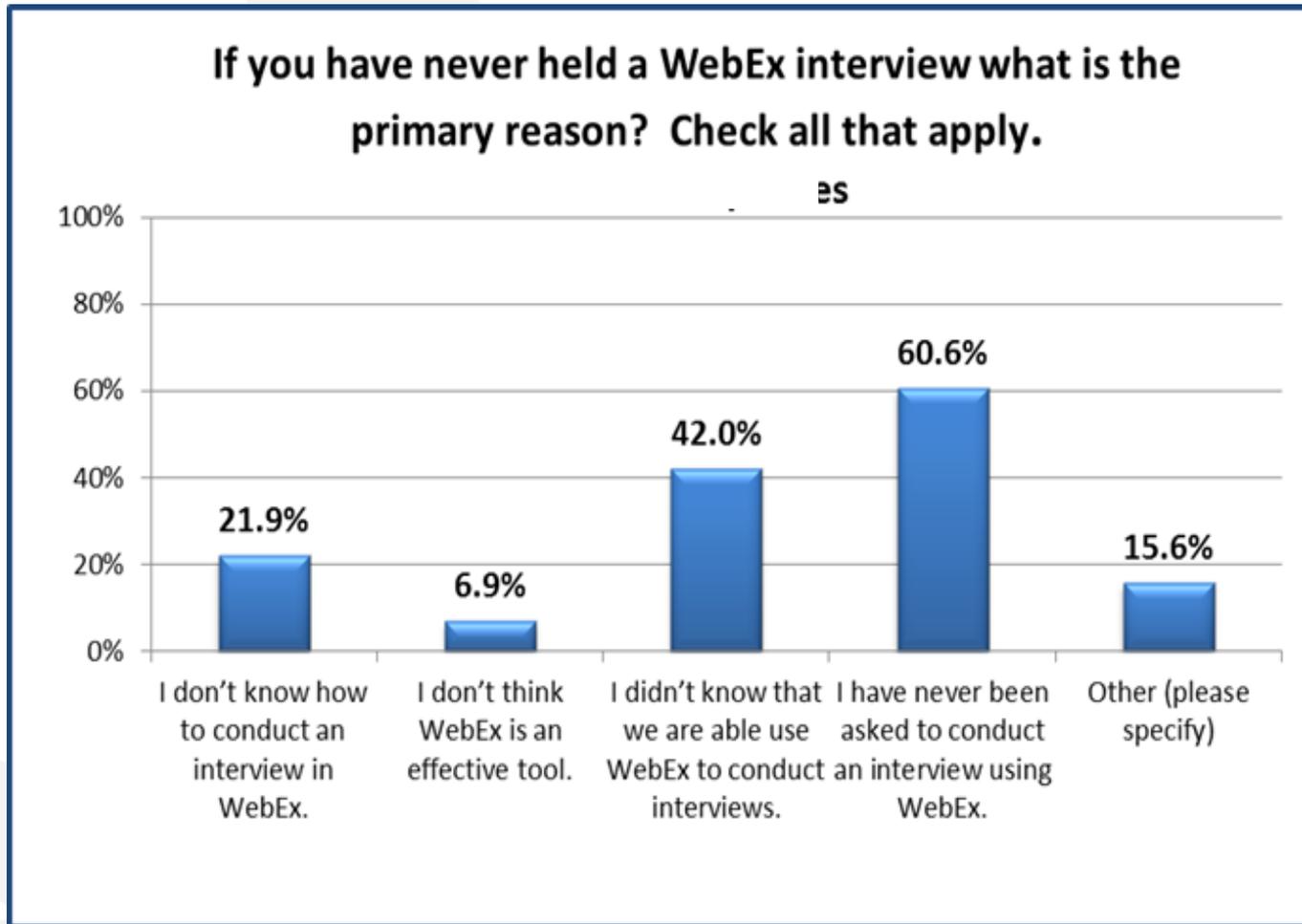


# Interview Survey Summary

- Most interviews are initiated by Applicants according to both surveys
- 99% of Applicants indicated that request for interviews are usually granted.



# Training Opportunities



# WebEx Basics & Demo

- You need a computer and a high-speed Internet connection is recommended.
- WebEx is a web-based service, so you can use it from any computer (Windows, Mac, Linux, or Solaris).
- No software needs to be downloaded or purchased.
- A telephone will be used to join the audio component of the meeting while a video camera may be used as part of the visual component.



# Click Link for Examiner

Open the email containing the WebEx online meeting invitation and click on the link to join the visual component of the online meeting.

-----  
To join the online meeting (Now from mobile devices!)  
-----

1. Click the following link: [Join the meeting](#)
2. If requested, enter your name and email address.
3. If a password is required, enter the meeting password:
4. Click "Join".





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# Verbal Authorization for Video Conferencing

## Change to Internet Usage Policy to Permit Oral Authorization for Video Conferencing Tools

- Policy has been updated to make it easier for Applicants to authorize the use of video conferencing tools to conduct examiner interviews.
- MPEP § 502.03 now allows a verbal request to authorize a WebEx interview, instead of submitting a written request.
- The verbal authorization is limited to the video conference interview and does not extend to other communications regarding the application.



# Interview Specialist

- Subject matter expert on interview practice and policy in each Technology Center
- To assist Examiners and Applicants in facilitating effective interviews
- The list of TC Specialists can be found here:  
<http://www.uspto.gov/patent/laws-and-regulations/interview-practice/interview-specialist>



# WebEx Training & Assistance

- Applicants who are interested in more detailed WebEx training may request a **one-on-one** WebEx training session with an interview specialist.
- Please email your request to [ExaminerInterviewPractice@USPTO.gov](mailto:ExaminerInterviewPractice@USPTO.gov)
  - Include preferred dates and times
  - Please give at least one week notice



# Public Interview Rooms

- A Public Interview Room is a video conference room on each USPTO campus designated for Applicants to use to connect and collaborate with examiners that are working remotely or at a different USPTO campus
- Currently in Alexandria, Detroit & Denver
- Coming soon to San Jose & Dallas



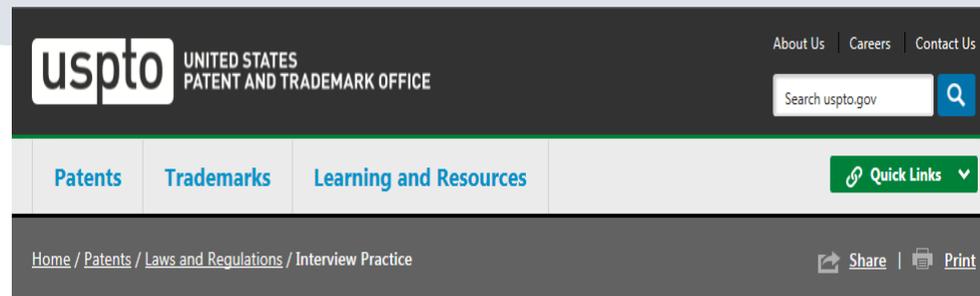
# Public Interview Rooms

- Must be reserved by Examiner at least two business days prior to interview.
- Written or verbal authorization to communicate electronically is required prior to reserving a public interview room (see MPEP § § [502.03](#) and [713.01](#), and 80 Fed. Reg. 23787, April 2015).



# Website

- USPTO.GOV
  - Policies
  - Training
  - FAQs
  - Contacts
- Comments & Questions  
[ExaminerInterviewPractice@USPTO.gov](mailto:ExaminerInterviewPractice@USPTO.gov)



Helpful 0

← Laws and Regulations

America Invents Act (AIA)

American Inventors Protection Act of 1999

Comments from the Public

**Interview Practice**

Examination Policy

Patent Related Notices

Patent Term Extension

Power of Attorney and Assignment

Revised Amendment Practice 37 CFR

## Interview Practice



**Interview Practice** provides you with free access to video conferencing with USPTO examiners. To join, you need a computer, high speed internet connection, a webcam and a telephone. If you cannot join from home or your office, USPTO offers dedicated meeting rooms at each of its major campuses (Alexandria, Va.; Detroit, Mich.; and Denver, Colo.).

### Survey



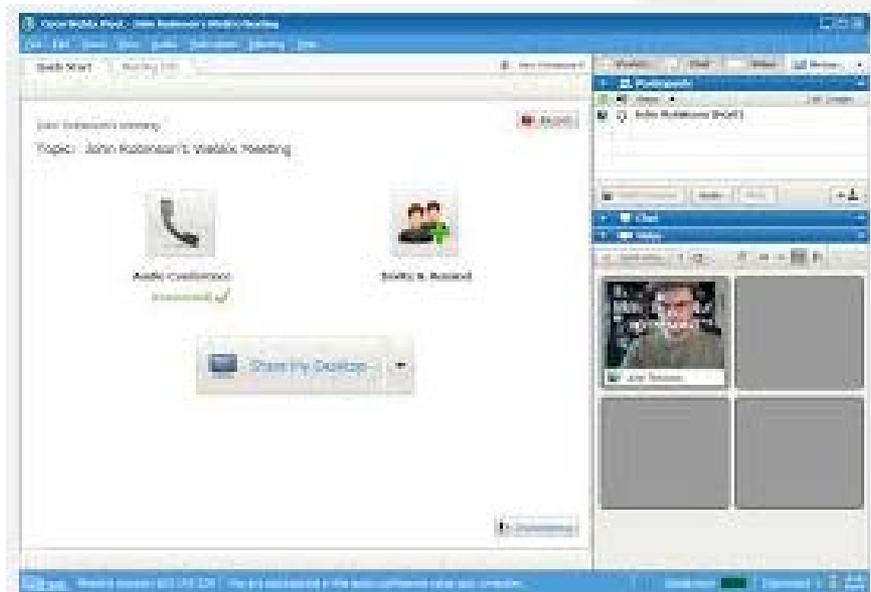
We have created a brief survey to learn more about applicant experiences with interview practices during prosecution. Responses will help us identify the best practices and training needs for USPTO.

[Take the survey](#).

### Federal Register Notice

USPTO is updating its Internet usage policy by modifying the authorization requirements to now permit oral authorization for video conferencing tools, such as WebEx, to be provided by the patent applicant/ practitioner

# WebEx Demo



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# Step 1: Click Emailed Link

Open the email containing the WebEx online meeting invitation and click on the link to join the visual component of the online meeting.

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To join the online meeting (Now from mobile devices!)

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1. Click the following link: [Join the meeting](#)
2. If requested, enter your name and email address.
3. If a password is required, enter the meeting password:
4. Click "Join".



# Step 2: Sign In

Enter '**Your name**' and '**Email address**' in the Meeting Center window and click '**Join**'.

● It's time to join!

Your Name:

Email Address:

Meeting password:



# Step 3: Allow Plug-In

If an Add-On or Plug-In appears and you have administrative privileges to install the application, select '**Allow**' or '**Download**' to install and launch the WebEx Application. (Depending on which browser you are using, the dialog box may appear different.)

## Internet Explorer:



## Google Chrome:



# Step 4: Java Admin Options

If Administrative privileges are not available, users can **'Use Java'** on Internet Explorer or **'Run a temporary application'** on Google Chrome and Mozilla Firefox.



# Step 5: Call In

To join the audio component of the online meeting, enter your **10 digit phone number** in the Audio Conference Window and click on '**Call Me**'. WebEx will call the entered phone number.



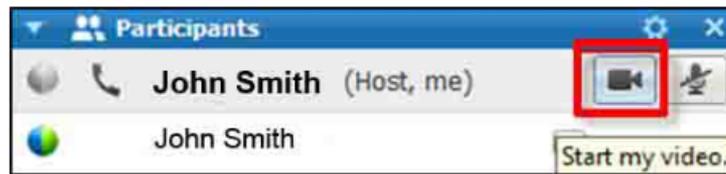
# Step 6: Answer Phone

Your phone will ring. Answer it and when prompted, press **'1'** on the phone dial pad to enter the audio portion of the conference.



# Step 7: Start Video

To join the visual component of the online meeting, when the WebEx Meeting starts, click the **'Start my video'** button next to your name in the participants list.

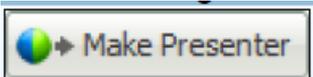


# Conducting WebEx Interviews

- **Conducting the Video Conference - Presenter**

## Designating a presenter

The first person to arrive is made the presenter, but the Host can assign a Participant the Presenter's role.

1. On the **Participants** panel, select a name to designate as the Presenter.
2. Click the **Make Presenter** button. A rectangular button with a light gray background and a thin blue border. On the left side of the button is a small globe icon with red, green, and blue segments. To the right of the globe is a right-pointing arrow, followed by the text "Make Presenter" in a dark gray font.
3. To reclaim the Presenter's role, select your own name and click the **Make Presenter** button.



# Conducting WebEx Interviews

## • Conducting the Video Conference - Sharing

### Sharing Files and Applications

- Share a **File** to present information that will not be edited.
- Share an **Application** to demonstrate software, edit a document, or train attendees on using an application.

Click to expand the **Share** drop-down menu from the main **Quick Start** tab, or the **Share** drop-down menu; see **Figures 16 and 17**.

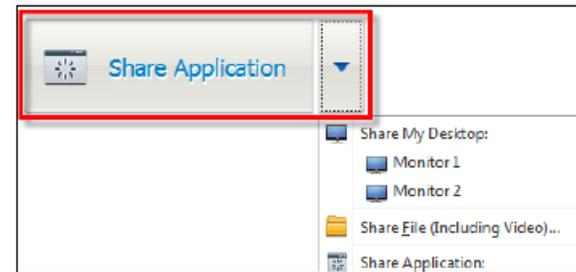


Figure 16. Share Application Menu

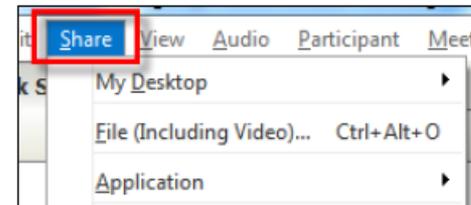


Figure 17. Share Menu

**Note:** Desktop sharing is not available for external meetings (interviews)

**Note:** File must be open for you to share it.

**Note:** Participant must be **Presenter** to share



# Conducting WebEx Interviews

- **Sharing Examples**

During an interview, an Examiner can share their **eDAN** application to e.g., view claims, or **EAST** application to e.g., discuss a cited reference.

The screenshot displays two web browser windows. The left window is eDAN 3.7.0, showing a patent application for 'CLM: BRENNEMAN, ROBERT (SR)'. The right window is EAST Browser, displaying a patent document for 'United States Patent Application Publication' (Pub. No. US 2006/0013235 A1) by Farnham, dated Jan. 19, 2006. The document includes an abstract, inventor information (Timothy David Farnham), and a technical diagram of a network system. The diagram shows a 'Mobile Device' connected to an 'Internet' cloud, which is connected to a 'Server' and a 'Dynamic Proxy'. A 'Certificate' is also shown connected to the 'Mobile Device' and the 'Internet'.



# Conducting WebEx Interviews

- **Conducting the Video Conference - Sharing**

When viewing a document in full-screen mode, or when sharing an application or desktop, use the **WebEx Sharing** toolbar to access annotation tools. Hover the cursor over the sharing note at top center of the monitor to bring up the **Control Panel**; see **Figure 18**.

The **Annotate** button will display annotation tools that can be used in conjunction with shared materials to call out specific elements; see **Figure 19**.



Figure 18. WebEx Sharing Toolbar



Figure 19. Annotation Tools



# Conducting WebEx Interviews

- **Annotate Example**

During an interview, an Examiner can annotate a shared document, e.g., **markup** a copy of the claims.

An Examiner can also use the **pointer tool** to e.g., show applicant where a claimed feature is not positively recited or point to where a claimed feature is taught in a reference.

The screenshot displays the eDAN 3.7.0 software interface. The main window shows a patent document titled '59000100 - CLM - BRENNEMAN, ROBERT (SIRA) - Claims, 1 of 4'. The document text includes the following sections:

**IN THE CLAIMS**

Please amend the claims as shown below.

1. (Original) A communication control method for controlling communication between wireless communication apparatuses that are capable of communicating wirelessly in a first communication mode in which communication is performed via a base station and a second communication mode in which communication is performed with a wireless communication apparatus directly, said method comprising:

- a connecting step of connecting a first wireless communication apparatus to a second wireless communication apparatus if, during communication by the first wireless communication apparatus in the first communication mode, the first wireless communication apparatus receives a search signal from the second wireless communication apparatus giving notification of the existence of the second wireless communication apparatus;
- a determining step of determining, by the second wireless communication apparatus, whether the first wireless communication apparatus possesses a desired function; and
- a data transmitting step of transmitting data from the second wireless communication apparatus to the first wireless communication apparatus in the second communication mode based upon result of the determination performed at said determining step.

A green arrow points to the underlined text 'step.' with a red note below it: 'Need to check out col. 2, II, 5-6 of Reference'.

The interface also includes a table of prosecution items on the left:

Item	St.	Doc. Code	Document Type
1	10	COCHECK	Compact Disk Review
2	10	COCHECK	Compact Disk Review
3	10	SEQ TXT	Sequence Listing
4	7	FOR	Foreign Reference
5	7	WCLM	Claims Worksheet
6	7	SPEC	Specification
7	7	SPEC	Specification
8	7	SPEC	Specification
9	7	DRW	Drawings-only black line drawings
10	7	IDS	Information Disclosure Statement (IDS) Form
11	7	CLM	Claims
12	7	REM	Applicant Argument Made in an Amendment
13	7	ADS	Application Data Sheet
14	7	ABST	Abstract
15	7	371P	Documents submitted in Applications
16	7	371P	Documents submitted in Applications
17	7	371P	Documents submitted in Applications
18	7	371P	Documents submitted in Applications
19	7	371P	Documents submitted in Applications
20	7	371P	Documents submitted in Applications
21	7	TRNA	Transmittal of New Applications
22	7	OATH	Oath or Declaration
23	7	WFEE	Fee Worksheet (SIR)
24	7	SPEC	Specification

The 'Annotation Tools' toolbar at the bottom includes a pointer tool, text tool, line tool, rectangle tool, highlighter tool, eraser tool, and a save icon. Below the toolbar are buttons for 'Allow to Annotate...', 'Stop Annotate...', and 'Restore'.





# USPTO Patent Quality Metrics

Marty Rater, Chief Statistician

Valencia Martin Wallace, Deputy Commissioner for Patent Quality

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# Overview

- OPQA Structure
- Work Product Reviews
- Surveys
- Examiner Transactional Data
- Quality Composite
- Next Steps

# Office of Patent Quality Assurance (OPQA)

- OPQA is responsible for the overall assessment and measurement of patent *examination* quality at the USPTO.
  - Measurement accomplished through:
    - work product reviews;
    - administration of satisfaction-based surveys; and
    - analysis of examiner transactional data



# Office of Patent Quality Assurance (con't)

- 53 Review Quality Assurance Specialists (RQAS)
  - Former primary examiners with demonstrated skills in examination quality, productivity, efficiency, mentoring and training
    - Avg. 22 years patent examination experience
  - Tasks include review of examiner work product, training, mentoring, and serving as subject matter experts
    - Assigned to specific technology in which they have examination experience



# Office of Patent Quality Assurance (con't)

- RQAS Duties:
  - 75% of time dedicated to review of work product
  - 25% of time providing Technology Center training and assistance
- 6 Supervisory RQAS (SRQAS) oversee the RQAS
  - Ensure consistency among reviewers
  - Validate issues raised and interact with Patent Corps
- Statisticians and program analysts

# Work Product Reviews

- Randomly selected Office Actions to ensure that any metric we generate represents a true picture of all patent corps work product

# Work Product Reviews (con't)

- Key metrics derived from work product reviews:
  - Final Disposition Compliance Rate
    - Measures correctness of the final determination made by an examiner – either the decision to allow a patent or finally reject it
    - Review for improper or omitted rejections, improper finality, failure to treat arguments
  - In-Process Compliance Rate
    - Measures correctness and reasonableness of Office Actions during prosecution (non-final actions)
    - Review for improper or omitted rejections, improper restriction practice, failure to treat arguments, and other issues that may significantly inhibit the advancement of prosecution

# Other Work Product Reviews

- First Action on the Merits (FAOM) and Search:
  - Implemented in 2011 to better capture quality at initial stages of prosecution
  - Provides more insight into clarity issues than normal compliance reviews
    - Key focus of current quality initiative
- Targeted Reviews
  - Ad hoc reviews to assist in evaluating the effectiveness of training and the impact of programs on quality
    - e.g., 101 rejections, use of 3<sup>rd</sup> party art submissions, restriction practice



# Internal Quality Survey

- Conducted semi-annually
- Measures patent examiner satisfaction with various factors that lead to the ability to perform high quality patent examination
  - Evaluates overall **examiner** experience in past 3 months with respect to:
    - Office-related factors: tools, training, etc.
    - Applicant-related factors: incoming patent applications, applicant responses, etc.



# External Quality Survey

- Conducted semi-annually
- Measures applicant and practitioner satisfaction with patent examination quality
  - Evaluates overall **applicant** experience in past 3 months with respect to:
    - Consistency
    - Reasonableness of rejections
    - Adhering to rules and procedures



# Quality Index Reporting (QIR)

- Statistical analysis of data representing examination events (examiner trends) occurring during prosecution
  - Data taken from the USPTO internal database
- Statistical analysis identifies outlier populations that can signal the presence of quality or procedural issues that represent best practices or opportunities for improvement
- Typically a process-based evaluation of quality rather than an end-product inspection

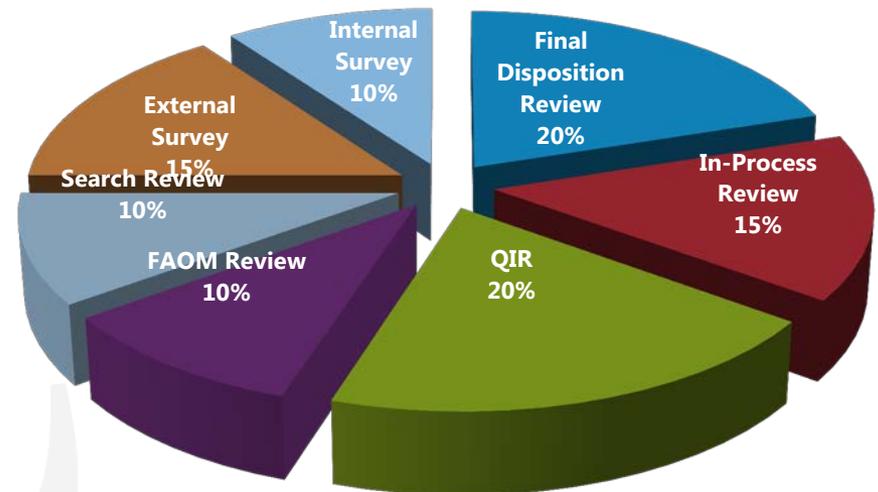
# Uses of Quality Data

- In addition to generating metrics of quality to gauge performance, USPTO uses OPQA data to:
  - Develop training
  - Measure effectiveness of training
  - Determine the impact of PTO programs on quality
    - Telework programs, etc.

# Quality Composite

- In 2011, USPTO implemented a Quality Composite in an attempt to consolidate the wide variety of quality metrics and generate a single index that could be used to quickly assess progress towards Office goals.

Quality Composite Items and Weights



# Lunch Keynote

Russell Slifer, Deputy Under Secretary and Deputy Director of  
the USPTO

# State of the Patent Trial and Appeal Board

Scott Boalick, Acting Deputy Chief Judge

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# Appeals Statistics

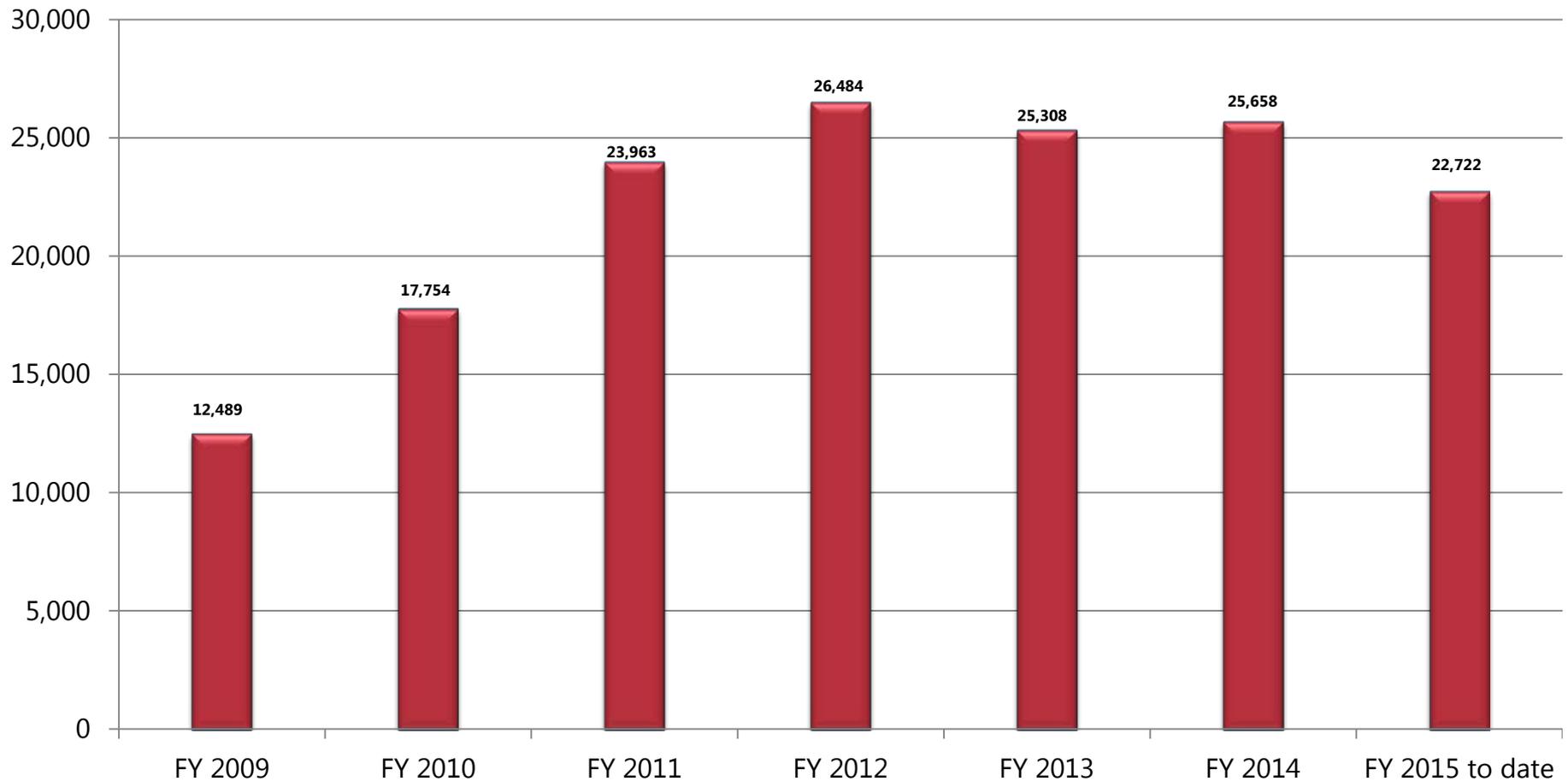
# PTAB Receipts and Dispositions

*Period: 07/11/2015 thru 08/11/2015*

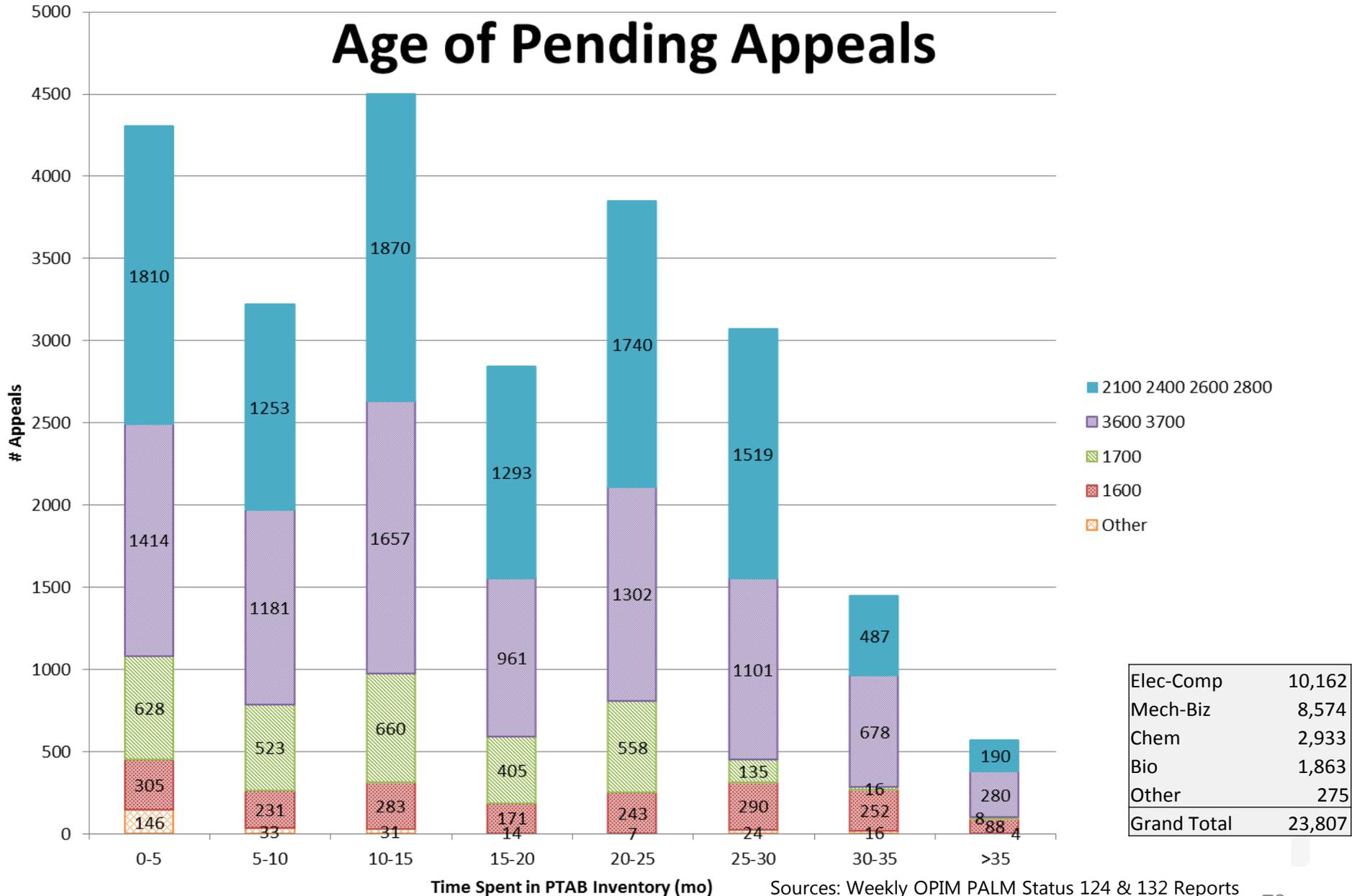
Discipline	# Cases Received	# Cases Disposed	Difference (Disposed minus Received)
Biotech	64	37	-27
Business Methods	35	104	69
Chemical	116	125	9
Contested Cases	65	24	-41
Design	2	1	-1
Electrical	329	507	178
Mechanical	208	240	32
***Totals***	819	1038	219

# PTAB Inventory – Pending Ex Parte Appeals

(excluding appeals from reexamination proceedings)



# Age of Pending Appeals



Elec-Comp	10,162
Mech-Biz	8,574
Chem	2,933
Bio	1,863
Other	275
<b>Grand Total</b>	<b>23,807</b>

Sources: Weekly OPIM PALM Status 124 & 132 Reports (6/2/15)

# **Expedited Patent Appeal Pilot (EPAP)**

# Purpose

- Allows appellant to have an *ex parte* appeal accorded special status in return for withdrawing another *ex parte* appeal pending before the Board
- Assists Board in reducing its inventory of *ex parte* appeals

# Effective Date and Duration

- Pilot is effective June 19, 2015
- Pilot will run until 2,000 appeals have been accorded special status, or until June 20, 2016, whichever occurs earlier

# Participation in EPAP

- Appellant must file a petition under 37 C.F.R. § 41.3 to the Chief Judge in the application for which special status is sought
  - Use Form/PTO/SB 438
  - File through EFS-Web
  - Can only be filed an appeal for which a docketing notice was mailed no later than June 19, 2015
  - Petition fee is waived; no fee

# Content of Petition

- Identifies by application number and appeal number both appeal to be made special and appeal to be withdrawn
- Withdraws request for oral hearing in appeal to be made special (no refunds)
- Withdraws appeal in another application for which a docketing notice was mailed no later than June 19, 2015 (no refunds)
- Applications involved in both appeals must be owned by the same party as of June 19, 2015, or name at least one inventor in common
- Must be signed by a registered practitioner who has a power or attorney under 37 C.F.R. § 1.32, or has the authority to act under 37 C.F.R. § 1.34 in both applications.

# Other Considerations

- Withdrawal of an appeal may not be used for more than one petition to make special under EPAP
- Appeal made special will be advanced out of turn for a decision on the appeal, but the application will not have special status after the decision on appeal
- Applicant can file a Request for Continued Examination (RCE) in the application for the appeal to be withdrawn
  - RCE must be filed with the petition under 37 C.F.R. § 41.3
  - Application having no allowed claims becomes abandoned upon withdrawal of an appeal.

# How soon will I receive a decision?

- Goals:
  - Render decision on petition to make the appeal special: 2 months from filing date of petition
  - Render decision on appeal: 4 months from date a petition to make appeal special is granted

# Pendency of Decided Appeals

(from 10/1/2014 through 7/31/2015)

Discipline	Technology Center	Number of Decisions	Pendency from PTAB Docketing to Decision (Months)
Biotech	1600	395	32.4
Chemical	1700	1152	24.9
Electrical	2100	1490	31.7
	2400	1698	31.4
	2600	1305	31.3
	2800	626	27.0
Designs	2900	20	26.2
Mech/Bus Methods	3600	1671	31.6
	3700	1389	30.1
Reexams	3900	218	6.0
Total Average		9,964	29.7

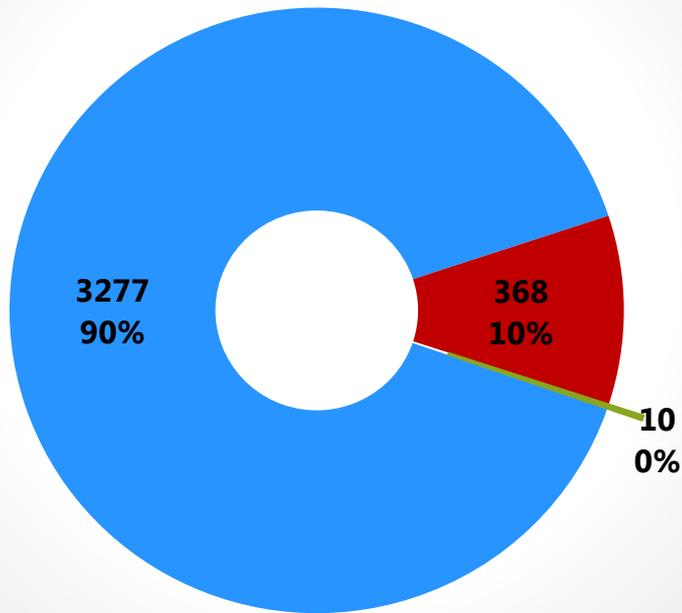
# **AIA Statistics**

## Comparison by Technology Center of FY 2014 AIA Filings v. Patent Grants

TC	AIA Filings	Patent Grants
1600	90	24,669
1700	107	31,863
2100	188	24,422
2400	114	30,983
2600	223	40,445
2800	289	70,281
2900	3	22,452
3600	226	38,160
3700	156	42,931
Other	98	176
Total	1,494	326,382

# 3655 Total AIA Petitions\*

Cumulative from 09/16/2012



■ Total IPR Petitions ■ Total CBM Petitions ■ Total PGR Petitions

## Narrative:

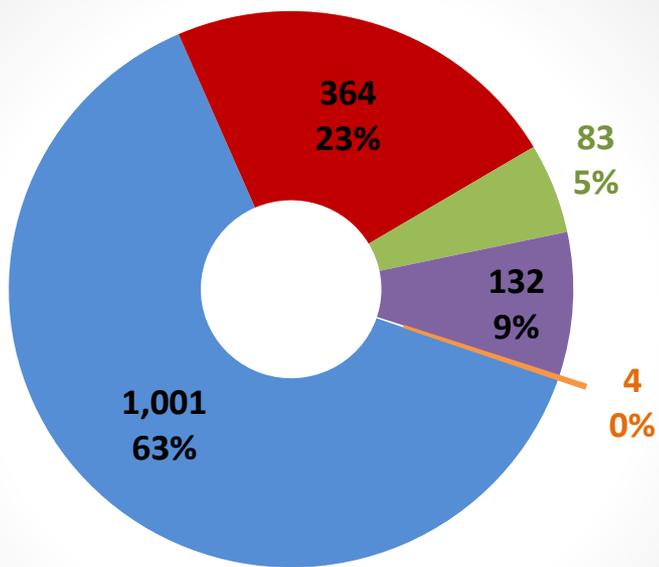
This pie chart shows the total number of cumulative AIA petitions filed to date broken out by trial type (i.e., IPR, CBM, and PGR).

**\*Data current as of: 7/31/2015**





### 1584 Total AIA Petitions in FY 2015\* (Technology Breakdown)



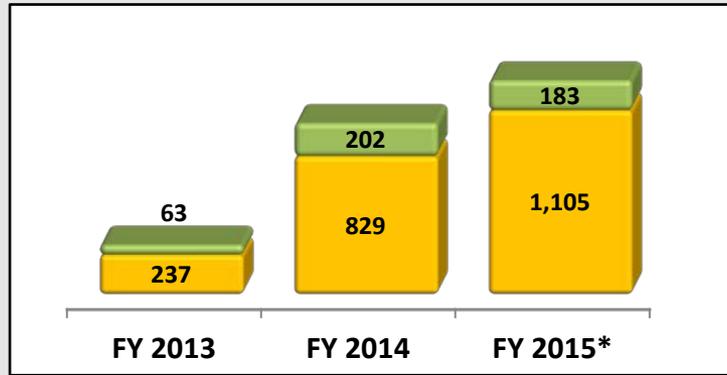
- Electrical/Computer - TCs 2100, 2400, 2600, 2800
- Mechanical/Business Method - TCs 3600, 3700
- Chemical - TC 1700
- Bio/Pharma - TC 1600
- Design - TC 2900

#### **Narrative:**

This pie chart shows the total number of AIA petitions filed in the current fiscal year to date as well as the number and percentage of these petitions broken down by technology.

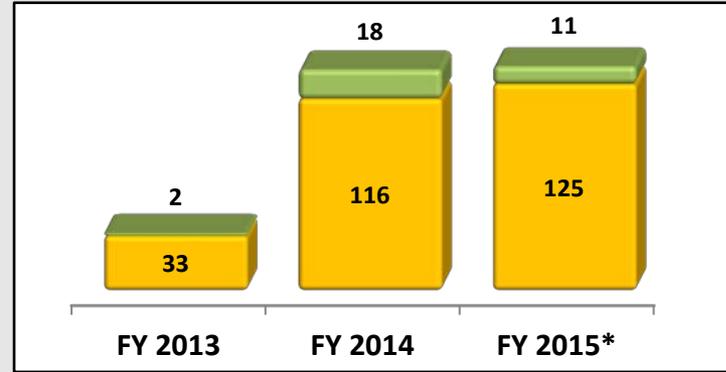
**\*Data current as of: 7/31/2015**

**IPR - Number of Patent Owner Preliminary Responses by Fiscal Year**



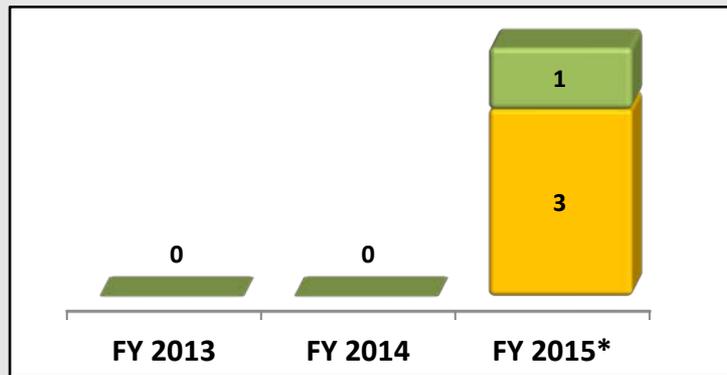
■ Filed ■ Waived/Not Filed

**CBM - Number of Patent Owner Preliminary Responses by Fiscal Year**



■ Filed ■ Waived/Not Filed

**PGR - Number of Patent Owner Preliminary Responses by Fiscal Year**



■ Filed ■ Waived/Not Filed

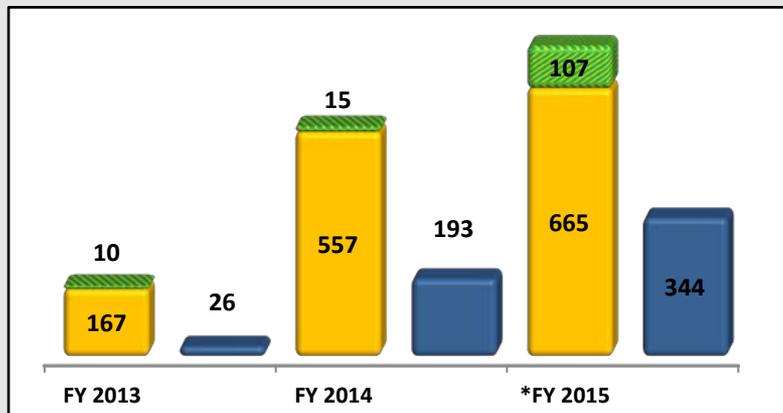
**Narrative:**

These three sets of bar graphs show the number of patent owner preliminary responses filed and waived/not filed each fiscal year in IPR, CBM, and PGR proceedings.

**\*Data current as of: 7/31/2015**

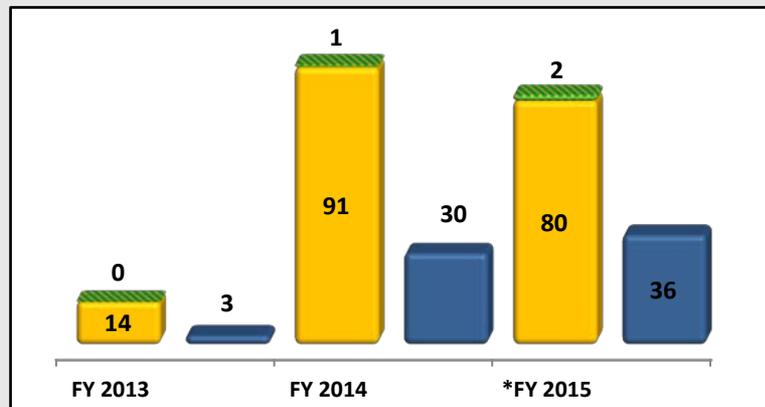


**IPR - Number of Decisions On Institution Per Fiscal Year by Outcome**



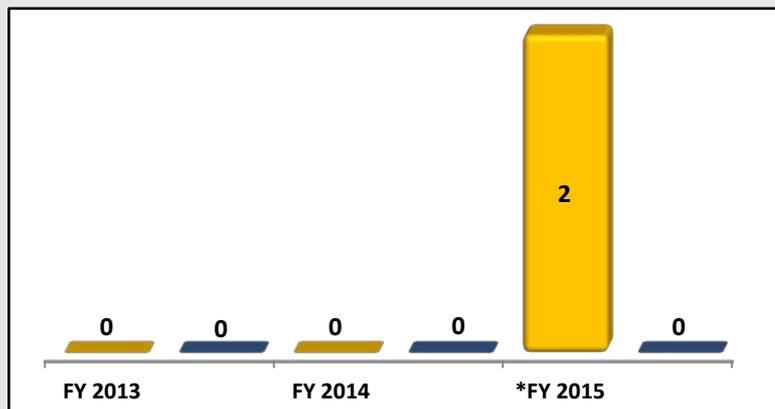
■ Instituted ■ Joiners ■ Denials

**CBM - Number of Decisions On Institution Per Fiscal Year by Outcome**



■ Instituted ■ Joiners ■ Denials

**PGR - Number of Decisions On Institution Per Fiscal Year by Outcome**



■ Instituted ■ Joiners ■ Denials

**Narrative:**

These three sets of bar graphs show the number of decisions on institution by fiscal year broken out by trials instituted (including joinders) and trials denied in IPR, CBM, and PGR proceedings. A trial that is instituted in part is counted as an institution in these bar graphs.

**\*Data current as of: 7/31/2015**



# Disposition of IPR Petitions Completed to Date\*



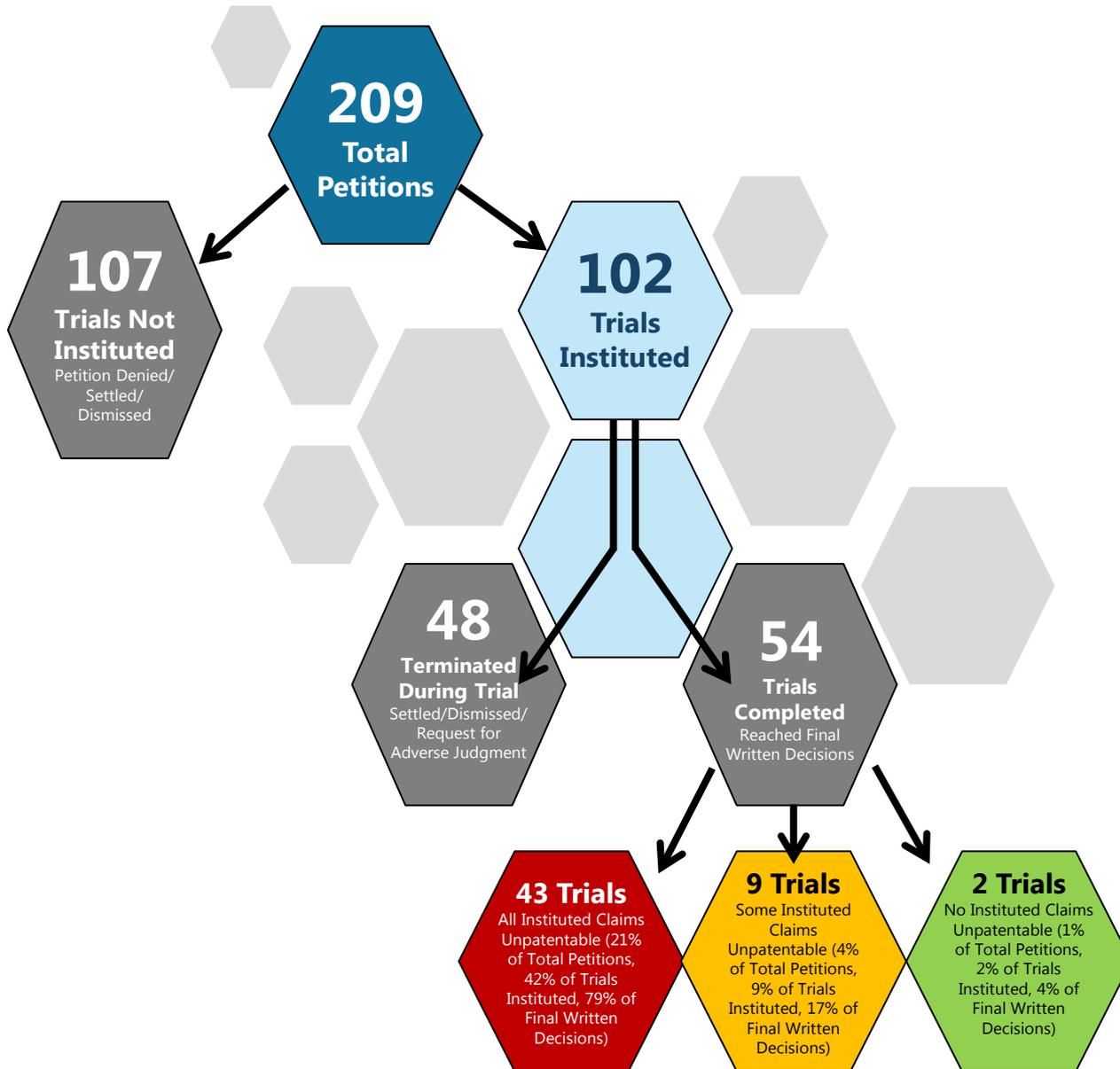
## Narrative:

This graph shows a stepping stone visual depicting the outcomes for all IPR petitions filed to-date that have reached a final disposition.

\*Data current as of: 7/31/2015



# Disposition of CBM Petitions Completed to Date\*



## Narrative:

This graph shows a stepping stone visual depicting the outcomes for all CBM petitions filed to-date that have reached a final disposition.

\*Data current as of: 7/31/2015



# Disposition of PGR Petitions Completed to Date\*



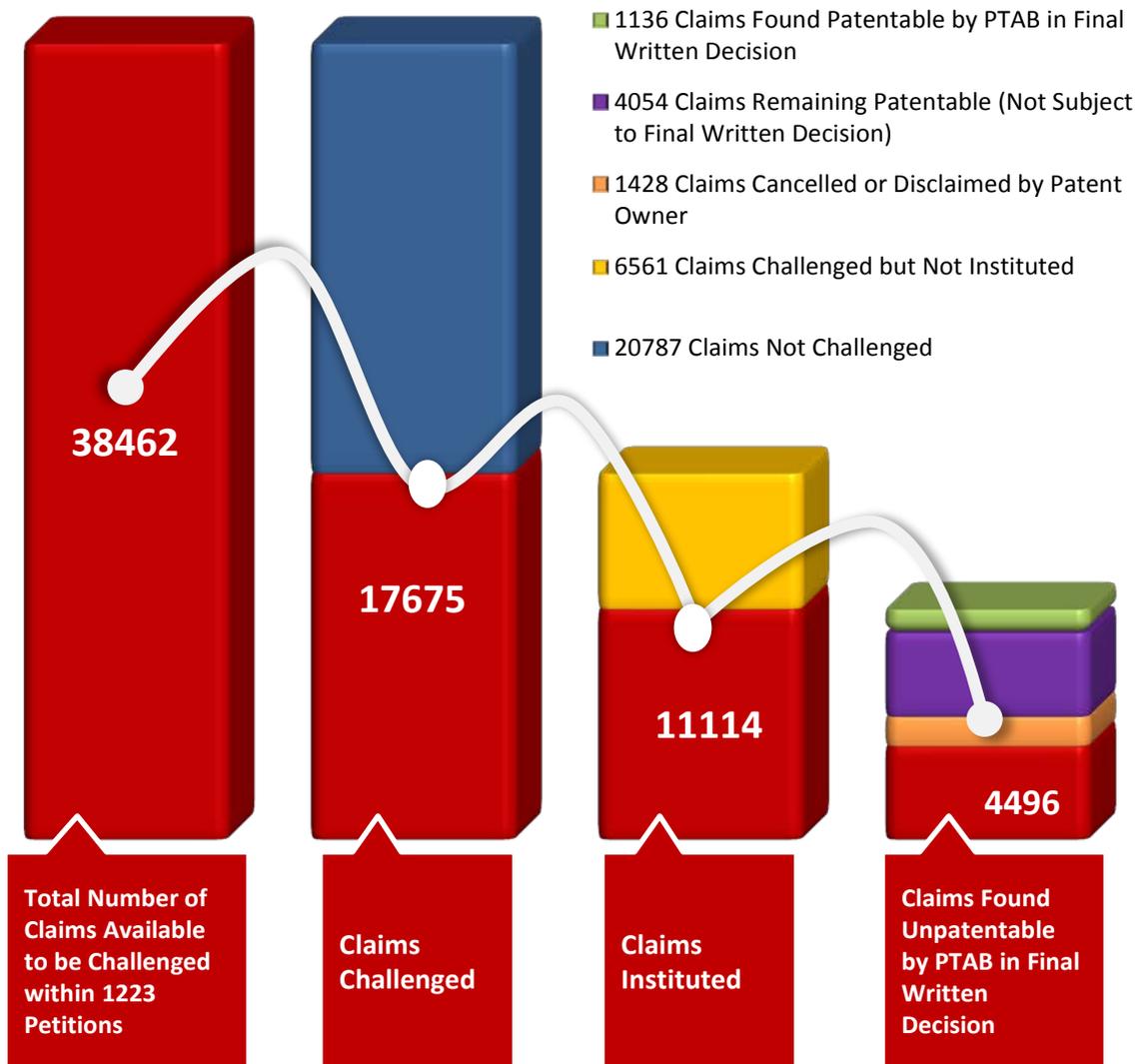
## Narrative:

This graph shows a stepping stone visual depicting the outcomes for all PGR petitions filed to-date that have reached a final disposition.

\*Data current as of: 7/31/2015



## IPR Petitions Terminated to Date\*



### Narrative:

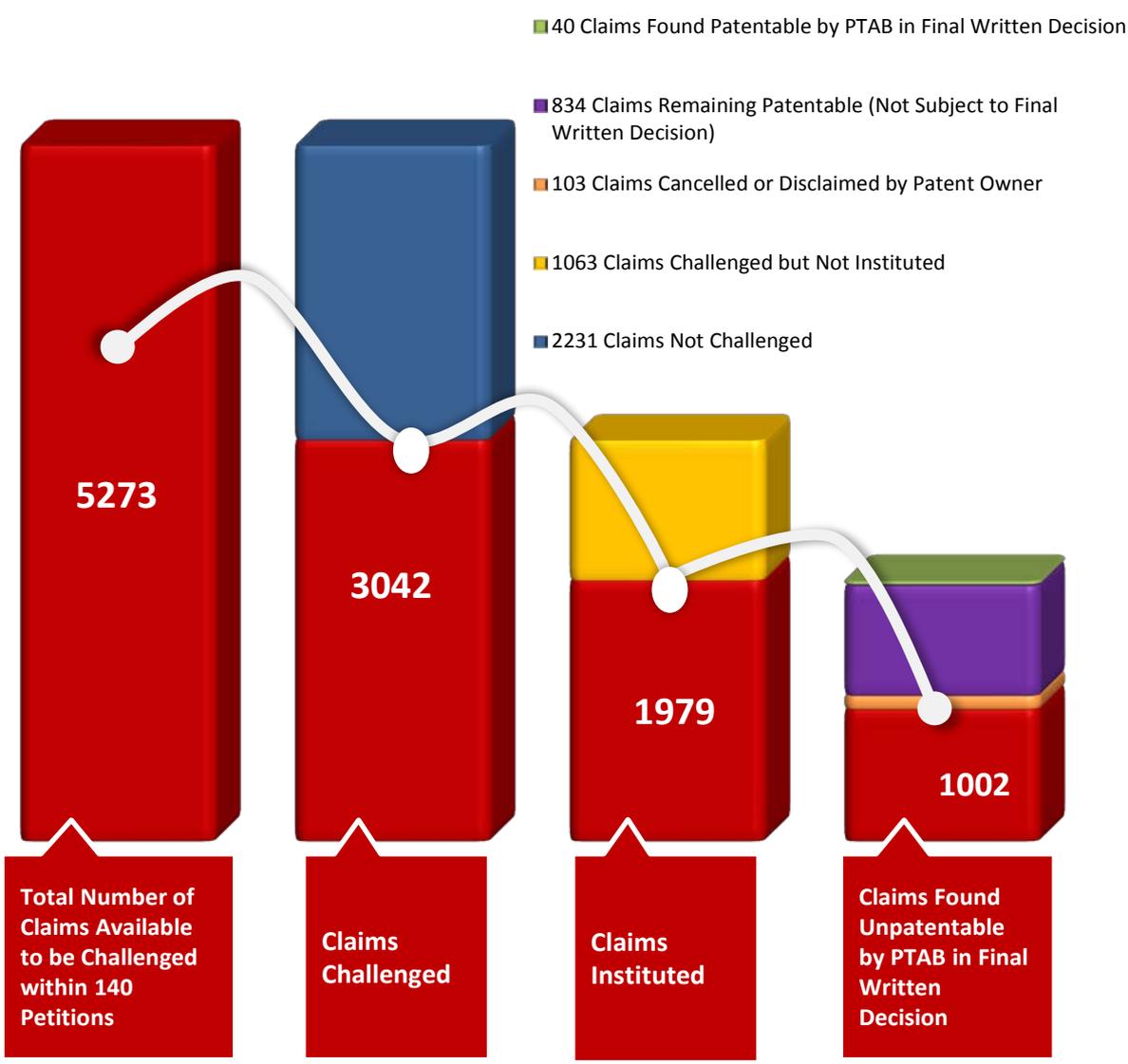
This visual contains four bars. The first bar shows the total number of claims available to be challenged in the IPR petitions filed. The second bar shows the number of claims actually challenged and not challenged. The third bar shows the number of claims on which trial was instituted and not instituted. The fourth bar shows the total number claims found unpatentable in a final written decision, the number of claims canceled or disclaimed by patent owner, the number of claims remaining patentable (not subject to a final written decision), and the number of claims found patentable by the PTAB.

**Note:** Petitions terminated does not included petitions denied.

**\*Data current as of: 7/31/2015**



# CBM Petitions Terminated to Date\*



## Narrative:

This visual contains four bars. The first bar shows the total number of claims available to be challenged in the CBM petitions filed. The second bar shows the number of claims actually challenged and not challenged. The third bar shows the number of claims on which trial was instituted and not instituted. The fourth bar shows the total number claims found unpatentable in a final written decision, the number of claims canceled or disclaimed by patent owner, the number of claims remaining patentable (not subject to a final written decision), and the number of claims found patentable by the PTAB.

**Note:** Petitions terminated does not included petitions denied.

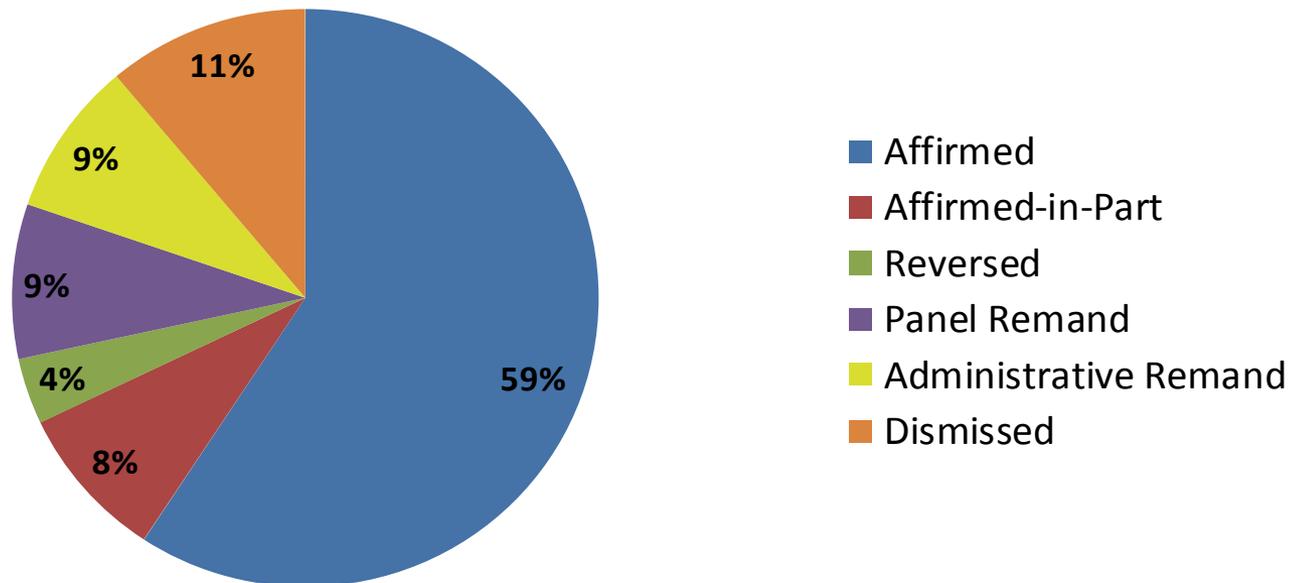
**\*Data current as of: 7/31/2015**



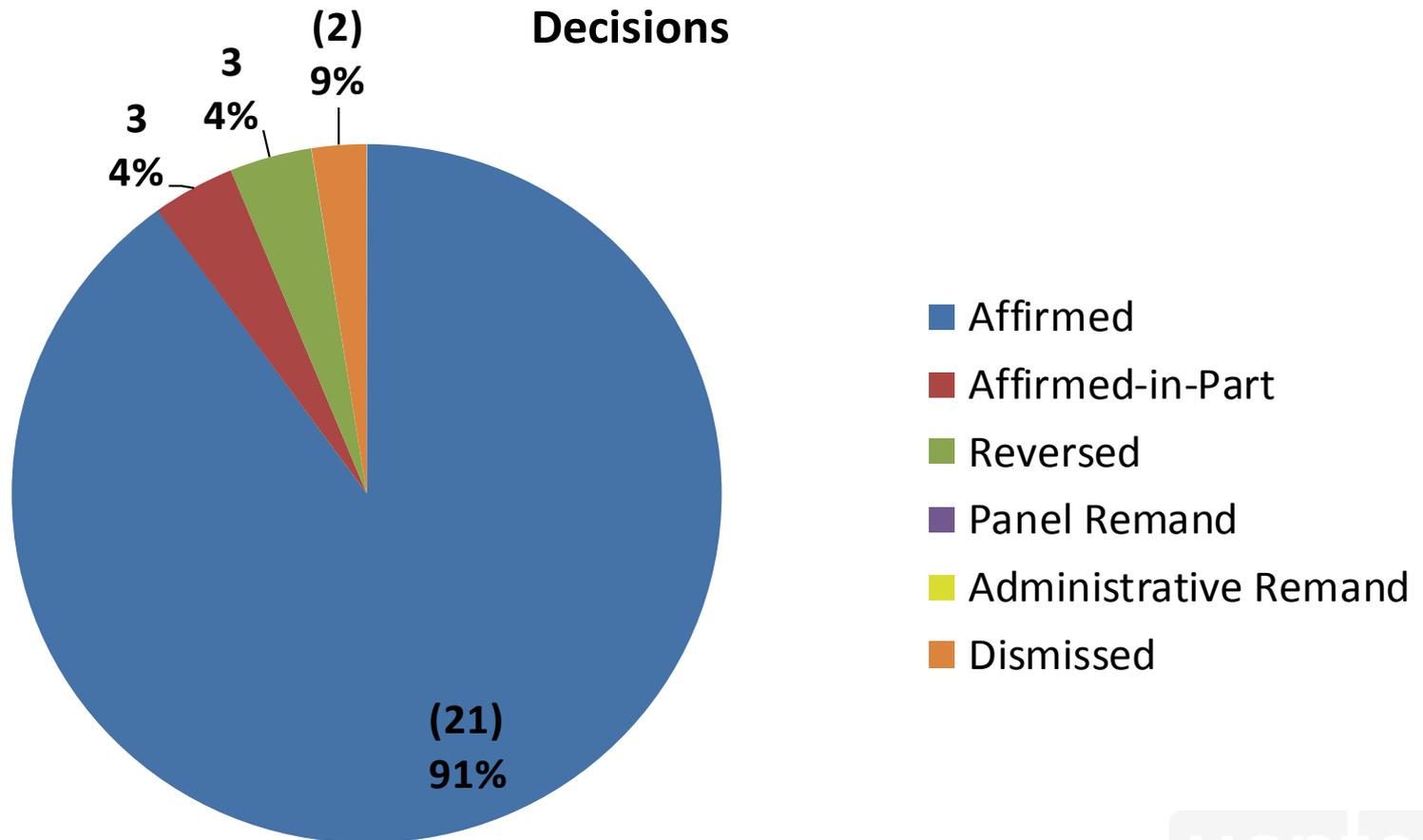
# CAFC Outcome Statistics

# CAFC Decisions – Appeals FY2014

Decisions



# CAFC Decisions – Trials as of 06/30/2015



# Proposed AIA Trial Rule Changes

Susan Mitchell, Lead Judge

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# AIA Trial Rulemaking

- In response to stakeholder requests, the Office moved forward with two rule packages:
  1. A first final rule package that encompassed less difficult “quick-fixes” based upon both stakeholder comments and internal PTAB suggestions, including more pages for briefing for motions to amend and for petitioner’s reply brief; and
  2. A second proposed rule package that published today.
- The second proposed rule package addresses the remaining issues raised in comments received from the public, as well as providing more guidance concerning our growing experience with AIA proceedings.
- The public has sixty days to provide the Office with comments on the proposed rules. The Office will issue a final rule, responding to these comments, and also issue a revised Office Patent Trial Practice Guide reflecting guidance concerning our current practice in handling AIA proceedings.

# Proposed Rule Changes

- Proposes to allow patent owners to include, with their opposition to a petition to institute a proceeding, new testimonial evidence such as expert declaration, responding to commentary raising concerns that patent owners are disadvantaged by current rules letting petitioners' evidence go unanswered before a trial is instituted
- Proposes a new requirement on practitioners before the PTAB, akin to the Rule 11 requirements in federal courts, that would give the USPTO a more robust means with which to police misconduct
- Proposes to clarify that the PTAB will use the claim construction standard used by district courts for patents that will expire during proceedings and therefore cannot be amended, while confirming the use of broadest reasonable interpretation (BRI) for all other cases
- Notes the PTAB's development of motions-to-amend practice through its own body of decisions, including a recent decision that clarified what prior art a patent owner must address to meet its burden of proof
- Proposes using a word count for major briefing so that parties are free to present arguments and evidence to the Office in a way that a party deems is most effective, including presenting arguments in claim charts

# Motions-to-Amend

- *MasterImage 3D, Inc. v. RealD Inc.*, Case IPR2015-00040 (PTAB July 15, 2015) (Paper 42) (representative)
  - Clarified earlier *Idle Free* decision
  - Patent Owner must show patentable distinction over prior art of record (in the proceeding; in the prosecution history; in any other proceeding involving the same patent)
  - Duty of candor and good faith in the Office may lead to additional prior art made of record by the Patent Owner when moving to amend

# Possible Pilot Program for Institution Decisions

- The Office is considering a pilot program to explore approaches to increase the efficiency of the process for handling the administration of the AIA post grant proceedings, specifically, a potential alternative to the current three-judge institution model.
- The Office is seeking input on whether to conduct a pilot program under which a single APJ would decide whether to institute an IPR trial, with two additional APJs being assigned to conduct the IPR trial, if instituted.

# The Bar's Response to the Proposed AIA Trial Rule Changes

Erika Arner, Finnegan Henderson  
Brad Pedersen, Patterson Thunte  
Susan Mitchell, Lead Judge  
Peter Chen, Lead Judge (Santa Clara)  
Miriam Quinn, Lead Judge (Dallas)  
Linda Horner, Lead Judge (Alexandria)  
Scott Boalick, Acting Deputy Chief Judge

# Response to Proposed Rules

- Perspectives from Patent Owners & Petitioners on Proposed Rules
- Perspectives from the Bench on Proposed Rules

# Hot Issues in PTAB Trials

Tina Hulse, Judge (Santa Clara)

Matt Clements, Lead Judge (Santa Clara)

Stacey White, Judge (Dallas)

Georgiana Braden, Judge (Dallas)

Mike Tierney, Lead Judge (Alexandria)

Sally Medley, Judge (Alexandria)

David McCombs, Hayes and Boone

Dorothy Whelan, Fish & Richardson (Santa Clara and Alexandria)

William Noon, Illumina (Dallas)

Todd Baker, Oblon (Alexandria)

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# Hot Issues

- Handling Multiple Proceedings
- Estoppel Issues and Considerations
- Federal Circuit Developments
- Remands: What's Next?

# AIA Trial

Ariosa Diagnostics Inc. v. Illumina Inc. (IPR 2014-01093) (Santa Clara)  
Judges: Lora Green, Tina Hulse, Zhenyu Yang

Amazon.com Inc. v. Cellular Communications Equipment LLC  
(IPR 2014-01134) (Dallas) Judges: Jennifer Bisk, Gregg Anderson,  
Robert Weinschenk

JP Morgan Chase & Co. v. Intellectual Ventures LLC (CBM 2014-00157)  
(Alexandria) Judges: Kristen Droesch, Barbara Parvis, Matt Clements

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# Closing Remarks

Sharon Israel, Mayer Brown, AIPLA President  
Janet Gongola, Senior Advisor

# Thank You

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