



Patent Trial and Appeal Board Motion to Amend Study

Update through September 30, 2017

UNITED STATES
PATENT AND TRADEMARK OFFICE



Motion to Amend Study: Installment 3 (Update Through End of FY 2017)

In April 2016, after having completed more than 1,500 trials in more than three-and-one-half years of America Invents Act (“AIA”) trials,¹ the Board undertook a study of motions to amend to determine: (1) the number of motions to amend that had been filed in AIA trials, both as a cumulative total and by fiscal year; (2) subsequent developments of each motion to amend; (3) the number of motions to amend requesting to substitute claims that were granted, granted-in-part and denied-in-part, and denied; and (4) the reasons the Board provided for denying entry of substitute claims. The Motion to Amend Study and data supporting the study are available on the Board’s website. See Motion to Amend Study (April 30, 2016), <https://go.usa.gov/xXXyT>; Data for Completed Trials with a Motion to Amend, <https://go.usa.gov/xXXyZ> (last visited Mar. 28, 2017).

The Board has continued to collect data on motions to amend, and in June 2017, updated the Motion to Amend Study through May 31, 2017. The second installment of the Motion to Amend Study analyzed the same information as the original study, and also is available on the Board’s website. See Motion to Amend Study (update through May 31, 2017), <https://go.usa.gov/xndDZ> (last visited Jan. 11, 2017); Data for 254 Completed Trials (MTA study), <https://go.usa.gov/xndDk> (last visited Jan. 11, 2017).

¹ Trials are counted as “completed” when they are terminated due to settlement, request for adverse judgment, dismissal, or final written decision. Further, as explained in the Motion to Amend Study, joined or consolidated trials were counted as a single trial for purposes of the motion to amend statistics.

Now, in light of the availability of five years' worth of data, the Board provides another update to the Motion to Amend Study through September 30, 2017 (the end of FY 2017), in the graphs and table below.

Graph I is a pie chart that shows the cumulative number of motions to amend that have been filed in AIA trials, both completed and pending, through September 30, 2017. Patent owners have filed a motion to amend in 275 of the 2,766 completed trials (10%), and in 38 of the 725 pending trials (5%)—a total of 313 motions to amend.

Graph II is a pie chart that depicts the subsequent developments of the motions to amend, focusing on the outcomes of the 275 completed trials in which a patent owner filed a motion to amend. The Board decided a motion to amend requesting to substitute claims in 170 of the 275 completed trials (62%). In the remaining 105 completed trials (38%), the motion to amend: (a) requested solely to cancel claims (19 or 7%), (b) was rendered moot because the panel of judges found the original claims patentable (27 or 10%), or (c) was not decided because the case terminated prior to a final written decision (59 or 21%).

Graph III is a pie chart that depicts the outcomes of the 170 motions to amend requesting to substitute claims that the Board decided, i.e., the number of motions to amend requesting to substitute claims that the Board granted, granted-in-part and denied-in-part, or denied. The Board granted or granted-in-part and denied-in-part a motion to amend in 14 of the 170 trials (8%) and denied a motion to amend in 156 of the 170 trials (92%).

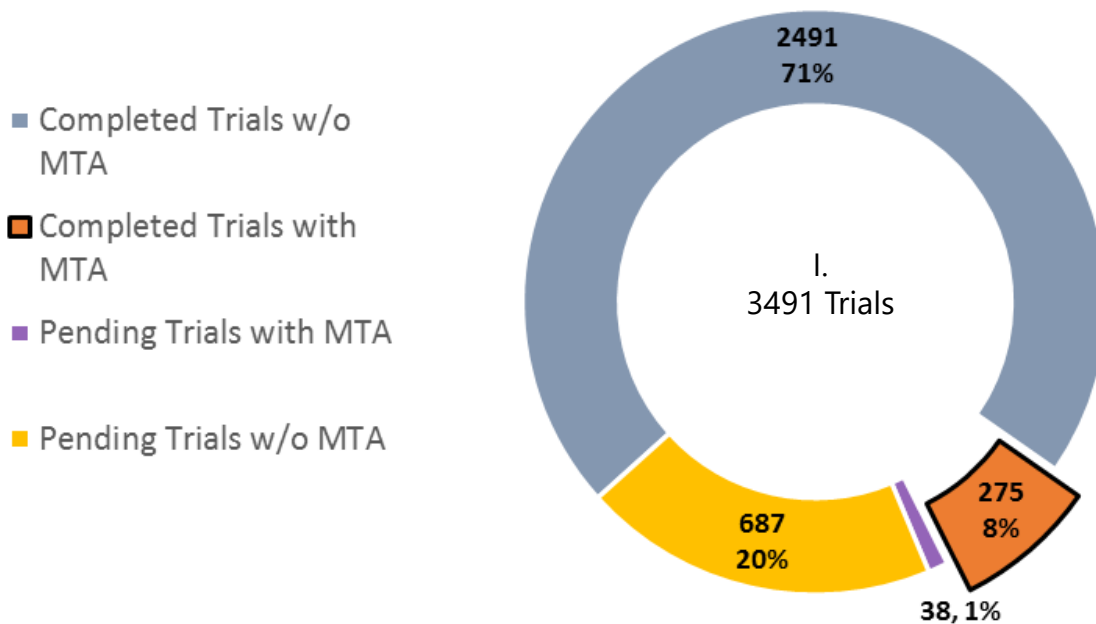
Table I follows Graph III and focuses on the reasons provided for denying entry of substitute claims in the 166 trials in which the Board denied or denied-in-part a motion to amend. The Board's final written decisions provided at least one statutory reason for denying or denying-in-part a motion to amend in 144 of the 166 trials (87%). Using conventional prosecution as a comparison, the Board's decisions in those cases are akin to an examiner rejecting a proposed amended claim because it is anticipated, obvious, not adequately described in the written description, indefinite, or directed to non-statutory subject matter. In the remaining 22 (13%) trials, the Board based a denial solely on procedural reasons related to the requirements for a motion to amend.²

Graph IV follows Table I and shows the total number of motions to amend filed in a given fiscal year.

² Those 22 trials are the same 22 trials identified as procedural denials in the April 2016 Motion to Amend Study.

Graph I: Number of Motion to Amend Filings

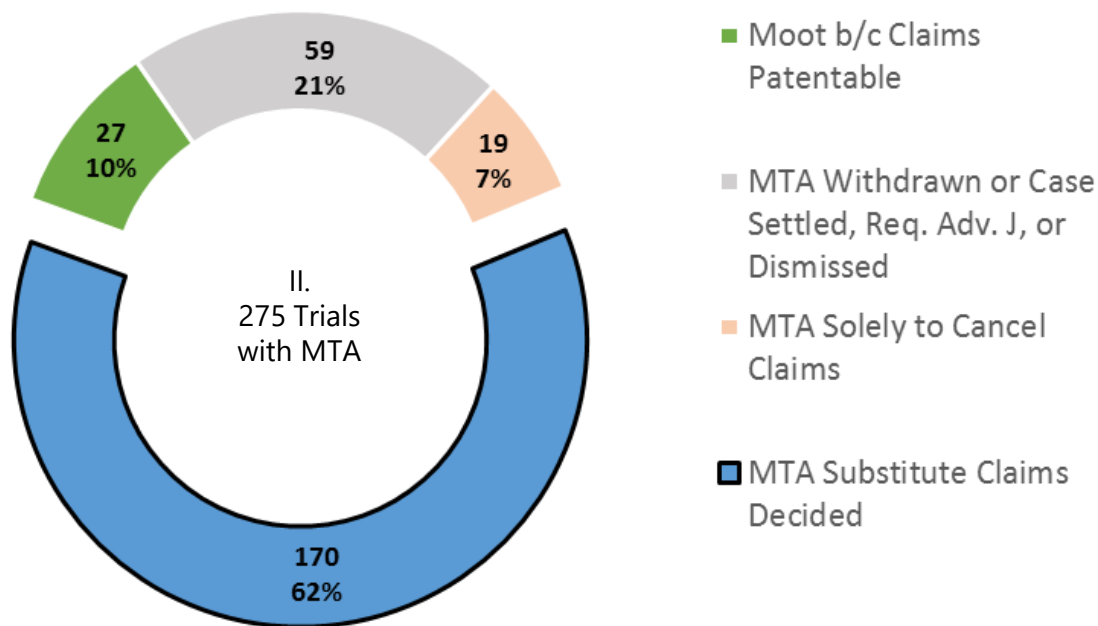
How Many Motions to Amend Are Filed?



Data current as of: 9/30/2017

Graph II: Subsequent Developments of Motions to Amend

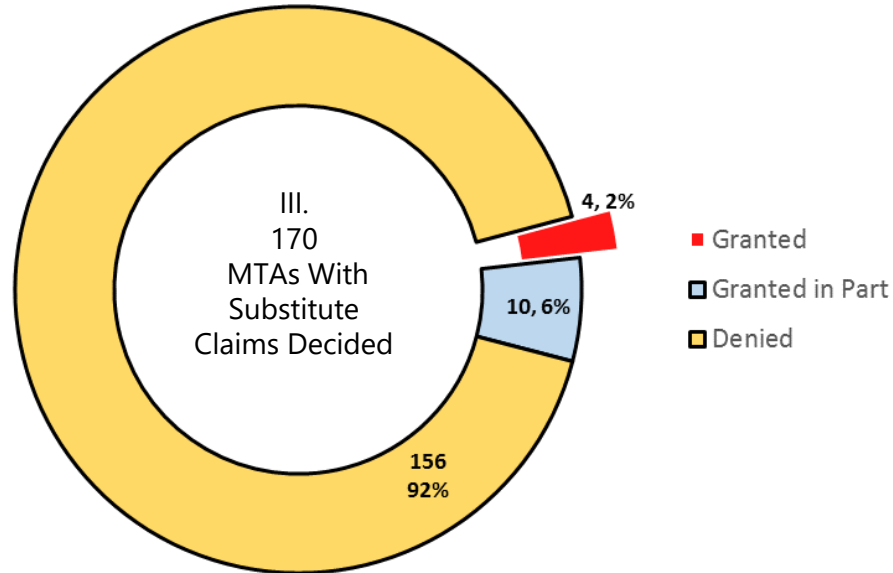
Subsequent Developments of the Motions to Amend



Data current as of: 9/30/2017

Graph III: Disposition of Motions to Amend

How Many Motions to Amend Substituting Claims Are Granted?



Data current as of: 9/30/2017

Table I: Reason for Denial of Motions to Amend

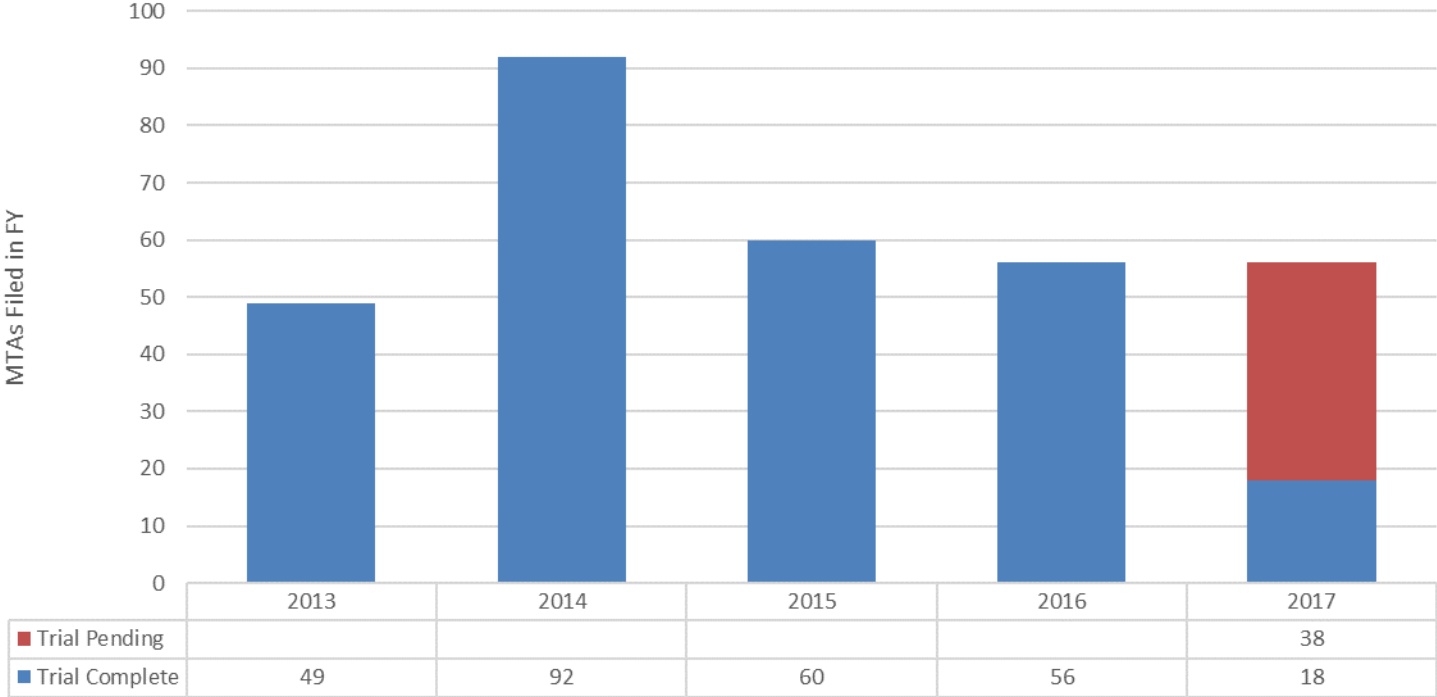
| | Reason for Denying Entry | # of Motions | % of Motions |
|----------------------|---|--------------|--------------|
| §102/103 | Anticipated or Obvious Over Art of Record | 67 | 40% |
| §102/103/ 112/316 | Multiple Statutory Reasons *All included at least 102, 103, and/or 112 as a reason for denial | 39 | 23% |
| §101 | Non-Statutory Subject Matter | 12 | 7% |
| §112 | Written Description | 10 | 6% |
| §112 | Enablement | 3 | 2% |
| §112 | Definiteness | 1 | 1% |
| §316 | Claims Enlarge Scope of Patent | 9 | 5% |
| §316 | Unreasonable Number of Substitute Claims | 3 | 2% |
| | Procedural Reasons | 22 | 13% |
| | Total Motions to Amend Denied (in whole or in part) | 166 | 100% |

Data current as of: 9/30/2017



Graph IV: Motion to Amend Filings Per Fiscal Year

How Many Motions to Amend Were Filed in Each Fiscal Year?



Data current as of: 9/30/2017



