

Patent Trial and Appeal Board Motion to Amend Study

Installment 4: Update through March 31, 2018

UNITED STATES
PATENT AND TRADEMARK OFFICE



Motion to Amend Study: Installment 4 (Update Through March 31, 2018)

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, Installment 1), <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 has posted on its website second and third installments of the Motion to Amend Study that analyze the same information as the original study. See Motion to Amend Study (update through September 30, 2017, Installment 2), <https://go.usa.gov/xQMew> (last visited June 13, 2018); Data for 275 Completed Trials with MTAs, <https://go.usa.gov/xQMeM> (last visited June 13, 2018); Motion to Amend Study (update through May 31, 2017, Installment 3), <https://go.usa.gov/xndDZ> (last visited June 13, 2018); Data for 254 Completed Trials with MTAs, <https://go.usa.gov/xndDk> (last visited June 13, 2018).

¹ Trials, i.e., instituted AIA proceedings, are counted as “completed” when they are terminated due to settlement, request for adverse judgment, dismissal, or final written decision. Further, 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 more than five years' worth of data, the Board provides another update to the Motion to Amend Study through March 31, 2018 (midyear of FY 2018), in the graphs below (Installment 4). The information that the Board analyzed remains the same, but the Board has created several new visual depictions to show more clearly some of the data and information regarding motions to amend.

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 March 31, 2018. Patent owners have filed a motion to amend in 305 of the 3,203 completed trials (11%), and in 56 of the 725 pending trials (8%)—a total of 361 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 305 completed trials in which a patent owner filed a motion to amend. The Board decided a motion to amend requesting to substitute claims in 189 of the 305 completed trials (62%). In the remaining 116 completed trials (38%), the motion to amend: (a) requested solely to cancel claims (20 or 7%), (b) was rendered moot because the panel of judges found the original claims patentable or because the panel of judges already decided a motion to amend proposing the same substitute claims (35 or 11%), or (c) was not decided because the case terminated prior to a final written decision (61 or 20%).

Graph III is a pie chart that depicts the outcomes of the 189 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 18 of the 189 trials (10%) and denied a motion to amend in 171 of the 189 trials (90%).

Graph IV, which is a new graph, focuses on the reasons provided for denying entry of substitute claims in the 182 trials in which the Board denied (171) or denied-in-part (11) a motion to amend. The Board's final written decisions identified at least one statutory ground of unpatentability or found that the patent owner failed to satisfy the statutory requirements for a motion to amend under 35 U.S.C. § 316(d) in 88% of trials or 160 trials. The Board's decisions in most of 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 (12%) trials, the Board based a denial solely on procedural reasons related to the requirements for a motion to amend. Those 22 trials are the same 22 trials that the Board identified as procedural denials in the Motion to Amend Study released in April 2016 (Installment 1).

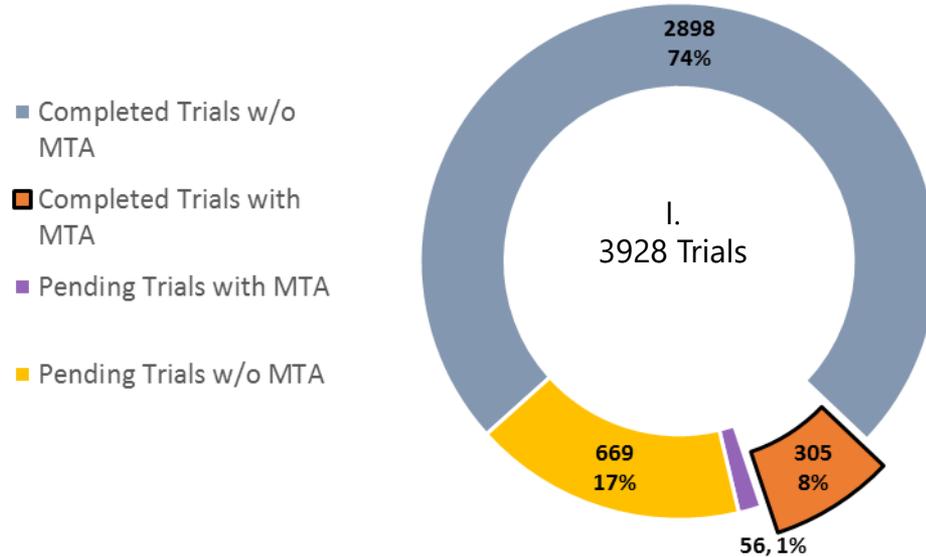
Graph V shows the total number of motions to amend filed by fiscal year. Graph V shows an increase in the number of motions to amend filed in fiscal year 2018, when compared to other fiscal years. The number of motions to amend filed through the first half of fiscal year 2018 (54) exceeds the number of motions to amend filed for the entire fiscal year 2017 (50), and is approximately the same as the number of motions to amend filed for the entire fiscal year 2016 (56).

Graph VI shows the number of motions to amend filed by fiscal quarter. Graph VI shows that the number of motions to amend filed in the first two quarters of fiscal year 2018 exceeds the number of motions to amend filed in any other two consecutive quarters.

Graph I: Number of Motion to Amend Filings

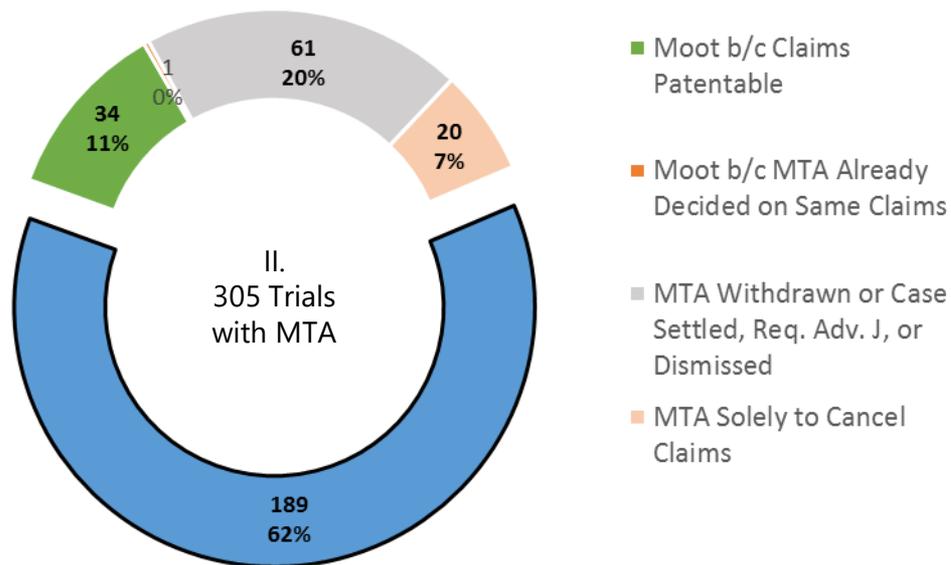
(FY13 to FY18: 10/1/2012-3/31/2018)

How Many Motions to Amend Are Filed?



Graph II: Subsequent Developments of Motions to Amend (FY13 to FY18: 10/1/2012-3/31/2018)

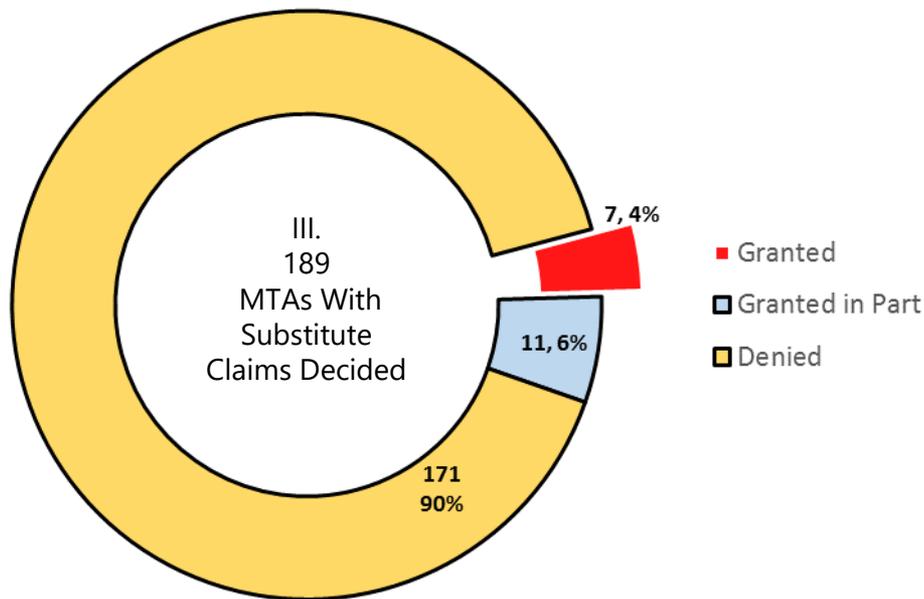
Subsequent Developments of the Motions to Amend



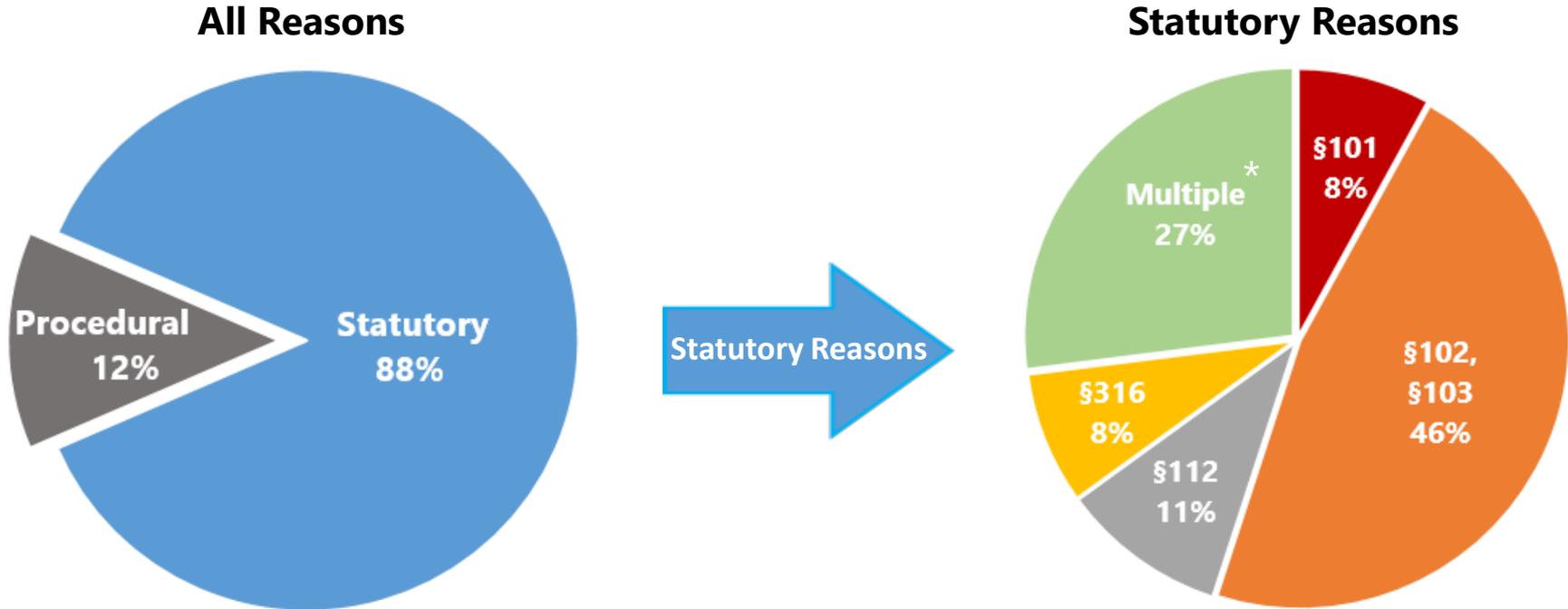
Graph III: Disposition of Motions to Amend

(FY13 to FY18: 10/1/2012-3/31/2018)

How Many Motions to Amend Substituting Claims
Are Granted?



Graph IV: Reasons for Denying Entry of Substitute Claims (FY13 to FY18: 10/1/2012-3/31/2018)

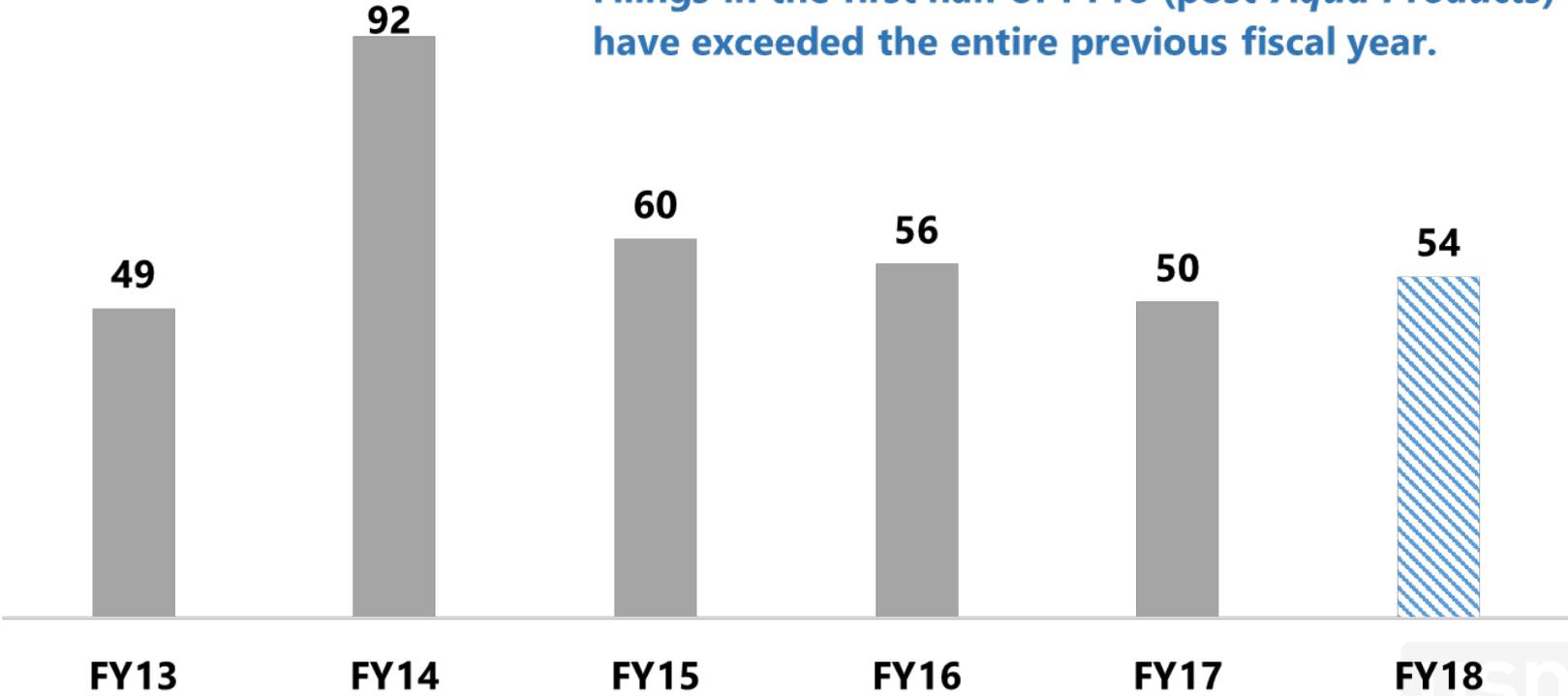


* All but one of the cases in which multiple statutory reasons were provided for denying entry of substitute claims included §§ 102, 103 and/or 112 as a reason for denial.

Graph V: Motions to Amend Filed by Fiscal Year

(FY13 to FY18: 10/1/12 to 3/31/18)

Filings in the first half of FY18 (post-Aqua Products) have exceeded the entire previous fiscal year.



Graph VI: Motions to Amend Filed by Fiscal Quarter (FY13 to FY18: 10/1/12 to 3/31/18)

Filings in the first half of 2018 (post-Aqua Products) exceeded any other two consecutive quarters.

