Patent Trial and Appeal Board
Boardside Chat:
The one-year *ex parte* appeal, Fast-Track Appeals Pilot Program, and What happens after PTAB decides an appeal.

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Agenda

• The one-year *ex parte* appeal
• Fast-Track Appeals Pilot Program
• What happens after PTAB decides an appeal
Question/comment submission

• To send in questions or comments during the webinar, please email:
  – PTABBoardsideChat@uspto.gov
The one-year *ex parte* appeal

How to get from final action to PTAB decision in one year (or less)
Ex parte appeals pendency goal

• Today’s discussion: review the timing of *ex parte* appeals and discuss how an appellant can obtain a quicker decision when desired

• Allow stakeholders to make informed decision on whether to appeal to PTAB, regardless of technology

• 12-month average pendency for decided appeals, regardless of technology
  
  – Pendency is measured from the date jurisdiction passes to PTAB (i.e., approximately when PTAB receives all briefing, the appeal forwarding fee is paid, and an appeal number is assigned) to the date PTAB issues a decision
  
  – Pendency does not include the time it takes from Final Action to jurisdiction passing to the PTAB
Final Action–to–PTAB decision in one year

Appellants can increase the likelihood of receiving a PTAB decision on an appeal within one year of final rejection by:

1. Promptly filing during the briefing stage
   – notice of appeal, appeal brief, and reply brief
   – Appellants can do its part to reduce the briefing stage to 6 months or less

2. Using the PTAB Fast-Track Appeals Pilot Program
   – provides a decision within 6 months of Fast-Track decision grant
   – current non-Fast-Track appeal decision median time is around 12 months

Thus resulting in a total Final Action-to-PTAB Decision time of:

– with PTAB Fast-Track Appeals Pilot Program: < 12 months
– without PTAB Fast-Track Appeals Pilot Program: < 18 months
The course of an *ex parte* appeal

<table>
<thead>
<tr>
<th>Document</th>
<th>Who files/issues</th>
<th>PTAB jurisdiction</th>
</tr>
</thead>
<tbody>
<tr>
<td>Final Rejection</td>
<td>Examiner</td>
<td>No</td>
</tr>
<tr>
<td>Notice of Appeal</td>
<td>Appellant</td>
<td>No</td>
</tr>
<tr>
<td>Appeal Brief</td>
<td>Appellant</td>
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</tr>
<tr>
<td>Examiner’s Answer</td>
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</tr>
<tr>
<td>Reply Brief</td>
<td>Appellant</td>
<td>No</td>
</tr>
<tr>
<td>Decision</td>
<td>PTAB</td>
<td>Yes</td>
</tr>
</tbody>
</table>

- Jurisdiction transfers to PTAB approximately when filing of a (optional) reply brief (or expiration of the time to file a reply brief) and the appeal forwarding fee is paid.
- Other optional actions (e.g., Pre-Appeal Conference Pilot Program) may occur between some filings, before jurisdiction transfers to PTAB.
**Appellant controls the briefing duration**

<table>
<thead>
<tr>
<th>Document</th>
<th>Who files/issues</th>
<th>Maximum (months)</th>
<th>Typical (months)</th>
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<tr>
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<td>Appeal Brief</td>
<td>Appellant</td>
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<td>Reply Brief</td>
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<tr>
<td>Decision</td>
<td>PTAB</td>
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* About 95% of Examiner’s Answers issue within 4 months after an Appeal Brief filing, with ~2.5 months being the average overall. Neither guarantees the timing of any particular Examiner’s Answer.

**Total briefing (months):**

- Maximum: ~19
- Typical: ~11.5
## Total time to decision

<table>
<thead>
<tr>
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**PTAB Jurisdiction:**
- Slowest PTAB appeals (<5%): ~24 months
- Typical PTAB appeal: ~12 months

**Total time-to-decision (months):**
- ~43
- ~23.5
# The one-year appeal

<table>
<thead>
<tr>
<th>Document</th>
<th>Typical (months)</th>
<th>Diligent Appellant (months)</th>
<th>Diligent + PTAB Fast-Track</th>
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<td>1</td>
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<td>1</td>
</tr>
<tr>
<td>Reply Brief</td>
<td>~12</td>
<td>~12</td>
<td>&lt;6</td>
</tr>
<tr>
<td>Decision</td>
<td>~12</td>
<td>~12</td>
<td>&lt;6</td>
</tr>
</tbody>
</table>

**Final-to-Decision (months):**
- Typical: ~23
- Diligent Appellant: ~18
- Diligent + PTAB Fast-Track: <12

Where an Appellant would like to conclude an appeal quickly, the time frames for the briefing stage show how such appeals may proceed. It is not appropriate for all appeals.
Planning for *ex parte* appeals

• Diligent Appellant using PTAB Fast-Track Appeals Pilot Program: <12 months Final Action-to-PTAB Decision
  – Typical time for Final Action-to-PTAB Decision: 23 months

• Appellants largely control duration of briefing stage
  – Typical time is 11 months, which Appellants can do its part to shorten

• The average duration of an appeal after PTAB docketing is approaching 12 months.
  – PTAB Fast-Track Pilot Program goal: issue decision within 6 months
Question/comment submission

• To send in questions or comments during the webinar, please email:
  – PTABBoardsideChat@uspto.gov
LEAP

• Designed to:
  – Aid in development of the next generation of patent practitioners
  – Encourage a diverse group of advocates to develop their skills before the Board

• To qualify, a patent agent or attorney must have:
  – Three or fewer substantive oral arguments in any federal tribunal, including PTAB, and
  – Seven or fewer years of experience as a licensed attorney or agent
Fast-Track Appeals Pilot Program

Get your ex parte appeal decided in six months or less
Let’s chat

- One-year pilot program to expedite ex parte appeals before the PTAB
- Preliminary results show early success
- Goals: explain the Pilot Program and share our data
- To send in questions or comments during the webinar, please email:
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What is the Fast-Track Appeals Pilot Program?
The basics

- One-year pilot program before the PTAB
- An appellant can request an ex parte appeal to be expedited out of turn by filing:
  - A petition
  - A fee ($420)
- Pendency goal: PTAB decision within six months
Does my appeal qualify?

• Application type
  – Original utility, design, or plant nonprovisional application

• Status of appeal
  – Pending ex parte appeal (Notice of Appeal filed and Docketing Notice issued)
  – Not limited to “new” appeals (a petition may be submitted for any currently pending appeal)
Are there any restrictions?

- The number of granted petitions is limited to 125 per quarter (500 total)
- Hearings permitted, with some caveats
- Not available for applications already treated as special during appeal under MPEP §708.01
  - See MPEP §708.01 (e.g., appeals treated special due to age or health of inventor)
Petition requirements

• Petition under 37 C.F.R. § 41.3
  – Form PTO/SB/451 recommended, but not required
  – Identify the application number and appeal number
  – Certify that the ex parte appeal qualifies

• Petition fee under 37 C.F.R. § 41.20(a)
  – $420 (non-refundable)
Fast-track website

www.uspto.gov/patents/ptab/fast-track-appeals-pilot-program
Form-fillable pdf also available at: www.uspto.gov/patents/apply/forms/forms-patent-applications-filed-or-after-september-16-2012
Filing the petition

• Submit by EFS-Web, Patent Center, or Postal Service
  – Electronic submission is preferred
• Petitioner notified of grant or denial
  – Denials have been due to lack of PTAB jurisdiction
• May petition again if denied, but will not get the filing date of a denied petition
Granted petition limits

• 125 granted petitions per quarter and 500 total in the one-year pilot
  – Quarter 1—July 2020 through September 2020
  – Quarter 2—October 2020 through December 2020

• PTAB may exercise discretion to grant a small number of additional petitions per quarter
  – Additional petitions may be held in abeyance and considered in the following quarter in order of receipt
Check our website for petition limit updates

- The pilot program website is regularly updated with current information on quarterly limits.
Hearings

• Appellant with a fast-tracked ex parte appeal may request oral argument before a PTAB panel
  – PTAB will make best efforts to accommodate time/location preferences
  – But, hearing may be scheduled in any available hearing room in any office location or by telephone

• Appellant cannot reschedule hearings and remain in the Pilot Program
  – May opt out of the Pilot Program and reschedule hearing
  – May request video/telephone if office location is inconvenient
  – May waive hearing and continue on fast-track

• Currently, all hearings for ex parte appeals are telephonic by default.
  – www.uspto.gov/coronavirus
How are we doing?
Petitions received per quarter

- **Quarter 1**
  - July 2020 through September 2020
- **Quarter 2**
  - October 2020 through December 2020
- **Quarter 3**
  - January 2021 through March 2021 (as of January 22, 2021)

<table>
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<tr>
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<th>Petitions Received in First Quarter</th>
<th>Granted Petitions</th>
<th>Granted Petitions (Heard appeals)</th>
<th>Denied Petitions</th>
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<thead>
<tr>
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<th>Petitions Received in Second Quarter</th>
<th>Granted Petitions</th>
<th>Granted Petitions (Heard appeals)</th>
<th>Denied Petitions</th>
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<thead>
<tr>
<th></th>
<th>Petitions Received in Third Quarter</th>
<th>Granted Petitions</th>
<th>Granted Petitions (Heard appeals)</th>
<th>Denied Petitions</th>
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<td>11</td>
<td>11</td>
<td>4</td>
<td>0</td>
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</table>
Petition decision statistics
(Program Q1 and Q2: July 2, 2020–December 31, 2020)

• Total petitions filed: 104
  – Average time to decide: 1.6 days

• Total petitions granted: 99
  – 5 petitions denied because the applications were not within PTAB jurisdiction

• Number of appeals decided: 69 (so far)
• Average time for decision on appeal: 1.9 months
How fast is fast-track?

• Must faster than usual
  – Target of six months
  – Faster than the approximately 13-month average time to decide appeals overall
Issued decision statistics

- At the end of the second quarter, 69 fast-tracked ex parte appeals have been decided
  - Out of 99 petitions for fast-track status granted
  - Included 19 oral hearings
  - 30 fast-tracked ex parte appeals are pending
Technology center statistics
(Program Q1 & Q2: July 2, 2020–December 31, 2020)

<table>
<thead>
<tr>
<th>TC</th>
<th># Petitions Filed</th>
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<tbody>
<tr>
<td>1600</td>
<td>17</td>
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<td>1700</td>
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<tr>
<td>2100</td>
<td>10</td>
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<td>2400</td>
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<td>2600</td>
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<td>2800</td>
<td>11</td>
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<tr>
<td>3600</td>
<td>22</td>
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<tr>
<td>3700</td>
<td>12</td>
</tr>
</tbody>
</table>

- TC 1600: Biotechnology and Organic Chemistry
- TC 2600: Communications
- TC 3600: Transportation, Construction, Electronic Commerce, Agriculture, National Security and License and Review
Take-away thoughts

• The pilot program is working as intended
  – PTAB is handling the pilot program well, with no negative impact on ex parte appeal pendency rates overall, while still providing decisions on ex parte appeals within six months, when requested though the pilot

• Evaluation of the pilot program
  – Will occur after the conclusion of the one-year period or when a 500-appeal threshold is met, whichever occurs first, to determine next steps
Give us feedback

• Contact information:
  – Phone 571-272-9797
  – Email: fasttrackappeals@uspto.gov
Further information

• Federal Register notice:

• Frequently asked questions:
Question/comment submission

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Patent Trial and Appeal Board (PTAB) performance benchmarks for dispositions, pendency, inventory, and other tracking measures.

Under Construction: PTAB is migrating to a new statistics format for AIA trials. We are moving all of our outcome statistics into a new quarterly "Outcome Roundup" format that includes outcome information on a by-petition, by-patent, and by-claim basis. We will continue publishing non-outcome trial statistics on a monthly basis. In addition, we now provide end of year outcome statistics for fiscal year 2019 for AIA trials below, and expect to provide the same for fiscal year 2020 soon.

**Trial statistics**

Current fiscal year (FY) statistics to date:

- **FY21 Q1 Outcome Roundup** (coming soon)
- **November 2020**
- **October 2020**

Prior fiscal year statistics:

- **FY20 End of Year Outcome Roundup**
  - Appendix
- **FY19 End of Year Outcome Roundup**
  - Appendix

**Appeal and interference statistics**

Current fiscal year (FY) statistics to date:

- **December 2020**
- **November 2020**
- **October 2020**
What happens after PTAB decides an appeal?
Methodology

- Started with ~9,224 applications that received a PTAB decision on appeal in FY 2019
- Identified the next substantive event in application’s file history
  - Excluded reexaminations and applications with only ministerial actions.
- For remaining ~9,190 applications, classified next substantive event (other than a request for rehearing) into one of four broad categories:
  - “Allowed”: Notice of Allowance issued
  - “Prosecution”: usually Applicant filed Request for Continued Examination with claim amendment
    - Does not include the filing of a continuation, divisional, or continuation-in-part application
  - “Abandoned”: usually Notice of Abandonment issued
  - “CAFC”: appealed to Court of Appeals for the Federal Circuit
Outcome Terminology—An Example to Explain

Example: Assume an application only has claims 1-4, and each is rejected by the Examiner as obvious under 35 U.S.C. § 103.

<table>
<thead>
<tr>
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<tbody>
<tr>
<td>Affirmed</td>
<td>1-4</td>
<td></td>
</tr>
<tr>
<td>Affirmed-in-Part</td>
<td>1-3 only</td>
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<tr>
<td>Reversed</td>
<td>None</td>
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<tr>
<td>Affirmed with new ground of rejection by PTAB</td>
<td>1-4, under a new theory</td>
<td></td>
</tr>
<tr>
<td>Reversed with new ground of rejection by PTAB</td>
<td>None</td>
<td>1-4</td>
</tr>
</tbody>
</table>

- **Affirmed**: 58.4%
- **Affirmed-in-part**: 8.7%
- **Affirmed with a new ground entered by PTAB**: 1.0%
- **Reversed**: 30.3%
  - **Reversed with a new ground of rejection entered by PTAB**: 1.0%

*Excludes reexaminations and applications with no meaningful post-appeal event*
What happens in the application after the rejection of the claims is affirmed?
(Oct. 1, 2018 – Sept. 30, 2019)

Affirmed without a new ground of rejection entered by PTAB

- Prosecution: 30.3%
- Allowed: 1.2%
- Abandoned: 67.9%
- CAFC: 0.7%
- 5,363 Apps.

Affirmed with a new ground of rejection entered by PTAB

- Prosecution: 53.3%
- Allowed: 1.1%
- Abandoned: 45.6%
- 90 Apps.
What happens in the application after the rejection of the claims is affirmed-in-part?
(Oct. 1, 2018 – Sept. 30, 2019)

**Affirmed-in-part without a new ground of rejection entered by PTAB**

- Prosecution: 46.5%
- Abandoned: 3.5%
- CAFC: 0.5%
- Allowed: 49.5%

**Affirmed-in-part with a new ground of rejection entered by PTAB**

- Prosecution: 57.1%
- Abandoned: 28.6%
- Allowed: 14.3%
- 63 Apps.
What happens in the application after the rejection of the claims is reversed?  
(Oct. 1, 2018 – Sept. 30, 2019)

- **Allowed**: 2,783 Apps. (94.7%)
  - Prosecution: 5.3%

- **Reversed without a new ground of rejection entered by PTAB**: 95 Apps. (8.4%)
- **Abandoned**: 95 Apps. (71.6%)

- **Reversed with a new ground of rejection entered by PTAB**: 95 Apps. (20%)
- **Allowed**: 20 Apps. (8.4%)
- **Prosecution**: 95 Apps. (71.6%)
What happens in the application when a new ground of rejection **is** or is not entered by PTAB?

(Oct. 1, 2018 – Sept. 30, 2019)

- **New ground of rejection not entered by PTAB**
  - Abandoned: 41.0%
  - Allowed: 34.6%
  - Prosecution: 24%
  - CAFC: 0.5%
  - 8,942 Apps.

- **New ground of rejection is entered by PTAB**
  - Prosecution: 61.3%
  - Abandoned: 31.5%
  - Allowed: 7.3%
  - 248 Apps.
Takeaways

- Typical outcomes:
  - Affirmed mostly led to abandonment, with most of the remainder of applications seeing further prosecution
  - Affirmed-in-part led to a nearly 50/50 between allowance and prosecution, with a small portion of applications being abandoned
  - Reversed led almost entirely to allowances, with a small portion of applications seeing further prosecution

- New grounds of rejection had a significant impact on post-appeal outcomes, for all types of PTAB decisions—generally, a much greater portion of applications saw further prosecution (over 50% for each type of decision)
Question/comment submission

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