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Chat with the Chief

Recent Developments at PTAB

David P. Ruschke
Chief Administrative Patent Judge

December 19, 2017

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Overview

- *Aqua Products* Guidance
- Motion to Amend Study: update 3
- SOP 9 on remands
- Expanded panels
- Stay informed



***Aqua Products* Guidance**

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Federal Circuit Decision

- Federal Circuit issued *en banc* opinion Oct. 4, 2017
- 5 opinions
- Lead opinion stated:
 - “(1) the PTO has not adopted a rule placing the burden of persuasion with respect to the patentability of amended claims on the patent owner that is entitled to deference;” and
 - “(2) in the absence of anything that might be entitled deference, the PTO may not place that burden [of persuasion] on the patentee”

PTAB's Guidance I

- Provide certainty and transparency on how the Board will handle motions to amend
- Board will not place the burden of persuasion on a patent owner with respect to the patentability of substitute claims presented in a motion to amend
- Board will determine whether the substitute claims are unpatentable based on the entirety of the record, including any opposition made by the petitioner

PTAB's Guidance II

- Technical aspects of motion to amend practice will not change
 - Current briefing practice as to the types, timing, and certain procedural requirements remains the same
 - Patent owner must continue to confer with the Board before filing a motion to amend

PTAB's Guidance III

- If a party in a particular case believes there is a need to discuss the impact of *Aqua Products*, party may contact the Board to arrange a conference call
- Party may request briefing changes or additional briefing
- Board generally will permit supplemental briefing if requested

Minerva Surgical v. Hologic Inc.

IPR 2016-00868, Papers 56 & 57 (Oct. 5, 2017)

- Extended 12-month statutory deadline to consider the impact of *Aqua Products en banc* decision, Papers 56 and 57
 - 12-month deadline to expire on October 6
 - *Aqua Products* issued on October 4
- Panel denied motion to amend, Paper 63
 - “preponderance of the evidence establishes that substitute claims 16–23 presented in the Motion to Amend are unpatentable over the prior art of record” as obvious

A faint, light gray technical drawing of a mechanical assembly, possibly a piston or engine component, serves as the background. It features various numbered callouts (e.g., 80, 86, 84, 82, 40, 36, 22, 26, 68, 24, 30, 86, 34, 32, 52, 50) and hatching lines indicating different materials or sections.

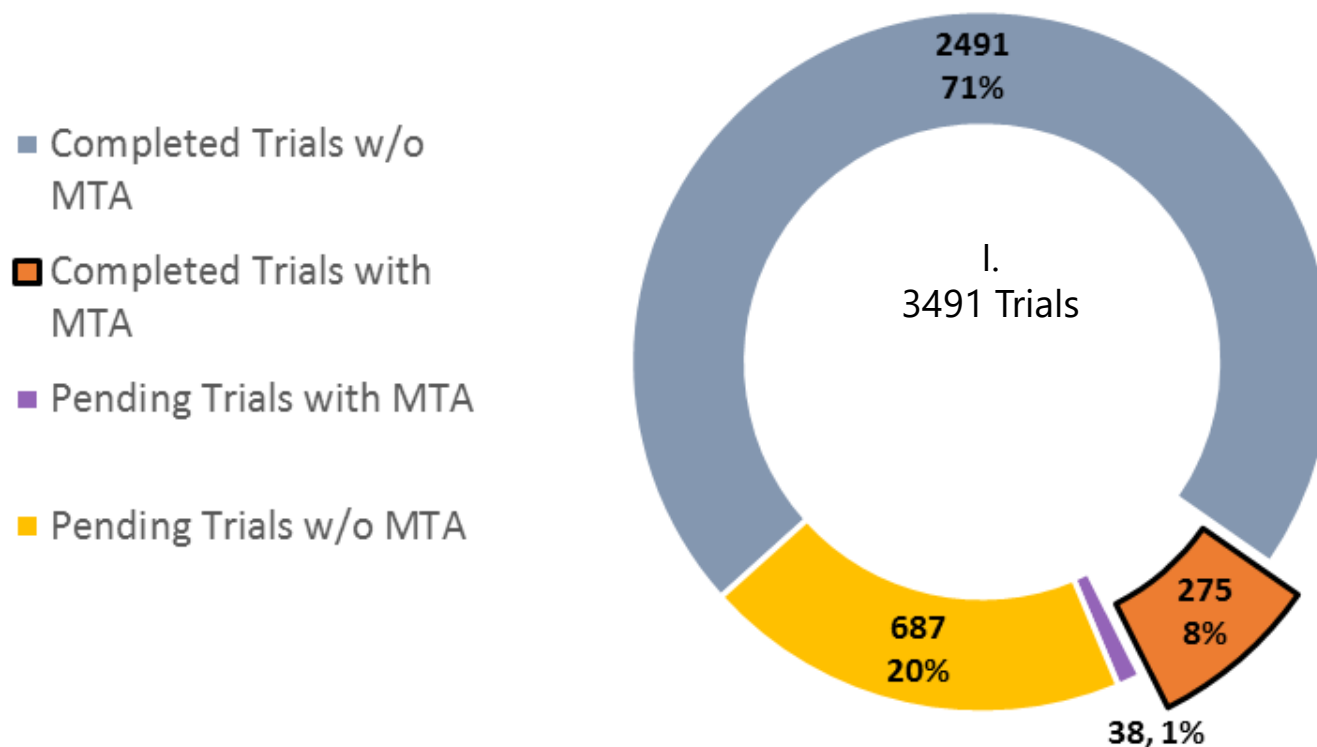
Motion to Amend Study: Update 3 Data through September 30, 2017

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Motion to Amend Total Filings

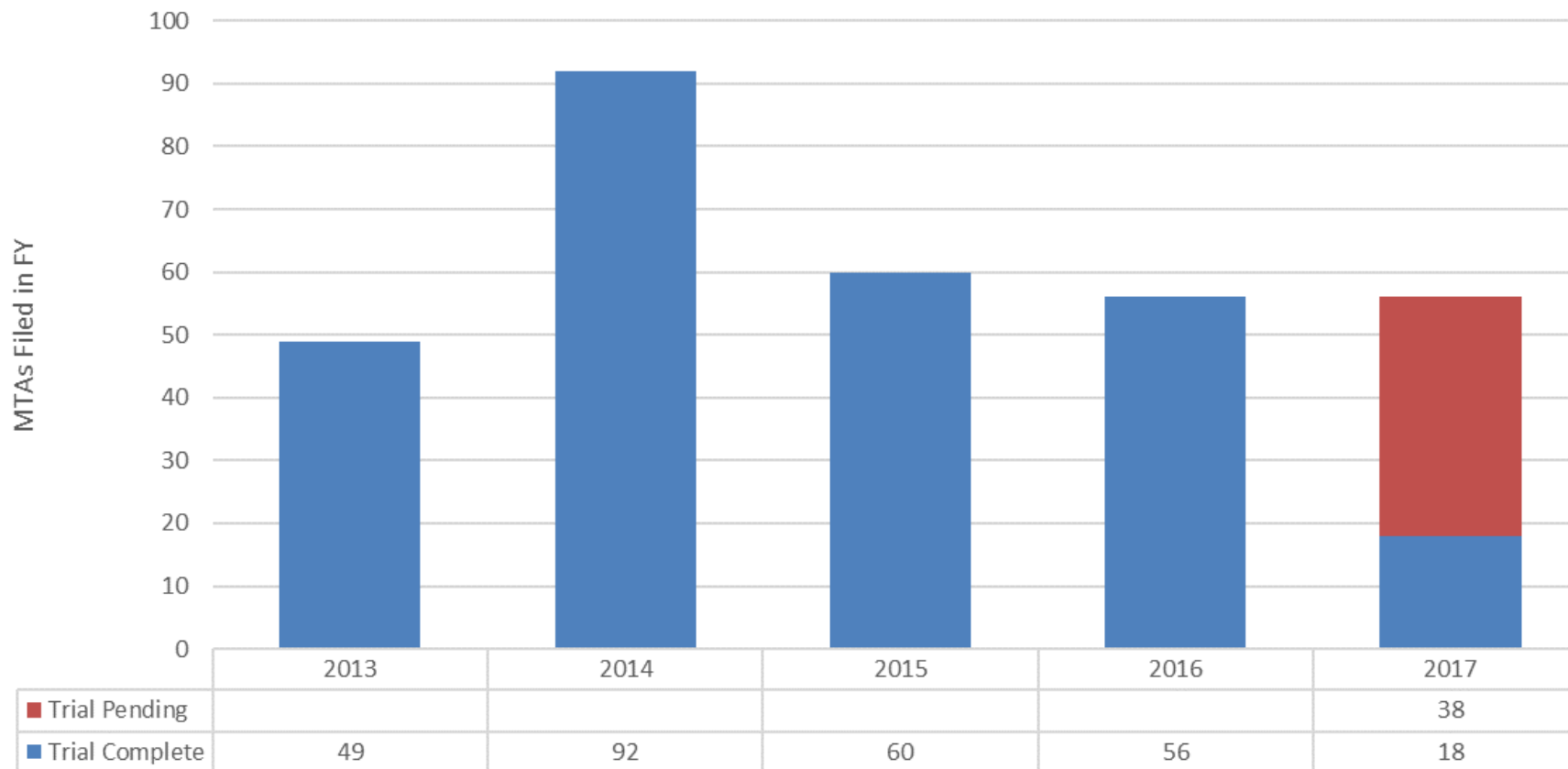
How Many Motions to Amend Are Filed?



Data current as of: 9/30/2017

Motions to Amend Filings by Fiscal Year

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



Data current as of: 9/30/2017

Reasons for Motions to Amend Denials

	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%
	<i>Total Motions to Amend Denied (in whole or in part)</i>	166	100%

A detailed technical drawing of a mechanical assembly, likely a multi-cylinder internal combustion engine, is shown in a light gray line-art style. The drawing includes various components such as pistons, connecting rods, and a crankshaft, with numerous numerical callouts (e.g., 80, 86, 84, 82, 40, 36, 22, 26, 68, 24, 30, 34, 32, 52, 50) indicating specific parts or features. The drawing is oriented horizontally and serves as a background for the slide.

SOP 9 on Remands

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Changes to SOP 9

- Goal of issuing remand decisions within 6 months of mandate issuing
- Requires a meeting between panel and Chief, Deputy Chief, or their delegates following remand decision
- Establishes default procedures for trial and appeal remand scenarios

Default Trial Procedures for Common Remand Scenarios

	Remand Scenario	Additional Briefing?	Additional Evidence?	Oral Argument?
1	Erroneous claim interpretation	Yes, unless the claim interpretation to be applied on remand was proposed by one of the parties and the effect has been fully briefed	No, unless evidence of record is insufficient to afford due process	No
2	Failure to consider the evidence	Yes, unless the evidence was fully briefed on the record	No	No
3	Inadequate explanation by the Board	No, unless the briefing on the issues is inadequate for the Board to have made a decision in the first instance	No	No
4	Erroneous application of law	Yes, unless the law was fully briefed on the record but not reflected in Board decision	No	No
5	Law of due process/denial of APA rights	Yes	Yes, for parties whose rights have been violated, unless additional briefing on evidence of record is sufficient to afford due process	Yes, if necessary to afford due process
6	Improper consideration of the arguments	Yes, unless argument is fully briefed in the record	No	No

Default Appeal Procedures for Common Remand Scenarios

	Remand Scenario	Prosecution/Reexamination Reopened
1	Erroneous claim interpretation	No, unless alternative claim interpretation renders the present rejection(s) moot
2	Failure to consider the evidence	No, unless the evidence of record is deemed entirely insufficient to support the present rejection(s)
3	Inadequate explanation by the Board	No, the Board provides additional explanation or reverse on the present record
4	Erroneous application of law	No, unless the correct application of the law renders the present rejection(s) moot
5	Law of due process/denial of APA rights	Yes, typically in the form of a new ground of rejection
6	Improper consideration of the arguments	No, arguments that were not sufficiently briefed before the Board are deemed waived



80 86 84 82 40 36 22 26 68 24 30 86 34 32 52 50

Expanded Panels

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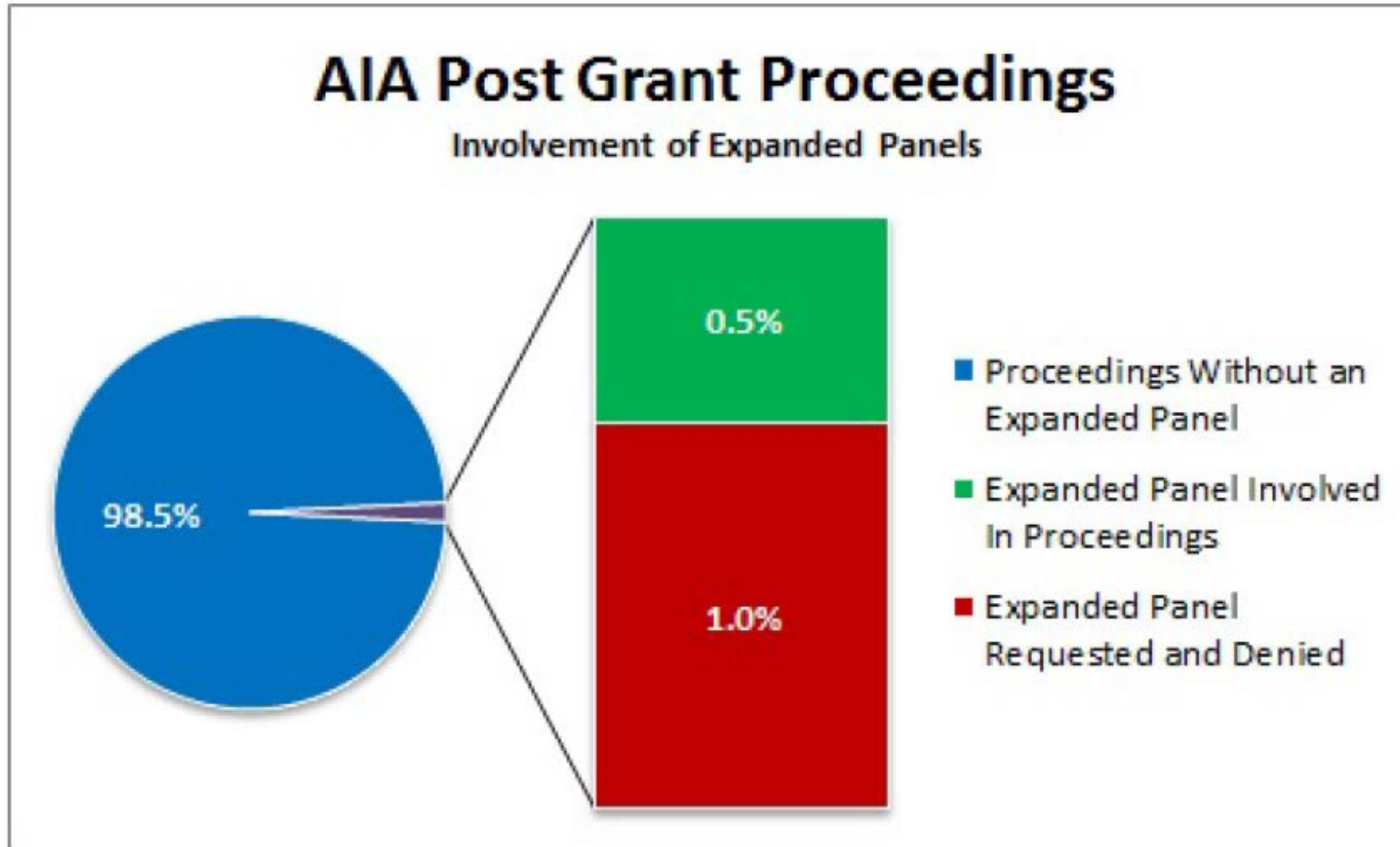
Reasons for Panel Expansion

- Chief has discretion to expand a panel
- Reasons:
 - Issue of exceptional importance
 - Maintain uniformity of Board decisions
 - Written request from Commissioner for Patents or the Commissioner's delegate identifying an issue:
 - Of first impression; or
 - Governed by a prior Board decision where Commissioner has determined it would not be in the public interest to follow the prior Board decision

Suggestion for Panel Expansion

- Who?
 - Judge
 - Merits panel
 - Interlocutory panel
 - Applicant or patent owner in an appeal
 - Party in an inter partes reexam, interference, or AIA trial
- Suggestion must be in writing with reasons and basis for expansion

PTAB Expanded Panels for AIA Trials



Of 7,200 plus AIA trial proceedings, expanded panels have occurred in about 40 of those proceedings



Recent Panel Expansion

- Expansion done 4 times in FY2017 to emphasize a point of recent Board jurisprudence
- *Neil Ziegmann v. Carlis G. Stephens*, Case IPR2015-01860 (PTAB Sept. 6, 2017) (Paper 13) (vote from 3-0 to 5-0 with expansion)
 - *Concludes that a set of prior art or arguments may be considered “substantially the same” under Section 325(d) if they are “cumulative to or substantially overlap with issues previously considered by the Office with respect to the patent.”*
- *General Plastic v. Canon*, Case IPR2016-01357 (PTAB Sept. 6, 2017) (Paper 19) (vote from 3-0 to 7-0 with expansion)
 - Sets for non-exhaustive factors for Board to consider in deciding whether to permit follow-on petitioners in AIA proceedings
- *HTC America v. Virginia Innovation Sciences*, Case IPR2017-00870 (PTAB Sept. 13, 2017) (Paper 11)
 - *Panel is expanded because there was substantial difference of opinion among the original judges of a group of related petitions related to the issue of 112(f)*
- *Facebook v. Skky*, Case CBM2016-00091 (PTAB Sept. 28, 2017) (Paper 12) (vote from 3-0 to 5-0 with expansion)
 - *Concludes that CBM patent review eligibility is determined based on the claims of the challenged patent as they exist at the time of the decision to institute, and that statutorily disclaimed claims must be treated as if they never existed*

Other Panel Expansions in the News

- *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, Case IPR2014-01121 & IPR2015-00762) (PTAB Oct. 5, 2015) (vote from 3-1 to with 3-2 expansion)
- *Target Corp. v. Destination Maternity Corp.*, Case IPR2014-00508) (PTAB Feb. 12, 2015) (vote from 3-0 to 4-3 with expansion)
- Same party joinder under 315(c) at issue
- Expanded majority permitted same party joinder whereas dissent (original majority before expansion) denied same party joinder



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What's New

2017

- [Guidance on Motions to Amend After Aqua Products](#) (November 21, 2017)
- [Judicial Conference Slides](#) (June 29, 2017)
- [PTAB "Boardside Chat" Webinar Series](#)
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"Chat with the Chief"

The PTAB is pleased to announce a new webinar series called "Chat with the Chief" for [Chief Judge David Ruschke](#) to share updates on current PTAB developments and initiatives.

The "Chat with the Chief" is free for all to attend. The Chief will receive questions for a two-way discussion.

In addition to the "Chat with the Chief" webinars, the PTAB is continuing its "Boardside Chat" webinar series on a bi-monthly basis. Boardside Chats feature conversations with Board judges on various ex parte appeal and AIA trial topics.

Please mark your calendars, and join the Board for informative and lively conversations!


Date	Time	Topic	Additional Speaker(s)
Tuesday, Oct. 24, 2017	Noon to 1 p.m.	Multiple AIA Petitions <ul style="list-style-type: none">Presentation	Lead Judge Bill Saindon

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Boardside Chat Webinars

<https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/procedures/ptab-boardside-chat-webinar-0>

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Questions

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