

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Patent Trial and Appeal Board Motion to Amend Study

Installment 5: Update through September 30, 2018

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Motion to Amend Study: Installment 5 (Update Through September 30, 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, or MTAs, 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> (last visited Feb. 20, 2019); Data for Completed Trials with a Motion to Amend, <https://go.usa.gov/xXXyZ> (last visited Feb. 20, 2019).

The Board has continued to collect data on motions to amend and has posted on its website second, third, and fourth installments of the Motion to Amend Study that analyze the same information as the original study. See Special Report Archive, Motion to Amend Studies, <https://go.usa.gov/xEmqb> (last visited Feb. 20, 2019) (providing all Motion to Amend Study installments and data sets).

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 the Board provides another update to the Motion to Amend Study through September 30, 2018 (end of FY 2018), in the graphs below (Installment 5). 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 September 30, 2018. Patent owners have filed a motion to amend in 326 of the 3,599 completed trials (9%), and in 90 of the 670 pending trials (13%)—a total of 416 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 326 completed trials in which a patent owner filed a motion to amend. The Board decided a motion to amend requesting to substitute claims in 205 of the 326 completed trials (63%). In the remaining 121 completed trials (37%), the motion to amend: (a) requested solely to cancel claims (20 or 6%), (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 (36 or 11%), or (c) was not decided because the case terminated prior to a final written decision (64 or 20%).

Graph III is a pie chart that depicts the outcomes of the 205 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 21 of the 205 trials (10%) and denied a motion to amend in 184 of the 205 trials (90%).

Graph IV focuses on the reasons provided for denying entry of substitute claims in the 197 trials in which the Board denied (184) or denied-in-part (13) 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 89% of trials or 175 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 (11%) 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).

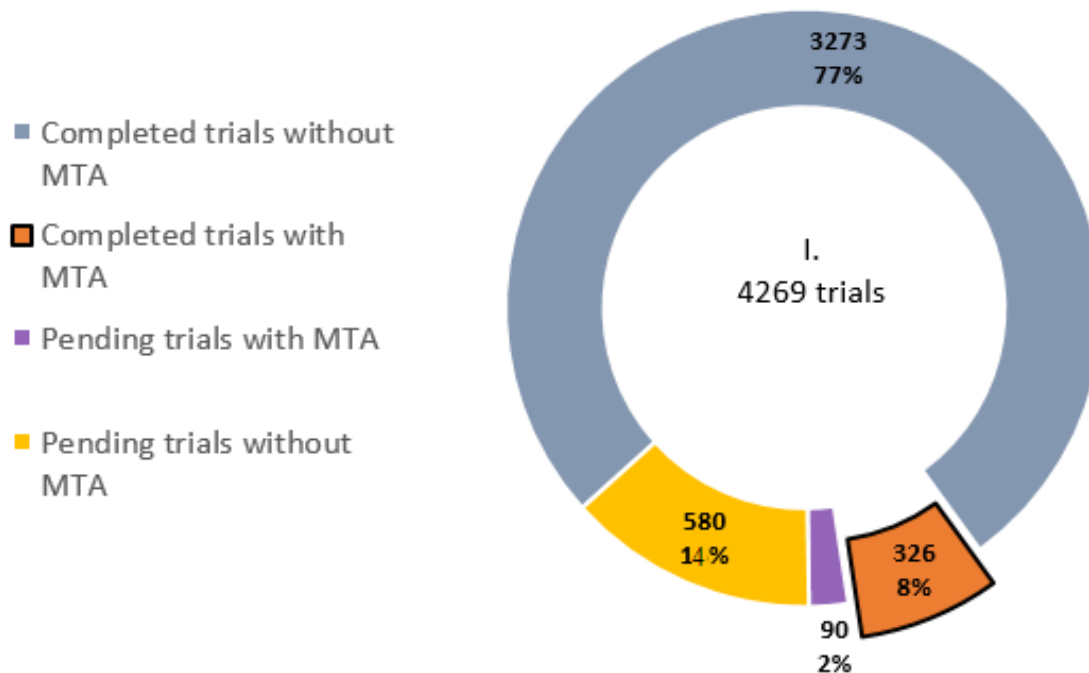
Graph V shows the total number of motions to amend filed by fiscal year. Graph V shows an increase in the number of motions to amend filed in fiscal year 2018, when compared to other fiscal years. The number of motions to amend filed in fiscal year 2018 (114) is more than the number of motions to amend filed in any other fiscal year, and more than double the number of motions to amend filed in each of fiscal year 2017 (50) and 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 third quarter of fiscal year 2018 exceeds the number of motions to amend filed in any other quarter.

Graph I: Number of motion to amend filings

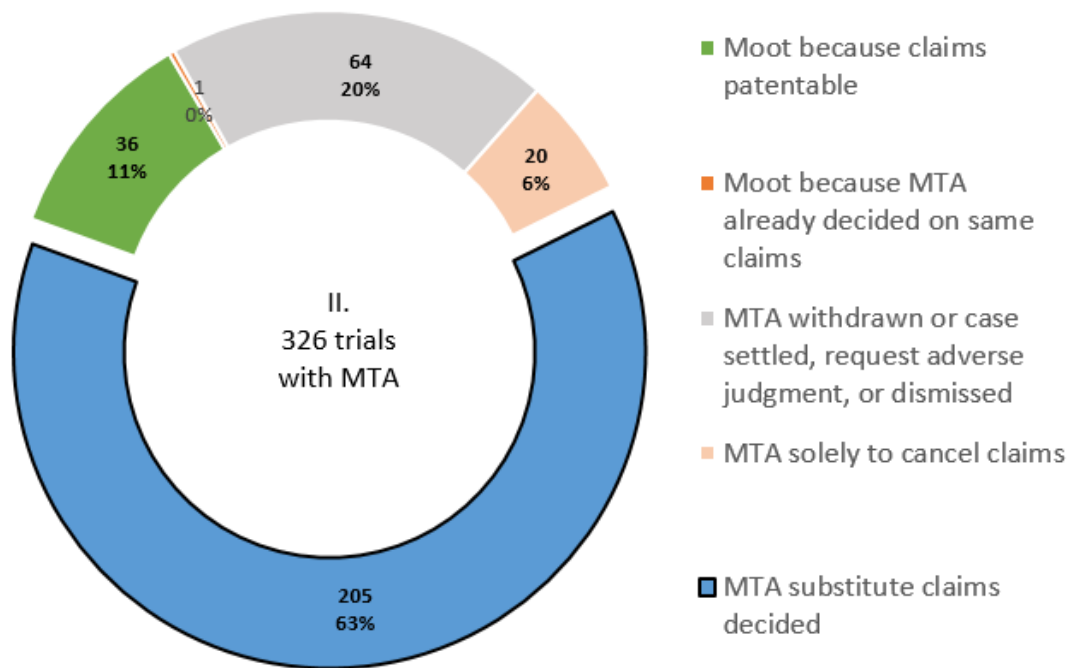
(FY13 to FY18: Oct. 1, 2012 to Sept. 30, 2018)

How many motions to amend are filed?



Graph II: Subsequent developments of motions to amend (FY13 to FY18: Oct. 1, 2012 to Sept. 30, 2018)

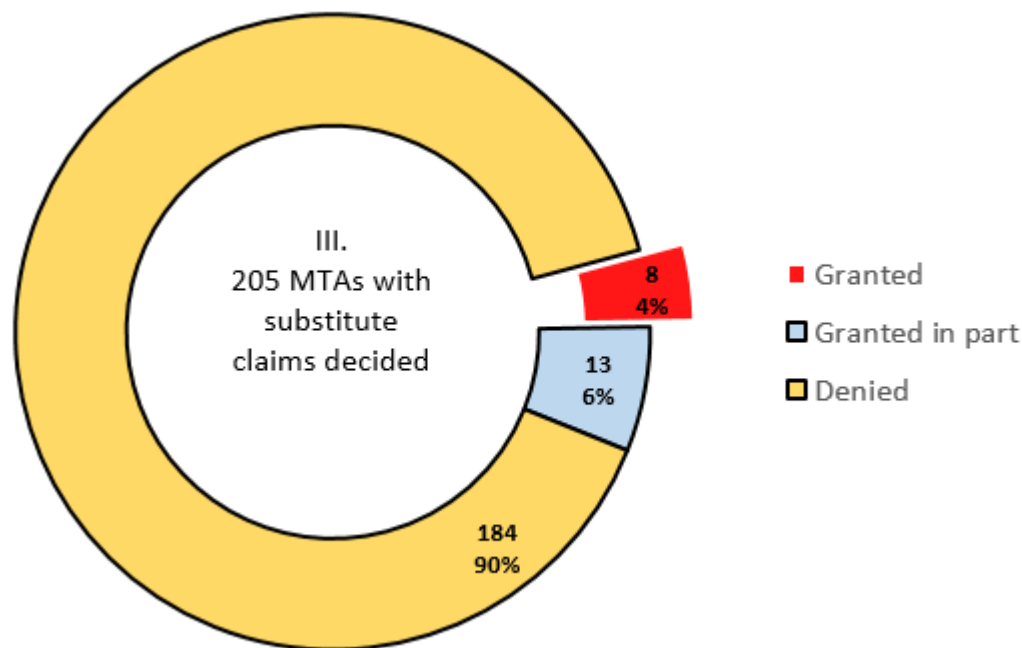
Subsequent developments of the motions to amend



Graph III: Disposition of motions to amend

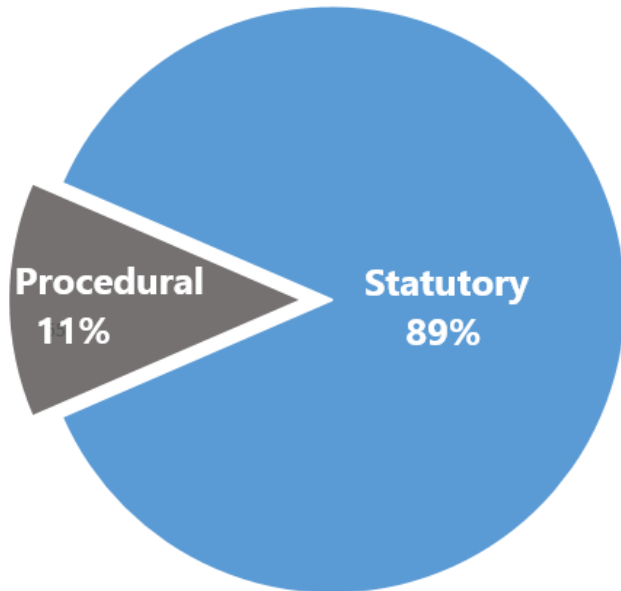
(FY13 to FY18: Oct. 1, 2012 to Sept. 30, 2018)

How many motions to amend substituting claims are granted?



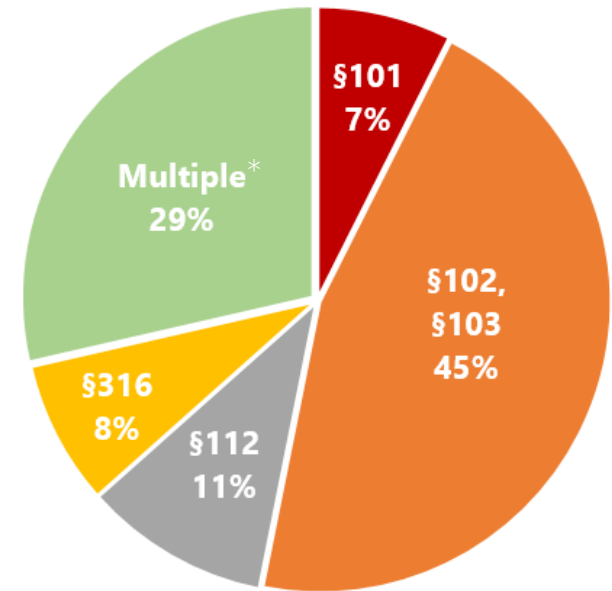
Graph IV: Reasons for denying entry of substitute claims (FY13 to FY18: Oct. 1, 2012 to Sept. 30, 2018)

All Reasons



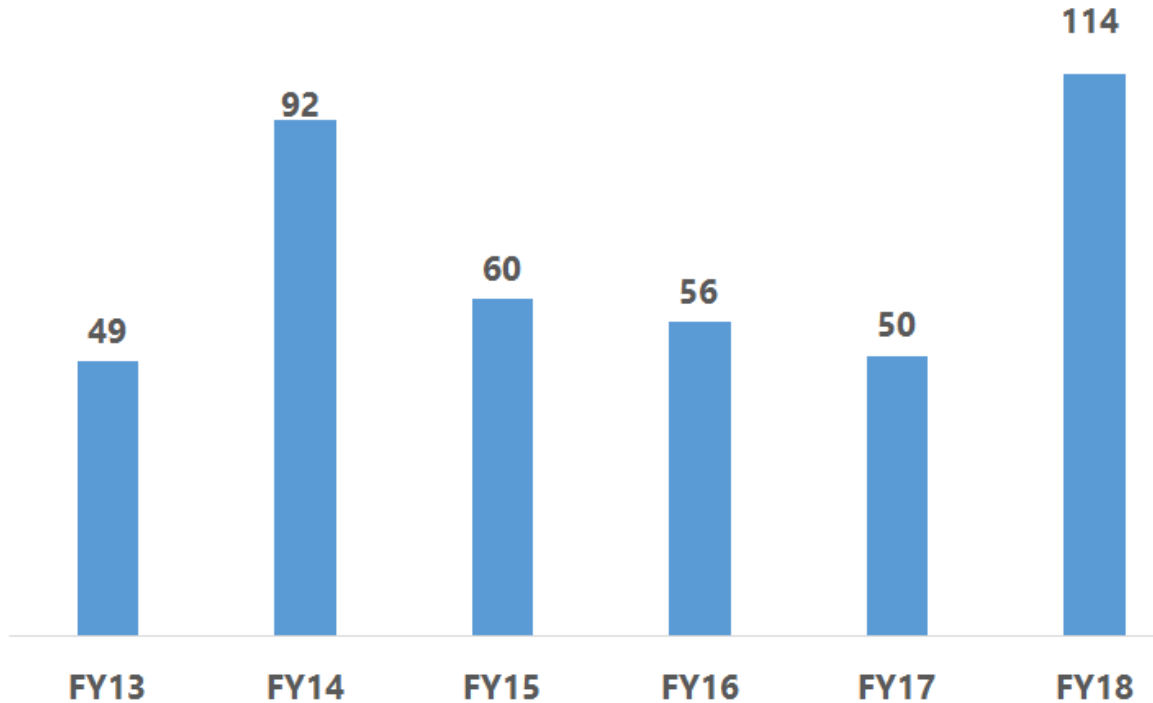
Statutory Reasons

Statutory Reasons



* 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: Oct. 1, 2012 to Sept. 30, 2018)



Graph VI: Motions to amend filed by fiscal quarter (FY13 to FY18: Oct. 1, 2012 to Sept. 30, 2018)

