

## Recent PTAB Developments

Frances L. Ippolito  
Administrative Patent Judge  
Patent Trial and Appeal Board  
United States Patent and Trademark Office

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## Appeal Statistics

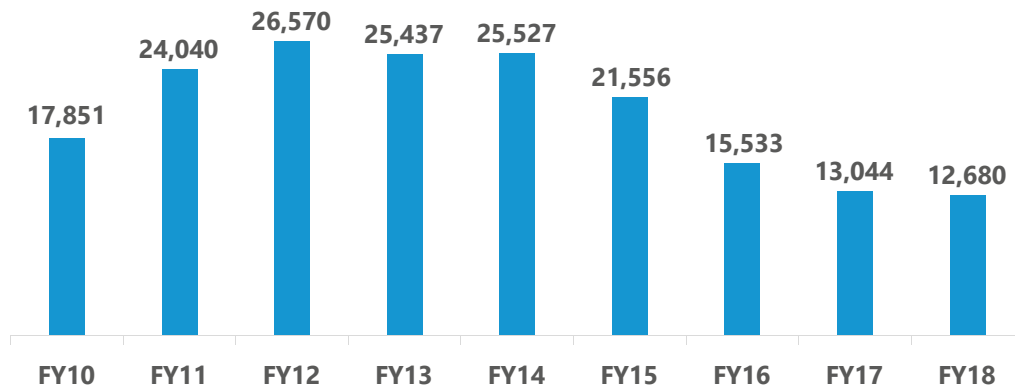
Patent Trial and Appeal Board



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## Pending Appeals

(FY10 to FY18: 9/30/10 to 1/31/18)

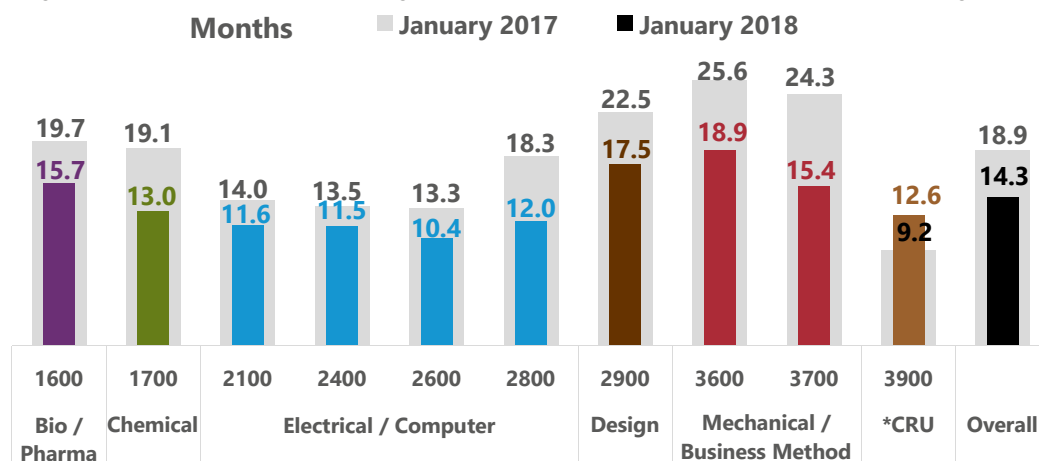


Note: FY17 pending changed from 13,034 to 13,044 due to an internal end of FY18 Q1 audit.

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## Pendency of Decided Appeals in FY17 and FY18

(Pendency of appeals decided in January 2017 compared to appeals decided in January 2018)

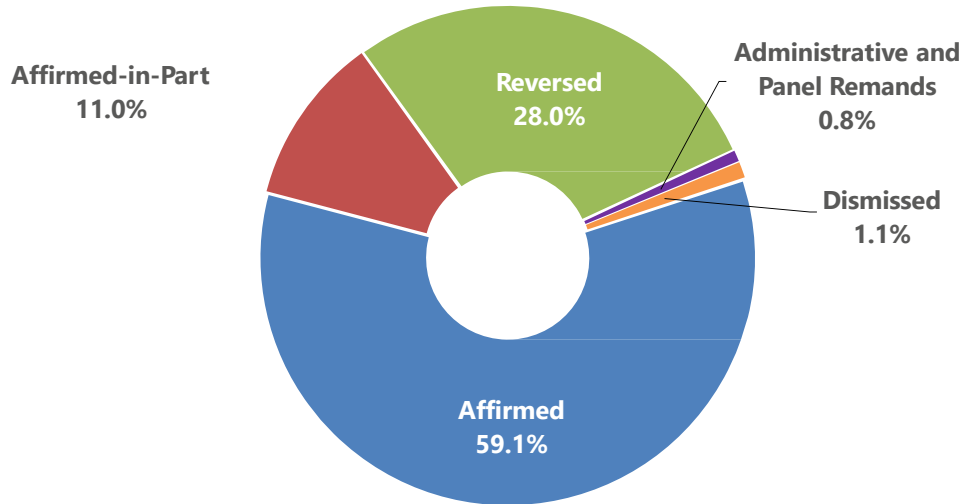


Pendency is calculated as average months from Board receipt date to final decision.  
 \*CRU (Central Reexamination Unit) includes ex parte reexams, inter partes reexams, supplemental examination reviews and reissues from all technologies.

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## Appeal Outcomes in FY18

(FY18: 10/1/17 to 1/31/18)



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## Decisions and Dispositions

Affirm the Rejection

Affirm-in-Part

Reverse the Rejection

Vacate the Rejection (rare)

Remand the Application (rare)

Dismiss the Appeal (rare)

New Ground of Rejection (37 C.F.R. § 41.50(b))

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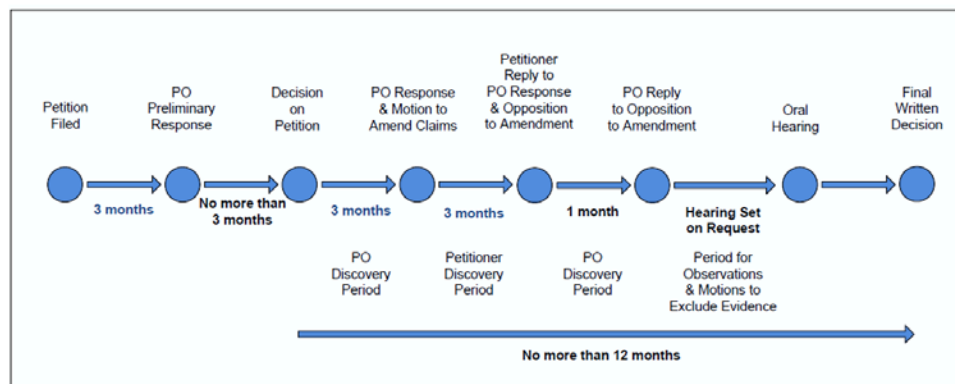
# Trial Statistics

## IPR, PGR, CBM

Patent Trial and Appeal Board

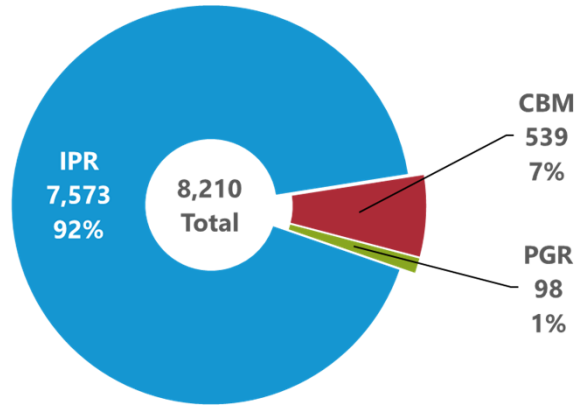


## AIA Trial Proceeding Standard Timeline



## Petitions by Trial Type

(All Time: 9/16/12 to 2/28/18)

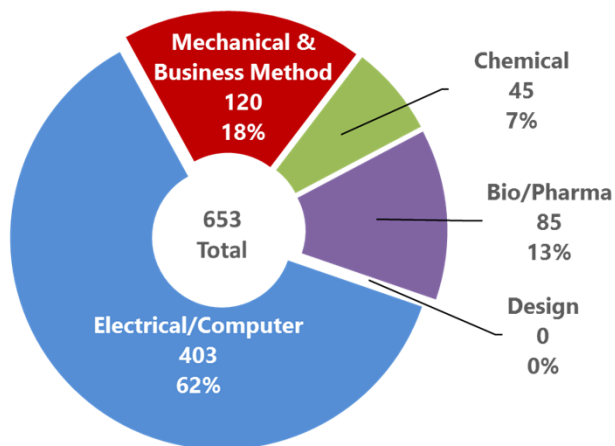


Trial types include Inter Partes Review (IPR), Post Grant Review (PGR), and Covered Business Method (CBM).



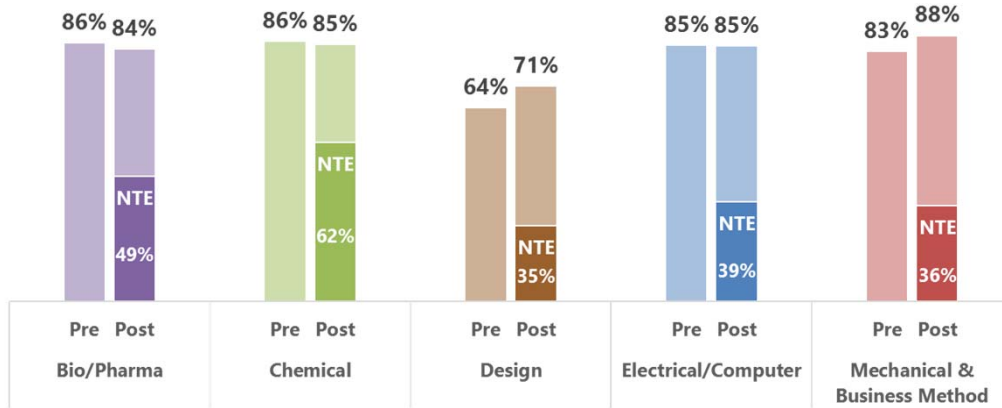
## Petitions Filed by Technology in FY18

(FY18 to date: 10/1/17 to 2/28/18)



## Preliminary Response Filing Rates

Pre- and Post-Rule To Allow New Testimonial Evidence (NTE)  
(All Time: 9/16/12 to 2/28/18)

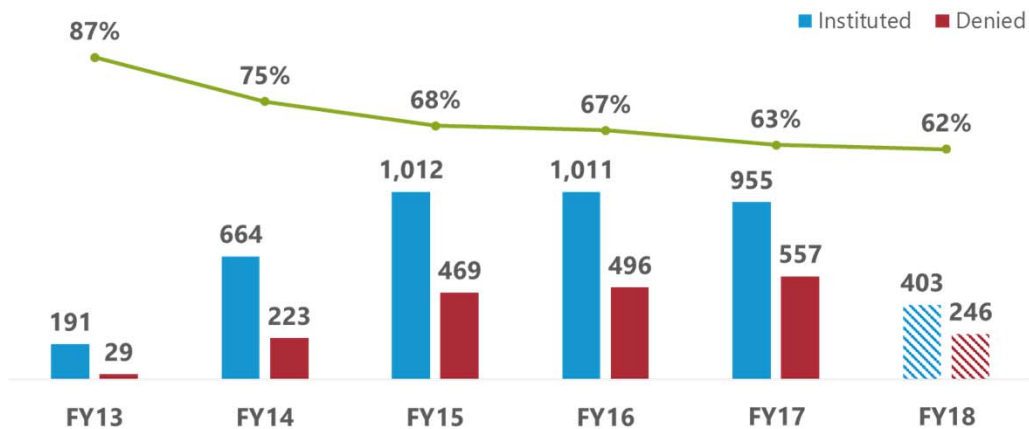


The rule to allow new testimonial evidence was effective May 2, 2016.



## Institution Rates

(FY13 to FY18: 10/1/12 to 2/28/18)

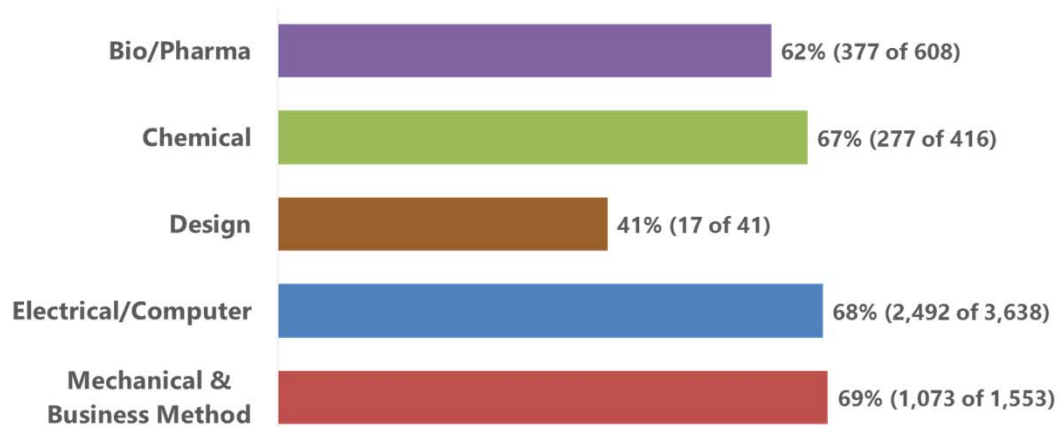


Institution rate for each fiscal year is calculated by dividing petitions instituted by decisions on institution (i.e., petitions instituted plus petitions denied). The outcomes of decisions on institution responsive to requests for rehearing are excluded.



## Institution Rates by Technology

(All Time: 9/16/12 to 2/28/18)



Institution rate for each technology is calculated by dividing petitions instituted by decisions on institution (i.e., petitions instituted plus petitions denied). The outcomes of decisions on institution responsive to requests for rehearing are excluded.



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## Guidance on Motions to Amend

## *In re Aqua Products*

### **October 4, 2017 – Federal Circuit issued en banc decision, which included five separate opinions**

As noted in lead opinion: “[V]ery little said over the course of the many pages that form the five opinions in this case has precedential weight.”

“The only legal conclusions that support and define the judgment of the court are: (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 on the patentee.”

### **November 21, 2017 – PTAB Chief Judge issued Guidance in view of Aqua Products decision**

[https://www.uspto.gov/sites/default/files/documents/guidance\\_on\\_motions\\_to\\_amend\\_11\\_2017.pdf](https://www.uspto.gov/sites/default/files/documents/guidance_on_motions_to_amend_11_2017.pdf)

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## **Guidance on Motions to Amend in view of Aqua Products**

- Board will not place the burden of persuasion on PO with respect to the patentability of substitute claims presented in a motion to amend;
- If PO files a motion to amend, Board will determine whether the substitute claims are unpatentable by a preponderance of the evidence based on the entirety of the record, including any opposition made by the petitioner;
- Current practice and procedure before Board has not changed.



## **Guidance on Motions to Amend in view of *Aqua Products***

- A motion to amend must meet requirements of 35 U.S.C. § 316(d)
  - propose a reasonable number of substitute claims
  - substitute claims do not enlarge scope of the original claims or introduce new matter
- A motion to amend must meet requirements of 37 C.F.R. § 42.121 or § 42.221, as applicable
  - set forth written description support and support for benefit of a filing date in relation to each substitute claim
  - respond to grounds of unpatentability involved in the trial
- Under 37 C.F.R. § 42.11, all parties have a duty of candor
  - including PO's duty to disclose information that PO is aware of that is material to the patentability of substitute claims, if such information is not already of record

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## **Guidance on Motions to Amend in view of *Aqua Products***

- Board will continue its current briefing practice as to types, timing, and page-limits of briefs;
- Parties with pending motions to amend may request briefing changes or additional briefing;
- PO may contact the Board to file new or substitute motion to amend under certain circumstances.

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# Recent Precedential and Informative Decisions

## Precedential

### Facebook, Inc. v. Skky, LLC

- Case CBM2016-00091, Paper 12 (Sept. 28, 2017)
- AIA § 18, pre-institution statutory disclaimer

### Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha

- Case IPR2016-01357 et al., Paper 19 (Sept. 6, 2017)
- AIA § 314(a), discretionary factors re: multiple petitions

## Informative

### [Cultec, Inc. v. Stormtech LLC](#)

- Case IPR2017-00777, Paper 7 (Aug. 22, 2017)
- AIA § 325(d), deny institution – examination

### [Hospira, Inc. v. Genentech, Inc.](#)

- Case IPR2017-00739, Paper 16 (July 27, 2017)
- AIA § 325(d), deny institution – examination

### [Unified Patents Inc. v. Berman](#)

- Case IPR2016-01571, Paper 10 (Dec. 14, 2016)
- AIA § 325(d), deny institution – examination

## Informative (continued)

[Becton, Dickinson & Co. v. B. Braun Melsungen AG](#), Case IPR2017-01587, Paper 8 (Dec. 15, 2017) (designated Mar. 21, 2018) [AIA § 325(d), deny institution – examination; discretionary factors]

[Kayak Software Corp. v. Int'l Bus. Mach. Corp.](#), Case CBM2016-00075, Paper 16 (Dec. 15, 2016) (designated Mar. 21, 2018) [AIA § 325(d), deny institution – examination]

# Where to Find Precedential and Informative Decisions

The image displays three sequential screenshots of the USPTO website to illustrate how to find precedential and informative decisions.

- First Screenshot:** Shows the 'Patent Trial and Appeal Board' page. A red circle highlights the 'Decisions' link in the 'Upcoming PTAB events' section. A red arrow labeled '1' points from this link to the second screenshot.
- Second Screenshot:** Shows the 'Decisions' page. A red box highlights the 'Precedential and Informative Decisions' link in the left sidebar. A red arrow labeled '2' points from this link to the third screenshot.
- Third Screenshot:** Shows the 'Precedential and Informative Decisions' page. A red box highlights the 'Precedential and Informative Decisions' link in the left sidebar. A red arrow points from this link to the main content area of the page, which lists various decision categories such as 'Recently designated decisions', 'Patent eligibility - 35 U.S.C. § 101', 'Anticipation - 35 U.S.C. § 102', etc.

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