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SONSINI**

A teal-colored background featuring a close-up, slightly blurred image of mechanical gears. The gears are metallic and interlocked, with one gear in the foreground being more prominent than the others in the background.

2024 PTAB YEAR IN REVIEW

Table of Contents

<u>Introduction.....</u>	1
<u>PTAB Filings and Outcomes</u>	2
<u>Notable Developments at the PTAB</u>	3
<u>Appellate Review of AIA Post-Grant Proceedings.....</u>	4
<u>Summary Affirmances and Written Opinions in AIA Appeals Before the Federal Circuit.....</u>	7
<u>About Wilson Sonsini’s Post-Grant Practice</u>	10

Introduction



Wilson Sonsini Goodrich & Rosati is pleased to present our *2024 PTAB Year in Review*.

We begin with a review of 2024 petition filings and outcomes at the Patent Trial and Appeal Board (PTAB) of the U.S. Patent and Trademark Office (USPTO).

We then provide a summary of notable developments at the PTAB, including proposed rule changes and director review decisions.

Next, we explore several appellate decisions relevant to PTAB trials.

Finally, we provide an update on summary affirmances and written opinions in America Invents Act (AIA) appeals before the United States Court of Appeals for the Federal Circuit.

We hope you find our *2024 PTAB Year in Review* to be a useful resource for insight on the most meaningful developments from the past year. As always, should you have any questions or comments on any of the matters discussed in this report, please contact a member of the firm's post-grant practice or your regular Wilson Sonsini attorney.

PTAB Filings and Outcomes

Patents challenged and substantive institution rates at the PTAB for FY2024 were generally consistent with trends observed since 2018, with rates of institution, merits denials, and discretionary denials similar to those in FY2023. Below is a brief elaboration about these numbers.

	Petitions	Patents Challenged	Institution Rate	Denial of Institution	
				Merits	Discretion
FY18	1,614	1,146	60%	26%	14%
FY19	1,467	1,048	57%	23%	19%
FY20	1,514	1,194	59%	21%	20%
FY21	1,403	1,136	58%	25%	17%
FY22	1,367	1,108	69%	24%	6%
FY23	1,243	1,052	67%	26%	6%
FY24 ²	1,290	1,037	72%	21%	7%

2024 AIA Post-Grant Proceedings Filing and Institution Rates

Over the past six PTAB fiscal years (from October through September), the number of petitions has dropped while the number of patents challenged has been flat. Thus, the reduction in the number of petitions may be attributed to a decrease in parallel and serial challenges to patents. Institution rates were steady between FY2018 and FY2021, hovering at or around 60 percent. However, the institution rates for FY2022 to FY2024 petitions are significantly higher (67 percent-72 percent), generally as a result of discretionary denials.¹

In past years, the frequency of discretionary denials such as those related to parallel district court litigation (*Fintiv*), serial challenges (*General Plastic*), and repeating arguments and evidence previously considered by the Office (*Advanced Bionics*) had rivaled the frequency of merits-based denials. In FY2022 the PTAB dramatically curtailed the use of discretionary denials. The reduced rate of discretionary denials has remained consistent in FY2023 and FY2024.

Institution rates for the various technology centers remained variable in FY2024, with rates ranging from 53 percent to 83 percent. In FY2024, institution of patents from USPTO's

Biotechnology Technology Center further increased, up eight percent since FY2023 and 25 percent since FY2022. Computer Architecture continued its downward trend, decreasing by 11 percent since FY2023 and 28 percent since FY2022, making it the technology with the lowest institution rate, at 53 percent. Chemistry had long been the most difficult technology in which to gain institution, but it saw an increase of 20 percent in FY2024 to an institution rate of 65 percent, although the significance of the change is limited with only 39 total petitions filed in this center. Patents from the remaining Technology Centers had institution rates slightly higher than the previous few fiscal years.

Tech Center	FY21		FY22		FY23		FY24	
	Total Petitions	Institution Rate	Total Petitions	Institution Rate	Total Petitions	Institution Rate	Total Petitions	Institution Rate
1600 – Biotechnology	99	69%	95	58%	91	75%	72	83%
1700 – Chemical and Material Engineering	79	53%	53	49%	33	45%	39	65%
2100 – Computer Architecture	190	53%	168	81%	129	64%	105	53%
2400 – Computer Networks	254	53%	244	68%	242	63%	320	70%
2600 – Communications	232	55%	259	75%	261	74%	239	77%
2800 – Semiconductors	208	67%	212	72%	226	69%	222	75%
3600 – Transportation	142	63%	143	62%	124	63%	131	71%
3700 – Mechanical Engineering	176	55%	172	69%	121	69%	153	78%
Miscellaneous	24	--	21	--	15	--	9	--

Looking now to Final Written Decisions resulting from FY2023 petitions as compared to those filed in the prior two fiscal years, the percentage of decisions upholding all claims had ticked down slightly to 15 percent in FY2022 but ticked back up to 19 percent in FY2023, consistent with the rates seen in FY2020 and FY2021. Decisions finding all claims unpatentable remained steady at 68 percent. Mixed decisions also remained constant at 16 percent. In keeping with past trends, successful motions to amend were not obtained in a significant percentage of cases.

	FY20 (n=449)	FY21 (n=484)	FY22 (n=492)	FY23 (n=351) ³
All claims upheld	18%	19%	15%	19%
All claims unpatentable	61%	66%	68%	68%
Mixed	20%	15%	16%	16%
Amended claims	1%	<1%	<1%	<1%

Notable Developments at the PTAB

USPTO Rule Updates

After multiple years in which no rule changes were adopted, USPTO promulgated multiple new rules in 2024. The first of these was in June 2024, when new rules were adopted governing procedures for internal circulation and review of PTAB decisions before issuance.⁴ The new rules were added as 37 C.F.R. Part 43. These rules forbid the Director, Deputy Director, Commissioner for Patents, and Commissioner for Trademarks from communicating with a PTAB panel about a decision prior to issuance, unless they are a member of the panel. The same prohibition applies to Management Judges, except that their

input is allowed on panel request. The rules make any feedback or suggestions optional at the panel's discretion and requires any binding policy or guidance to be written and made public.

In October 2024, the USPTO also adopted new rules governing Director review.⁵ The new rules were added as 37 C.F.R. §42.75. Under these rules, Director review is available for institution decisions, final decisions, and other decisions concluding an AIA proceeding. Director review is also available for decisions granting rehearing, but not for

decisions denying rehearing. This maintains the prior practice that Director review of a final or institution decision is an alternative to rehearing, rather than providing a second bite at the apple. The rules also maintain the opportunity for

sua sponte Director review and specify timing and procedures governing the Director review process.

The USPTO also adopted rules governing the motion to amend process for AIA trials.⁶ These rules amend 37 C.F.R. §§42.121 (governing *inter partes* review, or IPR) and 42.221 (governing post grant review). The amendments add rules governing preliminary guidance and revised motions to amend, generally consistent with recent PTAB practice under its Motion To Amend Pilot Program.⁷ The rules also provide the PTAB itself with an opportunity to raise a new ground of unpatentability, in which case parties must be given notice and opportunity to respond. The opportunity to raise a new ground of unpatentability in this manner loosely resembles the PTAB's ability to raise new grounds of rejection in appeals from *ex parte* examination.⁸

A final new rule adopted this year simplifies the rules governing counsel in AIA proceedings, including allowing parties to proceed without back-up counsel on showing good cause, streamlining the process for repeat *pro hac vice* admission of counsel, and clarifying requirements for non-registered counsel to inform the Office about developments that may materially affect their *pro hac vice* status.⁹

Rule changes were also proposed this year regarding terminal disclaimer practice¹⁰ and discretionary denial.¹¹ Among the changes proposed for terminal disclaimer practice was to require terminal disclaimers to disclaim enforcement of the disclaimed patent if *any* claim of the prior patent was subsequently invalidated by prior art. The terminal disclaimer proposal was subsequently withdrawn after provoking hundreds of comments.¹² The discretionary denial rule proposal remains pending and includes proposed rules covering discretionary denial under 35 U.S.C. §§314(a), 324(a), and 325(d). Among other aspects, the proposal would provide rules on handling serial and parallel petitions, previously presented art and arguments, and discretionary denial in the joinder context. The rule would also authorize patent owners to file a paper separate from the preliminary response to raise issues of discretionary denial. The proposed rule does not address considerations of parallel district court proceedings under *Fintiv*¹³ and its progeny.

PREVAIL Act Considered by Senate

The Promoting and Respecting Economically Vital American Innovation Leadership (PREVAIL) Act¹⁴ will be moving to the full Senate for a vote after narrowly passing the Senate Judiciary Committee in an 11-10 vote. The draft Act would implement numerous changes to AIA proceedings, including applying

a presumption of validity at a clear and convincing evidence standard instead of a preponderance standard. It also would broaden estoppel provisions, including by effectively moving forward to the institution decision the estoppel provisions of 35 U.S.C. §315(e) that currently apply upon issuance of a final written decision institution. The Act also would apply a time bar of one year from date of service of a district court complaint to reexamination requests, similar to that for IPR petitions. Broadly speaking, the effect of the act would be to discourage patent validity challenges and make them harder to win.

Director Review Decisions

The PTAB Review has been reporting developments at the USPTO including updates for Director Review decisions throughout the year. Recent decisions were covered in the October 2024 issue. Since then, then-Director Kathi Vidal has left her position at the USPTO. Before she left, then-Director Vidal penned three additional Director review decisions, which are summarized briefly below.

In *Duration Media LLC v. Rich Media Club LLC*, then-Director Vidal vacated a split panel's final written decision that upheld challenged claims.¹⁵ Members of the panel disagreed about whether the petitioner had shown a claim element (the "viewability test") was disclosed in the prior art. The panel found that the petitioner's expert admitted at cross-examination that a relied-upon prior art reference did not teach "how to do its viewability test."¹⁶ Director Vidal disagreed with the majority and concluded that the panel need not rely on the expert's testimony where the prior art itself is easily understandable to the panel.¹⁷ She commented, "expert testimony is not dispositive, or even necessary, to resolve whether [the prior art] discloses the viewability test."¹⁸

In *Luminex Int'l Co., Ltd. v. Signify Holdings B.V.*, then-Director Vidal issued a supplemental opinion providing additional reasons for her decision finding that a indemnitee was not an unidentified real party-in-interest (RPI).¹⁹ She explained that, without more, "a customer-indemnitee's request for indemnification by a manufacturer-indemnitor under a standard, non-exclusive, manufacturer-customer indemnification agreement relating to patent infringement" cannot be "sufficient to support a finding of real party in interest and trigger the one-year time bar."²⁰ Put differently, "standard indemnification language" in a contract alone "does not support an inference that the Agreement" gives another party "the opportunity or ability to control" an IPR proceeding.²¹

In *Nokia of Am. Corp. v. Soto*,²² then-Director Vidal vacated for the second time a panel decision denying institution for presenting substantially the same art and arguments as were previously considered by the USPTO. In March 2024, then-Director Vidal had vacated the panel's first non-institution decision because "the Board did not sufficiently explain its findings that substantially the same art and substantially the same arguments were previously presented to the Office."²³ On remand from the Director, the panel again determined that the petitioner's obviousness challenges were substantially the same as those advanced during prosecution of the challenged patent. On review, then-Director Vidal again concluded that the panel's determination was erroneous.²⁴ She faulted the panel for not "consider[ing] sufficiently the material differences between" prior art references in this case versus those advanced during prosecution.²⁵ She noted in particular that the reference considered during prosecution "fails to teach an optical transceiver" while the references asserted by petitioner in this case include "disclosure of optical

transceivers," which "is a material difference between their teachings."²⁶

With Director Vidal's departure from the USPTO, it is unknown whether the next Director will share much of Director Vidal's opinions expressed in her decisions or will apply the power of Director Review to steer the PTAB process differently.

Appellate Review of AIA Post-Grant Proceedings

Amended Claims

One feature of PTAB trials is the patent owner's ability to amend its claims,²⁷ which is not available in district court. Three precedential Federal Circuit decisions in 2024 highlight the challenges that arise when a patent owner wants to "substitute"²⁸ claims for the challenged claims.

CyWee

The PTAB has adopted a facially rigid practice that joinder petitioners must be silent partners in a PTAB trial. The PTAB and the Federal Circuit recently confirmed, however, that when the interests of the original and joinder petitioners diverge significantly, the joinder petitioner is not a hostage to the original petitioner (and whatever agreements it might have with the patentee). In *CyWee Group v. ZTE*,²⁹ the original petitioner had elected not to challenge substitute claims. Perhaps the substitute claims gave the original petitioner a non-infringement argument. Whatever the reason, the joinder petitioner was concerned about the substitute claims and challenged them. The PTAB initially denied the joinder petitioner's request to oppose CyWee's motion to amend but, on rehearing, the PTAB agreed that the joinder petitioner

had an independent interest in opposing the motion to amend that the original petitioner no longer wished to oppose. The PTAB denied CyWee's motion to substitute claims and CyWee appealed. The Federal Circuit affirmed the denial of CyWee's motion to amend. The court affirmed that the joinder petitioner could depart from its agreement to take a backseat to the original petitioner when their interests diverged. The court also upheld the decision on the merits.

Joinder has always presented a conundrum for petitioners because joinder can significantly interfere with any possible settlement between the original petitioner and the patentee. *CyWee* amplifies this conundrum because anything less than a global settlement with all parties could result in the joinder petitioner undercutting any advantage the patentee or original petitioner assumed it achieved by settling.

Zyxel

Amending claims in the face of an opposing party can be challenging enough, but in *Zyxel Communications v. UNM Rainforest Innovations*,³⁰ the appeal proved to be the problem. The PTAB had held most claims unpatentable, but had granted UNMRI's motion to amend and determined one claim was not obvious. On appeal, Zyxel argued that the surviving claim was also unpatentable and, if so, the amended claims should be collaterally estopped on the same facts that rendered the surviving claim obvious.

The court affirmed the granting of the motion to amend as it had been argued at the PTAB, but agreed with Zyxel that *all* claims were obvious, including the one that had survived at the PTAB. The court explained that the collateral

estoppel argument—though new on appeal—was proper because collateral estoppel was not a possibility until the court reversed the PTAB's patentability decision for the surviving claim.

Pfizer

While amending claims is challenging, in *Pfizer v. Sanofi Pasteur*,³¹ the patent owner received a partial reprieve. The PTAB had held all claims unpatentable and had denied Pfizer's motion to amend. On appeal, the court affirmed the unpatentability of all original claims and denial of the motion to amend for all but two substitute claims. For the two exceptions, the court agreed with Pfizer that the PTAB had failed to articulate why these two claims were unpatentable; consequently, the court remanded these claims to the PTAB for further analysis. On remand, the PTAB held the surviving claims to be obvious and Pfizer has again appealed.

Patentee Estoppel—*Softview v. Apple*³²

The IPR and post-grant review statutes provide explicit estoppel against petitioners,³³ but lack any equivalent estoppel for patentees. A PTAB rule fills this gap by barring a patent applicant or owner from acting inconsistently with an adverse decision, including seeking a claim that is patentably indistinct from a claim refused or canceled in a PTAB trial.³⁴ *Softview* appealed two PTAB decisions in reexaminations holding its original patent claims estopped under the PTAB rule. *Softview* challenged the agency's authority to promulgate the rule, the scope of the rule, and whether it applied to issued patent claims.

The court found authority for the rule in a specific statutory provision permitting

the PTAB to make rules governing the relationship between PTAB trials and other patent proceedings.³⁵ *Softview* argued that, because the rule would make otherwise patentable claims unpatentable without a statutory basis, the rules were substantive rather than procedural and thus beyond the statute's scope. The court, however, distinguished decisions about another statute that did not grant the agency authority to make substantive rules, holding the statute here is broader in scope in the context of PTAB trials.

The court also rejected *Softview*'s scope argument that the rule's "not patentably distinct" standard was improperly broader than common-law collateral estoppel. Explaining that "patentably distinct" is a specialized term in patent law, familiar from obviousness-type double patenting and patent interferences, the court held that the term has the same meaning for the patentee-estoppel rule. In any case, the court explained, the rule is also consistent with collateral estoppel.

Softview prevailed, however, in its challenge to the PTAB's application of the rule to issued claims. The reexaminations involved a mix of original and amended claims. While affirming application of the patentee-estoppel rule to the amended claims, the court pointed to other PTAB decisions holding that the rule does not apply to unamended patent claims. Although the PTAB here had distinguished the earlier PTAB cases, the court found the earlier PTAB cases more persuasive and more broadly applicable. Thus, the court adopted an easily applied distinction between new (amended) and old (unamended) claims for all applications of the rule.

Unpatentability over Prior Art

2024 saw developments in both how obviousness is analyzed and what constitutes prior art.

LKQ

In *LKQ v. GM Global Technology Operations*,³⁶ the court (sitting *en banc*) clarified that its design-patent obviousness precedent was overly rigid and contrary to the U.S. Supreme Court's decision in *KSR International v. Teleflex*.³⁷ The Federal Circuit had required a primary prior-art reference that was "basically the same" as the challenged design claim. Any secondary reference had to be "so related" to the primary reference that it would suggest the applicability of one to the other. Neither of these requirements exists in obviousness law generally. The fallacy of the first requirement could be seen from a Supreme Court decision³⁸ in which the front of one design and the back of another design were used together: under rigid Federal Circuit precedent, neither older design would have been "basically the same" as the resulting design. The *en banc* panel decided the relatedness of any secondary reference was best analyzed under the analogous-art standard used for obviousness generally.

Cytiva

Although design-patent cases make up a small fraction of PTAB trials, *LKQ* was a useful reminder that rigid, area-specific doctrines are in tension with *KSR*. Another such doctrine, the lead-compound analysis used in many chemical cases has been applied with varying degrees of rigidity since *KSR*. *Cytiva Bioprocess v. JSR*³⁹ reaffirms that lead-compound analysis is not always required and that obviousness analysis must remain flexible. The court held that the PTAB's obvious-to-try analysis

was reasonable on the facts of the case; indeed, the court explained that both analyses proceed from the same essential situation in which an artisan is faced with finite options.

IOENGINE

In *IOENGINE v. Ingenico*,⁴⁰ the court partially reversed the PTAB's unpatentability determination due to misapplication of the printed-matter doctrine. Under this doctrine, a claim limitation reciting "communicative content" (originally actual printed matter but now applied more broadly) might not be given patentable weight. Here, the PTAB held that "encrypted communications" and "program code" were printed matter. The court disagreed, explaining as a threshold matter that these limitations are not printed matter because, while they relate to communication, it is not the *content* of the communication that is being claimed.

Prior Art

Several cases in 2024 addressed whether a reference is properly prior art, with the court generally declining to expand exceptions to the use of references (or similar bars) as prior art.

Sanho

*Sanho v. Kaijet Technology*⁴¹ held that a reference that derived its content from the inventor was nevertheless prior art. The America Invents Act reorganized the statutory section that defines prior art⁴² by, among other things, codifying safe-harbor exceptions for the inventor's own disclosures.⁴³ Under one provision, the reference must derive from a public disclosure by the inventor.⁴⁴ In *Sanho*, the reference derived from a private sale, prompting the question whether a private sale is necessarily a public disclosure that would trigger the safe harbor. The court held the safe harbor

should be read narrowly to require public disclosure of the invention; hence, this reference fell outside the safe harbor and was available as prior art.

Weber

In *Weber, Inc. v. Provisur Technologies*,⁴⁵ the court reversed a PTAB determination that user manuals were not prior art because they were confidential and thus not publicly available. The court explained that user manuals are generally produced for dissemination to the interested public. The PTAB gave too little weight to evidence of broad availability and too much weight to intellectual property-rights clauses in the manuals, which the PTAB mistook for confidentiality requirements.

"On Sale" Prior Art

In *Crown Packaging Technology v. Belvac Production Machinery*,⁴⁶ a British subsidiary had sent a "quotation" to a customer in the United States. The court held that, whatever its label, the quotation was sufficient as an offer for sale because it targeted a specific entity, called itself an "offer," and provided sufficiently definite terms of sale. Moreover, the sale was "in this country" despite its foreign origin because it was sufficient for it to be directed to a U.S. customer. Similarly, in *Celanese International v. International Trade Commission*,⁴⁷ the court deemed a secret foreign use of a patented process resulting in U.S. sales to have been a sale. Celanese sought to bar U.S. sales of Chinese sweeteners made using its patented process. Celanese argued that its earlier use of the process could have not put it on sale because the use was secret. The court disagreed, agreeing with the ITC that Supreme Court precedent⁴⁸ permitting secret sales to bar patents would also apply to secret uses of commercialized processes resulting in U.S. sales.

Standing on Appeal

The court continued to police its jurisdiction in 2024, although it also continued to support standing for patent owners.

Sanho

In *Sanho* (discussed above under prior art), the court confirmed that the PTAB's unpatentability determination against Sanho's claims was still a live controversy despite Sanho giving the petitioner a covenant not to sue because Sanho still had an interest in preserving its claims to assert against others. Interestingly, the court did not discuss whether Sanho actually intended to sue others.⁴⁹

Intellectual Tech

Similarly, the court held the plaintiff in *Intellectual Tech. v. Zebra Technologies*⁵⁰ had standing to sue despite having granted a security interest in its patent to a lender and then defaulted. The court held that the security agreement allowed the plaintiff to retain an exclusionary right in the patent, which met the constitutional minimum for a protectable interest, but left open for remand whether the plaintiff met the statutory requirement⁵¹ to be a "patentee" because the district court had not decided the issue.

Platinum

The petitioner in *Platinum Optics v. Viavi Solutions*⁵² was not successful in maintaining standing. Viavi had sued Platinum for infringement, but then dismissed the suits with prejudice. Platinum argued that letters from Viavi indicated that it would sue Platinum again. Despite the letters and litigation history, the court held the threat was too speculative to constitute a concrete injury-in-fact. The court explained that a petitioner need not concede infringement to have standing, but nevertheless required the petitioner

to show the risk is "substantial." The contrast between *Sanho* and *Platinum* highlights the asymmetric barriers patentees and petitioners face in proving standing.

Pendency

Perhaps the story more important than any single opinion in 2024 has been the Federal Circuit's growing delay in hearing and deciding cases. Appeals are averaging 300 days from the completion of briefing to panel hearing, compared to half that time five years ago. Various factors have contributed to the delay, including courtroom renovations and the unavailability of one judge. The court has instituted measures to reduce its backlog, including inviting district-court judges to sit on panels and adding hearing days to its calendar. Nevertheless, any significant reduction in the backlog will be slow in coming. A party needing a prompt decision should work with counsel as soon as the notice of appeal is filed to explore options for expediting the hearing.

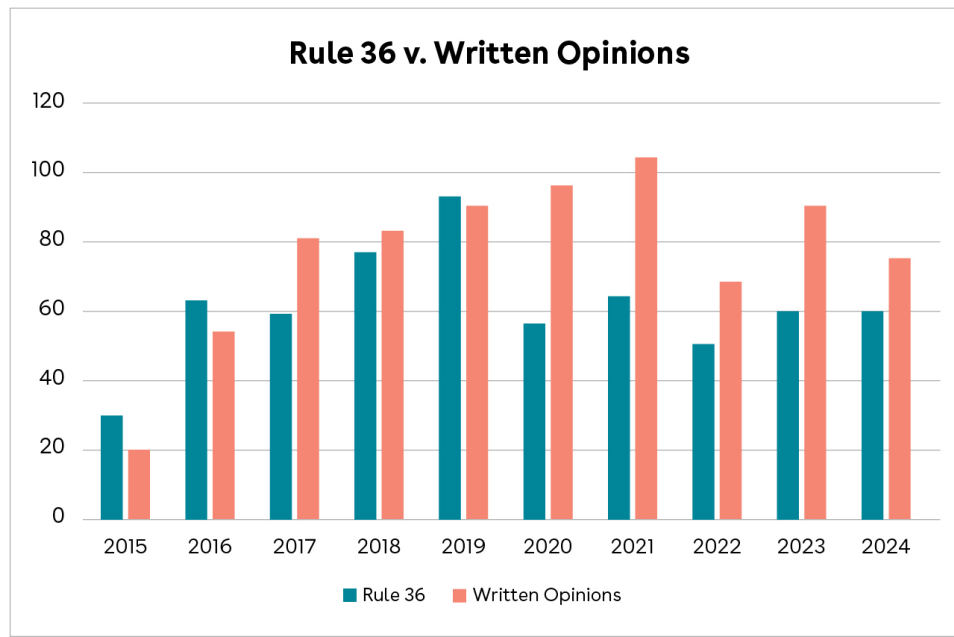
Summary Affirmances and Written Opinions in AIA Appeals Before the Federal Circuit

With its exclusive jurisdiction over patent cases,⁵³ the Federal Circuit hears many appeals arising from final written decisions issued by the PTAB in AIA trial proceedings. The court affirms most of these appeals and, in many cases, summarily affirms without a written opinion. Summary affirmances are governed by Federal Circuit Rule 36, which permits the court to "enter a judgment of affirmance without opinion" under certain conditions and when "an opinion would have no precedential value."⁵⁴

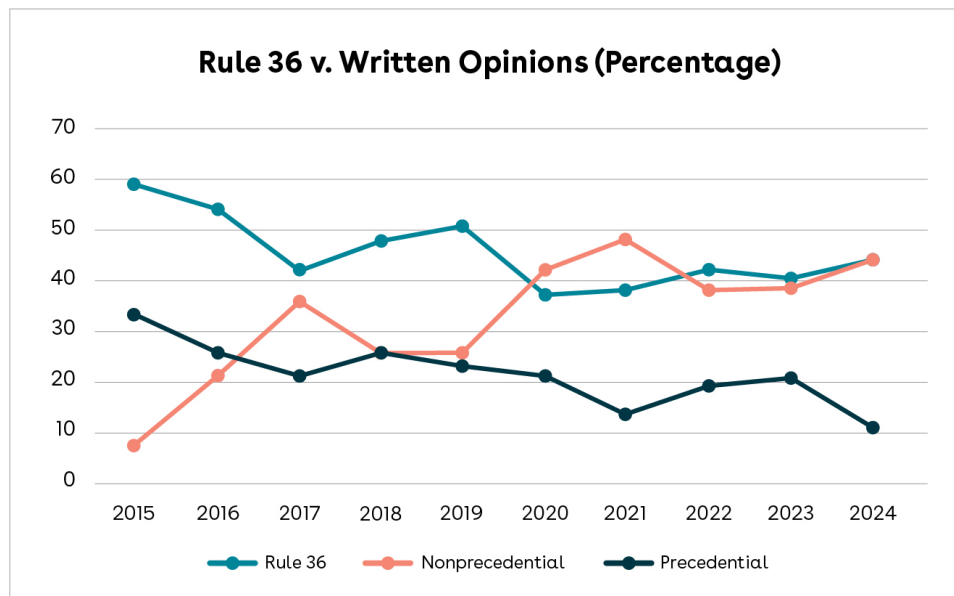
The enactment of post-grant trial proceedings under the AIA has led to a significant rise in appeals from the PTAB heard by the Federal Circuit over recent years. While the court's Rule 36 practice has enabled some judicial efficiency over a consistently growing docket, some have criticized and challenged the court's use of Rule 36 summary affirmances in deciding appeals. For example, in August 2021, after receiving a Rule 36 judgment in an appeal from a district court case dismissing its patent claims,⁵⁵ one party petitioned the U.S. Supreme Court, arguing that the Federal Circuit's Rule 36 affirmance violated certain constitutional and statutory protections.⁵⁶ In February 2023, another patentee seeking to overturn PTAB decisions against its patents in seven IPRs asked the Supreme Court to review the Federal Circuit's Rule 36 affirmance practice.⁵⁷ This latter challenge argued that the Federal Circuit's use of Rule 36 "violate[d] the requirement of 35 U.S.C. §144 that the Federal Circuit 'shall issue to the Director its mandate and opinion.'"⁵⁸ The following year, a third patentee asked the Supreme Court for relief from a Federal Circuit's summary affirmance of IPR decisions.⁵⁹

The Supreme Court denied these petitions,⁶⁰ but this has not dissuaded others from challenging the Federal Circuit's Rule 36 practice. In a recent combined petition for rehearing and rehearing *en banc*, a party urged the Federal Circuit to reconsider its Rule 36 affirmance of three IPRs⁶¹ on the basis that these decisions "violated the Supreme Court's mandate" in *Loper Bright Enterprises v. Raimondo* prohibiting a reviewing court from deferring "to an agency interpretation of the law simply because a statute is ambiguous."⁶² By affirming the judgment without explanation, the party argued, the Federal Circuit had deferred to the PTAB's conclusion that the applied prior art was enabled (an issue of law).⁶³ Indeed, recently, the Supreme Court has ordered a respondent to file a response to such a petition.⁶⁴

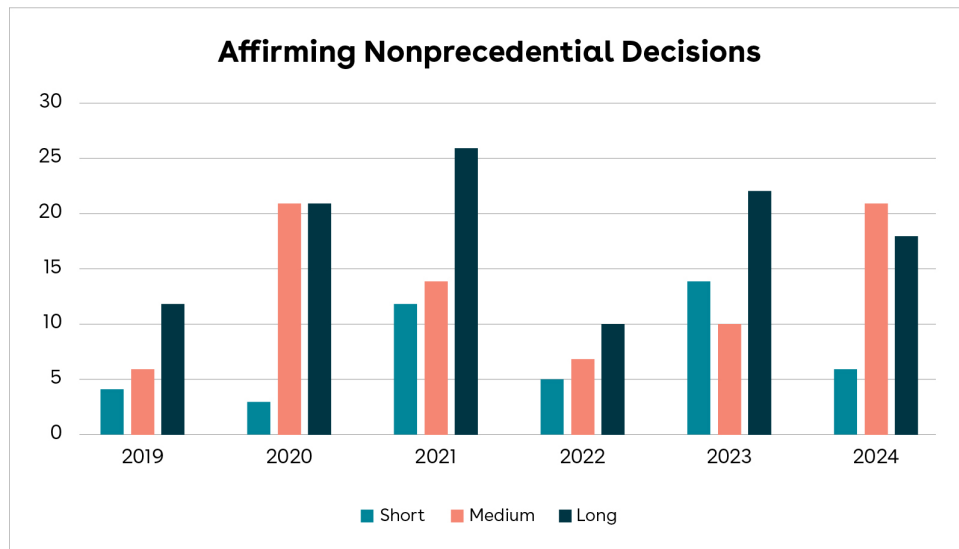
In light of these recent challenges to Rule 36, we analyzed recent trends in Rule 36 affirmances and written opinions of final written decisions issued by the PTAB in AIA trial proceedings. We found that the number of Rule 36 judgments affirming AIA trial decisions has **decreased** in recent years. As shown below, up to 2019, Rule 36 affirmances represented over (or close to) a majority of decided AIA trial appeals. However, the number of Rule 36 affirmances began to drop off in 2020, with written opinions now consistently making up the majority of AIA appeal judgments.



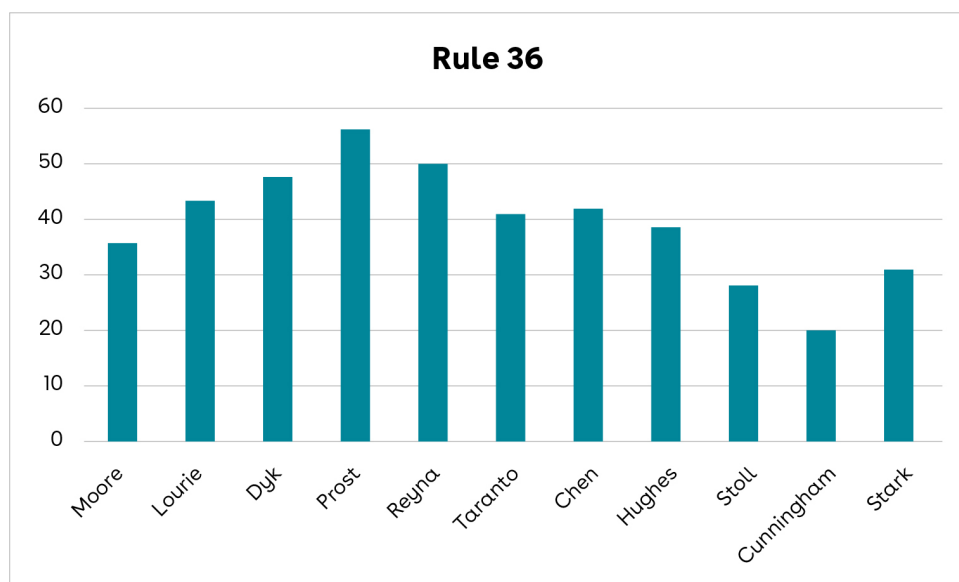
Breaking down written opinions further into type (precedential or nonprecedential), the trend shows that, while the percentage of Rule 36 affirmances issued by the court has steadily decreased since 2015, the percentage of nonprecedential decisions has increased over the same time period, with the percentage of precedential decisions steadily decreasing. Over the last two years, a near-equal percentage of Rule 36 affirmances and nonprecedential opinions have been issued by the Federal Circuit for appeals arising from AIA trial proceedings. This trend suggests that there has been a shift by the court toward issuing nonprecedential decisions instead of Rule 36 affirmances.



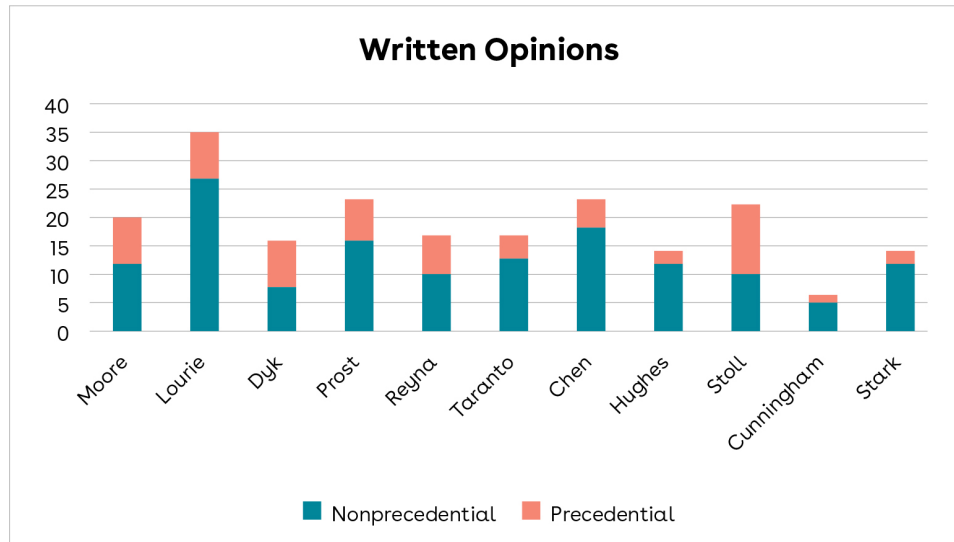
Looking into the details of this overall shift, the graph below provides an overview of the length of nonprecedential decisions issued by the court from 2019 to 2024 that affirmed on all issues on appeal. Relative to 2019, while there was an increased number of longer nonprecedential decisions (greater than 10 pages) issued by the court, an uptick in medium-length decisions (greater than five pages and less than or equal to 10 pages) occurred in 2020 and an uptick in short-length decisions (less than or equal to five pages) occurred in 2021. In the years since 2021, longer nonprecedential decisions have declined overall, with relatively more short- and medium-length decisions being issued by the court during 2022 to 2024. This relative increase in the issuance of short- and medium-length nonprecedential opinions may suggest that, in lieu of issuing Rule 36 affirmances, the court is now trending toward writing nonprecedential opinions, albeit relatively shorter decisions.



What has been the recent rate of Rule 36 affirmances among the currently active judges on the Federal Circuit? The below graph illustrates how many panels each active judge⁶⁵ has been on from 2022 to 2024 where the panel summarily affirmed an appeal from an AIA trial. Judge Prost was associated with the highest number of Rule 36 judgments, with most judges, except for Judges Stoll and Cunningham, falling between 30 and 50 summary affirmances.



Moreover, with respect to nonprecedential and precedential decisions issued from 2022 to 2024, Judge Lourie had the highest number of opinions as a writing judge, with the vast majority of those opinions being nonprecedential. With the exception of Judges Stoll and Dyk, the remaining judges also had a majority of their written opinions issued as nonprecedential.



On balance, the data reviewed indicate that party-challenges to the Federal Circuit’s Rule 36 affirmance practice have preceded an increase in the tendency of the court to issue written affirmances, even if those opinions are short, but that the court continues to employ Rule 36 for summary affirmance despite the pushback. In practice, substituting short opinions for summary affirmances might mainly increase the time to receive a decision in simple cases.

About Wilson Sonsini’s Post-Grant Practice

The professionals in Wilson Sonsini Goodrich & Rosati’s post-grant practice are uniquely suited to navigate the complex trial proceedings at the United States Patent and Trademark Office (USPTO). We have extensive experience before the PTAB, representing clients in numerous new trial proceedings and in countless reexaminations and patent interference trials. Our practice includes professionals with decades of experience at the PTAB, including former USPTO personnel. Our core team leverages firmwide intellectual property expertise to provide comprehensive IP solutions for clients that cover strategy, prosecution, licensing, enforcement, and defense.

Disclaimer

This communication is provided as a service to our clients and friends and is for informational purposes only. It is not intended to create an attorney-client relationship or constitute an advertisement, a solicitation, or professional advice as to any particular situation.

Endnotes

- 1 PTAB institution data in this article was obtained using Lex Machina and includes discretionary denials of institution. FY2024 numbers reflected institution decisions entered on or before December 26, 2024.
- 2 419 cases had not reached the institution stage as of December 26, 2024.
- 3 135 IPRs had yet to reach Final Written Decision as of December 26, 2024.
- 4 Rules Governing Pre-Issuance Internal Circulation and Review of Decisions Within the Patent Trial and Appeal Board, 89 Fed. Reg. 49808 (June 12, 2024).
- 5 Rules Governing Director Review of Patent Trial and Appeal Board Decisions, 89 Fed. Reg. 79744 (Oct. 1, 2024).
- 6 Rules Governing Motion To Amend Practice and Procedures in Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board, 89 Fed. Reg. 76421 (Sep. 18, 2024).
- 7 See Notice Regarding a New Pilot Program Concerning Motion To Amend Practice and Procedures in Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board, 84 Fed. Reg. 9497 (Mar. 15, 2019).
- 8 See 37 C.F.R. §41.50(b).
- 9 Expanding Opportunities To Appear Before the Patent Trial and Appeal Board, 89 Fed. Reg. 82172 (Oct. 10, 2024).
- 10 Terminal Disclaimer Practice To Obviate Nonstatutory Double Patenting, 89 Fed. Reg. 40439 (May 10, 2024).
- 11 Patent Trial and Appeal Board Rules of Practice for Briefing Discretionary Denial Issues, and Rules for 325(d) Considerations, Instituting Parallel and Serial Petitions, and Termination Due to Settlement Agreement, 89 Fed. Reg. 28693 (Apr. 19, 2024).
- 12 Terminal Disclaimer Practice To Obviate Nonstatutory Double Patenting; Withdrawal, 89 Fed. Reg. 96152 (Dec. 4, 2024).
- 13 *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (Mar. 20, 2020).
- 14 S. 2220, 118th Cong. (2023-2024).
- 15 IPR2023-00953, Paper 78 (Dec. 12, 2024).
- 16 *Id.*, 7.
- 17 *Id.*, 9-10 (citing *Wyers v. Master Lock Co.*, 616 F.3d 1231, 1242 (Fed. Cir. 2010)).
- 18 *Id.*, 11.
- 19 IPR2024-00101, Paper 20 (Nov. 21, 2024).
- 20 *Id.*, 11.
- 21 *Id.*, 12.
- 22 IPR2023-00680, -00681, -00682, Paper 30 (Dec. 3, 2024).
- 23 IPR2023-00680, -00681, -00682, Paper 18, 2-3 (Mar. 28, 2024).
- 24 IPR2023-00680, -00681, -00682, Paper 30, 6 (Dec. 3, 2024).
- 25 *Id.*
- 26 *Id.*, 7-8.
- 27 35 U.S.C. §§316(d), 326(d).
- 28 37 C.F.R. §§42.121(a)(3) (reasonable number of substitute claims), 221(a)(3) (same).
- 29 90 F.4th 1358 (Fed. Cir. 2024).
- 30 107 F.4th 1368 (Fed. Cir. 2024).
- 31 94 F.4th 1341 (Fed. Cir. 2024).
- 32 108 F.4th 1366 (Fed. Cir. 2024).
- 33 35 U.S.C. §§315(e), 325(e).
- 34 37 C.F.R. §42.73(d)(3).
- 35 35 U.S.C. §§316(a)(4), 326(a)(4).
- 36 102 F.4th 1280 (Fed. Cir. 2024) (*en banc*).
- 37 550 U.S. 398 (2007).
- 38 *Smith v. Whitman Saddle*, 148 U.S. 674 (1893).
- 39 App. 2023-2074 (Fed. Cir. Dec. 4, 2024).
- 40 App. 2021-1277 (Fed. Cir. May 3, 2024).
- 41 108 F.4th 1376 (Fed. Cir. 2024).
- 42 35 U.S.C. §102.
- 43 35 U.S.C. §102(b)(2).
- 44 35 U.S.C. §102(b)(2)(B).
- 45 92 F.4th 1059 (Fed. Cir. 2024).
- 46 App. 22-2299 (Fed. Cir. Dec. 10, 2024).
- 47 App. 22-1827 (Fed. Cir. Aug. 12, 2024).
- 48 *Helsinn Healthcare v. Teva Pharms.*, 586 U.S. 123 (2019).
- 49 108 F.4th 1379 n.2.
- 50 101 F.4th 807 (Fed. Cir. 2024) (from a district-court dismissal for lack of standing).
- 51 35 U.S.C. §281.
- 52 111 F.4th 1378 (Fed. Cir. 2024).
- 53 28 U.S.C. §1295.
- 54 Fed. Cir. R. 36(a).
- 55 *Bobcar Media LLC v. Aardvark Event Logistics, Inc.*, No. 20-1847 (Fed. Cir. Mar. 5, 2021).
- 56 Petition for Writ of Certiorari, *Bobcar Media LLC v. Aardvark Event Logistics, Inc.*, No. 21-158 (Aug. 2, 2021).

Endnotes (cont.)

- 57 *Virentem Ventures, LLC v. Google LLC*, Nos. 21-1764, 21-1765, 21-1804, 21-1822 (Fed. Cir. Nov. 21, 2022); *Virentem Ventures, LLC v. Google LLC*, Nos. 21-1805, 21-1806 (Fed. Cir. Nov. 21, 2022); *Virentem Ventures, LLC v. Google LLC*, No. 21-1934 (Fed. Cir. Nov. 21, 2022).
- 58 Petition for Writ of Certiorari, *Virentem Ventures, LLC v. Google LLC*, No. 22-803 (Feb. 21, 2023).
- 59 *Jodi A. Schwendimann v. Neenah, Inc.*, Nos. 22-1951, 22-1952, 22-1953 (Fed. Cir. Oct. 11, 2023); Petition for Writ of Certiorari, *Jodi A. Schwendimann v. Neenah, Inc.*, No. 23-1023 (Mar. 14, 2024).
- 60 *Bobcar Media LLC v. Aardvark Event Logistics, Inc.*, 142 S. Ct. 235 (2021); *Virentem Ventures, LLC v. Google LLC*, 143 S. Ct. 1060 (2023); *Jodi A. Schwendimann v. Neenah, Inc.*, 144 S. Ct. 2579 (2024).
- 61 Petition for Rehearing and Rehearing *En Banc*, *Converter Manufacturing, LLC v. Tekni-Plex, Inc.*, Nos. 23-1801, 23-1802, 23-1803 (Fed. Cir. Oct. 9, 2024).
- 62 *Loper Bright Enterprises v. Raimondo*, 144 S. Ct. 2244, 2273 (2024); Petition for Rehearing and Rehearing *En Banc*, *Converter Manufacturing, LLC v. Tekni-Plex, Inc.*, Nos. 23-1801, 23-1802, 23-1803, at pp. 1, 10 (Fed. Cir. Oct. 9, 2024).
- 63 Petition for Rehearing and Rehearing *En Banc*, *Converter Manufacturing, LLC v. Tekni-Plex, Inc.*, Nos. 23-1801, 23-1802, 23-1803, at pp. 1, 10 (Fed. Cir. Oct. 9, 2024).
- 64 Response Requested, *ParkerVision, Inc. v. TCL Industry Holdings*, No. 24-518 (S. Ct. Dec. 16, 2024).
- 65 The graph shows the Rule 36 counts for 11 of the 12 active judges. Judge Newman is not currently hearing appeals and so was excluded from the dataset.

For more information, please contact:

Michael Rosato
206.883.2529
mrosato@wsgr.com

Matt Argenti
650.354.4154
margenti@wsgr.com

Richard Torczon
202.973.8811
rtorczon@wsgr.com

Jad Mills
206.883.2554
jmills@wsgr.com

WILSON SONSINI

650 Page Mill Road, Palo Alto, California 94304-1050 | Phone 650-493-9300 | Fax 650-493-6811 | www.wsgr.com

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