



This document is scheduled to be published in the Federal Register on 11/03/2015 and available online at <http://federalregister.gov/a/2015-28107>, and on [FDsys.gov](http://FDsys.gov)

[3510-16-P]

## DEPARTMENT OF COMMERCE

### United States Patent and Trademark Office

[Docket No.: PTO-P-2015-0055]

#### **Proposed Pilot Program Exploring an Alternative Approach to Institution Decisions in Post Grant Administrative Reviews; Reopening of Period for Comments**

**AGENCY:** United States Patent and Trademark Office, Commerce.

**ACTION:** Request for comments; reopening of comment period.

**SUMMARY:** The United States Patent and Trademark Office (USPTO) is requesting comments on a proposed pilot program pertaining to the institution and conduct of the post grant administrative trials provided for in the Leahy-Smith America Invents Act (AIA), Pub. L. No. 112-29, 125 Stat. 284 (2011). The AIA provides for the following post grant administrative trials: Inter Partes Review (IPR), Post-Grant Review (PGR), and Covered Business Method Patent Review (CBM). The USPTO currently has a panel of three Administrative Patent Judges (APJs) decide whether to institute a trial, and then normally has the same three-APJ panel conduct the trial, if instituted. The USPTO is considering a pilot program under which the determination of whether to institute an IPR

will be made by a single APJ, with two additional APJs being assigned to the IPR if a trial is instituted. Under this pilot program, any IPR trial will be conducted by a panel of three APJs, two of whom were not involved in the determination to institute the IPR. The USPTO published a request for comments in the Federal Register on August 25, 2015, seeking public comment on a proposed pilot program pertaining to the institution and conduct of these post grant administrative trial proceedings. See Request for Comments on a Proposed Pilot Program Exploring an Alternative Approach to Institution Decisions in Post Grant Administrative Reviews, 80 FR 51540 (Aug. 25, 2015). The USPTO is now extending the period for public comment until November 18, 2015.

**DATES:** *Comment Deadline Date:* Written comments on the notice published August 15, 2015 (80 FR 51540) must be received on or before November 18, 2015.

**ADDRESSES:** Comments must be sent by electronic mail message over the Internet addressed to: PTABTrialPilot@uspto.gov.

Electronic comments submitted in plain text are preferred, but also may be submitted in ADOBE® portable document format or MICROSOFT WORD® format. The comments will be available for viewing via the USPTO's Internet Web site (<http://www.uspto.gov>). Because comments will be made available for public inspection, information that the submitter does not desire to make public, such as an address or phone number, should not be included in the comments.

**FOR FURTHER INFORMATION CONTACT:** Scott R. Boalick, Vice Chief  
Administrative Patent Judge by telephone at (571) 272-9797.

**SUPPLEMENTARY INFORMATION:** The first petitions for AIA post grant administrative trials were filed on September 16, 2012. Since then, over 3,600 petitions have been filed, and over 1,500 trials have been instituted. The USPTO has thus far been able to meet the demands placed on its resources created by the unexpectedly heavy workload. The Patent Trial and Appeal Board (PTAB) has issued over 2,200 decisions on institution and over 450 final written decisions. In three-plus years, the PTAB has not missed one statutory or regulatory deadline. At the same time, the PTAB has reduced the backlog of ex parte appeals.

Notwithstanding the success-to-date, the USPTO is proactively looking for ways to enhance its operations for the benefit of its stakeholders and therefore is interested in exploring alternative approaches that might improve its efficiency in handling AIA post grant proceedings while being fair to both sides and continuing to provide high quality decisions. Based upon comments received from the public through public fora and formal requests, the agency is considering a pilot program to test changing how the institution phase of a post grant proceeding is handled.

Once trial is instituted, the AIA mandates that the resulting trial be conducted before a three-member panel of the PTAB. Generally, under current practice, the same panel of three APJs decides whether to institute and, if instituted, handles the remainder of the

proceeding, much like how federal district court judges handle cases through motions to dismiss, summary judgment, and trial. But a three-judge panel of the PTAB is not required under the statute prior to institution, and the USPTO believes it is prudent to explore other potentially more efficient options, especially given that the number of petitions filed may continue to increase.

To date and currently, the agency has intended to meet the resource demands on the PTAB due to both AIA post grant proceedings and ex parte appeals by hiring additional judges. Even with continued hiring, however, increases in filings and the growing number of cases may strain the PTAB's continuing ability to make timely decisions and meet statutory deadlines. Therefore, the agency wishes to explore and gain data on a potentially more efficient alternative to the current three-judge institution model. Having a single judge decide whether to institute trial in a post grant proceeding, instead of a panel of three judges, would allow more judges to be available to attend to other matters, such as reducing the ex parte appeal backlog and handling more post grant proceedings. The request for comments on the proposed pilot indicated that written comments must be received on or before October 26, 2015. See id. at 51540. In view of stakeholder requests for additional time to submit comments on the new administrative trial proceedings, the USPTO is now extending the period for public comment until November 18, 2015.

Date: \_October 29, 2015

---

Michelle K. Lee  
Under Secretary of Commerce for Intellectual Property and

Director of the United States Patent and Trademark Office  
[FR Doc. 2015-28107 Filed: 11/2/2015 8:45 am; Publication Date: 11/3/2015]