IPO Annual Meeting

Patent Trial and Appeal Board
State of the Board

David P. Ruschke
Chief Administrative Patent Judge
*Alexandria, Va. count includes judges who participate in TEAPP.
USPTO Locations

USPTO
600 Dulany Street, Alexandria, VA 22314

Randolph Square
2800 S. Randolph Street, Arlington, VA 22206

Byron Rogers Building
1961 Stout Street, 14th Floor
Denver, Colorado 80294

Elijah J. McCoy USPTO
300 River Place South, Suite 2900
Detroit, Michigan 48207

San Jose City Hall
200 E. Santa Clara Street
San Jose, CA 95113
Board Size Over Time
(Calendar Year)
PTAB Office Location Demographics
as of June 30, 2016

- Virginia Headquarters: 15%
- Midwest Regional Office: 9%
- Rocky Mountain Regional Office: 5%
- Texas Regional Office: 6%
- West Coast Regional Office: 4%
- TEAPP: 61%
Board Docket Assignments
(approximate) as of June 30, 2016

- AIA: 31%
- Ex parte Appeals: 55%
- Inter Partes Reexamination Appeals: 7%
- Management: 6%
- Interferences: 1%
Appeal Statistics
Annual PTAB Inventory – Pending Ex Parte Appeals
(excluding appeals from reexamination proceedings)

<table>
<thead>
<tr>
<th>Year</th>
<th>FY 2009</th>
<th>FY 2010</th>
<th>FY 2011</th>
<th>FY 2012</th>
<th>FY 2013</th>
<th>FY 2014</th>
<th>FY 2015</th>
<th>FY 2016 to 08/02/16</th>
</tr>
</thead>
<tbody>
<tr>
<td>Number</td>
<td>12,489</td>
<td>17,754</td>
<td>23,963</td>
<td>26,484</td>
<td>25,308</td>
<td>25,658</td>
<td>21,451</td>
<td>16,994</td>
</tr>
</tbody>
</table>
FY 2015 Monthly PTAB Inventory – Pending Ex Parte Appeals
(excluding appeals from reexamination proceedings)
FY 2016 Monthly PTAB Inventory – Pending Ex Parte Appeals
(excluding appeals from reexamination proceedings)
Weekly PTAB Inventory – Pending Ex Parte Appeals
(excluding appeals from reexamination proceedings)
FY 2016 Annual Receipts & Dispositions Summary Report
(excluding appeals from reexamination proceedings)

Averages
- Received: 710
- Disposed: 1149
Receipts & Dispositions Summary Report - July 2016
(excluding appeals from reexamination proceedings)

EOM Inventory (June 2016): 17,546
Receipts & Dispositions Summary Report - June 2016
(excluding appeals from reexamination proceedings)

EOM Inventory (May 2016): 18,253
Decisions by Type: FY 2015

- Affirmed: 57%
- Affirmed-in-Part: 13%
- Reversed: 29%
- Panel Remand: 0%
- Administrative Remand: 0%
- Dismissed: 1%

Decisions
Expedited Patent Appeal Pilot (EPAP)

- Published June 19, 2015
- *Ex parte* appeal accorded special status when another is withdrawn
- Timing Goal - 2 months to decide petition & 4 months from the date of petition grant to decide appeal
- Data through June 14, 2016: 23 petitions filed (20 granted and 3 denied); Average time to decide petition approximately 2 days
- Pilot Program ended June 20, 2016
Small Entity Pilot Program

• Published 09/16/2015
• Provides opportunity for small entities to secure expedited review
• Small entities with a single pending appeal
• Agree to review based on one claim
• No rejections under §112
• Timing Goal - 2 months to decide petition & 4 months from the date of petition grant to decide appeal
• Data through June 16, 2016: 19 petitions filed (11 granted and 8 denied); Average time to decide petition approximately 10 days
• Will run until 2,000 appeals have been accorded special status or until September 16, 2016
# Pendency of Decided Appeals

**FY 2015**

<table>
<thead>
<tr>
<th>Discipline</th>
<th>Technology Center</th>
<th>Number of Decisions</th>
<th>Pendency from PTAB Docketing to Decision (Months)</th>
</tr>
</thead>
<tbody>
<tr>
<td>Biotech</td>
<td>1600</td>
<td>534</td>
<td>33.5</td>
</tr>
<tr>
<td>Chemical</td>
<td>1700</td>
<td>1,480</td>
<td>24.9</td>
</tr>
<tr>
<td>Electrical</td>
<td>2100</td>
<td>1,934</td>
<td>31.4</td>
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<tr>
<td></td>
<td>2400</td>
<td>2,077</td>
<td>31.0</td>
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<tr>
<td></td>
<td>2600</td>
<td>1,652</td>
<td>31.0</td>
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<tr>
<td></td>
<td>2800</td>
<td>773</td>
<td>26.9</td>
</tr>
<tr>
<td>Designs</td>
<td>2900</td>
<td>29</td>
<td>30</td>
</tr>
<tr>
<td>Mech/Bus Methods</td>
<td>3600</td>
<td>2,031</td>
<td>31.7</td>
</tr>
<tr>
<td></td>
<td>3700</td>
<td>1,772</td>
<td>30.4</td>
</tr>
<tr>
<td>Reexams</td>
<td>3900</td>
<td>287</td>
<td>6.1</td>
</tr>
<tr>
<td><strong>Total Average</strong></td>
<td><strong>12,569</strong></td>
<td><strong>29.7</strong></td>
<td></td>
</tr>
</tbody>
</table>
# Pendency of Decided Appeals

## FY 2016 (October 1, 2015 – June 30, 2016)

<table>
<thead>
<tr>
<th>Discipline</th>
<th>Technology Center</th>
<th>Pendency from PTAB Docketing to Decision (Months)</th>
</tr>
</thead>
<tbody>
<tr>
<td>Biotech</td>
<td>1600</td>
<td>32.4</td>
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<tr>
<td>Chemical</td>
<td>1700</td>
<td>23.1</td>
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<tr>
<td>Electrical</td>
<td>2100</td>
<td>25.5</td>
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<td></td>
<td>2400</td>
<td>25.2</td>
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<td>Designs</td>
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<td>3700</td>
<td>28.9</td>
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<tr>
<td>Reexams</td>
<td>3900</td>
<td>7.2</td>
</tr>
<tr>
<td><strong>Total Average</strong></td>
<td><strong>3900</strong></td>
<td><strong>26.5</strong></td>
</tr>
</tbody>
</table>
Trial Statistics
## Comparison by Technology Center of FY 2015 AIA Filings v. Patent Grants

<table>
<thead>
<tr>
<th>TC</th>
<th>AIA Filings</th>
<th>AIA Filings (%)</th>
<th>Patent Grants</th>
<th>Patent Grants (%)</th>
</tr>
</thead>
<tbody>
<tr>
<td>1600</td>
<td>164</td>
<td>8.6</td>
<td>24,561</td>
<td>7.6</td>
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<tr>
<td>1700</td>
<td>88</td>
<td>4.6</td>
<td>31,286</td>
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<td>2100</td>
<td>209</td>
<td>11.0</td>
<td>24,177</td>
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<tr>
<td>2400</td>
<td>159</td>
<td>8.4</td>
<td>30,461</td>
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<tr>
<td>2600</td>
<td>402</td>
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<td>39,777</td>
<td>12.4</td>
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<td>2800</td>
<td>311</td>
<td>16.4</td>
<td>70,802</td>
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<tr>
<td>2900</td>
<td>4</td>
<td>0.2</td>
<td>25,438</td>
<td>7.9</td>
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<tr>
<td>3600</td>
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<td>13.6</td>
<td>34,972</td>
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<td>3700</td>
<td>175</td>
<td>9.2</td>
<td>40,512</td>
<td>12.6</td>
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<tr>
<td>Other</td>
<td>131</td>
<td>6.9</td>
<td>36</td>
<td>0.0</td>
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<tr>
<td>Total</td>
<td>1,902</td>
<td></td>
<td>322,022</td>
<td></td>
</tr>
</tbody>
</table>
Narrative:
This pie chart shows the total number of cumulative AIA petitions filed to date broken out by trial type (i.e., IPR, CBM, and PGR).

*Data current as of: 6/30/2016*
Narrative:
This bar graph depicts the number of AIA petitions filed each fiscal year, with each bar showing the filings for that fiscal year by trial type (i.e., IPR, CBM, and PGR).

*Data current as of: 6/30/2016*
Narrative:
These line graphs display the number of IPR, CBM, and PGR petitions filed each month and the total number of all petitions filed each month from the effective date of the AIA trial provisions.

*Data current as of: 6/30/2016*
Narrative:
This pie chart shows the total number of AIA petitions filed in the current fiscal year to date as well as the number and percentage of these petitions broken down by technology.

*Data current as of: 6/30/2016*
Narrative:
These three sets of bar graphs show the number of patent owner preliminary responses filed and waived/not filed each fiscal year in IPR, CBM, and PGR proceedings.

*Data current as of: 6/30/2016*
Narrative:
This chart shows the percentage of petitions instituted of all decisions on petition, by technology area.

*Data current as of: 6/30/2016*
Narrative:
These three sets of bar graphs show the number of decisions on institution by fiscal year broken out by trials instituted (including joinders) and trials denied in IPR, CBM, and PGR proceedings. A trial that is instituted in part is counted as an institution in these bar graphs.

*Data current as of: 6/30/2016*
Narrative:
These three sets of bar graphs show settlements in AIA trials broken down by settlements that occurred prior to institution and settlements that occurred after institution in IPR, CBM, and PGR proceedings.

*Data current as of: 6/30/2016*
Narrative:
This graph shows a stepping stone visual depicting the outcomes for all IPR petitions filed to-date that have reached a final disposition.

Disputation of IPR Petitions Completed to Date*

*Data current as of: 6/30/2016
Disposition of CBM Petitions Completed to Date*

Narrative:
This graph shows a stepping stone visual depicting the outcomes for all CBM petitions filed to-date that have reached a final disposition.

*Data current as of: 6/30/2016
Narrative:
This visual contains four cylinders. The first cylinder shows the total number of claims available to be challenged in the IPR petitions filed. The second cylinder shows the number of claims actually challenged and not challenged. The third cylinder shows the number of claims on which trial was instituted and not instituted. The fourth cylinder shows the total number claims found unpatentable in a final written decision, the number of claims canceled or disclaimed by patent owner after institution, the number of claims remaining patentable (not subject to a final written decision), and the number of claims found patentable by the PTAB.

Note: “Completed” petitions include terminations (before or after a decision on institution) due to settlement, request for adverse judgment, or dismissal; final written decisions; and decisions denying institution.

*Data current as of: 6/30/2016*
Narrative:
This visual contains four cylinders. The first cylinder shows the total number of claims available to be challenged in the CBM petitions filed. The second cylinder shows the number of claims actually challenged and not challenged. The third cylinder shows the number of claims on which trial was instituted and not instituted. The fourth cylinder shows the total number claims found unpatentable in a final written decision, the number of claims canceled or disclaimed by patent owner after institution, the number of claims remaining patentable (not subject to a final written decision), and the number of claims found patentable by the PTAB.

Note: “Completed” petitions include terminations (before or after a decision on institution) due to settlement, request for adverse judgment, or dismissal; final written decisions; and decisions denying institution.

*Data current as of: 6/30/2016
Narrative:
This chart shows claim outcomes for instituted trials, by technology area.

Note: Claims involved in instituted trials that settle or are dismissed are not depicted. Accordingly, a bar may not add up to 100%.

*Data current as of: 6/30/2016*
MOTIONS TO AMEND STUDY
How Many Motions to Amend Are Filed?

- Completed Trials w/o MTA: 1347 (59%)
- Completed Trials with MTA: 192 (8%)
- Pending Trials with MTA: 34 (2%)
- Pending Trials w/o MTA: 709 (31%)

Data current as of: 4/30/2016
Subsequent Developments of the Motions to Amend

- Moot b/c Claims Patentable
- MTA Withdrawn or Case Settled, Req. Adv. J, or Dismissed
- MTA Solely to Cancel Claims
- MTA Substitute Claims Decided

192 Trials with MTA

- 118 (62%) MTA Substitute Claims Decided
- 41 (21%) MTA Withdrawn or Case Settled, Req. Adv. J, or Dismissed
- 17 (9%) MTA Solely to Cancel Claims
- 16 (8%) Moot b/c Claims Patentable

Data current as of: 4/30/2016
How Many Motions to Amend Substituting Claims Are Granted?

118 MTAs with Substitute Claims Decided

- 112 (95%) Granted
- 2 (2%) Granted in Part
- 4 (3%) Denied

Data current as of: 4/30/2016
### Reasons Provided for Denying Entry of Substitute Claims*

<table>
<thead>
<tr>
<th>Reason Given</th>
<th># of Cases</th>
<th>Pct</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Reasons Based on 35 U.S.C.:</strong></td>
<td></td>
<td></td>
</tr>
<tr>
<td>101 Non-Statutory Subject Matter</td>
<td>7</td>
<td>6%</td>
</tr>
<tr>
<td>112(a) Written Description</td>
<td>9</td>
<td>8%</td>
</tr>
<tr>
<td>112(b) Definiteness</td>
<td>1</td>
<td>1%</td>
</tr>
<tr>
<td>102/103 Anticipated / Obvious Over Art of Record</td>
<td>41</td>
<td>35%</td>
</tr>
<tr>
<td>316(d)(3) Claims Enlarge Scope of Patent</td>
<td>6</td>
<td>5%</td>
</tr>
<tr>
<td>316(d)(1)(B) Unreasonable # Substitute Claims</td>
<td>3</td>
<td>3%</td>
</tr>
<tr>
<td>Multiple Statutory Reasons Given**</td>
<td>27</td>
<td>23%</td>
</tr>
<tr>
<td><strong>Reasons Based on Procedure:</strong></td>
<td></td>
<td></td>
</tr>
<tr>
<td>Cases Where Only Procedural Reasons Given</td>
<td>22</td>
<td>19%</td>
</tr>
<tr>
<td><strong>Totals:</strong></td>
<td>116</td>
<td>100%</td>
</tr>
</tbody>
</table>

* 116 MTAs requesting entry of substitute claims have been denied in whole or in part.

** Of the "Multiple Statutory Reasons Given" trials, 24 of the 27 trials included "Anticipated/Obvious" as a reason.
Data for FY2016 are from October 1, 2015–April 30, 2016.
LESSONS LEARNED
Petition Filing

1. Petition Filed
2. PO Preliminary Response
3. Decision on Petition
4. PO Response & Motion to Amend Claims
5. Petitioner Reply to PO Response & Opposition to Amendment
6. PO Reply to Opposition to Amendment
7. Oral Hearing
8. Final Written Decision

- 3 months
- No more than 3 months
- 3 months
- 3 months
- 1 month
- Hearing Set on Request
- PO Discovery Period
- Petitioner Discovery Period
- PO Discovery Period
- Period for Observations & Motions to Exclude Evidence

No more than 12 months
Lessons Learned: Petitions

• Conclusions need to be supported by:
  – Sound legal analysis; and
  – Citations to evidentiary record

• Analysis needs to appear in petition itself (no incorporation by reference from declaration)

• Better to provide detailed analysis for limited number of challenges than identify large number of challenges for which little analysis is provided

• See Wowza Media v. Adobe, IPR2013-00054 (Paper 12)(denying petition)
Lessons Learned: Claim Charts

• Use standard two-column format. See FAQ D13

• Claim charts are not sufficient by themselves; they must be explained.

• Claim charts should contain pinpoint references to the supporting evidence. See FAQ D12
Lessons Learned: Claim Construction

• Claim constructions should be supported by citations to the record that justify the proffered construction and analysis provided as to why the claim construction is the broadest reasonable construction. 37 C.F.R. § 42.104(b)(3).

• An example of a failure to provide a sufficient claim construction occurs where claim terms are open to interpretation, but party merely restates claim construction standard to be used, e.g.,
  
  – A claim subject to inter partes review receives the “broadest reasonable construction in light of the specification of the patent in which it appears.” 37 C.F.R. § 42.100(b)
Lessons Learned: Experts

• Tutorials are helpful especially for complex technologies

• Expert testimony without underlying facts or data is entitled to little or no weight. 37 C.F.R. § 42.65(a). See Monsanto Co. v. Pioneer Hi-Breed Int’l, IPR2013-00022, Paper 43 (denying petition)

• Avoid merely “expertizing” your claim charts
Lessons Learned: Obviousness

• Question of obviousness is resolved based on underlying factual determinations identified in *Graham*
  – Includes addressing differences between claimed subject matter and the prior art

• Address the specific teachings of the art relied upon rather than rely upon what others have said (e.g., examiners)
  – Parties are to address whether there is a reason to combine art (*KSR*) and avoid conclusory statements

• See *Veeam Software v. Symantec*, IPR2013-00145 (Paper 12); *Heart Failure Tech. v. CardioKinetix*, IPR2013-00183 (Paper 12) (denying petition)
Patent Owner Preliminary Response

Petition Filed

PO Preliminary Response

Decision on Petition

PO Response & Motion to Amend Claims

Petitioner Reply to PO Response & Opposition to Amendment

PO Reply to Opposition to Amendment

Oral Hearing

Final Written Decision

3 months

No more than 3 months

3 months

3 months

1 month

Hearing Set on Request

PO Discovery Period

Petitioner Discovery Period

PO Discovery Period

Period for Observations & Motions to Exclude Evidence

No more than 12 months
Lessons Learned: Patent Owner Preliminary Response

• Clearly identify procedural and substantive reasons to deny petition, e.g.,
  – Statutory bar under 35 U.S.C. § 315 or § 325?
  – Failure to identify real parties-in-interest/privies?
  – Weaknesses in Petitioner’s case?
    • Petitioner’s claim construction is improper
    • Cited references are not, in fact, prior art
    • Cited references lack material element(s)

• Cannot present new testimonial evidence
  – BUT can cite existing testimony and reports
Decision on Petition

1. Petition Filed
2. PO Preliminary Response
3. Decision on Petition
4. PO Response & Motion to Amend Claims
5. Petitioner Reply to PO Response & Opposition to Amendment
6. PO Reply to Opposition to Amendment
7. Oral Hearing
8. Final Written Decision

- PO Discovery Period
- Petitioner Discovery Period
- PO Discovery Period
- Period for Observations & Motions to Exclude Evidence

No more than 12 months
Joinder

- Petition Filed
- PO Preliminary Response
- Decision on Petition
- PO Response & Motion to Amend Claims
- Petitioner Reply to PO Response & Opposition to Amendment
- PO Reply to Opposition to Amendment
- Oral Hearing
- Final Written Decision

- 3 months
- No more than 3 months
- 3 months
- 3 months
- 1 month
- Hearing Set on Request

- PO Discovery Period
- Petitioner Discovery Period
- PO Discovery Period
- Period for Observations & Motions to Exclude Evidence

No more than 12 months
Lessons Learned: Joinder

• Must be a like review proceeding
• Requires filing a motion and petition
• File within one month of institution
• Impact on schedule important

• *Dell v. Network-1*, IPR2013-00385 (Paper 17)(joinder granted)
• *Sony v. Network-1*, IPR2013-00386 (Paper 16)(joinder denied)
Discovery Period

- Petition Filed
- PO Preliminary Response
- Decision on Petition
- PO Response & Motion to Amend Claims
- Petitioner Reply to PO Response & Opposition to Amendment
- PO Reply to Opposition to Amendment
- Oral Hearing
- Final Written Decision

Timeline:
- PO Discovery Period: 3 months
- Petitioner Discovery Period: 3 months
- PO Discovery Period: 1 month
- Hearing Set on Request
- Period for Observations & Motions to Exclude Evidence: No more than 12 months
Types of Discovery


• Routine Discovery
  – Cited exhibits
  – Cross-examination of witnesses
  – Inconsistent information

• Additional Discovery
Lessons Learned: Additional Discovery

- Five factor test used in evaluating additional discovery requests (IPR2012-00001, Garmin v. Cuozzo (Paper 26)):
  1. More than a possibility and mere allegation must exist that something useful might be found.
  2. Is the request merely seeking early identification of opponent’s litigation position?
  3. Can party requesting discovery generate the information?
  4. Interrogatory questions must be clear.
  5. Are requests overly burdensome to answer?

- Requests for specific documents with a sufficient showing of relevance are more likely to be granted whereas requests for general classes of documents are typically denied
Lessons Learned: Depositions

• Federal Rules of Evidence apply

• Objections to admissibility waived

• Follow the Testimony Guidelines (Practice Guide Appendix D)
  – No “speaking” objections or coaching
  – Instructions not to answer are limited

• Foreign language/country. See Ariosa v. Isis, IPR2013-00022 (Papers 55, 67)
Motions-to-Amend

• Board conference required

• Normally one-for-one claim substitution

• Must narrow scope

• Need to show patentable distinction

• Clearly state the contingency of substitution

• See *Idle Free v. Bergstrom*, IPR2012-00027 (Paper 26) and *MasterImage 3D, Inc. v. RealD Inc.*, IPR2015-00040 (Paper 42)
Motions-to-Amend

  – Clarified earlier *Idle Free* decision
  – Patent Owner must show patentable distinction over prior art of record (in the proceeding; in the prosecution history; in any other proceeding involving the same patent)
  – Duty of candor and good faith in the Office may lead to additional prior art made of record by the Patent Owner when moving to amend
Motions-to-Amend

• Unlike during examination, PTAB does not “examine” amended claims during an AIA proceeding
  – No search is conducted
  – No claim rejections made

• Burden is on the movant (i.e., the patent owner) to show the patentable distinction of the proposed amended claim
Oral Hearing

1. Petition Filed
2. PO Preliminary Response
3. Decision on Petition
4. PO Response & Motion to Amend Claims
5. Petitioner Reply to PO Response & Opposition to Amendment
6. PO Reply to Opposition to Amendment
7. Oral Hearing
8. Final Written Decision

- PO Discovery Period
- Petitioner Discovery Period
- PO Discovery Period
- Period for Observations & Motions to Exclude Evidence

No more than 12 months
Lessons Learned: Oral Hearing

• Attorneys should bear in mind that:
  – Panel may have more than three judges;
  – Some panel members may participate by video; and
  – All questions from the judges are based on the written record, including arguments made in the parties’ briefs and expert testimony filed in support of the parties’ briefs

• Attorneys should be prepared to answer questions about the entire record, including claim construction, motion to amend, priority, secondary consideration and swearing-behind issues
  – Have sufficient familiarity with the record to answer questions effectively; and
  – Be ready to deviate from a prepared presentation to answer questions
Lessons Learned: Oral Hearing

• Attorneys should focus on the best argument and not try to cover every argument made during the course of the trial.

• No new evidence or argument is permitted.

• Demonstrative exhibits should serve merely as visual aids.
  – Pages of the record, with appropriate highlighting (e.g., highlighted figures), are effective and could be very helpful.
  – When referring to slides, identify the number of the slide rather than say “this slide” or “next slide.”
Settlement and Termination

1. Petition Filed
2. PO Preliminary Response
3. Decision on Petition
4. PO Response & Motion to Amend Claims
5. Petitioner Reply to PO Response & Opposition to Amendment
6. PO Reply to Opposition to Amendment
7. Oral Hearing
8. Final Written Decision

Duration:
- 3 months
- No more than 3 months
- 1 month
- Hearing Set on Request
- Period for Observations & Motions to Exclude Evidence
- No more than 12 months
Lessons Learned: Settlement

• Parties may file a joint motion to terminate a proceeding on the basis of settlement
  – Preauthorization is required; and
  – May be filed at any stage of the proceeding, even before institution
    • If the proceeding is terminated before institution, petitioner may file a request for refund of post-institution fee

• Board has discretion to proceed to final written decision, especially at an advanced stage when all briefing is complete

• Board is more likely to grant early motions to terminate
Lessons Learned: Settlement

• When there are multiple petitioners, proceeding may be terminated with respect to one petitioner when that petitioner settles with patent owner

• Joint motion to terminate must be accompanied by a true copy of the settlement agreement; a redacted version is not permitted

• Parties may request that the settlement agreement be treated as business confidential information
  – See § 42.74(c) and FAQ G2
AIA Rulemaking
AIA Rulemaking

In response to stakeholder requests, the Office moved forward with two rule packages:

1. A first final rule package that encompassed less difficult “quick-fixes” based upon both stakeholder comments and internal PTAB suggestions, including more pages for briefing for motions to amend and for petitioner’s reply brief; and


New Rules - Summary

• Claim Construction for Expiring Patents
• Patent Owner Preliminary Response
• Oral Hearings
• Word Count
• Rule 11-Type Certification
New Rules – Claim Construction

• A party may request district court-type (Phillips) construction
• Must certify patent will expire within 18 mos. from entry of Notice of Filing Date
• Motion and certification must be filed within 30 days from filing of Petition
New Rules – Preliminary Response

• Eliminates prohibition of new testimonial evidence

• Petitioner may seek leave to file a reply
  – Requires showing of “good cause”
New Rules – Preliminary Response

“The Board’s decision will take into account a patent owner preliminary response where such a response is filed, including any testimonial evidence, but a genuine issue of material fact created by such testimonial evidence will be viewed in the light most favorable to the petitioner solely for purposes of deciding whether to institute an inter partes [post-grant] review.”
New Rules – Oral Hearing

Demonstrative exhibits must be served at least seven business days before the oral argument and filed no later than the time of the oral argument.
New Rules – Word Count

- Petitions for IPRs: 14,000 words.
- Petitions for PGR/CBM: 18,700 words.
- Petitions requesting DER: 14,000 words.
- Preliminary Response and Response: same as Petition.
- Reply to Patent Owner Responses: 5,600 words
New Rules – Word Count

• New Exclusions in Petitions:
  – Mandatory notices
  – Certificate of word count

• Other Exclusions:
  – Table of contents
  – Table of authorities
  – Certificate of service
  – Appendix of exhibits or claim listings
New Rules – Rule 11-Type Certification

• Signature Requirements
  – Incorporate 37 C.F.R. 11.18(a)
  – Board may expunge unsigned submissions

• Representations
  – Incorporate 37 C.F.R. 11.18(b)(2)

• Sanctions
  – 21-day cure provision
New Rules – Signature Requirement

“Every petition, response, written motion, and other paper filed in a proceeding must comply with the signature requirements set forth in § 11.18(a) of this chapter.”
New Rules – Signature Requirement

“For all documents filed in the Office in patent, trademark, and other non-patent matters, and all documents filed with a hearing officer in a disciplinary proceeding, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Office must bear a signature, personally signed or inserted by such practitioner . . . . “

37 C.F.R. 11.18(a)
New Rules - Representations

“By presenting to the Board a petition, response, written motion, or other paper—whether by signing, filing, submitting, or later advocating it—an attorney, registered practitioner, or unrepresented party attests to compliance with the certification requirements under § 11.18(b)(2) of this chapter.”
“(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances,

(i) The paper is not being presented for any *improper purpose*, such as to harass someone or to cause unnecessary delay or needless increase in the cost of any proceeding before the Office;

(ii) The other *legal contentions therein are warranted* by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(iii) The *allegations and other factual contentions have evidentiary support* or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(iv) The *denials of factual contentions are warranted* on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief. “

37 C.F.R. 11.18(b)(2)(emphasis added)
New Rules – Sanctions Motions

• Requires a separate motion
• Motion must describe specific conduct
• Board must authorize filing
• Moving party must serve motion 21 days before seeking authorization
• No motion if opposing party “cures”
New Rules – Sanctions

• Board *sua sponte* may order attorney or party to show cause
• Sanctions must be consistent with § 42.12
• Sanctions order must describe conduct and explain basis
PTAB Precedential Decisions
# PTAB Designations for Decisions

<table>
<thead>
<tr>
<th>PTAB Opinion Designation</th>
<th>Description of Designation</th>
</tr>
</thead>
<tbody>
<tr>
<td>Precedential</td>
<td>A nominated decision may be considered for designation as precedential for any reason, but particular emphasis will be placed on opinions resolving conflicts or addressing novel questions. A precedential opinion is <strong>binding authority</strong> in subsequent matters involving similar facts or issues.</td>
</tr>
<tr>
<td>Informative</td>
<td>The Chief Judge may designate any nominated opinion as informative for any reason (unless it is designated as precedential). Opinions designated as informative provide the Board’s general consensus on recurring issues and guidance to examiners, appellants, patent owners, or petitioners in areas where parties routinely misapply the law. An informative opinion is <strong>not binding authority</strong>.</td>
</tr>
<tr>
<td>Representative</td>
<td>The Chief Judge may designate any nominated opinion as representative (unless it is designated as precedential). Representative opinions typically provide a representative sample of outcomes on a matter and the designation is used to bring the opinions to the attention of the public. A representative opinion is <strong>not binding authority</strong>.</td>
</tr>
<tr>
<td>Routine</td>
<td>Every Board opinion is, by default, a routine opinion until it is designated as precedential or informative. A routine opinion is <strong>not binding authority</strong>.</td>
</tr>
</tbody>
</table>
PTAB Precedential Decisions Designation Process

- Board member or public may nominate any opinion for consideration.
- Chief Judge considers nominated opinions and may circulate opinion to full Board for vote.
- Director must concur with favorable vote.
- Opinion is designated as precedential and is binding on future panels.
Recent PTAB Precedential Decisions

- In May 2016, the Board designated the following five decisions as precedential:
  - **Garmin Int’l v. Cuozzo Speed Techs LLC**, IPR2012-00001, Paper 26 (Mar. 5, 2013) - This order discusses the factors considered in evaluating motions for additional discovery in IPR proceedings.
  - **Bloomberg, Inc. v. Markets-Alert Pty, Ltd.**, CBM2013-00005, Paper 32 (May 29, 2013) – This order discusses the factors considered in evaluating motions for additional discovery in CBM proceedings.
  - **Oracle Corp. v. Click-to-Call Techs**, LP, IPR2013-00312, Paper 26 (October 30, 2013) (precedential only as to Section III.A.) - This decision pertains to interpretation of “served with a complaint” for purposes of triggering the one-year time bar set forth in 35 U.S.C. § 315(b).
  - **MasterImage 3D, Inc. v. RealD Inc.**, IPR2015-00040, Paper 42 (July 15, 2015) – This order provides guidance on patent owner’s burden to show entitlement to substitute claims.

- Copies of these precedential decisions can be found on the [USPTO's website](https://www.uspto.gov).
PTAB Important Notes and Events
Important Notes and Events

• The Patent Trial and Appeal Board End to End (PTAB E2E) is currently available for users to file, access and search IPR, CBM and PGR AIA Review cases. Derivations will still be filed and viewed in PRPS.
  – Patent Trial and Appeal Board End to End (PTAB E2E)
  – Patent Review Processing System (PRPS)
Thank You
Reference Materials
# Major Differences between IPR, PGR, and CBM

<table>
<thead>
<tr>
<th>Inter Partes Review (IPR)</th>
<th>Petitioner</th>
<th>Estoppel</th>
<th>Standard</th>
<th>Basis</th>
</tr>
</thead>
<tbody>
<tr>
<td>Post Grant Review (PGR)</td>
<td>• Person who is not the patent owner and has not previously filed a civil action challenging the validity of a claim of the patent • Must identify all real parties in interest</td>
<td>• Raised or reasonably could have raised • Applied to subsequent USPTO/district court/ITC action</td>
<td>More likely than not OR Novel or unsettled legal question important to other patents/applications</td>
<td>101, 102, 103, 112, double patenting but not best mode</td>
</tr>
<tr>
<td>Inter Partes Review (IPR)</td>
<td>• Person who is not the patent owner, has not previously filed a civil action challenging the validity of a claim of the patent, and has not been served with a complaint alleging infringement of the patent more than 1 year prior (exception for joinder) • Must identify all real parties in interest</td>
<td>• Raised or reasonably could have raised • Applied to subsequent USPTO/district court/ITC action</td>
<td>Reasonable likelihood</td>
<td>102 and 103 based on patents and printed publications</td>
</tr>
<tr>
<td>Covered Business Method (CBM)</td>
<td>• Must be sued or charged with infringement • Financial product or service • Excludes technological inventions • Must identify all real parties in interest</td>
<td>• Office—raised or reasonably could have raised • Court-raised</td>
<td>Same as PGR</td>
<td>Same as PGR (some 102 differences)</td>
</tr>
</tbody>
</table>
## Major Differences between IPR, PGR, and CBM

<table>
<thead>
<tr>
<th>Proceeding</th>
<th>Available</th>
<th>Applicable</th>
<th>Timing</th>
</tr>
</thead>
<tbody>
<tr>
<td>Post Grant Review (PGR)</td>
<td>From patent grant to 9 months after patent grant or reissue</td>
<td>Patent issued under first-inventor-to-file</td>
<td>Must be completed within 12 months from institution, with 6 months good cause exception possible</td>
</tr>
<tr>
<td>Inter Partes Review (IPR)</td>
<td>For first-inventor-to-file, from the later of: (i) 9 months after patent grant or reissue; or (ii) the date of termination of any post grant review of the patent. For first-to-invent, available after grant or reissue (technical amendment)</td>
<td>Patent issued under first-to-invent or first-inventor-to-file</td>
<td>Must be completed within 12 months from institution, with 6 months good cause exception possible</td>
</tr>
<tr>
<td>Covered Business Method (CBM)</td>
<td>Available 9/16/12 (for first-inventor-to-file only after PGR not available or completed)</td>
<td>Patents issued under first-to-invent and first-inventor-to-file</td>
<td>Must be completed within 12 months from institution, with 6 months good cause exception possible</td>
</tr>
</tbody>
</table>
PTAB Resources

Information concerning the **Board** can be found at:
http://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board-0

Information concerning **Appeals** can be found at:

Information concerning **Trials** can be found at:

Information concerning **PTAB Statistics** can be found at:

Information concerning **Board Decisions** can be found at:
http://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/decisions
## PTAB Contact Information

<table>
<thead>
<tr>
<th>Matter</th>
<th>PTAB Contact: 571-272-9797</th>
</tr>
</thead>
<tbody>
<tr>
<td>Notice of Appeal, Appeal Brief Review/Notices of Non-Compliance (in all appeals, including all reexamination proceedings), and PTAB Docketing and Before-Decision Matters</td>
<td>Steven Bartlett</td>
</tr>
<tr>
<td>Oral Argument before the PTAB</td>
<td>Quita Gould</td>
</tr>
<tr>
<td>Board Post-Decision</td>
<td>Amalia Santiago</td>
</tr>
<tr>
<td>Board Statistics</td>
<td>Frances Han</td>
</tr>
<tr>
<td>Reexam/Reissue Appeals</td>
<td>Lynn Kryza</td>
</tr>
<tr>
<td>Status Inquiries</td>
<td>PTAB Receptionist</td>
</tr>
<tr>
<td>Interferences</td>
<td>Interference Paralegal</td>
</tr>
<tr>
<td>Appeal Rehearing</td>
<td>Jefferson Taylor</td>
</tr>
</tbody>
</table>

Phone: 571-272-9797 (General, Trial Division, Interference Assistance Line)
Phone: 571-272-7822 (Trial Division, Trials, and PRPS Assistance Line)

FAX 1: 571-273-9797 (All Oral Hearing Notice Responses)
FAX 2: 571-273-0043 (Interference Trial Division ONLY)
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For delivery via Fedex, UPS, etc.:
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Patent Trial and Appeal Board
Madison Building (East)
600 Dulany Street
Alexandria, Virginia 22313
Subscription Center
https://public.govdelivery.com/accounts/USPTO/subscriber/new

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Questions?