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# Fact v. Myth

## Questions and Answers with the Chief Judge regarding USPTO PTAB IPR Proceedings

David P. Ruschke  
Chief Administrative Patent Judge  
July 23, 2018

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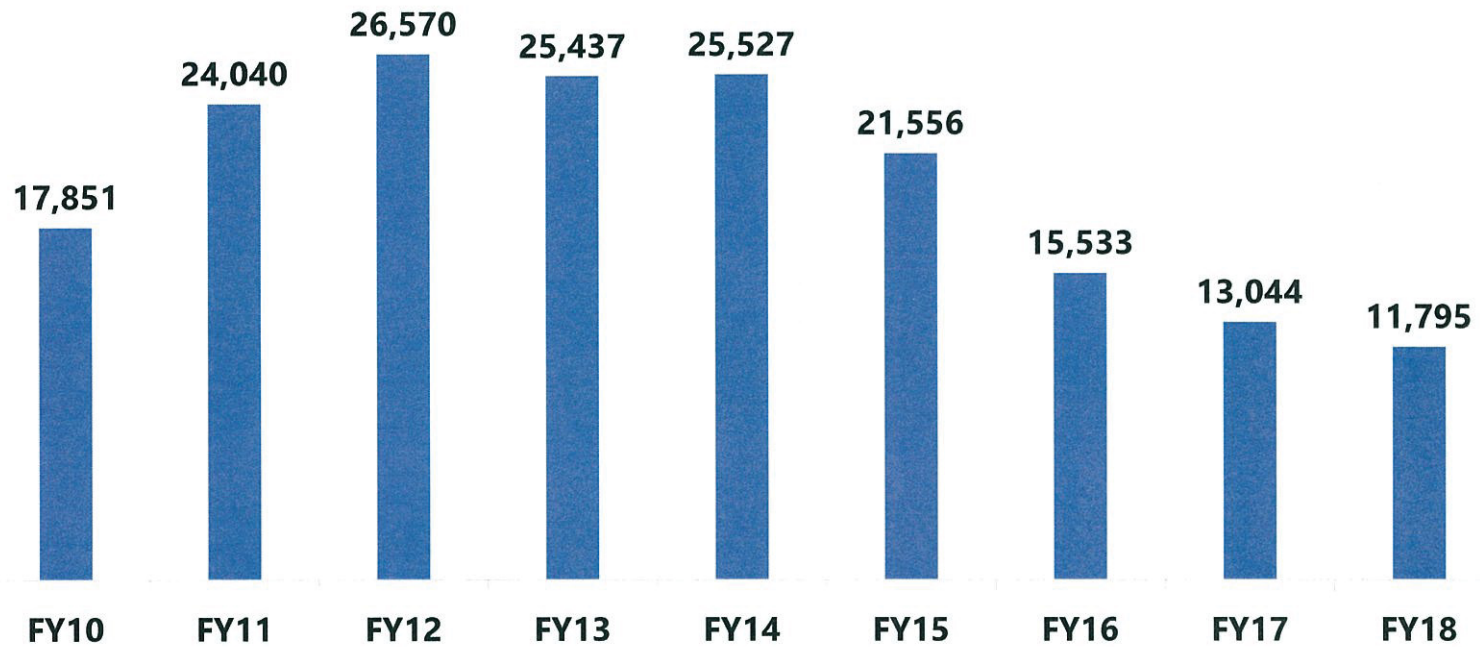
# *Ex Parte* Appeal Inventory

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# Pending Appeals

(FY10 to FY18: 9/30/10 to 6/30/18)



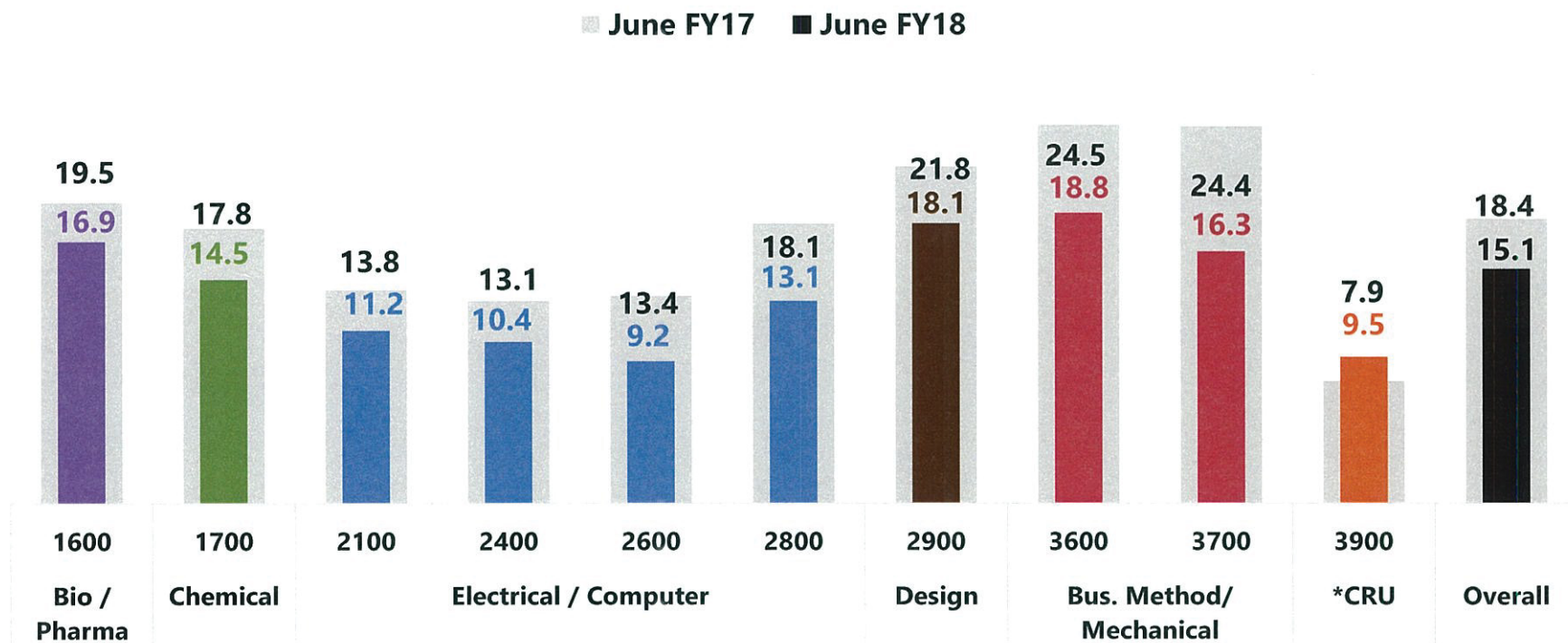
# ***Ex Parte* Appeal Pendency**

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# Pendency of Decided Appeals in FY17 and FY18

(Pendency of appeals decided in June 2017 compared to June 2018 in months)



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.

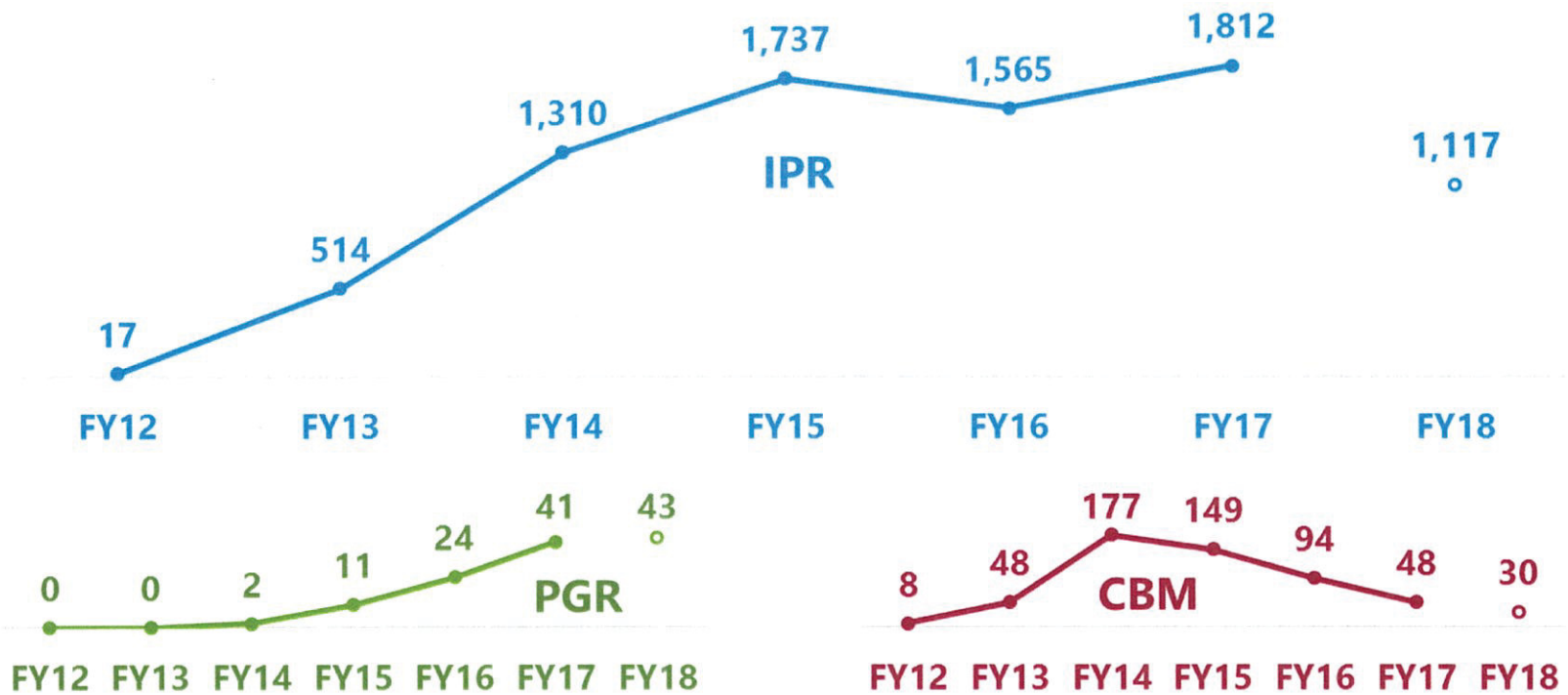
# Trends in AIA Petition Filing

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# Petitions Filed by Trial Type and Fiscal Year

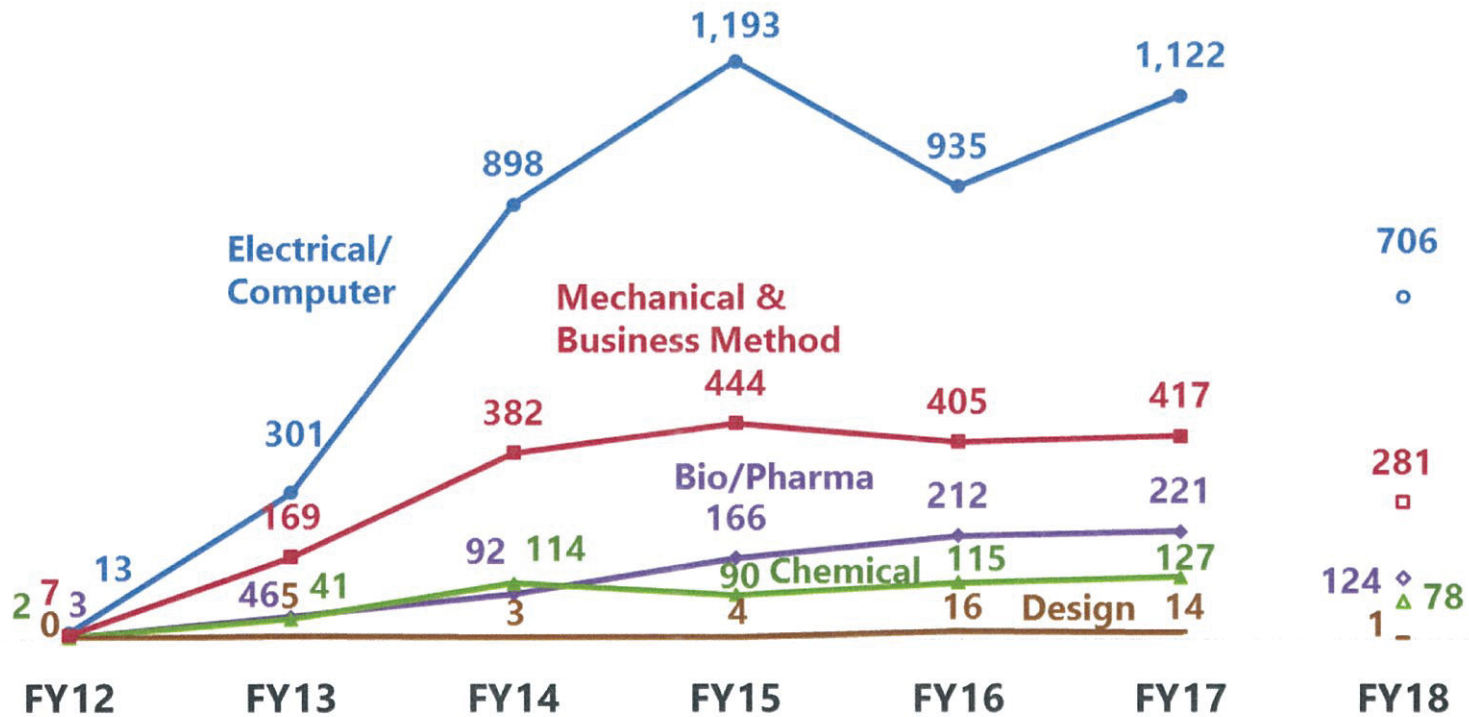
(All Time: 9/16/12 to 6/30/18)





# Petitions Filed by Technology and Fiscal Year

(All Time: 9/16/12 to 6/30/18)



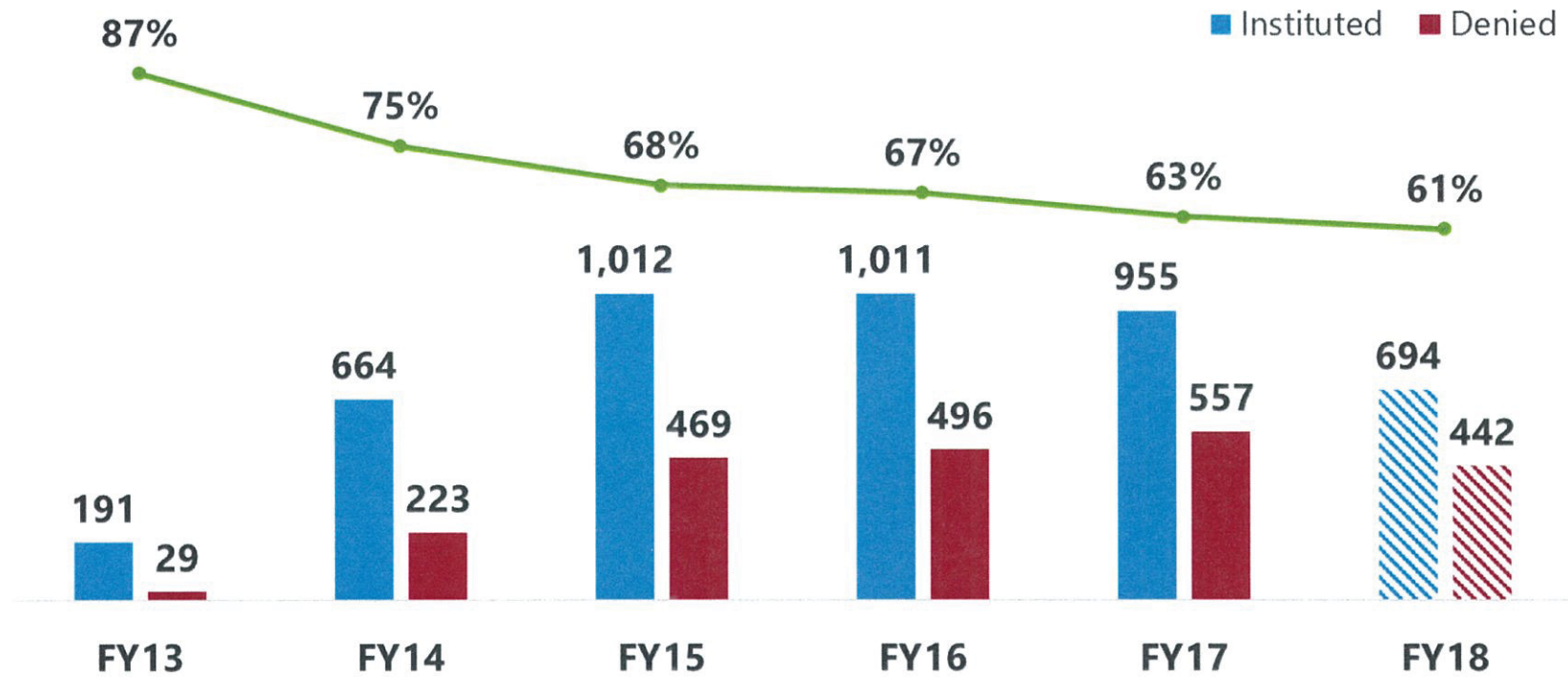
# AIA Trial Institution Rate

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# Institution Rates

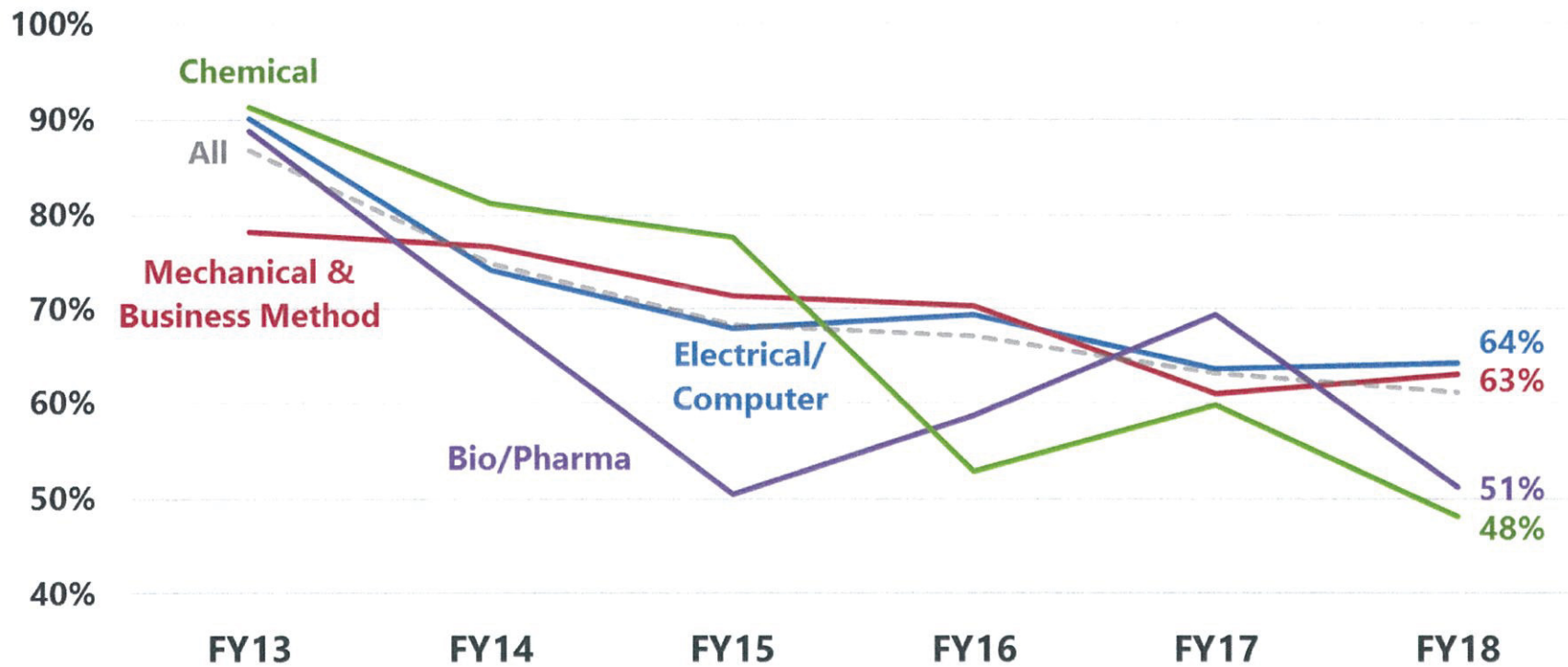
(FY13 to FY18: 10/1/12 to 6/30/18)



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

(FY13 to FY18: 10/1/12 to 6/30/18)



Institution rate is calculated by dividing petitions instituted by decisions on institution in each fiscal year, excluding requests for rehearing. The Design technology is not displayed due to insufficient numbers of decisions on institution.

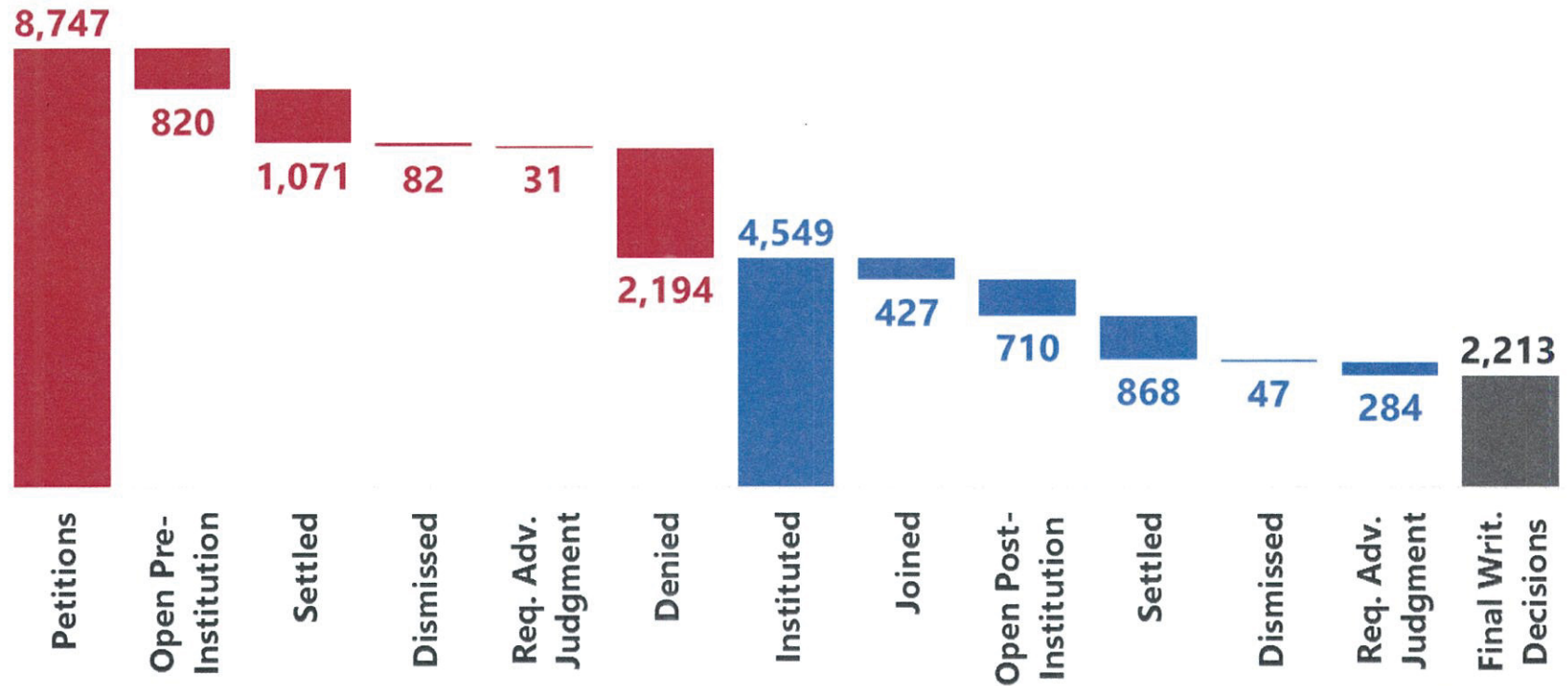
# AIA Trial Outcomes

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# Status of Petitions

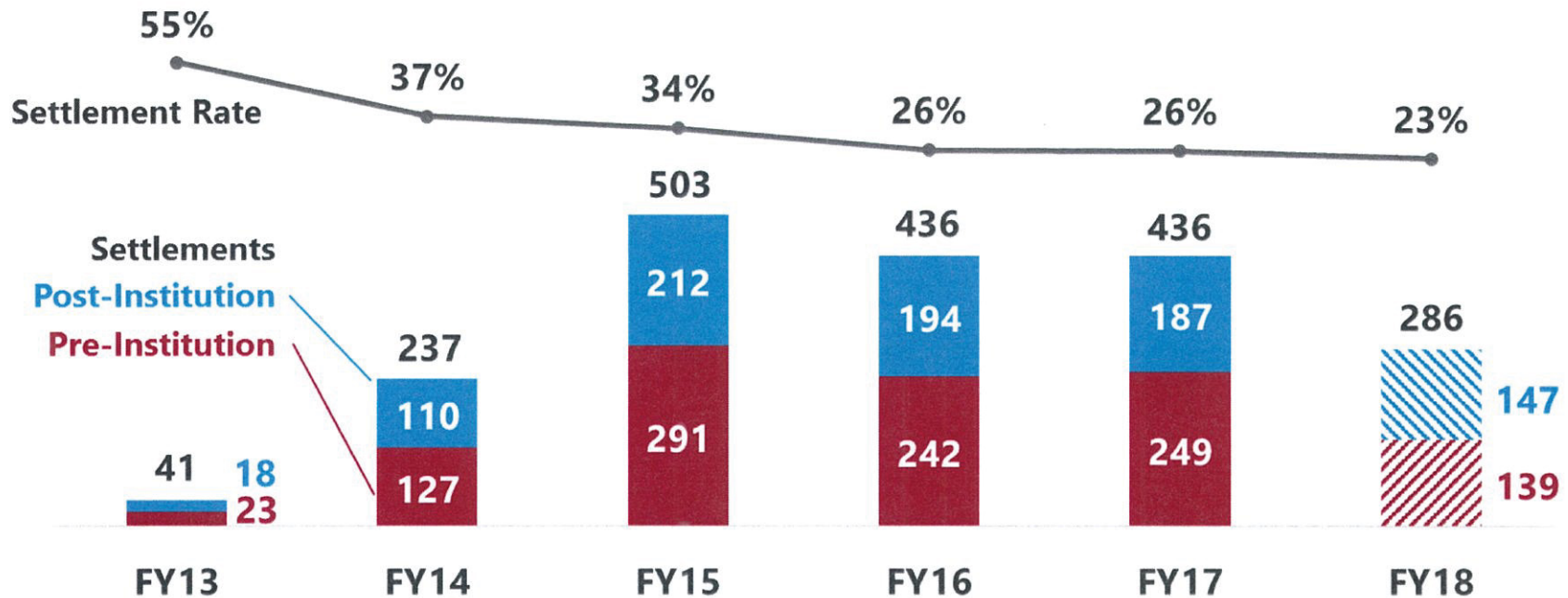
(All Time: 9/16/12 to 6/30/18)



These figures reflect the latest status of each petition. The outcomes of decisions on institution responsive to requests for rehearing are incorporated. Once joined to a base case, a petition remains in the Joined category regardless of subsequent outcomes.

# Settlements by Fiscal Year

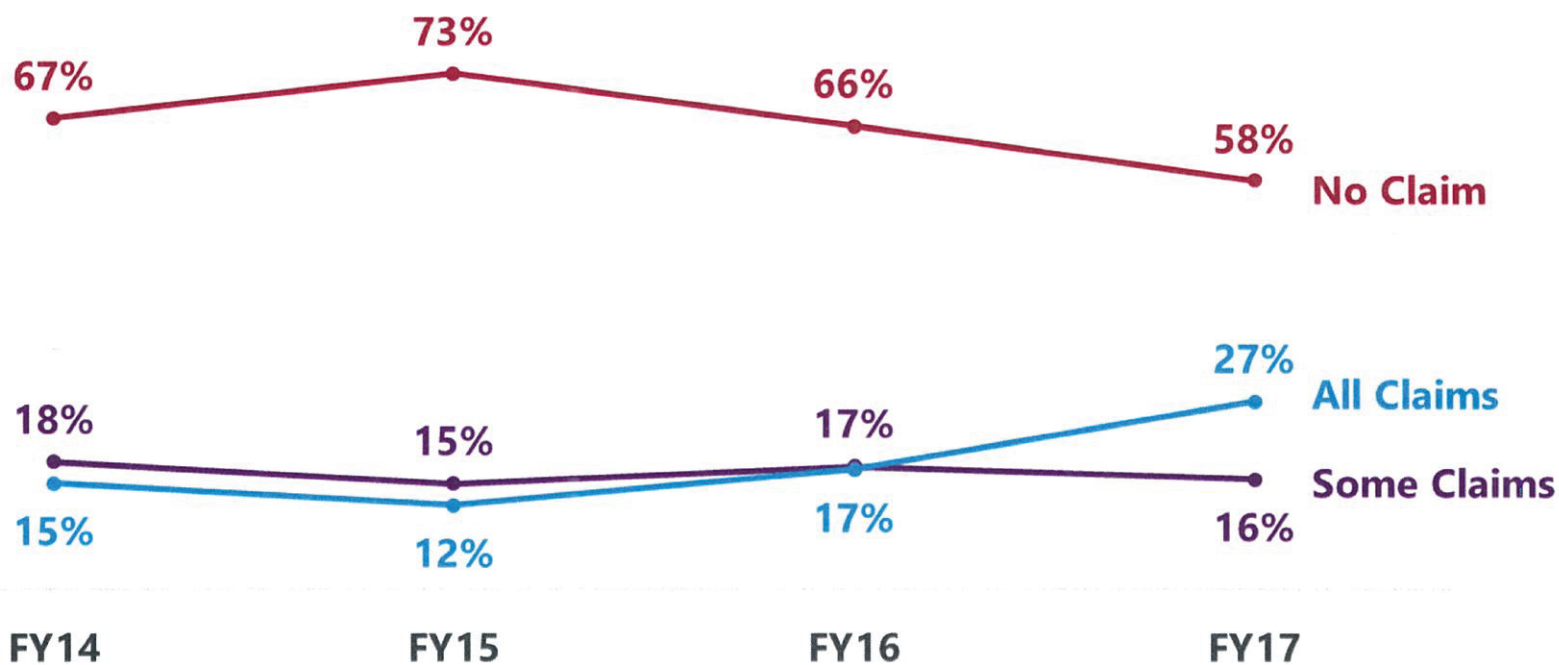
(FY13 to FY18: 10/1/12 to 6/30/18)



Settlement rate is calculated by dividing total settlements by terminated proceedings in each fiscal year (i.e., settled, dismissed, terminated with a request for adverse judgment, denied institution, and final written decision), excluding joined cases.

# Final Written Decisions

Percent of Decisions by Instituted Claims Remaining Patentable by Fiscal Year



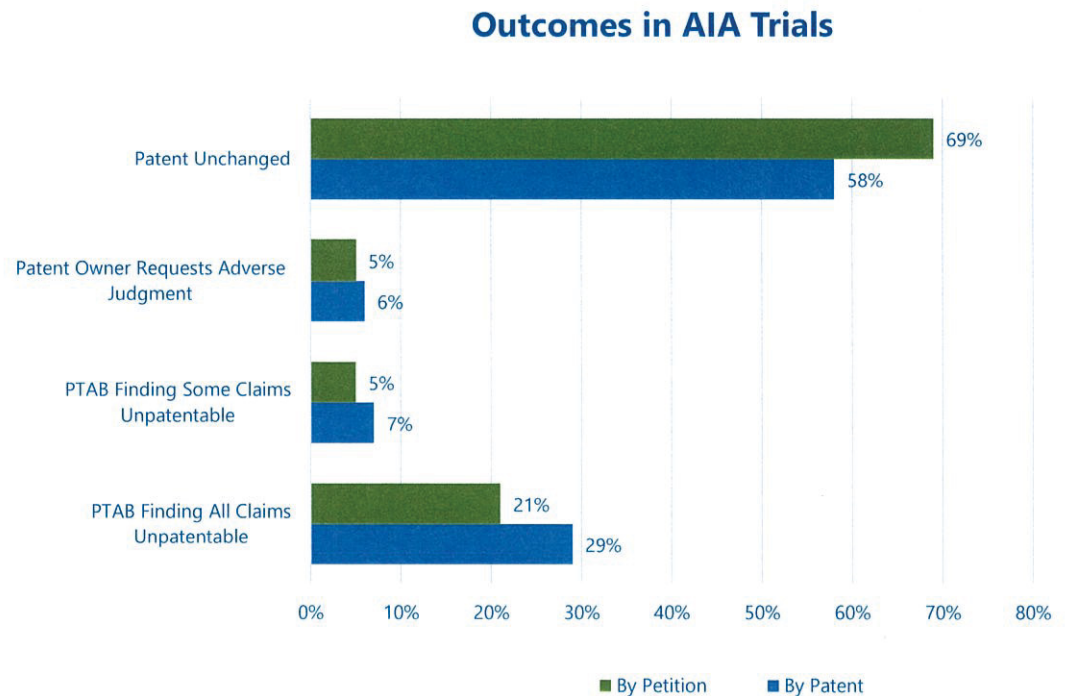
Joined cases are excluded.

\*Data Through 9/30/17



## Ultimate Outcome for Patents in AIA Trials

- 69% of all petitions result in a patent being unchanged; 58% of patents are unchanged at the end of one or more AIA proceedings
- “By patent” accounts for whether any one petition against particular patent results in any unpatentable claims
- “By petition” accounts for whether a particular petition results in any unpatentable claims



\*Data Through 6/30/17

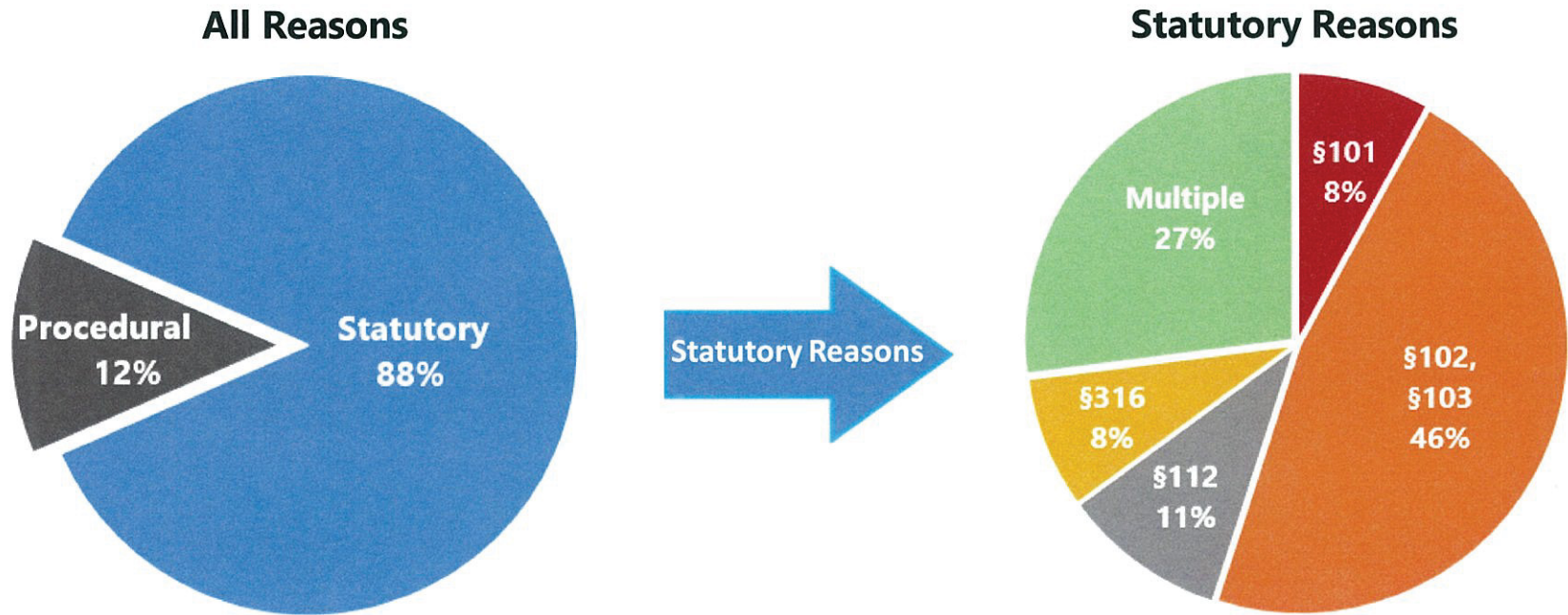
# Motions to Amend

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# Reasons for Denying Entry of Substitute Claims

(FY13 to FY18: 10/1/2012-3/31/2018)

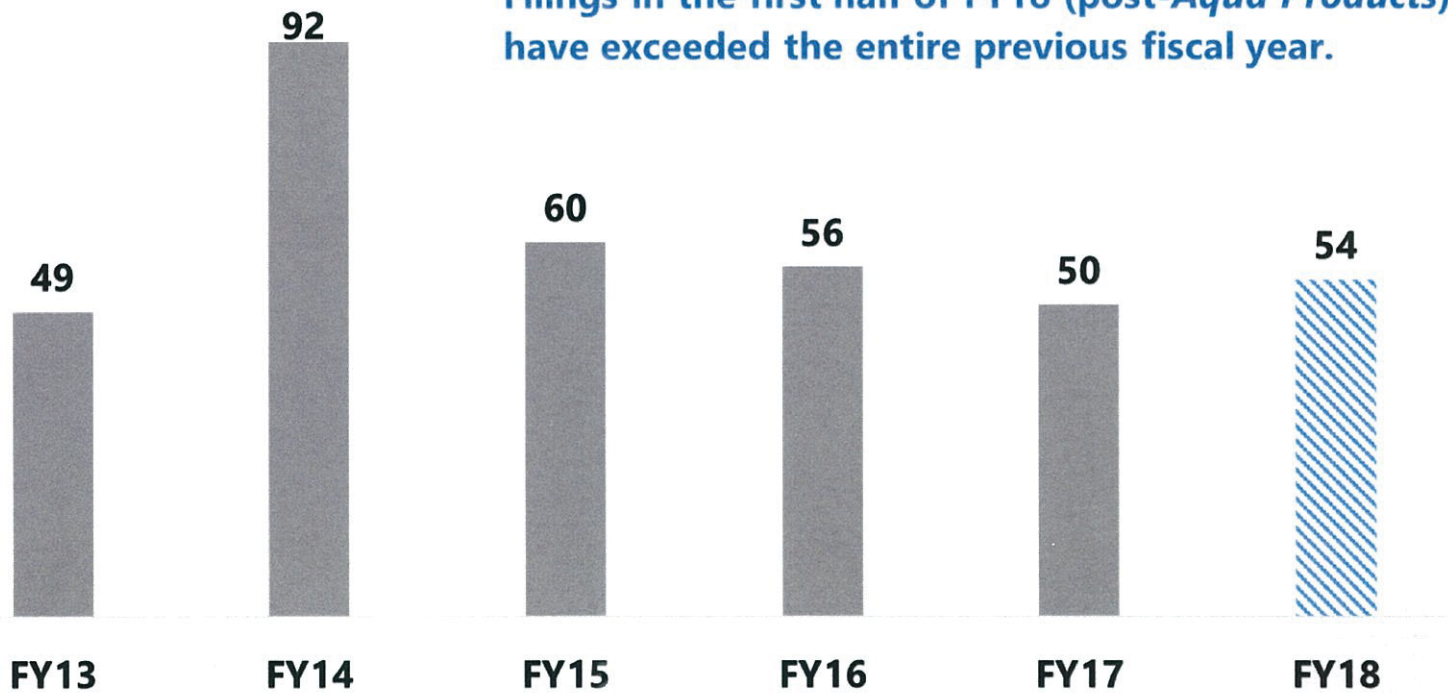


\* All but one of the cases in which multiple statutory reasons were provided for denying entry of substitute claims included §§ 102, 103 and/or 112 as a reason for denial.

# Motions to Amend Filed by Fiscal Year

(FY13 to FY18: 10/1/12 to 3/31/18)

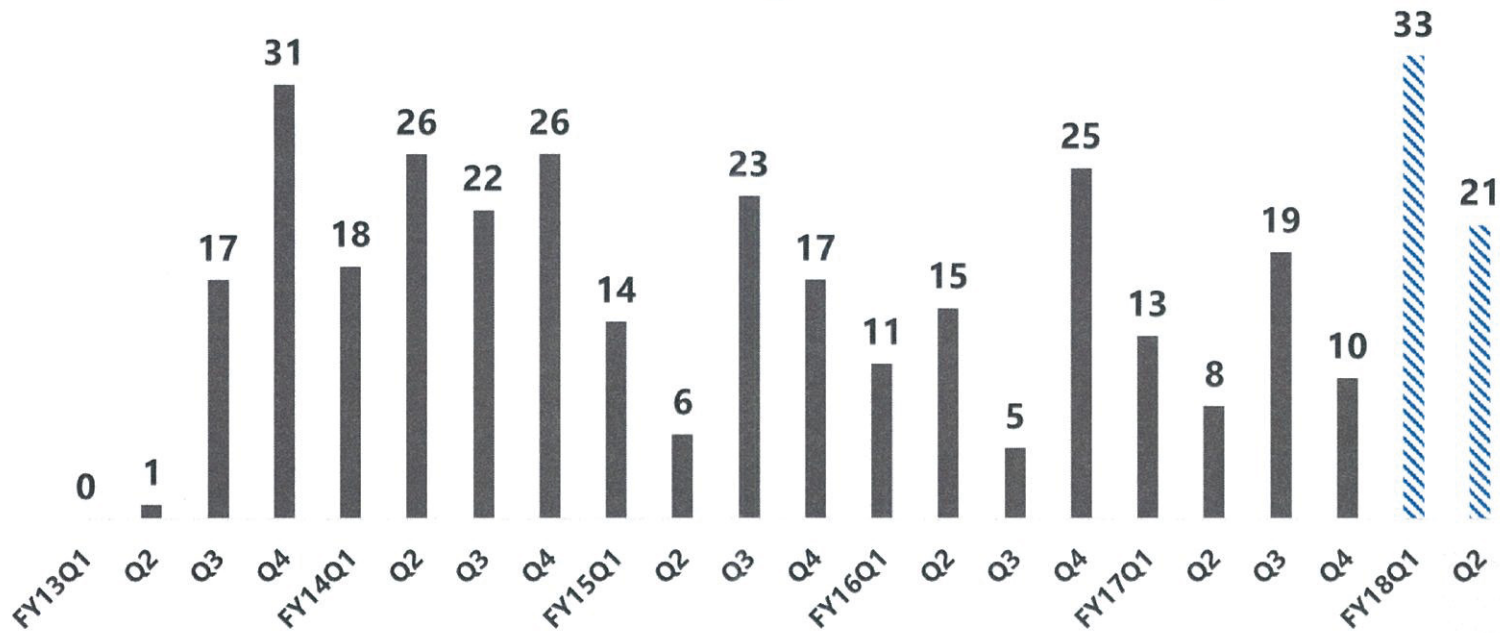
Filings in the first half of FY18 (post-*Aqua Products*) have exceeded the entire previous fiscal year.



# Motions to Amend Filed by Fiscal Quarter

(FY13 to FY18: 10/1/12 to 3/31/18)

Filings in the first half of 2018 (post-Aqua Products) exceeded any other two consecutive quarters.



# ***Western Digital v. SPEX Techs.***

***IPR2018-00082 -00084 (PTAB Apr. 25, 2018) (Paper 13) (Informative)***

- Order provides guidance and information regarding statutory and regulatory requirements for a motion to amend in light of Federal Circuit case law (e.g., *Aqua Products*), including on:
  - contingent motions to amend;
  - burden of persuasion that the Office applies when considering the patentability of substitute claims;
  - requirement that a patent owner propose a reasonable number of substitute claims;
  - requirement that the amendment respond to a ground of unpatentability involved in the trial;
  - scope of the proposed substitute claims;
  - requirement that a patent owner provide a claim listing with its motion to amend;
  - default page limits that apply to motion to amend briefing; and
  - duty of candor

# Number of Petitions and Petitioners per Patent

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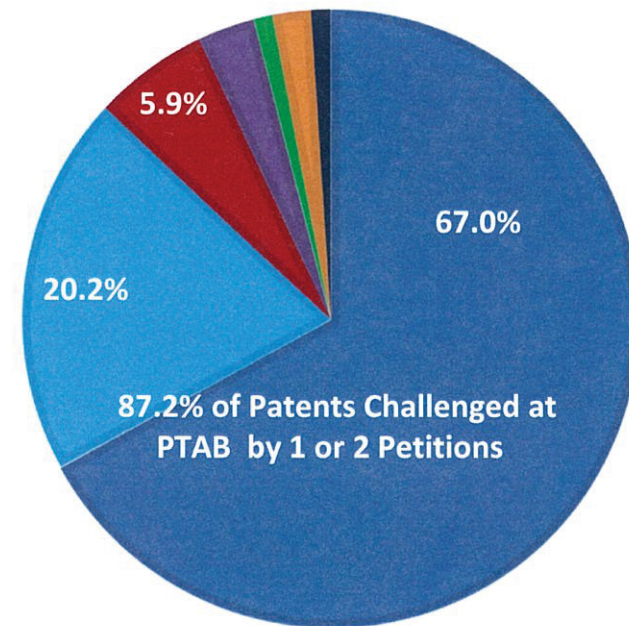
## Multiple Petition Study

### *Petitions Per Patent*

No. of Petitions per Patent	Patents	% of Total
1	2932	67.0%
2	885	20.2%
3	256	5.9%
4	142	3.2%
5	54	1.2%
6	52	1.2%
7 or more	55	1.3%
Total	4376	100%

### NUMBER OF PETITIONS PER PATENT

■ 1 ■ 2 ■ 3 ■ 4 ■ 5 ■ 6 ■ 7 or more



Data Through 6/30/17



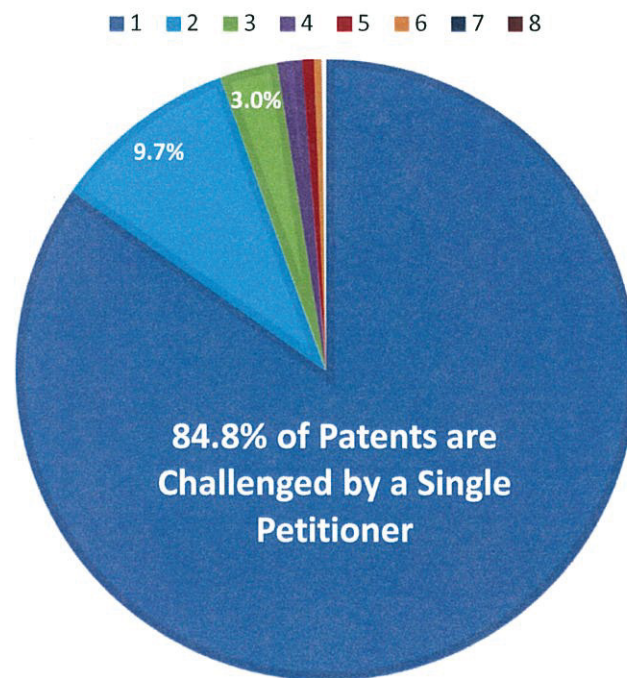
## Multiple Petition Study

### *Petitioners Per Patent*

No. of Petitioners vs. Patent	No. of Patents	% Patents
1	3711	84.8%
2	424	9.7%
3	132	3.0%
4	59	1.3%
5	28	0.6%
6	17	0.4%
7	2	<0.1%
8	3	<0.1%
Total	4376	100%

Data Through 6/30/17  
 Percentages may not add to 100% due to rounding

### NUMBER OF PETITIONERS PER PATENT



# Timing of AIA Petition Filing

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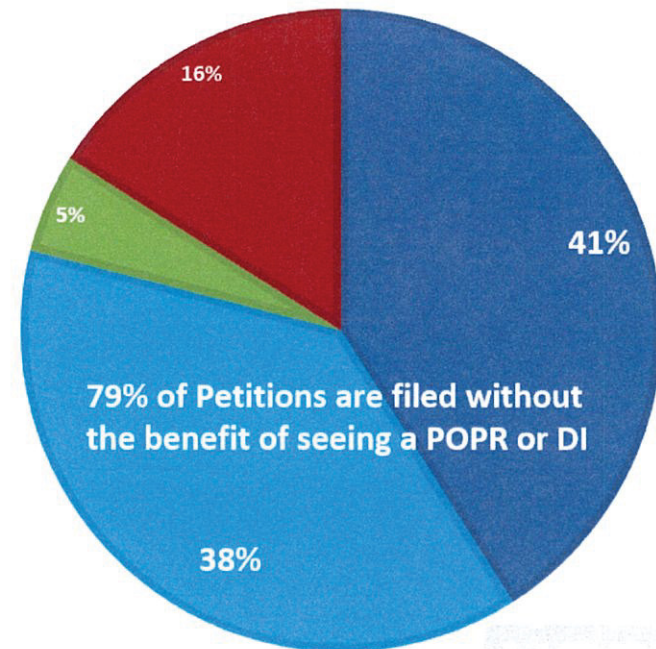
# Multiple Petition Study

## When *Petitions* are Filed

Timing of Petition	No. of Petitions	% of Petitions
Single Petition Filed	2932	41%
Multiple Petitions Filed On or Near Same Day	2685	38%
Multiple Petitions Filed After POPR, But Before DI	381	5%
Multiple Petitions Filed After DI	1170	16%
Total	7168	100%

### WHEN PETITIONS ARE FILED

- Single Petition vs. Patent
- Multiple Petition Filed On or Near Same Day
- Multiple Petition Filed after POPR
- Multiple Petition Filed After DI



Data Through 6/30/17

# Multiple Petition Study

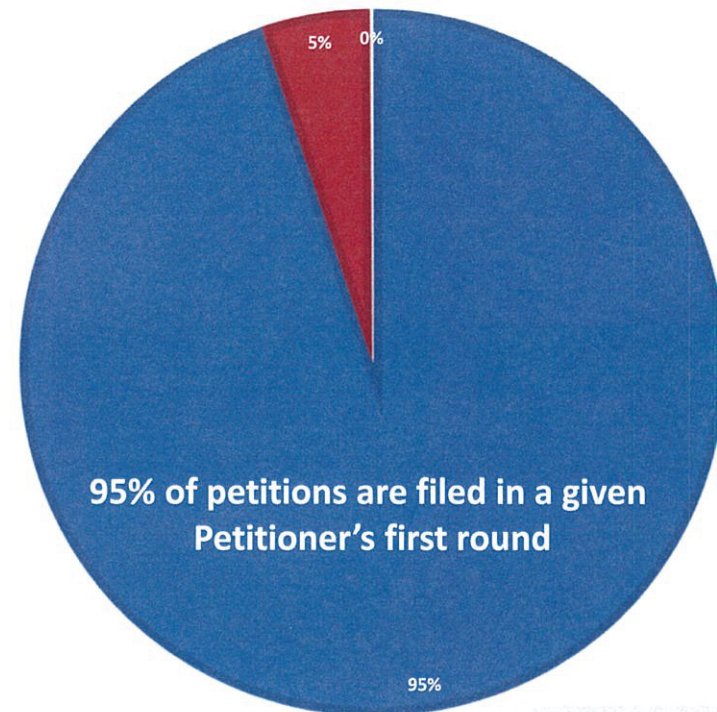
## Rounds of *Petitions*

- *95% of petitions are filed in a given petitioner's first round*
- *A "round" is all petitions filed before receiving a DI on one of those petitions*

Rounds of Petitions	No. of Petitions	% of Petitions
First Round of Petitions	6481	95%
Second Round of Petitions	369	5%
Third or Fourth Round of Petitions	7	<0.1%
Total	6857*	

PERCENT OF PETITIONS

■ One Round ■ Two Rounds ■ 3+ Rounds



Data Through 6/30/17

\*Not included are 311 Petitions filed where a request to join as a party to another proceeding was granted

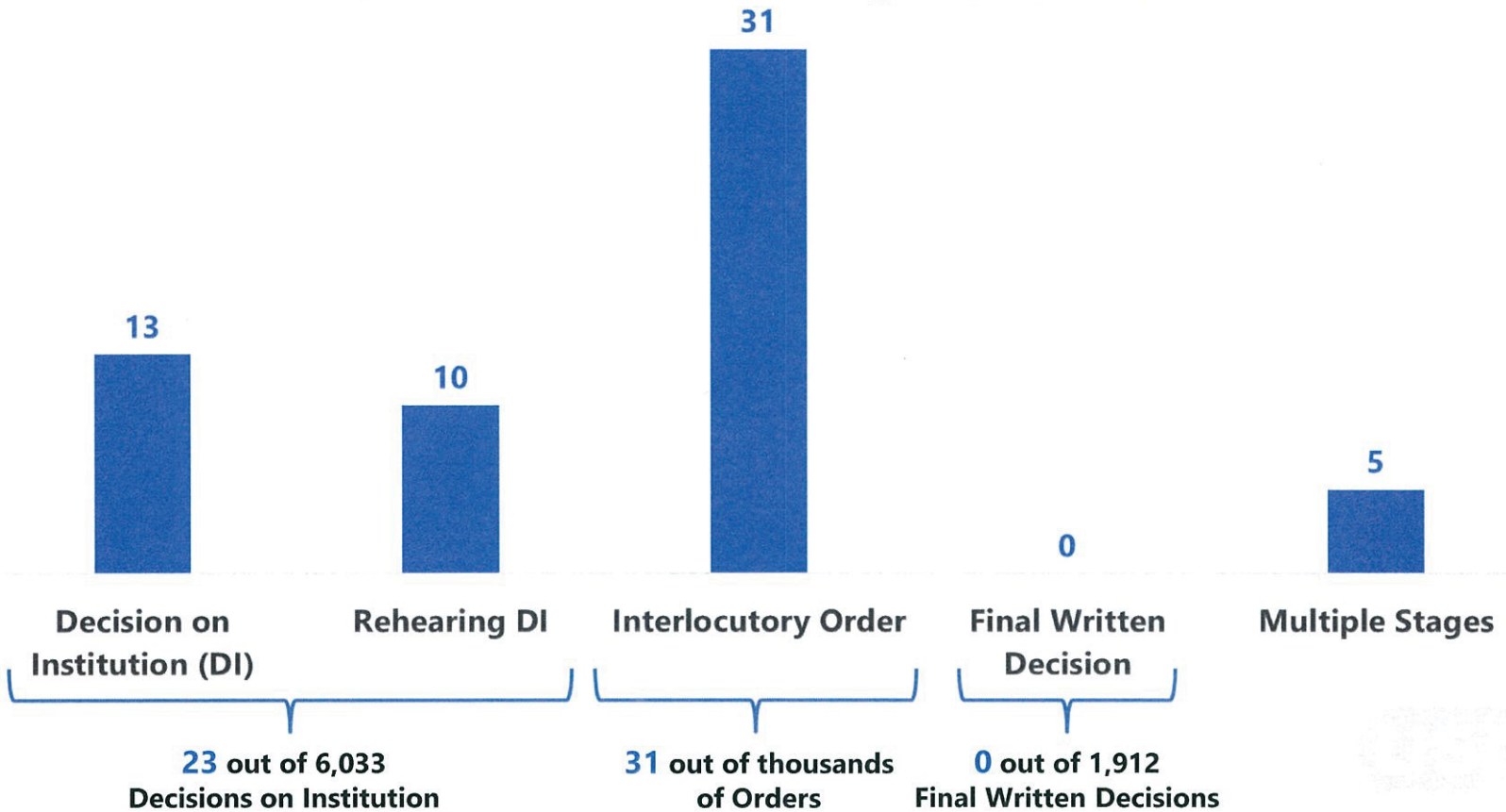
# Expanded Panels

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# Expanded Panels Are Rare

(7930 Total Petitions through 12/31/2017)



# Orange Book-listed Patents

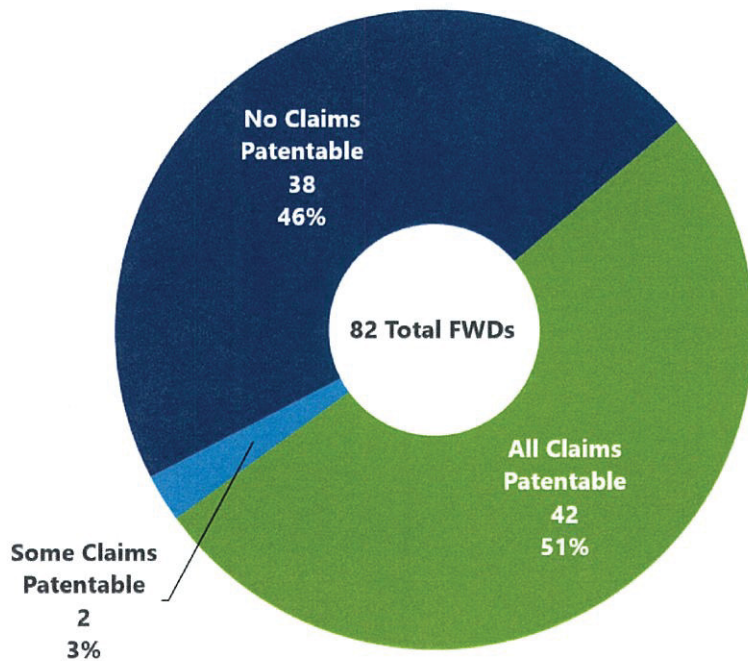
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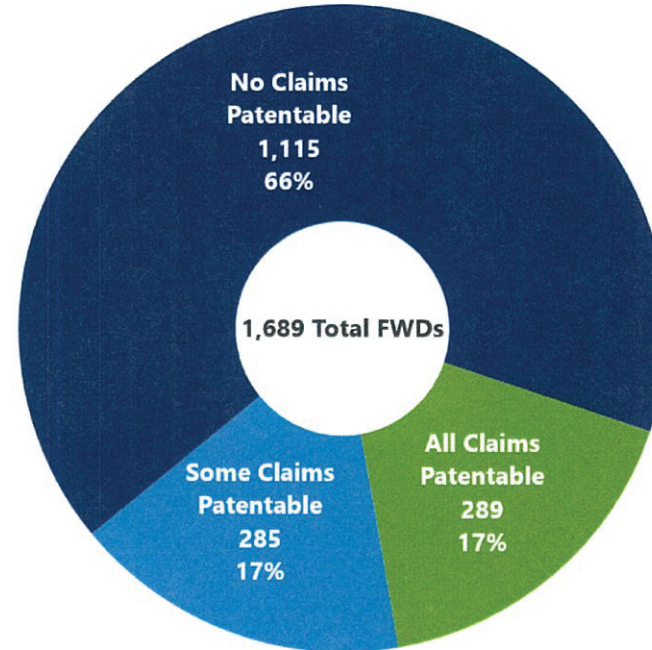
# Status of Instituted Claims in Final Written Decisions

(As of End FY17: 9/16/12 to 9/30/17)

## Orange Book-listed Patents

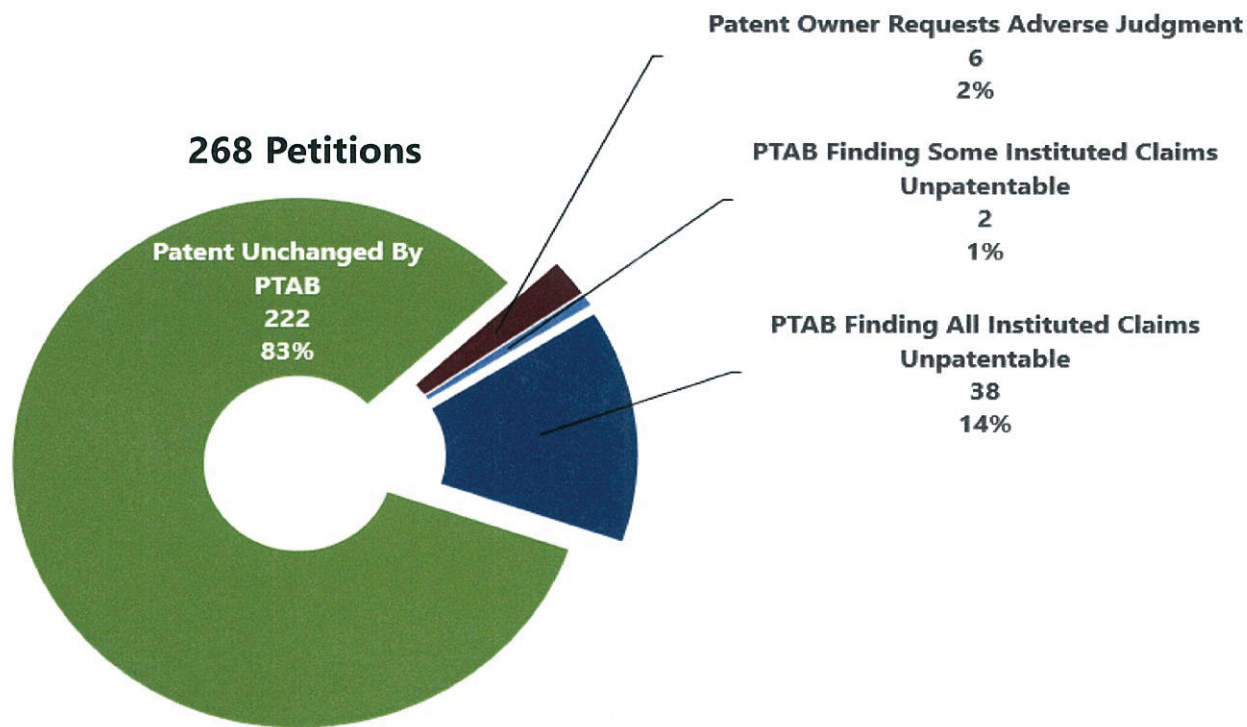


## All Other Technologies (including misc. bio-pharma)





# Outcomes for Petitions Challenging Orange Book-listed Patents (as of End FY17: 9/16/12 to 9/30/17)



The patent being unchanged by PTAB includes final written decisions with all claims patentable, settlements, dismissals, and petitions denied institution.

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# SAS Guidance

## Guidance on the impact of SAS on AIA trial proceedings

**Release date: April 26, 2018**

On April 24, 2018, the U.S. Supreme Court issued *SAS Institute Inc. v. Iancu*, 2018 WL 1914661, (U.S. Apr. 24, 2018). In light of this decision, the Patent Trial and Appeal Board (PTAB) will proceed in the following fashion at this time. The PTAB will continue to assess the impact of this decision on its operations and will provide further guidance in the future if appropriate.

As required by the decision, the PTAB will institute as to all claims or none. At this time, if the PTAB institutes a trial, the PTAB will institute on all challenges raised in the petition.

For pending trials in which a panel has instituted trial on all of the challenges raised in the petition, the panel will continue with the proceeding in the normal course. By contrast, for pending trials in which a panel has instituted trial only on some of the challenges raised in the petition (as opposed to all challenges raised in the petition), the panel may issue an order supplementing the institution decision to institute on all challenges raised in the petition.

Additionally, for pending trials in which a panel enters an order supplementing the institution decision pursuant to this notice, the panel may take further action to manage the trial proceeding, including, for example, permitting additional time, briefing, discovery, and/or oral argument, depending on various circumstances and the stage of the proceeding. For example, if the panel has instituted a trial and the case is near the end of the time allotted for filing the Patent Owner Response, the panel may extend the due date for the Patent Owner Response to enable the patent owner to address any additional challenges added to the proceeding.

# ***Implementation of SAS***

- PTAB will institute on all challenges raised in the petition or not institute at all (i.e., binary decision)
- If panel has issued a decision on institution (DI) instituting on all challenges, panel will proceed as normal
- If panel has issued a DI denying institution on all challenges, no additional action

# ***Implementation of SAS***

- If panel has instituted on only some challenges raised in the petition, panel may at this time:
  - Issue order instituting on all challenges;
  - Receive joint request filed by the parties to terminate as to certain challenges

# **Notice of Proposed Rulemaking (NPRM) for Claim Construction**

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# ***Claim Construction NPRM***

***83 Fed. Reg. 21,221 (May 9, 2018)***

Proposed 42.100(b), 42.200(b), 42.300(b):

“In an [AIA trial] proceeding, a claim of a patent, or a claim proposed in a motion to amend under § 42.121, shall be construed using the same claim construction standard that would be used to construe such claim in a civil action to invalidate a patent under 35 U.S.C. 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.

Any prior claim construction determination concerning a term of the claim in a civil action, or a proceeding before the International Trade Commission, that is timely made of record in the inter partes review proceeding will be considered.”

# ***Claim Construction NPRM***

***83 Fed. Reg. 21,221 (May 9, 2018)***

- USPTO intends that any proposed rule changes adopted in a final rule would be applied to all pending AIA trial proceedings
- Public comment period closed on July 9
- Federal Register Notice:
- <https://www.federalregister.gov/documents/2018/05/09/2018-09821/changes-to-the-claim-construction-standard-for-interpreting-claims-in-trial-proceedings-before-the>





# Questions and Comments

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Chief Administrative Patent Judge

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