

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# **Patent Trial and Appeal Board Boardside Chat: SOP2-related forms, Motion to Amend (MTA) pilot program preliminary results, and Multiple Petitions Study Update**

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Jessica Kaiser, Lead Administrative Patent Judge

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December 10, 2020

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# Agenda

- SOP2-related forms
  - PTAB anonymous decision nomination form
  - POP request amicus form
- MTA pilot program preliminary results
- Multiple Petitions Study Update

# Question/comment submission

- To send in questions or comments during the webinar, please email:
  - [PTABBoardsideChat@uspto.gov](mailto:PTABBoardsideChat@uspto.gov)

**SOP2-related forms**

# Standard operating procedure 2 (SOP2), revision 10

- Created a Precedential Opinion Panel (POP) to rehear matters of exceptional importance involving policy or procedure in pending trials and appeals, resulting in binding agency authority unless otherwise designated;
- Procedure for nomination, review, and designation of Board decisions, other than POP decisions, as precedential or informative; and
- Procedure for de-designating precedential and informative decisions.

# **PTAB anonymous decision nomination form**

# PTAB anonymous decision nomination form

- Published September 24, 2020.
- Accessible on the PTAB's [Precedential and informative decisions](#) page of the USPTO website.
- Allows any member of the public to nominate any PTAB decision for precedential or informative designation.

# PTAB anonymous decision nomination form

## PTAB Decision Nomination

This submission form allows individuals to anonymously nominate any routine decision of the Board for designation as precedential or informative. Please provide as much identifying information as possible for any nominated decision, and set forth a brief description of the reasons for the requested designation. Individuals nominating a decision may also enter their name and email address.

**\*items are mandatory**

\*Type of nomination:

\*Case number:   
(e.g., IPR2020-01234; 2008-001183)

\*Case name:

\*Paper number:   
(Enabled for case number begin with IPR, PGR, or CBM)

\*Brief reasons for nomination:   
(Limited to 750 characters)

Name (optional):

E-mail Address (optional):



# Access the PTAB anonymous decision nomination form

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## Patent Trial and Appeal Board

The Patent Trial and Appeal Board (PTAB) conducts trials, including inter partes, post-grant, and covered business method patent reviews and derivation proceedings, hears appeals from adverse examiner decisions in patent applications and reexamination proceedings, and renders decisions in interferences.



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### Decisions

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# Access the PTAB anonymous decision nomination form

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Decisions

- Daily AIA review decisions
- Precedential and informative opinions**
- Precedential Opinion Panel
- Archive of representative AIA trial orders, decisions, and notices
- Search final decisions
- Search proceedings

## Precedential and informative decisions

PTAB precedential and informative decisions are organized by subject matter in the accordion below. Recently designated decisions appear in the first panel. Archived decisions include those not pertinent to or less pertinent to current PTAB practice.

See bottom of the page for alphabetical lists of all precedential and informative decisions. PTAB retired the Excel workbooks containing all PTAB precedential and informative decisions.

A **precedential** decision establishes binding authority concerning major policy or procedural issues, or other issues of exceptional importance, including constitutional questions, important issues regarding statutes, rules, and regulations, important issues regarding case law, or issues of broad applicability to the Board. [Standard Operating Procedure 2](#), 2-3, 11.

An **informative** decision provides Board norms on recurring issues, guidance on issues of first impression to the Board, guidance on Board rules and practices, and guidance on issues that may develop through analysis of recurring issues in many cases. [Standard Operating Procedure 2](#), 9.

If you are interested in anonymously nominating a routine decision of the Board for designation as precedential or informative, please complete the [PTAB decision nomination form](#).

Expand all | Collapse all

> Recently designated decisions



**Precedential Opinion Panel (POP) request:  
amicus form**

# POP request: amicus form

- Published November 19, 2020.
- Accessible the PTAB's [Precedential Opinion Panel](#) page of the USPTO website.
- Allows the submission of an amicus request addressing a pending request for POP review.

# POP request: amicus form

## Precedential Opinion Panel (POP) Request: Amicus Form

PTAB/AF/1 (11/20)

This submission form allows individuals to submit an amicus request supporting or opposing a pending request for POP review in a particular case. Individuals must provide certain information about themselves and the case in which the POP request has been made, can explain why they support or oppose the POP request (e.g., the decision is/is not contrary to Supreme Court, Federal Circuit, or Board precedent), and must certify that the form is being submitted within seven business days of entry of the Notification of Receipt of POP Request into the case docket or patent application file. This information will be entered into the record of the case or patent application.

**\*items are mandatory**

\*Name:

\*Affiliation:   
(e.g., none, law firm, university, company, association)

\*Client represented:   
(e.g., none or XYZ, Inc.)

\*Case number:   
(e.g., IPR2020-01234; 2008-001183)

\*Case name:   
(e.g., ABC Corp. v. 123 Corp.)

\*Rehearing Request  
paper number:   
(For IPR, PGR, or CBM case numbers; e.g., Paper 115)

\*Type of amicus:

\*Brief reasons for  
supporting or  
opposing POP review:   
(Limited to 3000 characters)

\*Relationship to a  
party to the  
proceeding:   
(e.g., none or subsidiary of ABC Corp.)

I certify that I am submitting this amicus form within seven business days of entry of the Notification of POP request into the case docket or patent application file.

\*Signature:  (e.g., /signaturename/)



# POP request: amicus form vs. POP amicus brief

	POP request: amicus form	POP amicus brief
Timing	Filed before decision whether to grant POP review	Filed after POP review is granted
Reason filed	Can explain why POP review should be granted or denied	Can explain how the POP should decide the issue(s) presented

# Access the POP request: amicus form

The screenshot shows the USPTO website header with the logo and navigation links. The main content area is titled "Patent Trial and Appeal Board" and includes a brief description of the board's functions. The breadcrumb trail is: Home > Patents: Application Process > Patent Trial and Appeal Board > Patent Trial and Appeal Board. There are "Share" and "Print" icons in the top right of the content area.



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# Access the POP request: amicus form

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## Decisions

Daily AIA review decisions

Precedential and informative opinions

**Precedential Opinion Panel**

Archive of representative AIA trial orders, decisions, and notices

Search final decisions

Search proceedings

## Precedential Opinion Panel

The Precedential Opinion Panel ("POP") operates, at the discretion of the Director, to decide issues of exceptional importance to the Patent Trial and Appeal Board (e.g., issues involving agency policy or procedure). By default, POP members are the Director, the Commissioner for Patents, and the Chief Judge. Learn more on the [Precedential and informative decisions](#) page.

### [POP Request: Amicus Form](#)

Submit an amicus request supporting or opposing a pending request for POP review.

### POP review granted - proceedings

***Hunting Titan, Inc. v. DynaEnergetics Europe GmbH***, IPR2018-00600

- Decision under POP review - [Paper 42](#) (August 20, 2019)
- POP grant order - [Paper 46](#) (November 7, 2019)
- Amicus briefing - CLOSED (December 20, 2019)
- Oral hearing - [Paper 63](#) (February 18, 2020) **NEW**
- POP decision - [Paper 67](#) (July 6, 2020) **NEW**



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# **Motion to Amend (MTA) pilot program preliminary results**

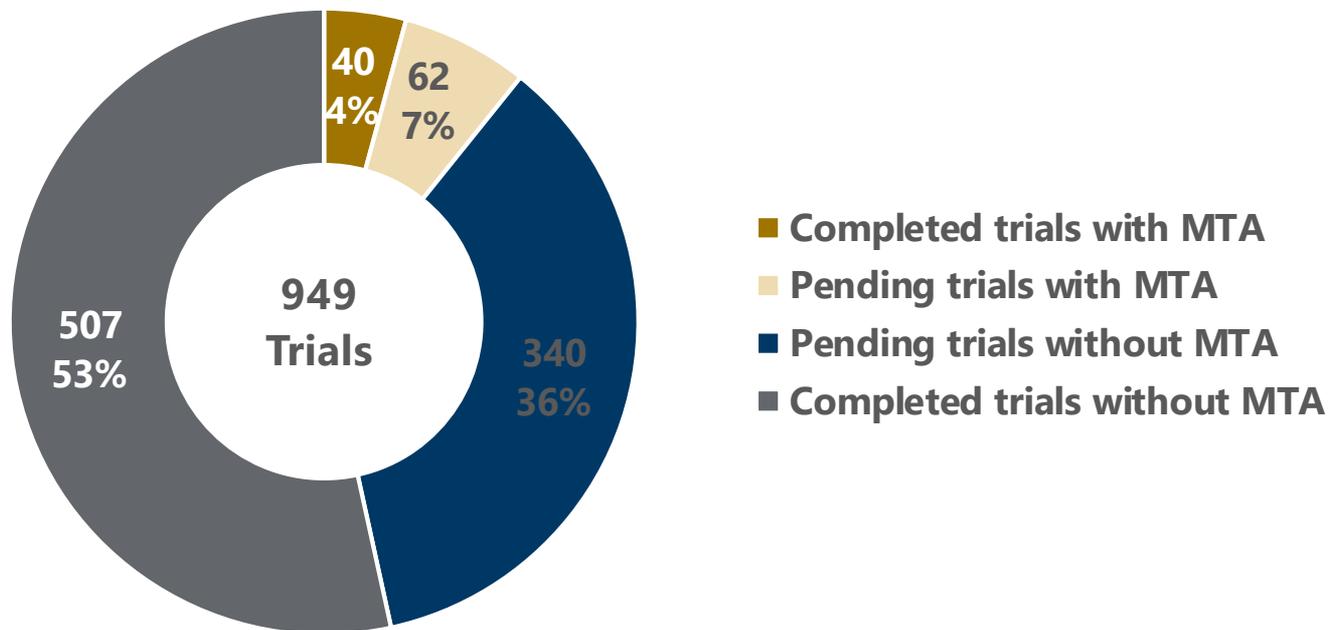
# Highlights of MTA pilot program

- New program provides patent owner (PO) with two options not previously available:
  1. PO may choose to receive preliminary guidance (PG) from Board on its motion to amend (MTA).
  2. PO may choose to file a revised MTA (rMTA) after receiving petitioner's opposition to initial MTA and/or after receiving Board's PG (if requested).
- Pilot program applies to all AIA trials instituted on or after publication date of the notice (i.e., March 15, 2019)

# MTA filings

(Pilot: Mar. 15, 2019 to Sept. 30, 2020)

In how many trials are MTAs filed?

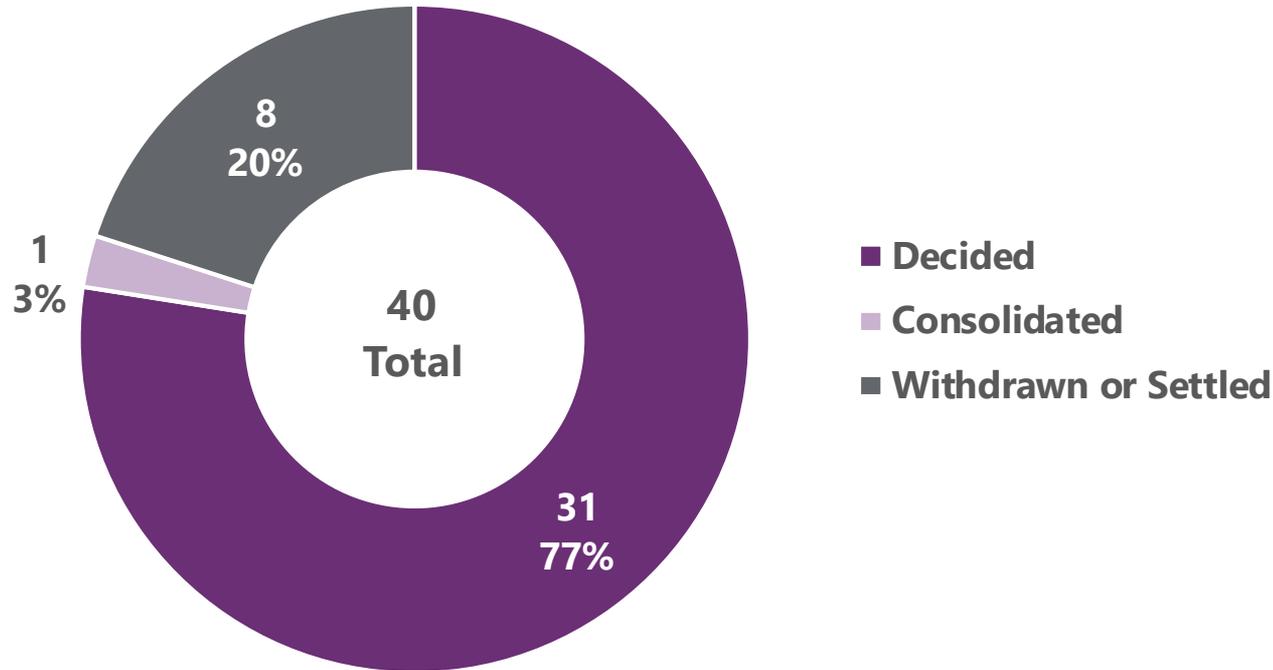


Trials reflect institutions between March 15, 2019 and June 30, 2020. The outcomes of decisions on institution responsive to requests for rehearing are incorporated.



# MTA subsequent developments

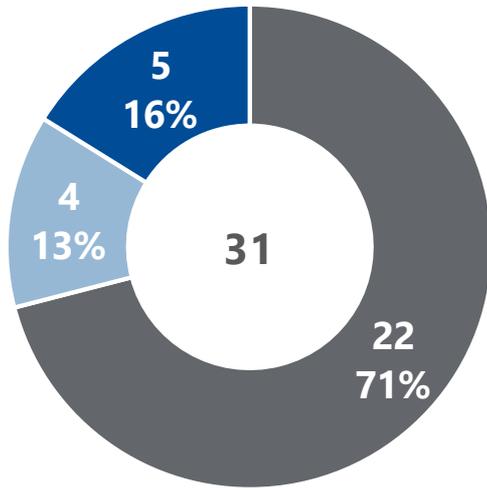
(Pilot: Mar. 15, 2019 to Sept. 30, 2020)



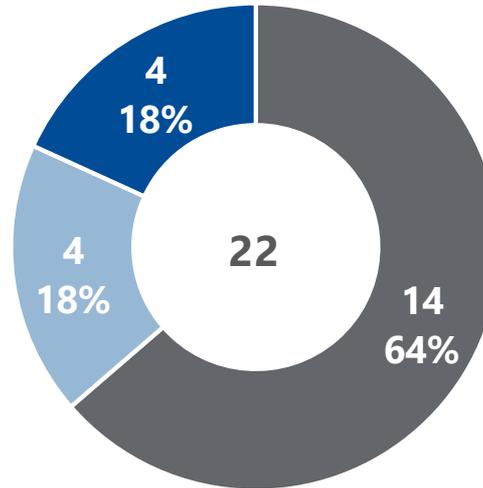
# MTA dispositions, by option

(Pilot: Mar. 15, 2019 to Sept. 30, 2020)

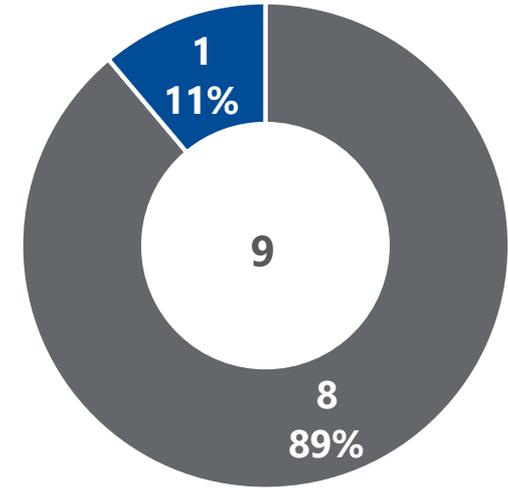
Overall



With Pilot Option



No Pilot Option

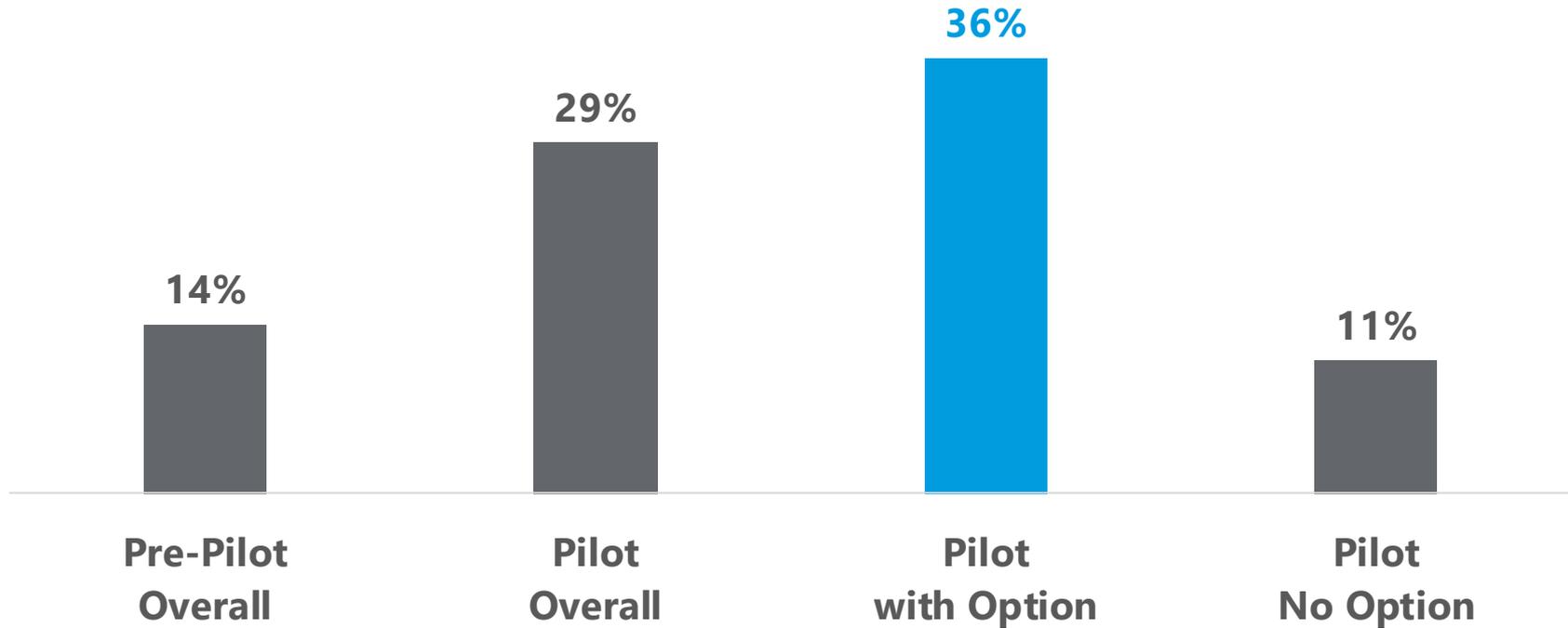


■ Denied ■ Granted in Part ■ Granted

Pilot options include requests for preliminary guidance (PG) and revised MTAs. Dispositions reflect MTAs substituting claims.



# MTA grant rates

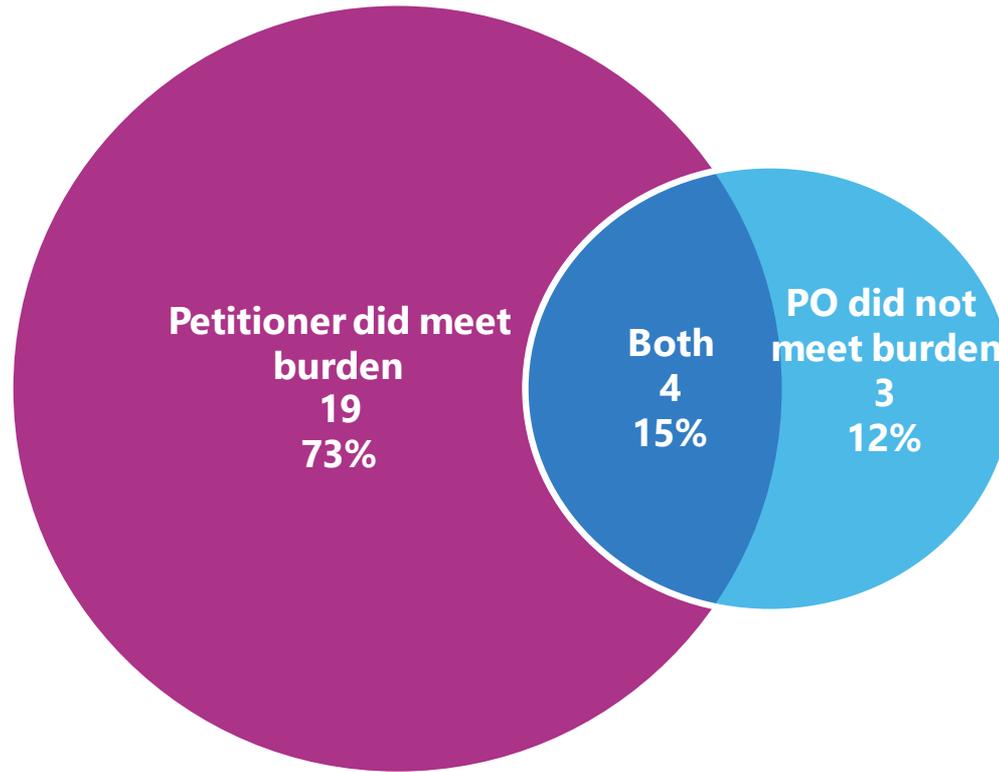


Pilot options include requests for preliminary guidance and revised MTAs.  
Grant rate calculated as the percent of MTA dispositions granted or granted in part.



# Denial of claim substitution, by party's burden

(Pilot: Mar. 15, 2019 to Sept. 30, 2020)

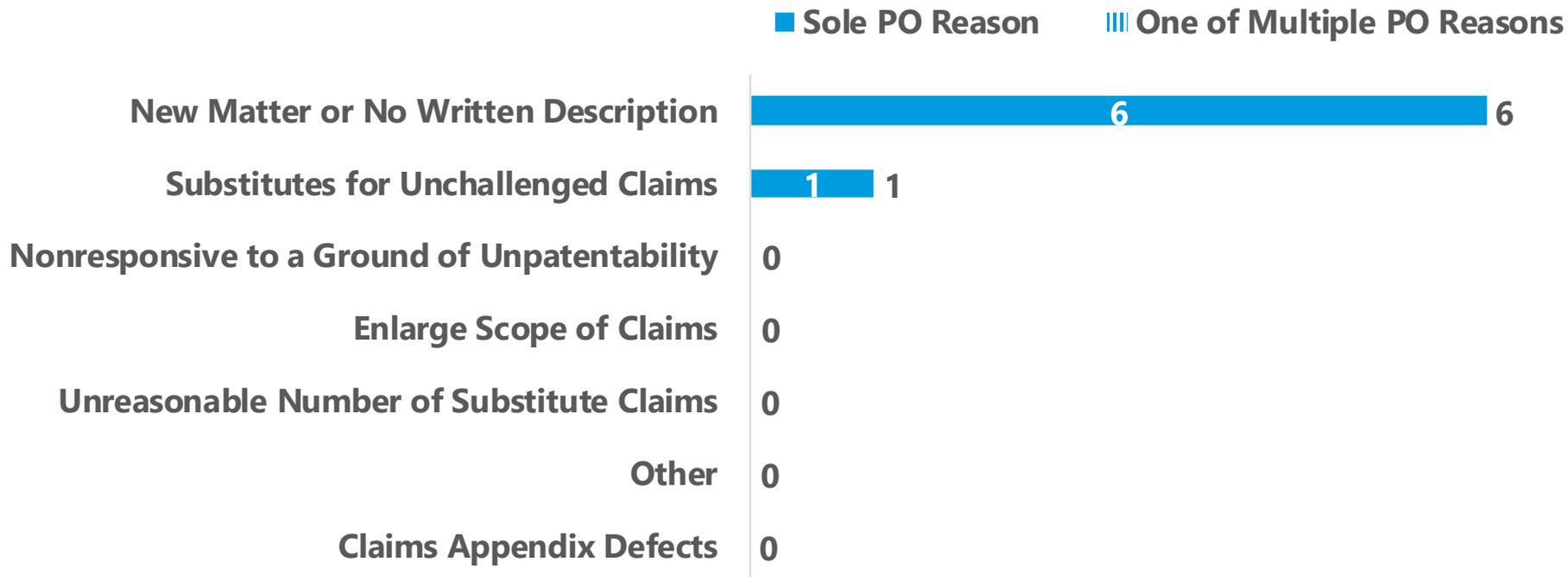


This diagram reflects instances where Petitioner met its burden to show unpatentability or Patent Owner failed to meet its burden on the statutory and regulatory requirements.



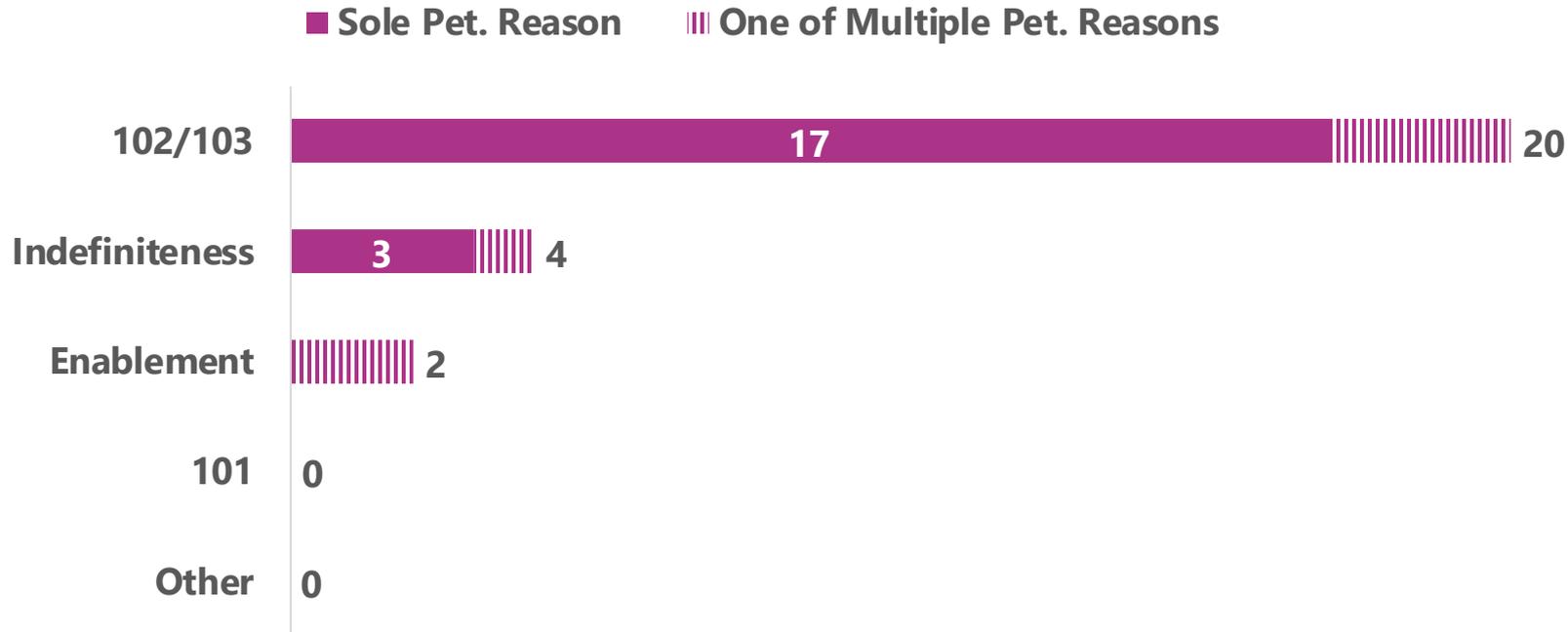
# Reasons PO did not meet burden

(Pilot: Mar. 15, 2019 to Sept. 30, 2020)



# Reasons Petitioner did meet burden

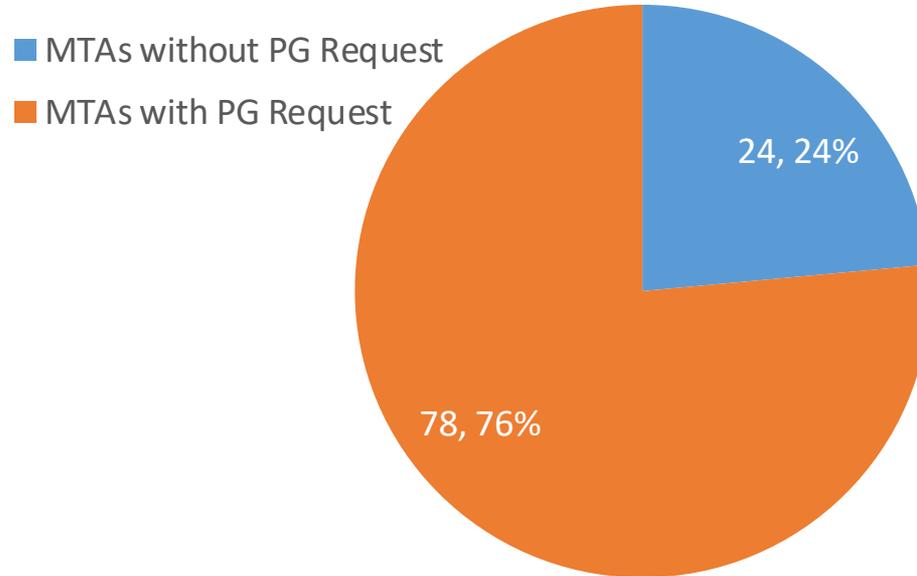
(Pilot: Mar. 15, 2019 to Sept. 30, 2020)



# MTA pilot data

(Mar. 15, 2019 to Sept. 30, 2020)

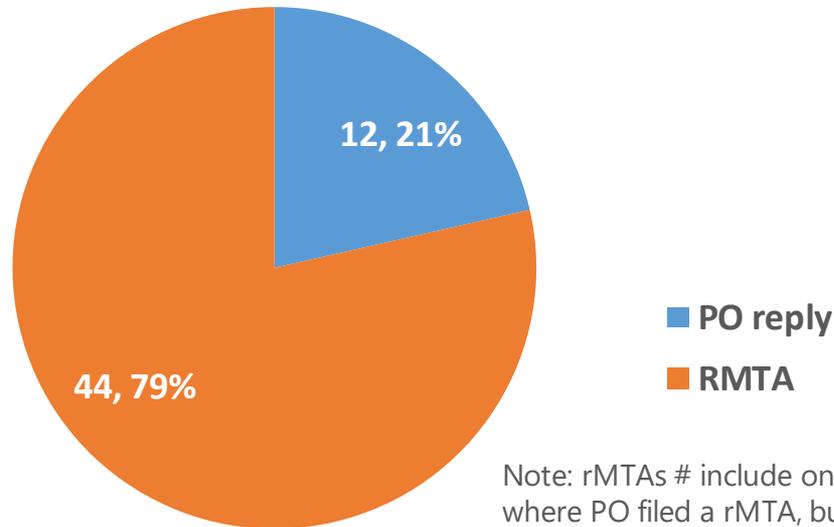
Number of MTAs filed under pilot program



# Patent owner filings after preliminary guidance

(Mar. 15, 2019 to Sept. 30, 2020)

PO filings after preliminary guidance



# Takeaways from MTA pilot program preliminary data

- POs file MTAs in about the same percentage of instituted trials.
- POs have elected one or both pilot options in the vast majority of trials.
- POs choosing at least one pilot option are more likely to have MTAs granted for at least one proposed substitute claim.

# Question/comment submission

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# Multiple Petitions Study

# Multiple petitions

- How “successful” are multiple petition strategies for petitioners?
- “Challenge”: one petitioner vs. one patent
- Serial petitions
  - Same petitioner vs. same patent, filed  $> 90$  days apart
- Parallel petitions
  - Same petitioner vs. same patent, filed  $\leq 90$  days apart



# Serial petition: petitioner's result

Filed > 90 days apart

1 <sup>st</sup> Petition		Serial Petition		Reported Result of Attempt
	+		=	Success
	+		=	Success
	+		=	Failure
	+		=	Failure

# Serial petitions

- *General Plastic* designated FY17
- Compare FY16 with FY17
- Compare to current

# Serial petitions

Metrics for analysis:

<b>FY</b>	<b>Challenges</b>	<b>Serial petition attempts</b>	<b>Attempt rate</b>	<b>Serial petition successes</b>	<b>Success rate</b>
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# Serial petitions

	Challenges	Serial petition attempts	Attempt rate	Serial petition successes	Success rate
FY16	1232	89	7%	46	52%
FY17	1160	86	7%	26	30%
FY20	938	21	2%	7	33%

# Serial petitions

- What made a successful serial petition in FY20?
  - Patent Owner (PO) asserts new claims in D.Ct (2).
  - PO does not contest adding one or two claims (2).
  - Filing an IPR after CBM found ineligible and merits not reached (3).

# Serial petitions

- Observations

- Success rate dramatically dropped after *General Plastic*.
- Attempt rate dropped after success rate dropped.
- Serial petitions were successful when the scope of D.Ct litigation is in flux, or to correct minor errors and omissions.

# Parallel petition: petitioner's result

Filed  $\leq$  90 days apart



[order does not change result]

# Parallel petitions

- *Comcast v. Rovi*: mid-FY19
- *Trial Practice Guide* update: late FY19
- Compare FY18, FY19, FY20

# Parallel petitions

	Challenges	Parallel petition attempts	Attempt rate	Parallel petition successes	Success rate
FY18	1178	182	15%	89	49%
FY19	1033	206	20%	112	54%
FY20	938	145	15%	43	30%

Note: The average number of petitions filed in a parallel petition attempt was 2.22 in FY18; 2.37 in FY19; and 2.28 in FY20.

# Parallel petitions

- What made a successful parallel petition in FY20?
  - Large number of claims/complex claim set (11)
  - Prior art eligibility/Antedation Issues (12)
  - PO did not contest (20)
  - PO asserted new claims in DCt (1)

# Parallel petitions

- Observations

- Attempt and success rate has fallen.
- Over 2/3 of parallel petitions were to cover non-overlapping claim sets on the same art.
- About 1/3 of parallel petitions were to cover uncertain prior art status (e.g., antedation or prior art eligibility).
- If a parallel petition is granted, 90% of the time two petitions were instituted in total.

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