Patent Trial and Appeal Board

State of the Board
USPTO Locations

- Silicon Valley, Calif.
- Denver, Colo.
- Dallas, Texas
- Detroit, Mich.
- Alexandria, Va.
Judge Members of the Board

Judges
PTAB Office Location Demographics
as of May 18, 2015

- Virginia: 57%
- Michigan: 12%
- Colorado: 9%
- Texas: 6%
- California: 5%
- TEAPP: 4%
- Hoteling: 4%
Allocation of Judges
as of May 18, 2015

- AIA (32%)
- Ex parte Appeals (51%)
- Inter Partes Reexamination Appeals (8%)
- Management (7%)
- Interferences (2%)
AIA Statistics
AIA Trial Timeline

- 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
- Period for Observations & Motions to Exclude Evidence

- No more than 12 months
Petition Filing

- 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
## Comparison by Technology Center of FY 2014 AIA Filings v. Patent Grants

<table>
<thead>
<tr>
<th>TC</th>
<th>AIA Filings</th>
<th>Patent Grants</th>
</tr>
</thead>
<tbody>
<tr>
<td>1600</td>
<td>90</td>
<td>24,669</td>
</tr>
<tr>
<td>1700</td>
<td>107</td>
<td>31,863</td>
</tr>
<tr>
<td>2100</td>
<td>188</td>
<td>24,422</td>
</tr>
<tr>
<td>2400</td>
<td>114</td>
<td>30,983</td>
</tr>
<tr>
<td>2600</td>
<td>223</td>
<td>40,445</td>
</tr>
<tr>
<td>2800</td>
<td>289</td>
<td>70,281</td>
</tr>
<tr>
<td>2900</td>
<td>3</td>
<td>22,452</td>
</tr>
<tr>
<td>3600</td>
<td>226</td>
<td>38,160</td>
</tr>
<tr>
<td>3700</td>
<td>156</td>
<td>42,931</td>
</tr>
<tr>
<td>Other</td>
<td>98</td>
<td>176</td>
</tr>
<tr>
<td>Total</td>
<td>1,494</td>
<td>326,382</td>
</tr>
</tbody>
</table>
AIA Progress (as of May 21, 2015)

- AIA Monthly Filings

<table>
<thead>
<tr>
<th></th>
<th>Total</th>
<th>IPR</th>
<th>CBM</th>
<th>PGR</th>
<th>DER</th>
</tr>
</thead>
<tbody>
<tr>
<td>Total</td>
<td>3,294</td>
<td>2,929</td>
<td>346</td>
<td>8</td>
<td>11</td>
</tr>
</tbody>
</table>

![Bar chart showing monthly filings from September 2012 to May 2015]
AIA Progress (for FY15 through May 21, 2015)

- AIA Petition Technology Breakdown

- Electrical/Computer - TCs 2100, 2400, 2600, 2800 (761)
- Mechanical/Business Methods - TCs 3600, 3700 (294)
- Chemical - TC 1700 (55)
- Bio/Pharma - TC 1600 (99)
- Design - TC 2900 (3)
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
AIA Progress (as of May 21, 2015)

- Cumulative Patent Owner Preliminary Responses

<table>
<thead>
<tr>
<th></th>
<th>Filed</th>
<th>Waived</th>
</tr>
</thead>
<tbody>
<tr>
<td>IPR</td>
<td>1,892</td>
<td>416</td>
</tr>
<tr>
<td>CBM</td>
<td>250</td>
<td>28</td>
</tr>
<tr>
<td>PGR</td>
<td>3</td>
<td>1</td>
</tr>
</tbody>
</table>
Decision on Petition

- Petition Filed
- 3 months
- PO Preliminary Response
- No more than 3 months
- Decision on Petition
- 3 months
- PO Response & Motion to Amend Claims
- 3 months
- Petitioner Reply to PO Response & Opposition to Amendment
- 1 month
- PO Reply to Opposition to Amendment
- Hearing Set on Request
- 1 month
- PO Discovery Period
- Petitioner Discovery Period
- PO Discovery Period
- Period for Observations & Motions to Exclude Evidence
- No more than 12 months
- Final Written Decision
# AIA Progress (as of May 21, 2015)

- **AIA Petition Dispositions**

<table>
<thead>
<tr>
<th></th>
<th>Trials Instituted</th>
<th>Joinders</th>
<th>Percent Instituted</th>
<th>Denials</th>
<th>Total No. of Decisions on Institution</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>IPR</strong></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td>FY13</td>
<td>167</td>
<td>10⁺</td>
<td>87%</td>
<td>26</td>
<td>203</td>
</tr>
<tr>
<td>FY14</td>
<td>557</td>
<td>15⁺</td>
<td>75%</td>
<td>193</td>
<td>765</td>
</tr>
<tr>
<td>FY15</td>
<td>519</td>
<td>96⁺</td>
<td>72%</td>
<td>239</td>
<td>854</td>
</tr>
<tr>
<td><strong>CBM</strong></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td>FY13</td>
<td>14</td>
<td>0</td>
<td>82%</td>
<td>3</td>
<td>17</td>
</tr>
<tr>
<td>FY14</td>
<td>91</td>
<td>1⁺</td>
<td>75%</td>
<td>30</td>
<td>122</td>
</tr>
<tr>
<td>FY15</td>
<td>58</td>
<td>-</td>
<td>69%</td>
<td>26</td>
<td>84</td>
</tr>
<tr>
<td><strong>DER</strong></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td>FY14</td>
<td>0</td>
<td>0</td>
<td>0%</td>
<td>3</td>
<td>3</td>
</tr>
</tbody>
</table>
Final Written Decision

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

Timeline:
- 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

Total: No more than 12 months
# Inter Partes Review Petitions Terminated to Date (as of 4/30/2015)

- **29,774 Claims in 937 Petitions**

<table>
<thead>
<tr>
<th>Category</th>
<th>Number</th>
<th>Percentage</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>13,699 Claims Challenged</strong></td>
<td>29,774</td>
<td>85%</td>
</tr>
<tr>
<td><strong>8,886 Claims Instituted</strong></td>
<td>13,699</td>
<td>65%</td>
</tr>
<tr>
<td><strong>4,813 Claims Challenged but Not Instituted</strong></td>
<td>8,886</td>
<td>55%</td>
</tr>
<tr>
<td><strong>3,378 Claims Found Unpatentable</strong></td>
<td>4,813</td>
<td>38%</td>
</tr>
<tr>
<td><strong>3,396 Claims Remaining Patentable</strong></td>
<td>3,378</td>
<td>38%</td>
</tr>
<tr>
<td><strong>1,236 Claims Cancelled or Disclaimed (Non-PTAB)</strong></td>
<td>3,396</td>
<td>36%</td>
</tr>
<tr>
<td><strong>876 Claims Found Patentable by PTAB</strong></td>
<td>1,236</td>
<td>26%</td>
</tr>
<tr>
<td><strong>1,236 Claims Cancelled or Disclaimed (Non-PTAB)</strong></td>
<td></td>
<td></td>
</tr>
<tr>
<td><strong>876 Claims Found Patentable by PTAB</strong></td>
<td></td>
<td></td>
</tr>
<tr>
<td><strong>3,396 Claims Remaining Patentable</strong></td>
<td></td>
<td></td>
</tr>
</tbody>
</table>
AIA Trial Rulemaking Update
AIA Trial Feedback

• Nationwide listening tour conducted in April and May 2014
• Federal Register Request for Comments published in June 2014
• Comment period closed October 16, 2014
• Comments have been published on the Patent Trial and Appeal Board page of the USPTO website
• A wide range of feedback was received
  – Non-rule specific comments
  – Comments directed to the seventeen questions posed for public input
• Quick-fixes for AIA Rules were implemented on March 27, 2015, and the final rule was published on May 19, 2015.
<table>
<thead>
<tr>
<th>Topics for Comment</th>
</tr>
</thead>
<tbody>
<tr>
<td>Claim construction</td>
</tr>
<tr>
<td>Amendment practice</td>
</tr>
<tr>
<td>Patent owner preliminary response</td>
</tr>
<tr>
<td>Obviousness</td>
</tr>
<tr>
<td>Real party in interest</td>
</tr>
</tbody>
</table>
AIA Trial Rulemaking

• In response to stakeholder requests, the Office is moving forward with two rule packages:

  1. A first package, which went into effect upon publication on May 19, 2015, encompasses less difficult “quick-fixes” based upon both stakeholder comments and internal PTAB suggestions.

  2. A second package, issued as proposed rules, will address more difficult changes to the rules, and also will include any changes to the Trial Practice Guide. Plan to issue in July, 2015.
AIA Trial Rulemaking

Quick-Fixes


• Increased the number of pages for a motion to amend from 15 to 25 pages, with a commensurate increase in the number of pages for the opposition, in addition to allowing the Patent Owner to list the amended claims in an appendix.

• Increased the number of pages for a Petitioner’s reply brief from 15 to 25 pages.
Boardside Chats
# Boardside Chats

## 2015

<table>
<thead>
<tr>
<th>Date</th>
<th>Time</th>
<th>Topic</th>
<th>Speakers</th>
</tr>
</thead>
<tbody>
<tr>
<td>Tuesday, February 3</td>
<td>Noon to 1 pm Eastern Time</td>
<td>PTAB Statistics and Key Decisions</td>
<td>Chief Judge James Donald Smith</td>
</tr>
<tr>
<td>Tuesday, April 7</td>
<td></td>
<td>Do’s and Don’ts for Ex Parte Appeals</td>
<td>Panel of Administrative Patent Judges</td>
</tr>
<tr>
<td>Tuesday, June 2</td>
<td></td>
<td>Discovery in AIA Trials</td>
<td>Panel of Practitioners and Administrative Patent Judges</td>
</tr>
<tr>
<td>Tuesday, August 4</td>
<td></td>
<td>AIA Rulemaking and Guidance Changes</td>
<td>Lead Judge Susan Mitchell</td>
</tr>
<tr>
<td>Tuesday, October 6</td>
<td></td>
<td>Best Practices before the PTAB</td>
<td>Panel of Administrative Patent Judges</td>
</tr>
</tbody>
</table>

- “Boardside Chat” is a lunchtime webinar series to be held bi-monthly throughout 2015. The purpose of the Chats is to update you on current Board activities and statistics as well as to regularly receive your feedback about the same.

- All Chats are free and open to all. Also, all Chats will include time for attendee questions and comment.

- Materials from past events are on the PTAB website.
PTAB Website
Revised PTAB Website
Subscription Center
Subscription Center
http://enews.uspto.gov/lists/?p=subscribe&id=1

• Sign up to receive the latest news and updates from the USPTO conveniently via e-mail
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>
Post Grant Resources

- Information concerning the Board and specific trial procedures may be found at:
  http://www.uspto.gov/ip/boards/bpai/index.jsp

- General information concerning implementation of the Leahy-Smith America Invents Act, including post grant reviews, may be found at:
  http://www.uspto.gov/aia_implementation/index.jsp
Questions?