

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



PTAB Update

Scott R. Boalick

Chief Administrative Patent Judge

Jacqueline W. Bonilla

Deputy Chief Administrative Patent Judge

Janet Gongola

Vice Chief Administrative Patent Judge

May 7, 2020

Patent Public Advisory Committee quarterly meeting

UNITED STATES
PATENT AND TRADEMARK OFFICE



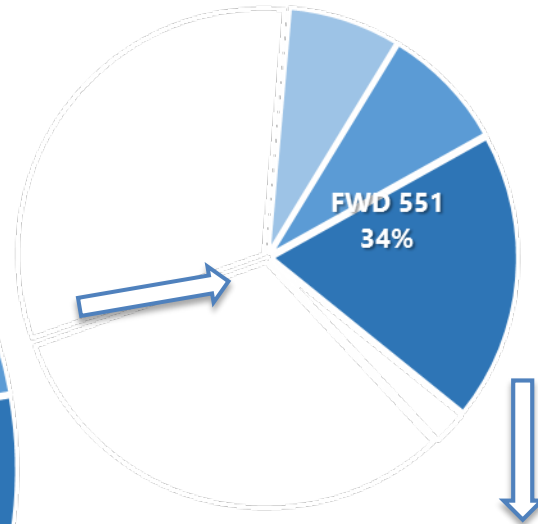
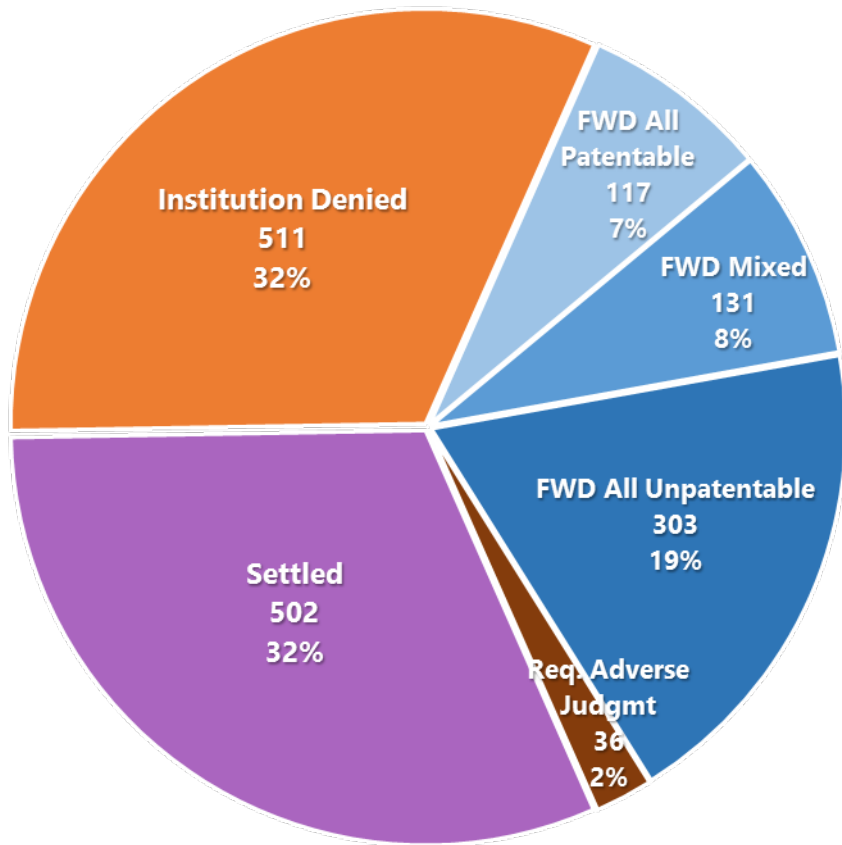
Agenda

- AIA trials statistics
- POP and precedential decisions
- LEAP program

Outcomes

AIA trials statistics

Outcomes in FY19, by petition



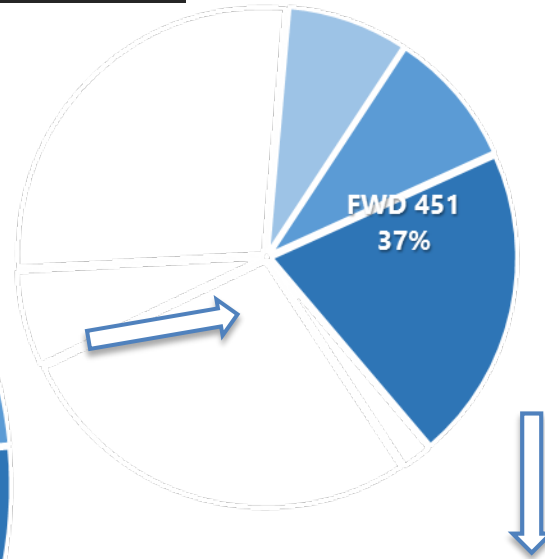
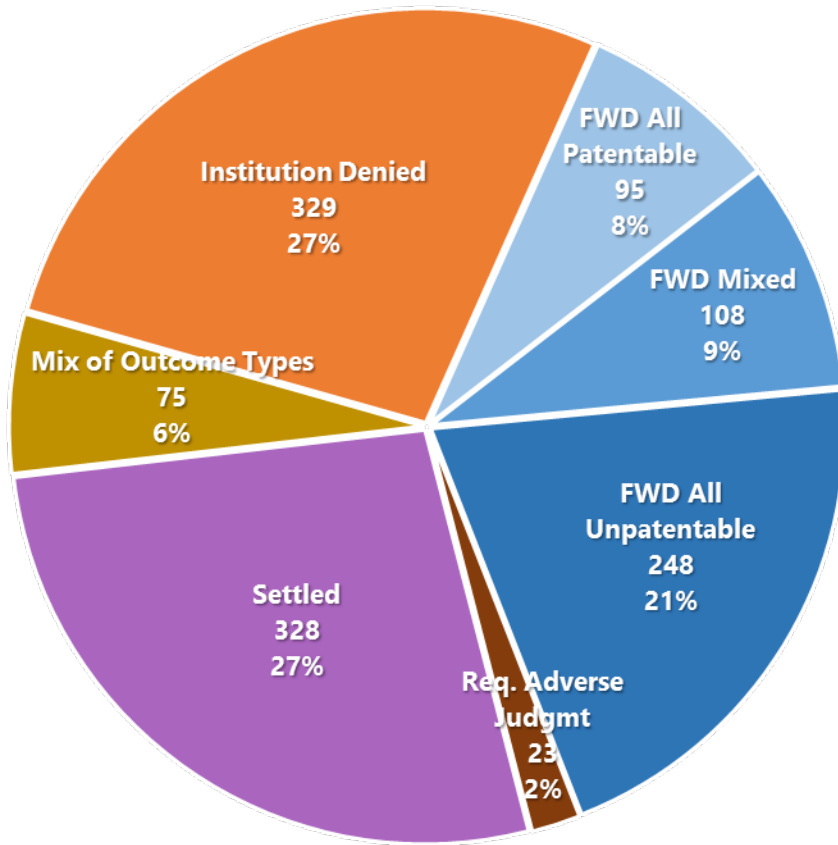
Percentage of the Final Written Decisions

117 (21%)	FWD All Patentable
131 (24%)	FWD Mixed
303 (55%)	FWD All Unpatentable



Joined and dismissed cases excluded.

Outcomes in FY19, by patent



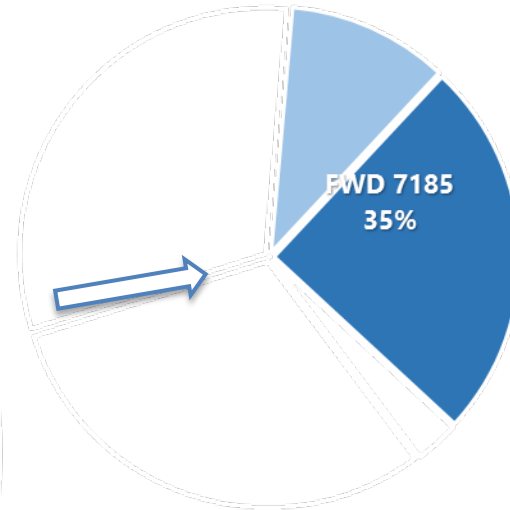
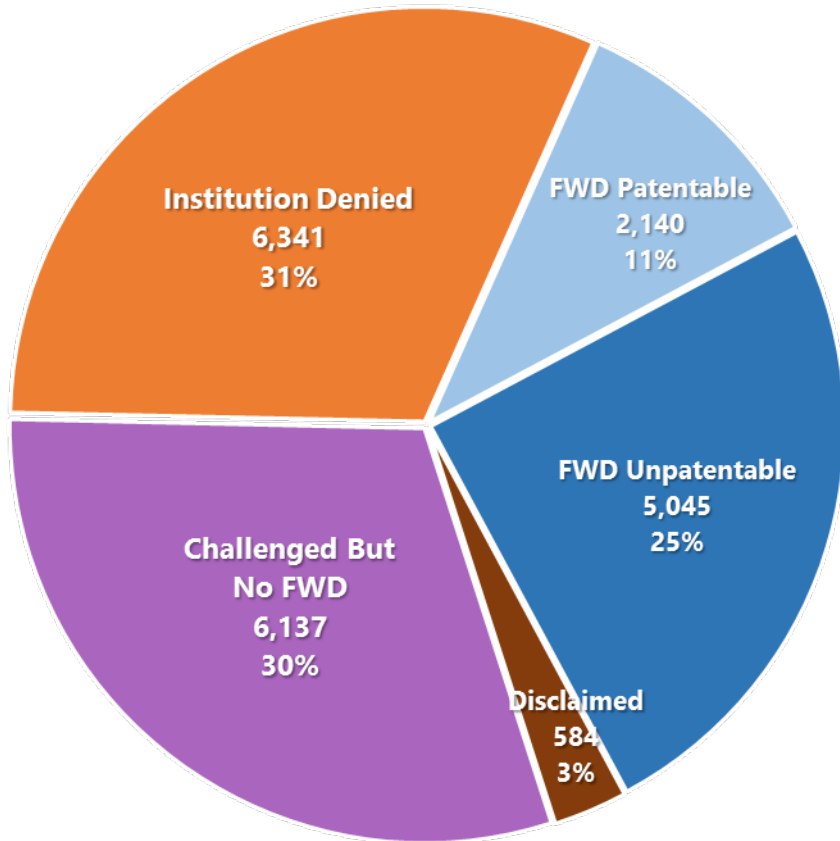
Percentage of the Final Written Decisions

95 (21%)	FWD All Patentable
108 (24%)	FWD Mixed
248 (55%)	FWD All Unpatentable



Joined and dismissed cases excluded. FWD patentability or unpatentability reported with respect to the claims challenged. "Mix of Outcome Types" means patent saw a mix of denied, settled, and req. adverse judgment.

Outcomes in FY19, by claim challenged



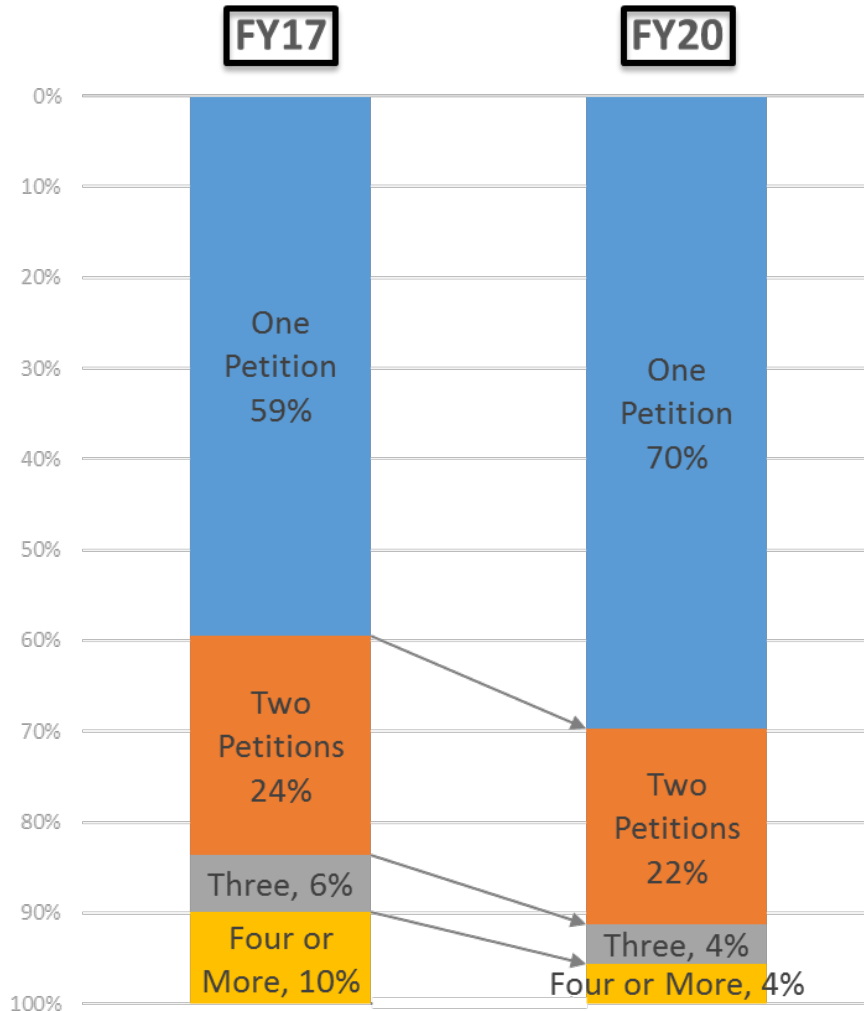
Percentage of the Final Written Decisions

2140 (30%)	FWD Patentable
5045 (70%)	FWD Unpatentable



FWD patentability or unpatentability reported with respect to the claims challenged.

Multiple petitions: pre-*General Plastic* vs. today



Patent Challenged by:	FY17 (%)	FY20 (%)	% Change
One Petition	59	70	19%
Two Petitions	24	22	-8%
Three	6	4	-33%
Four or More	10	4	-60%

Each bar accounts for all patents challenged during the indicated FY timeframe, and counts the total number of petitions ever filed with respect to those patents from September 16, 2012, up to the end of that FY timeframe. The timeframe for FY17 is the entire year, and the timeframe for FY20 is through the end of Q1.

POP and precedential decisions

POP decisions and orders

Case/Appeal Name	Case/Appeal Number	Topic	Status	Date Decided
<i>Proppant Express Invs., LLC v. Oren Techs., LLC</i>	IPR2018-00914, Paper 38	AIA - Joinder - 315(c)	Decided (POP)	3/13/2019
<i>GoPro, Inc. v. 360Heros, Inc.</i>	IPR2018-01754, Paper 38	AIA - 315(b) - Time Bar	Decided (POP)	8/23/2019
<i>Hulu, LLC v. Sound View Innovations, LLC</i>	IPR2018-01039, Paper 29	AIA - Printed Publications	Decided (POP)	12/20/2019

Case/Appeal Name	Case/Appeal Number	Topic	Status	Date Order Issued
<i>Hunting Titan, Inc. v. DynaEnergetics GmbH & Co. KG</i>	IPR2018-00600, Paper 46	AIA - Motion to Amend	Pending (POP)	11/7/2019

Hunting Titan, Inc. v. DynaEnergetics GmbH & Co. KG

IPR2018-00600 (PTAB Aug. 20, 2019) (Paper 42)

- Precedential Opinion Panel (POP) ordered review to address the following issues:
 - Under what circumstances and at what time during an inter partes review proceeding may the Board raise a ground of unpatentability that a petitioner did not advance or insufficiently developed against substitute claims proposed in a motion to amend?
 - If the Board raises such a ground of unpatentability, whether the Board must provide the parties notice and an opportunity to respond to the ground of unpatentability before the Board makes a final determination.
- The POP accepted additional briefing from the parties and amici until and held an oral hearing on February 18, 2020.

Precedential and informative decisions

Precedential decisions (20)

- AIA - RPI - 312(a)(2), 315(b) (2)
- AIA - RPI - 322(a)(2) (1)
- AIA - Institution - 314(a) (2)
- AIA - Institution - 314(a), 325(d) (1)
- AIA - Institution - 325(d) (3)
- AIA - Bar - 315(a)(1) (1)
- AIA - Time Bar - 315(b) (1)
- AIA - MTA - 316(d) (2)
- AIA - Oral Argument (2)
- AIA - Pre-institutions Disclaimer (1)
- AIA - Request for Rehearing (1)
- AIA - Witness Testimony (1)
- Printed Publication (1)
- Secondary Considerations - 103 (1)

Informative decisions (20)

- AIA - Institution - 312(a)(3) (1)
- AIA - Institution - 314(a) (2)
- AIA - Institution - 325(d) (1)
- 101 (6)
- Design Choice - 103 (2)
- Rationale - 103 (2)
- AIA - 311(b) - Printed Publication (4)
- Secondary Considerations - 103 (2)

Recent decisions designated precedential

Case/Appeal Name	Case/Appeal Number	Topic	Date Issued	Date Designated
<i>Proppant Express Invs., LLC v. Oren Techs., LLC</i>	IPR2017-01917, Paper 86	AIA - RPI - 312(a)(2), 315(b)	2/13/2019	4/16/2019
<i>Ventex Co., Ltd v. Columbia Sportswear North America, Inc.</i>	IPR2017-00651, Paper 152	AIA - RPI - 312(a)(2), 315(b)	1/24/2019	4/16/2019
<i>Adello Biologics LLC v. Amgen Inc.</i>	PGR2019-00001, Paper 11	AIA - RPI - 322(a)(2)	2/14/2019	4/16/2019
<i>Valve Corp. v. Elec. Scripting Prods., Inc.</i>	IPR2019-00062, -00063, -00084, Paper 11	AIA - Institution - 314(a)	4/2/2019	5/7/2019
<i>Valve Corp. v. Elec. Scripting Prods., Inc.</i>	IPR2019-00064, -00065, -00085, Paper 10	AIA - Institution - 314(a)	5/1/2019	8/2/2019
<i>NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.</i>	IPR2018-00752 , Paper 8	AIA - Institution - 314(a), 325(d)	9/12/2018	5/7/2019
<i>Becton, Dickinson and Company v. B. Braun Melsungen AG</i>	IPR2017-01586, Paper 8	AIA - Institution - 325(d)	12/15/2017	8/2/2019
<i>Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH</i>	IPR2019-01469, Paper 6	AIA - 325(d) – Institution	2/13/2020	3/24/2020
<i>Oticon Medical AB v. Cochlear Limited</i>	IPR2019-00975, Paper 15	AIA - 325(d) - Institution	10/16/2019	3/24/2020

Recent decisions designated precedential (cont.)

Case/Appeal Name	Case/Appeal Number	Topic	Date Issued	Date Designated
<i>Cisco Systems, Inc. v. Chromar Systems, Inc.</i>	IPR2018-01511, Paper 11	AIA - Bar - 315(a)	1/31/2019	8/29/2019
<i>Infiltrator Water Techs., LLC, v. Presby Patent Trust</i>	IPR2018-00224, Paper 25	AIA - Time Bar - 315(b)	10/1/2018	9/9/2019
<i>Lectrosonics, Inc. v. Zaxcom, Inc.</i>	IPR2018-01129, -01130, Paper 15	AIA - MTA - 316(d)	2/25/2019	3/7/2019
<i>Amazon.com, Inc. v. Uniloc Luxembourg S.A.</i>	IPR2017-00948, Paper 34	AIA - MTA - 316(d)	1/18/2019	3/18/2019
<i>DePuy Synthes Prods., Inc. v. MEDIDEA, L.L.C.</i>	IPR2018-00315, Paper 29	AIA - Oral Argument	1/23/2019	3/18/2019
<i>K-40 Elecs., LLC v. Escort, Inc.</i>	IPR2013-00203, Paper 34	AIA - Oral Argument	5/21/2014	3/18/2019
<i>General Electric Co. v. United Techs. Corp.</i>	IPR2017-00491, Paper 9	AIA - Pre-institution Disclaimer	7/6/2017	9/9/2019
<i>Huawei Device Co., Ltd. v. Optis Wireless Tech., LLC</i>	IPR2018-00816, Paper 19	AIA - Request for Rehearing	1/8/2019	4/5/2019
<i>Focal Therapeutics, Inc. v. SenoRx, Inc.</i>	IPR2014-00116, Paper 19	AIA – Witness Testimony	7/21/2014	7/10/2019

Recent decisions designated precedential (cont.)

Case/Appeal Name	Case/Appeal Number	Topic	Date Issued	Date Designated
<i>Lectrosonics, Inc. v. Zaxcom, Inc.</i>	IPR2018-01129, Paper 33	Secondary Considerations - 103	1/24/2020	4/14/2020
<i>Ex parte Grillo-López</i>	Appeal 2018-006082	Printed Publications	1/31/2020	4/7/2020

Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH

IPR2019-01469 (PTAB Feb. 13, 2020) (Paper 6) (Precedential)

- Designated precedential on March 24, 2020.
- Denied institution based on 35 U.S.C. § 325(d).
 - Explained that the Board uses a two-part framework for exercising discretion under § 325(d).
 - After applying the framework, the Board determined that the Petition presents the same or substantially the same prior art previously presented to the Office and that the Petitioner failed to show that the Examiner materially erred as to the patentability of challenged claims.

Oticon Medical AB v. Cochlear Limited

IPR2019-00975 (PTAB Oct. 16, 2019) (Paper 15) (precedential as to sections II.B and II.C)

- Designated precedential on March 24, 2020, as to Sections II.B and II.C only.
- Declined to exercise discretion under 35 U.S.C. § 325(d).
 - Determined that the cited art was not substantially the same as the art considered during prosecution and that the Examiner erred in not considering the art during prosecution.
- Declined to exercise discretion under 35 U.S.C. § 314(a).
 - Distinguished *NHK Spring Co. v. IntriPlex Technologies, Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential), because no trial date had been set in the co-pending district court case, and the IPR would not be duplicative of the district court consideration of validity.

Lectrosonics, Inc. v. Zaxcom, Inc.

IPR2018-01129, Paper 33 (PTAB Jan. 24, 2020) (Precedential)

- Designated precedential on April 14, 2020.
- Considered *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1373 (Fed. Cir. 2019).
- Determined challenged claims are unpatentable because Patent Owner did not establish a nexus between the claims and objective evidence of non-obviousness.
- Determined Patent Owner's amended claims are patentable because the Patent Owner did establish a nexus to objective evidence of non-obviousness, including long-felt need and industry praise.

Ex parte Grillo-López

Appeal No. 2018-006082 (PTAB Jan. 31, 2020) (Precedential)

- Designated precedential on April 7, 2020.
- Explained that the burden for establishing that a reference is a printed publication is different in examination than in an inter partes review proceeding.
- Determined that the holding in *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 (PTAB Dec. 20, 2019) (precedential), does not apply to examination.

Recent decisions designated informative

Case/Appeal Name	Case/Appeal Number	Topic	Date Issued	Date Designated
<i>Argentum Pharmaceuticals LLC v. Research Corporation Technologies, Inc.</i>	IPR2016-00204, Paper 19	AIA - 311(b) - Printed Publication	5/23/2016	4/7/2020
<i>Seabery North America Inc. v. Lincoln Global, Inc.</i>	IPR2016-00840, Paper 11	AIA - 311(b) - Printed Publication	10/6/2016	4/7/2020
<i>Sandoz Inc. v. AbbVie Biotechnology Ltd.</i>	IPR2018-00156, Paper 11	AIA - 311(b) - Printed Publication	6/5/2018	4/7/2020
<i>In-Depth Geophysical, Inc. v. ConocoPhillips Company</i>	IPR2019-00849, Paper 14	AIA - 311(b) - Printed Publication	9/6/2019	4/7/2020
<i>Adaptics Limited v. Perfect Company</i>	IPR2018-01596, Paper 20	AIA - Grounds - 312(a)(3)	3/6/2019	8/2/2019
<i>Deeper, UAB v. Vexilar, Inc.</i>	IPR2018-01310, Paper 7	AIA - Institution - 314(a)	1/24/2019	4/5/2019
<i>Chevron Oronite Company LLC v. Infineum USA L.P.</i>	IPR2018-00923, Paper 9	AIA - Institution - 314(a)	11/7/2018	4/5/2019
PUMA North America, Inc. v. NIKE, Inc.	IPR2019-01042, Paper 10	AIA - 325(d) - Institution	10/31/2019	3/24/2020
<i>Ex Parte Smith</i>	Appeal 2018-000064	101	2/1/2019	3/19/2019
<i>Ex Parte Olson</i>	Appeal 2017-006489	101	3/25/2019	7/1/2019

Recent decisions designated informative

Case/Appeal Name	Case/Appeal Number	Topic	Date Issued	Date Designated
<i>Ex Parte Kimizuka</i>	Appeal 2018-001081	101	5/15/2019	7/1/2019
<i>Ex Parte Savescu</i>	Appeal 2018-003174	101	4/1/2019	7/1/2019
<i>Ex Parte Fautz</i>	Appeal 2019-000106	101	5/15/2019	7/1/2019
<i>Ex parte Hannun</i>	Appeal 2018-003323	101	4/1/2019	12/11/2019
<i>Ex Parte Maeda</i>	Appeal 2010-009814	Design Choice - 103	10/23/2012	10/15/2019
<i>Ex Parte Spangler</i>	Appeal 2018-003800	Design Choice - 103	2/20/2019	10/15/2019
<i>Hulu, LLC v. Sound View Innovations, LLC</i>	IPR2018-00582, Paper 34	Rationale - 103	8/5/2019	12/11/2019
<i>Johns Manville Corp. v. Knauf Insulation, Inc.</i>	IPR2018-00827, Paper 9	Rationale - 103	10/16/2018	12/11/2019
<i>Ex parte Whirlpool Corporation</i>	Appeal 2013-008232	Secondary Considerations - 103	10/30/2013	4/14/2020
<i>Ex parte Thompson</i>	Appeal 2011-011620	Secondary Considerations - 103	3/21/2014	4/14/2020

Argentum Pharmaceuticals LLC v. Research Corporation Technologies, Inc.

IPR2016-00204, Paper 19 (May 23, 2016) (Informative as to section II.B)

- Designated informative on April 7, 2020, as to section II.B only.
- Determined the Petitioner did not sufficiently show that a reference was publicly available because the record included only a district court joint statement of uncontested facts identifying the reference as a printed publication. The joint statement did not involve the Petitioner and expressly indicated that it was only for purposes of the district court litigation.

Seabery North America Inc. v. Lincoln Global, Inc.

IPR2016-00840, Paper 11 (Oct. 6, 2016) (Informative as to section II.A.i)

- Designated informative on April 7, 2020, as to section II.A.i only.
- Determined the Petitioner made a sufficient showing for purposes of institution that a reference was publicly available, where the record included testimony that the reference was deposited in a university library, indexed and available for retrieval by the public, and that reprints of the reference bear a copyright and publication date.

Sandoz Inc. v. AbbVie Biotechnology Ltd.

IPR2018-00156, Paper 11 (June 5, 2018) (Informative as to section III.C.1)

- Designated informative on April 7, 2020, as to section III.C.1 only.
- Determined the Petitioner made a sufficient showing for purposes of institution that a drug package insert was publicly available, where the record included a screenshot of an archived FDA webpage from the Internet Archive and testimony from a medical doctor describing the use and accessibility of information on the FDA's webpage.

In-Depth Geophysical, Inc. v. ConocoPhillips Company

IPR2019-00849, Paper 14 (Sept. 6, 2019) (Informative as to section I.E)

- Designated informative on April 7, 2020, as to section I.E only.
- Determined the Petitioner did not sufficiently show that a conference paper was publicly accessible because the paper's copyright date and date stamp were insufficient to show that the paper was actually disseminated prior to the date of the conference, or otherwise available to interested persons of ordinary skill in the art.

PUMA North America, Inc. v. NIKE, Inc.

IPR2019-01042 (PTAB Oct. 31, 2019) (Paper 10)

- Designated informative on March 24, 2020.
- Denied institution based on 35 U.S.C. § 325(d).
 - The Examiner twice rejected the challenged claims over the same combination of references in the same manner the Petitioner proposed, and the Petitioner failed to show examiner error.

Ex parte Whirlpool Corp.

Appeal 2013-008232 (Oct. 30, 2013) (Informative)

- Designated informative on April 14, 2020.
- Reversed the Examiner's obviousness rejection, finding that the Patent Owner established a nexus between the claimed invention and its objective evidence of non-obviousness, including industry praise, commercial success, long-felt need, and copying, and that such objective evidence is sufficient to demonstrate non-obviousness of the claimed invention.

Ex parte Thompson

Appeal 2011-011620 (March 21, 2014) (Informative)

- Designated informative on April 14, 2020.
- Reversed the Examiner's obviousness rejection, noting that assessing whether a claimed invention would have been obvious requires considering objective evidence of non-obviousness, and weighing appropriately the prior art-based evidence in conjunction with the objective evidence.

LEAP program

Legal Experience and Advancement Program (LEAP)

- Designed to foster the development of the next generation of patent practitioners by creating opportunities for them to gain the proper skills and experience in oral arguments before the Board

LEAP eligibility

- Targeting attorneys and agent new to the practice of law or new to practice before the PTAB
- To qualify, a patent agent or attorney must have:
 - three (3) or fewer substantive oral arguments in any federal tribunal, including PTAB, *and*
 - seven (7) or fewer years of experience as a licensed attorney or agent

LEAP benefits

- Board will grant additional argument time to the party, typically up to fifteen minutes depending on the length of the proceeding and the PTAB's hearing schedule
- Additional time is for the *party*
 - A LEAP practitioner does not have to be allocated a specific amount of time—it remains within the party's discretion to allocate time between counsel
 - LEAP practitioner must have a substantive role in the oral argument
- More experienced counsel may provide some assistance, if necessary, and may make limited clarifications on the record

LEAP requests

- AIA trials: email to Trials@uspto.gov at least 5 business days before the hearing
- Appeals: email to PTABHearings@uspto.gov at least 5 business days before the hearing
- LEAP practitioner must file a Verification Form confirming eligibility

LEAP preparation

- PTAB oral advocacy training
 - e.g., flow of a hearing, effective use of hearing time, use of demonstratives during a hearing, and oral advocacy tips

Next steps for LEAP

- LEAP practitioners are encouraged to participate otherwise in Board proceedings
 - e.g., conference calls, pre-hearing conferences, and depositions

Appendix

Hearings update

Remote hearings update: current status

- Oral hearings for appeals are telephonic.
- Oral hearings for AIA trials are by video.
- Most hearings have gone smoothly.
- Few have had technical issues, which were eventually resolved.

Remote hearings update: statistics – March 16, 2020* to April 30, 2020

- 117 appeal hearings
- 33 AIA hearings

* All USPTO closed to the public on March 16, 2020.

Hearings update: public access

- Public access instruction on PTAB Hearings webpage.
 - Until further notice, Patent Trial and Appeal Board (PTAB) oral hearings will be conducted remotely by video or telephone. During this time period, to listen in on any particular oral hearing, please make a request via email to PTABHearings@uspto.gov. The request should include any request for accommodations for individuals with disabilities, including captioning. The request must be received at least three business days prior to the oral hearing date. The Board will then respond to the request, and also provide any connection information. At a later date, a transcript for each oral hearing will be entered into the record of the relevant proceeding, and will be publicly available in PTAB E2E (<https://ptab.uspto.gov/#/login>), unless an exception applies.
- <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/hearings>

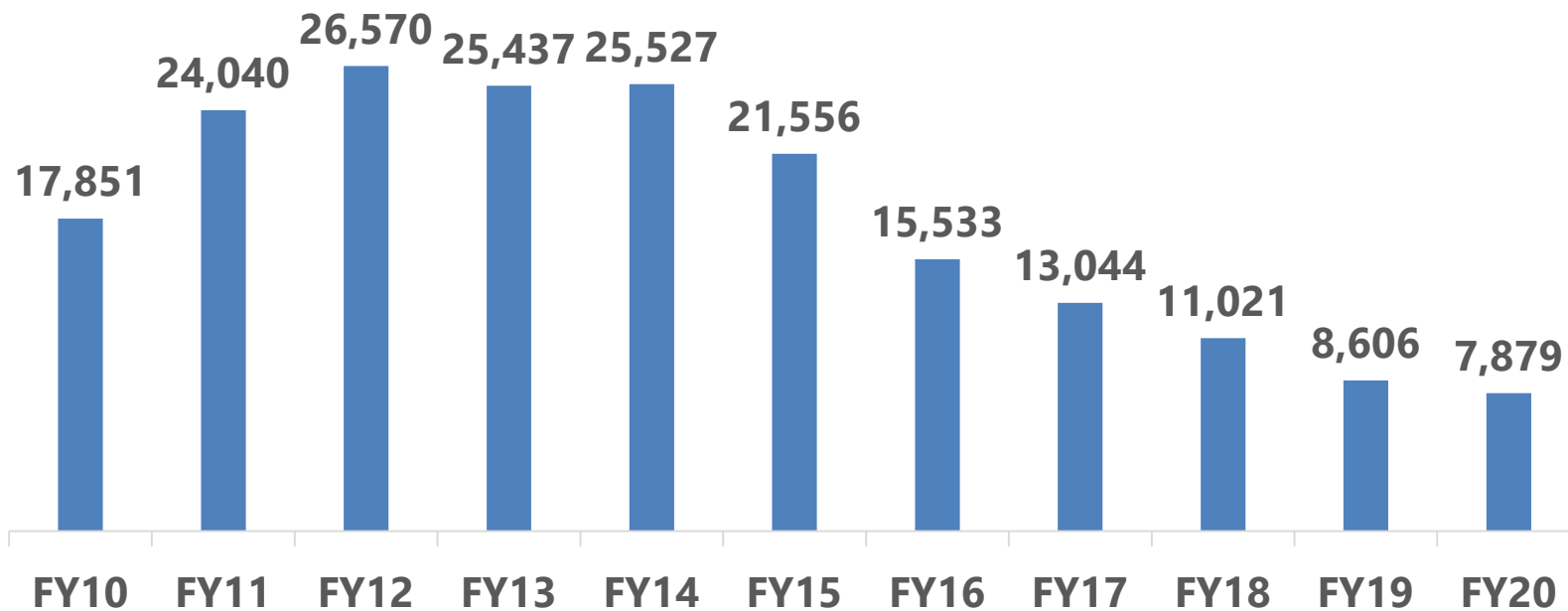
Hearing room upgrades: current status

- Hearing room A/V upgrades have been delayed due to office closures and travel restrictions.

Appeal and interference statistics – March 2020

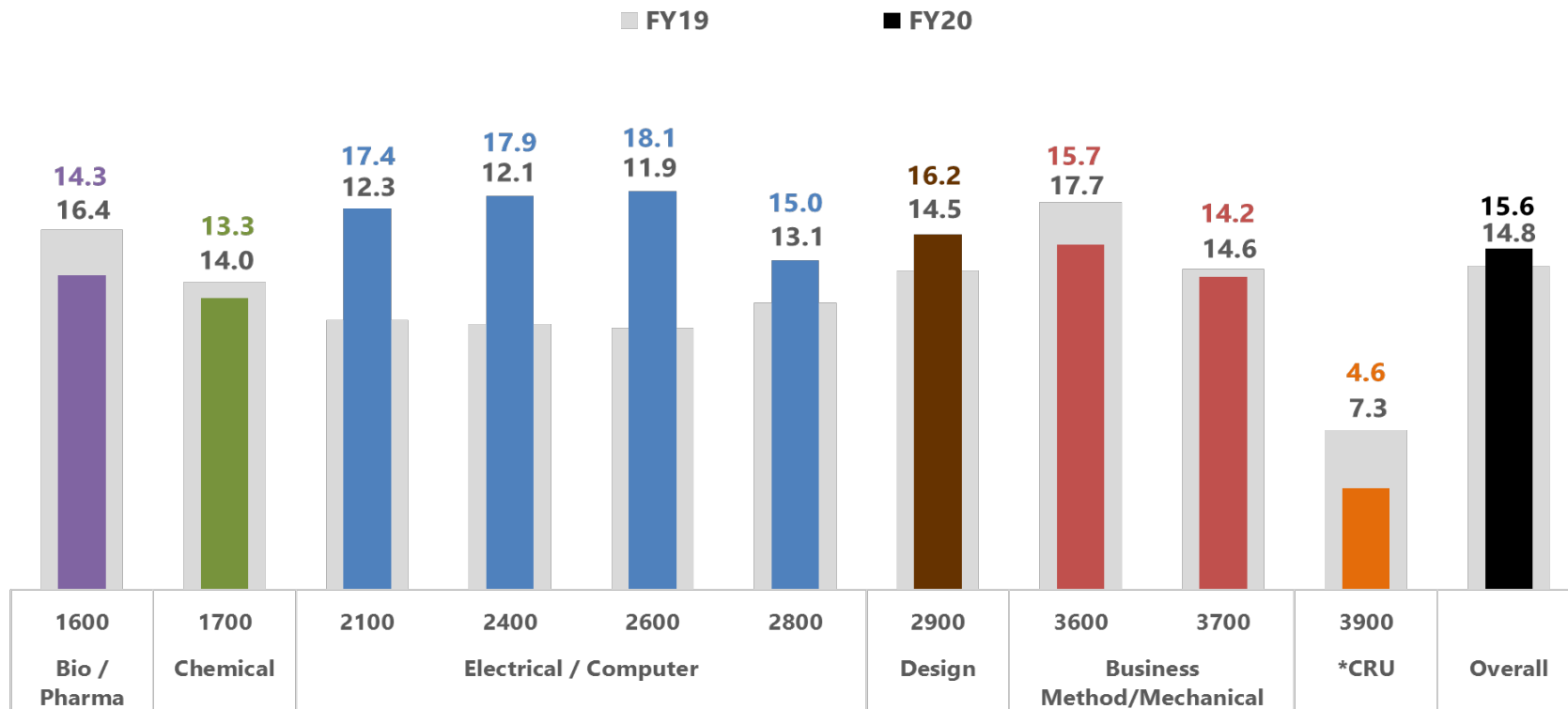
Pending appeals FY10 to FY20

(Sept. 30, 2010 – March 31, 2020)



Pendency of decided appeals

(Jan. 2019 – Mar. 2019 compared to Jan. 2020 – Mar. 2020)



Pendency is calculated as average months from Board receipt date to final decision.

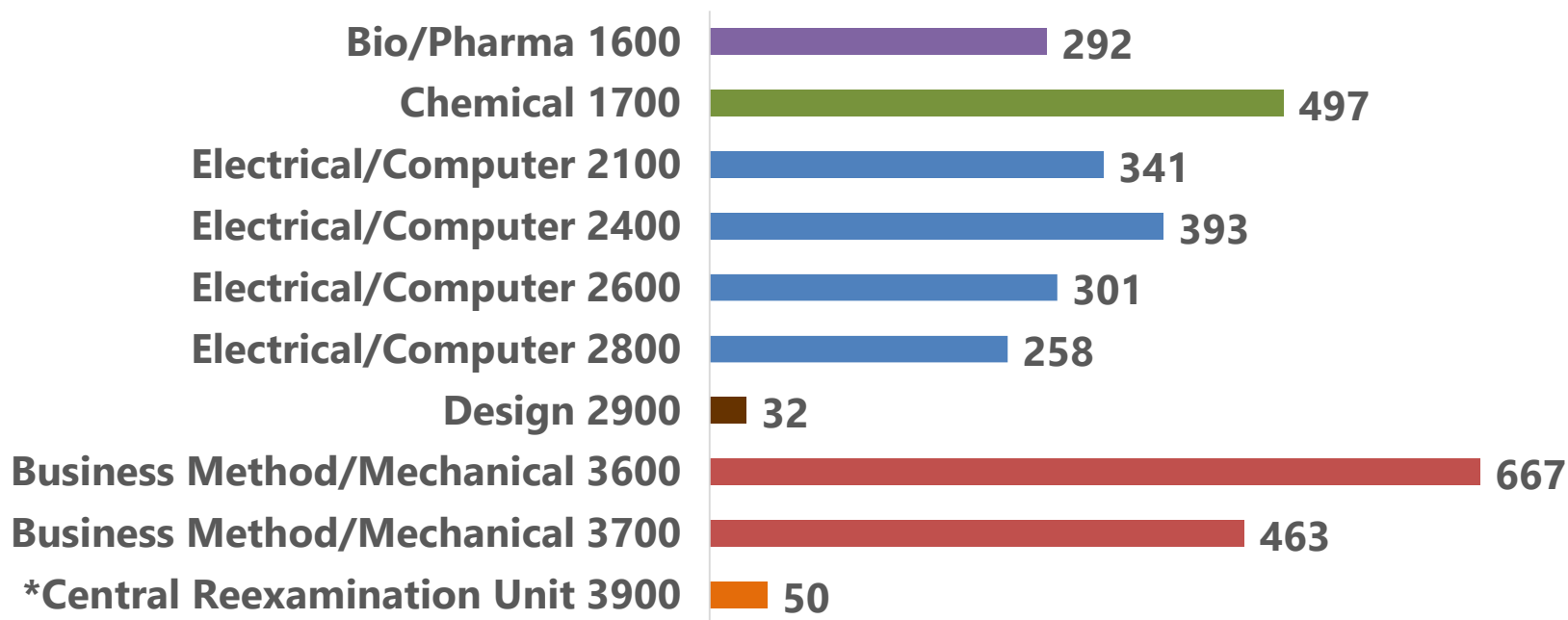
Pendency is calculated for a three month period compared to the same period the previous year.

*CRU (Central Reexamination Unit) decisions include 11 *ex parte* reexams, 5 *inter partes* reexam, 1 supplemental examination reviews, and 11 reissues from all technologies for Jan. 2020– Mar. 2020.



Appeal intake in FY20

(Oct. 1, 2019 – Mar. 31, 2020)

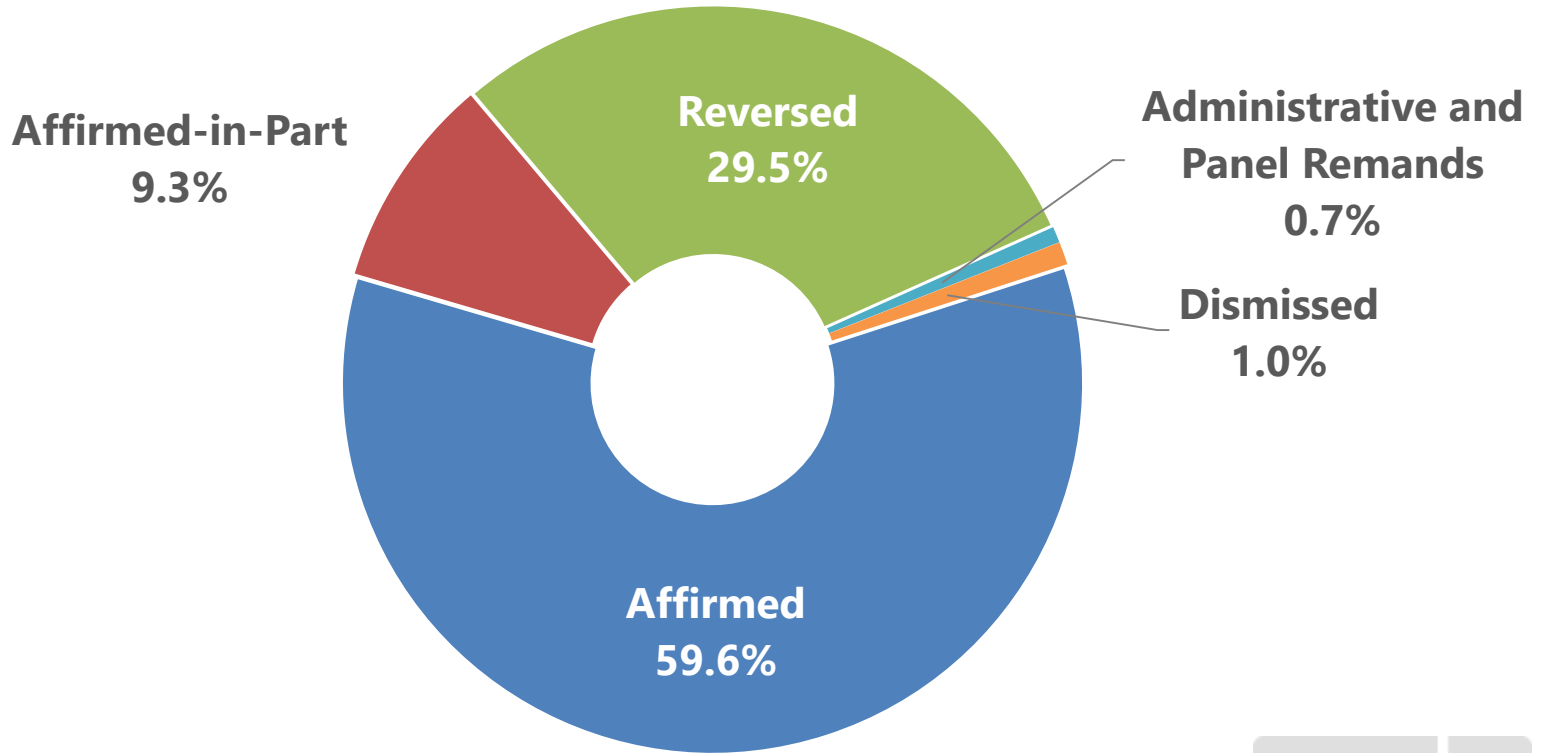


*The Central Reexamination Unit includes ex parte reexams, inter partes reexams, supplemental examination reviews and reissues from all technologies.



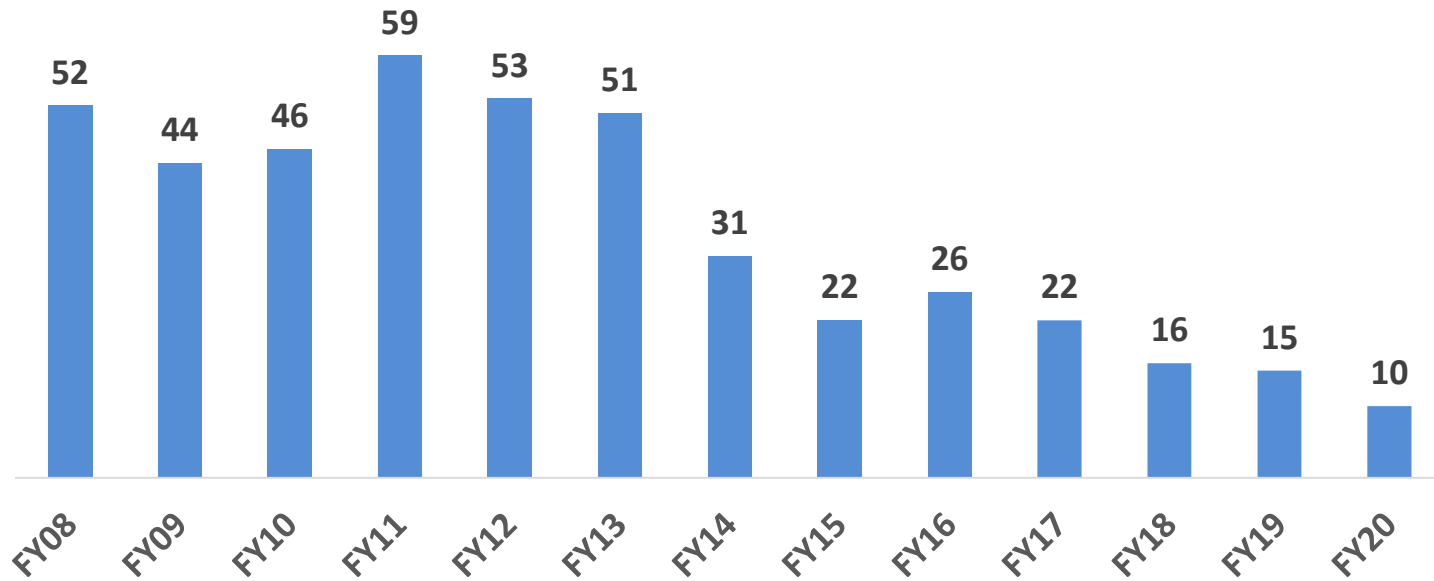
Appeal outcomes in FY20

(Oct. 1, 2019 - Mar. 31, 2020)



Interference inventory

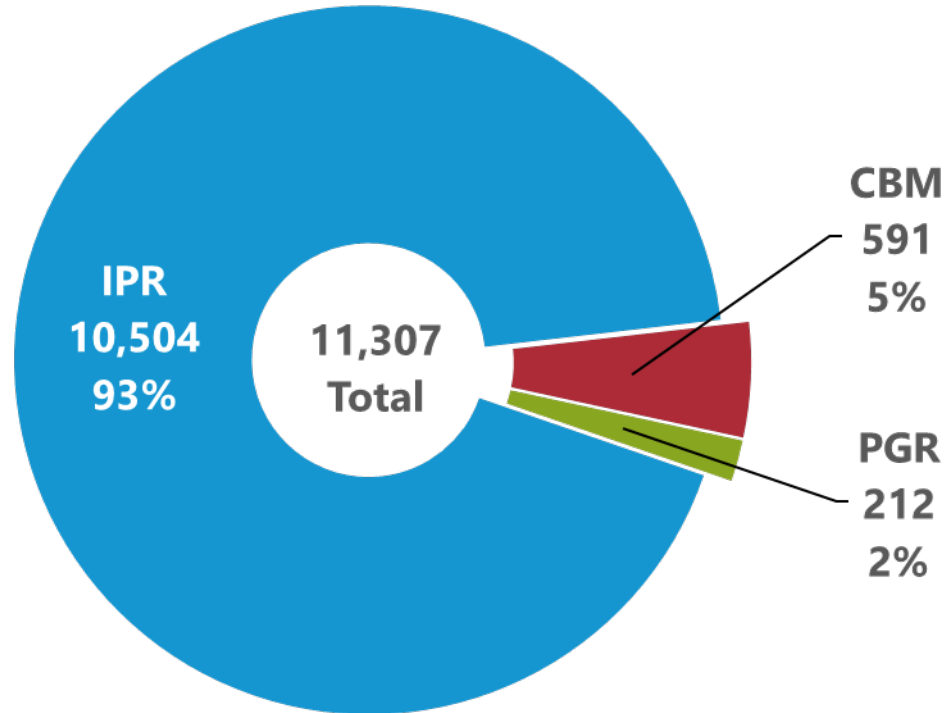
(Sept. 30, 2008 – Mar. 31, 2020)



Trial statistics (IPR, PGR, CBM) – March 2020

Petitions by trial type

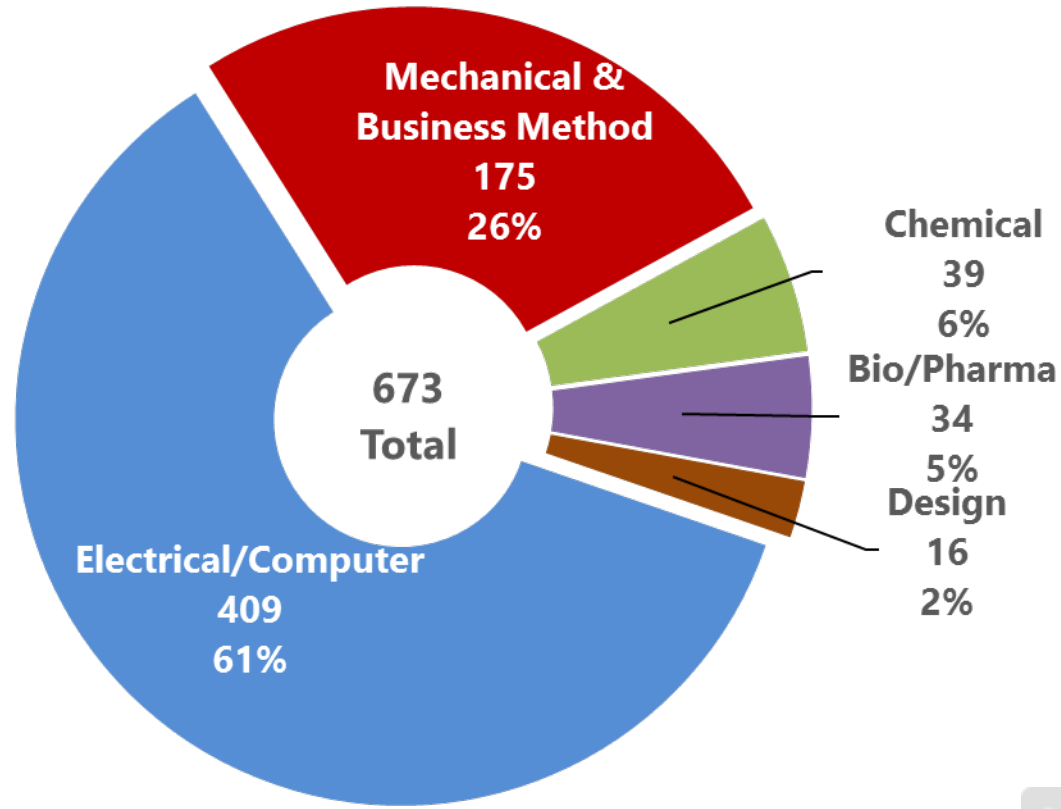
(All Time: Sept. 16, 2012 to Mar. 31, 2020)



Trial types include Inter Partes Review (IPR), Post Grant Review (PGR), and Covered Business Method (CBM).

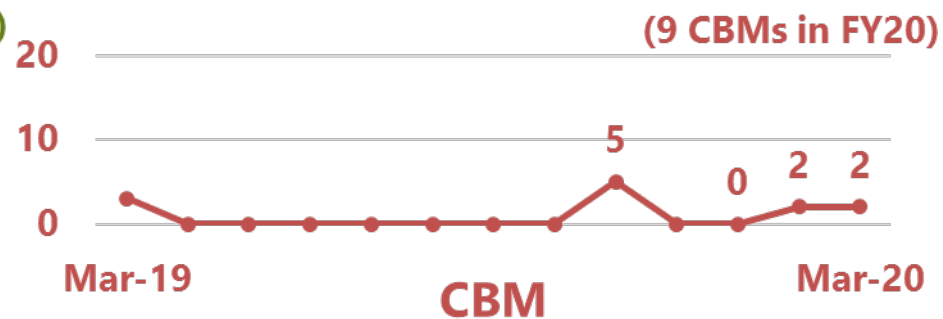
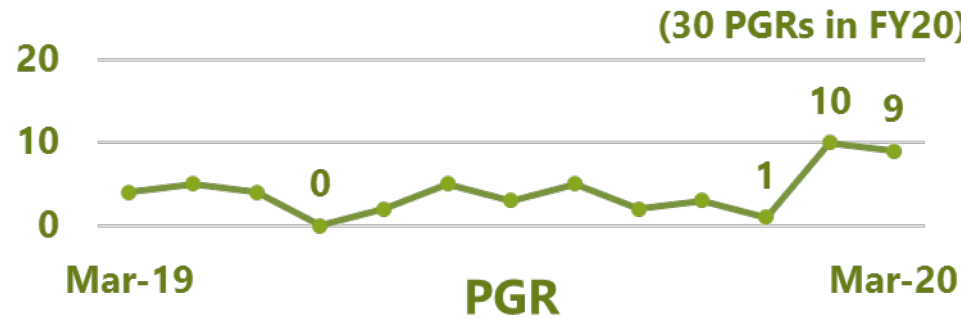
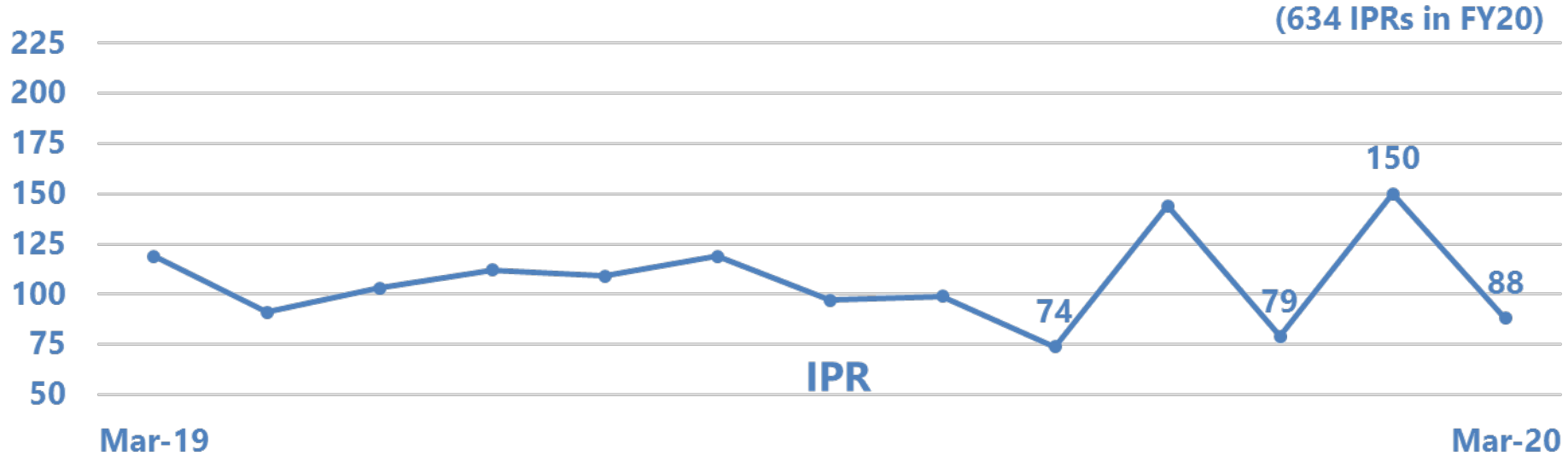
Petitions filed by technology in FY20

(FY20: Oct. 1, 2019 to Mar. 31, 2020)



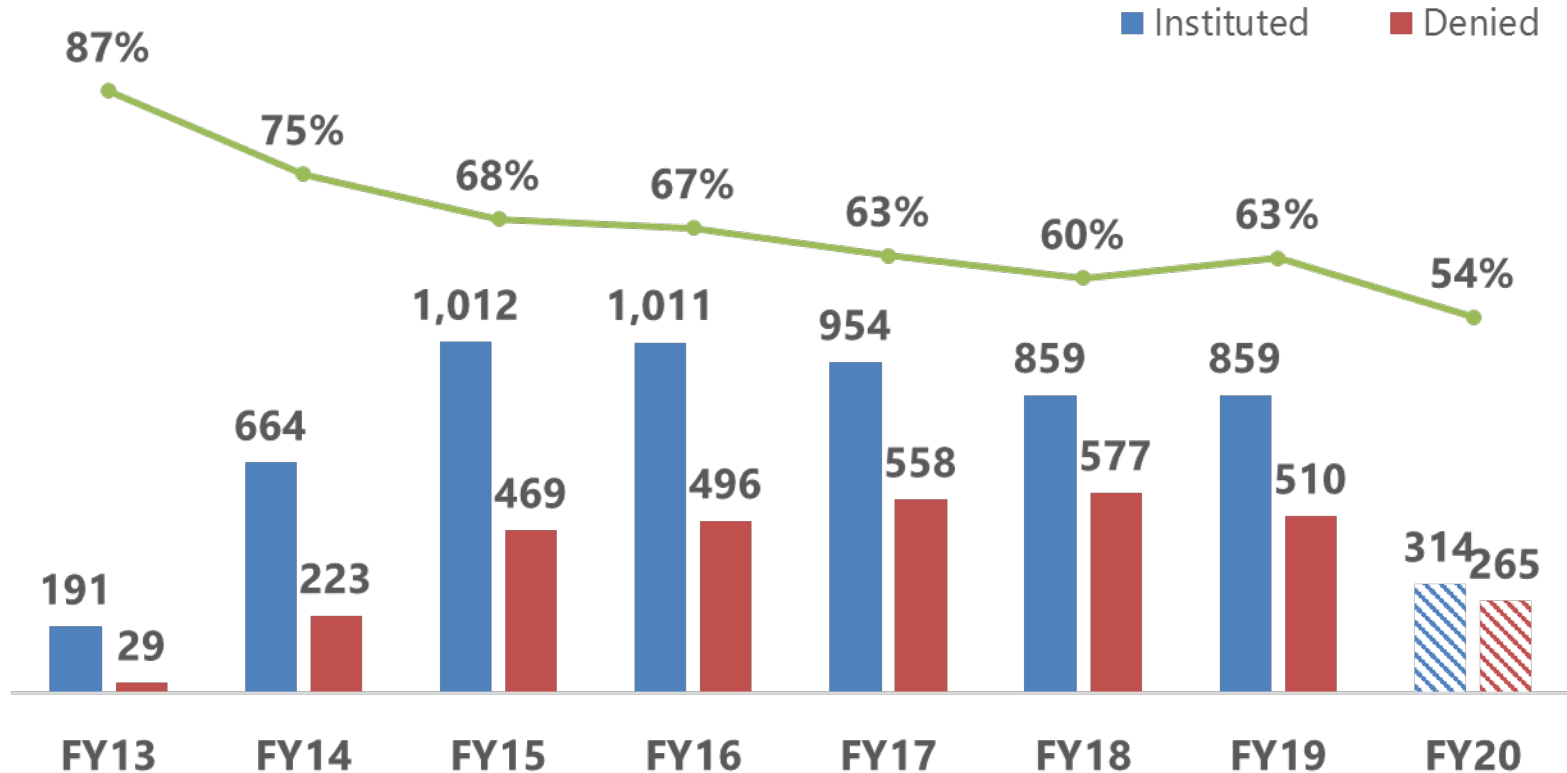
Petitions filed by month

(Mar. 2020 and Previous 12 Months: Mar. 1, 2019 to Mar. 31, 2020)



Institution rates

(FY13 to FY20: Oct. 1, 2012 to Mar. 31, 2020)

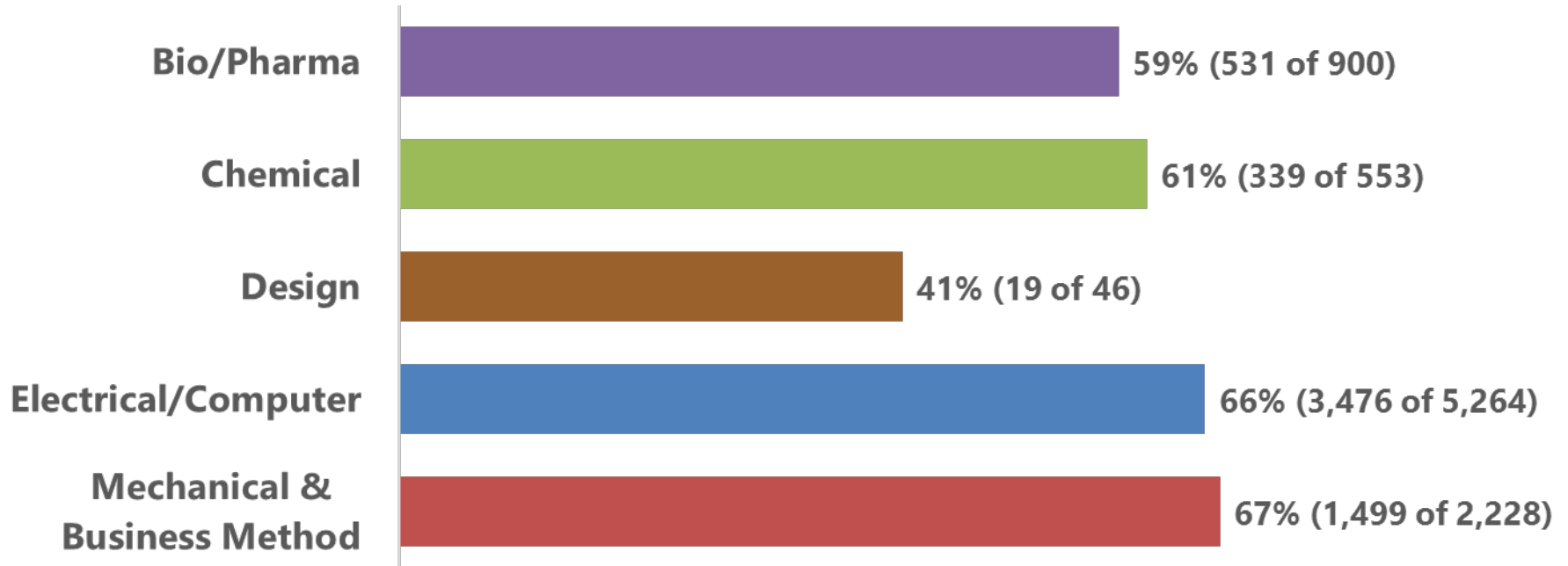


Institution rate for each fiscal year is calculated by dividing petitions instituted by decisions on institution (i.e., petitions instituted plus petitions denied). The outcomes of decisions on institution responsive to requests for rehearing are excluded.



Institution rates by technology

(All Time: Sept. 16, 2012 to Mar. 31, 2020)

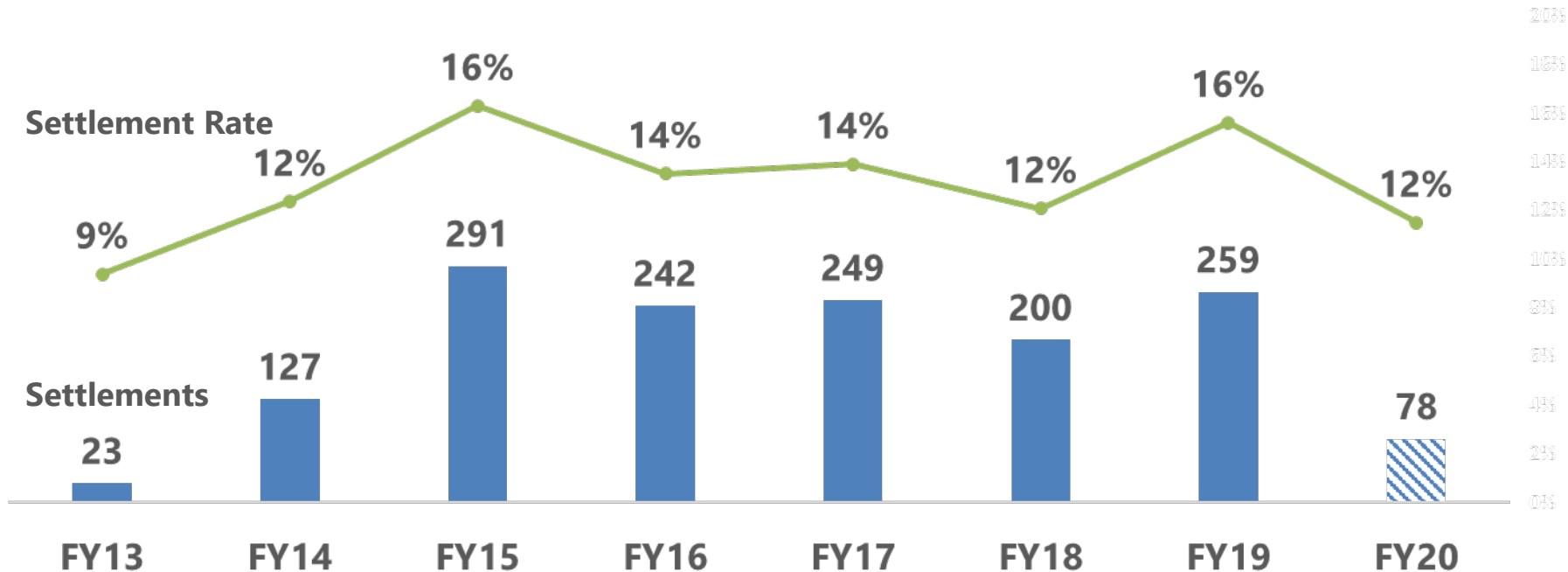


Institution rate for each technology is calculated by dividing petitions instituted by decisions on institution (i.e., petitions instituted plus petitions denied). The outcomes of decisions on institution responsive to requests for rehearing are excluded.



Pre-institution settlements

(FY13 to FY20: Oct. 1, 2012 to Mar. 31, 2020)

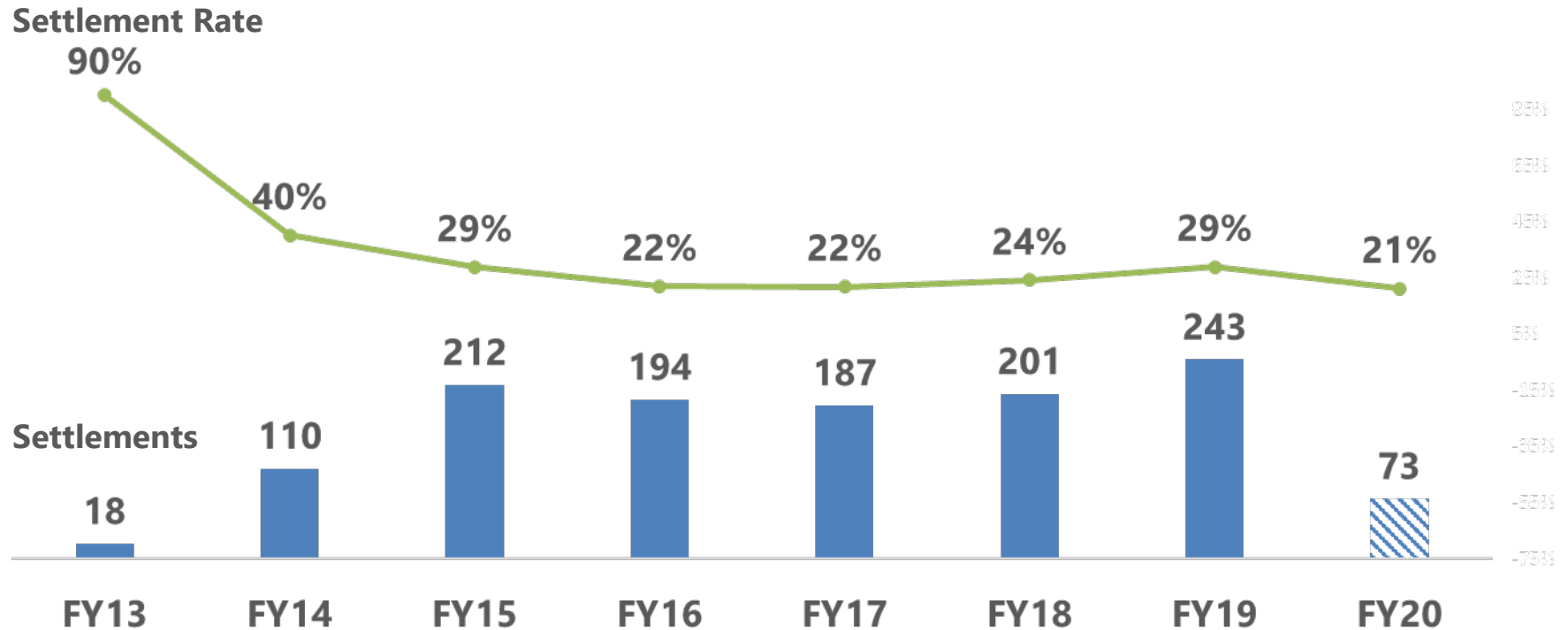


Settlement rate for each year is calculated by dividing pre-institution settlements by the sum of proceedings instituted, denied institution, dismissed, terminated with a request for adverse judgment, and settled before decision on institution.



Post-institution settlements

(FY13 to FY20: Oct. 1, 2012 to Mar. 31, 2020)

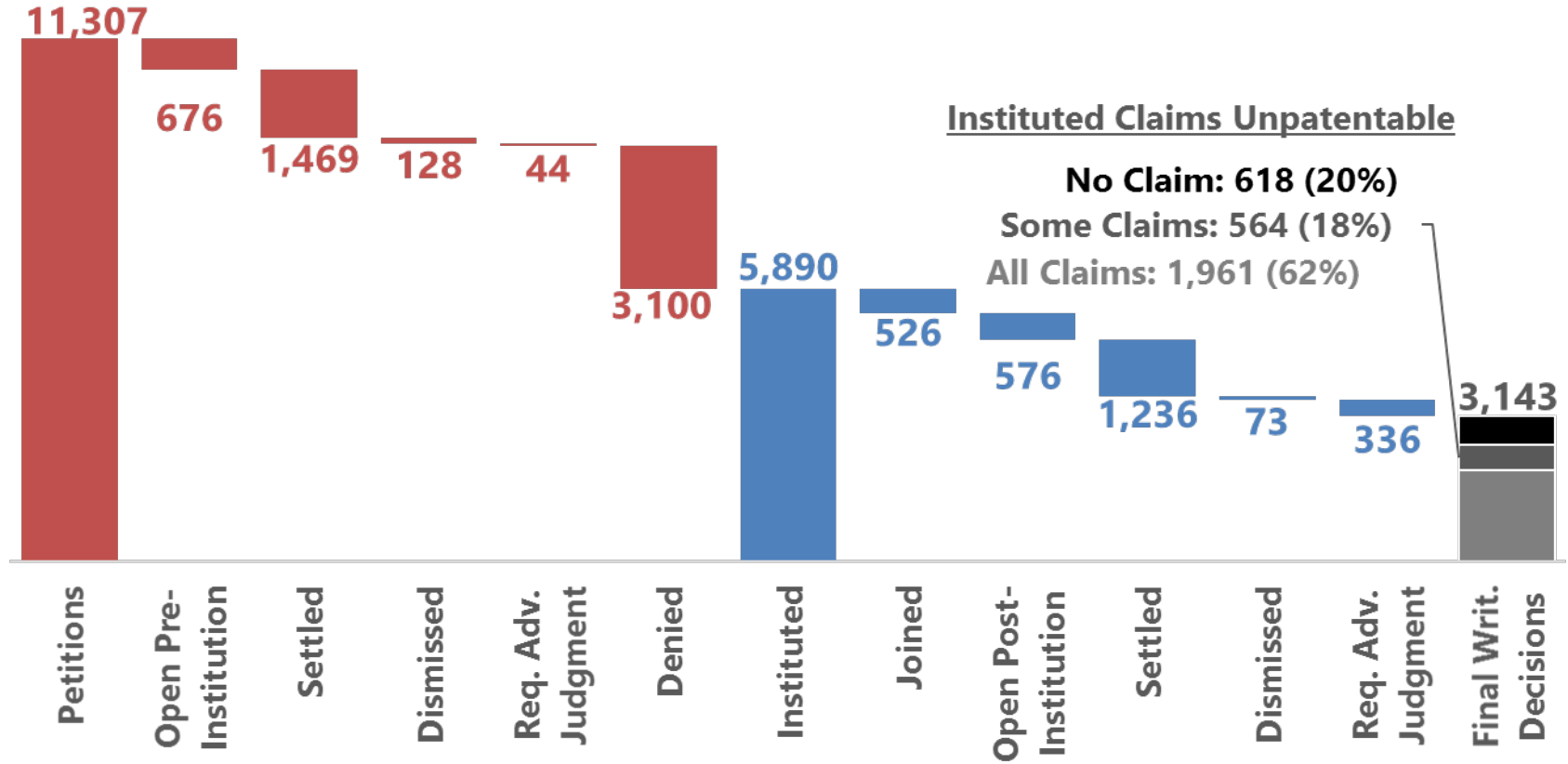


Settlement rate for each year is calculated by dividing post-institution settlements by proceedings terminated post-institution (i.e., settled, dismissed, terminated with a request for adverse judgment, and final written decision), excluding joined cases.



Status of petitions

(All Time: Sept. 16, 2012 to Mar. 31, 2020)

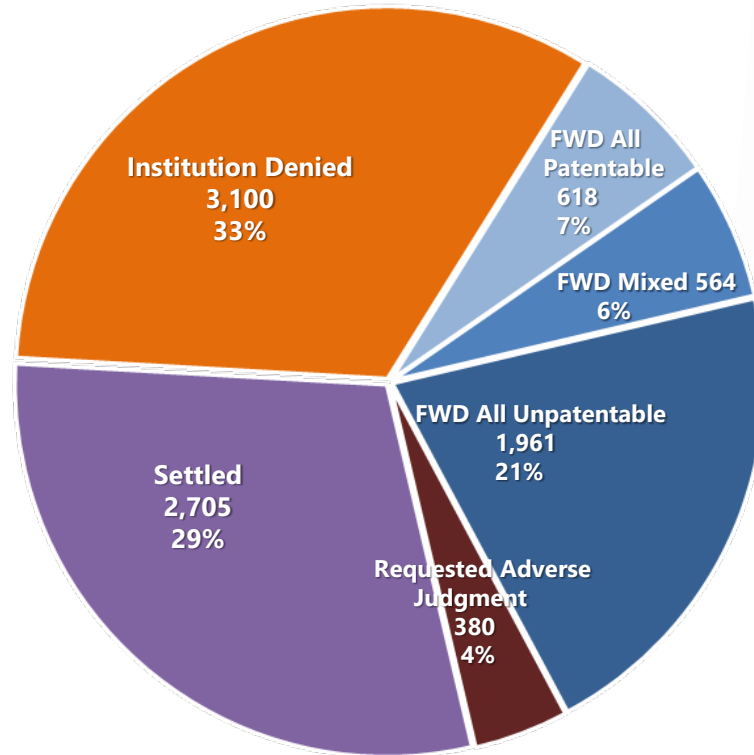


These figures reflect the latest status of each petition. The outcomes of decisions on institution responsive to requests for rehearing are incorporated. Once joined to a base case, a petition remains in the Joined category regardless of subsequent outcomes.

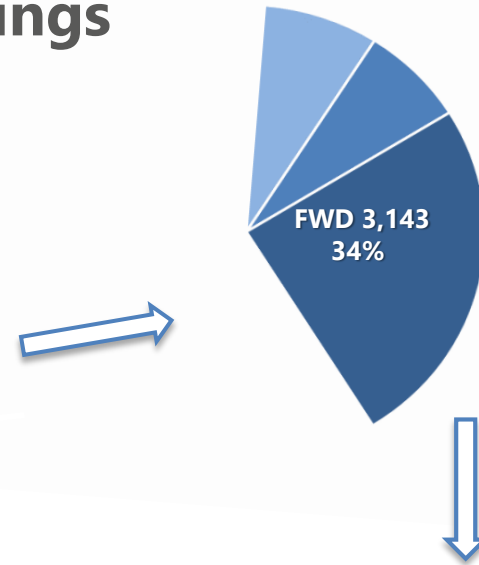


Outcome of concluded proceedings

(All time: Sept. 16, 2012 to Mar. 31, 2020)



Joined and dismissed cases are excluded.



Percentage of the Final Written Decisions

618 (20%)	FWD All Patentable
564 (18%)	FWD Mixed
1,961 (62%)	FWD All Unpatentable



Thank You

