

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Patent Trial and Appeal Board Motion to Amend Study

Installment 6: Update through March 31, 2020

Pre-pilot program closeout

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Motion to Amend Study: Installment 6 (Update through March 31, 2020)

In April 2016, after having completed more than 1,500 trials in more than three-and-one-half years of America Invents Act (AIA) trials,¹ the Board undertook a study of motions to amend (MTAs) to determine: 1) the number of MTAs that had been filed in AIA trials, both as a cumulative total and by fiscal year; 2) subsequent developments of each MTA; 3) the number of MTAs requesting to substitute claims that were granted, granted-in-part and denied-in-part, and denied; and 4) the reasons the Board provided for denying entry of substitute claims. The Motion to Amend Study and data supporting the study are available on the Board's website. *See* Motion to Amend Study (April 30, 2016, Installment 1), <https://go.usa.gov/xXXyT> (last visited June 29, 2020); Data for Completed Trials with a Motion to Amend, <https://go.usa.gov/xXXyZ> (last visited June 29, 2020).

The Board has continued to collect data on MTAs and has posted on its website second, third, fourth, and fifth installments of the Motion to Amend Study that analyze the same information as the original study. *See* Special Report Archive, Motion to Amend Studies, <https://go.usa.gov/xEmqb> (last visited June 29, 2020) (providing all Motion to Amend Study installments and data sets).

¹ Trials, i.e., instituted AIA proceedings, are counted as “completed” when they are terminated due to settlement, a request for adverse judgment, dismissal, or a final written decision. Further, joinders were counted as a single trial for purposes of the MTA statistics. Trials with a consolidated final written decision were counted as a single trial for all of the MTA statistics except for the numbers of MTAs filed by fiscal year and fiscal quarter, because those trials were not yet consolidated at the time an MTA was filed in each.

In this installment (the sixth), the Board provides another update to the Motion to Amend Study through March 31, 2020, to complete the pre-pilot program MTA data.² This installment also includes limited information and data for MTAs filed under the pilot program in Graphs I and V–VIII. Graphs II–IV, which are described in further detail below, focus on subsequent developments and dispositions of pre-pilot MTAs. As of March 31, 2020, only four trials eligible for pilot MTAs reached disposition at the Board. Thus, meaningful data on subsequent developments and dispositions of those motions were not yet available for pilot-eligible motions to amend. In Graphs V–VIII, however, the Board provides information and data reflecting how many motions to amend patent owners have filed under the pilot program and how patent owners have used the options available under the pilot.³

Graph I is a pie chart that shows the cumulative number of motions to amend (pre-pilot and pilot) that have been filed in AIA trials, both completed and pending,⁴ through March 31, 2020. Patent owners have filed at least one pre-pilot MTA in 504 of the 4,783 completed trials (11%) and, in total, have filed 506 pre-pilot MTAs.⁵ Because

² On March 15, 2019, the office implemented a pilot program for MTAs filed in AIA trials before the Board. *See* Notice Regarding a New Pilot Program Concerning Motion To Amend Practice and Procedures in Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board, 84 FR 9497 (Mar. 15, 2019). The pilot program applies to all AIA trials instituted on or after March 15, 2019. *Id.*

³ Graphs V and VI also include data for pre-pilot MTAs.

⁴ For purposes of Graph I, “pending” trials exclude trials with a request for rehearing of a final written decision and trials remanded from the United States Court of Appeals for the Federal Circuit.

⁵ In IPR2015-01190, the Board denied the patent owner’s MTA. The Federal Circuit vacated the Board’s denial and remanded the case for further proceedings. The Board authorized the patent owner to file a second MTA that the Board has not yet decided. Also, in IPR2017-01405, the patent owner filed two separate MTAs. Thus, although

MTAs are pilot-eligible only for cases instituted on or after March 15, 2019, patent owners have filed pilot-eligible motions to amend in 54 (9%) of the 576 pending trials and four (< 1%) of the 4,783 completed trials, for a total of 58 pilot-eligible MTAs as of March 31, 2020.

Graph II is a pie chart that depicts the subsequent developments of the pre-pilot MTAs, focusing on the outcomes of the 505 MTAs that patent owners filed in the 504 completed trials.⁶ The Board decided an MTA requesting to substitute claims in 335 of the 504 completed trials (66%). In the remaining 170 completed trials (34%), the MTA: a) requested solely to cancel claims (20 or 4%), b) was rendered moot because the panel of judges found the original claims patentable or because the panel of judges already decided an MTA proposing the same substitute claims (60 or 12%), or c) was not decided because the case terminated prior to a final written decision (90 or 18%).

Graph III is a pie chart that depicts the outcomes of the 335 pre-pilot MTAs requesting to substitute claims that the Board decided, i.e., the number of MTAs requesting to substitute claims that the Board granted, granted-in-part and denied-in-part, or denied. The Board granted or granted-in-part and denied-in-part an MTA in 46 of the 335 trials (14%) and denied an MTA in 289 of the 335 trials (86%).

patent owners filed an MTA in 504 completed trials, the total number of pre-pilot MTAs is 506 when taking into account the two MTAs filed in IPR2017-01405 and the two MTAs filed in IPR2015-01190.

⁶ As noted above, the patent owner in IPR2017-01405 filed two separate MTAs. Graph II includes the outcomes for both of those motions to amend. Graph II does not include the second motion to amend in IPR2015-01190 because, as noted above, the Board has not yet decided that motion.

Graph IV consists of two pie charts, focusing on the reasons provided for denying entry of substitute claims in the 308 trials in which the Board denied (289) or denied-in-part (19) a pre-pilot MTA. The Board's final written decisions identified at least one statutory ground of unpatentability, in 92% of trials or 283 trials. The Board's decisions in most of those cases are akin to an examiner rejecting a proposed amended claim because it is anticipated, obvious, not adequately described in the written description, indefinite, or directed to non-statutory subject matter. In the remaining 25 (8%) trials, the Board based a denial solely on procedural reasons related to the requirements for an MTA, e.g., the amendment was non-responsive to a ground of unpatentability, or the patent owner sought to amend an unchallenged claim.

Graph V is a bar chart that shows the total number of MTAs filed by fiscal year, including pre-pilot MTAs, pilot MTAs where the patent owner requested preliminary guidance from the Board, and pilot MTAs where the patent owner did not request preliminary guidance from the Board.

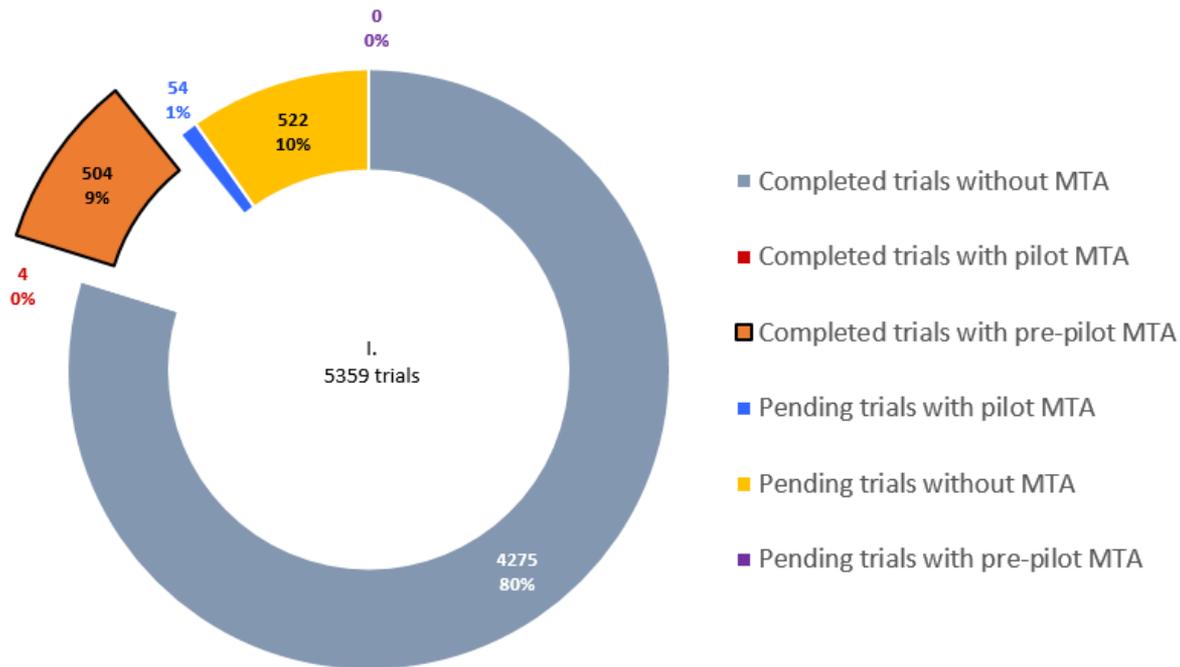
Graph VI is a bar chart that shows the number of MTAs filed by fiscal quarter, including pre-pilot MTAs, pilot MTAs where the patent owner requested preliminary guidance from the Board, and pilot MTAs where the patent owner did not request preliminary guidance from the Board. Graph VI shows that the total number of MTAs filed in each of the third quarter of fiscal year 2018 and the third quarter of fiscal year 2019 exceeds the number of MTAs filed in any other quarter.

Graph VII is a new pie chart that depicts whether patent owners requested preliminary guidance from the Board in relation to pilot-eligible MTAs. MTAs are eligible for the pilot program (and thus a request for preliminary guidance) in cases in which the Board instituted review on or after March 15, 2019. The earliest date on which pilot-eligible MTAs could be filed was June 7, 2019 (some filed as late as July of 2019 were pre-pilot based on the date of institution of the proceeding). For pilot-eligible MTAs filed through March 31, 2020, 48 out of 58 (83%) requested preliminary guidance from the Board, and 10 out of 58 (17%) did not.

Graph VIII is a new pie chart that depicts patent owner next filings after receiving preliminary guidance from the Board on an MTA. The Board issued the first preliminary guidance on an MTA under the pilot program on October 16, 2019, and the first filing by a patent owner after receiving the Board's preliminary guidance was on October 30, 2019. Graph VIII shows that as of March 31, 2020, after receiving the Board's preliminary guidance, in 17 of 29 cases (58%), the patent owner filed a revised MTA. In six of 29 cases (21%), the patent owner filed a reply in support of its initial MTA, and in six of 29 cases (21%), the MTA was withdrawn, the case was terminated, or the due date for the patent owner's next filing had not occurred as of March 31, 2020.

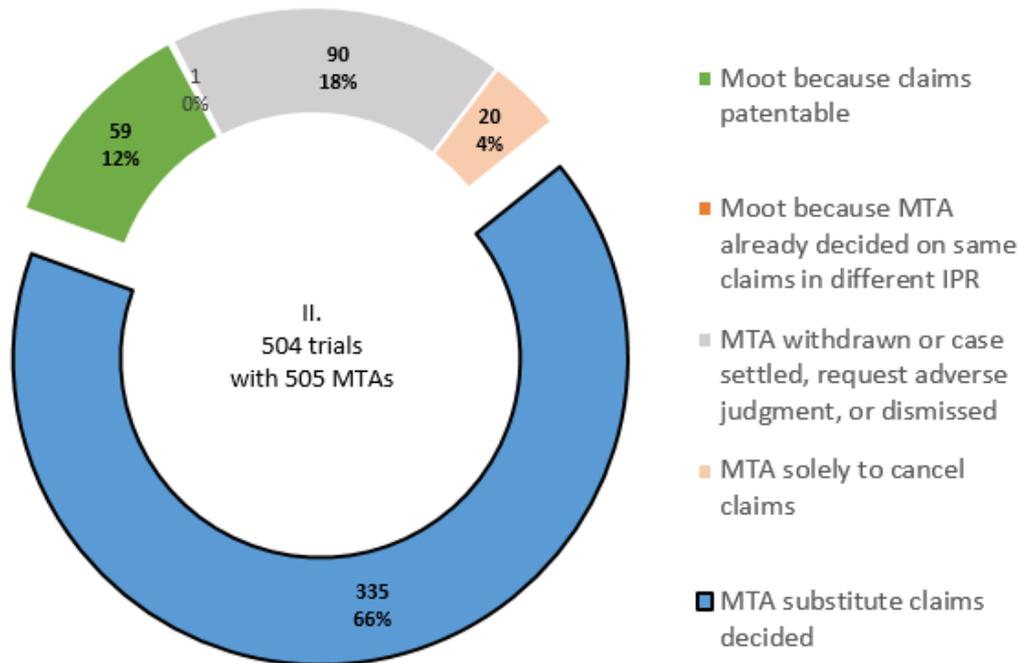
Graph I: Number of motion to amend (MTA) filings (FY13 to FY20: Oct. 1, 2012 to Mar. 31, 2020)

In how many trials are MTAs filed?



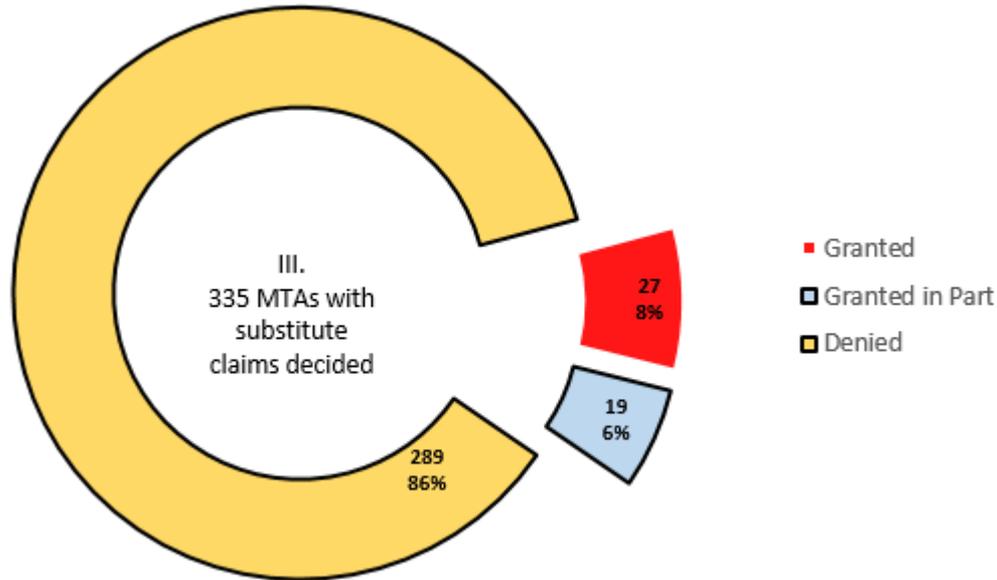
Graph II: Subsequent developments of pre-pilot MTAs (FY13 to FY20: Oct. 1, 2012 to Mar. 31, 2020)

Subsequent developments of the MTAs

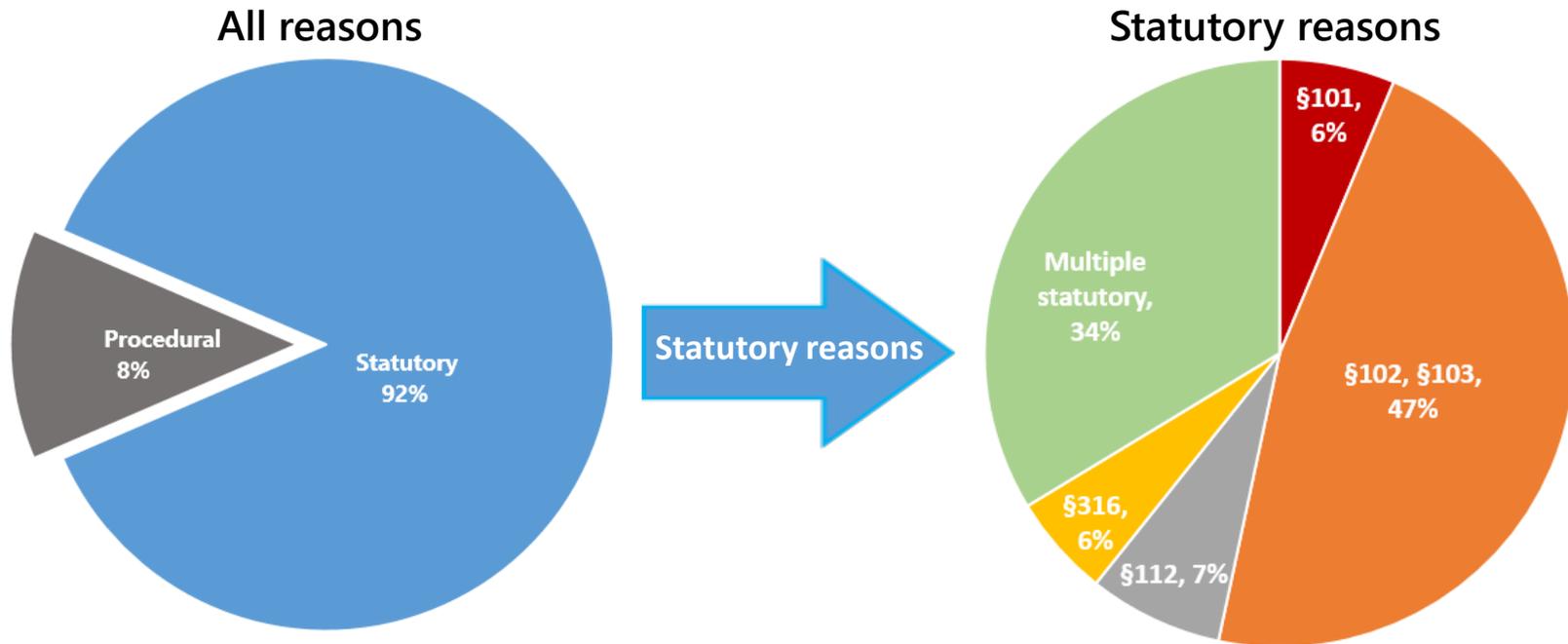


Graph III: Disposition of pre-pilot MTAs (FY13 to FY20: Oct. 1, 2012 to Mar. 31, 2020)

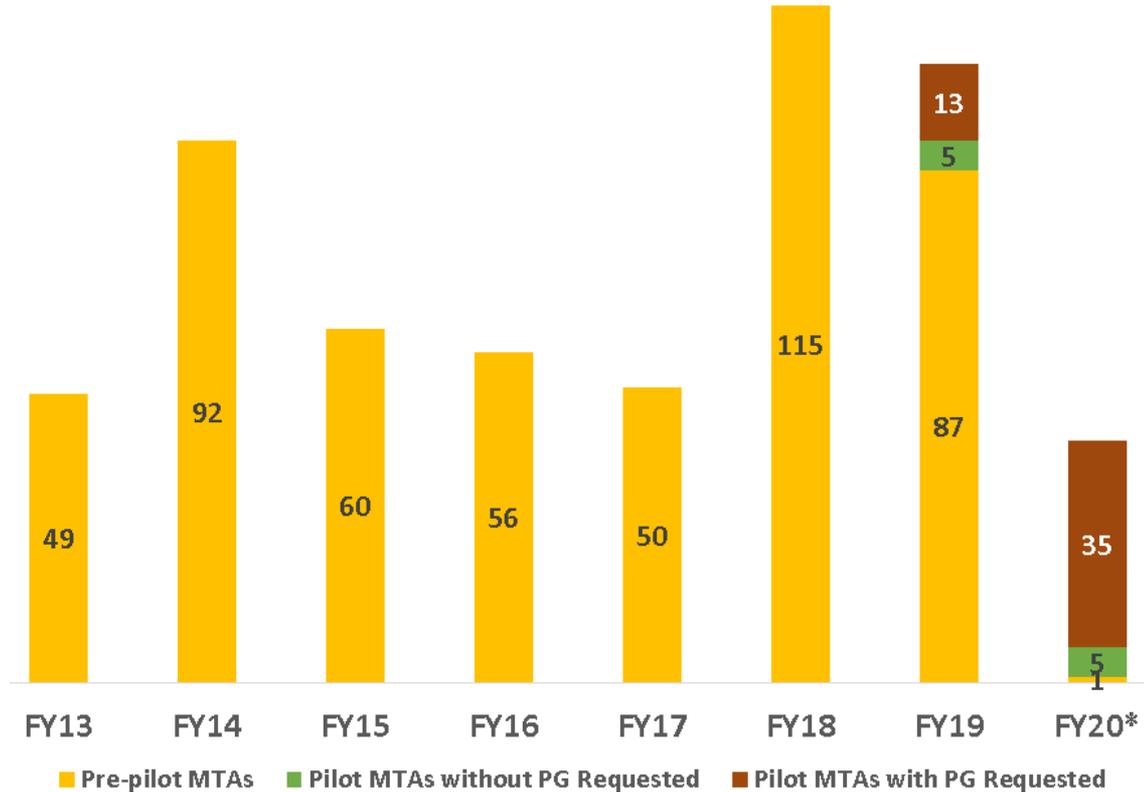
How many MTAs substituting claims are granted?



Graph IV: Reasons for denying entry of substitute claims for pre-pilot MTAs (FY13 to FY20: Oct. 1, 2012 to Mar. 31, 2020)



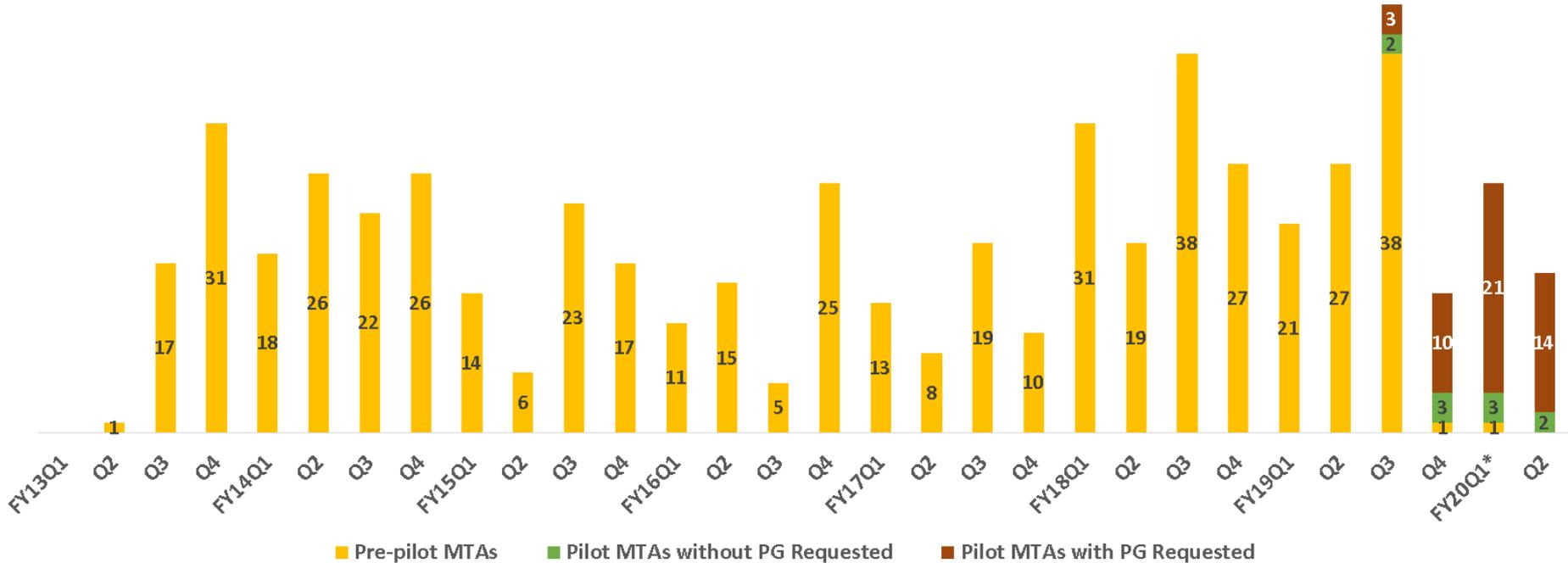
Graph V: MTAs filed by fiscal year (FY13 to FY20: Oct. 1, 2012 to Mar. 31, 2020)



* The one pre-pilot MTA filed in FY20 is a corrected MTA of an MTA originally filed in FY19. FY20 data is through March 31, 2020.



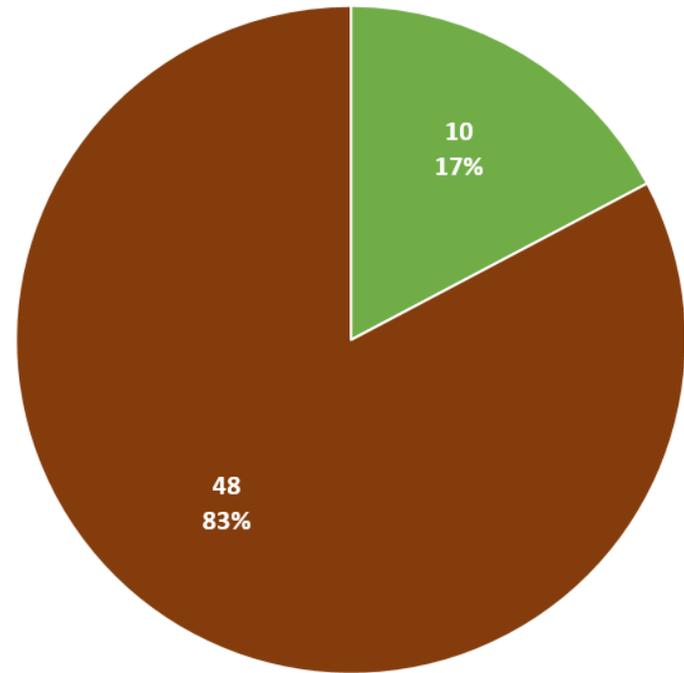
Graph VI: MTAs filed by fiscal quarter (FY13 to FY20: Oct. 1, 2012 to Mar. 31, 2020)



* The one pre-pilot MTA filed in FY20 Q1 is a corrected MTA of an MTA originally filed in FY19. FY20 data is through March 31, 2020.



Graph VII: MTAs filed under pilot program (Through Mar. 31, 2020)



■ MTAs without PG Request ■ MTAs with PG Request



Graph VIII: Patent owner filings after preliminary guidance (Through Mar. 31, 2020)

