

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Patent Trial and Appeal Board (PTAB) update

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November 19, 2020

Patent Public Advisory Committee quarterly meeting

UNITED STATES
PATENT AND TRADEMARK OFFICE



Agenda

- Highlights of annual report
- *Advanced Bionics*
- Multiple petitions
- Overview of CBM

Highlights of annual report

PPAC Annual Report - PTAB

- Ex parte appeals
- AIA trials
- New procedures and improvements
- Designated decisions
- Operational efforts

Advanced Bionics

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).
 - whether the same or substantially the same art previously was presented to the office or whether the same or substantially the same arguments previously were presented to the office; and
 - if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the office erred in a manner material to the patentability of challenged claims.
 - After applying the framework, the Board determined that the petition presented 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.

Multiple petitions

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 ≤ 90 days apart

Serial petition: Petitioner's result

Filed > 90 days apart

First 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:

FY	Challenges	Serial petition attempts	Attempt rate	Serial petition successes	Success rate
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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 serial 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.

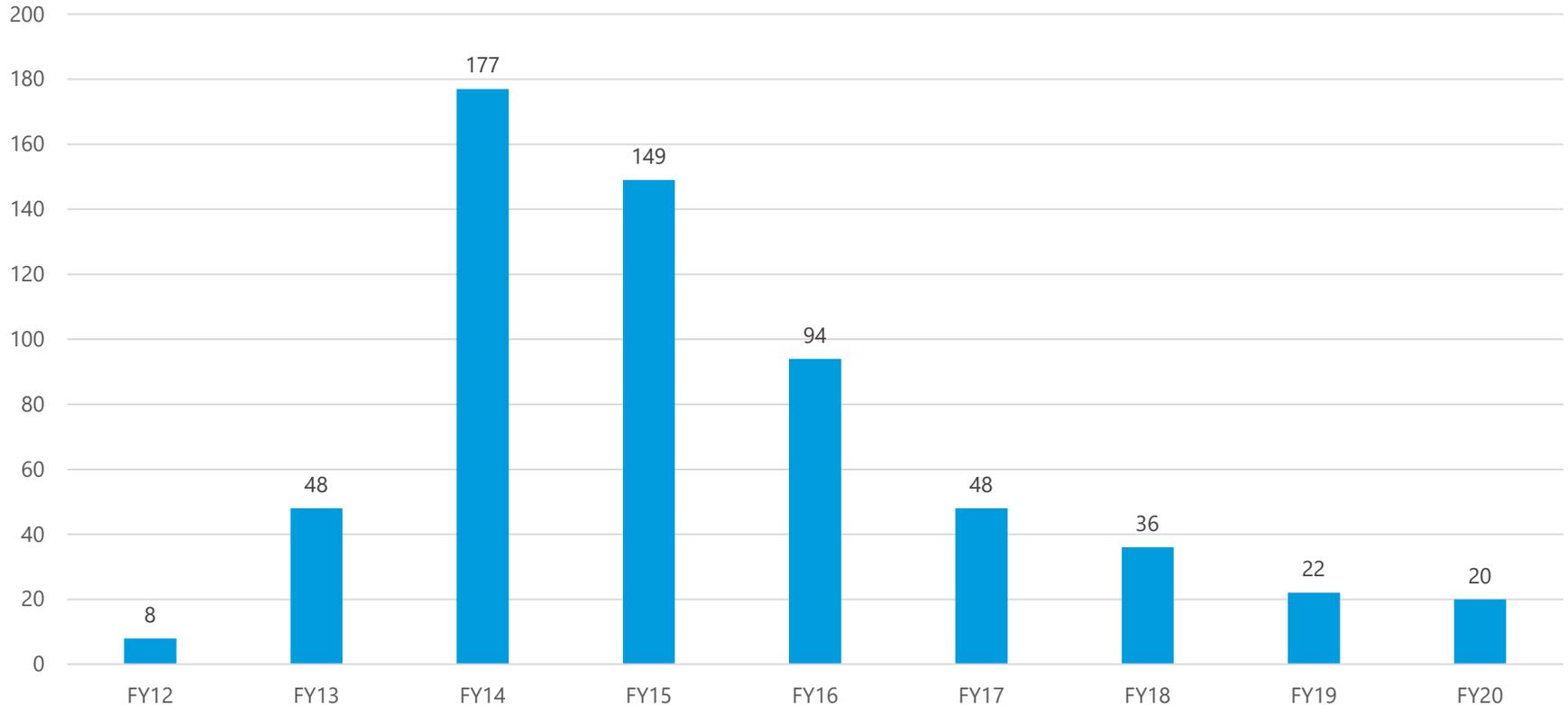
Overview of CBM

CBM proceedings

- Under § 18(a) of the AIA, the transitional program for post-grant review of CBM patents sunset on September 16, 2020.
- Although the program has sunset, existing CBM proceedings, based on petitions filed before September 16, 2020, are still pending.
- The filing of CBM petitions has steadily declined since FY 2014, when filings peaked at 177 CBM petitions. By contrast, in FY 2020, petitioners filed only 20 CBM petitions, with 8 being filed right before the program sunset last month. The year before, in FY 2019, petitioners likewise filed only 22 CBM petitions.

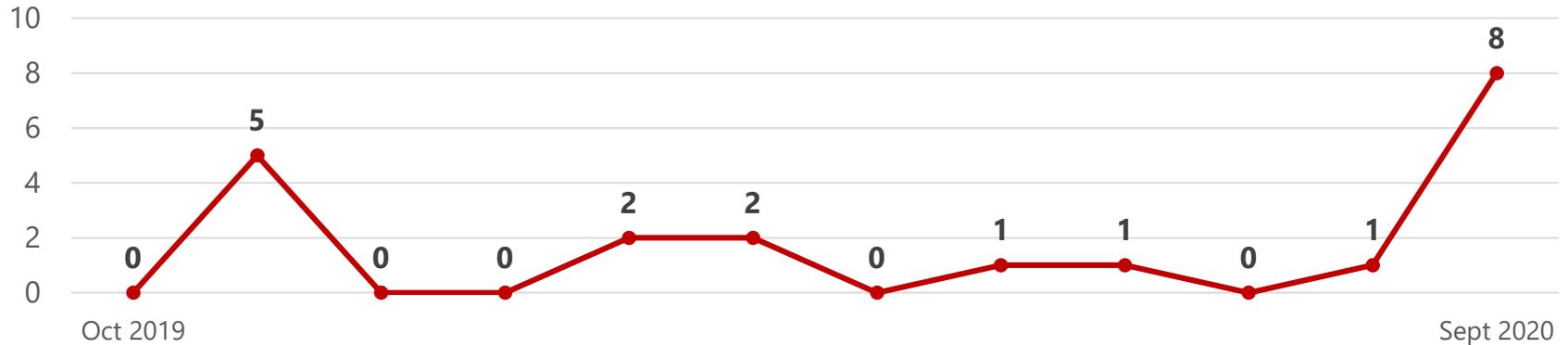
CBM petition filings by fiscal year

CBMs filed

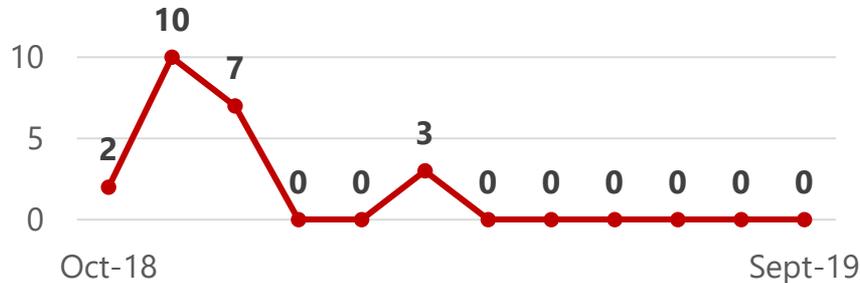


CBM petition filings by month

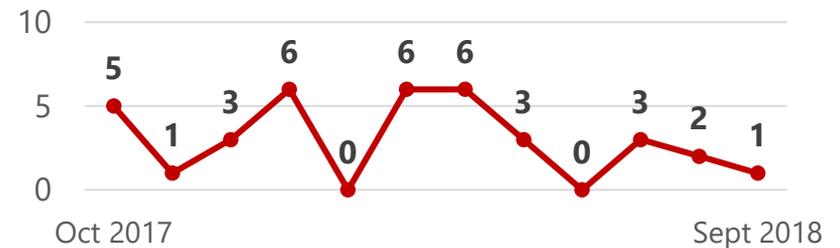
20 CBMs in FY20



22 CBMs in FY19



36 CBMs in FY18



Questions and comments

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