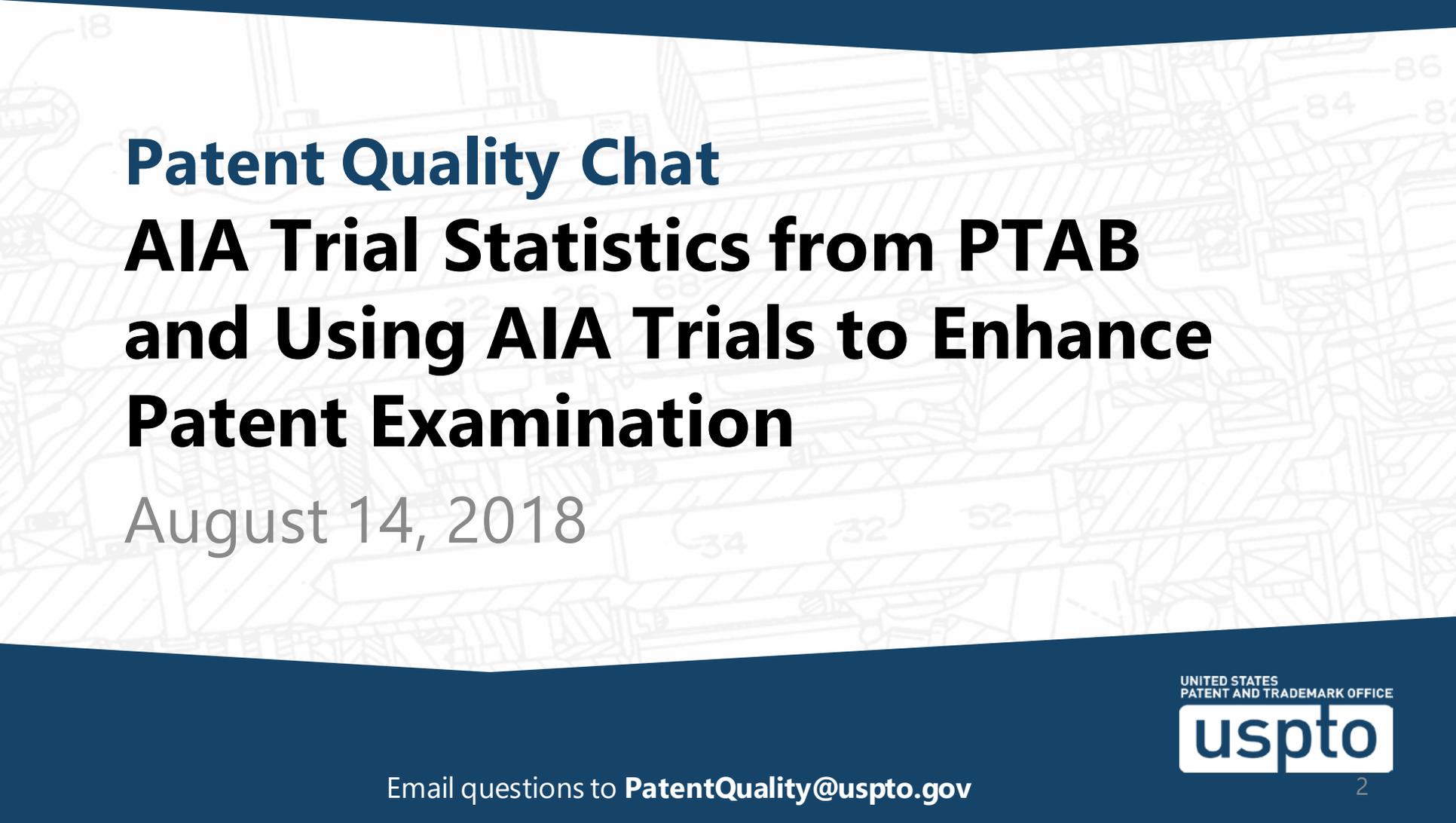


UNITED STATES
PATENT AND TRADEMARK OFFICE



Email questions to PatentQuality@uspto.gov



Patent Quality Chat

AIA Trial Statistics from PTAB

and Using AIA Trials to Enhance

Patent Examination

August 14, 2018

UNITED STATES
PATENT AND TRADEMARK OFFICE



Email questions to PatentQuality@uspto.gov

To send in questions or comments during the webinar, please email:

PatentQuality@uspto.gov

UNITED STATES
PATENT AND TRADEMARK OFFICE



Email questions to **PatentQuality@uspto.gov**

<http://www.uspto.gov/patentquality>

Patent Quality

Providing high-quality, efficient examination of patent applications is paramount to [our mission](#) at USPTO. To ensure we continue to issue high-quality patents that will fuel innovation well into the future, the [Office of the Deputy Commissioner for Patent Quality](#), along with our partners across the Patents organization, promotes and supports the continuous improvement of patent products, processes and services through collaboration with internal and external stakeholders of the intellectual property community.

Highlights



[Patent Quality Chat](#)

Our next Patent Quality Chat will be on August 14th on "AIA Trial Statistics from PTAB and Using AIA Trials to Enhance Patent Examination."

[Quality Metrics](#)

See our new metrics approach, categorizing into product, process and perception indicators.

[Stakeholder Training on Examination Practice and Procedure \(STEPP\)](#)

Sign up for an upcoming training developed for those interested in a better understanding of the examination process at the USPTO.



Email questions to PatentQuality@uspto.gov

<http://www.uspto.gov/patent/initiatives/patent-quality-chat>

- 1 Patent Quality Chat
- 2 Join the Webinar
- 3 **2018 Chat Series**
- 4 Previous Events
- 5 General Information

2018 Chat Series

Date	Topic	Speaker
Tuesday, August 14 Noon - 1 p.m. ET	AIA Trial Statistics from PTAB and Using AIA Trials to Enhance Patent Examination <ul style="list-style-type: none">• Presentation Slides (coming soon)• Video (coming soon)	<ul style="list-style-type: none">• Janet Gongola Vice Chief Judge for Engagement, Patent Trial and Appeal Board• Jack Harvey Assistant Deputy Commissioner for Patent Operations
Tuesday, July 10 Noon - 1 p.m. ET	Improving Access to Global Patent Data <ul style="list-style-type: none">• Presentation Slides• Video	<p>Speakers</p> <ul style="list-style-type: none">• Nelson Yang Acting Director of International Patent Business Solutions in the Office of International Patent Cooperation• Jocelyn Ram Patent Business Analyst in the Office of International Patent Cooperation

Email questions to PatentQuality@uspto.gov

Patent Quality Chat

AIA Trial Statistics from PTAB and Using AIA Trials to Enhance Patent Examination

Janet Gongola

Vice Chief Judge for Engagement, Patent Trial and Appeal Board

Jack Harvey

Assistant Deputy Commissioner for Patent Operations, Office of the Commissioner for Patents

UNITED STATES
PATENT AND TRADEMARK OFFICE



Email questions to PatentQuality@uspto.gov

Patent Trial and Appeal Board (PTAB) - Overview

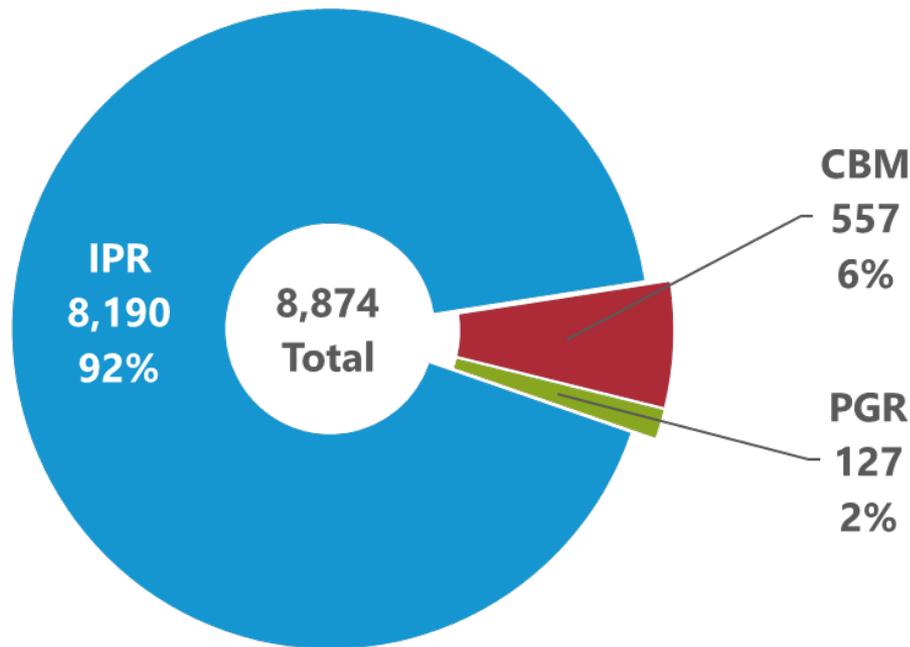
- AIA Trial Statistics
- Upcoming Studies
- Recent AIA Trial Developments



Petitions by Trial Type

(All Time: 9/16/12 to 7/31/18)

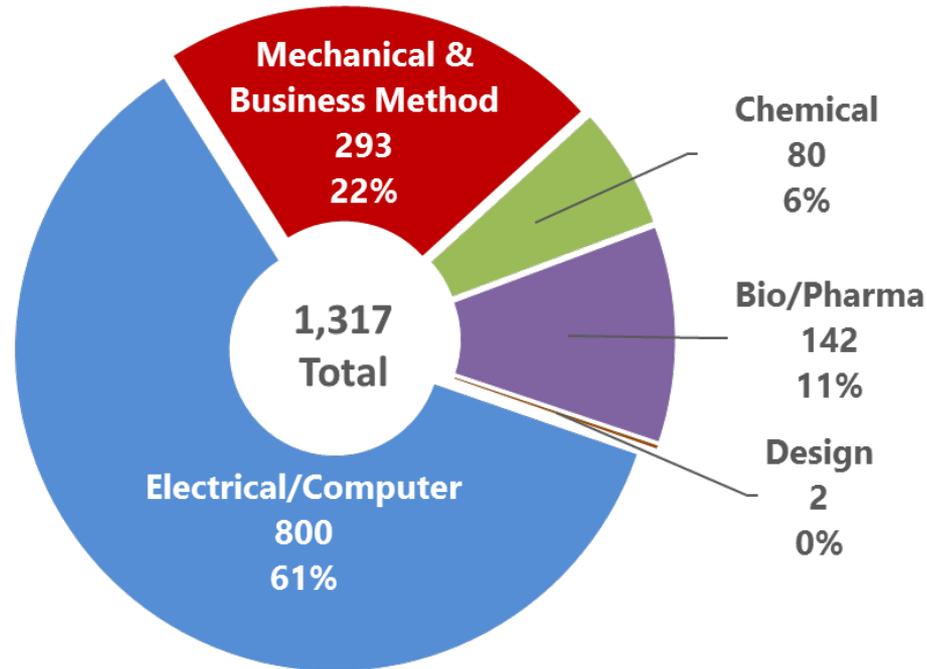
Trial types include Inter Partes Review (IPR), Post Grant Review (PGR), and Covered Business Method (CBM).



Email questions to PatentQuality@uspto.gov

Petitions Filed by Technology in FY18

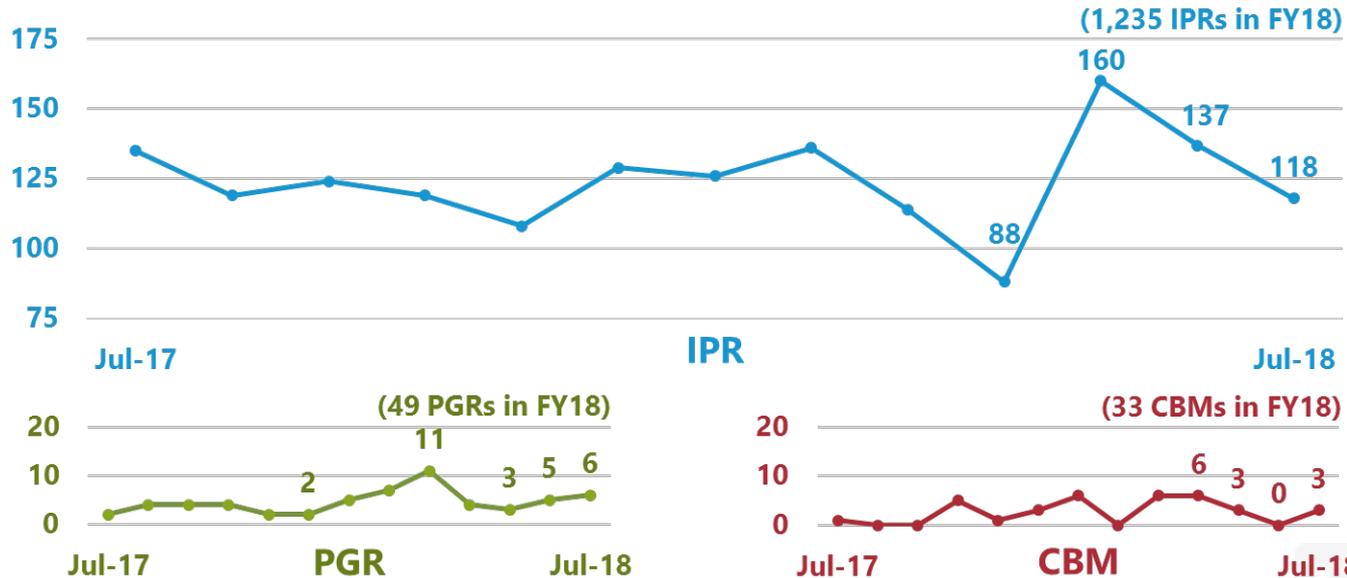
(FY18 to date: 10/1/17 to 7/31/18)



Email questions to PatentQuality@uspto.gov

Petitions Filed by Month

(July 2018 and Previous 12 Months: 7/1/17 to 7/31/18)

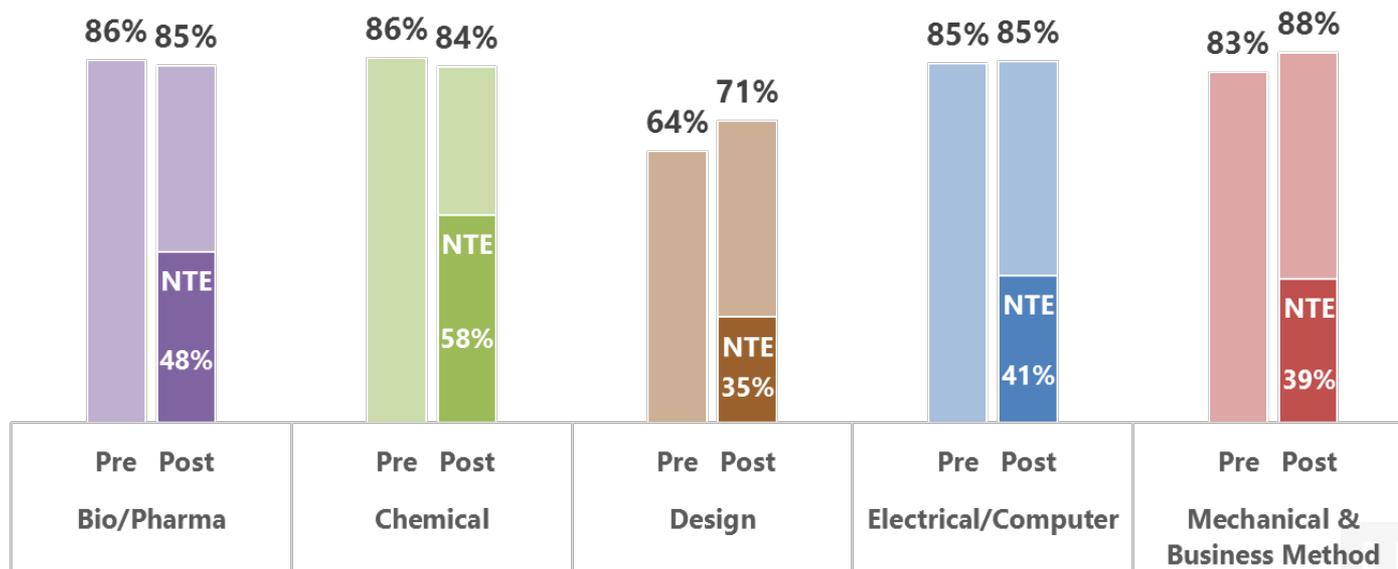


Email questions to PatentQuality@uspto.gov

Preliminary Response Filing Rates

Pre- and Post-Rule To Allow New Testimonial Evidence (NTE)

(All Time: 9/16/12 to 7/31/18)

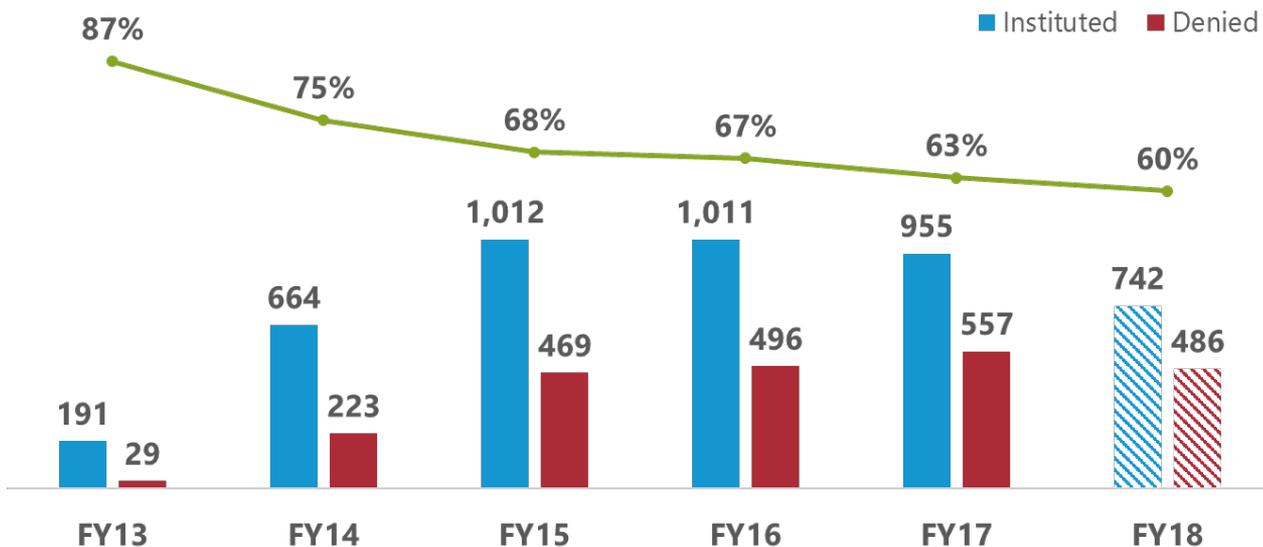


The rule to allow new testimonial evidence was effective May 2, 2016.



Institution Rates

(FY13 to FY18: 10/1/12 to 7/31/18)

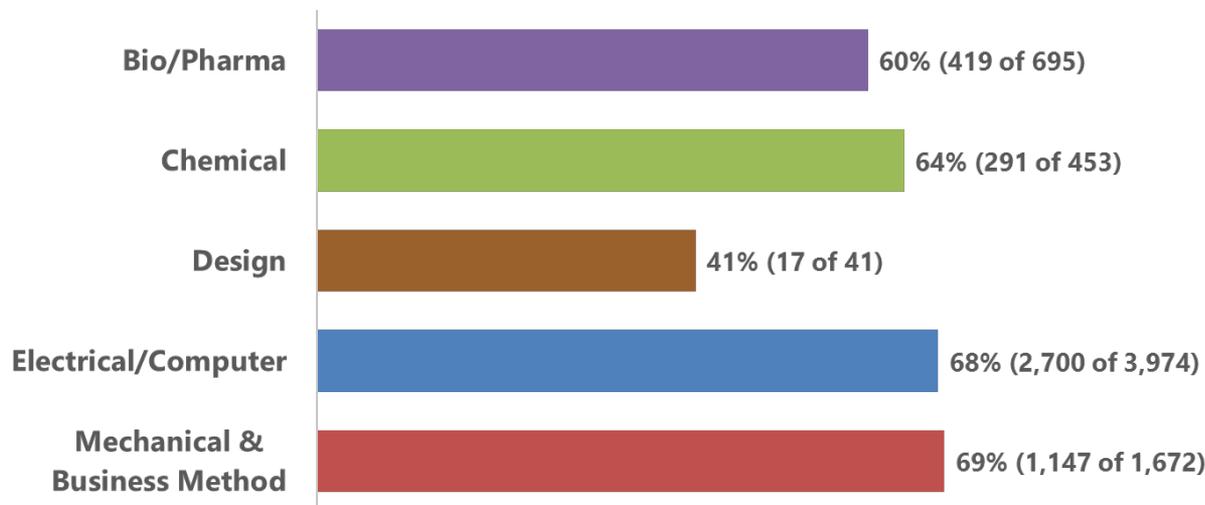


Institution rate for each fiscal year is calculated by dividing petitions instituted by decisions on institution (i.e., petitions instituted plus petitions denied). The outcomes of decisions on institution responsive to requests for rehearing are excluded.



Institution Rates by Technology

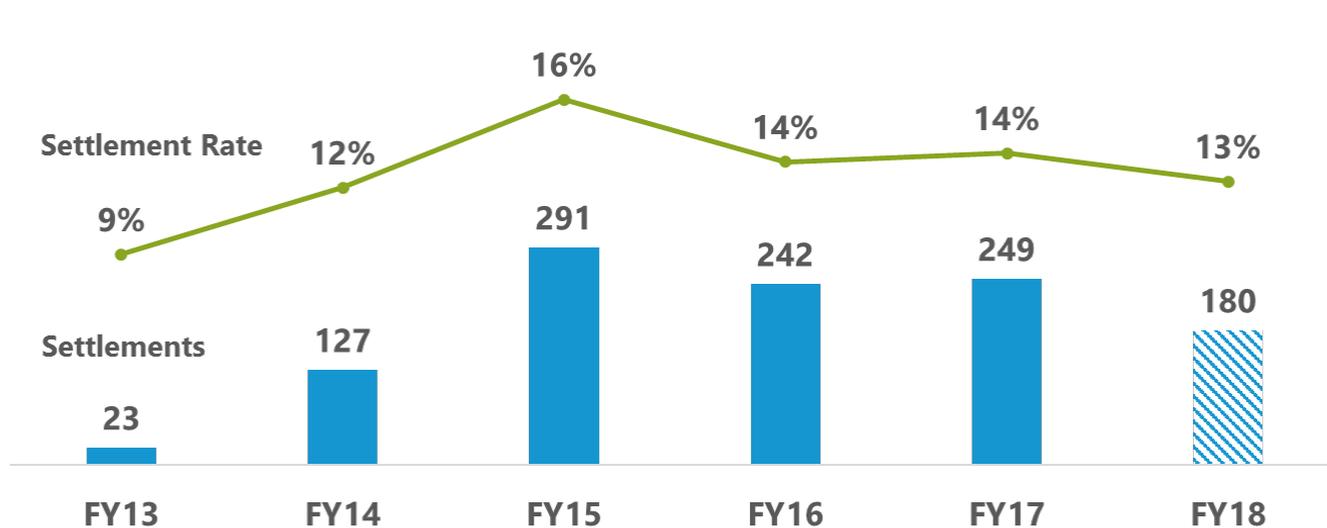
(All Time: 9/16/12 to 7/31/18)



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 FY18: 10/1/12 to 7/31/18)

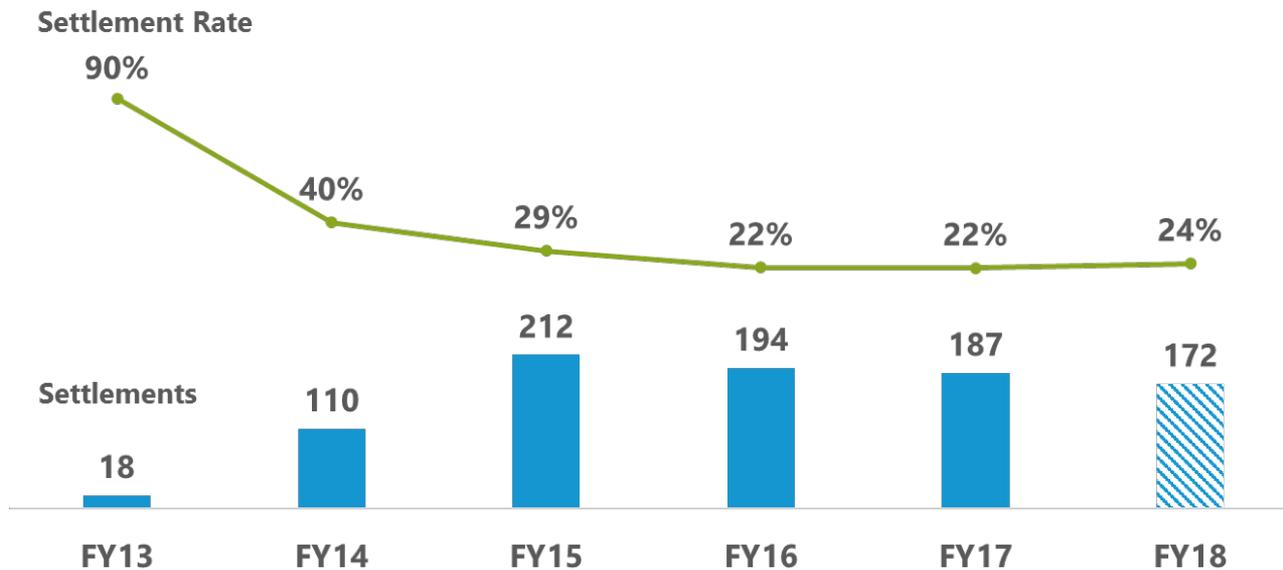


2000
1000
1000

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.



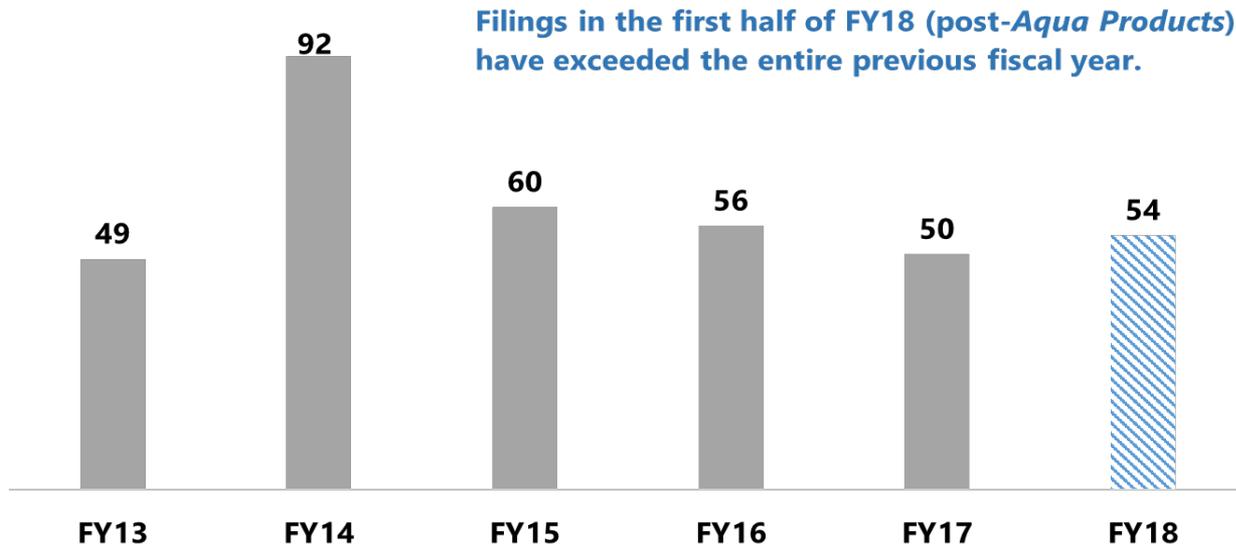
Post-Institution Settlements (FY13 to FY18: 10/1/12 to 7/31/18)



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.

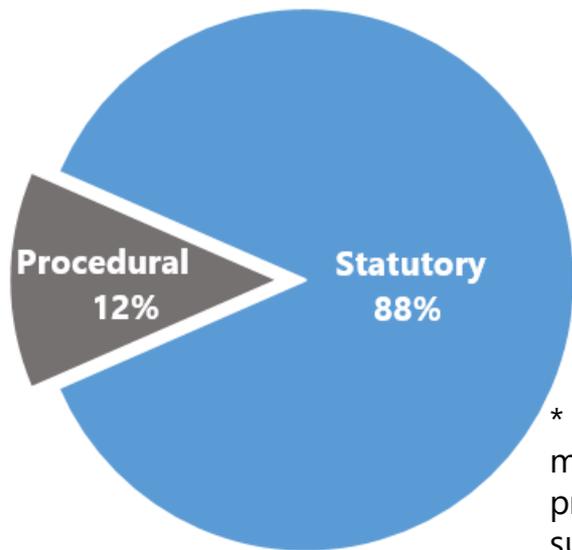


Motions to Amend Filed by Fiscal Year (FY13 to FY18: 10/1/12 to 3/31/18)

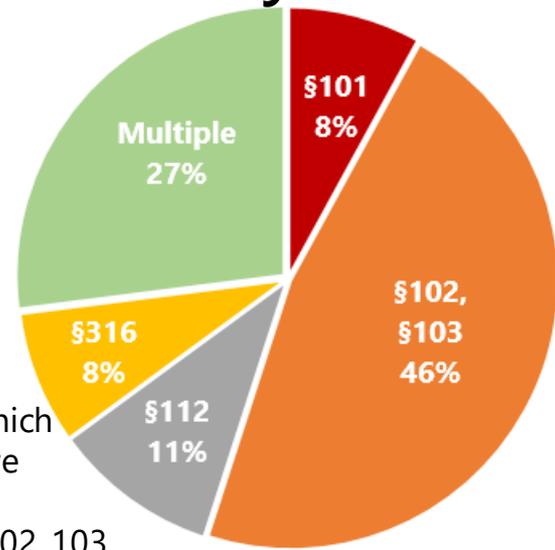


Reasons for Denial of Motions to Amend (FY13 to FY18: 10/1/2012-3/31/2018)

All Reasons



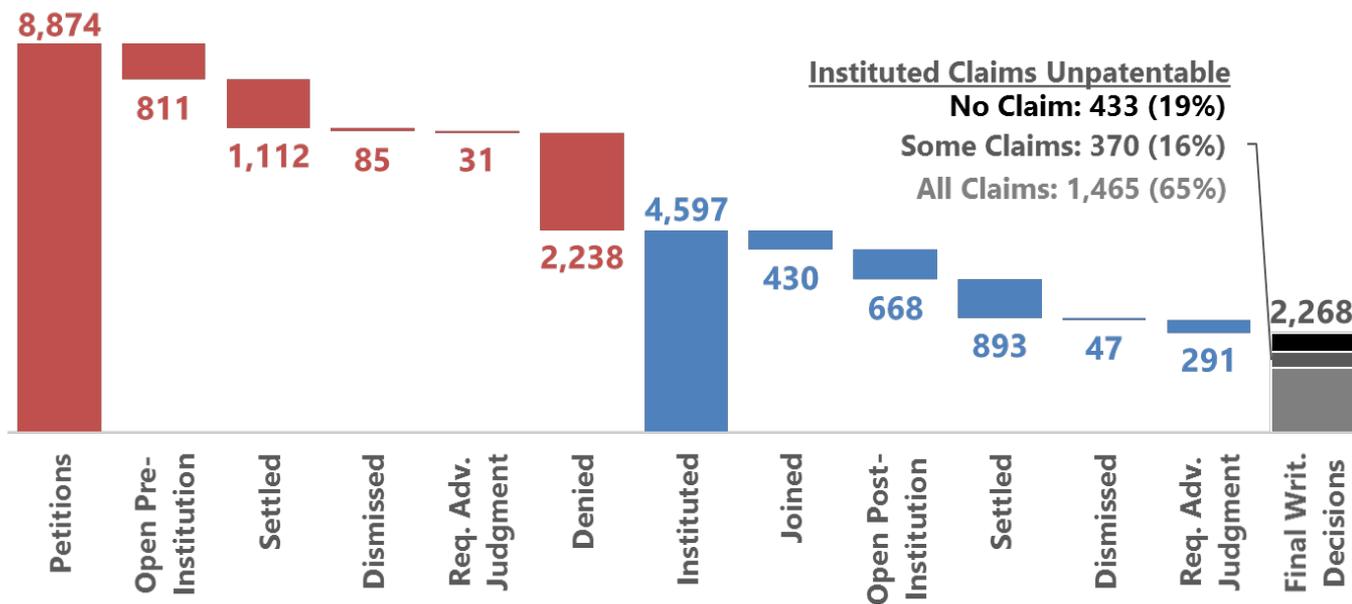
Statutory Reasons



* All but one of the cases in which multiple statutory reasons were provided for denying entry of substitute claims included §§ 102, 103 and/or 112 as a reason for denial.

Status of Petitions

(All Time: 9/16/12 to 7/31/18)



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.



Parallel Proceeding Study

- Goal = explore the interaction between parallel proceedings at the USPTO (e.g., AIA trials, reexam, and reissue) involving issued patents
- Joint effort between PTAB and Central Reexamination Unit (CRU)
- Study will consider:
 - Number of proceedings filed against each patent;
 - Identity of the party filing each proceeding;
 - Timing of each proceeding; and
 - Whether any proceeding is/was stayed pending outcome of the AIA trial



Section 325(d) Study

- Goals
 - Evaluate the extent to which AIA proceedings are revisiting issues previously addressed by the USPTO;
 - Understand the reasons for the different results in cases with fully or partially overlapping art, with those results perhaps usable to improve original prosecution; and
 - Assess why panels do or do not accept § 325(d) arguments
- Coordinating with Patents
- Study uses cases in which a patent owner raised a § 325(d) argument as a proxy for the set of cases in which similar or the same issues might exist

Claim Construction Notice of Proposed Rule Making (NPRM)

83 Fed. Reg. 21,221 (May 9, 2018)

- Proposed to apply the same claim construction standard in an AIA trial proceeding as that used in a civil action to invalidate a patent
- Also proposed that PTAB will consider any prior claim construction determination concerning a term of the claim in a civil action, or a proceeding before the International Trade Commission, that is timely made of record



Claim Construction NPRM con't

83 Fed. Reg. 21,221 (May 9, 2018)

- Public comments were due on or before July 9
- 374 comments received:
 - 297 from individuals;
 - 45 from associations;
 - 31 from corporations; and
 - 1 from a law firm



Trial Practice Guide,

August 2018 Update. 83 Fed. Reg. 39989 (August 13, 2018)

<https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/ptab-trial-practice-guide-august-2018>

- Provide further guidance about standard practices during AIA trials, accounting for almost six years of experience with trials
- Original Trial Practice Guide published in August 2012, concurrent with the promulgation of the AIA Trial Rules
- May be additional updates in the future



Trial Practice Guide - Highlights

(August 2018 Update)

- Use of expert testimony;
- Consideration of various non-exclusive factors in the determination of whether to institute a trial;
- Sur-replies to principal briefs as a matter of right;
- Distinction between motions to exclude and motions to strike, and the proper use of each;
- Procedures for oral hearing before the Board, including the use of live testimony, sur-rebuttal, and default time for the hearing; and
- Pre-hearing conference and potential early resolution of issues

Learn More about PTAB

<https://www.uspto.gov/patents-application-process/patenttrialandappealboard>

Home / Patents: Application Process / Patent Trial and Appeal Board

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.



Trials

Manage or review pending inter parte review, post-grant review, covered business method, derivation, and interference proceedings.



Appeals

Manage or review proceedings directed to adverse decisions of examiners in patent applications, reissue applications, and reexaminations of issued patents.



Decisions

Browse public final agency decisions of PTAB, including decisions designated as precedential or informative.



Hearings

Review guidance, schedules, and inclement weather advisories for oral arguments for appeals, interferences, and trials.



Resources and guidance

Learn about the Patent Trial and Appeal Board or find key policies, procedures, forms, and guidance.



Statistics

View performance benchmarks of the PTAB, including dispositions, pendency, inventory, and other tracking measures.



PTAB Data Tools and IT Systems

Stay informed regarding maintenance events, obtain direct access to PTAB automated information sharing platforms, subscribe for updates, or provide feedback.



PTAB Events

Find where our judges are speaking and learn more about events sponsored by PTAB.



About PTAB

Discover the history of the PTAB and map out its modern structure and mission.

Guidance on SAS NEW

[Notice of Proposed Rulemaking of Claim Construction Standard used in PTAB AIA Trial Proceedings NEW](#)

Upcoming PTAB events

[Impact of SAS, Motion to Amend Practice, and Claim Construction in Trial Proceedings](#)
Jun 5, 2018 12:00 PM ET

[Motions to Exclude and Motions to Strike in AIA Trial Proceedings](#)
Jun 7, 2018 12:00 PM ET

[PTAB/TTAB Stadium Tour at University of San Diego School of Law](#)
Sep 20, 2018 10:00 AM PT
San Diego, CA



Post Grant Outcomes Program - Overview

- AIA Proceedings Overview
- Examiner Navigation and Usage
- Post Grant Outcomes Statistics

AIA Proceedings: Overview

On September 16, 2012, the America Invents Act (AIA) established four new Patent Trial and Appeal Board (PTAB) proceedings:

- Inter Partes Review (IPR),
- Post Grant Review (PGR),
- Transitional Program for Covered Business Method Patents (CBM), and
- Derivation (DER).

These proceedings allow third-party petitioners to challenge claims in an issued patent at the PTAB without resorting to litigation.



AIA Proceedings: The Petition

- Each type of AIA proceeding (IPR, PGR, CBM, and DER) begins with **the filing of a petition** for instituting a trial.
- For examiners of related applications (i.e., CONs, CIPs, DIVs), there may be prior art in the petition that will lead to a more informed patentability decision in the related application(s) currently pending before them.
- The Post Grant Pilot revealed that IPR petitions are highly relevant for locating prior art for use in related child applications.
- Petitions in AIA proceedings are accessed using the Patent Trial and Appeal Board End-to-End system (PTAB-E2E).



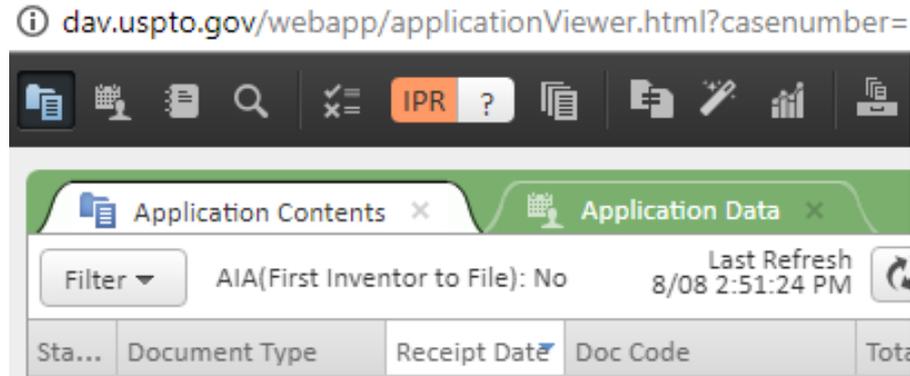
Examiner Notification

- To bring the AIA trial petitions to the examiner, the examiners' docket management tool, PE2E-DAV, has been updated to include an indicator to notify examiners whenever they have a case related to an issued patent undergoing an AIA trial.



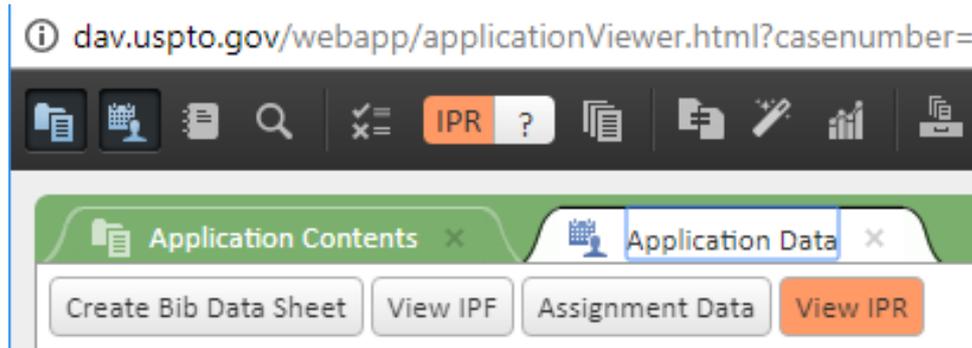
New Indicator

- When an application is opened in PE2E-DAV, the orange colored IPR box in the top center of the image below is visible if an AIA petition has been filed in a related patent.



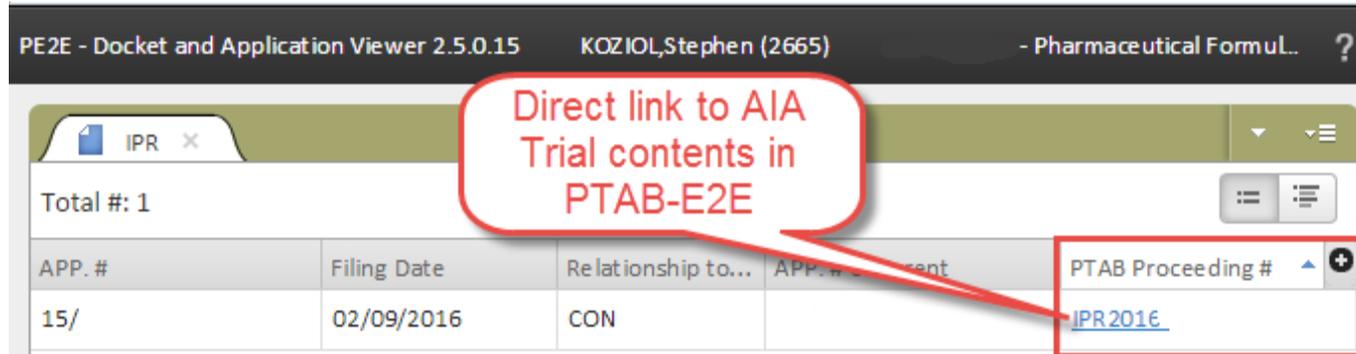
Two Level Notification

- Also, under the Application Data tab, the orange View IPR tab box is highlighted



Accessing the Trial Proceedings

- Clicking either orange button opens a new window listing all AIA trials in related patents:



PE2E - Docket and Application Viewer 2.5.0.15 KOZIOL,Stephen (2665) - Pharmaceutical Formul.. ?

IPR x

Total #: 1

APP. #	Filing Date	Relationship to...	APP. #	Parent	PTAB Proceeding #
15/	02/09/2016	CON			IPR2016

Accessing PTAB-E2E

- The link in the "PTAB Proceeding #" column leads directly to the contents of the corresponding AIA trial in PTAB-E2E:

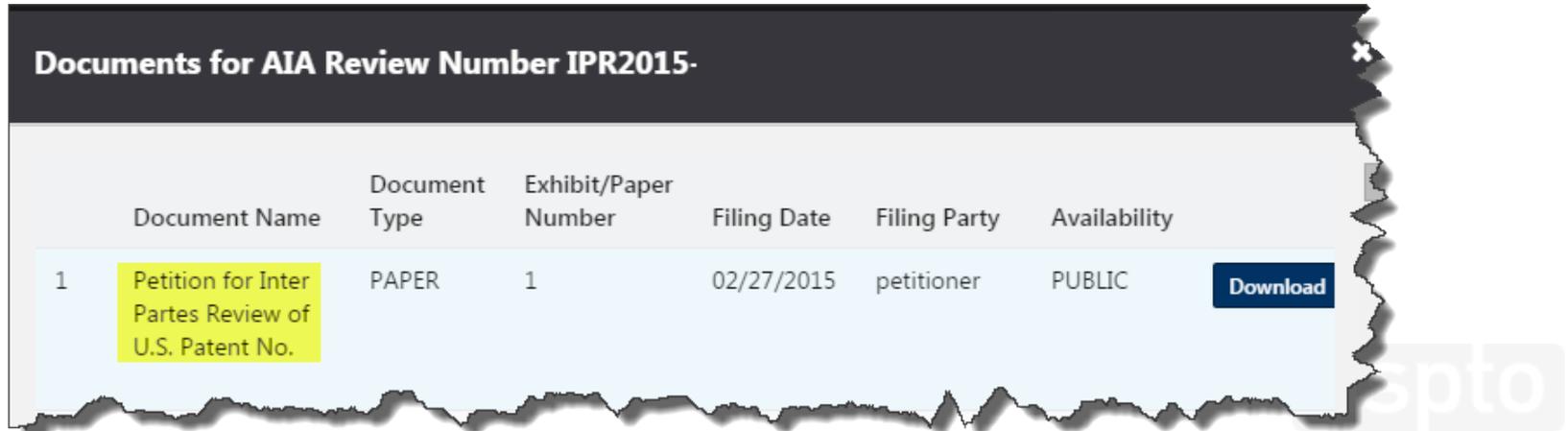


uspto About Us Careers Contact Us							
Patent Trial and Appeal Board							
Documents for Proceeding IPR2016-							
	Document Name	Document Type	Exhibit/Paper Number	Filing Date	Filing Party	Availability	
1	Refund Request	PAPER	12	08/05/2016	petitioner	PUBLIC	View Document
2	007 Petition	PAPER	1	04/06/2016	petitioner	PUBLIC	View Document
3	Power of Attorney	PAPER	2	04/06/2016	petitioner	PUBLIC	View Document
4	Notice of Filing Date Accorded to Petitioner	PAPER	3	04/12/2016	board	PUBLIC	View Document

Email questions to PatentQuality@uspto.gov

Accessing the Petition

- The Petition is usually among the first documents in the file wrapper.
- By selecting Download, the Petition will open as a PDF.



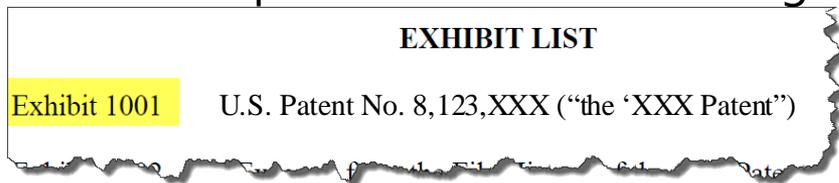
The screenshot shows a web interface titled "Documents for AIA Review Number IPR2015-". It contains a table with the following columns: Document Name, Document Type, Exhibit/Paper Number, Filing Date, Filing Party, and Availability. The first row of the table is highlighted in light blue and has a yellow box around the "Document Name" cell. A blue "Download" button is located to the right of the first row. The "uspto" logo is visible in the bottom right corner of the screenshot area.

	Document Name	Document Type	Exhibit/Paper Number	Filing Date	Filing Party	Availability	
1	Petition for Inter Partes Review of U.S. Patent No.	PAPER	1	02/27/2015	petitioner	PUBLIC	Download

Navigating the Petition

Petitions can be long, but the Post Grant Outcomes pilot revealed that examiners found the following sections to be particularly useful:

- Exhibit List
- Detailed Explanations of the Challenges



The Exhibit List features all the documents (e.g., Patents, Printed Publications, expert declarations) being used to challenge the claims in the issued patent.

- PDFs of each of the exhibits are available in the PTAB E2E file wrapper:



Other Relevant Documents in the AIA Trial File Wrapper

- In addition to the Petition, the Post Grant Outcomes pilot revealed that examiners found **Expert Declarations** helpful for understanding the state of the art.
- Not all AIA Trials will have an expert declaration.

50 EX1002 Declaration of

EXHIBITS

1002

08/05/2016

petitioner

PUBLIC

Download

uspto

Petitioner's Relevance Exhibit

- Often times petitioners add a detailed chart on how their submitted art reads on the patented claims

Ground	35 USC	Index of References	Claims
1	§ 102	Smith	61-65
2	§ 103	Smith in view of Carr	1-4, 9, 10, 13, 17, 19-23, 27, 29, 44-46 and 53

High Level Statistics from the Post Grant Outcome Program

- To date, over 1400 AIA trial proceedings have been linked to related applications undergoing examination.
- In a random sample of these related applications, nearly 50% of examiners cited at least one prior art reference from the AIA trial in their Office action – citing it either of record or in a rejection.



Learn More...

- Post Grant Outcomes

<https://www.uspto.gov/patent/initiatives/post-grant-outcomes>

- Post Grant Outcomes Pilot

<https://www.uspto.gov/patent/initiatives/post-grant-outcomes-pilot>

- Contact Us

PostGrantOutcomes@uspto.gov



Let's Chat about AIA Trial Statistics from PTAB and Using AIA Trials to Enhance Patent Examination

Janet Gongola

Vice Chief Judge for Engagement, Patent Trial and Appeal Board

Jack Harvey

Assistant Deputy Commissioner for Patent Operations, Office of the Commissioner for Patents

UNITED STATES
PATENT AND TRADEMARK OFFICE



Email questions to PatentQuality@uspto.gov



Next Patent Quality Chat

TBD

September 11, 2018

UNITED STATES
PATENT AND TRADEMARK OFFICE



Email questions to PatentQuality@uspto.gov

Other Patent Quality-Related Events

<https://www.uspto.gov/about-us/events>

August 17-18	Invention-Con 2018 (in Alexandria)
Sept 24	Biotechnology/Chemical/Pharmaceutical Customer Partnership (in Alexandria and virtual)
Throughout FY19	Stakeholder Training on Examination Practice and Procedure (STEPP) for agents, attorneys and inventors. https://www.uspto.gov/patent/initiatives/stakeholder-training-examination-practice-and-procedure-stepp

Email questions to PatentQuality@uspto.gov

UNITED STATES
PATENT AND TRADEMARK OFFICE



Thank you for joining us today!

Patent Quality Chat
Webinar Series 2018
August 14, 2018

Email questions to PatentQuality@uspto.gov

UNITED STATES
PATENT AND TRADEMARK OFFICE





Email questions to PatentQuality@uspto.gov