Biotechnology, Chemical, Pharmaceutical Customer Partnership Meeting

Kalyan Deshpande, Senior Lead Administrative Patent Judge, PTAB
Michelle Ankenbrand, Lead Administrative Patent Judge, PTAB
Michael Cygan, Administrative Patent Judge, PTAB
Eric Jeschke, Administrative Patent Judge, PTAB
Kristi Sawert, Administrative Patent Judge, PTAB
Amanda Wieker, Administrative Patent Judge, PTAB
June 15, 2021
Agenda

• Precedential and informative decisions
  – Process (POP and designation)
  – Recently designated cases

• Appeals
  – Appeal brief template,
  – Appeal timeline, and
  – Fast-track appeals pilot programs (regular and COVID-related)

• AIA Trials
  – Motions to amend

• Legal Experience and Advancement Program (LEAP)
Process (POP and designation)

Precedential and informative decisions
Standard operating procedure 2 (SOP2), revision 10

- Creation of a Precedential Opinion Panel (POP) to rehear matters of exceptional importance involving policy or procedure in pending trials and appeals, resulting in binding agency authority unless otherwise designated;
- Procedure for nomination, review, and designation of Board decisions, other than POP decisions, as precedential or informative; and
- Procedure for de-designating precedential and informative decisions.
SOP 2

- Creates the processes for designating PTAB decisions in appeals and trial proceedings as precedential or informative

- Sets forth 2 paths for special designation:
  Path 1: Precedential Opinion Panel (POP) review
  Path 2: Designation
What is the POP?

- POP = Precedential Opinion Panel

- POP is a special panel formed to rehear cases in PTAB appeals or trial proceedings and issue decisions that create binding Board precedent
Typical issues for the POP

- The POP hears cases that involve:
  - Constitutional questions
  - Important questions regarding statutes, rules, regulations
  - Important issues regarding precedential case law
  - Issues of broad applicability to Board
  - Resolve conflicts between Board decisions
  - Promote certainty and consistency
Who is on the POP?

• Default composition
  1. Director of USPTO
  2. Commissioner for Patents
  3. PTAB Chief Judge

• SOP 2 set forth order of substitutes
Who can request POP review?

• Any party to a proceeding, for example:
  – an applicant appealing an adverse decision by a patent examiner,
  – a party in a PTAB trial proceeding

• Commissioner for Patents, PTAB Chief Judge, or any other member of the Board
How is POP review requested?

• Submit an email requesting POP review to Precedential_Opinion_Panel_Request@uspto.gov.

• The email MUST be accompanied by a request for rehearing.
How is POP review requested?

- Email must also “identify with particularity the reasons for recommending Precedential Opinion Panel review”

- Submitter must include at least one of the following statements:
  1. Decision is contrary to binding precedent (SCOTUS, CAFC, PTAB)
  2. Decision is contrary to a constitutional provision, statute, or regulation
  3. Case implicates a question of exceptional importance
How is POP review announced?

• If POP decides to grant review, a POP grant order is issued

• POP grant order includes:
  – Issue to be resolved by POP
  – Schedule for the review process, including due dates for briefing
  – Additional and responsive briefing and page limits
  – Amicus briefing and page limits
  – Oral Hearing information

• If POP denies review, a POP denial order is entered into the record of the proceeding
Will the POP hold an oral hearing?

- Oral Hearing will be granted if requested by the parties and as determined by the POP
- Hearing Order includes:
  - Date and location for oral hearing
  - Information on demonstratives
  - Order for hearing arguments
- Hearing is open to public
POP information

www.uspto.gov/patents/ptab
POP information

www.uspto.gov/patents/ptab/decisions/precedential-opinion-panel

Precedential Opinion Panel

The Precedential Opinion Panel (POP) operates, at the discretion of the Director, to decide issues of exceptional importance to the Patent Trial and Appeal Board (e.g., issues involving agency policy or procedures). By default, POP members are the Director, the Commissioner for Patents, and the Chief Judge. Learn more on the Precedential and informative Opinions page.

**POP Request: Amicus Form**

Submit an amicus request supporting or opposing a pending request for POP review.

**POP review granted - proceedings**

- **Hunting Titan, Inc. v. DynaEnergetics Europe GmbH, IPR2018-00600**
  - Decision under POP review - [Prelim.](#) (August 20, 2019)
  - POP grant order - [Grant](#) (November 7, 2019)
  - Amicus briefing - CLOSED (December 20, 2019)
  - Oral Hearing - [Prelim.](#) (February 10, 2020) [NEW]
  - POP decision - [Prelim.](#) (July 6, 2020) [NEW]

- **GoPro, Inc. v. 360Heros, Inc., IPR2018-01754**
  - Decision under POP review - [Prelim.](#) (April 3, 2019)
  - POP grant order - [Grant](#) (May 10, 2019)
  - Amicus briefing - CLOSED (May 21, 2019)
  - POP decision - [Prelim.](#) (August 28, 2019)

- **Hulu, LLC v. Sound View Innovations, LLC., IPR2018-01039**
  - Decision under POP review - [Prelim.](#) (December 8, 2018)
  - POP grant order - [Grant](#) (April 3, 2019)
  - Amicus briefing - CLOSED (May 1, 2019)
  - POP decision - [Prelim.](#) (December 20, 2019)

- **Propellant Express Investments, LLC v. Oren Techs LLC., IPR2018-00914**
  - Decision under POP review - [Prelim.](#) (November 28, 2018)
  - POP grant order - [Grant](#) (December 3, 2018)
  - Amicus briefing - CLOSED (December 28, 2018)
  - POP decision - [Prelim.](#) (March 12, 2019)
Precedential Opinion Panel (POP) request amicus form
POP request amicus form

• Published November 19, 2020.
• Accessible the PTAB’s Precedential Opinion Panel page of the USPTO website.
• Allows the submission of an amicus request addressing a pending request for POP review.
POP request amicus form

• Must be made within seven business days of entry of the Notification of Receipt of POP Request into the case docket or patent application file.

• Must include case identifying information:
  – name of the submitter,
  – any affiliation, and
  – any client represented.

• Option to explain why the POP request should or should not be granted.
POP request amicus form

Precedential Opinion Panel (POP) 
Amicus Form

This submission form allows individuals to submit an amicus request supporting or opposing a pending request for POP review in a particular case. Individuals must provide certain information about themselves and the case in which the POP request has been made, explain why they support or oppose the POP request (e.g., the doctrine is or is not contrary to Supreme Court, Federal Circuit, or Board precedent), and certify that the form is being submitted within seven business days of entry of the Notification of Receipt of POP Request into the case docket or patent application file. This information will be entered into the record of the case or patent application.

*Items are mandatory:

*Name:

*Affiliation:
  [e.g., none, law firm, university, company, association]

*Client represented:
  [e.g., none or XYZ, Inc.]

*Case number:
  [e.g., 200600-01234 or 2008-00118]

*Case name:
  [e.g., ABC Corp. v. 123 Corp.]

*Rehearing Request
  paper number:
  [(For PT, RP, or CBM case numbers e.g., Paper 115)]

*Type of amicus:
  Select an option

*Brief reasons for
  supporting or
  opposing POP review:
  [Limited to 3000 characters]

*Relationship to a
  party to the
  proceeding:
  [e.g., none or subsidiary of ABC Corp.]

* I certify that I am submitting this amicus form within seven business days of entry of the Notification of POP request into the case docket or patent application file.

*Signatures:
  [e.g., /signaturename]

Submit
PTAB anonymous decision nomination form
PTAB anonymous decision nomination form

• Published September 24, 2020.

• Accessible on the PTAB’s Precedential and informative decisions page of the USPTO website.

• Allows any member of the public to nominate any PTAB decision for precedential or informative designation.
PTAB anonymous decision nomination form

• Provide as much identifying information as possible.

• Set forth a brief description of the reasons for the requested designation.

• May also enter name and email address.
PTAB anonymous decision nomination form

PTAB Decision Nomination

This submission form allows individuals to anonymously nominate any routine decision of the Board for designation as precedential or informative. Please provide as much identifying information as possible for any nominated decision, and set forth a brief description of the reasons for the requested designation. Individuals nominating a decision may also enter their name and email address.

*Items are mandatory

*Type of nomination: [Select an option]

*Case number: [Blank]
(e.g., IPR2020-01234; 2006-001183)

*Case name: [Blank]

*Paper number: [Blank]
(Enabled for case numbers begin with IPR, PGR, or CBM)

*Brief reasons for nomination: [Blank]
(Limited to 750 characters)

Name (optional): [Blank]

E-mail Address (optional): [Blank]

Submit
Recently designated cases

Precedentiaal and informative decisions
Recently designated decisions

Real Party-in-Interest (designated Dec. 4, 2020)
- *SharkNinja Operating LLC v. iRobot Corp.*, IPR2020-00734, Paper 11 (Oct. 6, 2020) (precedential)

Joinder (designated Dec. 4, 2020)

Exercising Discretion under 314 (*Fintiv*) (designated Dec. 17, 2020)
- *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (Dec. 1, 2020) (precedential as to § II.A)
- *Snap, Inc. v. SRK Tech. LLC*, IPR2020-00820, Paper 15 (Oct. 21, 2020) (precedential as to § II.A)
• Determined petitioner bears the burden to establish no RPI or privy was served with a complaint alleging infringement more than one year prior to the filing of the petition.

• Whether a non-party is a RPI or privy is a fact-dependent question demanding a flexible approach to determine who, from a practical and equitable standpoint, will benefit from the redress that the *inter partes* review might provide.
Determined to not address whether a party is an unnamed RPI when it would not create a time bar or estoppel under 35 U.S.C. § 315.

Such a lengthy exercise is unnecessary for the purposes of rendering a decision on institution of trial when there is no time bar implication.

Identification of all “correct” RPIs under 35 U.S.C. 312(a)(2) is not jurisdictional.

The petition in IPR2020-00854 is undeniably the second petition Apple has filed challenging the ‘088 patent.

Applied the General Plastic factors to a follow-on petition that is accompanied with a motion for joinder.

Determined, after a holistic review of the General Plastic factors that the facts weigh in favor of exercising discretion to deny institution.

See General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (precedential as to § II.B.4.i)).
Sotera Wireless, Inc. v. Masimo Corp.
IPR2020-01019

• Petitioner broadly stipulates to not pursue “any ground raised or that could have been reasonably raised.”

• Petitioner’s broad stipulation addresses concerns of duplicative efforts and potentially conflicting decisions, ensuring that an inter partes review is a “true alternative” to the district court proceeding.

• Determined that petitioner’s broad stipulation weighed strongly against the exercise of discretion to deny institution of inter partes review.
Snap, Inc. v. SRK Tech. LLC
IPR2020-00820

• The district court’s stay of the litigation pending denial of institution or a final written decision allays concerns about inefficiency and duplication of efforts.

• Determined that the granting of a stay pending inter partes review weighs strongly against exercising discretion to deny inter partes review.
Appeals

Appeal brief template
Appeal timeline, and
Fast-track appeals pilot programs (regular and COVID-related)
Appeal brief template: new appeal brief tool and how to access

Appeals
Appeal brief tool

• There are two parts to the appeal brief tool:
  1. Word document template
  2. PDF instructions for completing the template
Location of appeal brief tool: PTAB page on USPTO website

www.uspto.gov/patents/ptab
Location of appeal brief tool:
New to PTAB page on USPTO website
www.uspto.gov/patents/ptab/ptab-inventors

What are ex parte appeals?
If a patent examiner twice rejects or issues a final rejection in a patent application, the applicant can seek review of the rejection by the Board. The Board calls such an applicant by the title appellant.

An appellant and the respondent submit written papers called briefs in their respective positions. An appeal brief contains certain required information to help the Board understand the invention and the arguments for patentability. For help in preparing an appeal brief, the Board offers an appeal brief template and instructions to guide appellants; these documents featured on the Preparing an Ex Parte Appeal Brief webpage.

In addition, the appellant also may request to make an oral presentation to the Board, which is called an oral hearing.

The Board will review the briefs, attend the oral hearing, and then render a decision. The Board will either affirm or reverse, in part or whole, the examiner’s rejection. If the appellant is not successful in securing reversal of the examiner's rejection from the Board, the appellant may seek reconsideration by the Board or federal court review or both.

The appeal process involves nine steps and is explained in those videos below:

Inventor Info Chat (Appealing a Final Rejection to the Patent Trial and Appeal Board: What you need to know. August 15, 2019)
Boardroom chat (Appeals Made Easy. November 7, 2019)

Learn more about ex parte appeals on the PTAB's Appeal webpage. Also, feel free to use our resources for independent inventors and those new to appeals.
Location of appeal brief tool:
Preparing an ex parte appeal brief page
Appeal brief tool: Word template and PDF instructions

Word template

<table>
<thead>
<tr>
<th>IN THE UNITED STATES PATENT AND TRADEMARK OFFICE</th>
</tr>
</thead>
<tbody>
<tr>
<td>Inventor(s): [Inventor Name(s)]</td>
</tr>
<tr>
<td>Application No. [##,##,##]</td>
</tr>
<tr>
<td>Filed [Application Filing Date]</td>
</tr>
<tr>
<td>Title: [APPLICATION TITLE]</td>
</tr>
</tbody>
</table>

MAIL STOP APPEAL BRIEF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**APPEAL BRIEF**
Appellant submits this Appeal Brief in response to the final Office action mailed [Date], and further to the Notice of Appeal filed [Date]. Appellant requests consideration of this appeal by the Patent Trial and Appeal Board.

I. REAL PARTY IN INTEREST
   Add

II. RELATED APPEALS AND INTERFERENCES
    Add

III. SUMMARY OF CLAIMED SUBJECT MATTER
    Add

IV. ARGUMENTS
    Add
    a. Rejection 1 — The Rejection of Claims . . . Based on . . .
       1. Independent Claim 1

PDF Instruction Document

I. REAL PARTY IN INTEREST
   This section requires a statement from you that identifies the real party in interest at the time the appeal brief is filed. A real party in interest may include you as the inventor and any other individuals or entities that have ownership rights to the patent application. For example, an assignee of the patent application may be a real party in interest. A statement is not required if the named inventor(s) are the real party in interest. If you do not provide a statement, the Board will consider the inventor(s) to be the real party in interest. Typically, a pro se inventor is the real party in interest. See MPEP §§ 301, 324, 1205.02(i) (https://mpep.uspto.gov/ RDMS/MPEP/current/#/current/d0e123366.html).

Example:
The real party of interest is The Great White Café LLC (Baja, California 21511) by virtue of an assignment by the inventor duly recorded in the Assignment Branch of the Patent and Trademark Office.

II. RELATED APPEALS AND INTERFERENCES
   Please list all of your prior or pending cases before the Board or before a court. These cases are based on applications or patents that you
Filing an appeal brief via EFS-Web:
Preparing an ex parte appeal brief page
Filing an appeal brief via EFS-Web
Appeal brief template: parts of an appeal brief

Appeals
Parts of an appeal brief

• Six parts:
  – Summary of claimed subject matter
  – Real party in interest
  – Related appeals, interferences, and trials
  – Argument
  – Conclusion (optional)
  – Claims appendix
Summary of claimed subject matter

• Provides a concise explanation of the subject matter defined in each of the rejected independent claims

• Not required for pro se applicants, but may help the Board understand the arguments

• If included, should identify, for each claim element, supporting disclosure and figures
Real party in interest

- Statement from you that identifies the real party in interest at the time the appeal brief is filed.
- A real party in interest may include you as the inventor and any other individuals or entities that have ownership rights to the patent application.
- An assignee of the patent application may be a real party in interest.
- You must update the real party in interest if it changes during the proceeding (See 37 C.F.R. § 41.8).

Example: The real party in interest is The Great White Café LLC (Baja, California 21511).
Related appeals, interferences, and trials

- List any prior or pending cases before the Board or a court that are related to the current appeal
- A related case is based on a patent or application that you own and would affect the current appeal or be affected by the current appeal
  - A related case might be a continuation application

Example 1: Appeal No. 2019-1234, prior decision dated July 1, 2020

Example 2: There are no related appeals, interferences, or trials to appellant’s knowledge
Argument

• Why the examiner’s decision to reject the pending claims of your application is improper and should be reversed
Conclusion and claims appendix

• Conclusion should briefly explain what relief you want from the Board (e.g., reverse the examiner’s rejection)

• Appendix must include all claims on appeal
  – Should not indicate prior amendments or reference non-admitted amendments
  – Should start on a new page
The one-year ex parte appeal:
how to get from final action to PTAB decision in one year (or less)
The one-year appeal

<table>
<thead>
<tr>
<th>Document</th>
<th>Typical (months)</th>
<th>Diligent Appellant (months)</th>
<th>Diligent + PTAB Fast-Track</th>
</tr>
</thead>
<tbody>
<tr>
<td>Final Rejection</td>
<td>4</td>
<td>1</td>
<td>1</td>
</tr>
<tr>
<td>Notice of Appeal</td>
<td>3</td>
<td>1.5</td>
<td>1.5</td>
</tr>
<tr>
<td>Appeal Brief</td>
<td>~2.5</td>
<td>~2.5</td>
<td>~2.5</td>
</tr>
<tr>
<td>Examiner’s Answer*</td>
<td>2</td>
<td>1</td>
<td>1</td>
</tr>
<tr>
<td>Reply Brief</td>
<td>~12</td>
<td>~12</td>
<td>&lt;6</td>
</tr>
</tbody>
</table>

**Final-to-Decision (months):**

|                  | ~23              | ~18                         | <12                       |

Where an Appellant would like to conclude an appeal quickly, the time frames for the briefing stage show how such appeals may proceed. It may not be appropriate for all appeals.
Fast-Track Appeals Pilot Program and
Fast-Track Pilot Program for Appeals Related to COVID-19

Appeals
Fast-Track Appeals Pilot Program

• *Get your ex parte appeal decided in 6 months or less*

• Pilot program before the PTAB
  – Initially one year (expires July 2021); to be extended

• An appellant can request an ex parte appeal to be expedited out of turn by filing:
  – A petition
  – A fee ($420)

• Pendency goal: PTAB decision within six months
Does my appeal qualify?

• Application type
  – Original utility, design, or plant nonprovisional application

• Status of appeal
  – Pending ex parte appeal (Notice of Appeal filed and Docketing Notice issued)
  – Not limited to “new” appeals (a petition may be submitted for any currently pending appeal)
Are there any restrictions?

- The number of granted petitions is limited to 125 per quarter (500 total)
- Hearings permitted, with some caveats
- Not available for applications already treated as special during appeal under MPEP 708.01
  - See MPEP 708.01 (e.g., appeals treated special due to age or health of inventor)
New: Fast-Track Pilot Program for Appeals Related to COVID-19

• Published April 15, 2021 (86 FR 19877)
• Similar to Fast-Track Appeals Pilot, but
  – No fee
    • Still file a petition, but fee waived
  – Technology limit
    • “must claim a product or process subject to an applicable FDA approval for COVID–19 use”
  – No time limit; 500 total granted petitions for the pilot program
Petition requirements

• Petition under 37 C.F.R. § 41.3
  – Online forms recommended, but not required
  – Identify the application number and appeal number
  – Certify that the ex parte appeal qualifies
  – Covid-19 Fast Track—Certify that the application claims a product or process subject to an applicable FDA approval for COVID-19 use

• Petition fee under 37 C.F.R. § 41.20(a)
  – $420 (non-refundable) for regular Fast Track Appeals Pilot Program
  – No fee for Covid-19 Fast Track Pilot Program
Hearings

• Appellant with a fast-tracked ex parte appeal may request oral argument before a PTAB panel
  – PTAB will make best efforts to accommodate time/location preferences
  – But, hearing may be scheduled in any available hearing room in any office location or by telephone

• Appellant cannot reschedule hearings and remain in the pilot program
  – May opt out of the pilot program and reschedule hearing
  – May request video/telephone if office location is inconvenient
  – May waive hearing and continue on fast-track

• Currently, all hearings for ex parte appeals are telephonic
  – www.uspto.gov/coronavirus
How fast is fast track?

• Much faster than usual
  – Target of 6 months
  – Faster than the approximate 13–14 month average time to decide appeals overall (https://www.uspto.gov/patents/ptab/statistics)

• Current average time to decide petition: 1.4 days
• Current average time to decision on appeal: 2.2 months
Check PTAB website for petition limit and timeliness updates

Fast-track appeals pilot program

What is the Fast-track Appeals Pilot Program?
Under the Fast-track Appeals Pilot Program, applicants can have their ex parte appeals advanced out of turn. Applicants simply file a petition to request fast-track review of their ex parte appeal and pay a $1420 petition fee. The Patent Trial and Appeal Board (PTAB) or Board has set a target of issuing a decision within six months from the date the petition is granted and the ex parte appeal is entered into the pilot program.

The Fast-track Appeals Pilot Program is effective on July 2, 2020. This means an appellant may file a petition for inclusion of an ex parte appeal in the pilot program starting on July 2, 2020.

Read the Federal Register Notice here.

Eligibility requirements
To qualify for fast-track status, the following four conditions must be met:

- **Application Type:** The application must be an original utility, design, or plant nonprovisional application.
- **Status of appeal:** The appeal for fast-track status must be an ex parte appeal for which a notice of appeal has been filed and a PTAB deciding notice has been issued by the USPTO (i.e., the appeal is pending before the PTAB).
- **Petition:** The appellant must file a petition under 37 CFR 41.43 in the USPTO’s electronic filing system (EFS-Web) identifying the application and appeal by application number and appeal number, respectively, for which fast-track review is sought.
  - Form: Petition—Fast-Track Appeals Pilot Program (PTO/SB/165)

- **Fee:** The appellant must pay a $1420 fee under 37 CFR 41.20(a) with the petition.
- **USPTO Fee Schedule**

Time to decision
The Board has set a target of issuing a decision within six months from the date that a petition for fast-track review is granted. Since the program’s inception in July 2020 through December 31, 2020, PTAB has decided 59 fast-track appeals with an average decision time of about 2 months from the date the petition for fast-track review was granted and about 6 months from the date PTAB received the appeal. Thus the overall decision time is at least 60% faster than the average appeal time for cases not under fast-track review, which currently stands at about 13 months as of the end of calendar year 2020.

 Granted petition limits
The USPTO has limited the number of granted petitions to 125 per quarter for the duration of the Fast-Track Appeals Pilot Program, which is expected to run for one year.

The table shows the status of the number of granted petitions per quarter and total for the pilot duration, as well as open slots available during each time period.

<table>
<thead>
<tr>
<th>As of date</th>
<th>Petitions received in quarter</th>
<th>Petitions granted in quarter</th>
<th>Available petition slots in quarter</th>
<th>Petitions held in abeyance</th>
<th>Total granted petitions</th>
</tr>
</thead>
<tbody>
<tr>
<td>Q4 (starting 4/1/2021)</td>
<td>5/17/2021</td>
<td>28</td>
<td>27</td>
<td>98</td>
<td>0</td>
</tr>
</tbody>
</table>
Check PTAB website for petition limit and timeliness updates

COVID fast-track appeals pilot program

Need an expedited decision on your ex parte appeals related to COVID-19?

The USPTO has implemented the COVID-19 Prioritized Examination Pilot Program to prioritize the examination of certain patent applications claiming a product or process subject to an applicable FDA approval for COVID-19 use.

As a companion to the COVID-19 prioritized examination, the USPTO has implemented the Fast-Track Pilot Program for Appeals Related to COVID-19, under which an appellant may have certain COVID-19-related ex parte appeals before the Patent Trial and Appeal Board (PTAB or Board) accorded fast-track status. Appellants simply file a petition to request fast-track review of their COVID-19-related ex parte appeal—i.e., an appeal of an application that claims a product or process that is subject to an applicable FDA approval for COVID-19 use. No petition fee is required.

The PTAB has set a target of issuing a decision within six months from the date the petition is granted and the COVID-19-related ex parte appeal is entered into the pilot program.

The Fast-Track Pilot Program for Appeals Related to COVID-19 is effective on April 15, 2021. This means an appellant may file a petition for inclusion of a COVID-19 related ex parte appeal in the pilot program starting on April 15, 2021.

Read the Federal Register Notice here [^]
Summary

Fast-Track Appeals Pilot Program

• Pilot program to expedite ex parte appeals before the PTAB
• Fee
• Limit of 500 granted petitions/year (quarterly limit of 125)
• One year (to be extended)
• No technology limit
• Learn more: www.uspto.gov/patents/ptab/fast-track-appeals-pilot-program

Fast-Track Pilot Program for Appeals Related to COVID-19

• Pilot program to expedite ex parte appeals related to COVID-19 before the PTAB
• No fee
• Limit of 500 granted petitions (no quarterly limits)
• No time limit
• “Must claim a product or process subject to an applicable FDA approval for COVID–19 use”
• Learn more: www.uspto.gov/patents/patent-trial-and-appeal-board/covid-fast-track-appeals-pilot-program
MTA Pilot Program

AIA trials
Request for comment on proposed changes to motion to amend (MTA) practice in AIA trials

- October 29, 2018, the Office published a motion to amend (MTA) request for comments (RFC):
  - Proposed a new MTA process and pilot program.
  - Sought input regarding burden of persuasion when determining patentability of substitute claims, after Aqua Products.
  - Included 17 questions of interest, but also solicited feedback regarding MTA practice generally.
- Office received 49 comments from stakeholders (as of December 21, 2018).
- Office carefully considered all comments and revised pilot program in response.
MTA pilot program notice

• In response to comments, the office issued a notice regarding a new pilot program concerning MTA practice and procedures in AIA trials.

• Published in Federal Register at 84 Fed. Reg. 9497 (March 15, 2019).

• Notice also provides responses to comments.
  – Topics include timelines, retroactivity of applying pilot, Board preliminary decision, opportunity to file a revised MTA, contingent MTAs, and opting-out of pilot.
  – Comments also included requests for clarification regarding existing reissue and reexamination procedures at the USPTO.
  – Stakeholder comments to October MTA RFC are available at go.usa.gov/xEXS2.
Highlights of MTA pilot program

• Provides patent owner (PO) with two options not previously available:
  • **Option 1**: PO may choose to receive preliminary guidance (PG) from Board on its motion to amend (MTA).
  • **Option 2**: PO may choose to file a revised MTA after receiving petitioner’s opposition to initial MTA and/or after receiving Board’s PG (if requested).

• Option 1 is not a predicate for option 2
• Applies to all AIA trials instituted on or after publication date of the notice (i.e., March 15, 2019)
Schedule entered at institution (Appendix 1A)

* PO indicates in MTA whether it requests Preliminary Guidance
All cases

• Scheduling order entered at institution sets due dates similar to prior practice
  – Schedule is changed only if/after PO files revised MTA
  – Parties can stipulate to move dates, but must leave time for PG
  – Small changes:
    • 12 weeks for MTA and Opposition (Opp.) to MTA
      – Similar to prior schedule
      – Same due dates as PO response and petitioner reply (petition)
    • Six weeks for reply and sur-reply regarding MTA
      – Rather than 1 month under prior practice
      – Same due dates as PO sur-reply and motion to exclude (MTE)
All cases with an MTA

• In initial MTA, PO may request PG
  – If PO does not request PG, no PG
  – If PO requests it, Board will provide PG within four weeks of due date for Opp. to MTA
  – No rehearing request from PG
All cases with an MTA where Patent Owner requests PG

• Content of PG
  – Preliminary, non-binding initial assessment of MTA based on record so far
    • Typically short paper (although may be oral guidance in a conference call, at Board’s discretion)
    • Focuses on limitations added in MTA
    • Does not address patentability of original claims
    • Does not provide dispositive conclusions
PO choices

• Based on Opp. to MTA and/or PG, PO may file:
  – Reply to opposition to MTA and PG (if requested); or
  – Revised MTA; or
  – Nothing
PO files reply

- Appendix 1A of pilot notice
- PO files reply to MTA opposition and/or PG
  - No change to scheduling order
  - Petitioner may file sur-reply six weeks after PO reply (on same day as MTE)
    - No new evidence other than deposition transcripts of cross-examination of any reply witness
    - Limited to response to PG (if provided) and PO reply
  - Oral hearing at ~nine months (similar to prior practice)
PO files revised MTA

• Appendix 1B of pilot notice
• PO files revised MTA
  – Includes one or more new proposed substitute claims in place of previously presented substitute claims
  – May provide new arguments and/or evidence as to why revised MTA meets statutory and regulatory requirements
  – May keep some proposed substitute claims from original MTA and reply to PG and/or Opp. on those claims
  – Must provide amendments, arguments, and/or evidence that are responsive to issues raised in PG or Opp.
PO files revised MTA

• Board issues revised scheduling order shortly after PO files revised MTA
  – Sets dates for briefing on revised MTA
  – Revises dates for MTE and associated briefing
  – Revises oral hearing date to ~10 months
    • If needed, PO may ask to file MTE regarding reply or sur-reply evidence at or after oral hearing

• Final written decision addresses only substitute claims at issue in revised MTA (if necessary)
Revised schedule if revised MTA (Appendix 1B)

New Procedures in Black and Grey
Existing Procedures in White

* PO indicates in MTA whether it requests Preliminary Guidance
** If PO files a rMTA, Board adjusts schedule to this revised timeline
If PO files no paper after opposition and/or PG

- If no PG, no further briefing on MTA
- If PG:
  - Petitioner may file reply to PG (three weeks after due date for PO reply)
    - May only respond to PG
  - PO may file sur-reply in response (three weeks thereafter)
    - May only respond to reply
  - No new evidence with either paper
MTA Pilot Program data (through March 31, 2021)

AIA trials
MTA filings
(Pilot: Mar. 15, 2019 to Mar. 31, 2021)

In how many trials are MTAs filed?

- Completed trials with MTA
- Pending trials with MTA
- Pending trials without MTA
- Completed trials without MTA

Trials reflect institutions between March 15, 2019 and December 31, 2020. The outcomes of decisions on institution responsive to requests for rehearing are incorporated.
MTA subsequent developments
(Pilot: Mar. 15, 2019 to Mar. 31, 2021)

![Pie chart showing the distribution of Decided, Consolidated, and Withdrawn or Settled cases.]

- **Decided**: 83 cases (76%)
- **Consolidated**: 19 cases (23%)
- **Withdrawn or Settled**: 1 case (1%)

Total: 83 cases
MTA dispositions, by option
(Pilot: Mar. 15, 2019 to Mar. 31, 2021)

- Overall with Pilot Option: 52 dispositions
  - Denied: 6 (12%)
  - Granted in Part: 7 (13%)
  - Granted: 39 (75%)
- No Pilot Option: 11 dispositions
  - Denied: 10 (91%)
  - Granted in Part: 1 (9%)

Pilot options include requests for preliminary guidance and MTA revisions. Dispositions reflect MTAs substituting claims.
MTA grant rates

<table>
<thead>
<tr>
<th></th>
<th>Pre-Pilot Overall</th>
<th>Pilot Overall</th>
<th>Pilot with Option</th>
<th>Pilot No Option</th>
</tr>
</thead>
<tbody>
<tr>
<td>Grant Rate</td>
<td>14%</td>
<td>22%</td>
<td>25%</td>
<td>9%</td>
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</table>

Pilot options include requests for preliminary guidance and MTA revisions. Grant rate calculated as the percent of MTA dispositions granted or granted in part.
Denial of claim substitution, by party’s burden
(Pilot: Mar. 15, 2019 to Mar. 31, 2021)

This diagram reflects instances where Petitioner met its burden to show unpatentability or patent owner failed to meet its burden on the statutory and regulatory requirements.
# Denial of claim substitution: patent owner burden

(Pilot: Mar. 15, 2019 to Mar. 31, 2021)

<table>
<thead>
<tr>
<th>Issue</th>
<th>Sole PO Reason</th>
<th>One of Multiple PO Reasons</th>
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<tbody>
<tr>
<td>New Matter or No Written Description</td>
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<td>24</td>
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<td>Substitutes for Unchallenged Claims</td>
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<td>Nonresponsive to a Ground of Unpatentability</td>
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<tr>
<td>Enlarge Scope of Claims</td>
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<tr>
<td>Unreasonable Number of Substitute Claims</td>
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<td></td>
</tr>
<tr>
<td>Other</td>
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<tr>
<td>Claims Appendix Defects</td>
<td>0</td>
<td></td>
</tr>
</tbody>
</table>
Denial of claim substitution: petitioner burden
(Pilot: Mar. 15, 2019 to Mar. 31, 2021)

- **Sole Pet. Reason**
  - 102/103: 29
  - Indefiniteness: 7
  - Enablement: 3
  - 101: 0
  - Other: 0

- **One of Multiple Pet. Reasons**
  - 102/103: 43
  - Indefiniteness: 19

Total: 62
MTA pilot options data
(Mar. 15, 2019 to March 31, 2021)

Number of MTAs Filed under Pilot Program
- MTAs without PG Request
- MTAs with PG Request

- 103 (81%)
- 24 (19%)

84

MTA Pilot Option #2

- **R-MTAs**: 57, 79%
- **Replies**: 15, 21%
MTA precedent, Final rule on burdens, and reexam/reissue notice

AIA trials
Applicable rules and precedential decisions

- 35 U.S.C. § 316(d) (setting forth PO requirements for MTAs in IPRs), § 326(d) (same for MTAs in PGRs)
  - e.g., a motion to amend cannot propose substitute claims for unchallenged claims
- 37 C.F.R. § 42.121 (setting forth our rules for MTAs in IPRs, including new rule on burdens in part (d)), § 42.221 (same for MTAs in PGRs)
  - burden generally on Petitioner for unpatenability, but Board can raise issues in special circumstances
  - guidance and information regarding statutory and regulatory requirements for a motion to amend in light of Federal Circuit case law
  - 316(d)/326(d) does not prevent the Board from considering unpatentability under sections other than § 102 and § 103 with respect to proposed substitute claims.
The POP concluded:

- The Board may, in certain rare circumstances, raise a ground of unpatentability that a petitioner did not advance, or insufficiently developed, against substitute claims proposed in opposing a motion to amend.
  - Examples of such rare circumstances include:
    - Where the petitioner has ceased to participate in the proceeding; or
    - Where certain evidence not raised, but is readily identifiable and so persuasive that the Board should take it up in the interest of supporting the integrity of the patent system.

- Due process requires notice and opportunity to respond
  - Could ask for supplemental briefing
  - Could ask parties to be prepared to discuss the issue during the oral hearing
Final rule allocating MTA burdens

- New subsection(d) to 37 C.F.R. § 42.121 and § 42.221, allocating burdens of persuasion in relation to a motion to amend (MTA)
  - Applies to MTAs filed on or after January 20, 2021
  - Assigns to patent owner the burden of showing that a MTA complies with certain statutory and regulatory requirements for such a motion
  - Assigns to petitioner the burden of showing the unpatentability of substitute claims
Final rule – Board discretion

• Irrespective of the burdens and the adversarial nature of the proceeding, the Board may, in the interests of justice, exercise its discretion to grant or deny a MTA, but only for reasons supported by readily identifiable and persuasive evidence of record in the proceeding.

• In doing so, the Board may make of record only readily identifiable and persuasive evidence in a related proceeding before the USPTO or evidence that a district court can judicially notice.

• Where the Board exercises its discretion, the parties will have an opportunity to respond.
Notice regarding options for reissue or reexamination during pending AIA proceeding

• Published in Federal Register at 84 Fed. Reg. 16654 (April 22, 2019)
• Notice provides:
  – A summary of current practice regarding existing office procedures that apply to reissue and reexamination, including after a petitioner files an AIA petition challenging claims of same patent, after Board institutes a trial, and after Board issues a final written decision (FWD)
  – Summary information about factors the office currently considers when determining:
    • Whether to stay or suspend a reissue proceeding, or stay a reexamination proceeding, that involves a patent at issue in an AIA proceeding; and
    • When and whether to lift such a stay or suspension
Legal Experience and Advancement Program (LEAP)
Legal Experience and Advancement Program (LEAP)

- Launched on May 15, 2020
- Goal: to foster the advancement of the next generation of patent practitioners through skills development and oral advocacy opportunities at the PTAB
- Targeting patent agents and attorneys newer to the practice of law or to the PTAB
Objectives

LEAP fosters the development of newer practitioners by:

- Incentivizing oral advocacy opportunities, and
- Offering practical, hands-on training

As a result, LEAP:

- Develops a deep “bench” of talent and experience
- Improves the quality of cases heard by the Board and the courts, which supports client interests
- Increases diversity within the patent bar
Eligibility

- To qualify for LEAP, a patent agent or attorney must have:
  1. Three (3) or fewer substantive oral arguments in any federal tribunal, including PTAB, and
  2. Seven (7) or fewer years of experience as a licensed attorney or registered patent agent
Eligibility

• To qualify for LEAP, a patent agent or attorney must have:
  1. Three (3) or fewer substantive oral arguments in any federal tribunal, including PTAB, and
  2. Seven (7) or fewer years of experience as a licensed attorney or registered patent agent

• “Substantive” = arguments directed to the merits of the case
  – Not ancillary issues, e.g., scheduling or discovery disputes
Eligibility

• To qualify for LEAP, a patent agent or attorney must have:

  1. Three (3) or fewer substantive oral arguments in any federal tribunal, including PTAB, and

  2. Seven (7) or fewer years of experience as a licensed attorney or registered patent agent

• 7-year period begins with first licensure or registration

  • Not tolled for practice in a different field or jurisdiction, or for years away from practice altogether
How to apply

• Apply for a **specific** proceeding, **after** a hearing date is established

• Email [PTABHearings@uspto.gov](mailto:PTABHearings@uspto.gov) at least five (5) business days before the hearing
  
  • Submit a Request and Verification Form.
  
  • See [https://www.uspto.gov/patents/ptab/leap](https://www.uspto.gov/patents/ptab/leap) “LEAP participation requests,” for a sample combined form
Oral argument

• A party with a LEAP practitioner arguing at oral hearing typically receives 15 minutes of additional argument time

• Additional time is for the party
  – The LEAP practitioner must have a meaningful and substantive role, but need not argue for a specific amount of time

"By giving the extra time, it takes that out of the equation and makes it more accommodating, which can mitigate clients' concerns about splitting time."

Cory Bell, Partner
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
Oral argument

• More experienced counsel may provide some assistance to the LEAP practitioner, if necessary, and may make limited clarifications on the record

“PTAB’s program strikes a great balance. It incentivizes and encourages parties to allow more junior or less experienced attorneys to argue, while ensuring that if other counsel have value to add or would like to supplement the record, they may do so. There is little risk and much upside.”

Kathi Vidal, Silicon Valley Managing Partner
Winston & Strawn LLP
Training

• PTAB offers free LEAP training opportunities:
  – Oral advocacy skills
  – Preparing for an oral argument
  – AIA trials mock argument
  – Appeals mock argument
  – The “perfect” argument

• Available at “LEAP Preparation,”
  www.uspto.gov/patents/ptab/leap
Participation

• 51 LEAP requests
  – 18 AIA petitioners
  – 17 AIA patent owners
  – 16 *ex parte* appellants

• 37 firms and companies represented
Recent events

• 6 training webinars since inception
• Conducted by judges and external counsel
• 3 mock argument sessions
  – 2 AIA trials and 1 ex parte appeal
  – 120 participants
  – 120 judge volunteers
Thoughts from the patent community

This program will go a long way toward moving the needle and empowering and training our next generation of lawyers. Any time we rise the tide for junior lawyers, we necessarily rise the tide for all and thus promote diversity.

Kathi Vidal, Silicon Valley Managing Partner, Winston & Strawn LLP

“The PTAB has done a great job with the LEAP program. I really hope all practitioners who are eligible will take advantage of this program. In fact, not only law firms, but clients are very supportive of an initiative like this one that helps a practitioner grow and develop professionally!”

Naveen Modi, Partner & Global Vice Chair of IP, Paul Hastings LLP

“This program provides a runway of sorts to give people, incrementally, a shot at having those opportunities while balancing the risk to clients that something would go awry.”

Michael D. Specht, Director, Sterne, Kessler, Goldstein & Fox

“The PTAB’s LEAP provides meaningful and substantive opportunities for junior practitioners to hone their oral advocacy skills.”

Akkad Moussa, Associate, Kilpatrick Townsend & Stockton LLP
LEAP webpage

- https://www.uspto.gov/leap
Questions/comments