

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



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PTAB JUDICIAL CONFERENCE

June 29, 2017

UNITED STATES
PATENT AND TRADEMARK OFFICE

uspto

The Patent Trial and Appeal Board Judicial Conference
June 29, 2017

STATE OF THE BOARD

David P. Ruschke
Chief Administrative Patent Judge

Scott R. Boalick
Deputy Chief Administrative Patent Judge

UNITED STATES
PATENT AND TRADEMARK OFFICE



USPTO Locations

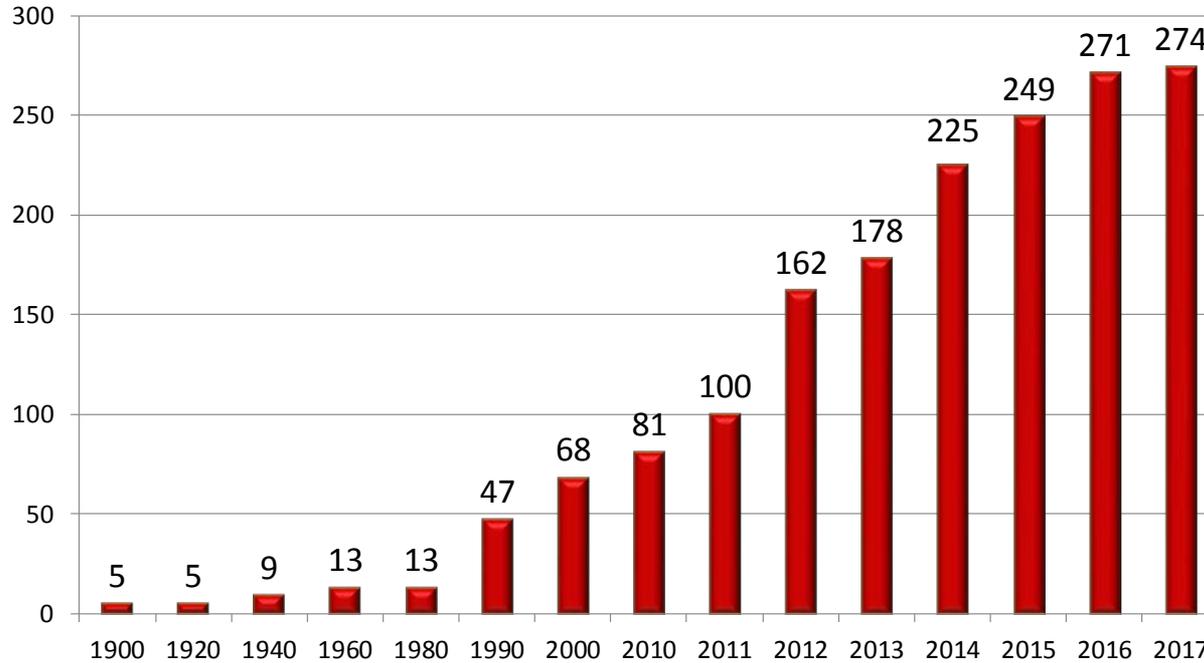


*Alexandria, Va. count includes judges who participate in TEAPP.



Board Size Over Time

(Calendar Year)

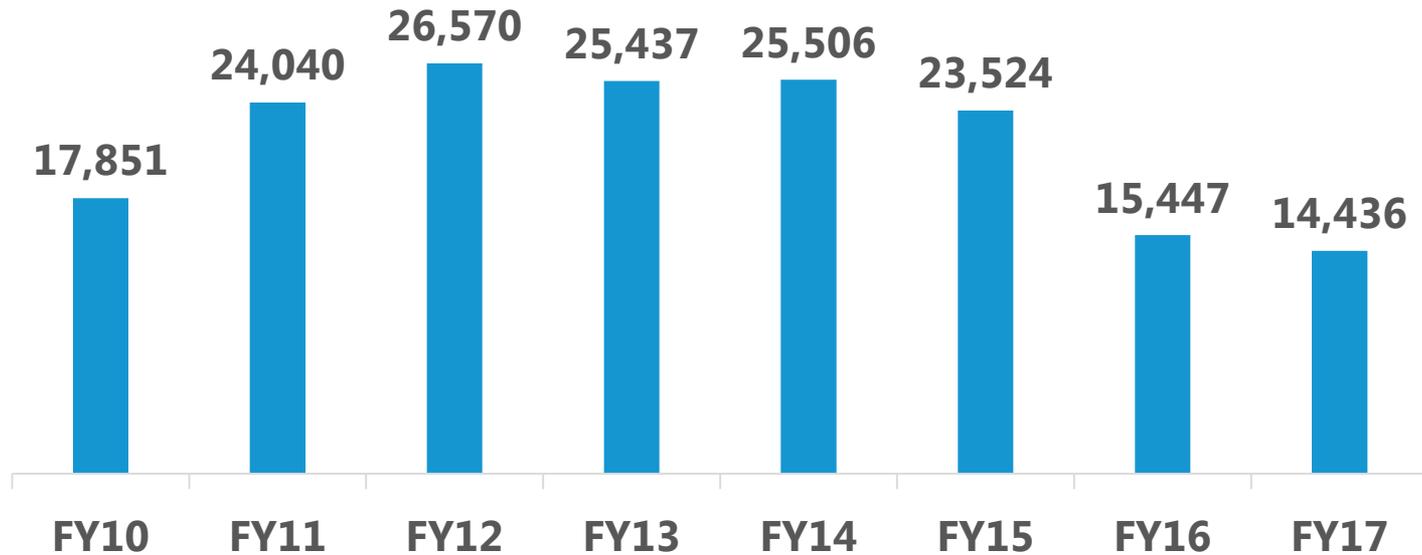


Ex Parte Appeals

APPEAL STATISTICS

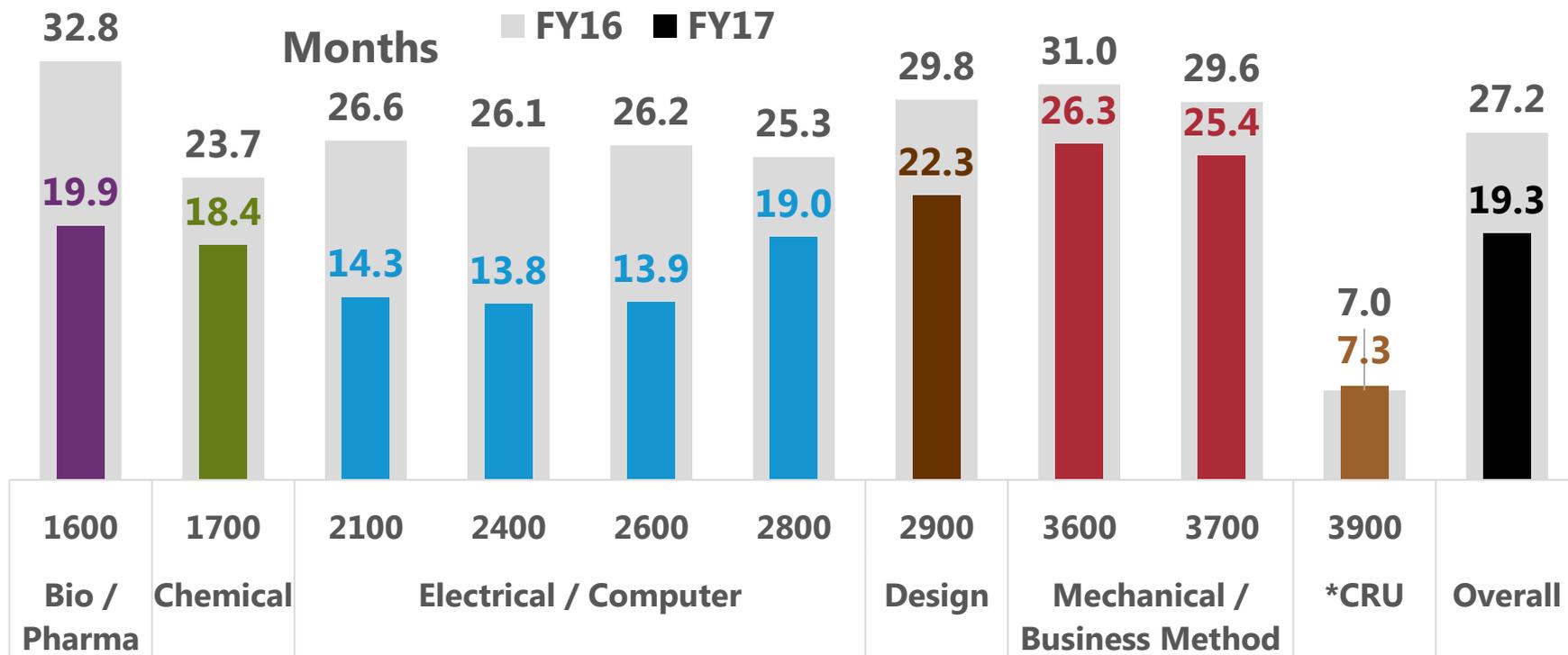
Pending Appeals

(FY10 to FY17: 10/1/09 to 4/30/17)



Pendency of Decided Appeals in FY16 and FY17

(4/30/16 compared to 4/30/17)

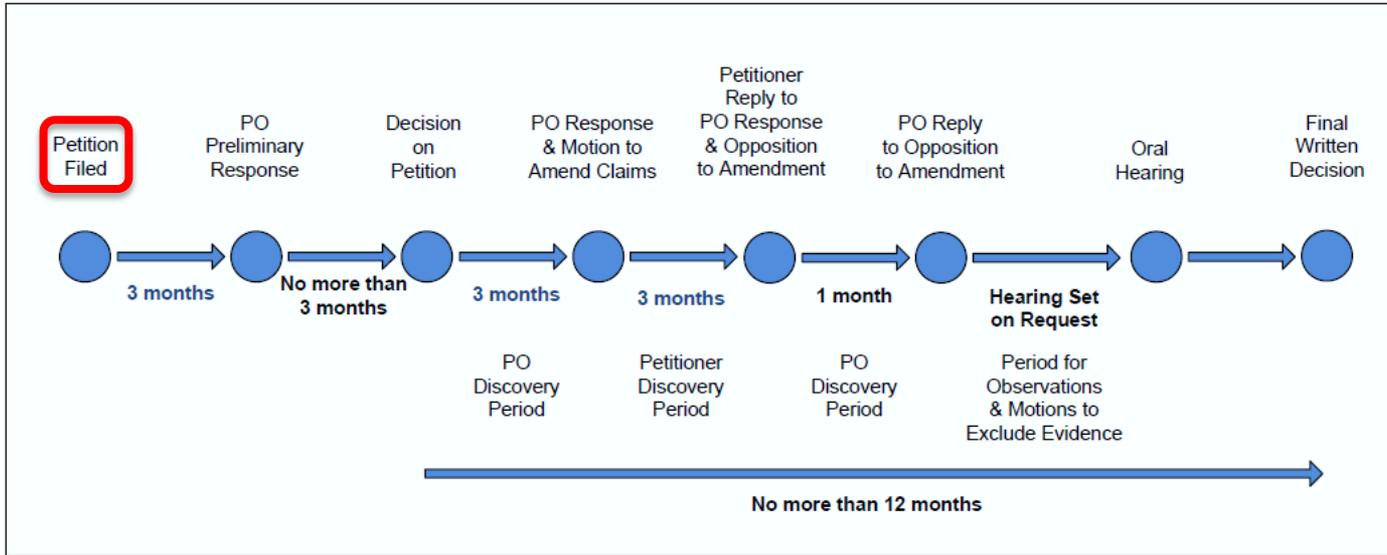


Pendency is calculated as average months from Board receipt date to final decision.
 *CRU (Central Reexamination Unit) includes ex parte reexams, inter partes reexams, supplemental examination reviews and reissues from all technologies.

Post-Grant Proceedings

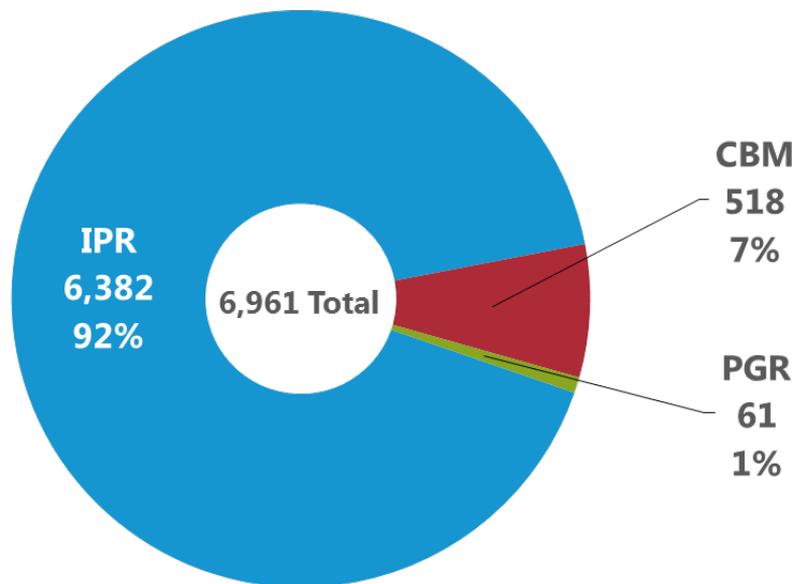
AIA TRIALS

Petition Filed



Petitions by Trial Type

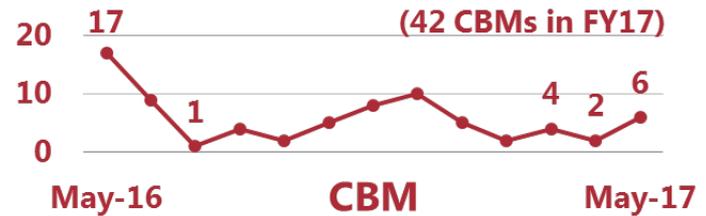
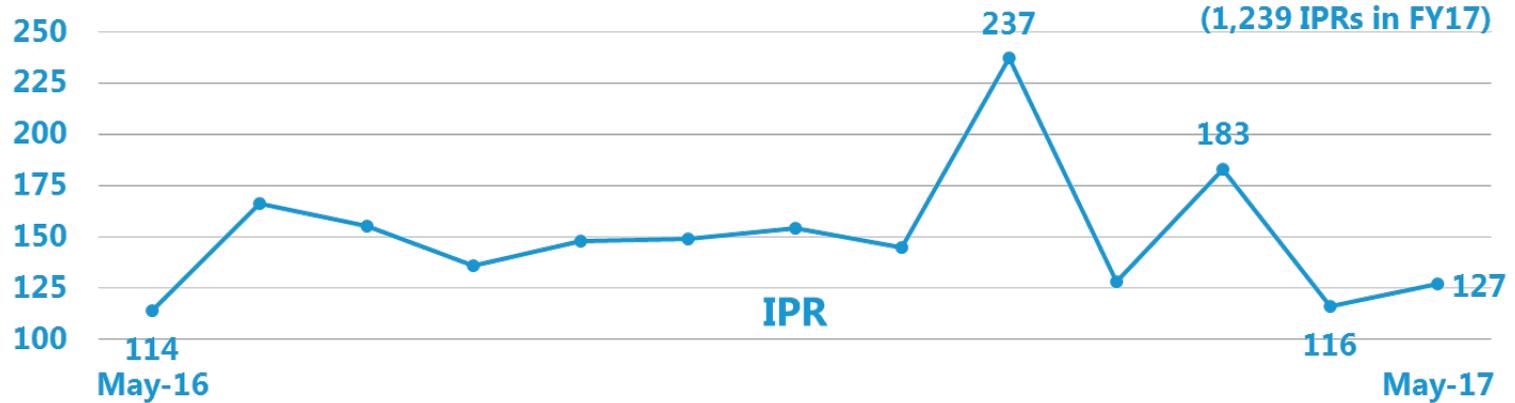
(All Time: 9/16/12 to 5/31/17)



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

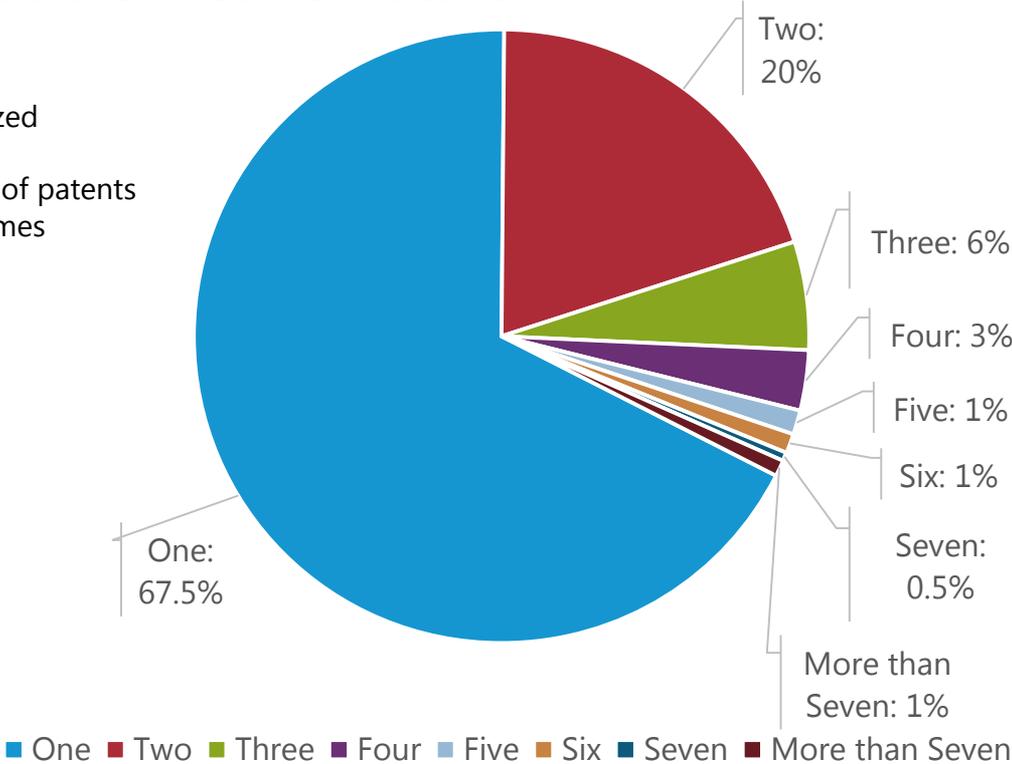
Petitions Filed by Month

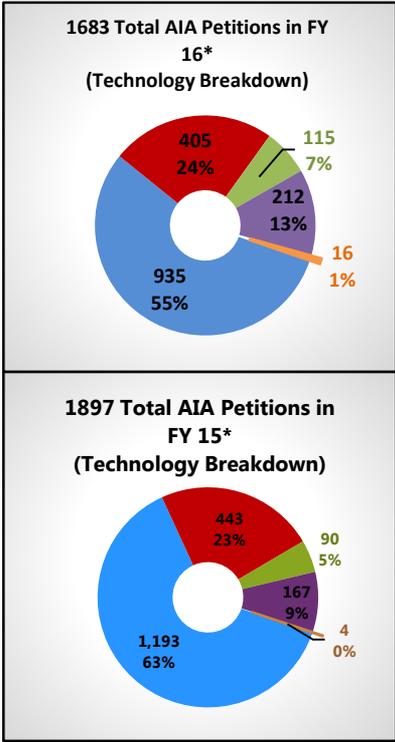
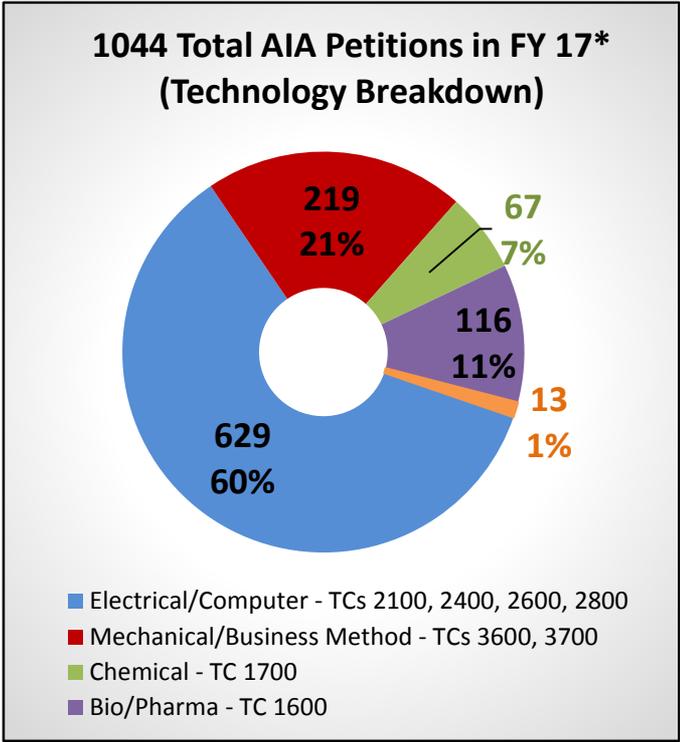
(May 2017 and Previous 12 Months: 5/1/16 to 5/31/17)



Number of Petitions Filed Per Patent (As of 2/28/17)

- 3,998 patents analyzed
- Approximately 88% of patents challenged 1 or 2 times





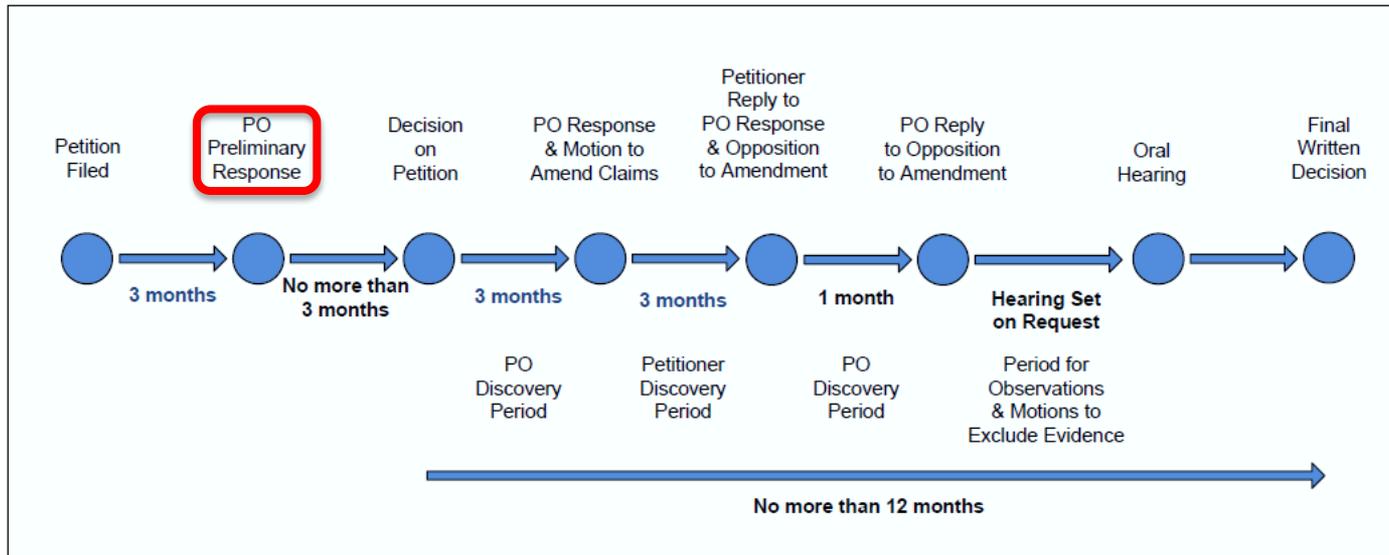
Narrative:

This pie chart shows the total number of AIA petitions filed in the current fiscal year to date as well as the number and percentage of these petitions broken down by technology.

*Data current as of: 3/31/2017

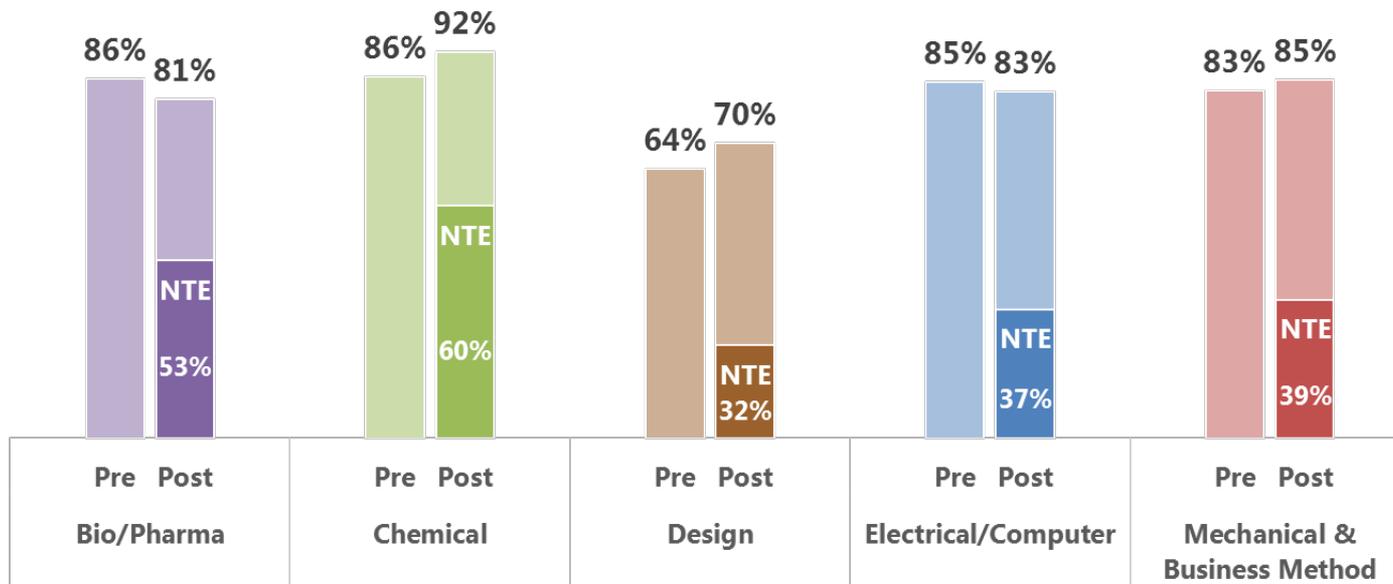


Patent Owner Preliminary Response



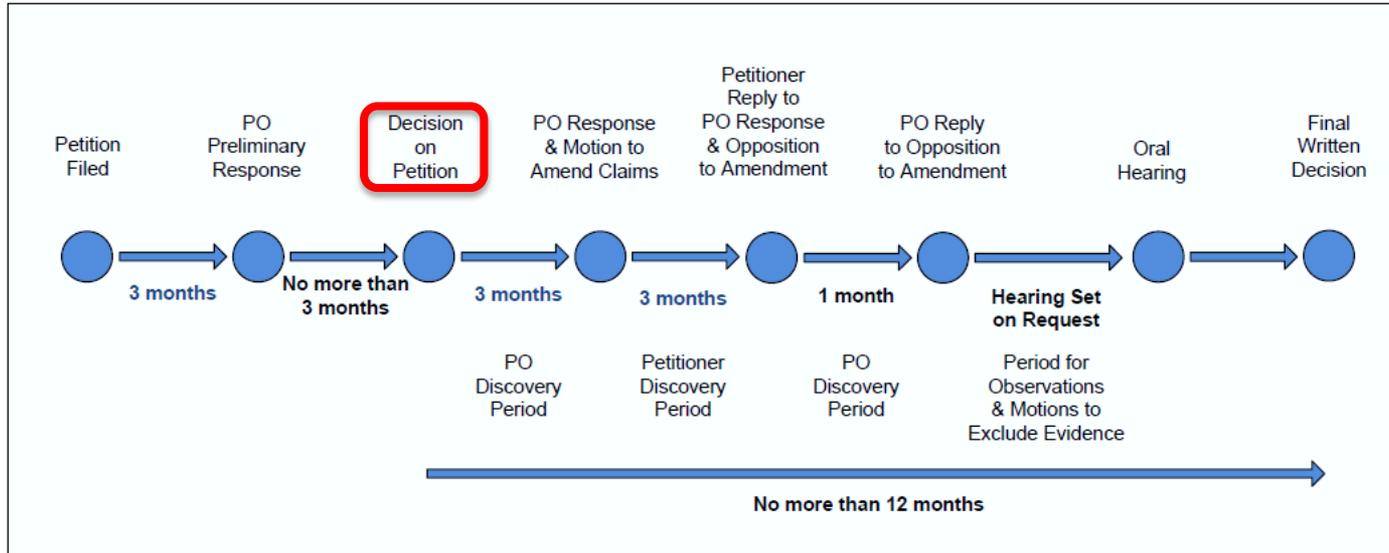
Preliminary Response Filing Rates

Pre- and Post-Rule To Allow New Testimonial Evidence (NTE) (All Time: 9/16/12 to 5/31/17)



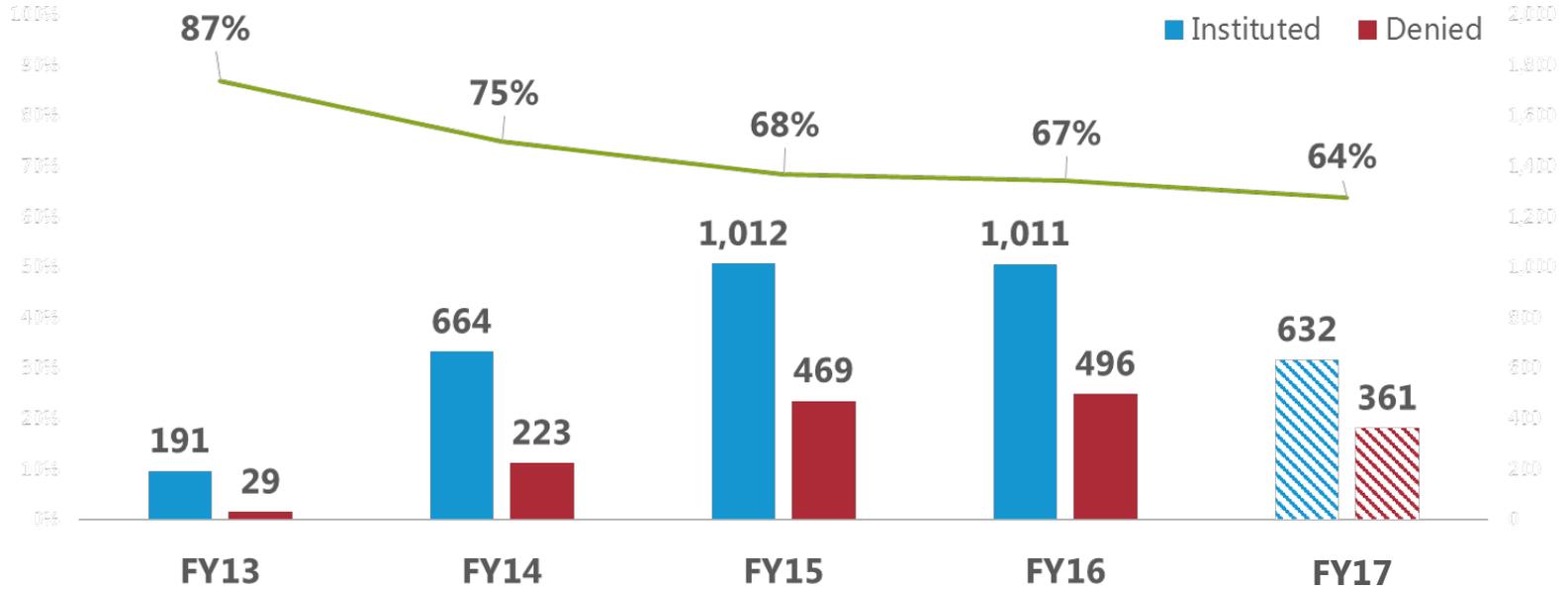
The rule to allow new testimonial evidence was effective May 2, 2016.

Institution Phase



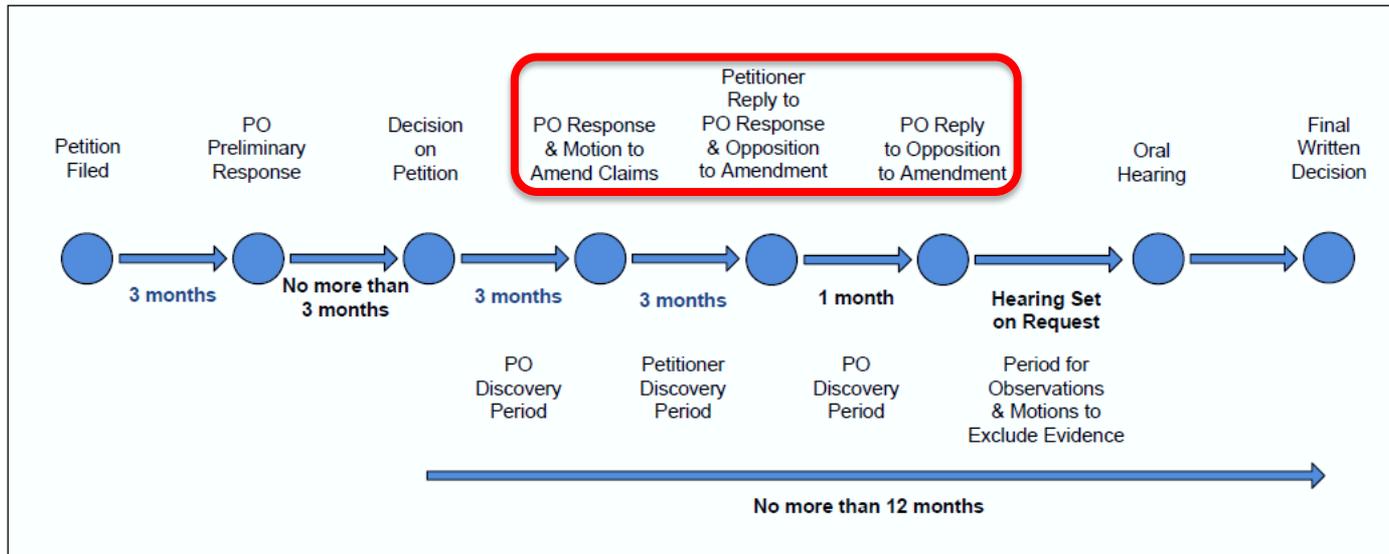
Institution Rates

(FY13 to FY17: 10/1/12 to 5/31/17)



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.

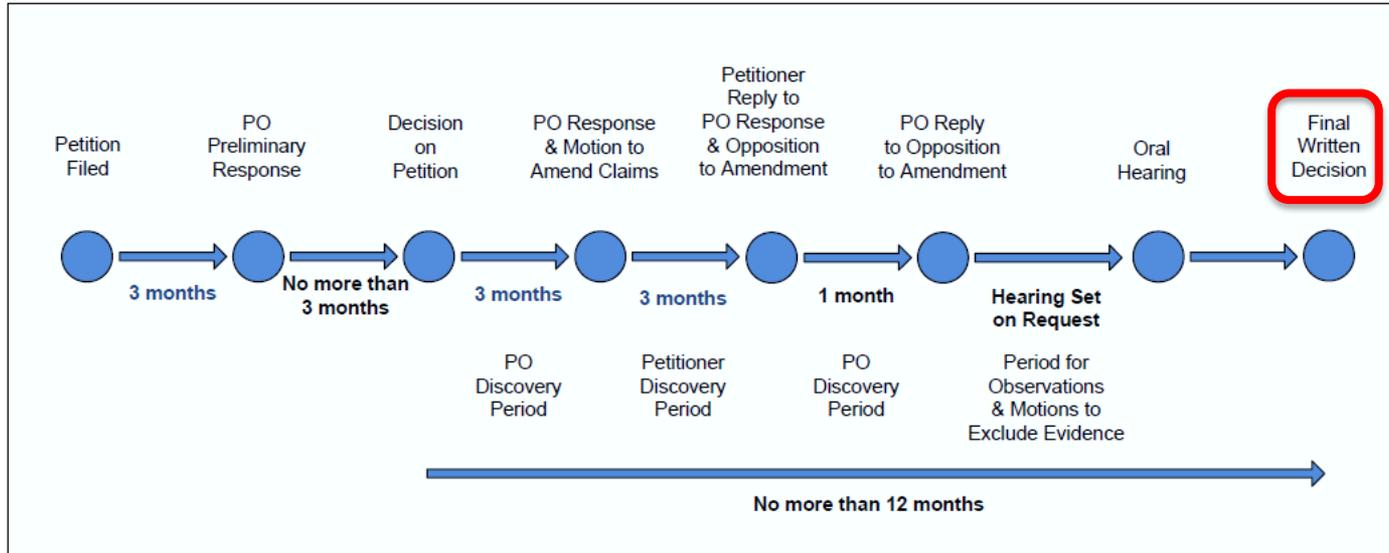
Motions to Amend



Motion to Amend Study

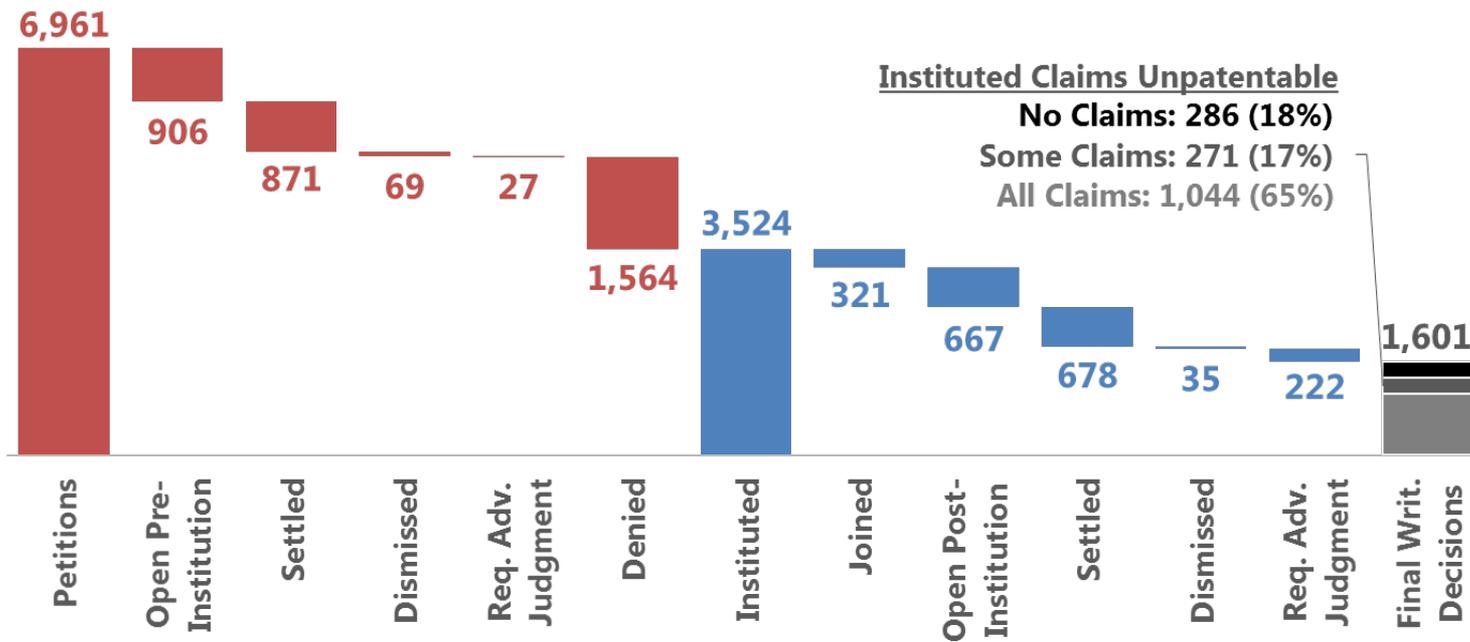
	Reason for Denying Entry	# of Motions	% of Motions
§102/103	Anticipated or Obvious Over Art of Record	62	40%
§102/103/112/316	Multiple Statutory Reasons	35	23%
	<i>*All included at least 102, 103, and/or 112 as a reason for denial</i>		
§101	Non-Statutory Subject Matter	9	6%
§112	Written Description	10	6%
§112	Enablement	3	2%
§112	Definiteness	1	1%
§316	Claims Enlarge Scope of Patent	9	6%
§316	Unreasonable Number of Substitute Claims	3	2%
	Procedural Reasons	22	14%
	Total Motions to Amend Denied	154	

Final Written Decision



Status of Petitions

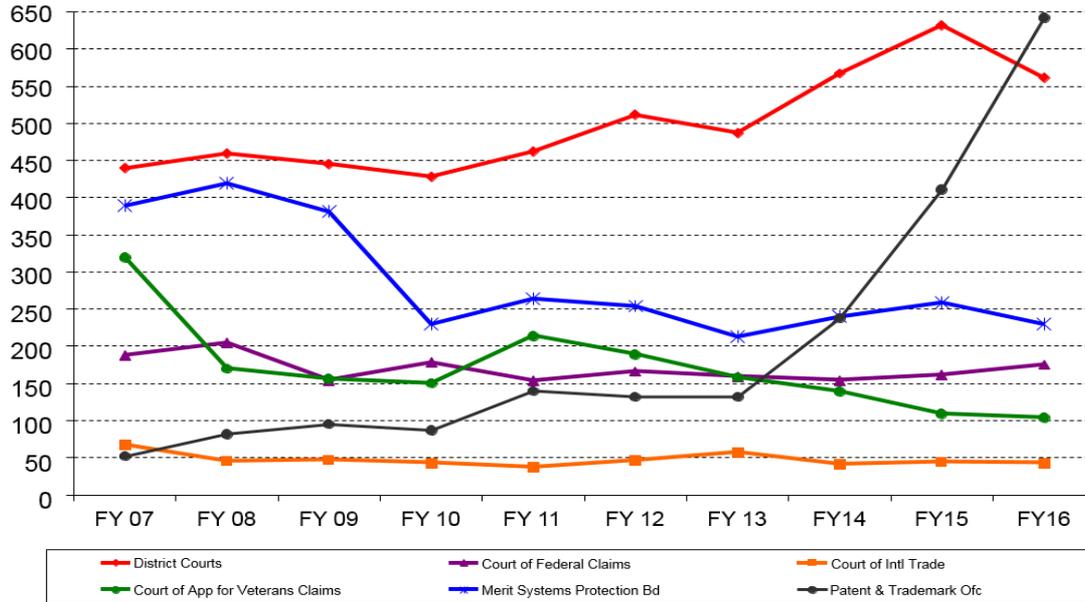
(All Time: 9/16/12 to 5/31/17)



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.



United States Court of Appeals for the Federal Circuit Appeals Filed in Major Origins



Notes: Includes reinstated, cross-, and consolidated appeals.

Source: <http://www.cafc.uscourts.gov/the-court/statistics>



Updates to PTAB Standard Operating Procedures

- SOP9 will standardize how each particular type of remand is handled. While some remands require very little, e.g., applying a new claim construction. Other types of remands may require new evidence or additional hearings.
- SOP9 will set an aspirational goal of issuing a decision on remand within 6 months of mandate.

Questions and Comments

David P. Ruschke

Chief Administrative Patent Judge

(571) 272-9797

David.Ruschke@USPTO.GOV

Scott R. Boalick

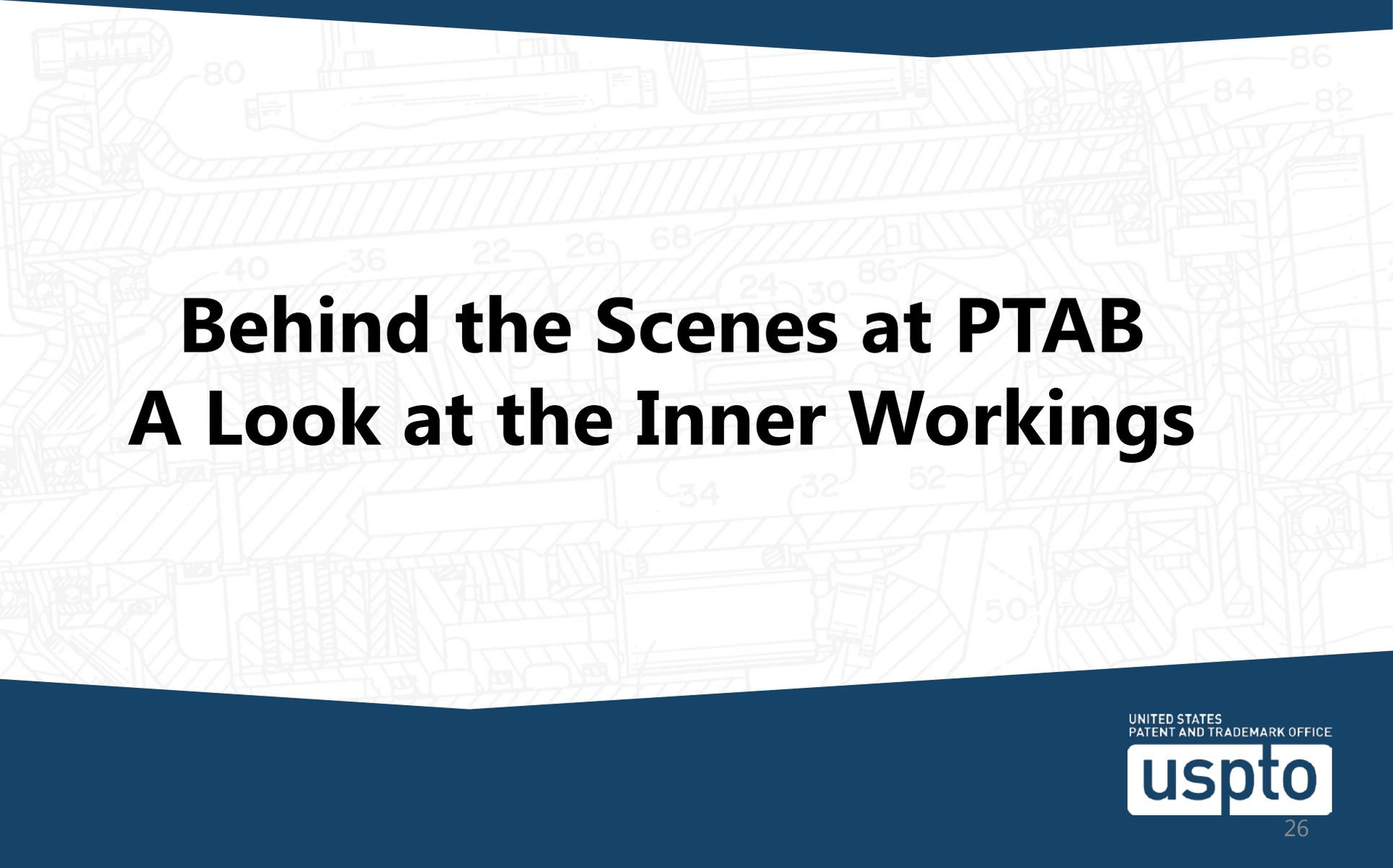
Deputy Chief Administrative Patent Judge

(571) 272-9797

Scott.Boalick@uspto.gov

UNITED STATES
PATENT AND TRADEMARK OFFICE



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Behind the Scenes at PTAB

A Look at the Inner Workings

UNITED STATES
PATENT AND TRADEMARK OFFICE



Behind the Scenes at PTAB

Moderator: Judge J. John Lee

- **Overview of PTAB Organization**
- **Introduction to PTAB Leadership**
- **A Look at the Inner Workings**

Overview of PTAB Organization



OFFICE OF THE CHIEF JUDGE
David Ruschke, Chief Judge
Scott Boalick, Deputy Chief Judge
(115100)

Krista Flanagan, Patent Attorney
Andrew Nalven, Patent Attorney
Sylvia Gerukos, Executive Assistant
Vacant, Executive Assistant

Jacqueline Bonilla
Vice Chief Judge for Operations
Division 1

Vacant
Vice Chief Judge for Operations
Division 2

Janet Gongola
Vice Chief Judge for
Engagement

Dave Talbott
Board Executive
Board Operations Division

Michael Tierney
Vice Chief Judge for Operations
Division 3

Scott Weidenfeller
Vice Chief Judge for Operations
Division 4

Lora Green
Lead Judge
Section 1

Christopher Crumbley
Lead Judge
Section 4

Brian Murphy
Lead Judge
Section 2

Scott Moore
Lead Judge
Section 9

Beverly Bunting
Lead Judge
Section 8

William Saindon
Lead Judge
Section 10

Kevin Turner
Lead Judge
Section 11

Stacey White
Lead Judge
Section 19

Thomas Giannetti
Lead Judge
Section 13

Patrick Boucher
Lead Judge
Section 15

Michael Zecher
Lead Judge
Section 20

Rae Lynn Guest
Lead Judge
Section 3

Michael Kim
Lead Judge
Section 6

Jeffrey Robertson
Lead Judge
Section 5

Susan Mitchell
Lead Judge
Section 7

William Fink
Lead Judge
Section 12

Melissa Haapala
Lead Judge
Section 16

Trenton Ward
Lead Judge
Section 14

Matthew Clements
Lead Judge
Section 17

David Kohut
Lead Judge
Section 21

Barbara Benoit
Lead Judge
Section 18

IT Systems &
Services Branch

Case Management
Branch

Data Analysis &
Process Improvement

Administrative
Management Branch

Hearing Operations

Paralegal Operations

Introduction to PTAB Leadership

- Chief Judge **David P. Ruschke**
- Deputy Chief Judge **Scott R. Boalick**

- Board Executive **Dave Talbott**
- Vice Chief Judge for Engagement **Janet A. Gongola**
- Vice Chief Judge **Jacqueline Wright Bonilla**
- Vice Chief Judge **Michael P. Tierney**
- Vice Chief Judge **Scott C. Weidenfeller**

Board Executive

Dave Talbott

- Technology Center Director (TC 3600, TC 2100, TC 2800)
 - Director, Search and Information Resources Administration (SIRA)
 - Director, PALM
 - Deputy Director, Office of Patent Automation
 - Supervisory Patent Examiner
-
- **B.S., Civil Engineering, West Virginia Institute of Technology**

Vice Chief Judge for Engagement

Janet A. Gongola

- Patent Reform Coordinator
- Associate Commissioner for Patent Examination Policy
- Associate Solicitor
- Adjunct Professor, George Washington University School of Law
- Law Clerk, Chief Judge Paul R. Michel (Fed. Cir.)
- Law Clerk, Chief Judge Sue L. Robinson (D. Del.)

- J.D., Indiana University School of Law
- B.S., Chemistry, Mathematics, Muskingum University



Vice Chief Judge

Jacqueline Wright Bonilla

- Lead Administrative Patent Judge
- Partner, Foley & Lardner LLP
- Law Clerk, Circuit Judge Randall R. Rader (Fed. Cir.)
- Associate, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP

- J.D., University of Virginia School of Law
- Ph.D., Cellular & Molecular Pharmacology, University of Virginia
- B.A., Biochemistry, University of California, Berkeley



Vice Chief Judge

Michael P. Tierney

- Lead Administrative Patent Judge
- Instrumental in rulemaking process for AIA trials
- Patent Examiner
- Associate, Morgan, Lewis & Bockius LLP

- J.D., University of Washington School of Law
- B.S., Chemical Engineering, University of Washington

Vice Chief Judge

Scott C. Weidenfeller

- Acting Deputy Solicitor
- Senior Counsel for Patent Law and Litigation
- Associate, Covington & Burling LLP
- Law Clerk, Circuit Judge Timothy B. Dyk (Fed. Cir.)

- J.D., Georgetown University Law Center
- B.S., Mechanical Engineering, Rice University
- B.A., Economics, Rice University

Behind the Scenes at PTAB

- Judge Panels

Behind the Scenes at PTAB

- Judge Panels
- **PTAB E2E**

Behind the Scenes at PTAB

- Judge Panels
- PTAB E2E
- **Hearings**

Behind the Scenes at PTAB

- Judge Panels
- PTAB E2E
- Hearings
- **Conference Calls**

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Perspectives from the Bench and Bar: Winning your Ex Parte Appeal

UNITED STATES
PATENT AND TRADEMARK OFFICE



Judge Linda Horner

Administrative Patent Judge Linda Horner was appointed to the Board of Patent Appeals and Interferences in 2006. She served as Acting Vice Chief Judge of the Patent Trial and Appeal Board from 2013-2014. At the Board, Judge Horner adjudicates appeals and AIA trial proceedings.

Prior to her appointment, Judge Horner was a Director at an intellectual property law firm in Washington, DC, where she prosecuted and litigated patent matters from 1994 to 2006. Judge Horner received her law degree from Boston University School of Law. She received her Bachelor's Degree in Mechanical Engineering from Cornell University.

Judge Tara Hutchings

Administrative Patent Judge Tara Hutchings was appointed to the Patent Trial and Appeal Board in 2014. At the Board, Judge Hutchings adjudicates appeals.

Prior to her appointment, Judge Hutchings was intellectual property counsel at a Fortune Global 500 company, where she primarily managed patent prosecutions from 2009-2014. She also prosecuted and litigated patent matters at law firms from 1999 to 2009. Judge Hutchings received her law degree from George Washington University Law School in 2004. She received her Master's Degree in Electrical Engineering from Syracuse University, her Bachelor's Degree in Electrical Engineering from University of Maryland, and her Bachelor's Degree in Physics from Salisbury University.

Malcolm McGowan

Malcolm McGowan is a partner at Cermak Nakajima & McGowan LLP, a boutique firm located in historic Alexandria, Virginia. Malcolm began his practice as a patent agent at Burns, Doane, Swecker and Mathis in 1994; since then he has represented clients before the USPTO in patent prosecution (including *ex parte* appeals), reexamination, and interference matters. Malcolm earned a Ph.D. in Neuropharmacology from the University of Chicago, and most of his practice has been in the pharmaceutical, biotech, and chemical arts. He holds a J.D. from the Georgetown University Law Center.



Charles (Chad) Wieland III

Charles (Chad) Wieland III is a Shareholder and Co-Chair of the Intellectual Property (IP) Section at Buchanan Ingersoll & Rooney PC. He has been a private patent practitioner for more than 28 years, focusing his practice on IP matters. Prior to joining Buchanan, Chad was a member of Burns, Doane, Swecker and Mathis, one of the top tier IP boutiques of its day – which was acquired by Buchanan Ingersoll & Rooney in 2005. His practice includes patent prosecution, client counseling and technology transactions, federal court litigation and AIA proceedings. He is a frequent lecturer on IP issues throughout the U.S. and abroad and has been recognized many times by his peers with various awards and honors. Chad is also a Founding Master and Chair of the Formation Committee of the Pauline Newman IP American Inn of Court. Prior to his law career, he was an examiner in x-ray and other radiant energy technologies.

A technical drawing of a mechanical assembly, possibly a piston or a similar component, rendered in a light gray line-art style. The drawing includes various hatching patterns to indicate different materials or cross-sections. Numerous callout numbers are scattered throughout the drawing, including 80, 84, 86, 82, 22, 26, 68, 40, 36, 34, 32, 52, 50, and 86. The drawing is set against a white background that is part of a larger blue and white graphic design.

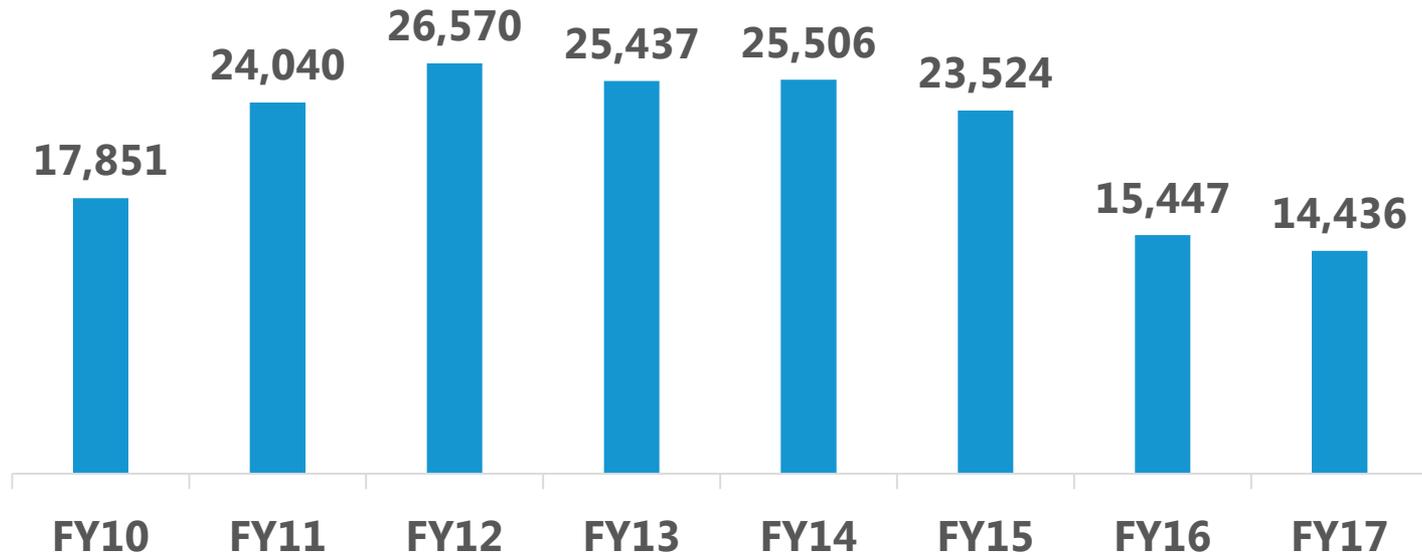
Perspectives from the Bench and Bar: Winning your Ex Parte Appeal

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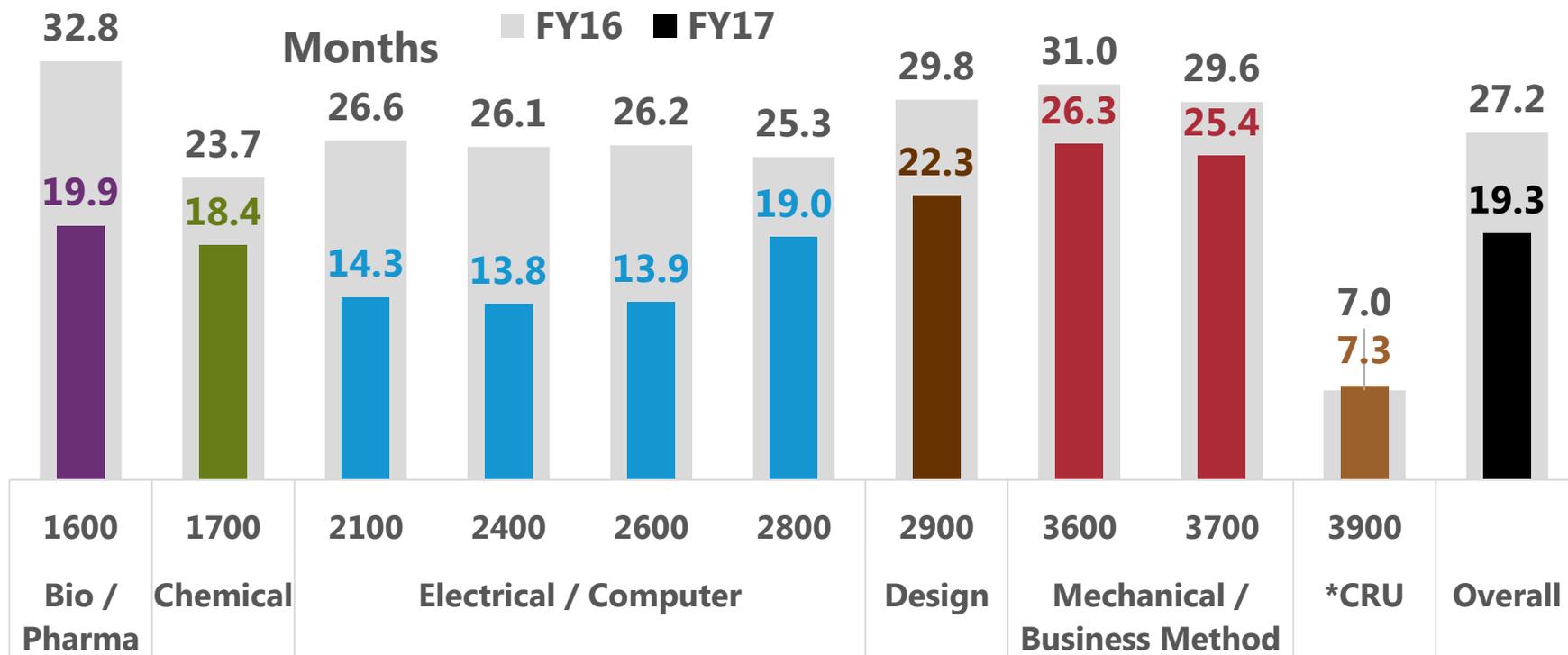
Pending Appeals

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Pendency of Decided Appeals in FY16 and FY17

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Perspectives from the Bench and Bar: Winning your Ex Parte Appeal

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AIA Trial Hot Topics

Introduction

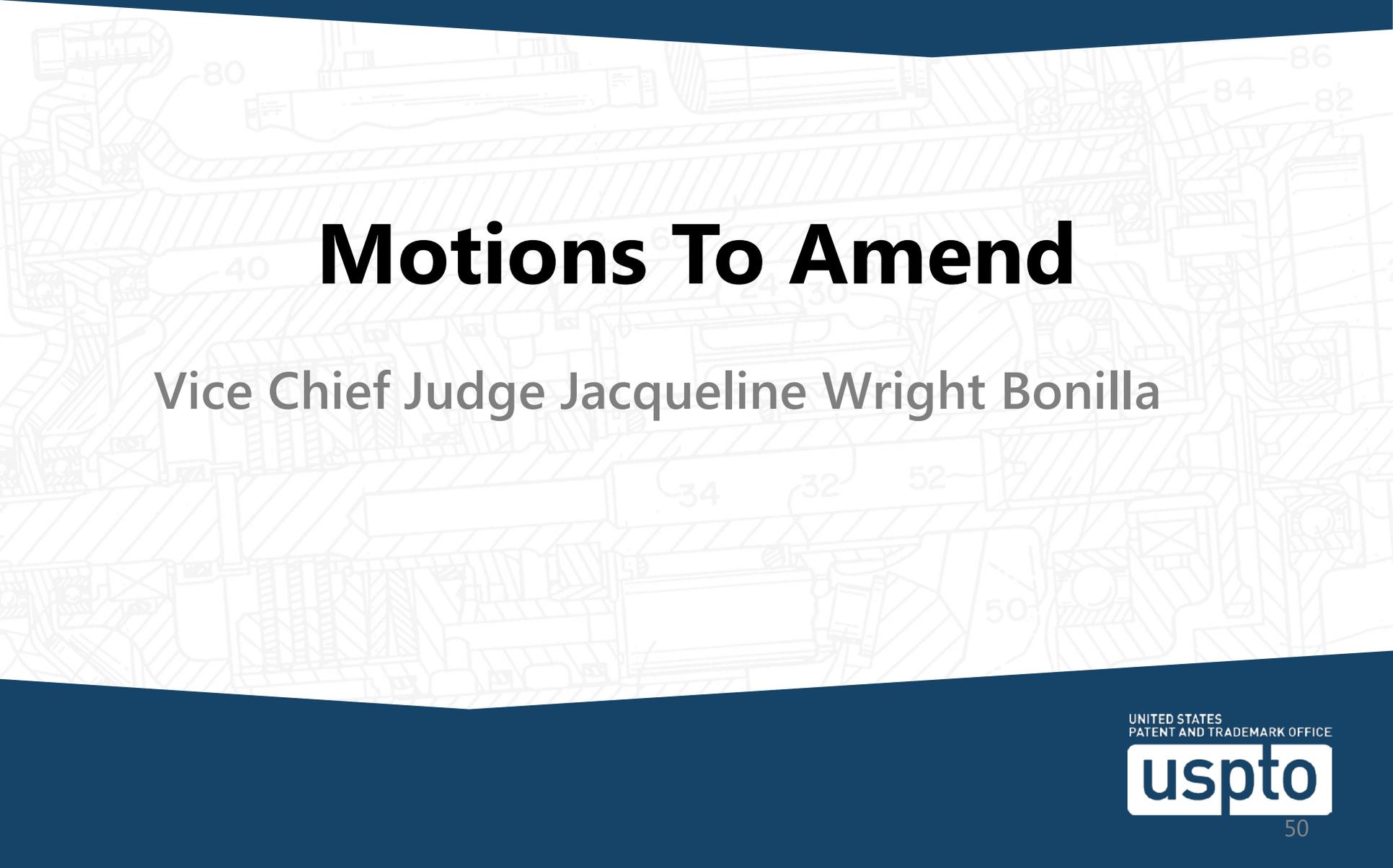
Judge Josiah Cocks

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Roundtable Discussions

- Your opportunity to provide input to the patent community and the PTAB
- Questions and scenarios on two topics using printed materials, also available to on-line participants
 - Motions to Amend
 - Multiple Petitions
- We will precede each topic with a short introduction
- Followed by table discussions and presentation of major points raised
- Each table will have a facilitator, typically a PTAB judge
- Table should select a spokesperson (other than the facilitator) to present to the attendees the major points raised during table discussions
- Time permitting, we will have a “lightning round” of general questions for multiple petitions discussion
- To facilitate exchange of different points of view, consider participating in a roundtable with colleagues you don’t work with all the time

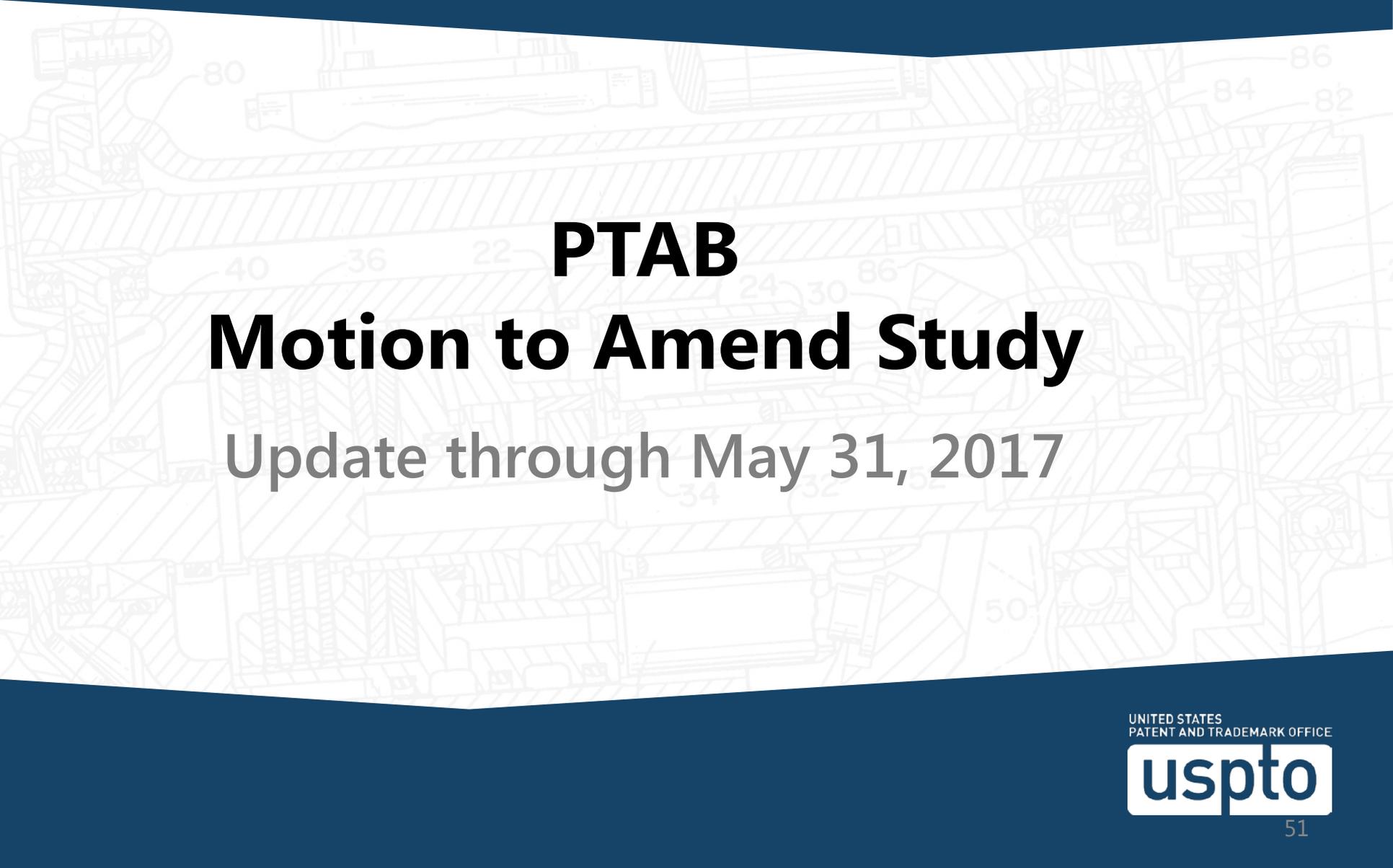
A technical drawing of a mechanical assembly, possibly a gear or a similar component, rendered in a light gray color. The drawing includes various parts, surfaces, and dimensions, with numbers like 80, 40, 24, 30, 34, 32, 52, 50, 84, 86, and 82 scattered throughout. The drawing is set against a dark blue background that has a wavy, torn-paper-like edge at the top and bottom.

Motions To Amend

Vice Chief Judge Jacqueline Wright Bonilla

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PATENT AND TRADEMARK OFFICE



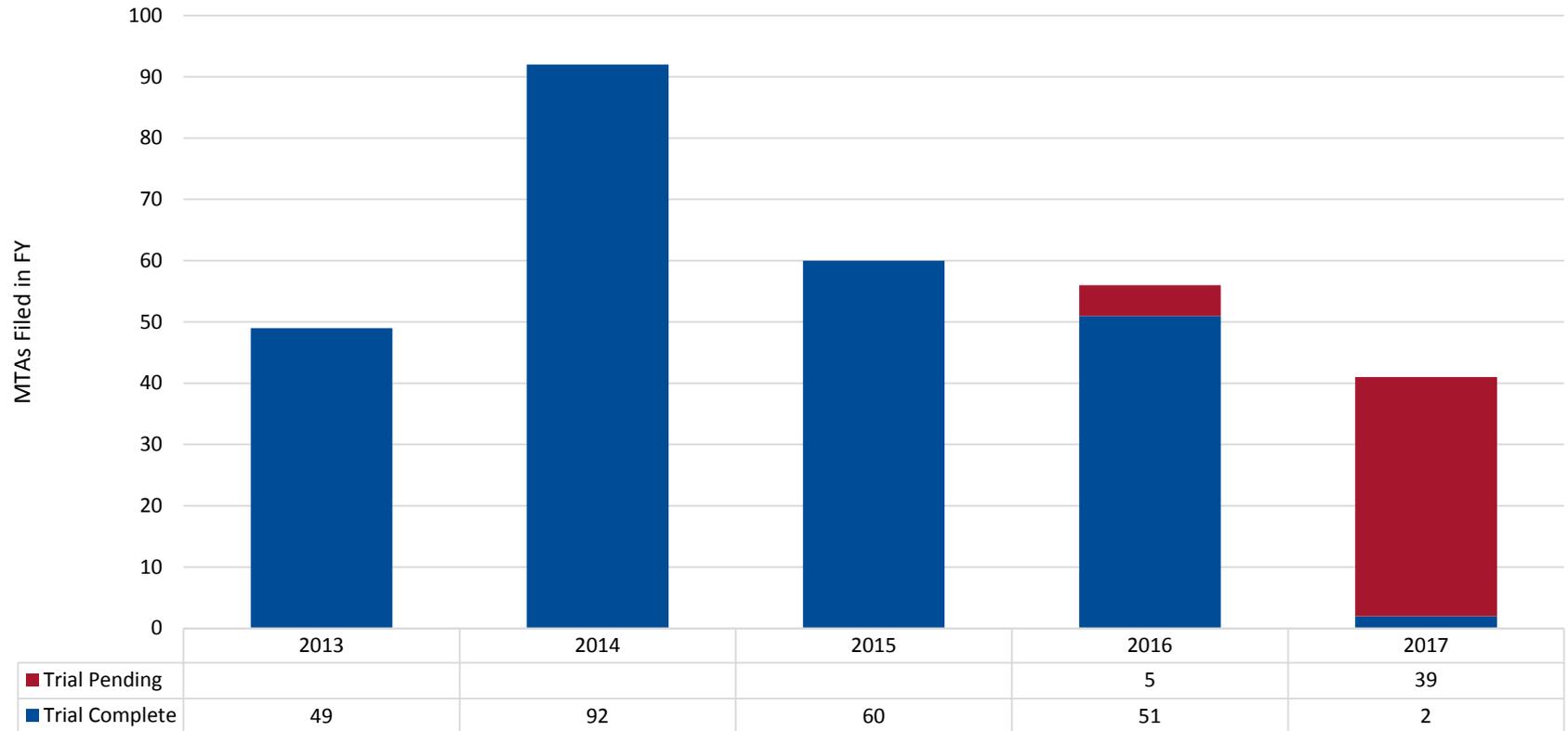


PTAB
Motion to Amend Study
Update through May 31, 2017

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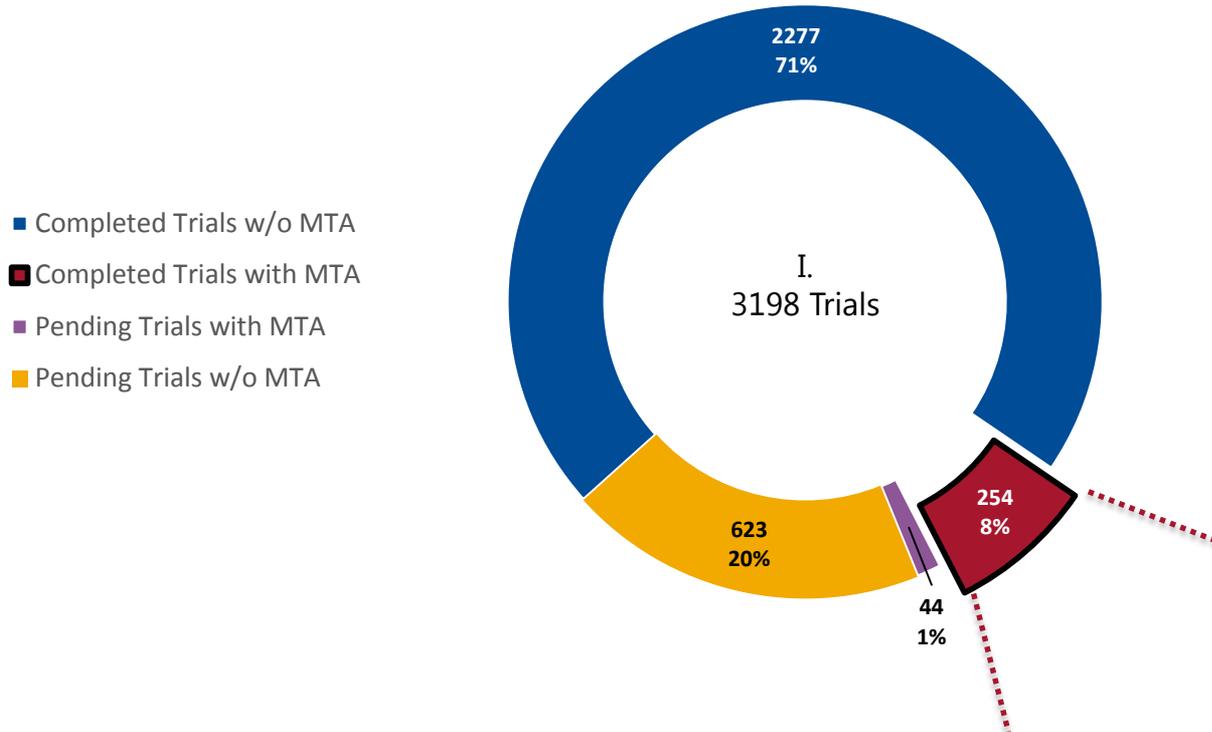
How Many Motions to Amend Were Filed in Each Fiscal Year?



* Data for FY2017 are from October 1, 2016–May 31, 2017

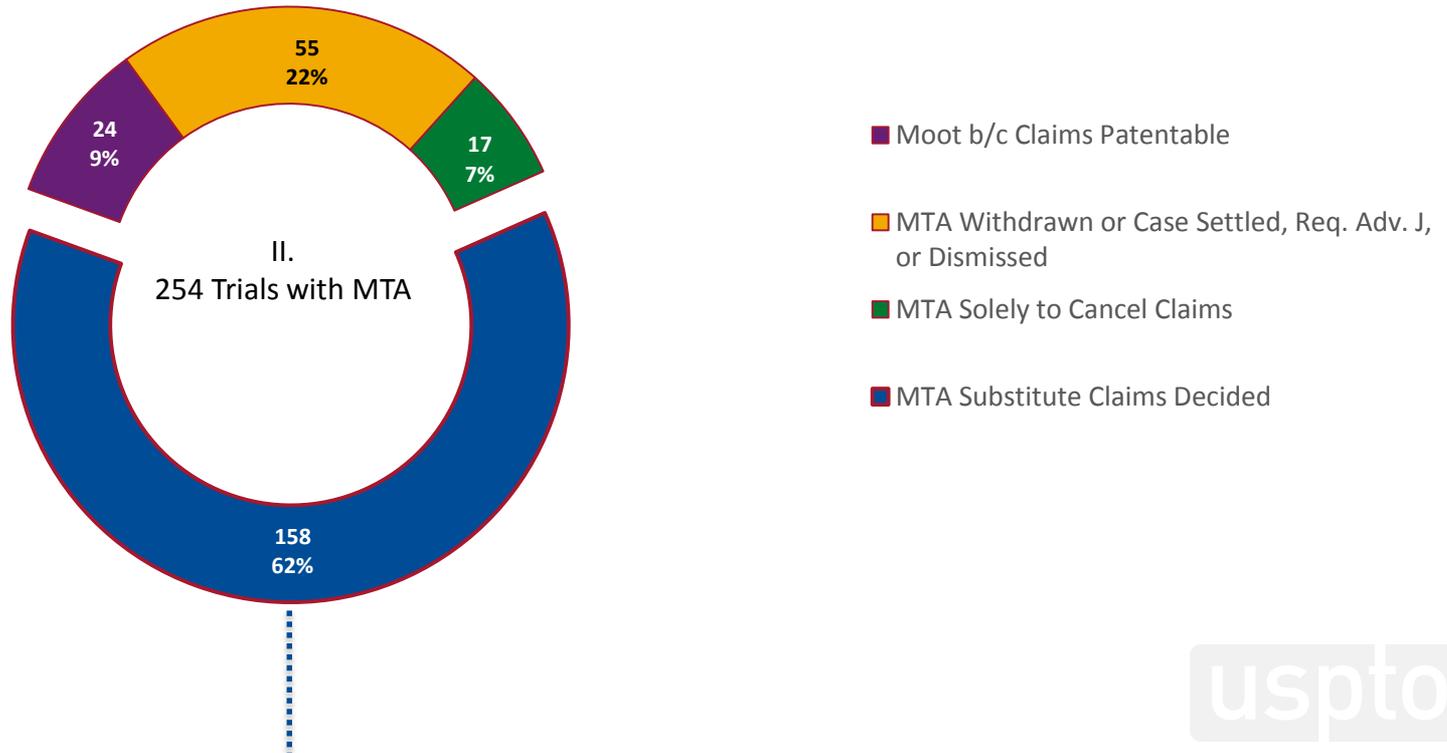
Graph I

How Many Motions to Amend Are Filed?



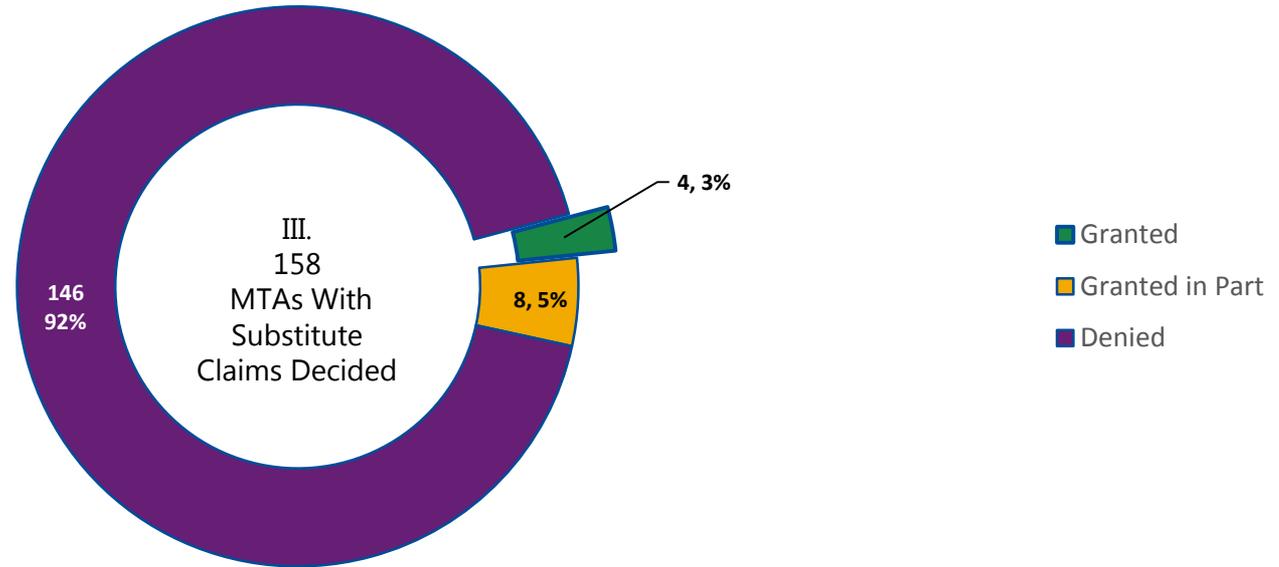
Graph II

Subsequent Developments of the Motions to Amend

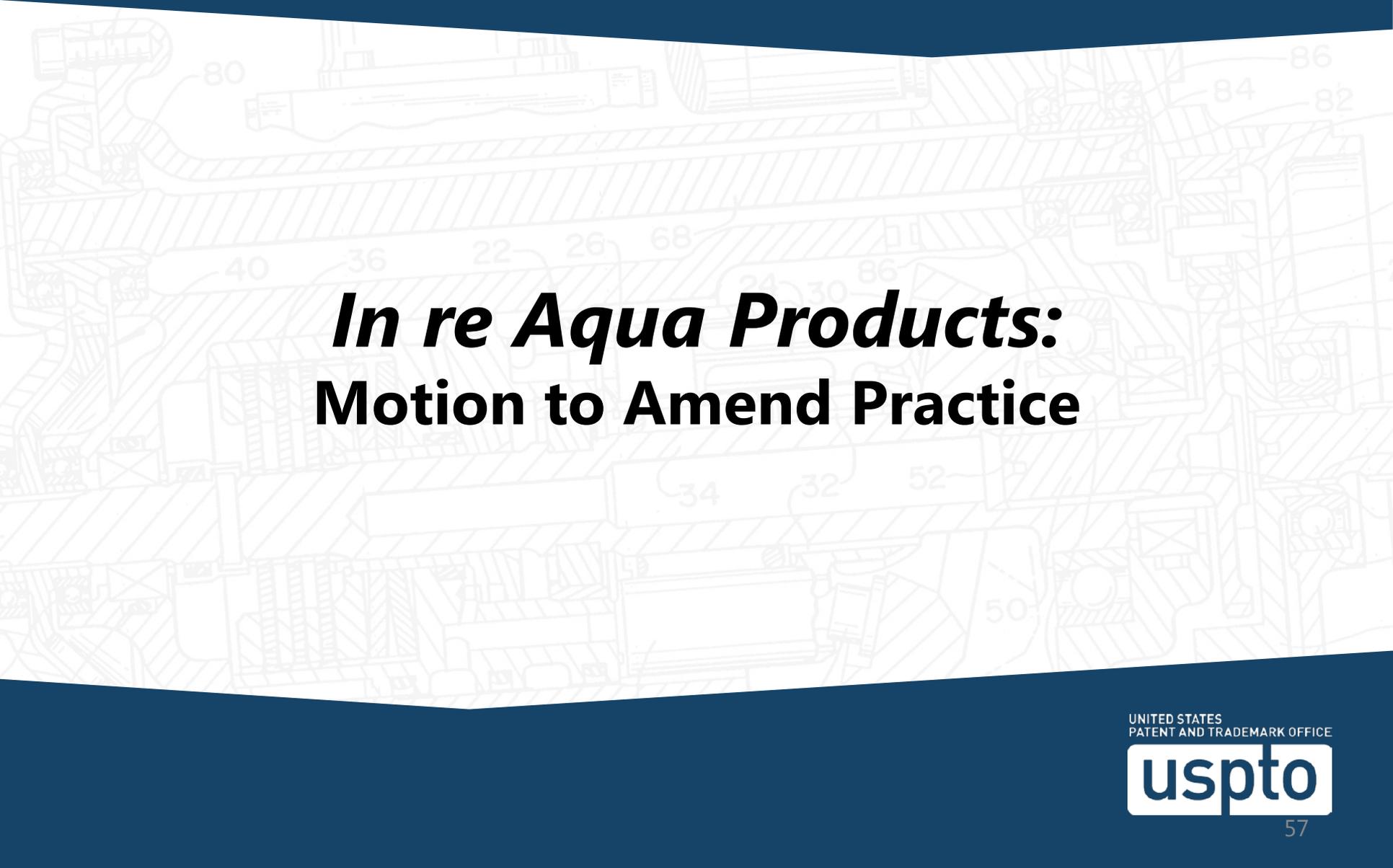


Graph III

How Many Motions to Amend Substituting Claims Are Granted?



	Reason for Denying Entry	# of Motions	% of Motions
§102/103	Anticipated or Obvious Over Art of Record	62	40%
§§102/103 112/316	Multiple Statutory Reasons *All included at least 102, 103, and/or 112 as a reason for denial	35	23%
§101	Non-Statutory Subject Matter	9	6%
§112	Written Description	10	6%
§112	Enablement	3	2%
§112	Definiteness	1	1%
§316	Claims Enlarge Scope of Patent	9	6%
§316	Unreasonable Number of Substitute Claims	3	2%
	Procedural Reasons	22	14%
	<i>Total Motions to Amend Denied</i>	154	100%



In re Aqua Products:
Motion to Amend Practice

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In re Aqua Products

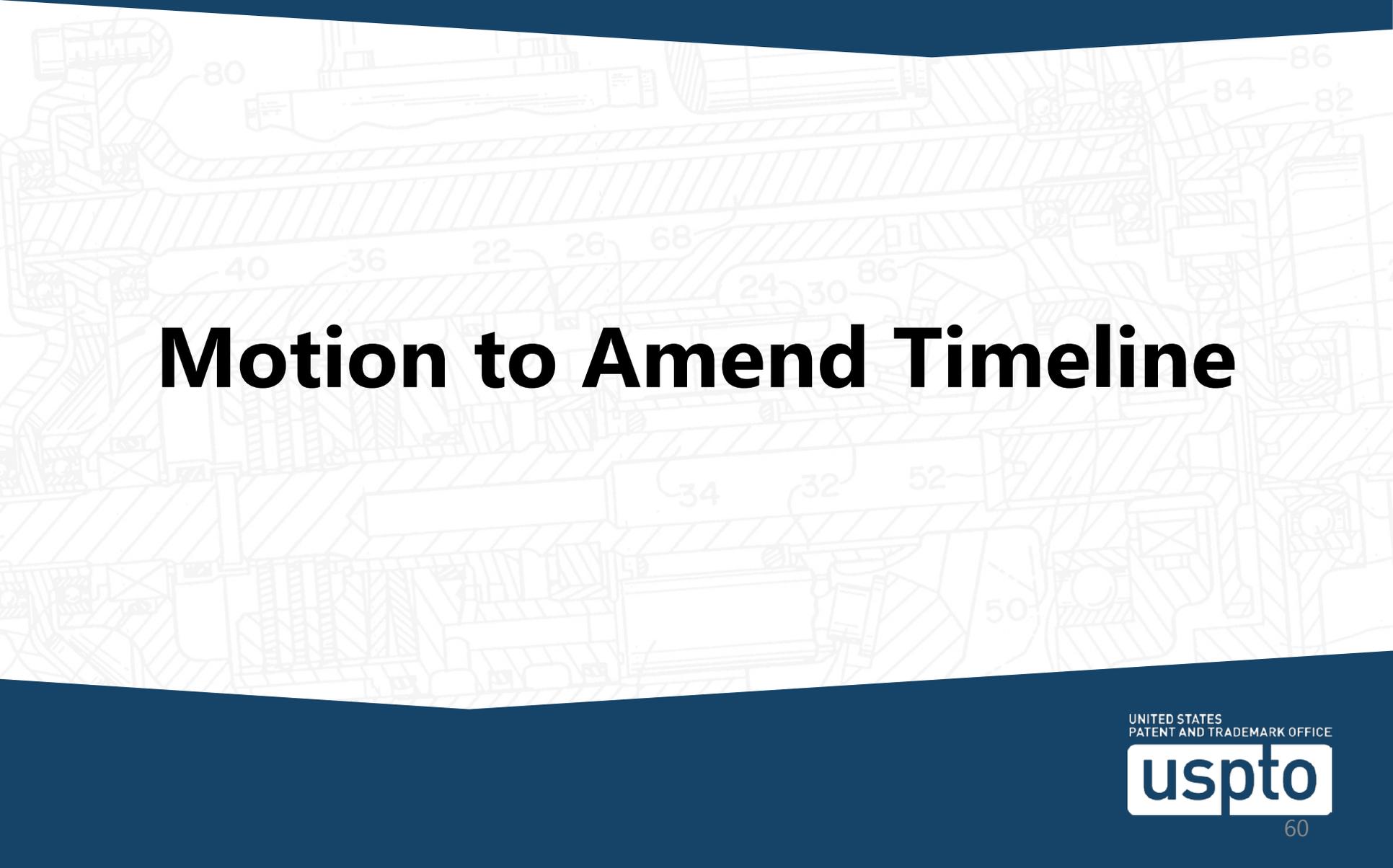
- In IPR2013-00159, PTAB denied Aqua's motion to substitute claims 22–24, which amended claims 1, 8, and 20 to require additional limitations
- Federal Circuit affirmed on May 25, 2016 (Prost, Reyna, Stark)
- Federal Circuit issued order granting rehearing en banc on Aug. 12, 2016 (per curiam)
- En banc oral argument heard on Dec. 9, 2016

In re Aqua Products—Rehearing en banc

Questions for appellant and USPTO intervenor:

Q1: When a patent owner (“PO”) moves to amend claims under 35 U.S.C. § 316(d), may the PTO require PO to bear the burden of persuasion, or a burden of production, regarding patentability of amended claims as a condition of allowing them? Which burdens are permitted under 35 U.S.C. § 316(e)?

Q2: When a petitioner does not challenge the patentability of a proposed amended claim, or the Board thinks the challenge is inadequate, may the Board sua sponte raise patentability challenges to such a claim? If so, where would the burden of persuasion, or a burden of production, lie?

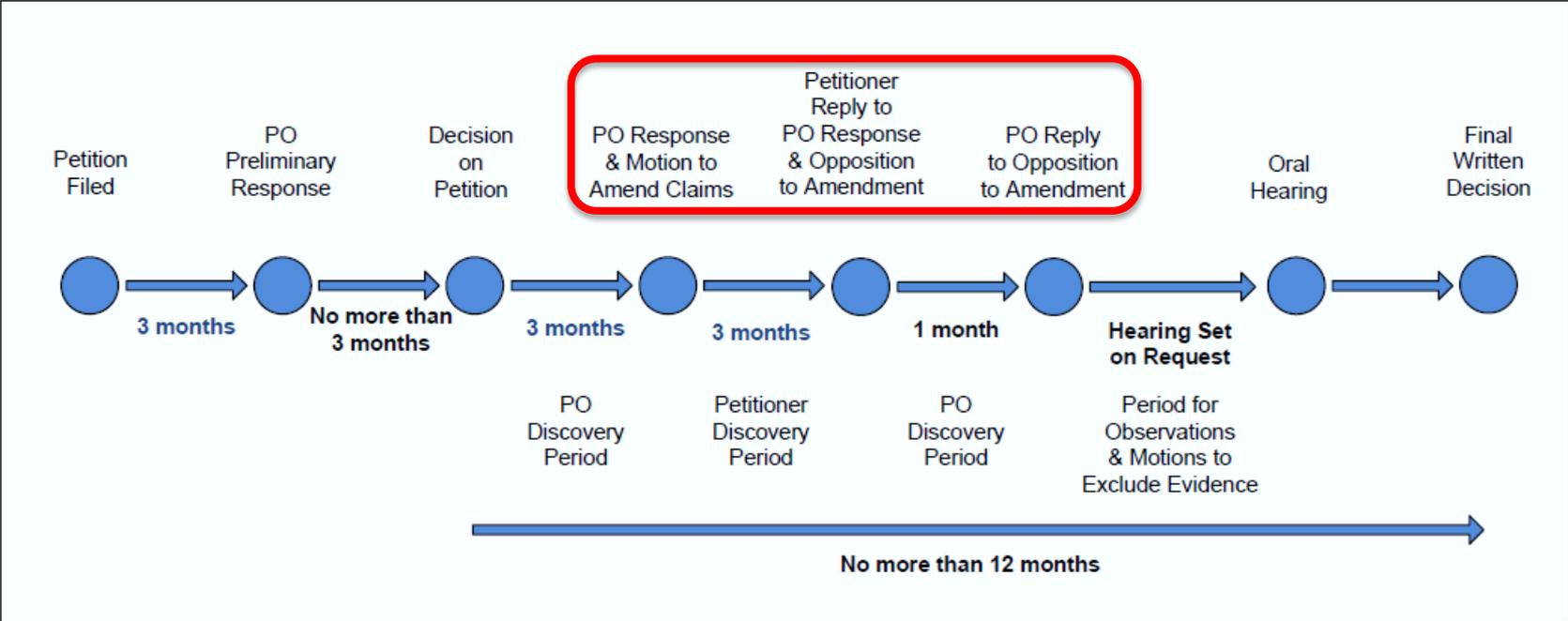
A technical drawing of a mechanical assembly, possibly a multi-layer printed circuit board (PCB) or a similar electronic component. The drawing is rendered in a light gray line-art style against a white background. It features numerous rectangular and cylindrical components, some of which are labeled with numerical callouts such as 80, 84, 86, 82, 40, 36, 22, 26, 68, 24, 30, 86, 34, 32, 52, and 50. The drawing is oriented horizontally and occupies the upper and middle portions of the slide.

Motion to Amend Timeline

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Motion to Amend



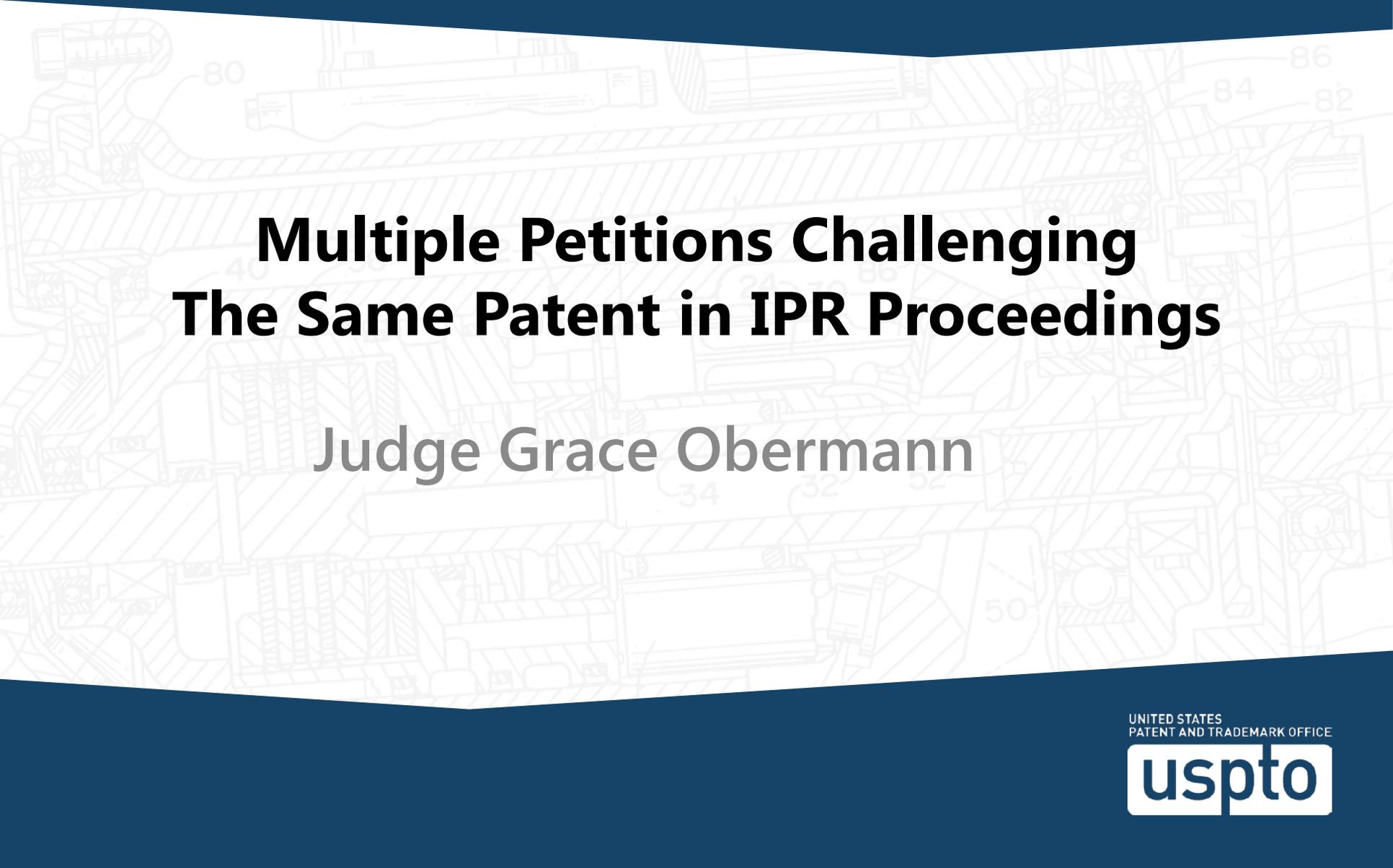
A technical drawing of a mechanical assembly, possibly a multi-layer printed circuit board (PCB) or a similar electronic component. The drawing is rendered in a light gray color and features numerous callout numbers such as 80, 86, 84, 82, 40, 36, 24, 30, 34, 32, 50, and 52. The drawing shows various layers, components, and connections, with hatching used to indicate different materials or cross-sections.

Motions to Amend

Roundtable Discussion

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The background of the slide is a technical drawing of a mechanical assembly, possibly a gear or a similar component, rendered in a light gray color. The drawing includes various lines, hatching, and numerical callouts such as 80, 84, 86, 82, 40, 34, 32, 50, and 52, which are typical of engineering blueprints. The drawing is centered and occupies most of the slide's area.

Multiple Petitions Challenging The Same Patent in IPR Proceedings

Judge Grace Obermann

UNITED STATES
PATENT AND TRADEMARK OFFICE

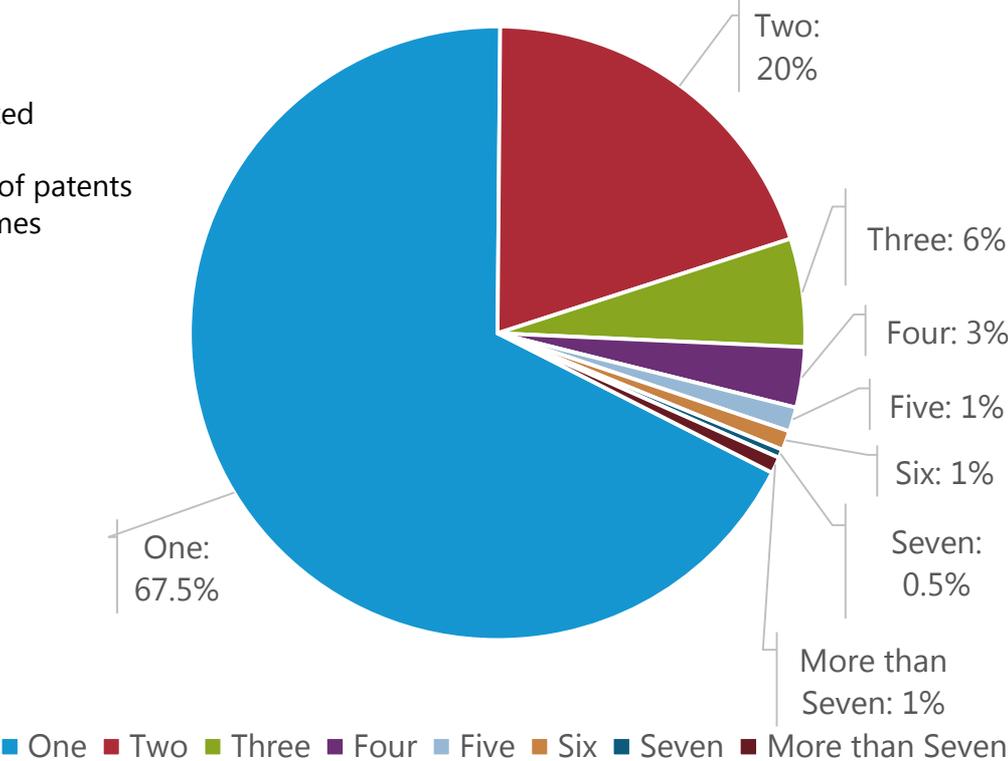
uspto

Multiple Petition Study

- Having heard from a number of stakeholders concerned about multiple petitions filed against a single patent, the Board has undertaken a study of the prevalence of such filings.
- The study is based on five-years' worth of data representing about 4,000 patents challenged in AIA trial proceedings.
- The data includes all patents challenged in IPR, PGR, and CBM petitions filed from September 2012 through February 2017.

Number of Petitions Filed Per Patent (As of 2/28/17)

- 3,998 patents analyzed
- Approximately 88% of patents challenged 1 or 2 times





Multiple Petitions

Roundtable Discussion

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Questions and Comments

David P. Ruschke

Chief Administrative Patent Judge
(571) 272-9797

David.Ruschke@USPTO.GOV

<https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/suggestion-box>

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A technical drawing of a mechanical assembly, possibly a piston and crankshaft, rendered in white lines on a dark blue background. The drawing includes various parts with numerical callouts such as 80, 84, 86, 82, 40, 36, 22, 26, 68, 24, 30, 86, 34, 32, 52, 50, and 68. The text "Thank You for Attending" is centered over the drawing in a large, bold, black font.

Thank You for Attending

UNITED STATES
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