

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# ***Inter Partes* Review/Post Grant Review: Status Report and Overview of the New Rules**

Lora M. Green

Lead Administrative Patent Judge

Patent Trial and Appeal Board

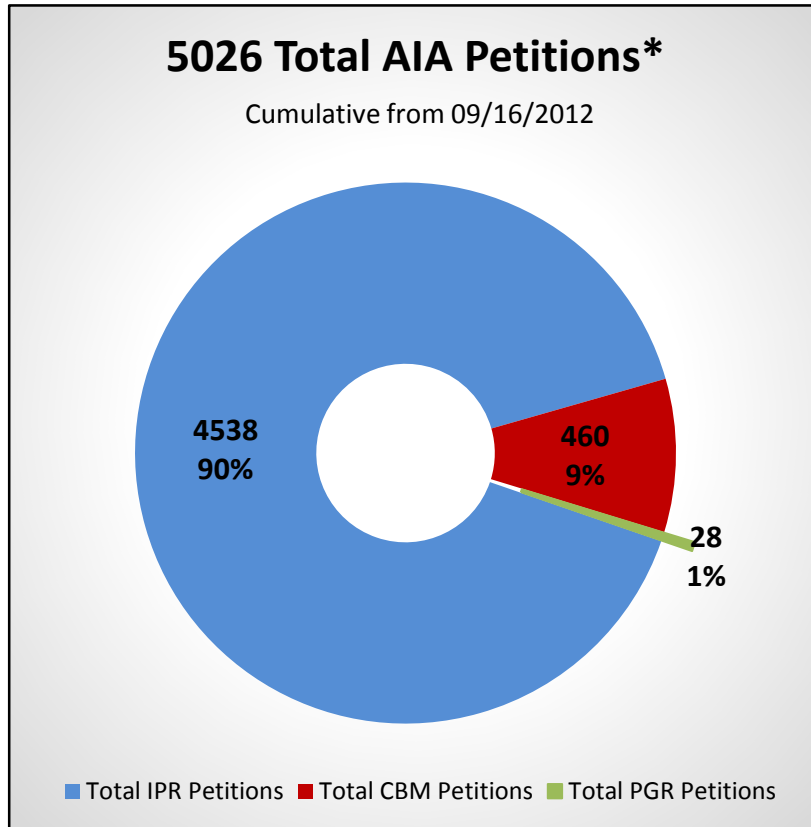
United States Patent and Trademark Office

June 30, 2016

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# Total AIA Petitions

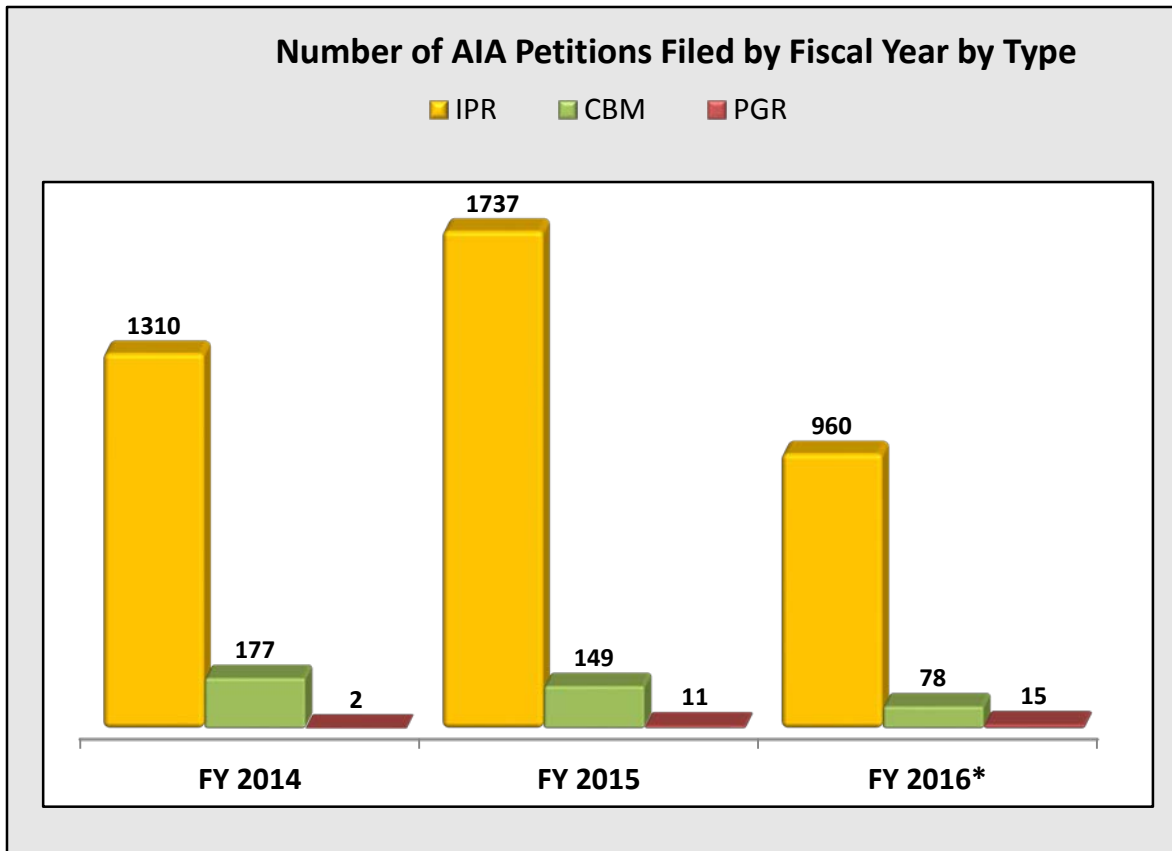


**Narrative:**

This pie chart shows the total number of cumulative AIA petitions filed to date broken out by trial type (i.e., IPR, CBM, and PGR).

**\*Data current as of: 5/31/2016**

# AIA Petitions By Type



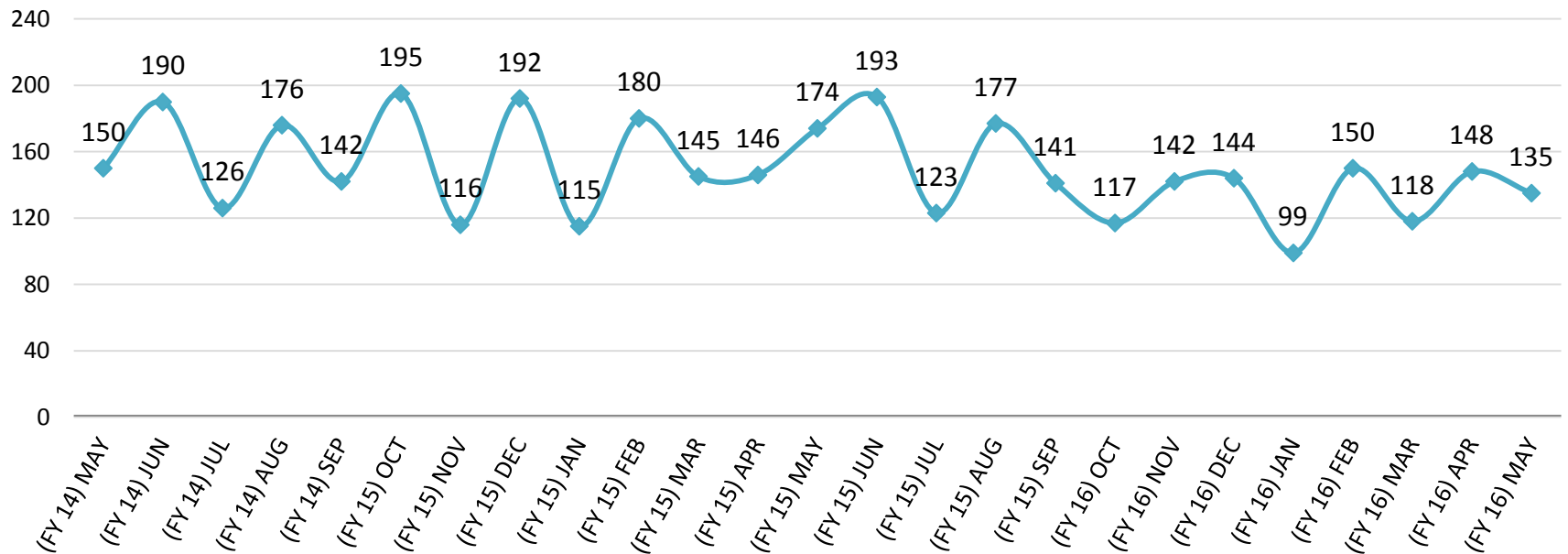
## Narrative:

This bar graph depicts the number of AIA petitions filed each fiscal year, with each bar showing the filings for that fiscal year by trial type (i.e., IPR, CBM, and PGR).

**\*Data current as of: 5/31/2016**

# AIA Petitions By Month

## Number of TOTAL Petitions Filed by Month\*



### Narrative:

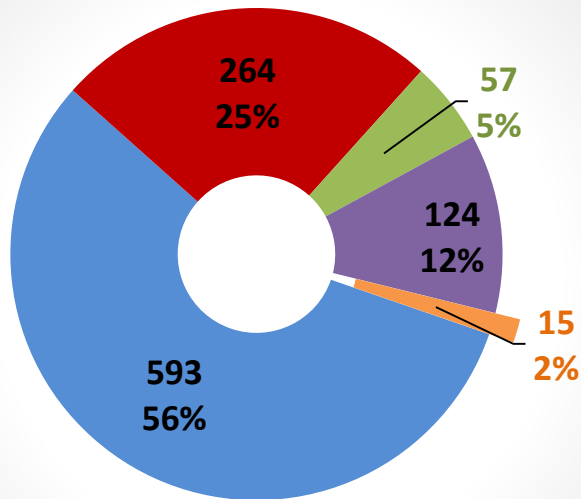
These line graphs display the number of IPR, CBM, and PGR petitions filed each month and the total number of all petitions filed each month from the effective date of the AIA trial provisions.

\*Data current as of: 5/31/2016



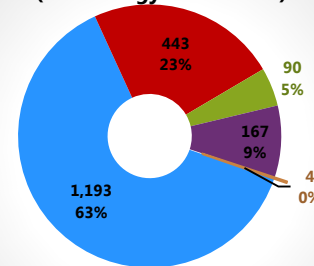
# AIA Petitions by Technology

1053 Total AIA Petitions in FY 16\*  
(Technology Breakdown)

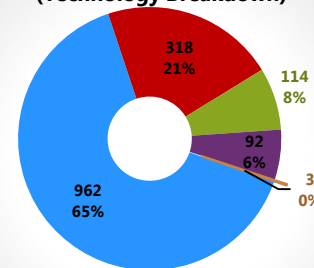


- Electrical/Computer - TCs 2100, 2400, 2600, 2800
- Mechanical/Business Method - TCs 3600, 3700
- Chemical - TC 1700
- Bio/Pharma - TC 1600
- Design - TC 2900

1897 Total AIA Petitions in FY 15\*  
(Technology Breakdown)



1489 Total AIA Petitions in FY 14\*  
(Technology Breakdown)



## 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.

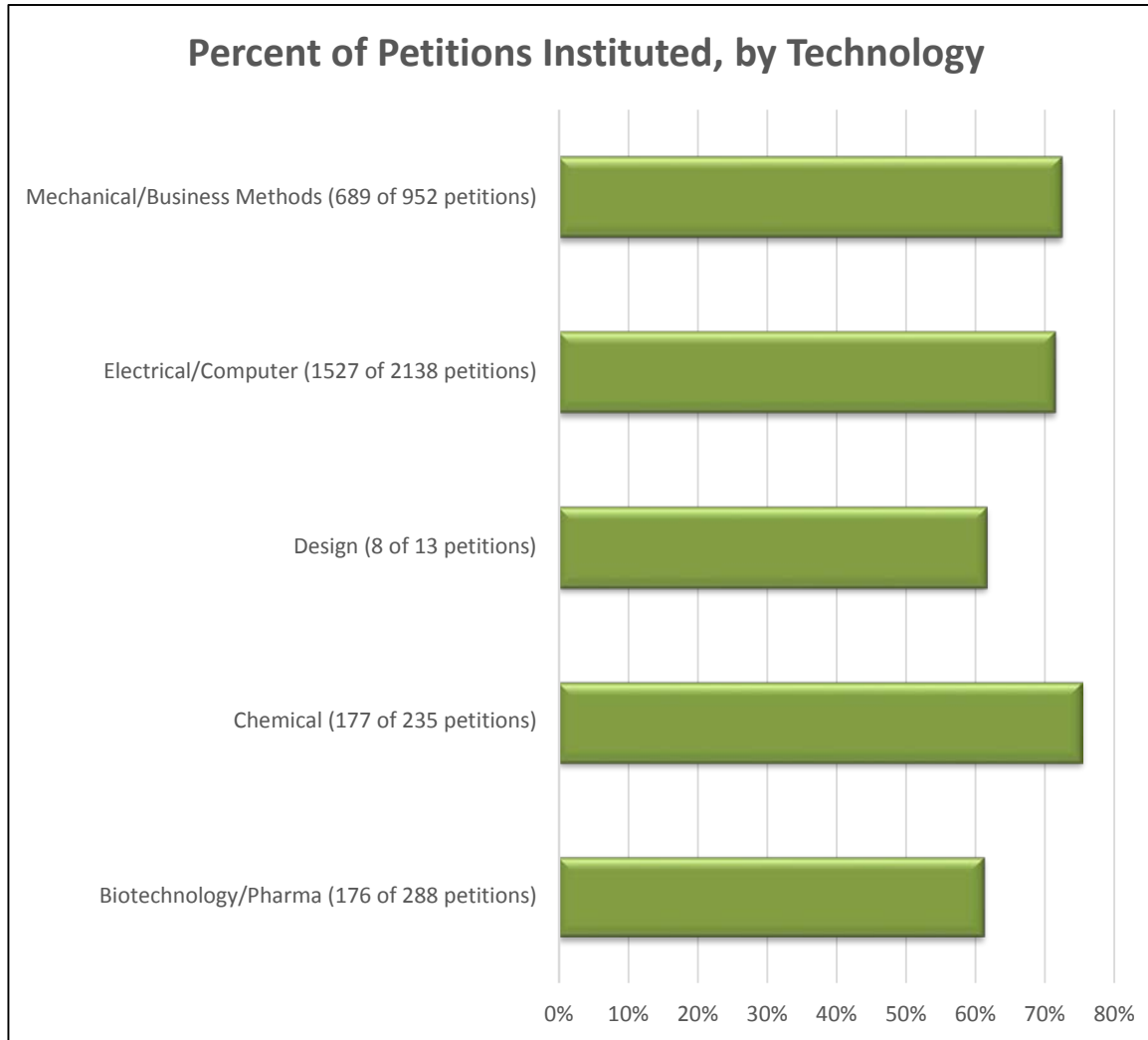


\*Data current as of: 5/31/2016

## Comparison by Technology Center of FY 2015 AIA Filings v. Patent Grants

TC	AIA Filings	AIA Filings(%)	Patent Grants	Patent Grants (%)
1600	164	8.6	24,561	7.6
1700	88	4.6	31,286	9.7
2100	209	11.0	24,177	7.5
2400	159	8.4	30,461	9.5
2600	402	21.1	39,777	12.4
2800	311	16.4	70,802	22.0
2900	4	0.2	25,438	7.9
3600	259	13.6	34,972	10.9
3700	175	9.2	40,512	12.6
Other	131	6.9	36	0.0
Total	1,902		322,022	

# Petitions Instituted by Technology



## **Narrative:**

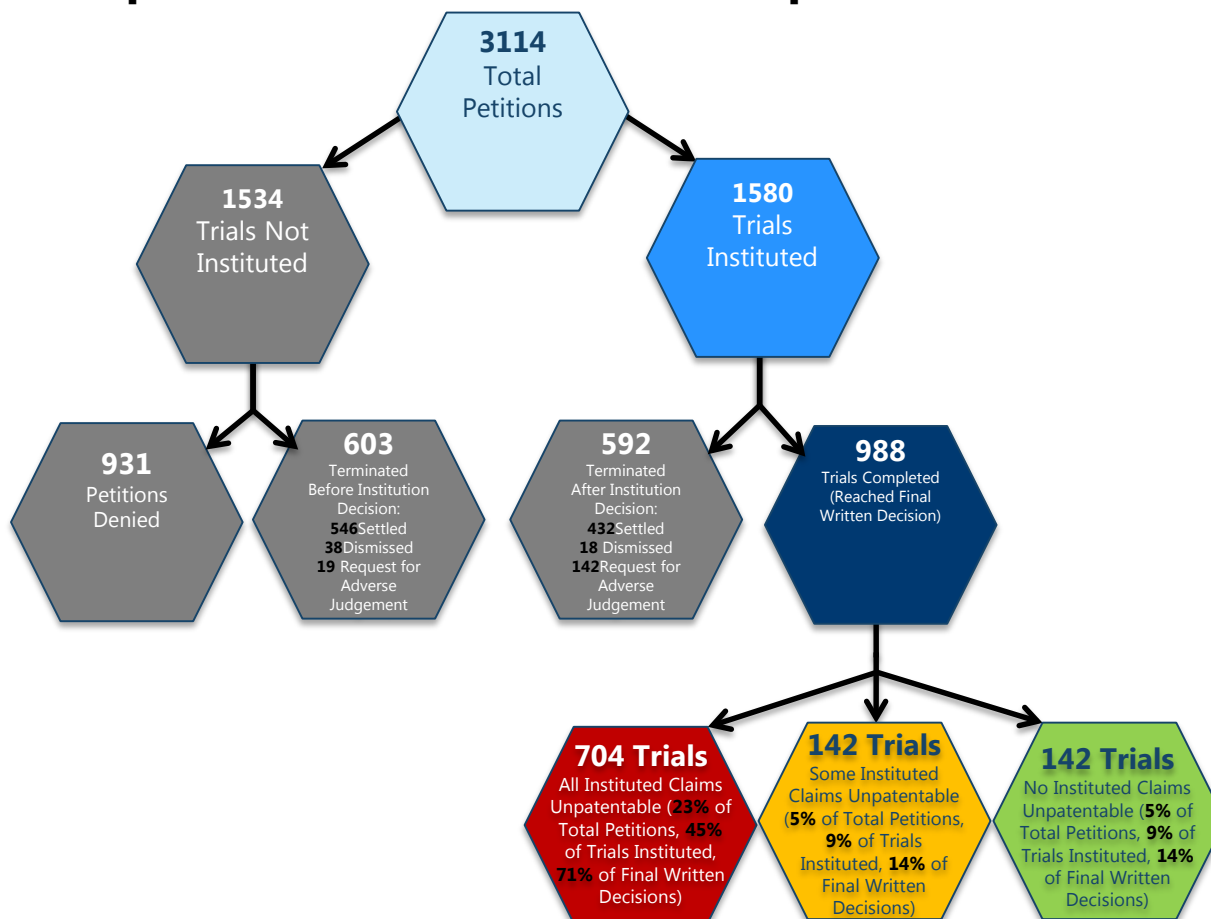
This chart shows the percentage of petitions instituted of all decisions on petition, by technology area.

**\*Data current as of: 5/31/2016**



# Disposition of IPR Petitions

## Disposition of IPR Petitions Completed to Date\*



### Narrative:

This graph shows a stepping stone visual depicting the outcomes for all IPR petitions filed to-date that have reached a final disposition.

\*Data current as of: 5/31/2016



# Disposition of IPR Petitions

- 3114 Petitions Completed
- 1580 Trials Instituted (51%)
- 988 Trials Completed (FWDs)
- 704 Trials with All Instituted Claims Unpatentable
  - 23% of total petitions completed
- 142 Trials with Some Claims Unpatentable
- 142 Trials with No Instituted Claims Unpatentable

# What Patents and When

- **IPR:** depends on effective filing date
  - Is effective f/d before or after March 16, 2013?
  - Pre-AIA patents – anytime after issuance (technical amendment)
  - Post-AIA patents – 9 months after patent issues or PGR is terminated (whichever is later)
- **CBM:** anytime after suit or charge of infringement
- **PGR:** within 9 months of patent issuance
  - Post-AIA patents only

# Standard for Initiating Review

- **IPR:** “a reasonable likelihood that the petitioner would prevail” with respect to at least one challenged claim
- **CBM/PGR:** “more likely than not that at least one claim is unpatentable” or the petition raises “a novel or unsettled legal question that is important to other patents or applications”

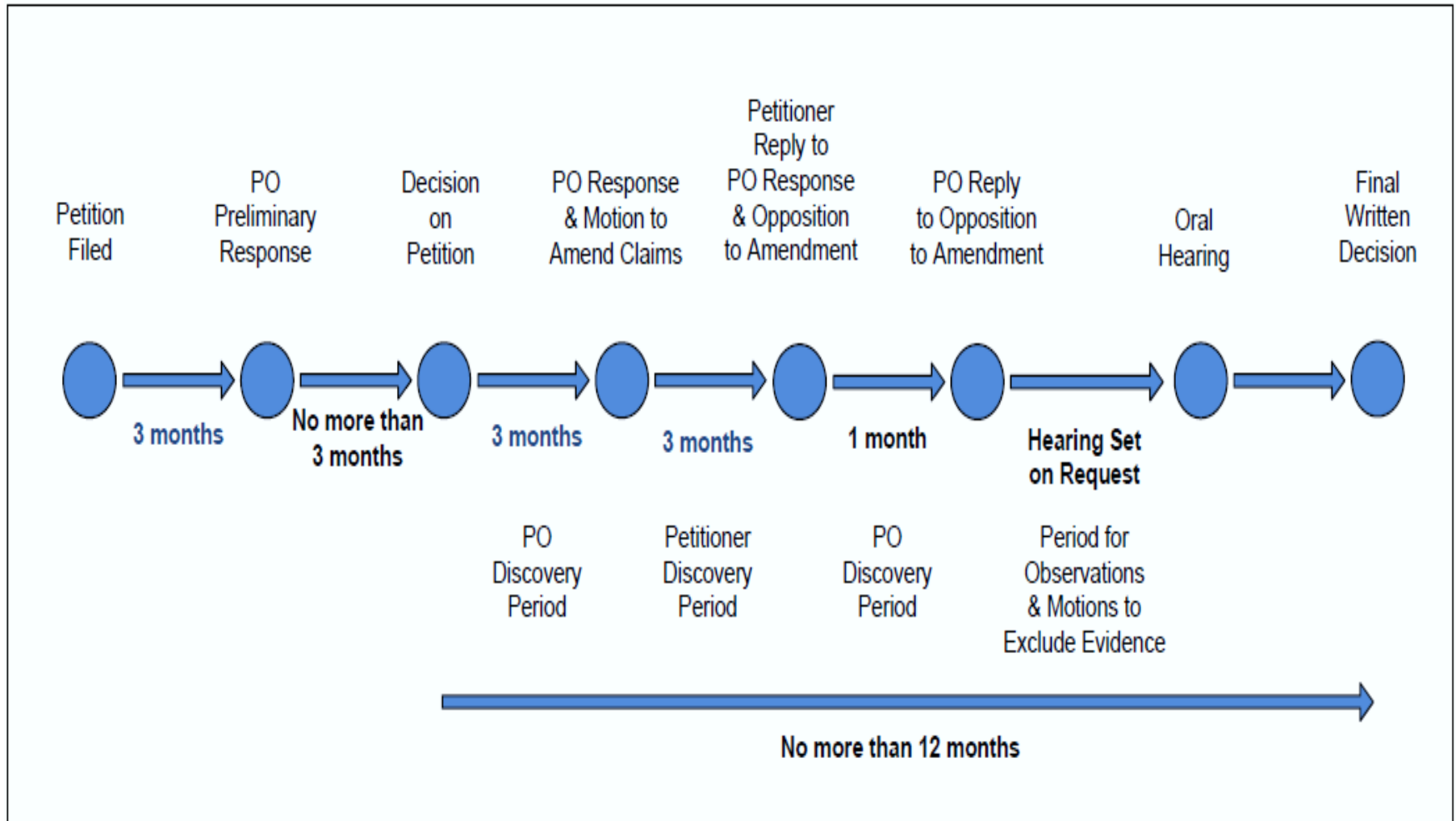
# Structure of Proceeding

- Same basic structure for all the proceedings
- Reduction of burdens on the parties via:
  - Streamlining and converging issues for decision;
  - Use of page limits and electronic filing;
  - Use of conference calls; and
  - Institution of a trial on a claim-by-claim, ground-by-ground basis
  - *Limited discovery*

# Standard for Claim Construction

- The Board interprets claims of an **unexpired** patent using the **broadest reasonable construction** in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *see also* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012).

# AIA Proceeding Timeline



# New Rules – Rulemaking Process

- April-May 2014 – Nationwide Listening Tour
- June 2014 – RFC
- May 2015 – “Quick Fix” Rules
- August 2015 – Proposed New Rules
- April 1, 2016 – Final New Rules
- April 27, 2016 – Correction to Final New Rules



# New Rules - Summary

- Claim Construction for Expiring Patents
- Patent Owner Preliminary Response
- Oral Hearings
- Word Count
- Rule 11-Type Certification

# New Rules – Claim Construction

- A party may request district court-type (Phillips) construction
- Must certify patent will expire within 18 mos. from entry of Notice of Filing Date
- Motion and certification must be filed within 30 days from filing of Petition

# New Rules – Preliminary Response

- Eliminates prohibition of new testimonial evidence
- Petitioner may seek leave to file a reply
  - Requires showing of “good cause”

# New Rules – Preliminary Response

“The Board’s decision will take into account a patent owner preliminary response where such a response is filed, *including any testimonial evidence*, but a genuine issue of material fact created by such testimonial evidence *will be viewed in the light most favorable to the petitioner* solely for purposes of deciding whether to institute an inter partes [post-grant] review.”

# New Rules – Oral Hearing

Demonstrative exhibits must be served at least seven business days before the oral argument and filed no later than the time of the oral argument.

# New Rules – Word Count

- Petitions for IPRs: 14,000 words.
- Petitions for PGR/CBM: 18,700 words.
- Petitions requesting DER: 14,000 words.
- Preliminary Response and Response: same as Petition.
- Reply to Patent Owner Responses: 5,600 words

# New Rules – Word Count

- New Exclusions in Petitions:
  - Grounds for standing
  - Mandatory notices
  - Certificate of word count
- Other Exclusions:
  - Table of contents
  - Table of authorities
  - Certificate of service
  - Appendix of exhibits or claim listings

# New Rules: Rule 11-Type Certification

- Signature Requirements
  - Incorporate 37 C.F.R. 11.18(a)
  - Board may expunge unsigned submissions
- Representations
  - Incorporate 37 C.F.R. 11.18(b)(2)
- Sanctions
  - 21-day cure provision



# **New Rules – Signature Requirement**

“Every petition, response, written motion, and other paper filed in a proceeding must comply with the signature requirements set forth in § 11.18(a) of this chapter.”

# New Rules – Signature Requirement

“For all documents filed in the Office in patent, trademark, and other non-patent matters, and all documents filed with a hearing officer in a disciplinary proceeding, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Office *must bear a signature*, personally signed or inserted by such practitioner . . . .”

37 C.F.R. 11.18(a)

# New Rules - Representations

“By presenting to the Board a petition, response, written motion, or other paper—whether by signing, filing, submitting, or later advocating it—an attorney, registered practitioner, or unrepresented party attests to compliance with the certification requirements under § 11.18(b)(2) of this chapter.”

# New Rules – Representations

“(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances,

(i) The paper is not being presented for any *improper purpose*, such as to harass someone or to cause unnecessary delay or needless increase in the cost of any proceeding before the Office;

(ii) The other *legal contentions therein are warranted* by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(iii) The *allegations and other factual contentions have evidentiary support* or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(iv) The *denials of factual contentions are warranted* on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief. ”

37 C.F.R. 11.18(b)(2)(emphasis added)

# New Rules – Sanctions Motions

- Requires a separate motion
- Motion must describe specific conduct
- Board must authorize filing
- Moving party must serve motion 21 days before seeking authorization
- No motion if opposing party “cures”

# New Rules – Sanctions

- Board *sua sponte* may order attorney or party to show cause
- Sanctions must be consistent with § 42.12
- Sanctions order must describe conduct and explain basis

# Recent PTAB Precedential Decisions

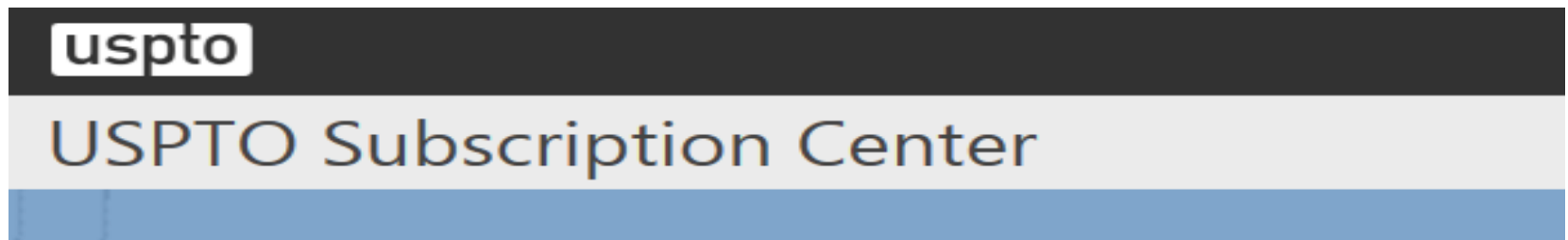
- In May 2016, the Board designated the following five decisions as precedential:
  - ***Garmin Int’l v. Cuozzo Speed Techs LLC***, IPR2012-00001, Paper 26 (Mar. 5, 2013) - This order discusses the factors considered in evaluating motions for additional discovery in IPR proceedings.
  - ***Bloomberg, Inc. v. Markets-Alert Pty, Ltd.***, CBM2013-00005, Paper 32 (May 29, 2013) – This order discusses the factors considered in evaluating motions for additional discovery in CBM proceedings.
  - ***Oracle Corp. v. Click-to-Call Techs, LP***, IPR2013-00312, Paper 26 (October 30, 2013) (precedential only as to Section III.A.) - This decision pertains to interpretation of “served with a complaint” for purposes of triggering the one-year time bar set forth in 35 U.S.C. § 315(b).
  - ***MasterImage 3D, Inc. v. RealD Inc.***, IPR2015-00040, Paper 42 (July 15, 2015) – This order provides guidance on patent owner’s burden to show entitlement to substitute claims.
  - ***Lumentum Holdings, Inc. v. Capella Photonics, Inc.***, IPR2015-00739 (Paper 38) (March 4, 2016) – This decision interprets 35 U.S.C. § 312(a)(2).
- Copies of these precedential decisions can be found on the [USPTO's website](#).



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