

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



JPO Judicial Symposium

Scott R. Boalick, Chief Administrative Patent Judge

October 28, 2022



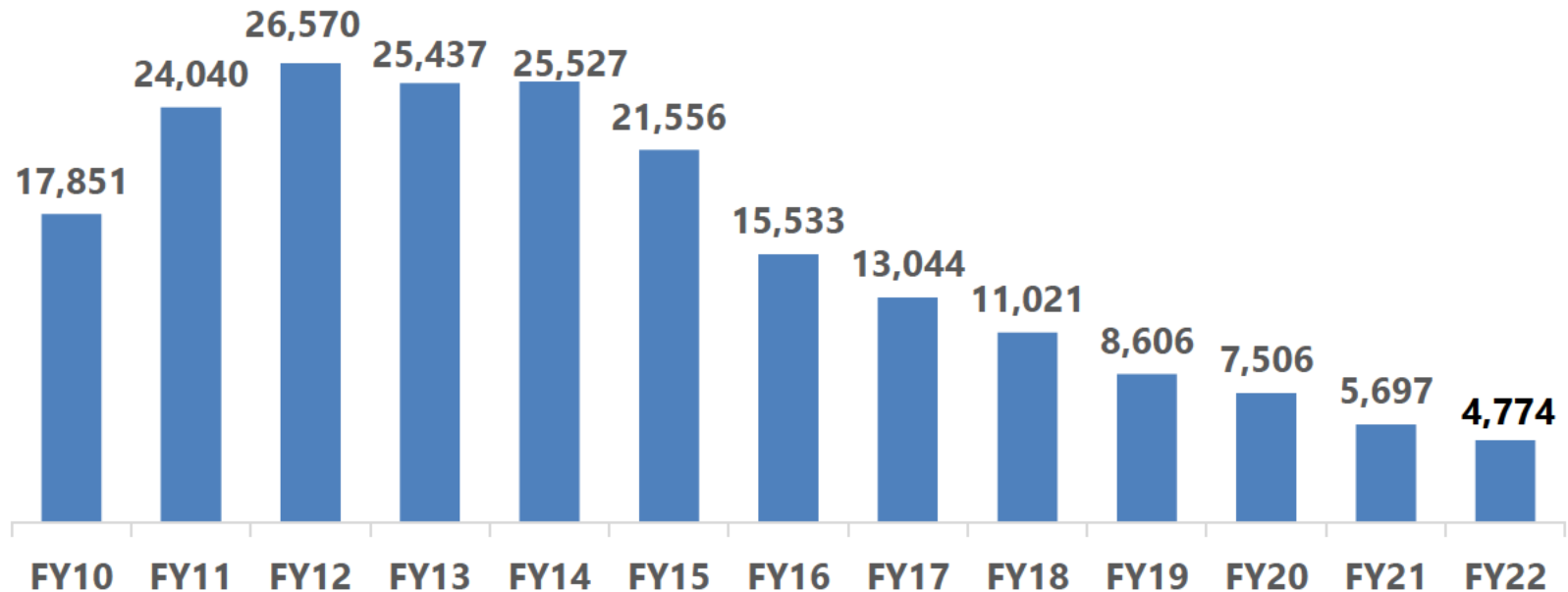
UNITED STATES
PATENT AND TRADEMARK OFFICE ®

August 31, 2022

Appeal statistics

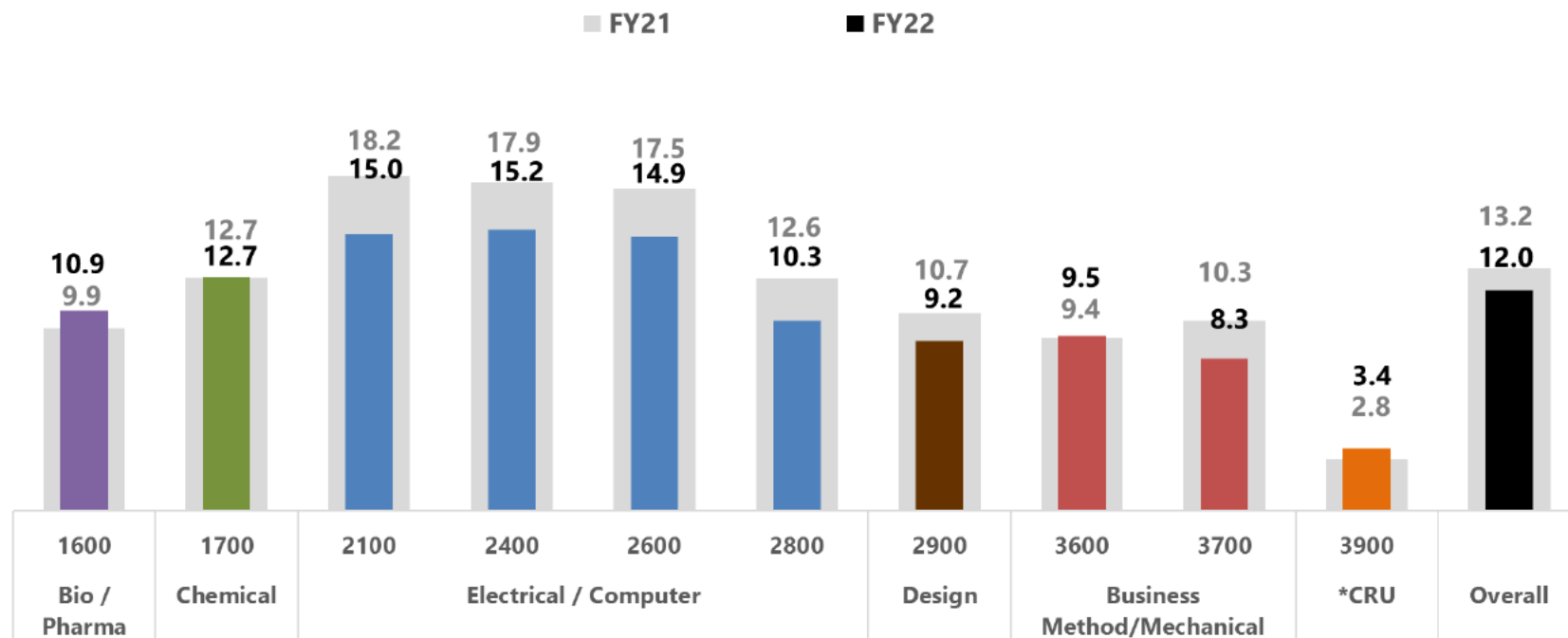
Pending appeals FY10 to FY22

(Sept. 30, 2010 – Aug. 31, 2022)



Pendency of decided appeals

(Jun. 2021 – Aug. 2021 compared to Jun. 2022 – Aug. 2022)



Pendency is calculated as average months from Board receipt date to final decision.

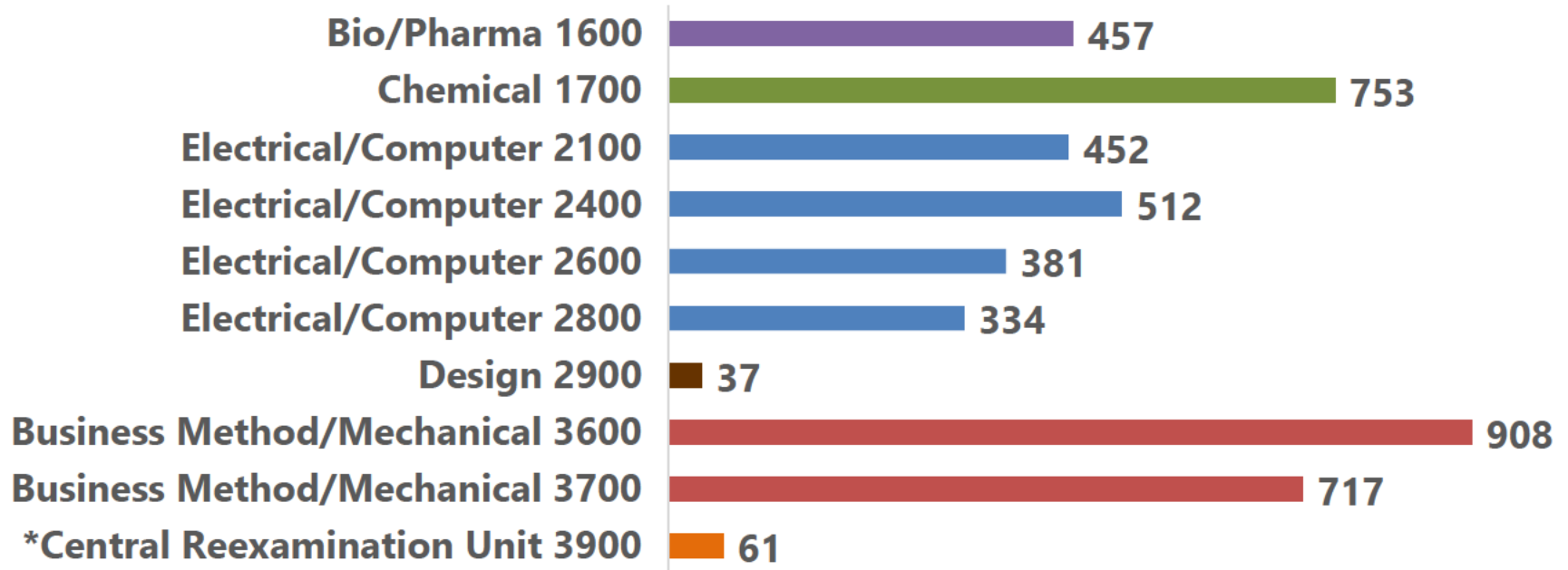
Pendency is calculated for a three month period compared to the same period the previous year.

*CRU (Central Reexamination Unit) decisions include 5 *ex parte* reexams, 2 *inter partes* reexam, 0 supplemental examination review, and 7 reissues from all technologies for Jun. 2022 – Aug. 2022.



Appeal intake in FY22

(Oct. 1, 2021 – Aug. 31, 2022)

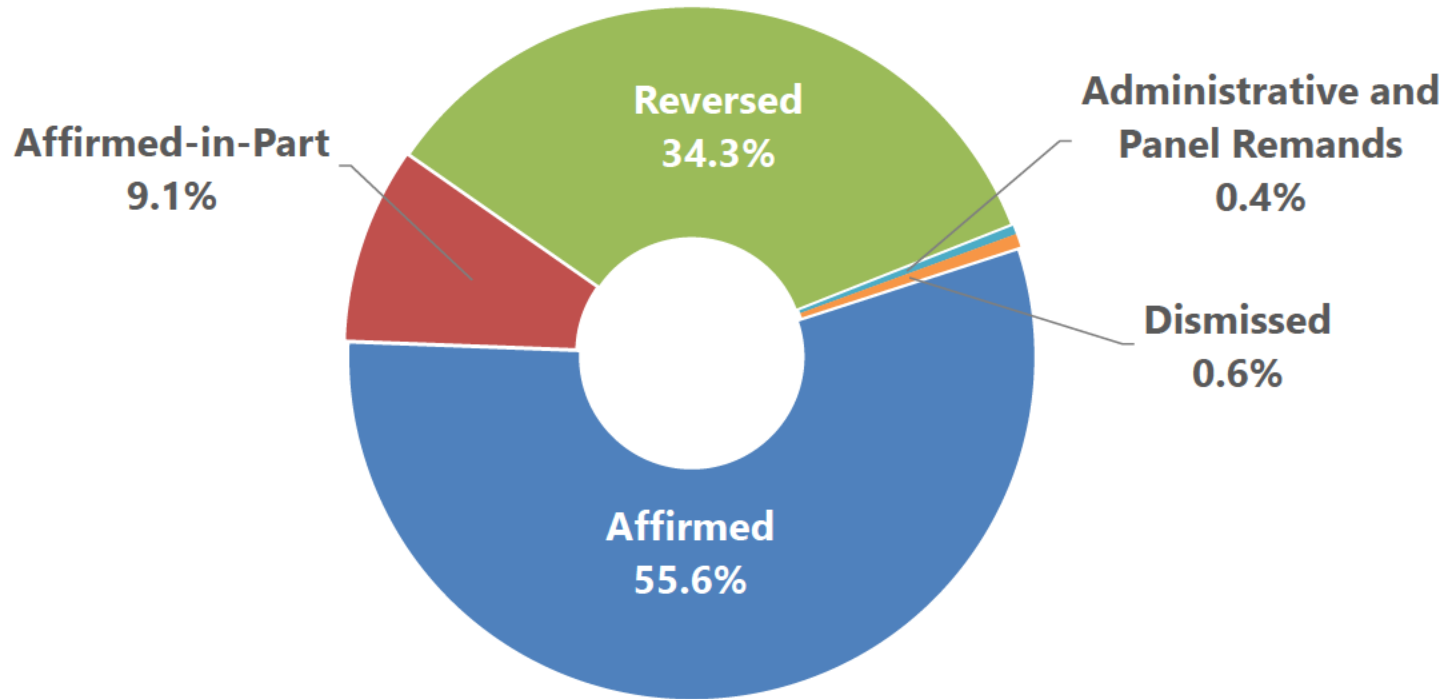


*The Central Reexamination Unit includes ex parte reexams, inter partes reexams, supplemental examination reviews and reissues from all technologies.



Appeal outcomes in FY22

(Oct. 1, 2021 - Aug. 31, 2022)



AIA trial proceedings

Types of AIA proceedings

Post-Grant Review (PGR):

- Limited 9 month window of time to challenge
- Broader range of challenges available compared to IPR

Inter Partes Review (IPR):

- Can challenge patents throughout their lifespan (after 9 months)
- Limited grounds of challenge compared to PGR

Derivation:

- Window of time to challenge = 1-year from claim publication
- Petition alleges another derived invention from the correct inventor

Scope of grounds in petition

- **IPR:** only on § 102 and § 103 grounds, and only on basis of prior art consisting of patents and printed publications
- **PGR:** on any grounds for invalidity (except best mode)

Standard for initiating review

- **IPR:** “a reasonable likelihood that the petitioner would prevail” with respect to at least one challenged claim
- **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”

AIA trial proceedings

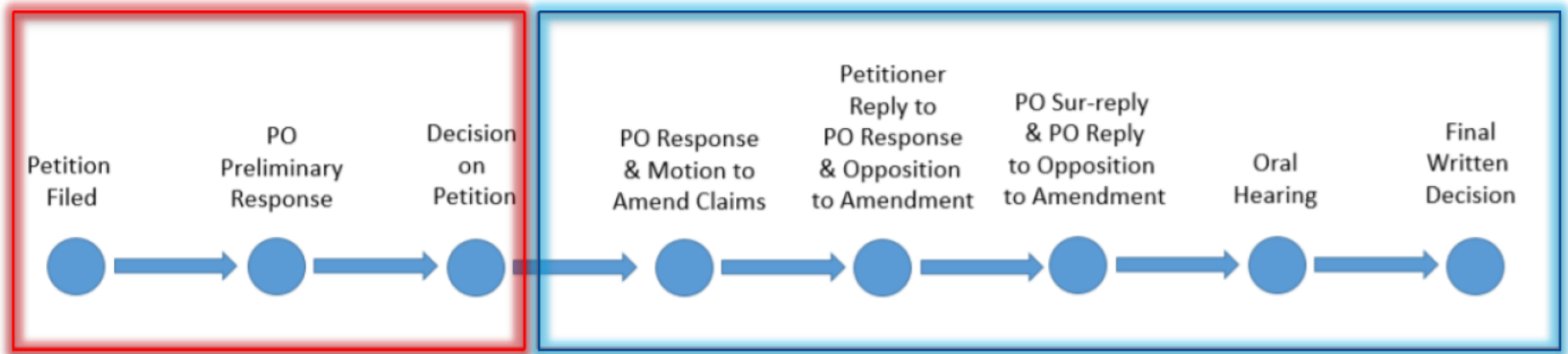
Standard of proof: a “preponderance of evidence”

- Lower than “clear and convincing evidence” required to prevail in district courts

Final written decision

- Issued within 12 months of institution
- Can extend by 6 months, but only for “good cause”
- Generally, entire process (petition → termination or final decision) will take 18 months or less

AIA proceeding timeline



Institution phase

Trial phase

What sources of law apply?

- U.S. Supreme Court and U.S. Court of Appeals for the Federal Circuit
- 35 U.S.C. §§ 311-329 (statutes governing IPRs and PGRs)
- 37 C.F.R. §§ 42.1-42.412 (rules/regulations for trials in general, and IPRs, PGRs, and Derivation Proceedings)
- Precedential PTAB decisions
 - www.uspto.gov/patents/ptab/precedential-informative-decisions
- Consolidated Trial Practice Guide, Nov. 2019
- Director guidance and memoranda



AIA proceeding outcomes

- The outcome may be that all challenged claims are upheld, some challenged claims are upheld, or none of the challenged claims are upheld.
 - **All claims patentable**: Each and every challenged claim upheld
 - **Mixed**: At least one challenged claim, but not all, upheld
 - **All claims unpatentable**: No challenged claim upheld

Options for patent owner after an unfavorable final written decision

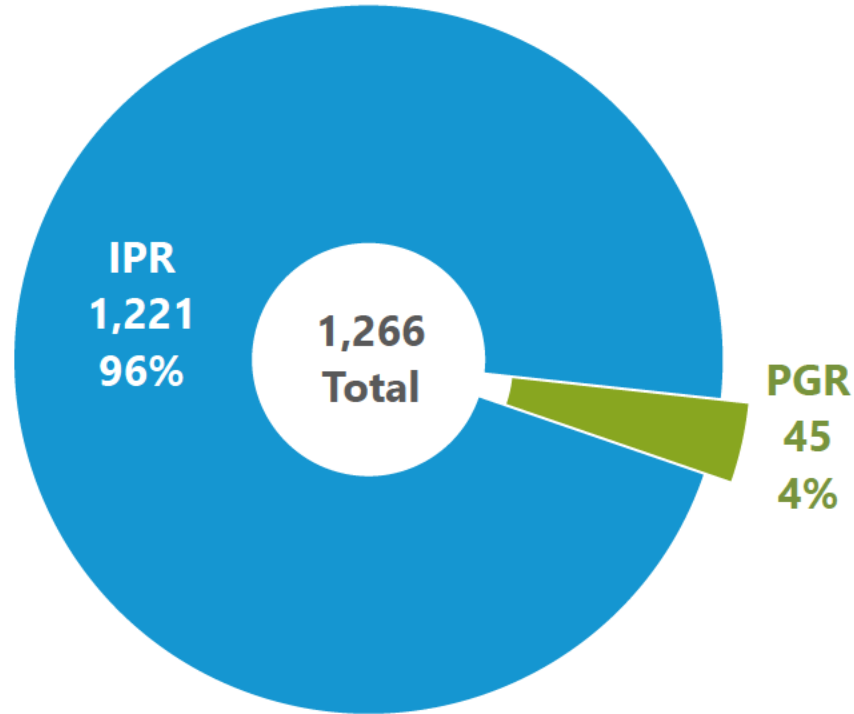
- Seek panel rehearing
- Seek rehearing by precedential opinion panel (POP)
- Seek Director review
- Appeal to the Federal Circuit

August 2022

AIA Proceeding Statistics

Petitions filed by trial type

(FY22 through August: Oct. 1, 2021 to Aug. 31, 2022)

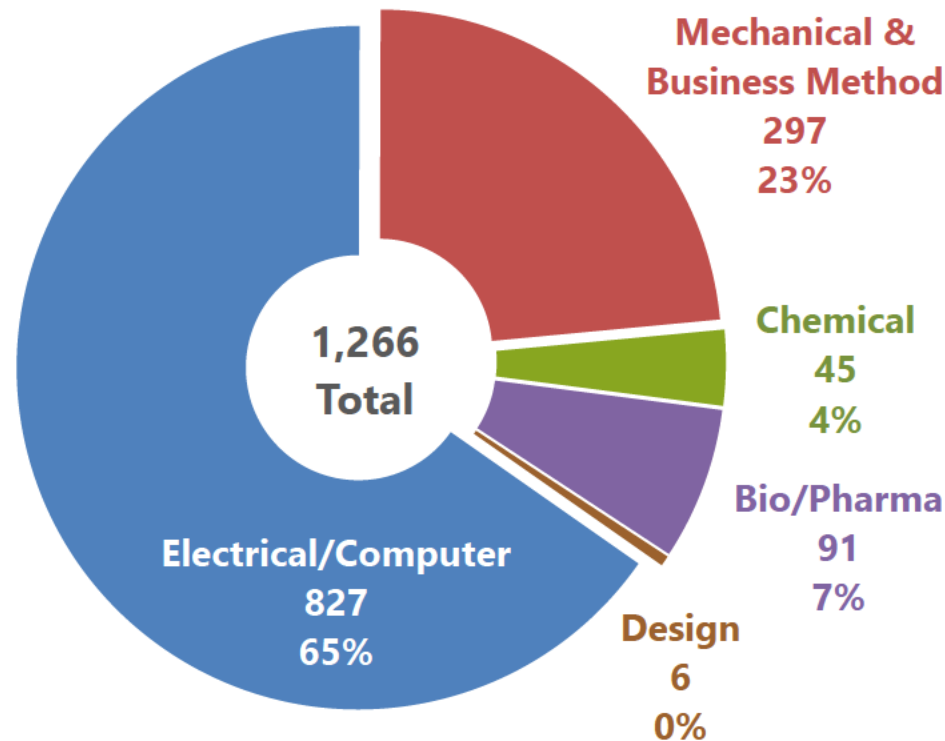


Trial types include Inter Partes Review (IPR) and Post Grant Review (PGR).



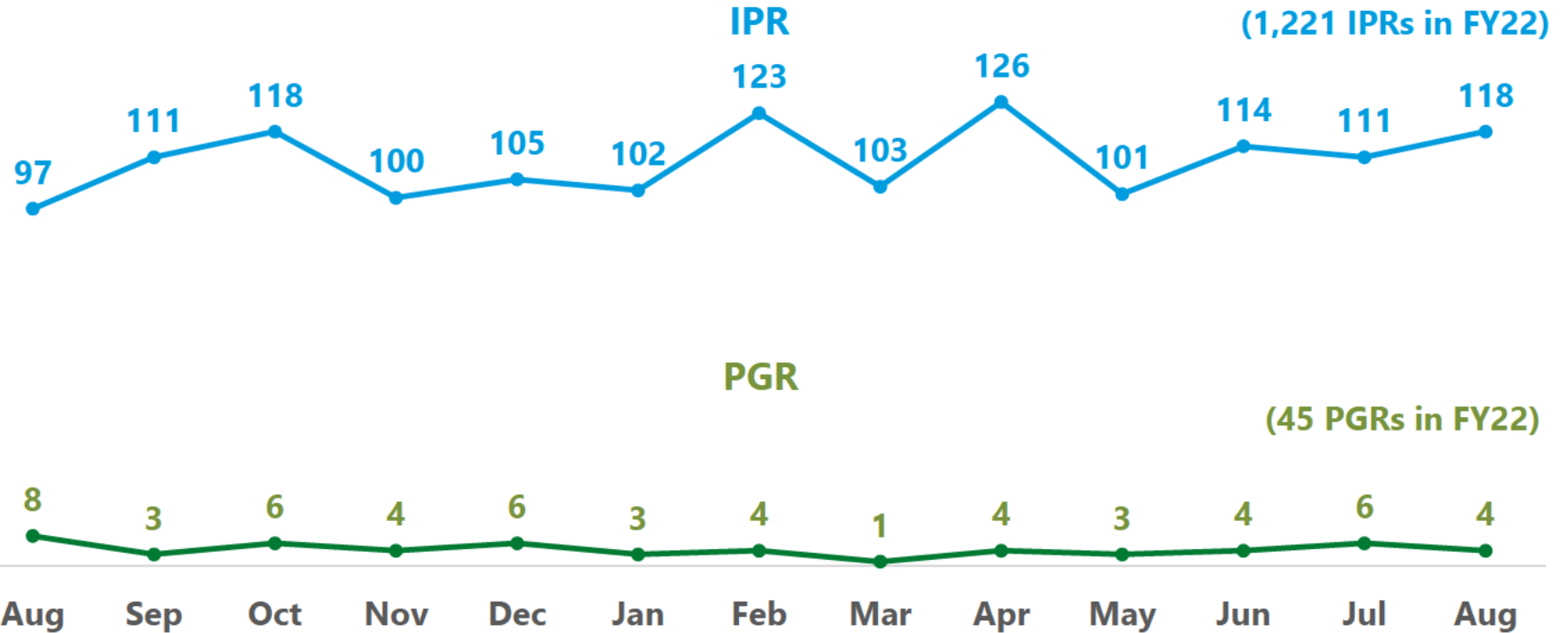
Petitions filed by technology

(FY22 through August: Oct. 1, 2021 to Aug. 31, 2022)



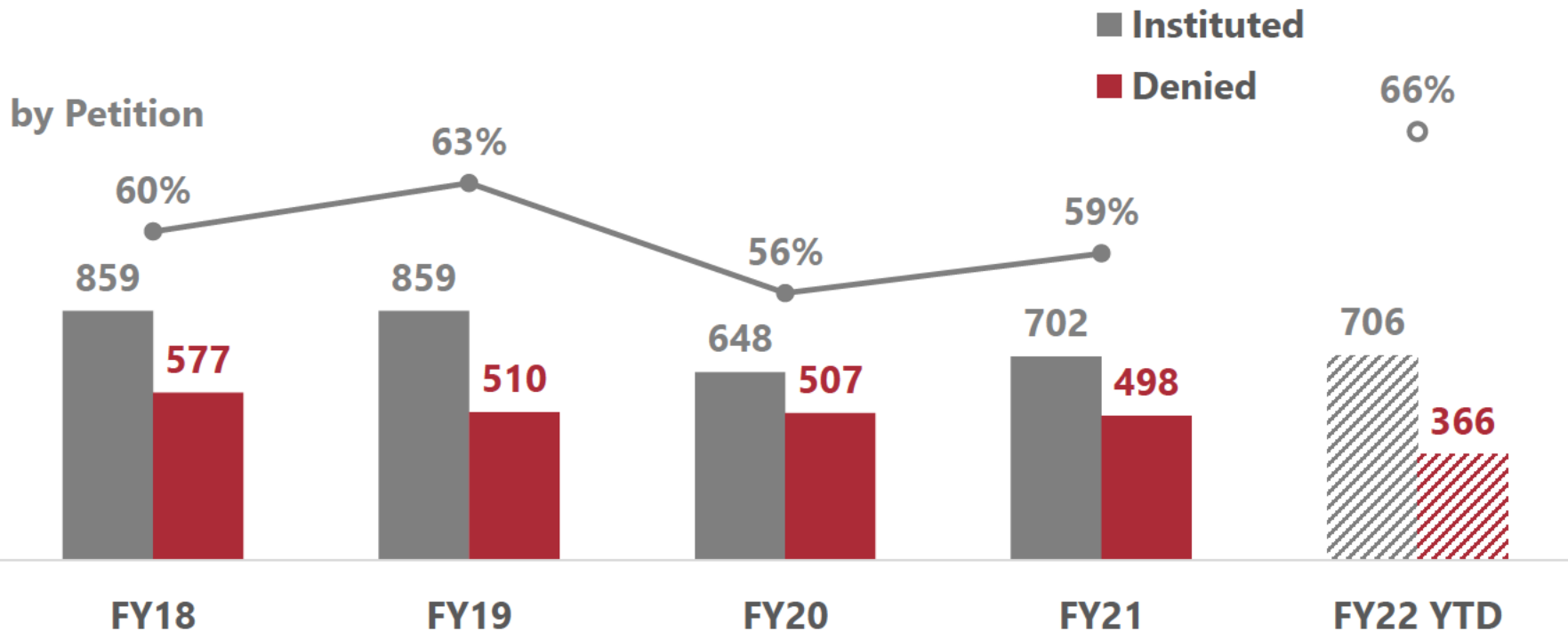
Petitions filed by month

(Aug. 2022 and Previous 12 Months: Aug. 1, 2021 to Aug. 31, 2022)



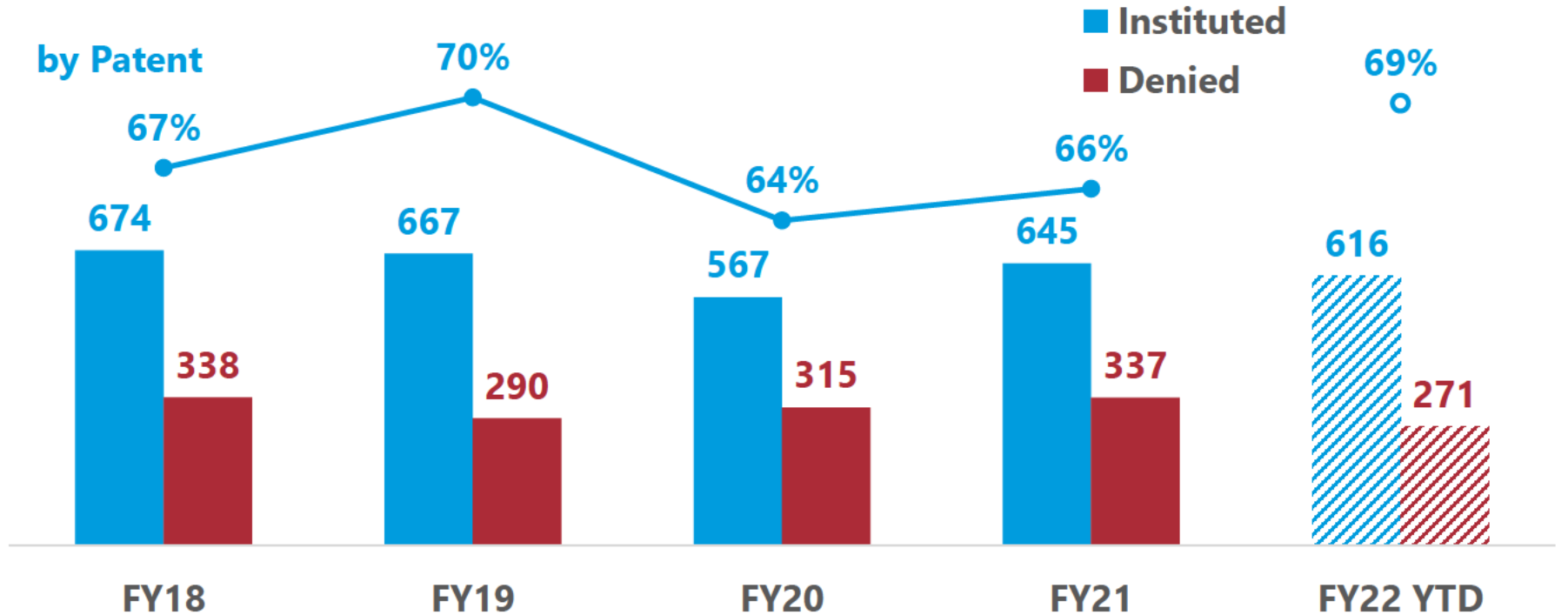
Institution rates by petition

(FY18 to FY22 through August: Oct. 1, 2017 to Aug. 31, 2022)



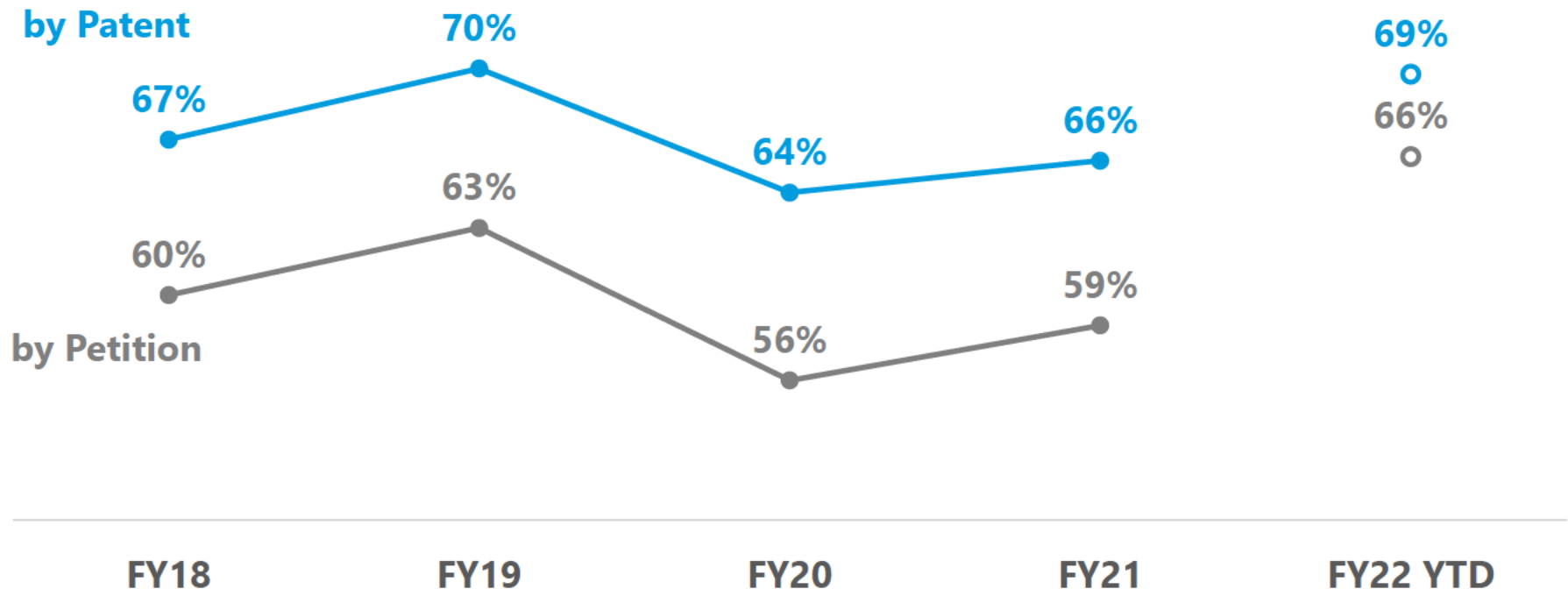
Institution rates by patent

(FY18 to FY22 through August: Oct. 1, 2017 to Aug. 31, 2022)



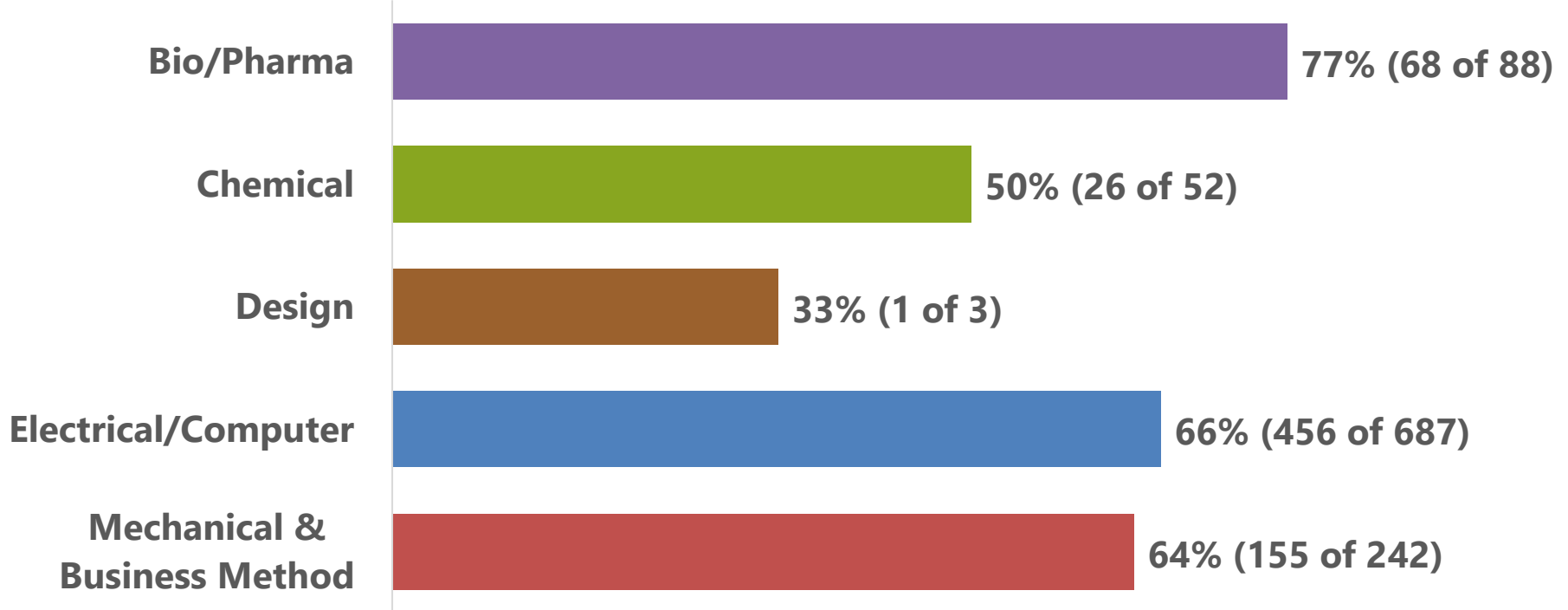
Institution rates by patent and by petition

(FY18 to FY22 through August: Oct. 1, 2017 to Aug. 31, 2022)



Institution rates by technology

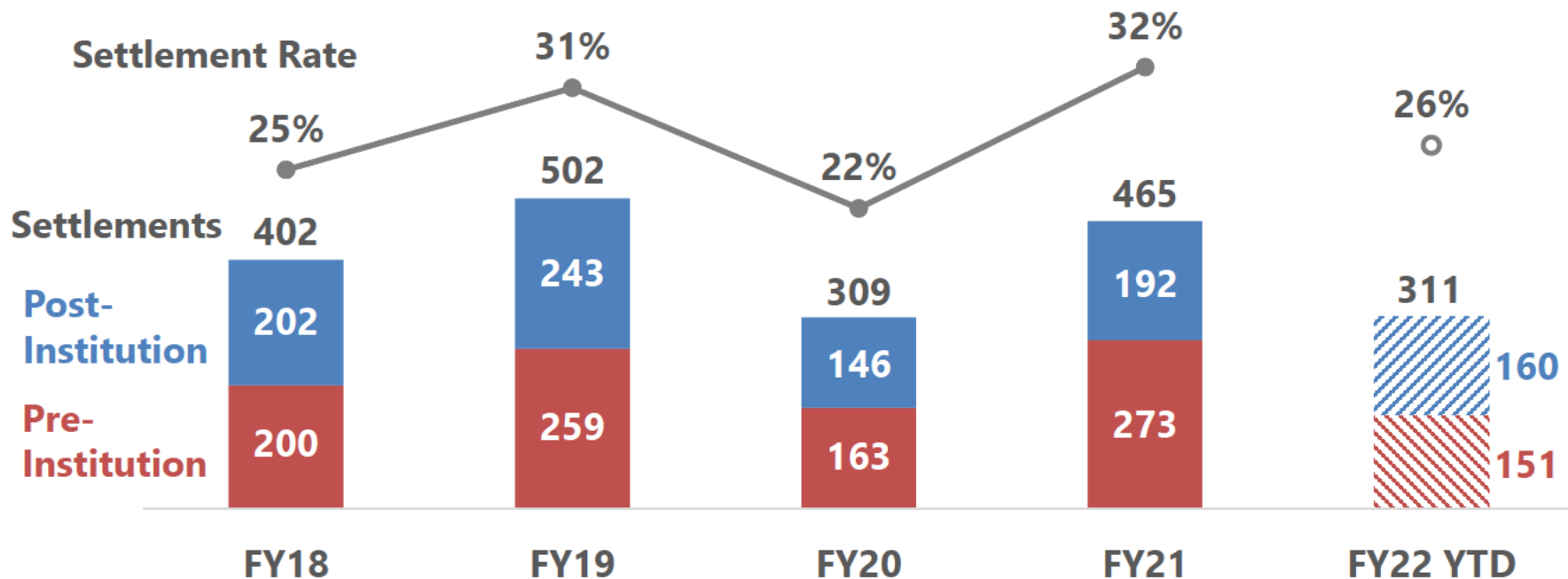
(FY22 through August: Oct. 1, 2021 to Aug. 31, 2022)



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.

Settlements

(FY18 to FY22 through August: Oct. 1, 2017 to Aug. 31, 2022)

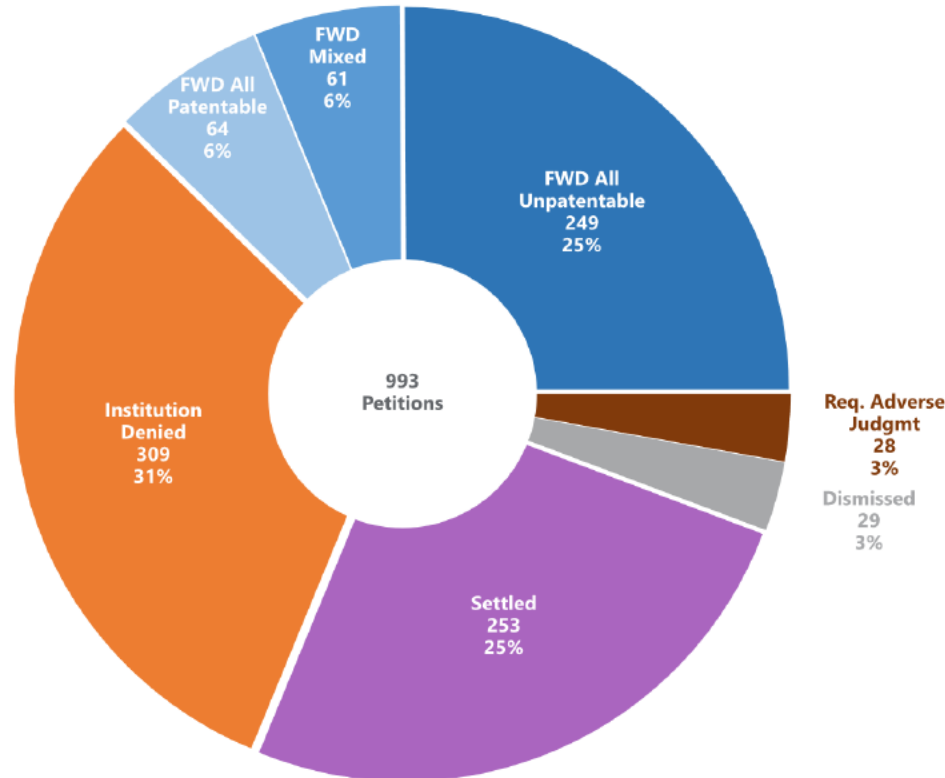


Settlement rate is calculated by dividing total settlements by concluded proceedings in each fiscal year (i.e., denied institution, settled, dismissed, requested adverse judgment, and final written decision), excluding joined cases.



Outcomes by petition

(FY22 through Q3: Oct. 1, 2021 to Jun. 30, 2022)

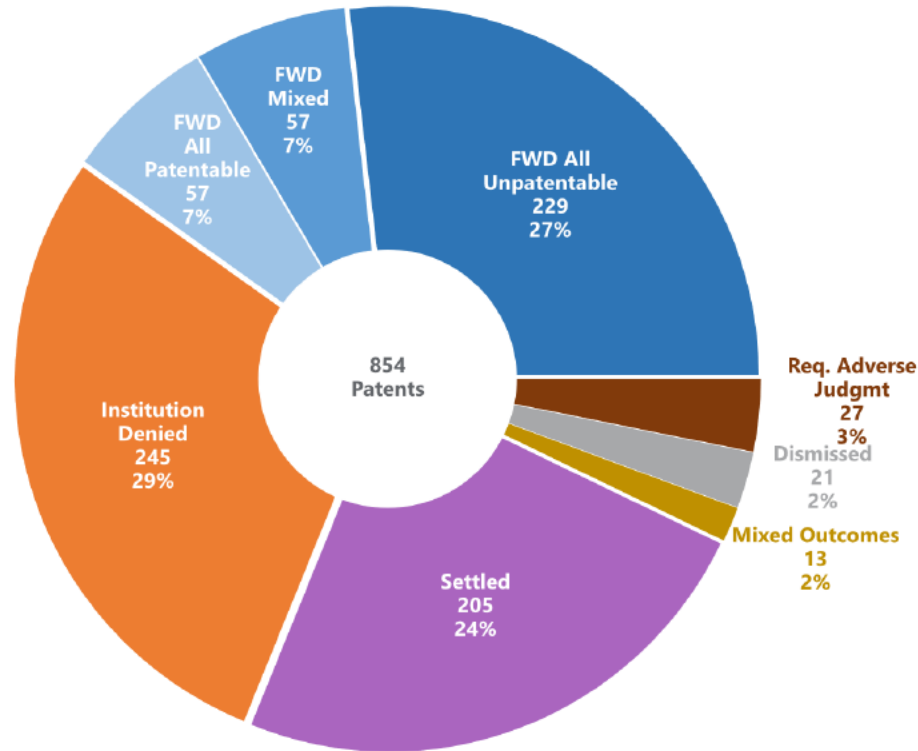


FWD patentability or unpatentability reported with respect to the claims at issue in the FWD. Joined cases are excluded.



Outcomes by patent

(FY22 through Q3: Oct. 1, 2021 to Jun. 30, 2022)



FWD patentability or unpatentability reported with respect to the claims at issue in the FWD. "Mixed Outcome" is shown for patents receiving more than one type of outcome from the list of: denied, settled, dismissed, and/or req. adverse judgement only. A patent is listed in a FWD category if it ever received a FWD, regardless of other outcomes.

Outcomes by claim challenged

(FY22 through Q3: Oct. 1, 2021 to Jun. 30, 2022)

