

Fireside Chat with Chief Administrative Judge Boalick

Fall Patents Series: Day 1, Session 2; Nov. 9, 2:00 p.m.



**AMSTER
ROTHSTEIN
& EBENSTEIN LLP**
Intellectual Property Law



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Hon. Scott Boalick
Chief Administrative Patent Judge
Patent Trial and Appeal Board, USPTO

**LAW OFFICES
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Kenneth Adamo
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Additionally, the following content is presented solely for the purposes of discussion and illustration, and does not comprise, nor is to be considered, as legal advice.

Recent Events Affecting the PTAB

Apr. 2020: *Thryv v. Click to Call* issues on non-reviewability of institution related decision

July 2020: *Hunting Titan* on Motions to Amend and new Procedures Adopted

Dec. 2020: Final rule on Burden of Persuasion for Motions to Amend

Sept. 2020: *Facebook v. Windy City* on Joinder of parties but not new grounds

Oct. 2020: PTAB Adopts new Precedential Decisions on Real Party in Interest

Oct. 2020: Request for Comments on Discretionary Denials

Dec. 2020: PTAB Adopts new Precedential Decisions on Discretionary Denials

Jan. 2021: New Administration took office, and new Interim Director, and no new Director yet

June 2021: *Arthrex* Decision by the U.S. Supreme Court

July – Sept. 2021: USPTO seeks comments on Patent Eligibility

Sept. 2021: USPTO grants POP Request in *Toshiba America Electronic Components, Inc. v. Monument Peak Ventures, LLC*

Oct. 2021: *Mobility Works, LLC v. Unified Patents, LLC* decision by the Federal Circuit

Reviewability of PTAB Decisions In General

Request of Reconsideration

POP Panel Review

Director Review

Collateral Attacks at District Court (Section 145)

Appeal to Federal Circuit

Supreme Court Scrutiny

Arthrex:
Constitutional
Challenges to
PTAB APJs

Remands

Director Review

New Challenges

Impact on Chief Administrative
Judge's Office of Director's Review

Thryvv: Reviewability of Institution Decisions

Impact of *Thryvv*

Challenges to Institution Decisions

Discretionary Denials

Collateral Attacks on Institution Decisions

Any New Rule Making expected

*Director
Issued Memos
and Policies*

Indefiniteness

Patent-Eligibility

Admitted Prior Art

Motions to Amend

*Aqua
Products*
changed
the Rules

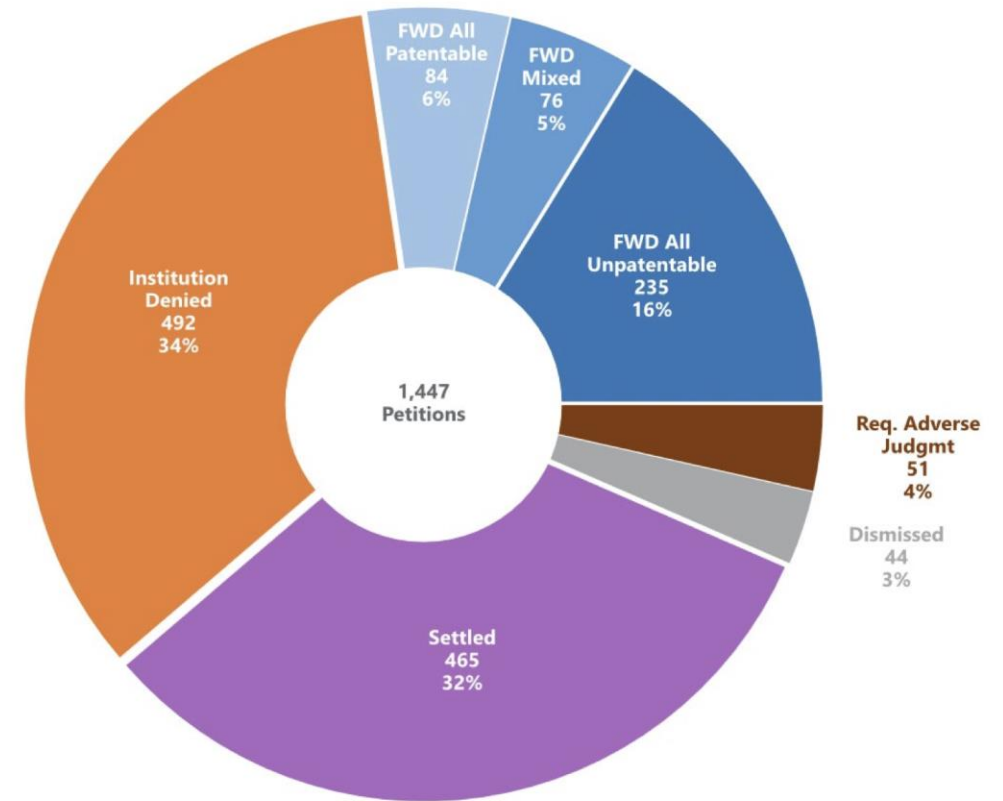
PTAB adopted
New
Procedures

Still Not much
success for
Patent Owners

What is Next?

PTAB Outcomes

Outcomes by petition (FY21: Oct. 1, 2020 to Sept. 30, 2021)

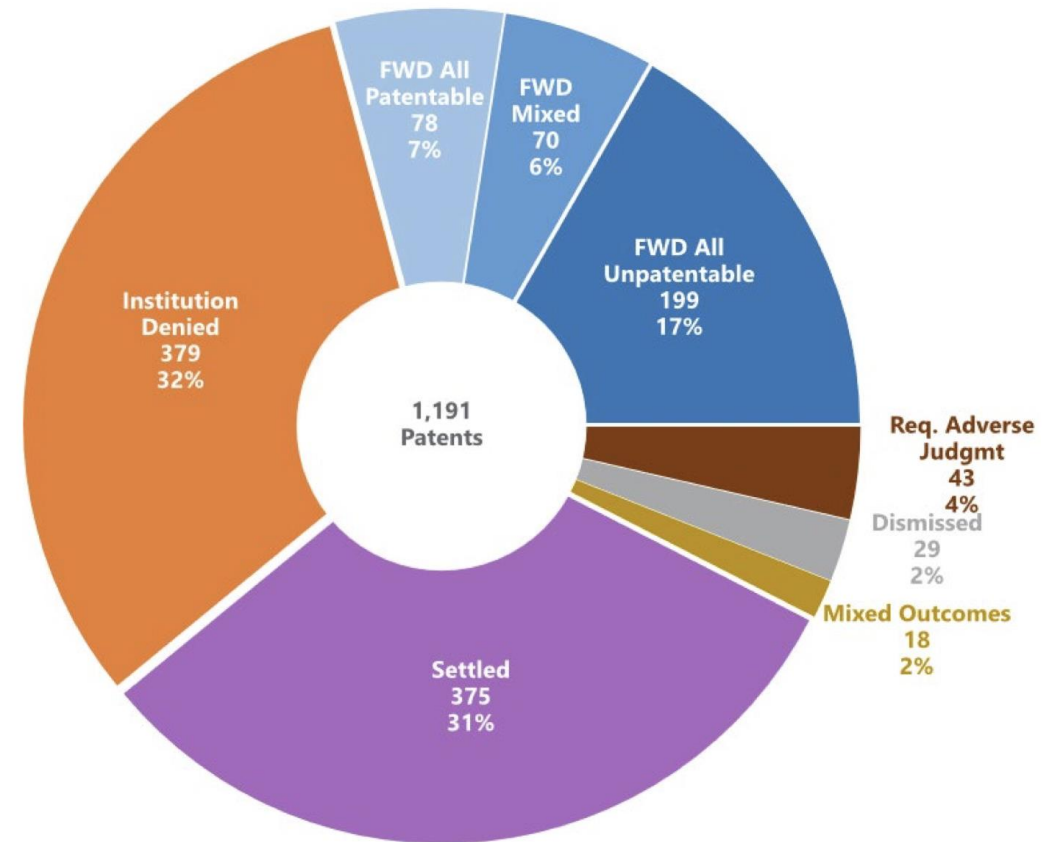


FWD patentability or unpatentability reported with respect to the claims at issue in the FWD. Joined cases are excluded.

SOURCE: https://www.uspto.gov/sites/default/files/documents/ptab_aia_fy2021__roundup.pdf

PTAB Outcomes

Outcomes by patent (FY21: Oct. 1, 2020 to Sept. 30, 2021)

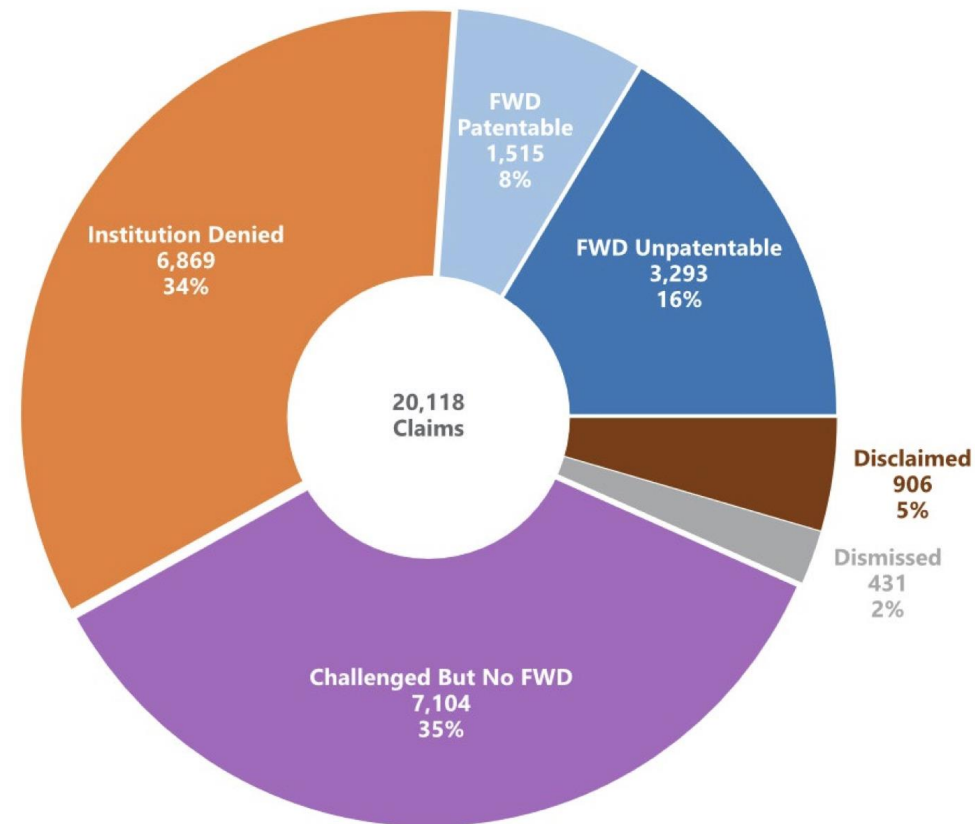


FWD patentability or unpatentability reported with respect to the claims at issue in the FWD. "Mixed Outcome" is shown for patents receiving more than one type of outcome from the list of: denied, settled, dismissed, and/or req. adverse judgement only. A patent is listed in a FWD category if it ever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

SOURCE: https://www.uspto.gov/sites/default/files/documents/ptab_aia_fy2021__roundup.pdf

PTAB Outcomes

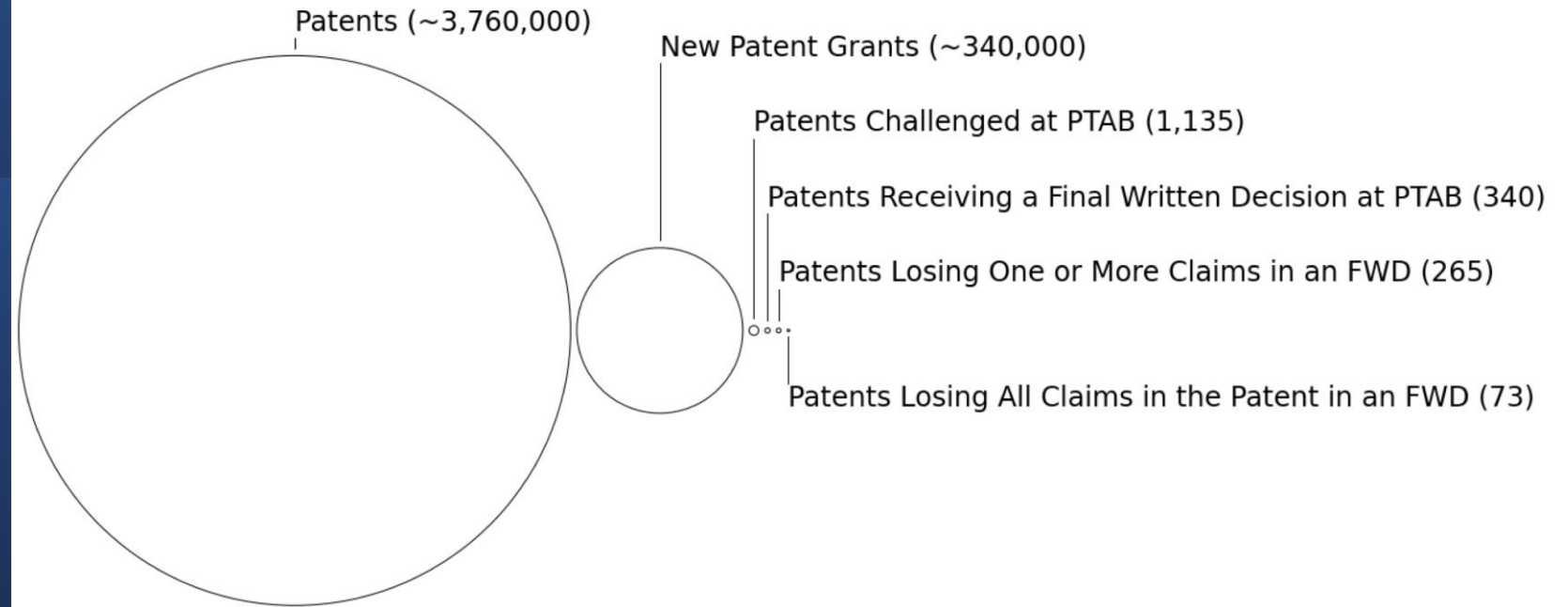
Outcomes by claim challenged (FY21: Oct. 1, 2020 to Sept. 30, 2021)



SOURCE: https://www.uspto.gov/sites/default/files/documents/ptab_aia_fy2021__roundup.pdf

PTAB Outcomes

All patents (FY21: Oct. 1, 2020 to Sept. 30, 2021)



The area inside each circle is scaled to the number of patents in the category.



What can we
expect next from
the PTAB?

