

UNITED STATES
PATENT AND TRADEMARK OFFICE





NYIPLA One-Day Patent CLE Seminar

**State of the Patent Trial and Appeal Board and
Preparing for Changes to Practices, Policies and
Procedures**

Cynthia M. Hardman, Administrative Patent Judge

November 7, 2024

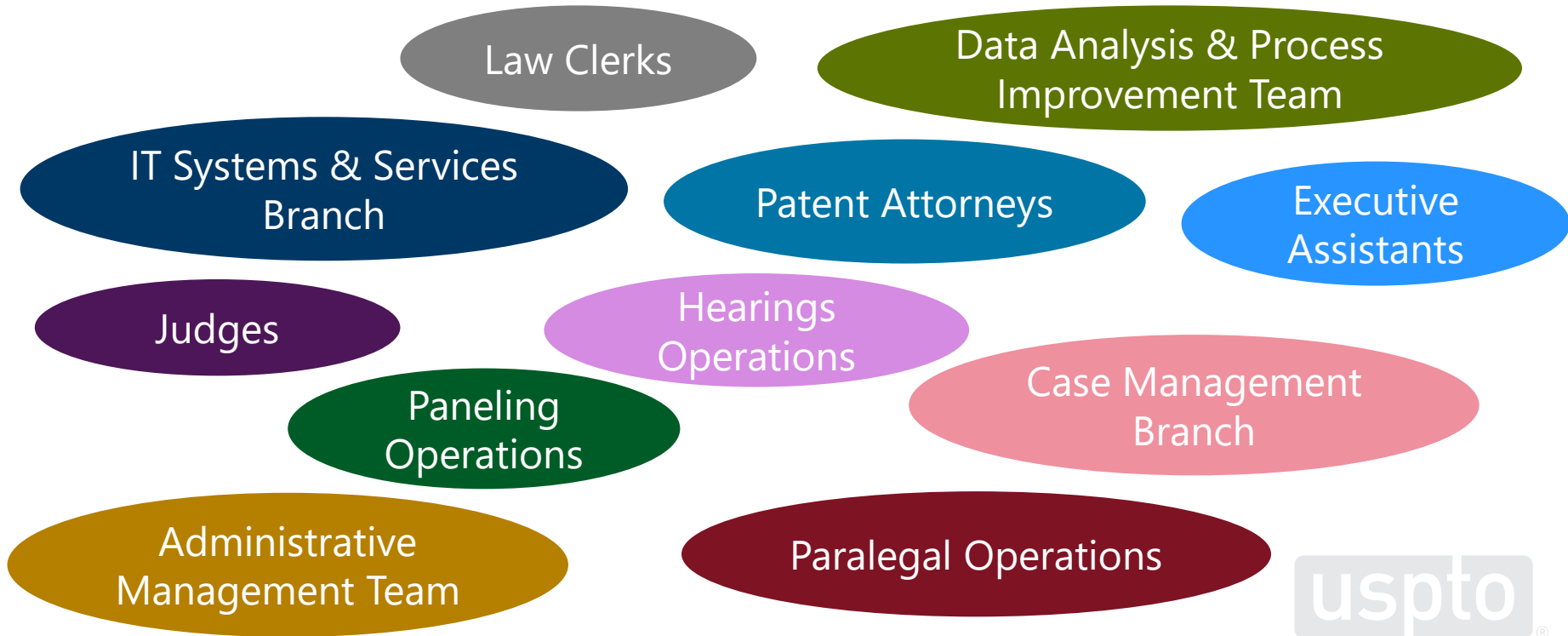


UNITED STATES
PATENT AND TRADEMARK OFFICE ®

State of the Board

Patent Trial and Appeal Board (PTAB)

THE NUMBERS: ~350 members



FY2024 PTAB case load



- 5,479 filed cases
 - 4,188 *ex parte* appeals
 - 1,291 AIA petitions
- 5,317 issued decisions
 - 3,781 *ex parte* appeals; average pendency of 12.4 months
 - 1,089 AIA decisions on institution; average pendency of 2.7 months
 - 447 AIA Final Written Decisions; average pendency of 11.7 months

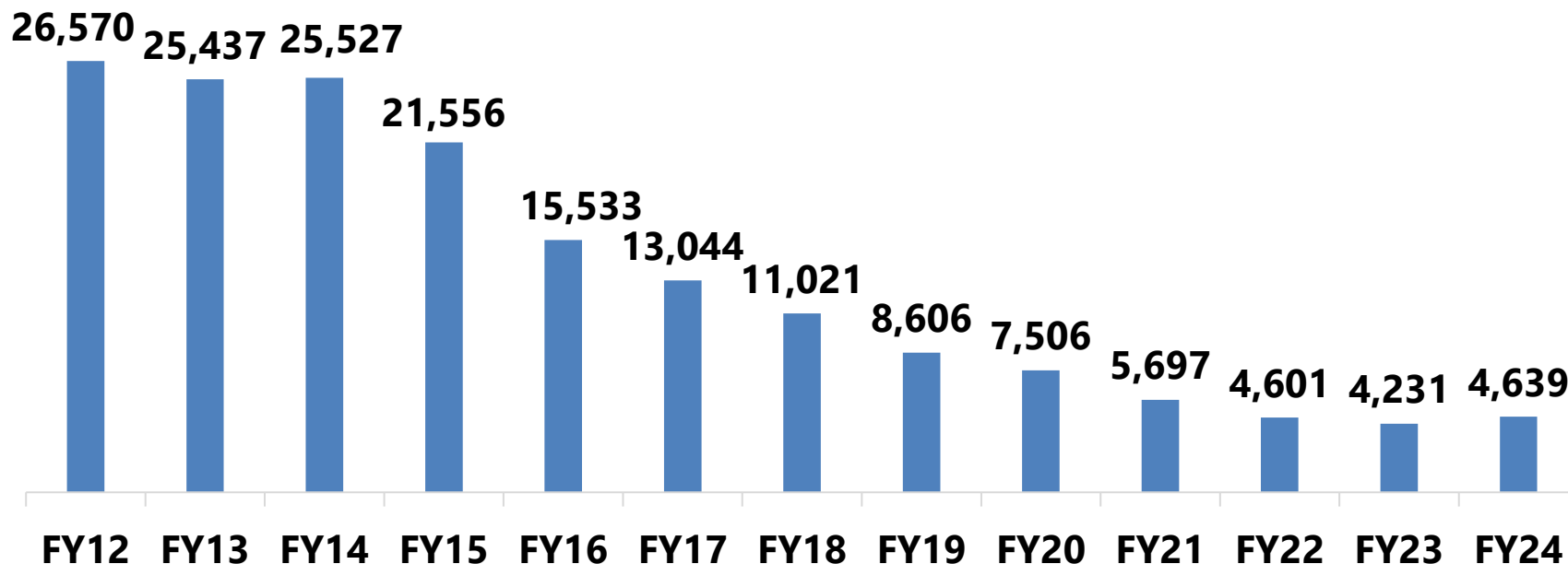
FY2024 hearings

- 671 hearings
 - 155 requests for public audio feed
- 227 in person hearings
 - 93 *ex parte* appeals
 - 134 AIA review hearings
- 444 remote hearings
 - 179 *ex parte* appeals
 - 265 AIA review hearings



Pending appeals FY12 to FY24

(Sept. 30, 2012 – Sept. 30, 2024)

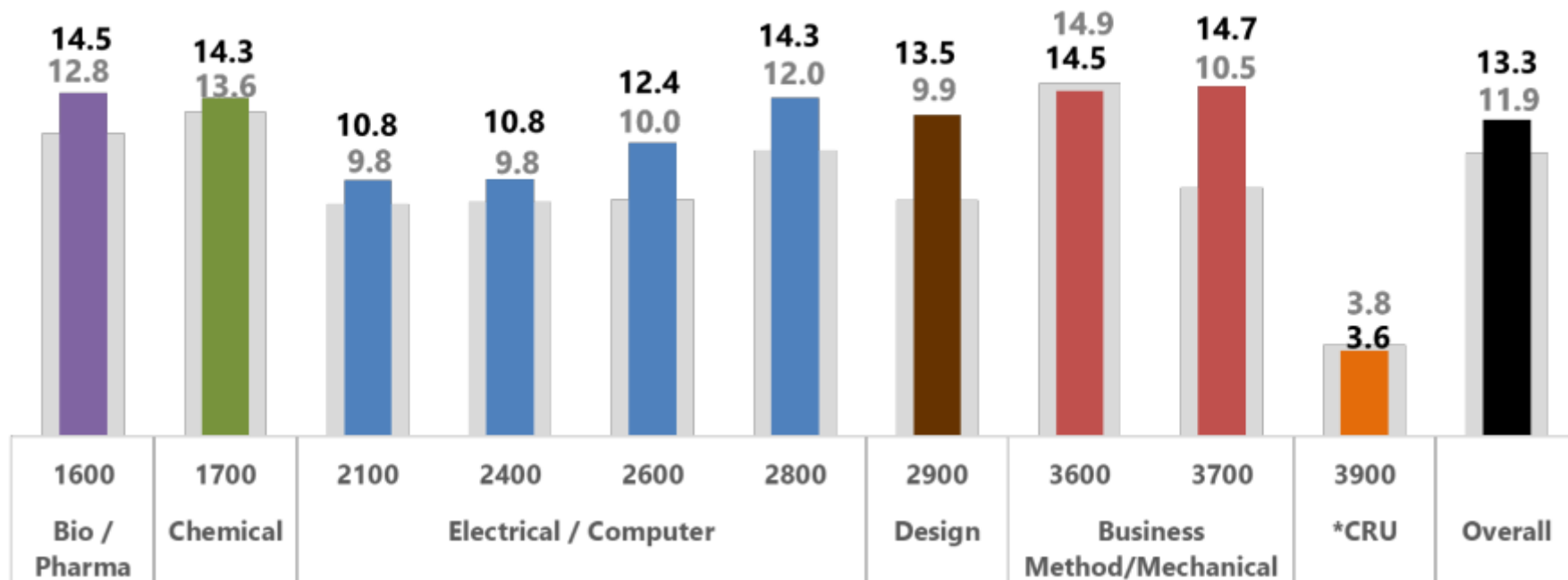


Pendency of decided appeals

(Jul. 2023 – Sept. 2023 compared to Jul. 2024 – Sept. 2024)

■ FY23

■ FY24



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.

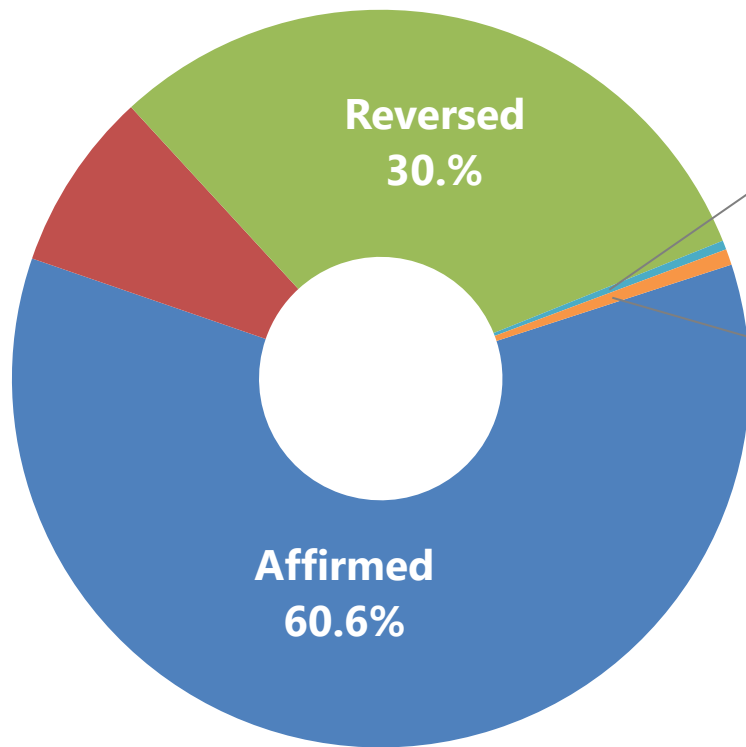
*CRU (Central Reexamination Unit) decisions include *ex parte* reexams, *inter partes* reexam, supplemental examination review, and reissues from all technologies.



Appeal outcomes in FY24

(Oct. 1, 2023 – Sept. 30, 2024)

Affirmed-in-Part
8.0%



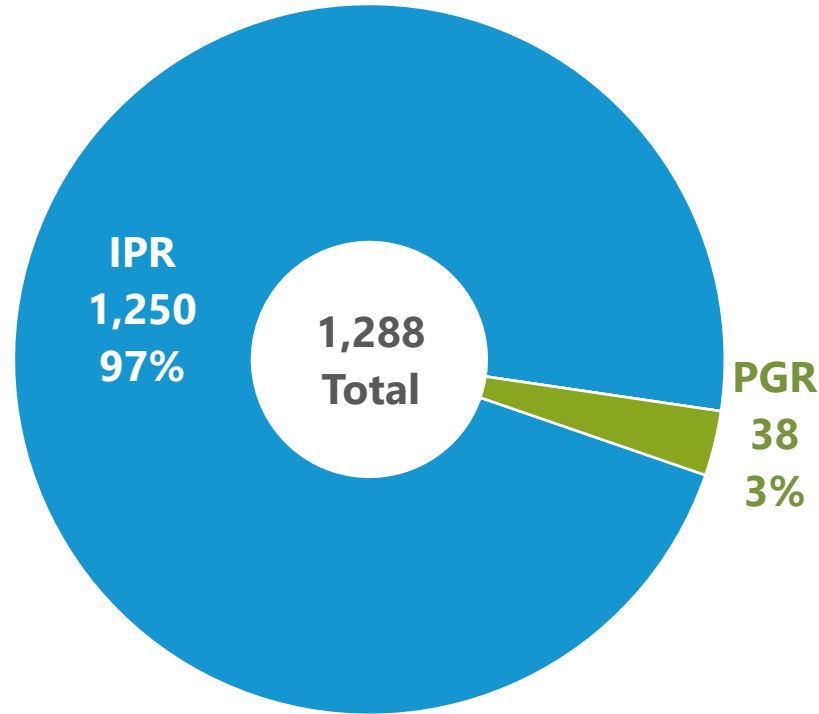
**Administrative and
Panel Remands**
0.4%

Dismissed
0.7%

Affirmed
60.6%

Petitions filed by trial type

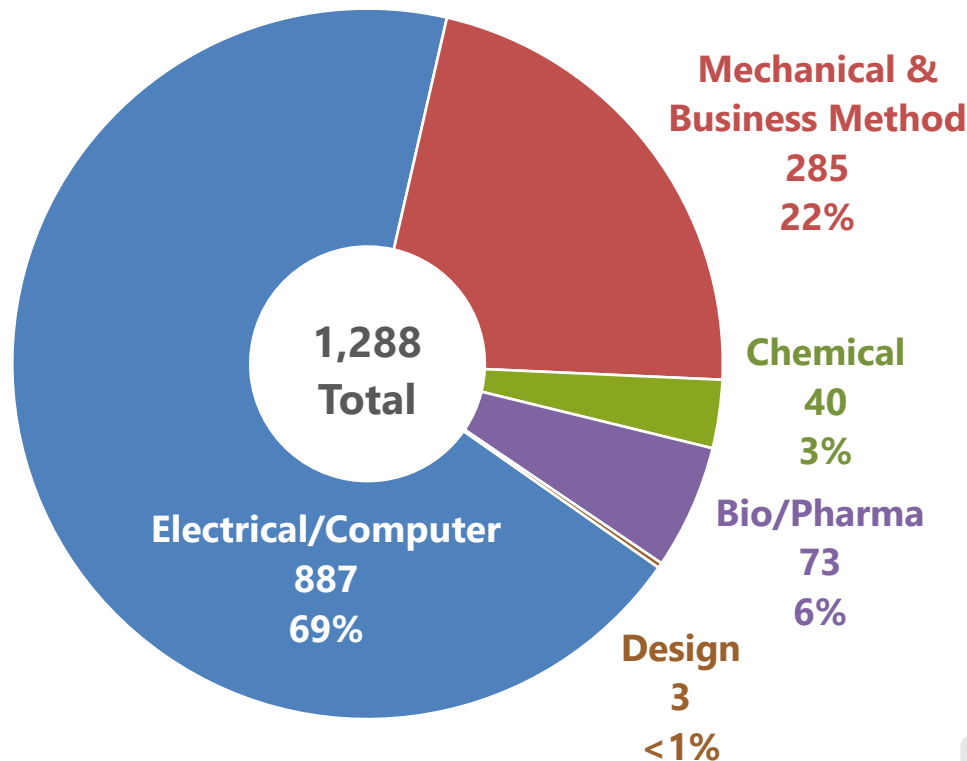
(FY24: Oct. 1, 2023 to Sept. 30, 2024)



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

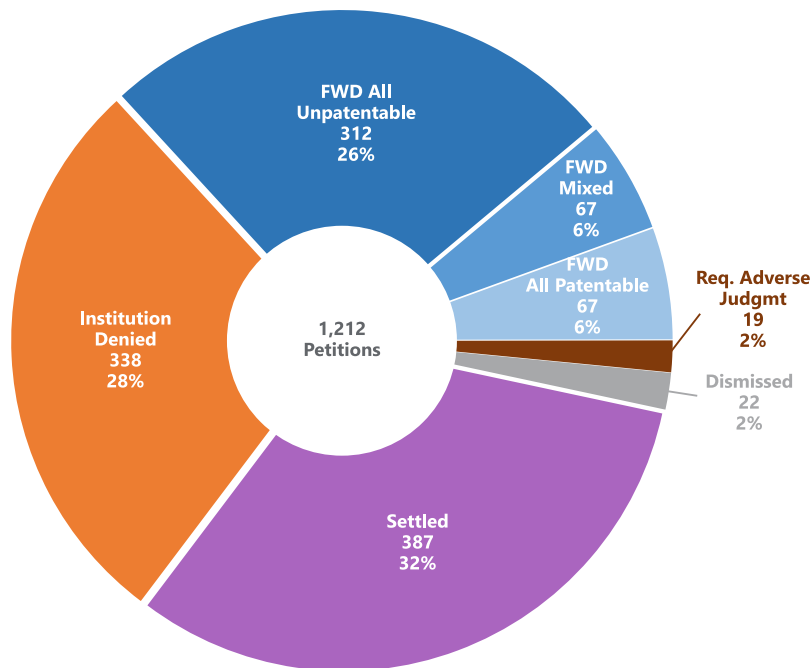
Petitions filed by technology

(FY24: Oct. 1, 2023 to Sept. 30, 2024)



Outcomes by petition

(FY24: Oct. 1, 2023 to Sept. 30, 2024)

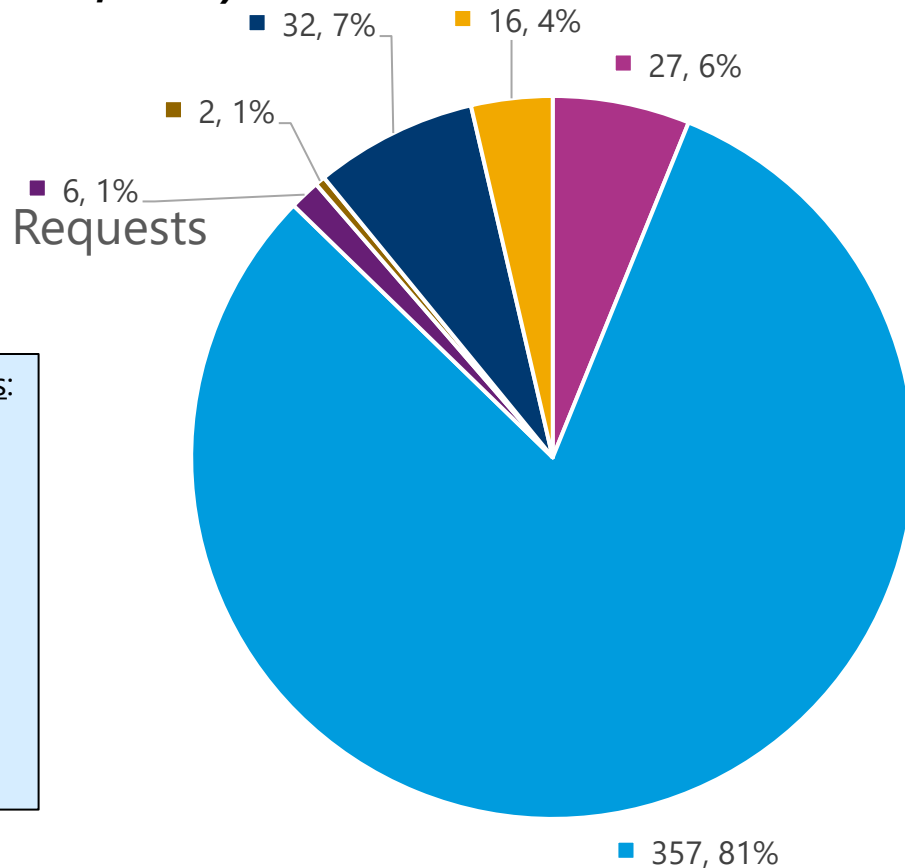


FWD patentability or unpatentability reported with respect to the claims at issue in the FWD. Joined cases are excluded.



Director Review: Statistics

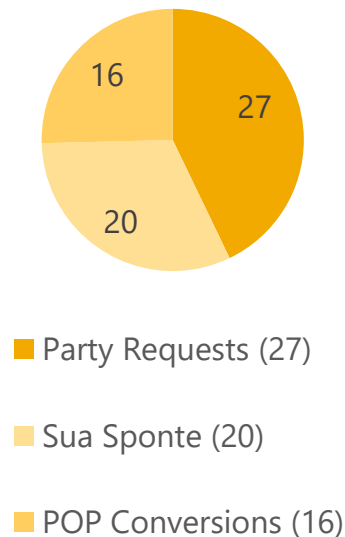
(through October 15, 2024)



424 compliant requests:

- 157 requests from Final Written Decisions
- 148 requests from Decisions on Institution
- 118 limited remands post-*Arthrex*

Grants



PTAB rulemaking

Final Rule on Pre-Issuance Internal Circulation and Review of Decisions Within PTAB

Effective Date:
July 12, 2024

- **USPTO added new rules 37 C.F.R. §§ 43.1-43.6, which provide:**
 - Prior to issuance of a decision by a PTAB panel, the Director, Deputy Director, and Commissioners for Patents and Trademarks shall not communicate, directly or through intermediaries, with any member of the panel regarding the decision.
 - Similarly, no Management Judge or an officer or employee of the Office external to the Board shall initiate communication, directly or through intermediaries, with any member of a panel regarding a decision prior to issuance.
 - Any individual panel member may optionally request that one or more PTAB Management Judges or an officer or employee of the Office external to the Board provide input on a decision prior to issuance.
 - It is within the sole discretion of the panel to adopt any edits, suggestions, or feedback.
- **89 FR 49808 (June 12, 2024)**



Final Rule on Motions to Amend

Effective date:
October 18, 2024

- USPTO amends rules to:
 - Make the motion to amend pilot program permanent, including
 - Issuance of preliminary guidance
 - Option for filing a revised motion to amend
 - Revise rules on burdens of persuasion
 - Preponderance of the evidence standard applies to any new ground of unpatentability raised by the Board
 - Board may consider all evidence of record in the proceeding, including evidence identified in a USPTO prior art search
- 89 FR 76421 (Sept. 18, 2024)



Final Rule on Director Review

Effective date:
October 31, 2024

- Govern Director Review of PTAB decisions
 - Provide that parties to an AIA proceeding may request Director Review of:
 - Any decision on institution,
 - Any final written decision, or
 - Any decision granting rehearing of such a decision, or any other decision concluding a proceeding brought under 35 U.S.C. §§ 135, 311, or 321
 - Address timing and format of requests for Director Review
 - Provide that Director may initiate review sua sponte
- 89 FR 79744 (Oct. 1, 2024)



Final Rule on expanding opportunities to practice before the PTAB in AIA proceedings

Effective Date:
**November 12,
2024**

- Amends PTAB rules of practice to:
 - Excuse requirement to designate back-up counsel for good cause
 - Provide a streamlined alternative procedure for pro hac vice recognition that does not require a fee
 - Clarify duties of counsel recognized pro hac vice
- In response to public input, Final Rule does not amend rules to permit non-registered counsel to serve as lead counsel.
 - Instead, USPTO intends to explore a pilot project under which non-registered counsel would be permitted to serve as lead counsel in some circumstances.
- 89 FR 82172 (Oct. 10, 2024)



Notice of Proposed Rulemaking for briefing discretionary denial issues, and rules for 325(d) considerations, instituting parallel and serial petitions, and termination due to settlement agreement

Deadline to
comment closed:
June 18, 2024

- Proposed rules
 - Enhance and build on existing precedent and guidance PTAB uses in exercising discretion to institute inter partes and post-grant reviews for:
 - serial petitions
 - parallel petitions, and
 - petitions implicating the same or substantially the same art or arguments previously presented to the Office under 35 U.S.C. 325(d)
 - Provide separate briefing process for discretionary institution arguments
 - Align procedures for termination of proceedings pre- and post-institution
- 89 FR 28693 (Apr. 19, 2024)



PTAB outreach

PTAB outreach: Virtual programs

- **Boardside Chat webinars**
 - Series addresses best practices before the Board and answers attendees questions
 - www.uspto.gov/patents/ptab/events/boardside-chats
- **Inventor Hour webinars**
 - Series covering PTAB proceeding basics for independent inventors and those new to PTAB practice
 - <https://www.uspto.gov/patents/ptab/events/inventor-hour>



PTAB outreach: In-person programs

- PTAB and TTAB Stadium Tours
 - Educational sessions and live PTAB *ex parte* appeal and AIA trial proceedings and TTAB opposition proceedings at law schools
 - PTAB and TTAB have plans to visit Michigan State University College of Law in East Lansing, Michigan next year
 - www.uspto.gov/patents/ptab/ptabttab-stadium-tour

PTAB outreach: In-person programs

- PTAB *Ex Parte* Appeals Roadshows
 - Educational sessions sharing best practices for how to succeed in an *ex parte* appeals proceeding
 - Tips for more efficiently filing an appeal brief and making more persuasive written arguments
 - Mock oral argument before a judge panel
 - Gain behind-the-scenes perspectives about what PTAB judges expect and have seen in winning appeals
 - PTAB has visited Los Angeles, Austin, Atlanta, Indianapolis, Philadelphia, and more cities coming soon!
 - www.uspto.gov/patents/ptab/ex-parte-appeal-roadshows



PTAB outreach: Legal assistance

- PTAB Pro Bono Program
 - Matches under-resourced inventors with volunteer patent professionals for the purpose of providing free legal assistance in proceedings before the PTAB. Currently open to *ex parte* appeals.
 - www.uspto.gov/PTABprobono
- PTAB Education Clinic
 - Provides free education to members of the public who have questions about proceedings at the PTAB
 - www.uspto.gov/patents/ptab/education-clinic



PTAB outreach: Development opportunities

- PTAB Legal Experience and Advancement Program (LEAP)
 - Provides training and oral advocacy opportunities for less experienced advocates in proceedings before the PTAB
 - Events
 - LEAP mock argument trilogy
 - LEAP to Chambers
 - LEAP to Law Schools
 - www.uspto.gov/patents/ptab/leap



PTAB outreach: Development opportunities

- PTAB Moot Court
 - Provides law school students a unique opportunity to develop written and oral advocacy skills in the context of an AIA proceedings
 - www.uspto.gov/patents/ptab/moot-court-competition



PTAB outreach: Development opportunities

- PTAB Judicial Law Clerk Program
 - Focuses on patent law
 - Prosecution: *ex parte* appeals
 - Litigation: AIA proceedings
 - Each clerk works with several APJs, and potentially other agency officials
 - Term limited position — one year
 - Timeline
 - Hiring a year in advance
 - Posting will open by April/May for clerkships starting in Fall 2026
 - www.uspto.gov/patents/ptab/ptab-judicial-law-clerk-program



