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Intellectual Property Alert: Notes from the USPTO and Patent Public Advisory Committee Quarterly Meeting Part 8 of 8: PTAB Update

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The United States Patent and Trademark Office (the Office) and the Patent Public Advisory Committee (PPAC) recently held their Patent Public Advisory Committee Quarterly Meeting to review policies, goals, performance, budget, and user fees. Topics addressed included 1) Update on Patents business units; 2) [Finance/Budget](#); 3) [IT update](#); 4) Artificial Intelligence; 5) International update; 6) Pendency and Quality; and 7) [PTAB update](#).

This final alert summarizes three topics discussed during the meeting: 1) America Invents Act (AIA) trials statistics; 2) the Precedential Opinion Panel (POP) and precedential decisions; and 3) the Legal Experience and Advancement Program (LEAP) program.

AIA Trial Statistics

Regarding outcomes in FY19 of cases by petition, about 32% institutions were denied, about 32% were settled, about 36% of the cases made it to a final written decision (FWD), and about 2% requested adverse judgment. For the 36% cases that made it to FWD, 21% were patentable and 55% were unpatentable, with 24% mixed outcome (in the case where there was more than one petition, and that one of them settled, for example).

Regarding the outcomes in FY19 by patent, 27% patent institutions were denied, 27% patent institutions were settled, and about 2% requested adverse judgement. About 37% of patents challenged in FY19 ended up with a FWD, wherein 21% of challenged patents were upheld and 55% were found unpatentable.

Regarding the outcomes in FY19 by claims challenged, only 25% of the challenged claims were actually found unpatentable in the FWD, and about 31% of institutions were denied. For the ones that went onto to receive a FWD, about 10% were found patentable.

For FY20 Q1, about 70% of the patents were challenged in one petition, so far (22% challenged in two petitions).

Precedential Opinion Panel (POP) and Precedential Decisions

PTAB Deputy Chief Judge, Jackie Bonilla, presented precedential cases, which can be found [here](#). One example presented was *Hunting Titan, Inc. v. DynaEnergetics GmbH & Co.* KG IPR2018-00600 (PTAB Aug. 20, 2019) (Paper 42), a case that dealt with motions to amend and what happens to substitute claims. The POP ordered review to address the following issues:

1. *Under what circumstances and at what time during an inter partes review proceeding may the Board raise a ground of unpatentability that a petitioner did not advance or insufficiently developed against substitute claims proposed in a motion to amend?*
2. *If the Board raises such a ground of unpatentability, whether the Board must provide the parties notice and an opportunity to respond to the ground of unpatentability before the Board makes a final determination.*

The POP accepted additional briefing from the parties and amici and held an oral hearing on February 18, 2020.

Legal Experience and Advancement Program (LEAP)

LEAP was designed to foster the development of the next generation of patent practitioners by creating opportunities to gain the proper skills and experience in oral arguments before the Board. To be eligible, a patent agent or attorney new to the practice of law or new to practice before the PTAB must have three or fewer substantive oral arguments in any federal tribunal, including the PTAB, **and** seven or fewer years of experience as a licensed attorney or agent.

Under the LEAP program, the Board will grant additional argument time to the LEAP participant, typically up to 15 minutes depending on the length of the proceeding and the PTAB's hearing schedule. The LEAP participant does not have to be allocated a specific amount of time, and it remains within the Board's discretion to allocate time between counsels. The LEAP participant must have a substantive role in the oral argument, but more experienced counsel may provide some assistance, if necessary, and may make limited clarifications on the record.

To file a LEAP request:

- AIA trials: email to Trials@uspto.gov at least 5 business days before the hearing.
- Appeals: email to PTABHearings@uspto.gov at least 5 business days before the hearing.
- LEAP participants must file a Verification Form confirming eligibility.

LEAP participants are encouraged to participate otherwise in Board proceedings (e.g., conference calls, pre-hearing conferences, and depositions).