

PTAB Programs Spurring More Amendments, Faster Appeals

By **Ryan Davis**

Law360 (February 11, 2021, 10:21 PM EST) -- New Patent Trial and Appeal Board programs have boosted the odds that patent owners can secure amended claims in America Invents Act reviews and significantly sped up some appeals of rejected patent applications, U.S. Patent and Trademark Office officials said Thursday.

At a meeting of the USPTO's Patent Public Advisory Committee, PTAB Deputy Vice Chief Administrative Patent Judge Jacqueline Bonilla provided statistics on a pilot program in which the board provides feedback to patent owners when they seek to amend claims in AIA reviews, and permits them to revise their motion in response.

The optional program began in 2019 in response to concerns that the board very rarely grants motions to amend, and Judge Bonilla said that it has significantly changed the outcome of such motions.

"The bottom line is that when patent owners actually choose to take advantage of the pilot, it's more likely that the motion to amend is going to be granted for at least one substitute claim," she said.

Prior to the program, motions to amend were granted or granted in part about 14% of the time, she noted, but now, such motions are granted or granted in part about 30% of the time whether or not patent owners participate in the program.

Most patent owners have taken advantage of the program, and when they have, 36% of their motions to amend have been granted, Judge Bonilla said. Patent owners who filed motions to amend but chose not to get feedback from the board only had their motions granted 9% of the time, she said.

"So it really seems to make a difference if they requested preliminary guidance or took advantage of filing a revised motion to amend," she said.

Another new PTAB program, which began last year as a way to accelerate appeals of rejected patent applications, has been moving cases along even more quickly than expected, said PTAB Vice Chief Judge Janet Gongola.

There have been 117 requests to participate in the program, which requires an extra fee, and the board has been responding to the requests in an average of two days, she said. All the requests have been granted, except six that were filed prematurely and didn't yet qualify for the program.

When the program was launched, the USPTO said the board would resolve appeals selected for it within six months, compared to 15 months on average for a normal appeal. Judge Gongola said that in practice, the program has turned out to be considerably speedier.

"The average time for a decision has been under two months. So that is much faster than we had anticipated, and it is way faster than the current average appeal pendency of 12 months," she said. "The numbers are better than our expectations, and we want the public to know about them."

Finally, Judge Gongola provided an update on another fledgling PTAB initiative, known as the Legal Experience and Advancement Program, or LEAP, which provides less experienced attorneys opportunities to argue cases at the board.

The program gives parties 15 additional minutes for their arguments when they are handled by attorneys with under seven years experience as a licensed attorney and fewer than three oral argument opportunities before any tribunal.

To date, the board has received 33 requests to participate in the program, 27% from parties appealing rejections of patent applications, 33% from petitioners in an AIA trial and 40% from patent owners in a trial, she said.

She noted that the firms that have participated in the program most frequently to date are Sterne Kessler Goldstein & Fox PLLC, Sunstein LLP, Willkie Farr & Gallagher LLP and Finnegan Henderson Farabow Garrett & Dunner LLP, with two to five LEAP participants each.

The program also offers extensive training opportunities for attorneys, including mock trials before board judges and presentations by experienced PTAB practitioners. Judge Gongola encouraged committee members to spread the word about the program, so that "more practitioners can get the experience we would like for them to have."

"We believe this experience will generally help them in their careers beyond the board, in advocating before any tribunal," including district courts, the Federal Circuit and the U.S. International Trade Commission, she said.

--Editing by Emily Kokoll.