

# While you were working: PTAB developments you may have missed

Focus on Pharma

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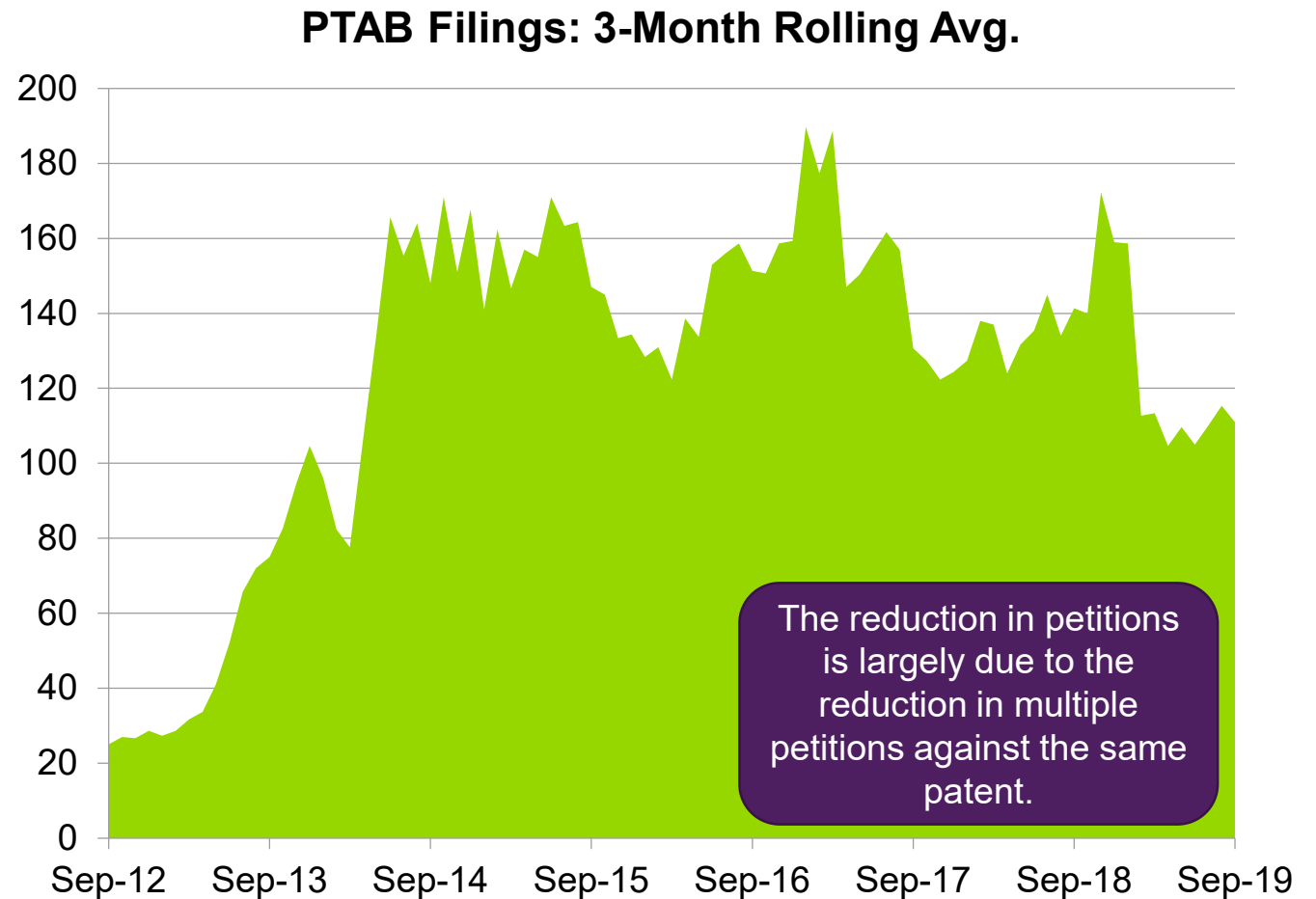
Deborah Sterling, Ph.D.

October 25, 2019

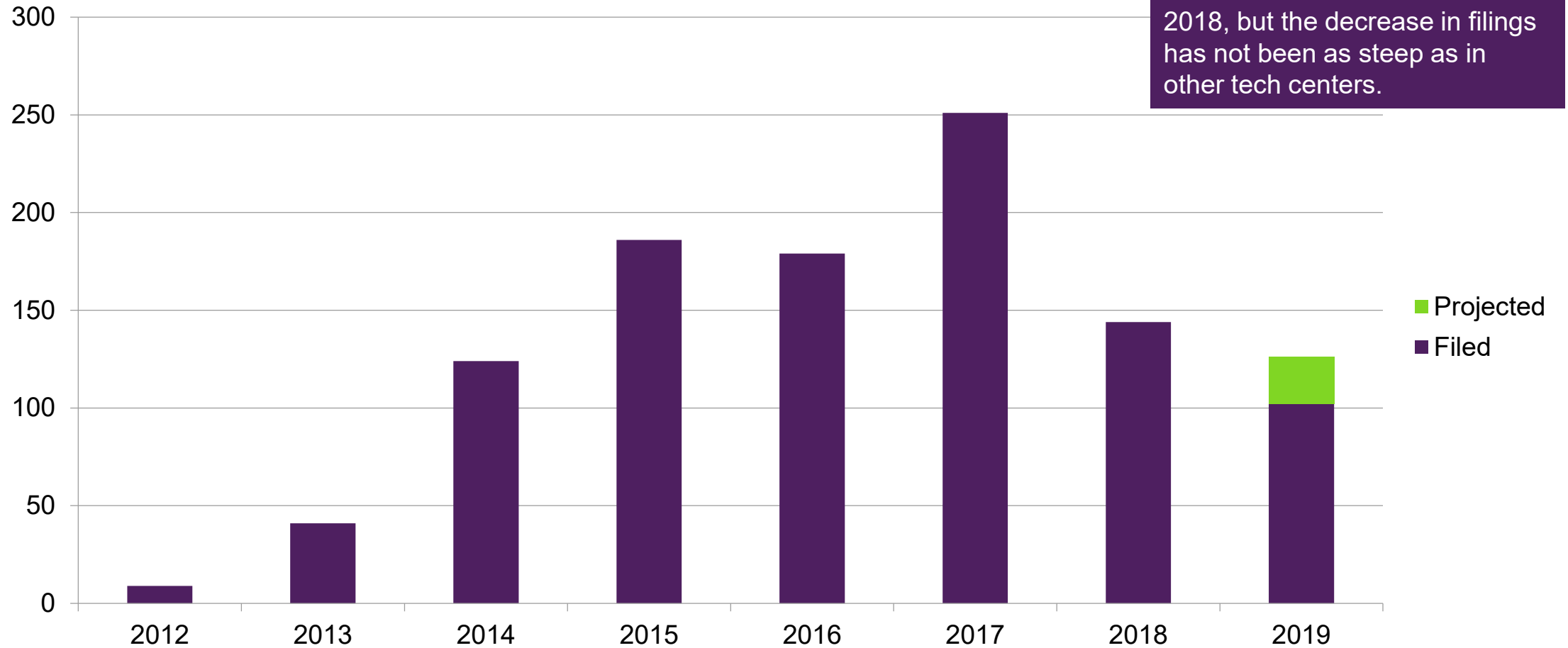
Technical Minds. Legal Muscle.

# PTO Litigation Filing Trends

- 2017 was the most active year for petition filing – slightly topping the previous high from 2015. **2019 is on pace to have the fewest petitions filed since 2013.**
- Petitions have challenged **6,520** unique patents – a petition to patent ratio of **1.64:1**.

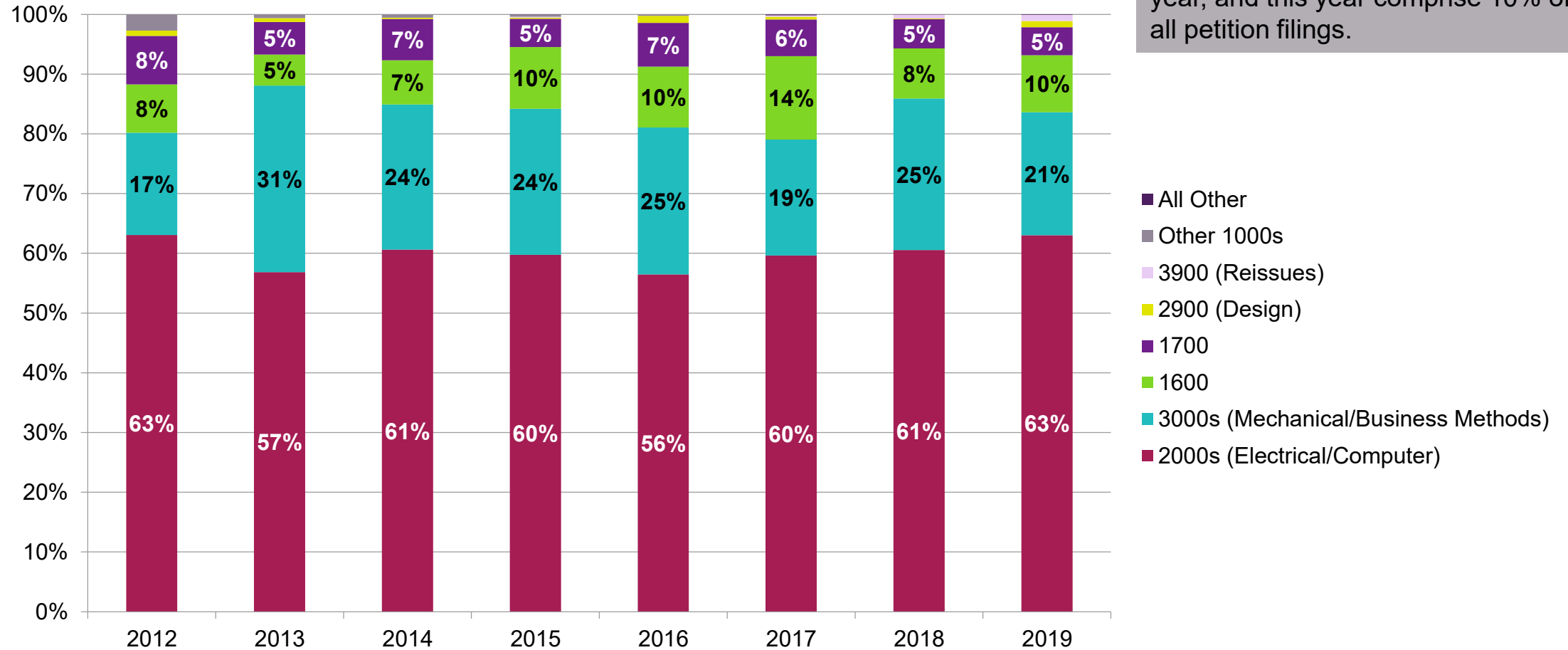


# TC 1600 Petition Filings by Year

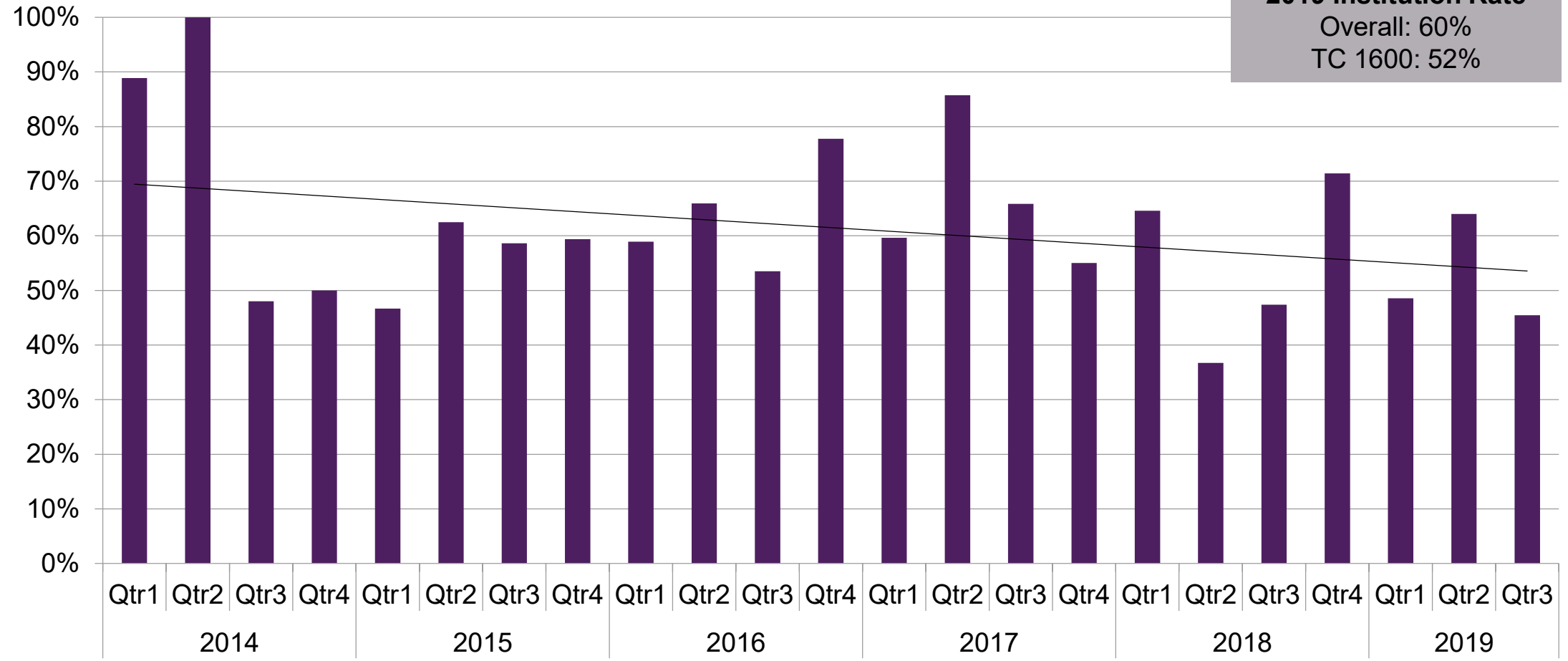


# PTAB Filings by Tech Center

TC 1600 Petitions accounted for 14% of filings in 2017, dropped to 8% last year, and this year comprise 10% of all petition filings.

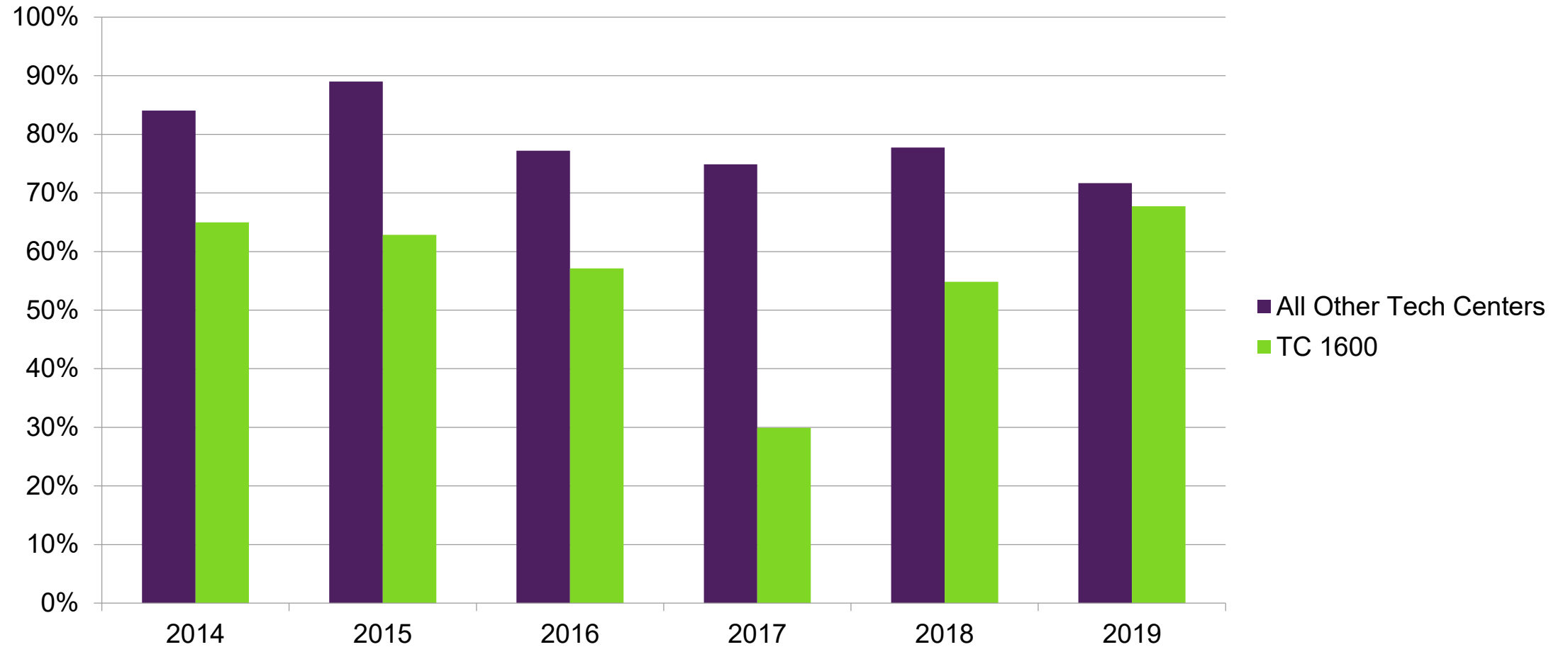


# TC 1600 Proceeding Institution Rate



**2019 Institution Rate**  
 Overall: 60%  
 TC 1600: 52%

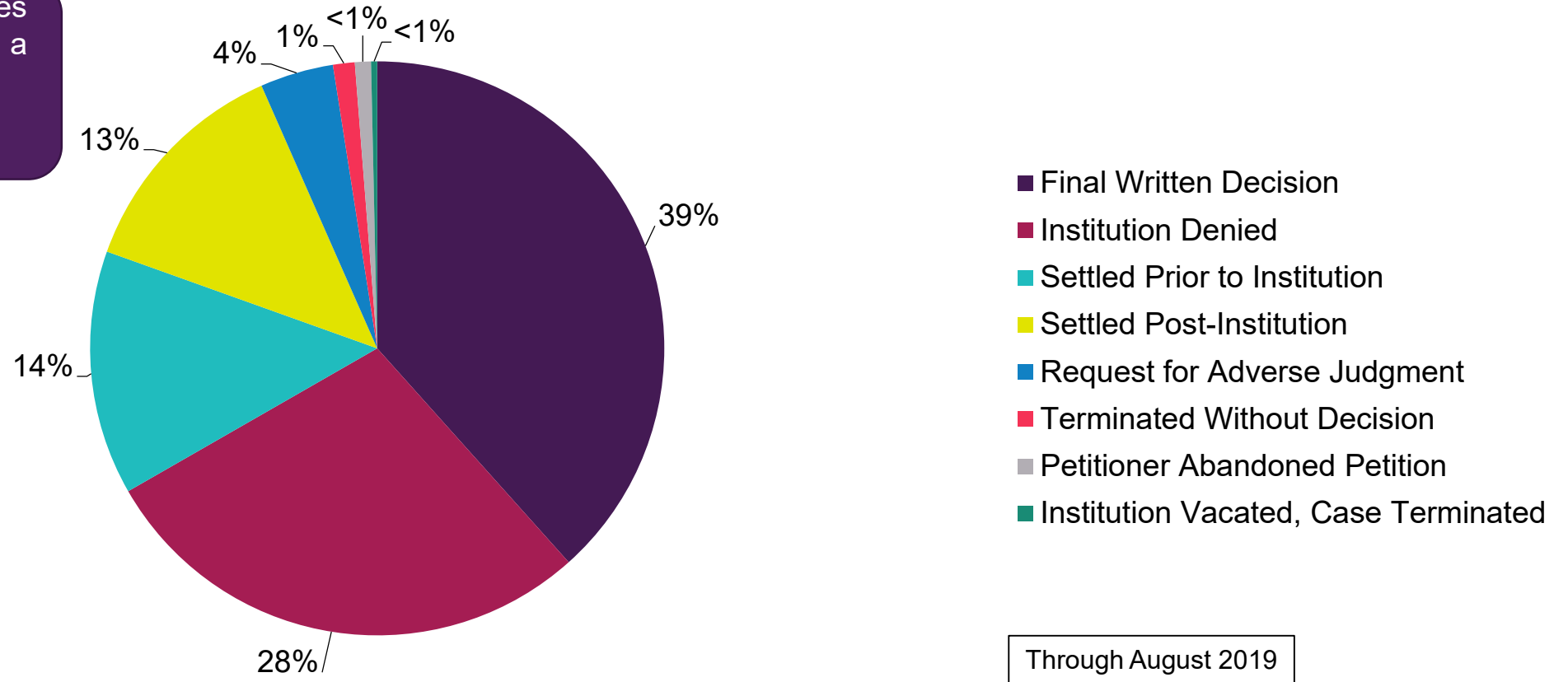
# Instituted Claim Cancellation Rate



# Outcome of Proceedings

## 19 Months After Filing, Excluding Pending Cases

Nearly 30% of challenges are dismissed based on a settlement that likely significantly reduced litigation costs.





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# Triggering one-year stat bar to filing an IPR





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# Updates to Trial Guide

# July 2019 Updates to the Trial Practice Guide

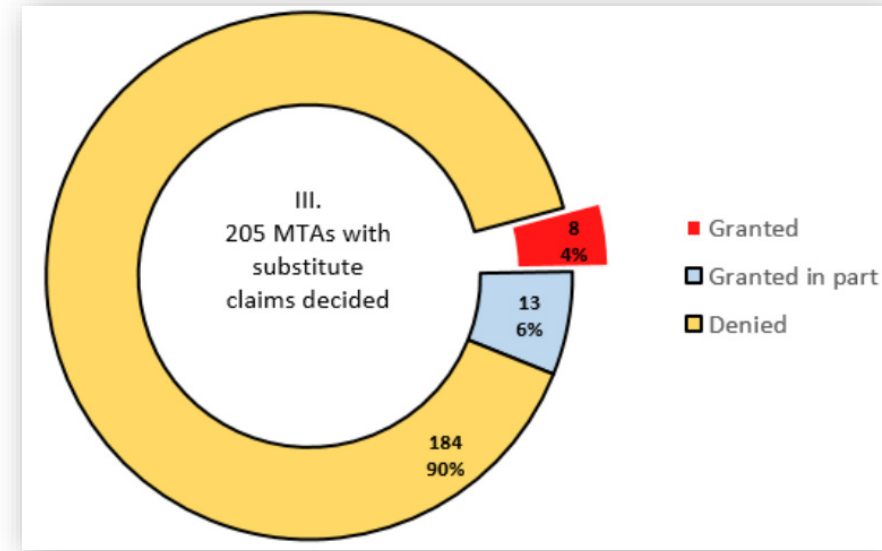
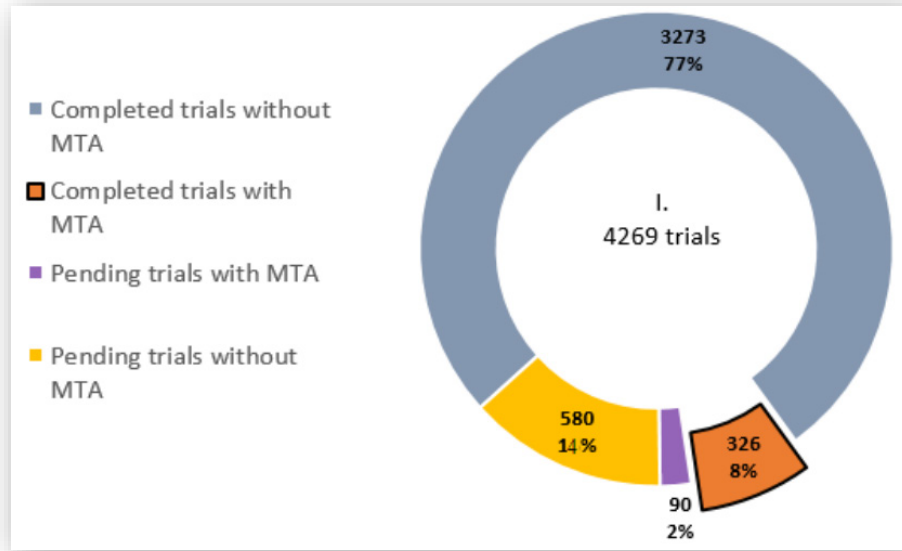
- Revised claim construction standard
- Testimonial evidence with a patent owner preliminary response
- Required submission for petitions challenging the same patent
- Motion to amend practice
- Remand procedures
- Motion for joinder considerations/factors
- Requesting modifications to the default protective order
- Granting additional discovery



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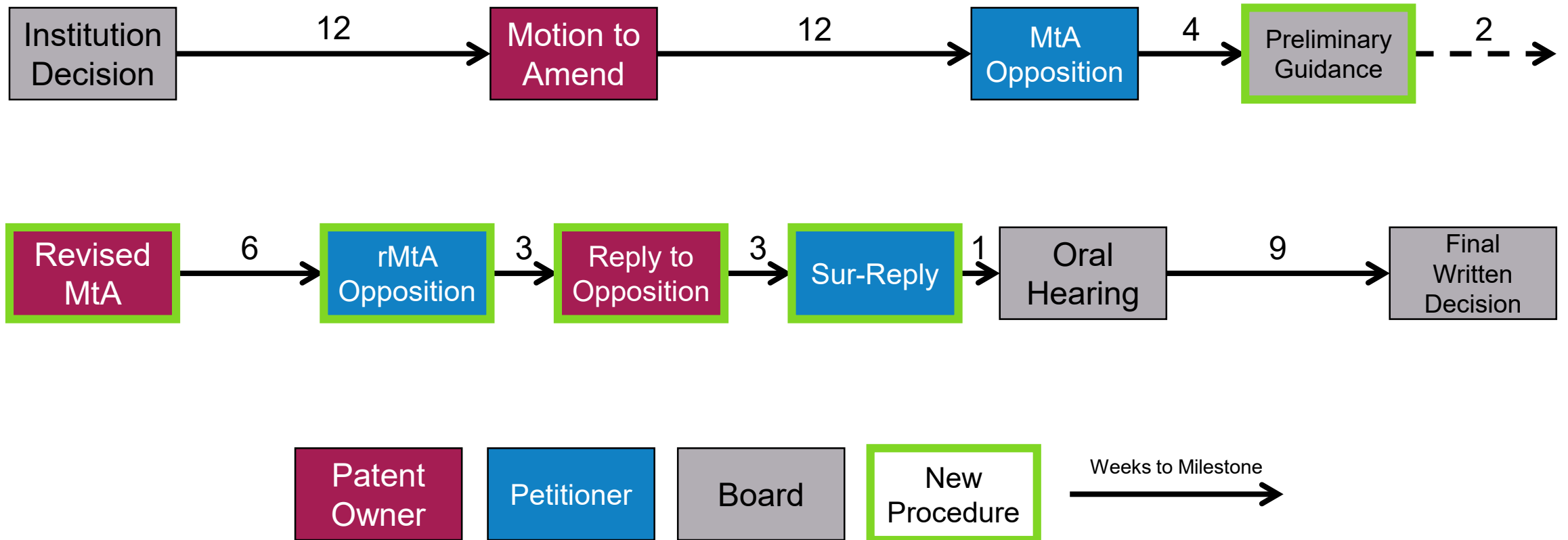
# Motions to Amend

# New Motion to Amend Pilot Program



- Since inception, all PTAB trials granted patent owner ability to amend claims – in theory.
- Rarely filed, rarely granted – fully granted in 0.2% of instituted trials (USPTO Motion to Amend Study through September 2018).

# Motion to Amend Pilot Program Timeline

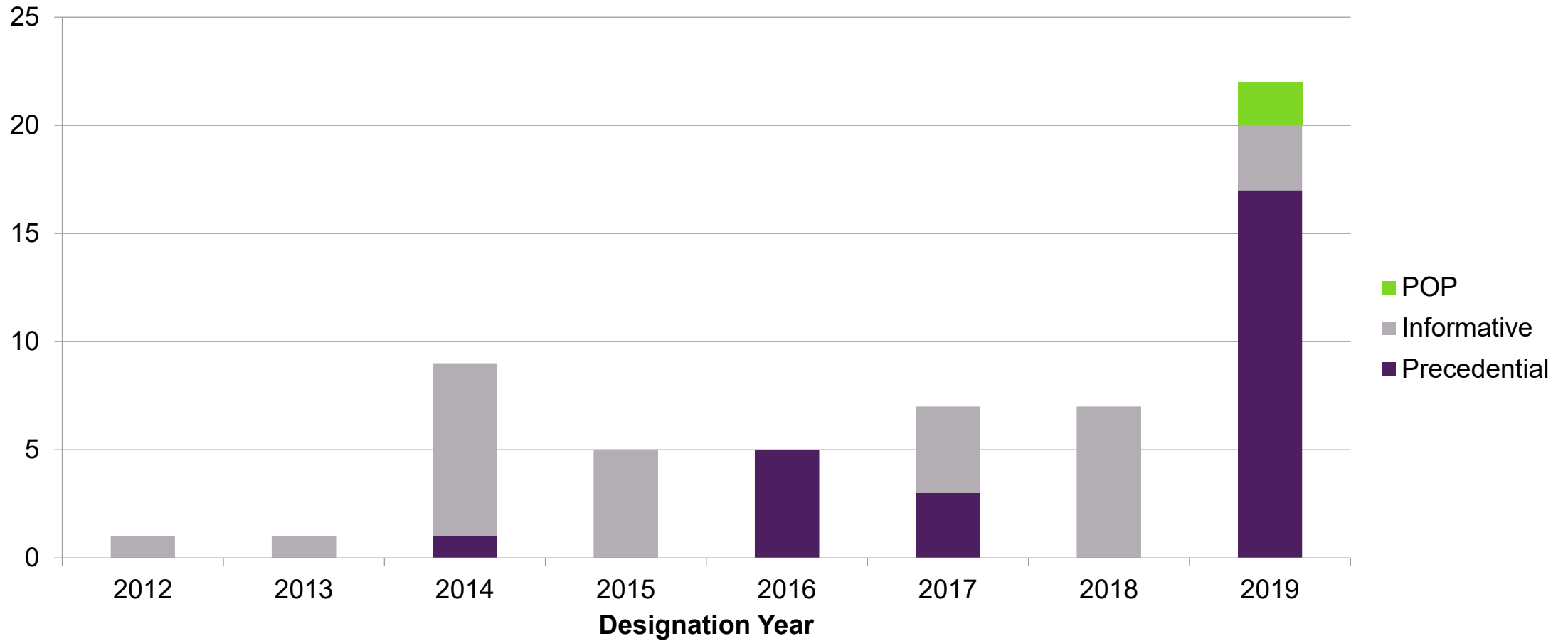




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# Precedential Opinion Panels

# Designations by Year and Type



# Precedential Decision Issues (Includes POP)

	2012	2013	2014	2015	2016	2017	2018	2019	Total
Bar due to patent owner's action					1			5	6
Institution						1		3	4
Real parties in interest					1			1	2
Motions to amend								2	2
Oral Argument								2	2
Bar due to petitioner's action			1					1	2
Discovery					2				2
Request for rehearing								1	1
Deposition testimony								1	1
Preliminary response to petition								1	1
Covered business method review eligibility						1			1
Multiple proceedings								1	1
Assignor estoppel						1			1
Estoppel					1				1
Joinder								1	1
<b>Total</b>			<b>1</b>		<b>5</b>	<b>3</b>		<b>19</b>	<b>28</b>





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# Standing to Appeal



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# Remands

# Default Remand Procedure

Remand Scenario	Additional Briefing	Additional Evidence	Oral Argument
Erroneous Claim Interpretation	Yes, unless the claim interpretation to be applied on remand was proposed by one of the parties and the effect thereof has been fully briefed	No, unless evidence of record is insufficient to afford due process	No
Failure to Consider the Evidence	Yes, unless the evidence was fully briefed on the record	No	No
Inadequate Explanation by the Board	No, unless the briefing on the issues is inadequate for the Board to have made a decision in the first instance	No	No
Erroneous Application of Law	Yes, unless the law was fully briefed on the record but not reflected in Board decision	No	No
Lack of Due Process/Denial of APA rights	Yes	Yes, for parties whose rights have been violated, unless additional briefing on evidence of record is sufficient to afford due process	Yes, if necessary to afford due process
Improper Consideration of the Arguments	Yes, unless argument is fully briefed in the record	No	No

# Questions?



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