

## **2020 PTAB ANALYSIS AND TRENDS: A CLOSER LOOK AT MOTIONS TO AMEND AND THE PILOT PROGRAM**

### **I. Update and Statistical Analysis of Motions To Amend in AIA Trials Under the Pilot Program**

In 2016, the Patent Trial and Appeal Board (“PTAB”) undertook a study of motions to amend to determine: (1) the number of motions to amend that had been filed in AIA trials, both as a cumulative total and by fiscal year; (2) subsequent developments in each motion to amend; (3) the number of motions to amend requesting to substitute claims that were granted, granted-in-part, denied-in-part, and denied; and (4) the reasons the Board provided for denying entry of substitute claims.<sup>1</sup> The PTAB’s study (updated through September 30, 2018) reported that less than 10% of all PTAB trials included a motion to amend. Prior to the PTAB Pilot Program, only 4% of decided motions to amend were fully granted, another 6% were granted-in-part, and 90% were denied.<sup>2</sup>

On March 15, 2019, the PTAB announced a new Pilot Program for motions to amend, which became available for all proceedings instituted on or after that date.<sup>3</sup> The Pilot Program is intended to encourage more patent owners to file motions to amend, giving the patent owner two options not previously available: (1) the opportunity to request non-binding, preliminary guidance from the Board on its motion to amend; and (2) the option to file revised amended claims after receiving the petitioner’s opposition and any preliminary guidance.

This paper provides updated statistics on motions to amend.<sup>4</sup> In particular, it explores whether there has been an increase in the number of motions to amend filed and whether the PTAB has allowed a greater number of claim amendments under the new Pilot Program. Overall, the data shows that while there was a spike in motions to amend filed at the start of the Pilot Program, the number of motions filed has dropped significantly. And, while some predicted the Pilot Program would improve the very low success rates of motions to amend, the Pilot Program to date has not advanced the needle for patent owners in any significant regard.

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<sup>1</sup> U.S. Patent & Trademark Off., Patent Trial and Appeal Board, Motion to Amend Study: Installment 5, at 1, Mar. 2019, [https://www.uspto.gov/sites/default/files/documents/ptab\\_%20mta\\_study\\_%28installment\\_5\\_-\\_%20update\\_through\\_fy2018%29.pdf](https://www.uspto.gov/sites/default/files/documents/ptab_%20mta_study_%28installment_5_-_%20update_through_fy2018%29.pdf) (“PTAB Motion to Amend Study”).

<sup>2</sup> *Id.* at 2–3.

<sup>3</sup> Notice Regarding a New Pilot Program Concerning Motion To Amend Practice and Procedures in Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board, 84 Fed. Reg. 9,497 (Mar. 15, 2019), <https://www.federalregister.gov/documents/2019/03/15/2019-04897/notice-regarding-a-new-pilot-program-concerning-motion-to-amend-practice-and-procedures-in-trial>.

<sup>4</sup> Statistical information presented in the paper was collected from the USPTO website and data from Docket Navigator and Lex Machina.

Figure 1 tracks the number of motions to amend filed by the PTAB's fiscal year. The data shows an increase in the number of motions to amend filed in fiscal year 2018,<sup>5</sup> and this increase was sustained in fiscal year 2019, the year when the PTAB Pilot Program started. However, the projected number of filings for fiscal year 2020 is down significantly.

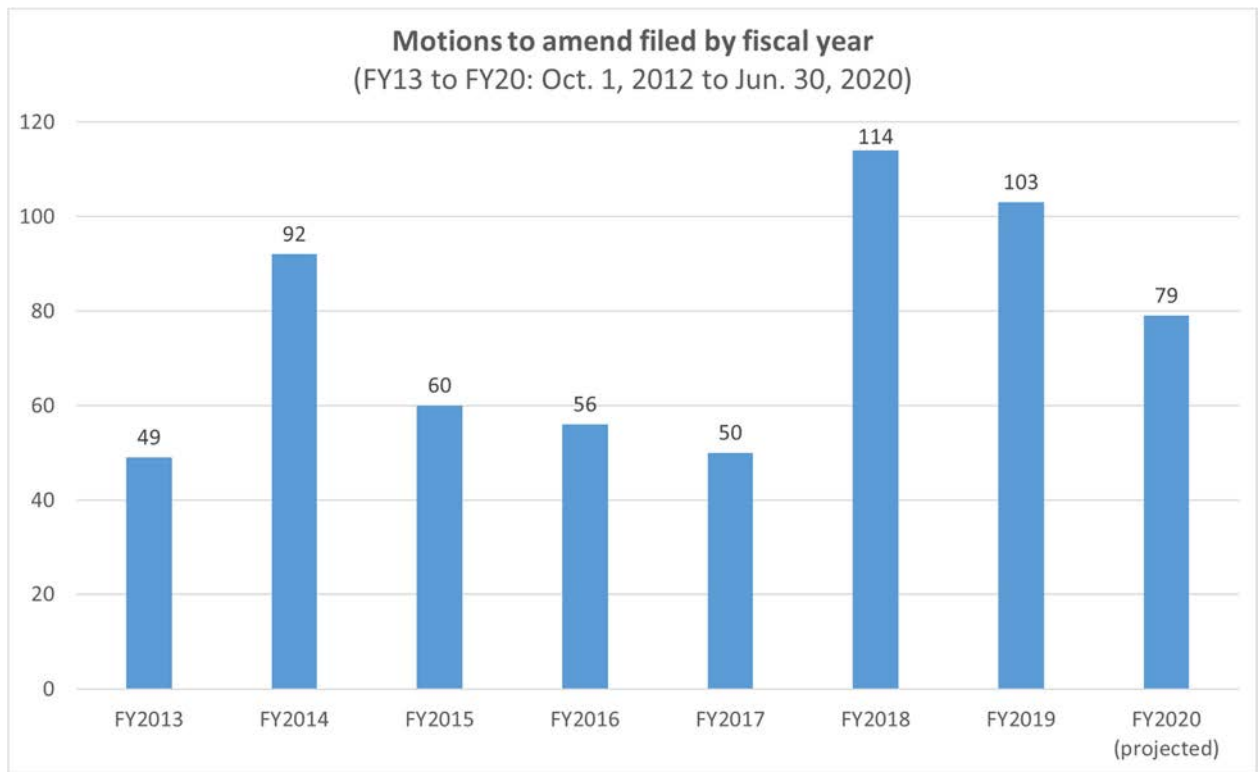


Figure 1

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<sup>5</sup> The spike in the number of motions to amend filed in fiscal year 2018 could be in response to the *en banc* rehearing decision in *Aqua Prods. Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017), where the Federal Circuit held that petitioner bears the burden of persuasion with respect to the patentability of amended claims. This case was decided on October 4, 2017, the beginning of the PTAB's fiscal year 2018.

Figure 2 looks at the same data as Figure 1 by fiscal quarter. The number of motions to amend filed in the third quarter of fiscal year 2019 (*i.e.*, between April and June 2019) exceeds the number of motions to amend filed in any other fiscal quarter. This spike in the motions to amend may be attributed to the start of the Pilot Program on March 15, 2019. In subsequent fiscal quarters, the numbers of motions to amend filed decrease significantly.

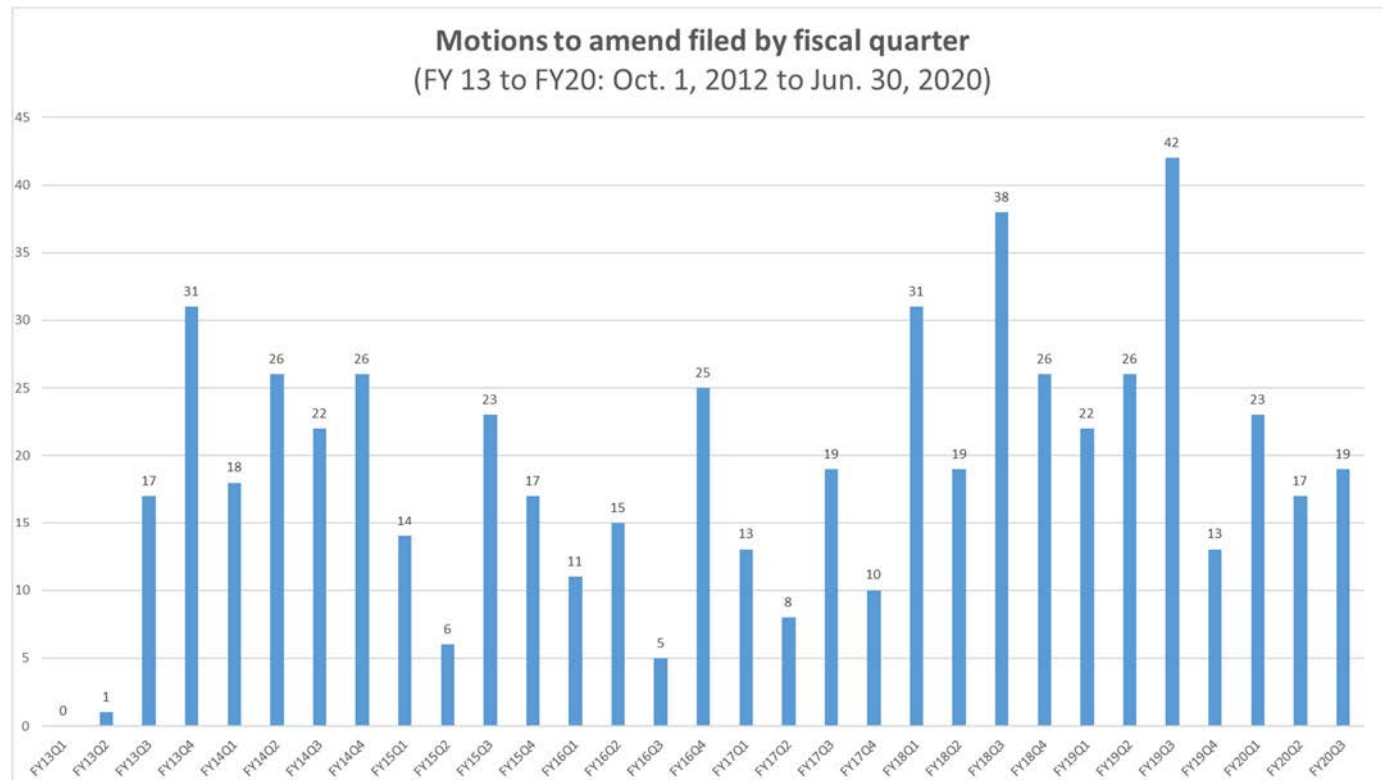


Figure 2

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