

2022 PTAB Annual Conference Takeaways

Choate was a sponsor of the recent PTAB Bar Association Annual Conference in Washington D.C., where more than 150 practitioners, in-house counsel, and attorneys from law firms gathered to hear the latest updates and trends. The conference kicked off with a keynote speech from PTAB Chief Judge Scott Boalick and concluded with a panel on ethics before the PTAB. The conference also included a “fireside” chat with the Under Secretary of Commerce for Intellectual Property and Director of the USPTO. Below are key takeaways from the conference.

AIA Retrospective and Challenges Facing the PTAB

The 10-year anniversary of the America Invents Act (“AIA”) in September 2021 (which created the post grant review and *inter partes* review framework), has created an opportunity to reflect on how far things have come since the AIA was passed and what gaps may still remain. In light of the gaps that have been identified, Congress has recently proposed legislation that may impact future PTAB proceedings.

For example, the proposed “Restoring the America Invents Act,” which, among other things, would remove discretion of denial of institution and codify Director review of final written decisions from the PTAB. Particularly, the proposal would require that the Director explain any decision to overrule a panel decision separately and in writing.

The goal of the legislative proposals is to provide consistency in PTAB procedures, specifically in the area of discretionary denial, which has been a hot topic of debate since the PTAB outlined the factors to consider when exercising discretionary denial in *Apple v. Fintiv*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential).

Ex Parte Reexamination & Inter Partes Review

The impact of *Fintiv* continues to be felt, particularly with an increase of requests for *ex parte* reexaminations, as more parties look to alternative options to either avoid discretionary denial at the PTAB, or attempt to save some claim scope after a final written decision. The Board, however, will stay a parallel *ex parte* reexamination proceeding in favor of an *inter partes* review, depending on a number of factors, including the similarity between the claims being considered in both proceedings, and the art and arguments being raised.

Therefore, the strategy for bringing parallel proceedings in both an *ex parte* reexamination and an *inter partes* review, must be carefully considered, as highlighted by the recent Federal Circuit case, *In re Vivint, Inc.*, No. 20-1992 (Fed. Cir. Sept. 29, 2021). In *Vivint*, the Board exercised its discretion to deny institution under § 325(d), which lead Petitioner to request *ex parte* reexamination of all claims of the challenged patent, raising substantially the same grounds as raised in the Petition.

The Patent Office, despite challenges from Patent Owner that the arguments had already been dismissed in a Petition for *inter partes* review, continued with reexamination. Patent Owner appealed to the Federal Circuit, which decided that the Patent Office abused its discretion by denying institution under § 325(d) “based on abusive filing practices,” and then granting “a nearly identical reexamination request that is even more abusive.”

After *Vivint*, the Office has emphasized that they are reviewing the art and arguments raised in parallel proceedings to avoid inconsistent positions, and that any petitions under § 325(d) or 37 CFR 1.182 should be made quickly to avoid waste of resources.

Appellate Review of PTAB Rulings

Recent analysis of PTAB decisions appealed to the Federal Circuit showed that 79% of PTAB cases are affirmed at the Federal Circuit. Of the 21% that are reversed, 75% of those decisions are reversed for procedural or legal errors. Few cases are reversed due to a finding that the PTAB decision lacked substantial evidence. In the event parties settle at the Federal Circuit, it is still possible that the Solicitor's Office can step into the shoes of the appellant and litigate the appeal.

Diversity Initiatives

The PTAB shared the following statistics and emphasized that it continues its work on improving diversity:

- Women make up 20-30% of registered patent attorneys.
- Women make up 12% of total attorney appearances in PTAB proceedings.

We are proud to note that Choate is among the top five firms identified by the PTAB Bar Association for women attorney appearances in the Biopharma space.

Practice Tips & Updates

- The importance of a meet and confer between parties before making any request to the Board was emphasized. APJs at the meeting noted that they are far more likely to give additional briefing opportunities if both parties agree.
- The pro bono program for *ex parte* appeals is now live and qualified attorneys can register [here](#). Inventors who meet the USPTO's qualification can begin signing-up in early June.
- The USPTO has launched a pilot program titled the "Deferred Subject Matter Eligibility Response Pilot Program (DSMER)" to assess the value of permitting applicants to defer responding to Subject Matter Eligibility (SME) rejections under 35 U.S.C. § 101 until the earlier of either the final disposition of the patent application or after all non-SME issues of patentability have been addressed. This program runs between February 1, 2022 and July 30, 2022 and participation in DSMER is by invitation only.
- The LEAP program continues to be a favorite topic of the judges, who strongly encourage firms to take advantage of it. The Board also highlighted that the standards for LEAP qualification recently changed by removing the requirement that an attorney practice for 7 years or less to qualify, which gives more practitioners an opportunity to take advantage of the program.

For more information about the evolving landscape at the PTAB as discussed at the conference, please contact one of the following attorneys:

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