

A background of a technical drawing or patent illustration, showing various mechanical parts and components with numerical callouts such as 18, 80, 84, 86, 82, 68, 34, 32, and 52. The drawing is rendered in a light gray color against a white background.

# Patent Trial and Appeal Board Motion to Amend Study

4/30/2016

UNITED STATES  
PATENT AND TRADEMARK OFFICE



## Motion to Amend Study

There have been more than 4,850 *inter partes* review, covered business method review, and post-grant review petitions filed since the inception of the America Invents Act (“AIA”). As of April 30, 2016, the Board had instituted and completed 1539 trials<sup>1</sup> (either through post-institution termination due to settlement, request for adverse judgment, dismissal, or in a final written decision). Given the number of pending and completed trials, the Board undertook a study of motions to amend to determine: (1) the number of motions to amend that have been filed in AIA trials, both as a cumulative total and by fiscal year; (2) subsequent developments of each motion to amend; (3) the number of motions to amend requesting to substitute claims that are granted, granted-in-part and denied-in-part, and denied; and (4) the reasons the Board has provided for denying entry of substitute claims.

The AIA provides that a patent owner may file a motion to amend its claims during a trial. A motion to amend may involve a request to cancel patent claims, to substitute claims in the patent, or a combination of the two. Requests solely to cancel claims typically are granted without substantive review. Requests that seek to substitute claims are generally decided only when the panel of judges determines that the claims as originally issued are unpatentable, because nearly all such motions are contingent on a decision unfavorable to patentability on the original claims. Because not all proceedings include a motion to amend, because some proceedings that

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<sup>1</sup> Joined or consolidated trials were counted as a single trial for purposes of the motion to amend statistics, because this study focuses on the outcome of a motion filed in one of those trials. The number of completed trials referenced in the motion to amend statistics, therefore, differs from the total number of petitions referenced in other Board statistics depicting outcomes for all petitions that have reached a final disposition.

include a motion to amend do not result in a final written decision, because not all motions to amend seek to substitute claims, and because the Board does not need to reach the merits of a motion to substitute claims when the original claims are deemed patentable, the Board has decided the merits of a motion to amend to substitute claims in only a fraction (118 trials, or 8%) of the 1539 completed AIA trials.

These graphs and table below provide the results of the motion to amend study. Graph I is a pie chart that shows the cumulative number of motions to amend that have been filed in AIA proceedings, both completed and pending. Patent Owners have filed a motion to amend in 192 of the 1539 completed trials (12%), and in 34 of the 743 pending trials (5%).

Graph II, a pie chart that depicts the subsequent developments of the motions to amend, focuses on the outcomes of the 192 completed trials in which Patent Owners filed a motion to amend. The panel of judges decided a motion to amend requesting to substitute claims in 118 of the 192 completed trials (61%<sup>2</sup>). In 74 of the 192 completed trials (39%<sup>3</sup>), the motion to amend either: (a) requested solely to cancel claims (17, or 9%), (b) was rendered moot because the panel of judges found the original claims patentable (16, or 8%), or (c) was not decided because the case terminated prior to a final written decision (41, or 21%).

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<sup>2</sup> The label for Graph II indicates 62% rather than 61%. This is because the software program that was used to generate these graphs apportions rounding errors among each slice of the pie to ensure the percentage labels add up to 100%. Accordingly, a number may be rounded up or down when it typically would not. Here, 0.61458 was double rounded in the pie chart to 62% to ensure the slices add up to 100%.

<sup>3</sup> See n. 2.

Graph III is a pie chart that depicts the outcomes of the 118 motions to amend requesting to substitute claims that were decided, i.e., the number of motions to amend requesting to substitute claims that were granted, granted-in-part and denied-in-part, or denied. A panel of judges granted or granted-in-part and denied-in-part a motion to amend in 6 of the 118 trials (5%) and denied a motion to amend in 112 of the 118 trials (95%).

The table to the left of Graph III focuses on the reasons provided in the final written decisions for denying entry of substitute claims in the 116 trials in which the motion to amend was denied or denied-in-part. The table is divided into two sections: (1) reasons based in whole or in part on 35 U.S.C., and (2) reasons based solely on procedure. The final written decision set forth at least one statutory reason for denying or denying-in-part a motion to amend in 94 of the 116 trials (81%), and based a denial solely on procedural reasons in 22 of the 116 trials (19%). For purposes of the study, a denial based on a patent owner's failure to show that the substitute claims are patentable over the "prior art in general" was classified as a procedural reason. Of the 116 trials in which the motion to amend was denied or denied-in-part, only 1 trial had a motion to amend denied based solely on a patent owner's failure to show patentability over the prior art in general.<sup>4</sup>

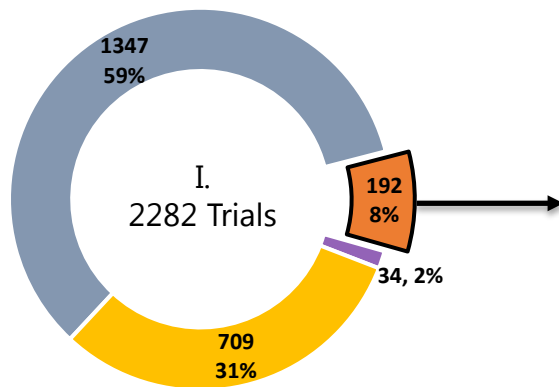
As set forth above, the motion to amend study also determined the number of motions to amend filed in each fiscal year. The bar chart corresponding to the data shows the total number of motions to amend filed in a given fiscal year. The data for fiscal year 2016 is from October 1, 2015 through April 30, 2016.

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<sup>4</sup> See *Idle Free Systems, Inc. v. Bergstrom, Inc.*, Case IPR2012-00027, slip op. 26–38 (PTAB January 7, 2014) (Paper 66).

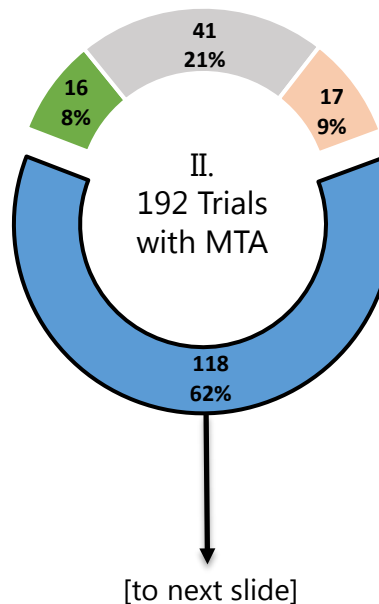
## How Many Motions to Amend Are Filed?

- Completed Trials w/o MTA
- Completed Trials with MTA
- Pending Trials with MTA
- Pending Trials w/o MTA



## Subsequent Developments of the Motions to Amend

- Moot b/c Claims Patentable
- MTA Withdrawn or Case Settled, Req. Adv. J, or Dismissed
- MTA Solely to Cancel Claims
- MTA Substitute Claims Decided



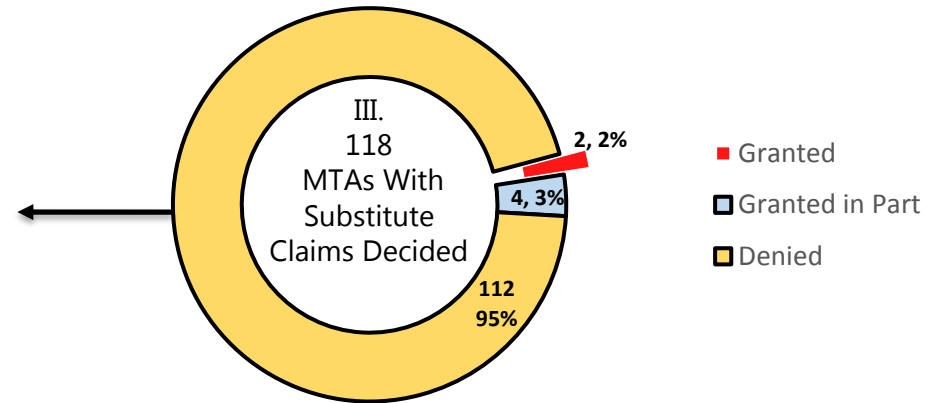
### Reasons Provided for Denying Entry of Substitute Claims\*

	<i>Reason Given</i>	<i># of Cases</i>	<i>Pct</i>
<b>Reasons Based in Whole or Part on 35 U.S.C.:</b>			
101	Non-Statutory Subject Matter	7	6%
112(a)	Written Description	9	8%
112(b)	Definiteness	1	1%
102/103	Anticipated/Obvious Over Art of Record	41	35%
316(d)(3)	Claims Enlarge Scope of Patent	6	5%
316(d)(1)(B)	Unreasonable # Substitute Claims	3	3%
	Multiple Statutory Reasons Given**	27	23%
<b>Reasons Based Solely on Procedure:</b>			
	Cases Where Only Procedural Reasons Given	22	19%
	<i>Totals:</i>	<i>116</i>	<i>100%</i>

\* 116 MTAs requesting entry of substitute claims have been denied in whole or in part.

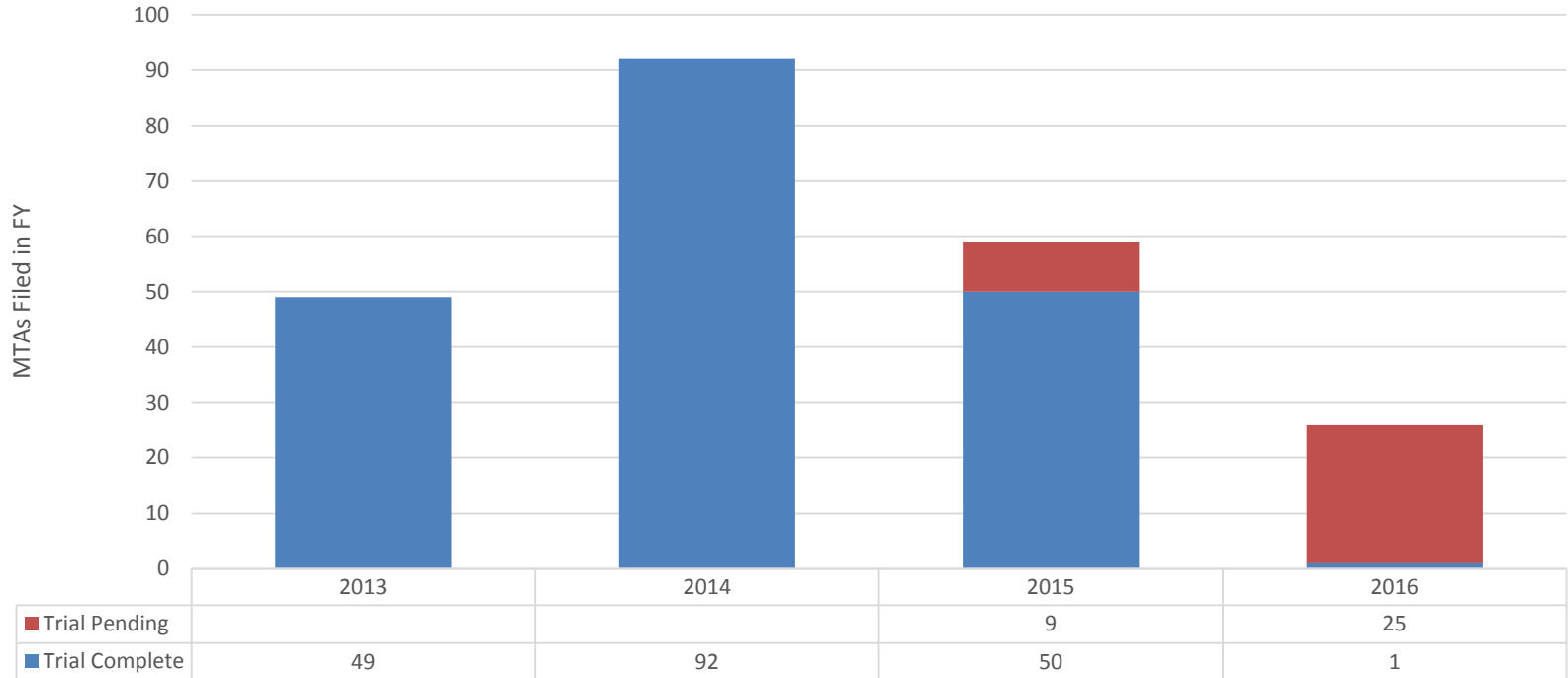
\*\* Of the "Multiple Statutory Reasons Given" trials, 24 of the 27 trials included "Anticipated/Obvious" as a reason.

### How Many Motions to Amend Substituting Claims Are Granted?



Data current as of: 4/30/2016

## How Many Motions to Amend Were Filed in Each Fiscal Year?



Data for FY2016 are from October 1, 2015–April 30, 2016.

