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PTAB programs streamlining patent amendment and appeal processes

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The United States Patent and Trademark Office (USPTO) develops patent initiatives designed to advance and support the examination process.¹ Some of those initiatives include new, pilot programs for the Patent Trial and Appeal Board (PTAB). There are a couple of new PTAB programs recently introduced that should increase a patent owners' chances of amending claims and speed up the appeal process.

Motion to Amend Pilot Program

The Motion to Amend (MTA) Pilot Program applies to all American Invents Act trials instituted on or after March 15, 2019.² The pilot program provides a patent owner with two options not previously available. The first option is that a patent owner may choose to receive preliminary guidance from the PTAB on its MTA. The second option is that a patent owner may choose to file a revised MTA after receiving petitioner's opposition to the original MTA and/or after receiving the PTAB's preliminary guidance (if requested). Patent owners still have the option to pursue an MTA as was done prior to institution of the program.

Almost two years after institution of the program, the MTA pilot program appears to be improving the number of motions to amend and granted motions to amend. According to PTAB Deputy Vice Chief Administrative Patent Judge Jacqueline Bonilla, motions to amend were granted or granted in part about 14% of the time, but now, such motions are granted or granted in part about 30% of the time whether or not patent owners participate in the program.³ Additionally, she noted that 36% of patent owners who filed the new MTA were granted.

This incremental, but steady, increase in grant rates generally shows the PTAB's preliminary guidance may assist a patent owner in successfully amending claims. This may also have other

¹ <https://www.uspto.gov/patents/initiatives/uspto-patent-application-initiatives-timeline>

² <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>

³ <https://www.law360.com/ip/articles/1354805/ptab-programs-spurring-more-amendments-faster-appeals>

effects, such as influencing a patent owner's enforcement strategy. Other options a patent owner may consider include reissue applications and *ex parte* reexamination.

Fast-Track Appeals Pilot Program

The Fast-Track Appeals (FTA) Pilot Program became effective on July 2, 2020.⁴ Under the FTA pilot program, appellants who file an *ex parte* appeal and receive notice from the PTAB that the appeal was docketed can file a petition, along with a petition fee, to expedite review of the appeal. The PTAB set a target of issuing a decision on the *ex parte* appeal within six months from the date the petition is granted and the appeal is entered into the pilot program. This program does not affect any of the appellant's other pending appeals.

Recent data released by the USPTO, about eight months after institution of the program, suggests that the average time to decide a petition is 1.5 days and the average time to a decision on appeal is 1.9 months.⁵ The USPTO has also limited the number of granted petitions to 125 per quarter, with its website tracking both the current number of petitions received and remaining spots in the quarter. Hearings are also available for appellants who utilize the FTA.

Receiving a decision at least twice as fast under the FTA program (appeal decisions typically take 13–15 months) allows appellants to more quickly receive an allowed patent or reconsider patent protection strategy. This is especially attractive to appellants in fast-changing technological industries. However, appellants should keep in mind that a request for oral argument under the FTA does not allow for the appellant to reschedule the hearing. Appellants only have the opportunity to waive the hearing.

Patent owners and applicants with an interest in these PTAB or any of the USPTO's pilot programs should consult with an attorney to discuss program requirements and to confirm whether the program aligns with the applicant's overall intellectual property strategy.

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⁴ <https://www.federalregister.gov/documents/2020/07/02/2020-14244/fast-track-appeals-pilot-program>

⁵ <https://www.uspto.gov/patents/ptab/fast-track-appeals-pilot-program>