

Patent Trial and Appeal Board Boardside Chat: The one-year *ex parte* appeal, Fast-Track Appeals Pilot Program, and What happens after PTAB decides an appeal.

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Agenda

- The one-year *ex parte* appeal
- Fast-Track Appeals Pilot Program
- What happens after PTAB decides an appeal

Question/comment submission

- To send in questions or comments during the webinar, please email:
 - PTABBoardsideChat@uspto.gov

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The one-year *ex parte* appeal

How to get from final action to PTAB decision in one year (or less)

Ex parte appeals pendency goal

- Today's discussion: review the timing of *ex parte* appeals and discuss how an appellant can obtain a quicker decision when desired
- Allow stakeholders to make informed decision on whether to appeal to PTAB, regardless of technology
- 12-month average pendency for decided appeals, regardless of technology
 - Pendency is measured from the date jurisdiction passes to PTAB (i.e., approximately when PTAB receives all briefing, the appeal forwarding fee is paid, and an appeal number is assigned) to the date PTAB issues a decision
 - Pendency does not include the time it takes from Final Action to jurisdiction passing to the PTAB

Final Action-to-PTAB decision in one year

Appellants can increase the likelihood of receiving a PTAB decision on an appeal within one year of final rejection by:

1. Promptly filing during the briefing stage
 - notice of appeal, appeal brief, and reply brief
 - Appellants can do its part to reduce the briefing stage to 6 months or less
2. **Using the PTAB Fast-Track Appeals Pilot Program**
 - provides a decision within 6 months of Fast-Track decision grant
 - current non-Fast-Track appeal decision median time is around 12 months

Thus resulting in a total Final Action-to-PTAB Decision time of:

- with PTAB Fast-Track Appeals Pilot Program: < 12 months
- without PTAB Fast-Track Appeals Pilot Program : < 18 months

The course of an *ex parte* appeal

Document	Who files/issues	PTAB jurisdiction
Final Rejection	Examiner	No
Notice of Appeal	Appellant	No
Appeal Brief	Appellant	No
Examiner's Answer	Examiner	No
Reply Brief	Appellant	No
Decision	PTAB	Yes

- Jurisdiction transfers to PTAB approximately when filing of a (optional) reply brief (or expiration of the time to file a reply brief) and the appeal forwarding fee is paid.
- Other optional actions (e.g., Pre-Appeal Conference Pilot Program) may occur between some filings, before jurisdiction transfers to PTAB.

Appellant controls the briefing duration

Document	Who files/issues
Final Rejection	Examiner
Notice of Appeal	Appellant
Appeal Brief	Appellant
Examiner's Answer*	Examiner
Reply Brief	Appellant
Decision	PTAB

Maximum (months)	Typical (months)
6	4
7	3
4*	2.5*
2	2

Total briefing (months):	
~19	~11.5

* About 95% of Examiner's Answers issue within 4 months after an Appeal Brief filing, with ~2.5 months being the average overall. Neither guarantees the timing of any particular Examiner's Answer.

Total time to decision

Document	Who files/issues
Final Rejection	Examiner
Notice of Appeal	Appellant
Appeal Brief	Appellant
Examiner's Answer*	Examiner
Reply Brief	Appellant
Decision	PTAB

Maximum (months)	Typical (months)
~19	11.5
~24	~12

Total time-to-decision (months):	
~43	~23.5

PTAB Jurisdiction:

Slowest PTAB appeals (<5%):

~24 months

Typical PTAB appeal:

~12 months

The one-year appeal

Document	Typical (months)	Diligent Appellant (months)	Diligent + PTAB Fast-Track
Final Rejection	4	1	1
Notice of Appeal	3	1.5	1.5
Appeal Brief	~2.5	~2.5	~2.5
Examiner's Answer*	2	1	1
Reply Brief	~12	~12	<6
Decision			

Final-to-Decision (months):	~23	~18	<12
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- Where an Appellant would like to conclude an appeal quickly, the time frames for the briefing stage show how such appeals may proceed. It is not appropriate for all appeals.

Planning for *ex parte* appeals

- Diligent Appellant using PTAB Fast-Track Appeals Pilot Program: < 12 months Final Action-to-PTAB Decision
 - Typical time for Final Action-to-PTAB Decision: 23 months
- Appellants largely control duration of briefing stage
 - Typical time is 11 months, which Appellants can do its part to shorten
- The average duration of an appeal after PTAB docketing is approaching 12 months.
 - PTAB Fast-Track Pilot Program goal: issue decision within 6 months

Question/comment submission

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LEAP

- **Designed to:**
 - Aid in development of the next generation of patent practitioners
 - Encourage a diverse group of advocates to develop their skills before the Board
- **To qualify, a patent agent or attorney must have:**
 - Three or fewer substantive oral arguments in any federal tribunal, including PTAB, *and*
 - Seven or fewer years of experience as a licensed attorney or agent

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Fast-Track Appeals Pilot Program

Get your ex parte appeal decided in six months or less

Let's chat

- One-year pilot program to expedite ex parte appeals before the PTAB
- Preliminary results show early success
- Goals: explain the Pilot Program and share our data
- To send in questions or comments during the webinar, please email:
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What is the Fast-Track Appeals Pilot Program?

The basics

- One-year pilot program before the PTAB
- An appellant can request an ex parte appeal to be expedited out of turn by filing:
 - A petition
 - A fee (\$420)
- Pendency goal: PTAB decision within six months

Does my appeal qualify?

- Application type
 - Original utility, design, or plant nonprovisional application
- Status of appeal
 - Pending ex parte appeal (Notice of Appeal filed and Docketing Notice issued)
 - Not limited to “new” appeals (a petition may be submitted for any currently pending appeal)



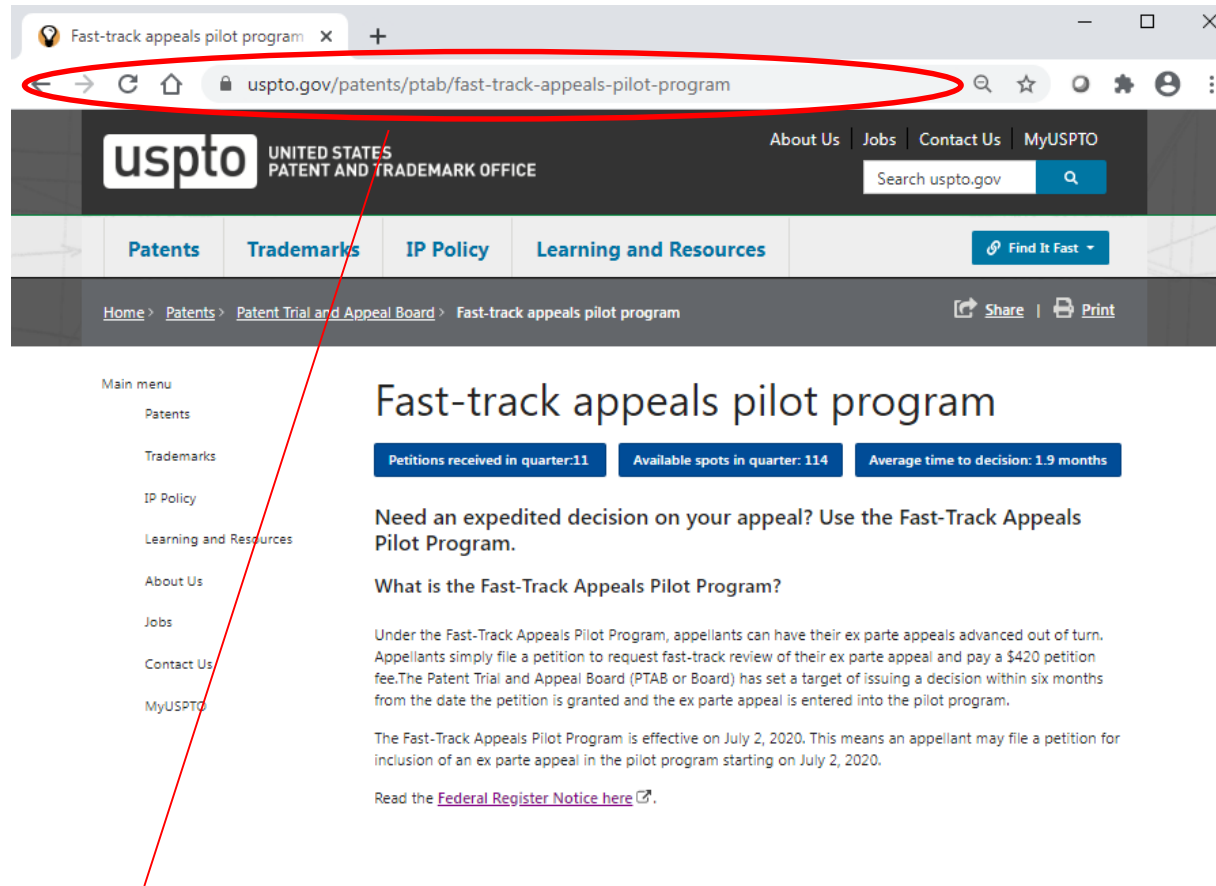
Are there any restrictions?

- The number of granted petitions is limited to 125 per quarter (500 total)
- Hearings permitted, with some caveats
- Not available for applications already treated as special during appeal under MPEP §708.01
 - See MPEP §708.01 (e.g., appeals treated special due to age or health of inventor)

Petition requirements

- **Petition under 37 C.F.R. § 41.3**
 - Form PTO/SB/451 recommended, but not required
 - Identify the application number and appeal number
 - Certify that the ex parte appeal qualifies
- **Petition fee under 37 C.F.R. § 41.20(a)**
 - \$420 (non-refundable)

Fast-track website



www.uspto.gov/patents/ptab/fast-track-appeals-pilot-program



Petition form

Doc Code: PET. 41.3
Document Description: Petition under Rule 41.3 to Chief Admin Patent Judge PTO/SB/451 (07-20)

PETITION Fast-Track Appeals Pilot Program			
PART I. IDENTIFICATION OF THE APPEAL TO ACCORD FAST-TRACK STATUS			
Appeal No.:		Application Number:	
First Named Inventor:		Filing Date:	
Title of Invention:			
PART II. CERTIFICATIONS: Appellant hereby certifies the following and petitions to participate in the Fast-Track Appeals Pilot Program for the above-identified appeal.			
1. Appellant files this certification and petition under 37 CFR 41.3 to include the appeal in the application identified in Part I (above) in the Fast-Track Appeals Pilot Program.			
2. The above-identified appeal is pending before the Patent Trial and Appeal Board (PTAB) and a docketing notice has been issued.			
3. The petition fee for filing a petition under 37 CFR 41.3 accompanies this petition.			
4. The above-identified appeal is currently not treated as special under MPEP 708.01 (e.g., age or health of the inventor).			
5. The registered practitioner submitting this certification and petition has a power of attorney (37 CFR 1.32), or has authority to act (37 CFR 1.34), for the above-identified application, or the appellant is prosecuting the appellant's own case (37 CFR 1.31).			
PART III. ORAL HEARING: For informational purposes, please indicate whether Appellant has filed a compliant Request for Oral Hearing per 37 CFR 41.47 for the above-identified appeal:			
Yes <input type="checkbox"/> No <input type="checkbox"/>			
<input type="checkbox"/> If yes, Appellant hereby waives the Oral Hearing. (Appellant is not required to waive an Oral Hearing to participate in the Fast-Track Patent Appeal Pilot.)			
Signature		Date	
Name (Print/Typed)		Practitioner Registration Number	
<small>Note: This form must be signed in accordance with 37 CFR 1.33 and consistent with Certification 5 above. See 37 CFR 1.4(d) for signature requirements and certifications. Submit multiple forms if more than one signature is required.* *Total of _____ forms are submitted.</small>			

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Fast-track appeals pilot program

Patents received in quarter: 11 Available spots in quarter: 114 Average time to decision: 1.9 months

Need an expedited decision on your appeal? Use the Fast-Track Appeals Pilot Program.

What is the Fast-Track Appeals Pilot Program?

Under the Fast-Track Appeals Pilot Program, appellants can have their ex parte appeals advanced out of turn. Appellants simply file a petition to request fast-track review of their ex parte appeal and pay a \$420 petition fee. The Patent Trial and Appeal Board (PTAB or Board) has set a target of issuing a decision within six months from the date the petition is granted and the ex parte appeal is entered into the pilot program.

The Fast-Track Appeals Pilot Program is effective on July 2, 2020. This means an appellant may file a petition for inclusion of an ex parte appeal in the pilot program starting on July 2, 2020.

Read the [Federal Register Notice here](#).

Eligibility requirements

To qualify for fast-track status, the following four conditions must be met:

- **Application type:** The application must be an original utility, design, or plant nonprovisional application.
- **Status of appeal:** The appeal for fast-track status must be an ex parte appeal for which a notice of appeal has been filed and a PTAB docketing notice has been issued by the USPTO (i.e., the appeal is pending before the PTAB).
- **Petition:** The appellant must file a petition under 37 CFR 41.3 via the [USPTO's electronic filing system](#) identifying the application and appeal by application number and appeal number, respectively, for which fast-track review is sought.
 - o Form: [Petition—Fast-Track Appeals Pilot Program \(Form PTO/SB/451\)](#)
- **Fee:** The appellant must pay a \$420 fee under 37 CFR 41.206. [USPTO Fee Schedule](#)

Time to decision

The Board has set a target of issuing a decision within six months from the date that a petition for fast-track review is granted. Since the program's inception in July 2020 through December 30, 2020, PTAB has decided 69 fast-track appeals with an average decision time of about 2 months from the date the petition for fast-track review was granted, and about 6 months from the date PTAB received the appeal. Thus, the overall decision time is at least 50% faster than the average appeal time for cases not under fast-track review, which currently stands at about 13 months at the end of calendar year 2020.

Granted petition limits

The USPTO has limited the number of granted petitions to 125 per quarter for the duration of the Fast-Track Appeals Pilot Program, which is expected to run for one year.

The table shows the status of the number of granted petitions per quarter and total for the pilot duration, as well as open slots available during each time period. A "quarter" under this pilot program is defined as a three-month period measured from the start date of the pilot program. For example, if the pilot program has a start

Form-fillable pdf also available at: www.uspto.gov/patents/apply/forms/forms-patent-applications-filed-or-after-september-16-2012



Filing the petition

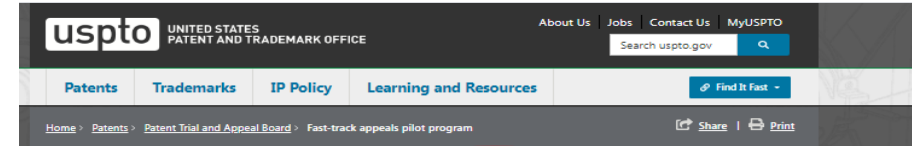
- Submit by EFS-Web, Patent Center, or Postal Service
 - Electronic submission is preferred
- Petitioner notified of grant or denial
 - Denials have been due to lack of PTAB jurisdiction
- May petition again if denied, but will not get the filing date of a denied petition

Granted petition limits

- 125 granted petitions per quarter and 500 total in the one-year pilot
 - Quarter 1—July 2020 through September 2020
 - Quarter 2—October 2020 through December 2020
- PTAB may exercise discretion to grant a small number of additional petitions per quarter
 - Additional petitions may be held in abeyance and considered in the following quarter in order of receipt

Check our website for petition limit updates

- The pilot program website is regularly updated with current information on quarterly limits



Petitions received in quarter: 11
Available spots in quarter: 114
Average time to decision: 1.9 months

	As of date	Petitions received in quarter	Petitions granted in quarter	Available petition slots in quarter	Petitions held in abeyance	Total granted petitions
Q3 (starting 1/1/2021)	1/22/2021	11	11	114	0	110

Fast-track appeals pilot program

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- Petition:** The appellant must file a petition under 37 CFR 41.3 via the [USPTO's electronic filing system](#) identifying the application and appeal by application number and appeal number, respectively, for which fast-track review is sought.
 - Form: Petition—Fast-Track Appeals Pilot Program ([Form PTO/SB/451](#))
- Fee:** The appellant must pay a \$420 fee under 37 CFR 41.20(a) with the petition.
 - [USPTO Fee Schedule](#)

Time to decision

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Q3 (starting 1/1/2021)	1/22/2021	11	11	114	0	110

Hearings

- Appellant with a fast-tracked ex parte appeal may request oral argument before a PTAB panel
 - PTAB will make best efforts to accommodate time/location preferences
 - But, hearing may be scheduled in any available hearing room in any office location or by telephone
- **Appellant cannot reschedule hearings and remain in the Pilot Program**
 - May opt out of the Pilot Program and reschedule hearing
 - May request video/telephone if office location is inconvenient
 - May waive hearing and continue on fast-track
- **Currently, all hearings for ex parte appeals are telephonic by default.**
 - www.uspto.gov/coronavirus



How are we doing?

Petitions received per quarter

- Quarter 1
 - July 2020 through September 2020
- Quarter 2
 - October 2020 through December 2020
- Quarter 3
 - January 2021 through March 2021 (as of January 22, 2021)

Petitions Received in First Quarter	Granted Petitions	Granted Petitions (Heard appeals)	Denied Petitions
62	59	21	3
Petitions Received in Second Quarter	Granted Petitions	Granted Petitions (Heard appeals)	Denied Petitions
42	40	9	2
Petitions Received in Third Quarter	Granted Petitions	Granted Petitions (Heard appeals)	Denied Petitions
11	11	4	0

Petition decision statistics

(Program Q1 and Q2: July 2, 2020–December 31, 2020)

- Total petitions filed: 104
 - Average time to decide: 1.6 days
- Total petitions granted: 99
 - 5 petitions denied because the applications were not within PTAB jurisdiction
- Number of appeals decided: 69 (so far)
- Average time for decision on appeal: 1.9 months

How fast is fast-track?

- Must faster than usual
 - Target of six months
 - Faster than the approximately 13-month average time to decide appeals overall
 - See PTAB statistics, www.uspto.gov/patents/ptab/statistics

Issued decision statistics

- At the end of the second quarter, 69 fast-tracked ex parte appeals have been decided
 - Out of 99 petitions for fast-track status granted
 - Included 19 oral hearings
 - 30 fast-tracked ex parte appeals are pending

Technology center statistics

(Program Q1 & Q2: July 2, 2020–December 31, 2020)

TC	# Petitions Filed
1600	17
1700	7
2100	10
2400	9
2600	16
2800	11
3600	22
3700	12

- TC 1600: Biotechnology and Organic Chemistry
- TC 2600: Communications
- TC 3600: Transportation, Construction, Electronic Commerce, Agriculture, National Security and License and Review

Take-away thoughts

- **The pilot program is working as intended**
 - PTAB is handling the pilot program well, with no negative impact on ex parte appeal pendency rates overall, while still providing decisions on ex parte appeals within six months, when requested through the pilot
- **Evaluation of the pilot program**
 - Will occur after the conclusion of the one-year period or when a 500-appeal threshold is met, whichever occurs first, to determine next steps

Give us feedback

- Contact information:
 - Phone 571-272-9797
 - Email: fasttrackappeals@uspto.gov

Further information

- Federal Register notice:
 - www.federalregister.gov/documents/2020/07/02/2020-14244/fast-track-appeals-pilot-program
- Frequently asked questions:
 - www.uspto.gov/patents/ptab/fast-track-appeals-pilot-program

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USPTO PTAB website – statistics

Appeals

Decisions

Hearings

Resources and guidance

Statistics

PTAB dashboard

PTAB data tools and IT systems

PTAB events

[New to PTAB](#)

About PTAB

PTAB help

Patent Trial and Appeal Board (PTAB) performance benchmarks for dispositions, pendency, inventory, and other tracking measures.

Under Construction: PTAB is migrating to a new statistics format for AIA trials. We are moving all of our outcome statistics into a new quarterly "Outcome Roundup" format that includes outcome information on a by-petition, by-patent, and by-claim basis. We will continue publishing non-outcome trial statistics on a monthly basis. In addition, we now provide end of year outcome statistics for fiscal year 2019 for AIA trials below, and expect to provide the same for fiscal year 2020 soon.

Trial statistics

Current fiscal year (FY) statistics to date:

- [FY21 Q1 Outcome Roundup](#) (coming soon)
- [November 2020](#)
- [October 2020](#)

Prior fiscal year statistics:

- [FY20 End of Year Outcome Roundup](#)
 - [Appendix](#)
- [FY19 End of Year Outcome Roundup](#)
 - [Appendix](#)

[Trial statistics archive](#)

Appeal and interference statistics

Current fiscal year (FY) statistics to date:

- [December 2020](#)
- [November 2020](#)
- [October 2020](#)

[Appeal and interference statistics archive](#)

[PTAB dashboards](#)

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What happens after PTAB decides an appeal?

Methodology

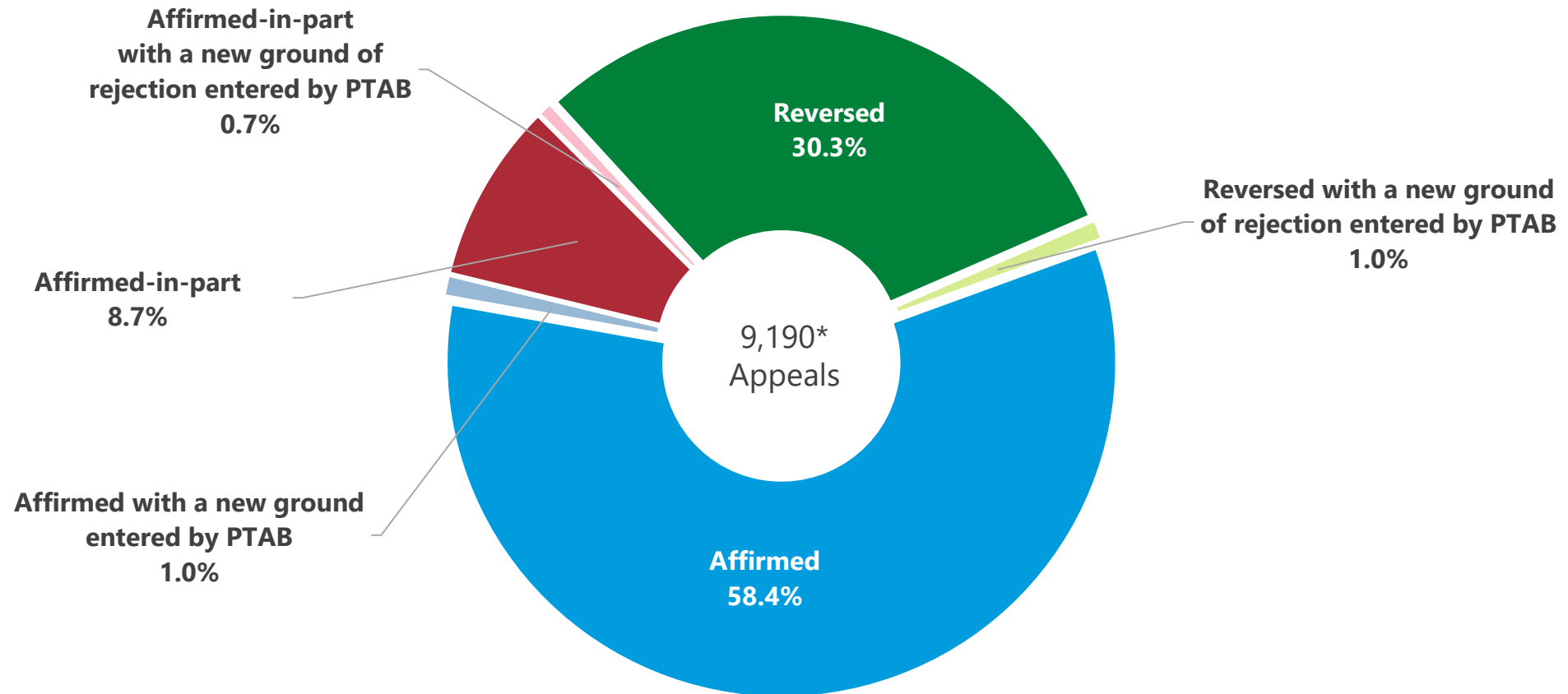
- Started with ~9,224 applications that received a PTAB decision on appeal in FY 2019
- Identified the next substantive event in application's file history
 - Excluded reexaminations and applications with only ministerial actions.
- For remaining ~9,190 applications, classified next substantive event (other than a request for rehearing) into one of four broad categories:
 - "Allowed": Notice of Allowance issued
 - "Prosecution": usually Applicant filed Request for Continued Examination with claim amendment
 - Does not include the filing of a continuation, divisional, or continuation-in-part application
 - "Abandoned": usually Notice of Abandonment issued
 - "CAFC": appealed to Court of Appeals for the Federal Circuit

Outcome Terminology—An Example to Explain

- Example: Assume an application only has claims 1-4, and each is rejected by the Examiner as obvious under 35 U.S.C. § 103.

Outcome of Appeal	Claims still rejected under 35 U.S.C. § 103	Claims newly rejected under 35 U.S.C. § 112
Affirmed	1-4	
Affirmed-in-Part	1-3 only	
Reversed	None	
Affirmed with new ground of rejection by PTAB	1-4, under a new theory	
Reversed with new ground of rejection by PTAB	None	1-4

Outcomes of decisions on appeal issued by PTAB in FY 2019 (Oct. 1, 2018 – Sept. 30, 2019)



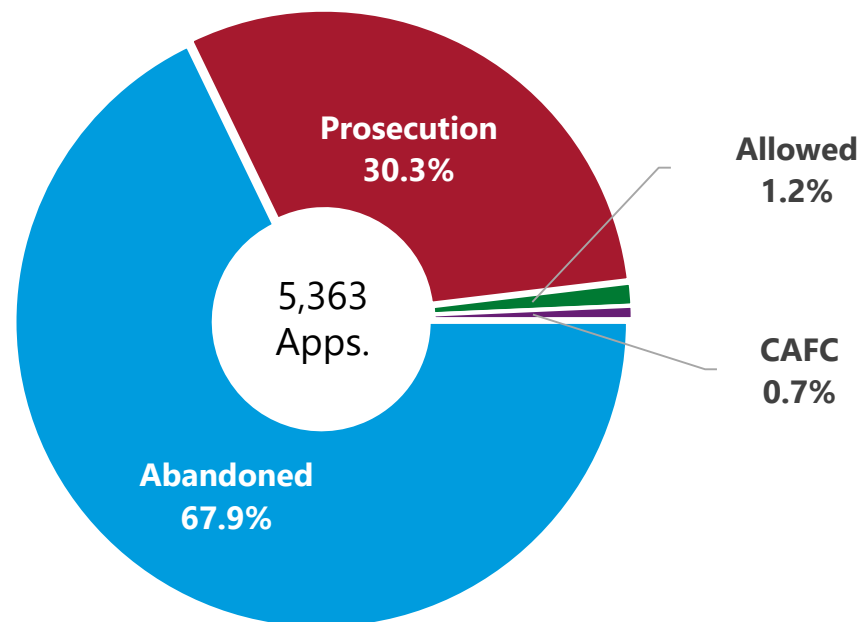
*Excludes reexaminations and applications with no meaningful post-appeal event



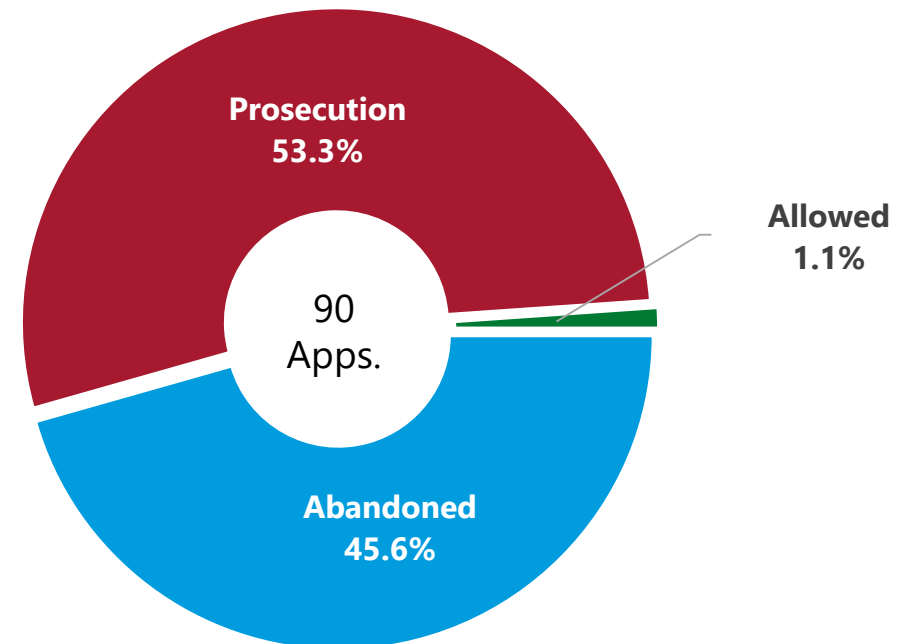
What happens in the application after the rejection of the claims is affirmed?

(Oct. 1, 2018 – Sept. 30, 2019)

Affirmed without a new ground of rejection entered by PTAB



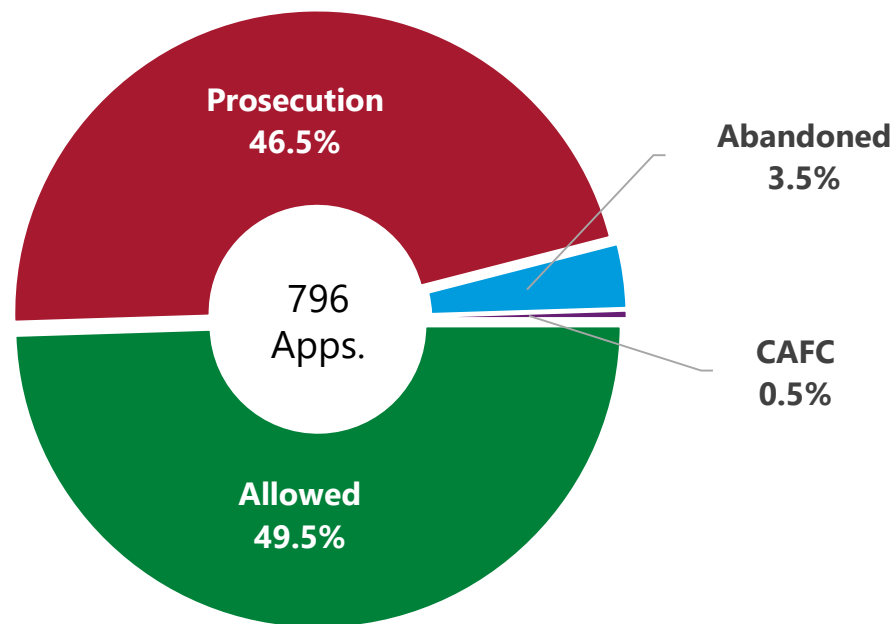
Affirmed with a new ground of rejection entered by PTAB



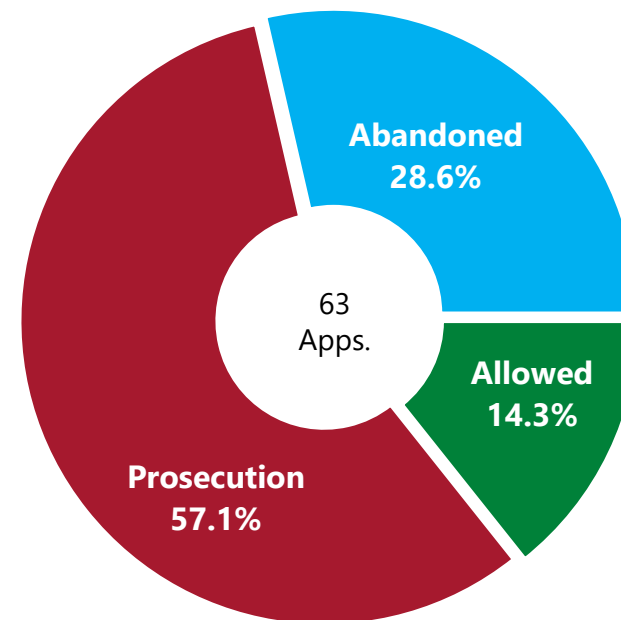
What happens in the application after the rejection of the claims is affirmed-in-part?

(Oct. 1, 2018 – Sept. 30, 2019)

Affirmed-in-part without a new ground of rejection entered by PTAB



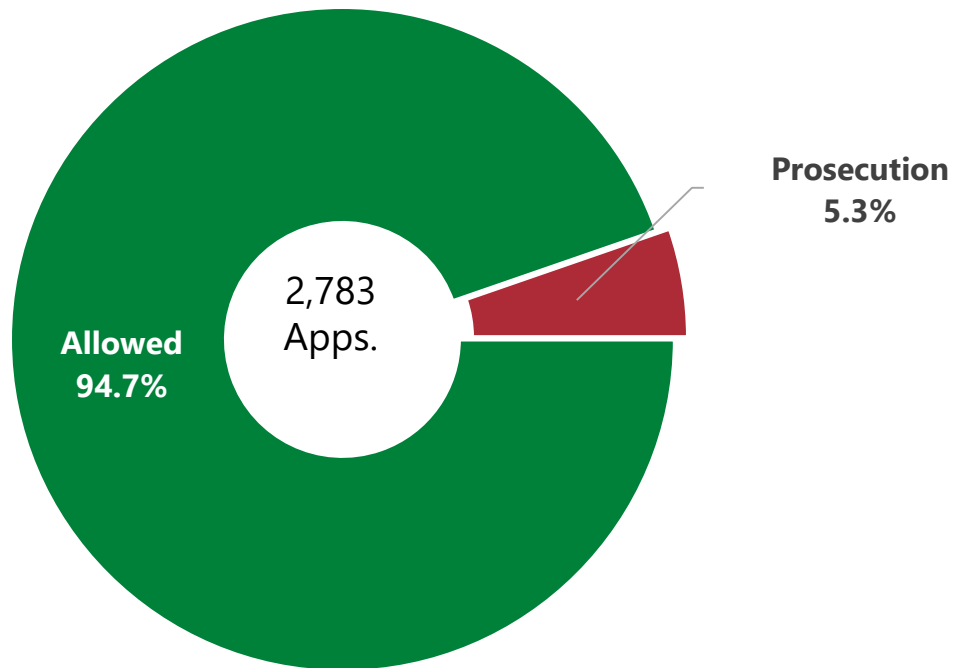
Affirmed-in-part with a new ground of rejection entered by PTAB



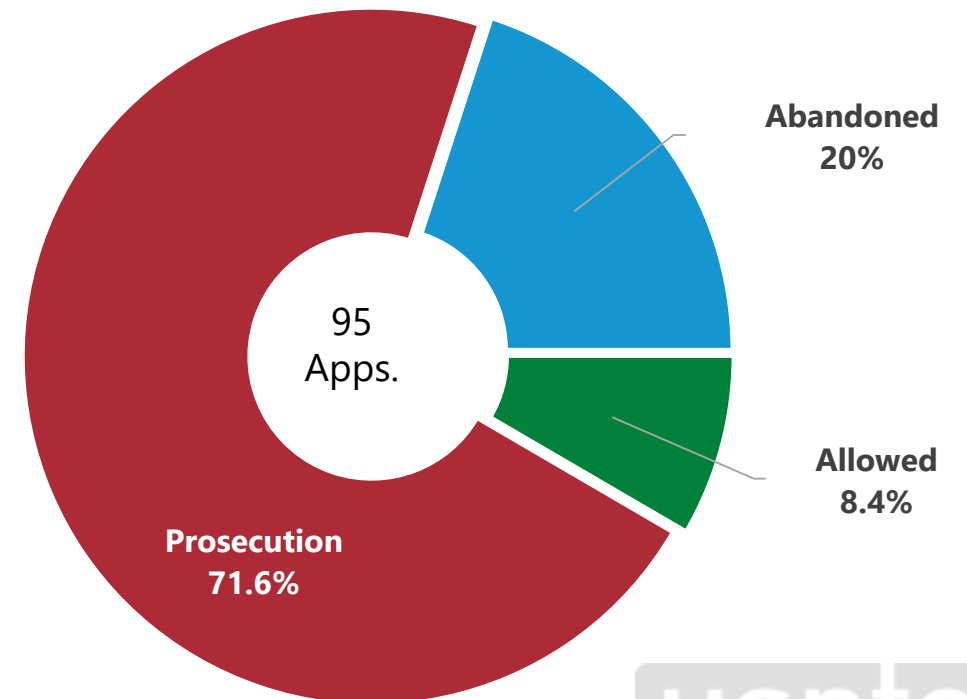
What happens in the application after the rejection of the claims is reversed?

(Oct. 1, 2018 – Sept. 30, 2019)

Reversed without a new ground of rejection entered by PTAB



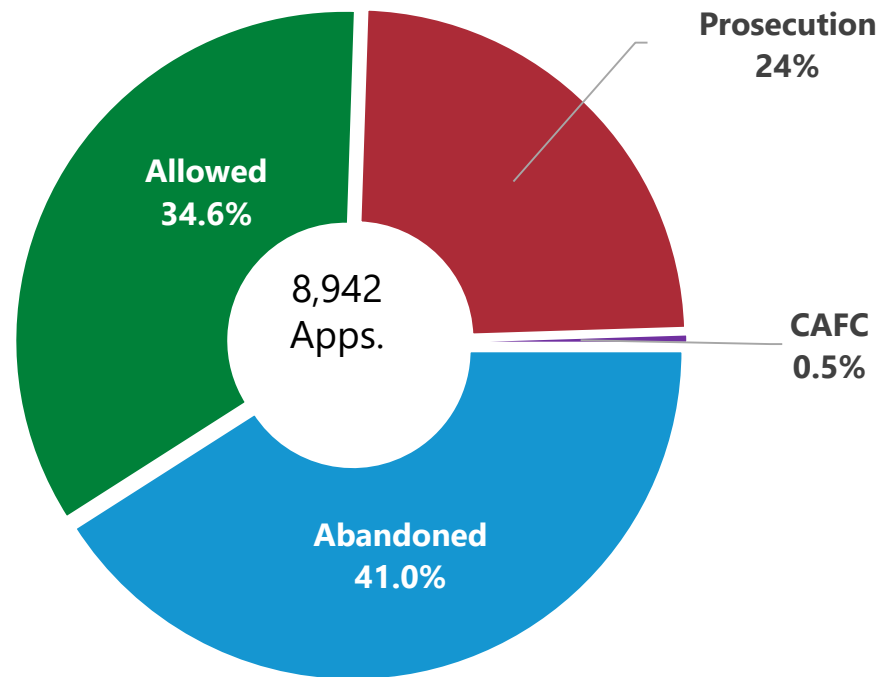
Reversed with a new ground of rejection entered by PTAB



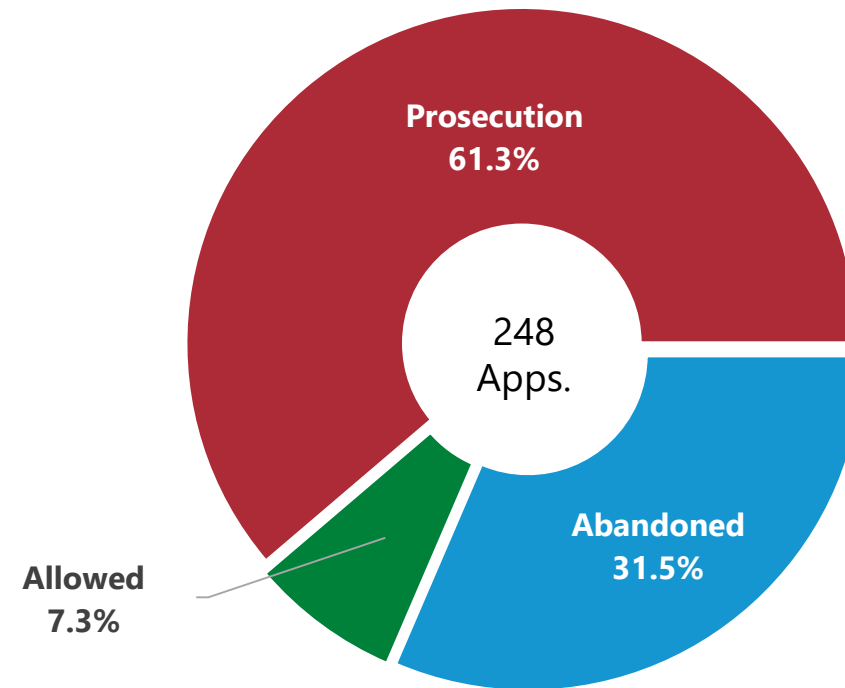
What happens in the application when a new ground of rejection is or is not entered by PTAB?

(Oct. 1, 2018 – Sept. 30, 2019)

New ground of rejection not entered by PTAB



New ground of rejection is entered by PTAB



Takeaways

- Typical outcomes:
 - Affirmed mostly led to abandonment, with most of the remainder of applications seeing further prosecution
 - Affirmed-in-part led to a nearly 50/50 between allowance and prosecution, with a small portion of applications being abandoned
 - Reversed led almost entirely to allowances, with a small portion of applications seeing further prosecution
- New grounds of rejection had a significant impact on post-appeal outcomes, for all types of PTAB decisions—generally, a much greater portion of applications saw further prosecution (over 50% for each type of decision)

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