



Patent Trial and Appeal Board Motion to Amend Study

Update through May 31, 2017

UNITED STATES
PATENT AND TRADEMARK OFFICE



Motion to Amend Study: Installment 2 (Update Through End of FY 2017)

In April 2016, after having completed more than 1,500 trials in more than three-and-one-half years of America Invents Act (“AIA”) trials,¹ the Board 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 of each motion to amend; (3) the number of motions to amend requesting to substitute claims that were granted, granted-in-part and denied-in-part, and denied; and (4) the reasons the Board provided for denying entry of substitute claims. The Motion to Amend Study and data supporting the study are available on the Board’s website. See Motion to Amend Study (April 30, 2016), <https://go.usa.gov/xXXyT>; Data for Completed Trials with a Motion to Amend, <https://go.usa.gov/xXXyZ> (last visited Mar. 28, 2017).

The Board has continued to collect data on motions to amend and provides an update to the Motion to Amend Study through May 31, 2017, in the graphs and table below.

¹ Trials are counted as “completed” when they are terminated due to settlement, request for adverse judgment, dismissal, or final written decision. Further, as explained in the Motion to Amend Study, joined or consolidated trials were counted as a single trial for purposes of the motion to amend statistics.

Graph I is a pie chart that shows the cumulative number of motions to amend that have been filed in AIA trials, both completed and pending, through May 31, 2017. Patent owners have filed a motion to amend in 254 of the 2,531 completed trials (10%), and in 44 of the 667 pending trials (7%)—a total of 298 motions to amend.

Graph II is a pie chart that depicts the subsequent developments of the motions to amend, focusing on the outcomes of the 254 completed trials in which a patent owner filed a motion to amend. The Board decided a motion to amend requesting to substitute claims in 158 of the 254 completed trials (62%). In the remaining 96 completed trials (38%), the motion to amend: (a) requested solely to cancel claims (17 or 7%), (b) was rendered moot because the panel of judges found the original claims patentable (24 or 9%), or (c) was not decided because the case terminated prior to a final written decision (55 or 22%).

Graph III is a pie chart that depicts the outcomes of the 158 motions to amend requesting to substitute claims that the Board decided, i.e., the number of motions to amend requesting to substitute claims that the Board granted, granted-in-part and denied-in-part, or denied. The Board granted or granted-in-part and denied-in-part a motion to amend in 12 of the 158 trials (8%) and denied a motion to amend in 146 of the 158 trials (92%).

Table I follows Graph III and focuses on the reasons provided for denying entry of substitute claims in the 154 trials in which the Board denied or denied-in-part a motion to amend. The Board's final written decisions provided at least one statutory reason for denying or denying-in-part a motion to amend in 132 of the 154 trials (86%). Using conventional prosecution as a comparison, the Board's decisions in those cases are akin to an examiner

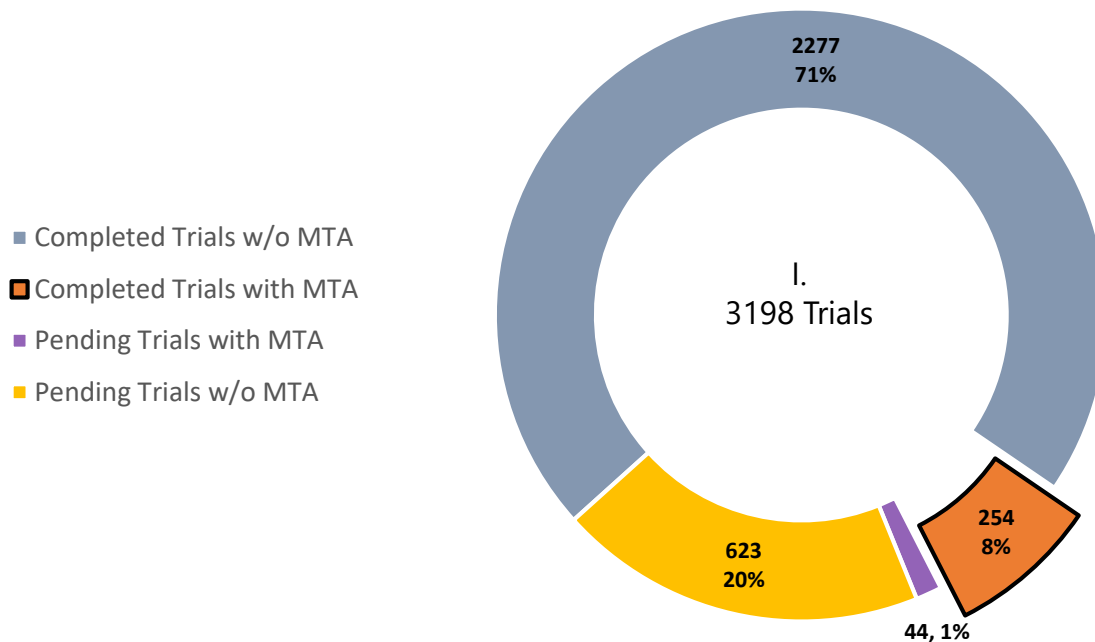
rejecting a proposed amended claim because it is anticipated, obvious, not adequately described in the written description, indefinite, or directed to non-statutory subject matter. In the remaining 22 (14%) trials, the Board based a denial solely on procedural reasons related to the requirements for a motion to amend.²

Graph IV follows Table I and shows the total number of motions to amend filed in a given fiscal year.

² Those 22 trials are the same 22 trials identified as procedural denials in the April 2016 Motion to Amend Study.

Graph I: Number of Motion to Amend Filings

How Many Motions to Amend Are Filed?

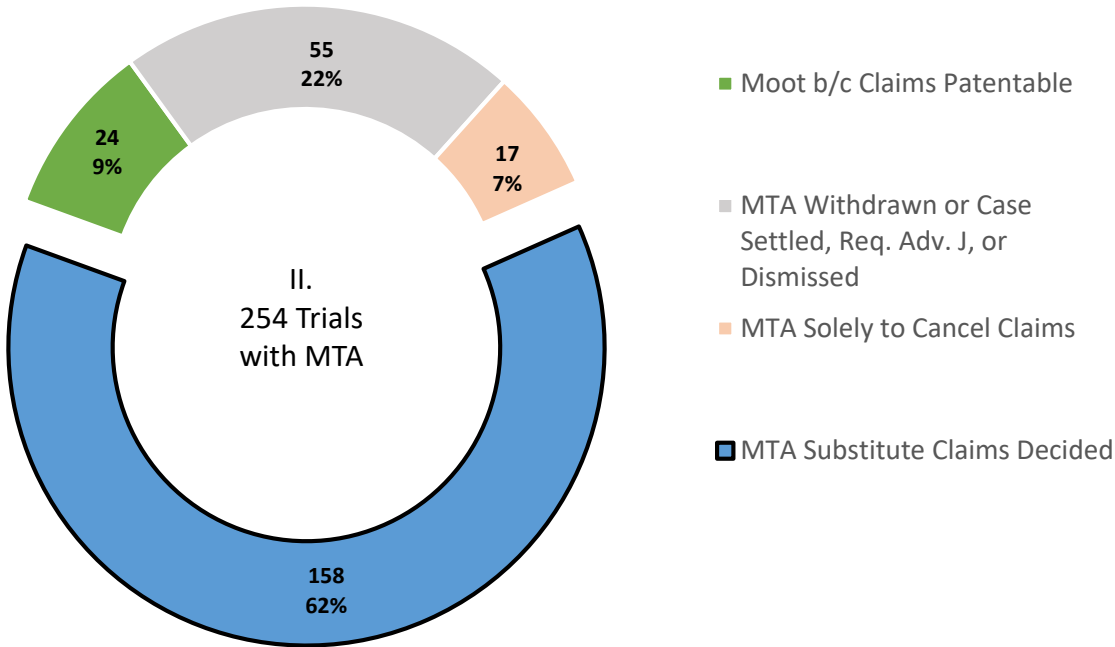


Data current as of: 5/31/2017



Graph II: Subsequent Developments of Motions to Amend

Subsequent Developments of the Motions to Amend

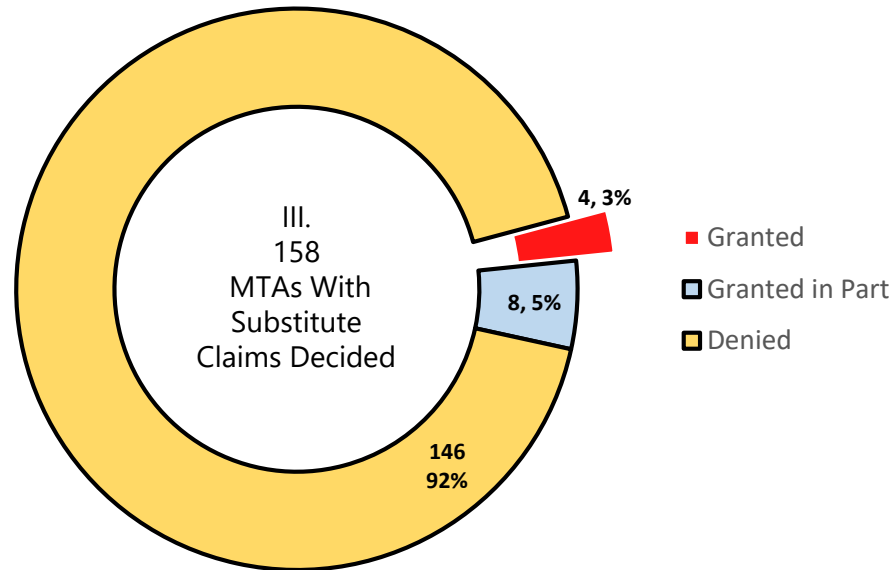


Data current as of: 5/31/2017



Graph III: Disposition of Motions to Amend

How Many Motions to Amend Substituting Claims Are Granted?



Data current as of: 5/31/2017

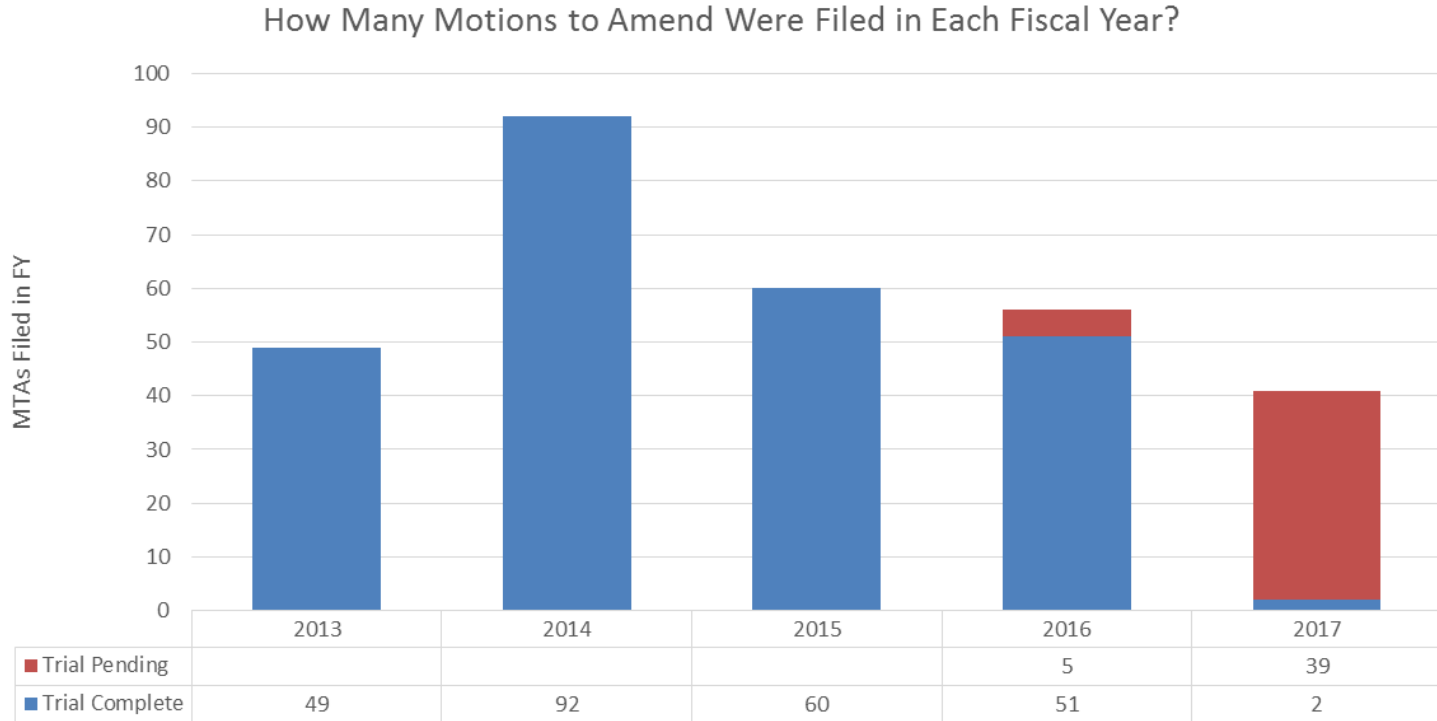
Table I: Reason for Denial of Motions to Amend

	Reason for Denying Entry	# of Motions	% of Motions
§102/103	Anticipated or Obvious Over Art of Record	62	40%
§§102/103/ 112/316	Multiple Statutory Reasons *All included at least 102, 103, and/or 112 as a reason for denial	35	23%
§101	Non-Statutory Subject Matter	9	6%
§112	Written Description	10	6%
§112	Enablement	3	2%
§112	Definiteness	1	1%
§316	Claims Enlarge Scope of Patent	9	6%
§316	Unreasonable Number of Substitute Claims	3	2%
	Procedural Reasons	22	14%
	<i>Total Motions to Amend Denied (in whole or in part)</i>	154	100%



Data current as of: 5/31/2017

Graph IV: Motion to Amend Filings Per Fiscal Year



* Data for FY2017 are from October 1, 2016–May 31, 2017.

