

PTAB Strategies and Insights

March 2019



VISIT WEBSITE

CONTACT US

SUBSCRIBE

FORWARD TO A FRIEND

The *PTAB Strategies and Insights* newsletter provides timely updates and insights into how best to handle proceedings at the USPTO. It is designed to increase return on investment for all stakeholders looking at the entire patent life cycle in a global portfolio.

This month, we cover three topics:

- First, we direct your attention to the first decision out of the PTAB's newly formed Precedential Opinion Panel (POP), addressing the question of whether petitioners can join their own petitions.
- Second, the USPTO launched a pilot program on March 15th that implements significant changes to motion to amend practice in PTAB trials.
- In addition, in case you missed it last month, we direct your attention to the publication of our annual review of the top cases to reach the Federal Circuit from the PTAB. This is the third annual report on appeals from the PTAB to the Federal Circuit. A PDF of the full report can be downloaded from the Sterne, Kessler, Goldstein & Fox website.

We will return to decisions coming from the POP and we will tie together guidance regarding motions to amend practice in the coming months.

We welcome feedback and suggestions about this newsletter to ensure we are meeting the needs and expectations of our readers. So if you have topics you wish to see explored within an issue of the newsletter, please reach out to me.

To view our past issues, as well as other firm newsletters, please click [here](#).

Thank you.

Best regards,
Jason

Editor & Author:

Authors:

IN THIS ISSUE

PTAB Precedent Opinion Panel Clarifies Standard for Joinder of Parties and Issues

USPTO Announces Sweeping Changes to Motion to Amend Procedures in AIA Trials via Pilot Program

2019 Report: Federal Circuit Appeals from the PTAB - Summaries of Key 2018 Decisions

[DOWNLOAD](#)



Jason D. Eisenberg

Director

jasone@sternekessler.com



Pauline Pelletier

Director

ppelletier@sternekessler.com



Michael Specht

Director

mspecht@sternekessler.com



Graham Phero

Counsel

gphero@sternekessler.com

PTAB PRECEDENT OPINION PANEL CLARIFIES STANDARD FOR JOINDER OF PARTIES AND ISSUES

By: [Pauline M. Pelletier](#)

On March 13, 2018, the U.S. Patent and Trademark Office Patent Trial and Appeal Board (PTAB)'s Precedential Opinion Panel (POP), consisting of Director Andrei Iancu, Commissioner of Patents Drew Hirshfeld, and newly appointed Chief Administrative Patent Judge Scott Boalick, denied petitioner Proppant Express's motion for joinder.

[Read More](#)



USPTO ANNOUNCES SWEEPING CHANGES TO MOTION TO AMEND PROCEDURES IN AIA TRIALS VIA PILOT PROGRAM

By: [Graham C. Phero](#) and [Michael D. Specht](#)

On March 15, 2019, the United States Patent and Trademark Office (USPTO) launched a pilot program that implements significant changes to motion to amend practice in AIA trials. The Office states that its goal in proposing these changes is to "provide an improved amendment practice in AIA trials in a manner that is fair and balanced for all parties and stakeholders."

[Read More](#)

2019 REPORT: FEDERAL CIRCUIT APPEALS FROM THE PTAB - SUMMARIES OF KEY 2018 DECISIONS

In 2018, the U.S. Court of Appeals for the Federal Circuit docketed close to 600 appeals from the U.S. Patent and Trademark Office (USPTO). That is the second highest

number since starting to hear post-American Invents Act (AIA) cases in 2014, and cases from the USPTO remain the largest contributor to the Federal Circuit's docket. Despite the volume, average appeal pendency appears to have stabilized in 2018 at around 15 to 16 months.

[Read More](#)

FEDERAL CIRCUIT APPEALS FROM THE PTAB



 **Sterne Kessler**
STERNE KESSLER GOLDSTEIN & FOX

The information contained in this newsletter is intended to convey general information only, and should not be construed as a legal opinion or as legal advice. Sterne, Kessler, Goldstein & Fox P.L.L.C. disclaims liability for any errors or omissions, and information in this newsletter is not guaranteed to be complete, accurate, and updated. Please consult your own lawyer regarding any specific legal questions.

© 2019 Sterne, Kessler, Goldstein & Fox P.L.L.C

[Click Here](#) to opt-out of this communication

Technical Minds. Legal Muscle.