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THE MIXED CASE FOR A PTAB OFF-RAMP

SAURABH VISHNUBHAKAT*

This Essay begins from the emerging agenda in the political branches for reforming various aspects of the USPTO Patent Trial and Appeal Board, and focuses on a particular reform: the creation of a PTAB off-ramp whereby a patent being challenged in an administrative revocation proceeding could be removed into a system primarily aimed at amending its claims and preserving its validity. To put the proposal into perspective, the Essay presents specific empirical trends, largely unexplored until now, that implicate patent reliance interests to which the PTAB has done injury. Ultimately, because the benefits and costs from a PTAB off-ramp are mixed, it should not come at the political expense of other more basic or feasible reforms.

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INTRODUCTION

It has now been six years since the PTAB began conducting adversarial revocation proceedings under the America Invents Act (“AIA”).¹ In that time, the PTAB has gone through three important developments that now suggest the time is right for reevaluation and potential reform. First and most importantly, the PTAB’s intake of over 9,000 cases has produced a rich source of data to test many of the empirical assumptions and predictions that motivated the creation of PTAB review.² Along the way, major structural choices by the Patent Office in implementing PTAB review have also undergone judicial scrutiny in the Federal Circuit and the Supreme Court, over a long enough time period to allow learning and retrenchment by the courts.³ Most recently, changeovers in leadership have also begun to effect reversals in the Patent Office’s own policy regarding the PTAB.⁴

Political developments confirm the appetite for reform. From within the agency, a rule issued last autumn⁵ to change the PTAB’s standard for claim construction away from the broadest-reasonable-interpretation approach to the district courts’ *Phillips* approach, which a number of scholars have urged as a superior alternative.⁶ This policy reversal is particularly notable because the Supreme Court in *Cuozzo Speed Technologies, LLC. v. Lee* specifically

1. Leahy–Smith America Invents Act, Pub. L. No. 112-29 (2011).

2. The empirical literature on the PTAB is significant and growing. *See, e.g.*, Saurabh Vishnubhakat et al., *Strategic Decision Making in Dual PTAB and District Court Proceedings*, 31 BERKELEY TECH. L.J. 45 (2016); Jarrad Wood & Jonathan Stroud, *Three Hundred Nos: An Empirical Analysis of the First 300+ Denials of Institution for Inter Partes and Covered Business Method Patent Reviews Prior to In Re Cuozzo Speed Technologies, LLC*, 14 J. MARSHALL REV. INTELL. PROP. L. 112 (2015); Brian J. Love & Shawn Ambwani, *Inter Partes Review: An Early Look at the Numbers*, 81 U. CHI. L. REV. DIALOGUE 93 (2014); Saurabh Vishnubhakat, *Renewed Efficiency in Administrative Patent Revocation*, 104 IOWA L. REV. (forthcoming 2019); Brian J. Love et al., *Determinants of Patent Quality: Evidence from Inter Partes Review Proceedings*, 90 U. COLO. L. REV. 67 (2019).

3. *See, e.g.*, Saurabh Vishnubhakat, *Disguised Patent Policymaking*, 76 WASH. & LEE L. REV. (forthcoming 2019) (discussing the initially permissive and subsequently restrictive arc of Federal Circuit and Supreme Court responses to the Patent Office view of its own nonappealable discretion).

4. Andrei Iancu, Director, U.S. Patent & Trademark Office, *The Role of U.S. Patent Policy in Domestic Innovation and Potential Impacts on Investment*, Address before U.S. Chamber of Commerce Patent Policy Conference (Apr. 11, 2018) (transcript available at perma.cc/6Y2E-VTV) (discussing patent-eligible subject matter and administrative revocation as agency priorities for reevaluation).

5. *See* Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51340 (Oct. 11, 2018).

6. *E.g.*, Letter from John R. Allison, et al., *Response to the Proposed “Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial Appeal Board”*, 3 Fed. Reg. 21221 (May 9, 2018), to USPTO (July 9, 2018), available at <https://www.ssrn.com/abstract=3211380> (citing Vishnubhakat, et al., *supra* note 2). *See also* Michael Risch, *The Failure of Public Notice in Patent Prosecution*, 21 HARV. J.L. & TECH. 179, 192–204 (2007) (criticizing the broadest-reasonable-interpretation standard even in initial patent examination).

held that the Patent Office's then-governing BRI approach was a reasonable exercise of the agency's discretion under the *Chevron* framework.⁷

From Congress, meanwhile, proposals have emerged that take specific aim at various aspects of the PTAB. For example, the STRONGER Patents Act, introduced last year in the Senate, and again this year in the House, would, among other things, create the same presumption of validity in PTAB review as there is in district court litigation, require clear and convincing evidence to rebut it, create a standing requirement for *inter partes* review, and substantially scale back the nonappealability of initial PTAB decisions whether to institute review.⁸ This year's Hatch-Waxman Integrity Act would limit the use of the PTAB against patents listed in the FDA Orange Book, primarily by forcing a choice between district court litigation under the Hatch-Waxman Act or the Biologics Price Competition and Innovation Act on one hand, and PTAB review on the other hand.⁹

This Essay examines a proposal in the same vein of PTAB reform which has received less widespread attention so far. That proposal is to create an off-ramp from the PTAB. A patent could be removed from the administrative trial setting, such as an *inter partes* review, and placed into a more examination-like setting whose primary purpose would be to correct defects in the patent rather than invalidate it altogether. A specific form of the off-ramp proposal was sketched out by leading patent attorney John White in late 2016.¹⁰ A discretionary form of the idea appears in the STRONGER Patents Act.¹¹ And in its most recent round of PTAB Annual Judicial Conferences and a subsequent request for comments in the Federal Register, the Patent Office also signaled its interest more generally in some form of an off-ramp from the administrative litigation setting and sought public input on it.¹²

7. *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–45 (2016).

8. Support Technology & Research for Our Nation's Growth and Economic Resilience Patents Act, H.R. 5340, 115th Cong. (2018); S. 1390, 115th Cong. § 102 (2017).

9. Hatch-Waxman Integrity Act, H.R. 990, 116th Cong. (2019); S. 344, 116th Cong. § 2 (2019).

10. John White, *Curing the PTAB: How 3 Fixes Will Make a Better, Fairer Process*, IPWATCHDOG (Dec. 20, 2016), perma.cc/93KB-JUCZ.

11. Support Technology & Research for Our Nation's Growth and Economic Resilience Patents Act, H.R. 5340, 115th Cong. (2018); S. 1390, 115th Cong. § 102(i)(1) (2017). (providing for an expedited patentability report in the discretion of the PTAB).

12. U.S. PATENT & TRADEMARK OFFICE, SHARING INSIGHTS: FROM BENCH TO BAR AND BAR TO BENCH 166–67, PTAB Annual Judicial Conferences (June 28–July 31, 2018), perma.cc/N8R3-Q5DU; Request for Comments on Motion To Amend Practice and Procedures in Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board, 83 Fed. Reg. 54319 (Oct. 29, 2018).

I. RELIANCE INTERESTS AND THE PTAB

The motivations for reform include, in significant part, a sense that PTAB review disproportionately affects patent owners who are individual inventors and small businesses. Closely related is the view that protections written into the AIA itself to safeguard against abuses were improperly implemented, to the detriment of patent owners and their reliance on stable patent rights. This view is now increasingly voiced in policy discussions¹³ and court filings,¹⁴ as well as popular media.¹⁵

Specific examples of these premises repay closer empirical scrutiny. This Part presents the results of a new study of *inter partes* review cases from the beginning of PTAB review through June 2018—more than 8,000 cases involving nearly 4,900 patents in all.¹⁶ This case information was further merged with research data published by the USPTO Office of the Chief Economist, which contains a wide range of bibliographic application data.¹⁷ The results, which are presented in Subparts A and B as follow, are a striking set of new findings about the effect of PTAB review upon reliance interests in the patent system that predate the enactment of the AIA.

A. *Small Entities and Their Patents*

Among patent owners, small entities have borne an outsized share of *inter partes* review challenges.¹⁸ Overall, 25.8 percent of the petitions filed through June 2018, have been against patents owned by small entities. By contrast, the expected share of petitions that should have been filed against

13. See, e.g., *Comments of the Small Business Technology Council*, No. PTO-P-2018-0036 (U.S. Patent & Trademark Off., July 9, 2018); *Small Business & Entrepreneurship Council Comments on USPTO's Proposed Changes to the Claim Construction Standard Used in PTAB Proceedings*, No. PTO-P-2018-0036 (U.S. Patent & Trademark Off., July 9, 2018).

14. See, e.g., Brief of Amici Curiae US Inventor, Inc. and 31 Other Grass Roots Inventor Organizations in Support of Petitioner, *Oil States Energy Serv., LLC v. Greene's Energy Grp., LLC*, No. 16-712 (S. Ct., Aug. 29, 2017); Brief of Amici Curiae Patent-Practicing Technology Innovators in Support of Petitioner, *Cuozzo Speed Techs., LLC v. Lee*, No. 15-446 (S. Ct., Feb. 29, 2016).

15. See, e.g., Hon. Kathleen O'Malley, Hon. David Kappos, Gary Lauder, Hon. Paul Michel, and Jamie Simpson, *IP, Antitrust, and Innovation Policy – Enabling the Fourth Industrial Revolution*, 2018 LeadershIP Symposium (Apr. 10, 2018), bit.ly/2xbZ5Eb; Josh Malone, *PTAB Reform: An Urgent Request on Behalf of Independent Inventors*, IPWATCHDOG (May 7, 2018), perma.cc/3UNJ-USQ5.

16. Data on PTAB cases was obtained from Docket Navigator. See docketnavigator.com.

17. See Patent Examination Research Dataset (“Public PAIR”), U.S. PATENT & TRADEMARK OFFICE, perma.cc/L8BT-JW5P (last visited Sept. 16, 2018).

18. For present purposes, a small entity is defined as the Patent Office defines it under 37 C.F.R. § 1.27. Micro entities were not included both because they make up a negligible share of patent owners in *inter partes* review and because the recent creation of that category, see Leahy-Smith America Invents Act, Pub. L. No. 112-29 § 10(b) (2011), means there is no relevant historical baseline.

small-entity patents over this period is 22.2 percent.¹⁹ Viewed over time, this disparity has often been greater, exceeding the expected share by as much as half or three-fourths. This comparison is summarized in Figure 1.

The disparity has important distributive implications. Small entities, especially start-ups, rely substantially more on patent protection to secure competitive advantage in the market, to obtain venture capital and other financing, and to establish reputation,²⁰ as well as to maintain leverage in cross-licensing negotiations, leverage that would otherwise be reserved for firms who enjoy greater size and incumbency.²¹ This disproportionately greater reliance on patents means that the burden of PTAB review would still hit small entities harder if small-entity patent owners were brought into the PTAB at the same rate, or even a somewhat lower rate, as compared to the rate at which small entities receive patents generally. That they are brought into the PTAB at a higher rate is even stronger evidence of the burden.

This is not to say, of course, that being a small entity makes one's patent less deserving of scrutiny. A questionable patent is no less questionable because a sympathetic owner asserts it. The AIA's grand bargain in creating adversarial post-issuance review, however, rested in significant—and historically sustained—part on the opportunity for patent owners to preserve the validity of their patents through amendment rather than the all-or-nothing proposition of adjudicating validity in district court litigation.²² This

19. The expected share was determined by calculating the share of all issued patents that issued to small entities in each respective year when the patents now being challenged in *inter partes* review were issued. For example, in September 2012, 17 *inter partes* review petitions were filed in total. The following are the years of issue of the challenged patents and the small-entity share of all issued patents from that year:

Year	1995	2000	2001	2002	2003	2004	2005	2009	2010	2011
Patent	2	1	2	1	1	2	1	2	2	3
Small-Entity Share	0.305	0.274	0.257	0.230	0.234	0.232	0.229	0.206	0.203	0.201

Thus, for these 17 petitions, the expected share of small-entity patents should be 3.98 (the dot-product of rows 2 and 3). The share observed is 4. This calculation was done for each of the 70 months from September 2012, through June 2018, inclusive.

20. See Stuart J.H. Graham, et al., High Technology Entrepreneurs and the Patent System: Results of the 2008 Berkeley Patent Survey, 24 BERKELEY TECH. L.J. 1255, 1262–63 (2009).

21. See Stuart J.H. Graham & Ted M. Sichelman, Patenting by Entrepreneurs: An Empirical Study, 17 MICH. TELECOMM. & TECH. L. REV. 111, 120–21 (2010).

22. See, e.g., Patent Quality Improvement: Post-Grant Opposition: Hearing Before the Subcomm. on Courts, the Internet, and Intellectual Property of the H. Comm. on the Judiciary, 108th Cong., at 6 (2004) (statement of James A. Toupin, USPTO General Counsel) (testifying that “By providing for the possibility of amendment of challenged claims, the proposed system would preserve the merited benefits of patent claims better than the win-all or lose-all validity contests in district court.”).

assurance, that PTAB review was about preserving patent claims by amendment where possible and not solely about invalidating them, was naturally of great importance to patent owners in general, and to small entities in particular.

Nevertheless, until October 2017, the Patent Office practice as to proposed amendments in *inter partes* review was to impose the burden on patent owners to show patentability even though the petitioner in PTAB proceedings generally bears the burden to prove unpatentability.²³ The likelihood that amendments would actually be allowed, meanwhile, has been low from the start.²⁴ Understood in this context, the disproportionate targeting in *inter partes* review of patents owned by small entities represents one of the more problematic injuries from current PTAB practice upon reliance interests in the patent system.

B. Retroactivity Against Existing Patents

Another such reliance injury has been to owners of patents that were sought, prosecuted, and issued before the first-inventor-to-file (“FITF”) provisions of the AIA went into effect. The FITF regime is an important reference point because it differentiates post-grant review from *inter partes* and covered business method review.²⁵ Post-grant review applies to all FITF patents and only to them,²⁶ and thus, it is the AIA’s only revocation mechanism that is solely prospective. By contrast, *inter partes* review works with express retroactive force upon all patents regardless of whether they were issued “before, on, or after” the effective date of the AIA.²⁷

It is unsurprising, then, that at the start of *inter partes* review, i.e., a year after the AIA was enacted but still six months before the FITF regime went into effect, all petitions were against past, pre-AIA patents. The share of petitions for *inter partes* review that challenge post-FITF patents has grown over time and, as of June 2018, makes up 37.5 percent of such petitions. What may be surprising, however, is just how far back into the historical register of patent rights *inter partes* review has, in fact, reached.

23. *Aqua Prods., Inc. v. Matal*, 872 F.3d 1290, 1297 (Fed. Cir. 2017).

24. A series of internal studies by the USPTO, further discussed below, have repeatedly confirmed the low likelihood that patent owner requests to amend will be granted. *See infra* notes 78–79 and accompanying text.

25. The effective date for FITF patents was set at March 16, 2013, or 18 months from the enactment of the AIA on September 16, 2011. *See Leahy-Smith America Invents Act*, Pub. L. No. 112-29 § 3(n)(1).

26. *See id.* § 6(f)(2)(A).

27. *See id.* § 6(c)(2)(A).

The share of *inter partes* review petitions that challenge FITF patents has grown from zero to 37.5 percent. By contrast, the share of petitions that challenge pre-AIA patents that would have been subject merely to *inter partes* reexamination (“IPX”) has persistently been much larger. It began at around 64.9 percent and remained above the 60 percent mark for the first four years of *inter partes* review. Since then and at the most recent count, it remains above 50 percent. Finally, a notable share of petitions have also attacked patents so old that they would not have been eligible even for *inter partes* reexamination. That share was initially 35.1 percent of petitions for *inter partes* review and has been slow to decline, remaining above 10 percent until just this past year. Figures 2 and 3 summarize these trends.

The comparison to *inter partes* reexamination is particularly salient because one of the cardinal defenses against the charge of retroactivity in the PTAB is that *inter partes* review does not really frustrate reliance interests in any meaningful sense.²⁸ The reason for this is that a dozen years before the AIA, the 1999 American Inventors Protection Act (“AIPA”) established the system of *inter partes* reexamination for the Patent Office to reevaluate and, if appropriate, revoke issued patents in a process that included the adversarial participation of third parties.²⁹ *Inter partes* review may be a different regime in form, the argument goes but is the same in structure and function as *inter partes* reexamination. Thus, those who filed and obtained their patents subject to the latter can be deemed to be sufficiently on notice as to the former.

This view is pragmatic and defensible but invites reasonable disagreement. It is true that reexamination under the AIPA was adversarial, in the sense that the third-party requester could participate and respond in each round of briefing and argumentation.³⁰ The focus of the proceeding, however, remained the dialogue between the patent owner and the reexaminer, a dialogue conducted “according to the procedures established for initial examination.”³¹ Indeed, the Patent Office appeared to view the system as different in kind from district court proceedings, expressly

28. *Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC*, 138 S. Ct. 1365, 1371, 1374 (2018) (likening the old system of *inter partes* reexamination to the current system of *inter partes* review and concluding that under both systems, patents were, and are, granted subject to the same “authority to reexamine—and perhaps cancel—a patent claim”).

29. American Inventors Protection Act of 1999, Pub. L. No. 106-113 §§ 4601–4608 (1999). *See* Vishnubhakat, et al., *supra* note 2, at 57–58.

30. 35 U.S.C. § 314(b) (1999); MPEP § 2654 (describing the conduct of *inter partes* reexamination proceedings).

31. 35 U.S.C. § 314(a) (1999).

cautioning that *inter partes* reexaminations “do not countenance so-called ‘litigation tactics.’”³²

The patentee-reexaminer dialogue, meanwhile, was concerned chiefly with vetting and, wherever possible, preserving, by amendment, the validity of claims on which a “substantial new question” of patentability had arisen since the initial agency examination concluded.³³ It was subject to this regime that parties had sought and obtained their patents after the AIPA, only to learn—more than a decade later—that other sufficient conditions for revocation could still be created and applied against their patents. *A fortiori*, the patents issued before the AIPA that were not subject even to *inter partes* reexamination have suffered and continue to suffer an ever greater reversal of reliance interests in the current system of *inter partes* review.³⁴

II. DESIGNING AN OFF-RAMP

The difficulties that *inter partes* review has imposed against patents owned by small entities and those issued prior to the AIA, and even prior to the AIPA, share a common feature: difficulty in amending patent claims to preserve their validity. The proposal of a PTAB off-ramp aims specifically at redressing this difficulty.

A. Existing Patent Office Authority

The off-ramp design that John White first proposed in 2016³⁵ is a fairly straightforward concept and thus is the starting point of the present analysis. The depth with which the Patent Office has recently engaged with the idea builds from a similar starting point. The basic proposal was as follows:

1. Promptly after a petition for PTAB review is filed, the patent owner could seek reissue.³⁶

32. MPEP § 2609.

33. 35 U.S.C. § 312(a) (1999).

34. The case of *ex parte* reexamination, which has been in place since 1980, is mixed. To date, all patents subjected to *inter partes* review under the AIA were issued after *ex parte* reexamination, meaning that the owners of these patents sought and obtained them subject to *some* form of administrative reevaluation. Nevertheless, differences between AIA review and this earlier administrative review system are no less relevant than with *inter partes* reexamination. *Ex parte* reexamination was also concerned quite consciously with a renewed examiner-patentee dialogue with sustained opportunity to preserve validity by amendment. Moreover, *ex parte* reexamination could be brought by the patent owner itself as a way of shoring up the defensibility of its own patent, whereas modern PTAB reviews specifically exclude patent owners from bringing such petitions under the AIA.

35. See John White, *Curing the PTAB: How 3 Fixes Will Make a Better, Fairer Process*, IPWATCHDOG (Dec. 20, 2016), perma.cc/93KB-JUCZ.

36. *Id.*

2. Upon the patent owner's application for reissue, the petition for PTAB review would be stayed.³⁷

3. The reissue examiner would conduct that proceeding based on well-established agency practice³⁸ that is oriented toward correcting the scope of the patent claims while preserving their validity.³⁹

4. Notably, the reissue examiner would also determine any intervening rights that might arise as a result.⁴⁰

The principal feature of this approach is that the agency could implement it under existing statutory authority, which provides that "if another proceeding or matter involving the patent is before the Office, the Director may determine the manner in which the *inter partes* review or other proceeding or matter may proceed, including providing for stay, transfer, consolidation, or termination of any such matter or proceeding."⁴¹ Indeed, this provision expressly refers to the statute authorizing reissue proceedings.⁴²

There is, however, an additional feature in the original proposal that is probably beyond the Patent Office's authority to implement. Not only would all PTAB review of a patent undergoing reissue be stayed, but district-court litigation involving the patent would also be dismissed without prejudice, ostensibly to preserve a defendant-petitioner's right to refile.⁴³ Dismissing court actions is, of course, beyond agency power. Indeed, even staying district court actions would be difficult. The statutes governing PTAB review provide for mandatory or presumptive litigation stays in certain situations, but these stays leave intact the considerable discretion of courts to grant or deny stays themselves.⁴⁴

In fact, even if courts were willing to dismiss without prejudice in such cases, the benefit to PTAB petitioners who seek *inter partes* review after being sued in district court would still be minimal. The one-year time bar, which requires a party that has been served with a complaint alleging infringement to seek *inter partes* review within one year or forgo it entirely,

37. *Id.*

38. 37 C.F.R. §§ 1.171–1.179.

39. *Id.*

40. *Id.*

41. 35 U.S.C. § 315(d). There is correspondingly broad authority as to post-grant review as well. *See* 35 U.S.C. § 325(d).

42. *Id.* (cross-referencing 35 U.S.C. § 251).

43. *See* White, *supra* note 35.

44. *E.g.*, 35 U.S.C. §§ 315(a)(2), 325(a)(2); Leahy-Smith America Invents Act, Pub. L. No. 112-29 § 18(b).

still applies to such petitioners.⁴⁵ And, as the *en banc* Federal Circuit recently explained, dismissal without prejudice of the district court case does not reset or toll the one-year bar.⁴⁶ Thus, holding a defendant-petitioner's rights in abeyance during reissue, without prejudicing its right to challenge the patent later, would require curbing judicial case management discretion as well as a restructuring of the one-year time bar—neither of which the Patent Office currently has authority to do.

The Patent Office, for its part, has elaborated on the basic off-ramp concept with two further institutional design considerations. The starting point for the agency, as for Mr. White's proposal, is to involve examiners rather than rely solely on the administrative patent judges of the PTAB.⁴⁷ Going further, the agency asks whether the involvement of the examiner should be mandatory (as the use of reissue practice seems to assume) or invoked upon request, such as through an advisory report from the examiner.⁴⁸ And if it should be upon request, should that request come from the patent owner, from the petitioner, from either party, from both parties jointly, or from the PTAB panel itself?⁴⁹

It is notable that the Patent Office's own proposal frames the use of examiners as an adjunct to the work of the PTAB in evaluating motions to amend.⁵⁰ It does not contemplate handing the patent off to a distinct proceeding (albeit still inside the agency) the way Mr. White's basic proposal does. The significance of this framing is that the Patent Office is likely quite attentive to the overarching constraints on PTAB adjudication, especially the one-year statutory deadline for issuing final written decisions,⁵¹ and is inclined to keep the PTAB in control of the overall timeline.

B. *The Effect of Aqua Products*

The PTAB-centric approach to involving examiners in the preservation of patent validity means that the off-ramp concept that the Patent Office is now considering is situated in the context of a motion to amend. The most

45. 35 U.S.C. § 315(b).

46. *Click-To-Call Techs., LP v. Ingenio, Inc.*, 899 F.3d 1321, 1328 n.3 (Fed. Cir. 2018).

47. U.S. PATENT & TRADEMARK OFFICE, SHARING INSIGHTS: FROM BENCH TO BAR AND BAR TO BENCH 166, PTAB Annual Judicial Conferences (June 28–July 31, 2018), perma.cc/N8R3-Q5DU.

48. *Id.*

49. *Id.*; see also Request for Comments on Motion To Amend Practice and Procedures in Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board, 83 Fed. Reg. 54319, 54323, 54325 (Oct. 29, 2019) (suggesting a various situations in which the panel may seek examiner assistance on proposed amendments).

50. *Id.* at 167 (asking whether “patent examiners should be involved in *assisting* the Board in addressing motions to amend”) (emphasis added).

51. 35 U.S.C. § 316(a)(11).

salient design consideration in that context is the *en banc* Federal Circuit's 2017 decision in *Aqua Products v. Matal*, regarding who bears the burden of proving the patentability or unpatentability of claims introduced by proposed amendment during *inter partes* review.⁵²

In *Aqua Products*, the Federal Circuit held that the petitioner must bear the burden of proving that amended claims introduced by the patent owner are unpatentable.⁵³ This disrupted the prior PTAB practice of imposing that burden upon the patent owner.⁵⁴ The tension between these positions arose from two general rules that, on their own terms, seem relatively straightforward. The PTAB rule at issue provided that relief must generally be sought in the form of a motion and the party who makes the motion bears the burden of establishing that the relief is warranted.⁵⁵ However, the governing statutory language of 35 U.S.C. § 316(e) provides that the petitioner, not the patent owner, bears the overall burden of proving the unpatentability of patent claims in *inter partes* review.⁵⁶

Importantly for considering off-ramp design, the *en banc* court in *Aqua Products* reached its decision by overlapping plurality positions, not a single clear majority position. The lead opinion of Judge O'Malley disapproved the Patent Office rule and was joined by Judges Newman, Lourie, Moore, and Wallach—with Judges Dyk and Reyna concurring in the result.⁵⁷ The separate opinion of Judge Reyna, meanwhile, found the statute ambiguous and was joined by Judge Dyk—and joined in pertinent part by Chief Judge Prost and Judges Taranto, Chen, and Hughes.⁵⁸

The locus of overlap was Judges Reyna and Dyk's view that § 316(e) is ambiguous but that the Patent Office did not interpret it in an APA-compliant fashion and so does not merit *Chevron* deference.⁵⁹ (Judge Taranto wrote separately—in dissent, with Chief Judge Prost and Judges Chen and Hughes—that the agency did interpret the ambiguity in § 316(e) and did merit *Chevron* deference.⁶⁰) These positions are summarized in Figure 4.⁶¹

52. *Aqua Prods. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017) (*en banc*).

53. *Id.* at 1296.

54. *Id.* at 1301.

55. 37 C.F.R. § 42.20.

56. 35 U.S.C. § 316(e).

57. *Aqua Prods.*, 872 F.3d at 1295.

58. *Id.* at 1334 (Reyna, J., concurring).

59. *Id.*

60. *Id.* at 1342 (Taranto, J., dissenting).

61. Judge Moore wrote separately, joined by Judges Newman and O'Malley, "to address problems with the Director's attempt to extend *Chevron* deference beyond any prior applications of the doctrine." *Id.* at 1328 (Moore, J., concurring). Judge Hughes also wrote separately, joined by Judge Chen, to argue that the Patent Office is still entitled, if not to *Chevron* deference for interpreting an ambiguous statute, to *Auer* deference for interpreting its own regulation, as well as to reject the view that the agency's

The upshot of Judges Reyna and Dyk's swing-vote view is that if the Patent Office were to engage in APA rulemaking as to who bears the burden of establishing the patentability (or unpatentability) of amended claims, then the 7–4 split of *Aqua Products* might well turn into a 6–5 majority going the other way.⁶²

If the burden continues to belong to the petitioner, then examiner involvement in evaluating amended claims should require the petitioner's assent, and vice-versa. If, as the Patent Office has suggested, the PTAB panel might seek examiner involvement either (1) where the petitioner has dropped out or (2) where the panel *sua sponte* believes examiner input would be useful, then the patent owner especially should have a chance to respond to the examiner report.

Public actions, as well as empirical trends, suggest that the importance of *Aqua Products* to Patent Office practice has been substantial. Following the *en banc* decision on October 4, 2017, the Chief Judge of the PTAB, on November 21, 2017, issued a guidance memorandum to all administrative patent judges on how to implement the decision in cases both future and pending.⁶³ The PTAB's next round of annual judicial conferences, held in summer 2018 at the Patent Office headquarters and its regional offices, started gathering public input on claim amendment and the involvement of examiners.⁶⁴ And most recently, the agency's request for comments seeks input even more specifically oriented toward rulemaking in the manner suggested by Judge Reyna's opinion.⁶⁵

Indeed, cumulative data on motions to amend in the PTAB suggests that the agency may have been attuned to the possibility of reversal even before the opinion issued. Figure 5 shows the results of motions to amend as a retrospective moving average from the beginning of PTAB review in late 2012 through the end of January 2019. Through late summer 2016, the rate at which motions to amend were granted or granted-in-part had been persistently low, at or below 4 percent. However, those rates began to grow

interpretation of § 316(e) was not an APA-compliant act of rulemaking. *Id.* at 1358 (Hughes, J., dissenting). These opinions are omitted only for clarity as to the discussion at hand.

62. *See id.* at 1335 (Reyna, J., concurring) (noting that his opinion “does not bar the Agency from crafting a wholesome interpretation of the evidentiary burdens allowed under the *inter partes* review statute that could be afforded deference if properly promulgated under APA rulemaking procedures”).

63. David P. Ruschke, *Guidance on Motions to Amend in view of Aqua Products*, USPTO (Nov. 21, 2017), perma.cc/DW9N-TEA3.

64. U.S. PATENT & TRADEMARK OFFICE, SHARING INSIGHTS: FROM BENCH TO BAR AND BAR TO BENCH 166, PTAB Annual Judicial Conferences (June 28–July 31, 2018), perma.cc/N8R3-Q5DU.

65. Request for Comments on Motion To Amend Practice and Procedures in Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board, 83 Fed. Reg. 54322, 54324–25.

almost immediately after the Federal Circuit in August 2016 granted the petition for *en banc* rehearing in *Aqua Products*.

In determining how best to proceed in the wake of that case, then, the recent request for comments poses the very questions on which the slim *en banc* outcome turned: (1) should the agency engage in rulemaking to allocate the burden of persuasion in motions to amend, and (2) if so, who should bear the burden, the petitioner or the patent owner?⁶⁶ The request for comments also cites the PTAB guidance order of April 2018 in the *Western Digital* case, which allocated the burden on the petitioner and was subsequently designated an “informative” opinion as to different aspects of PTAB amendment practice.⁶⁷

Public response to the request for comments appears, on the whole, to favor notice-and-comment rulemaking by the Patent Office as to amendment practice. Leading IP groups such as the American IP Law Association,⁶⁸ the IP Owners Association,⁶⁹ and the IP Law Section of the American Bar Association⁷⁰ support notice-and-comment rulemaking. So do leading industry groups such as the Biotechnology Innovation Organization⁷¹ and the Institute of Electrical and Electronics Engineers.⁷² Those who believe patent owners should bear the burden also favor rulemaking as the preferred means to restore pre-*Aqua Products* practice, including the Computer & Communications Industry Association⁷³ and the Electronic Frontier Foundation.⁷⁴ And leading individual commentators on the patent system,

66. *Id.*

67. *W. Dig. Corp. v. SPEX Techs., Inc.* No. IPR2018-00082, Paper 13 (P.T.A.B Apr. 25, 2018).

68. Letter from Sheldon H. Klein, President, American Intellectual Property Law Association to Judge Jacqueline Wright Bonilla, Acting Deputy Chief Administrative Patent Judge, and Michael Tierney, Vice Chief Administrative Patent Judge (Dec. 20, 2018), perma.cc/JAT6-6PPY.

69. Letter from Henry Hadad, President, Intellectual Property Owners Association to Judge Jacqueline Wright Bonilla, Acting Deputy Chief Administrative Patent Judge, and Michael Tierney, Vice Chief Administrative Patent Judge (Dec. 21, 2018), perma.cc/ZDQ2-2NG6.

70. Letter from Mark K. Dickson, Chair, ABA Section of Intellectual Property Law to Judge Jacqueline Wright Bonilla, Acting Deputy Chief Administrative Patent Judge, and Michael Tierney, Vice Chief Administrative Patent Judge (Dec. 13, 2018), perma.cc/58RU-V7T3.

71. Letter from Hans Sauer, Deputy General Counsel & VP for Intellectual Property, Biotechnology Innovation Organization to Judge Jacqueline Wright Bonilla, Acting Deputy Chief Administrative Patent Judge, and Michael Tierney, Vice Chief Administrative Patent Judge (Dec. 21, 2018), perma.cc/M5YR-9Q4E.

72. Letter from Ron D. Katznelson, Vice Chair for Patents, Intellectual Property Committee, and Brendan B. Godfrey, Vice President for Government Relations, IEEE-USA to Judge Jacqueline Wright Bonilla, Acting Deputy Chief Administrative Patent Judge, and Michael Tierney, Vice Chief Administrative Patent Judge (Dec. 21, 2018), perma.cc/E43U-L2X6.

73. Letter from Joshua Landau, Patent Counsel, Computer & Communications Industry Association to Judge Jacqueline Wright Bonilla, Acting Deputy Chief Administrative Patent Judge, and Michael Tierney, Vice Chief Administrative Patent Judge (Dec. 21, 2018), perma.cc/222F-B9LQ.

74. Letter from Daniel Nazer, Senior Staff Attorney, and Alex Moss, Staff Attorney, Electronic Frontier Foundation to Judge Jacqueline Wright Bonilla, Acting Deputy Chief Administrative Patent

such as former Eli Lilly general counsel and former AIPLA President Robert Armitage, favor rulemaking as well.⁷⁵ Together, these authorities indicate a consensus. This consensus, together with information-gathering that the Patent Office has already done, suggests that a proposed rulemaking probably is in the offing. As for who should bear the burden as a result of such rulemaking, there is not a consensus, but there is apparent majority support for placing the burden on the petitioner,⁷⁶ as would be in accordance with Judge O'Malley's lead opinion in *Aqua Products*.

In general, to avoid gamesmanship, a party-driven invocation of examiner involvement should probably require the assent of whichever party bears the burden of persuasion. For example, if Patent Office rulemaking codifies *Western Digital*, that the burden belongs to the petitioner, then the patent owner should not be able to disrupt the petitioner's case by unilaterally introducing an examiner into the process. Conversely, and for the same reason, if the rulemaking restores the pre-*Aqua Products* allocation that the burden belongs to the patent owner, then the petitioner should not be able to disrupt the patent owner's defense of its own amended claims through the tactical and idiosyncratic use of agency resources.

However, if examiner participation is either mandatory or at the discretion of the panel (rather than the parties), then the allocation of the burden will likely not matter as much. In those circumstances, the involvement of the examiner would be akin to the involvement of a magistrate judge to address certain issues in district court litigation, with no particularly party-specific avenue for inappropriate strategic behavior.

Instead, the mandatory or panel-initiated use of examiners to evaluate the patentability of amended claims should assure ample opportunity for a response to the recommended conclusions of the examiner. It would be appropriate, of course, to take briefing both from the petitioner and from the patent owner, but as a matter of basic due process, the opportunity of the patent owner would be the more important one to guarantee.

III. THE MIXED CASE

The likely contours of a PTAB off-ramp, both as attorney John White has proposed, and as the Patent Office has explored and continues to explore,

Judge, and Michael Tierney, Vice Chief Administrative Patent Judge (Dec. 20, 2018), perma.cc/6HVK-QEJQ.

75. Letter from Robert A. Armitage to Judge Jacqueline Wright Bonilla, Acting Deputy Chief Administrative Patent Judge, and Michael Tierney, Vice Chief Administrative Patent Judge (Nov. 7, 2018), perma.cc/J7MT-ND8E.

76. See *supra* notes 65–69, 72.

are chiefly concerned with the difficulty of preserving patent claims, where possible, through amendment. Evaluating the institutional design of a PTAB off-ramp in terms of amendment practice, meanwhile, requires considering not only the landscape of current practice after *Aqua Products* but also the agency's relatively high likelihood of rulemaking in the near term. The result of this evaluation is ultimately equivocal, with worthy arguments on both sides of the cost-benefit ledger.

A. Benefits

The principal benefit of an off-ramp from PTAB reviews under the AIA, as noted above,⁷⁷ would be that it would adhere to the preservation of patents to the extent that their claims are salvageable through amendment. Certainly, it would adhere more closely to that goal than does the current observed practice of the PTAB in granting motions to amend. The Patent Office has now published four internal studies of the results of motions to amend, each a cumulative analysis from the start of PTAB review in late 2012.⁷⁸ Each study has shown that a panel's likelihood of denying a motion to amend consistently been at or higher than 90 percent.⁷⁹

Even now, over a year after the *Aqua Products* decision, the cumulative rate as of January 2019 for full denial of motions to amend remains about 91.2 percent.⁸⁰ The 12-month average rate as of January 2019 for full denial is only slightly more generous at 84.8 percent.⁸¹ Indeed, notwithstanding that the burden of persuasion has now been reallocated away from patent owners, Figure 6 shows that even the overall *number* of motions to amend has remained relatively flat apart from a temporary uptick after the PTAB issued its post-*Aqua Products* guidance. This followed a marked decline in such

77. See *supra* notes 35–40 and accompanying text.

78. U.S. PATENT & TRADEMARK OFFICE, PATENT TRIAL AND APPEAL BOARD MOTION TO AMEND STUDY (Apr. 30, 2016), bit.ly/2vrJMoY [hereinafter MTA Study #1]; U.S. PATENT & TRADEMARK OFFICE, PATENT TRIAL AND APPEAL BOARD MOTION TO AMEND STUDY: INSTALLMENT 2 (May 31, 2017), bit.ly/2LMuiXY [hereinafter MTA Study #2]; U.S. PATENT & TRADEMARK OFFICE, PATENT TRIAL AND APPEAL BOARD MOTION TO AMEND STUDY: INSTALLMENT 3 (Sept. 30, 2017), bit.ly/2n6xKOl [hereinafter MTA Study #3]; U.S. PATENT & TRADEMARK OFFICE, PATENT TRIAL AND APPEAL BOARD MOTION TO AMEND STUDY: INSTALLMENT 4 (Mar. 31, 2018), bit.ly/2LXiS2E [hereinafter MTA Study #4].

79. MTA Study #1, *supra* note 78, at 6; MTA Study #2, *supra* note 78, at 6; MTA Study #3, *supra* note 78, at 6; MTA Study #4, *supra* note 78, at 7.

80. Data on motions to amend is available from the Docket Navigator service, docketnavigator.com. Rates were calculated based on motions to amend that were (1) granted in full, (2) denied in full, or (3) granted in part and denied in part. Excluded from the analysis were 14 motions to amend (out of 208 total) that were either denied as moot or denied without prejudice.

81. *Id.*

requests during 2015 when the numbers of motions to amend were at an all-time high, but (as Figure 5 shows) so were the rates of full denial.

A second key benefit of an off-ramp from the adversarial PTAB setting would be that a disinterested examiner assessment of amended or substitute claims is likely to be preferable over highly partial arguments from a petitioner. Although PTAB review is, by design, cheaper and more broadly accessible than litigation,⁸² the selection of petitioners into administrative patent revocation is still driven primarily by direct self-interest. Of petitioners who seek *inter partes* review, for example, 70 percent have previously been sued in U.S. district court for infringing the patent that they seek to revoke in the PTAB.⁸³ Covered business method review is even more directly defensive, and only those who have been sued for, or charged with, infringement of the patent in question (or their privies or real parties in interest) are permitted to seek review.⁸⁴

The incentives of PTAB petitioners may be well-suited for testing the validity of already-issued patent claims as, indeed, the more robustly adversarial structure of AIA review reflects. Yet the narrow, result-oriented arguments typical of patent litigation are inapt for patent claims being evaluated for the first time. For this, the approach of examiners, especially the highly experienced examiners who serve in the Central Reexamination Unit of the Patent Office,⁸⁵ is at one remove from the immediate stakes of the dispute. Thus, it is better suited to evaluate the innovation- and disclosure-related merits of the proposed amended claims in light of the prior art in the relevant field or fields of technology. In fact, the use of examiners that the Patent Office mentioned in its recent request for comments referred specifically to examiners from the Central Reexamination Unit for the preparation of an advisory report to the PTAB panel on the patentability of amended claims.⁸⁶

Thus, whether the Patent Office were to send a patent into a distinct proceeding for reissue or keep it in PTAB review and merely invite an impartial advisory report on patentability, the benefits would be a more amendment-friendly process in accord with a key assurance of the AIA, and the more dispassionate perspective of a seasoned examiner.

82. Vishnubhakat, et al., *supra* note 2, at 51–55.

83. *Id.* at 73.

84. Leahy-Smith America Invents Act, Pub. L. No. 112-29 § 18(a)(1)(B).

85. USPTO, Central Reexamination Unit, bit.ly/2V9ZArM (noting that “[t]he CRU is staffed with senior primary patent examiners and supervisory patent examiners having a wide range of technical expertise and advanced patent legal knowledge.”).

86. Request for Comments on Motion To Amend Practice and Procedures in Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board, 83 Fed. Reg. 54319, 54323.

B. Costs

Nevertheless, against these benefits, significant costs must also be acknowledged. The most salient is delay. Whether a patent validity review in the PTAB is held in abeyance pending a reissue proceeding, or the PTAB panel itself awaits the preparation of an examiner advisory report, introducing a new institutional actor midstream will lengthen the review process. This result is especially likely in certain subsets of cases, such as those involving unusually complex or valuable technologies, a large number of patent claims, or a large number of parties—simply because the incentive and scope for potential amendments will be correspondingly greater.

For example, prior research has shown that *inter partes* review petitions against “Drugs & Medical”-related patents are especially prone to strategic joinder.⁸⁷ In that technology, a minority of petitioners (48.5 percent) are “standard petitioners,” i.e., they have previously been sued on the patent that they now challenge.⁸⁸ However, a significant majority of petitions (70.8 percent) in that technology contain at least one standard petitioner.⁸⁹ In other words, those who are not prior defendants frequently join petitions of those who are.⁹⁰

For the Patent Office, this problem of delay, and potentially significant delay, is not only a general matter of promoting expeditious resolution in service of social welfare. It is also an explicit statutory obligation. All three types of patent validity reviews under the AIA must be concluded within one year of institution, and even the discretion of the Director to extend the adjudication period “for good cause shown” is limited only to an additional six months.⁹¹ Making advisory input from examiners a routine part of amendment practice would quickly push review to the outer limits of these deadlines and would threaten the agency’s ability to meet its obligations.

A second major cost of more elaborate and examiner-oriented amendment practice is its potential effect on judicial stays and court-agency substitution more generally. The problem of stays pending PTAB review has beguiled litigants on both sides from the start. District courts have been highly variable in the rates at which they stay cases, from as frequently as 70

87. Vishnubhakat, et al., *supra* note 2, at 74.

88. *Id.* at 74, 102 (Figure 15a).

89. *Id.* at 74, 103 (Figure 15b).

90. *Id.* at 74.

91. 35 U.S.C. §§ 316(a)(11), 326(a)(11).

percent in the Northern District of California to as rarely as 40 percent or less in the Eastern District of Texas according to one recent estimate.⁹²

In large part, this was due to the Patent Office's doctrine of partial institution, whereby a petition might not be fully granted or fully denied but granted in part and denied in part.⁹³ It was only recently, with the Supreme Court's April 2018 decision in *SAS Institute v. Iancu*, that partial institution was abolished, so that the PTAB must now make only binary decisions on each petition.⁹⁴ This change points to an abruptly clearer informational signal from the PTAB to the courts about what issues are likely to be simplified if the agency grants review, and what issues are likely to remain for the courts if the agency denies review.⁹⁵ A more protracted PTAB process, however, would push the pendulum back toward greater uncertainty, and for longer, on the part of courts regarding the validity of the patents at bar. The rational but socially undesirable response of courts, in turn, would be to deny stays more often and with greater variation once again.

A third cost, somewhat more elusive but no less important for that, is the problem of trying to fix a dramatic administrative expansion of the patent system by compounding its complexity and, likely, its cost. As Professor John Duffy argued in the months leading up to the enactment of the AIA, "one might fairly [have] question[ed] whether the substantial expansion of Patent Office's bureaucratic proceedings over the past three decades has been a good thing or not," but the even further expansion that the AIA brought about reflected "something truly unprecedented in the history of U.S. patent law."⁹⁶

Closely tied to the problem of bureaucratic expansion is that the fee-setting authority granted to the Patent Office allowed it to "raise its fees to fuel its own growth."⁹⁷ The agency must set its fees at cost recovery—i.e., patent fees can be no higher than is necessary to recover the costs related to the agency's patent-related activities.⁹⁸ The potential for moral hazard is plain. Fees may rise so long as agency activities expand to justify them.⁹⁹ The problems of expansion and cost are predictably difficult to parse because

92. Joel Sayres & Julie Wahlstrand, *To Stay or Not to Stay Pending IPR? That Should Be a Simpler Question*, 17 CHI.-KENT J. INTELL. PROP. | PTAB BAR ASSOC. 52, 63–65 (2018).

93. 37 C.F.R. §§ 42.108, 42.208 (2012).

94. *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348 (2018).

95. Vishnubhakat, *supra* note 2, at 26–27.

96. John F. Duffy, *The Big Government Patent Bill 1*, PATENTLYO (June 23, 2011), perma.cc/TU76-DL7R.

97. *Id.*

98. Leahy-Smith America Invents Act, Pub. L. No. 112-29 § 10(a)(2).

99. See Duffy, *supra* note 96, at 3 (predicting that "the inflation of fees will track the inflation of the bureaucracy. It will do nothing to check the growth of the bureaucracy.").

reforming PTAB amendment practice effectively will likely require significant agency resources. Doing it well will be costly, but doing it cheaply may render it so ineffectual that doing it badly may prove worse than doing nothing at all.

CONCLUSION

In the final analysis, the case for a PTAB off-ramp is unclear for much the same reason that administrative patent revocation under the AIA has been troublesome in the first place. At its core, the design of the PTAB is to make it easier to invalidate poor-quality patents, but to do so, it must necessarily make it easier to invalidate all patents—in the hope that the punishments at the end would fall disproportionately on poor-quality patents.¹⁰⁰ Although this problem could be managed, it could not be avoided entirely because poor-quality patents cannot reliably be identified up front; if they could, there would be no need for review at all.¹⁰¹

The inverse is also true. Procedures that make it easier to preserve the validity of particular patents unavoidably make it easier to preserve the validity of all patents by diminishing the relative cost-savings associated with PTAB review for petitioners who otherwise seek a cheaper, faster, and more expert alternative than the district courts for litigating the validity of patents.

The mixed case for a PTAB off-ramp should give pause to institutional designers both in the Patent Office and in Congress. Recent doctrinal retrenchments from the Supreme Court and the Federal Circuit have already begun to scale back some of the more expansive and problematic positions of the Patent Office concerning PTAB structure, offering a positive way forward.¹⁰² Meanwhile, renewed enthusiasm in the Patent Office for other, more foundational issues such as PTAB claim construction¹⁰³ and the doctrine of patent-eligible subject matter¹⁰⁴ have largely met with public approval and success. The resurgent but finite political capital of the Patent

100. Federal Trade Commission Hearing No. 4 on Competition and Consumer Protection, *Session 1: Emerging Trends in Patent Quality* (Oct. 24, 2018) (testimony of Saurabh Vishnubhakat), bit.ly/2Ebku31.

101. *Id.*

102. *See generally* Vishnubhakat, *Disguised Patent Policymaking*, *supra* note 3 (discussing the arc of Patent Office aggrandizement from the early days of the PTAB to more recent reversals).

103. *See supra* notes 5–6 and accompanying text.

104. *E.g.*, USPTO, *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (Jan. 7, 2019); Andrei Iancu, Director, U.S. Patent & Trademark Office, Remarks at the 10th Annual Patent Law & Policy Conference (Nov. 26, 2018), bit.ly/2GWVX4y; Andrei Iancu, Director, U.S. Patent & Trademark Office, Remarks at the Intellectual Property Owners Association 46th Annual Meeting (Sept. 24, 2018), bit.ly/2xzUoEr.

Office and the generally limited window of consensus within which patent legislation is likely to succeed all point toward a need for cautious prioritization. The past shortcomings of PTAB practice with respect to preserving patents through amendment do merit reform, but this should not come at the expense of other more basic or feasible reforms.

FIGURES AND TABLES

Figure 1. The Share of Small Entities in *Inter Partes* Review

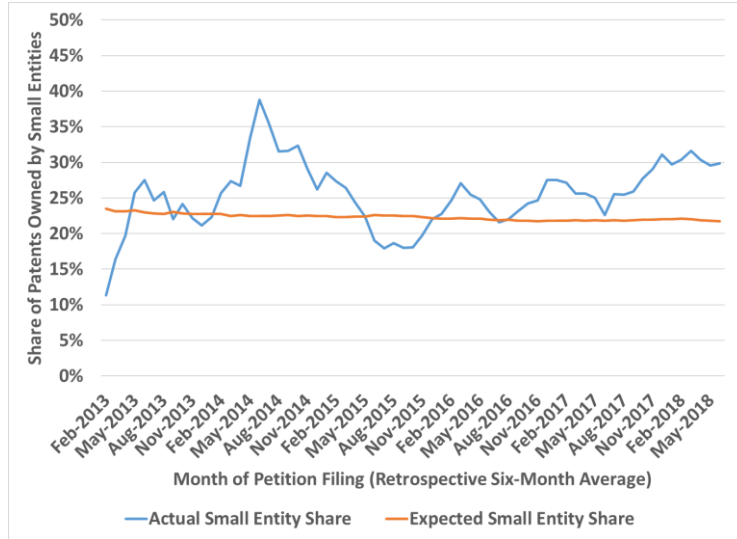


Figure 2. Cohorts of Patents Challenged in *Inter Partes* Review

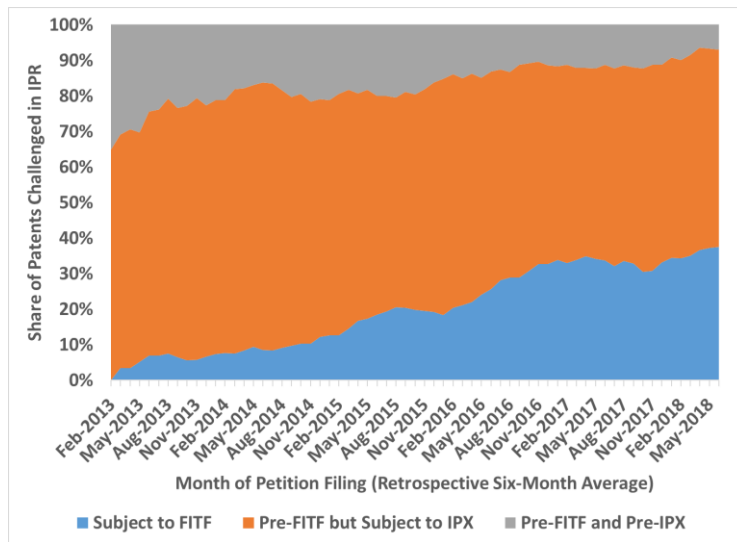


Figure 3. Cohorts of Patents Challenged in *Inter Partes* Review

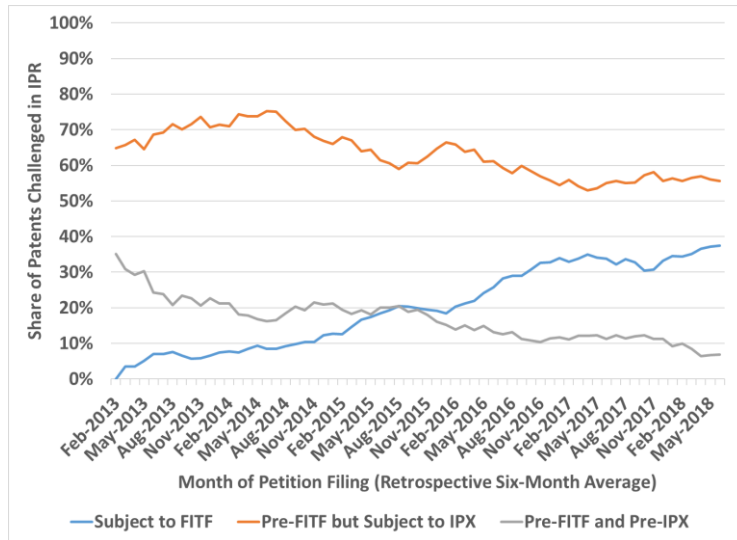


Figure 4. O’Malley, Reyna & Taranto Positions in *Aqua Products*

	Is § 316(e) ambiguous?	Did PTO engage in APA-compliant rulemaking?	Does PTO get <i>Chevron</i> deference?
O’Malley	No	No (in the alternative)	No
Newman			
Lourie			
Moore			
Wallach			
Reyna	Yes	No	Yes
Dyk			
Taranto		Yes	
Prost			
Hughes			
Chen			

Figure 5. Outcomes of Motions to Amend in *Inter Partes* Review (Retrospective 12-month Average)

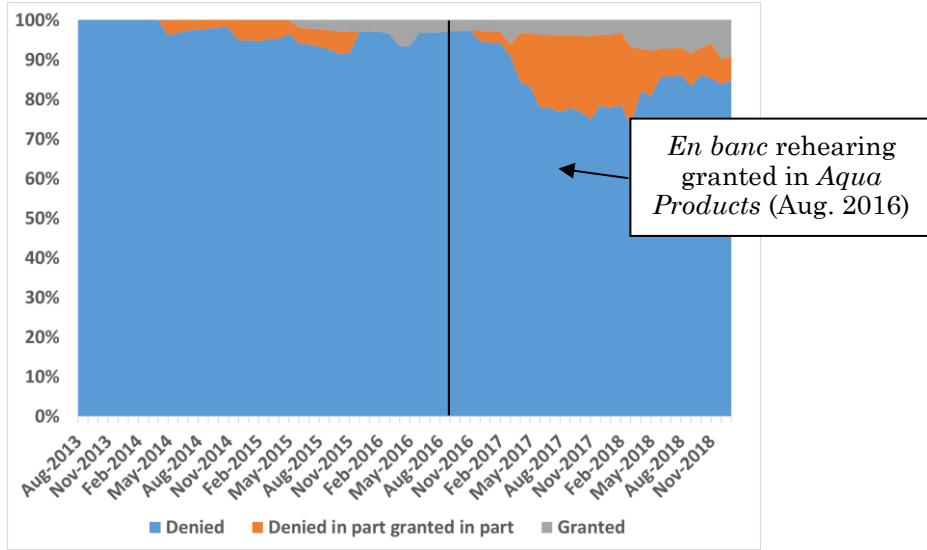


Figure 6. Motions to Amend in *Inter Partes* Review (Retrospective 12-month Average)

