

## Busting 3 Myths About The Patent Trial And Appeal Board

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Ever since the America Invents Act created a new framework for challenging the validity of patents, critics have charged that the proceedings unfairly favor petitioners.[1] In the wake of recent U.S. Supreme Court challenges, there have even been calls for the AIA process to be repealed or overhauled.[2] Such drastic proposals, however, often rest on incomplete facts and outdated perceptions. In this article, we address three common myths: (1) the Patent Trial and Appeal Board is a “death squad” for patents; (2) patent owners too often endure serial challenges to the same patent, and (3) absent an off-ramp, patent owners lack a fair opportunity to amend claims in AIA proceedings. As our review of PTAB data shows, AIA proceedings have been sufficiently fair to patent owners. There is no justification for radical changes.



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### **Myth: The PTAB is a “death squad,” killing off property rights.**

In 2013, former Federal Circuit Chief Judge Randall Rader famously labeled the PTAB a “death squad”[3] — a characterization critics have continued to echo.[4] But a closer look at PTAB data casts doubt on this myth. If anything, patent owners have steadily increased their success in AIA proceedings.



Sina Aria

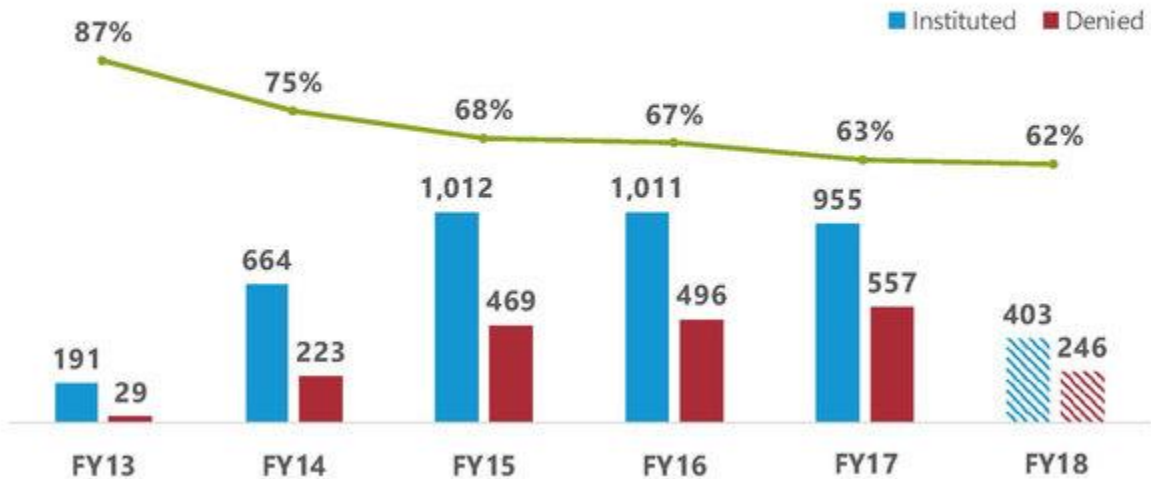
### ***Patent owners have a fair opportunity to knock out petitions before institution.***

While the PTAB did institute the vast majority of AIA petitions in the beginning, the institution rate has declined to a sustainable level in the years since. In 2013, the PTAB instituted 87 percent of petitions, but by the end of 2017 the rate had dropped to 63 percent, as shown in Figure 1 below.[5] It is hard to argue that patent owners do not now have a fair chance of success in blocking institution.



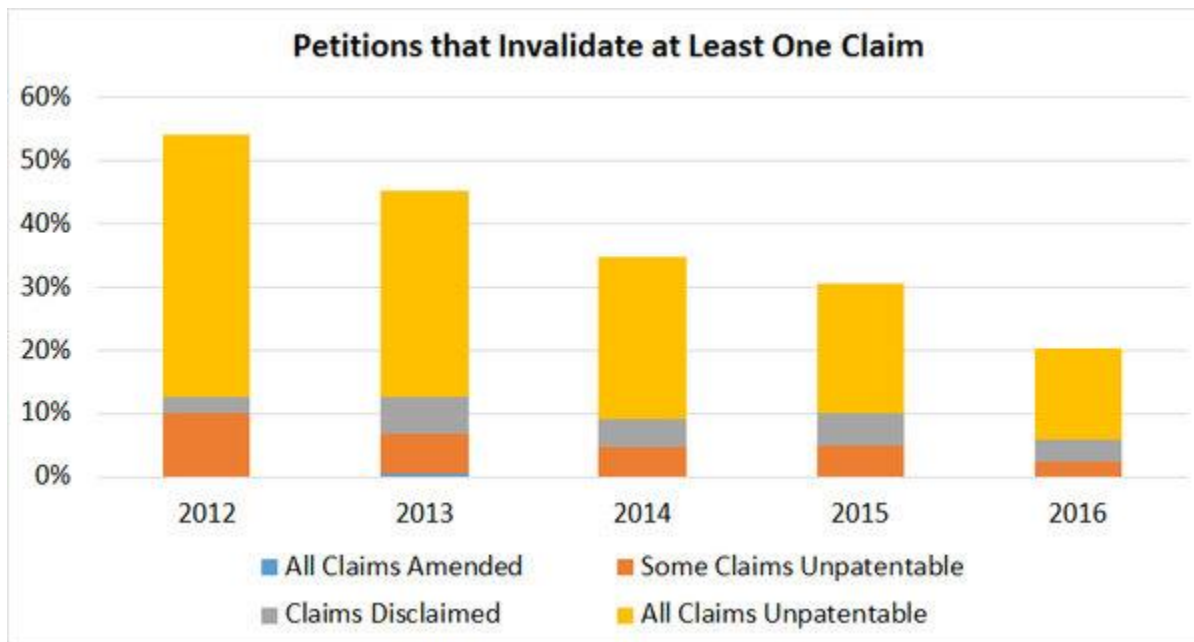
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## Institution Rates (FY13 to FY18: 10/1/12 to 2/28/18)



***Patent owners have a sufficiently fair opportunity to defeat petitions throughout the AIA proceedings.***

Looking at the broader AIA process — including both pre-institution and post-institution stages — statistics still show that patent owners have a fair overall chance of success. As Figure 2 indicates, while over 50 percent of all filed petitions led to a final written decision invalidating at least one claim in 2013, the rate had plummeted to 20 percent by 2016.[6]



Even the average statistics over the life of AIA proceedings — taking into account the initial higher rates of invalidation — show that the process has been fair to patent owners. Fewer than one out of three (32 percent) petitions filed from inception to February 2018 resulted in a final written decision invalidating all claims of the challenged patent.[7]

Whatever truth the “death squad” myth might have once held, it is not consistent with the comprehensive statistical data available today.

***Factors that contributed to higher initial invalidation rate likely no longer exist.***

While it is hard to say definitively why the institution and invalidation rates discussed above have declined from their initial heights, some of the following factors may have contributed.

First, the higher invalidation rate in the early years could have been due to a pent-up demand for a cost-effective, speedy challenge to weak patents.[8] Before the AIA, the common options for challenging validity — e.g., in district court or reexamination proceedings — were neither cost-effective nor speedy. The AIA gave petitioners a mechanism for challenging weak patents at a lower cost than district court litigation and at a faster pace than U.S. Patent and Trademark Office re-examination proceedings. After the PTAB invalidated the challenged “low-hanging fruits,” the invalidation rates declined toward a more sustainable level.[9]

Second, the declining institution rate could be due to the USPTO’s efforts to level the playing field. The USPTO has lifted certain restrictions that it initially placed on the patent owner’s ability to defeat petitions. For example, the initial AIA rules authorized only the petitioners to offer testimonial evidence before the institution decision, while barring the patent owner from doing the same.[10] Consequently, trials were more likely to be instituted in the initial years because, all else being equal, the PTAB generally assigned more weight to testimonial evidence offered in support of the petition than the patent owner’s attorney arguments in the preliminary response. In March 2016, however, the USPTO amended the AIA rules to authorize patent owners to submit expert declarations prior to institution — a change that provided greater ammunition for patent owners to shoot down petitions at the institution stage.[11] Such efforts may have been responsible for the 5 percent decline in the institution rate between fiscal year 2015 and 2017.[12] As PTAB Chief Judge David Ruschke recognized, these were “tangible, real example(s) of ... rules that improve the opportunities patent owners have to put their views forward.”[13]

Third, the invalidation rate could have decreased as patent owners became increasingly adept at using the procedural tools to defeat petitions. For example, patent owners more effectively used procedures to strike petitioners’ arguments and evidence submitted after filing of the petition. Patent owners also became more skilled at defeating petitions for presenting prior art and arguments similar to those considered during the prosecution history or in prior USPTO proceedings. In addition, patent owners increasingly defeated petitions on procedural grounds, such as failure to name all real parties-in-interest and failure to abide by timing requirements for filing the petition.[14]

***Institution rates may further decline after the recent SAS Institute decision.***

In April 2018, the SAS Institute Supreme Court decision made significant changes to the PTAB’s institution practice.[15] Before SAS, the PTAB instituted an inter partes review as to only a subset of challenged claims in over 20 percent of the cases.[16] The PTAB also had the authority to address, in the instituted proceeding, only a subset of invalidity grounds presented in the petition.[17] The SAS decision, however, put an end to the practice of partial institution of claims, instead requiring that the board address all challenged claims. [18] In the recent post-SAS decisions in July 2018 — *Adidas v. Nike* and *BioDelivery Sciences v. Aquestive Therapeutics* — the Federal Circuit further required that the board address all grounds raised in the petition, if the IPR is instituted.[19]

While it is too early to tell how the SAS decision could impact IPR statistics, institution rates may continue to decline after SAS.[20] Before SAS, the partial institution practice allowed the board to meet the one-year deadline to conclude the IPR by selectively addressing claims and grounds.[21] Left with the all-or-nothing requirement after SAS, however, the board may opt for noninstitution when the petition fails to make a strong case for most of the challenged claims and/or most of the invalidity grounds. In other words, after SAS, the board may deny institution when the only other alternative, complete institution, would be wasteful of its limited resources.[22]

Therefore, the statistics have not been unfavorable to patent owners, and after SAS, the statistics may further tilt towards the patent owners.

**Myth: Patent owners too often endure serial challenges to the same patent.**

Critics often complain that the AIA rules allow petitioners to gain an unfair advantage by asserting serial invalidity challenges against the same patent, either in subsequent AIA proceedings or in subsequent district court proceedings.[23] The evidence shows otherwise.[24]

***Patent owners rarely face multiple AIA challenges by different petitioners, and when they do, developments in co-pending litigation are usually the cause.***

The criticism that multiple petitioners too often “gang-tackle” the same patent finds no support in the data. To the contrary, it is rare for multiple petitioners to file separate petitions against the same patent.[25] A USPTO study in June 2017 found that around 85 percent of patents before the PTAB are challenged by only one petitioner, and around 10 percent are challenged by two petitioners filing separate petitions.[26] Facing two or more petitioners in only 15 percent of the cases does not suggest a prevalence of gang-tackling.

Further, the rare instances in which multiple petitioners challenge the same patent are likely dictated by the nature and strategy of co-pending litigation, not gamesmanship. Several circumstances could justify the filing of separate petitions.

Filing multiple petitions is at times the only practical option for defendants in multidefendant district court lawsuits. Particularly in cases in which the patent owner serves the complaint in a staggered fashion, the later-served co-defendants may need to file a separate petition. For example, in popular patent venues such as the Eastern District of Texas or the District of Delaware, the patent owner often names over 10 defendants per suit, but may not serve the complaint on all defendants at the same time.[27] A common reason for this approach: the patent owner may be in settlement discussions with one defendant but not others. In other cases, the patent owner may learn about a new alleged infringer after serving the complaint on others. In such circumstances, the first-served defendant often files its AIA petition within only a few months of service of complaint to have a chance of staying the district court proceeding. The later-served defendant(s), however, may not be able to join the original petition in time and would need to file a separate petition.

Defendants sometimes opt to file separate petitions because their defenses may not be aligned. Often, due to differences between defendants’ accused products, the patent owner has a unique infringement theory with respect to each defendant. As a result, each defendant may have unique noninfringement positions and claim construction positions. Such differences may necessitate separate petitions by the defendants.

***Gamesmanship rarely causes multiple petitions.***

Critics have also claimed that patent owners too often have to endure multiple petitions against the same patent, whether filed by one or multiple petitioners.[28] The rationale is that the current PTAB rules allow “wait and see” gamesmanship, referring to a hypothetical circumstance in which the petitioner holds off on filing a subsequent petition until after seeing the board’s institution decision and claim construction ruling on an earlier petition involving the same patent.[29] In the rare instances that multiple petitions are filed, however, they are generally not due to an attempt at gamesmanship.

The USPTO’s statistics show that multiple petitions are rare: 87 percent of patents before the PTAB are challenged by only one or two petitions.[30] Further, there are legitimate reasons for filing multiple petitions. One justification for multiple petitions is that the invalidity challenges cannot fit within a single petition given the stringent 14,000 word limit.[31] In fact, 63 percent of secondary petitions are filed on the same day as the first petition, most commonly due to this reason.[32] Accordingly, those petitioners often need to file multiple petitions to adequately explain the basis for their invalidity challenges.

The notion that petitioners are engaged in “wait and see” gamesmanship is likewise without support. The USPTO’s statistics show that 84 percent of secondary petitions are filed prior to a decision on institution.[33] Therefore, the vast majority of secondary petitions could not benefit from the board’s ruling or construction in a previous decision.[34]

Lastly, the relatively rare secondary petitions filed after an institution decision are generally filed due to developments in litigation, not an attempt at gamesmanship. Of the relatively rare secondary petitions, about 60 percent are filed as a result of a change in concurrent litigation or by parties seeking to join an existing trial.[35] For example, between the filing of the first and second petitions, the patent owner may take positions on claim construction in the co-pending district court litigation, which would necessitate a subsequent petition. Similarly, near or after the filing date of an AIA petition by a defendant, a patent owner may assert additional claims of the patent against the same defendant or add another defendant to the lawsuit, necessitating a subsequent petition.

***The PTAB already has safeguards against frivolous serial challenges.***

The rare instances in which gang tackling and gamesmanship may have occurred do not necessitate a major overhaul or elimination of the AIA proceedings.[36] The AIA has already given the board broad power to deny any petition where “the same or substantially the same prior art or arguments previously were presented.”[37] In fact, the board has vigorously used this authority to reject petitions raising arguments similar to those raised in the initial examination of the patent and earlier petitions.[38] The board has also used its discretion to deny institution based on multiple factors, including whether the petition is trying to use the patent owner’s response or the board’s institution decision as a road map to cure deficiencies in an earlier petition.[39] The board has further rejected IPR petitions that were deemed to harass patent owners.[40]

Therefore, gang tackling, gamesmanship and harassment against patentees in multiple AIA proceedings are statistically rare occurrences that the PTAB already has existing authority to combat. Accordingly, a major overhaul is not needed.

***Patent owners may have more ammunition to defeat secondary invalidity challenges after SAS.***

Congress formed the AIA proceedings to serve as a cost-effective, streamlined alternative to district

court litigation.[41] Critics, however, have claimed that contrary to the intended purpose, IPRs are often duplicative of the district court proceeding. [42] In particular, critics have claimed that estoppel rules have done little to prevent the petitioner from asserting multiple duplicative invalidity challenges in multiple forums.[43] There is no evidence, however, that duplicative litigation is common. And to the extent duplicative litigation exists, it may decline after SAS.[44]

By way of background, estoppel prevents the petitioner from subsequently asserting any ground that the petitioner raised or reasonably could have raised during an IPR that results in a final invalidity decision.[45] Estoppel applies to subsequent challenges in a proceeding before the USPTO, a district court, or the U.S. International Trade Commission.[46] Before SAS, the petitioner had the option to subsequently challenge the validity of the noninstituted claims.[47] The petitioner also had the option to later assert invalidity grounds that were not instituted in the IPR.[48]

The SAS decision, however, may limit the petitioner's ability to assert secondary challenges in the district court. After SAS, when the board institutes an IPR, it is required to institute all claims and all grounds. [49] As a result, to the extent duplicative litigation regarding invalidity exists, it may decline after SAS.

***After SAS, district courts may be more likely to stay litigation pending IPRs.***

Critics have also claimed that IPRs and district court proceedings often address invalidity challenges to the same patent in parallel, leading to inefficiencies and inconsistencies.[50] For example, when the PTAB institutes only a subset of claims, the co-pending district court case may proceed in parallel as to at least the noninstituted claims.[51] In such cases, some courts have reasoned that a stay is not justified because the IPR(s) would not resolve issues with respect to certain claims involved in the district court case.[52] After SAS, however, the district courts are more likely to stay the litigation, knowing that the PTAB is required to issue a final decision on all challenged claims and all grounds in the petition.[53] Accordingly, parallel litigation may become less common.

Therefore, a major overhaul is not needed because the recent SAS decision may help address patent owner's concerns regarding multiple invalidity challenges.

***Myth: Absent an off-ramp from AIA proceedings, patent owners have no fair opportunity to amend claims.***

Another criticism of the PTAB has been its rare allowance of claim amendments during an AIA proceeding.[54] Critics claim the low success rate has dissuaded patent owners from moving to amend claims.[55] One proposal for overhauling the current amendment procedure in AIA proceedings — the STRONGER Patent Act — is currently pending before Congress. The bill proposes an off-ramp proceeding that would allow patent owners to leave the PTAB to amend the claims before a patent examiner.[56]

For the reasons discussed below, however, there is no compelling need for such drastic changes to the current amendment procedure. The Federal Circuit and the USPTO have already changed the law to improve the patent owner's ability to amend claims in AIA proceedings. An off-ramp proceeding may create more problems than it solves.[57]

***The recent Aqua Products decision could significantly improve patent owners' ability to amend claims in AIA proceedings.***

In its October 2017 Aqua Products decision, the Federal Circuit eased the procedures for patent owners seeking to amend claims.[58] Although the PTAB had initially required the patent owner to prove patentability of the amended claims it proposes,[59] an en banc Federal Circuit lifted the burden of proof from the patent owner.[60] Judge Ruschke followed suit on Nov. 21, 2017, promulgating new guidance for motions to amend based on the Aqua Products decision.[61]

The PTAB's post-Aqua Products decisions suggest that patent owners could face more favorable odds in seeking to amend claims. As of April 2018 — about four months since the issuance of new USPTO guidelines — the PTAB has granted in full or part five motions to amend.[62] While it is too early to draw a definitive conclusion, this represents a significant improvement for patent owners, considering that the board granted only 14 such motions to amend in the prior five years.[63]

Because the recent change in the AIA motion-to-amend practice could make it easier for patent owners to prevail, it would be premature to create an off-ramp at this stage. The better approach would be to wait and see how this new procedure plays out.

***An off-ramp proceeding may not significantly improve patent owners' ability to amend claims.***

Patent owners rarely move to amend claims — in about 8 percent of AIA proceedings[64] — but the low rate may be due less to the PTAB's procedural requirements and more to other strategic considerations. For example, patent owners often forgo motions to amend because amended claims can significantly cut down damages awards in co-pending district court litigation. Under the doctrine of “intervening rights,” the patent owner cannot recover past damages in the district court if claims are substantively amended — regardless of the procedure used for amending the claims.[65] This is a common consideration for patent owners because 85 percent of AIA proceedings stem from one or more co-pending district court cases, the vast majority of which include a damages claim.[66] [67] This can be a strong financial disincentive particularly if the alleged infringement started well before institution of the AIA proceeding at issue, which is often the case. As long as patent owners have a financial incentive to forgo motions to amend, the availability of an off-ramp procedure may not have an appreciable effect

Moreover, an off-ramp may be unnecessary because there are already existing pathways for patent owners to amend or add claims.[68] For example, patent owners can amend claims through reissue or ex parte re-examination proceedings before, during, or after AIA proceedings. [69] Patent owners have already used those existing off-ramps for amendment 50 times.[70] Further, patent owners may have co-pending continuation applications in which they may make amendments or add claims based on the developments in the AIA proceedings.[71]

***An off-ramp may cause more problems than it solves.***

An off-ramp could also undermine one of the objectives of AIA proceedings: speedy resolution of validity-related disputes.[72] By designing a framework intended to complete validity review within 12 months of institution, Congress envisioned the AIA proceeding as an alternative to district court litigation.[73] The PTAB has largely complied with the time requirements.[74] With the introduction of an off-ramp, however, AIA proceedings could be significantly delayed if stayed pending the off-ramp's resolution.[75] And if not stayed, the PTAB and off-ramp proceedings could lead to conflicting results and further delays to resolve the potential inconsistencies.[76]

Given the significant procedural challenges of the off-ramp proposal, the better alternative is to streamline the amendment process within the existing PTAB framework. For example, a current source

of inefficiency is the contingent amendment procedure. In a contingent motion, the patent owner requests that the board evaluate patentability of (1) challenged claims as they stand, and (2) proposed substitute claims in the event the board finds the challenged claims unpatentable.[77] The contingent amendment process, however, compounds the workload of the board by requiring evaluation of two alternative sets of claims.[78] To streamline the proceeding, consideration should be limited to only a single set of claims. That is, the patent owner could be required to select between a review of either the challenged claims or the substitute claims, but not both.

In sum, an off-ramp would likely prove to be a complex and premature solution for a problem that may well be adequately addressed by gradual changes to the amendment process within the current PTAB framework.

Some of the drastic proposals for modifying AIA proceedings to make them more favorable for patent owners rely on myths that are at best supported by outdated or incomplete data. A closer look shows that AIA proceedings are not unfairly prejudicial to patent owners. Pursuing radical changes to these PTAB procedures is not just unnecessary but ultimately counterproductive.

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[3] Tony Dutra, "Rader Regrets CLS Bank Impasse, Comments on Latest Patent Reform Bill," <https://www.bna.com/rader-regrets-cls-n17179879684> (Oct. 29, 2013).

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[6] Source: Lex Machina, PTAB data accessed on March 12, 2018; at the time of publication, 2016 was the last full year for which such PTAB data was available on Lex Machina.

[7] USPTO, Trial Statistics, at 11. The cited statistic takes into petitions that led to a final decision by the PTAB as of Feb. 28, 2018, excluding petitions that were pending, settled, joined, dismissed by parties, or subject to a request for adverse judgment.

[8] Jarrod Wood & Jonathan R. K. 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, 142 (2015).

[9] *Id.*

[10] Ryan Davis, “New AIA Review Rules Strengthen Hand of Patent Owners,” <https://www.law360.com/articles/778766> (March 31, 2016).

[11] 37 CFR § 42.108(c).

[12] USPTO, Trial Statistics, at 7.

[13] Ryan Davis, “PTAB Aims to Make AIA Reviews Fair To All, New Chief Says,” <https://www.law360.com/ip/articles/830607> (Aug. 19, 2016).

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[17] *Id.*

[18] *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018).

[19] See e.g., *adidas AG v. Nike, Inc.*, No. 2018-1180, 2018 WL 3213007, at \*2 (Fed. Cir. July 2, 2018); “Guidance on the Impact of SAS on AIA Trial Proceedings,”

USPTO, [https://www.uspto.gov/sites/default/files/documents/guidance\\_on\\_the\\_impact\\_of\\_sas\\_on\\_aia\\_trial\\_proceedings\\_%20\(april\\_26,\\_2018\).pdf](https://www.uspto.gov/sites/default/files/documents/guidance_on_the_impact_of_sas_on_aia_trial_proceedings_%20(april_26,_2018).pdf) (April 26, 2018); see also *BioDelivery Sciences International, Inc. v. Aquestive Therapeutics, Inc.*, Nos. 2017-1265, 2017-1266, 2017-1268, 2018 WL 3625151, at \*4 (Fed. Cir. July 31, 2018).

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[21] *Id.* 35 U.S.C. § 315(b).

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[24] Dorothy Atkins, “PTAB Chief Debunks Patent Myth as Petitions Soar,” <https://www.law360.com/articles/986011/ptab-chief-debunks-patent-myth-as-petitions-soar> (Nov. 16, 2017).

[25] *Id.*; United States Patent Office, *An Analysis of Multiple Petitions in AIA Trials*, 12, [https://www.uspto.gov/sites/default/files/documents/Chat\\_with\\_the\\_Chief\\_Boardside\\_Chat\\_Multiple\\_Petition\\_Study\\_20171024.pdf](https://www.uspto.gov/sites/default/files/documents/Chat_with_the_Chief_Boardside_Chat_Multiple_Petition_Study_20171024.pdf) (Oct. 24, 2017) (“Analysis of Multiple Petitions”).

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[31] 37 CFR 42.24.

[32] USPTO, *Analysis of Multiple Petitions*, at 17.

[33] *Id.* at 17-19.

[34] *Id.*

[35] Id.

[36] Paul Morinville, et al., “Fundamental Incongruities of PTAB Operations Affect the Integrity of the Patent System,” <http://www.ipwatchdog.com/2017/05/01/incongruities-ptab-operations-integrity-patent-system/id=82738/> (May 1, 2017).

[37] 35 U.S.C. §§ 315(d), 325(d).

[38] See *Cultec, Inc. v. Stormtech LLC*, Case, IPR2017-00777, Paper 7 (PTAB Aug. 22, 2017) (Informative) (denying institution based on similar arguments overcome in examination); *Praxair Distribution Inc. v. Ino Therapeutics, LLC*, IPR2016-00781, Paper 10 (PTAB, Aug. 25, 2016) (denying a petition based on similarity of arguments to those presented in an earlier petition).

[39] *General Plastic Industrial Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB, Sept. 6, 2017) (Precedential).

[40] See *Butamax Advance Biofuels LLC v. Gevo, Inc.*, IPR2014-00581, Paper 8 at 13 (PTAB, Decision Denying Institution, Oct. 14, 2014) (“Allowing similar, serial challenges to the same patent, by the same petitioner, risks harassment of patent owners and frustration of Congress’s intent in enacting the Leahy-Smith America Invents Act.”) (citing H.R. Rep. No. 112-98, pt.1, at 48 (2011)).

[41] 35 U.S.C. § 316(a)(11).

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[46] Id.

[47] Id.

[48] Id.

[49] *adidas AG v. Nike, Inc.*, No. 2018-1180, 2018 WL 3213007, at \*2 (Fed. Cir. July 2, 2018); “Guidance on the Impact of SAS on AIA Trial Proceedings,” USPTO, [https://www.uspto.gov/sites/default/files/documents/guidance\\_on\\_the\\_impact\\_of\\_sas\\_on\\_aia\\_trial\\_proceedings\\_%20\(april\\_26,\\_2018\).pdf](https://www.uspto.gov/sites/default/files/documents/guidance_on_the_impact_of_sas_on_aia_trial_proceedings_%20(april_26,_2018).pdf) (April 26, 2018); see also David W. O’Brien and Clint Wilkins, “U.S. Supreme Court Could Dramatically Reshape IPR Estoppel,” *Intellectual Property Magazine* (UK), September 22, 2017, available at: <https://www.law.berkeley.edu/wp->

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[50] Anne S. Layne-Farrar, *The Cost of Doubling Up: an Economic Assessment of Duplication in PTAB Proceedings and Patent Infringement Litigation*, *Landslide*, Vol. 10, No. 5, May-June (2018), available at: [http://www.crai.com/sites/default/files/publications/The\\_Cost\\_of\\_Doubling\\_Up\\_An\\_Economic\\_Assessment\\_of\\_Duplication\\_in\\_PTAB\\_proceedings\\_Landslide\\_May\\_2018\\_Layne\\_Farrar.pdf](http://www.crai.com/sites/default/files/publications/The_Cost_of_Doubling_Up_An_Economic_Assessment_of_Duplication_in_PTAB_proceedings_Landslide_May_2018_Layne_Farrar.pdf).

[51] *Id.*

[52] *Id.*

[53] Justin M. Philpott and Eric A. Zelepugas, "SAS Institute Inc. v. Iancu: Raising the Stakes to an All-Or-Nothing Game at The PTAB," <https://bannerwitcoff.com/ip-alert-sas-institute-inc-v-iancu-raising-the-stakes-to-an-all-or-nothing-game-at-the-ptab/> (April 20, 2018).

[54] Barbara Mccurdy, et al., "Paths To Successful Motions To Amend At PTAB," <https://www.law360.com/articles/956738/paths-to-successful-motions-to-amend-at-ptab> (Aug. 30, 2017).

[55] Gene Quinn, "Patent Office Defends PTAB Denying Motions to Amend," <http://www.ipwatchdog.com/2016/05/10/new-patent-office-study-defends-ptab-motion-amend-practice/id=69007/> (May 10, 2016).

[56] Supplemental Statement of Judge Paul R. Michel (Ret.) former Chief Judge United States Court of Appeals for the Federal Circuit Before the Subcommittee on Courts, Intellectual Property, and the Internet, Committee on the Judiciary, United States House of Representatives, "The Impact of Bad Patents on American Businesses" (Sept. 12, 2017); Ryan Davis, "Questions Surround Idea for PTAB Amendment 'Off-Ramp,'" <https://www.law360.com/articles/946351> (July 24, 2017); Steve Brachmann, "STRONGER Patents Act Introduced in House, Seeks to Strengthen a Crippled Patent System," <http://www.ipwatchdog.com/2018/03/26/stronger-patents-act-house/id=95188/> (March 26, 2018); Josh Landau, "You Don't Need To Build An IPR Off-Ramp - It Already Exists," <https://www.patentprogress.org/2017/12/04/ipr-offramps-already-exist/> (Dec. 4, 2017).

[57] *Id.*

[58] *Aqua Products, Inc. v. Matal*, 872 F.3d 1290, 1300 (Fed. Cir. 2017).

[59] *Id.*

[60] *Id.* at 1296.

[61] USPTO Memorandum Re: Guidance on Motion to Amend in view of *Aqua Products*, available at: [https://www.uspto.gov/sites/default/files/documents/guidance\\_on\\_motions\\_to\\_amend\\_11\\_2017.pdf](https://www.uspto.gov/sites/default/files/documents/guidance_on_motions_to_amend_11_2017.pdf) (Nov. 21, 2017).

[62] Source: Docket Navigator, PTAB data accessed on April 23, 2018.

[63] United States Patent and Trademark Office, Patent Trial and Appeal Board Motion to Amend Study, <https://www.uspto.gov/sites/default/files/documents/PTAB%20MTA%20Study%20%203%20%20>

update%20through%2020170930.pdf (Sept. 30, 2017) (“Motion to Amend Study”).

[64] USPTO, Motion to Amend Study, at 4; Gene Quinn, “Patent Office Defends PTAB Denying Motions to Amend,” <http://www.ipwatchdog.com/2016/05/10/new-patent-office-study-defends-ptab-motion-amend-practice/id=69007/> (May 10, 2016).

[65] *Laitram Corp. v. NEC Corp.*, 163 F.3d 1342, 1346 (Fed. Cir. 1998); *Bloom Eng’g Co. v. N. Am. Mfg. Co.*, 129 F.3d 1247, 1249 (Fed. Cir. 1997).

[66] See USPTO, Analysis of Multiple Petitions, at 27.

[67] “Intervening rights” could also be a consideration in some of the remaining 15 percent of AIA proceedings because the patent owner may seek to preserve a claim for past damages in future district court proceedings.

[68] Josh Landau, “You Don’t Need To Build An IPR Off-Ramp - It Already Exists,” <https://www.patentprogress.org/2017/12/04/ipr-offramps-already-exist/> (Dec. 4, 2017).

[69] *Id.*

[70] *Id.*

[71] *Id.*

[72] 35 U.S.C. § 316(a)(11)

[73] *Id.*

[74] USPTO FY 2017 Performance and Accountability Report at 57, <https://www.uspto.gov/sites/default/files/documents/USPTOFY17PAR.pdf>.

[75] Ryan Davis, “Questions Surround Idea for PTAB Amendment ‘Off-Ramp,’” <https://www.law360.com/articles/946351> (July 24, 2017).

[76] *Id.*

[77] Barbara Mccurdy, et al., “Paths To Successful Motions To Amend At PTAB,” <https://www.law360.com/articles/956738/paths-to-successful-motions-to-amend-at-ptab> (Aug. 30, 2017); 35 U.S.C. § 316 (d).

[78] How to Fix the Amendment Fallacy, 239 *Managing Intell. Prop.* 38 (2014).