

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Analysis of multiple petitions in AIA Proceedings

(December 2020 update)









Multiple petitions

- How “successful” are multiple petition strategies for petitioners?
- “Challenge”: one petitioner vs. one patent
- Serial petitions
 - Same petitioner vs. same patent, filed > 90 days apart
- Parallel petitions
 - Same petitioner vs. same patent, filed ≤ 90 days apart



Serial petition: petitioner's result

Filed > 90 days apart

1 st Petition		Serial Petition		Reported Result of Attempt
	+		=	Success
	+		=	Success
	+		=	Failure
	+		=	Failure

Serial petitions

- *General Plastic* designated FY17
- Compare FY16 with FY17
- Compare to current

Serial petitions

Metrics for analysis:

FY	Challenges	Serial petition attempts	Attempt rate	Serial petition successes	Success rate
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Serial petitions

	Challenges	Serial petition attempts	Attempt rate	Serial petition successes	Success rate
FY16	1232	89	7%	46	52%
FY17	1160	86	7%	26	30%
FY20	938	21	2%	7	33%

Serial petitions

- What made a successful serial petition in FY20?
 - Patent Owner (PO) asserts new claims in D.Ct (2).
 - PO does not contest adding one or two claims (2).
 - Filing an IPR after CBM found ineligible and merits not reached (3).

Serial petitions

- Observations
 - Success rate dramatically dropped after *General Plastic*.
 - Attempt rate dropped after success rate dropped.
 - Serial petitions were successful when the scope of D.Ct litigation is in flux, or to correct minor errors and omissions.

Parallel petition: petitioner's result

Filed \leq 90 days apart

Inst Inst Inst = Success

Inst Deny Deny = Failure

Inst Inst Deny = Success

Deny Deny Deny = Failure

[order does not change result]

Parallel petitions

- *Comcast v. Rovi*: mid-FY19
- *Trial Practice Guide* update: late FY19
- Compare FY18, FY19, FY20

Parallel petitions

	Challenges	Parallel petition attempts	Attempt rate	Parallel petition successes	Success rate
FY18	1178	182	15%	89	49%
FY19	1033	206	20%	112	54%
FY20	938	145	15%	43	30%

Note: The average number of petitions filed in a serial petition attempt was 2.22 in FY18; 2.37 in FY19; and 2.28 in FY20.

Parallel petitions

- What made a successful parallel petition in FY20?
 - Large number of claims/complex claim set (11)
 - Prior art eligibility/Antedation Issues (12)
 - PO did not contest (20)
 - PO asserted new claims in DCt (1)

Parallel petitions

- Observations

- Attempt and success rate has fallen.
- Over 2/3 of parallel petitions were to cover non-overlapping claim sets on the same art.
- About 1/3 of parallel petitions were to cover uncertain prior art status (e.g., antedation or prior art eligibility).
- If a parallel petition is granted, 90% of the time two petitions were instituted in total.

