Under the USPTO’s former inter partes reexamination proceedings, it could take several years to receive a decision on the ultimate patentability of claims. In the event of a parallel litigation, U.S. district courts were reluctant to stay their judicial proceedings to await the USPTO's result on the viability of the patent, in order to maintain control over their own dockets. Also, under prior inter partes reexamination, a third-party requester had limited opportunity to be heard in the USPTO's assessment of the patent. Therefore, a party took enormous risk in attempting to strike a patent via this avenue. The alternate route to challenge patent validity, via a declaratory judgment action in U.S. district court, also required several years and often posed prohibitively high litigation costs.

Against this backdrop, the America Invents Act (AIA) included provisions for expedited administrative review via inter partes review (IPR), post-grant review (PGR), and transitory covered business method review (CBM). These reviews create a major shift in the ability of a would-be challenger to have patent claims deemed unpatentable, without having to risk losing any voice in the proceeding as in the prior inter partes reexamination, and without incurring the imposing costs, and sometimes delay, of a declaratory judgment of patent invalidity in the U.S. district court. The reviews vary in their requirements for challenging patent claims, which are briefly explained in Part 1, Chapter 1: Introduction to Board Proceedings. Due to the effective dates of the PGR, very few final written decisions have issued that broadly challenge patents under the wide range of patentability challenges available under title 35 of the U.S. Code. However, thousands of documents have already been generated in IPR and CBM proceedings, providing substantial guidance on how the Board views patent eligibility under Section 101, as well as patentability based on printed publications under Sections 102 and 103. The Board has also issued some final written
decisions on indefiniteness, enablement, and written description under Section 112.

When Congress contemplated creating the above administrative trial system, it estimated that the USPTO would preside over approximately 510 administrative AIA trials per year.\footnote{Changes to Implement Post-Issuance Review Proceedings, 77 Fed. Reg. 48,711, 48,724 (Aug. 14, 2012).} Since its inception in September 16, 2012, the Patent Trials and Appeal Board (PTAB or the Board) has reviewed, on average, 120 petitions per month requesting a finding of unpatentability of patent claims. The proceedings have proved much more positive and widely utilized than originally anticipated. This has resulted in a body of case law being developed rapidly. This book takes the approach of reviewing that body of case law and organizing central principles in the Board’s analyses on substantive, procedural, and evidentiary issues.

Under current USPTO practice, Board decisions are not precedential unless so indicated. The Board has designated only a small handful (several dozen) of several thousand documents as precedential, informative, or representative. Although this book discusses patterns in Board decisions, each panel of the Board is not bound by these decisions. However, we have observed notable consistency in the complex framework of decisions, generating a wealth of guidance to parties and practitioners on the Board’s treatment of various issues. The book compiles these decisions as guidance for specific patterns that have arisen during IPR, PGR, and CBM proceedings. This book provides a framework for understanding the Board’s past practices for better predicting actions in future cases and strategizing a case accordingly.

The review procedures have changed the landscape for patent challenges. Moreover, even in the short span of time, the Board proceedings themselves have also changed to accommodate the 18-month statutory framework in which the Board must yield its final written decision for any instituted grounds of unpatentability.

The PTAB trials follow a general procedure for each of the IPR, PGR, and CBM proceedings. Part 1, Chapter 1 of this book introduces these different Board proceedings, including an explanation of their differences and a trial timeline. The Office Patent Trial Practice Guide\footnote{77 Fed. Reg. 48,756 (Aug. 14, 2012).} describes the timeline as follows.

Part 1, Chapters 2–10 follow the phases within the timeline. These chapters provide a summary of the rules and regulations governing IPRs, PGRs, and CBMs at each phase and description of the precedential decisions, informative decisions, and representative decisions showing the Board’s interpretation of the USPTO regulations at these stages.
Part 2 provides guidance on Board decisions that may apply at different points of a Board proceeding. Chapters 11 and 12 describe subtleties of how the Board applies widely known patent concepts of claim construction and patentability in determining whether to institute trial, to allow claim amendments, and to determine patentability in its final written decision. Chapters 13 and 14 respectively cover Discovery and Evidence, and address which information may be introduced into a PTAB trial, how it may be presented, and how to protect information from public disclosure. Chapter 15 explains the formality and timing requirements of motions before the Board, as well as explaining some motions decisions that do not neatly fall within a particular time frame of the Board trial. Finally, Chapter 16 describes the consequences of estoppel for both parties once a final written decision issues.