

Jacqueline (Jackie) Wright Bonilla

Senior Legal Advisor



Deputy Chief Administrative Patent Judge Jackie Bonilla is serving as the Senior Legal Advisor to the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (USPTO). As the Senior Legal Advisor, she counsels the Director of the USPTO on a wide range of patent-related legal and policy issues, including those relevant to America Invents Act (AIA) proceedings at the Patent Trial and Appeal Board (PTAB); the process for Director review of PTAB decisions; litigation before the Federal Circuit and Supreme Court; and PTAB and patent-related precedent, Director guidance, and rulemaking.

Since her appointment as an administrative patent judge in January 2012, Judge Bonilla has conducted numerous post-grant patent trials under the AIA, heard appeals from adverse examiner decisions in patent applications and reexamination proceedings, and rendered decisions in interferences. She has served in several leadership positions at the PTAB, including as Deputy Chief Administrative Patent Judge since March 2019, helping to shape agency policy as it relates to PTAB practice and lead the PTAB as it handles cases and renders decisions in all areas of its jurisdiction.

Prior to joining the USPTO, Judge Bonilla worked for 12 years in private practice, including as a partner at Foley & Lardner, LLP. She also served as a judicial law clerk to the now-retired Chief Judge Randall Rader at the U.S. Court of Appeals for the Federal Circuit.

Judge Bonilla graduated from the University of Virginia School of Law, and she holds a doctorate in pharmacology from the University of Virginia and a bachelor's degree in biochemistry from the University of California, Berkeley.



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JPPCLE

40th Annual Joint Patent Practice Seminar

Jacqueline W. Bonilla
Deputy Chief Administrative Patent Judge & Senior Legal Advisor

September 10, 2024

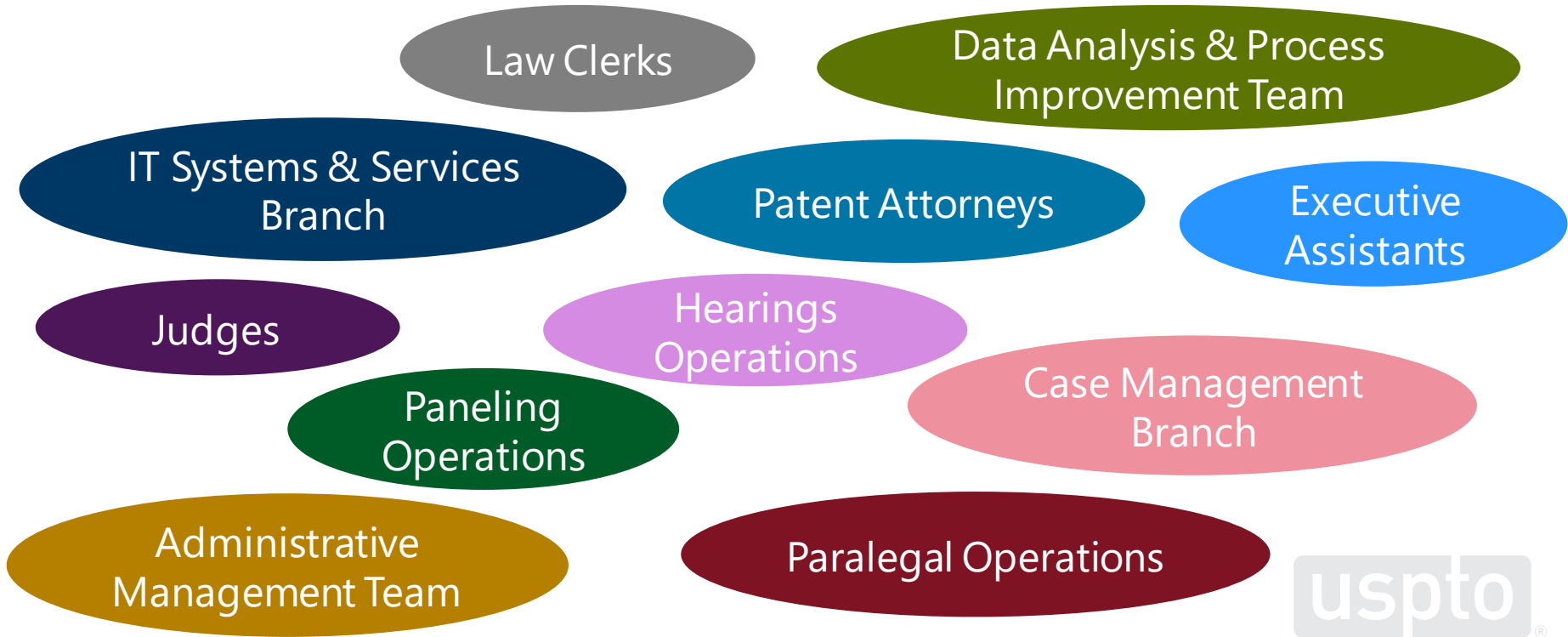


UNITED STATES
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State of the Board

Patent Trial and Appeal Board (PTAB)

THE NUMBERS: ~350 members



FY2023 PTAB case load



- Paneled 5,931 cases
 - 4,608 *ex parte* appeals
 - 1,323 AIA petitions
- Issued 5,911 decisions
 - 4,651 *ex parte* appeals; average pendency of 11.9 months
 - 752 AIA decisions on institution; average pendency of 2.6 months
 - 508 AIA Final Written Decisions; average pendency of 11.8 months

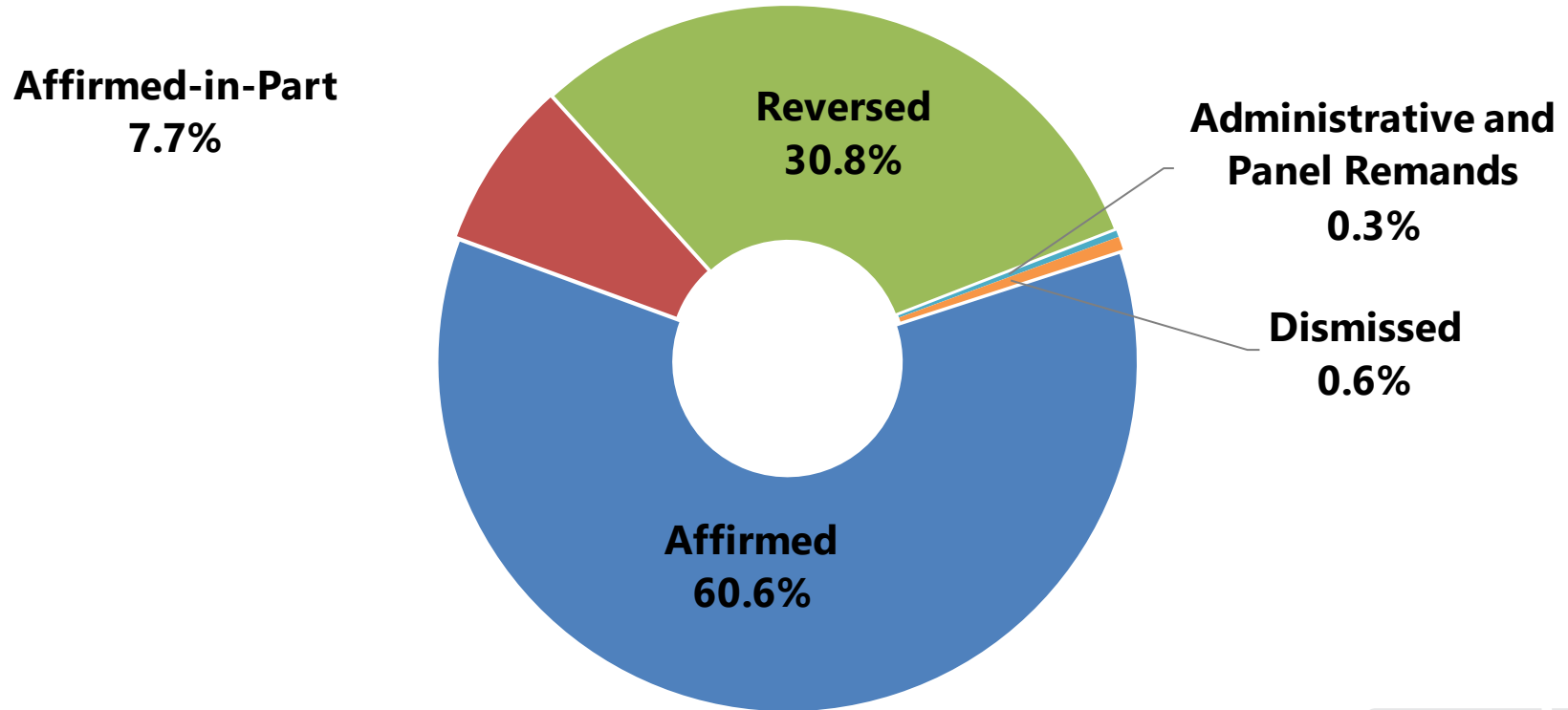
FY2023 hearings

- 868 hearings
 - 405 requests for public audio feed
- 264 in person hearings
 - 132 *ex parte* appeals
 - 132 AIA review hearings
- 604 remote hearings
 - 232 *ex parte* appeals
 - 372 AIA review hearings



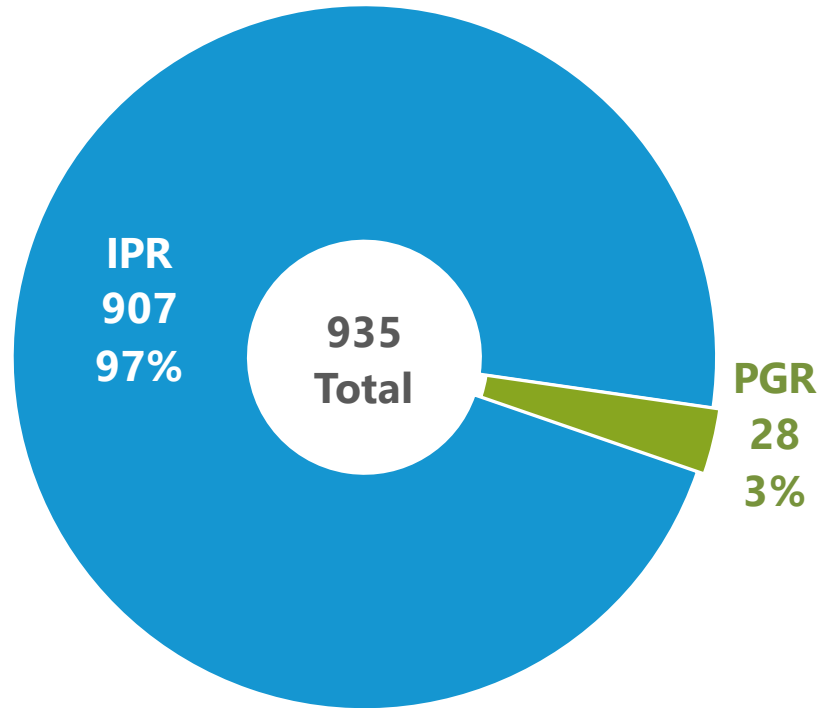
Appeal outcomes in FY24

(Oct. 1, 2023 – Jun. 30, 2024)



AIA petitions filed by trial type

(FY24 through Q3: Oct. 1, 2023 to Jun. 30, 2024)

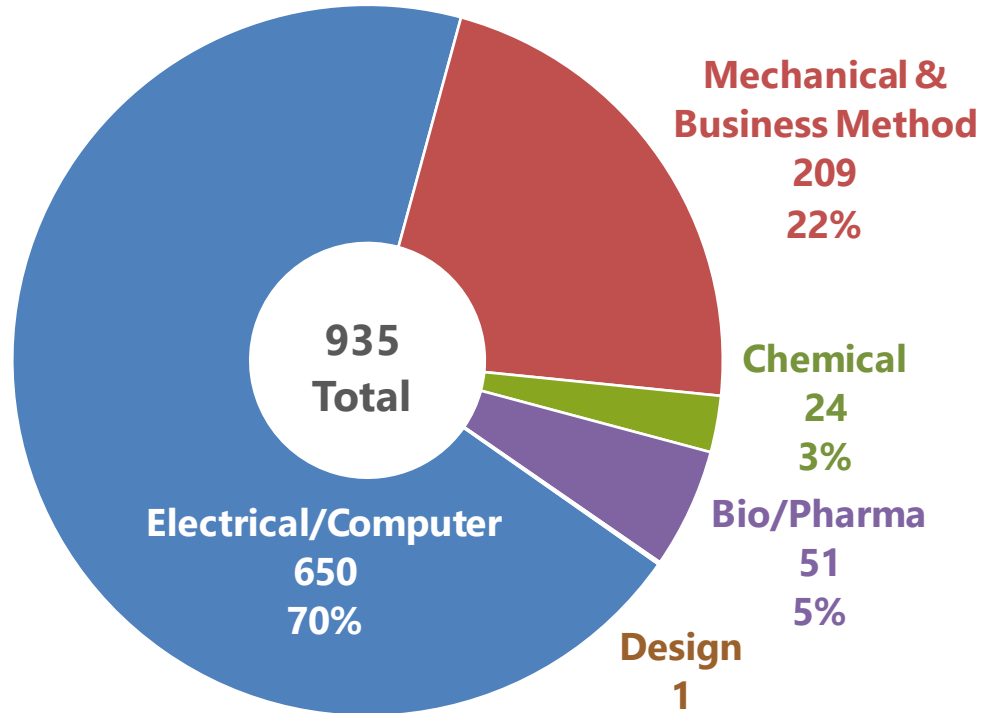


Trial types include Inter Partes Review (IPR) and Post Grant Review (PGR).



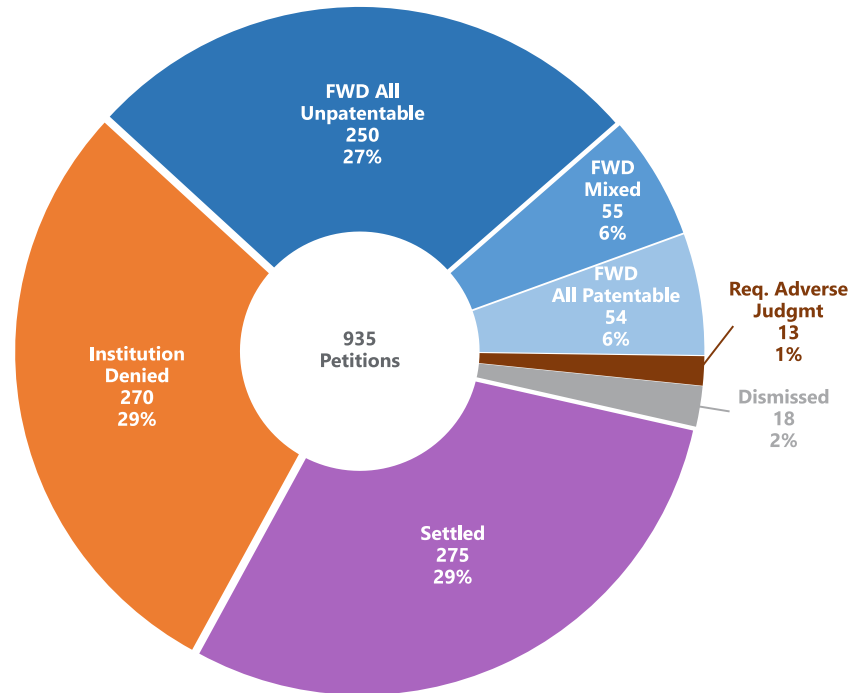
AIA petitions filed by technology

(FY24 through Q3: Oct. 1, 2023 to Jun. 30, 2024)



Outcomes by petition

(FY24 through Q3: Oct. 1, 2023 to Jun. 30, 2024)



FWD patentability or unpatentability reported with respect to the claims at issue in the FWD. Joined cases are excluded.



Director Review

United States v. Arthrex, Inc., 141 S. Ct. 1970, 1986 (2021): The Director “may review final PTAB decisions and, upon review, may issue decisions [herself] on behalf of the Board.”

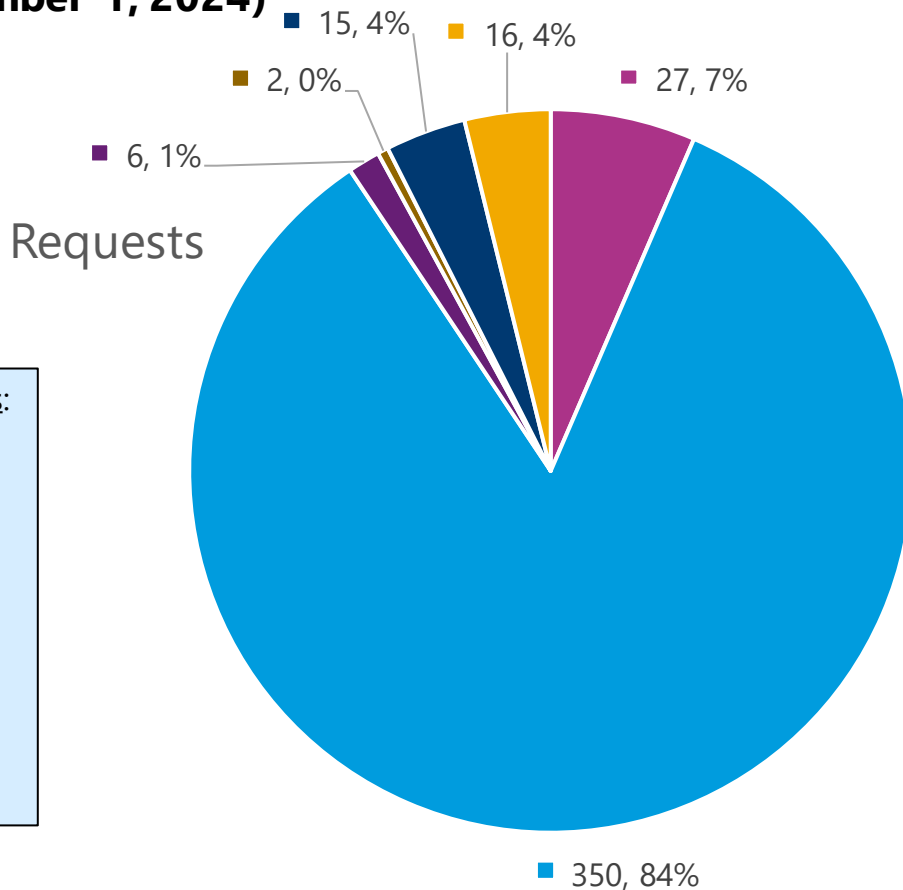
Current interim Director Review process:

- A party may request Director Review of:
 - A decision on institution,
 - A final written decision, or
 - A decision granting a request for rehearing of either of the above.
- A party may request Director Review *or* rehearing by the Board, but not both.
- The Director can initiate Director Review *sua sponte*.

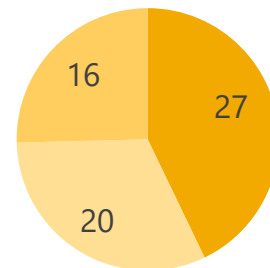


Director Review: Statistics

(through September 1, 2024)



Grants



398 compliant requests:

- 156 requests from Final Written Decisions
- 124 requests from Decisions on Institution
- 118 limited remands post-*Arthrex*

- Party Requests (27)
- Sua Sponte (20)
- POP Conversions (16)



PTAB rulemaking

Final Rule on Pre-Issuance Internal Circulation and Review of Decisions Within PTAB

Effective Date:
July 12, 2024

- **USPTO added new rules 37 C.F.R. §§ 43.1-43.6, which provide:**
 - Prior to issuance of a decision by a PTAB panel, the Director, Deputy Director, and Commissioners for Patents and Trademarks shall not communicate, directly or through intermediaries, with any member of the panel regarding the decision.
 - Similarly, no Management Judge or an officer or employee of the Office external to the Board shall initiate communication, directly or through intermediaries, with any member of a panel regarding a decision prior to issuance.
 - Any individual panel member may optionally request that one or more PTAB Management Judges or an officer or employee of the Office external to the Board provide input on a decision prior to issuance.
 - It is within the sole discretion of the panel to adopt any edits, suggestions, or feedback.
- **89 FR 49808 (June 12, 2024).**



Standard Operating Procedure 1

Effective Date:
June 12, 2024

- Update to SOP1
 - Revises and clarifies paneling guidelines for assigning cases to judges
 - Consistent with new rules 37 C.F.R. §§ 43.1-43.6
 - Consistent with current practice, does not include any procedure for panel expansion
 - Addresses paneling matters related to Director Review
 - Aligns with Board's commitment to meet all statutory deadlines while ensuring reasonable workloads



Notice of Proposed Rulemaking on Motions to Amend

Deadline to
comment closed:
May 3, 2024

- USPTO proposed to amend rules to:
 - Make the motion to amend pilot program permanent, including
 - Issuance of preliminary guidance
 - Option for filing a revised motion to amend
 - Revise rules on burdens of persuasion
 - Preponderance of the evidence standard applies to any new ground of unpatentability raised by the Board
 - Board may consider all evidence of record in the proceeding, including evidence identified in a USPTO prior art search
- 89 FR 15531 (Mar. 4, 2024).



Notice of Proposed Rulemaking on expanding opportunities to practice before the PTAB in AIA proceedings

- USPTO proposed to amend rules to:
 - Allow non-registered practitioners who are recognized pro hac vice to serve as lead counsel
 - Excuse requirement to designate back-up counsel for good cause
 - Provide a streamlined alternative procedure for pro hac vice recognition
 - Clarify duties of counsel recognized pro hac vice
- 89 FR 13017 (Feb. 21, 2024).

Deadline to
comment closed:
May 21, 2024



Notice of Proposed Rulemaking on Director Review

Deadline to
comment closed:
June 17, 2024

- Govern Director Review of PTAB decisions
 - Provide that parties to an AIA proceeding may request Director Review of:
 - Any decision on institution,
 - Any final written decision, or
 - Any decision granting rehearing of such a decision, or any other decision concluding a proceeding brought under 35 U.S.C. §§ 135, 311, or 321
 - Address timing and format of requests for Director Review
 - Provide that Director may initiate review sua sponte
- 89 FR 26807 (Apr. 16, 2024).



Notice of Proposed Rulemaking for briefing discretionary denial issues, and rules for 325(d) considerations, instituting parallel and serial petitions, and termination due to settlement agreement

Deadline to
comment closed:
June 18, 2024

- Proposed rules
 - Enhance and build on existing precedent and guidance PTAB uses in exercising discretion to institute inter partes and post-grant reviews for:
 - serial petitions
 - parallel petitions, and
 - petitions implicating the same or substantially the same art or arguments previously presented to the Office under 35 U.S.C. 325(d)
 - Provide separate briefing process for discretionary institution arguments
 - Align procedures for termination of proceedings pre- and post-institution
- 89 FR 28693 (Apr. 19, 2024).



PTAB outreach

PTAB outreach: Virtual programs

- Boardside Chat webinars

- Series addresses best practices before the Board and answers attendees questions
- www.uspto.gov/patents/ptab/ptab-boardside-chats

- Inventor Hour webinars

- Series covering PTAB proceeding basics for independent inventors and those new to PTAB practice
- www.uspto.gov/about-us/events/inventor-hour-events



PTAB outreach: Nationwide in-person programs

- PTAB and TTAB Stadium Tours
 - Educational sessions and live PTAB *ex parte* appeal and AIA trial proceedings and TTAB opposition proceedings at law schools
 - PTAB and TTAB will visit Florida A&M School of Law (an HBCU) in Orlando, Florida in the fall
 - www.uspto.gov/patents/ptab/ptabttab-stadium-tour



PTAB outreach: Nationwide in-person programs

- PTAB *Ex Parte* Appeals Roadshows
 - Educational sessions sharing best practices for how to succeed in an *ex parte* appeals proceeding
 - Tips for more efficiently filing an appeal brief and making more persuasive written arguments
 - Mock oral argument before a judge panel
 - Gain behind-the-scenes perspectives about what PTAB judges expect and have seen in winning appeals
 - PTAB has visited Los Angeles, Austin, Atlanta, Indianapolis, Philadelphia, and more cities coming this fall
 - www.uspto.gov/patents/ptab/ex-parte-appeal-roadshows



PTAB outreach: Development opportunities

- PTAB Legal Experience and Advancement Program (LEAP)
 - Provides training and oral advocacy opportunities for less experienced advocates in proceedings before the PTAB
 - Events
 - LEAP mock argument trilogy
 - LEAP to Chambers
 - LEAP to Law Schools
 - www.uspto.gov/patents/ptab/leap



PTAB outreach: Development opportunities

- PTAB Moot Court
 - Provides law school students a unique opportunity to develop written and oral advocacy skills in the context of an AIA proceedings
 - www.uspto.gov/patents/ptab/moot-court-competition



PTAB outreach: Legal assistance

- PTAB Pro Bono Program
 - Matches under-resourced inventors with volunteer patent professionals for the purpose of providing free legal assistance in proceedings before the PTAB. Currently open to *ex parte* appeals.
 - www.uspto.gov/PTABprobono
- PTAB Education Clinic
 - Provides free education to members of the public who have questions about proceedings at the PTAB
 - www.uspto.gov/patents/ptab/education-clinic



