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## INSIGHT: SAS Won't Overwhelm the New APJs

### Inter Partes Reviews

Attorney Charles L. Gholz argues that the Jeremiads over the effect of *SAS Institute v. Iancu* on the workload of the board are overblown.



BY CHARLES L. GHOLZ

In the days immediately following *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348, 200 L. Ed. 2d 695, 126 U.S.P.Q.2d 1307, 86 U.S.L.W. 4252 (2018), the blogosphere was full of Jeremiads predicting that the panels of administrative patent judges handling *inter partes* reviews (IPRs) would be unable to decide all of the issues being foisted on them within the 18 months maximum given to them — by 35 U.S.C. § 36(11) — let alone within the “normal” maximum of a year.

As a longtime practitioner before the board in patent interferences, and given my belief that IPRs are somewhat simplified versions of the first phase of patent interferences (i.e., what is commonly referred to as “the motions phase”), those Jeremiads seemed to me to be overwrought, if not downright hysterical. The interference section of the board has long faced (and, in my experience, largely complied with) the following mandate imposed by 37 C.F.R. § 41.200(c):

Patent interferences shall be administered such that pendency before the Board is normally no more than two years.

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Note that that mandate is to complete entire interferences in two years, not simply to complete the first phase of all interferences within two years. Hence, the administrative patent judges handling patent interferences are required to do much more in two years than the APJs handling IPRs are required to do in 18 months.

Since I was unaware of any recent published statistics supporting my belief that the interference section of the board has largely complied with its rule-based mandate to decide patent interferences within two years, I generated the following table, using only recent patent interferences in which board-level decisions were entered at the conclusion of the first phase — that is, not including any of the 20 percent of the recent patent interferences that went on to the second phase. See Gholz and Ricciuti, “Determining Priority of Invention Is Not a Must in Interferences,” 95 PTCJ 593 (April 6, 2018).

Notes:

(1) In an effort to make the interferences for which I calculated pendency as similar to post-SAS IPRs as possible, I did not calculate the pendency of the interferences in which all claims of at least one party were not designated as corresponding to the or a count.

(2) Several of the line items in the table represent a plurality of interferences that were consolidated for disposition, meaning those line items represent disposition of all of the claims in each of those interferences.

All Claims of At Least One Party Designated As Corresponding To the Count or to At Least One Motion Attacking All of the Opponent's Claims Designated As Corresponding To at Least One

Int. No	Declared	One of the Counts	Count Authorized	Decided	Pendency
105,921	04/01/13	Yes	Yes	04/21/14	12 months, 20 days
105,937	04/15/13	No			
105,956	08/16/13	Yes	Yes	01/26/15	17 months, 10 days
105,960	08/28/13	No			
105,961	09/26/13	Yes	Yes	02/12/15	16 months, 16 days
105,982	12/09/13	Yes	Yes	02/03/15	13 months, 24 days
105,988	01/23/14	Yes	Yes	02/11/15	12 months, 18 days
105,996	02/27/14	Yes	No		
106,000	03/28/14	Yes	Yes	09/14/15	17 months, 16 days
106,001	03/31/14	Yes	Yes	02/23/15	10 months, 12 days
106,007	07/18/14	Yes	Yes	04/29/16	21 months, 11 days
106,008	07/24/14	Yes	Yes	09/20/16	13 months, 26 days
106,019	03/31/15	No	Yes		
106,022	04/08/15	Yes	Yes	04/19/16	12 months, 11 days
106,030	07/20/15	Yes	Yes	01/26/17	17 months, 6 days
106,037	10/08/15	Yes	Yes	08/09/16	10 months, 1 day
106,065	08/31/16	Yes	Yes	12/26/17	16 months, 25 days

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(3) In many of the interferences listed in the table, all of the claims of both or all of the parties were designated as corresponding to the or to one of the counts, again meaning those line items represent disposition of more claims than the APJs handling IPRs will typically be asked to dispose of under SAS.

### **Conclusion**

So, it appears that the pre-America Invents Act APJs in the interference section were able to dispose of those

patent interferences that did not go on to a second phase in less than 18 months in all but one of the interferences examined and that they were occasionally able to do so in less than 12 months. Since many of those patent interferences involved more complicated legal issues than the post-AIA APJs deal with in IPRs, I submit that the post-AIA APJs should be able to do the same even after *SAS Institute Inc. v. Iancu*.