

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Patent Trial and Appeal Board (PTAB) Inventor Hour webinar

An introduction to the Board—terminology and processes

Janet Gongola, Vice Chief Administrative Patent Judge

Cynthia Hardman, Administrative Patent Judge

Ryan Flax, Administrative Patent Judge

Eric Jeschke, Administrative Patent Judge

August 26, 2021

UNITED STATES
PATENT AND TRADEMARK OFFICE



What is Inventor Hour?

New **outreach effort** from the U.S. Patent and Trademark Office (USPTO) to inventors and new practitioners

Provides **foundational information** about the USPTO's Patent Trial and Appeal Board (PTAB)

Each **monthly webinar** will present on various aspects of PTAB



Topics for Inventor Hour webinars

This inaugural webinar will provide a broad **overview** of the PTAB and its proceedings.

Future webinars will provide further information on those proceedings, or other aspects of **practice before the PTAB**, such as oral **hearings, statistics,** and PTAB **history.**

Question/comment submission

To send in questions or comments during the webinar, please email:

PTABInventorHour@uspto.gov

Agenda

What is the **PTAB**?

Meet the judges

The basics of **ex parte appeals**

The basics of **post-grant proceedings**
under the America Invents Act

Walk about the **web**



What is the PTAB?

Meet the judges



Janet Gongola



Cynthia Hardman



Ryan Flax



Eric Jeschke



What is the PTAB?

- a. What is the **PTAB** generally?
- b. Who issues **decisions** at the PTAB?
- c. What does the PTAB **do**?

What is the PTAB generally?

A **board** (i.e., a decision-making group) in the USPTO

Created on September 16, 2012, by the **America Invents Act** (AIA)

The Board of Patent Appeals and Interferences (BPAI), became the **Patent Trial and Appeal Board**.



Who issues decisions at the PTAB?

The **Director** of the USPTO

The **Deputy** Director

The **Commissioner** for **Patents**

The **Commission** for **Trademarks**

Approximately 250 administrative **patent judges**
(APJs)



What does the PTAB do?

Reviews examiner work product

Appeals in ex parte proceedings

Appeals in reexamination proceedings and reissue applications

Conduct trials of issued patents (AIA trials)

Conducts interferences



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Inventor resources

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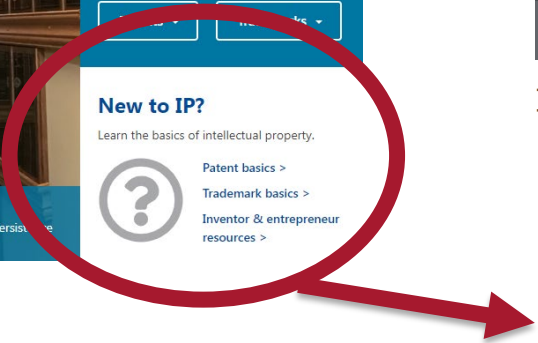
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Driving innovation
Audrey Sherman, a leading inventor of adhesives at 3M, shows what's possible through persistence and collaboration. [FULL STORY>](#)



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Inventor and entrepreneur resources

<p>Get started</p> <p>Learn about types of intellectual property (IP) and how to protect your idea or product.</p> <ul style="list-style-type: none"> > Types of IP protection > Attend a free training > Patents basics > Trademark basics 	<p>Before you apply</p> <p>Search existing patents and trademarks to find out if your idea is unique. If it is, create an account.</p> <ul style="list-style-type: none"> > Search patents > Search trademarks > Create an account to apply 	<p>Get help to apply</p> <p>Set yourself up for success by learning via USPTO's free resources and find expert help.</p> <ul style="list-style-type: none"> > Find resources near you > Watch our videos > Find a patent attorney > Do I need a trademark attorney? 	<p>Apply for IP rights</p> <p>Submit your application for a patent or trademark. See if you qualify for reduced patent fees.</p> <ul style="list-style-type: none"> > Apply for a patent > Apply for a trademark > Costs to file > Reduced patent fees
<p>After you apply</p> <p>As your patent or trademark is examined you may need to take additional steps.</p> <ul style="list-style-type: none"> > Check application status > Respond to a Patent decision > Prepare for a patent interview > Respond to a Trademark decision 	<p>Appeal or fix an issue</p> <p>An applicant may petition a procedural rule or issue, or appeal a patent rejection or trademark refusal.</p> <ul style="list-style-type: none"> > Learn about patent petitions > Learn about trademark petitions > Learn about trademark appeals 	<p>Entrepreneur resources</p> <p>Learn about small business resources at the USPTO and other federal agencies.</p> <ul style="list-style-type: none"> > Startup resources > License or sell your IP > Change patent owner > Change trademark owner > Other federal resources 	<p>Protect yourself</p> <p>Don't be misled by false claims, scams, or companies offering services for unusually low prices.</p> <ul style="list-style-type: none"> > Known patent scams > Known trademark scams > Prevent or report a scam

The basics of ex parte appeals

The basics of ex parte appeals

- a. What are **ex parte appeals**?
- b. What **rules and law** apply in an ex parte appeal?
- c. What are the possible **outcomes** on appeal?
- d. What happens **after** an ex parte appeal is over?

What are ex parte appeals?

After an application is filed, an examiner decides if it meets various requirements.

If not, the examiner may issue a “rejection”

When the examiner has **twice** rejected the claims or issued a “**final**” office action, the applicant can seek review by the PTAB.

What are *ex parte* appeals (cont.)?

Begins with “**appeal brief**” filed by appellant and then “**answer**” filed by the examiner

Appellant may file a “**reply**”

Decided by a **panel** of at least three administrative patent judges (or statutory members)

What rules and law apply?

- Law of the U.S. Supreme Court and U.S. Court of Appeals for the Federal Circuit
- 35 U.S.C. (Patents)
- 37 C.F.R. Part 41
- Precedential PTAB decisions
- Manual of Patent Examining Procedure (MPEP)
 - Guidance to the PTAB

What are the possible outcomes?

The outcome may be an affirmance, an affirmance-in-part, a reversal, or new ground(s) of rejection

Affirmance: rejection of each and every claim is upheld

Affirmance-in-part: rejection of at least one claim, but not all, is upheld

Reversal: None of the examiner's rejections are upheld

New ground(s) of rejection: Judges issue a new rejection of one or more claims

What happens after an appeal?

The outcome dictates who is responsible for taking the next step

If the outcome is an **affirmance or new ground(s)** of rejection, the **applicant** must take the next step

If the outcome is an **affirmance-in-part**, the **applicant** may take the next step

If the outcome is a **reversal**, the **examiner** will take the next step

Question/comment submission

To send in questions or comments during the webinar, please email:

PTABInventorHour@uspto.gov

Fast-track pilot programs



Fast-Track Appeals Pilot Program

- Pilot program to expedite ex parte appeals before the PTAB
- Appellant can request appeal be expedited out of turn by filing a petition and a fee
- Learn more about the Fast-Track Appeals Pilot Program at: www.uspto.gov/patents/ptab/fast-track-appeals-pilot-program

Fast-Track Pilot Program for Appeals Related to COVID-19

- Pilot program to expedite ex parte appeals related to COVID-19 before the PTAB
- Appellant can request appeal be expedited out of turn by filing a petition **WITHOUT** a fee
- Learn more about the Fast-Track Pilot Program for Appeals Related to COVID-19 at: www.uspto.gov/patents/patent-trial-and-appeal-board/covid-fast-track-appeals-pilot-program



The basics of post-grant proceedings under the America Invents Act

The basics of AIA trials

- a. What are **AIA trials**?
- b. What **types** of AIA trials exist?
- c. Who can **start** an AIA trial?
- d. Who is **involved** in an AIA trial?
- e. How does an AIA trial **work**?
- f. What **rules and law** apply in an AIA trial?
- g. What are the possible **outcomes**?

What are AIA trials?

America Invents Act (AIA) – Congress revised the Patent Act to provide an *alternative* way to settle patent validity disputes besides district court litigation

AIA trials are intended to be **streamlined**, **efficient**, and **cost effective**

What types of AIA trials exist?

Inter Partes Review (IPR): from 9 months after patent grant throughout the life of the patent; can challenge claims based on prior art (patents or printed publications)

Post-Grant Review (PGR): from patent grant through 9 months; can challenge claims based on prior art and other bases

Derivation: 1-year from claim publication; determines correct inventor; alleges another derived the invention from the correct inventor

Who can start an AIA trial?

Most people or **corporate entities** other than the patent owner can file a “petition”

Petition fee is required to file

U.S. government cannot

Certain people or corporations may be barred from filing due to their behavior

Who is involved in an AIA trial?

Petitioner = challenger

Files petition challenging a U.S. patent; must pay a filing fee

Carries legal burden throughout proceeding to prove claims are not patentable

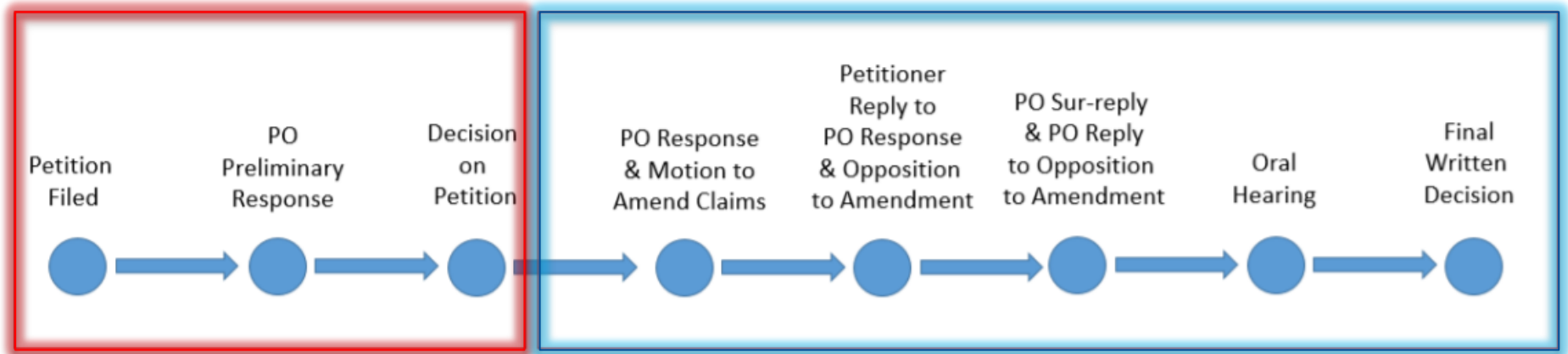
Patent owner

Has opportunities to represent their interests

Panel of at least three administrative patent judges (or statutory members)



How does an AIA trial work?



Institution phase

Trial phase

What rules and law apply in an AIA trial?

U.S. Supreme Court and U.S. Court of Appeals for the Federal Circuit

35 U.S.C. §§ 311-329 (statutes governing IPRs and PGRs)

37 C.F.R. §§ 42.1-42.412 (rules/regulations for trials in general, and IPRs, PGRs, and Derivation Proceedings)

Precedential PTAB decisions

<https://www.uspto.gov/patents/ptab/precedential-informative-decisions>

Consolidated Trial Practice Guide, Nov. 2019



What are the possible outcomes?

The outcome may be that all challenged claims are upheld, some challenged claims are upheld, or none of the challenged claims are upheld.

All claims patentable: Each and every challenged claim upheld

Mixed: At least one challenged claim, but not all, upheld

All claims unpatentable: No challenged claim upheld

Options for patent owner after a final written decision

Seek panel rehearing

Seek Director review

Appeal to the Federal Circuit

Inventors Digest

www.inventorsdigest.com



Monthly issues, each featuring articles about USPTO

Starting in September, monthly articles about PTAB

Free online



Walk about the web

New to PTAB?

Independent inventors, new practitioners, and others can explore the links below to better understand the Patent Trial and Appeal Board's (PTAB) role during and after the patenting process.



What is PTAB?

PTAB is a tribunal within the USPTO that reviews rejections made by examiners in proceedings called ex parte appeals and decides patentability questions for issued patents raised by third parties in proceedings called AIA trials.

- > [More about PTAB](#)
- > [More about PTAB Hearings](#)



Ex parte appeals

If a patent examiner twice rejects or issues a final rejection in a patent application, the applicant can seek review of the rejection by the Board.

- > [What are ex parte appeals?](#)



AIA proceedings

A third party who is not the patent owner, called a petitioner, may challenge the validity of the claims in an issued patent in an AIA proceeding before the Board.

- > [More about AIA proceedings](#)



Any questions?

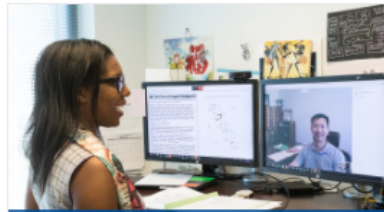
Contact PTAB or peruse helpful FAQs.

- > [Get help](#)



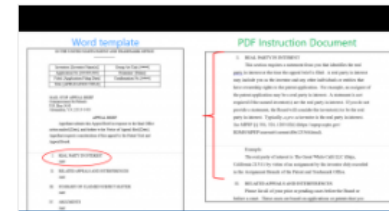
PTAB BOARDSIDE CHAT WEBINARS

The PTAB Boardside Chat series highlights best practices and answers questions raised by attendees



TEMPORARY CHANGE

PTAB conducts remote hearings



EX PARTE APPEAL BRIEF TEMPLATE

Provides help in drafting an ex parte appeal brief for independent inventors and others

Question/comment submission

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Next Inventor Hour webinar



- **September 23, 2021**, from noon to 1 p.m. ET
- Topics
 - Meet an APJ
 - Appeal Bytes (information on ex parte appeals)
 - Walkabout the PTAB webpage
 - Trial Bytes (information on AIA trials)
 - Conquer the stats



Future Inventor Hour webinars

- **October** 28, 2021, from noon to 1 p.m. ET
- **November** 18, 2021, from noon to 1 p.m. ET
- **December** 16, 2021, from noon to 1 p.m. ET

