

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# Patent Trial and Appeal Board Inventor Hour webinar: episode 3

Janet Gongola, Vice Chief Judge for Strategy

Jeff Fredman, Administrative Patent Judge

Cynthia Hardman, Administrative Patent Judge

Eric Jeschke, Administrative Patent Judge

October 28, 2021

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# Agenda



Meet a Judge



Appeal Byte: how PTAB reaches a decision



Trial Byte: Patent Owner strategies



Walkabout the PTAB webpage

\*INFORMATION NOT INTENDED AS LEGAL ADVICE



# Question/comment submission

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# Meet a Judge: Frances Ippolito



Frances Ippolito  
Administrative Patent Judge



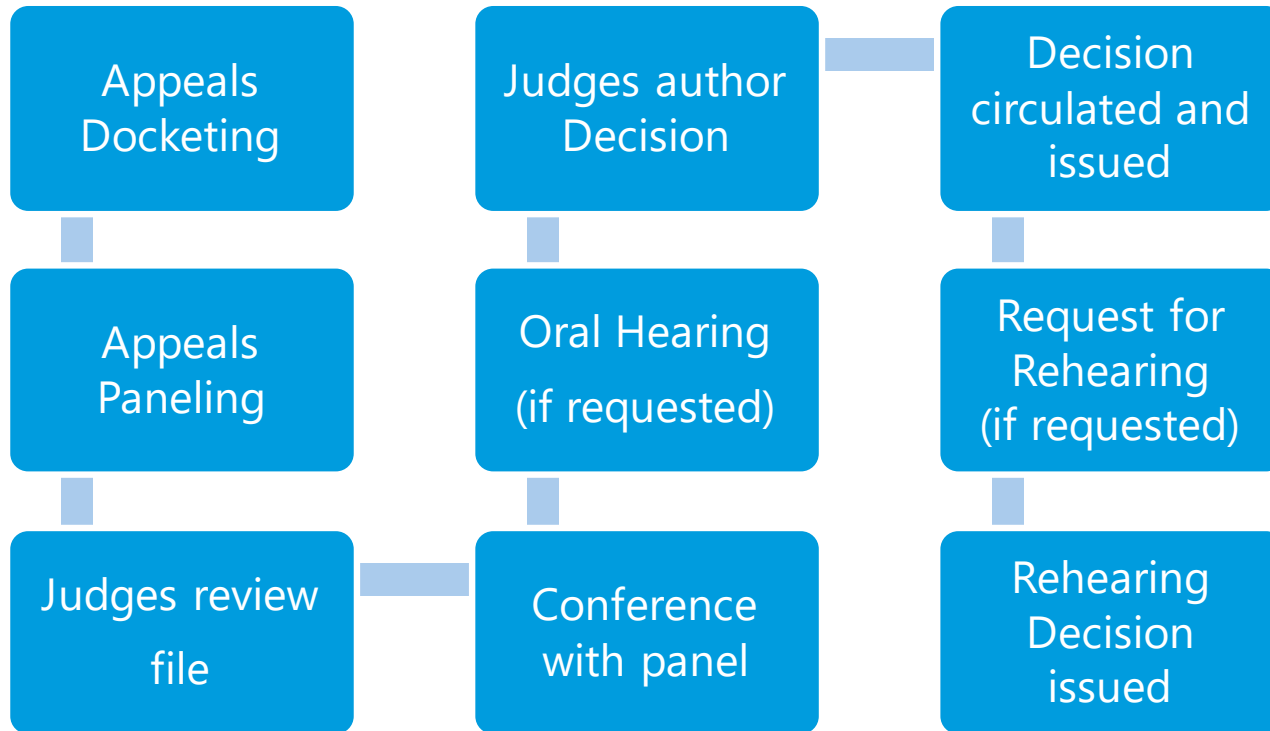
Jeff Fredman, Administrative Patent Judge



# Appeal Byte:

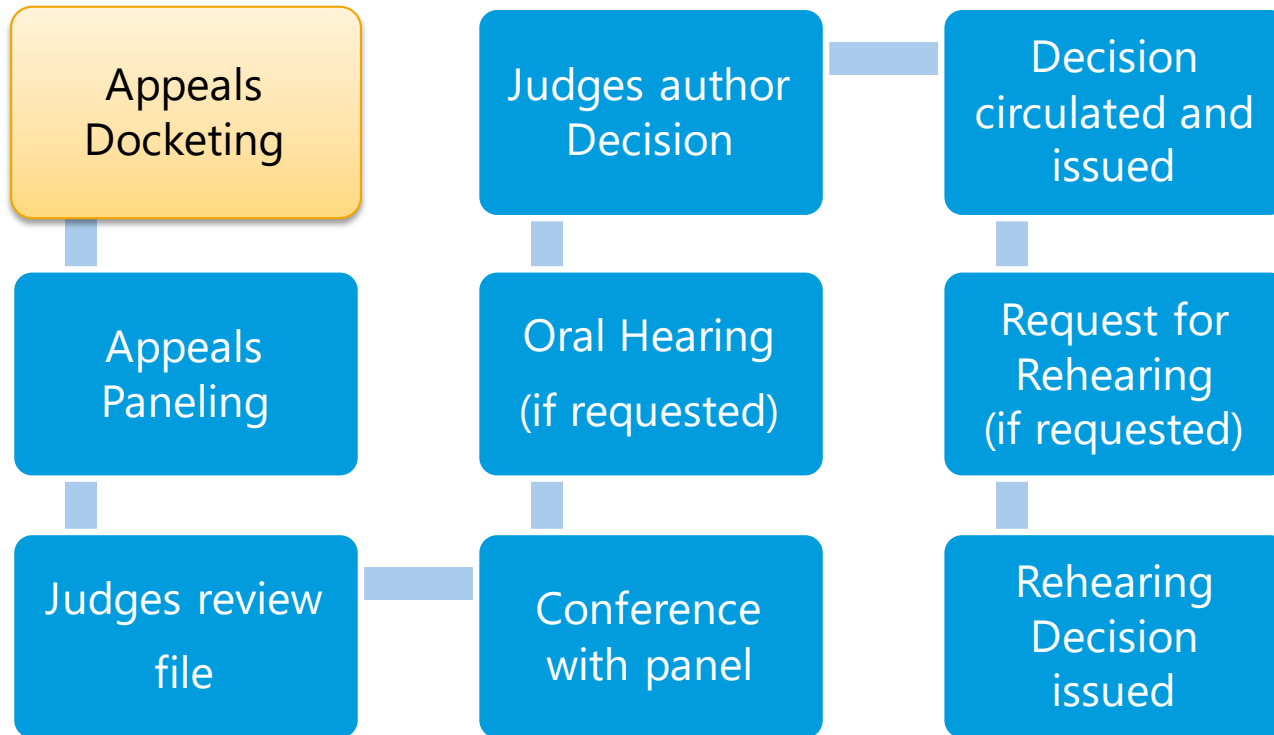
How the PTAB reaches a decision in *ex parte* appeals

# Ex parte appeals process

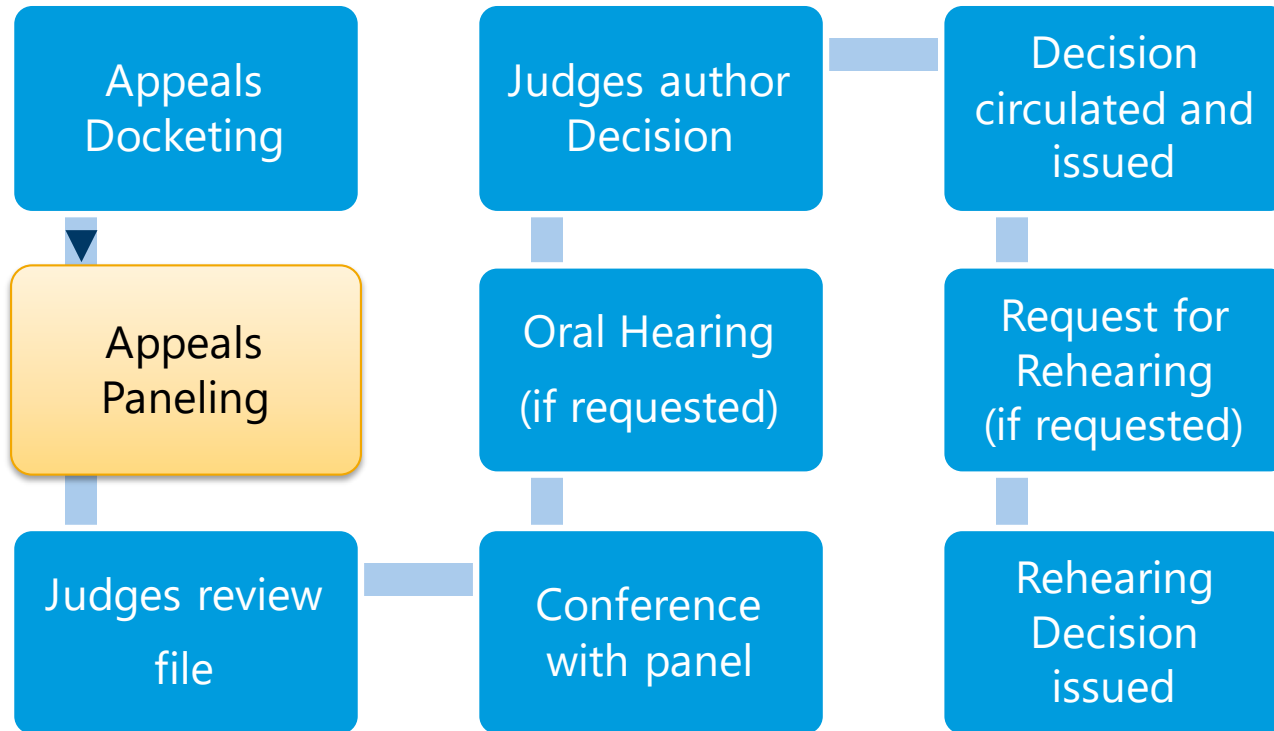




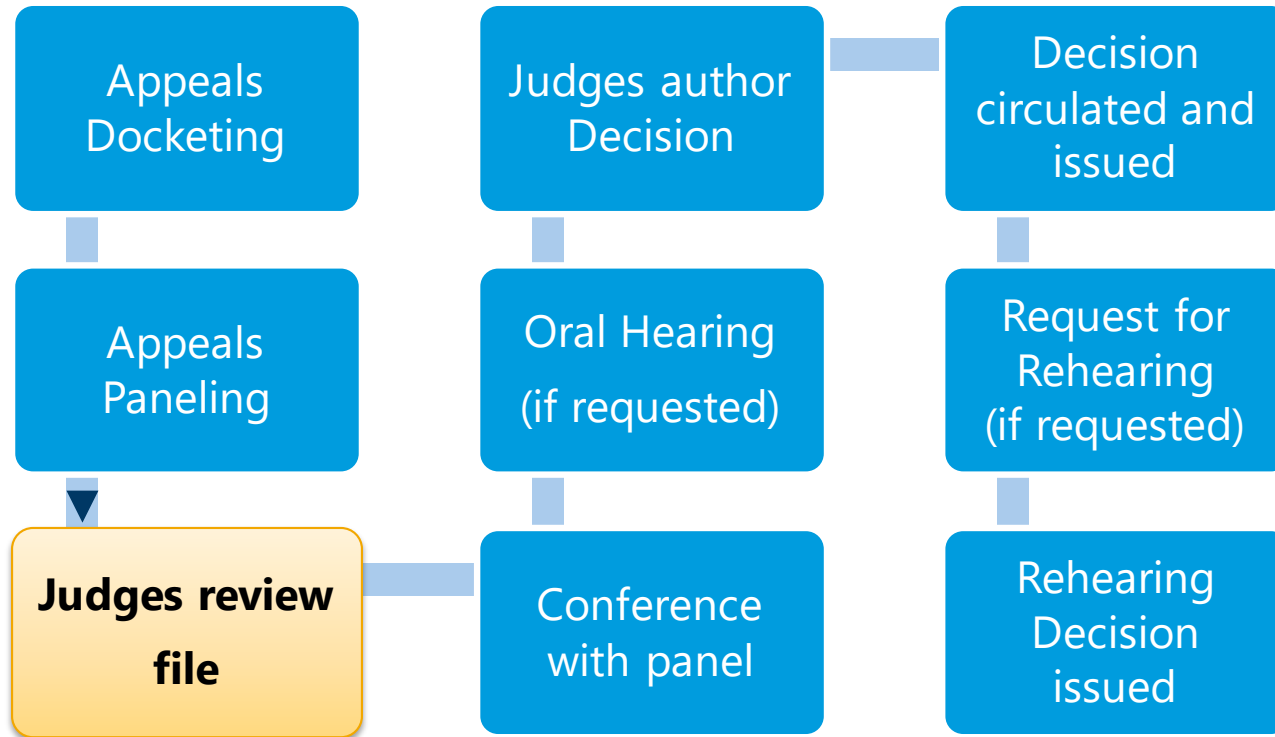
# Ex parte appeals process



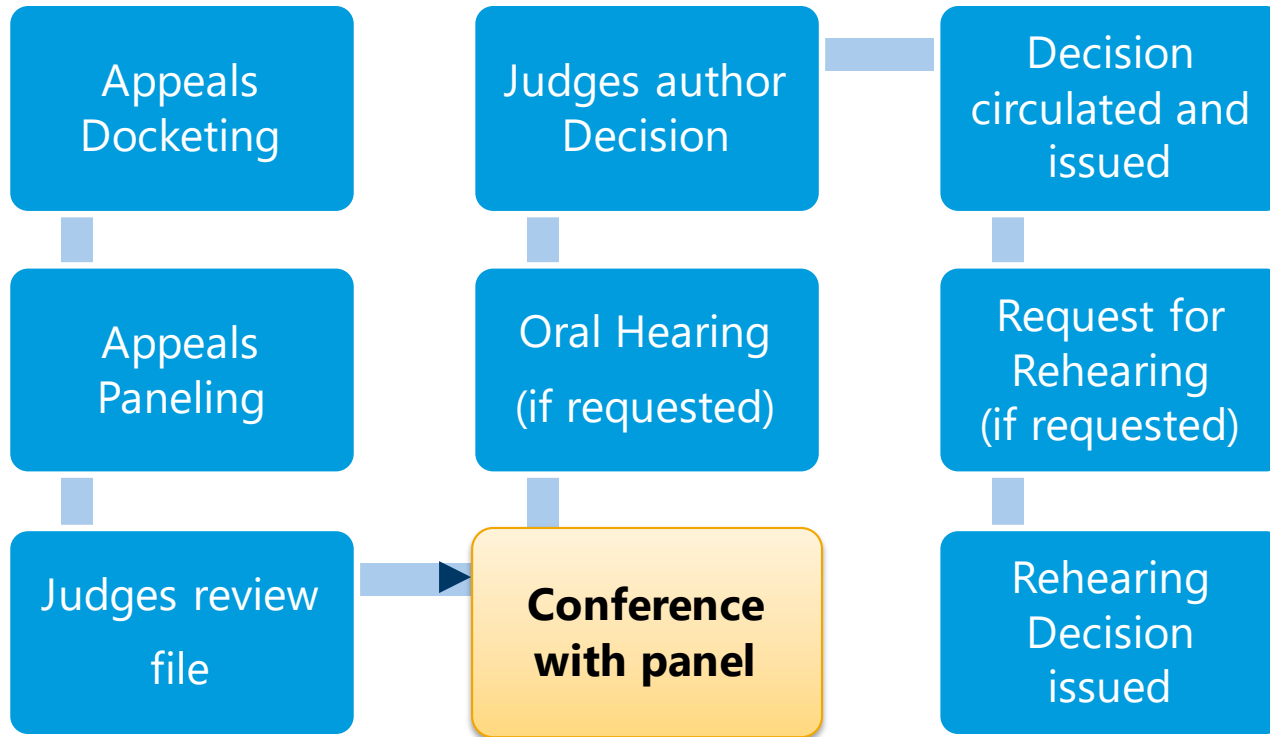
# Ex parte appeals process



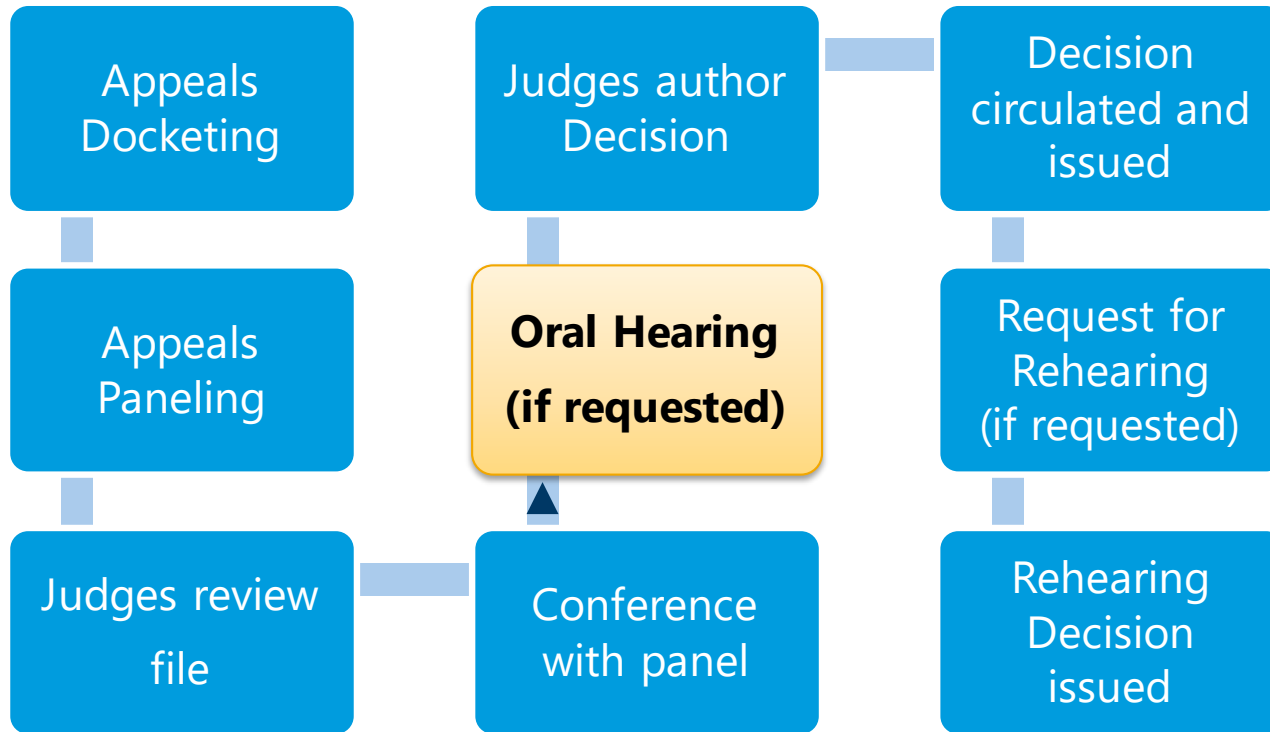
# Ex parte appeals process



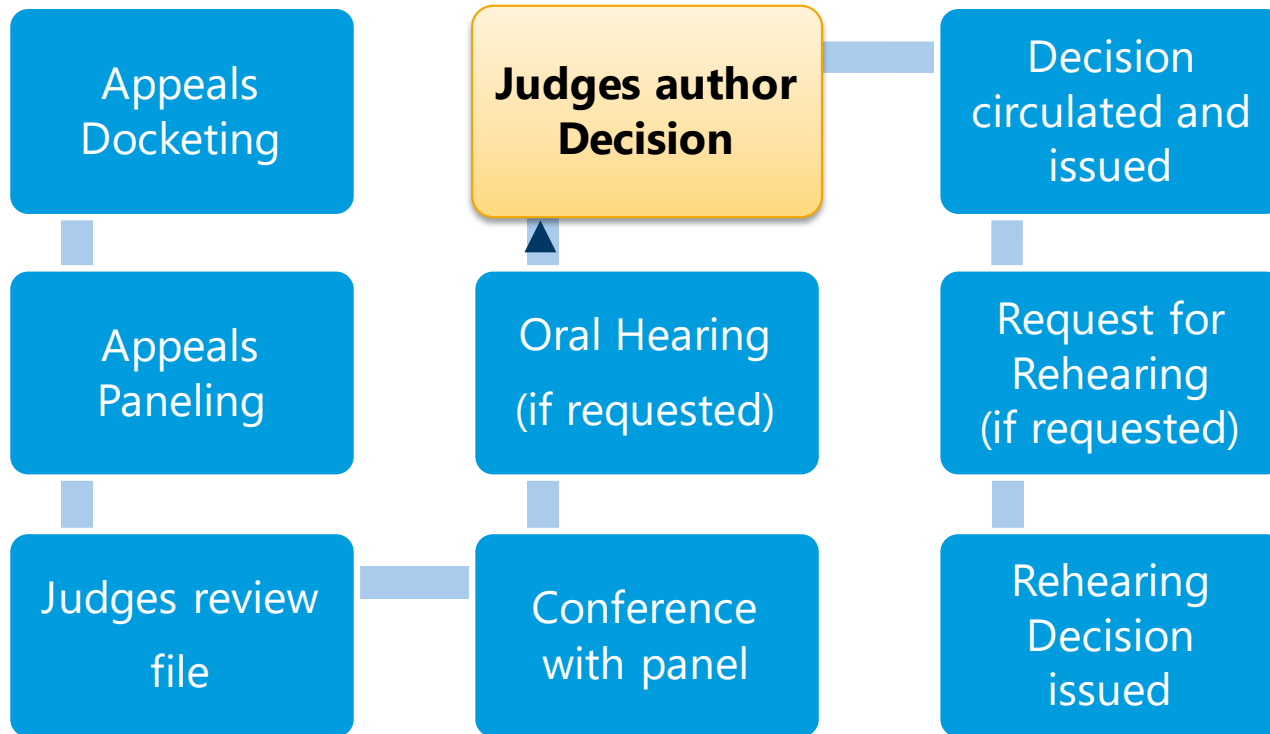
# Ex parte appeals process



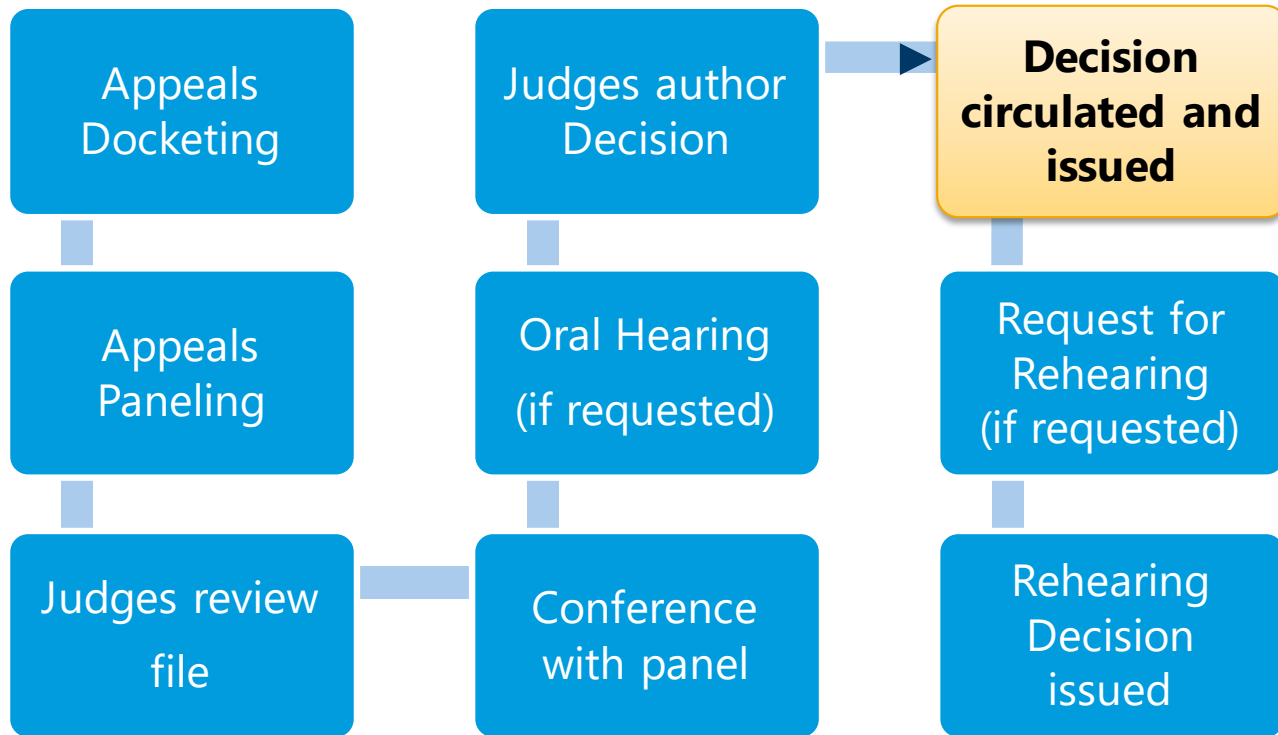
# Ex parte appeals process



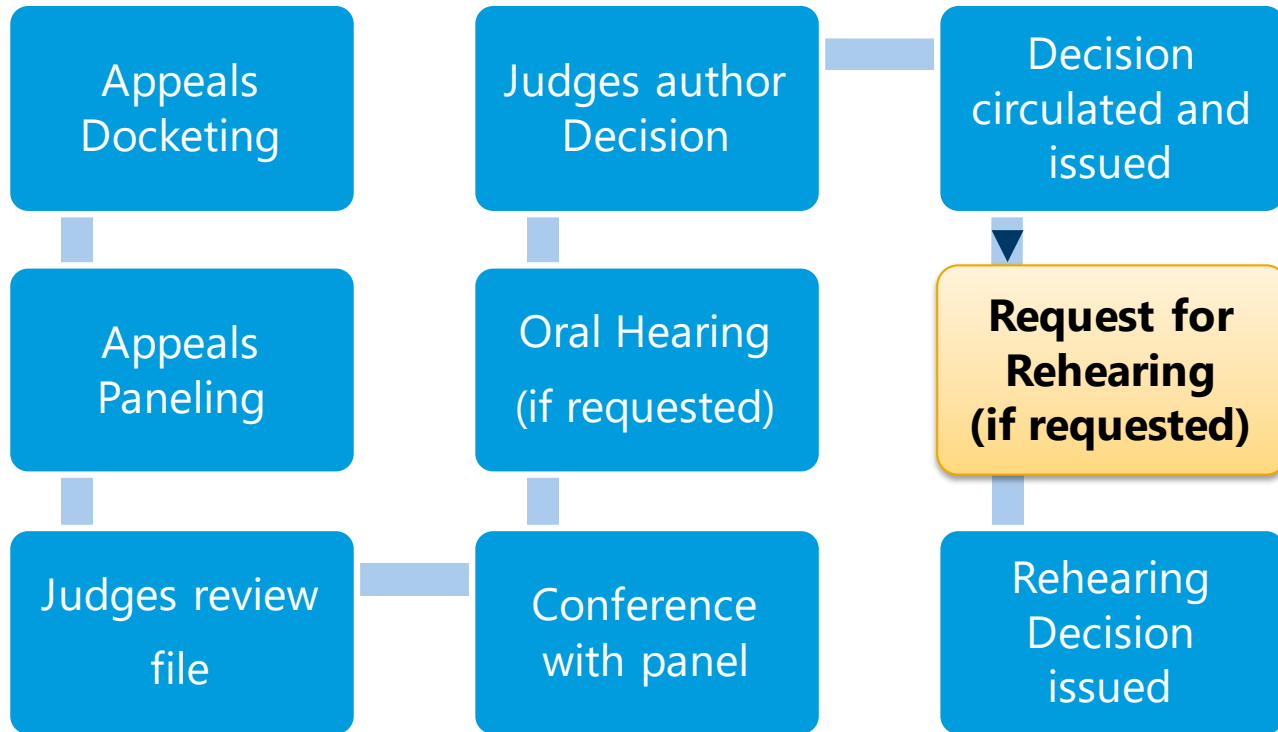
# Ex parte appeals process



# Ex parte appeals process

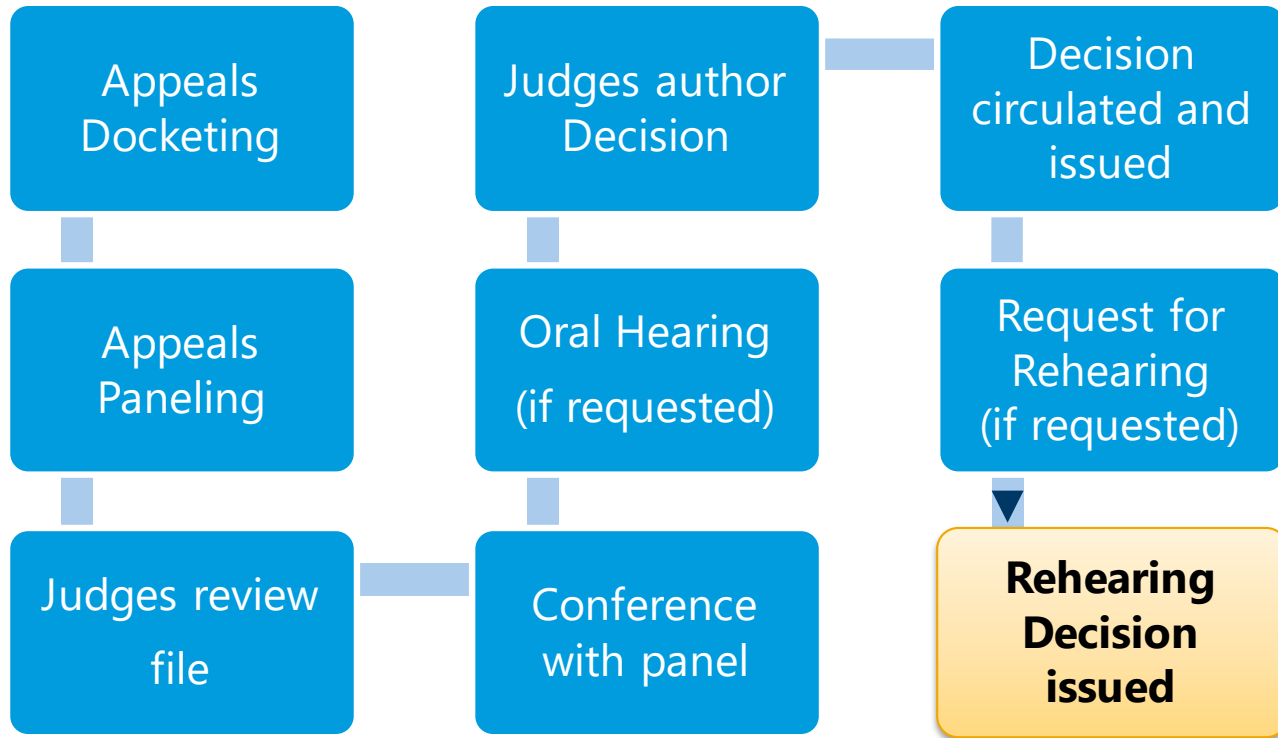


# Ex parte appeals process





# Ex parte appeals process



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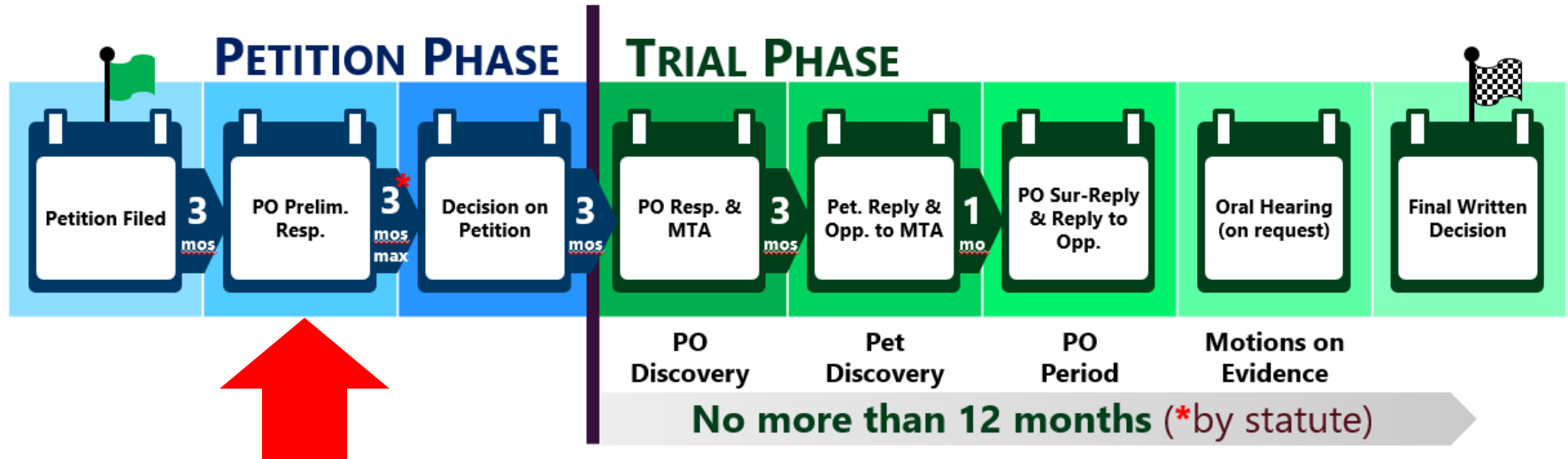
Cynthia Hardman, Administrative Patent Judge



# **Trial Byte:**

**Petition phase strategies for Patent Owners**

# Patent Owner Preliminary Response



# Overview of potential patent owner strategies

- Disclaimer of one or more challenged claims
- Patent Owner Preliminary Response (optional)
- Discretionary denial arguments
  - 35 U.S.C. §§ 314/324; § 325(d)

# Disclaimer

- “No inter partes review will be instituted based on disclaimed claims.”
  - 37 C.F.R. § 42.107(e).
- A statutory disclaimer can streamline the proceedings.

# Patent Owner Preliminary Response is optional

- “The patent owner *may* file a preliminary response to the petition.”
  - 37 C.F.R. § 42.107(a).
- A preliminary response can address reasons why the Board should decline to institute review of the challenged patent.

# Discretionary denial

- Institution of IPR and PGR is discretionary.
- USPTO Director is “permitted, but never compelled” to institute IPR or PGR.
  - See, e.g., 35 U.S.C. §§ 314, 324; *Harmonic Inc. v. Avid Tech. Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016).



# 1. Discretionary denial – multiple petitions

- Institution may be denied where **multiple petitions** are filed against the same patent.
  - Serial petitions (sequential in time)
  - Parallel petitions (at approximately same time)

## 2. Discretionary denial – failure to identify grounds with particularity

- 35 U.S.C. § 312(a): “A petition . . . may be considered only if . . . the petition identifies, in writing and **with particularity**, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim . . . .”

# 3. Discretionary denial – parallel litigation

- Institution may be denied based on the state of a [parallel litigation](#).

## 4. Discretionary denial – § 325(d)

- Institution may be denied if **the same or substantially the same** prior art or arguments previously were presented to the Office.

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Eric Jeschke, Administrative Patent Judge



# Walkabout the PTAB webpage

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Board Decisions

Decision Date: 06/29/2021 - 07/29/2021

612 results found Page refreshed 9:57:02 AM

	Proceeding #	Application #/Reexam Control #	Appellant/PO/Respondent	Board Decision	Decision Date	Proceeding Type	Decision Type	Tech Center
	2020006406	15533514	HEWLETT-PACKARD DEVELOPMENT COMPANY, L.P.	Reversed	07-28-2021	Appeal	Decision	2800
	2020003521	15171404	Corning Incorporated	Denied	07-28-2021	Appeal	Rehearing Decision	2800
	2020006292	16526459	Elliott Beaber	Affirmed	07-28-2021	Appeal	Decision	1700
	2021000204	15381229	Lenovo (Singapore) Pte. Ltd.	Reversed	07-28-2021	Appeal	Decision	2800
	2021001246	14744242	Gregory Aharonian	Affirmed	07-28-2021	Appeal	Decision	1700
	2020002593	15094119	Samsung Electronics Co., Ltd.	Reversed	07-28-2021	Appeal	Decision	2400
	2020002880	14162018	P2S Media Group Oy	Reversed	07-28-2021	Appeal	Decision	2400
	2021000394	15535443	KONINKLIJKE PHILIPS N.V.	Affirmed	07-28-2021	Appeal	Decision	3700
	2021000715	15827132	United Technologies Corporation	Affirmed	07-28-2021	Appeal	Decision	3700
	2021000732	15977736	Taylor Hall	Affirmed	07-28-2021	Appeal	Decision	3700
	2020003861	15507005	CORNING INCORPORATED	Affirmed	07-28-2021	Appeal	Decision	1700
	2021001237	14388575	Altor BioScience Corporation	Affirmed	07-28-2021	Appeal	Decision	1600





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Appellant/PO/Respondent Tech Center >

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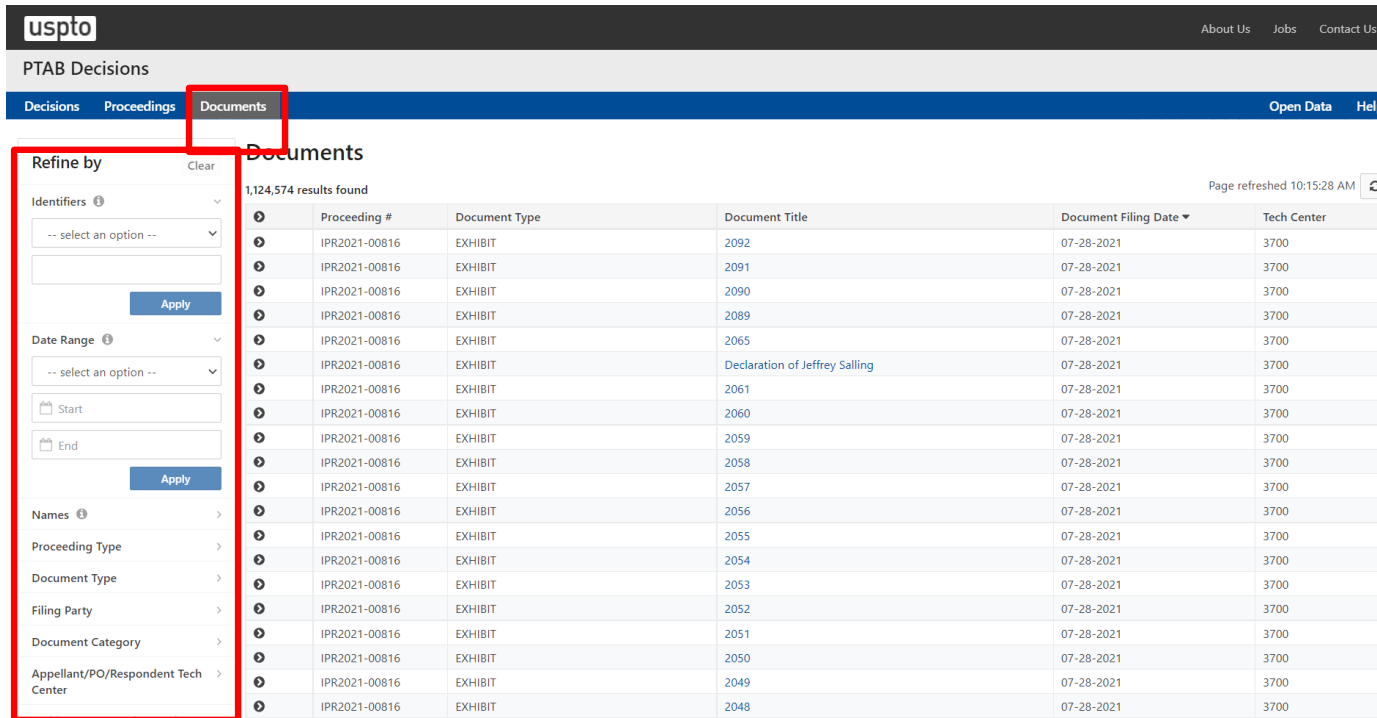
### Proceedings

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Proceeding #	Patent #	Application # / Reexam Control #	Appellant/PO/Respondent	Proceeding Status	Proceeding Filing Date	Tech Center
IPR2021-01238	10526882	15183387	-	Submitted	07-28-2021	3600
IPR2021-01208	9545176	12621950	-	Submitted	07-28-2021	3700
IPR2021-01318	8781868	13902893	-	Submitted	07-27-2021	3600
PGR2021-00104	10820446	16243732	-	Submitted	07-26-2021	3700
IPR2021-01241	10791936	16586528	-	Submitted	07-26-2021	2100
IPR2021-01296	9372580	13332945	-	Submitted	07-26-2021	2600
IPR2021-01317	9146777	13750696	-	Submitted	07-26-2021	2100
PGR2021-00102	10907459	17022972	-	Submitted	07-26-2021	3600
PGR2021-00103	10815764	16946082	-	Submitted	07-26-2021	3600
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IPR2021-01304	8478036	13410577	-	Submitted	07-24-2021	2600
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IPR2021-01246	6591153	09974801	-	Submitted	07-23-2021	2100



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The screenshot displays the USPTO PTAB Decisions search interface. The top navigation bar includes the USPTO logo, 'About Us', 'Jobs', and 'Contact Us'. Below this, the 'PTAB Decisions' section features tabs for 'Decisions', 'Proceedings', and 'Documents', with 'Documents' being the active tab. A 'Help' link and 'Open Data' button are also present. The main content area shows a search results page for 'Documents' with 1,124,574 results found. A 'Refine by' sidebar is visible on the left, containing various filters such as Identifiers, Date Range, Names, Proceeding Type, Document Type, Filing Party, Document Category, and Appellant/PO/Respondent Tech Center. The main table lists search results with columns for Proceeding #, Document Type, Document Title, Document Filing Date, and Tech Center.

Proceeding #	Document Type	Document Title	Document Filing Date	Tech Center
IPR2021-00816	EXHIBIT	2092	07-28-2021	3700
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IPR2021-00816	EXHIBIT	2090	07-28-2021	3700
IPR2021-00816	EXHIBIT	2089	07-28-2021	3700
IPR2021-00816	EXHIBIT	2065	07-28-2021	3700
IPR2021-00816	EXHIBIT	Declaration of Jeffrey Salling	07-28-2021	3700
IPR2021-00816	EXHIBIT	2061	07-28-2021	3700
IPR2021-00816	EXHIBIT	2060	07-28-2021	3700
IPR2021-00816	EXHIBIT	2059	07-28-2021	3700
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IPR2021-00816	EXHIBIT	2049	07-28-2021	3700
IPR2021-00816	EXHIBIT	2048	07-28-2021	3700



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The screenshot shows the top navigation bar of the USPTO website. On the left is the 'uspto' logo and the text 'UNITED STATES PATENT AND TRADEMARK OFFICE'. On the right are links for 'About Us', 'Jobs', 'Contact Us', and 'MyUSPTO', along with a search box containing 'Search uspto.gov'. Below this is a secondary navigation bar with tabs for 'Patents', 'Trademarks', 'IP Policy', and 'Learning and Resources', and a 'Find It Fast' button. A breadcrumb trail at the bottom of the header reads: 'Home > Patents > Patent Trial and Appeal Board > Decisions > AIA Review decisions'. To the right of the breadcrumb are 'Share' and 'Print' icons.

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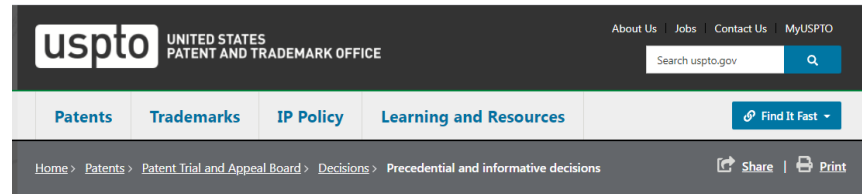


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PTAB precedential and informative decisions are organized by subject matter in the accordion below. Recently designated decisions appear in the first panel. Archived decisions include those not pertinent to or less pertinent to current PTAB practice.

See bottom of the page for alphabetical lists of all precedential and informative decisions. PTAB retired the Excel workbooks containing all PTAB precedential and informative decisions.

A **precedential** decision establishes binding authority concerning major policy or procedural issues, or other issues of exceptional importance, including constitutional questions, important issues regarding statutes, rules, and regulations, important issues regarding case law, or issues of broad applicability to the Board. [Standard Operating Procedure 2](#), 2-3, 11.

An **informative** decision provides Board norms on recurring issues, guidance on issues of first impression to the Board, guidance on Board rules and practices, and guidance on issues that may develop through analysis of recurring issues in many cases. [Standard Operating Procedure 2](#), 9.

If you are interested in anonymously nominating a routine decision of the Board for designation as precedential or informative, please complete the [PTAB decision nomination form](#).

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- › Recently designated decisions
- › Patent eligibility - 35 U.S.C. § 101
- › Anticipation - 35 U.S.C. § 102
- › Obviousness - 35 U.S.C. § 103
- › Specification and claim requirements - 35 U.S.C. § 112
- › Plant patents - 35 U.S.C. § 161



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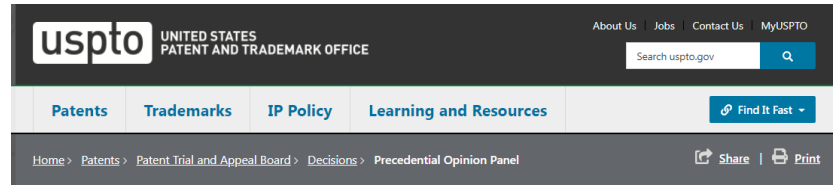
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### [POP Request: Amicus Form](#)

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### POP review granted - proceedings

#### **Hunting Titan, Inc. v. DynaEnergetics Europe GmbH**, IPR2018-00600

- Decision under POP review - [Paper 42](#) (August 20, 2019)
- POP grant order - [Paper 46](#) (November 7, 2019)
- Amicus briefing - CLOSED (December 20, 2019)
- Oral hearing - [Paper 63](#) (February 18, 2020) **NEW**
- POP decision - [Paper 67](#) (July 6, 2020) **NEW**

#### **GoPro, Inc. v. 360Heros, Inc.**, IPR2018-01754

- Decision under POP review - [Paper 15](#) (April 3, 2019)
- POP grant order - [Paper 23](#) (May 10, 2019)
- Amicus briefing - CLOSED (May 24, 2019)
- POP decision - [Paper 38](#) (August 23, 2019)

#### **Hulu, LLC, v. Sound View Innovations, LLC**, IPR2018-01039

- Decision under POP review - [Paper 12](#) (December 3, 2018)
- POP grant order - [Paper 15](#) (April 3, 2019)
- Amicus briefing - CLOSED (May 1, 2019)
- POP decision - [Paper 29](#) (December 20, 2019)

**Dominant Express Investments, LLC v. Open Table, LLC**, IPR2018-00914





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# **Audience Questions and Comments**

# Next Inventor Hour webinar



- **November** 18, 2021, at noon to 1 p.m. ET
  - Meet a Supervisory Patent Attorney
  - Hearing Byte: ex parte hearings
  - Trial Byte: motions to amend
  - How PTAB fits in: District Court; PTAB; International Trade Commission (ITC)
  - Case study



