

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# Patent Trial and Appeal Board

## Inventor Hour Webinar: **Episode 5**

Tawen Chang, Administrative Patent Judge

Ryan Flax, Administrative Patent Judge

Janet Gongola, Vice Chief Judge

Ulrike Jenks, Administrative Patent Judge

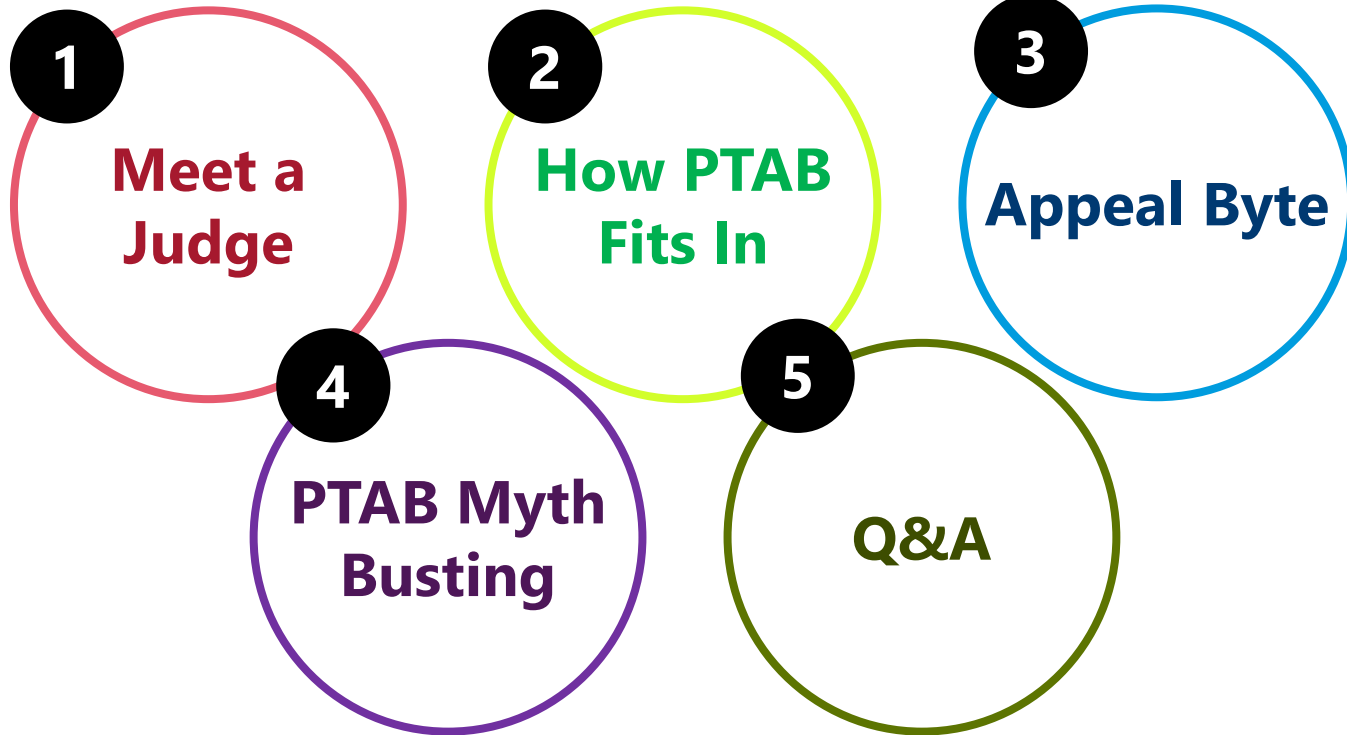
Eric C. Jeschke, Administrative Patent Judge

February 24, 2022

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# Today's Agenda



# Question/Comment Submission

To send in questions or comments about the presentation, please email:

– [PTABInventorHour@uspto.gov](mailto:PTABInventorHour@uspto.gov)



# Meet a Judge:

## Judge Tawen Chang



Tawen Chang  
Administrative Patent Judge



# Patent Pro Bono Program for Independent Inventors & Small Businesses

Are you an inventor or small business who has limited resources and needs help applying for a patent on an invention? If so, you may be eligible to receive *pro bono* ("for free") attorney representation through the Nationwide Pro Bono Program.

<https://www.uspto.gov/patents/basics/using-legal-services/pro-bono/inventors>



Ryan H. Flax, Administrative Patent Judge



# **How PTAB Fits In: Board / Federal Circuit / Supreme Court**



# Patent-Adjudicating Forums



**PTAB**



**Fed.  
Cir.**



**US  
Supreme  
Court**

# The Board at USPTO



**PTAB**



**Fed.  
Cir.**



**US  
Supreme  
Court**

# The Board at USPTO

**PTAB**

*Ex Parte*  
Appeals

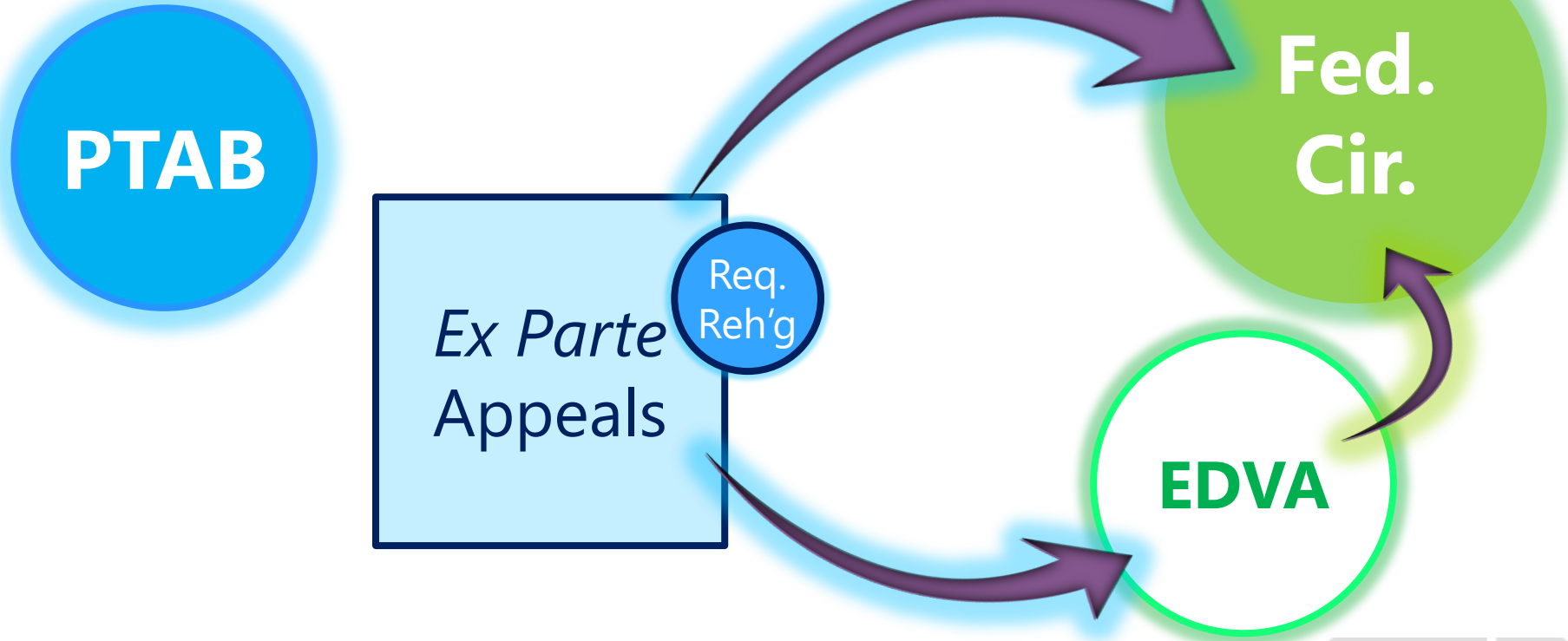
AIA  
Proceedings

IPR

PGR

Derivation

# Appealing Board Decisions



# Appealing Board Decisions

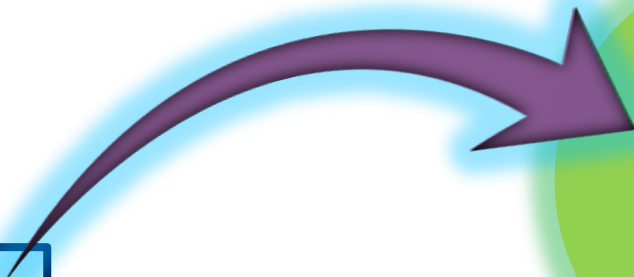
**PTAB**

IPRs &  
PGRs

Req.  
Reh'g

Dir.  
Rev.

POP  
Rev.



**Fed.  
Cir.**

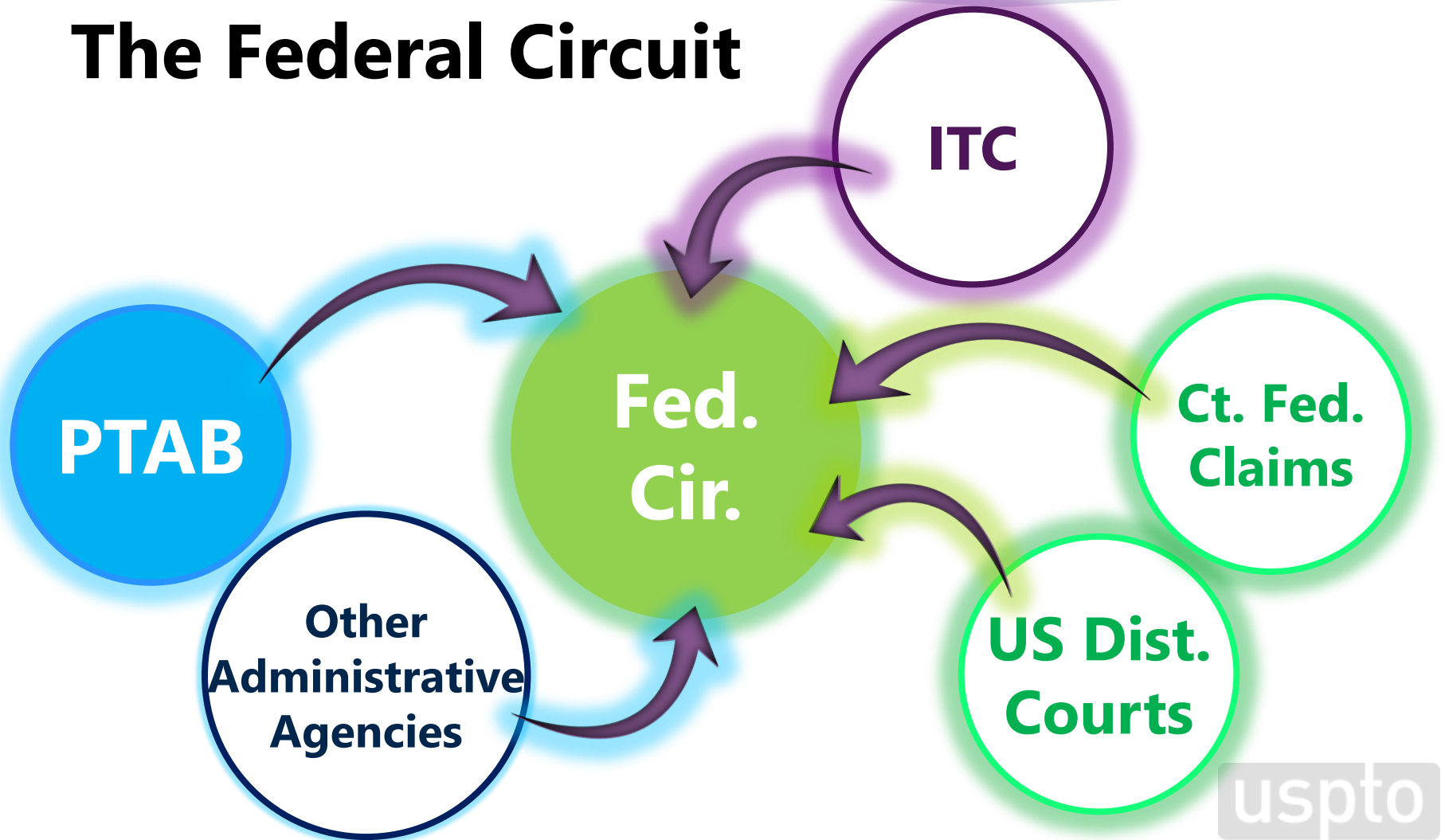
# The Federal Circuit

PTAB

Fed.  
Cir.

US  
Supreme  
Court

# The Federal Circuit



# The US Supreme Court

PTAB

Fed. Cir.

**US  
Supreme  
Court**



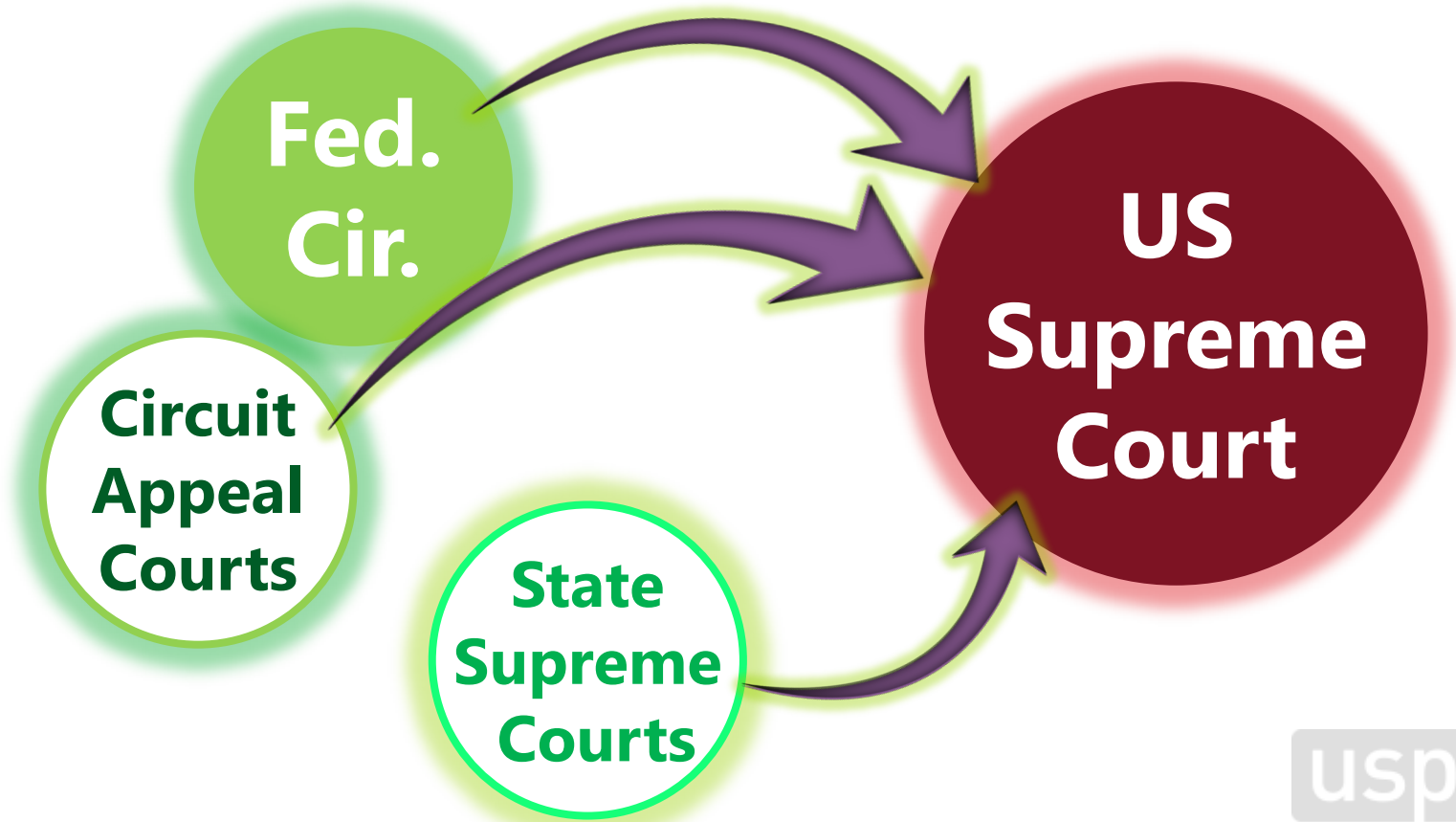
# The US Supreme Court

*U.S. Constitution, Article III, Section I:*  
“The judicial Power of the United States, shall be vested in one Supreme Court, and in such inferior Courts as the Congress may from time to time ordain and establish.”

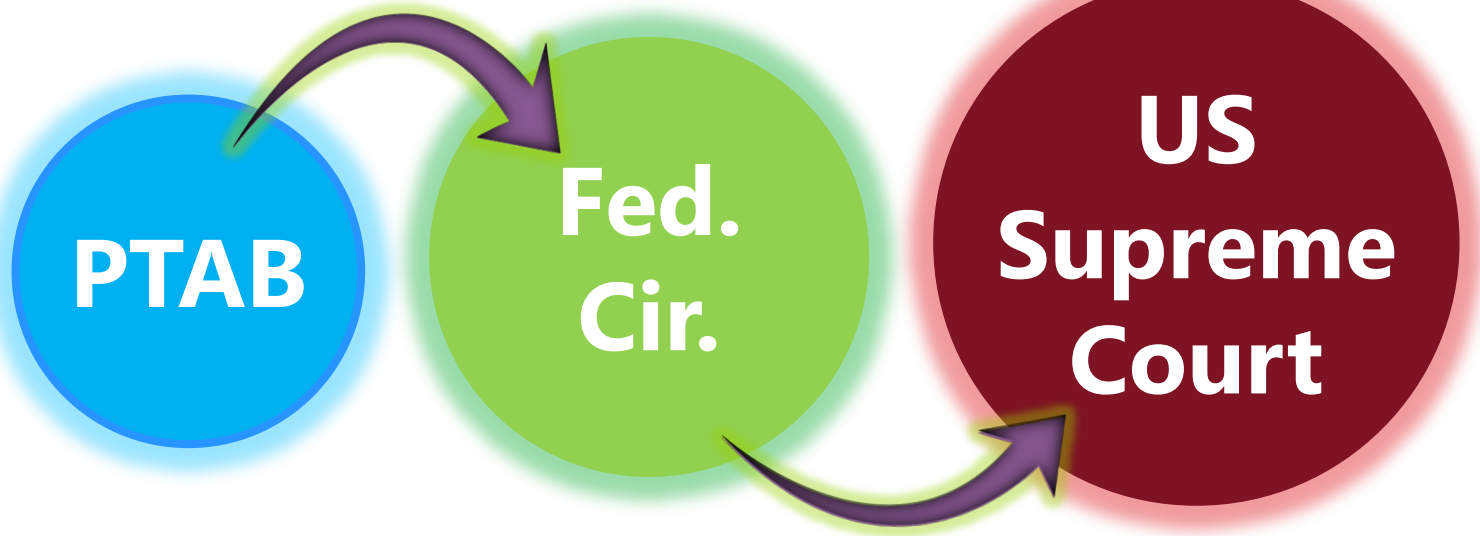


**US  
Supreme  
Court**

# The US Supreme Court



# Patent-Adjudicating Forums



# Question/Comment Submission

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# LEAP Program

**L**egal **E**xperience and **A**dvancement **P**rogram provides training and oral advocacy opportunities for less experienced advocates to gain practical experience in proceedings before the Patent Trial and Appeal Board.

<https://www.uspto.gov/patents/ptab/leap>



Ulrike Jenks, Administrative Patent Judge



# Appeal Byte:

## What is a declaration?

# What is a Declaration?

**EXHIBIT 1**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor : Attorney Docket No. 2019-0917  
Andrew John HEALEY : **Confirmation No. 2166**  
Serial No. 15/024,265 : Group Art Unit 1618  
Filed March 24, 2016 : Examiner Jake Minh Vu

ULTRASOUND MEDIATED DELIVERY OF :  
DRUGS

\_\_\_\_\_

**DECLARATION UNDER 37 C.F.R. § 1.132**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Commissioner:

I, Per Sontum, of Oslo, Norway, declare as follows:

1. I am a co-inventor of the above-identified U.S. Application No. 15/024,265 (hereinafter, "the present application").
2. I am the CEO of PHOENIX SOLUTIONS AS, the owner of the present application.
3. I have been engaged in research and development relating to microbubble and emulsion compositions/technology and related medicines for more than 29 years.
4. I have reviewed the Office Action mailed May 1, 2019 in the present application and the Eriksen (WO 99/53963) reference cited therein.
5. The following experiments set forth below were conducted by me or under my direction and control.

Declarations are witness **testimony**.

All statements are written and must be made **under oath**.

Declarations are submitted as **exhibits** to accompany an office action response or appeal brief.

# Who are Declaration Witnesses?

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Fact Witnesses

Experts

Inventors

(usually people that know the technology and can testify as to what one of ordinary skill in the art would have known)



# Declaration Testimony

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Support **patentability positions** like:



Written description



Enablement



How the ordinarily skilled artisan would understand the prior art



Objective indicia of non-obviousness

# What Evidence Should You Submit?

**Documents** that  
support your  
patentability  
positions

**Data** that  
support your  
patentability  
positions

Witness  
**declarations** that  
support your  
patentability  
positions

# Parts of a Declaration

Case  
Caption

Numbered  
Paragraphs

PATENT  
Attorney Docket No. 20145186-05

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: )  
Steen H. MATTHIESEN et al. ) Group Art Unit: 1634  
Application No.: 13/513,164 ) Examiner: Robert Thomas CROW  
Filed: November 02, 2012 )  
Confirmation No.: 2515  
For: COMPOSITIONS AND )  
METHODS FOR PERFORMING ) NGE Ref. 027644.8103  
HYBRIDIZATIONS WITH )  
NO DENATURATION )

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Commissioner:

**DECLARATION OF  
JENS MOLLERUP UNDER 37 C.F.R. § 1.132**

I, Jens Mollerup, declare and state that:

1. I am a citizen of Denmark, and I work with the inventor of the above-identified application. I understand that the above-identified application has been assigned to Dako Denmark A/S. Agilent Technologies acquired Dako in 2012. Prior to February 1, 2017, I was an employee of Dako Denmark A/S, and then I was transferred to Agilent Technologies Denmark ApS.
2. I understand that the patent examiner has rejected claims directed to a method of hybridizing nucleic acid sequences as being unpatentable based in part on Bischoff et al. U.S. Patent No. 6,656,734. For the reasons below, Bischoff is not relevant to a method of hybridization.

Application No. 13/513,164  
Attorney Docket No. 20145186-05

Sworn  
Oath

7. In ISH, penetration of the nucleic acids is passive as the cell (tissue) is fixed and the cell membrane is not intact. During transfection performed on viable non-fixed cells, the cell membrane needs to be intact before and after the transfection process for the organism to be viable and allow effect of the transfected entity.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: 2017 AUG 18

  
Jens Mollerup

Date &  
Signature

# Question/Comment Submission

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# Inventors Digest

<https://www.inventorsdigest.com>

- Monthly issues, each featuring articles about USPTO
- Monthly articles about PTAB
- Free online



Eric C. Jeschke, Administrative Patent Judge



# **PTAB Files: Myth-Busting**

# Myth:

**Ex parte appeals take 3 years to receive a decision from the PTAB.**

PLAUSIBLE?

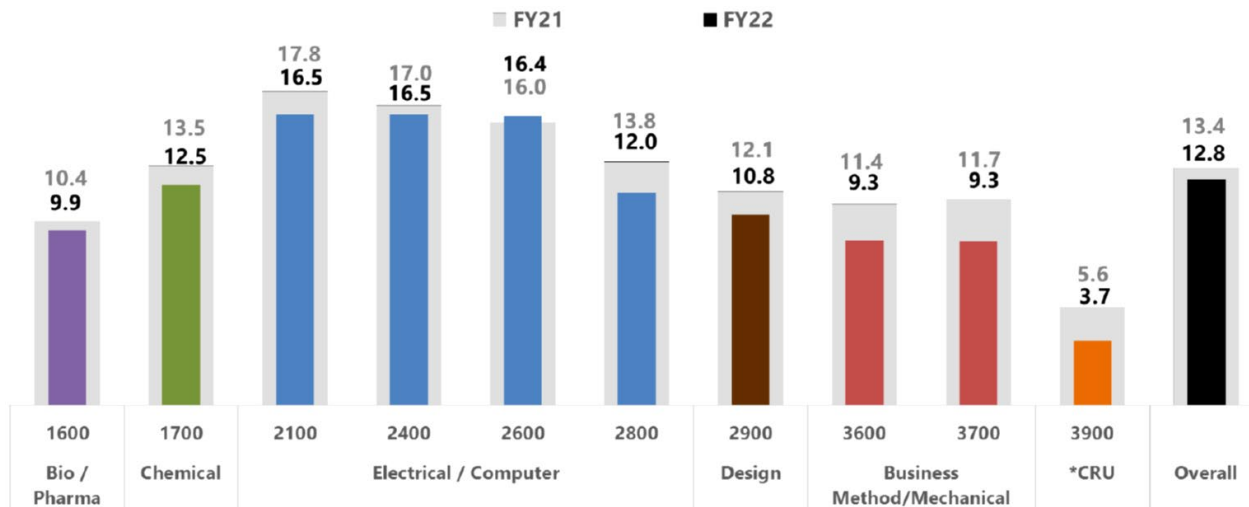
BUSTED?

# Facts:



## Pendency of decided appeals

(Aug. 2020 – Oct. 2020 compared to Aug. 2021 – Oct. 2021)



Pendency is calculated as average months from Board receipt date to final decision.

Pendency is calculated for a three month period compared to the same period the previous year.

\*CRU (Central Reexamination Unit) decisions include 10 *ex parte* reexams, 1 *inter partes* reexam, 0 supplemental examination review, and 4 reissues from all technologies for Aug. 2021. – Oct. 2021.

After PTAB gets jurisdiction, it takes about

**13 months**

to receive a PTAB decision on an *ex parte* appeal.





# Myth:

**PTAB almost always affirms the examiner's rejection of the claims in *ex parte* appeals.**

PLAUSIBLE?

BUSTED?

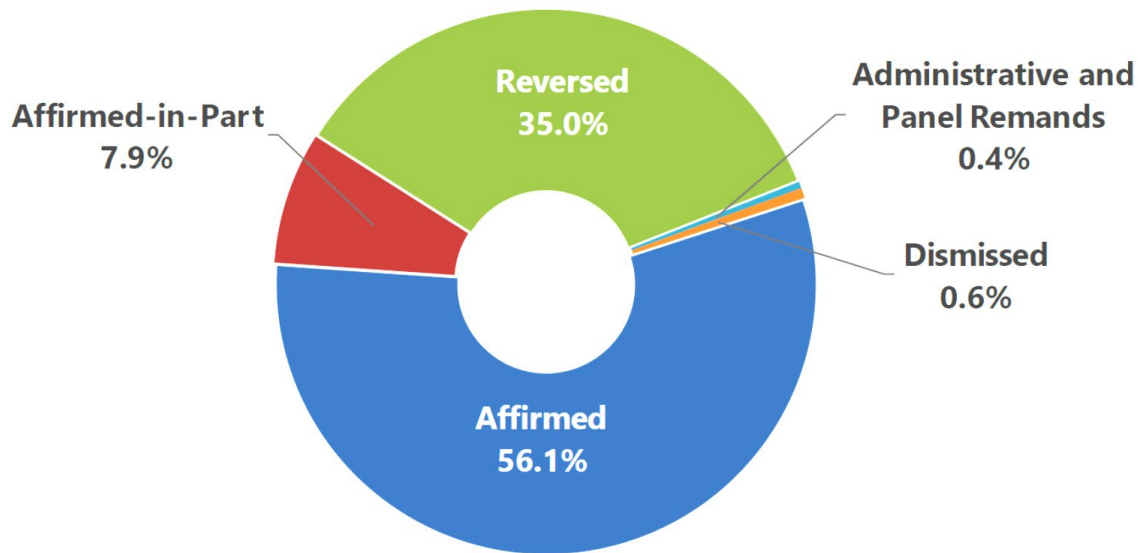
**Facts:**



## Appeal outcomes in FY22

(Oct. 1, 2021 - Oct 31, 2021)

PTAB affirms an  
examiner's rejection  
**about 56%**  
of the time.



Notably though, less than 3% of examiner final rejections are appealed to the Board.

# Myth:

**Most PTAB proceedings involve a patent in parallel litigation before the U.S. district courts.**

PLAUSIBLE?

BUSTED?

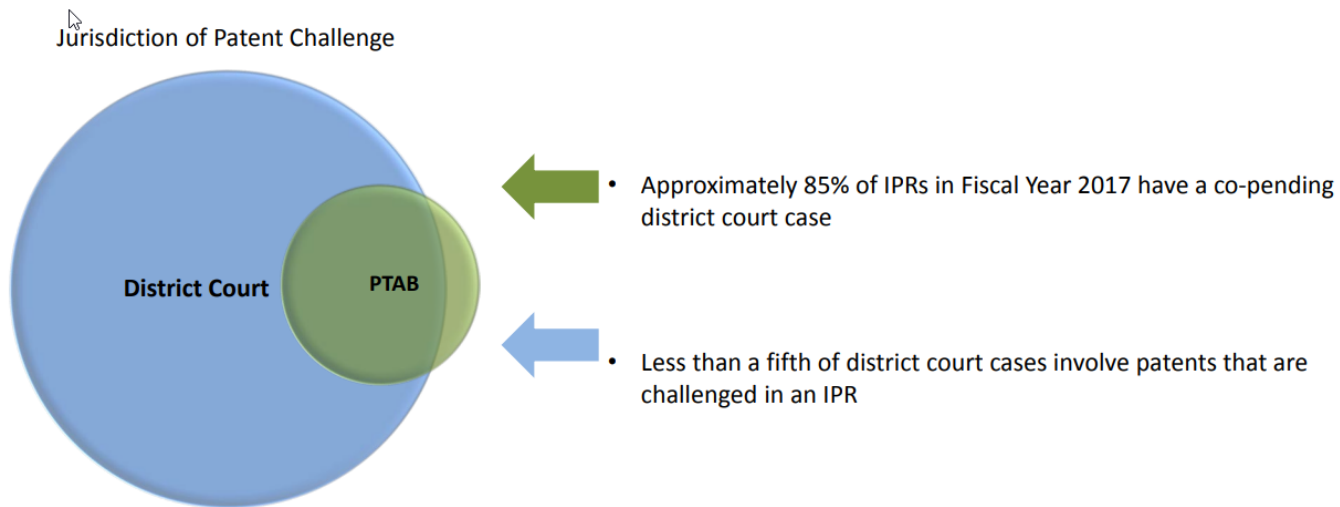
# Facts:

# PLAUSIBLE

## Jurisdiction of Patent Challenges

# About 85%

of PTAB cases DO involve a patent subject to concurrent district court litigation.



Data sourced from Lex Machina PTAB Report 2017

**Myth:**

**PTAB institutes trial in every AIA proceeding.**

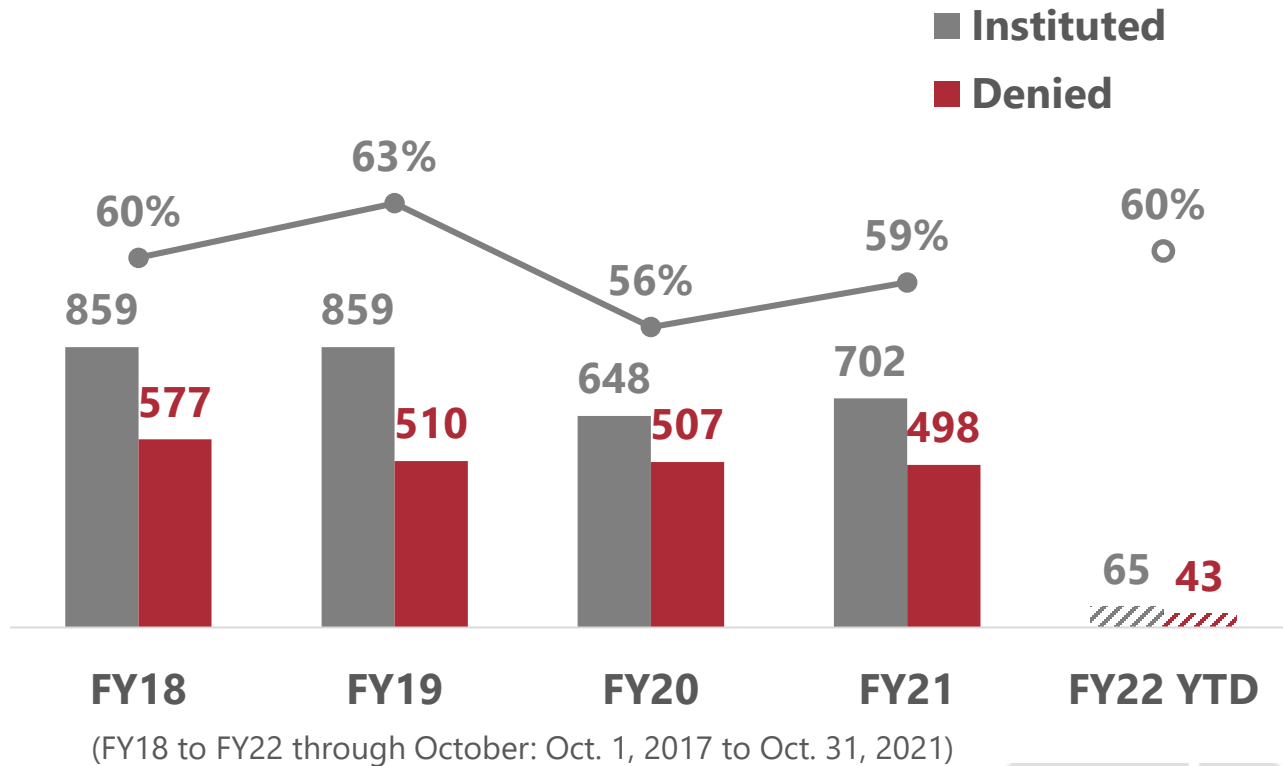
PLAUSIBLE?

BUSTED?

Facts:



PTAB institutes  
an AIA trial  
**about**  
**55 to 65%**  
of the time.



# Myth:

**In AIA proceedings, PTAB  
invalidates all patents it sees.**

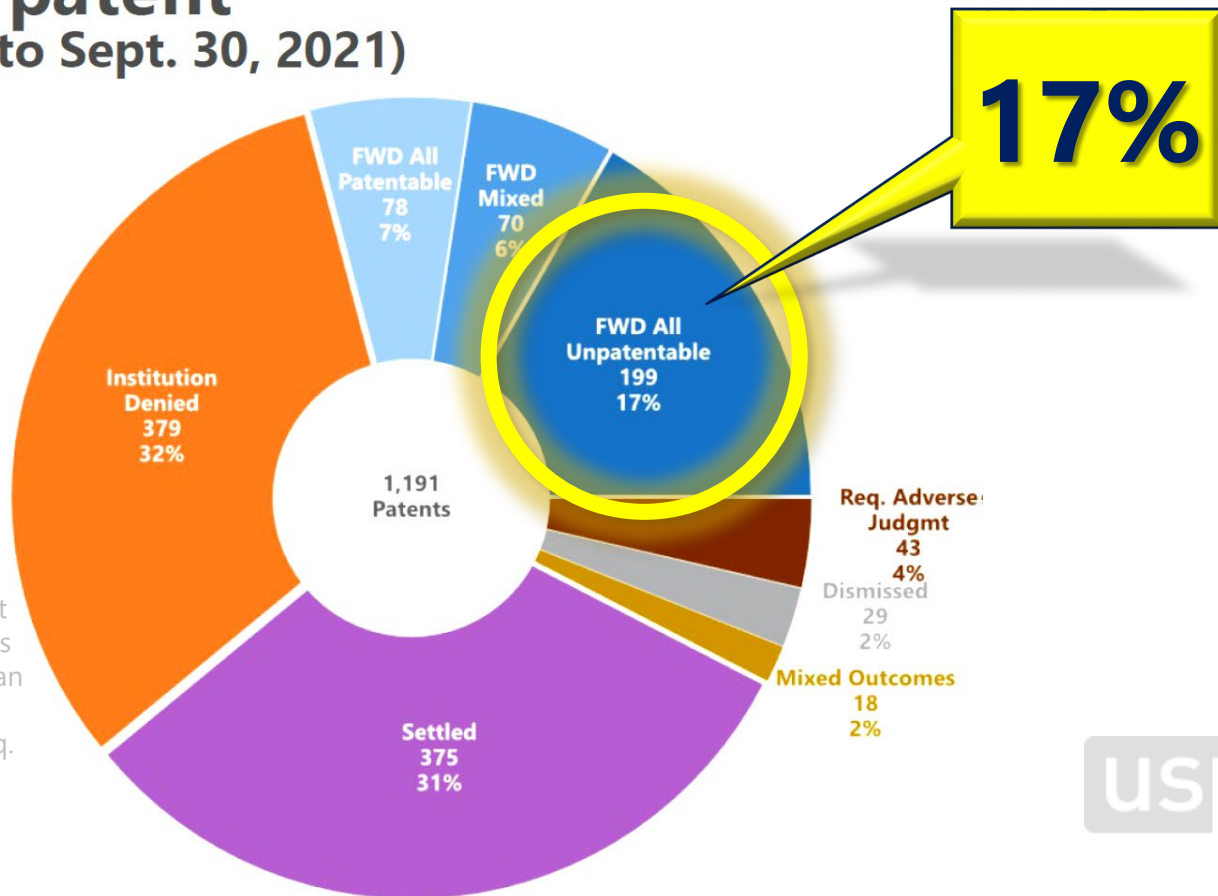
PLAUSIBLE?

BUSTED?

# Facts:

# BUSTED

## Outcomes by patent (FY21: Oct. 1, 2020 to Sept. 30, 2021)



FWD patentability or unpatentability reported with respect to the claims at issue in the FWD. "Mixed Outcome" is shown for patents receiving more than one type of outcome from the list of: denied, settled, dismissed, and/or req. adverse judgement only. A patent is listed in a FWD category if it ever received a FWD, regardless of other outcomes.



# More PTAB Statistics

For more information about PTAB statistics, including the data featured here, check our

**Statistics Webpage**

[www.uspto.gov/patents/ptab/statistics](http://www.uspto.gov/patents/ptab/statistics)

## Statistics

Patent Trial and Appeal Board (PTAB) performance benchmarks for dispositions, pendency, inventory, and other tracking measures.

PTAB has released a new statistics format for AIA trials. In FY21, we moved the outcome statistics into a new quarterly "Outcome Roundup" format. The new format includes outcome information on a by-petition, by-patent, and by-claim basis. We will continue publishing non-outcome trial statistics on a monthly basis. We also provide end-of-year outcome statistics for fiscal years 2019 and 2020 for AIA trials.

### Trial statistics

Current fiscal year (FY) statistics to date:

- [FY21 Q3 Outcome Roundup \(June 2021\)](#)
  - [Appendix](#)
- [May 2021](#)
- [April 2021](#)
- [FY21 Q2 Outcome Roundup \(March 2021\)](#)
  - [Appendix](#)
- [February 2021](#)
- [January 2021](#)

### Appeal and interference statistics

Current fiscal year (FY) statistics to date:

- [July 2021](#)
- [June 2021](#)
- [May 2021](#)
- [April 2021](#)
- [March 2021](#)
- [February 2021](#)
- [January 2021](#)
- [December 2020](#)
- [November 2020](#)
- [October 2020](#)

# Question/Comment Submission

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# Next Inventor Hour webinar



**March 24, 2022**, noon to 1 p.m. ET

- Meet the Chief Clerk of the Board
- Patent Pro Bono Program
- Trial Bytes—Consolidated Trial Practice Guide
- Case Study



# Future Inventor Hour webinars

- **March 24 2022**, noon to 1 p.m. ET
- April 28, 2022 (same time)
- May 26, 2022 (same time)



