

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# Patent Trial and Appeal Board Inventor Hour webinar: episode 2

Kalyan Deshpande, Senior Lead Judge

Jeff Fredman, Administrative Patent Judge

Eric Jeschke, Administrative Patent Judge

Ryan Flax, Administrative Patent Judge

Scott Raevsky, Administrative Patent Judge

Cynthia Hardman, Administrative Patent Judge

Troy Tyler, Board Executive

Kulunie Cannon, Deputy Clerk for Hearings

September 23, 2021

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# Agenda

- Meet a Board Operations Division member
- Appeal Byte: what is an ex parte appeal?
- Walkabout the PTAB webpage
- Trial Byte: AIA proceedings overview
- Hearings Byte: hearings logistics
- Case study

# Question/comment submission

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

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



**Meet a Board Operations Division  
member: Troy Tyler**



Troy Tyler  
Board Executive

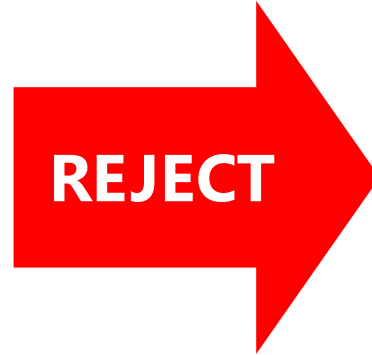
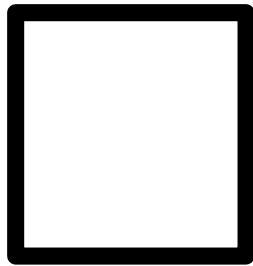
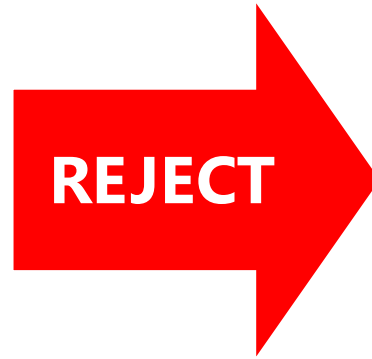
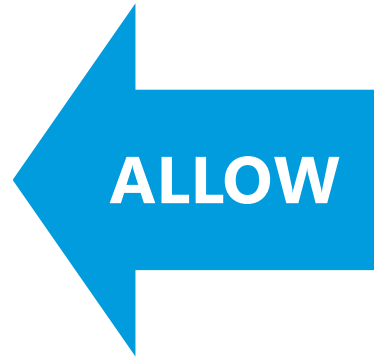
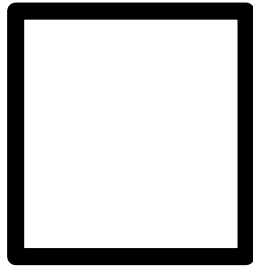


Jeff Fredman, Administrative Patent Judge



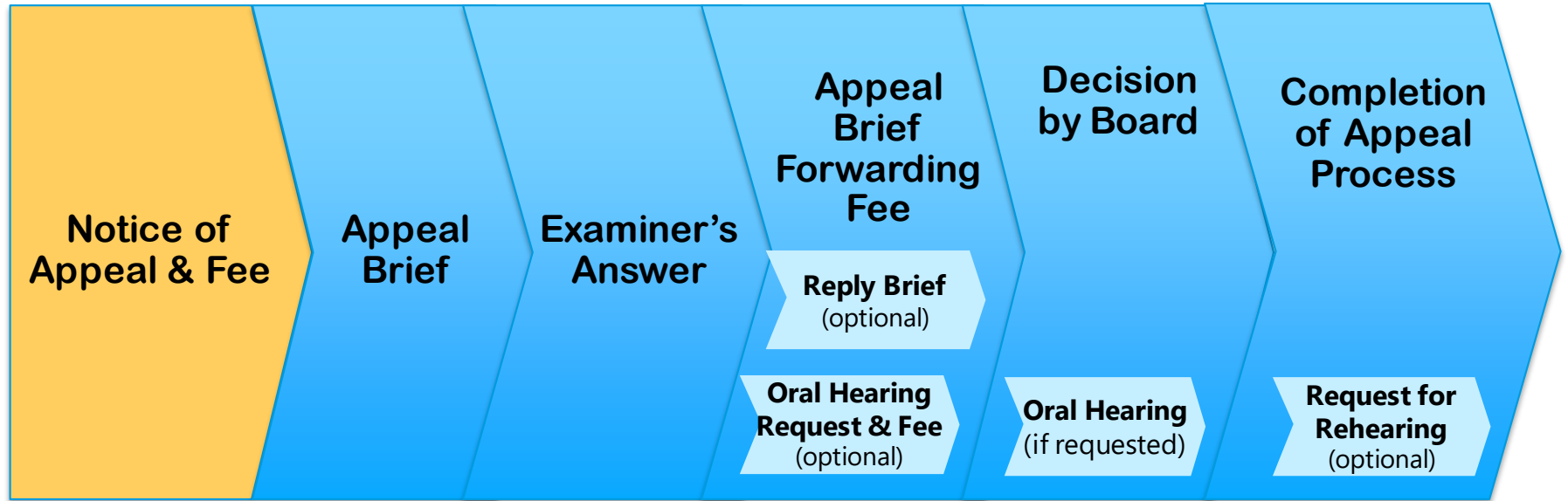
**Appeal Byte:**

**what is an ex parte appeal?**

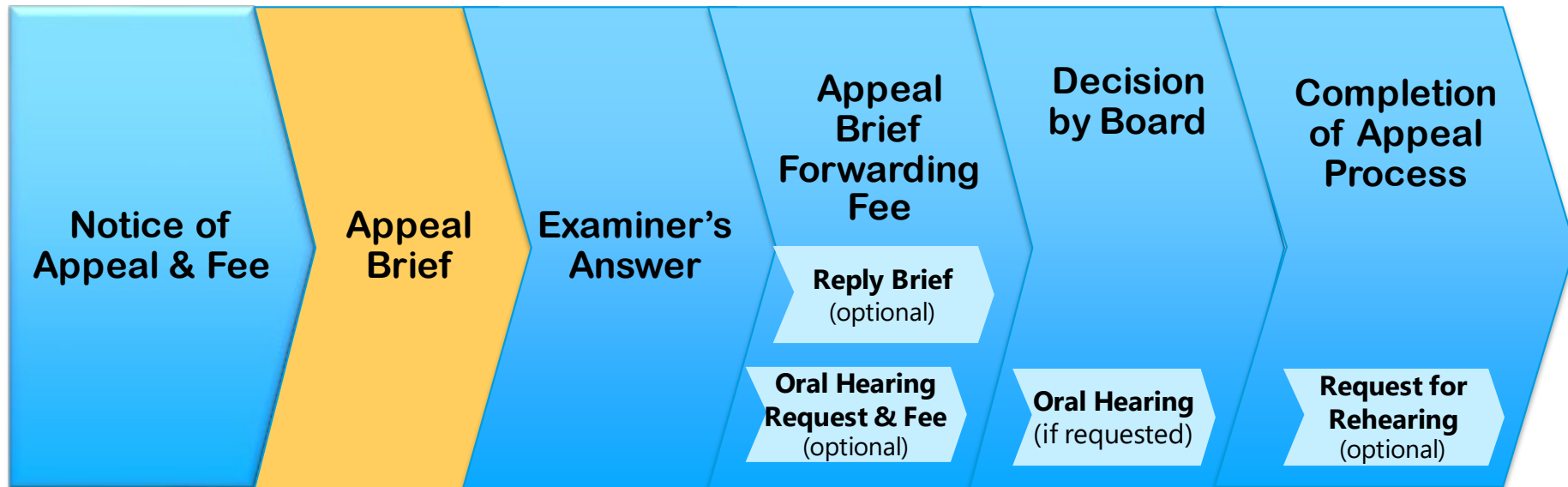




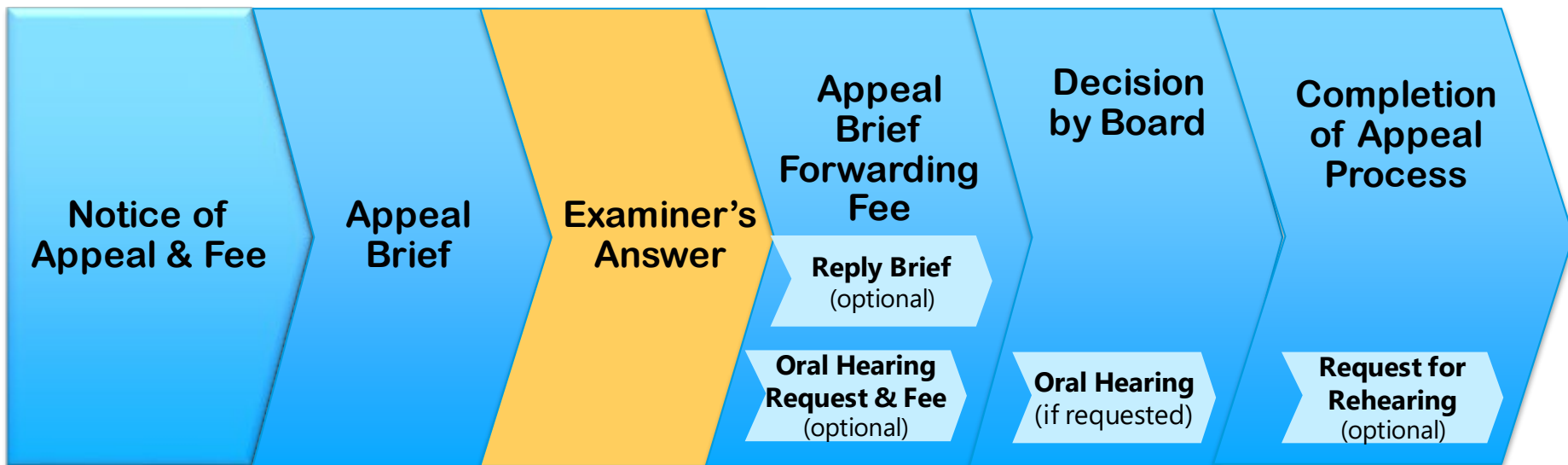
# Ex parte appeal process



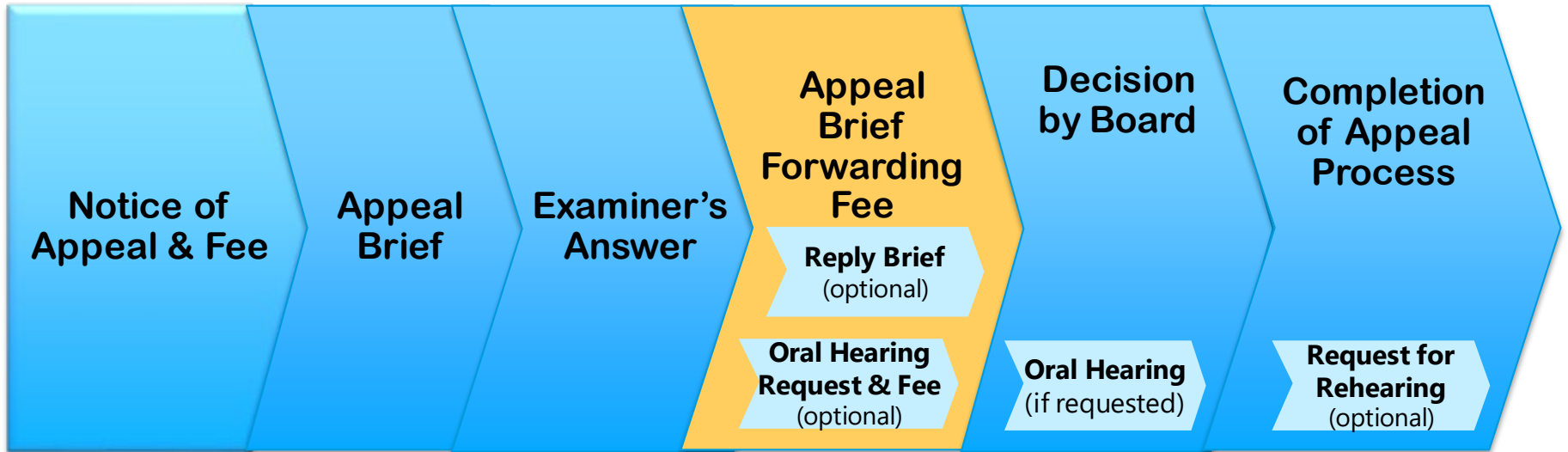
# Ex parte appeal process



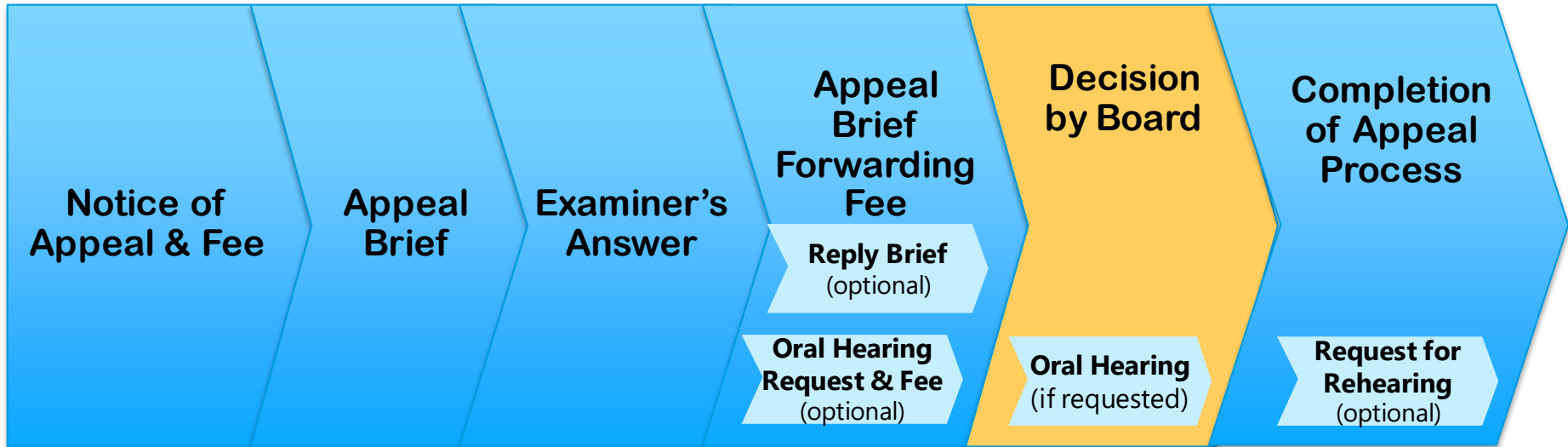
# Ex parte appeal process



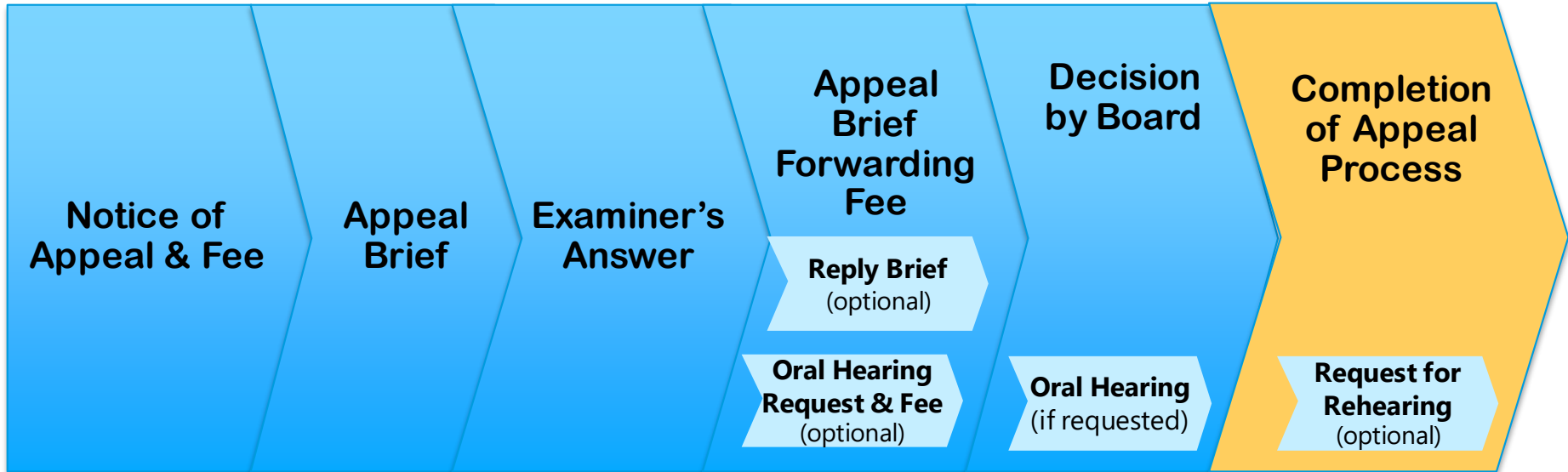
# Ex parte appeal process



# Ex parte appeal process



# Ex parte appeal process



# Question/comment submission

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# Inventor resources









## www.uspto.gov



A screenshot of the USPTO website homepage. The header includes the USPTO logo and navigation links: "About Us", "Jobs", "Contact Us", and "MyUSPTO". A search bar is present. Below the header are navigation tabs for "Patents", "Trademarks", "IP Policy", and "Learning and Resources". The main content area features a "Find It Fast" section with buttons for "Patents" and "Trademarks". A red circle highlights the "New to IP?" section, which includes a question mark icon and links for "Patent basics", "Trademark basics", and "Inventor &amp; entrepreneur resources". A red arrow points from this section to the right-hand screenshot. Below the "Find It Fast" section is a "Driving innovation" article featuring Audrey Sherman.

A screenshot of the USPTO website page titled "Inventor and entrepreneur resources". The header is identical to the homepage. The navigation tabs are "Patents", "Trademarks", "IP Policy", and "Learning and Resources". The main content area shows the breadcrumb "Home &gt; Learning and Resources &gt; Inventor and entrepreneur resources" and "Share" and "Print" icons. Below this is the "Inventor and entrepreneur resources" section, which is the focus of the right-hand screenshot.

## Inventor and entrepreneur resources

 <h3>Get started</h3> <p>Learn about types of intellectual property (IP) and how to protect your idea or product.</p> <ul style="list-style-type: none"><li>&gt; Types of IP protection</li><li>&gt; Attend a free training</li><li>&gt; Patents basics</li><li>&gt; Trademark basics</li></ul>	 <h3>Before you apply</h3> <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"><li>&gt; Search patents</li><li>&gt; Search trademarks</li><li>&gt; Create an account to apply</li></ul>	 <h3>Get help to apply</h3> <p>Set yourself up for success by learning via USPTO's free resources and find expert help.</p> <ul style="list-style-type: none"><li>&gt; Find resources near you</li><li>&gt; Watch our videos</li><li>&gt; Find a patent attorney</li><li>&gt; Do I need a trademark attorney?</li></ul>	 <h3>Apply for IP rights</h3> <p>Submit your application for a patent or trademark. See if you qualify for reduced patent fees.</p> <ul style="list-style-type: none"><li>&gt; Apply for a patent</li><li>&gt; Apply for a trademark</li><li>&gt; Costs to file</li><li>&gt; Reduced patent fees</li></ul>
 <h3>After you apply</h3> <p>As your patent or trademark is examined you may need to take additional steps.</p> <ul style="list-style-type: none"><li>&gt; Check application status</li><li>&gt; Respond to a Patent decision</li><li>&gt; Prepare for a patent interview</li><li>&gt; Respond to a Trademark decision</li></ul>	 <h3>Appeal or fix an issue</h3> <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"><li>&gt; Learn about patent petitions</li><li>&gt; Learn about patent appeals</li><li>&gt; Learn about trademark petitions</li><li>&gt; Learn about trademark appeals</li></ul>	 <h3>Entrepreneur resources</h3> <p>Learn about small business resources at the USPTO and other federal agencies.</p> <ul style="list-style-type: none"><li>&gt; Startup resources</li><li>&gt; License or sell your IP</li><li>&gt; Change patent owner</li><li>&gt; Change trademark owner</li><li>&gt; Other federal resources</li></ul>	 <h3>Protect yourself</h3> <p>Don't be misled by false claims, scams, or companies offering services for unusually low prices.</p> <ul style="list-style-type: none"><li>&gt; Known patent scams</li><li>&gt; Known trademark scams</li><li>&gt; Prevent or report a scam</li></ul>



Eric Jeschke, Administrative Patent Judge



# **Walkabout the PTAB webpage**

# uspto.gov/ptab

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'. Below this is a search bar with the text 'Search uspto.gov' and a magnifying glass icon. A secondary navigation bar contains 'Patents', 'Trademarks', 'IP Policy', and 'Learning and Resources', along with a 'Find It Fast' button. The main content area has a dark blue background with a breadcrumb trail: 'Home > Patents > Patent Trial and Appeal Board > Patent Trial and Appeal Board'. To the right of the breadcrumb are 'Share' and 'Print' icons. The main heading is 'Patent Trial and Appeal Board'. Below the heading is a paragraph: 'The Patent Trial and Appeal Board (PTAB) conducts trials, including inter partes, post-grant, and covered business method patent reviews and derivation proceedings, hears appeals from adverse examiner decisions in patent applications and reexamination proceedings, and renders decisions in interferences.'



## Trials and appeals

- > [New to PTAB?](#)
- > [Trial proceedings](#)
- > [Appeals proceedings](#)
- > [Preparing for hearings](#)
- > [Fees](#)



## Decisions

- > [All PTAB decision data](#)
- > [AIA daily decisions](#)
- > [Precedential and informative decisions](#)
- > [Precedential Opinion Panel \(POP\)](#)



## Learn more

- > [Resources and guidance](#)
- > [Statistics](#)
- > [Databases and IT tools](#)
- > [Frequently asked questions](#)
- > [Boardside Chat webinar series](#)
- > [PTAB suggestion box and contact info](#)
- > [Recent proposals, pilots and final rules](#)



# uspto.gov/patents/patent-trial-and-appeal-board/about-ptab/new-ptab

## 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](#)

# uspto.gov/patents/ptab/trials

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Patent Trial and Appeal Board

## Trials

- Derivation proceeding
- Inter partes review
- Patent Trial and Appeal Board End to End (PTAB E2E)
- Post grant review
- Transitional program for covered business method patents
- Interference
- Appeals
- Decisions
- Hearings
- Resources and guidance
- Statistics
- PTAB data tools and IT systems
- PTAB events

## Trials

Information about proceedings conducted by the Patent Trial and Appeal Board (PTAB), including inter partes review, post-grant review, the transitional post-grant review for covered business method patents, derivations, and interferences.

### Proposed changes

Possible revisions to AIA trial proceedings for public comment

### Statutes and rules

America Invents Act (AIA) trials, statutes, and rules; amendments to the rules; reference guide to statutes; and final rules and the practice guide

### AIA trial types

Comparisons and descriptions of AIA trial types

### Hearings

Hearing procedures and calendars

### Guidance

Guidance for conducting trial proceedings

### Representative orders, decisions and notices

Orders, decisions and notices from representative AIA trials

### Interferences

Resources for interference practice

### Statistics

AIA trial statistics

### PTAB End to End

Tools for filing or searching AIA cases

### FAQs

Frequently asked questions about trials



# uspto.gov/patents/ptab/appeals

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Patent Trial and Appeal Board

[Trials](#)

**[Appeals](#)**

[Decisions](#)

[Hearings](#)

[Resources and guidance](#)

[Statistics](#)

[PTAB data tools and IT systems](#)

[PTAB events](#)

[New to PTAB](#)

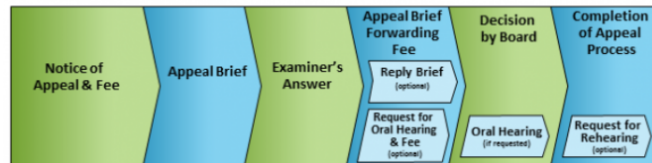
[About PTAB](#)

[PTAB help](#)

## Appeals


Information about ex parte appeals conducted by the Patent Trial and Appeal Board (PTAB) from adverse decisions of examiners in patent applications, reissue applications, and reexamination proceedings.

### Appeals – General Process



[Expand all](#) | [Collapse all](#)

- [General process](#)
- [Resources](#)
- [Frequently asked questions \(FAQs\)](#)

Please send suggestions regarding the appeals process to the Board at [PTAB Appeals Suggestions](#) .

# uspto.gov/patents/ptab/hearings

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Patent Trial and Appeal Board

[Trials](#)

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## Hearings

An appellant in an ex parte appeal and the parties in an AIA trial may request an oral hearing to explain their position before the Patent Trial and Appeal Board (PTAB). An oral hearing gives the Board an opportunity to ask questions of the parties to aid the Board in deciding the case. An oral hearing may be held in a courtroom with a court reporter present to prepare a transcript of the proceeding.

[Expand all](#) | [Collapse all](#)

### ▼ Hearing schedule

Until further notice, Patent Trial and Appeal Board (PTAB) oral hearings will be conducted remotely by video or telephone. During this time, to listen in on any particular oral hearing, please make a request via email to [PTABHearings@uspto.gov](mailto:PTABHearings@uspto.gov) at least three business days prior to the oral hearing date. Please include any requests for accommodations for individuals with disabilities, including captioning. The Board will respond to the request, and provide any connection information. Transcripts for each oral hearing will subsequently be entered into the record of the relevant proceeding, and be publicly available in [PTAB E2E for AIA Trials](#) or in [Public Pair for appeals](#), unless an exception applies.

NOTE: Due to last minute cancellations or no shows, there are no guarantees that a hearing on a particular proceeding will occur, although it may be posted.

\* [PTAB September 2021 Hearing Schedule \(PDF\)](#)

\* [PTAB October 2021 Hearing Schedule \(PDF\)](#)

### ► [Hearing guidance](#)



# uspto.gov/learning-and-resources/fees-and-payment/uspto-fee-schedule

Patent trial and appeal fees			Back to top		
Fee code	37 CFR §	Description	Fee	Small entity fee	Micro entity fee
1405/2405/3405	41.20(a)	Petitions to the Chief Administrative Patent Judge under 37 CFR 41.3	420.00	420.00	420.00
1401/2401/3401	41.20(b)(1)	Notice of appeal	840.00	420.00	210.00*
n/a	41.20(b)(2)(i)	Filing a brief in support of an appeal	0.00	0.00	0.00
1404/2404/3404	41.20(b)(2)(ii)	Filing a brief in support of an appeal in an inter partes reexamination proceeding	2,100.00	1,050.00	525.00*
1403/2403/3403	41.20(b)(3)	Request for oral hearing	1,360.00	680.00	340.00*
1413/2413/3413	41.20(b)(4)	Forwarding an appeal in an application or ex parte reexamination proceeding to the Board	2,360.00	1,180.00	590.00*
1406/2406/3406	42.15(a)(1)	Inter partes review request fee - Up to 20 claims	19,000.00	19,000.00	19,000.00
1414/2414/3414	42.15(a)(2)	Inter partes review post-institution fee - Up to 20 claims	22,500.00	22,500.00	22,500.00
1407/2407/3407	42.15(a)(3)	Inter partes review request of each claim in excess of 20	375.00	375.00	375.00
1415/2415/3415	42.15(a)(4)	Inter partes post-institution request of each claim in excess of 20	750.00	750.00	750.00
1408/2408/3408	42.15(b)(1)	Post-grant or covered business method review request fee - Up to 20 claims	20,000.00	20,000.00	20,000.00
1416/2416/3416	42.15(b)(2)	Post-grant or covered business method review post-institution fee - Up to 20 claims	27,500.00	27,500.00	27,500.00
1409/2409/3409	42.15(b)(3)	Post-grant or covered business method review request of each claim in excess of 20	475.00	475.00	475.00
1417/2417/3417	42.15(b)(4)	Post-grant or covered business method review post-institution request of each claim in excess of 20	1,050.00	1,050.00	1,050.00



# Question/comment submission

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Cynthia Hardman, Administrative Patent Judge

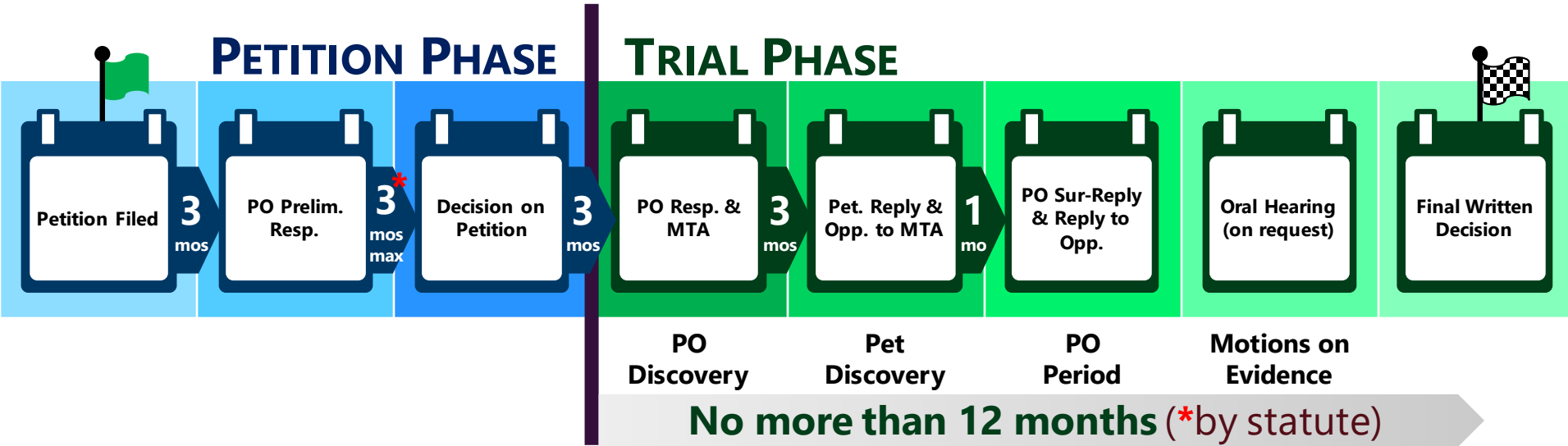


# **Trial Byte:** **AIA proceedings overview**

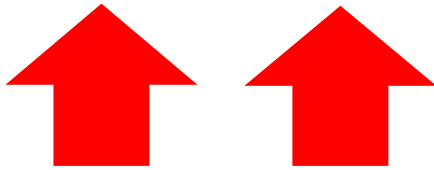
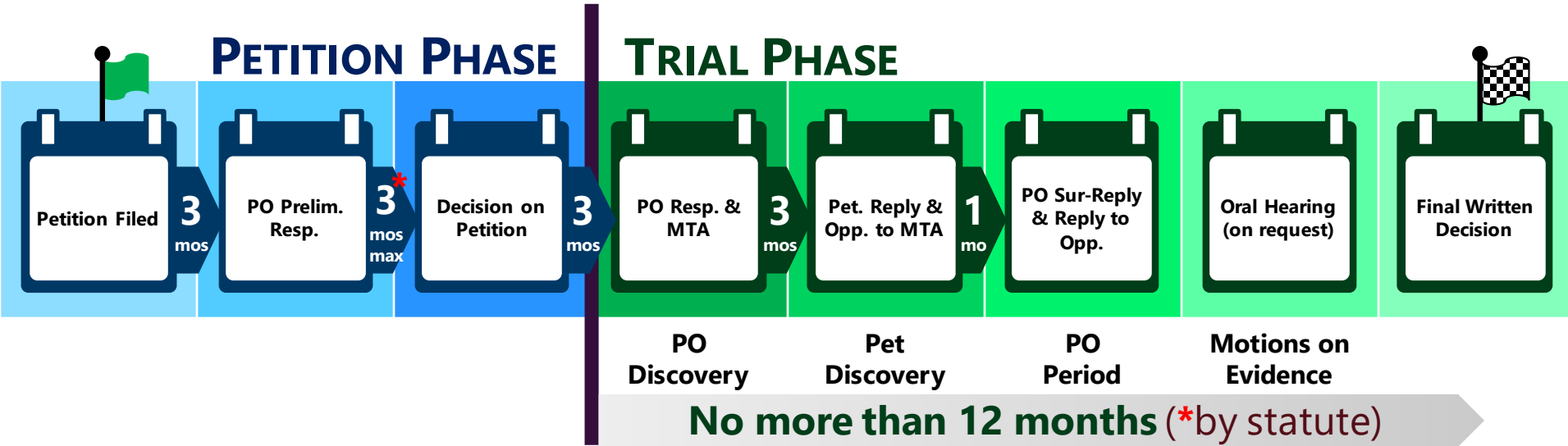
# Types of AIA Proceedings

Trial Type	Who Can File	Applicability	Availability	Basis
Inter partes review (IPR)	Person who is: <ul style="list-style-type: none"> <li>(a) not the patent owner,</li> <li>(b) has not previously filed a civil action challenging the validity of a claim of the patent, and</li> <li>(c) has not been served with a complaint alleging infringement of the patent more than 1 year prior (exception for joinder).</li> </ul>	Any patent (first-to-invent or first-inventor-to-file).	For first-to-invent patents: anytime after patent grant or reissue.  For first-inventor-to-file patents: from the later of: <ul style="list-style-type: none"> <li>(a) 9 months after patent grant or reissue; or</li> <li>(b) the date of termination of any post grant review.</li> </ul>	102 and 103 based on patents and printed publications.
Post-grant review (PGR)	Person who is: <ul style="list-style-type: none"> <li>(a) not the patent owner, and</li> <li>(b) has not previously filed a civil action challenging the validity of a claim of the patent.</li> </ul>	Patent issued under first-inventor-to-file.	Must be filed within 9 months of patent grant or reissue.	101, 102, 103, 112 (but not best mode), and double patenting.

# AIA Proceeding Timeline



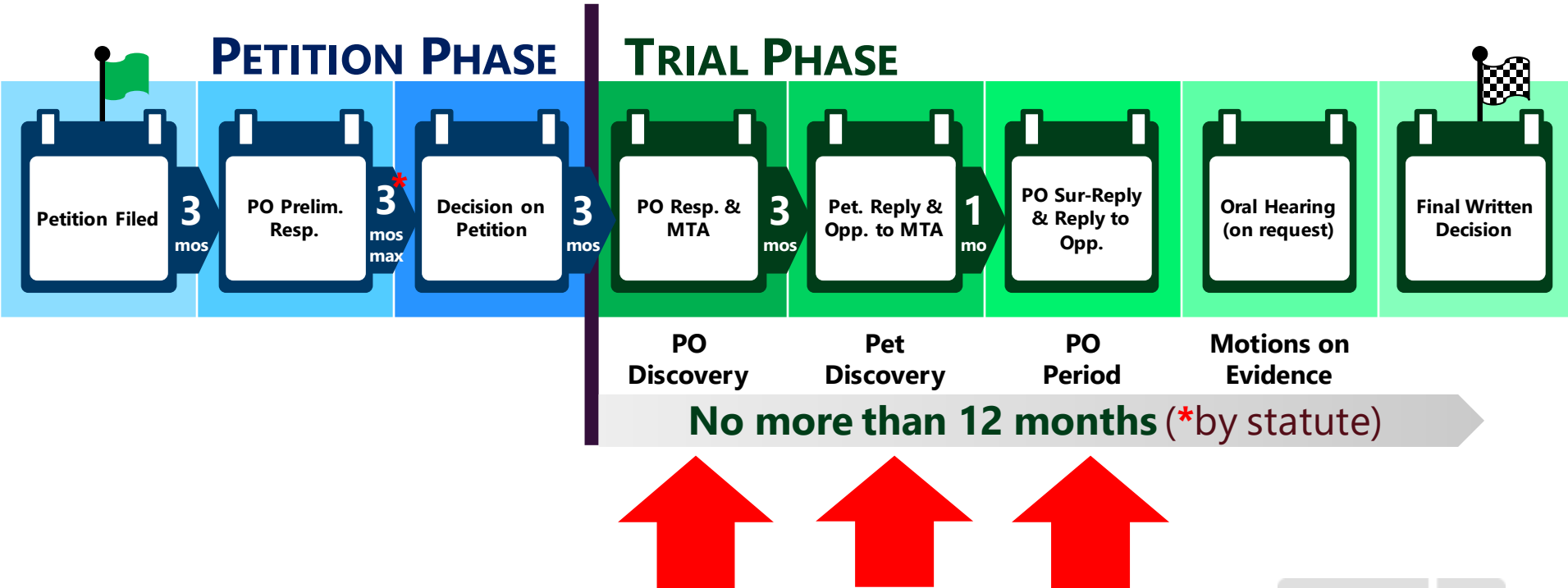
# Petition Phase: Briefing



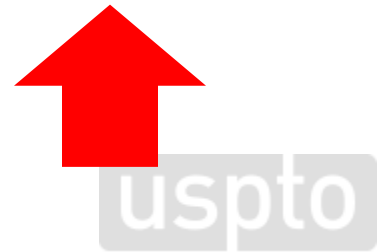
# Petition Phase: Institution



# Trial Phase: Briefing



# Trial Phase: Evidence Motions & Hearing



# Trial Phase: Final Written Decision





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Kulunie Cannon, Deputy Clerk for Hearings



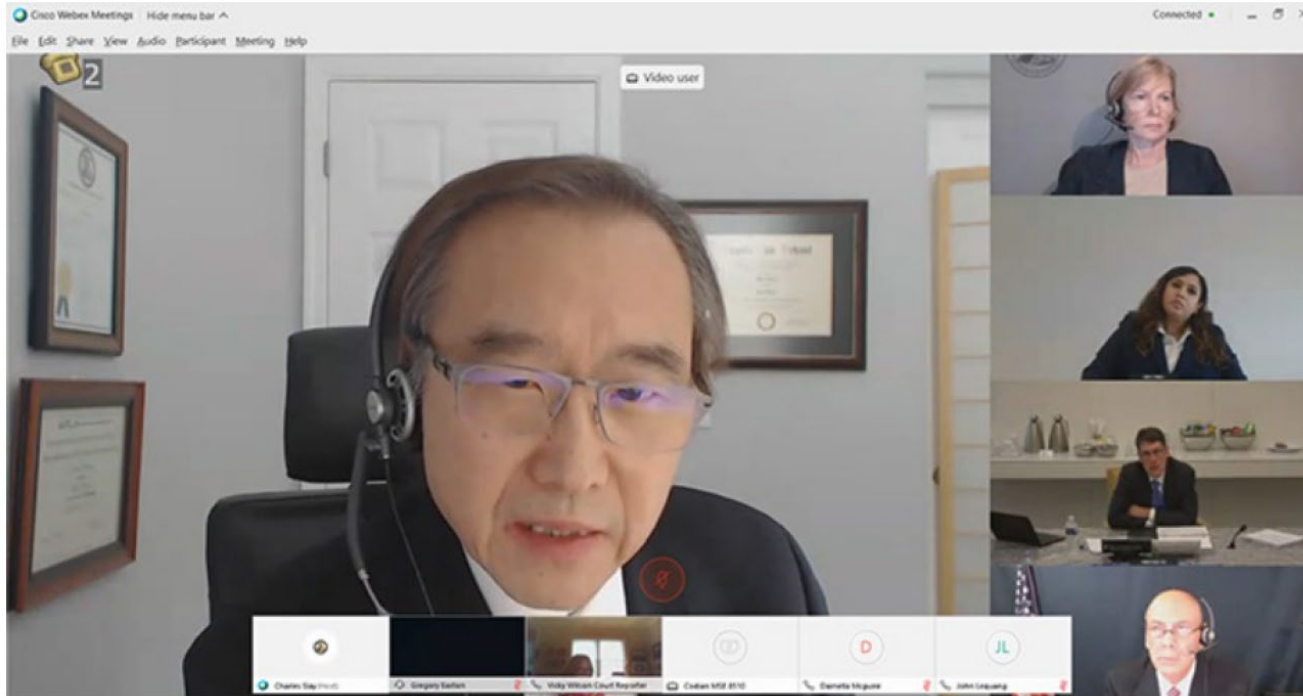
# Hearings Byte:

## hearings logistics

# Hearings

- Oral hearings can be requested in both ex parte appeals and AIA trials
- This presentation gives an introduction to logistics common to both types of hearings

# Remote hearings



# In-person hearings

Alexandria, Virginia



Detroit, Michigan



Dallas, Texas



Denver, Colorado



San Jose, California



# Additional resources

- For more hearings information, visit [uspto.gov/patents/ptab/hearings](https://uspto.gov/patents/ptab/hearings)
- You will find:
  - PTAB Hearings Guide
  - Hearing Locations
  - Forms and Samples
  - Hearing Schedule

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Scott Raevisky, Administrative Patent Judge

# Case study

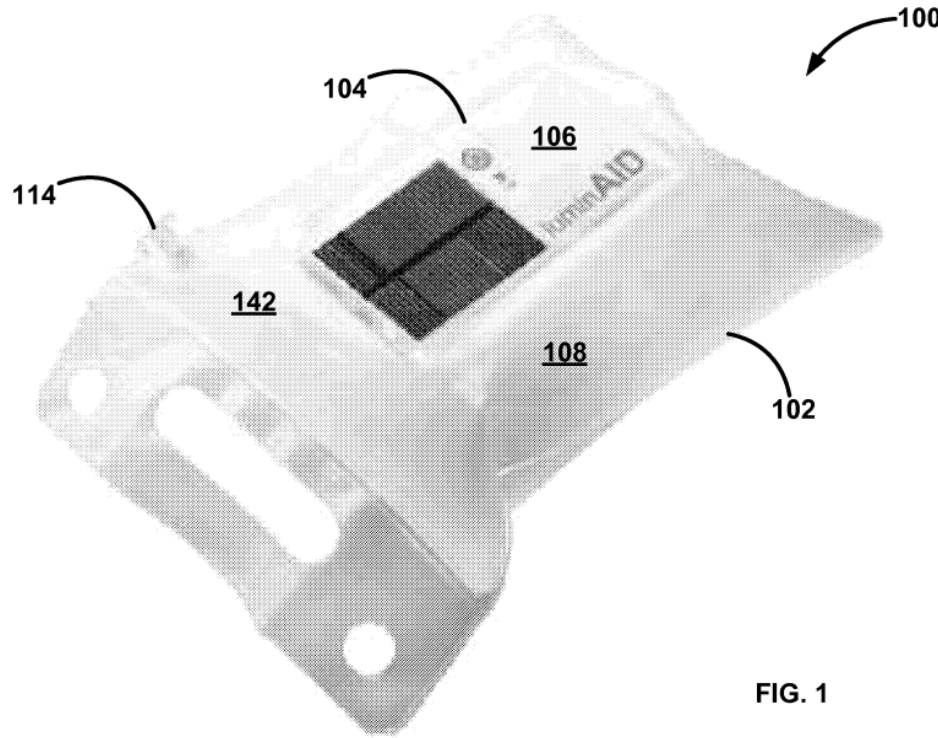


# Case studies goals

- Provide insight into patent prosecution
- Show how the inter partes review (IPR) framework requires a case-specific and fact-intensive inquiry
- Answer questions regarding PTAB's current approach

# U.S. Patent No. 9,347,629

(filed as U.S. Patent Application No. 14/397,722)



# Claim 1 as filed

1. An inflatable solar-powered light, comprising:
  - an expandable bladder including a plurality of surfaces;
  - a solar-powered light assembly positioned on at least one of said plurality of surfaces of said bladder; and
  - one or more cover portions positioned over said assembly and joined with said at least one of said plurality of surfaces of said bladder around edges of said one or more cover portions, wherein at least a portion of at least one of said at least one or more cover portions is substantially transparent and each of said one or more cover portions forms a substantially waterproof envelope with said at least one of said plurality of surfaces of said bladder in which said solar-powered light assembly is contained.

# Claim 1 as allowed by the Examiner

1. An inflatable solar-powered light, comprising:  
an expandable bladder having a plurality of surfaces that include a first plastic surface sealed at its edges and a second plastic surface opposed to the first plastic surface and sealed at its edges, the expandable bladder having a collapsed state and an expanded state; and  
a solar-powered light assembly positioned on the first plastic surface and having:  
a circuit board,  
a rechargeable battery electrically connected to the circuit board,  
a solar panel on a first side of the circuit board and electrically connected to the circuit board, and positioned to aim outside the bladder in the collapsed state and the expanded state,

at least one light-emitting diode opposed to the solar panel and attached to a second side of the circuit board to aim toward the second plastic surface when the bladder is in the collapsed state and the expanded state,  
wherein a substantially transparent cover portion covers the solar panel and circuit board, and is substantially waterproof, and wherein the first surface and the second surface lie flat adjacent each other when the bladder is collapsed.

# *Mpowerd v. Luminaid Lab, LLC*

IPR2018-01524, Paper 51 (Mar. 27, 2020)

- IPR process

- Aug. 8, 2018 Mpowerd filed an IPR petition
- Feb. 26, 2019 PTAB instituted IPR trial (Paper 6) and included a scheduling order (Paper 7)
- May 17, 2019 Patent Owner Luminaid filed a response to the IPR petition supported by a Declaration showing reduction to practice before the filing of the prior art



# *Mpowerd v. Luminaid Lab, LLC*

IPR2018-01524, Paper 51 (Mar. 27, 2020)

- IPR process (continued)

- July 25, 2019                      Petitioner Mpowerd deposed Declarant
- Aug. 16, 2019                      Petitioner Mpowerd filed a reply to the Patent Owner Luminaid's response
- Aug. 28-Oct. 21, 2019      A variety of motions were filed, including motions to seal, to exclude, and to allow live testimony
- Nov. 4, 2019                      Oral hearing with live testimony
- Feb. 25, 2020                      A Final Written Decision was issued in favor of Patent Owner Luminaid



# Takeaways

- Careful examination and appropriate claim amendments help limit the universe of relevant prior art, limiting opportunities for successful challenges
- An institution decision is not the final result
- Evidence supporting a position is always important, and here the evidence was dispositive for Patent Owner Luminaid

# Question/comment submission

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# Next Inventor Hour webinar



- **October** 28, 2021, at noon to 1 p.m. ET
- Topics
  - Meet a member of PTAB
  - Appeal Byte (how a decision is reached)
  - Walkabout the PTAB webpage
  - Trial Byte (pre-institution strategies for patent owners)
  - PTAB: a storied history

# Future Inventor Hour webinars



- **November** 18, 2021, at noon to 1 p.m. ET
- **December** 16, 2021, at noon to 1 p.m. ET

