

UNITED STATES
PATENT AND TRADEMARK OFFICE



Patent Trial and Appeal Board Inventor Hour: Episode 16

John Schneider, Administrative Patent Judge

Brandon Warner, Administrative Patent Judge

Tawen Chang, Administrative Patent Judge

Special guests

Jolyn Eley, Office of Patents Stakeholder Experience

Robert Hodge, Office of Patents Stakeholder Experience

Hellen Bryan-Johnson, Senior Trademark Policy Advisor

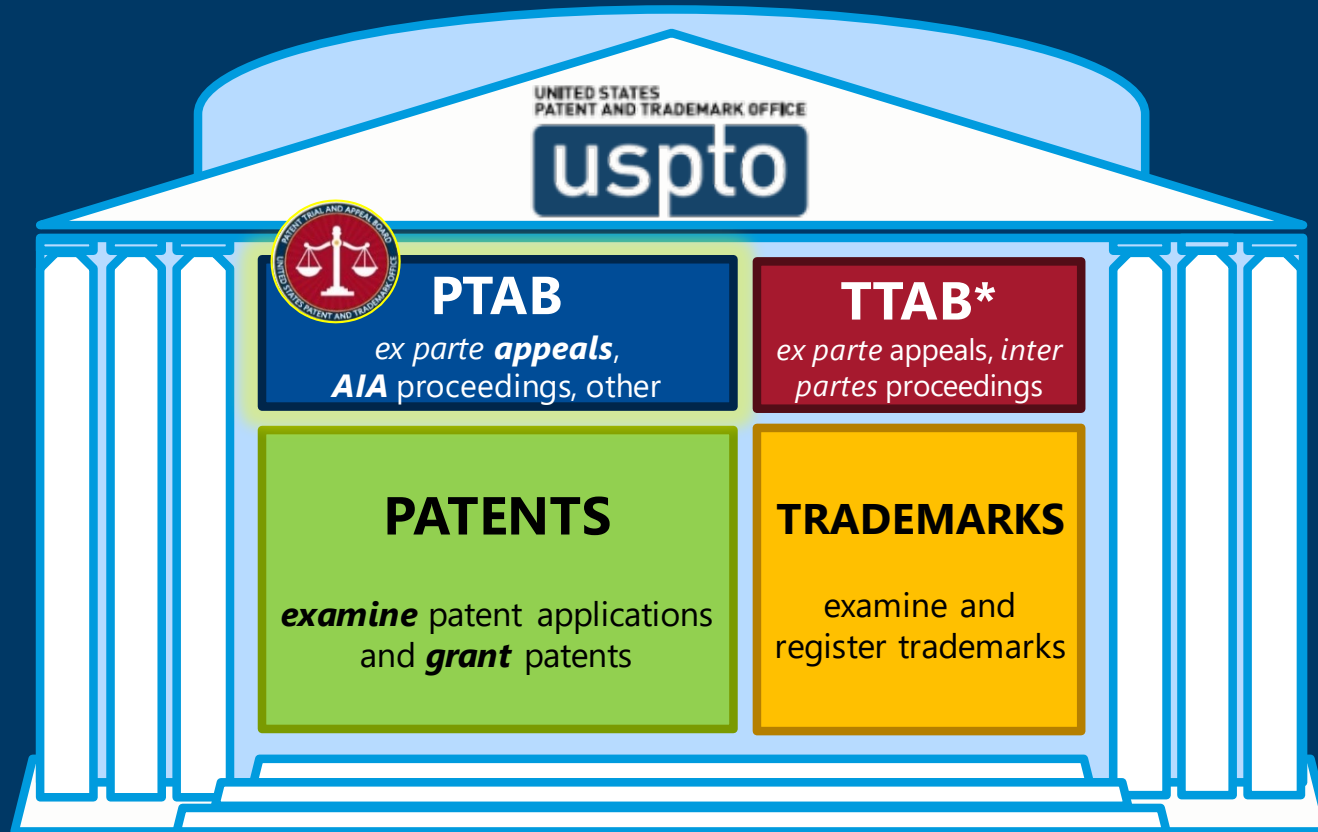
Ram Shukla, Supervisory Patent Examiner, TC 1600

March 23, 2023



UNITED STATES
PATENT AND TRADEMARK OFFICE ®

What is the Patent Trial and Appeal Board?



Today's agenda

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**Meet
Jolyn Eley &
Robert Hodge
OPSE**

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**Hearing Byte:
Inventors at
Ex Parte
Hearings**

3

**Walk About
the Web:
IP Identifier
Tool**

4

Q&A

Question/comment submission

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

– PTABInventorHour@uspto.gov



Brandon Warner, Administrative Patent Judge



Meet USPTO Professionals

Jolyn Eley & Robert Hodge

Office of Patents Stakeholder Experience

OPSE Office of Patents
Stakeholder Experience



Jolyn Eley



Robert Hodge

Question/comment submission

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Successful Inventing Series: product development



- Wednesday, April 22, 2023, 4:00-5:30 p.m. (PT)
- Topics include:
 - The job of product development is to obsolete the competition
 - Product design vs. product engineering
- Register at <https://www.uspto.gov/about-us/events/successful-inventing-product-development>
- The *Successful Inventing Series* is a set of monthly presentations that cover various aspects of the invention process, presented by the USPTO and the Licensing Executives Society - Silicon Valley Chapter.



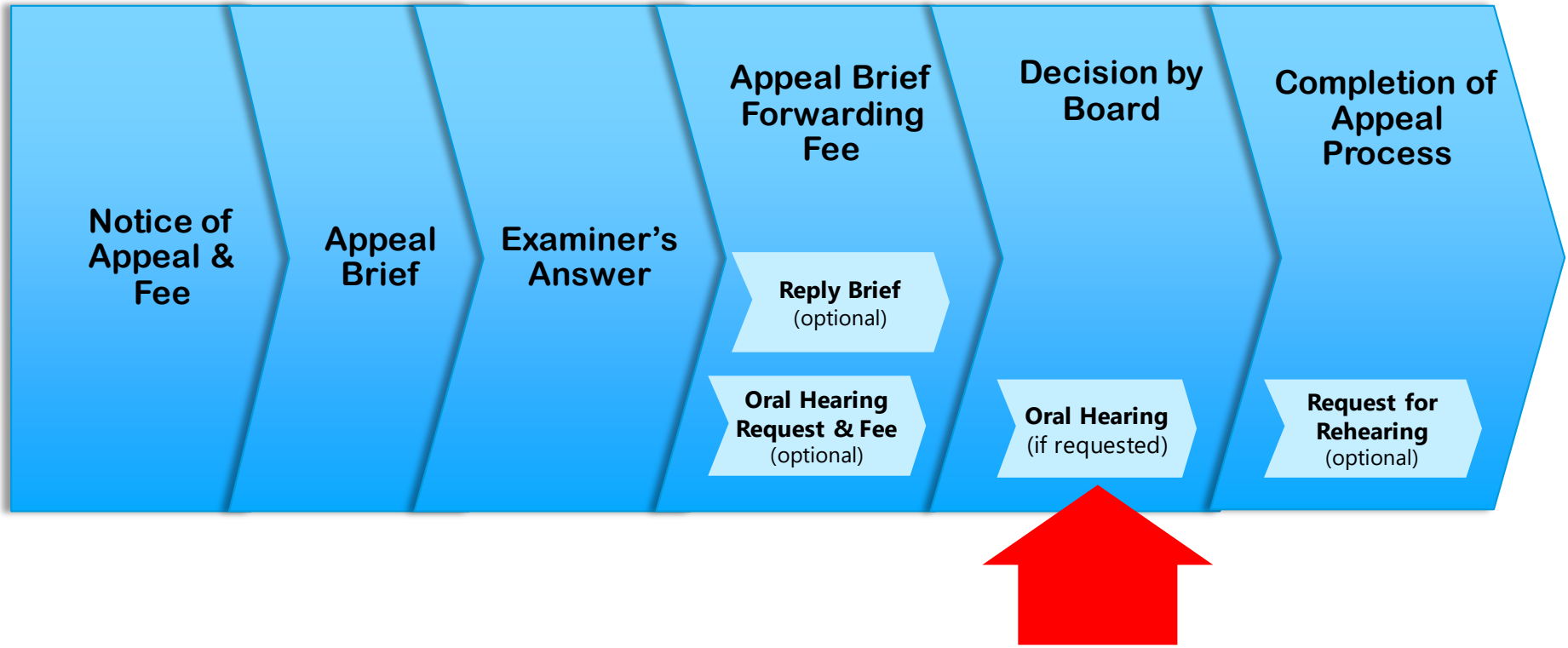
Tawen Chang, Administrative Patent Judge



Hearing Byte:

Inventors at Ex Parte Hearings

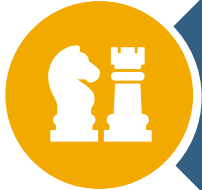
Hearings: ex parte appeals



Agenda



When & how

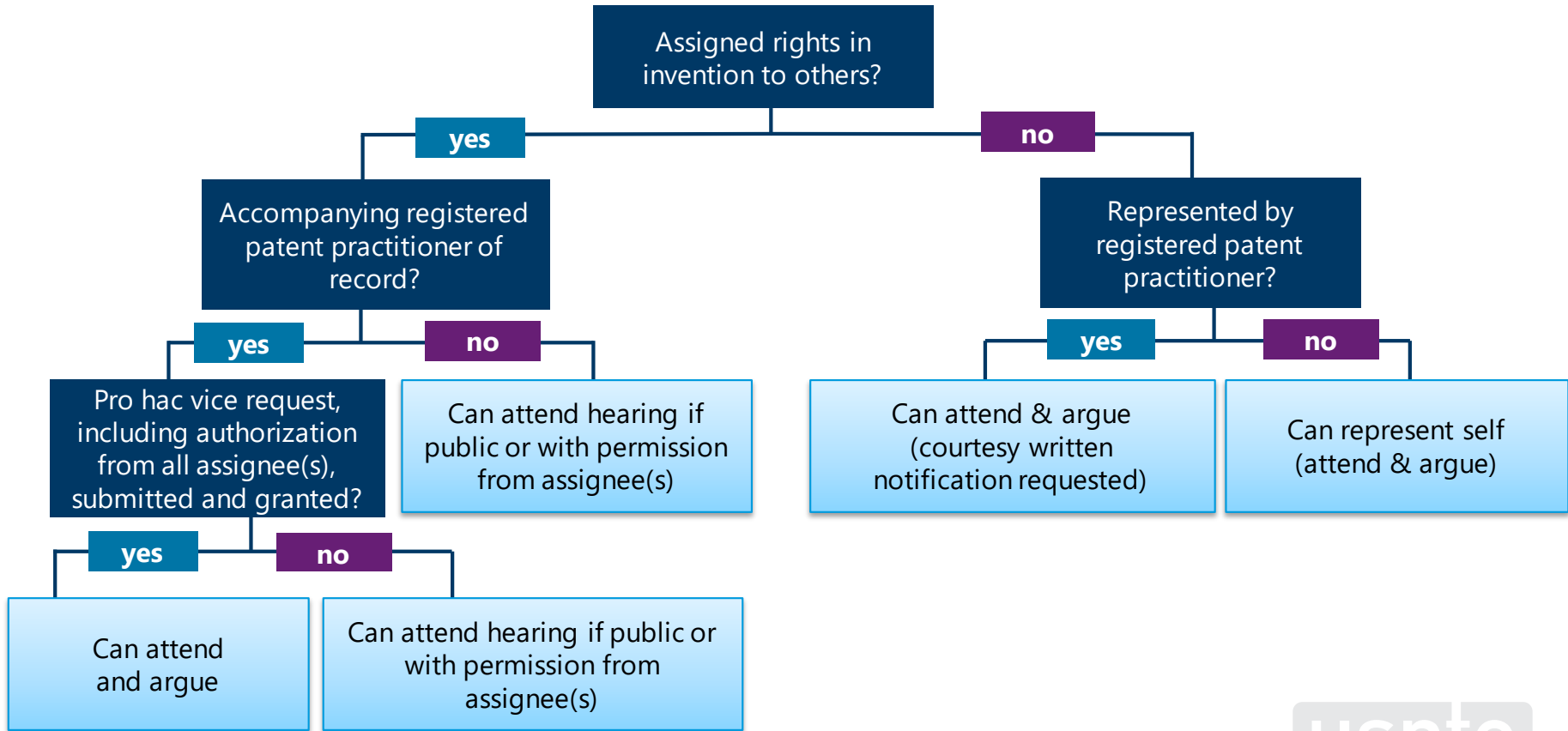


Strategic considerations

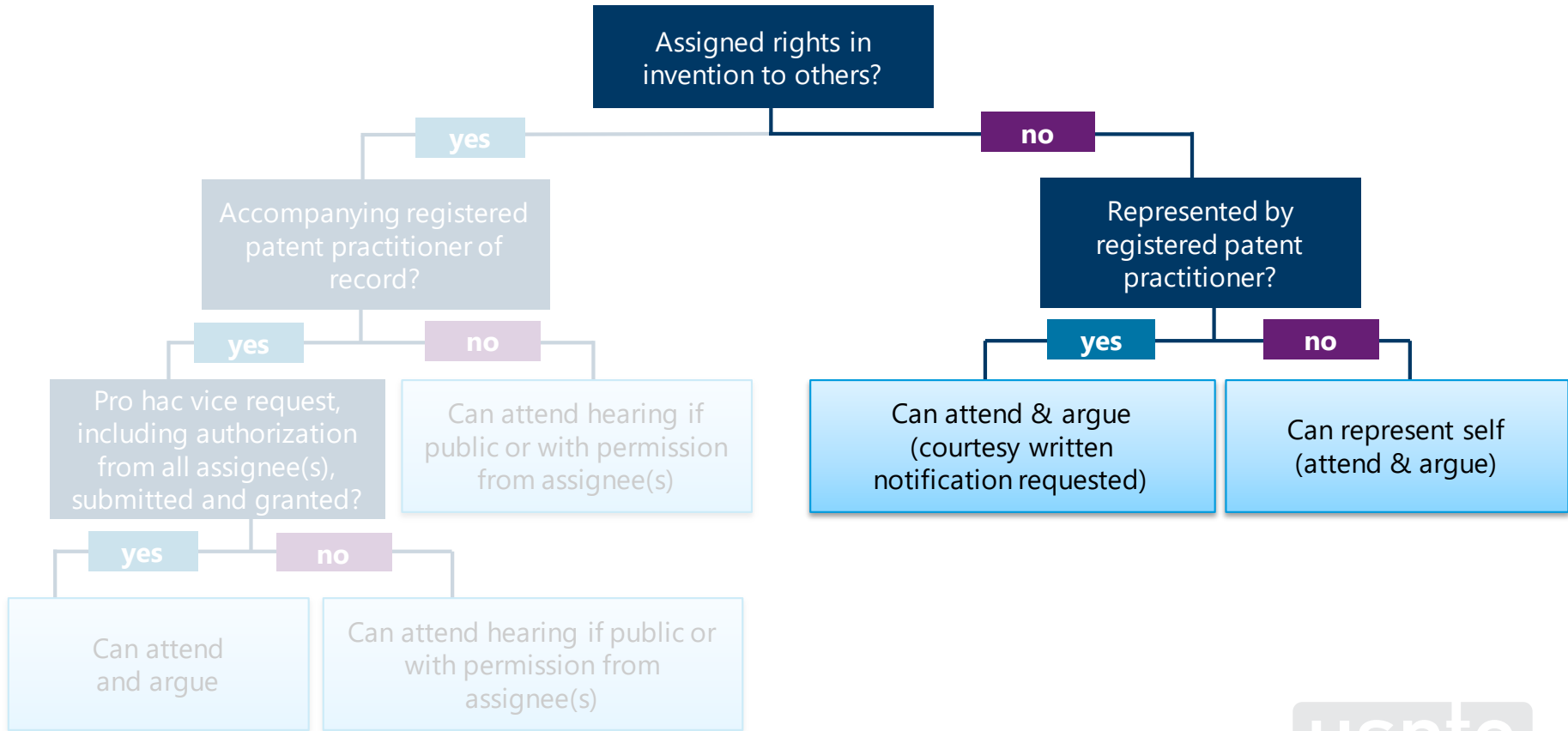


Best practices

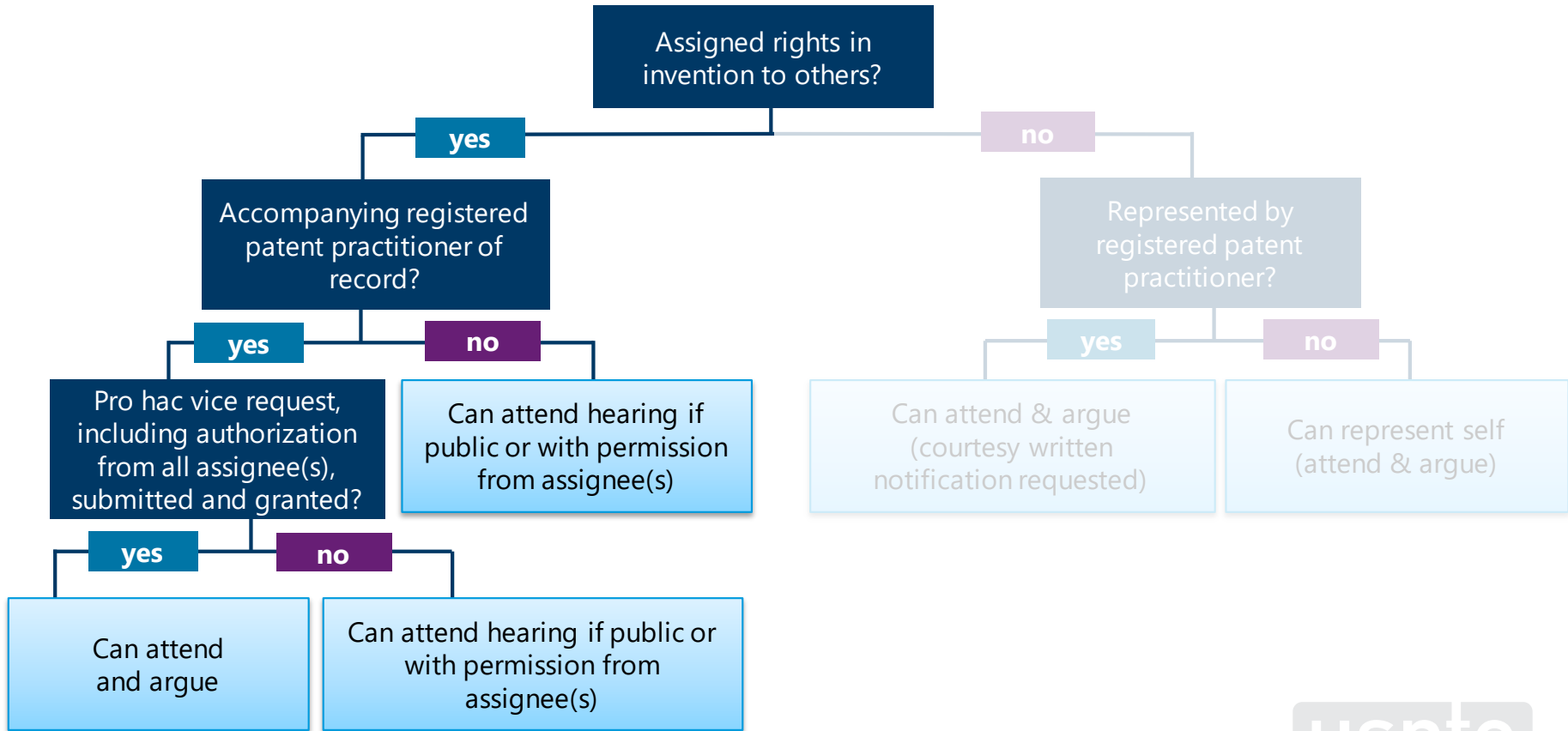
When & how inventors can participate



When & how inventors can participate



When & how inventors can participate



Communication with PTAB for ex parte appeals

Pro hac vice requests:

- E-mail/fax
- Attn: PTAB's hearings clerk
- PTABHearings@uspto.gov
- Fax: 571-273-9797
- **Good cause**
- **Authorization from all assignees**

Notifications regarding inventor participation:

- E-mail/fax
- Attn: PTAB's hearings clerk
- PTABHearings@uspto.gov
- Fax: 571-273-9797



Strategic considerations

- Clarify complicated technology
- Answer questions & respond to follow up (*no new evidence or arguments)
- Allow assessment of level of skill

- Limited time for presentation (20 minutes)
- Difficult to anticipate questions
- Statements may unintentionally support rejection

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Best practices



Consider alternatives

- Declarations during prosecution
- Help prepare counsel for hearing



Prioritize presentation

- Usually need not discuss background technology
- Focus on critical issue(s) where technical knowledge adds value
- No new arguments or evidence



Prepare & coordinate

- Coordinate with counsel
- Know the record
- Anticipate questions and prepare response if possible

Best practices



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United States Patent and Trademark Office



The Patent Trial and Appeal Board

Guide to the administration
of oral hearings before the
Patent Trial and Appeal Board

October 15, 2020

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Can I request that my hearing be rescheduled?

Who can present oral argument?

Can state law registered trademark practitioners present oral argument?

How much oral argument time is designated for each side?

Can an inventor accompany the registered patent practitioner at the oral hearing?

Can a party unaccompanied by a registered patent practitioner present oral argument?

Can an inventor who is unrepresented by a registered patent practitioner present oral argument?

Do I have to notify the PTAB if the registered practitioner of record who will be presenting arguments is different from the registered practitioner of record who will be presenting arguments?

Can a party request that an unaccompanied registered patent practitioner not of record present at the oral argument?

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present oral argument?20

How much time is designated to present oral argument?16

Can inventors accompany the registered patent practitioner of record during the appeal hearing?16

Can a party request that an unaccompanied registered patent practitioner not of record present at the oral argument?17

Can an inventor who is unrepresented by a registered patent practitioner present themselves and present oral arguments?17

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Question/comment submission

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Finding a patent practitioner



<https://www.uspto.gov/learning-and-resources/patent-and-trademark-practitioners/finding-patent-practitioner>

- The USPTO Office of Enrollment and Discipline (OED) maintains a **roll of active patent practitioners** who are eligible to represent others before the USPTO
- Only registered patent attorneys and agents, and individuals given limited recognition, can represent applicants before the USPTO



Ram Shukla, Supervisory Patent Examiner, TC 1600

Hellen Bryan-Johnson, Senior Trademark Policy Advisor



Walk About the Web:

IP Identifier Tool

Hellen
Bryan-Johnson



Senior Trademark Policy
Advisor

Ram
Shukla



Supervisory Patent
Examiner



What is the IP Identifier?

- User-friendly, online learning tool
- Enables you to
 - **Identify your potential IP**
 - and
 - **Learn how to protect it**
- Provides digestible information about protecting your IP (patents, trademarks, copyrights, trade secrets)
- Great starting point for those who are starting their IP journey



How does the IP Identifier work?

Basic IP Identifier

Answer six brief questions to identify your type of IP

Advanced IP Identifier

Individualized sections featuring basic information about a specific type of IP

Summary report

- Provides additional information and links to resources
- You can save questions and answers in a PDF



Coming
SOON

Tips for managing your IP assets

uspto®

Key features of the IP Identifier

- ❑ **IP basics** written in **plain language**
- ❑ **Flexible** starting points
- ❑ **Easy to complete** in one sitting
- ❑ **Summary report** for each category of IP
- ❑ **Brief survey** to gather input for future improvements

The screenshot shows the USPTO IP Identifier website. At the top, the USPTO logo and 'UNITED STATES PATENT AND TRADEMARK OFFICE' are visible, along with navigation links for 'About Us', 'Careers', and 'Contact Us'. The main heading is 'IP Identifier: Learn to identify and protect your intellectual property'. Below this is a navigation menu with 'Welcome', 'Basic IP Identifier', 'Advanced IP Identifier', and 'Tips for managing your IP assets'. A 'Feedback' section includes a survey link and the email 'IPIdentifierfeedback@uspto.gov'. A 'Need Help?' section provides technical assistance contact. The main content area is titled 'Where do I start?' and contains introductory text, a survey question, and two radio button options. A disclaimer is located at the bottom of the main content area. The footer contains OMB Control Number 0651-0080, expiration date 11/30/2024, and a PRA Statement.

uspto UNITED STATES PATENT AND TRADEMARK OFFICE

About Us Careers Contact Us

INTELLECTUAL PROPERTY IDENTIFIER

IP Identifier: Learn to identify and protect your intellectual property

→ Welcome

- Basic IP Identifier
- Advanced IP Identifier
- Tips for managing your IP assets

Feedback

Please use this brief [survey](#) to share your valuable feedback.

Need Help?

If you need technical help with using the tool please email IPIdentifierfeedback@uspto.gov

Where do I start?

Learn how to identify which of your creative ideas might be intellectual property assets and how to protect them by using the USPTO Intellectual Property (IP) Identifier.

Are you thinking about starting a business? Do you own one already? Or maybe you're an inventor, artist, or designer. Maybe you sell goods online or in a store or provide a service to others. If so, you may have **intellectual property**.

Do you know what types of IP you might have? Do you know how to protect them?

No, I don't know what types of IP I have

Yes, I do know what types of IP I have

DISCLAIMER:
The information provided in this website is for general information purposes only and does not constitute legal advice. When filing an application for obtaining specific IP rights, you may benefit from professional legal assistance. While the USPTO cannot aid in the selection or recommendation of an attorney or agent, [a register of active patent practitioners is available from the Office of Enrollment and Discipline](#). This IP Identifier contains links to third-party websites. The USPTO is not responsible for the material found therein. Please review the [Linking policy](#) for more information.

OMB Control Number: 0651-0080
Expiration Date: 11/30/2024

PRA Statement
A Federal agency may not conduct or sponsor, and a person is not required to respond to, nor shall a person be subject to a penalty for failure to comply with an information collection subject to the requirements of the Paperwork Reduction Act of 1995, unless the information collection has a valid OMB Control Number. The OMB Control Number for this information collection is 0651-0080. Public burden for this survey is estimated to average 5 minutes per response, including the time for reviewing instructions, searching existing data sources, gathering and maintaining the data needed, and completing and reviewing the information collection. Send comments regarding this burden estimate or any other aspect of this information collection, including suggestions for reducing this burden to the Office of the Chief Administrative Officer, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450 or email informationCollection@uspto.gov

How do I access the IP Identifier?

- Available in multiple locations on the USPTO's website

The screenshot shows the USPTO website interface. At the top, there is a search bar with the text "Search uspto.gov" and a magnifying glass icon. Below the search bar are navigation tabs for "Patents", "Trademarks", "IP Policy", and "Learning and Resources". A "Find It Fast" button is also visible. The main content area features a large banner with portraits of two men and handwritten text, with the heading "Found on Baker's list" and a link to "Documenting the history of Black innovation one name at a time FULL STORY>". To the right, a "New to IP?" section contains several links: "Patent basics", "Trademark basics", "Identify what kind of IP you have", "Inventor & entrepreneur resources", "Access our free services", "Training and education events", and "USPTO in your region".



IP Identifier

Live demo



Identify what kind of intellectual property (IP) you have

NEW!

Answer six brief questions to identify your IP and then learn how to protect it

Find out more at
ipidentifier.uspto.gov





Thank you!

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www.uspto.gov

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Future programs



Inventor Hour, Episode 17

Thursday, April 27, noon (ET)

Inventor Hour, Episode 18

Thursday, May 25, noon (ET)



