

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Patent Trial and Appeal Board Inventor Hour Webinar: Episode 10

Ryan Flax, Lead Administrative Patent Judge, PTAB

Robert Silverman, Administrative Patent Judge, PTAB

Lynne Browne, Administrative Patent Judge, PTAB

Jeffrey Fredman, Administrative Patent Judge, PTAB

Brandon Warner, Administrative Patent Judge, PTAB

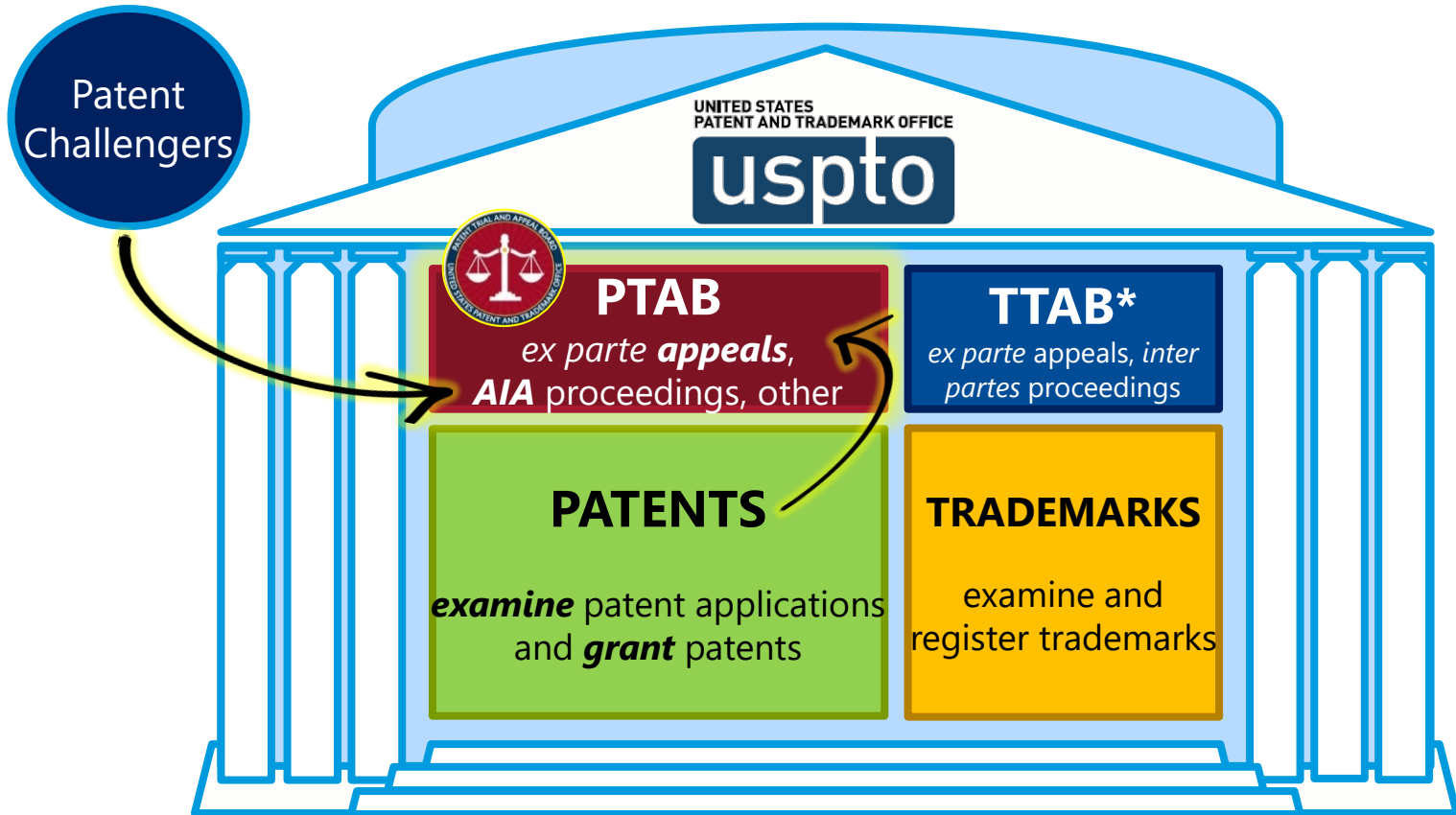
Stephen Key, Inventor, inventRight, LLC

July 28, 2022

UNITED STATES
PATENT AND TRADEMARK OFFICE



Refresher: What is the Patent Trial and Appeal Board (PTAB or the Board)?



*Trademark Trial and Appeal Board (TTAB)

Today's agenda

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Inventor**

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Q&A

*INFORMATION NOT INTENDED AS LEGAL ADVICE

Question/comment submission

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

- PTABInventorHour@uspto.gov

Brandon Warner, Administrative Patent Judge



Meet an Inventor:
Stephen Key, inventRight, LLC.



Stephen Key
inventRight, LLC





Robert Silverman, Administrative Patent Judge



Appeal Byte:

What is Prior Art

Role of prior art in evaluating patent rights

-  **Anticipation:** Single item of prior art describes what is claimed (35 U.S.C. §102).
-  **Obviousness:** Claimed invention would have been obvious to a person of ordinary skill in the field, in view of one or more items of prior art (35 U.S.C. §103).

Categories of prior art

Patent or
published
application

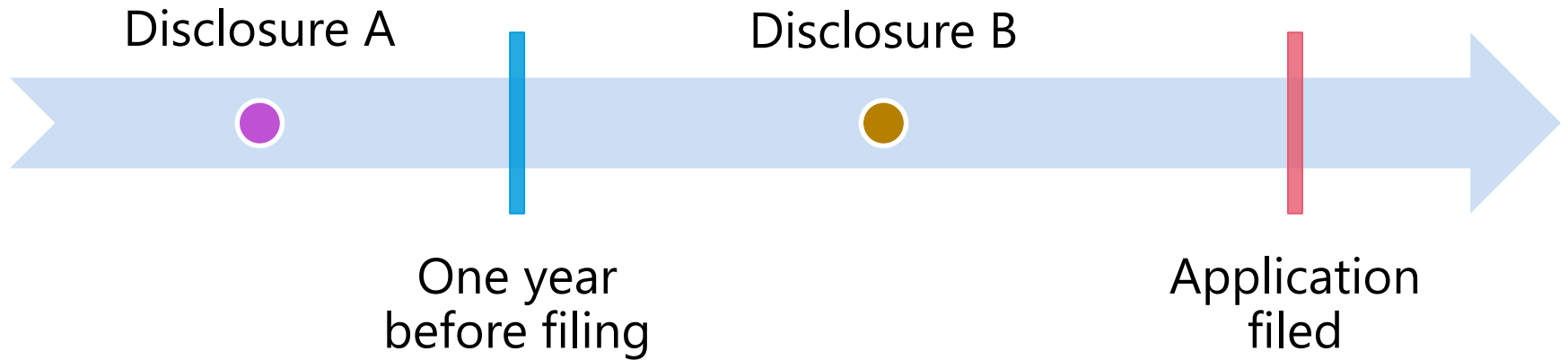
Printed
publication

Public use

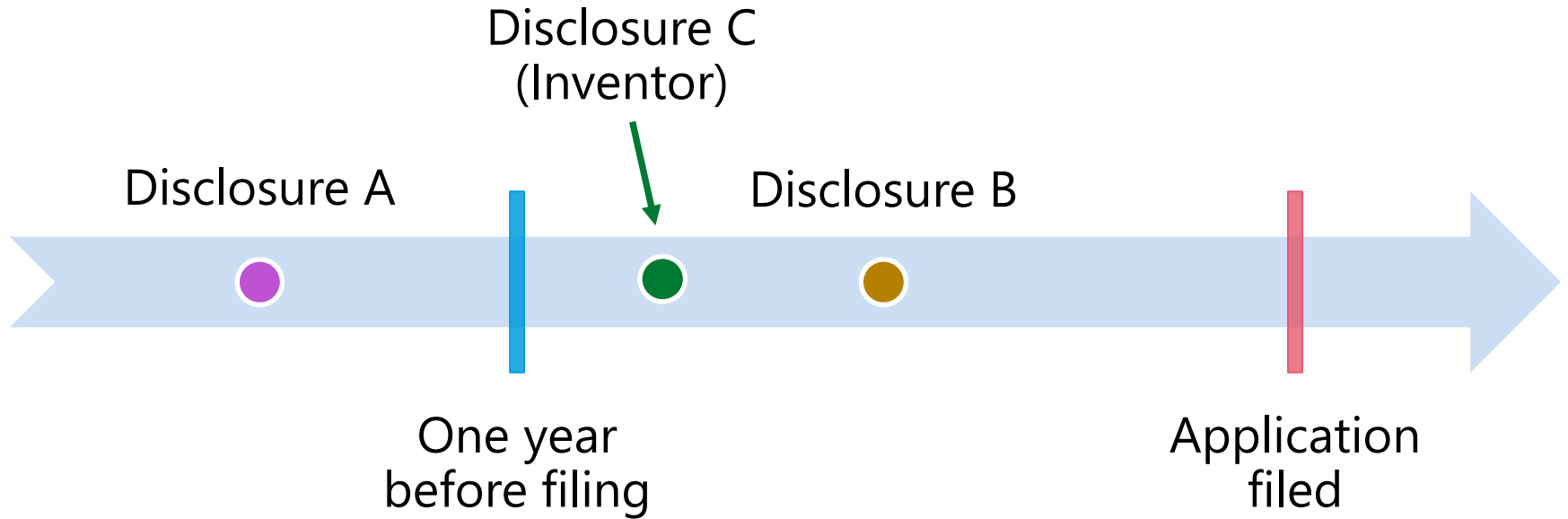
On sale

Otherwise
available to
the public

Timing of prior art



Timing of prior art



Printed publications

590

ASTRONOMY: W. H. WRIGHT

This research has been supported by a grant of three hundred dollars from the Warren Fund of the American Academy of Arts and Sciences, and for this aid we wish to express our indebtedness.

- ¹ Cambridge University Press.
- ² *Amer. Physik. Zeitsch.*, Ser. 4, 20, 237-68, 606-18 (1906); *Zt. physik. Chem., Leipzig*, 64, 686 (1908); 84, 410 (1913).
- ³ 18 papers in *J. Amer. Chem. Soc.*, 30, 33, 35.
- ⁴ *J. Amer. Chem. Soc.*, 33, 1060 (1911).
- ⁵ Richards and Coombs, *Ibid.*, 37, 1656-76 (1915); these PROCEEDINGS, 1, 404 (1915).
- ⁶ *Amer. Physik.*, Ser. 4, 9, 434 (1902).

OUTLINES OF A PROPOSED SYSTEM OF CLASSIFICATION OF THE NEBULAE BY MEANS OF THEIR SPECTRA*

By W. H. Wright

LICK OBSERVATORY, UNIVERSITY OF CALIFORNIA
Presented to the Academy, October 22, 1915

This paper may properly be considered a continuation of one previously published in these PROCEEDINGS, 1, 266 (1915). In that article the opinion is expressed that the behavior of the line 4686A might serve as the basis of a classification of the nebulae. The notion will be discussed here in greater detail. About eleven of the planetary nebulae have been studied with a fair degree of completeness, and while this number is too low to afford the most secure basis for broad generalizations, the observations seem to point the way to a rational system of classification of these objects on the basis of their spectra.

In figure 1 are reproduced the spectra of nine planetary nebulae and the great nebula in Orion. As stated in the earlier paper the method adopted for observing the spectra of such nebulae consists in placing the slit of the spectrograph directly across the image. In this way the length of a spectral line is made to furnish a measure of the extent of the occurrence of the emitting material in the nebula.

The first spectrum shown is that of N. G. C. 7027. This nebula consists of two nuclei, of unequal brightness, surrounded by fainter nebulosity. In photographing the spectrum the slit was placed in the line of the two nuclei. The spectrum shows the nebula to be unusually homogeneous. Some of the fainter lines appear to be short but that is probably merely the result of their faintness, as they are no shorter than the

* This and the following paper contains, in abbreviated form, the substance of one read before the eighteenth (Pacific Coast) meeting of the American Astronomical Society, under the title: *The spectra of the gaseous nebulae and some points of correspondence between them and other celestial spectra.*

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14 PAGES 1ST EDITION

WEATHER

THE ASSOCIATED PRESS THE INTERNATIONAL NEWS SERVICE THE PACIFIC NEWS SERVICE

EVENING TRIBUNE

ESTABLISHED 1916 PAGE TWO CENTS SAN DIEGO, CALIFORNIA, FRIDAY, MAY 7, 1915

LUSITANIA TORPEDOED

SINKING OF GREAT LINER MAY INVOLVE UNITED STATES

FATE OF PASSENGERS AND CREW UNCERTAIN MOST SERIOUS EVENT OF WAR, IS OPINION HELD IN WASHINGTON

VICTIM OF SUBMARINE SINKS OFF IRISH COAST IN THIRTY MINUTES

By HERBERT TEMPLE
European Manager of the I. N. S.

LONDON, May 7.—Germany today delivered her greatest sea blow of the war at Coast Britain, when the great Cunard liner Lusitania was torpedoed by a German submarine off Kinalee Head, Ireland.

The liner to the Lusitania was delivered at 3:30 o'clock this afternoon, when the vessel was in the Atlantic, eight miles off the Heads of Kinalee, on the south coast of Ireland.

1400 PASSENGERS ON BOARD SHIP

More than 1400 passengers, among them over 3000 "neutral" Americans, were aboard the liner.

At 5:30 o'clock this afternoon, Lloyd's issued a statement that the Lusitania was believed to have been blown up by an infernal machine. The statement said:

"We have no details of the fate of the passengers and crew, but they are considered to be safe."

The first news of the disaster to the big liner came from Queenstown. It said:

"Last night wireless reports the following disaster call from the Lusitania: 'Come at once. Big fire. Passengers two miles south Kinalee.'"

Subsequently word was received here that all available craft from the harbor along the southern coast of Ireland had been dispatched to the big liner's assistance. Still later advices from Queenstown said:

"About twenty boats belonging to the Lusitania are in the vicinity of the disaster. About fifteen vessels are waiting to the Lusitania's assistance."

BRITISH AT FIRST SCEPTICAL

As soon as news of the disaster was received here, the Canal office was besieged by anxious inquiries. Some of the American residents of London rushed to the American embassy, clamoring for news of the Americans who sailed on the Lusitania.

At first the public was skeptical of the report of the disaster, believing it impossible that a submarine could reach the liner's position.

The admiralty had been at the greatest pains to guard the Lusitania and other big liners in the belief that they would be needed as transports. Not only were warships sent out to protect the Lusitania, but special ships were sent out to guard the lane north and east of Ireland.

TORPEDO SINKS BIG SHIP

NEW YORK, May 7.—The disaster to the Lusitania, the largest liner afloat, and which the admiralty said this evening is believed to have sunk in 20 minutes, has been confirmed by the British admiralty. The liner was torpedoed by a German submarine off the coast of Ireland, and was sunk about 11 miles south of the Heads of Kinalee. Three hundred and thirty-five Americans were aboard the liner, and it is estimated that 1400 passengers were on board the vessel when it was torpedoed. The vessel was carrying 1000 tons of munitions.

SEVERAL BRITISH AT ASSISTANCE

The disaster to the Lusitania, the largest liner afloat, and which the admiralty said this evening is believed to have sunk in 20 minutes, has been confirmed by the British admiralty. The liner was torpedoed by a German submarine off the coast of Ireland, and was sunk about 11 miles south of the Heads of Kinalee. Three hundred and thirty-five Americans were aboard the liner, and it is estimated that 1400 passengers were on board the vessel when it was torpedoed. The vessel was carrying 1000 tons of munitions.

LOCKWOOD MAY GO IN TODAY

FORTUNE TELLERS TO FACE TRIAL

PASSENGERS WARNED BEFORE SHIP SAILS

JITNEY THROWS WHEEL PASSENGER IS KILLED

FORMER GREEK PREMIER IS RECALLED TO ATHENS

The Relative Values of News Services

ARTICLE NO. 1


In the most fully equipped and complete newspaper office in the West, the relative values of news services are being studied by the Evening Tribune. The office is equipped with the latest and most complete equipment for the production of news services. The office is equipped with the latest and most complete equipment for the production of news services.

BIOLOGY AND ITS MAKERS

With Portraits and Other Illustrations

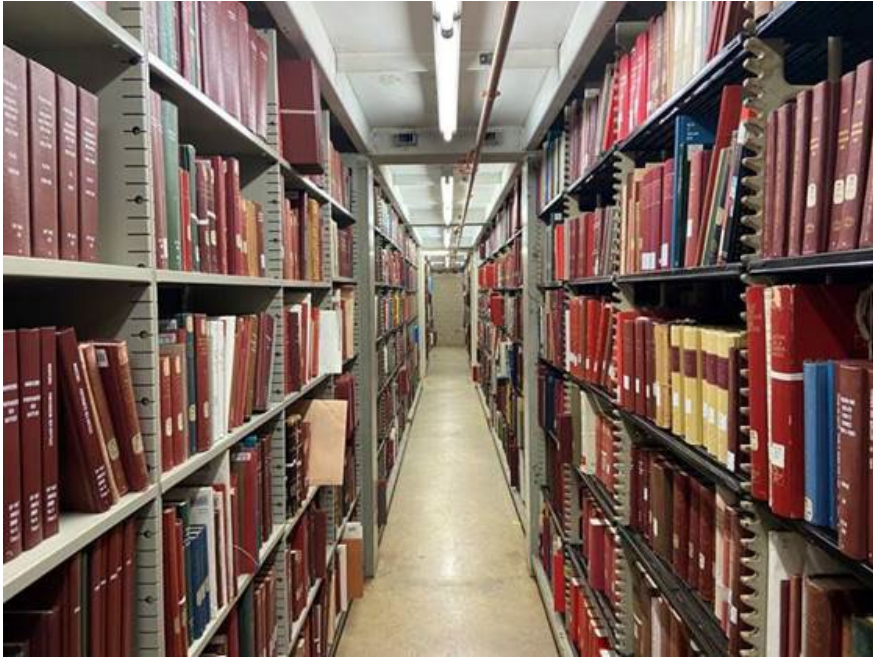
BY WILLIAM A. LOCY, Ph.D., Sc.D.
Professor in Northwestern University

THIRD EDITION, REVISED



NEW YORK
HENRY HOLT AND COMPANY
1915

Theses



In re Hall, 781 F.2d 897 (Fed. Cir. 1986).



In re Bayer, 568 F.2d 1357 (CCPA 1978).

Online publications

Look at the CGI environment variable HTTP—REFERER. In Perl, you can do something like this:

```
# !/usr/local/bin/perl

$referer=$ENV {'HTTP_REFERER'};

print "Content-type: text/plain", "**n";

if ($referer =~ /abc*.html/){

print "A link in abc.html called this document.", "**n";}

}elsif ($referer =~ /efg*.html/){

print "A link in efg.html called this document.", "**n";}


else{

print "A link in", $referer, "called this document.", "**n";

}

exit(0);
```

Suffolk Techs., LLC v. AOL Inc.,
752 F.3d 1358 (Fed. Cir. 2014).

 **Joint Collaborative Team on Video Coding (JCT-VC)**
of ITU-T SG16 WP3 and ISO/IEC JTC1/SC29/WG11
6th Meeting: Torino, IT, 14-22 July, 2011

Document: [JCTVC-F803_d42](#)

Title: **WD4: Working Draft 4 of High-Efficiency Video Coding**

Status: Output Document of JCT-VC

Purpose: Working Draft of HEVC

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Fraunhofer HHI / TU Berlin	

Source: Editor

Abstract

Working Draft 4 of High-Efficiency Video Coding.

Ed. Notes (WD4):

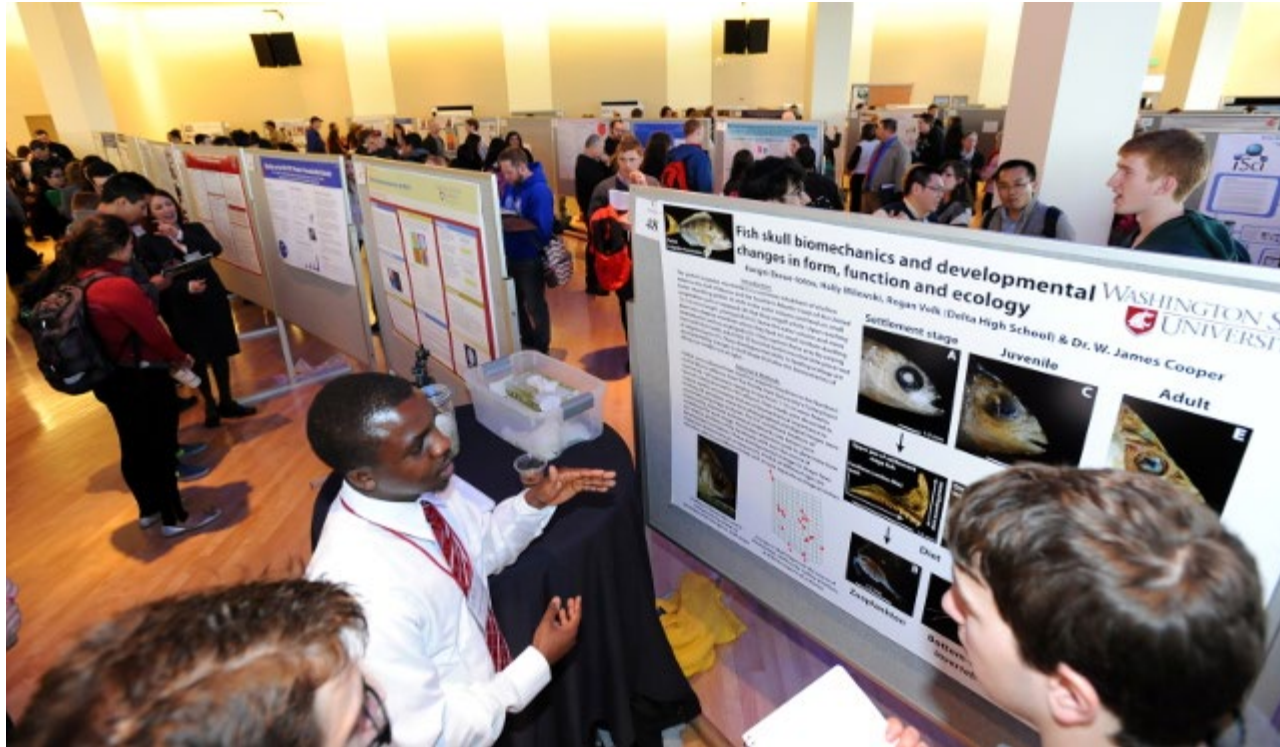
- Removed inferred merge (JCTVC-F082)
- Incorporated slice header flag to disable 4x4 inter partitions (JCTVC-F744)
- Incorporated modified rounding in MV scaling (JCTVC-F142)
- Removed intermediate amvp spatial candidates redundancy check (JCTVC-F050)
- Incorporated reducing the number of spatial mv scalings to 1 (JCTVC-F088)
- Incorporated spatial merge candidate positions unification (JCTVC-F419)
- Incorporated one reference list check for temporal mvp (JCTVC-F587)
- Incorporated AMVP/merge parsing robustness with simplifications (JCTVC-F470)
- Incorporated unified availability check for intra (JCTVC-F477)
- Incorporated generic interpolation filter (JCTVC-F537)
- Incorporated non-square quadtree transform NSQT (JCTVC-F412)
- Incorporated asymmetric motion partitions AMP (JCTVC-F379)
- Incorporated [CABAC redundancy reduction \(JCTVC-G227\)](#)
- Incorporated [modified delta OP binarization \(JCTVC-F745\)](#)
- Incorporated [diagonal coefficient scanning in CABAC \(JCTVC-F129\)](#)
- Incorporated [parallel context processing for coefficient levels in CABAC \(JCTVC-F130\)](#)
- Incorporated [context sharing for significant_coeff_flag of 16x16 and 32x32 transforms \(JCTVC-F132\)](#)
- Incorporated [unified scans \(JCTVC-F288\)](#)

Ed. Notes (WD3):

- Added Residual coding CABAC syntax and semantics
- Added Zig-zag scanning process
- Added CABAC Binarization processes
- Incorporated MV coding (JCTVC-E481)
- Incorporated Compression of reference indices (JCTVC-E059)
- Incorporated Zero merge candidate (JCTVC-E146)
- Incorporated Intra mode coding (JCTVC-E088/E131) (Inserted by TK 31/3/2011 with notes)
- Fixed the CABAC coefficients syntax, semantics and inverse scanning process
- Incorporated CABAC coeffs (JCTVC-E253)

Samsung Elecs. Co. v. Infobridge Pte. Ltd.,
929 F.3d 1363 (Fed. Cir. 2019).

Conference presentations



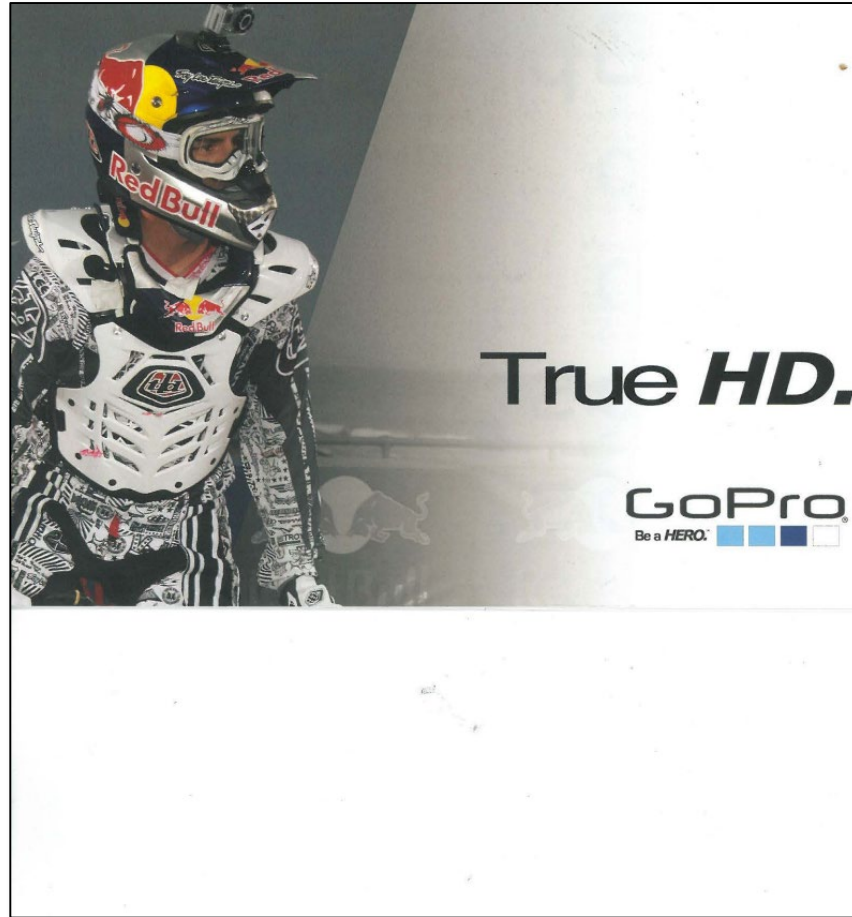
In re Klopfenstein, 380 F.3d 1345 (Fed. Cir. 2004).

Protected information



In re Klopfenstein, 380 F.3d 1345 (Fed. Cir. 2004).

Sales catalog



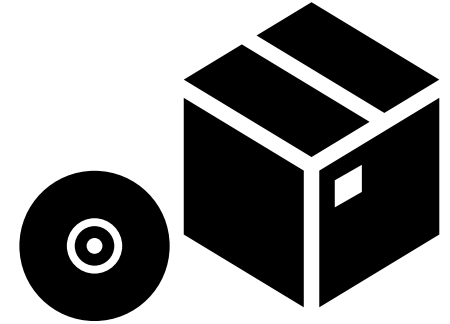
GoPro, Inc. v. Contour IP Holding LLC,
908 F.3d 690 (Fed. Cir. 2018).

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Is it a prior art “printed publication”?

Scenario 1

- Product Manual on CD ROM
- Distributed to the 586 individual Purchasers
- Product was advertised widely to persons in the technical field
- Expensive (\$25,000)
- No confidentiality restrictions on copying/ distribution “for non-commercial use”



Is it a prior art “printed publication”?

Scenario 1

- **Yes**, Product Manual is a “printed publication.”
- “Public accessibility is not limited to circumstances of free or academic distributions; ‘commercial distribution can qualify.”

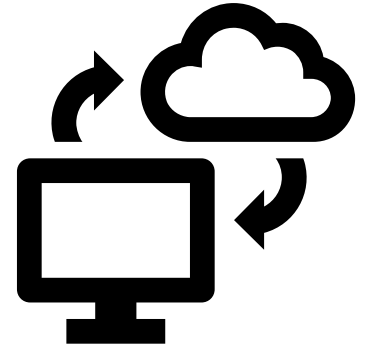
Centripetal Networks, Inc. v. Cisco Systems, Inc., 847 F. App’x 869 (Fed. Cir. 2021)



Is it a prior art “printed publication”?

Scenario 2

- Technical Report on university department website
- Indexed by Author Name and Year of posting
- Not searchable



Is it a prior art “printed publication”?

Scenario 2

- **No**, the Technical Report is **not** a “printed publication”
- The Technical Report was “not *meaningfully* indexed such that an interested artisan exercising reasonable diligence would have found it.”

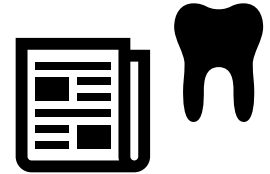


Acceleration Bay, LLC v. Activision Blizzard Inc.,
908 F.3d 765 (Fed. Cir. 2018)

Is it a prior art “printed publication”?

Scenario 3

- Product Catalog provided at a dental product trade show
- Seeking distributors for the product
- Between 200-500 copies made available
- Provided to attendees, without indication of confidentiality obligations



Is it a prior art “printed publication”?

Scenario 3

- **Yes**, the Product Catalog is a “printed publication.”
- “[T]he [Product] Catalog is the type of document intended for public dissemination, and it bears no designations, such as ‘draft’ or ‘confidential,’ that might suggest that it was not intended for public distribution.”



Nobel Biocare Servs. AG v. Instradent USA, Inc., 903 F.3d 1365 (Fed. Cir. 2018)

Question/comment submission

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

- PTABInventorHour@uspto.gov

PTAB Pro Bono Program



- Under-resourced inventors may receive free legal help from volunteer attorneys for ex parte appeals before the PTAB
- For more details – watch the recording of the [April Inventor Hour webinar](#) online or check out the PTAB Pro Bono Program at www.uspto.gov/ptabprobono



Merrell C. Cashion, Jr., Administrative Patent Judge



Hearing Byte:

How Judges Prepare for *Ex Parte* Hearings







Judges' preparation for an *ex parte* hearing

- **Preparation** is key for a productive hearing
 - Appellant/Counsel identifies critical issues that favor appellant's position
 - Judges ask questions on issues on which the outcome of a case may turn






Judge Panels

- Each case is assigned to a panel of **at least three judges**
- All three judges are present at a case hearing (in-person, virtually, or some combination thereof)
- The examiner typically does not appear at the hearing
- Judges typically ask the appellant questions at the hearing to aid in understanding the issues and how those issues should be decided

Pre-hearing record review

- Before the hearing, the panel of judges reviews the record for each appeal
- This review typically includes:
 -  Specification and Drawings
 -  Appeal Brief and Reply Brief (if filed)
 -  Declarations (if any discussed in the Appeal Brief)
 -  Appealed Office Action, including evidence relied upon (references)
 -  Examiner's Answer
 -  Any additional document deemed necessary



Purpose of pre-hearing record review

- Review of the Appeal and Reply Briefs (**papers by appellant**):
 -  identifying the critical issues that appellant believes favor their case
 -  understanding appellant's explanation of why the examiner erred as to each ground of rejection contested
 -  identifying the weakest parts of the case on which the outcome may turn
- Review of the Appealed Action and Answer (**papers by examiner**):
 -  understanding the examiner's application of the evidence (references), including the interpretation of the evidence and conclusions
 -  understanding the examiner's reliance on the relevant laws cited in arriving at the stated conclusions

Goals of pre-hearing record review

- The goals of a judge's review of the record:
 - become familiar with the record of the appeal
 - identify the salient issues for discussion in the pre-hearing conference held among the panelists

Pre-hearing conference

- At an internal pre-hearing conference, judges discuss a case to:
 -  crystallize the key issues for discussion at the hearing
 -  walk through the evidence of record
- The panel of judges makes **no decision** on the outcome of an appeal **BEFORE** the hearing

Day of the hearing

The judges are ready!

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



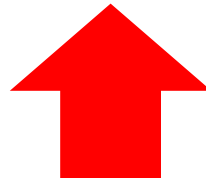
Lynne Browne, Administrative Patent Judge








Trial Byte:

Patent Owner Response

Overview of AIA proceedings



Patent owner response

-  Failing to address an issue may result in a **waiver**
-  Due **three months** from institution
-  Opportunity to file a **motion to amend**
-  Opportunity to address **merits** of Petition
-  Opportunity to supplement the evidentiary record with a **declaration**

Formal content of PO response

IPR2021-00052 (USP 9,877,562) Patent Owner's Response

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Level of ordinary skill and claim construction

“Factors that may be considered in determining **level of ordinary skill** in the **art** include: (1) the educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and (6) educational level of active workers in the field.” *Environmental Designs, Ltd. v. Union Oil Co. of CA*, 713 F2d 693, 696 (Fed. Cir. 1983).

IPR2021-00052 (USP 9,877,562)

Patent Owner's Response

C. Person of Ordinary Skill in the Art (“POSA”)

Dafni does not dispute Ontel's proposed level of skill in this proceeding, but reserves the right to do so in others.

D. Claim Construction

For the purposes of this IPR, Dafni agrees with Ontel that the claims should be given their “ordinary and customary meaning.” Pet. 11. In later sections, Dafni further explains the ordinary and customary meaning in the context of the claim elements.

Evidence

Filed on behalf of: Guy A. Shaked Investments, Ltd.

Entered: January 20, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ONTEL PRODUCTS CORPORATION,
Petitioner,

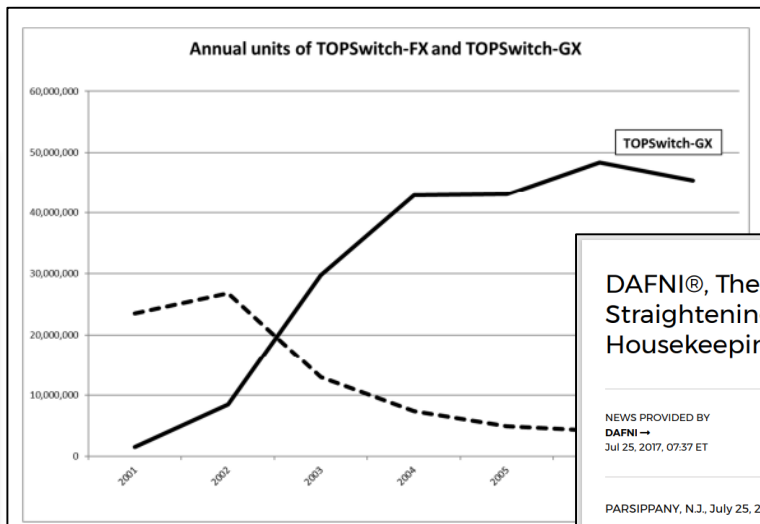
v.

GUY A. SHAKED INVESTMENTS LTD.,
Patent Owner

Case IPR2021-00052
Patent 9,877,562 B2

DECLARATION OF SCOTT O. GANAJA, P.E. IN SUPPORT OF
PATENT OWNER'S PRELIMINARY RESPONSE

Guy A. Shaked Inv. Ltd.
Exhibit 2002
Ontel Prod. Corp. v. Guy A. Shaked Inv. Ltd.
IPR2021-00052
Ex. 2002-001



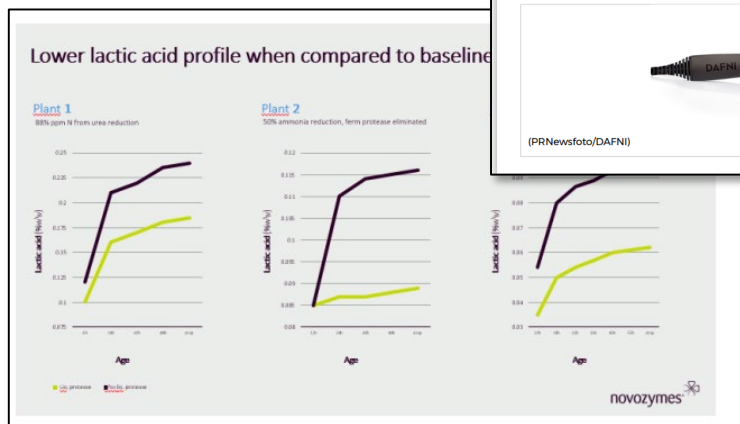
DAFNI®, The Original Ceramic Hair Straightening Brush, Wins Prestigious Good Housekeeping Beauty Lab Award

NEWS PROVIDED BY
DAFNI →
Jul 25, 2017, 07:37 ET

PARSIPPANY, N.J., July 25, 2017 /PRNewswire/ -- DAFNI®, the original patented heated ceramic hair straightening brush, is thrilled to announce its prestigious *Good Housekeeping Beauty Lab Award* as the best "Hot Stylin' Tool."



(PRNewfoto/DAFNI)



uspto

Arguments

IPR2021-00052 (USP 9,877,562)

Patent Owner's Response

V. Ground 3: Claims 1-10 Are Patentable Over Choi, Ida, and Gress

Ontel did not (and cannot) demonstrate that a POSA could have or would have modified Choi such that its alleged elongate heating elements are monolithic with its alleged heating plate, as recited in claim 1. The Board preliminarily agrees that Ontel did not meet its burden with respect to this claim element. Inst. Dec. 30-34.

Relying on a **dissent** in an inapposite Federal Circuit case, Ontel proffers the conclusory argument that it would have been an obvious “design choice” to modify Choi so that its heat transfer units (the alleged heating element) and its iron roll (the alleged heating plate) are fashioned from a single piece of metal. Pet. 43-45. Failing that, Ontel turns to Gress’s monolithic embodiment again. *Id.* 45.

Ontel is wrong on both points. Gress explains that its preferred and non-monolithic embodiment is particularly simple to make and assemble. Gress is correct, and the same is true for Choi. Fashioning such a complicated component from a single piece of metal is difficult and expensive, if not impossible. Ganaja Decl. ¶¶ 90-94. Further, trying to do so with Choi would result in a device that is challenging (i.e., expensive) or impossible to assemble. In particular, Choi’s heat insulating units (the accused spacers) must be inserted into its heat transfer unit (the alleged heating elements) before Choi is assembled—an impossibility if Choi’s iron roll and heat transfer units are fabricated from a single piece of metal.

Question/comment submission

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Future programs



Invention-Con – August 10-12

Register: <https://www.uspto.gov/about-us/events/invention-con-2022-inspiring-and-redefining-innovative-mindset>

PTAB's presentation is scheduled for **August 12, at 1 pm ET**

Inventor Hour, Episode 11

Thursday, September 22, at noon ET



Question/comment submission

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