

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



USPTO administrative tribunal: Patent Trial and Appeal Board

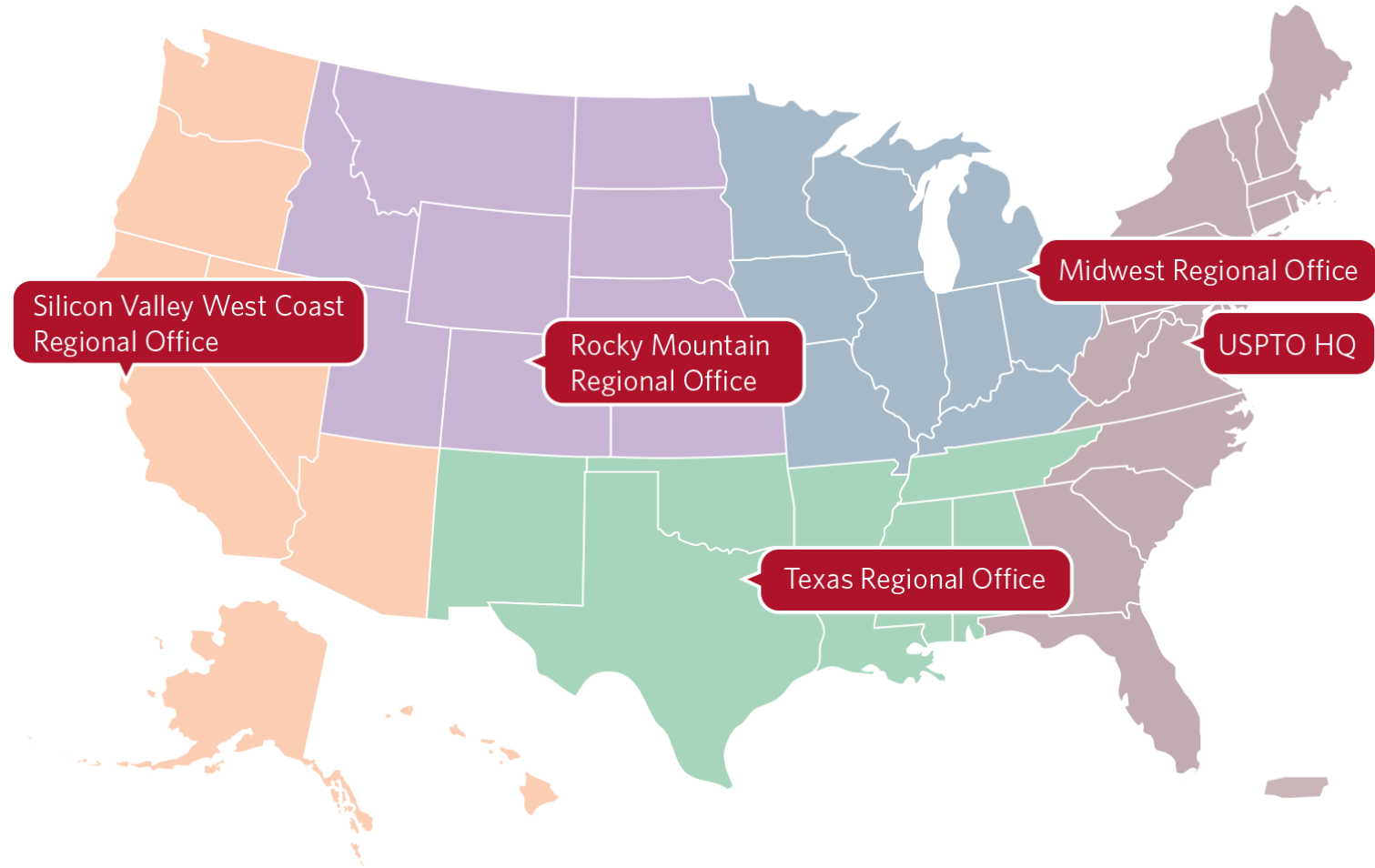
Georgianna Witt Braden, Lead Administrative Patent Judge

August 26, 2021

UNITED STATES
PATENT AND TRADEMARK OFFICE

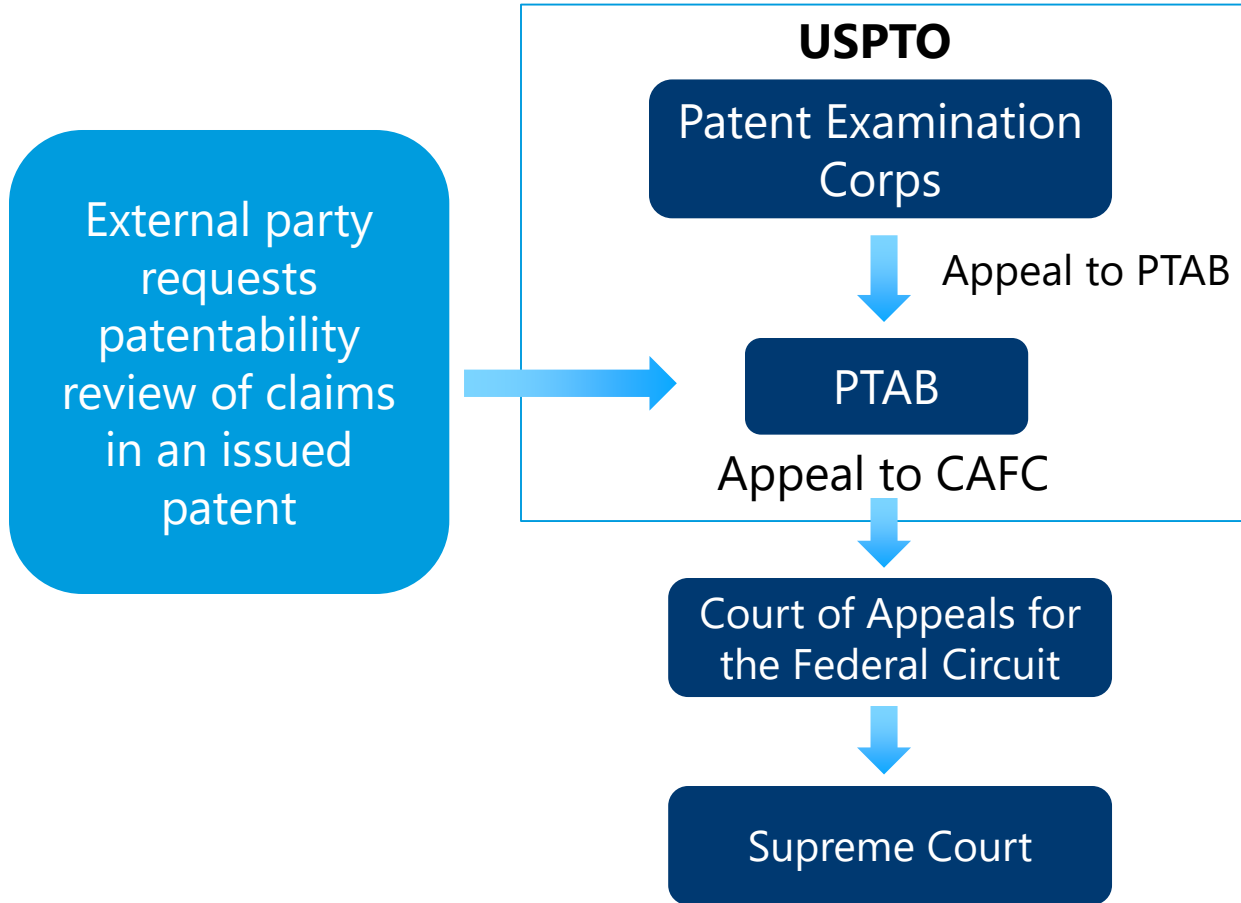


USPTO offices



Patent Trial and Appeal Board

The general process



The Board

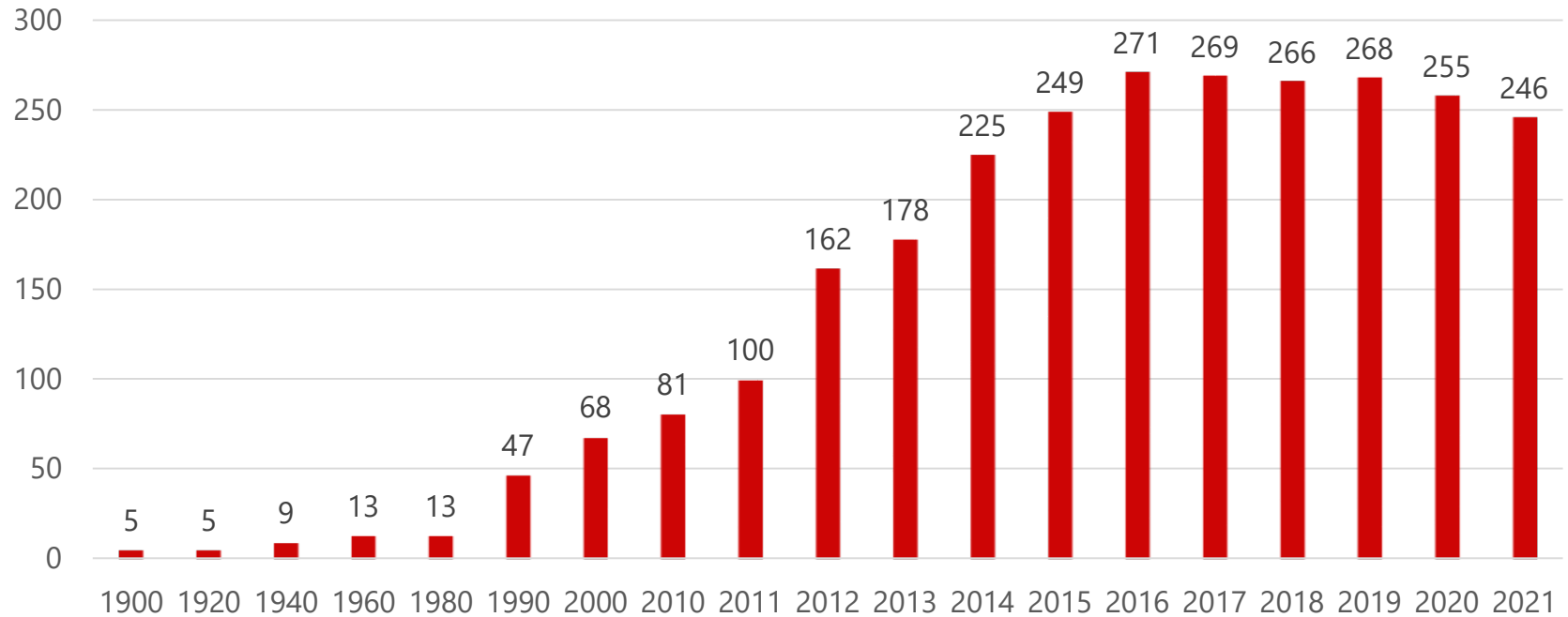
- The Board is created by statute (35 U.S.C. § 6)
 - That statute mandates the Board's:
 - Duties
 - Composition
 - Qualifications for membership
 - Panel form of decision-making (appeals, derivation proceedings, post-grant reviews, and inter partes reviews)
- Original “board of disinterested persons” provided for in Patent Act of 1836
- Patent Act of 1861 formed the permanent Board of Appeals of “persons of competent legal knowledge and scientific ability”
 - President Lincoln appointed George Harding, Esq. of Philadelphia as the first “Examiner-in-Chief”

The administrative patent judges

- Chief judge (1)
- Deputy chief judge (1)
- Vice chief judges (4)
- Senior lead judges (2)
- Lead judges (23)
- Judges (215)
 - Patent attorneys, law clerks, paralegals, administrators, and support staff assist the judges with their work at the board

Board size over time

(Calendar year)



Types of PTAB proceedings

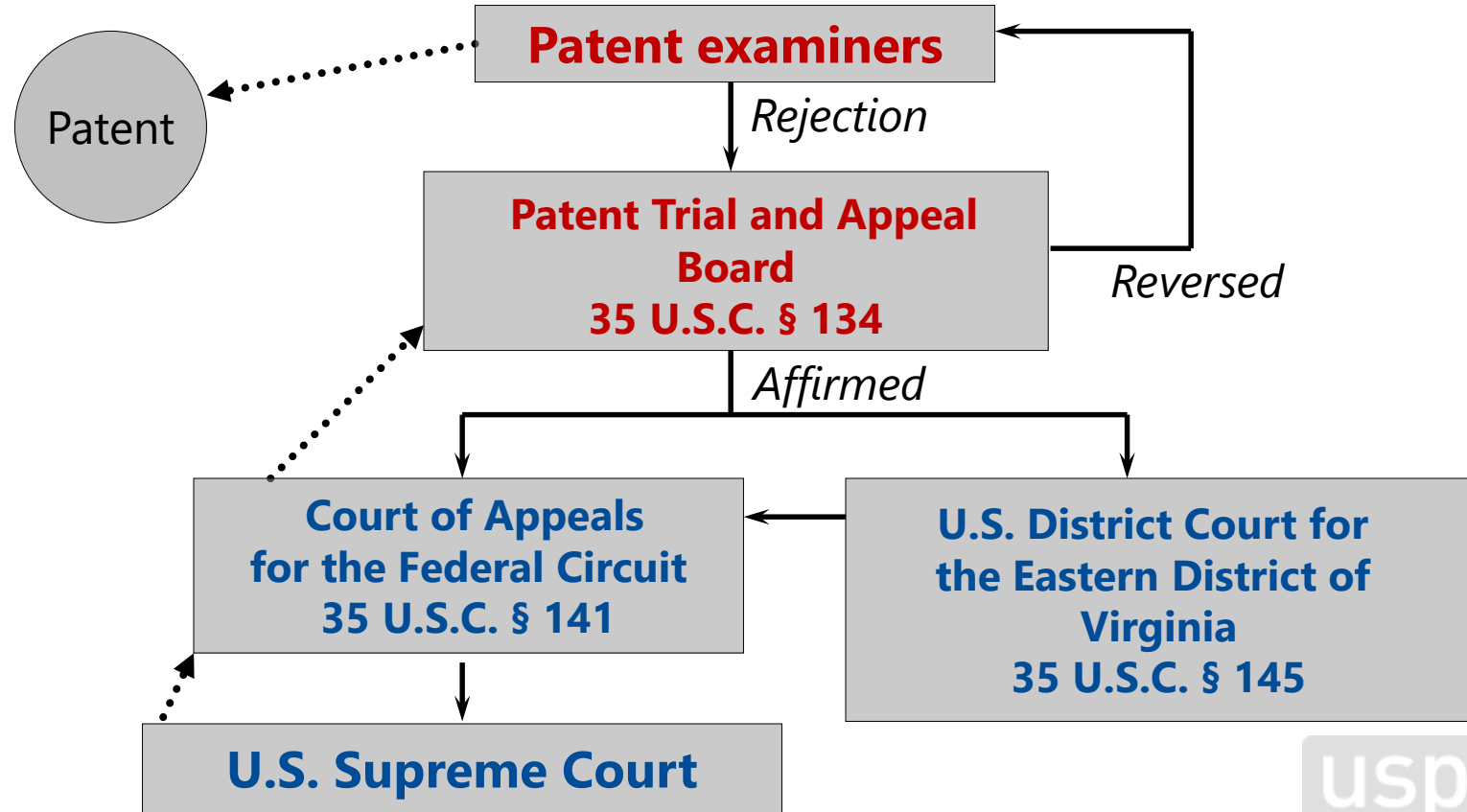
- Appeals in ex parte patent applications
- Appeals in ex parte and inter partes reexamination proceedings
- Interferences
- Inter partes reviews (IPR)
- Covered business method reviews (CBM)
- Derivations (DER)
- Post-grant reviews (PGR)

Case processing at PTAB

- Docket case
 - Transfers jurisdiction from examiner if a case is appealed
- Assign a panel (usually 3 judges)
 - Chief judge and SOP1
- Conference between judges
- Oral hearing (if requested)
- Post-hearing conference between judges
- Circulate opinion
- Issue decision
- Rehearing request
- Appeal

***Ex parte* appeals**

The *ex parte* appeal process

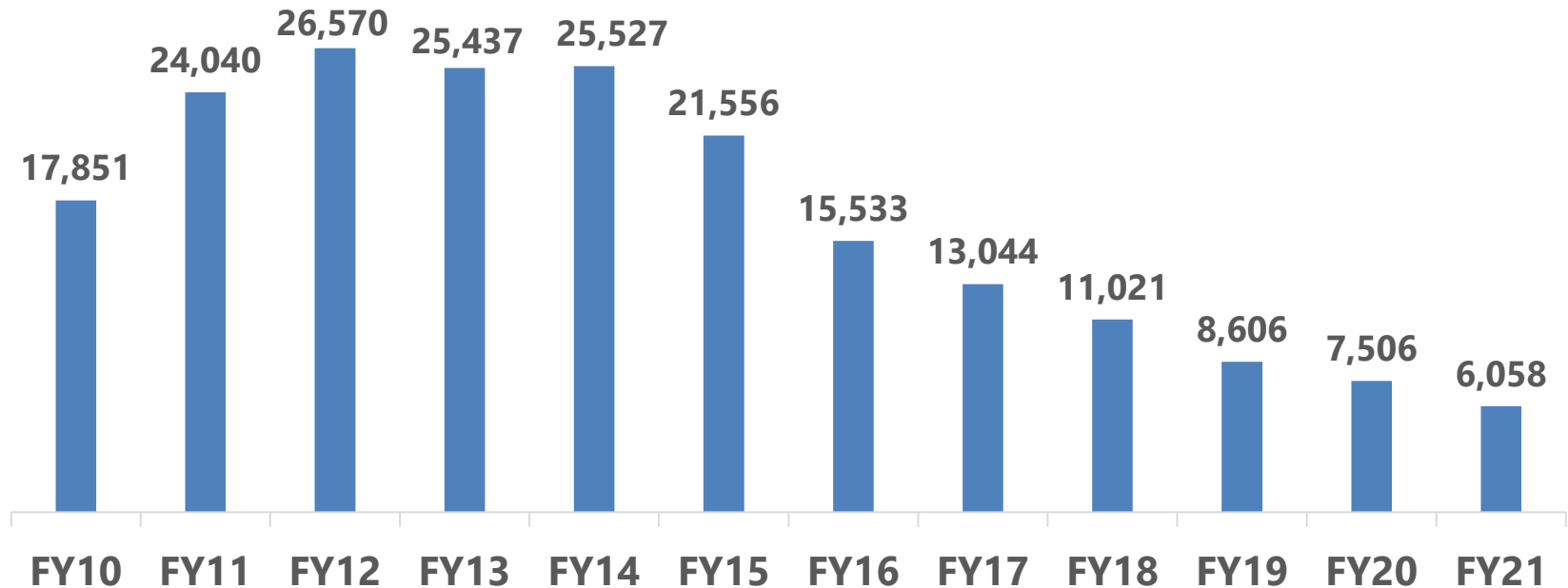


Decisions and dispositions in ex parte cases

- Affirm the rejection
- Affirm-in-part
- Reverse the rejection
- Vacate the rejection (rare)
- Remand the application (rare)
- Dismiss the appeal (rare)
- New ground of rejection (37 C.F.R. § 41.50(b)) (rare)

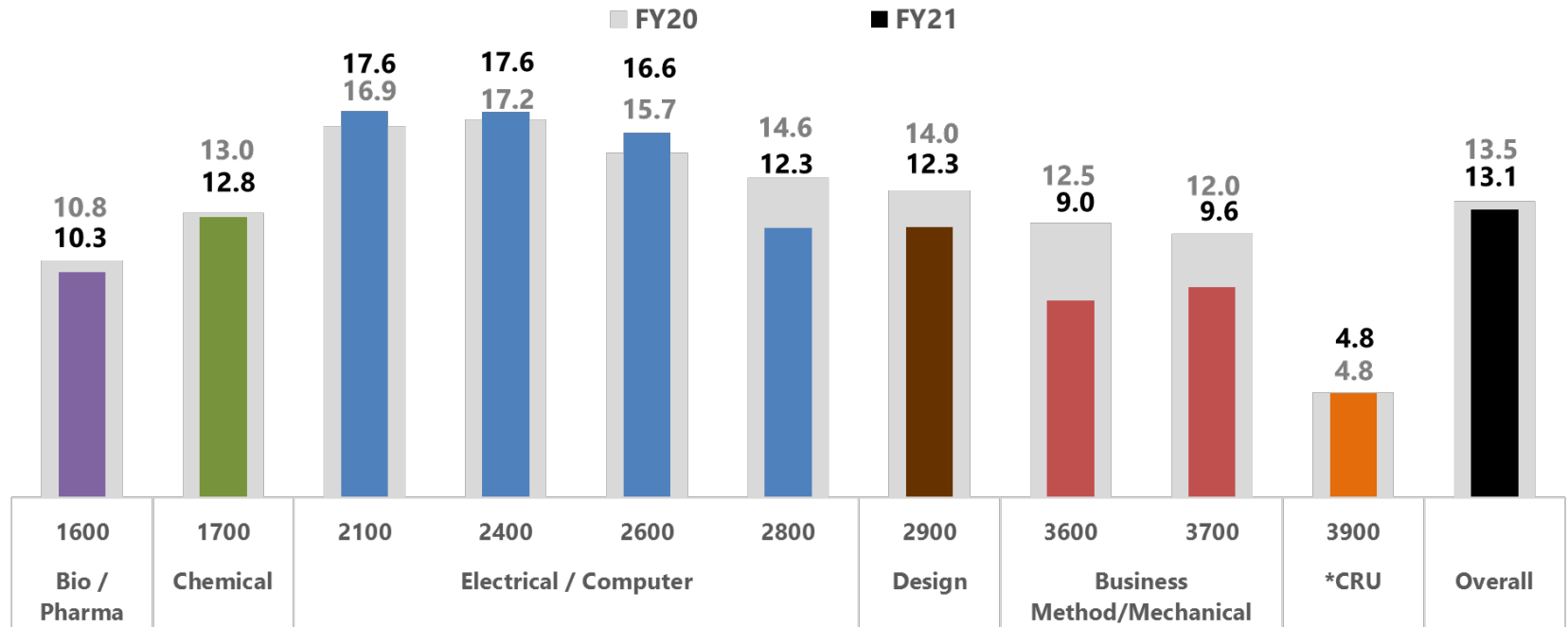
Pending appeals FY10 to FY21

(Sept. 30, 2010 – July 31, 2021)



Pendency of decided appeals

(May 2020 – July 2020 compared to May 2021 – July 2021)



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

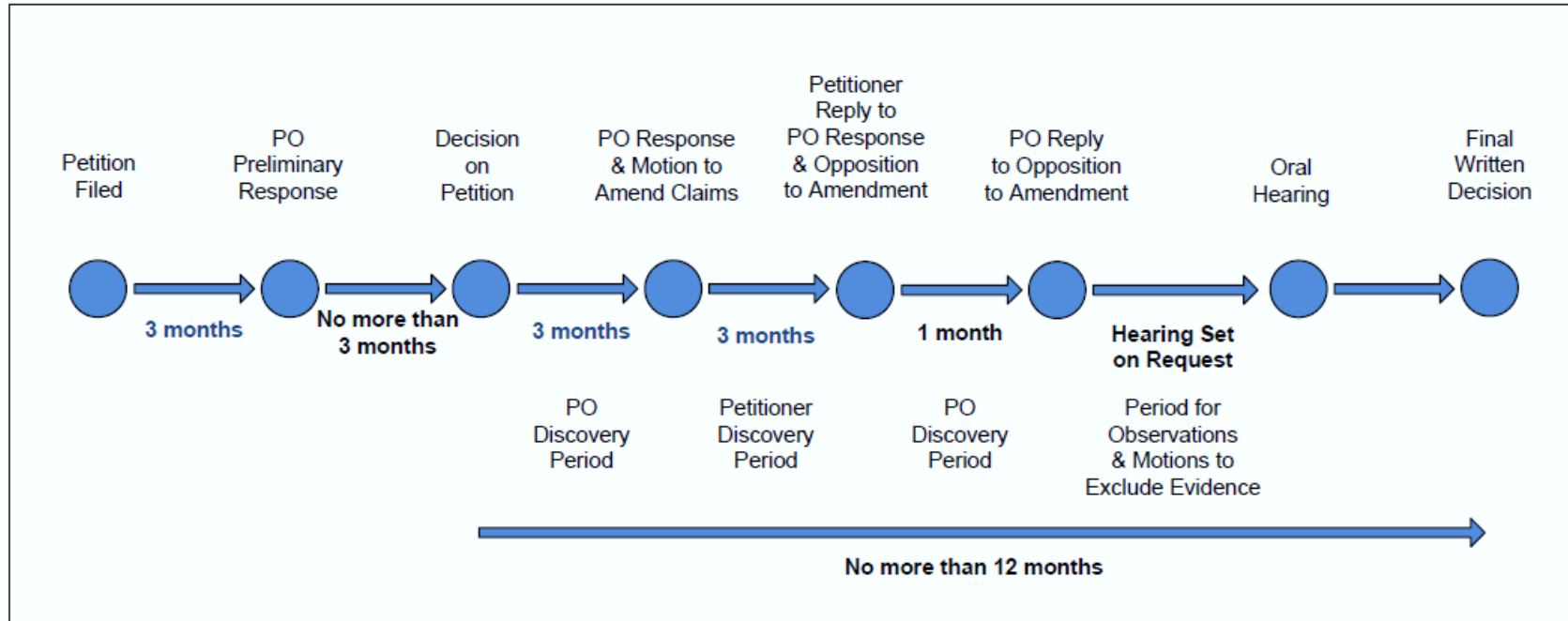
Pendency is calculated for a three month period compared to the same period the previous year.

*CRU (Central Reexamination Unit) decisions include 4 *ex parte* reexams, 6 *inter partes* reexam, 0 supplemental examination reviews, and 5 reissues from all technologies for May 2021 – July 2021.



AIA trial proceedings

Standard timeline for AIA trials



Scope of grounds in petition

- IPR
 - Only on § 102 and § 103 grounds, and only on basis of prior art consisting of patents and printed publications
- PGR
 - On any grounds for invalidity (except best mode)

Scope of review

- CBM*
 - Same as PGR, but must be a “covered business method” patent
 - Claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service
 - Does not include “technological inventions”

* The Office will not consider a CBM petition filed on or after September 16, 2020.



Standard for initiating review

- IPR
 - “A reasonable likelihood that the petitioner would prevail” with respect to at least one challenged claim
- CBM/PGR
 - “More likely than not that at least one claim is unpatentable” or the petition raises “a novel or unsettled legal question that is important to other patents or applications”

AIA trial proceedings

- Standard of proof: a “preponderance of evidence”
 - Lower than “clear and convincing evidence” required to prevail in district courts
- Final written decision
 - Issued within 12 months of institution
 - Can extend by 6 months, but only for “good cause”
 - Generally, entire process (petition to termination or final decision) will take 18 months or less

Potential outcomes in AIA proceedings

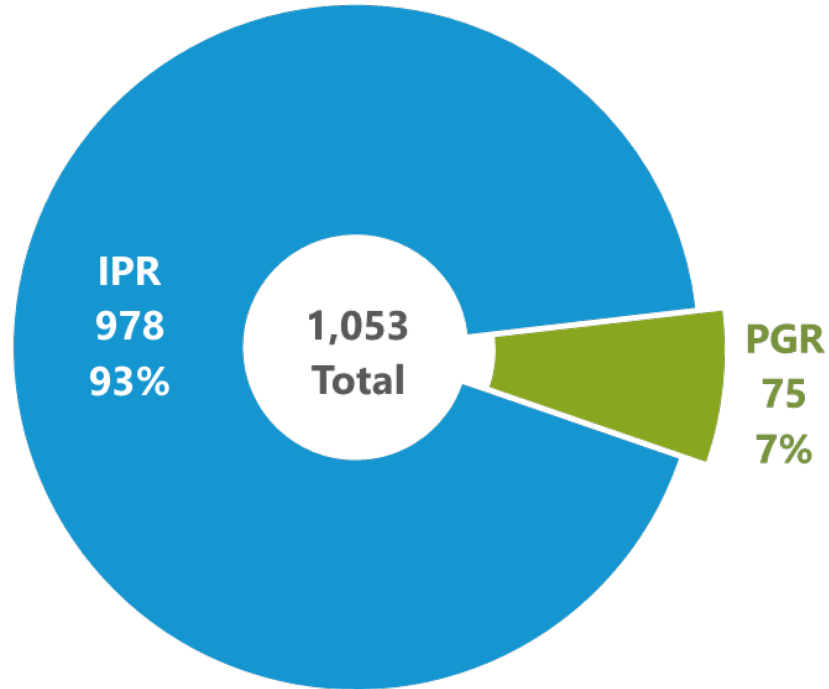
- Deny institution
- Settle
- Dismiss
- Request for Adverse Judgment
- Final Written Decision

Dispositions in final written decisions

- Find all challenged claims unpatentable
- Mixed outcome
 - Find some challenged claims unpatentable
 - Find some challenged claims patentable (i.e., petitioner did not meet burden to show unpatentable)
- Find all challenged claims patentable

Petitions filed by trial type

(FY21 through Q3: Oct. 1, 2020 to June 30, 2021)

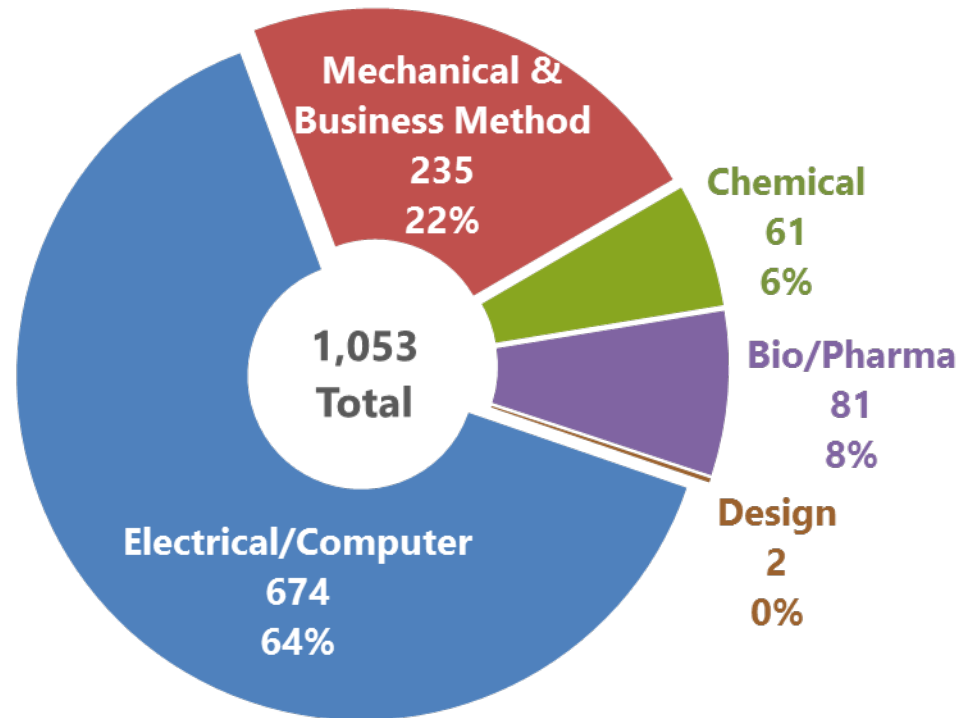


Trial types include Inter Partes Review (IPR), Post Grant Review (PGR), and Covered Business Method (CBM). The Office will not consider a CBM petition filed on or after September 16, 2020.



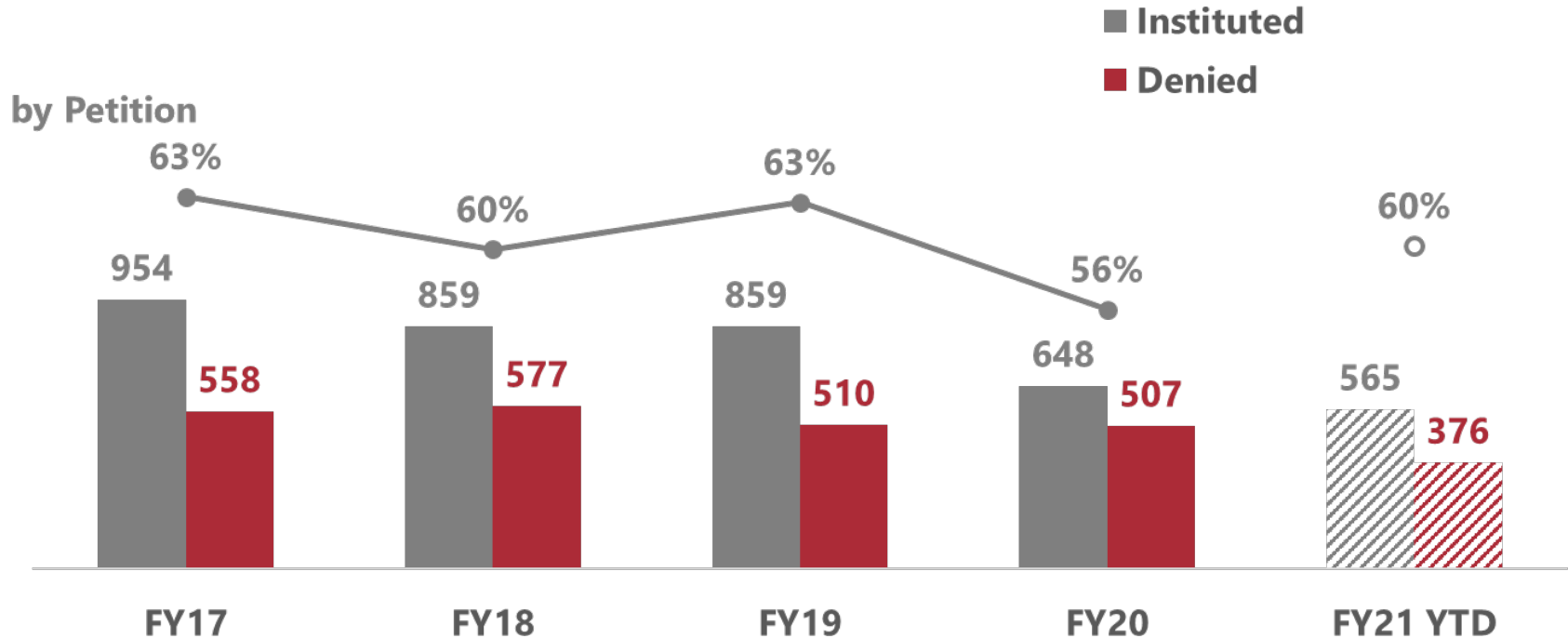
Petitions filed by technology in FY21

(FY21 through Q3: Oct. 1, 2020 to June 30, 2021)



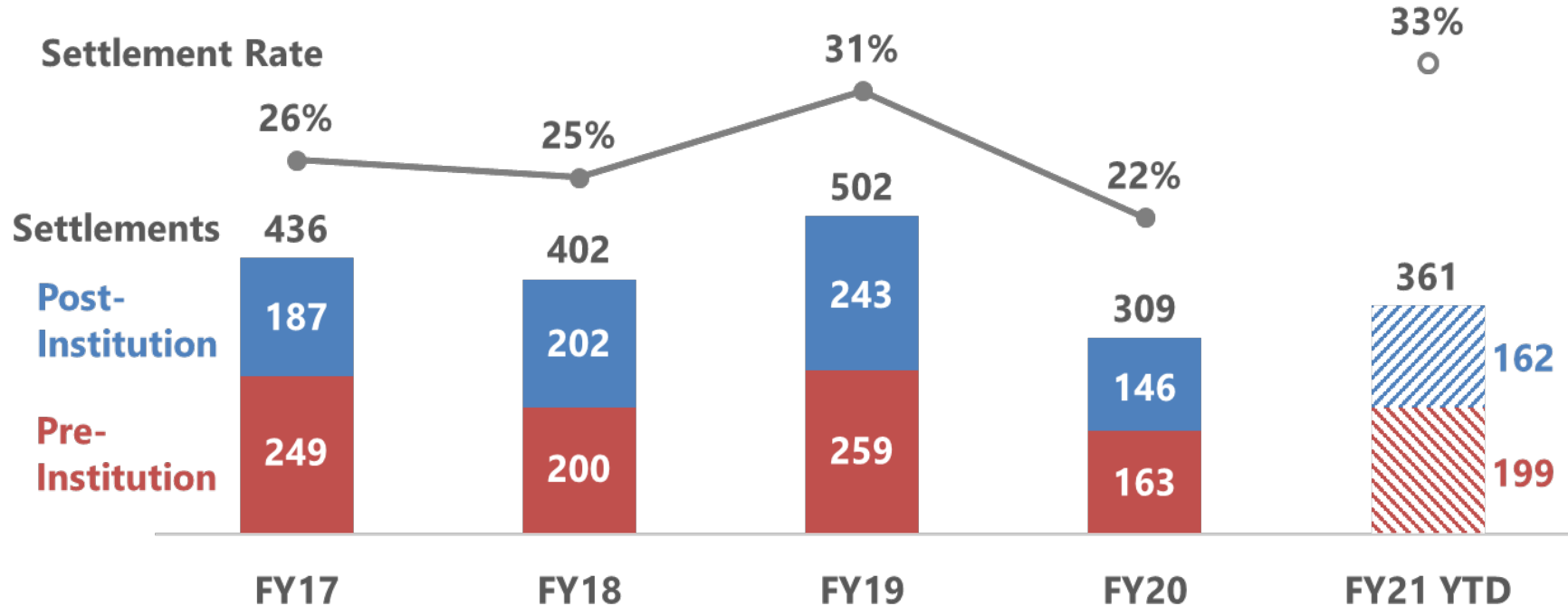
Institution rates by petition

(FY17 to FY21 through Q3: Oct. 1, 2016 to June 30, 2021)



Settlements

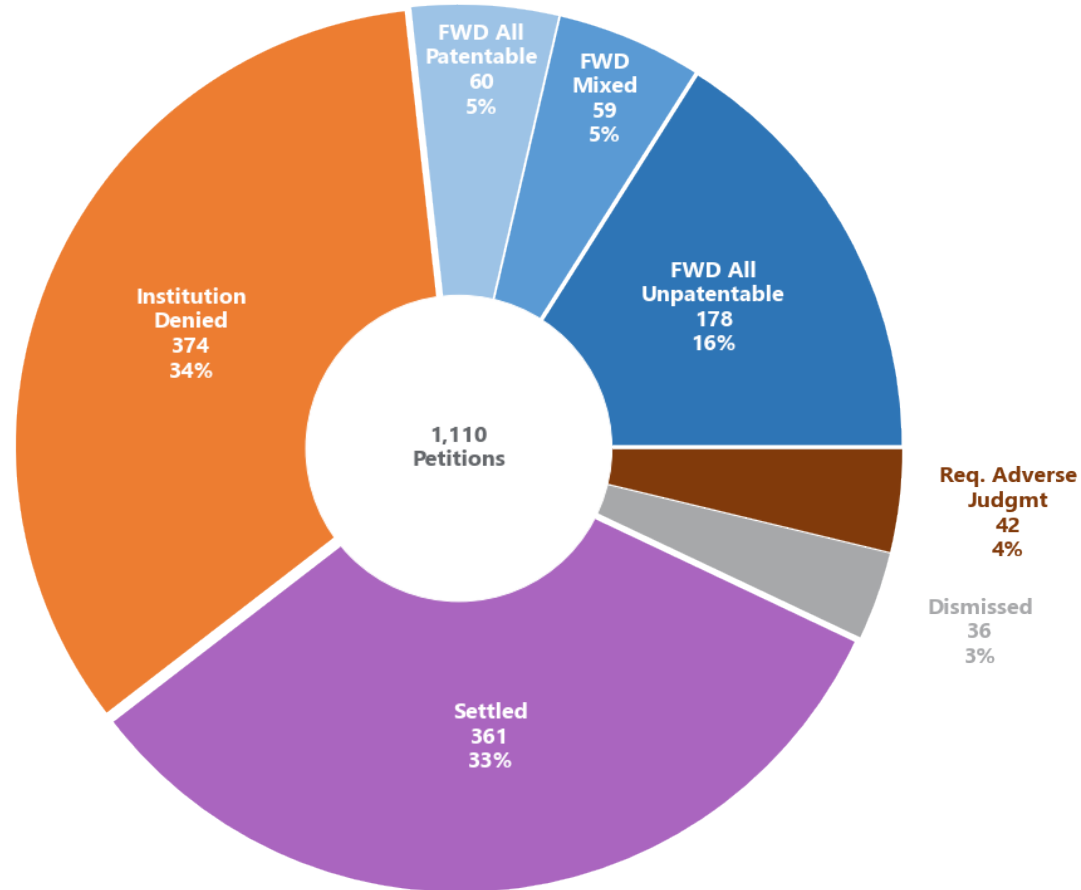
(FY17 to FY21 through Q3: Oct. 1, 2016 to June 30, 2021)



Settlement rate is calculated by dividing total settlements by concluded proceedings in each fiscal year (i.e., denied institution, settled, dismissed, requested adverse judgment, and final written decision), excluding joined cases.

Outcomes by petition

(FY21 through Q3: Oct. 1, 2020 to June 30, 2021)



PTAB resources

New to PTAB

<https://www.uspto.gov/patents/patent-trial-and-appeal-board/about-ptab/new-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?

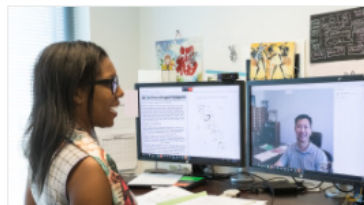
Contact PTAB or peruse helpful FAQs.

- > [Get help](#)



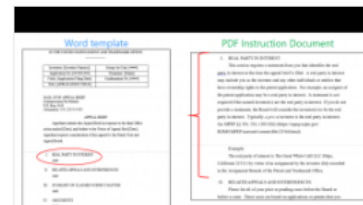
PTAB BOARDSIDE CHAT WEBINARS

The PTAB Boardside Chat series highlights best practices and answers questions raised by attendees



TEMPORARY CHANGE

PTAB conducts remote hearings



EX PARTE APPEAL BRIEF TEMPLATE

Provides help in drafting an ex parte appeal brief for independent inventors and others



PTAB resources

- Information concerning the board:
 - <https://www.uspto.gov/patents/ptab>
- Information concerning appeals:
 - <https://www.uspto.gov/patents/ptab/appeals>
- Information concerning AIA trials:
 - <https://www.uspto.gov/patents/ptab/trials>
- Information concerning PTAB statistics:
 - <https://www.uspto.gov/patents/ptab/statistics>
- Information concerning board decisions:
 - <https://www.uspto.gov/patents/ptab/decisions>





Thank you!

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www.uspto.gov