

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# Patent Trial and Appeal Board Inventor Hour: Episode 23

**Ulrike Jenks**, Administrative Patent Judge

**Eric Jeschke**, Administrative Patent Judge

**John Schneider**, Administrative Patent Judge

Special guests:

**Chanceity Robinson**, Primary Patent Examiner, Technology Center 1700

**Joel Attey**, Primary Patent Examiner, Technology Center 3700

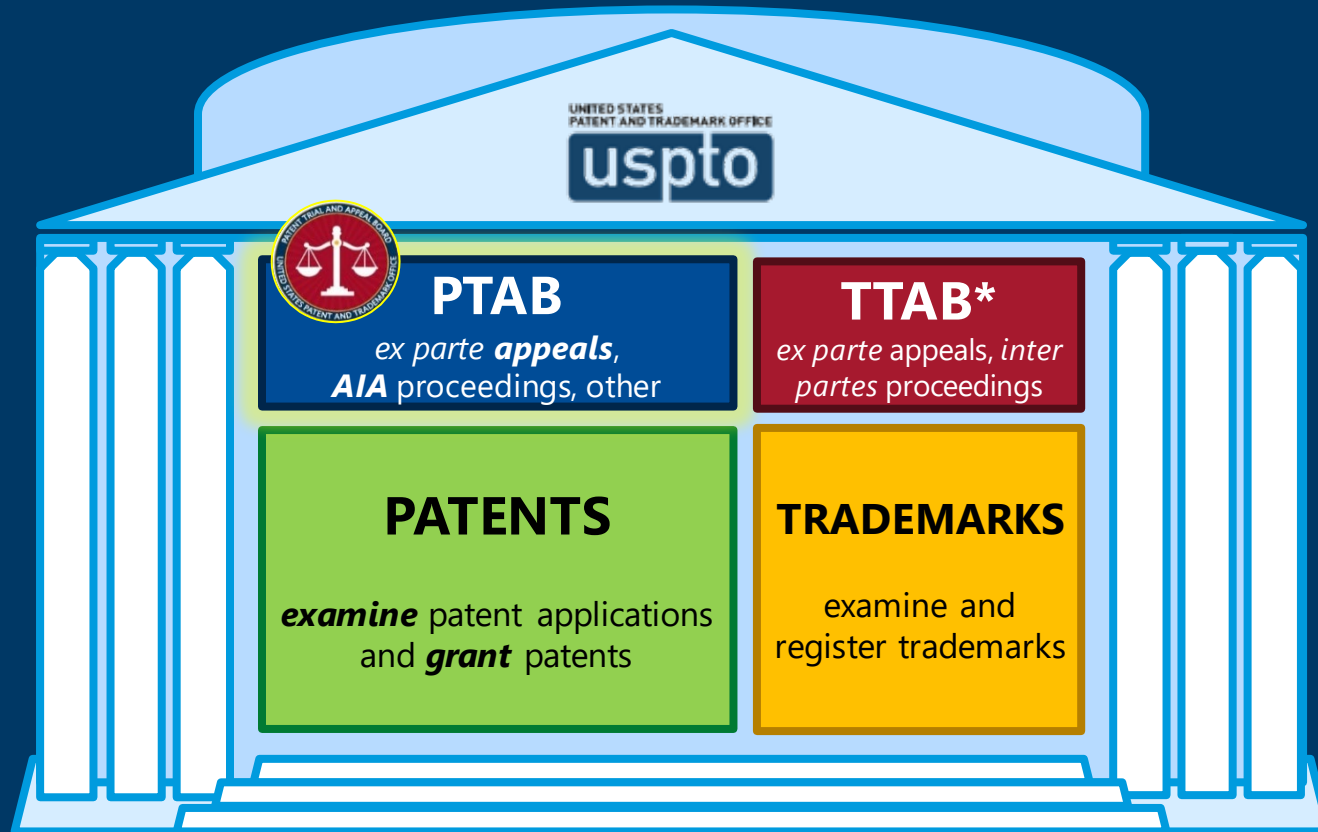
**Joshua Benitez**, Council for Inclusive Innovation (CI<sup>2</sup>)

October 26, 2023



UNITED STATES  
PATENT AND TRADEMARK OFFICE ®

# What is the Patent Trial and Appeal Board?



\*Trademark Trial and Appeal Board (TTAB)

# Today's agenda

1

**A day  
in the life:  
patent  
examiners**

2

**First-Time Filer  
Pilot Program**

3

**Trial byte:  
Motions in  
AIA trials**

4

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



Ulrike Jenks, Administrative Patent Judge



## **Meet USPTO professionals**

**Chanceity Robinson, Technology Center 1700**

**Joel Attey, Technology Center 3700**

Chanceity Robinson



Primary Patent Examiner  
Technology Center 1700

Joel Attey



Primary Patent Examiner  
Technology Center 3700

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# 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>



Joshua Benítez, Council for Inclusive Innovation (CI<sup>2</sup>)



**Pilot program:**  
**First-Time Filer Expedited Examination**



Joshua Benítez



Executive Secretary &  
Program Coordinator



# Council for Inclusive Innovation (CI<sup>2</sup>)

**Expand innovation** in the United States:

- Tapping into the strength of our nation's **diversity**
- Increasing opportunities for **all Americans** to participate in innovation



For more information visit: <https://www.uspto.gov/ExpandingInnovation>



# First-Time Filer Expedited Examination pilot program



- **Increase accessibility** to the patent system for inventors who are
  - **new** to the patent application process
  - including those in **historically underserved** geographic and economic areas.
- **Expedites** the first office action for participants
- Up to **1,000** qualifying applications until **March 11, 2024**
  - Subject to USPTO discretion to end the pilot program sooner



# What can this pilot program do for you?

- **Reduce time** to receive first office action on the merits
- Give an **early indication** of whether the invention is patentable
- Potentially get a patent and onto the market **faster**



# You may be eligible if you have:

- Filed a **utility nonprovisional** patent application meeting certain guidelines
- **Not** been **named** as an inventor on any other nonprovisional application
- Filed your application electronically using **Patent Center** (in DOCX format)

Cont'd on next page



# You may be eligible if you have (cont'd):

- **Completed** your application when filing for program
- Qualified for special status based on **income** (<https://www.uspto.gov/PatentMicroentity>), and
- Received **reasonable training** in the basics of patent application process
  - USPTO training resources for meeting requirement at <https://www.uspto.gov/FirstTimePatentFiler>.
  - Additional USPTO support/resources for inventors & entrepreneurs at <https://www.uspto.gov/CES>.





# Information and questions



- For **more information**:
  - <https://www.uspto.gov/FirstTimePatentFiler>.
- Frequently asked **questions**:
  - <https://www.uspto.gov/initiatives/first-time-filer-pilot-program/first-time-filer-expedited-examination-pilot-program>.
- **Contact us**:
  - Office of Patent Legal Administration
  - 571-272-7704
  - [CI2FirstTimeFilerPilot@uspto.gov](mailto:CI2FirstTimeFilerPilot@uspto.gov).



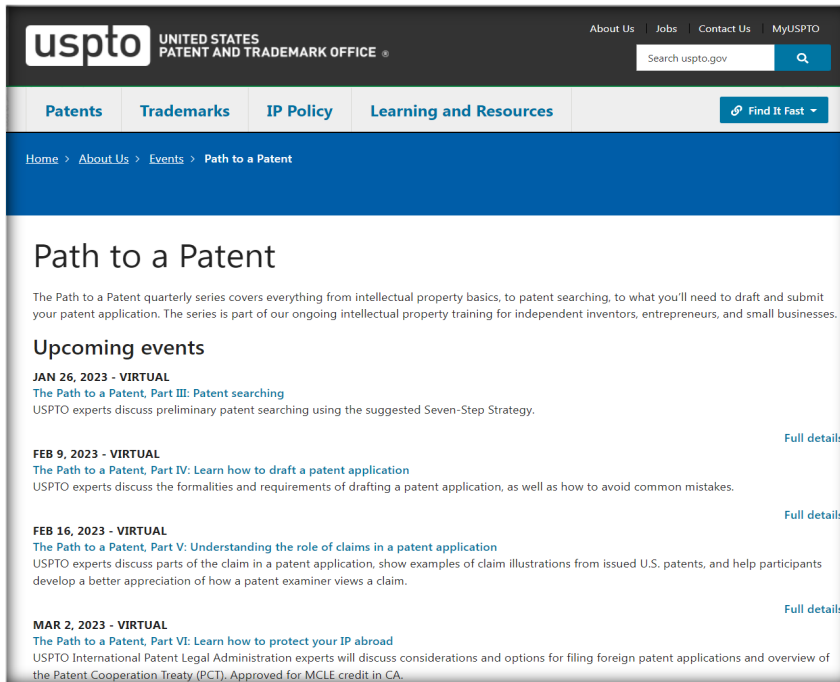
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# USPTO “Path to a Patent” series



The screenshot shows the USPTO website's navigation and content for the 'Path to a Patent' series. The top navigation bar includes the USPTO logo, the text 'UNITED STATES PATENT AND TRADEMARK OFFICE', and links for 'About Us', 'Jobs', 'Contact Us', and 'MyUSPTO'. A search bar is also present. Below the navigation bar, there are tabs for 'Patents', 'Trademarks', 'IP Policy', and 'Learning and Resources', with a 'Find It Fast' button. The breadcrumb trail reads 'Home > About Us > Events > Path to a Patent'. The main heading is 'Path to a Patent', followed by a descriptive paragraph: 'The Path to a Patent quarterly series covers everything from intellectual property basics, to patent searching, to what you'll need to draft and submit your patent application. The series is part of our ongoing intellectual property training for independent inventors, entrepreneurs, and small businesses.' Below this is a section for 'Upcoming events' with four entries, each including a date, event type, title, description, and a 'Full details' link.

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Home > About Us > Events > Path to a Patent

## Path to a Patent

The Path to a Patent quarterly series covers everything from intellectual property basics, to patent searching, to what you'll need to draft and submit your patent application. The series is part of our ongoing intellectual property training for independent inventors, entrepreneurs, and small businesses.

### Upcoming events

**JAN 26, 2023 - VIRTUAL**  
[The Path to a Patent, Part III: Patent searching](#)  
USPTO experts discuss preliminary patent searching using the suggested Seven-Step Strategy. [Full details](#)

**FEB 9, 2023 - VIRTUAL**  
[The Path to a Patent, Part IV: Learn how to draft a patent application](#)  
USPTO experts discuss the formalities and requirements of drafting a patent application, as well as how to avoid common mistakes. [Full details](#)

**FEB 16, 2023 - VIRTUAL**  
[The Path to a Patent, Part V: Understanding the role of claims in a patent application](#)  
USPTO experts discuss parts of the claim in a patent application, show examples of claim illustrations from issued U.S. patents, and help participants develop a better appreciation of how a patent examiner views a claim. [Full details](#)

**MAR 2, 2023 - VIRTUAL**  
[The Path to a Patent, Part VI: Learn how to protect your IP abroad](#)  
USPTO International Patent Legal Administration experts will discuss considerations and options for filing foreign patent applications and overview of the Patent Cooperation Treaty (PCT). Approved for MCLE credit in CA. [Full details](#)

This series covers everything from intellectual property **basics**, to patent **searching**, to what you'll need to **draft** and **submit** your patent application.

More information:

<https://uspto.gov/about-us/events/path-patent>



Eric Jeschke, Administrative Patent Judge



# **Trial byte:**

## **Motions in AIA Trials**

# Agenda



**Definition**



**General guidance**



**Common types**

# mo·tion ('mō-shən)

an **application**

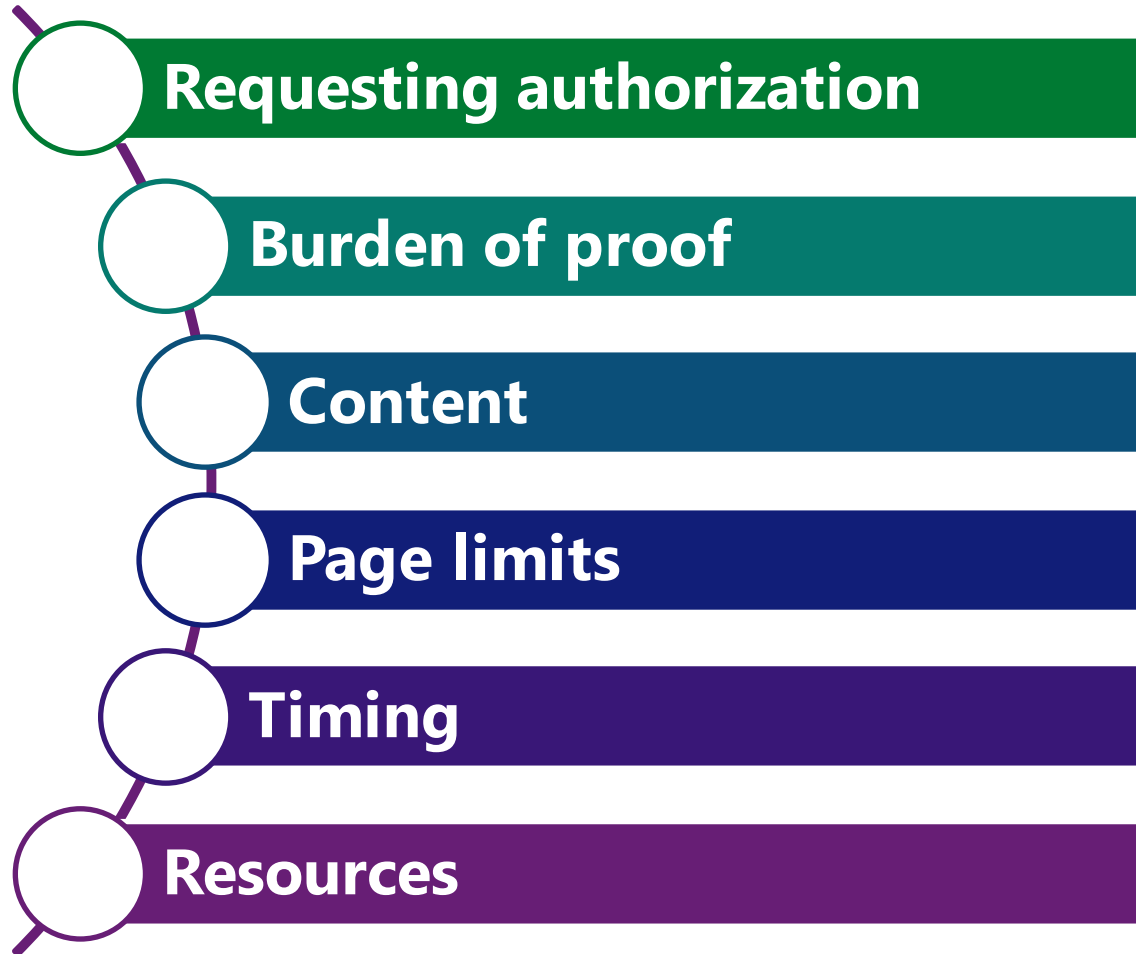
made to a court or **judge**

to obtain an **order, ruling**, or direction

<https://www.merriam-webster.com/dictionary/motion>



# General guidance



# Requesting authorization (if required)

## Email requirement for conference call

- \* Copy all parties
- \* Generally indicate relief requested
- \* No arguments / attachments
- \* Times when all parties available
- \* Address meet & confer request & state any opposition

Conference call  
with panel

File motion  
(if authorized)



# Burden of proof



Burden of proof to establish entitlement to requested relief is on **moving party**: 37 C.F.R. § 42.20(c)

# Content

## Motion

- \* Relief requested
- \* Reason for request
- \* Significance of evidence, material facts, law
- \* Required showing for particular type of motion

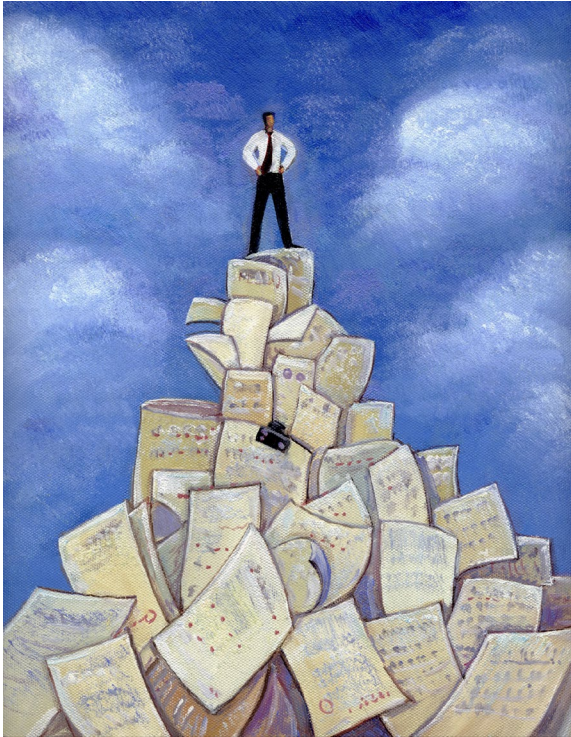
## Opposition

- \* Requirements for motions
- \* Disputed material facts

## Reply

- \* Directed only to corresponding opposition

# Page limits



Motions - **15 pages** unless advance waiver

Oppositions - same as corresponding motion

Replies - **5 pages**

Board may set other page constraints

Page limits:

- **Include** any statement of material facts to be admitted or denied
- **Exclude** table of contents, certificate of service, appendix of exhibits

# Timing



## Set in scheduling order

Patent owner motion to amend (and opposition/reply)

Revised motion to amend (if filed)

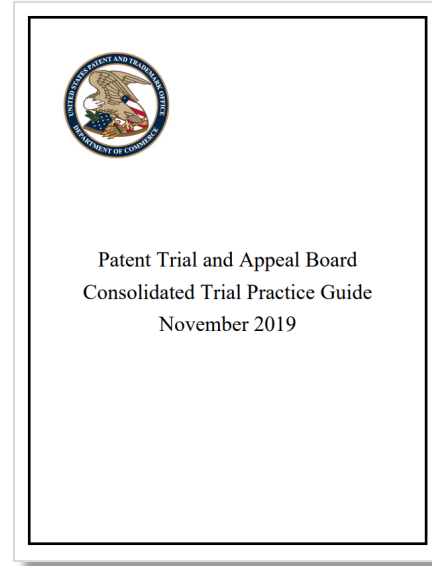
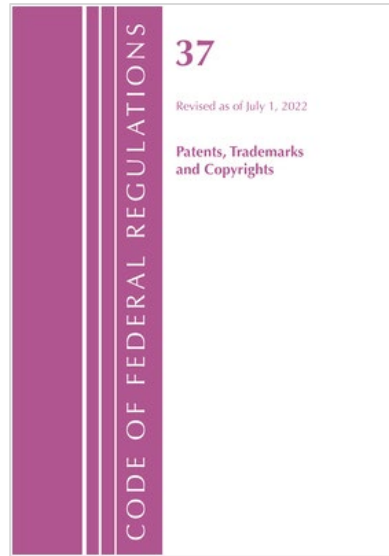
Motion(s) to exclude evidence (and opposition/reply)

## Opposition default – 1 month

Typically set much shorter

Board can deny relief not promptly sought: § 42.25(b)

# Resources

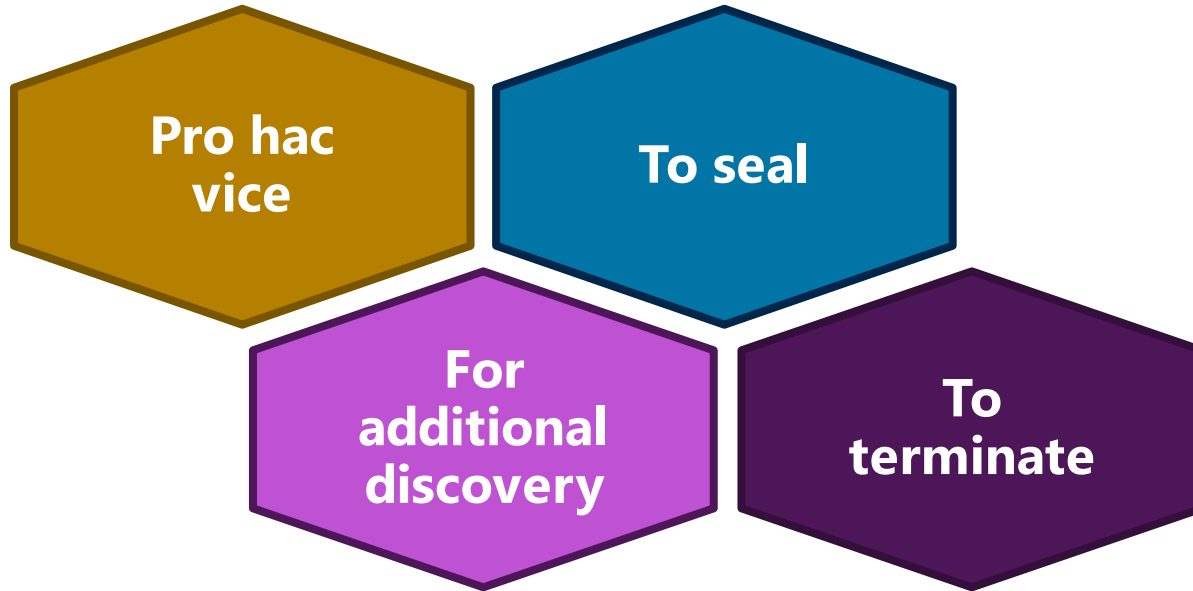


**Rules 37 C.F.R. § 42.20–25** (<https://www.govinfo.gov/content/pkg/CFR-2022-title37-vol1/pdf/CFR-2022-title37-vol1.pdf>)

**Trial Practice Guide** ([www.uspto.gov/TrialPracticeGuideConsolidated](http://www.uspto.gov/TrialPracticeGuideConsolidated))



# Common motions in AIA proceedings



# Pro hac vice motion

## 37 C.F.R. § 42.10

### Why

- Allow **non-PTO-registered** attorney to appear for specific proceeding

### How authorized

- In notice of filing date

### When

- No sooner than **21 days** after service of petition
- Opposition w/in **1 week**
- **No reply** unless Board authorizes

# Pro hac vice motion

37 C.F.R. § 42.10

## What

- Must show:
  - Legal & technical **qualifications**
  - Established **familiarity** with subject matter
  - **Party intent** to be represented
- **Affidavit** of counsel seeking admission

## Misc.

- Eligible only as **backup** counsel
- **May not withdraw** without Board authorization



# Motion to seal

37 C.F.R. §§ 42.14, 42.54

## Why

- To keep **confidential** your (or a third party's) information

## How authorized

- Authorization to file **not required**

## When

- **Concurrent** with filing of document or thing to be sealed

# Motion to seal

37 C.F.R. §§ 42.14, 42.54

## What

- Explanation **why** info is **confidential**
- Proposed **protective order** (if one not yet entered)
  - Entry of PO (even Board's default PO) not automatic -- must request
  - Show difference from default order
- Certification of **good faith attempt to confer** with opposing party

## Misc.

- Standard = **good cause**
- Public policy to make information available
- Consider **redaction**
- Move to **expunge** confidential info after final judgement if appropriate (37 C.F.R. § 42.56)

# Motion for additional discovery

## 37 C.F.R. § 42.51

### Why

- Obtain more information in opposing party's possession to support your case

### How authorized

- By request to panel

### When

- Should be timely made after need for additional discovery arises
- AIA trials do not have a formal "discovery deadline" like many district courts, but do have statutory deadlines

# Motion for additional discovery

## 37 C.F.R. § 42.51

### What

- IPR = Interest of Justice
  - *Garmin* factors
    - More than possibility/**mere allegation**?
    - About other party's **litigation positions**/underlying basis?
    - Other means to get **equivalent info**?
    - Instructions for response **easily understandable**?
    - Overly **burdensome**?
- PGR = good cause

### Misc.

- Very fact specific issues
- Parties may agree to additional discovery between themselves

# Motion to terminate

37 C.F.R. §§ 42.72, 42.73

## Why

- To seek termination
  - Of a **party**
  - Of the **proceeding**

## How authorized

- By request to panel

## When

- Examples:
  - Judgment against self (any time during proceeding)
  - After parties settle
  - Where an earlier final written decision creates estoppel that prevents petitioner, real party in interest or privy of the petitioner, from maintaining a proceeding

# Motion to terminate

## 37 C.F.R. §§ 42.72, 42.73

### What

- A party may request adverse judgment against itself. Actions interpreted as adverse judgment can include:
  - Disclaimer of patent, claim cancellation, concession of unpatentability, abandonment of contest
- Settlement:
  - Can settle any issue via joint request
  - All agreement/understandings in writing & filed with Board
    - May treat as business confidential – request to keep separate
    - Board not a party

### Misc.

- Board **may proceed to FWD** (even if no petitioner remains)
- Estoppel
  - Ground **raised** or **reasonably could have** been raised

# Common motions: Summary

Motion	Authorization Required	37 CFR §	Consolidated Trial Practice Guide page
<b>Pro Hac Vice</b>	Yes – in notice of filing date	42.10	11
<b>To seal</b>	No	42.14; 42.54-55	19
<b>For additional Discovery</b>	Yes	42.51	4, 6-7, 22-34, 92, 100
<b>To terminate</b>	Yes	42.72; 42.73	4, 53, 86

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# PTAB statistics

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More information:

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





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# THANK YOU!

Inventor Hour will return  
**Thursday Jan. 25, 2024, noon (ET)**

See you in the new year!



