

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# Patents and PTAB Collaborations

Stefanos Karmis, Director of the Office of Patent Quality Assurance  
Scott Boalick, Chief Judge, Patent Trial and Appeal Board  
Jackie Bonilla, Deputy Chief Judge, Patent Trial and Appeal Board

February 6, 2020

Patent Public Advisory Committee quarterly meeting

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# Patents & Patent Trial and Appeal Board (PTAB) collaborations

- Patents & PTAB collaborate to help ensure consistency between Patents & PTAB and for continuous quality improvement
- Areas of collaboration include
  - Training
  - Stakeholder engagement
  - Data Studies

# Training collaborations

- Revised subject matter eligibility guidance
  - Patents and PTAB engaged regularly on development and implementation of the revised subject matter eligibility guidance
- Examiner Quality Chat Series
  - Patent Quality and PTAB are partnering on delivering training to examiners via the Patent Examiner Quality Chat Series
  - Trainings are designed to build examiner's skill set and knowledge for more successful outcomes at appeal

# Training collaborations

- Two trainings were delivered in FY2019 and one in FY2020
  - Providing rationale in obviousness rejections
  - Considerations that impact success in appeals (e.g. effectively supporting your position, claim interpretation, etc.)
  - Introduction to PTAB Trials
- Additional planned trainings for FY2020 include
  - AIA trials – Institution standards, 35 U.S.C. 325(d)
  - Precedential Opinion Panel (POP) Process
  - Precedential and informative decisions

# Training collaborations

- Patent Quality Chats and Boardside Chats
  - Patents and PTAB each host a webinar chat series to inform stakeholders of relevant initiatives, best practices, and to gather feedback and address questions on specific topics
  - Patent employees occasionally are featured at Boardside Chats, and vice versa, for broader outreach
  - Presentation material and videos from the chats are made available as a resource for those unable to attend the webinar



# Training collaborations

- Technology Center Training
  - TCs work with PTAB to provide technology relevant training and feedback to examiners based on decisions in appeal
- Hearings
  - Patents and PTAB have partnered to allow employees to attend hearings as a way to provide education on these types of proceedings
  - PTAB invited reps from Patents to attend a Precedential Opinion Panel (POP) oral hearing (*Hulu v. Sound View*)
  - Examiners are now able to virtually attend PTAB oral hearings covering different technology areas



# Training collaborations

- **Career development opportunities**
  - PTAB offers several developmental detail opportunities for patent examiners and patents employees
    - Assist Administrative Patent Judges (APJs) with the performance of their duties
- **Judicial Law Clerk Program**
  - In 2018, PTAB created a law clerk program modeled off the judicial clerk program used in federal courts
  - Law clerks serve a one year term
  - Current law clerk class includes 2 former patent examiners



# Stakeholder collaborations

- Patents has partnered with PTAB on roadshows designed to inform stakeholders of Office updates and initiatives
- Recent roadshows were done in partnership with AIPLA with sessions held in Seattle, Houston, and Boston
- Topics included:
  - USPTO quality initiatives
  - Tips to improve patent quality
  - Revised subject matter eligibility guidance
  - Providing rationale in obviousness rejections
  - Overview and updates on AIA Trials and trial procedure
  - Best practices in trial proceedings



# Data study collaborations

- 35 USC 325(d)
  - OPQA partnered with PTAB on a study related to 35 USC 325(d)
  - OPQA reviewed cases and collected data where the patent owner argued that reference(s) were previously considered by the examiner during prosecution
- **Data consistency**
  - Statisticians from Patents and PTAB are engaged in conversations on how best to collect and report out data
  - The goal is to provide consistent data, that is usable and understandable to internal and external stakeholders

# Data study collaborations

- AIA trial study – prior art
  - OPQA partnered with PTAB to obtain data from AIA Trials
  - OPQA is reviewing these trials to better understand prior art trends and the prior art gap between prosecution and litigation
  - Comparing prior art trends in prosecution vs AIA trials (e.g. types of prior art and the frequency in which they are relied upon, etc.)

# Questions and comments

- **Stefanos Karmis**  
Director of the Office of patent quality assurance  
(571) 272-6744  
[stefanos.karmis@uspto.gov](mailto:stefanos.karmis@uspto.gov)
- **Scott R. Boalick**  
Chief administrative patent judge  
(571) 272-9797  
[scott.boalick@uspto.gov](mailto:scott.boalick@uspto.gov)
- **Jacqueline W. Bonilla**  
Deputy Chief administrative patent judge  
(571) 272-9797  
[jacqueline.bonilla@uspto.gov](mailto:jacqueline.bonilla@uspto.gov)



