Patent Trial and Appeal Board (PTAB)
Inventor Hour webinar

An introduction to the Board—terminology and processes

Janet Gongola, Vice Chief Administrative Patent Judge
Cynthia Hardman, Administrative Patent Judge
Ryan Flax, Administrative Patent Judge
Eric Jeschke, Administrative Patent Judge
August 26, 2021
What is Inventor Hour?

New **outreach effort** from the U.S. Patent and Trademark Office (USPTO) to inventors and new practitioners

Provides **foundational information** about the USPTO’s Patent Trial and Appeal Board (PTAB)

Each **monthly webinar** will present on various aspects of PTAB
Topics for Inventor Hour webinars

This inaugural webinar will provide a broad overview of the PTAB and its proceedings.

Future webinars will provide further information on those proceedings, or other aspects of practice before the PTAB, such as oral hearings, statistics, and PTAB history.
Question/comment submission

To send in questions or comments during the webinar, please email:
PTABInventorHour@uspto.gov
Agenda

What is the **PTAB**?

Meet the judges

The basics of **ex parte appeals**

The basics of **post-grant proceedings** under the America Invents Act

Walk about the **web**
What is the PTAB?
Meet the judges

Janet Gongola
Cynthia Hardman
Ryan Flax
Eric Jeschke
What is the PTAB?

a. What is the PTAB generally?
b. Who issues decisions at the PTAB?
c. What does the PTAB do?
What is the PTAB generally?

A board (i.e., a decision-making group) in the USPTO

Created on September 16, 2012, by the America Invents Act (AIA)

The Board of Patent Appeals and Interferences (BPAI), became the Patent Trial and Appeal Board.
Who issues decisions at the PTAB?

The **Director** of the USPTO

The **Deputy Director**

The **Commissioner for Patents**

The **Commission for Trademarks**

Approximately 250 administrative **patent judges** (APJs)
What does the PTAB do?

**Reviews examiner work product**

- Appeals in ex parte proceedings
- Appeals in reexamination proceedings and reissue applications

**Conduct trials of issued patents (AIA trials)**

Conducts interferences
Question/comment submission

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Inventor resources
www.uspto.gov
The basics of ex parte appeals
The basics of ex parte appeals

a. What are **ex parte appeals**?
b. What **rules and law** apply in an ex parte appeal?
c. What are the possible **outcomes** on appeal?
d. What happens **after** an ex parte appeal is over?
What are ex parte appeals?

After an application is filed, an examiner decides if it meets various requirements. If not, the examiner may issue a “rejection”.

When the examiner has twice rejected the claims or issued a “final” office action, the applicant can seek review by the PTAB.
What are *ex parte* appeals (cont.)?

Begins with “*appeal brief*” filed by appellant and then “*answer*” filed by the examiner.

Appellant may file a “*reply*”

Decided by a *panel* of at least three administrative patent judges (or statutory members)
What rules and law apply?

- Law of the U.S. Supreme Court and U.S. Court of Appeals for the Federal Circuit
- 35 U.S.C. (Patents)
- 37 C.F.R. Part 41
- Precedential PTAB decisions
  - Guidance to the PTAB
What are the possible outcomes?

The outcome may be an affirmance, an affirmance-in-part, a reversal, or new ground(s) of rejection

**Affirmance**: rejection of each and every claim is upheld

**Affirmance-in-part**: rejection of at least one claim, but not all, is upheld

**Reversal**: None of the examiner's rejections are upheld

**New ground(s) of rejection**: Judges issue a new rejection of one or more claims
What happens after an appeal?

The outcome dictates who is responsible for taking the next step.

If the outcome is an **affirmance or new ground(s) of rejection**, the **applicant** **must** take the next step.

If the outcome is an **affirmance-in-part**, the **applicant** **may** take the next step.

If the outcome is a **reversal**, the **examiner** will take the next step.
Question/comment submission

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Fast-track pilot programs

Fast-Track Appeals Pilot Program

• Pilot program to expedite ex parte appeals before the PTAB
• Appellant can request appeal be expedited out of turn by filing a petition and a fee
• Learn more about the Fast-Track Appeals Pilot Program at: www.uspto.gov/patents/ptab/fast-track-appeals-pilot-program

Fast-Track Pilot Program for Appeals Related to COVID-19

• Pilot program to expedite ex parte appeals related to COVID-19 before the PTAB
• Appellant can request appeal be expedited out of turn by filing a petition WITHOUT a fee
• Learn more about the Fast-Track Pilot Program for Appeals Related to COVID-19 at: www.uspto.gov/patents/patent-trial-and-appeal-board/covid-fast-track-appeals-pilot-program
The basics of post-grant proceedings under the America Invents Act
The basics of AIA trials

a. What are AIA trials?
b. What types of AIA trials exist?
c. Who can start an AIA trial?
d. Who is involved in an AIA trial?
e. How does an AIA trial work?
f. What rules and law apply in an AIA trial?
g. What are the possible outcomes?
What are AIA trials?

**America Invents Act (AIA)** – Congress revised the Patent Act to provide an *alternative* way to settle patent validity disputes besides district court litigation.

AIA trials are intended to be *streamlined*, *efficient*, and *cost effective*. 
What types of AIA trials exist?

**Inter Partes Review (IPR):** from 9 months after patent grant throughout the life of the patent; can challenge claims based on prior art (patents or printed publications)

**Post-Grant Review (PGR):** from patent grant through 9 months; can challenge claims based on prior art and other bases

**Derivation:** 1-year from claim publication; determines correct inventor; alleges another derived the invention from the correct inventor
Who can start an AIA trial?

Most people or corporate entities other than the patent owner can file a “petition”

Petition fee is required to file

U.S. government cannot

Certain people or corporations may be barred from filing due to their behavior
Who is involved in an AIA trial?

**Petitioner** = challenger

- Files petition challenging a U.S. patent; must pay a filing fee
- Carries legal burden throughout proceeding to prove claims are not patentable

**Patent owner**

- Has opportunities to represent their interests

Panel of at least three administrative patent judges (or statutory members)
How does an AIA trial work?

Institution phase

Trial phase
What rules and law apply in an AIA trial?

U.S. Supreme Court and U.S. Court of Appeals for the Federal Circuit

35 U.S.C. §§ 311-329 (statutes governing IPRs and PGRs)

37 C.F.R. §§ 42.1-42.412 (rules/regulations for trials in general, and IPRs, PGRs, and Derivation Proceedings)

Precedential PTAB decisions
https://www.uspto.gov/patents/ptab/precedential-informative-decisions

Consolidated Trial Practice Guide, Nov. 2019
What are the possible outcomes?

The outcome may be that all challenged claims are upheld, some challenged claims are upheld, or none of the challenged claims are upheld.

**All claims patentable:** Each and every challenged claim upheld

**Mixed:** At least one challenged claim, but not all, upheld

**All claims unpatentable:** No challenged claim upheld
Options for patent owner after a final written decision

Seek panel rehearing
Seek Director review
Appeal to the Federal Circuit
Inventors Digest
www.inventorsdigest.com

Monthly issues, each featuring articles about USPTO

Starting in September, monthly articles about PTAB

Free online
Walk about the web

New to 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.

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.

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.

Any questions?
Contact PTAB or peruse helpful FAQs.

> Get help

More about PTAB
More about PTAB Hearings

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
Question/comment submission

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Next Inventor Hour webinar

• **September 23, 2021**, from noon to 1 p.m. ET
• Topics
  – Meet an APJ
  – Appeal Bytes (information on ex parte appeals)
  – Walkabout the PTAB webpage
  – Trial Bytes (information on AIA trials)
  – Conquer the stats
Future Inventor Hour webinars

- **October** 28, 2021, from noon to 1 p.m. ET
- **November** 18, 2021, from noon to 1 p.m. ET
- **December** 16, 2021, from noon to 1 p.m. ET