Patent Trial and Appeal Board
Inventor Hour Webinar: Episode 9

Janet Gongola, Vice Chief Judge
Brian Fried, Inventor
Robert Silverman, Administrative Patent Judge
Amee Shah, Administrative Patent Judge
John Schneider, Administrative Patent Judge
June 23, 2022
Refresher: What is PTAB (the Board)?

PTAB: ex parte appeals, AIA proceedings, other

Patent Challengers

TTAB: ex parte appeals, inter partes proceedings

PATENTS: examine patent applications and grant patents

TRADEMARKS: examine and register trademarks
Today’s Agenda

1. Meet an Inventor
2. Appeal Byte: What is an Appeal Brief
3. IP History: Patent Models
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
Meet an Inventor:
Brian Fried

Robert Silverman, Administrative Patent Judge
Question/Comment Submission

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– PTABInventorHour@uspto.gov
PTAB Pro Bono Program

• A collaboration with the PTAB Bar Association to create a clearinghouse to bring together volunteer attorneys and pro bono clients.

• For more details – watch the recording of the April Inventor Hour online or search USPTO.gov.
Appeal Byte:
What is an appeal brief?

Amee Shah, Administrative Patent Judge
Agenda

- Parts of an appeal brief
- New appeal brief tool
Parts of an appeal brief
Parts of an appeal brief

Six parts:

1. Summary of claimed subject matter
2. Real party-in-interest
3. Related appeals, interferences, and trials
4. Argument
5. Conclusion (optional)
6. Claims appendix
Summary of claimed subject matter

- Provides a concise explanation of the subject matter defined in each of the rejected independent claims

- Not required for pro se applicants, but may help the Board understand the arguments

- If included, should identify, for each claim element, supporting disclosure and figures
Real party-in-interest

- Statement that identifies the real party-in-interest at the time the appeal brief is filed
- It may be you, the inventor, and/or others that have ownership rights to the patent application
- May be an assignee
- You must update if it changes during the proceeding (See 37 C.F.R. § 41.8)

Example: “The real party in interest is The Great White Café LLC (Baja, California 21511).”
Related appeals, interferences, and trials

List any prior or pending cases before the Board or a court that are related to the current appeal.

A related case is one involving a patent or application where papers (such as an Office Action or PTAB decision) regarding that patent or application would be affected by the current appeal.

– A related case might be, e.g., a continuation application

Example 1: “Appeal No. 2019-1234, prior decision dated July 1, 2020.”

Example 2: “There are no related appeals, interferences, or trials to appellant’s knowledge.”
Argument

Why the examiner’s decision to reject the pending claims of your application is improper and should be reversed
Conclusion and claims appendix

Conclusion should briefly explain what relief you want from the Board (e.g., reverse the examiner’s rejection)

Appendix must include all claims on appeal

– Should not indicate or illustrate prior amendments or reference non-admitted amendments
– Should start on a new page
New appeal brief tool and how to access
Appeal brief tool

There are two parts to the appeal brief tool:

1. Word document template
2. PDF instructions for completing the template
Location of the brief tool at PTAB’s webpage
www.uspto.gov/patents/ptab
Location of the brief tool at PTAB’s webpage

Preparing an ex parte appeal brief webpage

Are you an independent inventor looking to appeal a patent examiner’s rejection of your claims without the assistance of an attorney, which is called acting “pro se” in your appeal? If so, you’re in the right place.

If any of the claims in a patent application has been twice rejected or finally rejected by a patent examiner, you may seek review as an appellant before the Patent and Trademark Appeal Board (PTAB).

An appellant and the examiner may submit written papers known as “briefs” to explain their respective positions. The process begins when an appellant files a “notice of appeal” followed by an appellant’s “appeal brief.” The examiner usually responds with an “answer” to address the appellant’s argument made in the “appeal brief.” The appellant may, but doesn’t have to, then file a “reply brief” to address the “answer.”

Once fully briefed, your appeal will be considered by a panel of three administrative patent judges at the Board. The panel will review the briefs and render a decision either reaffirming (“affirming”) or not maintaining (“reversing”) any part of the examiner’s rejection.

For help creating your appeal brief, see the documents below:

- A Word document template that features the various required sections of a brief, for example, a summary of the claimed subject matter, arguments, and claim appendix.
- A PDF that provides general guidance on the information required in the various sections of the brief along with helpful examples to use as models.
- An instructional video on how to use these documents.

With these templates and, if needed, the relevant cited rules and the Manual of Patent Examining Procedure, you should be well on your way to preparing an effective appeal brief.

Other resources:
- To file your appeal brief, go to FFS: Web
- New to PTAB
- Contact Information for the Board
Appeal brief tool: Word template and PDF instructions

### Word template

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: [Inventor Name(s)]

Group Art Unit: [####]

Application No.: [####,####]

Examiner: [Name]

Filed: [Application Filing Date]

Confirmation No.: [####]

Title: [APPLICATION TITLE]

MAIL STOP APPEAL BRIEF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Appellant submits this Appeal Brief in response to the final Office action mailed [Date], and further to the Notice of Appeal filed [Date]. Appellant requests consideration of this appeal by the Patent Trial and Appeal Board.

I. REAL PARTY IN INTEREST
   Add

II. RELATED APPEALS AND INTERFERENCES
   Add

III. SUMMARY OF CLAIMED SUBJECT MATTER
   Add

IV. ARGUMENTS
   Add
   a. Rejection 1 – The Rejection of Claims... Based on...
      i. Independent Claim 1

### PDF Instruction Document

I. REAL PARTY IN INTEREST
   This section requires a statement from you that identifies the real party in interest at the time the appeal brief is filed. A real party in interest may include you as the inventor and any other individuals or entities that have ownership rights to the patent application. For example, an assignee of the patent application may be a real party in interest. A statement is not required if the named inventor(s) are the real party in interest. If you do not provide a statement, the Board will consider the inventor(s) to be the real party in interest. Typically, a pro se inventor is the real party in interest. See MPEP §§ 301, 324, 1205.02(i) (https://mpep.uspto.gov/RDMS/MPEP/current/#current/d0e123366.html).

   Example:
   The real party of interest is The Great White Café LLC (Baja, California 21511) by virtue of an assignment by the inventor duly recorded in the Assignment Branch of the Patent and Trademark Office.

II. RELATED APPEALS AND INTERFERENCES
   Please list all of your prior or pending cases before the Board or before a court. These cases are based on applications or patents that you
Filing an appeal brief via EFS-Web:
Preparing an ex parte appeal brief page

Other resources:
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Filing an appeal brief via EFS-Web

https://www.uspto.gov/patents/apply/applying-online/about-efs-web
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Invention-Con

https://www.uspto.gov/about-us/events/invention-con-event-series

Coming August 10–12, 2022!

Invention-Con is the USPTO's annual conference for independent inventors, entrepreneurs, and small business owners whose success depends on guarding their creative work.

For more information, email InventionCon@uspto.gov or call 571-272-8033.
John E. Schneider, Administrative Patent Judge

IP History: Patent Models
Patent Models

Patent Act of 1790:

“[D]eliver to the Secretary of State a specification in writing, containing a description, accompanied with drafts or models, and explanations and **models (if the nature of the invention or discovery will admit of a model)** of the thing or things, by him or them invented or discovered.”
Patent Models

- Models were limited in size
  - 12x12x12
  - Sometimes multiple models were submitted

- Requirement maintained until 1880
  - Congress dropped the requirement in 1870

- Some inventors still submitted models to show reduction to practice
Patent Models

Models were on public display

Model Room 1860s
Patent Models

Many Models were destroyed in the Patent Office fires in 1836 and 1877. 75,000 were destroyed in 1877.
Patent Models

- Patent Office maintained the collection until 1925
- Smithsonian took 10,000
- Remainder sold off
  - Hagley Museum
  - Franklin Institute
  - Private collectors
President Lincoln’s Patent

United States Patent Office
Abraham Lincoln, of Springfield, Illinois.

Buoys for Vessels Over Shoals

Specification forming part of Letters Patent No. 6,469, issued May 22, 1849; application filed March 26, 1849.

Figures 1, 2, 3, and 4 show the various parts of the invention. In the construction of such buoys the body E, with the pipe or tube A, and the float B, are arranged as shown in the figures. The body E is perforated at the lower end with openings D, which pass through the buoy and are closed by means of stops or plugs to prevent water from entering the buoys. The pipes A are placed at opposite ends of the buoy and are connected with the float B by means of a joint or coupling to prevent the pipes from being separated from the float in case of injury or disability. The glasses or tubes E are placed at the lower end of the buoy and are connected with the body E by means of a joint or coupling to prevent the glasses from being separated from the body in case of injury or disability. The glasses or tubes E are placed at the lower end of the buoy and are connected with the body E by means of a joint or coupling to prevent the glasses from being separated from the body in case of injury or disability. The glasses or tubes E are placed at the lower end of the buoy and are connected with the body E by means of a joint or coupling to prevent the glasses from being separated from the body in case of injury or disability. The glasses or tubes E are placed at the lower end of the buoy and are connected with the body E by means of a joint or coupling to prevent the glasses from being separated from the body in case of injury or disability.

US 6,469 issued May 22, 1849

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[Image of Lincoln's Patent Image]
Morse Telegraph

US 4,453 issued 1846
Typewriter

US 182,511 Issued 1876
Cotton Picker

US 266,884 issued 1882
Frying Pan

US 108,385 Issued 1870
Question/Comment Submission

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Next Inventor Hour webinar

• **July 28, 2022**, at noon to 1 p.m. ET

• Topics, include: Meet Inventor Stephen Key, What is Prior Art?, Motions to Amend
Future Inventor Hour webinars

- **July 28, 2022**, at noon to 1 p.m. ET
- August 10-12, Invention-Con
- September 22