Patent Trial and Appeal Board
Inventor Hour: Episode 13

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Arthur Peslak, Administrative Patent Judge
Ulrike Jenks, Administrative Patent Judge
Lynne Browne, Administrative Patent Judge
Christopher Paulraj, Administrative Patent Judge
Victoria F. Phillips, Clinic Director, Glushko-Samuelson IP Law Clinic, American University Washington College of Law
David Grossman, Adjunct Patent Supervisor, Glushko-Samuelson IP Law Clinic, American University Washington College of Law
What is the Patent Trial and Appeal Board?

Patent Challengers

PTAB
- ex parte appeals,
- AIA proceedings, other

PATENTS
- examine patent applications
- grant patents

TTAB*
- ex parte appeals, inter partes proceedings

TRADemarks
- examine and register trademarks

*Trademark Trial and Appeal Board (TTAB)
Today’s agenda

1. Appeal byte: What is a claim?
2. Trial byte: Motions to Amend
3. Case study: Ex parte Lewis
4. Meet a Law School IP Clinic Director
5. Q&A

*INFORMATION NOT INTENDED AS LEGAL ADVICE
Question/comment submission

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Appeal byte:
What is a claim?

Arthur Peslak, Administrative Patent Judge
What is a claim?

Claims define the subject matter that you seek to protect and are part of the patent or application’s written description.
What is a claim?

Claim

Preamble

Transitional phrase

Body

Wherein/whereby clause*

Functional*

Means plus function*

*optional
Claim – Preamble and Type of Invention

A Process ...

A Machine ...

A Manufacture

A Composition of Matter
Preamble

A process for collecting Martian soil to identify indigenous lifeforms
Claim – transitional phrase

- Comprising
- Consisting
- Consisting essentially
1. A process for collecting Martian soil to identify indigenous lifeforms, comprising:
   i. launching a rocket from the United States to land on Mars;
   ii. digging up soil sample;
   iii. putting the sample on a slide;
   iv. optically imaging the sample; and
   v. detecting an unknown organism.
Wherein the Martian organism will not use either RNA or DNA as the genetic material;
Claim – functional

. . . And the Martian organism is transparent to infrared rays;
Claim – means plus function

Where the testing also involves a means for scanning the sample.
1. A process for collecting Martian soil to identify indigenous lifeforms, comprising:

i. launching a rocket from the United States to land on Mars;
ii. digging up soil sample;
iii. putting the sample on a slide;
iv. optically imaging the sample; and
v. detecting an unknown organism;

wherein the Martian organism will not use either RNA or DNA as the genetic material;

and the Martian organism is transparent to infrared rays;

where the testing also involves a means for scanning the sample.
2. The process of claim 1, wherein the rocket is launched from Cape Canaveral.

3. The process of claim 1, wherein the imaging is performed by a human on a microscope.

4. The process of claim 2, wherein the Martian organism uses silicon based genetic material.
Question/comment submission

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Trial byte:
Motions to amend

Ulrike Jenks, Administrative Patent Judge
Overview of AIA proceedings

**Petition Phase**
- Petition Filed
- PO Prelim. Resp.
- Decision on Petition

**Trial Phase**
- PO Resp. & MTA
- Pet. Reply & Opp. to MTA
- PO Sur-Reply & Reply to Opp.
- Oral Hearing (on request)
- Final Written Decision

**PO Discovery**
**Pet Discovery**
**PO Period**
**Motions on Evidence**

No more than 12 months (*by statute*)
Patent owner motion to amend

Cancel any challenged claim

Amend any challenged claim

Cannot enlarge scope or add new matter
Petitioner opposition to motion to amend

- **Petitioner bears the burden** of showing the unpatentability of proposed substitute claims

- The Board itself may, in the interests of justice, exercise its **discretion to grant or deny** a motion to amend for any reason supported by the evidence of record
Motion to Amend Pilot Program

Option 1:
Request preliminary guidance

Option 2:
File a revised MTA
Other amendment options

• Notice regarding options for reissue or reexamination during pending AIA proceeding
  • Published in Federal Register at 84 Fed. Reg. 16654 (April 22, 2019)
  • Available at https://www.uspto.gov/patents/ptab/notice-regarding-options-amendments
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Case file: Ex Parte Lewis, Appeal No. 2008-0034
Goals

Provide **insight** into patent prosecution

Show importance of careful **claim drafting**

Answer questions regarding PTAB’s **approach**
Relevant legal principles

“The name of the game is the claim”

Prior art or combination must disclose all limitations in order to anticipate or render obvious the claim.

Limitation not in the claim cannot distinguish claim over prior art.
Technology of application

TITLE: METHOD FOR PRACTICING PITCHING AND APPARATUS THEREFOR

INVENTOR: JOSEPH EDWIN LEWIS

CROSS REFERENCE TO RECENTLY GRANTED PATENTS

This application claims the benefit under 35 U.S.C. §119(e) of U.S. Provisional Application No. 60/516,467 filed 11/01/2003, which is included herein by reference.

TECHNICAL FIELD

The present invention pertains generally to the games of baseball and softball, and more particularly to a method and system for practicing pitching in which the positions of a batter mannequin and a catcher mannequin are remotely controlled by a user.

BACKGROUND OF THE INVENTION

Devices for practicing pitching are known in the art. U.S. Patent No. 6,350,211 shows a baseball pitching aid wherein a simulated pitcher is used to help the pitcher improve his techniques. The lower portion of the simulated pitcher uses a motorized assembly to simulate a pitcher's arm. The simulated pitcher is then moved to various simulated locations near a batter to aid the baseball player in improving his pitch. The simulated pitcher is controlled by a user to move the simulated pitcher into the path of the baseball to aid in the improvement of the baseball player.

The present invention is directed to a method and apparatus for practicing pitching. The present invention is particularly useful for baseball and softball pitchers. The present invention helps to improve the skills of the pitcher by allowing the pitcher to practice in a simulated environment. The present invention is particularly useful for baseball and softball pitchers who want to improve their pitching skills. The present invention is also useful for baseball and softball coaches who want to improve the skills of their players.
Technology of application

- pitching area 500
- pitching mound 506
- remote control unit 70
- catcher mannequin 24
- batter mannequin 22
- turntable 26
- fixed plate 32
- rotatable head 34
- pitching mound 506
Cited prior art

U.S. Patent No. 3,525,525 (Rideout)
45. A system for practicing pitching, comprising: a batter mannequin which rotates to a right handed batting position or to a left handed batting position.
Claim 45 anticipated by Rideout?

Examiner: “Rideout discloses a batter mannequin (batter 30), which rotates to a right-handed batting position or to a left handed batting position.”
Claim 45 anticipated by Rideout?

Appellant: Batting positions refers to "specific physical relationships" between batter and home plate/catcher.

Rideout batter “cannot ... change batting hands, much less change between right and left handed batting positions.”
Claim 45 does not recite a plate or a catcher, and during prosecution Examiner and Board give terms broadest reasonable interpretation in light of Specification.

Claim 45 does not require rotation to both right handed and left handed batting positions.

Claim 45 does not require changing batting hands.
Claim 49 anticipated by Rideout?

47. The system according to Claim 45, further including:
   a turntable having a perimeter and a center; and, said batter mannequin disposed on said turntable in an off center position near said perimeter of said turntable.

49. The system according to Claim 47, further including:
   said turntable rotating about 180° to effect said right handed and left handed batting positions.
Claim 49 anticipated by Rideout?

Examiner: “Rideout shows the turntable rotating (arms 22) about 180 degrees and the batter (30) is turned 180 degrees to go from a right-handed batter to a left-handed batter.”
Claim 49 anticipated by Rideout?

Appellant: “[S]ince the batter is a fixed toy figure, it can never . . . go from a right-handed batter to a left-handed batter.”

“No amount of rotation can change ... handedness of the Rideout batter.”
Board reversed rejection of claim 49

"[C]laim 49 specifically recites rotation of the turntable to position the batter in the 'right-handed and left-handed batting positions' ... (in contrast to independent claim 45 ... using the alternative language 'or')."

"Rideout clearly does not disclose a left-handed batting position."

**FIG. 4**
1. A system for practicing pitching, comprising:

- a batter mannequin which rotates to a right handed batting position or to a left handed batting position;
- a turntable having a perimeter and a center;
- a fixed plate disposed in front of said batter mannequin;
- said batter mannequin rotating about said fixed plate.

2. A system for practicing pitching, comprising:

- a batter mannequin which rotates to a right handed batting position or to a left handed batting position;
- said turntable rotating about 180° to effect said right handed and left handed batting position.
Takeaways

Keeping in mind **brodest reasonable interpretation** in view of Specification

Including limitations **not suggested** by prior art

**Carefully describing** invention in the claims

Allowed Claims
Question/comment submission

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Victoria F. Phillips (Clinic Director) & David Grossman (Adjunct Patent Supervisor)
Vicki Phillips

David Grossman

ipclinic@wcl.american.edu
Current nationwide coverage
Nationwide coverage


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Future programs

Inventor Hour, Episode 14
Thursday, January 26, noon (ET)