Patent Trial and Appeal Board
Inventor Hour webinar: episode 3

Janet Gongola, Vice Chief Judge for Strategy
Jeff Fredman, Administrative Patent Judge
Cynthia Hardman, Administrative Patent Judge
Eric Jeschke, Administrative Patent Judge

October 28, 2021
Agenda

Meet a Judge

Appeal Byte: how PTAB reaches a decision

Trial Byte: Patent Owner strategies

Walkabout the PTAB webpage

*INFORMATION NOT INTENDED AS LEGAL ADVICE
Question/comment submission

To send in questions or comments during the webinar, please email:

PTABInventorHour@uspto.gov
Meet a Judge: Frances Ippolito
Frances Ippolito
Administrative Patent Judge
Appeal Byte:
How the PTAB reaches a decision in *ex parte* appeals

Jeff Fredman, Administrative Patent Judge
Ex parte appeals process

1. Appeals Docketing
2. Appeals Paneling
3. Judges review file
4. Judges author Decision
5. Oral Hearing (if requested)
6. Conference with panel
7. Decision circulated and issued
8. Request for Rehearing (if requested)
9. Rehearing Decision issued
Ex parte appeals process

Appeals Docketing

Appeals Paneling

Judges review file

Oral Hearing (if requested)

Conference with panel

Judges author Decision

Decision circulated and issued

Request for Rehearing (if requested)

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Cynthia Hardman, Administrative Patent Judge

Trial Byte:
Petition phase strategies for Patent Owners
Patent Owner Preliminary Response

**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

**No more than 12 months (by statute)**
Overview of potential patent owner strategies

- **Disclaimer** of one or more challenged claims
- Patent Owner **Preliminary Response** (optional)
- **Discretionary denial** arguments
  - 35 U.S.C. §§ 314/324; § 325(d)
Disclaimer

• “No inter partes review will be instituted based on disclaimed claims.”
  – 37 C.F.R. § 42.107(e).

• A statutory disclaimer can streamline the proceedings.
Patent Owner Preliminary Response is optional

• “The patent owner may file a preliminary response to the petition.”
  – 37 C.F.R. § 42.107(a).

• A preliminary response can address reasons why the Board should decline to institute review of the challenged patent.
Institution of IPR and PGR is discretionary.

USPTO Director is “permitted, but never compelled” to institute IPR or PGR.

1. Discretionary denial – multiple petitions

- Institution may be denied where *multiple petitions* are filed against the same patent.
  - Serial petitions (sequential in time)
  - Parallel petitions (at approximately same time)
2. Discretionary denial – failure to identify grounds with particularity

• 35 U.S.C. § 312(a): “A petition . . . may be considered only if . . . the petition identifies, in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim . . . .”
3. Discretionary denial – parallel litigation

• Institution may be denied based on the state of a parallel litigation.
4. Discretionary denial – § 325(d)

- Institution may be denied if the same or substantially the same prior art or arguments previously were presented to the Office.
Question/comment submission

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Walkabout the PTAB webpage

Eric Jeschke, Administrative Patent Judge
Where to find PTAB decisions:
uspto.gov/patents/ptab
How to find a specific decision:
developer.uspto.gov/ptab-web/#/search/decisions
How to find specific proceedings:
developer.uspto.gov/ptab-eb/#/search/proceedings
How to find specific documents:
developer.uspto.gov/ptab-web/#/search/documents

![PTAB Decisions](image)

**Documents**

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<th>Proceeding #</th>
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<th>Tech Center</th>
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uspto.gov/patents/ptab/precedential-opinion-panel
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Audience Questions and Comments
Next Inventor Hour webinar

- **November** 18, 2021, at noon to 1 p.m. ET
  - Meet a Supervisory Patent Attorney
  - Hearing Byte: ex parte hearings
  - Trial Byte: motions to amend
  - How PTAB fits in: District Court; PTAB; International Trade Commission (ITC)
  - Case study