Patent Trial and Appeal Board
Inventor Hour webinar: Episode 8

Janet Gongola, Vice Chief Administrative Patent Judge
Terrence W. McMillin, Administrative Patent Judge
Meredith Petravick, Administrative Patent Judge
John E. Schneider, Administrative Patent Judge
Emily Sprague, Office of Enrollment and Discipline

May 26, 2022
Today’s agenda

1. Meet a Judge
2. Appeal Byte
3. Hearing Byte
4. Law School Clinic Program
5. 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 a Judge:
Judge Terrence W. McMillin

Janet Gongola, Vice Chief Administrative Patent Judge
Ex Parte Appeal Byte:
File an *ex parte* appeal OR file a petition to the Director of the USPTO
Petitionable matters during prosecution

A petition to the Director under 37 C.F.R. § 1.181 is a request to invoke the supervisory authority of the Director to review any action or requirement of an examiner, which is not subject to appeal to the Board.

Generally, an objection is petitionable.
Examples of petitionable matters during prosecution

Some petitionable matters are:

- a requirement for restriction or election of species;
- finality of an office action;
- non-entry of amendments;
- a requirement to cancel “new matter” from the specification; and
- failure to designate a rejection as a new ground of rejection in an examiner’s answer (37 C.F.R. § 41.40).
Appealable matters during prosecution

An *ex parte* appeal under 35 U.S.C. § 134 is a request for the Board to review an adverse decision in a second or subsequent rejection of an applicant’s claims by an Examiner.

Generally, a rejection is appealable.
Examples of matters appealable to the Board

Some appealable matters are:

- a patent eligibility rejection under 35 U.S.C. § 101;
- a patentability rejection based on prior art under 35 U.S.C. §§ 102, 103; and
- an indefiniteness, enablement, or written description rejection under 35 U.S.C. § 112.
Who decides?

During prosecution, the Board will not ordinarily hear a question that should be decided by the Director on petition, and the Director will not ordinarily entertain a petition where the question presented is a matter appealable to the Board.

When the objection is "determinative of the rejection," however, the matter may be addressed by the Board during an appeal.
Who decides a petition to the Director?

The Director may delegate their authority to Office officials to decide petitions while a patent application is pending.

Because different matters may be considered by different branches of the Office, each distinct subject, inquiry, or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.
Who decides an *ex parte* appeal?

Each *ex parte appeal* is heard by at least three members of the Patent Trial and Appeal Board, who are designated by the Director.
When to file?

- Generally, a petition to the Director should be filed within two months from the Office Action at issue.

- A notice of appeal to the Board must be filed within the period for reply set in the last Office Action from the Examiner, which is normally three months for applications.
Timeliness

The mere filing of a petition to the Director will not stay the period for replying to an Examiner’s action that may be running against an application or act as a stay of other proceedings.

A petition to the Director not filed within 2 months from the Office action at issue may be dismissed as untimely.

Generally, petitionable matters are resolved in a case by the time it is before the Board for a decision.
Resources

More information about filing a petition to the Director is available at:

– USPTO Website at https://www.uspto.gov/patents/apply/petitions

More information about filing an *ex parte* appeal is available at:

– USPTO Website at https://www.uspto.gov/patents/ptab/appeals
Office of Petitions – help desk

• Office of Petitions staff answer questions about petitionable matters.
• Phone Number 571-272-3282.
• Available Monday to Friday 8:30 AM to 5:00 PM Eastern.
Question/comment submission

• To send in questions or comments about the presentation, please email:
  – PTABInventorHour@uspto.gov
Hearing Byte
AIA Oral Hearings

John E. Schneider, Administrative Patent Judge
Hearings: AIA trials

**PETITION PHASE**
- Petition Filed: 3 mos
- PO Prelim. Resp.: 3 mos max
- Decision on Petition: 3 mos

**TRIAL PHASE**
- PO Resp. & MTA: 3 mos
- Pet. Reply & Opp. to MTA: 3 mos
- PO Sur-Reply & Reply to Opp.: 1 mo

- Oral Hearing (on request)
- Final Written Decision

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

*No more than 12 months (by statute)*
AIA hearings

- What to expect
- What to present
- How to prepare
What to expect

- Opportunity to further explain your case
- Three judge panel
- One hour each side
- Currently remote
- Transcript becomes part of the record
What to present

- May use demonstratives such as PowerPoint
- No new evidence or arguments
  - Panel may ask for citation to record to confirm no new argument
- Usually no live testimony
A word about using PowerPoint
How to prepare

- Pre-hearing Conference
- Know the record
- Focus on key issues
- Be ready for hard questions
- Listen to the questions asked the other side
- Know your PowerPoint deck
- Listen to or read prior arguments
Resources

More Information about AIA hearings is available at:

Guide to the administration of oral hearings before the Patent Trial and Appeal Board

Consolidated Trial Practice Guide
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.
Overview:
USPTO Law School Clinic Certification Program

Emily Sprague, Staff Attorney
Office of Enrollment and Discipline, USPTO
Law School Clinic Certification Program

- Allows students in a participating law school’s clinic program to practice before the USPTO under the strict guidance of a Law School Faculty Clinic Supervisor
  - The OED Director grants participating law students limited recognition to practice before the USPTO in patents/trademarks.

- Participating in the program gives real-world experience to clinic students while providing IP pro bono services to the community

- Benefits for students, schools, the USPTO, and entrepreneurs and inventors seeking legal representation
Benefits to USPTO and inventors

Impact for inventors

– Opportunity to work with experienced patent practitioners/faculty clinic supervisors and law students
– Benefit from IP pro bono services
– May benefit from expedited review of his/her applications by the USPTO

Impact for the USPTO

– Increased participation in the patent system by increasing patent application filings
– Improved patent quality
– Supplements pro se (filing on your own) assistance efforts
History of the program

- Pilot program from 2008 to 2014
- H.R. 5108 sponsored by two U.S. Representatives
- Signed into law on December 16, 2014
  - Required the establishment of regulations for application to and participation in the program
    - 37 CFR §§ 11.16 (admission) & 11.17 (participation)
    - Notice of Proposed Rulemaking issued December 16, 2015
    - Final Rule published May 27, 2016
Participating law school requirements

- ABA accredited law school
- Must provide services *pro bono* to the public
- Must have protocol for seamless representation of clients
- Must have approved Faculty Clinic Supervisor
- Must comply with reporting requirements
Current nationwide coverage

[Map of the United States with various markers indicating patent and trademark programs, patent program only, and trademark program only.]
Nationwide coverage


<table>
<thead>
<tr>
<th>Arizona</th>
<th>California</th>
<th>Colorado</th>
<th>Connecticut</th>
<th>District of Columbia</th>
<th>Florida</th>
<th>Idaho</th>
<th>Illinois</th>
<th>Indiana</th>
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<tr>
<td>Arizona State University</td>
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<td>University of Colorado Law School</td>
<td>University of Connecticut Law School</td>
<td>American University, Washington College of Law</td>
<td>University of Miami Law School</td>
<td>University of Idaho College of Law</td>
<td>Northwestern Pritzker School of Law</td>
<td>Indiana University Maurer School of Law</td>
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<td>Sandra Day O'Connor College of Law</td>
<td>Lincoln Law School of San Jose</td>
<td>The George Washington University School of Law</td>
<td>Howard University School of Law</td>
<td>The University of Cincinnati</td>
<td>University of Notre Dame Law School</td>
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<td>University of California, Irvine School of Law</td>
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<td>University of Notre Dame Law School</td>
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<td>Southern University Law Center</td>
<td>University of Maryland School of Law</td>
<td>Northeastern University School of Law</td>
<td>University of Detroit Mercy School of Law</td>
<td>Mitchell Hamline School of Law</td>
<td>University of Minnesota Law School</td>
<td>University of Nebraska College of Law</td>
<td>University of New Hampshire</td>
<td>Rutgers Law School</td>
<td>Brooklyn Law School</td>
<td>North Carolina Central University School of Law</td>
<td>Case Western Reserve University School of Law</td>
<td>Lewis &amp; Clark Law School</td>
<td>University of Puerto Rico School of Law</td>
<td>Roger Williams University School of Law</td>
<td>University of Tennessee College of Law</td>
<td>Baylor Law School</td>
<td>Brigham Young University Law School</td>
<td>George Mason University, Antonin Scalia Law School</td>
<td>Seattle University School of Law</td>
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<td>Tulane University Law School</td>
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<td>Rutgers Law School</td>
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<td>University of North Carolina at Chapel Hill School of Law</td>
<td>Wake Forest University Law School</td>
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<td>University of Puerto Rico School of Law</td>
<td>University of Rhode Island School of Law</td>
<td>Vanderbilt Law School</td>
<td>South Texas College of Law, Houston</td>
<td>Texas A&amp;M University School of Law</td>
<td>George Mason University, Antonin Scalia Law School</td>
<td>University of Washington School of Law</td>
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Program overview

Currently, **62 law schools** are in the program from all across the United States

![Bar chart showing participation by law schools in the program.](chart.png)
Clients served statistics

Client representations undertaken
2017–2021

<table>
<thead>
<tr>
<th>Year</th>
<th>Representations</th>
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<tbody>
<tr>
<td>2017</td>
<td>1889</td>
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<tr>
<td>2018</td>
<td>2217</td>
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<td>2019</td>
<td>2313</td>
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<tr>
<td>2020</td>
<td>2114</td>
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<td>2021</td>
<td>2267</td>
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<tr>
<td>Totals</td>
<td>10,800</td>
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Client Representations Undertaken
New application filing statistics

Application filing statistics
FY2009–2021

Patent Applications Filed
Trademark Applications Filed
Summary of application statistics

Application filing statistics
FY2009–2021

Total Applications Filed
- Patent Applications
- Trademark Applications
Prosecution work statistics

Reponses filed
2017–2021

Patent Responses
Trademark Responses
Results/successes statistics

Patents issued and trademarks registered
2017–2021

- Patents Issued
- Trademarks Registered
Finding and contacting a participating law school


Law School Clinic Certification Program

The Law School Clinic Certification Program includes over 60 participating law school clinics that provide legal services pro bono to the public, including to inventors, entrepreneurs, and small businesses. Participating law school clinics provide patent and/or trademark legal services to qualified members of the public who are accepted as a client of a clinic. Each participating law school has requirements for accepting new clients and accepts new clients at their discretion.

Expand all | Collapse all

Get help from a law school clinic

Students enrolled in participating law school clinic certification programs practice intellectual property law before the USPTO under the strict guidance of a law school faculty clinic supervisor. Students practice both patent and trademark law before the United States Patent and Trademark Office (USPTO). The Office of Enrollment and Discipline administers the program; the Director of the Office of Enrollment and Discipline grants the law students limited recognition to practice before the USPTO.

Students gain experience drafting and filing either patent applications or trademark applications for clients of the law school clinic. Further, as they are authorized to practice before the USPTO, they gain experience answering office actions and communicating with either patent examiners or trademark examining attorneys for the applications they have filed.
Additional information

• Questions regarding the program may be directed to the Office of Enrollment and Discipline:
  – Phone: 571-272-4097
  – Email: LawSchoolInformation@uspto.gov

• See frequently asked questions for more information:
  – Law School Clinic Certification Program FAQs
Question/comment submission

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  – PTABInventorHour@uspto.gov
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.
Next Inventor Hour webinar

June 23, 2022, at noon to 1 p.m. ET

- Meet a judge
- Appeal Byte: what is an appeal brief
- IP History: patent models