Patent Trial and Appeal Board
Inventor Hour Webinar: Episode 5

Tawen Chang, Administrative Patent Judge
Ryan Flax, Administrative Patent Judge
Janet Gongola, Vice Chief Judge
Ulrike Jenks, Administrative Patent Judge
Eric C. Jeschke, Administrative Patent Judge

February 24, 2022
Today’s Agenda

1. Meet a Judge
2. How PTAB Fits In
3. Appeal Byte
4. PTAB Myth Busting
5. Q&A
Meet a Judge:
Judge Tawen Chang
Patent Pro Bono Program for Independent Inventors & Small Businesses

Are you an inventor or small business who has limited resources and needs help applying for a patent on an invention? If so, you may be eligible to receive pro bono ("for free") attorney representation through the Nationwide Pro Bono Program.

https://www.uspto.gov/patents/basics/using-legal-services/pro-bono/inventors
How PTAB Fits In:
Board / Federal Circuit / Supreme Court

Ryan H. Flax, Administrative Patent Judge
Patent-Adjudicating Forums

PTAB

Fed. Cir.

US Supreme Court
The Board at USPTO

PTAB

Fed. Cir.

US Supreme Court
The Board at USPTO

PTAB

Ex Parte Appeals

AIA Proceedings

IPR

PGR

Derivation
Appealing Board Decisions

PTAB

Ex Parte Appeals

Req. Reh'g

Fed. Cir.

EDVA
Appealing Board Decisions

PTAB

IPRs & PGRs

Fed. Cir.

Req. Reh’g

Dir. Rev.

POP Rev.
The Federal Circuit
The Federal Circuit

- PTAB
- Other Administrative Agencies
- ITC
- Ct. Fed. Claims
- US Dist. Courts
The US Supreme Court

PTAB
Fed. Cir.
US Supreme Court
The US Supreme Court

_U.S. Constitution, Article III, Section I:_

“The judicial Power of the United States, shall be vested in one Supreme Court, and in such inferior Courts as the Congress may from time to time ordain and establish.”
The US Supreme Court
Patent-Adjudicating Forums

PTAB → Fed. Cir. → US Supreme Court
Question/Comment Submission

To send in questions or comments about the presentation, please email:

– PTABInventorHour@uspto.gov
LEAP Program

Legal Experience and Advancement Program provides training and oral advocacy opportunities for less experienced advocates to gain practical experience in proceedings before the Patent Trial and Appeal Board.

https://www.uspto.gov/patents/ptab/leap
What is a declaration?

Ulrike Jenks, Administrative Patent Judge
What is a Declaration?

Declarations are witness *testimony*. All statements are written and must be made *under oath*.

Declarations are submitted as *exhibits* to accompany an office action response or appeal brief.
Who are Declaration Witnesses?

Fact Witnesses

Experts

Inventors

(usually people that know the technology and can testify as to what one of ordinary skill in the art would have known)
Declaration Testimony

Support patentability positions like:

- Written description
- Enablement
- How the ordinarily skilled artisan would understand the prior art
- Objective indicia of non-obviousness
What Evidence Should You Submit?

- **Documents** that support your patentability positions
- **Data** that support your patentability positions
- **Witness declarations** that support your patentability positions
Parts of a Declaration

- **Case Caption**
- **Numbered Paragraphs**
- **Sworn Oath**
- **Date & Signature**

**Sample Declaration Text:**

1. I, Jens Mollerup, declare and state that:
   1. I am a citizen of Denmark, and I work with the inventor of the above-identified application. I understand that the above-identified application has been assigned to Dako Denmark A/S. Agilent Technologies acquired Dako in 2012. Prior to February 1, 2017, I was an employee of Dako Denmark A/S, and then I was transferred to Agilent Technologies Denmark ApS.
   2. I understand that the patent examiner has rejected claims directed to a method of hybridizing nucleic acid sequences as being unpatentable based on the prior art cited by Bischoff et al. U.S. Patent No. 3,686,374. For the reasons above, Bischoff is not relevant to a method of hybridization.
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Inventors Digest

https://www.inventorsdigest.com

• Monthly issues, each featuring articles about USPTO
• Monthly articles about PTAB
• Free online
PTAB Files: Myth-Busting

Eric C. Jeschke, Administrative Patent Judge
Myth:

Ex parte appeals take 3 years to receive a decision from the PTAB.

PLAUSIBLE? BUSTED?
Facts:

After PTAB gets jurisdiction, it takes about 13 months to receive a PTAB decision on an ex parte appeal.
Myth:

PTAB almost always affirms the examiner’s rejection of the claims in *ex parte* appeals.

PLAUSIBLE? BUSTED?
Facts:

PTAB affirms an examiner’s rejection about 56% of the time.

Notably though, less than 3% of examiner final rejections are appealed to the Board.
Myth:

Most PTAB proceedings involve a patent in parallel litigation before the U.S. district courts.

PLAUSIBLE?  BUSTED?
Facts:

About 85% of PTAB cases DO involve a patent subject to concurrent district court litigation.
Myth:

PTAB institutes trial in every AIA proceeding.

PLAUSIBLE?  BUSTED?
Facts: PTAB institutes an AIA trial about 55 to 65% of the time.

(FY18 to FY22 through October: Oct. 1, 2017 to Oct. 31, 2021)
Myth:

In AIA proceedings, PTAB invalidates all patents it sees.

Plausible? Busted?
Facts: BUSTED

Outcomes by patent

17%

FWD patentability or unpatentability reported with respect to the claims at issue in the FWD. “Mixed Outcome” is shown for patents receiving more than one type of outcome from the list of: denied, settled, dismissed, and/or req. adverse judgement only. A patent is listed in a FWD category if it ever received a FWD, regardless of other outcomes.
More PTAB Statistics

For more information about PTAB statistics, including the data featured here, check our Statistics Webpage

www.uspto.gov/patents/ptab/statistics
Question/Comment Submission

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Next Inventor Hour webinar

March 24, 2022, noon to 1 p.m. ET

• Meet the Chief Clerk of the Board
• Patent Pro Bono Program
• Trial Bytes—Consolidated Trial Practice Guide
• Case Study
Future Inventor Hour webinars

- **March 24, 2022**, noon to 1 p.m. ET
- April 28, 2022 (same time)
- May 26, 2022 (same time)