

UNITED STATES
PATENT AND TRADEMARK OFFICE





Patent Trial and Appeal Board (PTAB)

Inventor Hour: Episode 30

LiLan Ren, Administrative Patent Judge

Brandon Warner, Administrative Patent Judge

Amee Shah, Administrative Patent Judge

Ryan Flax, Lead Administrative Patent Judge

Janet Gongola, Vice Chief Administrative Patent Judge

Special guest:

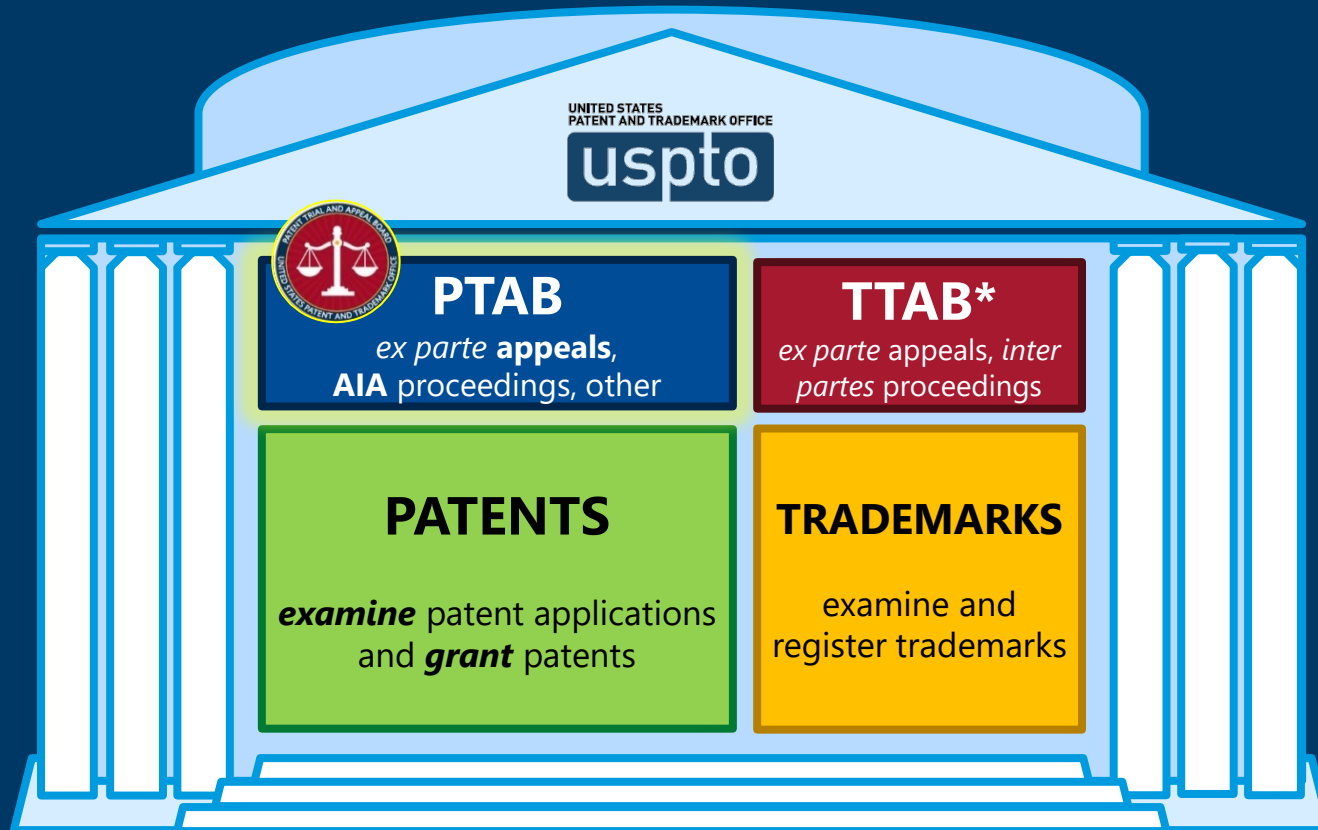
Sean Wilkerson, Innovation Outreach Specialist

July 25, 2024



UNITED STATES
PATENT AND TRADEMARK OFFICE ®

What is the Patent Trial and Appeal Board?



Today's agenda

1

Interview with
Sean Wilkerson

2

Ex parte
appeal byte:
RCE or appeal?

3

Advocacy byte:
Things you
should know

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

Janet Gongola, Vice Chief Administrative Patent Judge



An interview with Sean Wilkerson

Innovation Outreach Specialist



Sean Wilkerson

*Innovation Outreach
Specialist*

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-

USPTO's Inventors Conference • August 16 - 17 • In person/virtual

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PTAB Pro Bono Program



- Under-resourced inventors may receive free legal help from volunteer attorneys for *ex parte* appeals before the PTAB.
- For more details:
 - Watch the recording of the [July 2023 Inventor Hour webinar](#) online; and/or
 - Check out the PTAB Pro Bono Program webpage at www.uspto.gov/ptabprobono.



Brandon Warner, Administrative Patent Judge



***Ex parte* appeal byte:**

File an RCE or *ex parte* appeal after a final rejection?

Final rejection

- After an application is filed, an examiner decides if it meets various requirements.
 - If not, the examiner may issue a **rejection**.
- When the examiner has **twice** rejected the claims or issued a **final** office action, the applicant has choices to make.

After a final rejection

- Several options
 - Before an examiner
 - Interview
 - After final response
 - After Final Consideration Pilot 2.0 (AFCP 2.0)
 - **Request for Continued Examination (RCE)**
 - File a continuation application
 - Abandon the application
 - Before the PTAB
 - ***Ex parte* appeal**

What is a request for continued examination (RCE)?

- After prosecution of an application is closed, an applicant may request continued examination of the application by timely filing a submission and paying a fee.
 - 37 C.F.R §1.114

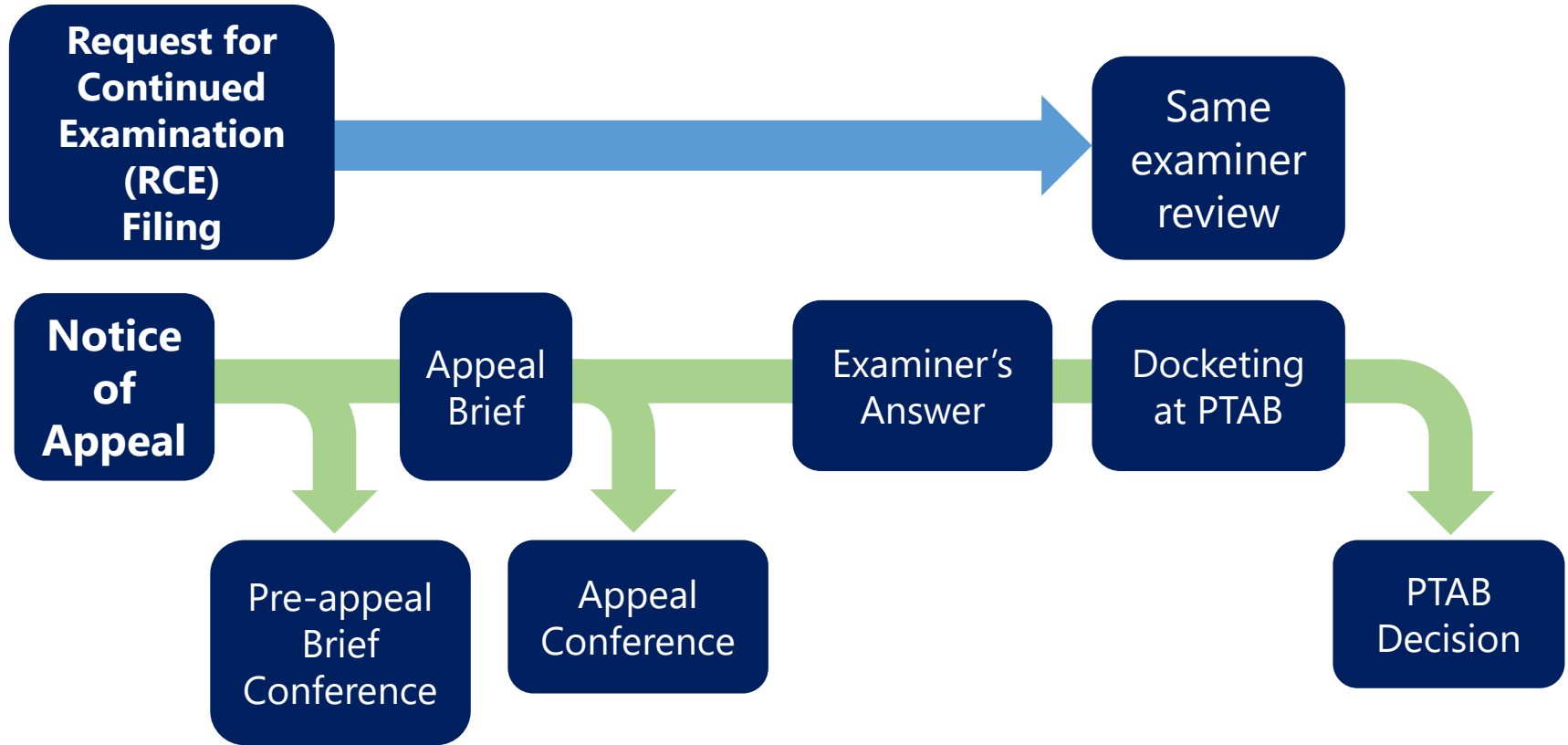
What are *ex parte* appeals?

- After an application has been twice rejected or an examiner has issued a final rejection in the application, an applicant may seek review of the final rejection by three administrative patent judges at the PTAB.

Considerations in selecting an RCE v. an *ex parte* appeal

- Process
- Decision makers
- Timing
- Costs

Steps in review process



Decision makers

- **RCEs: single set of eyes**

- Typically, same examiner continues examination after entry of responsive submission accompanying the RCE.

- **Appeals to PTAB: multiple sets of eyes**

- Additional reviewers:
 - Before arriving at PTAB, a three-examiner conference (including supervisor and examiner of record)
 - After arriving at PTAB, typically decided by three administrative patent judges (APJs)

Timing*

- **RCEs**

- Currently, examiner responds to RCE in about 1.9 months.

- **Appeals to PTAB**

- PTAB issues a decision on appeal, on average, about 12 months after the appeal forwarding fee is paid.
- Fast track appeals available upon request with payment of petition fee.
 - Decision on appeal issued within 6 months of petition (currently averaging 2-3 months).

*Timing reflects amount of time for decision maker to take action



Costs*

RCE

- 1st request: \$1,360
- 2nd and subsequent requests: \$2,000
- Costs to prepare response to final rejection

Appeal to PTAB

- Notice of appeal: \$840
- Appeal forwarding: \$2,360
- Optional Fast-Track Appeals: \$420
- Optional request for oral hearing: \$1,360
- Costs to prepare appeal and reply briefs

*fees shown as undiscounted, large entity cost; small entity is 50% discount; micro entity is 75% discount (except Fast-Track fee)



Question/comment submission

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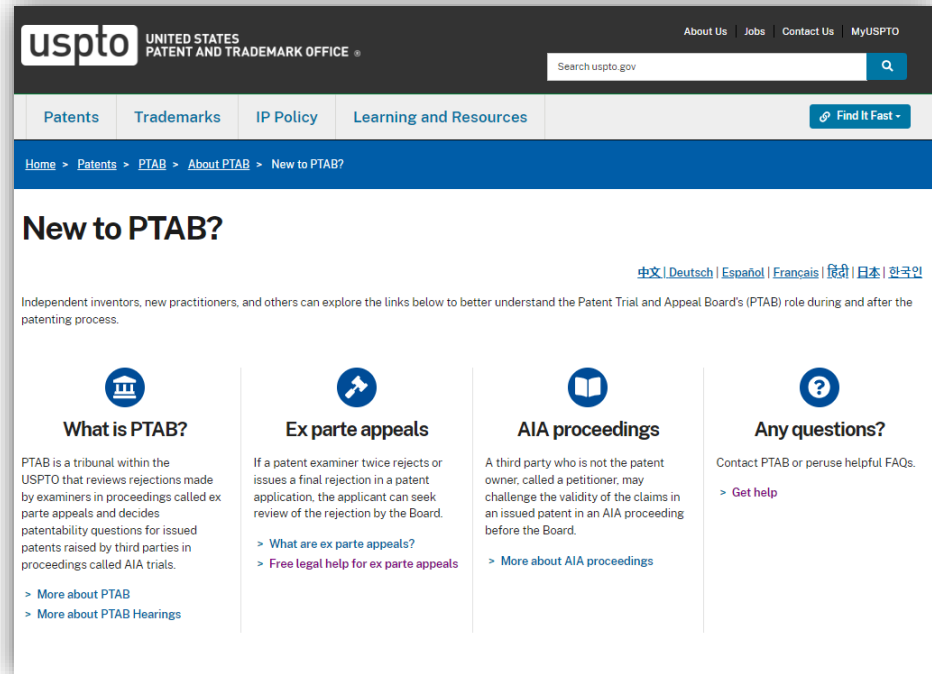
- PTABInventorHour@uspto.gov



New to PTAB webpage



- Contains basic information about:
 - *Ex parte* appeals
 - AIA trial proceedings
- Available in multiple languages.
- www.uspto.gov/patents/patent-trial-and-appeal-board/about-ptab/new-ptab



Ryan Flax, Lead Administrative Patent Judge

Amee Shah, Administrative Patent Judge



Advocacy byte: Things You Should Know

Tip 1: Interpreting claims

The Office applies the **broadest reasonable interpretation** of claim language (consistent with the specification) in considering **pending claims**.

Tip 2: Non-claimed features

Seldom will arguing over features of your invention that are not **recited in the rejected claims** be persuasive. **What matters most is how the language of the claims defines your invention** and how that is novel, non-obvious, and supported by the specification.

Tip 3: Evidence

An examiner's rejection must be supported by **evidence** and cannot be mere conclusions.

Tip 4: More on evidence

You need evidence to support your arguments.

Argument is no substitute for evidence.

Tip 5: Filing evidence

File your evidence during prosecution, before the appeal.

Question/comment submission

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Watch a PTAB hearing



- All PTAB hearings are available for public viewing.
- To request access, either virtual or in-person, submit a request to:
PTABHearings@uspto.gov
at least 3 days before the hearing.
- To view the hearing schedule:
www.uspto.gov/patents/ptab/hearings

July 2024 PTAB Public Hearing Schedule						
Proceeding No.	Serial No.	PARTY	Date	Time	Location	Room
IPR 2023-00634 IPR 2023-00734		MASIMO CORPORATION v. APPLE INC.	Tuesday, July 9, 2024	9:00 AM (EDT)		VIRTUAL
IPR 2023-00554 IPR 2023-00714		CISCO SYSTEMS, INC. v. ORCKIT CORPORATION	Tuesday, July 9, 2024	11:00 AM (EDT)		VIRTUAL
IPR 2023-00624 IPR 2023-00626		COPELAND COMFORT CONTROL LP v. OLLNOVA TECHNOLOGIES LTD.	Tuesday, July 9, 2024	1:00 PM (EDT)	ALEXANDRIA, VA	D
IPR 2023-00656		IRIUSRISK INC. v. THREATMODELER SOFTWARE, INC.	Wednesday, July 10, 2024	1:00 PM (EDT)		VIRTUAL
IPR 2022-01223		APPLE INC. v. SMART MOBILE TECHNOLOGIES LLC	Wednesday, July 10, 2024	1:00 PM (EDT)		VIRTUAL
IPR 2023-00529 IPR 2023-00531		MICROSOFT CORPORATION v. LEMKO CORP.	Thursday, July 11, 2024	1:00 PM (EDT)		VIRTUAL
IPR 2023-00601 IPR 2023-00602		SAMSUNG ELECTRONICS CO., LTD. v. APEX BEAM TECHNOLOGIES LLC	Friday, July 12, 2024	11:00 AM (EDT)		VIRTUAL
IPR 2023-00701 IPR 2023-00621 IPR 2023-00756 IPR 2024-00143 IPR 2024-00145 IPR 2024-00144		SAMSUNG ELECTRONICS CO., LTD. v. DODOTS LICENSING SOLUTIONS LLC	Friday, July 12, 2024	1:00 PM (EDT)		VIRTUAL
IPR 2023-00693		KAHOOT! ASA & KAHOOT! EDU, INC., v. AVIEL D. RUBIN	Friday, July 12, 2024	1:00 PM (EDT)		VIRTUAL
2024-002449	90014901	LIT-US CHISUM 21-A, LLC (PATENT OWNER) et al.	Monday, July 15, 2024	10:00 AM (PDT)		VIRTUAL
IPR 2023-00568 IPR 2023-00153 IPR 2023-00154		LIGHTTRICKS LTD. v. PLOTAGRAPH, INC.	Monday, July 15, 2024	1:00 PM (EDT)		VIRTUAL
IPR 2023-00611 IPR 2023-00613 IPR 2023-00614		QUASAR SCIENCE LLC v. COLT INTERNATIONAL CLOTHING, INC. (d/b/a COLT LED)	Tuesday, July 16, 2024	1:00 PM (EDT)		VIRTUAL

Questions?

Future programs

Inventor Hour, Episode 31

Thursday, Aug. 22, 2024, noon (ET)

Inventor Hour, Episode 32

Thursday, Sept. 26, 2024, noon (ET)



