

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# USPTO administrative tribunal: Patent Trial and Appeal Board

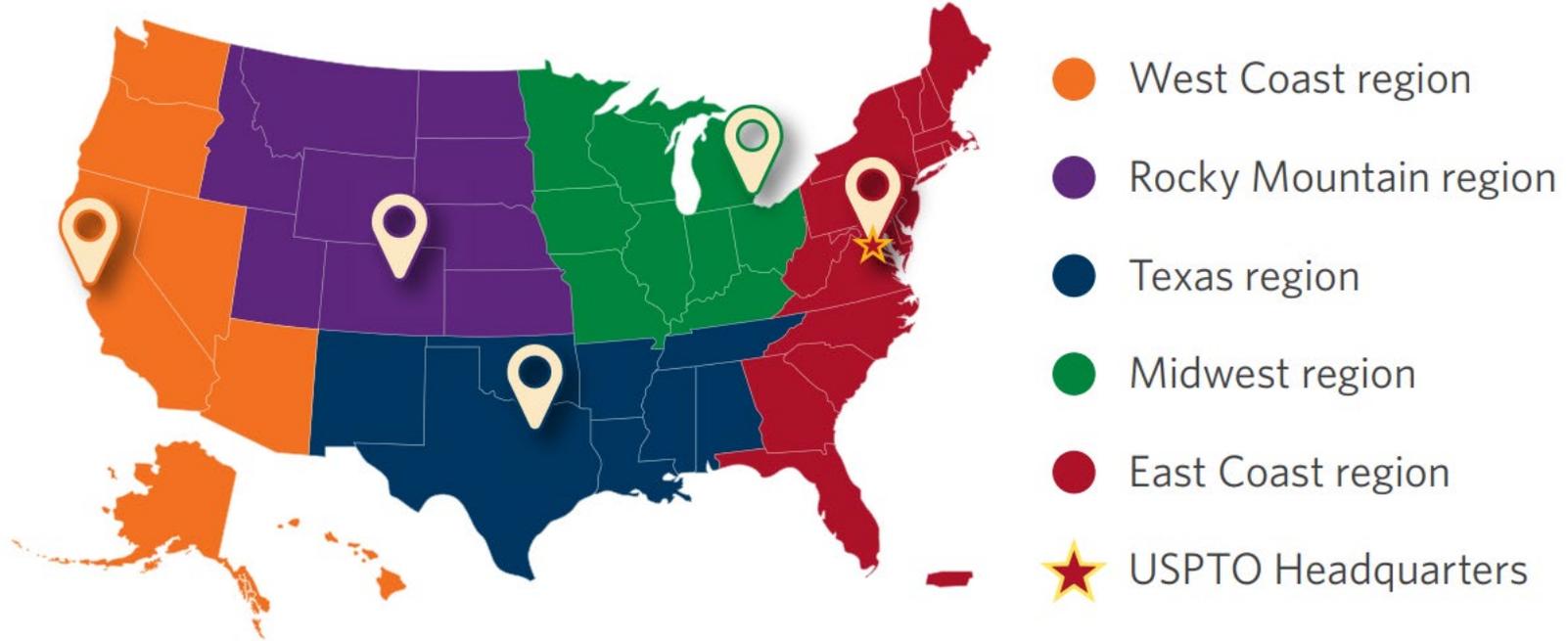
Georgianna Witt Braden, Lead Administrative Patent Judge

February 23, 2023

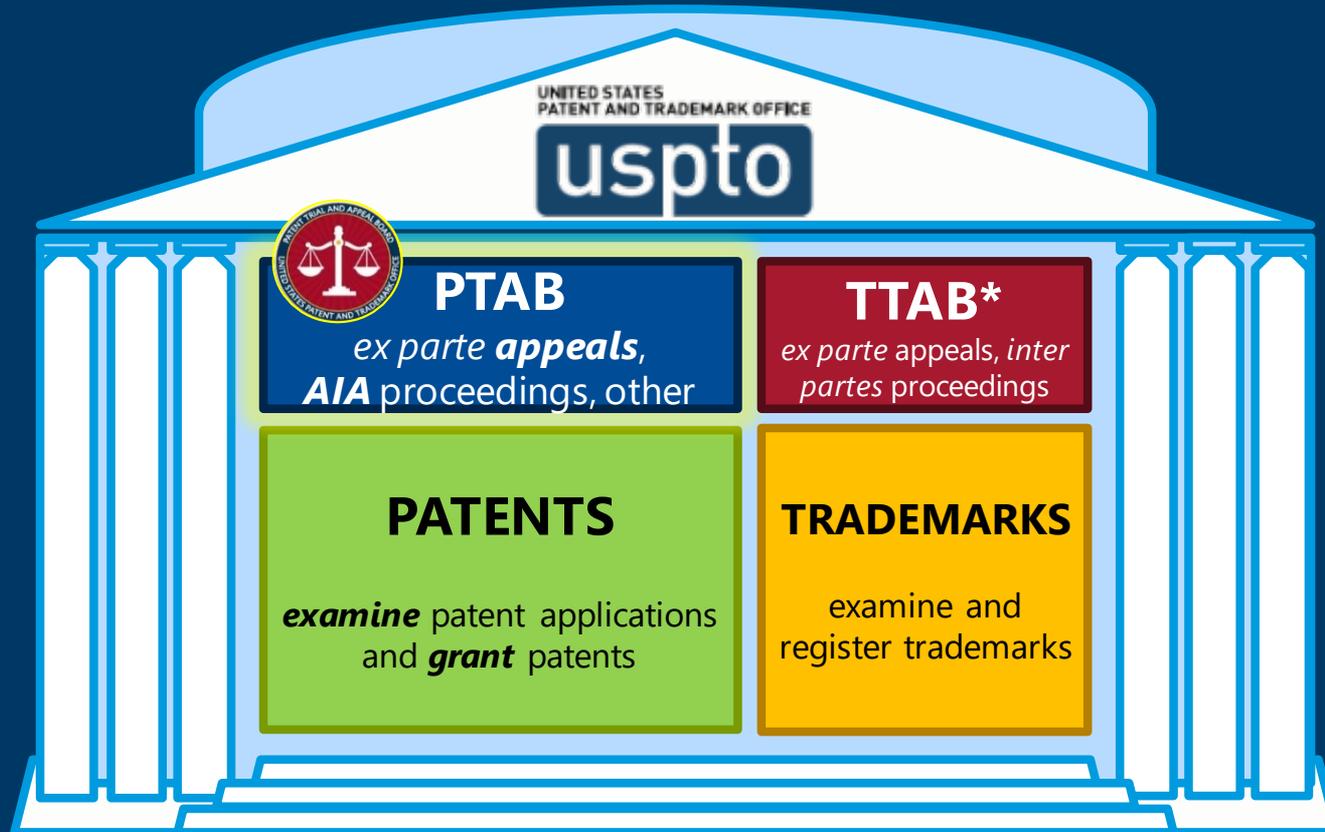


UNITED STATES  
PATENT AND TRADEMARK OFFICE ®

# USPTO offices



# What is the Patent Trial and Appeal Board?



# Administrative tribunals

- Within the USPTO
- An adjudicatory body that
  - reviews agency decisions
  - decides whether claims in issued patents are patentable when challenged by third parties
  - follows binding law and agency policy
- Jurisdiction is limited to questions of patentability



# Patent Trial and Appeal Board

# The Board

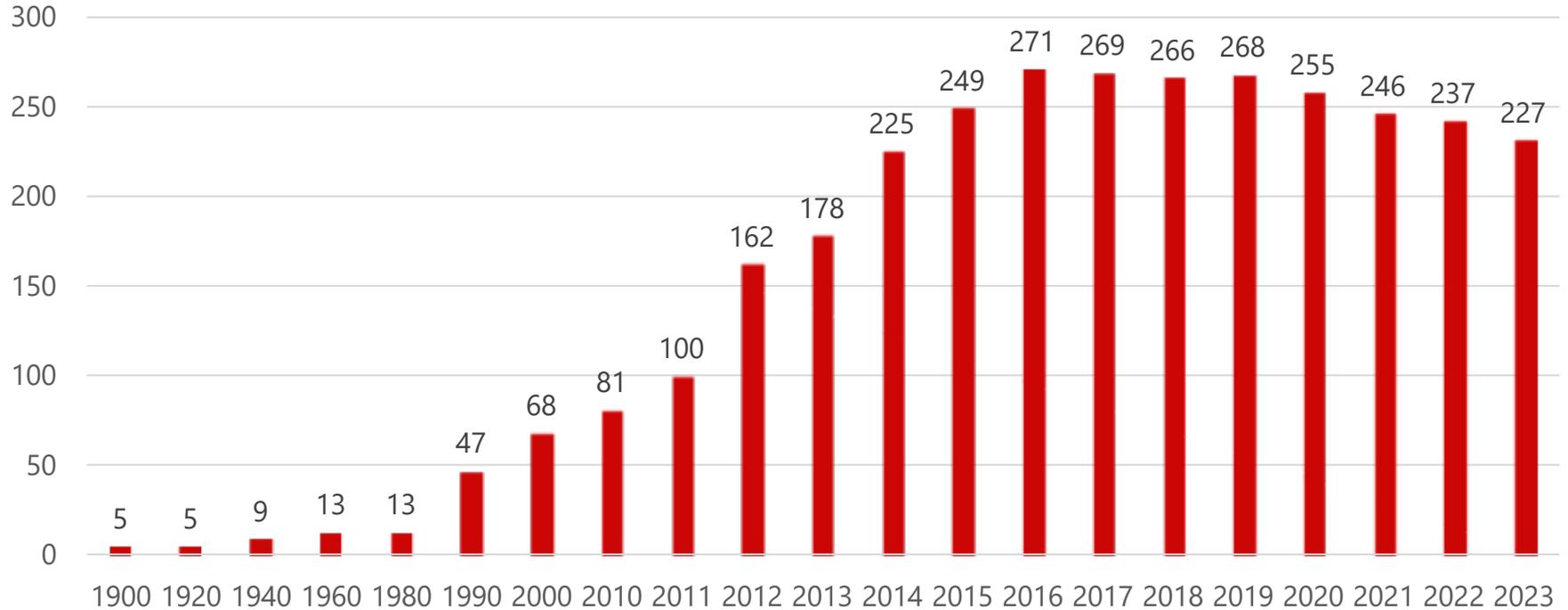
- The Board is created by statute (35 U.S.C. § 6)
  - That statute mandates the Board's:
    - Duties
    - Composition
    - Qualifications for membership
    - Panel form of decision-making (appeals, derivation proceedings, post-grant reviews, and inter partes reviews)
- Original “board of disinterested persons” provided for in Patent Act of 1836
- Patent Act of 1861 formed the permanent Board of Appeals of “persons of competent legal knowledge and scientific ability”
  - President Lincoln appointed George Harding, Esq. of Philadelphia as the first “Examiner-in-Chief”

# The administrative patent judges

- Chief judge (1)
- Deputy chief judge (1)
- Vice chief judges (5)
- Senior lead judges (3)
- Lead judges (30)
- Judges (191)
  - Patent attorneys, law clerks, paralegals, administrators, and support staff assist the judges with their work at the board

# Board size over time

(Calendar year)



# PTAB judges

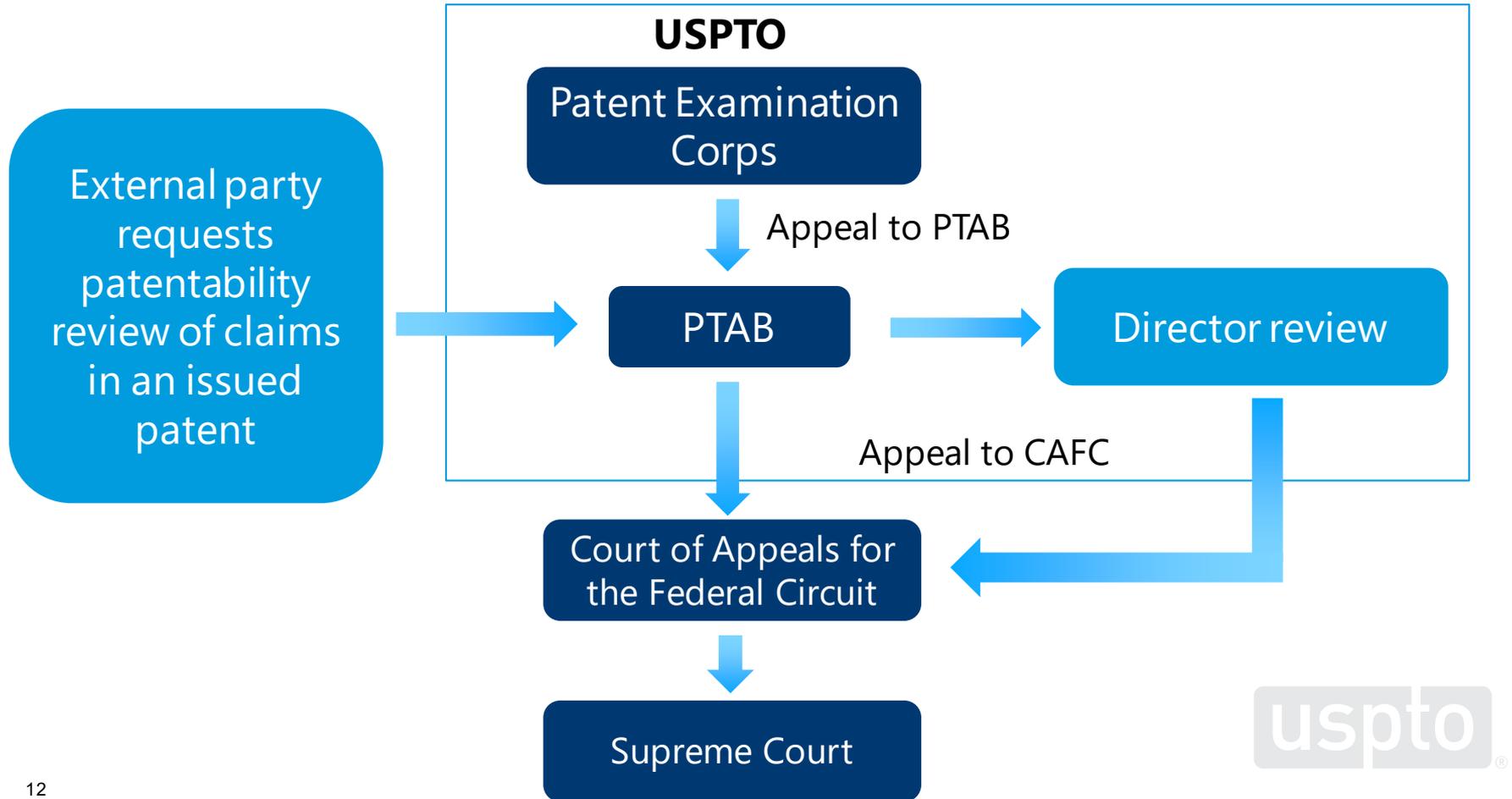
- **Education**
  - Must possess a law degree
  - Must possess a technical degree
- **Professional license**
  - Must be a member in good standing of the legal bar of a state, Washington, D.C., or U.S. territory
- **Experts in patent law**
  - Must have significant, specialized experience in the patent field
  - Must have education and/or work experience in science or engineering

# Types of PTAB proceedings

- Appeals in ex parte patent applications
- Appeals in ex parte and inter partes reexamination proceedings
- Reissues
- Interferences/**Derivations (DER)**
- **Inter partes reviews (IPR)**
- **Post-grant reviews (PGR)**



# The general process



# Case processing at PTAB

- Docket case
  - Transfers jurisdiction from examiner if a case is appealed
- Assign a panel (usually 3 judges), pursuant to SOP1
- Conference between judges
- Oral hearing (if requested)
- Post-hearing conference between judges
- Circulate opinion
- Issue decision
- Rehearing request
- Appeal

# Ex parte appeals

# Patent Examiner

- To serve as advocate/protector of the public interest with respect to intellectual property.
- To provide direct service and assistance to customers from inside and outside the USPTO.
- To evaluate patentability with respect to invention(s) claimed in a patent application under the conditions for patentability set forth in Title 35 of the United States Code.



# Basis for rejection

35 U.S.C. §101

Inventions patentable

35 U.S.C. §112

Specification

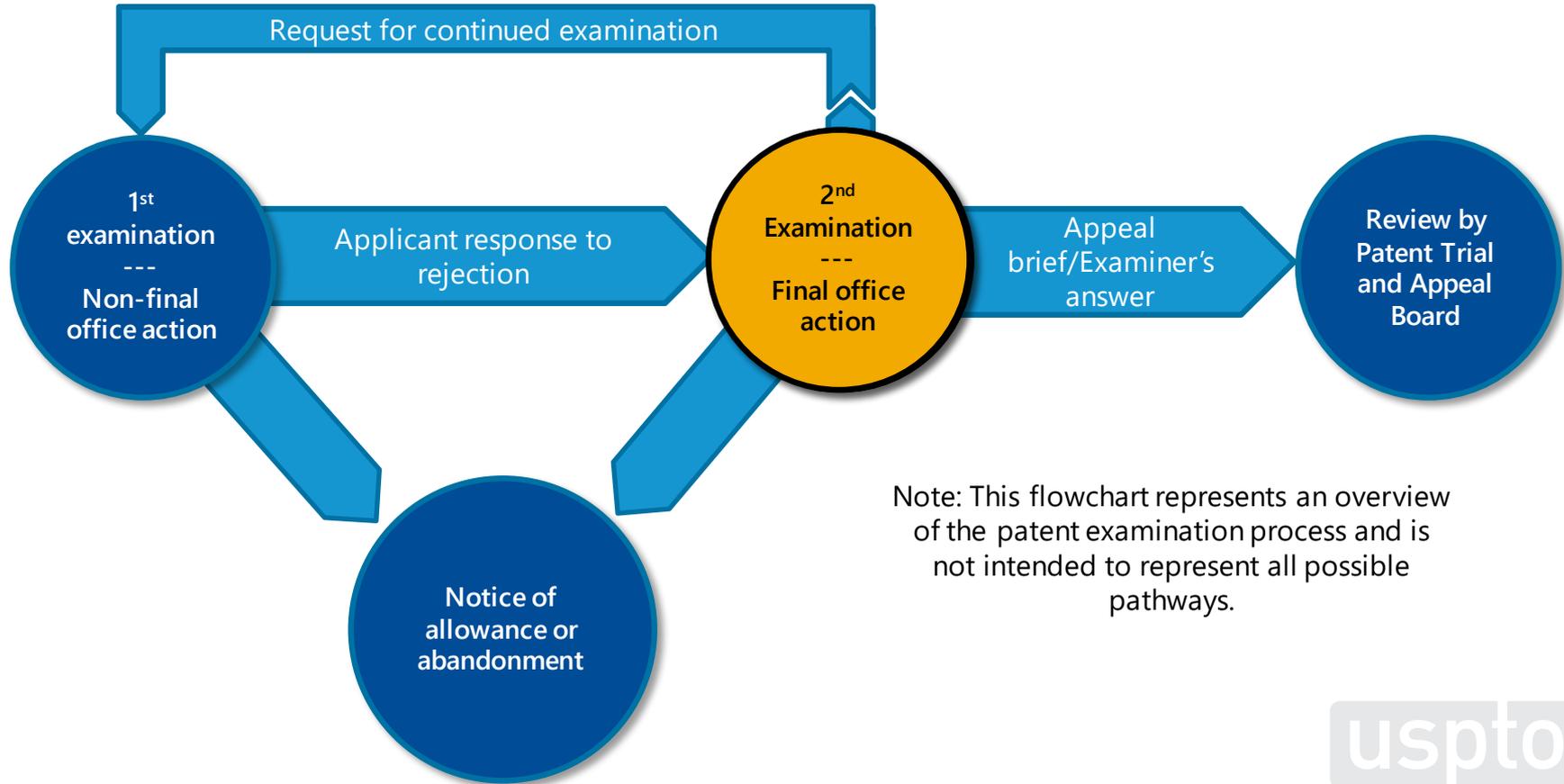
35 U.S.C. §102

Conditions for patentability: novelty

35 U.S.C. §103

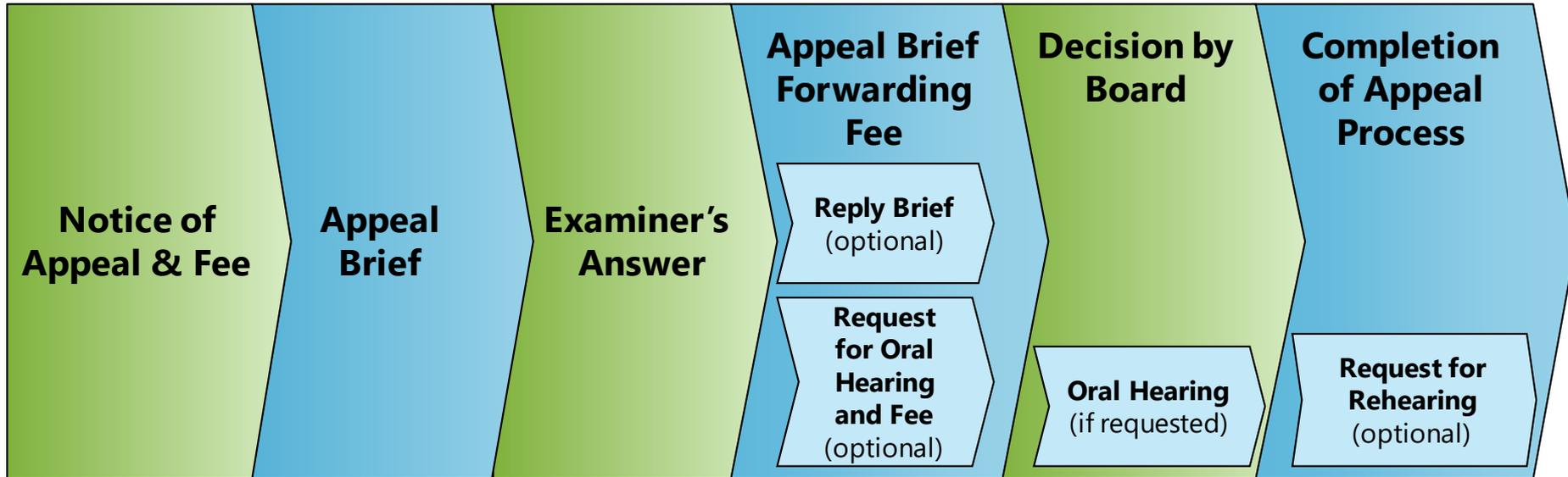
Conditions for patentability: non-obvious subject matter

# Overview of patent examination process



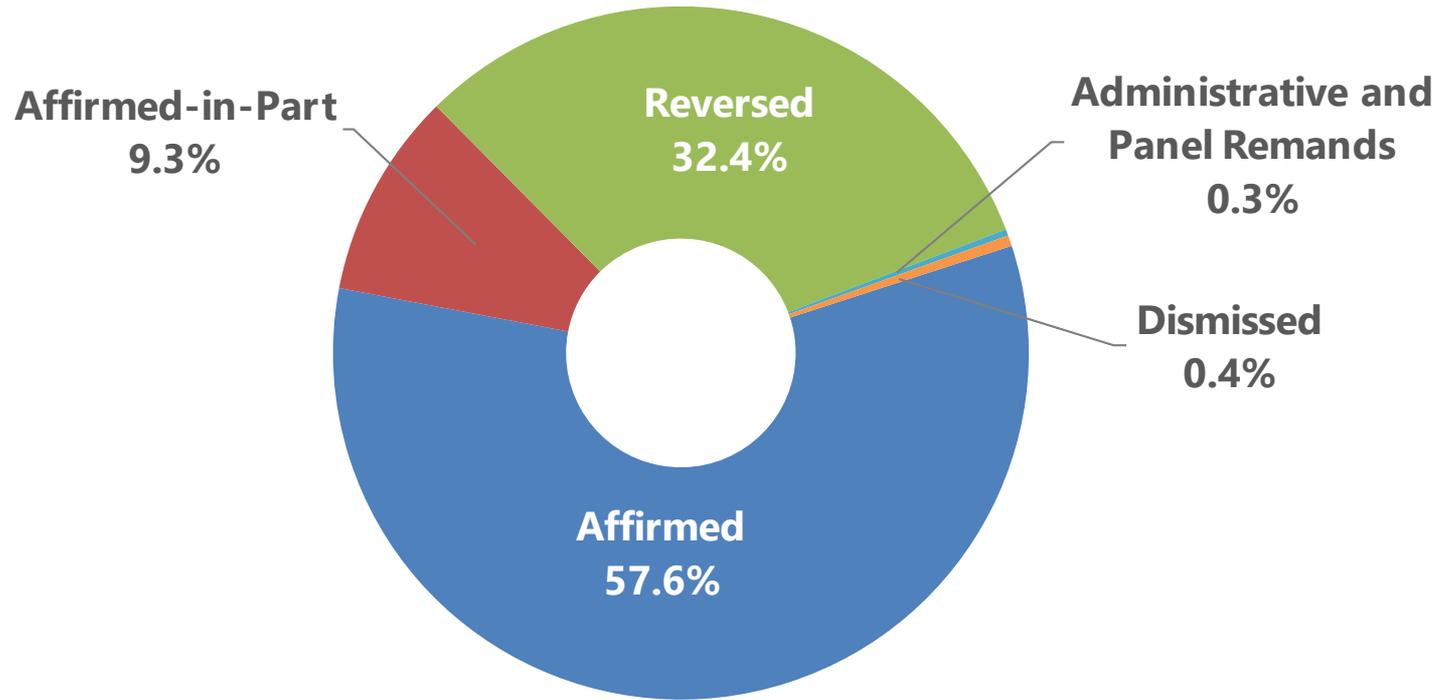
Note: This flowchart represents an overview of the patent examination process and is not intended to represent all possible pathways.

# PTAB Appeals – general process

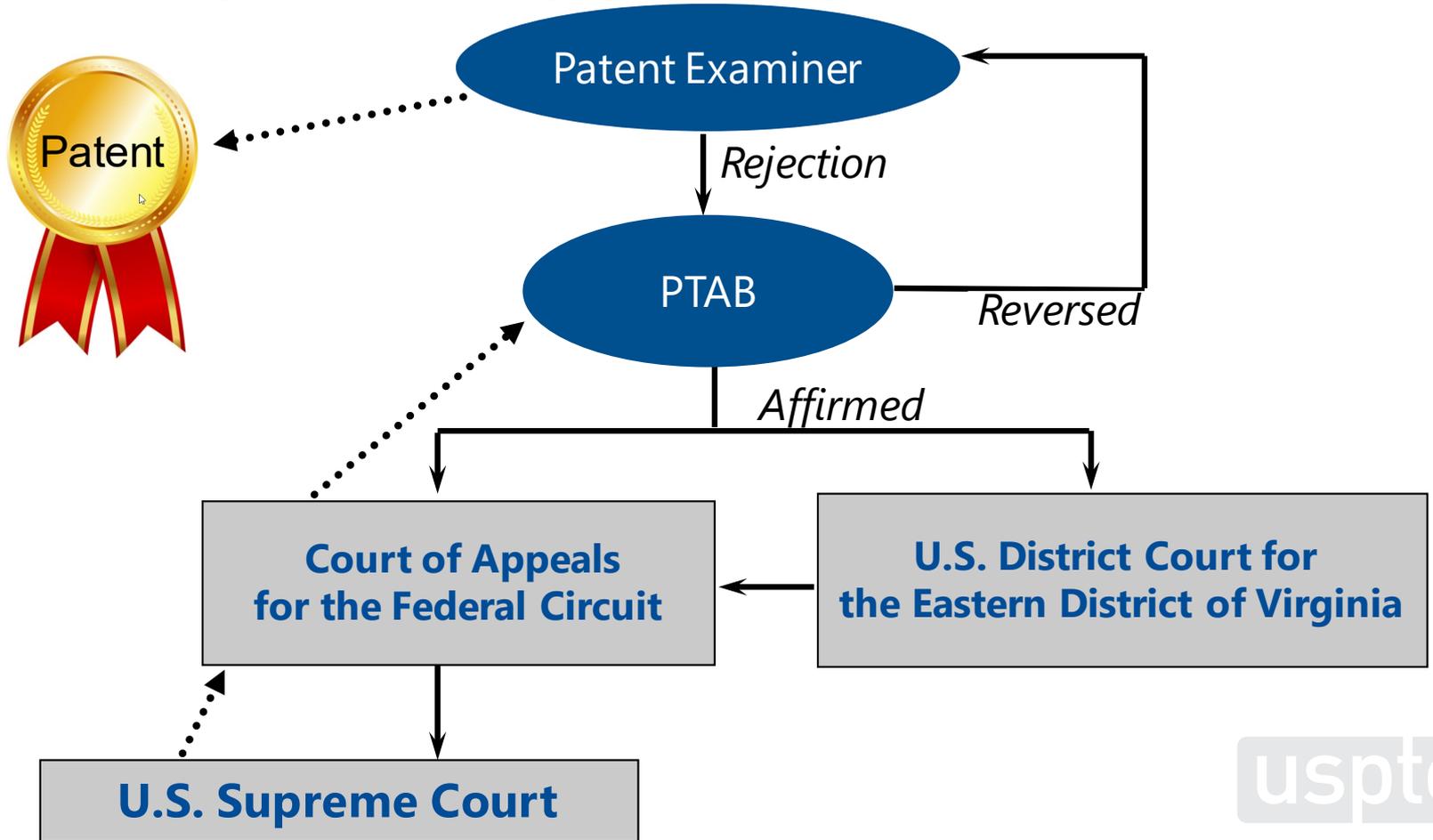


# Appeal outcomes in FY23

(Oct. 1, 2022 - Jun. 30, 2023)



# The *ex parte* appeal process



# Allowance, issue, and after patent grant

## Allowance

- "Allowance" refers to the decision-making aspect of the process.

## Issue

- "Issue" refers to the administrative and procedural aspects of the process.
- An application is ISSUED after a decision to ALLOW the application has been made by the examiner

## After patent grant

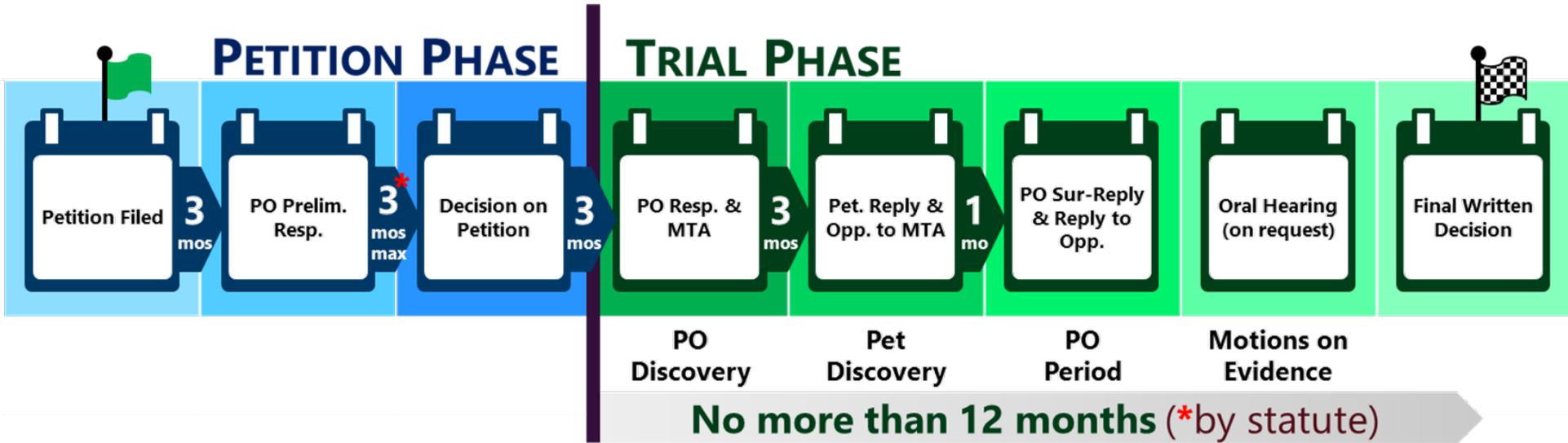
- Maintenance fees for utility patents due 3.5, 7.5, and 11.5 years after patent issue date.
- Correction by way of Certificate of Correction or Reissue.

Fee schedule: <https://www.uspto.gov/learning-and-resources/fees-and-payment/uspto-fee-schedule>



# **AIA trial proceedings**

# Hearings: AIA trials



# Scope of grounds in petition

- **IPR**
  - Only on § 102 and § 103 grounds, and only on basis of prior art consisting of patents and printed publications
- **PGR**
  - On any grounds for invalidity (except best mode)

# Standard for initiating review

- IPR
  - “A reasonable likelihood that the petitioner would prevail” with respect to at least one challenged claim
- PGR
  - “More likely than not that at least one claim is unpatentable” or the petition raises “a novel or unsettled legal question that is important to other patents or applications”



# AIA trial proceedings

- Standard of proof: a “preponderance of evidence”
  - Lower than “clear and convincing evidence” required to prevail in district courts
- Final written decision
  - Issued within 12 months of institution
  - Can extend by 6 months, but only for “good cause”
  - Generally, entire process (petition to termination or final decision) will take 18 months or less



# Potential outcomes in AIA proceedings

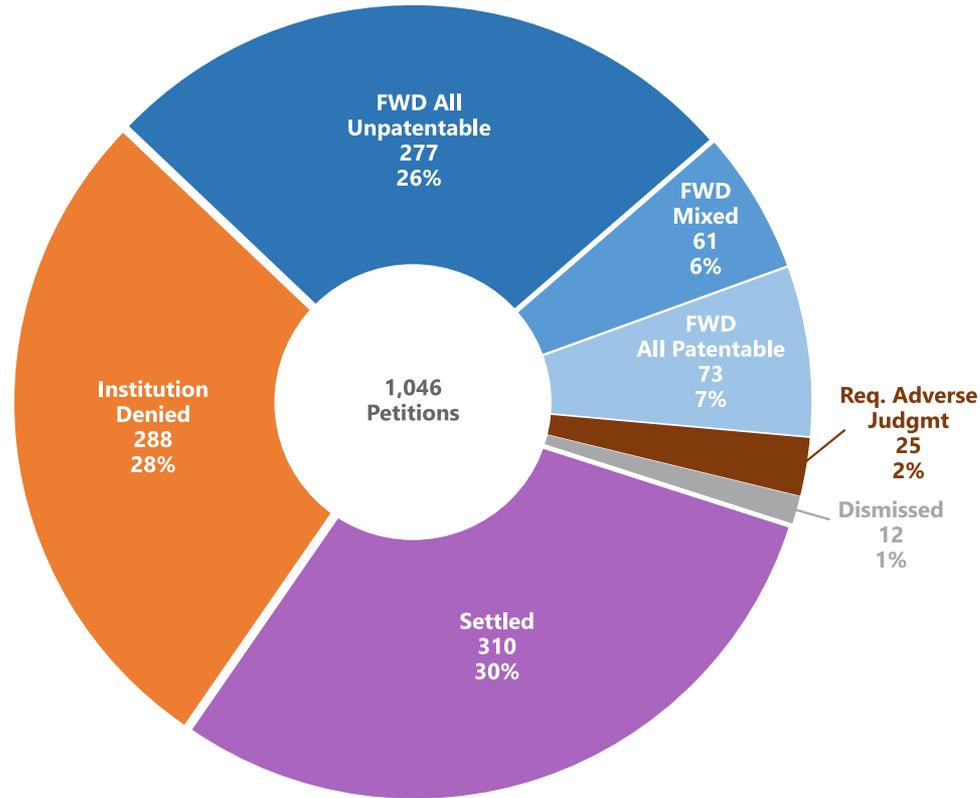
- Deny institution
- Settle
- Dismiss
- Request for Adverse Judgment
- Final Written Decision

# Dispositions in final written decisions

- Find all challenged claims unpatentable
- Mixed outcome
  - Find some challenged claims unpatentable
  - Find some challenged claims patentable (i.e., petitioner did not meet burden to show unpatentable)
- Find all challenged claims patentable

# Outcomes by petition

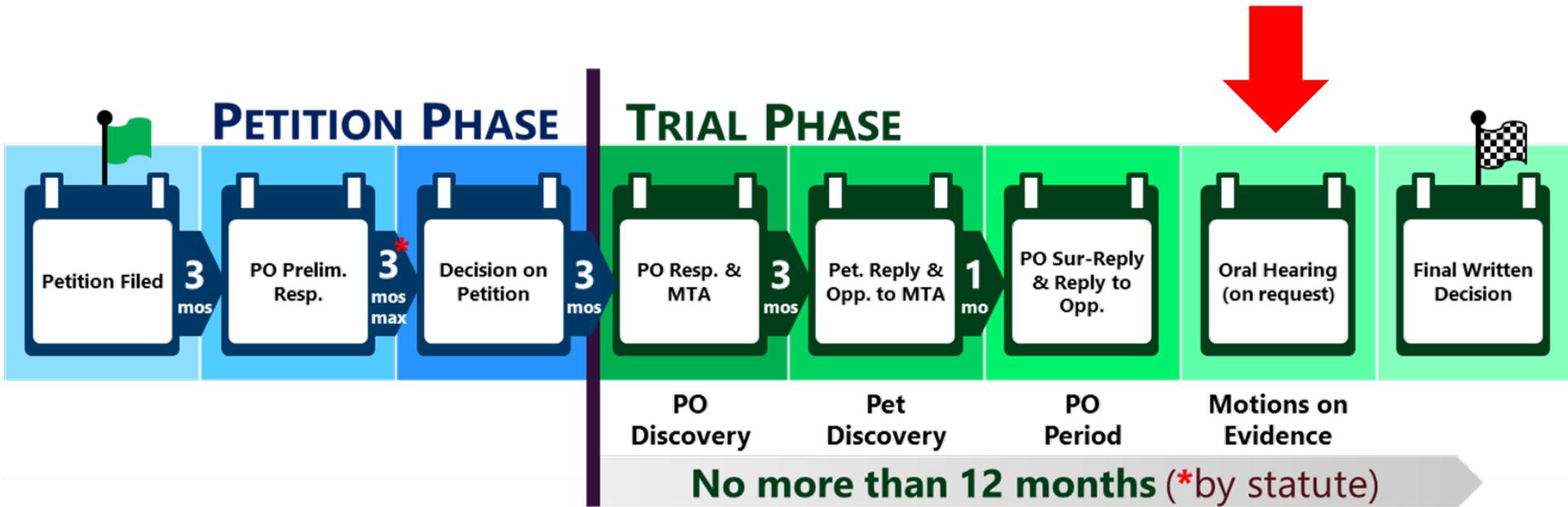
(FY23 through Q3: Oct. 1, 2022 to Jun. 30, 2022)



FWD patentability or unpatentability reported with respect to the claims at issue in the FWD. Joined cases are excluded.

# Hearings before the PTAB

# Hearings: AIA trials



# Purpose of a PTAB hearing

- Hearing is an opportunity to persuade the panel that the existing record supports your position and [answer](#) the judges' questions about the case.
- PTAB hearings differ from district court trials
  - All evidence and argument is already in the record
    - New evidence is not permitted
    - New argument is not permitted

# PTAB judges

- PTAB judges sit in 3-judge panels
- PTAB judges differ from district court judges & juries
  - APJs have legal and scientific training
  - APJs come into the hearing with:
    - knowledge of the technology, background, and prior art
    - knowledge of the evidence and arguments of record
    - unresolved questions regarding dispositive issues
  - APJs are concerned with the record, not with how well you work a courtroom

# Judge pre-hearing preparation

- Before the hearing, judges review the record
- At an internal pre-hearing conference, judges discuss a case to:
  - Crystallize the key issues
  - Walk through the evidence of record
- Judges make no decision on the outcome before the hearing, but will usually have **questions they want answered** and **facts they want confirmed**

# PTAB hearings logistics

- Hearings may be conducted in-person or remotely
- Judges have a copy of the record and demonstratives
  - Refer to specific Demonstratives, Papers, or Exhibits by slide and page number
- Hearing transcript becomes part of the record

# Legal Experience and Advancement Program (LEAP)

- Launched on May 15, 2020
- Goal: to foster the advancement of the next generation of patent practitioners through skills development and oral advocacy opportunities at the PTAB
- Targeting patent agents and attorneys newer to the practice of law or to the PTAB
- LEAP practitioner participation is an option in both ex parte appeals and AIA trials
- <https://www.uspto.gov/patents/ptab/leap>



**PTAB resources**

# New to PTAB

<https://www.uspto.gov/patents/patent-trial-and-appeal-board/about-ptab/new-ptab>

Independent inventors, new practitioners, and others can explore the links below to better understand the Patent Trial and Appeal Board's (PTAB) role during and after the patenting process.



## What is PTAB?

PTAB is a tribunal within the USPTO that reviews rejections made by examiners in proceedings called ex parte appeals and decides patentability questions for issued patents raised by third parties in proceedings called AIA trials.

- > [More about PTAB](#)
- > [More about PTAB Hearings](#)



## Ex parte appeals

If a patent examiner twice rejects or issues a final rejection in a patent application, the applicant can seek review of the rejection by the Board.

- > [What are ex parte appeals?](#)



## AIA proceedings

A third party who is not the patent owner, called a petitioner, may challenge the validity of the claims in an issued patent in an AIA proceeding before the Board.

- > [More about AIA proceedings](#)



## Any questions?

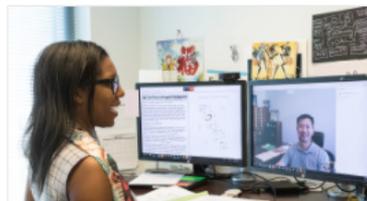
Contact PTAB or peruse helpful FAQs.

- > [Get help](#)



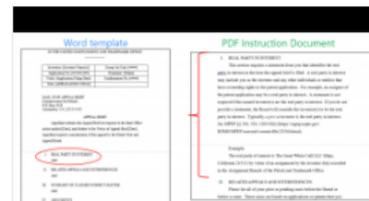
### PTAB BOARDSIDE CHAT WEBINARS

The PTAB Boardside Chat series highlights best practices and answers questions raised by attendees



### TEMPORARY CHANGE

PTAB conducts remote hearings



### EX PARTE APPEAL BRIEF TEMPLATE

Provides help in drafting an ex parte appeal brief for independent inventors and others



# PTAB Boardside Chat webinar series

- Addresses best practices before the Board and answers questions raised by attendees
- Free, bi-monthly webinars are open to all
- Register for an upcoming webinar or see presentations and videos from past webinars:

<https://www.uspto.gov/patents/ptab/ptab-boardside-chats>



# PTAB Pro Bono Program

[www.uspto.gov/ptabprobono](http://www.uspto.gov/ptabprobono)

Financially under-resourced inventors are matched with volunteer patent professionals to obtain free legal assistance in proceedings before the PTAB. Currently open to *ex parte* appeals and later expanding to AIA trials.



## For inventors:

- Eliminate financial barriers for legal assistance
- Aid under-resourced inventors in making effective arguments

## For volunteers:

- Provide legal help in their field of legal practice
- Create new contacts in the community



# PTAB resources

- Information concerning the board:
  - <https://www.uspto.gov/patents/ptab>
- Information concerning appeals:
  - <https://www.uspto.gov/patents/ptab/appeals>
- Information concerning AIA trials:
  - <https://www.uspto.gov/patents/ptab/trials>
- Information concerning PTAB statistics:
  - <https://www.uspto.gov/patents/ptab/statistics>
- Information concerning board decisions:
  - <https://www.uspto.gov/patents/ptab/decisions>





# Thank you!

**Georgianna Witt Braden**

Lead Administrative Patent  
Judge

(571) 272-9797

[www.uspto.gov](http://www.uspto.gov)

# Introduction to the Trademark Trial and Appeal Board (TTAB)

Jyll S. Taylor

Administrative Trademark Judge

Trademark Trial and Appeal Board



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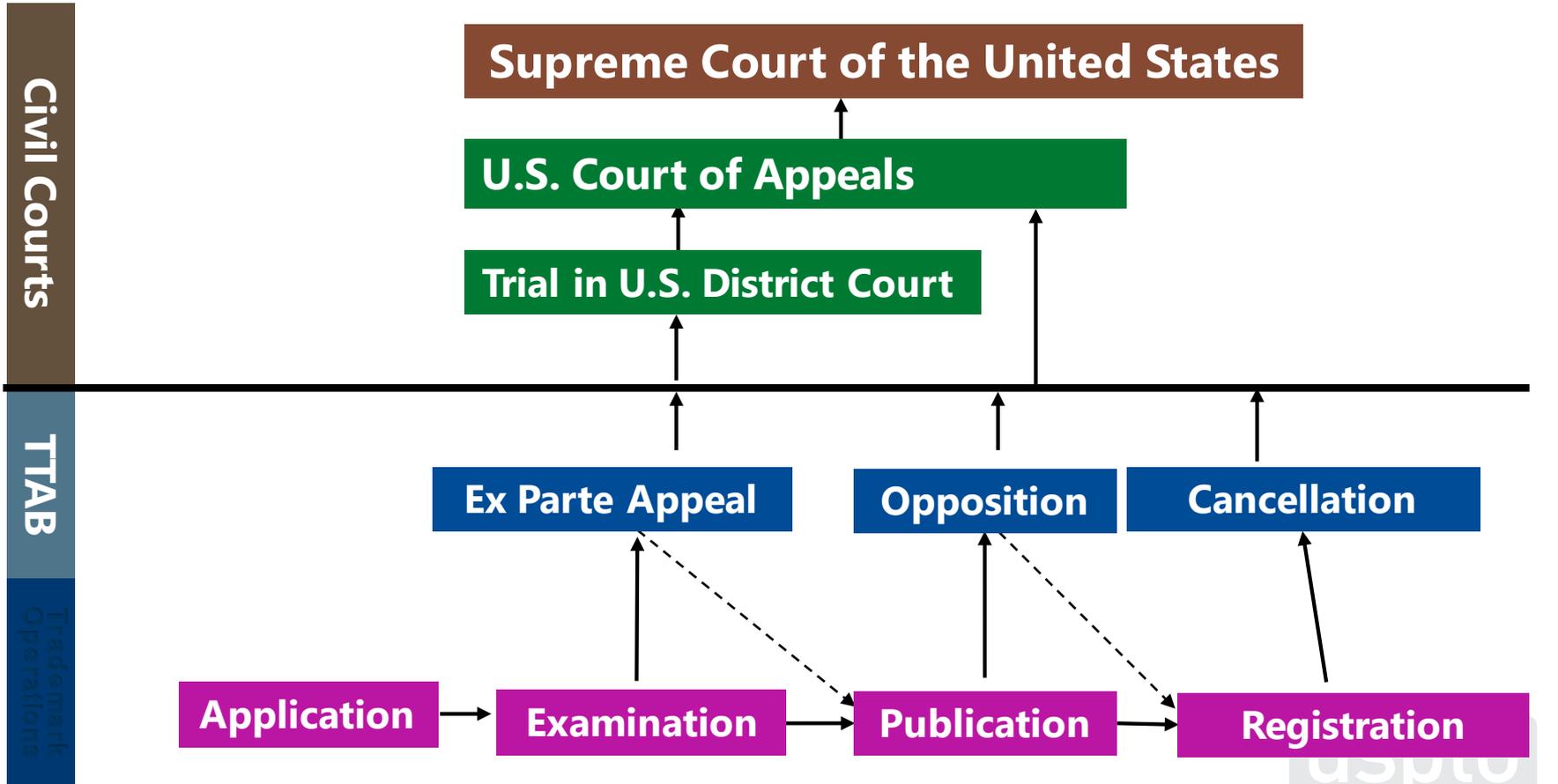
# **General information about TTAB**

# Trademark Trial and Appeal Board

- Established in 1958 to streamline administrative proceedings
- In 1993, the title of the decision makers was changed from “Board members” to “Administrative Trademark Judges”
- The leadership title was changed from “Chairman of the Board” to “Chief Administrative Trademark Judge;” four individuals have held this position
- In 2000, a Managing Interlocutory Attorney position was created; five individuals have held this position
- In 2012, a Senior Level position for the editor of the TTAB Manual of Procedure (TBMP) was established; one individual has held this position
- In 2015, the position of “Deputy Chief Administrative Trademark Judge” was created; two individuals have held this position



# Administrative proceedings



# Types of proceedings

- **Ex parte appeals, applications:** Appeal from a trademark examining attorney's refusal to register
- **Ex parte appeals, registrations:** Appeal from a final Office action in an expungement or reexamination proceeding
- **Oppositions:** Challenge by any party believing it would be damaged by registration of pending application
- **Cancellations:** Challenge by any party believing it would be damaged by existing registration
- **Concurrent use:** Request for a geographically limited registration

# Limited jurisdiction

- Right to registration: TTAB considers only the right to registration, not the right to use
- Related issues: TTAB may not resolve related issues such as contract or licensing disputes
- Limited remedies: TTAB cannot award damages or attorney fees, or issue injunctions, etc.
- BUT administrative proceedings can be faster and less expensive



# Board personnel

- Chief Administrative Trademark Judge
- Deputy Chief Administrative Trademark Judge
- Senior Attorney and TBMP Editor
- Managing Interlocutory Attorney
- Administrative Trademark Judges
- Interlocutory Attorneys
- Chief Clerk
- Lead Paralegal and Paralegals
- Administrative Officer
- Administrative & Technical Staff



# Administrative trademark judges

- **Preside:** At oral hearings
- **Final decisions:** Draft final decisions on merits of appeals, oppositions, cancellations, and concurrent use proceedings
- **Dispositive orders:** Review and approve orders on dispositive or potentially dispositive motions

# Interlocutory attorneys

- **Draft and issue orders on non-dispositive motions**
  - Discovery motions
  - Contested scheduling motions
  - Complicated uncontested motions
- **Draft orders on dispositive motions for approval by judges**
  - Motions for summary judgment
  - Motions for sanctions
  - Motions to dismiss

# Paralegals

- **Draft and issue orders** on consent motions and uncontested motions
  - Extensions of time to oppose
  - Extension or suspension of proceedings
  - Stipulated dispositions
- **Draft orders for interlocutory attorney** signature
- **Draft and issue orders** on appeal cases
- **Docket** management

# Client services

- Information specialists
  - **Answer public inquiries** by telephone and email about TTAB practice and electronic filing
    - 571-272-8500
    - [TTABInfo@uspto.gov](mailto:TTABInfo@uspto.gov)
- Hearing specialist
- Supervisor



# The rest...

- Chief clerk
- Analytics and information technology
- Administrative staff
  - TTAB administrative officer
  - Human capital
  - Budget and contracts
  - Telework, communications and space
  - Visual information

**Ex parte appeals**

# Procedure: Ex parte appeals

- Final refusal to register or second refusal on the same issue
- Must file an appeal within a set period from issuance of the final office action
  - Three months for an application
    - Optional three-month extension may be requested for a fee
    - Six months for a Madrid application (Trademark Act § 66(a))
  - Three months for a registration
    - Optional one-month extension may be requested for a fee
- No new evidence permitted during appeal
- Appellant and examining attorney submit briefs
- Appellant may request oral hearing
  - Participation in person or by video



# Grounds for refusal (1 of 3)

- Trademark Act Section 2
  - § 2(a) Deceptive
    - No longer immoral or scandalous
      - *Iancu v. Brunetti*, 139 S.Ct. 2294, 2019 USPQ2d 232043 (2019)
    - No longer disparaging
      - *Matal v. Tam*, 137 S. Ct. 1744, 122 USPQ2d 1757 (2017)
  - § 2(b) Official insignia
  - § 2(c) Name or likeness of living individual
  - § 2(d) Likely to cause confusion

# Grounds for refusal (2 of 3)

- § 2(e)(1) - Merely descriptive or deceptively misdescriptive; generic
- § 2(e)(2) - Primarily geographically descriptive
- § 2(e)(3) - Primarily geographically deceptively misdescriptive
- § 2(e)(4) - Primarily merely a surname
- § 2(e)(5) - Comprises matter that is functional

# Grounds for refusal (3 of 3)

- § 3 – Applies to service marks
- § 4 – Applies to collective and certification marks
- § 5 – Use by related companies
- § 6 – Disclaimers
- § 23 – Supplemental register

**Inter partes (trial) proceedings**

# Publication for opposition

- Official Gazette – published weekly
- Initial opposition period is 30 days
- Extensions of time to oppose may be granted to a maximum of 180 days from publication
- Fee is per application



# Opposition: Filing

- Registration may be opposed by any party which believes it would be damaged by registration
- Opposer must file a notice of opposition within thirty days of publication or within a granted extension of time to oppose
- Must include the filing fee
- May be based on any ground for refusal of registration



# Cancellation: Filing

Same as opposition but filed after registration

- Within five years of registration – cancellation may be based on any ground for refusal
- After three years of registration – expungement
- After five years – grounds for cancellation limited, including:
  - Genericness
  - Functionality
  - Abandonment
  - Obtained by fraud
  - Likelihood of confusion and descriptiveness are *not* available after five years

# Grounds to oppose/cancel

- Grounds available in appeal and trial cases:
  - Trademark Act §§ 2(a)-(e)
  - § 6 (disclaimers) & § 23 (Supplemental register)
- Additional grounds available in inter partes:
  - Non-use (Trademark Act § 1(a))
  - Lack of bona fide intent to use (Trademark Act § 1(b))
  - Abandonment (Trademark Act § 14(3))
  - Dilution (Trademark Act § 43(c))
  - Fraud (Fed. R. Civ. P. 9)

# Inter partes timeline: Pleadings

- Pleadings define the issues in the case
- **Complaint:** Either a notice of opposition or petition for cancellation
  - Consists of a “short and plain” statement of
    - Entitlement - reasons plaintiff believes it will be damaged by registration
    - Grounds – provide fair notice of the basis for each claim and be plausible
- **Answer: Response to complaint**
  - Affirmative defenses may be asserted
- **Counterclaim: To cancel plaintiff’s pleaded registration(s)**
  - Plaintiff allowed time to answer counterclaim



# Inter partes timeline: Discovery

- **Discovery conference**
  - Topics: Discovery planning, Fed. R. Civ. P. 26(f)
  - Board participation
- **Initial disclosures, Fed. R. Civ. P. 26(a)**
  - Individuals likely to have discoverable information
  - Documents which may be used to support claims or defenses
- **Discovery**
  - Interrogatory requests for written answers
  - Requests for production of documents or things
  - Depositions: Live testimony under oath
  - Requests for admission: requests to admit facts
- **Expert disclosures**

# Inter partes timeline: Trial

- Pre-trial disclosures
- Plaintiff's trial period – 30 days
  - Testimony – by deposition or affidavit
  - Notices of reliance – documentary evidence
    - Discovery materials – Rule 2.120(j)(3)(i)
    - Registrations – Rule 2.122(d)(2)
- Printed publications and official records – Rule 2.122(e)
  - Trademark Rule 2.132 motions
- Defendant's trial period – 30 days
  - Rebuttal period – 15 days
  - Must respond to defendant's evidence

# Inter partes timeline: Briefing

- **Briefs:** Written arguments on law and facts
  - No new evidence
  - Attachments discouraged (and usually ignored)
    - Page limits strictly enforced
  - Cite to evidence by referencing the TTABVUE record
    - **Plaintiff's brief**
      - 55 pages maximum
    - Due 60 days after close of rebuttal testimony
      - **Defendant's brief**
        - 55 pages maximum
      - Due 30 days after due date of plaintiff's brief
        - **Rebuttal brief**
          - 25 pages maximum
    - Due 15 days after due date of defendant's brief



# Inter partes timeline: Oral hearing

- Scheduled only at the request of either party
- Attendance of non-requesting party not required
  - Participation either in person or by video
- Not a formal part of the record; no transcript or recording
  - No new evidence or testimony at hearing

# Inter partes timeline: Decision

- **Decision: The explanation of the Board's judgment**
  - Panel of three administrative judges
  - Requires consideration of all relevant evidence and arguments
  - Findings of fact and conclusions of law
  - A judge who disagrees with the result may write a dissenting opinion
  - A judge who agrees with the result, but not the reasoning of the majority, may write a concurring opinion

# Abbreviated proceedings

- **Motion to dismiss for failure to state a claim**
  - When the facts alleged do not constitute grounds for relief, the proceeding may be dismissed
- **Motion for summary judgment**
  - No genuine dispute of material fact
  - Movant is entitled to win as a matter of law
- **Accelerated Case Resolution (ACR)**
  - Similar to summary judgment, but the Board may determine disputed facts



# Alternative Dispute Resolution

- Negotiation
  - Parties may generally settle on any mutually agreeable terms
- Third-party dispute resolution
  - Arbitration
  - Mediation
- Extension/Suspension: TTAB will suspend proceedings to allow settlement negotiation



# Review of Board decisions

- Judicial review of Board's decision
  - Must be taken within sixty-three days of final decision
- U.S. Court of Appeals for the Federal Circuit
  - Appeal on the administrative record
  - Briefs and oral argument
- United States District Court
  - Administrative record
  - New testimony or evidence allowed
  - De novo review by new trial

# Useful resources

- Trademark Statute and Rules
  - <https://tfsr.uspto.gov/RDMS/TFSR/current>
    - Trademark Act of 1946 (as amended) — 15 USC § 1051, et seq.
    - Rules of Practice in Trademark Cases — 35 CFR § 2.1, et seq.
    - Representation of Others Before the USPTO — 35 CFR Parts 10 & 11
- TTAB precedential decisions — United States Patent Quarterly
- Trademark Manual of Examining Procedure (TMEP)
  - <https://tmep.uspto.gov/RDMS/TMEP/current>
- [Trademark Trial and Appeal Board Manual of Procedure \(TBMP\)](#)
  - <https://tbmp.uspto.gov/RDMS/TBMP/current>
- [TTABVue \(TTAB electronic docketing and case files\)](#)
  - <http://ttabvue.uspto.gov/ttabvue/>
- [TTAB decision summaries at TTAB Reading Room](#)
  - <https://ttab-reading-room.uspto.gov/efoia/efoia-ui/#/search/decisions>
- [Official Gazette of the USPTO](#)
  - [www.uspto.gov/learning-and-resources/official-gazette/trademark-official-gazette-tmog](http://www.uspto.gov/learning-and-resources/official-gazette/trademark-official-gazette-tmog)



# Other USPTO links

- USPTO home page
  - [www.uspto.gov](http://www.uspto.gov)
- Trademark Examining Operations
  - [www.uspto.gov/trademark](http://www.uspto.gov/trademark)
    - Search pending and registered trademarks (TESS)
    - File trademark applications and documents (TEAS)
    - Check status and view trademark files (TSDR)
- Trademark Trial and Appeal Board
  - [www.uspto.gov/ttab](http://www.uspto.gov/ttab)
    - File TTAB documents (ESTTA)
    - View TTAB dockets and files (TTABVUE)
    - Statute and Rules
    - TTAB Manual (TBMP)



