Patent Trial and Appeal Board
Inventor Hour: Episode 23

Ulrike Jenks, Administrative Patent Judge
Eric Jeschke, Administrative Patent Judge
John Schneider, Administrative Patent Judge

Special guests:
  Chanceity Robinson, Primary Patent Examiner, Technology Center 1700
  Joel Attey, Primary Patent Examiner, Technology Center 3700
  Joshua Benitez, Council for Inclusive Innovation (CI²)

October 26, 2023
What is the Patent Trial and Appeal Board?

PTAB: ex parte appeals, AIA proceedings, other

PATENTS: examine patent applications and grant patents

TTAB*: ex parte appeals, inter partes proceedings

TRADEMARKS: examine and register trademarks

*Trademark Trial and Appeal Board (TTAB)
Today’s agenda

1. A day in the life: patent examiners
2. First-Time Filer Pilot Program
3. Trial byte: Motions in AIA trials
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
Meet USPTO professionals
 Chanceity Robinson, Technology Center 1700
   Joel Attey, Technology Center 3700

Ulrike Jenks, Administrative Patent Judge
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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
Pilot program:
First-Time Filer Expedited Examination

Joshua Benítez, Council for Inclusive Innovation (CI²)
Joshua Benítez
Executive Secretary & Program Coordinator
Council for Inclusive Innovation (CI²)

Expand innovation in the United States:
• Tapping into the strength of our nation’s diversity
• Increasing opportunities for all Americans to participate in innovation

For more information visit: https://www.uspto.gov/ExpandingInnovation
First-Time Filer Expedited Examination pilot program

- **Increase accessibility** to the patent system for inventors who are
  - new to the patent application process
  - including those in **historically underserved** geographic and economic areas.

- **Expedites** the first office action for participants

- Up to **1,000** qualifying applications until **March 11, 2024**
  - Subject to USPTO discretion to end the pilot program sooner
What can this pilot program do for you?

• **Reduce time** to receive first office action on the merits

• Give an **early indication** of whether the invention is patentable

• Potentially get a patent and onto the market **faster**
You may be eligible if you have:

- Filed a **utility nonprovisional** patent application meeting certain guidelines

- **Not** been **named** as an inventor on any other nonprovisional application

- Filed your application electronically using **Patent Center** (in DOCX format)

Cont’d on next page
You may be eligible if you have (cont’d):

• **Completed** your application when filing for program

• Qualified for special status based on **income** (https://www.uspto.gov/PatentMicroentity), and

• Received **reasonable training** in the basics of patent application process
  
  – USPTO training resources for meeting requirement at https://www.uspto.gov/FirstTimePatentFiler.
  
  – Additional USPTO support/resources for inventors & entrepreneurs at https://www.uspto.gov/CES.
Information and questions

• For **more information:**

• Frequently asked **questions:**

• **Contact us:**
  – Office of Patent Legal Administration
  – 571-272-7704
  – CI2FirstTimeFilerPilot@uspto.gov.
Question/comment submission

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USPTO “Path to a Patent” series

This series covers everything from intellectual property basics, to patent searching, to what you’ll need to draft and submit your patent application.

More information: https://uspto.gov/about-us/events/path-patent
Motions in AIA Trials

Eric Jeschke, Administrative Patent Judge

Trial byte:
Motions in AIA Trials
Agenda

- Definition
- General guidance
- Common types
motion ('mō-shən)

an application

made to a court or judge

to obtain an order, ruling, or direction

https://www.merriam-webster.com/dictionary/motion
General guidance

- Requesting authorization
- Burden of proof
- Content
- Page limits
- Timing
- Resources
Requesting authorization (if required)

Email requirement for conference call
* Copy all parties
* Generally indicate relief requested
* No arguments / attachments
* Times when all parties available
* Address meet & confer request & state any opposition

Conference call with panel

File motion (if authorized)
Burden of proof to establish entitlement to requested relief is on moving party: 37 C.F.R. § 42.20(c)
Content

Motion
* Relief requested
* Reason for request
* Significance of evidence, material facts, law
* Required showing for particular type of motion

Opposition
* Requirements for motions
* Disputed material facts

Reply
* Directed only to corresponding opposition
Page limits

Motions - **15 pages** unless advance waiver
Oppositions - same as corresponding motion
Replies - **5 pages**

Board may set other page constraints

Page limits:

- **Include** any statement of material facts to be admitted or denied
- **Exclude** table of contents, certificate of service, appendix of exhibits
Timing

Set in scheduling order

- Patent owner motion to amend (and opposition/reply)
- Revised motion to amend (if filed)
- Motion(s) to exclude evidence (and opposition/reply)

Opposition default – 1 month

Typically set much shorter

Board can deny relief not promptly sought: § 42.25(b)
Resources


Common motions in AIA proceedings

- Pro hac vice
- For additional discovery
- To seal
- To terminate
Pro hac vice motion
37 C.F.R. § 42.10

<table>
<thead>
<tr>
<th>Why</th>
<th>• Allow non-PTO-registered attorney to appear for specific proceeding</th>
</tr>
</thead>
<tbody>
<tr>
<td>How authorized</td>
<td>• In notice of filing date</td>
</tr>
<tr>
<td>When</td>
<td>• No sooner than 21 days after service of petition</td>
</tr>
<tr>
<td></td>
<td>• Opposition w/in 1 week</td>
</tr>
<tr>
<td></td>
<td>• No reply unless Board authorizes</td>
</tr>
</tbody>
</table>
Pro hac vice motion
37 C.F.R. § 42.10

What
• Must show:
  – Legal & technical qualifications
  – Established familiarity with subject matter
  – Party intent to be represented
• Affidavit of counsel seeking admission

Misc.
• Eligible only as backup counsel
• May not withdraw without Board authorization
### Motion to seal

#### 37 C.F.R. §§ 42.14, 42.54

<table>
<thead>
<tr>
<th>Why</th>
<th>To keep confidential your (or a third party’s) information</th>
</tr>
</thead>
<tbody>
<tr>
<td>How authorized</td>
<td>Authorization to file not required</td>
</tr>
<tr>
<td>When</td>
<td>Concurrent with filing of document or thing to be sealed</td>
</tr>
</tbody>
</table>
Motion to seal
37 C.F.R. §§ 42.14, 42.54

**What**
- Explanation *why* info is confidential
- Proposed *protective order* (if one not yet entered)
  - Entry of PO (even Board’s default PO) not automatic -- must request
  - Show difference from default order
- Certification of *good faith attempt to confer* with opposing party

**Misc.**
- Standard = *good cause*
- Public policy to make information available
- Consider *redaction*
- Move to *expunge* confidential info after final judgement if appropriate (37 C.F.R. § 42.56)
Motion for additional discovery
37 C.F.R. § 42.51

Why
- Obtain more information in opposing party’s possession to support your case

How authorized
- By request to panel

When
- Should be timely made after need for additional discovery arises
- AIA trials do not have a formal “discovery deadline” like many district courts, but do have statutory deadlines
Motion for additional discovery
37 C.F.R. § 42.51

What

• IPR = Interest of Justice
  – Garmin factors
    ▪ More than possibility/mere allegation?
    ▪ About other party’s litigation positions/underlying basis?
    ▪ Other means to get equivalent info?
    ▪ Instructions for response easily understandable?
    ▪ Overly burdensome?
• PGR = good cause

Misc.

• Very fact specific issues
• Parties may agree to additional discovery between themselves
Motion to terminate
37 C.F.R. §§ 42.72, 42.73

Why
• To seek termination
  – Of a party
  – Of the proceeding

How authorized
• By request to panel

When
• Examples:
  – Judgment against self (any time during proceeding)
  – After parties settle
  – Where an earlier final written decision creates estoppel that prevents petitioner, real party in interest or privy of the petitioner, from maintaining a proceeding
Motion to terminate
37 C.F.R. §§ 42.72, 42.73

What

• A party may request adverse judgment against itself. Actions interpreted as adverse judgment can include:
  – Disclaimer of patent, claim cancellation, concession of unpatentability, abandonment of contest
• Settlement:
  – Can settle any issue via joint request
  – All agreement/understandings in writing & filed with Board
    ▪ May treat as business confidential – request to keep separate
    ▪ Board not a party

Misc.

• Board may proceed to FWD (even if no petitioner remains)
• Estoppel
  – Ground raised or reasonably could have been raised
# Common motions: Summary

<table>
<thead>
<tr>
<th>Motion</th>
<th>Authorization Required</th>
<th>37 CFR §</th>
<th>Consolidated Trial Practice Guide page</th>
</tr>
</thead>
<tbody>
<tr>
<td>Pro Hac Vice</td>
<td>Yes – in notice of filing date</td>
<td>42.10</td>
<td>11</td>
</tr>
<tr>
<td>To seal</td>
<td>No</td>
<td>42.14; 42.54-55</td>
<td>19</td>
</tr>
<tr>
<td>For additional Discovery</td>
<td>Yes</td>
<td>42.51</td>
<td>4, 6-7, 22-34, 92, 100</td>
</tr>
<tr>
<td>To terminate</td>
<td>Yes</td>
<td>42.72; 42.73</td>
<td>4, 53, 86</td>
</tr>
</tbody>
</table>

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Question/comment submission

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PTAB statistics

More information: https://www.uspto.gov/patents/ptab/statistics
THANK YOU!
Inventor Hour will return
Thursday Jan. 25, 2024, noon (ET)

See you in the new year!