Patent Trial and Appeal Board
Inventor Hour Webinar: Episode 10

Ryan Flax, Lead Administrative Patent Judge, PTAB
Robert Silverman, Administrative Patent Judge, PTAB
Lynne Browne, Administrative Patent Judge, PTAB

Jeffrey Fredman, Administrative Patent Judge, PTAB
Brandon Warner, Administrative Patent Judge, PTAB
Stephen Key, Inventor, inventRight, LLC

July 28, 2022
Refresher: What is the Patent Trial and Appeal Board (PTAB or the Board)?

**PTAB**
- *ex parte appeals*
- *AIA proceedings, other*

**PATENTS**
- *examine* patent applications
- *grant* patents

**TTAB***
- *ex parte appeals, inter partes proceedings*

**TRADEMARKS**
- examine and register trademarks

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

1. Meet an Inventor
2. Appeal Byte: What is Prior Art
3. Hearing Byte: How Judges Prepare
4. Trial Byte: Patent Owner Response
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 an Inventor:
Stephen Key, inventRight, LLC.

Brandon Warner, Administrative Patent Judge
Appeal Byte:
What is Prior Art

Robert Silverman, Administrative Patent Judge
Role of prior art in evaluating patent rights

**Anticipation**: Single item of prior art describes what is claimed (35 U.S.C. §102).

**Obviousness**: Claimed invention would have been obvious to a person of ordinary skill in the field, in view of one or more items of prior art (35 U.S.C. §103).
Categories of prior art

- Patent or published application
- Printed publication
- Public use
- On sale
- Otherwise available to the public
Timing of prior art

Disclosure A  One year before filing  Disclosure B  Application filed
Timing of prior art

Disclosure A
One year before filing

Disclosure B

Disclosure C (Inventor)

Application filed
Printed publications

ASTRONOMY. W. H. WRIGHT

This research has been supported by a grant of three hundred dollars from the Warren Fund of the American Academy of Arts and Sciences, and for this aid we wish to express our indebtedness.

1 Cambridge University Press.
5 Rend. Circ. Mat. Palermo, 27, 169-302 (1915); these Proceedings, 1, 65 (1882).

OUTLINES OF A PROPOSED SYSTEM OF CLASSIFICATION OF THE NEBULAE BY MEANS OF THEIR SPECTRA

By W. L. Wright

Lick Observatory, University of California

Published in the American Journal, October 22, 1915

This paper may properly be considered a continuation of one previously published in these Proceedings, 1, 206 (1885). In that article the opinion is expressed that the behavior of the Sir 660A might serve as the basis of a classification of the nebulae. The notion will be discussed here in greater detail. About eleven of the planetary nebulae have been studied with a fair degree of completeness, and while this number is too small to afford the most secure basis for broad generalizations, the observations seem to point the way to a rational system of classification of these objects on the basis of their spectra.

In figure 1 are reproduced the spectra of nine planetary nebulae and the great nebula in Orion. As stated in the earlier paper the method adopted for observing the spectra of such nebulae consists in placing the slit of the spectroscope directly across the image. In this way the length of a spectral line is made to furnish a measure of the extent of the occurrence of the emitting material in the nebula.

The first spectrum shown is that of N. G. C. 7027. This nebula consists of two nuclei, of unequal brightness, surrounded by fainter nebulosity. In photographing the spectrum the slit was placed in the line of the two nuclei. The spectrum shows the nebula to be unusually homogeneous. Some of the latter lines appear to be short but that is probably merely the result of their faintness, as they are no shorter than the

* This and the following paper contain, in abbreviated form, the substance of one read before the eighteenth (Pacific Coast) meeting of the American Astronomical Society, under the title "The spectra of the planetary nebulae and some points of correspondence between them and other celestial objects."
Theses

*In re Hall*, 781 F.2d 897 (Fed. Cir. 1986).

*In re Bayer*, 568 F.2d 1357 (CCPA 1978).
Online publications

Look at the CGI environment variable HTTP—REFERER. In Perl, you can do something like this:

```perl
#!/usr/local/bin/perl

$referer = $ENV{'HTTP_REFERER'};
print "Content-type: text/plain\n\n";
if ($referer =~ /abc\..html/){
print "A link in abc.html called this document.\n\n";
}elsif ($referer =~ /efg\..html/){
print "A link in efg.html called this document.\n\n";
}else{
print "A link in \$referer, called this document.\n\n";
}
exit(0);
```

*Suffolk Techs., LLC v. AOL Inc.,* 752 F.3d 1358 (Fed. Cir. 2014).

Conference presentations

In re Klopfenstein, 380 F.3d 1345 (Fed. Cir. 2004).
Protected information

Do not share

In re Klopfenstein, 380 F.3d 1345 (Fed. Cir. 2004).
Sales catalog

GoPro, Inc. v. Contour IP Holding LLC, 908 F.3d 690 (Fed. Cir. 2018).
Is it a prior art “printed publication”?

Scenario 1

- Product Manual on CD ROM
- Distributed to the 586 individual Purchasers
- Product was advertised widely to persons in the technical field
- Expensive ($25,000)
- No confidentiality restrictions on copying/distribution “for non-commercial use”
Is it a prior art “printed publication”?  
Scenario 1

- **Yes**, Product Manual is a “printed publication.”
- “Public accessibility is not limited to circumstances of free or academic distributions; ‘commercial distribution can qualify.”

*Centripetal Networks, Inc. v. Cisco Systems, Inc.*, 847 F. App’x 869 (Fed. Cir. 2021)
Is it a prior art “printed publication”? Scenario 2

- Technical Report on university department website
- Indexed by Author Name and Year of posting
- Not searchable
Is it a prior art “printed publication”? 
Scenario 2

• *No*, the Technical Report is *not* a “printed publication”

• The Technical Report was “not meaningfully” indexed such that an interested artisan exercising reasonable diligence would have found it.

*Acceleration Bay, LLC v. Activision Blizzard Inc.*, 908 F.3d 765 (Fed. Cir. 2018)
Is it a prior art “printed publication”?  
Scenario 3

- Product Catalog provided at a dental product trade show
- Seeking distributors for the product
- Between 200-500 copies made available
- Provided to attendees, without indication of confidentiality obligations
Is it a prior art “printed publication”?  

Scenario 3

- **Yes**, the Product Catalog is a “printed publication.”

- “[T]he [Product] Catalog is the type of document intended for public dissemination, and it bears no designations, such as ‘draft’ or ‘confidential,’ that might suggest that it was not intended for public distribution.”

**Nobel Biocare Servs. AG v. Instradent USA, Inc., 903 F.3d 1365 (Fed. Cir. 2018)**
Question/comment submission

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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 April Inventor Hour webinar online or check out the PTAB Pro Bono Program at www.uspto.gov/ptabprobono
Hearing Byte:
How Judges Prepare for *Ex Parte* Hearings

Merrell C. Cashion, Jr., Administrative Patent Judge
Judges’ preparation for an *ex parte* hearing

- **Preparation** is key for a productive hearing
  - Appellant/Counsel identifies critical issues that favor appellant’s position
  - Judges ask questions on issues on which the outcome of a case may turn
Judge Panels

• Each case is assigned to a panel of at least three judges

• All three judges are present at a case hearing (in-person, virtually, or some combination thereof)

• The examiner typically does not appear at the hearing

• Judges typically ask the appellant questions at the hearing to aid in understanding the issues and how those issues should be decided
Pre-hearing record review

• Before the hearing, the panel of judges reviews the record for each appeal

• This review typically includes:
  - Specification and Drawings
  - Appeal Brief and Reply Brief (if filed)
  - Declarations (if any discussed in the Appeal Brief)
  - Appealed Office Action, including evidence relied upon (references)
  - Examiner’s Answer
  - Any additional document deemed necessary
Purpose of pre-hearing record review

• Review of the Appeal and Reply Briefs (papers by appellant):
  - identifying the critical issues that appellant believes favor their case
  - understanding appellant’s explanation of why the examiner erred as to each ground of rejection contested
  - identifying the weakest parts of the case on which the outcome may turn

• Review of the Appealed Action and Answer (papers by examiner):
  - understanding the examiner’s application of the evidence (references), including the interpretation of the evidence and conclusions
  - understanding the examiner’s reliance on the relevant laws cited in arriving at the stated conclusions
Goals of pre-hearing record review

• The goals of a judge’s review of the record:
  ◆ become familiar with the record of the appeal
  ◆ identify the salient issues for discussion in the pre-hearing conference held among the panelists
Pre-hearing conference

• At an internal pre-hearing conference, judges discuss a case to:
  - crystallize the key issues for discussion at the hearing
  - walk through the evidence of record

• The panel of judges makes no decision on the outcome of an appeal BEFORE the hearing
Day of the hearing

The judges are ready!
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Inventors Digest

https://www.inventorsdigest.com

- Monthly issues, each featuring articles about USPTO
- Monthly articles about PTAB
- Free online
Trial Byte: Patent Owner Response

Lynne Browne, Administrative Patent Judge
Overview of AIA proceedings

**Petition Phase**
- Petition Filed
- PO Prelim. Resp.
- Decision on Petition

**Trial Phase**
- PO Resp. & MTA
- Pct. Reply & Opp. to MTA
- PO Sur-Reply & Reply to Opp.
- Oral Hearing (on request)
- Final Written Decision

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

No more than 12 months (*by statute*)
Patent owner response

• Failing to address an issue may result in a waiver
• Due three months from institution
• Opportunity to file a motion to amend
• Opportunity to address merits of Petition
• Opportunity to supplement the evidentiary record with a declaration
Formal content of PO response

- Table of Authorities
- Exhibit List
- Introduction
- Background
Level of ordinary skill and claim construction

“Factors that may be considered in determining level of ordinary skill in the art include: (1) the educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and (6) educational level of active workers in the field.” Environmental Designs, Ltd. v. Union Oil Co. of CA, 713 F2d 693, 696 (Fed. Cir. 1983).
Evidence

United States Patent and Trademark Office
Before the Patent Trial and Appeal Board
Ontel Products Corporation, Petitioner,
v.
Guy A. Shaked Investments Ltd., Patent Owner
Case IPR2021-00852
Petition 9,877,962 B2

Declaration of Scott O. Ganaza, P.E. In Support of Patent Owner’s Preliminary Response

Lower lactic acid profile when compared to baseline

DAFNI®, The Original Ceramic Hair Straightening Brush, Wins Prestigious Good Housekeeping Beauty Lab Award

News provided by DAFNI®
July 25, 2017, 07:37 ET

PARSIPPANY, N.J., July 25, 2017 /PRNewswire/ — DAFNI®, the original patented heated ceramic hair straightening brush, is thrilled to announce its prestigious Good Housekeeping Beauty Lab Award as the best “Hot Stylin’ Tool.”

[Image of DAFNI® brush]
V. Ground 3: Claims 1-10 Are Patentable Over Choi, Ida, and Gress

Ontel did not (and cannot) demonstrate that a POSA could have or would have modified Choi such that its alleged elongate heating elements are monolithic with its alleged heating plate, as recited in claim 1. The Board preliminarily agrees that Ontel did not meet its burden with respect to this claim element. Id. 30-34.

Relying on a dissent in an improper Federal Circuit case, Ontel proffers the conclusory argument that it would have been an obvious “design choice” to modify Choi so that its heat transfer units (the alleged heating element) and its iron roll (the alleged heating plate) are fashioned from a single piece of metal. Pet. 43-45.

Failing that, Ontel turns to Gress’s monolithic embodiment again. Id. 45.

Ontel is wrong on both points. Gress explains that its preferred and non-monolithic embodiment is particularly simple to make and assemble. Gress is correct, and the same is true for Choi. Fashioning such a complicated component from a single piece of metal is difficult and expensive, if not impossible. Gress Decl. ¶¶ 90-94. Further, trying to do so with Choi would result in a device that is challenging (i.e., expensive) or impossible to assemble. In particular, Choi’s heat insulating units (the accused spacers) must be inserted into its heat transfer unit (the alleged heating elements) before Choi is assembled—an impossibility if Choi’s iron roll and heat transfer units are fabricated from a single piece of metal.
Question/comment submission

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Future programs

**Invention-Con – August 10-12**
PTAB’s presentation is scheduled for **August 12, at 1 pm ET**

**Inventor Hour, Episode 11**
Thursday, September 22, at noon ET
Question/comment submission

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