Patent Trial and Appeal Board

Inventor Hour: Episode 14

Janet Gongola, Vice Chief Administrative Patent Judge
Stacey White, Lead Administrative Patent Judge
Michael Astorino, Administrative Patent Judge
LiLan Ren, Administrative Patent Judge
John Schneider, Administrative Patent Judge
Robert Silverman, Administrative Patent Judge
NaThanya Ferguson, Supervisory Innovation Development Outreach and Program Specialist

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

**Patents**
- Examine patent applications and grant patents
- PTAB: ex parte appeals, AIA proceedings, other

**Trademarks**
- Examine and register trademarks
- TTAB*: ex parte appeals, inter partes proceedings

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

1. Meet a USPTO professional
2. Invention & patent lifecycle
3. Appeal byte: Importance of the claims
4. Walkabout the web: Inventor and entrepreneur resources
5. Hearing byte: Attending an oral hearing
6. 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

Meet a USPTO professional

NaThanya Ferguson
Supervisory Innovation Development Outreach & Program Specialist
USPTO Office of Innovation Outreach
NaThanya Ferguson
Supervisory Innovation Development Outreach and Program Specialist
USPTO Office of Innovation Outreach
Question/comment submission

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Law School Clinic Certification Program

• Over 60 participating law school clinics
• Pro bono legal services to the public, including inventors, entrepreneurs, and small businesses
• Participating schools and contact information at: https://www.uspto.gov/learning-and-resources/ip-policy/public-information-about-practitioners/law-school-clinic-1
PTAB stakeholder outreach

Part of PTAB’s “Stadium Tour”

- February 21–23, 2023
- Sandra Day O’Connor College of Law,
- Arizona State University
- Phoenix, AZ
Invention & patent lifecycle
Example patenting timeline


- Appeal to PTAB
- Abandon
- RCE
Patenting timeline

1. Develop Invention
2. Learn About Patenting
4. First Examiner Office Action
5. Applicant Response
6. Second Examiner Office Action
7. Patent Granted
   - Appeal to PTAB
   - Abandon
   - RCE
Example patenting timeline

1. Develop Invention
2. Learn About Patenting
4. First Examiner Office Action
5. Applicant Response
6. Second Examiner Office Action
7. Patent Granted

OFFICE ACTION SUMMARY

Applicant No. 123456

Patient for Reply:

Requirement is written in English. It is not required to be translated (37 CFR 1.6). A requirement in a language other than English must be accompanied by an English requirement.

First examiner office action

Applicant

Response

Second examiner office action

Patent granted

Abandon

Appeal to PTAB

RCE
Example patenting timeline

1. Develop Invention
2. Learn About Patenting
4. First Examiner Office Action
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8. Appeal to PTAB
9. Abandon
10. RCE

SAMPLE FORMAT FOR REVISED AMENDMENT PRACTICE (Rev. 4/02)

Appl. No. : XX/YY/ZZ Confirmation No. WXYZ
Applicant : Jane Q. Inventor
Filed : April 19, 2003
TEA U. : 171
Examiner : John Doe
Docket No. : 12455AA/8756
Customer No. : 8888

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AMENDMENT

Sir:
In response to the Office action of October 18, 2003, please amend the above-identified application as follows.

Amendments to the Specification begin on page 2 of this paper.
Amendments to the Claims are reflected in the listing of claims which begins on page 3 of this paper.
Amendments to the Drawings begin on page 4 of this paper and include both an attached replacement sheet and an annotated sheet showing changes.

RCE

Abandon

Appeal to PTAB

RCE
Example patenting timeline

- Develop Invention
- Learn About Patenting
- Prepare & File Patent Application
- First Examiner Office Action
- Applicant Response
- Second Examiner Office Action
- Patent Granted

- Appeal to PTAB
- Abandon
- RCE
Patenting timeline

- Develop Invention
- Learn About Patenting
- Prepare & File Patent Application
- First Examiner Office Action
- Applicant Response
- Second Examiner Office Action
- Patent Granted

Alternative paths:
- Appeal to PTAB
- Abandon
- RCE
Example patenting timeline

1. Develop Invention
2. Learn About Patenting
4. First Examiner Office Action
5. Applicant Response
6. Second Examiner Office Action
7. Patent Granted

- Appeal to PTAB
- Abandon
- RCE
Example patenting timeline

1. Develop Invention
2. Learn About Patenting
4. Applicant Response
5. Second Examiner Office Action
6. Patent Granted

Options:
- Appeal to PTAB
- Abandon
- RCE
Example patenting timeline

1. Develop Invention
2. Learn About Patenting
4. First Examiner Office Action
5. Applicant Response
6. Second Examiner Office Action
7. Patent Granted
8. Appeal to PTAB
9. Abandon
10. RCE

Abandon
USPTO “Path to a Patent” series

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

https://www.uspto.gov/about-us/events/path-patent
Question/comment submission

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– PTABInventorHour@uspto.gov
LiLan Ren, Administrative Patent Judge

Appeal byte:
Importance of the claims
Importance of the claims

“To coin a phrase, the name of the game is the claim.”

- Judge Giles Rich
A claim is:

a sentence at the end of the patent that defines the legal scope of protection

1. A dog toy used for purposes of play and retrieval, the dog toy comprising:
   an elongated member having a first end and a second end, an elongated portion extending between the first end and the second end, the elongated member further including a holding portion; and
   a plurality of tines positioned on at least one of the first end or the second end, the plurality of tines extending along the elongated portion of the elongated member, the tines extending away from the elongated member wherein as the user throws the dog toy through the air the dog toy generates a whistling noise when air passes through the plurality of tines and creates a clacking noise when the dog toy reaches the ground.

2. The dog toy of claim 1 wherein the elongated member and the elongated portion are generally cylindrical.

3. The dog toy of claim 1 wherein the other of the first or second end not including the tines is solid thereby acting as the holding portion.
The claim is not:

the Specification, which includes the drawings and the written description
Examination

• Focuses on whether the **claims** are
  – Patent eligible
  – Clear and not indefinite
  – Specific (i.e., not omnibus or “what is disclosed”)
  – Supported by the written description and figures
  – Novel and non-obvious in view of the prior art
Patentability requirements

• Novel, not already known
• Non-obvious, would not have been obvious to “person skilled in the art” in view of prior art
Two-step analysis

• Step 1: claim interpretation
• Step 2: comparing the prior art
Step 1: claim interpretation

• Interpret the claims to determine the meaning and scope of each claim limitation

• During examination, the words of the claims are given their broadest reasonable interpretation consistent with the specification
Claim scope

1. A dog toy used for purposes of play and retrieval, the dog toy comprising:
   - an elongated member having a first end and a second end,
   - an elongated portion extending between the first end and the second end, the elongated member further including a holding portion; and
   - a plurality of tines positioned on at least one of the first end or the second end, the plurality of tines extending along the elongated portion of the elongated member, the tines extending away from the elongated member wherein as the user throws the dog toy through the air the dog toy generates a whistling noise when air passes through the plurality of tines and creates a clacking noise when the dog toy reaches the ground.

2. The dog toy of claim 1 wherein the elongated member and the elongated portion are generally cylindrical.

3. The dog toy of claim 1 wherein the other of the first or second end not including the tines is solid thereby acting as the holding portion.
Step 2: comparing the prior art

- Examiner searches for relevant prior art
- Focuses on the interpreted claims
Comparing the prior art

Prior Art

Claim

Known, not novel

Obvious

Non-obvious
Examiner’s rejection

Focus of the rejection is on the claims

• Claim 1 is not novel because prior art X discloses A+B.

• Claim 2 is obvious because prior art Y discloses C and it would have been obvious to combine with prior art X.

• Claim 3 is non-obvious because the prior art does not discloses D.

1. A dog toy used for purposes of play and retrieval, the dog toy comprising:
   an elongated member having a first end and a second end, an elongated portion extending between the first end and the second end, the elongated member further including a holding portion, and
   a plurality of tines positioned on at least one of the first end or the second end, the plurality of tines extending along the elongated portion of the elongated member, the tines extending away from the elongated member wherein as the user throws the dog toy through the air the dog toy generates a whistling noise when air passes through the plurality of tines and creates a clacking noise when the dog toy reaches the ground.

2. The dog toy of claim 1 wherein the elongated member and the elongated portion are generally cylindrical.

3. The dog toy of claim 1 wherein the other of the first or second end not including the tines is solid thereby acting as the holding portion.
Responding to a rejection

• Focus of the response is on the claims
  – Respond by argument
  – Amend the claims
  – Or both
Arguments

• Focus arguments on the claim features
  – Maybe the examiner misinterpreted the claim scope
  – Maybe the examiner misapplied the prior art
• Arguments that are not focused on claim features are often not persuasive
Amending claims

Claims can be amended to add features that are described in the specification as originally-filed.
1. (Original) A dog toy used for purposes of play and retrieval, the dog toy comprising:

an elongate member having a first end and a second end, an elongated portion extending between the first end and the second end, the elongated member further including a holding portion; and a plurality of tines positioned on at least one of the first end or the second end, the plurality of tines extending along the elongated portion of the elongated member, the tines extending away from the elongated member wherein as the user throws the dog toy through the air the dog toy generates a whistling noise when air passes through the plurality of tines and creates a clacking noise when the dog toy reaches the ground.

1. (Currently Amended) A dog toy used for purposes of play and retrieval, the dog toy comprising:

an elongate member having a first end and a second end, an elongated portion extending between the first end and the second end, the elongated member further including a holding portion; and a plurality of tines positioned on at least one of the first end or the second end, the plurality of tines extending along the elongated portion of the elongated member, the tines extending away from the elongated member wherein as the user throws the dog toy through the air the dog toy generates a whistling noise when air passes through the plurality of tines and creates a clacking noise when the dog toy reaches the ground; and

wherein the other of the first and second end not including the tines is solid thereby acting as the holding portion.
Amending claims

Prior Art

Known, Not Novel

Obvious

Unpatentable Claim

Patentable Claim

Claim
Infringement

• Focuses on whether a competitor’s product/method infringes the claims

• To infringe, the competitor’s product or method must meet each and every feature of at least one claim

• Be careful during examination to avoid amending claims to be so narrow in scope that they have no value
Question/comment submission

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

– PTABInventorHour@uspto.gov
USPTO YouTube channel

• View dozens of videos:
  – USPTO’s Invention-Con
  – Tips for registering a trademark
  – Science of Innovation series for kids and teachers
  – Careers at USPTO
  – And a lot more

• https://www.youtube.com/user/USPTOvideo/
Stacey White, Lead Administrative Patent Judge

Walk about the web:
Free resources for inventors and entrepreneurs
https://www.uspto.gov/learning-and-resources/inventors-entrepreneurs-resources
https://www.uspto.gov/learning-and-resources/inventors-entrepreneurs-resources
Access our free services

The United States Patent and Trademark Office (USPTO) offers a wide range of intellectual property (IP) resources, including application assistance, education and training, and other services that support the full spectrum of customers—from independent patent and trademark firms, to attorneys and business advisors in both the private and public sectors. Learn more about what USPTO is doing to expand participation in the innovation ecosystem through [Innovate Innovation](https://www.uspto.gov/learning-and-resources/access-our-free-services), including our [Council for Inclusive Innovation (CII)](https://www.uspto.gov/learning-and-resources/access-our-free-services).

To identify below, select a category to filter the list by your area of interest.

### Application Assistance

<table>
<thead>
<tr>
<th>Title</th>
<th>Description</th>
<th>Resource category</th>
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</thead>
<tbody>
<tr>
<td>Application Assistance Unit (AAU)</td>
<td>Provides assistance with questions and issues pertaining to pre-examination processing of patent applications and the post-examination processing of patent applications.</td>
<td><img src="https://www.uspto.gov/learning-and-resources/access-our-free-services" alt="Resource Category" /></td>
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<tr>
<td>Finding a patent practitioner</td>
<td>Search the registry of active patent practitioners who are eligible to represent others before the USPTO in patent matters.</td>
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<tr>
<td>Hiring a U.S. licensed attorney for trademarks</td>
<td>Discover if you are required to hire an attorney and why you should hire an attorney for trademark matters, even if you are not required to.</td>
<td><img src="https://www.uspto.gov/learning-and-resources/access-our-free-services" alt="Resource Category" /></td>
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<tr>
<td>Inventors Assistance Center</td>
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<td>Under the supervision of an approved faculty clinic supervisor, law school students provide pro bono representation to individuals and small businesses throughout the country in the prosecution of patent and trademark applications before the USPTO.</td>
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</tr>
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<td>Patent and Trademark Resource Centers</td>
<td>Nationwide network of 80+ libraries that offers the public trademark and patent assistance. These libraries provide access to awarness-based search systems, and staff demonstrate how to use search tools and offer classes on intellectual property.</td>
<td><img src="https://www.uspto.gov/learning-and-resources/access-our-free-services" alt="Resource Category" /></td>
</tr>
</tbody>
</table>
Access our free services

The United States Patent and Trademark Office (USPTO) offers a wide range of intellectual property (IP) resources, including application assistance, education and training, and other services that support the full spectrum of customers—from independent patent and trademark filers, to attorneys and business advisors in both the private and public sectors. Learn more about what USPTO is doing to expand participation in the innovation ecosystem through inclusive innovation, including our Council for Inclusive Innovation (CII).

Using the icons below, select a category to filter results by your areas of interest.

- All Resources
- Patents
- Trademarks
- Attorneys and Business Advisors

Title | Description | Resource
--- | --- | ---
Application Assistance | Application Assistance Unit (AAU) | 
| Provides assistance with questions and issues pertaining to pre-examination processing of patent applications and the post-examination processing of patent applications. | 
Finding a patent practitioner | Search the registry of active patent practitioners who are eligible to represent others before the USPTO in patent matters. | 
Inventors Assistance Center | Provides patent assistance and information to the public to help make filing a patent application simple and efficient before, during, and after the patent application process (i.e., patent maintenance). | 
Law School Clinic Certification Program | Under the supervision of an approved faculty clinic supervisor, law school clinics provide pro bono representation to individuals and small businesses throughout the country in the prosecution of patent and trademark applications before the USPTO. | 
Patent and Trademark Resource Centers | Nationwide network of 80+ libraries that offers the public trademark and patent assistance. These libraries provide access to examiner-based search systems, and demonstrate how to use search tools and offer classes on intellectual property. | 

https://www.uspto.gov/learning-and-resources/access-our-free-services
Small and medium-sized ENTERPRISE RESOURCES

The United States Patent and Trademark Office (USPTO) is a unique federal agency that generates income and provides a return on its investment by issuing patents for inventions. Patent-intensive industries account for 41% of U.S. gross domestic product. Many of the businesses operating in these industries are small and medium-sized enterprises (SMEs). To support SMEs and other innovators, the USPTO created this page to share resources from federal agencies and international organizations for growing a business and for protecting intangible business assets like IP.

For information on IP fundamentals, such as filing a patent or registering a trademark, visit the USPTO’s inventor and entrepreneur resources page and to find out about some of the ways the USPTO can assist you, browse our free services.

IP valuation and business development
Find out how to evaluate your IP assets and develop your business.
- Valuing IP assets
- Intellectual property basics
- Emerging Leaders Initiative
- USA.gov’s small business portal

IP commercialization
Learn about IP technology transfer, licensing, and partnerships.
- Technology transfer basics
- Patents for Humanity awards
- National security partnerships
- Marketplace for federal agriculture technology
- Patents 4 Partnerships licensing
- Marketplace for sustainable technology

Protection for IP abroad
Learn about domestic IP policy initiatives, international IP treaties, and practical tools to protect your IP internationally.
- International IP protection
- International IP toolskits
- IP Attaché Program
- Patent validity protection
- Other IP policy information
- World Intellectual Property Organization

International trade and exporting
Access resources for growing and protecting your business through international cooperation.
- Information on exporting
- Small businesses and trade
- Reporting trade violations
- Free trade agreements
- Training and toolkits about IP rights

Federal funding for innovation
- CARES Act funding through the Minority Business Development Agency
- National Institutes of Health funding opportunities
- National Science Foundation programs for small businesses
- COVID-19 relief efforts through the Small Business Administration
- Additional funding resources can be found here

https://www.uspto.gov/learning-and-resources/startup-resources
Innovator events for everyone

Question/comment submission

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Hearing byte
Attending an oral hearing
USPTO Patent Trial & Appeal Board
Mechanics of attending an oral hearing: overview

• Notice of hearing
• Public admission
• Hearing waiting room
• Hearing room decorum
• Inclement weather
• Helpful resources
NOTICE OF HEARING - ALEXANDRIA, VIRGINIA
RESPONSE REQUIRED WITHIN 21 DAYS

The Patent Trial and Appeal Board (PTAB) will hear the above-identified appeal on the date indicated. The hearing will commence at the time set, and as soon as the argument in one appeal concludes, the succeeding appeal will be taken up. The time allowed for argument is 20 minutes, unless additional time is requested and approved before the argument commences. If the application involved in this appeal has been published, the hearing will be open to the public.

Hearing Attendance Confirmation or Waiver

Appellant is required to confirm attendance at the hearing or waive the hearing within 21 days of the mailing date of this notice. Appellant may confirm or waive attendance by completing the “APPELLANT RESPONSE TO NOTICE OF HEARING” and returning it to the PTAB.

Options for Hearing Attendance

If Appellant opts to attend the hearing, Appellant may appear in-person, by video, or by telephone. In Appellant’s response to the NOTICE OF HEARING, Appellant should indicate the manner in which Appellant will appear for the hearing.

If Appellant is no longer interested in having a hearing, then Appellant must file a waiver of the hearing with the PTAB. This allows the panel of Administrative Patent Judges assigned to the appeal to act promptly on the appeal without waiting for the hearing date.

If Appellant fails to respond to this NOTICE OF HEARING, the PTAB will issue a decision on the briefs based on the written record.
Notice of hearing

Hearing Attendance Options (please select one)

( ) I elect an IN-PERSON hearing and will appear at a hearing room in the following USPTO office:

- ALEXANDRIA, VA - 600 Dulany Street
- DALLAS, TX - 207 South Houston Street
- SAN JOSE, CA - 26 S. Fourth Street
- DETROIT, MI - 300 River Place Drive
- DENVER, CO - 1961 Stout Street

( ) I elect a remote VIDEO hearing and will appear from a non-USPTO location that I secure for myself.

( ) I elect a TELEPHONIC hearing.

( ) I WAIVE the hearing.

( ) I am requesting to RESCHEDULE the hearing. A separate paper must be filed.
Hearing facilities

- Denver, Colorado
- Detroit, Michigan
- San Jose, California
- Alexandria, Virginia
- Dallas, Texas

Regions:
- Silicon Valley region
- Rocky Mountain region
- Texas region
- Midwest region
- East Coast region

USPTO office location
USPTO headquarters
Public admission: Madison Building
Madison Building: atrium
Madison Building: atrium (inside)
Madison East security
Madison East 9th floor
PTAB hearing waiting room
PTAB clerk’s desk

Hearing Room Protocol

Docket
PTAB hearing rooms: headquarters

- Hearing Room A: maximum capacity is 63 occupants.
- Hearing Room B: maximum capacity is 15 occupants.
- Hearing Room D: maximum capacity is 28 occupants.
- Headquarters does not have designated overflow facilities.
- Point of contact for hearing room questions: 571-272-9797
PTAB hearing rooms: regional offices

**Detroit, Michigan**

The maximum occupancy of the Detroit hearing room is 14 occupants.

Overflow facilities: Designated overflow room is the training room (RPL022061).

Point of contact for hearing room questions:
Administrative assistant/usher 313-446-6576

**Denver, Colorado**

The maximum occupancy of the Denver hearing room is 26 occupants.

Overflow facilities: Designated overflow room is Room 14.111.

Point of contact for hearing room questions:
Receptionist/usher 303-297-4262

**Dallas, Texas**

The maximum occupancy of the Dallas hearing room is 13 occupants.

Overflow facilities: Designated overflow room is Room #157.

Point of contact for hearing room questions:
Administrative assistant/usher 469-295-9073

**San Jose, California**

The maximum occupancy of the San Jose hearing room is 10 occupants.

Overflow facilities: Designated overflow room is Room #320.

Point of contact for hearing room questions:
Administrative assistant/usher 418-918-9900
Hearing room protocol/decorum

• Formal business attire, or business casual attire if you are an observer

• Guidelines
  – No recording devices
  – Turn off cell phones and electronic devices
  – No food or drink, except water
  – Unless the APJ permits, there will be no entries/exits during a hearing
  – During the hearing, excessive talking or loud outbursts are prohibited
  – Improper hearing room behavior may result in removal or other sanctions
Inclement weather

- Main campus (Alexandria, Virginia)
  - Sign up for OPM email alerts - [http://apps.opm.gov/listserv_apps/list-sub.cfm?targetlist=operatingstatus](http://apps.opm.gov/listserv_apps/list-sub.cfm?targetlist=operatingstatus)

- Regional Offices, please call
  - Detroit, Michigan, 313-446-4949
  - Dallas, Texas, 469-295-9494
  - Denver, Colorado, 303-297-4646
  - San Jose, California, 408-918-7676
Helpful resource: guide to the administration of oral hearings before the Patent Trial and Appeal Board

- Available at: https://www.uspto.gov/sites/default/files/documents/PTAB_hearings_guide_101520.pdf
Question/comment submission

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

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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
Question/comment submission

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– PTABInventorHour@uspto.gov
Questions?
Future programs

Inventor Hour, Episode 15
Thursday, February 23, noon (ET)