Patent Trial and Appeal Board
Inventor Hour: Episode 15

Janet A. Gongola, Vice Chief Administrative Patent Judge
Cynthia M. Hardman, Administrative Patent Judge
Jeffrey N. Fredman, Administrative Patent Judge
Ryan H. Flax, Lead Administrative Patent Judge
and special guests Sara Butts and Robert Berry

February 23, 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. Meet PTRC: Robert Berry & Sara Butts
2. Appeal Byte: Basics of Ex Parte Appeals
3. Trial Byte: AIA Proceedings Review
4. Walk About the Web: Translations
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 the PTRC
Patent & Trademark Resource Center
Robert Berry and Sara Butts

Ryan H. Flax, Lead Administrative Patent Judge
City or county public library
College or university library
State library
Special library
Question/comment submission

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Request a PTAB speaker

If your organization is interested in having a PTAB speaker at an event, submit a request:


- Form takes less than 5 minutes to complete
- Preferred to have specific **date, time, and format**
- May identify a specific person or ask generally
Appeal Byte:
Basics of *Ex Parte* Appeals

Jeffrey Fredman, Administrative Patent Judge
The basics of *ex parte* appeals

- What are *ex parte* appeals?
- What *rules and law* apply in an *ex parte* appeal?
- What are the possible *outcomes* on appeal?
- What happens *after* an *ex parte* appeal is over?
What are *ex parte* appeals?

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 can seek review by the PTAB.
Patentability: statutory requirements

- Subject matter eligibility §101
- Novelty §102
- Non-Obviousness §103
- Definiteness §112(b)
- Written description §112(a)
- Enablement §112(a)
What rules and law apply?

- Law of the U.S. Supreme Court and U.S. Court of Appeals for the Federal Circuit
- 35 U.S.C. (Patents)
- 37 C.F.R. Part 41
- Precedential PTAB decisions
  - Guidance to the PTAB
The *ex parte* appeal process

What are the possible outcomes?

The outcome may be an affirmance, an affirmance-in-part, a reversal, or new ground(s) of rejection

**Affirmance**: rejection of each and every claim is upheld

**Affirmance-in-part**: rejection of at least one claim, but not all, is upheld

**Reversal**: None of the examiner's rejections are upheld

**New ground(s) of rejection**: Judges issue a new rejection of one or more claims
What happens after an appeal?

The outcome dictates who is responsible for taking the next step

If the outcome is an **affirmance or new ground(s) of rejection**, the **appellant** **must** take the next step.

If the outcome is an **affirmance-in-part**, the **appellant** **may** take the next step.

If the outcome is a **reversal**, the **examiner** will take the next step.
Question/comment submission

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Appeal brief tool

• Need help in preparing an appeal brief? Check out the appeal brief tool

• Tool walks through the required sections of an appeal brief, gives instructions on what information should be presented in each section, and provides examples

• Instructional video also available

• Free!
Cynthia Hardman, Administrative Patent Judge

**Trial Byte:**
AIA Proceedings Overview, a Review
What are AIA trial proceedings?

**America Invents Act (AIA)** – Congress revised the Patent Act to provide an additional forum to address patentability/validity disputes

AIA trials are intended to be streamlined, efficient, and cost effective.
What types of AIA trial proceedings exist?

**Inter Partes Review (IPR):** can challenge claims based on prior art (patents or printed publications)

**Post-Grant Review (PGR):** can challenge claims based on prior art and other bases

**Derivation:** determines correct inventor; alleges another derived the invention from the correct inventor
## Comparison of IPR and PGR

<table>
<thead>
<tr>
<th>Trial Type</th>
<th>Who Can File</th>
<th>Applicability</th>
<th>Availability</th>
<th>Basis</th>
</tr>
</thead>
<tbody>
<tr>
<td>Inter partes review (IPR)</td>
<td>Person who is: (a) not the patent owner, (b) has not previously filed a civil action challenging the validity of a claim of the patent, and (c) has not been served with a complaint alleging infringement of the patent more than 1 year prior (exception for joinder).</td>
<td>Any patent (first-to-invent or first-inventor-to-file).</td>
<td>For first-to-invent patents: anytime after patent grant or reissue.</td>
<td>102 and 103 based on patents and printed publications.</td>
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<td>For first-inventor-to-file patents: from the later of: (a) 9 months after patent grant or reissue; or (b) the date of termination of any post grant review.</td>
<td></td>
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<tr>
<td>Post-grant review (PGR)</td>
<td>Person who is: (a) not the patent owner, and (b) has not previously filed a civil action challenging the validity of a claim of the patent.</td>
<td>Patent issued under first-inventor-to-file.</td>
<td>Must be filed within 9 months of patent grant or reissue.</td>
<td>101, 102, 103, 112 (but not best mode), and double patenting.</td>
</tr>
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</table>
Who is involved in an AIA trial proceeding?

**Petitioner**

Files petition challenging a U.S. patent; must pay a filing fee

Carries legal burden to prove claims unpatentable

**Patent owner**

Has opportunities to represent its interests

**Panel**

Typically three administrative patent judges
How do AIA trial proceeding work?

**PETITION PHASE**
- Petition Filed
  - 3 mos
- PO Prelim. Resp.
  - 3 mos max
- Decision on Petition
  - 3 mos

**TRIAL PHASE**
- PO Resp. & MTA
  - 3 mos
- Pet. Reply & Opp. to MTA
  - 3 mos
- PO Sur-Reply & Reply to Opp.
  - 1 mo
- Oral Hearing (on request)
- Final Written Decision
- Motions on Evidence

**PETITION PHASE**
- PO Discovery
- Pet Discovery

**TRIAL PHASE**
- PO Period
- Motions on Evidence

No more than 12 months (*by statute)
What are the possible outcomes?

The outcome may be that all challenged claims are upheld, some challenged claims are upheld, or none of the challenged claims are upheld.

**All claims patentable**: Each and every challenged claim upheld

**Mixed**: At least one challenged claim, but not all, upheld

**All claims unpatentable**: No challenged claim upheld
What happens next?

- Panel rehearing
- Director review
- Appeal to the U.S. Court of Appeals for the Federal Circuit
Want to learn more?

Prior **Inventor Hour Episodes** covering AIA trial proceedings:

- **Episode 1** (Aug. 2021): Introduction AIA trial proceedings
- **Episode 2** (Sept. 2021): Overview of the phases and timing of AIA trial proceedings
- **Episode 3** (Oct. 2021): Pre-institution strategies for Patent Owners
- **Episode 4** (Jan. 2022): Overview of the Board’s Institution Decision
- **Episode 6** (March 2022): Orientation to Trial Practice Guide
- **Episode 10** (July 2022): Patent Owner’s Response
- **Episode 12** (Sept. 2022): Discovery in AIA trial proceedings
- **Episode 13** (Oct. 2022): Motions to Amend

*prior episodes available at https://www.uspto.gov/about-us/events/inventor-hour-events*
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Email alerts from USPTO

https://public.govdelivery.com/accounts/USPTO/subscriber/new
Walk About the Web: PTAB’s Webpages Translations

Janet Gongola, Vice Chief Administrative Patent Judge
USPTO introduces new tool to help creators identify their intellectual property

This tool replaces the IP Assessment tool

USPTO seeks public comments on draft 2022-2026 Strategic Plan

We welcome all comments until the deadline of January 31, 2023

"There is a crucial need for a new era of innovation, and for all of us to unite in helping every potential innovator in our country realize their full potential."
Patent Trial and Appeal Board

The Patent Trial and Appeal Board (PTAB) conducts trials, including inter partes, post-grant, and covered business method patent reviews and derivation proceedings, hears appeals from adverse examiner decisions in patent applications and reexamination proceedings, and renders decisions in interferences.

Trials and appeals
- Resources and guidance
- Trial proceedings
- Appeals proceedings
- New to PTAB?
- Preparing for hearings
- Fees
- PTAB Pro Bono

Decisions
- All PTAB decision data
- AIA daily decisions
- Precedential and informative decisions
- Interim decision circulation process
- Precedential Opinion Panel
- Interim Director review process
- Status of Director review requests

Learn more
- Statistics
- Databases and IT tools
- Frequently asked questions
- Boardside Chat webinar series
- PTAB Inventor Hour series
- PTAB suggestion box, contact info, and speaker request form
- Recent proposals, pilot programs, and final rules
- PTAB Judicial Law Clerk Program
New to 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?
> Free legal help for 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

Spanish | Deutsch
¿Con interés en el PTAB?

Los inventores independientes, los profesionales recientes y otros pueden explorar los enlaces a continuación para comprender mejor el papel que juega el Tribunal de Apelación y Juicio de Patentes (PTAB, por sus siglas en Inglés) en el proceso de obtener una patente de invención.

¿Qué es PTAB?
PTAB es un tribunal administrativo dentro de la USPTO que revisa los rechazos definitivos realizados por los examinadores en procedimientos llamados apelaciones ex parte y resuelve las cuestiones de patentabilidad de las patentes emitidas planteadas por terceros en procedimientos contenciosos bajo la Ley “América Inventa” (AIA, por sus siglas en Inglés).

Apelaciones ex parte
Si un examinador de patentes rechaza dos veces o emite un rechazo definitivo en una solicitud de patente, el solicitante puede buscar revisión con respecto al rechazo ante el PTAB a través de una apelación ex parte.

> ¿Qué son las apelaciones ex parte?

Procedimientos bajo la AIA
Un tercero que no sea el titular de la patente, llamado peticionario, puede impugnar la validez de las reivindicaciones de una patente emitida en un procedimiento contencioso bajo la AIA ante el PTAB.

> Más información sobre los procedimientos bajo la AIA

¿Alguna pregunta?
Haga contacto con PTAB o lea detenidamente las preguntas frecuentes disponibles para su conveniencia.

> Obtenga asistencia (en Inglés)
Other translated languages

Chinese: PTAB 新手？

French: Êtes-vous nouveau à PTAB?

German: Neu bei PTAB?

Greek: Καινούργιοι στο PTAB?

Hindi: PTAB में पहली बार आए हैं?

Japanese: PTABは初めてですか？

Korean: PTAB을 처음 방문하십니까?

Russian: Новичок в PTAB?

Urdu: آپ کے لئے نیا PTAB
Question/comment submission

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Questions?
Future programs

Inventor Hour, Episode 16
Thursday, March 23, noon (ET)

Inventor Hour, Episode 17
Thursday, April 27, noon (ET)