Patent Trial and Appeal Board
Inventor Hour: Episode 16

John Schneider, Administrative Patent Judge
Brandon Warner, Administrative Patent Judge
Tawen Chang, Administrative Patent Judge

Special guests

Jolyn Eley, Office of Patents Stakeholder Experience
Robert Hodge, Office of Patents Stakeholder Experience
Hellen Bryan-Johnson, Senior Trademark Policy Advisor
Ram Shukla, Supervisory Patent Examiner, TC 1600

March 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 Jolyn Eley & Robert Hodge OPSE
2. Hearing Byte: Inventors at Ex Parte Hearings
3. Walk About the Web: IP Identifier Tool
4. Q&A

*INFORMATION NOT INTENDED AS LEGAL ADVICE
To send in questions or comments about the presentation, please email:

– PTABInventorHour@uspto.gov
Meet USPTO Professionals
Jolyn Eley & Robert Hodge
Office of Patents Stakeholder Experience
Question/comment submission

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Successful Inventing Series: product development

- Wednesday, April 22, 2023, 4:00-5:30 p.m. (PT)
- Topics include:
  - The job of product development is to obsolete the competition
  - Product design vs. product engineering
- The *Successful Inventing Series* is a set of monthly presentations that cover various aspects of the invention process, presented by the USPTO and the Licensing Executives Society - Silicon Valley Chapter.
Hearing Byte:
Inventors at Ex Parte Hearings

Tawen Chang, Administrative Patent Judge
Hearings: ex parte appeals

1. Notice of Appeal & Fee
2. Appeal Brief
3. Examiner’s Answer
4. Appeal Brief Forwarding Fee
5. Decision by Board
6. Completion of Appeal Process
7. Oral Hearing Request & Fee (optional)
8. Oral Hearing (if requested)
9. Request for Rehearing (optional)
10. Reply Brief (optional)
Agenda

When & how

Strategic considerations

Best practices
When & how inventors can participate

Assigned rights in invention to others?

- yes
  - Accompanying registered patent practitioner of record?
    - yes
      - Can attend hearing if public or with permission from assignee(s)
      - Can represent self (attend & argue)
    - no
      - Pro hac vice request, including authorization from all assignee(s), submitted and granted?
        - yes
          - Can attend and argue
        - no
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      - yes
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Communication with PTAB for ex parte appeals

**Pro hac vice requests:**
- E-mail/fax
- Attn: PTAB’s hearings clerk
- PTABHearings@uspto.gov
- Fax: 571-273-9797
- **Good cause**
- **Authorization from all assignees**

**Notifications regarding inventor participation:**
- E-mail/fax
- Attn: PTAB’s hearings clerk
- PTABHearings@uspto.gov
- Fax: 571-273-9797
Strategic considerations

- Clarify complicated technology
- Answer questions & respond to follow up (*no new evidence or arguments)
- Allow assessment of level of skill

- Limited time for presentation (20 minutes)
- Difficult to anticipate questions
- Statements may unintentionally support rejection
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Best practices

**Consider alternatives**
- Declarations during prosecution
- Help prepare counsel for hearing

**Prioritize presentation**
- Usually need not discuss background technology
- Focus on critical issue(s) where technical knowledge adds value
- No new arguments or evidence

**Prepare & coordinate**
- Coordinate with counsel
- Know the record
- Anticipate questions and prepare response if possible
## Best practices

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# The Patent Trial and Appeal Board (PTAB)

Guide to the administration of oral hearings before the Patent Trial and Appeal Board (PTAB)

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**How much time is designated to present oral arguments?**

If you have notified the PTAB in writing that you will be presenting arguments, the PTAB will determine the amount of time granted to present oral arguments.

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**Can inventors accompany the registered practitioner?**

Inventors may accompany the registered practitioner at the hearing. Inventors are not required to be present at the hearing, but if present, they may make opening remarks and present oral arguments. Inventors may request in writing that the PTAB allow them to present oral arguments at the hearing.

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**Can a party request that an unaccompanied registered patent practitioner represent themselves and present oral arguments?**

Yes, a party may request that an unaccompanied registered patent practitioner represent themselves and present oral arguments if there is a reasonable basis for the party's assertion that the registered patent practitioner is not the best person to present the arguments.
Question/comment submission

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

– PTABInventorHour@uspto.gov
The USPTO Office of Enrollment and Discipline (OED) maintains a roll of active patent practitioners who are eligible to represent others before the USPTO.

Only registered patent attorneys and agents, and individuals given limited recognition, can represent applicants before the USPTO.
Walk About the Web:
IP Identifier Tool

Ram Shukla, Supervisory Patent Examiner, TC 1600
Hellen Bryan-Johnson, Senior Trademark Policy Advisor
Hellen Bryan-Johnson
Senior Trademark Policy Advisor

Ram Shukla
Supervisory Patent Examiner
What is the IP Identifier?

• User-friendly, online learning tool
• Enables you to
  – Identify your potential IP
    and
  – Learn how to protect it
• Provides digestible information about protecting your IP (patents, trademarks, copyrights, trade secrets)
• Great starting point for those who are starting their IP journey
How does the IP Identifier work?

**Basic IP Identifier**
Answer six brief questions to identify your type of IP

**Advanced IP Identifier**
Individualized sections featuring basic information about a specific type of IP

**Summary report**
- Provides additional information and links to resources
- You can save questions and answers in a PDF

Tips for managing your IP assets
Key features of the IP Identifier

- **IP basics** written in *plain language*
- **Flexible** starting points
- **Easy to complete** in one sitting
- **Summary report** for each category of IP
- **Brief survey** to gather input for future improvements
How do I access the IP Identifier?

- Available in multiple locations on the USPTO’s website
IP Identifier

Live demo
Identify what kind of intellectual property (IP) you have

Answer six brief questions to identify your IP and then learn how to protect it

Find out more at ipidentifier.uspto.gov
Thank you!

Ram R Shukla – SPE, Art Unit 1635
Ram.Shukla@uspto.gov
Ext. 20735

Hellen Bryan-Johnson – Senior Trademark Policy Advisor - OUS
Hellen.Johnson2@uspto.gov
Ext. 29446
www.uspto.gov
Question/comment submission

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

– PTABInventorHour@uspto.gov
Questions?
Future programs

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

Inventor Hour, Episode 18
Thursday, May 25, noon (ET)