

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Patent Trial and Appeal Board Inventor Hour: Episode 20

Janet Gongola, Vice Chief Administrative Patent Judge

Stacey White, Lead Administrative Patent Judge

Brandy Zukanovich, Patent Attorney

Special guests

Jennifer O'Connell, PTAB Bar Association

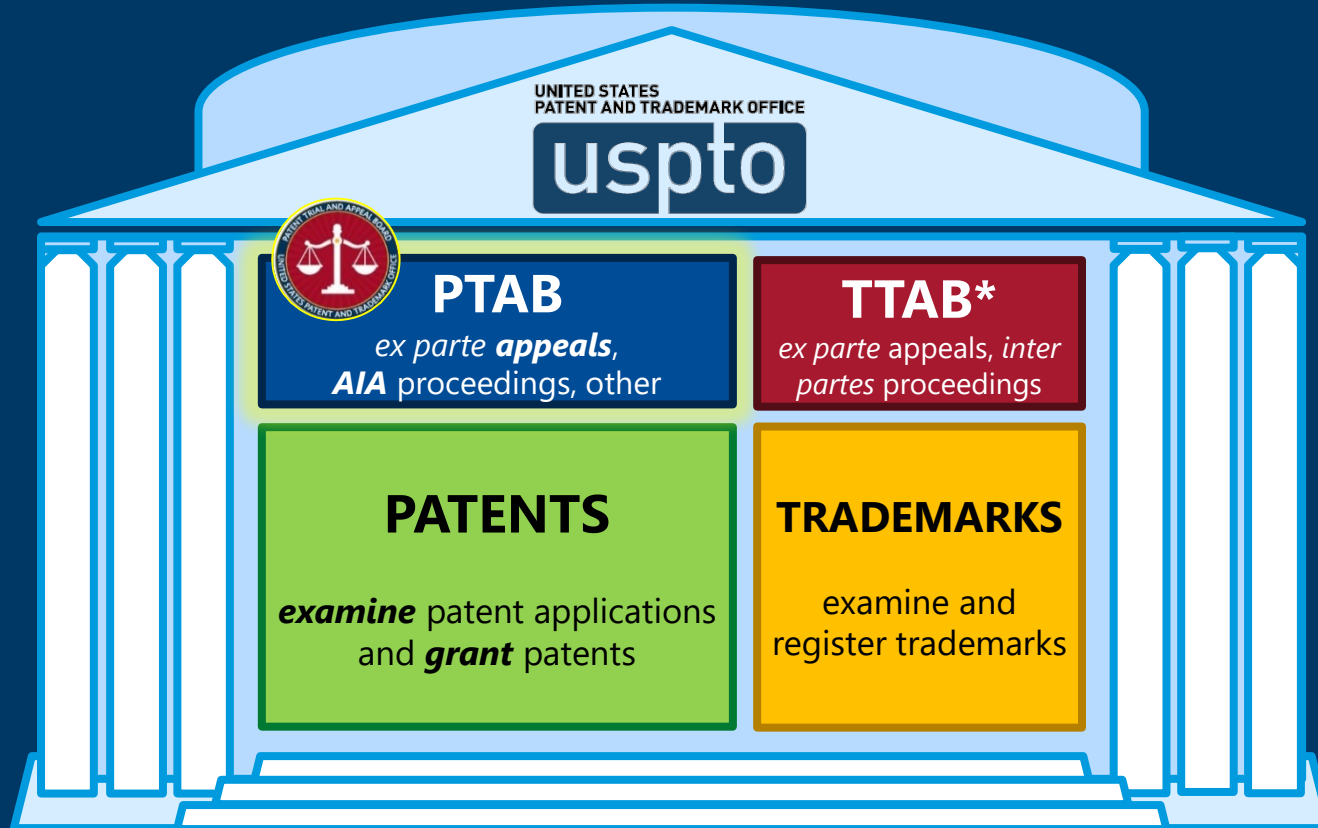
Eugene Goryunov, PTAB Bar Association

July 27, 2023



UNITED STATES
PATENT AND TRADEMARK OFFICE ®

What is the Patent Trial and Appeal Board?



Agenda

- PTAB Pro Bono Program structure
- Skit
 - Participant eligibility
 - How to apply
 - Matching
 - Volunteer eligibility
- Questions

Question/comment submission

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

- PTABInventorHour@uspto.gov

PTAB Pro Bono Program

Program Structure

Pro bono

- Definition = **“for the public good”**
- Refers to services rendered by a professional for free
- Example usage:
 - The attorneys are representing the client pro bono
 - Pro bono legal services

Pro bono program goals

For inventor participants

- Eliminate financial barriers for legal assistance
- Aid under-resourced inventors in making effective arguments

For volunteer practitioners:

- Provide legal help in their field of legal practice
- Create new contacts in the community
- Gain experience in working with clients

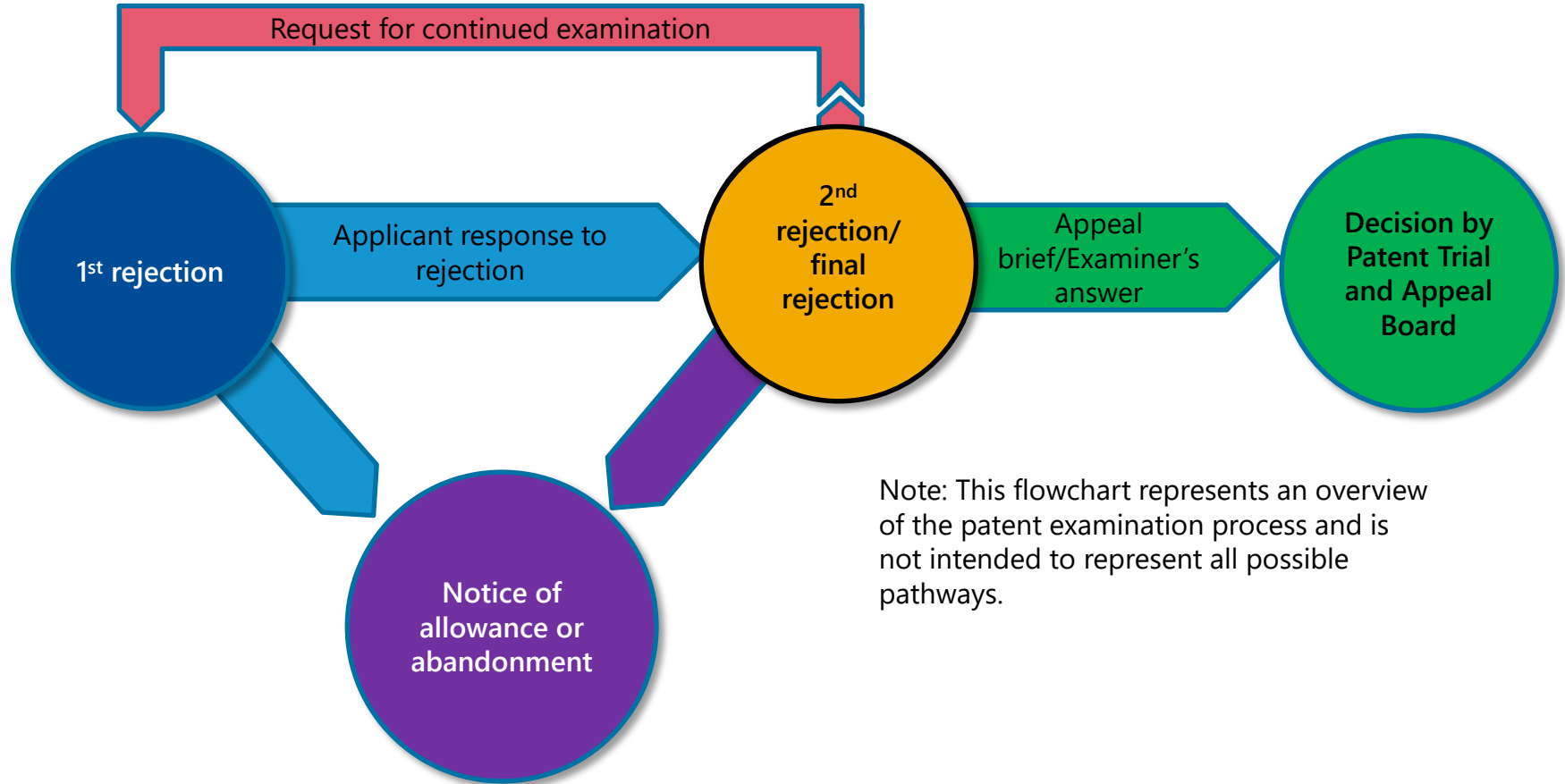
Pro bono program scope

- Program currently assists with *ex parte* appeals through a Board decision.
- Applicant pays all USPTO fees and ancillary costs associated with the appeal.

What is an *ex parte* appeal

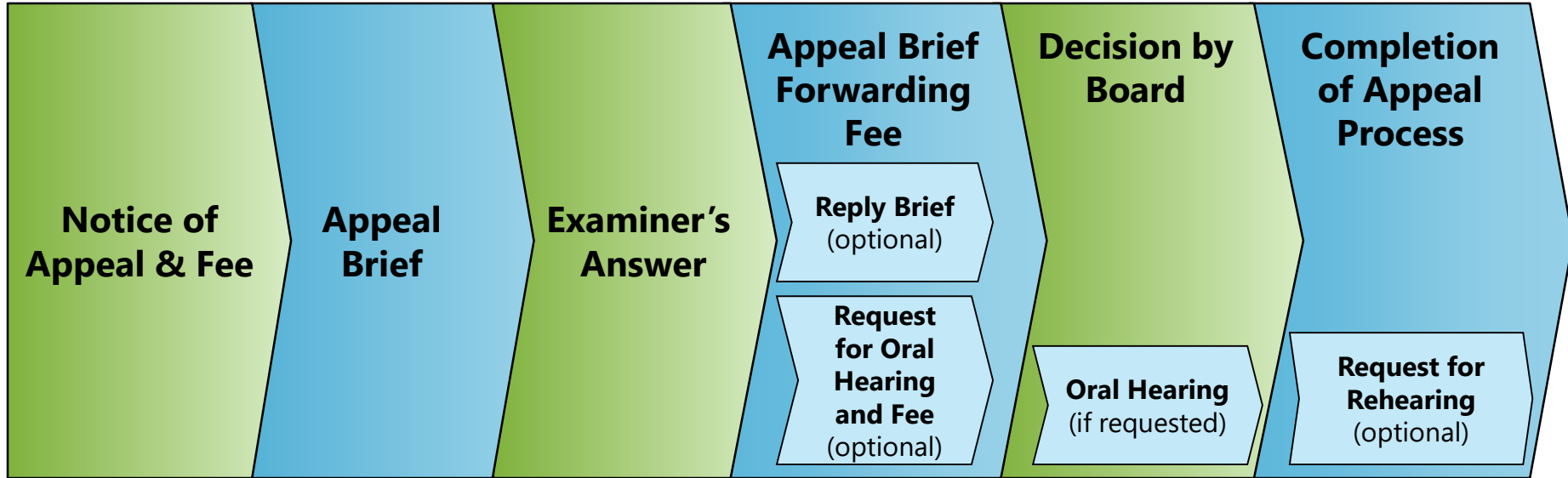
- *Ex parte* = “**from one party**”
- If a patent examiner twice rejects or issues a final rejection in a patent application, the applicant can seek review of the rejection by the Board.
 - Not every disagreement with the examiner is something that may be appealed.
- If the applicant chooses to appeal, the applicant is called an appellant.

Overview of patent examination process



Note: This flowchart represents an overview of the patent examination process and is not intended to represent all possible pathways.

PTAB Appeals: General process



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PTAB Pro Bono Program

Skit

PTAB Pro Bono Program

Eligibility criteria

Individual inventors: Eligibility criteria

- Number of inventors
- Residency
- Income
- Knowledge
- Timing
- Ownership interest

Number of Inventors

- Solo/Individual
 - One inventor

Residency

- Location
 - An inventor must live in the United States.

Income

- Limited financial means

Limited financial means

Persons in the Household	Poverty Level*	400% Poverty
1	\$14,580	\$58,320
2	\$19,720	\$78,880
3	\$24,860	\$99,440
4	\$30,000	\$120,000
5	\$35,140	\$140,560
6	\$40,280	\$161,120
7	\$45,420	\$181,680
8	\$50,560	\$202,240

* 2023 HHS Poverty guidelines for the 48 contiguous states and the District of Columbia. Available at <https://aspe.hhs.gov/topics/poverty-economic-mobility/poverty-guidelines>

Knowledge

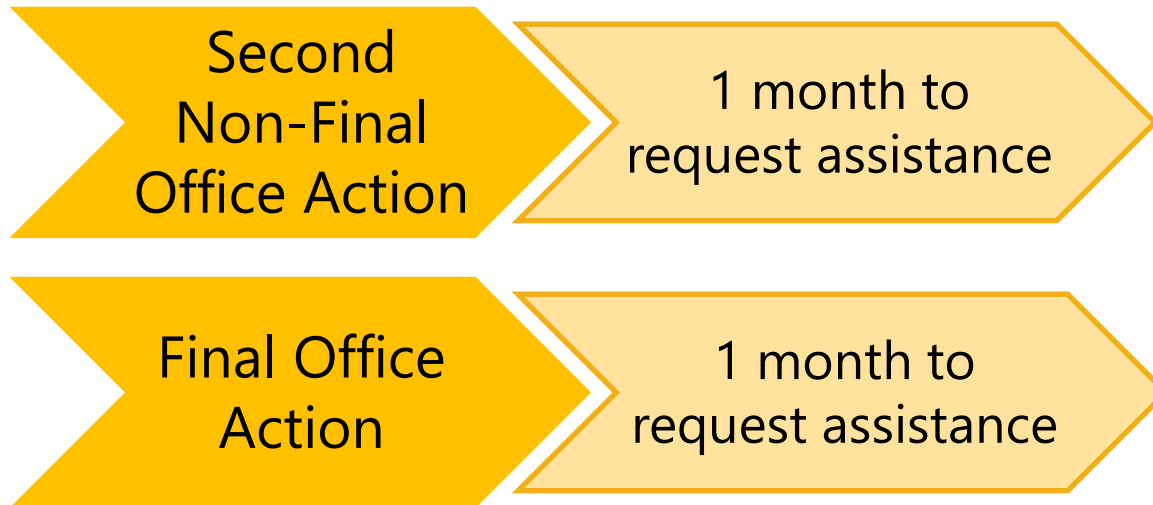
- An inventor must demonstrate knowledge of the program and the *ex parte* appeal process.
 - Videos available at:
<https://www.uspto.gov/patents/patent-trial-and-appeal-board/patent-trial-and-appeal-board-pro-bono-program-independent>

Timing

- An inventor must apply to the program within one month from the date of a second office action or final office action.

Timing to apply

- Request assistance within 1 month from date of Office action at issue
- Examples:



Ownership interest

- A filed United States (pending) patent application.
 - Owned by the inventor and the inventor is not under an obligation to sell or give the ownership of the pending patent application (invention) to someone else

Inventor group: Eligibility criteria

- Same as individual inventor **PLUS**
- No more than four known inventors for the invention

Inventor-owned small business: Eligibility criteria

- Same as inventor group **PLUS** small business ownership and small business income
 - Small business ownership
 - The small business must be 100% inventor owned.
 - The small business owns the invention and is not under an obligation to sell or give the ownership of the pending patent application (invention) to someone else.
 - Small business income
 - The business must have a limited amount of total gross income.
 - The business must expect a limited total gross income.

Knowledge check

Question 1: true or false?

Inventors do not pay anything if they are part of the pro bono program.

Answer

- **False**
 - Applicant pays all USPTO fees and ancillary costs associated with the appeal.

Question 2: true or false?

There is a time limit on when an inventor can apply for pro bono assistance.

Answer

- **True**

- An inventor must apply to the program within one month from the date of a second office action or final office action.

Question 3: true or false?

Inventors are not required to complete the training videos before submitting a request for pro bono assistance.

Answer

- **False**

- An inventor must demonstrate knowledge of the program and the *ex parte* appeal process by viewing two videos prior to applying for PTAB Pro Bono assistance.

Question 4: true or false?

If you believe the examiner did something wrong then you can always file an appeal.

Answer

- **False**
 - Not every disagreement with the examiner is something that may be appealed.

Question/comment submission

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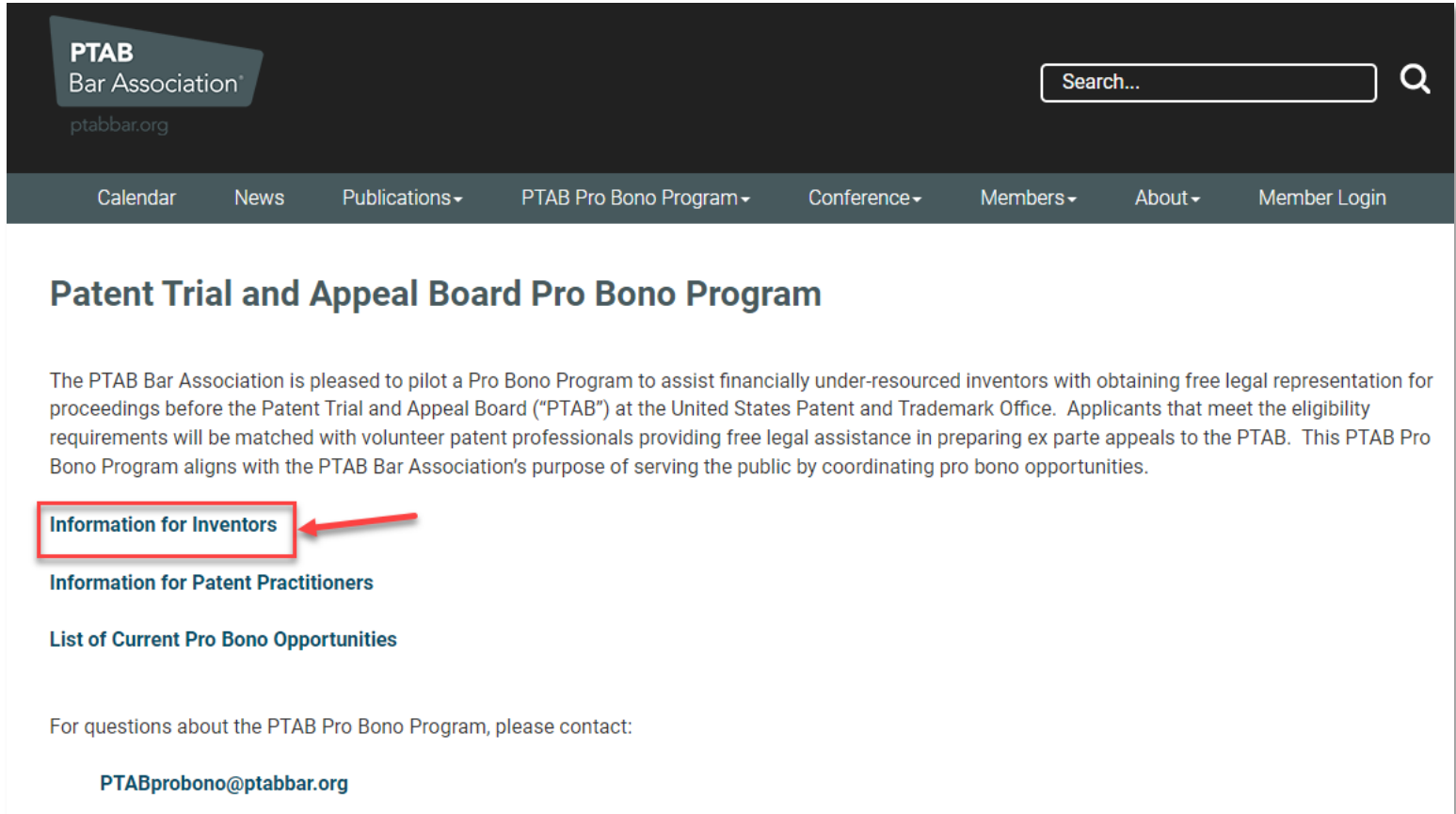
- PTABInventorHour@uspto.gov

PTAB Pro Bono Program

How to apply

Step 1: Access the inventor application form

ptabbar.org



PTAB
Bar Association[®]
ptabbar.org

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Patent Trial and Appeal Board Pro Bono Program

The PTAB Bar Association is pleased to pilot a Pro Bono Program to assist financially under-resourced inventors with obtaining free legal representation for proceedings before the Patent Trial and Appeal Board (“PTAB”) at the United States Patent and Trademark Office. Applicants that meet the eligibility requirements will be matched with volunteer patent professionals providing free legal assistance in preparing ex parte appeals to the PTAB. This PTAB Pro Bono Program aligns with the PTAB Bar Association’s purpose of serving the public by coordinating pro bono opportunities.

[Information for Inventors](#)

[Information for Patent Practitioners](#)

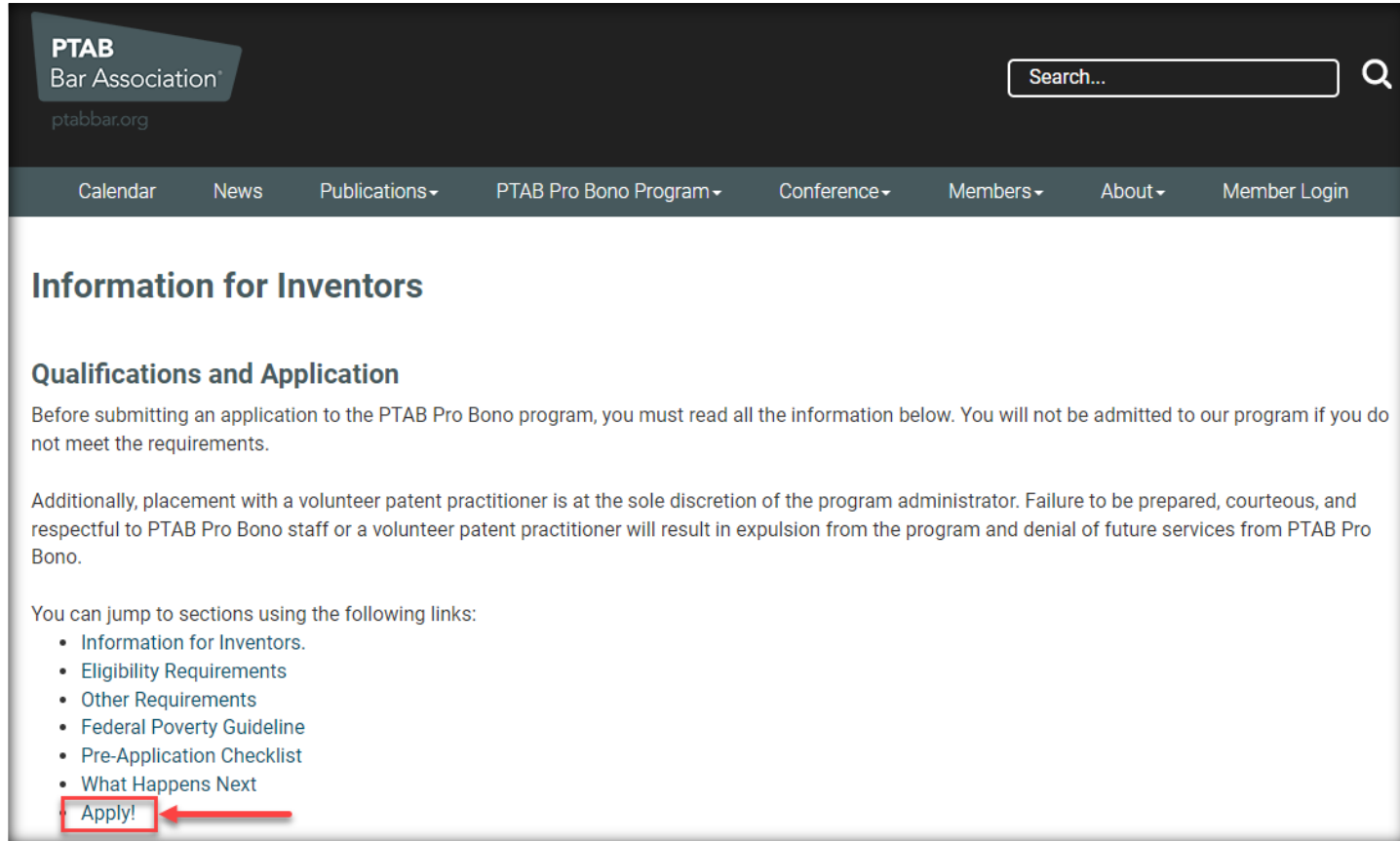
[List of Current Pro Bono Opportunities](#)

For questions about the PTAB Pro Bono Program, please contact:

PTABprobono@ptabbar.org

Step 2: Access the inventor application form

ptabbar.org



The screenshot shows the PTAB Bar Association website. The header includes the logo 'PTAB Bar Association' and the URL 'ptabbar.org'. A search bar is located in the top right corner. The navigation menu contains links for 'Calendar', 'News', 'Publications', 'PTAB Pro Bono Program', 'Conference', 'Members', 'About', and 'Member Login'. The main content area is titled 'Information for Inventors' and includes a sub-section 'Qualifications and Application'. Below this, there is a paragraph of text and a list of links. The 'Apply!' link is highlighted with a red box and a red arrow pointing to it.

PTAB
Bar Association
ptabbar.org

Search...

Calendar News Publications PTAB Pro Bono Program Conference Members About Member Login

Information for Inventors

Qualifications and Application

Before submitting an application to the PTAB Pro Bono program, you must read all the information below. You will not be admitted to our program if you do not meet the requirements.

Additionally, placement with a volunteer patent practitioner is at the sole discretion of the program administrator. Failure to be prepared, courteous, and respectful to PTAB Pro Bono staff or a volunteer patent practitioner will result in expulsion from the program and denial of future services from PTAB Pro Bono.

You can jump to sections using the following links:

- Information for Inventors.
- Eligibility Requirements
- Other Requirements
- Federal Poverty Guideline
- Pre-Application Checklist
- What Happens Next
- **Apply!**

Step 3: Access the inventor application form

ptabbar.org

Solo Inventor Application for Pro Bono Assistance - PTAB Bar Association

* indicates required fields

Submission Type
Select an Option

Personal Information

Salutation *
Select an Option

First Name *
Middle Name
Last Name *
Phone *
Email *
Address *
<https://aspe.hhs.gov/topics/poverty-economic-mobility/poverty-guidelines>
Address 2
City *
State *
Zip *

Demographic Data

Gender *
Select an Option

Ethnicity *
Select an Option

Race *
Select an Option

Veteran Status *
Select an Option

Financial Information

Do you have a household income of less than 400% (4x) federal poverty guidelines? *
Select an Option
(<https://aspe.hhs.gov/topics/poverty-economic-mobility/poverty-guidelines>)

* The PTAB Bar Association administrator may ask you to provide proof of income such as 1040 Forms submit disability payments, disability benefits, Medicaid information, etc.

Knowledge

You must demonstrate knowledge of the ex parte appeal process by successfully completing a video training video explains how the PTAB Pro Bono Program works and the second video walks through the ex parte appeal process.

Have you completed the training course offered by the USPTO? *
Select an Option

Are you currently represented by an attorney? *
Select an Option

Ownership Interest

Are you currently under a contractual obligation to assign (i.e. sell or give ownership of) the application? *
Select an Option

Patent Pro Bono Program

Has this application for appeal assistance been prosecuted by a volunteer associated with the USPTO's patent pro bono program? *
Select an Option

If yes, please provide *
Name of Regional Program

Patent Attorney/Agent Name
Patent Attorney/Agent Registration Number

* The PTAB Bar Association may reach out to 1) the prior regional program to confirm your financial status for participation and 2) your prior attorney for information on why he/she considers the application ripe for appeal.

Invention / Appeal Information

Title of Invention *
Basic Subject Area *
Bio/Lifesciences
Ornamental Design
Mechanical
Chemical
Electrical/Computer

Application No. *
select all that apply

Status of Application *
Select an Option

Date of Last Office Action *
select all that apply

Briefly describe the basis for appeal (please limit explanation to what you believe to be the error in the broadest independent claim rejected by the Examiner) *

Identify examiner error

Invention / Appeal Information

Title of Invention *

Basic Subject Area *

Bio/Lifesciences
Ornamental Design
Mechanical
Chemical
Electrical/Computer

select all that apply

Application No. *

Status of Application *

Select an Option

Date of Last Office Action *

Briefly describe the basis for appeal (please limit explanation to what you believe to be the error in the broadest independent claim rejected by the Examiner) *

PTAB Pro Bono Program

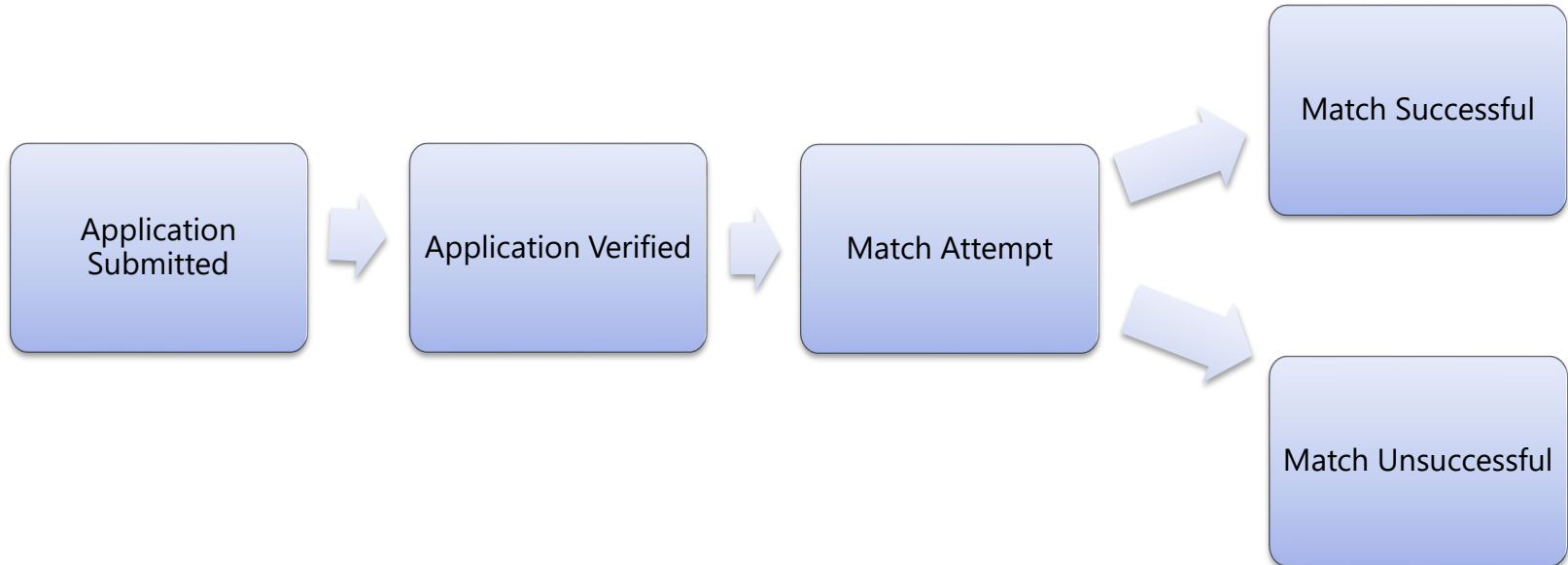
Matching

Matching

- Conducted by the Clearinghouse.
- Clearinghouse reviews application for completeness.
- Clearinghouse contacts applicant prior to matching to verify applicant.
- Placement requests are sent to all volunteers via email.
- Volunteers respond to email request if interested.
- Clearinghouse will connect volunteer with inventor via email.

Timing for matching

Placement occurs less than one month after applicant has been qualified for placement.



Volunteer patent practitioner qualifications

- Be a U.S. licensed patent attorney or patent agent.
- Have experience in the technology and proceeding type.
- Provide malpractice insurance.
- Agree to no fee for services.
- Provide a representation agreement.

Tips for success

- Fill out application completely.
 - Application number
- Be responsive to volunteer attorney throughout process.
- Be patient; process takes time and Board will not issue a decision overnight.

Question/comment submission

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Knowledge check

Question 5: true or false?

All inventors who apply for assistance will be matched with a volunteer attorney.

Answer

- **False**

- The PTAB Bar Association will attempt to match an inventor, inventor group, or inventor-owned small business with a volunteer patent practitioner, however a match is not guaranteed.

Question 6: true or false?

The PTAB Pro Bono Program can help you file your patent application.

Answer

- **False**
 - The PTAB Pro Bono Program assists with the preparing and filing of *ex parte* appeals to the PTAB.

Contact info

- PTABprobono@uspto.gov
- PTABprobono@ptabbar.org

Additional resources

<https://www.uspto.gov/learning-and-resources/access-our-free-services>

The screenshot shows the USPTO website's 'Access our free services' page. The header includes the USPTO logo, navigation links (About Us, Jobs, Contact Us, MyUSPTO), and a search bar. The main navigation menu highlights 'Learning and Resources'. The breadcrumb trail is 'Home > Learning and Resources > Access our free services'. The page title is 'Access our free services'. A paragraph explains that the USPTO offers a wide range of IP resources, including application assistance, education, and training, supporting customers from independent filers to attorneys and business advisors. It mentions the 'Council for Inclusive Innovation (CII)'. Below this, a note says 'Using the icons below, select a category to filter the list by your area of interest.' There are four filter icons: a lightbulb for 'All Resources', a ribbon for 'Patents', a registered trademark symbol for 'Trademarks', and a building for 'Attorneys and Business Advisors'. A table lists resources with columns for Title, Description, and Resource category.

Title	Description	Resource category
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.	





Future programs



Inventor Hour, Episode 21

Thursday, August 24, noon (ET)

Inventor Hour, Episode 22

Thursday, September 28, noon (ET)



