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
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)*
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

1st rejection

Applicant response to rejection

2nd rejection/final rejection

Appeal brief/Examiner’s answer

Decision by Patent Trial and Appeal Board

Request for continued examination

Notice of allowance or abandonment

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

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

<table>
<thead>
<tr>
<th>Persons in the Household</th>
<th>Poverty Level*</th>
<th>400% Poverty</th>
</tr>
</thead>
<tbody>
<tr>
<td>1</td>
<td>$14,580</td>
<td>$58,320</td>
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<td>$181,680</td>
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<tr>
<td>8</td>
<td>$50,560</td>
<td>$202,240</td>
</tr>
</tbody>
</table>

Knowledge

• An inventor must demonstrate knowledge of the program and the *ex parte* appeal process.

• Videos available at:
  
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:

  - Second Non-Final Office Action: 1 month to request assistance
  - Final Office Action: 1 month to request assistance
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 about 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.
• 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.
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PTAB Pro Bono Program

How to apply
Step 1: Access the inventor application form
ptabbar.org
Step 2: Access the inventor application form [ptabbar.org]
Step 3: Access the inventor application form
ptabbar.org
Identify examiner error

Invention / Appeal Information

Title of Invention *

Basic Subject Area *
- Bio/Lifesiences
- 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.
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.
• 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
Questions?
Future programs

Inventor Hour, Episode 21
Thursday, August 24, noon (ET)

Inventor Hour, Episode 22
Thursday, September 28, noon (ET)