Patent Trial and Appeal Board
Inventor Hour: Episode 21

Michael Astorino, Administrative Patent Judge
Janet Gongola, Vice Chief Administrative Patent Judge
Ulrike Jenks, Administrative Patent Judge
John Schneider, Administrative Patent Judge

Special guest:
Scott Boalick, Chief Administrative Patent Judge
What is the Patent Trial and Appeal Board?

**PTAB**
- *ex parte appeals, AIA proceedings, other*

**TTAB***
- *ex parte appeals, inter partes proceedings*

**PATENTS**
- *examine patent applications and grant patents*

**TRADEMARKS**
- *examine and register trademarks*

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

1. Meet a PTAB judge
2. Trial Byte: AIA petition challenges
3. Hearing byte: Using demonstratives
4. 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 a PTAB judge

Scott R. Boalick, Chief Administrative Patent Judge
Question/comment submission

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Access USPTO free services

https://www.uspto.gov/learning-and-resources/access-our-free-services
Ulrike Jenks, Administrative Patent Judge

Trial Byte:
Types of challenges in an AIA petition
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
11. Abandon
The patent issued –
What can happen next?
Post-grant timeline for presenting an AIA challenge to a patent

Application filed on or after 3/16/2013

PGR – filed up to 9 months

Ex parte Reexamination, Reissue, Supplemental Examination

IPR – 9 months after patent issues
What is the difference between a PGR or IPR proceeding?

<table>
<thead>
<tr>
<th>Type of challenge</th>
<th>Post grant review (PGR) (filing time line is between 0-9 month date)</th>
<th>Inter Partes Review (IPR) (earliest is from 9 month – end of patent term)</th>
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<tbody>
<tr>
<td>35 U.S.C. § 101</td>
<td>![checkmark]</td>
<td></td>
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<tr>
<td>Eligibility</td>
<td>![checkmark]</td>
<td></td>
</tr>
<tr>
<td>35 U.S.C. § 112</td>
<td>![checkmark]</td>
<td>![checkmark]</td>
</tr>
<tr>
<td>written description / enablement</td>
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<td></td>
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<tr>
<td>35 U.S.C. § 102</td>
<td>![checkmark]</td>
<td>![checkmark]</td>
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<tr>
<td>Novelty</td>
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<tr>
<td>35 U.S.C. § 103</td>
<td>![checkmark]</td>
<td>![checkmark]</td>
</tr>
<tr>
<td>non-obviousness</td>
<td>![checkmark]</td>
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</table>

* Not best mode
Difference in the institution standards

“reasonable likelihood”

“more likely than not”
Evidence available for a petition

<table>
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<tr>
<th>Type of art / evidence</th>
<th>Post grant review (PGR) (filing time line is between the 0-9 month date)</th>
<th>Inter Partes Review (IPR) (earliest from 9 month – end of patent term)</th>
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<tr>
<td>Patents / Patent publications</td>
<td>✔️</td>
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<tr>
<td>Printed publications</td>
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<td>On-sale activity</td>
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<td>Public use</td>
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Patents for Humanity: Green Energy

• The USPTO is expanding the **Patents for Humanity Awards Program** to include a new category for those who are responding rapidly to the challenges of climate change by **developing green energy sources** using game-changing technologies.

• Any U.S. patent or patent application that is directed to **green energy technologies** is eligible for this award.

• Submission deadline has been extended to **September 15, 2023**

What are demonstratives?

- Aids to presenting your argument
- Presentation software (e.g. PowerPoint)
- Physical exhibits
Demonstratives

• Not part of the record
• Must be supported by the record
  – Provide citations
• No new evidence or arguments
Keep it simple

• Avoid large blocks of text
• Focus on key points
• Don’t make it too long
• Highlight key points or elements
By "crystallization-resistant sugar" is meant a mono-or disaccharide or mixture of mono- and/or disaccharides, which crystallizes, at the water content and water activity encountered in the semimoist cookies of the home-baked type, substantially more slowly than sucrose under the same conditions, typically remaining uncrystallized for periods of at least 1-6 months. Particularly good crystallization resistant sugars are fructose, dextrose, and mixtures of sugars of which fructose and dextrose together comprise at least about 15% by weight, and solutions thereof. Others include psicose fructose, sorbose, tagatose, allose, altrose, mannose, gulose, idose, galactose, talose, maltose, and lactose.

US Patent 4,455, 333, col. 5, ll. 25-37
By *crystallization-resistant sugar* is meant a mono-or disaccharide or mixture of mono- and/or disaccharides, which crystallizes, at the water content and water activity encountered in the semimoist cookies of the home-baked type, substantially more slowly than sucrose under the same conditions, typically remaining uncrystallized for periods of at least 1-6 months. Particularly good crystallization resistant sugars are fructose, dextrose, and mixtures of sugars of which fructose and dextrose together comprise at least about 15% by weight, and solutions thereof. Others include psicose fructose, sorbose, tagatose, allose, altrose, mannose, gulose, idose, galactose, talose, maltose, and lactose.

US Patent 4,455, 333, col. 5, ll. 25-37
Keep it short

• Appeal – 20 minutes
• AIA proceeding – Typically 60 minutes per side including rebuttal
• At best one slide a minute
Suggestion

• Main presentation covering key issues
• Supplement with backup slides to use if needed
Keep it simple
Know your presentation

• Be able to move about the slide deck
  – Page number then enter
• Don’t be wedded to the order of the slides
• Know your opponent’s slides
The hearing

• Provide copies in advance
• Give page cites
“We Have Met the Enemy and He Is PowerPoint”

NY Times, April 26, 2010
Additional guidance


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– PTABInventorHour@uspto.gov
PTAB contact info

By telephone:
- 571-272-9797 (general; appeals; and interferences)
- 571-272-7822 (trials; and PTACTS)

By email:
- PTAB_Appeals_Suggestions@USPTO.GOV
- Trials@uspto.gov
- PTABStatisticsQuestions@USPTO.GOV
- PTABOutreach@uspto.gov
- PTABP-TACTSAdmin@uspto.gov
Weigh-in on future Inventor Hour topics

**Interviews** with inventors, PTAB judges, examiners, lawyers, trademarks, other areas of the patent office?

Review of **substantive patent law** like anticipation, enablement, utility, obviousness, restriction practice, appeals?

Identification of **resources** for inventors?

Inventor **success stories**?

**Practical tips** on working with the patent office?

**Something entirely new?**

Send your wish list to - **PTABInventorHour@uspto.gov**
Questions?
Future programs

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

Inventor Hour, Episode 23
Thursday, October 26, noon (ET)