Patent Trial and Appeal Board
Inventor Hour webinar: episode 2

Kalyan Deshpande, Senior Lead Judge
Jeff Fredman, Administrative Patent Judge
Eric Jeschke, Administrative Patent Judge
Ryan Flax, Administrative Patent Judge

Scott Raevsky, Administrative Patent Judge
Cynthia Hardman, Administrative Patent Judge
Troy Tyler, Board Executive
Kulunie Cannon, Deputy Clerk for Hearings

September 23, 2021
Agenda

• Meet a Board Operations Division member
• Appeal Byte: what is an ex parte appeal?
• Walkabout the PTAB webpage
• Trial Byte: AIA proceedings overview
• Hearings Byte: hearings logistics
• Case study
Question/comment submission

To send in questions or comments during the webinar, please email:

PTABInventorHour@uspto.gov
Meet a Board Operations Division member: Troy Tyler
Troy Tyler
Board Executive
Appeal Byte:
what is an ex parte appeal?

Jeff Fredman, Administrative Patent Judge
Ex parte appeal process

Notice of Appeal & Fee

Appeal Brief

Examiner’s Answer

Appeal Brief Forwarding Fee

Decision by Board

Completion of Appeal Process

Reply Brief (optional)

Oral Hearing Request & Fee (optional)

Oral Hearing (if requested)

Request for Rehearing (optional)
Ex parte appeal process

Notice of Appeal & Fee

Appeal Brief

Examiner’s Answer

Appeal Brief Forwarding Fee

Reply Brief (optional)

Oral Hearing Request & Fee (optional)

Oral Hearing (if requested)

Decision by Board

Completion of Appeal Process

Request for Rehearing (optional)
Ex parte appeal process

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

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

- Notice of Appeal & Fee
- Appeal Brief
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Ex parte appeal process

1. Notice of Appeal & Fee
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   - Request for Rehearing (optional)
Question/comment submission

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PTABInventorHour@uspto.gov
Inventor resources
www.uspto.gov
Walkabout the PTAB webpage

Eric Jeschke, Administrative Patent Judge
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
- New to PTAB?
- Trial proceedings
- Appeals proceedings
- Preparing for hearings
- Fees

Decisions
- All PTAB decision data
- AIA daily decisions
- Precedential and informative decisions
- Precedential Opinion Panel (POP)

Learn more
- Resources and guidance
- Statistics
- Databases and IT tools
- Frequently asked questions
- Boardside Chat webinar series
- PTAB suggestion box and contact info
- Recent proposals, pilots and final rules
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?

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
Trials

Information about proceedings conducted by the Patent Trial and Appeal Board (PTAB), including inter partes review, post-grant review, the transitional post-grant review for covered business method patents, derivations, and interferences.

**Proposed changes**
Possible revisions to AIA trial proceedings for public comment

**Statutes and rules**
America Invents Act (AIA) trials, statutes, and rules: amendments to the rules; reference guide to statutes; and final rules and the practice guide

**AIA trial types**
Comparisons and descriptions of AIA trial types

**Hearings**
Hearing procedures and calendars

**Guidance**
Guidance for conducting trial proceedings

**Representative orders, decisions and notices**
Orders, decisions and notices from representative AIA trials

**Interferences**
Resources for interference practice

**Statistics**
AIA trial statistics

**PTAB End to End**
Tools for filing or searching AIA cases

**FAQs**
Frequently asked questions about trials
Information about ex parte appeals conducted by the Patent Trial and Appeal Board (PTAB) from adverse decisions of examiners in patent applications, reissue applications, and reexamination proceedings.

Appeals – General Process

- Notice of Appeal & Fee
- Appeal Brief
- Examiner’s Answer
- Decision by Board
- Completion of Appeal Process

Expand all | Collapse all

- General process
- Resources
- Frequently asked questions (FAQs)

Please send suggestions regarding the appeals process to the Board at PTAB Appeals Suggestions.
Hearings

An appellant in an exparte appeal and the parties in an AIA trial may request an oral hearing to explain their position before the Patent Trial and Appeal Board (PTAB). An oral hearing gives the Board an opportunity to ask questions of the parties to aid the Board in deciding the case. An oral hearing may be held in a courtroom with a court reporter present to prepare a transcript of the proceeding.

Expand all | Collapse all

Hearing schedule

Until further notice, Patent Trial and Appeal Board (PTAB) oral hearings will be conducted remotely by video or telephone. During this time, to listen in on any particular oral hearing, please make a request via email to PTABHearings@uspto.gov at least three business days prior to the oral hearing date. Please include any requests for accommodations for individuals with disabilities, including captioning. The Board will respond to the request, and provide any connection information. Transcripts for each oral hearing will subsequently be entered into the record of the relevant proceeding, and be publicly available in PTAB E2E for AIA Trials or in Public Pair for appeals, unless an exception applies.

NOTE: Due to last minute cancellations or no shows, there are no guarantees that a hearing on a particular proceeding will occur, although it may be posted.

* PTAB September 2021 Hearing Schedule (PDF)
* PTAB October 2021 Hearing Schedule (PDF)

Hearing guidance
<table>
<thead>
<tr>
<th>Fee code</th>
<th>37 CFR §</th>
<th>Description</th>
<th>Fee (Regular)</th>
<th>Fee (Small)</th>
<th>Fee (Micro)</th>
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<tbody>
<tr>
<td>1405/2405/3405</td>
<td>41.20(a)</td>
<td>Petitions to the Chief Administrative Patent Judge under 37 CFR 41.3</td>
<td>420.00</td>
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<td>210.00*</td>
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<td>42.15(a) (1)</td>
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</table>
Question/comment submission

To send in questions or comments during the webinar, please email:

PTABInventorHour@uspto.gov
Cynthia Hardman, Administrative Patent Judge

Trial Byte: AIA proceedings overview
## Types of AIA Proceedings

<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>
</tr>
<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>
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</tbody>
</table>
AIA Proceeding Timeline

**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

**Timeline Details**
- PO Discovery
- Pet Discovery
- PO Period
- Motions on Evidence

**Duration**
- No more than 12 months (*by statute)
Petition Phase: Briefing

**Petition Phase**
- Petition Filed
- PO Prelim. Resp.
- Decision on Petition

**Trial Phase**
- PO Resp. & MTA
- Pet. Reply & Opp. to MTA
- PO Sur-Reply & Reply to Opp.

- Oral Hearing (on request)
- Final Written Decision

No more than 12 months (*by statute)
PETITION PHASE

- Petition Filed
- PO Prelim. Resp.
- Decision on Petition

TRIAL PHASE

- PO Resp. & MTA
- Pet. Reply & Opp. to MTA
- PO Sur-Reply & Reply to Opp.
- Oral Hearing (on request)
- Final Written Decision

PETITION PHASE: Institution

- No more than 12 months (*by statute)
**Trial Phase: Briefing**

**Petition Phase**
- Petition Filed: 3 mos
- PO Prelim. Resp.: 3 mos max
- Decision on Petition: 3 mos

**Trial Phase**
- PO Discovery: 3 mos
- Pet. Reply & Opp. to MTA: 3 mos
- PO Sur-Reply & Reply to Opp.: 1 mo
- Oral Hearing (on request)
- Final Written Decision

**No more than 12 months** (*by statute*)
Trial Phase: Evidence Motions & Hearing

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

**TRIAL PHASE**
- PO Resp. & MTA
- Pet. Reply & Opp. to MTA
- PO Sur-Reply & Reply to Opp.
- Oral Hearing (on request)
- Final Written Decision

**PETITION PHASE TIMELINE**
- PetitionFiled: 3 mos
- PO Prelim. Resp.: 3 mos max
- Decision on Petition: 3 mos

**TRIAL PHASE TIMELINE**
- PO Resp. & MTA: 3 mos
- Pet. Reply & Opp. to MTA: 1 mo
- PO Sur-Reply & Reply to Opp.: 1 mo
- Oral Hearing (on request): No more than 12 months (*by statute*)
- Final Written Decision: No more than 12 months (*by statute*)
Trial Phase: Final Written Decision

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

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

**Final Written Decision**

No more than 12 months (*by statute)
Question/comment submission

To send in questions or comments during the webinar, please email:

PTABIInventorHour@uspto.gov

Kulunie Cannon, Deputy Clerk for Hearings

Hearings Byte: hearings logistics
Hearings

• Oral hearings can be requested in both ex parte appeals and AIA trials
• This presentation gives an introduction to logistics common to both types of hearings
Remote hearings
In-person hearings

Alexandria, Virginia

Detroit, Michigan

Dallas, Texas

Denver, Colorado

San Jose, California
Additional resources

- For more hearings information, visit uspto.gov/patents/ptab/hearings

- You will find:
  - PTAB Hearings Guide
  - Hearing Locations
  - Forms and Samples
  - Hearing Schedule
Question/comment submission

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PTABInventorHour@uspto.gov
Scott Raevsky, Administrative Patent Judge

Case study
Case studies goals

• Provide insight into patent prosecution
• Show how the inter partes review (IPR) framework requires a case-specific and fact-intensive inquiry
• Answer questions regarding PTAB’s current approach
1. An inflatable solar-powered light, comprising:

   an expandable bladder including a plurality of surfaces;

   a solar-powered light assembly positioned on at least one of said plurality of surfaces of said bladder; and

   one or more cover portions positioned over said assembly and joined with said at least one of said plurality of surfaces of said bladder around edges of said one or more cover portions, wherein at least a portion of at least one of said at least one or more cover portions is substantially transparent and each of said one or more cover portions forms a substantially waterproof envelope with said at least one of said plurality of surfaces of said bladder in which said solar-powered light assembly is contained.
Claim 1 as allowed by the Examiner

1. An inflatable solar-powered light, comprising:
   an expandable bladder having a plurality of surfaces that
   include a first plastic surface sealed at its edges and a
   second plastic surface opposed to the first plastic surface
   and sealed at its edges, the expandable bladder having a
   collapsed state and an expanded state; and
   a solar-powered light assembly positioned on the first plastic surface and having:
   a circuit board,
   a rechargeable battery electrically connected to the circuit board,
   a solar panel on a first side of the circuit board and electrically connected to the circuit board, and positioned to aim outside the bladder in the collapsed state and the expanded state,
   at least one light-emitting diode opposed to the solar panel and attached to a second side of the circuit board to aim toward the second plastic surface when the bladder is in the collapsed state and the expanded state,
   wherein a substantially transparent cover portion covers the solar panel and circuit board, and is substantially waterproof, and wherein the first surface and the second surface lie flat adjacent each other when the bladder is collapsed.
Mpowerd v. Luminaid Lab, LLC
IPR2018-01524, Paper 51 (Mar. 27, 2020)

- IPR process
  - Aug. 8, 2018 Mpowerd filed an IPR petition
  - Feb. 26, 2019 PTAB instituted IPR trial (Paper 6) and included a scheduling order (Paper 7)
  - May 17, 2019 Patent Owner Luminaid filed a response to the IPR petition supported by a Declaration showing reduction to practice before the filing of the prior art
Mpowerd v. Luminaid Lab, LLC
IPR2018-01524, Paper 51 (Mar. 27, 2020)

• IPR process (continued)
  – July 25, 2019  Petitioner Mpowerd deposed Declarant
  – Aug. 16, 2019  Petitioner Mpowerd filed a reply to the Patent Owner Luminaid’s response
  – Aug. 28-Oct. 21, 2019  A variety of motions were filed, including motions to seal, to exclude, and to allow live testimony
  – Nov. 4, 2019  Oral hearing with live testimony
  – Feb. 25, 2020  A Final Written Decision was issued in favor of Patent Owner Luminaid
Takeaways

• Careful examination and appropriate claim amendments help limit the universe of relevant prior art, limiting opportunities for successful challenges

• An institution decision is not the final result

• Evidence supporting a position is always important, and here the evidence was dispositive for Patent Owner Luminaid
Question/comment submission

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PTABInventorHour@uspto.gov
Next Inventor Hour webinar

• **October** 28, 2021, at noon to 1 p.m. ET

• Topics
  – Meet a member of PTAB
  – Appeal Byte (how a decision is reached)
  – Walkabout the PTAB webpage
  – Trial Byte (pre-institution strategies for patent owners)
  – PTAB: a storied history
Future Inventor Hour webinars

- **November** 18, 2021, at noon to 1 p.m. ET
- **December** 16, 2021, at noon to 1 p.m. ET