Patent Trial and Appeal Board
Inventor Hour webinar: **Episode 4**

Tawen Chang, Administrative Patent Judge
Ryan Flax, Administrative Patent Judge
Steven Fulk, Supervisory Patent Attorney
Janet Gongola, Vice Chief Judge
Ulrike Jenks, Administrative Patent Judge
Meredith Petravick, Administrative Patent Judge

January 27, 2022
Today’s agenda

1. Meet a Patent Attorney
2. Hearing Byte
3. Trial Byte
4. How PTAB Fits Into IP Landscape
5. Case Study
6. Q&A
Question/Comment Submission

• To send in questions or comments about the presentation, please email:
  – PTABInventorHour@uspto.gov
Meet a Patent Attorney:
Supervisory Patent Attorney Steven Fulk
Hearing Byte:

Ex Parte Appeal 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

- Oral Hearing (if requested)
- Request for Rehearing (optional)
- Reply Brief (optional)
- Oral Hearing Request & Fee (optional)
Hearings: *Ex Parte* Appeals

- What to expect
- What to present
- How to prepare
Question/Comment Submission

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Finding a Patent Practitioner


- The USPTO Office of Enrollment and Disciple 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
Trial Byte:
Institution Decision

Meredith Petravick, Administrative Patent Judge
PTAB Institution Decision

**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*)
Overview of Institution Decision

The Board issues a written decision indicating whether it will start an AIA trial.

Petitioner must demonstrate a reasonable likelihood that it would prevail with respect to at least 1 of the claims challenged in IPR petition (PGR standard is more likely than not).
Overview of Institution Decision

If the Board institutes a trial, it will institute on all claims and challenges raised in the petition.
Overview of Institution Decision

Based on the state of the record at institution, the Board will generally provide parties guidance about the Board’s preliminary views on the parties’ competing arguments.

This guidance allows parties to focus their arguments and may inform other options such as settlement, claim amendment, claim disclaimer, or request for adverse judgment on some claims or grounds.
Overview of Institution Decision

- Party dissatisfied with the Board’s institution decision may request rehearing as to points the Board overlooked or misapprehended

- Institution decisions are generally not appealable
Overview of Institution Decision

The Board will enter a **Scheduling Order** concurrent with a decision to institute a trial

– Scheduling Order sets due dates for the trial to ensure completion within one year of institution

– sample Scheduling Order is available in the Trial Practice Guide ([available at www.uspto.gov/TrialPracticeGuideConsolidated](http://www.uspto.gov/TrialPracticeGuideConsolidated))
Question/Comment Submission

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Inventors Digest

https://www.inventorsdigest.com

• Monthly issues, each featuring articles about USPTO
• Monthly articles about PTAB
• Free online
How PTAB Fits Into IP Landscape: District Court / PTAB / ITC
Forums for Challenging Patents

- U.S. District Courts
- USPTO
- ITC
Forums for Challenging Patents

U.S. District Courts

USPTO

ITC
U.S. District Courts

Infringement defendants

Declaratory judgment plaintiffs
U.S. District Courts: Invalidity Grounds

- Patent eligibility
- Obviousness
- Anticipation
- On-Sale Bar
- Derivation
- Enablement
- Indefiniteness
- Written description
U.S. District Courts: Invalidity Grounds

CLEAR AND CONVINCING BURDEN OF PROOF
U.S. District Courts: Issues of Note

- Broad discovery
- Unpredictable timing
- Layperson jury
- High costs
U.S. District Courts: Invalidity grounds

Determination on patent validity → Appeal to Federal Circuit → Petition to Supreme Court
Forums for Challenging Patents

U.S. District Courts

USPTO

ITC
Patent Trial and Appeal Board

AIA Proceedings

Inter Partes Review

Post-Grant Review

Derivation Proceeding
PTAB: Invalidity grounds

Patent eligibility

Obviousness

On-Sale Bar

Anticipation

Written description

Enablement

Indefiniteness

IPR & PGR

IPR & PGR

PGR

PGR

PGR
PTAB: Invalidity grounds

- Patent eligibility
- Invention
- Anticipation
- On-Sale Bar
- Obviousness
- Written description
- Enablement
- Indefiniteness

PREPONDERANCE OF THE EVIDENCE BURDEN OF PROOF

IPR & PGR

Enablement

PGR

PGR

PGR
PTAB: Issues of note

- Narrower discovery
- Burden of Proof
- 3 technically trained judges, no jury
- Fast and predictable timing
- Lower costs
Patent Trial and Appeal Board: After a Final Written Decision

Request rehearing or POP review

Board panel or Director review

Appeal (Fed. Cir.)
Forums for Challenging Patents

U.S. District Courts

USPTO

ITC
International Trade Commission

Section 337 investigations
International Trade Commission

- Same defenses as in District Court
- No Declaratory Judgement attacks
- Expeditious
- No jury
- Broad, but rapid discovery
- ITC ruling has no effect outside ITC
Question/Comment Submission

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Inventor resources
www.uspto.gov
Ulrike Jenks, Administrative Patent Judge

Inventor Case Study:
Guy A. Shaked Investments LLC
Inventor Case Study: Goals

- Provide **insight** into patent prosecution
- Show how the **inter partes review (IPR) framework** requires case-specific and fact-specific inquiry
- Answer questions regarding PTAB’s current approach
U.S. Patent No. 9,578,943
(filed as U.S. App. No. 14/975,783)

Figure 1A
1. A brush comprising:

   a plurality of heating elements protruding from a face of the brush, the heating elements dispersed on at least a part of the brush’s face at a specified density; and

   a plurality of spacers arranged to maintain a specified distance between protruding ends of the heating elements and a scalp of a head that is being brushed, the spacers dispersed on the at least part of the brush’s face at a specified density that assures maintaining the specified distance with respect to a resilience of the spacers.
Claim 1 as **allowed** by the Examiner

1. A hairbrush, comprising:
   a heating plate extending over a face of the hairbrush;
   a plurality of heating elements thermally coupled to the
   heating plate and protruding from only the face of the
   hairbrush; the plurality of heating elements defining a
   hair treating area disposed on at least a part of the
   hairbrush’s face at a specified density, the plurality of
   heating elements arranged in a plurality of lengthwise
   rows, each of the plurality of lengthwise rows including
   a number of the plurality of heating elements;
   wherein, for each of the plurality of lengthwise rows, the
   heating elements thereof are offset relative to the heat-
   ing elements in an adjacent one of the plurality of
   lengthwise rows;
   a plurality of heat insulating spacers projecting outwardly
   from at least some of the plurality of heating elements,
   thereby providing a space between the plurality of
   heating elements and a user’s scalp during use; and
   a plurality of heat insulating elongate peripheral spacers
   disposed at least around a portion of the hair treating
   area of the hairbrush.
Ontel Prods. Corp. v. Guy A. Shaked Invs. LTD.,
IPR2020-01703, Paper 12 (Apr. 13, 2021)

- Sept. 28, 2020: Ontel filed an IPR petition
- Jan. 18, 2021: Shaked filed a Preliminary Patent Owner Response
- Apr. 13, 2021: PTAB denied institution
Takeaways

- Consideration of relevant prior art during examination and appropriate claim amendments help limit the universe of relevant prior art for post-grant challenges, thereby limiting opportunities for successful challenges.

- A well-drafted preliminary response may result in a decision not to institute.

- Consider how limitations in a claim may make the claim less susceptible to challenge.
Question/Comment Submission

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Next Inventor Hour webinar

- **February 24, 2022**, at noon to 1 p.m. ET
  - Meet a judge
  - How PTAB fits in: Appeals from PTAB
  - Inventor case study
  - Appeal byte