

# Patent Trial and Appeal Board Inventor Hour: Episode 22

**Ryan Flax**, Lead Administrative Patent Judge

**Meredith Petravick**, Administrative Patent Judge

**John Schneider**, Administrative Patent Judge

Special guests:

**Melanye Johnson**, Acting Deputy Chief Administrative Trademark Judge

**Mariessa Terrell**, Attorney Advisor for Trademark Customer Outreach

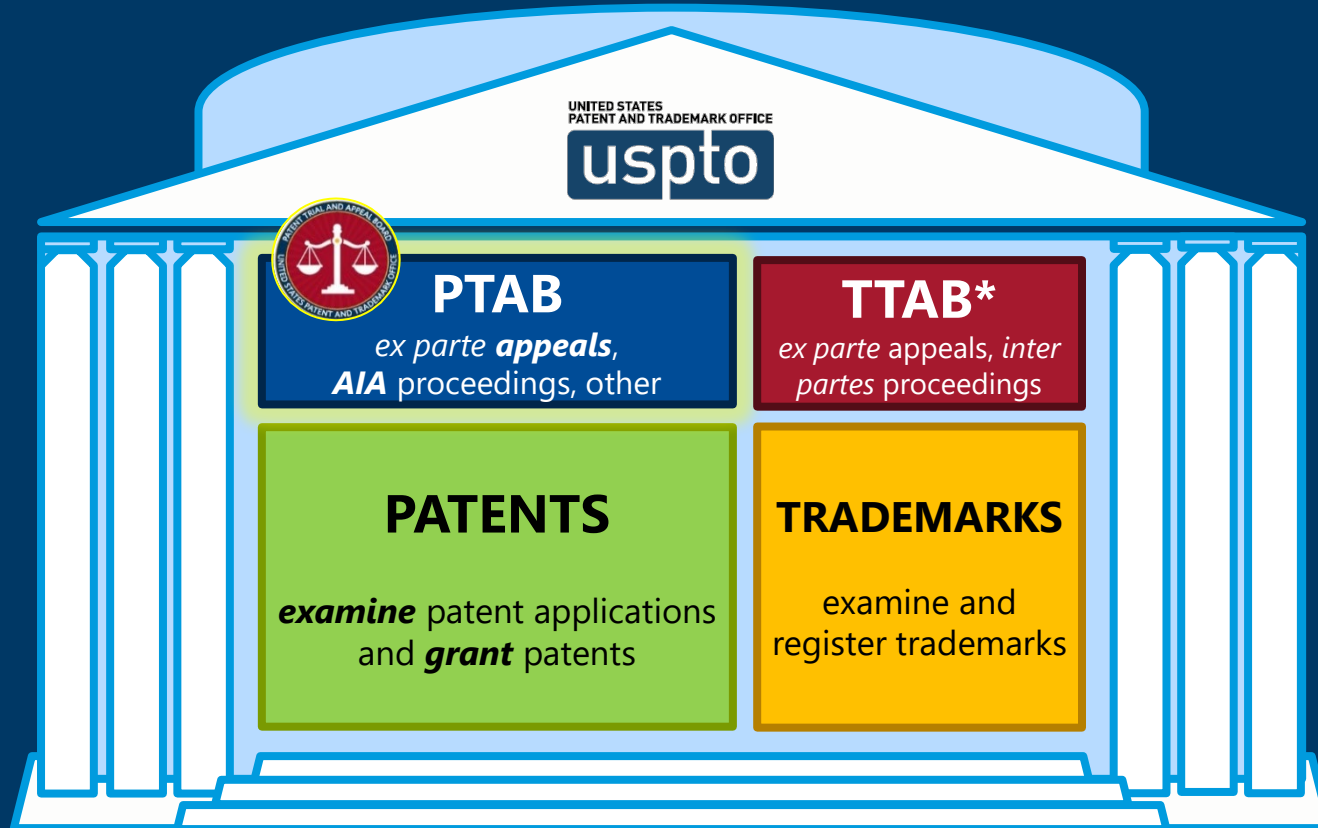
**Sophia Johnson**, National Inventors Hall of Fame Museum

September 28, 2023



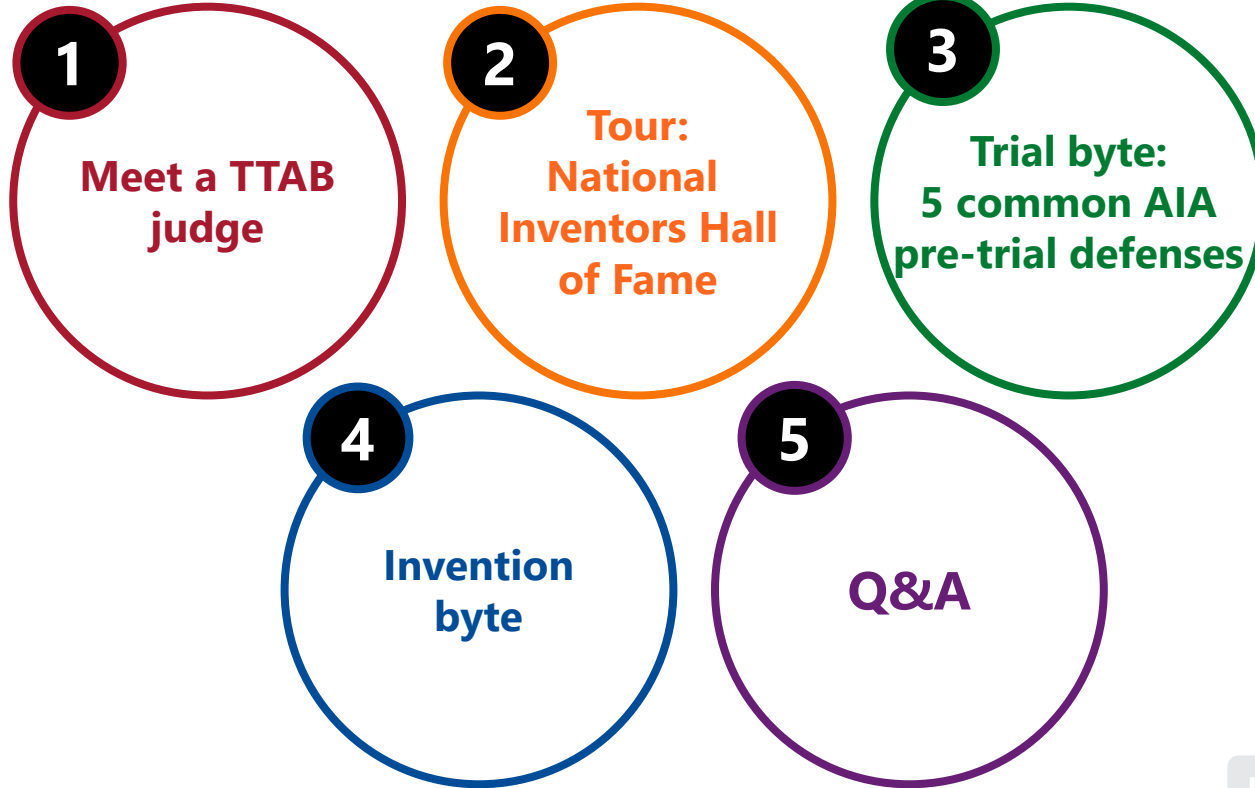
UNITED STATES  
PATENT AND TRADEMARK OFFICE ®

# What is the Patent Trial and Appeal Board?



\*Trademark Trial and Appeal Board (TTAB)

# Today's Agenda



# Question/comment submission

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Mariessa Terrell, Attorney Advisor for Trademark Customer Outreach



## **Meet a TTAB Judge**

Melanye Johnson, Acting Deputy Chief  
Administrative Trademark Judge



**Melanye Johnson**  
*Acting Deputy Chief  
Administrative Trademark Judge*

# Question/comment submission

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For questions contact [probono@uspto.gov](mailto:probono@uspto.gov)

**Info & Registration:** [www.uspto.gov/about-us/events/patent-pro-bono-program-pathways-inclusive-innovation-0](http://www.uspto.gov/about-us/events/patent-pro-bono-program-pathways-inclusive-innovation-0)





Meredith Petravick , Administrative Patent Judge



# **Trial byte:**

**5 common AIA pre-trial defenses**

# Pre-Institution Petition Phase



Patent Owners have the *option* to file a Preliminary Response.



# Common pre-trial IPR defenses

1. Arguing that institution is **barred**
2. Arguing failure to identify each ground of challenge **with particularity**
3. Arguing the institution **burden** not met, e.g., no reasonable likelihood of unpatentability in IPRs
- 4. Disclaiming** weaker claims
5. Requesting **discretionary denial**



# #1: Arguing that institution is barred

No institution if:

before the date on which the petition is filed, the petitioner or real party in interest filed a civil action challenging the validity of a claim of the patent; or

the petition is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent

35 U.S.C. § 315 (a)(1) & (b)



## #2: Arguing failure to identify each ground of challenge with particularity

For example,

“A petition... may be considered only if... the petition identifies, in writing and **with particularity**, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim... .”

35 U.S.C. § 312(a)(3)



# #3: No reasonable likelihood

*Inter partes* review may not be “instituted unless the Director determines that the information presented in the petition filed... and any response filed... shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

35 U.S.C. § 314(a)

## #4: Disclaimer of claims

“No inter partes review will be instituted based on **disclaimed** claims.”

37 C.F.R. § 42.107(e).

# #5: Requesting discretionary denial

The Director is “permitted, but **never compelled**” to institute IPR or PGR.

*Harmonic Inc. v. Avid Tech. Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016); 35 U.S.C. § 314



# #5(a): Discretionary denial: Multiple petitions

Institution may be denied where **multiple petitions** are filed against the same patent.

# #5(a): Discretionary denial: Multiple petitions

## *General Plastics Factors*

1. whether the **same petitioner** previously filed a petition directed to the same claims of the same patent;
2. whether at the time of filing of the first petition the **petitioner knew of the prior art** asserted in the second petition or should have known of it;
3. whether at the time of filing of the second petition the petitioner already received the patent owner's **preliminary response** to the first petition or received the Board's decision on whether to institute review in the first petition;
4. the length of **time** that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
5. whether the petitioner provides adequate **explanation** for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
6. the finite **resources** of the Board; and
7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than **1 year** after the date on which the Director notices institution of review.

*General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB, Sept. 6, 2017)  
(precedential)

# #5(b): Discretionary denial: Parallel litigation

Institution may be denied based on the state of a [parallel litigation](#) in district court.

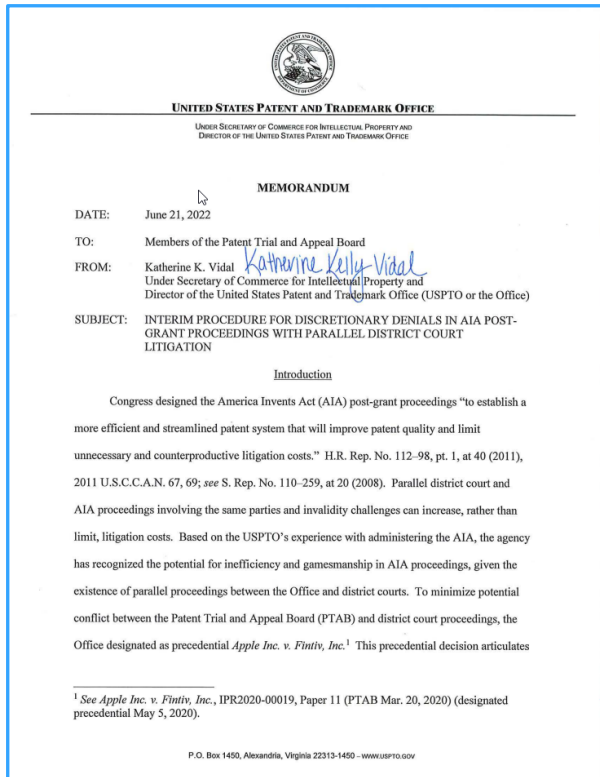
# #5(b): Discretionary denial: Parallel litigation

## *Fintiv* Factors

1. whether the court granted a **stay** or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court's **trial date** to the Board's projected statutory deadline for a final written decision;
3. the **investment** in the parallel proceeding by the court and the parties;
4. the **overlap** between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the **same party**; and
6. other circumstances that impact the Board's exercise of discretion, including the **merits**.

*Apple v. Fintiv*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential)

# #5(b): Discretionary denial: Parallel litigation



**Director’s Memo** clarifies when and how the Board will apply the *Fintiv* factors. For example, when the Petition presents “compelling merits” or Petitioner provides a “*Sotera*” Stipulation.



## #5(c): Discretionary denial: Same art/ arguments

Institution may be denied if **the same or substantially the same** prior art or arguments previously were **presented to the Office**.

35 U.S.C. § 325(d)

# #5(c): Discretionary denial: Same art/ arguments

## ***Advanced Bionics* two-part framework**

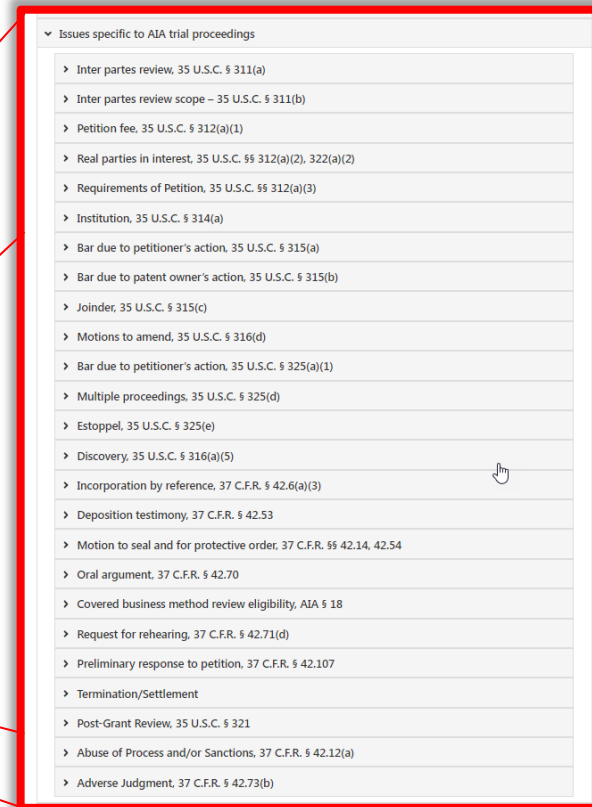
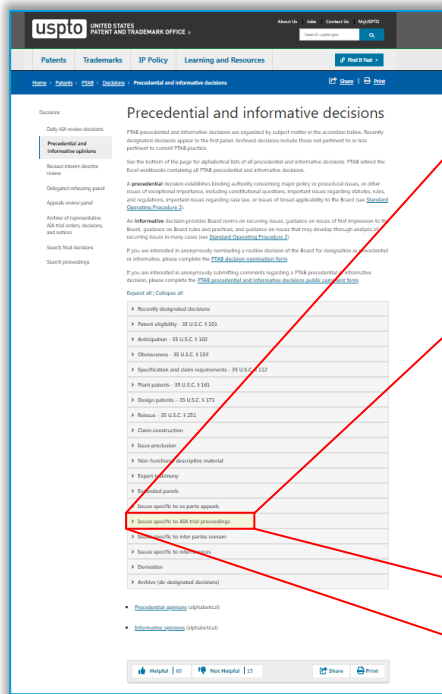
(1) whether **the same or substantially the same art** previously was presented to the Office or whether **the same or substantially the same arguments** were previously presented to the Office

(2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office **erred in a manner material to the patentability** of challenged claims

*Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020)(precedential)



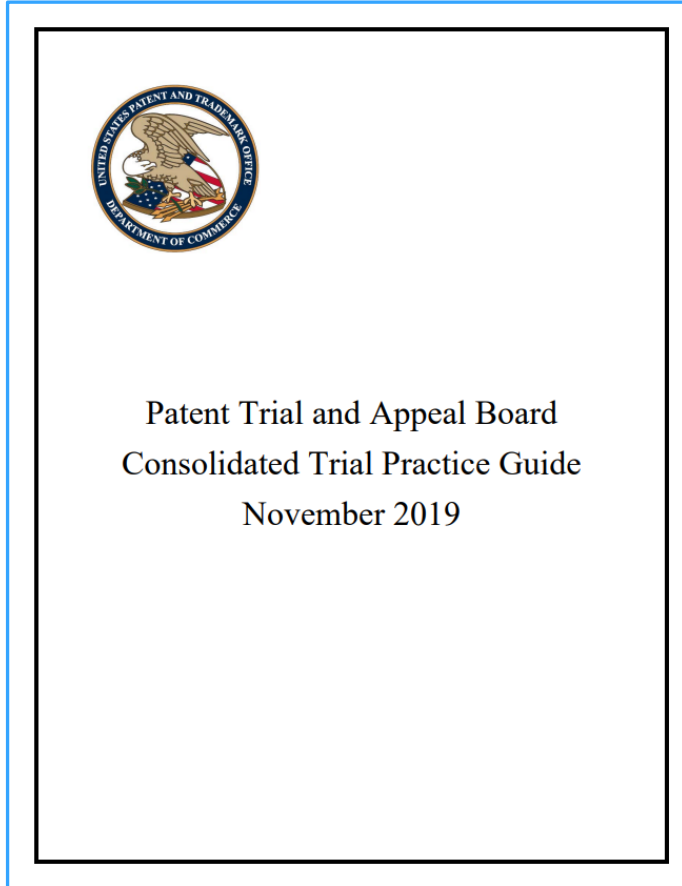
# Precedential and informative decisions website



Located at: [www.uspto.gov/patents/ptab/precedential-informative-decisions](http://www.uspto.gov/patents/ptab/precedential-informative-decisions)



# Additional resource



Located at:

[www.uspto.gov/about-us/news-updates/consolidated-trial-practice-guide-november-2019](https://www.uspto.gov/about-us/news-updates/consolidated-trial-practice-guide-november-2019)



# Question/comment submission

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For more information, see [www.uspto.gov/FirstTimePatentFiler](http://www.uspto.gov/FirstTimePatentFiler)



Sophia Johnson, Associate Director of Government Relations



**National Inventors Hall of Fame**  
**50<sup>th</sup> Anniversary**

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John E Schneider, Administrative Patent Judge



# **Invention byte: And the invention is...**

# 2023

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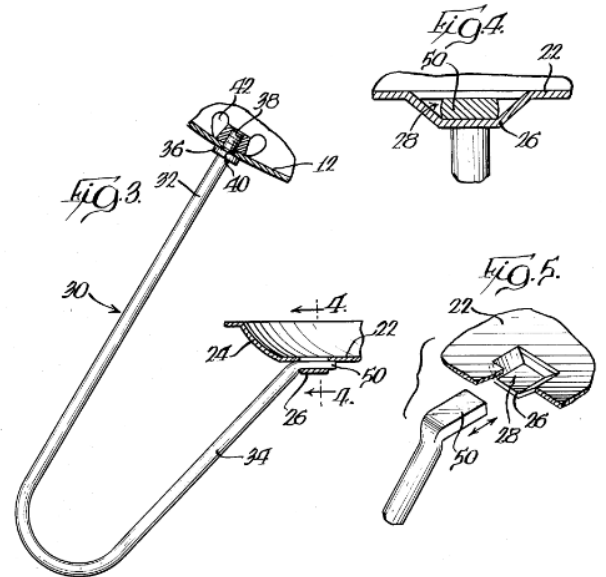
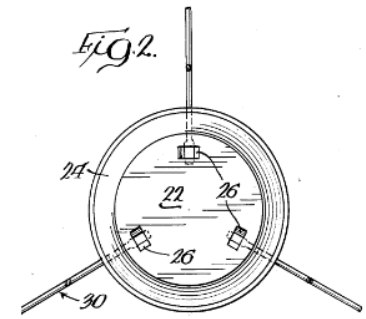
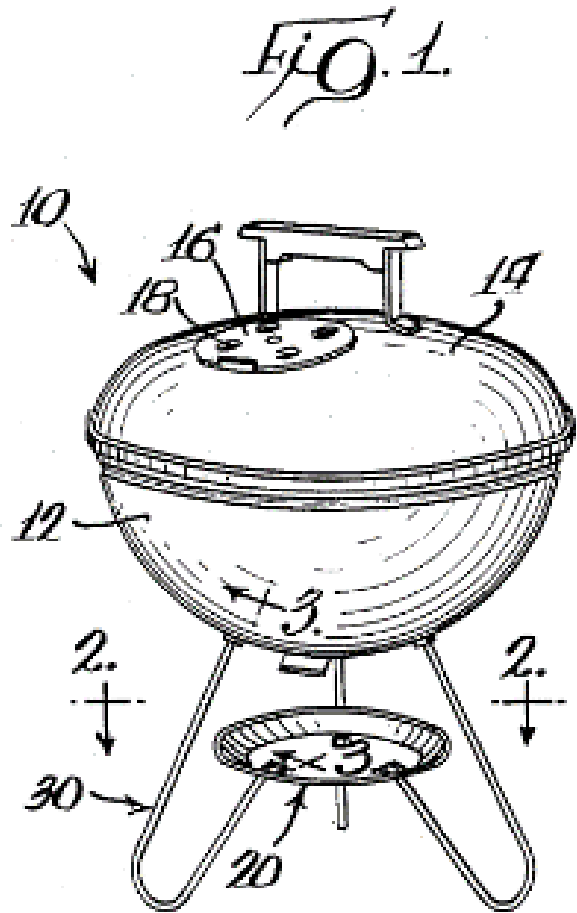
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# **An improvement of the iconic Weber® charcoal grill was patented in 1985. What was the improvement?**

- A. Increased number of vent openings
- B. Attachment of legs to the kettle without the need for tools
- C. Larger ash catcher
- D. None of the above

# U.S. Patent 4,498,452: Kettle With Ash Catcher





**His invention was first patented in 1942 and was later used on the Voyager mission. Who was he?**

- A. Guillermo Gonzalez Camarena
- B. Hugo Teran Salgueor
- C. Luis Alejandro Cavallo Caroca
- D. Luis Van Ahn

# Guillermo Gonzalez Camareno

U.S. Patent 2,296,019



“Chromatic Adapter for  
Television Equipment”

Issued Sept. 15, 1942



Credit: National Inventors Hall of Fame

# NATIONAL INVENTORS HALL OF FAME



S. DUNCAN

ALBERT E. ...



JOHN ...

WILLIAM ...



JOHN ...

JOHN ...



JOHN ...

JOHN ...



Portable Hand and Electric Drill  
1897-98



THE EFFECTIVE INVENTOR

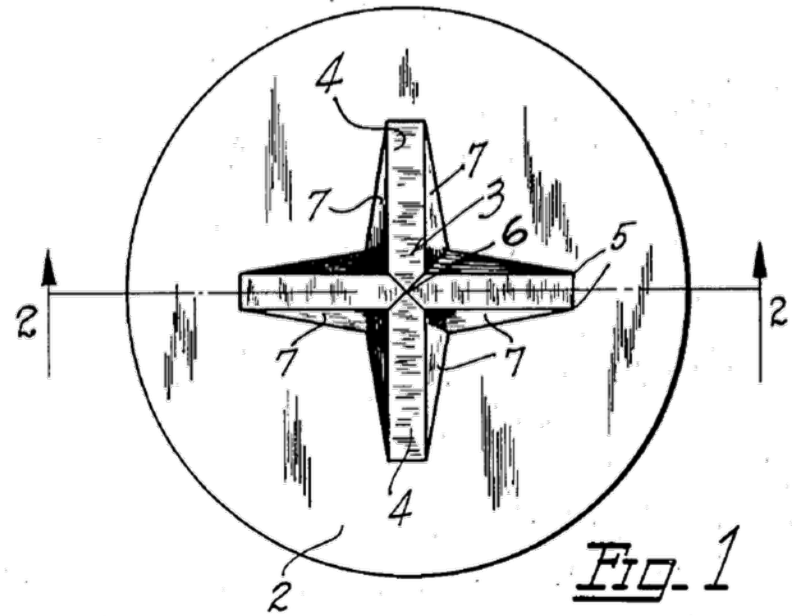
IS SOMEONE WHO SOLVES PROBLEMS!

# **This invention was first used on the 1936 Cadillac. What was it?**

- A. Crosshead or Phillips screw
- B. Vanity Mirror
- C. Headlight
- D. V-8 engine

# The Phillips head screw

U.S. Patent 2,046,343 "Screw" issued July 3, 1934



Credit: National Inventors Hall of Fame



# Question/comment submission

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# 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?

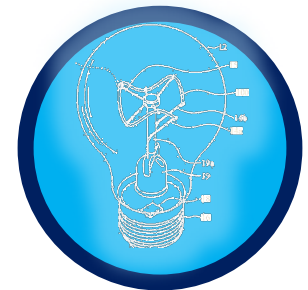
Identification of **resources** for inventors?

Inventor **success stories**?

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

**Something entirely new?**

Send your wish list to - [PTABInventorHour@uspto.gov](mailto:PTABInventorHour@uspto.gov)



# PTAB contact info



## By telephone:

- 571-272-9797 (general; appeals; and interferences)
- 571-272-7822 (trials; and PACTS)

## By email:

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**Questions?**

# Future programs



## Inventor Hour, Episode 23

Thursday, October 26, noon (ET)

*(Then a break until January 2024!)*



