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
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)
Today’s Agenda

1. Meet a TTAB judge
2. Tour: National Inventors Hall of Fame
3. Trial byte: 5 common AIA pre-trial defenses
4. Invention byte
5. 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 TTAB Judge

Melanye Johnson, Acting Deputy Chief Administrative Trademark Judge

Mariessa Terrell, Attorney Advisor for Trademark Customer Outreach
Melanye Johnson
Acting Deputy Chief
Administrative Trademark Judge
Question/comment submission

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Patent Pro Bono Program:
Pathways to inclusive innovation

Learn about government resources for protecting your intellectual property

October 11 from 12:30-5:30 p.m. ET, virtually or in person at USPTO headquarters in Alexandria, Virginia

For questions contact probono@uspto.gov

Info & Registration: www.uspto.gov/about-us/events/patent-pro-bono-program-pathways-inclusive-innovation
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
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)
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.

#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.

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 where 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

Precedential and informative decisions website

Located at: www.uspto.gov/patents/ptab/precedential-informative-decisions
Additional resource

Located at:

Question/comment submission

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First-Time Filer Expedited Examination Pilot Program

Expedites the first Office action, which expands opportunity in innovation. By lowering time-based barriers for inventors who might otherwise be unable to participate in the patent system, this initiative will enable them to bring their innovations to impact more rapidly.

For more information, see www.uspto.gov/FirstTimePatentFiler
National Inventors Hall of Fame
50th Anniversary

Sophia Johnson, Associate Director of Government Relations
Question/comment submission

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Journeys of innovation

Relatable stories that chronicle the journeys of inventors and entrepreneurs

• Learn how they got their start, challenges they faced, and what it took to bring their ideas to fruition
• Learn about the importance of creating and protecting intellectual property

A new story each month:
www.uspto.gov/learning-and-resources/journeys-innovation
Invention byte: And the invention is...
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
NATIONAL HISPANIC HERITAGE MONTH
September 15 to October 15
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 Camarena

U.S. Patent 2,296,019

“Chromatic Adapter for Television Equipment”

Issued Sept. 15, 1942

Credit: National Inventors Hall of Fame
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
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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
PTAB contact info

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

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- Trials@uspto.gov
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- PTABOutreach@uspto.gov
- PTABP-TACTSAdmin@uspto.gov
Questions?
Inventor Hour, Episode 23

Thursday, October 26, noon (ET)

(Then a break until January 2024!)