

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Patent Trial and Appeal Board (PTAB) Update

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March 10, 2022

Patent Public Advisory Committee public meeting

UNITED STATES
PATENT AND TRADEMARK OFFICE



Agenda

- New developments from PTAB
 - Director review
 - PTAB resources for inventors
 - PTAB pro bono pilot program
 - LEAP eligibility requirement

Implementation of interim procedure

Post-*Arthrex*: Director review

Director review

- *Arthrex* provided the Director authority to review a PTAB final decision in an *inter partes* review by rehearing.
- The USPTO has implemented an interim procedure for Director review, consistent with the *Arthrex* decision.
- In this interim procedure, such a review may be initiated *sua sponte* by the Director or requested by a party to an AIA proceeding in relation to a final written decision.

Director review (cont.)

- If initiated *sua sponte* by the Director, the parties to the proceeding will be given notice and may be given an opportunity for briefing.
- The Director's review may address any issue, including issues of fact and issues of law, and will be *de novo*.

Director review - procedure

- A party may request Director review of a final written decision in an *inter partes* review or a post-grant review by concurrently:
 - filing a request for rehearing by the Director of a PTAB decision, and
 - submitting a notification of that request by email to Director_PTABDecision_Review@uspto.gov, and copying counsel for the parties.

Director review – procedure (cont.)

- After a panel issues a final written decision in an *inter partes* review or a post-grant review, a party may request either Director review or rehearing by the original PTAB panel but may not request both.
 - If a party requests panel rehearing and the panel grants rehearing, a party may subsequently request Director review of that decision.
 - If a party requests both Director review and panel rehearing (either together, or in the alternative), the USPTO will treat such a request as a request for Director review.

Director review - requirements

- A request for rehearing by the Director must satisfy the timing requirements of 37 C.F.R. 42.71(d).
 - Must be filed within 30 days of the entry of a final written decision or a decision on rehearing by a PTAB panel
- A timely request for rehearing by the Director will be considered a request for rehearing under 37 C.F.R. 90.3(b) and will reset the time for appeal or civil action as set forth in that rule.

Director review

- The Precedential Opinion Panel (POP) process will remain in effect and unchanged at this time.
 - However, the USPTO will be reviewing the POP process in view of the Director review process and welcomes public suggestions regarding potential changes.
- Only a party to a case may submit a request for Director review. Third party requests for Director review are not permitted.
- During implementation of the interim procedure, the USPTO will not charge a fee.

Director review – future plans

- The current process is envisioned as an interim procedure that may change based on input from the public and experience with conducting Director reviews.
- Suggestions about the Director review process may be submitted to Director_Review_Suggestions@uspto.gov.

Director review – further information

- For more details on the interim Director review procedure:
 - USPTO *Arthrex* information webpage
 - www.uspto.gov/patents/patent-trial-and-appeal-board/procedures/uspto-implementation-interim-director-review
 - *Arthrex* Q&As
 - www.uspto.gov/patents/patent-trial-and-appeal-board/procedures/arthrex-qas
 - July 1, 2021, Boardside Chat presentation
 - www.uspto.gov/about-us/events/learn-about-interim-director-review-process-following-us-v-arthrex-inc

Director review – statistics

(through March 7, 2022)

- Requests for Director review:
 - 187 total received
 - 11 pending requests
 - 176 complete
 - 162 denied
 - 9 dismissed
 - 1 withdrawn
 - 4 granted

PTAB resources for inventors

New to PTAB webpage

<https://www.uspto.gov/patents/patent-trial-and-appeal-board/about-ptab/new-ptab>

- Contains basic information about the PTAB, ex parte appeals, and AIA trial proceedings
- Features ex parte appeal brief tools



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?

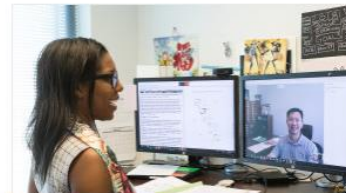
Contact PTAB or peruse helpful FAQs.

- > [Get help](#)



PTAB BOARDSIDE CHAT WEBINARS

The PTAB Boardside Chat series highlights best practices and answers questions raised by attendees



TEMPORARY CHANGE

PTAB conducts remote hearings



EX PARTE APPEAL BRIEF TEMPLATE

Provides help in drafting an ex parte appeal brief for independent inventors and others

Inventor Hour webinar series

<https://www.uspto.gov/about-us/events/inventor-hour-events>

- Monthly webinar for independent inventors and those new to PTAB practice
- Inaugural webinar held on August 26, 2021
- Each webinar
 - Features an interview with a PTAB member
 - Covers a variety of topics about practice before PTAB
 - Often showcases an inventor success story before PTAB
- Recordings of all past webinars and materials presented are on the Inventor Hour webinar series webpage




Inventors Digest

www.inventorsdigest.com

Free third-party publication featuring monthly articles about PTAB

September 2021



As more examiners and hearing staff of the PTAB return to the agency, hearing to resolve the patent application backlog of cases that are expected to be 20 percent since its all-time low in January 2020.

The Patent Trial and Appeal Board was created by the AIA to resolve patent disputes by expediting disputes on patent validity. Its processes and results have drawn some criticism. But as Joseph M. Foster, former counsel of the Patent Trial and Appeal Board, noted in a number of previous issues, and a lot of these issues are very difficult. It just takes a long time to fill through these and figure out what the right solution—something that going to work going forward and making the USPTO boarders at Alexandria, Virginia.

The PTAB

Understanding the risks and processes of the tribunal formed in 2012

USPTO has recently announced its proposed budget for FY2022. The budget includes a 10% increase in the number of patent examiners and a 10% increase in the number of patent trial and appeal board members. The budget also includes a 10% increase in the number of patent trial and appeal board members. The budget also includes a 10% increase in the number of patent trial and appeal board members.

WHAT'S NEXT

PTAB INVENTOR HOUR WEBINARS: These Thursday events are for independent inventors and those new to Patent Trial and Appeal Board (PTAB) practice. The session covers PTAB procedures, such as, ex parte appeals, and American Inventor Act (AIA) trials and other useful information for practicing before the board such as oral hearing protocols, statistics, and more.

The next Inventor Hour webinar is from noon to 1 p.m. ET on October 28. Another follows on November 18. Presentation materials and recordings are posted after the webinar. Do you email questions in advance or during the webinar to ptab@inventorsdigest.com?

INVESTOR QUESTIONS (ask@inventorsdigest.com): patent trial and appeal board/inventor hour webinars

Visit inventorsdigest.com for many other opportunities to attend free virtual events and training.

November 2021



PTAB Trials


USPTO page breaks down elements of process for protecting patent rights

DURING YOUR PATENT RIGHTS and understanding a patent challenger's arguments that your claim are invalid are goals for Patent Trial and Appeal Board (PTAB) trials from a previous perspective.

Given that a stake for many independent inventors, the notion of going to trial may be daunting. At www.gov.patents/ptab/trials, the USPTO breaks down the trial process into categories to make the subject's more understandable.

Among those major topics:

- Inter partes review:** Inter partes is a Latin phrase that translates to "between the parties."
- Ex parte:** This is a trial conducted at the board to review the patentability of one or more claims in a patent—only on a ground that could be raised under 35 USC Patent Code Sections 102 or 103, and only relating to prior art consisting of patents or printed publications.
- Section 102, entitled "Conditions for Patentability,"** describes some conditions where patent should not be granted to an inventor based on the concept of novelty. These conditions generally involve an invention that is already known publicly.



PTAB INVENTOR HOUR WEBINARS:

If you are an inventor or a PTAB practitioner, you can find foundational information about the process. American Inventor Act (AIA) trials in both form and practice. Presentation materials and recordings are posted after the webinar. Do you email questions in advance or during the webinar to ptab@inventorsdigest.com?



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October 2021



Ex parte, Explained

How inventors can appeal a rejected patent application

A N INVENTOR who disagrees with a USPTO patent examiner's decision to reject claims in a patent application may appeal the decision to a review and advisory board. If the appeal is successful, the patent will be granted. If not, the applicant may seek review by the Patent Trial and Appeal Board (PTAB) in a proceeding called an ex parte appeal.

The USPTO provides resources for preparing an ex parte appeal, including a Word template to write a hearing paper for the brief and general guidelines on writing the required sections (located on the template with example 1).

After the Appeal Brief is filed, the examiner will respond to the arguments in the Appeal Brief as well as the Examiner's Answer. The examiner will also consider whether to maintain, modify, or withdraw each rejection. Further, the examiner may include a new ground of rejection against some or all of the pending claims. Lastly, the examiner will provide notice that the applicant may file an appeal for forwarding within two months from the date of the examiner's notice to the appeal.



The purpose of ex parte is to demonstrate to a three-judge panel that the examiner erred in rejecting the claimed invention and that the rejection should be reversed.

In an ex parte appeal, an applicant asks a demonstrator to a three-judge panel that the examiner erred in rejecting the claimed invention and that the rejection should be reversed. In this way, the PTAB functions as a quality control check on examination to ensure that examiners make correct patentability decisions.

WHAT'S NEXT


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January 2022



2 Tribunals Rule on Patent Validity

Understanding the similarities and differences between the PTAB and district courts on IP matters

WHEN TRIBUNALS RULE on a patent's validity in the United States' And which tribunal to decide on infringement or damages? To the United States, the Patent Trial and Appeal Board (PTAB) and the U.S. district courts adjudicate patent validity. But only the courts address infringement and penalties. Because patents are economically important and patent litigation often comes with high stakes, it is important to understand the major ways in which these tribunals are similar and different.

District courts rule on patent validity in bench trials or jury trials. A bench trial is a trial where the judge is the factfinder. A jury trial is a trial where a jury of six to twelve members of the public from various backgrounds—technical, non-technical, legal, and non-legal—decide patent validity.

These courts determine infringement, and may seek injunctive and monetary relief as damages. There are two kinds of district court proceedings in which patent validity may arise: a patent owner may sue a third party for infringement, and the third party defends itself by asserting that the patent is invalid.

A third party may file a declaratory judgment action for a ruling that a patent is invalid.

Because the PTAB cannot hear patent infringement allegations, it is common to have parallel proceedings in which patent validity is determined by the PTAB and the district court. In fact, approximately 85 percent of civil cases in district court do not concern district court litigation.

But a civil case in district court, the party moving for Article III standing. That is, the party moving will sue has an injury that



District courts determine infringement, and can award injunctive and monetary relief as damages. The PTAB does not.



INVESTOR QUESTIONS (ask@inventorsdigest.com):

patent trial and appeal board/inventor hour webinars. Questions to submit or during the actual events and/or training.

December 2021



Inside PTAB Hearings

Understanding how to make your best case before the board

WHEN YOU move a review or inter partes review to a hearing, the applicant and the examiner (whose written briefs are discussed in the previous article on ex parte appeals) that the applicant goes to have attorneys making arguments in a hearing of a board.

Though it might be the USPTO's best-kept secret, it is how the Patent Trial and Appeal Board (PTAB) hears appeals and how the applicant and the examiner (whose written briefs are discussed in the previous article on ex parte appeals) that the applicant goes to have attorneys making arguments in a hearing of a board.

During the applicant's presentation, the PTAB judges will likely ask questions and seek clarification on certain issues. The applicant is usually given 20 minutes to complete his or her presentation. Once a hearing is held, the PTAB issues a decision. Unlike the applicant in ex parte appeals, the parties in AIA trials usually always expect a hearing.

Hearings in AIA trials proceed similarly to those in ex parte appeals, with the parties presenting their arguments and the judges asking questions. But unlike in a hearing in an ex parte appeal, in which the examiner is usually not present, both the petitioner and the examiner are present.

During an AIA trial hearing, the parties take turns presenting their arguments. The petitioner goes first, followed by the patent owner. Both parties typically give 40 minutes total for their presentations. The petitioner may move a portion of his or her time for rebuttal—a chance to address the patent owner's initial presentation. The patent owner, in turn, may move a portion of his or her rebuttal—a chance to rebut the petitioner's rebuttal. Following a hearing, the PTAB issues a decision.

In other situations, these hearing enable parties to present arguments and evidence in front of a least three judges. The hearings give the judges the opportunity to ask questions of the parties to help them decide the cases.

During hearings involving oral arguments, the patent applicant—called the "appellant" before the PTAB—may choose whether to have a hearing. If the applicant decides not to have a hearing, the case is referred to an "in brief." The PTAB decides the case entirely on written arguments submitted by



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PTAB pro bono pilot program

LEAP eligibility requirement

Other new developments

PTAB pro bono pilot program

- Announced at the PTAB Bar Association Annual Conference on September 23, 2021
- Collaborating with the PTAB Bar Association to create a clearinghouse to bring together volunteer attorneys and pro bono clients
- More detailed information forthcoming, including eligibility criteria for assistance

LEAP eligibility requirement



- Requirement update of November 18, 2021
- Practitioner (a licensed attorney or registered agent) no longer required to attest to a particular number of years of experience
- Practitioner only needs to certify that they presented three or fewer substantive oral arguments in any tribunal, including the PTAB



Thank you!

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