

UNITED STATES
PATENT AND TRADEMARK OFFICE



Patent Trial and Appeal Board Inventor Hour: Episode 15

Janet A. Gongola, Vice Chief Administrative Patent Judge

Cynthia M. Hardman, Administrative Patent Judge

Jeffrey N. Fredman, Administrative Patent Judge

Ryan H. Flax, Lead Administrative Patent Judge

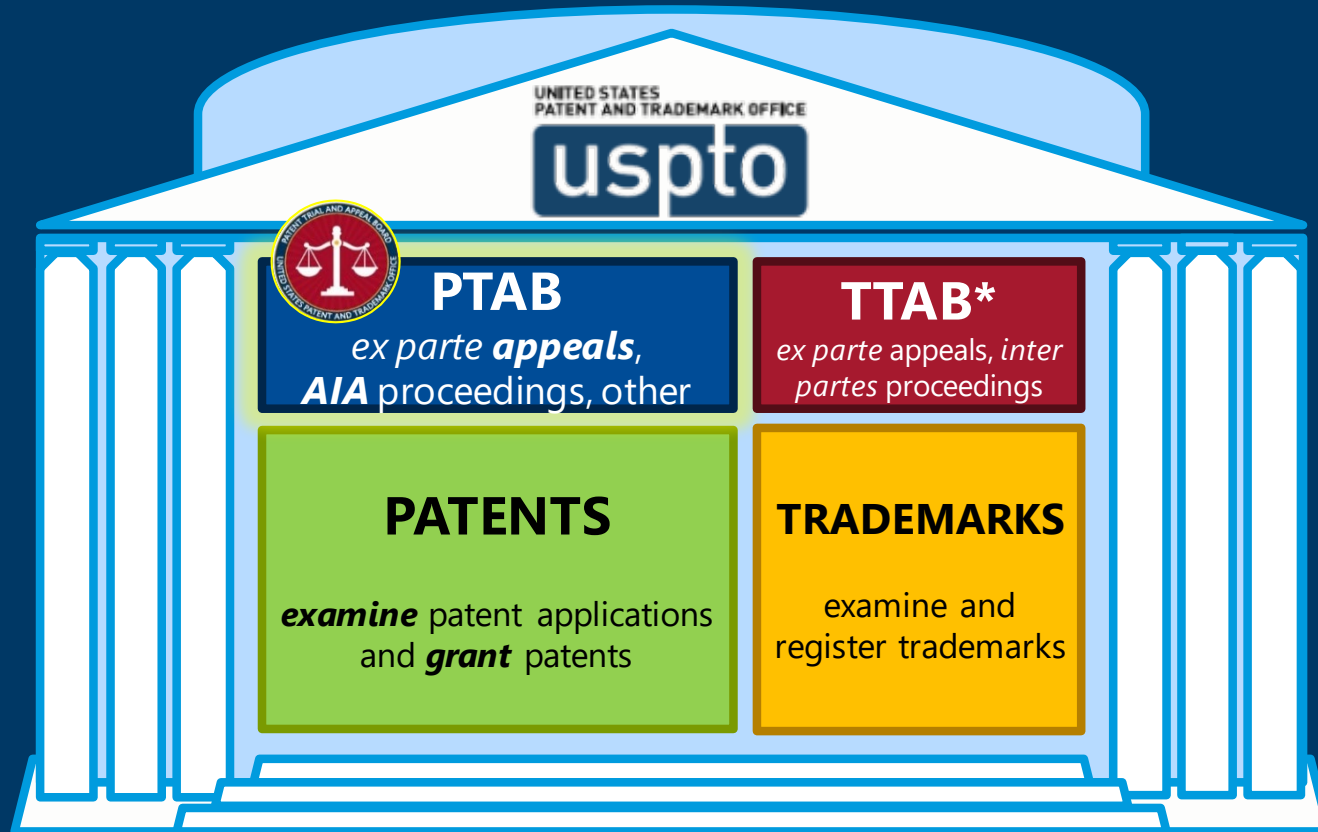
and special guests **Sara Butts** and **Robert Berry**

February 23, 2023



UNITED STATES
PATENT AND TRADEMARK OFFICE ®

What is the Patent Trial and Appeal Board?



Today's agenda

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Robert Berry
& Sara Butts

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Ryan H. Flax, Lead Administrative Patent Judge



Meet the PTRC

Patent & Trademark Resource Center

Robert Berry and Sara Butts

PTRC

patent &
trademark
resource
center

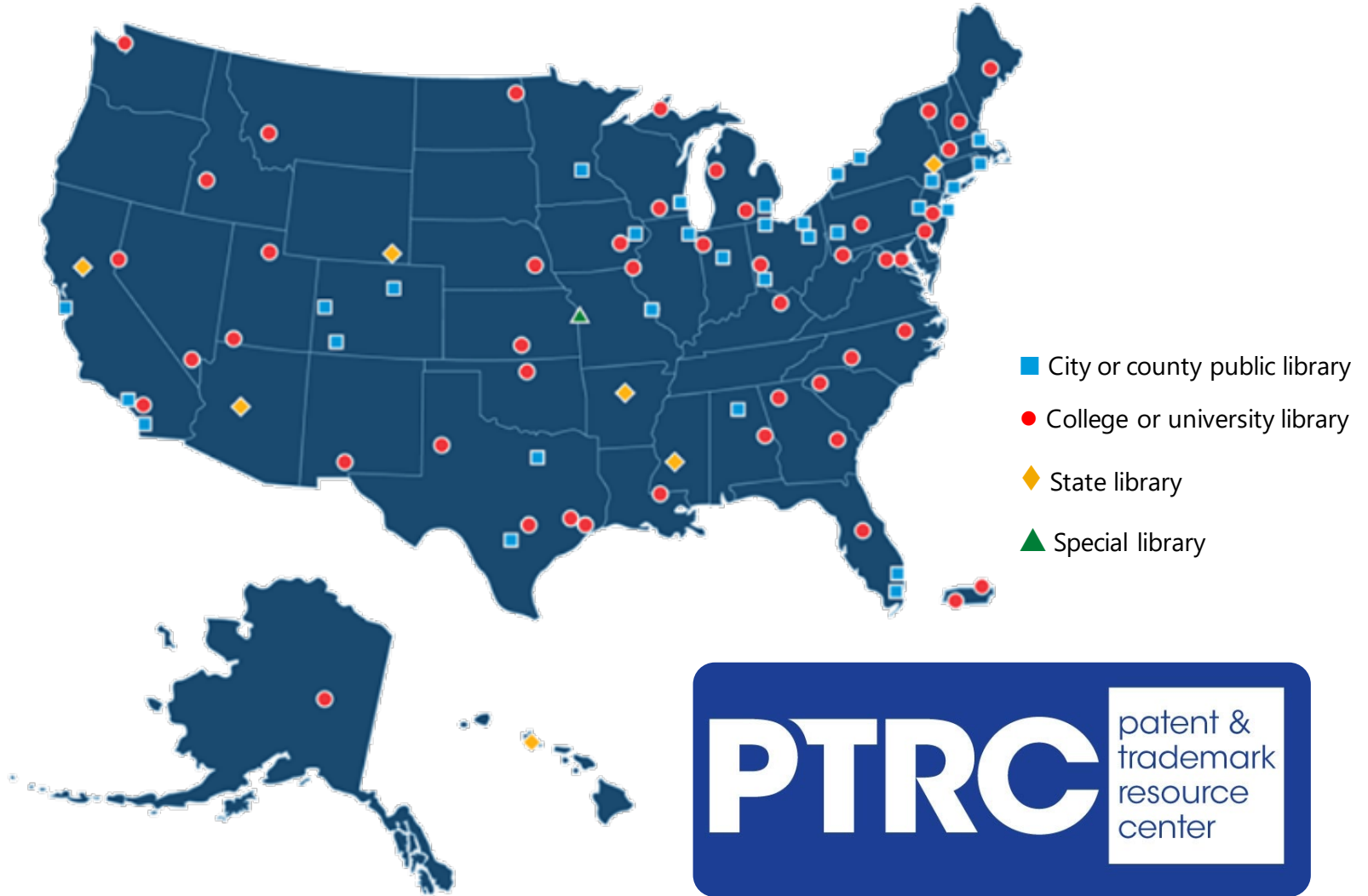


Robert (Rob) Berry



Sara Butts

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- If your organization is interested in having a PTAB speaker at an event, **submit a request**:
 - <https://www.uspto.gov/about-us/organizational-offices/office-chief-communications-officer/speaker-request-form>
- Form takes less than **5 minutes** to complete
- Preferred to have specific **date, time, and format**
- May identify a specific person or ask generally





Jeffrey Fredman, Administrative Patent Judge



Appeal Byte:

Basics of *Ex Parte* Appeals


The basics of *ex parte* appeals

-  What are ***ex parte* appeals**?
-  What **rules and law** apply in an *ex parte* appeal?
-  What are the possible **outcomes** on appeal?
-  What happens **after** an *ex parte* appeal is over?

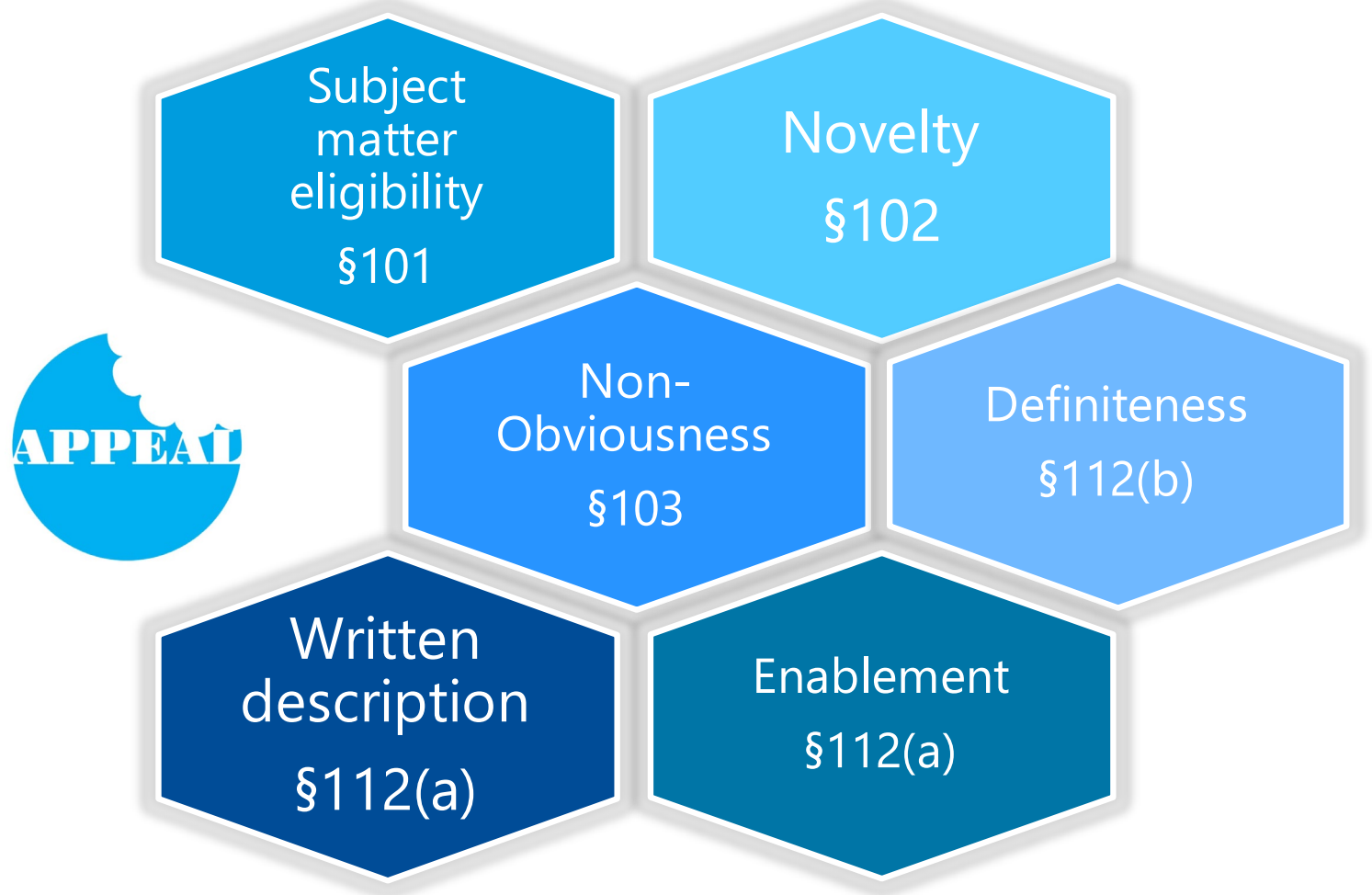
What are *ex parte* appeals?

-  After an application is filed, an examiner decides if it meets various requirements.






If not, the examiner may issue a “**rejection**”

-  When the examiner has **twice** rejected the claims or issued a “**final**” office action, the applicant can seek review by the PTAB.

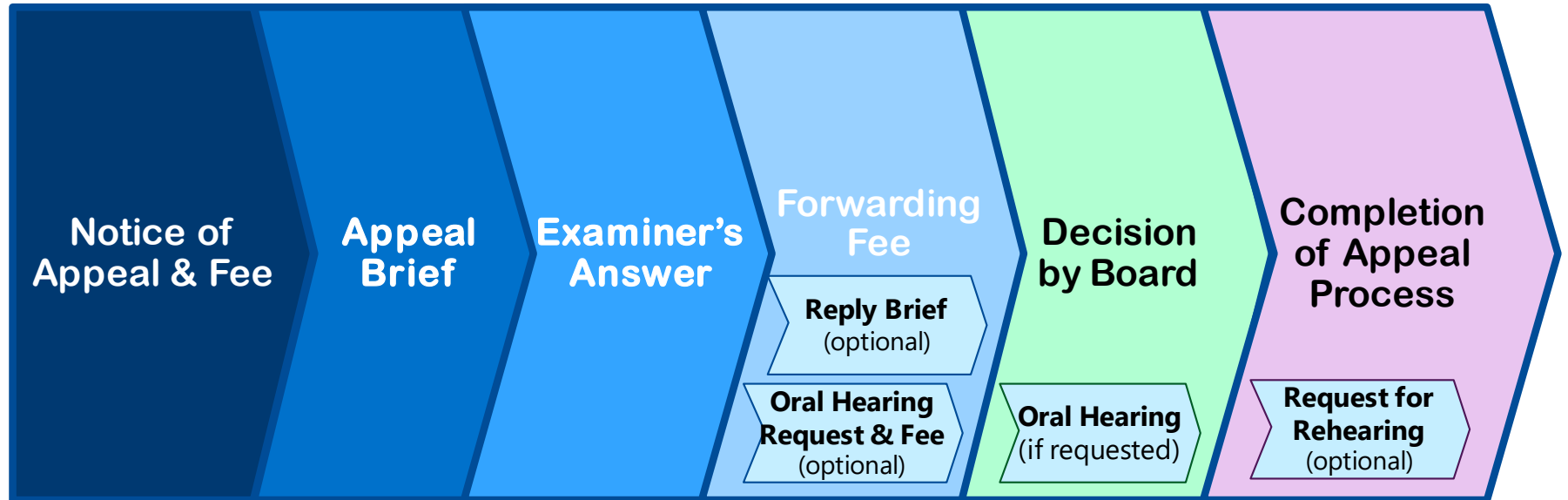
Patentability: statutory requirements



What rules and law apply?

-  Law of the U.S. Supreme Court and U.S. Court of Appeals for the Federal Circuit
-  35 U.S.C. (Patents)
-  37 C.F.R. Part 41
-  Precedential PTAB decisions
-  Manual of Patent Examining Procedure (MPEP)
 - Guidance to the PTAB

The *ex parte* appeal process



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



What are the possible outcomes?

The outcome may be an affirmance, an affirmance-in-part, a reversal, or new ground(s) of rejection

Affirmance: rejection of each and every claim is upheld

Affirmance-in-part: rejection of at least one claim, but not all, is upheld

Reversal: None of the examiner's rejections are upheld

New ground(s) of rejection: Judges issue a new rejection of one or more claims



What happens after an appeal?

The outcome dictates who is responsible for taking the next step

If the outcome is an **affirmance or new ground(s)** of rejection, the **appellant** must take the next step

If the outcome is an **affirmance-in-part**, the **appellant** may take the next step

If the outcome is a **reversal**, the **examiner** will take the next step



Question/comment submission

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Appeal brief tool



- Need help in preparing an **appeal brief**? Check out the **appeal brief tool**
 - <https://www.uspto.gov/patents/patent-trial-and-appeal-board/resources/preparing-ex-parte-appeal-brief>
- Tool walks through the **required sections** of an appeal brief, gives **instructions** on what information should be presented in each section, and provides **examples**
- Instructional **video** also available
- **Free!**



Cynthia Hardman, Administrative Patent Judge



Trial Byte:

AIA Proceedings Overview, *a Review*

What are AIA trial proceedings?

America Invents Act (AIA) – Congress revised the Patent Act to provide an additional forum to address patentability/validity disputes

AIA trials are intended to be **streamlined**, **efficient**, and **cost effective**



What types of AIA trial proceedings exist?

Inter Partes Review (IPR): can challenge claims based on prior art (patents or printed publications)

Post-Grant Review (PGR): can challenge claims based on prior art and other bases

Derivation: determines correct inventor; alleges another derived the invention from the correct inventor



Comparison of IPR and PGR

Trial Type	Who Can File	Applicability	Availability	Basis
Inter partes review (IPR)	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).	Any patent (first-to-invent or first-inventor-to-file).	For first-to-invent patents: anytime after patent grant or reissue. For first-inventor-to-file patents: from the later of: (a) 9 months after patent grant or reissue; or (b) the date of termination of any post grant review.	102 and 103 based on patents and printed publications .
Post-grant review (PGR)	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.	Patent issued under first-inventor-to-file .	Must be filed within 9 months of patent grant or reissue.	101, 102, 103, 112 (but not best mode), and double patenting.

Who is involved in an AIA trial proceeding?

Petitioner

Files petition challenging a U.S. patent; must pay a filing fee
Carries legal burden to prove claims unpatentable

Patent owner

Has opportunities to represent its interests

Panel

Typically three administrative patent judges



How do AIA trial proceeding work?



What are the possible outcomes?

The outcome may be that all challenged claims are upheld, some challenged claims are upheld, or none of the challenged claims are upheld.

All claims patentable: Each and every challenged claim upheld

Mixed: At least one challenged claim, but not all, upheld

All claims unpatentable: No challenged claim upheld



What happens next?

- Panel rehearing
- Director review
- Appeal to the U.S. Court of Appeals for the Federal Circuit

Want to learn more?

Prior **Inventor Hour Episodes** covering AIA trial proceedings:

- *Episode 1* (Aug. 2021): Introduction AIA trial proceedings
- *Episode 2* (Sept. 2021): Overview of the phases and timing of AIA trial proceedings
- *Episode 3* (Oct. 2021): Pre-institution strategies for Patent Owners
- *Episode 4* (Jan. 2022): Overview of the Board's Institution Decision
- *Episode 6* (March 2022): Orientation to Trial Practice Guide
- *Episode 10* (July 2022): Patent Owner's Response
- *Episode 12* (Sept. 2022): Discovery in AIA trial proceedings
- *Episode 13* (Oct. 2022): Motions to Amend



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A large red arrow pointing from the right towards the email address input field.

<https://public.govdelivery.com/accounts/USPTO/subscriber/new>



Janet Gongola, Vice Chief Administrative Patent Judge



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Making maternity wear fashionable

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USPTO introduces new tool to help creators identify their intellectual property

This tool replaces the IP Assessment tool

USPTO seeks public comments on draft 2022-2026 Strategic Plan

We welcome all comments until the deadline of January 31, 2023



[T]here is a crucial need for a new era of innovation, and for all of us to unite in helping every potential innovator in our country



Patents

Trademarks

IP Policy

Learning and Resources

Find It Fast ▾

Getting started

- Patent basics
- Process overview
- Legal assistance and resources
- Inventor and entrepreneur resources
- International cooperation
- Patent FAQs

Application process

- Search for patents
- Learn about patent classification
- Filing online
- Checking application status
- Responding to Office actions
- Revisions
- Patent Trial and Appeal Board

Maintaining a patent

- Maintenance fees
- Correcting your patent
- Transferring ownership
- Ordering certified documents

Tools & links

About EFS-Web

File a patent application online with EFS-web

Check application status

Check patent application status with Patent Center and Private PAIR

Patent Trial & Appeal Board

Resolve disputes regarding patents with PTAB

More tools & links

Patent Center

Single interface replacement for EFS-Web, Private PAIR and Public PAIR

Fees and payment

Pay maintenance fees and learn more about filing fees and other payments

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View international patent filings

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Making maternity wear fashionable

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Latest news

Remarks

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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

- > [Resources and guidance](#)
- > [Trial proceedings](#)
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Decisions

- > [All PTAB decision data](#)
- > [AIA daily decisions](#)
- > [Precedential and informative decisions](#)
- > [Interim decision circulation process](#)
- > [Precedential Opinion Panel](#)
- > [Interim Director review process](#)
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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?](#)
- > [Free legal help for 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](#)



¿Con interés en el PTAB?

[English](#)

Los inventores independientes, los profesionales recientes y otros pueden explorar los enlaces a continuación para comprender mejor el papel que juega el Tribunal de Apelación y Juicio de Patentes (PTAB, por sus siglas en Inglés) en el proceso de obtener una patente de invención.



¿Qué es PTAB?

PTAB es un tribunal administrativo dentro de la USPTO que revisa los rechazos definitivos realizados por los examinadores en procedimientos llamados apelaciones ex parte y resuelve las cuestiones de patentabilidad de las patentes emitidas planteadas por terceros en procedimientos contenciosos bajo la Ley "América Inventa" (AIA, por sus siglas en Inglés).



Apelaciones ex parte

Si un examinador de patentes rechaza dos veces o emite un rechazo definitivo en una solicitud de patente, el solicitante puede buscar revisión con respecto al rechazo ante el PTAB a través de una apelación ex parte.

> [¿Qué son las apelaciones ex parte?](#)



Procedimientos bajo la AIA

Un tercero que no sea el titular de la patente, llamado peticionario, puede impugnar la validez de las reivindicaciones de una patente emitida en un procedimiento contencioso bajo la AIA ante el PTAB.

> [Más información sobre los procedimientos bajo la AIA](#)



¿Alguna pregunta?

Haga contacto con PTAB o lea detenidamente las preguntas frecuentes disponibles para su conveniencia.

> [Obtenga asistencia \(en Inglés\)](#)

Other translated languages

Chinese: PTAB 新手？

Japanese: PTABは初めてですか？

French: Êtes-vous nouveau à PTAB?

Korean: PTAB를 처음 방문하십니까?

German: Neu bei PTAB?

Russian: Новичок в PTAB?

Greek: Καινούργιοι στο PTAB?

Urdu: PTAB آپ کے لیے نیا ہے؟

Hindi: PTAB में पहली बार आए हैं?

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Future programs



Inventor Hour, Episode 16

Thursday, March 23, noon (ET)

Inventor Hour, Episode 17

Thursday, April 27, noon (ET)



