

UNITED STATES
PATENT AND TRADEMARK OFFICE



Patent Trial and Appeal Board Inventor Hour: Episode 27

Janet Gongola, Vice Chief Administrative Patent Judge

Jeffrey Fredman, Administrative Patent Judge

Robert Silverman, Administrative Patent Judge

LiLan Ren, Administrative Patent Judge

Arthur Peslak, Administrative Patent Judge

Cynthia Murphy, Administrative Patent Judge

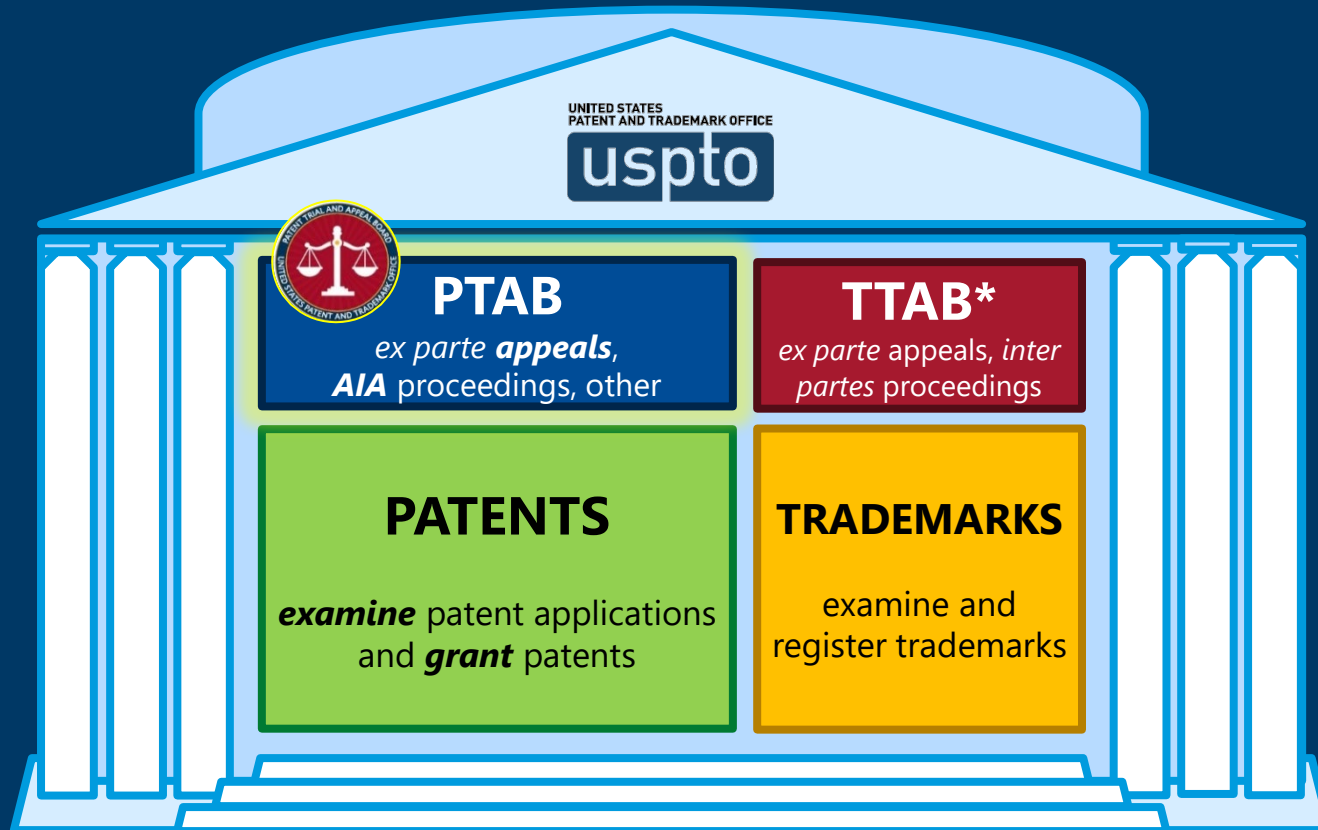
Special guest: **Pete Mehravari**, Director, Global IP Academy

April 25, 2024



UNITED STATES
PATENT AND TRADEMARK OFFICE ®

What is the Patent Trial and Appeal Board?



Today's agenda

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**Interview
with
Pete Mehravari**

2

**Trial byte:
Conference Call**

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**PTAB Files:
PTAB & Design
Patents**

4

Q&A

Question/comment submission

To send in questions or comments about the presentation, please email:

- PTABInventorHour@uspto.gov

Janet Gongola, Vice Chief Administrative Patent Judge



An interview with Pete Mehravari

Director of the Global IP Academy



Pete Mehravari
*Director of the
Global IP Academy*

PTAB Ex Parte Appeals Roadshows



- Educational sessions sharing best practices for how to succeed in an ex parte appeals proceeding
 - Tips for more efficiently filing an appeal brief and making more persuasive written arguments
 - Mock oral argument before a judge panel
 - Gain behind-the-scenes perspectives about what PTAB judges expect and have seen in winning appeals
- Fireside chat with a PTAB executive leader
- PTAB will visit Philadelphia on May 2, 2024
 - www.uspto.gov/patents/ptab/ex-parte-appeal-roadshows



Jeffrey Fredman, Administrative Patent Judge



Trial byte:

An American Invents Act (AIA) conference call

Conference calls

- Conference calls are used in AIA trial proceedings to raise and resolve issues in an expedited manner.



Example conference call in three acts

Characters:

- Counsel for Petitioner – Sally Smith
- Counsel for Patent Owner – Bob Baxter
- PTAB APJ – Judge Harding

Act one

Example conference call

Judge Harding: Ms. Smith, you requested the conference call. We will hear from you first.

Sally Smith: Thank you. Our Objections to Evidence were due May 1. We finalized and dated the Objections for May 1st on both the paper and the certificate of service. We intended to file and serve the Objections that day. Due to an internal mix-up by our paralegal, the document did not actually get filed until slightly after midnight May 2nd, and did not get served to opposing counsel until 12:17 AM. This mistake should not be held against my client.



Example conference call

Sally Smith

Petitioner is **seeking authorization to file a motion to excuse late action. Rule 42.5(c)(3)** provides that a late action will be excused on a showing of good cause or upon a Board decision that consideration on the merits would be in the interest of justice. Here, our motion will show good cause to excuse the late action. We intended to file and serve the Objections on May 1st, but due to an internal mix-up by our paralegal, the Objections did not actually get filed until slightly after midnight May 2nd, and did not get served to opposing counsel until 12:17 AM on May 2nd. The delay was only minutes. Our motion will also show that it is **in the interest of justice to excuse the late action** because a few minutes of delay should not be held against our client and caused no harm to Patent Owner.

We **request authorization to file a motion**, of no more than 5 pages, no later than 3 business days from today.



Act two

Example conference call

Bob Baxter: Petitioner's Objections were filed and served late. It doesn't matter that it was only 17 minutes late. The Board should not excuse the late filing because Petitioner waited too long to ask for the Board to excuse the late filing . . .

Sally Smith (interrupting): It was only 17 minutes. . .

Bob Baxter (responding to Ms. Smith): Please let me finish!

Sally Smith (interrupting): You could not have been prejudiced . . .

Judge Harding: Ms. Smith, it's Mr. Baxter's turn to speak. **You will have another turn to speak** after Mr. Baxter is done. **Please address your remarks to the Board, not to each other.** Mr. Baxter, please continue.

Act three

Example conference call

Judge Harding: Ms. Smith, we will hear your response now. When did you become aware the Objections were filed and served late? Why did you wait 28 days to request to file a motion to excuse?

Ms. Smith: I am not **prepared to answer that question**. I cannot recall right now. I did not know that Patent Owner was going to make the timeliness of my request an issue.

Judge Harding: Ms. Smith did you **attempt to confer with Patent Owner before requesting the conference call** to find out if and why Patent Owner would oppose?

Ms. Smith: No, your honor.



Conclusion

Best practices during the conference call

- Clearly articulate the relief being requested or the reasons the relief is opposed.
- Each party will be given a chance to speak. Generally, the party requesting relief will speak first, then the opposing party, and then again the requesting party.
- The Judges may have questions. Be prepared to answer the questions as best you can.
- Remember Rule 42.1(c) Decorum requirement. Every party must act with courtesy and decorum in all proceedings before the Board, including in interactions with other parties.



Question/comment submission

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PTAB pro bono program



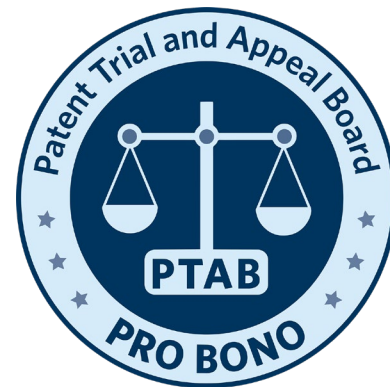
Matches under-resourced inventors with volunteer patent professionals for the purpose of providing free legal assistance in proceedings before the PTAB. Currently open to ex parte appeals.

- **Administered by the PTAB Bar Association**

https://www.ptabbar.org/ptab_pro_bono.php

- **More Information**

<https://www.uspto.gov/PTABprobono>



Inventor Hour Webinar, July 27, 2023, <https://www.uspto.gov/about-us/events/ptab-inventor-hour-episode-20>



Cynthia Murphy, Administrative Patent Judge



PTAB Files

PTAB & Design Patents

Design patents

- In general terms, a “utility patent” protects the way an article is used and works (35 U.S.C. 101), while a “design patent” protects the way an article looks (35 U.S.C. 171).

(12) **United States Design Patent**
Huckaby

(10) Patent No.: **US D1,000,000 S**

(45) Date of Patent: **** Sep. 26, 2023**

(54) **DISPENSING COMB**

(71) Applicant: **Agustina Huckaby**, Fort Worth, TX
(US)

(72) Inventor: **Agustina Huckaby**, Fort Worth, TX
(US)

(57) **CLAIM**

The ornamental design for a dispensing comb, as shown and described.

DESCRIPTION

FIG. 1 is a front elevational view of a dispensing comb showing my new design;

FIG. 2 is a rear elevational view of the dispensing comb;

FIG. 3 is a right side elevational view of the dispensing comb;

FIG. 4 is a left side elevational view of the dispensing comb;

FIG. 5 is a top plan view of the dispensing comb;

FIG. 6 is a bottom plan view of the dispensing comb; and,

FIG. 7 is a top, front and left side perspective view of the dispensing comb.

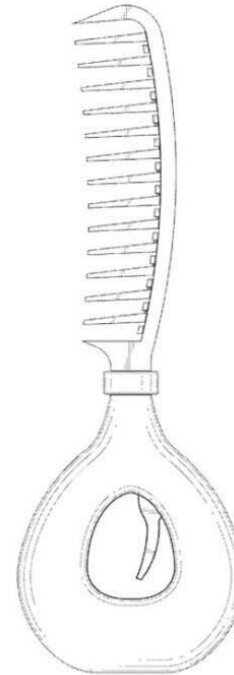


FIG. 1

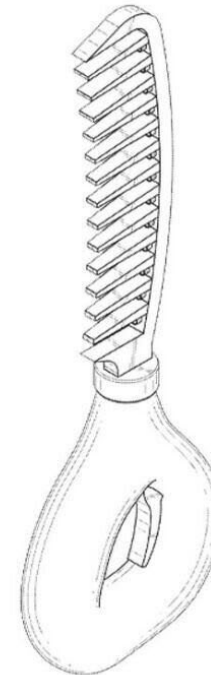


FIG. 7

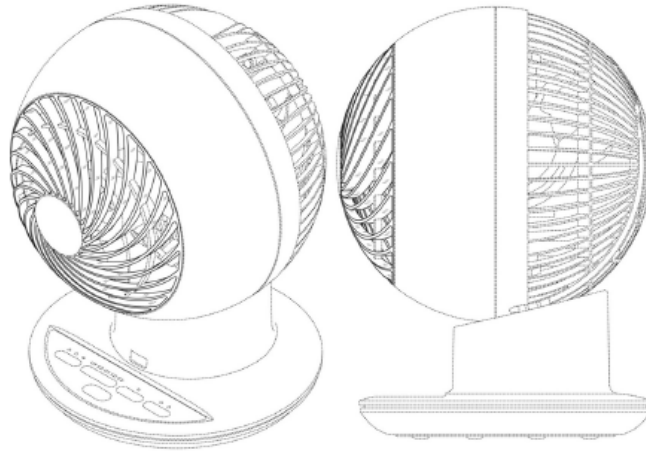
Reviews at the PTAB

- PTAB reviews design-patent issues in:
 - Appeals
 - Inter parties reviews (IPR)
 - Post grant reviews (PGR)

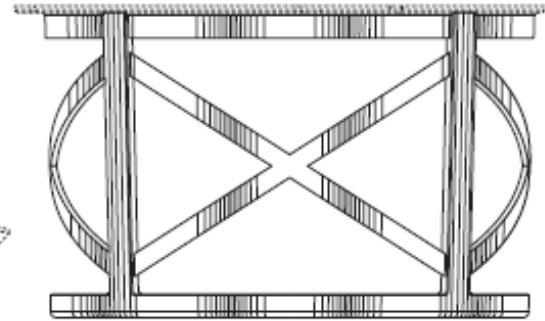
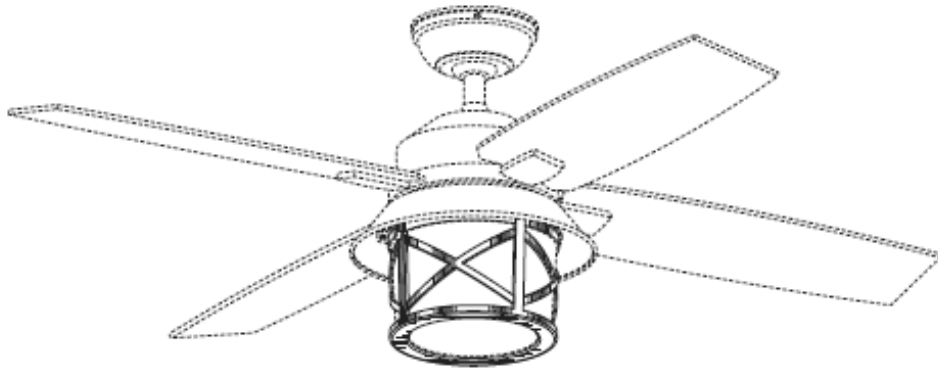
Some designs we have reviewed . . .

Fan club . . .

AIR CIRCULATOR



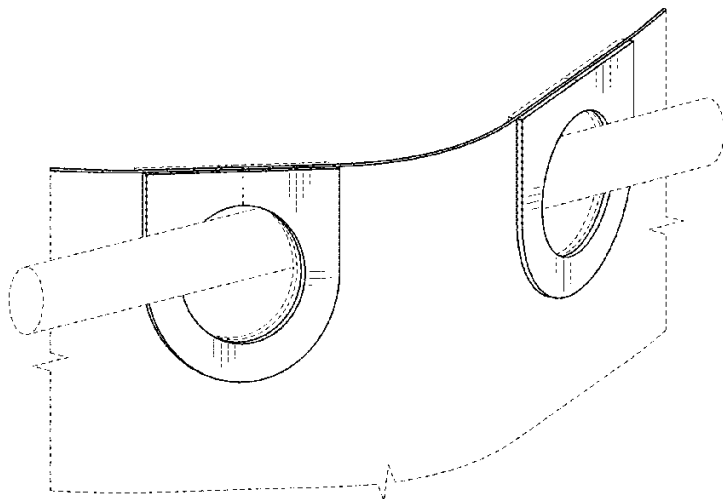
CEILING FAN LIGHT CAGE



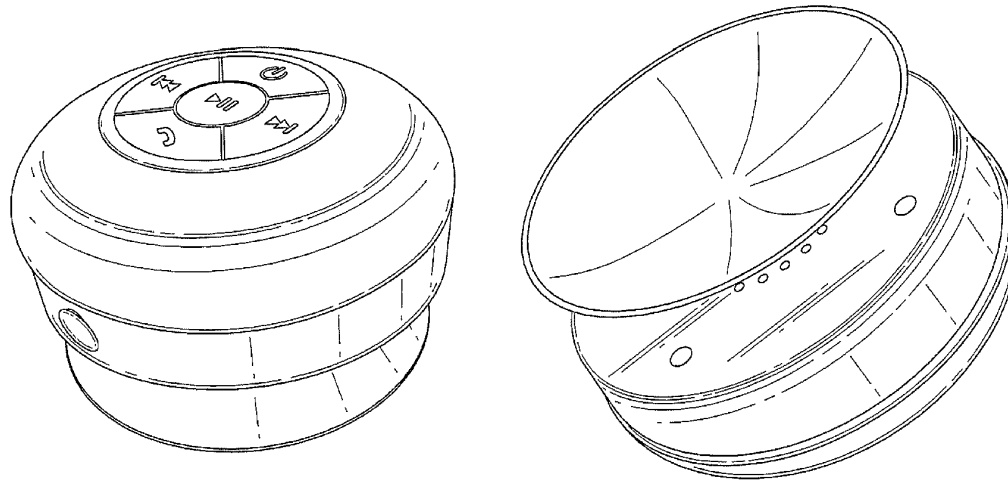
Some designs we have reviewed . . .

For the shower . . .

SHOWER CURTAIN



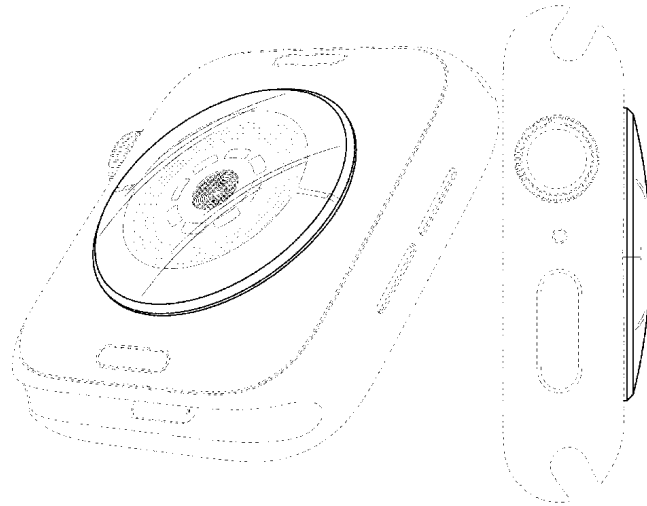
CIRCULAR SHOWER RADIO WITH BASE



Some designs we have reviewed . . .

Electronic devices . . .

ELECTRONIC DEVICE



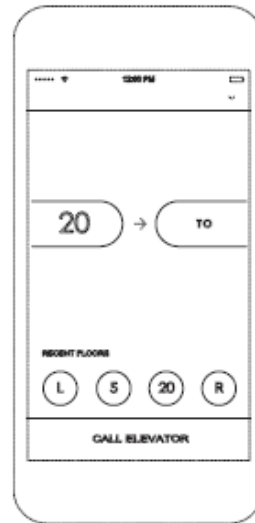
ELECTRONIC DEVICE



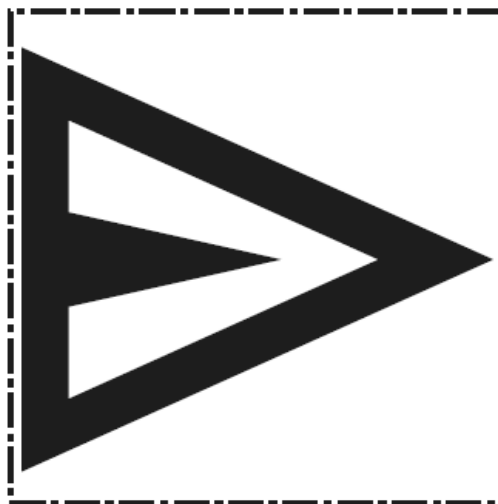
Some designs we have reviewed . . .

Display screens . . .

DISPLAY SCREEN OR PORTION THEREOF WITH GRAPHICAL USER INTERFACE



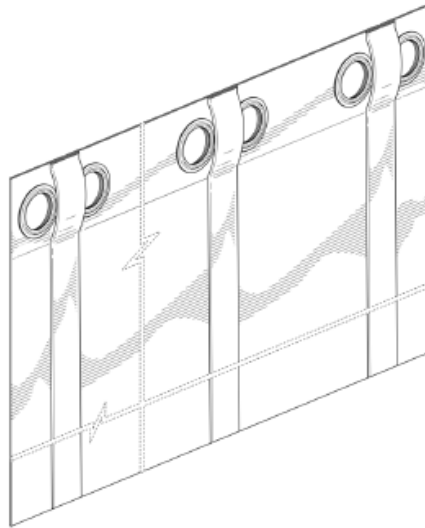
DISPLAY SCREEN WITH ICON



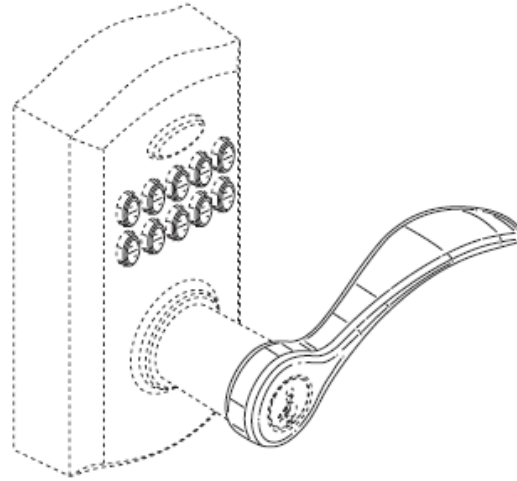
Some designs we have reviewed . . .

Use at home products . . .

BOX PLEAT CURTAIN



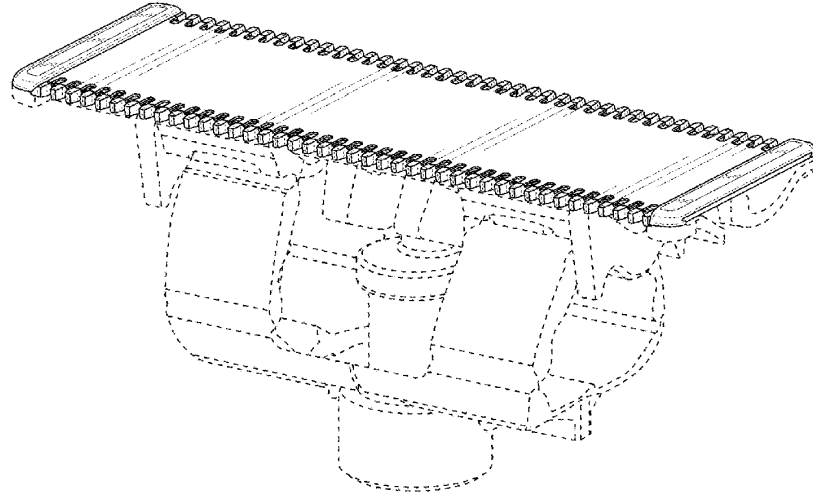
ELECTRONIC DOOR LOCK



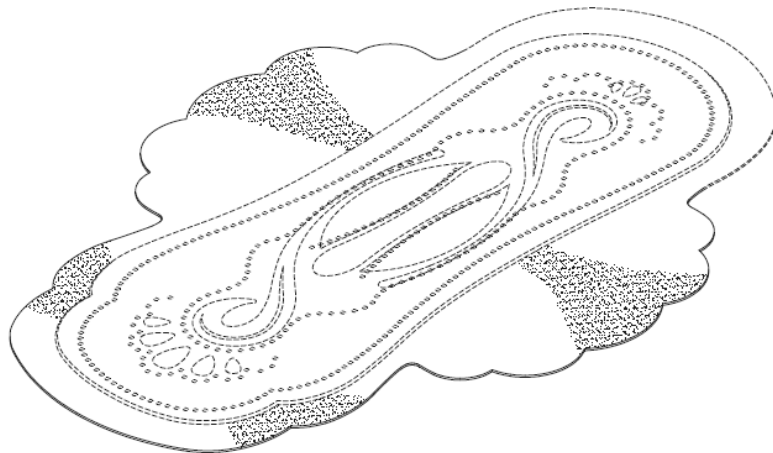
Some designs we have reviewed . . .

Personal care . . .

BLADE FOR HAIR CUTTING APPLIANCE



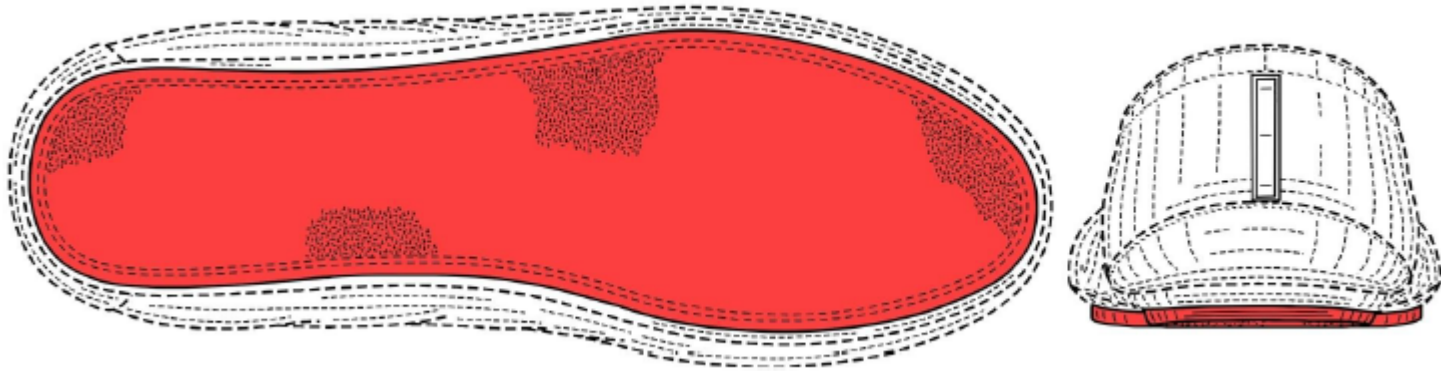
SANITARY NAPKIN



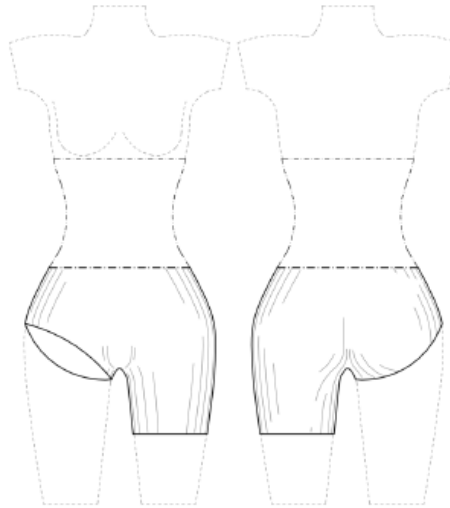
Some designs we have reviewed . . .

Shoes and garments . . .

SINGLE-SOLE SHOE



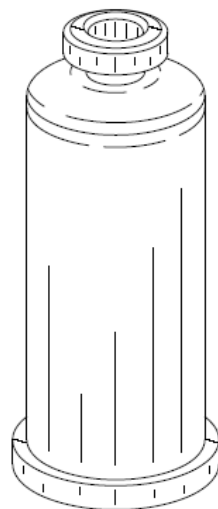
SHORT GARMENT



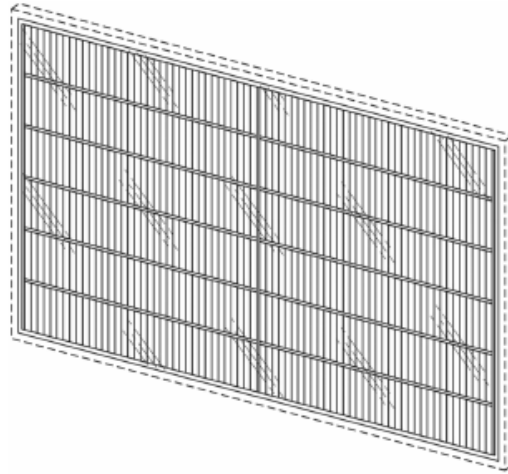
Some designs we have reviewed . . .

Industry . . .

CONTAINER FOR PHARMACEUTICALS



SOLAR PANEL



Resources about design patents

- Free services and resources
 - www.uspto.gov/FreeServices
- IP Identifier
 - ipidentifier.uspto.gov



Questions?

Future programs

Inventor Hour, Episode 28

Thursday, May 23, 2024, noon (ET)

Inventor Hour, Episode 29

Thursday, June 27, 2024, noon (ET)



