

UNITED STATES
PATENT AND TRADEMARK OFFICE



Patent Trial and Appeal Board Inventor Hour: Episode 23

Ulrike Jenks, Administrative Patent Judge

Eric Jeschke, Administrative Patent Judge

John Schneider, Administrative Patent Judge

Special guests:

Chanceity Robinson, Primary Patent Examiner, Technology Center 1700

Joel Attey, Primary Patent Examiner, Technology Center 3700

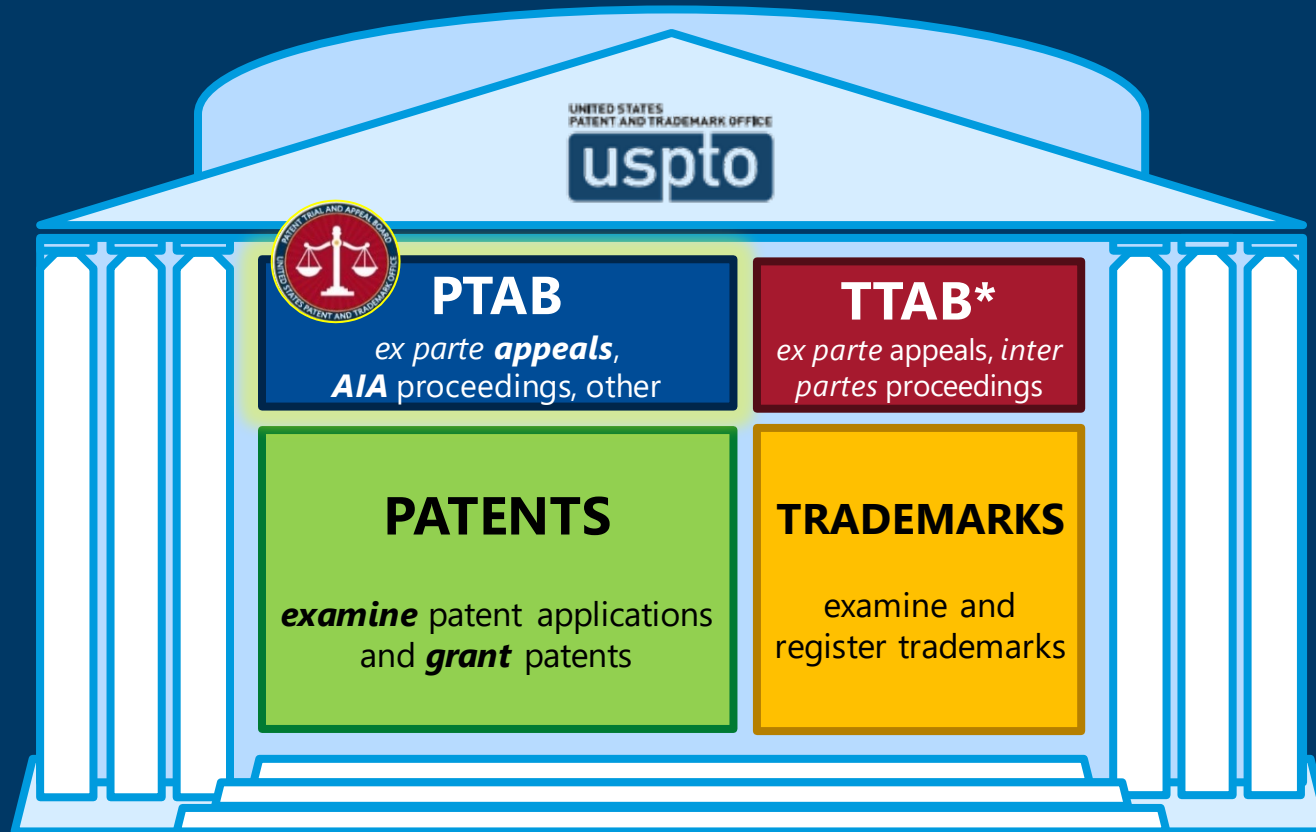
Joshua Benitez, Council for Inclusive Innovation (CI²)

October 26, 2023



UNITED STATES
PATENT AND TRADEMARK OFFICE ®

What is the Patent Trial and Appeal Board?



*Trademark Trial and Appeal Board (TTAB)

Today's agenda

1

**A day
in the life:
patent
examiners**

2

**First-Time Filer
Pilot Program**

3

**Trial byte:
Motions in
AIA trials**

4

Q&A

Question/comment submission

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

– PTABInventorHour@uspto.gov



Ulrike Jenks, Administrative Patent Judge



Meet USPTO professionals

Chanceity Robinson, Technology Center 1700

Joel Attey, Technology Center 3700

Chanceity Robinson



Primary Patent Examiner
Technology Center 1700

Joel Attey



Primary Patent Examiner
Technology Center 3700

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Patent Pro Bono Program for independent inventors & small businesses

Are you an inventor or small business who has limited resources and needs help applying for a patent on an invention? If so, you may be eligible to receive *pro bono* ("for free") attorney representation through the Nationwide Pro Bono Program.

<https://www.uspto.gov/patents/basics/using-legal-services/pro-bono/inventors>



Joshua Benítez, Council for Inclusive Innovation (CI²)



Pilot program:
First-Time Filer Expedited Examination



Joshua Benítez



Executive Secretary &
Program Coordinator



Council for Inclusive Innovation (CI²)

Expand innovation in the United States:

- Tapping into the strength of our nation's **diversity**
- Increasing opportunities for **all Americans** to participate in innovation



For more information visit: <https://www.uspto.gov/ExpandingInnovation>



First-Time Filer Expedited Examination pilot program



- **Increase accessibility** to the patent system for inventors who are
 - **new** to the patent application process
 - including those in **historically underserved** geographic and economic areas.
- **Expedites** the first office action for participants
- Up to **1,000** qualifying applications until **March 11, 2024**
 - Subject to USPTO discretion to end the pilot program sooner



What can this pilot program do for you?

- **Reduce time** to receive first office action on the merits
- Give an **early indication** of whether the invention is patentable
- Potentially get a patent and onto the market **faster**



You may be eligible if you have:

- Filed a **utility nonprovisional** patent application meeting certain guidelines
- **Not** been **named** as an inventor on any other nonprovisional application
- Filed your application electronically using **Patent Center** (in DOCX format)

Cont'd on next page



You may be eligible if you have (cont'd):

- **Completed** your application when filing for program
- Qualified for special status based on **income** (<https://www.uspto.gov/PatentMicroentity>), and
- Received **reasonable training** in the basics of patent application process
 - USPTO training resources for meeting requirement at <https://www.uspto.gov/FirstTimePatentFiler>.
 - Additional USPTO support/resources for inventors & entrepreneurs at <https://www.uspto.gov/CES>.



Information and questions



- For **more information**:
 - <https://www.uspto.gov/FirstTimePatentFiler>.
- Frequently asked **questions**:
 - <https://www.uspto.gov/initiatives/first-time-filer-pilot-program/first-time-filer-expedited-examination-pilot-program>.
- **Contact us**:
 - Office of Patent Legal Administration
 - 571-272-7704
 - CI2FirstTimeFilerPilot@uspto.gov.



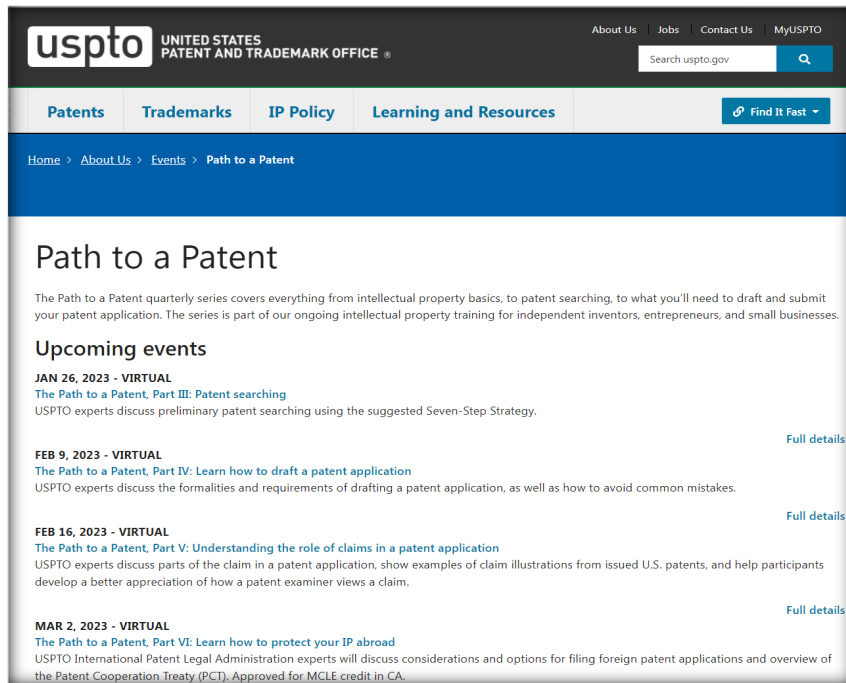
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USPTO “Path to a Patent” series



The screenshot shows the USPTO website's 'Path to a Patent' series page. The header includes the USPTO logo, navigation links (About Us, Jobs, Contact Us, MyUSPTO), and a search bar. The main navigation bar highlights 'Patents', 'Trademarks', 'IP Policy', and 'Learning and Resources'. The breadcrumb trail reads: Home > About Us > Events > Path to a Patent. The page title is 'Path to a Patent'. A descriptive paragraph states: 'The Path to a Patent quarterly series covers everything from intellectual property basics, to patent searching, to what you'll need to draft and submit your patent application. The series is part of our ongoing intellectual property training for independent inventors, entrepreneurs, and small businesses.' Under the 'Upcoming events' section, four events are listed:

- JAN 26, 2023 - VIRTUAL**
The Path to a Patent, Part III: Patent searching
USPTO experts discuss preliminary patent searching using the suggested Seven-Step Strategy. [Full details](#)
- FEB 9, 2023 - VIRTUAL**
The Path to a Patent, Part IV: Learn how to draft a patent application
USPTO experts discuss the formalities and requirements of drafting a patent application, as well as how to avoid common mistakes. [Full details](#)
- FEB 16, 2023 - VIRTUAL**
The Path to a Patent, Part V: Understanding the role of claims in a patent application
USPTO experts discuss parts of the claim in a patent application, show examples of claim illustrations from issued U.S. patents, and help participants develop a better appreciation of how a patent examiner views a claim. [Full details](#)
- MAR 2, 2023 - VIRTUAL**
The Path to a Patent, Part VI: Learn how to protect your IP abroad
USPTO International Patent Legal Administration experts will discuss considerations and options for filing foreign patent applications and overview of the Patent Cooperation Treaty (PCT). Approved for MCLE credit in CA. [Full details](#)

This series covers everything from intellectual property **basics**, to patent **searching**, to what you'll need to **draft** and **submit** your patent application.

More information:
<https://uspto.gov/about-us/events/path-patent>



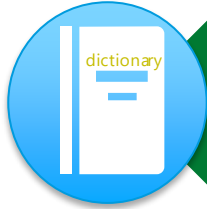
Eric Jeschke, Administrative Patent Judge



Trial byte:

Motions in AIA Trials

Agenda



Definition



General guidance



Common types

mo·tion ('mō-shən)

an **application**

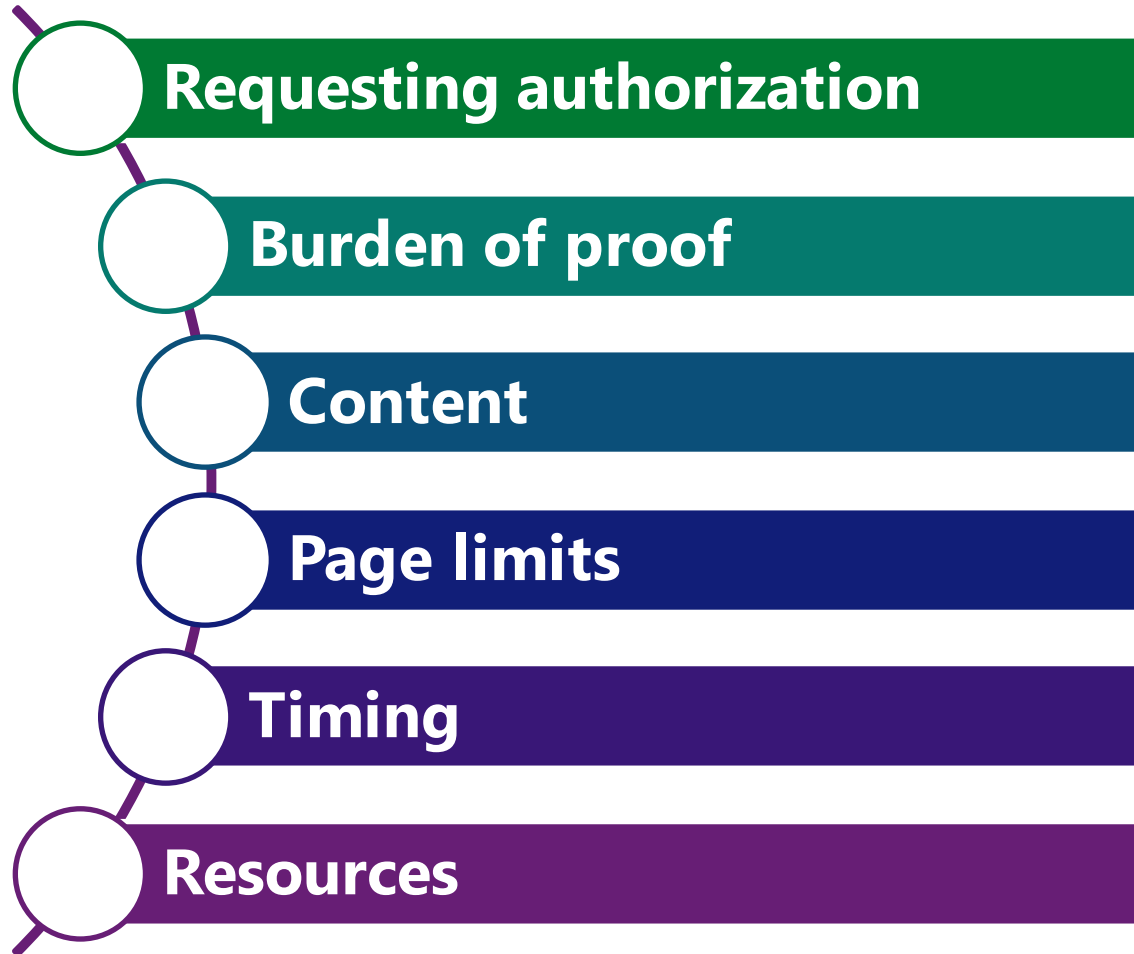
made to a court or **judge**

to obtain an **order**, **ruling**, or direction

<https://www.merriam-webster.com/dictionary/motion>



General guidance



Requesting authorization (if required)

Email requirement for conference call

- * Copy all parties
- * Generally indicate relief requested
- * No arguments / attachments
- * Times when all parties available
- * Address meet & confer request & state any opposition

Conference call with panel

File motion (if authorized)

Burden of proof



Burden of proof to establish entitlement to requested relief is on **moving party**: 37 C.F.R. § 42.20(c)

Content

Motion

- * Relief requested
- * Reason for request
- * Significance of evidence, material facts, law
- * Required showing for particular type of motion

Opposition

- * Requirements for motions
- * Disputed material facts

Reply

- * Directed only to corresponding opposition

Page limits



Motions - **15 pages** unless advance waiver

Oppositions - same as corresponding motion

Replies - **5 pages**

Board may set other page constraints

Page limits:

- **Include** any statement of material facts to be admitted or denied
- **Exclude** table of contents, certificate of service, appendix of exhibits

Timing



Set in scheduling order

Patent owner motion to amend (and opposition/reply)

Revised motion to amend (if filed)

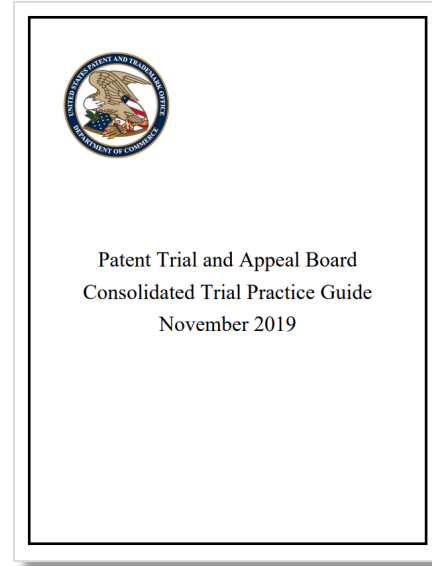
Motion(s) to exclude evidence (and opposition/reply)

Opposition default – 1 month

Typically set much shorter

Board can deny relief not promptly sought: § 42.25(b)

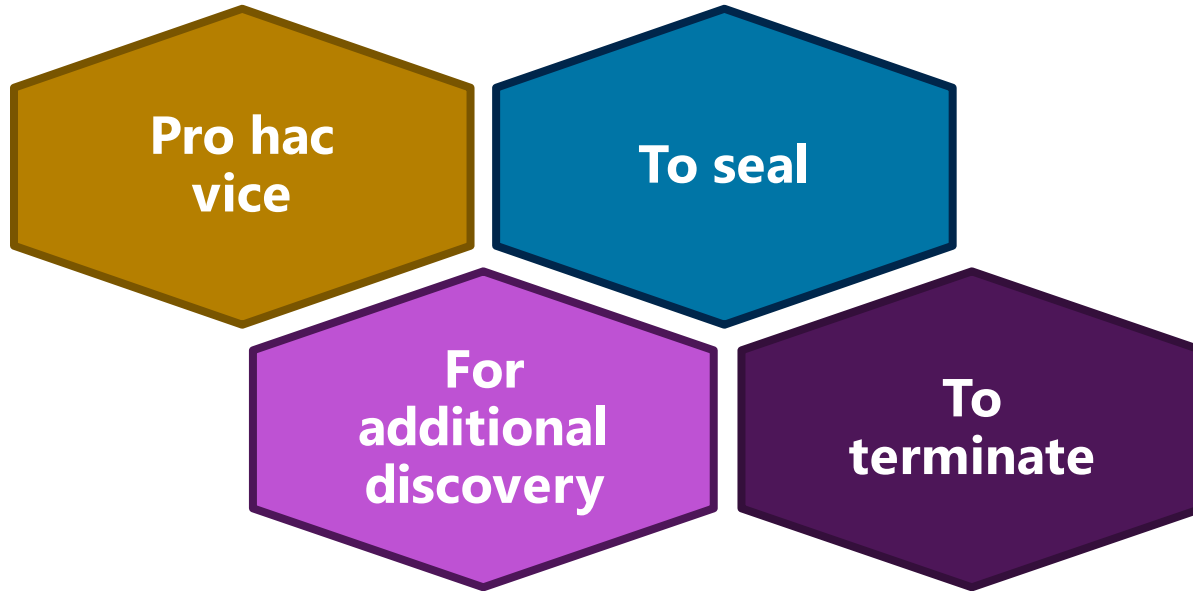
Resources



Rules 37 C.F.R. § 42.20–25 (<https://www.govinfo.gov/content/pkg/CFR-2022-title37-vol1/pdf/CFR-2022-title37-vol1.pdf>)

Trial Practice Guide (www.uspto.gov/TrialPracticeGuideConsolidated)

Common motions in AIA proceedings



Pro hac vice motion

37 C.F.R. § 42.10

Why

- Allow **non-PTO-registered** attorney to appear for specific proceeding

How authorized

- In notice of filing date

When

- No sooner than **21 days** after service of petition
- Opposition w/in **1 week**
- **No reply** unless Board authorizes

Pro hac vice motion

37 C.F.R. § 42.10

What

- Must show:
 - Legal & technical **qualifications**
 - Established **familiarity** with subject matter
 - **Party intent** to be represented
- **Affidavit** of counsel seeking admission

Misc.

- Eligible only as **backup** counsel
- **May not withdraw** without Board authorization

Motion to seal

37 C.F.R. §§ 42.14, 42.54

Why

- To keep **confidential** your (or a third party's) information

How authorized

- Authorization to file **not required**

When

- **Concurrent** with filing of document or thing to be sealed

Motion to seal

37 C.F.R. §§ 42.14, 42.54

What

- Explanation **why** info is **confidential**
- Proposed **protective order** (if one not yet entered)
 - Entry of PO (even Board's default PO) not automatic -- must request
 - Show difference from default order
- Certification of **good faith attempt to confer** with opposing party

Misc.

- Standard = **good cause**
- Public policy to make information available
- Consider **redaction**
- Move to **expunge** confidential info after final judgement if appropriate (37 C.F.R. § 42.56)

Motion for additional discovery

37 C.F.R. § 42.51

Why

- Obtain more information in opposing party's possession to support your case

How authorized

- By request to panel

When

- Should be timely made after need for additional discovery arises
- AIA trials do not have a formal "discovery deadline" like many district courts, but do have statutory deadlines

Motion for additional discovery

37 C.F.R. § 42.51

What

- IPR = Interest of Justice
 - *Garmin* factors
 - More than possibility/**mere allegation**?
 - About other party's **litigation positions**/underlying basis?
 - Other means to get **equivalent info**?
 - Instructions for response **easily understandable**?
 - Overly **burdensome**?
- PGR = good cause

Misc.

- Very fact specific issues
- Parties may agree to additional discovery between themselves

Motion to terminate

37 C.F.R. §§ 42.72, 42.73

Why

- To seek termination
 - Of a **party**
 - Of the **proceeding**

How authorized

- By request to panel

When

- Examples:
 - Judgment against self (any time during proceeding)
 - After parties settle
 - Where an earlier final written decision creates estoppel that prevents petitioner, real party in interest or privy of the petitioner, from maintaining a proceeding

Motion to terminate

37 C.F.R. §§ 42.72, 42.73

What

- A party may request adverse judgment against itself. Actions interpreted as adverse judgment can include:
 - Disclaimer of patent, claim cancellation, concession of unpatentability, abandonment of contest
- Settlement:
 - Can settle any issue via joint request
 - All agreement/understandings in writing & filed with Board
 - May treat as business confidential – request to keep separate
 - Board not a party

Misc.

- Board **may proceed to FWD** (even if no petitioner remains)
- Estoppel
 - Ground **raised** or **reasonably could have** been raised

Common motions: Summary

Motion	Authorization Required	37 CFR §	Consolidated Trial Practice Guide page
Pro Hac Vice	Yes – in notice of filing date	42.10	11
To seal	No	42.14; 42.54-55	19
For additional Discovery	Yes	42.51	4, 6-7, 22-34, 92, 100
To terminate	Yes	42.72; 42.73	4, 53, 86

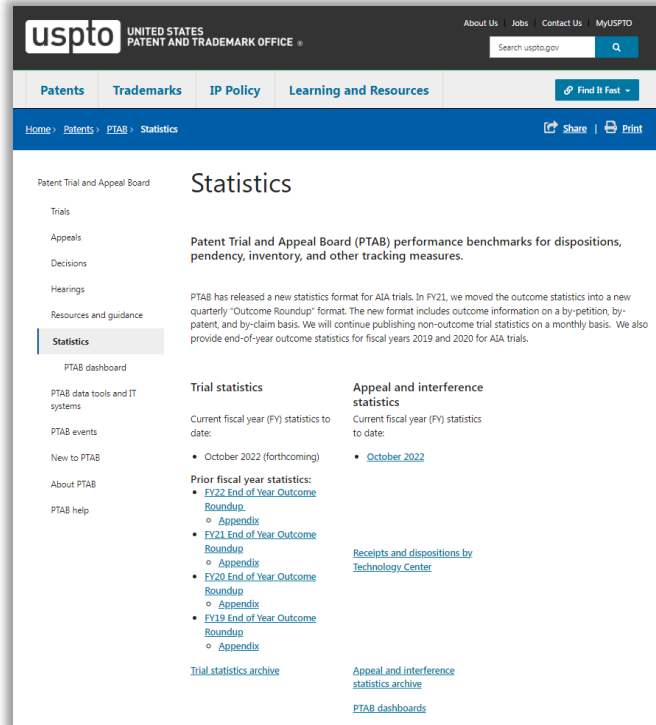
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PTAB statistics



More information:

<https://www.uspto.gov/patents/ptab/statistics>





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THANK YOU!

Inventor Hour will return
Thursday Jan. 25, 2024, noon (ET)

See you in the new year!



