

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# **USPTO administrative tribunal: Patent Trial and Appeal Board**

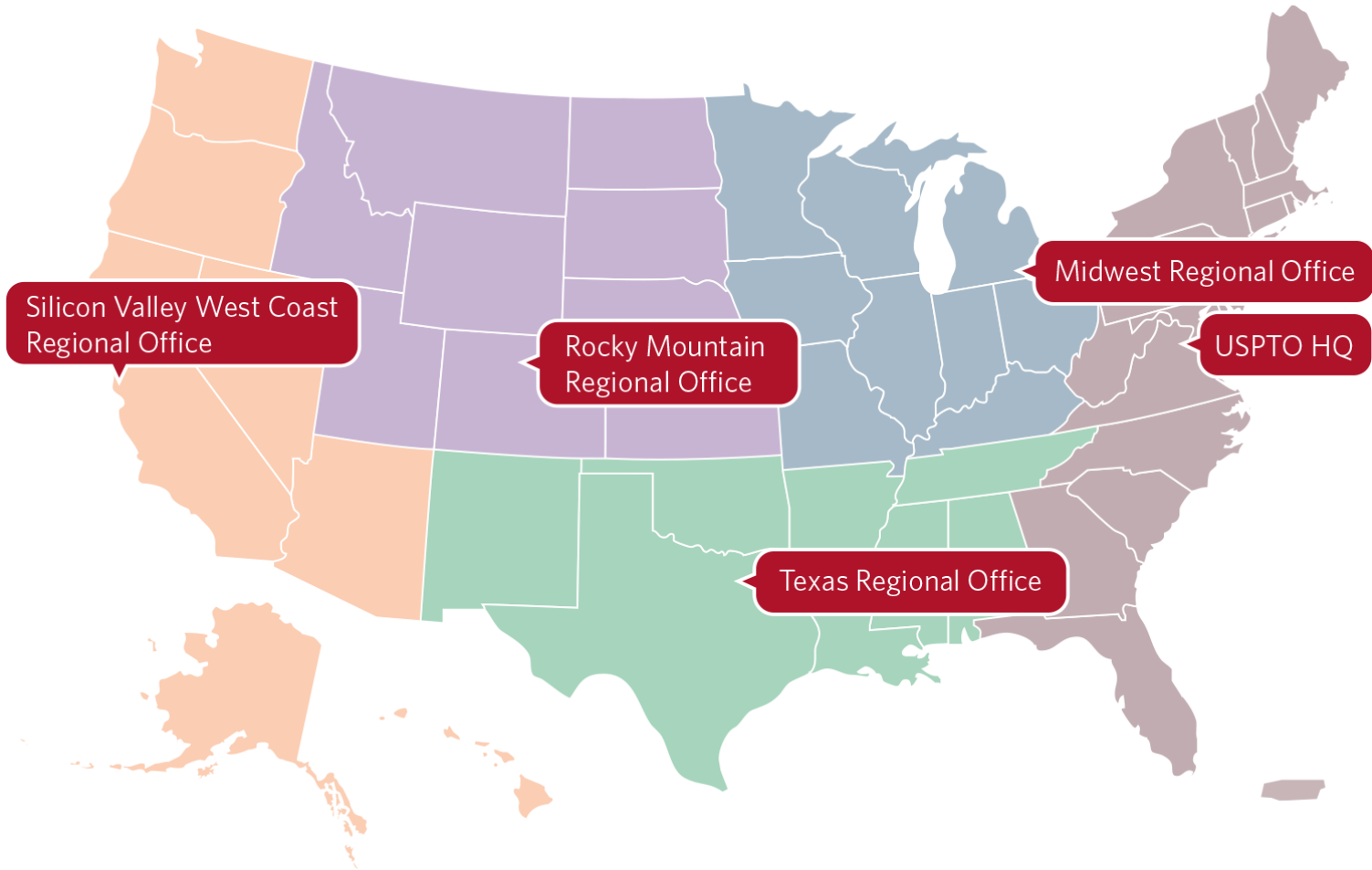
Georgianna Witt Braden, Lead Administrative Patent Judge

February 23, 2023

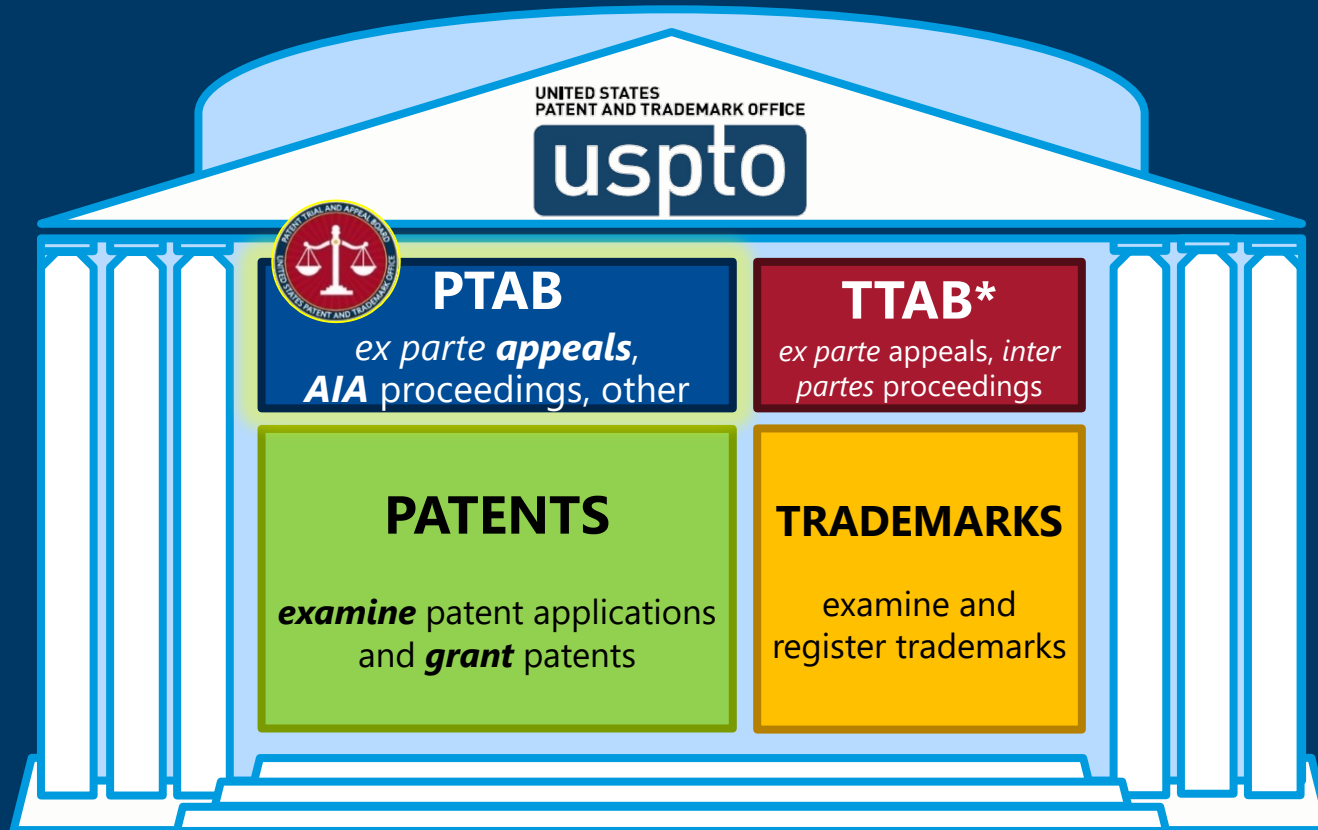


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PATENT AND TRADEMARK OFFICE ®

# USPTO offices



# What is the Patent Trial and Appeal Board?



# Administrative tribunals

- Within the USPTO
- An adjudicatory body that
  - reviews agency decisions
  - decides whether claims in issued patents are patentable when challenged by third parties
  - follows binding law and agency policy
- Jurisdiction is limited to questions of patentability



# **Patent Trial and Appeal Board**

# The Board

- The Board is created by statute (35 U.S.C. § 6)
  - That statute mandates the Board's:
    - Duties
    - Composition
    - Qualifications for membership
    - Panel form of decision-making (appeals, derivation proceedings, post-grant reviews, and inter partes reviews)
- Original “board of disinterested persons” provided for in Patent Act of 1836
- Patent Act of 1861 formed the permanent Board of Appeals of “persons of competent legal knowledge and scientific ability”
  - President Lincoln appointed George Harding, Esq. of Philadelphia as the first “Examiner-in-Chief”

# The administrative patent judges

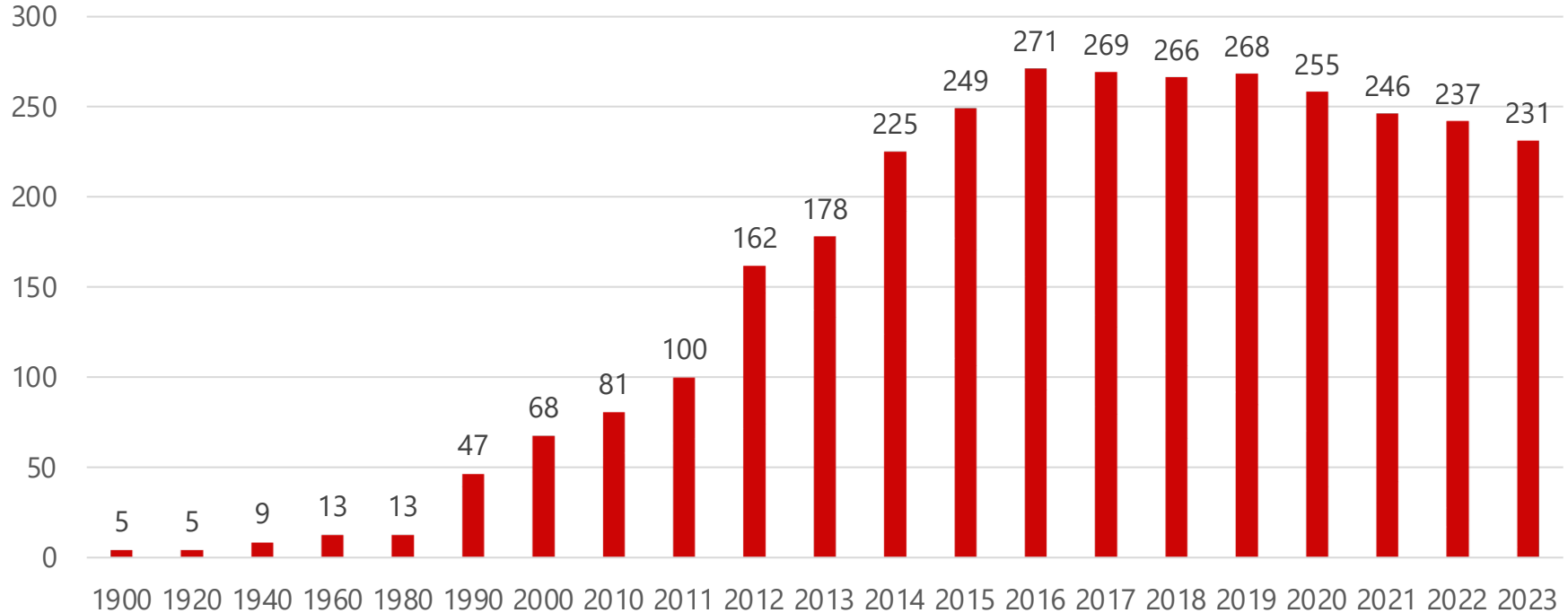
- Chief judge (1)
- Deputy chief judge (1)
- Vice chief judges (5)
- Senior lead judges (3)
- Lead judges (30)
- Judges (191)
  - Patent attorneys, law clerks, paralegals, administrators, and support staff assist the judges with their work at the board





# Board size over time

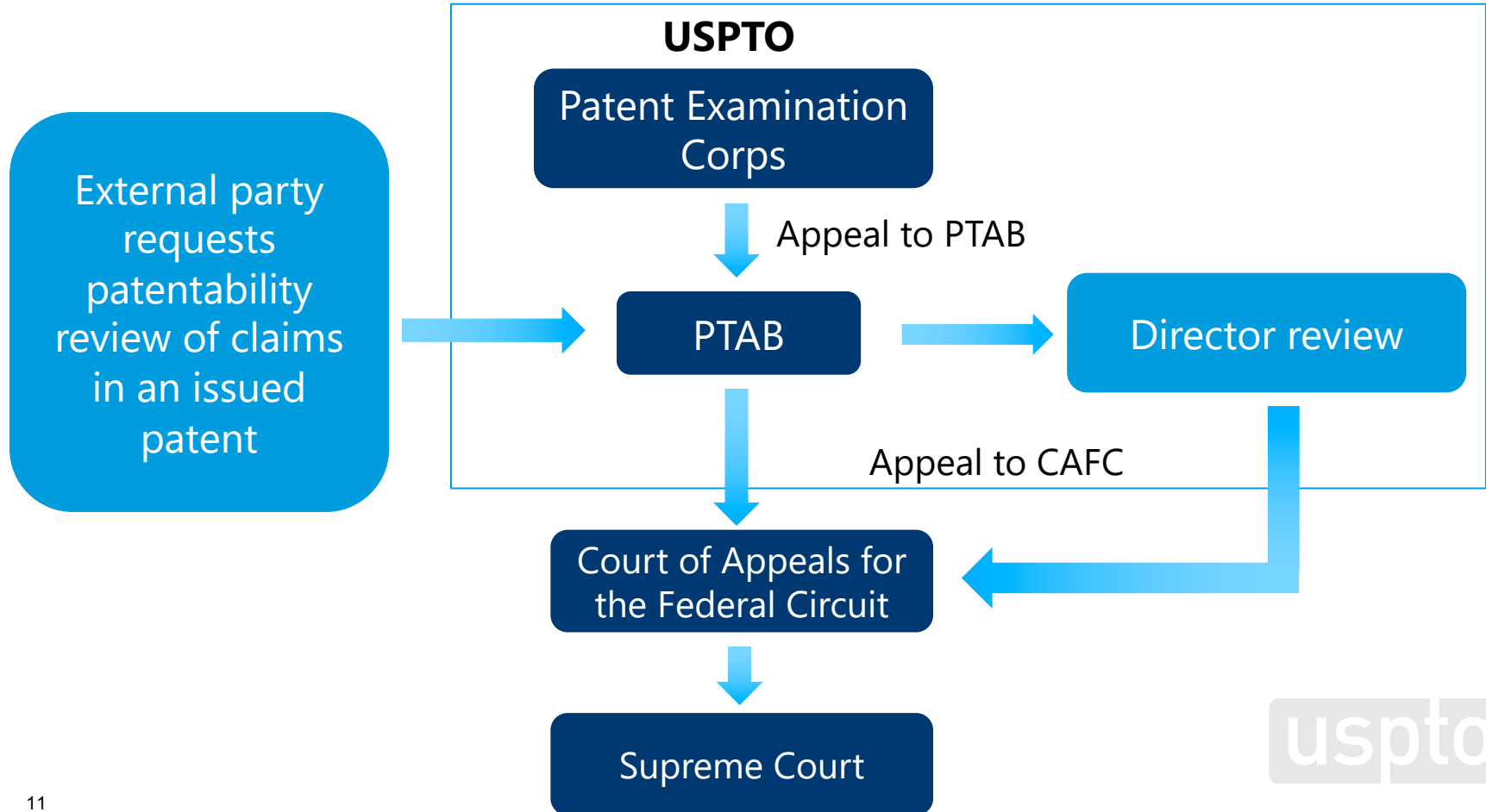
(Calendar year)



# PTAB judges

- **Education**
  - Must possess a law degree
  - Must possess a technical degree
- **Professional license**
  - Must be a member in good standing of the legal bar of a state, Washington, D.C., or U.S. territory
- **Experts in patent law**
  - Must have significant, specialized experience in the patent field
  - Must have education and/or work experience in science or engineering

# The general process



# Types of PTAB proceedings

- Appeals in ex parte patent applications
- Appeals in ex parte and inter partes reexamination proceedings
- Reissues
- Interferences/**Derivations (DER)**
- **Inter partes reviews (IPR)**
- **Post-grant reviews (PGR)**



# Case processing at PTAB

- Docket case
  - Transfers jurisdiction from examiner if a case is appealed
- Assign a panel (usually 3 judges), pursuant to SOP1
- Conference between judges
- Oral hearing (if requested)
- Post-hearing conference between judges
- Circulate opinion
- Issue decision
- Rehearing request
- Appeal

**Ex parte appeals**

# Patent Examiner

- To serve as advocate/protector of the public interest with respect to intellectual property.
- To provide direct service and assistance to customers from inside and outside the USPTO.
- To evaluate patentability with respect to invention(s) claimed in a patent application under the conditions for patentability set forth in Title 35 of the United States Code.



# Basis for rejection

35 U.S.C. §101

Inventions patentable

35 U.S.C. §112

Specification

35 U.S.C. §102

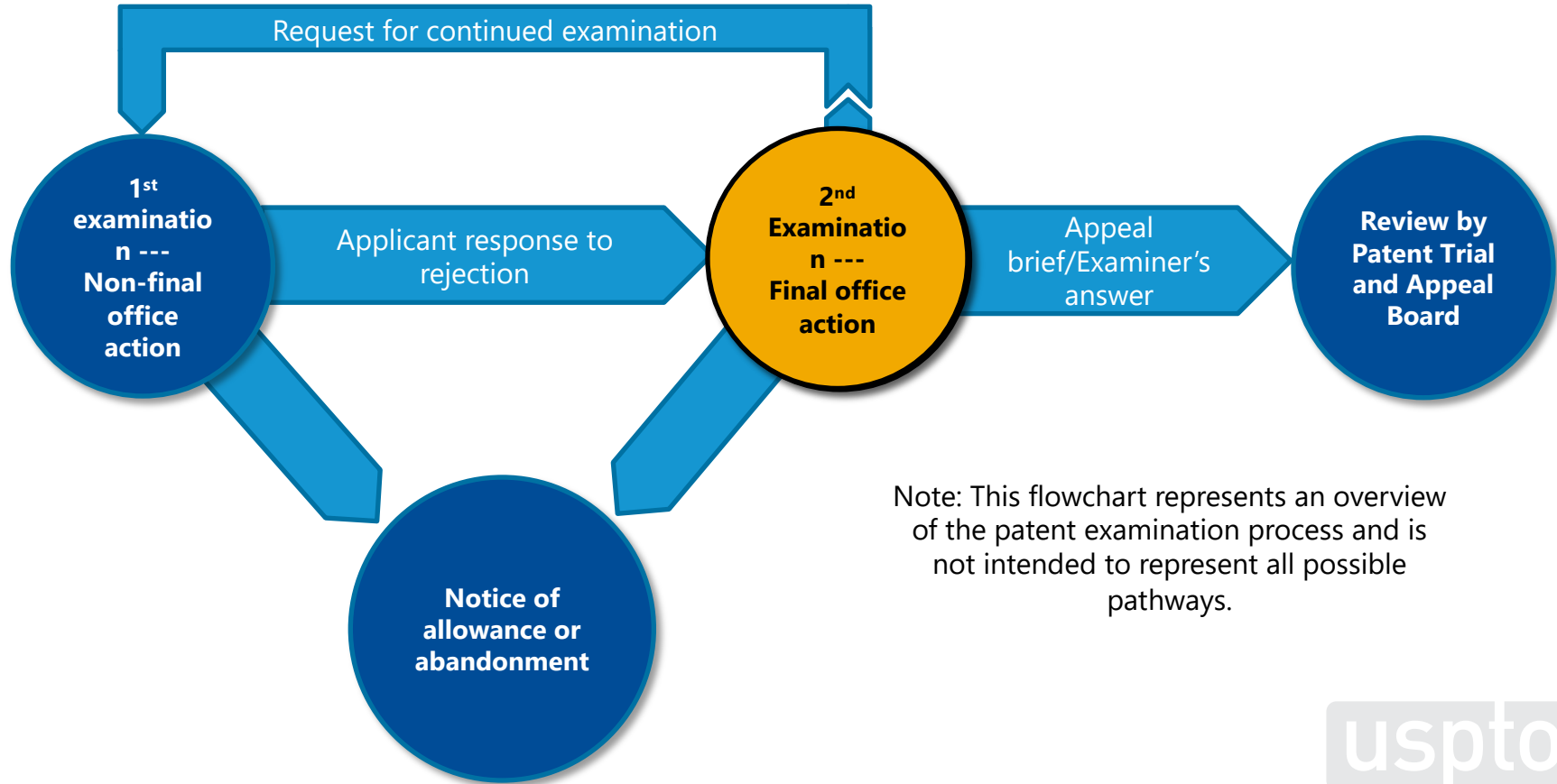
Conditions for patentability: novelty

35 U.S.C. §103

Conditions for patentability: non-obvious  
subject matter

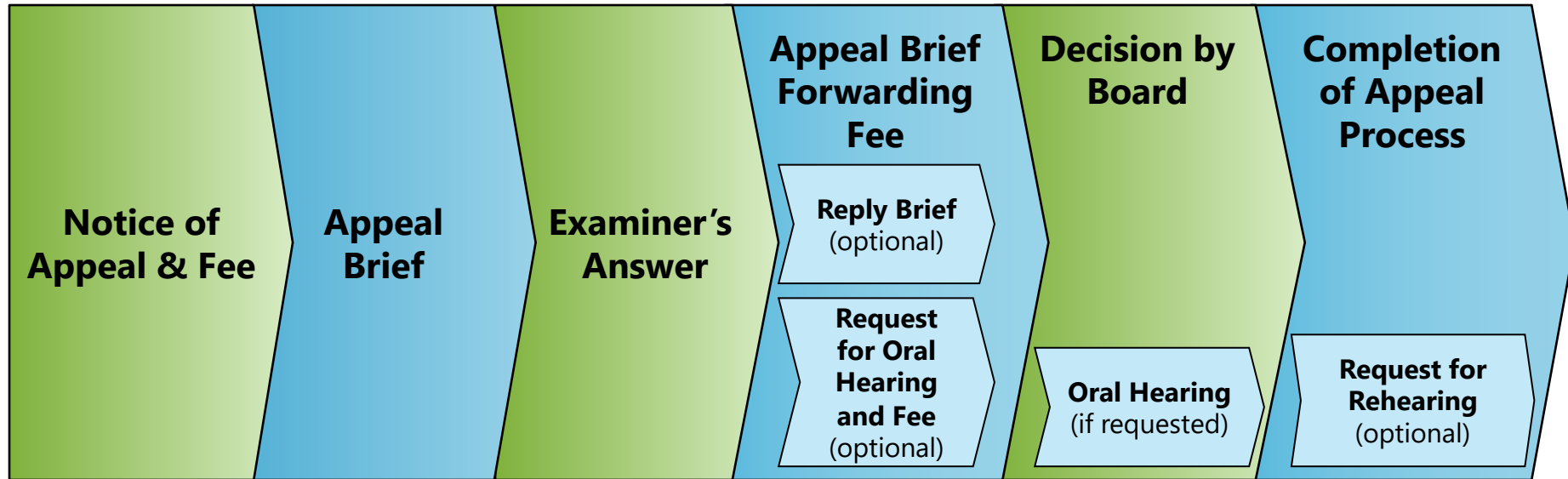


# Overview of patent examination process



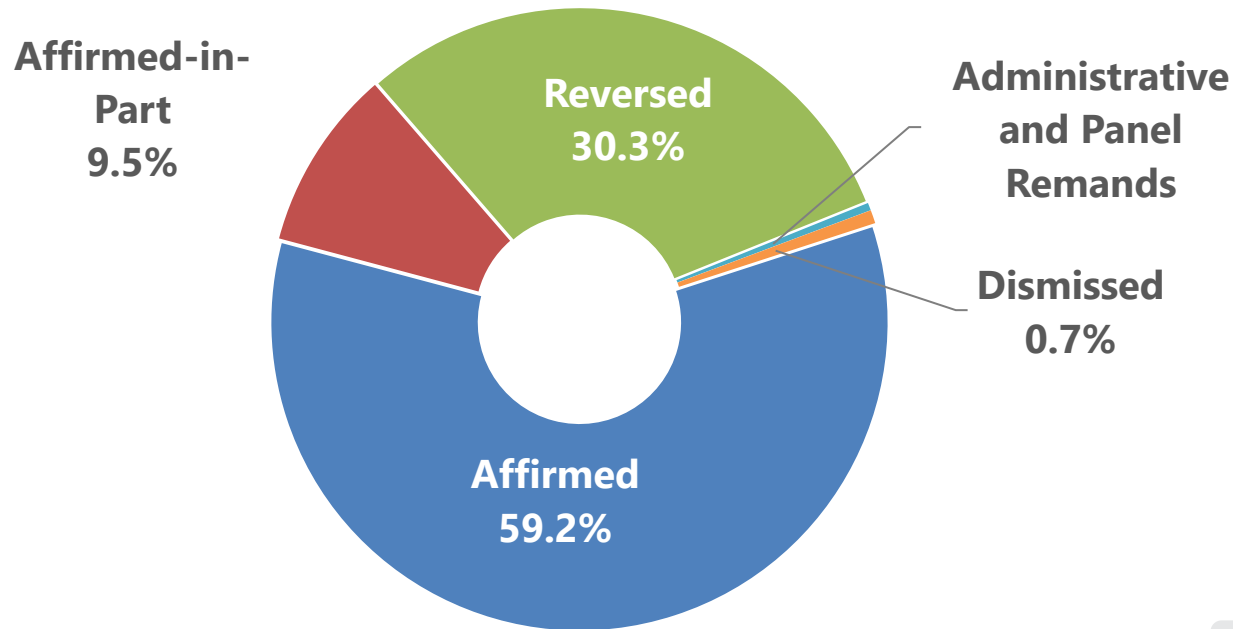
Note: This flowchart represents an overview of the patent examination process and is not intended to represent all possible pathways.

# PTAB Appeals – general process

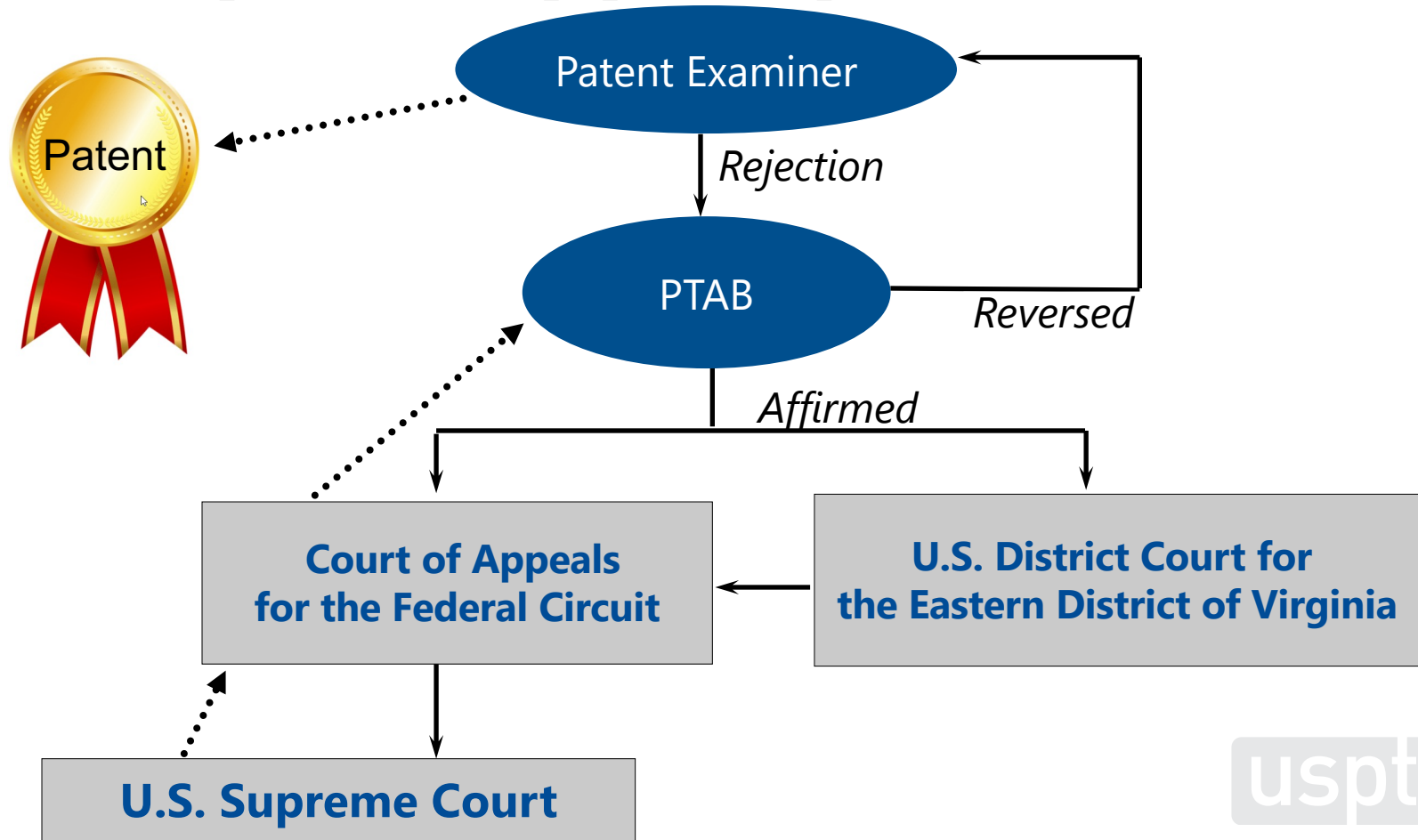


# Appeal outcomes in FY23

(Oct. 1, 2022 - Dec. 31, 2022)



# The *ex parte* appeal process



# Allowance, issue, and after patent grant

## Allowance

- "Allowance" refers to the decision-making aspect of the process.

## Issue

- "Issue" refers to the administrative and procedural aspects of the process.
- An application is ISSUED after a decision to ALLOW the application has been made by the examiner

## After patent grant

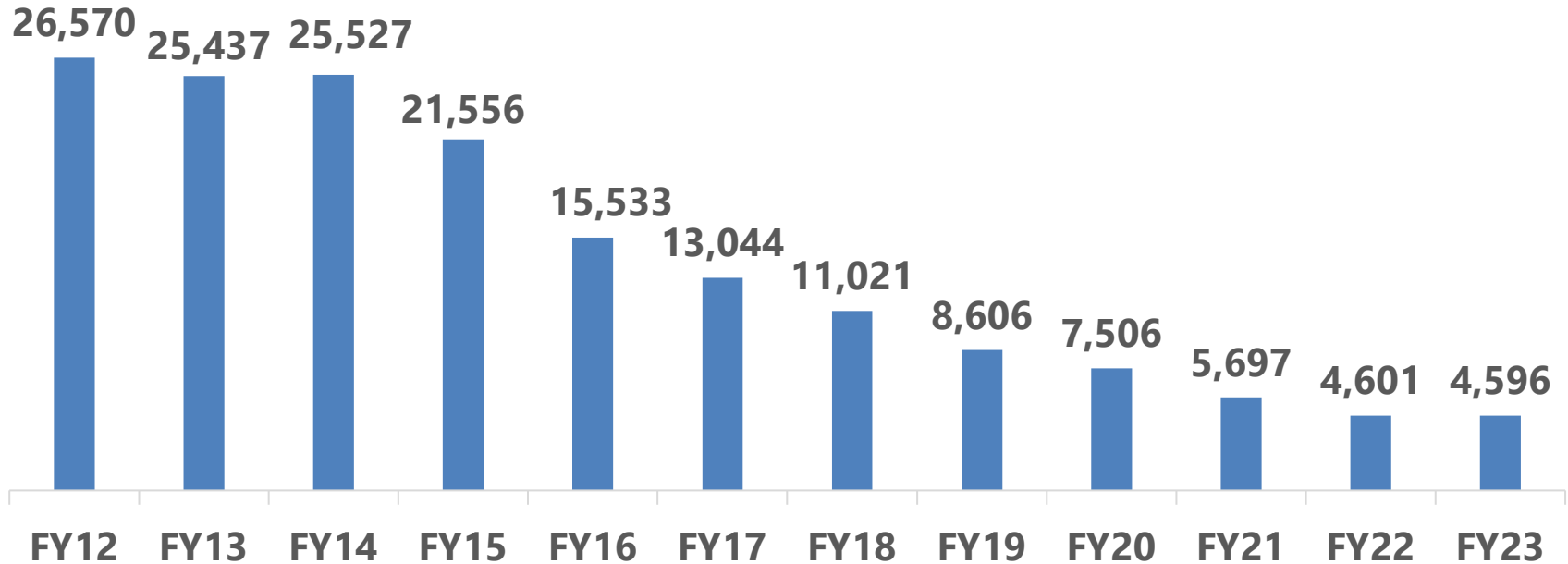
- Maintenance fees for utility patents due 3.5, 7.5, and 11.5 years after patent issue date.
- Correction by way of Certificate of Correction or Reissue.

Fee schedule: <https://www.uspto.gov/learning-and-resources/fees-and-payment/uspto-fee-schedule>



# Pending appeals FY12 to FY23

(Sept. 30, 2012 – Dec. 31, 2022)

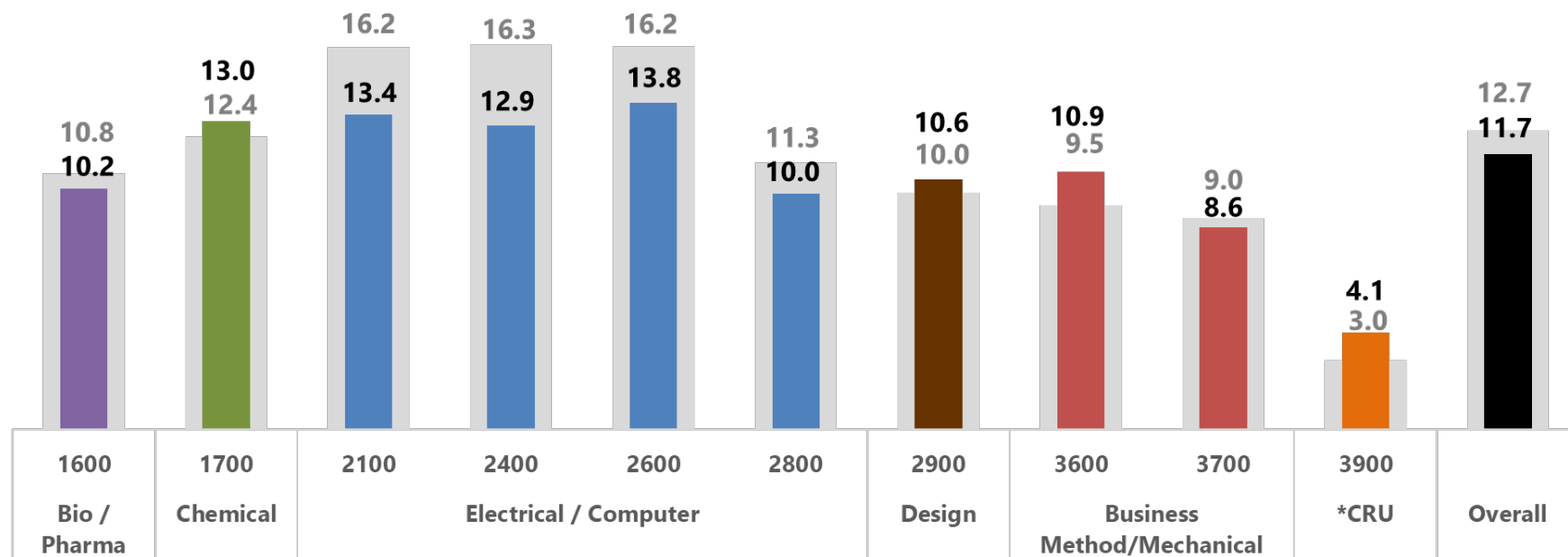


# Pendency of decided appeals

(Oct. 2021 – Dec. 2021 compared to Oct. 2022 – Dec. 2022)

■ FY22

■ FY23



Pendency is calculated as average months from Board receipt date to final decision.

Pendency is calculated for a three month period compared to the same period the previous year.

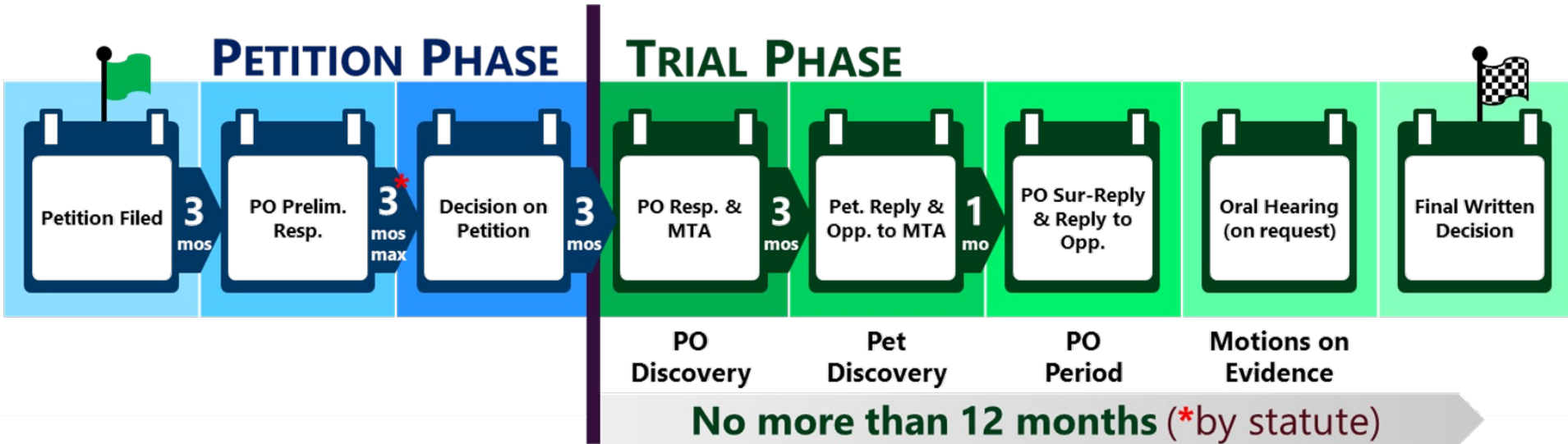
\*CRU (Central Reexamination Unit) decisions include *ex parte* reexams, *inter partes* reexam, supplemental examination review, and reissues from all technologies.



# AIA trial proceedings



# Hearings: AIA trials



# Scope of grounds in petition

- IPR
  - Only on § 102 and § 103 grounds, and only on basis of prior art consisting of patents and printed publications
- PGR
  - On any grounds for invalidity (except best mode)

# Standard for initiating review

- IPR
  - “A reasonable likelihood that the petitioner would prevail” with respect to at least one challenged claim
- PGR
  - “More likely than not that at least one claim is unpatentable” or the petition raises “a novel or unsettled legal question that is important to other patents or applications”



# AIA trial proceedings

- Standard of proof: a “preponderance of evidence”
  - Lower than “clear and convincing evidence” required to prevail in district courts
- Final written decision
  - Issued within 12 months of institution
  - Can extend by 6 months, but only for “good cause”
  - Generally, entire process (petition to termination or final decision) will take 18 months or less

# Potential outcomes in AIA proceedings

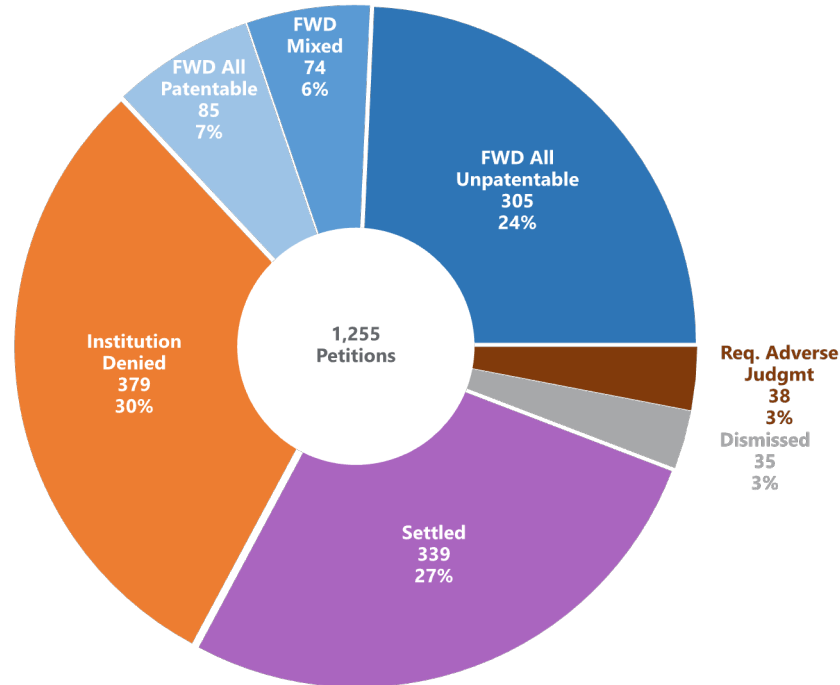
- Deny institution
- Settle
- Dismiss
- Request for Adverse Judgment
- Final Written Decision

# Dispositions in final written decisions

- Find all challenged claims unpatentable
- Mixed outcome
  - Find some challenged claims unpatentable
  - Find some challenged claims patentable (i.e., petitioner did not meet burden to show unpatentable)
- Find all challenged claims patentable

# Outcomes by petition

(FY22: Oct. 1, 2021 to Sept. 30, 2022)

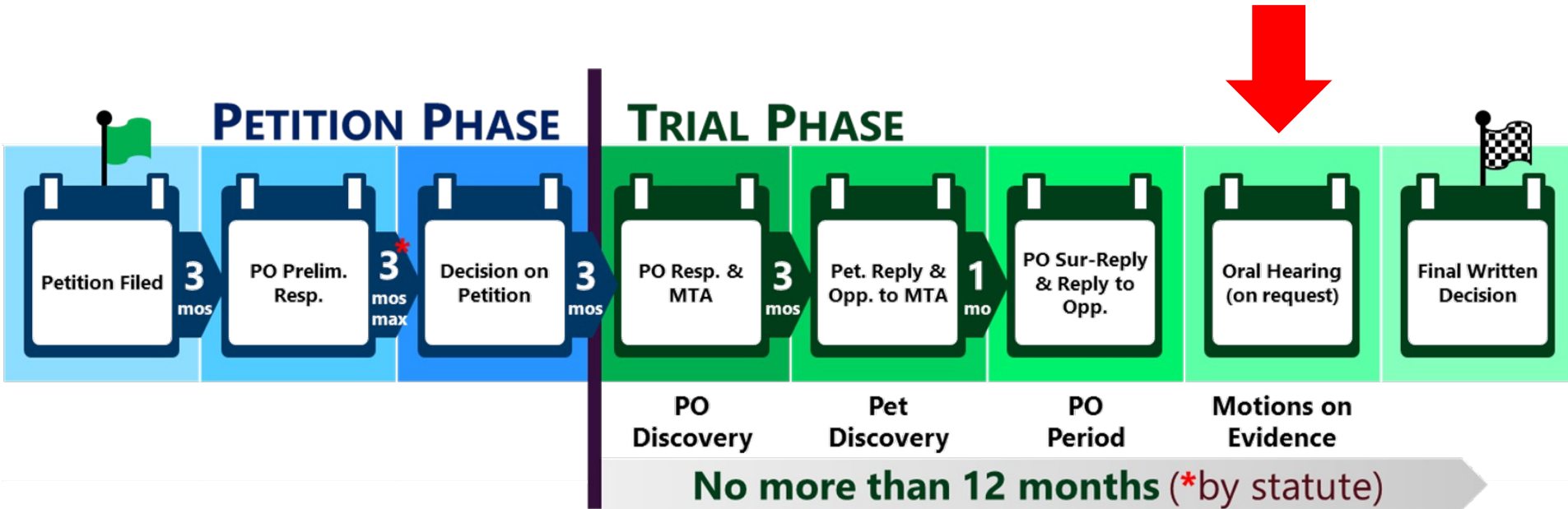


FWD patentability or unpatentability reported with respect to the claims at issue in the FWD. Joined cases are excluded.

# Hearings before the PTAB



# Hearings: AIA trials



# Purpose of a PTAB hearing

- Hearing is an opportunity to persuade the panel that the existing record supports your position and answer the judges' questions about the case.
- PTAB hearings differ from district court trials
  - All evidence and argument is already in the record
    - New evidence is not permitted
    - New argument is not permitted

# PTAB judges

- PTAB judges sit in 3-judge panels
- PTAB judges differ from district court judges & juries
  - APJs have legal and scientific training
  - APJs come into the hearing with:
    - knowledge of the technology, background, and prior art
    - knowledge of the evidence and arguments of record
    - unresolved questions regarding dispositive issues
    - some preliminary conclusions on the merits
  - APJs are concerned with the record, not with how well you work a courtroom

# Judge pre-hearing preparation

- Before the hearing, judges review the record
- At an internal pre-hearing conference, judges discuss a case to:
  - Crystallize the key issues
  - Walk through the evidence of record
- Judges make no decision on the outcome before the hearing, but will usually have **questions they want answered** and **facts they want confirmed**

# PTAB hearings logistics

- Hearings may be conducted in-person or remotely
- Judges have a copy of the record and demonstratives
  - Refer to specific Demonstratives, Papers, or Exhibits by slide and page number
- Hearing transcript becomes part of the record

# Legal Experience and Advancement Program (LEAP)

- Launched on May 15, 2020
- Goal: to foster the advancement of the next generation of patent practitioners through skills development and oral advocacy opportunities at the PTAB
- Targeting patent agents and attorneys newer to the practice of law or to the PTAB
- LEAP practitioner participation is an option in both ex parte appeals and AIA trials
- <https://www.uspto.gov/patents/ptab/leap>



**PTAB resources**

# New to PTAB

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

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?](#)



## 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?

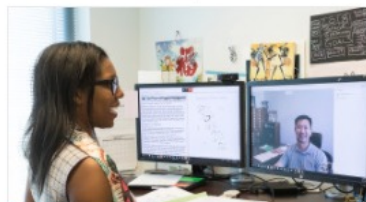
Contact PTAB or peruse helpful FAQs.

- > [Get help](#)



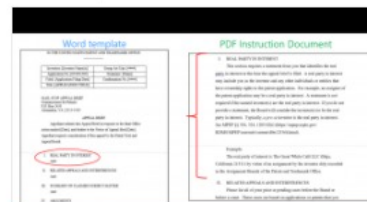
### PTAB BOARDSIDE CHAT WEBINARS

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





# PTAB Boardside Chat webinar series

- Addresses best practices before the Board and answers questions raised by attendees
- Free, bi-monthly webinars are open to all
- Register for an upcoming webinar or see presentations and videos from past webinars:  
<https://www.uspto.gov/patents/ptab/ptab-boardside-chats>



# PTAB Pro Bono Program

[www.uspto.gov/ptabprobono](http://www.uspto.gov/ptabprobono)

Financially under-resourced inventors are matched with volunteer patent professionals to obtain free legal assistance in proceedings before the PTAB. Currently open to *ex parte* appeals and later expanding to AIA trials.



## For inventors:

- Eliminate financial barriers for legal assistance
- Aid under-resourced inventors in making effective arguments

## For volunteers:

- Provide legal help in their field of legal practice
- Create new contacts in the community



# PTAB resources

- Information concerning the board:
  - <https://www.uspto.gov/patents/ptab>
- Information concerning appeals:
  - <https://www.uspto.gov/patents/ptab/appeals>
- Information concerning AIA trials:
  - <https://www.uspto.gov/patents/ptab/trials>
- Information concerning PTAB statistics:
  - <https://www.uspto.gov/patents/ptab/statistics>
- Information concerning board decisions:
  - <https://www.uspto.gov/patents/ptab/decisions>





# Thank you!

**Georgianna Witt Braden**

Lead Administrative Patent  
Judge

(571) 272-9797

[www.uspto.gov](http://www.uspto.gov)