

UNITED STATES
PATENT AND TRADEMARK OFFICE



Patent Trial and Appeal Board Inventor Hour: Episode 13

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Arthur Peslak, Administrative Patent Judge

Ulrike Jenks, Administrative Patent Judge

Lynne Browne, Administrative Patent Judge

Christopher Paulraj, Administrative Patent Judge

Victoria F. Phillips, Clinic Director, Glushko-Samuels IP Law Clinic, American University Washington College of Law

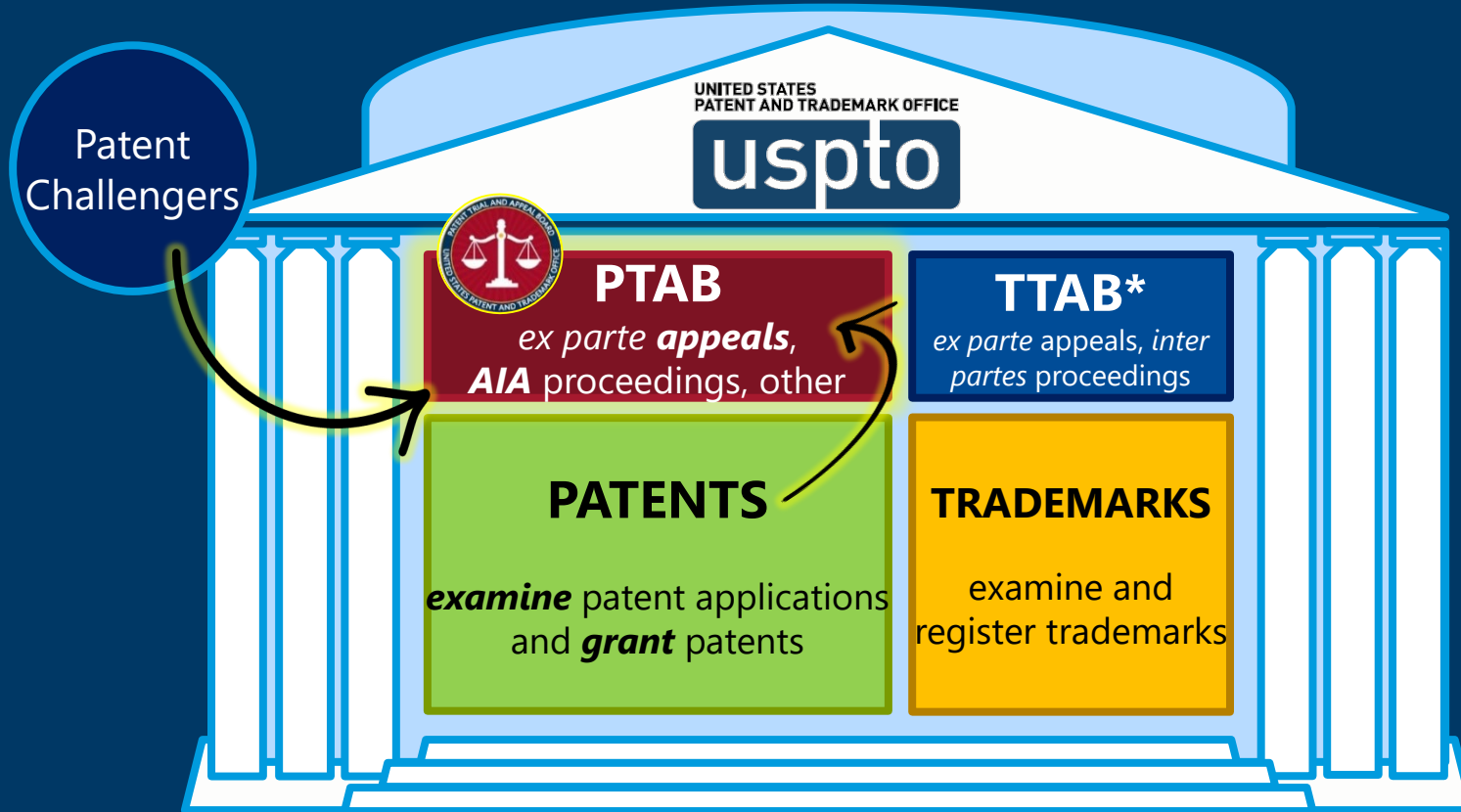
David Grossman, Adjunct Patent Supervisor, Glushko-Samuels IP Law Clinic,
American University Washington College of Law



UNITED STATES
PATENT AND TRADEMARK OFFICE ®

October 27, 2022

What is the Patent Trial and Appeal Board?



Today's agenda

1

Appeal byte:
What is a claim?

2

Trial byte:
Motions to Amend

3

Case study:
Ex parte Lewis

4

**Meet a
Law School IP
Clinic Director**

5

Q&A

Question/comment submission

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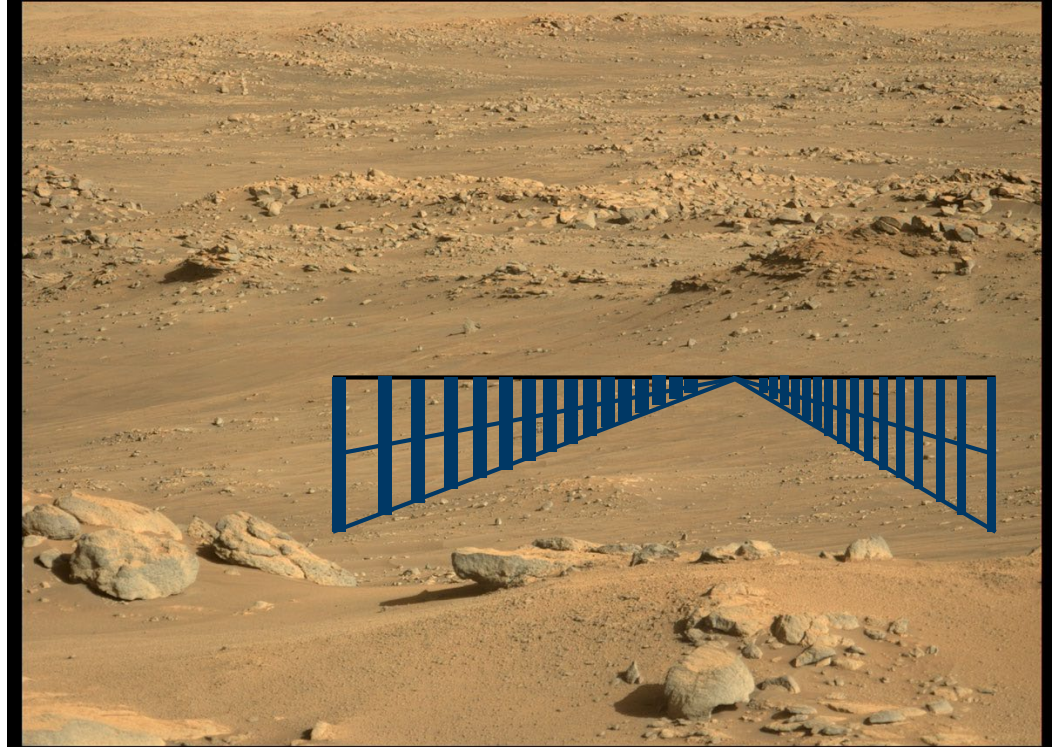
Arthur Peslak, Administrative Patent Judge



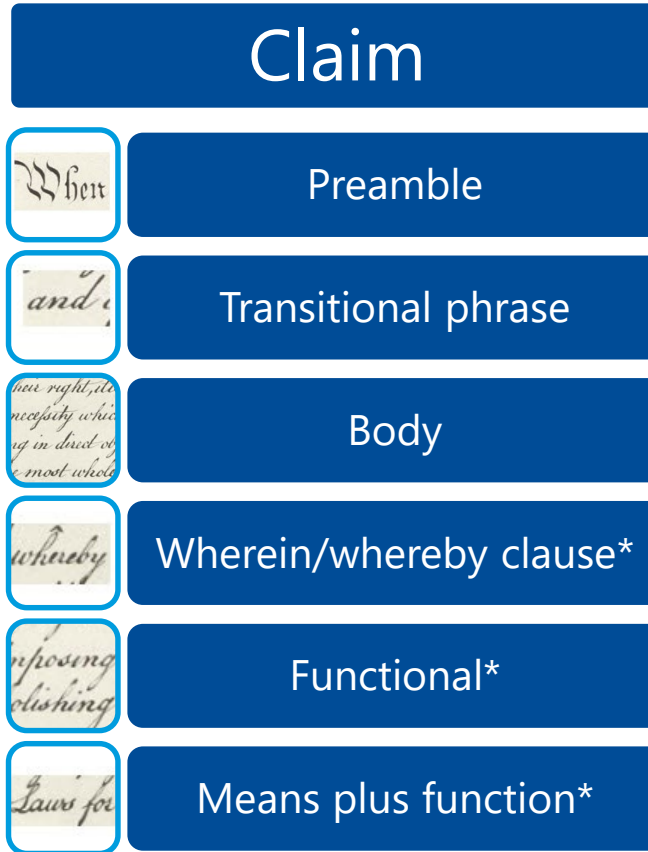
Appeal byte: What is a claim?

What is a claim?

Claims define the subject matter that you seek to protect and are part of the patent or application's written description

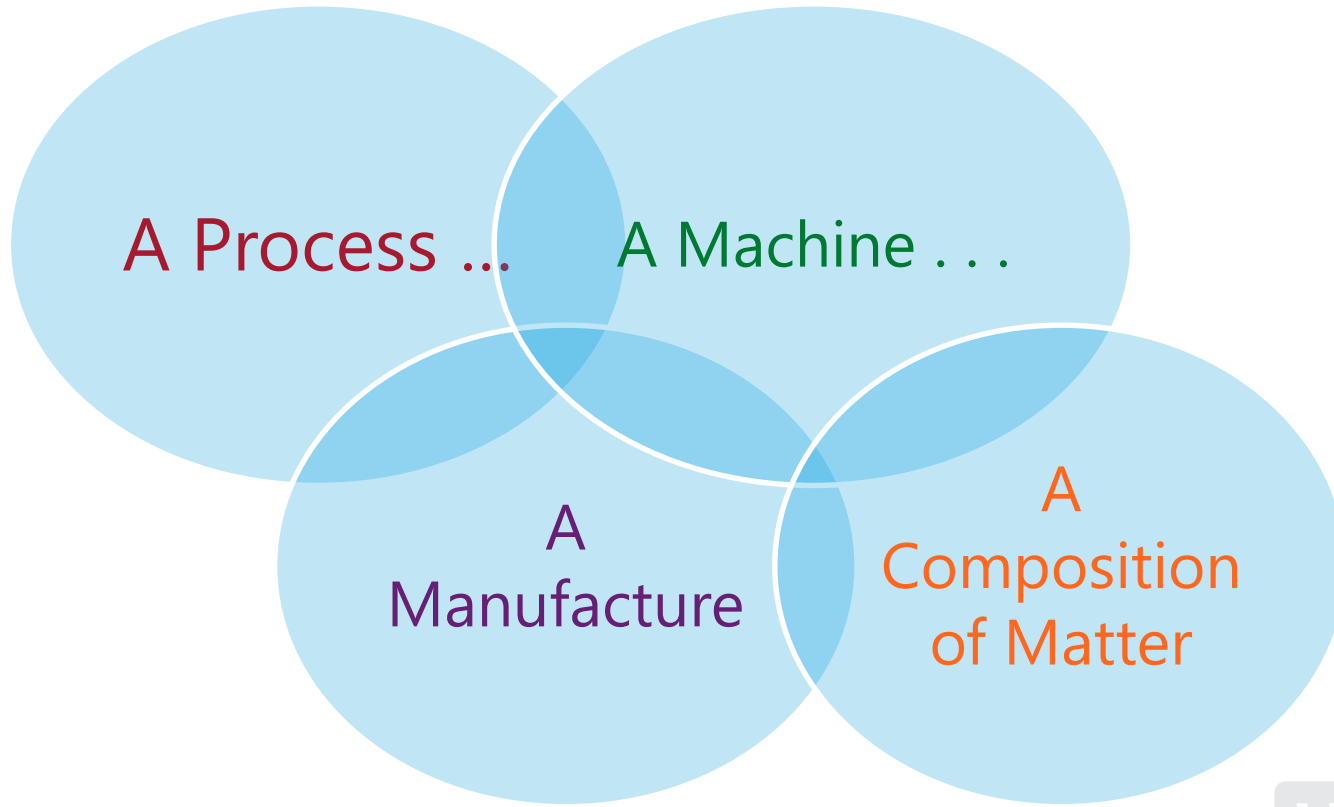


What is a claim?



**optional*

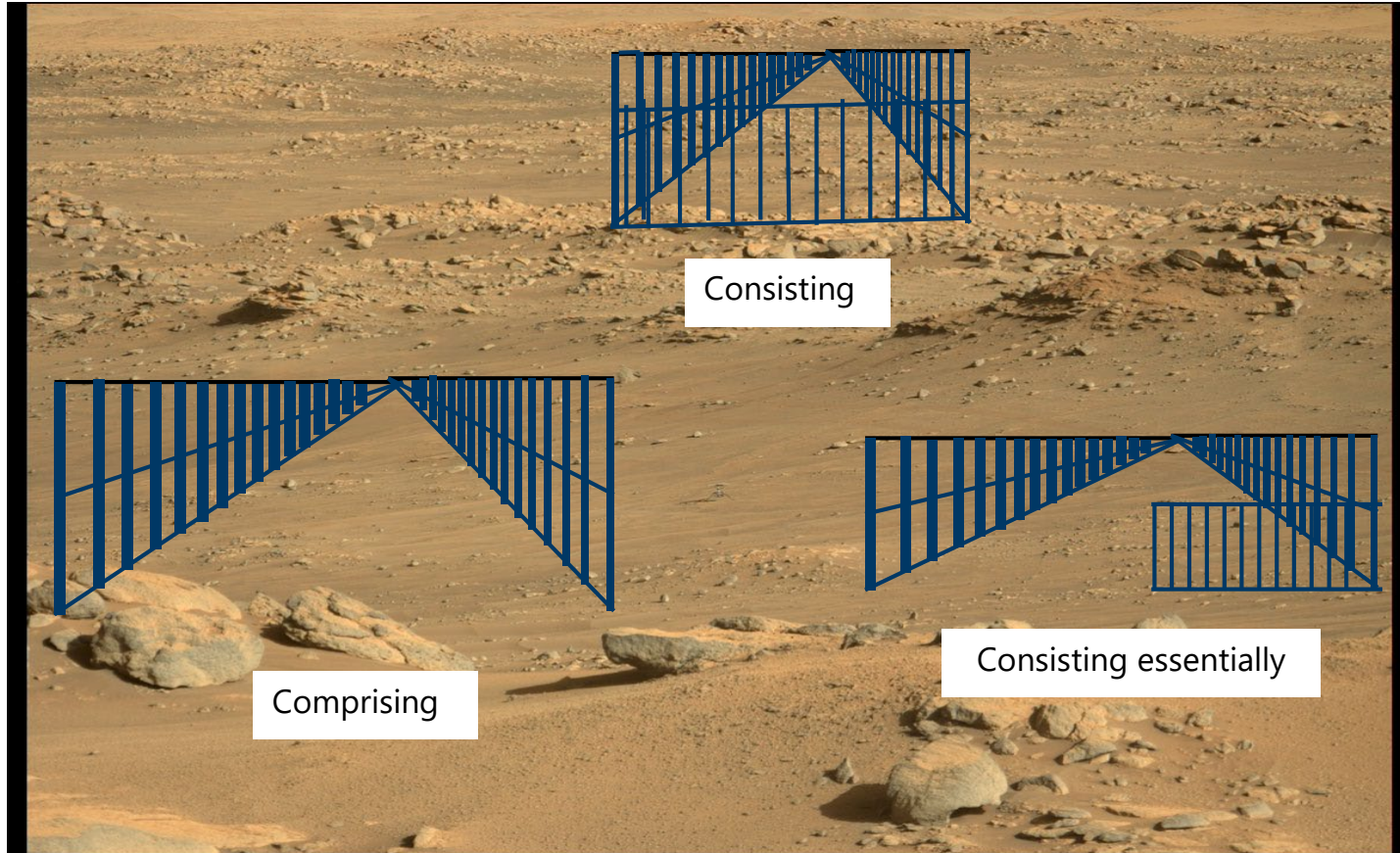
Claim – Preamble and Type of Invention



Preamble

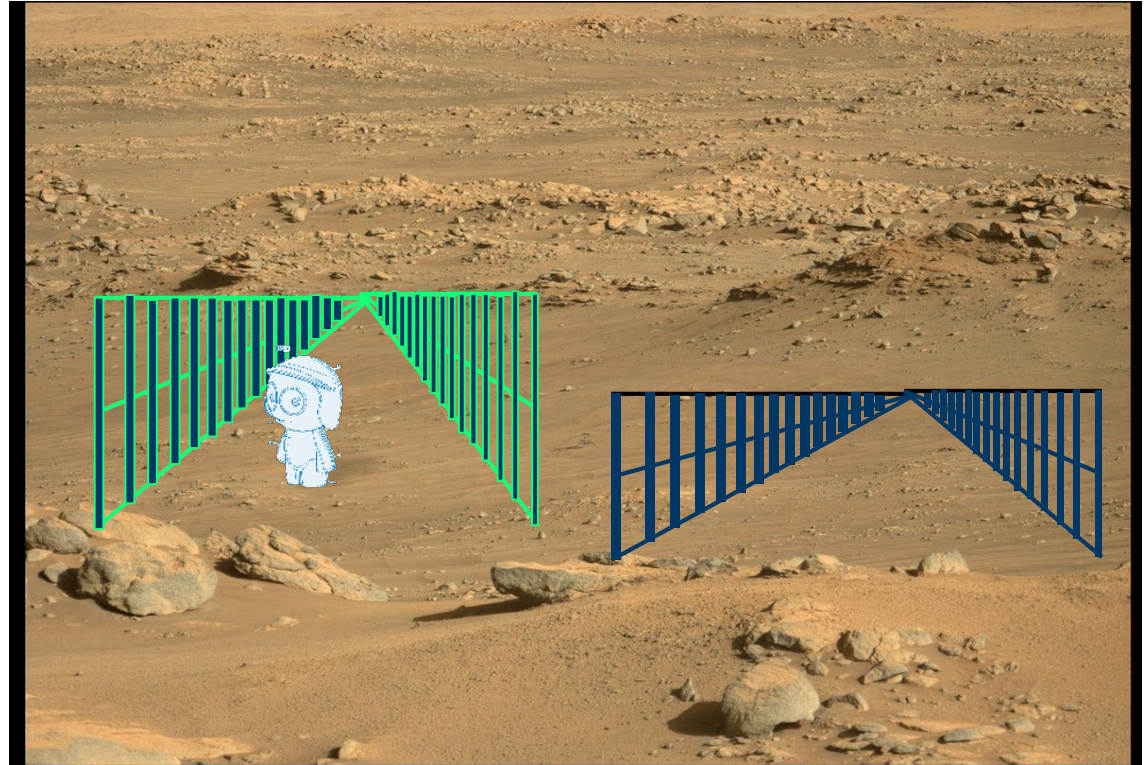
A process for collecting Martian soil to identify indigenous lifeforms

Claim – transitional phrase



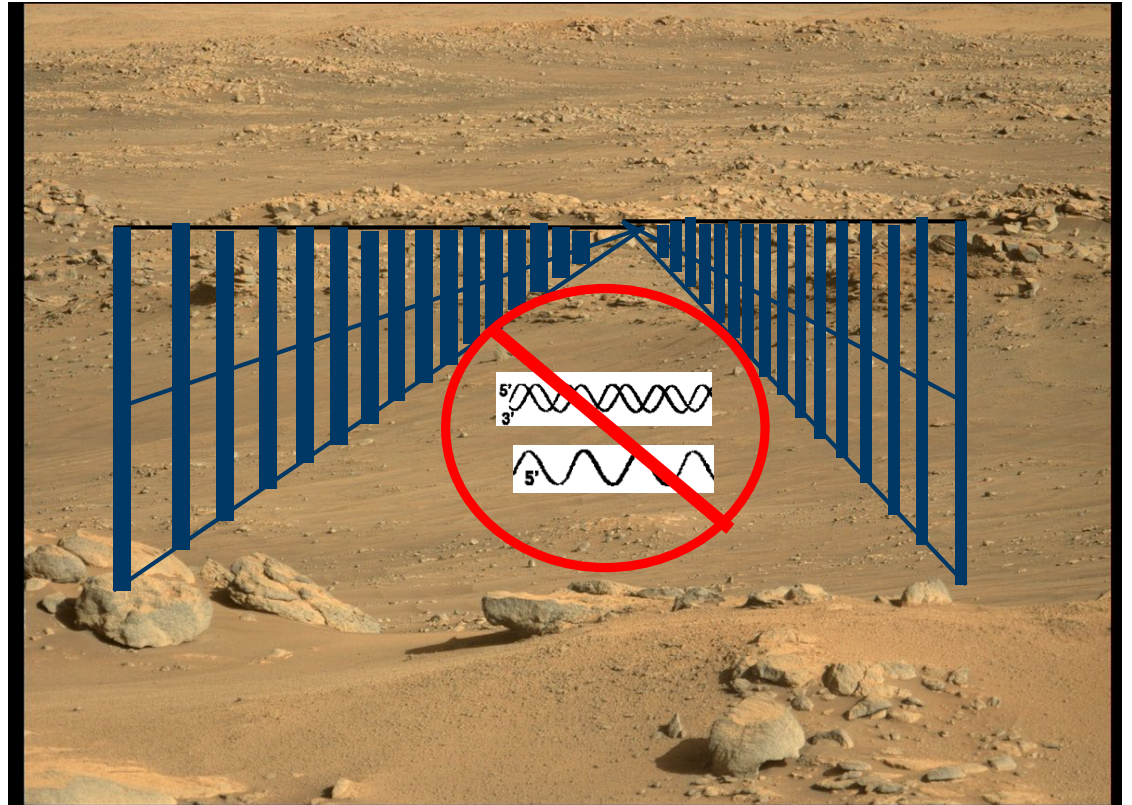
Claim – body

1. A process for collecting Martian soil to identify indigenous lifeforms, comprising:
 - i. launching a rocket from the United States to land on Mars;
 - ii. digging up soil sample;
 - iii. putting the sample on a slide;
 - iv. optically imaging the sample; and
 - v. detecting an unknown organism.



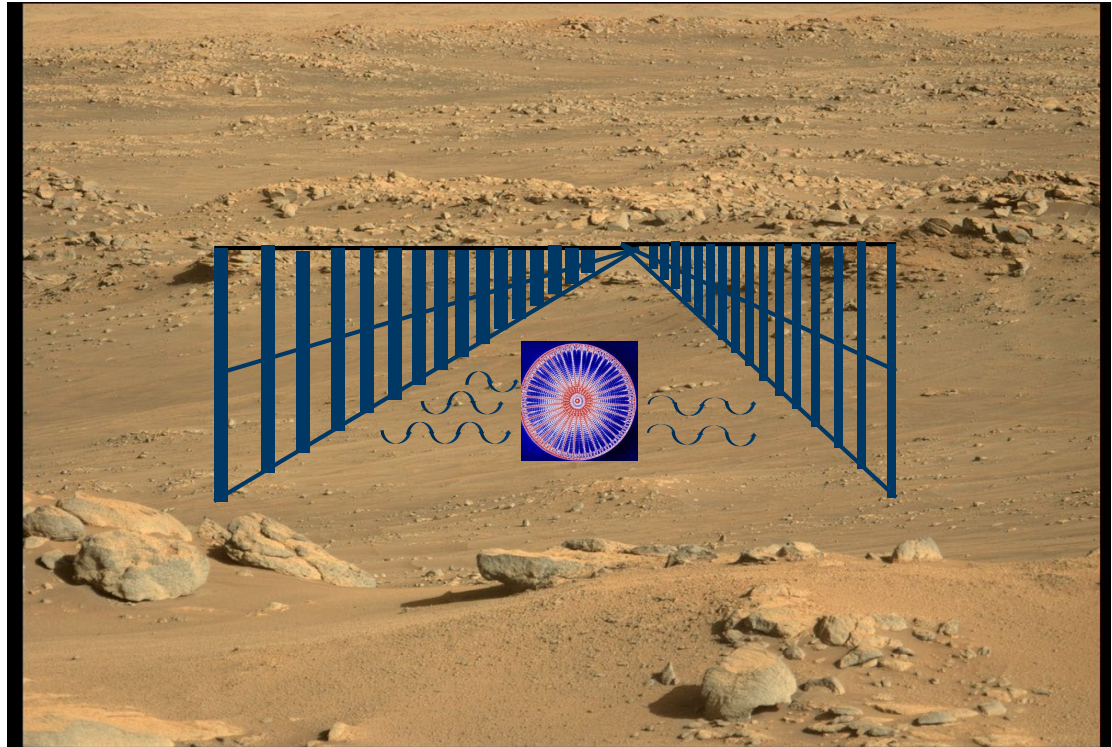
Claim – wherein, whereby

Wherein the
Martian organism
will not use either
RNA or DNA as the
genetic material;



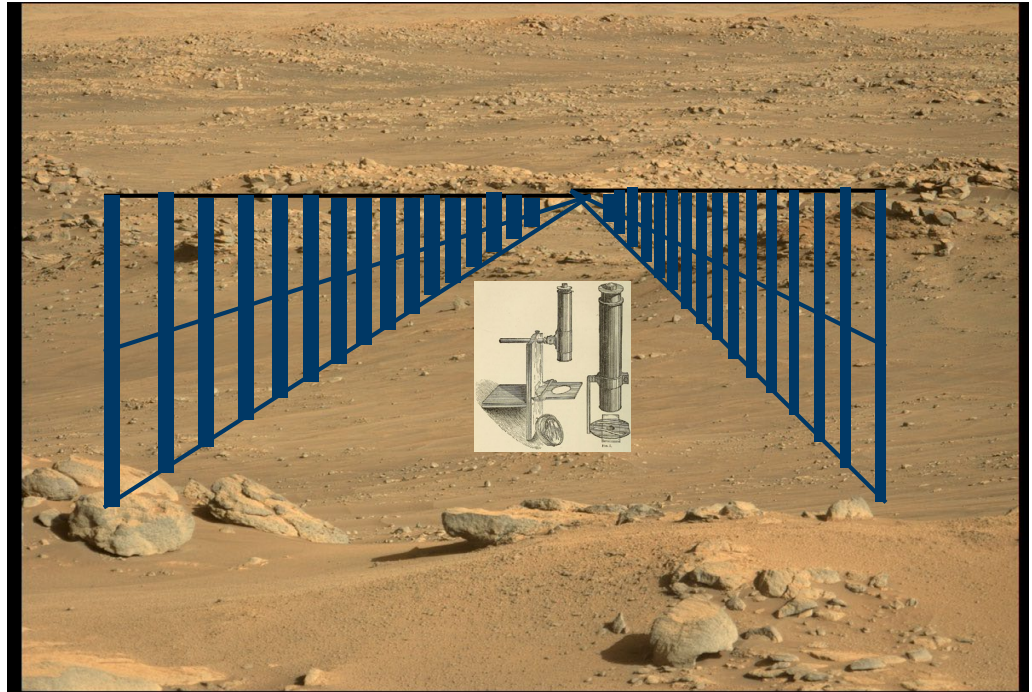
Claim – functional

... And the
Martian organism
is transparent to
infrared rays;



Claim – means plus function

Where the testing also involves a *means for scanning the sample.*



Claim

1. A process for collecting Martian soil to identify indigenous lifeforms,

comprising:

- i. launching a rocket from the United States to land on Mars;
- ii. digging up soil sample;
- iii. putting the sample on a slide;
- iv. optically imaging the sample; and
- v. detecting an unknown organism;

wherein the Martian organism will not use either RNA or DNA as the genetic material;

and the Martian organism is transparent to infrared rays;

where the testing also involves a means for scanning the sample.



Dependent claims

2. The process of claim 1, wherein the rocket is launched from Cape Canaveral.
3. The process of claim 1, wherein the imaging is performed by a human on a microscope.
4. The process of claim 2, wherein the Martian organism uses silicon based genetic material.

Question/comment submission

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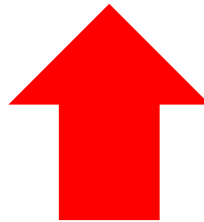
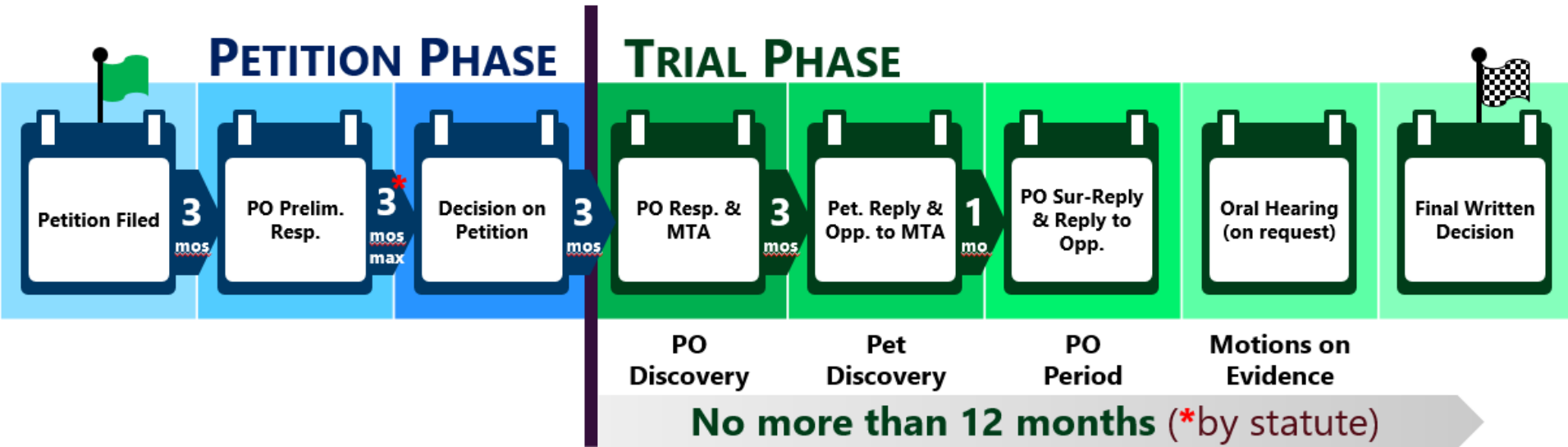
Ulrike Jenks, Administrative Patent Judge



Trial byte:

Motions to amend

Overview of AIA proceedings



Patent owner motion to amend

**Cancel any
challenged
claim**

**Amend any
challenged
claim**

**Cannot enlarge
scope or add
new matter**

Petitioner opposition to motion to amend

- **Petitioner bears the burden** of showing the unpatentability of proposed substitute claims
- The Board itself may, in the interests of justice, exercise its **discretion to grant or deny** a motion to amend for any reason supported by the evidence of record

Motion to Amend Pilot Program

Option 1:
Request preliminary
guidance

Option 2:
File a revised MTA

Other amendment options

- **Notice regarding options for reissue or reexamination during pending AIA proceeding**
 - Published in Federal Register at 84 Fed. Reg. 16654 (April 22, 2019)
 - Available at <https://www.uspto.gov/patents/ptab/notice-regarding-options-amendments>



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Lynne Browne, Administrative Patent Judge



Case file:

Ex Parte Lewis, Appeal No. 2008-0034

Goals



Provide **insight** into patent prosecution



Show importance of careful **claim drafting**



Answer questions regarding PTAB's **approach**

Relevant legal principles

“The **name of the game** is the claim”

prior art or
combination
must disclose
all limitations in order to
anticipate or render
obvious the claim

limitation not in
the claim **cannot**
distinguish claim
over prior art

Technology of application

TITLE: METHOD FOR PRACTICING PITCHING AND APPARATUS THEREFOR

INVENTOR: JOSEPH EDWIN LEWIS

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CROSS REFERENCE TO RELATED APPLICATIONS

This application claims the filing benefit under 35 U.S.C. §119(e) of U.S. Provisional Application No. 60/516,467 filed 11/01/2003, which is included herein by reference.

10

TECHNICAL FIELD

15

The present invention pertains generally to the more particularly to a method and system for practicing batter mannequin and a catcher mannequin are remotely

20

BACKGROUND OF THE INVENTION

Devices for practicing pitching are known in the art. U.S. Pat. No. 6,350,211 shows a baseball pitching aid wherein a simulator is provided for use in pitching practice. The lower portion of the simulator includes two stakes which are inserted into the ground and provide a simulated batter in an appropriate place near "home plate", a pitcher can use the batter as a reference to determine the location of the strike zone. The size of the batter can be adjusted to vary the size of the strike zone. A ball detection apparatus and audio output can be provided to indicate when a pitch is detected and whether the pitch is a ball or a strike.

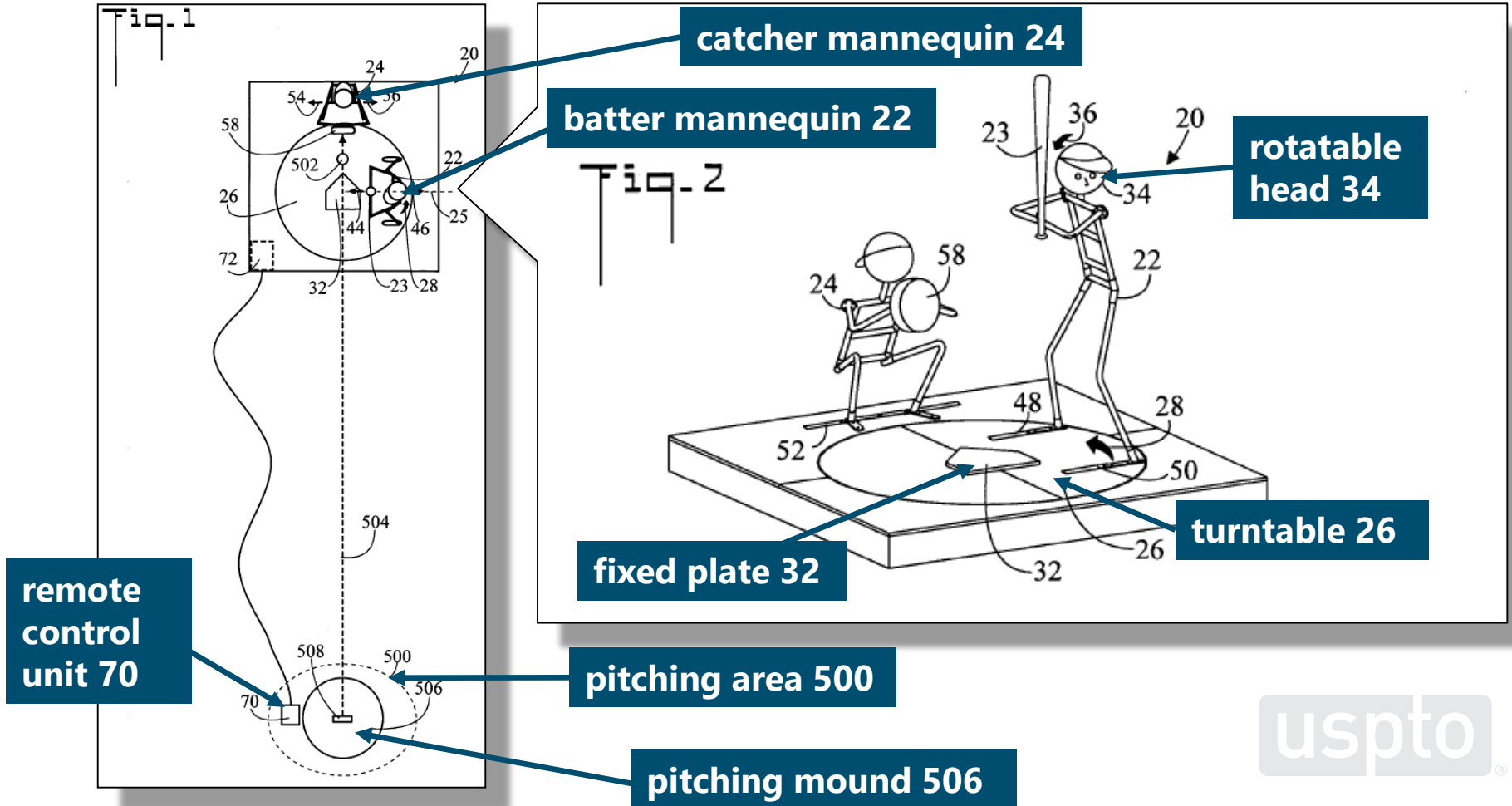
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TITLE: METHOD FOR PRACTICING PITCHING AND APPARATUS THEREFOR

TECHNICAL FIELD

The present invention pertains generally to the games of baseball and softball, and more particularly to a method and system for practicing pitching in which the positions of a batter mannequin and a catcher mannequin are remotely controlled by a user.

Technology of application



Cited prior art

U.S. Patent No. 3,525,525 (Rideout)

United States Patent Office 3,525,525
Patented Aug. 25, 1970

1

3,525,525
TOY BASEBALL GAME
Richard G. Rideout, Cambridge, Mass., assignor to
Richard W. Schmader, Winchester, Mass.
Filed June 28, 1968, Ser. No. 740,967
Int. Cl. A63f 7/06, 7/10
U.S. Cl. 273—89 10 Claims

ABSTRACT OF THE DISCLOSURE

A toy baseball game apparatus including a field on which a baseball diamond is shown, a motor-driven rotor on which a member representing a batter is removably mounted, stop elements under the four bases selectively movable up through the field into the path of the batter to stop the rotation of the rotor, a ball, means operable by one player to project the ball to any one of four swinging targets a selected one of which can be locked by the opposing player, and means operable by the ball when it passes one of the targets to start the motor and simultaneously to raise a corresponding stop element to stop the rotation when the batter reaches it. The rotor advances base-runner elements placed thereon.

This invention is an improvement over the apparatus shown in U.S. Pat. No. 3,050,308.

The game is designed for operation by two opposing players one of whom projects the ball toward any of the targets for the purpose of causing rotation of the rotor. The other player manipulates devices to prevent passage of the ball past any of the targets. For a more complete understanding of the invention reference may be had to the following description and to the drawings, of which:

FIG. 1 is a perspective view of the apparatus embodying the invention;

FIG. 2 is a section, on a larger scale, on the line 2—2 of FIG. 1;

FIG. 3 is a plan view of the apparatus shown in FIG. 1, but on a larger scale, portions being broken away;

FIG. 4 is a section on a vertical plane of part of the apparatus;

FIG. 5 is a rear elevation of the apparatus;

FIG. 6 is a detail elevation of one of the switches controlling the motor;

FIG. 7 is a fragmentary sectional view showing a stop element elevated to intercept the batter member;

FIG. 8 is a front elevational view of the apparatus shown in FIG. 1; and

FIG. 9 is a wiring diagram of the circuits in the apparatus.

As indicated in FIG. 1, the apparatus comprises a rectangular box having a bottom 10 and side walls 12 and 14. Spaced above the bottom 10 is a horizontal field 16 on which is depicted a baseball diamond 18 with the home plate nearest to the front of the apparatus. Over the diamond is a rotor 20 which, as shown, consists of four arms 22 of equal length extending radially from a vertical shaft 24 driven by a small electric motor 26 mounted under the field 16 and supported by a bar 27. The four arms 22 are preferably identical, each having near its free end a short transverse slot 28 to receive a removable member or playing piece 30 which represent the batter in playing the game. The slots 28 are equidistant from the axis of rotation of the rotor 20 and when the rotor is at rest, the slots 28 are respectively directly over slots 32 at the locations of the four bases of the diamond, the latter slots being for stop members, hereinafter described, which are selectively elevated to intercept the batter member 30. Each arm 22 has a thickened end portion through which is a hole 34 adapted to receive a cylindrical peg 36

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representing a base-runner. A peg 36 fits loosely in any of the holes 34 and its lower end rests on the field 16 so that when the rotor 20 turns, it carries the peg or pegs 36 around from one base to the next. If a base-runner is advanced all the way around the diamond, it drops through an aperture 40 near the home plate, scoring a run. A partition wall 41 just behind the aperture 40 keeps the peg within easy reach after it had dropped below the field. Near the rear end of the apparatus is a vertical barrier 42 which has a series of four rectangular openings 44, 46, 48, 50.

by target plate 42 which is pivoted to top and bar swing back when it passes horizontal switch in series of power on 68 for the FIG. 6, etc which serve conductor 7 supported by down from faces of the when the coil of the switch, carrying it of each cup to an exit slide bar 84 which can be by manipulating the rotor 20. This permits the ball when in one of the cups 64 to escape to a chute 94 and through an opening 96 in the rear of the casing. Each switch 70, 72 is in series with the motor 26 and a power source so that when the ball 62 enters any one of the cups 64 and rocks it downward to close one of the switches, the motor 26 starts to rotate the rotor 20 carrying with it the batter 30 and any base-runners 36 which may be in the holes 34. To stop the rotor 20 a series of four stop elements 100 is provided, each stop element being located directly below one of the slots 32 in the field 16. One such stop element is shown in FIGS. 4 and 7. The stop elements are mechanically connected respectively to the four rockable cups 64 by arms 102, 104, 106, 108 which extend forward from the respective cups 64. These stop elements determine how far the batter 30 will progress when the motor 26 is started. For example, if the ball passes through the opening 44 and enters the cup behind the target 52, the ball will rock that cup downward thus elevating the stop element 100 which is supported by the arm 102 at third base. In other words, the ball entering the cup behind the target 52 results in a three-base hit. If the ball enters the cup behind the target 54, 56, 58, the results are, respectively, a two-base hit, a home run and a single as is evident from FIG. 3. When a stop element 100 is elevated to project above the level of the field 16, as indicated in FIG. 7, it is in the path of travel of a lug 110 projecting down from the batter 30 below the arm 22. Each stop element 100 is preceded by a sloping edge 112 which is engaged by the lug 110 just before it reaches the stop element 100. As the lug rides on the sloping edge 112, it depresses the arm that carries the stop element and rocks the cup to which the arm is attached, thus raising the conductor 74 and opening the switch to deenergize the motor 26.

3,525,525
TOY BASEBALL GAME
Richard G. Rideout, Cambridge, Mass., assignor to
Richard W. Schmader, Winchester, Mass.
Filed June 28, 1968, Ser. No. 740,967
Int. Cl. A63f 7/06, 7/10
U.S. Cl. 273—89 **10 Claims**



Cited prior art

U.S. Patent No. 3,525,525 (Rideout)

target plate 52 (also 54, 56, 58)

batter 30

ball 62 &
bat 126

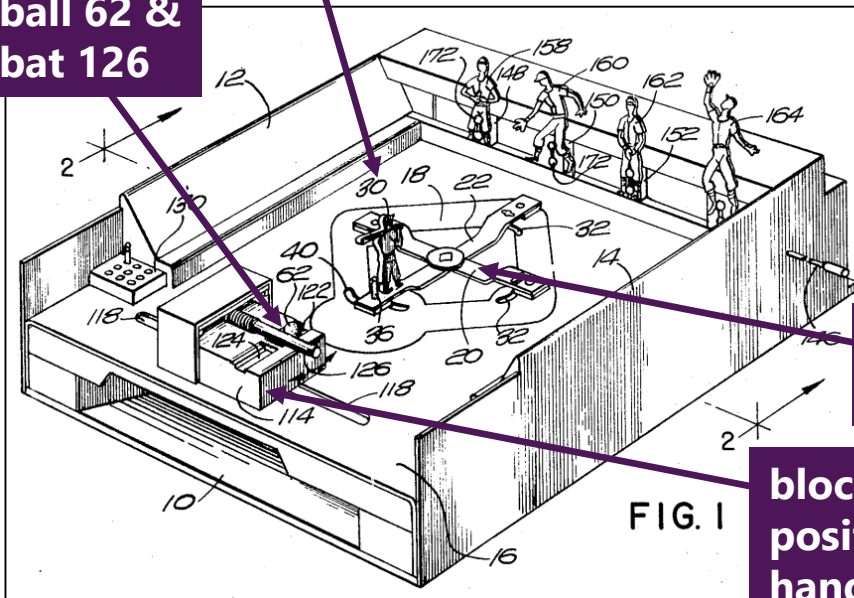


FIG. 1

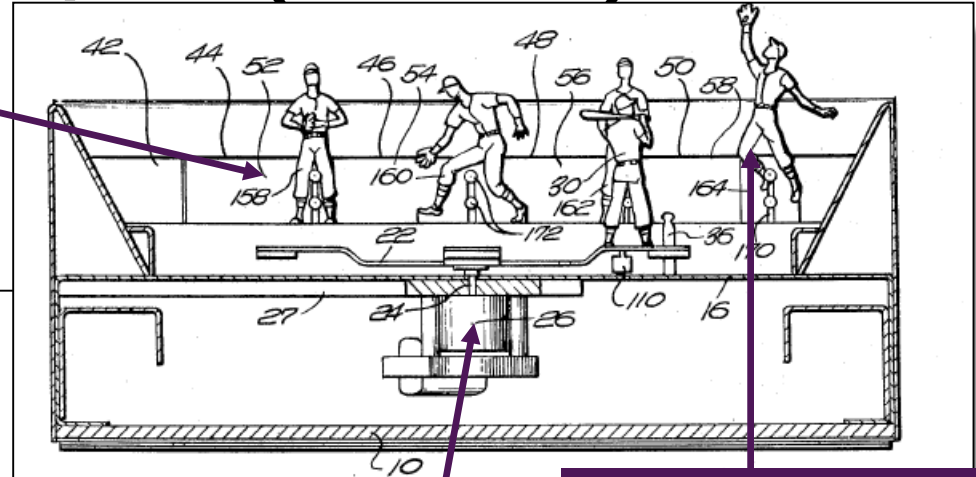


FIG. 2

motor 26

detachable element
164 (also 158, 160,
162) in form of
baseball player

rotor 20 consisting of
four arms 22

block 114 with bat 126 in
position to represent right-
handed batter

Claim 45 anticipated by Rideout?

45. A system for practicing pitching, comprising:
a batter mannequin which rotates to a right
handed batting position **or** to a left handed batting
position.

Claim 45 anticipated by Rideout?

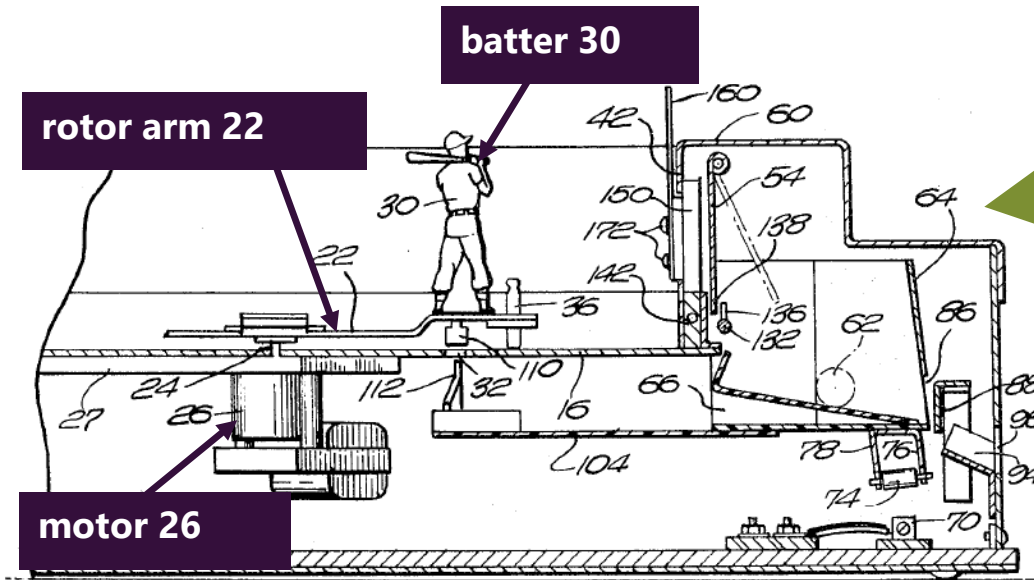


FIG. 4

Examiner: "Rideout discloses a batter mannequin (batter 30), which rotates to a right-handed batting position or to a left handed batting position"

Claim 45 anticipated by Rideout?

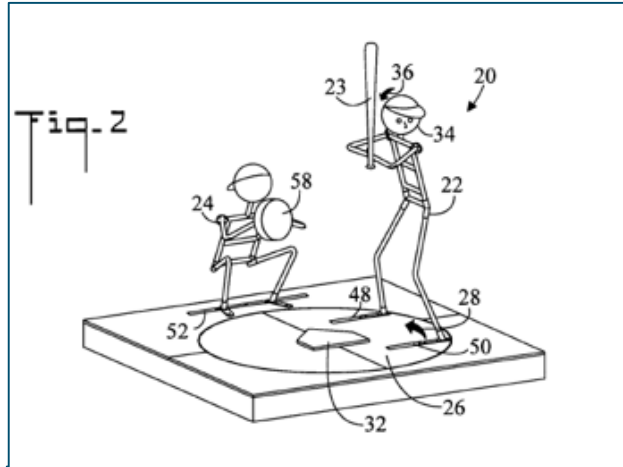


Fig. 2 Batter 22 in right handed batting position

Rideout batter "cannot ... change batting hands, much less change between right and left handed batting positions."

Appellant: Batting positions refers to "specific physical relationships" between batter and home plate/catcher.

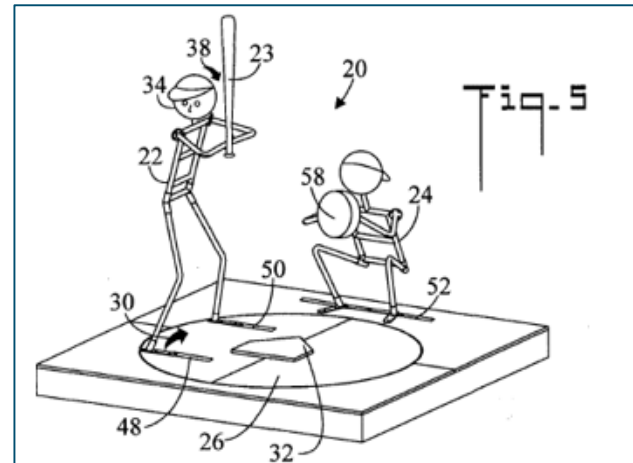


Fig. 5 Batter 22 in left handed batting position

Board affirmed rejection of claim 45

Claim 45 **does not recite** a plate or a catcher, and during prosecution Examiner and Board gives terms **broadest reasonable interpretation** in light of Specification.

Batter 30 in right handed batting position

Rotor arm 22

Motor 26

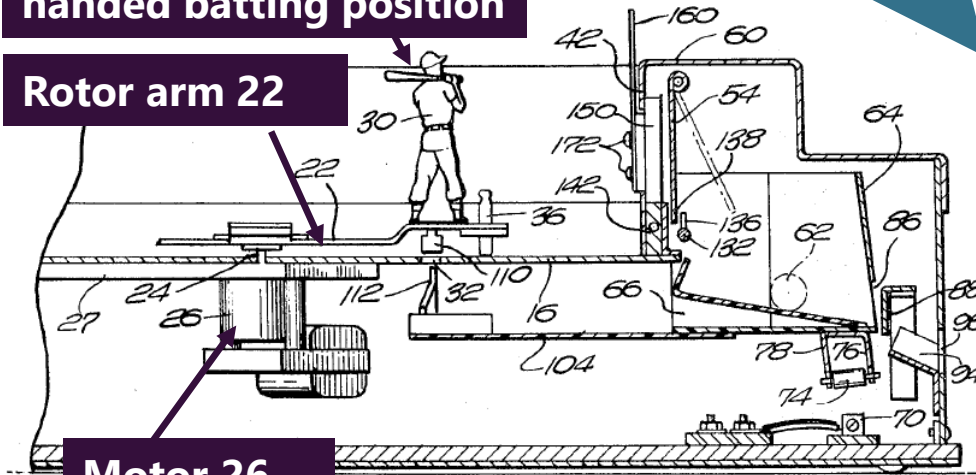


FIG. 4

Claim 45 does not require rotation to both right handed **and** left handed batting positions.

Claim 45 **does not require** changing batting hands.

Claim 49 anticipated by Rideout?

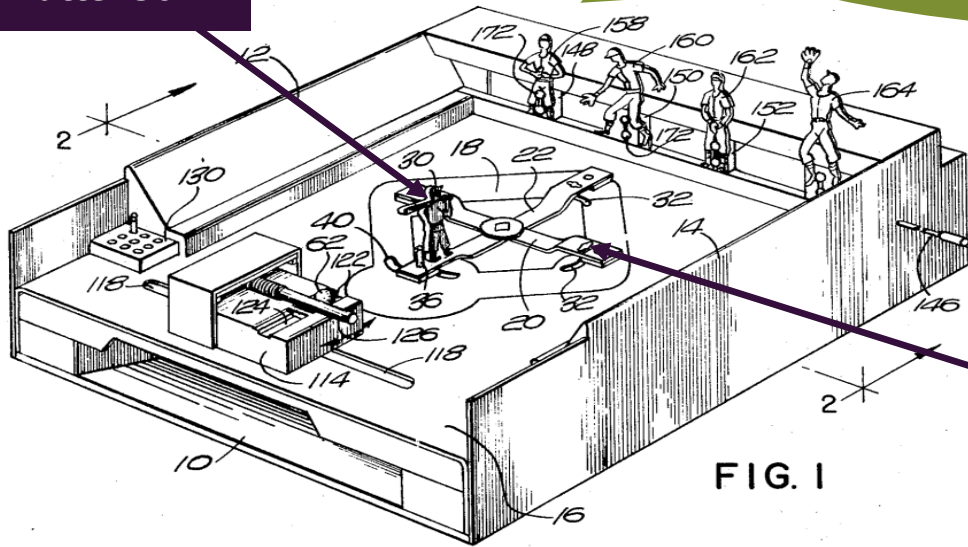
47. The system according to Claim 45, further including:
a turntable having a perimeter and a center; and, said batter mannequin disposed on said turntable in an off center position near said perimeter of said turntable.

49. The system according to Claim 47, further including:
said turntable rotating about 180° to effect said right handed **and** left handed batting positions.

Claim 49 anticipated by Rideout?

Examiner: "Rideout shows the turntable rotating (arms 22) about 180 degrees and the batter (30) is turned 180 degrees to go from a right-handed batter to a left-handed batter."

Batter 30



Rotor 20

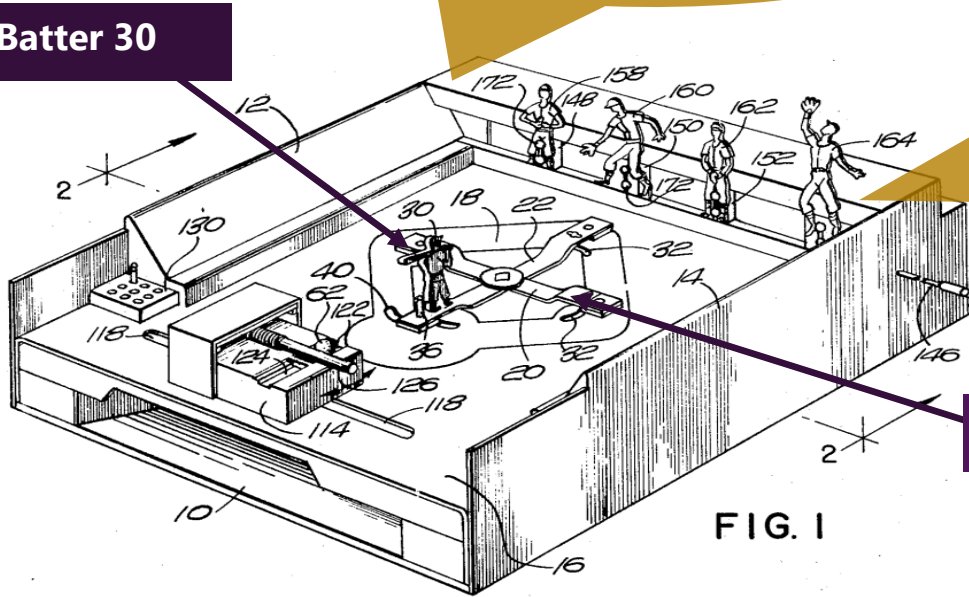
FIG. 1

Claim 49 anticipated by Rideout?

Appellant: "[S]ince the batter is a fixed toy figure, it can never . . . go from a right-handed batter to a left-handed batter."

"No amount of rotation can change ... handedness of the Rideout batter."

Batter 30



Rotor 20

FIG. 1

Board reversed rejection of claim 49

"[C]laim 49 **specifically recites** rotation of the turntable to position the batter in the 'right-handed **and** left-handed batting positions' ... (in contrast to independent claim 45 ... using the alternative language 'or')."

Batter 30 in right handed batting position

Rotor arm 22

Motor 26

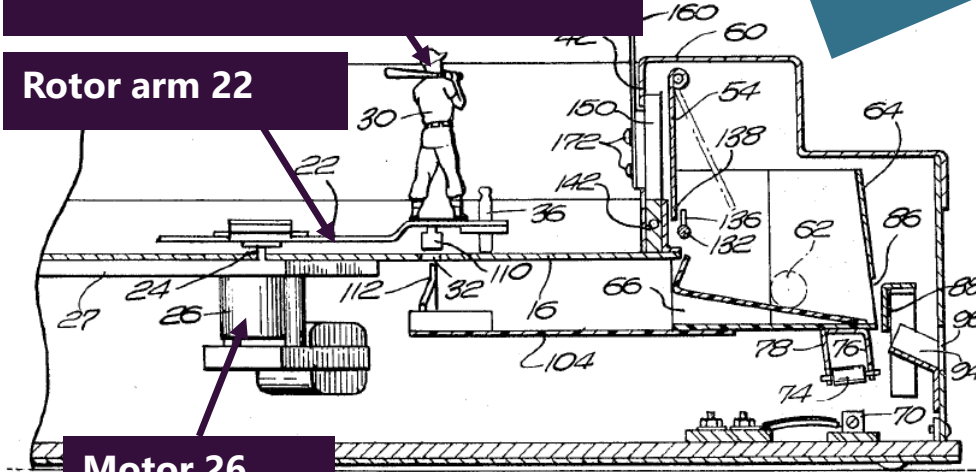


FIG. 4

"Rideout clearly does not disclose a left-handed batting position."

After the Board decision



US007435194B1

(12) **United States Patent**
Lewis

(10) **Patent No.:** US 7,435,194 B1
(45) **Date of Patent:** Oct. 14, 2008

(54) **METHOD**
APPARATUS

US 7,435,194 B1

(76) Inventor:

9

10

(*) Notice:

a remote control unit 70 for remotely controlling the movement of batter mannequin 22 and positioning of catcher mannequin 24;

The method further including:
in step (c), remote control unit 70 disposed adjacent to said pitching area; and,
the user performing steps (d) and (e).
The preferred embodiments of the invention described herein are exemplary and numerous modifications, additions, and rearrangements can be readily envisioned to achieve an equivalent result, all of which are intended to be embraced within the scope of the appended claims.

(21) Appl. No.:

(d) using remote control unit 70 to move batter mannequin 22 to either the right handed batting position or the left handed batting position;

(22) Filed:

(e) using remote control unit 70 to position catcher mannequin 24 to a desired position along the transverse path; and,
(f) the user throwing ball 502 toward catcher mannequin 24.

Ref

(60) Provisional 1, 2003.

The method further including:
in step (c), batter mannequin 22 having a body 27 which is bilaterally symmetrical about a vertical median plane 25 (refer to FIG. 4).

(51) **Int. Cl.**
A63B 69/00
A63B 7/26

The method further including:
in step (c), batter mannequin 22 disposed on a turntable 26 which rotates about 180°; and,
in step (d) turntable 26 rotating so that batter mannequin 22 assumes either the right handed batting position or the left handed batting position.

(58) **Field of Cl**

The method further including:
in step (c), turntable 26 rotating about a fixed plate 32 disposed in front of batter mannequin 22.

See applic

(56)

The method further including:
in step (c), batter mannequin 22 having a rotatable head 34, rotatable head 34 (1) automatically assuming a left-looking position when batter mannequin 22 is in the right handed batting position, and (2) automatically assuming a right-looking position when batter mannequin 22 is in the left handed batting position.

The method further including:
in step (c), batter mannequin 22 having both a left-looking face and a right-looking face.

The method further including:
in step (c), fixed plate 32 disposed in front of batter mannequin 32, batter mannequin 22 selectively movable toward or away from fixed plate 32, and,
prior to step (f), using remote control unit 70 to position batter mannequin 22 to a desired position with respect to fixed plate 32.

The method further including:
in step (c), catcher mannequin 24 having a mitt 58, mitt 58 selectively positionable in a vertical direction; and,
prior to step (f), using remote control unit 70 to position mitt 58 to a desired vertical position.

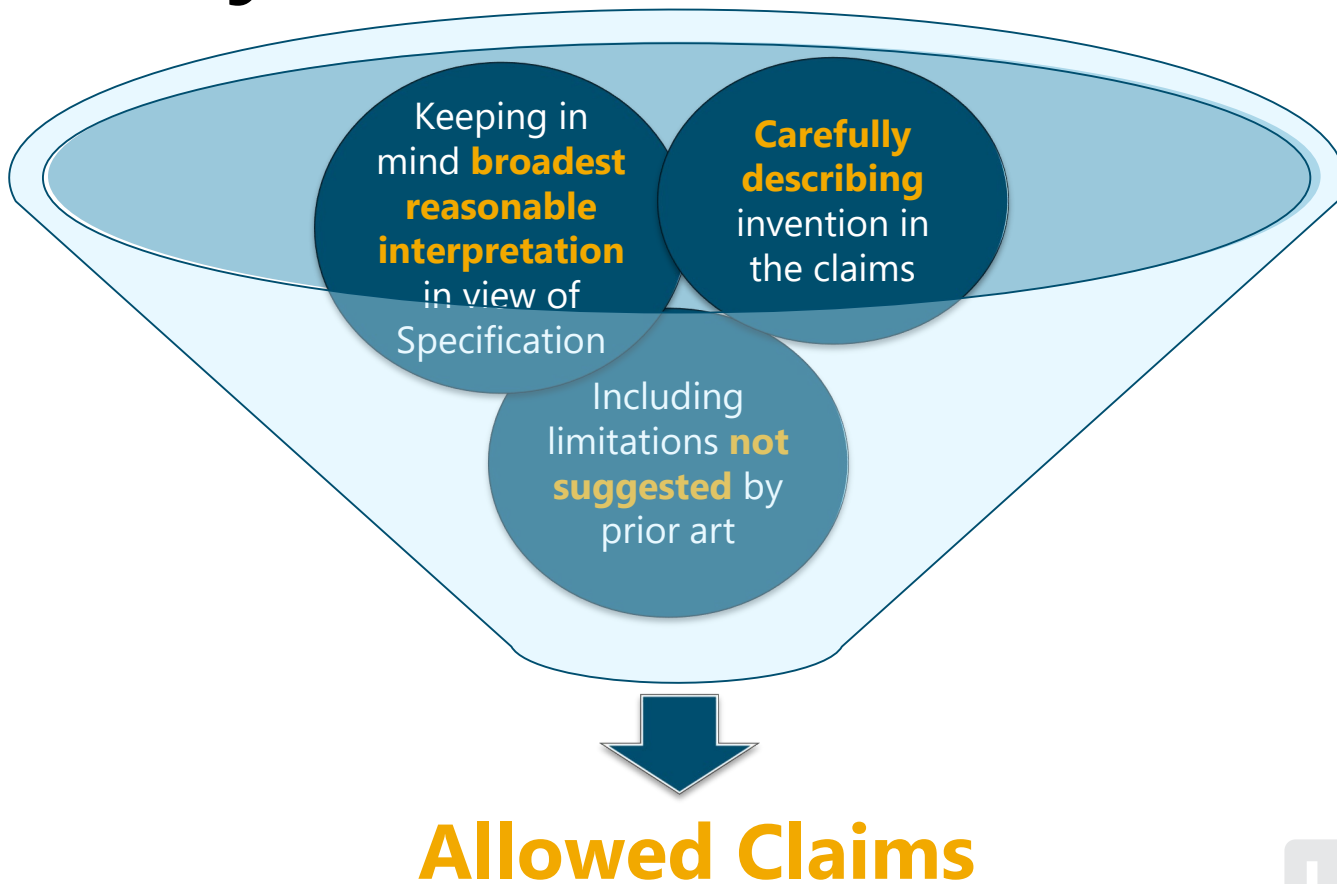
The method further including:
in step (e), mitt 58 having an impact sensor, so that when ball 502 strikes mitt 58 a signal is generated and sent to an audio device to announce that that mitt 58 has been struck.

* * * * *

I claim:

1. A system for practicing pitching, comprising:
a batter mannequin which rotates to a right handed batting position or to a left handed batting position;
a turntable having a perimeter and a center;
said batter mannequin disposed on said turntable in an off center position near said perimeter of said turntable; and,
said turntable rotating about 180° to effect said right handed and left handed batting positions.
2. A system for practicing pitching, comprising:
a batter mannequin which rotates to a right handed batting position or to a left handed batting position;
a fixed plate disposed in front of said batter mannequin;
said batter mannequin rotating about said fixed plate;
a turntable having a perimeter and a center;
said batter mannequin disposed on said turntable in an off center position near said perimeter of said turntable;
said batter mannequin having a body which faces said center of said turntable;
said turntable rotating about 180° to effect said right handed and left handed batting positions;
one of (1) said batter mannequin having a rotatable head, said rotatable head automatically assuming a left-looking position when said batter mannequin is in said right handed batting position, and said rotatable head automatically assuming a right-looking position when said batter mannequin is in said left handed batting position, and (2) said batter mannequin having both a left-looking face and a right-looking face;
when said body of said batter mannequin is viewed from the front, said body is bilaterally symmetrical about a vertical median plane;
a catcher mannequin disposed behind said batter mannequin; and,
said catcher mannequin positionable with respect to said fixed plate, said positioning being from side to side along a transverse path.

Takeaways



Question/comment submission

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Christopher Paulraj, Administrative Patent Judge



Meet a law school IP clinic director:

Glushko-Samuels IP Law Clinic, American University Washington College of Law
Victoria F. Phillips (Clinic Director) & **David Grossman** (Adjunct Patent Supervisor)



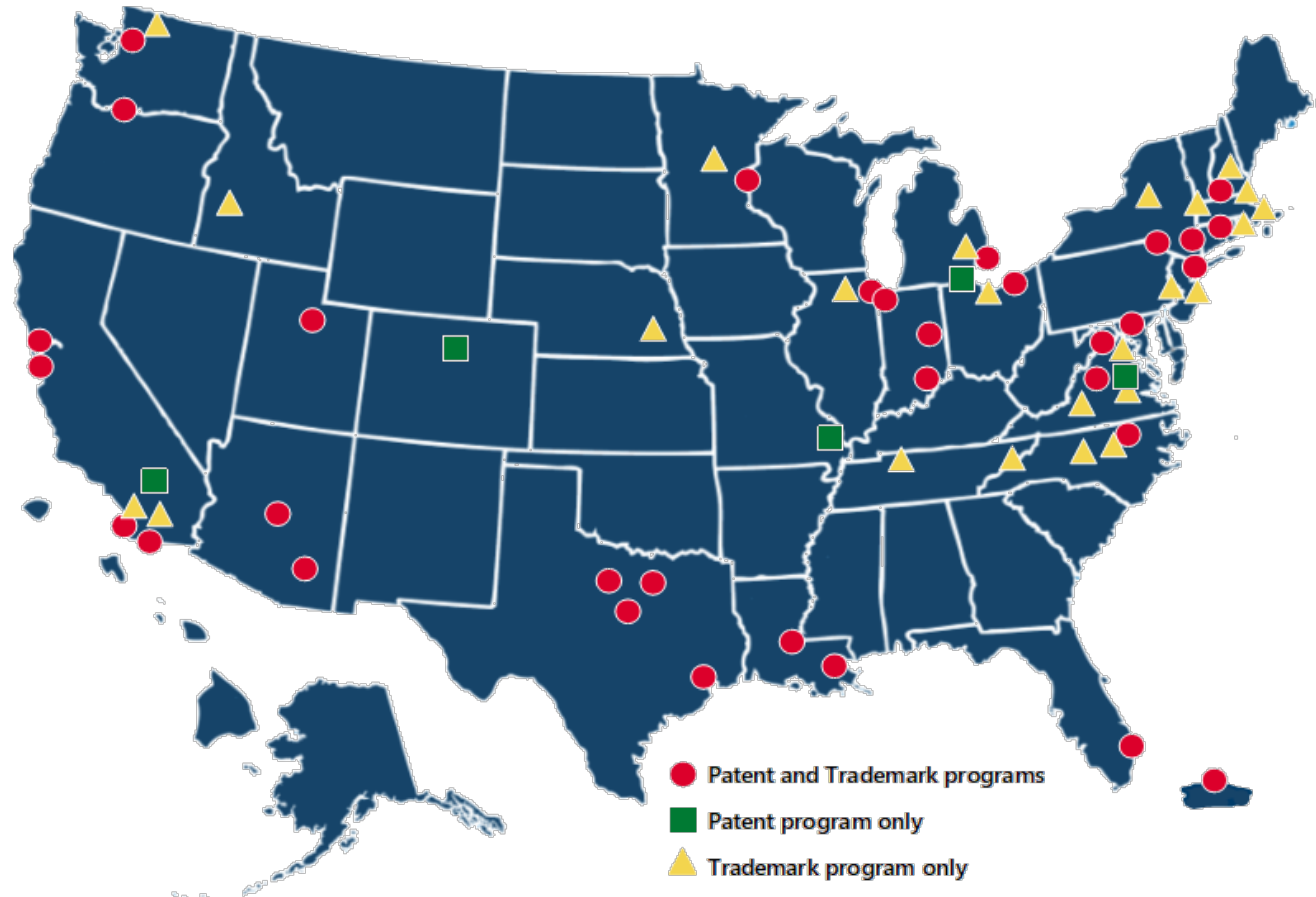
Vicki Phillips



David Grossman

ipclinic@wcl.american.edu

Current nationwide coverage



Nationwide coverage

<https://www.uspto.gov/sites/default/files/documents/USPTO-Law-School-Clinic-Certification-Map-May-2022.pdf>

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District of Columbia	<ul style="list-style-type: none"> ● American University, Washington College of Law ● Howard University School of Law ▲ The George Washington University School of Law 	Missouri	<ul style="list-style-type: none"> ■ Washington University in St. Louis School of Law 	Puerto Rico	<ul style="list-style-type: none"> ● University of Puerto Rico School of Law
Florida	<ul style="list-style-type: none"> ● University of Miami School of Law 	Nebraska	<ul style="list-style-type: none"> ▲ University of Nebraska College of Law 	Rhode Island	<ul style="list-style-type: none"> ▲ Roger Williams University School of Law
Idaho	<ul style="list-style-type: none"> ▲ University of Idaho College of Law 	New Hampshire	<ul style="list-style-type: none"> ▲ UNH Franklin Pierce School of Law 	Tennessee	<ul style="list-style-type: none"> ▲ University of Tennessee College of Law ▲ Vanderbilt Law School
Illinois	<ul style="list-style-type: none"> ▲ Northwestern Pritzker School of Law ● University of Illinois Chicago School of Law 	New Jersey	<ul style="list-style-type: none"> ▲ Rutgers Law School 	Texas	<ul style="list-style-type: none"> ● Baylor Law School ● South Texas College of Law Houston ● Southern Methodist University Dedman School of Law ● Texas A&M University School of Law
Indiana	<ul style="list-style-type: none"> ● Indiana University Maurer School of Law ● Indiana University Robert H. McKinney School of Law ● University of Notre Dame Law School 	New York	<ul style="list-style-type: none"> ● Brooklyn Law School ● Fordham University School of Law ● New York Law School ▲ Syracuse University College of Law 	Utah	<ul style="list-style-type: none"> ● Brigham Young University Law School
				Virginia	<ul style="list-style-type: none"> ■ George Mason University, Antonin Scalia Law School ▲ Liberty University School of Law ▲ University of Richmond School of Law
				Washington	<ul style="list-style-type: none"> ▲ Seattle University School of Law ● University of Washington School of Law

Question/comment submission

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

– PTABInventorHour@uspto.gov





Questions?

Future programs



Inventor Hour, Episode 14

Thursday, January 26, noon (ET)



