

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# Patent Trial and Appeal Board Inventor Hour webinar: **Episode 8**

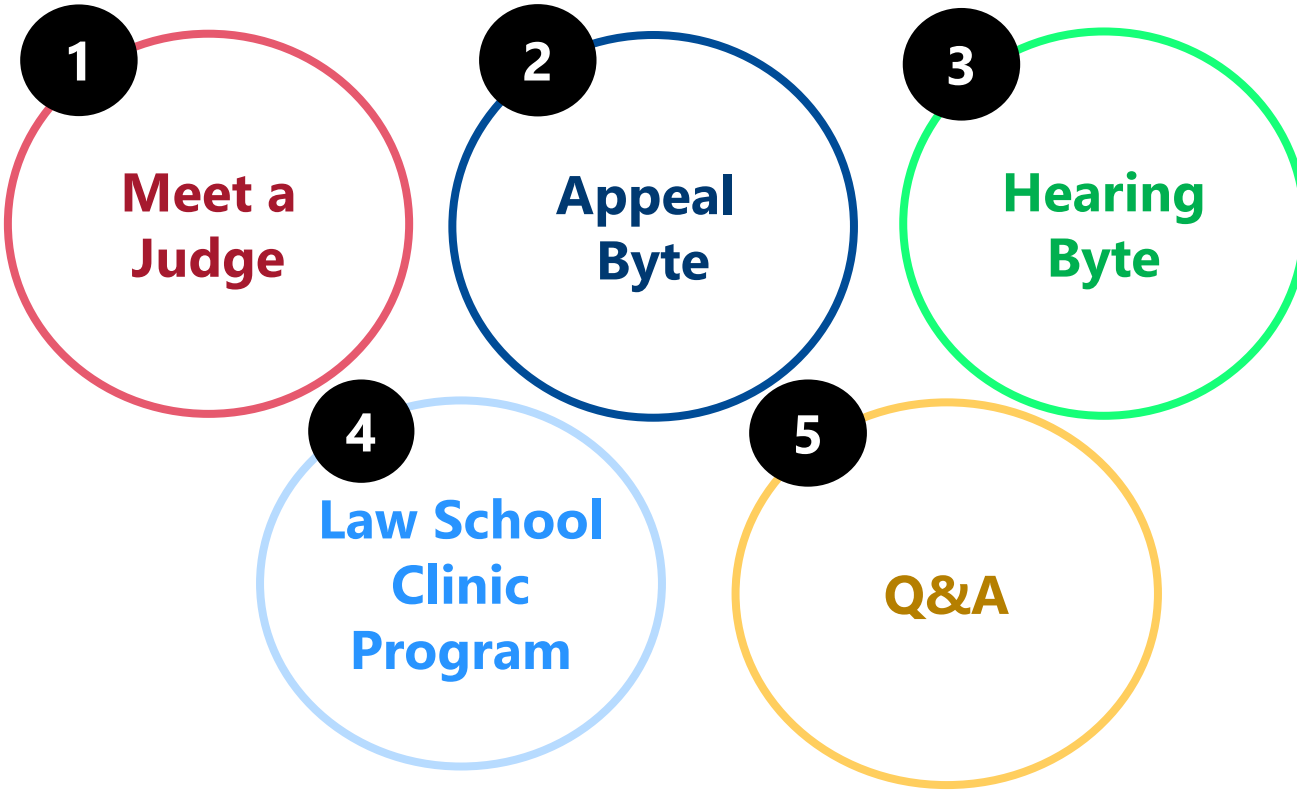
Janet Gongola, Vice Chief Administrative Patent Judge  
Terrence W. McMillin, Administrative Patent Judge  
Meredith Petravick, Administrative Patent Judge  
John E. Schneider, Administrative Patent Judge  
Emily Sprague, Office of Enrollment and Discipline

May 26, 2022

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# Today's agenda



\*INFORMATION NOT INTENDED AS LEGAL ADVICE



# Question/comment submission

- To send in questions or comments about the presentation, please email:
  - [PTABInventorHour@uspto.gov](mailto:PTABInventorHour@uspto.gov)

Janet Gongola, Vice Chief Administrative Patent Judge



# Meet a Judge:

## Judge Terrence W. McMillin



**Terrence W. McMillin**  
**Administrative Patent Judge**




Meredith Petravick, Administrative Patent Judge



## ***Ex Parte* Appeal Byte:**

**File an *ex parte* appeal OR  
file a petition to the Director of the USPTO**

# Petitionable matters during prosecution






 A **petition to the Director** under 37 C.F.R. § 1.181 is a request to invoke the supervisory authority of the Director to review any action or requirement of an examiner, which is not subject to appeal to the Board.

 Generally, an **objection** is petitionable.





# Examples of petitionable matters during prosecution

Some **petitionable** matters are:




-  a requirement for restriction or election of species;
-  finality of an office action;
-  non-entry of amendments;
-  a requirement to cancel “new matter” from the specification; and
-  failure to designate a rejection as a new ground of rejection in an examiner’s answer (37 C.F.R. § 41.40).

# Appealable matters during prosecution



-  An *ex parte appeal* under 35 U.S.C. § 134 is a request for the Board to review an adverse decision in a second or subsequent rejection of an applicant's claims by an Examiner.
-  Generally, a *rejection* is appealable.

# Examples of matters appealable to the Board



Some **appealable** matters are:

-  a patent eligibility rejection under 35 U.S.C. § 101;
-  a patentability rejection based on prior art under 35 U.S.C. §§ 102, 103; and
-  an indefiniteness, enablement, or written description rejection under 35 U.S.C. § 112.

# Who decides?

-  During prosecution, the Board will **not** ordinarily hear a question that should be decided by the Director on petition, and the Director will **not** ordinarily entertain a petition where the question presented is a matter appealable to the Board.
-  When the objection is "determinative of the rejection," however, the matter **may** be addressed by the Board during an appeal.



# Who decides a petition to the Director?

-  The Director may delegate their authority to Office officials to decide **petitions** while a patent application is pending.
-  Because different matters may be considered by different branches of the Office, each distinct subject, inquiry, or order must be contained in **a separate paper** to avoid confusion and delay in answering papers dealing with different subjects.




# Who decides an *ex parte* appeal?

Each *ex parte appeal* is heard by at least three members of the Patent Trial and Appeal Board, who are designated by the Director.

# When to file?

-  Generally, a petition to the Director should be filed within two months from the Office Action at issue.
-  A notice of appeal to the Board must be filed within the period for reply set in the last Office Action from the Examiner, which is normally three months for applications.

# Timeliness

-  The mere filing of a petition to the Director will not stay the period for replying to an Examiner's action that may be running against an application or act as a stay of other proceedings.
-  A petition to the Director not filed within 2 months from the Office action at issue may be dismissed as untimely.
-  Generally, petitionable matters are resolved in a case by the time it is before the Board for a decision.



# Resources

More information about filing a petition to the Director is available at:

- Manual of Patent Examining Procedure § 1002
- USPTO Website at <https://www.uspto.gov/patents/apply/petitions>

More information about filing an *ex parte* appeal is available at:

- Manual of Patent Examining Procedure § 1200
- USPTO Website at <https://www.uspto.gov/patents/ptab/appeals>

# Office of Petitions – help desk



- Office of Petitions staff answer questions about petitionable matters.
- Phone Number 571-272-3282.
- Available Monday to Friday 8:30 AM to 5:00 PM Eastern.

# Question/comment submission

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  - [PTABInventorHour@uspto.gov](mailto:PTABInventorHour@uspto.gov)

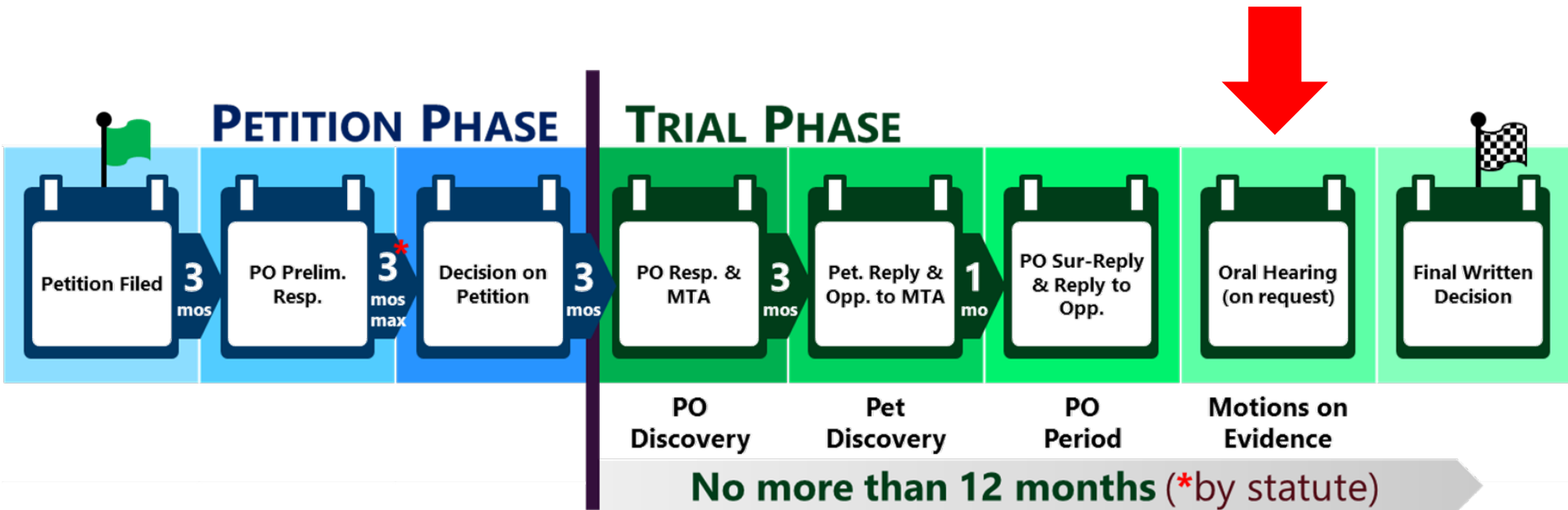
John E. Schneider, Administrative Patent Judge



# Hearing Byte

## AIA Oral Hearings

# Hearings: AIA trials








# AIA hearings

 What to expect

 What to present

 How to prepare

# What to expect

-  Opportunity to further explain your case
-  Three judge panel
-  One hour each side
-  Currently remote
-  Transcript becomes part of the record

# What to present

 May use demonstratives such as PowerPoint

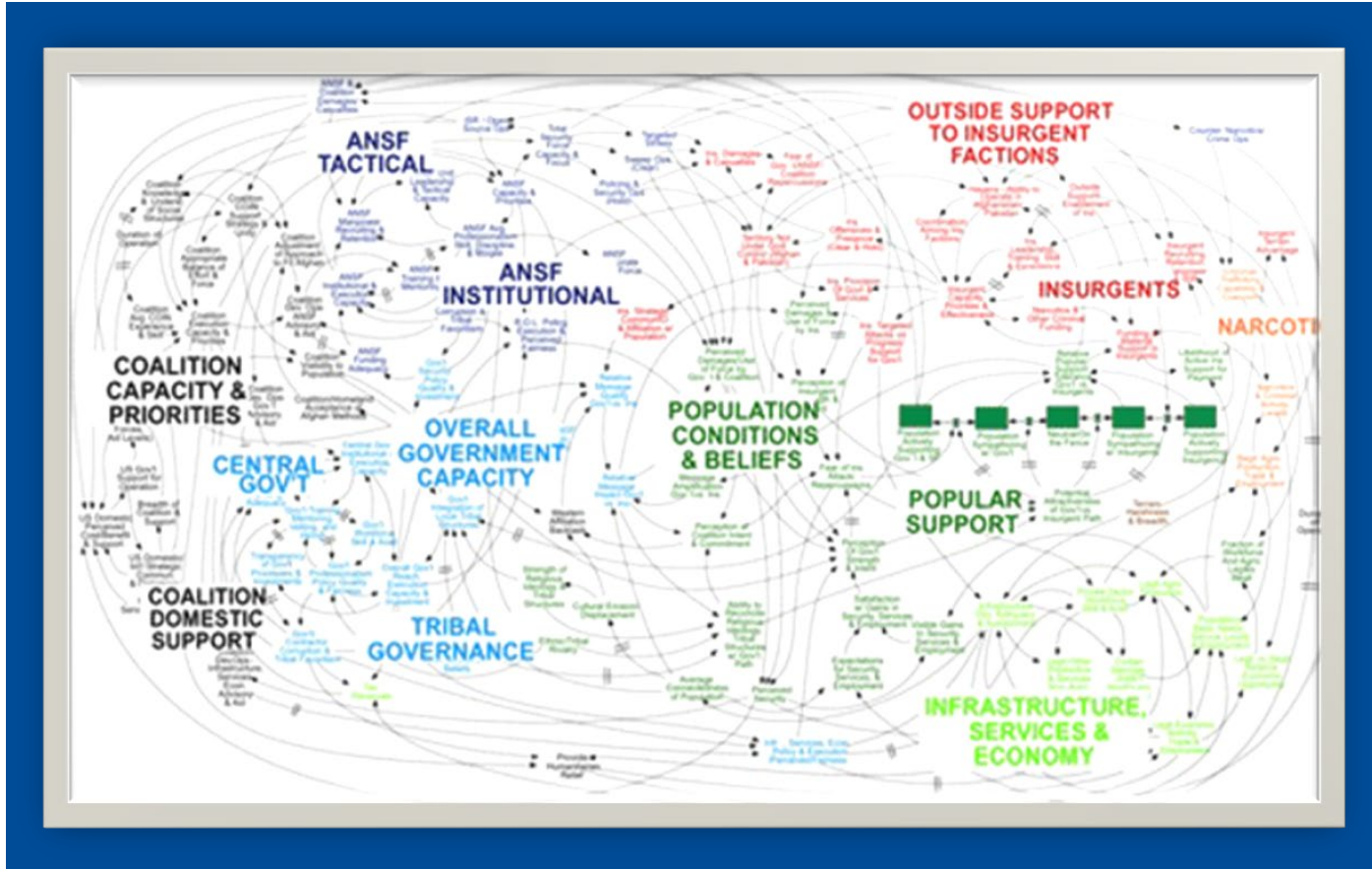
 No new evidence or arguments

– Panel may ask for citation to record to confirm no new argument








 Usually no live testimony



# A word about using PowerPoint



# How to prepare

-  Pre-hearing Conference
-  Know the record
-  Focus on key issues
-  Be ready for hard questions
-  Listen to the questions asked the other side
-  Know your PowerPoint deck
-  Listen to or read prior arguments

# Resources

More Information about AIA hearings is available at:

## **Guide to the administration of oral hearings before the Patent Trial and Appeal Board**

[https://www.uspto.gov/sites/default/files/documents/PTAB\\_hearings\\_guide\\_101520.pdf](https://www.uspto.gov/sites/default/files/documents/PTAB_hearings_guide_101520.pdf)

## **Consolidated Trial Practice Guide**

<https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf>

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# PTAB Pro Bono Program



- A collaboration with the PTAB Bar Association to create a clearinghouse to bring together volunteer attorneys and pro bono clients.
- For more details – watch the recording of the April Inventor Hour online or search [USPTO.gov](https://www.uspto.gov).

Emily Sprague, Staff Attorney




Office of Enrollment and Discipline, USPTO



## **Overview:**

### **USPTO Law School Clinic Certification Program**

# Law School Clinic Certification Program

-  Allows **students** in a participating law school's clinic program to practice before the USPTO under the strict guidance of a Law School Faculty Clinic Supervisor
  - The OED Director grants participating law students limited recognition to practice before the USPTO in patents/trademarks.
-  Participating in the program gives **real-world experience** to clinic students while providing **IP pro bono services** to the community
-  **Benefits** for **students**, schools, the USPTO, and **entrepreneurs and inventors** seeking legal representation

# Benefits to USPTO and inventors



## Impact for inventors

- Opportunity to work with experienced patent practitioners/faculty clinic supervisors and law students
- Benefit from IP pro bono services
- May benefit from expedited review of his/her applications by the USPTO



## Impact for the USPTO

- Increased participation in the patent system by increasing patent application filings
- Improved patent quality
- Supplements pro se (filing on your own) assistance efforts





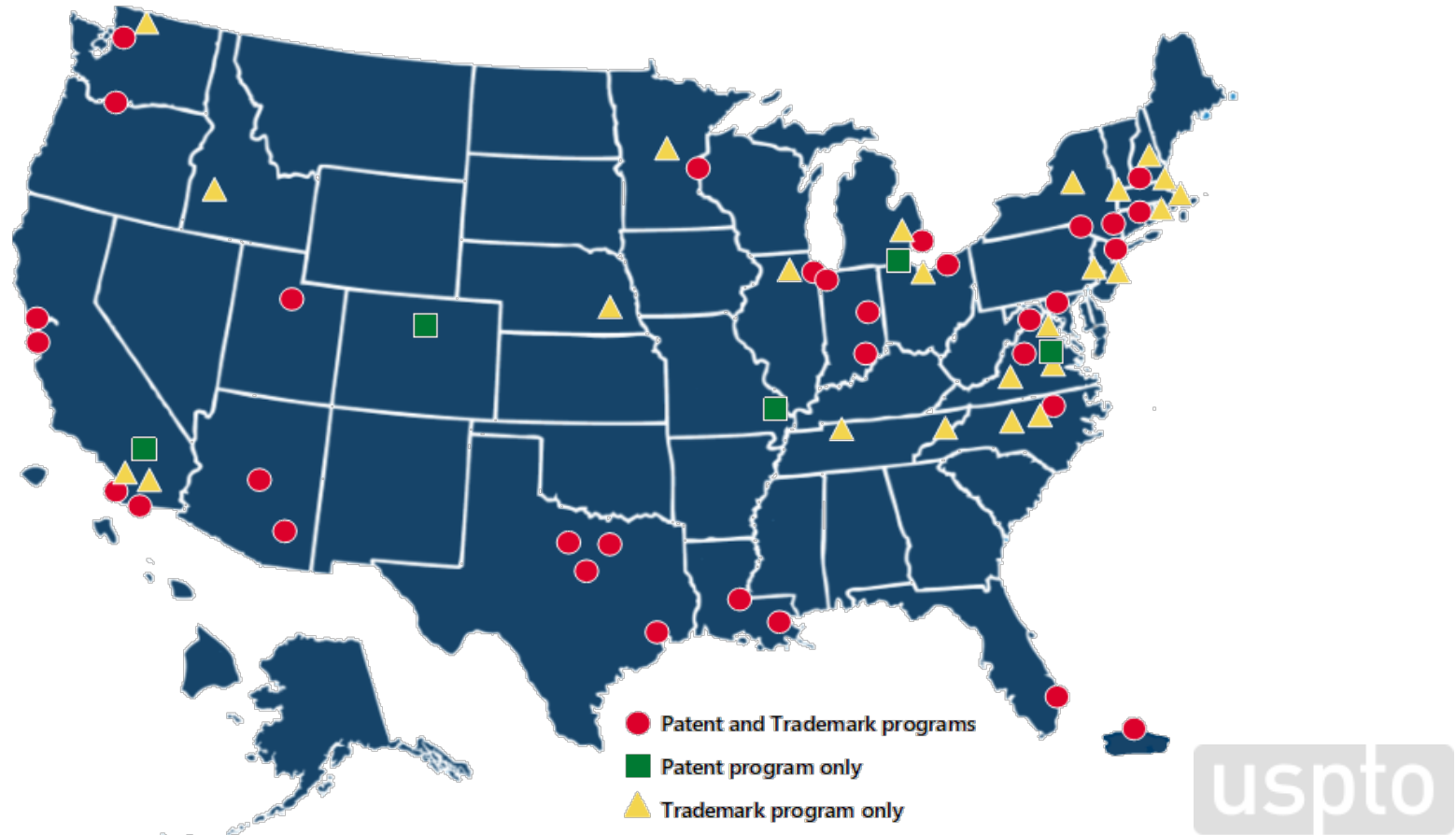
# History of the program

- 🏠 Pilot program from 2008 to 2014
- 🏠 H.R. 5108 sponsored by two U.S. Representatives
- 🏠 Signed into law in on December 16, 2014
  - Required the establishment of regulations for application to and participation in the program
    - 37 CFR §§ 11.16 (admission) & 11.17 (participation)
    - Notice of Proposed Rulemaking issued December 16, 2015
    - Final Rule published May 27, 2016

# Participating law school requirements

- 🏠 ABA **accredited** law school
- 🏠 Must provide services *pro bono* to the public
- 🏠 Must have **protocol** for seamless representation of clients
- 🏠 Must have approved Faculty Clinic **Supervisor**
- 🏠 Must comply with **reporting** requirements

# Current nationwide coverage



# Nationwide coverage

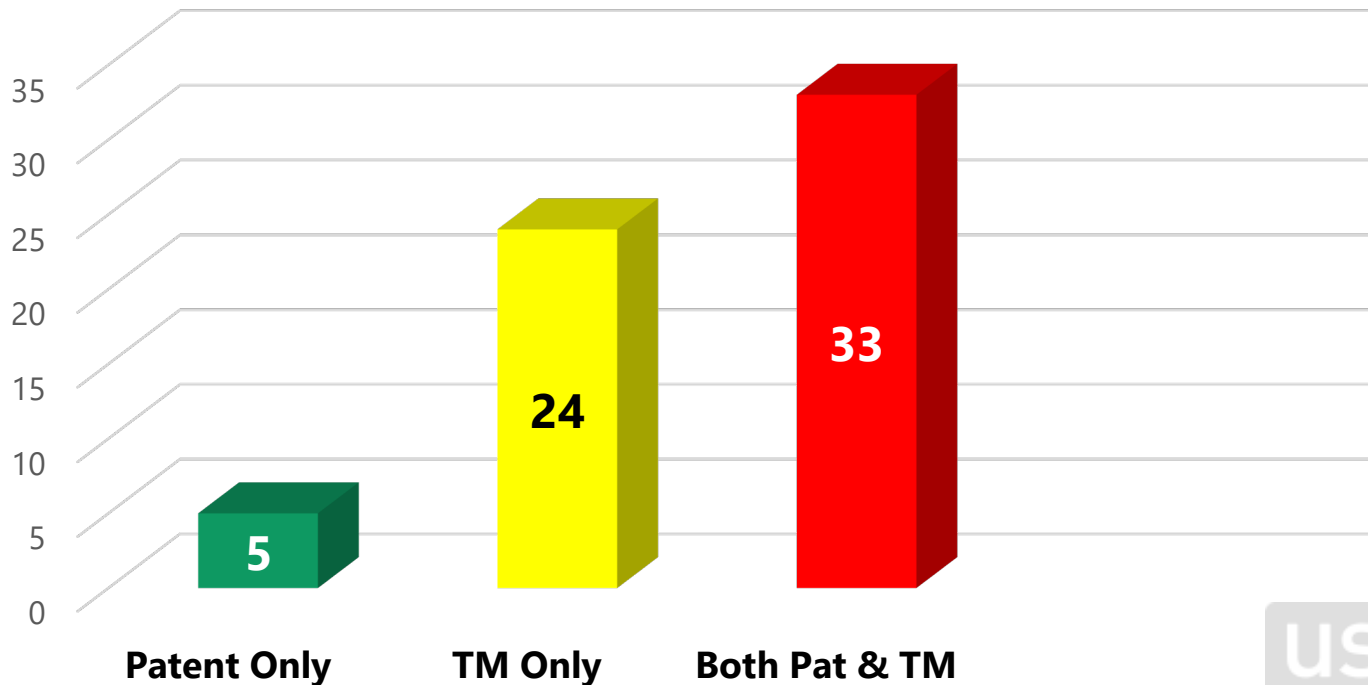
<https://www.uspto.gov/sites/default/files/documents/USPTO-Law-School-Clinic-Certification-Map-May-2022.pdf>

<b>Arizona</b>	<ul style="list-style-type: none"> <li>● Arizona State University Sandra Day O'Connor College of Law</li> <li>● University of Arizona James E. Rogers College of Law</li> </ul>	<b>Louisiana</b>	<ul style="list-style-type: none"> <li>● Southern University Law Center</li> <li>● Tulane University Law School</li> </ul>	<b>North Carolina</b>	<ul style="list-style-type: none"> <li>● North Carolina Central University School of Law</li> <li>▲ University of North Carolina at Chapel Hill School of Law</li> <li>▲ Wake Forest University Law School</li> </ul>
<b>California</b>	<ul style="list-style-type: none"> <li>▲ California Western School of Law</li> <li>● Lincoln Law School of San Jose</li> <li>● Thomas Jefferson School of Law</li> <li>▲ University of California, Irvine School of Law</li> <li>■ University of California, Los Angeles School of Law</li> <li>● University of San Diego School of Law</li> <li>● University of San Francisco School of Law</li> </ul>	<b>Massachusetts</b>	<ul style="list-style-type: none"> <li>▲ Boston College Law School</li> <li>▲ Northeastern University School of Law</li> <li>● Suffolk University Law School</li> <li>▲ Western New England University School of Law</li> </ul>	<b>Ohio</b>	<ul style="list-style-type: none"> <li>● Case Western Reserve University School of Law</li> <li>▲ University of Akron School of Law</li> </ul>
<b>Colorado</b>	<ul style="list-style-type: none"> <li>■ University of Colorado Law School</li> </ul>	<b>Michigan</b>	<ul style="list-style-type: none"> <li>● University of Detroit Mercy School of Law</li> <li>▲ University of Michigan Law School</li> <li>■ Wayne State University Law School</li> </ul>	<b>Oregon</b>	<ul style="list-style-type: none"> <li>● Lewis &amp; Clark Law School</li> </ul>
<b>Connecticut</b>	<ul style="list-style-type: none"> <li>● University of Connecticut School of Law</li> </ul>	<b>Minnesota</b>	<ul style="list-style-type: none"> <li>● Mitchell Hamline School of Law</li> <li>▲ University of St. Thomas School of Law</li> </ul>	<b>Pennsylvania</b>	<ul style="list-style-type: none"> <li>▲ University of Pennsylvania Law School</li> </ul>
<b>District of Columbia</b>	<ul style="list-style-type: none"> <li>● American University, Washington College of Law</li> <li>● Howard University School of Law</li> <li>▲ The George Washington University School of Law</li> </ul>	<b>Missouri</b>	<ul style="list-style-type: none"> <li>■ Washington University in St. Louis School of Law</li> </ul>	<b>Puerto Rico</b>	<ul style="list-style-type: none"> <li>● University of Puerto Rico School of Law</li> </ul>
<b>Florida</b>	<ul style="list-style-type: none"> <li>● University of Miami School of Law</li> </ul>	<b>Nebraska</b>	<ul style="list-style-type: none"> <li>▲ University of Nebraska College of Law</li> </ul>	<b>Rhode Island</b>	<ul style="list-style-type: none"> <li>▲ Roger Williams University School of Law</li> </ul>
<b>Idaho</b>	<ul style="list-style-type: none"> <li>▲ University of Idaho College of Law</li> </ul>	<b>New Hampshire</b>	<ul style="list-style-type: none"> <li>▲ UNH Franklin Pierce School of Law</li> </ul>	<b>Tennessee</b>	<ul style="list-style-type: none"> <li>▲ University of Tennessee College of Law</li> <li>▲ Vanderbilt Law School</li> </ul>
<b>Illinois</b>	<ul style="list-style-type: none"> <li>▲ Northwestern Pritzker School of Law</li> <li>● University of Illinois Chicago School of Law</li> </ul>	<b>New Jersey</b>	<ul style="list-style-type: none"> <li>▲ Rutgers Law School</li> </ul>	<b>Texas</b>	<ul style="list-style-type: none"> <li>● Baylor Law School</li> <li>● South Texas College of Law Houston</li> <li>● Southern Methodist University Dedman School of Law</li> <li>● Texas A&amp;M University School of Law</li> </ul>
<b>Indiana</b>	<ul style="list-style-type: none"> <li>● Indiana University Maurer School of Law</li> <li>● Indiana University Robert H. McKinney School of Law</li> <li>● University of Notre Dame Law School</li> </ul>	<b>New York</b>	<ul style="list-style-type: none"> <li>● Brooklyn Law School</li> <li>● Fordham University School of Law</li> <li>● New York Law School</li> <li>▲ Syracuse University College of Law</li> </ul>	<b>Utah</b>	<ul style="list-style-type: none"> <li>● Brigham Young University Law School</li> </ul>
				<b>Virginia</b>	<ul style="list-style-type: none"> <li>■ George Mason University, Antonin Scalia Law School</li> <li>▲ Liberty University School of Law</li> <li>▲ University of Richmond School of Law</li> </ul>
				<b>Washington</b>	<ul style="list-style-type: none"> <li>▲ Seattle University School of Law</li> <li>● University of Washington School of Law</li> </ul>



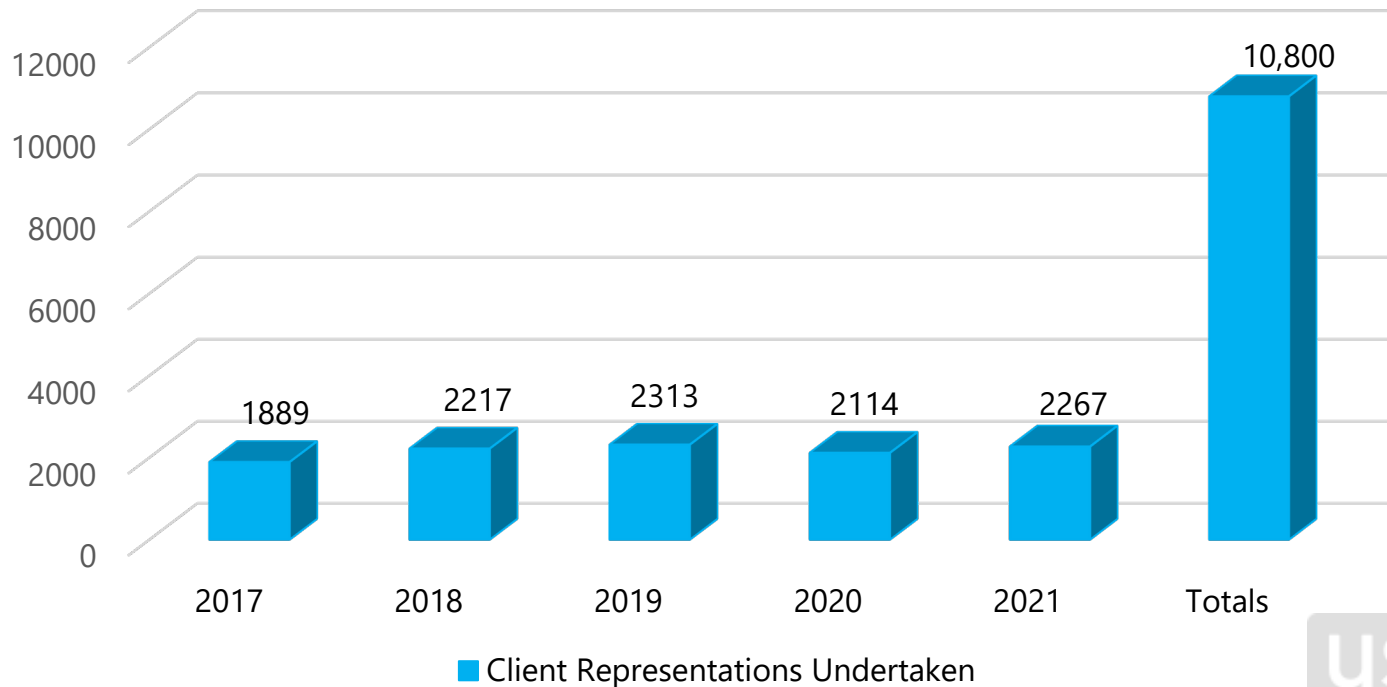
# Program overview

Currently, **62 law schools** are in the program from all across the United States



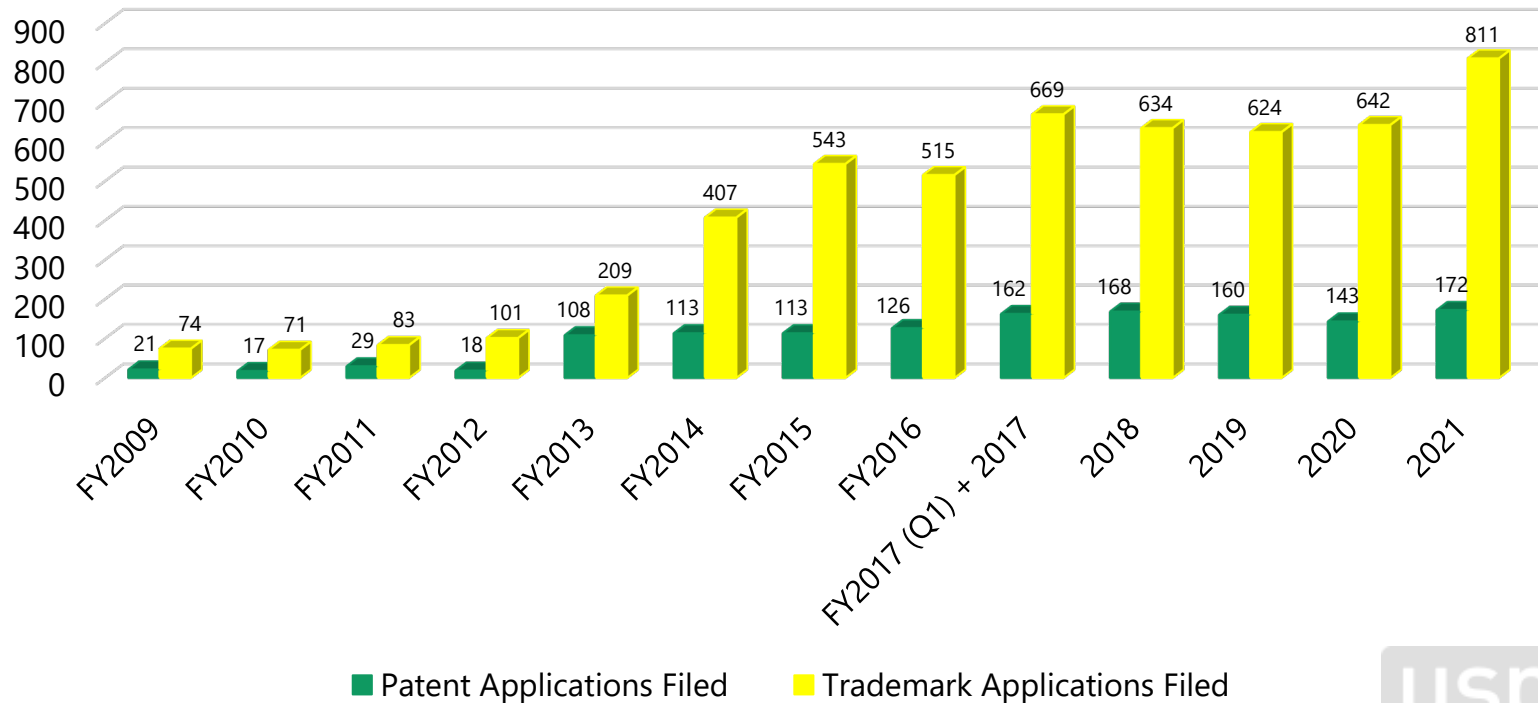
# Clients served statistics

## Client representations undertaken 2017–2021



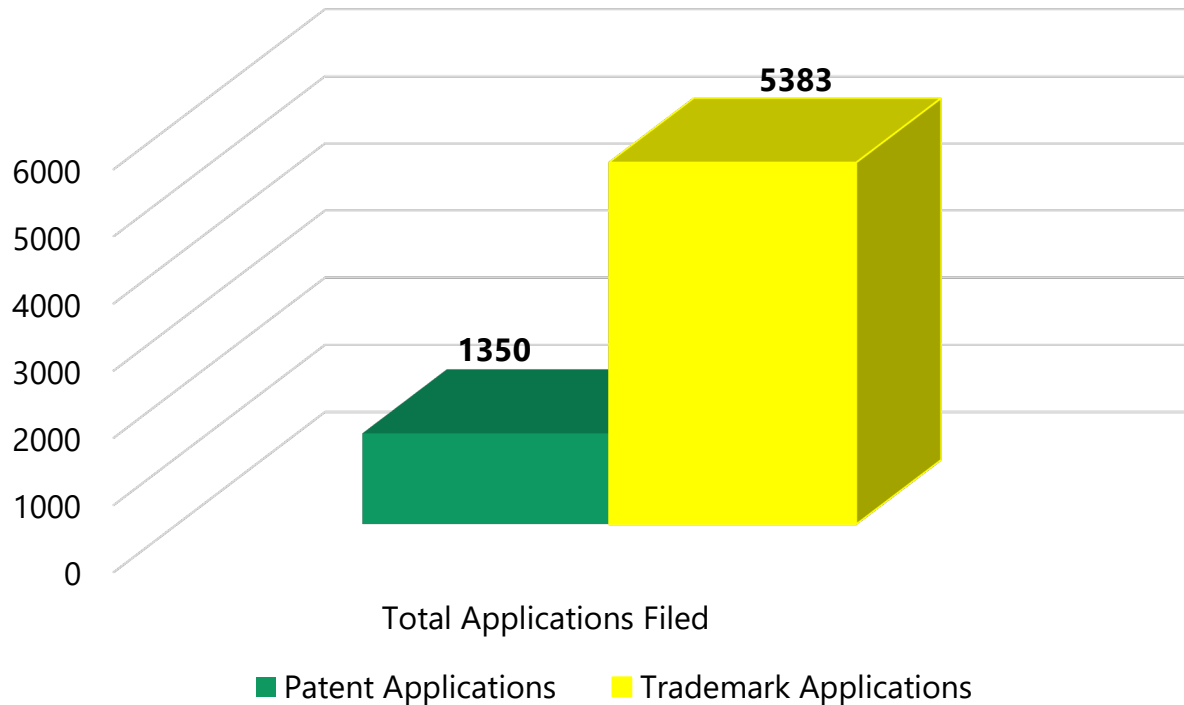
# New application filing statistics

## Application filing statistics FY2009–2021



# Summary of application statistics

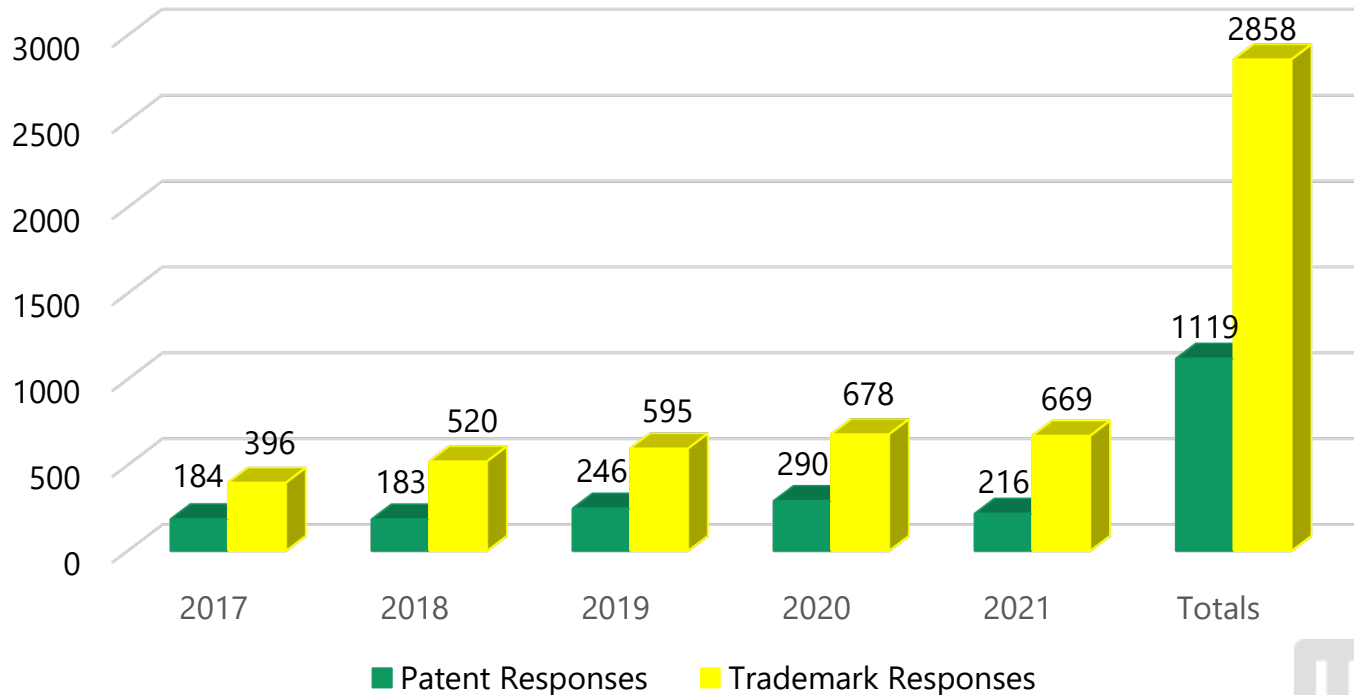
## Application filing statistics FY2009–2021





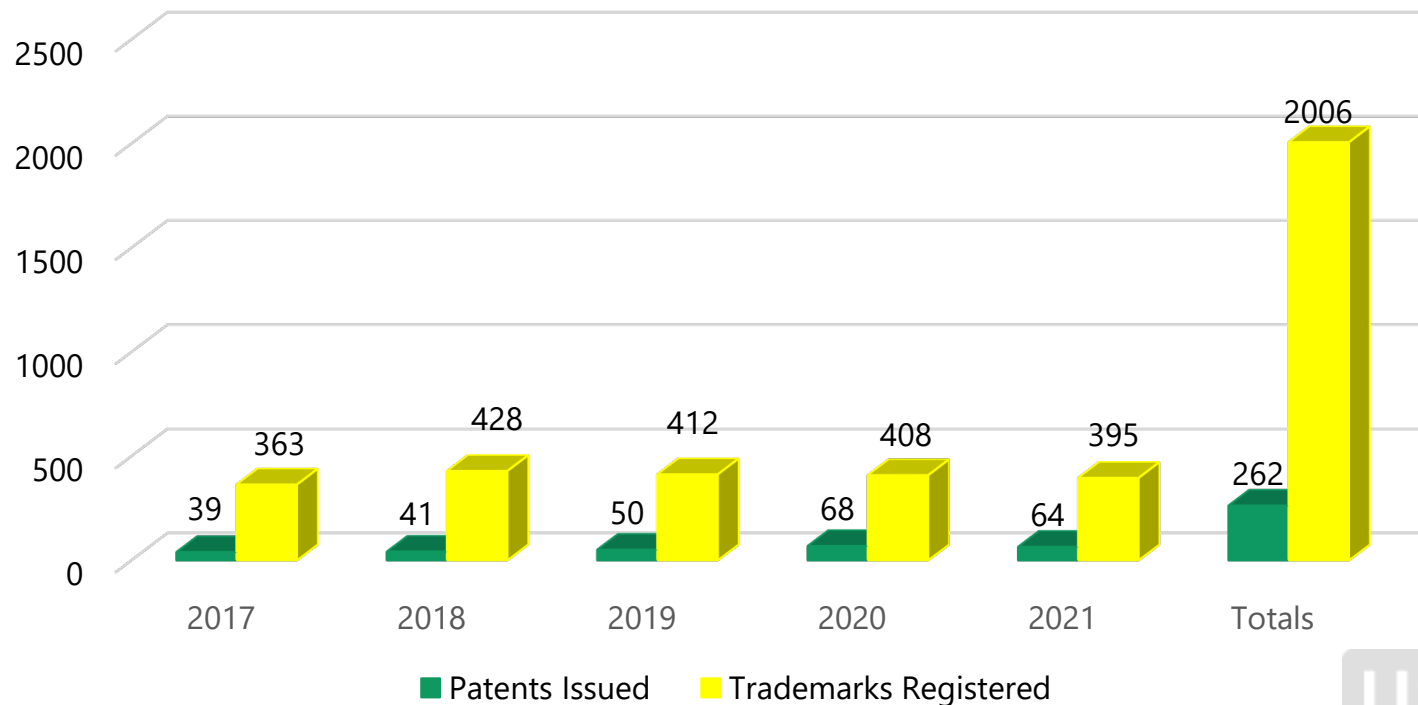
# Prosecution work statistics

## Reponses filed 2017–2021



# Results/successes statistics

## Patents issued and trademarks registered 2017–2021



# Finding and contacting a participating law school

<https://www.uspto.gov/learning-and-resources/ip-policy/public-information-about-practitioners/law-school-clinic-1>

The screenshot shows the top portion of the USPTO website. On the left is the USPTO logo with the text "UNITED STATES PATENT AND TRADEMARK OFFICE". To the right are links for "About Us", "Jobs", "Contact Us", and "MyUSPTO". Below these is a search bar with the placeholder text "Search uspto.gov" and a magnifying glass icon. A navigation menu contains "Patents", "Trademarks", "IP Policy", and "Learning and Resources", with "Learning and Resources" being the active page. A "Find It Fast" button is also present. Below the navigation menu is a breadcrumb trail: "Home > Learning and Resources > Patent and Trademark Practitioners > Law School Clinic Certification Program". To the right of the breadcrumb trail are "Share" and "Print" icons.

Intellectual property legal  
assistance programs

Patent pro bono program

Pro Se assistance program

Scam prevention

**Law school clinic program**

## Law School Clinic Certification Program

The Law School Clinic Certification Program includes over 60 participating law school clinics that provide legal services pro bono to the public, including to inventors, entrepreneurs, and small businesses. Participating law school clinics provide patent and/or trademark legal services to qualified members of the public who are accepted as a client of a clinic. Each participating law school has requirements for accepting new clients and accepts new clients at their discretion.

[Expand all](#) | [Collapse all](#)

### ▼ Get help from a law school clinic

Students enrolled in participating law school clinic certification programs practice intellectual property law before the USPTO under the strict guidance of a law school faculty clinic supervisor. Students practice both patent and trademark law before the United States Patent and Trademark Office (USPTO). The Office of Enrollment and Discipline administers the program; the Director of the Office of Enrollment and Discipline grants the law students limited recognition to practice before the USPTO.

Students gain experience drafting and filing either patent applications or trademark applications for clients of the law school clinic. Further, as they are authorized to practice before the USPTO, they gain experience answering office actions and communicating with either patent examiners or trademark examining attorneys for the applications they have filed.

# Additional information

- Questions regarding the program may be directed to the Office of Enrollment and Discipline:
  - Phone: 571-272-4097
  - Email: [LawSchoolInformation@uspto.gov](mailto:LawSchoolInformation@uspto.gov)
- See frequently asked questions for more information:
  - [Law School Clinic Certification Program FAQs](#)

# Question/comment submission

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# Invention-Con

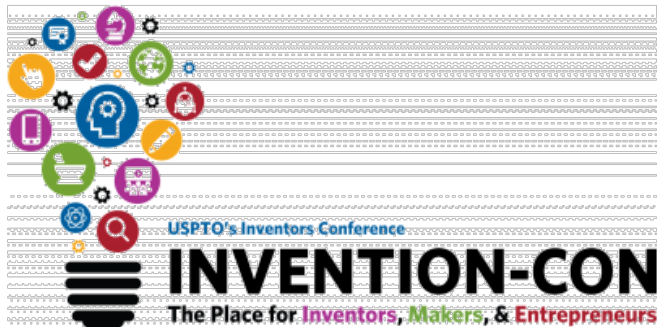


<https://www.uspto.gov/about-us/events/invention-con-event-series>

## Coming August 10–12, 2022!

Invention-Con is the USPTO's annual conference for independent inventors, entrepreneurs, and small business owners whose success depends on guarding their creative work.

For more information, email [InventionCon@uspto.gov](mailto:InventionCon@uspto.gov) or call 571-272-8033.



# Next Inventor Hour webinar



**June 23, 2022**, at noon to 1 p.m. ET

- Meet a judge
- Appeal Byte: what is an appeal brief
- IP History: patent models



