

UNITED STATES
PATENT AND TRADEMARK OFFICE



Patent Trial and Appeal Board Inventor Hour: Episode 21

Michael Astorino, Administrative Patent Judge

Janet Gongola, Vice Chief Administrative Patent Judge

Ulrike Jenks, Administrative Patent Judge

John Schneider, Administrative Patent Judge

Special guest:

Scott Boalick, Chief Administrative Patent Judge

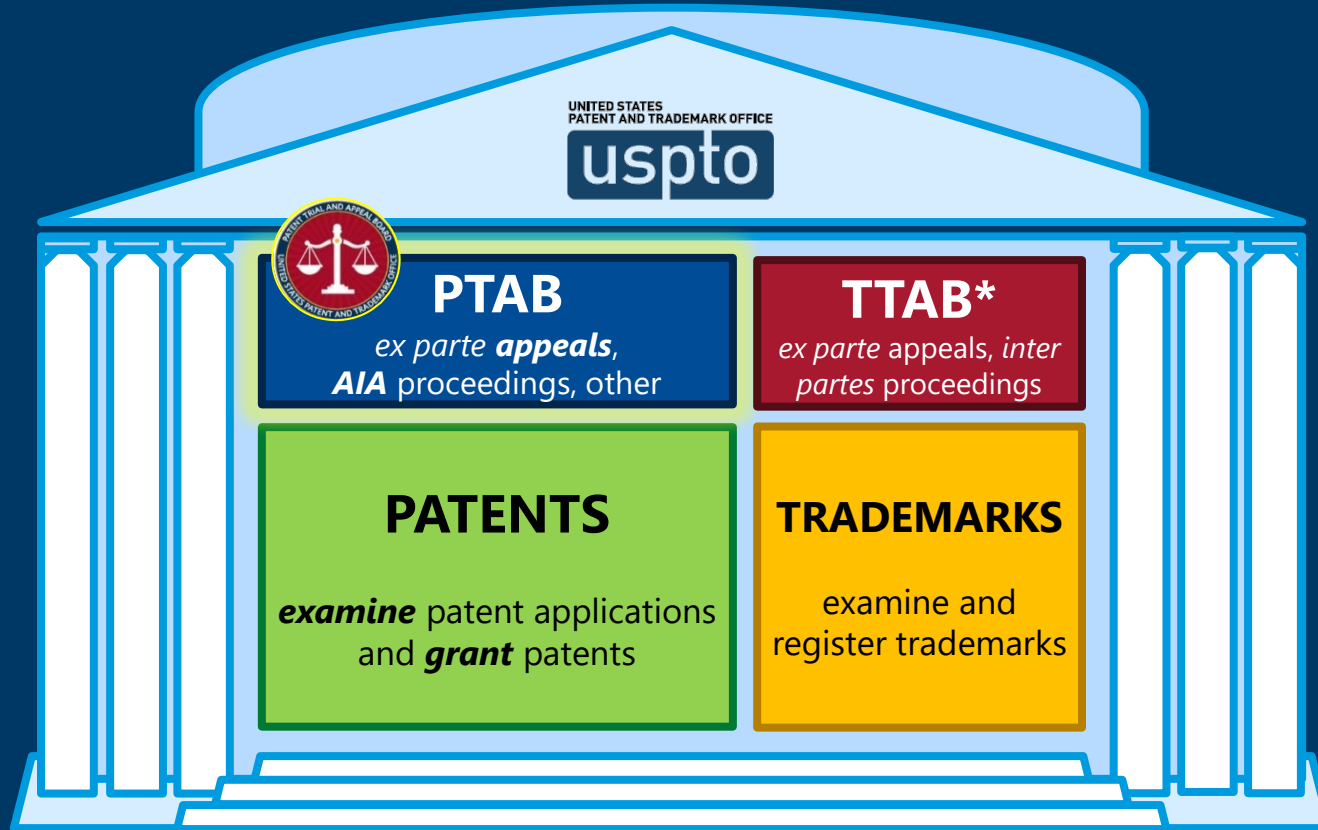


August 24, 2023



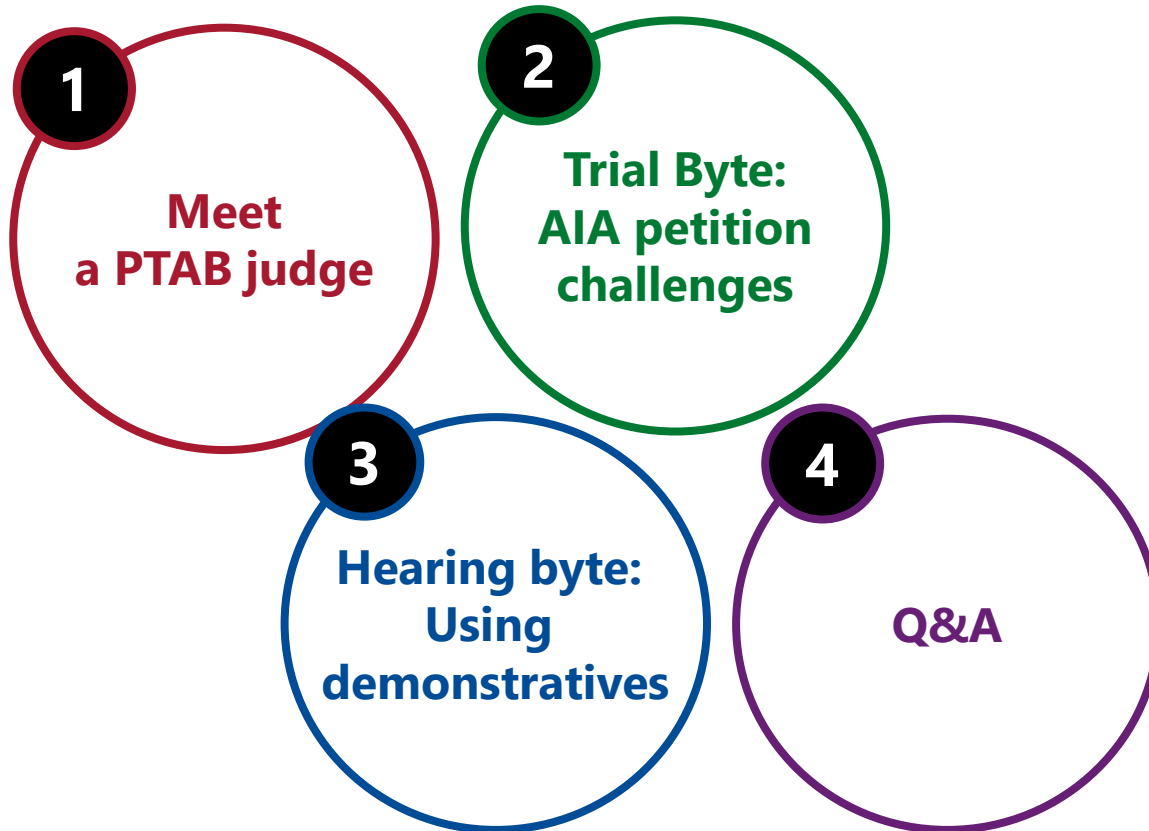
UNITED STATES
PATENT AND TRADEMARK OFFICE ®

What is the Patent Trial and Appeal Board?



*Trademark Trial and Appeal Board (TTAB)

Today's agenda



Question/comment submission

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

- PTABInventorHour@uspto.gov



Janet Gongola, Vice Chief Administrative Patent Judge for Strategy



Meet a PTAB judge

Scott R. Boalick, Chief Administrative Patent Judge

A photograph of Chief Judge Scott R. Boalick speaking at a podium. He is a bald man with glasses, wearing a dark suit, white shirt, and patterned tie. He is gesturing with his hands while speaking into a microphone. A name tag is pinned to his lapel. The background is a blue curtain.

Chief Judge Scott R. Boalick

Hon. Scott Boalick

Chief Judge, 17th
Circuit, IA

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Access USPTO free services



The screenshot shows the USPTO website's "Access our free services" page. The header includes the USPTO logo, navigation links (About Us, Jobs, Contact Us, MyUSPTO), and a search bar. The main content area features a blue navigation bar with "Patents", "Trademarks", "IP Policy", and "Learning and Resources". Below this is a breadcrumb trail: "Home > Learning and Resources > Access our free services". The main heading is "Access our free services". A paragraph explains that the USPTO offers a wide range of intellectual property (IP) resources, including application assistance, education and training, and other services that support the full spectrum of customers—from independent patent and trademark filers, to attorneys and business advisors in both the private and public sectors. A link is provided to learn more about what USPTO is doing to expand participation in the innovation ecosystem through [inclusive innovation](#), including our [Council for Inclusive Innovation \(CII\)](#).

Using the icons below, select a category to filter the list by your area of interest.

Four icons are displayed: a lightbulb for "All Resources", a ribbon for "Patents", a registered trademark symbol (R) for "Trademarks", and a building for "Attorneys and Business Advisors".

Title	Description	Resource category
Application Assistance		
Application Assistance Unit (AAU)	Provides assistance with questions and issues pertaining to pre-examination processing of patent applications and the post-examination processing of patent applications.	
Finding a patent practitioner	Search the registry of active patent practitioners who are eligible to represent others before the USPTO in patent matters.	
Hiring a U.S.-licensed attorney for trademarks	Discover if you are required to hire an attorney and why you should hire an attorney for trademark matters, even if you are not required to.	
Inventors Assistance Center	Provides patent assistance and information to the public to help make filing a patent application simple and efficient before, during, and after the patent application process (i.e., patent maintenance).	
Law School Clinic Certification Program	Under the supervision of an approved faculty clinic supervisor, law school students provide pro bono representation to individuals and small businesses throughout the country in the prosecution of patent and trademark applications before the USPTO.	
Patent and Trademark Resource Centers	Nationwide network of 80+ libraries that offers the public trademark and patent assistance. These libraries provide access to examiner-based search systems, and staff demonstrate how to use search tools and offer classes on intellectual property.	

<https://www.uspto.gov/learning-and-resources/access-our-free-services>



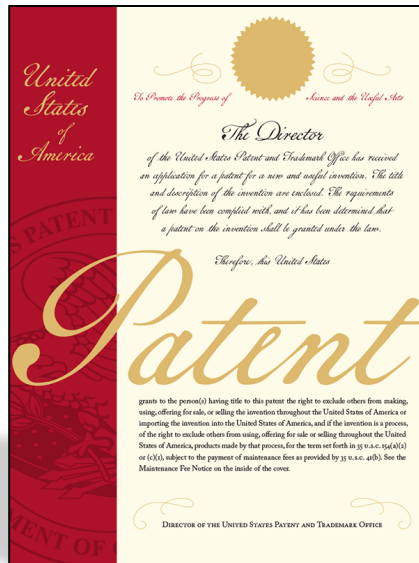
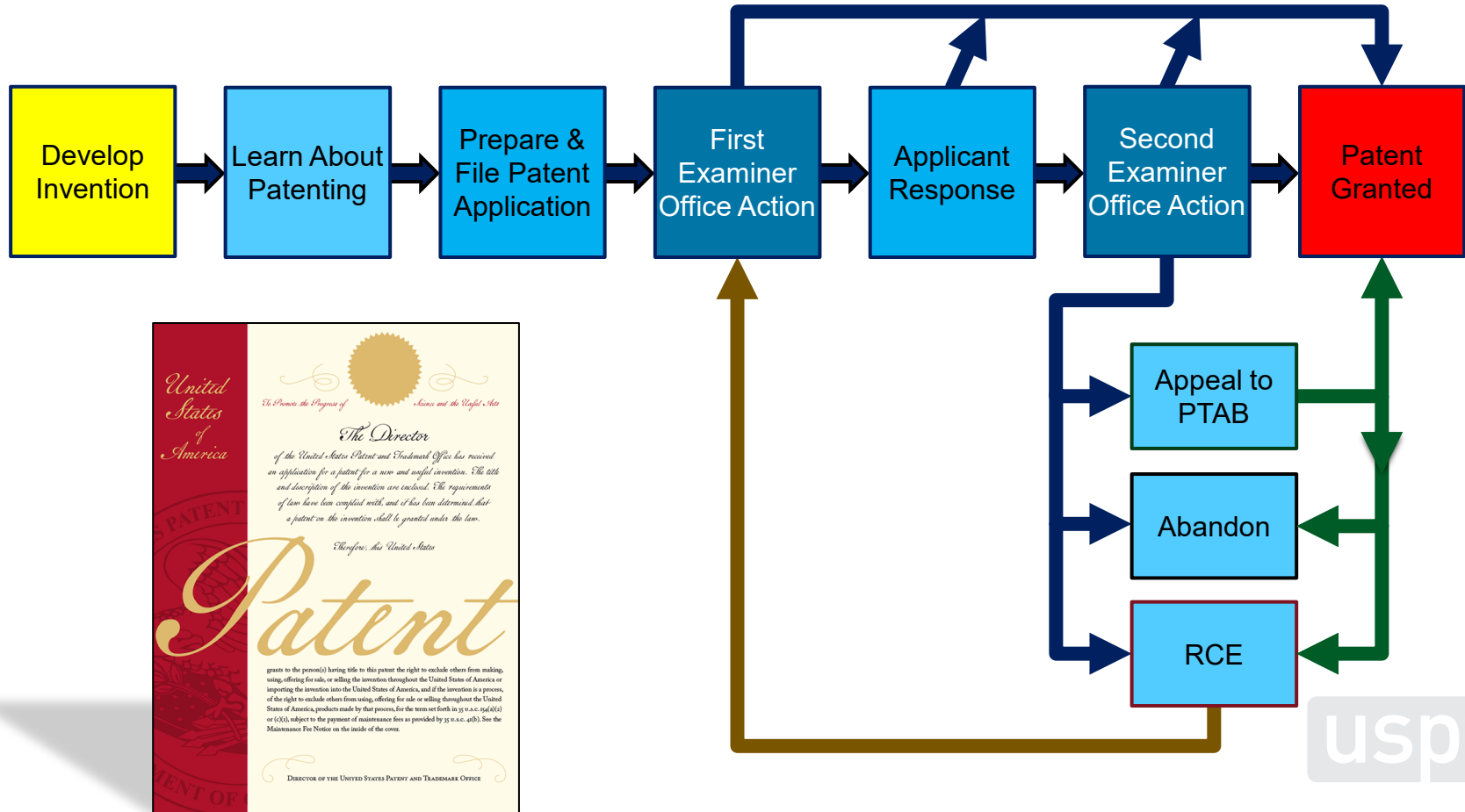
Ulrike Jenks, Administrative Patent Judge

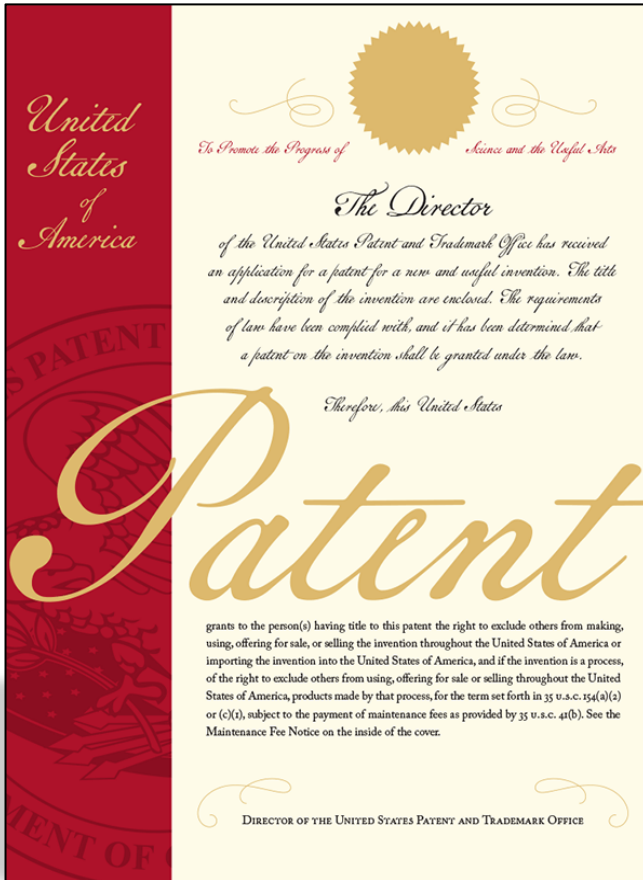


Trial Byte:

Types of challenges in an AIA petition

Patenting timeline

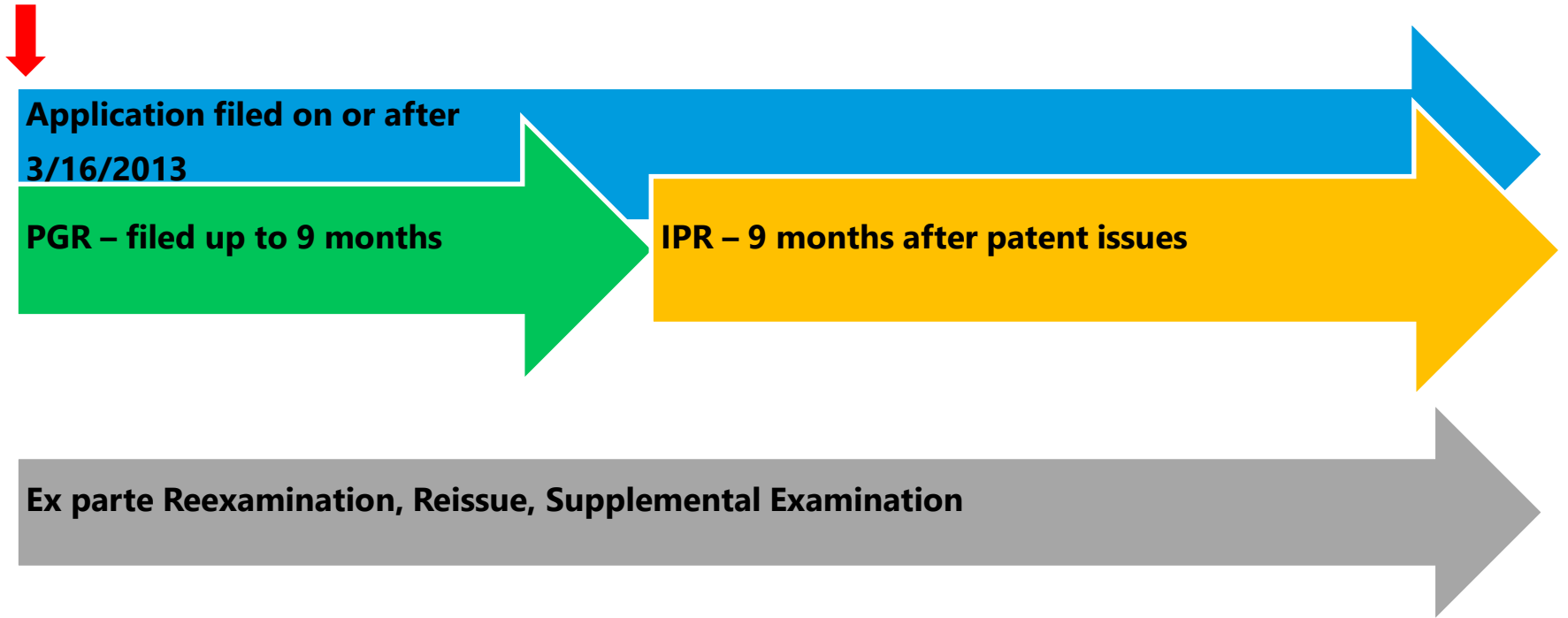




The patent issued –
What can happen next?



Post-grant timeline for presenting an AIA challenge to a patent

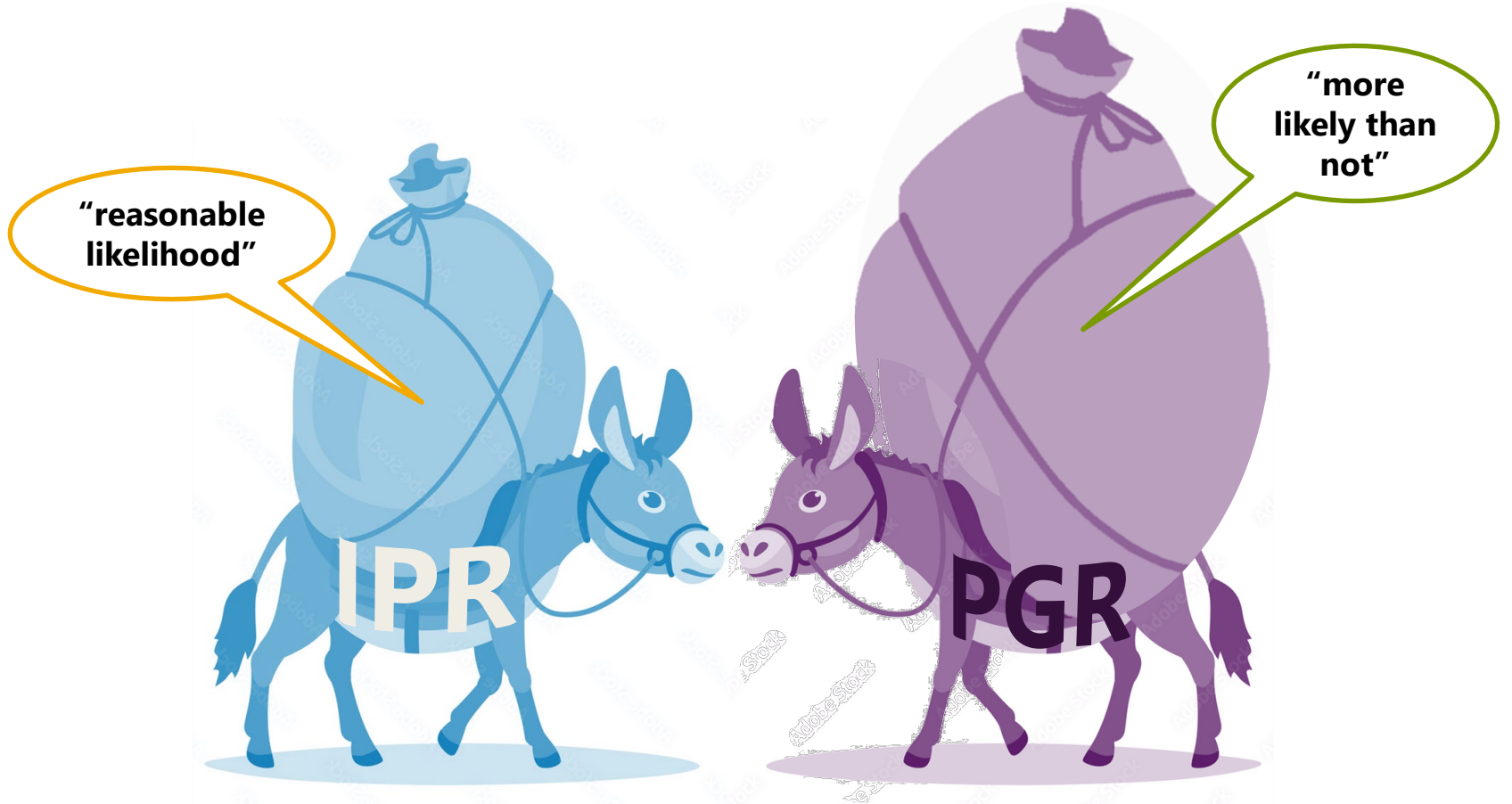


What is the difference between a PGR or IPR proceeding?

Type of challenge	Post grant review (PGR) (filing time line is between 0-9 month date)	<i>Inter Partes</i> Review (IPR) (earliest is from 9 month – end of patent term)
35 U.S.C. § 101 Eligibility	✓	
35 U.S.C. § 112 written description / enablement	✓*	
35 U.S.C. § 102 Novelty	✓	✓
35 U.S.C. § 103 non-obviousness	✓	✓

* Not best mode

Difference in the institution standards



Evidence available for a petition

Type of art / evidence	Post grant review (PGR) (filing time line is between the 0-9 month date)	<i>Inter Partes</i> Review (IPR) (earliest from 9 month – end of patent term)
Patents / Patent publications	✓	✓
Printed publications	✓	✓
Public disclosures	✓	
On-sale activity	✓	
Public use	✓	

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Patents for Humanity: Green Energy

- The USPTO is expanding the **Patents for Humanity Awards Program** to include a new category for those who are responding rapidly to the challenges of climate change by **developing green energy sources** using game-changing technologies.
- Any U.S. patent or patent application that is directed to **green energy technologies** is eligible for this award
- Submission deadline has been extended to **September 15, 2023**
- <https://www.uspto.gov/ip-policy/patents-humanity-green-energy>



John E. Schneider, Administrative Patent Judge

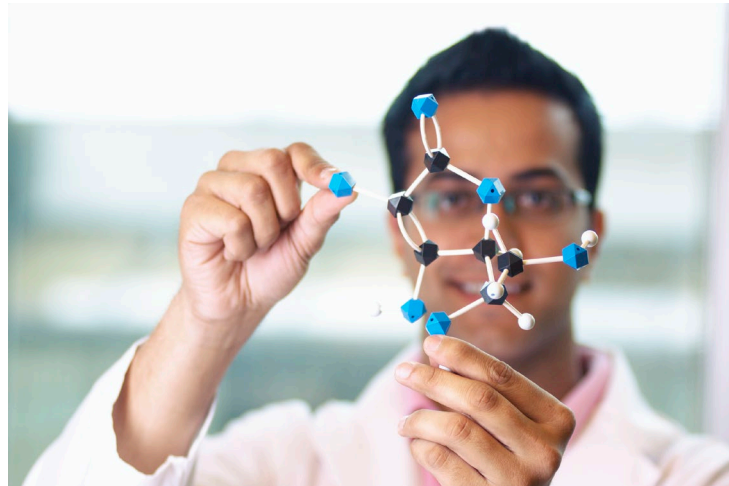


Hearing Byte:

Using demonstratives

What are demonstratives?

- Aids to presenting your argument
- Presentation software (e.g. PowerPoint)
- Physical exhibits



Demonstratives

- Not part of the record
- Must be supported by the record
 - Provide citations
- No new evidence or arguments

Keep it simple

- Avoid large blocks of text
- Focus on key points
- Don't make it too long
- Highlight key points or elements

Avoid large blocks of text



By "crystallization-resistant sugar" is meant a mono- or disaccharide or mixture of mono- and/or disaccharides, which crystallizes, at the water content and water activity encountered in the semimoist cookies of the home-baked type, substantially more slowly than sucrose under the same conditions, typically remaining uncrystallized for periods of at least 1-6 months. Particularly good crystallization resistant sugars are fructose, dextrose, and mixtures of sugars of which fructose and dextrose together comprise at least about 15% by weight, and solutions thereof. Others include psicose fructose, sorbose, tagatose, allose, altrose, mannose, gulose, idose, galactose, talose, maltose, and lactose.

US Patent 4,455, 333, col. 5, ll. 25-37



Highlight key passage



By "***crystallization-resistant sugar***" is meant a mono-or disaccharide or mixture of mono- and/or disaccharides, which crystallizes, at the water content and water activity encountered in the semimoist cookies of the home-baked type, substantially more slowly than sucrose under the same conditions, typically ***remaining uncrystallized for periods of at least 1-6 months***. Particularly good crystallization resistant sugars are fructose, dextrose, and mixtures of sugars of which fructose and dextrose together comprise at least about 15% by weight, and solutions thereof. Others include psicose fructose, sorbose, tagatose, allose, altrose, mannose, gulose, idose, galactose, talose, maltose, and lactose.

US Patent 4,455, 333, col. 5, ll. 25-37



Keep it short

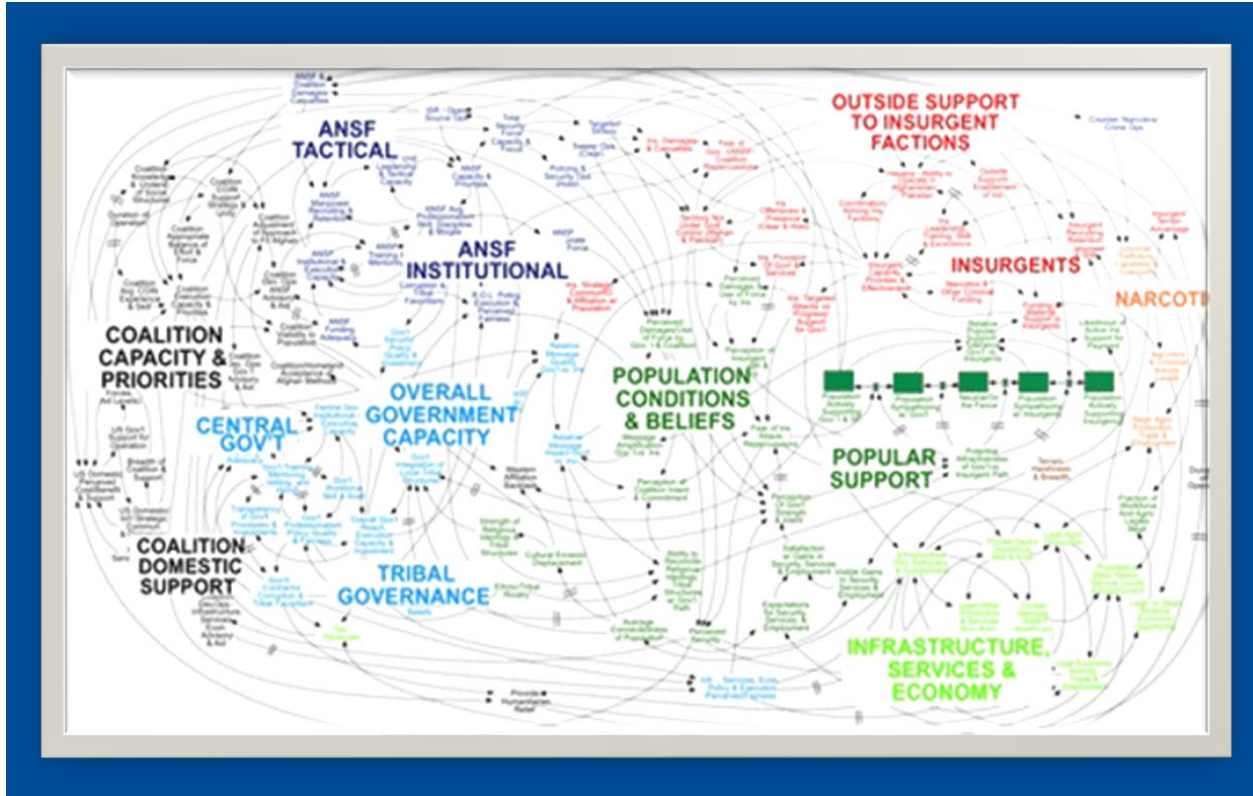
- Appeal – 20 minutes
- AIA proceeding – Typically 60 minutes per side including rebuttal
- At best one slide a minute

Suggestion

- Main presentation covering key issues
- Supplement with backup slides to use if needed



Keep it simple



Know your presentation

- Be able to move about the slide deck
 - Page number then enter
- Don't be wedded to the order of the slides
- Know your opponent's slides



The hearing

- Provide copies in advance
- Give page cites



*“We Have Met the Enemy and He Is
PowerPoint”*

NY Times, April 26, 2010



Additional guidance

- Patent Trial and Appeal Board Consolidated Trial Practice Guide,
<https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf?MURL>
- 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%20hearings%20guide%20101520.pdf)



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PTAB contact info



By telephone:

- 571-272-9797 (general; appeals; and interferences)
- 571-272-7822 (trials; and PTACTS)

By email:

- PTAB_Appeals_Suggestions@USPTO.GOV
- Trials@uspto.gov
- PTABStatisticsQuestions@USPTO.GOV
- PTABOutreach@uspto.gov
- PTABP-TACTSAdmin@uspto.gov



Weigh-in on future Inventor Hour topics

Interviews with inventors, PTAB judges, examiners, lawyers, trademarks, other areas of the patent office?

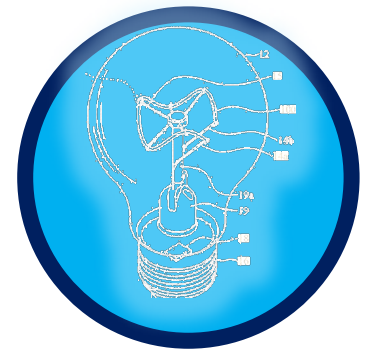
Review of **substantive patent law** like anticipation, enablement, utility, obviousness, restriction practice, appeals?

Identification of **resources** for inventors?

Inventor **success stories**?

Practical tips on working with the patent office?

Something entirely new?



Send your wish list to - PTABInventorHour@uspto.gov



Future programs



Inventor Hour, Episode 22

Thursday, September 28, noon (ET)

Inventor Hour, Episode 23

Thursday, October 26, noon (ET)



