

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# Patent Trial and Appeal Board Inventor Hour Webinar: Episode 9

Janet Gongola, Vice Chief Judge

Brian Fried, Inventor

Robert Silverman, Administrative Patent Judge

Amee Shah, Administrative Patent Judge

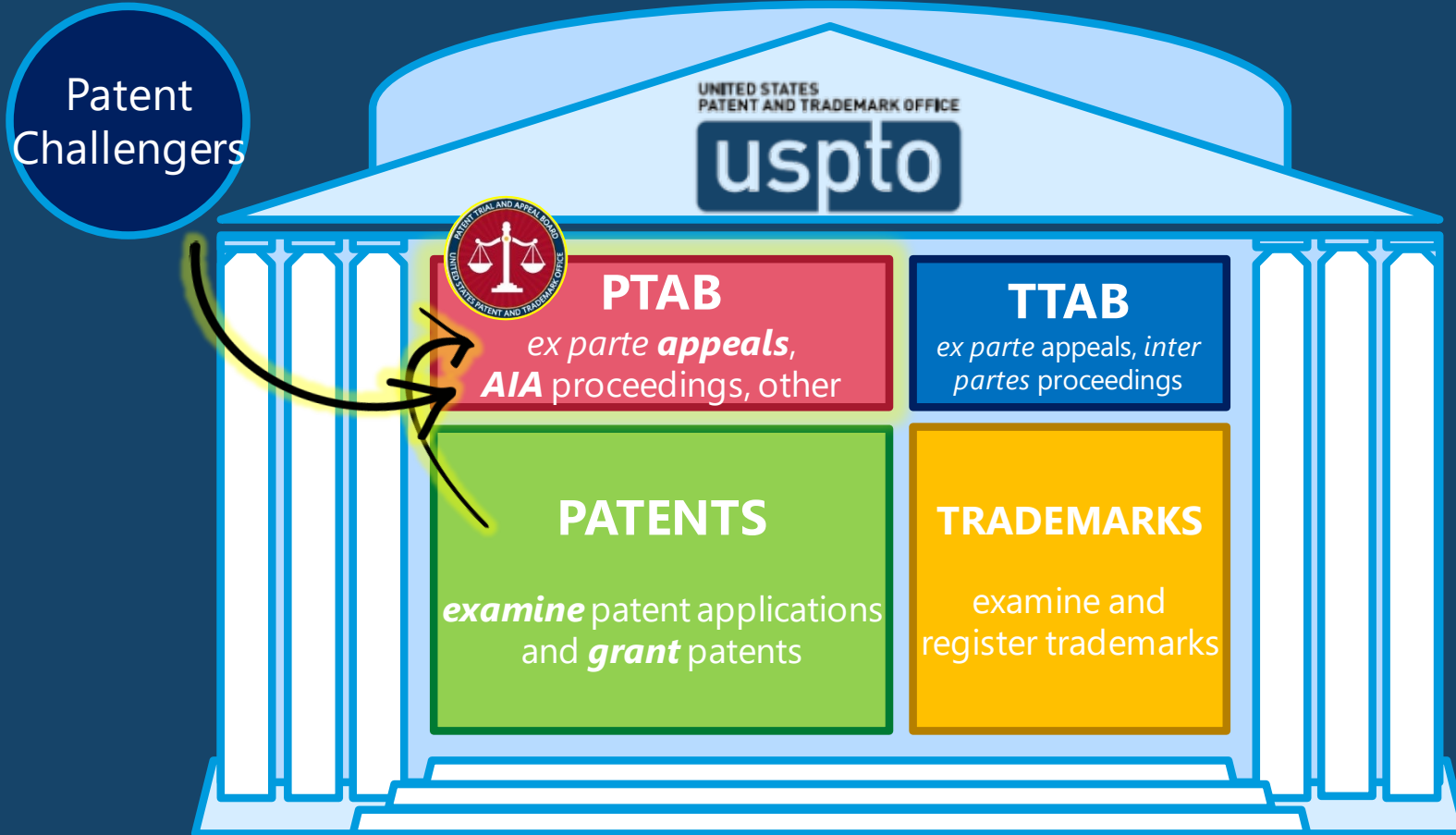
John Schneider, Administrative Patent Judge

June 23, 2022

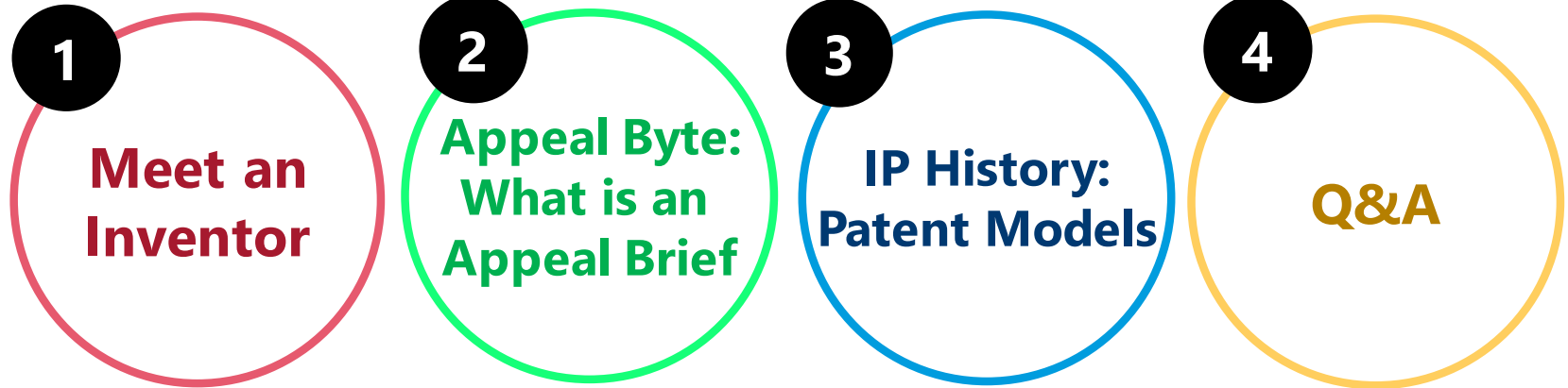
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# Refresher: What is PTAB (the Board)?



# Today's Agenda



# Question/Comment Submission

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

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



Robert Silverman, Administrative Patent Judge



# Meet an Inventor:

**Brian Fried**



Brian Fried  
Inventor



# Question/Comment Submission

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



# 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.



Amee Shah, Administrative Patent Judge



# Appeal Byte:

## What is an appeal brief?

# Agenda

-  Parts of an appeal **brief**
-  New appeal brief **tool**




# Parts of an appeal brief

# Parts of an appeal brief





## Six parts:

1. Summary of claimed subject matter
2. Real party-in-interest
3. Related appeals, interferences, and trials
4. Argument
5. Conclusion (optional)
6. Claims appendix

# Summary of claimed subject matter



-  Provides a concise explanation of the subject matter defined in each of the rejected independent claims
-  Not required for *pro se* applicants, but may help the Board understand the arguments
-  If included, should identify, for each claim element, supporting disclosure and figures

# Real party-in-interest

-  Statement that identifies the real party-in-interest at the time the appeal brief is filed
-  It may be you, the inventor, and/or others that have ownership rights to the patent application
-  May be an assignee
-  You must update if it changes during the proceeding  
(*See 37 C.F.R. § 41.8*)

Example: “The real party in interest is The Great White Café LLC (Baja, California 21511).”

# Related appeals, interferences, and trials

-  List any prior or pending cases before the Board or a court that are related to the current appeal
-  A related case is one involving a patent or application where papers (such as an Office Action or PTAB decision) regarding that patent or application would be affected by the current appeal.
  - A related case might be, e.g., a continuation application

Example 1: "Appeal No. 2019-1234, prior decision dated July 1, 2020."

Example 2: "There are no related appeals, interferences, or trials to appellant's knowledge."







# Argument

Why the examiner's decision to reject the pending claims of your application is improper and should be reversed

# Conclusion and claims appendix

-  Conclusion should briefly explain what relief you want from the Board (e.g., reverse the examiner's rejection)
-  Appendix must include all claims on appeal
  - Should not indicate or illustrate prior amendments or reference non-admitted amendments
  - Should start on a new page

# **New appeal brief tool and how to access**

# Appeal brief tool

There are **two parts** to the appeal brief **tool**:

1. Word document **template**
2. PDF **instructions** for completing the template

# Location of the brief tool at PTAB's webpage

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

The screenshot shows the USPTO Patent Trial and Appeal Board (PTAB) website. The header includes the USPTO logo, the text "UNITED STATES PATENT AND TRADEMARK OFFICE", and navigation links for "About Us", "Jobs", "Contact Us", and "MyUSPTO". A search bar is located in the top right corner. Below the header, there are tabs for "Patents", "Trademarks", "IP Policy", and "Learning and Resources", along with a "Find It Fast" button. The main content area is titled "Patent Trial and Appeal Board" and includes a brief description of the PTAB's functions. Below this, there are three main sections: "Trials and appeals", "Decisions", and "Learn more". The "Trials and appeals" section is highlighted with a red circle, and the link "New to PTAB?" is highlighted in yellow. The "Decisions" section lists links for "All PTAB decision data", "AIA daily decisions", "Precedential and informative decisions", and "Precedential Opinion Panel (POP)". The "Learn more" section lists links for "Statistics", "Databases and IT tools", "Frequently asked questions", "Boardside Chat webinar series", "PTAB Inventor Hour series", "PTAB suggestion box, contact info, and speaker request form", "Recent proposals, pilot programs, and final rules", and "PTAB Judicial Law Clerk Program". At the bottom of the page, there are five navigation buttons: "PTAB E2E system", "Search decisions, documents, proceedings", "Hearing information", "Latest developments", and "Recent proposals, pilot programs & final rules".

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## Patent Trial and Appeal Board

The Patent Trial and Appeal Board (PTAB) conducts trials, including inter partes, post-grant, and covered business method patent reviews and derivation proceedings, hears appeals from adverse examiner decisions in patent applications and reexamination proceedings, and renders decisions in interferences.

### Trials and appeals

- > Resources and guidance
- > Trial proceedings
- > Appeals proceedings
- > **New to PTAB?**
- > Preparing for hearings
- > Fees
- > PTAB Pro Board

### Decisions

- > All PTAB decision data
- > AIA daily decisions
- > Precedential and informative decisions
- > Precedential Opinion Panel (POP)

### Learn more

- > Statistics
- > Databases and IT tools
- > Frequently asked questions
- > Boardside Chat webinar series
- > PTAB Inventor Hour series
- > PTAB suggestion box, contact info, and speaker request form
- > Recent proposals, pilot programs, and final rules
- > PTAB Judicial Law Clerk Program

PTAB E2E system Search decisions, documents, proceedings Hearing information Latest developments Recent proposals, pilot programs & final rules

# Location of the brief tool at PTAB's webpage

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

The screenshot shows the USPTO website's 'New to PTAB?' page. The page features a navigation bar with 'Patents', 'Trademarks', 'IP Policy', and 'Learning and Resources'. Below the navigation, there are three main sections: 'What is PTAB?', 'Ex parte appeals', and 'AIA proceedings'. A red circle highlights the 'EX PARTE APPEAL BRIEF TEMPLATE' link in the 'AIA proceedings' section. The link is part of a larger graphic that includes a 'Word template' and a 'PDF Instruction Document' for the brief. The 'Word template' shows a form with fields for 'Applicant Information', 'Applicant's Address', 'The Applicant's Name', and 'The Case Number'. The 'PDF Instruction Document' contains instructions for drafting the brief, including a 'Briefing Schedule' and a 'Briefing Checklist'. The 'EX PARTE APPEAL BRIEF TEMPLATE' link is located at the bottom of the graphic.

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Patents | Trademarks | IP Policy | Learning and Resources

Home > Patents > Patent Trial and Appeal Board > About PTAB > New to PTAB?

## New to PTAB?

Independent inventors, new practitioners, and others can explore the links below to better understand the Patent 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

**EX PARTE APPEAL BRIEF TEMPLATE**

Provides help in drafting an ex parte appeal brief for independent inventors and others

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

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# Preparing an ex parte appeal brief webpage

[www.uspto.gov/patents/patent-trial-and-appeal-board/resources/preparing-ex-parte-appeal-brief](http://www.uspto.gov/patents/patent-trial-and-appeal-board/resources/preparing-ex-parte-appeal-brief)

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Main menu

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- Trademarks
- IP Policy
- Learning and Resources
- About Us
- Jobs
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## Preparing an ex parte appeal brief

Are you an independent inventor looking to appeal a patent examiner's rejection of your claims without the assistance of an attorney, which is called acting "pro se" in your appeal? If so, you're in the right place.

If any of the claims in a patent application has been twice rejected or finally rejected by a patent examiner, you may seek review as an appellant before the Patent and Trial Appeal Board (PTAB).

An appellant and the examiner may submit written papers known as "briefs" to explain their respective positions. The process begins when an appellant files a "notice of appeal" followed by an appellant's "appeal brief." The examiner usually responds with an "answer" to address the appellant's argument made in the "appeal brief." The appellant may, but doesn't have to, then file a "reply brief" to address the "answer."

Once fully briefed, your appeal will be considered by a panel of three administrative patent judges at the Board. The panel will review the briefs and render a decision, either maintaining ("affirming") or not maintaining ("reversing") all or part of the examiner's rejection.

For help creating your appeal brief, see the documents below:

- A [Word document](#) template that features the various required sections of a brief, for example, a summary of the claimed subject matter, arguments, and claim appendix
- A [PDF](#) that provides general guidance on the information required in the various sections of the brief along with helpful examples to use as models
- An [instructional video](#) on how to use these documents.

With these documents and, if needed, the [relevant cited rules](#) and the [Manual of Patent Examining Procedure](#), you should be well on your way to drafting your appeal brief.

**Other resources:**

- [To file your appeal brief, go to EFS-Web](#)
- [New to PTAB](#)
- [Contact information for the Board](#)



# Appeal brief tool: Word template and PDF instructions

## Word template

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors: [Inventor Name(s)]	Group Art Unit: [####]
Application No. [#####,###]	Examiner: [Name]
Filed: [Application Filing Date]	Confirmation No. [####]
Title: [APPLICATION TITLE]	

MAIL STOP APPEAL BRIEF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**APPEAL BRIEF**

Appellant submits this Appeal Brief in response to the final Office action mailed [Date], and further to the Notice of Appeal filed [Date]. Appellant requests consideration of this appeal by the Patent Trial and Appeal Board.

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I. REAL PARTY IN INTEREST  
Add

II. RELATED APPEALS AND INTERFERENCES  
Add

III. SUMMARY OF CLAIMED SUBJECT MATTER  
Add

IV. ARGUMENTS  
Add

a. Rejection 1 – The Rejection of Claims . . . Based on . . .  
i. Independent Claim 1

## PDF Instruction Document

I. REAL PARTY IN INTEREST

This section requires a statement from you that identifies the real party in interest at the time the appeal brief is filed. A real party in interest may include you as the inventor and any other individuals or entities that have ownership rights to the patent application. For example, an assignee of the patent application may be a real party in interest. A statement is not required if the named inventor(s) are the real party in interest. If you do not provide a statement, the Board will consider the inventor(s) to be the real party in interest. Typically, a *pro se* inventor is the real party in interest. See MPEP §§ 301, 324, 1205.02(i) (<https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e123366.html>).

Example:

The real party of interest is The Great White Café LLC (Baja, California 21511) by virtue of an assignment by the inventor duly recorded in the Assignment Branch of the Patent and Trademark Office.

II. RELATED APPEALS AND INTERFERENCES

Please list all of your prior or pending cases before the Board or before a court. These cases are based on applications or patents that you





# Filing an appeal brief via EFS-Web: Preparing an ex parte appeal brief page

[www.uspto.gov/patents/patent-trial-and-appeal-board/resources/preparing-ex-parte-appeal-brief](http://www.uspto.gov/patents/patent-trial-and-appeal-board/resources/preparing-ex-parte-appeal-brief)

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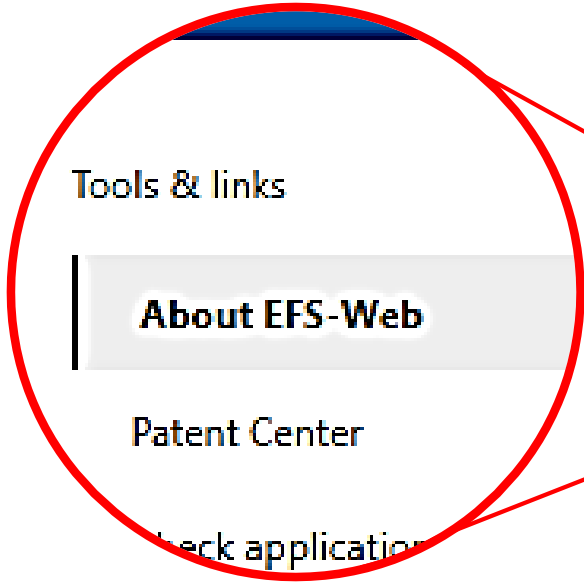
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# Filing an appeal brief via EFS-Web

<https://www.uspto.gov/patents/apply/applying-online/about-efs-web>



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## Tools & links

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  - Patent Center
  - Check application status
  - Fees and payments
  - Patent Trial & Appeal Board
  - Global Dossier
  - More tools & links

## About EFS-Web

### EFS-Web for Registered eFilers

Enhanced filing, follow-on processing, saved submissions and more.

Sign-in with uspto.gov account

### Important Information

- [EFS-Web Resources](#)  
Instructions to become a Registered eFiler ([Getting Started - New Users](#)), system requirements, EFS-Web Fillable Forms, and other useful information and links
- [EFS-Web Announcements](#)  
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### Sponsorship Tool

The [Sponsorship Tool in Patent Center](#) can be used by **registered practitioners** to sponsor their support staff to work on their behalf. For step-by-step instructions, see [Patent Center Sponsorship Tool Guide](#).

Sponsorship Tool in Patent Center

After signing in to Patent Center, you can access the sponsorship tool under the **Manage > Sponsor Users** menu option.

### DOCX Training

Learn how to file and retrieve DOCX files in Patent Center, EFS-Web, and PAIR. Each session takes about an hour and includes time for questions.

Visit our [Patents DOCX filing Events page](#) to register for the training sessions

[Patent Electronic Business Center](#)

Call Toll-Free 866-217-9197 or local 571-272-4100

Email [ebc@uspto.gov](mailto:ebc@uspto.gov)

### EFS-Web for Unregistered eFilers

Basic initial filing of new patent applications

Note: Unregistered eFilers are not permitted to file follow-on submissions/fees in EFS-Web. eFilers are advised to pay fees online as part of the initial application submission or use an [alternative filing method](#) to pay fees on the same day to avoid a late surcharge.

### EFS-Web Contingency

Basic initial filing of new patent applications when the primary portal to EFS-Web has an unscheduled outage.

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### Patent Center

Patent Center is the new tool for electronic filing and management of patent applications, and is available for all users. A Training mode is available to practice filing. Please visit the [Patent Center Information](#) page for more information.

Open Patent Center



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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.



John E. Schneider, Administrative Patent Judge

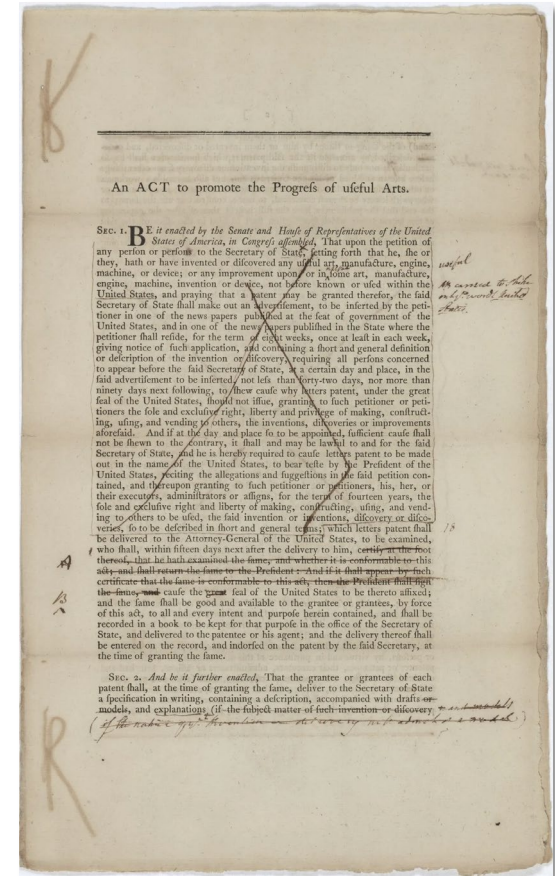


# IP History: Patent Models

# Patent Models

## Patent Act of 1790:

"[D]eliver to the Secretary of State a specification in writing, containing a description, accompanied with drafts or models, and explanations and **models (if the nature of the invention or discovery will admit of a model)** of the thing or things, by him or them invented or discovered."



# Patent Models

- 📖 Models were limited in size
  - 12x12x12
  - Sometimes multiple models were submitted
- 📖 Requirement maintained until 1880
  - Congress dropped the requirement in 1870
- 📖 Some inventors still submitted models to show reduction to practice

# Patent Models

Models were on  
public display

Model Room 1860s







# Patent Models

Many Models were  
destroyed in the  
Patent Office fires  
in 1836 and 1877

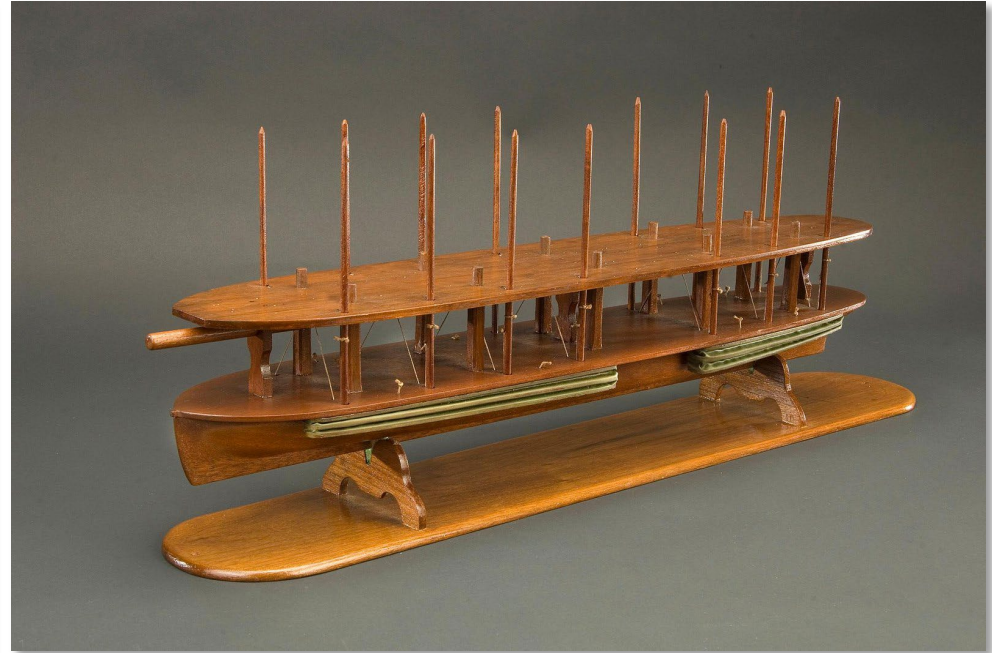
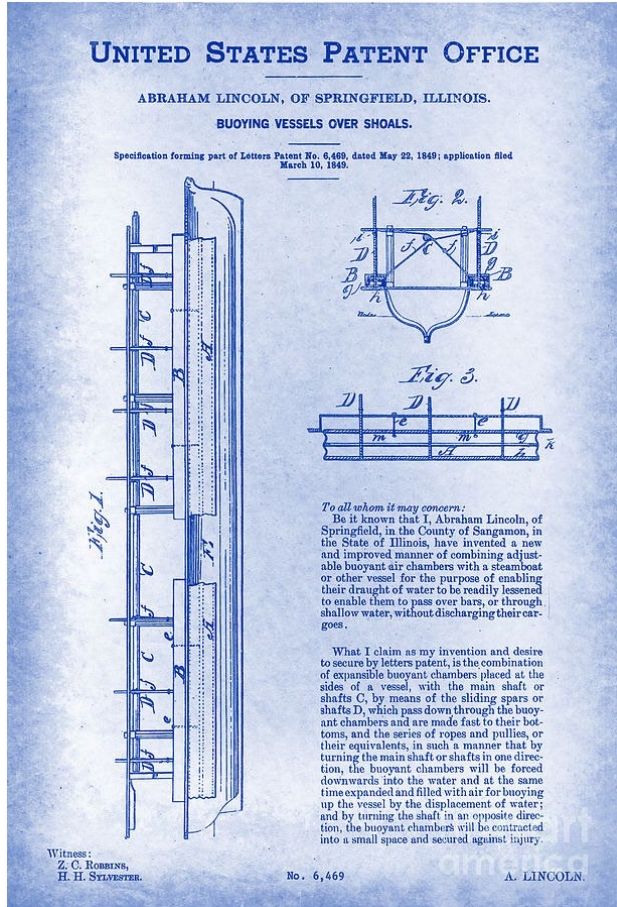
75,000 were  
destroyed in 1877



# Patent Models

-  Patent Office maintained the collection until 1925
-  Smithsonian took 10,000
-  Remainder sold off
  - Hagley Museum
  - Franklin Institute
  - Private collectors

# President Lincoln's Patent



US 6,469 issued May 22, 1849









# Cotton Picker

UNITED STATES PATENT OFFICE.

DAVID RAWL, OF SHELLEBURG, SOUTH CAROLINA.

COTTON-PICKER.

SPECIFICATION forming part of Letters Patent No. 266,884, dated October 31, 1882.

To all whom it may concern:

Be it known that I, David Rawl, of Shelburg, in the State of South Carolina, have invented a certain new and useful Cotton-Picker, of which I have hereunto annexed a full, true, and exact description, in the presence of the witnesses, and the nature of which is fully set forth in the following claims, in which I particularly point out that which I claim as my invention.

My object, in the present invention, is to improve upon the various devices for picking cotton, and to combine the same in a simple, efficient, and durable machine, which is capable of picking cotton in a more rapid and economical manner than any other device of the kind heretofore known.

It is known that the various devices for picking cotton are of various kinds, and are generally of a heavy and complicated nature, and are not adapted for use in the field, or for use by a single person.

The present invention is a simple and efficient device, which is adapted for use in the field, and for use by a single person.

The device consists of a frame, which is supported by four legs, and is provided with a hopper for the cotton, and a series of rollers and gears, which are adapted for picking the cotton.

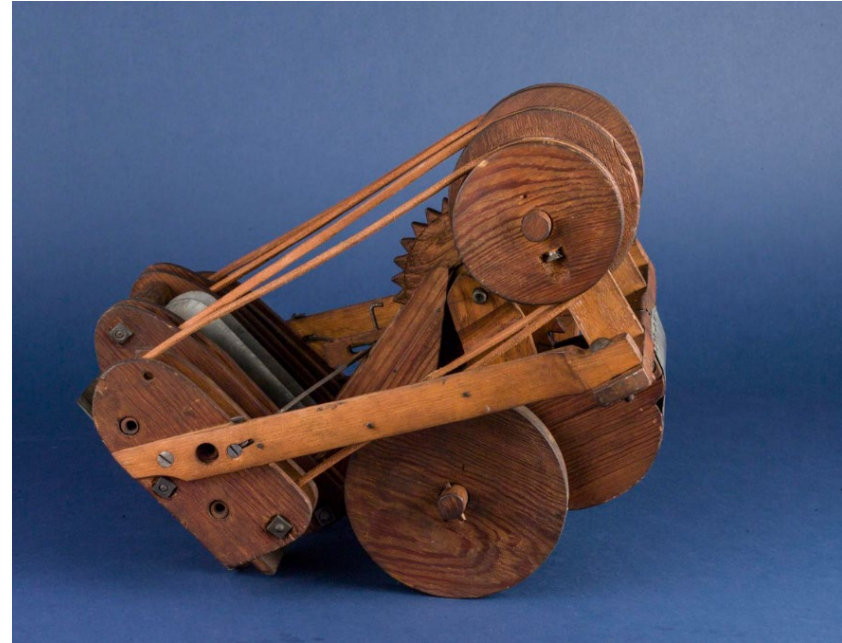
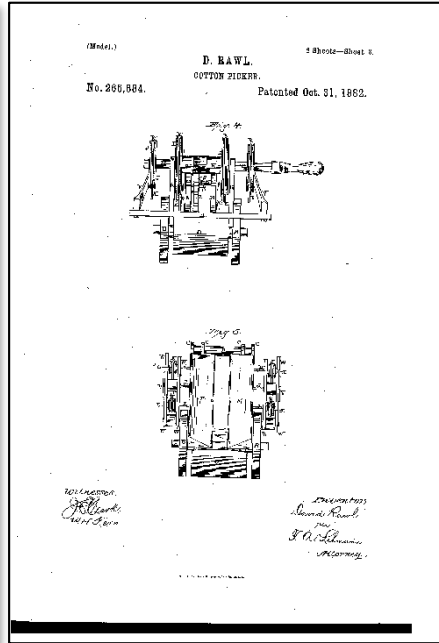
The rollers are arranged in a row, and are adapted to pick the cotton as it passes between them.

The gears are adapted to rotate the rollers, and are driven by a hand crank, which is provided with a handle.

The device is adapted to pick cotton in a more rapid and economical manner than any other device of the kind heretofore known.

The device is simple and efficient, and is adapted for use in the field, and for use by a single person.

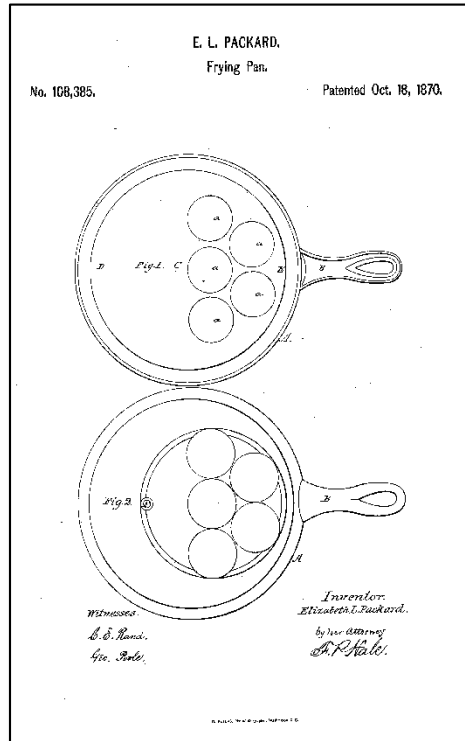
The device is a new and useful invention, and is adapted to pick cotton in a more rapid and economical manner than any other device of the kind heretofore known.



US 266,884 issued 1882



# Frying Pan



US 108,385 Issued 1870



# Question/Comment Submission

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



# Next Inventor Hour webinar



- **July 28, 2022**, at noon to 1 p.m. ET
- Topics, include: Meet Inventor Stephen Key, What is Prior Art?, Motions to Amend



# Future Inventor Hour webinars

- **July 28, 2022**, at noon to 1 p.m. ET
- August 10-12, Invention-Con
- September 22



