

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Patent Trial and Appeal Board Inventor Hour webinar: **Episode 4**

Tawen Chang, Administrative Patent Judge

Ryan Flax, Administrative Patent Judge

Steven Fulk, Supervisory Patent Attorney

Janet Gongola, Vice Chief Judge

Ulrike Jenks, Administrative Patent Judge

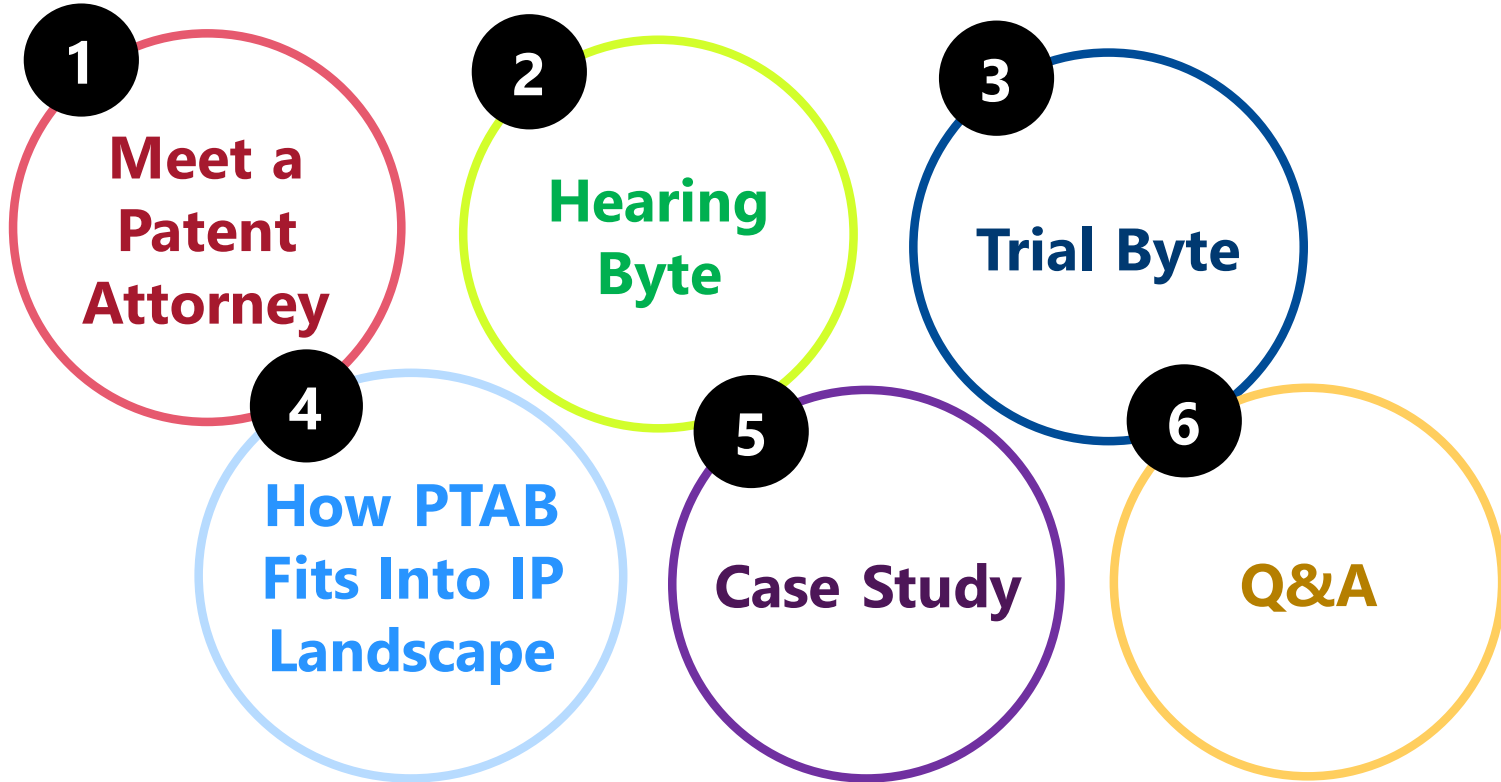
Meredith Petravick, Administrative Patent Judge

January 27, 2022

UNITED STATES
PATENT AND TRADEMARK OFFICE



Today's agenda



Question/Comment Submission

- To send in questions or comments about the presentation, please email:
 - PTABInventorHour@uspto.gov



Meet a Patent Attorney: **Supervisory Patent Attorney Steven Fulk**



Steven Fulk
Supervisory Patent Attorney



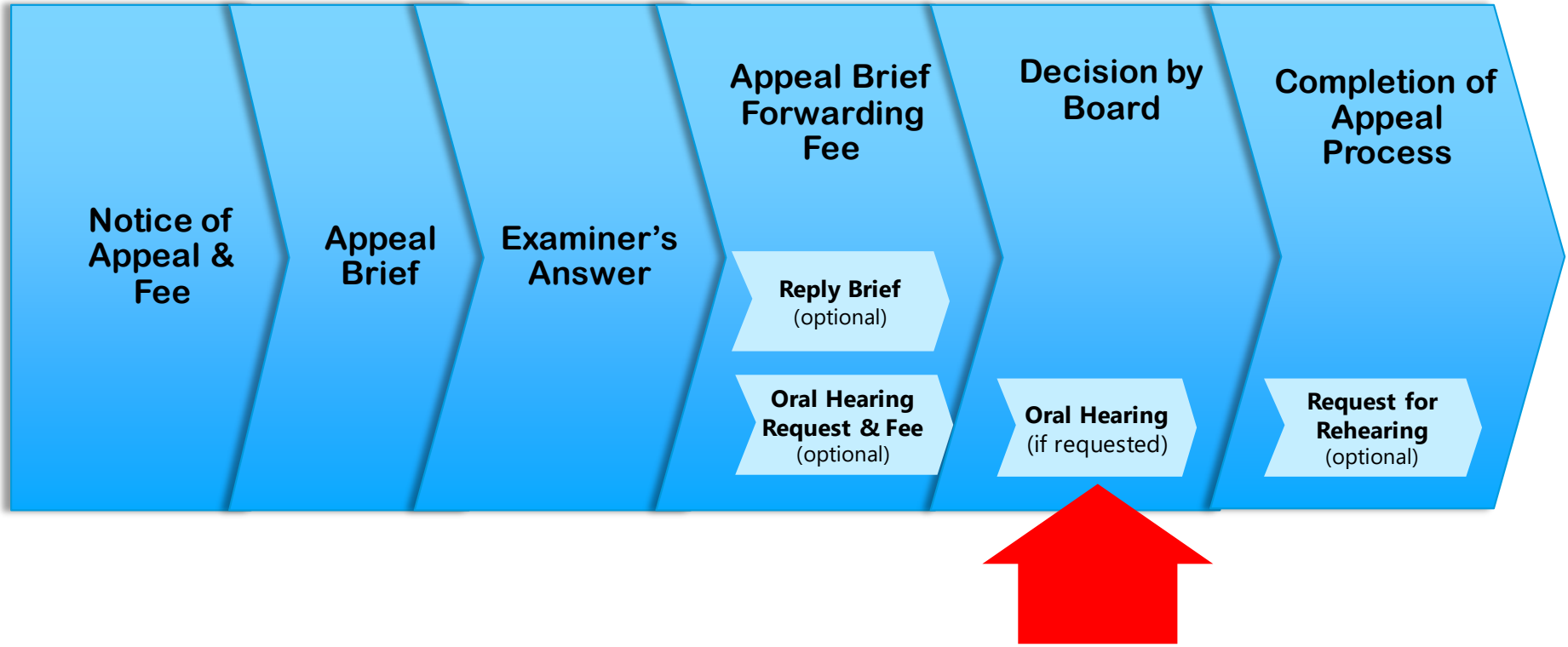
Tawen Chang, Administrative Patent Judge



Hearing Byte:




Ex Parte Appeal Hearings

Hearings: *Ex Parte* Appeals



Hearings: *Ex Parte* Appeals



-  What to **expect**
-  What to **present**
-  How to **prepare**

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Finding a Patent Practitioner



<https://www.uspto.gov/learning-and-resources/patent-and-trademark-practitioners/finding-patent-practitioner>

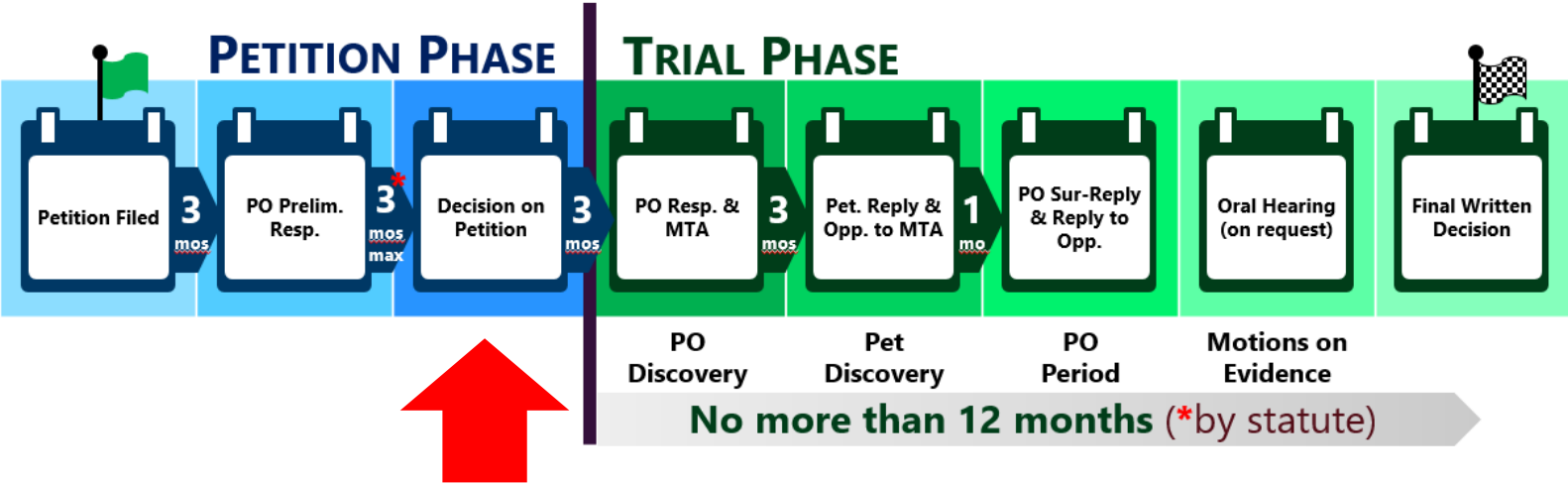
- The USPTO Office of Enrollment and Discipline maintains a roll of active patent practitioners who are eligible to represent others before the USPTO
- Only registered patent attorneys and agents, and individuals given limited recognition, can represent applicants before the USPTO

Meredith Petravick, Administrative Patent Judge





Trial Byte: **Institution Decision**


PTAB Institution Decision



Overview of Institution Decision

-  The Board issues a **written decision** indicating whether it will start an AIA trial
-  Petitioner must demonstrate a **reasonable likelihood** that it would prevail with respect to at least 1 of the claims challenged in IPR petition (PGR standard is *more likely than not*)

Overview of Institution Decision

 If the Board institutes a trial, it will institute on **all claims and challenges** raised in the petition

Overview of Institution Decision





Based on the state of the record at institution, the Board will generally provide parties **guidance about the Board's preliminary views** on the parties' competing arguments



This guidance allows parties to **focus their arguments** and may inform other options such as settlement, claim amendment, claim disclaimer, or request for adverse judgment on some claims or grounds

Overview of Institution Decision

-  Party dissatisfied with the Board's institution decision **may request rehearing** as to points the Board overlooked or misapprehended
-  Institution decisions are **generally not appealable**

Overview of Institution Decision



The Board will enter a **Scheduling Order** concurrent with a decision to institute a trial

- Scheduling Order sets due dates for the trial to ensure completion within one year of institution
- sample Scheduling Order is available in the Trial Practice Guide (*available at www.uspto.gov/TrialPracticeGuideConsolidated*)

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Inventors Digest

<https://www.inventorsdigest.com>



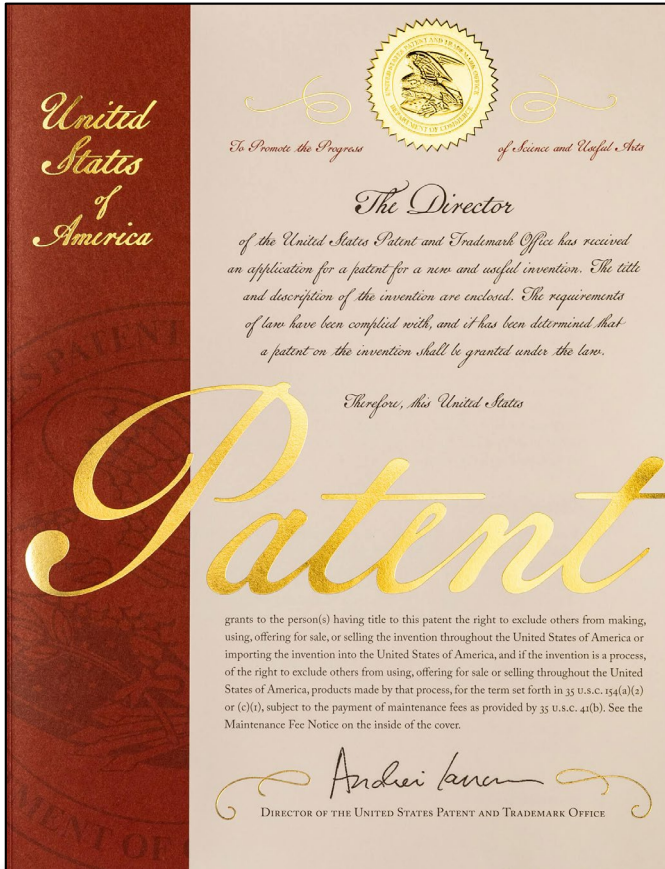
- Monthly issues, each featuring articles about USPTO
- Monthly articles about PTAB
- Free online



Ryan H. Flax, Administrative Patent Judge



How PTAB Fits Into IP Landscape: District Court / PTAB / ITC



Infringed?

Invalid?

Forums for Challenging Patents

**U.S.
District
Courts**

USPTO

ITC

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Forums for Challenging Patents

**U.S.
District
Courts**

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U.S. District Courts



Infringement
defendants

Declaratory
judgment
plaintiffs

U.S. District Courts: Invalidation Grounds

Patent
eligibility

Obviousness

Enablement

Anticipation

Indefiniteness

Derivation

On-Sale
Bar

Written
description

U.S. District Courts: Invalidity Grounds

Patent
eligibility

On-Sale
Bar

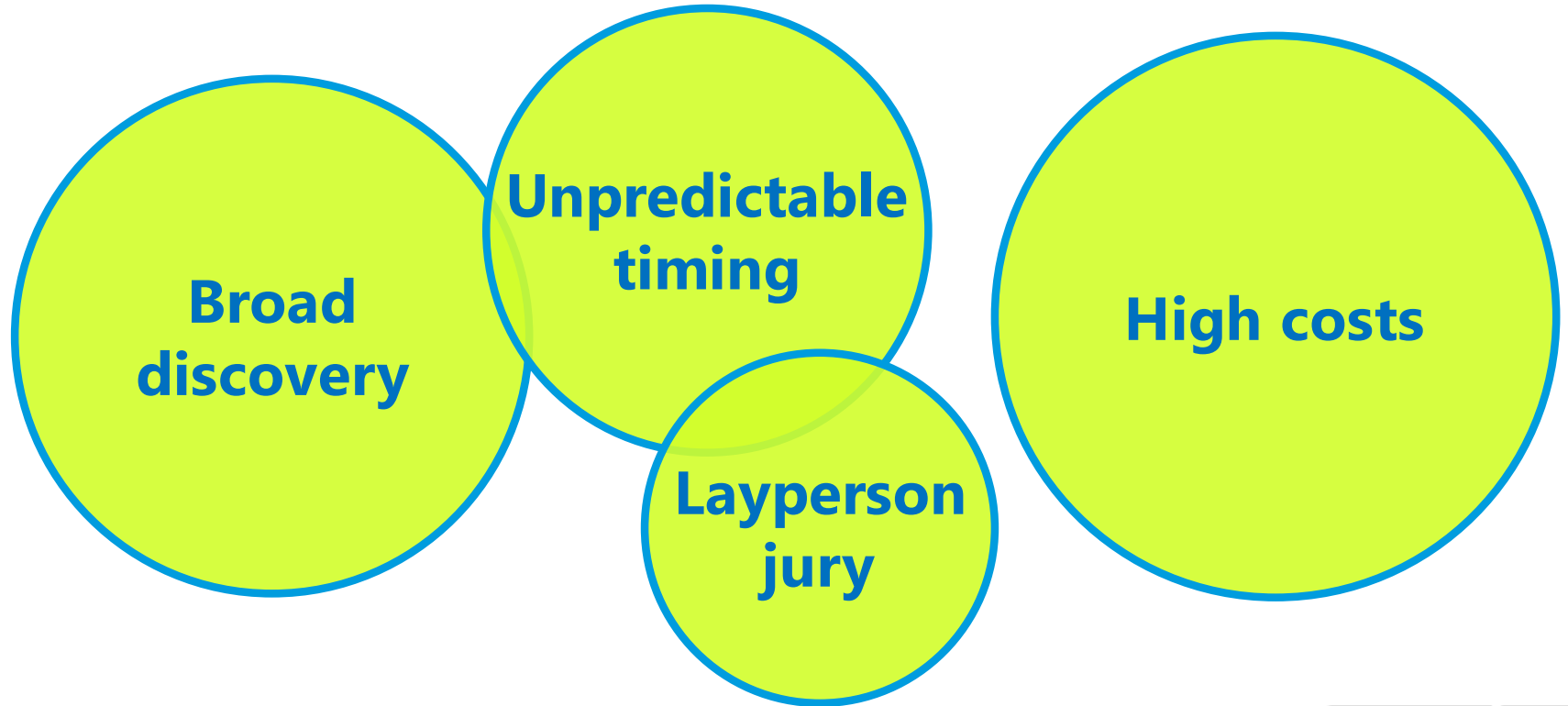
**CLEAR AND
CONVINCING BURDEN
OF PROOF**

Enablement

Definiteness

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U.S. District Courts: Issues of Note



U.S. District Courts: Invalidation grounds

**Determination
on patent
validity**

**Appeal
to Federal
Circuit**

**Petition
to Supreme
Court**

Forums for Challenging Patents

U.S.
District
Courts

USPTO

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Patent Trial and Appeal Board



Inter Partes
Review

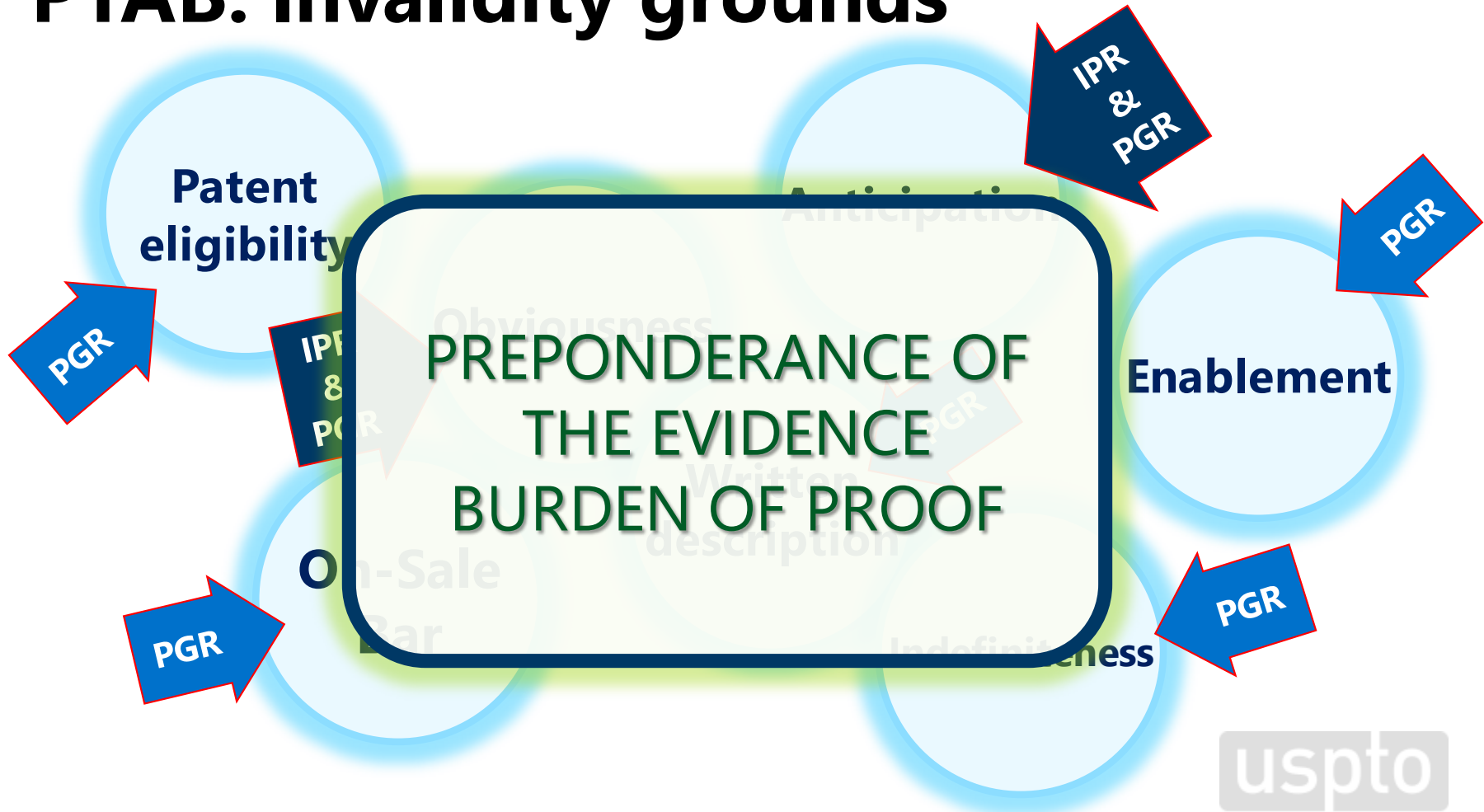
Post-Grant
Review

Derivation
Proceeding

PTAB: Invalidation grounds



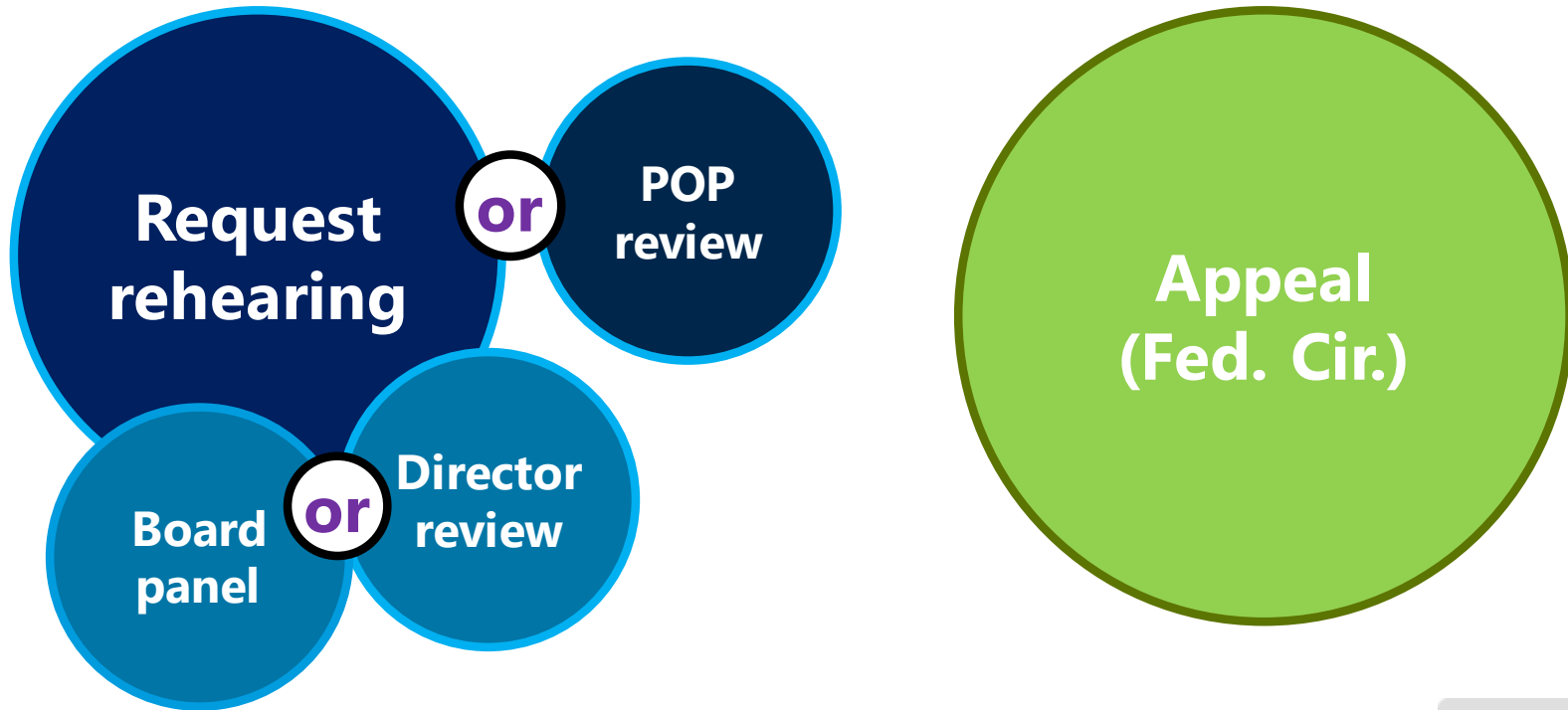
PTAB: Invalidity grounds



PTAB: Issues of note



Patent Trial and Appeal Board: After a Final Written Decision



Forums for Challenging Patents

U.S.
District
Courts

USPTO

ITC

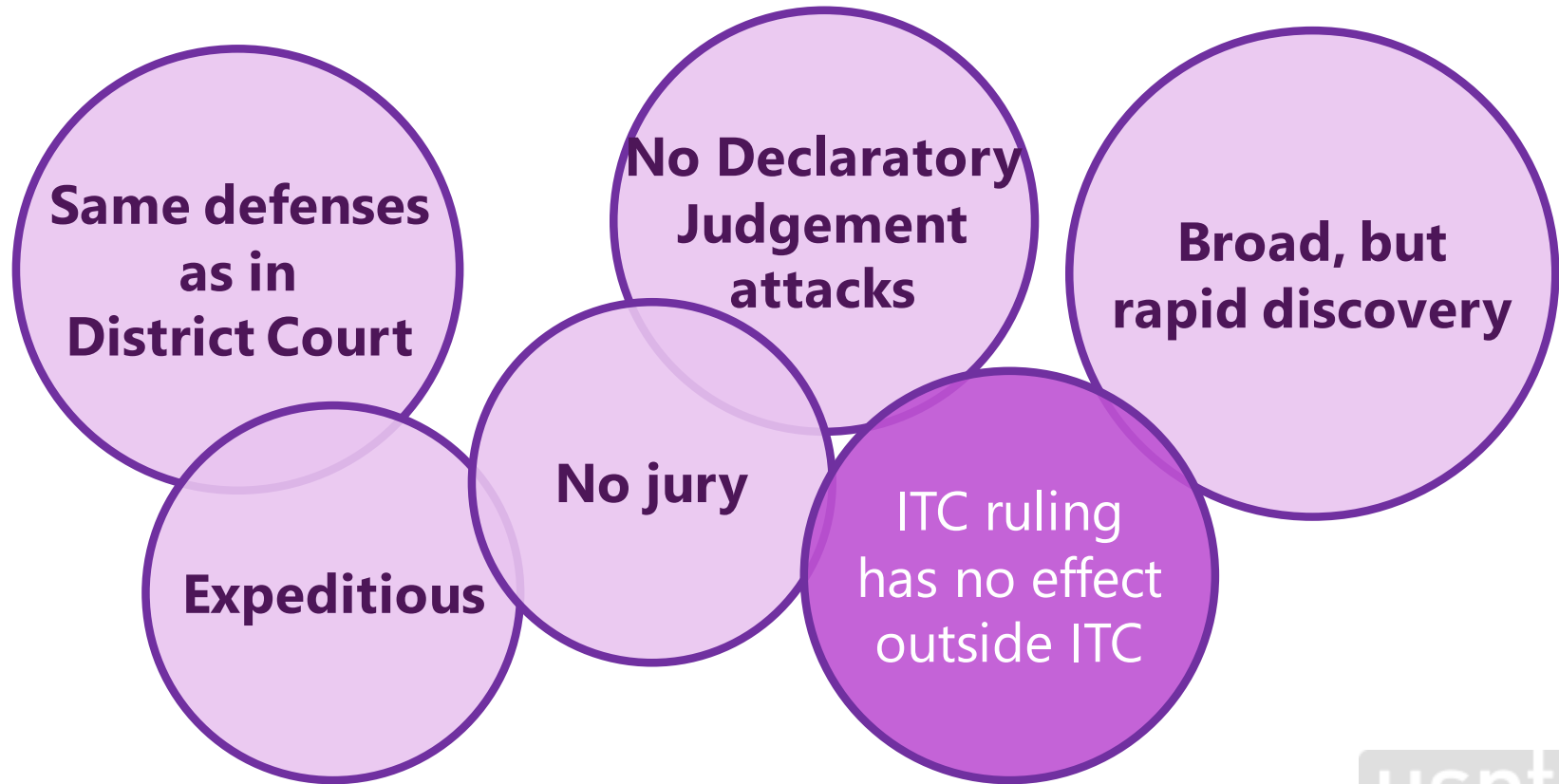
International Trade Commission

**Section 337
investigations**



uspto

International Trade Commission



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Driving innovation

Audrey Sherman, a leading inventor of adhesives at 3M, shows what's possible through persistence and collaboration. [FULL STORY](#)

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<p>Get started</p> <p>Learn about types of intellectual property (IP) and how to protect your idea or product.</p> <ul style="list-style-type: none"> > Types of IP protection > Attend a free training > Patents basics > Trademark basics 	<p>Before you apply</p> <p>Search existing patents and trademarks to find out if your idea is unique. If it is, create an account.</p> <ul style="list-style-type: none"> > Search patents > Search trademarks > Create an account to apply 	<p>Get help to apply</p> <p>Get yourself up for success by learning via USPTO's free resources and find expert help.</p> <ul style="list-style-type: none"> > Find resources near you > Watch our videos > Find a patent attorney > Do I need a trademark attorney? 	<p>Apply for IP rights</p> <p>Submit your application for a patent or trademark. See if you qualify for reduced patent fees.</p> <ul style="list-style-type: none"> > Apply for a patent > Apply for a trademark > Costs to file > Reduced patent fees
<p>After you apply</p> <p>As your patent or trademark is examined you may need to take additional steps.</p> <ul style="list-style-type: none"> > Check application status > Respond to a Patent decision > Prepare for a patent interview > Respond to a Trademark decision 	<p>Appeal or fix an issue</p> <p>An applicant may petition a procedural rule to issue, or appeal a patent rejection or trademark refusal.</p> <ul style="list-style-type: none"> > Learn about patent petitions > Learn about patent appeals > Learn about trademark petitions > Learn about trademark appeals 	<p>Entrepreneur resources</p> <p>Learn about small business resources at the USPTO and other federal agencies.</p> <ul style="list-style-type: none"> > Startup resources > License or sell your IP > Change patent owner > Change trademark's owner > Other federal resources 	<p>Protect yourself</p> <p>Don't be misled by false claims, scams, or companies offering services for unusually low prices.</p> <ul style="list-style-type: none"> > Know patent scams > Know trademark scams > Prevent or report a scam






Ulrike Jenks, Administrative Patent Judge

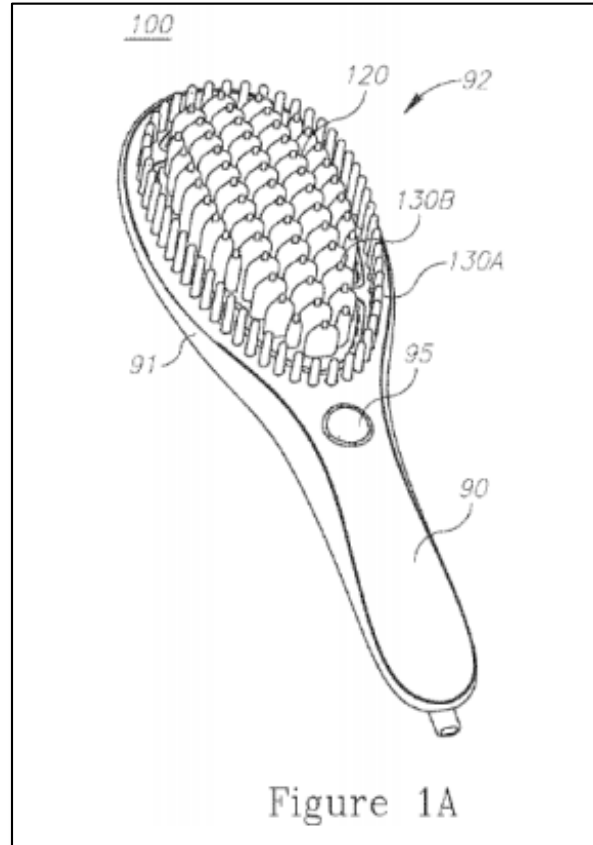


Inventor Case Study: **Guy A. Shaked Investments LLC**

Inventor Case Study: Goals

-  Provide **insight** into patent prosecution
-  Show how the ***inter partes* review (IPR) framework** requires case-specific and fact-specific inquiry
-  Answer questions regarding PTAB's current **approach**

U.S. Patent No. 9,578,943 (filed as U.S. App. No. 14/975,783)



Claim 1 as filed

1. A brush comprising:
 - a plurality of heating elements protruding from a face of the brush, the heating elements dispersed on at least a part of the brush's face at a specified density; and
 - a plurality of spacers arranged to maintain a specified distance between protruding ends of the heating elements and a scalp of a head that is being brushed, the spacers dispersed on the at least part of the brush's face at a specified density that assures maintaining the specified distance with respect to a resilience of the spacers.

Claim 1 as allowed by the Examiner

1. A hairbrush, comprising:
a heating plate extending over a face of the hairbrush;
a plurality of heating elements thermally coupled to the heating plate and protruding from only the face of the hairbrush, the plurality of heating elements defining a hair treating area disposed on at least a part of the hairbrush's face at a specified density, the plurality of heating elements arranged in a plurality of lengthwise rows, each of the plurality of lengthwise rows including a number of the plurality of heating elements;
wherein, for each of the plurality of lengthwise rows, the heating elements thereof are offset relative to the heating elements in an adjacent one of the plurality of lengthwise rows;
a plurality of heat insulating spacers projecting outwardly from at least some of the plurality of heating elements, thereby providing a space between the plurality of heating elements and a user's scalp during use; and
a plurality of heat insulating elongate peripheral spacers disposed at least around a portion of the hair treating area of the hairbrush.

Ontel Prods. Corp. v. Guy A. Shaked Invs. LTD., IPR2020-01703, Paper 12 (Apr. 13, 2021)



Sept. 28, 2020: Ontel filed an IPR petition



Jan. 18, 2021: Shaked filed a Preliminary Patent Owner Response



Apr. 13, 2021: PTAB *denied institution*

Takeaways



Consideration of relevant prior art during examination and **appropriate claim amendments** help limit the universe of relevant prior art for post-grant challenges, thereby limiting opportunities for successful challenges



A **well-drafted preliminary response** may result in a decision not to institute



Consider how **limitations** in a claim may make the claim less susceptible to challenge

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Next Inventor Hour webinar



- **February 24, 2022**, at noon to 1 p.m. ET
 - Meet a judge
 - How PTAB fits in: Appeals from PTAB
 - Inventor case study
 - Appeal byte

