

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Patent Trial and Appeal Board Boardside Chat:

Behind the scenes at the PTAB with the Board
Operations Division

Troy Tyler, Board Executive

Kulunie Cannon, Deputy Chief Clerk of the Board

Andrew Kellogg, Supervisory Paralegal Specialist

Breck Reitter, Supervisory Paralegal Specialist

David Schmerfeld, Paneling Management Program Specialist

March 17, 2022

UNITED STATES
PATENT AND TRADEMARK OFFICE



Question/comment submission

- To send in questions or comments during the webinar, please email:
 - PTABBoardsideChat@uspto.gov

Agenda

- Part 1: Overview of the Board Operations Division
- Part 2: Functions to support PTAB decisions

Troy Tyler
Board Executive

Part 1: Overview of the Board Operations Division (who we are)

Board Operations Division

- **Board Executive – Troy Tyler**
 - Case management branch
 - IT systems & services branch
 - Administrative branch
- **Case management branch – Chief Clerk**
 - Paneling operations
 - Hearing operations
 - Paralegal operations
- **Administrative branch**
 - Data analysis and process improvement
 - Administrative management

Case management

- Paralegal Operations
 - 51 paralegals who are assigned work on either appeals or AIA trials
- Paneling Operations
 - 5 management program specialists
- Hearing Operations
 - 3 hearings support staff

IT systems & services branch

- 7 IT support specialists and staff
- IT customer service (support all PTAB Users for any use of IT systems including user account management, case information issues, and mailing issues)
- Product development and PTAB systems testing
- Maintain PTAB website

PTAB end to end

Trials

Derivation proceeding

Inter partes review

Patent Trial and Appeal Board End to End (PTAB E2E)

Post grant review

Transitional program for covered business method patents

Interference

PTAB E2E will be impacted on Saturday, March 5 between 12:01 a.m. to 5 a.m. ET due to scheduled maintenance (payment processing system unavailable).

PTAB E2E will be impacted on Saturday, March 19 from 12:01 a.m. to 5 a.m. ET due to scheduled maintenance (payment processing system unavailable).

Parties must either pay fees for petitions outside of this scheduled maintenance time or pay early. Those with deadlines for petition filing or other associated documents to a pending AIA case, must use an [alternate filing method](#).

Questions? Contact PTAB 8:30 a.m. to 5 p.m. ET at 571-272-9797 weekdays or email Trials@uspto.gov .

Patent Trial and Appeal Board End to End

PTAB E2E

File and search IPR, CBM, PGR and DER AIA review cases


- [How to login to PTAB E2E](#)
 - Reminder: you must change your password every 180 days.
- **To search without creating a user id and password:**
 1. Fill out at least one of the four **Search PTAB** fields on the [login page](#).
 2. Answer the CAPTCHA
 3. Click on Search

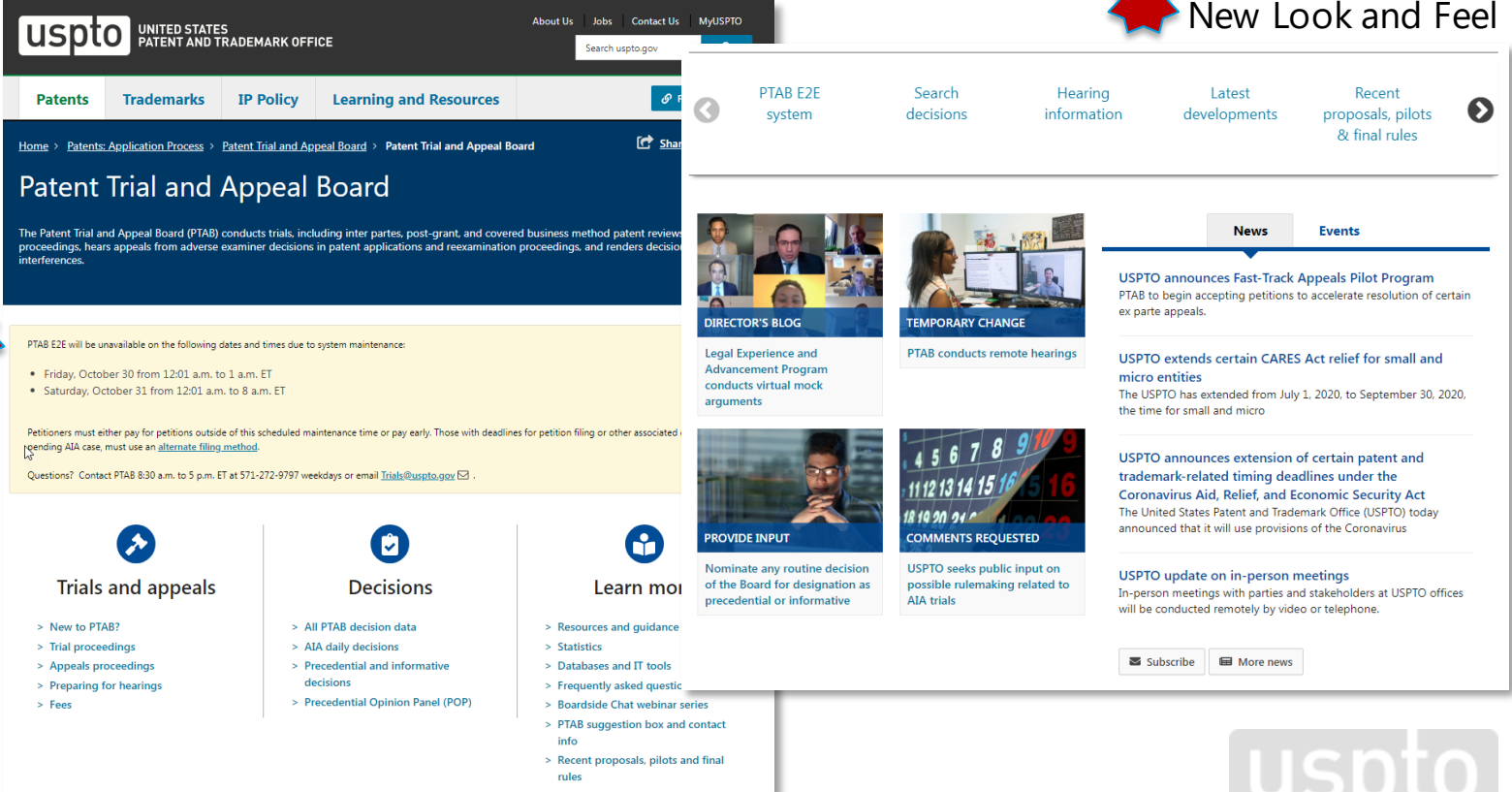
Technical issues

1. Only PDF and MPEG format files (MPEG, MPG, MP1, MP2, MP3, MP4, M1A, M2A, M1V, MPA, MPV) may be uploaded in PTAB E2E. Password-protected files are not accepted. Users are encouraged to convert other file types such as Microsoft Word documents, into text-searchable PDF files, instead of printing and scanning to make flat PDF files.

uspto

PTAB website enhancements

 New Look and Feel



The screenshot displays the USPTO Patent Trial and Appeal Board (PTAB) website. At the top, the USPTO logo and navigation links (About Us, Jobs, Contact Us, MyUSPTO) are visible. A search bar is located below the navigation. The main navigation menu includes Patents, Trademarks, IP Policy, and Learning and Resources. The page title is "Patent Trial and Appeal Board".

A navigation bar at the top right features links for "PTAB E2E system", "Search decisions", "Hearing information", "Latest developments", and "Recent proposals, pilots & final rules".

The main content area is divided into several sections:

- News:**
 - USPTO announces Fast-Track Appeals Pilot Program:** PTAB to begin accepting petitions to accelerate resolution of certain ex parte appeals.
 - USPTO extends certain CARES Act relief for small and micro entities:** The USPTO has extended from July 1, 2020, to September 30, 2020, the time for small and micro.
 - USPTO announces extension of certain patent and trademark-related timing deadlines under the Coronavirus Aid, Relief, and Economic Security Act:** The United States Patent and Trademark Office (USPTO) today announced that it will use provisions of the Coronavirus.
 - USPTO update on in-person meetings:** In-person meetings with parties and stakeholders at USPTO offices will be conducted remotely by video or telephone.
- Events:**
 - DIRECTOR'S BLOG:** Legal Experience and Advancement Program conducts virtual mock arguments.
 - TEMPORARY CHANGE:** PTAB conducts remote hearings.
 - PROVIDE INPUT:** Nominate any routine decision of the Board for designation as precedential or informative.
 - COMMENTS REQUESTED:** USPTO seeks public input on possible rulemaking related to AIA trials.
- Notifications:**
 - PTAB E2E will be unavailable on the following dates and times due to system maintenance:
 - Friday, October 30 from 12:01 a.m. to 1 a.m. ET
 - Saturday, October 31 from 12:01 a.m. to 8 a.m. ET
 - Petitioners must either pay for petitions outside of this scheduled maintenance time or pay early. Those with deadlines for petition filing or other associated pending AIA case, must use an [alternate filing method](#).
 - Questions? Contact PTAB 8:30 a.m. to 5 p.m. ET at 571-272-9797 weekdays or email Trials@uspto.gov.
- Trials and appeals:**
 - > New to PTAB?
 - > Trial proceedings
 - > Appeals proceedings
 - > Preparing for hearings
 - > Fees
- Decisions:**
 - > All PTAB decision data
 - > AIA daily decisions
 - > Precedential and informative decisions
 - > Precedential Opinion Panel (POP)
- Learn more:**
 - > Resources and guidance
 - > Statistics
 - > Databases and IT tools
 - > Frequently asked questions
 - > Boardside Chat webinar series
 - > PTAB suggestion box and contact info
 - > Recent proposals, pilots and final rules

At the bottom right, there are "Subscribe" and "More news" buttons, and the USPTO logo.

 Notifications

Administrative management

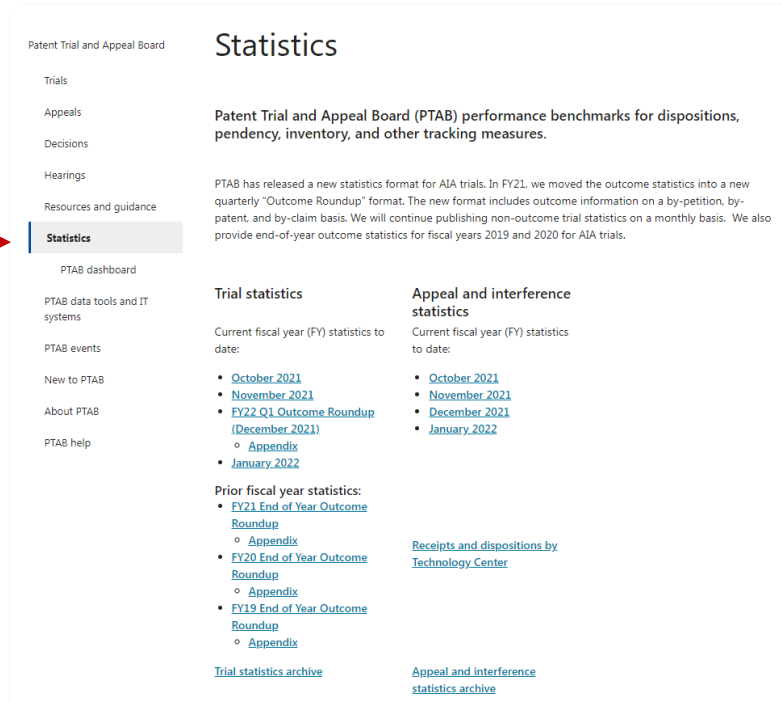
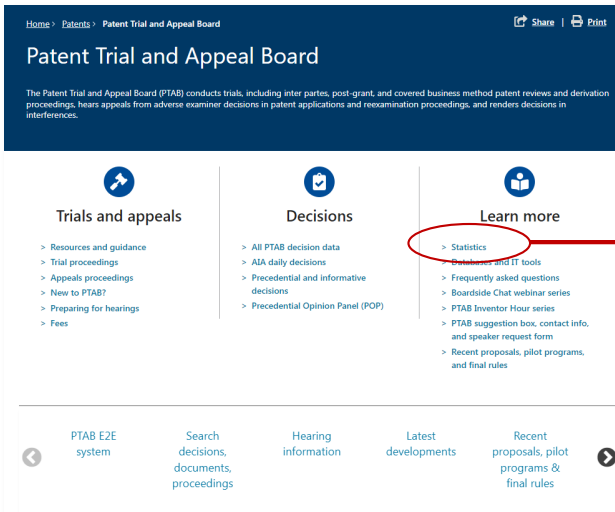
- 9 staff
- Functions include:
 - Acquisition & Budget
 - Human Resources
 - Information Technology
 - Space Management
 - Time and Attendance
 - Training
 - Travel
 - Special Projects

Data analysis and process improvement

- 2 statisticians
- 4 data analysts
- Analysts and statisticians routinely engage in producing and maintaining statistics and reports on Board operations

PTAB statistics

- Statistics are shared monthly with the public on PTAB webpages
- <https://www.uspto.gov/patents/ptab/statistics>



Reports

- Collect, explore, and present large amounts of data in an easily comprehensible format to the public

Home > Patents > Patent Trial and Appeal Board

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
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 - > PTAB Inventor Hour series
 - > PTAB suggestion box, contact info, and speaker request form
 - > Recent proposals, pilot programs, and final rules

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

Special reports

Fiscal Year 2021

- [Orange Book/biologics study update through June 2021](#) (Aug. 2021) – an updated report on AIA trials involving petitions challenging Orange Book-listed patents and biologic patents. Study methodology for identifying Orange book-listed and biologic patents is provided in the Fiscal Year 2019 Orange Book/biologics study posted below. Study methodology used to create the statistics are provided in this [presentation](#).
 - Orange Book petitions ([csv](#) (all), [csv](#) (status))
 - Orange Book patents ([csv](#))
 - Biologic petitions ([csv](#) (all), [csv](#) (status))
 - Biologic patents ([csv](#))
 - Data dictionary ([pdf](#))
- [Multiple Petitions Study](#) (updated December 2020): a report on multiple petitions filed in AIA proceedings, including serial and parallel petitions

Fiscal Year 2020

- [Motion to Amend Study, Installment 6 through March 31, 2020](#) (updated July 2020) – a report on the outcomes of pre-pilot motions to amend in AIA trials and some limited data for motions to amend filed under the Office's pilot program
 - [Data for 504 completed trials with a pre-pilot MTA](#) (July 2020) – a report on the data for the 504 completed trials with a pre-pilot MTA
- [Trial statistics by patent and by claim](#) (June 2020) - a report providing various AIA trial statistics, including results by petition, by patent, and by claim; also includes an update on multiple petitions.

Fiscal Year 2019

- [Orange Book/biologics study](#) (July 2019) - a report on AIA trials involving petitions challenging Orange Book listed patents and biologic patents. The report also includes a study on district court pharmaceutical litigation. Below are the individual data files in .csv format for the Orange Book/biologics study and the data dictionaries, which provides names, definitions, and attributes for the data in the files, in .pdf:
 - Orange Book petitions ([csv](#), [pdf](#))
 - Biologic petitions ([csv](#), [pdf](#))
 - Litigation data for patents ([csv](#), [pdf](#))
 - Litigation data for petitions ([csv](#), [pdf](#))
 - [Parallel proceedings study](#) (April 2019) - a report on interaction between parallel proceedings at the USPTO (e.g., AIA proceedings, reexam, and re-issue) involving issued patents

Fiscal Year 2018

- [Expanded panels study](#) (March 2018) - a report on panel expansion in AIA trials
- [Orange Book-listed patent study](#) (March 2018) - a report on FDA-approved drug patents challenged in AIA trials
- [Multiple petition study](#) (October 2017) - a report on multiple petitions filed in AIA proceedings

Special reports archive

Contact

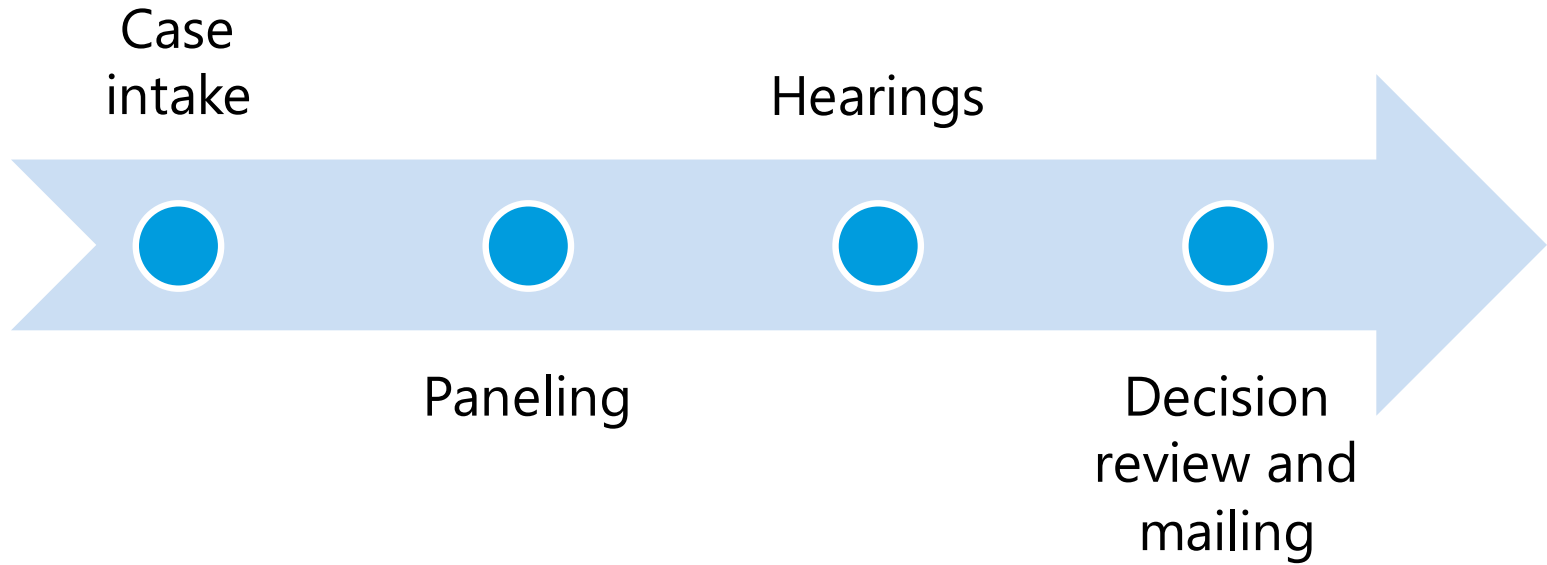
Email questions about PTAB statistics to [PTAB_Statistics_Questions](#)

Question/comment submission

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 - PTABBoardsideChat@uspto.gov

Part 2: Functions to support PTAB decisions (what we do)

Case processing



Breck Reitter & Andrew Kellogg
Supervisory Paralegal Specialists

Case intake

Appeal intake

- Upon receipt of an appeal, the record is reviewed to ensure:
 - No RCE, express abandonment, or request to withdraw appeal present
 - Appeal forwarding fee is paid
 - Any request for oral hearing is timely (filed with or before reply brief) and fee paid
 - No undecided petitions that affect the appeal are present
 - Any after final amendments have been acted upon
 - Any new grounds of rejection in the answer affecting all claims have been addressed in a reply brief

Appeal intake (cont.)

- If there are no issues in the record:
 - Docketing notice is issued to appellant
 - PDF file of appeal is created for judge to use
 - Appeal moves on to paneling team
- If there are issues in the record, the appeal will be dismissed or remanded, as appropriate

Designation as special

- If the underlying application was designated as special, then the appeal automatically will be designated as special
- Appeals designated as special are advanced out of turn for decision
- <https://www.uspto.gov/web/offices/pac/mpep/s708.html>

Fast-Track Appeal Pilot Program

- An appellant may file a request for expedited review under the Fast-Track Appeal (FTA) Pilot Program
- Upon receipt of a request for expedited review, a paralegal will review the record to confirm that the eligibility criteria is met:
 - The appeal is docketed at the Board and the petition fee is paid
 - The application has not already been made special
 - The petition is filled out correctly
- Average time to decide FTA petition is 2.6 days and average time to appeal decision is 2.9 months from date FTA petition is approved (6 month goal)
- <https://www.uspto.gov/patents/ptab/fast-track-appeals-pilot-program>



AIA trial petition intake

- Upon receipt of an AIA trial petition, a paralegal reviews the record to ensure:
 - Petition fee has been paid
 - Petition is compliant with legal requirements
 - Real party in interest
 - Related matters
 - Certification of word count of the petition
 - Challenged claims and statutory grounds and evidence used in challenge
 - Evidence entered as exhibits

AlA trial petition intake (cont.)

- If there are no defects:
 - Accord the filing date to petition
 - Send out notice of filing date accorded
 - Petition moves on to paneling team
- If there are **minor** defects:
 - Accord the filing date to petition
 - Identify defects in the notice
 - Give petitioner five business days to correct petition
 - After correction, issue a notice of accepting corrected petition

AlA trial petition intake (cont.)

- If **major** defects exist that threaten the according of the filing date (rare):
 - Notify supervisory paralegal
 - Contact petitioner to resolve defect and preserve filing date
 - Judge may be consulted
- Trial Practice Guide:
 - <https://www.uspto.gov/TrialPracticeGuideConsolidated>

Question/comment submission

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PTAB appeal brief tool



- Available for independent inventors looking to appeal a patent examiner's rejection without the assistance of an attorney
- <https://www.uspto.gov/patents/patent-trial-and-appeal-board/resources/preparing-ex-parte-appeal-brief>
- Appeal brief tool includes:
 - A [Word document](#) template;
 - A [PDF](#) that provides general guidance and helpful examples; and
 - An [instructional video](#) on how to use these documents.

David Schmerfeld
Paneling Management Program Specialist

Paneling

Paneling

- “Paneling” describes the process by which judges are assigned to the panels that hear cases
- Per 35 U.S.C. § 6, the Director of the USPTO has the authority to designate the members of the panel. The Director has delegated this authority to the Chief Judge who has further delegated it to an administrative paneling team
- Standard Operating Procedure 1 describes the paneling process
 - Applies to all cases under PTAB’s jurisdiction
 - <https://www.uspto.gov/patents/ptab/procedures/revisions-standard-operating>

General paneling considerations

- Conflicts of interest
 - Summary of ethics rules
https://ogc.commerce.gov/sites/default/files/pto-summary_of_ethics_rules-2022.pdf.
- Technology
- Experience
- Related cases
- Judge workload

Appeals paneling

- *Ex parte* appeals assignment is available for all judges on the Board
- For judges who have an appeals docket, cases are automatically assigned on a regular, periodic basis
- Judges may request appeals be added to their docket

AIA trial paneling

- Some judges are assigned AIA trial proceedings on their docket taking into account, as feasible, factors including the expressed jurisdictional preference of each judge, overall docket composition of PTAB, and workload needs of PTAB
- In general, each month, all AIA trial proceedings which received a notice of filing date accorded in the previous month are assigned a panel
- Consideration given to number of writing assignments judges have in 3-month period
 - Decisions on institution
 - Final written decisions

Repaneling

- A case may need to be repaneled from a particular judge due to:
 - Recusal
 - Deadlines
 - Unavailability, e.g., due to situations such as approved leave, detail assignment, death, illness, reassignment, retirement, or departure from the agency
- Each judge is ultimately responsible for avoiding a conflict and requesting to be re-paneled when a conflict in a particular case arises

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LEAP



- [Legal Experience and Advancement Program \(LEAP\)](#)
- Designed to:
 - Aid in development of the next generation of patent practitioners
 - Encourage a diverse group of advocates to develop their skills before the Board
- To qualify, a patent agent or attorney must have:
 - Three or fewer substantive oral arguments in any federal tribunal, including PTAB

Kulunie Cannon
Deputy Chief Clerk of the Board

Hearings

New developments

- Video hearings are now available for all types of cases at PTAB, including *ex parte* appeals and reexaminations
- Video access to PTAB hearings for the public now available
 - Public may request to view a hearing by submitting a request to PTABHearings@USPTO.gov

Orders

- Hearing order (AIA) and notice of hearing (appeals)
 - Sent approximately 3 weeks before hearing
 - Outlines hearing information
 - Contains information about submitting demonstratives

Procedure for appeals

- Appellant can select a video or telephonic hearing upon receipt of the notice of hearing
- PTAB Hearings will provide WebEx connection information to appellant approximately one week before the hearing
- On the day of the hearing, PTAB Hearings will call each appellant when it is time to connect to the hearing
- PTAB will ensure the line is clear before each proceeding begins

Procedures for AIA trials

- Each party must contact PTAB Hearings five business days prior to the oral hearing date to receive video set-up information
- PTAB will provide WebEx connection information and conduct a test with parties
- On the day of the hearing, all parties are connected to the hearing 30 minutes prior to the designated start time
 - Counsel and judges are held in separate conferences for privacy reasons until proceedings begin

LEAP requests

- PTAB Hearings staff process LEAP requests, which are submitted to PTABHearings@uspto.gov five business days prior to the oral hearing date
- Upon approval, qualified LEAP practitioners are granted an additional 15 minutes of argument time
- Since the program was implemented in May 2020, 113 requests have been granted

Monitoring hearings

- PTAB closely monitors all hearings and troubleshoots technical issues as they arise
- If you experience any technical difficulty during your hearing, please let the panel know immediately or contact us at PTABHearings@uspto.gov
 - For example, if a party is experiencing poor video quality, the Board may provide alternate dial-in information

Remote hearings during pandemic

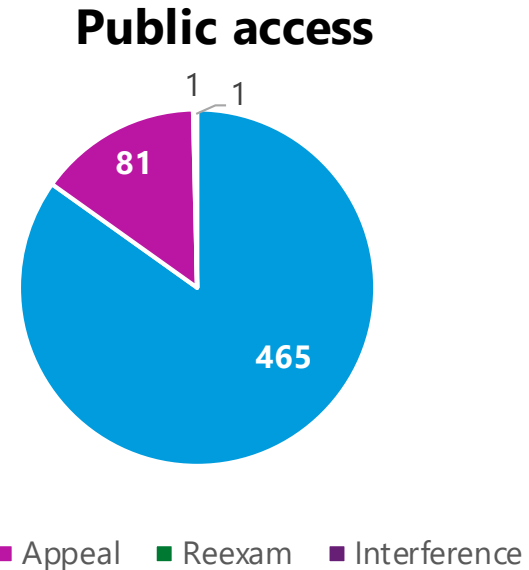
March 16, 2020 – February 28, 2022

- 100% of hearings conducted remotely
- On average, ~1130 hearings/year since March 2020
 - *Ex parte* appeal hearings = ~644/year
 - AIA trial hearings = ~467/year
 - Reexamination hearings = ~19/year

Remote hearings during pandemic (cont.)

March 16, 2020 – February 28, 2022

- Public access provided for 548 hearings
 - 465 AIA trials
 - 81 ex parte appeals
 - 1 reexamination
 - 1 interference



- Public may request to listen to a hearing by submitting a request to PTABHearings@USPTO.gov

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PTAB hearings



Information regarding PTAB oral hearings including

- Hearings schedule
- Hearings guide
- Hearings locations
- Forms and samples (AIA trials and appeals)

is available at:

<https://www.uspto.gov/patents/ptab/hearings>



Breck Reitter & Andrew Kellogg
Supervisory Paralegal Specialists

Paralegal Operations

Decision processing by paralegals

- Once a judge has drafted a decision, it is sent to a paralegal to verify accuracy of, among other things:
 - Bibliographic data such as inventors, party names, etc.
 - Case information such as appeal and application numbers, judge panel and seniority
 - Grammar, abbreviations, formatting, spelling
 - Quotations
 - Citations
 - Pending claim listings, grounds of rejection, summary table data
 - Disposition

Decision processing by paralegals (cont.)

Paralegals also:

- Enter orders and decisions for judges
 - Includes entering all orders, decisions, oral hearing transcripts, dismissals, and remands
- Process requests for rehearing

Paralegal communication with counsel

- Processing of communications (email/phone) to and from counsel concerning procedural issues
 - Supervisory paralegals monitor Trials' internal/external email inbox and telephone help line
 - Paralegals receive some direct communications from counsel
 - Paralegals setup teleconferences between counsel and judge panel
 - Email: Trials@USPTO.gov
 - Phone: 571-272-7822



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PTAB decisions



- To search all PTAB trial, appeal, and interference decisions issued after July 1997, please visit:
<https://developer.uspto.gov/ptab-web/#/search/decisions>
- To view PTAB precedential and informative decisions, please visit:
<https://www.uspto.gov/patents/ptab/precedential-informative-decisions>



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Next Boardside Chat



- April 21, 2022, at 12-1 pm ET
- Topic: After final consideration & conferences
 - Learn about the After Final Consideration Pilot
 - Pre-appeal conferences
 - Appeal conferences
 - Information about the application timeline and requirements
- Register for and learn about upcoming Boardside Chats, and access past Boardside Chats at:
<https://www.uspto.gov/patents/ptab/ptab-boardside-chats>



