

UNITED STATES
PATENT AND TRADEMARK OFFICE



iH Patent Trial and Appeal Board (PTAB) **Inventor Hour: Episode 30**

LiLan Ren, Administrative Patent Judge

Brandon Warner, Administrative Patent Judge

Ameesh Shah, Administrative Patent Judge

Ryan Flax, Lead Administrative Patent Judge

Janet Gongola, Vice Chief Administrative Patent Judge

Special guest:

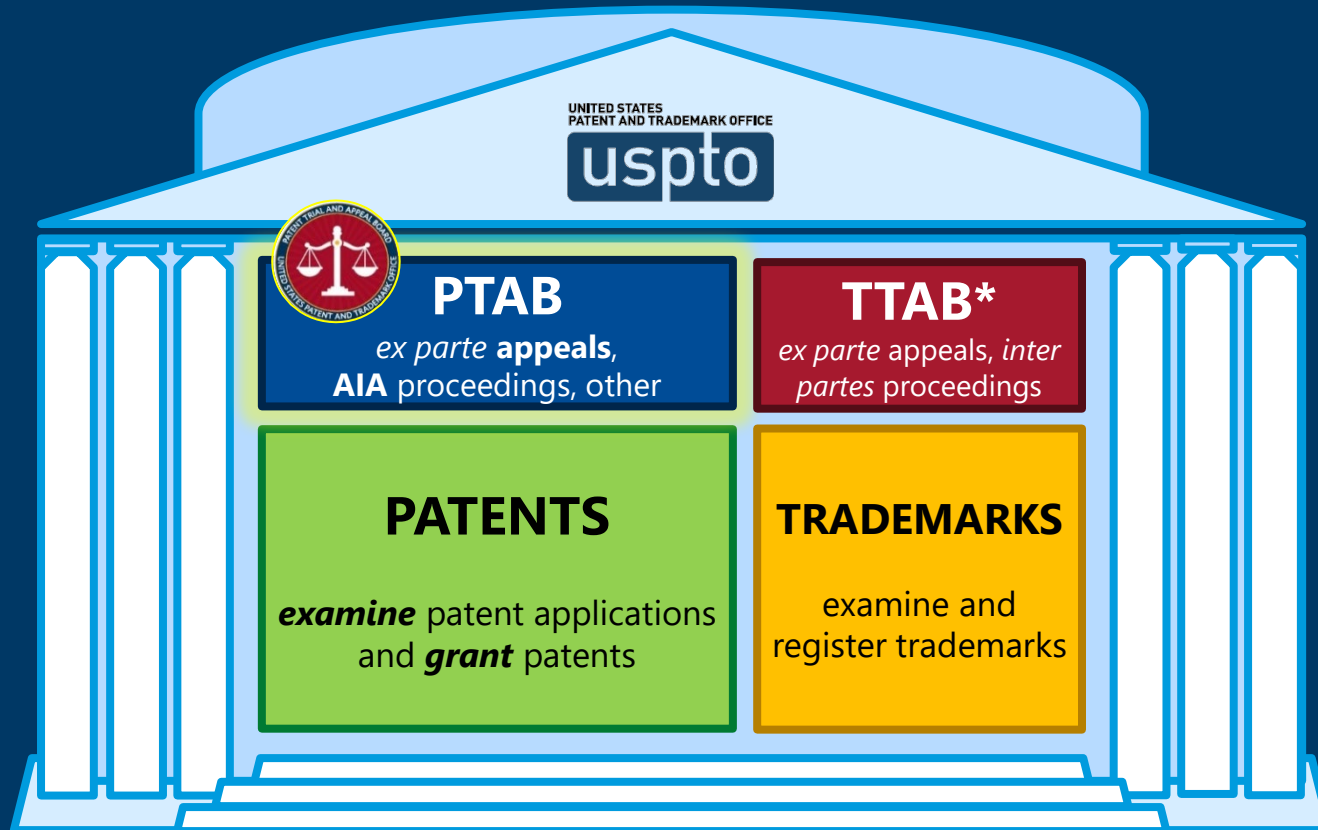
Sean Wilkerson, Innovation Outreach Specialist

July 25, 2024



UNITED STATES
PATENT AND TRADEMARK OFFICE ®

What is the Patent Trial and Appeal Board?



Today's agenda

1

Interview with
Sean Wilkerson

2

Ex parte
appeal byte:
RCE or appeal?

3

Advocacy byte:
Things you
should know

4

Q&A

*Information not intended as legal advice

Question/comment submission

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

- PTABInventorHour@uspto.gov

Janet Gongola, Vice Chief Administrative Patent Judge



An interview with Sean Wilkerson

Innovation Outreach Specialist



Sean Wilkerson

*Innovation Outreach
Specialist*

Office of Public Engagement

Invention-Con

www.uspto.gov/inventioncon

- For inventors, makers, and entrepreneurs
- August 16 from 11:30 a.m. to 6 p.m. ET: in-person at USPTO headquarters in Alexandria, Virginia and virtual
- August 17 from 10 a.m. to 2 p.m. ET: in-person only at USPTO headquarters
- For more information, check out the Invention-Con webpage or email InventionCon@uspto.gov



Question/comment submission

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PTAB Pro Bono Program



- Under-resourced inventors may receive free legal help from volunteer attorneys for *ex parte* appeals before the PTAB.
- For more details:
 - Watch the recording of the [July 2023 Inventor Hour webinar](#) online; and/or
 - Check out the PTAB Pro Bono Program webpage at www.uspto.gov/ptabprobono.



Brandon Warner, Administrative Patent Judge



***Ex parte* appeal byte:**

File an RCE or *ex parte* appeal after a final rejection?

Final rejection

- After an application is filed, an examiner decides if it meets various requirements.
 - If not, the examiner may issue a **rejection**.
- When the examiner has **twice** rejected the claims or issued a **final** office action, the applicant has choices to make.

After a final rejection

- Several options
 - Before an examiner
 - Interview
 - After final response
 - After Final Consideration Pilot 2.0 (AFCP 2.0)
 - **Request for Continued Examination (RCE)**
 - File a continuation application
 - Abandon the application
 - Before the PTAB
 - ***Ex parte* appeal**

What is a request for continued examination (RCE)?

- After prosecution of an application is closed, an applicant may request continued examination of the application by timely filing a submission and paying a fee.
 - 37 C.F.R §1.114

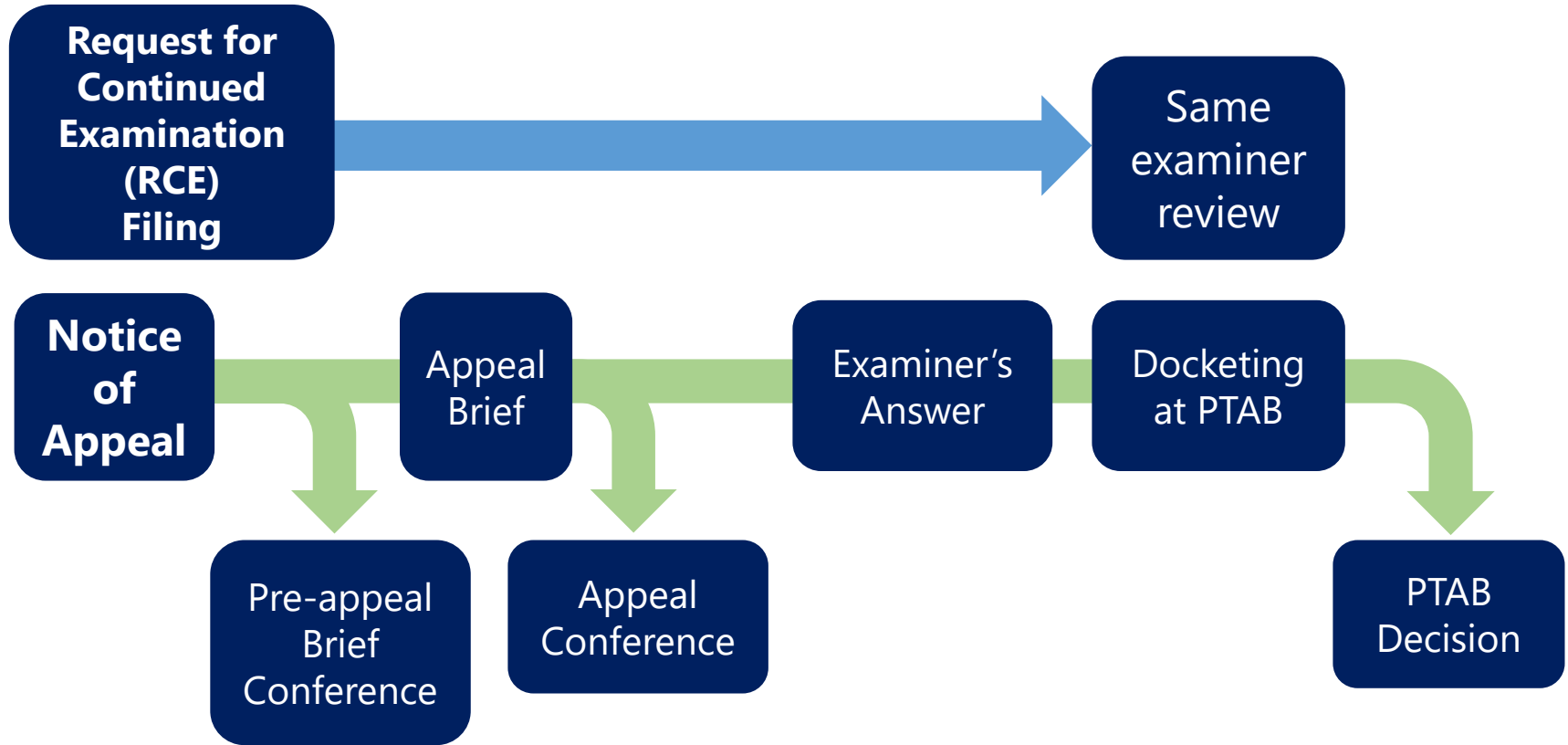
What are *ex parte* appeals?

- After an application has been twice rejected or an examiner has issued a final rejection in the application, an applicant may seek review of the final rejection by three administrative patent judges at the PTAB.

Considerations in selecting an RCE v. an *ex parte* appeal

- Process
- Decision makers
- Timing
- Costs

Steps in review process



Decision makers

- **RCEs: single set of eyes**

- Typically, same examiner continues examination after entry of responsive submission accompanying the RCE.

- **Appeals to PTAB: multiple sets of eyes**

- Additional reviewers:

- Before arriving at PTAB, a three-examiner conference (including supervisor and examiner of record)
- After arriving at PTAB, typically decided by three administrative patent judges (APJs)

Timing*

- **RCEs**

- Currently, examiner responds to RCE in about 1.9 months.

- **Appeals to PTAB**

- PTAB issues a decision on appeal, on average, about 12 months after the appeal forwarding fee is paid.
- Fast track appeals available upon request with payment of petition fee.
 - Decision on appeal issued within 6 months of petition (currently averaging 2-3 months).

*Timing reflects amount of time for decision maker to take action



Costs*

RCE

- 1st request: \$1,360
- 2nd and subsequent requests: \$2,000
- Costs to prepare response to final rejection

Appeal to PTAB

- Notice of appeal: \$840
- Appeal forwarding: \$2,360
- Optional Fast-Track Appeals: \$420
- Optional request for oral hearing: \$1,360
- Costs to prepare appeal and reply briefs

*fees shown as undiscounted, large entity cost; small entity is 50% discount; micro entity is 75% discount (except Fast-Track fee)



Question/comment submission

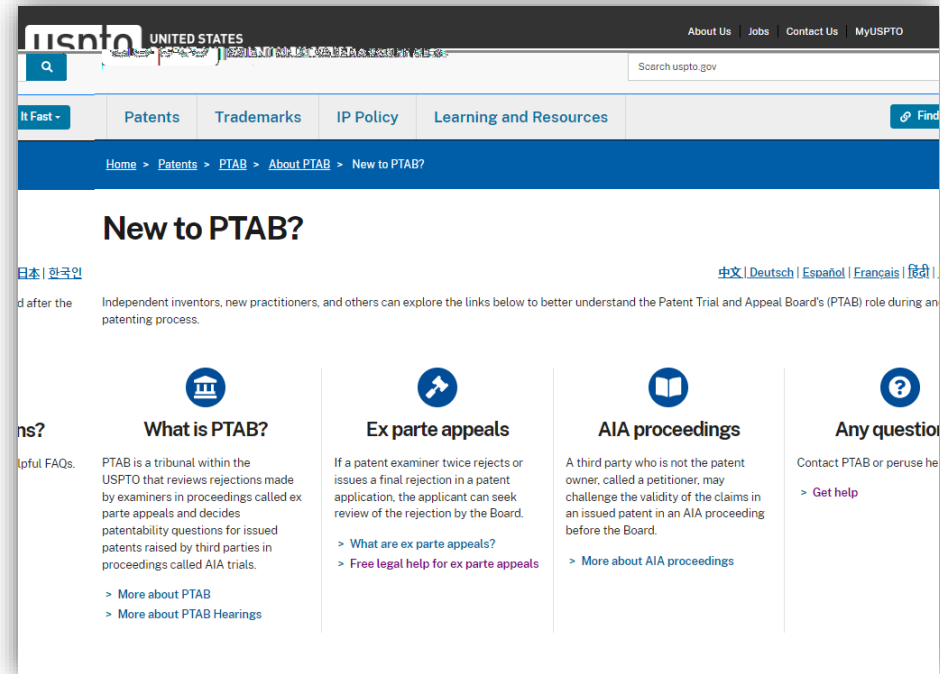
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New to PTAB webpage



- Contains basic information about:
 - *Ex parte* appeals
 - AIA trial proceedings
- Available in multiple languages.
- www.uspto.gov/patents/patent-trial-and-appeal-board/about-ptab/new-ptab



Ryan Flax, Lead Administrative Patent Judge

Amee Shah, Administrative Patent Judge



Advocacy byte:
Things You Should Know

Tip 1: Interpreting claims

The Office applies the **broadest reasonable interpretation** of claim language (consistent with the specification) in considering **pending claims**.

Tip 2: Non-claimed features

Seldom will arguing over features of your invention that are not **recited in the rejected claims** be persuasive. **What matters most is how the language of the claims defines your invention** and how that is novel, non-obvious, and supported by the specification.

Tip 3: Evidence

An examiner's rejection must be supported by **evidence** and cannot be mere conclusions.

Tip 4: More on evidence

You need evidence to support your arguments.

Argument is no substitute for evidence.

Tip 5: Filing evidence

File your evidence during prosecution, before the appeal.

Question/comment submission

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

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Watch a PTAB hearing



- All PTAB hearings are available for public viewing.
- To request access, either virtual or in-person, submit a request to: PTABHearings@uspto.gov at least 3 days before the hearing.
- To view the hearing schedule: www.uspto.gov/patents/ptab/hearings

July 2024 PTAB Public Hearing Schedule						
Proceeding No.	Serial No.	PARTY	Date	Time	Location	Room
IPR 2023-00634 IPR 2023-00734		MASIMO CORPORATION v. APPLE INC.	Tuesday, July 9, 2024	9:00 AM (EDT)		VIRTUAL
IPR 2023-00554 IPR 2023-00714		CISCO SYSTEMS, INC. v. ORCKIT CORPORATION	Tuesday, July 9, 2024	11:00 AM (EDT)		VIRTUAL
IPR 2023-00624 IPR 2023-00626		COPELAND COMFORT CONTROL LP v. OLLNOVA TECHNOLOGIES LTD.	Tuesday, July 9, 2024	1:00 PM (EDT)	ALEXANDRIA, VA	D
IPR 2023-00656		IRIUSRISK INC. v. THREATMODELER SOFTWARE, INC.	Wednesday, July 10, 2024	1:00 PM (EDT)		VIRTUAL
IPR 2022-01223		APPLE INC. v. SMART MOBILE TECHNOLOGIES LLC	Wednesday, July 10, 2024	1:00 PM (EDT)		VIRTUAL
IPR 2023-00529 IPR 2023-00531		MICROSOFT CORPORATION v. LEMKO CORP.	Thursday, July 11, 2024	1:00 PM (EDT)		VIRTUAL
IPR 2023-00601 IPR 2023-00602		SAMSUNG ELECTRONICS CO., LTD. v. APEX BEAM TECHNOLOGIES LLC	Friday, July 12, 2024	11:00 AM (EDT)		VIRTUAL
IPR 2023-00701 IPR 2023-00621 IPR 2023-00756 IPR 2024-00143 IPR 2024-00145 IPR 2024-00144		SAMSUNG ELECTRONICS CO., LTD. v. DODOTS LICENSING SOLUTIONS LLC	Friday, July 12, 2024	1:00 PM (EDT)		VIRTUAL
IPR 2023-00693		KAHOOT! ASA & KAHOOT! EDU, INC., v. AVIEL D. RUBIN	Friday, July 12, 2024	1:00 PM (EDT)		VIRTUAL
2024-002449	90014901	LIT-US CHISUM 21-A, LLC (PATENT OWNER) et al.	Monday, July 15, 2024	10:00 AM (PDT)		VIRTUAL
IPR 2023-00568 IPR 2023-00153 IPR 2023-00154		LIGHTRICKS LTD. v. PLOTAGRAPH, INC.	Monday, July 15, 2024	1:00 PM (EDT)		VIRTUAL
IPR 2023-00611 IPR 2023-00613 IPR 2023-00614		QUASAR SCIENCE LLC v. COLT INTERNATIONAL CLOTHING, INC. (d/b/a COLT LED)	Tuesday, July 16, 2024	1:00 PM (EDT)		VIRTUAL



Questions?

Future programs

Inventor Hour, Episode 31

Thursday, Aug. 22, 2024, noon (ET)

Inventor Hour, Episode 32

Thursday, Sept. 26, 2024, noon (ET)



