

**UNITED STATES
PATENT AND TRADEMARK OFFICE**





Relation between USPTO Patent Trial and Appeal Board (PTAB) and Courts

Scott Boalick, Chief Administrative Patent Judge



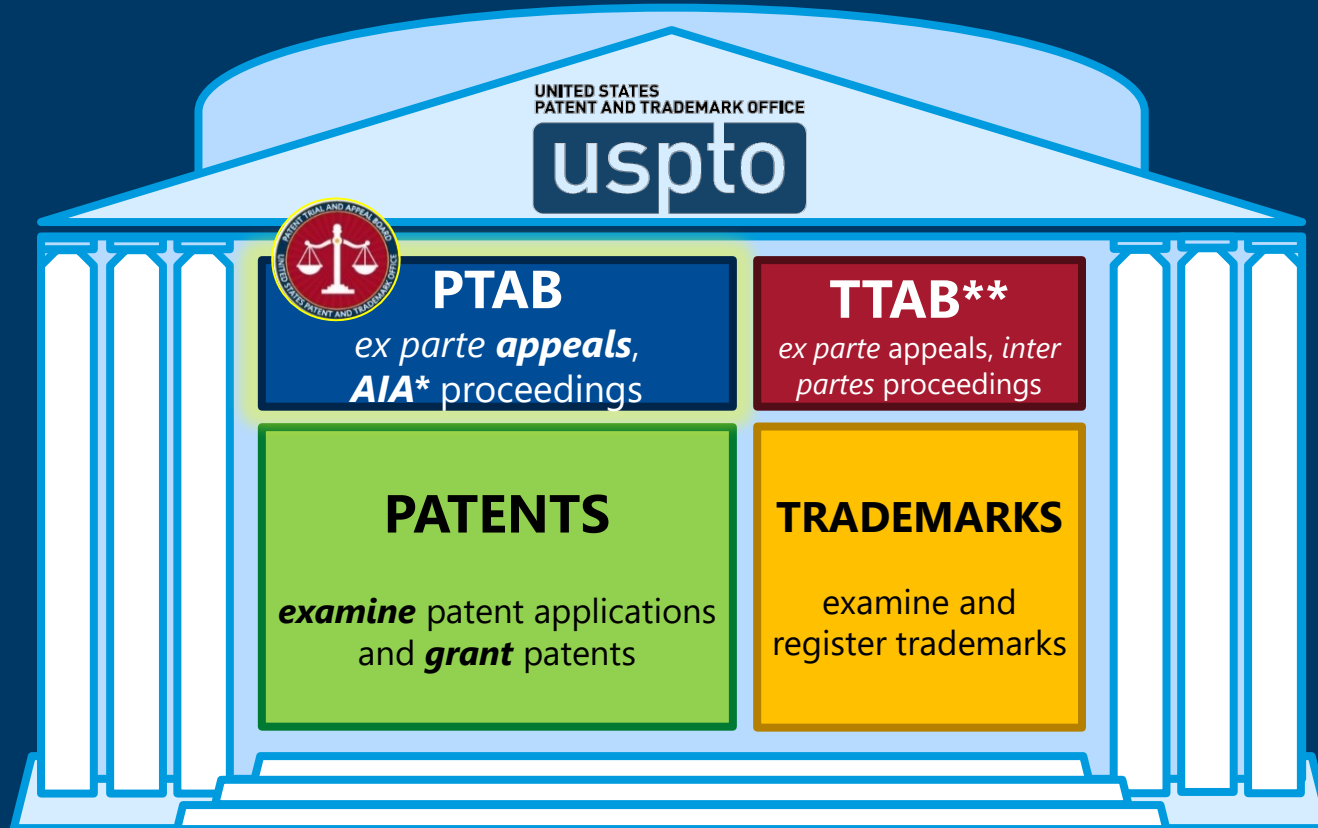
UNITED STATES
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Today's Agenda

- What exactly is "**PTAB**"?
- How we handle ***Ex Parte Appeals***
- **Post-Grant Proceedings** under the America Invents Act
- **Where we fit in** to the U.S. IP courts

PTAB overview

What is the Patent Trial and Appeal Board?



What does the PTAB do?

- **Reviews examiner** work product
 - Appeals from unsuccessful patent applicants
- **Conducts AIA reviews** based on challenges of issued patents by third parties

What are AIA trial proceedings?

- **America Invents Act (AIA)** – Congress revised the Patent Act to provide an additional forum to address patentability/validity disputes
- AIA proceedings are intended to be **streamlined**, **efficient**, and **cost effective**
 - 37 C.F.R. 42.2 (“Trial means a contested case instituted by the Board based upon a petition. A trial begins with a written decision notifying the petitioner and patent owner of the institution of the trial. The term trial specifically includes a derivation proceeding . . . an inter partes review . . . a post-grant review.”)

Comparison of IPR and PGR

Trial Type	Who Can File	Applicability	Availability	Basis
Inter partes review (IPR)	Person who is: (a) not the patent owner, (b) has not previously filed a civil action challenging the validity of a claim of the patent, and (c) has not been served with a complaint alleging infringement of the patent more than 1 year prior (exception for joinder).	Any patent.	For first-to-invent patents: anytime after patent grant or reissue. For first-inventor-to-file patents: from the later of: (a) 9 months after patent grant or reissue; or (b) the date of termination of any post grant review.	Patent Act Sections 102 and 103 based on anticipation and obviousness over patents and printed publications.
Post-grant review (PGR)	Person who is: (a) not the patent owner, and (b) has not previously filed a civil action challenging the validity of a claim of the patent.	Patent issued after the AIA went into effect.	Must be filed within 9 months of patent grant or reissue.	Patent Act Sections 101, 102, 103, 112 (but not best mode), and double patenting.

Who is involved in an AIA trial proceeding?

Petitioner

Files petition challenging a U.S. patent; must pay a filing fee

Carries legal burden to prove claims unpatentable

Patent Owner

Has opportunities to represent its interests

Judicial Panel

Typically three administrative patent judges

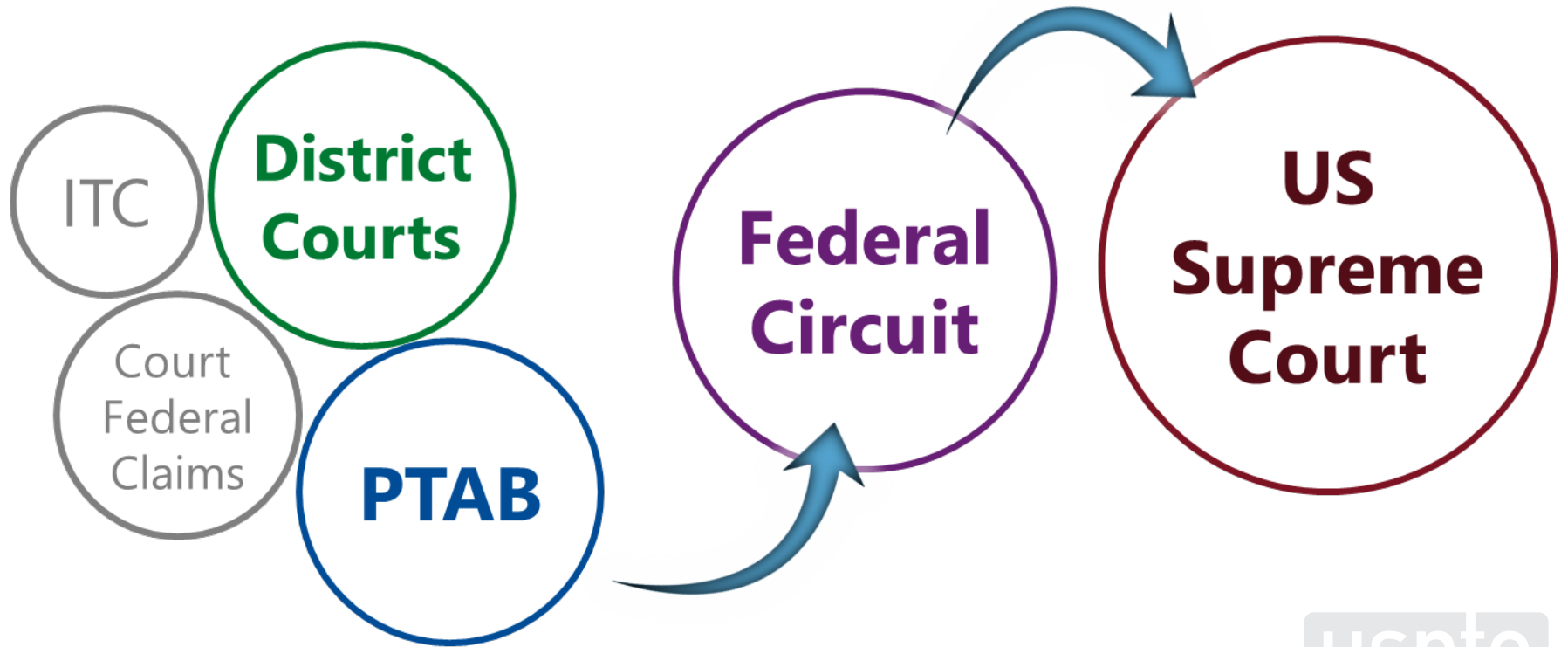


AIA proceeding timeline



How the PTAB fits into the IP landscape

Patent proceedings forums



The Board at USPTO: Types of decisions

PTAB

Ex Parte
Appeals

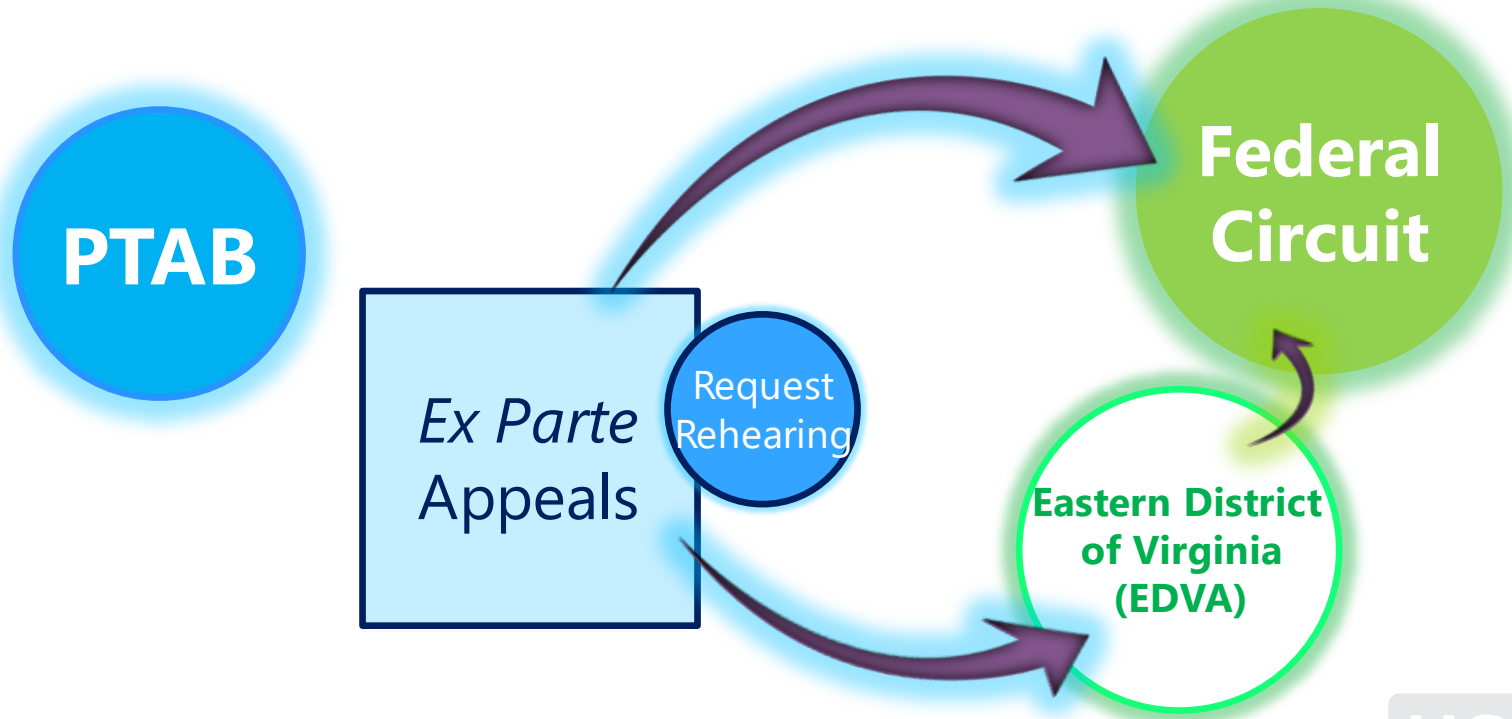
AIA
Proceedings

IPR

PGR

Derivation

Appealing Board decisions



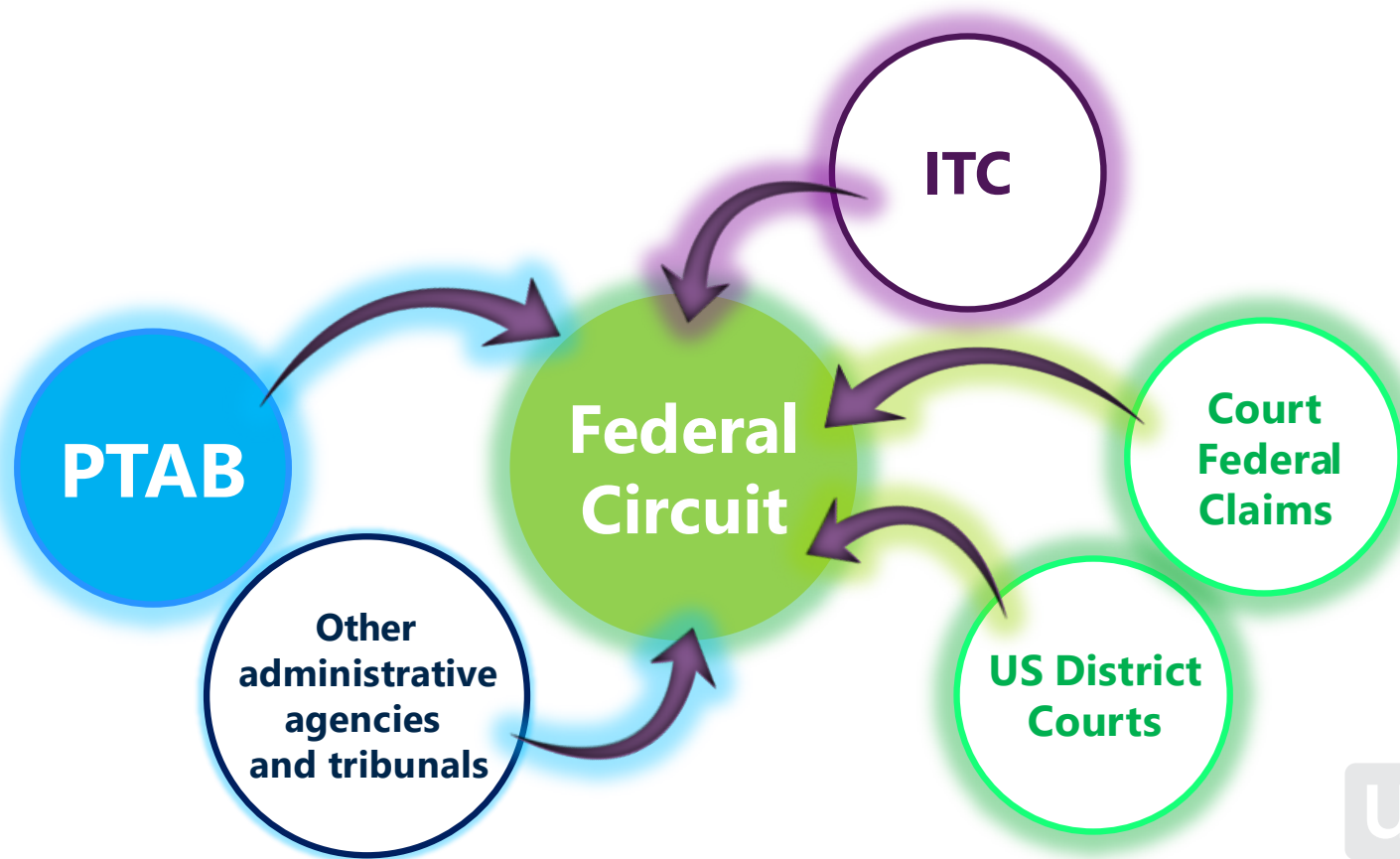
Appealing Board decisions

PTAB

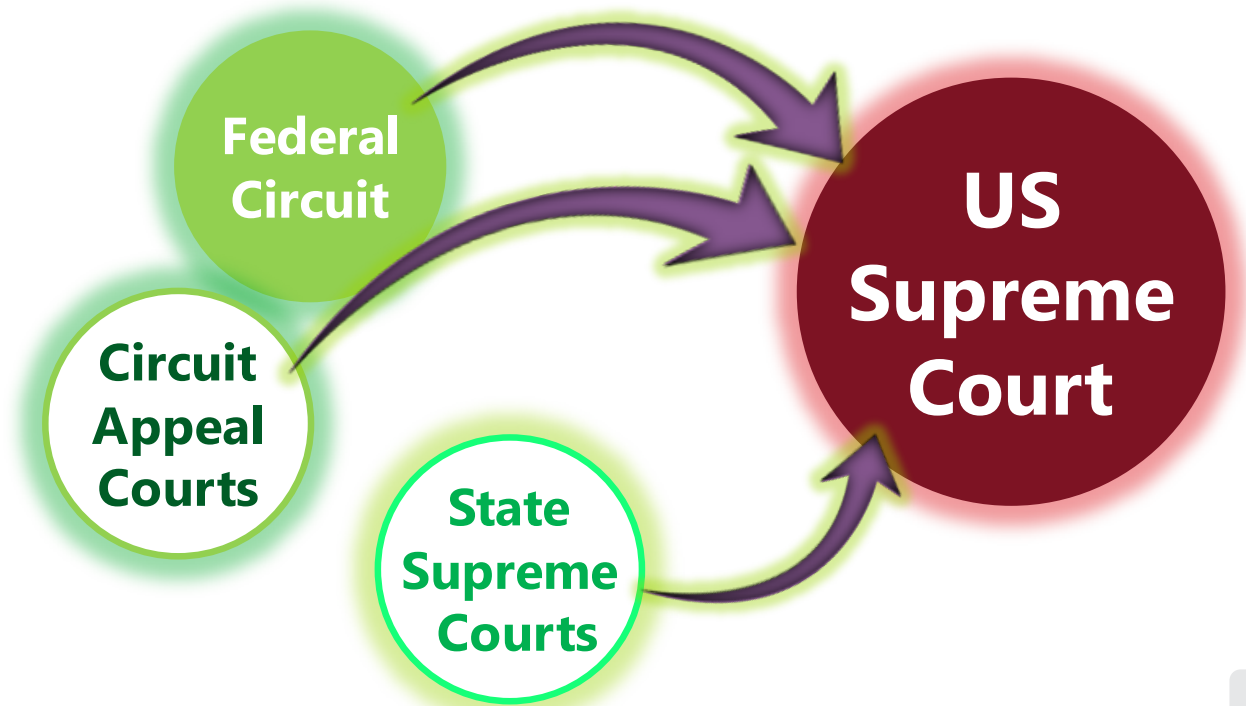


Federal Circuit

The Federal Circuit



The U.S. Supreme Court



The U.S. Supreme Court

U.S. Constitution, Article III, Section I:

“The judicial Power of the United States, shall be vested in one Supreme Court, and in such inferior Courts as the Congress may from time to time ordain and establish.”

The Supreme Court may decide to hear cases from the Federal Circuit originating from the PTAB.

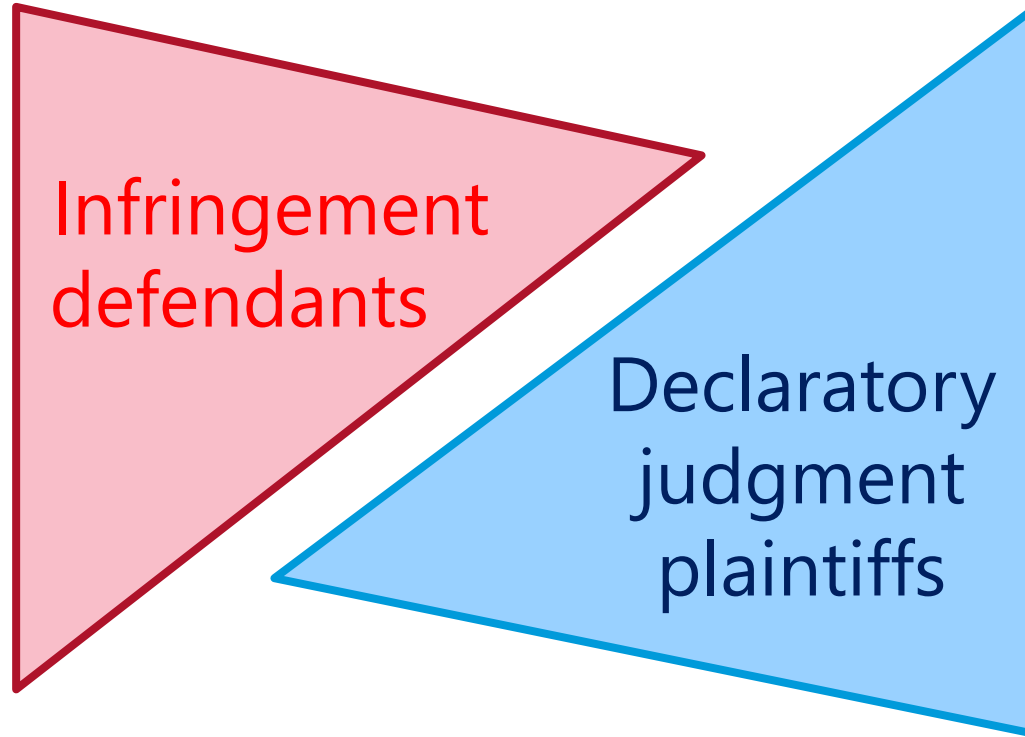


**U.S.
Supreme
Court**



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U.S. District Courts



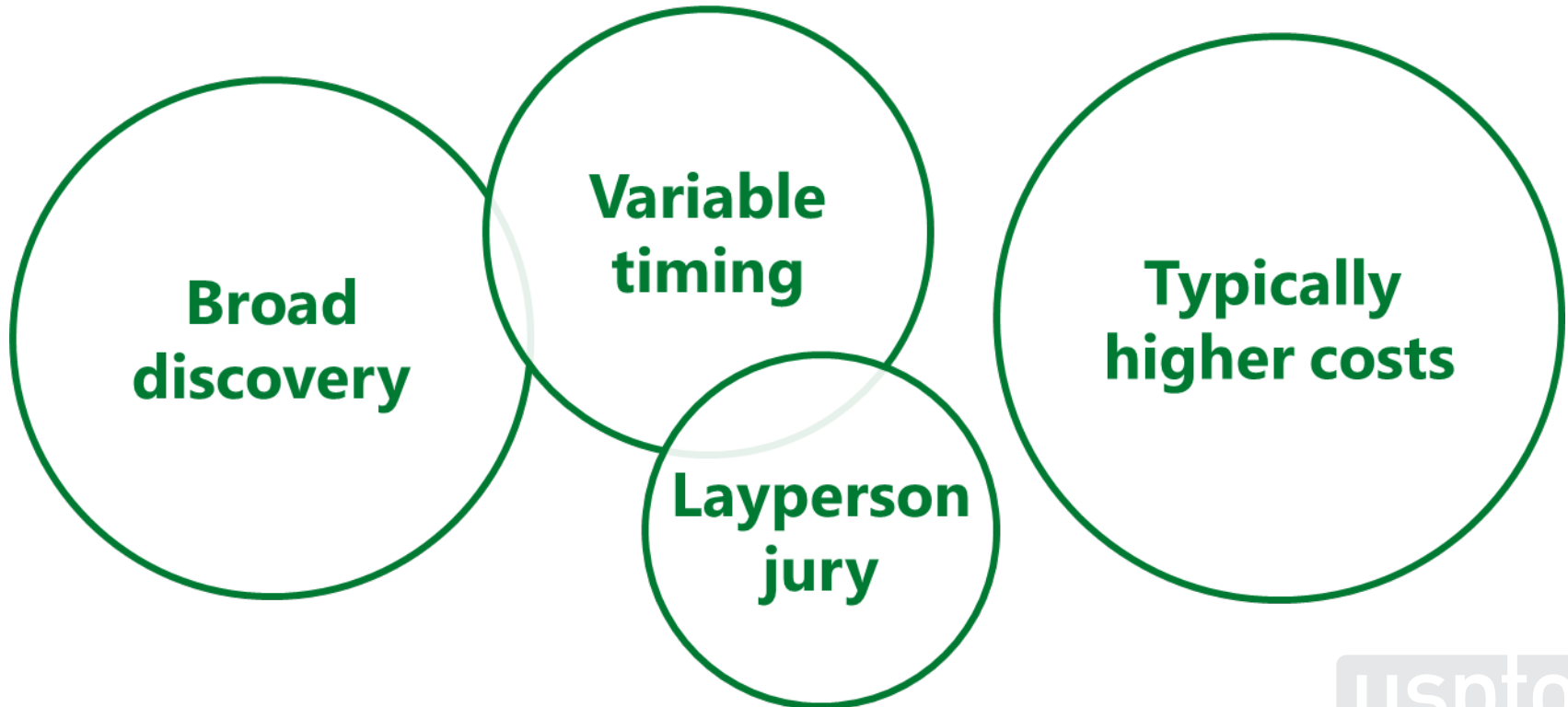
U.S. District Courts: Invalidity

Grounds for challenging

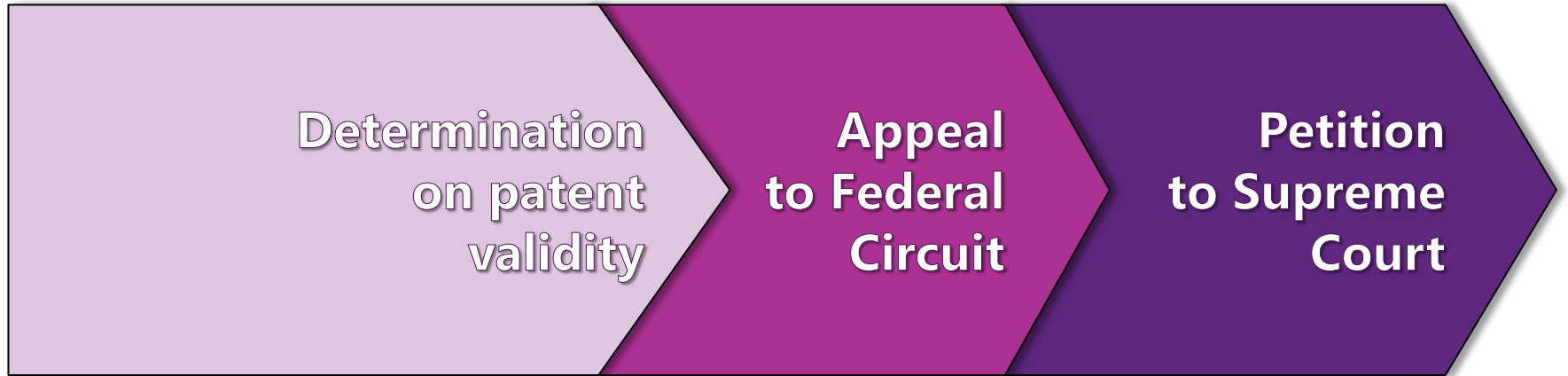
- Patent eligibility
- Obviousness
- Anticipation
- On-sale bar
- Written description
- Indefiniteness
- Enablement

**CLEAR AND
CONVINCING
BURDEN OF
PROOF**

U.S. District Courts: Issues of note



U.S. District Courts: Invalidation grounds



Patent Trial and Appeal Board



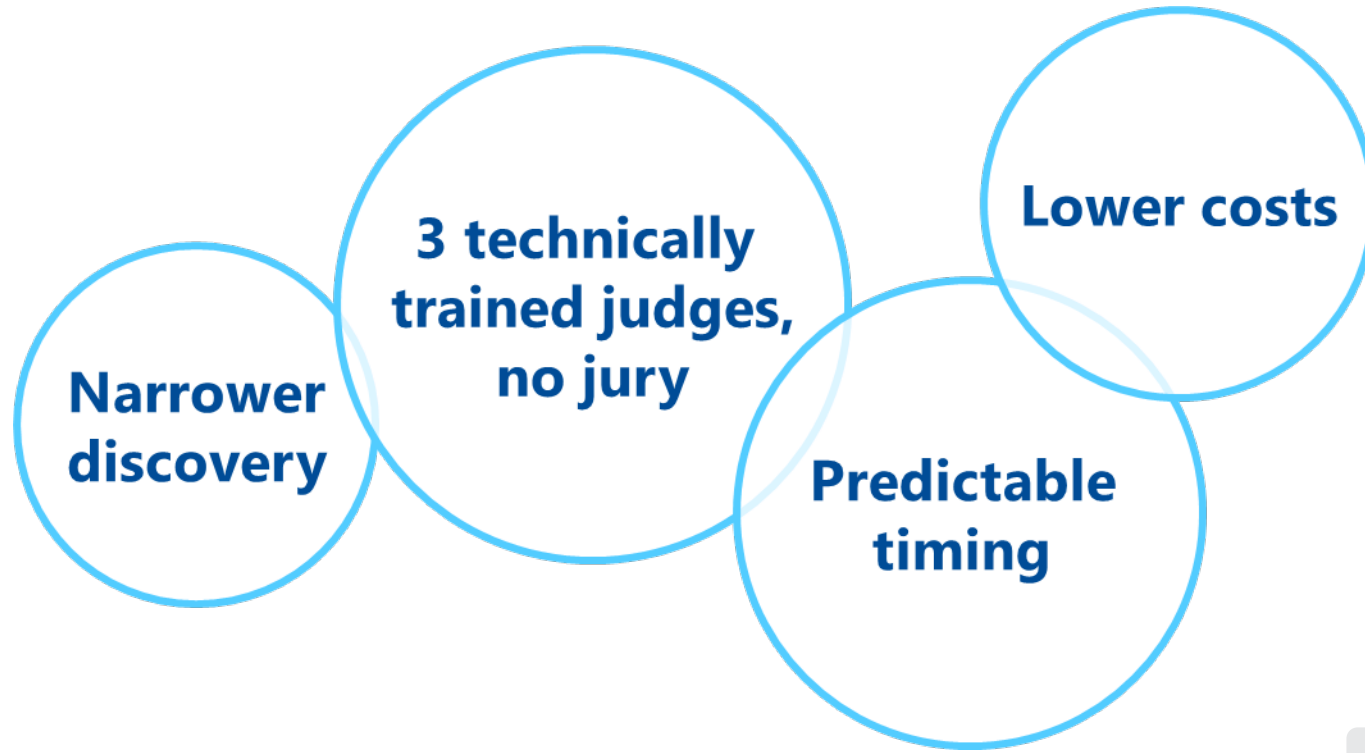
- *Inter Partes Review*
- **Post-Grant Review**
- **Derivation Proceeding**

PTAB: Unpatentability

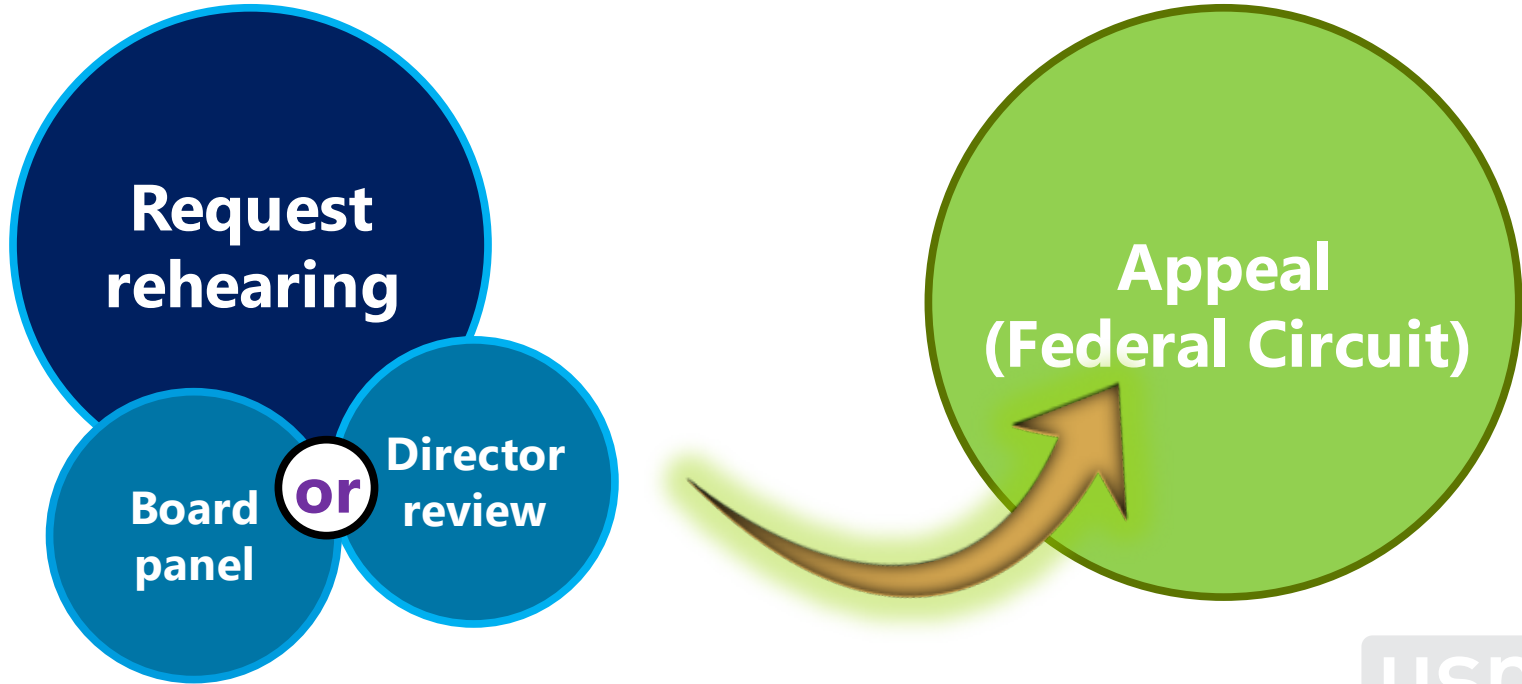
PREPONDERANCE
OF THE EVIDENCE
BURDEN OF PROOF

	IPR	PGR
Patent eligibility		✓
Obviousness	✓	✓
Anticipation	✓	✓
On-sale bar		✓
Written description		✓
Indefiniteness		✓
Enablement		✓

PTAB: Issues of note



Patent Trial and Appeal Board: After a final written decision



Questions?



Appendix

The law & rules for AIA proceedings

- U.S. Supreme Court and U.S. Court of Appeals for the Federal Circuit
- 35 U.S.C. §§ 311-329 (statutes governing IPRs and PGRs)
 - uscode.house.gov/browse/prelim@title35&edition=prelim
- 37 C.F.R. §§ 42.1-42.412 (rules/regulations for trials in general, and IPRs, PGRs, and Derivation Proceedings)
 - www.ecfr.gov/cgi-bin/textidx?&tpl=/ecfrbrowse/Title37/37tab_02.tpl
- Precedential PTAB decisions
 - www.uspto.gov/patents/ptab/precedential-informative-decisions
- Consolidated Trial Practice Guide, Nov. 2019
 - www.uspto.gov/about-us/news-updates/consolidated-trialpractice-guide-november-2019
- Director guidance and memoranda



Appealing Board decisions to the courts

- 35 U.S. Code § 319 – Appeal
 - A party dissatisfied with the final written decision of the Patent Trial and Appeal Board under section 318(a) may appeal the decision pursuant to sections 141 through 144. Any party to the inter partes review shall have the right to be a party to the appeal.
- 35 U.S. Code § 145 – Civil action to obtain patent
 - An applicant dissatisfied with the decision of the Patent Trial and Appeal Board in an appeal under section 134(a) may, unless appeal has been taken to the United States Court of Appeals for the Federal Circuit, have remedy by civil action against the Director in the United States District Court for the Eastern District of Virginia [EDVA] if commenced within such time after such decision, not less than sixty days, as the Director appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Patent Trial and Appeal Board, as the facts in the case may appear and such adjudication shall authorize the Director to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant.

Appealing Board decisions to the courts

- 35 U.S. Code § 141 - Appeal to Court of Appeals for the Federal Circuit
 - (a) Examinations.— An applicant who is dissatisfied with the final decision in an appeal to the Patent Trial and Appeal Board under section 134(a) may appeal the Board’s decision to the United States Court of Appeals for the Federal Circuit.
 - (b) Reexaminations.— A patent owner who is dissatisfied with the final decision in an appeal of a reexamination to the Patent Trial and Appeal Board under section 134(b) may appeal the Board’s decision only to the United States Court of Appeals for the Federal Circuit.
 - (c) Post-Grant and Inter Partes Reviews.— A party to an inter partes review or a post-grant review who is dissatisfied with the final written decision of the Patent Trial and Appeal Board under section 318(a) or 328(a) (as the case may be) may appeal the Board’s decision only to the United States Court of Appeals for the Federal Circuit.

Jurisdiction of the Federal Circuit

28 U.S. Code § 1295 - Jurisdiction of the United States Court of Appeals for the Federal Circuit:

(a) The United States Court of Appeals for the Federal Circuit shall have **exclusive** jurisdiction—

(1) of an appeal...relating to patents or plant variety protection

...

(4) of an appeal from a decision of—

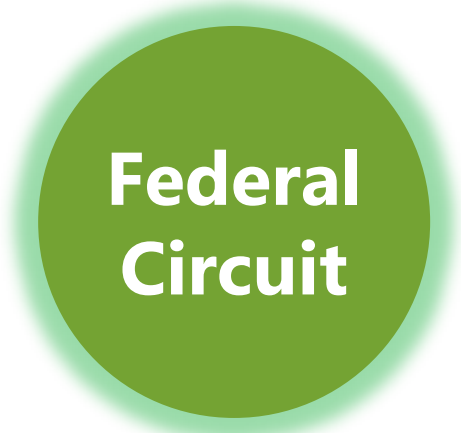
(A) the Patent Trial and Appeal Board ... with respect to a ... reexamination, post-grant review, or inter partes review;

(B) the [USPTO Director] with respect to [trademark] applications; or

(C) a district court [handling a patent case];

(5) of an appeal from ... the United States Court of International Trade;

(6) to review ... the United States International Trade Commission.



**Federal
Circuit**



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Clear and convincing evidence

- According to the Supreme Court in *Colorado v. New Mexico*, 467 U.S. 310 (1984), "clear and convincing" means that the evidence is highly and substantially more likely to be true than untrue.
 - Judge/Jury must be convinced that the contention is highly probable
 - More than preponderance of the evidence at PTAB
 - Less rigorous than beyond a reasonable doubt standard in criminal cases

**CLEAR AND
CONVINCING
BURDEN OF
PROOF**

Preponderance of the evidence

- Courts define “preponderance of the evidence” to mean that the evidence is more likely true than not true
 - At the end of trial, PTAB must decide whether there is at least a 51% chance that Petitioner’s assertions for each challenged claim are true
 - Less rigorous than “clear and convincing evidence” at District Court
 - More rigorous than “reasonable likelihood” standard to institute IPR
 - More rigorous than “more likely than not” standard to institute PGR

**PREPONDERANCE
OF THE EVIDENCE
BURDEN OF
PROOF**