

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Patent Trial and Appeal Board (PTAB) update

Scott R. Boalick, Chief Administrative Patent Judge
Jacqueline W. Bonilla, Deputy Chief Administrative Patent Judge
Janet A. Gongola, Vice Chief Administrative Patent Judge
Michael W. Kim, Vice Chief Administrative Patent Judge
Eric Jeschke, Administrative Patent Judge
Michael Cygan, Administrative Patent Judge

May 6, 2021
Patent Public Advisory Committee quarterly meeting

UNITED STATES
PATENT AND TRADEMARK OFFICE



Agenda

- Fast-Track Pilot Program for Appeals Related to COVID-19 status update
- Outreach programs
- The one-year study for ex parte appeal

Update

Fast-Track Pilot Program for Appeals Related to COVID-19

Fast-Track Pilot Program for Appeals Related to COVID-19

- Published April 15, 2021
- Temporary pilot program before the PTAB
- An appellant can request an ex parte appeal related to COVID-19 to be expedited out of turn by filing a no cost petition
- Pendency goal: PTAB decision within six months

Does my appeal qualify?

- **Application type**
 - Original utility, design, or plant nonprovisional application
 - Application with claims that cover a product or process subject to an applicable FDA approval for COVID-19 use
- **Status of appeal**
 - Pending ex parte appeal (Notice of Appeal filed and Docketing Notice issued)
 - Not limited to “new” appeals (a petition may be submitted for any currently pending appeal)

Are there any restrictions?

- The number of granted petitions is limited to 500 total
- Hearings permitted, with some caveats
- Not available for applications already treated as special during appeal under MPEP 708.01
 - See MPEP 708.01 (e.g., appeals treated special due to age or health of inventor)

Petition requirements

- Petition under 37 C.F.R. § 41.3
 - Form PTO/SB/454 recommended, but not required
 - No cost
 - Identify the application number and appeal number
 - Certify that the application claims a product or process subject to an applicable FDA approval for COVID-19 use

Independent Inventors & New Practitioners

Outreach programs

Inventor Hour webinars

- Purpose: offer education about PTAB proceedings at a foundational level
- Launch on May 13 and quarterly thereafter
- Topics: appeal brief template and instructions (May 13)
- Webinar access information available at: <https://www.uspto.gov/patents/ptab/ptab-inventors>



Ex parte appeal brief template

- To provide generalized guidance in ex parte appeals to both independent inventors proceeding *pro se* and new practitioners
 - [Word template](#) (with section headings) serves as the starting point for an appeal brief
 - [PDF instruction document](#) provides jargon-free, generalized guidance to help the user draft each section in the Word template (after saving locally)

Expected usage

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.

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



Current status

- The [Word template](#), [PDF instruction document](#), and an instructional video are now available for use
 - <https://www.uspto.gov/patents/ptab/ptab-inventors>
- Please provide feedback on these tools: [PTAB Appeals Suggestions@uspto.gov](mailto:PTAB.Appeals.Suggestions@uspto.gov)

How to get from final action to PTAB decision in one year (or less)

The one-year *ex parte* appeal

Ex parte appeals pendency goal

- Today's discussion: review the timing of *ex parte* appeals and discuss how an appellant can obtain a quicker decision when desired
- Allow stakeholders to make informed decision on whether to appeal to PTAB, regardless of technology
- 12-month average pendency for decided appeals, regardless of technology
 - Pendency is measured from the date jurisdiction passes to PTAB (i.e., approximately when PTAB receives all briefing, the appeal forwarding fee is paid, and an appeal number is assigned) to the date PTAB issues a decision
 - Pendency does not include the time it takes from Final Action to jurisdiction passing to the PTAB

Final Action-to-PTAB decision in one year

Appellants can increase the likelihood of receiving a PTAB decision on an appeal within one year of final rejection by:

1. Promptly filing during the briefing stage
 - notice of appeal, appeal brief, and reply brief
 - Appellants can do its part to reduce the briefing stage to 6 months or less
2. Using the PTAB Fast-Track Appeals Pilot Program
 - provides a decision within 6 months of Fast-Track decision grant
 - current non-Fast-Track appeal decision median time is around 12 months

Thus resulting in a total Final Action-to-PTAB Decision time of:

- with PTAB Fast-Track Appeals Pilot Program: < 12 months
- without PTAB Fast-Track Appeals Pilot Program : < 18 months



The course of an *ex parte* appeal

Document	Who files/issues	PTAB jurisdiction
Final Rejection	Examiner	No
Notice of Appeal	Appellant	No
Appeal Brief	Appellant	No
Examiner's Answer	Examiner	No
Reply Brief	Appellant	No
Decision	PTAB	Yes

- Jurisdiction transfers to PTAB approximately when filing of a (optional) reply brief (or expiration of the time to file a reply brief) and the appeal forwarding fee is paid.
- Other optional actions (e.g., Pre-Appeal Conference Pilot Program) may occur between some filings, before jurisdiction transfers to PTAB.



Appellant controls the briefing duration

Document	Who files/issues	Maximum (months)	Typical (months)
Final Rejection	Examiner		
Notice of Appeal	Appellant	6	4
Appeal Brief	Appellant	7	3
Examiner's Answer*	Examiner	4*	2.5*
Reply Brief	Appellant	2	2
Decision	PTAB		
Total briefing (months):		~19	~11.5

* About 95% of Examiner's Answers issue within 4 months after an Appeal Brief filing, with ~2.5 months being the average overall. Neither guarantees the timing of any particular Examiner's Answer.

Total time to decision

Document	Who files/issues
Final Rejection	Examiner
Notice of Appeal	Appellant
Appeal Brief	Appellant
Examiner's Answer*	Examiner
Reply Brief	Appellant
Decision	PTAB

Maximum (months)	Typical (months)
~19	11.5
~24	~12

PTAB Jurisdiction:

Slowest PTAB appeals (<5%):

~24 months

Typical PTAB appeal:

~12 months

Total time-to-decision (months):

~43	~23.5
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The one-year appeal

Document	Typical (months)	Diligent Appellant (months)	Diligent + PTAB Fast-Track
Final Rejection			
Notice of Appeal	4	1	1
Appeal Brief	3	1.5	1.5
Examiner's Answer*	~2.5	~2.5	~2.5
Reply Brief	2	1	1
Decision	~12	~12	<6

Final-to-Decision (months):	~23	~18	<12
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- Where an Appellant would like to conclude an appeal quickly, the time frames for the briefing stage show how such appeals may proceed. It may not be appropriate for all appeals.

Planning for *ex parte* appeals

- Diligent Appellant using PTAB Fast-Track Appeals Pilot Program: <12 months Final Action-to-PTAB Decision
 - Typical time for Final Action-to-PTAB Decision: 23 months
- Appellants largely control duration of briefing stage
 - Typical time is 11 months, which Appellants can do its part to shorten
- The average duration of an appeal after PTAB docketing is approaching 12 months.
 - PTAB Fast-Track Pilot Program goal: issue decision within 6 months

Questions and comments

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