

UNITED STATES
PATENT AND TRADEMARK OFFICE



Patent Trial and Appeal Board (PTAB) basics and priorities

Scott Boalick, Chief Administrative Patent Judge

Jacqueline Bonilla, Deputy Chief Administrative Patent Judge

Georgianna Braden, Lead Administrative Patent Judge

May 7, 2025



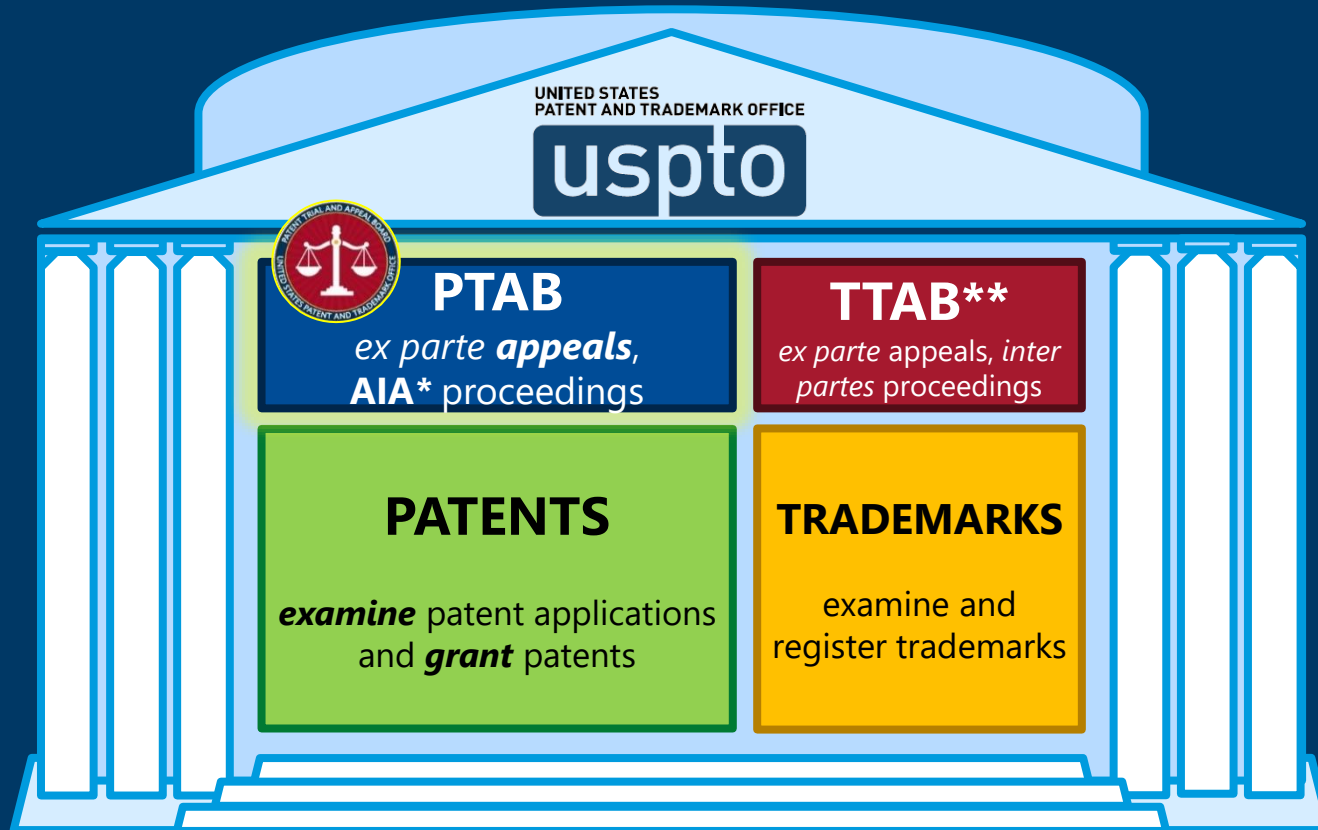
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Question/comment submission

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What is the Patent Trial and Appeal Board?



What is the PTAB?

- A neutral administrative adjudicatory body (known as the “**Board**”) within the United States Patent and Trademark Office
- Created on September 16, 2012, by the **America Invents Act** (AIA)
 - The **Patent Trial and Appeal Board** was previously the Board of Patent Appeals and Interferences (BPAI)
 - The Board (called different things over the years) has a long history that goes back to 1861



Who issues decisions at the PTAB?

- Just under 200 **administrative patent judges** (APJs)
 - In 5 different offices nationwide
 - All APJs are both legally and technically trained—All have extensive experience in patent law, coming from law firms, in-house counsel at companies, DOJ, USPTO, and ITC, etc.
- The Board further comprises four statutory members
 - The **Director** of the USPTO
 - The **Deputy** Director
 - The **Commissioner** for **Patents**
 - The **Commissioner** for **Trademarks**



What does the PTAB do?

- **Decides *ex parte* appeals** filed by patent applicants dissatisfied with a patent examiner determination to reject a patent application
- **Conducts proceedings under the AIA**, based on challenges to issued patents by third parties

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The basics of *ex parte* appeals

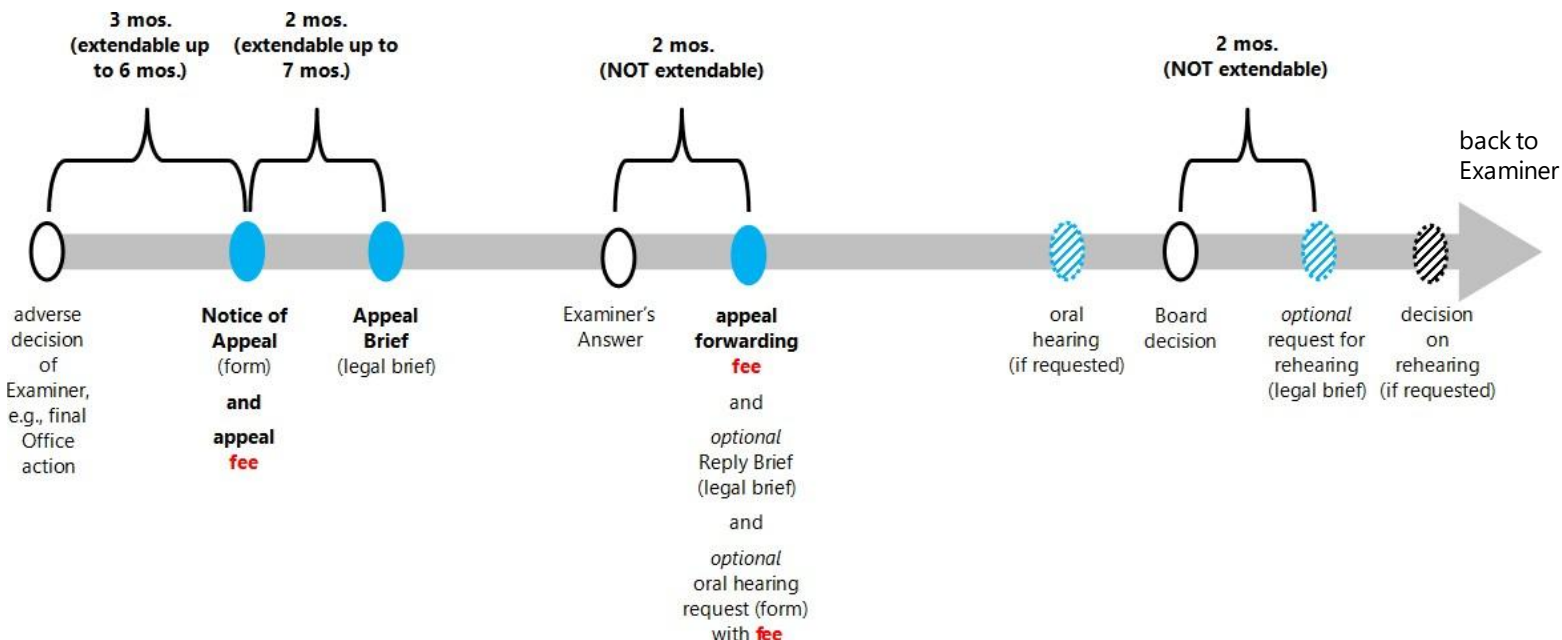
What are *ex parte* appeals?

- 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 can seek review by the PTAB

What are *ex parte* appeals (cont.)?

- Begins with an “**appeal brief**” filed by appellant
- Examiner files an “**answer**”
- Appellant may file a “**reply**” (not always filed)
- A **panel** of at least three administrative patent judges (or statutory members) decide the appeal

Ex parte appeal process



Source: 37 C.F.R. § § 41.31-54; MPEP §§ 1204-1214.

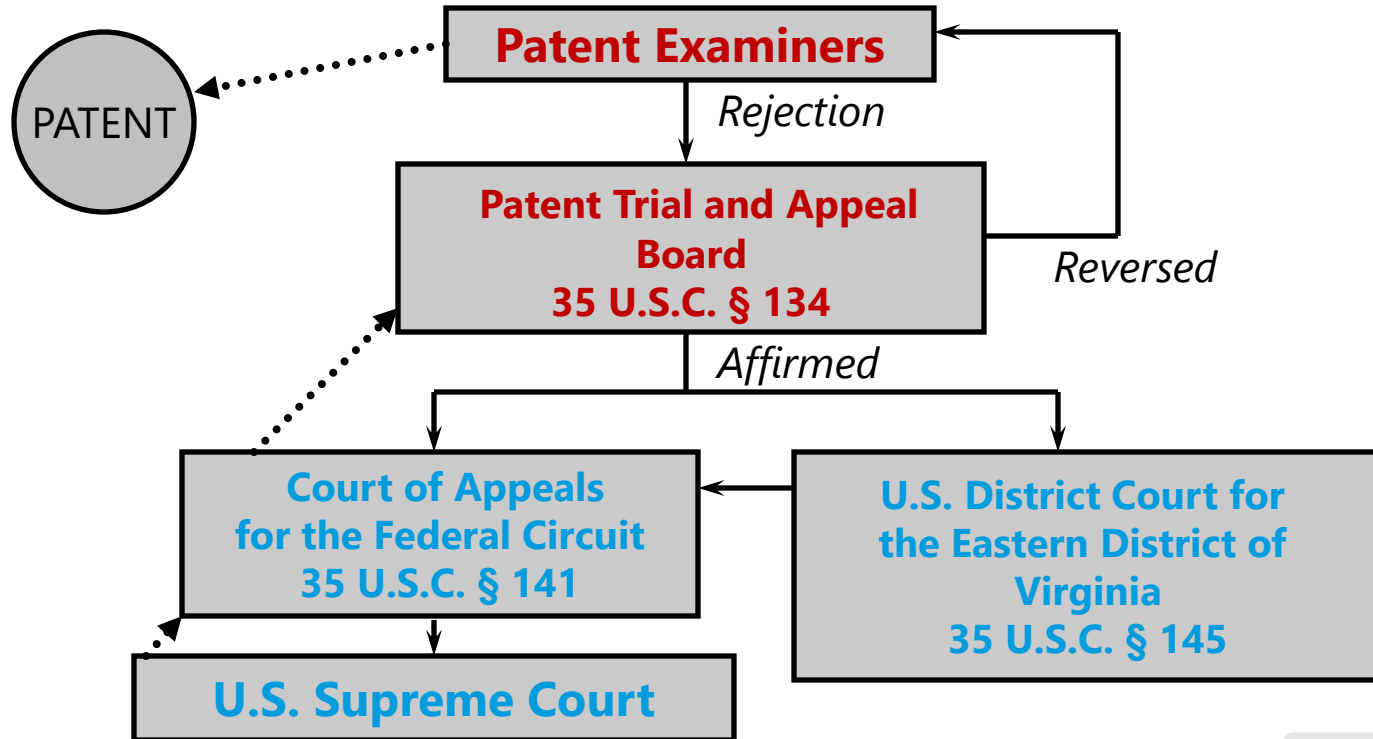
Sources of Law and Guidance

- Law of the U.S. Supreme Court and U.S. Court of Appeals for the Federal Circuit
- 35 U.S.C. (Patents)
- 37 C.F.R. Part 41
- Precedential PTAB decisions
- Director guidance and memoranda

What are the possible outcomes?

- The outcome may be an affirmance, an affirmance-in-part, a reversal, or new ground(s) of rejection
 - **Affirmance**: rejection of each and every claim is upheld
 - **Affirmance-in-part**: rejection of at least one claim, but not all, is upheld
 - **Reversal**: None of the examiner's rejections are upheld
 - **New ground(s) of rejection**: Judges issue a new rejection of one or more claims

The *ex parte* appeal process



What happens after an appeal?

- The outcome dictates who is responsible for taking the next step
 - If the outcome is an **affirmance or new ground(s)** of rejection, the **applicant** must take the next step
 - If the outcome is an **affirmance-in-part**, the **applicant** may take the next step
 - If the outcome is a **reversal**, the **examiner** will take the next step

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The basics of proceedings under the AIA

AIA proceedings are intended to:

- Increase the integrity of the patent system
- Act as an alternative vehicle for third parties to challenge patents, via a **streamlined**, **efficient**, and **cost-effective** proceeding
- Be decided by administrative judges with **expertise** in complicated technology and areas of law
- Provide **fast resolutions** of disputes



Types of AIA proceedings

Post-Grant Review (PGR):

- Limited 9 month window of time to challenge
- Broader range of challenges available compared to IPR

Inter Partes Review (IPR):

- Can challenge patents throughout their lifespan (after 9 months)
- Limited grounds of challenge compared to PGR
 - Only on grounds under 35 U.S.C. § 102 or § 103 and only on the basis of prior art consisting of patents or printed publications

Derivation:

- Window of time to challenge = 1-year from claim publication
- Petition alleges another derived invention from the correct inventor



Who can file an AIA proceeding?

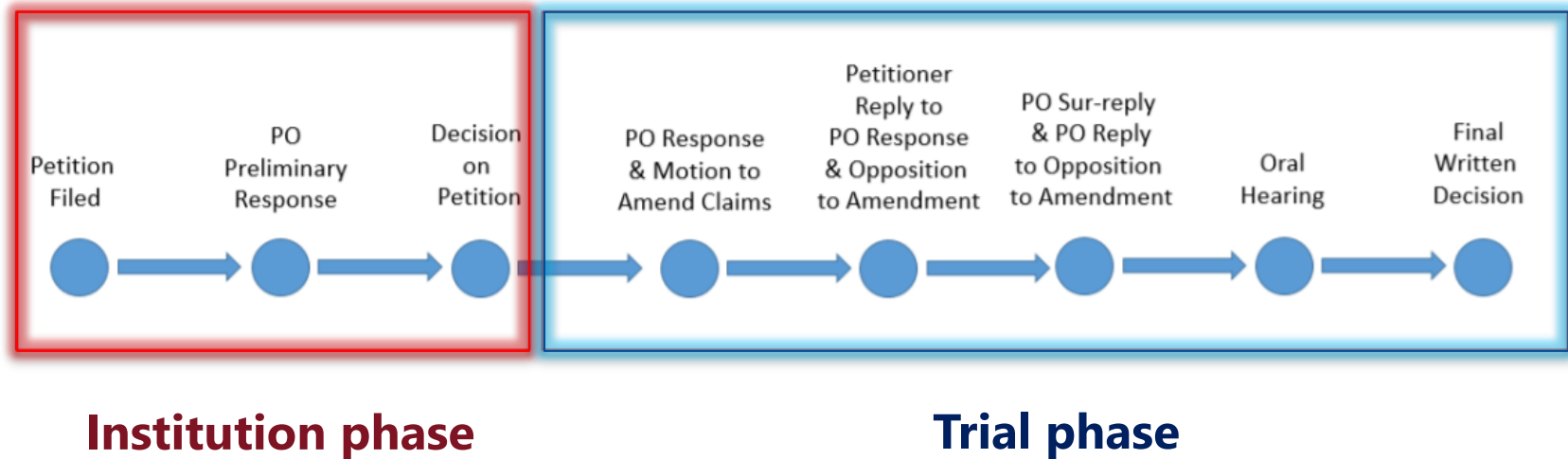
- **Most people** or **corporate entities** other than the patent owner can file a “petition”
 - Petition fee is required to file
- U.S. government cannot
- Certain people or corporations may be barred from filing based on actions they take

Who is involved in an AIA proceeding?

- **Petitioner** = challenger
 - Files petition challenging a U.S. patent; must pay a filing fee
 - Carries legal burden throughout proceeding to prove claims are not patentable
- **Patent owner**
 - Has opportunities to represent their interests
- **Panel of at least three administrative patent judges**
(or statutory members)



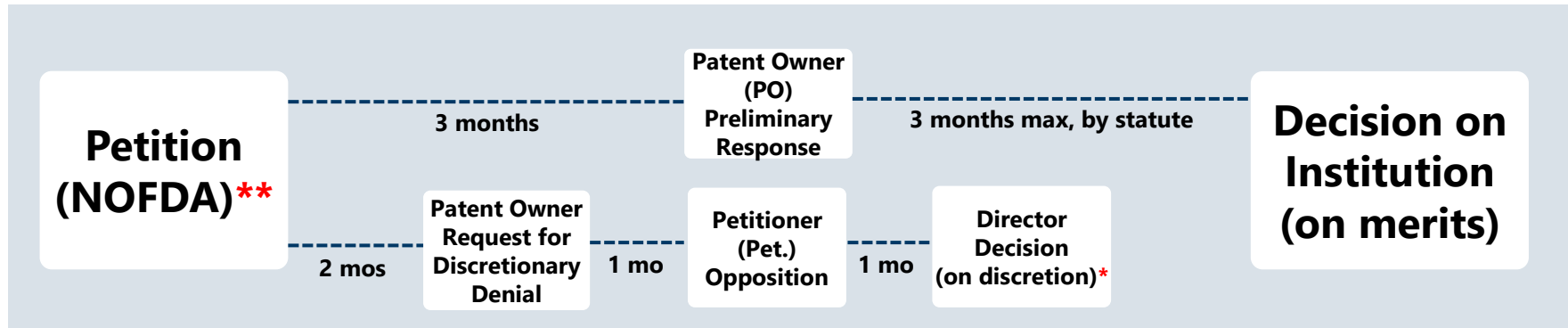
How does an AIA proceeding work?



Timeline: AIA proceedings

Interim processes (March 26, 2025 memorandum)

Preliminary Phase

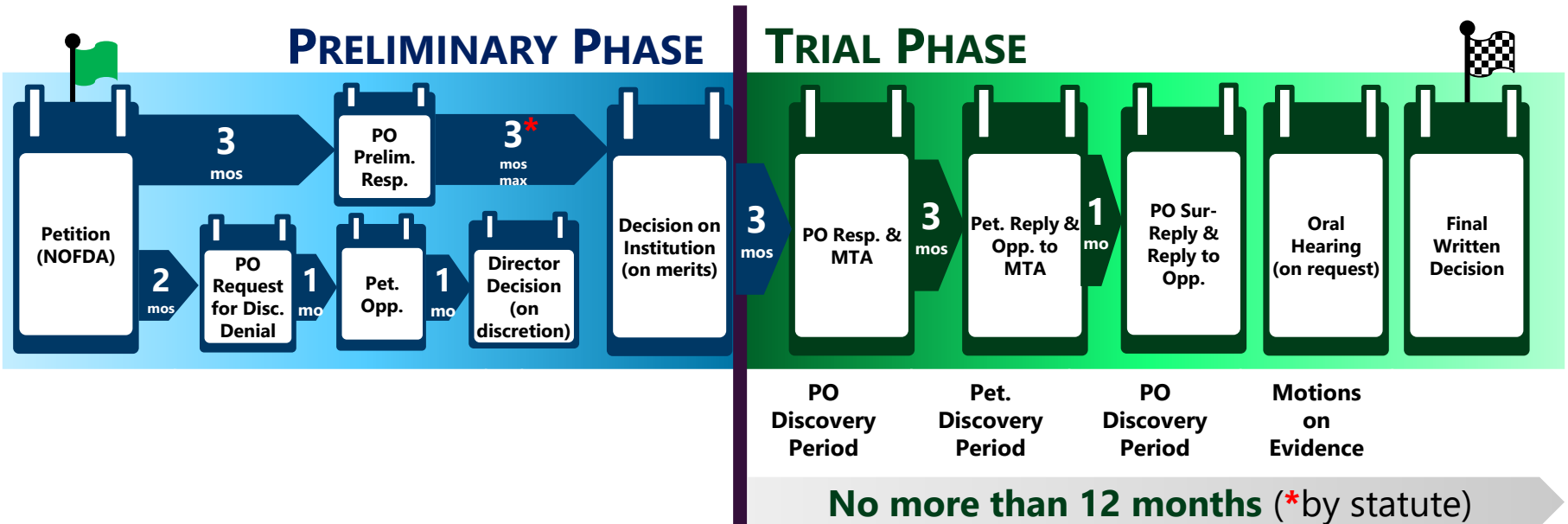


** Notice of filing date accorded

* If the Director does not exercise discretion to deny institution, a Board panel determines whether to institute based on merits

Timeline: AIA proceedings

Interim processes (March 26, 2025 memorandum)



Common motions in AIA proceedings



Sources of Law and Guidance

- 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)
- 37 C.F.R. §§ 42.1-42.412 (rules/regulations for trials in general, and IPRs, PGRs, and Derivation Proceedings)
- Precedential PTAB decisions
- Consolidated Trial Practice Guide, Nov. 2019
- Director guidance and memoranda



Applicability of other federal rules

- **Federal Rules of Evidence**
 - Applies in proceedings expressly by regulation: 37 C.F.R. § 42.62 (but not those for criminal matters)
 - Motions to exclude evidence and expert testimony
- **Federal Rules of Civil Procedure**
 - Do not apply
 - Board has its own rules on discovery

What are the possible outcomes in final written decisions?

- The outcome may be that all challenged claims are upheld, some challenged claims are upheld, or none of the challenged claims are upheld.
 - **All claims patentable**: Each and every challenged claim upheld
 - **Mixed**: At least one challenged claim, but not all, upheld
 - **All claims unpatentable**: No challenged claim upheld

Options for parties after a final written decision

- Seek panel rehearing
- Seek review of the Board's decision by the Director of the USPTO ("Director Review")
- Appeal to the U.S. Court of Appeals for the Federal Circuit

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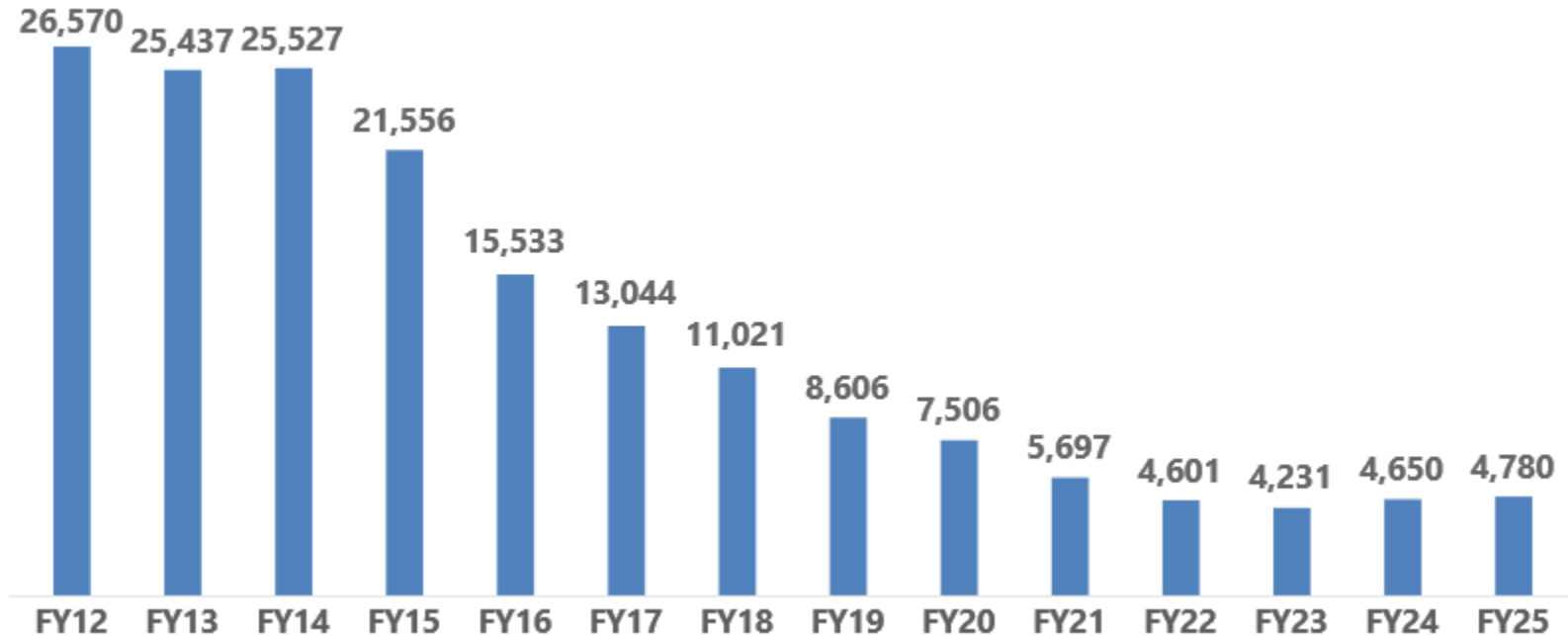
PTAB priorities

PTAB priorities

- Execute all duties as required under 35 U.S.C. § 6
- Maintain high decisional quality
- Reduce pendency of *ex parte* appeals
- Meet all statutory deadlines in AIA proceedings
- IT improvements

Pending appeals FY12 to FY25

(September 30, 2012 – November 30, 2024)



Questions

