

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# PTAB operations today

Chief Judge Scott Boalick

Deputy Chief Judge Jackie Bonilla

Vice Chief Judge Mike Tierney

Acting Vice Chief Judge Michael Kim

May 1, 2020

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# Agenda

- Case management
- CARES Act extension
- Remote hearings

# Question/comment submission

- To send in questions or comments during the webinar, please email:
  - [PTABBoardsideChat@uspto.gov](mailto:PTABBoardsideChat@uspto.gov)

# Case management

# Filings I

- Electronic filing is strongly encouraged for all PTAB proceedings
- Electronic filings should be made as follows:
  - Appeals: use EFS-Web
  - AIA trials: use PTAB E2E
  - Interferences: use Interference Web Portal
- **eSignature on PTAB filings are permitted under 37 C.F.R. 1.4(d)(2)**
  - eSignature = typed name between two forward slashes (e.g., /Dr. James T. Jones, Jr./)

# Filings II

- Due to the ongoing closure of physical facilities, processing of paper filings at USPTO may be affected
- If you submit a paper filing in an AIA or interference proceeding, you should notify PTAB as soon as reasonably practicable by sending an email to [Trials@uspto.gov](mailto:Trials@uspto.gov)
  - Paper submissions in AIA and interference proceedings must be accompanied by a written explanation showing that the USPTO electronic filing systems were unavailable due to technical problems and email systems were down, or that extraordinary circumstances were present

# Service of AIA Trial Petition

- Generally, an AIA petition and supporting evidence must be served on patent owner at the correspondence address of record for the subject patent—see 37 C.F.R. 42.105(a) and 42.205(a)
- Service may be made electronically by email to counsel associated with the correspondence address of record for the subject patent, but there are requirements:
  - Upon agreement of the parties, electronic service of petition and supporting evidence may be served electronically—see 37 C.F.R. 42.105(b) and 42.205(b)
  - Absent agreement, petition must be accompanied by a motion requesting permission to serve petition electronically and explain why electronic service is warranted
  - Petitioner should notify Board of electronic service of a petition and supporting evidence via email to [Trials@uspto.gov](mailto:Trials@uspto.gov)



# Depositions and declarations

- Depositions by video (preferred) or telephone (as back-up if parties agree) are permitted
  - If the parties cannot agree on a videoconference or telephone deposition, the parties should contact Board by joint email at [Trials@uspto.gov](mailto:Trials@uspto.gov)
- An expert or affiant may sign a declaration or affidavit electronically by eSignature under 37 C.F.R. 1.4(d)(2)

# **CARES Act extension**

# CARES Act extension eligibility

- For deadlines in patent applications, reexamination proceedings, and proceedings before the PTAB other than trial proceedings, if an eligible document or fee was or is due between (and inclusive of both) March 27, 2020, and May 31, 2020, the filing will be considered timely if filed on or before June 1, 2020, **provided that** the filing is accompanied by a statement that the delay in filing or payment was due to the COVID-19 outbreak as set forth in the Extended CARES Act notice of **April 28, 2020**.

# CARES Act extensions for appeals

- The following appeal-related filings are eligible for the period of relief:
  - Notice of appeal
  - Appeal brief
  - Reply brief
  - Appeal forwarding fee
  - Request for an oral hearing before the PTAB
  - Response to a substitute examiner's answer
  - Amendment in connection with a new ground of rejection by the PTAB
  - Request for rehearing of a PTAB appeal decision
  - Petition to the Chief Judge

# CARES Act extensions for AIA trials

- 30-day extension of time available for certain AIA trial-related filings:
  - Patent owner preliminary response in a trial proceeding, or any related responsive filings
    - In the event that the USPTO extends a deadline for a patent owner preliminary response or any related filings, the PTAB may also extend the deadlines provided in 35 U.S.C. §§ 314(b) and 324(c).



# CARES Act extensions for AIA trials

- 30-day extension **not available** for statutory deadlines for:
  - Filing AIA petition under either 35 U.S.C. §§ 315(b) or 321(c)
  - Issuing a final written decision, except that such deadlines may be extended for good cause shown for not more than six months, as provided for in 35 U.S.C. §§ 316(a)(11) and 326(a)(11).
    - Good cause may include situations to accommodate parties' requests for extensions due to the COVID-19 outbreak preventing or interfering with a filing or appearance before the Board or, due to such extensions, the Board cannot otherwise meet the one-year deadline

# CARES Act extensions

- For all other situations where the COVID-19 outbreak has prevented or interfered with a filing before the Board, a request for an extension of time can be made by contacting the PTAB:
  - By telephone at 571-272-9797
  - By email at:
    - [Trials@uspto.gov](mailto:Trials@uspto.gov) (for AIA trials)
    - [PTAB Appeals Suggestions@uspto.gov](mailto:PTAB_Appeals_Suggestions@uspto.gov) (for PTAB appeals)
    - [InterferenceTrialSection@uspto.gov](mailto:InterferenceTrialSection@uspto.gov) (for interferences)



# Resources

- CARES Act FAQs:
  - [www.uspto.gov/patent/laws-and-regulations/cares-act-faqs?utm\\_campaign=subscriptioncenter&utm\\_content=&utm\\_medium=email&utm\\_name=&utm\\_source=govdelivery&utm\\_term](https://www.uspto.gov/patent/laws-and-regulations/cares-act-faqs?utm_campaign=subscriptioncenter&utm_content=&utm_medium=email&utm_name=&utm_source=govdelivery&utm_term)

**Remote hearings**

# Remote hearing readiness: generally

- Oral hearings for appeals are telephonic
- Oral hearings for AIA trials are by video or by telephone
- You will receive a Hearing Order with relevant instructions.
  - Appeals: a few days before oral hearing date
  - AIA Trials: ~three weeks before oral hearing date
- If you have any questions or special requests, please contact us at [PTABHearings@uspto.gov](mailto:PTABHearings@uspto.gov)

# Remote Hearing Readiness: Appeals

An oral hearing before a merits panel of the Patent Trial and Appeal Board has been scheduled to be included in the session of hearings commencing **Monday, April 6, 2020 at 1:00PM ET**. A Telephonic Oral Hearing has been granted.

This appeal hearing is set to be heard in a session of oral hearings beginning at **1:00 PM ET**. **PTAB Hearings will provide Appellant with connection information prior to the hearing.** The Board will provide a court reporter and a transcript of the call will be entered into the record. All other expenses involved with the Telephonic Hearing, such as the cost of the call, must be borne by Appellant.

- Please be ready when your session begins
- For more precise timing, contact PTAB Hearings at (571) 272-9797



# Remote hearing readiness: trials

- Please contact PTAB Hearings at (571) 272-9797 five business days prior to the oral hearing date to receive video set-up information
  - A day or two before the oral hearing date, we will contact you to test your connection, and resolve any technical issues

# Best practices for remote hearings

- If at any time during the proceeding, you encounter technical or other difficulties that fundamentally undermine your ability to adequately represent your client, please let the panel know immediately, and adjustments will be made
  - For example, if a party is experiencing poor video quality, the Board may provide alternate dial-in information

# Best practices for remote hearings

- Please unmute yourself only when speaking
- Identify yourself when you speak
- There may be audio lag
  - Please observe a pause prior to speaking, so as to avoid speaking over others
- For best audio quality, please use a headset

# Best practices for remote hearings

- For video, dress as you would for an in-person hearing
- The panel will have access to all papers filed with the Board, including demonstratives
  - For AIA Trials, there will be no shared screens, so please identify clearly and specifically each demonstrative/paper referenced

# Public access

- Public access instruction on PTAB Hearings webpage, under “Hearing Schedule”
  - Until further notice, Patent Trial and Appeal Board (PTAB) oral hearings will be conducted remotely by video or telephone. During this time period, to listen in on any particular oral hearing, please make a request via email to [PTABHearings@uspto.gov](mailto:PTABHearings@uspto.gov). The request should include any request for accommodations for individuals with disabilities, including captioning. The request must be received at least three business days prior to the oral hearing date. The Board will then respond to the request, and also provide any connection information. At a later date, a transcript for each oral hearing will be entered into the record of the relevant proceeding, and will be publicly available in PTAB E2E (<https://ptab.uspto.gov/#/login>) for AIA Trials or in Public Pair (<https://portal.uspto.gov/pair/PublicPair>) for appeals, unless an exception applies.
- [www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/hearings](https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/hearings)
- Audio only; public muted

# Question/comment submission

- To send in questions or comments during the webinar, please email:
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**Thank you!**

[www.uspto.gov](http://www.uspto.gov)