



Minnesota IP Law Association



Schwegman Lundberg & Woessner | slwip.com

USPTO Updates: PTAB Changes and USPTO Programs Useful During COVID-19

Before We Get Started...



Recording

A link to the recording and slides will be emailed to all registrants.



Questions

Type in the question box and we will answer in real time or during the Q&A.



Social

Follow us on LinkedIn or go to SLW Institute on slwip.com to see upcoming and on demand webinars.



Speakers



**Acting Vice Chief
Administrative Patent Judge
Kim**
Patent Trial & Appeal Board



**Senior Attorney
David Buck**
Schwegman Lundberg
& Woessner

Acting Vice Chief Administrative Patent Judge Kim

Patent Trial & Appeal Board

Administrative Patent Judge Michael W. Kim was appointed to the Patent Trial and Appeal Board (PTAB) on April 24, 2011. Judge Kim started his role as acting vice chief judge on November 1, 2019 and was appointed lead judge in 2013. In addition to his management responsibilities, which includes coordinating the PTAB policy on subject matter eligibility and running the Judicial Law Clerk program, Judge Kim has conducted hundreds of inter partes reviews and post-grant reviews under the America Invents Act (AIA), and also reviewed over a thousand adverse decisions of examiners upon applications for patents. He works primarily in the business methods, mechanical, and electrical technology areas. Prior to his appointment, Judge Kim was a patent attorney at the PTAB. Prior to joining the U.S. Patent and Trademark Office (USPTO), Judge Kim was a patent attorney at Finnegan, where he focused on patent prosecution and client counseling, before spending a year traveling the country on a presidential election campaign.

Judge Kim received his law degree from the Duke University School of Law, where he was a founding member of the Duke Law and Technology Review, and holds a Bachelor of Science degree in Mechanical Engineering from the Massachusetts Institute of Technology, where he also hold concentrations in Economics, Political Science, and Writing.



Senior Attorney

David Buck

Schwegman Lundberg & Woessner

David Buck is a registered patent attorney with experience in multiple technology areas including medical devices, automotive, aerospace, HVAC systems and components, fire & security solutions, aircraft propulsion systems, green energy, e-commerce and software implemented systems, manufacturing and repair processes, disk drives, and semiconductors. In addition to his experience drafting and prosecuting patents both foreign and domestic, David has experience with issues of patentability, patent infringement, freedom-to-operate, IP due diligence, and strategic counseling. David received his bachelor's degree in Mechanical Engineering (summa cum laude) from Michigan Technological University in 2003. After graduation, David worked as a general engineer specializing in plastics and composites in Madison, Wisconsin. He received his law degree from Marquette University in 2007. During law school, he worked at Johnson Controls, Inc. in Milwaukee, WI. David is a member of the Minnesota State Bar Association, the Minnesota Intellectual Property Law Association, the Hennepin County Bar Association, and the American Intellectual Property Law Association. He has also presented and written on various topics in IP.



Episode Overview

- PTAB practice changes in view of COVID-19
- Other PTAB updates
- Helpful USPTO programs during a pandemic



Discussion Point 1: PTAB Updates

- Recent Precedential Cases Of Note
- Recent Practice Changes
- Fast Track Appeals Pilot Program



Recent Precedential Opinions

- **Apple Inc. v. Fintiv, Inc., IPR 2020-00019**
- **Hulu, LLC v. Sound View Innovations, LLC, IPR2018-01039**
- **Hunting Titan, Inc. v. DynaEnergetics Europe GmbH, Case IPR2018-00600**
- **Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH, Case IPR2019-01469**



Recent Practice Changes

- Remote Hearing Practices
 - Overview
 - Tips and Advice



Fast Track Appeals Pilot Program

- Updates
- Eligibility requirements
- Granted petition limits
- More Information:
<https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/fast-track-appeals-pilot-program>

Discussion Point 2: Useful USPTO Programs

- Can save you money in most cases
- Can shift time periods when you pay certain fees

Useful USPTO Programs

- Full First Action Interview Pilot Program
- Request for Deferral of Examination
- COVID-19 Prioritized Examination Pilot Program

Full First Action Interview Pilot Program

Applicant is entitled to a first action interview, upon request, prior to the first Office action on the merits. The examiner will conduct a prior art search and provide applicant with a condensed pre-interview communication citing relevant prior art and identifying proposed rejections or objections. Within 30 days of receipt, applicant schedules an interview and submits proposed amendments and/or arguments. At the interview, the relevant prior art, proposed rejections, amendments and arguments will be discussed. If agreement is not reached, the applicant will receive a first action interview Office action that includes an interview summary that constitutes a first Office action on the merits.



Who is eligible for this pilot?

All utility applications in all technology areas are eligible

BUT...



Who is eligible for this pilot?

- Application must contain three or fewer independent claims and twenty or fewer total claims
- Must not contain any multiple dependent claims
- Must claim only a single invention



How it Works

- **Examiner: Follow current restriction policy and practice**
- **Examiner: Conduct a prior art search**
- **Examiner: Follow current policy and practice if a determination of allowability is made**
- **Examiner: Issue a Pre-interview Communication (PTOL-413FP) setting a one month (30 day) time period to request or decline an interview**

- **The time period to respond to the Pre-interview Communication maybe extended for one additional month (30 days).**



How it Works

- Applicant may choose not to interview
- If Applicant schedules interview it will be conducted in a typical manner
 - Applicant may discuss proposed amendments or remarks
- Examiner required to document interview
- Applicant required to document interview



How do I request this pilot?

- Must file a form
 - <https://www.uspto.gov/ebc/index.html>
- And file the form least one day before a first Office action on the merits of the application appears in the Patent Application Information Retrieval (PAIR) system



What is the purpose of this pilot?

- **USPTO stated purposes:**
 - **Promote personal interviews prior to issuance of a first Office action on the merits**
 - **Advance examination of applications once taken up in turn**
 - **Facilitate resolution of issues for timely disposition of an application**
 - **Give applicants more options in regards to the amount of notice and procedure needed**

USPTO Objective One

- **Promote personal interviews prior to issuance of a first Office action on the merits**
 - **Develop a rapport with Examiner**
 - **Potential drawback: Some Examiners do not like interviews**
 - **May want to conduct diligence on Examiner prior to make a request**



USPTO Objective Two

- **Advance examination of applications once taken up in turn**
 - **Clarify questions regarding specification**
 - **Provides a chance to correct any misunderstandings or mistakes**
 - **Allows one to advocate to set the stage for your position in a more informal manner**



USPTO Objective Three

- **Facilitate resolution of issues for timely disposition of an application**
 - **Allows Examiner to raise issues under 112 and 101 that can be addressed at initial stages**

USPTO Objective Four

- Give applicants more options in regards to the amount of notice and procedure needed
 - Provides one with a “feel” for the case
 - Option to abandon case
 - Option to refocus case

Where can I get further information on this pilot?

- USPTO link: <https://www.uspto.gov/patent/initiatives/first-action-interview/full-first-action-interview-pilot-program>
 - Power Point Slide walk through available at website

Deferred Examination

- Filing form PTO/SB/37
- Allows prosecution to be deferred on a plant or utility application up to three years
 - Can specify a lesser period of time



How it Works

- **File the form referenced above**
- **Pay fee under 37 CFR 1.17(i) for request for deferral of examination (\$140 for large entity)**
- **Must rescind any request for non-publication**
- **Third party can trigger examination after publication**

Why would deferring be good for me?

- Search and Examination Fees are deferred
 - Allows flexibility on these payments, cost savings if application is later abandoned
- Good if you are not flying blind (have a search report or want resolution in another jurisdiction as a guide post)

Where can I get further information regarding Deferred Examination?

- USPTO link:
<https://www.uspto.gov/sites/default/files/documents/sb0037.pdf>
- <https://www.jdsupra.com/legalnews/quick-protection-or-flexible-27997/>
- <https://www.ip-watch.org/2009/03/12/inside-views-deferred-examination-a-solution-whose-time-has-come/>



COVID-19 Prioritized Examination Pilot Program

The United States Patent and Trademark Office (USPTO) will accept requests for prioritized examination of up to 500 qualifying patent applications without requiring payment of certain fees associated with prioritized examination. Under this pilot, the USPTO will advance out of turn certain patent applications related to COVID-19 for examination, resulting in their prioritized examination.



Who is eligible for this pilot?

- Applications must contain one or more claims to a product or process related to COVID-19.
- Such claimed product or process must be subject to an applicable Food and Drug Administration (FDA) approval for COVID-19 use.
- The request must include a certification that the applicant qualifies for either small or micro entity status and an executed Application Data Sheet (ADS) meeting the requirements of 37 CFR 1.53(f)(3)(i).



Who is eligible for this pilot?

- **non-continuing, original, nonprovisional utility or plant patent applications filed with an acceptable request to participate**

Or:

- **utility or plant applications, including the national stage of a prior international application, in which an acceptable request to participate has been filed with or after a request for continued examination (RCE), if no prior RCE was granted prioritized examination status.**



Who is eligible for this pilot?

- **Must meet requirements for Track 1 application**
 - **Present no more than four independent claims and 30 total claims**
 - **No multiple dependent claims**
 - **Pay the other required fees (e.g., the basic filing fee, search fee, and examination fee)**



How do I request this pilot?

- Applicants should use [Pilot Program Form PTO/SB/450](#) to request participation in the pilot.





Minnesota IP Law Association



Thank you for your interest.

Questions?



Schwegman Lundberg & Woessner | slwip.com



Minnesota IP Law Association



These materials are for general informational purposes only. They are not intended to be legal advice, and should not be taken as legal advice. They do not establish an attorney-client relationship.



Schwegman Lundberg & Woessner | slwip.com