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Using PTAB-E2E for Post Grant Pilot Applications

How to identify relevant information in AIA proceedings at the Patent Trial and Appeal Board (PTAB)

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Training Overview

- **Goal 1:** to increase awareness of the four new Patent Trial and Appeal Board (PTAB) proceedings established by the America Invents Act (AIA)
- **Goal 2:** to successfully navigate PTAB-E2E and take advantage of the prior art available in AIA proceedings

AIA Proceedings: Overview

On September 16, 2012, the America Invents Act (AIA) established four new Patent Trial and Appeal Board (PTAB) proceedings:

- Inter Partes Review (IPR),
- Post Grant Review (PGR),
- Transitional Program for Covered Business Method Patents (CBM), and
- Derivation (DER).

These proceedings allow third-party petitioners to challenge claims in an issued patent at the PTAB without resorting to litigation.



AIA Proceedings: The Petition

- Each type of AIA proceeding (IPR, PGR, CBM, and DER) begins with **the filing of a petition** for instituting a trial.
- The Post Grant Pilot focuses on IPR petitions.
- For examiners of pending, related applications (i.e., CONs, CIPs, DIVs), there may be prior art in the petition that will lead to a more informed patentability decision in the related application(s).
- Petitions in AIA proceedings are accessed using the Patent Trial and Appeal Board End-to-End system (PTAB-E2E)

How to Access PTAB-E2E

Direct Link: <https://ptab.uspto.gov/#/login>
(Google Chrome Recommended)

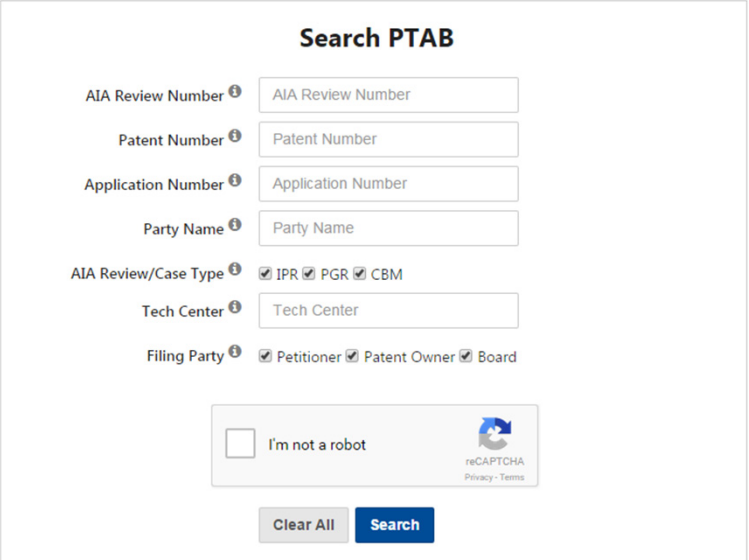
To find a PTAB trial file wrapper, enter one of:

- Trial Number (e.g., IPR2016-123XX)
- U.S. Patent Number or
- U.S. Application Number

of the case undergoing the PTAB proceeding

do NOT use the application number of your related, pending application

Then select "Search"



The screenshot shows the "Search PTAB" form on the USPTO website. It includes input fields for "AIA Review Number", "Patent Number", "Application Number", and "Party Name". There are also checkboxes for "AIA Review/Case Type" (IPR, PGR, CBM) and "Filing Party" (Petitioner, Patent Owner, Board). A "Tech Center" dropdown menu is present. At the bottom, there is a reCAPTCHA "I'm not a robot" checkbox, a "Clear All" button, and a blue "Search" button.



Opening the File Wrapper

Click on View Documents to open the file wrapper:

You are seeing 1 results for Patent Number: sorted by AIA Review Number and Patent Number.

☐ AIA Review

10 records per page

Filter by

AIA Review Number	Filing Date	Institution Decision Date	Patent Number	Application Number	Petitioner	Patent Owner	Status	Tech Center	
IPR2015-	02/27/2015		8.	13			Trial Instituted	2600	View Documents

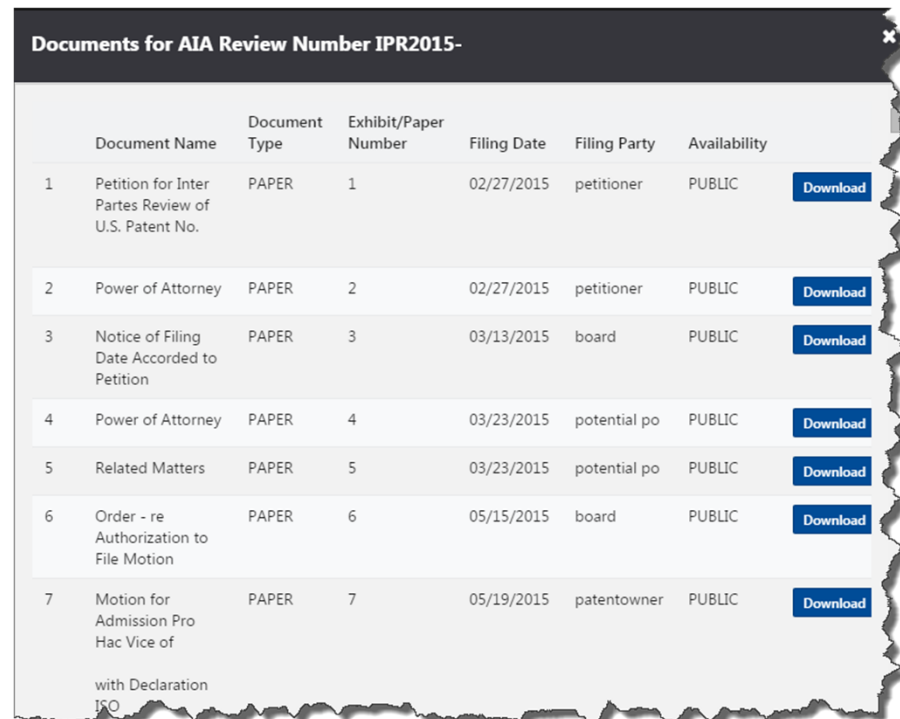
Showing 1 to 1 of 1 entries



Navigating the File Wrapper

The file wrapper lists all the documents of the proceeding. Common categories include:

- IPR Petitions
- Prior art (patents and printed publications)
- Expert declarations
- Related litigation
- PTAB decisions and processing papers
- Miscellaneous (e.g., Power of Attorney)



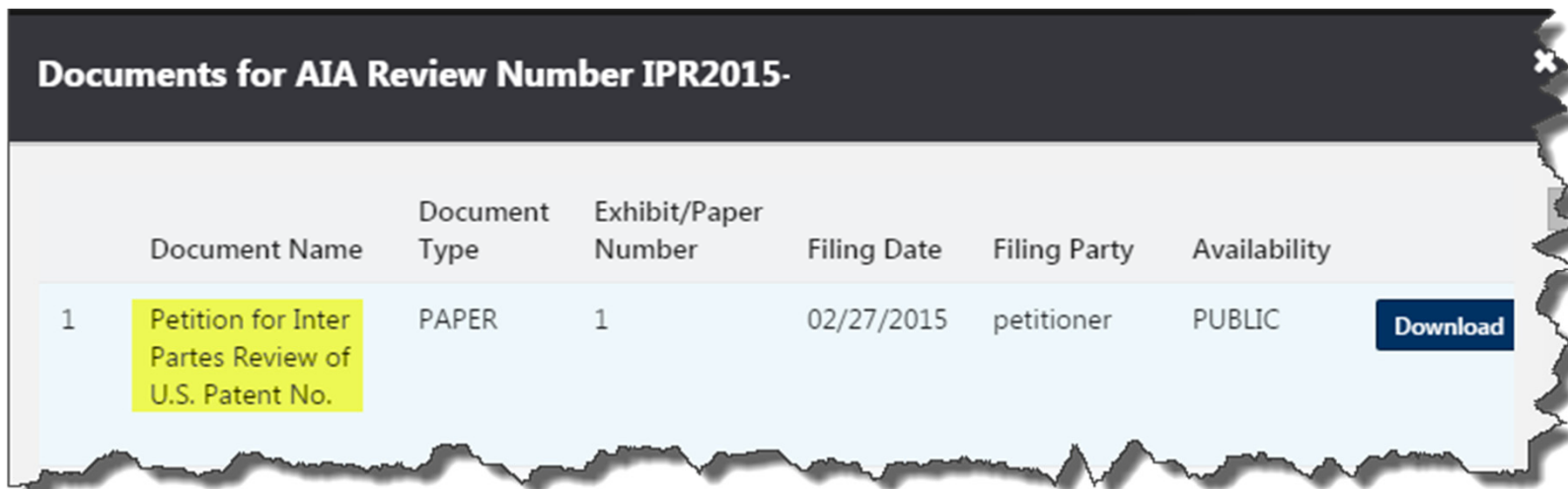
The screenshot shows a web interface titled "Documents for AIA Review Number IPR2015-". It contains a table with 7 rows of document information. Each row includes a document number, name, type, exhibit/paper number, filing date, filing party, and availability. A "Download" button is present for each document. The interface has a dark header and a light gray table background.

	Document Name	Document Type	Exhibit/Paper Number	Filing Date	Filing Party	Availability	
1	Petition for Inter Partes Review of U.S. Patent No.	PAPER	1	02/27/2015	petitioner	PUBLIC	Download
2	Power of Attorney	PAPER	2	02/27/2015	petitioner	PUBLIC	Download
3	Notice of Filing Date Accorded to Petition	PAPER	3	03/13/2015	board	PUBLIC	Download
4	Power of Attorney	PAPER	4	03/23/2015	potential po	PUBLIC	Download
5	Related Matters	PAPER	5	03/23/2015	potential po	PUBLIC	Download
6	Order - re Authorization to File Motion	PAPER	6	05/15/2015	board	PUBLIC	Download
7	Motion for Admission Pro Hac Vice of with Declaration ISO	PAPER	7	05/19/2015	patentowner	PUBLIC	Download

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Accessing the Petition

The Petition is usually among the first documents in the file wrapper. Select Download, and the Petition will open as a PDF.



Documents for AIA Review Number IPR2015-

	Document Name	Document Type	Exhibit/Paper Number	Filing Date	Filing Party	Availability	
1	Petition for Inter Partes Review of U.S. Patent No.	PAPER	1	02/27/2015	petitioner	PUBLIC	Download

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Navigating the Petition

Petitions can be long, but in the Pilot, we are primarily interested in the:

- Exhibit List and
- Detailed Explanations of the Challenges

EXHIBIT LIST	
Exhibit 1001	U.S. Patent No. 8,123,XXX (“the ‘XXX Patent’”)

The Exhibit List features all the documents (e.g., Patents, Printed Publications, expert declarations) being used to challenge the claims in the issued patent.

PDFs of each of the Exhibits are available in the PRPS File Wrapper:

7	U.S. Patent No. 8,123,XXX	Exhibit	1001	1/21/2016	Petitioner	Public
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How to Use the Exhibit List

Examiners are encouraged to review the patents and printed publications in the **Exhibit List** for potential use in the related application they are examining.

Examiners are **not required** to use these references in a prior art rejection in the related application. For example, if the related application is a Divisional or Continuation-In-Part, the claims may be different enough such that the references used in the parent application are only marginally relevant.

However, if the claims in the child application are broader than the parent application, the references used in the parent application may be highly relevant and provide useful information in the patentability determination of the child application.



How to Use the Detailed Explanations of the Challenges

The **Detailed Explanations of the Challenges** is the Petitioner's detailed mapping of the references from the Exhibit List to the challenged claims of the patent.

Examiners may find this mapping useful information in the patentability determination of the child application.

A. Grounds 1: Claims 1 & 2 are Obvious Over Smith in View of Jones, O'Connor 'XXX, or Sullivan, and in View of van Helsing 'YYY)

i. Claim 1

Claim 1 is directed to a system comprising a canalphone housing, two LFDs carried within the canalphone housing, two MFDs carried within the canalphone housing, and two HFDs carried within the canalphone housing, with three functional limitations directed to the HFD. Ex. 1001, col. 5:64-6:18.

Questions?

- PostGrantOutcomes@uspto.gov



