

United States Patent and Trademark Office



The Patent Trial and Appeal Board

Guide to the administration
of oral hearings before the
Patent Trial and Appeal Board

October 15, 2020

UNITED STATES
PATENT AND TRADEMARK OFFICE

uspto

Table of Contents

Overview	3
Purpose	3
What is the hearings team and how do they support hearings?	3
Comments/concerns	3
Requesting oral hearing before the PTAB	3
Ex parte and reexamination appeals	3
AIA trials	3
Legal Experience and Advancement Program (LEAP)	4
Paneling hearings	5
Scheduling hearings	5
Notification of a hearing	6
Ex parte and reexamination appeals	6
AIA trials	7
Public admission	8
Hearing room decorum	9
Parties appearing before the board	9
Use of demonstratives	9
Helpful tips when presenting oral argument before the PTAB	9
Hearing facilities	11
Inclement weather	12
Frequently asked questions	13
How do I cancel my request for an ex parte oral hearing?	13
Can I request a video or telephonic hearing after I have already confirmed my in-person attendance?	14
Can inventors or members of the public listen to oral hearings electronically?	14
Can I present an oral argument from one of the PTAB's regional office locations?	14
Would it be helpful to the panel if I provide a copy of written materials for the hearing?	14
I want to use demonstratives (e.g., a flip chart or a PowerPoint presentation) during arguments; does the PTAB have equipment that can be set up so that I can make the presentation?	15

Can I request that my hearing be rescheduled or postponed?	15
Who can present arguments at the oral hearing?	16
Can state licensed attorneys who are not registered to practice before the USPTO present oral argument?	16
How much time is designated to present oral argument?	16
Can inventors accompany the registered patent practitioner of record during the appeal hearing?	16
Can a party request that an unaccompanied registered patent practitioner not of record present at the oral argument?	17
Can an inventor who is unrepresented by a registered patent practitioner represent themselves and present oral arguments?	17
Do I have to notify the PTAB if the registered practitioner of record who will be presenting arguments is different from the one who signed the Notice of Hearing's attendance confirmation?	17
I am involved in an inter partes reexamination in which the patent owner and a third party requestor have both timely requested oral hearings in relation to our respective appeal and cross-appeal. Does each side get 30 minutes argument time total or 30 minutes for each of the appeal and cross-appeal (60 minutes total)?	17
How do I request additional argument time for an ex parte appeal hearing?	18
Can an oral hearing fee be refunded?	18
I received an Order Denying Oral Hearing in an ex parte proceeding. How do I request reconsideration and/or petition this order?	18
Will a written transcript of an oral hearing be available?	18

Hearings guide definitions of key terms	19
--	-----------

Overview

Purpose:

The Patent Trial and Appeal Board (PTAB) has prepared these materials to aid parties and counsel in preparing for and participating in oral argument before the PTAB.

Note: This manual does not supersede or interpret law or regulation governing the legal aspects of the PTAB proceedings. This manual addresses those policies and administrative procedures governing oral hearings before the PTAB and provides practitioners with additional information and instructions to navigate the procedural requirements. This manual is a supplement to the PTAB Trial Practice Guide and is meant to be read in conjunction with that document. This manual does not have the force of law. The PTAB may modify certain guidelines as needed to meet agency or stakeholder needs.

What is the hearings team and how do they support hearings?

The PTAB hearings team falls under the Case Management Branch of the PTAB and is located in Alexandria, Virginia, with contracted support in each regional office location. The hearings team administratively supports all proceedings before the PTAB by sending out hearing notices, scheduling hearings, coordinating court reporting, and providing hearing room support. They coordinate the use of audio-visual equipment and ensure it is in working order to facilitate the use of PowerPoint presentations. The hearings team also coordinates telephonic and video hearings.

Comments/concerns:

The hearings team encourages you to provide any feedback, positive and negative, to ChiefClerkPTAB@uspto.gov. Please limit your responses to concerns that directly support administrative processes. For example, comments should not include any requests regarding your interest in a specific proceeding. We solicit comments on what administrative support we are providing well, what we can do better, and what procedures we could discontinue or implement.

Requesting oral hearing before the PTAB

The PTAB is responsible for conducting trials, including inter partes, post-grant, and covered business method patent reviews and derivation proceedings; hearing appeals from adverse examiner decisions in patent applications and reexamination proceedings; and rendering decisions in interferences. In accordance with 35 U.S.C. § 6(c), panels of administrative patent judges (APJs) are responsible for adjudicating these cases. Each case shall be heard by at least three members of the PTAB, who shall be designated by the chief judge under authority delegated by the director.

Ex parte and reexamination appeals

When the PTAB receives an appeal, the intake database system assigns an appeal number that is directly associated with the application number. The appeal number can be used internally to track the appeal from start to finish. Generally, ex parte proceedings are decided on a first-in/first-out basis.

In accordance with 37 CFR § 41.47(b) (ex parte and reexamination appeals) and 37 CFR § 41.73(b) (inter partes reexamination appeals), a Request for Oral Hearing must be filed as a separate paper (not within the Notice of Appeal or any other paper). The **required fee**, as set forth in 37 CFR § 41.20(b)(3), must be paid within the appropriate time period as set forth in 37 CFR § 41.47(a) (ex parte appeals) or 37 CFR § 41.73(a) (inter partes reexamination appeals). The time for requesting an oral hearing cannot be extended.

If a party receives an Order for a Non-Compliant Request for Oral Hearing, the party will need to file a petition under 37 CFR § 41.3 and the requisite fee under 37 CFR § 41.20(a) requesting that the hearing request be accepted. Such petition is due within 14 days from the Order. See 37 CFR § 41.3(e). The chief judge or his/her designee will decide the petition. If the petition is denied, a refund of the fee for filing a request for oral hearing will not be granted.

If the request and fee are not filed as set forth above, the case will be assigned for consideration and the decision will be based on the briefs without an oral hearing. Appeals decided on the briefs are given the same consideration by the PTAB as appeals decided after an oral hearing. See 37 CFR § 41.47(a), § 1.73(c).

AIA trials

For AIA trials, a party may request oral argument on an issue raised in a paper, at a time set by the PTAB. The request must be filed as a separate paper and must specify the issues to be argued. See 37 CFR § 42.70(a). The APJ(s) handling the matter will notify the parties of the hearing date and time by order issued by the PTAB.

Legal Experience and Advancement Program (LEAP)

The Board has established the Legal Experience (LEAP) to foster development of the next generation of patent practitioners by creating opportunities to gain the proper skills and experience in oral arguments before the Board. The Board defines a LEAP practitioner as having three (3) or fewer “substantive” oral hearing arguments in any federal tribunal, including PTAB, and seven (7) or fewer years of experience as a licensed attorney or patent agent.

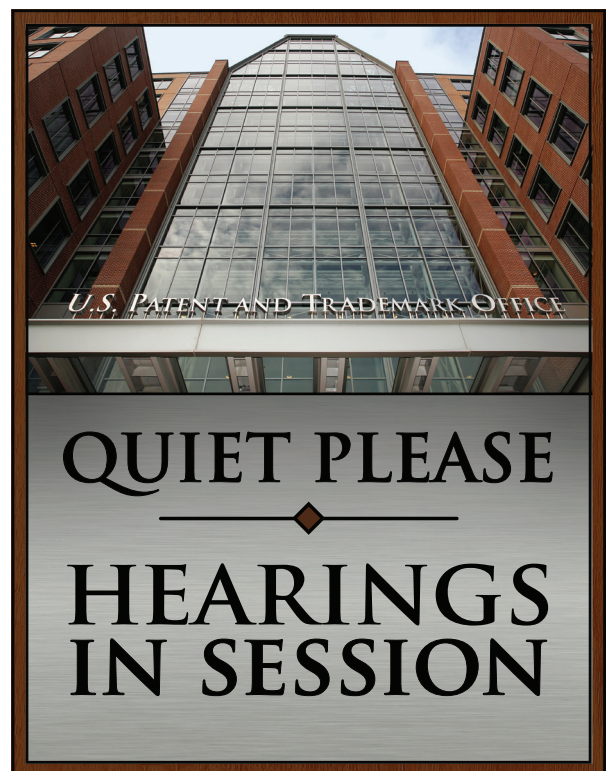
Parties before the Board are encouraged to participate in LEAP through which LEAP practitioners conduct at least a portion of an oral hearing. In exchange, the Board will grant up to fifteen (15) minutes of additional oral argument time to that party.

Parties may request to participate in LEAP by emailing PTABHearings@uspto.gov at least five (5) days before the hearing. In every case, the LEAP practitioner shall verify eligibility for the program by filing a completed verification form into the record. Parties may obtain more information about how to participate in LEAP by visiting our [LEAP website](#), which provides a sample combined request and verification form.

A LEAP practitioner may conduct the entire argument or may share time with other counsel, provided that the LEAP practitioner is offered a meaningful and substantive opportunity to argue before the Board. The party has the discretion as to the type and quantity of oral argument that will be conducted by the LEAP practitioner. Moreover, whether the LEAP practitioner conducts the argument in whole or in part, the Board will permit more experienced counsel to provide some assistance to the LEAP practitioner, if necessary, during the hearing, and to clarify any statements on the record before the conclusion of the hearing. Importantly, the Board does not draw any inference about the importance of a particular issue or issues, or the merits of the party’s arguments regarding that issue, from the party’s decision to have (or not to have) a LEAP practitioner argue.

In instances where an advocate does not meet the LEAP eligibility requirements, either due to the years of experience as a licensed attorney/patent agent or the number of “substantive” oral hearing arguments, but nonetheless has a basis for considering themselves to be in the category of advocates that this program is intended to assist, the Board encourages argument by such advocates during oral hearings. Additional argument time will not be provided in such circumstances, however, as with LEAP, a party may request to share time with counsel and the Board will permit more experienced counsel to provide some assistance. If necessary, during oral argument, and to clarify any statements on the record before the conclusion of the oral argument.

As always, all practitioners appearing before the Board shall demonstrate the highest professional standards. All practitioners are expected to have a command of the factual record, the applicable law, and Board procedures, as well as the authority to commit the party they represent.



Also available as part of the eCourse

[2021 Advanced Patent Law \(USPTO\) eConference](#)

First appeared as part of the conference materials for the
16th Annual Advanced Patent Law Institute session

"Best Practices for Ex Parte Appeals"