UNITED STATES
PATENT AND TRADEMARK OFFICE

Advocacy in ex parte appeals

September 3, 2020

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PATENT AND TRADEMARK OFFICE
uspto

Agenda

- Appeal pendency
- Fast-track appeal pilot
- Advocacy in ex parte appeals

Question/comment submission

- To send in questions or comments during the webinar, please email:
  - PTABBoardsideChat@uspto.gov

Appeal pendency

Question/comment submission

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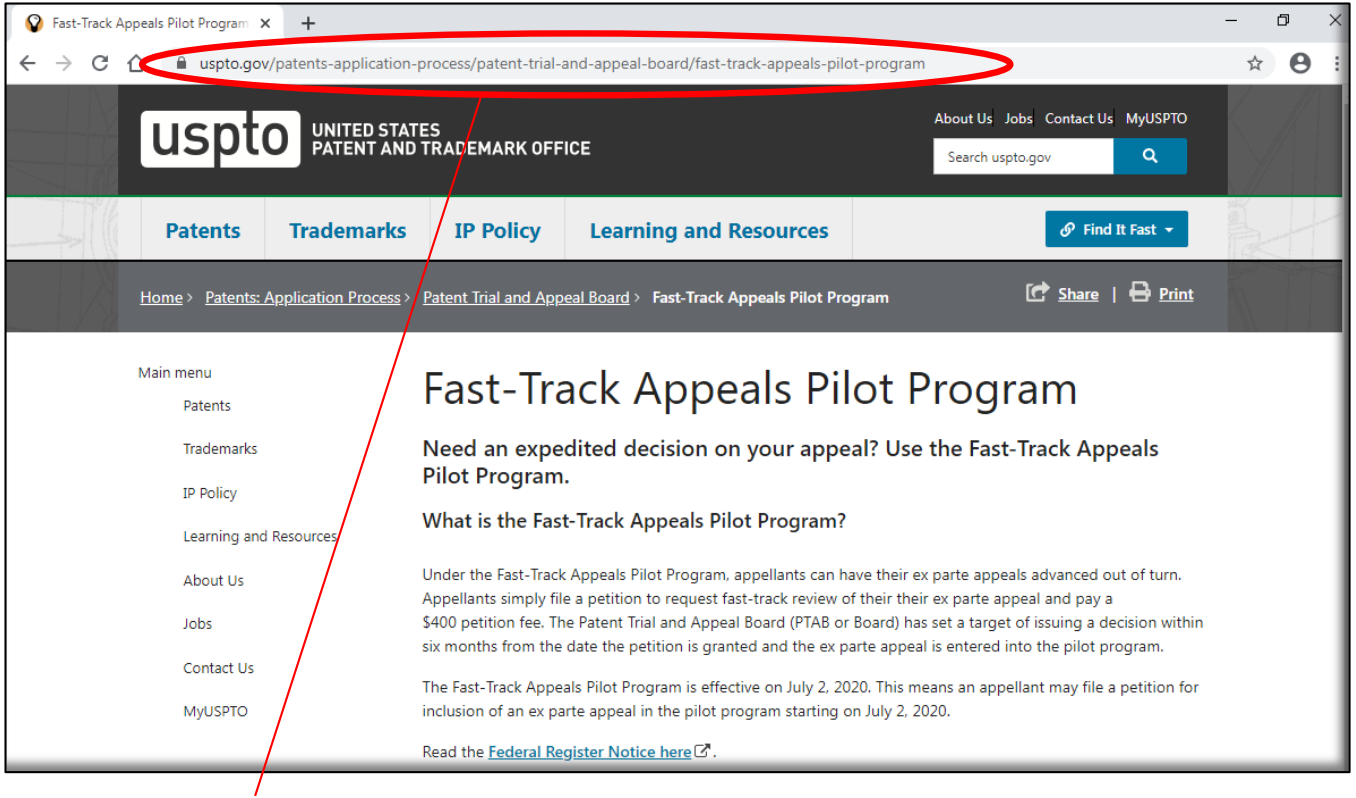
Fast-Track Appeals Pilot Program

Overview

- One-year pilot starting July 2, 2020.
- $400 fee.
- Six-month pendency goal.
- 125-granted-petition limit per quarter (500 total).
- Hearings permitted, with some restrictions.

Fast-Track webpage



www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/fast-track-appeals-pilot-program

Further information

- Federal Register notice:
  - www.federalregister.gov/documents/2020/07/02/2020-14244/fast-track-appeals-pilot-program
- Frequently asked questions:
  - www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/fast-track-appeals-pilot-program

Advocacy in ex parte appeals

Topic 1: Storytelling

- Understand your audience.
- An effective introduction is key.
- Frame your arguments as a story.
- Provide the APJ a roadmap through the material.
- Provide a short primer on the technology.
- Lay out any real-world impact and importance.
- Explain the prosecution in a thematic manner.
- Do not provide pages of case law divorced from facts.
- Use drawings, annotations, tables, and sub-headings.

Storytelling: effective example

V. Brief Discussion of Exemplary Embodiment

To help the understanding of the application, Applicant will now discuss the exemplary embodiment described in the present application. . . The home network gateway stores information relating to requests received via a home network. The home network gateway uses the stored information as part of determining whether to supply content in response to a second request for content to the requesting device. If based on information included in the second request and information about a previous request, e.g., a first request stored in memory, the home network gateway determines that the source, e.g., sender, of the first and second messages is the same the requested content is provided in response to the second request.

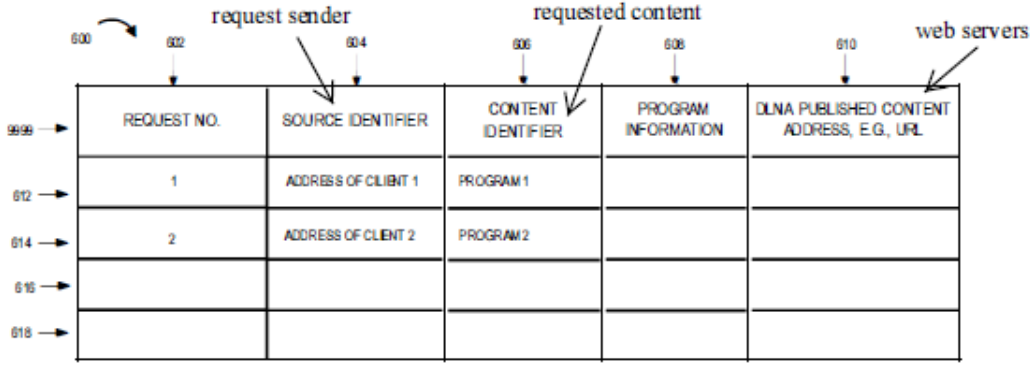


FIGURE 8

Storytelling: effective example

Accordingly, to try and identify precisely what the Examiner considers to be the "first video on demand service request message" Applicant reviewed the Examiner cited paragraphs.

Paragraph [0149] of the E281 reference

Paragraph [0157] of the E281 reference

Paragraph [0171] of the E281 reference

Paragraph [0179] of the E281 reference

Appellant quoted each cited paragraph to show that either the reference did not mention a "request message" or the message was not a request from a client, as claimed.

Storytelling: less effective example

- Technology: computer security and malicious code detection.
- Appellant filed a “template” brief that included all of the required sections without adding any context and with little effort on actual argument.
- Arguments mostly cut and paste from the OA Response
  - “The appellant respectfully reminds the examiner and the Board that to establish a prima facie case of obviousness, three basic criteria must be met . . .”

Storytelling: less effective example

Argument #1 For example, assuming *arguendo* that Griffin teaches the claimed "disassembling an object under analysis," the Examiner nevertheless admits that Griffin does not teach "comparing the assembly language listing to a known object, the known object belonging to a family in an object taxonomy." The Examiner relies on Oliver for this element. But the cited portion of Oliver teaches string matching to classify the "suspect file" (i.e., not a disassembled subroutine). The Examiner's rejection ought to be reversed on this basis alone: the matching in the claim is not the string matching described by Oliver.

Again, the Examiner admits that neither Oliver nor Griffin teaches the claimed "call tracing" or "fuzzy fingerprinting." Thus, the Examiner brings in two additional references to allegedly teach the missing elements.

Argument #2 Specifically, the Examiner brings in Alme to teach fuzzy fingerprinting. However, Alme teaches fuzzy fingerprinting of a malware *file*, not a fuzzy fingerprint based on a call trace of an assembly listing, and "identifying a known malicious subroutine or function within the call trace," as in the claims.

Argument #3 As to the "call trace" limitation, the Examiner relies on Keohane. But Keohane at best teaches that call traces exist—not that they are useful for computing a fuzzy fingerprint of a malware subroutine.

Argument #4 In short, the Examiner has merely assembled a pile of references that *at best* teach that disassembly exists, that object taxonomies exist, that (string) matching exists, that fuzzy fingerprints exist, and that call traces exist. Even granting, *arguendo*, that these references teach those things, the Examiner has failed to show how these references *interact* with one another to teach the system as claimed, or that they are properly combined—other than the Examiner's own conclusory statement that each of these references exist in "the same field of art."

Topic 2: Claim grouping

- Appellant may or may not indicate that the dependent claims stand or fall with the independent claim(s).
- In cases where appellant groups the claims, the Board selects a representative claim and states that the remaining claims stand or fall with the representative claim. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Claim grouping: effective example

- Independent claim: A hybrid fuel airplane comprising an aft pressure bulkhead and a cryogenic fuel tank, the **cryogenic tank being located behind the aft pressure bulkhead**.
- Appellant cited to portions of the reference regarding the location of the fuel tank being located between the main landing gear wheel and the Auxiliary Power Unit.
- Appellant also noted the reference does not explicitly disclose an aft pressure bulkhead let alone the fuel tank's location with respect to an aft pressure bulkhead.

Claim grouping: less effective example

- Independent claim: The multi-layer film member comprises a **pattern . . .**
- Dependent claim: The multi-layer film member comprises an **embossed pattern . . .**
- The examiner found a "textured" pattern and an "embossed" pattern to be similar and/or equivalent despite the specification's differentiation between a "textured" pattern and an "embossed" pattern.
- The examiner applied prior art directed to a "textured" pattern.
- The examiner's reasoning to modify the primary reference with the "textured" pattern of the secondary reference was the same reasoning described by appellant in the specification for providing an "embossed" pattern.

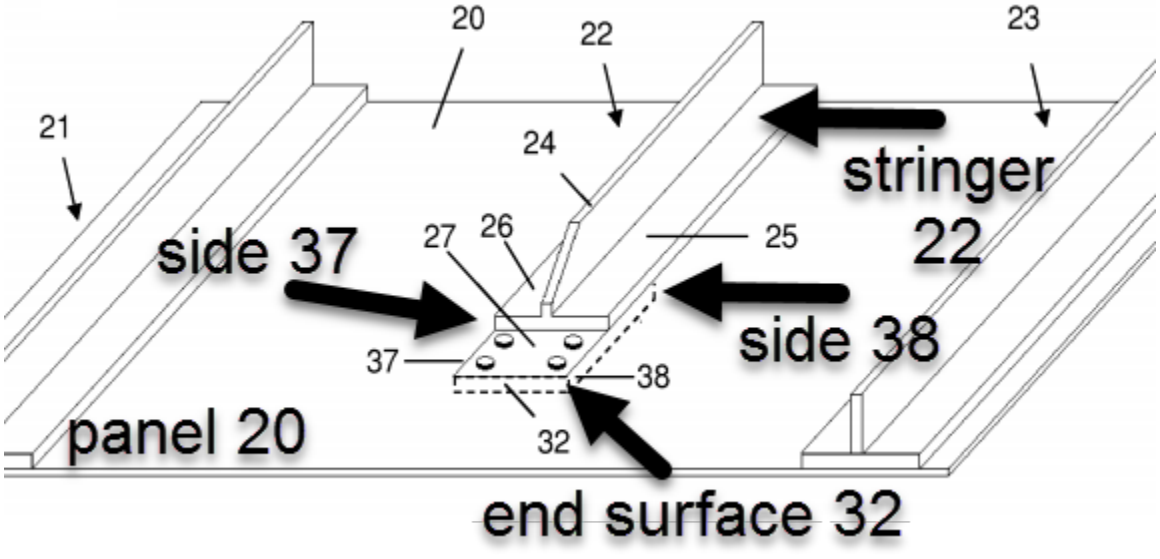
Topic 3: Claim construction

- Sometimes issues in an appeal turns on how the claimed term should be interpreted.
- In these cases, it can be helpful to expressly state how the term should be interpreted and the basis for that interpretation.

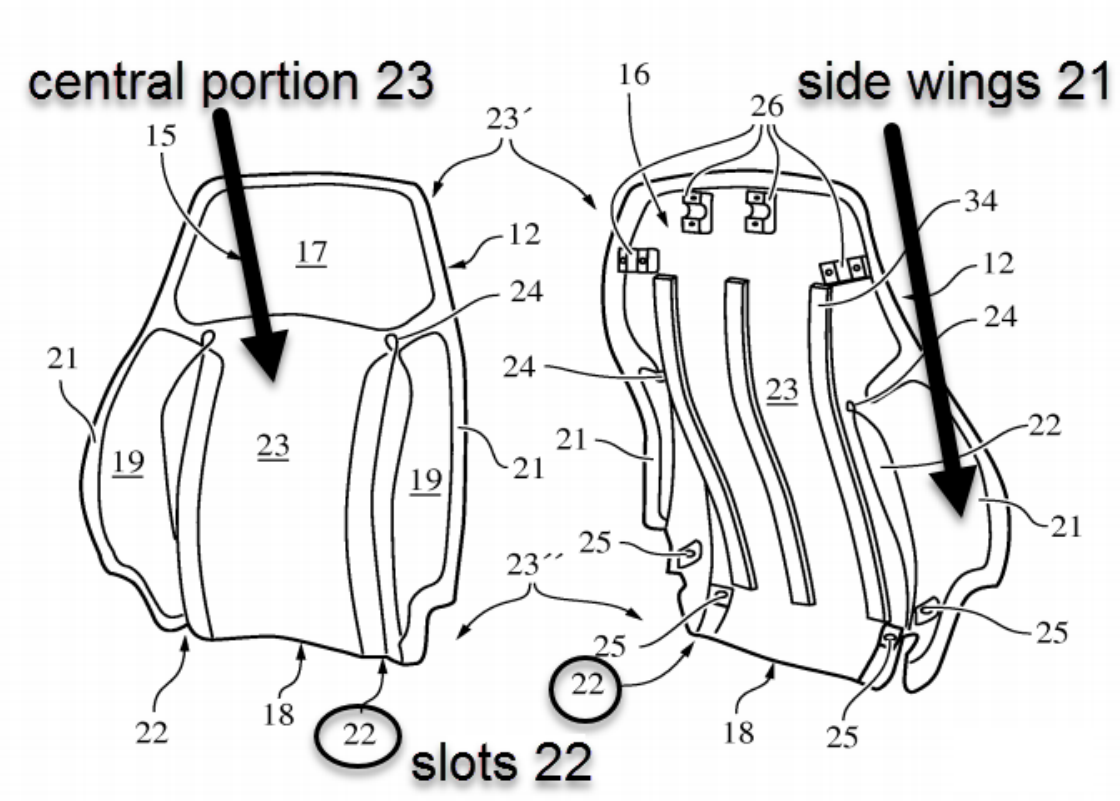
Topic 3: Claim construction

- DO:
  - Define the disputed term
  - Identify support for this view
  - Explain why the examiner's interpretation is incorrect
- DON'T:
  - Fail to provide an interpretation or support for the disputed term
  - Forget to address any clarified claim construction of terms set forth in the answer

Claim construction: effective example



Claim construction: less effective example



Topic 4: Point out examiner error

- Clearly address the examiner's rejection *as articulated* and point the Board to what you think is the error in that rejection.
- Refer to the specific portion of the rejection, block quote it if necessary.
- Refrain from personal attacks
  - "the examiner has no idea"
  - the examiner made a "multitude of unfair or misleading representations of authority including the MPEP, the inaccurate statements about important cases, and selectively created new 'tests' from Supreme Court precedents "
  - "Appellant makes no suggestion that the Examiner has done anything in bad faith, but . . . "

Point out examiner error: effective example

- Technology: thermography of gas turbine engine components.
- Appellant used a simple analogy to explain examiner error.
- A hypothetical claim for a "mousetrap comprising a metal base, wherein a bait comprises cheese."
  - Examiner found *Reference A* discloses a mousetrap and a bait, but failed to disclose "a mousetrap comprising a metal base, wherein the bait comprises cheese."
  - Examiner relied on *Reference B* as describing "metal"
  - Examiner relied on *Reference C* as describing "cheese"

Point out examiner error: less effective example

Appellants respectfully contend that the cited portions of the references, alone or in combination, fail to teach or suggest at least the claim features recited above (and the claims that depend therefrom). The Final Action admits that *Kaufman* does not disclose the claimed features emphasized above but alleges that *Maerz* discloses the above features. However, *Maerz* and *Glover* fail to cure the deficiencies in *Kaufman*. For example, the cited portions of *Maerz* (paragraphs [0037], [0038], [0080]-[0083] describes a **POPS basket as containing a group of Pilots** (paragraph [0077]), which is **not** the same as a **security bundle that includes securities and an index to a future revenue** recited in the current claims. Accordingly, Appellants respectfully submit that the claims are patentable over the cited portions of the cited references for at least the above reasons.

Topic 5: Arguments structure

- Present only the strong arguments
- Remove or strengthen weaker arguments
- Make strongest arguments first
  - E.g., clear error; an argument that applies to all claims

Strongest first: effective example

- Technology: identifying orphaned luggage.
- Several rejections were at issue.
- However, on the 103 rejection, appellant argued set forth its strongest argument regarding a missing limitation.

Strongest first: less effective example

- Technology: well bore
- Finding a dispositive argument that applies to several rejections buried at page 24 of the appeal brief.

Strongest first: illustration

Orphaned luggage arguments

1. Strongest argument - Limitation C missing from Reference B.
2. Other lesser arguments

Well bore arguments

1. Reference A does not teach limitation a.
2. Reference A does not teach limitation b.
3. Reference C does not teach limitation d.
4. Reference D does not teach limitation b.
5. No motivation to combine A and B
6. No motivation to combine B and C
7. No motivation to combine C and D.

. . .

36. Strongest argument: Reference C does not teach limitation e.

Topic 6: Develop arguments

- DO: Address the rejection set forth by the examiner.
- DO: Relate cited case law back to the claimed subject matter and the cited prior art.
- DO NOT: Merely recite the claim language and make a naked assertion that the corresponding language is not found in the prior art.
- DO NOT: Present arguments for findings/conclusions not made by the examiner.

Develop arguments: effective example

- Technology overview: A hinge assembly for pivotably attaching a door to a domestic appliance, the hinge assembly comprising **a pair of linkage members forming a slot therein to receive a linkage member pin**.

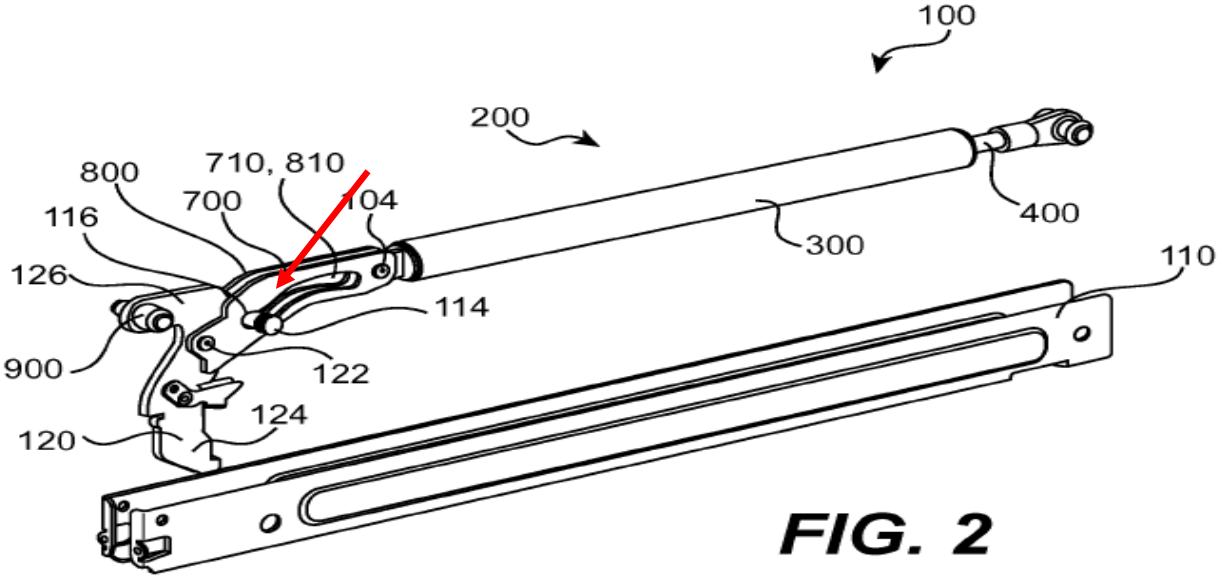
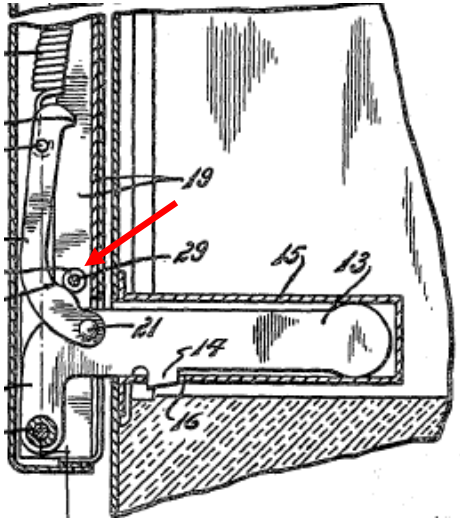


FIG. 2

Develop arguments: effective example



- The examiner reasoned it would have been obvious to a skilled artisan to replace the curved surface of the link members of the primary reference with the curved slot of the secondary reference in order to slow movement speed of the link member pin with respect to the link members during movement of the hinge.
- Appellant explained that "[t]he purpose of [the primary reference] is to help ease closure of the door."

Develop arguments: effective example

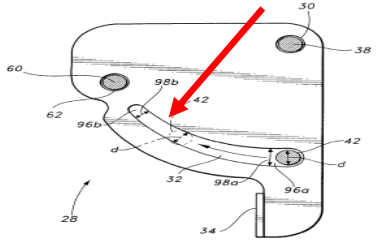


Fig. 4

- Appellant concluded that if, as suggested by the Examiner, "the curved surface in the link members of [the primary reference] were replaced with the slot of [the secondary reference], the modified door [of the primary reference] would not be able to close and function properly."

Develop arguments: less effective example

- Technology overview: A sports helmet comprising an energy absorbing liner having first and second layers, **the second layer of the liner being formed of a breathable material.**
- Appellant's arguments were directed to:
  - Official notice
  - Doctrine of inherency
  - Proposing to make modifications to the prior art reference
- Appellant also made a broad statement that "all the claimed elements must be disclosed in the prior art" but did not apprise the Board of additional claimed elements purportedly missing from the prior art reference.

Topic 7: Use evidence

- Support arguments with evidence as appropriate.
- Attorney argument cannot be a substitute for evidence.
- Do not rely on new evidence that was not before the examiner during prosecution.
- Point to evidence that actually rebuts the examiner's findings.
- Explain how the evidence shows examiner error.

Use evidence: effective example

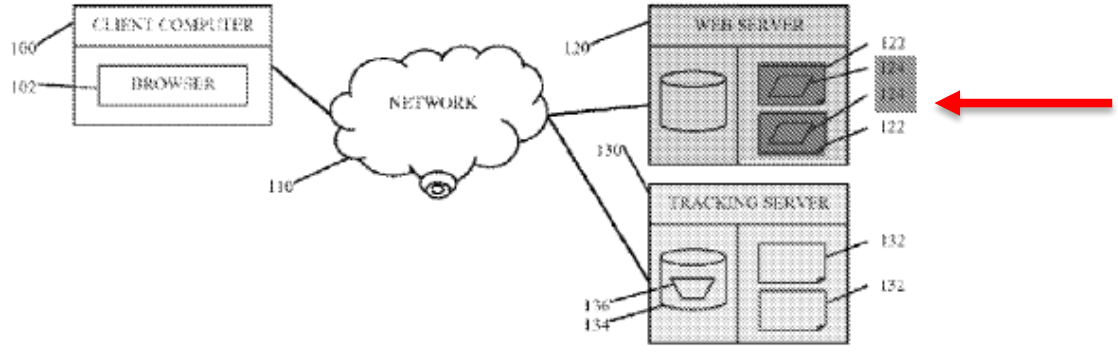
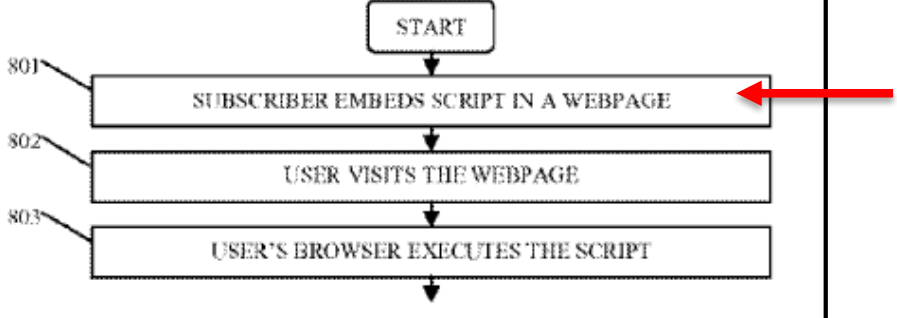


FIG. 6 of *Yavilevich* also shows script 124 inserted into the web site 122 on the web server 120. FIGS. 8A and 8B clearly show the script embedded before the user visits the web page, for example, in FIG. 8A to the right. *See also id* at 1:61-62 (describing a web-site provider who "copies the code into each web-site page that is to be monitored.")



Use evidence: less effective example

- Use expert evidence only where appropriate.
- In an appeal from a § 101 rejection of claims involving a clinical method, appellant submitted expert declarations.
- Appellant relied on experts to establish patent eligibility under step one of the *Alice* framework.
- Experts stated that the claimed methods could not be performed mentally and were not an abstract idea.

Topic 8: Reply briefs

- Sometimes the examiner's answer includes additional/alternative findings, rationale, claim construction, or new ground of rejection.
- DO: Address these items in a reply brief.
- DO NOT: Regurgitate arguments from the appeal brief without consideration of the answer; raise new arguments that could have been presented in the appeal brief (*see* 37 C.F.R. 41.41(b)(2)).

Reply briefs: effective example

- Technology overview: A piston in an internal combustion engine having a crown section and a ring formed in the crown section. The ring is made of a first material and a second material, with the **second material being an alloy of aluminum and magnesium**.
- The examiner found that a prior art reference taught the claimed second material. Appellant persuasively argued in the appeal brief that the second material was not an alloy.
- In the answer, the examiner changed the rejection by finding that the second material being an alloy of aluminum and magnesium would have been obvious in light of known techniques for fixing rings.
- In the reply brief, appellant provided arguments as to why the examiner's finding lacks evidentiary support, and runs contrary to the teaching of the reference.

Reply briefs: less effective example

- Technology overview: identifying problems with an information system and providing remediation recommendations.
- Appellants presented reply brief with various new arguments that were not raised in the Appeal Brief and were not in response to a shift in the answer in the examiner's position.

Reply briefs: less effective example

Appeal Brief	Answer	Response
Reference W does not teach limitation b	Reference B applied – same as Final	
Reference B, element A does not teach aspect "a" of limitation b	Reference B, element B applied for aspect "a" - same as Final	Elements A and B do not teach limitation b, aspect "a".
Reference B does not teach aspect "b" of limitation b	Aspect "b" is not recited in the claim language.	
No reason to combine B & W to arrive at limitation b	Repeats rationale used in Final.	
		Limitation c is not taught.
		Limitation a is not taught
		Limitation d is not taught

Topic 9: Consider oral hearing

- Opportunity
  - Provide additional clarification of how the subject invention differs from the cited prior art.
  - Provide additional clarification of arguments presented in the briefs.
  - Discuss submitted objective evidence of non-obviousness.
  - Make clear on the record any typographical errors found in the application.
  - Answer questions from the judges.
- Not an opportunity to present to the Board new arguments that were not previously before the examiner.

Oral hearing: effective example

- Technology overview: An industrial robot comprising first and second kinematic chains with respective first and second actuators and a single end effector, the second kinematic chain comprising **the first rod of the first kinematic chain, the second joint of the first kinematic chain, and a sub-chain portion connecting the second rod and the first rod**, the second kinematic chain being configured to transmit rotation of the second actuator to a respective movement of the end effector.

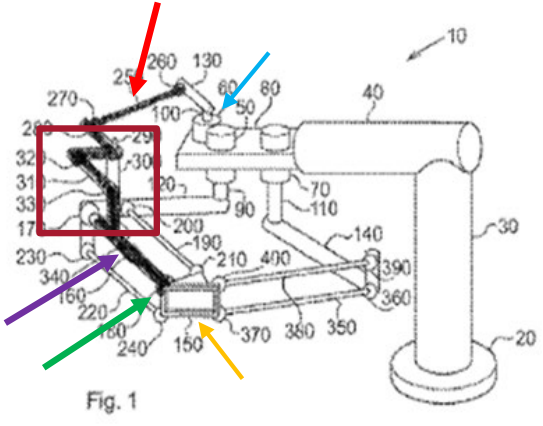
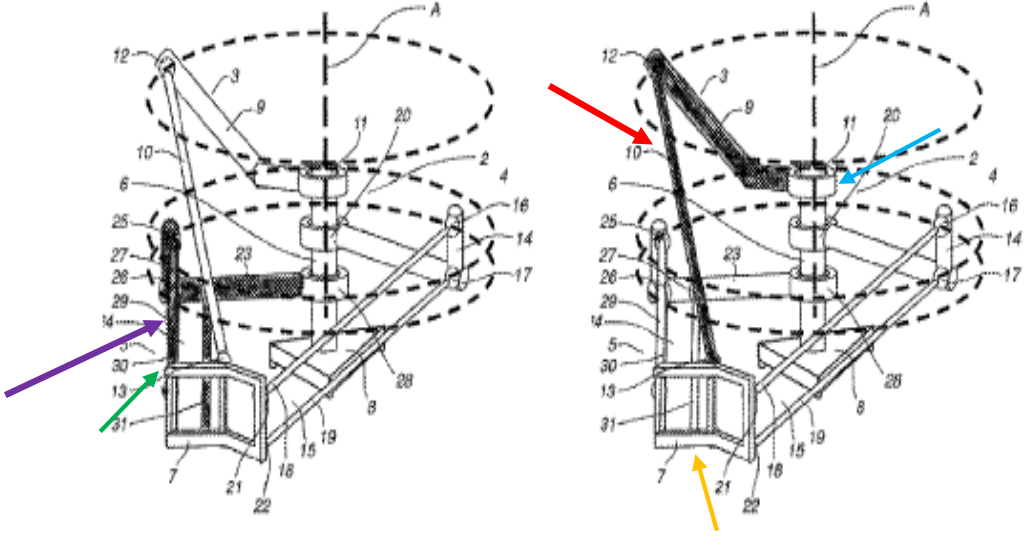


Fig. 1

(Third annotated FIG. 1, showing second kinematic chain in bold)

Oral hearing: effective example



(First annotated FIG. 1 of Kock) (Second annotated FIG. 1 of Kock)

- Appellant effectively demonstrated that elements "9, 10, 12, and 13" of Kock ("second kinematic chain") are not connected to link 30 ("first rod") and joint 33 ("second joint") in any way that would permit rotation means 11 ("second actuator") to transfer energy to platform 7 ("end effector") via link 30 ("first rod") and/or joint 33 ("second joint").

Question/comment submission

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Thank you!

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