

UNITED STATES
PATENT AND TRADEMARK OFFICE



Patent Trial and Appeal Board Boardside Chat: Presenting Technology in AIA Proceedings

Brian McNamara, Administrative Patent Judge

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November 17, 2022



UNITED STATES
PATENT AND TRADEMARK OFFICE ®

Question/comment submission

- To send in questions or comments during the webinar, please email:
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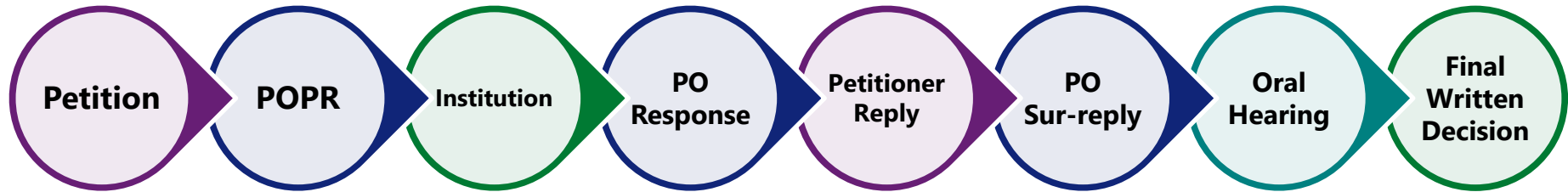
Agenda

- Where to include technology descriptions
- Tips for addressing technology descriptions
- Examples of effective visuals
- Handling technology descriptions at the oral hearing
- Panel question-and-answer

Who is your audience?

- Not a district court trial – no jury
- Decided by a panel of three APJs
 - APJs with technical background and experienced in patent law
 - At least a bachelor's degree in engineering or science
- Paper record primarily

Timeline of an AIA proceeding



Where to include technology descriptions

Petition

- Sections of a petition
 - Background
 - Separate technology review
 - Overview of patent
 - Summary of prior art
 - Claim construction
- Others possible places where technology may be addressed
 - Applying prior art to claims
 - Explanation of combination of references

Expert declaration

- Include a background technology tutorial
 - Define/explaining technical terms and concepts
 - Expanding on technology in the patent/prior art/argument
 - Discussing additional references/materials

Preliminary Response and Response

- Different goals for patent owner preliminary response (POPR) and patent owner response
 - POPR is optional and may have dual purposes
 - Explain why trial should not be instituted (e.g., discretionary denials); and
 - Address the merits (e.g., missing claim elements, motivation to combine)
 - Provide technology background similar to petition
 - Response has a more singular purpose to address the merits
 - Focus on technology as needed to address the merits
 - More focus on holes in petitioner's argument



Reply and Sur-reply

- Focus on disputed issues
- Concentrate on the relevant evidence to support arguments
- Highlight inconsistencies in arguments
- May include declaration with additional technology descriptions and figures
- Can discuss deposition testimony
- Last chance to include figures/subject matter that might be used as demonstratives

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Recent Requests for Comments

Requests for Comments on



- Expanding Admission Criteria for Registration to Practice in Patent Cases Before the USPTO
- Expanding Opportunities To Appear Before the Patent Trial and Appeal Board
- Published on October 18, 2022
- Comments will be accepted through January 17, 2023
- Federal Register:
 - <https://www.federalregister.gov/documents/2022/10/18/2022-22572/expanding-opportunities-to-appear-before-the-patent-trial-and-appeal-board>
 - <https://www.federalregister.gov/documents/2022/10/18/2022-22569/expanding-admission-criteria-for-registration-to-practice-in-patent-cases-before-the-united-states>



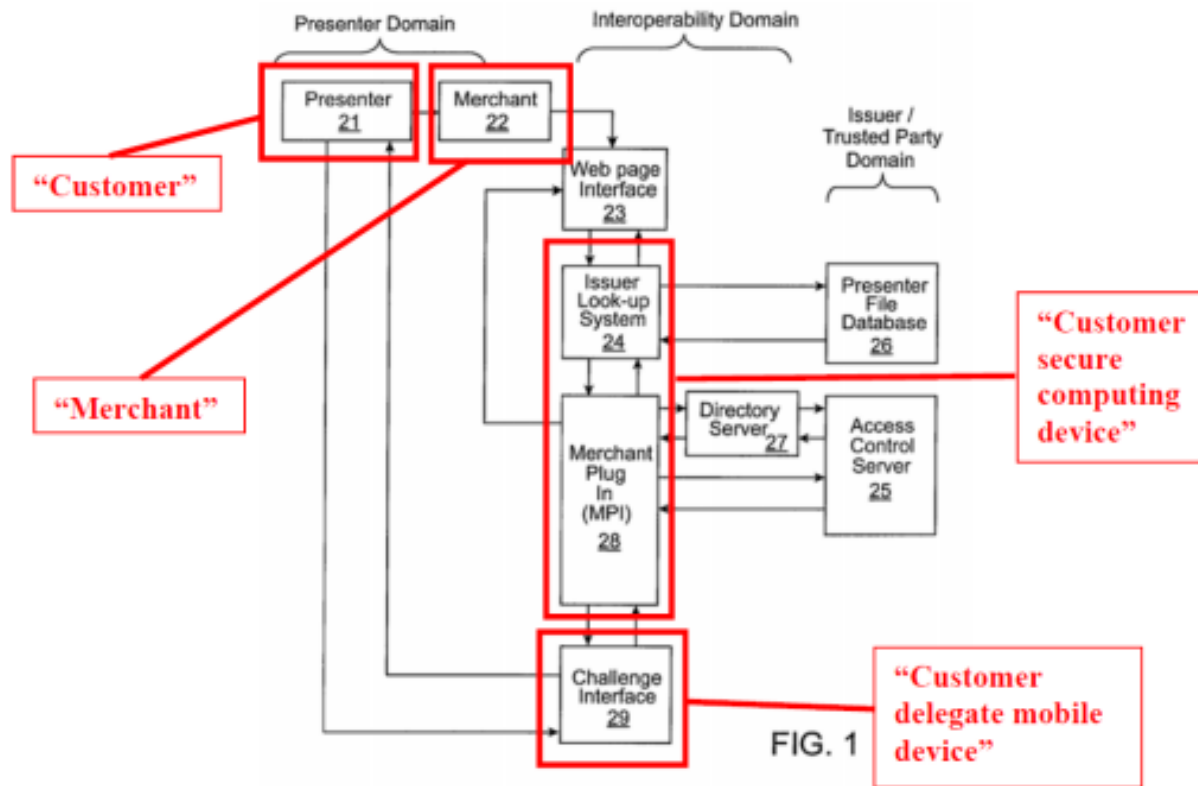
Tips for addressing technology descriptions

Using modified/annotated figures

- Highlighting and/or labeling
- Adding arrows and descriptors
- Color coding to match claim elements
- Combining figures from different references to show a combination
- Creating new diagrams to show operation of patent or prior art

Are the visuals effective in these examples?

Example 1



Example 2

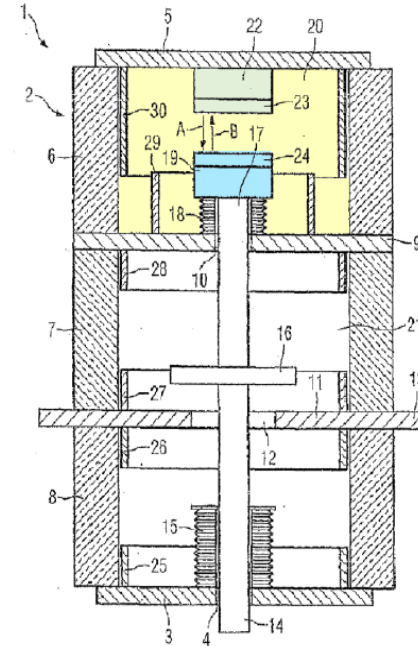
Claim 1	
1[preamble]	A circuit breaker apparatus comprising:
1[a]	a housing;
1[b]	a first bushing outwardly of said housing;
1[c]	a second bushing extending outwardly of said housing;
1[d]	a first vacuum bottle positioned in said housing and having a pair of contactors therein, one of said pair of contactors being electrically connected to said second bushing;
1[e]	a second vacuum bottle positioned in said housing and having a pair of contactors therein, one of said pair of contactors of said second vacuum bottle being electrically interconnected to ground; and
1[f]	mechanical linkage movable between a first position and a second position, said first position electrically connecting said first bushing to said second bushing, said second position electrically connecting said first bushing to ground.

Example 2

1[d]:

Anger's vacuum interrupter includes a vacuum-sealed "first internal area (20)," which corresponds to the claimed "first vacuum bottle." (Ex. 1005, 11:19.) The first internal area 20 has a fixed contact piece (22/23) and a movable contact piece (19/24), with the movable contact piece (19/24) affixed to the movable contact rod 14, as shown in annotated Figure 1 of Anger below. (*Id.*, 11:14-22, Fig. 1.)

FIG. 1

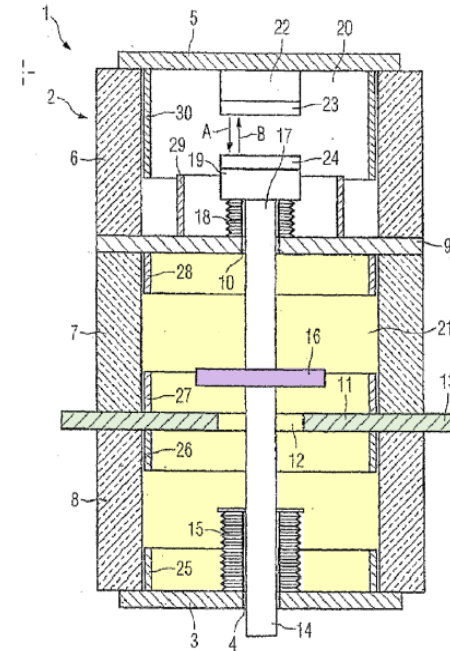


Example 2

1[e]:

Anger also teaches a **second internal area (21)**, which corresponds to the claimed “second vacuum bottle” and contains a **grounding contact (16)** and a **mating contact (11)**, as shown in annotated Figure 1 of Anger below. (Ex. 1005, 11:10-20, Fig. 1.)

FIG. 1

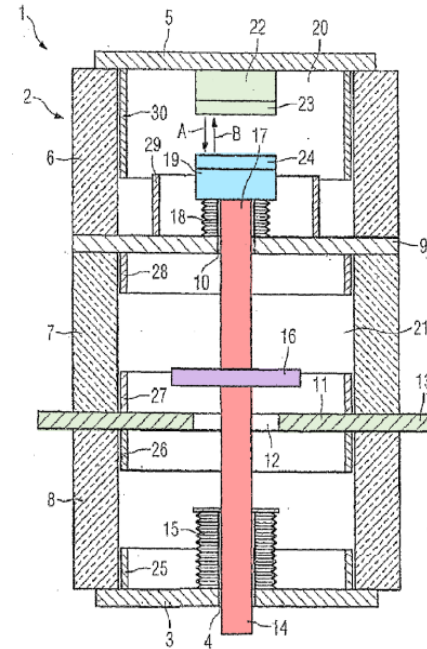


Example 2

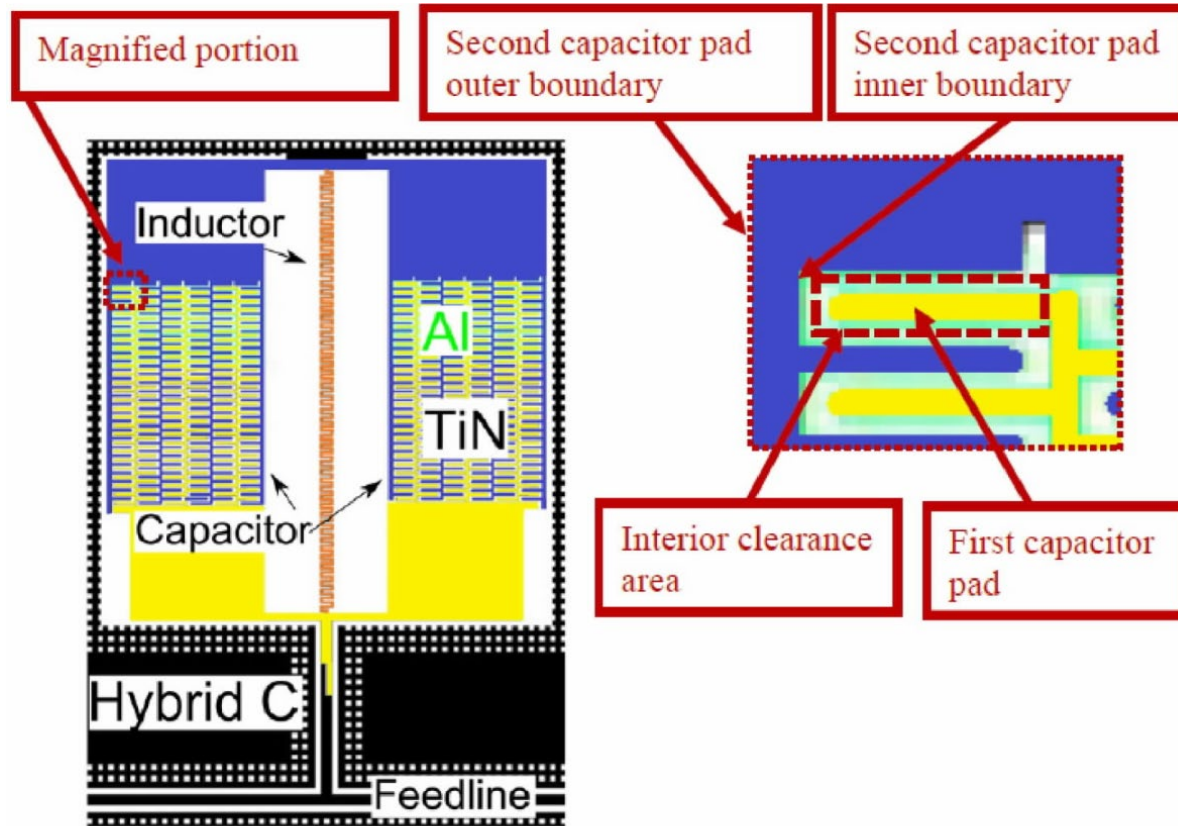
1[f]:

Anger in combination with Field discloses this limitation. Figure 1 of Anger discloses a **movable contact rod (14)** (which is operated by a non-depicted “actuating device”) that is “conductively connected” to an electrical power supply. (*Id.*, 6:15-17.) The movable contact rod is shown below in annotated Figure 1 and forms the claimed “mechanical linkage” that moves between the claimed first and second positions. (*Id.*, 6:8-7:16; Ex. 1003, ¶142-147.)

FIG. 1



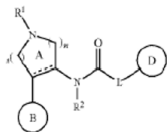
Example 3



IBM-1010, Fig. 1 (partial and annotated)

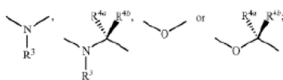
Example 4 (claim)

1. A compound represented by the formula



wherein:

ring A is a piperidine ring or a pyrrolidine ring and each straight line is a single bond and $\cdots\cdots\cdots$ is a single bond;
 ring B is an aromatic ring optionally having substituent(s);
 ring D is an aromatic ring optionally having substituent(s),
 wherein 6-pyrrolinyl is excluded;
 L is a group represented by the formula



R^2 , R^3 , R^{4a} and R^{4b} are each independently a hydrogen atom, an optionally halogenated C_{1-6} alkyl group or an optionally halogenated C_{3-6} cycloalkyl group, or R^2 and R^3 are optionally bonded via an alkylene chain or an alkenylene chain, or R^{4a} and R^{4b} are optionally bonded via an alkylene chain or an alkenylene chain;

R^1 is a hydrogen atom or a substituent;

m and n are each independently an integer of 0 to 3;

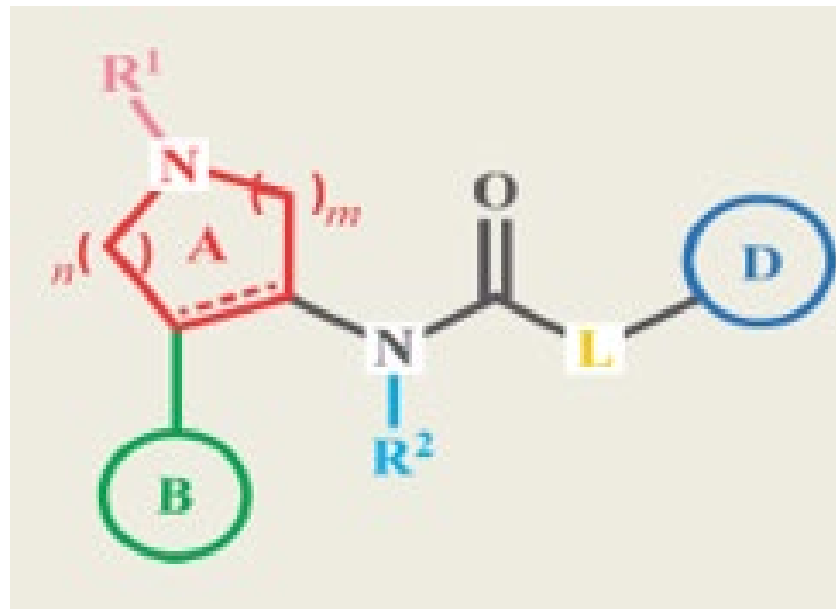
$m+n$ is an integer of 2 to 3;

provided that when L is a group represented by the formula



wherein each of R^{4a} and R^{4b} is as defined above, then ring

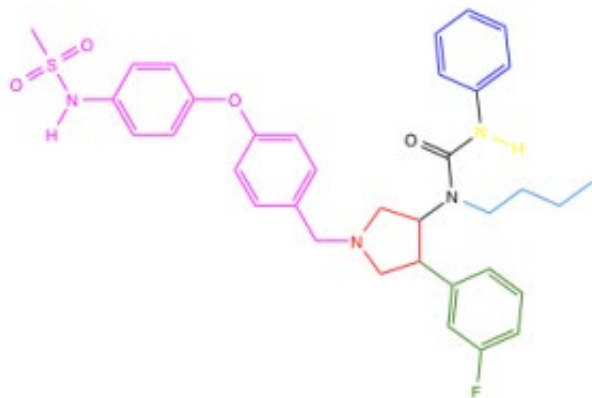
D is an aromatic ring having substituent(s);
 excluding: N-[4-(biphenyl-4-yl)piperidin-3-yl]-N'-[naphthalen-2-yl]urea;
 or a salt thereof.



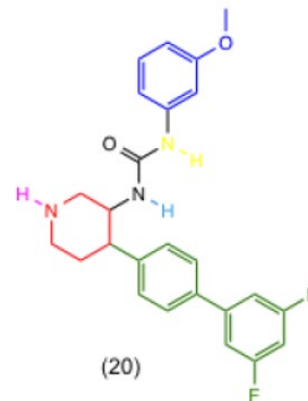
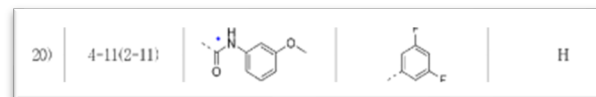
Example 4 (prior art disclosures)

EP '721

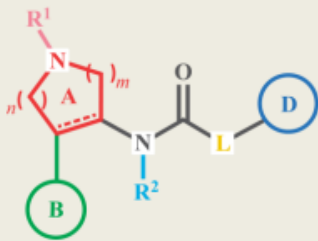
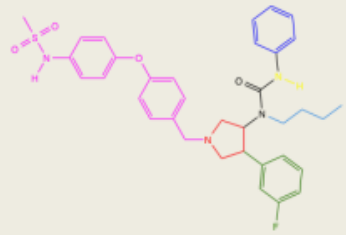
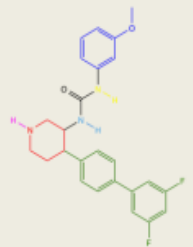
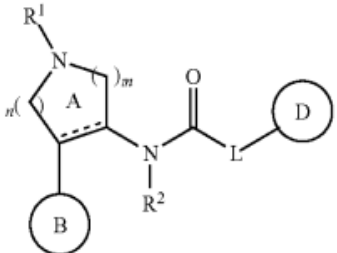
N-[4-(4- {[3-[(anilincarbonyl)(butyl)amino]-4-(3-fluorophenyl)pyrrolidin-yl]methyl} phenoxy)phenyl] methanesulfonamide.



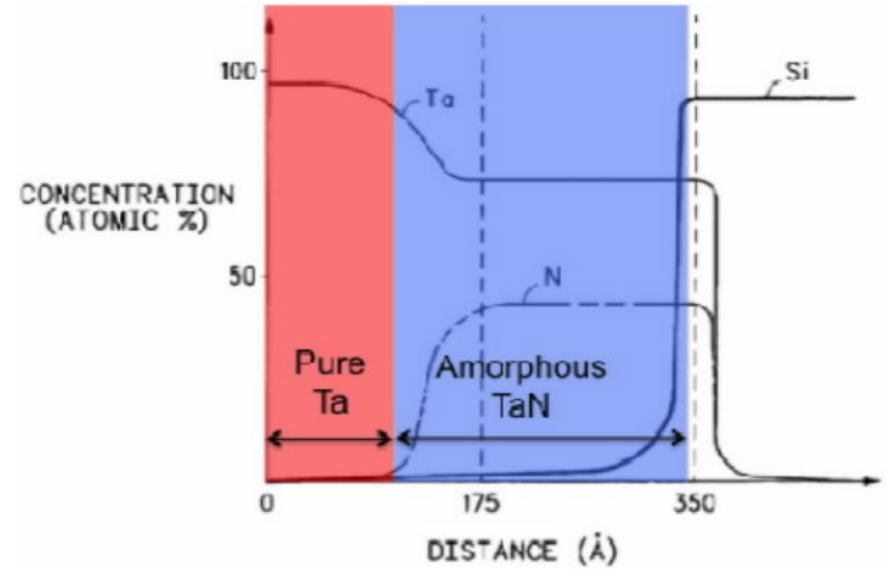
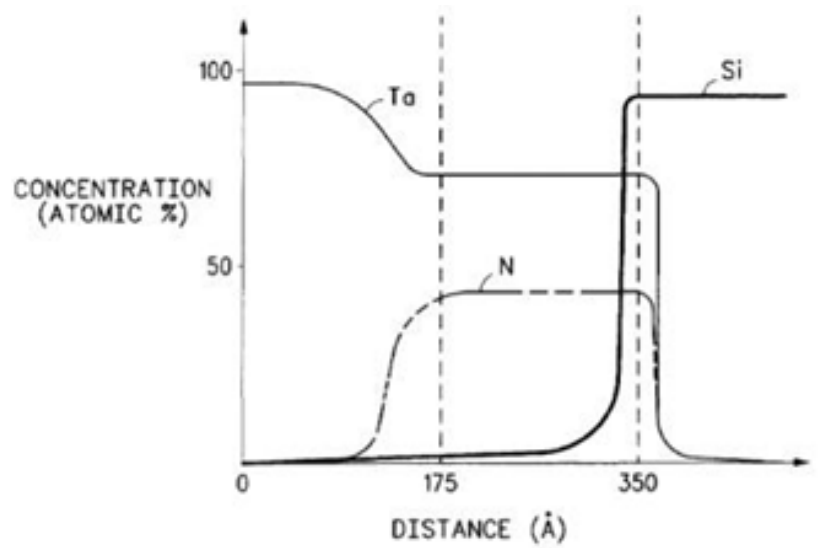
KR '645



Example 4 (claim chart)

<p align="center"><u>Claim Limitations</u></p> 	<p align="center"><u>Disclosed in EP '721</u></p> 	<p align="center"><u>Disclosed in KR '645</u></p> 
<p>1. A compound represented by the formula</p>  <p>wherein: ring A is a piperidine ring or a pyrrolidine ring and each straight line is a single bond and - - - is a single bond;</p>	<p>Compound 3 of EP '721, has a pyrrolidine ring, which is depicted in red in the drawing above. The pyrrolidine ring of Compound 3 has all single bonds.</p> <p>Compound 3 of EP '721 also contains an amino carbonyl moiety, which is depicted in black.</p>	<p>The KR Compounds have a piperidine ring, which is depicted in red in the drawing above. The piperidine ring of the KR Compounds has all single bonds.</p> <p>The KR Compounds also contain an amino carbonyl moiety, which is depicted in black.</p>

Example 5



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USPTO Director review



- The USPTO has published information on the Director review process to increase openness as it formalizes the process
- Details on the interim process and suggestions for parties who wish to request Director review

<https://www.uspto.gov/patents/patent-trial-and-appeal-board/interim-process-director-review>

- Status of Director review requests
 - Information about the proceedings in which Director review has been granted
 - Monthly updated spreadsheet with the status of all Director review requests

<https://www.uspto.gov/patents/patent-trial-and-appeal-board/status-director-review-requests>



**How should technology
description be handled at the oral
hearing?**

Oral hearing

Hearing Room A



Hearing Room B



Hearing Room D



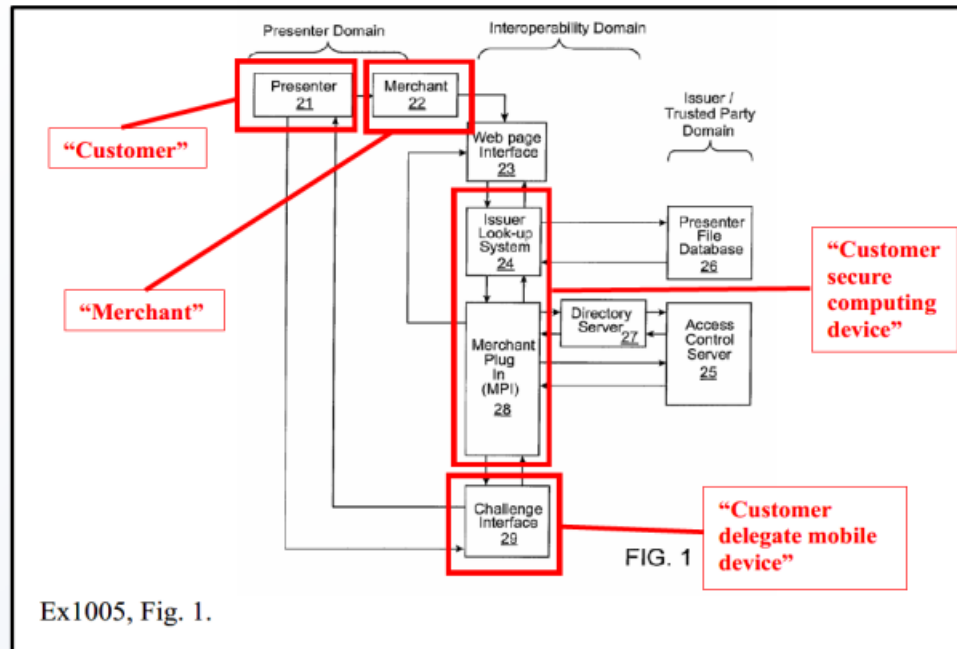
- At this stage, panel is very familiar with the record
- General technology overview typically not helpful
- Focused discussions on disputed technical issues can be helpful
- Demonstratives limited to what is already of record
- Type of hearing: virtual or in-person
- Showing animation and video require advance approval

Demonstratives

- Demonstratives must be filed no later than the time of the hearing (can be modified)
- PTAB hearing rooms contain a document camera projector and laptop projector
- Parties must provide their own laptop
- Currently, PTAB has HDMI, VGA, and Mac connections only
- Different judges use demonstratives differently

Example 1

Mark Up of Wentker (Ex1005) Fig. 1



Institution Decision, Paper No. 16, p. 14
(citing Petition, Paper No. 1, p. 30,
mark up of Fig. 1, Ex1005).

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE - ASK-DX-12

Example 2

Applying the *Wands* Factors to EP '721

1 The quantity of experimentation necessary

Routine experimentation will suffice because all of the steps needed to make and purify Compound 3 were known (Ex. 1011, Crimmins Decl., at ¶ 64)

2 The amount of direction or guidance presented

Skilled artisans have all of the direction needed based on the disclosed structure and generally available knowledge (*Id.* at ¶¶ 49, 55, 62, and see Appendix B)

3 The presence or absence of working examples

Dr. Hunt agrees that Compound 3 could be made (*Id.* at ¶ 50)

4 The nature of the invention

EP '721 discloses chemical compounds that could be readily made (*Id.* at ¶¶ 49, 58)

Applying the *Wands* Factors to EP '721 (Continued)

5 The state of the prior art

The organic chemistry knowledge needed for synthesizing the compounds is well known (*Id.* at ¶¶ 52, 59; Ex. 2053 at 10-22)

6 The relative skill of those in the art

Those of ordinary skill in the art are highly skilled and educated (Ex. 1011 at ¶ 60)

7 The predictability or unpredictability of the art

Synthetic organic chemistry is predictable (*Id.* at ¶ 61)

8 The breadth of the subject matter

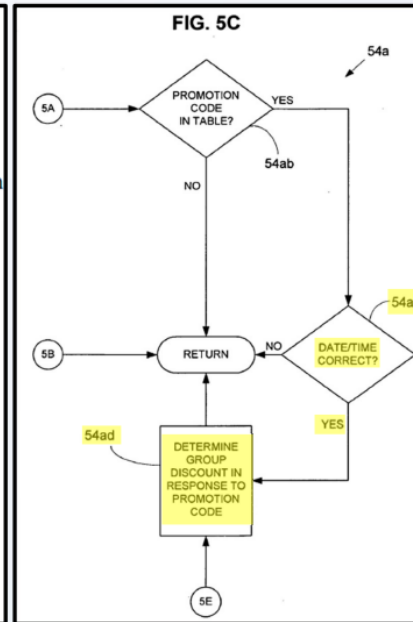
Only one compound needs to be enabled (*Id.* at ¶ 57)

Example 3

Ground 5 - Claim 26

290. Wehr discloses the determination of a discount for a fuel purchase (i.e., the evaluation of a rule) **only during a specified time**, namely, a time frame associated with a particular promotion code. (See, e.g., Ex1008, ¶[0054] (“If a promotion code is indeed identified and transmitted, the presence of the promotion code in the loyalty promotion table 18 that is stored in the computer readable medium 38 is determined in step 54ab and, if the promotion code is present, **it is determined in step 54ac whether the current date and time of use of the fuel dispenser 26 by the customer falls between the start date/time and the end date/time associated with the promotion code.** If the current date and time **does fall between the start and end dates and times, a group discount associated with the promotion code is determined in step 54ad, with the group discount being a discount applicable to one or more POS systems**, including the POS system 20.

Ex1002, Zatkovich Declaration, ¶290 (cited in Petition, Paper No. 1, p. 69).



Ex1008, FIG. 5C (discussed Ex1002, ¶290).

Example 4

Ground 5 - Claim 26

Indeed, Mr. Landers confirmed that Wehr does disclose the evaluation of a processing rule (e.g., the determination of a group discount associated with the promotion code) during a specified time period (e.g., a time frame associated with a particular promotion code):

Q. Date and time of use of the fuel dispenser 26 by the customer falls between the start date and time and the end date and time associated with the promotion code. Do you see that?

A. Yes, yes.

Q. And if it falls within the time period, you move on to 54d. If it doesn't, you stop, right?

A. Yes.

Q. So 54d only occurs if you are during the specified time period that is tested in 54c, correct?

A. Yes.

Q. So whatever rule occurs in 54d is only testified -- is only evaluated during the active time interval specified in 54c, correct?

MR. MAHONEY: Objection, form.

Q. In Wehr.

A. That's correct.

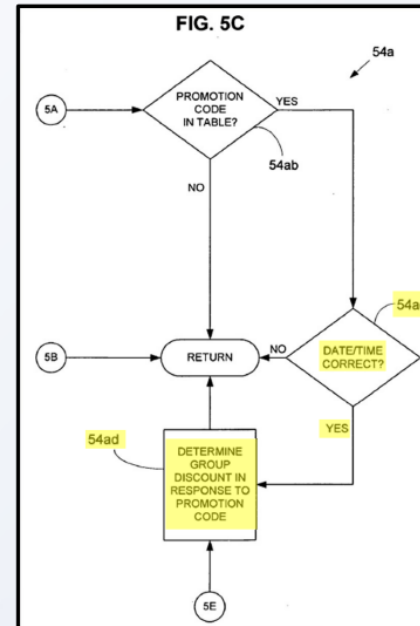
Q. So 54d would meet claim 26 in your -- in your opinion, correct?

A. Fifty-four D -- give me a second.

(Reading.)

During the active time, yeah, yes.

(Ex1018, Tr. 87:6-89:12; see also Pet., at 69; Ex1002, ¶290).

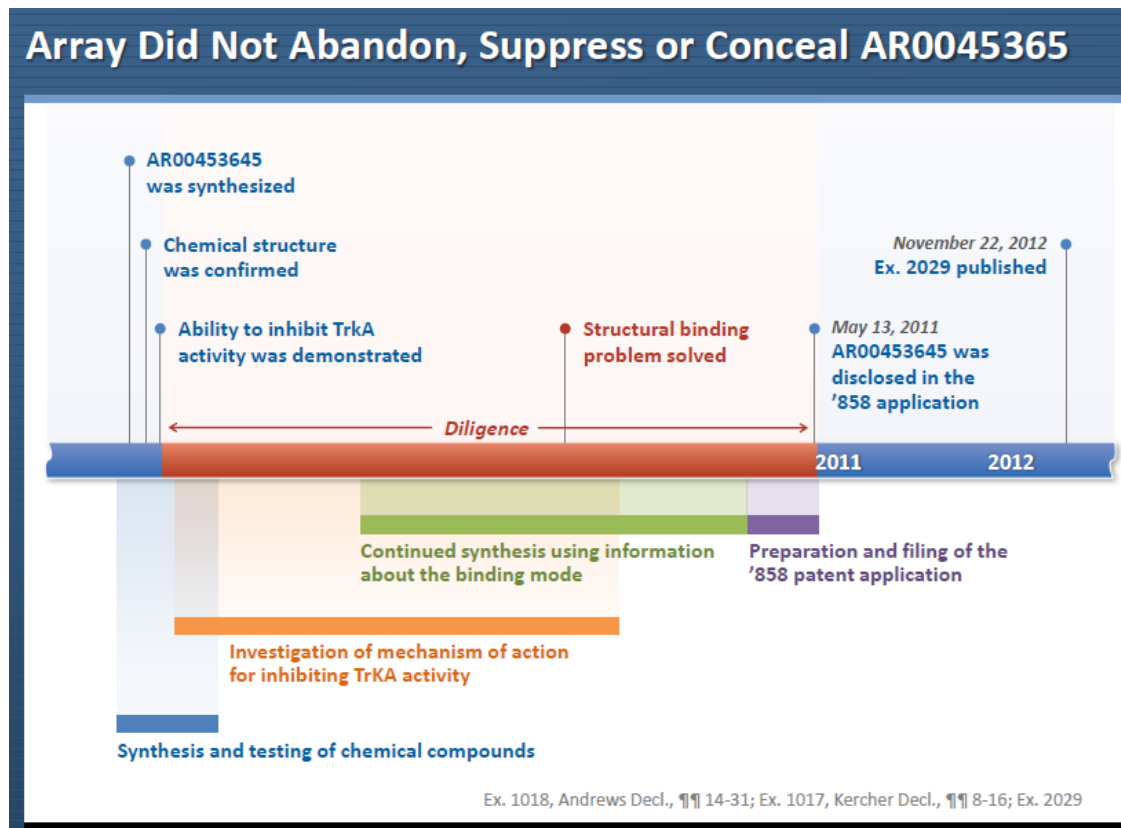


Ex1008, FIG. 5C (discussed in Paper No. 13, pp. 21-22, and Ex1002, ¶290).

Petitioner Askeladden L.L.C.'S Reply to Patent Owner's Response, Paper No. 13, p. 21-22.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE - ASK-DX-44

Example 5



Takeaways

- Many ways to effectively describe the technology
- Most effective way may depend on (i) the technology itself or (ii) the issues presented in the pleadings
- Focus on describing the technology that is important; discuss related technology, as needed
- Make effective use of expert declarations
- Oral hearings should not be technology tutorials

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Next Boardside Chat



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