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PATENT AND TRADEMARK OFFICE**

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Patent Quality Chat

Best Practices Before the Patent Trial and Appeal Board

June 12, 2018

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

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Patent Quality

Providing high-quality, efficient examination of patent applications is paramount to [our mission](#) at USPTO. To ensure we continue to issue high-quality patents that will fuel innovation well into the future, the [Office of the Deputy Commissioner for Patent Quality](#), along with our partners across the Patents organization, promotes and supports the continuous improvement of patent products, processes and services through collaboration with internal and external stakeholders of the intellectual property community.

Highlights



[Patent Quality Chat](#)

Our next Patent Quality Chat will be on June 12th discussing "Best Practices Before the Patent Trial and Appeal Board".

[Quality Metrics](#)

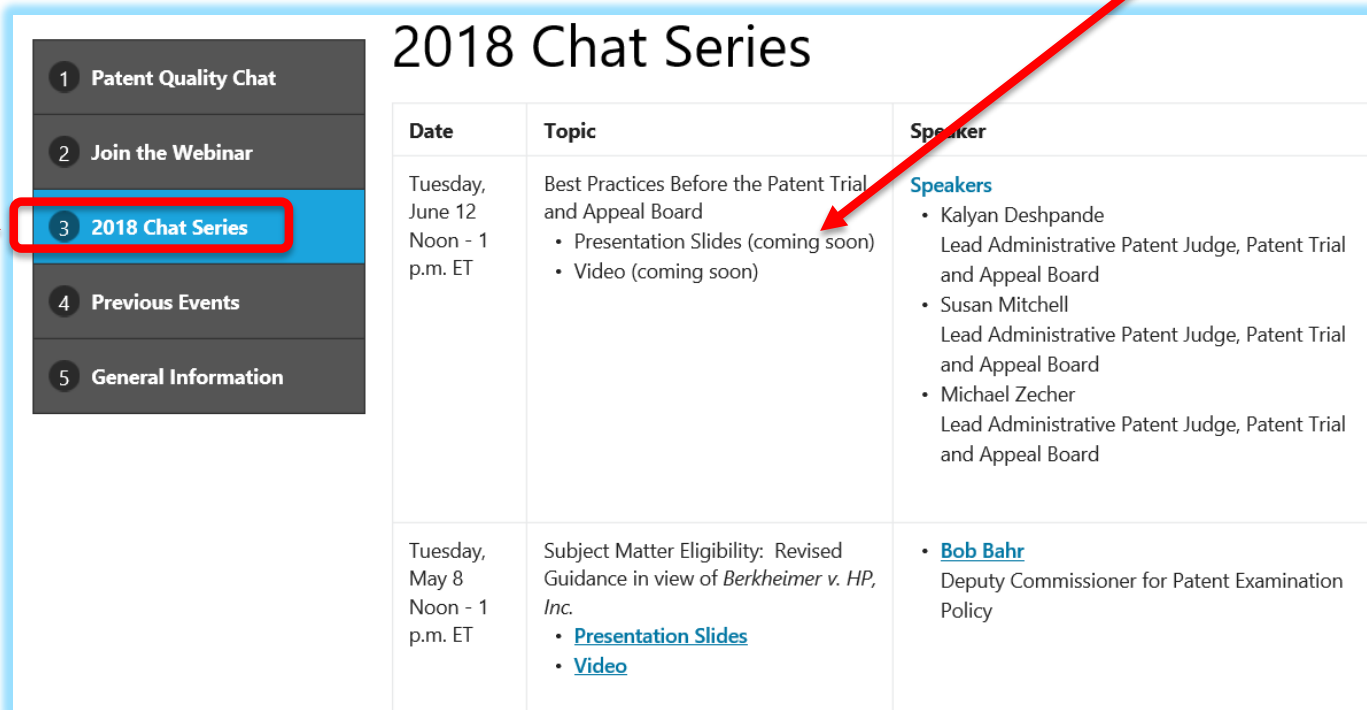
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2018 Chat Series

Date	Topic	Speaker
Tuesday, June 12 Noon - 1 p.m. ET	Best Practices Before the Patent Trial and Appeal Board <ul style="list-style-type: none">• Presentation Slides (coming soon)• Video (coming soon)	Speakers <ul style="list-style-type: none">• Kalyan Deshpande Lead Administrative Patent Judge, Patent Trial and Appeal Board• Susan Mitchell Lead Administrative Patent Judge, Patent Trial and Appeal Board• Michael Zecher Lead Administrative Patent Judge, Patent Trial and Appeal Board
Tuesday, May 8 Noon - 1 p.m. ET	Subject Matter Eligibility: Revised Guidance in view of <i>Berkheimer v. HP, Inc.</i> <ul style="list-style-type: none">• Presentation Slides• Video	<ul style="list-style-type: none">• Bob Bahr Deputy Commissioner for Patent Examination Policy

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Patent Quality Chat

Best Practices Before the Patent Trial and Appeal Board

Lead Judges Kalyan K. Deshpande,
Michael R. Zecher, and Susan L. C. Mitchell
June 12, 2018

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Overview/Agenda

- Board jurisdiction
- Proceedings
- Practice tips for written and oral advocacy



Administrative Tribunal

- An administrative tribunal of 3 Administrative Patent Judges (APJs)
- The Patent Trial and Appeal Board (PTAB) reviews ex parte examination appeals, and petitions filed by third parties seeking to challenge the patentability of issued claims
- The PTAB is part of the U.S. Patent and Trademark Office, which is directed by Deputy Under Secretary of Commerce for Intellectual Property (Andrei Iancu)

PTAB

- PTAB is created by statute (35 U.S.C. § 6)
 - This statute mandates the following:
 - Duties
 - Composition
 - Qualifications of membership (i.e., “persons of competent legal knowledge and scientific ability”)
 - Panel form of decision-making (i.e., appeals, reexaminations, derivation proceedings (DERs), *inter partes* review proceedings (IPRs), and post-grant review proceedings (PGRs))



Hierarchy of the PTAB and APJs

- Director of the USPTO (and other statutory members listed in 35 U.S.C § 6)
- Chief Judge
- Deputy Chief
- 5 Vice Chief Judges
- 30 Lead Judges
- 229 Judges
 - PTAB also includes Patent Attorneys, Law Clerks, Paralegals, and Administrative/Support Staff that assist Judges with their various responsibilities



Types of Proceedings

- Appeals in *ex parte* patent applications
- Appeals in *ex parte* and *inter partes* reexaminations
- Interferences
- IPRs
- DERs
- PGRs
- Covered business method patent review proceedings (CBMs)—sunsets in September 2020



Actions by Panel Decision

- 35 U.S.C. § 6(c) requires that “[e]ach appeal, derivation proceeding, post-grant review, and inter parte review shall be heard by at least 3 members of the [PTAB], who shall be designated by the Director.”



Typical Case

- Docketing
 - In *ex parte* appeals and reexaminations, jurisdiction transfers from the Examiner when a case is appealed
 - In IPRs, DERs, PGRs, and CBMs, a paralegal enters a “Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response”
- Assigning a panel (usually 3 Judges)
 - Chief Judge and SOP1
 - Judge 1 is generally assigned the writing responsibility, unless after the conference he/she is in the minority
- Conference between Judges
- Oral hearing (if requested)
- Post-hearing conference between Judges (only if oral hearing occurs)
- Circulating opinion
- Signed decision



Preparation Tips

- Preliminary identify the issue(s) and brainstorm how each issue should be addressed in the form of argument
- Rank your arguments
- Scour the record for facts that provide support for each argument
- Research the law pertaining to each issue
 - If there is precedential case law on point, make sure the citation is correct
 - If case law is non-precedential, yet helpful to a particular argument, consider its' persuasive effect
- Draft a focused outline



Opening Brief

- General conventions for excellent legal writing
 - Always employ respectful and appropriate language
 - Avoid jargon; be clear and direct
 - Adhere to a logical structure
 - Use headers to focus the reader
 - Develop focused paragraphs with appropriate introduction sentences
 - Consider persuasiveness of demonstrative aids, such as timelines, charts, diagrams, tables, or pictures
 - Edit carefully



Pitfalls to Avoid

- Don't misrepresent or overstate a fact or legal authority
- Avoid incomprehensible string citations, unnecessary citations, and long block quotes
- Avoid burying your best argument
- Avoid paraphrasing claim limitations
 - Often indicative of incorporating embodiments from the specification into the claims
- Don't recite a claim limitation verbatim and then nakedly assert the prior art does not disclose, teach, or suggest that limitation
- Avoid absolute or conclusory statements



Reply Brief

- Consider whether a reply brief is necessary
- If necessary, avoid being defensive
- Briefly restate specific arguments from the opening brief and then address your adversaries' responses one-by-one
- Don't feel compelled to address every point raised by your adversary, especially trivial points
- Edit carefully



Common Arguments

- Depending on the particular circumstances of each case, the various arguments discussed hereafter may be done effectively or ineffectively
- The following slides provide a list of common arguments with respect to claim construction, anticipation, obviousness, written description, enablement, definiteness, etc.



Claim Construction

- Highlight a lexicographical definition in the specification
- If no lexicographical definition, explain in detail how a proposed construction is consistent with the plain language of the claim and the specification
 - Avoid a proposed construction that relies on a particular embodiment disclosed in the specification
- In Trial proceedings (e.g., IPRs, PGRs, CBMs, reexaminations), consider the prosecution history to determine whether there was a surrender of subject matter or a clear, unmistakable disclaimer
- When in evidence, explain the significance of extrinsic evidence (e.g., expert testimony, dictionary definitions, etc.)
- Parties should be prepared to explain any differences between the claim construction positions they are currently taking before the Board and their positions in other forums (e.g., district court or ITC)

Anticipation

- Explain why the prior art does not disclose, both explicitly and inherently, a particular claim limitation
- Highlight if the anticipation position is based on a combination of embodiments from a single prior art reference
- Keep in mind that anticipation must be “considered together with the knowledge of one of ordinary skill in the pertinent art.” *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (citation omitted)



Obviousness

- Explain why the prior art does not teach or suggest a particular claim limitation
- Attack the rationale to combine
 - Where possible, highlight any conclusory statements that lack factual or evidentiary support
 - Although a teaching, suggestion, or motivation may provide “a helpful insight,” keep in mind that it cannot be used as a rigid and mandatory formula. *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418-19 (2007).
- Impermissible hindsight reconstruction
 - Citations to the specification are often indicative of hindsight
- Teaching away
 - Remember that mere differences between references or a reference that proposes an alternative solution does not constitute a teaching away
- Modifying prior art reference A with prior art reference B would change reference A’s basic principle of operation
- Modifying prior art reference A with prior art reference B would make reference A inoperable for its intended purpose

Obviousness (cont.)

- Bodily incorporation
- Non-analogous art
 - The key is whether the reference is analogous to the applicant or patent at issue—not whether prior art references A and B used in an obviousness combination are in different and non-analogous arts
- Secondary considerations
 - Nexus, Commercial success, copying, long-felt need, etc.



Written Description

- When examining the written description for support for a claimed invention, the exact terms appearing in the claim “need not be use *haec verba*.” *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997) (citation omitted).
- The proper test for written description support is whether the relied upon disclosure “reasonably conveys to those skilled in the art that the invention had possession of the claimed subject matter” as of the earliest effective filing date. *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010).

Enablement

- Lack of an explicit analysis based on *In re Wands*, 858, F.2d 731, 737 (Fed. Cir. 1988) is not a per se reason to reverse an enablement rejection or deny a ground of unpatentability based on enablement
 - Often times an Examiner or Petitioner will discuss some *Wand* factors without explicitly labeling them
- Focus should be on undue experiment
- Does the specification sufficiently explain how, why or what a person of ordinary skill in the would have understood or known to do?



Definiteness

- Arguments regarding definiteness may depend on whether it is in the prosecution or trial context
 - In the prosecution context, must consider whether the claim language is “cast in clear—as opposed to ambiguous, vague, indefinite—terms.” *In re Packard*, 751 F.3d 1307, 1313 (Fed. Cir. 2014).
 - In the trial context, it is still unsettled as to whether *Packard* standard or the “reasonable certainty” standard set forth in *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120 (2014) is controlling. *Tinnus Enters., LLC v. Telebrands Corp.*, No. 2017-1726, slip op. *10-13 (Fed. Cir. May 30, 2018).
- Regardless of context, exact precision is not required



General Tips for Oral Advocacy

- Be confident
- Be prepared for all levels of knowledge in a Judge
 - Recognize your audience and tailor your message accordingly
- Lead with your strongest argument
- Where possible, include the notion that you are seeking a just result
- When asked a question, answer it directly



Biggest Mistakes Made by Oral Advocates

- Not listening carefully and, therefore, failing to address the concerns raised by the Judge
- Answering a question before thinking about what to say
- Admitting contrary facts, but being unable to re-focus the Judge on facts that support your case
 - You should be prepared to defend your ground on all levels



Preparing for Oral Argument

- Know the entire record
- Put yourself in the shoes of each Judge and think about what questions he/she might ask
- Brainstorm how to explain your case and arguments in a compelling way
- Rehearse, rehearse, rehearse



Demonstratives

- Most Judges find demonstratives helpful, especially in highly technical cases, but be careful not to rely on them excessively
- Be prepared to jump around to various slides
- **NO** new arguments or evidence are permitted



Making the Most of Rebuttal

- Don't respond to all your adversaries' points; rebut your adversary only on important points
- Focus on the key issues that the Judges seem to care about most and give a clear, straightforward reason as to why you should prevail on those issues
- Recognize where you might be able to stand on your written briefs



Pitfalls to Avoid

- Always be respectful to your adversary
- Avoid memorizing your entire presentation
- Don't spend too much time on case citations
- If you make a mistake, don't try to cover it—acknowledge it
- Don't dodge questions
- Don't introduce new arguments without first seeking express authorization from the panel



Live Witnesses

- Live witnesses are permitted, but rarely requested
 - In at least one instance, a fact witness was permitted in an IPR to address the issue of antedation (i.e., conception and diligence)
 - If requested, the live witness should be prepared to answer questions from the panel
- If a practitioner strongly believes that its case will benefit from live testimony, he/she should seek prior authorization from the panel
- The vast majority of testimony is admitted in paper form, as a declaration



Let's Chat about Best Practices Before the Patent Trial and Appeal Board

With Lead Judges Kalyan K. Deshpande, Michael R. Zecher,
and Susan L. C. Mitchell

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Next Patent Quality Chat

Improving Access to Global Patent Data

July 10, 2018

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Other Patent Quality-Related Events

<https://www.uspto.gov/about-us/events>

June 13	TC 2800 Circuits Customer Partnership Meeting in Alexandria and via webcast in all USPTO regional offices)
June 21	Inventor Info Chat "Application Data Sheet (ADS) Part II" (virtual)
June 27	USPTO Additive Manufacturing Partnership Meeting (in Alexandria)
August 17-18	INVENTION-CON 2018 (in Alexandria)

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Thank you for joining us today!

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Webinar Series 2018
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