

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Legal Experience and Advancement Program (LEAP): Oral advocacy training

Patent Trial and Appeal Board

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UNITED STATES
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Part 1: LEAP structure

LEAP

- Designed to foster the development of the next generation of patent practitioners by creating opportunities for them to gain the proper skills and experience in oral arguments before the Board.

LEAP eligibility

- Targeting attorneys and agents new to the practice of law or new to practice before the PTAB.
- To qualify, a patent agent or attorney must have:
 - three or fewer substantive oral arguments in any federal tribunal, including PTAB, **and**
 - seven or fewer years of experience as a licensed attorney or agent.

LEAP benefits

- Board will grant additional argument time to the party, typically up to 15 minutes depending on the length of the proceeding and the PTAB's hearing schedule.
- Additional time is for the *party*:
 - A LEAP practitioner does not have to be allocated a specific amount of time—it remains within the party's discretion to allocate time between counsel.
 - LEAP practitioner must have a substantive role in the oral argument.
- More experienced counsel may provide some assistance, if necessary, and may make limited clarifications on the record.

LEAP requests

- For appeals and AIA trials: Email to PTABHearings@uspto.gov at least five business days before the hearing.
- LEAP practitioner must file a Verification Form confirming eligibility.

LEAP website: www.uspto.gov/leap

The screenshot shows the top portion of the USPTO website. At the top left is the USPTO logo and the text "UNITED STATES PATENT AND TRADEMARK OFFICE". To the right are links for "About Us", "Jobs", "Contact Us", and "MyUSPTO". Below this is a search bar with the placeholder text "Search uspto.gov" and a magnifying glass icon. A navigation bar contains links for "Patents", "Trademarks", "IP Policy", and "Learning and Resources", along with a "Find It Fast" button. Below the navigation bar is a breadcrumb trail: "Home > Patents: Application Process > Patent Trial and Appeal Board > Legal Experience and Advancement Program (LEAP)". To the right of the breadcrumb trail are "Share" and "Print" icons.

Main menu

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Legal Experience and Advancement Program (LEAP)

The USPTO is committed to fostering a strong and vital patent system. It is important that advocates have the proper skills and experience to support stakeholders and effectively represent their interests. To that end, the USPTO sees value in providing opportunities for the advocates to gain experience in proceedings before the Patent Trial and Appeal Board (PTAB) through our Legal Experience and Advancement Program (LEAP).

LEAP is designed to encourage the professional development of patent attorneys and agents appearing before the PTAB through increased opportunities for oral advocacy. Accordingly, the PTAB will grant up to 15 minutes additional argument time to parties that choose to participate in LEAP, depending on the length of the proceeding and the PTAB's hearing schedule.

Eligibility

To qualify as a LEAP practitioner, a patent agent or attorney must have:

1. three or fewer substantive oral arguments in any federal tribunal, including the PTAB, and
2. seven or fewer years of experience as a licensed attorney or agent.

LEAP participation requests

A practitioner may submit an email request to participate in LEAP at least five business days before the hearing:

- For ex parte appeals: PTABHearings@uspto.gov
- For AIA trials: Trials@uspto.gov

LEAP becomes effective on May 15, 2020. LEAP practitioners may begin to file requests to present arguments to the PTAB under this program starting on that day.

Prior to the hearing, the LEAP practitioner must file a LEAP Practitioner Verification Form confirming eligibility to participate in the program.

- [LEAP Practitioner Verification Form](#)



Part 2: Oral advocacy

Purpose of the hearing: A judge's perspective

- Judges thoroughly review the case prior to the hearing. They will have preliminary conclusions about some issues of the case, but likely will be undecided as to other issues that may be critical to their decision.
- Judges will want to focus on the issues critical to their decision, even if those issues are not the issues you would like to focus on.
- As a result, oral argument usually is **more like a Q&A** than a presentation.
- Listen to the judges' questions and try to understand what issues interest them. This is your opportunity to provide arguments in your side's favor and persuade the judges on issues about which they're undecided.

Before the hearing

- **Review the hearing order.** It includes helpful information including, but not limited to:
 - Finalized hearing date, time, and location.
 - Total length of argument time.
 - Instructions for exchanging demonstratives, if applicable (AIA trials).
 - Instructions for requesting pre-hearing conference, if applicable (AIA trials). This is an opportunity to:
 - Confirm specific procedures for facilitating argument by a LEAP practitioner.
 - Ask whether there is a particular issue about which the panel would like to hear.
 - Have LEAP practitioner conduct the pre-conference hearing.
 - Instructions for requesting audio/visual equipment.
 - Instructions for requesting remote viewing (subject to hearing room availability).

Practice makes perfect

- Take the opportunity to moot your argument with colleagues, if at all possible.
- At minimum, run through your points with a stopwatch to see if you overflow your time allocation.

Hearing room set-up

- Hearings generally are public
- At least one judge normally will appear live
- One or two judges often appear remotely via video from
 - A hearing room in a different regional office.
 - A personal office.
- There may be remote observers via video (e.g., counsel, members of the public).

Hearing typically will be live in Alexandria or in one of the four regional office Hearing Rooms.



Hearing room set-up

- Remote judges cannot hear unless you speak into the microphone.
- Remote judges cannot see the audio/visual display of demonstratives.
 - However, the judges have an electronic copy.
 - Refer to each demonstrative by page number as you argue so remote judges can follow along.
- When answering questions, address the judge who asked the question.
 - If the judge is remote, look into the camera, not the monitor displaying the judge.
 - In some hearing rooms, the camera is not next to the monitor.
 - Hearing room staff can help you identify camera location before the hearing begins.

Be mindful of judges attending remotely.



Flow of a hearing

- Hearings generally begin with remarks by the presiding judge regarding the name of the case and logistics, followed by the judge requesting appearances by the parties.
- If a LEAP practitioner will be arguing some or all of the case, introduce the LEAP practitioner during appearances. This is also a good time to raise issues or confirm procedures and logistics regarding participation of a LEAP practitioner.
- Typical order of an AIA trial argument:
 - Petitioner opening (at this time, the petitioner is usually asked if/how much time it wishes to reserve for rebuttal).
 - Patent owner response (at this time, the patent owner is usually asked if/how much time it wishes to reserve for sur-rebuttal, if rebuttal requested).
 - Petitioner rebuttal.
 - Patent owner sur-rebuttal (if requested).



Before your start, remember...

- It may seem easier to quickly run through a prepared slide deck without interruption than to answer questions, some of which may be difficult because they relate to weaknesses in your case. Although a prepared presentation is a good place to start, running through the presentation is not the purpose of the hearing.
- When a judge interrupts to ask a question, listen carefully. If needed, ask that they repeat the question or request clarification. Take your time in answering if you need to. Even if the clock is running, it's better to provide a thoughtful answer that helps your case than to hurry with a quick answer so you can get back to your slide deck. The judge likely asked the question because the question and your answer is important to the decision.

Watch the clock

- Try to be mindful of time.
- The time for presenting an oral argument is normally set in the Scheduling Order, but may be modified on a case-by-case basis.
- Be sure to find a way to work in the key points you want to make.

Use your time effectively

- *Remember: The judges review the case thoroughly before the hearing. You should spend your time focusing on key issues.*
- No need to start argument with extensive background summarizing the claims and grounds.
- No need to describe the patent and prior art generally. However, consider describing aspects critical to the case.
- A roadmap of which issues are critical to the case is helpful, followed by diving right in to the issues to use time most effectively.
 - For example, perhaps the key issues are (1) construction of a particular claim term; (2) whether a reference teaches a particular claim limitation; and (3) whether motivation to combine two references has been shown.
- Be prepared to address weaknesses in your case. Being unprepared can cost argument time if you fumble for a response and could potentially cost the argument as well.

Demonstratives: Two approaches

- One school of thought is to use demonstratives only if they are helpful to illustrate a point.
- Another school of thought is to use demonstratives as a tool to help you remember the evidence and arguments.
- These approaches are not mutually exclusive.

Using demonstratives only if they are helpful

- *Because arguments and evidence at the hearing are limited to those of record, consider whether demonstratives are even needed to present your case (as opposed to simply referring to the record). If you use demonstratives, they should be helpful in illustrating or highlighting points in the record.*
- Helpful demonstratives may include, but are not limited to:
 - Critical claim language;
 - Illustrative figures;
 - Important quotes from documents or papers;
 - Key case law; and
 - Bullet point list of major issues.
- Remember, remote judges cannot see which demonstrative is being displayed in the live hearing room. Identify by page number the demonstrative you are discussing.

Using demonstratives as a tool to recall evidence and arguments

- The record can be voluminous. Some lawyers may find demonstratives to be a useful tool to help them recall where evidence and arguments can be found in the record.
- If you use demonstratives as a recall tool, be flexible and be prepared to skip around. The judge may want to address specific topics in an order different from how you organized your presentation, based on the issue(s) the judge considers most important.
- When using demonstratives as a recall tool, the requirement that they be limited to evidence and argument previously presented still applies.
- Counsel should have access to the entire record, not just their slides, during oral argument (e.g., laptop with bookmarked .pdf file including all papers and exhibits). Judges often ask questions about a specific page in a document or exhibit.

Answer the question being asked (part 1)

- Judges usually want to focus on a few specific issues, and that focus may deviate from yours. When judges ask questions that shift the focus of your presentation, generally it is because the question and your answer is important to their decision.
- Don't be discouraged if a judge interrupts your presentation and starts asking questions that deviate from your presentation. This almost certainly will happen.
- Answer the question. Don't brush aside the question, but rather use it as an opportunity to provide your side's point of view.
- Provide a concise answer and focus on the merits. Judges are interested primarily in the facts of the case, and the merits of your arguments in light of the evidence.

Answer the question being asked (part 2)

- *If you think the question is not relevant, explain why. However, the judge may disagree, and still ask that you answer the question. You may damage your credibility if you do not answer. Also, your side waives the opportunity to take a position.*
- If you don't know the answer, it's best to admit you don't know.
- If the answer is something you need to look up, let the judge know and consider revisiting during rebuttal/sur-rebuttal.
- If the answer is something you would prefer your colleague to answer, that's ok. Let the judge know.

Don't avoid difficult questions/issues

- *A weakness in your case is not necessarily dispositive. A proceeding often will have weaknesses on each side. Judges often identify these weaknesses while preparing for the hearing, and will ask about them. Be prepared to address apparent weaknesses in your case. Avoiding them will likely hurt more than help your case.*
- For each weakness in your case, consider whether your position is:
 - Reasonable, and
 - Whether the weakness is dispositive or alters the outcome for which you are arguing.
- Judges can tell when counsel is avoiding to answer a difficult question.
- Unreasonable refusal to acknowledge something that is readily apparent will damage your credibility and may signal that your case is weak.
- If applicable, be prepared to explain why the apparent weakness doesn't change the outcome for which you are arguing.

Know the record

- *Know the record well—not just portions you consider essential. Something in the record may be important to the judge, even if you don't think it is important.*
- If parts of the record go to important issues, know those parts and be prepared to discuss them.
- Know and understand your opponent's arguments, and how they use the evidence for support. Even if you prefer to focus on your arguments and evidence, the judge may want your view of the other side's evidence and arguments. It's generally to your benefit to give your side's view.
- There may be evidence in the record the parties don't focus on in their briefs. This doesn't mean the evidence is unimportant or that a judge won't ask about it.
 - For example, if there is a claim construction issue, the judge may ask about portions of the patent specification that use the claim language even if the parties don't discuss those portions of the specification in their briefs, because the judge considers it important in interpreting the claim language.

Decorum

- The PTAB requires all attendees to maintain a professional appearance appropriate for appearing before a tribunal. Counsel appearing before a panel are required to wear formal business attire.
- Generally, once argument begins, you will only speak when it is your turn to argue. Typically, objections should not be made while a party is arguing. This disrupts the flow of the hearing. The objecting party should wait until it is the objecting parties' turn to argue.
- Do not speak while a judge is speaking. This makes it difficult for the court reporter to produce an accurate transcription. Even if you are eager to answer the question, wait for the judge to finish speaking.
- Always be courteous, including with opposing counsel. It reflects well and may enhance your credibility.
- When the other side is arguing, try to remain calm, mind your facial expressions and body language, and avoid excessive conversation with your co-counsel, as these can be distracting and disrespectful. Judges notice.

Additional resources

- The Patent Trial and Appeal Board: Guide to the administration of oral hearings before the Patent Trial and Appeal Board (Aug. 30, 2019)
- www.uspto.gov/sites/default/files/documents/PTAB%20Hearings%20Guide.pdf

ABC's of oral advocacy

- **A**nswer the question being asked, even if it deviates from your prepared presentation
- **B**egin the presentation with the critical issues, not extensive background.
- **C**onsider whether demonstratives will be useful to your presentation. New arguments are not permitted.
- **D**o not avoid difficult issues. Judges will be most interested in the weakest part of your case, because those are the points on which the case may turn.
- **E**nsure you are familiar with the entire record, not just positions helpful to your case.
- **F**ocus on your substantive arguments, based on the evidence of record, rather than the background or history of the parties and the process that led the parties to the Board.
- www.uspto.gov/sites/default/files/ip/boards/bpai/oral_advocacy_before_the_ptab_2014_0620.pdf

