

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# Best practices to present argument related to patentability and unpatentability before the PTAB

Judge James T. Moore  
Judge Kalyan K. Deshpande  
Judge Christopher L. Crumbley

Patent Trial and Appeal Board Webinar Series  
June 7, 2016

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# Boardside Chats

Date	Time	Topic	Speakers
Thursday, June 23 (Special Addition)	Noon to 1 pm Eastern Time	Demonstration of PTAB End-to-End New Filing System	Heather Herndon, Acting Branch Chief, IT Systems and Services Branch
Tuesday, August 2		Presentation of prior art in an AIA trial	Judges Barry Grossman and Kevin Chase
Tuesday, October 4		Use of demonstratives and/or live and/or oral testimony at oral argument  Presenting your case at oral argument to a panel including a remote judge	TBD

# AIPLA/ PTAB Bench & Bar Conference

- Thursday, June 15 from 1 to 5:30 pm followed by networking reception
- Alexandria headquarters or via webinar
- Registration at <http://www.aipla.org/learningcenter/PTABBenchAndBar2016/Pages/default.aspx>

# Agenda

Topics	Presenter
Best practices	Judge James T. Moore Judge Kalyan K. Deshpande Judge Christopher L. Crumbley
Q&A with audience	Janet Gongola (moderator)

# Overview

- I. General Observations
- II. Claim Construction
- III. Specific Arguments

# I. General Observations

- Kitchen Sink Briefs
- Nonresponsive Arguments
- Emotion, Exaggeration, and Puffery
- Precedent
- Reply Brief
- Request for Rehearing
- Oral Argument Protocol

# Kitchen Sink Briefs

Numerous Decisions:

- Which grounds/rejections to appeal
- Which claims to argue separately
- How many arguments for each ground
- Single or multiple petitions

# Nonresponsive Arguments

**Claim:** An injection device comprised of five elements

**Rejection/ground:** obviousness over Takei and Buchner

- Takei discloses everything but element E
- Obvious to add Buchner's element E to Takei

**Non Responsive Arguments:**

- Takei does not disclose an injection device (elements A-E)
- Buchner does not disclose A-D

# Emotion, Exaggeration, and Puffery

- Avoid emotion
  - “The Examiner takes the ridiculous position that . . . .”
  - “The Patent Owner stubbornly refuses to concede. . . .”
- Avoid Exaggeration
  - “The Examiner provides *no reason* for the proposed modification.”
  - “The reference has *nothing to do* with the claimed subject matter.”

# Emotion, Exaggeration, and Puffery (continued)

- Avoid puffery
  - “It is clear that. . .”
  - “It is beyond dispute. . .”

# Precedent

## Not Binding

- MPEP
- District Court Cases
- Routine/Representative/Informative Board decisions
- Non precedential Federal Circuit Decision

## Binding

- Supreme Court Decisions
- Federal Circuit precedential Decisions
- Precedential Board Decisions

# Reply Brief

- Do not simply repeat the Appeal Brief
- If everything was addressed in the Appeal Brief, consider resting on that
  - Caveat: sometimes a reply is required
- Effective Uses:
  - Intervening case law
  - Countering the answer

# Request for Rehearing

- “state with particularity the points believed to have been misapprehended or overlooked by the board”
- Don’t simply repeat earlier arguments
- Identify where the argument was previously made

# Oral Argument Protocol

- Avoid emotion
- Cordial and respectful
- No new arguments
- Exhibits should have been shown/served to opposing counsel
- Presentation vs. interactive
- Recognize that some Judges may be remotely viewing

# II. Claim Construction

- Semantics
- Importing limitations from the specification
- Other arguments that are not commensurate in scope

# Semantics

**Claim:** Recites “a first power source”

**Finding:**

Lee’s combination power supply 10 and plug 11 correspond to a first power source as claimed

**Argument:**

“Lee discloses a power supply 10 and a plug 11 not a first power source as claimed.”

# Importing from the Specification

**Claim:** “a structure including a plurality of metallic members which support a platform”

**Specification:** The preferred embodiment includes four metallic legs supporting the platform.

**Argument:**

“The prior art does not disclose four metallic legs supporting the platform.”

# Other Arguments

## **Claim:**

Claim 1 is directed to “[a] coupling for a medical instrument for connecting two lines.”

## **Argument:**

The prior art coupling does not conduct fluid as required by claim 1.

## **Analysis:**

- Not expressly in the claim
- Specification says “line” refers to all types of tubular structures to include lines for electricity and light
- Consequently, the coupling of claim 1 is not limited to connecting fluid lines

# III. Specific Arguments

- Rationale
- Non-analogous Art
- Secondary Considerations
- Teaching Away
- 112 Enablement

# Rationale

## **Proffered Rationale:**

The ground/rejection combines Miller and Naito. The proffered rationale is to reduce production cost.

## **Arguments:**

- Miller does not disclose a technique for reducing production cost
- The ground/rejection does not contain any rationale
- Combining these references would increase maintenance cost
- The proffered rationale is insufficient and therefore the combination is based on hindsight
- Miller's sensor is too large to fit into Naito's device

*These arguments generally are ineffective.*

# Nonanalogous Art

## Arguments:

- “Jones is not in the same field of endeavor.”
- Against a combination based on Miller and Morin  
“Miller is not analogous to Morin.”

*These arguments generally are ineffective.*

# Secondary Considerations

## Typically Ineffective Arguments:

- Arguing the age of references alone
- Arguing commercial success without evidence of market share
- Arguing any secondary consideration without establishing add nexus to the claimed subject matter
- Arguing copying without establishing the copy is the same as the claimed product
- Arguing long felt need without establishing that the invention satisfied that need

# Teaching Away

## Ineffective

- The reference discloses an alternative approach
- The reference discloses an inferior alternative
- Improper characterization of the reference
- Differences

## Effective

- Direction divergent from that chosen by Appellant
- Unlikely to be productive of the result sought
- Change the basic principle of operation
- Renders the prior art unsatisfactory for its intended purpose
- It would produce an inoperative device

# 112 Enablement

## Arguments:

- The Examiner did not cite to *In re Wands*
- The Examiner did not address each of the eight *Wands* factors

*These arguments generally are ineffective.*

The proper inquiry is whether undue experimentation would be required. Explicitly addressing each factor is not required

**Questions?**

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**Thank You**

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