

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# **LEAP Mock Arguments and Practicum**

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# Agenda

**1:00 – 1:30**

Welcome and Opening  
Remarks

- Chief Judge Scott Boalick
- Director Andrei Iancu
- PTAB Bar Association President Steve Baughman

**1:30 – 3:00**

Mock Arguments

- Participant Arguments (30 minutes per side)
- Panel Feedback to Participants (30 minutes)

**3:00- 4:00**

Practicum and Closing  
Remarks

- Oral Advocacy: Deconstructed

# Opening Remarks



# Chief Judge Scott Boalick

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# Director Andrei Iancu

# **Steve Baughman**

## **President of PTAB Bar Association**

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**Mock Arguments**  
**(please proceed to your hearing room)**

# Oral Advocacy: Deconstructed

Tim Fink, Vice Chief Administrative Patent Judge  
Janet Gongola, Vice Chief Administrative Patent Judge  
Kal Deshpande, Lead Administrative Patent Judge

# Introduction

# Purpose of oral argument

- A lawyer's view: win the case
- A judge's view:
  - <https://www.youtube.com/watch?v=JzKExC2MJsQ>

# Capstone of the case

- Conversation—not a lecture
- Explain case simply and clearly—do not deluge the judges with excessive facts and authorities
- Maintain good eye contact and watch for body language
- Speak clearly and not too fast



# Stand and address the court



**Opening:**

**Make the first few seconds count**

# Purpose of the opening?

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# Purpose of the opening

- Use the first, uninterrupted seconds strategically
- Tell the court what the case is about and what issues it must decide
- You want the judge to focus on your case and distinguish it from the other cases that the judge has on his/her docket
  - “This is a contact lens infringement suit where the issue concerns the claim construction of the term “oval.”

# Case 1: *Dretke v. Hadley* (S.Ct. 2004)

- Haley was arrested for stealing a calculator from Wal-Mart and convicted of theft. Crime was punishable by two years in prison, but prosecutors charged him as habitual felony offender under Texas “three strikes” law
- Judge agreed and sentenced to 14.5 years. Under the law, Haley’s prior felonies did not count, but his defense counsel did not raise
- Texas conceded Haley did not meet law, but argued Haley procedurally defaulted by waiving the argument
- Haley contended he was actually innocent of the prior felonies and therefore met the exception to the procedural default document
- 5<sup>th</sup> Circuit ruled that Haley fit into the “actual innocence exception” and should be released
- Issue = Whether the actual innocence exception applies to capital and non-capital cases?



# Effective opening?

# ***Dretke* opening**

- Used first, uninterrupted seconds to raise a broad policy issue, avoiding the facts of his case
  - Elephant in the room: person imprisoned for years on an erroneous sentence
  - Avoid the “then, why are you here?” moment by confronting that fact head on
- Loss 6-3

## **Case 2: *Global-Tech v. SEB (S.Ct. 2011)***

- Issue = what level of knowledge is required for induced patent infringement





# Effective opening?

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# ***Global-Tech* opening**

- Used first, uninterrupted seconds strategically to state that no matter what “test” the Court adopts his client should win
  - First question by Justice Kagan helped him reinforce that point
- Win 8-1

**Middle:**

**Answer the Questions**

# Purpose of the judge questions?

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# Purpose of judge questions

- Test positions for strengths and weaknesses
- Determine implications of ruling a certain way often through hypotheticals
- Force parties to face up to weaknesses in their case
- Rarely will success depend on the “speech” you prepared in advance; success depends on the answers to judge questions

# How to answer judge questions

- Stay calm and listen to question
- Respond immediately with “yes/no” and not “I’ll get to that later”
- Respond with candor and do not bluff or exaggerate
- Okay to say “I don’t know”; provide answer on rebuttal
- If you don’t understand the question, ask for clarification
- Conferences directly follow arguments—your answers are in the judges’ mind when they “conference” the case

# Justice John Roberts, in his own words:

- <https://www.youtube.com/watch?v=UJQ7Ds4nAmA>

## **Case 3: *Fields v. City of Philadelphia* (3d Cir. 2017)**

- Anti-fracking protest at Philly Convention Center. Police acted to arrest a protestor, and Fields was standing on public sidewalk and took a photo
- Police ordered him to leave and Fields refused. Police arrested Fields and confiscated his phone and opened several photos
- Fields alleged First Amendment retaliation
- Issue = whether the First Amendment protects acts of photographing or otherwise recording police conducting official duties in public



# Appellant's argument



# Effective answers?

# Appellant's argument

- Answered the question immediately and directly: "both," "absolutely"
- Explains how the court should decide the issue
- Did not fight the hypotheticals on "time, place, and manner" and "I-95 v. Temple campus"
- Brought the panel back to her point: "that's not this case"
- Won appeal

# Appellee's argument



# Effective answers?

# Appellee's argument

- Did not directly answer "yes/no" hypothetical
- Did not read body language of judge: winged arms, dropped jaw, crossed arms, scowl
- Could defend the dispositive argument in the appeal by case law citation: what support for the idea that permissibility of taking picture is tethered to the intent of what to do with picture
- Finally cited a case, authored by the Judge, that stands for a different legal point: symbolic speech
- Lost appeal

**Closing:**

**Finish Strong**

# Purpose of closing?



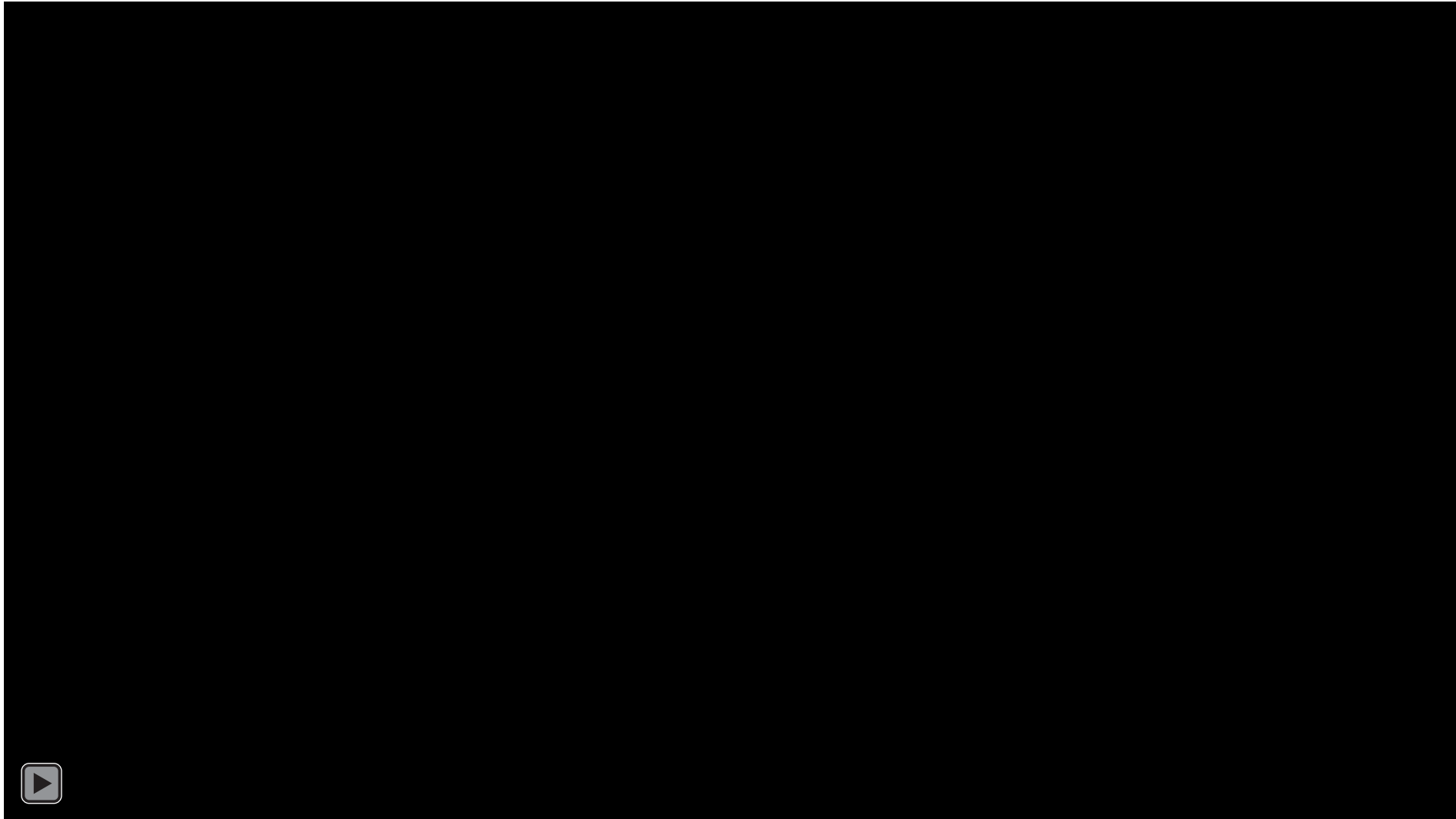
# Purpose of closing/rebuttal

- Request the desired outcome succinctly
- Do not rebut unless you have something important to say; don't waste time with correcting minor errors or addressing peripheral points and never introduce a new subject

# **Case 4: *Doe v. Pasadena Unified School Dist.* (9th Cir. 2020)**

- Jane Doe, an undocumented immigrant, and her children sued the Pasadena school and the school principal for allegedly threatening to call immigration if she complained about his school lunch policy to the school board
- Issue = whether summary judgment to the school should be affirmed because no material facts that Doe or her children were denied any educational opportunities?

# Closing



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# Effective closing?

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# Closing

- Summed up the case in 1 minute, 15 seconds:
  - Restate good facts: “there 39 times”
  - Legal standard: No material disputes
  - Summary judgment should be affirmed; no need to remand
- Know when to sit down
- Affirmed

# Final Thought

# Lose gracefully – you can't win them all



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# Questions?



**Thank you:**

**Go forth and oral advocate**

