

DESCRIBING THE TECHNOLOGY IN AIA PROCEEDINGS

Administrative Patent Judge Russell Cass

Administrative Patent Judge Kimberly McGraw

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Brian Murphy, Haug Partners LLP

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NYIPLA PTAB Committee

UNITED STATES
PATENT AND TRADEMARK OFFICE



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 bachelors in engineering or science
 - Not every APJ on the panel may have same level experience in technology at issue
- Paper record primarily

Timeline of an AIA Proceeding



Where to include technology descriptions

- Petition
- Petitioner's Expert Declaration
- Patent Owner Preliminary Response/Declaration
- Patent Owner Response/Declaration
- Reply/Declaration
- Sur-reply
- Oral Hearing

Questions/Comments

Where to include technology descriptions

Petition

- Background/Separate Technology Overview Section
- Overview of Patent
- Summaries of Prior Art References
- Claim Construction
- Explanation of Combination of References
- Applying Prior Art to Claims

Expert declaration

- Background technology tutorial
- Defining/explaining technical terms and concepts
- Expanding on technology in the patent/prior art/argument
- Discussing additional references/materials

Patent Owner Preliminary Response and Patent Owner Response

- Different Goals for Preliminary Response and Response
- Preliminary Response:
 - Explain why trial should not be instituted.
 - Discretionary Denials
 - Missing claim elements
 - Error in Petition
- Response
 - Address the merits – focus on holes in Petitioner’s argument

Reply and Sur-reply

- Focuses on disputed issues
- Opportunity to focus the panel in on the relevant evidence to support the case
- Highlight inconsistencies in arguments
- Reply can include declaration with additional technology descriptions and figures
- Can discuss deposition testimony

Tips for addressing technology descriptions

Using modified/annotated figures

- Highlighting and/or labeling **relevant** portions
- 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

Situations that may benefit from additional explanation

- Product specifications
- Technology standards
- Unpredictability
- Teaching away/technical obstacles
- Inherent disclosures

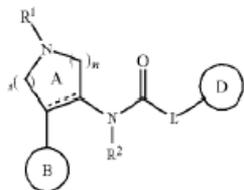
Questions/Comments

Are the visuals effective in these examples?

Petition: Example 1

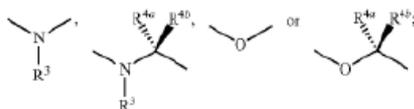
Claim 1:

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 ----- 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-quinolyl is excluded;
 L is a group represented by the formula



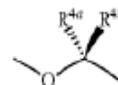
R^2 , R^3 , R^{4a} and R^{4b} are each independently a hydrogen atom, an optionally halogenated C_{1-6} alkyl group or an optionally halogenated C_{3-6} cycloalkyl group, or R^2 and R^3 are optionally bonded via an alkylene chain or an alkenylene chain, or R^{4a} and R^{4b} are optionally bonded via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

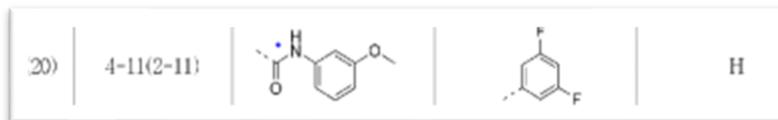
excluding: N-[4-(biphenyl-4-yl)piperidin-3-yl]-N'-(naphthalen-2-yl)urea;

or a salt thereof.

Prior Art Disclosures:

EP '721: N-[4-(4- {[3-[(anilincarbonyl)(butyl)amino]-4-(3-fluorophenyl)pyrrolidin-1-yl]methyl}phenoxy)phenyl]methanesulfonamide.

KR '645:

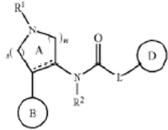


uspto

Petition: Example 1

Claim

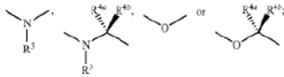
I. A compound represented by the formula



wherein

ring A is a piperidine ring or a pyrrolidine ring and each straight line is a single bond and $\text{---}\text{---}\text{---}$ 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-quinolyl 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;

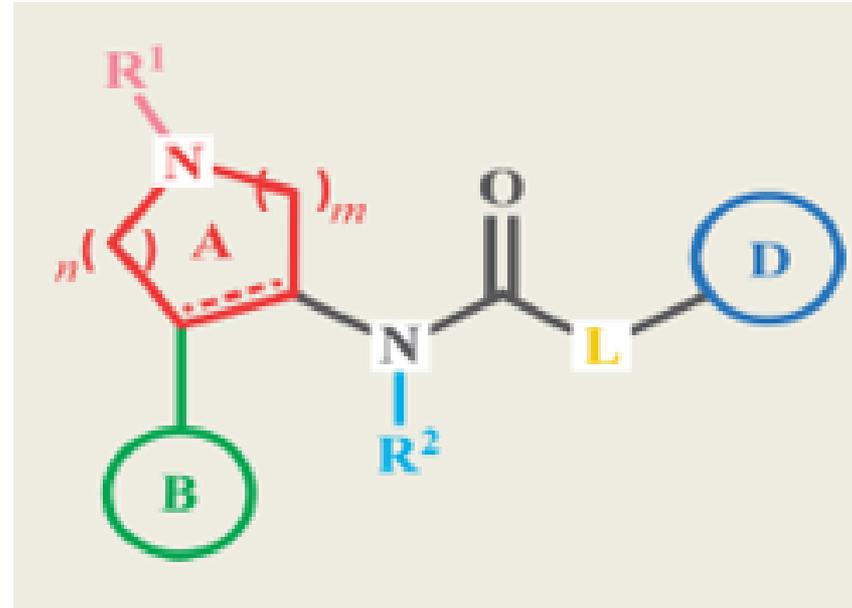
m and n are each independently an integer of 0 to 3, and m+n is an integer of 2 to 3;

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);

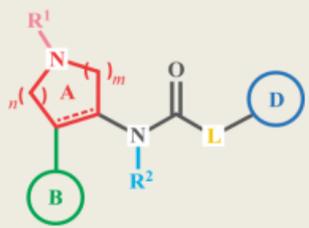
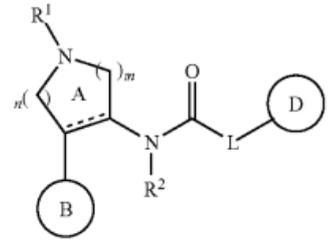
excluding: N-[4-(biphenyl-4-yl)piperidin-3-yl]-N'-(naphthalen-2-yl)urea; or a salt thereof.



uspto

Petition: Example 1

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>

Petition: Example 2

FIG. 1

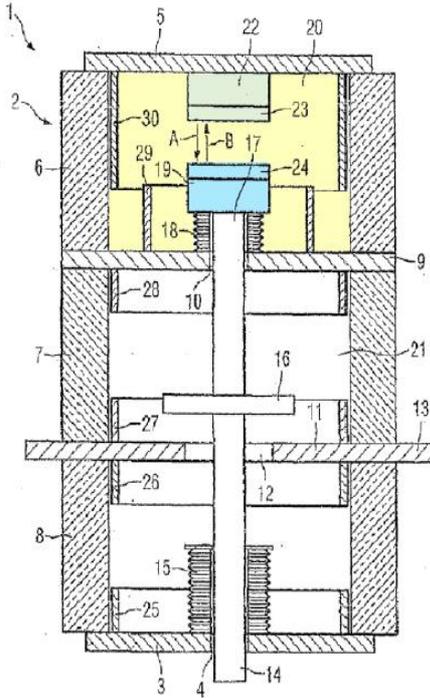


FIG. 1

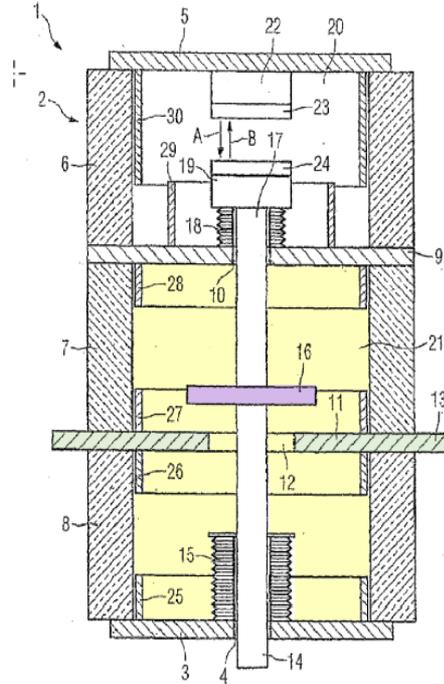
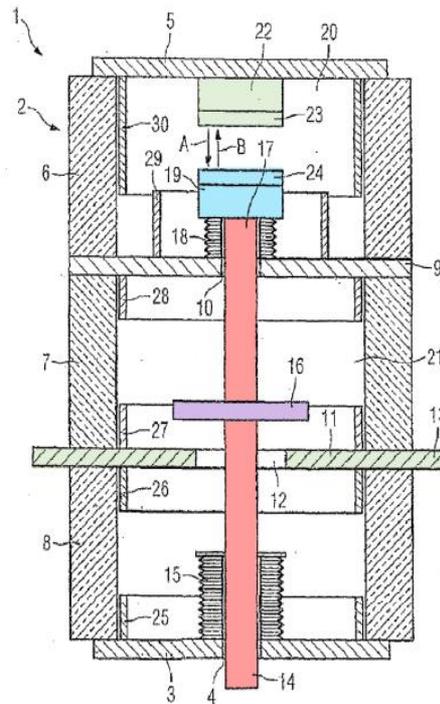
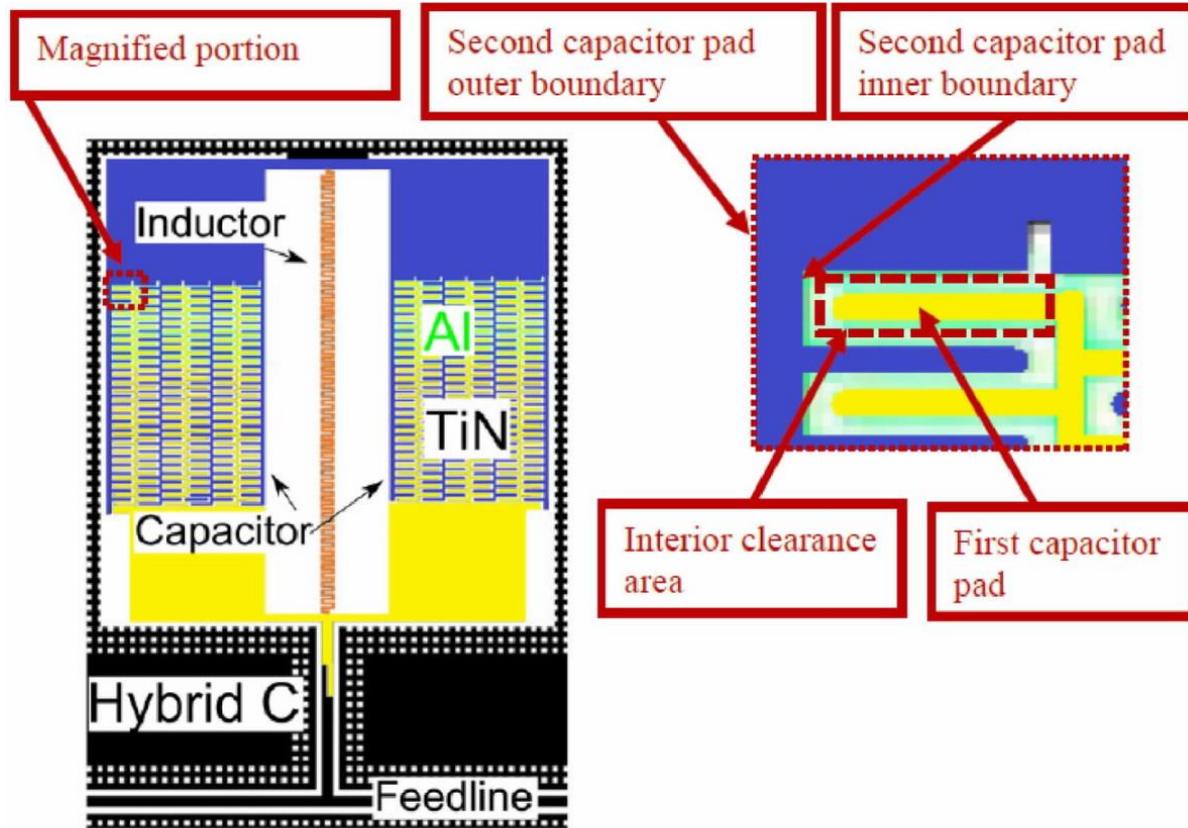


FIG. 1

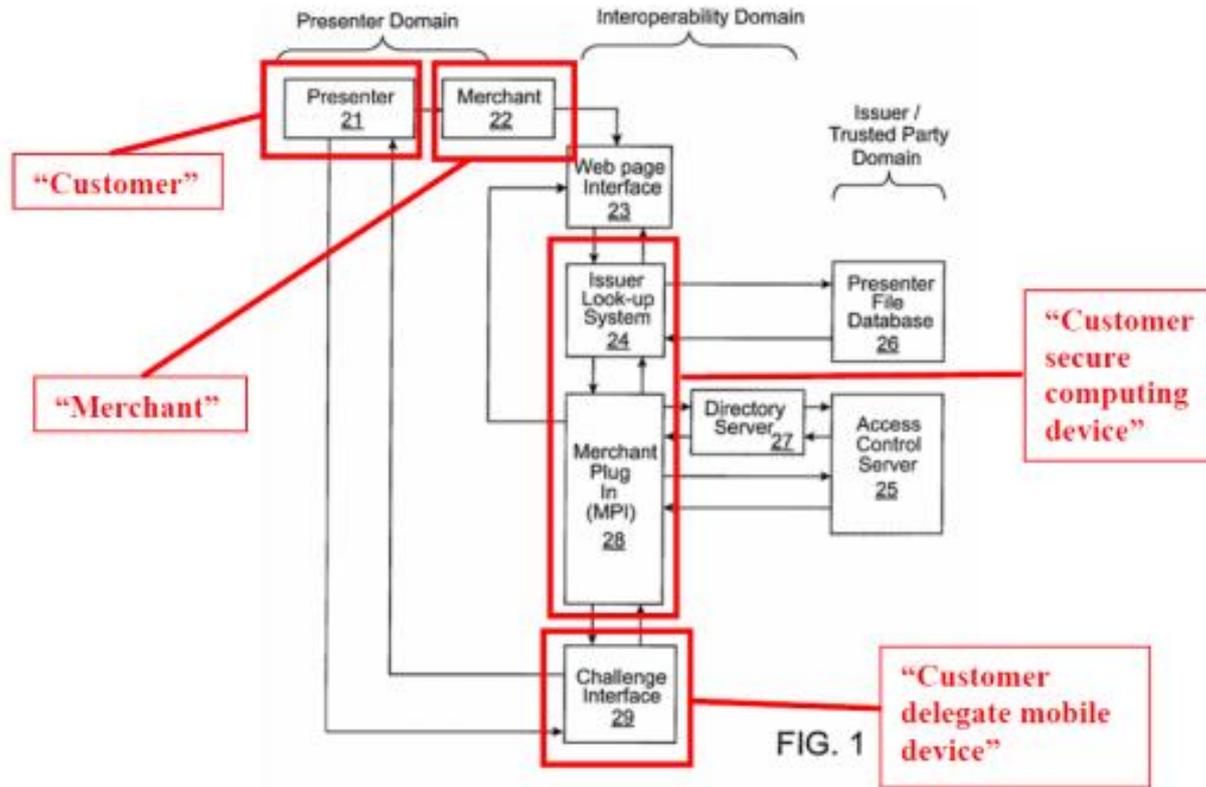


Petition: Example 3

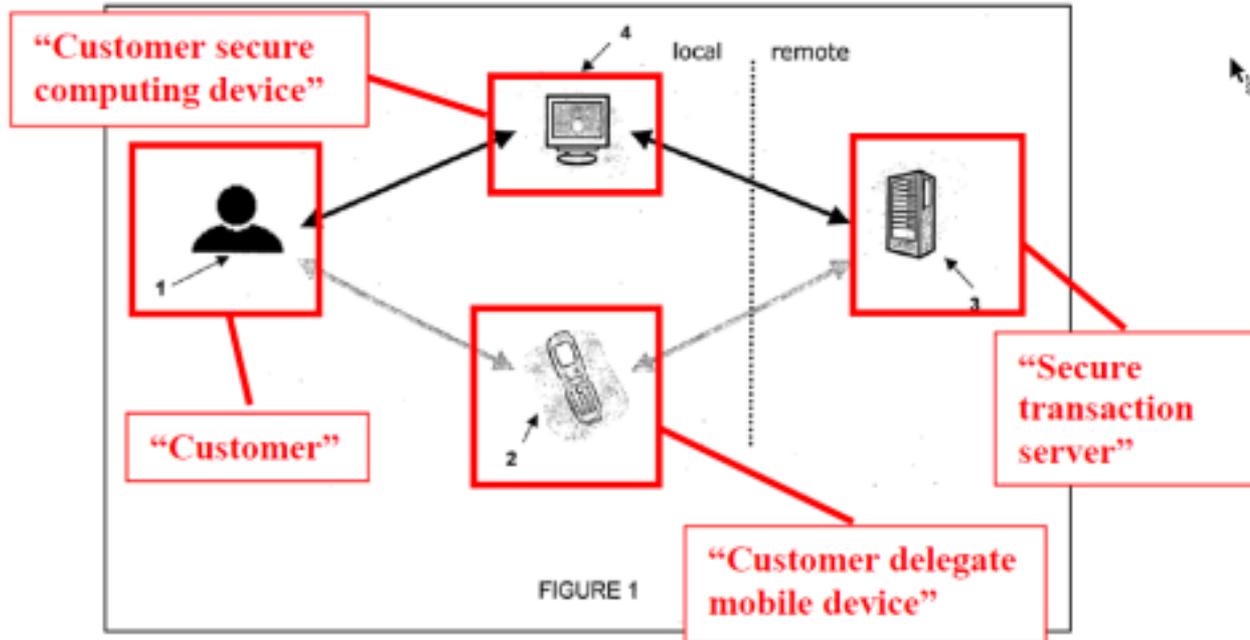


IBM-1010, Fig. 1 (partial and annotated)

Petition: Example 4

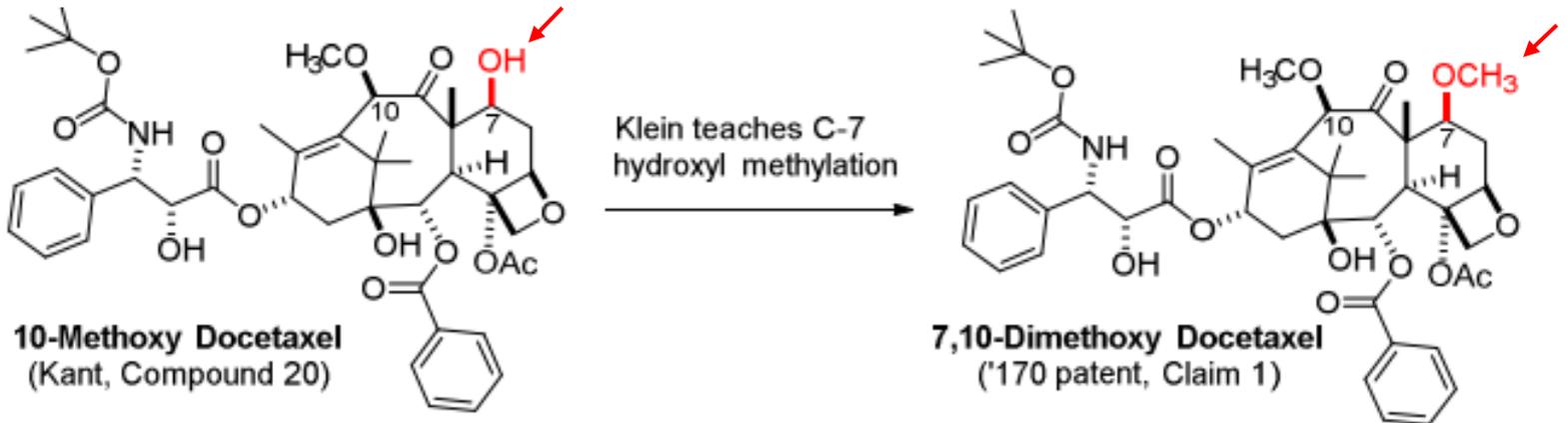


Petition: Example 4

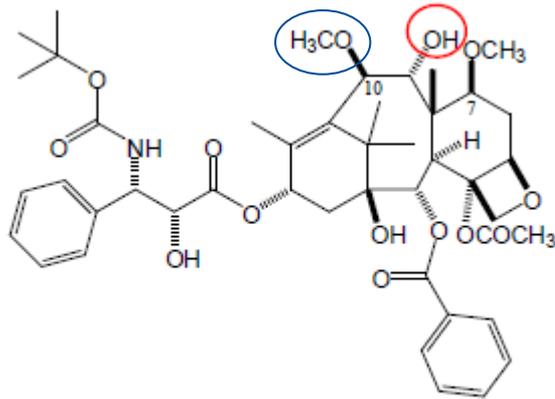


POPR: Example 5

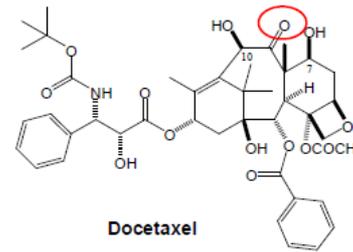
Petitioner's Argument:



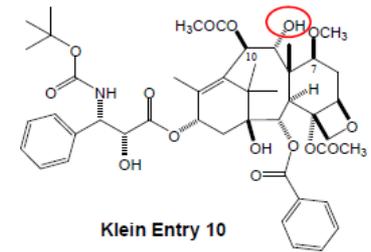
POPR: Example 5



**Kant Compound 20 With
C-7 Methyl and C-9 Hydroxyl of Klein Entry 10**



Docetaxel

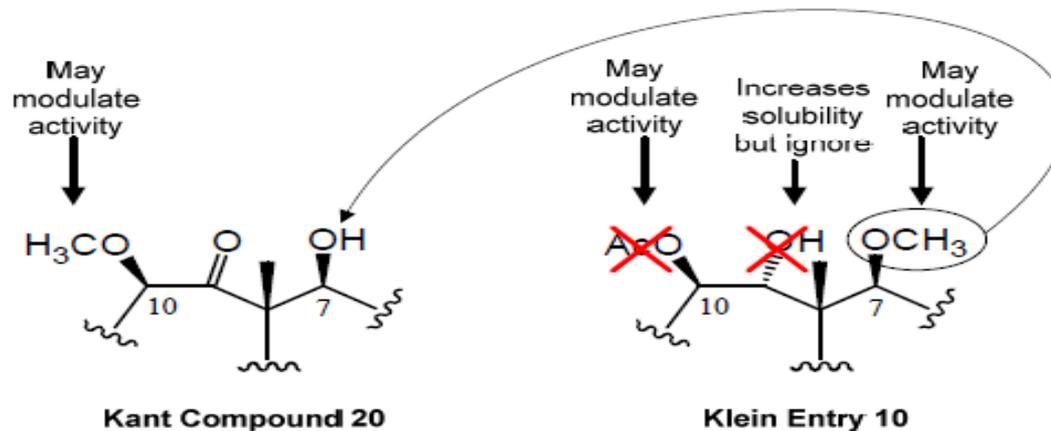


Klein Entry 10

Mylan fails to explain why a POSA would want to ignore the key teaching of Klein and lose these benefits by changing its key C-9 modification back to a C-9 oxo group to obtain cabazitaxel.

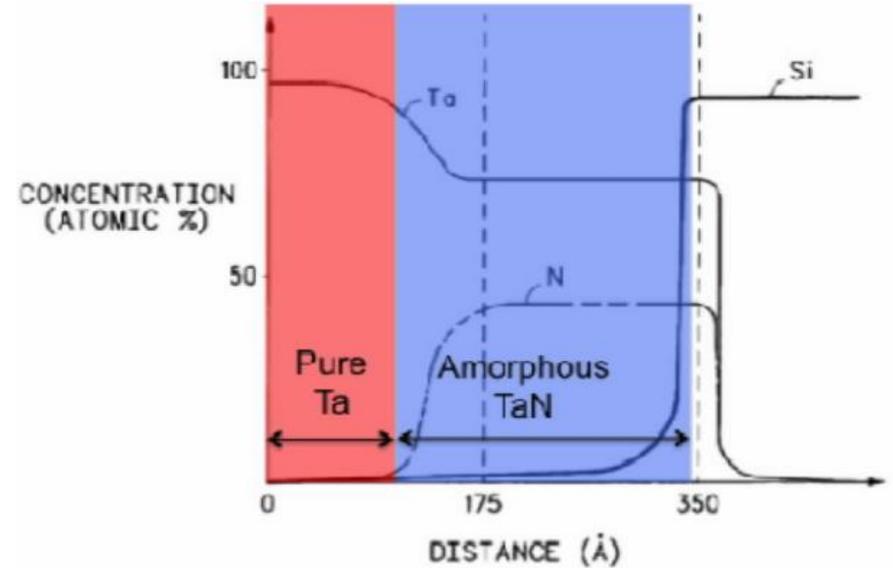
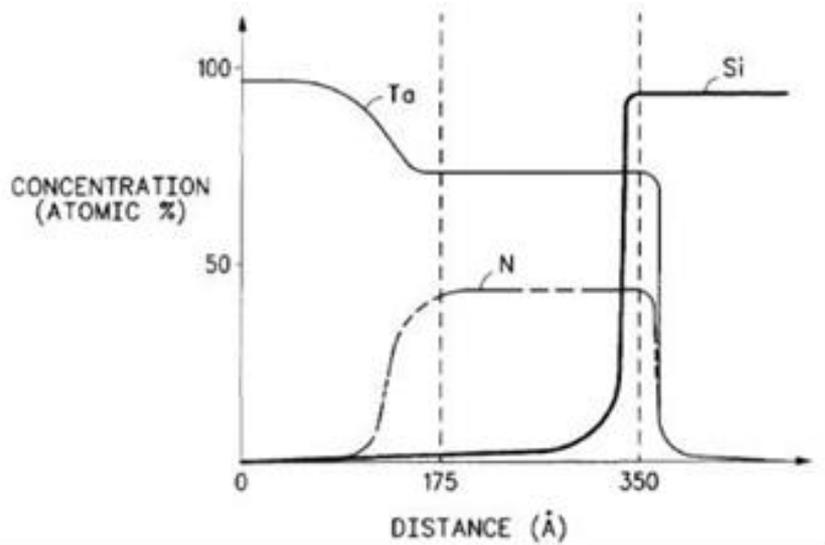
POPR: Example 5

In reality, Mylan's analysis requires perfect hindsight by having the POSA select only the C-7 methyl from Entry 10 in Klein and rejecting all the other teachings of Klein to modify the Kant 20 compound:



Mylan's cherry-picking approach should be rejected.

Petition: Example 6



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

Oral Hearing

Hearing Room A



Hearing Room B



Hearing Room D



- Panel is very familiar with the record at this stage
- 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 vs. In person
- Animation and video require advance approval

Demonstratives

- Typically demonstratives due 5 days before hearing (can be modified)
- PTAB hearing rooms contain an Elmo projector and laptop projector
- Parties must provide their own laptop
- Currently, PTAB has HDMI, VGA, and Mac connections only
- Different judges use demonstratives differently

Demonstratives: Example 1

Ground 2 – Claim 8 Invalid Undisputed / Drovok (Ex1006)

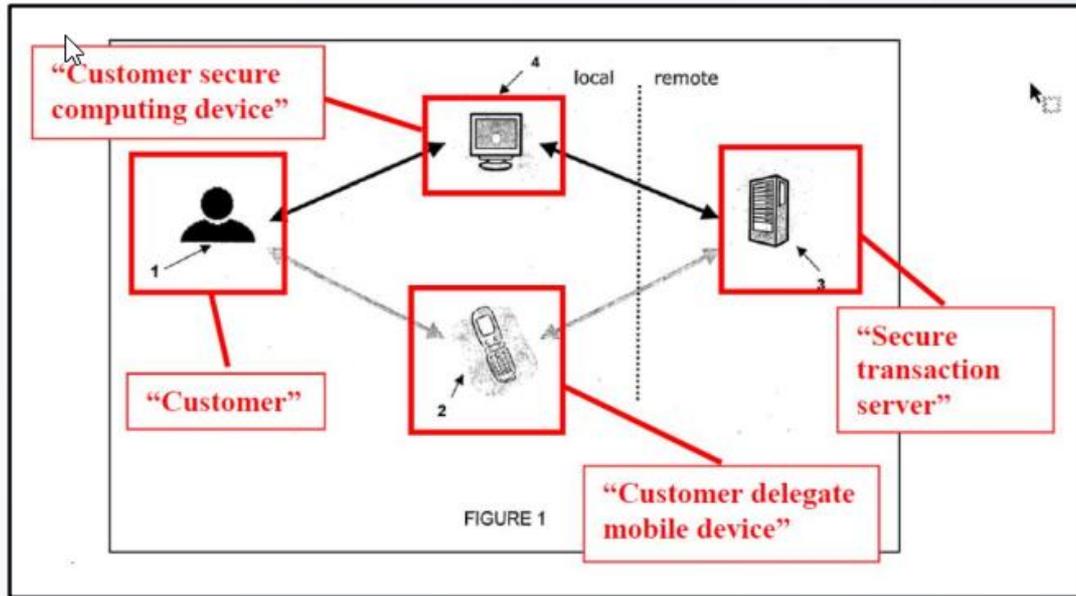


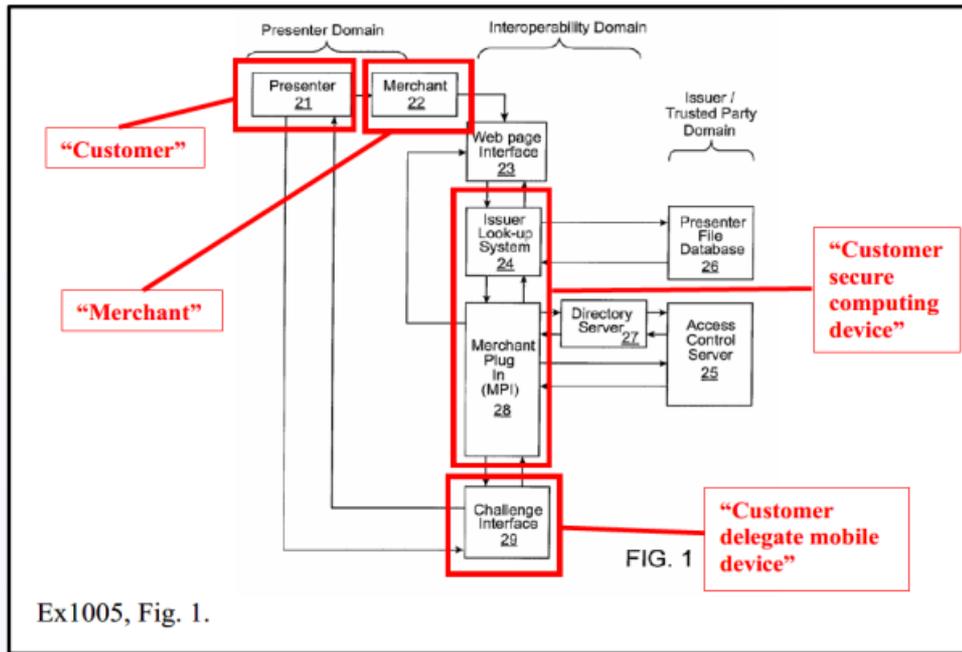
FIGURE 1

Institution Decision, Paper No. 16, p. 27
(citing Petition, Paper No. 1, p. 80,
marked up version of Fig. 1 from Drovok, Ex1006).



Demonstratives: 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



Demonstratives: 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

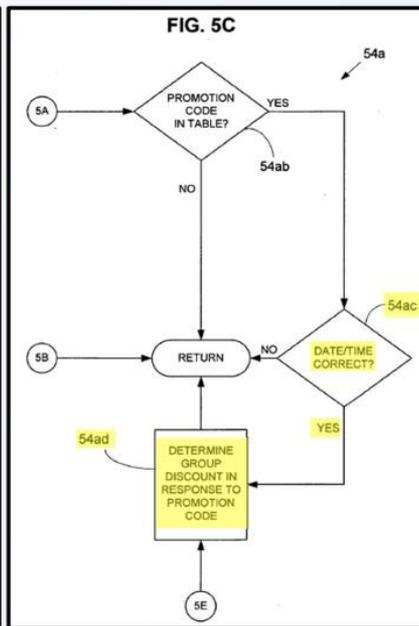
Only one compound needs to be enabled (*Id.* at ¶ 57)

Demonstratives: 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).

Demonstratives: 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.

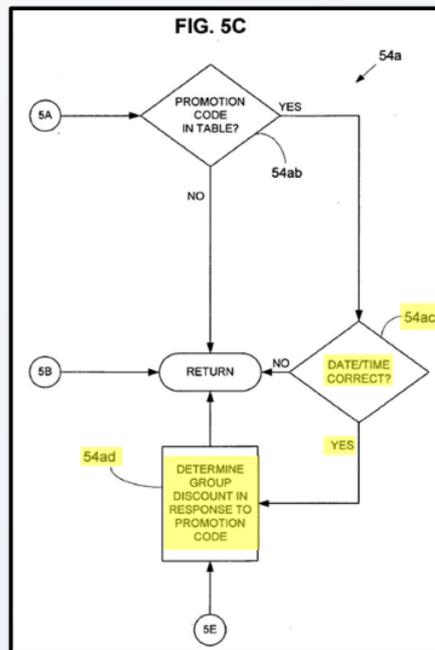
Q. In Wehr.

A. That's correct.

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

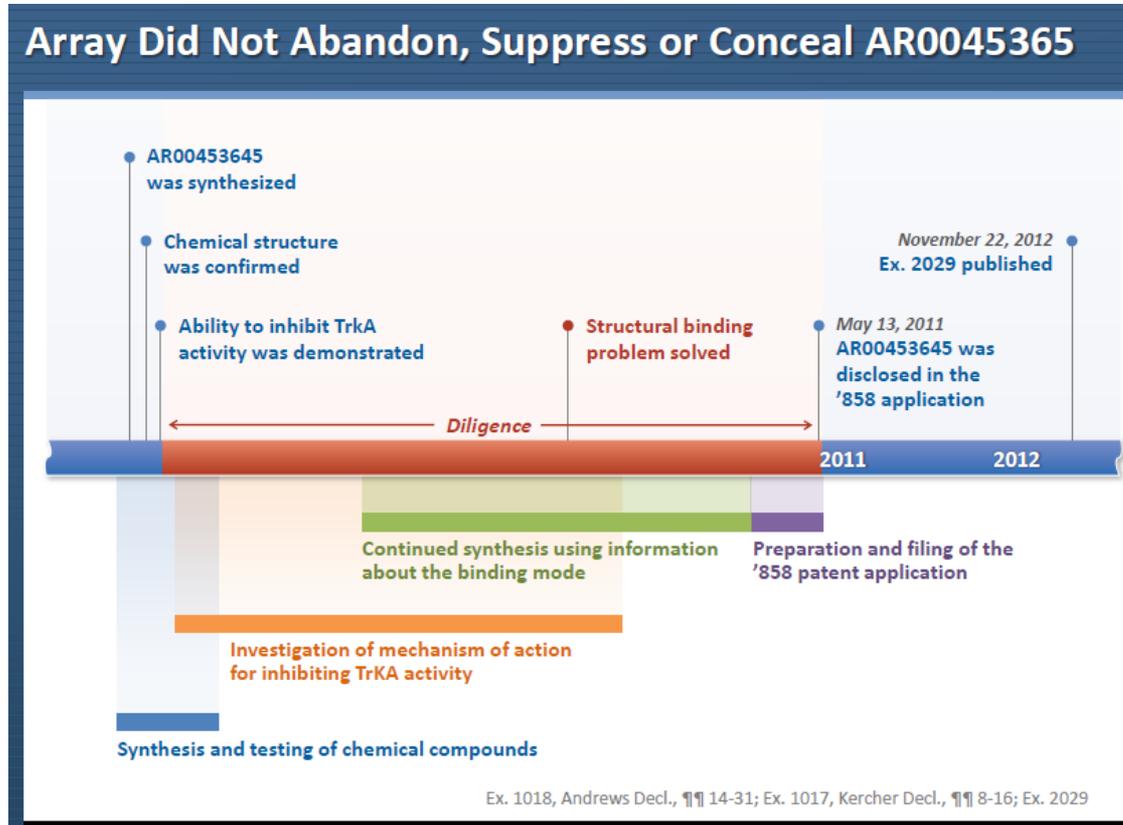
A. Fifty-four D -- give me a second.
(Reading.)
During the active time, yeah, yes.

(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).

Demonstratives: Example 5



Take-aways

- 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

Questions/Comments

