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*Vice Chief Judge for Engagement
Janet Gongola*



*Lead Administrative Patent Judge
Annette Reimers*



*Administrative Patent Judge
Rachel Townsend*

NYIPLA PTAB Committee Meeting

September 19, 2023, at 4:00pm ET

Ex Parte Appeals

Featuring a Patent Vignette

**Amster
Rothstein &
Ebenstein** LLP

Hosted by Co-chairs: Charles R. Macedo and Ken Adamo

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A Patent Vignette

Annette Reimers, Rachel Townsend,
and Janet Gongola
September 19, 2023



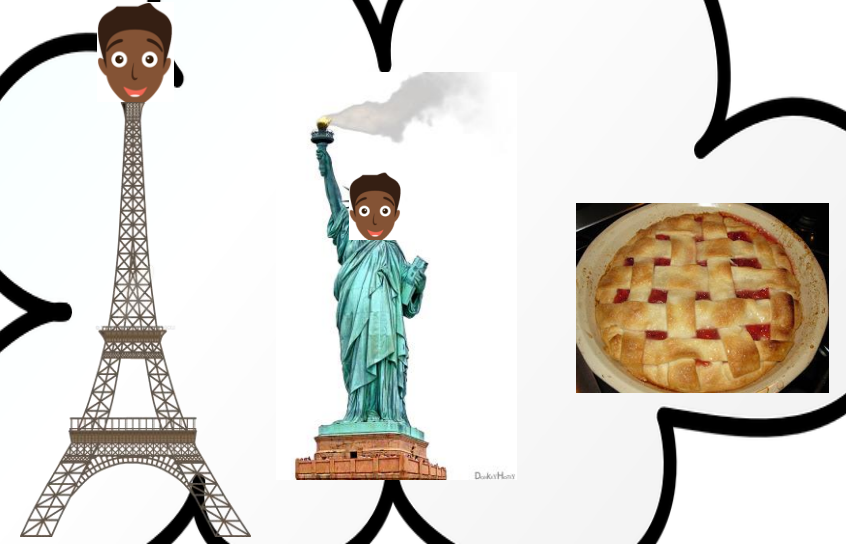
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Maurice is an electrical engineer. He was visiting the fair and saw the world's largest cherry pie.



In the souvenir shop, Maurice saw lots of pie themed merchandise like pans, slicers, and 3D replicas. Maurice wanted a 3D replica of himself with the pie. He had an idea!



Maurice decided that kiosks selling 3D replicas of tourists combined with sights like the Eiffel tower, the Statue of Liberty, or even the world's largest cherry pie would be highly desired.





Maurice decided that he should **file a patent application** for his idea. He hired Jen as his patent attorney and she filed his application with claims to a system and method.



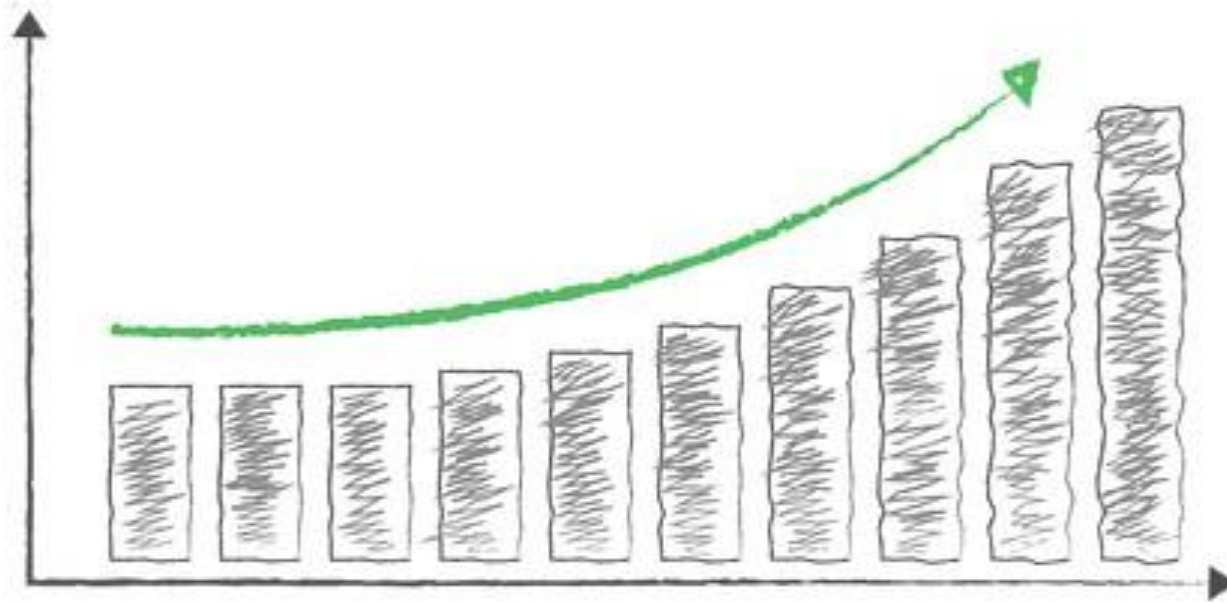


The USPTO patent examiner **rejected** all of Maurice's claims as obvious. Jen drafted claim amendments as well as arguments in response to the rejection. The examiner was not persuaded and issued a **final rejection**.





Jen suggests to Maurice that he **appeal** to the PTAB.



Meanwhile, Maurice tells Jen that **sales are booming** at his one kiosk, without any advertising. He even gives Jen a gift when she visits DC.



Question 1: What scope should Jen plan to address in the Appeal Brief?

1. A bullet point summary
2. Fulsome explanation of the law
3. Citation to case law with conclusory statement of what Examiner got wrong
4. Targeted argument of how the Examiner committed a legal error and/or the factual circumstances that establish the Examiner's erroneous conclusion

Question 2: *How should Jen organize Maurice's Appeal Brief? Why?*

1. Start with the weakest argument to build suspense
2. Start with the strongest argument to hit hard at the start
3. Organization doesn't matter so long as all the issues are present
4. Include the new evidence of Maurice's high volume of unexpected sales (which are not of record) as objective indicia of nonobviousness to convince the Board that the invention is patent worthy



Jen filed an Appeal Brief leading off with the **strongest argument** and arguing the dependent claims separate from the independent claims. Upon receipt of the Examiner's Answer, Jen noticed that the **Examiner clarified** some of his arguments and made what she considered to be a **new ground of obviousness rejection** for the software claim.



CLE Code

Question 3: *What advice should Jen give to Maurice about submitting a Reply Brief?*

1. Skip the Reply Brief because there is nothing new to be said.
2. File a Reply Brief to reiterate the Opening Brief.
3. File a Reply Brief only to respond to the Examiner's new ground of rejection.
4. File a Reply Brief only to address the Examiner's argument to the extent that the Examiner clarified those argument and a response would be useful to the Board.

Question 4: *How should Jen recommend Maurice respond to the Examiner's new grounds of rejection? Why?*

1. File a petition under 37 CFR § 1.181 to request that prosecution be reopened
2. Ignore it because an Examiner cannot raise a new ground of rejection in an Examiner's Answer
3. Address in the Reply Brief with argument only
4. Address in Reply Brief with new evidence in direct response to the new ground



Jen and Maurice decide to **file a Reply Brief to expound on the Examiner's clarified arguments and address the new grounds.**

Jen also tells Maurice that she thinks it would help to explain his inventions at an **Oral Hearing.**



Question 5: What should Jen argue at oral hearing on behalf of Maurice? Why?

1. Tell Maurice's story of invention and why the patents are so important to him. Maurice also wants to bring in the invention, display it, and make each panel member a souvenir
2. Explain patent law to the panel
3. Address how the examiner erred and point out any relevant case law that supports Maurice's case
4. Point out Maurice's high volume of unexpected sales (which are not of record) as objective indicia of nonobviousness

Question 6: *During the oral argument, the panel asks Jen a particularly difficult question. How should Jen handle this question?*

1. Tell the panel that she will get to the answer at the appropriate point in her pre-prepared script
2. Pause and ask for a moment to consult the record
3. Tell the panel that the question is not important, decline to answer, and continue with her pre-prepared script
4. Explain that she does not know the answer and request the opportunity to file a supplemental paper

Question 7: *During the oral argument, the panel pose a hypothetical to Jen. How should Jen handle the hypo?*

1. Tell the panel that the hypo is “not this case”
2. Answer the hypo and point out how Maurice’s facts are distinguishable from the hypo
3. Tell the panel that she does not know the answer to the hypo and return to her script
4. Revise the facts of the hypo to be favorable to Maurice and answer the more favorable hypo



At the oral hearing, Jen focused about **how the examiner erred** without involving Maurice. In response to the panel's difficult question, Jen paused to consult the record and did her best to **answer the question directly**. Jen received a **PTAB Decision reversing** the obviousness rejection on the system claims and **affirming** the new ground of obviousness rejection on the method claims.

Question 8: *What should Jen advise Maurice to do after he gets the Board Decision? Why?*

1. Allow the Examiner to take action on the reversal and likely obtain a patent on the system claims
2. Reopen prosecution for the affirmed new grounds of rejection on the method claims and file claim amendments or new evidence of the high volume sales
3. Request panel rehearing of the affirmed rejection
4. Appeal to the Eastern District of Virginia with new evidence
5. Appeal to the Federal Circuit

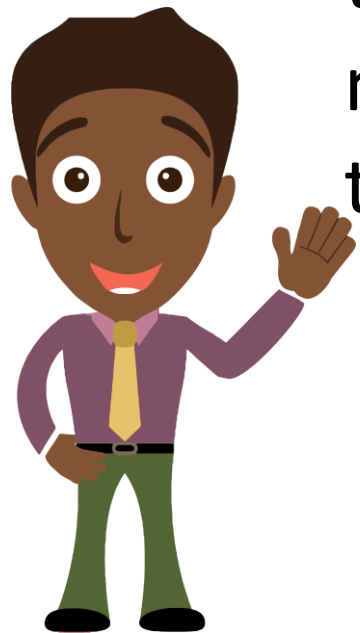


Maurice instructs Jen to **seek panel rehearing** on the affirmed new obviousness rejection.



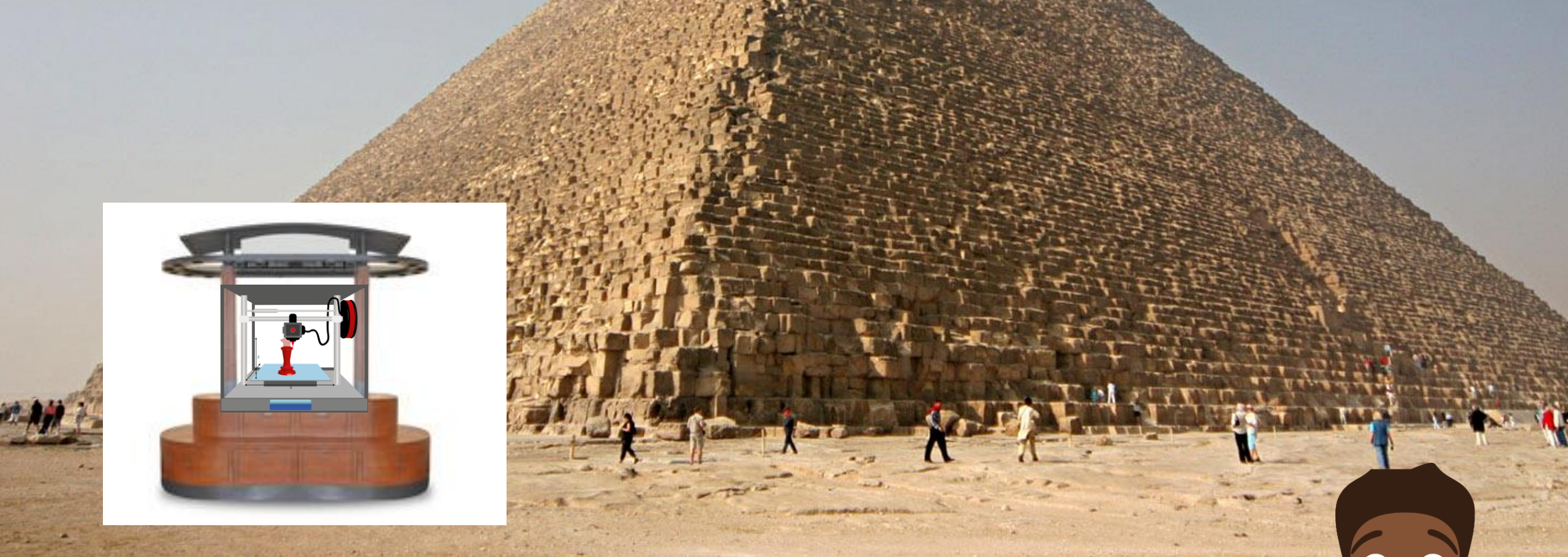
Question 9: *What should Jen advise Maurice to argue in the request for rehearing? Why?*

1. Argue that the panel should have taken the new evidence of the high volume sales (which are not of record) as objective indicia of nonobviousness and reversed the rejection
2. Point out why there was good cause to grant the patent
3. Show where the panel misapprehended or misunderstood the facts and/or law
4. Remake the arguments from the Opening Brief yet again because the panel must not have understood them



Jen explains that the standard for rehearing is to point out how the panel **misapprehended or overlooked the facts and/or law** and that the best strategy is to argue that there was no motivation to combine the references in the obviousness rejection.





While the rehearing was pending, Maurice was thrilled to let Jen know that his sales continued to increase, and that he received two **awards** from the World Travel Society for best souvenir and from the International Printing Society for best new scanner/printer.





The Board was not persuaded by Maurice's argument and **denied panel rehearing**. Jen advises Maurice to **reopen prosecution** and present the new evidence of **even higher sales and the awards**.



Maurice ends our story with **an issued patent on the system** and **one application** progressing to issue on the method, 35 kiosks around the world with booming sales, a trophy case for his awards, and ringing endorsement for his patent attorney, Jen.

Question 10: *What resources should Jen and Maurice know about if they want to learn more about the PTAB?*

1. New to PTAB webpage: <https://www.uspto.gov/patents/patent-trial-and-appeal-board/about-ptab/new-ptab>
2. Boardside Chat webinars: <https://www.uspto.gov/patents/ptab/ptab-boardside-chats>
3. Inventor Hour webinars: <https://www.uspto.gov/about-us/events/inventor-hour-events>
4. Hearings schedule: <https://www.uspto.gov/patents/ptab/hearings>

