



NYIPLA PTAB MEETING

Outcomes of Ex Parte PTAB Appeals



Co-chair, Charley Macedo



Co-chair, Ken Adamo



Partner, Clint Mehall



Judge, Mike Cygan



Judge, Debra Dennett



Judge, Jason Chung

 **Tuesday, March 19, 2024**

 **4:00 PM - 5:00 PM**

REGISTER NOW

 <https://www.nyipla.org/assnfe/ev.asp?ID=1501>

Disclaimer

The following presentation reflects the personal opinions of its authors and does not necessarily represent the views of their respective clients, partners, employers, or Amster, Rothstein & Ebenstein LLP, Davidson, Davidson & Kappel LLC, the USPTO, the New York Intellectual Property Law Association, the PTAB Committee, and the Patent Law and Practice Committee or their members.

Additionally, the following content is presented solely for discussion and illustration and does not comprise, nor is it to be considered legal advice.

**Amster
Rothstein &
Ebenstein** LLP

Join us at our Hospitality Suite located
in the Nassau West Room!

Friday, March 22nd
Located at the Hilton Midtown
2nd Floor, South Corridor
From 6:00pm-7:30pm

After dinner cocktails & dessert:
10:00pm - Midnight



THE NEW YORK
INTELLECTUAL PROPERTY
LAW ASSOCIATION

The
102nd
Annual Dinner
IN HONOR OF THE
*Federal
Judiciary*
— MARCH 22, 2024 —

Come join us for this prestigious
event at the Hilton for some
cocktails & conversation!

Obviousness Argument Analytics

4

DAVIDSON, DAVIDSON & KAPPEL, LLC

Common Obviousness Arguments

5

- I searched through PTAB ex parte appeal decisions using LexisNexis PatentAdvisor to see which common arguments were most likely to result in wins when mentioned in a PTAB decision

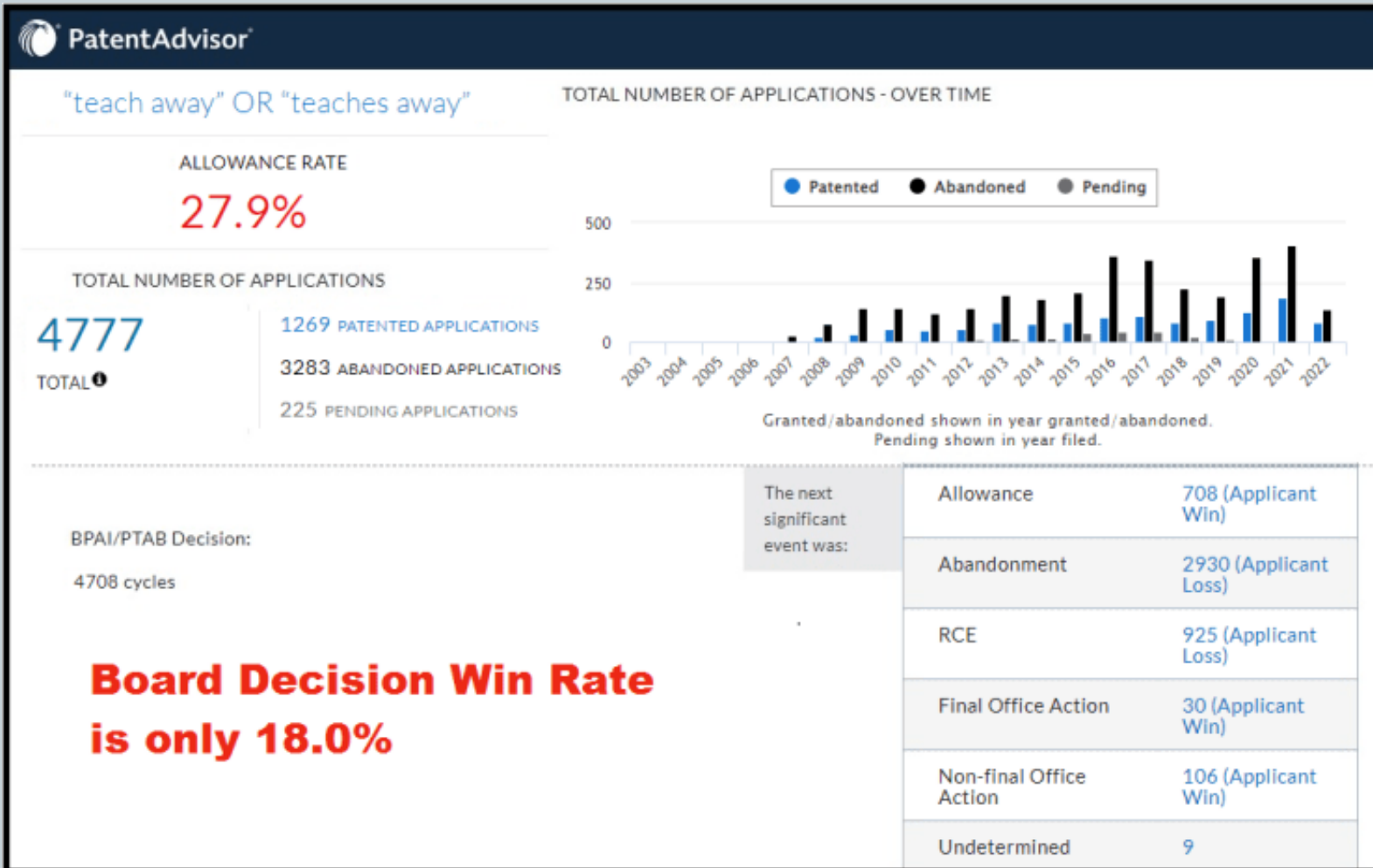
Common Arguments

6

- The prior art teaches away
 - -should only be used in specific circumstances where prior art essentially teaches modification would not work
 - -should not be used if prior art mentions it is more expensive, has inferior property, is a trade off between two properties

Common Arguments

7

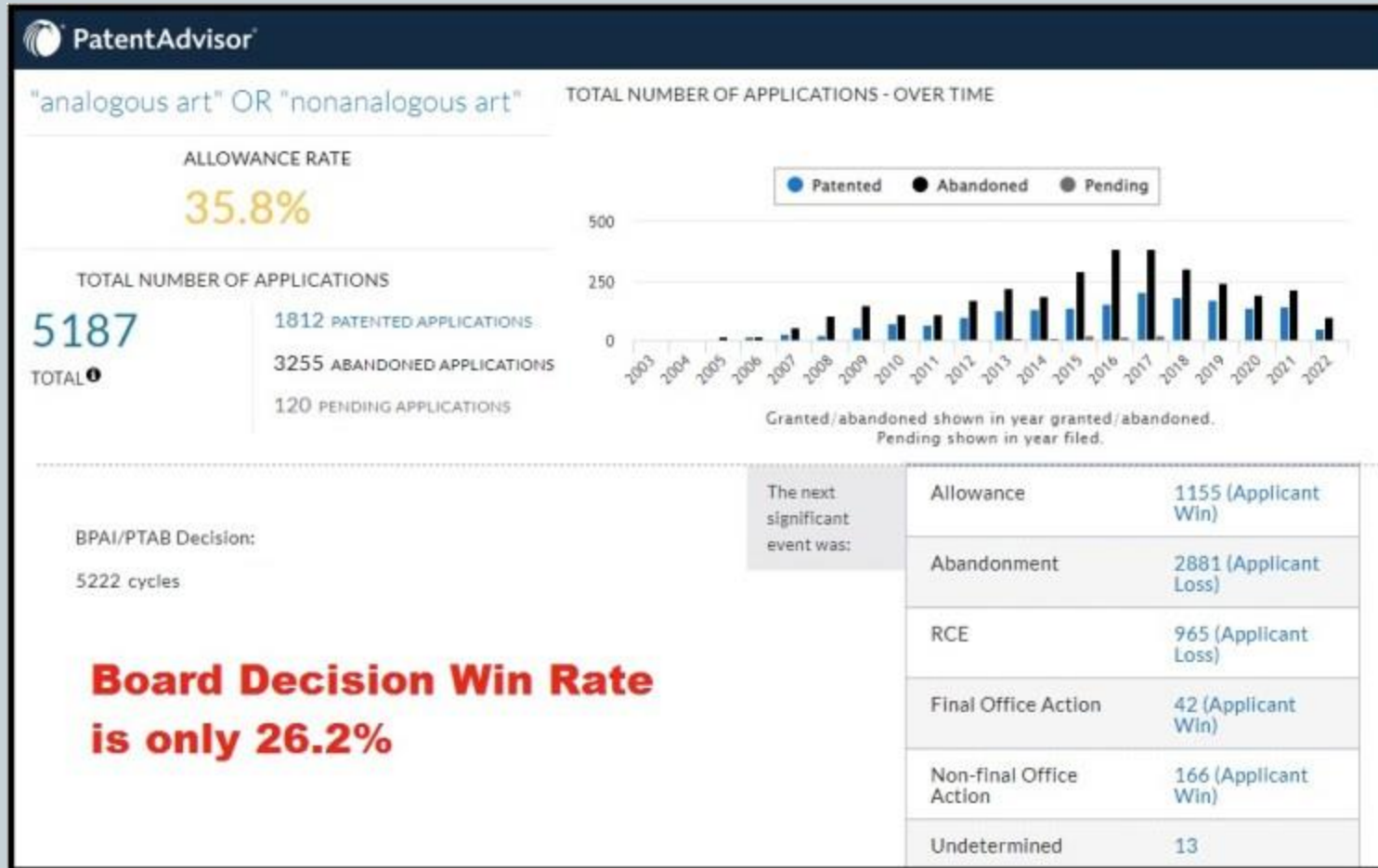


Common Arguments

8

- **The prior art is non-analogous art**
 - -have to show that (1) the prior art is not in the field of endeavor of the application and (2) the prior art is not reasonably pertinent to the problem faced by the inventor

Common Arguments



Common Arguments

10

- Reason for combination not supported by rational underpinning
 - "[R]ejections on obviousness grounds cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."
 - *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 417-18 (2007)

Common Arguments

11



Search

Business Development

My Saved Work

Browser Extension

Briefcase Search Results for

“rational underpinning”

ALLOWANCE RATE

55.1%

Board Decision Win Rate is 47.5%

TOTAL NUMBER OF APPLICATIONS

15302

TOTAL

8230 PATENTED APPLICATIONS

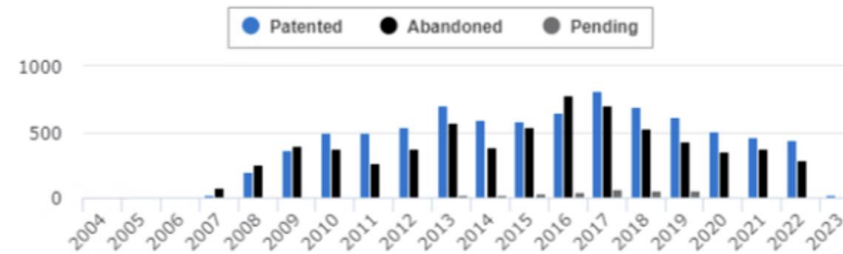
6710 ABANDONED APPLICATIONS

362 PENDING APPLICATIONS

This page is limited to patent applications with electronic file histories that were filed on or after 11/29/00.

[Click here to include all known published applications.](#)

TOTAL NUMBER OF APPLICATIONS - OVER TIME



Granted/abandoned shown in year granted/abandoned.
Pending shown in year filed.

Common Arguments

12

- Rejection lacks factual basis
 - “The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because *it may doubt* that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.”
 - *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967)

Common Arguments

13



PatentAdvisor

Search

Business Development

My Saved Work

Browser Extension

Briefcase Search Results for

"factual basis" "speculation"

Board Win Rate 82.9%

ALLOWANCE RATE

83.9%

TOTAL NUMBER OF APPLICATIONS

1525

TOTAL ⓘ

1222 PATENTED APPLICATIONS

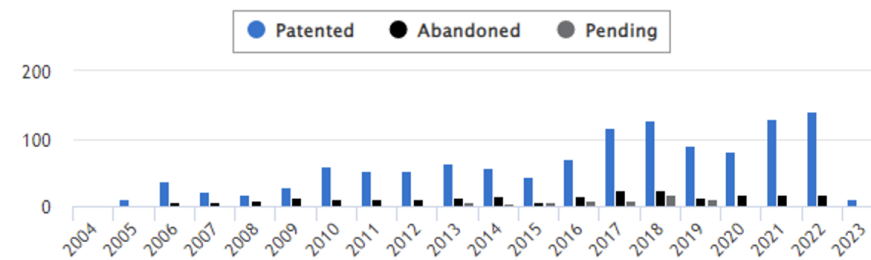
234 ABANDONED APPLICATIONS

69 PENDING APPLICATIONS

This page is limited to patent applications with electronic file histories that were filed on or after 11/29/00.

[Click here to include all known published applications.](#)

TOTAL NUMBER OF APPLICATIONS - OVER TIME



Granted/abandoned shown in year granted/abandoned.
Pending shown in year filed.

Common Arguments

14

● Hindsight bias

- “Any judgement on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant’s disclosure, such a reconstruction is proper.”
- *In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971)

Common Arguments

Briefcase Search Results for
"knowledge gleaned" "Hindsight"

Board Win Rate 17.9%

ALLOWANCE RATE
27.7%

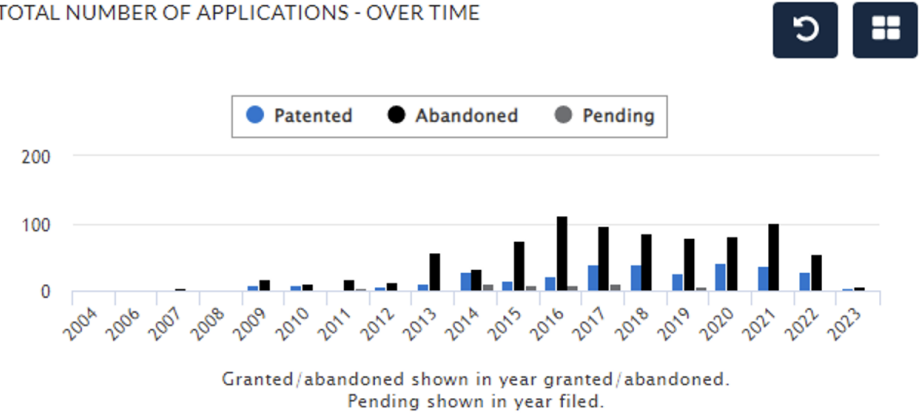
TOTAL NUMBER OF APPLICATIONS

1249
TOTAL ⓘ

327 **PATENTED APPLICATIONS**
853 **ABANDONED APPLICATIONS**
69 **PENDING APPLICATIONS**

This page is limited to patent applications with electronic file histories that were filed on or after 11/29/00.
[Click here to include all known published applications.](#)

TOTAL NUMBER OF APPLICATIONS - OVER TIME



Common Arguments

16

● Principle of operation

- A proposed modification or combination of the prior art that would change the “basic principles under which the [prior art] was designed to operate” weighs against a conclusion of prima facie obviousness.
- *See, e.g.*, In re Ratti, 270 F.2d 810, 813 (CCPA 1959).

Common Arguments

17



Search

Business Development

My Saved Work

Browser Extension

Briefcase Search Results for

"In re Ratti" "principle of operation"

Board Win Rate 36.1%

ALLOWANCE RATE

46.9%

TOTAL NUMBER OF APPLICATIONS

366

TOTAL

167 PATENTED APPLICATIONS

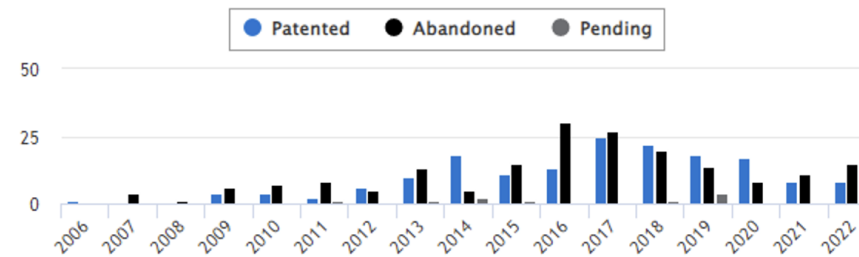
189 ABANDONED APPLICATIONS

10 PENDING APPLICATIONS

This page is limited to patent applications with electronic file histories that were filed on or after 11/29/00.

[Click here to include all known published applications.](#)

TOTAL NUMBER OF APPLICATIONS - OVER TIME



Granted/abandoned shown in year granted/abandoned.
Pending shown in year filed.

CLE Code

Common Arguments

19

- Invention cannot be used as a template for its own reconstruction
- “To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction—an illogical and inappropriate process by which to determine patentability.”
- *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570 (Fed. Cir. 1996)

Common Arguments

20

Briefcase Search Results for

"hindsight" AND "template" AND "reconstruction"

Board Win Rate 63.1%

ALLOWANCE RATE

61%

TOTAL NUMBER OF APPLICATIONS

251

TOTAL

150 PATENTED APPLICATIONS

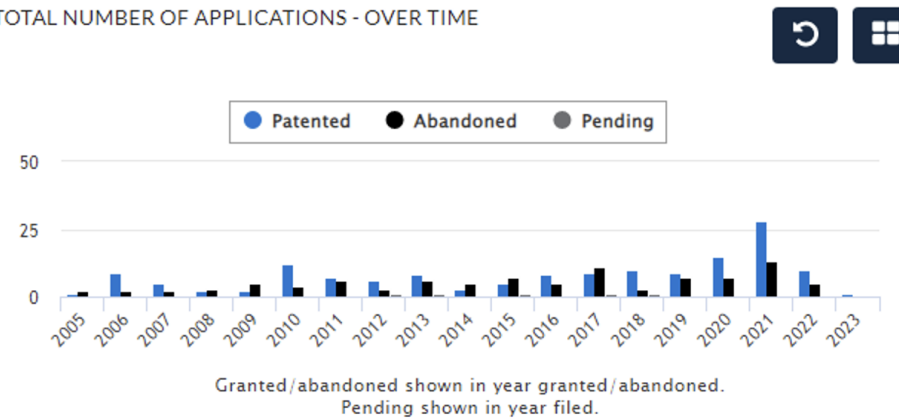
96 ABANDONED APPLICATIONS

5 PENDING APPLICATIONS

This page is limited to patent applications with electronic file histories that were filed on or after 11/29/00.

[Click here to include all known published applications.](#)

TOTAL NUMBER OF APPLICATIONS - OVER TIME



Common Arguments

21

- **Invention cannot be used as a template for its own reconstruction**
 - “To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction—an illogical and inappropriate process by which to determine patentability.”
 - *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570 (Fed. Cir. 1996)

Common Arguments

22

- **Broadest reasonable construction**

- “The broadest construction rubric coupled with the term “comprising” does not give the PTO an unfettered license to interpret claims to embrace anything remotely related to the claimed invention. Rather, claims should always be read in light of the specification and teachings in the underlying patent.”
- *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260 (Fed. Cir. 2010)

Common Arguments

23

Briefcase Search Results for

"603 F.3d 1255" "broadest"

Board Win Rate 66.4%

ALLOWANCE RATE

71.1%

TOTAL NUMBER OF APPLICATIONS

537

TOTAL ⓘ

371 PATENTED APPLICATIONS

151 ABANDONED APPLICATIONS

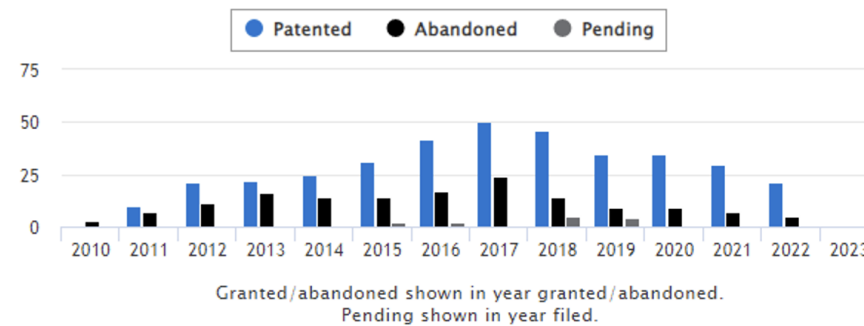
15 PENDING APPLICATIONS

This page is limited to patent applications with electronic file histories that were filed on or after 11/29/00.

[Click here to include all known published applications.](#)

Windows PowerShell

TOTAL NUMBER OF APPLICATIONS - OVER TIME



Common Arguments

24

- **Showing elements were known is not sufficient to show obviousness**
 - “A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.”
 - *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007)

Common Arguments

25

Briefcase Search Results for

“A patent composed of several elements is not proved obvious merely by demo...”

Board Win Rate 79.8%

ALLOWANCE RATE

79.8%

TOTAL NUMBER OF APPLICATIONS

663

TOTAL ⓘ

521 PATENTED APPLICATIONS

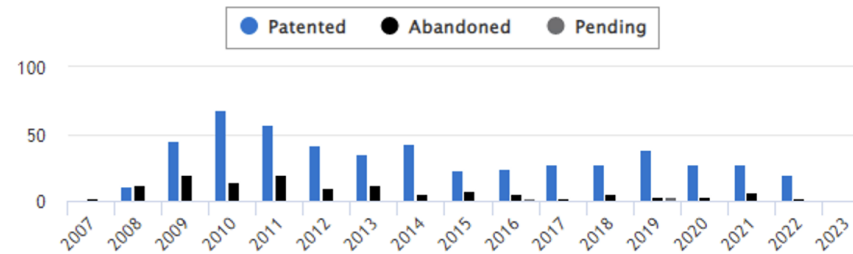
132 ABANDONED APPLICATIONS

10 PENDING APPLICATIONS

This page is limited to patent applications with electronic file histories that were filed on or after 11/29/00.

[Click here to include all known published applications.](#)

TOTAL NUMBER OF APPLICATIONS - OVER TIME



Granted/abandoned shown in year granted/abandoned.

Common Arguments

26

- **Examiner Has Initial Burden**

- “The examiner bears the initial burden ... of presenting a *prima facie* case of unpatentability.’
- *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Common Arguments

27



PatentAdvisor

Search

Business Development

My Saved Work

Browser Extension

Briefcase Search Results for

Board Win Rate 65.7%

"The examiner bears the initial burden"

ALLOWANCE RATE

67.6%

TOTAL NUMBER OF APPLICATIONS

3480

TOTAL

2326 PATENTED APPLICATIONS

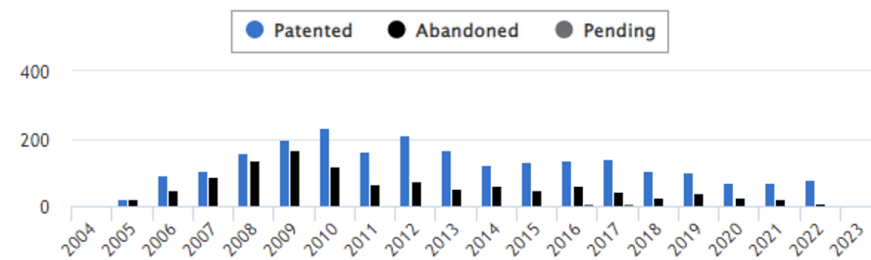
1113 ABANDONED APPLICATIONS

41 PENDING APPLICATIONS

This page is limited to patent applications with electronic file histories that were filed on or after 11/29/00.

[Click here to include all known published applications.](#)

TOTAL NUMBER OF APPLICATIONS - OVER TIME



Granted/abandoned shown in year granted/abandoned.
Pending shown in year filed.

Common Arguments

28

- **“Could make” is not enough**

- “[O]bviousness concerns whether a skilled artisan not only could have made but would have been motivated to make the combinations or modifications of prior art to arrive at the claimed invention.”
- *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015).

Common Arguments

29

Briefcase Search Results for

“not only could have made but would have been motivated”

Board Win Rate 86.5%

ALLOWANCE RATE

87.3%

TOTAL NUMBER OF APPLICATIONS

231

TOTAL

186 PATENTED APPLICATIONS

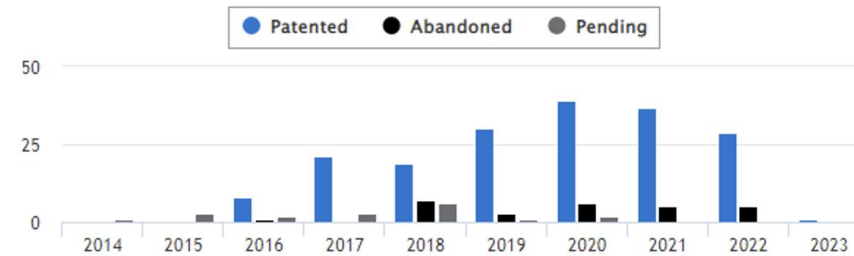
27 ABANDONED APPLICATIONS

18 PENDING APPLICATIONS

This page is limited to patent applications with electronic file histories that were filed on or after 11/29/00.

[Click here to include all known published applications.](#)

TOTAL NUMBER OF APPLICATIONS - OVER TIME



Granted/abandoned shown in year granted/abandoned.

Common Arguments

30

- **No reasonable expectation of success**

- “[T]o have a reasonable expectation of success, one must be motivated to do more than merely [] vary all parameters or try each of [the] numerous possible choices until one possibly arrive[s] at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful.”
- *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1365 (Fed. Cir. 2007)

Common Arguments

31



PatentAdvisor

Search

Business Development

My Saved Work

Browser Extension

Briefcase Search Results for

“reasonable expectation of success”

Board Win Rate 27.4%

ALLOWANCE RATE

33.3%

TOTAL NUMBER OF APPLICATIONS

6988

TOTAL

2245 PATENTED APPLICATIONS

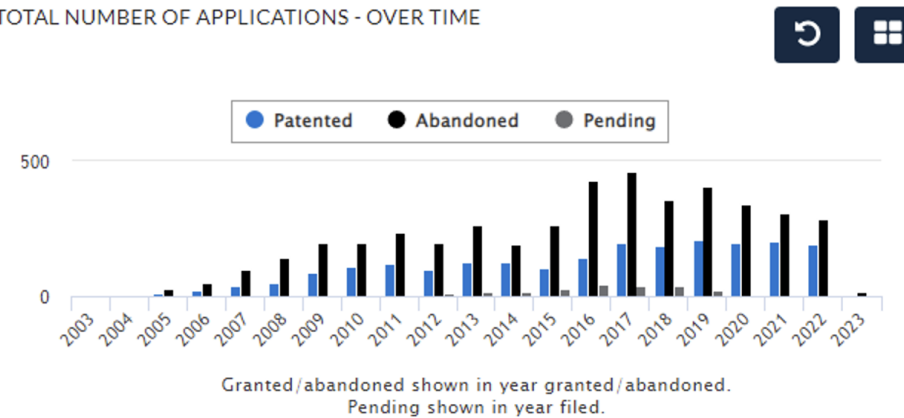
4491 ABANDONED APPLICATIONS

252 PENDING APPLICATIONS

This page is limited to patent applications with electronic file histories that were filed on or after 11/29/00.

[Click here to include all known published applications.](#)

TOTAL NUMBER OF APPLICATIONS - OVER TIME



Common Arguments

32

- **Prior art needs to suggest modification is desirable**
 - "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification."
 - *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984)

Common Arguments

33



PatentAdvisor

Search

Business Development

My Saved Work

Browser Extension

Briefcase Search Results for

"The mere fact that the prior art could be so modified would not have made ..."

Board Win Rate 91.2%

ALLOWANCE RATE

85.3%

TOTAL NUMBER OF APPLICATIONS

34

TOTAL ⓘ

29 PATENTED APPLICATIONS

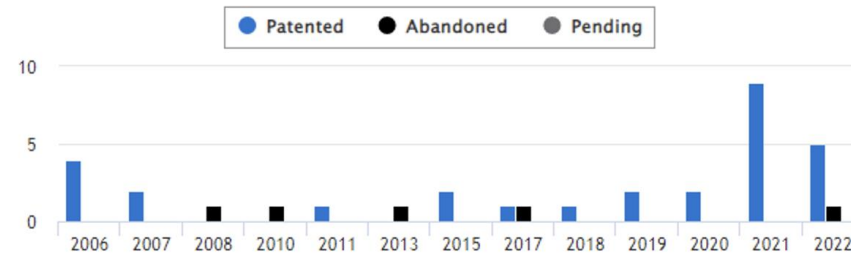
5 ABANDONED APPLICATIONS

0 PENDING APPLICATIONS

This page is limited to patent applications with electronic file histories that were filed on or after 11/29/00.

[Click here to include all known published applications.](#)

TOTAL NUMBER OF APPLICATIONS - OVER TIME



Granted/abandoned shown in year granted/abandoned.

Questions & Discussion



DAVIDSON, DAVIDSON & KAPPEL, LLC