



PTAB Committee

PTAB Committee Meeting: Best Practices before the PTAB

**Amster
Rothstein &
Ebenstein** LLP

Featuring guest speaker:

Hosted By:



ZOOM WEBINAR



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RSVP: ADMIN@NYIPLA.ORG | 1.0 NY/NJ CLE AVAILABLE FOR ATTENDEES

Best Practices Before The PTAB During Ex Parte Appeal

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Disclaimer

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Best Practices Before The PTAB During Ex Parte Appeal

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- Lead with technical arguments when possible, but always cite some case law
- Make the PTAB's job in writing the opinion easy by supplying the best case law

Best Practices Before The PTAB During Ex Parte Appeal

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- **Most common winning arguments from my last 35 ex parte appeal wins**
 - (1) Prior art does not teach what examiner says
 - (2) Articulated reasoning to combine is conclusory and/or lacks a rational underpinning
 - (3) Unreasonable claim interpretation
 - (4) Reasoning is speculative/lacks a factual basis

Best Practices Before The PTAB During Ex Parte Appeal

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- Only argue the claim language, and be mindful of Prosecution History Estoppel
- Do not get into the advantages of the invention
- The claim says “X,” the prior art teaches “Y” – explain why “Y” is not “X” or why it is unclear how “Y” could possibly be “X”

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- Add fallback dependent claims in the 1st Response to Office Action if the interpretation of the prior art or the combination of references is unreasonable
- Present every reasonable dependent claim argument on appeal
- If the rejection of dependent claims is unclear, as is often the case, point this out

Best Practices Before The PTAB During Ex Parte Appeal

- **Argue the Examiner has not met the requisite burden**
 - MPEP 2106(II) states that “[t]he examiner bears the initial burden ... of presenting a *prima facie* case of unpatentability.” (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)).
 - MPEP § 2142 (“If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit secondary evidence to show nonobviousness.”).
 - *See ACCO Brands Corp. v. Fellowes, Inc.*, 813 F.3d 1361, 1365 (Fed. Cir. 2016) (“[T]he concept of *prima facie* obviousness establishes the framework for the obviousness determination and the burdens the parties face” during patent examination. . . . “Under this framework, the patent examiner must first set forth a *prima facie* case, supported by evidence, showing why the claims at issue would have been obvious in light of the prior art.”).

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- **50-50 tie goes to the Appellant**
- See *In re Caveney*, 761 F.2d 671, 674 (Fed. Cir. 1985) (“preponderance of the evidence is the standard that must be met by the PTO in making rejections”).

Best Practices Before The PTAB During Ex Parte Appeal

- Argue that the Examiner’s reasoning is not supported by a rational underpinning
- See MPEP 2142; *KSR Int’l Co. v. Teleflex Inc.*, (“[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.”)
- The USPTO “must examine the relevant data and articulate a satisfactory explanation for its action including a ‘rational connection between the facts found and the choice made.’” *Motor Vehicle Mfrs. Ass’n v. State Farm Mut. Auto. Ins. Co.*, 463 U.S. 29, 43 (1983) (internal citation omitted); see *Synopsys, Inc. v. Mentor Graphics Corp.*, 814 F.3d 1309, 1322 (Fed. Cir. 2016) (stating that, as an administrative agency, the PTAB “must articulate logical and rational reasons for [its] decisions” (internal quotation marks and citation omitted)).

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- But.....consider whether you are saying too much, and whether you are leading the Examiner into more convincing reasoning in the Examiner's Answer
- Leaving some reasoning for the Reply Brief can give you the last word, without prompting the Examiner to create a strong rational underpinning

Best Practices Before The PTAB During Ex Parte Appeal

- Challenge the Examiner’s claim construction as being beyond the broadest reasonable interpretation
- “Above all, the broadest reasonable interpretation must be reasonable in light of the claims and specification.” *PPC Broadband, Inc. v. Corning Optical Commc ’ns RF, LLC*, 815 F.3d 747, 755 (Fed. Cir. 2016) (emphasis in original).
- As our reviewing Court held, “[t]he protocol of giving claims their broadest reasonable interpretation . . . does not include giving claims a legally incorrect interpretation.” *Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1298 (Fed. Cir. 2015) (citing *In re Skvorecz*, 580 F.3d 1262, 1267 (Fed. Cir. 2009)
- *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260 (Fed. Cir. 2010) (“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.”).

Best Practices Before The PTAB During Ex Parte Appeal

- **Challenge the Examiner’s reasoning as being speculative**
- See, *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967) (“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.”)(emphasis in original)).
- *In re Jones*, 958 F.2d 347, 349-51 (Fed. Cir. 1992) (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if it be called evidence)...”).
- *In re Kaplan*, 789 F.2d 1574, 1580 (Fed. Cir. 1986) (“[T]here must be some clear evidence to establish why the variation would have been obvious which can properly qualify as ‘prior art.’”).

Best Practices Before The PTAB During Ex Parte Appeal

- Argue an obviousness combination is based on improper hindsight bias
- *See In re Wesslau*, 353 F.2d 238, 241 (1965) (“It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.”).
- *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985)). (“When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.”)
- *See In re Rouffet*, 149 F.3d 1350, 1358 (Fed. Cir. 1998) (“hindsight” is inferred when the specific understanding or principle within the knowledge of one of ordinary skill in the art leading to the modification of the prior art in order to arrive at appellant's claimed invention has not been explained).

Best Practices Before The PTAB During Ex Parte Appeal

- **Call out the Examiner's inherency arguments**
- *Par Pharm. v. TWI Pharms.*, 773 F.3d 1186, 1195-96, 112 USPQ2d 1945, 1952 (Fed. Cir. 2014) ("A party must, therefore, meet a high standard in order to rely on inherency to establish the existence of a claim limitation in the prior art in an obviousness analysis - the limitation at issue necessarily must be present, or the natural result of the combination of elements explicitly disclosed by the prior art.")
- *Agilent Techs., Inc. v. Affymetrix, Inc.*, 567 F.3d 1366, 1383 (Fed. Cir. 2009) ("The very essence of inherency is that one of ordinary skill in the art would recognize that a reference unavoidably teaches the property in question." (Emphasis added)).
- *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) ("To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' ")).

Best Practices Before The PTAB During Ex Parte Appeal

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- **Be aggressive!!!**
- ❑ You do not gain anything by being differential to the Examiner
- ❑ Take the gloves off when attacking the Examiner's reasoning
- ❑ Examiners will not hold it against you

QUESTIONS?

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