

LEGAL INSIGHT

November 27, 2013

Five Lessons Learned at a PTAB Hearing

Practice Group(s):

**Patent Office
Litigation**

**IP Procurement and
Portfolio
Management**

IP Litigation

By Matthew S. Dicke and Jason A. Engel

Following a recent hearing involving K&L Gates' lawyers before the Patent Trial and Appeal Board ("PTAB") on behalf of the patent owner in an *inter partes* reexamination, several key practice tips emerged that may be useful as clients and counsel encounter the increase in post-grant proceedings. This particular appearance related to an appeal brought by a third-party requester, but the lessons learned apply to any form of oral advocacy, and may be particularly useful for patent prosecutors newly before the PTAB.

As background, the PTAB's duties are to:

- i. on written appeal of an applicant, review adverse decisions of the examiner;
- ii. review appeals of reexaminations (including appeals of already pending *inter partes* reexaminations);
- iii. conduct derivation proceedings; and
- iv. conduct *inter partes* reviews and post-grant reviews. See 35 U.S.C. § 6(a).

In an *inter partes* reexamination, after receiving a Right of Appeal Notice (final action) adverse to the patentability or confirming the patentability of the patent at issue, the patent owner or third-party requester may appeal to the PTAB and has the option of requesting an oral hearing. See MPEP Section 2674. The purpose of the oral hearing is to enable the parties to orally advocate the positions taken in their appeal briefs and to enable the PTAB to question the parties. After the PTAB renders its decision, appeals of PTAB decisions are made to the Federal Circuit.

Five Practice Tips and Observations

1. Know the Record

Knowledge of the record (prosecution history, references, case law, and related proceedings) is paramount. A deep grasp of the record will supply you ready answers and references to potentially specific questions from the PTAB. Similarly, you will also be able to call out the other party's new and/or modified arguments in your rebuttal. The PTAB will appreciate your ability to efficiently provide focused information that can help them help you.

2. Avoid New Argument

In a recent hearing, an appellant introduced new arguments, but the PTAB was very quick to interject and ask where these arguments were in the appeal briefing. The PTAB let the appellant make these arguments, but strongly suggested, given the limited argument time, that the appellant focus on the issues raised for appeal.

Five Lessons Learned at a PTAB Hearing

3. Be Prepared to Answer Questions Not at Issue on Appeal

While the parties are expected to adhere to the issues as briefed, the PTAB can ask whatever it wants. During preparation, think outside the box and consider what could happen if prosecution were re-opened or where there may be abstract questions not necessarily reflected in the issues for appeal. In a recent hearing, the PTAB asked questions related to the prior art, the obviousness inquiry, and the invention itself, all of which were framed as “hypothetical.” Be prepared to field these questions, but be careful not to attempt to inject unsupported expert-like evidence. Do not speculate, and defer to written arguments, if necessary.

4. The PTAB Allows Visual Demonstratives

While the PTAB cautioned against the introduction of new argument not of record, in this matter, it did allow demonstrative slides. The slides, or other forms of demonstrative exhibits, can serve a helpful illustrative function as long as used properly. The PTAB will have questions and you will be rebutting arguments by the other side. Accordingly, do not be beholden to the planned order of your presentation or plan to read from a “script.” Note that you must request that audio-visual equipment be set up at least three days in advance of your hearing.

5. The PTAB Allows the Appellant Rebuttal Time

In an *inter partes* reexamination appeal, each appellant and respondent has 30 minutes of argument time. The examiner has 20 minutes if they elect to appear (did not appear in our case). See MPEP Section 2680. The PTAB indicated that the appellant third-party requester in our case was to present first and could reserve any desired amount of time from its 30 minutes for rebuttal. The respondent only gets one block of 30 minutes. If you are the appellant, be sure to reserve rebuttal time.

Obviously, these observations and tips are not all-encompassing, but hopefully they are useful. Please do not hesitate to contact the lawyers below if you have any questions regarding our experience with the PTAB and post-grant proceedings. We are happy to assist you.

Five Lessons Learned at a PTAB Hearing

Authors:

Matthew S. Dicke

matthew.dicke@klgates.com

+1.312.578.5415

Jason A. Engel

jason.engel@klgates.com

+1.312.807.4236

K&L GATES

Anchorage Austin Beijing Berlin Boston Brisbane Brussels Charleston Charlotte Chicago Dallas Doha Dubai Fort Worth Frankfurt Harrisburg Hong Kong Houston London Los Angeles Melbourne Miami Milan Moscow Newark New York Orange County Palo Alto Paris Perth Pittsburgh Portland Raleigh Research Triangle Park San Diego San Francisco São Paulo Seattle Seoul Shanghai Singapore Spokane Sydney Taipei Tokyo Warsaw Washington, D.C. Wilmington

K&L Gates practices out of 48 fully integrated offices located in the United States, Asia, Australia, Europe, the Middle East and South America and represents leading global corporations, growth and middle-market companies, capital markets participants and entrepreneurs in every major industry group as well as public sector entities, educational institutions, philanthropic organizations and individuals. For more information about K&L Gates or its locations, practices and registrations, visit www.klgates.com.

This publication is for informational purposes and does not contain or convey legal advice. The information herein should not be used or relied upon in regard to any particular facts or circumstances without first consulting a lawyer.

©2013 K&L Gates LLP. All Rights Reserved.