

Oral Advocacy before the Patent Trial and Appeal Board

You and your client have decided that your case pending before the Patent Trial and Appeal Board (“Board”) would benefit from an oral hearing in front of a panel of Administrative Patent Judges¹ who have been assigned to decide the case. To prepare for the oral hearing, here is a set of suggestions, from A to F, to help maximize the effectiveness of your presentation.

Answer the question being asked. While your prepared presentation undoubtedly focuses on the points that you find most important, those may not be the areas of greatest concern for the judges. Be prepared to deviate from your prepared presentation to answer the questions asked by the panel. Rather than brush off inquiries, embrace questions as an opportunity to explain why the issue favors your position, or at least is not as harmful to your position as it might appear on its face. Not answering questions is one of the quickest ways to lose credibility with the panel. If you think the question is not relevant, provide an explanation to that effect, but then still provide an answer to the question asked.

Begin the conversation with the critical issues, not extensive background information. The judges are familiar with the record. If a specific background point is very relevant, discuss it, but do not give a detailed history of the technology behind the invention — unless the judges ask for it, of course. Remember to limit your discussion and arguments to the information in the record. The panel will not entertain arguments and evidence that are presented for the first time during oral hearing.

Consider whether demonstrative exhibits will be useful to your presentation. Because new arguments are not permitted during the hearing, exhibits should be limited to evidence and arguments of record. In some cases, however, where the record reflects a clear misunderstanding or impasse, demonstratives supported by the record may help resolve the matter. Demonstratives that may be particularly helpful may include pages from the record, such as figures, with appropriate highlighting. And when referring to the demonstratives during the oral hearing, refer to the specific slide number, rather than saying “next slide,” as that makes it easier for the judges, especially those judges participating in the video remotely, to follow the argument. On the other hand, do not be overly reliant on your demonstratives lest the panel pays more attention to your exhibits than to what you are saying.

¹ While a panel normally consists of three judges, a panel may consist of more than three judges, and some of the panel members may be participating in the oral hearing by video.

Do not avoid the difficult issues. The judges will be most interested in the weakest parts of your case, because those are the points on which the outcome of the case may turn. Be prepared to explain why the apparent weakness does not change the legal conclusion for which you are arguing.

Ensure that you are familiar with the entire record, not just those portions essential to your argument. There may be something in the specification, a declaration, or in one of the cited references, that supports or refutes your arguments, but is identified by a party only in passing. It may, however, be very important to a judge. Also, your argument may raise other issues that require evaluation of additional parts of the record. If those types of questions arise, the judges on the panel will be interested in your informed and confident view of those issues.

Focus on your substantive arguments, based on the evidence of record, and where and how you have relied on that evidence, rather than arguments about the process that led you to the Board. For example, for appeals from adverse examiner decisions, the Judges are aware that patent prosecution is not always easy or straightforward. But the remedy for perceived prosecution errors, such as improper restrictions, premature final rejections, or refusal by the examiner to follow proper procedure, is by way of petition to the Director, and not by appeal to the Board. The decision of the panel will be based on the facts as developed in the record. Nearly all patentability issues are resolved based on the particular facts of your case—very few require or even invite an extension of or a new gloss on the law—so focus on the facts in the record, and explain why they support a determination of reversible error in the appealed rejection.

Going forward, keep these tips in mind as you prepare to present your appeal to the Board. Following these tips will not only allow for a more productive hearing for the judges deciding your appeal, but may also lead to a more favorable result for you and your client.