Boardside Chat: Ex Parte Appeals

Administrative Patent Judges Bradley Garris, Linda Horner, and John Jeffery

Patent Trial and Appeal Board
Webinar Series (2 of 5)
April 7, 2015
# Boardside Chats

<table>
<thead>
<tr>
<th>Date</th>
<th>Time</th>
<th>Topic</th>
<th>Speakers</th>
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</thead>
<tbody>
<tr>
<td>Tuesday, June 2</td>
<td>Noon to 1 pm Eastern Time</td>
<td>Discovery in AIA Trials</td>
<td>Panel of Practitioners and Administrative Patent Judges</td>
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<tr>
<td>Tuesday, August 4</td>
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<td>AIA Rulemaking and Guidance Changes</td>
<td>Lead Judge Susan Mitchell</td>
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<tr>
<td>Tuesday, October 6</td>
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<td>Best Practices before the PTAB</td>
<td>Panel of Administrative Patent Judges</td>
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## Agenda

<table>
<thead>
<tr>
<th>Topic</th>
<th>Presenter</th>
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<tbody>
<tr>
<td>Ex Parte Appeal Statistics</td>
<td>Judge Horner</td>
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<tr>
<td>Appeal Process</td>
<td>Judge Garris</td>
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<td>Appeal Resources on PTAB Website</td>
<td>Judge Jeffery</td>
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<tr>
<td>Panel Discussion on Effective Advocacy</td>
<td>Judges Garris, Horner, and Jeffery</td>
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<tr>
<td>Q&amp;A</td>
<td>Ms. Gongola (moderator)</td>
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Ex Parte Appeal Statistics
Pending Ex Parte Appeals
(excluding appeals from reexamination proceedings)

Through 4-1-2015

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<thead>
<tr>
<th>Fiscal Year</th>
<th>Number of Appeals</th>
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<td>FY 2013</td>
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<td>FY 2014</td>
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<td>FY 2015 to date</td>
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Pending Ex Parte Appeals
(excluding appeals from reexamination proceedings)
## PTAB Receipts and Dispositions

Data from 02/28/2015 thru 03/31/2015

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<tr>
<th>Discipline</th>
<th># Cases Received</th>
<th># Cases Disposed</th>
<th>Difference (Disposed minus Received)</th>
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<tr>
<td>Biotech</td>
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<td>53</td>
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<td>Business Methods</td>
<td>43</td>
<td>117</td>
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<tr>
<td>Chemical</td>
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<td>164</td>
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<td>Reexamination</td>
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<td>40</td>
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<td>Design</td>
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<tr>
<td>Mechanical</td>
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Age of Pending Appeals by TC
Data as of 3/15/2015

Age of Pending Appeals

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<th>Mechanical/Business Methods</th>
<th>Chemical</th>
<th>Biotech</th>
<th>Designs and Reexaminations</th>
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# Pendency of Decided Appeals

Data from 10/1/2014 through 3/31/2015

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<tr>
<th>Discipline</th>
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<th>Number of Decisions</th>
<th>Pendency from PTAB Docketing to Decision (Months)</th>
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<tr>
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<td>Chemical</td>
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<td>Electrical</td>
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<td>830</td>
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<td>2400</td>
<td>984</td>
<td>32.1</td>
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<td>2600</td>
<td>761</td>
<td>31.7</td>
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<td>Designs</td>
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<td>11</td>
<td>26.1</td>
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<td>Mech/Bus Methods</td>
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<td>961</td>
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Allocation of Judges
Data as of March 23, 2015

Total Number of Judges: 230
# Outcomes

Data from FY2015 through end of February 2015

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<tr>
<th>Discipline</th>
<th>Tech Center</th>
<th>Affirmed</th>
<th>Affirmed-in-Part</th>
<th>Reversed</th>
<th>Remanded</th>
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<td>&lt;1%</td>
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<tr>
<td>Electrical</td>
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<td>&lt;1%</td>
<td>&lt;1%</td>
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<td></td>
<td>2400</td>
<td>60.1%</td>
<td>13.5%</td>
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<td>1.0%</td>
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<td>0%</td>
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<tr>
<td>Reexams</td>
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<td>15.7%</td>
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<td>2.0%</td>
<td>2.0%</td>
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<tr>
<td>Total Ave.</td>
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<td>13.3%</td>
<td>30.0%</td>
<td>0.3%</td>
<td>1.2%</td>
<td></td>
</tr>
</tbody>
</table>

* Data set comprised of 7 decisions.  ** Data set comprised of 102 decisions.
Appeal Process
Appeal to PTAB: Ex Parte Appeals
Assignment of Appeal Number

The Fiscal Year

- 10/1/2013: FY2013 begins
- 12/31/2013: 1st QTR ends
- 9/30/2014: FY2014 ends

 Appeals received at the Board during FY 2014 are serially numbered 2014-000001, 2014-000002, etc.
Image File Wrapper (IFW)
Ex Parte Oral Hearings

The Oral Hearing may be in the form of a personal appearance, telephonic presentation, or a video conference via the electronic hearing room.

The rules covering presenting an Oral Hearing Request may be found in 37 CFR Section 41.20 regarding fees, and Section 41.47 regarding the Oral Hearing.
After the Applicant has presented an Appeal Brief, if the Patent Examiner assigned to the application proceeds with an Examiner’s Answer, the Applicant has the option of Requesting an Oral Hearing.

The Request for Oral Hearing needs to be filed within two months of the mailing date of the Examiner’s Answer, and contain the required fee.
Processing at PTAB

The Board sends appellant a Notice containing the time, day and location of the oral hearing.

It is Board policy to give Applicant 21 days to respond back to the PTAB as to whether attendance at the Oral Hearing is being confirmed or waived.

Applicant also states who will be attending the Oral Hearing if a personal appearance is being made.

There is no refund of the Oral Hearing fee if the Oral Hearing is waived.
Processing at PTAB

If the Oral Hearing is to be conducted either by telephone or by video conference, a request for such needs to be filed with the confirmation.

It is recommended that communications regarding postponements, telephonic hearings, and video conference hearings be made via facsimile transmissions due to time constraints.

PTAB Hearing Fax number (571) 273-9797
Appeal Resources on PTAB Website
The Patent Trial and Appeal Board’s duties include review of adverse decisions, review of appeals of reexaminations, derivation proceedings, inter partes and post-grant reviews, and rendering decisions on interferences.
Accessing PTAB Web Page via Patents Site
PTAB Web Site: Appeals

Welcome to the Patent Trial and Appeal Board (PTAB)

Welcome to the PTAB Web Site. This site includes information about proceedings conducted by the PTAB, including inter partes reviews, post-grant reviews, the Patent Trial and Appeal Board, and PTAB decisions. It also includes resources such as FAQs, statistics, and links to related websites.

This page includes information about appeals conducted by the Patent Trial and Appeal Board from adverse decisions of examiners in patent applications, reissue applications, and reexamination proceedings.

Hearings
This page contains information concerning proceedings conducted before the Patent Trial and Appeal Board, including oral hearings, written proceedings, and other related materials.

Resources
This page contains resources, case studies, and other materials related to the PTAB, including FAQs, statistics, and links to related websites.

Statistics
This page contains statistical data and information related to the PTAB, including filings, decisions, and other related metrics.

Events
This page includes information about events and meetings related to the PTAB, including upcoming events and contacts for more information.

What's New
This page includes updates and changes to the PTAB website, including new features, policies, and other related information.

System Maintenance
This page includes information about system maintenance and upgrades, including scheduled outages and other related information.
PTAB Web Site: Appeals Resources

Appeals

This page includes information about appeals conducted by the Patent Trial and Appeal Board from adverse decisions of examiners in patent applications, reissue applications, and reexamination proceedings.

- Board Rules for Ex Parte Appeals®
- Board Rules for Inter Partes Appeals®
- Practice Tips and Checklists to Reduce Non-Compliant Briefs
  This page includes a listing of the top eight reasons briefs are found to be non-compliant, checklists used by the Office to determine if briefs comply with the rules, and forms used by the Office to notify parties of non-compliant briefs.
- Practice Tips for Writing Effective Appeal Briefs
- Suggestion Box®
- Frequently Asked Questions (FAQs)

Appeals – General Process

Reference Materials

- Board Rules for Appeals Filed Before January 2012® [PDF]
- MPEP Chapter 1200 (Appeals)
- MPEP Chapter 2200 (Ex Parte Reexamination)
- MPEP Chapter 2600 (Inter Partes Reexamination)
- Guidance on Petitions Under CFR Rule 41.3 to the PTAB
- Fee and Payment Information
- Forms
  - AIA/31 - Notice of Appeal
  - AIA/32 - Request for Oral Hearing Before the Patent Trial and Appeal Board
- EFS-Web
Appeals: Board Rules

Appeals

This page includes information about appeals conducted by the Patent Trial and Appeal Board from adverse decisions of examiners in patent applications, reissue applications, and reexamination proceedings.

- Board Rules for Ex Parte Appeals
- Board Rules for Inter Partes Appeals
- Practice Tips and Checklists to Reduce Non-Compliant Briefs
- Practice Tips for Writing Effective Appeal Briefs
- Suggestion Box
- Frequently Asked Questions (FAQs)
Appeals: Practice Tips for Writing Effective Appeal Briefs

Appeals

This page includes information about appeals conducted by the Patent Trial and Appeal Board from adverse decisions of examiners in patent applications, reissue applications, and reexamination proceedings.

- Board Rules for Ex Parte Appeals
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- Practice Tips for Writing Effective Appeal Briefs
- Suggestion Box
- Frequently Asked Questions (FAQs)
Practice Tips for Writing Effective Appeal Briefs

Provided below are ten practice tips for writing effective ex parte briefs when appearing before the Patent Trial and Appeal Board in an ex parte appeal.

Appeal Briefs, 37 C.F.R. § 41.37

- **Present only the strongest arguments.**
- Do not dilute strong arguments by including weaker arguments or arguments that have no bearing on the issues in the case.
- **Strategically group claims to highlight the strongest arguments in the case.**
- Give careful thought to which claims you choose to argue separately so that weaker arguments do not dilute stronger arguments.
- For those claims argued separately, place such arguments under separate sub-headings.
- If the same arguments are being made for patentability of two or more independent claims, argue these claims as a group under a single heading.
- **Develop the facts of your case to show how the law applies to achieve the result being sought.**
- Set out the standard for the legal theory you seek to have applied, and then provide arguments or evidence to demonstrate the legal theory applies to the case before the Board.
- Clearly address the examiner’s rejection as articulated in the rejection on appeal and point the Board to the alleged error in that rejection.
- **Understand the burden of proof.**
- Recognize when the burden of proof shifts to appellant and provide arguments to show why the burden should not be shifted or evidence to rebut the examiner’s findings and meet the burden of proof.
Appeals: Suggestion Box & FAQs

Appeals

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- Suggestion Box
- Frequently Asked Questions (FAQs)
PTAB Web Site: Decisions

Welcome to the Patent Trial and Appeal Board (PTAB)

PTAB to Host “Boardside Chat” Webinar Series Bi-monthly - Next Chat is on April 7, 2015
New Maximum Daily Limit for Credit Card Payments, Effective June 1, 2015
View Public Comments Submitted for the Request for Comments on Trial Proceedings under the America Invents Act before the Patent Trial and Appeal Board

PTAB Systems Quick Links
- ACTIS filing - Interference Web Portal
- PPSS - Patent Review Processing System
- Final Decisions - PTAB related final agency decisions
- Subscriptions - Sign up here to receive the latest news and updates from the USPTO conveniently via email.

Decisions
This page includes links to all public, final agency decisions of the Patent Trial and Appeal Board, including decisions designated as precedential or informative.
Decisions: Precedential & Informative Board Decisions

Decisions

This page includes links to all public, final decisions of the Patent Trial and Appeal Board, including decisions designated as precedential or informative.

› Precedential Opinions (2014OCT06) [MSExcel]
› Informative Opinions
   ‹ Informative Opinions (2015JAN06) [MSExcel]
› Final Decisions
› Key Decisions Involving Functional Claiming
› Representative AIA Trial Orders, Decisions, and Notices

NOTE: Some material listed on this page may require a plug-in or viewer, available here.
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<tr>
<th>Case Name</th>
<th>Case Number</th>
<th>Case Type</th>
<th>Date Issued</th>
<th>PTAB Procedure</th>
<th>101</th>
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<th>103</th>
<th>112</th>
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<td>AIA</td>
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Routine Board Decisions

Decisions

This page includes links to all public, final decisions of the Patent Trial and Appeal Board, including decisions designated as precedential or informative.

- Precedential Opinions (2014OCT06) [MSEexcel]
- Informative Opinions
  - Informative Opinions (2015JAN06) [MSEexcel]

Final Decisions
- Key Decisions Involving Functional Claiming
- Representative AIA Trial Orders, Decisions, and Notices

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Welcome to the USPTO e-FOIA page. Through this page you can search for publicly available final decisions rendered by the Patent Trial and Appeal Board. In the field below you can enter a proceeding number to search the collection of available decisions. If you do not have a proceeding number but you know the caption of the case you are looking for, for example ABC Co. v. University of Illinois, or you know a text string found in the case you can search the collection by using the "Search Document Text" field by typing the text string in the search field. The Final Decision date range starts on July 1, 1997.

Search by Identifier: Application No.
Identifier: [Input field]
Get Info

Search by Range: Decision date
Start Date (mm/dd/yyyy): [Input field]
End Date (mm/dd/yyyy): [Input field]

Search Document Text: Search syntax: Use the operators AND, OR, and AND NOT between search terms along with parentheses, e.g. "(John deere" or graham) and not "prior art"

Records per Page: 60
Get Info
Retrieve Decisions from the past 30 days
Key Decisions Involving Functional Claiming

Decisions

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- Precedential Opinions (2014OCT06) [MSExcel]
- Informative Opinions
  - Informative Opinions (2015JAN06) [MSExcel]
- Final Decisions
  - Key Decisions Involving Functional Claiming
  - Representative AIA Trial Orders, Decisions, and Notices
- NOTE: Some material listed on this page may require a plug-in or viewer, available here.
# Hearings Information

## Hearings

This page contains information concerning presenting oral argument for appeals, interferences, and AIA trials conducted by the Patent Trial and Appeal Board.

## Resources

The page contains policies, procedures, rules, guides, tools and manuals which are associated with proceedings before the Patent Trial and Appeal Board.

## Statistics

Periodic summaries of data concerning proceedings before the Patent Trial and Appeal Board, including dispositions, pendency, inventory, and other tracking measures.

## About PTAB

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Hearings Information

Hearings

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General
- Public Admission
- Hearing Protocol
- Oral Advocacy before the Patent Trial and Appeal Board [PDF]
- Hearing Schedules
- Inclement Weather
- Hearing Room Tour Information
- Directions to Alexandria campus
  - Hearing Rooms are located in Madison East, 9th floor

>> Some resources may require browser plugins

Guidance
- Requesting Oral Hearings
- Rescheduling or Canceling an Oral Hearing
- Video and Telephonic Hearings
- Participation from Satellite Offices in Oral Hearings
- Appearance at the Oral Hearing
- Duration of Hearing
- Use of Demonstratives and Exhibits
- Oral Hearing Transcripts
## Hearing Schedule Example

**APRIL 2015 PTAB Public Hearing Schedule**

<table>
<thead>
<tr>
<th>Proceeding No.</th>
<th>Serial No.</th>
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Resources

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Resources: Standard Operating Procedures

Resources

The following policies, procedures, rules, guides, tools and manuals are associated with proceedings before the Patent Trial and Appeal Board.

› Standard Operating Procedures
  › Board Rules for Ex Parte Appeals [effective Jan. 23, 2012]
  › Board Rules for Inter Partes Appeals
  › Trial Rules
    › Umbrella Rules (subpart a - Trial Practice and Procedure)
    › Inter Partes Review
    › Post-Grant Review
    › Covered Business Method Review
    › Derivation
    › Frequently Asked Questions

› Trial Practice Guide [PDF]
› Patent Review Processing System (PRPS)
› America Invents Act (AIA) Trial Roundtables, April 15 to May 8, 2014
› Detroit Region Roadshow, November 5 to 19, 2014
› Interferences
  › Contested Cases
  › Patent Interferences

› Board-related Official Gazette Notices
› Frequently Asked Questions (FAQs)
Standard Operating Procedures

SOP 1 (rev. 13): Assignment of judges to merits panels, motions panels, and expanded panels (12 February 2009) [PDF]
SOP 2 (rev. 9): Publication of opinions and designation of opinions as precedential, informative, representative, and routine (22 September 2014) [PDF]
## Statistics

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PTAB Web Site: Help

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PTAB Help: FAQs, Contact Information, and Feedback/Suggestion Boxes

Frequently Asked Questions

- America Invents Act Trials
- PTAB Trials
- Appeals

How to Contact PTAB

- Contact Information
- Mailing Address
- Directions

Feedback and Suggestion Boxes

- Appeal Suggestions
- PTAB Trial Suggestions for AIA proceedings
- Patent Review Processing System (PRPS) Suggestions
Panel Discussion on Effective Advocacy
Tip 1: Clarify Claim Construction by Defining Key Claim Terms

• Acknowledge when an issue turns on claim construction

• Provide an interpretation for key claim terms with a basis for the interpretation under the "broadest reasonable interpretation" standard
Tip 1: Clarify Claim Construction by Defining Key Claim Terms (cont’d)

• Demonstrate why the examiner's interpretation is unreasonable in view of how ordinarily skilled artisans would understand the term in light of Appellant’s specification.

• Ideally, cite a clear and unambiguous definition of the term in the specification.
Tip 1: Clarify Claim Construction by Defining Key Claim Terms (cont’d)

• Absent such a definition, identify evidence of record to show that the disputed term has a narrower meaning than the Examiner’s construction
  – Under the Board’s 2012 rules, dictionaries are excluded from the definition of “Evidence” under 37 C.F.R. § 41.30 and may be cited before the Board.
Tip 2: Support Arguments With Evidence

• Attorney argument cannot substitute for evidence

• Merely pointing out what a claim recites is not a separate argument for patentability
Insufficient arguments: *In re Lovin*

- In *In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011), the court held that the Board can require more substantive arguments in an appeal brief than
  1. merely reciting the claim elements, and
  2. a bare assertion that the corresponding elements are not found in the prior art
Tip 2: Support Arguments With Evidence (cont’d)

• Do not rely on new evidence that was not before the examiner during prosecution
  – Also applies to oral hearings
    • See 37 C.F.R. § 41.47 (2012)

• But see 37 C.F.R. § 41.30 (excluding dictionaries from the definition of “Evidence” and noting that they may be cited to the Board)
Supporting Arguments With Evidence: Secondary Considerations

• Example 1: Secondary considerations of non-obviousness
  – Unexpected results
  – Commercial success
  – Long-felt, but unsolved need
  – Failure of others, etc.
Supporting Arguments With Evidence: Teaching Away/ Inoperability

• Example 2: Inoperability to Demonstrate Non-obviousness

• **Evidence** that examiner’s proposed combination would render cited prior art unsuitable for its intended purpose can be probative
Tip 3: Effective Use of Reply Briefs

• Use reply briefs to respond to points raised in the Examiner’s Answer
  – Do not reiterate arguments presented in appeal brief
  – Use the reply brief to:
    • reply to specific findings made, or positions taken, by the examiner in the answer, or
    • address intervening case law relevant to the issues on appeal
Tip 3: Effective Use of Reply Briefs

– Do not raise new arguments in a reply brief that are not responsive to arguments made in the examiner's answer
– Do not argue claims separately for the first time in a reply brief
– Board will generally not consider such new arguments
  • See 37 C.F.R. § 41.41(b)(2) (2012)
Questions?
## Boardside Chats

<table>
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<tr>
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<th>Time</th>
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<td>Tuesday, June 2</td>
<td>Noon to 1 pm Eastern Time</td>
<td>Discovery in AIA Trials</td>
<td>Panel of Practitioners and Administrative Patent Judges</td>
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<td>Tuesday, August 4</td>
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<td>AIA Rulemaking and Guidance Changes</td>
<td>Lead Judge Susan Mitchell</td>
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<td>Tuesday, October 6</td>
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<td>Best Practices before the PTAB</td>
<td>Panel of Administrative Patent Judges</td>
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