5 Must-Have Skills To Shine At The PTAB

By Erin Coe

Law360, San Diego (November 12, 2015, 1:58 PM ET) -- America Invents Act reviews at the Patent Trial and Appeal Board are a special breed of patent proceedings that are hypertechnical like prosecution yet adversarial like litigation, and they require practitioners with a unique blend of talents.

The proceedings, which were created by the AIA in 2012, provide an accelerated system for challenging patent validity. Because the PTAB is required to resolve the question of a patent’s validity within 12 months after it institutes a review, with the possibility of a six-month extension for good cause, practitioners are under intense time pressures. They also must be ready at the oral hearing for a barrage of questions by a panel of judges who aren’t afraid to dive into the technological details.

Attorneys who tend to succeed at the PTAB are those who have both the technical chops necessary to do well in the prosecution setting and the advocacy skills that are critical for litigation, according to W. Karl Renner, co-chair of Fish & Richardson PC’s post-grant practice.

“The people who excel in this tend to have a strategic approach, where they are able to think of the big picture and can build to the final story,” he said. “They also have to know the record and the technology. Often at the district court, and even at the International Trade Commission, so many times the details of the technology can get swept up and marginalized as one component of a broader fight. Here, at the PTAB, they are front and center.”

Here, experts highlight the key skills lawyers need to excel at the PTAB.

Deep Familiarity With the Technology

Because the administrative law judges on a PTAB panel usually have specialized backgrounds, practitioners must have extensive knowledge of the technology at hand and the ability to articulate it to a sophisticated audience, according to Lori Gordon, a director in Sterne Kessler Goldstein & Fox PLLC’s litigation and electronics practices and member of the firm’s patent office litigation team.

“Compared to the district court, where a lot of times the judges and juries are not technically trained, a different type of advocacy is required at the PTAB,” she said. “Lawyers need to go three or four layers deeper into the technology than they ever would in district court.”

Telling an emotional story where one side is the hero and the other side is the villain often pays less dividends at the PTAB and risks alienating the judges, according to Roberto Devoto, a principal at Fish &
“The judges have an ear and appetite for the technical arguments, and the other fluff that is put around the issue of whether an innovation is new has less bite and effect,” he said. “The judges are looking for what the technically correct answer is and are focusing on that, not on who has the nice, heart-pulling story or who seems like a nicer, humbler, more down-to-earth guy.”

Lawyers who prefer to brush over the nitty-gritty details with broad statements may find the PTAB to be a tough crowd.

“Lawyers who have the technical facility and really enjoy the technology are those who are best suited for this forum,” Devoto said.

**Critical Thinking**

Whether seeking to invalidate or defend a patent before the PTAB, lawyers must have a finely honed ability to critically review the application of prior art on the patent claims, according to Devoto.

“The reason this skill is uniquely important to PTAB reviews is because of the unforgiving nature of the proceedings,” he said. “You only have very few opportunities to advance your arguments, and after laying out your case in chief, your ability to modify, pivot and add arguments is severely limited.”

When a company is sued for patent infringement, it has one year from the date of service of the complaint to file a petition for an inter partes review. Once a petition is filed, the patent owner has three months to file a preliminary response, which is optional, and if a review is instituted, it has three months from the date of institution to submit a response and any motion to amend claims.

The strict time limits of the proceeding make it all the more crucial for lawyers to identify in advance all of their arguments and their opposing side’s counterarguments to ensure they are putting their best foot forward with the initial filing, he said.

“Lawyers need to consider claims and prior art from all angles ahead of time to minimize the likelihood of surprises,” he said.

**Good Judgment**

Attorneys at the PTAB also need to be adept at deciphering which arguments to raise in the proceeding and which ones to forgo, according to George Quillin, chair of Foley & Lardner LLP’s patent office trials group.

“In prosecution, if an argument doesn’t work, you file a response and keep at it until you or the examiner gives up,” he said. “In a PTAB proceeding, you only get one shot and you better be right.”

Petitioner attorneys who focus on the quantity of their arguments over the quality could see their case
fall prey to the PTAB’s redundancy doctrine, a time-saving tool the board uses to encourage lawyers to advance arguments based on the best pieces of prior art, according to Devoto.

“Multiple pieces of prior art can hurt you, as it can invite the PTAB to choose on its own initiative which pieces of prior art should go forward,” he said. “If you advance a whole bunch of grounds of claim rejections and fail to explain why they aren’t redundant to each other, the PTAB will pick and choose arguments based on its own selection criteria, and it may institute a trial on one of your weaker grounds.”

Nimble Oral Advocacy

PTAB reviews involve a lot of motions, as well as a range of formal and informal interactions with judges who are very active in the decision-making process, putting a premium on strong presentation skills and thinking quickly on one’s feet, according to Bob Steinberg, chair of Latham & Watkins LLP’s PTAB practice.

The oral hearing before a PTAB panel is similar to drawn-out oral arguments at the appellate level, and a hearing can sometimes last 90 minutes, depending on the complexity and number of patents at issue in the case, he said.

“The PTAB judges ask a lot of questions. They like to roll up their sleeves and get into the technology,” he said. “When you’re before a panel of these judges, it feels like you’re an expert witness on cross-examine. It’s intense and quite invigorating.”

Attorneys who try to script their arguments for the oral hearing at the PTAB like they would for opening and closing statements at the district court are headed for a rude awakening, according to Gordon.

“In many cases [at the oral hearing], I may have five or 10 minutes to warm up before there’s a barrage of nonstop questions for an hour,” she said. “Attorneys need to know all the nuances of the case and be ready to be flexible based on how the questions are rolling.”

Big-Picture Focus

Attorneys with experience working on both the prosecution and litigation sides not only have a richer perspective of the patent arena, they also have a better chance of gaining an edge at the PTAB, according to Gordon, who started her career as a patent prosecutor before moving on to litigate cases at the district court and Federal Circuit levels. She now handles PTAB matters exclusively.

“PTAB judges are often grounded in prosecution, and the process of how to get a patent comes up more than you would think,” she said. “At the same time, PTAB proceedings are subject to the same federal rules of evidence, and you have depositions as in district court litigation, and you have to keep an eye on the Federal Circuit since rulings can be appealed there. Having a 360-degree view of the patent practice helps you be successful at the PTAB.”

With the proceedings increasing in popularity, more pure litigators are jumping in, but they sometimes make mistakes that those with a more comprehensive background don’t make, such as in depositions of the other side’s expert witnesses, she said.

Depositions in PTAB proceedings are akin to a cross-exam in trial at the district court, and the point of
the deposition is to get testimony in a condensed form that attorneys can use in their brief or at oral arguments. But some attorneys ask experts open-ended questions and let them rattle on for 10 minutes, which won’t help, and will often hurt, their case, she said.

“Attorneys need laser-focused questions to get the sound bite from the expert and need to be able to keep following up if the expert is trying to evade their questions,” she said.

As filings continue to pick up at the PTAB, a hybrid patent attorney is emerging, according to Gordon.

“It’s a new type of attorney with a different skill set from a prosecutor or litigator,” she said. “With a strong technological foundation, an understanding of the forum’s rules and procedures and a 360-degree view, PTAB attorneys are unique litigators within the scheme of patent law.”

--Editing by Mark Lebetkin and Emily Kokoll.