



THINK FORWARD

Practice Tips Learned From the Inaugural PTAB Bar Association Conference

The newly formed PTAB Bar association held its inaugural conference in Washington, D.C. from March 1-3. More than 400 people were in attendance, including a mix of practitioners, in-house counsel, PTAB administrative law judges (ALJs), and other representatives from the United States Patent and Trademark Office. The conference included panel discussions with a diverse range of panelists offering a wide spectrum of views, which led to open discussions on various post-grant proceeding topics.

PTAB ALJ panelists provided interesting perspectives from the bench. Here are some of the practical tips I gathered during the conference related to oral hearings.

A party has the option to request oral hearing during a post-grant proceeding under 37 CFR §42.70. The PTAB then has the discretion to set a time limit for each party to present their arguments during the oral hearing. The oral hearing is essentially the last opportunity for the parties to present their arguments to the PTAB. By the time of oral hearings, the PTAB has already reviewed written arguments from both the petitioner and patent owner, and also identified the main controversial issues. Therefore, one of the main themes advocated by the ALJs was to focus on the controversial issues and not waste limited time on undisputed facts. In practice, this translates to being careful not to overuse slides. This may be achieved by, for example, only including slides on cases with holdings having a direct application to a controversy, and leaving out slides illustrating general rules and laws.

ALJs also emphasized having a strong understanding of the proceeding record for the oral hearing. Sounds simple, but attorneys risk losing credibility in front of the PTAB when they are not able to answer questions concerning statements made in their filings, or provide support from the record relating to arguments presented during the oral hearings. Oral arguments in a post-grant proceeding are fact-intensive and draw heavily from the established record of the proceeding. Oftentimes the PTAB will directly question attorneys while they are presenting their arguments. To be more effective, it might make sense to split oral arguments between multiple attorneys who focus on specific topics, as long as the number of attorneys does not grow to a number that becomes distracting.

Coming prepared on the record of the proceedings was stressed, but the ALJs also recommended allowing the PTAB to lead the discussion during oral hearings. The PTAB will come prepared with their own set of questions to address what they perceive to be the main controversial issues. So if the PTAB is leading the discussion to specific topics, attorneys would be well served to focus on those specific topics and provide answers to the PTAB's question.

Finally, laser pointers don't appear to show up effectively on the new LCD display boards.

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Additional information about post-grant proceedings can be found on our [Post-Grant Patent practice group page](#).

