

# Prosecution to Avoid Review

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# Practical Tips for the Prosecution Team



**Tip 1**  
**High Profile and High Stakes Prosecutions Need Some**  
**TLC**

# High Profile/High Stakes Matters

- Identify high profile and high stakes prosecutions
- Get prosecution teams with post-grant review experience working on those matters
- Forget some of the pre-conceived aspects of volume prosecution
  - E.g., cheap and fast
  - E.g., minimal or no patent prior art search
  - E.g., claim count limitations
  - E.g., discussion of the prior art

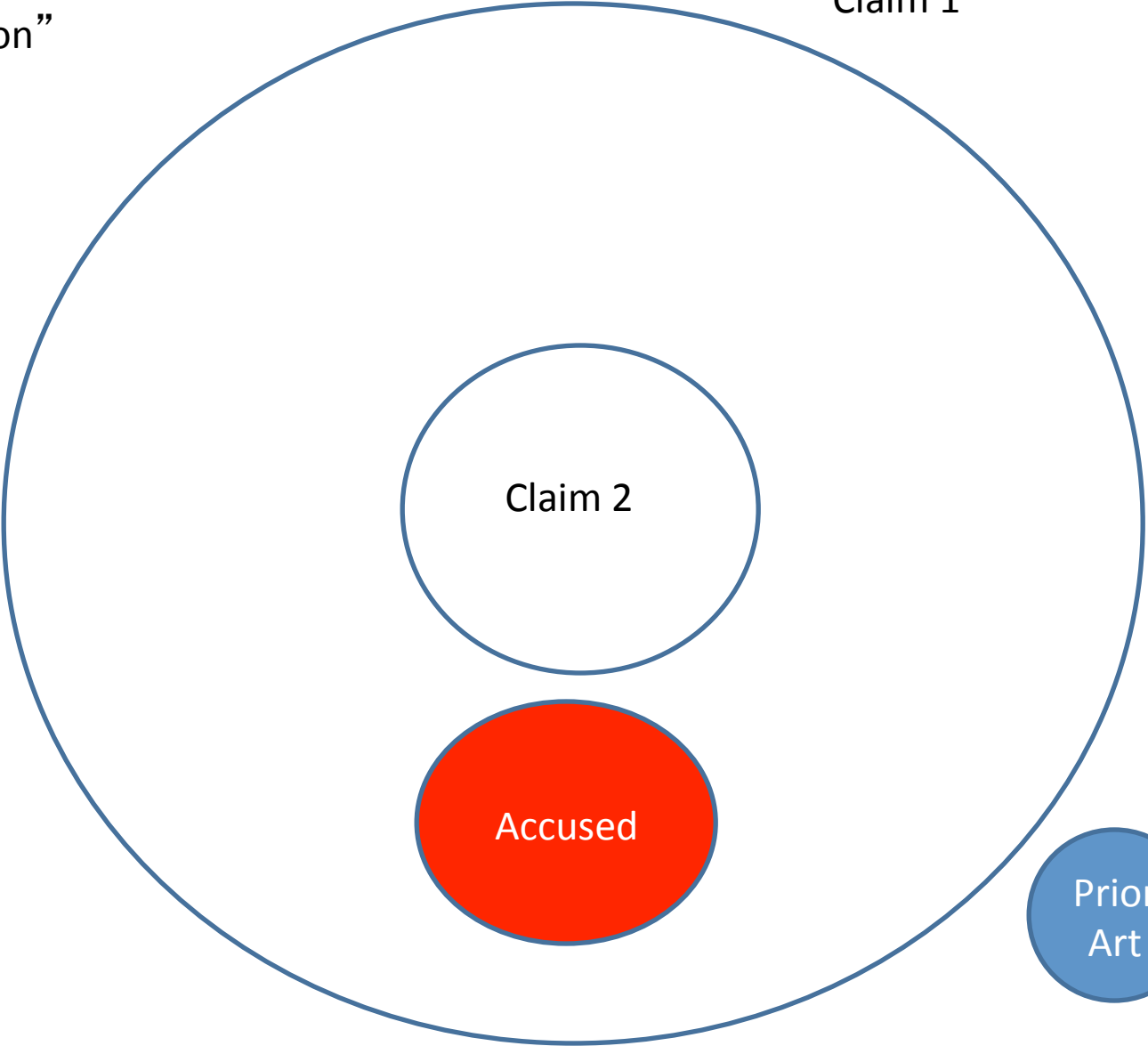
# Prosecutors and Litigators Need New Thinking

- You need to incorporate legal changes as soon as possible into your applications, because the petitions before the Board have already used the latest cases
  - Patent-eligibility
  - Joint infringement
  - Obviousness
- Ambiguous claim language is subject to broadest reasonable interpretation in the PTAB
  - The Board has used it to narrow or cancel many claims already
  - Interpretation will be the subject of much argument in a proceeding
  - Cannot cloak the invention in technology-speak and expect that it will not be understood by a PTAB judge
    - Expert declarations accompany most PTAB petitions now
- Prior art undercharacterizations/mischaracterizations will come back to bite the drafter
  - There is no need for a new reference or new issue to challenge patent claims

**Tip 2**  
**Amendments are the Enemy of Patent Asserters (and  
the Friend of Patent Challengers) in Patent Review**

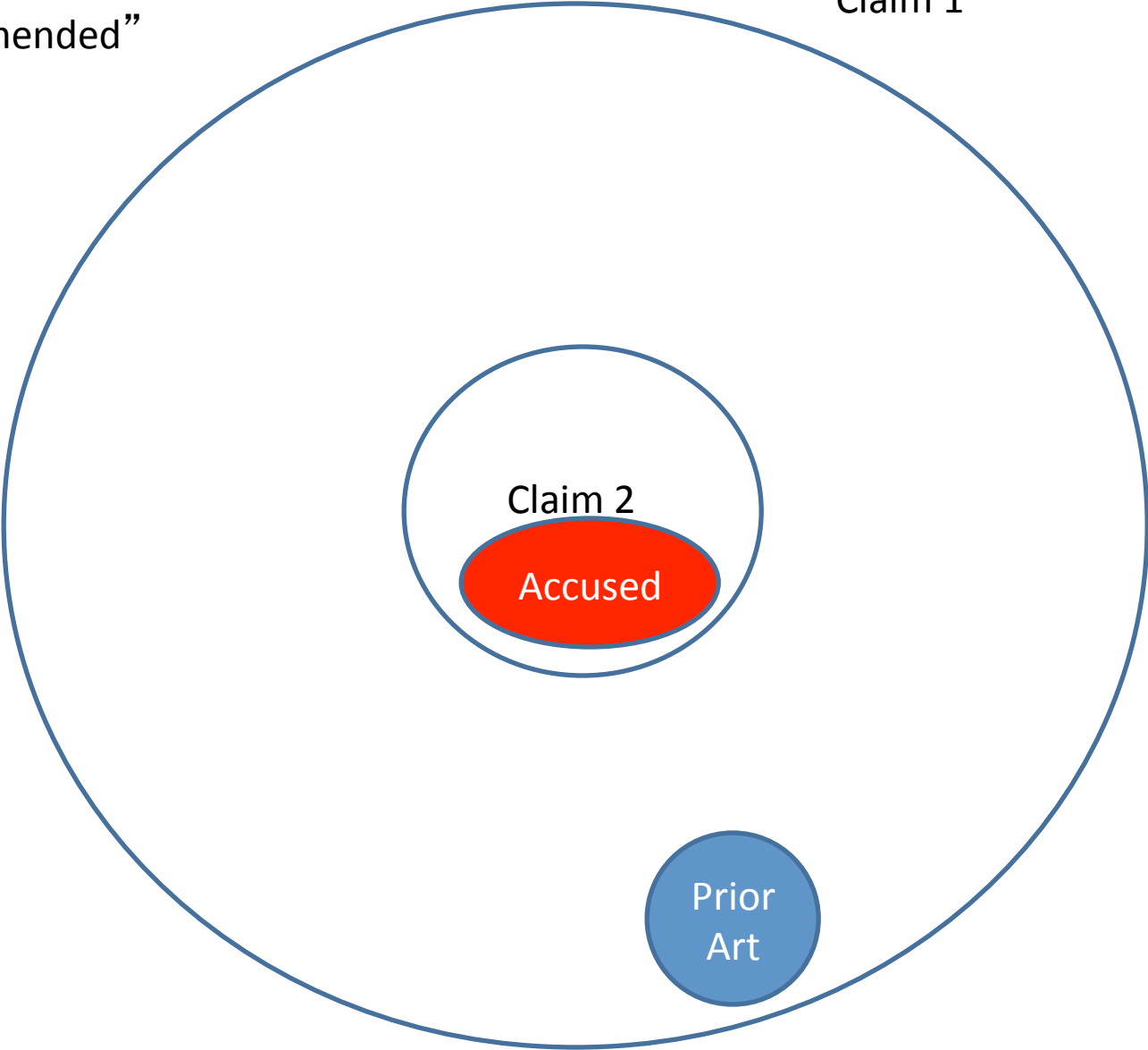
“No Amendment  
Situation”

Claim 1



“Dependent Claim  
Not Amended”

Claim 1





“Amendment  
Situation”

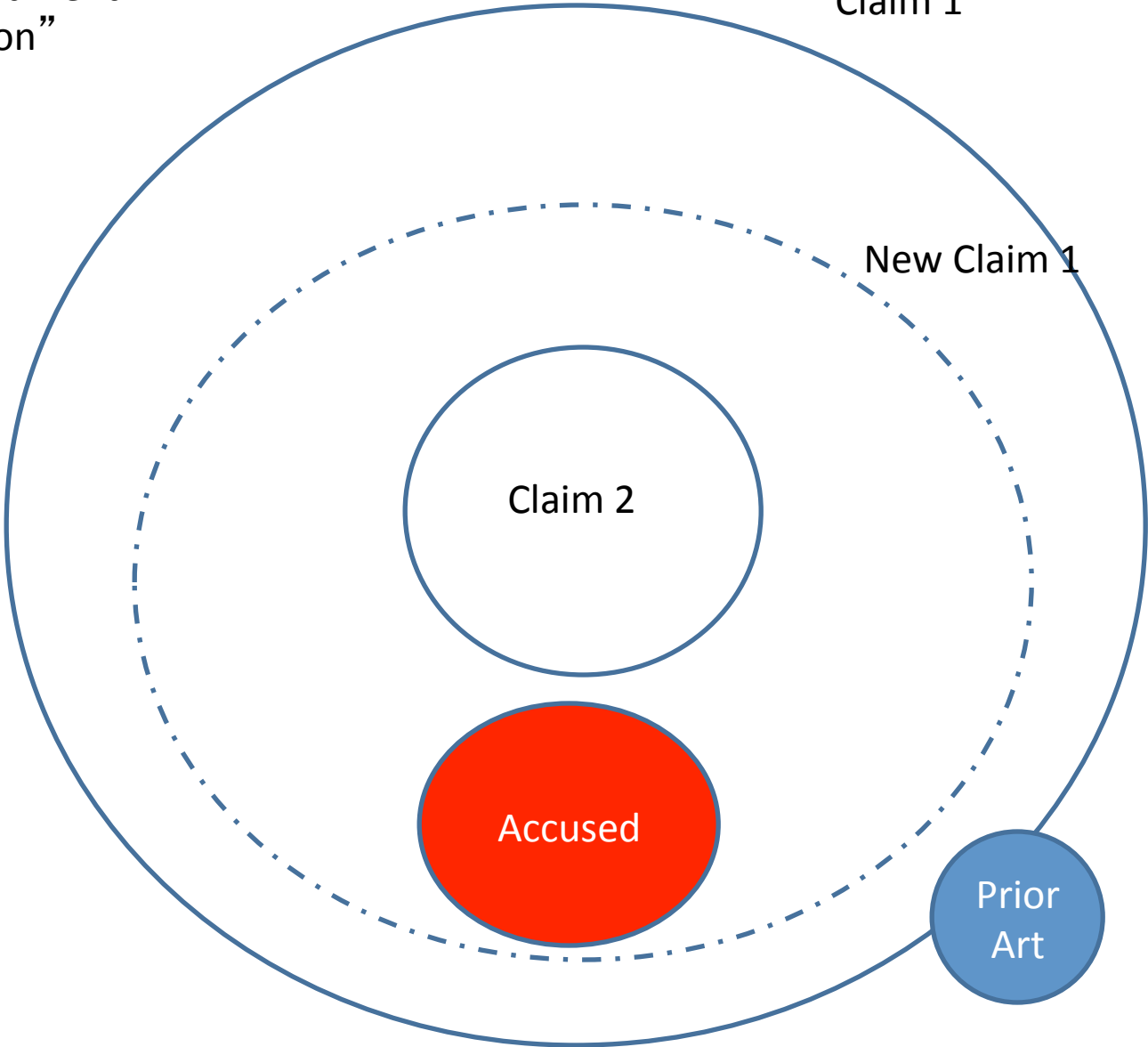
Claim 1

New Claim 1

Claim 2

Accused

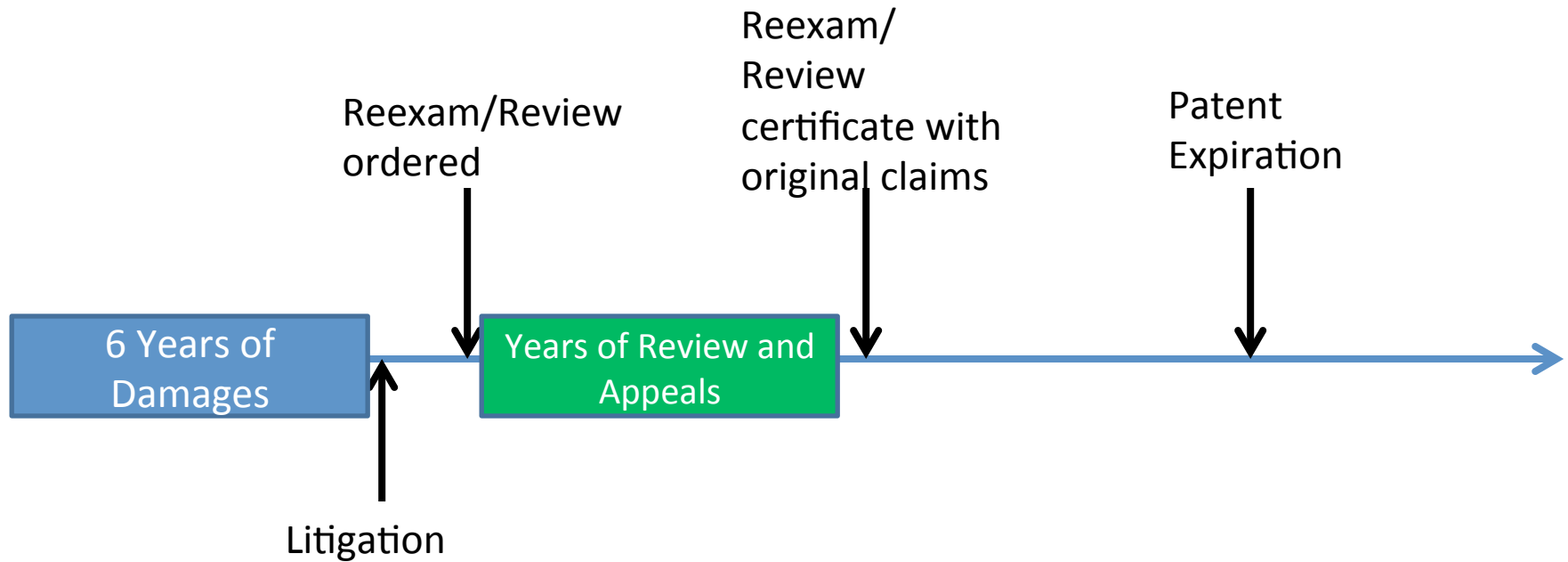
Prior  
Art



# Substantive Amendments May Trigger Intervening Rights

- Absolute Intervening Rights
  - 35 U.S.C. § 307(b) for reexamination has same effect as 35 U.S.C. § 252 for reissued patents
  - 35 U.S.C. § 318(c) for IPR (and § 328(c) for PGR and CBM) has same effect as 35 U.S.C. § 252 for reissued patents
  - Can result in forgiveness of damages prior to issuance of reexamination certificate (“past damages”)
- Equitable Intervening Rights
  - 35 U.S.C. § 252(b), last sentence “made substantial preparation for”
  - Court may allow an infringer future practice of invention to allow for infringer who scaled up in reliance of invalidity of patent

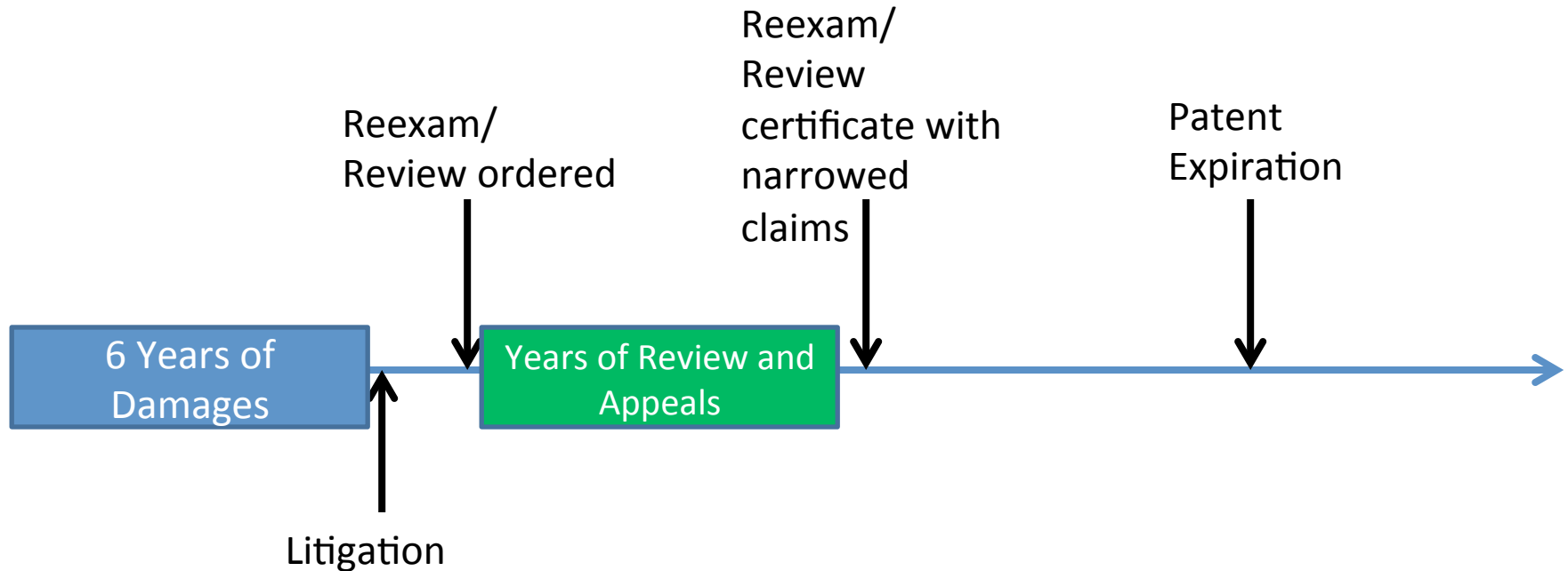
# Past Damages with No Substantive Amendments



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Potential Damages

# “Past Damages” with Substantive Amendment



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Potential Damages if no original dependent claim infringed (subject to intervening rights)

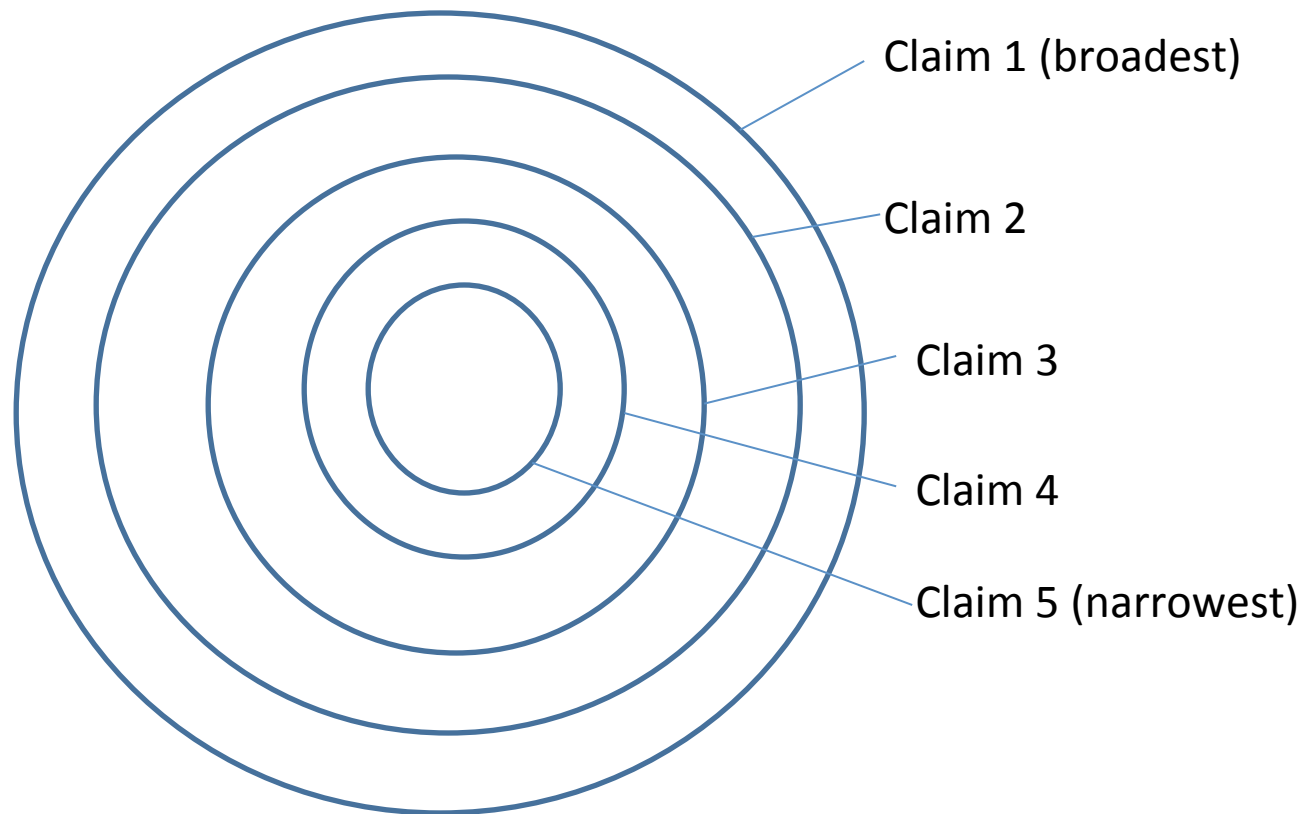
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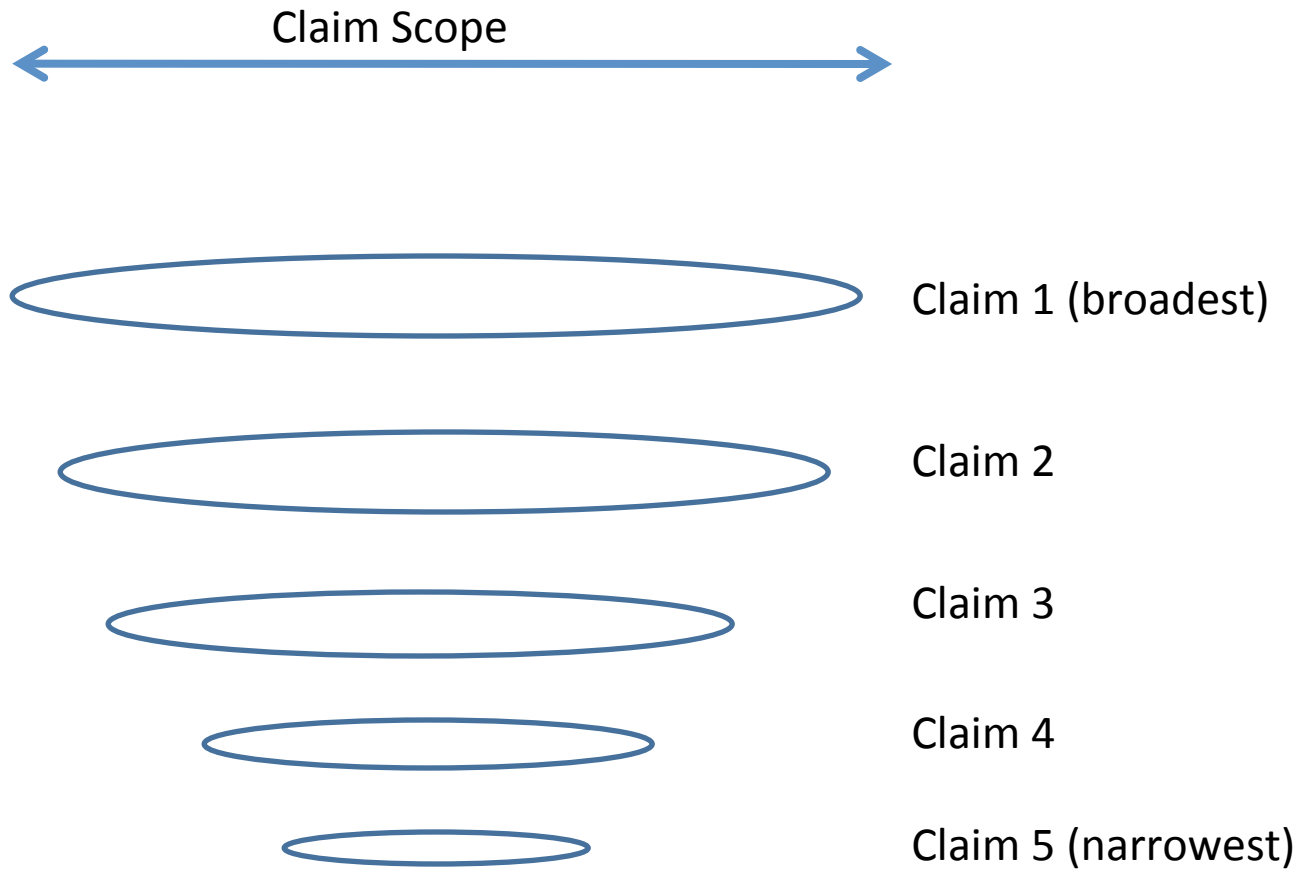
Potential Damages if original dependent claim infringed

**Tip 3**  
**Think of Your Invention as a Continuum and  
Thoroughly Claim it With Nested Dependent Claims**

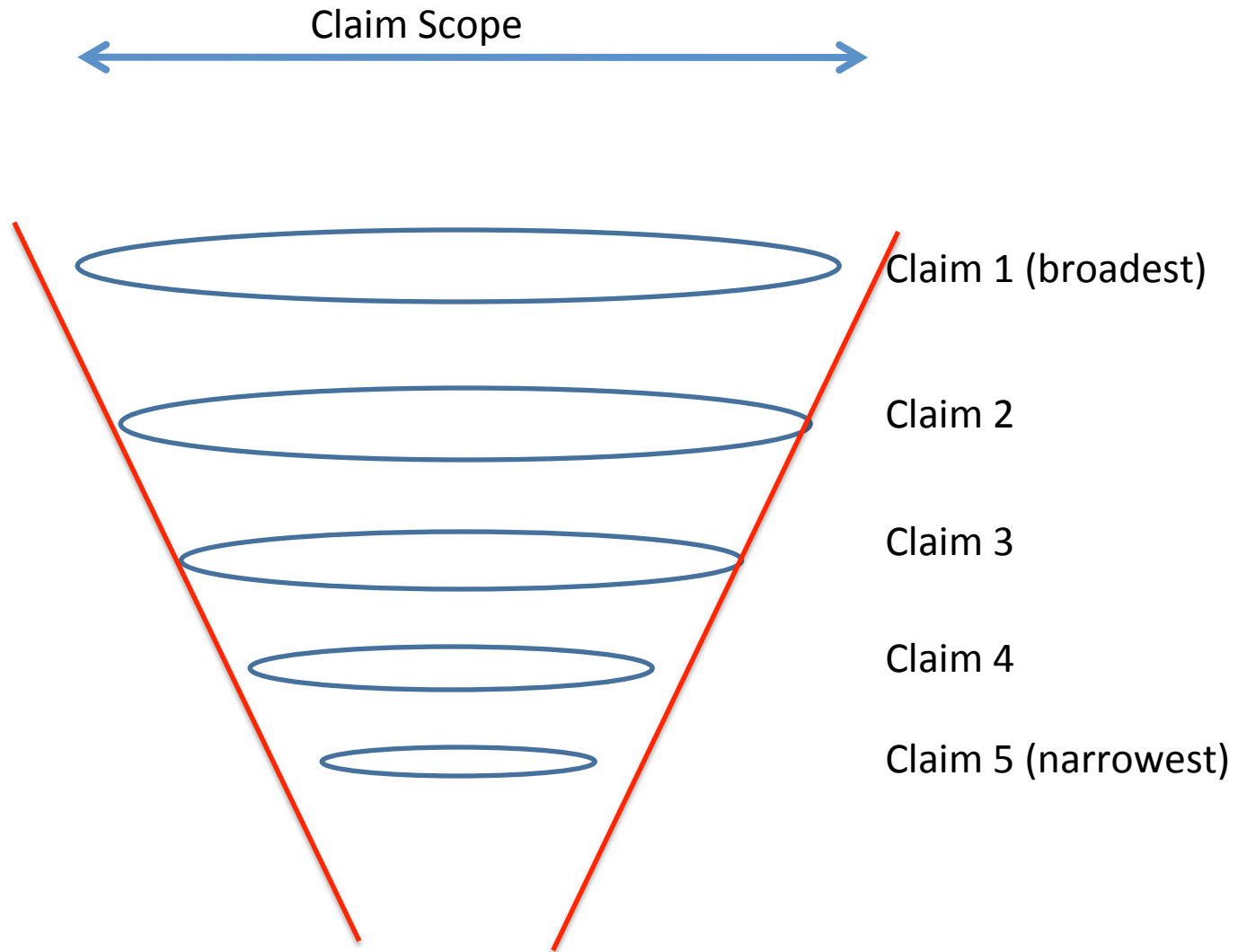
# Think of Inventions as a Continuum and Gradually Claim the Continuum

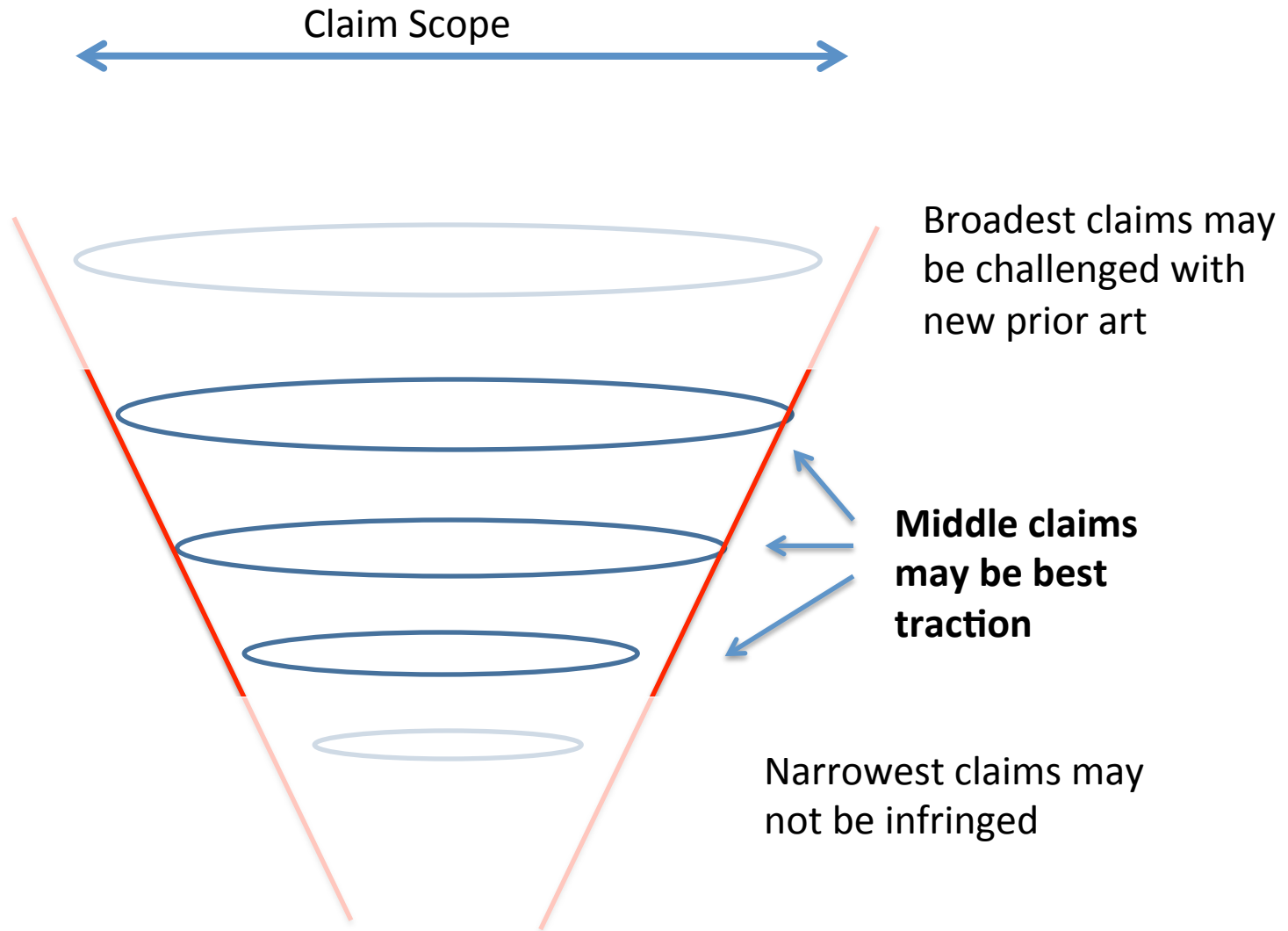
- Claim your invention in ranges
- Narrow it by successive dependent claims that add further nested limitations
- By claiming a range of gradually varying claim scope, you greatly enhance the odds that at least some of the claims survive in case prior art is later learned to be closer than first thought
  - Make “landing pads” of narrower dependent claims to best preserve past damages as an option in a parallel or subsequent litigation
  - Make competitors hesitate to initiate the reexam/review in the first place



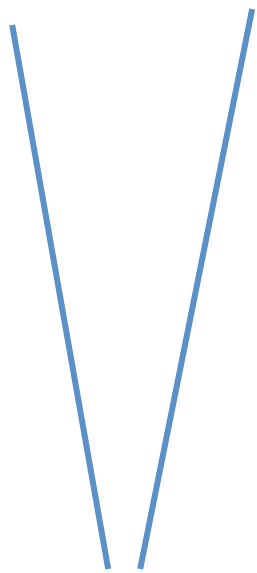




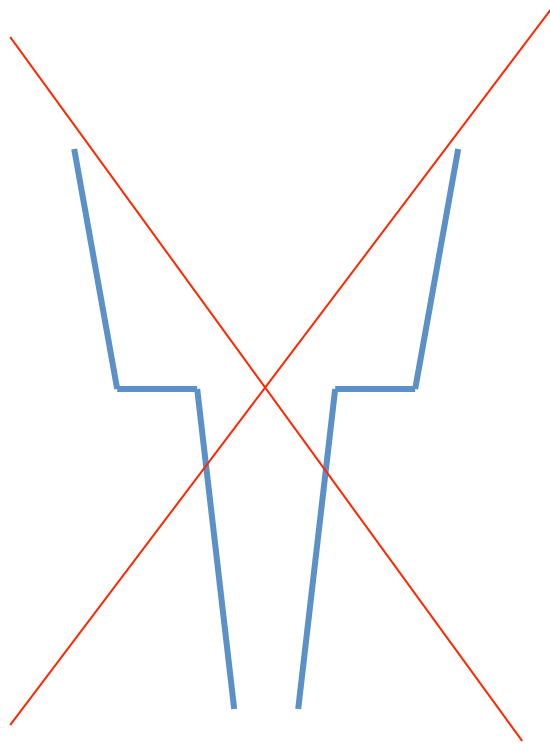




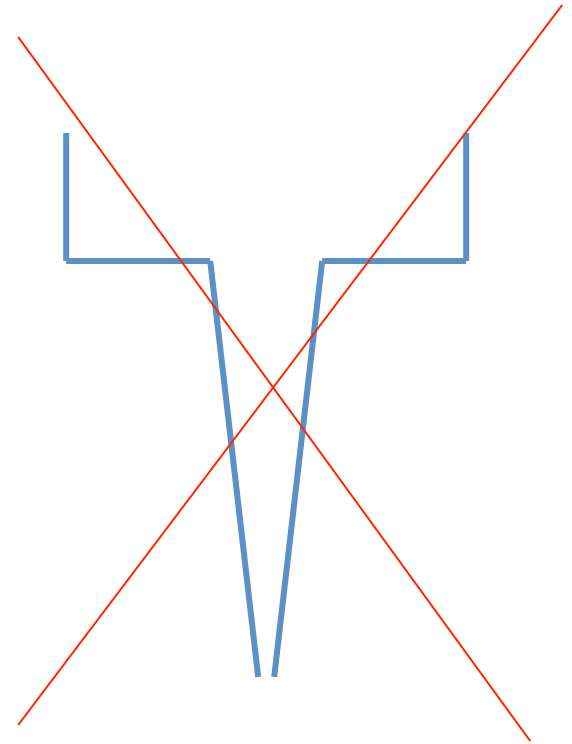
**Tip 4**  
**Structure Claims to Avoid “Substantive Amendment”**  
**in Post-Grant Proceedings**



Progressively narrower



Progressively narrower with abrupt step in middle of dependent claim chain



Abruptly narrower claim 2 of dependent claim chain

**Tip 5**  
**Where Possible Employ Independent Claim Element  
Diversity to make the Patent Harder to Challenge**

# Use Independent Claim Diversity

- Independent claim diversity provides more work for claim challenges by petitioner;
- Claim diversity has better changes of surviving review
  - NOTE: May be difficult with current restriction practice

# PTAB Observations Thus Far

- The Board is running a very tight ship
  - Early forgiveness due to the new proceedings
  - Less so in the future
- The Board will not tolerate a lot of gaming
  - Litigation strategies are frowned on
- The Board will define your claim terms
  - Whether you do or not!

# PTAB Observations Thus Far

- The Board will make very detailed findings of fact
- Claims reviewed on an individual basis



# **CHANGES TO WATCH FOR**

# Rise of Written Description Challenges

## – 35 U.S.C. § 112, ¶1

- § 112 rejections are common in post-grant
  - PGR, CBM
    - § 112 is Built into the process
  - IPR
    - § 112 is not automatic, but observed:
      - w.r.t. priority date challenges
      - New claim language

# Written Description Prosecution Tips

- Haste makes waste
  - Just plain old hurrying can make problems
  - Don't Expect the Examiner to check for written description
- Occasional spot checking of written description support will find nonconformists
- Beware the last minute “convenient amendment” for allowability
  - Need prosecution practices with consistency and closure
- Poor Framing of issues causes a \*lot\* of problems
  - Negative limitations
  - “exclusion” of the prior art
  - Half-baked amendments to overcome prior art
- How about some healthy background (e.g., boilerplate)?

# Rise of Indefiniteness Challenges – 35

## U.S.C. § 112, ¶2

- § 112 rejections are common in post-grant
  - PGR, CBM
    - § 112 is Built into the process
  - IPR
    - § 112 is not common in IPR – may result in loss of jurisdiction of the Board
      - Board cannot interpret the claims!
      - Can result in IPR being dismissed in extreme cases

# Tips for Avoiding Indefiniteness

- Reward fewer antecedent basis defects
- Reward fewer poorly defined terms/phrases
- Means-plus-function
  - 35 U.S.C. § 112(f), Williamson v. Citrix, and Aristocrat Technologies Problems

# Rise of Technical Prior Art Challenges – 35 U.S.C. §§ 102, 103

- Skilled PTAB 3 judge panel
- Do your homework or someone will do it for you

# Fast Prosecution-to-PTAB Cycles

- Will be less than 1 year in some cases
  - Don't forget, you don't always go to trial!
    - Settlements
    - Waiver
    - One year bar

# Quick Tips for the Prosecution Team

- Dependent claims can help save recoveries for past damages
- Smart claims are claims drafted with prior art in mind
  - informed claiming
  - not too broad
- You can draft to avoid post-grant challenges



# Thank You!

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# Disclaimer

This presentation is not intended to be legal advice, but rather it is a general discussion of possible considerations about patent practice which will vary greatly with actual facts and state of the law. The reader is urged to retain competent legal counsel for any actions contemplated or ongoing.