

# Strategies for Strengthening your PTAB Trial Record for Appeal

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## Standards of Review for PTAB Appeals

- Questions of law are reviewed *de novo*.
  - Claim construction
  - Statutory interpretation
  - Compliance with obviousness legal standards under § 103
  - Whether a claim invokes means-plus-function under § 112 ¶ 6
  - Function and corresponding structure determinations under § 112 ¶ 6
  - Patentable subject matter under § 101
  - Constitutional questions

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## Standards of Review for PTAB Appeals

- Questions of fact are reviewed for **substantial evidence**.
  - Anticipation under § 102
  - Underlying obviousness factual issues under § 103
    - Analogous art
    - Scope and content of the prior art
    - Reasons to combine
    - Secondary considerations
- Compliance with procedural/evidentiary rules reviewed for **abuse of discretion**.

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# Build Your Record

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## Belt & Suspenders Approach to Evidence

- Alternative evidence can support your positions if your primary evidence is not available.
  - Strongest evidence may get excluded, or accorded little weight.
  - Make sure your alternative evidence is cited in papers (not just in declaratory evidence).
  - Example: include evidence on how the claim is met under both parties' proposed claim construction.
  - Attorney argument need not be rebutted with expert testimony (*Idemitsu*), but it certainly doesn't hurt.

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## Belt & Suspenders Approach to Theories

- Alternative theories (e.g., reasons to combine) can lead the CAFC to rule in your favor even if your primary argument fails.
  - Preserve alternative theories in your Reply or Patent Owner Response. Do not waive if possible.
  - Arguments not meaningfully developed are treated by the CAFC as waived, and you could lose a partial win (*HTC Corp.*)
  - Harmless error can be your savior.

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