

UNITED STATES
PATENT AND TRADEMARK OFFICE



2022 PTAB Bar Association Annual Conference

APJ Day – Appeals

March 23, 2022

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Oral advocacy before PTAB

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Purpose of the hearing—a judge’s perspective

- Judges thoroughly review the case prior to the hearing, and will have preliminary conclusions about some issues of the case, but likely will be undecided as to other issues that may be critical to their decision
- Judges will want to focus on the issues critical to their decision, even if those issues are not the issues you would like to focus on
- As a result, oral argument usually is ***more like a Q & A*** than a presentation
- Listen to the Judges’ questions and try to understand what issues interest them. This is your opportunity to provide arguments in your side’s favor and persuade the Judges on issues about which they’re undecided



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Before the hearing

Review the Hearing Order. It includes helpful information including, but not limited to

- Finalized hearing date, time, and location
- Total length of argument time
- Instructions for exchanging demonstratives, if applicable (AIA trials)
- Instructions for requesting pre-hearing conference, if applicable (AIA trials)
- Instructions for requesting audio/visual equipment
- Instructions for requesting remote viewing (subject to hearing room availability)

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Practice makes perfect

- Take the opportunity to moot your argument with colleagues, if at all possible
- At minimum, run through your points with a stopwatch to see if you overflow your time allocation

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First appeared as part of the conference materials for the
17th Annual Advanced Patent Law Institute session

"Tips for Oral Arguments Before the PTAB"