

# Top Ten Tips For Winning a Patent Appeal

by James T. Carmichael\*

While sitting as an Administrative Patent Judge on over five hundred appeals and arguing dozens more myself at the U.S. Court of Appeals for the Federal Circuit, I distilled the recipe for successful appellate argument down to ten easy techniques. But first, there are a few things that can be done before the argument even begins.

## A. Before the Argument

### 1. Shoot the Background (and the Summary)

The first thing patent attorneys are taught, and the first thing they write when they sit down to draft a patent application, is the Background of the Invention. This is wrong. The Background of the Invention section should, in most cases, be eliminated.

The traditional view of writing a good patent application has long been that the prior art should be discussed and distinguished in the Background of the Invention section. Typically, these Background sections attempt to describe (or invent) problems associated with the prior art. The Background is proudly followed by a “Summary of the Invention.” The Summary proclaims that the horrible problems described in the Background have now been miraculously solved by the invention. It also summarizes the invention. This too is wrong. The Summary of the Invention should generally be eliminated.

The traditional approach described above is harmful to the inventor. It often creates “prior art” knowledge that never actually existed. It almost always limits the scope of protection. Parties attacking a patent can look to the Background and Summary as a way to restrict the invention to one that solves particular problems. They can also make the evolution of the prior art into the new invention seem trivially obvious.

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Most patent attorneys think that the Background and Summary are required. They are not. In most instances, they are not even helpful. And they cost money.

Learning to write patent applications has always been an apprenticeship. I first learned the craft from an attorney that supervised me at a law firm. He, in turn, learned it from an attorney that supervised him when he started at the firm. This quickly takes us back to a knowledge base developed in the first half of the 1900's.

Everything changed in 1952. Or at least it should have. That was the year that "obviousness" supplanted the old "flash of genius" standard of patentability. Prior to 1952, the Background and Summary tradition made more sense. A patent attorney was required to convince the U.S. Patent and Trademark Office that the invention was truly inspired. Despite the passage of fifty years since that requirement was eliminated by Congress, the apprenticeship system perpetuated the old way of drafting patent applications.

In laboring over the Background and Summary, attorneys sometimes believe they are telling a compelling story to a jury somewhere in the future. Having read thousands of Backgrounds and Summaries, I am still looking for one that would make a good screenplay. Even if patent drafters could effectively communicate to a jury, why should they? It is a trial attorney's nightmare. Only after the issues have been winnowed through years of patent prosecution, marketplace developments, and litigation will the trial attorney know how best to present an invention to a jury. The patent application is drafted far too early in the process to set the inventor's position in stone.

I have argued or judged many appeals that an inventor lost because of loose statements in the Background or Summary. Those cases could have been won had the Background and Summary never been written.

2. Order Translations
3. Inspect The File at the PTO
4. Fire Your Lawyer

B. The Top Ten

1. Focus on One Authority
2. Argue Claims Separately
3. Challenge the Prima Facie Case
4. Object to “Common Knowledge”
5. Protest “Inherency”
6. Avoid the Loser Arguments
  - a. Inoperable combination
  - b. Large number of references
  - c. No explicit suggestion
  - d. Partial teaching away
  - e. Secondary considerations
  - f. *Ad hominem*
7. Add An Addendum
8. Use a Summary of the Argument to Full Effect
9. Score at Oral Argument
10. If All Else Fails . . . . Request Rehearing