

5 KEY TAKEAWAYS

Building a Winning Evidentiary Record at the PTAB (and Surviving Appeal)

Kilpatrick partners [John Alemanni](#) and [Justin Krieger](#) recently presented a CLE addressing “Building a Winning Evidentiary Record at the PTAB (and Surviving Appeal).”

Key takeaways from the presentation include:

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Proving a prior art reference was publicly accessible is key and should not be taken for granted.

It is important to focus on what exactly the Petitioner is attempting to prove, that is, whether it was actually disseminated or otherwise made available. Potential sources of evidence include:

- Declarations from a librarian, such as at a university library, who can testify as to what, when, and how the reference was cataloged and made available.
- Declarations from a technical expert or other person of skill in the art who attended a conference or otherwise has personal knowledge regarding the reference or the circumstances under which it was made available.
- Citations to the prior art reference in other widely available documents.

Proving the date a prior art reference is available requires attention to detail.

Do the dates match across the evidence related to the reference?

- Do any reference numbers match across the evidence?
- Is there anything about the reference that suggests it was confidential, such as explicit marking?
- For web-pages, consider Internet Archive corroboration and ensure the archived page was actually available before the critical date.
- Examine the reference carefully for contradictory evidence.

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When relying on or rebutting evidence of Secondary Considerations, focus on evidence of nexus, either presumptive nexus or an actual nexus.

For a presumption, you must demonstrate commercial product embodies the claims and is coextensive with them.

- The analysis should be in both the briefs and supported by expert testimony.
- Identify additional unclaimed features that might affect the analysis.

Evidence first submitted with a Petitioner’s reply is sometimes but not always admissible.

- If a Patent Owner presents argument that the Petitioner did not anticipate, the Petitioner may be able to introduce new evidence in the reply.
- The new evidence is most likely to survive a motion to exclude if it is supplied in support of an argument presented in the original petition.

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Obtaining additional discovery is difficult, but not impossible.

- Request a call with the Board to seek leave to file a motion for additional discovery.
- Be prepared to address all of the “Garmin factors,” and in particular, show how the discovery request is not based on a mere possibility or allegation.