



## IP: These claims are not obvious, just ask my expert!

**FILING AN EXPERT DECLARATION DURING PATENT APPLICATION PROSECUTION CAN BE VERY PERSUASIVE, BUT CAREFUL CONSIDERATION SHOULD BE GIVEN WHEN SELECTING EXPERTS AND DRAFTING THE DOCUMENT**

Since the Supreme Court's decision in [KSR Int'l Co. v. Teleflex, Inc.](#), patent examiners at the United States Patent & Trademark Office (USPTO) have wider latitude with respect to combining prior art references to support an obviousness rejection. Following *KSR*, the USPTO promulgated examination guidelines and rationales for examiners to use in evaluating obviousness. Patent applicants may overcome a rejection based on some of these rationales, for example, by demonstrating the unpredictability present in the art at the time the invention was made. One way to do that is by surveying the state of the prior art and presenting evidence to the USPTO. A declaration under 37 C.F.R. § 1.132 (132 declaration) may add credibility to such evidence.

Among other uses, a 132 declaration may be used to disqualify references and to traverse rejections under 35

U.S.C. §101 (utility), §102 (novelty), §103 (obviousness) and §112 (written description). Patent applicants and their representatives should be mindful of several important issues when selecting an expert and when drafting the document.

### Some important "do's" for applicants to consider

1. Consider the expert's background and any relationship with the patent applicant. The expert's credentials (*e.g.*, a resume or *curriculum vitae*) should be included in a 132 declaration, and those credentials should establish the declarant as an expert in the technology area at issue. While on the one hand an inventor can likely easily establish credibility as an expert in the field, a 132 declaration executed by a prominent "outside" expert has the potential advantages of avoiding any appearance of business or financial interest; and securing the cooperation

of a respected authority figure throughout prosecution and, if necessary, during litigation (while also precluding the possibility of an opponent from doing so). Regardless, all aspects of the relationship between the expert declarant and patent applicant(s), inventor(s), assignee(s), and/or licensee(s) should be identified in a 132 declaration. An undisclosed business relationship between a patent applicant and a declarant can hide possible bias, implicate inequitable conduct and, as a result, potentially render the subject patent unenforceable.

2. Evidence to support opinions in a 132 declaration can be very powerful. Much like the situation that attorney argument without factual evidence will not rebut *prima facie* obviousness, a 132 declaration providing only the expert's opinion, without detailed reasoning discussing the claims and the prior art, may fail to persuade an examiner. To strengthen the statements made

by the declarant, particularly when the declarant is opining on a secondary consideration such as unexpected results or commercial success, evidence (e.g., comparative data, references, etc.) can be submitted. Keep in mind that when providing evidence of unexpected results, it must be shown that the unexpected results are commensurate with what is *claimed* in the patent application. Similarly, when providing evidence of, for example, commercial success, it must be shown that the commercial success is the result of the *claimed features*.

3. Focus on the skill and knowledge of an ordinary artisan at the time of the invention. Expert declarants should point to specific deficiencies in the relevant art. Conclusions unsupported by facts are to be avoided. Instead, declarants should provide facts followed by reasoned, technical conclusions.

**Some important “don’ts” to avoid**

1. Avoid legalese! A 132 declaration should not provide legal conclusions. Leave the legal arguments/conclusions to the attorney. An expert’s opinion on the ultimate legal conclusion is not evidence, and providing such an opinion could come back to haunt the expert in a later proceeding or litigation. For example, in a 132 declaration where an expert declarant states that he understands §103

(obviousness) and has read all of the references cited by the examiner and has concluded that the claims are not obvious, the expert declarant may very well find herself/himself being deposed on the nuances of §103 patent law — an unenviable position for a scientist.

2. Avoid misleading statements and omission of facts. Just like failing to disclose a business relationship between a patent applicant and a declarant, material misrepresentations in a 132 declaration may result in the unenforceability of a patent. Patent applicants and expert declarants should not withhold adverse information (e.g., negative data). Instead, the adverse information should be fully disclosed and, if appropriate, a 132 declaration may explain the circumstances that generated the negative results.

3. Do not underestimate the risks of inequitable conduct. A finding of inequitable conduct requires materiality and intent to deceive. A 132 declaration is presumed material to patentability and so intent to deceive the USPTO may be more readily inferred. Patent applicants should disclose any and all facts that an examiner (or a judge in later litigation) may consider important when evaluating the relevance of evidence submitted during prosecution.

When drafting patent applications

or responses to Office Actions, beginning patent practitioners are often advised to “imagine that this application will be litigated and that every word will be scrutinized...” This mentality should also be adopted when preparing expert declarations. Select an expert with excellent credentials and someone that can be trusted during a deposition. In the declaration itself, the expert should fully disclose any past or present financial relationships with the patent applicant, draw reasoned technical (as opposed to legal) conclusions based on provided facts, and avoid misleading statements or omitting facts that an examiner may deem important for patentability.

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