

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Appeals and Pre-Appeals

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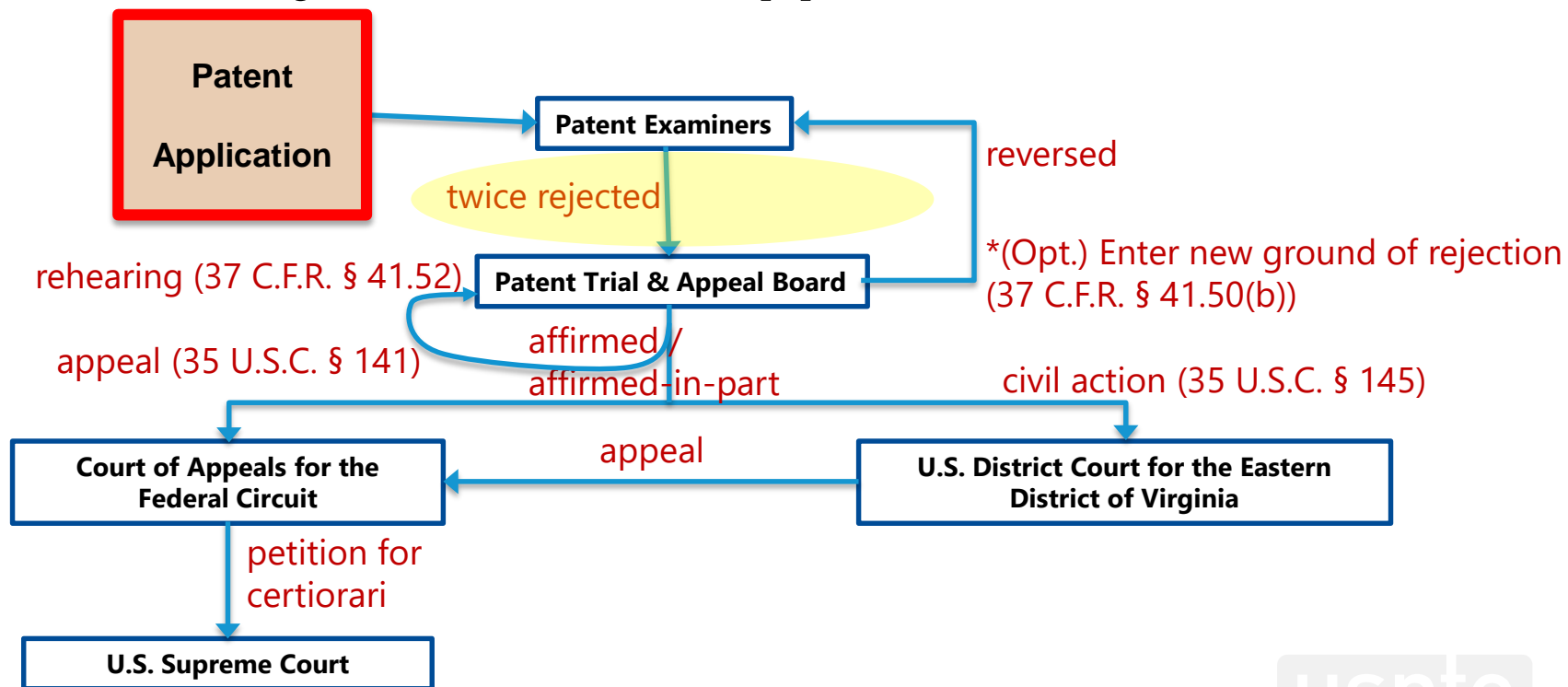
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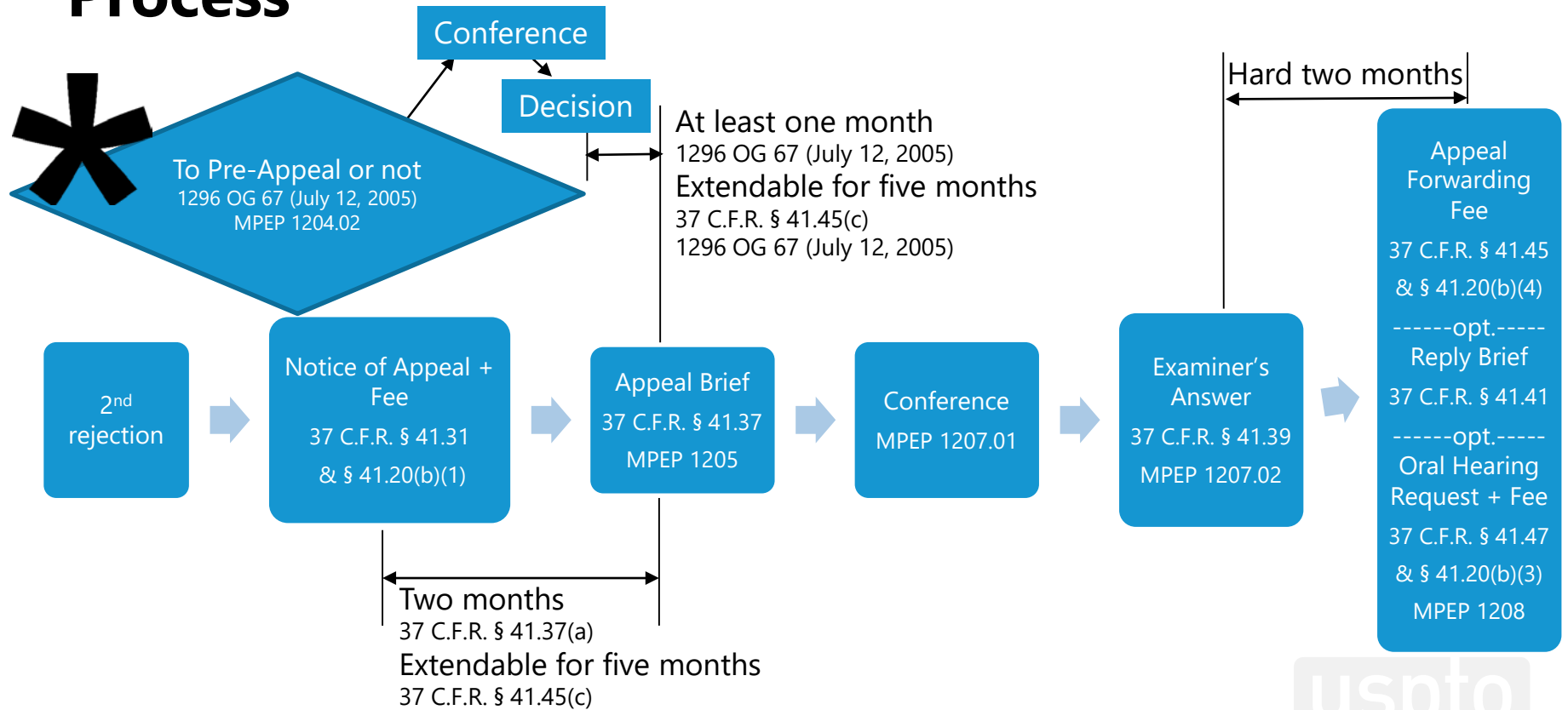
Objectives

- Appeals Process overview (from soup to nuts)
- The Technology Center review processes
 - For Pre-Appeals
 - For Appeals
- TC 2800 Statistics
- Frequent Questions on Raising Issues
- Q & A

Path for PTAB and Court Review of Twice-Rejected Patent Applications



Quick Refresher on USPTO *ex parte* Appeals Process



To Pre-Appeal or Not

- **When you should consider requesting a Pre-Appeal Conference**
 - If some or all the rejections of record
 - Are improper and without basis
 - Are based on a factual or legal error
- **When Appeal might be better**
 - If the rejections of record articulate a *prima facie* case that requires further evidence, or interpretation of the claims of the applied art; or other evidence, to rebut

How to request a Pre-Appeal Conference

- Use the USPTO Form PTO/SB/33, or Label your Request Form as “Pre-Appeal Brief Request For Review”
- Submit WITH Notice of Appeal, as a SEPARATE Document
- No Amendments, Affidavits, or Other Evidence
- No Request Fee, But Notice of Appeal Fee Still Required
- No More Than Five (5) Pages of Arguments Attached to the Request Form
- CLEAR, CONCISE, FOCUSED

What Happens Next?

- **Technology Center (TC) convenes a panel**
 - TC 2800 uses QAS (Quality Assurance Specialist), SPE, and examiner of record
- **Panel reviews rejections identified by request, arguments submitted with the request, and application file**
- **Panel will decide if an issue for appeal is, in fact, present and issue a decision which should be mailed within 45 days of receipt of a properly filed request**
- **No applicant or representative participation**

Pre-Appeal's Design

- “Clear deficiency in the *prima facie* case in support of a rejection”
 - (1) Clearly improper rejections based upon error in fact
 - (2) Omission of essential elements required for *prima facie* rejection

* *New Pre-Appeal Brief Conference Pilot Program*, 1296 OG 67 (July 12, 2005); *Extension of the Pilot Pre-Appeal Brief Conference Program*, 1303 OG 21 (Feb. 7, 2006)

- **Examples of arguments appropriate for Pre-Appeal**
 - The applied reference is not in fact prior art
 - Inventive entity is clearly not one to which reference can be applied
 - A claim element that is clearly not present in applied art
 - Support in the disclosure is clearly found contrary to a 112(a) rejection contrary to the rejection's assertion otherwise
 - No rationale is provided in a 103 rejection
 - No evidentiary basis for a 103 rationale is provided in the rejection

Pre-Appeal's Design (cont.)

- **Examples of arguments that might take more than five pages (appropriate for Appeal)**
 - Secondary considerations
 - Improper combinations / teaching away in 103 rejections
 - Unsettled/challenging case law analysis
 - Questions over broadest reasonable interpretation
 - Challenges to Official Notice or inherency findings
 - Characteristics of POSITA* rendering 103 improper

*Person of Ordinary Skill In The Art

Panel's Decision

- **Decision will relate claim's status and simply state one of the following:**
 - Application remains under appeal
 - Prosecution is reopened
 - Application is allowed
 - Request is noncompliant and is dismissed

TC 2800 Pre-Appeal Conference Statistics

	Proceed to Board	Reopen / Allowance
FY 2017 (~953)	60.2% (~574)	38.8%
FY 2018 (~548)*	61.7% (~338)	37.3%

*At midyear

** Stats based on internal TC2800 tracking
7/25/2018

What Next?

- Proceed by filing an appeal brief
- Take indicated allowable material (amend claims)
- File RCE or Continuation
- Abandon

TC 2800 Appeal Practice

- Case goes to examiner's amended docket and examiner requests conference with SPE and QAS
- Hold Conference
- Conference Decision: prepare Examiner's Answer or reopen prosecution (new rejection, allow)

TC 2800 Appeal Conference Statistics

	Proceed to Board	Reopen / Allowance
FY 2017 (~1140)	75% (~855)	25%
FY 2018 (~517)*	73.9% (~382)	26.1%

*At midyear

** Stats based on internal TC2800 tracking

7/25/2018

Pre-Appeal vs. Appeal

	Pre-Appeal	Appeal
Filing Times	Same day as Notice of Appeal	2 months from Notice of Appeal (extendable for 5)
Issues	Simple	> = Simple
Page Limit	5 pages	N/A
Conference Scheduling	generally management responsibility	Docketed to Examiner's Amendment Docket (generally Examiner responsibility)
Conferees (positions)	Examiner, SPE, QAS	Examiner, SPE, QAS
Decision Goals	Generally <= 45 days	<=56 days

Raising Issues

Ordering the arguments?

- * Best argument first

Raising Issues

“The arguments shall explain why the examiner erred as to each ground of rejection contested by appellant.” 37 C.F.R. § 41.37(c)(1)(iv)

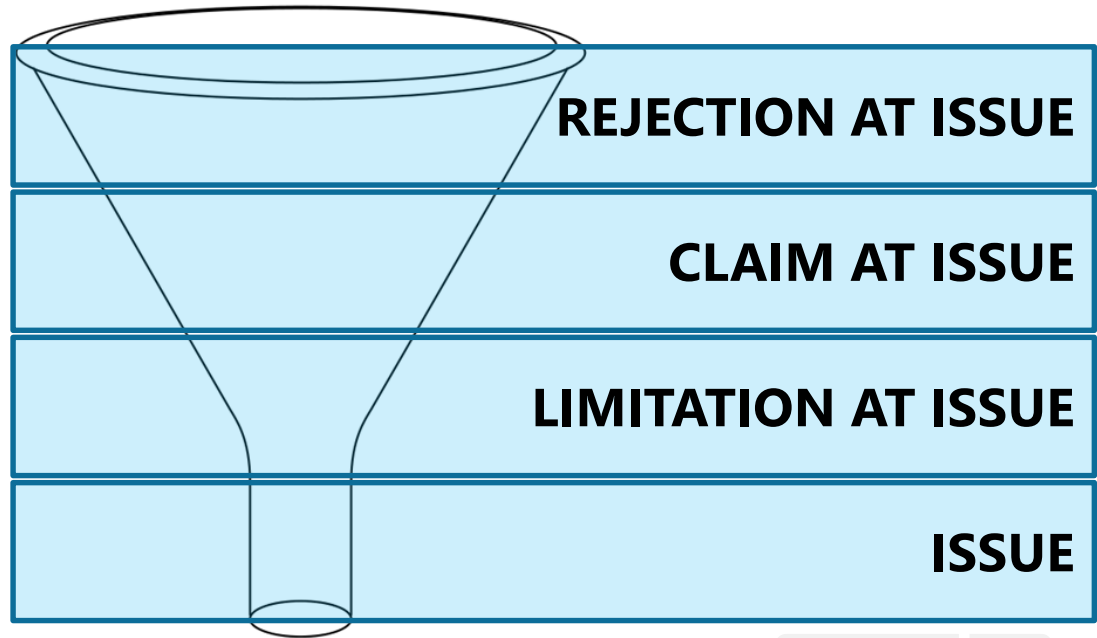
“The Board will treat as waived, for purposes of the present appeal, any arguments not raised by appellant.” 77 FED. REG. 72270, 72275



Raising Issues (cont.)

Funnel Approach

- Rejection
- Claim
- Limitation
- Why



Raising Issues (cont.)

“A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.” 37 C.F.R. § 41.37(c)(1)(iv)

See also, In re Lovin, 652 F.3d 1349 (Fed. Cir. 2011).

Claim Interpretation

“Absent an express definition in their specification, the fact that appellants can point to definitions or usages that conform to their interpretation does not make the PTO's definition unreasonable when the PTO can point to other sources that support its interpretation.” *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997)

Resources

- PTAB Statistics

<https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/statistics>

- First Office Action Estimator

<https://www.uspto.gov/learning-and-resources/statistics/first-office-action-estimator>



Questions and Answers

