

EX PARTE APPEAL BRIEF TEMPLATE GUIDANCE

In most *ex parte* appeals before the Patent Trial and Appeal Board (the “PTAB”), an initial brief, an answer brief, and a reply brief will be filed, in that order. As the appellant, who filed the notice of appeal, you will file the initial brief, i.e., the “Appeal Brief.” The Examiner then will respond with an “Examiner’s Answer.” You are not required to file a Reply Brief, but you may want to do so in order to respond to the arguments in the Examiner’s Answer. The Reply Brief only needs to include an Argument section because it just responds to the Answer; the Reply Brief cannot include any new arguments. On the other hand, if the Examiner raises new or different arguments in the Answer, you can respond to those arguments in the Reply Brief.

This document and the companion WORD template are intended to assist you in drafting the initial Appeal Brief.

I. REAL PARTY IN INTEREST

This section requires a statement from you that identifies the real party in interest at the time the appeal brief is filed. A real party in interest may include you as the inventor and any other individuals or entities that have ownership rights to the patent application. A statement is not required if the named inventor(s) are the real party in interest. If you do not provide a statement, the Board will consider the inventor(s) to be the real party in interest. Typically, a *pro se* inventor is the real party in interest. See Manual of Patent Examining Procedure, (MPEP) §§ 301, 324, 1205.02(i) (<https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e123366.html>).

Example:

The real party of interest is The Great White Café LLC (Baja, California 21511) by virtue of an assignment by the inventor.

II. RELATED APPEALS, INTERFERENCES, AND TRIALS

Please list all of your prior or pending cases before the Board or before a court related to the application subject to the current appeal, if any. These cases are based on applications or patents that you own. For example, an application and a continuation of that application are related to each other. It is important to notify the Board about prior or pending cases because they could affect the Board's decision in this case or be affected by the Board's decision in this case. There is no need to provide copies of any decisions. See MPEP § 1205.02(ii) (<https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e123366.html>).

Example 1:

Case No.; Date of Prior Decision (Appeal No. 2019-1234, prior decision dated July 1, 2020)

Example 2:

There are no related appeals, interferences, or trials to Appellant's knowledge.

III. SUMMARY OF CLAIMED SUBJECT MATTER

This section should provide a concise explanation of the subject matter defined in each of the rejected independent claims (i.e., those claims that do not refer to other claims by number). For *pro se* applicants, an appeal brief will be accepted without this section. See MPEP § 1205.02(v) (<https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e123366.html>).

This section may, however, be helpful for the Board to understand the issues raised in the arguments below.

If included, this section should include a short explanation of each independent claim, with references, for each claim element, to (1) supporting aspects of the original-filed specification (i.e., not the published application), by page/line number or by paragraph number and (2) drawings (if any) by reference numerals (i.e., the numbers within a drawing that may be used to identify different parts of the invention).

Example:

In the following summary, references to paragraph numbers are to the paragraph numbers listed in the specification as filed on October 19, 2015.

1. A system for protecting towed marine seismic equipment from shark bite (Figs. 1, 2; Spec. ¶¶ 10, 12, 13, 17, 19, 24–26), comprising:

marine seismic equipment (Figs. 1 & 2, element 10; Spec. ¶¶ 1, 12–15, 17, 24–26), towed through a body of water (Fig. 2, element 20; Spec. ¶ 25) by a marine vessel (Figs. 1 & 2, element 11; Spec. ¶¶ 23, 25); and

an electropositive metal attached to the marine seismic equipment to repel sharks from the marine seismic equipment (Spec. ¶¶ 10, 19–23).

For further guidance, *see* MPEP § 1205.02(iii) (<https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e123366.html>).

IV. ARGUMENT

- **Introduction**

This section should include your arguments for why the Examiner's decision to reject the claims is improper, and should be reversed. Before drafting this section, you may want to consider some preliminary matters:

- Which rejection(s) and claim(s) to address? In deciding which grounds of rejection to address and which claims to argue for each ground of rejection, you may find it helpful to review the history and facts of the case, and research the law. You do not have to address all rejections or pending claims. But, keep in mind that any arguments not presented will not be considered by the PTAB, and cannot be presented later, for example, in a Reply Brief.
- Which arguments are the strongest? As a general rule, you should consider highlighting your strongest arguments by presenting those arguments first. Weaker arguments can sometimes distract from stronger arguments, so consider whether the weaker arguments are really needed. But again, keep in mind that any arguments that you decide not to include in the Appeal Brief cannot be presented later.

- **Suggested Format**

Each ground of rejection that you decide to address should be argued under a separate heading that identifies the ground of rejection, e.g., by claim number(s), statutory basis, and applied reference(s), if any. *See* MPEP § 1205(c)(1)(iv). Claims, subject to the same ground of rejection, may be argued individually (i.e., separately), as a group, or as several subgroups. For example, if you plan to present the same argument(s) for two or more claims that are subject to the same ground of rejection, consider arguing those claims as a group under a single heading or sub-heading rather than repeating the same argument multiple times.

Example:

A. *Whether claims 1–3 are unpatentable under 35 U.S.C. § 103 over Iranpour (U.S. Patent No. 7,974,151) in view of Stroud (US 2007/0256623 A1)*

Claim 1 is patentable over the combination of Iranpour and Stroud because

Claims 2 and 3 are patentable for the same reasons presented for claim 1.

On the other hand, if the arguments that you plan to present are not the same for all the claims, for example, if you have additional arguments for one of the claims, consider arguing that claim separately under a separate sub-heading. As a general rule, the best practice is to use a separate sub-heading for each claim that you want the PTAB to consider individually.

Example:

A. *Whether claims 1, 2, and 3 are unpatentable under 35 U.S.C. § 103 over Stroud and Iranpour*

1. Claims 1 and 2

Claim 1 is patentable over the combination of Iranpour and Stroud because Claim 2 is patentable for the same reasons presented for claim 1.

2. Claim 3

Claim 3 is patentable over the combination of Iranpour and Stroud because

• **Contents**

The term “rejection” is used when an examiner does not allow a pending claim. The rejection may be based on the pending claim’s failure to satisfy statutory requirements such as those required under 35 U.S.C. § 101 (patent ineligibility or lack of utility), 35 U.S.C. § 102 (lack of novelty), 35 U.S.C. § 103 (the claimed invention is obvious), and/or 35 U.S.C. § 112 (inadequate disclosure). *See* MPEP § 2103 (“Patent Examination Process”). An appellant may appeal the examiner’s rejection(s) for the Board’s review.¹

The initial burden of proof rests with the examiner to support a rejection by clearly stating the reasons for the rejection. This is commonly referred to as the burden on the examiner to establish a “prima facie” case. For example, if a claim is rejected as obvious over a combination of references, the examiner has the burden of showing that a person of ordinary skill in the art at the time of your invention would have had an apparent

¹ Generally, the Board will not consider matters that are left to an examiner’s discretion, e.g., objections, restriction requirements, refusals to enter an amendment; those matters may be reviewed only by filing a petition to the Director of the USPTO. Therefore, you should limit your arguments in the Appeal Brief to claim rejections.

reason to combine the references, as the examiner proposes, to arrive at your claimed invention. Only after the examiner satisfies this burden, does the burden shift to you, the appellant, to show that the rejection is improper.

For each ground of rejection that you decide to address, you should explain in clear terms why you believe the examiner has made an error. For example, you may wish to point out that the examiner has:

(1) misunderstood the invention or claims; (2) misunderstood the cited prior art; and/or (3) misunderstood the law or legal basis for the rejection. To be persuasive, you should always give reasons to support your position. It is not persuasive to state only that the examiner erred without offering an explanation why.

Depending on the facts of your case, there is a wide variety of arguments that, you, as an appellant, may set forth in challenging the rejections of your claims. The most frequent grounds of rejection are under 35 U.S.C. §§ 102 and 103, and are based on unpatentability in view of the prior art. The question under § 102 is whether the claimed invention is novel, i.e., new; the inquiry under § 103 is whether the claimed invention would have been obvious in view of the cited prior art to a person of ordinary skill in the art at the time of the claimed invention.

Continuing with this example, to challenge a rejection under 35 U.S.C. § 102 or § 103, you might argue that the examiner has misunderstood or mischaracterized your claimed invention or interpreted your claim(s) incorrectly.

During prosecution, claim terms are given their “broadest reasonable interpretation” consistent with the specification, and the claim language should be read in light of the specification as it would be understood by a person of ordinary skill in the art. If you believe that the examiner has

mischaracterized your invention, e.g., that the examiner's characterization of the claimed invention is inconsistent with your specification, or that the examiner has misinterpreted a particular claim term, you should point to evidence (e.g., the specification, dictionary definitions) to demonstrate that a person of ordinary skill in the art would have understood the claimed invention and/or interpreted the disputed claim term consistent with your interpretation. You also should explain why the examiner's contrary interpretation is inconsistent with the specification or is overly broad and/or unreasonable.

Example:

A person of ordinary skill in the art would understand from the specification [identify specific portions of the specification] that claim limitation X means . . . The examiner's interpretation of claim limitation X is improper because

Separately, you may argue that the rejection is based on the examiner's misinterpretation or mischaracterization of the teaching of a prior art reference. In that instance, you should explain why the examiner's understanding of the reference is incorrect, specifically, why the cited reference does not disclose or suggest the claim element or why the examiner erred in finding otherwise.

Example:

Iranpour does not disclose or suggest , as recited in claim because

Where appropriate, you may consider using annotated drawings to explain the difference(s) between the claimed invention and the cited prior art. This can make it easier for the PTAB to understand the differences between the claimed invention and the cited references.

You also may consider directing the PTAB’s attention to particular evidence (e.g., affidavits or declarations) in the record that supports your argument that the examiner made an error. However, any such evidence must have been before the examiner during prosecution; otherwise, it will not be considered by the PTAB.

Example 1:

The Examiner’s interpretation of is overly broad and unreasonable. As X explains in his declaration, a person of ordinary skill in the art at the time of Appellant’s invention would have understood to mean . . . because

Example 2:

The rejection under 35 U.S.C. § 103 is improper because, as X explains in her declaration, a person of ordinary skill in the art, at the time of Appellant’s invention, would not have combined Iranpour and Stroud because

Additionally, an error may involve an examiner’s misunderstanding or misapplication of the law. For example, to establish a prima facie of obviousness, the examiner must explain why a person of ordinary skill in the art would have had an apparent reason to combine the references, as the examiner proposes, to arrive at your claimed invention. The examiner’s analysis must be explicit and cannot consist of merely conclusory statements.

The suggestion to combine references in an obviousness rejection also cannot be based on knowledge of your claimed invention. As such, it is improper, in determining whether a person of ordinary skill in the art would have combined the cited references, as the examiner proposes, simply to rely on knowledge gained from your disclosure. In other words, an examiner may not use the disclosure in your application as a “blueprint” to reconstruct

your claimed invention by piecing together features of the prior art. Using your disclosure in this way is commonly referred to as the use of impermissible “hindsight,” which is not allowed.

Example 1:

The Examiner has not established a prima facie case of obviousness because the Examiner has not set forth sufficient reasoning to combine Iranpour and Stroud.

Example 2:

The Examiner’s basis for the combination of Stroud and Iranpour is improper because

Example 3:

A person of ordinary skill in the art would not have combined Iranpour and Stroud, as the Examiner proposes, absent knowledge of the claimed invention, because

Additionally, if the examiner has cited cases, consider whether each case supports the proposition for which it is cited, and if not, point out the error(s) in the examiner’s application. If you are aware of case law, i.e., a previous decision by the PTAB or a federal court, that supports your position, explain how the particular case applies to the facts of your case, and requires that the PTAB rule in your favor.

Example 1:

The Examiner misapplied the obviousness standard established in Case X because

Example 2:

Properly applied, Case Y supports Appellant’s position because

V. CONCLUSION

This section is not required, but it may be helpful to summarize your overall position(s). If included, you should explain the particular decision that you want the PTAB to make—normally, reversal of the final rejection and allowance of the pending claim(s).

Example:

In light of the foregoing, Appellant requests that the final rejection of the pending claim be reversed, and the application be remanded for allowance of the pending claim.

Date: [Date]

[Signature Block]

CLAIMS APPENDIX

This appendix must include all claims involved in the appeal. Claims that are, for example, canceled or withdrawn from consideration should not be presented in this section if they are not involved in the appeal. If an appellant wishes to remove certain claims from consideration on appeal, the appellant must submit an amendment to cancel the claims from the application. *See* 37 CFR §§ 41.31(c), 41.33.

The claims as provided in this appendix should (1) be clean, with no brackets or underlining indicating prior amendments, (2) be double-spaced, and (3) start on a new page.

For further guidance, see MPEP § 1205.02(v) (<https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e123366.html>).

The claims appendix should not reference any non-admitted amendment (i.e., proposed changes to the claims not allowed by the examiner). If an appellant wishes to seek review of an examiner's refusal to admit an amendment, affidavit or evidence, such review is by petition to the Director. For further guidance, see 37 CFR § 1.181.

Example:

1. A system for protecting towed marine seismic equipment from shark bite, comprising:

marine seismic equipment, towed through a body of water by a marine vessel; and

an electropositive metal attached to the marine seismic equipment to repel sharks from the marine seismic equipment.

2. The system of claim 1, wherein the marine seismic equipment comprises marine seismic streamers.

3. The system of claim 1, wherein the marine seismic equipment comprises marine seismic sources.