

Effective Use of Claim Grouping in Appeals to the Patent Trial and Appeal Board

When transitioning from examination to appeal, an appellant moves from negotiating patentable claims to resolving disputed patentability issues. The appeal brief normally is the Board's first exposure to an appellant's case, and it is the appellant's first opportunity to persuade the panel to rule in its favor. Therefore, an appellant should take care to craft a clear and persuasive brief that quickly educates the Board panel about the issues and technology, and focuses on appellant's strongest arguments, while avoiding the introduction of any new issues.

Every claim in an application, as a general matter, is considered a separate invention. The failure of an appellant to argue separately claims subject to the same ground of rejection, however, is deemed a waiver of any argument that the claims are entitled to separate consideration. *See* 37 C.F.R. § 41.37(c)(1)(iv). On the other hand, grouping claims to consolidate and simplify the issues for appeal is among the most powerful tools in an appellant's arsenal and, when used properly, can provide significant advantages. This article offers a number of tips and practical pointers for getting the most from this powerful tool.

Strategically identify the issues for review. Critical to the success of any appeal is the ability of the appellant to identify “winnable” issues that are dispositive of the appeal. The appellant decides which, and how many, issues to present on appeal. A “shotgun” approach, rarely, if ever, is advisable, and, in fact, may dilute detrimentally the impact of each issue presented. Almost invariably, one or two issues, if successful, can dispose of the appeal – many of the remaining issues are only tangential.

As a rule of thumb, an appellant should assess, for each issue being considered, whether, if that issue were the only issue decided in its favor, the appellant would cancel the remaining claims decided unfavorably and present the application to the Examiner for issue.

Group claims by issues in common. Once the issues to be presented for review are identified, the rejections and associated claims that turn on each issue can be identified and grouped to create a subset of claims, where the disposition of the rejection of each claim of the subset depends on the same set of issues. Rule 41.37(c)(1)(iv) directs that separate headings must be used for each ground of rejection argued separately, and that separate subheadings must be used for each claim or claim group argued separately within each ground of rejection. These headings are signals that the Board is to consider the patentability of the claim or group of claims separately. The rule purposefully requires the use of separate headings for each ground of rejection argued separately to avoid inappropriate conflating of different grounds of rejection, such as arose in *In re McDaniel*, 293 F.3d 1379 (Fed. Cir. 2002) and *Hyatt v. Dudas*, 551 F.3d 1307 (Fed. Cir. 2008).¹

¹ In *McDaniel*, the Federal Circuit concluded that claims rejected under 35 U.S.C. § 103 were not properly treated as a commonly rejected group where the examiner's rejection of the three non-representative claims in the group was based on a combination of references different from the combination of references cited against the chosen representative claim. *McDaniel*, 293 F.3d at 1384.

Similarly, in *Hyatt*, the Federal Circuit held that claims rejected for lack of written description do not share a common "ground of rejection" that would allow the Board to consider the group on the basis of a single representative claim, unless the claims share a common limitation that is asserted as lacking written description support. *Hyatt*, 551 F.3d at 1313.

Apart from signaling to the Board exactly which claims and/or claim groups are being argued, adhering to the requirements for headings to identify grounds of rejection and claim groupings, as set forth in Rule 41.37(c)(1)(iv), makes it less likely that an appellant will unintentionally neglect to argue a rejection. And, the rule beneficially focuses the appellant on finding issue commonality among the outstanding rejections.

Most issues pertain to specific claim limitations. A claim rejected for lack of enablement or insufficient written description is, thus, advantageously grouped with other claims that include the same limitation found to lack an enabling disclosure or written description support in the specification. Likewise, claims subject to indefiniteness rejections are best grouped with other claims that share the limitation rejected as indefinite; claims subject to prior art rejections are best grouped based on common recitations that the appellant maintains are not found and/or suggested in the cited references; and claims subject to statutory subject matter rejections are best grouped by common recitations that support patent-eligibility, utility, or non-membership in a judicially excluded class.

The disposition of some claims may turn on issues that are not directly related to claim recitations, such as those involving arguments of non-analogous art, the lack of an apparent reason for combining the cited references, and/or objective evidence of non-obviousness. Nonetheless, these claims often will fall naturally into a proper group based on the claim recitations. Generally, this will be the group that shares the same art and statutory basis on which the claim was rejected.

Consider whether claims within each group present additional, separate issues. Once a subset of claims having common issues is

identified, it is important to consider whether there are claims, within this subset, which also involve other different issues that should be presented for review.

This may arise, for example, in cases with numerous dependent claims subject to the same ground of rejection. The best course is to identify a core set of dispositive issues for all of the claims and then group the claims subject to the same ground of rejection together under a single representative claim. However, if more than a single representative claim is required, each of these additional claims or sub-groups of claims should be presented and argued under a separate sub-heading. Claims presented under a single heading may be decided as a group, according to the heading, even if the appellant discusses claims separately within that group.

As a corollary, it is important to include, in each group, every claim that turns on the issues in that group. This means looking for claims with similar recitations that may not be near each other in numerical order. Otherwise, an appellant may risk having the panel decide an issue in the appellant's favor, and yet omit any reference to a claim, whose disposition turns on that same issue, because the claim was not identified as part of the group.

Exercise caution when grouping claims with differing scope.

A word of caution—claims may best be argued separately where the claims are phrased similarly, but with some deliberate grammatical or additional term difference to distinguish scope. In those cases, it is important to discuss the implications of the grammatical differences. Simply reciting a claim limitation, and asserting that the limitation is not found in the prior art, is not taken as a separate argument for patentability. *See In re Lovin*, 652

F.3d 1349, 1357 (Fed. Cir. 2011) (holding that the Board reasonably interpreted 37 C.F.R. § 41.37(c)(1)(vii) (2007) as requiring “more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art”).

The brief should not say that the claims stand or fall together when the argument is limited to one narrow claim within the group and does not apply to other broader claims within the group. In that instance, the argument will only apply to the one narrow claim and the rejection of the other broader claims will be affirmed.

Claims with means-plus-function limitations may best be argued separately. A special case where a claim may best be argued separately is where the claim includes means-plus-function limitations. Pursuant to 35 U.S.C. § 112(f), a claim element drafted in means-plus-function format is properly construed to cover “the corresponding structure, material, or acts described in the specification and equivalents thereof.” *Id.* By grouping claims that include means-plus-function limitations with claims that do not include such limitations, an appellant may be viewed as having waived arguments that the means-plus-function limitations, when construed in accordance with 35 U.S.C. § 112(f), render the claim patentable over the prior art.

Avoid unnecessary repetition when separate arguments are presented. Unlike in examination, a decision on appeal is made based solely on the arguments raised in the briefs. Filing an appeal to the Board does not entitle an appellant to de novo review of all aspects of a rejection. Thus, each ground of rejection of a claim must be argued. The failure to

argue a rejection results in summary affirmance of that rejection. *See Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (“If an appellant fails to present arguments on a particular issue—or, more broadly, on a particular rejection—the Board will not, as a general matter, unilaterally review those uncontested aspects of the rejection”).

That said, although rejections must be argued separately, some issues may be in common across the different grounds of rejection. Thus, rather than repeating verbatim or paraphrasing arguments made earlier for a different ground of rejection, an appellant can save its own time, as well as the panel’s, by simply referencing the earlier arguments.

Every case is different and every brief is different. There is no comprehensive blueprint for writing a persuasive brief. Yet, following these tips will produce shorter, more sharply focused briefs that are helpful to the Board. Presented with a well-organized and focused brief, the Board is more likely to be persuaded that the Examiner erred, that there is something that readily can be done to place the application in condition for allowance, or that there is some fundamental disconnect between the Examiner and the appellant that the Board perhaps can resolve. Any one of these alternatives benefits the appellant in moving forward.