Appeals Roadshow

Patent Trial and Appeal Board

2023

uspto UNITED STATES PATENT AND TRADEMARK OFFICE ®

Agenda

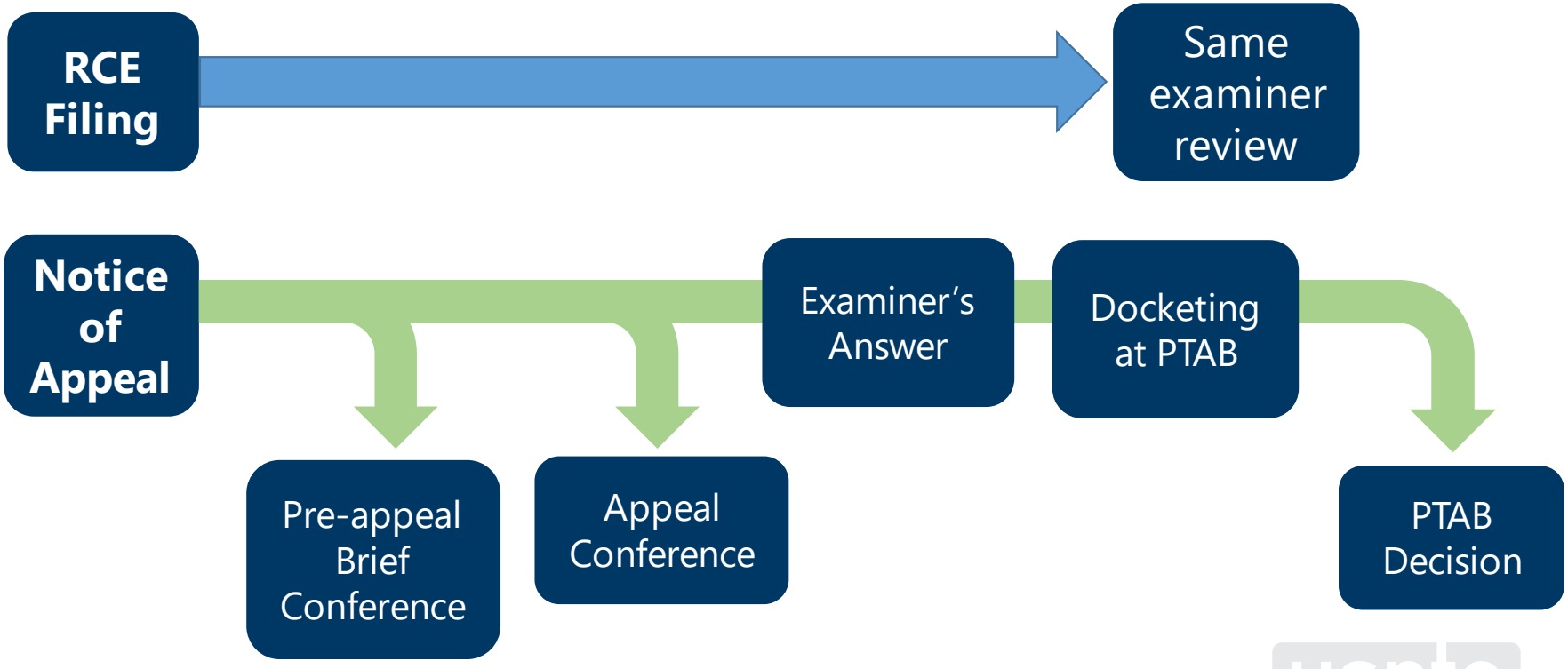
- Fireside Chat with Chief Judge
- Panel 1: Filing the Appeal
  - Options after final rejection
  - Steps in an appeal
- Panel 2: Written appeal advocacy
  - Effective advocacy in an appeal brief
  - Navigating an examiner's answer and reply brief
- Panel 3: Oral appeal advocacy
  - Oral hearing preparation
  - Mock oral argument
  - Options after a Board decision
- Panel 4: Practice Makes Perfect
  - Exercise
  - Other resources

Fireside Chat

Filing the appeal

Options after final rejection

Steps in review process



Appeals v. RCEs: considerations

- Decision makers;
- Scope of evidence and arguments;
- Timing;
- Costs;
- Outcomes; and
- Other

Decision makers

- **RCEs**
  - Typically, same Examiner continues examination after entry of responsive submission accompanying the RCE
- **Appeals to PTAB**
  - Pre-Appeal Brief Conference Pilot Program: An optional review by a three-examiner panel (including supervisor and examiner of record) that may be requested with filing of Notice of Appeal
  - Appeal Conference: A review by a three-examiner conference (that includes the supervisor and examiner of record) after Appeal Brief
  - Decision: After docketing at PTAB, typically decided by three administrative patent judges (APJs)

Scope of evidence and arguments

- **RCEs**
  - Can present new evidence, new arguments, and certain new claim amendments
  - Can request an examiner interview
- **Appeals to PTAB**
  - New evidence and claim amendments are limited after filing an appeal
  - Appellant generally may only rely on a new argument in the appeal brief but not in a reply brief (unless a new ground of rejection in the answer)
  - Can request an oral hearing

Timing*

- **RCEs**
  - Currently Examiner responds to RCE in about 1.8 months
- **Appeals to PTAB**
  - PTAB issues a decision on appeal, on average, about 12 months after the appeal forwarding fee is paid
  - Fast track appeals available upon request with payment of petition fee
    - Decision on appeal issued within 6 months of petition (currently under 2 months)

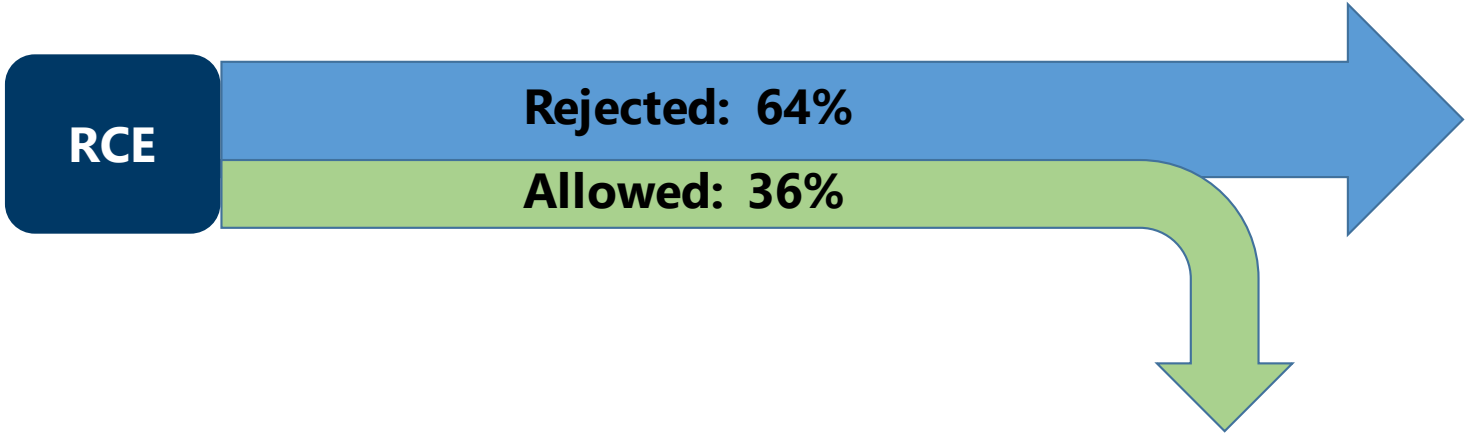
*Timing reflects amount of time for decision maker to take action

Costs*

- **RCEs**
  - 1st request: $1,360
  - 2nd and subsequent requests: $2,000
  - Costs to prepare response to final rejection
- **Appeals to PTAB**
  - Notice of appeal fee: $840
    - This fee covers three considerations from the PTO: pre-appeal conference, the appeal conference, and the examiner's answer
  - Appeal forwarding fee: $2,360
  - Optional Fast-Track Appeals fee: $420
  - Optional request for oral hearing fee: $1,360
  - Costs to prepare appeal brief and reply brief

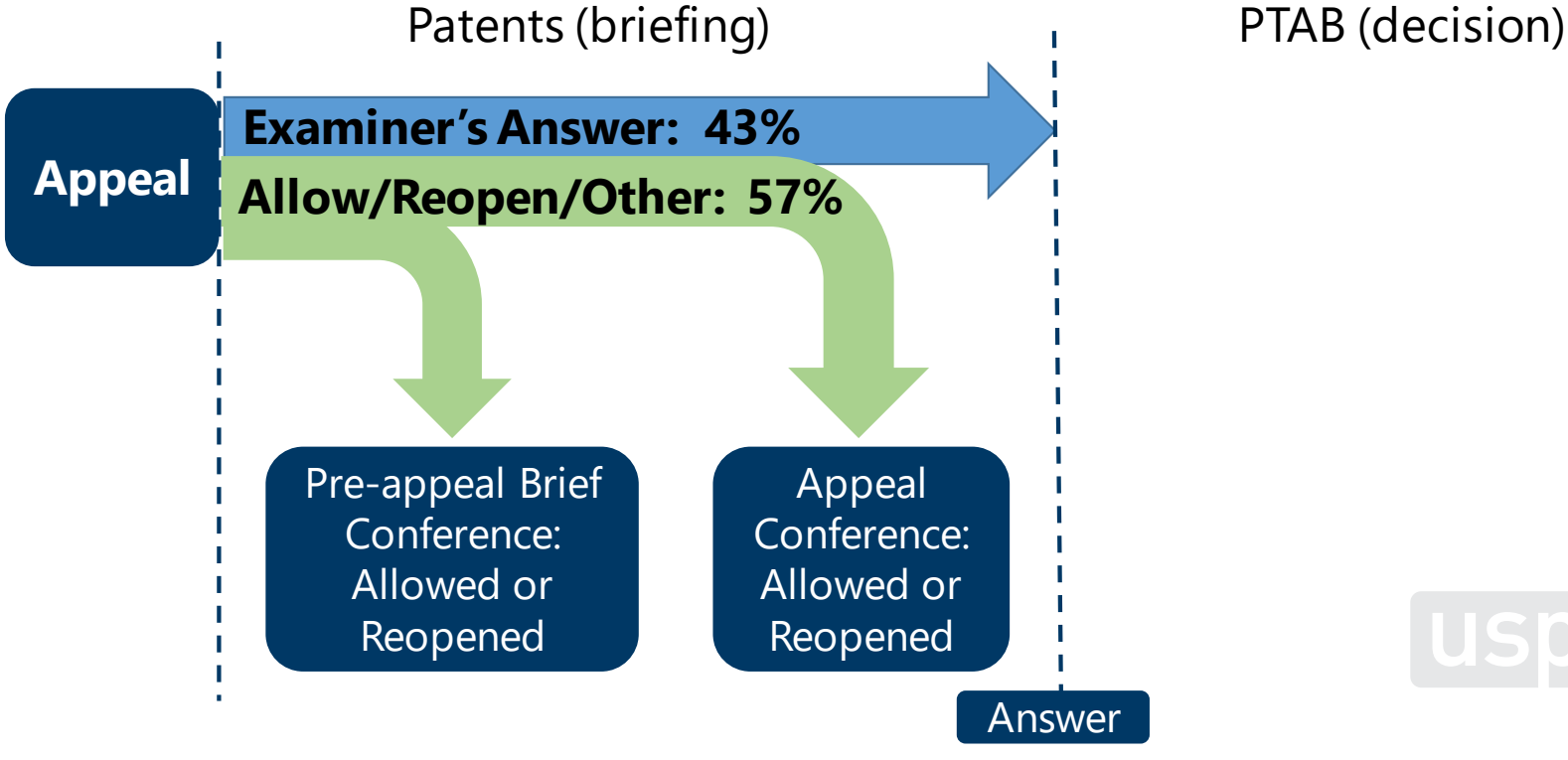
*fees shown as undiscounted, large entity cost;
small entity is 50% discount; micro entity is 75% discount (except Fast-Track fee

Next action after RCE



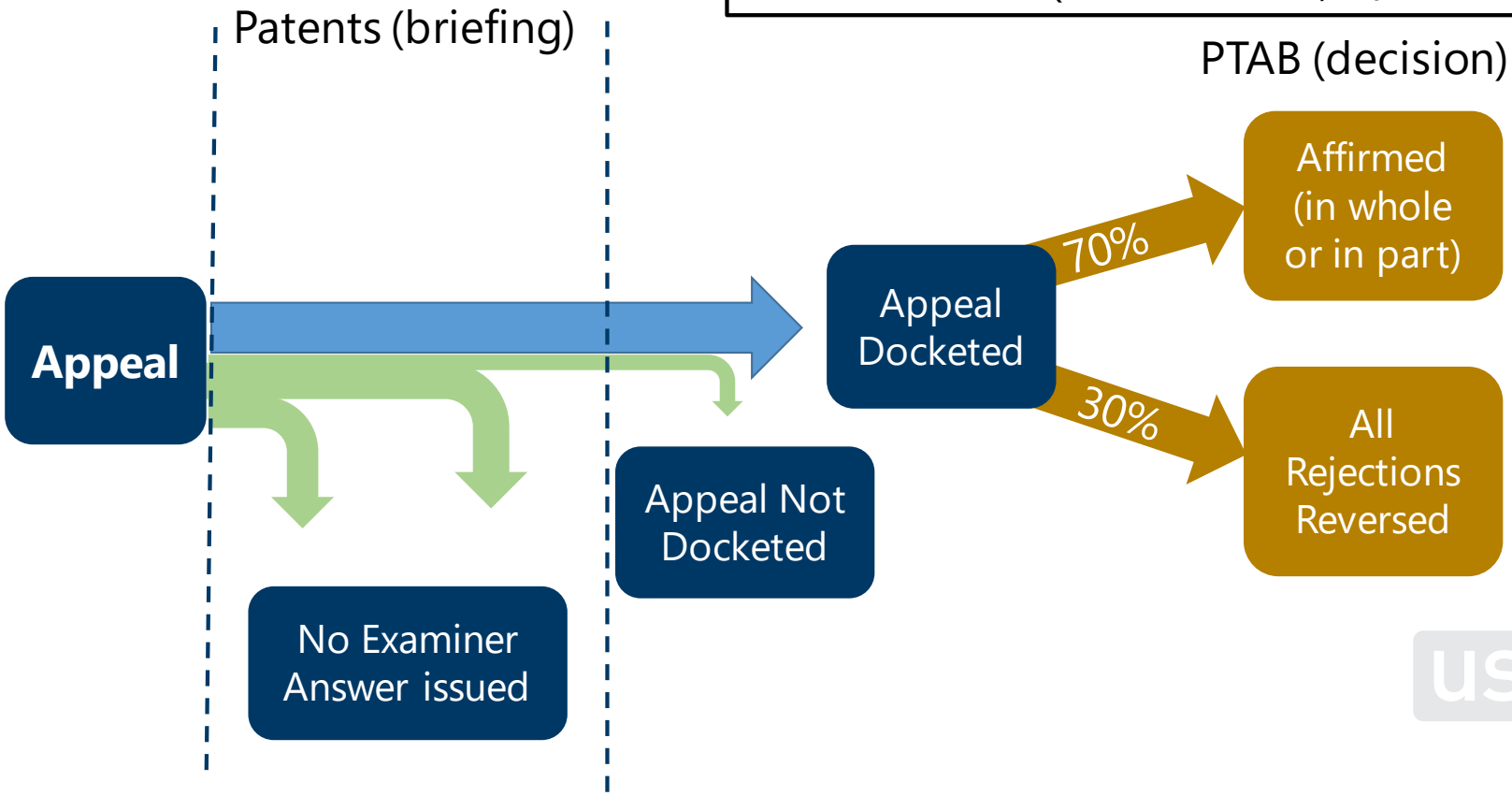
Appeal: Pre-Board Reviews

Only 43% of Appeals result in an Examiner's Answer (FY 2010-2020, +/-3%)

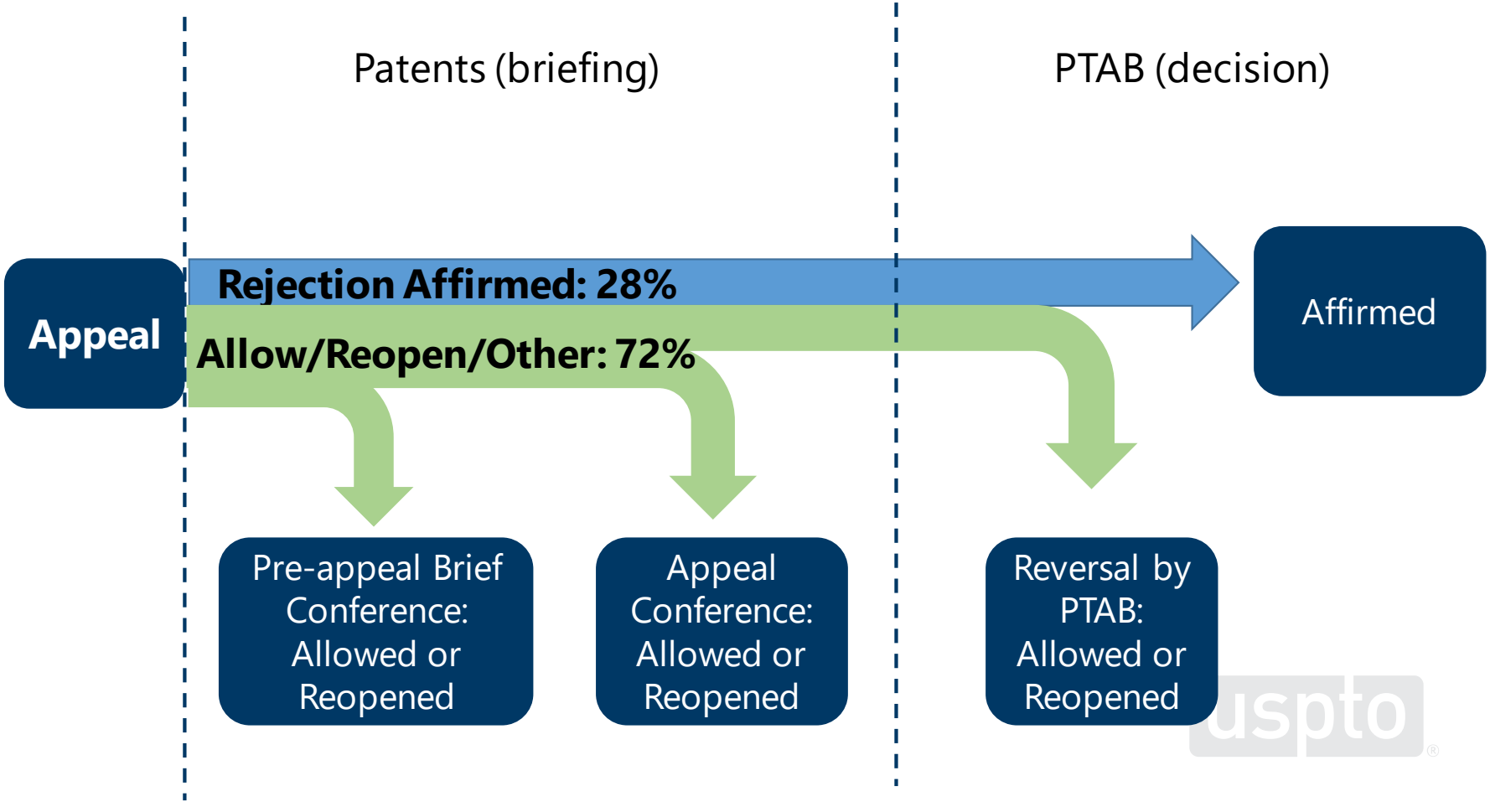


Appeals: PTAB Decision

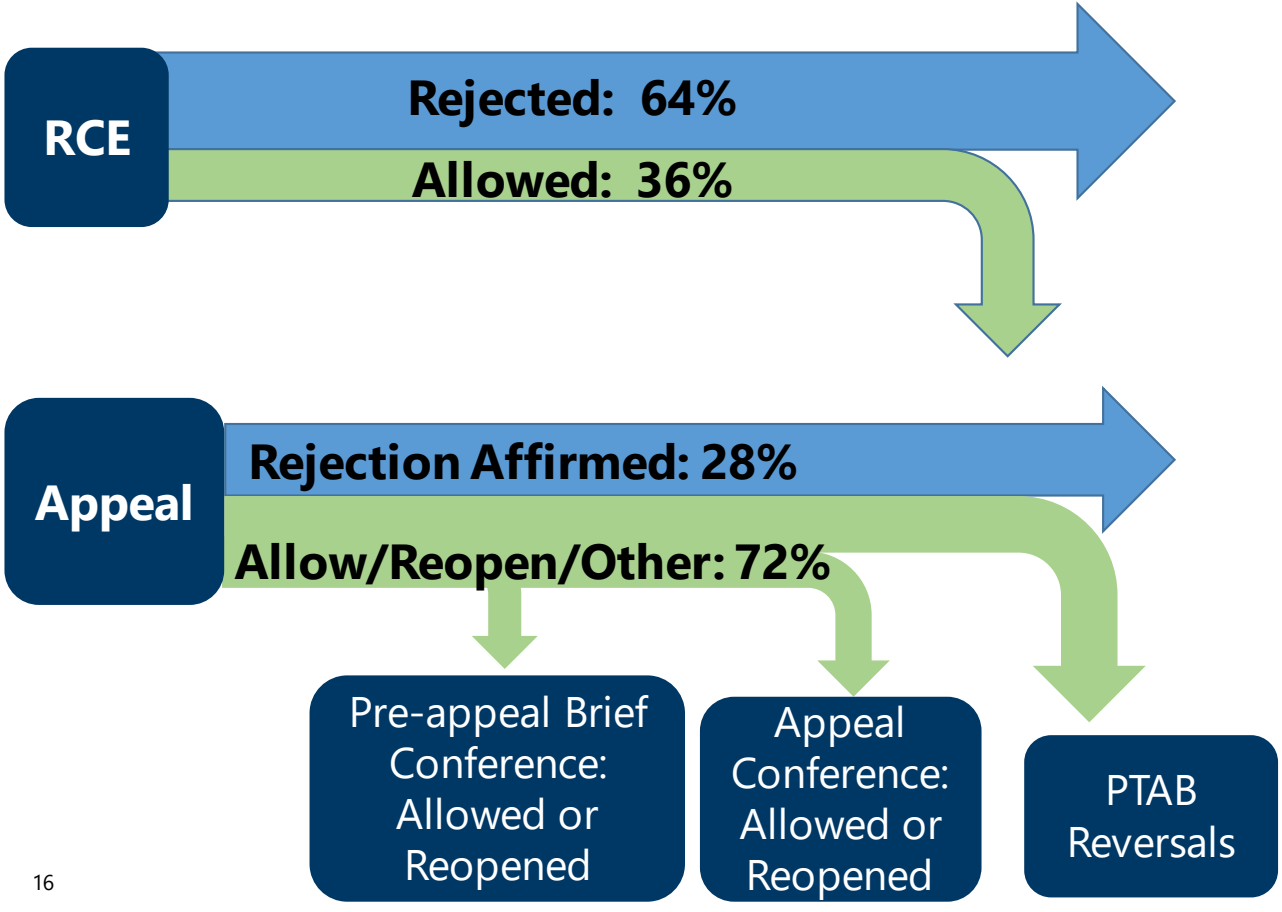
30% of docketed Appeals are fully reversed at PTAB (FY2016-2022, +/- 3.5%)



Overall Outcome after Appeal



Summary


RCE
Rejected: 64%
Allowed: 36%
Appeal
Rejection Affirmed: 28%
Allow/Reopen/Other: 72%
Pre-appeal Brief Conference: Allowed or Reopened
Appeal Conference: Allowed or Reopened
PTAB Reversals

Other benefits of an appeal

- Unlike for RCE, for a reversal, receive patent term adjustment for entire appeal period
- May take additional issues off the table in a post grant challenge

Takeaways

The facts of the case are the best guide to selecting how to proceed after final rejection.

- Same examiner for RCE versus multiple fresh reviewers for PTAB Appeal
- Viable amendment or new evidence allowed in RCE
- Timeframe
  - RCE is ~1.8 months
  - Appeal to PTAB ~12 months after forwarding fee paid.
  - Can be 2 months or less with Fast-Track.
- Cost
  - Appeals are marginally more expensive compared to RCE
  - Appeal fees: lower upfront cost provides for full briefing
  - Issues may be resolved quickly during briefing for Appeal

Steps in an appeal

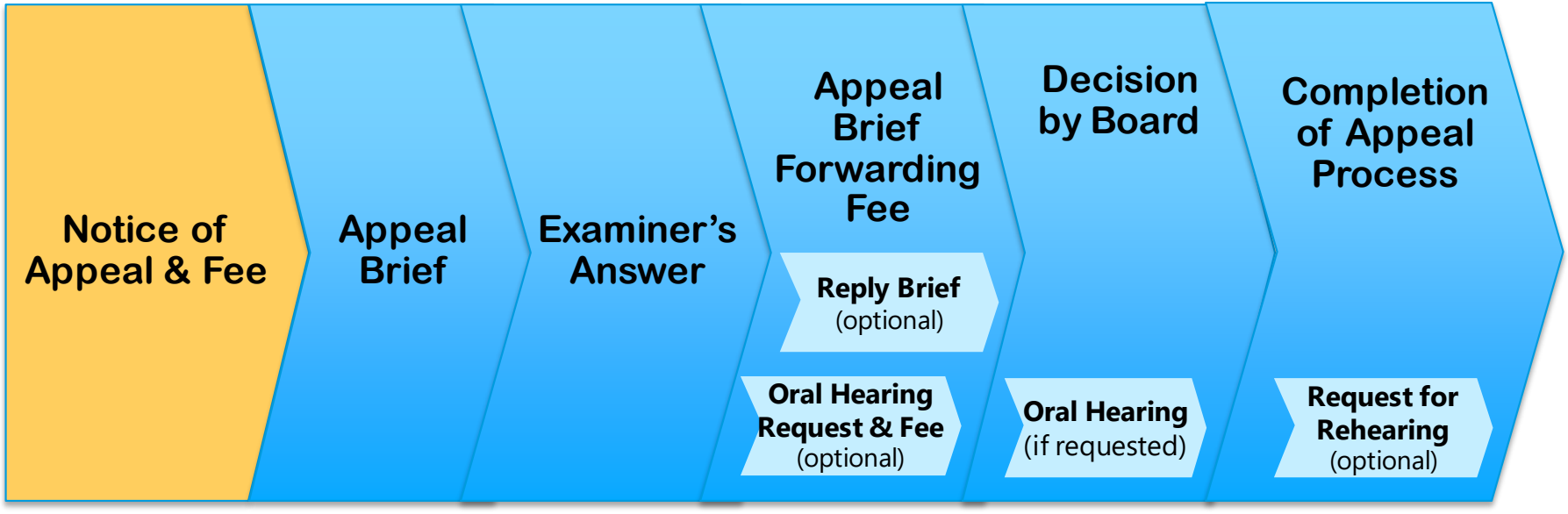
Adverse decision of the examiner

- Application must be twice rejected
  - The Office Action does not have to be final

- Office Action defines the Examiner's position on appeal

Source: 35 U.S.C. § 134; 37 C.F.R. § § 41.31; MPEP § 1204.

Ex parte appeal process

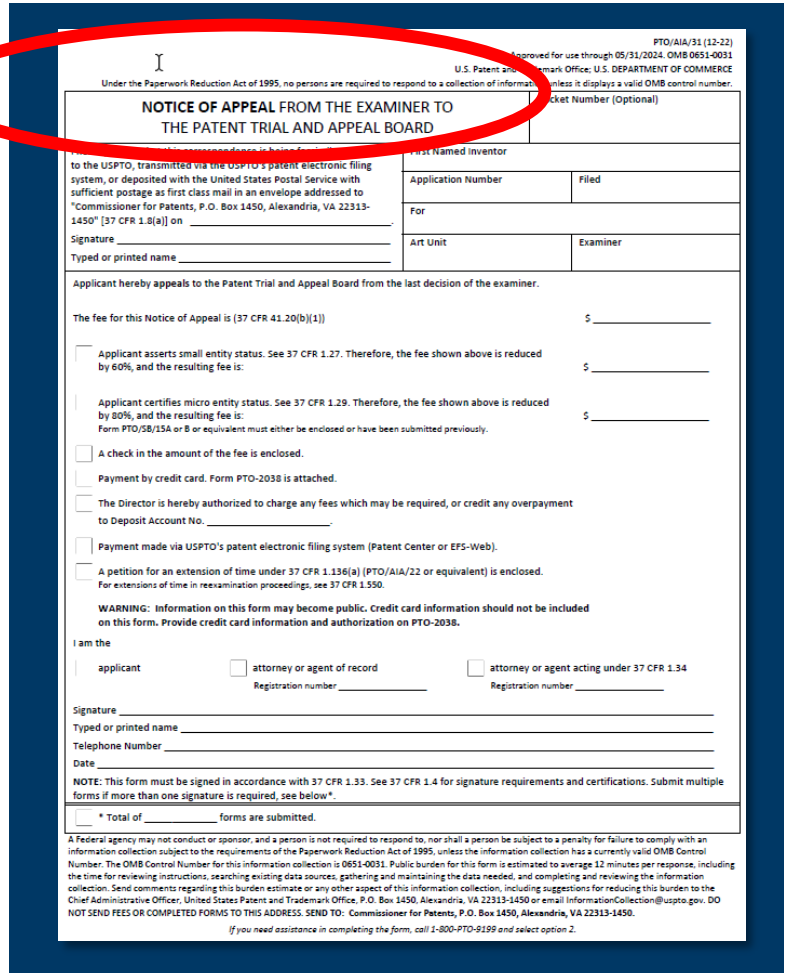


Notice of Appeal

- You must give notice that you intend to appeal from the Examiner's decision *and* pay an appeal fee
- Notice and payment due 3 months after the mailing date of the Examiner's decision you're appealing, e.g., Final Office Action
  - This time period is extendable for 3 additional months, so you can file a Notice of Appeal with payment of the appeal fee as late as 6 months after the Examiner's decision

Source: 35 U.S.C. § 41(a)(6)(A); 37 C.F.R. § 41.31(a); MPEP § 1204.

Notice of Appeal form



PTO/AIA/31 (12-22)

Approved for use through 05/31/2024. OMB 0651-0031

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Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

NOTICE OF APPEAL FROM THE EXAMINER TO THE PATENT TRIAL AND APPEAL BOARD

Docket Number (Optional)

First Named Inventor

Application Number | Filed

For

Art Unit | Examiner

I hereby certify that this correspondence is being [illegible] to the USPTO, transmitted via the USPTO's patent electronic filing system, or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____.

Signature _____

Typed or printed name _____

Applicant hereby appeals to the Patent Trial and Appeal Board from the last decision of the examiner.

The fee for this Notice of Appeal is (37 CFR 41.20(b)(1)) $ _____

☐ Applicant asserts small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by 60%, and the resulting fee is: $ _____

☐ Applicant certifies micro entity status. See 37 CFR 1.29. Therefore, the fee shown above is reduced by 80%, and the resulting fee is: $ _____
Form PTO/SB/15A or B or equivalent must either be enclosed or have been submitted previously.

☐ A check in the amount of the fee is enclosed.

☐ Payment by credit card. Form PTO-2038 is attached.

☐ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. _____.

☐ Payment made via USPTO's patent electronic filing system (Patent Center or EFS-Web).

☐ A petition for an extension of time under 37 CFR 1.136(a) (PTO/AIA/22 or equivalent) is enclosed.
For extensions of time in reexamination proceedings, see 37 CFR 1.550.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

I am the

☐ applicant ☐ attorney or agent of record Registration number _____ ☐ attorney or agent acting under 37 CFR 1.34 Registration number _____

Signature _____

Typed or printed name _____

Telephone Number _____

Date _____

NOTE: This form must be signed in accordance with 37 CFR 1.33. See 37 CFR 1.4 for signature requirements and certifications. Submit multiple forms if more than one signature is required, see below*.

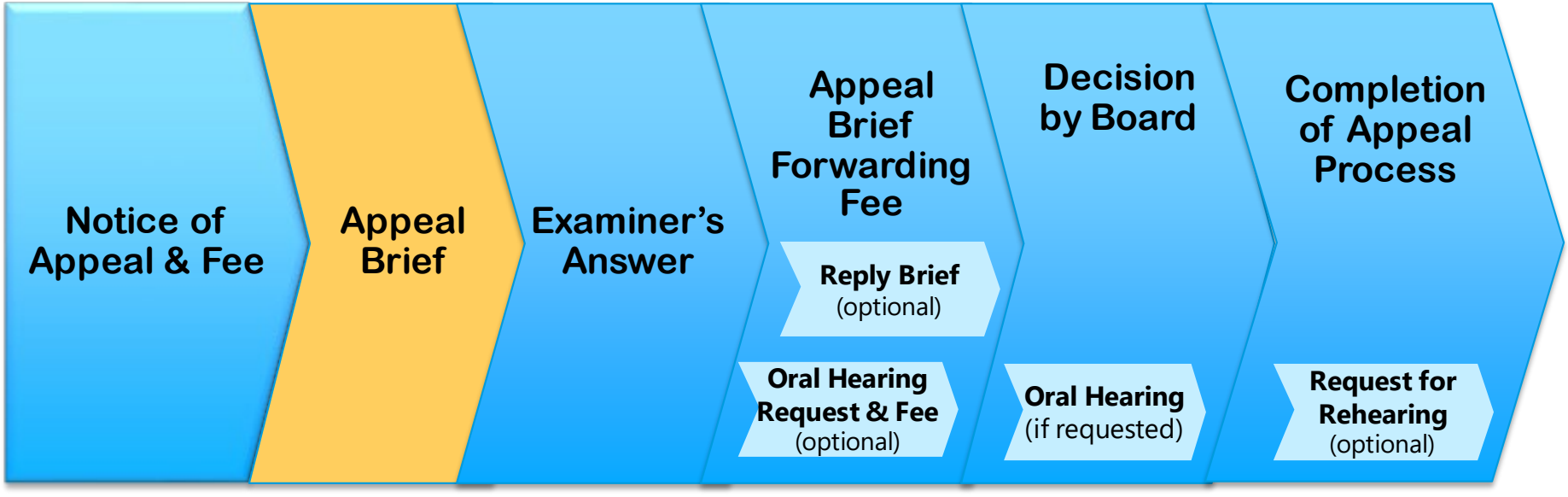
☐ * Total of _____ forms are submitted.

A Federal agency may not conduct or sponsor, and a person is not required to respond to, nor shall a person be subject to a penalty for failure to comply with an information collection subject to the requirements of the Paperwork Reduction Act of 1995, unless the information collection has a currently valid OMB Control Number. The OMB Control Number for this information collection is 0651-0031. Public burden for this form is estimated to average 12 minutes per response, including the time for reviewing instructions, searching existing data sources, gathering and maintaining the data needed, and completing and reviewing the information collection. Send comments regarding this burden estimate or any other aspect of this information collection, including suggestions for reducing this burden to the Chief Administrative Officer, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450 or email InformationCollection@uspto.gov. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: **Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

- Office provides a fillable form for Notice of Appeal: **https://www.uspto.gov/sites/default/files/documents/aia0031.pdf**

Ex parte appeal process

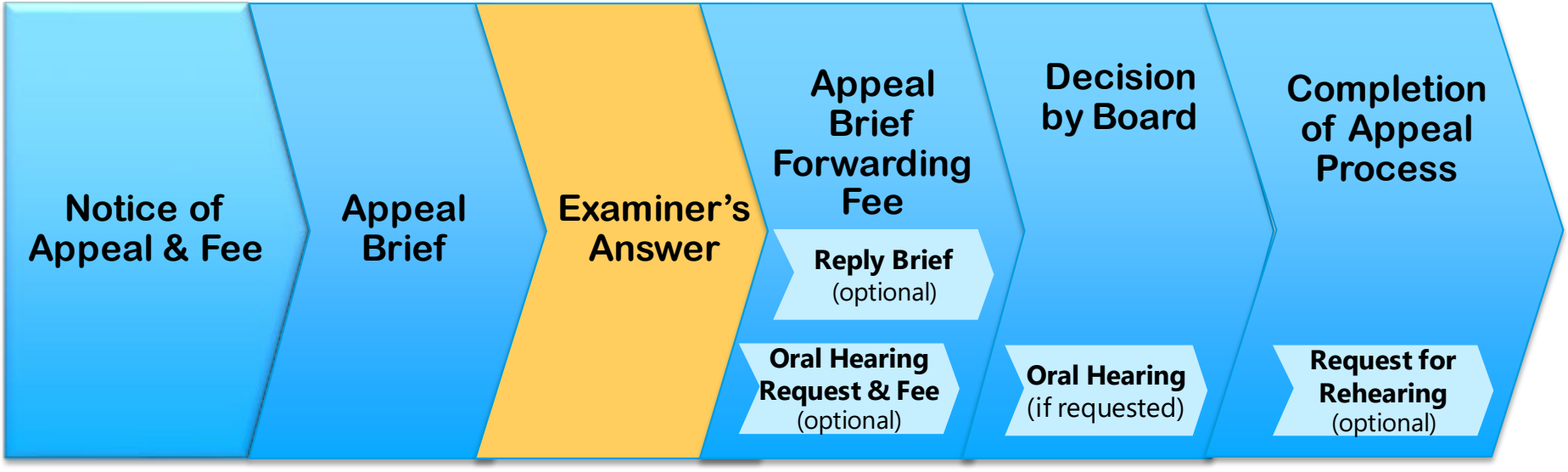


Appeal brief

- No fee due with appeal brief
- Due 2 months after you file the Notice of Appeal
  - This time period is extendable for 5 additional months
- Legal brief (not a form) that includes your arguments and defines the appeal
  - Identifies the issues the judges will consider on appeal
  - The judges generally will not look for additional issues, even issues that would resolve the appeal in your favor
  - If an argument is not raised in the Appeal Brief, it may be waived

Source: 37 C.F.R. § 41.37; MPEP § 1205.

Ex parte appeal process

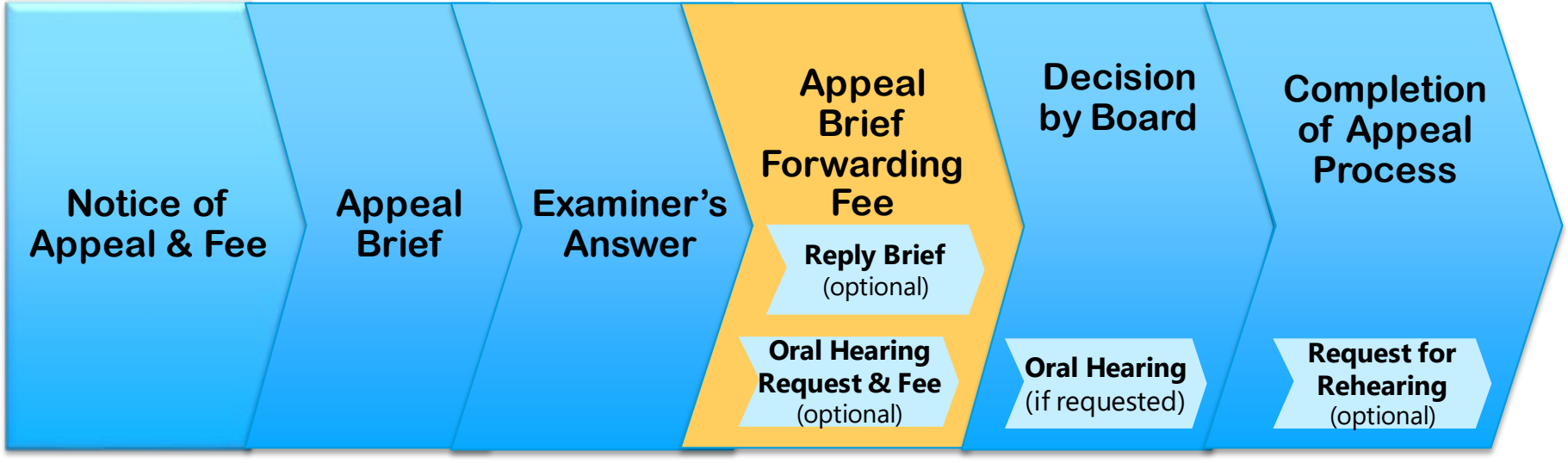


Examiner's Answer

- Examiner will respond to the arguments in the Appeal Brief
- Examiner will consider whether to maintain or modify each rejection
- Includes certain sections
  - Ground(s) of Rejection to Be Reviewed on Appeal
    - Withdrawn Rejection(s)
    - New Ground(s) of Rejection
  - Response to Arguments

Source: 37 C.F.R. § 41.39; MPEP § 1207.

Ex parte appeal process

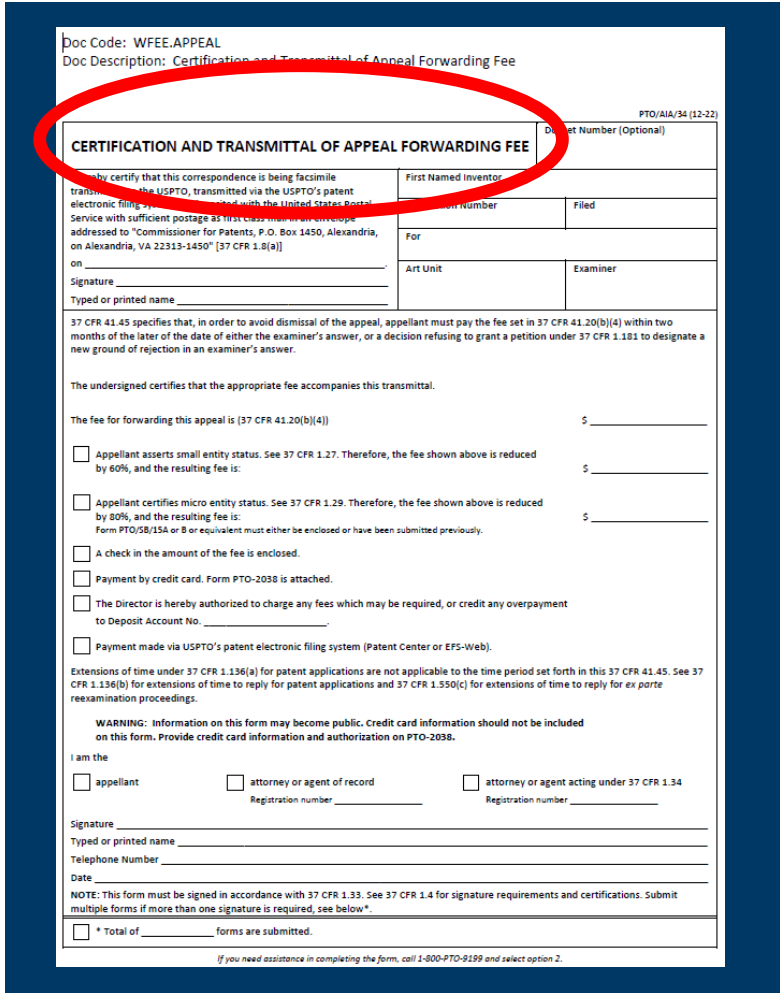


Appeal Forwarding Fee

- Due 2 months after Examiner's Answer – generally NOT EXTENDABLE
- Easy to forget
- May be filed with Reply Brief (optional) and/or request for oral hearing (optional)
  - No additional fee for Reply Brief
  - Request for oral hearing requires payment of an additional fee
  - If you don't file a Reply Brief or request for oral hearing, you still have to pay the appeal forwarding fee

Source: 37 C.F.R. § 41.45; MPEP §§ 1208, 1208.01; 37 CFR 1.136(a) and (b).

Appeal Forwarding Fee form



Doc Code: WFEE.APPEAL
Doc Description: Certification and Transmittal of Appeal Forwarding Fee

PTO/AIA/34 (12-22)

CERTIFICATION AND TRANSMITTAL OF APPEAL FORWARDING FEE

Docket Number (Optional)

I hereby certify that this correspondence is being facsimile transmitted to the USPTO, transmitted via the USPTO's patent electronic filing system, deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, on Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed name _____

First Named Inventor	
Application Number	Filed
For	
Art Unit	Examiner

37 CFR 41.45 specifies that, in order to avoid dismissal of the appeal, appellant must pay the fee set in 37 CFR 41.20(b)(4) within two months of the later of the date of either the examiner's answer, or a decision refusing to grant a petition under 37 CFR 1.181 to designate a new ground of rejection in an examiner's answer.

The undersigned certifies that the appropriate fee accompanies this transmittal.

The fee for forwarding this appeal is (37 CFR 41.20(b)(4)) $ _____

☐ Appellant asserts small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by 60%, and the resulting fee is: $ _____

☐ Appellant certifies micro entity status. See 37 CFR 1.29. Therefore, the fee shown above is reduced by 80%, and the resulting fee is: $ _____
Form PTO/SB/15A or B or equivalent must either be enclosed or have been submitted previously.

☐ A check in the amount of the fee is enclosed.

☐ Payment by credit card. Form PTO-2038 is attached.

☐ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. _____.

☐ Payment made via USPTO's patent electronic filing system (Patent Center or EFS-Web).

Extensions of time under 37 CFR 1.136(a) for patent applications are not applicable to the time period set forth in this 37 CFR 41.45. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for *ex parte* reexamination proceedings.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

I am the

☐ appellant ☐ attorney or agent of record Registration number _____ ☐ attorney or agent acting under 37 CFR 1.34 Registration number _____

Signature _____

Typed or printed name _____

Telephone Number _____

Date _____

NOTE: This form must be signed in accordance with 37 CFR 1.33. See 37 CFR 1.4 for signature requirements and certifications. Submit multiple forms if more than one signature is required, see below*.

☐ * Total of _____ forms are submitted.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

- Office provides a fillable form for submitting payment of the fee: **https://www.uspto.gov/sites/default/files/forms/aia0034.pdf**

Reply Brief

- Optional
- Due 2 months after Examiner's Answer – Generally NOT EXTENDABLE
- Should be submitted at the same time as payment of the appeal forwarding fee
- No additional fee for the Reply Brief

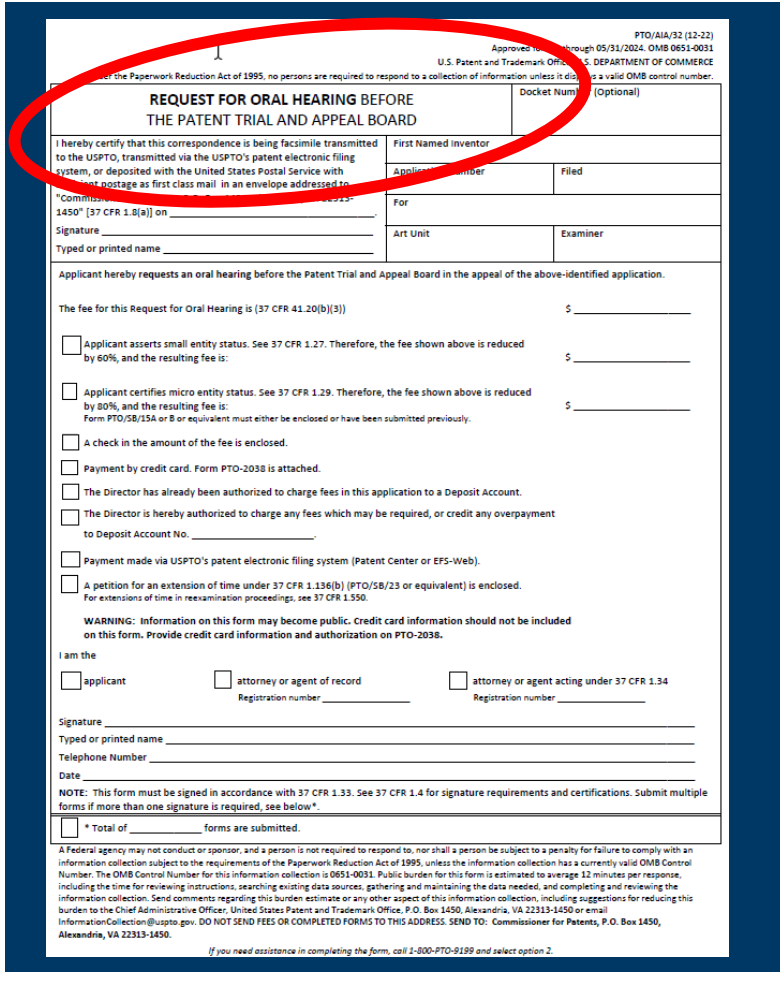
Source: 37 C.F.R. § 41.41; MPEP §§ 1208, 1208.01; 37 CFR 1.136 (a) and (b).

Oral Hearing Request

- Optional
- Due 2 months after Examiner's Answer or on the date of filing a reply brief, whichever is earlier – Generally NOT EXTENDABLE
- Must include payment of a fee

Source: 35 U.S.C. § 41(a)(6)(B); 37 C.F.R. § 41.47; MPEP § 1209; 37 CFR 1.136(a) and (b)

Oral Hearing Request form



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U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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REQUEST FOR ORAL HEARING BEFORE THE PATENT TRIAL AND APPEAL BOARD

Docket Num... (Optional)

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Signature _____

Typed or printed name _____

First Named Inventor

Applic... ...mber | Filed

For

Art Unit | Examiner

Applicant hereby requests an oral hearing before the Patent Trial and Appeal Board in the appeal of the above-identified application.

The fee for this Request for Oral Hearing is (37 CFR 41.20(b)(3)) $ _____

☐ Applicant asserts small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by 60%, and the resulting fee is: $ _____

☐ Applicant certifies micro entity status. See 37 CFR 1.29. Therefore, the fee shown above is reduced by 80%, and the resulting fee is: $ _____
Form PTO/SB/15A or B or equivalent must either be enclosed or have been submitted previously.

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☐ Payment by credit card. Form PTO-2038 is attached.

☐ The Director has already been authorized to charge fees in this application to a Deposit Account.

☐ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. _____.

☐ Payment made via USPTO's patent electronic filing system (Patent Center or EFS-Web).

☐ A petition for an extension of time under 37 CFR 1.136(b) (PTO/SB/23 or equivalent) is enclosed.
For extensions of time in reexamination proceedings, see 37 CFR 1.550.

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I am the

☐ applicant ☐ attorney or agent of record Registration number _____ ☐ attorney or agent acting under 37 CFR 1.34 Registration number _____

Signature _____

Typed or printed name _____

Telephone Number _____

Date _____

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☐ * Total of _____ forms are submitted.

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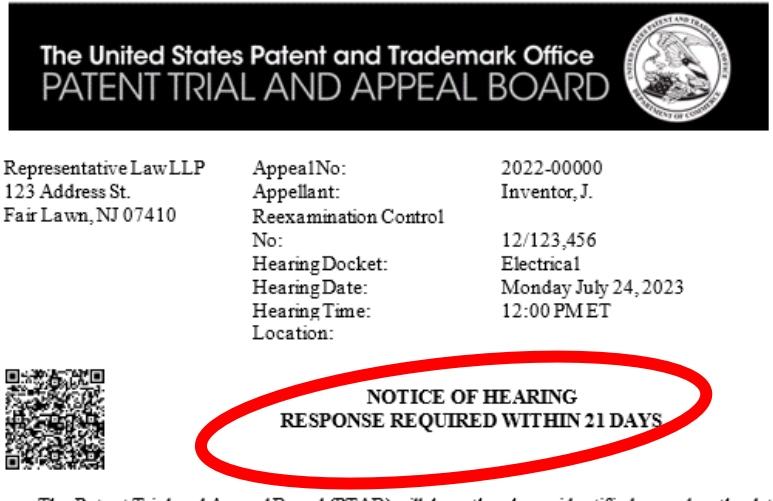
If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

- Office provides a fillable form: **https://www.uspto.gov/sites/default/files/documents/aia0032.pdf**

Notice of Hearing

- PTAB will send you a Notice of Hearing when the hearing date is set
- Will specify location, date, and time
- Includes important information – this does change over time, so please read it!



The United States Patent and Trademark Office
PATENT TRIAL AND APPEAL BOARD

Representative Law LLP
123 Address St.
Fair Lawn, NJ 07410

Appeal No:	2022-00000
Appellant:	Inventor, J.
Reexamination Control No:	12/123,456
Hearing Docket:	Electrical
Hearing Date:	Monday July 24, 2023
Hearing Time:	12:00 PM ET
Location:	

NOTICE OF HEARING
RESPONSE REQUIRED WITHIN 21 DAYS

The Patent Trial and Appeal Board (PTAB) will hear the above-identified appeal on the date indicated. The hearing will commence at the time set, and as soon as the argument in one appeal concludes, the succeeding appeal will be taken up. The time allowed for argument is 20 minutes, unless additional time is requested and approved before the argument commences. If the application involved in this appeal has been published, the hearing will be open to the public.

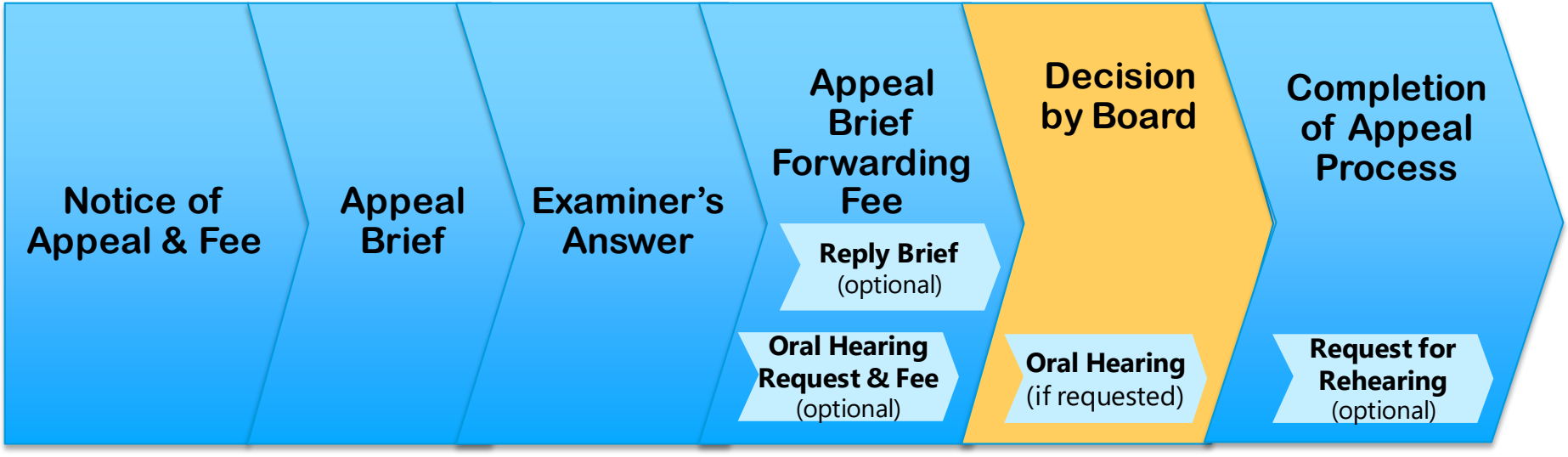
Response to Notice of Hearing

- 21 days to respond
- You can elect to appear in person, by video, or by telephone
- You can waive the hearing or request to reschedule
- You can make requests for accommodation and A/V requests

Hearing Order

- After you respond to Notice of Hearing, PTAB will issue an Order confirming time, place, and mode of the hearing
- Again, things change – please read the order
  - For example - new for *ex parte*: Deadline for Appellant to submit demonstratives into the record is at least 10 days before the hearing date

Ex parte appeal process



Written appeal advocacy

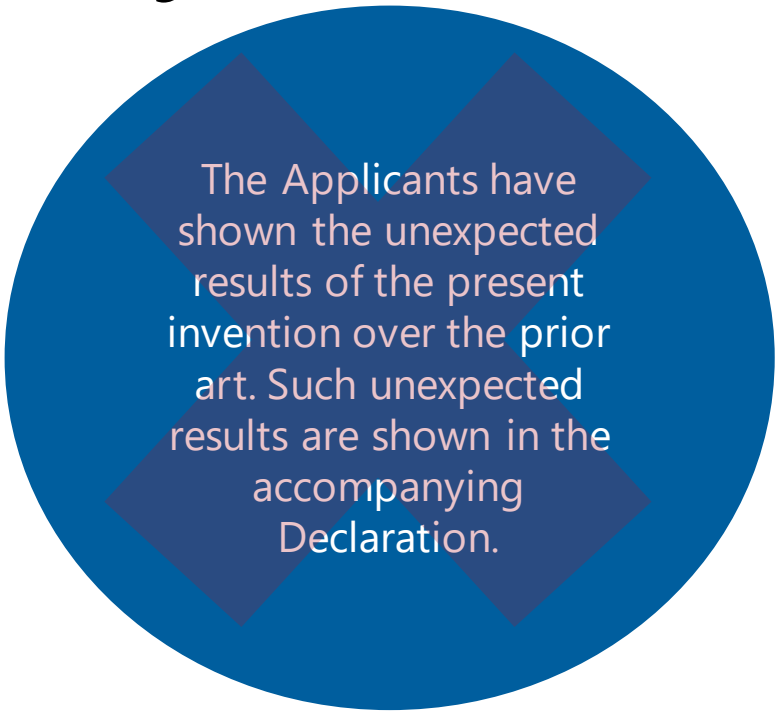
Effective advocacy in an appeal brief

Example 1: Anticipation Rejection

- Invention is A+B+C.
- Examiner rejected as anticipated based on Smith.
- Smith teaches A+B+C′.

Which is the better response to an anticipation rejection?

Argument A



Argument B

Argument A was persuasive

An anticipatory reference under 35 U.S.C. § 102 must disclose every limitation either expressly or inherently.

Net MoneyIN, Inc. v. VeriSign, Inc., 545 F.3d 1359, 1371 (Fed. Cir. 2008).

Argument A

Appellant cannot overcome an anticipation rejection by showing unexpected results or teaching away in the art, which are relevant only to an obviousness rejection.

In re Malagari, 499 F.2d 1297, 1302 (CCPA 1974).

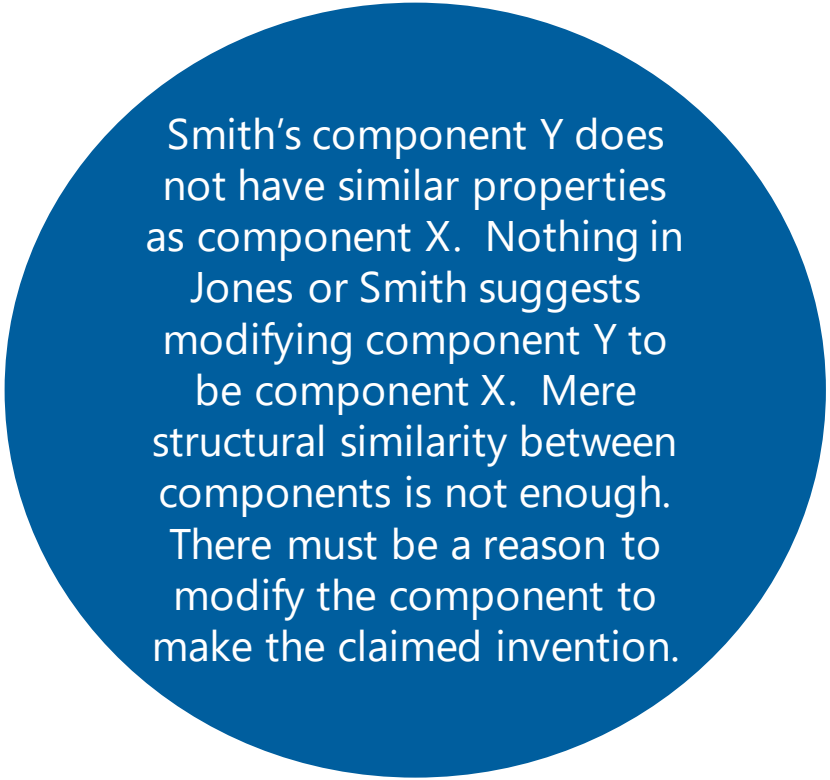
Argument B

Example 2: Obviousness Rejection

- Invention includes several elements including component X.
- Jones teaches all elements except component X. Smith includes a single teaching using component Y.
- Examiner rejected as obvious in view of Smith and Jones.
- Examiner combined Smith and Jones because Smith's component Y has a similar physical structure as component X.

Which is the better response to Examiner's reason to combine?

Argument A



Argument B

Argument B was persuasive

A limited range of choices, or "a finite number of identified, predictable solutions" supports a conclusion of obviousness.

Eisai Co. Ltd. v. Dr. Reddy's Labs., Ltd., 533 F.3d 1353 (Fed. Cir. 2008)

Argument A

Absent a reason or motivation based on prior art evidence, mere structural similarity between a prior art compound and the claimed compound does not inform the lead compound selection and appear to rely on hindsight analysis.

Otsuka Pharmaceutical Co., Ltd. v. Sandoz, Inc., 678 F.3d 1280 (Fed. Cir. 2012).

Argument B

Example 3: Obviousness Rejection Based on Inherency

- Invention includes component Q.
- Smith teaches using component U that often acts like component Q.
- Examiner rejected claim as obvious over Smith because component U inherently satisfies the requirement for Q.

Which is the better response to show a lack of inherency?

At most, the Examiner has shown a possibility that component U, in some circumstances, behaves like component Q. The Examiner has not provided a factual basis or reasoning to show that component U necessarily behaves like component Q.

Argument A

The Examiner improperly includes a finding of inherent anticipation in an obviousness rejection. The rejection fails because the Examiner has made no finding that a skilled artisan would have modified component U to behave like component Q

Argument B

Argument A was persuasive

"Inherency ... may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

Bettcher Indus., Inc. v. Bunzl USA, Inc., 661 F.3d 629, 639 (Fed. Cir. 2011).

Argument A

"[I]nherency may supply a missing claim limitation in an obviousness analysis."

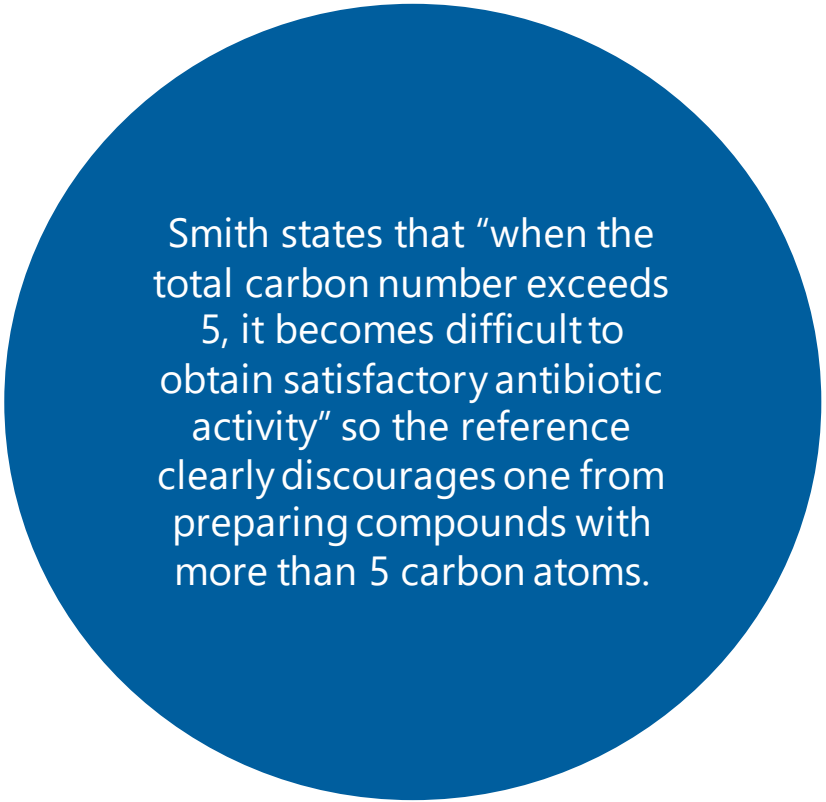
Par Pharm. v. TWI Pharm., Inc., 773 F.3d 1186, 1194 (Fed. Cir. 2014).

Argument B

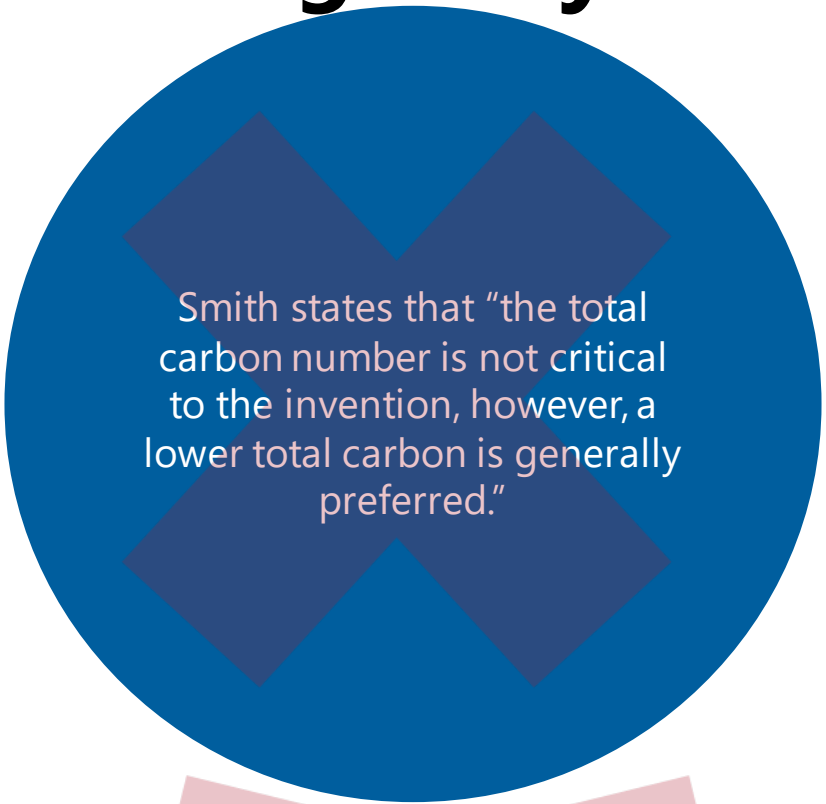
Example 4: Obviousness rejection traversed with Teaching Away

- Invention discloses antibiotic P with a 7 carbon R group attached.
- Smith suggests an antibiotic P with a 4 carbon R group attached.
- Examiner cites MPEP 2144.06(II) and says 7 carbon and 4 carbon R groups are obvious equivalents.

Which argument better demonstrates a teaching away?



Argument A



Argument B

Argument A was persuasive

"The prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed."

In re Fulton, 391 F.3d 1195, 1201 (Fed. Cir. 2004).

Argument A

"We cannot accept the suggestion that one is significantly 'taught away' from a 'particularly preferred embodiment' by the suggestion (whether true or false) that something else may be even better."

In re Susi, 440 F.2d 442, 446 n.3 (CCPA 1971).

Argument B

Example 5: Obviousness rejection traversed as art is not analogous

- Invention discloses a non-aqueous stain S for coating wood on a deck.
- Smith teaches an aqueous stain T for coating wood.
- Jones teaches a non-aqueous color V used for making bubble tea.
- The Examiner rejects the claim over a combination of Smith and Jones.

Which argument better shows the art is not analogous?

The Examiner does not give a reason why one of ordinary skill in the art would consider Jones, a reference discussing bubble tea ingredients, when developing wood stain.

Argument A

Smith is concerned with wetting a surface with the aqueous outer phase of an oil-in-water emulsion. Appellants' application, in marked contrast, is concerned with wetting a surface with the non-aqueous outer phase.

Argument B

Both Arguments were persuasive

"[T]wo separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved."

In re Bigio, 381 F.3d 1320, 1325 (Fed. Cir. 2004).

Arguments A & B

Example 6: Obviousness rejection traversed by evidentiary showing

- Invention discloses a solar light system composed of a panel P and an inverter I.
- Smith teaches a solar light system composed of a panel P.
- Jones teaches a solar light system with panel L using an improved inverter I.
- The Examiner finds it would have been obvious to incorporate the improved inverter I of Jones into the solar light system using the panel P of Smith.

Which argument has better supporting evidence?

Patent Owner presented (1) sales data from the company CFO establishing commercial success of the claimed device; (2) testimony of a university professor stating that others had tried and failed to combine panel P and inverter I and that skilled artisans were skeptical that panel P could be combined with inverter I; and (3) an industry publication stating that the invention won awards based on the claimed features.

Argument A

Patent Owner argued that the invention has been a huge commercial success and that the invention has been copied by numerous competitors.

Argument B

Argument A was persuasive

"Our case law requires the Board to consider evidence of objective factors in any obviousness determination."

In re Morsa, 713 F.3d 104, 111 (Fed. Cir. 2013).

"[A]ttorney argument [is] not the kind of factual evidence that is required to rebut a prima facie case of obviousness."

In re Geisler, 116 F.3d 1465, 1470 (Fed. Cir. 1997).

Argument A

Argument B

Takeaways

- Avoid obviousness arguments in rebutting an anticipation rejection
- Address obviousness rejections head-on
- Teaching away requires showing criticism or discouragement
- Art can be analogous if from the same field of endeavor or if reasonably pertinent to the inventor's problem
- Objective indicia of non-obviousness must be supported with evidence

Navigating an examiner's answer and reply brief

Examiner's answer

- Examiner responds to arguments proposed by Appellant
- Examiner responds by:
  - Clarifying the rejections
  - Explaining claim terms
  - Explaining the technology

Recognizing a new ground of rejection by the Examiner

- The presentation of new information, findings, or reasoning in the examiner's answer constitutes a new ground of rejection
  - If the examiner is **changing the thrust of the rejection** in the examiner's answer, it may be formally designated as a new ground of rejection in the examiner's answer.
- The Office has established guidelines at MPEP 1207.03 as to what constitutes a new ground of rejection.

New ground of rejection by the Examiner: clearly identified

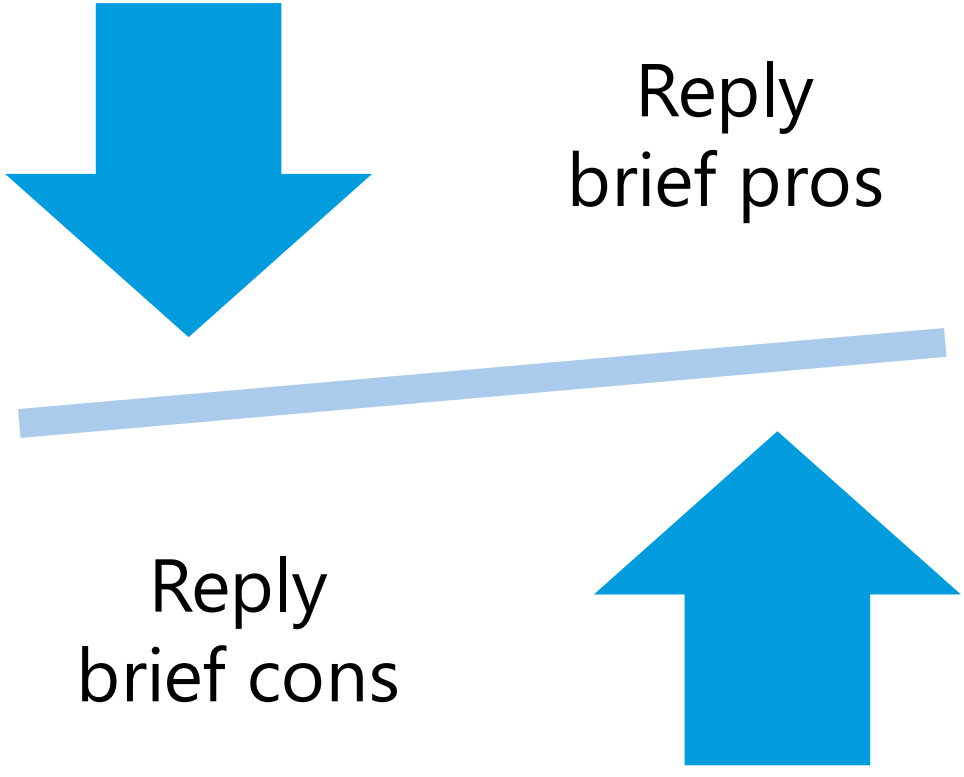
- Appellant's next steps:
  - 2 months to respond
  - Response options*:
    - Request that prosecution be reopened; or
    - Submit a reply brief that addresses all new grounds to maintain the appeal

  * The appeal will be dismissed if one of the above is not filed

New ground of rejection by the Examiner: Not clearly identified

- Appellant's options:
  - Petition (37 C.F.R. § 1.181)
    - Within 2 months
    - Before filing of a reply brief
  - Submit arguments in a reply brief addressing Examiner's argument raised for the first time in the Examiner's Answer

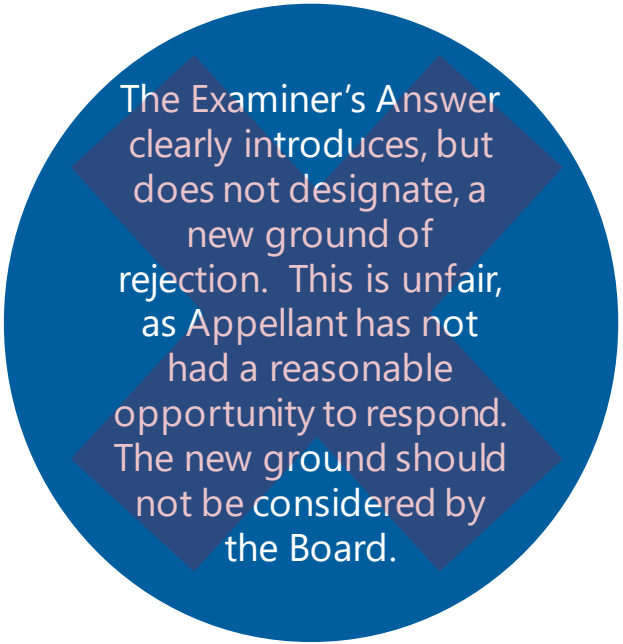
Filing a reply brief



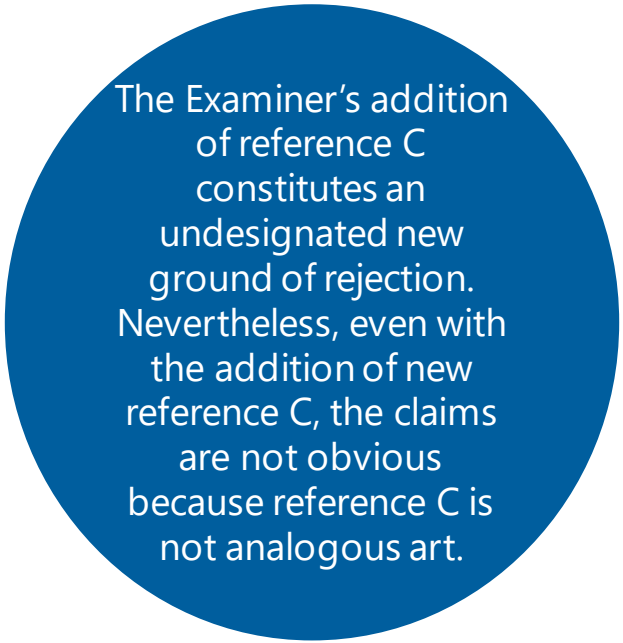
Things to consider in a reply brief

- Argue the substance of any new findings that the Examiner made in the examiner answer. For example, you might argue:
  - If the Examiner makes a new finding, construes a claim term, or cites a new reference,
    - Address why a limitation is not met in the new finding or construction
    - Address why the combination is not obvious over the new finding or construction
- If the Examiner clarifies the reasoning in the rejection,
  - Address the clarified reasoning head-on
- Repeating arguments from the Appeal Brief is seldom effective.

How should Appellant address an undesignated new ground?



Argument A



Argument B

Argument C

Argument B was persuasive. Argument C was also an option

Where, as here, Appellant did not file such a petition, Appellant's contentions regarding any alleged new ground of rejection in the Answer are waived.

Ex Parte Yehuda Binder & Benjamin Maytal, 2021 WL 4452955, at *8 (PTAB Sept. 27, 2021)

Argument A

If appellant wishes to submit only arguments, the filing of a petition under 37 CFR 1.181 is not necessary because appellant may submit arguments in a reply brief if they are responsive to arguments the examiner raised for the first time in the examiner's answer.

MPEP 1207.03(b)

Argument B

37 CFR 41.40 sets forth the exclusive procedure for an appellant to request review of the primary examiner's failure to designate a rejection as a new ground of rejection via a petition to the Director under 37 CFR 1.181. . . . This procedure should be used if an appellant feels an answer includes a new ground of rejection that has not been designated as such and wishes to reopen prosecution so that new amendments or evidence may be submitted in response to the rejection.

MPEP 1207.03(b)

Argument C

Takeaways

- When the Examiner changes the thrust of a rejection, it may be a new ground.
- Address a new ground head-on, either with a Petition to reopen or in a reply brief.
- Reply briefs are opportunities to respond to the Examiner, not to provide a duplicate copy of the appeal brief.

QUESTIONS?

Oral appeal advocacy

Oral hearing preparation

Reasons to request a hearing

- Specific issue or technical point
- Hear questions and answer them
- Client understanding of the process

Reasons not to request a hearing

- Cost
- Timing considerations

Judge preparation

- Pre-hearing conferences allow all judges to familiarize themselves with each case to be heard
- Panels will often develop questions about aspects of the case

Appellant preparation

- Determine what issues you want to discuss
- Have demonstratives or specific pages to refer the judges to (e.g., with figures) if you are not presenting them visually
- Have the record available to refer to if asked
- Be prepared to answer questions
- Business attire is expected

Hearing day

- Court clerks are there to help you
- Public may be present unless your case is confidential
- Presentation setup as previously arranged
- Court reporter will be transcribing the hearing

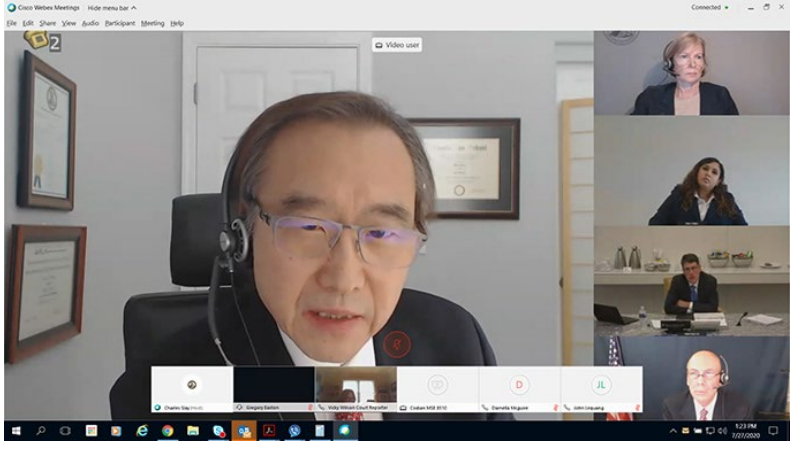
In-person hearing

- At least one judge in person
- Arrive on time, but other cases for the morning or afternoon may be heard first

- An electronic timer will help you keep track of your allotted time (generally 20 minutes)

Virtual hearing

- Each judge is on screen during the hearing
- Technical support available
  - Advance support also available to troubleshoot with you or your IT support
- Appellant chooses video or telephonic when electing a virtual oral hearing



Hearing guidance

https://www.uspto.gov/sites/default/files/documents/PTAB_hearings_guide_101520.pdf

Legal Experience and Advancement Program (LEAP)

- Open to practitioner with three or fewer substantive arguments in any federal tribunal
- Can conduct the entire hearing or share time
- More experienced practitioner may assist or clarify points if necessary
- Typically 15 minutes of additional time granted for hearing
- Request must be made in advance
- Available for ex parte appeals and AIA trials

www.uspto.gov/leap

Mock Appeal Argument

Invention and claim

1. A method for protecting marine seismic equipment by coating the equipment with an electropositive metal attached to repel sharks away from the equipment.

Examiner's rejection

- Claim 1 is rejected under as **obvious** over the combination of **Tuna** and **Flounder**

- **Tuna** discusses problems in the commercial fish industry. One problem is that sharks and other unwanted fish are often caught with the desired tuna fish. Tuna teaches that coating fishing hooks with electropositive metals will repel sharks and other fish but not the tuna

- **Flounder** teaches how to haul seismic marine equipment in the ocean

Appellant's response

- Tuna is **not analogous art** because
  - Tuna is not from the same field of endeavor as the claimed invention; and
  - Tuna is not reasonably pertinent to the problem to be solved by the claimed invention
- A **POSIA would not have been motivated** combine Tuna and Flounder because they teach entirely different things
  - Tuna concerns avoiding bycatch whereas Flounder deals with hauling seismic equipment

Examiner's final rejection

- Tuna is **analogous** art because
  - Tuna is from the same field of endeavor as the claimed invention, namely, preventing shark attacks; and
  - Tuna is reasonably pertinent to the problem solved by the claimed invention, which is repelling shark attacks
- A POSIA **would have been motivated** to combine Tuna and Flounder since each references addresses the common problem of repelling sharks

Takeaways

- Start solid, be clear why you should win
- Don't spend a lot of time explaining the technology unless your case warrants that
- If you are asked a question:
  - Answer as directly as possible
  - Don't be afraid to take a pause if you need to
  - Ask for clarification if needed
- Effective transitions between issues are useful
- Prepare for questions about the weakness in your case; don't avoid it. And prepare to explain why it does not matter or is not fatal
- Close concisely

What are my options if I lose before the Board?

Overview

After the PTAB affirms an Examiner's rejection, Appellant's options include one or more of the following:

I. Request Panel Rehearing

II. Appeal to federal court

III. Continued prosecution before the examiner

I. Panel Rehearing Request

What CAN be argued:

- Point(s) that PTAB "misapprehended or overlooked"
- New argument based upon recent relevant Board, Federal Circuit, or Supreme Court decision
- New arguments responding to a Board new ground of rejection (§41.50)
- Arguments that the Board's decision contains an undesignated new ground of rejection

What CANNOT be argued:

- New argument based upon newly introduced evidence
- Arguments not previously made in the Appeal Brief (except as listed above)

I. Panel Rehearing Request

<u>When can it be filed?</u>

- Within 2 months of original Board decision.

<u>Can I file a rehearing request of the rehearing decision?</u>

- Only if the rehearing decision "so modified the original decision as to become, in effect, a new decision, *and the Board states that a second request for rehearing would be permitted.*" 37 CFR 41.52.

I. Panel Rehearing Request

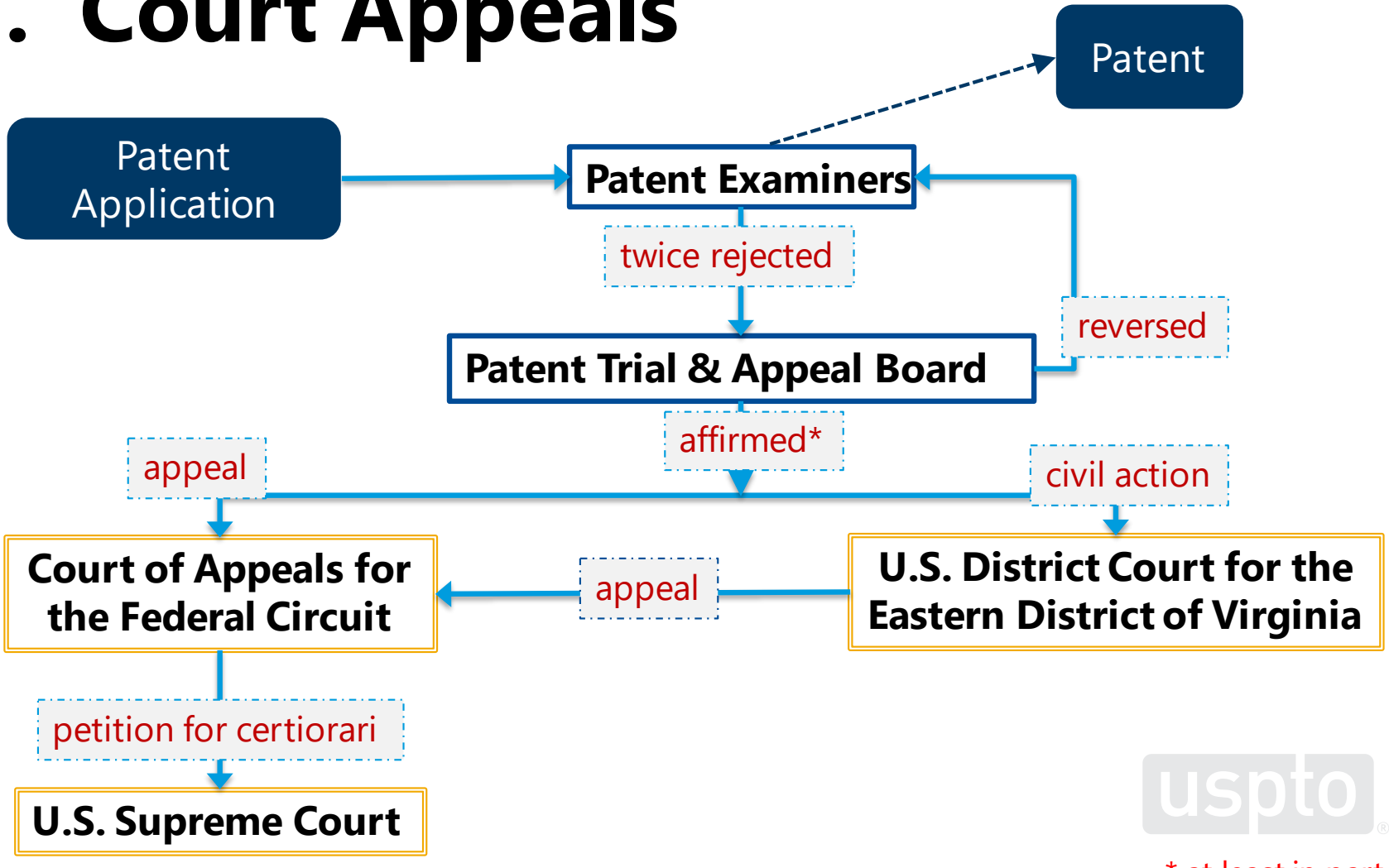
Can I simultaneously request rehearing and file an appeal to the CAFC?

- No – the decision on rehearing will be the final decision that may be appealed. The 63-day period for filing a CAFC appeal will start from the decision on rehearing.

Can I request an oral hearing for the rehearing request?

- The Board's normal rehearing practice does not include oral hearings.

II. Court Appeals



* at least in part

II. Court Appeals

- Notice of Appeal (CAFC) or Complaint (EDVA) must be filed 63 days from final decision (37 CFR 90.3)
  - Decision on rehearing resets time
  - Extendible for good cause or excusable neglect
- Serve notice to Director by service on the Office of the Solicitor
- Application file remains closed if not previously published
- USPTO may settle with Appellant or withdraw appeal
- For civil action at EDVA, expenses paid by Appellant

II. Court Appeals

Proceedings terminate on the date that is either the issuance of the mandate (CAFC) or the time to appeal the judgment (EDVA).

- If the Examiner's rejections are affirmed, any request to continue prosecution (by RCE) must be filed prior to the termination date.
- Solicitor's Office may assist in ascertaining the termination date of a civil action at the EDVA.

III. Continued prosecution

Would any of the claims be allowable?

- Non-statutory double patenting rejection?
  - file a proper terminal disclaimer prior to the expiration of the period for seeking review under 37 CFR 90.3
- Claim objected to as depending from a rejected claim?
  - File amendment pursuant to 37 CFR 41.33(b)(2) rewriting such claim in independent form within the period for seeking review under 37 CFR 90.3

*Not an exhaustive list

III. Continued prosecution

Want to file a new amendment after PTAB final decision? (MPEP 1213.07)

- Submit amendment with RCE under 37 CFR 1.114 and fee
  - Prosecution reopened and amendment entered
  - Not available in an application after filing Notice of Appeal to CAFC or a civil action in EDVA, unless appeal or civil action terminated and the application is still pending
- Can also petition the Director under 37 CFR 1.198

*Not an exhaustive list

Takeaways

- An appeal can be a waypoint towards adjudicating patent rights, but is never the final stop.
- PTAB or other judicial review can reverse an Examiner's rejection. But only the Examiner can issue a patent.
- Where rejections are reversed, or claims previously found allowable, further interaction with the Examiner may be needed before a patent may issue.

QUESTIONS?

Practice makes perfect

Maurice is an electrical engineer. He was visiting the fair and saw the world's largest cherry pie.

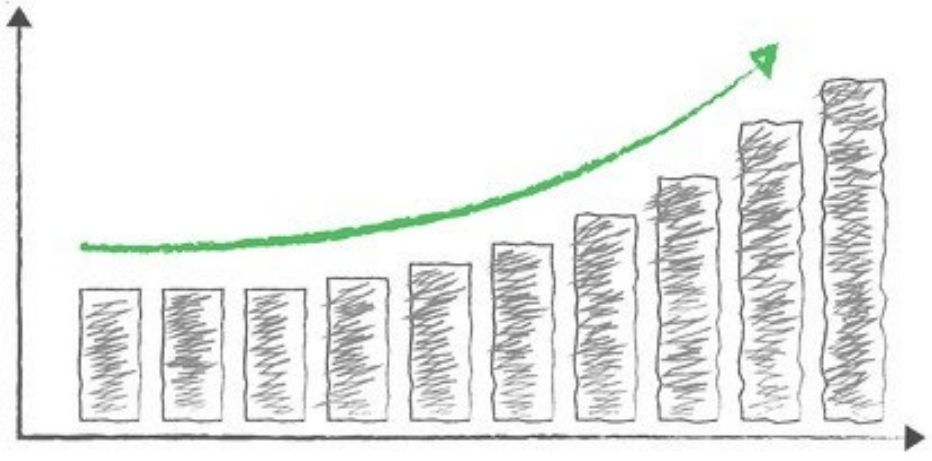
In the souvenir shop, Maurice saw lots of pie themed merchandise like pans, slicers, and 3D replicas. Maurice wanted a 3D replica of himself with the pie. He had an idea!

Maurice decided that kiosks selling 3D replicas of tourists combined with sights like the Eiffel tower, the Statue of Liberty, or even the world's largest cherry pie would be highly desired. He called his souvenirs "MeMeMe"s.

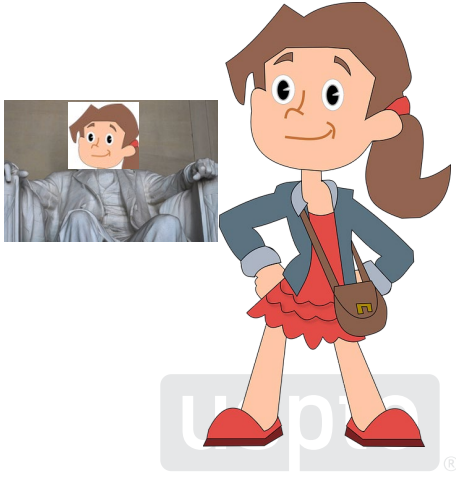
Maurice decided that he should **file a patent application** for his idea. He hired Jen as his patent attorney, and she filed his application with claims to a system and method.

The USPTO patent examiner **rejected** all of Maurice's claims as obvious. Jen drafted claim amendments as well as arguments in response to the rejection. The examiner was not persuaded and issued a **final rejection**.

Jen suggests to Maurice that he **appeal** to the PTAB.



Meanwhile, Maurice tells Jen that **sales are booming** at his one kiosk, without any advertising. He even gives Jen a gift when she visits DC.



Question 1: *What scope should Jen plan to address in the Appeal Brief?*

1. A bullet point summary
2. Fulsome explanation of the law
3. Citation to case law with conclusory statement of what Examiner got wrong
4. Targeted argument of how the Examiner committed a legal error and/or the factual circumstances that establish the Examiner's erroneous conclusion

Question 2: *How should Jen organize Maurice's Appeal Brief? Why?*

1. Start with the weakest argument to build suspense
2. Start with the strongest argument to hit hard at the start
3. Organization doesn't matter so long as all the issues are present
4. Include the new evidence of Maurice's high volume of unexpected sales (which are not of record) as objective indicia of nonobviousness to convince the Board that the invention is patent worthy

Jen filed an Appeal Brief leading off with the **strongest argument** and arguing the dependent claims separate from the independent claims. Upon receipt of the Examiner's Answer, Jen noticed that the **Examiner clarified** some of his arguments and made what she considered to be a **new ground of obviousness rejection** for the software claim.

Question 3: *What advice should Jen give to Maurice about submitting a Reply Brief?*

1. Skip the Reply Brief because there is nothing new to be said.
2. File a Reply Brief to reiterate the Opening Brief.
3. File a Reply Brief only to respond to the Examiner's new ground of rejection.
4. File a Reply Brief only to address the Examiner's argument to the extent that the Examiner clarified those argument and a response would be useful to the Board.

Question 4: *How should Jen recommend Maurice respond to the Examiner's new grounds of rejection? Why?*

1. File a petition under 37 CFR § 1.181 to request that prosecution be reopened
2. Ignore it because an Examiner cannot raise a new ground of rejection in an Examiner's Answer
3. Address in the Reply Brief with argument only
4. Address in Reply Brief with new evidence in direct response to the new ground

Jen and Maurice decide to **file a Reply Brief to expound on the Examiner's clarified arguments and address the new grounds**. Jen also tells Maurice that she thinks it would help to explain his inventions at an **Oral Hearing.**

Question 5: *What should Jen argue at oral hearing on behalf of Maurice? Why?*

1. Tell Maurice's story of invention and why the patents are so important to him. Maurice also wants to bring in the invention, display it, and make each panel member a souvenir
2. Explain patent law to the panel
3. Address how the examiner erred and point out any relevant case law that supports Maurice's case
4. Point out Maurice's high volume of unexpected sales (which are not of record) as objective indicia of nonobviousness

Question 6: *During the oral argument, the panel asks Jen a particularly difficult question. How should Jen handle this question?*

1. Tell the panel that she will get to the answer at the appropriate point in her pre-prepared script
2. Pause and ask for a moment to consult the record
3. Tell the panel that the question is not important, decline to answer, and continue with her pre-prepared script
4. Explain that she does not know the answer and request the opportunity to file a supplemental paper

Question 7: *During the oral argument, the panel pose a hypothetical to Jen. How should Jen handle the hypo?*

1. Tell the panel that the hypo is "not this case"
2. Answer the hypo and point out how Maurice's facts are distinguishable from the hypo
3. Tell the panel that she does not know the answer to the hypo and return to her script
4. Revise the facts of the hypo to be favorable to Maurice and answer the more favorable hypo

At the oral hearing, Jen focused on **how the examiner erred** without involving Maurice. In response to the panel's difficult question, Jen paused to consult the record and did her best to **answer the question directly**. Jen received a **PTAB Decision reversing** the obviousness rejection on the system claims and **affirming** the new ground of obviousness rejection on the method claims.

Question 8: *What should Jen advise Maurice to do after he gets the Board Decision? Why?*

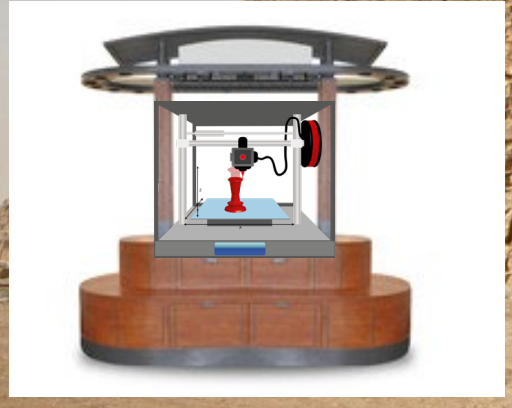
1. Allow the Examiner to take action on the reversal and likely obtain a patent on the system claims
2. Reopen prosecution for the affirmed new grounds of rejection on the method claims and file claim amendments or new evidence of the high volume sales
3. Request panel rehearing of the affirmed rejection
4. Appeal to the Eastern District of Virginia with new evidence
5. Appeal to the Federal Circuit

Maurice instructs Jen to **seek panel rehearing** on the affirmed new obviousness rejection.

Question 9: *What should Jen advise Maurice to argue in the request for rehearing? Why?*

1. Argue that the panel should have taken the new evidence of the high volume sales (which are not of record) as objective indicia of nonobviousness and reversed the rejection
2. Point out why there was good cause to grant the patent
3. Show where the panel misapprehended or misunderstood the facts and/or law
4. Remake the arguments from the Opening Brief yet again because the panel must not have understood them

Jen explains that the standard for rehearing is to point out how the panel **misapprended or overlooked the facts and/or law** and that the best strategy is to argue that there was no motivation to combine the references in the obviousness rejection.



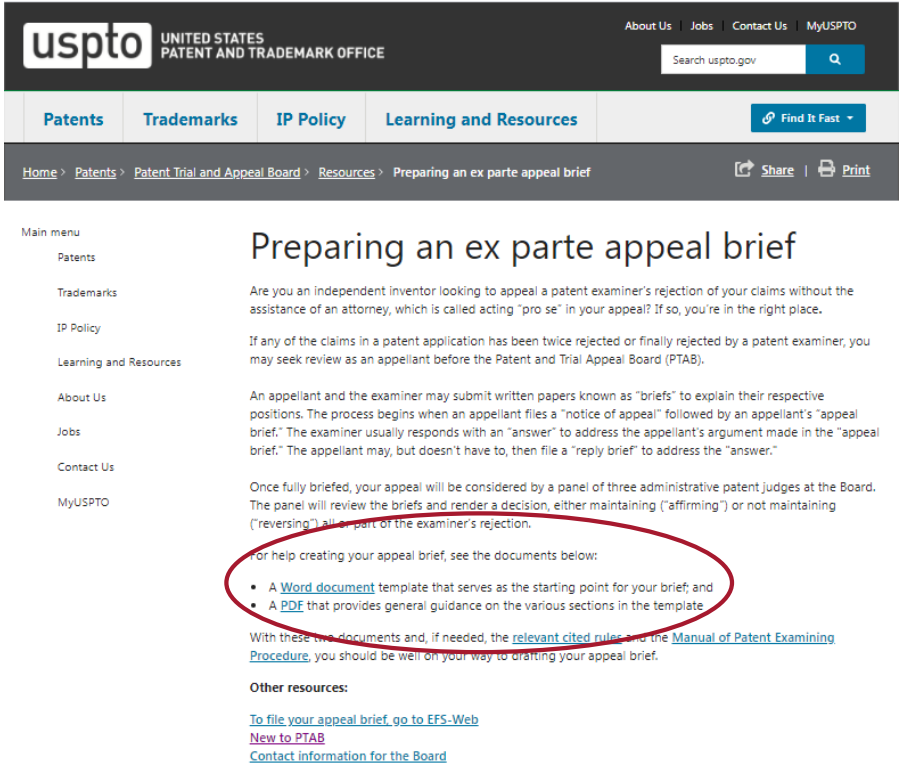
While the rehearing was pending, Maurice was thrilled to let Jen know that his sales continued to increase, and that he received two **awards** from the World Travel Society for best souvenir and from the International Printing Society for best new scanner/printer.

The Board was not persuaded by Maurice's argument and **denied panel rehearing.** Jen advises Maurice to **reopen prosecution** and present the new evidence of **even higher sales and the awards**.

Maurice ends our story with **an issued patent**, 35 kiosks around the world with booming sales, a trophy case for his awards, and ringing endorsement for his patent attorney, Jen.

Other PTAB resources

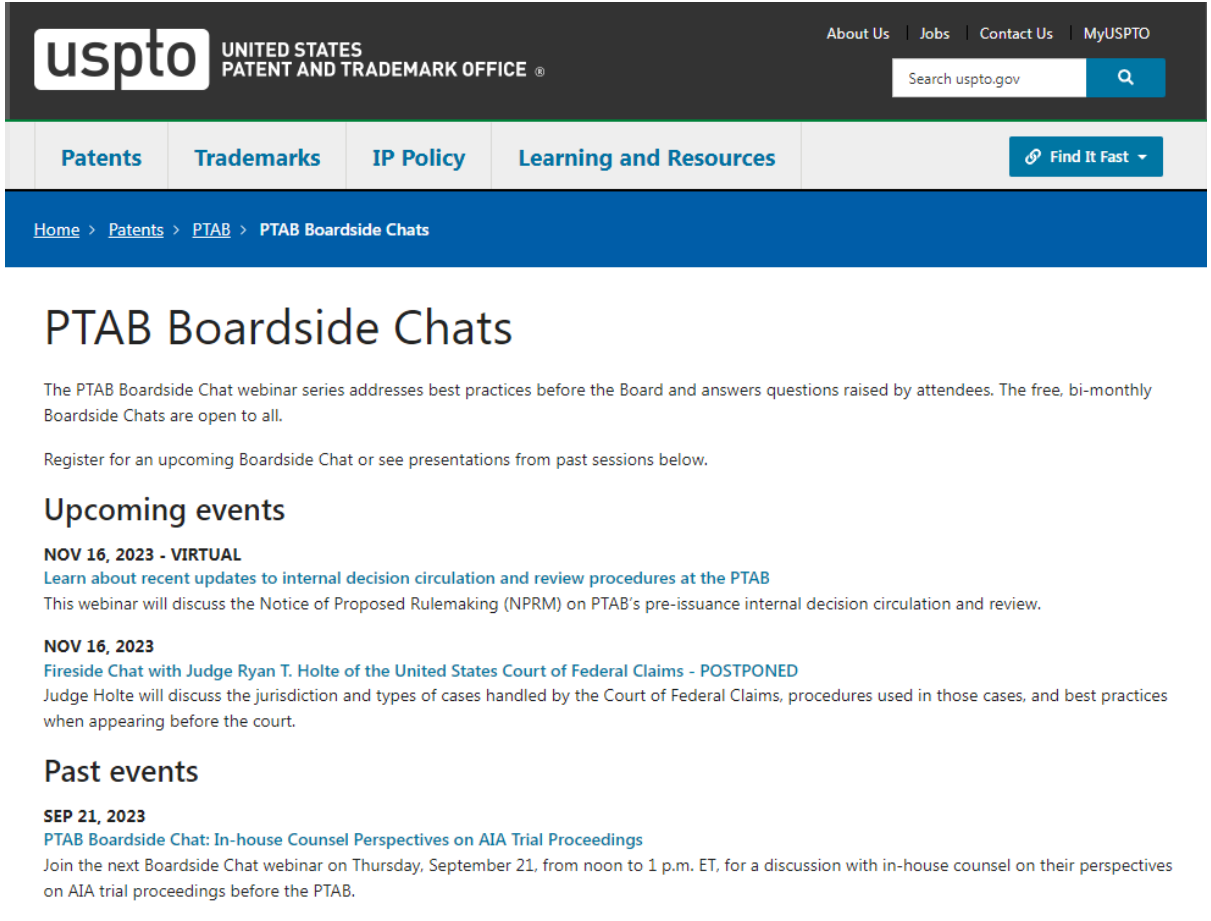
Appeal Brief Tool



https://www.uspto.gov/patents/patent-trial-and-appeal-board/resources/preparing-ex-parte-appeal-brief

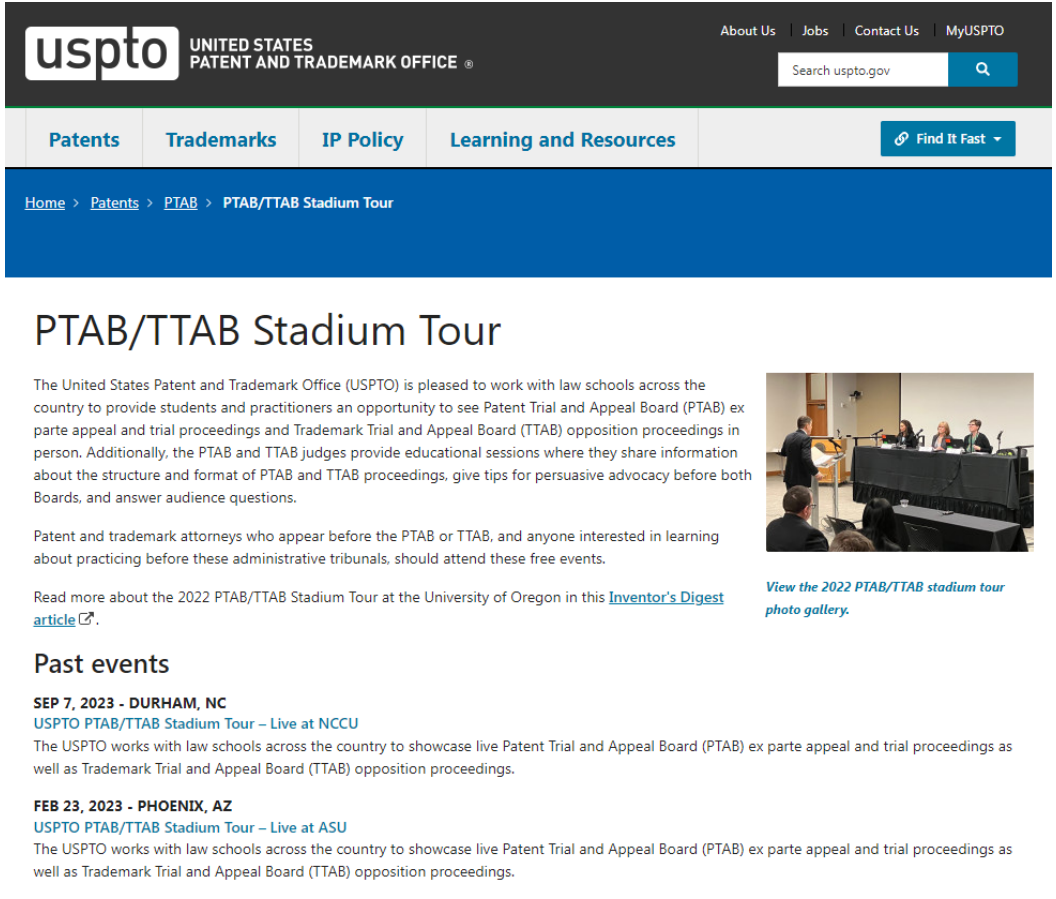
https://www.uspto.gov/sites/default/files/documents/ptab_boardside_chat_preparing_an_appeal_brief.pdf

Boardside Chat webinars



https://www.uspto.gov/patents/ptab/ptab-boardside-chats

Stadium Tours



https://www.uspto.gov/about-us/events/uspto-ptabttab-stadium-tour-live-nccu

QUESTIONS?

Thank you

Patent Trial and Appeal Board

2023

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