Patent Trial and Appeal Board (PTAB)
Boardside Chat: Appeal briefs made easy

James Worth, Lead Administrative Patent Judge
Eric Jeschke, Administrative Patent Judge
Frances Ippolito, Administrative Patent Judge
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Agenda

• New appeal brief tool
• Parts of an appeal brief
• Deep dive on the argument
• Common arguments for showing that the examiner erred
Question/comment submission

• To send in questions or comments during the webinar, please email:
  – PTABBoardsideChat@uspto.gov
New appeal brief tool and how to access
Appeal brief tool

• There are two parts to the appeal brief tool:
  1. Word document template
  2. PDF instructions for completing the template
Location of appeal brief tool: PTAB page on USPTO website

www.uspto.gov/patents/ptab
Location of appeal brief tool:
New to PTAB page on USPTO website
www.uspto.gov/patents/ptab/ptab-inventors
Location of appeal brief tool: Preparing an ex parte appeal brief page

Appeal brief tool: Word template and PDF instructions

**Word template**

**PDF Instruction Document**

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. For example, an assignee of the patent application may be a real party in interest. 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 MPEP §§ 301, 324, 1205.02(i) (https://mpep.uspto.gov/RDMS/MPEP/current/2current/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 duly recorded in the Assignment Branch of the Patent and Trademark Office.

II. RELATED APPEALS AND INTERFERENCES

Please list all of your prior or pending cases before the Board or before a court. These cases are based on applications or patents that you
Filing an appeal brief via EFS-Web: Preparing an ex parte appeal brief page

Filing an appeal brief via EFS-Web
Parts of an appeal brief
Parts of an appeal brief

• Six parts:
  – Summary of claimed subject matter
  – Real party in interest
  – Related appeals, interferences, and trials
  – Argument
  – Conclusion (optional)
  – Claims appendix
Summary of claimed subject matter

• Provides a concise explanation of the subject matter defined in each of the rejected independent claims

• **Not required** for pro se applicants, but may help the Board understand the arguments

• If included, should identify, for each claim element, supporting disclosure and figures
Real party in interest

- 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
- An assignee of the patent application may be a real party in interest
- You must update the real party in interest if it changes during the proceeding (See 37 C.F.R. § 41.8)

Example: The real party in interest is The Great White Café LLC (Baja, California 21511).
Related appeals, interferences, and trials

• List any prior or pending cases before the Board or a court that are related to the current appeal

• A related case is based on a patent or application that you own and would affect the current appeal or be affected by the current appeal
  – A related case might be a continuation application

Example 1: Appeal No. 2019-1234, prior decision dated July 1, 2020

Example 2: There are no related appeals, interferences, or trials to appellant’s knowledge
Argument

• Why the examiner’s decision to reject the pending claims of your application is improper and should be reversed
Conclusion and claims appendix

• Conclusion should briefly explain what relief you want from the Board (e.g., reverse the examiner’s rejection)

• Appendix must include all claims on appeal
  – Should not indicate prior amendments or reference non-admitted amendments
  – Should start on a new page
Question/comment submission

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LEAP

• **Legal Experience and Advancement Program** (LEAP)

• Designed to:
  – Aid in development of the next generation of patent practitioners
  – Encourage a diverse group of advocates to develop their skills before the Board

• To qualify, a patent agent or attorney must have:
  – Three or fewer substantive oral arguments in any federal tribunal, including PTAB, and
  – Seven or fewer years of experience as a licensed attorney or agent
Deep dive on the argument
Argument: preliminary steps

• Review the prosecution history of your application
• Decide which rejections and which claims to address
• Identify your strongest arguments
Argument: strategic considerations

• There is no limit on the number of pages
  – BUT the clearer and more concise your arguments, the better your chances of prevailing

• Present your strongest arguments first
  – Avoid diluting your strong arguments with weaker ones
  – BUT keep in mind–any rejection that you decide not to address and any arguments that you decide not to present CANNOT be presented later
Argument: suggested format

• Address each ground of rejection under a separate heading
• Identify the ground of the rejection by claim number, statutory basis, and references (if any)

Example:

I. Whether claims 1-3 are unpatentable under 35 U.S.C. § 103 over Reference A in view of Reference B
Argument: claim grouping

• If the same argument applies to two or more claims, consider arguing the claims as a group under a single heading or sub-heading

Example:

I. Whether claims 1-3 are unpatentable under 35 U.S.C. § 103 over Reference A in view of Reference B

Claim 1 is patentable over the combination of Reference A and Reference B because ...

Claims 2 and 3 are patentable for the same reasons presented for claim 1
Argument: arguing claims separately

• Use a separate heading or sub-heading for any claim that you want the PTAB to consider separately

Example:

Whether claims 1-3 are unpatentable under 35 U.S.C. § 103 over Reference A in view of Reference B

A. Claims 1 and 2
   Claim 1 is patentable over the combination of Reference A and Reference B because ...
   Claim 2 is patentable for the same reasons.

B. Claim 3
   Claim 3 is patentable over the combination of Reference A and Reference B because ...
Argument: kinds of rejections

- Examiner’s rejection will be based on one or more of the statutory requirements for patentability:
  - 35 U.S.C. § 101 (patent ineligibility or lack of utility)
  - 35 U.S.C. § 102 (lack of novelty)
  - 35 U.S.C. § 103 (obviousness)
  - 35 U.S.C. § 112 (inadequate disclosure)

- Examiner’s objections are usually petitionable, not appealable (See *Ex parte Frye* (precedential))
Argument: burden

• The initial burden of proof rests with the examiner to clearly state the reasons for the rejection

• After the examiner satisfies his burden, then the burden shifts to you to explain why you believe the examiner has made an error
Argument: explain why

• For whatever argument you make to show that the examiner erred, you should always give reasons to support your position.

• It is not persuasive to simply state that the examiner erred without explaining why.
  – Because, because, because.
Common arguments to show that the examiner erred
Common arguments

• Examiner misunderstood or mischaracterized the claimed invention or the pending claims
• Examiner misunderstood the cited prior art
• Examiner misunderstood the law or legal basis for the rejection
Argument: misunderstood the invention

• Explain that the examiner’s characterization of your claimed invention, or the examiner’s interpretation of the claim language, is inconsistent with your specification

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 ...
Argument: misunderstood the prior art

• Explain why the examiner’s understanding of a prior art reference is incorrect, e.g., why the examiner erred in finding that the prior art reference discloses or suggests a particular claim element

Example:

Reference A does not disclose or suggest ... , as recited in claim ... because ...
Argument: misunderstood the law

• Explain that the examiner has failed to correctly apply the law

Example 1, for an obviousness rejection:

The examiner has not set forth sufficient reasoning to combine Reference A and Reference B because ...

Example 2, for an obviousness rejection:

A person of ordinary skill in the art would not have combined Reference A and Reference B, as the examiner proposes, absent knowledge of the claimed invention, because ...
Argument: use of evidence

- Direct the Board’s attention to evidence in the record, e.g., affidavits or declarations from experts, that supports your argument
  - You cannot add new evidence to the record for the first time with the appeal brief

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 References A and B because ...
Argument: use of case law

- If you are aware of case law, i.e., a previous decision of the PTAB or a federal court, that supports your position, explain how the case applies to the facts of your case and shows that the examiner erred.
Question/comment submission

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Fast-track pilot programs

Fast-Track Appeals Pilot Program

- One-year pilot program to expedite ex parte appeals before the PTAB
- Appellant can request appeal be expedited out of turn by filing a petition and a fee
- Learn more about the Fast-Track Appeals Pilot Program at: www.uspto.gov/patents/ptab/fast-track-appeals-pilot-program

Fast-Track Pilot Program for Appeals Related to COVID-19

- Pilot program to expedite ex parte appeals related to COVID-19 before the PTAB
- Appellant can request appeal be expedited out of turn by filing a petition WITHOUT a fee
Question/comment submission

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Next Boardside Chat

• June 17, 2021, noon to 1 p.m. ET

• Agenda
  – Admission to practice before the USPTO
  – Pro hac vice recognition before the PTAB

• Register for and learn about upcoming Boardside Chats and access past Boardside Chats at: www.uspto.gov/patents/ptab/ptab-boardside-chats