

## Appeal Notes

Respond to the final rejection with any of  
new or clarified arguments  
further amending & limiting claims

Examiner maintains final, then:

- (1) filing a new application containing an augmented disclosure
- (2) filing a Request for Continued Examination ("RCE")
- (3) appealing the Patent Examiner's rejection to the PTO's Board of Patent Appeals and Interferences.
  - a) File "Pre-appeal brief request for review", or
  - b) File Appeal Brief.

Pre-appeal brief request for review (started as a trial program in 2005, continued)

"If the applicant feels the rejections of record are clearly not proper and are without basis, then filing this request may result in a panel decision that eliminates the need to file an appeal brief. This should be based upon a clear legal or factual deficiency in the rejections rather than an interpretation of the claims or prior art teachings."

Panel of examiners determine if prosecution should be re-opened, or if appeal is required.

### Appeal steps:

1. File Notice of Appeal (with response to final office action or within time allowed for response to final (3 months).
2. Within 2 months, file Appeal Brief, patent rules: 41.37, MPEP 1206 (extendable)

The rejection of an application by a Patent Examiner is appealable to the Board of Patent Appeals and Interferences, provided the appeal is timely filed and includes the appropriate fee. The Board is generally a three judge panel composed of former patent examiners. In order to be considered timely, the appeal must be filed while the application is still pending. In other words, the appeal must be filed before the period to respond to the office action has expired, which is generally three months for a final Office Action. The USPTO fee for filing a notice of appeal for a small entity is currently \$165.

An appeal starts with the filing of a Notice of Appeal. The Notice of Appeal is a simple procedural document. Next, an Appeal Brief must be filed within two months after filing the Notice of Appeal. Inventors, now referred to as appellants, may obtain up to five additional months to file the Appeal Brief with the payment of the appropriate extension fee. The USPTO small entity fee for filing the Appeal Brief on time is \$165.

The Appeal Brief must meet numerous USPTO requirements regarding the content. The bulk of the Appeal Brief is directed toward:

- (a) identifying the issues presented for review, and
- (b) the arguments regarding each issue.

Upon the filing of the Appeal Brief the Examiner must prepare an Answer. The Answer must meet a number of USPTO requirements directed to format and content, and most importantly, the Answer must respond to the arguments presented in the Appeal Brief.

The appellant is then given the right to file a Reply Brief, thereby giving them the last word before the Board. Additionally, the appellant may request an oral hearing of the appeal by the Board. Generally, an oral hearing should only be requested when necessary or desirable for a complete presentation of the appeal. Approximately fifteen to thirty percent of appeals involve oral hearings. Interestingly, many practitioners believe that appeals decided without an oral hearing receive more favorable outcomes. Additionally, the twenty minutes of oral arguments before the Board significantly increase the cost of an appeal.

The Board then considers the briefs and oral arguments, if any, and writes a Decision. The decision may affirm or reverse the Examiner's rejection in whole, or in part, or remand the application to the Examiner for further consideration. The decision must include specific findings of fact and conclusions of law sufficient for review should the decision be appealed. Often the Board will restrict the decision to a review of the rejections made by the Examiner.

This year, approximately 41% of the appeals decided by the Board reversed the Examiner, approximately 35% affirmed the position of the Examiner, and approximately 11% affirmed-in-part the position of the Examiner. Therefore, the odds of receiving a favorable outcome as the result of an appeal are quite good.

New appeal brief rules announced June 2008, take effect December 2008.

## Appeal to the PTO's Board of Patent Appeals and Interferences

Ex parte appeals from adverse decisions by patent examiners in applications for patents and in reexamination proceedings filed pursuant to Chapter 30 of 35 U.S.C. are provided for by 35 U.S.C. §§ 134 and 306. The rules governing ex parte appeals are found at 37 CFR §§ 41.30-41.54. Chapter 1200 of *The Manual of Patent Examining Procedure* sets forth the current procedures for appellants and patent examiners to follow in ex parte appeals. Sections 2273-2279 of *The Manual of Patent Examining Procedure* sets forth additional procedures for appellants and patent examiners to follow in ex parte appeals in a reexamination proceeding.