

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# Patent Trial and Appeal Board Boardside Chat: Improving *Ex Parte* Appeal Briefs

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# Question/comment submission

- To send in questions or comments during the webinar, please email:
  - [PTABBoardsideChat@uspto.gov](mailto:PTABBoardsideChat@uspto.gov)

# Presentation goals:

By the end of this presentation, practitioners should be aware of

- recommendations for drafting effective briefs
- tips for effectively using the appeal process

# 10 ways to improve an *ex parte* appeal brief

# 1. Identify facts in dispute

- The Board reviews appealed rejections for error based upon the issues identified by appellants, and in light of the arguments and evidence produced thereon.
  - *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)).

# 2. Appellant's burden on appeal

- Appellant carries the burden to clearly explain:
  - What evidence should be reviewed
  - What the reversible error is
- By statute, the Board functions as a board of review, not a de novo examination tribunal. 35 U.S.C. § 6(b)(1) (“[t]he [board] shall . . . review adverse decisions of examiners upon applications for patents . . .”).
- 37 C.F.R. § 41.37(c)(1)(iv): “[A]ny arguments or authorities not included in the appeal brief will be refused consideration by the Board for purposes of the present appeal.”

## 2. Appellant's burden on appeal

- Do *not* assume that the art speaks for itself.
- If an argument has been addressed by the examiner in the Office Action, appellant should address the examiner's response.
- "It is not the function of [an appellate tribunal] to examine the claims in greater detail than argued by an appellant, looking for [patentable] distinctions over the prior art." *In re Baxter Travenol Labs.*, 952 F.2d 388, 391 (Fed. Cir. 1991).



# 3. Appealable v. Petitionable

- The Board's statutory duty is to review "adverse decisions of examiners" on appeal. 35 U.S.C. § 6(b).
  - These adverse decisions are claim *rejections* on the merits (i.e., related to the grounds for patentability set forth in 35 U.S.C. §§ 101, 102, 103, and 112).
- Decisions by examiners that are not decided by the Board or the court, instead may be petitioned to the Technology Center Director or the Office of Petitions. 37 C.F.R § 1.181.
  - Examples of examiner's decisions that are of a discretionary, procedural, or non-substantive nature:
    - Objections to drawings or specification;
    - Restriction requirements;
    - Refusal to enter an amendment; and
    - Patent term extension.

# 3. Appealable v. Petitionable (cont.)

- The Board can review objections in rare situations where the basis for objection is directly connected with the merits of issues involving rejections of claims.
  - *In re Hengehold*, 440 F. 2d 1395 (CCPA 1971).
  - *Ex parte Frye*, 94 USPQ2d 1072, 1078 (BPAI 2010) (precedential).

# Question - Appealable v. Petitionable

- In response to a Non-Final Rejection (NFR), applicant amends the claims to add a new element and also amends the drawings to depict this element. The examiner then objects to the drawings for containing new matter and rejects the claim for lacking written description. If applicant disagrees, would the proper recourse be to appeal or petition the examiner's decisions?
  - A. Only challenge by petition under 37 C.F.R. § 1.181
  - B. Only challenge by appeal to the PTAB
  - C. Applicant may choose either a petition or an appeal

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# PTAB Appeal Brief tool



- Available for independent inventors looking to appeal a patent examiner's rejection without the assistance of an attorney.
- <https://www.uspto.gov/patents/patent-trial-and-appeal-board/resources/preparing-ex-parte-appeal-brief>
- Appeal Brief tool includes:
  - A [Word document](#) template;
  - A [PDF](#) that provides general guidance and helpful examples; and
  - An [instructional video](#) on how to use these documents.

# Question - Appealable v. Petitionable

- In response to a NFR, applicant amends the claims to add a new element and also amends the drawings to depict this element. The examiner then objects to the drawings for containing new matter and rejects the claim for lacking written description. If applicant disagrees, would the proper recourse be to appeal or petition the examiner's decisions?
  - A. Only challenge by petition under 37 C.F.R. § 1.181
  - B. Only challenge by appeal to the PTAB – See MPEP § 2163.06(II)
  - C. Applicant may choose either a petition or an appeal

# 4. Start with the strongest arguments

- Consider the organization of the arguments in the brief.
- Including arguments that have no bearing on the issues in the case distracts from the strongest arguments.
  - E.g., the fact that the examiner used the same references (or switched between a small set of references) throughout prosecution is not a strong argument
  - E.g., general frustration about the examination process
- Boilerplate statements are unhelpful and distract from meritorious arguments.
- “[M]ere statements of disagreement ... do not amount to a developed argument.” *SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1320 (Fed. Cir. 2006).

# 5. Strategize which claims to argue

- Boilerplate arguments for dependent claims are not considered separate arguments.
  - “A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.”  
37 C.F.R. § 41.37(c)(1)(iv).
- For those claims argued separately, place such arguments under separate sub-headings.
  - 37 C.F.R. § 41.37(c)(1)(iv): “any claim(s) argued separately or as a subgroup shall be argued under a separate subheading that identifies the claims by number.”



# 6. Supporting evidence is key

- Support arguments with the objective evidence.
  - Although it is true that all evidence of nonobviousness, including data in the specification, must be considered when assessing patentability, *In re Soni*, 54 F.3d 746, 750 (Fed. Cir. 1995) (citing *In re Margolis*, 785 F.2d 1029, 1031 (Fed. Cir. 1986)), the burden of analyzing and explaining data to support nonobviousness rests with the appellant. *In re Klosak*, 455 F.2d 1077, 1080 (CCPA 1972).
- Attorney argument is not evidence.
  - “Attorneys’ argument is no substitute for evidence.” *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1581 (Fed. Cir. 1989).

# 6. Supporting evidence is key

- Helpful to submit an Evidence Appendix, including any previously submitted declarations and other evidence cited in the Appeal Brief.
  - At a minimum, be sure to clearly identify the evidence using a clear description of the evidence along with the date of entry of such evidence.
  - 37 C.F.R. § 41.37(c)(2): “A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other Evidence.”
- But no need to include the specification or evidence that the examiner relies upon.

# Question - Supporting evidence

- Use of a declaration as supporting evidence may be appropriate:
  - A. If it is timely filed with the appeal brief, even if it was not previously presented to the examiner
  - B. If it repeats the arguments made in the appeal brief
  - C. If it clearly explains the legal precedent that applies to examiner's rejection
  - D. If it comes from an expert in the field of the invention and was previously made of record

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# PTAB decisions



- To search all PTAB trial, appeal, and interference decisions issued after July 1997, please visit:  
<https://developer.uspto.gov/ptab-web/#/search/decisions>
- To view PTAB precedential and informative decisions, please visit:  
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# 7. Accuracy of Summary of Claimed Subject Matter

- Required under 37 C.F.R. § 41.37(c)(iii).
- Important for any claim construction or 35 U.S.C. § 112 issues, particularly means-plus-function issues.
- This section is more than formality. It helps the judges understand the invention.
  - Helpful to direct the judges to specific disclosure (including drawings)

# 8. Use correct version of the claims

- “A brief shall not include any new or non-admitted amendment.” 37 C.F.R. § 41.37(c)(2).
- In some cases, claims are amended after the final rejection. The examiner may or may not enter the amendment.
- Arguments must be based on limitations in the latest version of claims entered into the record.



# 9. Filing a Reply Brief

- Appellant **MAY** file a single Reply Brief within two months of Examiner's Answer.\*\* 37 C.F.R. § 41.41(a).
- Generally no new amendments, affidavits, or evidence. 37 C.F.R. § 41.41(b).
- Arguments must be first raised in Appeal Brief or be responsive to a determination first raised in the Answer. 37 C.F.R. § 41.41(b).
- No extensions of time are permitted. 37 C.F.R. § 41.41(c).

\*\* Or within 2 months of a decision refusing to grant petition to designate a new ground of rejection.

# General Principle:

Appeal is taken from the Office Action's rejection—not from the Examiner's Answer:

- “Every applicant, any of whose claims has been twice rejected, may appeal from the decision of the examiner to the Board...” 37 CFR § 41.31(a)(1) (emphasis added).

# Question – Reply Brief

- If Examiner's Answer merely repeats the final rejection without further elaboration or response to appellant's arguments, appellant should:
  - A. Not file a Reply Brief
  - B. File a reply and point out that the Answer merely constitutes a cut-and-paste that doesn't respond to a certain argument
  - C. File a Reply Brief as early as possible with a cursory response to accelerate the appeal process, e.g., *"Appellant stands on arguments presented in the Appeal Brief."*
  - D. Any of the above

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# 10. Request for rehearing

- Appellant must state the points that the Board's decision "misapprehended or overlooked." 37 C.F.R. § 41.79(b).
- Ineffective to repeat arguments previously made in the appeal and/or reply briefs.
  - Instead identify where an argument was made if alleging that the Board failed to consider it or erred in considering it.
- New arguments and evidence not raised in the briefs generally not permitted. 37 C.F.R. § 41.79(b).

# QUESTIONS?



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# Next Boardside Chat



- September 15, 2022, at 12-1 p.m. ET
- Topic: Use of expert testimony in AIA proceedings
  - Practice tips on use of experts and expert testimony before the PTAB
  - Hear from administrative patent judges and leading practitioners
  - Panel discussion and Q&A session
- Register for and learn about upcoming Boardside Chats, and access past Boardside Chats at:

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



