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Practice Tips for Writing Effective Appeal Briefs

Provided below are ten practice tips for writing effective ex parte briefs when appearing before the Patent Trial and Appeal Board in an ex parte appeal.

Appeal Briefs, 37 C.F.R. § 41.37

- Present only the strongest arguments.
- Do not dilute strong arguments by including weaker arguments or arguments that have no bearing on the issues in the case.
- Strategically group claims to highlight the strongest arguments in the case.
- Give careful thought to which claims you choose to argue separately so that weaker arguments do not dilute stronger arguments.
- For those claims argued separately, place such arguments under separate sub-headings.
- If the same arguments are being made for patentability of two or more independent claims, argue these claims as a group under a single heading.
- Develop the facts of your case to show how the law applies to achieve the result being sought.
- Set out the standard for the legal theory you seek to have applied, and then provide arguments or evidence to demonstrate the legal theory applies to the case before the Board.
- Clearly address the examiner's rejection as articulated in the rejection on appeal and point the Board to the alleged error in that rejection.
- Understand the burden of proof.
- Recognize when the burden of proof shifts to appellant and provide arguments to show why the burden should not be shifted or evidence to rebut the examiner's findings and meet the burden of proof.
- Define key claim terms.
- Acknowledge when an issue turns on claim construction and provide an interpretation for the key claim terms with a basis for the interpretation under the "broadest reasonable interpretation" standard.
- Demonstrate why the examiner's interpretation is not "reasonable."
- Support arguments with evidence.
- Attorney argument cannot substitute for evidence.

- Do not rely on new evidence that was not before the examiner during prosecution.
- Understand the difference between appealable and petitionable issues.
- The Board reviews adverse decisions of examiners (i.e., claim rejections).
- The Board typically does not review matters within the examiner's discretion (i.e., objections to the figures or specification, restriction requirements, refusal to enter an amendment, etc.). These matters are decided by the Director on petition. See MPEP § 1002.
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- Use Summary of Claimed Subject Matter to support your appeal
- The Board uses the Summary of Claimed Subject Matter portion of the appeal brief to understand the claimed invention and how the claim elements correspond to the drawing elements and the description in the specification.
- This section is particularly important when the claim recites elements in §112(f) (means-plus-function) format.

Reply Briefs, 37 C.F.R. § 41.41

- Use reply briefs to respond to points raised in the Examiner's Answer
- Do not reiterate arguments presented in appeal brief.
- Use the reply brief to reply to specific findings made, or positions taken, by the examiner in the answer, or to address intervening case law relevant to the issues on appeal.
- Do not raise new arguments in a reply brief that are not responsive to arguments made in the examiner's answer.
- Do not separately argue claims for the first time in a reply brief.

Requests for Rehearing, 37 C.F.R. § 41.52

- File requests for rehearing only when appropriate
- Do not simply re-argue the points raised in the briefs.
- Identify particular points of error by the Board.
- Strategically limit arguments to only one or two assertions of error, and refer to the specific portions of the Board's opinion where the errors can be found.

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