

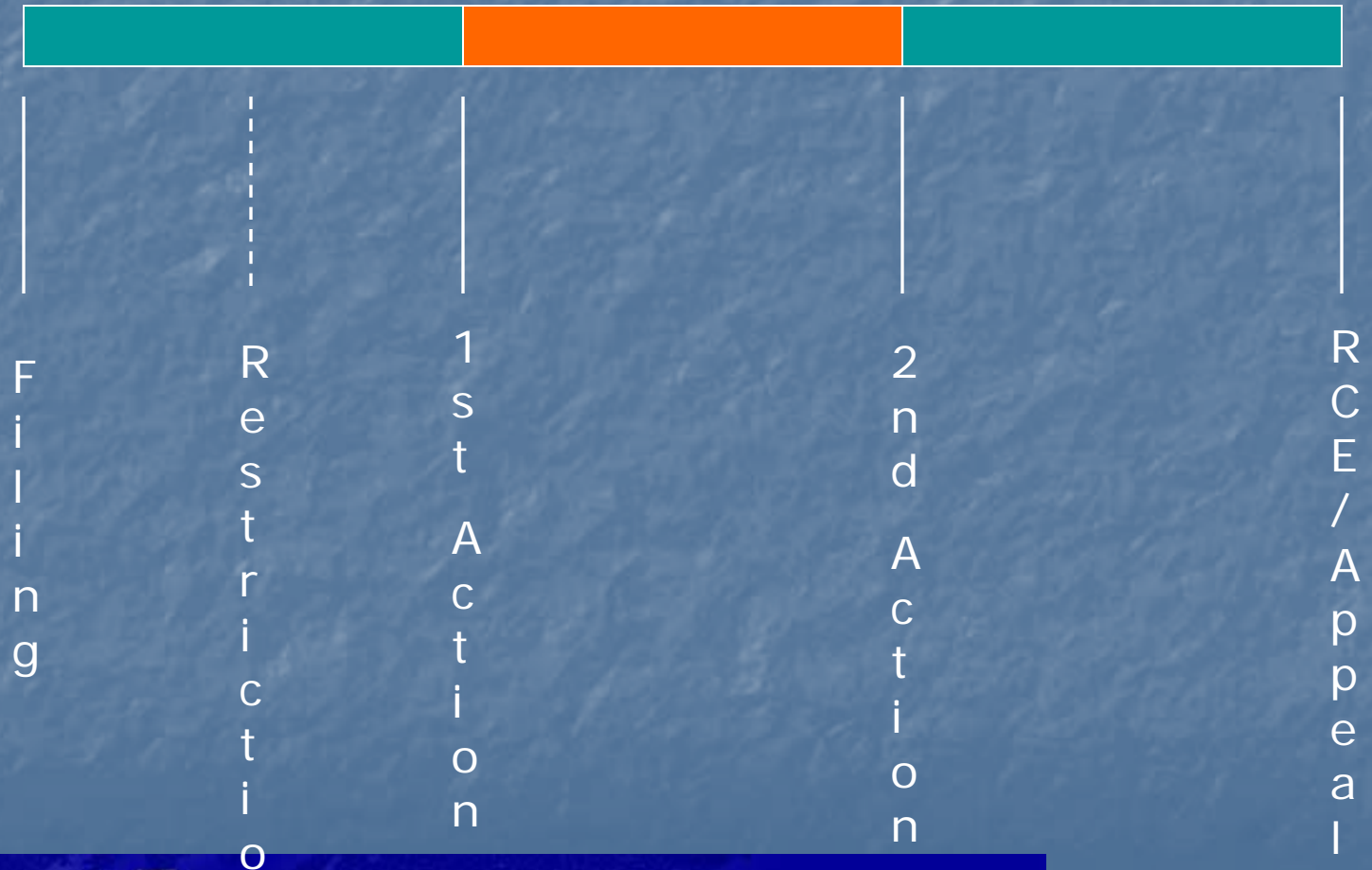
244th American Chemical Society National Meeting &
Exposition

APPEALS

R. Goozner – August 2012

Young & Thompson
International Patent & Trademark Law
Founded 1903

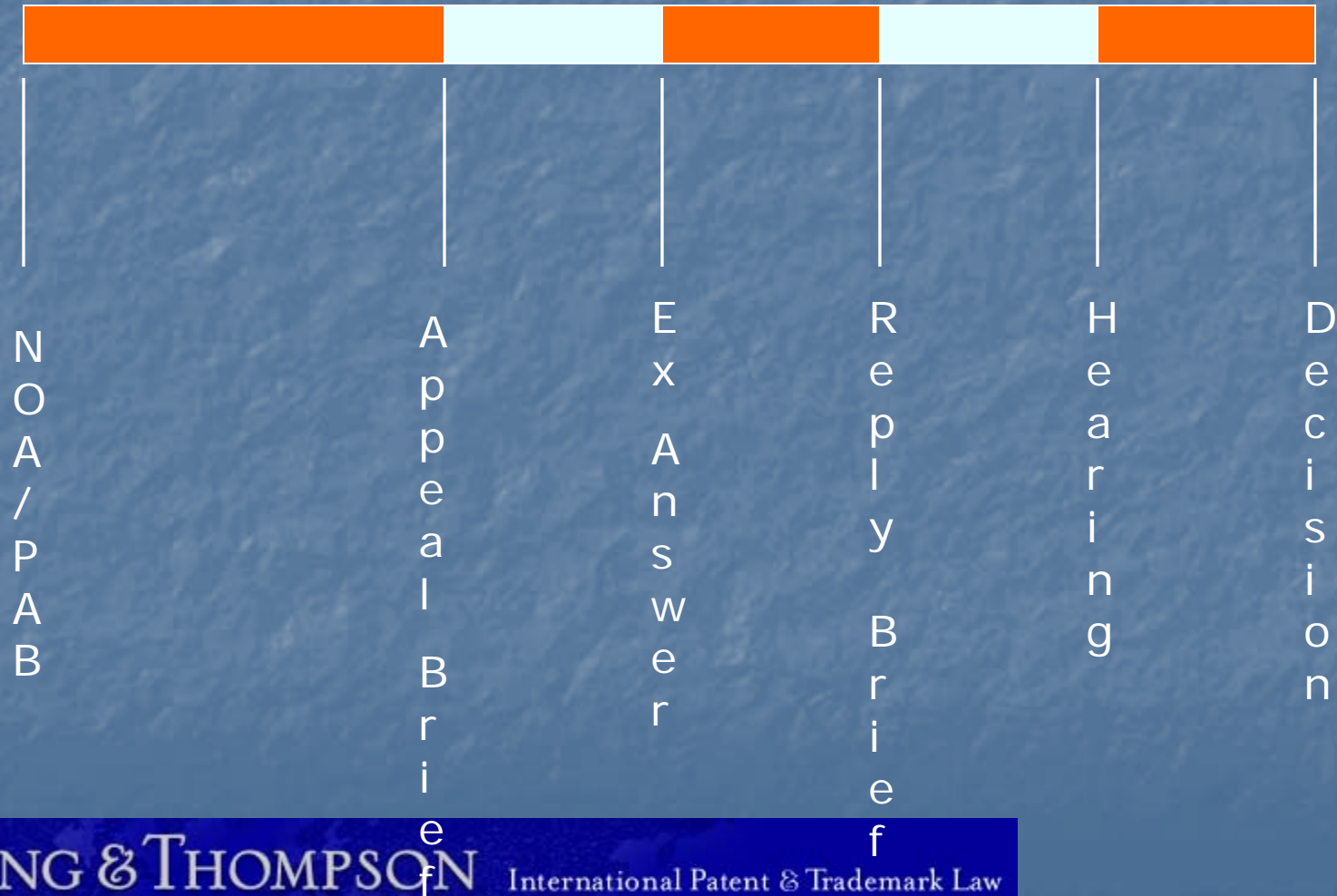
Prosecution Progression



APPEAL BY PATENT APPLICANT

- Under 37 CFR 41.31(a)(1) an applicant for a patent dissatisfied with the primary examiner's decision in the second rejection of his or her claims may appeal to the Board for review of the examiner's rejection by filing a notice of appeal and the required fee.
- A notice of appeal may be filed after any of the claims has been twice rejected, regardless of whether the claim(s) has/have been finally rejected.

Appeal Time Line



Notice of Appeal

PTO/SB/01 (07-09)
Approved for use through 07/31/2012. OMB 0651-0001
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

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 BOARD OF PATENT APPEALS AND INTERFERENCES		Docket Number (Optional)
<p>I hereby certify that this correspondence is being facsimile transmitted to the USPTO 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)]</p> <p>on _____</p> <p>Signature _____</p> <p>Typed or printed name _____</p>		
In re Application of		
Application Number	Filed	
For		
Art Unit	Examiner	

Applicant hereby appeals to the Board of Patent Appeals and Interferences from the last decision of the examiner.

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

Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by half, and the resulting fee is: \$ _____

A check in the amount of the fee is enclosed.

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. _____.

A petition for an extension of time under 37 CFR 1.136(a) (PTO/SB/22) is enclosed.

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/inventor. _____
Signature

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/06) _____
Typed or printed name

attorney or agent of record.
Registration number _____
_____ Telephone number

attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34. _____
_____ Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

*Total of _____ forms are submitted.

Simple form –
PDF fillable

Fee = \$620/310

2 months
(extendable up to
a total of 7
months) to file
appeal brief.

This collection of information is required by 37 CFR 41.21. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. 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.

Uses of Notice of Appeal

- To buy time extensions cheaply:

Normally,

First month extension: \$150/750

Second month extension: \$560/280

Third month extension: \$1270/635

But using Notice of Appeal:

Second Month (\$560/280) plus Notice of Appeal (\$620/310) for a total of \$1180/560 with an extra month to respond.

Pre Appeal Brief Request for Review

In July of 2005, the United States Patent and Trademark Office (USPTO) established a pilot pre-appeal brief conference program that offers a patent applicant an avenue to request a review of the legal and factual bases of the rejections in his or her patent application prior to the filing of an appeal brief.

The purpose of the program is to spare applicant the added time and expense of preparing an appeal brief if a review panel determines an application is not in condition for appeal. In proper situations, it can save both the resources of the applicant and the Office.

Requirements for Pre-Appeal Brief

- (1) File the request and accompanying arguments in a separate paper titled “Pre-Appeal Brief Request for Review” (Form PTO/SB/33 or equivalent).
- (2) Provide in five pages or less, concise, succinct and focused arguments for which the review is being requested.
- (3) File the request with the notice of appeal.
- (4) File the request without an amendment on same date
- (5) Address the notice of appeal and the request to one of the following:
 - - Mail Stop AF
 - Commissioner for Patents
 - P.O. Box 1450
 - Alexandria, VA 22313-1450; hand carry or e-file

PTO/SB/33

Doc Code: AP-PRE-REQ

PTO/SB/33 (27-08)
Approved for use through 07/01/2012. OMB 065-0031
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE
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.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage so first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" (37 CFR 1.8)(a) on _____ Signature _____ Typed or printed name _____	Application Number _____	Filed _____	
	First Named Inventor _____		
	Art Unit _____	Examiner _____	
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the _____ <input type="checkbox"/> applicant/inventor. _____ Signature _____ <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) _____ Typed or printed name _____ <input type="checkbox"/> attorney or agent of record. Registration number: _____ Telephone number _____ <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____ Date _____			
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input type="checkbox"/> *Total of _____ forms are submitted.			
<small>This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.16 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.</small>			
<small>If you need assistance in completing this form, call 1-800-PTO-0199 and select option 2.</small>			

Cover page
and 5 pages
of arguments

Pre-Appeal - Clear Error

The request should specify:

- o clear errors in the examiner's rejections; or
- o the examiner's omissions of one or more essential elements needed for a prima facie rejection.

For example, an applicant faced with an obviousness rejection should concisely point out (i.e., in no more than five pages) that a limitation is not met by a reference. Applicant can refer to arguments already of record rather than reasserting such arguments in the request. For example, applicant may point to a prior submission by paper number and/or date of submission and the relevant portions thereof (e.g., see response filed xx/xx/xx at pages 4 to 6).

Proceed to Appeal

Notice of Panel Decision from Pre-Appeal Brief Review	Application No. 12/20000	Applicant(s) [REDACTED]
	Examiner NEVEN ABOL JAIN	Art Unit 2165

This is in response to the Pre-Appeal Brief Request for Review filed 25 June, 2012.

1. **Improper Request** – The Request is improper and a conference will not be held for the following reason(s):

- The Notice of Appeal has not been filed concurrent with the Pre-Appeal Brief Request.
- The request does not include reasons why a review is appropriate.
- A proposed amendment is included with the Pre-Appeal Brief request.
- Other:

The time period for filing a response continues to run from the receipt date of the Notice of Appeal or from the mail date of the last Office communication, if no Notice of Appeal has been received.

2. **Proceed to Board of Patent Appeals and Interferences** – A Pre-Appeal Brief conference has been held. The application remains under appeal because there is at least one actual issue for appeal. Applicant is required to submit an appeal brief in accordance with 37 CFR 41.37. The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable.

The panel has determined the status of the claim(s) is as follows:
 Claim(s) allowed: _____
 Claim(s) objected to: _____
 Claim(s) rejected: 15-33
 Claim(s) withdrawn from consideration: _____

3. **Allowable application** – A conference has been held. The rejection is withdrawn and a Notice of Allowance will be mailed. Prosecution on the merits remains closed. No further action is required by applicant at this time.

4. **Reopen Prosecution** – A conference has been held. The rejection is withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.

All participants:

(1) SPE [REDACTED]	(3) [REDACTED]
(2) SPE [REDACTED]	(4) _____

		/s/ Neven Abol Jain Supervisory Patent Examiner, Art Unit 2165
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After conference
with 2 other
examiners

No reasons given

Effect of Pre-Appeal

PRE-APPEAL BRIEF CONFERENCE EFFECTS: ACTIONS IN RESPONSE TO REQUEST FOR PRE-APPEAL BRIEF REVIEW

FY	Number of requests	Frequency of requests (percent)	Proceed to board (percent)	Prosecution reopened (percent)	All rejections withdrawn (percent)	Defective request (percent)
06	6,525	24	55	37	5	3
07	7,240	25	56	38	4	2
08	8,255	27	59	37	2	2
09	9,967	30	56	39	3	2
10	12,019	34	56	38	5	1

Federal Register / Vol. 75, No. 219 / Monday, November 15, 2010 / Proposed Rules

69831

Appeal Brief

Specific items required by 37 CFR 41.37(c)(1) :

- (i) Real party in interest. A statement identifying by name the real party in interest even if the party named in the caption of the brief is the real party in interest. If appellant does not name the real party in interest under this heading, the Office will notify appellant of the defect in the brief and give appellant a time period within which to file an amended brief.
- (ii) *Related appeals and interferences*. A statement identifying all prior and pending appeals, judicial proceedings or interferences known to the appellant which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. Appellant includes the appellant, the appellant's legal representative and the assignee. Such related proceedings must be identified by application number, patent number, appeal number (if available) or interference number (if available).

Appeal Brief

Specific items required by 37 CFR 41.37(c)(1) :

- (iii) Summary of claimed subject matter. A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which must refer to the specification by page and line number, and to the drawing, if any, by reference characters.
- (iv) Argument. The appellant's contentions with respect to each ground of rejection presented and the basis for those contentions, including citations of authorities, statutes, and parts of the record relied on, should be presented in this section. A statement which merely points out what a claim recites will not be considered an argument for patentability of the claim.
- (v) Claim Appendix

No Longer Needed in Appeal Brief

- Status of Claims
- Status of Amendments
- Grounds of rejection to be reviewed on appeal
- Evidence Appendix (but still recommended)
- Related Proceedings Appendix

Effect of Appeal Brief

PRE-APPEAL BRIEF CONFERENCE EFFECTS: ACTIONS IN RESPONSE TO REQUEST FOR PRE-APPEAL BRIEF REVIEW

FY	Number of requests	Frequency of requests (percent)	Proceed to board (percent)	Prosecution reopened (percent)	All rejections withdrawn (percent)	Defective request (percent)
06	6,525	24	55	37	5	3
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08	8,255	27	59	37	2	2
09	9,967	30	56	39	3	2
10	12,019	34	56	38	5	1

APPEAL CONFERENCE EFFECTS: ACTIONS IN RESPONSE TO APPEAL BRIEF

FY	Examiner's answer (percent)	Prosecution reopened (percent)	All rejections withdrawn (percent)	Other action (percent)
98	58	12	29	1
99	52	15	32	1
00	46	21	32	1
01	40	25	34	1
02	38	26	34	1
03	38	29	31	1
04	39	32	27	2
05	39	35	24	2
06	49	30	19	2
07	56	28	14	2
08	59	28	12	1
09	56	27	16	1
10	59	23	17	1

After Appeal Brief is Filed

After an Appeal Brief under 37 CFR 41.37 has been filed and the examiner has considered the issues on appeal, the examiner may:

(A) reopen prosecution to enter a new ground of rejection with approval from the supervisory patent examiner;

(B) withdraw the final rejection and allow the application if the examiner determines that the rejections have been overcome and no new ground of rejection is appropriate; or

(C) maintain the appeal by conducting an appeal conference and draft an examiner's answer

Examiner's Answer

- Follows meeting with 2 other Examiners
- An Examiner's Answer may include a new ground of rejection.
- Two months to reply (no extensions of time).

New Ground of Rejection in Examiner's Answer

- (1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under § 1.111 with or without amendment or submission of affidavits or other evidence. Any amendment or submission of affidavits or other evidence must be relevant to the new ground of rejection.
- (2) Maintain appeal. Request that the appeal be maintained by filing a Reply Brief as set forth in § 41.41. Such a Reply Brief must address each new ground of rejection as set forth in § 41.37(c)(1)(vii) and should follow the other requirements of a brief as set forth in § 41.37(c).

Examiner's Answer

- New ground for rejection:
 - Based on a newly applied reference.
 - Can also be based on a new position or rationale that changes the “basic thrust of the rejection.”
- Will repeat ground for rejection
- Most important is “Response to Argument.”

Reply Brief

- Required if new ground of rejection
 - §102 -> §103
 - §103-> §102 based on new teaching
 - Citing new structure
 - Different portion of the claim for “new matter”
 - New reference
- 2 month time period to reply
 - No time extensions available
- Optional if no new ground of rejection

Oral Hearing

- **Optional**
- **No new arguments – only those of record**



Rehearing

- Request for rehearing
 - Must state particularly the points believed to have been misapprehended or overlooked by the Board. Arguments not raised in the briefs before the Board
 - Or on a recent Federal decision or decision by the Board
- Request within 2 months of date of decision

The Decision

- Possible outcomes:
 - Examiner Affirmed
 - Examiner Reversed
 - Examiner Affirmed in Part
 - Remand to the Examiner
 - Dismissed

The Decision – Examiner Aff'd

- Possibilities:
 - File RCE with new claim amendments, arguments and/or evidence
 - Appeal to CAFC – stands on the record
 - File suit in District Court of DC – new evidence possible

- Two months from decision

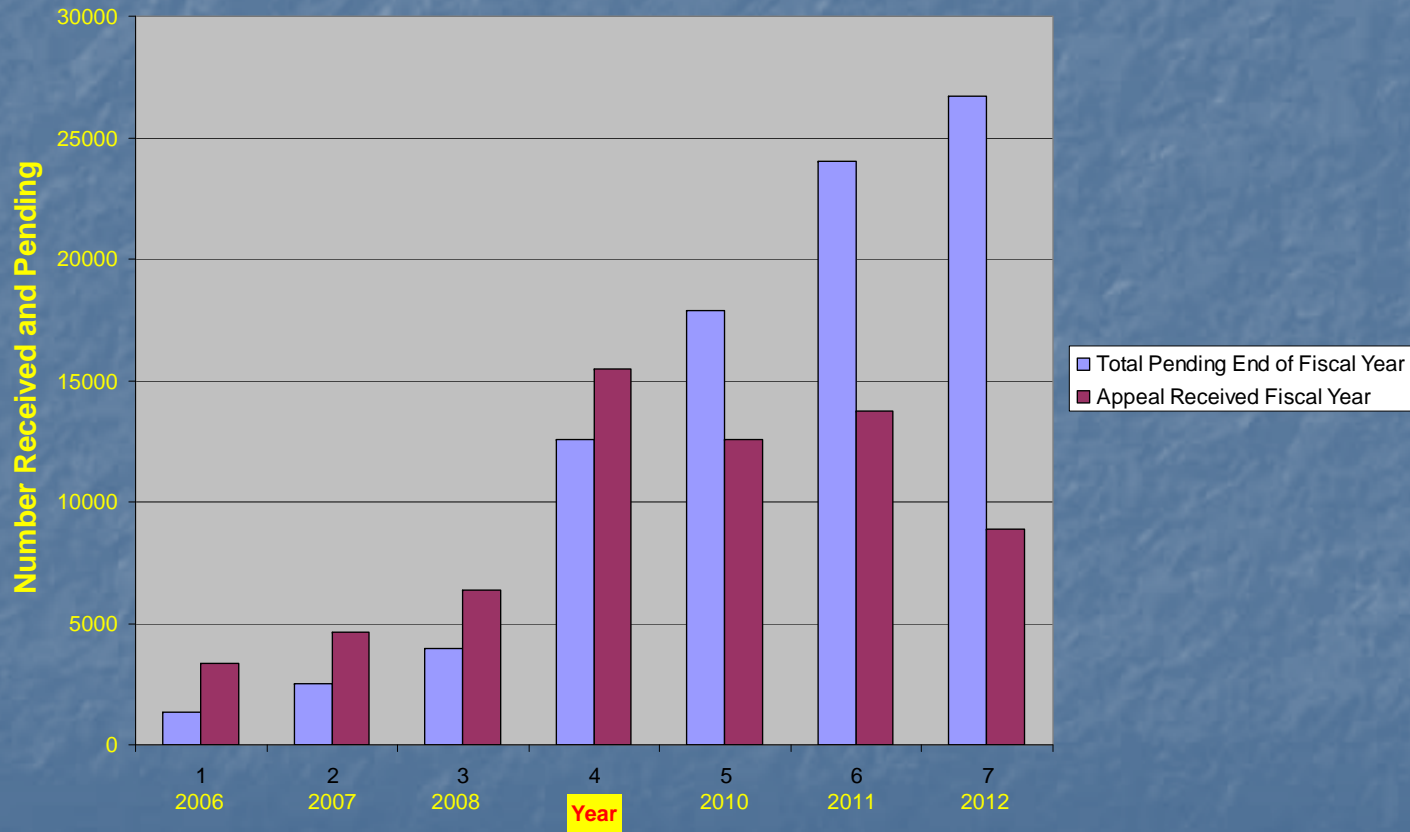
The Decision – Examiner Reversed, Aff'd in Part, or Remand

Application is sent back to the Examiner. The Examiner will either:

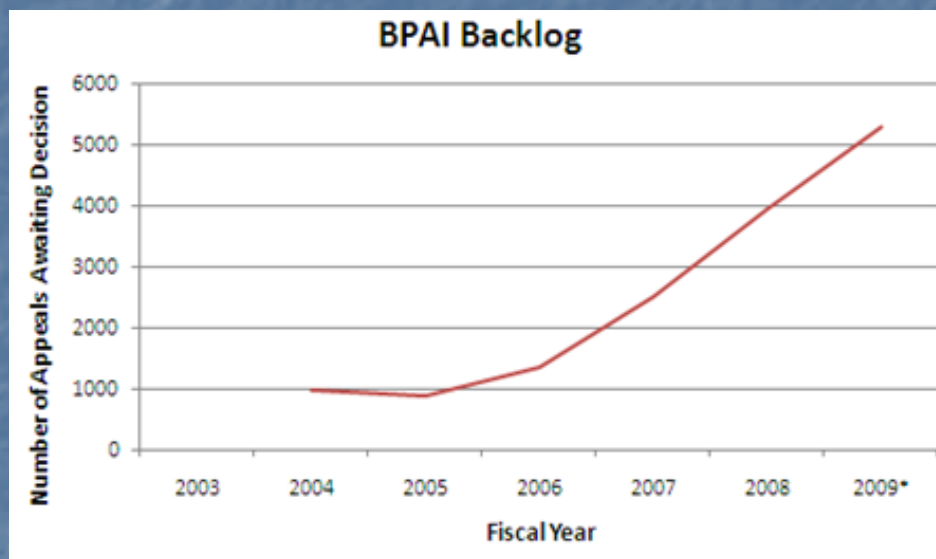
- Allow
- Issue new grounds for rejection

Statistics

Appeals



The Backlog Was Once 1000



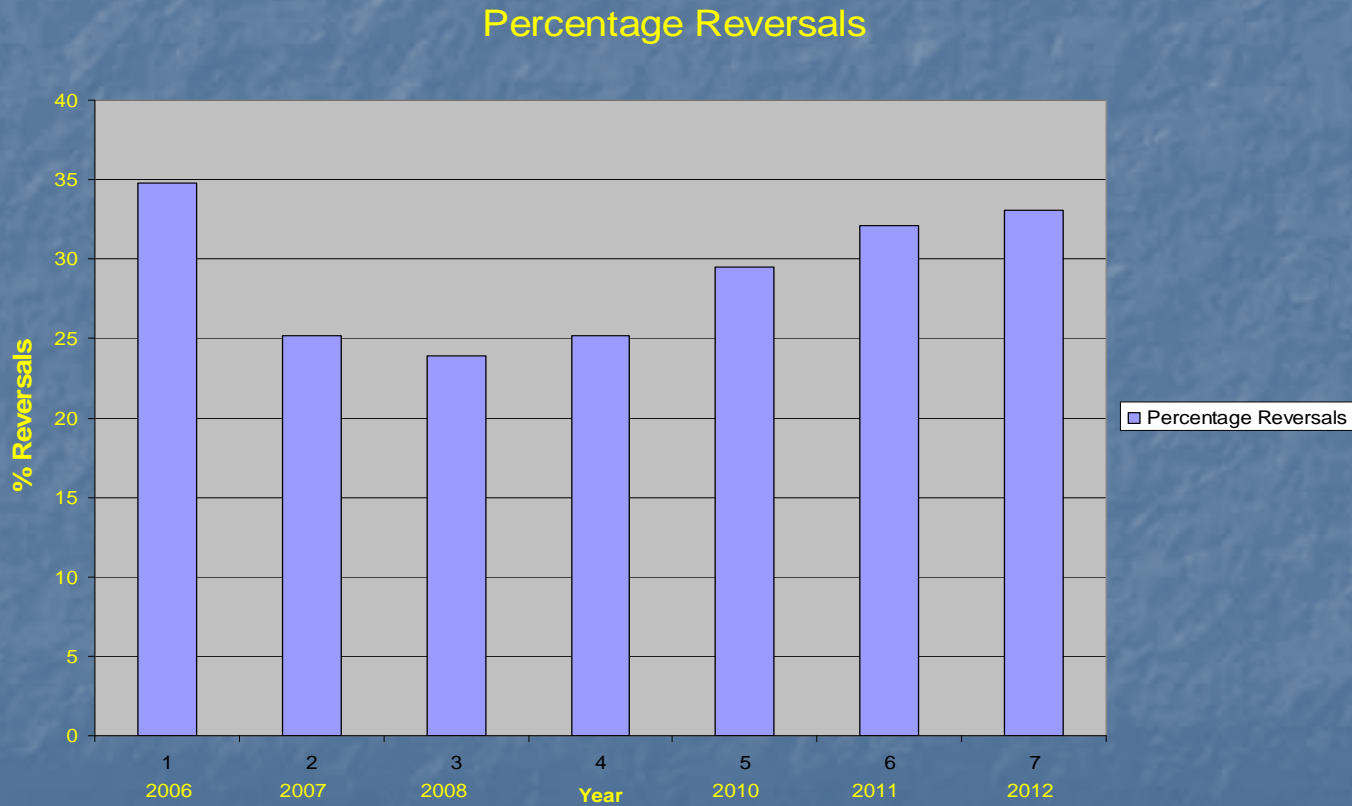
Source: Patentlyo.com

More Judges Being Hired



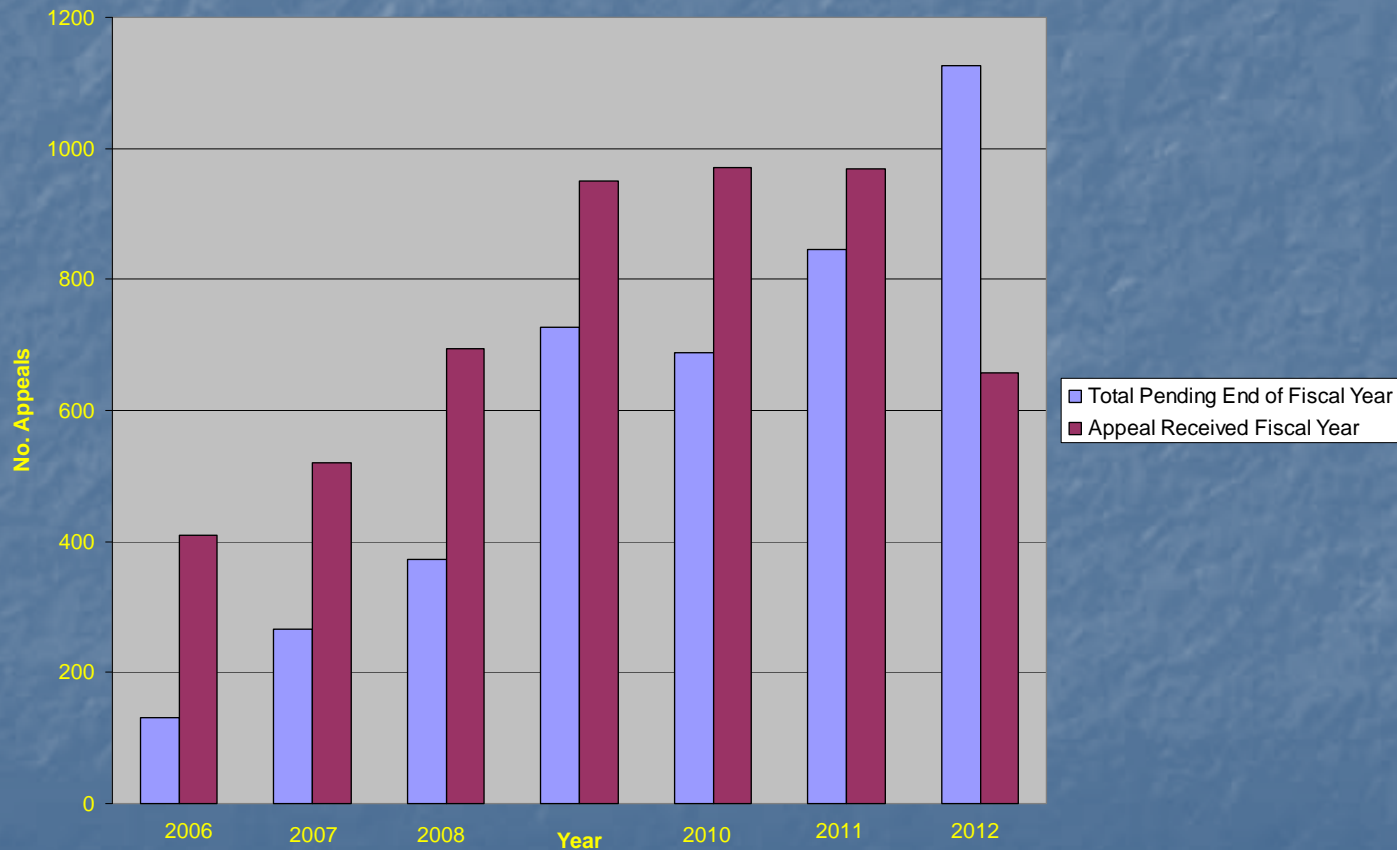
July 2, 2012: Jacqueline Wright Bonilla, Erica Franklin, James Housel, Deborah Katz, Neal Abrams, George Best, Andrew Caldwell, Thomas Giannetti, Andrew Metz and Grace Obermann. D. Kappos and Judge R. Rader on ends. Source: IP Watchdog.com

Overall Percentage Reversals

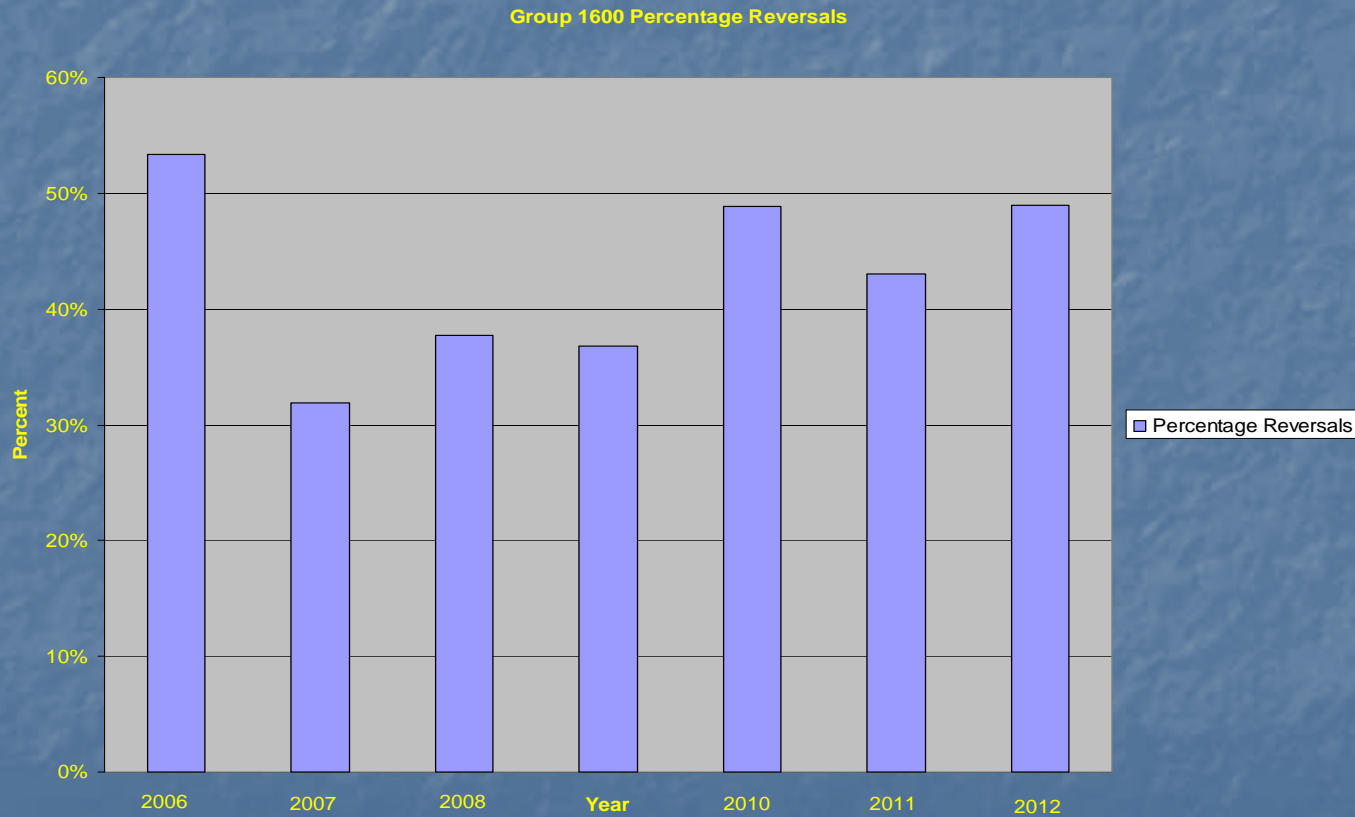


Art Unit 1600 - Appeals

Group 1600 Appeals

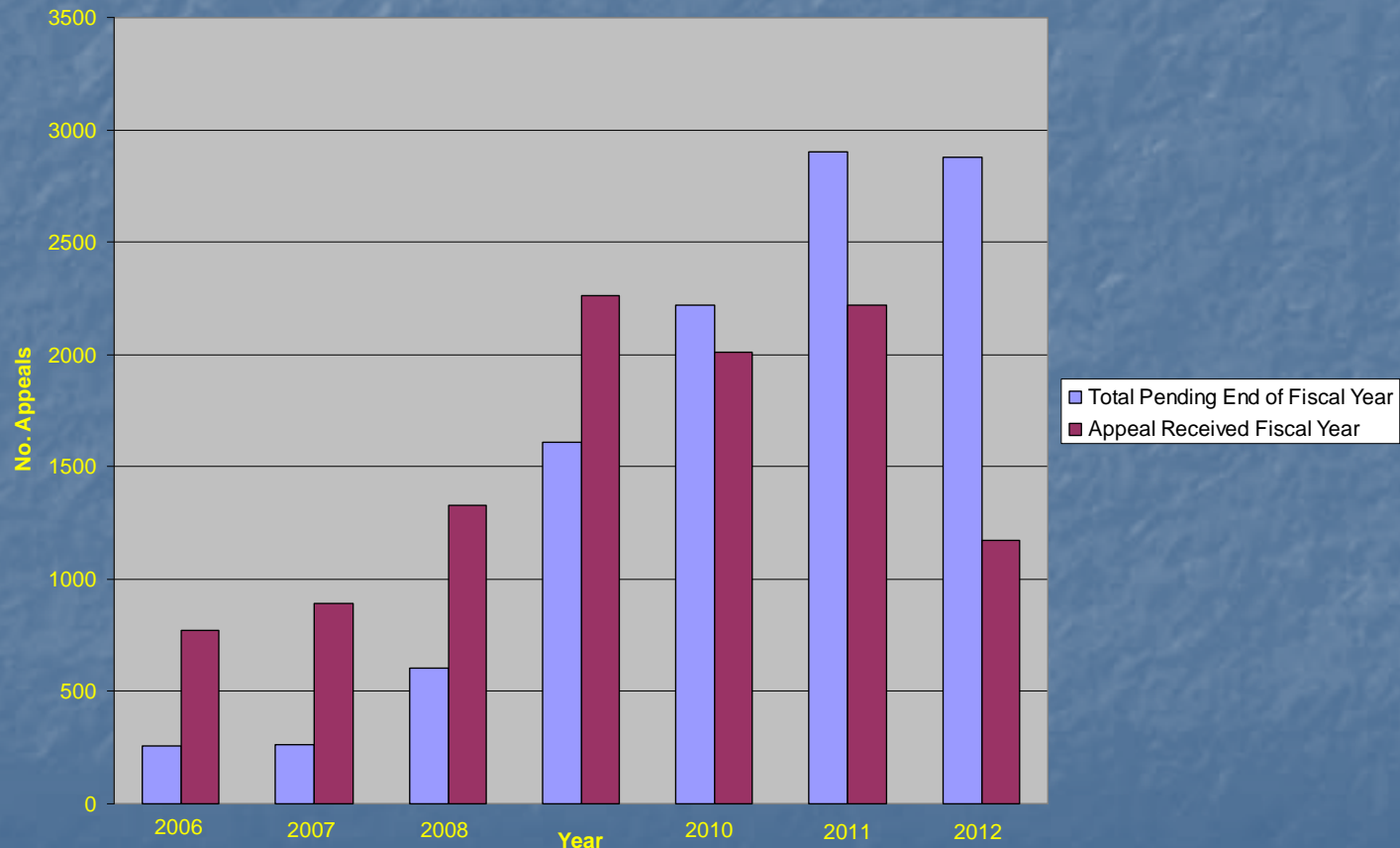


Art Unit 1600 - Reversals



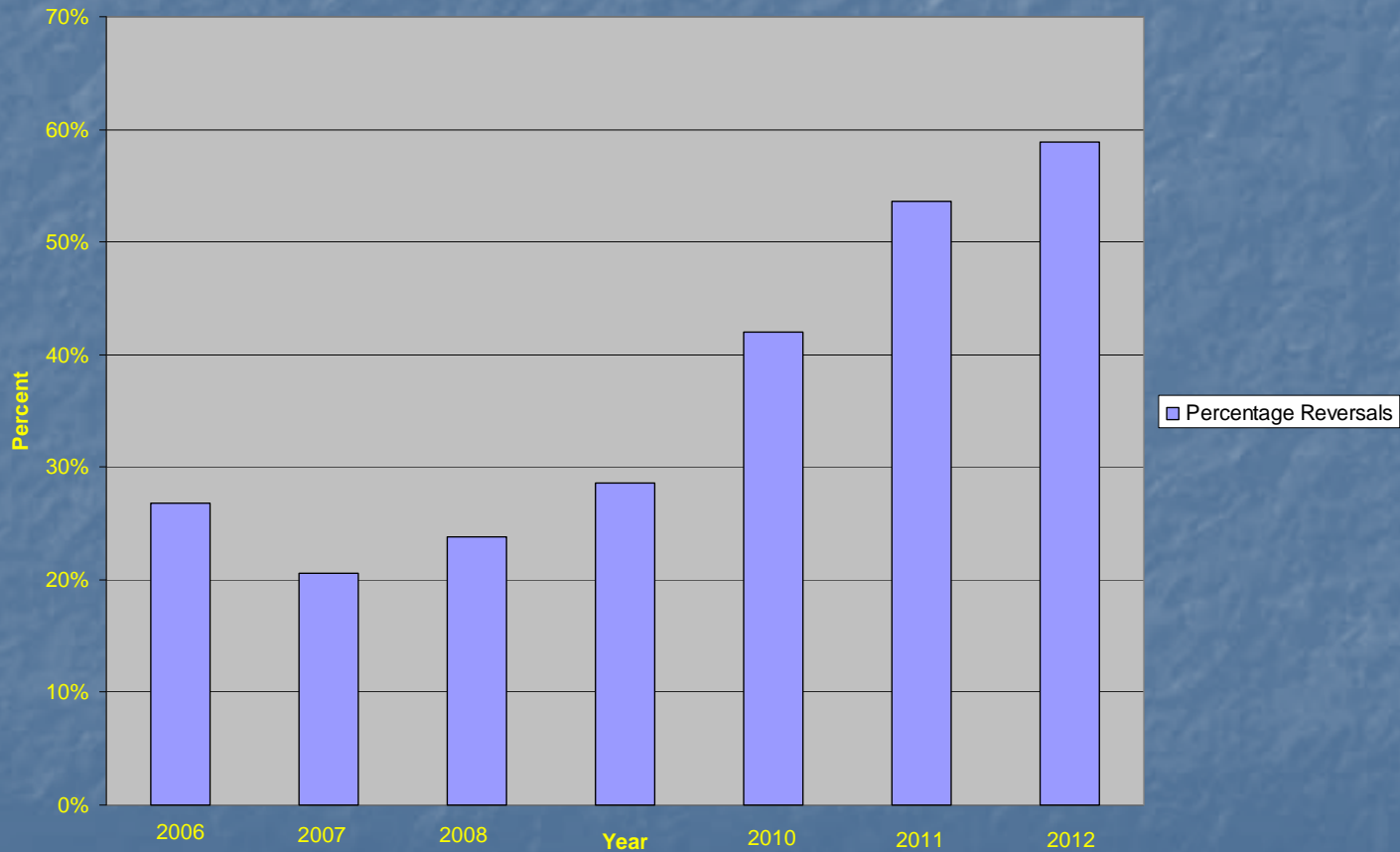
Group 1700 Appeals

Group 1700 Appeals



Group 1700 Reversals

Group 1700 Percentage Reversals



Thank You

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