

May It Please The Board
May 6, 2009

May it please the Board:

New Rules for Ex Parte Appeals to the Board - Need to Know.

The Director of the USPTO in his press release of June 9, 2008, said that the new rules will “improve the process of ex parte appeals,” “streamline the appeal process,” “crystallize the issues,” and “improve efficiency.” All will result, the Director explained, because the appeal process will have “improved efficiency,” “be more streamlined,” and “be more efficient.” *Id.*

Well said!

According to the Director, the requirements of the ex parte Appeal Brief will be clearer and compliance will be easier. Arguments will be concise and clear. As a result, decisions will be timely. Seemingly great news! Think again.

On June 11, 2008, one practitioner commented, “In reality, the new rules appear to significantly increase the number of formalities.” As a result, the same practitioner said, “The time and costs required to prepare an appeal are significantly increased.”

With all the above statements in mind, let us look at how the new rules will benefit you and me. You be the judge.

The patent bar has been informed:

- (1) The view is to move the Board to a more judicial role.

This first goal will be somewhat difficult to achieve, because many of the APJs now on the Board have little experience in patent prosecution, most have no litigation experience, and the majority have been on the Board less than five years.

- (2) One of the most important goals of the USPTO and BPAI is to reduce the rising pendency of patent appeals.

The number of patent appeals has more than doubled in less than two years. The work of all new patent examiners has been placed under rigid scrutiny, so they will let the Board allow applicants’ claims. There are new APJs who have never seen an Appeal Brief. New APJs are not quick to recognize critical issues and appear lost trying to decide those issues they do recognize. They refer to findings of law and conclusions of fact. Some are unprepared to perform their function and find nobody working at the workplace to guide them.

How can the Board overcome its limitations and achieve its goals? The answer is very simple. Force the patent lawyers and agents to help the APJs and examiners. Guide them. Show them the ways and means to decide cases. The patent bar can and must teach the Board how to distinguish between patentable and unpatentable subject matter and provide that teaching at nominal cost. Should patent attorneys decline to help, no problem, the Board will simply presume that applicants’ claims are unpatentable.

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The new rules were designed to require applicants to prove that their claims are patentable. This requirement is contrary to basic patent law. Make applicants do the work which the APJs and examiners do not have the wherewithal or time to do.

This is one explanation for the New Rules of Practice Before the Board in Ex Parte Appeals. It appears to make sense.

Check List For Ex Parte Appeals to the Board

Notice of Appeal (§41.31)

_____ must be filed within 2 months of the Final Rejection.

_____ must now be “signed”.

_____ time for filing the Notice of Appeal may be extended (6 mos. max §134)

Appeal Brief (§41.37)

Content (§41.37(e) - generally follows the Federal Rules of Appellate Practice)

_____ 1. Statement of the Real Party in Interest

_____ 2. Statement of Related Cases

_____ 3. Jurisdictional Statement

_____ 4. Table of Contents

_____ 5. Table of Authorities

_____ 6. Status of Amendments

_____ 7. Grounds of Rejection to be Reviewed

_____ 8. Statement of Facts

_____ 9. Argument

_____ 10. Appendix

_____ (i) Claims Section

_____ (ii) Claim Support and Drawings Analysis Section

_____ (iii) Means Plus Function Analysis Section

_____ (iv) Evidence Section

_____ (v) Related Cases Section

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_____ 30 pages for: 7. Grounds of Rejection to be Reviewed;
8. Statement of the Facts; and
9. Argument
_____ To Exceed 30 Page Limit for Appeal Brief, Petition the Chief APJ under §41.3

_____ Set Time for filing Appeal Brief – 2 months from the Notice of a Appeal

_____ To Extend the Time for Filing Appeal Brief, Petition under §1.136(a) (41.37(d))

_____ Page Numbering – Consecutive Arabic numerals starting with Page 1 of the Statement of Real Party of Interest and ending with the last page of the Appendix

_____ Double Space – double space everything (including footnotes) EXCEPT:

(headings)
(table of contents)
(table of authorities)
(signature blocks)
(certificate of service))

_____ Block quotations – left-hand indentation (block may be double or single spaced)

_____ Font – 14 point (everything, including footnotes)

_____ Standard Signature Block

Appellant or Representative
Registration Number
Correspondence Address
Telephone #
Fax #
E-mail address

_____ No Summary of Invention – replaced with APPENDIX

- Claims Section;
- Claim Support and Drawing Analysis Section (cite the page and line of the specification for descriptive support of each element of each independent and separately argued dependent claim); and
- Means Plus Function Analysis

_____ Headings – provide separate Headings for each Section, each Rejection, and each Point of Argument. The examiner will check for Headings and presume all requirements are satisfied when Headings for each Section, Rejection, and Point of Argument are presented

_____ STATEMENT OF THE REAL PARTY OF INTEREST

_____ STATEMENT OF RELATED CASES

_____ JURISDICTIONAL STATEMENT

IDENTIFY:

- _____ the statutory basis for the appeal, e.g., 35 U.S.C. §134
- _____ the date of the final rejection or the date the claims were twice rejected
- _____ the date the Notice of Appeal was filed
- _____ the dates of any extensions of time requested and granted (if known)
- _____ the date the Appeal Brief was filed

_____ TABLE OF CONTENTS

- _____ list the Contents - provide the first page for each Heading at far right

_____ TABLE OF AUTHORITIES

- _____ list cases in alphabetical order, e.g., Bond, In re, 16, 19
- _____ provide one citation for each case
- _____ cite Federal Reporters only, not USPQs.
- _____ cite Cases, Statutes, Regs., and MPEP in that order
- _____ provide the page number of the Appeal Brief where each citation appears in the Argument (provide pin-point cites for every quote or legal proposition in the Argument or the Board will not consider it)

Comment: Before 1995 the Table of Contents and Table of Authorities were readily generated using Word Perfect but could not be generated using Microsoft Word. Hopefully, Microsoft Word can now be used to generate these Tables at little expense.

_____ STATUS OF AMENDMENTS - indicate whether or not recent amendments were entered

_____ GROUND OF REJECTION

- _____ list in any order, e.g., Claims 1-10 are rejected under 35 U.S.C. §103 as being unpatentable in view of x and y.
- _____ petition to enter/consider evidence which was denied entry before filing the Notice of Appeal (if no petition is filed before appeal, the Board and the PTO will not consider the evidence after the appeal is decided - the same rejection may not be appealed twice)
- _____ rejections are appealable under 35 U.S.C. §134 (matters of procedure and Office discretion are petitionable, not appealable)
- _____ amend claims before the final rejection - amendments filed after final rejection must be accompanied by a showing of good cause why the amendment was not presented earlier (amendments canceling claims, placing claims in better condition for appeal, and/or reducing issues on appeal may be entered at the Examiner's discretion)

_____ STATEMENT OF FACTS (new - very important change)

This section of the Appeal Brief is a most important new section. The Statement of the facts can and will make or break the case on appeal. Applicant should tell his story clearly and objectively, i.e. the facts themselves show that the Examiner's rejection ought to be reversed. All the unsupported arguments in the world will not persuade the Board unless they are backed by objective evidence of record, i.e., the statement of the facts is a list of everything the evidence shows.

_____ A. List facts under the sub-heading relating to each separate rejection and label them, e.g. F103-1; F112-1; F103-2

_____ B. Use short statements, preferably one sentence for each fact and ALWAYS cite to the record (page and line). e.g. (NORRIS, p. 3, 1st ¶, pp. 8-12; Spec., p. 3, 2nd ¶, pp. 10-11)

_____ C. Findings made by the examiner which are not contested will be presumed accurate.

_____ ARGUMENT

_____ A. Back up each conclusion or point of argument by facts listed in the Statement of Facts and cite to the supporting facts listed in the Statement of Facts, e.g. F103-1; F112-2

_____ B. Respond to every point, conclusion, and argument in the Final Rejection and Examiner's Answer or concede the Examiner's point, conclusion, or argument. At minimum, always state the Examiner has not explained . . ., has not shown . . ., or has not met his burden

_____ C. Arguments based on precedent, statute, or a rule will not be considered without citing the pages and lines of the precedent, statute, or rule (SURPRISE: the MPEP is nothing more than a lot of guidelines)

_____ D. Argue dependent claims separately or they will stand or fall with the independent claims

_____ E. Argue each independent claim separately or the Examiner will select the best claim for his purposes

_____ F. Place every separate argument under a separate sub-heading

_____ G. Left uncontested, the Examiner's statement of facts, conclusions of law, and arguments shall be presumed correct. All subsequent contests are waived

_____ H. Don't argue petitionable matters. If you must petition, do it before the appeal or waive the issue. Neither the Board nor any other body of the PTO will allow Applicant to appeal the same issue again, especially if the evidence could have been entered by petition before the appeal and considered on appeal.

_____ I. Lead with claim interpretation if claim interpretation is outcome determinative

_____ J. FOCUS ON THE REASONS WHY THE EXAMINER ERRED. – EXPLAIN and SUPPORT by citation to STATEMENT OF FACT section, legal precedent, etc.

_____ K. For each argument – IDENTIFY if, when, and where the argument was previously presented or label it as a NEW ARGUMENT

_____ L. Each ground of rejection must be separately argued under a SEPARATE SUB-HEADING.

_____ M. Arguments not made in the Argument section of Appeal Brief are waived.

_____ N. Claim interpretation; Enablement; Obviousness; and Indefiniteness are all questions of law based on underlying facts – show the examiner erred

_____ O. Anticipation and Written Description are questions of fact - show the examiner clearly erred

_____ APPENDIX

_____ A. Claims Section

_____ present accurate, clean copies of all pending claims (INCLUDING ALLOWED AND CANCELLED CLAIMS) in numerical order

_____ must provide full text and specify status of every claim as:

1. (rejected);
2. (withdrawn);
3. (objected to);
4. (cancelled);
5. (allowed)

_____ B. Claim Support and Drawings Analysis Section.

For each independent and separately argued dependent claim:

_____ annotate the claims and claim/claims from which they depend.

Annotate DNA sequences by reference to Figures or drawings

_____ annotate using Boldface between braces ({ **XXXXX** })

_____ provide page and line or paragraph after each claim limitation specifying where it is described in the specification and/or drawings

_____ C. Means Plus Function Analysis

-avoid means plus function language like a plague; analysis very complex with references to examples in the Specification

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_____ D. Evidence Section – only evidence “entered by the examiner”; apparently not including Specification and applied prior art (to be safe, include Specification and prior art)

_____ provide a Table of Contents for

_____ Affidavits and Declarations

_____ Other evidence filed and entered before Notice of Appeal that is mentioned in Appeal Brief.

_____ Evidence not provided in the Evidence Section will not be considered

_____ Evidence entered into file after Notice of Appeal.

_____ E. Related Cases Section - provide copies of pertinent orders and opinions in related cases

_____ EXAMINER’S ANSWER (§41.39)

- no time limits
- no criteria
- no standards
- no specifications
- no limitations EXCEPT: 1. No new grounds of rejection.

LIFE IS NOT FAIR!

The new rules have one paragraph relating to the Examiner’s obligations. The Examiners will do what, when, and how the Director directs.

_____ REPLY BRIEF

Contents:

_____ reply to Examiner’s Answer.

_____ same rules which apply to Appeal Brief EXCEPT:

_____ 20 pages starting with Grounds of Rejection to be Reviewed

_____ File within 2 months of Examiner’s Answer

_____ Time for filing Reply Brief and number of pages may be extended by petition to the Chief of Board under §41.3.

Requests to extend time and increase the number of pages of the Reply Brief will not be decided by an APJ and may not be decided by a person legally or technically proficient (an administrative generalist or a legal advisor, not an APJ or a Patent Attorney)

_____ Statement of Additional Facts

_____ each additional fact must cite the page and line of the Examiner’s Answer where the point to which Applicant is responding appears. If no reference to the Examiner’s Answer is provided, the additional fact will not be considered and the Applicant waives the Examiner’s point.

_____ **NO NEW EVIDENCE MAY BE PRESENTED IN REPLY BRIEF**—however, Appellant must respond to any new evidence presented in the Examiner’s Answer

SUPPLEMENTAL EXAMINER'S ANSWERS ARE NOT ALLOWED

- less and less work for Examiners.

DOCKET NOTICE

After the Appeal Brief, the Examiner's Answer, and the Reply Brief have been filed, the case will be transferred to the Board – physically or electronically.

A DOCKET NOTICE will be mailed and dated.

Jurisdiction of the Board begins when the Docket Notice is mailed - however, authority to act on petitions to extend the time for filing a Reply Brief and increase the number of pages of the Appeal Brief and Reply Brief has been delegated to the Chief of the Board long before the Board has jurisdiction over the appeal. §41.3 applies even though the Board does not have jurisdiction over the case. How quickly the Chief can and will respond to a petition under §41.3 is uncertain. Potential fiasco. The safest bet always is to **TIMELY FILE THE REPLY BRIEF and ADHERE TO THE PAGE LIMIT REQUIREMENTS** for all Briefs.

ORAL ARGUMENT

- _____ A Written Request for Oral Argument must be filed within two months of the Examiner's Answer
- _____ extend the time for filing the Written Request by petitioning the Chief of Board under §41.3
- _____ the Board sets the date for Oral Hearing
- _____ Appellant must confirm attendance on the date the Oral Hearing is set or waive oral argument
- _____ Since all oral arguments/hearings are now transcribed by a court reporter, Applicant must furnish a list of technical terms and unusual words at the time attendance at Oral Hearing is confirmed.
- _____ 20 minutes for Oral Argument
- _____ argument limited to "the Record"

The "Record" includes all papers entered during prosecution. However, the APJs are unlikely to have reviewed more than the Briefs and the Prior Art before the Oral Hearing. Use the EVIDENCE SECTION of the APPENDIX as needed to place other documents of record before the APJs.

- _____ discussion of new Fed. Cir. Decisions is always allowed.
- _____ visual aids – 4 copies: 3 for judges and 1 for the record

APJs often are inadequately prepared for oral argument. Accordingly, Oral Argument may be a total waste of time. At best, the APJ assigned to write the opinion for the Board will have read the Briefs and summarized the issues for the other two APJs on the panel at a meeting immediately before or a day or two before the Hearing. New APJs are not inclined to ask questions at Oral Hearing, especially when the hearing is transcribed.

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_____ Applicant may, however, rephrase or clarify a position for the record in a manner that could not be done in the allotted 30 pages of the Appeal Brief and 20 pages of the Reply Brief.

_____ begin Oral Argument by proceeding directly to the critical points where the Examiner erred

_____ assume the panel knows the subject matter (APJs should be familiar with the facts of the case. Assume they are.)

In truth, very few APJs are well prepared for Oral Hearings. Given the PTO's new push for increased numbers of opinions to be authored by each APJ at the Board, I am sorry to say that APJs no longer have sufficient time to thoroughly check the complete record to ensure that the Board reaches the correct result. New Grounds of Rejection are not likely to be entered by a panel. New rejections are frowned upon by the Chief and must be approved by all three panel members.

The PTO's initial burden to establish unpatentability, irrespective of Congress's design and the decisions of Courts of Appeals, appears to have been eliminated by the new rules. Now, Applicant is required to show that the claimed subject matter is patentable.

_____ REQUEST FOR REHEARING (RECONSIDERATION)

_____ file within two months of the Board's Decision

_____ Contents:

_____ 1. Table of Contents

_____ 2. Table of Authorities

_____ 3. Argument – no new facts or issues

_____ identify and argue all points misapprehended or overlooked
_____ 10 pages for Argument (excluding Tables of Contents and Authorities)

The Request for Rehearing is a WASTE OF TIME UNLESS THE BOARD CLEARLY ERRED or the Board entered a New Ground Of Rejection without acknowledging it. The problem is the Board is not likely to grant the Request For Rehearing for any reason.

In Ex Parte Appeals to the Board, the New Rules of Practice require Appellants who seek to have appeals decided in their favor to show that the subject matter they claim is patentable. The Office no longer has the initial burden to show unpatentability.

Teddy S. Gron