

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Boardside Chat: Ex Parte Appeals

Administrative Patent Judges Bradley Garris, Linda Horner, and John Jeffery

Patent Trial and Appeal Board
Webinar Series (2 of 5)
April 7, 2015

UNITED STATES
PATENT AND TRADEMARK OFFICE



Boardside Chats

Date	Time	Topic	Speakers
Tuesday, June 2	Noon to 1 pm Eastern Time	Discovery in AIA Trials	Panel of Practitioners and Administrative Patent Judges
Tuesday, August 4		AIA Rulemaking and Guidance Changes	Lead Judge Susan Mitchell
Tuesday, October 6		Best Practices before the PTAB	Panel of Administrative Patent Judges

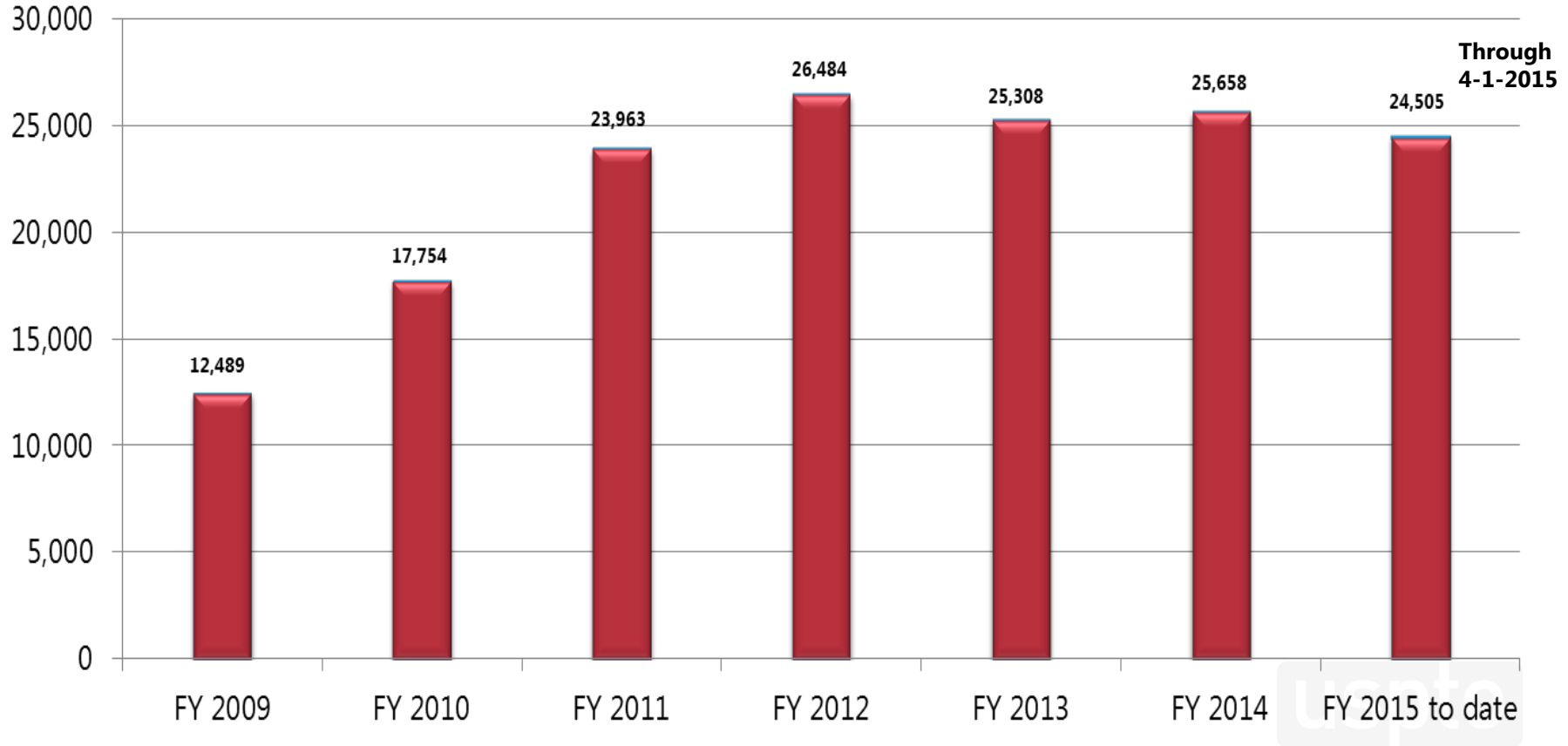
Agenda

Topic	Presenter
Ex Parte Appeal Statistics	Judge Horner
Appeal Process	Judge Garris
Appeal Resources on PTAB Website	Judge Jeffery
Panel Discussion on Effective Advocacy	Judges Garris, Horner, and Jeffery
Q&A	Ms. Gongola (moderator)

Ex Parte Appeal Statistics

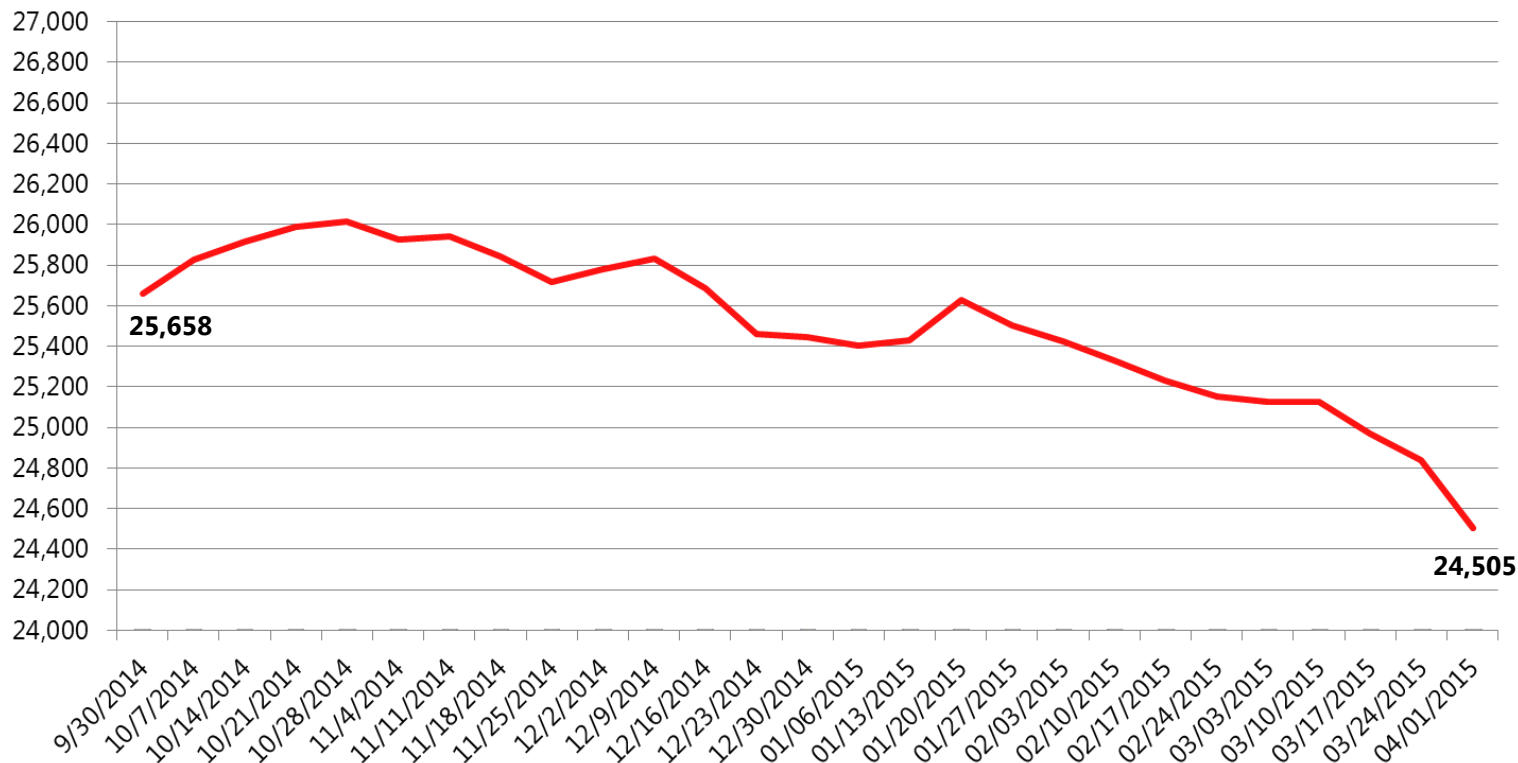
Pending Ex Parte Appeals

(excluding appeals from reexamination proceedings)



Pending Ex Parte Appeals

(excluding appeals from reexamination proceedings)



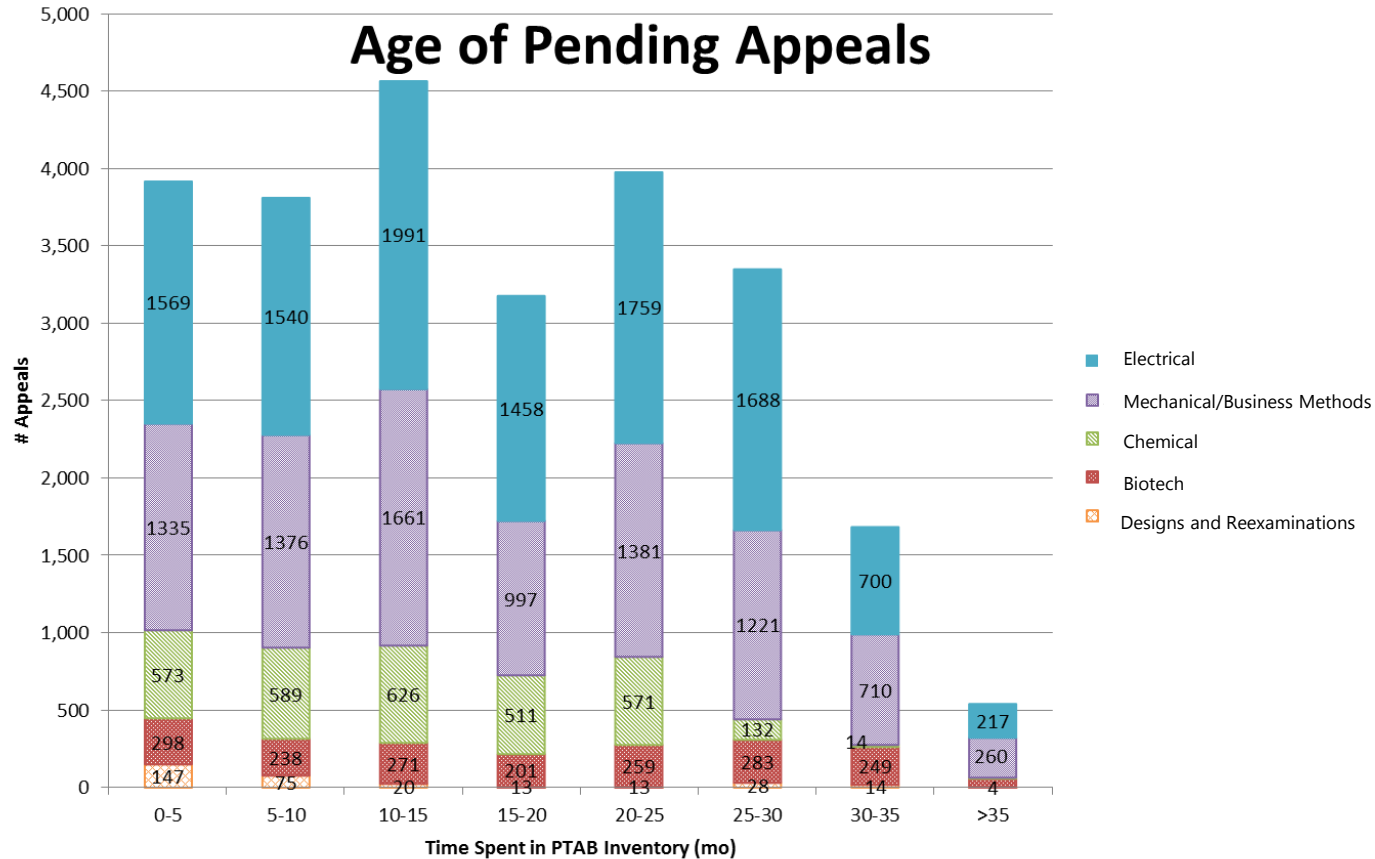
PTAB Receipts and Dispositions

Data from 02/28/2015 thru 03/31/2015

<i>Discipline</i>	<i># Cases Received</i>	<i># Cases Disposed</i>	<i>Difference (Disposed minus Received)</i>
Biotech	66	53	-13
Business Methods	43	117	74
Chemical	121	164	43
Reexamination	84	40	-44
Design	4	4	0
Electrical	315	743	428
Mechanical	202	267	65
Totals	835	1388	553

Age of Pending Appeals by TC

Data as of 3/15/2015



Pendency of Decided Appeals

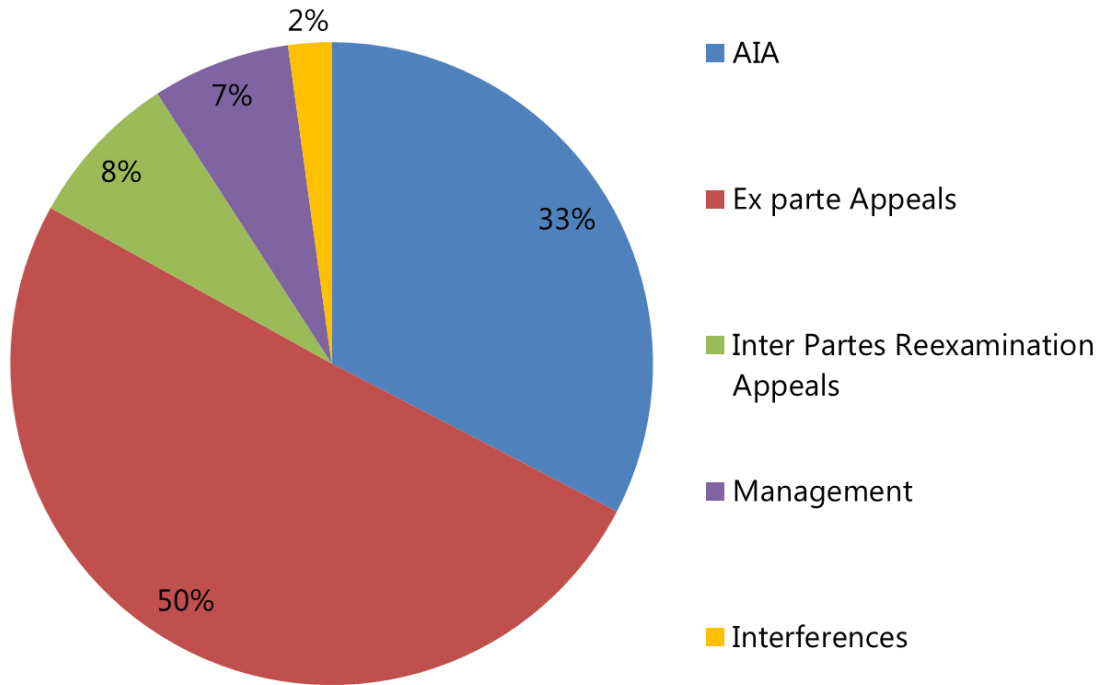
Data from 10/1/2014 through 3/31/2015

Discipline	Technology Center	Number of Decisions	Pendency from PTAB Docketing to Decision (Months)
Biotech	1600	224	31.5
Chemical	1700	661	24.6
Electrical	2100	830	32.0
	2400	984	32.1
	2600	761	31.7
	2800	409	27.0
Designs	2900	11	26.1
Mech/Bus Methods	3600	961	31.7
	3700	770	30.0
Reexams	3900	138	5.6
Total Average		5,749	29.8



Allocation of Judges

Data as of March 23, 2015



Total Number of Judges: 230



Outcomes

Data from FY2015 through end of February 2015

Discipline	Tech Center	Affirmed	Affirmed-in-Part	Reversed	Remanded	Dismissed
Biotech	1600	57.6%	11.0%	24.4%	1.2%	5.8%
Chemical	1700	62.6%	10.0%	26.2%	<1%	<1%
Electrical	2100	59.6%	11.7%	28.4%	<1%	<1%
	2400	60.1%	13.5%	25.0%	<1%	1.0%
	2600	63.3%	11.1%	25.2%	0%	<1%
	2800	54.8%	10.8%	33.8%	0%	<1%
Designs	2900*	85.7%	0%	14.3%	0%	0%
Mech/Bus Methods	3600	43.9%	15.6%	38.9%	<1%	1.1%
	3700	40.8%	18.4%	37.7%	<1%	2.6%
Reexams	3900**	70.6%	15.7%	9.8%	2.0%	2.0%
Total Ave.		55.2%	13.3%	30.0%	0.3%	1.2%

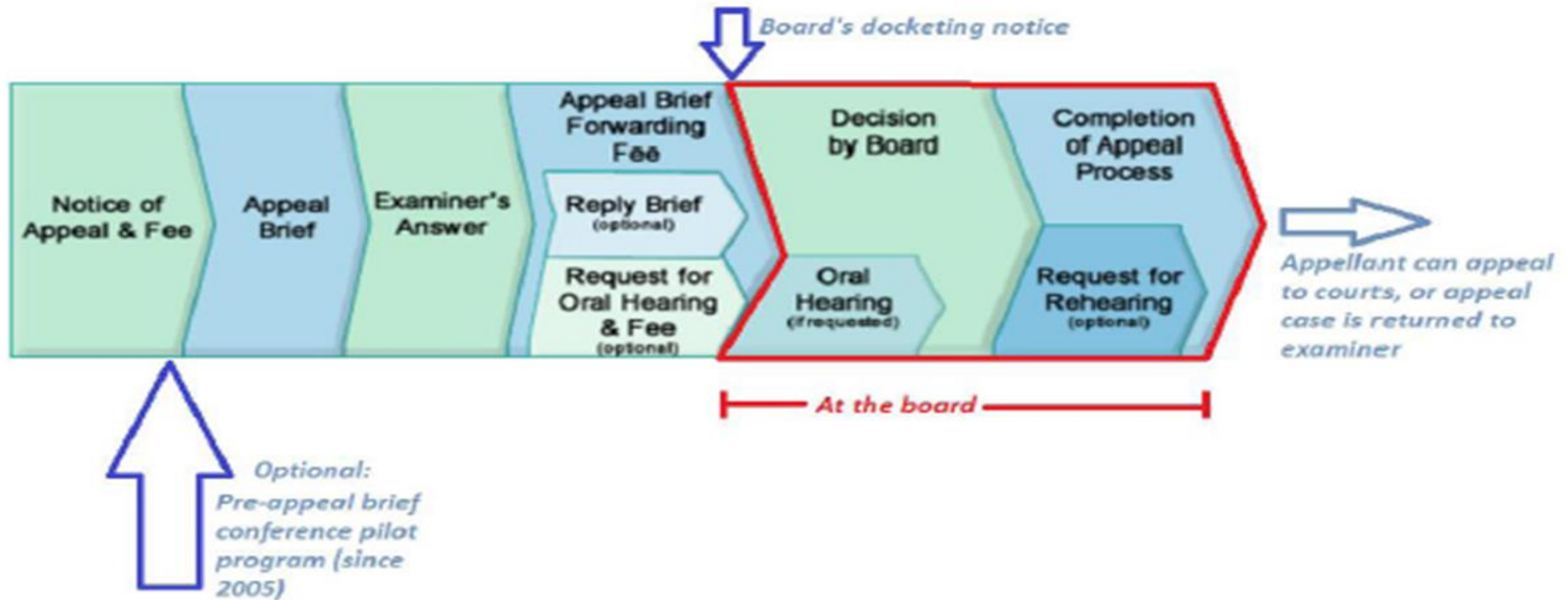
* Data set comprised of 7 decisions. ** Data set comprised of 102 decisions.



Appeal Process

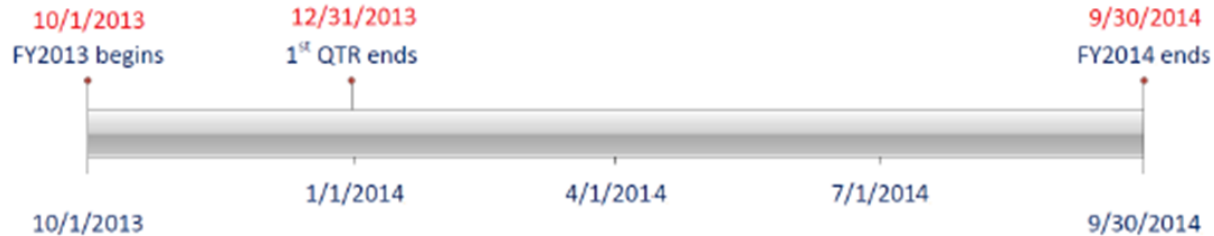
Appeal to PTAB: Ex Parte Appeals

Appeals - General Process



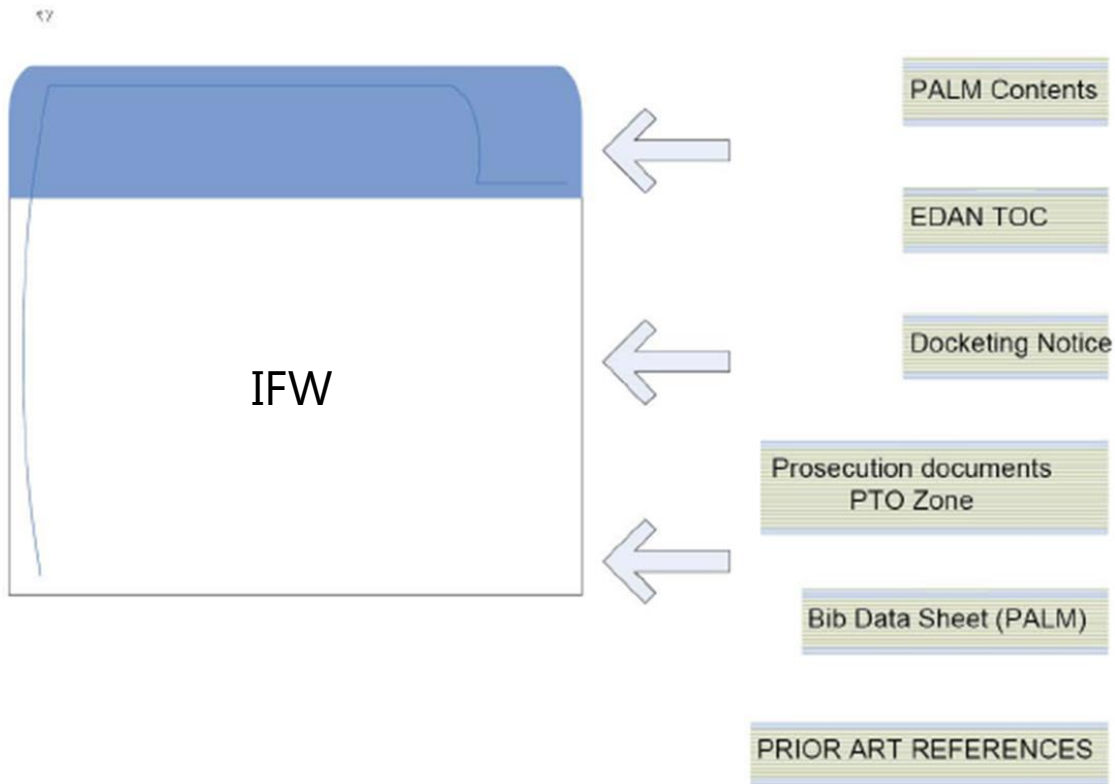
Assignment of Appeal Number

The Fiscal Year



Appeals received at the Board during FY 2014 are serially numbered 2014-000001, 2014-000002, etc.

Image File Wrapper (IFW)



Ex Parte Oral Hearings

- ✦ The Oral Hearing may be in the form of a personal appearance, telephonic presentation, or a video conference via the electronic hearing room.



- ✦ The rules covering presenting an Oral Hearing Request may be found in 37 CFR Section 41.20 regarding fees, and Section 41.47 regarding the Oral Hearing.

Requesting an Oral Hearing

- ✦ After the Applicant has presented an Appeal Brief, if the Patent Examiner assigned to the application proceeds with an Examiner's Answer, the Applicant has the option of Requesting an Oral Hearing.
- ✦ The Request for Oral Hearing needs to be filed within two months of the mailing date of the Examiner's Answer, and contain the required fee.



two months



Processing at PTAB



The Board sends appellant a Notice containing the time, day and location of the oral hearing.

- It is Board policy to give Applicant 21 days to respond back to the PTAB as to whether attendance at the Oral Hearing is being confirmed or waived.



21 Days



Hearing Notice

Confirmation or Waiver

- Applicant also states who will be attending the Oral Hearing if a personal appearance is being made.
- There is no refund of the Oral Hearing fee if the Oral Hearing is waived.



Processing at PTAB

- + If the Oral Hearing is to be conducted either by telephone or by video conference, a request for such needs to be filed with the confirmation.
- + It is recommended that communications regarding postponements, telephonic hearings, and video conference hearings be made via facsimile transmissions due to time constraints.



PTAB Hearing Fax number (571) 273-9797

Appeal Resources on PTAB Website

PTAB Link on USPTO Home Page

www.uspto.gov/ptab

The screenshot shows the top navigation bar of the USPTO website. The logo 'uspto' is on the left, followed by 'UNITED STATES PATENT AND TRADEMARK OFFICE'. On the right, there are links for 'About Us', 'Careers', and 'Contact Us', and a search bar with the text 'Search uspto.gov'. Below the navigation bar, there are tabs for 'Patents', 'Trademarks', and 'Learning and Resources', along with a 'Quick Links' dropdown menu. The main banner area features a blue background with the text 'Patent & Trademark Resource Centers (PTRC)' and a sub-headline 'Take advantage of local Patent & Trademark Resource Centers to get help getting started with patents or trademarks.' A button labeled 'Find a PTRC near you' is visible. On the right side of the banner, there is a technical drawing of a mechanical part with labels like 'Fig. 2' and 'Patent No. 5,450,953'.

Patent Trial and Appeal Board

The Patent Trial and Appeal Board's duties include review of adverse decisions, review of appeals of reexaminations, derivation proceedings, inter partes and post-grant reviews, and rendering decisions on interferences.

Learn About the Process

Patents

? General Information Concerning Patents

Find out if a utility, design, or plant patent is right for you

≡ Patent Process Overview

An overview of a patent application and maintenance process

🔍 Search for Patents

Find existing patents, published patent applications and other published patent documentation

Trademarks

™ Trademark Basics

Learn about trademarks and find out if it's right for you to apply for registration

≡ Trademark Process

An overview of a trademark application and maintenance process

🔍 Search Trademark Database

Search database for trademark registrations and applications by mark, owner, or serial/registration number with Trademark Electronic Search System (TESS)

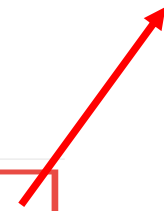
Patents & Trademarks Initiatives

Enhanced Patent Quality Initiative

Learn about USPTO efforts to increase patent quality, including the upcoming Patent Quality Summit...

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Accessing PTAB Web Page via Patents Site

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Patent Tools & Links

PatFT **AppFT**

Search for Patents
Find existing patents, published patent applications and other published patent documentation

EFS-Web

File Online
File a patent application online with EFS-Web

PAIR

Check the Status of Your Application
Check patent application status with Public and Private PAIR

Fee Schedule
Application, maintenance fees & payment information for Patents and Trademarks

Patents Forms
Find existing patents and public patent applications

Patent Trial and Appeal Board
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EPAS **AOTW-P**

Patents Assignments: Search & Change Ownership
During the examination of pending patent application as well as after the patent is granted, the owner may create and submit a Patent Assignment Recordation Coversheet to change patent ownership or owner

Laws, Regulations, Policies, Procedures, Guidance and Training
Domestic and international rulemaking and law enforcement



PTAB Web Site: Appeals

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Appeals

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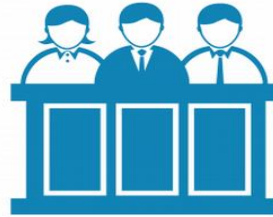
 Trials This page includes information about proceedings conducted by the Patent Trial and Appeal Board, including inter partes review post-grant review, the transitional post-grant review for covered business method patents, derivations and interferences.	 Appeals This page includes information about appeals conducted by the Patent Trial and Appeal Board from adverse decisions of examiners in patent applications, reissue applications, and reexamination proceedings.	 Decisions This page includes links to all public, final agency decisions of the Patent Trial and Appeal Board, including decisions designated as precedential or informative.
 Hearings This page contains information concerning presenting oral argument for appeals, interferences, and AIA trials conducted by the Patent Trial and Appeal Board.	 Resources The page contains policies, procedures, rules, guides, tools and manuals which are associated with proceedings before the Patent Trial and Appeal Board.	 Statistics Periodic summaries of data concerning proceedings before the Patent Trial and Appeal Board, including dispositions, pendency, inventory, and other tracking measures.
 About PTAB The Patent Trial and Appeal Board is created by statute, and includes statutory members and Administrative Patent Judges. The PTAB is charged with rendering decisions on: appeals from adverse examiner decisions, post-issuance challenges to patents, and interferences.	 Help Click here if you are you looking for more information about the Patent Trial and Appeal Board?	 Now Hiring Are you interested in learning more about being a judge or applying for a position at the Patent Trial and Appeal Board?
 Events Click here to locate an event with PTAB judges at a speaking engagement.	 What's New Are you looking for the latest news about PTAB?	 System Maintenance Any system maintenance announcements will be posted here.
 Suggestion Box Click here, if you are interested in providing any suggestions to PTAB.		

PTAB Web Site: Appeals Resources

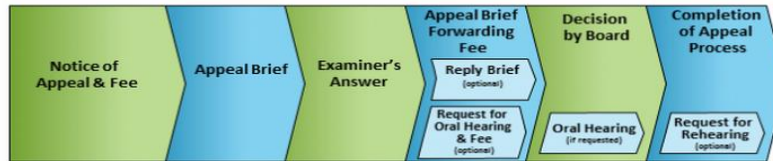
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- ▶ [Board Rules for Ex Parte Appeals](#)
- ▶ [Board Rules for Inter Partes Appeals](#)
- ▶ [Practice Tips and Checklists to Reduce Non-Compliant Briefs](#)
This page includes a listing of the top eight reasons briefs are found to be non-compliant, checklists used by the Office to determine if briefs comply with the rules, and forms used by the Office to notify parties of non-compliant briefs.
- ▶ [Practice Tips for Writing Effective Appeal Briefs](#)
- ▶ [Suggestion Box](#)
- ▶ [Frequently Asked Questions \(FAQs\)](#)



Appeals – General Process



Reference Materials

- ▶ [Board Rules for Appeals Filed Before January 2012](#) [\[PDF\]](#)
- ▶ [MPEP Chapter 1200 \(Appeals\)](#)
- ▶ [MPEP Chapter 2200 \(Ex Parte Reexamination\)](#)
- ▶ [MPEP Chapter 2600 \(Inter Partes Reexamination\)](#)
- ▶ [Guidance on Petitions Under CFR Rule 41.3 to the PTAB](#)
- ▶ [Fee and Payment Information](#)
- ▶ [Forms](#)
 - ▶ [AIA/31 Notice of Appeal](#)
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- ▶ [EFS-Web](#)




Appeals: Board Rules

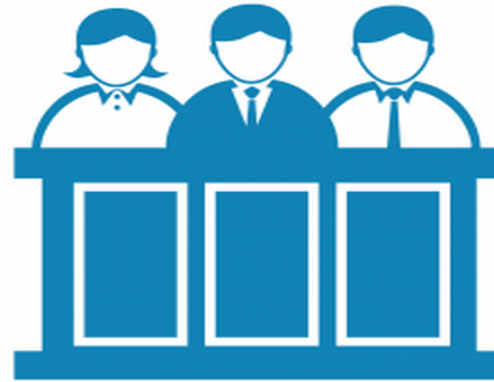
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Appeals: Practice Tips for Writing Effective Appeal Briefs

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Appeals: Practice Tips for Writing Effective Appeal Briefs

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.




Appeals: Suggestion Box & FAQs

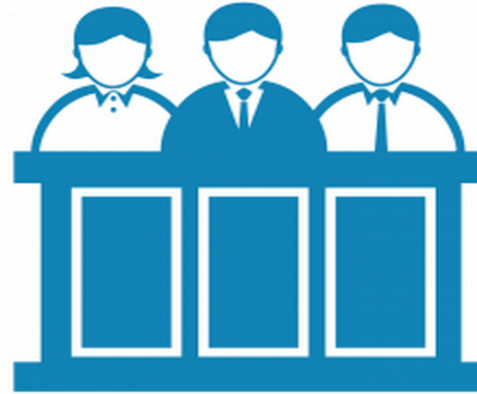
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PTAB Web Site: Decisions

[Home](#) / [Patents: Application Process](#) / **Patent Trial and Appeal Board**

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PRPS will not be able to accept credit and debit card payments on Saturday, March 28, 2015 from 6:00 pm – 12:00 am for newly filed petitions. Payments may still be made by deposit account during this time.
For additional details, see <http://www.uspto.gov/blog/ebiz/>.

<h3>Trials</h3> <p>This page includes information about proceedings conducted by the Patent Trial and Appeal Board, including inter partes review post-grant review, the transitional post-grant review for covered business method patents, derivations and interferences.</p>	<h3>Appeals</h3> <p>This page includes information about appeals conducted by the Patent Trial and Appeal Board from adverse decisions of examiners in patent applications, reissue applications, and reexamination proceedings.</p>	<h3>Decisions</h3> <p>This page includes links to all public, final agency decisions of the Patent Trial and Appeal Board, including decisions designated as precedential or informative.</p>
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Decisions

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Decisions: Precedential & Informative Board Decisions

This page includes links to all public, final decisions of the Patent Trial and Appeal Board, including decisions designated as precedential or informative.

- [Precedential Opinions \(2014OCT06\) \[MSExcels\]](#)
- [Informative Opinions](#)
 - [Informative Opinions \(2015JAN06\) \[MSExcels\]](#)

- [Final Decisions](#)
- [Key Decisions Involving Functional Claiming](#)
- [Representative AIA Trial Orders, Decisions, and Notices](#)
- [NOTE: Some material listed on this page may require a plug-in or viewer, \[available here\]\(#\).](#)



Precedential Opinions Spreadsheet

PTAB Precedential Opinions

Case Name	Case Number	Case Type	Date Issued	PTAB Procedure	101	102	103	112	251	Other
SecureBuy LLC v. CardinalCommerce Corp.	CBM2014-00035	AIA	04/25/14							x
Ex parte Mewherter	2012-007692	Appeal	05/08/13		x					
Ex parte Moncla	2009-006448	Appeal	06/22/10	x						
Ex parte Quist	2008-001183	Appeal	06/02/10	x			x			
Ex parte Frye	2009-006013	Appeal	02/26/10	x						
Ex parte Rodriguez	2008-000693	Appeal	10/01/09					x		
Ex parte Gutta	2008-4366	Appeal	08/10/09		x			x		
Ex parte Catlin	2007-3072	Appeal	02/03/09					x		
Ex parte Miyazaki	2007-3300	Appeal	11/19/08					x		
Ex parte Jella	2008-1619	Appeal	11/03/08				x			
Ex parte Yamaguchi	2007-4412	Appeal	08/29/08			x				
Ex parte Whalen II	2007-4423	Appeal	07/23/08			x	x			x
Ex parte Ghuman	2008-1175	Appeal	05/01/08	x						
Ex parte Fu	2008-0601	Appeal	03/31/08				x			

Routine Board Decisions

Decisions

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Board Decision Search Page



United States Patent and Trademark Office

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[Boards & Counsel](#) > [PTAB](#) > [Final Decisions of the Patent Trial and Appeal Board](#)

Welcome to the USPTO e-FOIA page. Through this page you can search for publicly available final decisions rendered by the Patent Trial and Appeal Board. In the field below you can enter a proceeding number to search the collection of available decisions. If you do not have a proceeding number but you know the caption of the case you are looking for, for example ABC Co. v. University of Illinois, or you know a text string found in the case you can search the collection by using the "Search Document Text" field by typing the text string in the search field. The Final Decision date range starts on July 1, 1997

Search by Identifier:

Identifier:

Search by Range:

Start Date (mm/dd/yyyy):

End Date (mm/dd/yyyy):

Search Document Text:

Search syntax: Use the operators AND, OR, and AND NOT between search terms along with parentheses, e.g. ("john deere" or graham) and not "prior art"

Records per Page:

[Retrieve Decisions from the past 30 days](#)



Key Decisions Involving Functional Claiming

Decisions

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Hearings Information



Hearings

This page contains information concerning presenting oral argument for appeals, interferences, and AIA trials conducted by the Patent Trial and Appeal Board.



Resources

The page contains policies, procedures, rules, guides, tools and manuals which are associated with proceedings before the Patent Trial and Appeal Board.



Statistics

Periodic summaries of data concerning proceedings before the Patent Trial and Appeal Board, including dispositions, pendency, inventory, and other tracking measures.



About PTAB

The Patent Trial and Appeal Board is created by statute, and includes statutory members and Administrative Patent Judges. The PTAB is charged with rendering decisions on: appeals from adverse examiner decisions, post-issuance challenges to patents, and interferences.



Help

Click here if you are you looking for more information about the Patent Trial and Appeal Board?



Now Hiring

Are you interested in learning more about being a judge or applying for a position at the Patent Trial and Appeal Board?

Hearings Information

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General

- › [Public Admission](#)
- › [Hearing Protocol](#)
- › [Oral Advocacy before the Patent Trial and Appeal Board \[PDF\]](#)
- › [Hearing Schedules](#)
- › [Inclement Weather](#)
- › [Hearing Room Tour Information](#)
- › [Directions to Alexandria campus](#)

Hearing Rooms are located in Madison East, 9th floor



>> *Some resources may require browser plugins*

Guidance

- › [Requesting Oral Hearings](#)
- › [Rescheduling or Canceling an Oral Hearing](#)
- › [Video and Telephonic Hearings](#)
- › [Participation from Satellite Offices in Oral Hearings](#)
- › [Appearance at the Oral Hearing](#)
- › [Duration of Hearing](#)
- › [Use of Demonstratives and Exhibits](#)
- › [Oral Hearing Transcripts](#)

Hearing Schedule Example

APRIL 2015 PTAB Public Hearing Schedule

Proceeding No.	Serial No.	Date	Time	Room
2015-000224		Wednesday, April 01, 2015	10:00 AM	D
IPR 2014-00358		Wednesday, April 01, 2015	1:00 PM	B
IPR 2014-00407 IPR 2014-00408		Wednesday, April 01, 2015	2:00 PM	A
2012-011965	12552103	Thursday, April 02, 2015	1:00 PM	B
2012-012346	11931762	Thursday, April 02, 2015	1:00 PM	B
IPR 2014-00736		Thursday, April 02, 2015	1:00 PM	D
IPR 2014-00402		Monday, April 06, 2015	10:00 AM	A
IPR 2014-00415		Monday, April 06, 2015	2:00 PM	A
2014-007769	90012413	Wednesday, April 08, 2015	10:00 AM	D
2015-000143	90012671	Wednesday, April 08, 2015	2:00 PM	B
IPR 2014-00365		Thursday, April 09, 2015	10:00 AM	A
IPR 2014-00272		Monday, April 13, 2015	1:30 PM	B
IPR 2014-00476		Monday, April 13, 2015	2:00 PM	A
IPR 2014-00440 IPR 2014-00441		Tuesday, April 14, 2015	9:00 AM	A
2012-012441	10508711	Tuesday, April 14, 2015	9:00 AM	B
2012-002223	10551053	Tuesday, April 14, 2015	9:00 AM	B

Resources



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This page contains information concerning presenting oral argument for appeals, interferences, and AIA trials conducted by the Patent Trial and Appeal Board.



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Resources

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 - ▶ [Frequently Asked Questions](#)
- ▶ [Trial Practice Guide \[PDF\]](#)
- ▶ [Patent Review Processing System \(PRPS\)](#)
- ▶ [America Invents Act \(AIA\) Trial Roundtables, April 15 to May 8, 2014](#)
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Standard Operating Procedures

Standard Operating Procedures

- SOP 1 (rev. 13): Assignment of judges to merits panels, motions panels, and expanded panels (12 February 2009) [PDF]
- SOP 2 (rev. 9): Publication of opinions and designation of opinions as precedential, informative, representative, and routine (22 September 2014) [PDF]

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Panel Discussion on Effective Advocacy

Tip 1: Clarify Claim Construction by Defining Key Claim Terms

- Acknowledge when an issue turns on claim construction
- Provide an interpretation for key claim terms with a basis for the interpretation under the "broadest reasonable interpretation" standard

Tip 1: Clarify Claim Construction by Defining Key Claim Terms (cont'd)

- Demonstrate why the examiner's interpretation is unreasonable in view of how ordinarily skilled artisans would understand the term in light of Appellant's specification
- Ideally, cite a clear and unambiguous definition of the term in the specification

Tip 1: Clarify Claim Construction by Defining Key Claim Terms (cont'd)

- Absent such a definition, identify evidence of record to show that the disputed term has a narrower meaning than the Examiner's construction
 - Under the Board's 2012 rules, dictionaries are excluded from the definition of "Evidence" under 37 C.F.R. § 41.30 and may be cited before the Board

Tip 2: Support Arguments With Evidence

- Attorney argument cannot substitute for evidence
- Merely pointing out what a claim recites is not a separate argument for patentability
 - 37 C.F.R. § 41.37(c)(1)(iv) (2012)

Insufficient arguments: *In re Lovin*

- In *In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011), the court held that the Board can require more substantive arguments in an appeal brief than
 - (1) merely reciting the claim elements, and
 - (2) a bare assertion that the corresponding elements are not found in the prior art

Tip 2: Support Arguments With Evidence (cont'd)

- Do not rely on new evidence that was not before the examiner during prosecution
 - Also applies to oral hearings
 - *See* 37 C.F.R. § 41.47 (2012)
- *But see* 37 C.F.R. § 41.30 (excluding dictionaries from the definition of “Evidence” and noting that they may be cited to the Board)

Supporting Arguments With Evidence: Secondary Considerations

- **Example 1: Secondary considerations of non-obviousness**
 - Unexpected results
 - Commercial success
 - Long-felt, but unsolved need
 - Failure of others, etc.

Supporting Arguments With Evidence: Teaching Away/ Inoperability

- **Example 2: Inoperability to Demonstrate Non-obviousness**
 - Evidence that examiner's proposed combination would render cited prior art unsuitable for its intended purpose can be probative

Tip 3: Effective Use of Reply Briefs

- 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
 - address intervening case law relevant to the issues on appeal

Tip 3: Effective Use of Reply Briefs

- Do not raise new arguments in a reply brief that are not responsive to arguments made in the examiner's answer
- Do not argue claims separately for the first time in a reply brief
- Board will generally not consider such new arguments
 - *See* 37 C.F.R. § 41.41(b)(2) (2012)

Questions?

Boardside Chats

Date	Time	Topic	Speakers
Tuesday, June 2	Noon to 1 pm Eastern Time	Discovery in AIA Trials	Panel of Practitioners and Administrative Patent Judges
Tuesday, August 4		AIA Rulemaking and Guidance Changes	Lead Judge Susan Mitchell
Tuesday, October 6		Best Practices before the PTAB	Panel of Administrative Patent Judges

