

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Patent Trial and Appeal Board (PTAB) Boardside Chat: Appeal briefs made easy

James Worth, Lead Administrative Patent Judge

Eric Jeschke, Administrative Patent Judge

Frances Ippolito, Administrative Patent Judge

May 13, 2021

UNITED STATES
PATENT AND TRADEMARK OFFICE



Agenda

- New appeal brief tool
- Parts of an appeal brief
- Deep dive on the argument
- Common arguments for showing that the examiner erred

Question/comment submission

- To send in questions or comments during the webinar, please email:
 - PTABBoardsideChat@uspto.gov

New appeal brief tool and how to access

Appeal brief tool

- There are two parts to the appeal brief tool:
 1. Word document template
 2. PDF instructions for completing the template

Location of appeal brief tool: PTAB page on USPTO website

www.uspto.gov/patents/ptab

The screenshot shows the USPTO Patent Trial and Appeal Board (PTAB) website. The page title is "Patent Trial and Appeal Board". Below the title, there is a description: "The Patent Trial and Appeal Board (PTAB) conducts trials, including inter partes, post-grant, and covered business method patent reviews and derivation proceedings, hears appeals from adverse examiner decisions in patent applications and reexamination proceedings, and renders decisions in interferences." The page is divided into three main sections: "Trials and appeals", "Decisions", and "Learn more". The "Trials and appeals" section contains a list of links: "New to PTAB?", "Trial proceedings", "Appeals proceedings", "Preparing for hearings", and "Fees". A red arrow points to the "New to PTAB?" link, which is circled in red. The "Decisions" section contains links for "All PTAB decision data", "AIA daily decisions", "Precedential and informative decisions", and "Precedential Opinion Panel (POP)". The "Learn more" section contains links for "Resources and guidance", "Statistics", "Databases and IT tools", "Frequently asked questions", "Boardside Chat webinar series", "PTAB suggestion box and contact info", and "Recent proposals, pilots and final rules". At the bottom of the page, there is a navigation bar with links for "PTAB E2E system", "Search decisions", "Hearing information", "Latest developments", and "Recent proposals, pilots & final rules".

Location of appeal brief tool: New to PTAB page on USPTO website

www.uspto.gov/patents/ptab/ptab-inventors

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New to PTAB

About PTAB

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New to PTAB

What is PTAB?

The Patent Trial and Appeal Board (PTAB) is a tribunal within the United States Patent and Trademark Office (USPTO) that reviews rejections made by examiners in proceedings called ex parte appeals and decides patentability questions for issued patents raised by third parties in proceedings called AIA trials.

The America Invents Act (AIA) created the PTAB or the Board. It was known previously as the Board of Patent Appeals and Interferences or BPAL.

The Board includes statutory members and administrative patent judges. The statutory members of the Board are the USPTO Director, Deputy Director, Commissioner for Patents, and Commissioner for Trademarks.

Administrative patent judges are appointed by the Secretary of Commerce and are legally and technically trained. Judges have extensive patent legal experience prior to their appointment on the Board, for example, in private practice, in government practice (e.g., at the Department of Justice or the International Trade Commission), and as in-house counsel in companies. Many also have served as USPTO examiners or judicial law clerks.

The Board also includes patent attorneys, law clerks, and paralegals along with support staff to administer proceedings and hearings.

[Learn more](#) about the Board, its composition, history, and areas of jurisdiction.

What are ex parte appeals?

If a patent examiner twice rejects or issues a final rejection in a patent application, the applicant can seek review of the rejection by the Board. The Board calls such an applicant by the title appellant.

An appellant and the examiner may submit written papers called briefs to set out their respective positions. An appellant brief contains certain required information to help the Board understand the invention and the arguments for patentability. For help in preparing an appeal brief, the Board offers an appeal brief template and instructions to guide appellants; these documents featured on the [Preparing an Ex Parte Appeal Brief Webpage](#).

In addition, the appellant also may request to make an oral presentation to the Board in a hearing called an oral hearing.

The Board will review the briefs, attend the oral hearing, and then render a decision. The Board will either affirm or reverse, in part or whole, the examiner's rejection. If the appellant is not successful in securing reversal of the examiner's rejection from the Board, the appellant may seek reconsideration by the Board or federal court review or both.

The [appeal process](#) involves nine steps and is explained in these videos below:

[Inventor Info Chat \(Appealing a Final Rejection to the Patent Trial and Appeal Board: What you need to know, August 15, 2019\)](#)

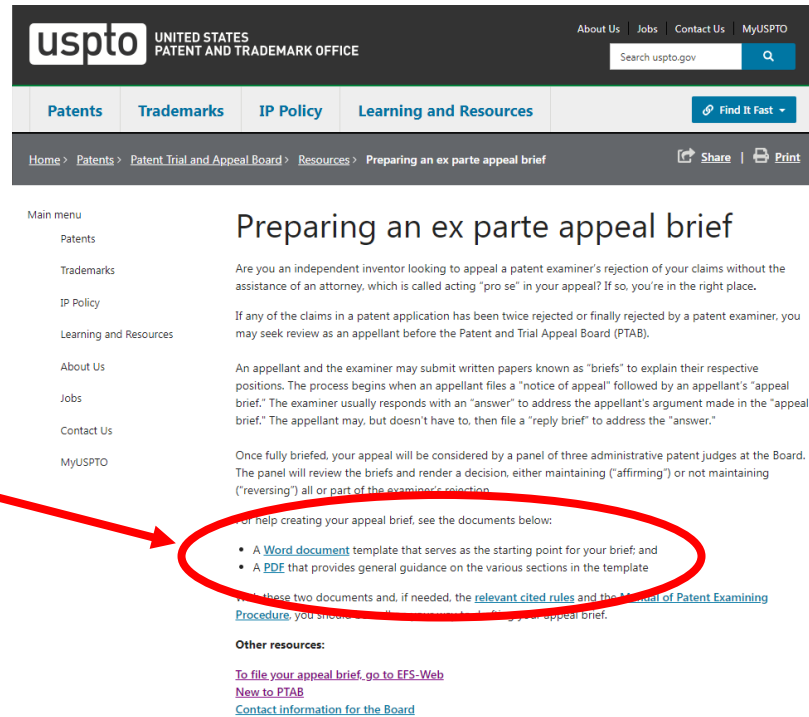
[Boardside chat: \(Appeals Made Easy, November 7, 2019\)](#)

Learn more about ex parte appeals on the [PTAB's Appeal](#) webpage. Also, feel free to use our [resources for independent inventors](#) and those new to appeals.



Location of appeal brief tool: Preparing an ex parte appeal brief page

www.uspto.gov/patents/patent-trial-and-appeal-board/resources/preparing-ex-parte-appeal-brief



The screenshot shows the USPTO website header with the logo and navigation links. The main content area is titled "Preparing an ex parte appeal brief". A red arrow points from the left side of the page to a red circle that highlights a list of resources for creating an appeal brief. The list includes a Word document template and a PDF. Below the list, there are links for "Other resources" including "To file your appeal brief, go to EFS-Web", "New to PTAB", and "Contact information for the Board".

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Preparing an ex parte appeal brief

Are you an independent inventor looking to appeal a patent examiner's rejection of your claims without the assistance of an attorney, which is called acting "pro se" in your appeal? If so, you're in the right place.

If any of the claims in a patent application has been twice rejected or finally rejected by a patent examiner, you may seek review as an appellant before the Patent and Trial Appeal Board (PTAB).

An appellant and the examiner may submit written papers known as "briefs" to explain their respective positions. The process begins when an appellant files a "notice of appeal" followed by an appellant's "appeal brief." The examiner usually responds with an "answer" to address the appellant's argument made in the "appeal brief." The appellant may, but doesn't have to, then file a "reply brief" to address the "answer."

Once fully briefed, your appeal will be considered by a panel of three administrative patent judges at the Board. The panel will review the briefs and render a decision, either maintaining ("affirming") or not maintaining ("reversing") all or part of the examiner's rejection.

For help creating your appeal brief, see the documents below:

- A [Word document](#) template that serves as the starting point for your brief; and
- A [PDF](#) that provides general guidance on the various sections in the template

With these two documents and, if needed, the [relevant cited rules](#) and the [Manual of Patent Examining Procedure](#), you should be able to prepare your appeal brief.

Other resources:

- [To file your appeal brief, go to EFS-Web](#)
- [New to PTAB](#)
- [Contact information for the Board](#)



Appeal brief tool: Word template and PDF instructions

Word template

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors: [Inventor Name(s)]	Group Art Unit: [####]
Application No. [##/###/####]	Examiner: [Name]
Filed: [Application Filing Date]	Confirmation No. [####]
Title: [APPLICATION TITLE]	

MAIL STOP APPEAL BRIEF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Appellant submits this Appeal Brief in response to the final Office action mailed [Date], and further to the Notice of Appeal filed [Date]. Appellant requests consideration of this appeal by the Patent Trial and Appeal Board.

I. REAL PARTY IN INTEREST
Add

II. RELATED APPEALS AND INTERFERENCES
Add

III. SUMMARY OF CLAIMED SUBJECT MATTER
Add

IV. ARGUMENTS
Add

a. Rejection 1 – The Rejection of Claims . . . Based on . . .
i. Independent Claim 1

PDF Instruction Document

I. REAL PARTY IN INTEREST

This section requires a statement from you that identifies the real party in interest at the time the appeal brief is filed. A real party in interest may include you as the inventor and any other individuals or entities that have ownership rights to the patent application. For example, an assignee of the patent application may be a real party in interest. A statement is not required if the named inventor(s) are the real party in interest. If you do not provide a statement, the Board will consider the inventor(s) to be the real party in interest. Typically, a *pro se* inventor is the real party in interest. See MPEP §§ 301, 324, 1205.02(i) (<https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e123366.html>).

Example:

The real party of interest is The Great White Café LLC (Baja, California 21511) by virtue of an assignment by the inventor duly recorded in the Assignment Branch of the Patent and Trademark Office.

II. RELATED APPEALS AND INTERFERENCES

Please list all of your prior or pending cases before the Board or before a court. These cases are based on applications or patents that you



Filing an appeal brief via EFS-Web: Preparing an ex parte appeal brief page

www.uspto.gov/patents/patent-trial-and-appeal-board/resources/preparing-ex-parte-appeal-brief

The screenshot shows the top portion of the USPTO website. On the left is the USPTO logo and the text "UNITED STATES PATENT AND TRADEMARK OFFICE". On the right are links for "About Us", "Jobs", "Contact Us", and "MyUSPTO", along with a search bar. Below this is a navigation bar with tabs for "Patents", "Trademarks", "IP Policy", and "Learning and Resources", and a "Find It Fast" button. At the bottom of the navigation bar is a breadcrumb trail: "Home > Patents > Patent Trial and Appeal Board > Resources > Preparing an ex parte appeal brief", and "Share" and "Print" icons.

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Preparing an ex parte appeal brief

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- A [PDF](#) that provides general guidance on the various sections in the template

With these two documents and, if needed, the [relevant cited rules](#) and the [Manual of Patent Examining Procedure](#), you should be well on your way to drafting your appeal brief.

Other resources

- [To file your appeal brief, go to EFS-Web New to PTAB](#)

• [Learn more information for the Board](#)



Filing an appeal brief via EFS-Web

The screenshot shows the USPTO website interface. At the top, the USPTO logo and navigation links (About Us, Jobs, Contact Us, MyUSPTO) are visible. Below the navigation bar, there are tabs for Patents, Trademarks, IP Policy, and Learning and Resources. A search bar is located on the right side of the navigation bar. The main content area is titled 'About EFS-Web' and features a red arrow pointing to a link labeled 'EFS-Web for Registered eFilers'. Other links include 'EFS-Web for Unregistered eFilers', 'EFS-Web Contingency', and 'Sponsorship Tool'. A sidebar on the left contains a list of tools and links, including 'About EFS-Web', 'Patent Center', 'Check application status', 'Fees and payment', 'Patent Trial & Appeal Board', 'Global Dossier', and 'More tools & links'. A contact information section at the bottom left provides telephone, email, and fax numbers. A 'Sign-in with uspto.gov account' button is also present.

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Patent Electronic Business Center

Telephone: 1-866-217-9197 (toll-free)

571-272-4100 (local)

E-mail: ebc@uspto.gov

Fax: 571-273-0177

Sign-in with uspto.gov account

Patent Center Beta, a new tool for electronic filing and management of patent application, is available for all users and features a Training mode to practice filing in DOCX format. Please visit the [Patent Center Information](#) page for more information.

About EFS-Web

[EFS-Web for Registered eFilers](#)

[EFS-Web for Unregistered eFilers](#)

[EFS-Web Contingency](#)

[Sponsorship Tool](#)

Important Information

- [EFS-Web Resources](#)
Instructions to become a Registered eFiler ([Getting Started - New Users](#)), system requirements, EFS-Web Fillable Forms, and other useful information and links
- [EFS-Web Announcements](#)
Recent and archived announcements.

The [Sponsorship Tool](#) can be used by **registered practitioners** to sponsor their support staff to work on their behalf. In order to sponsor support staff, a practitioner must first migrate to a USPTO.gov account and the support staff must each have a USPTO.gov account.

For step-by-step instructions, see [Sponsorship Tool Guide](#).

Sponsor Support Staff

Basic initial filing of new patent applications when the primary portal to EFS-Web has an



Parts of an appeal brief

Parts of an appeal brief

- Six parts:
 - Summary of claimed subject matter
 - Real party in interest
 - Related appeals, interferences, and trials
 - Argument
 - Conclusion (optional)
 - Claims appendix

Summary of claimed subject matter

- Provides a concise explanation of the subject matter defined in each of the rejected independent claims
- Not required for pro se applicants, but may help the Board understand the arguments
- If included, should identify, for each claim element, supporting disclosure and figures

Real party in interest

- Statement from you that identifies the real party in interest at the time the appeal brief is filed
- A real party in interest may include you as the inventor and any other individuals or entities that have ownership rights to the patent application
- An assignee of the patent application may be a real party in interest
- You must update the real party in interest if it changes during the proceeding (See 37 C.F.R. § 41.8)

Example: The real party in interest is The Great White Café LLC (Baja, California 21511).



Related appeals, interferences, and trials

- List any prior or pending cases before the Board or a court that are related to the current appeal
- A related case is based on a patent or application that you own and would affect the current appeal or be affected by the current appeal
 - A related case might be a continuation application

Example 1: Appeal No. 2019-1234, prior decision dated July 1, 2020

Example 2: There are no related appeals, interferences, or trials to appellant's knowledge

Argument

- Why the examiner's decision to reject the pending claims of your application is improper and should be reversed

Conclusion and claims appendix

- Conclusion should briefly explain what relief you want from the Board (e.g., reverse the examiner's rejection)
- Appendix must include all claims on appeal
 - Should not indicate prior amendments or reference non-admitted amendments
 - Should start on a new page

Question/comment submission

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 - PTABBoardsideChat@uspto.gov

LEAP

- [Legal Experience and Advancement Program \(LEAP\)](#)
- Designed to:
 - Aid in development of the next generation of patent practitioners
 - Encourage a diverse group of advocates to develop their skills before the Board
- To qualify, a patent agent or attorney must have:
 - Three or fewer substantive oral arguments in any federal tribunal, including PTAB, **and**
 - Seven or fewer years of experience as a licensed attorney or agent



Deep dive on the argument

Argument: preliminary steps

- Review the prosecution history of your application
- Decide which rejections and which claims to address
- Identify your strongest arguments

Argument: strategic considerations

- There is no limit on the number of pages
 - **BUT** the clearer and more concise your arguments, the better your chances of prevailing
- Present your strongest arguments first
 - Avoid diluting your strong arguments with weaker ones
 - **BUT** keep in mind—any rejection that you decide not to address and any arguments that you decide not to present **CANNOT** be presented later

Argument: suggested format

- Address each ground of rejection under a separate heading
- Identify the ground of the rejection by claim number, statutory basis, and references (if any)

Example:

- I. Whether claims 1-3 are unpatentable under 35 U.S.C. § 103 over Reference A in view of Reference B

Argument: claim grouping

- If the same argument applies to two or more claims, consider arguing the claims as a group under a single heading or sub-heading

Example:

- I. Whether claims 1-3 are unpatentable under 35 U.S.C. § 103 over Reference A in view of Reference B

Claim 1 is patentable over the combination of Reference A and Reference B because ...

Claims 2 and 3 are patentable for the same reasons presented for claim 1

Argument: arguing claims separately

- Use a separate heading or sub-heading for any claim that you want the PTAB to consider separately

Example:

Whether claims 1-3 are unpatentable under 35 U.S.C. § 103 over Reference A in view of Reference B

A. Claims 1 and 2

Claim 1 is patentable over the combination of Reference A and Reference B because ...

Claim 2 is patentable for the same reasons.

B. Claim 3

Claim 3 is patentable over the combination of Reference A and Reference B because ...

Argument: kinds of rejections

- Examiner's rejection will be based on one or more of the statutory requirements for patentability:
 - 35 U.S.C. § 101 (patent ineligibility or lack of utility)
 - 35 U.S.C. § 102 (lack of novelty)
 - 35 U.S.C. § 103 (obviousness)
 - 35 U.S.C. § 112 (inadequate disclosure)
- Examiner's objections are usually petitionable, not appealable (See [Ex parte Frye](#) (precedential))

Argument: burden

- The initial burden of proof rests with the examiner to clearly state the reasons for the rejection
- After the examiner satisfies his burden, then the burden shifts to you to explain why you believe the examiner has made an error

Argument: explain why

- For whatever argument you make to show that the examiner erred, you should always give reasons to support your position
- It is not persuasive to simply state that the examiner erred without explaining why
 - Because, because, because

**Common arguments to show that the
examiner erred**

Common arguments

- Examiner misunderstood or mischaracterized the claimed invention or the pending claims
- Examiner misunderstood the cited prior art
- Examiner misunderstood the law or legal basis for the rejection

Argument: misunderstood the invention

- Explain that the examiner's characterization of your claimed invention, or the examiner's interpretation of the claim language, is inconsistent with your specification

Example:

A person of ordinary skill in the art would understand from the specification [identify specific portions of the specification] that claim limitation X means ... The examiner's interpretation of claim limitation X is improper because ...

Argument: misunderstood the prior art

- Explain why the examiner's understanding of a prior art reference is incorrect, e.g., why the examiner erred in finding that the prior art reference discloses or suggests a particular claim element

Example:

Reference A does not disclose or suggest ... , as recited in claim ...
because ...

Argument: misunderstood the law

- Explain that the examiner has failed to correctly apply the law

Example 1, for an obviousness rejection:

The examiner has not set forth sufficient reasoning to combine Reference A and Reference B because ...

Example 2, for an obviousness rejection:

A person of ordinary skill in the art would not have combined Reference A and Reference B, as the examiner proposes, absent knowledge of the claimed invention, because ...

Argument: use of evidence

- Direct the Board's attention to evidence in the record, e.g., affidavits or declarations from experts, that supports your argument
 - You cannot add new evidence to the record for the first time with the appeal brief

Example 1:

The examiner's interpretation of ... is overly broad and unreasonable. As X explains in his declaration, a person of ordinary skill in the art at the time of appellant's invention would have understood ... to mean ... because ...

Example 2:

The rejection under 35 U.S.C. § 103 is improper because, as X explains in her declaration, a person of ordinary skill in the art, at the time of appellant's invention, would not have combined References A and B because ...

Argument: use of case law

- If you are aware of case law, i.e., a previous decision of the PTAB or a federal court, that supports your position, explain how the case applies to the facts of your case and shows that the examiner erred

Question/comment submission

- To send in questions or comments during the webinar, please email:
 - PTABBoardsideChat@uspto.gov

Fast-track pilot programs



Fast-Track Appeals Pilot Program

- One-year pilot program to expedite ex parte appeals before the PTAB
- Appellant can request appeal be expedited out of turn by filing a petition and a fee
- Learn more about the Fast-Track Appeals Pilot Program at: www.uspto.gov/patents/ptab/fast-track-appeals-pilot-program

Fast-Track Pilot Program for Appeals Related to COVID-19

- Pilot program to expedite ex parte appeals related to COVID-19 before the PTAB
- Appellant can request appeal be expedited out of turn by filing a petition WITHOUT a fee
- Learn more about the Fast-Track Pilot Program for Appeals Related to COVID-19 at: www.uspto.gov/patents/patent-trial-and-appeal-board/covid-fast-track-appeals-pilot-program



Question/comment submission

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Next Boardside Chat



- June 17, 2021, noon to 1 p.m. ET
- Agenda
 - Admission to practice before the USPTO
 - Pro hac vice recognition before the PTAB
- Register for and learn about upcoming Boardside Chats and access past Boardside Chats at: www.uspto.gov/patents/ptab/ptab-boardside-chats

