

Pre-Appeal Brief Request for Review | Overview and Effective Uses

The Pre-Appeal Brief Request for Review (PABR) provides an Applicant, whose patent application has been twice rejected, a means for obtaining formal review of outstanding Office Action rejections prior to the filing of an appeal brief. The USPTO states that, “the goals of the program are (1) to identify the presence or absence of clearly improper rejections based upon error(s) in facts, or (2) to identify the omission or presence of essential elements required to establish a prima facie rejection.”

Overview

As announced by the USPTO, “the program is intended to spare applicants the added time and expense of preparing an appeal brief if a panel review determines an application is not in condition for appeal.” The PABR may be utilized to review appealable issues (e.g., 35 USC 102/35 USC 103/35 USC 112 rejections | rejections involve substance) but not petitionable issues (e.g., claim objections: see [1.181 – Petition to the Director](#) | objections involve form).

It is proper to utilize the pre-appeal brief process when **clear error** or **factual deficiencies** are present in one or more of the rejections of the outstanding Office Action. Conversely, the Applicant should file an appeal brief and not request review through the PABR if the Applicant’s arguments will require an interpretation of the claims or prior art teachings.

Applicant Submission

- 1) Notice of Appeal: A notice of appeal (compliant with [37 CFR 41.31](#)) must be filed concurrently with the PABR submission.
- 2) USPTO PABR Request Form: [USPTO Form PTO/SB/33](#).
- 3) Arguments: The Applicant’s arguments detailing why review is being requested should be no longer than five pages (excluding the PABR Request Form). Additionally, no claim amendments may be included therewith (including any claim amendments will result in the PABR submission being dismissed). Further, the Applicant should refer to arguments already of record by particularly referring to the previously submitted arguments (e.g., “The arguments presented in Applicants response of January 1, 2010 at page 4, line 15 to page 5, line 5”).

USPTO Post-PABR Filing Process

Once the pre-appeal brief request for review has been received by the USPTO, a Technology Center Art Unit supervisor will designate a panel of examiners who are experienced in the subject technology to review the PABR submission. The panel of examiners will include “at least” a supervisor and the Examiner of record.

After the panel reviews the rejection(s)/Applicant arguments (without any further interaction with the Applicant), the panel will either: 1) allow the application; 2) reopen patent prosecution; 3) keep the application under appeal because at least one issue remains; or 4) dismiss the request due to a submission error (e.g., claim amendment included therewith, failing to submit notice of appeal, etc.).

Effective Use of PABR

Filing a pre-appeal brief request for review makes sense in many instances, especially when an Applicant’s arguments are being found unpersuasive by an Examiner and the Applicant believes that claim amendments are not required to overcome the rejection(s). In such a scenario, the pre-appeal brief provides the Applicant with an opportunity to place their patentability arguments before a panel of examiners (which include at least one supervisor) prior to filing a full appeal brief.

Filing a full appeal brief is costly as its preparation requires a substantial amount of time. Additionally, in view of the current backlog at the BPAI, an Applicant who files an Appeal Brief may incur a substantial wait prior to receiving an answer. Such an extended wait may be detrimental for an Applicant who requires an expedient patent grant to achieve a specific business objective (e.g., securing additional venture capital, etc.).

Conversely, the time and cost required for the pre-appeal brief submission is minimal as a majority of the Applicant’s former arguments may be essentially re-asserted in the PABR (although new patentability arguments may be asserted as long as no claim amendments are included therein). Additionally, if former arguments are indeed re-asserted in the PABR, minimal (or possibly no) prosecution history is generated by such a filing.

Many patent practitioners that I know who utilize the PABR feel generally positively about it. In many instances, the filing of the PABR may result in the rejection(s) being withdrawn and prosecution being re-opened. If the PABR results in a rejection being withdrawn, such a result is positive as prosecution is able to move forward without the Applicant having to either file an appeal brief or amend the claims.

Generally, anticipation rejections included in an Office Action are easier to overcome during patent prosecution than obviousness rejections. The aforementioned assertion is generally

maintained in the Pre-Appeal Brief Review context, as arguments directed toward anticipation rejections usually enjoy greater success than arguments directed toward obviousness rejections.

As stated previously, the Pre-Appeal Brief request may be utilized only when **clear error** or **factual deficiencies** are present in one or more of the rejections of the outstanding Office Action. The following items illustrate a few situations where the Pre-Appeal Brief Request for Review may be successfully utilized.

Anticipation/Obviousness – Fail to Consider Claim Recitation | Improper Correlated Claim Feature

For anticipation rejections, the Applicant will likely succeed if it is shown that the Office Action failed to entirely consider a claim recitation in the subject application (e.g., the office action does not correlate a claim feature in the subject application with that of a corresponding feature in the cited art or fails to consider all of the claim recitations). Additionally, if a claim feature in the subject application is not met by a correlated feature in the cited art, the Applicant may obtain success in filing a Pre-Appeal Brief Request for Review. Further, obviousness rejections which fail to consider a claim recitation(s) or improperly correlate a claim recitation, may be similarly overcome by filing persuasive arguments in a Pre-Appeal Brief Request for Review which point out the **clear error** or **factual deficiencies** which are present therein.

Obviousness – Teaching Away Arguments

An Applicant may be successful in overcoming an obviousness rejection if they further a persuasive “teaching away” argument. “Teaching away” requires an explicit statement or teaching within one of the cited references which indicates that the proposed combination, as asserted by the Office Action, would render the claimed invention (of the subject application) inoperable for its primary purpose.

It should be noted that if one of the references only describes disadvantages such as inefficiency or cost, a teaching away argument will be likely unsuccessful. Accordingly, for a “teaching away” argument to be successful, an explicit teaching must be included within the cited art (e.g., a machine will be unoperable if element A is XYZ material, a process will be unoperable above temperature ABC, etc.).

The MPEP provides guidance regarding “teaching away” ([MPEP 2141.02 – Differences Between Prior Art and Claimed or Invention](#)) indicating that, “a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). Further, [MPEP 2145 – D. References Teach Away from the Invention or Render Prior Art Unsatisfactory for Intended Purpose](#) provides additional guidance regarding “teaching away.”

Contrastingly, for arguments which require the panel to interpret claim scope or what a person of ordinary skill in the art would understand with regard to cited art (e.g., especially if multiple

interpretations are present) will likely not succeed, and instead should be included in a full appeal brief.

In summation, an Applicant should seriously consider filing a Pre-Appeal Brief Request for Review prior to filing an Appeal Brief.

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Joseph Iskra is a registered Patent Attorney who is licensed to practice law in the District of Columbia, and before the United States Patent and Trademark Office (USPTO), the Eastern and Western District Courts of Michigan, and the United States Court of Appeals for the Federal Circuit (CAFC). Joseph Iskra limits his practice to Federal Intellectual Property (IP) law matters and proceedings before the USPTO.