

5 KEY TAKEAWAYS

Strategically Using Appeals to the PTAB

Kilpatrick Townsend partner [Nicki Kennedy](#) and counsel [Troy Petersen](#) recently presented “Strategically Using Appeals to the PTAB” at the firm’s three-day CLE & Ski Series, KT Intellectual Property Seminar (KTIPS), in Colorado.

Here are some key takeaways.

1

Consider appeals to the PTAB as a logical next step in prosecution: Over the last ten years, there has been an approximately 80% drop in appeals filed with the PTAB. Appeal pendency currently averages 12 months from the date of the PTAB docketing notice. This pendency may be shortened even further by using a Fast Track appeals program. Applicant can control the front end, from filing the Notice of Appeal to submitting any Reply briefing, by filing well before each deadline.

2

Interview your case: Prior to proceeding to appeal, set-up an interview to talk to the examiner. Often, you can make progress on at least limiting the issues to present on appeal. If you are not able to progress, this can help solidify the decision to appeal.

3

Put your best claims forward: Use after final responses, either to present arguments or to present amendments, before filing a Notice of Appeal. Your claims should be in the best shape possible before proceeding to appeal. This includes addressing any claim objections or indefiniteness arguments.

4

Use all of the tools available: The Pre-Appeal Brief Request for Review is an underutilized tool that may help to avoid appeal or at least narrow the issues. This Request is filed along with a Notice of Appeal. There is no charge for the request. The examiner, the supervisor, and a Quality Assurance Specialist will review the Request and determine whether the case should proceed to appeal. The Request includes up to 5 pages of arguments and is a good place to present your strongest arguments. Especially when the examiner is a primary, this is likely the first time the supervisor is reviewing the case.

5

Evaluate your portfolio: Even if one case is being appealed, take advantage of co-pending cases or consider filing a continuation. This way, you can pursue different claim scope before an examiner while awaiting the appeal decision.

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