

## **Appealing the Rejection of a Patent Application**<sup>1</sup>

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### **I. Introduction.**

Sometimes appealing an Examiner's rejection is the only practical option. If no claims of valuable scope have been allowed or indicated as allowable, and all clarifying claim amendments, supporting evidence and salient arguments have been entered and considered, there is basically no choice but to appeal. There is little sense in refiling the same arguments over and over, or to unnecessarily narrow claims and lose valuable scope to push an application through the United States Patent and Trademark Office ("USPTO").

An appeal may be filed after a second or final office action. MPEP § 1204. Patent appeals are decided by the Patent Trial and Appeal Board ("PTAB" or "Board") of the USPTO. Even if you lose on appeal, prosecution can continue afterwards, and the Board's decision often provides valuable guidance on how to proceed.

### **II. Basic Prosecution Strategy Prior to Appeal.**

#### **A. The Claim Language Should Track the Arguments for Patentability.**

During prosecution, claims are subject to the broadest reasonable interpretation. *In re Morris*, 127F.3d 1048, 1054 (Fed. Cir. 1997). Before appealing, be certain that the literal claim language tracks the arguments in favor of patentability. Sometimes arguments, such as ones about the functional benefits of a physical structure or chemical compound, or about structures/components recited in the specification, are not literally supported by the claim language. In that situation, strongly consider amending, prior to appeal, the claim language to align with the arguments.

#### **B. The Best Practice is to Enter Claim Amendments Before Appealing.**

As explained below, claim amendments may not be entered after a Notice of Appeal is filed, so the best practice is to enter claim amendments in a Response to Office Action prior to filing a Notice of Appeal.

If a § 112 rejection is not one of the issues being appealed, carefully place the claims in order under 35 U.S.C. § 112 even if the Examiner has not raised a § 112 objection. The Board can raise new issues not addressed by the Examiner (37 C.F.R. § 41.50(b)), which is why the appealed claims should, for example, use terms consistent with those in the detailed description section of the specification and have proper antecedent basis.

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<sup>1</sup> This article is for educational purposes and does not constitute legal advice. It represents current, general opinions of the author, and not of his law firm or colleagues.

**C. Amending the Claims on or after the Date a Notice of Appeal Is Filed.**

There are two time frames to consider when amending claims on or after the date a Notice of Appeal has been filed: (1) on or after the date of filing the Notice of Appeal, but before filing the Appeal Brief (MPEP § 1206(II); 37 C.F.R. §§ 41.33(a), 1.116(b)), and (2) on or after the date of filing the Appeal Brief. 37 CFR §§ 41.37(c)(2), 1.116(b). A proposed amendment must be presented in a separate paper and cannot be in the Appeal Brief. MPEP § 1206(I); 37 C.F.R. § 41.37(c)(2). Any amendment filed after jurisdiction has passed to the Board should not be considered unless the Board remands the application for that purpose. MPEP § 1206(II); 37 C.F.R. § 41.35(a) (jurisdiction passes to the Board upon filing a Reply Brief or the expiration of time to file a Reply Brief, whichever is sooner).

**1. Amendment Made on or after the Date of the Notice of Appeal Is Filed, but Before the Appeal Brief Is Filed.**

Claim amendments made on or after the date of filing the Notice of Appeal, but before the Appeal Brief is filed, may be admitted only to (a) cancel claims, (b) comply with § 112 issues expressly set forth in a prior Office Action, (c) present rejected claims in better form for consideration on appeal, or (d) upon a showing of good and sufficient reasons as to why the amendment is necessary and was not presented earlier. 37 C.F.R. §§ 41.33(a), 1.116(b). All other amendments are admissible only as permitted by 37 C.F.R. §§ 41.39(b)(1) (request that prosecution be reopened after an Examiner's Answer is filed that includes a new ground of rejection), 41.50(a)(2)(i) (request that prosecution be reopened after a substitute Examiner's Answer is filed in response to a remand by the Board), or 41.50(b)(1) (prosecution is reopened in response to a new ground of rejection entered by the Board). 37 C.F.R. 41.33(c).

**2. Amendment Made on or after the Date the Appeal Brief Is Filed.**

On or after the date the Appeal Brief is filed, an amendment may only be admitted to (a) cancel claims, if the cancellation does not affect the scope of other claims on appeal, or (b) to rewrite dependent claims into independent form. 37 C.F.R. §§ 41.33(b). All other amendments are admissible only as permitted by 37 C.F.R. §§ 41.39(b)(1), 41.50(a)(2)(i), or 41.50(b)(1).

**D. The Best Practice is to Enter All Evidence Before Appealing and Be Certain that the Evidence Has Been Considered.**

New evidence may be added on or after the date of filing a Notice of Appeal, but prior to filing the Appeal Brief, only if the Examiner determines (a) that the evidence overcomes all rejections under appeal, and (b) there are good and sufficient reasons why the evidence is necessary and was not presented earlier. 37 C.F.R. § 41.33(d)(1). All other evidence is admissible only as permitted by 37 C.F.R. §§ 41.39(b)(1), 41.50(a)(2)(i), or 41.50(b)(1). 37 C.F.R. § 41.33(d)(2). New evidence may not be

included in an Appeal Brief. 37 C.F.R. § 41.37(c)(2). Any evidence filed after jurisdiction has passed to the Board should not be considered unless the Board remands the case to consider it. MPEP § 1206(II); 37 C.F.R. § 41.35(a).

Therefore, the best practice is to add any evidence (such as prior art, a declaration under 37 CFR § 1.132, or a full translation of any non-English reference) prior to filing a notice of appeal. Be certain that the Examiner has considered the evidence on the record (e.g., in an Office Action or Interview Summary). If necessary, arrange for an interview to consider evidence. If the Examiner has not considered evidence submitted in the Appeal Brief, the Board may remand the case to the Examiner after the Appeal Brief is filed, which would delay the proceedings. See MPEP § 1211.

### **The Evidence Should Support the Literal Claim Language**

Submitted evidence should support the literal claim language. For example, if a claim recites an alloy having 5% tin in which at least half of the tin remains in its elemental state in the alloy, the evidence (such as a chemical analysis) must *plainly show* that the *tested alloy* is the same as the *claimed alloy*.

The evidence should also plainly show that the prior art cited by the Examiner does not include each and every limitation of the claimed alloy and functions differently from the claimed alloy. Using this example, if a benefit of the claimed alloy is improved malleability or conductivity, include test results that plainly show the benefit in quantitative, objective terms.

#### **E. The Best Practice Is to Conduct Examiner Interviews Prior to Appeal.**

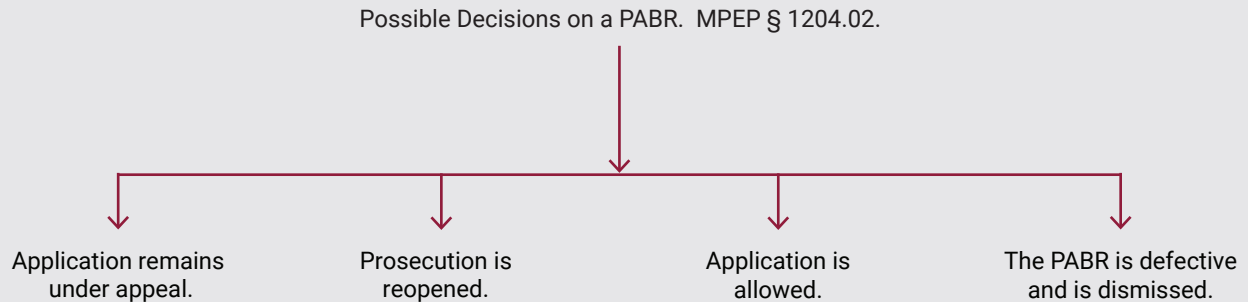
One interview after a final rejection is normally permitted. MPEP § 713.09. If a Notice of Appeal is filed, an interview may be conducted (1) before filing an Appeal Brief,<sup>2</sup> (2) before filing a Pre-Appeal Brief Request (MPEP § 1204.03), or (3) after a decision on a Pre-Appeal Brief Request and before filing an Appeal Brief. MPEP §§ 1204.02, 1204.03.

### **III. A Pre-Appeal Brief and Conference Is Probably Worth the Time and Expense.**

A Pre-Appeal Brief Review Request and Conference (“PABR”) request may be filed concurrently with a Notice of Appeal.<sup>3</sup> MPEP § 1204.02 (no extensions of time are available; the Pre-Appeal Brief Request must be filed with the Notice of Appeal and prior to filing an Appeal Brief). The possible outcomes of a PABR are shown below:

<sup>2</sup> An interview may be conducted after filing an Appeal Brief in “unusual” situations or “extraordinary circumstances,” such as to cancel claims. MPEP § 1204.03.

<sup>3</sup> This provision does not apply to re-examination proceedings.



PABRs are filed in about 40% of all Appeals, but are only successful<sup>4</sup> about 14% of the time. In contrast, appeals are fully or partially successful over 60% of the time when all possible outcomes are considered.

The PABR is limited to five pages, which may hamper the ability to thoroughly present arguments, especially if the patentability of multiple claims is being argued separately. Further, if a PABR is unsuccessful there is seldom useful feedback. Usually, all that is received is a one-paragraph notice that the PABR is denied, so there is no new information to advance prosecution.

But, the PABR can later be expanded to the full Appeal Brief. Plus, the PABR does provide an additional avenue to potentially have the application allowed. Consequently, even though a PABR adds to the overall expense of the appeal process, it is usually worthwhile.

#### **IV. The Basic *Ex Parte* Patent Application Appeal Process.**

File Notice of Appeal. 37 CFR § 41.31(a)(1). Any PABR must be filed with the Notice of Appeal. MPEP § 1204.02.

*Two months (extensions of time may be available) or one month after decision on PABR. MPEP § 1204, 1205; 37 C.F.R. §, 41.33, 41.37.*

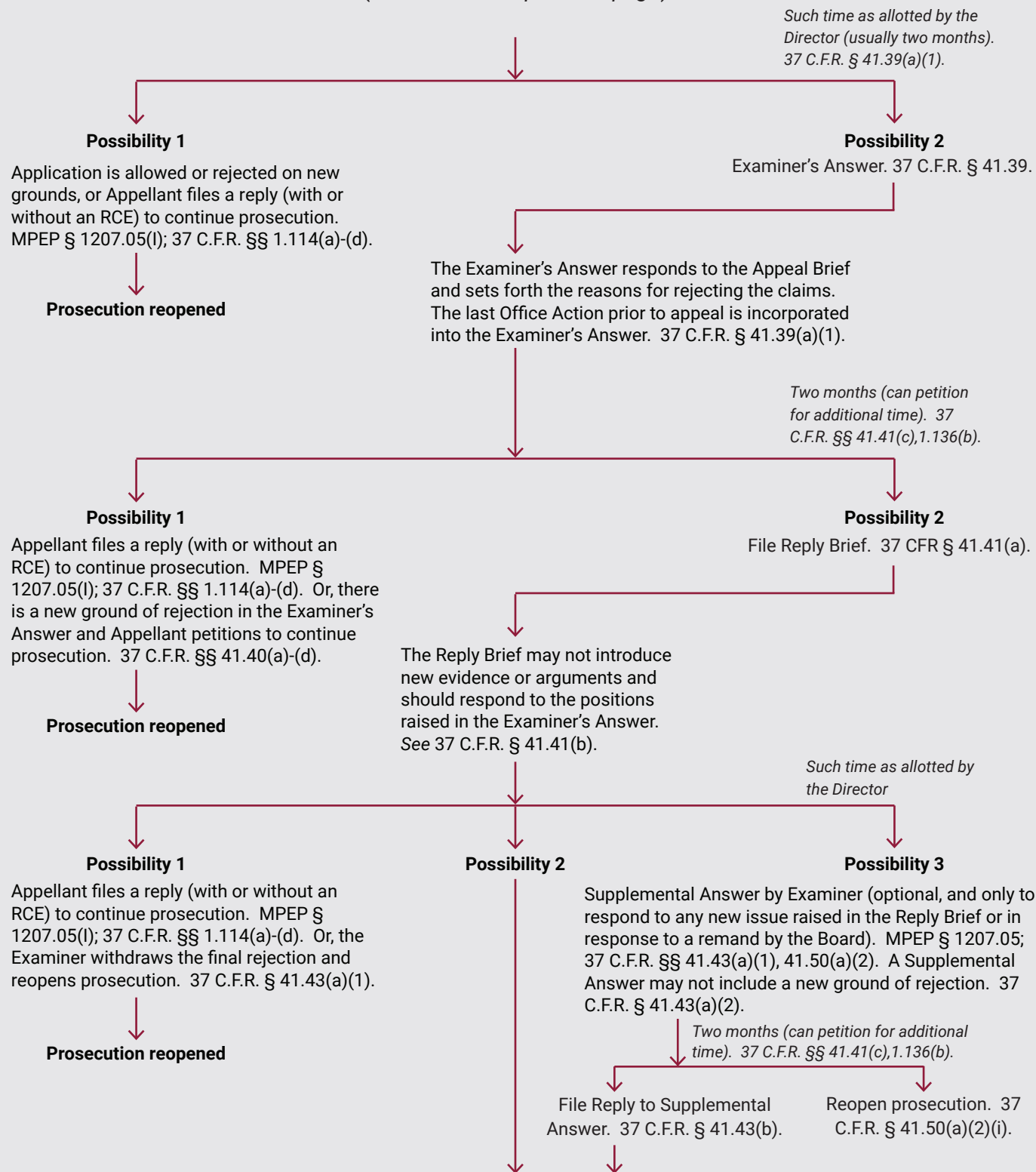
File Appeal Brief. 37 CFR § 41.37(a).

This leads to an appeal conference with the Examiner, the Supervisory Primary Examiner (“SPE”), and an independent Examiner (called a “conferee”). MPEP 1207.01. The Examiner, with approval of his/her SPE and the independent Examiner, may allow the case or issue a new ground of rejection.

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<sup>4</sup> “Successful” means that the claims are allowed.

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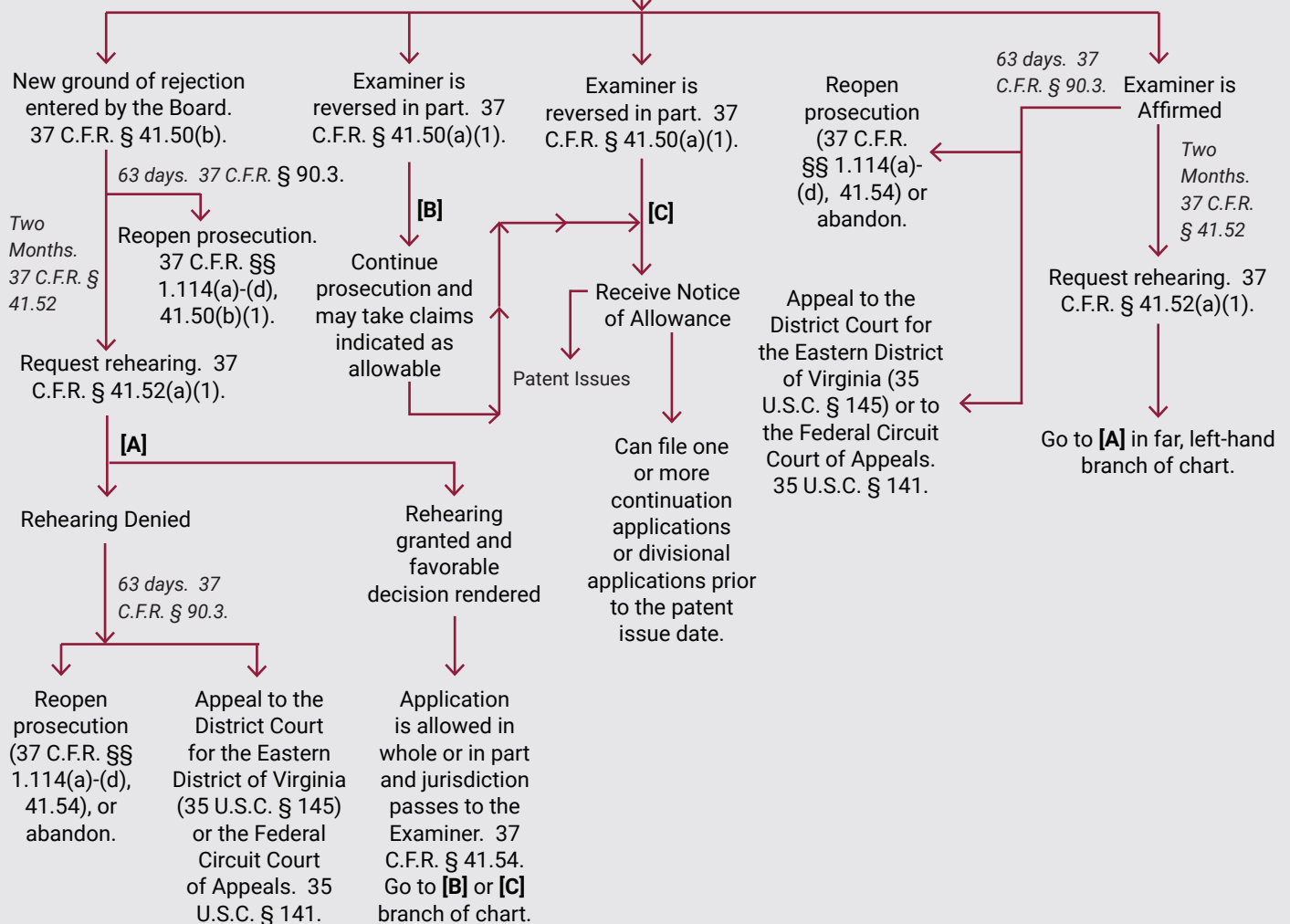
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Oral Hearing (if requested). An oral hearing must be requested in writing within two months after the Examiner's Answer or the date of filing the Reply Brief, whichever is earlier. MPEP § 1209(b). The date of the Oral Hearing is set by the Board (37 C.F.R. § 41.47(d)), and the Board may decide that an Oral Hearing is unnecessary. 37 C.F.R. § 41.47(f).

About 30 months after filing the Appeal Brief

Decision on Appeal by the Board (e.g., affirm the rejection, affirm in part, reverse the rejection, enter a new ground of rejection).

Summary of some possible Board decisions and responsive actions.<sup>5</sup>



<sup>5</sup> This provision does not apply to re-examination proceedings.

**V. Basic Substantive Appeal Brief Contents.**

**A. Summary of the Claimed Subject Matter.**

A concise explanation of the subject matter defined in each rejected independent claim must be provided. 37 C.F.R. § 41.37(c)(1)(iii). The summary must refer to the specification by page and line number or by paragraph number and to the drawings, if any, by reference characters. The references must be to the application as *filed* and not to the published application. *Id.*

Focus the appeal – limitation-by-limitation – on the words in the claims. Do not argue unclaimed aspects of the disclosure, or the benefits or function of unclaimed aspects. See *generally In re Himbler*, 47 USPQ 2d 1523, 1529 (Fed. Cir. 1998).

**B. Argument.**

**1. Concisely State Why the Examiner Erred.**

The Appeal Brief must include arguments as to why the Examiner erred for each ground of rejection, with citations of the statutes, regulations, authorities, and parts of the record (such as the application, prior art, and evidence submitted under 37 CFR § 1.132) relied on to support the argument. 37 C.F.R. § 41.37(iv).

Typical errors by an Examiner include: (1) failure to address a claim limitation, (2) misreading of the prior art, (3) not considering evidence, and (4) legal error, including which party bears the burden of proof.

**2. Use Headings and Annotated Figures (if Figures are in the Application).**

Each contested ground of rejection must be argued under a separate heading, and each heading must reasonably identify the ground of rejection being contested. *Id.* Also use sub-headings to organize arguments.

If pertinent to the application, use drawings, which can be annotated. Make it simple for the Board to understand the difference between the claimed invention and the prior art. Preferably identify drawings from the application as an “example” or “an embodiment,” and not as the “invention.”

**3. If Meaningful, Argue Patentability on a Claim-by-Claim Basis.**

Under each heading identifying the ground of rejection being contested, any claim(s) argued separately or as a subgroup must be argued under a separate subheading that identifies the claim(s) by number. *Id.* A statement that merely recites the language of a claim will not be considered an argument for separate patentability. *Id.*

The failure to separately argue the patentability of individual claims or groups of claims

constitutes a waiver of having the Board separately consider their patentability. *Id.* When multiple claims are subject to the same ground of rejection and are argued as a group or subgroup, the Board may select a single claim from the group or subgroup and decide the appeal as to that ground of rejection on the basis of the selected claim alone. Thus, the Board's determination of patentability of all claims in a group or subgroup may be based on the most vulnerable claim.

#### **4. Cite Current Case Law.**

Use the most relevant, current legal citations, akin to a litigation brief. Do not rely solely on the MPEP for case citations. Explain when the burden of proof is on the Examiner versus the Appellant.

#### **VI. Basic Reply Brief Contents.**

A Reply Brief responding to the arguments and evidence in the Examiner's Answer is permitted and should be filed. See 37 C.F.R. § 41.41. Some basic tips for the substance of a Reply Brief: (1) If the Examiner does not address where each and every claim limitation is present in the prior art, identify that and argue that the Examiner has tacitly conceded patentability.<sup>6</sup> (2) If the Examiner has not rebutted an argument about a ground of rejection presented in the Appeal Brief, argue that the ground has been waived or withdrawn. (3) If the Examiner has not provided evidence supporting rejections, and simply made conclusions allegedly based on what one skilled in the art would do, point that out and rebut it using evidence from the prior art or a declaration. (4) If the Examiner submits new evidence, object to it, and *also* submit a substantive response as to why the claims are patentable even if the new evidence is considered. (5) Do not raise arguments in a Reply Brief that are not responsive to arguments made in the Examiner's answer. 37 C.F.R. § 41.41(b). (6) Arguments of the patentability of separate claims cannot be presented for the first time in a Reply Brief. *Id.*

#### **VII. Reopen Prosecution if You Realize Something Is Wrong.**

It happens. When prosecuting an application there are often time and money constraints, and an issue that should have been addressed before appeal only becomes obvious when preparing an Appeal Brief or Reply to the Examiner's Answer. If necessary, reopen prosecution in order to amend the claims or introduce evidence. Prosecution can be reopened before a decision on appeal by replying to the last Office Action. 37 CFR §§ 1.114(a)-(d).

#### **VIII. Avoiding Appeals at all Costs Is a Mistake.**

Many practitioners are leery of appeals, and wrongly believe that (1) appeals are prohibitively expensive, (2) losing dooms an application, or (3) appeals take too long. The cost of an appeal is usually the same, or less, than the cost of further prosecution that could continue for years. Prosecution can be reopened even after an unfavorable appeal decision (37 C.F.R. §§ 1.114, 41.50(b)(1)), and an unfavorable decision often provides guidance for how to proceed. Finally, respect to timing,



much of the appeal time is added back to the term of any resulting patent. 35 U.S.C. §§ 154(b)(1)(c)(ii) and (iii); 37 C.F.R. §§ 1.702(a)(2), (3)(e).

## **IX. Conclusion.**

There are times when a rejection must be appealed to obtain valuable patent scope. When that happens, carefully prepare the application for appeal prior to filing a Notice of Appeal. Enter all amendments and evidence and present thorough, organized, compelling arguments for allowance.

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