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Appealing the Rejection of a Patent Application in the United States, Europe, and China

In some circumstances, appealing the rejection of a patent application is the only practical recourse a patent applicant may have to advance prosecution. In doing so, the patent applicant can appeal an examiner's decision refusing to grant a patent application to an administrative panel. This issue of Global Patent Prosecution discusses various considerations patent applicants may take into account when appealing their patent applications at the United States Patent and Trademark Office (USPTO), European Patent Office (EPO), and China National Intellectual Property Administration (CNIPA).

On another note, we've included an article about inherent obviousness in the biopharma space that may be of interest to many of our readers.

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**CONSIDERATIONS WHEN
APPEALING A PATENT
APPLICATION AT THE USPTO**

By: [Todd M. Hopfinger](#) and [Christian A. Camarce](#)

This article discusses aspects of ex parte appeals of patent applications before the United States Patent and Trademark Office (USPTO). A patent applicant, whose claims have been twice rejected, may appeal an examiner's decision to the Patent Trial and Appeal Board (PTAB). Four points of consideration related to the USPTO appeal process are discussed below.

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CONSIDERATIONS WHEN APPEALING A PATENT APPLICATION AT THE EPO

By: [Todd M. Hopfinger](#) and [Christian A. Camarce](#)

This article discusses aspects of ex parte appeals of patent applications before the European Patent Office (EPO). A patent applicant may appeal an examiner's decision on refusing to grant a patent application to the EPO Board of Appeals. Four points of consideration related to the EPO appeal process are discussed below.

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CONSIDERATIONS WHEN APPEALING A PATENT APPLICATION AT THE CNIPA

By: [Todd M. Hopfinger](#) and [Christian A. Camarce](#)

This article discusses aspects of ex parte appeals of patent applications before the China National Intellectual Property Administration (CNIPA). A patent applicant may appeal (submit a re-examination request) an examiner's decision refusing to grant a patent application to the Re-examination and Invalidation Department of the Patent Office (PRB). Four points of consideration related to the CNIPA appeal process are discussed below.

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OF NOTE: BIOPHARMA PATENTEES MUST NAVIGATE INHERENT OBVIOUSNESS

We thought that this *Law360* article, authored by our colleagues [Pauline M. Pelletier](#), [Marsha Rose Gilentine, Ph.D.](#), and [Eric K. Steffe](#), might be of interest to you:

"This year, the [U.S. Court of Appeals for the Federal Circuit](#) denied rehearing en banc in two appeals involving inherent obviousness — *Persion Pharmaceuticals LLC v. Alvogen Malta Operations Ltd.*[1] and *Hospira Inc. v. Fresenius Kabi USA LLC*[2] — perhaps missing an opportunity to clarify a doctrine that both the [U.S. Patent and Trademark Office](#) and courts have struggled to apply consistently and coherently."

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By: [Todd M. Hopfinger](#) and [Christian A. Camarce](#)

This article discusses aspects of ex parte appeals of patent applications before the United States Patent and Trademark Office (USPTO). A patent applicant, whose claims have been twice rejected, may appeal an examiner's decision to the Patent Trial and Appeal Board (PTAB). Four points of consideration related to the USPTO appeal process are discussed below.

First, patent applicants may consider the tradeoffs in pursuing the appeal process. In circumstances where an examiner is firmly entrenched in its positions, the appeal process provides patent applicants an opportunity to address the examiner's positions before a panel of PTAB judges. The panel of PTAB judges closely review the record—including briefing submitted by patent applicants—to determine the reasonableness of the examiner's arguments. This determination can be useful in not only the instant application but also in continuation applications that may be pursued by patent applicants, especially if the same examiner examines the continuation applications. But, the time and costs associated with the appeal process should also be considered when deciding to pursue the appeal process. In deciding whether to file an appeal, patent applicants may consider researching the examiner's statistics on appeal, such as the examiner's track record on affirmance by the PTAB.

Second, as an alternative to or in addition to the appeal process, patent applicants may consider requesting a pre-appeal conference. To request a pre-appeal conference, patent applicants must file a pre-appeal brief with a notice of appeal request. The pre-appeal brief is limited to five pages of arguments and cannot include claim amendments. The pre-appeal conference panel includes the examiner and two other conferees, who review the pre-appeal brief arguments and decide whether to allow the application, reopen prosecution, or proceed with an appeal to the PTAB. Because a pre-appeal brief is filed prior to filing an appeal brief, patent applicants can avoid the appeal process if the pre-appeal conference panel finds the examiner's rejections to be legally and/or factually flawed. On the other hand, if the pre-appeal conference panel agrees with the examiner, patent applicants have the option to file a request for continued examination (RCE), which is discussed briefly below. Compared to the appeal process, the pre-appeal process can save patent applicants time and costs.

Third, patent applicants may consider to forego oral hearing during the appeal process. Patent applicants are provided an oral hearing as a matter of right upon submission of a request for oral hearing. For arguments that may be nuanced or challenging to express in the appeal brief, patent applicants may find the oral hearing beneficial to express such arguments verbally to the

panel of PTAB judges. However, patents applicants may find these benefits to be outweighed by the time and costs associated with oral hearings. In addition, because the PTAB does not provide any type of preliminary opinion to patent applicants prior to oral hearing, preparation for oral hearing and gauging the likelihood of success may be challenging.

Fourth, patent applicants may consider planning their next steps if the PTAB affirms the examiner. In such cases, patent applicants have four options: (1) file a request for rehearing, (2) appeal to an appellate court, (3) commence a U.S. district court civil action, or (4) file an RCE. Because requests for rehearing (option 1) historically has had a high denial rate, patent applicants may want to avoid this option. In addition, patent applicants may find not find requests for rehearing beneficial because the requests generally cannot address existing arguments or introduce new evidence. With respect to filing an RCE (option 4), patent applicants are provided an opportunity to file new substantive amendments and arguments.

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By: [Todd M. Hopfinger](#) and [Christian A. Camarce](#)

This article discusses aspects of ex parte appeals of patent applications before the European Patent Office (EPO). A patent applicant may appeal an examiner's decision on refusing to grant a patent application to the EPO Board of Appeals. Four points of consideration related to the EPO appeal process are discussed below.

First, similar to the USPTO appeal process, patent applicants may consider the tradeoffs in pursuing the appeal process. In circumstances where an examiner is firmly entrenched in its positions, the appeal process provides patent applicants an opportunity to address the examiner's positions before the EPO Board of Appeals. Patent applicants must file a notice of appeal within two months of the date of notification of the decision of first instance being appealed. Within four months after the date of notification of the decision, patent applicants must file a written statement setting out the grounds of appeal. The Board closely review the records—including the written statement submitted by patent applicants—to determine the reasonableness of the examiner's arguments. But, the time and costs associated with the appeal process should also be considered when deciding to pursue the appeal process.

Second, patent applicants may consider filing a divisional application during the appeal process. The EPO Board of Appeals provides a preliminary opinion on decisive matters to the appealed matter at least four months in advance of oral proceeding, thus providing patent applicants an opportunity to gauge the likelihood of success of the appeal. If the likelihood of success appears low based on the preliminary opinion, patent applicants may consider filing the divisional application before oral proceeding. If patent applicants forego oral proceedings, they can recover 50% of the appeal fee.

Third, patent applicants may consider filing claim amendments with their appeal. Submission of substantive claim amendments during the EPO appeal process can be an advantage compared to the USPTO appeal process, which does not permit such claim amendments. However, patent applicants may need to carefully consider the scope of their claim amendments because "a party's appeal case shall be directed to the requests, facts, objections, arguments and evidence on which the decision under appeal was based." EPO Article 12(2). Accordingly, during the EPO appeal process, patent applicants may consider submitting extensive evidence, including evidence supporting various claim amendments they might wish to pursue, to ensure flexibility when submitting claim sets. The EPO requires patent applicants to rank their claim sets. Each claim set is considered in turn until the application is allowable or

no claim set remains. Patent applicants, however, may want to avoid submitting a large number of claim sets because the EPO may consider it an abuse of procedure.

Fourth, patent applicants may consider submitting a conditional request for oral proceedings at the start of the appeal process. Patent applicants can submit this request to avoid receiving an adverse decision from the EPO Board of Appeals without warning. In addition, patent applicants may find it beneficial to preserve their right to attend oral proceedings while they gauge the likelihood of success of the appeal. For example, patent applicants may submit a conditional request for oral proceedings and then schedule a telephone interview with the examiner after filing their written submissions. Alternatively, patent applicants may submit a conditional request for oral proceedings and then want to wait to receive a preliminary opinion from EPO Board of Appeals prior to the oral proceedings. Patent applicants can review the preliminary opinion to gauge the likelihood of success of the appeal. Patent applicants can also review the preliminary opinion to determine whether oral proceedings will move the matter forward and, if so, what type of arguments will be persuasive to the EPO Board of Appeals. For arguments that may be nuanced or challenging to express in writing, patent applicants may find the oral hearing beneficial to express such arguments verbally to the EPO Board of Appeals.

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This article discusses aspects of ex parte appeals of patent applications before the China National Intellectual Property Administration (CNIPA). A patent applicant may appeal (submit a re-examination request) an examiner's decision refusing to grant a patent application to the Re-examination and Invalidation Department of the Patent Office (PRB). Four points of consideration related to the CNIPA appeal process are discussed below.

First, similar to the USPTO appeal process, patent applicants may consider the tradeoffs in pursuing the appeal process. In circumstances where an examiner is firmly entrenched in its positions, the appeal process provides patent applicants an opportunity to address the examiner's positions before a panel of the PRB. The panel closely reviews the records—including briefing submitted by patent applicants—to determine the reasonableness of the examiner's arguments. Moreover, in circumstances where claim amendments may lead to an allowance, the appeal process provides patent applicants an opportunity to amend the claims at various stages before the panel issues a final decision. The examiner or the panel closely reviews the proposed amendments at each stage to determine if the amendments will lead to an allowance.

Patent applicants may also consider whether other options besides appeal are more appropriate for their goals. For example, unlike the USPTO or EPO where an appeal is often the only way to remove a patent application from a particular examiner, a patent applicant may consider filing a divisional application in China to have a different examiner examine the application. Moreover, unlike the USPTO or EPO where oral hearings are a matter of right, a patent applicant is rarely allowed an oral hearing during the CNIPA appeal process. Accordingly, for arguments that may be nuanced or challenging to express in writing, patent applicants may find the lack of an oral hearing a disadvantage of the CNIPA appeal process.

Second, patent applicants may consider filing a divisional application during the appeal process. Patent applicants can file a divisional application (1) within 3 months from the date of receiving a decision of rejection from the Chinese examiner, (2) after the request for re-examination is filed, or (3) during initiation of an administrative litigation against the re-examination decision. Patent applicants may consider filing a divisional application after receiving a preliminary assessment of the likelihood of success of their appeal. For example, patent applicants may wait to file a divisional application until after they receive the patent examiner's opinion in the interlocutory examination phase of the appeal. If an examiner's

opinion indicates an allowance is unlikely, a patent applicant may consider terminating the appeal process and proceed with filing a divisional application. When filing the divisional application, patent applicants can take into account the PRB's findings.

Third, patent applicants may consider filing claim amendments with their appeal. Submission of substantive claim amendments during the PRB appeal process can be an advantage compared to the USPTO appeal process, which does not permit such claim amendments. Moreover, unlike the EPO appeal process, patent applicants can generally submit amendments after filing their appeal. For example, patent applicants can submit amendments just before the PRB issues a Notification of Re-Examination indicating its disposition intent. This gives patent applicants at least one further opportunity to present observations and amendments. However, patent applicants may need to carefully consider the scope of their initial claim amendments because of the risk of surrendering patentable subject matter. Accordingly, during the appeal process, patent applicants may consider presenting their main amendments and arguments in the initial appeal filing and reserving their backup amendments and arguments until after receiving a Notification of Re-examination.

Fourth, patent applicants may need to carefully plan for the possibility of a Notification of Re-Examination from the PRB indicating the decision of rejection is intended to be upheld. Patent applicants have a shortened period of 1 month from the date of receipt of the Notification of Re-Examination to present additional arguments and amendments to persuade the PRB to revoke the decision of rejection. Because the next communication from the PRB can be a decision upholding the decision of rejection, patent applicants may consider telephoning one of the panel members of PRB to assess whether the panel member would be amenable to discuss how to overcome any objections raised. In addition, patent applicants may find that opening such discussion may encourage the PRB to issue another Notification of Re-Examinations, thereby providing patent applicants an additional opportunity to address any objections.

If the decision of rejection is upheld, patent applicants can still file a divisional application. While patent applicants can initiate administrative litigation against a negative appeal decision within 3 months of the date of the notification upholding the decision of rejection, patent applicants may consider forgoing such administrative litigation because the chance of success can be low.

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