

NYIPLA

Pre-appeal conferences, The one-year *ex parte* appeal, and What happens after PTAB decides an appeal.

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Agenda

- Pre-appeal conferences
- The one-year *ex parte* appeal
- What happens after PTAB decides an appeal



Pre-appeal conferences

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To pre-appeal or not

- When you should consider requesting a pre-appeal conference
 - If some or all the rejections of record
 - Are improper and without basis
 - Are based on a factual or legal error
- **When appeal might be better**
 - If the rejections of record articulate a prima facie case that requires further evidence, or interpretation of the claims or the applied art; or other evidence, to rebut

How to request a pre-appeal conference

- Use the USPTO form PTO/SB/33, or label your request form as “Pre-Appeal Brief Request For Review”
- Submit **with** notice of appeal, as a **separate** document
- No amendments, affidavits, or other evidence
- No request fee, but notice of appeal fee still required
- No more than five (5) pages of arguments attached to the request form
- **Clear, concise, focused**

What happens next?

- Technology center convenes a panel
- Panelist include:
 - The examiner charged with preparation of the examiner's answer,
 - A supervisory patent examiner, and
 - Another conferee having sufficient experience to be of assistance in the consideration of the merits of the issues on appeal
- Panel reviews rejections identified by request, arguments submitted with the request, and the application file
- Panel will decide if an issue for appeal is, in fact, present and issue a decision which should be mailed within 45 days of receipt of a properly filed request
- No applicant or representative participation

Pre-appeal: arguments

- “Clear deficiency in the prima facie case in support of a rejection”
 - Clearly improper rejections based upon error in fact
 - Omission of essential elements required for prima facie rejection
- * *New Pre-Appeal Brief Conference Pilot Program, 1296 OG 67 (July 12, 2005); Extension of the Pilot Pre-Appeal Brief Conference Program, 1303 OG 21 (Feb. 7, 2006)*
- Examples of arguments appropriate for pre-appeal
 - The applied reference is not in fact prior art
 - Inventive entity is clearly not one to which the reference can be applied
 - A claim element is clearly not present in applied art
 - Support in the disclosure is clearly found contrary to a 112(a) rejection’s assertion otherwise
 - No rationale is provided in a 103 rejection
 - No evidentiary basis for a 103 rationale is provided in the rejection

Pre-appeal: arguments (cont.)

- Examples of arguments that might take more than five pages (appropriate for appeal)
 - Secondary considerations
 - Improper combinations / teaching away in 103 rejections
 - Unsettled/challenging case law analysis
 - Questions over broadest reasonable interpretation
 - Challenges to official notice or inherency findings
 - Characteristics of POSITA* rendering 103 improper

*Person of ordinary skill in the art

Panel's decision

- Decision will relate claim's status and simply state one of the following:
 - Application remains under appeal
 - Prosecution is reopened
 - Application is allowed
 - Request is noncompliant and is dismissed

Pre-appeal conference statistics

Fiscal year	2016	2017	2018	2019	2020
Decisions to proceed	6829	5822	5418	4873	4692
Pre-appeal conference request	10148	9060	8136	8074	7377
% Decisions to proceed	67%	64%	66%	60%	64%

Pre-appeal vs. appeal conferences within the TC

	Pre-appeal	Appeal
Filing times	Same day as notice of appeal	2 months from notice of appeal (extendable for 5 additional months)
Issues	Clear legal or factual deficiency in rejection	Matters of interpretation or those requiring additional evidence, as well as any legal or factual deficiencies
Page limit	5 pages	N/A
Conferees (positions)	Examiner, SPE, another conferee	Examiner, SPE, another conferee
Decision goals	Generally ≤ 45 days	Generally ≤ 56 days

Questions and answers



The one-year *ex parte* appeal

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Ex parte appeals pendency goal

- Today's discussion: review the timing of *ex parte* appeals and discuss how an appellant can obtain a quicker decision when desired
- Allow stakeholders to make informed decision on whether to appeal to PTAB, regardless of technology
- 12-month average pendency for decided appeals, regardless of technology
 - Pendency is measured from the date jurisdiction passes to PTAB (i.e., approximately when PTAB receives all briefing, the appeal forwarding fee is paid, and an appeal number is assigned) to the date PTAB issues a decision
 - Pendency does not include the time it takes from Final Action to jurisdiction passing to the PTAB

Final Action-to-PTAB decision in one year

Appellants can increase the likelihood of receiving a PTAB decision on an appeal within one year of final rejection by:

1. Promptly filing during the briefing stage
 - notice of appeal, appeal brief, and reply brief
 - Appellants can do its part to reduce the briefing stage to 6 months or less
2. Using the PTAB Fast-Track Appeals Pilot Program
 - provides a decision within 6 months of Fast-Track decision grant
 - current non-Fast-Track appeal decision median time is around 12 months

Thus resulting in a total Final Action-to-PTAB Decision time of:

- with PTAB Fast-Track Appeals Pilot Program: < 12 months
- without PTAB Fast-Track Appeals Pilot Program : < 18 months

The course of an *ex parte* appeal

Document	Who files/issues	PTAB jurisdiction
Final Rejection	Examiner	No
Notice of Appeal	Appellant	No
Appeal Brief	Appellant	No
Examiner's Answer	Examiner	No
Reply Brief	Appellant	No
Decision	PTAB	Yes

- Jurisdiction transfers to PTAB approximately when filing of a (optional) reply brief (or expiration of the time to file a reply brief) and the appeal forwarding fee is paid.
- Other optional actions (e.g., Pre-Appeal Conference Pilot Program) may occur between some filings, before jurisdiction transfers to PTAB.

Appellant controls the briefing duration

Document	Who files/issues
Final Rejection	Examiner
Notice of Appeal	Appellant
Appeal Brief	Appellant
Examiner's Answer*	Examiner
Reply Brief	Appellant
Decision	PTAB

Maximum (months)	Typical (months)
6	4
7	3
4*	2.5*
2	2

Total briefing (months):	
~19	~11.5

* About 95% of Examiner's Answers issue within 4 months after an Appeal Brief filing, with ~2.5 months being the average overall. Neither guarantees the timing of any particular Examiner's Answer.

Total time to decision

Document	Who files/issues
Final Rejection	Examiner
Notice of Appeal	Appellant
Appeal Brief	Appellant
Examiner's Answer*	Examiner
Reply Brief	Appellant
Decision	PTAB

Maximum (months)	Typical (months)
~19	11.5
~24	~12

PTAB Jurisdiction:

Slowest PTAB appeals (<5%): ~24 months

Typical PTAB appeal: ~12 months

Total time-to-decision (months):	
~43	~23.5

The one-year appeal

Document	Typical (months)	Diligent Appellant (months)	Diligent + PTAB Fast-Track
Final Rejection	4	1	1
Notice of Appeal	3	1.5	1.5
Appeal Brief	~2.5	~2.5	~2.5
Examiner's Answer*	2	1	1
Reply Brief	~12	~12	<6
Decision			

Final-to-Decision (months):	~23	~18	<12
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- Where an Appellant would like to conclude an appeal quickly, the time frames for the briefing stage show how such appeals may proceed. It is not appropriate for all appeals.

Planning for *ex parte* appeals

- Diligent Appellant using PTAB Fast-Track Appeals Pilot Program: < 12 months Final Action-to-PTAB Decision
 - Typical time for Final Action-to-PTAB Decision: 23 1/2 months
- Appellant largely controls duration of briefing stage
 - Typical time is 11 1/2 months, which Appellant can do its part to shorten
- The average duration of an appeal after PTAB docketing is approaching 12 months.
 - PTAB Fast-Track Pilot Program goal: issue decision within 6 months

Questions and answers

What happens after PTAB decides an appeal

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Methodology

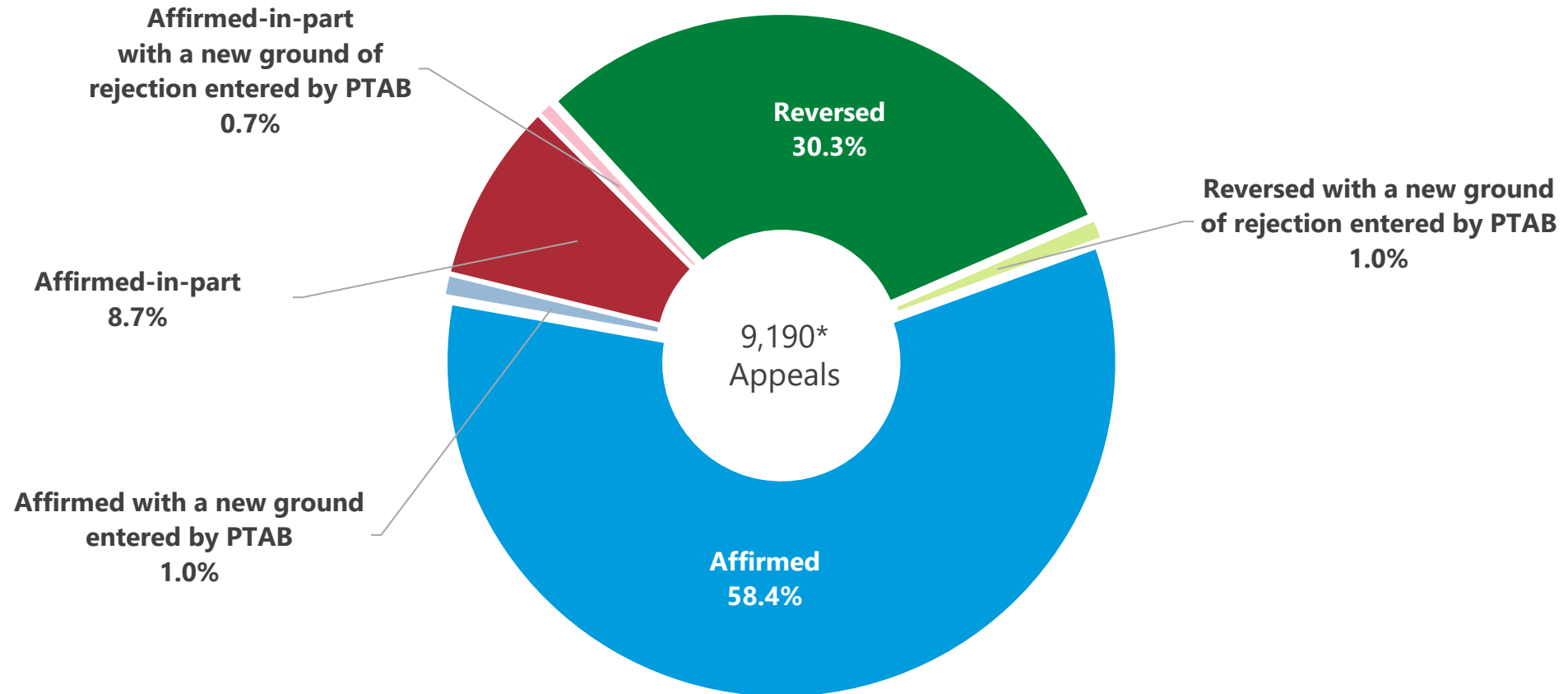
- Started with ~9,224 applications that received a PTAB decision on appeal in FY 2019
- Identified the next substantive event in application's file history
 - Excluded reexaminations and applications with only ministerial actions.
- For remaining ~9,190 applications, classified next substantive event (other than a request for rehearing) into one of four broad categories:
 - "Allowed": Notice of Allowance issued
 - "Prosecution": usually Applicant filed Request for Continued Examination with claim amendment
 - Does not include the filing of a continuation, divisional, or continuation-in-part application
 - "Abandoned": usually Notice of Abandonment issued
 - "CAFC": appealed to Court of Appeals for the Federal Circuit

Outcome Terminology—An Example to Explain

- Example: Assume an application only has claims 1-4, and each is rejected by the Examiner as obvious under 35 U.S.C. § 103.

Outcome of Appeal	Claims still rejected under 35 U.S.C. § 103	Claims newly rejected under 35 U.S.C. § 112
Affirmed	1-4	
Affirmed-in-Part	1-3 only	
Reversed	None	
Affirmed with new ground of rejection by PTAB	1-4, under a new theory	
Reversed with new ground of rejection by PTAB	None	1-4

Outcomes of decisions on appeal issued by PTAB in FY 2019 (Oct. 1, 2018 – Sept. 30, 2019)



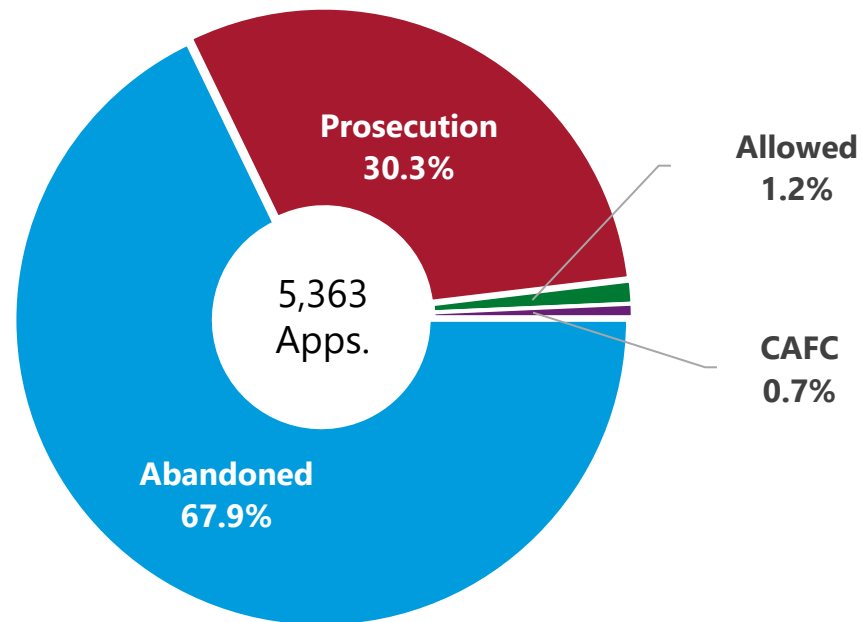
*Excludes reexaminations and applications with no meaningful post-appeal event



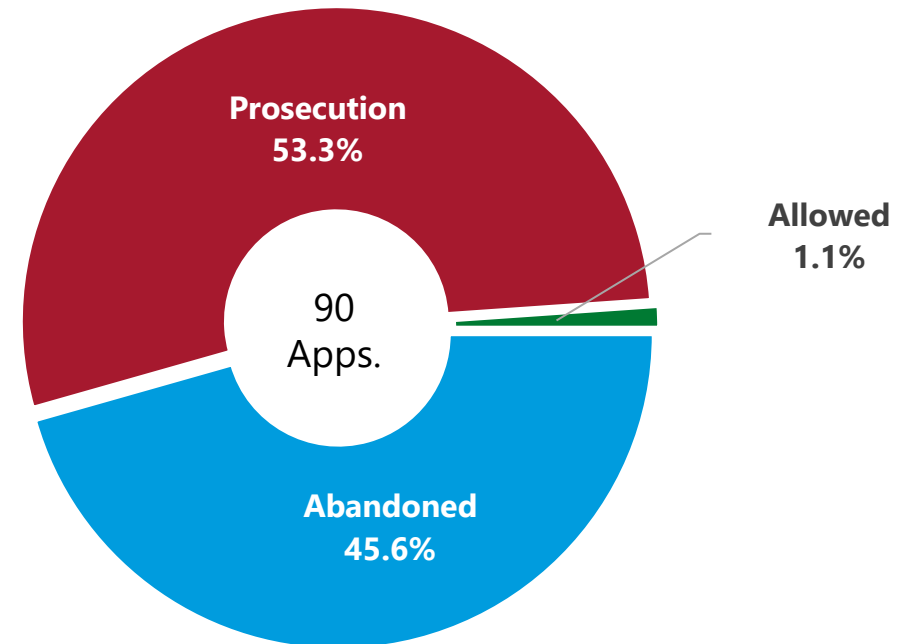
What happens in the application after the rejection of the claims is affirmed?

(Oct. 1, 2018 – Sept. 30, 2019)

Affirmed without a new ground of rejection entered by PTAB



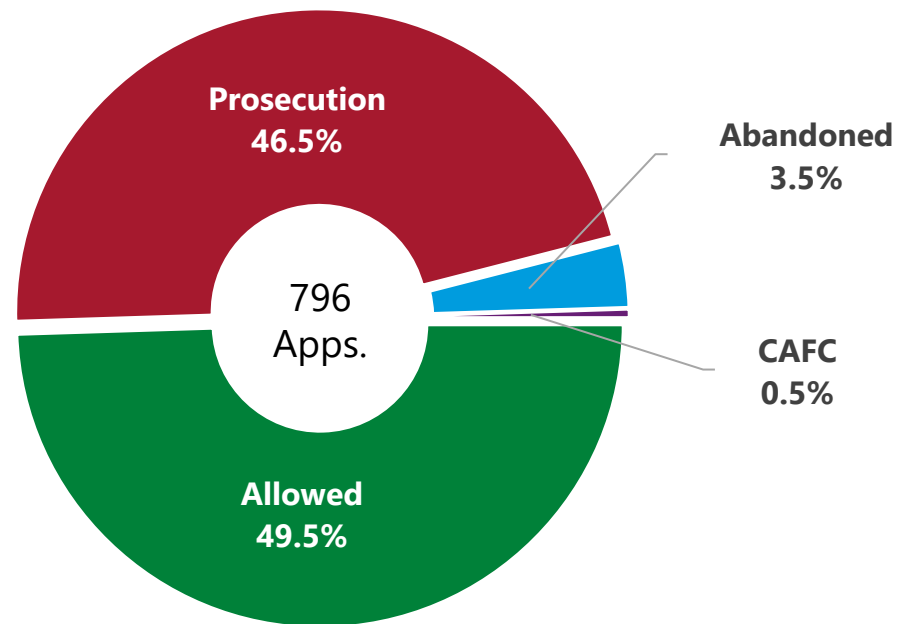
Affirmed with a new ground of rejection entered by PTAB



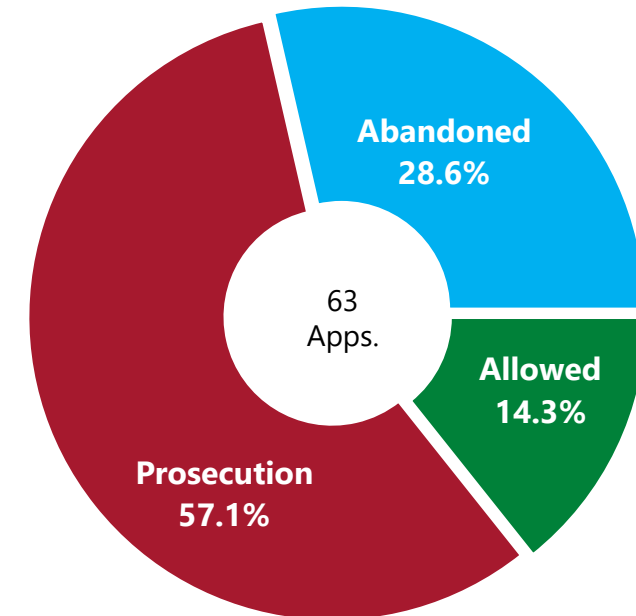
What happens in the application after the rejection of the claims is affirmed-in-part?

(Oct. 1, 2018 – Sept. 30, 2019)

Affirmed-in-part without a new ground of rejection entered by PTAB



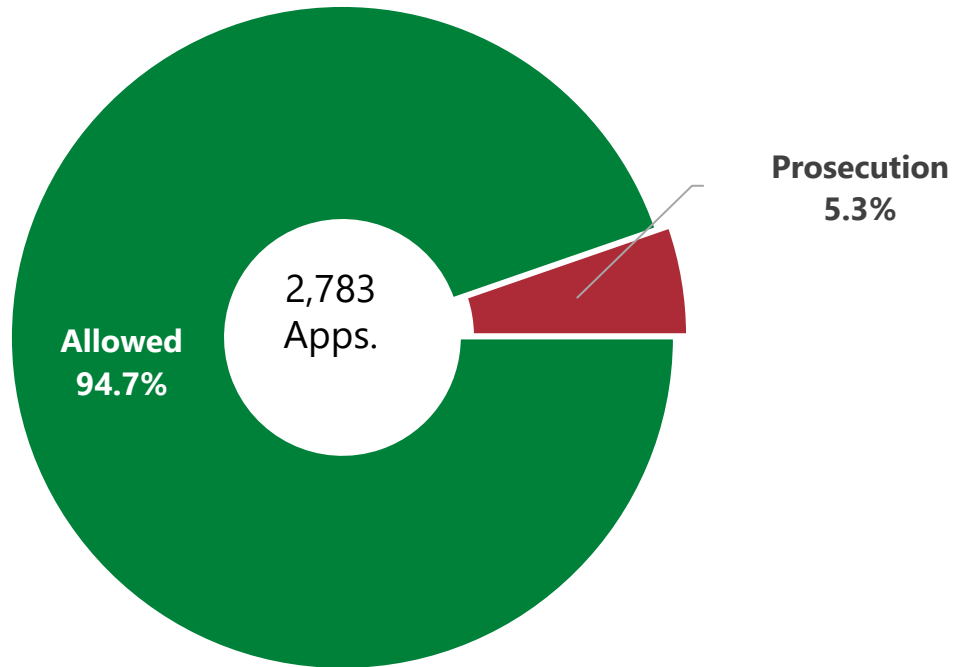
Affirmed-in-part with a new ground of rejection entered by PTAB



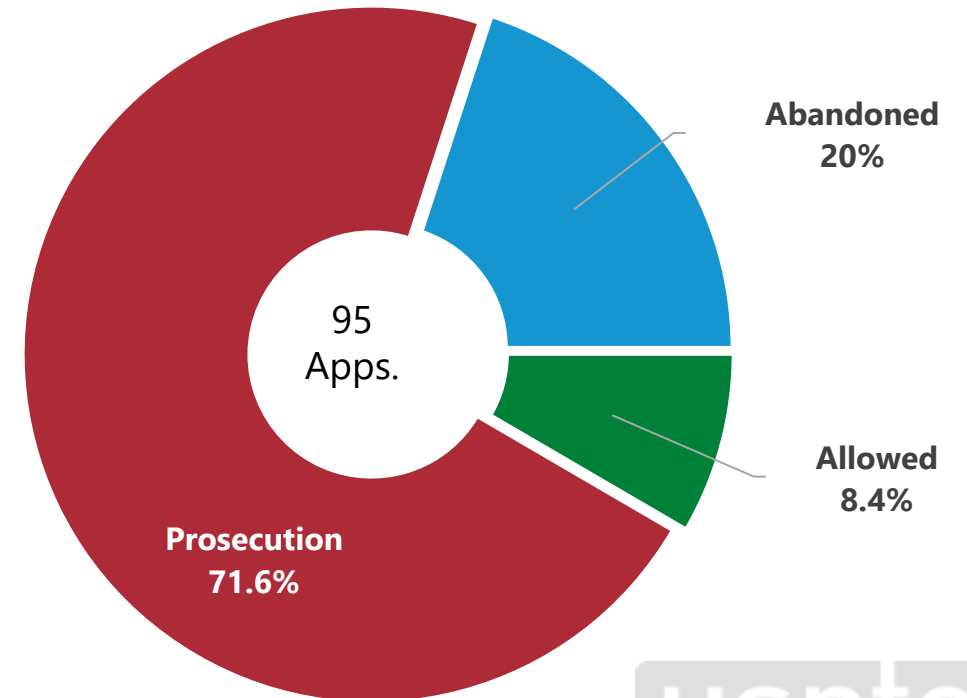
What happens in the application after the rejection of the claims is reversed?

(Oct. 1, 2018 – Sept. 30, 2019)

Reversed without a new ground of rejection entered by PTAB



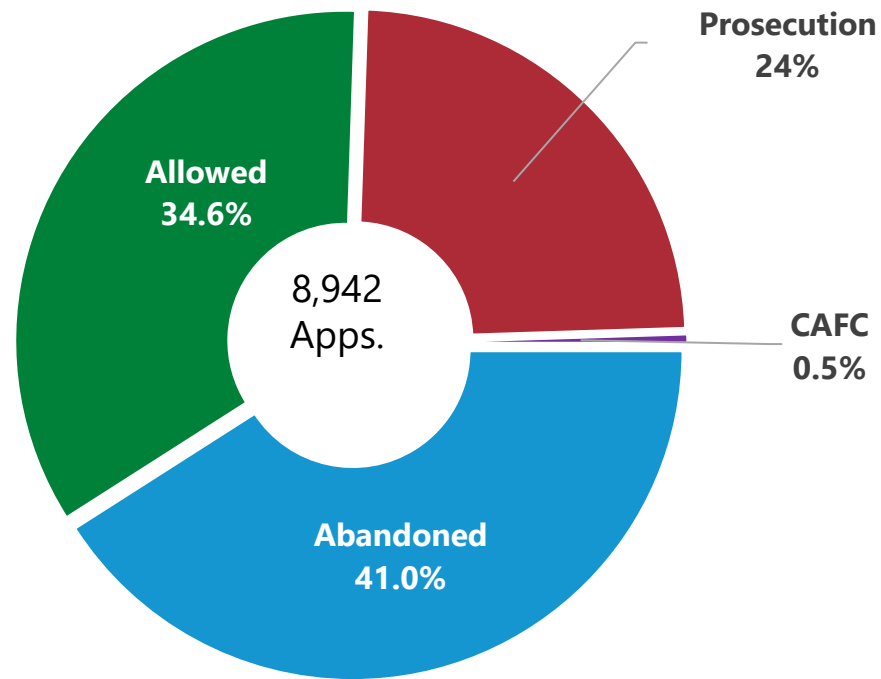
Reversed with a new ground of rejection entered by PTAB



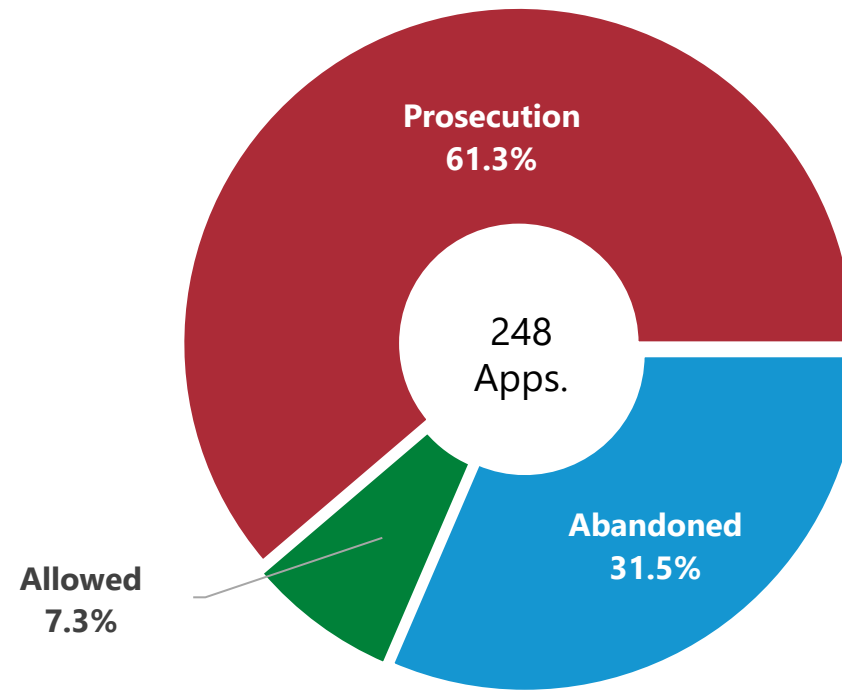
What happens in the application when a new ground of rejection is or is not entered by PTAB?

(Oct. 1, 2018 – Sept. 30, 2019)

New ground of rejection not entered by PTAB



New ground of rejection is entered by PTAB



Takeaways

- Typical outcomes:
 - Affirmed mostly led to abandonment, with most of the remainder of applications seeing further prosecution
 - Affirmed-in-part led to a nearly 50/50 between allowance and prosecution, with a small portion of applications being abandoned
 - Reversed led almost entirely to allowances, with a small portion of applications seeing further prosecution
- New grounds of rejection had a significant impact on post-appeal outcomes, for all types of PTAB decisions—generally, a much greater portion of applications saw further prosecution (over 50% for each type of decision)

Questions and answers

