

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# NYIPA October Meeting

October 4, 2022

Vice Chief Judge Janet Gongola  
Lead Judges Georgianna Braden, Alyssa  
Finamore, Ryan Flax, and Phil Kauffman  
Judge Bill Baumeister

# Written Advocacy: Ten Ways to Improve an *Ex Parte* Appeal Brief

# 1. Identify facts in dispute

- The Board reviews appealed rejections for error based upon the issues identified by Appellants, and in light of the arguments and evidence produced thereon.
  - *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)).

# 2. Appellant's burden on appeal

- Appellant carries the burden to clearly explain:
  - What evidence should be reviewed, and
  - What the reversible error is.
- By statute, the Board functions as a board of review, not a de novo examination tribunal. 35 U.S.C. § 6(b)(1) (“[t]he [board] shall ... review adverse decisions of examiners upon applications for patents ...”).
- 37 C.F.R. § 41.37(c)(1)(iv): “[A]ny arguments or authorities not included in the appeal brief will be refused consideration by the Board for purposes of the present appeal.”

## 2. Appellant's burden on appeal

- Do *not* assume that the art speaks for itself.
- If an argument has been addressed by the Examiner in the Office Action, Appellant should address the Examiner's response.
- "It is not the function of [an appellate tribunal] to examine the claims in greater detail than argued by an appellant, looking for [patentable] distinctions over the prior art." *In re Baxter Travenol Labs.*, 952 F.2d 388, 391 (Fed. Cir. 1991).

# 3. Appealable v. Petitionable

- The Board’s statutory duty is to review “adverse decisions of examiners” on appeal. 35 U.S.C. § 6(b).
  - These adverse decisions are claim *rejections* on the merits (i.e., related to the grounds for patentability set forth in 35 U.S.C. §§ 101, 102, 103, and 112).
- Decisions by examiners that are not decided by the Board or the court, instead may be petitioned to the TC Director or the Office of Petitions. 37 C.F.R § 1.181.
  - Examples of Examiner’s decisions that are of a discretionary, procedural, or non-substantive nature:
    - Objections to drawings or specification;
    - Restriction requirements;
    - Refusal to enter an amendment; and
    - Patent term extension.
- The Board can review objections in rare situations where the basis for objection is directly connected with the merits of issues involving rejections of claims.
  - *In re Hengehold*, 440 F. 2d 1395 (CCPA 1971).
  - *Ex parte Frye*, 94 USPQ2d 1072, 1078 (BPAI 2010) (precedential).



# 4. Start with the strongest arguments

- Consider the organization of the arguments in the brief.
- Including arguments that have no bearing on the issues in the case distracts from the strongest arguments.
  - E.g., the fact that the examiner used the same references (or switched between a small set of references) throughout prosecution is not a strong argument
  - E.g., general frustration about the examination process
- Boilerplate statements are unhelpful and distract from meritorious arguments.
- “[M]ere statements of disagreement ... do not amount to a developed argument.” *SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1320 (Fed. Cir. 2006).

# 5. Strategize which claims to argue

- Boilerplate arguments for dependent claims are not considered separate arguments.
  - “A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.”  
37 C.F.R. § 41.37(c)(1)(iv).
- For those claims argued separately, place such arguments under separate sub-headings.
  - 37 C.F.R. § 41.37(c)(1)(iv): “any claim(s) argued separately or as a subgroup shall be argued under a separate subheading that identifies the claims by number.”

# 6. Supporting evidence is key

- Support arguments with the objective evidence.
  - Although it is true that all evidence of nonobviousness, including data in the specification, must be considered when assessing patentability, *In re Soni*, 54 F.3d 746, 750 (Fed. Cir. 1995) (citing *In re Margolis*, 785 F.2d 1029, 1031 (Fed. Cir. 1986)), the burden of analyzing and explaining data to support nonobviousness rests with the Appellant. *In re Klosak*, 455 F.2d 1077, 1080 (CCPA 1972).
- Attorney argument is not evidence.
  - "Attorneys' argument is no substitute for evidence." *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1581 (Fed. Cir. 1989).

# 6. Supporting evidence is key

- Helpful to submit an Evidence Appendix, including any previously submitted declarations and other evidence cited in the Appeal Brief.
  - At a minimum, be sure to clearly identify the evidence using a clear description of the evidence along with the date of entry of such evidence.
  - 37 C.F.R. § 41.37(c)(2): “A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other Evidence.”
- But no need to include the specification or evidence that the examiner relies upon.

# 7. Accuracy of Summary of Claimed Subject Matter

- Required under 37 C.F.R. § 41.37(c)(iii).
- Important for any claim construction or 112 issues, particularly means-plus-function issues.
- This section is more than formality. It helps the judges understand the invention.
  - Helpful to direct the judges to specific disclosure (including drawings).

# 8. Use correct version of the claims

- “A brief shall not include any new or non-admitted amendment.” 37 C.F.R. § 41.37(c)(2).
- In some cases, claims are amended after the final rejection. The examiner may or may not enter the amendment.
- Arguments must be based on limitations in the latest version of claims entered into the record.

# 9. Filing a Reply Brief

- Appellant **MAY** file a single Reply Brief within two months of Examiner's Answer.\*\* 37 C.F.R. § 41.41(a).
- Generally no new amendments, affidavits, or evidence. 37 C.F.R. § 41.41(b).
- Arguments must be first raised in Appeal Brief or be responsive to a determination first raised in the Answer. 37 C.F.R. § 41.41(b).
- No extensions of time are permitted. 37 C.F.R. § 41.41(c).

\*\* Or within 2 months of a decision refusing to grant petition to designate a new ground of rejection.

# 10. Request for Rehearing

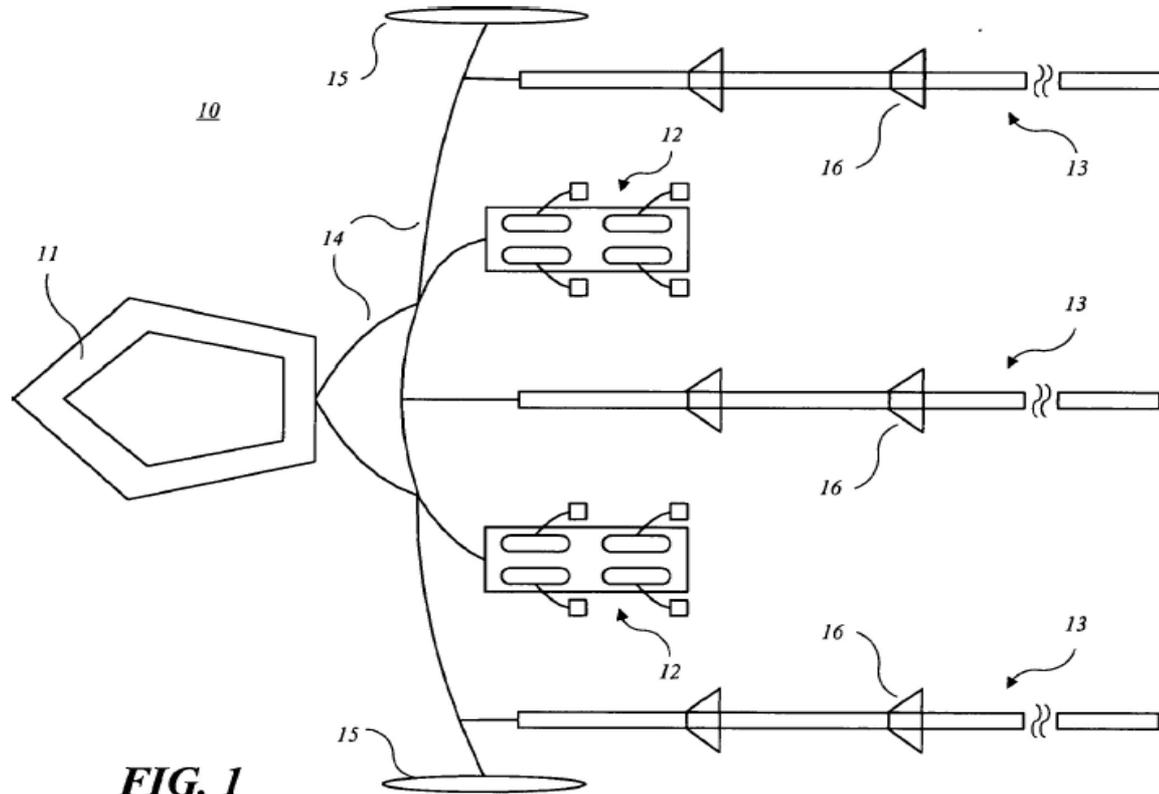
- Appellant must state the points that the Board's decision "misapprehended or overlooked." 37 C.F.R. § 41.79(b).
- Ineffective to repeat arguments previously made in the appeal and/or reply briefs.
  - Instead identify where an argument was made if alleging that the Board failed to consider it or erred in considering it.
- New arguments and evidence not raised in the briefs generally not permitted. 37 C.F.R. § 41.79(b).

# **Oral Advocacy: Effective Oral Hearings for an *Ex Parte* Appeal**

# Claimed Invention

- System for safeguarding seismic equipment in oil and gas geo-prospecting by shocking sharks
  1. A **system** to protecting towed marine seismic equipment from shark bite, comprising:
    - marine seismic **equipment** adapted for towing through a body of water; and
    - an **electropositive metal** attached to the marine seismic equipment to repel sharks from the seismic equipment.

# Figure 1



**FIG. 1**

# Rejection

- Claim 1 is rejected as obvious over the combination of:
  - Reference 1: Iranpour
  - Reference 2: Stroud

# Prior Art: Iranpour

- Iranpour discloses conducting marine surveys using towed seismic equipment
- Iranpour explains that marine animals may cross paths with the surveys, and to avoid harming the marine animals, a prevention zone should be identified and maintained around the animal

# Prior Art: Stroud

- Stroud discloses a device and method for repelling elasmobranchs (e.g., sharks, rays, and skates) with electropositive metals coated on small equipment such as buoys, nets, surfboards, and human-worn accessories like belts and flippers

# Examiner's Rejection

- Examiner finds that Iranpour teaches the concept of towing seismic equipment through water and limiting contact with marine creatures
- Examiner finds that Iranpour does not teach coating the equipment with an electropositive metal, but Stroud does
- Examiner states it would have been obvious to modify the system of Iranpour with the electropositive metal of Stroud to reduce damage to the equipment

# Appeal: Argument 1

- Appellant argues Stroud is not analogous art because it is from a different field of endeavor: commercial fishing and not oil and gas geo-prospecting
- Appellant also argues that Stroud solves a different problem: avoiding marine animals rather than repelling sharks

# Appeal: Argument 2

- Appellant argues Examiner's rationale to combine is conclusory and lacks evidence
  - Iranpour is about protecting marine animals, not repelling sharks
  - POSIA would not look to Iranpour b/c of large size difference between the size of the equipment involved: buoys and flippers versus large seismic equipment

**Mock Argument**

**Thank You**

