

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# ***Winning an ex parte appeal: what you need to know***

Mike Cygan, Administrative Patent Judge

Debra Dennett, Administrative Patent Judge

Jeff Fredman, Administrative Patent Judge

Brandon Warner, Administrative Patent Judge

Tuesday, July 18, 2023



UNITED STATES  
PATENT AND TRADEMARK OFFICE ®

# Topics

- Part 1: Steps in an ex parte appeal
- Part 2: Common errors made in filing an appeal brief
- Part 3: Persuasive arguments in an appeal brief
- Part 4: Audience questions

Judge Debra Dennett

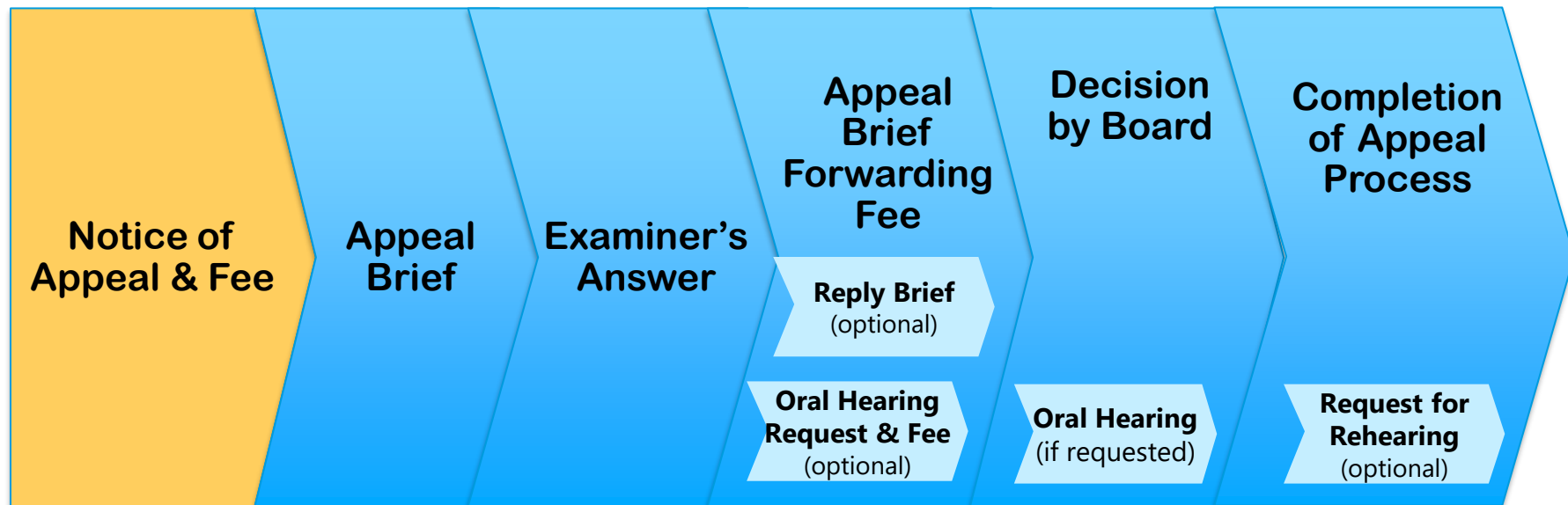
# **Part 1: Steps in an ex parte appeal**

# Adverse decision of the examiner

- Starting point is an Office Action including a rejection of one or more claims
- Appeal is taken from the Office Action, so the Office Action defines the Examiner's position on appeal
- You cannot appeal from *every* Office Action
  - Application must be twice rejected
  - Office Action does not have to be final



# Ex parte appeal process



# Notice of appeal

- You must give notice that you intend to appeal from the Examiner's decision and pay an appeal fee
- Notice and payment of the fee are due 3 months after the mailing date of the Examiner's decision from which appeal is being taken, e.g., Final Office Action
  - Time period is extendable for 3 additional months, so you can file a Notice of Appeal with payment of the appeal fee as late as 6 months after the Examiner's decision
- Office provides a form:  
<https://www.uspto.gov/sites/default/files/documents/aia0031.pdf>



# Notice of Appeal Form

PTO/AIA/31 (12-22)  
Approved through 05/31/2024. OMB 0651-0031

U.S. Patent and Trademark Office  
U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>NOTICE OF APPEAL FROM THE EXAMINER TO THE PATENT TRIAL AND APPEAL BOARD</b>	Docket Number (Optional)
--	--------------------------

I hereby certify that this correspondence is being facsimile transmitted to the USPTO, transmitted via the USPTO's patent electronic filing system, or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 [37 CFR 1.4(a)] on \_\_\_\_\_.

Signature _____	First Named Inventor _____
Typed or printed name _____	Applicant Number _____ Filed _____
	For _____
	Art Unit _____ Examiner _____

Applicant hereby appeals to the Patent Trial and Appeal Board from the last decision of the examiner.

The fee for this Notice of Appeal is (37 CFR 41.20(b)(1)) \$ \_\_\_\_\_

Applicant asserts small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by 60%, and the resulting fee is: \$ \_\_\_\_\_

Applicant certifies micro entity status. See 37 CFR 1.29. Therefore, the fee shown above is reduced by 80%, and the resulting fee is: \$ \_\_\_\_\_  
Form PTO/SB/15A or B or equivalent must either be enclosed or have been submitted previously.

A check in the amount of the fee is enclosed.

Payment by credit card. Form PTO-2038 is attached.

The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. \_\_\_\_\_.

Payment made via USPTO's patent electronic filing system (Patent Center or EFS-Web).

A petition for an extension of time under 37 CFR 1.136(a) (PTO/AIA/22 or equivalent) is enclosed.  
For extensions of time in reexamination proceedings, see 37 CFR 1.550.

**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

I am the

applicant       attorney or agent of record       attorney or agent acting under 37 CFR 1.34

Registration number: \_\_\_\_\_      Registration number: \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Telephone Number \_\_\_\_\_

Date \_\_\_\_\_

**NOTE:** This form must be signed in accordance with 37 CFR 1.33. See 37 CFR 1.4 for signature requirements and certifications. Submit multiple forms if more than one signature is required, see below\*.

\* Total of \_\_\_\_\_ forms are submitted.

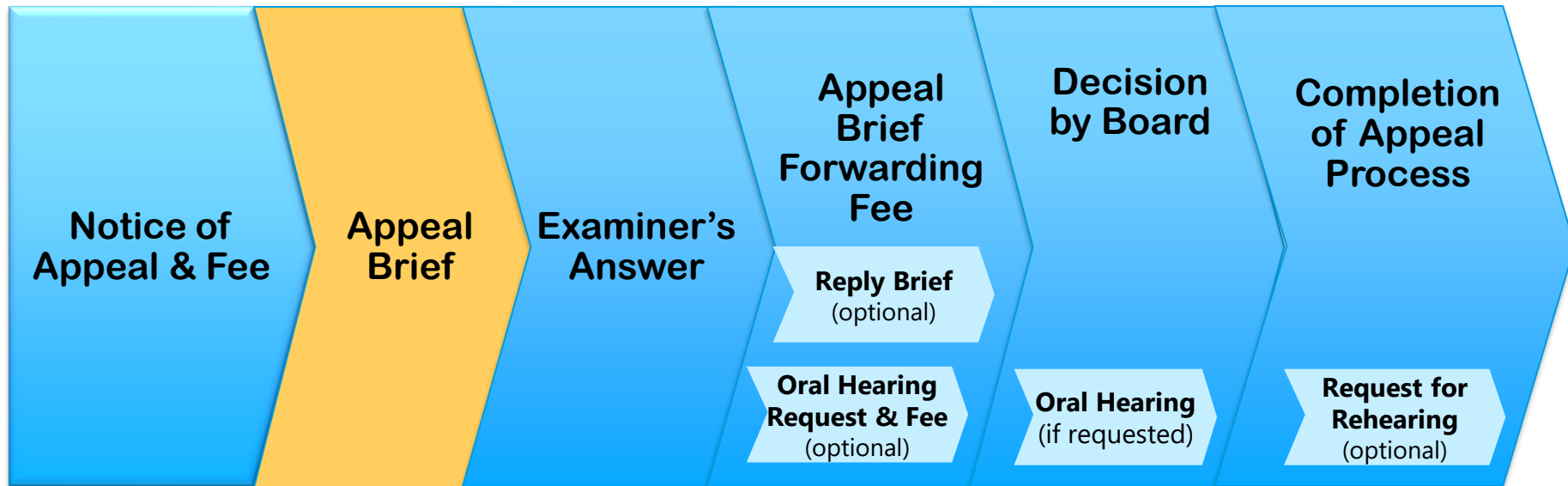
A Federal agency may not conduct or sponsor, and a person is not required to respond to, nor shall a person be subject to a penalty for failure to comply with an information collection subject to the requirements of the Paperwork Reduction Act of 1995, unless the information collection has a currently valid OMB Control Number. The OMB Control Number for this information collection is 0651-0031. Public burden for this form is estimated to average 12 minutes per response, including the time for reviewing instructions, searching existing data sources, gathering and maintaining the data needed, and completing and reviewing the information collection. Send comments regarding this burden estimate or any other aspect of this information collection, including suggestions for reducing this burden to the Chief Administrative Officer, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450 or email InformationCollection@uspto.gov. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.





# Ex parte appeal process

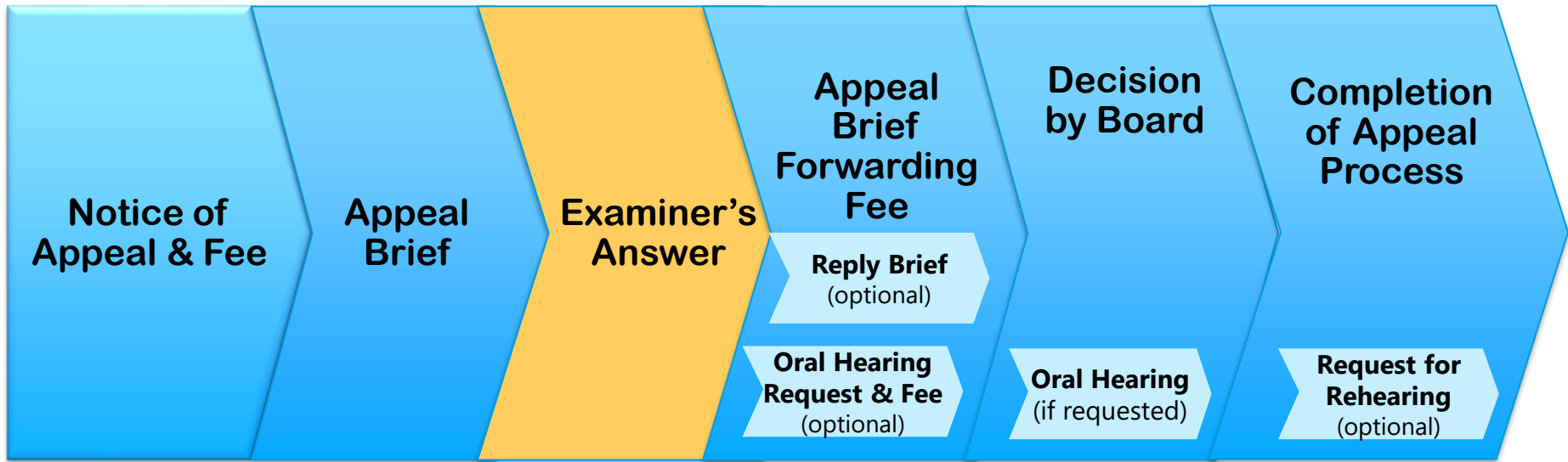


# Appeal brief

- No fee due with Appeal Brief
- Appeal Brief is due 2 months after you file the Notice of Appeal
  - This time period is extendable for 5 additional months
- Legal brief (not a form) that includes your arguments and defines the appeal
  - Appeal Brief identifies the issues the judges will consider on appeal
  - Judges generally will not look for issues, even issues that would resolve the appeal in your favor
  - If an argument is not raised in the Appeal Brief, it may be waived



# Ex parte appeal process

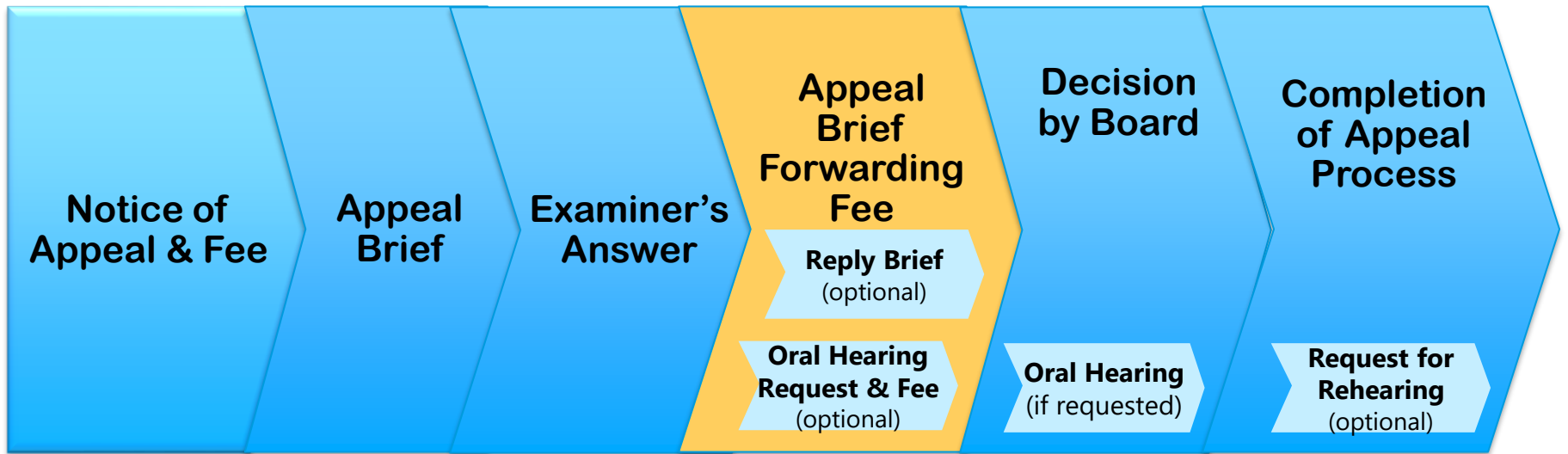


# Examiner's Answer

- Examiner's response to the Appeal Brief
  - Examiner will respond to all of the arguments in the Appeal Brief
  - Examiner will consider whether to maintain or modify each rejection
- Includes certain sections
  - Ground(s) of Rejection to Be Reviewed on Appeal
    - Withdrawn Rejection(s)
    - New Ground(s) of Rejection
  - Response to Arguments



# Ex parte appeal process



# Appeal forwarding fee

- Due 2 months after Examiner's Answer – NOT EXTENDABLE
- Easy to forget
- May be filed with Reply Brief (optional) and/or request for oral hearing (optional)
  - No fee for Reply Brief
  - Request for oral hearing requires payment of a fee
- Office provides a form for submitting payment of the fee:  
<https://www.uspto.gov/sites/default/files/forms/aia0034.pdf>



# Appeal Forwarding Fee Form

Doc Code: WFEE.APEAL  
Doc Description: Certification and Transmittal of Appeal Forwarding Fee

TO/AIA/34 (12-22)

**CERTIFICATION AND TRANSMITTAL OF APPEAL FORWARDING FEE** Docket Number (Optional)

I hereby certify that this correspondence is being facsimile transmitted to the USPTO, transmitted via the USPTO's patent electronic filing system, or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22304-1450."

First Named Inventor	Application Number	Filed
Signature	Art Unit	Examiner
Typed or printed name		

37 CFR 41.45 specifies that, in order to avoid dismissal of the appeal, appellant must pay the fee set in 37 CFR 41.20(b)(4) within two months of the later of the date of either the examiner's answer, or a decision refusing to grant a petition under 37 CFR 1.181 to designate a new ground of rejection in an examiner's answer.

The undersigned certifies that the appropriate fee accompanies this transmittal.

The fee for forwarding this appeal is (37 CFR 41.20(b)(4)) \$ \_\_\_\_\_

Appellant asserts small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by 60%, and the resulting fee is: \$ \_\_\_\_\_

Appellant certifies micro entity status. See 37 CFR 1.29. Therefore, the fee shown above is reduced by 80%, and the resulting fee is: \$ \_\_\_\_\_  
Form PTO/SB/15A or B or equivalent must either be enclosed or have been submitted previously.

A check in the amount of the fee is enclosed.

Payment by credit card. Form PTO-2038 is attached.

The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. \_\_\_\_\_

Payment made via USPTO's patent electronic filing system (Patent Center or EFS-Web).

Extensions of time under 37 CFR 1.136(a) for patent applications are not applicable to the time period set forth in this 37 CFR 41.45. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for *ex parte* reexamination proceedings.

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

I am the

appellant       attorney or agent of record       attorney or agent acting under 37 CFR 1.34  
Registration number \_\_\_\_\_      Registration number \_\_\_\_\_

Signature \_\_\_\_\_  
Typed or printed name \_\_\_\_\_  
Telephone Number \_\_\_\_\_  
Date \_\_\_\_\_

NOTE: This form must be signed in accordance with 37 CFR 1.33. See 37 CFR 1.4 for signature requirements and certifications. Submit multiple forms if more than one signature is required, see below\*.

\* Total of \_\_\_\_\_ forms are submitted.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



# Reply brief

- Optional
- Due 2 months after Examiner's Answer – NOT EXTENDABLE
- Should be submitted at the same time as payment of the appeal forwarding fee
- No additional fee for the Reply Brief





# Oral hearing request

- Optional
- Due 2 months after Examiner's Answer or on the date of filing a reply brief, whichever is earlier – NOT EXTENDABLE
- Must include payment of a fee
- Office provides a form:  
<https://www.uspto.gov/sites/default/files/documents/aia0032.pdf>



# Oral Hearing Request Form

PTO/AIA/32 (12-22)  
Through 05/31/2024. OMB 0651-0031

U.S. Patent and Trademark Office DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays this OMB control number.

<b>REQUEST FOR ORAL HEARING BEFORE THE PATENT TRIAL AND APPEAL BOARD</b>		Docket Number (Optional)
I hereby certify that this correspondence is being facsimile transmitted to the USPTO, transmitted via the USPTO's patent electronic filing system, or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450."		First Named Inventor _____
37 CFR 1.6(a) on _____		Application Number _____
Signature _____		For _____
Typed or printed name _____		Art Unit _____ Examiner _____

Applicant hereby requests an oral hearing before the Patent Trial and Appeal Board in the appeal of the above-identified application.

The fee for this Request for Oral Hearing is (37 CFR 41.20(b)(3)) \$ \_\_\_\_\_

Applicant asserts small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by 60%, and the resulting fee is: \$ \_\_\_\_\_

Applicant certifies micro entity status. See 37 CFR 1.29. Therefore, the fee shown above is reduced by 80%, and the resulting fee is: \$ \_\_\_\_\_  
Form PTO/SB/15A or B or equivalent must either be enclosed or have been submitted previously.

A check in the amount of the fee is enclosed.

Payment by credit card. Form PTO-2038 is attached.

The Director has already been authorized to charge fees in this application to a Deposit Account.

The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. \_\_\_\_\_.

Payment made via USPTO's patent electronic filing system (Patent Center or EFS-Web).

A petition for an extension of time under 37 CFR 1.134(b) (PTO/SB/23 or equivalent) is enclosed.  
For extensions of time in reexamination proceedings, see 37 CFR 1.550.

**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

I am the

applicant       attorney or agent of record       attorney or agent acting under 37 CFR 1.34

Registration number \_\_\_\_\_      Registration number \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Telephone Number \_\_\_\_\_

Date \_\_\_\_\_

**NOTE:** This form must be signed in accordance with 37 CFR 1.33. See 37 CFR 1.4 for signature requirements and certifications. Submit multiple forms if more than one signature is required, see below\*.

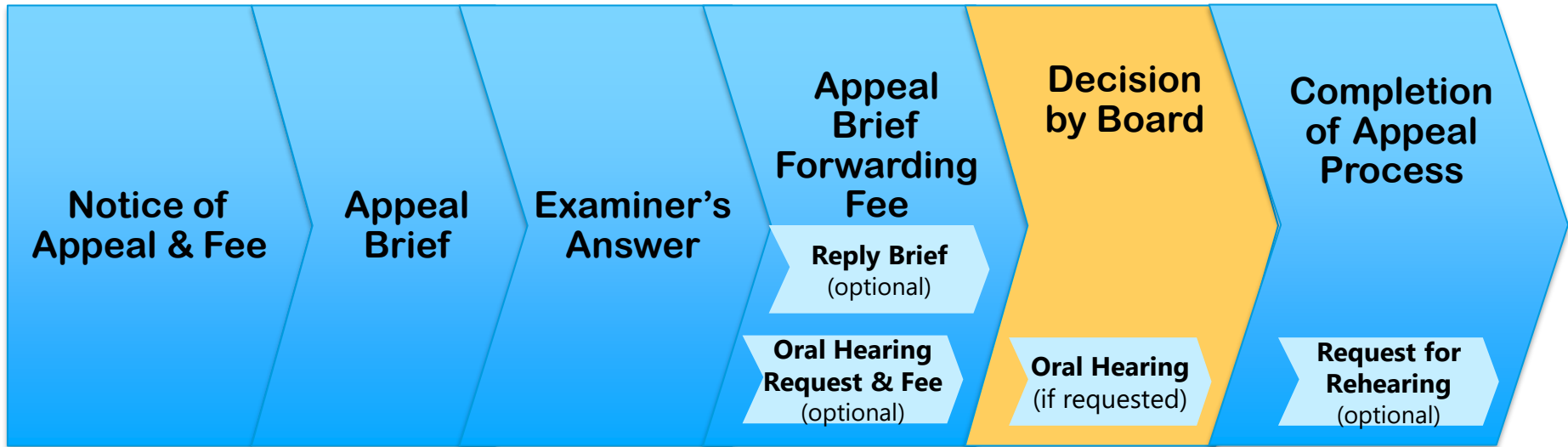
\* Total of \_\_\_\_\_ forms are submitted.

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If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



# Ex parte appeal process

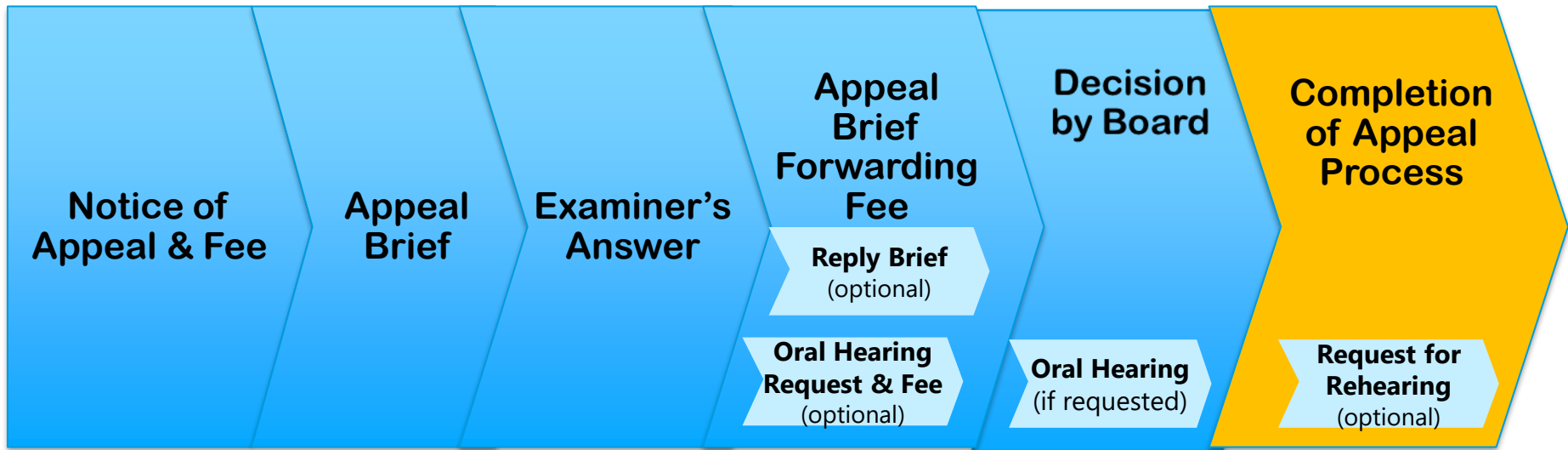


# Board decision

- Outcome may be an affirmance, an affirmance-in-part, a reversal, or new ground(s) of rejection
  - Affirmance: Every claim subject to a sustained rejection
  - Affirmance-in-Part: At least one claim, but not all, subject to a sustained rejection
  - Reversed: No claim subject to a sustained rejections
  - New Ground(s) of Rejection: Judges issue a new rejection of one or more claims
  - Sometimes, there may be a dissenting or concurring opinion



# Ex parte appeal process



# Rehearing

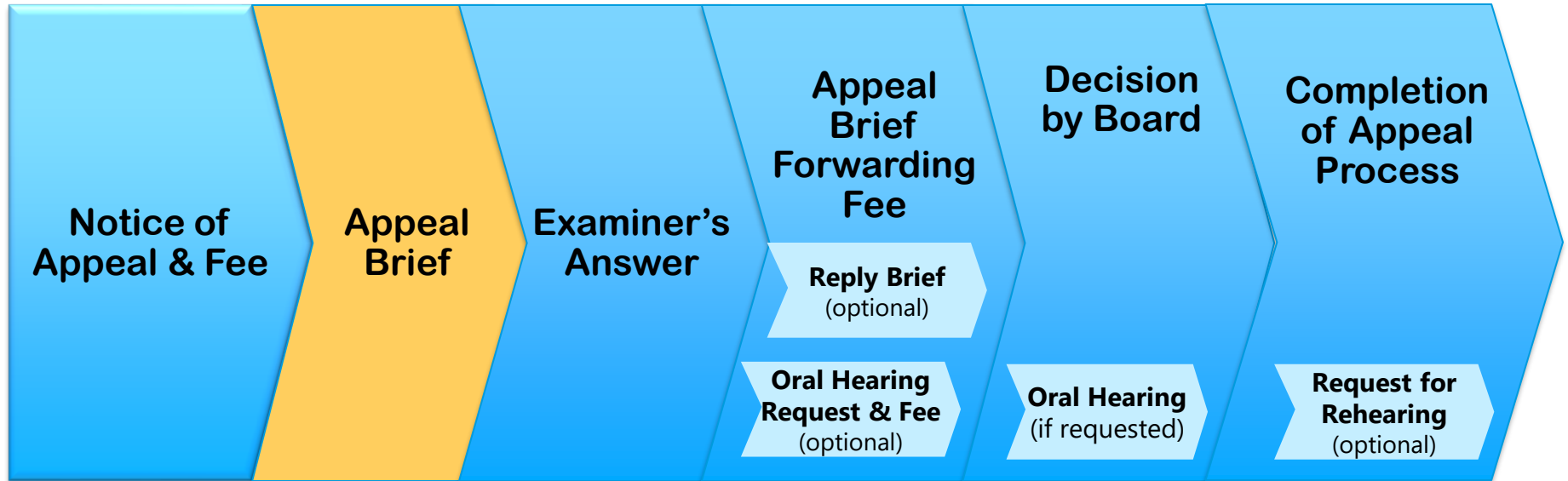
- If the outcome of the Board decision is an affirmance, an affirmance-in-part, or new ground(s) of rejection, a single rehearing request may be filed where:
  - Board decision misapprehended or overlooked specific points;
  - New grounds of rejection misapprehended or overlooked points;
  - Board decision includes undesignated new ground of rejection; or
  - New arguments limited to new Federal Circuit decision



Judge Brandon Warner

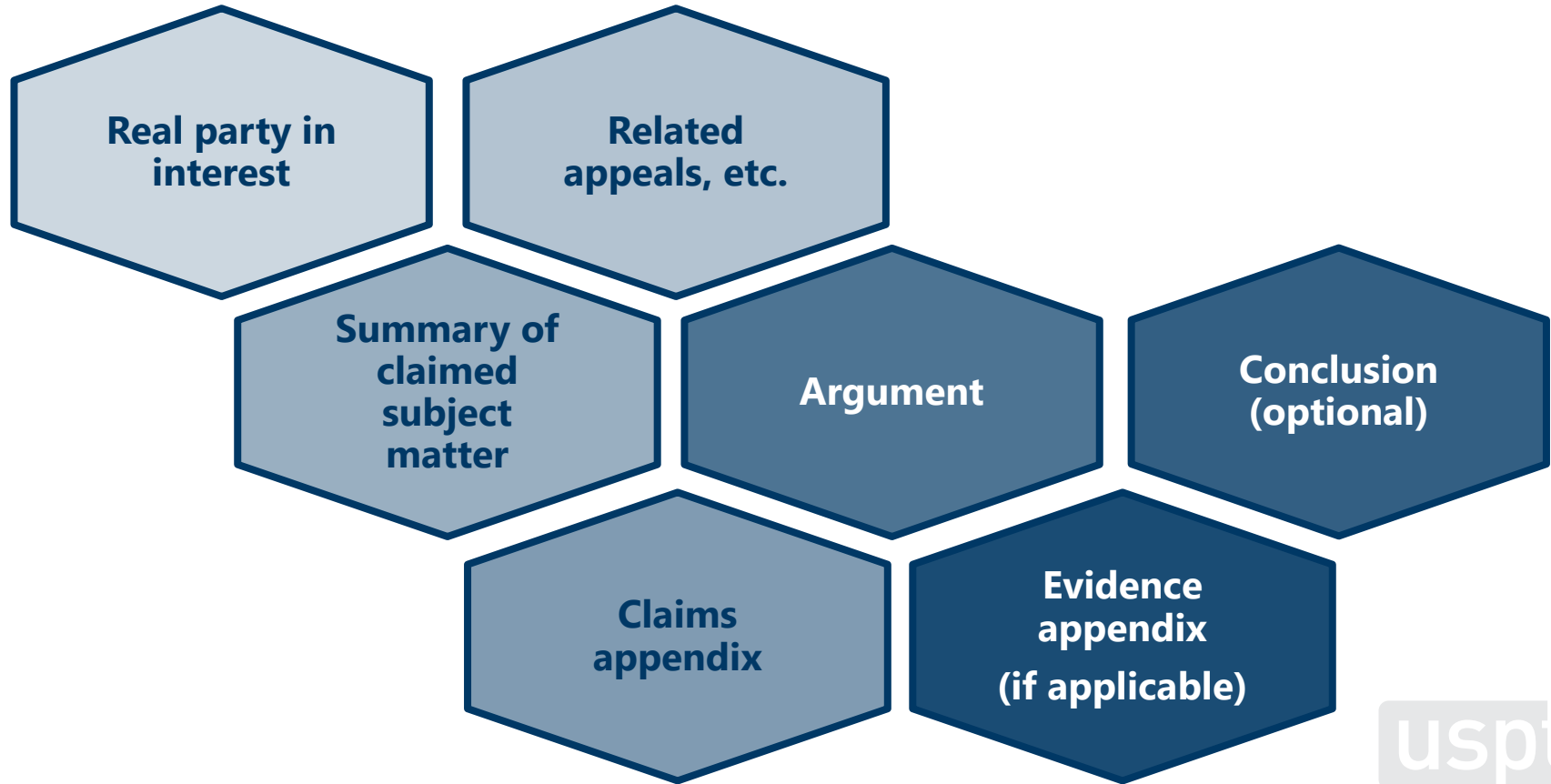
## **Part 2: Common errors made in filing an appeal brief**

# Ex parte appeal process





# Appeal brief rules – where & what



# Appeal brief template

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors: [Inventor Name(s)]	Group Art Unit: [####]
Application No. [#####]	Examiner: [Name]
Filed: [Application Filing Date]	Confirmation No. [#####]
Title: [APPLICATION TITLE]	

MAIL STOP APPEAL BRIEF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

## APPEAL BRIEF

Appellant submits this Appeal Brief in response to the final Office action mailed [Date], and further to the Notice of Appeal filed [Date]. Appellant requests consideration of this appeal by the Patent Trial and Appeal Board.

Application [Application #]

- I. REAL PARTY IN INTEREST  
Add
  - II. RELATED APPEALS, INTERFERENCES, AND TRIALS  
Add
  - III. SUMMARY OF CLAIMED SUBJECT MATTER  
Add
  - IV. ARGUMENTS  
Add
    - a. *Rejection 1 – The Rejection of Claims . . . Based on . . .*
      - i. *Independent Claim 1*  
Add
      - ii. *Independent Claim [#]*  
Add
    - b. *Rejection 2 – The Rejection of Claims . . . Based on . . .*
      - a. *Independent Claim 1*  
Add
      - b. *Independent Claim [#]*  
Add
  - V. CONCLUSION  
Add
- Date: [Date]

[Signature Block]

2

Application [Application #]

CLAIMS APPENDIX

1. [Add].

i

# Appeal brief rules – how enforced



# Notice of Non-Compliant Appeal Brief Form

<b>Notification of Non-Compliant Appeal Brief (37 CFR 41.37)</b>	Application No.	Applicant(s)	
	Examiner	Art Unit	

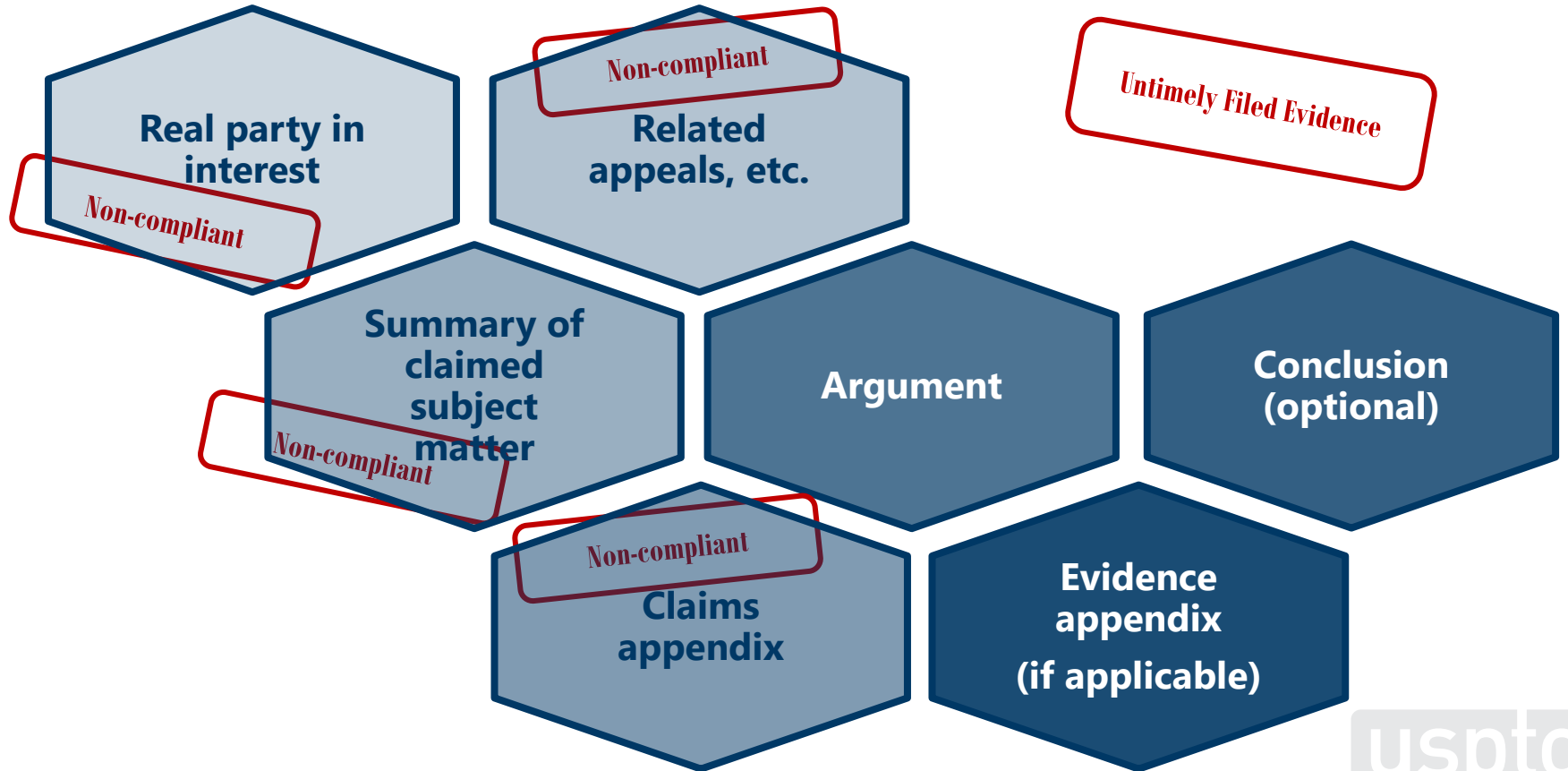
*The MAILING DATE of this communication appears on the cover sheet with the correspondence address--*

The Appeal Brief filed on \_\_\_\_\_ is defective for failure to comply with one or more provisions of 37 CFR 41.37(c).

To avoid dismissal of the appeal, applicant must file an amended brief or other appropriate correction (see MPEP 1205.03) within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer.  
**EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.**

- The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
- (a) The brief does not contain a concise explanation of the subject matter defined in each of the rejected independent claims, referring to the specification in the Record by page and line number or by paragraph number and to the drawings, if any, by reference characters; and/or (b) the brief fails to identify, for each rejected independent claim and for each dependent claim argued separately that contains a means plus function or step plus function recitation under 35 U.S.C. 112, sixth paragraph, the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification in the Record by page and line number or paragraph number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(iii)).
- The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(v)).
- Other (including any explanation in support of the above items):  
\_\_\_\_\_

# Common errors



# Real party in interest



**Name**



Real party in interest

- Inventor(s)?
- Assignee(s)?
- Parent corporation(s)?



Obligation to **update**

# Related cases



Identify by **number**



**Prior** and **pending**



Appellant/assignee **owns**



**Known** to appellant, counsel, assignee



May be **related** to, directly **affect**,  
be directly **affected by**, have a **bearing**

# Summary of claimed subject matter

- ✓ Concise explanation
- ✓ **Each rejected** independent claim
- ✓ Specification **as filed**
  - Not pre-grant publication
- ✓ **Page/line** numbers & drawings
- ✓ Structure for means + function



# Summary of claimed subject matter

## Common errors



Not citing to specification **as filed**



Not addressing **each** independent claim



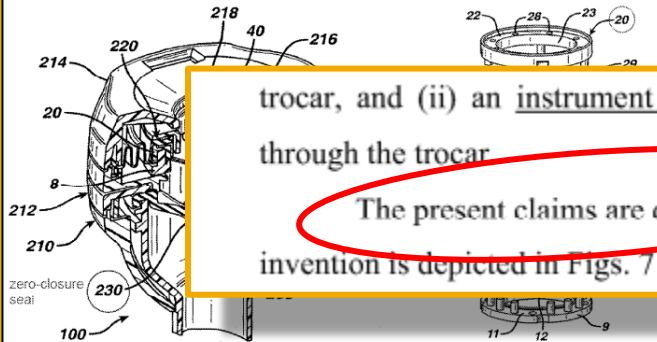
Referring only to **drawings** (& not specification)

# Common mistakes: example 1

## (V) SUMMARY OF CLAIMED SUBJECT MATTER

Trocars are used during minimally invasive endoscopic surgery. Surgical instruments with long shafts are inserted through the trocars to perform various surgical tasks. Trocars typically have two distinct types of seals to prevent the escape of fluid or gas during the surgical procedure: (i) a zero-closure seal intended seal the trocar when there is no instrument in the trocar, and (ii) an instrument seal intended to seal the trocar while instruments are inserted through the trocar.

The present claims are directed a novel instrument seal. One embodiment of the claimed invention is depicted in Figs. 7 and 2, portions of which are reproduced below with notations:



As shown in this embodiment, the instrument seal (2) is positioned proximal of the zero-closure seal (230). The instrument seal (2) shown in the exploded view comprises a first substantially rigid ring (8) and a second substantially rigid ring (20). A plurality of separate semicircular seal segments (4a-4d) are compressed between the rings (8, 20). Each seal segment (4a-4d) has a circumference greater than 180 degrees.

trocar, and (ii) an instrument seal intended to seal the trocar while instruments are inserted through the trocar

The present claims are directed a novel instrument seal. One embodiment of the claimed invention is depicted in Figs. 7 and 2, portions of which are reproduced below with notations:

# Common mistakes: example 1

<b>Notification of Non-Compliant Appeal Brief</b> (37 CFR 41.37)	Application No.	Applicant(s)	
	Examiner	Art Unit	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on June 11, 2012 is defective for failure to comply with one or more provisions of 37 CFR 41.37(c).

To avoid dismissal of the appeal, applicant must file a compliant appeal brief (37 CFR 41.37(c)(1)(i)) within **ONE MONTH** or **THIRTY DAYS** of the mailing date of this communication, **EXCLUSIONS OF THIS TIME PERIOD MAY APPLY.**

1.  The brief does not contain the items listed in the heading or in the proper order.

2.  (a) The brief does not contain a correct independent claims, referring to the number and to the drawings, if any, independent claim and for each dependent claim plus function recitation under 35 U.S.C. 112(b) specification as corresponding to each independent claim and line number or paragraph number and line number or paragraph number of the specification (37 CFR 41.37(c)(1)(iii)).

3.  The brief does not contain a correct independent claims, referring to the number and to the drawings, if any, independent claim and for each dependent claim plus function recitation under 35 U.S.C. 112(b) specification as corresponding to each independent claim and line number or paragraph number of the specification (37 CFR 41.37(c)(1)(iii)).

4.  Other (including any explanation in support of the above items):

Section V Summary of Claimed Subject Matter must identify and map all independent claims separately on appeal to the Specification by page and line number or paragraph number and/ or drawings if any by reference characters. (Claims 1, 9 and 17 were not mapped).

Section V Summary of Claimed Subject Matter must identify and map all independent claims separately on appeal to the Specification by page and line number or paragraph number and/ or drawings if any by reference characters. (Claims 1, 9 and 17 were not mapped).

# Common mistakes: example 2

## V. Summary of the Claimed Subject Matter

The claimed subject matter under examination is directed generally to antibiotic products.

Claims 1, 37, and 39 are the only independent claims.

Claim 1 is directed to a once-a-day, oral antibiotic product comprising three dosage forms, where the first and second dosage forms are delayed release dosage forms and the third dosage form is a delayed sustained release dosage form (i.e., a DR-DR-DSR release profile) and where the antibiotic product does not contain any immediate release dosage forms. Each of the dosage forms comprises

pharmaceutically accepta

second dosage form initi

antibiotic after the first d

release from the antibioti

antibiotic and the once-a-

twenty-four hour period.

including, for example, at

and in original claims 1, 3

twenty-four hour period. Support for claim 1 can be found throughout the specification, including, for example, at paragraphs [0013], [0015], [0021], [0022], [0032], [0033], and [0064] and in original claims 1, 3, and 6.

Claim 37 is similar to claim 1 except the antibiotic is amoxicillin. Thus, claim 37 is

directed to a once-a-day, oral amoxicillin product comprising three dosage forms, where the first

and second dosage forms are delayed release dosage forms and the third dosage form is a

delayed sustained release dosage form (i.e., a DR-DR-DSR release profile) and where the

antibiotic product does not contain any immediate release dosage forms. Each of the dosage

forms comprises amoxicillin and a pharmaceutically acceptable carrier. The third dosage form

initiates release of amoxicillin after the second dosage form initiates release of amoxicillin, and

the second dosage form initiates release of amoxicillin after the first dosage form initiates release

# Common mistakes: example 2

<b>Notification of Non-Compliant Appeal Brief (37 CFR 41.37)</b>		Application No.	Applicant(s)
		Examiner	Art Unit
--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--			
The Appeal Brief filed on <u>December 18, 2012</u> is defective for failure to comply with one or more provisions of 37 CFR 41.37(c).			
To avoid dismissal under 37 CFR 41.37(c), the appellant must file an appeal brief with the following extension:			
<b>EXTENSION:</b>			
1. <input type="checkbox"/>	The title page of the appeal brief must include the following information:		
2. <input checked="" type="checkbox"/>	(a) The title page of the appeal brief must include the following information: independent claim numbers independent claim numbers plus reference characters specification and drawings 41.37		
3. <input type="checkbox"/>	The title page of the appeal brief must include the following information:		
4. <input checked="" type="checkbox"/>	Other		
	<u>Section V Summary of Claimed Subject Matter does not refer to the Specification as originally filed with respect to independent claims 1 and 37, i.e. refers to paragraph numbers but the Specification as originally filed does not include paragraph numbers. The Summary must identify and map all independent claims separately on appeal to the Specification by page and line number or paragraph number (if used in the original specification) and drawings if any by reference characters</u>		
	<u>Another appeal brief is not required; just the corrected section can be submitted.</u>		

## 4. Other (including any explanation in support of the above items):

Section V Summary of Claimed Subject Matter does not refer to the Specification as originally filed with respect to independent claims 1 and 37, i.e. refers to paragraph numbers but the Specification as originally filed does not include paragraph numbers. The Summary must identify and map all independent claims separately on appeal to the Specification by page and line number or paragraph number (if used in the original specification) and drawings if any by reference characters

Another appeal brief is not required; just the corrected section can be submitted.

# Common mistakes: example 3

## V. SUMMARY OF CLAIMED SUBJECT MATTER

The claimed invention relates to motor-driven vehicle lubricating oil compositions, and method of using the same, designed to lubricate the crankcase of motor-driven vehicle internal combustion engines. (see, e.g., ¶¶ 0001-0003<sup>2</sup>). In particular, the claimed invention relates to motor-driven vehicle crankcase lubricating oil compositions having low sulfated ash content, low phosphorus content, and low sulfur content (see, e.g., ¶ 0001). Claims 1 and 16 are the independent claims.

### A. Claimed Subject Matter of Claim 1

Claim 1 is directed to a motor-driven vehicle lubricating oil composition, comprising: a) a major amount of a base oil having a sulfur content of 0.01 to 0.3 wt.% (see, e.g., ¶ 0038); b) an ashless dispersant comprising an amine derivative of a succinimide or a derivative thereof in an amount of 0.01 to 0.3 wt.% (see, e.g., ¶ 0042); c) a metal-containing detergent comprising a metal-containing detergent acid metal salt, having a TBN of 10 to 350 mg KOH/g, and a sulfur content of 0.1 to 1 wt.% in terms of a sulfated ash content of 0.1 to 1 wt.% (see, e.g., ¶ 0046); d) a zinc dialkyldithiophosphate in an amount of 0.002 to 0.015 wt.% in terms of the phosphorus content (see, e.g., ¶ 0054); e) a zinc dialkyldithiophosphate in an amount of 0.002 to 0.015 wt.% in terms of the phosphorus content (see, e.g., ¶ 0058), wherein: i) the ratio of the phosphorus content of the zinc dialkyldithiophosphate to the phosphorus content of the zinc dialkyldithiophosphate in the motor-driven vehicle lubricating oil composition is in the range of 10:1 to 2:1 (see, e.g., ¶ 0025); and ii) the motor-driven vehicle lubricating oil composition has a sulfur content of 0.01 to 0.5 wt.%, a phosphorus content of 0.01 to 0.1 wt.%, and a sulfated ash in the range of 0.1 to 1 wt.% (see, e.g., ¶ 0018).

<sup>2</sup> All references to the instant patent application herein are to the Patent Publication No. US 2003/0216200 (i.e., the publication of Patent Application No. US 10/430,594).

<sup>2</sup> All references to the instant patent application herein are to the Patent Publication No. US 2003/0216200 (i.e., the publication of Patent Application No. US 10/430,594).

# Common mistakes: example 3

Notification of Non-Compliant Appeal Brief (37 CFR 41.37)	Application No.	Applicant(s)	
	Examiner	Art Unit	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on July 20, 2012 is defective for failure to comply with one or more provisions of 37 CFR 41.37(c).

To avoid dismissal of the appeal, applicant must file an amended brief or other appropriate correction (see MPEP 1205.03) within ONE MONTH or THIRTY DAYS from the mailing date of this communication. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED ONLY IN EXCEPTIONAL CIRCUMSTANCES.

- The brief does not contain the items required by 37 CFR 41.37(c)(1)(i) in the proper order.
- (a) The brief does not contain a concise explanation of independent claims, referring to the specific claim number and to the drawings, if any, by reference to the independent claim and for each dependent claim plus function recitation under 35 U.S.C. 112, specification as corresponding to each claim number and line number or paragraph number, and 37 CFR 41.37(c)(1)(iii).
- The brief does not contain a correct copy of the specification, drawings, or claims.
- Other (including any explanation in support of the above items):

4.  Other (including any explanation in support of the above items):

Section III (or Section V), the Summary of Claimed Subject Matter, must identify and map all independent claims separately on appeal to the Specification by page and line number or paragraph number and/ or drawings if any by reference characters. The mappings are to the printed publication.

Mappings to any printed publications are not part of the official record and, thusly, cannot be accepted.

Another appeal brief in its entirety is not required; just the deleted section can be submitted.

Section III (or Section V), the Summary of Claimed Subject Matter, must identify and map all independent claims separately on appeal to the Specification by page and line number or paragraph number and/ or drawings if any by reference characters. The mappings are to the printed publication.

Mappings to any printed publications are not part of the official record and, thusly, cannot be accepted.

Another appeal brief in its entirety is not required; just the deleted section can be submitted.

# Claims appendix



## **Current** claims on appeal

- No new amendments
- No amendments not previously entered
- No cancelled claims



# Claims appendix

## Common errors



**New** or **non-admitted** amendment



**Markings** in the claims  
(e.g., brackets or underling)

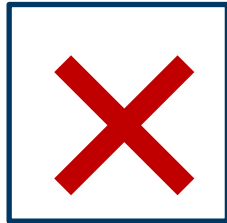
# Common mistakes: example 4

Notification of Non-Compliant Appeal Brief (37 CFR 41.37)	Application No.	Applicant(s)	
	Examiner	Art Unit	AIA (FITF) Status
--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--			
The Appeal Brief filed on <u>19 December 2022</u> is defective for failure to comply with one or more provisions of 37 CFR 41.37(c).			
To avoid dismissal of 1205.03) within <b>ONE EXTENSIONS OF TH</b>			
1. <input type="checkbox"/> The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(v)).			
2. <input type="checkbox"/> (a) The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(v)).			
3. <input checked="" type="checkbox"/> The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(v)).			
4. <input checked="" type="checkbox"/> Other (including any explanation in support of the above items):			
<p><u>The Claims Appendix is non-compliant as it does not match the last entered amendment, specifically related to claim(s) 37. The last entered amendment was filed on 9/18/22. The Examiner denied entry of the after final amendment field on 11/17/22. An entire new Appeal Brief is not necessary, only the corrected section..</u></p>			

## 4. Other (including any explanation in support of the above items):

The Claims Appendix is non-compliant as it does not match the last entered amendment, specifically related to claim(s) 37. The last entered amendment was filed on 9/18/22. The Examiner denied entry of the after final amendment field on 11/17/22. An entire new Appeal Brief is not necessary, only the corrected section..

# Other common errors



- **New** or not previously admitted **amendment** or **evidence**
  - 37 CFR § 41.37(c)(2)

# How to fix errors



## Not the end of the world!

- Receive **Notice** with identified error
- Timely **respond**
- Fix and **re-submit** (often not whole brief)

# How to avoid common errors



- Review **rules**
  - 37 CFR § 41.37(c)
  - MPEP § 1205.02
- Appeal Brief **template** ([link](#))

# Appeal brief tool

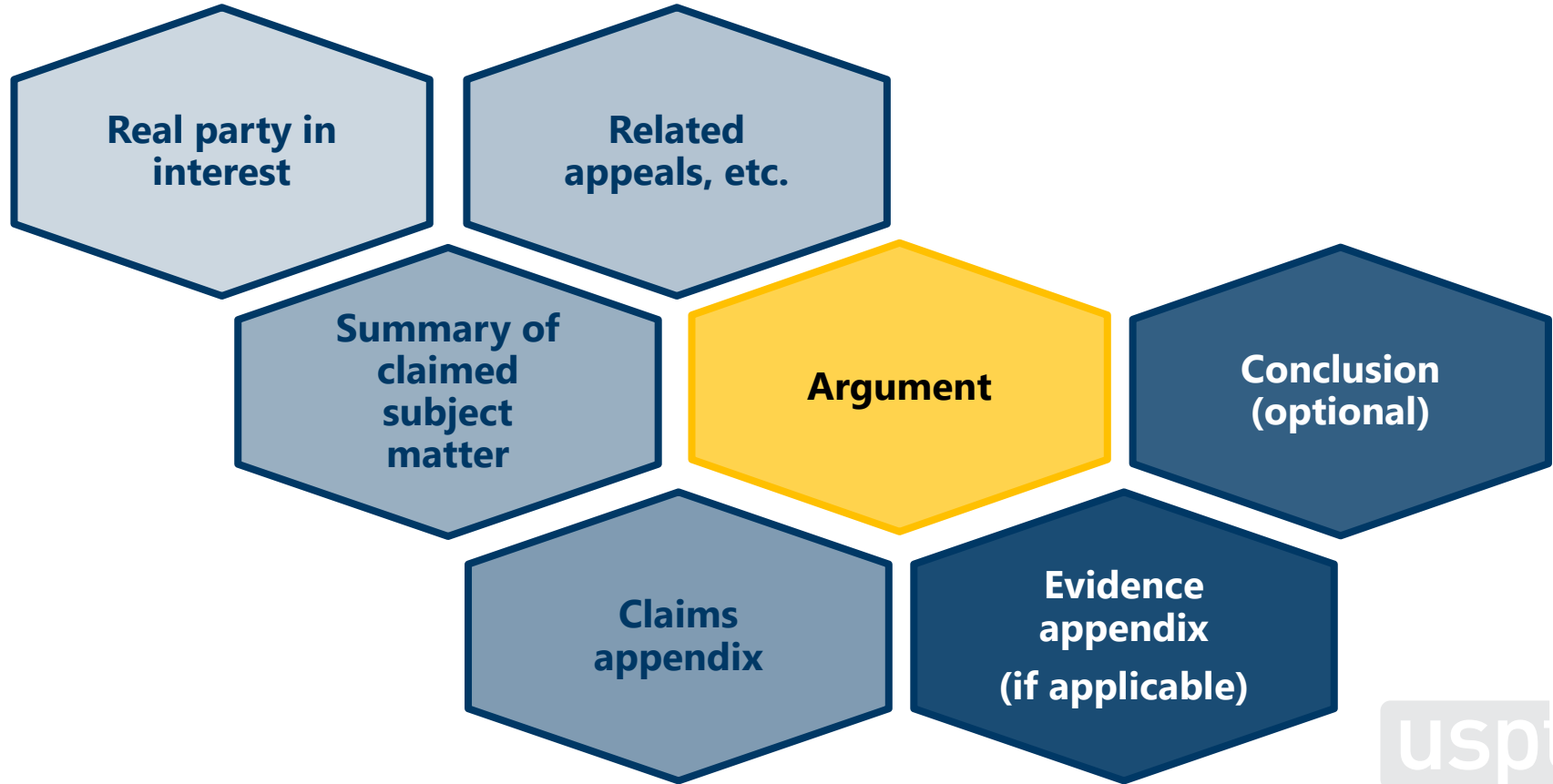
The screenshot shows the USPTO website interface. At the top, the USPTO logo and 'UNITED STATES PATENT AND TRADEMARK OFFICE' are visible. A search bar contains 'Search uspto.gov'. Below the header, a navigation menu includes 'Patents', 'Trademarks', 'IP Policy', and 'Learning and Resources', with 'Learning and Resources' highlighted. A 'Find It Fast' button is also present. The breadcrumb trail reads 'Home > Patents > Patent Trial and Appeal Board > Resources > Preparing an ex parte appeal brief'. The main content area features the title 'Preparing an ex parte appeal brief' circled in red. The text below the title explains the process for independent inventors to appeal a patent examiner's rejection of claims without an attorney. It details the submission of 'briefs' and the role of the Patent and Trial Appeal Board (PTAB). A list of resources includes a Word document template and a PDF guide. Other resources listed are links to file an appeal, go to EFS-Web, new to PTAB, and contact information for the Board.



Judges Michael Cygan and Jeff Fredman

# **Part 3: Persuasive arguments in an appeal brief**

# Appeal brief argument





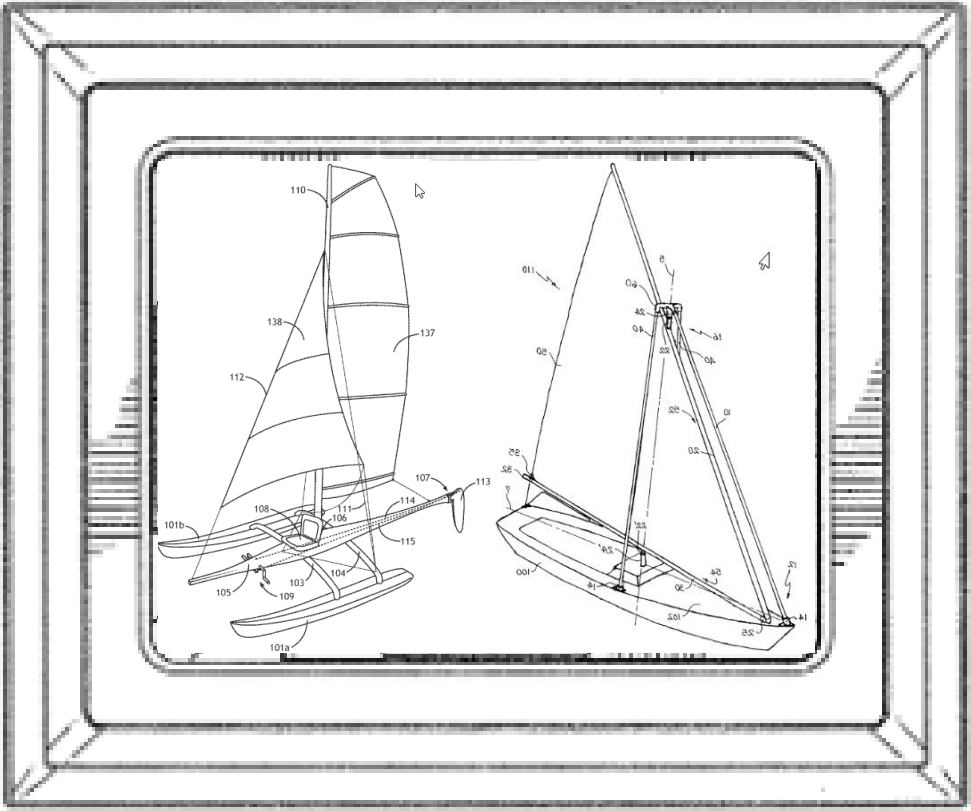
# Learning point: choosing a lead argument

Appellant submits that the Second Examiner did not have 'specific knowledge' sufficient to meet the standards for reopening of prosecution under 37 CFR 1.198 as to examination of the claims under the standards of 35 U.S.C.

## Argument

[S]o long as the rules of Patent Office practice are duly complied with, an applicant has no legal ground for complaint . . . The life of a patent solicitor has always been a hard one. *In re Ruschig*, 379 F.2d 990, 993 (CCPA 1967).

# Learning point: frame the argument



# Example 1: which is the better response to an anticipation rejection?

Would a person of skill in the art, reading the reference, would 'at once envisage' the claimed combination. The Appellant argues that the number of possible combinations of just 3 different genera from a list of 68 genera is  $68 \times 67 \times 66$ , over 300,000 possible combinations.

Argument A

The Applicants have shown the unexpected results of the present invention over the prior art. The results of Examples 1-14 and Comparative Examples 1-4 at in the Declaration under 37 CFR § 1.132 are listed below.

Argument B 

# Argument A was persuasive

that An anticipatory reference under 35 U.S.C. § 102 must direct the artisan to the invention “**without any need for picking, choosing**, and combining various disclosures not directly related to each other by the teachings of the cited reference.” *In re Arkley*, 455 F.2d 586, 587–88 (CCPA 1972)

Argument A

“If the rejection under § 102 is proper, however, appellant cannot overcome it by showing such unexpected results or teaching away in the art, which are relevant only to an obviousness rejection.” *In re Malagari*, 499 F.2d 1297, 1302 (CCPA 1974).

Argument B

## Example 2: which response better rebuts the reason to combine?

To make up for the missing element, the Examiner relies on a **single disclosure** of the agent. However, why would it lead one skilled in the art to choose to modify the prior art reference composition by specifically adding an agent, but not an alternative component?

Argument A

The question at issue in this appeal is simple — does discovering an **unknown problem** and solving it with a solution that makes the claimed invention more expensive make an invention non-obvious? The solution required that the prior art implement additional steps/features that increased the cost of the end product for no apparent reason (other than to solve the previously **unknown problem**).

Argument B



# Argument B was persuasive

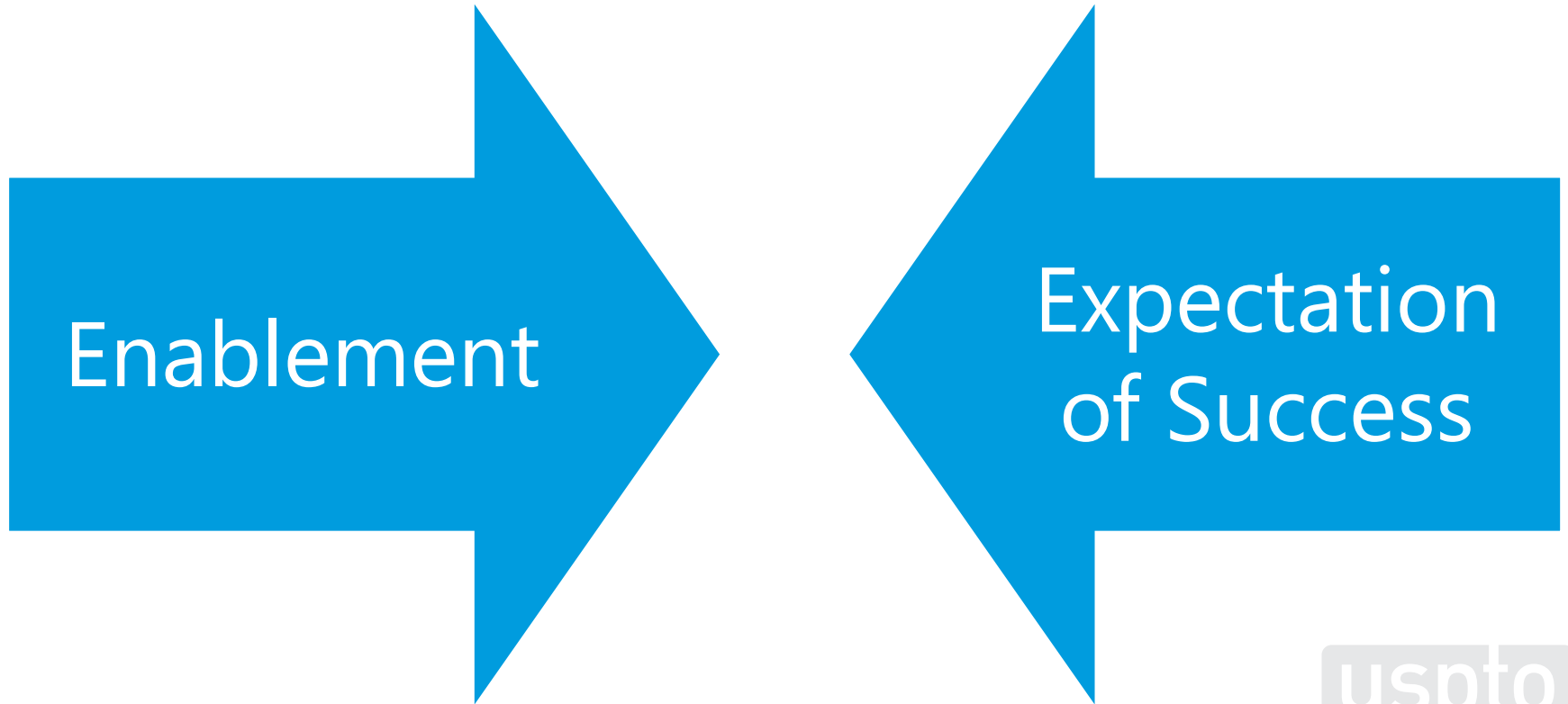
"[U]ndisputed teachings in the prior art . . . provide a suggestion and motivation."  
*SIBIA Neurosciences, Inc. v. Cadus Pharm. Corp.*, 225 F.3d 1349, 1358-59 (Fed. Cir. 2000).

Argument A

"We have recognized that where a **problem was not known in the art**, the solution to that problem may not be obvious, because "ordinary artisans would not have thought to try at all because they would not have recognized the problem." *Leo Pharm. Prods., Ltd. v. Rea*, 726 F.3d 1346, 1357 (Fed. Cir. 2013)." *Forest Labs, LLC v. Sigmanpharm Labs, LLC*, 918 F.3d 928 (Fed. Cir. 2019).

Argument B

# Teaching point: conflicting arguments



# Example 3: which argument better rebuts an Examiner's inherency position?

A coefficient of thermal expansion of a certain dielectric material disclosed may or may not accidentally or occasionally match a coefficient of thermal expansion of a certain organic polymer disclosed. However, the mere allegation that a coefficient of thermal expansion may match is not sufficient to establish inherency.

Argument A

The Office Action cites MPEP 2112(V) for the proposition that the Examiner can use 35 USC 103 to make an inherency rejection. . . . But a closer reading of the case law, if not MPEP 2112(V) shows inherency may not be used in an obviousness rejection.

Argument B





# Argument A was persuasive

"Inherency ... may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Bettcher Indus., Inc. v. Bunzl USA, Inc.*, 661 F.3d 629, 639 (Fed. Cir. 2011).

Argument A

""[I]nherency may supply a missing claim limitation in an obviousness analysis." *Par Pharm. v. TWI Pharm., Inc.*, 773 F.3d 1186, 1194 (Fed. Cir. 2014).

Argument B

# Teaching point: preserve argument or not



Save



Drop

# Example 4: which argument better demonstrates a teaching away?

The Examiner's cited reference states that "when the total carbon number exceeds 5, it becomes difficult to obtain satisfactory antibiotic activity" so the reference clearly discourages one from preparing compounds with more than 5 carbon atoms.

Argument A

Although the prior art did not foresee the specific invention that was later made, and did not warn against taking that path, it nevertheless implicitly teaches away from the claims, because it asserts that one element alone was sufficient and fully adequate.

Argument B

uspto®

# Argument A was persuasive

"The prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed". *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004).

Argument A

"We cannot accept the suggestion that one is significantly 'taught away' from a 'particularly preferred embodiment' by the suggestion (whether true or false) that something else may be even better." *In re Susi*, 440 F.2d 442, 446 n.3 (CCPA 1971).

Argument B

# Example 5: which argument better shows the art is not analogous?

There is no basis why one of ordinary skill in the art would stray from a first reference focus on comparing **medical imaging** information into a reference, that is focused on **measuring the velocity fluctuation in tokamak plasmas** using beam-emission-spectroscopy.

Argument A

The invention concerns spotting fluids for use on equipment stuck in subterranean formations and the reference concerns adhesives for vinyl wallpaper. Moreover, the reference is concerned with **wetting a surface with the aqueous outer phase** of an oil-in-water emulsion. Appellants' application, in marked contrast, is concerned with **wetting a surface with the non-aqueous outer phase**.

Argument B



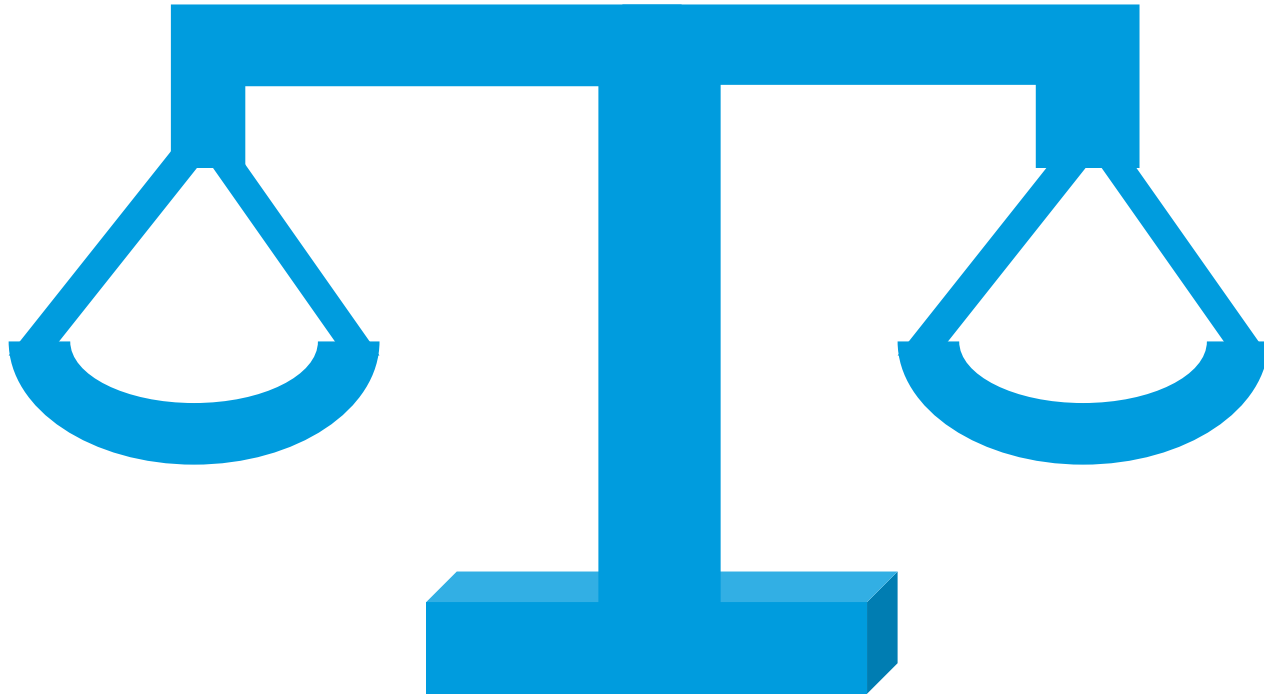
# Both arguments were persuasive

"[T]wo separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved." *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004),

Argument A

Argument B

# Teaching point: burden of proof/evidence



# Example 6: which argument has better supporting evidence?

Patent Owner presented . . . (1) sales data for the devices covered by the patented claims in dispute establishing commercial success of the claimed device; (2) survey data . . . ; (3) survey data establishing . . . ; (4) evidence of copying by other(s); (5) testimony regarding failure of others and market displacement of color changing lights covered by prior art; (6) testimony of an expert establishing skepticism; (7) industry praise for the claimed features; and (8) unexpected results evidence.

Argument A

The person of ordinary skill would have simply thrown out the system of [the first reference] and implemented the system of [the second reference] in the original form.

Argument B



# Argument A was persuasive

"[E]vidence bearing on the facts is never of 'no moment,' is always to be considered, and accorded whatever weight it may have." *In re Mageli*, 470 F.2d 1380, 1383 (C.C.P.A. 1973)

Argument A

"[A]ttorney argument [is] not the kind of factual evidence that is required to rebut a prima facie case of obviousness." *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997).

Argument B

# Takeaways

- Organize Briefs starting with the most persuasive argument, not the “best” argument
- Address the Examiner’s argument but in your own clear and organized way
- Try to avoid arguments that create other allowability problems
- Drop less persuasive arguments; they probably won’t persuade the Federal Circuit anyway
- Submit evidence where available and appropriate

# Part 4: Questions?

