



USPTO Announces Final Rules Concerning Appeal Practice

The United States Patent and Trademark Office (“PTO”) recently published new rules regarding practice before the Board of Patent Appeals and Interferences (“Board”). The PTO believes the new rules “will add clarity and efficiency to the appeal process.” The Board is experiencing a rapid increase in the number of appeals filed. As reported in the PTO’s Biotechnology/Chemical/Pharmaceutical Customer Partnership Meeting on June 4, 2008, in 2008, the Board will receive approximately 500 appeals from Technology Center 1600 alone (tasked with reviewing biotechnology related applications) with approximately 66% of the examiner’s rejections being affirmed and 33% being either reversed or remanded for further examination. Given the complex nature of securing patent protection in the biotechnical/medical/life science technologies, the new appeal rules will have a direct and dramatic impact upon those industries and the patent attorneys supporting those industries.

The Board is an administrative appeal entity within the PTO. After a claim or claims are twice rejected as unpatentable as either anticipated or obvious in view of the prior art, a patent applicant may challenge the examiner’s rejection(s) by appealing the issue to the Board. The first step in the appeals process is filing a Notice of Appeal. After filing the Notice of Appeal, the applicant has two (2) months to file an Appeal Brief. The examiner then replies to the applicant’s arguments by filing the Examiner’s Answer. Finally, the applicant is given an opportunity to respond to the Examiner’s Answer by filing a Reply Brief. The new rules affect, to some degree, every step of the appeals process.

The most substantive change may be the requirement that non-appealable errors must be resolved by petition prior to filing an appeal to the Board.

“Failure to timely file a petition seeking review of a decision of the examiner related to a non-appealable issue would generally constitute a waiver to have those issues considered.” Further, all Notices of Appeal must be signed (former practice allowed the filing of un-signed Notices of Appeal).

Many of the new rules are directed to “improving” the Appeal Brief. For example, Appeal Briefs are now limited to thirty (30) pages in length excluding the statements of real party in interest and related cases appendices, tables of authority and contents and signature block. The limitation on Appeal Brief length was intended to promote “concise” and “precise” writing. The new rules also set forth the required contents of the Appeal Brief.

Under the new rules, an Appeal Brief “must” contain, in the following order a: (1) statement of real party in interest, (2) statement of related cases, (3) jurisdictional statement, (4) table of contents, (5) table of authorities, (6) status of amendments, (7) ground of rejection to be reviewed, (8) statement of facts, (9) argument and (10) an appendix.

The statement of facts requires that the applicant set out in an “objective and non-argumentative manner” the facts material to the rejections on appeal. Each “fact” must be supported by a reference to a page number of the Record. The specific citation to support in the Record is required because applicants should not expect the examiner or the Board to search the Record to determine if a fact is supported by the evidence.

The new rules require that the argument section of the applicant’s brief explain why the examiner is believed to have erred as to each rejection under appeal.

The Appeal Brief must address rejections made by the examiner and cover all points made by the examiner with which the applicant disagrees or alleges error. Failure to explain the examiner's error results in waiver of those potential arguments.

The new rules have replaced the "summary of the invention" section of the Appeal Brief with a "claims and drawing analysis" and, if appropriate, a "means or step plus function" analysis. One significant requirement in the "claims analysis" section is that the applicant must provide a citation to the specification for each limitation of the claims being argued separately to provide the examiner and the Board with applicant's perspective on where the claims find support in the specification. The "drawing analysis" section requires the same type of citation to each and every claim limitation shown in the application's drawings.

The new rules have also streamlined the process after the applicant's Reply Brief. Under the new appeals rules, examiners will no longer provide a response to the Reply Brief, new grounds of rejection will no longer be permitted in an examiner's Answer, and a Supplemental Examiner's Answer will no longer be permitted in response to a Reply Brief.

The new appeals rules will go into effect on December 10, 2008 and apply to all appeals in which an Appeal Brief is filed on or after that date.

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