



UNITED STATES PATENT AND TRADEMARK OFFICE

Pre-Appeal Brief Conference (with Demo)

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Basis of Pre-Appeal Brief Conference

- New Pre-Appeal Brief Conference Pilot Program, 1296 Off. Gaz. Pat. Office 67 (July 12, 2005).
- Program extended indefinitely: Official Gazette Notice - 07 February 2006.



Benefit of Pre-Appeal Brief Conference

- Offers applicants an opportunity to request a review of identified matters on appeal employing an appeal conference prior to the filing of an appeal brief.
- Spares applicants the added time and expense of preparing an appeal brief if a panel review determines an application is not in condition for appeal.
- No Pre-Appeal Conference fee.
- Optional Procedure



Goals of Pre-Appeal Brief Conference

The stated goals of the program are

- (1) to identify the presence or absence of clearly improper rejections based upon error (s) in facts, or
- (2) to identify the omission or presence of essential elements required to establish a *prima facie* rejection.

See 1296 Off. Gaz. Pat. Office 67 (July 12, 2005).



Who Should File a Pre-Appeal Brief Request

- An applicant who wants a panel of experienced examiners to perform a detailed review of appealable issues within a set period of time.
- A sample request form is available on the USPTO Internet Website, on the forms page, as PTO/SB/33
- This process does not apply to reexamination proceedings.
- Requests are limited to appealable, not petitionable matters.



Forward Request to USPTO

- Address the notice of appeal and the request to:
 - Mail Stop AF - Commissioner for Patents
P.O. Box 1450 - Alexandria, VA 22313-1450.
 - Fax the notice of appeal and the request to the Central FAX Number (now 571 273-8300).
 - Hand carry the notice of appeal and the request to the USPTO Customer Service Window, ATTN: Mail Stop AF Randolph Building 401 Dulany Street Alexandria, VA 22314.
- ✓ The request should contain a certificate of mailing or transmission under 37 CFR 1.8 and be listed on any postcard receipt (MPEP 503).



Conditions Necessary to Request Panel Review

Applicant must file the request:

- with the filing of a notice of appeal (complying with 37 CFR 41.31) and appeal fee which is not refundable, even in the event of a decision favorable to applicant.
- before the filing of an appeal brief.
- No extensions of time are available for filing the request.
- No after-final or proposed amendments may accompany the request.



Content Necessary to Request Panel Review

- Arguments accompanying the request are:
 - in a separate paper entitled, "Pre-Appeal Brief Request for Review".
 - Five (5) or fewer total pages of argument.
- Refer to arguments already of record by simply referring to a prior submission by paper number and the relevant portions thereof (e.g., see paper number 3 at page 4).
- A long detailed explanation should not be required for a clear error in fact or other deficiency.
- Failure to comply with the above noted submission requirements may result in dismissal of the request.



Suggested Content of the Request

- The request should specify
 - ✓ clear errors in the examiner's rejections; or
 - ✓ the examiner's omissions of one or more essential elements needed for a *prima facie* rejection.
- For example, the request should point out that a claim limitation is not met by a reference asserted by the Examiner to be anticipating or the examiner failed to show a proper rationale for making a modification in an obviousness rejection.



Dismissal of the Request

- Dismissal will result, if applicant files any of the following responses after filing a request, but prior to a panel decision:
 - an appeal brief
 - a request for continued examination (RCE)
 - an after-final amendment
 - an affidavit or other evidence
 - an express abandonment
- If dismissed, a decision will not be made on the merits of the request.



The TC-1600 Pre-Appeal Brief Panel

- The decision-making panel is composed of:
 - The Examiner assigned to the application;
 - The Examiner's Supervisor (SPE); and
 - A Quality Assurance Specialist (QAS).

- Additional Examiners (e.g. training primary examiner) and/or Managers may be consulted, if needed.

- Applicant is not permitted to attend the review and no interviews will be granted prior to the panel's decision.



The Panel Process

- A panel considers the merits of each appealed rejection including reviewing:
 - the rejection (s) identified by applicant in the request; and
 - the application and the appropriate evidence in support of the rejections to the extent necessary.
- The panel will then decide if an issue for appeal is, in fact, present and issue a written decision which should be mailed within 45 days of receipt of a properly filed request.



Format of Panel Decision

- The decision will state one of the following:
 - 1: The application remains under appeal because there is at least one actual issue for appeal;
 - 2: Prosecution on the merits is reopened and an appropriate Office communication will follow in due course;
 - 3: The application is allowed on the existing claims and prosecution remains closed;
 - 4: The request fails to comply with the submission requirements and is dismissed.



Notice of Panel Decision

Notice of Panel Decision from Pre-Appeal Brief Review	Application/Control No.	Applicant(s)/Patent under Reexamination	
		Art Unit	

This is in response to the Pre-Appeal Brief Request for Review filed .

1. **Improper Request** – The Request is improper and a conference will not be held for the following reason(s):
- The Notice of Appeal has not been filed concurrent with the Pre-Appeal Brief Request.
 - The request does not include reasons why a review is appropriate.
 - A proposed amendment is included with the Pre-Appeal Brief request.
 - Other: .

The time period for filing a response continues to run from the receipt date of the Notice of Appeal or from the mail date of the last Office communication, if no Notice of Appeal has been received.

2. **Proceed to Board of Patent Appeals and Interferences** – A Pre-Appeal Brief conference has been held. The application remains under appeal because there is at least one actual issue for appeal. Applicant is required to submit an appeal brief in accordance with 37 CFR 41.37. The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable.

- The panel has determined the status of the claim(s) is as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: _____.
 Claim(s) withdrawn from consideration: _____.

3. **Allowable application** – A conference has been held. The rejection is withdrawn and a Notice of Allowance will be mailed. Prosecution on the merits remains closed. No further action is required by applicant at this time.

4. **Reopen Prosecution** – A conference has been held. The rejection is withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.

All participants:

- (1) _____. (3)_____
 (2) _____. (4)_____



Notice of Panel Decision (Cont.)

- The decision will summarize the status of the pending claims (still rejected, withdrawn rejections, objected to or allowable claims).
- In appropriate circumstances, a proposed amendment may accompany the panel's decision proposing changes that, if accepted, may result in an indication of allowability for the contested claim (s).



Nature of the Panel Decision

- The decision will not contain any additional grounds of rejection or any restatement of previously made rejections.
- Such matters will be addressed, as appropriate, in the Examiner's Answer.
- Following a panel review, the examiner retains the option to reopen prosecution or to allow an application after the filing of an appeal brief.
- This unlikely situation may arise, for example, where new arguments or evidence are presented in the appeal brief.



Nature of the Panel Decision (cont.)

- A panel decision to withdraw the rejections of any or all of the claims on appeal is not a decision by a panel of the B.P.A.I. and, as such, would not result in any patent term extension of adjustment under 35 U.S.C. Sec. 154(b) (37 CFR 1.701(a)(3) and 1.702(e)).
- Panel decisions cannot be petitioned because a decision to maintain a rejection is subject to appeal.
- A panel decision that the application remains under appeal is not a final agency action for purposes of court review.
- Thus, an applicant dissatisfied with the result of the pre-appeal brief conference must pursue the appeal before the B.P.A.I.

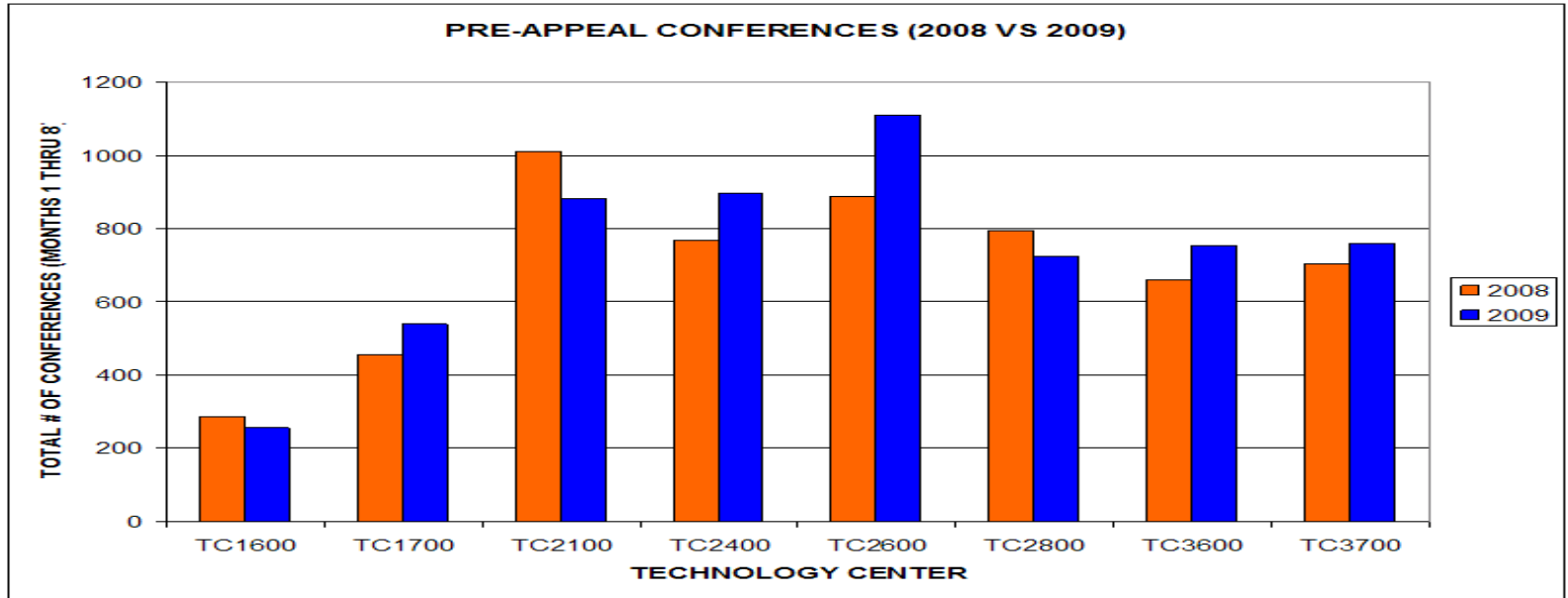


When Is The Appeal Brief Due

- Upon filing the request with the notice of appeal, the period of time for filing the appeal brief is the later of:
 - the two-month period set in 37 CFR 41.37(a) or
 - one month from the mail date of the panel decision.
- The time for filing the brief is extendible under 37 CFR 1.136 based on the mailing date of the panel decision or the receipt date of the notice of appeal, as applicable.
- The time for filing the brief (or RCE) ends on the mailing date of a panel decision that indicates all claims are allowed or that prosecution is reopened.



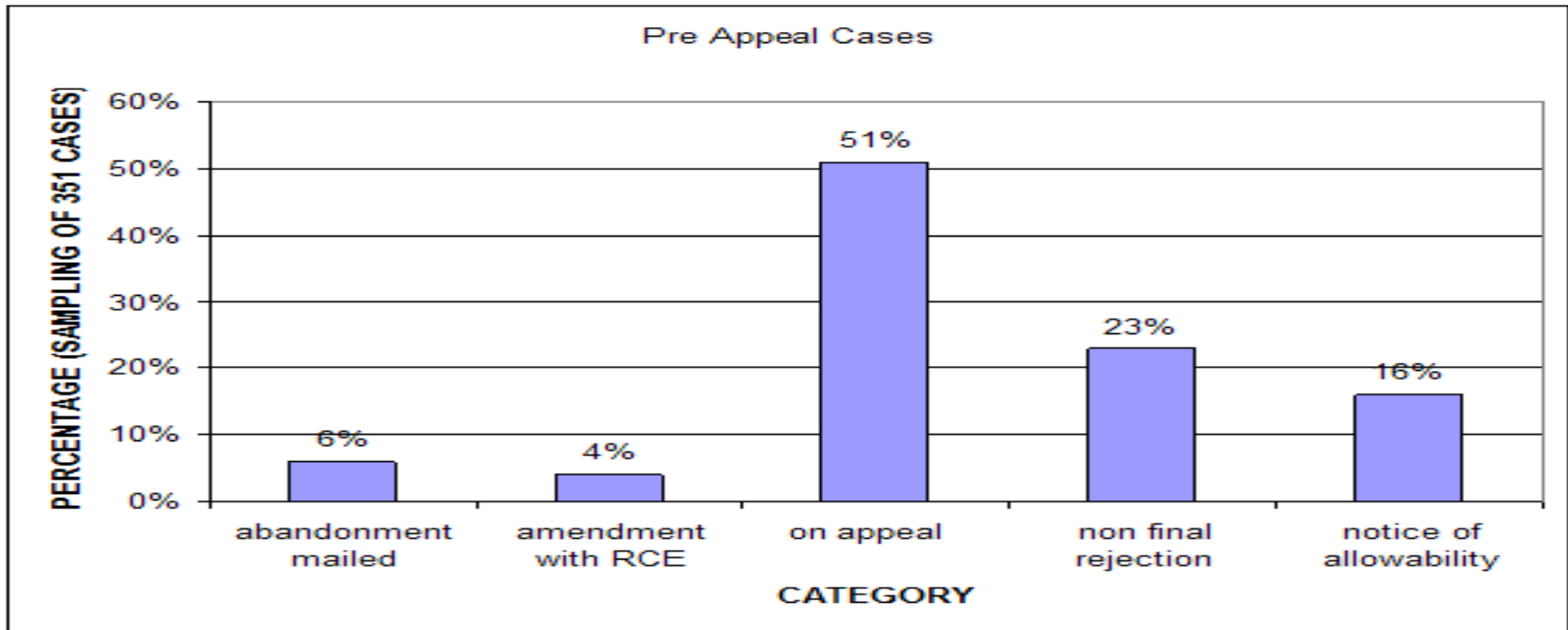
Corp-Wide Pre-Appeal Brief Conferences (2008 to Mid-July 2009 Sample)



PRE APPEAL CONFERENCE DECISIONS	2008	2009
	TC1600	269
TC1700	443	468
TC2100	1006	761
TC2400	750	632
TC2600	847	653
TC2800	765	528
TC3600	636	620
TC3700	685	579



TC-1600 Post-Panel Statistics (2008 to Mid-July 2009 Sample)



	Percentage	# of Cases
abandonment mailed	6%	20
amendment with RCE	4%	15
on appeal	51%	180
non final rejection	23%	79
notice of allowability	16%	57
		351



Questions

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