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# **TC1600 Appeals Practice**

**Jean Witz, Appeals Specialist**



# Pre-Appeal Brief Conference

- Offers applicants an avenue to request that a panel of examiners formally review the legal and factual basis of the rejections in their application prior to the filing of an appeal brief
- Intended to spare applicants the added time and expense of preparing an appeal brief if a panel review determines an application is not in condition for appeal
- Original Official Gazette Notice - 12 July 2005
- Official Gazette Notice of Pilot Extension – 7 February 2006



# Pre-Appeal Brief Conference Requests

- Filed with Notice of Appeal – Use Mail Stop AF
- Form PTO/SB/33
- No more than five (5) total pages of argument (excludes title page or request form)
- Must point out clear deficiency in the prima facie case in support of rejection(s)
- May refer to arguments of record by paper number and page



# Pre-Appeal Brief Conference Requests

- **Filing of any of the following will result in dismissal of conference request**
  - Appeal brief
  - RCE
  - Amendment
  - Affidavit or other evidence
  - Express abandonment
  - Request for an interference
  
- **If request is dismissed, the period for filing the appeal brief will be the later of the two-month period from the filing of the Notice of Appeal or one month from the mail date of the decision**



# Pre-Appeal Brief Conferees

- Appeals Specialist or designate
- SPE
- Examiner
- Mentoring Examiner (if applicable)



# Pre-Appeal Brief Conference Decision

- **Decision should be mailed within 45 days of conference request**
- **Decision is limited to the following outcomes:**
  - Application remains under appeal – brief is due - The time period will be reset to be one month from mailing of the decision, or the balance of the two-month notice of appeal time period, whichever is greater. This time is extendible under 37 CFR 1.136 based upon the mail date of the decision on the request or the receipt date of the notice of appeal, as applicable .
  - Application is allowable
  - Prosecution is reopened
  - Conference request is dismissed



# Appeal Brief Compliance Review – MPEP 1205

## ■ Appeals Center

- Enters brief and reviews for proper format
- Sends notice of non-compliance and forwards application to the Examiner

## ■ Examiner

- Reviews brief and any subsequent submissions
- May send notice of non-compliance or may clarify issues in Examiner's Answer

## ■ Board of Appeals

- Reviews brief and any subsequent submissions
- May send notice of non-compliance and remand application to the Examiner



# Common Appeal Brief Compliance Issues

## ■ Status of the claims

- The status of all claims, including canceled claims, must be identified

## ■ Summary of the claimed subject matter

- Each independent claim must be explained in detail and include reference to the specification by page and line numbers or paragraph numbers

## ■ Appendices

- *Claims Appendix* – Only claims on appeal are listed. No status identifiers are required.
- *Evidence Appendix and Related Proceedings Appendix* - If Appellant does not identify any evidence or related proceedings, then these appendices should be present but indicate either “None” or “N/A” under the heading





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