

Inter Partes Reexamination Appeals



Michael R. Fleming

Chief Administrative Patent Judge

Board of Patent Appeals and Interferences

United States Patent and Trademark Office

ABA-IPL

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Inter Partes Reexamination Appeals

BPAA Pendency and Workload

	FY2008	FY2009	FY2010 (Mid-Year)
BPAA Pendency	8.1 months	7.0 months	11.8 months
Pendency of BPAA Decided Appeals from Date of Reexamination Filing at USPTO	50.9 months	67.3 months	64.3 months
Disposals	1	10	6
Docketed	4	15	13
Inventory	4	9	16



Inter Partes Reexamination Appeals

- Applicable *Inter Partes* Reexamination Rules
 - Examination procedure – 37 C.F.R. §§ 1.902-1.997
 - Right of Appeal Notice – 37 C.F.R. § 1.953
 - Page limits for briefs – 37 C.F.R. § 1.943(c)
 - Appeal procedure – 37 C.F.R. §§ 41.60-41.81
 - See flowcharts in MPEP § 2601.01
 - See also MPEP §§ 2673-2682



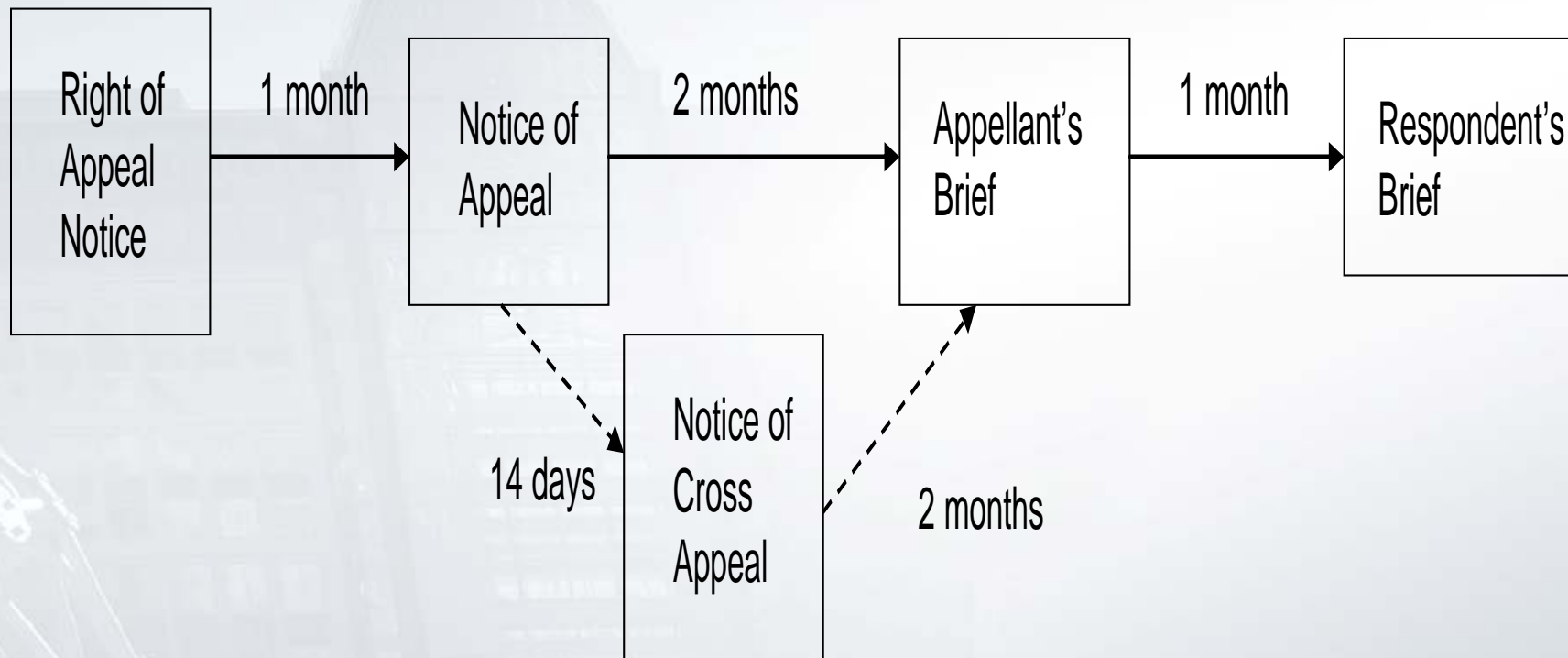
Inter Partes Reexamination Appeals

- Appeal Proceeding
 - Notice of Appeal and Cross Appeal – 37 C.F.R. § 41.61
 - Appellant's Brief – 37 C.F.R. § 41.67
 - Respondent's Brief – 37 C.F.R. § 41.68
 - Examiner's Answer – 37 C.F.R. § 41.69
 - Rebuttal Brief – 37 C.F.R. § 41.71
 - Oral Hearing – 37 C.F.R. § 41.73
 - Decision – 37 C.F.R. § 41.77
 - Rehearing – 37 C.F.R. § 41.79



Inter Partes Reexamination Appeals

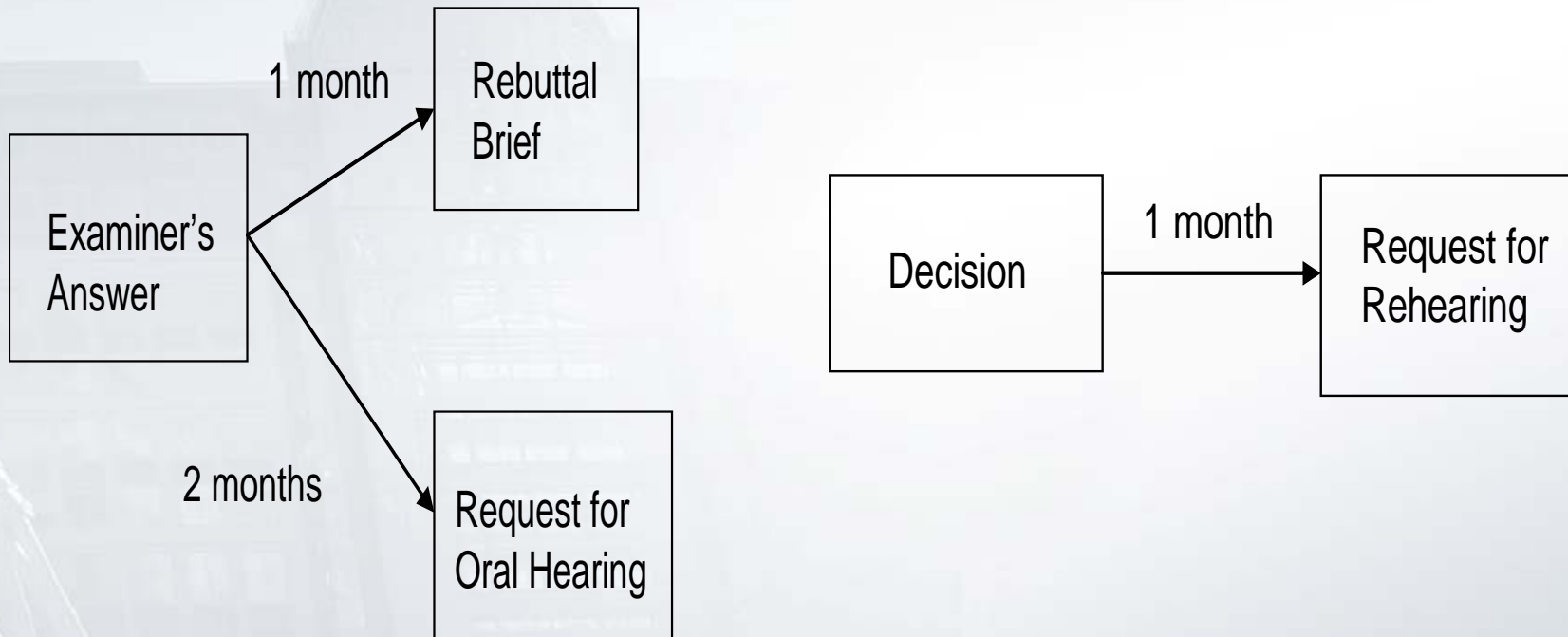
Appeal Timeline





Inter Partes Reexamination Appeals

Appeal Timeline





Inter Partes Reexamination Appeals

Appellant's Brief

- Contents
 - Same as ex parte appeal brief
 - Real party in interest
 - Related appeals and interferences
 - Status of claims
 - Status of amendments
 - Summary of claimed subject matter
 - Issues to be reviewed on appeal
 - Argument
 - Claims appendix
 - Evidence appendix
 - Related proceedings appendix
 - Certificate of service



Inter Partes Reexamination Appeals

Appellant's Brief

- Limitations
 - No new amendment or evidence
 - Page limitation – 30 pages or 14,000 words



Inter Partes Reexamination Appeals

Respondent's Brief

- Contents
 - Real Party in interest
 - Related appeals and interferences
 - Status of claims
 - Status of amendments
 - Summary of claimed subject matter
 - Issues to be reviewed on appeal
 - Argument
 - Evidence appendix
 - Related proceedings appendix
 - Certificate of service



Inter Partes Reexamination Appeals

Respondent's Brief

■ Limitations

- Arguments limited to issues raised in the appellant's brief to which the respondent's brief is directed
- A requester's respondent brief may not address any brief of any other requester
- Page limitation – 15 pages or 7,000 words



Inter Partes Reexamination Appeals

Examiner's Answer

- Contents
 - As may be necessary:
 - Explanation of invention claimed
 - Explanation of references relied upon
 - Grounds of rejection
 - Reasons for patentability

- Limitations
 - No new ground of rejection
 - No new determination not to make a proposed rejection



Inter Partes Reexamination Appeals

Rebuttal Brief

- Contents
 - Patent Owner
 - Arguments directed to issues raised in Examiner's Answer and/or any Respondent Brief
 - Requester
 - Arguments directed to issues raised in Examiner's Answer and/or Respondent Brief of Patent Owner
 - Certificate of service



Inter Partes Reexamination Appeals

Rebuttal Brief

- Limitations
 - Requester
 - No new proposed ground of rejection
 - Arguments not directed to issues raised in the Respondent Brief of any other Requester
 - Page limitation – 15 pages or 7,000 words



Inter Partes Reexamination Appeals

- Frequent Errors
 - Notice of Appeal
 - Claims on appeal not identified
 - Not signed
 - Fee not paid
 - Briefs (Appellant, Respondent and Rebuttal)
 - Page limits exceeded
 - Improper Summary of Claimed Subject Matter – claims not mapped to specification
 - Fee not paid



Inter Partes Reexamination Appeals

Practice Tips for *Inter Partes* Reexamination Appeals



Inter Partes Reexamination Appeals

Practice Tips

- Appellant's Brief – not required but consider providing:
 - Jurisdictional statement
 - Table of contents
 - Table of authorities



Inter Partes Reexamination Appeals

Practice Tips

- Appellant's Brief – arguments should be concise and focused
 - Identify facts in dispute in separate section
 - Identify pivotal claim language and explain resulting claim scope
 - Explain why examiner erred
 - Avoid repetitive and peripheral arguments



Inter Partes Reexamination Appeals

Practice Tips

- Appellant's Brief – arguments directed to why examiner erred
 - *Ex parte Belinne*, Appeal 2009-004693, (BPAI Aug. 10, 2009) (Informative opinion) (“Appellants do not present any arguments to explain why the Examiner’s explicit fact finding is in error.”).



Inter Partes Reexamination Appeals

Practice Tips

Appellant's Brief

- Clearly point out **material facts** relevant to why examiner erred
- Clearly point out **claim language** relevant to why examiner erred



Inter Partes Reexamination Appeals

Practice Tips

- Proper claim construction
 - *Ex parte Catlin*, Appeal No. 2007-3072, (BPAI February 3, 2009) (Precedential opinion) (means plus function limitation indefinite where specification fails to disclose algorithm for programming general purpose computer to perform specified function).



Inter Partes Reexamination Appeals

Practice Tips

- KSR considerations
 - *Ex parte Fu*, 89 USPQ2d 1115 (BPAI 2008) (expanded panel) (Precedential opinion) (One skilled in the art would anticipate success in substituting one species for another in its genus where the genus contains a limited number of species.).
 - *Ex parte Whalen*, Appeal No. 2007- 4423, 2008 WL 2957928 (BPAI July 23, 2008) (expanded panel) (Precedential opinion) (“Whalen II”) (A composition with a particular property at a high level is not rendered obvious by a prior art reference that teaches a similar composition and suggests that the property be minimized -- absent some reason to modify.).



Inter Partes Reexamination Appeals

Practice Tips

- *Ex parte Jellá*, 90 USPQ2d 1009 (BPAI 2008)
(expanded panel) (Precedential opinion)
(declaration evidence of non-obviousness)
 - establish nexus between claimed subject matter and evidence
 - evidence should be tied to functional not aesthetic aspects of claimed invention
 - demand established by market share and not solely by gross sales
 - long-felt need established by evidence that need was recognized by those of ordinary skill in the art)



Inter Partes Reexamination Appeals

Practice Tips

- Oral hearing presentation
 - The oral hearing is open to the public.
 - The oral hearing is transcribed by a court reporter and made part of the official record.
 - Make sure you are on time for the hearing. Remember you must clear security.



Inter Partes Reexamination Appeals

Practice Tips

- Oral hearing preparations
 - Identify your best argument in the Appellant's Brief.
 - Do not attempt to present every argument in the brief.
 - Highlight the portions of the specification and the claim language that support your best argument.
 - Identify the portions of the prior art that support your argument that the claim language distinguishes over the prior art.



Inter Partes Reexamination Appeals

Practice Tips

- Oral hearing preparations
 - Identify the weakness of your case.
 - Be prepared to address this weakness directly.
 - Be sure you are making arguments that are made in the Appellant's Brief.



Inter Partes Reexamination Appeals

Practice Tips

- Questions at oral hearing
 - Be prepared
 - Do not view the Judge who is asking the question as an adversary to your appeal.
 - View the question as an opportunity.
 - Do not deny the undeniable - you only lose credibility.



BPAI

Questions?

BPAI website: <http://www.uspto.gov/>

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