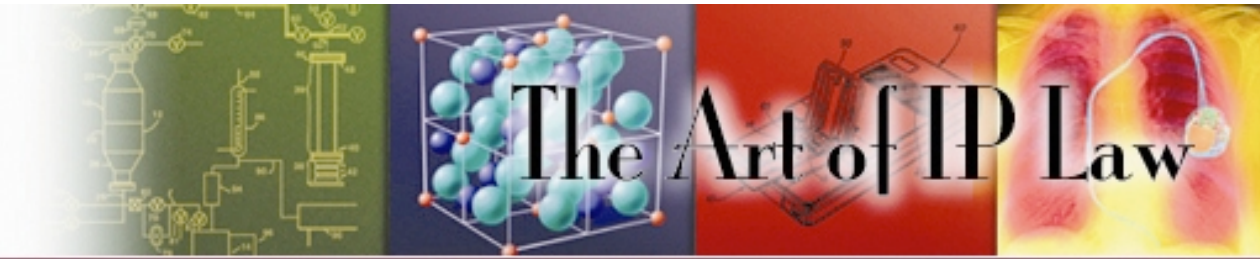




**INTELLECTUAL PROPERTY LAW**

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# Advanced Appeals Practice



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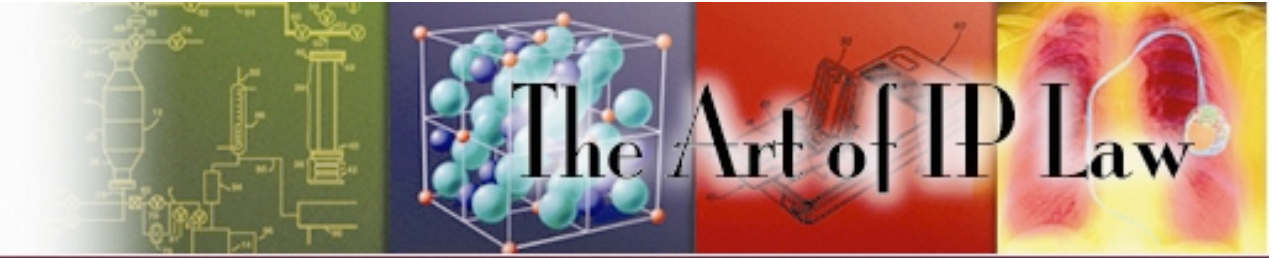
Seattle, WA 98104-4023

Phone: 206.903.2624

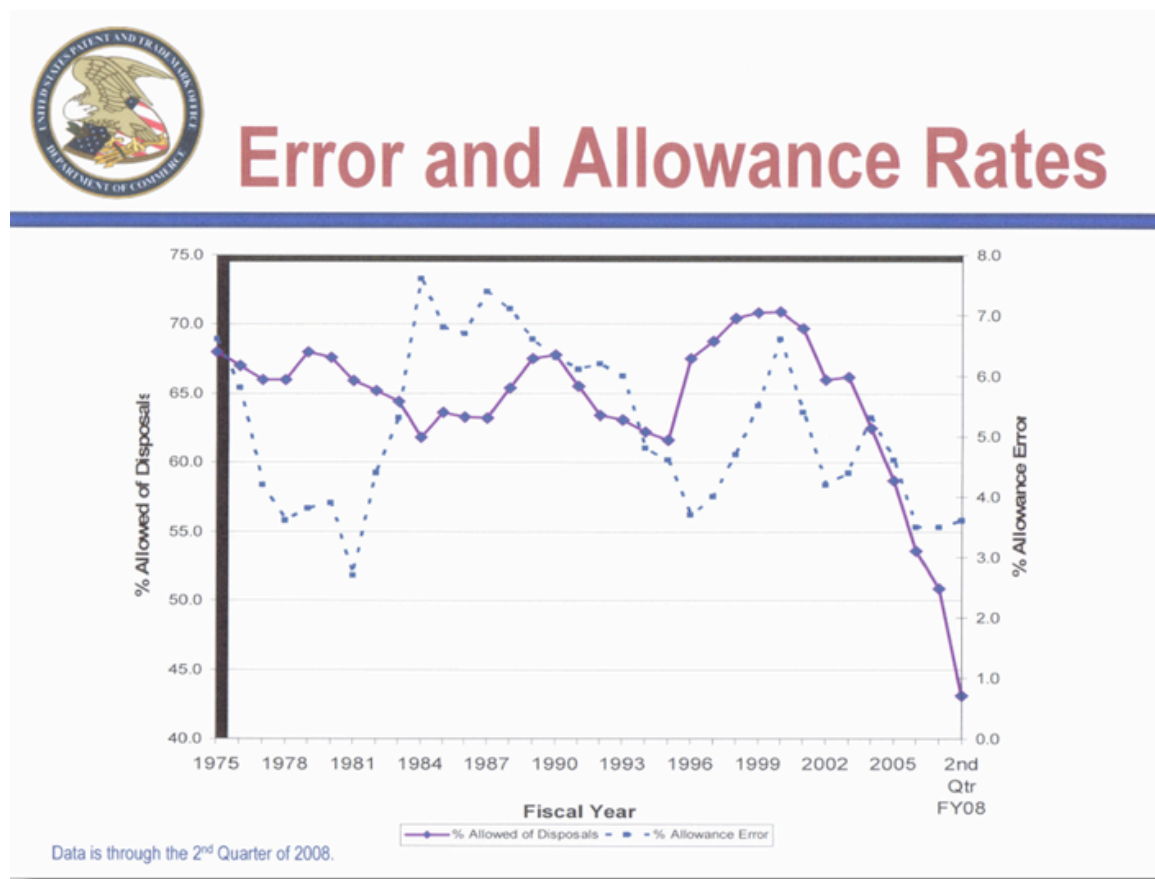
Fax: 206.624.7317

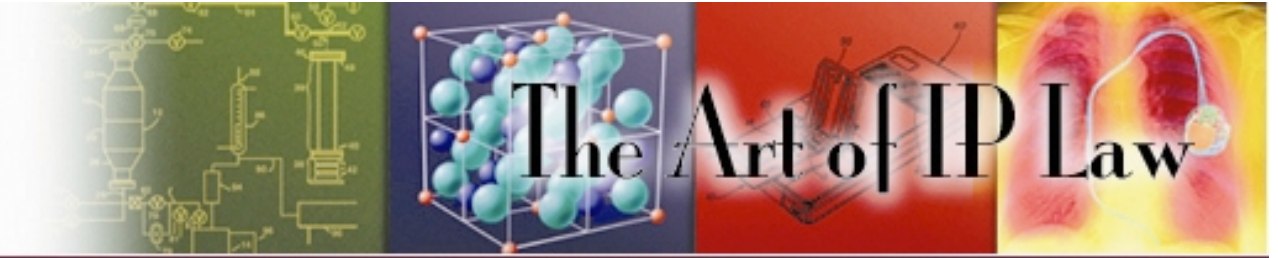
Email: [wsmith@woodcock.com](mailto:wsmith@woodcock.com)

**[www.woodcock.com](http://www.woodcock.com)**



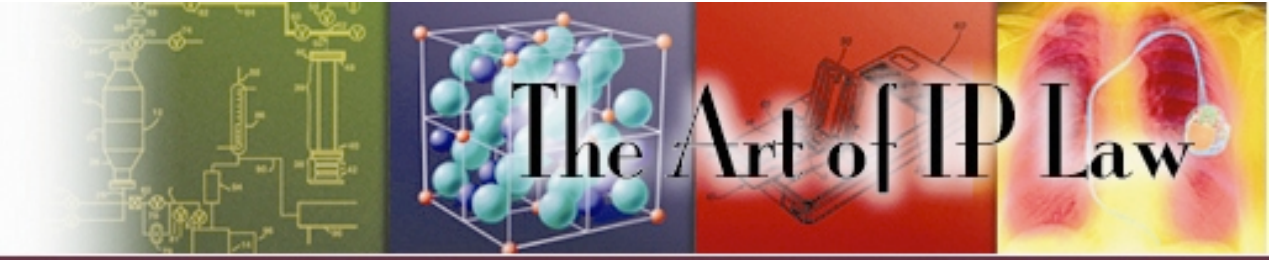
# When we last spoke in May 2009





## Since we last spoke

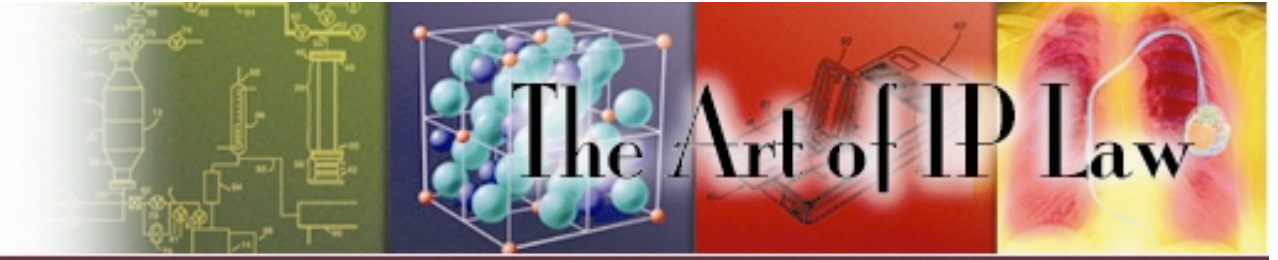
- USPTO announced latest iteration of BPAI rules in November 2010
  - Public comments under consideration
- New Chief Administrative Patent Judge as of May 8, 2011
  - James Donald Smith
- 23-28 new APJs to be hired this fiscal year
  - More to be hired next year, budget permitting



# Why appeal?

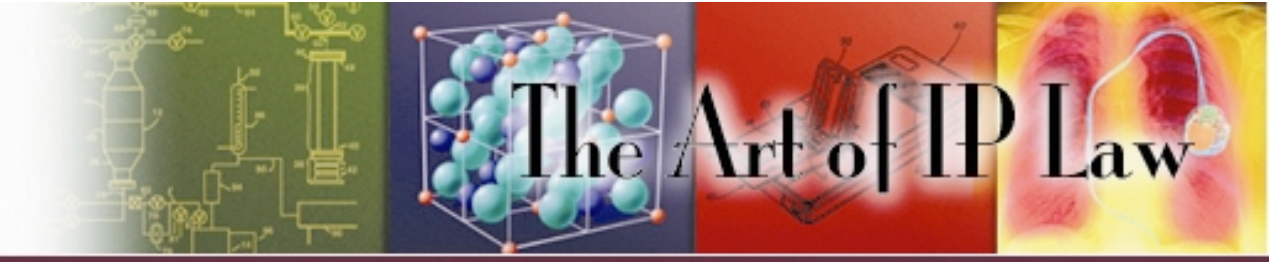
Recent statement of rejection:

The reference does not expressly teach a single embodiment with Applicant's [claim feature]. This deficiency is cured by common sense of the artisan.

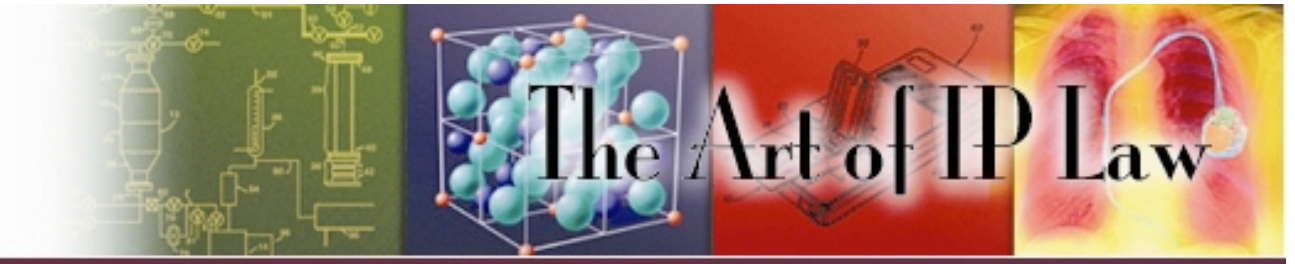


# Appeal/RCE

- Work with examiner
  - Interview
- RCE?
  - Claim scope
  - Evidentiary record

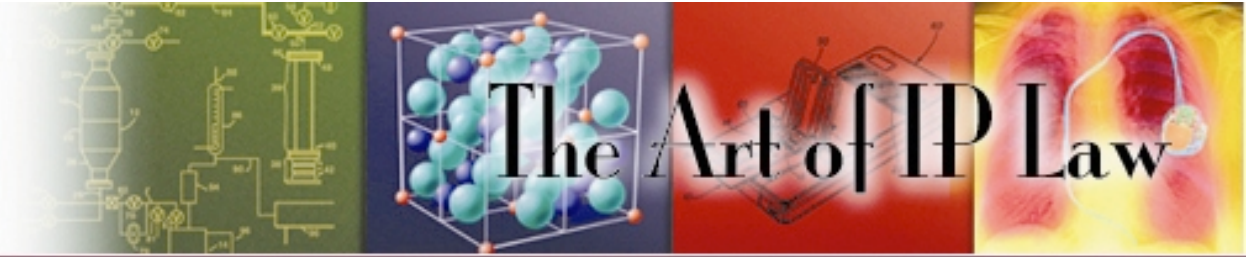


Appeal early and often as good things  
can happen.

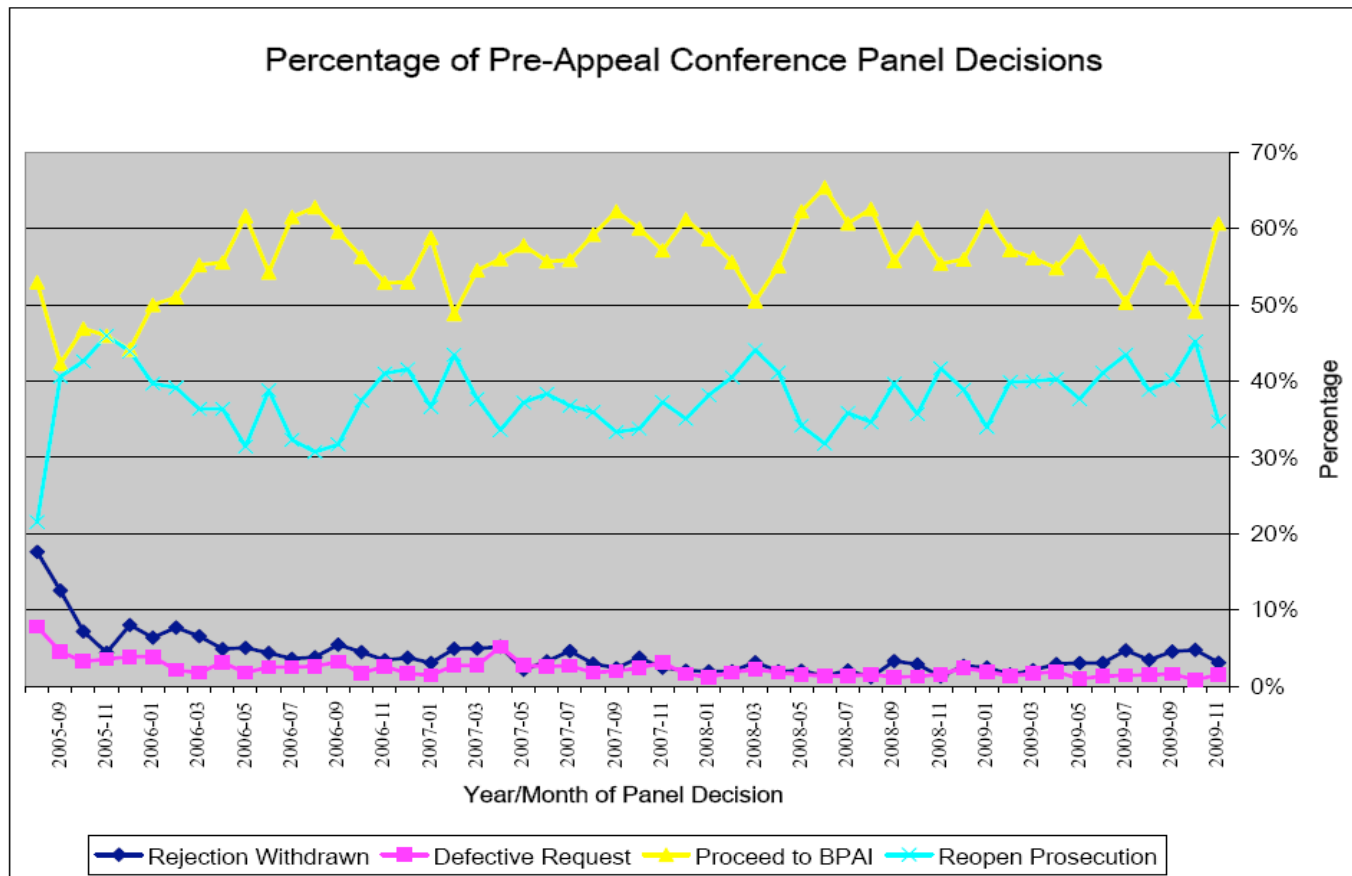


## Join the crowd

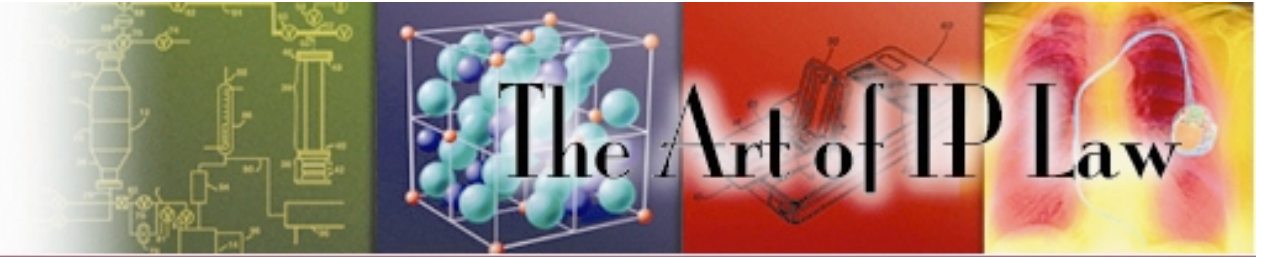
As of April 30, 2011, 21,170  
appeals were pending before the  
Board, up from 1,900 in December  
2005.



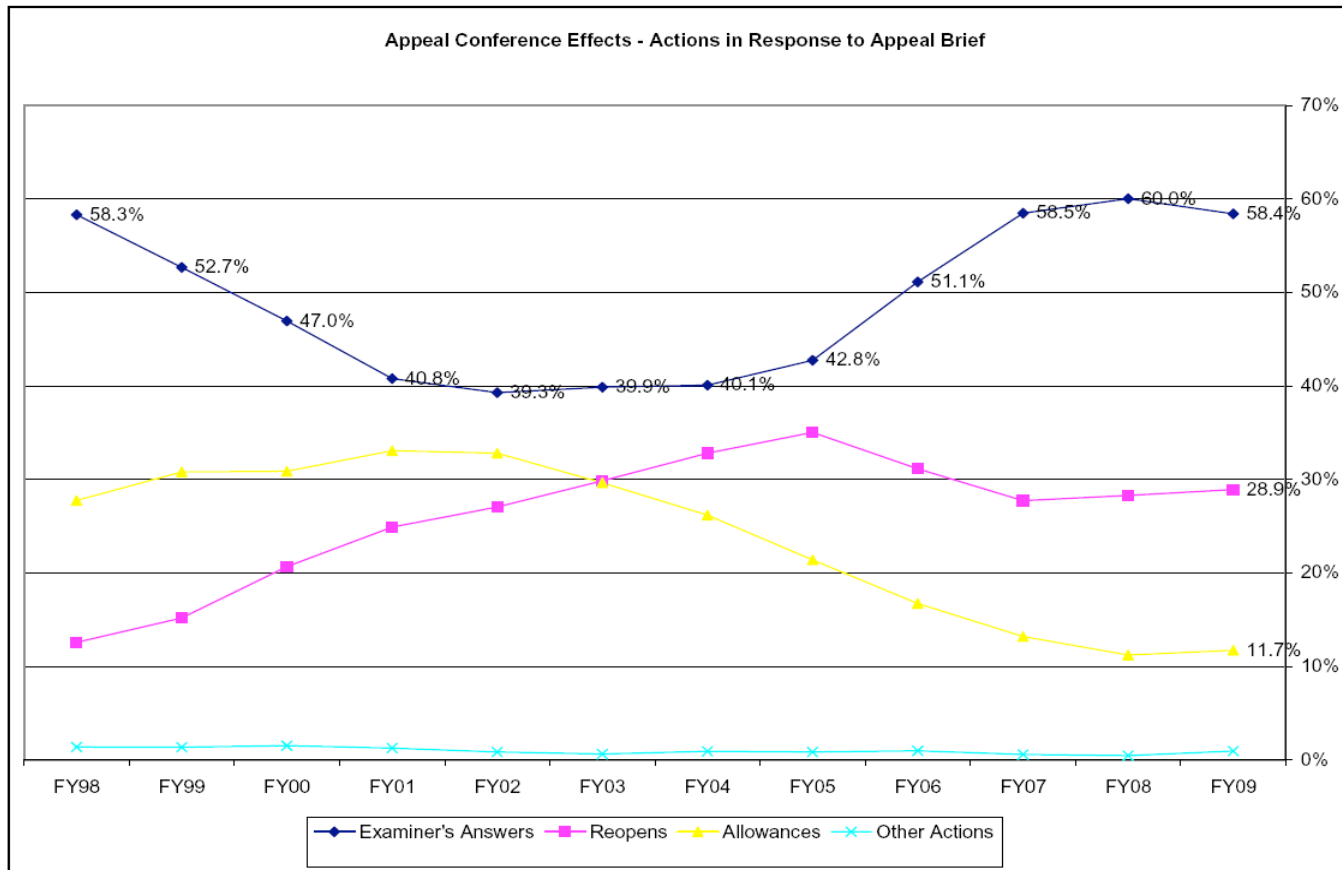
# A Significant Number Of Cases Are Reopened After An NOA Is Filed

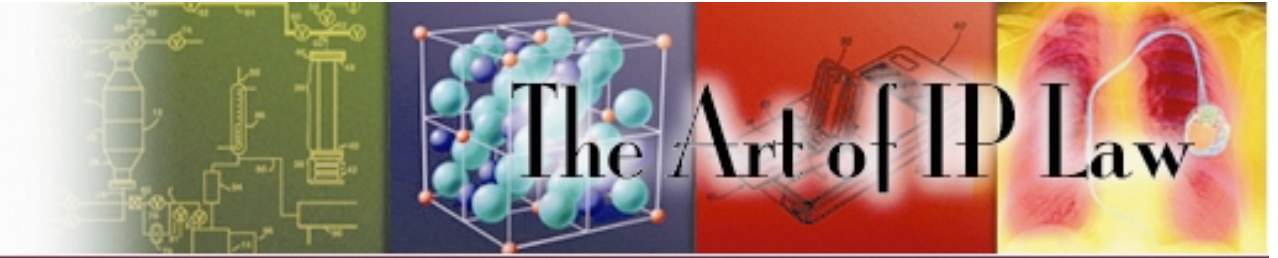






# A Significant Number Of Cases Are Reopened After An NOA Is Filed

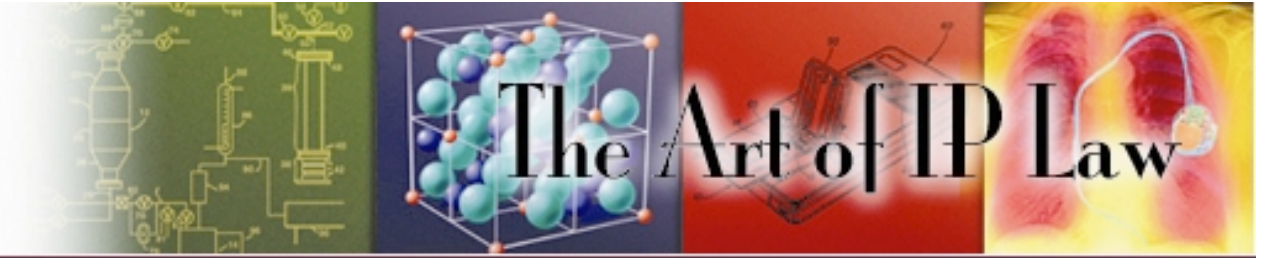




## Board Outcomes

The Board affirmed 48.8%, affirmed-in-part 14.3% and reversed 29.5% in FY 2010.

As of April 30, 2011, the Board has affirmed 48.8%, affirmed-in-part 13.1% and reversed 31.5% this fiscal year.



# An Appeal Is All About Claim Scope

“Analysis begins with a key legal question—what is the invention claimed?...Claim interpretation...will normally control the remainder of the decisional process.”

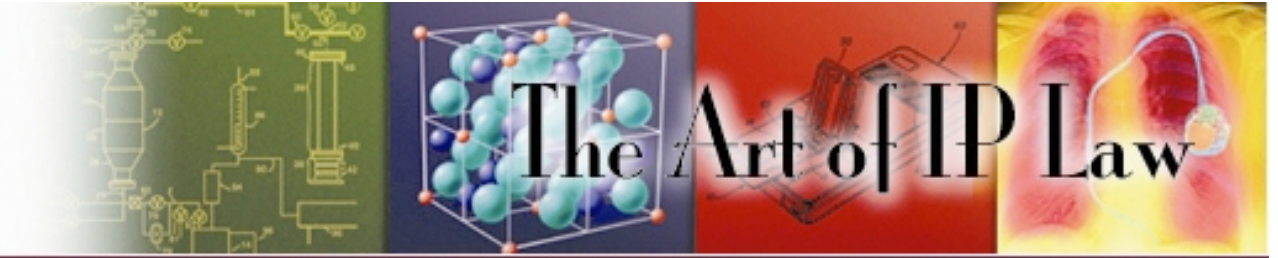
Panduit Corp. v. Dennison Manufacturing Co.,  
810 F.2d 1561, 1567-68 (Fed. Cir. 1987)



# Claim Construction in the USPTO

“[A]s an initial matter, the PTO applies to the verbiage of the proposed claims the **broadest reasonable** meaning of the words in their **ordinary usage** as they would be **understood by one of ordinary skill in the art**, taking into account whatever **enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant’s specification.**”

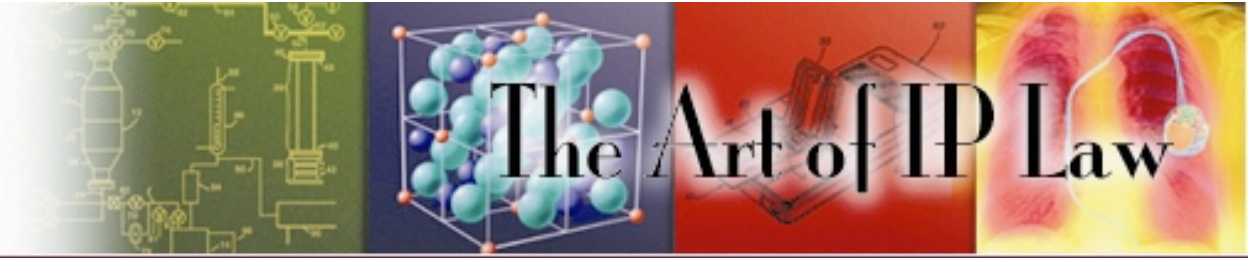
In re Morris, 127 F.3d 1048, 1054 (Fed. Cir. 1997)



# Claim Construction in the USPTO

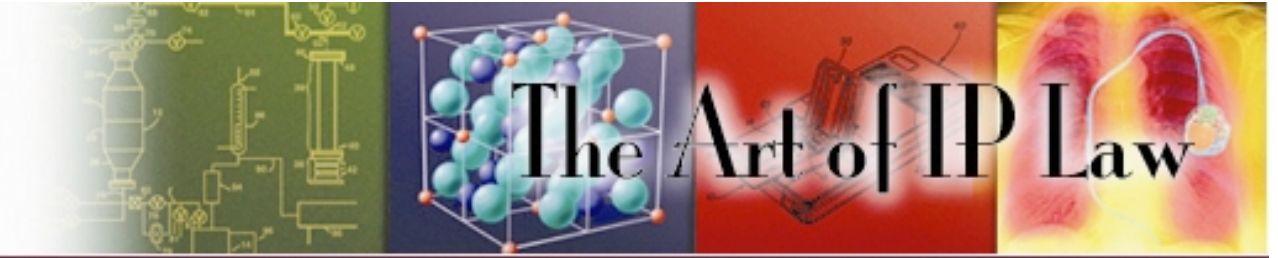
Just because you are right does not mean the examiner is wrong.

“[T]he fact that appellants can point to definitions or usages that conform to their interpretation does not make the PTO's definition unreasonable when the PTO can point to other sources that support its interpretation.” Morris, 127 F.3d at 1056



## Claim Scope v. 112-2

“If the language of a claim, given its broadest reasonable interpretation, is such that a person of ordinary skill in the relevant art would read it with more than one reasonable interpretation, then a rejection under § 112, ¶ 2 is appropriate.” 76 Fed. Reg. at 7164, second column



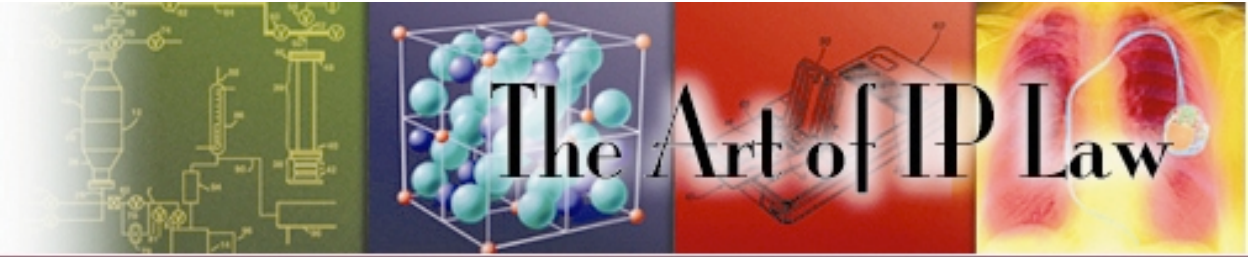
# Standard of Review

“[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant.

After evidence or argument is submitted by the applicant in response, **patentability is determined on the totality of the record, by a preponderance of evidence with due consideration to persuasiveness of argument.**

If examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent.”

In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992) (citations omitted)



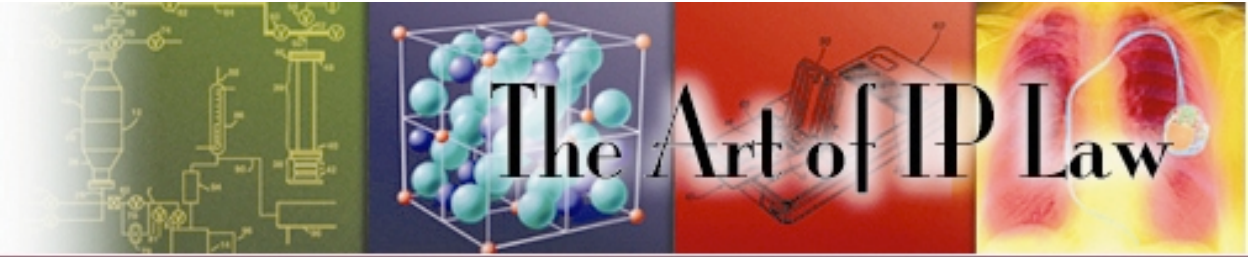
## But what is the BPAI standard of review?

“At issue is whether the Appellant has shown that the Examiner erred in making the aforementioned rejections.”

or,

“Does the evidence of record support the Examiner’s conclusion....”



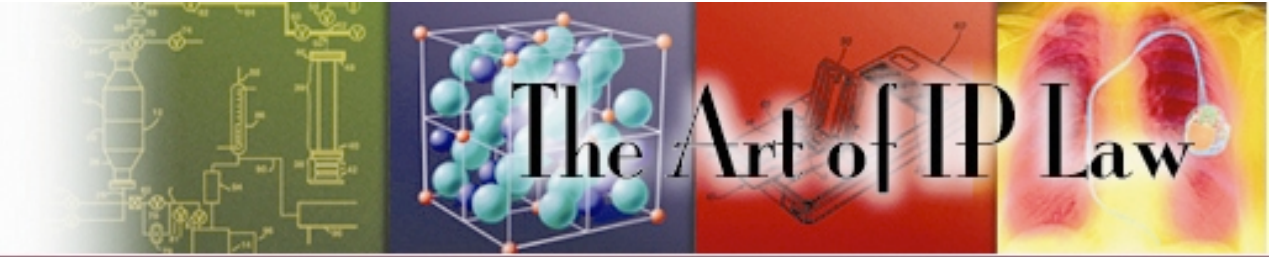


# Presumption Of Examiner Correctness?

Ex parte Frye, Appeal No. 2009-006013, February 26, 2010 (precedential)

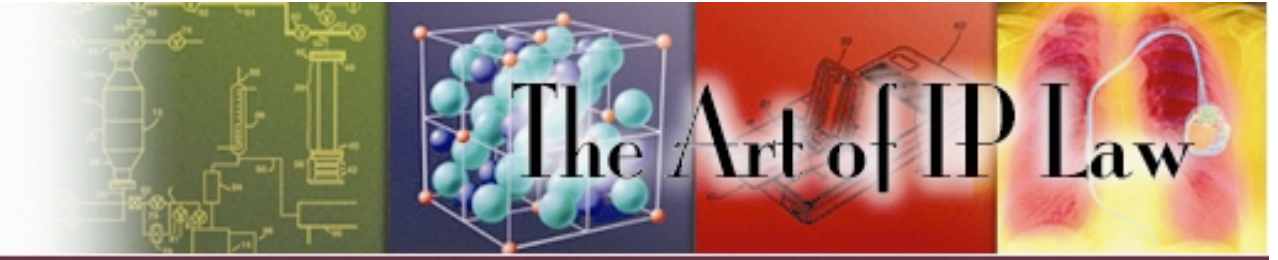
– Panel included the Director, Deputy Director, CAPJ, a VCAPJ and three APJs.

“Specifically, the Board reviews the particular finding(s) contested by an appellant anew in light of all the evidence and argument on that issue.”



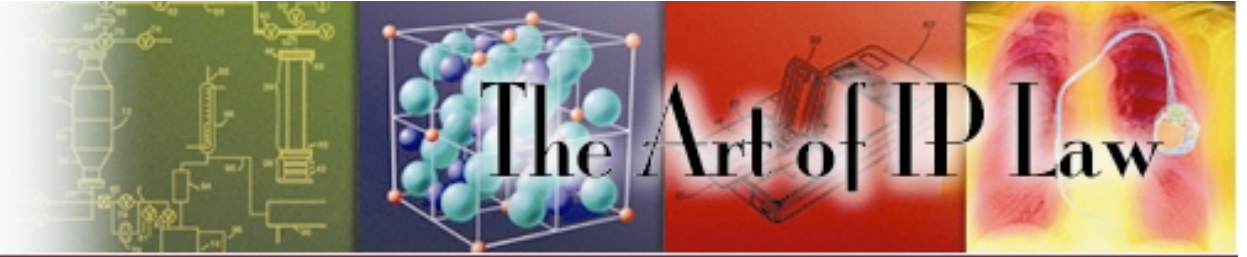
# Appeal Brief Must Contain All Arguments

The commentary to the November 2010 proposed rules states that even though the now proposed rule omits the previous strict waiver language, the “Board will still treat as waived, for purposes of the present appeal, any arguments not raised by appellant.” 75 Fed. Reg. 69835, third column.



## Work for PTA

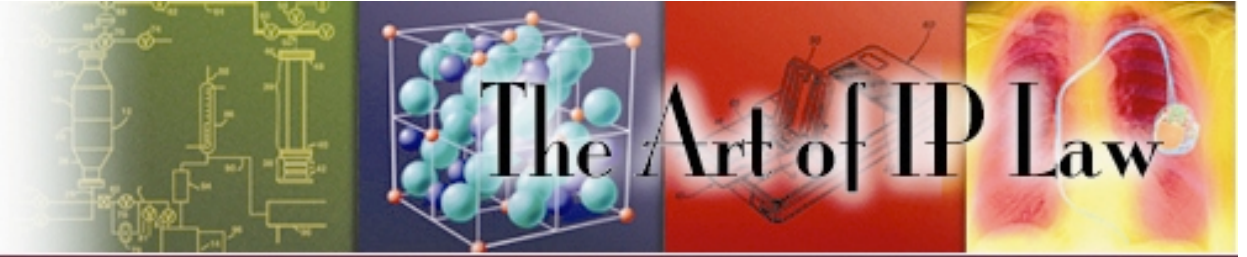
PTA accrues upon an “appellate review by the Board of Patent Appeals and Interferences or by a federal court in a case in which the patent was issued under a decision in the review reversing an adverse determination of patentability....” 35 U.S.C. § 154(b)(C)(2)(iii)



## PTA--Every Claim Counts Argue Claims Separately

Claims argued together, (stand or) fall together

- When argued as a group (subject to same rejection), the Board may select claim most vulnerable to rejection . . .
- Affirmance of rejection of this one claim is affirmance of all



# PTA--Every Claim Counts Argue Claims Separately

## Converse not true

- If the rejection of the first independent claim of the group is reversed . . .
- . . . Board will review each remaining independent claim in the group to see if reasons for reversing apply



## Work for PTA

- Beware of the BPAI “backfilling” gaps in the examiner’s case and calling the decision an “affirmance.”
- Relief is by way of Request for Rehearing
  - Request reversal of examiner’s rejection(s)
  - If BPAI believes the claims are unpatentable for facts and reasons not relied by the examiner, proper course is 37 CFR 41.50(b)



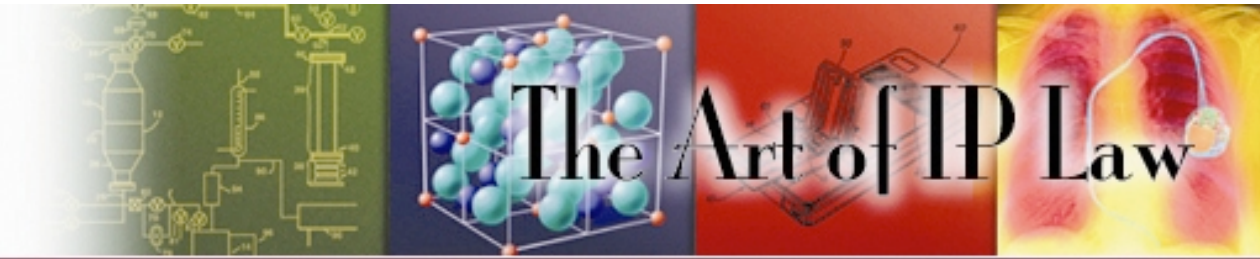
# Request a Hearing

- You will have the undivided attention of the panel
- Opportunity to answer questions that are of concern to the panel
- Opportunity to emphasize key arguments
- Have the last word



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