PATENT APPEALS = INVESTING IN BROAD CLAIMS

Appellate Counsel

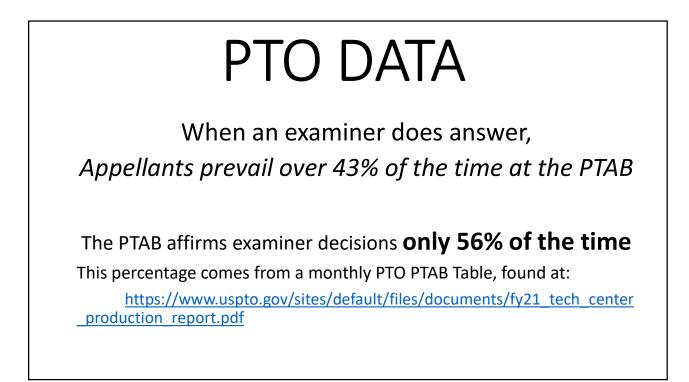
Joe Piccolo, Registration No. 34,695 DAVIDSON BERQUIST JACKSON & GOWDEY, LLP jpiccolo@dbjg.com, (571)765-7715

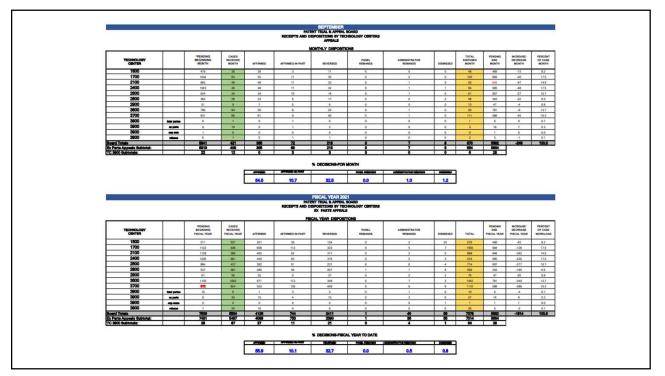
PTO DATA

Per the Patent Examination Manual, § 1207.01 -Appellant's Appeal Brief triggers an intra-agency conference on whether to defend the examiner rejection or not

The PTO has conveyed to me: only 65% of appeal briefs are answered

So, **Appeal Phase 1** has quick frequent success





Bottom, left box shows the PTAB affirms examiner decisions less than 56% of the time.

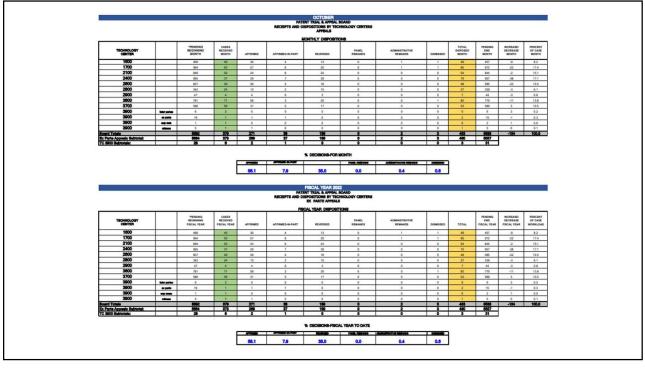
Middle line in between two tables, leftmost box shows 54.5%. That is, in September of this year, the PTAB affirmed Examiner Decisions 54.5% of the time.

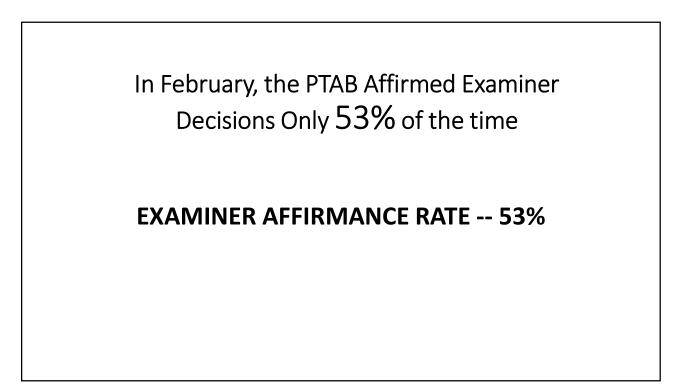
So, **Appeal Phase 2** includes much success for Appellants

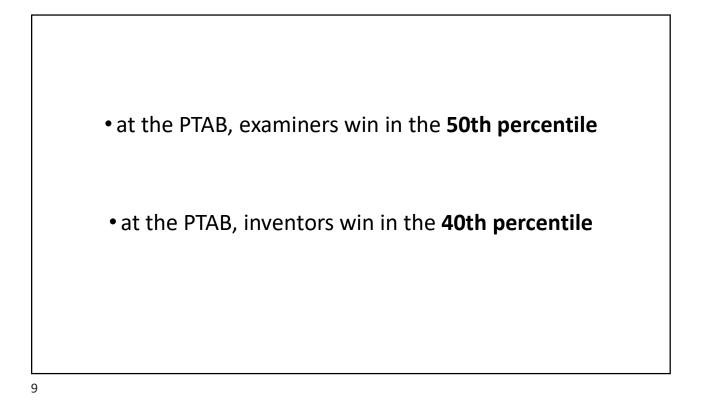
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In October, the PTAB affirmed examiner decisions 56% of the time.

The middle line in between below two tables shows 56%.







PTO Data shows that examiners regularly issue weak rejections. The inventor community should push back, not by amending, but by appealing. Doing so will get broad (and deserved) claims.

TWO KEY POINTS

1) DO NOT GIVE IN TO POOR EXAMINING

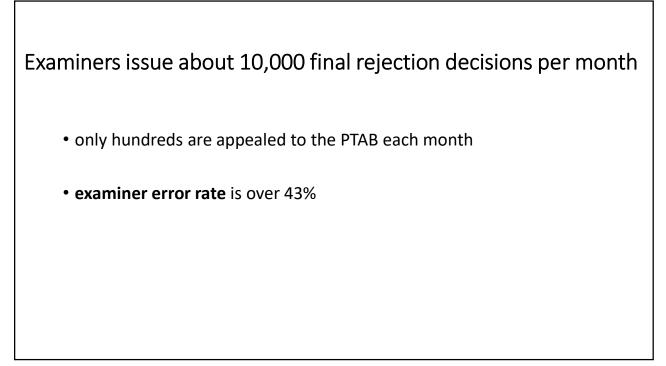
2) INVEST IN BROAD CLAIMS USING THE APPEAL PROCESS

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Appeals to the PTAB

Congress gave us a great tool to address the **Examiners' very high error rate**

Invest in broad claims instead of acquiescing to unreasonable positions and amending/narrowing an Inventor's Property

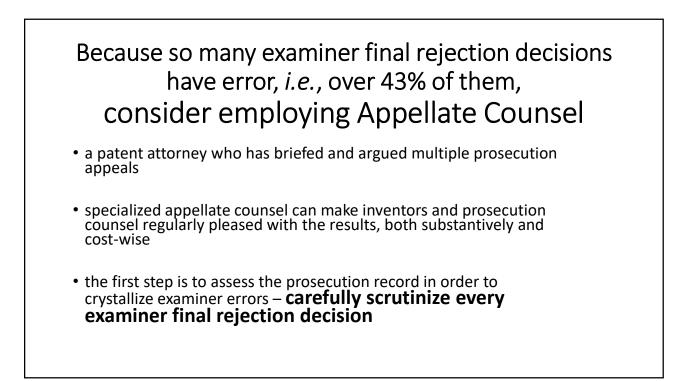




- An **Examiner Error Rate over 43%** means that of those 9,000+, many examiner final rejection decisions contain error that the PTAB would correct for your Inventors (or the examiner would just concede)
- Invest in Broad Claims instead of amending a claim that should be granted in unamended form

Thousands of Inventor Applications per month are losing out on the Curative PTAB Appeal Process

- Because I have studied this examiner error rate for a long time, I view it as **due diligence** that you review your prosecution records up to any examiner final rejection decision, with an eye toward appealing
- *Many* Inventors will get claims which they were fully entitled to all along
- Appellate Counsel can help analyze your prosecution records



Inventors Deserve A Diligent Look At Final Rejections, Given The PTAB's Examiner Error Rate

• Examiners win in the 50th percentile

• Inventors win in the 40th percentile

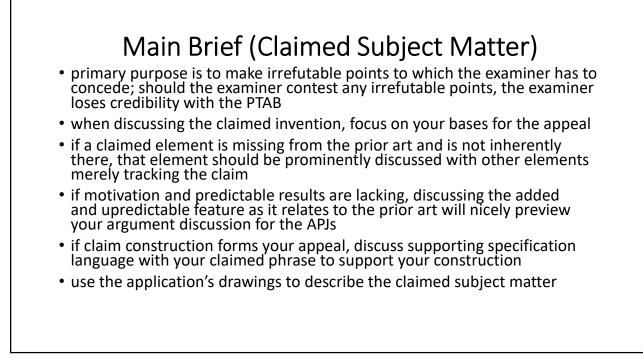
So, bargain less with examiners.

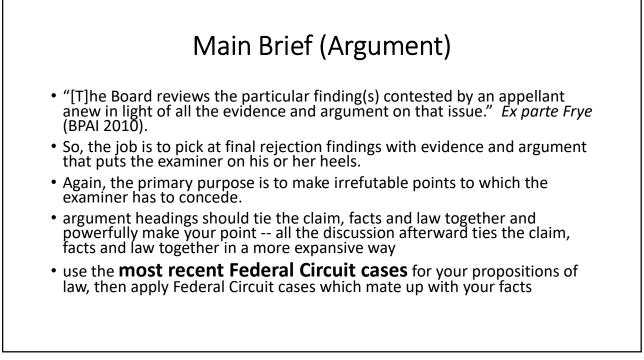
Due diligence can raise the 1-out-of-2 chance to 2-out-of-3 and higher.

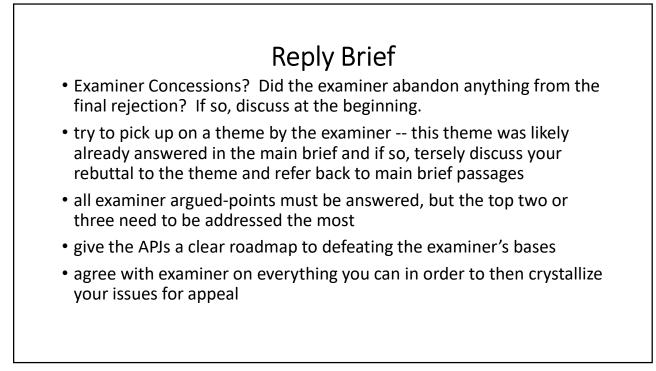
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Corrections by the PTAB

• For successful PTAB Appeals, there is corresponding Patent Term Adjustment. 35 U.S.C. § 154(b)(1)(C)(iii); 37 C.F.R. § 1.702(e).









- Is the examiner there? If so, your reply time/points will be critical.
- your points were already made in your main brief
- reiterate those points, but welcome interruption by the APJs
- it is their time to figure out who is right
- listen and answer with facts and evidence

