## PATENT APPEALS = INVESTING IN BROAD CLAIMS

### **Appellate Counsel**

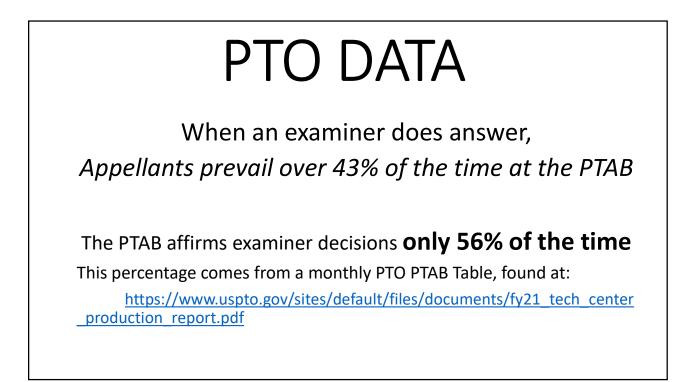
Joe Piccolo, Registration No. 34,695 DAVIDSON BERQUIST JACKSON & GOWDEY, LLP jpiccolo@dbjg.com, (571)765-7715

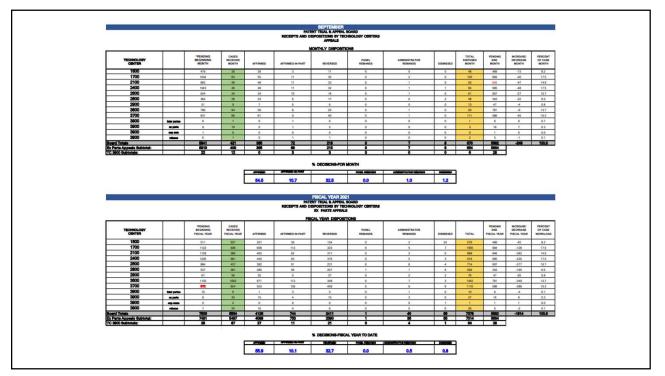
# PTO DATA

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.

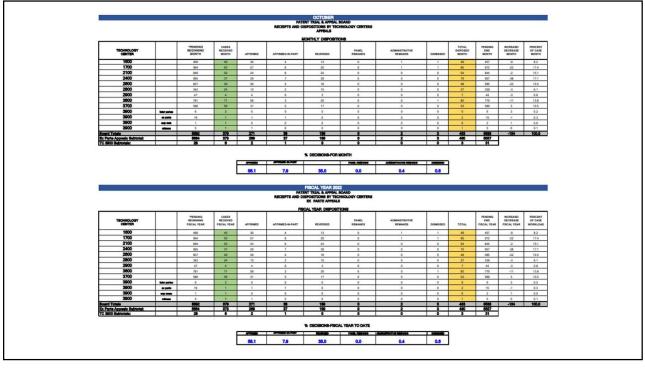
Middle line in between two tables, leftmost box shows 54.5%. That is, in September of this year, the PTAB affirmed Examiner Decisions 54.5% of the time.

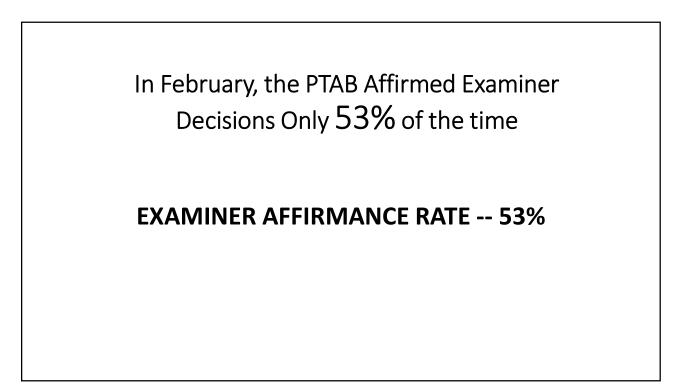
### So, **Appeal Phase 2** includes much success for Appellants

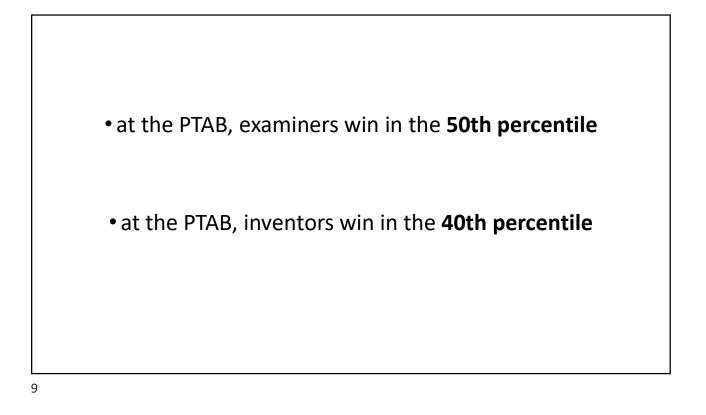
#### 5

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

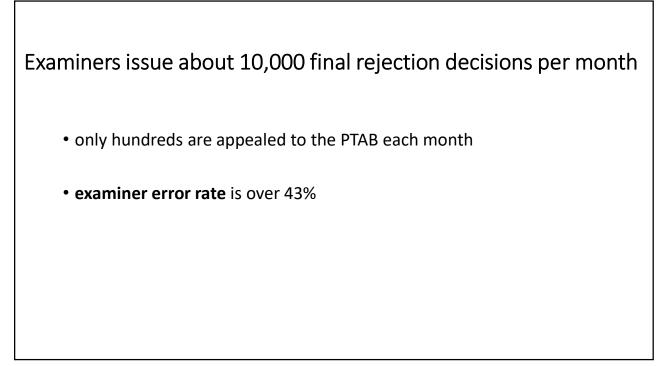
## 2) INVEST IN BROAD CLAIMS USING THE APPEAL PROCESS

11

## **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

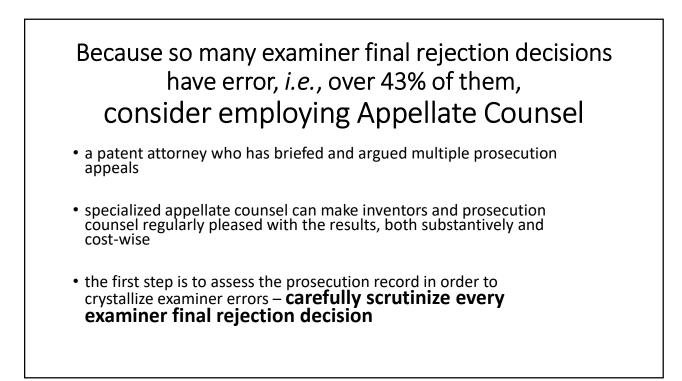




- An **Examiner Error Rate over 43%** means that of those 9,000+, many examiner final rejection decisions contain error that the PTAB would correct for your Inventors (or the examiner would just concede)
- Invest in Broad Claims instead of amending a claim that should be granted in unamended form

### 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

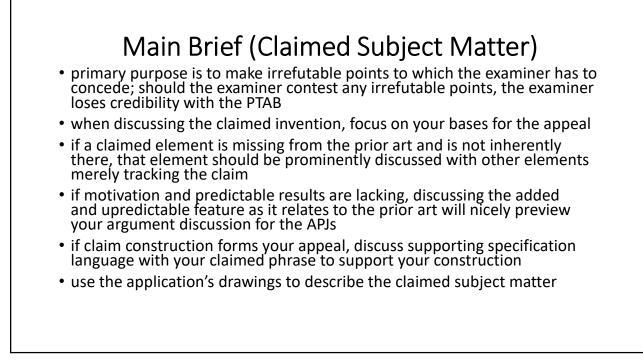
So, bargain less with examiners.

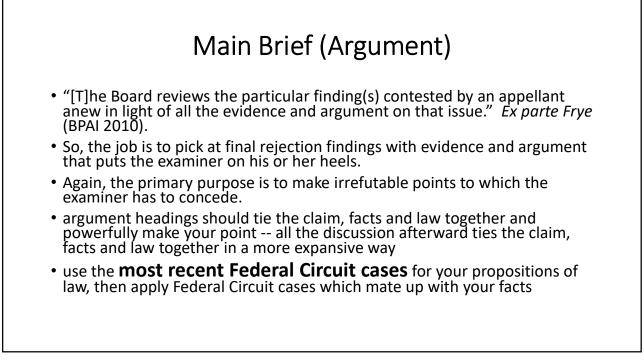
Due diligence can raise the 1-out-of-2 chance to 2-out-of-3 and higher.

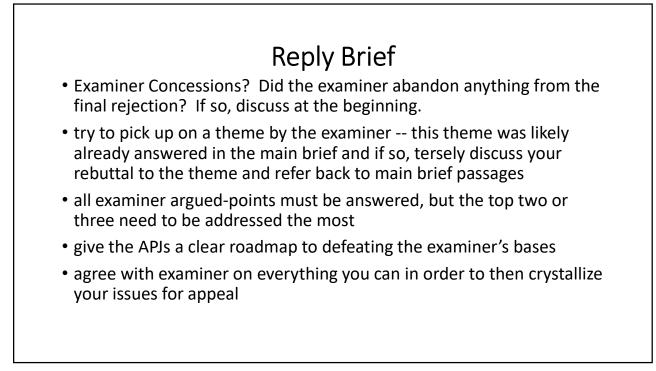
17

#### 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

