

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

1

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

2

PTO DATA

When an examiner does answer,
Appellants prevail over 43% of the time at the PTAB

The PTAB affirms examiner decisions **only 56% of the time**

This percentage comes from a monthly PTO PTAB Table, found at:

https://www.uspto.gov/sites/default/files/documents/fy21_tech_center_production_report.pdf

3

EXaminer												
PATENT TRIAL & APPEAL BOARD												
RECEIPTS AND DISPOSITIONS BY TECHNOLOGY CENTERS												
APPEALS												
MONTHLY DISPOSITIONS												
TECHNOLOGY CENTER	PENDING BEGINNING MONTH	CASES RECEIVED MONTH	AFFIRMED	AFFIRMED-IN-PART	REVERSED	PANEL REMANDS	ADMINISTRATIVE REMANDS	DISMISSED	TOTAL DISPOSED MONTH	PENDING END MONTH	INCREASE/DECREASE MONTH	PERCENT OF CASE MONTH
1900	424	18	22	3	11	0	0	0	46	466	-13	8.2
1700	1234	81	55	11	35	0	2	0	103	604	-40	17.5
2100	851	46	46	11	33	0	1	0	93	345	-47	14.9
2400	1043	46	46	11	32	0	1	1	94	666	-46	17.6
2800	524	24	24	10	16	0	1	0	61	607	-27	10.7
2800	364	28	23	6	17	0	0	2	48	342	-22	8.0
2900	51	8	7	0	6	0	0	0	13	47	-4	0.8
3600	750	34	19	8	25	0	1	0	53	781	-8	13.7
3700	631	46	31	9	40	0	1	0	111	546	-45	10.3
3800	0	1	0	1	0	0	0	0	1	6	0	0.1
3900	0	10	0	1	2	0	0	0	3	16	7	0.3
3900	0	0	0	0	0	0	0	0	0	0	0	0.0
3900	0	0	0	0	0	0	0	0	0	0	0	0.0
Grand Totals	6411	421	386	74	218	0	7	8	24	676	-246	10.0
Ex Parte Appeals Subtotal	6919	400	369	69	219	0	7	8	64	694	-246	10.0
TC 3900 Subtotal	0	0	0	0	0	0	0	0	0	0	0	0.0

% DECISIONS FOR MONTH					
AFFIRMED	AFFIRMED-IN-PART	REVERSED	PANEL REMANDS	ADMINISTRATIVE REMANDS	DISMISSED
64.6	10.7	32.6	0.0	1.0	1.2

EXaminer												
PATENT TRIAL & APPEAL BOARD												
RECEIPTS AND DISPOSITIONS BY TECHNOLOGY CENTERS												
EX PARTE APPEALS												
FISCAL YEAR DISPOSITIONS												
TECHNOLOGY CENTER	PENDING BEGINNING FISCAL YEAR	CASES RECEIVED FISCAL YEAR	AFFIRMED	AFFIRMED-IN-PART	REVERSED	PANEL REMANDS	ADMINISTRATIVE REMANDS	DISMISSED	TOTAL DISPOSED FISCAL YEAR	PENDING END FISCAL YEAR	INCREASE/DECREASE FISCAL YEAR	PERCENT OF CASE FISCAL YEAR
1900	511	521	257	39	154	0	2	24	576	486	-45	8.2
1700	1229	126	626	113	323	0	5	7	1076	654	-126	17.6
2100	852	50	483	37	311	0	2	0	898	646	-262	14.9
2400	1229	681	445	93	370	0	5	3	916	565	-239	17.5
2800	664	437	263	81	231	0	6	4	584	607	-277	10.7
2800	527	361	235	58	207	1	1	0	506	342	-195	8.0
2900	67	36	35	0	37	0	2	2	76	47	-20	0.8
3600	1120	1200	671	113	348	0	7	3	1462	781	-246	13.1
3900	0	624	353	106	409	0	6	6	1190	586	-286	10.3
3700	0	0	0	0	0	0	0	0	0	0	0	0.0
3800	0	0	0	0	0	0	0	0	0	0	0	0.0
3900	0	0	0	0	0	0	0	0	0	0	0	0.0
3900	0	0	0	0	0	0	0	0	0	0	0	0.0
Grand Totals	7990	6946	4126	744	2411	1	40	38	7328	5884	-1914	10.0
Ex Parte Appeals Subtotal	7481	5467	4069	723	2360	1	36	32	6714	5244	-1914	10.0
TC 3900 Subtotal	0	67	27	11	21	0	4	6	64	28	0	0.0

% DECISIONS FISCAL YEAR TO DATE					
AFFIRMED	AFFIRMED-IN-PART	REVERSED	PANEL REMANDS	ADMINISTRATIVE REMANDS	DISMISSED
65.9	10.1	32.7	0.0	0.5	0.8

4

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%.

6

OCTOBER PATENT TRIAL & APPEAL BOARD RECEIPTS AND DISPOSITIONS BY TECHNOLOGY CENTERS APPEALS												
MONTHLY DISPOSITIONS												
TECHNOLOGY CENTER	PENDING BEGINNING MONTH	CASES RECEIVED MONTH	AFFIRMED	AFFIRMED-IN-PART	REVERSED	PANEL REWARDS	ADMINISTRATIVE REWARDS	DISMISSED	TOTAL DISPOSED MONTH	PENDING END MONTH	INCREASE/DECREASE MONTH	PERCENT OF CASE MONTH
1800	456	43	33	4	13	0	1	1	48	437	-8	8.2
1700	894	63	53	5	23	0	1	1	83	972	-78	17.4
2100	896	52	24	6	24	0	0	0	54	844	-52	15.1
2400	895	37	29	7	19	0	0	0	75	867	-38	11.1
2800	827	25	25	4	18	0	0	0	48	885	-58	15.5
2900	342	24	19	2	13	0	0	0	34	356	-14	6.1
2900	47	4	4	0	2	0	0	0	7	44	-3	0.8
3000	781	71	58	3	23	0	0	1	85	770	-11	13.8
3700	188	18	21	3	17	0	0	0	51	189	1	15.5
3900	0	2	0	0	0	0	0	0	0	0	0	0.0
3900	18	1	1	1	0	0	0	0	2	15	-1	0.3
3900	0	1	0	0	0	0	0	0	0	2	1	0.0
3900	0	1	0	0	0	0	0	0	1	0	0	0.0
Board Totals	6882	379	271	38	149	0	2	3	468	6988	-104	100.0
Ex Parte Appeals Subtotal:	6884	379	269	37	149	0	2	3	469	6997	-113	100.0
TC 3900 Subtotal:	18	2	2	1	0	0	0	0	5	31	-13	0.0

% DECISIONS-FOR MONTH					
AFFIRMED	AFFIRMED-IN-PART	REVERSED	PANEL REWARDS	ADMINISTRATIVE REWARDS	DISMISSED
35.1	7.9	35.0	0.0	0.4	0.8

FISCAL YEAR DISPOSITIONS												
TECHNOLOGY CENTER	PENDING BEGINNING FISCAL YEAR	CASES RECEIVED FISCAL YEAR	AFFIRMED	AFFIRMED-IN-PART	REVERSED	PANEL REWARDS	ADMINISTRATIVE REWARDS	DISMISSED	TOTAL	PENDING END FISCAL YEAR	INCREASE/DECREASE FISCAL YEAR	PERCENT OF CASE WORKLOAD
1800	456	43	33	4	13	0	1	1	48	437	-8	8.2
1700	894	63	53	5	23	0	1	1	85	972	-78	17.4
2100	895	52	24	6	24	0	0	0	54	844	-51	15.1
2400	895	37	29	7	19	0	0	0	75	867	-38	11.1
2800	827	25	25	4	18	0	0	0	48	885	-42	15.5
2900	342	24	19	2	13	0	0	0	34	356	-14	6.1
2900	47	4	4	0	2	0	0	0	7	44	-3	0.8
3000	781	71	58	3	23	0	0	1	85	770	-11	13.8
3700	188	18	21	3	17	0	0	0	51	189	1	15.5
3900	18	2	0	0	0	0	0	0	0	0	0	0.0
3900	18	1	1	1	0	0	0	0	2	15	-1	0.3
3900	0	1	0	0	0	0	0	0	0	2	1	0.0
3900	0	1	0	0	0	0	0	0	1	0	0	0.0
Board Totals	6882	379	271	38	149	0	2	3	468	6988	-104	100.0
Ex Parte Appeals Subtotal:	6884	379	269	37	149	0	2	3	469	6997	-113	100.0
TC 3900 Subtotal:	18	2	2	1	0	0	0	0	5	31	-13	0.0

% DECISIONS-FISCAL YEAR TO DATE					
AFFIRMED	AFFIRMED-IN-PART	REVERSED	PANEL REWARDS	ADMINISTRATIVE REWARDS	DISMISSED
35.1	7.9	35.0	0.0	0.4	0.8

7

In February, the PTAB Affirmed Examiner
Decisions Only 53% of the time

EXAMINER AFFIRMANCE RATE -- 53%

8

- at the PTAB, examiners win in the **50th percentile**
- at the PTAB, inventors win in the **40th percentile**

9

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.

10

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

12

Examiners issue about 10,000 final rejection decisions per month

- only hundreds are appealed to the PTAB each month
- **examiner error rate** is over 43%

13

Examiners issue about 10,000 final rejection decisions per month

- 9,000+ examiner final rejection decisions *are not being appealed* each month
- 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

14

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

15

Because so many examiner final rejection decisions have error, *i.e.*, over 43% of them, consider employing Appellate Counsel

- a patent attorney who has briefed and argued multiple prosecution appeals
- specialized appellate counsel can make inventors and prosecution counsel regularly pleased with the results, both substantively and cost-wise
- the first step is to assess the prosecution record in order to crystallize examiner errors – **carefully scrutinize every examiner final rejection decision**

16

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).

18

Main Brief (Claimed Subject Matter)

- primary purpose is to make irrefutable points to which the examiner has to concede; should the examiner contest any irrefutable points, the examiner loses credibility with the PTAB
- when discussing the claimed invention, focus on your bases for the appeal
- if a claimed element is missing from the prior art and is not inherently there, that element should be prominently discussed with other elements merely tracking the claim
- if motivation and predictable results are lacking, discussing the added and unpredictable feature as it relates to the prior art will nicely preview your argument discussion for the APJs
- if claim construction forms your appeal, discuss supporting specification language with your claimed phrase to support your construction
- use the application's drawings to describe the claimed subject matter

19

Main Brief (Argument)

- “[T]he Board reviews the particular finding(s) contested by an appellant anew in light of all the evidence and argument on that issue.” *Ex parte Frye* (BPAI 2010).
- So, the job is to pick at final rejection findings with evidence and argument that puts the examiner on his or her heels.
- Again, the primary purpose is to make irrefutable points to which the examiner has to concede.
- argument headings should tie the claim, facts and law together and powerfully make your point -- all the discussion afterward ties the claim, facts and law together in a more expansive way
- use the **most recent Federal Circuit cases** for your propositions of law, then apply Federal Circuit cases which mate up with your facts

20

Reply Brief

- Examiner Concessions? Did the examiner abandon anything from the final rejection? If so, discuss at the beginning.
- try to pick up on a theme by the examiner -- this theme was likely already answered in the main brief and if so, tersely discuss your rebuttal to the theme and refer back to main brief passages
- all examiner argued-points must be answered, but the top two or three need to be addressed the most
- give the APJs a clear roadmap to defeating the examiner's bases
- agree with examiner on everything you can in order to then crystallize your issues for appeal

21

Oral Argument

- 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*

22

TAP THE POTENTIAL OF CLAIMS UNDULY REJECTED

- We owe this to the thousands of Inventors out there.
- Because the examiner error rate is **over 43%**, consider using Appellate Counsel and invest in obtaining broad claims.
- PTO Data shows examiners give up **a third of the time** rather than filing an examiner's answer.
- Acceding to examiner error is simply contrary to the Inventors' interests.

23

Two Key Points

Do not Give in to Poor Examining

Invest in Broad Claims by Appealing

24

COMPLEX LITIGATION
INTELLECTUAL PROPERTY
PATENT LAW



JOSEPH G. PICCOLO
PARTNER

DAVIDSON BERQUIST JACKSON & GOWDEY, LLP
8300 Greensboro Drive, Suite 500, McLean, VA 22102
Office: 571-765-7715 • Cell: 703-346-4224
jpiccolo@dbjg.com

USPTO Patent Attorney Registration No. 34,695
Admitted in New York only