

## New cost-effective forum to appeal finally-rejected patent applications

*The United States Patent & Trademark Office launches Pre-Appeal-Brief Conference pilot program*

The United States Patent and Trademark Office has recently introduced a pilot program that provides a new forum to appeal a final rejection during prosecution of a patent application. This pilot program provides a potentially powerful new tactical tool to obtain reconsideration of a final rejection. More specifically, in response to a written request by the patent applicant, a panel that includes outside Examiners will provide an earlier reevaluation of rejections—before the submission of the appeal brief is due.

### The pilot program

Once an applicant elects to participate in this pilot program, a panel of examiners formally reviews the bases for the rejections before the applicant actually commits resources to file an appeal brief. The panel determines whether a clear factual error or a deficiency in a prima facie rejection exists. Should the panel find that the contested rejections are proper, the applicant reserves the right to file an appeal. Otherwise the panel will either reopen prosecution or indicate that the claims are allowable. Consequently, the applicant may avoid the excessive costs and protracted prosecution time common to either appealing to the Board of Patent Appeals and Inferences or filing a Request for Continued Examination (“RCE”). The United States Patent and Trademark Office expects patent applicants to save collectively at least \$30 million annually if this pilot program becomes permanent.

### Participation requirements

To participate in the pilot program, an applicant files:

1. a notice of appeal, and
2. a request for Pre-Appeal-Brief Conference (the “Request”).

The Request is filed with a notice of appeal, but prior to the filing of an actual appeal brief. The Request is limited to no more than five pages and should include concise arguments setting forth the deficiencies in the Examiner’s reasons for maintaining the rejections. The applicant is encouraged to refer to arguments already of record rather than repeating them in the Request. Any after-final and proposed amendments accompanying the Request, however, will not be considered. Further, any of the following filings by the applicant automatically terminates the panel’s review:

1. an appeal brief,
2. an RCE,
3. an after-final amendment,
4. an affidavit or other evidence, and
5. a request for an express abandonment.

### Strategic considerations

The following provides a summary of some relevant aspects and strategic considerations of the pilot program.

- ▶ Earlier reevaluation of rejections by outside Examiners.

The program requires the panel of the Pre-Appeal-Brief Conference program to

scrutinize an Examiner’s reasoning for maintaining the rejections. The Examiner therefore will be required to convince his or her peers that the rejections are proper. We believe that an Examiner taking arguably unreasonable positions in rejecting claims may reconsider those positions earlier in the prosecution process rather than having the rejections reevaluated by his or her peers.

- ▶ Written record.

The applicant’s Request and the panel’s decision become part of the official patent application record. To the extent an applicant advances other reasons for patentability beyond those already of record, those arguments potentially form an additional basis for prosecution

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history estoppel. We recommend that an applicant attempt to discuss those reasons in an Examiner Interview prior to the final rejection to minimize written statements from potentially expanding the patent application record.

- ▶ Panel will not review issues lacking factual basis.

Under the program, the panel does not review issues relating to, for example, interpretations of the prior art teachings or the claim scope. Rather the United States Patent and Trademark Office has taken the position that the Board of Patent Appeals and Inferences is the arbiter to decide these matters within the traditional appeal process and this program is not an alternative for filing to appeal. We expect that the panel will serve as a forum for reconsideration of clear errors or omissions in the rejections including, for example:

- ▶ a failure in the cited prior art references to disclose or suggest a claim limitation in an anticipation or obviousness rejection, respectively,
  - ▶ a failure to show proper motivation for making a modification in an obviousness rejection,
  - ▶ a failure to show proper motivation for combining multiple references in an obviousness rejection, and
  - ▶ an erroneous assertion that there is lack of written disclosure support (i.e., language requires little or no interpretation by an ordinarily skilled artisan).
- ▶ Composition of panel.

The panel will include: (1) the examiner of record, (2) a supervisory patent examiner, or "SPE," and (3) at least one other examiner having sufficient experience to be of assistance in considering of the merits of the Request.

- ▶ Timing.

An applicant can expect a decision from the panel within 45 days from the

request. Should an applicant wish to formally appeal the panel's decision, the time period for filing an appeal brief is the greater between either (1) one month from the mailing date of the decision, or (2) the balance of the two-month time period running from the receipt of the notice of appeal. To avoid fees for extending the deadline of filing an appeal brief, we recommend that the applicant be prepared to immediately commit resources to draft the appeal brief after learning the panel's decision to ensure timely appeal within the one-month window.

If you would like to learn more about the pilot program, please contact one of the attorneys listed at the front of this Alert. ■