An Overview of Petitions and Patent Appeals in the USPTO

William F. Smith[1]
Adam R. Stephenson[2]
Kevin W. Hawkes[3]

This paper presents an overview of petitions and appeals in the USPTO. Every practitioner who prosecutes patent applications before the Patent Corps needs to be able to identify petitionable issues and know how to efficiently and effectively make use of appeals to the Patent Trial and Appeal Board (PTAB) in order to obtain claims of appropriate scope in a manner that maximizes patent term.

Petitions

Upon examining a patent application, the examiner may reject the claims or make objections and/or requirements.[4] It is important to determine which of these actions by an examiner are subject to an appeal to the PTAB and which must be addressed by way of petition. A rule of thumb is that a rejection of claims is to be appealed to the PTAB while objections and procedural requirements are subject to petition. This may seem anomalous in that the statute that defines the Board's duties states in relevant part that the Board "shall, on written appeal of an applicant, review adverse decisions of examiners upon applications for patent."[5] However, the CCPA clarified that not:

> all 'decisions,' which are made by examiners in the course of examination of applications from time of receipt to final disposition by allowance or abandonment and which might be termed 'adverse,' are perforce reviewable by the board of appeals. Such has not been the case, either before or after the passage of the 1952 Patent Act. There are a host of various kinds of

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[1] William (Bill) F. Smith is a Patent Agent (retired from VA bar) with IPTechLaw in Scottsdale AZ. Prior to entering private practice, Bill served in the USPTO for 33 years, the last 19 ½ of which were as an Administrative Patent Judge at the what is now named the Patent Trial and Appeal Board. The views expressed herein are solely those of the author and not necessarily those of the firm, the firm's clients or colleagues. (E-mail, willam@iptech.law).

[2] Adam R. Stephenson is a partner of IPTechLaw. Founder of the firm he was co-founder of Anticipat, a patent data company that produced the first commercial database of *ex parte* appeal decisions now found in LexsNexis IP's PatentAdvisor® data solution. Adam has been involved in many patent appeals and petitions throughout his private practice. The views expressed herein are solely those of the author and not necessarily those of the firm, the firm's clients or colleagues (E-mail, adam@iptech.law).

[3] Kevin W. Hawkes is managing partner of IPTechLaw. Kevin has been involved in preparing for and pursuing numerous successful ex parte patent appeals and petitions throughout his private practice across numerous areas of technology. The views expressed herein are solely those of the author and not necessarily those of the firm, the firm's clients or colleagues (E-mail, kevin@iptech.law).

[4] 35 U.S.C. § 132(a).

[5] 35 U.S.C. § 6(b).

> decisions an examiner makes in the examination proceeding - mostly matters of a discretionary, procedural or non-substantive nature - which have not been and are not now appealable to the board or to this court when they are not directly connected with the merits of issues involving rejections of claims, but traditionally have been settled by petition to the Commissioner.[6]

Petitions are provided for in 37 CFR §§ 1.181, 182 and 183. Chapter 1000 of the *Manual of Patent Examination Procedure* (MPEP), "Matters Decided by Various U.S. Patent and Trademark Office Officials," provides detailed guidance as to the specific USPTO officials who decide what issues. As explained, a petition generally has five points:

- The petition must be in writing, 37 CFR § 1.2.
- The petition must contain a statement of facts involved, the point(s) to be reviewed and the action requested, 37 CFR 1.181(b).
- The petition must be accompanied by a fee, if required, in order to avoid the petition being summarily dismissed, 37 CFR 1.181(d).
- The petition must be timely filed, as required in 37 CFR 1.181(f), or as required in a specific statute or regulation.
- The petition must comply with any specific requirements as provided by statute, regulation or USPTO policy.

Common situations where a practitioner finds it necessary to file a petition to overturn an examiner's action include when an examiner makes a restriction requirement final or refuses to enter an amendment or an affidavit after a final rejection. Another situation that is subject to petition, not appeal, is when the examiner makes a premature final rejection or where the rejection fails to actually respond to one or more arguments presented in the response. Other petitions that may be needed involve petitions to overturn requirements to amend drawings and petitions to revive applications or patents from abandonment/expiration for non-payment of maintenance fees. A great more recently created resource that outlines various petition types, the appropriate rule for each, and the fee associated with 26 different petitions is found on the USPTO's website.[7] Historical data on just about every petition that can be filed at the USPTO over many years can be found in the database at www.petition.ai. We recommend you consult the website information carefully or use the database at petition.ai to identify a historical example of a granted petition of the type you are attempting as one of the more difficult matters is often

[6] *In re Hengehold*, 440 F.2d 1395, 1403 (CCPA 1971).
[7] See https://www.uspto.gov/patents/apply/petitions.

determining what the specific fee is for your particular petition type and what the relevant facts and argument are.

Appeals

I. Introduction

The Patent Corps contains 9086 Patent Examiners as of the end of the USPTO's Fiscal Year in October of 2025. In the past, the Office made great strides in reducing examiner turnover, which means that examiners today tend to more experienced on average than they were in the 2000s. However, during 2025, the Office first froze all hiring of Examiners for over half of 2025. While Examiners were not ever allowed to opt into voluntary separation agreements or subject to involuntary termination like federal employees within the USPTO itself and other agencies during 2025, those Examiners who had sufficient seniority were still allowed to retire, though no hiring took place until around September of 2025. For the better part of a decade, the Patent Examiner position was a remote first position where the Examiner was allowed to work for anywhere in the United States or out of the Alexandria or other satellite office. In 2025, while existing examiners were allowed to retain telework privileges so far, all new examiners hired now are required to work 5 days a week out of the Alexandria Office. One of the major changes the Office took was to formally terminate the collective bargaining agreement between the USPTO and the Patent Office Professionals Association (POPA), the main union that represented Examiners and other USPTO staff. That collective bargaining agreement had established telework first as the main way Examiners did their work.

The termination of the collective bargaining agreement removed the telework protections Examiner had by virtue of the agreement. While a mass call for Examiners to move within a certain distance of a USPTO office and to work in-office has not yet been issued, and the termination of the collective bargaining agreement is still being litigated, it is conceivable that this call could come in the next few years. The termination of the collective bargaining agreement now meant that Office management no longer had to negotiated with POPA on changes to the Examiner production requirements, ending a decades-long relationship where Examiners were represented by the union in matters related to setting examining hours, the count system, and the amount of production required to meet minimum standards. Management has already taken advantage of this by upping

the required examining production for all examiners to avoid being placed on a performance improvement plan to 100% production every biweek. Other time for training and reviews of examiner work product was reduced or eliminated for Supervisory Patent Examiners and others. Also, the way Examiners now receive credit for interviews changed to become more restrictive in ways that will be discussed later in this paper.

The authors' experience is that if your client's case has difficult legal and/or technical issues it is likely that the case will end up at the PTAB regardless of the experience level of your examiner. Indeed, the more senior examiners can often be the most difficult to work with as their personal preferences can conflict with the client's goals and needs in various cases. The biggest factor seems to be how your examiner chooses to use the procedural tools available to them to do their job and obtain the workflow credit they are required to meet production. The increase in required production to meet expectations further heightens the need for examiners to maximize workflow from each case and to move cases every biweek. Because the USPTO as an organization is highly focused on production goals, for more than a few examiners, the decisions made on cases make the most sense when viewed by much credit they can get from the case rather than the specific technical or legal merits. Thus, for a patent practitioner to successfully win claims of appropriate scope to protect the client's technology, create an administrative record before the USPTO that contains minimal estoppels, and maximize patent term, it falls on the practitioner to take charge of the case and carefully guide it through the examination process. Effective use of an appeal to the PTAB can aid this effort. The rules of practice in effect today were finalized in November 2011 and came into effect on January 23, 2012.[8] What follows is an effort to highlight key stages of the appeal process and provide practice tips so that the practitioner will be able to more confidently navigate the appeals process in the USPTO.

II. Pre-Appeal Evaluation

Every applicant for a patent whose claims have been twice rejected is eligible for an appeal to the PTAB.[9] However, not every patent application eligible for an appeal under the statute and rules is necessarily ready for an appeal. To determine whether an appeal to

[8] "Rules of Practice Before the Board of Patent Appeals and Interferences in *Ex Parte* Appeals" 76 Fed.Reg. 72270 (November 22, 2012).

[9] 35 U.S.C. § 134(a); 37 CFR § 41.31(a). Appeals can be filed in continuation applications after a first action provided the claims presented were rejected at least once in the parent case.

the PTAB is the best route to follow, a number of factors need to be evaluated. Two of the guiding principles of the appeal rules are that appeals before the PTAB must focus on the claims, not the disclosed invention, and the record at the time the Appeal Brief is filed should be finalized. Thus, the claims and the record must be thoroughly reviewed in making a decision whether an appeal should be pursued.

Since the claims have been twice rejected, it is apparent the examiner is of a mind that the pending claims are not patentable on the existing record. However, it is easy during prosecution to lock in on the examiner's rejection(s) and lose sight of the state of the overall record including the scope of the claims. Thus, in seeking review of an adverse decision, the first step should be a thorough review of the existing claims and come to an understanding how they will be construed under the legal standard appropriate for claims pending before the USPTO. As set forth in *In re Morris*:[10]

> Some cases state the standard as 'the broadest reasonable interpretation.' … others include the qualifier 'consistent with the specification' or similar language …. Since it would be unreasonable for the PTO to ignore any interpretive guidance afforded by the applicant's written description, either phrasing connotes the same notion: as 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.

For those who are more accustomed to litigating patent claims in the federal courts instead of pursuing them before the USPTO, it may come as a surprise how broadly a claim will be read by a patent examiner and/or a PTAB merits panel. Since a significant number of patent applications contain rejections where the examiner has not construed any of the claims in detail, it behooves the practitioner to take a step back and determine just how broad the claims are under this standard. Pay attention to each independent claim. As explained *infra*, the PTAB merits panel will consider, at the least, each independent claim. Once a Notice of Appeal has been filed, your opportunity to amend the claims is limited.

If it is determined that the claims are of the correct scope, a review of the record should be undertaken to ensure that all evidence to be relied upon in the appeal has been properly entered and considered by the examiner. The opportunity to present additional

[10] *In re Morris*, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).

evidence once the Notice of Appeal has been filed is also limited. Make sure that any evidence to be relied upon in the Appeal Brief has been entered by the examiner as you must point to where in the record the examiner entered the evidence in the Appeal Brief. Silence on the part of the examiner does not mean the evidence has been entered. Consideration of the entered evidence by the examiner must also be apparent on the record. If evidence is acknowledged by the examiner but not discussed in any meaningful way, applicant should insist by way of response to such an Office action or by requesting review of the matter by a supervisor or other manager that the examiner set forth on the record a reasoned explanation why the evidence is not persuasive. Cases forwarded to the PTAB where the examiner is silent in regard to record evidence will, in most cases, result in a remand for the examiner to consider the evidence with the accompanying delay in the merits decision.

If the claims and the record are in a condition where applicant believes an appeal would be appropriate, the next factor to be considered is what the Examiner prosecution data indicates regarding the type of Examiner you are dealing with and whether negotiating with an appeal would be particularly helpful with your Examiner.

The foregoing discussion and Figures 1 and 2 and the end of this document are designed to provide detailed information on the appeals process overall. The first principle of effective *ex parte* appeals is fully understanding the ramifications and options available at each step in the process as previously discussed. The second step is then to pick the right battle. The right battle involves appealing the right issue with the right Examiner and have the case as ready as it can be made for the Board's inspection. The author William Smith recommends to "appeal early and often." But how does the practitioner know when and from what type of Examiner to appeal?.

At the outset, the authors' experience using Examiner level patent prosecution data coupled with PTAB decision data organized at the Examiner level and by issue has demonstrated that only using the data was it possible to recognize the right battle at the right time. Otherwise, the temptation was too strong to "interview and RCE." Often, it is not until a Board decision issues in a case that the applicant really has the opportunity to understand what the issues actually are in a case because the Examiner may simply be unable or unwilling to adequately frame them. Furthermore, until a Board decision has issued, even if it includes an affirmance, there is no "law of the case" that the appellant

can subsequently use with the Examiner to establish ground rules for what various claim terms mean and what various references actually teach and do not teach. Accordingly, the authors' experience with appealing early and often is that an appeal represents the most rapid way to get a case down to the "brass tacks" and challenge the Examiner to put their best case forward.

The question posed to the authors many times by various clients has been "Is there any way to get a different Examiner?" To the client, this question comes up when it is apparent that the Examiner may be more interested in getting workflow credit from the client's case than advancing its prosecution. A broad spectrum of behaviors exists, but those Examiners who are seeking to use cases for their personal benefit tend to hold out for RCEs and refuse to make commitments in interview situations. The authors have found that, particularly with dealing with primary Examiners, an appeal is an effective way to advance a case when filed right at the first final action if the art permits. Primary Examiners have wide latitude in the decisions that they make in their cases and do not necessarily have to follow supervisor recommendations. Accordingly, bringing a primary Examiner into a pre-appeal or appeal brief conference is the first time where other decision makers can officially weigh in and helps build what is called normative leverage in the patent prosecution negotiation. In other words, the appeals process becomes a way of "changing" your Examiner because now the Examiner handling your case is in the minority and has to agree to a jointly negotiated decision. Primary Examiners who have their own pet approaches to examination can be neutralized by bringing their arguments in front of supervisory Patent Examiners and quality assurance specialists who can have a normalizing effect.

In the author Adam Stephenson's experience, there is value in simply negotiating using an appeal with any Examiner where that Examiner's interview statistics indicate that less than 60% of the time the Examiner allows following an interview. For such an Examiner, interviewing the case is also not be advised in this situation either. The interviewing rules at the USPTO have changed in 2025 so that an Examiner is only automatically given an additional hour of examining time for a case for the first interview on that case. Presently, to get any more examining time for any subsequent interviews, the Examiner has to get supervisor approval, which reversed the earlier policy to simply automatically grant time for every interview. Thus, practitioners should carefully

consider whether they should take advantage of their one "free" interview with the Examiner. Similar to the RCE process, where the government fee is lower for the first RCE filed, using up the first interview on a case after the first action may not be the wisest course, as Examiners are not required to grant interview requests when a case has been finally rejected. The authors anticipate that we will see various examiners begin to refuse second interviews at final due to the overhead of trying to get their supervisor to approve the time to conduct them. Thus policies of interviewing every case at first action may have the effect of limiting Examiner engagement in situations where the interview may have greater value.

The author has found that the 60% allowance rate after interview has historically correlated with and identifies Examiners who refuse to agree to anything in an interview, do not engage in an interview, are unprepared for an interview, or for whom interviewing simply can make the situation much worse because they emotionally/psychologically cannot admit an error in person. For these types, the author has found that written advocacy is better and most effectively conducted to a broader audience than just the Examiner themselves. In other words, filing an RCE with an Examiner who will not make an agreement in an interview setting is much less likely to prove successful because the RCE is simply asking the same Examiner to change their mind in writing when they would not change their mind in an interview. Changing the nature of the negotiation and shifting the audience by bringing the case into a pre-appeal brief conference or an appeal conference is a more effective way of helping to reduce the issues to be decided by the Board or deal with Examiner-specific idiosyncrasies.

While any Examiner can be taken up on appeal, appeals are particularly helpful and advised when the Examiner handling your case can be identified using their examining data as being one for whom written, rather than oral, advocacy is advised. The next step is to decide is whether to take advantage of a pre-appeal review. Currently there are two avenues to do so. The first is to ask for a Pre-Appeal Brief Conference.[11] Some of the pros and cons of the Pre-Appeal process are:

Pros

- Two conferees review case with examiner

[11] See MPEP 1204.02 and http://www.uspto.gov/web/offices/com/sol/og/2005/week28/patbref.htm for the procedures to be followed for this option.

Cons

- No specific feedback as to why arguments were not persuasive is possible with the Advisory Action form received.
- Five page limit may hamper ability to effectively argue multiple rejections
- Some examiners respond better to pre-appeal brief requests for review than others, so use of pre-appeal briefs is best done in a targeted manner by reviewing the appeals data for examiner and using pre-appeals where the examiner is statistically more likely to allow or reopening prosecution at a higher rate at pre-appeal than at the appeal brief stage.

According to the PTO's announcement for the Pre-Appeal Brief Conference pilot program, the program is designed for cases where it is believed that the examiner has committed clear factual error. Thus, the best cases to be put into this program are those where it is believed the examiner has not accounted for all claim features in making a rejection or has clearly misread a reference in applying the reference to the claimed features. Various commercial examiner data sets also indicate that, for certain examiners, a Pre-Appeal Conference can be more effective than an appeal brief, particularly for examiners whose statistics show they let few of their appealed cases actually get decided by the Board. For such examiners, leading with a Pre-Appeal Brief and Conference tailors your approach to a negotiation the examiner's data indicates they respond most favorably to.

Be aware that if the examiner has relied upon a document that is in a language other than English, the examiner is required to obtain a full text translation of the document prior to the case being forwarded to the PTAB.[12] There is little reason for the examiner and counsel to wait until after the Notice of Appeal is filed to obtain a translation since patentability determinations are fact intensive. The client's interests are best served when the most relevant facts are made of record as early in the examination process as possible so the examiner and counsel can review them and respond in an appropriate manner. A complete translation of any document that you or the examiner relies upon should be obtained as soon as practicable so the relevant facts are of record. The same considerations apply to abstracts of a document being relied upon as evidence by either the examiner or

[12] *Manual of Patent Examining Procedure* (MPEP) 1207.02.

counsel. Obtain the full text document as early as practicable and consider it fully. Consideration of a translated and/or full text document rarely leaves the case in the same posture as it was when only an abstract or partial translation of the document is considered. Most times, the full text or fully translated document makes the examiner's case significantly stronger or weaker. Failing to fully comprehend the facts early in prosecution leads to situations where, had the more complete set of facts had been considered earlier in the case, an appeal would most likely not have been needed.

Another factor to consider is whether the additional delay in the briefing period of the appeal caused by requesting a Pre-Appeal Conference (assuming the case goes to the Board) is advisable in view of the timeliness of receiving a PTAB decision. Since the clock does not start for the Board until a case has been fully briefed and docketed, increasing the time spent briefing the case by requesting a Pre-Appeal Conference does not necessarily count toward additional patent term adjustment. Currently the Board's time to issue a written decision on a case ranges 10-16.2 months depending on Technology Center[13] with an average duration of 13.7 months following docketing of the appeal. Thus, you should carefully consider the briefing delays caused by each part of the briefing process including the Pre-Appeal Conference process. Even if your case is reopened after the pre-appeal conference or the Advisory Action indicates the conference is sending the case to the Board, you will have moved the case forward because of the conferees' input to the Examiner.

A new threat to appeal pendency is the introduction of the continuing application fee and the increase in RCE fees that occurred in January of 2025. Author Adam Stephenson believes that, for many clients of all sizes, the continuing application fee will lead to the filing of more appeals, particularly late in a patent family's lifespan which will result in increased appeal intakes over the next couple of years. If staffing levels are not increased at the Board to compensate during this same period, appeal inventory will continue to rise as will pendency. The effects of this will be gradually felt, however, but in

III. Appeal Brief

Prior to drafting the Appeal Brief, the detailed provisions of 37 CFR § 41.37 should

[13] See Jan 2025 PTAB published pendency statistics by Technology Center available at https://www.uspto.gov/patents/ptab/statistics.

be reviewed to avoid the need to file a supplemental or substitute Appeal Brief with the accompanying delay. Because of the efforts by the PTO to modify the rules, make sure you are aware of the version of the rules that is in effect.

There are two sections of the Appeal Brief that are key in setting forth a convincing position, *i.e.,* Summary of claimed subject matter[14] and the Argument section.[15]

A. Summary of claimed subject matter (37 CFR §41.37(c)(iii)

As set forth in *In re Hiniker Co.*[16], "[t]he invention disclosed in Hiniker's written description may be outstanding in its field, but the name of the game is the claim." One of the guiding principles in the *ex parte* appeals rules is to focus the appeal on the specific language of the claims. In the past, many appeals were briefed without either the examiner or counsel discussing the merits of any individual claim. Rather, the briefing was focused on an "invention." This approach, however, does not work with Board panels today whose focus is on precisely what the claims say when construed as broadly as reasonably possible.

The formal requirements of the "Summary of claimed subject matter" section are that a concise summary for each independent claim involved in the appeal referring to the specification and drawings is to be provided. A set of claim chart tables with the elements of the independent claims and citations to the appropriate figures and paragraphs in the specification normally suffices. A similar analysis is for each independent claim and dependent claim argued separately if the claims contain a limitation appellant or the examiner regards as a means or step plus function under 35 U.S.C. § 112(f). Note that this section of the rules puts the burden on appellant to identify such limitations. Presumably, any limitation not identified in this section as a § 112(f), the limitation will be construed under the broadest reasonable interpretation standard.

You should be able to point to where the words and phrases used in the claims appear in the specification. In other words, there should be no "mystery" words in the claims.[17] Whenever claims are amended to contain language that does not appear explicitly in the original disclosure, an appropriate amendment to the specification should be made

[14] 37 CFR § 41.37(c)(1)(iii) and MPEP 1205.
[15] 37 CFR § 41.37(c)(1)(iv) and MPEP 1205.
[16] *In re Hiniker Co*., 47 USPQ2d 1523, 1529 (Fed. Cir. 1998).
[17] 37 CFR § 1.75 (d)(1) ("The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. (See § 1.58(a)).").

concurrently (if needed) and an explanation provided setting forth how the original disclosure provides written descriptive support for the amendatory language. Adherence to this rule can avoid a substantial number of issues in regard to getting new grounds of rejection on the basis of new matter or lack of written description.

B. Separate arguments of claims (37 CFR § 41.37(c)(iv))

The Argument section of the Appeal Brief should not be a copy and paste from a previous response. The arguments previously presented to the examiner have not been convincing so now that you have a wider audience with the conferees and ultimately the PTAB merits panel, your arguments should be refined and expanded as needed. There is no page or word limit for the Appeal Brief. In-line drawings and annotated figures are greatly appreciated by Board panels. The arguments should be presented with separate headings identifying on a claim-by-claim basis as the most convincing arguments are made in regard to individual claims. Failure in the argument heading to identify all of the claims being argued under that heading will be noted by the Board panel as a violation of the rules. However, merely pointing out what a claim recites is not a proper argument—it does nothing to explain why the examiner's rejection of that claim is error.[18] It is also suggested that arguments should not be made based upon a group of claims even though permitted by the rule. Argue the merits of each individual claim. Claims argued together stand and fall together; claims argued separately stand and fall on their own merits. Also remember that only arguments presented in the argument section of the Appeal Brief will be considered by the Board panel.[19]

The rules require specific headings by ground of rejection made be present in the argument section.[20] However, do not limit yourself to those headings. For example, if your position in regard to a 35 U.S.C. § 103(a) rejection is the examiner has failed to establish a *prima facie* case of obviousness, there is no reason, suggestion or motivation to combine the references and/or there is evidence of unexpected results, use separate headings for each part of your argument to highlight each part of your position. Appropriate use of headings gives the reader a heads up as to the theory of your case as the Appeal Brief is being reviewed and guides the reviewees' thinking.

At the least, each independent claim on appeal should be separately argued as the

[18] 37 CFR § 41.37(c)(1)(iv).
[19] *Id.*
[20] *Id.*

merits panel will review each of them. If independent claims are lumped into a group, the merits panel will pick the claim that is perceived to be most vulnerable to the examiner's rejection(s) and begin the analysis there. If the rejection of that claim can be affirmed, the rejection of all of the remaining claims of the entire group of claims argued will also be affirmed, regardless of their individual patentability. In contrast, if the rejection of the chosen independent claim is reversed, the merits panel will review all independent claims in the group to assure that the reasons for reversing the rejection are applicable to each independent claim.

A previous proposed rule revision for appeals provided that "[a]ny finding made or conclusion reached by the examiner that is not challenged will be presumed to be correct." What this meant is that any finding or conclusion by the examiner that you believe to be incorrect needs to be challenged lest the PTAB attach particular significance to it and use it as a basis for affirming a rejection. A number of APJs have adopted an "error" standard of review in *ex parte* appeals. Under this standard, the APJ assumes that examiner's rejection is correct and, thus, they only review the case to the extent where the Appellant urges error on the part of the examiner in the Appeal Brief. While this proposed rule was subsequently withdrawn, it behooves the practitioner to couch arguments in the Appeal Brief in terms of examiner "error."

Avoid chain citations of authority. Citation of one case that is on point is more convincing than a copy and paste of serial cases in support of the same point. Also, do not rely upon the *Manual of Patent Examining Procedure* (MPEP) exclusively as authority on merits issues. Rely upon the statute and legal precedent. The MPEP is more helpful as to procedural issues. The only exception to this is where the MPEP contains the official statements of Office policy on a legal issue that both the Board and the Examiners are to follow. Currently, this is the case for statutory subject matter rejections under 35 U.S.C. 101 where the USPTO has chosen to summarize its current examining policy and process based on court decisions in the MPEP itself.

Careful argument of individual claims can maximize patent term. In most cases it is helpful to separately argue a dependent claim that seems to be a sure winner. Patent term will be adjusted if "appellate review by the Patent Trial and Appeal Board 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…."[21] This means that succeeding with a reversal for just one claim in the application in an affirmed-in-part Board decision yields PTA. Also know that certain remands from the PTAB may result in patent term adjustment.[22]

IV. Examiner's Answer

The Examiner's Answer is provided by 37 CFR § 41.39 and detailed guidance is set forth in the MPEP.[23] Upon receipt, the Examiner's Answer should be first reviewed to ensure it complies with the administrative guidance set forth in the MPEP. Then the Answer should be reviewed on the merits. In reviewing the Answer, pay special attention to:

- The claims to be reviewed. Make sure that the examiner has accounted for all the claims on appeal and that any changes to the claims subject to a given rejection make sense.
- Whether the examiner agrees that a correct copy of the claims on appeal is present.
- Whether the examiner is in agreement with the rejections to be reviewed. If a rejection is not repeated in the Answer it may be taken by the merits panel as withdrawn or it may be considered by the merits panel.[24]
- Whether the examiner has relied upon new evidence, either in the statement of the rejection or in responding to arguments.[25] If the examiner has relied upon additional evidence in the Answer, your response can take many forms. If you have a ready response on the existing record, make an objection to the new evidence in a Reply Brief and provide your substantive argument. If a proper response requires that you rely upon additional claim amendments or evidence, you should petition[26] as the Examiner's Answer is improper and request reopening of prosecution at this point.

Another point to be aware of, especially if the case involves cutting edge legal issues such as written description in biotechnology cases or patent eligible subject matter in computer implemented inventions or business method cases, is that:

> If an examiner's answer is believed to contain a new interpretation or application of the existing patent law, the examiner's answer, application file, and an explanatory memorandum should be forwarded to the TC Director for consideration. See MPEP § 1003. If approved by the TC Director, the examiner's

[21] 35 U.S.C. § 154(b)(1)(C)(iii).
[22] 37 CFR § 1.702(e).
[23] MPEP 1207 *et seq.*
[24] MPEP 1207.02.
[25] *In re Hoch*, 428 F.2d 1341, 1342, n. 3 (CCPA 1970)("Where a reference is relied on to support a rejection, whether or not in a 'minor capacity,' there would appear to be no excuse for not positively including the reference in the statement of the rejection.").
[26] *See* 37 CFR § 1.181.

> answer should be forwarded to the Office of the Deputy Commissioner for Patent Examination Policy for final approval.[27]

It is suggested that this issue be raised at the first instance you believe the examiner is forging new legal ground and not wait for the Answer. If an examiner states that a position is art unit or technical center "policy," check with the Technical Center Director and or the Office of the Deputy Commissioner for Patent Examination Policy to confirm that this is the case and obtain a written statement of the "policy."

Note also that an examiner must use the headings set forth in the Argument section of the Appeal Brief in responding to those arguments.[28] Thus, there should be a one to one correspondence between the arguments in the Appeal Brief and the Response to Argument section of the Answer.

V. Reply Brief

A Reply Brief should focus on merits issues. While you may want to note procedural anomalies in a preface of a Reply Brief, issues such as whether a new ground of rejection was made or admissibility of evidence or amendments can only be resolved by way of petition.[29] If it is believed that an Examiner's Answer is improper, e.g., the examiner did not respond to each argument set forth in the Appeal Brief, relief is also by way of petition. In other words, counsel has to be insistent that proper procedure is followed by the examiner by way of administrative remedies as the PTAB will base its decision on the merits and the record allowed by the Appellant to go to the Board. By insisting the examiner follow proper procedure, cases will not be returned or remanded with the attendant loss of time and possible loss of patent term.

Do not let any shift in the examiner's position as set forth in the Office action from which the appeal is taken and the position taken by the examiner in the Examiner's Answer go unchallenged. If a shift in position can be responded to adequately on the existing record, do so in the Reply Brief. The Federal Circuit is clear that if the Appellant chooses to respond to a newly presented argument in the Answer in the Reply Brief, instead of petition, the Board must consider the responsive arguments.[30] If it is not possible to fully address

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[27] MPEP 1207.02.
[28] *Id.*
[29] 37 CFR § 41.40.
[30] *In re Durance*, 891 F.3d 991, 1002 (Fed Cir. 2018) "The Patent Office contends that Durance should have petitioned to have the examiner's answer designated as a new ground of rejection, relying on the Patent Office's Manual of Patent Examination Procedure (" MPEP") § 1207.03. But this Court does not read MPEP § 1207.03 or 37 C.F.R. § 41.41 to put such a burden on applicants. Neither contemplates that the applicant has

the newly presented argument in the Reply, file a petition that a new ground of rejection has been improperly made by the examiner stating that additional amendment and/or evidence is needed for a proper response. Under current rules, the time for filing a reply brief is tolled pending decision of the petition.[31]

VI. Pre-decision procedure

Prior to the image file wrapper (IFW), the paper administrative file was physically moved to the PTAB two months after an Examiner's Answer was entered and no Reply Brief was filed or shortly after a Reply Brief was acknowledged by the examiner. The arrival of the case was the PTAB's notice that it was ready for decision. Now, in the IFW age, an electronic message is sent to the PTAB to announce the case is ready for a decision on appeal. Keep track of your case Patent Center. If you have not received a Docket Notice or notice that the appeal is being returned to the examiner for procedural problems from the PTAB within a week or so after the briefing is completed, contact the examiner and request that the case be electronically forwarded to the PTAB for decision.

VII. Oral hearing

Oral argument can be helpful in winning a favorable ruling. However, argument presented by counsel who are not adequately prepared can have adverse circumstances such as snatching defeat from the jaws of victory. Thus, make sure you have a very good reason for requesting a hearing. If your case has cutting edge legal issues or complex facts, a hearing should be helpful. If the only rejection is under 35 U.S.C. § 103(a) and your argument is no reason, suggestion or motivation, a hearing may not improve your chances of winning a reversal and may delay a decision compared to submitting the case on the briefs. In such cases, please recognize that oral arguments are relatively rare in that data collected by the Author a few years ago indicated that only about 3% of *ex parte* appeals involved oral argument.

Understand that oral arguments are routinely recorded and transcribed with a copy of the transcript made of record. The rules require that counsel prepare a list of technical terms and unusual words to be provided to the transcriptionist. Since the hearing is

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to petition to have a new argument in an answer designated as a new ground of rejection before it can respond to the new argument. Rather, § 41.41 states that a showing of good cause is only required if the argument is not responsive to an argument raised by the examiner. Here, Durance's reply brief was responsive to the examiner's answer and included citations indicating the new arguments to which Durance was responding…It was error for the Board to find such argument waived."

[31] *Id.*

transcribed, answer hypothetical questions carefully.

At the hearing, you are limited to a twenty minute presentation unless more time is requested beforehand. Most merits panels are lenient with the time and understand that questions eat into counsel's time. If the day's calendar is not busy and the argument is viewed as constructive, it is likely more time will be allotted. The USPTO's LEAP program can be used to bring in a less experienced practitioner to do the argument, at which point additional arguing time will be provided[32].

Arguments presented at the hearing are limited to those made in the briefing.[33] It is your 20 minutes and most panels will let you use it as you like but do not confuse a panel politely listening to a new argument with any thought that it will be considered when that panel reaches their decision.

Avoid using computer presentations during the hearing. Your time is limited and experience shows that they are generally a distraction and time is wasted trying to set up and operate equipment. If you want the panel to focus on claim language or disclosure in a reference, make copies of the passages for each panel member and offer it up to the bench prior to beginning your argument. In doing so, make the representation that the proffered material is of record and has been before the examiner. A concise briefing package works better than a computer presentation. Keep in mind that most of the time one or more members of the panel may be appearing via video conference to the specific hearing room to which you are assigned, so bringing paper into the room may not allow you to reach each member of the panel. In 2025, the ability for you and your client to appear by video conferencing was ended, which means in-person oral argument at a USPTO office is now mandated.

Also be aware that members of the PTAB may have visual impairments, e.g., color blindness, so any demonstratives or demonstrations should be clear and readable from a distance and not rely on specific coloration to establish vital points. Always ask if the presentation can be seen by all panel members. Also, speak with sufficient volume to be heard.

Be prepared to be interrupted with questions. The majority of questions will concern claim scope and prior art, whether relied upon by the examiner or not. You should

[32] Additional information on the LEAP program can be found here: https://www.uspto.gov/patents/ptab/leap.

[33] 37 CFR § 41.47(e)(1).

be prepared to discuss the entire record. Do not get locked in to the examiner's specific position to the exclusion of the record in preparing for the hearing. It can happen that a merits panel finds when the claims are considered in an individual manner and properly construed, a reference of record not relied upon by the examiner is seen to be more relevant in determining the patentability of a claim than the references applied by the examiner. A counsel prepared to discuss the entire record may be able to dispel a panel member's concerns and avoid a new ground of rejection under 37 CFR § 41.50(b).

Also be aware that the panel members may ask you about potential arguments not included in the Examiner's final rejection, the Answer, or your briefs. Understand that the panel is free to enter a new ground of rejection on the basis of your answers to these questions. So, before answering such questions, be sure to preface the answer with, "Your honor, that question raises an issue that is not before the Board in this appeal. However, I will answer it as follows…." The goal here is to attempt to keep the panelists focused on the question of whether the Examiner committed error in the appeal from rejection rather than the question of whether the cited art could render the claims obvious, etc. over some new theory.

Do not try to guess the outcome of the case from the questions asked by the panel. Most questions are asked to test the strength of the examiner's position and the weakness of your position. Do not deny the undeniable. Credibility counts.

Careful thought should be given to whether an applicant or representative of the assignee should attend the hearing. Some of the pros and cons are:

Pros

- Can explain complex technology
- Provide helpful background information

Cons

- May be too emotionally involved
- May make statements that can be construed as admissions
- Exposes counsel to panel questions that specifically are seeking admissions for use in their decision.

VIII. Post-decision practice

If the merits panel decision reverses all of the rejections—congratulations!

However, this does not 100% guarantee the Examiner will issue a notice of allowance. While this happens almost as a matter of course in most situations, the examiner's supervisor can take the adverse decision to the Technology Center Director who can then give permission to reopen prosecution instead. Since the Appellant is given no information that this is taking place until after the time for appeal of the reversal has run, there is no procedural tool available to prevent this from happening. If this occurs, be prepared to take a second trip to the Board to address any new art/arguments if the rejections do not improve.

If rejections are affirmed, make sure that all separately argued claims were considered and that all rejections submitted for review were considered. Also see that all arguments were considered. In the situation where your case was affirmed-in-part and where at least one independent claim is indicated as patentable (or remains patentable if not actually the subject of the appeal), filing a request for continued examination (RCE) is seldom the right response due to the corresponding loss of PTA. In affirmed-in-part situations like these, the Examiner should cancel the affirmed claims and issue a notice of allowance for the independent claim(s) that remain (or ask you to provide a draft amendment that does this). Filing an RCE to take the allowed claims in this situation actually surrenders the patent term adjustment that would otherwise be applied to your case because you prevailed on at least one claim (assuming at least one remaining claim was the subject of the appeal).

It is important that you compare the facts and reasons used by a merits panel in affirming an examiner's rejection to those the examiner relied upon in stating the rejection in the Answer. It may be that the merits panel made a new ground of rejection without designating it as such. A good test to determine whether that happened is to see if you had a fair opportunity to react to the thrust of the rejection in your briefing.[34]

In the absence of a designated new ground of rejection under 37 CFR § 41.50(b), you are limited in most circumstances to a single request for rehearing.[35] If you believe a new ground of rejection has been made by the merits panel, make your case in the opening portion of the request and subsequently make your merits arguments as this may be your only opportunity to do so.

[34] *In re Kronig,* 539 F.2d 1300 (CCPA 1976).
[35] 37 CFR § 41.52.

In any request for rehearing, state your arguments with particularity. Explicitly point out what facts, arguments and/or points of law were misunderstood or overlooked. This is another area where appropriate headings serve to focus the reader and make your position clearer.

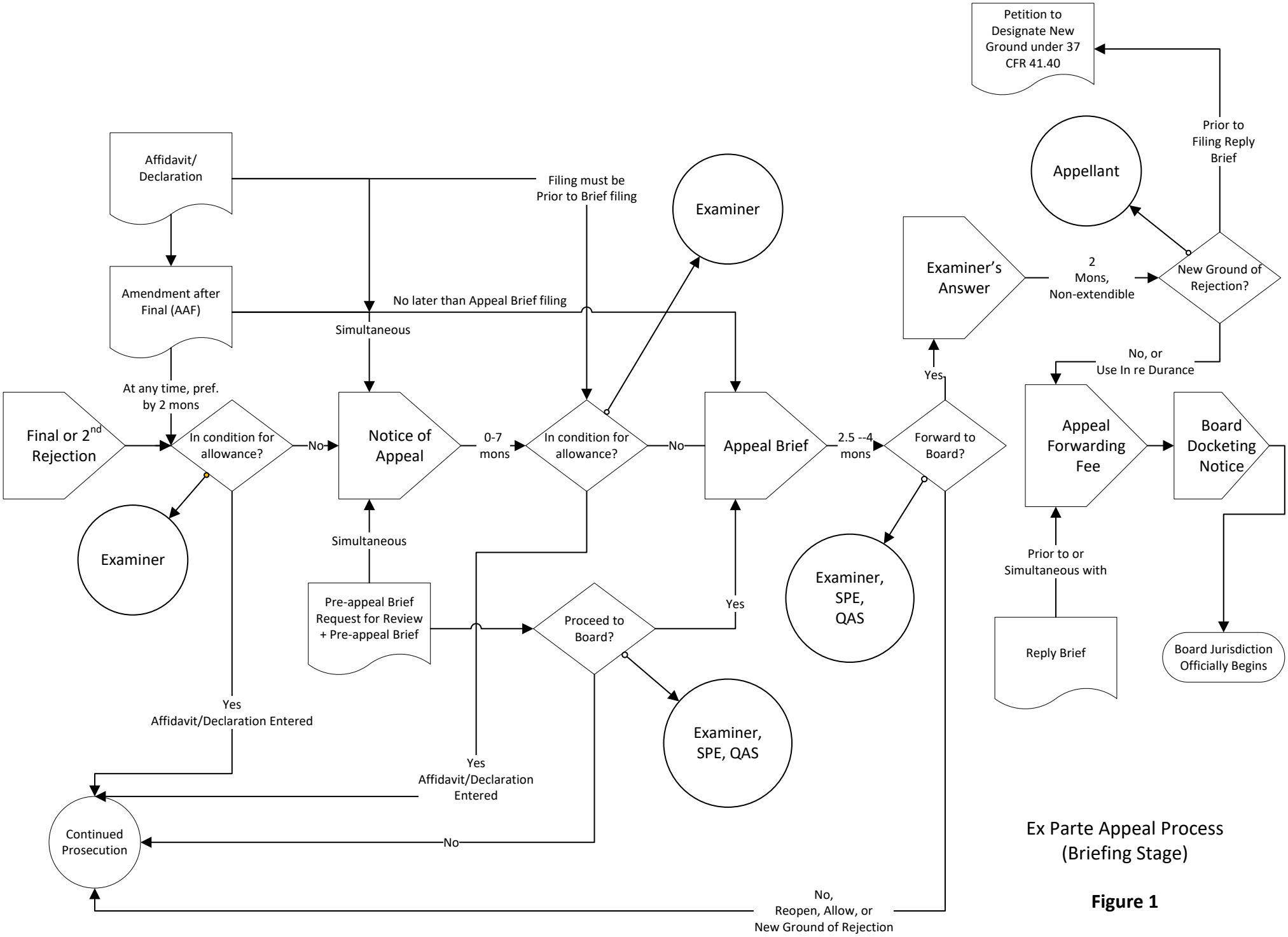
Understand that if a new ground of rejection is made under 37 CFR § 41.50(b), you must elect to either reopen prosecution in front of the examiner or request rehearing before the PTAB on the same record. For a new ground of rejection, the only route for review by the Federal Circuit is filing a request for hearing FIRST—there is no automatic direct right of appeal until the request for rehearing has been filed and decided. If the new ground of rejection results in a rejection of all claims on appeal, you MUST take action or the appeal will be dismissed and you will have to petition to revive the application and file an RCE. You cannot have two bites of the apple, *i.e.,* request rehearing from the PTAB and, if unsuccessful, reopen prosecution before the examiner. Also be aware that if the PTAB makes a new ground of rejection under 37 CFR § 41.50(b), the examiner is without authority to overturn that rejection without an amendment and/or evidence not previously of record being submitted.

IX. Summary

In order to successfully navigate the *ex parte* appeals process you must have an understanding of the rules, your Examiner, and be a forceful advocate for your client. But as importantly you must have an accurate understanding of the breadth of the claims subject to the appeal. While you and the examiner may have been content to discuss patentability issues prior to the Appeal Brief on the basis of an "invention" instead of the individual claims, the appeal will be decided on a claim-by-claim basis on the actual language of the claims that are individually argued or on the basis of a claim representative of a group of claims argued together. With respect to advocacy before the PTAB, the Federal Circuit was right on point when it stated "[a]nalysis begins with a key legal question--<u>what</u> is the invention <u>claimed</u>?...Claim interpretation...will normally control the remainder of the decisional process."[36] Keep your eye on the claims and you will increase your chances of having a successful outcome at the PTAB. Always remember, however, that the patent prosecution strategy of "appealing early and often" is often actually more about effectively <u>negotiating</u> with more difficult examiners than it is about persuading the Board in the end.

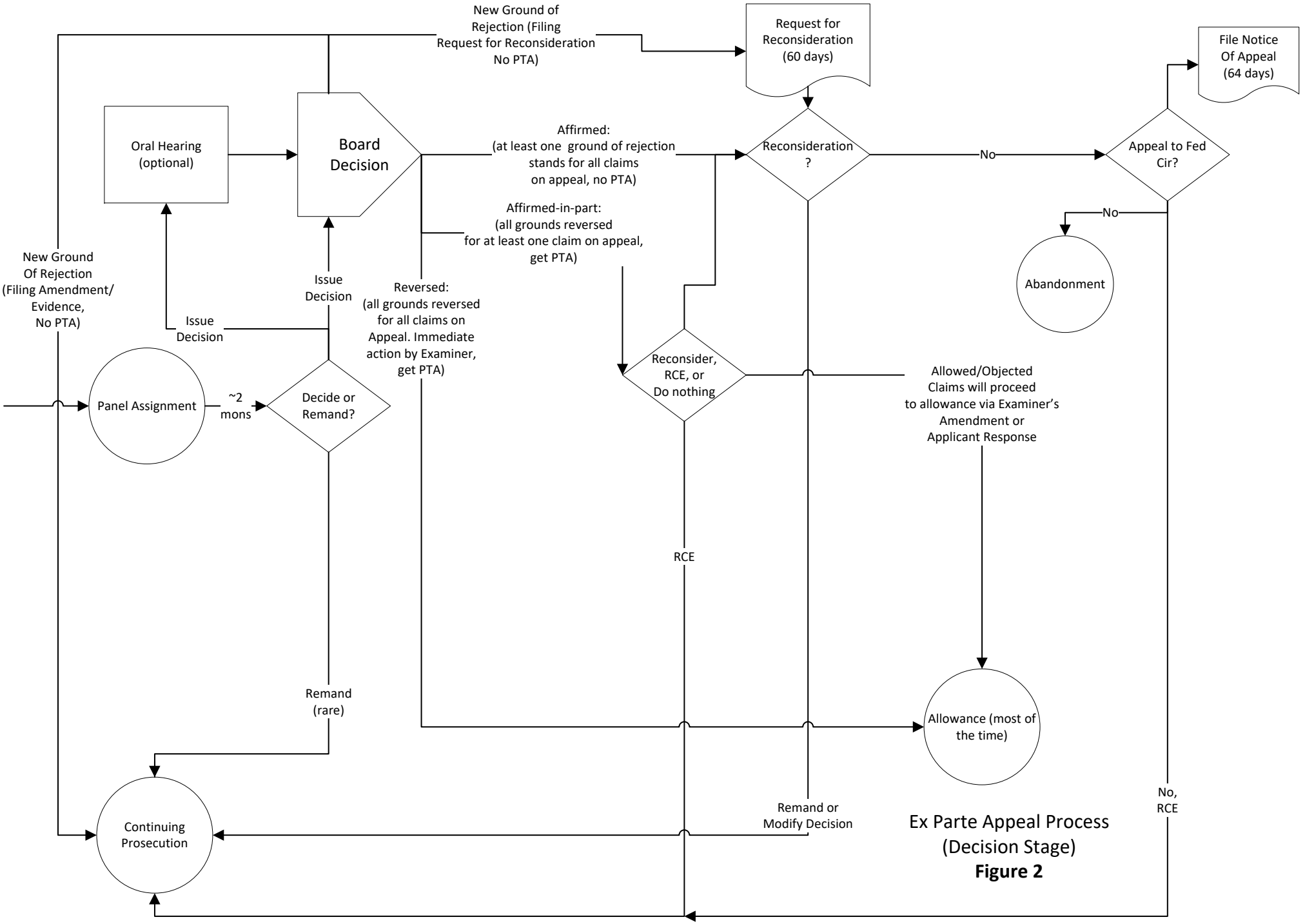
[36] *Panduit Corp. v. Dennison Manufacturing Co.*, 810 F.2d 1561, 1568 (Fed. Cir. 1987).

This conclusion is supported by USPTO data presented in 2024 during PTAB road shows indicated that only about 30% of cases in which a notice of appeal has been filed actually result in a Board decision. Pursuing appeals before the right examiners on a properly prepared record can lead to re-openings of prosecution without RCEs and allowances with less prosecution cost and shorter claims with fewer amendments that can create prosecution history in later proceedings.



Ex Parte Appeal Process
(Briefing Stage)

Figure 1



Ex Parte Appeal Process
(Decision Stage)
Figure 2