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From the Experts: To Appeal or Not to Appeal, That is the Question

How and When Should You Appeal Patent Examiner Decisions?

A former patent examiner shares strategies for appealing patent examiner decisions. When handed an adverse patent application decision, the cost, time, and likelihood of success become the basic considerations for deciding whether to appeal the examiner's decision. Given there are already 20,000 undecided appeals hanging in limbo with the U.S. Patent and Trademark Office, the decision to appeal must be made strategically.

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When handed an adverse patent application decision, the cost, time, and likelihood of success become the basic considerations for deciding whether to appeal the examiner's decision to the Board of Appeals and Interferences. Given there are already 20,000 undecided appeals of examiner decisions hanging in limbo with the U.S. Patent and Trademark Office (USPTO) Board of Appeals, the decision to appeal must be made strategically.

Though seemingly odd advice, the best appeal may be the one you don't make. Because of the number of undecided appeals queued up ahead of you, the average time from filing to a decision is almost 30 months. And the Board's reversal rate has been declining in recent years to a reported rate of only 29 percent in 2010.

Once a decision to proceed with an appeal has been made, the practitioner can choose from several strategic directions. If possible, it is far easier and quicker to hold an interview with the patent examiner rather than appealing the decision. The purpose of this interview is not to convince the examiner that he or she is wrong, but to clarify whether the application is ripe for appeal to the Board. This course of action assumes the examiner is acting reasonably (an assumption not always safe to make).

The best situation for an appeal is one that is a winner from the very start, such as situations where it can be specifically shown an examiner's rejection of an application is clearly not supported by facts. These do not include rejections based on the law or on facts that are ambiguous, but are based on facts that in no way support the rejection. In other words, the rejection does not—and cannot be modified to—pass the proverbial "laugh test."

An example of this situation is where the examiner has repeatedly missed showing that a claim's elements are described or suggested by the cited prior art, coupled with the fact that the cited prior art does not itself actually describe or suggest those claims elements. In these instances, an appeal may be successful when the examiner is forced to write an Examiner's Answer and comes face to face with the clearly inadequate

rejection, which cannot be supported even if rewritten. The examiner has the choice of remaining steadfast in the original decision, which looks bad to the Supervisory Patent Examiner and to the quality reviewer, or to withdraw the rejection. In some instances, "saving face" may mean allowing the application outright. The success rate for immediate withdrawal of the rejection and allowance of the application using this strategy can sometimes be quite high.

In many cases, applicants will have no other option than to appeal. These are instances where the prosecution has proceeded to the point where you understand the examiner's position and the examiner understands your position. The two positions, however, are miles apart and neither side is willing to limit the scope of the claims. The strategy here is to play strong dual roles of patent attorney and appellate attorney. Using your best arguments, you must convince the Board you are correct and the examiner is not.

If your decision is to appeal, the pre-appeal process may not be worth your time. Statistically, only 2 to 5 percent of requests for pre-appeal brief review have the desired outcome of withdrawing the rejection and allowance of the application. Forty percent of such requests merely result in the rejection being removed, but not allowance of the application. Thus, the pre-appeal review process could be worth considering if your goal is removal of the rejection, but not if your goal is allowance.

For all appeals, follow both the spirit and the letter of The Manual of Patent Examining Procedure. The requirements for the appeal brief are numerous and very detailed. Failure to follow these requirements to the letter will result in the appeal brief being rejected as non-compliant. Recently, on the dashboard section of its website, the USPTO reported approximately eight percent of all appeal briefs were initially determined to be non-compliant. These briefs must be corrected and resubmitted, making a long process even longer. To ensure compliance, be aware that the USPTO periodically proposes changes to the appeal process in an effort to streamline the process.

When circumstances allow, take the opportunity to present oral arguments to the Board. You could write hundreds of pages of arguments in an appeal brief, yet not be sure the Board will focus on your desired facts and arguments. During oral arguments, however, you have an opportunity to engage the administrative judges and direct their attention to the facts and law supporting your case. If you can't present oral arguments, a picture truly is worth a thousand words: submitting charts, drawings, and other displays will help focus the attention of the administrative judges and speed up the learning curve needed to come to the correct decision.

In the end, though, it is in an applicant's best interests to try to avoid an appeal, if at all possible, as the cost, time, and likelihood of success are rarely in your favor.

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