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## Speeding Up USPTO Patent Appeals

Law360, New York (January 27, 2012, 1:04 PM ET) -- When a patent application has been finally rejected by a patent examiner, the owner of the patent application can appeal that decision to the Board of Patent Appeals and Interferences. In an effort to reduce the burden on owners and patent examiners, the United States Patent and Trademark Office announced changes to its rules for ex parte appeals to the board from a final rejection of a patent application by the patent examiner.

The new rules, which went into effect on Jan. 23, 2012, are limited to ex parte proceedings and have no bearing on patent interferences, inter partes patent re-examination or post-grant review of patent applications. The USPTO published the new rules on Nov. 28, 2011, in the Federal Register at 76 Fed. Reg. 72270. The USPTO withdrew the previously published 2008 rules, which were never implemented. The final rules are quite lengthy, covering about 30 pages of triple-column format in the Federal Register.

To supplement the rules in the Federal Register, the USPTO will soon be issuing a series of frequently asked questions and a series of slides to explain the new rules to owners and patent examiners. Both of these sources of information should be studied by the owner before proceeding with an appeal, despite the summary presented below.

The goal of the new rules is to make the appeal process quicker and easier, thereby diminishing the backlog of appeal cases. There are over 25,000 patent applications currently on appeal and the average time to decide an appeal is well above two years. To achieve this stated goal, some of the previous requirements in the appeal process have been eliminated.

Everything previously submitted with an appeal brief (the document prepared by the owner during the appeal) such as statements about the status of claims, the status of amendments, the grounds of rejection on appeal, the evidence appendix and the related proceeding appendix have been eliminated. The citation of authorities has been amended so preferred citations can be used instead of mandatory citations and the requirement for parallel citations has been deleted.

The requirements of the examiner's answer (the document prepared by the patent examiner during the appeal) have been simplified, and the examiner need not determine whether the appeal brief meets the required form. As well, there is no longer a requirement that a response to a reply brief (the document prepared by the owner in reply to the examiner's answer) needs to be prepared by the examiner. With fewer requirements, the USPTO hopes the number of noncompliant appeal briefs, examiner's answers and reply briefs will be reduced, shortening the appeal process since these noncompliant documents no longer are returned to the owner, corrected, and then resubmitted.

To speed up the process, the new rules also allow some assumptions to be made during the appeal process. First, when the appeal brief fails to identify a real party in interest, the board may

now assume the inventors named in the application are the real party in interest.

If the statement of related cases is omitted, the board will assume there are no such related cases. As well, the new rules will presume the appeal is taken from the rejection of all of the claims pending in the application unless otherwise specified. Most of this information is already available in the Image File Wrapper on the Patent Application Retrieval System, anyway, and so is duplicative.

To achieve a quicker appeal process, the new rules also focus the jurisdiction of the board and allow the board to exercise its jurisdiction over the patent application earlier. Thus, the board will assume jurisdiction on the earlier of (1) the filing of a reply brief or (2) the expiration of time in which to file such a reply brief. Examiners are no longer required to acknowledge receipt of the reply brief, an action they previously had to take before the board could exercise jurisdiction over the appeal.

Any argument raised in the reply brief from the examiner that was not raised in the appeal brief, or is not responsive to an argument raised in the examiner's answer, will not be considered by the board unless good cause is shown. Other ancillary issues, like considering an information disclosure statement or a petition, are held in abeyance until after the appeal concludes.

The appeal process will also be quickened by focusing the examiner's attention on just the issues raised in the appeal. Thus, the new rules limit the new grounds of rejections that can be raised by an examiner during the appeal. The USPTO will soon amend the Manual of Patent Examining Procedure, the internal guidelines used by USPTO, to provide guidance as to what constitutes a "new ground of rejection" during the appeal, as well as the procedures for petitioning the examiner's failure to designate a new ground of rejection. The final rules, however, have given some examples of actions that will constitute a new ground of rejection:

- changing the basis of the rejection of the patent application from a novelty rejection under 35 U.S.C. § 102 to an obvious rejection under 35 U.S.C. § 103 (or vice versa) using a different disclosure in a prior art reference;
- providing new calculations to support a rejection of a claimed range using a prior art reference that describes an overlapping range;
- citing new structures in a prior art reference to support a rejection of structural obviousness under 35 U.S.C. § 103; and
- relying on a different part of the claim when rejecting it in a "new matter" rejection under 35 U.S.C. § 112.

Just as importantly, the final rules describe examples of actions that will not constitute a new ground of rejection:

- relying on a different part of a prior art reference to elaborate on a position that supports the rejection of the claims;
- changing the basis of rejection from an obviousness rejection under 35 U.S.C. § 103 to a novelty rejection under 35 U.S.C. § 102, but relying on the same part of the prior art reference;
- relying on fewer references in support of an obviousness rejection under 35 U.S.C. § 103 while relying on the same rationale;
- changing the order of the prior art references while relying on the same description within the prior art references; and
- citing to other parts of a prior art reference when responding to the arguments raised by

the owner against the rejection.

By streamlining the procedural requirement, these new rules should make the appeal process quicker and easier on the owners and patent examiners, as well as focus the board's attention on the substantive issues in the appeal. But only time will tell if they diminish the backlog of appeal cases and actually shorten the average time for an appeal.

--By Kenneth Horton, Kirton McConkie PC

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