

## **Board of Patent Appeals and Interferences Frequently Asked Questions**

1. What is an appeal to the Board of Patent Appeals and Interferences (BPAI)?

It is a request for a hearing before a panel of typically three members of the Board (unless an expanded panel is deemed necessary by the Board) to determine if the rejection made by the patent examiner is proper.
2. How do I file an appeal?
  - a. When?

The applicant would first file a Notice of Appeal after the claims have been twice rejected within the time period provided under 1.134. Within two months of filing of the Notice of Appeal, the Appeal Brief would need to be filed. Extensions of time under 1.136 are permitted for filing the Notice of Appeal and the Appeal Brief.
  - b. Fees?

The fee for a large entity for Notice of Appeal is currently \$540, and the fee for the Appeal Brief is currently \$540. If the Notice of Appeal and Appeal Brief are filed together, both fees must still be paid. The fee schedule may be found in 41.20.
3. What happens when I file an appeal?
  - a. BPAI Review

Once the Appeal Brief is filed, the Appeal Brief is reviewed by the BPAI for compliance with 41.37 under MPEP 1205.03. If the Appeal Brief is found to be compliant, the application is forwarded to the examiner for consideration. After all subsequent briefs and answers have been made, or none filed within the designated time period, the application is sent for a final review of content before the Board where the case is either remanded for correction of informality or given an appeal number and is later assigned to a panel of Board members.
  - b. Examiner's Answer

If the examiner decides to go forward with the appeal, an appeal conference is held with the examiner, a supervisory patent examiner (SPE) and another examiner experienced in the art to determine whether to proceed with an Examiner's Answer to rebut the Appeal Brief, allow the application or to reopen prosecution.
  - c. Reopening prosecution, Applicants or Examiner

The examiner may also decide, prior the appeal conference, to reopen prosecution. Only the SPE approval is required and no appeal conference is held. Also, the applicant may also file an RCE which reopens prosecution within two months of the date of the Examiner's Answer.
  - d. Reply Brief

A Reply Brief may optionally be filed within two months from the date of the Examiner's Answer to further rebut the arguments made in the Examiner's Answer. If the Examiner's Answer contains a new ground of rejection, a Reply

Brief must be filed in response to the new ground of rejection. There are no fees or extensions of time to file a Reply Brief.

- e. Oral Hearing

A request to have the hearing conducted telephonically, by video conference or in person is considered to be an Oral Hearing as opposed to a Hearing On Brief. The request needs to be filed within two months of the date of the Examiner's Answer, and include a fee under 41.20. Currently the fee for a large entity is \$1080.
4. What happens if I receive a negative opinion from the Board?
- One can proceed to amend the claims to overcome the position taken by the Board or file for reconsideration of the Board decision via a Rehearing. Further appeal can still be made to the Fed Cir or District Court of DC if the Rehearing decision is not found favorable.
- a. Estoppel effects of the opinion

Claims subject to an adverse decision made by the Board, which has not been overturned, can not be again submitted for consideration before the examiner since it is an estoppel. Any such claims would be rejected under *res judicata* as being based on a prior adjudication, against the inventor on the same claim, a patentably nondistinct claim, or a claim involving the same issue.
  - b. Options for proceeding after?
    - i. Request Rehearing?

A single request for reconsideration may be submitted before the Board as a rehearing request.

      - 1. What does this mean and how do I do it?

The request for rehearing is limited to a rebuttal of points believed to have been misapprehended or overlooked by the Board. However, if the Board applied a new ground of rejection, a request for rehearing must present a rebuttal to the new ground of rejection and not contain any new evidence or amendments in response thereto. The request is made On Brief and needs to be filed within two months of the Board decision.
    - ii. Reopen prosecution?

This is when the case is sent back to the examiner for consideration.

      - 1. Why would I want to do this and what could I do and how?

In the situation where a new ground of rejection was applied by the Board, instead of filing a rehearing request, a request may be filed to reopen the prosecution before the examiner, solely on the matter of the new ground of rejection. Amendments and new evidence may also be submitted to rebut the new ground of rejection. Otherwise, if it is desired to further amend the claims over the rejection maintained by the Board, an RCE made be filed to reopen the entire prosecution. Any request for reopening must be filed within two months of the Board decision and there are no fees or extensions.
    - iii. Appeal to Fed Cir and the District Court of DC?

Further appeal to a higher authority may still be made if dissatisfied with the final decision of the Board.

1. How to do?

In accordance with 1.304, an appeal may be filed before the Fed Cir or the District Court of DC within two months of the final decision of the Board. An appeal before the Fed Cir must be based on the record of the case which means no new evidence or new arguments would be permitted. Fees to file such are set by the Fed Cir and may be viewed on their website at

<http://www.cafc.uscourts.gov>. Alternatively, if it is desired to submit new evidence and arguments, than an appeal (civil action) before the District Court of DC would need to be made. Court costs for cases before the District Court of DC tend to be substantially higher than for the Fed Cir due to new evidence or issues being considered. Information filing and fees before the District Court of DC may be found on their website at <http://www.dcd.uscourts.gov/dcd>.

2. What can I expect?

The respective courts will contact you regarding a court date and you will have the option of proceeding On Brief or by an appearance before the court. Also, representing the Board will be a solicitor from the USPTO.

5. Who constitutes the Board?

35 U.S.C. § (6)a establishes the membership of the Board as being the Director, the Deputy Director, the Commissioner for Patents, the Commissioner for Trademarks, and the Administrative Patent Judges.

a. Do the Board members have technical backgrounds?

Each Judge and law clerk has at least a bachelor's degree in science or engineering or equivalent. Many members have one or more advance degrees.

6. How is the Board structured?

The Board is separated into two divisions, and each division is divided into technological sections. Each section is then divided into plural chambers, with each chamber comprising two judges, two patent attorneys and an assigned paralegal.

7. Why does it take so long for the Board to decide my case?

In recent years there have been an ever increasing number of cases filed before the USPTO and thus the number of cases awaiting decision by the Board has increased accordingly. In order to accommodate the resulting influx of cases, the Board has hired additional judges and patent attorneys, expedited the appeal review process and instituted a chambers structure. This should result in a reduction of pendency in the near future.

## 8. Statistics

### a. Rate of affirmation of rejections

The Board does not track the various types of rejections such as:

- i. Anticipation under 35 USC 102 of same or inherently the same prior art.
- ii. Obviousness under 35 USC 103 of a modification of a prior art such as by a combination of prior art.
- iii. Written description under 35 USC 112, 1<sup>st</sup> ¶ being defective.
- iv. Enablement under 35 USC 101 as being non-useful or inoperative, and
- v. Other such as those listed under MPEP 703 on rejections not based on prior art.

Rather, the Board presents monthly and yearly statistics on the affirmances, affirmances-in-part, reversals, remands and dismissals of appeals from respective technical centers. They may be found on the website of the Board at <http://www.uspto.gov/ip/boards/bpai/index.jsp> under Receipts and Dispositions. Also available on the website under Performance and Measures are listings of pendency from the date of assignment of the appeal number to the decision date of the panel. Additionally, the Board keeps track of appeals found to be compliant as well as various selected stages of appeals in its website under Dashboards. On the USPTO Dashboard website, pendency from filing to a Board decision may be found at <http://www.uspto.gov/dashboards/patents/main.dashxml> under New Pendency-related Measures.

### b. Disposition rate and what does this mean

The disposition rate, which is found under Receipts and Dispositions on the Board website as noted above, is the percentage of appeals disposed of by a particular decision, remand or dismissal. This would give an insight as to the general outcome of an appeal on a monthly and yearly cumulative basis. Also it could be used to see the monthly and year-to-date output of the Board.

## 9. Informative procedural decisions and/or legal decisions?

A listing of key and precedential decisions is available from the Board website at <http://www.uspto.gov/ip/boards/bpai/index.jsp> under the heading “Board Opinion and Decisions.”

## 10. Who constitutes our practice group?

Highly experienced practitioners including Partners Daniel Pereira, Rick Treanor, and Surinder Sachar; former Board Patent Judges Teddy S. Gron and Lee E. Barrett; and former Board Administrator Craig R. Feinberg.