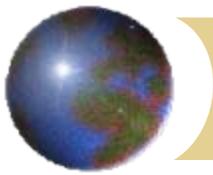




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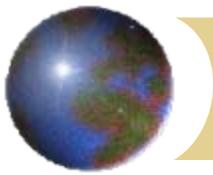
Making Effective Use of the Appeals Process & Practice Tips

Michael R. Fleming
Chief Administrative Patent Judge
Board of Patent Appeals and Interferences
571-272-9797
michael.fleming@uspto.gov



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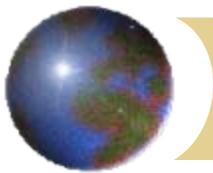
- ✚ Accomplishments and Future Workload
- ✚ Making Effective Use of the Ex Parte Appeal Process
- ✚ Substantive Practice Tips
- ✚ Electronic Hearing Room



Major FY 07 Accomplishments

+ Interferences

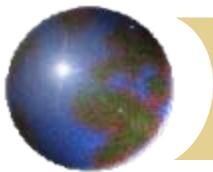
- + Terminated **45** interferences
- + Average pendency of pending interferences is **8.8** months
- + Average pendency of terminated interferences is **9.5** months
- + Percentage of interferences terminated in 2 years or less is **100%**



Major FY 07 Accomplishments

Ex Parte Appeals

-  Disposed of **1379** appeals
-  New appeal inventory of **1834** appeals
-  Average pendency of decided appeals is **5.6** months (from Docketing Notice date)



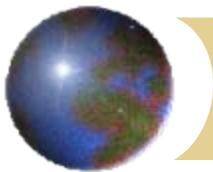
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Ex Parte Results by TC for FY 07

EX PARTE APPEALS FISCAL YEAR 2007 DISPOSITIONS

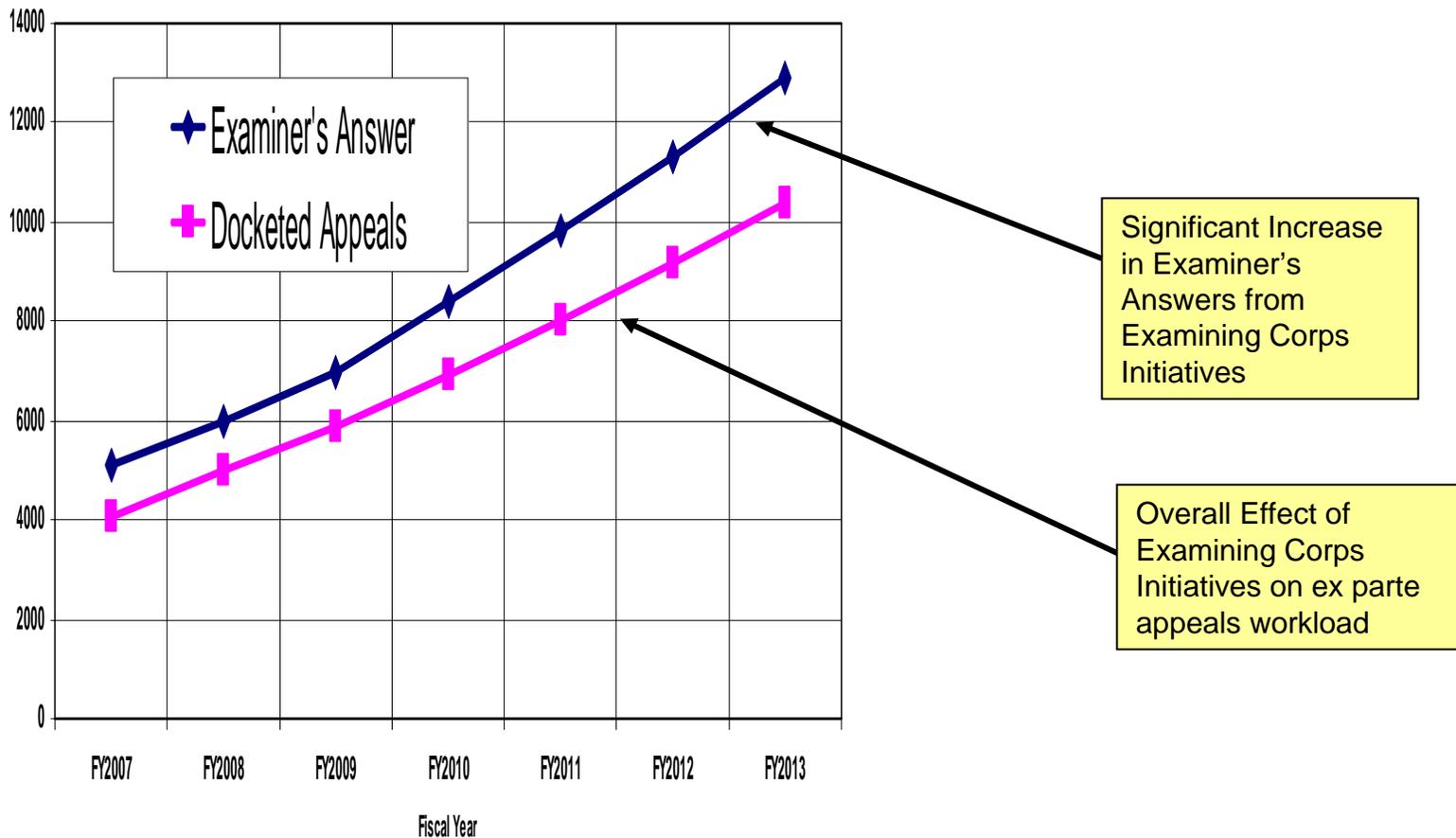
TECHNOLOGY CENTER	PENDING BEGINNING FISCAL YEAR	APPEALS RECEIVED FISCAL YEAR	AFFIRMED	AFFIRMED-IN-PART	REVERSED	PANEL REMANDS	ADMIN REMANDS	DISMISSED	TOTAL	PENDING END FISCAL YEAR	INCREASE/DECREASE FISCAL YEAR	PERCENT OF CASE WORKLOAD
1600	132	223	81	20	53	5	2	12	173	182	50	9.9
1700	260	392	194	29	62	20	2	4	311	341	81	18.6
2100	209	460	117	36	79	4	2	2	240	429	220	23.4
2600	72	188	52	21	25	3	1	0	102	158	86	8.6
2800	121	141	62	12	35	10	1	0	120	142	21	7.7
2900	11	6	1	0	0	0	0	0	1	16	5	0.9
3600	372	271	90	41	114	6	3	2	256	387	15	21.1
3700	180	194	85	42	56	7	1	4	195	179	-1	9.8
Board Totals	1357	1875	682	201	424	55	12	24	1398	1834	477	100.0

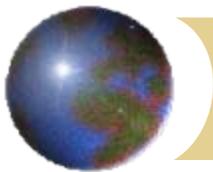
AFFD	AIP	REV	PANEL RMD	ADMIN RMD	DISM
48.8	14.4	30.3	3.9	0.9	1.7



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Ex Parte Workload Increases

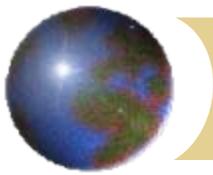




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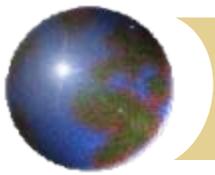
Workload Increases and APJ Hiring Requirements

Ex Parte Hiring Requirements							
Fiscal Year	2007	2008	2009	2010	2011	2012	2013
Appeals	4,041	4,970	5,895	6,913	8,009	9,150	10,351
APJ Hires	18	13	10	13	15	15	15
Cumulative Hires	18	31	41	54	69	84	99



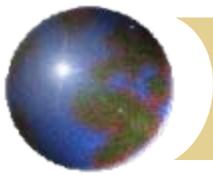
Effective Use of the Ex Parte Appeal Process

- + Purpose of the appeal process is to:
 - + Focus on where the appellant believes the examiner erred as opposed to de novo review
 - + Articulate the issues
 - + Identify the relevant facts



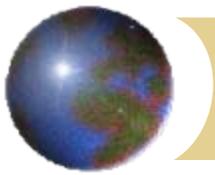
Effective Use of the Ex Parte Appeal Process

- ✚ Appeal process has two presentations:
 - ✚ 1) Presentation of appellant's arguments before the examiner and patent corps reviewers
 - ✚ 2) Presentation of examiner's rejections and appellant's arguments before the Board



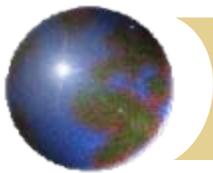
Effective Use of the Ex Parte Appeal Process

- ✚ Milestones in the Appeal Process:
 - ✚ Notice of Appeal
 - ✚ Appeal Brief
 - ✚ Examiner's Answer
 - ✚ Reply Brief
 - ✚ Docketing Notice
 - ✚ Oral Hearing



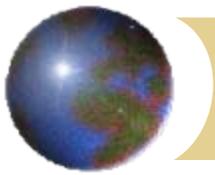
Effective Use of the Ex Parte Appeal Process

- ✚ Notice of Appeal
 - ✚ Objectively evaluate the strength of your arguments
 - ✚ Consider requesting a pre-appeal brief conference
 - ✚ Consider further prosecution options



Effective Use of the Ex Parte Appeal Process

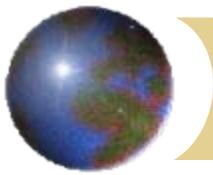
- ✚ Notice of Appeal (cont.)
 - ✚ Resolve outstanding prosecution procedural matters
 - ✚ Information Disclosure Statements
 - ✚ Petitionable issues



Effective Use of the Ex Parte Appeal Process

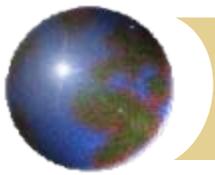
┆ Appeal Brief

- ┆ Arguments should be a clear and complete statement of appellant's position at the time of filing the brief
- ┆ When making a new argument, clearly identify it as such



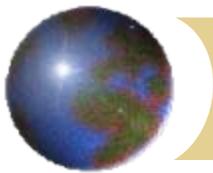
Effective Use of the Ex Parte Appeal Process

- Appeal Brief (cont.)
 - A good argument includes citation to the record for relevant facts and prior statement of arguments
 - Remember only arguments made in the brief will be considered by the Board



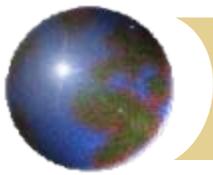
Effective Use of the Ex Parte Appeal Process

- Appeal Brief (cont.)
 - Appeals are won or lost on:
 - Claim interpretation
 - Findings of fact
 - Application of the correct law



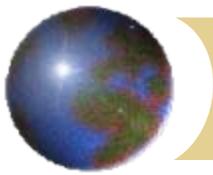
Effective Use of the Ex Parte Appeal Process

- Appeal Brief (cont.)
 - Properly map claims in the Summary of the Claimed Subject Matter section
 - Appropriately address the Evidence and Related Proceedings appendices



Effective Use of the Ex Parte Appeal Process

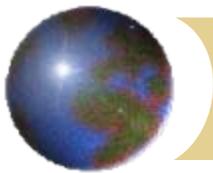
- ✚ Examiner's Answer
 - ✚ Opportunity for examiner and patent corps reviewers to consider:
 - ✚ 1) appellant's prior arguments
 - ✚ 2) appellant's new arguments



Effective Use of the Ex Parte Appeal Process

+ Reply Brief

- + No new arguments allowed except in response to new arguments raised in examiner's answer
- + Not intended to be a reiteration of the appeal brief



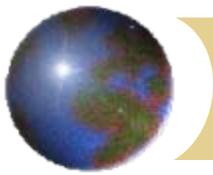
Effective Use of the Ex Parte Appeal Process

✚ Docketing Notice

- ✚ Two specialized units review appeal documents to resolve defects before docketing at the Board

- ✚ Patent Corps Appeal Center

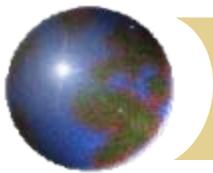
- ✚ Board Reviewing Team



Effective Use of the Ex Parte Appeal Process

✚ Oral Hearing

- ✚ Oral Hearings Open to the Public
- ✚ Transcriptions of Oral Hearings
- ✚ Entered into Official Record
- ✚ Cost Borne by PTO

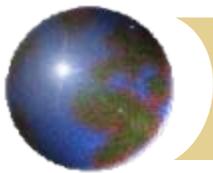


Substantive Practice Tips - *KSR*

✚ *KSR* refocused the Board on consideration of the obviousness factors set forth in *Graham*:

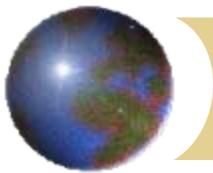
- ✚ The scope and content of the prior art are to be determined;
- ✚ Differences between the prior art and the claims at issue are to be ascertained; and
- ✚ The level of ordinary skill in the pertinent art resolved.

KSR Int'l v. Teleflex Inc., 82 USPQ2d 1385, 1391 (2007).



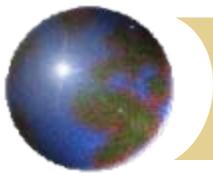
Substantive Practice Tips - *KSR*

- ✚ In resolving obviousness issues, a finding that there is no teaching-suggestion-motivation does not establish patentability if other indicia of obviousness are present. *KSR*, 82 USPQ2d at 1396-97.



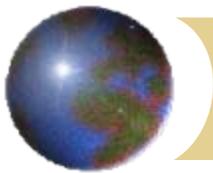
Substantive Practice Tips - *KSR*

- ✚ "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results. Three cases decided after *Graham* illustrate the application of this doctrine." *KSR*, 82 USPQ2d at 1395.



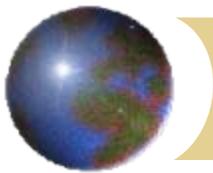
Substantive Practice Tips - *KSR*

- ✚ "In *United States v. Adams*, ... [t]he Court recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result." *KSR*, 82 USPQ2d at 1395.



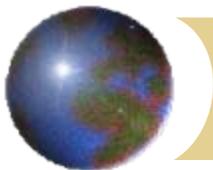
Substantive Practice Tips - *KSR*

- ✚ "In *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, ... [t]he two [pre-existing elements] in combination did no more than they would in separate, sequential operation." *KSR*, 82 USPQ2d at 1395.



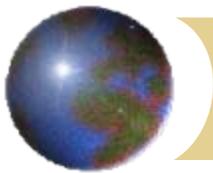
Substantive Practice Tips - *KSR*

- ✚ "[I]n *Sakraida v. AG Pro, Inc.*, ... the Court derived from the precedents the conclusion that when a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious." *KSR*, 82 USPQ2d at 1395-96 (internal quotation omitted).



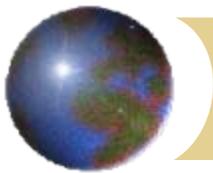
Substantive Practice Tips - *KSR*

✚ “As is clear from cases such as *Adams*, a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR*, 82 USPQ2d at 1396.



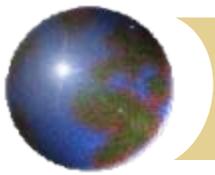
Substantive Practice Tips - *KSR*

✚ “Helpful insights, however, need not become rigid and mandatory formulas; and when it is so applied, the TSM test is incompatible with our precedents. The obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents. The diversity of inventive pursuits and of modern technology counsels against limiting the analysis in this way. In many fields it may be that there is little discussion of obvious techniques or combinations, and it often may be the case that market demand, rather than scientific literature, will drive design trends.” *KSR*, 82 USPQ2d at 1396.



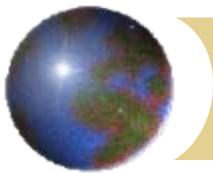
Substantive Practice Tips - Published Board Decisions

- ✚ Publication of Board Decisions
 - ✚ Precedential
 - ✚ Informative
 - ✚ Routine
 - ✚ All Published on Board Website



Substantive Practice Tips - Published Board Decisions

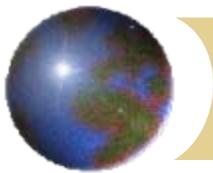
- ✚ Precedential Decisions
 - ✚ Binding on Board
 - ✚ Procedure for becoming precedential set forth in SOP 2



Precedential Decision

- Non-Statutory Subject Matter
- *Ex parte Lundgren*, 76 USPQ2d 1385, 1388 (Bd. Pat. App. Int. 2005).

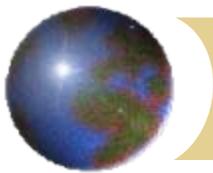
“[T]here is currently no judicially recognized separate ‘technological arts’ test to determine patent eligible subject matter under § 101.”



Substantive Practice Tips - Published Board Decisions

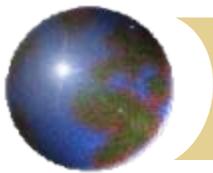
✚ Informative Decisions

- ✚ Not Binding on Board or Examiners
- ✚ Illustrative of Board Norms – Addressing:
 - ✚ Best Practices
 - ✚ Reoccurring Problems
 - ✚ Developing Areas of Law
- ✚ Citable by commercial reporting service or URL from BPAI website



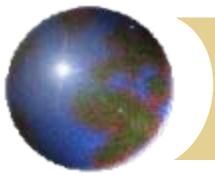
Informative Decision

- ✚ Determination of Ordinary Skill in the Art
- ✚ *Ex Parte Jud*, Appeal No. 2006-1061 (Appl. No. 09/505,713) 2006 WL 4080053, at *2 (Jan. 30, 2007) (request for rehearing, expanded panel).
“A question of what the hypothetical person with such skill would have known (and known how to do).”



Informative Decision

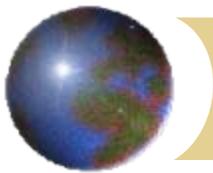
- ✚ Non-Statutory Subject Matter
- ✚ *Ex parte Bilski*, Appeal No. 2002-2257 (Appl. No 08/833,892) 2006 WL 4080055 (Sep. 26, 2006) (appeal pending at Federal Circuit, Appeal No. 07-1130).
- ✚ Tests for statutory subject matter
 - ✚ Transformation of subject matter
 - ✚ Abstract idea exclusion
 - ✚ Useful, concrete and tangible result



Informative Decision

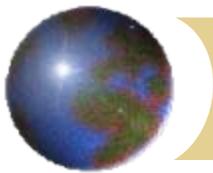
- ✚ Non-Functional Descriptive Material
- ✚ *Ex parte Mathias*, Appeal No. 2005-1851 (Appl. No. 09/612,788) 2005 WL 5121483, at *3 (*aff'd*, Appeal No. 06-1103, 2006 WL 2433879 (Fed. Cir. Aug. 17, 2006) (Rule 36)).

“[N]onfunctional descriptive material cannot lend patentability to an invention that would have otherwise been anticipated by the prior art.”



Informative Decision

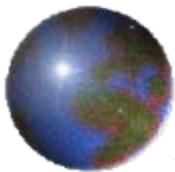
- ✚ Reissue Recapture
- ✚ *Ex parte Kraus*, Appeal No. 2005-0841 (Appl. No. 08/230,083) 2006 WL 3939191 (Sep. 21, 2006) (Supp. Decision).
- ✚ Surrendered subject matter is subject matter of an application claim that was amended or canceled **and**
- ✚ On a limitation-by-limitation basis, the territory falling between the scope of application claim that was amended or canceled and patent claim that was ultimately issued.



Substantive Practice Tips - Published Board Decisions

+ Routine Decisions

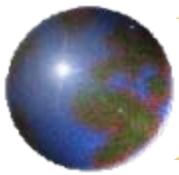
- + All Other Board Decisions (Great Majority)
- + Citable for Whatever Persuasive Value They May Have
- + Should be Cited Sparingly



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Electronic Hearing Room Dulany Street Entrance



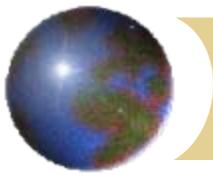


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Inside Atrium, Madison East on Left





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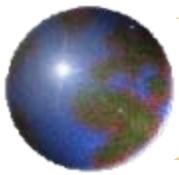
Electronic Hearing Room

Security Screening Madison East



proceed through metal
detector to first elevators

obtain security
badge

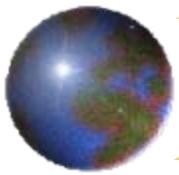


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Elevator Lobby, 9th Floor

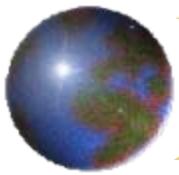




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Electronic Hearing Room Attorney Waiting Area



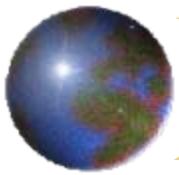


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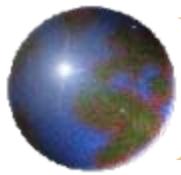




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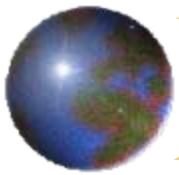




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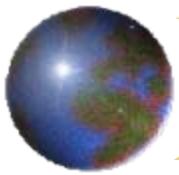




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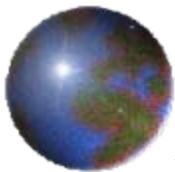




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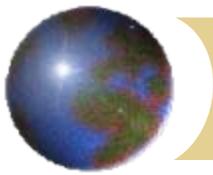




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Thank You