Tips for Writing Effective PTAB Appeals Briefs

Thursday, November 13, 2014

Your patent application has been rejected - again. You are ready to file an appeal brief with the Patent Trial and Appeal Board (PTAB) and tell three Administrative Patent Judges that the examiner is wrong. The rules for filing an appeal brief are provided in 37 C.F.R. § 41.37, including the brief’s required content. Adhering to these rules is the first step in writing an appeal brief and will ensure that you avoid a notice of non-compliance requiring resubmission of the brief. As a second step, making your appeal brief as clear and persuasive as possible will move you toward PTAB victory. To this end, the U.S. Patent and Trademark Office (USPTO) provides “Practice Tips for Writing Effective Appeal Briefs” at their website. We elaborate on some of these tips – and more – below to help make your brief effective.

- **Present strong arguments:** Carefully consider the arguments to be presented. Take a fresh look at your case – in most instances, do not simply repeat arguments previously presented because those have already been evaluated and deemed unpersuasive by the examiner. Weaker arguments or arguments that have no bearing on the issues in the case can dilute stronger arguments, so consider whether they are really necessary. Do, however, keep in mind that any arguments or authorities not presented in the appeal brief will not be considered by the PTAB.

- **Organize the brief strategically:** You generally want the PTAB to read your strongest arguments first to help persuade them quickly to your side. Consider organizing the brief by argument, to highlight the strongest arguments in the case, by grouping together the claims to which they apply. Alternatively, in cases with many claims and/or with claims having different recitations of relevance, it can be beneficial to organize your brief by claim to help keep the reader focused on one claim’s language and the various issues related thereto.

- **Argue claims separately:** The PTAB will not evaluate the patentability of any claims not individually addressed in your appeal brief, so give careful thought to which claims you choose to argue separately. To increase your chances for success, separately argue as many dependent claims as possible. For claims argued separately, consider placing such arguments under separate sub-headings for ease of readability and to highlight their individual patentability.

- **Support arguments with evidence:** Attorney argument cannot substitute for evidence, e.g., case law, previously submitted affidavits or declarations, and previously submitted evidence of secondary considerations. Cite evidence to support the arguments you put forward. Any relied-upon evidence in the appeal brief must have been before the examiner during prosecution for the PTAB to consider it.

- **Explain case law:** Unlike USPTO examiners, who typically focus on and cite to the Manual of Patent Examining Procedure (MPEP) in evaluating patentability, the PTAB largely relies on case law in their decisions. It can thus be helpful to cite cases supporting your position to help give the PTAB legal precedent to rule for you. Make sure that all case law directly cited by the examiner, or cited in an MPEP...
section relied upon by the examiner, actually supports the proposition for which it is cited. If not, point out the misinterpretation.

- **Attack rejections for factual and legal errors**: To the extent possible, dispute factual errors and legal errors made by the examiner in your appeal arguments. Factual errors include claim and reference misinterpretations. Legal errors include citations of non-analogous art, applications of impermissible hindsight, inoperable combination of references, teaching away of from the proposed combination of references, failure to articulate reasoning with some rational underpinning to support an obviousness rejection, and the misinterpretation or misapplication of case law.

- **Develop the facts and apply the law**: Develop the facts of your case and show how the law applies to require a decision in your favor. In other words, provide a sort of outline for the PTAB’s written decision with respect to every argument presented in your brief. For example, first set out the standard for a legal theory and then provide arguments and evidence showing that the legal theory applies and requires the PTAB to rule for you. Make sure that the facts and applied law clearly address the examiner’s articulated rejection.

- **Know the burden of proof**: Recognize when the burden of proof shifts to you, the appellant. When the examiner has improperly shifted the burden to you, refute that determination to demonstrate why the rejection must be withdrawn. If you do have the burden of proof, ensure that your arguments meet the burden.

- **Address key claim terms**: When a key dispute involves an issue of claim construction, provide your interpretation of the claim term and an explanation of errors in the examiner’s interpretation. Because pending claims terms are interpreted under the “broadest reasonable interpretation” standard, ensure that your interpretation has a basis under this standard. If applicable, demonstrate why the examiner’s interpretation, while “broad,” is not “reasonable.”

- **Understand the difference between appealable and petitionable issues**: The PTAB reviews adverse decisions of examiners, e.g., claim rejections. Matters not within the examiner’s discretion, e.g., objections, restriction requirements, and refusal to enter an amendment, are inappropriate for appeal brief argument. These matters should be left out of the appeal brief and instead petitioned for decision by the Director.

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