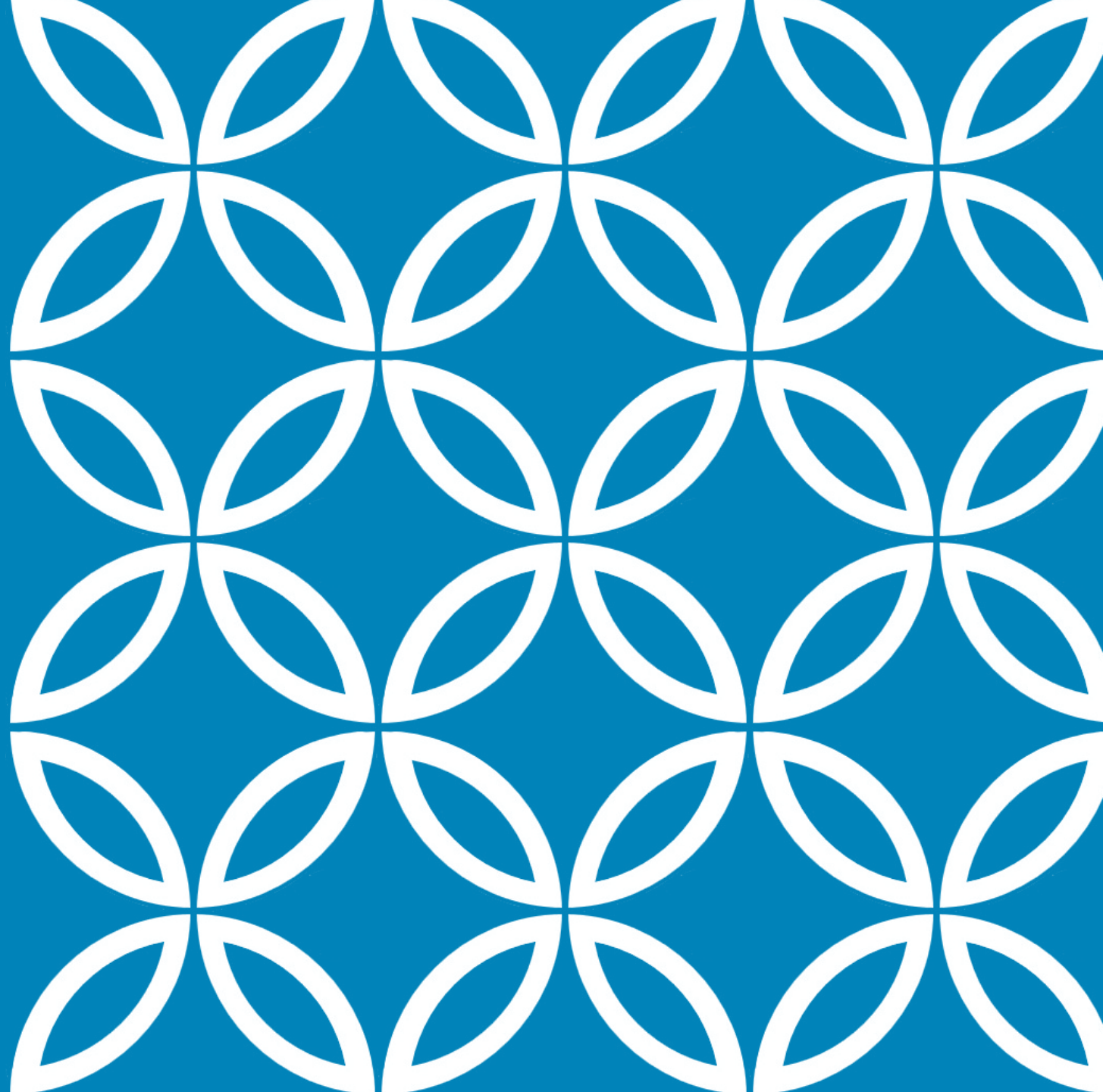




INS AND OUTS OF EX PARTE APPEALS AND ORAL ARGUMENTS APPEALS TO PTAB COMMITTEE WEBINAR

PTAB BAR ASSOCIATION

EXAMINER'S
ANSWER,
REPLY BRIEF &
ORAL HEARING

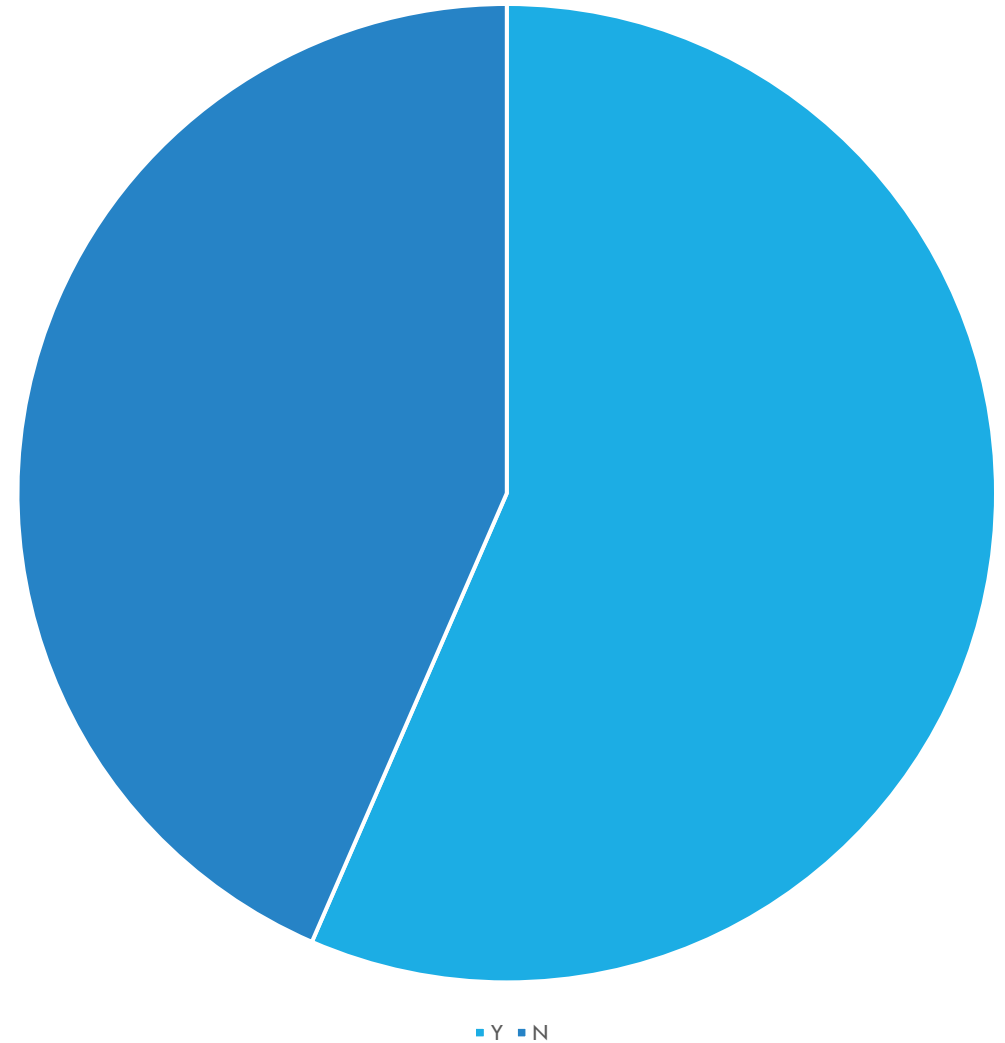


Q36: ELIMINATE EXAMINER'S ANSWER?

Yes: 26

No: 20

Eliminate Examiner's Answer?



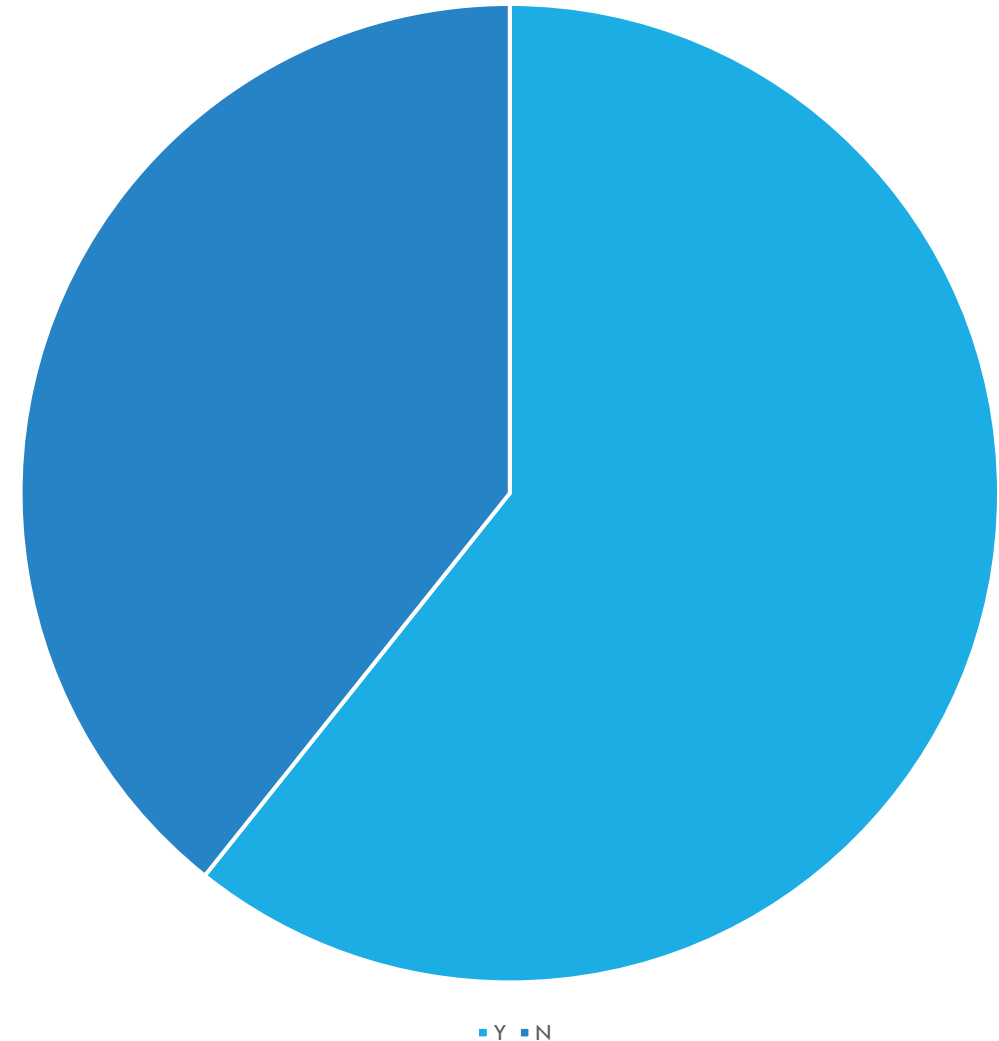
Q37: APPEAL BRIEF AS LAST PAPER IN APPEAL?

Yes: 34

No: 22

Caveat: (USPTO Management,
Already optional, 37 CFR
41.39(a)) may authorize filing an
Answer

Appeal Brief as Last Paper?



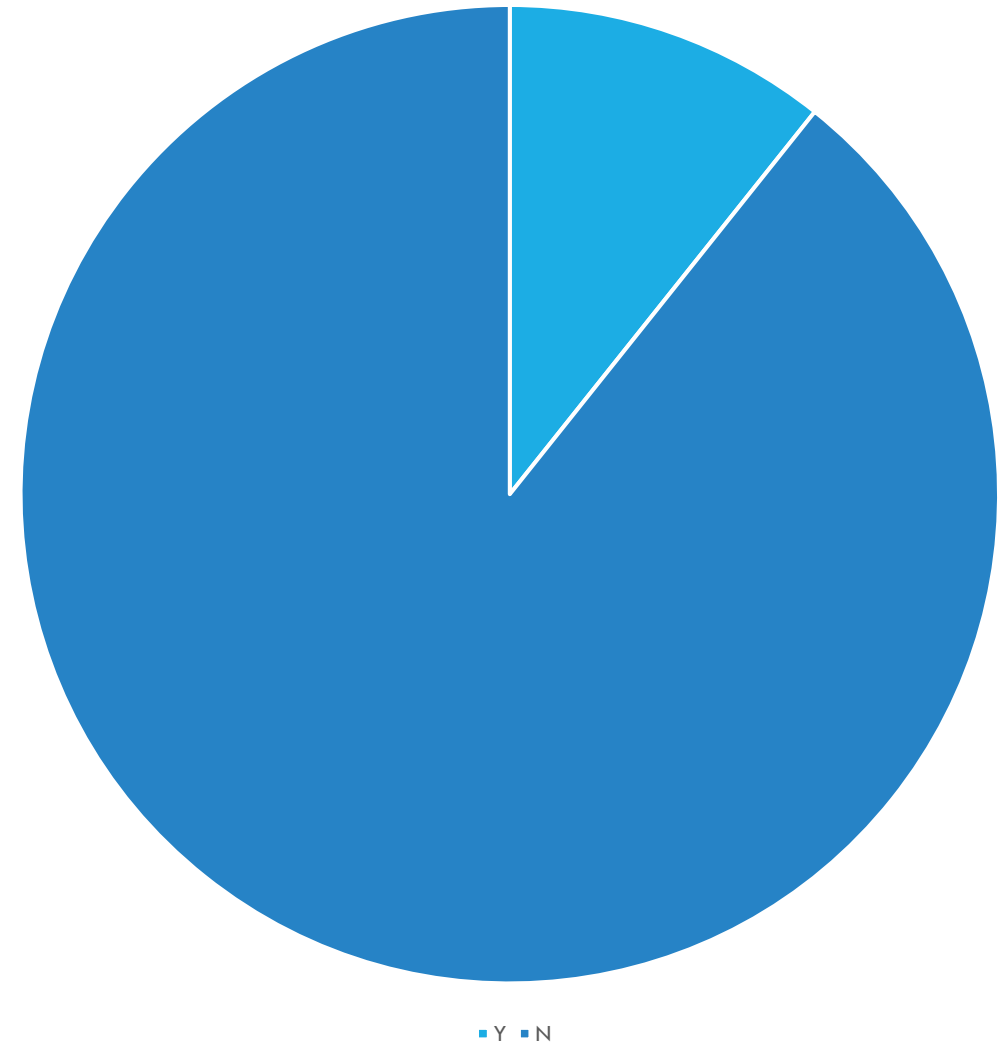
Q38: EXPERIENCED UNFAVORABLE INFERENCE WITH NO REPLY BRIEF?

Yes: 6

No: 50

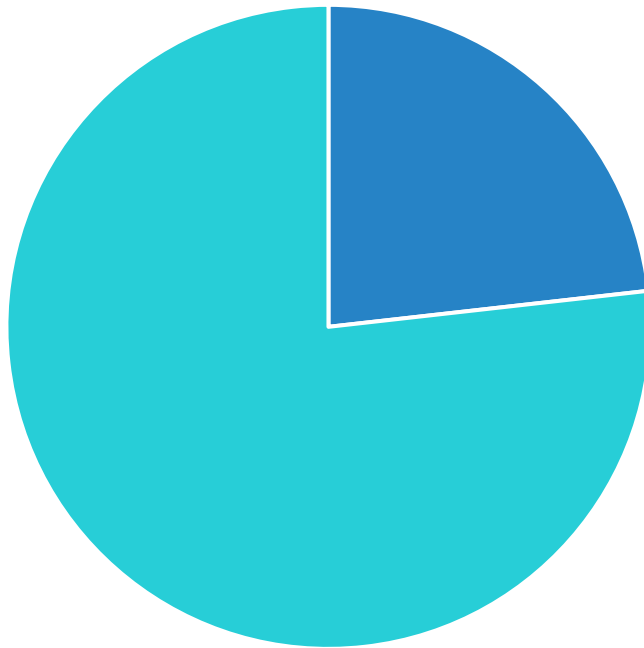
This question did not allow no
opinion answers in survey.

Unfavorable inference from no Reply Brief?



Q39: PROCEDURALLY FAIR TO DRAW ADVERSE INFERENCE WHEN NO REPLY BRIEF?

Procedurally fair to draw adverse inference from no
Reply Brief?

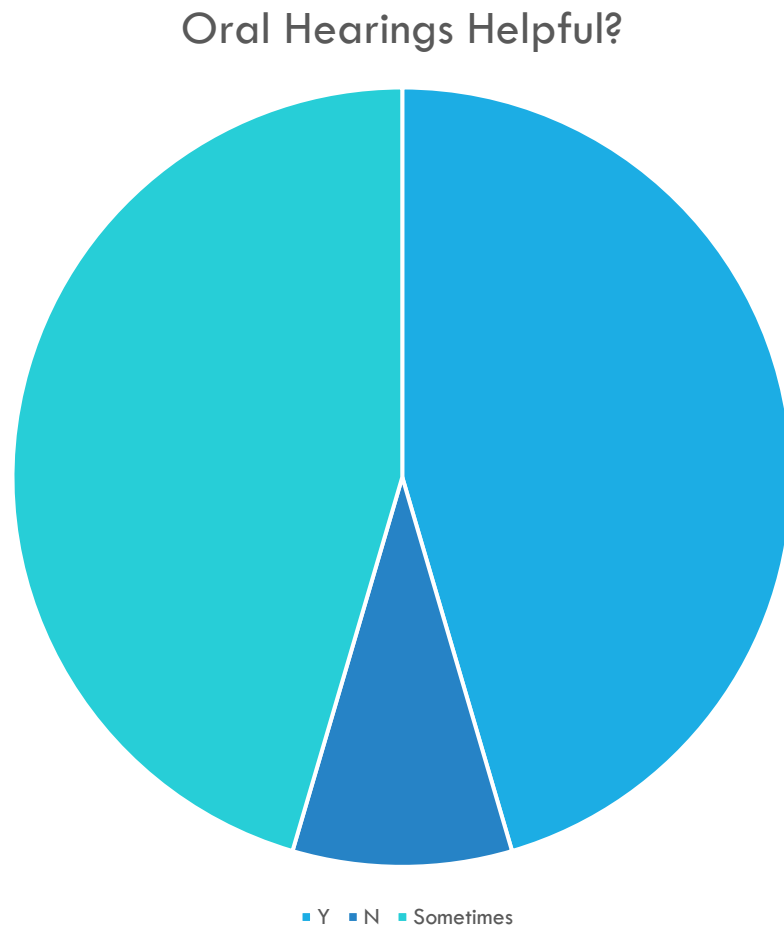


■ Q39 ■ Y ■ N

Yes: 13

No: 43

Q40: ARE ORAL HEARINGS HELPFUL?



Yes: 25

No: 4

Sometimes: 25

Q41: WHY DO YOU BELIEVE ORAL HEARINGS ARE NOT HELPFUL?

Risk of admissions: 3

Additional cost: 2

Lack of ability to influence/change Board decision: 1

ADMISSIONS

- In the oral hearing I observed as a third party requestor in an *ex parte* reexamination proceeding, the Board's written decision **expressly identified admissions** made during the oral hearing. The patent owner would have been better off not holding the hearing because the Board would not have been able to rely on those admissions. If the case was then going to be appealed to the Fed. Cir., not having those admissions in the record could only have strengthened the case before the Fed. Cir. So my experience observing and in presenting oral argument to the TTAB is that you can wind up harming your case more than helping in in oral argument.

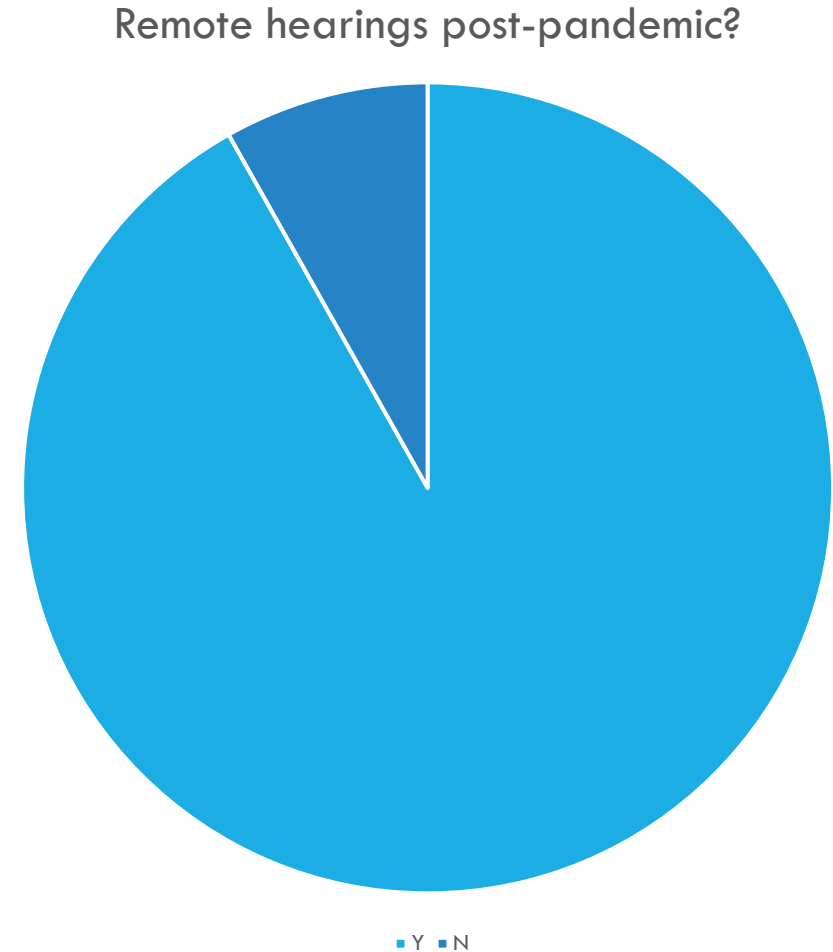
UNCONVINCING

- Based on the Board's questions, I recall only one oral hearing that likely led to the Board changing their decision. In every other *ex parte* oral hearing, I believe that the Board's decision was not changed by the oral hearing.
- I have not participated in an oral hearing for an *ex parte* appeal, and I have a high success rate on appeal. I think the issues are so limited on *ex parte* appeals that hearings are not necessary.

Q34: MAINTAIN REMOTE ORAL HEARING OPTION POST-PANDEMIC?

Yes: 45

No: 4



Q33: HOW HAVE REMOTE ORAL HEARINGS COMPARED TO IN PERSON?

Reduction of travel was plus for those who preferred remote oral hearings.

Inability to read the room/identify judge speaking/avoid talking over judges were major themes for those who found remote hearings worse.

Video was suggested as possible solution to help with reading room issues as improvement over audio-only hearings.

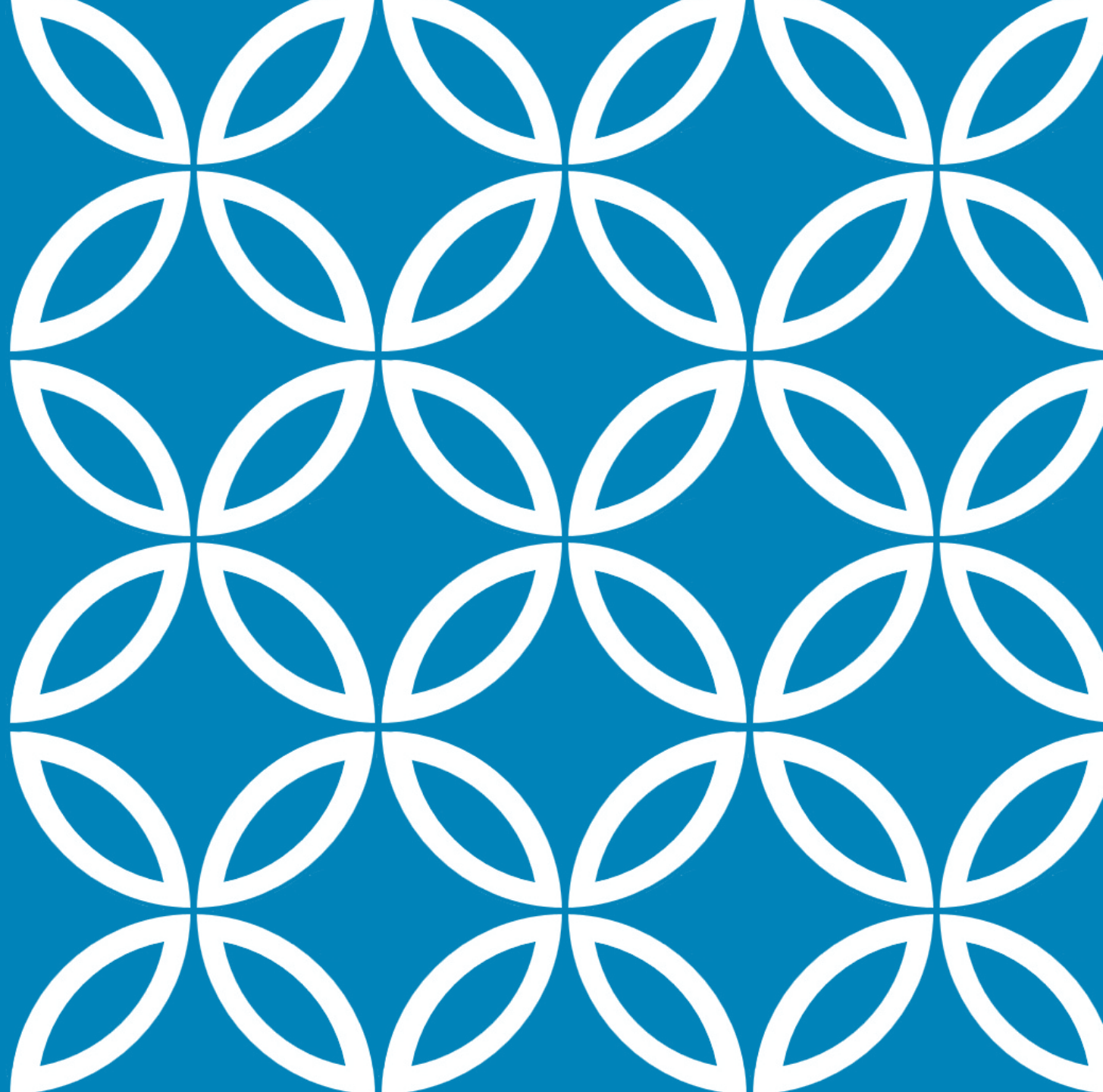
No opinion, No, Yes, Blank: 41

Comparable: 1

Better: 4

Worse: 9

BOARD DECISION



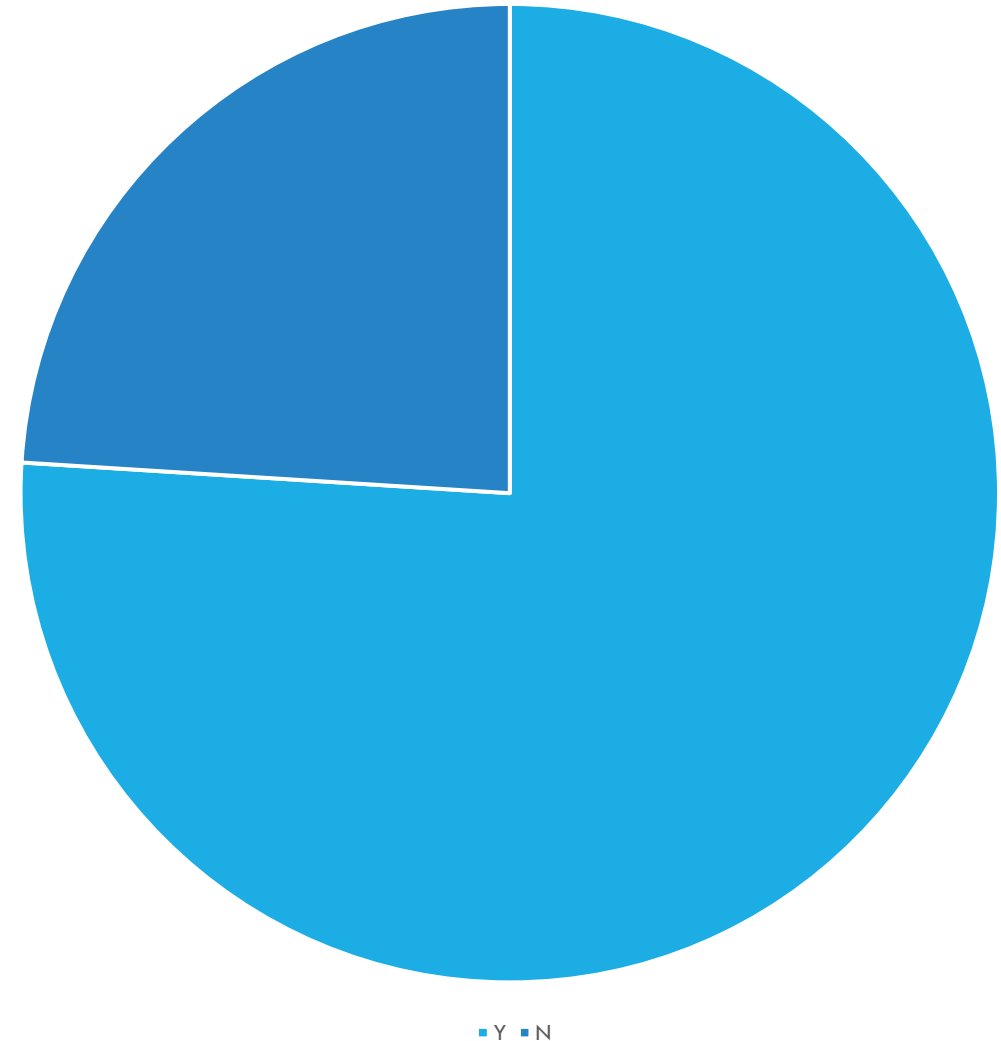
Q42: SHOULD THE BOARD BE REQUIRED TO ADDRESS EACH AND EVERY REJECTION APPEALED?

Yes: 38

No: 12

- Deciding only one issue impacts compactness of remaining prosecution.
- Eliminates repeat appeals on remaining issues.
- Unfair to Appellant

Board to Address all Rejections on Appeal?



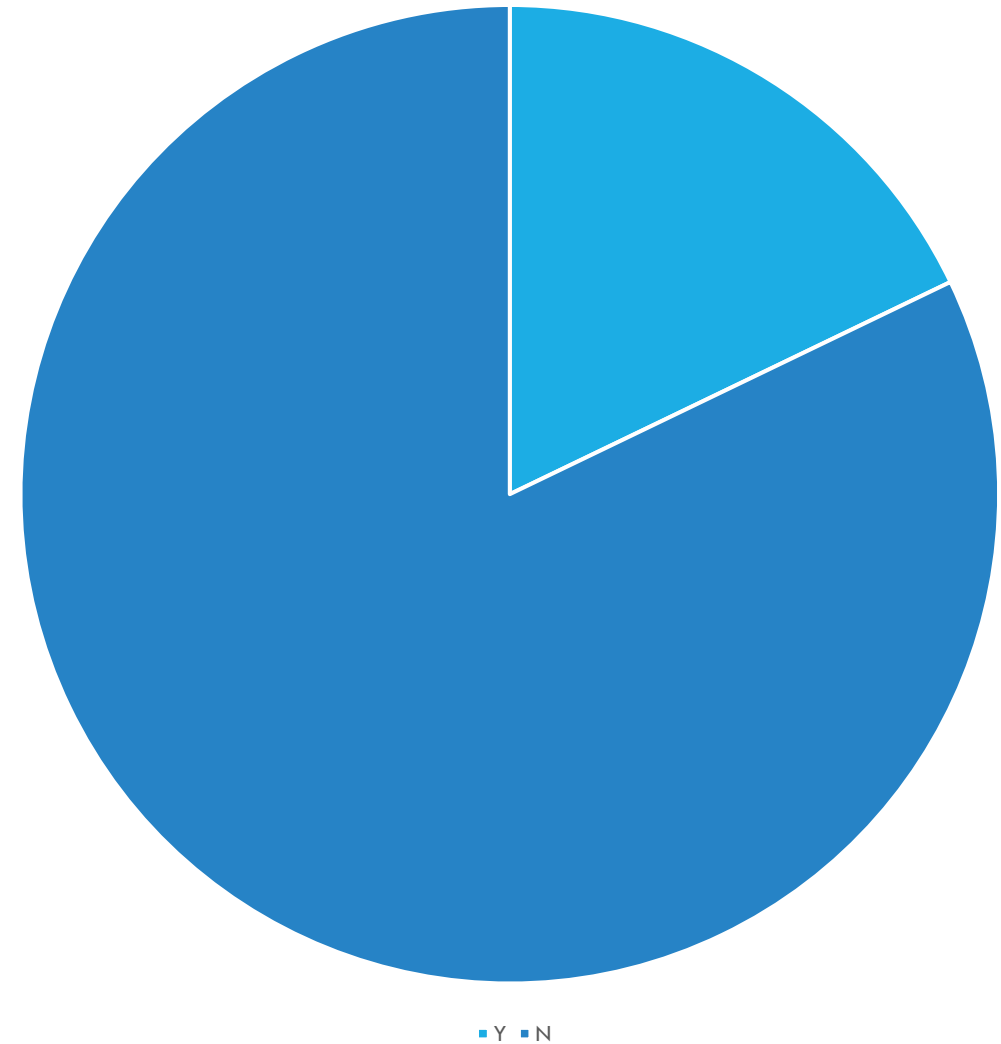
Q43: SAME REJECTION MORE THAN ONCE TO THE BOARD?

Yes: 10

No: 46

This question did not allow no
opinion answers in the survey.

Same Rejection to the Board?

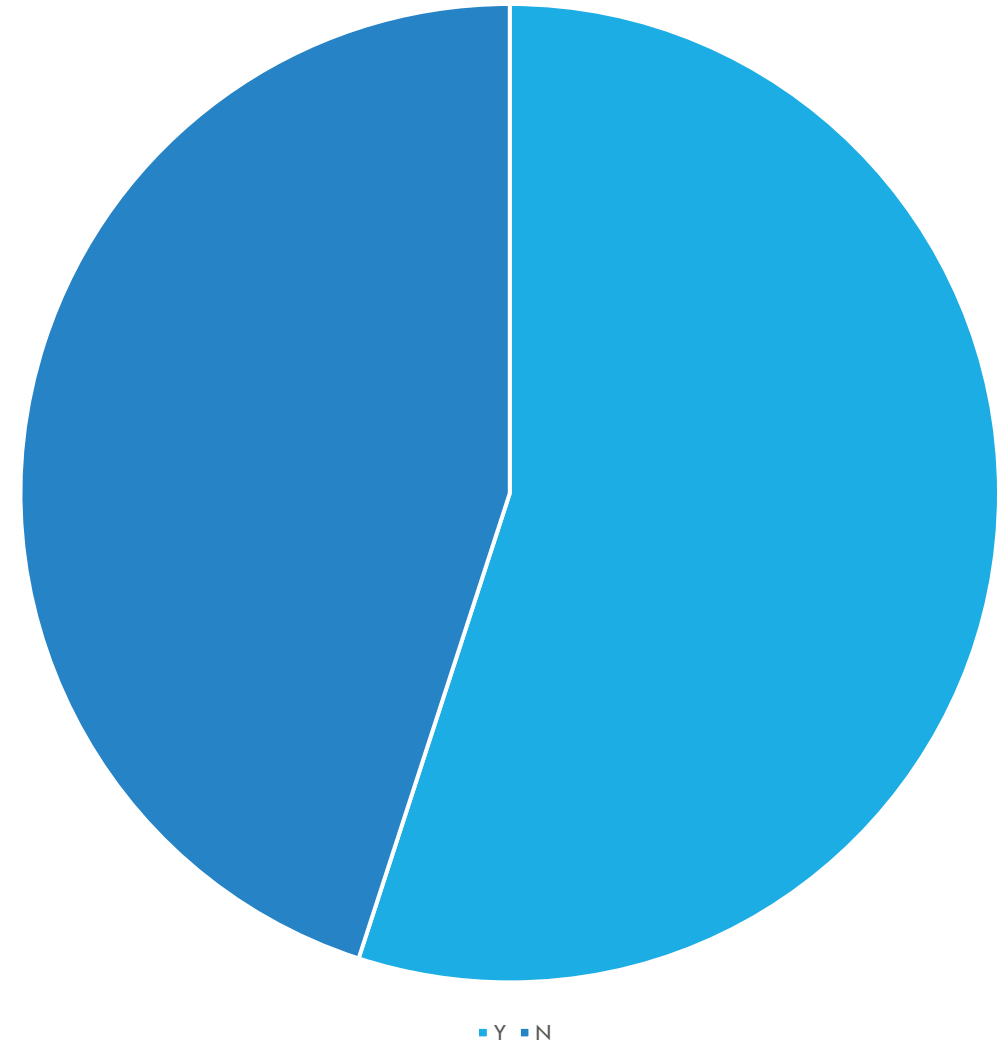


Q45: CONCERNS RE BOARD'S ABILITY TO RAISE NEW GROUNDS OF REJECTION?

Yes: 22

No: 18

Concerns re New Grounds of Rejection?



Q46: CONCERNS RE NEW GROUND OF REJECTION

FAIRNESS

- It makes the process a ***moving target*** and essentially unfair for the applicants.
- Lack of ***procedural fairness***. Appellant does not have an opportunity to respond to new rejection, creating a due process issue.
- Board Decision is final and impacts the record, so Appellant needs to the ability to ***fairly defend*** their position regarding a new ground of rejection.
- Appeal process should have some ***finality***. Examiners should not get a chance to simply update their search and issue a new rejection prior to or after a Decision.

FORCED AMENDMENTS

- Once Board raises a new rejection, as far as the Examiner is concerned, the rejection is set in stone. ***Amendment, not argument***, is the only way to move forward no matter the quality of the Board rejection.

Q46: CONCERNS RE NEW GROUND OF REJECTION

REMAND & REOPENING

- Remanding to Examiners v Board entering a new rejection gives Appellant ***ability to respond*** to rejection.
- Board should outline how rejection of record was in error and identify issues Examiner must consider without opining on whether the new grounds have merit.
- Appellant should receive a refund of fees upon remand/reopening to compensate for the increase in fees and time delay.

Q47: BOARD USED NEW FACTS/REASONING W/O DESIGNATING A NEW GROUND OF REJECTION?

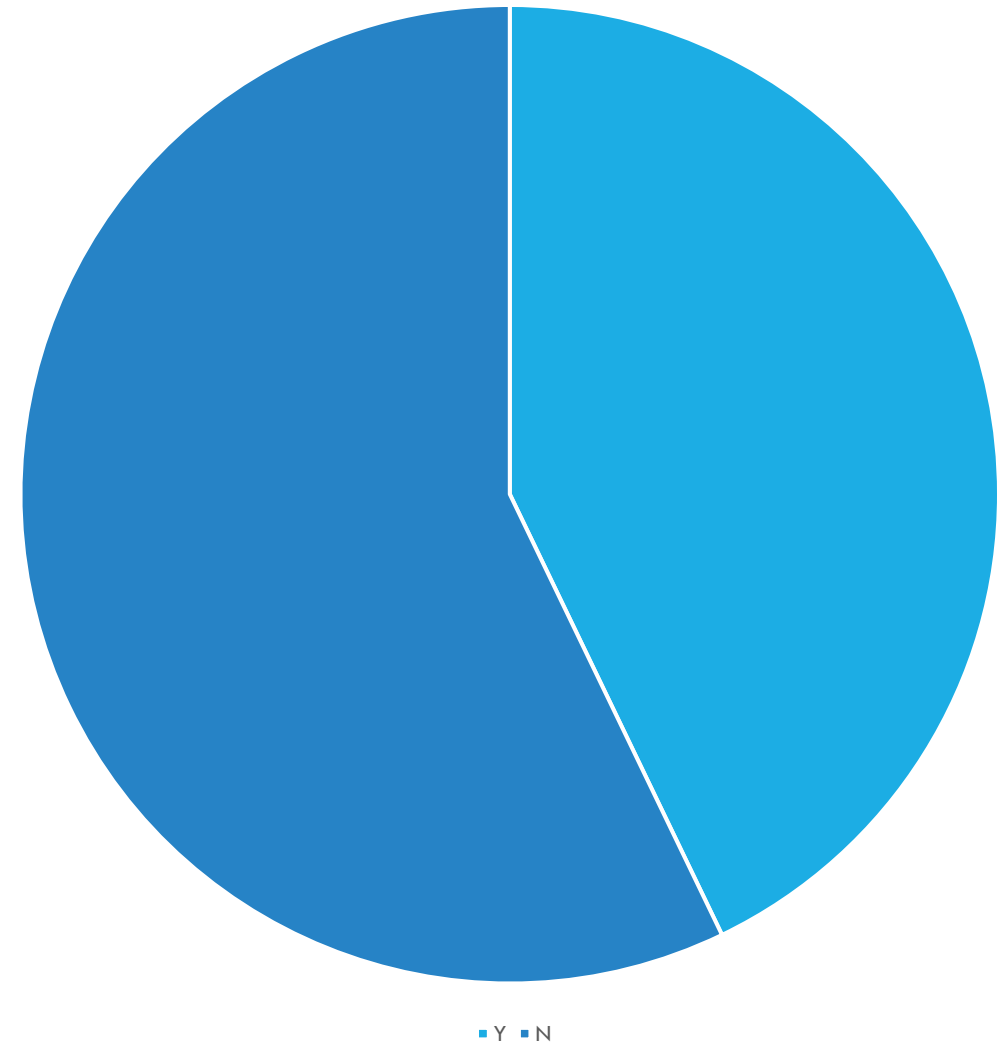
Yes: 24

No: 32

This question did not have a no opinion option in the survey.

- Board Decisions should explain why facts/reasoning are not a new rejection and how tied to original rejections.
- Doing so strengthens Board's position with OPLA as well.
- Petition process to overcome this is cumbersome and costly to Appellant.

New findings w/o designating new ground?



Q17&18: PRE-APPEAL REOPENING/ALLOWANCE %S

Q17: Is Pre-appeal reopening/allowance % consistent with your experience?

In response to data from all TCs except TC 2900 showing reopening/allowance percentages post pre-appeal brief ranging between **55%-76.1%**:

Yes: 26

No: 10

Q18: What is your estimate of % of cases being reopened/allowed?

N/A & Don't Know: 8

75%: 3

50% - 70%: 16*

30% - 40%: 9

20% - 25%: 6

10% - <20%: 5

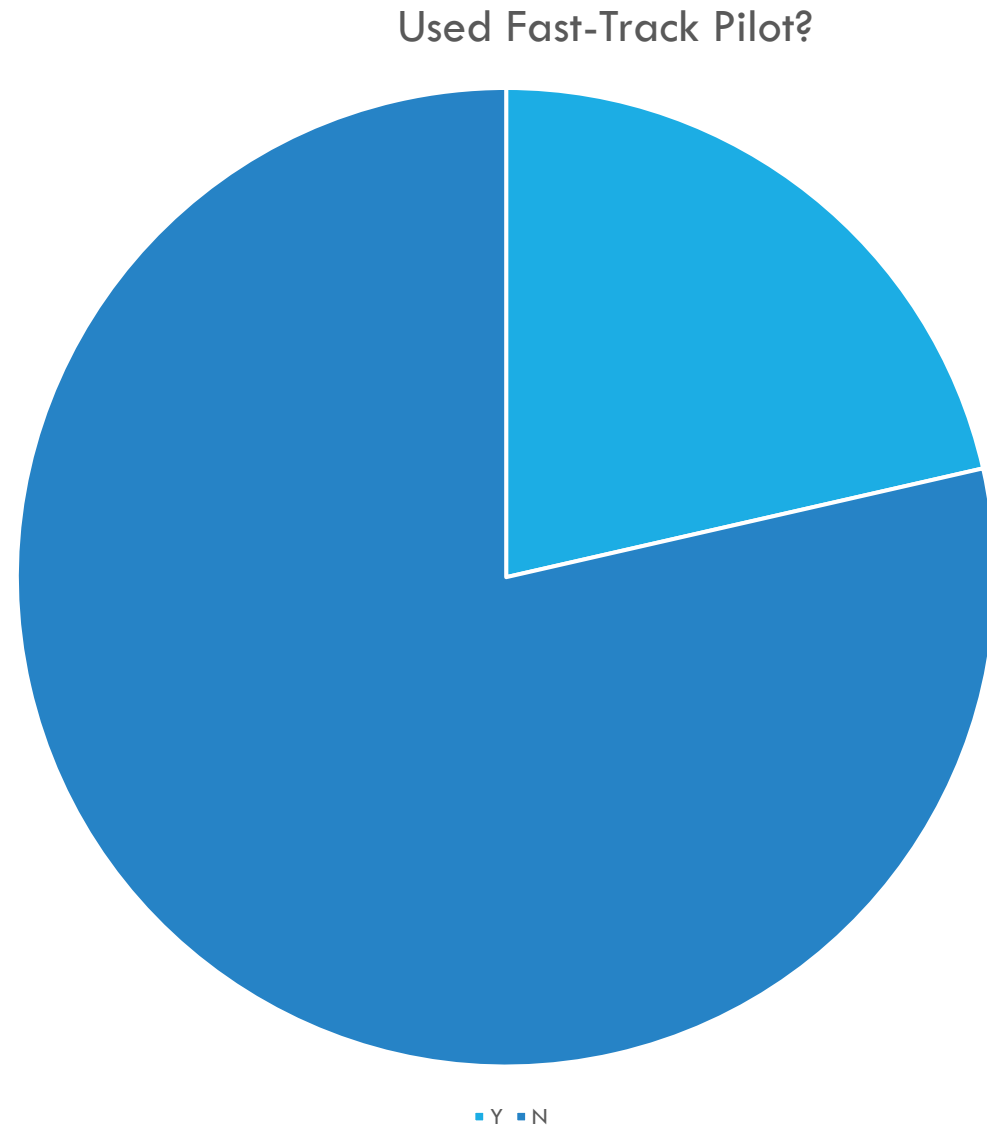
0% - <10%: 8

*Consistent with USPTO data

Q30: USED FAST- TRACK APPEALS PILOT PROGRAM?

Yes: 12

No: 44



Q31: HAS FAST- TRACK AFFECTED DECISION TO APPEAL?

12

- YES

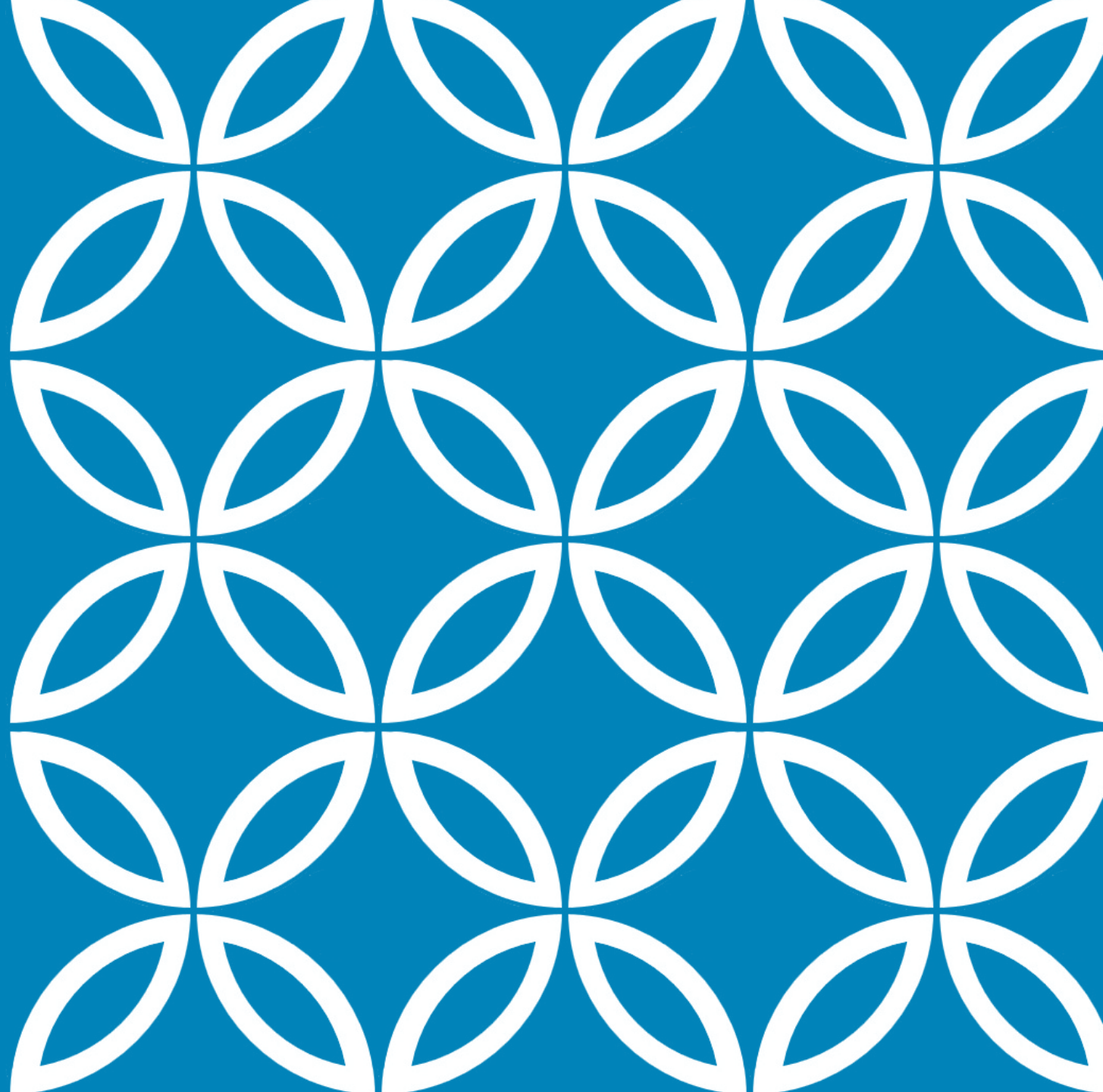
17

- NO

25

- No opinion, N/A, blank, none, Maybe/Don't know/Unknown

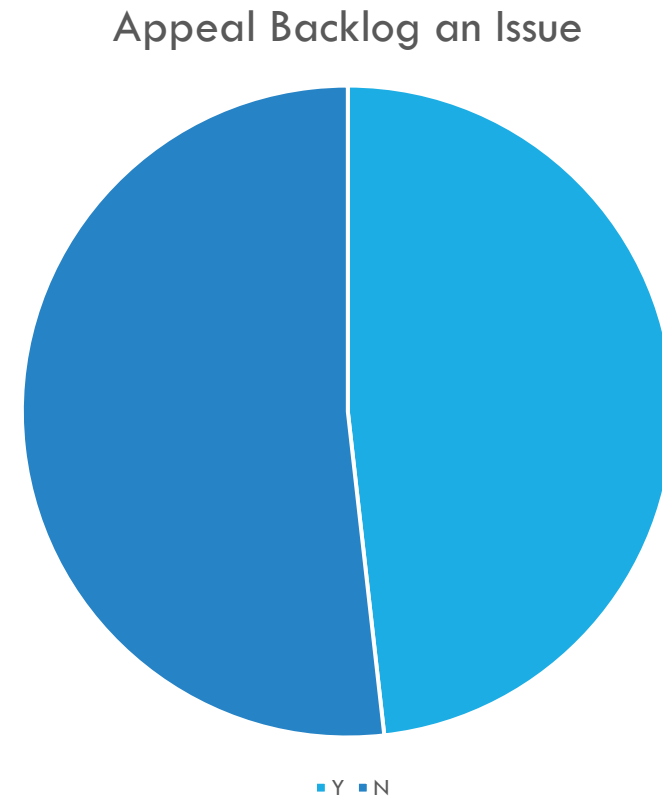
STATISTICS



Q11: APPEAL BACKLOG AN ISSUE?

Yes: 27

No: 29



Q48: ADDITIONAL STATISTICAL DATA DESIRED FROM PTAB

53/56 respondents would like to see data on the rate prosecution is reopened following the filing of:

- Notice of appeal
- Pre-appeal brief
- Appeal brief

48/56 respondents would like to see issue-level reversal rate data for the statutory grounds of rejection (102, 103, 112, etc.)

23/56 respondents would like to see data on the seniority of lead practitioners in an *ex parte* appeal (as indicated by Reg. No.)

20/56 respondents would like to see data based on voluntary disclosure regarding the relevant diversity demographics of practitioners filing and arguing *ex parte* appeals.