Overview of the
USPTO Appeal Process
and
Practice Tips

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Decision Factors for Filing Appeal at USPTO

- Advancement of Prosecution has ground to a halt (e.g., the Examiner maintains or keeps adding new rejections in Office Actions)

- Examiner is being unreasonable and/or ignoring claimed features

- Desire for “supervisory” review of Examiner’s Office Action

- Desire to obtain patent based on current claim scope without further dilution

- Time constraints / strategic time delay – Appeal process may take several years

- Client makes internal management decision to Appeal

- Statistically, there is only @ a 30% chance of reversing the Examiner by filing an Appeal

- Filing and prosecuting Appeal and conducting Oral Hearing is expensive
This bar chart shows Average Pendency of Decided Appeals by Technology Center for Appeals Decided in FY17 to date (Oct 1, 2016 through February 28, 2017). Pendency is measured from date of PTAB docketing (assignment of appeal number) to date of Decision.
This graph shows the total number of ex parte appeals pending at the end of fiscal year 2010 through February 28, 2017, excluding reexamination, reissue and supplemental examination appeals.
Outcomes in Appeals

FY15:
- 56.9% AFFIRMED
- 12.7% AFFIRMED-IN-PART
- 13.2% REVERSED
- 28.6% ADMINISTRATIVE REMANDS
- 0.0% PANEL REMANDS
- 0.1% DISMISSED

FY14:
- 53.6% AFFIRMED
- 12.9% AFFIRMED-IN-PART
- 13.2% REVERSED
- 28.6% ADMINISTRATIVE REMANDS
- 0.0% PANEL REMANDS
- 0.5% DISMISSED

FY16:
- 56.9% AFFIRMED
- 12.9% AFFIRMED-IN-PART
- 28.6% REVERSED
- 0.6% ADMINISTRATIVE REMANDS
- 0.8% PANEL REMANDS
- 0.0% DISMISSED

FY17:
- 55.3% AFFIRMED
- 13.2% AFFIRMED-IN-PART
- 29.8% REVERSED
- 0.1% ADMINISTRATIVE REMANDS
- 0.2% PANEL REMANDS
- 0.6% DISMISSED
Source of Appeal Statistics


Statistics

Periodic summaries of data concerning proceedings before the Patent Trial and Appeal Board, including dispositions, pendency, inventory, and other tracking measures.

- AIA Trial Statistics (graphical)
- Appeals and Interferences (graphical)
- Process Production Report
- Receipts and Dispositions by Technology Center
- Performance Measures
- Dashboards
- PTAB/BJAI Archived Statistics

The Patent Trial and Appeal Board is providing updated graphical AIA Trial Statistics beginning with April 2015. The previous AIA Trial Statistics documents have been placed on the Archive page. If you have any questions about these statistics, you can reach us at 571-272-7822.
Source of PTAB Final Decisions
https://e-foia.uspto.gov/Foia/PTABReadingRoom.jsp
Recent BSKB Appeal Decisions

Total Number of Appeal Case Decisions
January – April, 2017: 9

Affirmation of Examiner’s Rejections: 3

Reversal of Examiner’s Rejections: 5 (1 with new grounds of rejection – 112)

Combination: 1 – Affirmation for 10 claims and Reversal for 6 claims
Recent BSKB Appeal Decisions (Continued)

Total Number of Appeal Case Decisions
January – December, 2016: 55

Affirmation of Examiner’s Rejections: 39

Reversal of Examiner’s Rejections: 12 (1 with new grounds of rejection – 112)

 Denied Decision on Rehearing: 1

Granted-In-Part Decision of Rehearing: 1
Recent BSKB Appeal Decisions (Continued)

Total Number of Appeal Case Decisions
January – December, 2015: 11

Affirmation of Examiner’s Rejections: 5

Affirmed-In-Part of Examiner’s Rejections: 1

Reversal of Examiner’s Rejections: 1

Denied Decision on Rehearing: 4
Appeals – General Process

1. Notice of Appeal & Fee
2. Appeal Brief
3. Examiner’s Answer
   - Reply Brief (optional)
   - Request for Oral Hearing & Fee (optional)
4. Appeal Brief Forwarding Fee
5. Decision by Board
   - Oral Hearing (if requested)
6. Completion of Appeal Process
   - Request for Rehearing (optional)
Requirements for Filing Appeal at USPTO


(a) PATENT APPLICANT.— An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Patent Trial and Appeal Board, having once paid the fee for such appeal.

(b) PATENT OWNER.— A patent owner in a reexamination may appeal from the final rejection of any claim by the primary examiner to the Patent Trial and Appeal Board, having once paid the fee for such appeal.
37 CFR 41.37 Appeal brief.

(a) Timing. Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31. The appeal brief fee in an application or ex parte reexamination proceeding is $0.00, but if the appeal results in an examiner's answer, the appeal forwarding fee set forth in § 37 CFR 41.20(b)(4) must be paid within the time period specified in § 41.45 to avoid dismissal of an appeal.

(b) Failure to file a brief. On failure to file the brief within the period specified in paragraph (a) of this section, the appeal will stand dismissed.
## Requirements for Filing Appeal at USPTO (Continued)

### Patent Trial and Appeal Fees

<table>
<thead>
<tr>
<th>Fee Code</th>
<th>37 CFR</th>
<th>Description</th>
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<th>Small Entity Fee</th>
<th>Micro Entity Fee</th>
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<td>1,000.00</td>
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Pre-Appeal Brief Conference Pilot Program

- Offers applicants an avenue to request that a panel of Examiners formally review the legal and factual basis of the rejections in their application prior to the filing of an appeal brief.

- The Examiner's rejection is reviewed prior to the actual filing of an appeal brief.

- The program is intended to spare applicants the added time and expense of preparing an appeal brief if a panel review determines an application is not in condition for appeal.

- May save both the resources of the applicant and the Office.
- Under the current practice every applicant whose claims have been twice rejected may appeal the examiner's decision to the Board of Patent Appeals and Interferences.

- To do so, the applicant first files a notice of appeal accompanied by the appropriate fee within the appropriate time period.

- Within two months from the date of the filing of the notice of appeal, applicant must file an appeal brief accompanied by the appropriate fee.

- Applicants may buy extensions of time for filing the appeal brief.
Pre-Appeal Brief Conference Pilot Program (Continued)

- This pilot program offers applicants an opportunity to request a review of identified matters on appeal employing an appeal conference currently employed in the Office, but prior to the filing of an appeal brief.

- The goals of the program are to identify the presence or absence of clearly improper rejections based upon error(s) in facts, or to identify the omission or presence of essential elements required to establish a prima facie rejection.

- Any applicant who has filed a notice of appeal and who wants a panel of experienced examiners to perform a detailed review of appealable issues within a set period of time.
Pre-Appeal Brief Conference Pilot Program (Continued)

How to decide if you should request this panel review?

- If the applicant feels the rejections of record are clearly not proper and are without basis, then filing this request may result in a panel decision that eliminates the need to file an appeal brief.

- This should be based upon a clear legal or factual deficiency in the rejections rather than an interpretation of the claims or prior art teachings. The latter is more appropriate for the traditional appeal process currently employed by applicants.
Pre-Appeal Brief Conference Pilot Program (Continued)

What happens during a panel review?
A panel of examiners (including the examiner of record) will consider the merits of each ground of rejection for which appeal has been requested and will issue a written decision as to the status of the application.

When should you file an appeal brief or other correspondence?
This program is designed to allow applicants who think there is a clear deficiency in the prima facie case in support of a rejection to file the request at the same time that they file a notice of appeal. This affords the Office the best opportunity to ensure that applicant will promptly receive a decision on the request.
Pre-Appeal Brief Conference Pilot Program (Continued)

- During the panel review, a panel of examiners (including the examiner of record) will consider the merits of each ground of rejection for which appeal has been requested and will issue a written decision as to the status of the application.

- This program is designed to allow applicants who think there is a clear deficiency in the prima facie case in support of a rejection to file the request at the same time that they file a notice of appeal.

- If the request is filed with the notice of appeal, the period of time for filing the appeal brief will be the later of the two-month period set in 37 CFR 41.37(a) or one month from the mail date of the decision on the request.
If applicant files any of the following responses after filing a request, but prior to a decision by the appointed panel of examiners assigned to conduct the review, the review process will end and a decision will not be made on the merits of the request:

- an appeal brief
- a request for continued examination (RCE)
- an after-final amendment
- an affidavit or other evidence
- an express abandonment

A request for the declaration of an interference will also result in an end to the review process.
Content of Appeal Brief

(i) **Real party in interest.** A statement identifying by name the real party in interest at the time the appeal brief is filed, except that such statement is not required if the named inventor or inventors are themselves the real party in interest. If an appeal brief does not contain a statement of the real party in interest, the Office may assume that the named inventor or inventors are the real party in interest.

(ii) **Related appeals, interferences, and trials.** A statement identifying by application, patent, appeal, interference, or trial number all other prior and pending appeals, interferences, trials before the Board, or judicial proceedings.

(iii) **Summary of claimed subject matter.** A concise explanation of the subject matter defined in each of the rejected independent claims, which shall refer to the specification in the Record by page and line number or by paragraph number, and to the drawing, if any, by reference characters.
(iv) **Argument.** The arguments of appellant with respect to each ground of rejection, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the Record relied on.

The arguments shall explain why the examiner erred as to each ground of rejection contested by appellant. Except as provided for in §§ 41.41, 41.47 and 41.52, any arguments or authorities not included in the appeal brief will be refused consideration by the Board for purposes of the present appeal.

Each ground of rejection contested by appellant must be argued under a separate heading, and each heading shall reasonably identify the ground of rejection being contested (*e.g.*, by claim number, statutory basis, and applied reference, if any).

For each ground of rejection applying to two or more claims, the claims may be argued separately (claims are considered by appellant as separately patentable), as a group (all claims subject to the ground of rejection stand or fall together), or as a subgroup (a subset of the claims subject to the ground of rejection stand or fall together).
Content of Appeal Brief (Continued)

(iv) Argument (Continued)
When multiple claims subject to the same ground of rejection are argued as a group or subgroup by appellant, the Board may select a single claim from the group or subgroup and may decide the appeal as to the ground of rejection with respect to the group or subgroup on the basis of the selected claim alone.

Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately.

Under each heading identifying the ground of rejection being contested, any claim(s) argued separately or as a subgroup shall be argued under a separate subheading that identifies the claim(s) by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

(v) Claims appendix. An appendix containing a copy of the claims involved in the appeal.
Content of Appeal Brief (Continued)

Notice of non-compliance. If a brief is filed which does not comply with all the requirements of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not, within the set time period, file an amended brief that overcomes all the reasons for non-compliance stated in the notification, the appeal will stand dismissed. Review of a determination of non-compliance is by petition to the Chief Administrative Patent Judge.
USPTO’s Practice Tips for Writing Effective Appeal Briefs

Appeal Briefs, 37 C.F.R. § 41.37
- Present only the strongest arguments.
- Do not dilute strong arguments by including weaker arguments or arguments that have no bearing on the issues in the case.

- Strategically group claims to highlight the strongest arguments in the case.
- Give careful thought to which claims you choose to argue separately so that weaker arguments do not dilute stronger arguments.
- For those claims argued separately, place such arguments under separate sub-headings.
- If the same arguments are being made for patentability of two or more independent claims, argue these claims as a group under a single heading.
USPTO’s Practice Tips for Writing Effective Appeal Briefs (Continued)

Appeal Briefs, 37 C.F.R. § 41.37
- *Develop the facts of your case to show how the law applies to achieve the result being sought.*
- Set out the standard for the legal theory you seek to have applied, and then provide arguments or evidence to demonstrate the legal theory applies to the case before the Board.
- Clearly address the examiner's rejection as articulated in the rejection on appeal and point the Board to the alleged error in that rejection.
- *Understand the burden of proof.*
- Recognize when the burden of proof shifts to appellant and provide arguments to show why the burden should not be shifted or evidence to rebut the examiner's findings and meet the burden of proof.
USPTO’s Practice Tips for Writing Effective Appeal Briefs (Continued)

Appeal Briefs, 37 C.F.R. § 41.37
- Define key claim terms.

- Acknowledge when an issue turns on claim construction and provide an interpretation for the key claim terms with a basis for the interpretation under the "broadest reasonable interpretation" standard.

- Demonstrate why the examiner's interpretation is not "reasonable."

- Support arguments with evidence.

- Attack examiner’s motivation statements (see following example)
USPTO’s Practice Tips for Writing Effective Appeal Briefs (Continued)

The Board typically does not review matters within the examiner's discretion (i.e., objections to the figures or specification, restriction requirements, refusal to enter an amendment, etc.). These matters are decided by the Director on petition. See MPEP § 1002.

*Use Summary of Claimed Subject Matter to support your appeal*

The Board uses the Summary of Claimed Subject Matter portion of the appeal brief to understand the claimed invention and how the claim elements correspond to the drawing elements and the description in the specification. This section is particularly important when the claim recites elements in § 112(f) (means-plus-function) format.
USPTO’s Practice Tips for Writing Effective Reply Briefs

Reply Briefs, 37 C.F.R. § 41.41

*Use reply briefs to respond to points raised in the Examiner's Answer*

Do not reiterate arguments presented in appeal brief.

Use the reply brief to reply to specific findings made, or positions taken, by the examiner in the answer, or to address intervening case law relevant to the issues on appeal.

Do not raise new arguments in a reply brief that are not responsive to arguments made in the examiner's answer.

Do not separately argue claims for the first time in a reply brief.
Example - Attacking motivation statements

**Examiner’s “Generic” Motivation Statements**

*CC to the UE to transport information from the BS to the UE*. It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Lindoff within the system of Bala and Pelletier to obtain the claimed invention because to acquire the knowledge taught by the reference material and to make adjustment accordingly, has been held that the provision of adjustability, where needed, involves only routine skill in the art. This is important for a base station and UE to exchange information regardless the status of the first DL CC (anchor CC)).

*Transmit one or more HARQ retransmissions on a different carrier*. It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Pelletier within the system of Bala to obtain the claimed invention because to acquire the knowledge taught by the reference material and to make adjustment accordingly, has been held that the provision of adjustability, where needed, involves only routine skill in the art. This is important for a base station and UE to exchange feedback on the status of the received information on either end).
Preparing for Oral Hearings

37 CFR 41.47 Oral hearing.

(a) An oral hearing should be requested only in those circumstances in which appellant considers such a hearing necessary or desirable for a proper presentation of the appeal. An appeal decided on the briefs without an oral hearing will receive the same consideration by the Board as appeals decided after an oral hearing.

(b) If appellant desires an oral hearing, appellant must file, as a separate paper captioned "REQUEST FOR ORAL HEARING," a written request for such hearing accompanied by the fee set forth in § 41.20(b)(3) within two months from the date of the examiner's answer or on the date of filing of a reply brief, whichever is earlier.

(c) If no request and fee for oral hearing have been timely filed by appellant as required by paragraph (b) of this section, the appeal will be assigned for consideration and decision on the briefs without an oral hearing.
Preparing for Oral Hearings (Continued)

37 CFR 41.47 Oral hearing.

(d) If appellant has complied with all the requirements of paragraph (b) of this section, a date for the oral hearing will be set, and due notice thereof given to appellant. If an oral hearing is held, an oral argument may be presented by, or on behalf of, the primary examiner if considered desirable by either the primary examiner or the Board. A hearing will be held as stated in the notice, and oral argument will ordinarily be limited to twenty minutes for appellant and fifteen minutes for the primary examiner unless otherwise ordered.

(e)

(1) Appellant will argue first and may reserve time for rebuttal. At the oral hearing, appellant may only rely on Evidence that has been previously entered and considered by the primary examiner and present argument that has been relied upon in the brief or reply brief except as permitted by paragraph (e)(2) of this section. The primary examiner may only rely on argument and Evidence relied upon in an answer except as permitted by paragraph (e)(2) of this section.

(2) Upon a showing of good cause, appellant and/or the primary examiner may rely on a new argument based upon a recent relevant decision of either the Board or a Federal Court.
Preparing for Oral Hearings (Continued)

37 CFR 41.47 Oral hearing.
If appellant has any special request, such as for a particular date, day of the week, or afternoon vs. morning hearing session, this will be taken into consideration in setting the hearing, if made known to the Board in advance, as long as such request does not unduly delay a decision in the case and does not place an undue administrative burden on the Board.

The appellant may also file a request, in a separate paper addressed to the Clerk of the Board, to present his/her arguments via telephone or an audio-video connection. The appellant making the request will be required to bear the cost of the telephone call or the audio-video connection. Prior to the hearing date, the Board’s IT specialist may contact the appellant making an audio-video request to confirm software compatibility.

The appellant may file a request, in a separate paper addressed to the Clerk of the Board, to use a projector while presenting his/her arguments (e.g., for a PowerPoint® presentation). The Office may provide a projector for the appellant’s use subject to availability. The appellant making the request is responsible for providing his or her own laptop or mobile computer.
Preparing for Oral Hearings (Continued)

37 CFR 41.47 Oral hearing.
If the time set in the notice of hearing conflicts with prior commitments or if subsequent events make appearance impossible, the hearing may be rescheduled on written request, in a separate paper addressed to the Clerk of the Board. However, in view of the administrative burden involved in rescheduling hearings and the potential delay which may result in the issuance of any patent based on the application on appeal, postponements are discouraged and will not be granted in the absence of convincing reasons in support of the requested change.

Normally, 20 minutes are allowed for appellant to explain his or her position. If appellant believes that additional time will be necessary, the appellant should file a request in a separate paper addressed to the Clerk of the Board well in advance of the hearing. The request for such time will be taken into consideration in assigning the hearing date. The final decision on whether additional time is to be granted rests within the discretion of the senior member of the panel hearing the case.

At the oral hearing, appellant may only rely on evidence that has been previously entered and considered by the primary examiner and present arguments that have been relied upon in the brief or reply brief. Upon a showing of good cause, appellant and/or the primary examiner may rely on a new argument based upon a recent relevant decision of either the Board or a Federal Court.
Oral Hearings – Practice Tips

Prepare a written script.

Prepare visual aids as needed and consider filing Exhibits to refer to.

Remember - 20 minutes are typically allotted for presenting arguments (ask for more time if interrupted with questions and/or at the beginning of the hearing).

Be prepared to answer questions regarding advantages of claimed features upon which patentability is relied upon, or other “off-base” questions unrelated to the pending rejections.
EXHIBIT B:  
COLOR-CODED CORRELATION OF PRIOR ART REFERENCES APPLIED BY THE EXAMINER TO FEATURES OF INDEPENDENT CLAIM 18

[Bala et al. (U.S. Publication No. 2010/0227569)]

18. (Previously Presented)  A method for receiving data by a base station (BS) in a wireless access system supporting multi-carriers, the method comprising:

transmitting an uplink (UL) grant information for a first UL component carrier (CC) to a user equipment (UE) through a first downlink (DL) CC among a plurality of DL CCs.

[Lindoff et al. (U.S. Patent No. 8,699,467)]

wherein the first UL CC is linked with a second DL CC other than the first DL CC:

[Pelletier et al. (U.S. Publication No. 2009/0300456)]

receiving UL data from the UE through UL resources of the first UL CC indicated by the UL grant information;

determining a reception status of the received UL data; and
Oral Hearings – Examples of Visual Aids (Cont.)

EXHIBIT E: COLUMN 2, LINES 31-63 OF LINDOFF ET AL. (U.S. PATENT NO. 8,699,467) AND EXCERPTS FROM OFFICE ACTION AND EXAMINER’S ANSWER

The user equipment can periodically rather than continuously monitor the base station. The periodic monitoring helps to reduce power consumption on the user equipment since the user equipment are not continuously monitoring the base station.

In an embodiment, the triggering event generally occurs when at least one of the current non-anchor carriers is better than or at least one of the current anchor carriers. When the non-anchor carrier becomes one of the new anchor carriers, the user equipment of the current non-anchor carrier is sufficient by itself, then it can be the sole anchor carrier. Thus all anchor carriers, can to be put into the power conservation mode, such as being turned off or running in a periodic monitoring.

Note that minimizing the number of anchor carriers for the user equipment also has the benefit of enhancing system capacity since less resources (less number of carriers) have to be devoted to the user equipment.

Other concepts can be used to multiple base stations. These concepts can be extended to multiple base stations. For example, the user equipment can request a selection of anchor carrier(s) from each base station. Then the user equipment can be implemented to switch to the second or third component carrier.

In other aspects, the base station itself can initiate switching of anchor carriers for load management purposes. Also, carrier hopping defined sequence of anchor carrier(s) changes over time for a user equipment. The carrier hopping can be especially useful for fast moving user equipment.

From pages 4 and 5 of May 5, 2014 Office Action

The first DL CC, however, Lindoff teaches wherein the first DL CC is always mapped to the scheduled UL CC, however, when the quality report related to the DL CC is allocated to the UE to take the place of the first DL CC and linked to the scheduled UL CC no the user equipment and then the UE sends the knowledge to exchange information regardless of the status of the first DL CC (anchor CC).
Oral Hearings – Practice Tips (Continued)
Source – USPTO Website: “Oral Advocacy before the Patent Trial and Appeal Board”

You and your client have decided that your case pending before the Patent Trial and Appeal Board (“Board”) would benefit from an oral hearing in front of a panel of Administrative Patent Judges¹ who have been assigned to decide the case. To prepare for the oral hearing, here is a set of suggestions, from A to F, to help maximize the effectiveness of your presentation.

¹ While a panel normally consists of three judges, a panel may consist of more than three judges, and some of the panel members may be participating in the oral hearing by video.
Answer the question being asked. While your prepared presentation undoubtedly focuses on the points that you find most important, those may not be the areas of greatest concern for the judges. Be prepared to deviate from your prepared presentation to answer the questions asked by the panel. Rather than brush off inquiries, embrace questions as an opportunity to explain why the issue favors your position, or at least is not as harmful to your position as it might appear on its face. Not answering questions is one of the quickest ways to lose credibility with the panel. If you think the question is not relevant, provide an explanation to that effect, but then still provide an answer to the question asked.
Begin the conversation with the critical issues, not extensive background information. The judges are familiar with the record. If a specific background point is very relevant, discuss it, but do not give a detailed history of the technology behind the invention — unless the judges ask for it, of course. Remember to limit your discussion and arguments to the information in the record. The panel will not entertain arguments and evidence that are presented for the first time during oral hearing.
Consider whether demonstrative exhibits will be useful to your presentation. Because new arguments are not permitted during the hearing, exhibits should be limited to evidence and arguments of record. In some cases, however, where the record reflects a clear misunderstanding or impasse, demonstratives supported by the record may help resolve the matter. Demonstratives that may be particularly helpful may include pages from the record, such as figures, with appropriate highlighting. And when referring to the demonstratives during the oral hearing, refer to the specific slide number, rather than saying “next slide,” as that makes it easier for the judges, especially those judges participating in the video remotely, to follow the argument. On the other hand, do not be overly reliant on your demonstratives lest the panel pays more attention to your exhibits than to what you are saying.
Do not avoid the difficult issues. The judges will be most interested in the weakest parts of your case, because those are the points on which the outcome of the case may turn. Be prepared to explain why the apparent weakness does not change the legal conclusion for which you are arguing.

Ensure that you are familiar with the entire record, not just those portions essential to your argument. There may be something in the specification, a declaration, or in one of the cited references, that supports or refutes your arguments, but is identified by a party only in passing. It may, however, be very important to a judge. Also, your argument may raise other issues that require evaluation of additional parts of the record. If those types of questions arise, the judges on the panel will be interested in your informed and confident view of those issues.
Focus on your substantive arguments, based on the evidence of record, and where and how you have relied on that evidence, rather than arguments about the process that led you to the Board. For example, for appeals from adverse examiner decisions, the Judges are aware that patent prosecution is not always easy or straightforward. But the remedy for perceived prosecution errors, such as improper restrictions, premature final rejections, or refusal by the examiner to follow proper procedure, is by way of petition to the Director, and not by appeal to the Board. The decision of the panel will be based on the facts as developed in the record. Nearly all patentability issues are resolved based on the particular facts of your case—very few require or even invite an extension of or a new gloss on the law—so focus on the facts in the record, and explain why they support a determination of reversible error in the appealed rejection.
Other Issues Regarding Appeals

- If there is a continuation application pending, it may be desirable to drag out/suspend prosecution until a decision is received from the PTAB on the parent case.

- Beware of possible Examiner retaliation for reversal of Examiner by PTAB (e.g., unreasonable “112” rejections applied to claims in continuation application).

- Results of Appeal cases, in client’s view, may reflect on law firm’s performance in general.
Source for Additional Information on Oral Hearings
