

# Pre-Appeal Brief Panels Should Allow More Applications Rather Than Reopening Prosecution



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By now, patent prosecutors should be aware of the PTO's Pre-Appeal Brief Conference Program. This Program "offers applicants an opportunity to request a review of identified matters on appeal [by a three member Panel] employing an appeal conference currently employed by the Office, but prior to the filing of an appeal brief."<sup>1</sup> Many Pre-Appeal Brief Panel decisions "reopen prosecution." In many instances, however, the applications should be allowed instead of prosecution merely being reopened. This would be more consistent with the Office's own rules, less expensive for applicants, and also assist in reducing the Office's backlog of applications.

## FOUR POSSIBLE PANEL DECISIONS

The purpose and mechanics of the Pre-Appeal Program are explained in *Suggestions for the Pre-Appeal Brief Conference Pilot Program*, Intellectual Property Today, Volume 12, No. 12, page 24 (December, 2005). In short, after a Panel has reviewed a Pre-Appeal Brief Request for Review (the "Request"), the Panel issues one of four decisions:

- (1) Improper Request – The Request is improper and a con-

ference will not be held because a Notice of Appeal was not concurrently filed with the Request, the Request does not include reasons why a review is appropriate, a proposed amendment is included with the Request, or "Other."

- (2) Proceed to the Board of Patent Appeals and Interferences – . . . The application remains under appeal because there is at least one actual issue for appeal. . . .
- (3) Allowable application – A conference has been held. The rejection is withdrawn and a Notice of Allowance will be mailed. Prosecution on the merits remains closed. No further action is required by applicant at this time.
- (4) Reopen Prosecution – A conference has been held. The rejection is withdrawn and a new Office Action will be mailed. No further action is required by applicant at this time.<sup>2</sup>

While I am not aware of any PTO statistics regarding the frequency of these decisions, in my experience, the majority of these decisions result in the reopening of prosecution. Often, after a particular Panel decision to reopen prosecution issues, a subsequent Office Action simply replaces rejections from a previous final Office Action with completely new rejections that cite new prior art.

## WHY REOPEN PROSECUTION WHEN THE CASE SHOULD BE ALLOWED?

A decision to "reopen" prosecution and issuance of a subsequent Office Action often run afoul of the principles of compact prosecution. In particular, the Manual of Patent Examining Procedure (MPEP) at § 2106(II) states the following:

It is essential that patent applicants obtain a prompt yet complete exami-

nation of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, USPTO personnel should state all reasons and bases for rejecting claims in the first Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, USPTO personnel should indicate how rejections may be overcome and how problems may be resolved. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

The MPEP is clear – **all reasons and bases** for rejecting claims of an application should be set forth in the first Office Action. At least in theory, the "best" reasons and bases are logically included within "all" the reasons and bases for rejecting the claims (i.e., the "best" are subsumed by "all").

When a Panel decision reopens prosecution and a subsequent Office action rejects the claims based on new prior art, the principles of compact prosecution are unquestionably undermined. Moreover, the subsequent Office Action (that includes new rejections citing new art) implies that the initial examination was violated in at least two ways: (1) a prima facie case of unpatentability was not established, and (2) all reasons and bases for rejecting the claims were not set forth in the previous Office actions.

## FILING AN ADDITIONAL REQUEST AFTER PROSECUTION REOPENS

If an Examiner performs a supplemental search and finds a new and more relevant reference, it makes sense that the reference should be cited in the post-Panel decision Office Action. In my experience, however, numerous new references cited in post-Panel decision Office Actions are less relevant than the originally cited art. Thus, an applicant is most likely forced into a new round of less productive prosecution, which

obviously costs the applicant (and the Office) time and resources.

In a recent application, after a first round of prosecution, I drafted and filed a Pre-Appeal Brief Request for Review, along with a Notice of Appeal. The Panel issued a decision that reopened prosecution. The Examiner subsequently issued an Office Action that cited new art and was weaker than the previous final action. The Examiner stuck to his guns during the second round of prosecution and refused to reconsider the rejections. I eventually filed a Second Pre-Appeal Brief Request for Review. After considering the Second Request, the Panel allowed the application. Of course, not every case is as difficult, or easy for that matter, as this one.

In another application, for example, I filed four Requests. After each Panel decision, the Examiner issued a new Office Action with increasingly weaker rejections and less relevant cited references. It seemed like the Panel and Examiner viewed the process as a war of attrition. The Panel's and Examiner's actual and/or perceived motives notwithstanding, the process clearly violated the principles of compact prosecution.

As a side note, when filing a Second Pre-Appeal Brief Request for Review, keep in mind that no additional fee is required for the accompanying Second Notice of Appeal – the fee for the Notice is already paid.<sup>3</sup> Additionally, a friendly reminder to the Panel that the applicant is filing a **Second** Pre Appeal Brief Request for Review coupled with a polite request for allowance may help persuade the Panel to allow the application.

## PRE-APPEAL BRIEF REQUESTS SAVE TIME AND RESOURCES

Some may suggest simply going forward with a full appeal if an Examiner persists in citing less relevant art. Prosecution can also be reopened after the filing of an Appeal Brief.<sup>4</sup> An Appeal Brief, however, involves much more preparation time and expense than a Pre-Appeal Brief Request for Review.

If prosecution is reopened (whether after a Panel decision or the filing of an Appeal Brief), an applicant can either enter a new round of prosecution with the Examiner, or the applicant can “initiate a new appeal by filing a new notice of appeal under 37 CFR

41.31.”<sup>5</sup> Further, if a new Notice of Appeal is filed, an applicant may also file a new Pre-Appeal Brief Request for Review along with the new Notice of Appeal. If a Pre Appeal Brief Request results in an allowance or reopening of prosecution, the applicant is spared the expense of drafting an Appeal Brief. If, however, the Panel decides that the case is ripe for appeal, then the applicant is still able to file an appeal brief, and has spent a relatively small amount (when compared to drafting an Appeal Brief) for the Request.

In my opinion, if an applicant decides to appeal a final rejection, a Pre- Appeal Brief Request for Review should be filed as a matter of course before an Appeal Brief. The advantage to such a practice is that the application may be allowed, or prosecution reopened, without the costs and time associated with preparing an Appeal Brief.

## ALLOWING APPLICATIONS SAVES THE PTO AND THE APPLICANT TIME AND RESOURCES

In light of recent Office proposals to limit an applicant to a certain number of continuations and RCEs, it is crucial for applicants to consider appealing final rejections. An Appeal is not a continuation or RCE, and, therefore, will not count against any arbitrary limits the Office may impose with respect to continuation or RCE practice. The Pre-Appeal Brief Program provides an applicant an opportunity to streamline the Appeal process by obviating the need to file an Appeal Brief.

When a post-Panel decision Office Action rejects claims of an application with completely different art, the Panel must have determined that the claims were not anticipated or rendered unpatentable by art cited in the final Office Action. So then the ultimate question is, at what point will a Panel simply allow an application? In my view, an application should be allowed if the Panel decides that the art used in the final Office action has clearly been overcome (i.e., it is clear that the claims are allowable over the cited art). The art cited in the final Office action is, theoretically, the best art the Examiner could find (per MPEP § 2106(II)). There is no reason to think that the Examiner will find better art if given another chance. It is true that the Examiner **may** find better art if given multiple search opportunities, but such a pos-

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sibility always exists, whether the Examiner has performed one, two, or even many searches. At some point, the process of examination needs to cease and the application be allowed.

The process of “whack-a-mole” prosecution in which an Examiner continually dredges up weaker and weaker prior art is inefficient and expensive both to the applicant and the Office. Panel decisions that allow applications preempt this process and help reduce the oppressive examination backlog of which the Office continually complains. For these reasons alone, Pre Appeal Brief Panels should be more willing to allow applications, as opposed to merely reopening prosecution. **IPT**

## ENDNOTES

1. See *New Pre-Appeal Brief Conference Pilot Program*, 1296 OG 2 (July 12, 2005)
2. See PTO Notice of Panel Decision (Document APPRE.DOC).
3. See MPEP § 1207.04 (“If appellant elects to continue prosecution and prosecution was reopened prior to a decision on the merits by the Board of Patent Appeals and Interferences, the fee paid for the notice of appeal, appeal brief, and request for oral hearing (if applicable) will be applied to a later appeal on the same application.”)
4. See *id.* (“The examiner may, with approval from the supervisory patent examiner, reopen prosecution to enter a new ground of rejection after appellant’s brief or reply brief has been filed.”)
5. See *id.*