



## *Ex Parte* PTAB Appeals Strategies for Success

Courtenay C. Brinckerhoff  
Foley & Lardner LLP

**FOLEY**  
FOLEY & LARDNER LLP

### When Is A Case Ready For Appeal?

- Claims twice rejected (35 USC § 134(a))
- At an impasse on the merits of rejections
- All evidence is of record
- All claim amendments have been presented and entered
- All fall back positions are embodied in pending claims

## Pre-Appeal Brief Review?

- At most a few clear-cut issues underlying the rejection(s)
- Limited to 5 pages of arguments
- Must be filed with Notice of Appeal
- Appeal Brief deadline will be measured from date of decision

## Appeal Brief Strategies

- Use 37 C.F.R. § 41.37 as a template
- Identify claims to be argued separately
- Address each rejection under a separate heading
- Address separately argued claims under separate subheadings
- Include cited references and evidence in Evidence Appendix

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14<sup>th</sup> Annual Advanced Patent Law Institute session

"Ex Parte Appeals Practice"