



# *Ex Parte* PTAB Appeals Strategies for Success

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## Appeal Timeline (USPTO Large Entity Fee)

- Notice of Appeal (\$840)
- Appeal Brief
  - due 2 mos. from NOA, extendable up to 5 mos.
- Examiner's Answer
  - Earn PTA if received more than 4 mos. after Appeal Brief
- Appeal Forwarding Fee/Opt'I Reply Brief/Opt'I Request for Oral Hearing
  - Due 2 months from Examiner's Answer (not extendable)
  - Appeal Forwarding Fee: \$2360
  - Oral Hearing Fee: \$1360
- Appeal Docketing Notice
  - Once received, can file petition for Fast Track Appeal (\$420)
- Optional Oral Hearing
- Decision
- Total average pendency: 13-15 months (current statistics: 13.3 months)

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## 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

## When Is A Case Ready For Appeal?

- With shorter appeal pendency, appeal may be more viable option than previously
- Avoid PTA impacts of RCE

*Chudik v. Hirshfeld*  
(Fed. Cir. Feb. 8, 2021)

The Examiner reopened prosecution after an Appeal Brief **four times** over three years; an early RCE prevented recouping PTA for some of that time.

## 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 on request for pre-appeal brief review.

## 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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## Title search: Ex Parte PTAB Appeals: Strategies for Success

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16<sup>th</sup> Annual Advanced Patent Law Institute session  
"Best Practices for Ex Parte Appeals"