

Better Prosecution Using *Ex Parte* Appeals December 9, 2021

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The goal of patent prosecution is to obtain the broadest claims in order to stop competitors. But it involves a negotiation with the patent examiner, who has a very different goal of trying to narrow the claims to differentiate from prior art.

Patent prosecution in the US can be a "paper fight" between the applicant and the examiner. During this back and forth the applicant typically amends the claims in each response to help advance prosecution and move the case toward allowance. However, the applicant only has the right to one amendment before the examiner can issue a final rejection and push the applicant to file a Request for Continued Examination (RCE). Examiners like RCEs because they get credit for a new examination each time one is filed. In the face of examiner rejections, many applicants give in to the use of RCEs.

According to the USPTO, the total pendency excluding RCEs (i.e., the average number of months from the patent application filing date to the ultimate disposal of the application) is about 28.6 months, while the pendency of applications which include at least one RCE is 46.4 months. Therefore, filing RCE typically means lengthy waiting.

There is an alternative to using RCEs. When there is a stalemate with respect to the desired coverage, the better option is an *ex parte* appeal to take the case out of the examiner's hands. An applicant can

file a notice of appeal once any claim has been twice rejected and then has two months to file an appeal brief. Only after a supervisory patent examiner agrees with the examiner that the rejections should be maintained does the appeal proceed and the examiner files an answer to the appeal brief.

The applicant then has two months to file a reply brief, which only then confers jurisdiction to the PTAB. The applicant can also request an oral hearing. Once the briefs and any oral argument have been considered, the PTAB issues its decision, which may reverse the examiner in whole or in part, affirm the examiner, or even set forth new grounds of rejection.

However, a substantial number of appeals do not reach the PTAB. In many cases, the examiner does not even file an answer. Examiners (or their supervisors) may be convinced by arguments in the appeal brief and immediately allow the application. Examiners may also reopen prosecution. In either situation, the appeal has been successful in removing the outstanding rejections and advancing prosecution.

The most obvious benefits of the appeal process are that there is no need to further limit the claims to advance prosecution. Similarly, there is less potential prosecution history disclaimer. In addition, patent term extensions are an often-overlooked benefit because any time spent waiting for the PTAB to issue a decision could be added to the patent term. Contrast this with RCEs, where the time spent waiting simply reduces the patent term.

Appeals are also quite successful. According to USPTO, the cases reversed or partly reversed are generally around 40%. At WHIPgroup, we have over an 80% success rate on appeal, meaning that in 4 out of 5 cases the examiner is reversed by the PTAB, typically leading to a Notice of Allowance. Moreover, the costs of appeal are comparable to inefficient prosecution, since it will avoid multiple office actions and an RCE.

Ex parte appeals should be part of any patent prosecution strategy. A good appeal has a high chance of success and will result in broader protection, which is the end-goal of all patent prosecution. An appeal should be pursued whenever there is a strong argument that at least one claim is novel, which means it is helpful to have a strategy for dependent claims. And an Appeal means that the applicant did not have to further limit claim scope.

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