

PTO PROCEDURES

AIPLA PPT b– AUGUST 12, 2004

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Continuation Applications, RCEs, Appeals, Petitions, Interferences, Public Use Proceedings, Determinations, and Oppositions

Excludes ‘corrective procedures’
(reexam, reissue, cert.
correction), and excludes details
of division and restriction practice²

GENERAL OUTLINE

- REVIEW PTO PROCEDURES
- DRAW CONCLUSIONS
- APPLY TO FACT PATTERN

Continuation Application Practice

- Definition
- Continuation specific advice
- 35 USC 102(e) effect

Continuation Definition

- (1) claim to priority to a prior (non-provisional) application
- (2) that has continuity in inventorship, pendency, and disclosure
- (3) arguably - no new matter *



Continuation Definition

Distinguish from priority to:

- a CIP
- a Provisional
- a Foreign application
- But, applies to **PCT**

Continuation of a PCT

By treaty, a PCT application designating the U.S. has the effect of a U.S. national application...*except* for purposes of 102(e). See U.S. reservation under PCT article 64(4)(c) and 35 USC 363.

Continuation of a PCT

- 35 USC 365(c) right to claim in a U.S. application (35 USC 111(a) application) priority to a PCT application.
- Con of a 371 national stage
- Con of an intl. stage “By-Pass”

Continuation Definition

- Right to prior filing dates applies on a claim by claim basis
- TEST for a *claim's* right to a prior filing date - 35 USC 112 first paragraph support in the priority application



Continuation Definition

- 35 USC 112 requirements apply to a 'continuation' application...
- *Except* for updating the best mode requirement (but be careful)

Continuation Definition

FORMAL REQMTS:

- 35 USC 120 “specific reference”
- 37 CFR 1.78 (note cost of untimely compliance)

Continuation Advice Prosecution Laches

Advance prosecution to avoid prosecution laches issues. In re Bogese (“failure to further the prosecution of ...[the] application toward the issuance of any claims.”).

Continuation Advice

First Action Finals

Lack of instruction situations

- File continuation...
- *but* add claim or argument raising new issue
- Avoids first action final rejection

Continuation Advice Incorporation By Reference

Incorporation By Reference

(IBR) - General legal doctrine that provides the legal effect of writing all material into a document without the cost of actually performing the writing.

Continuation Advice – IBR

- Expressly IBR disclosure of priority document(s) into an application.
- Why?

Continuation Advice - IBR

- A priority claim is not an IBR. In re de Seversky.
- If you need to rely upon material appearing only in a priority document, you need an IBR.

Continuation Application – 35 USC 102(e) Effect

- 102(e) prior art date is the flip side of priority, however
- 102(e) <> 119/120/365

Continuation Application – 35 USC 102(e) Effect

- “but for delays” in the USPTO, the application would have issued. Milburn criteria led to 102(e)

Continuation Application – 35 USC 102(e) Effect

- Wertheim (CCPA 1981) deals with 102(e) prior art effect of a priority application claimed in an issued patent.

Continuation Application – 35 USC 102(e) Effect

Issue – When is an *unpublished patent application's disclosure* prior art due to a priority claim to that application in an issued patent?

Continuation Application – 35 USC 102(e) Effect

Wertheim (CCPA 1981) – *Held*

- issuance of patent makes priority application prior art only if a claim in the patent has 112, 1st support in the priority application.

Continuation Application – 35 USC 102(e) Effect

- Wertheim (CCPA 1981) – What about *published* (not issued) applications? No legal precedent yet. Open issue as to 102(e) effect of priority applications.

RCEs

- RCEs generally provide continued examination in applications when prosecution is otherwise closed.

RCEs

Filing an RCE:

- Reopens prosecution
- Withdraws an appeal
- Cuts off 35 USC 154(b)(1)(B)(i)
PTA

RCEs

- RCE cuts off 35 USC 154(b)(1)(B)(i) PTA for pendency greater than 3 years

RCEs

An RCE is *timely* if filed:

- after prosecution is closed
- prior to abandonment or payment of the issue fee
- not while an appeal or civil action is pending

RCEs

An RCE *requires*:

- a "submission" that advances prosecution (IDS, amendment, arguments, evidence)
- a fee (base filing fee)

RCEs

- An RCE will generally be acted upon in a few months
- Examiner has discretion in allowing switch between restricted inventions

RCE/Con Comparison

Compared to a Con, an RCE:

- Costs less
- Faster turnaround
- Precludes double patenting
- Preserves PTA in excess of 3 years accumulated at time of filing the RCE

RCE/Con Comparison – Diversity of Rights

Diversity of Rights issues

- inventorship
- ownership
- licensing
- contract rights

RCE/Con Advice

- Diversity of Rights

- Unlike RCEs, Cons and new applications can be used to a client's benefit in diversity of rights situations

RCE/Con Advice

- Diversity of Rights

- Inventor of any claim is a co-applicant/owner Ethicon Inc. v. United States Surgical Corp.
- Joint Development Agreements
- Non Disclosure Agreement
- Duty of disclosure issues

RCE/Con Advice - PTO Statements

RCE/Con useful when the PTO indicates that broader protection may be available, *after final*

- Examiner's reasons for allowance
- Decisions from the Board of Patent Appeals and Interference

RCE/Con Advice - Targeting Tactics

- Keep an application pending to:
- Target Infringers – Present claims tailored to infringements
 - Target interferers – Copy claims in published applications and patents

RCE/Con Advice - Targeting Infringers

- Claims tailored to infringements are more likely to be valid and infringed
- Infringement information develops with time

RCE/Con Advice -

Targeting Interferers

- Claims in issued patents are generally *not* useful to prevent interfering patents
- Winter v. Fujita et al.
- Pending application reqmt

RCE/Con Advice - Targeting with a Reissue

Reissue application is not the best choice

- New application delay in examination
- Error requirement and recapture rule limitations

RCE/Con Advice - Targeting Drawbacks

- Continued duty and burden of disclosure
- No privilege in the PTO
- Prosecution history estoppel
- Bogese type laches

Division Applications

- Divisions result from withdrawal of claims in an application (restriction/election)
- Withdrawal generally detrimental to the applicant
- Term, cost, complication

Division Applications

- Consonance requirement
- Division claims must be consonant with examiner's stated demarcation to be protected by 35 USC 121 from double patenting attacks on validity.

Division Applications - Advice

- Avoid Divisions and improper divisions, when practical by:
 - Presenting proper claims when filing
 - Traversing improper and vague requirements

Criteria for Requirements for Restriction/Election

Restriction/election requirements are defined by criteria specified in 35 USC 121, case law, 37 CFR 1.141-146, and MPEP 801-818.

Criteria For Requirements

MPEP 803 – any requirement must show both that:

- one group of claims is *independent or distinct* from another group of claims *and*
- a ‘*serious burden*’ exists in examining both groups

Traversing Requirements - Effect

- Preserves right to petition for withdrawal of requirement
- Provokes finality of requirement to help preclude subsequent withdrawal of the requirement

Traversing Requirements - Effect

- Clarifies consonant subject matter
- Leads to withdrawal or modification of requirement

Types of Arguments for Traversing Requirements

- Arguing (admitting) claims are patentably indistinct (bad)
- Arguing impropriety of requirement
- Amending claims to moot requirement

Fact Patterns Where Requirement may be Defeated

1. Requirement contains no reasoning
2. Alleged species function interchangeably or read on one embodiment – Muench

Fact Patterns

3. Requirement imposed after claims rejection; requirement is not consistent with existence of or basis for the rejections.
4. Grouping classification is the same.

Fact Patterns

5. Requirement relies upon incorrect factual assertions
6. Requirement's reasoning not commensurate with the scope of claims in the various groups

Fact Patterns

7. Limitation relied upon to distinguish groups appear in dependent claims
8. Method of making and product restriction mooted by adding exact method and product analog claims

Precluding Certain Requirements by Proper Drafting

- Disclose interchangeability and disclose use of limitations in the alternatives - Muench
- Include exact analog method and product claims

Appeals to the Board

A right to appeal exists whenever:

“the applicant has twice been denied a patent.” Ex Parte Lemoine (precedential)

Appeals to the Board

Appeal Requires filing of:

- Notice of appeal, and fee
- Appeal brief (triplicate), and fee
- Reply brief is optional (triplicate)
- Supplemental brief may be required

Appeals to the Board

Examiner's response to Appeal Brief may be:

- Examiner's Answer
- Office action (reopen prosecution)
- Notice of allowance *

Appeals to the Board

Applicant's Response:

- Examiner's Answer – Reply brief
- Office action reopening prosecution – Either amendment **or** request to maintain appeal and supplemental brief (no evidence or amendment) - 37 CFR 1.193(b)(2)(ii)

Appeals to the Board

- Request to maintain appeal and supplemental appeal brief preserves PTA due to existence and continuity of the appeal.

Appeals to the Board

Appeal decided by a panel of at least 3 Administrative Patent Judges (APJs). 35 USC 6(b).

Panel can: affirm, reverse, remand, require, reject. 37 CFR 1.196.

Appeals to the Board

- Panel decision on the merits is a ‘final agency action’
- Appellant has 2 months from date of decision to request reconsideration, appeal, or file a civil action

CHANGES TO *APPEALS* – FINAL RULES PUBLISHED 8/12/2004

41.12 – Parallel USPQ and West cites *required*

41.37 - AB -> EA1 - > RB1 – EA2 -> RB2

41.39(a)(2) – New Ground of rejection permitted in EA!

**41.50 – Filing evidence or amendment after AB
withdraws appeal**

AB claims grouping now optional

AB must include appendix containing evidence of record

Appeal Brief Structure

- Brief sections should generally parallel the sections defined in 37 CFR 1.192(b)
- Special structure regarding issues, arguments, and groups

Appeal Brief Structure

- Issues – Corresponding to statement of rejections, not sub-issues
- Argument – Corresponding to responses to rejections, not sub-issues

Appeal Brief Structure

- Claim Groups – Claim groups *should* correspond to sub-issues.
- Only group together claims for which all sub-issues are identical such that the panel cannot reach different conclusions on patentability claims of a group

Appeal Brief Structure

Sub-issues apply differently to different claims:

- Reference interpretation/claim construction
- Content of proposed modification/combination
- Support, Definiteness, Enablement

Reply Brief Structure

- Sequentially track statements in the Answer
- Do not repeat arguments appearing in appeal or supplemental brief

Reply Brief Contents

- Address points elaborated in the Answer
- Identify points in the Brief that the Answer did not address
- Identify new grounds of rejection in the Answer (the panel will ignore new grounds of rejection)

Oral Hearings

- Anecdotal, but consistent and repeated guidance from the Board indicates that oral hearings are generally *detrimental* to the appellant.
- Oral hearings also cost \$.

Strategy in View of Rights to Continued Prosecution, Appeal, and PTA

- Promptly filing an appeal has certain advantages over continuing prosecution

Advantages of Prompt Appeal Compared to Continuing Prosecution

- Limits prosecution history
- Cuts off examiner's ability to impose additional rejections
- Affords PTA for a successful appeal

Advantages of Prompt Appeal Compared to Continuing Prosecution

- Speeds issuance of broad claims
- Moots continuation applications for non allowed claims, and avoids attendant complications
- Likely to cost less

Setting Up an Application for Prompt Appeal

- Second office action generally final (compact prosecution)
- Anticipate appeal by presenting all claims, amendments, and evidence in response to the first office action

Response to the First Office Action – Setup for Appeal

- Thorough reasoning in response to a first office action enables porting of reasoning in the response directly into a subsequent appeal brief

Response to the First Office Action – Setup for Appeal

- Reasoning – A thorough response to a first action helps identify subject matter you can claim in ‘backup claims’

Response to the First Office Action – Setup for Appeal

- Consider the possibility that you will lose on appeal on a disputed issue (claim interp, motivation to combine, reference teaching, etc.), and draft your response accordingly.

Response to the First Office Action – Setup for Appeal

- Do not amend a claim to avoid a rejection if the rejection may be improper
- Do add similar claims that may avoid the rejection – ‘backup claims’ anticipating the appeal

Response to the First Office Action – Setup for Appeal

- Submit all relevant evidence
- Evidence is more important on appeal than before the examiner
- Panel will rely upon evidence

Response to the First Office Action – Setup for Appeal

- Statement at an oral hearing is not a reliable substitute for evidence of record
- Admissions at oral hearing can hurt you

Petitions - Purpose

Petitions address procedural issues, such as actions or requirements of an examiner not subject to appeal, and can invoke the Director's supervisory authority.

Petitions – Structure

Petitions generally consist of three parts:

- Requested action
- Material facts
- Reasoning

Petitions - Limitations

- May require a prior request for reconsideration
- Generally must be filed within 2 months of the action prompting the petition

Petitions - Review

- Generally, right to request reconsideration, if denied
- Review of denial via APA (5 USC 701 et seq.) - Sue the Director in a District Court, on the administrative record. Cf. Arnold v. Dudas.

Petitions - Generally

- Factual assertions must be accurate
- Should be filed promptly to avoid procedural disadvantage

Interferences - Overview

- About 200 per year
- Declaration of an interference is discretionary with Director - 35 USC 135(a)
- Inter Partes proceeding

Interferences - Overview

- (Former) CAPJ Stoner created the 'Trial Section' in 1999
- Trial Section provides uniformity in procedure and law
- Notice Declaring Interference (55 pages) + TS Precedent

Interference

Winter v. Fujita (1999)

- Defined the meaning of ‘same patentable invention’ (37 CFR 1.601(n)) and ‘interfere’ (35 USC 135(a)) to be claims that are obvious in view of each other
- Two-ways obviousness test

Interference Timing

- 37 CFR 1.604 and 607 requests
- Request to Declaration – Median 22 months
- Non-priority motions phase – 1 year
- Priority phase – 1 year

Interference Motions Phase

- *Redefine the interference* defined in the Notice Declaring Interference
- *Redefine* - Attack patentability, amend/add/remove claims from a count of the interference, etc.

Interference Priority Phase

- Present Priority evidence
- Briefing, and final hearing
- Panel Decision

Interference Testimony

- Direct testimony via declaration
- Cross-examination – Live
- Cross interleaved during the proceeding, ***not*** at the end
- Interleaving enables decision on motions before priority phase

Interference Estoppel

- Applies to any issue that was raised or *could have been* raised
- Virtually any issue could have been raised in an interference

Interferences 135(b) and (c)

- 135(b) – 1 year claim bar for copying claims patented or published in US or PCT
- 135(c) – Must file copy of any agreement in contemplation of settlement of an interference

Interferences - Advice

- *Avoid* interferences, unless you have a certain business need
- Interferences result in cancellation of claims, *not* patents
- Interferences *tie up* applications

Interferences - Advice

- Do present claims to similar but arguably not interfering subject matter (in pursuit of a patent)
- Note the two-ways test of Winter allows 37 CFR 1.131 antedating for claims similar to those in an issued patent

Interferences - Advice

- Consider splitting interfering and non-interfering subject matter into different applications
- Toll 135(b), by copying claims
- Notify the PTO *whenever* copying claims

Public Use Proceeding

- About 4 petitions per year
- Mechanism for public to submit evidence of a public use or sale affecting a pending application

Public Use Proceeding

- Petition must be filed prior to publication or allowance of 111(a) application
- Petition must be filed prior to 2 months after publication of a reissue application

Public Use Proceeding

- Petition must be supported by evidence proving the existence of the public use
- Must make a prima facie showing of unpatentability (hard to do without access to claims!)

Public Use Proceeding

- If petition granted, evidentiary proceeding follows.
- Proceeding governed by evidentiary rules used in interferences

Determinations

- *None*, in the last few years
- Title proceeding in which the applicant disputes transfer of title in response to a Notice of gov. intent to transfer

Determinations

- Upon Notice, 30 days to request a hearing before the Board
- Issue: Generally, whether invention conceived or reduced to practice with gov. funds
- Proceeding governed by rules for interferences

Oppositions – The Wave of the Future

- Currently does not exist
- Problem address – No generally available mechanism exists to test validity of issued patents

Oppositions – The Wave of the Future

- Re-exams limited to self authenticating evidence
- Interferences limited to interfering subject matter
- DJ limited to actual threat of suit

Oppositions – Description

- PTO Board proceeding
- Non-Self authenticating evidence admissible
- Procedurally similar to interference motions phase

Oppositions – Benefits

- One year to completion
- Avoids drawbacks of many other legal procedures; cost, time, limited scope
- Employs PTO expertise

PPT Fact Pattern Issues

- Inventorship error
- Effect of concession on restriction requirement /election
- How to have challenged RR

PPT Fact Pattern Issues

- Did atty notify client re RR options and consequences?
- Did atty notify client when Receiving NOA regarding options?

PPT Fact Pattern Issues

- Inventorship/Division problem
- Did application claim 16 violate consonance? (claim mixing system and code limitations)
- Double patenting consequences

PPT Fact Pattern Issues

- Was new claim 15 advisable?
- Compare reasons for allowance to independent claims
- Unclaimed subject matter

PTO PROCEDURES

THE END

THANK YOU

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SLIDES COVERED

1-22 – Continuations

34-38 – Targeting, and Winter

52 – Right of Appeal

66-75 – Prosecution strategy

90-92 – Interference advise

103-106 – PPPT fact pattern questions