



Patent Resources Group
When, Why and How to Effectively Appeal to the USPTO
Board of Patent Appeals and Interferences
Course Syllabus

- Determining when, during the prosecution of the application, it is prudent to file an appeal, considering the nature of the examiner's rejection(s) and the legal and technological issues involved (e.g., identifying and appealing inappropriate obviousness rejections in the post-KSR USPTO).
- How to respond to Office actions in a way that will enhance success before the Board.
- Claim construction by the Board.
- The Board's treatment of Rule 131 and 132 evidence.
- Pre-appeal brief conference requirements and strategy under the USPTO's new rules.
- How to write an effective brief to the Board, including strategies in presenting facts, arguments and authorities.
- A detailed analysis of each of the required parts of a brief.
- How to deal with the new presumption of correctness of the examiner's rejection(s), including how to establish examiner error.
- Taking apart the examiner's answer and writing an effective reply brief.
- Making an effective oral argument at the hearing.
- Reviewing and responding to the Board's decision, including how to respond to both stated and unstated new grounds of rejection.
- How to avoid winning the appeal and yet – inadvertently – losing the case.
- Further judicial review, i.e., to the CAFC or the U.S. District Court.
- Patent term adjustment issues – how winning or losing the appeal affects your patent term in significantly different ways.