

# Leveraging the *Ex Parte* Process

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Judge Rae Lynn Guest, Lead APJ, PTAB  
Judge Jay Moore, APJ, PTAB  
Shruti Costales, HP Inc.  
Caroline Pinkston, Hewlett Packard Enterprise

Moderator: Courtenay Brinckerhoff, Foley & Lardner LLP



# Agenda

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- I. From the PTAB
  - A. Statistics and Pendency
- II. When Does it Make Sense to Appeal?
  - A. Perspectives into an Applicant's Decision Process
- III. Appeal Strategies and Best Practices
  - A. Timing: When to File an Appeal?
  - B. Alternatives to Appeal
  - C. Appeal and Reply Briefs
  - D. Oral Argument
  - E. Request for Rehearing
- IV. The Appeals Process: What Works?
- V. Considerations with Parallel Post-Grant Proceedings
- VI. Ex Parte Reexamination

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



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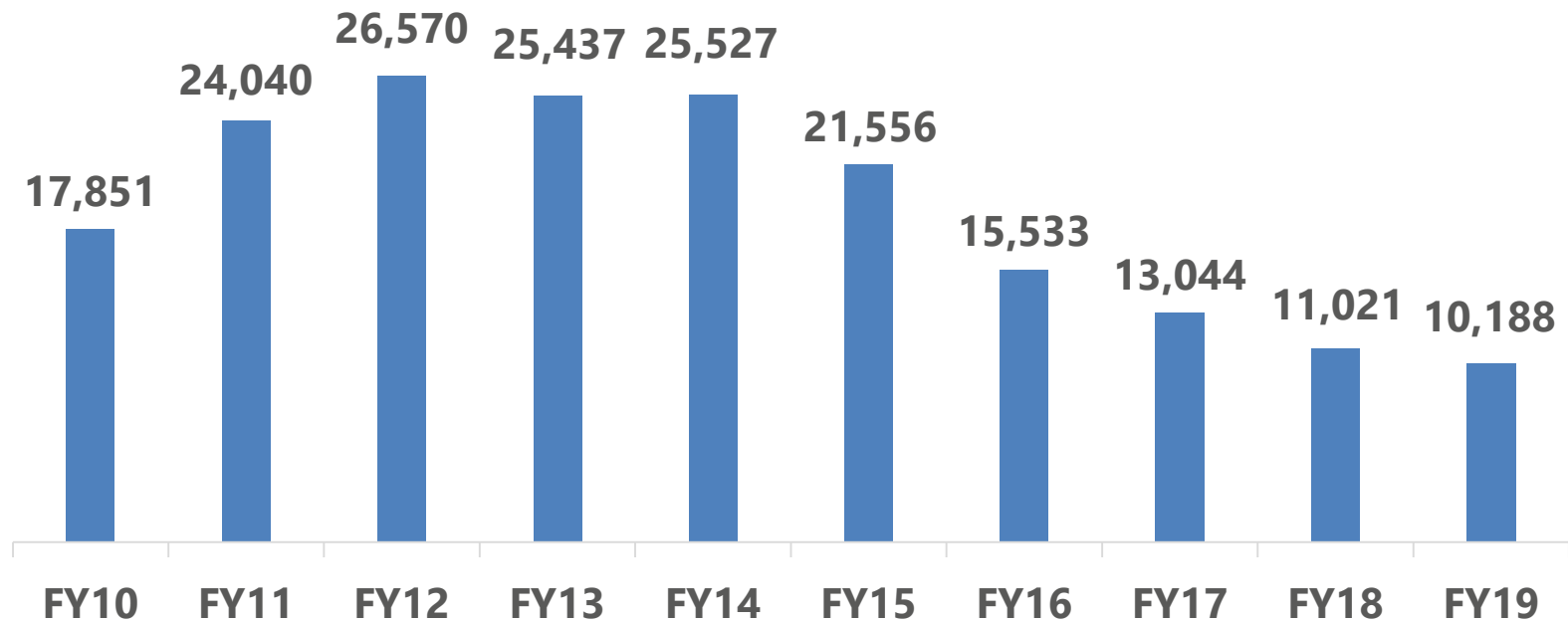
# USPTO Appeal Statistics

## Patent Trial and Appeal Board

### January 2019

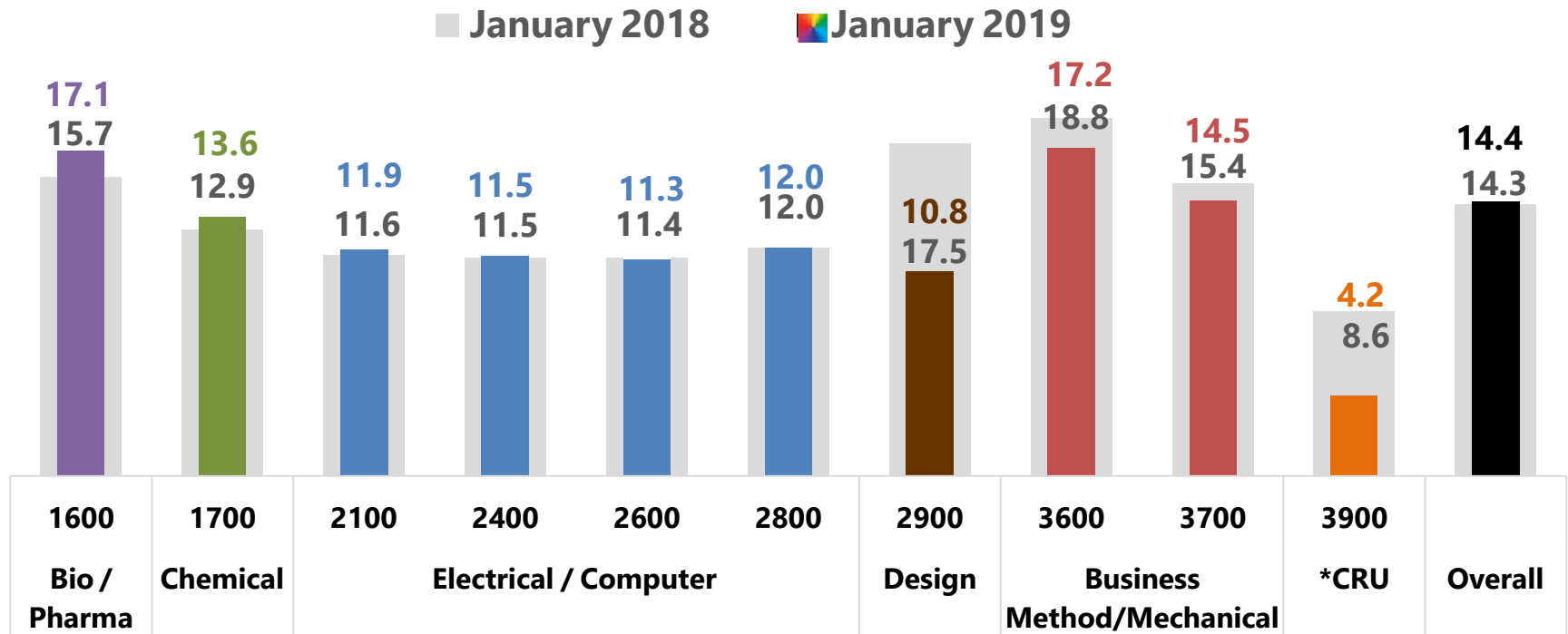
# Pending appeals FY10 to FY19

(Sept. 30, 2010 – Jan. 31, 2019)



# Pendency of decided appeals in FY18 and FY19

(January 2018 compared to January 2019 in months)

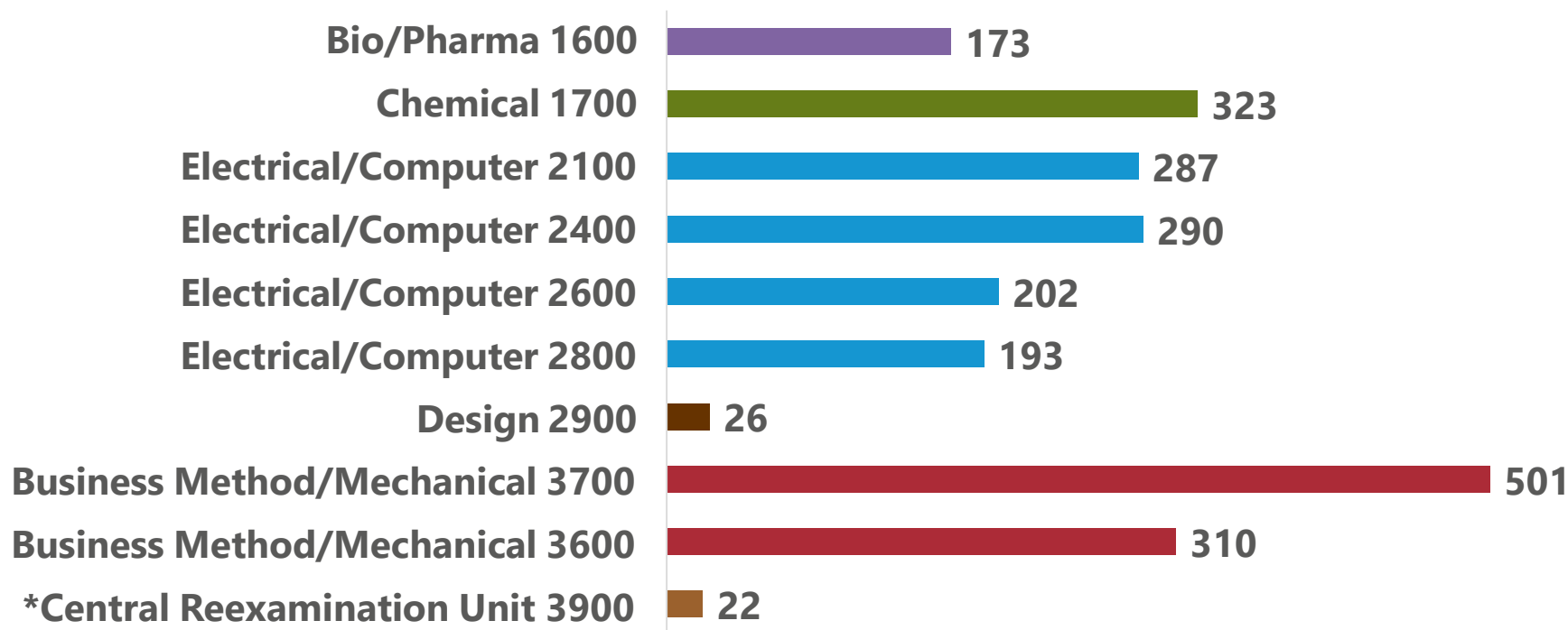


Pendency is calculated as average months from Board receipt date to final decision.

\*CRU (Central Reexamination Unit) decisions include 7 ex parte reexams, 6 inter partes reexams, 1 supplemental examination review and 3 reissues from all technologies.

# Appeal intake in FY19

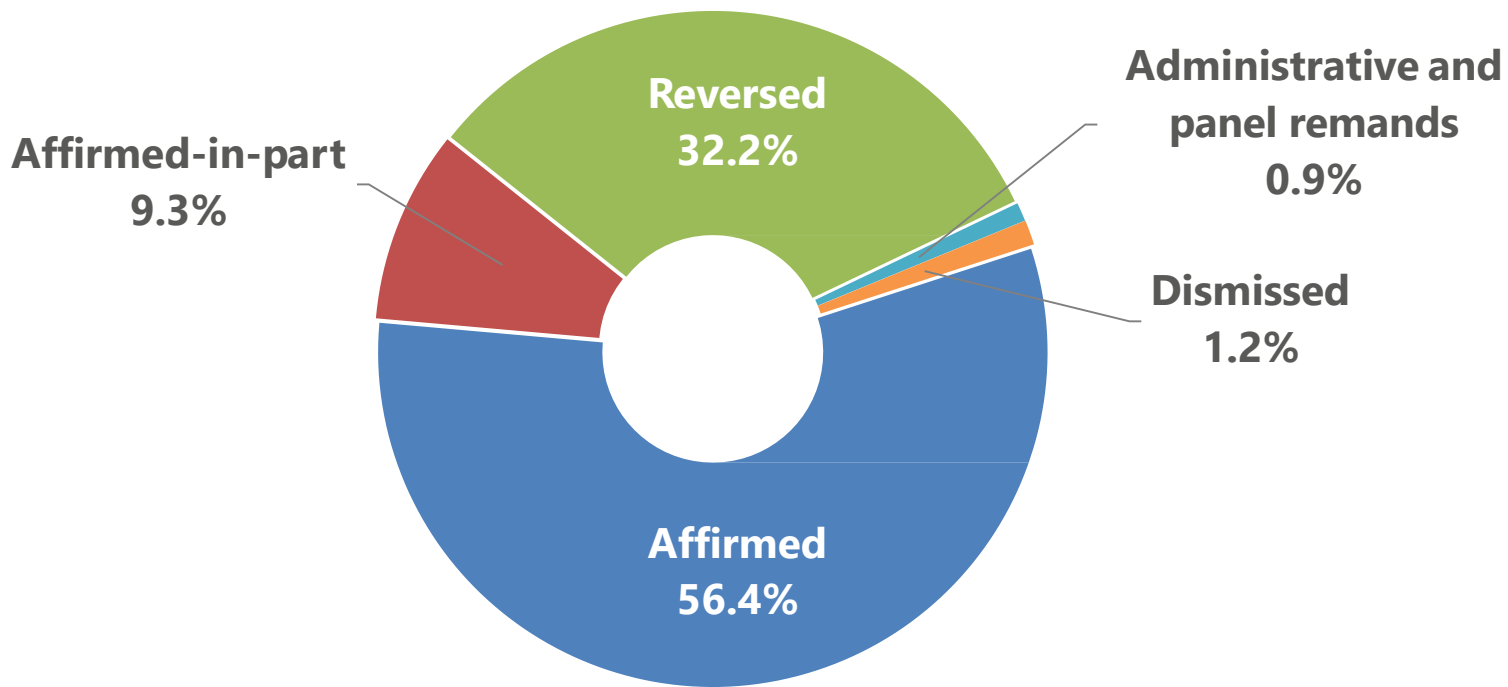
(Oct. 1, 2018 to Jan. 31, 2019)



\*The Central Reexamination Unit includes ex parte reexams, inter partes reexams, supplemental examination reviews and reissues from all technologies.

# Appeal outcomes in FY19

(Oct. 1, 2018 to Jan. 31, 2019)







# When Does it Make Sense to Appeal?

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- What makes a case a good candidate for appeal?
  - Applicant perspectives
    - Business factors?
    - Legal factors?
    - Statistics?
    - Timing?
    - Costs?
    - Alternative routes?
  - PTAB perspectives

# Appeal Strategies & Best Practices

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- Alternatives to Appeal
  - Applicant perspectives
    - AFCP 2.0
    - Pre-Appeal Brief Request for Review
    - RCE
    - Effectiveness?
  - PTAB perspective

# Appeal Strategies & Best Practices

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- Briefs
  - USPTO practice tips
    - <https://www.uspto.gov/patents-application-process/appealing-patent-decisions/resources/practice-tips-writing-effective>
  - Best practices (Applicant and PTAB perspectives)
    - Opening Brief
      - » Formulating arguments
      - » Reliance on precedent
      - » Reliance on evidence
    - Reply Brief
      - Considerations in filing a reply
      - What makes a good reply?
    - Rationales for reversing

# Appeal Strategies & Best Practices

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- Oral Argument
  - How often are cases argued orally?
  - Based on?
    - Applicant perspectives
      - Technology?
      - Legal issues?
      - Costs?
  - When is a request for oral argument denied?
  - Process and structure
  - Best practices (Applicant and PTAB perspectives)
    - Who should argue?
    - Who should attend?
    - Content
    - Demonstratives

# Appeal Strategies & Best Practices

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- Request for Rehearing (Applicant and PTAB perspectives)
  - When to request rehearing?
  - Issues considered?
  - Best practices?
  - Chances of success?
    - Tips for improving chances.
- How are such requests handled procedurally within the PTAB?

# The Appeals Process: What Works?

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- Getting cases through the PTAB efficiently and effectively
  - PTAB perspective
  - Applicant perspective

# Parallel Post-Grant Proceedings

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- PTAB perspective
  - Impact on procedure?
  - Impact on decision?
  
- Applicant perspective
  - advantages?
  - risks?



# Ex Parte Reexamination

- Overview

- Differences from pre-grant prosecution?

- Statistics

1. Total requests filed since start of <i>Ex Parte</i> reexam on 07/01/81.....	14005
a. By patent owner	4137 30%
b. by other member of the public	9825 70%
c. By order of Commissioner	43 0%

2. Number of Filings by discipline	
a. Chemical Operation	3782 27%
b. Electrical Operation	5270 38%
c. Mechanical Operation	4717 34%
d. Design Patents	236 2%

3. Annual *Ex Parte* Reexam Filings

Fiscal Yr.	No	Fiscal Yr.	No	Fiscal Yr.	No	Fiscal Yr.	No	Fiscal Yr.	No
1981	78 (3 mos.)	1989	242	1997	380	2005	520	2013	305
1982	187	1990	297	1998	348	2006	473	2014	355
1983	186	1991	309	1999	391	2007	601	2015	243
1984	189	1992	390	2000	312	2008	691	2016	225
1985	230	1993	359	2001	295	2009	605	2017	189
1986	232	1994	379	2002	272	2010	698	2018	189
1987	240	1995	395	2003	394	2011	736		
1988	269	1996	413	2004	436	2012	781		

4. Number known to be in litigation.....	4731 34%
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# Ex Parte Reexamination

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- When to use?
  - Applicant perspectives
  - Strategy considerations
- Best practices
  - Applicant and PTAB perspectives
- Appeals from *ex parte* reexam?
  - Handled differently?
  - PTAB perspective
  - Applicant perspective

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THANK YOU!