

PRE-APPEAL BRIEF CONFERENCE EFFECTS

In 2005, the U.S. Patent and Trademark Office (USPTO) introduced the Pre-Appeal Brief Conference (Conference). The Conference allows patent applicants to request a panel of examiners to review the legal and factual basis of the rejections in their applications prior to filing an appeal brief. For the Conference, applicants submit a short 5-page memo to be reviewed by the panel, as compared to a lengthy appeal brief for an appeal before the Board of Patent Appeals and Interferences (Board).

On November 15, 2010, the USPTO published statistics indicating the effect of the Pre-Appeal Brief Conference. According to the statistics provided by the USPTO, Fig. 1 indicates that about 57% of Conferences remained under appeal and proceeded to the Board. Fig. 2 and 3 present an interesting comparison. During the last five years, a higher percentage of the Pre-Appeal Brief Conferences than the Appeal Conferences resulted in reopening the prosecution. By contrast, a higher percentage of the Appeal Conferences resulted in withdrawing all rejections and found all existing claims allowable.

It is worth noting that an extra prosecution period after reopening the prosecution may affect a patent term adjustment once the patent is issued. Therefore, the strategic balancing question in an appeal preparation would be: patent life v. immediate issuance.

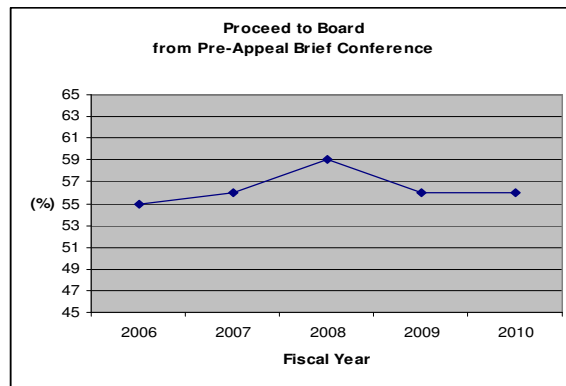


Fig. 1.

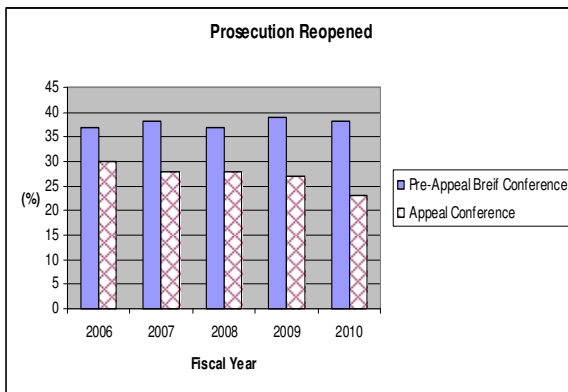


Fig. 2.

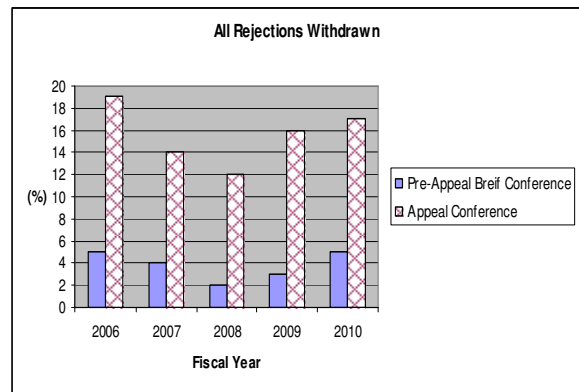


Fig. 3.