

The State of the Board of Patent Appeals and Interferences

Patent Lawyers Club of Washington

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Chief Administrative Patent Judge
Board of Patent Appeals and Interferences
April 1, 2003

Board of Patent Appeals and Interferences (BPAI)

BPAI is created by statute (35 U.S.C. § 6)

That statute mandates the BPAI's:

- Duties
- Composition
- Qualifications for membership
- Panel form of decision-making

Duties

35 U.S.C. § 6(b)

Duties of the Board:

“The Board of Patent Appeals and interferences shall, on written appeal of an applicant, review adverse decisions of examiners upon applications for patents and shall determine priority and patentability of invention in interferences declared under section 135(a).”

35 U.S.C. § 6 (a)

Composition of the Board:

“The Director, the Deputy [Director], the Commissioner for Patents, the Commissioner for Trademarks, and the administrative patent judges shall constitute the Board.”

35 U.S.C. § 6 (a)

Qualifications:

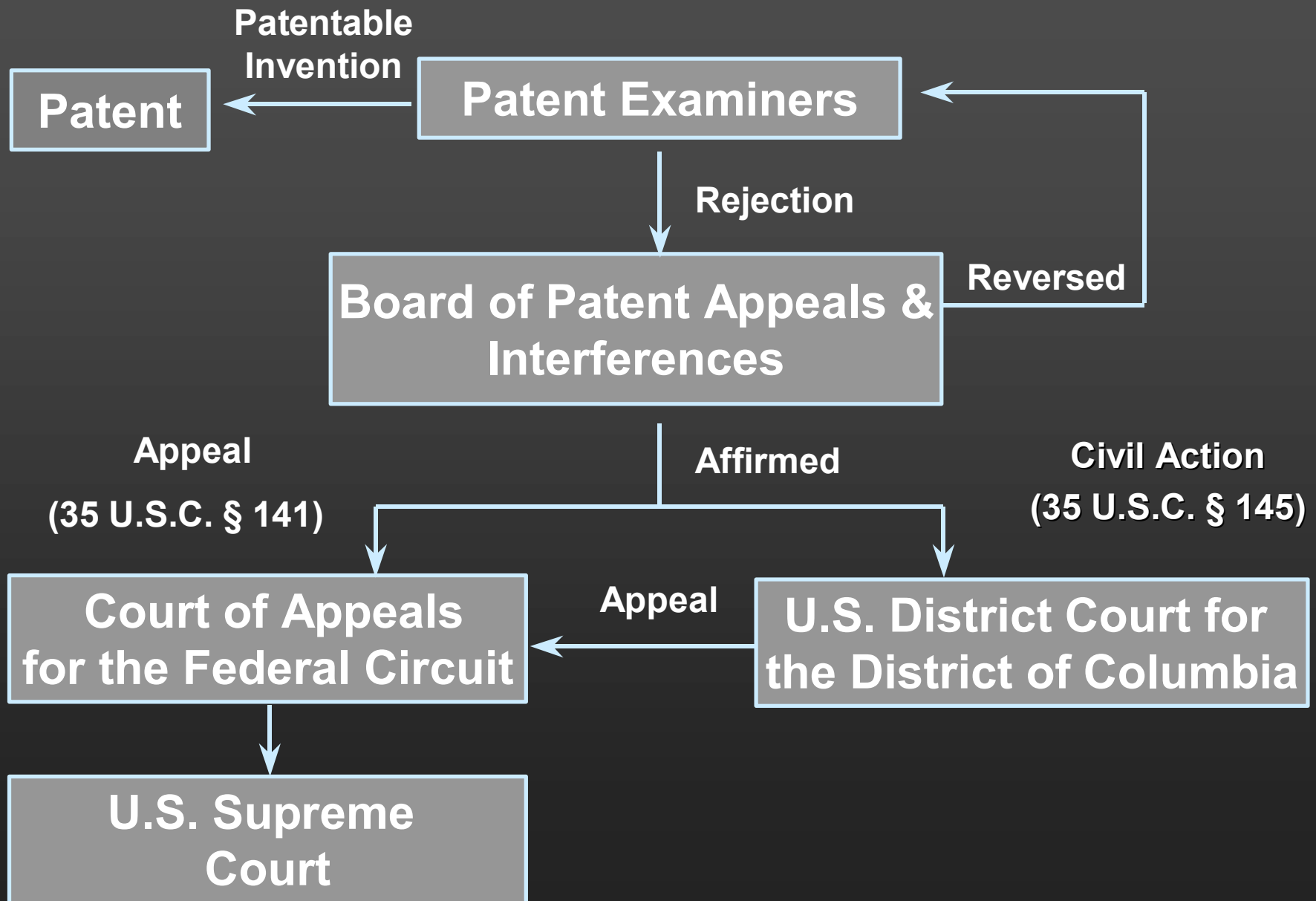
“The administrative patent judges shall be persons of competent legal knowledge and scientific ability who are appointed by the Director.”

35 U.S.C. § 6(b)

Panels:

“Each appeal and interference shall be heard by at least three members of the Board, who shall be designated by the Director.”

The Appellate Review Process



What is an interference?

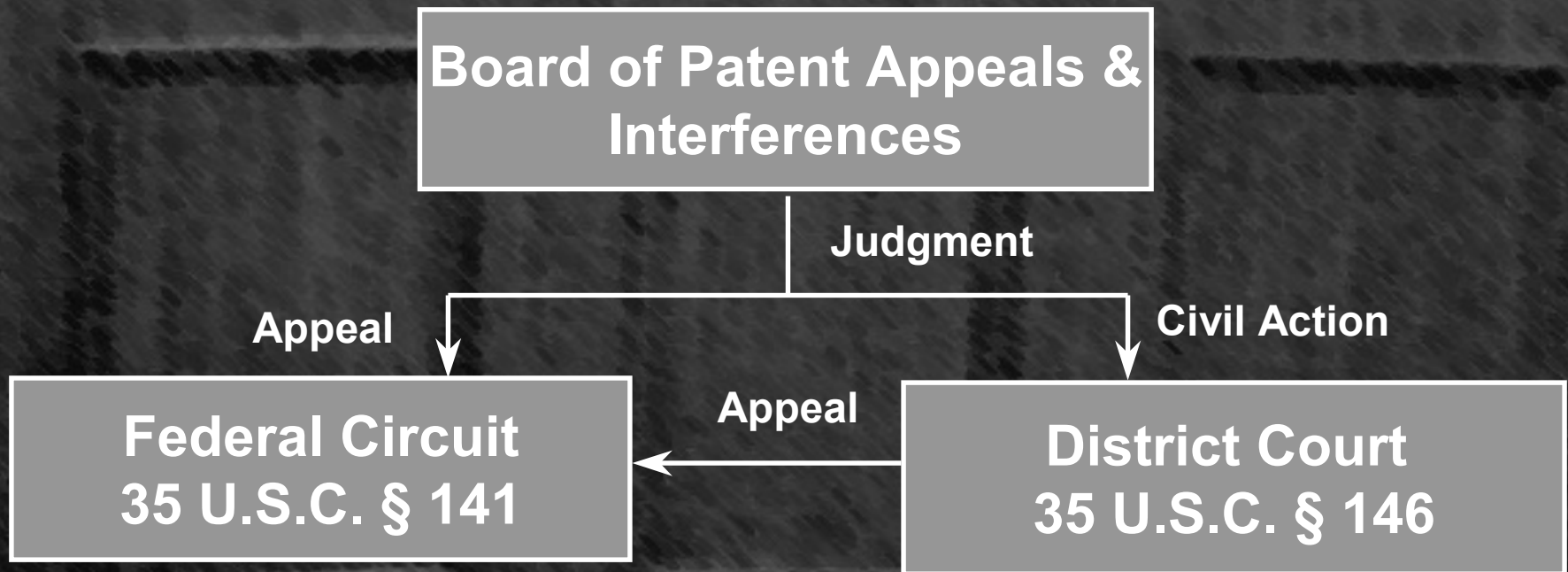
The United States has a system under which a patent is awarded to the one who is “first-to-invent” rather than the one who is “first-to-file” a patent application.

A proceeding conducted within the USPTO to decide who is “first-to-invent” is called an interference.

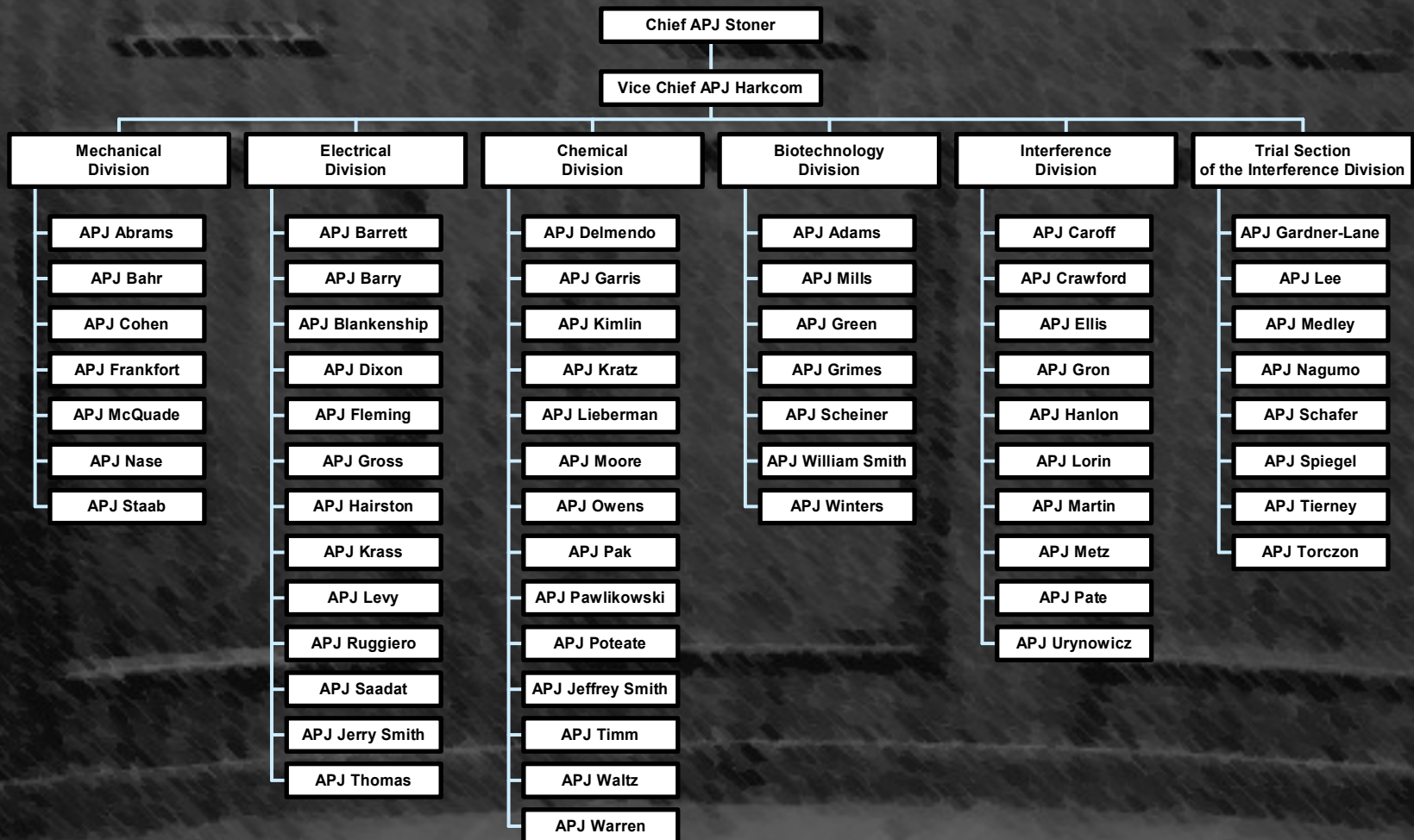
What is an interference?

An interference proceeding within the USPTO, pursuant to 35 U.S.C. § 135, may be instituted whenever an application is made for a patent which, in the opinion of the Director, would interfere with any pending application or any unexpired patent.

Judicial Review in Interferences



APJs as of April 1, 2003 (alphabetical order)



The APJs

chief APJ

vice-chief APJ

59 other APJs

all APJs hold technical and law degrees

about 25% hold advanced technical degrees

roughly 75% of all APJ time is spent on deciding appeals

roughly 25% of all APJ time is spent on conducting and
deciding interferences

Major FY 2002 Accomplishments

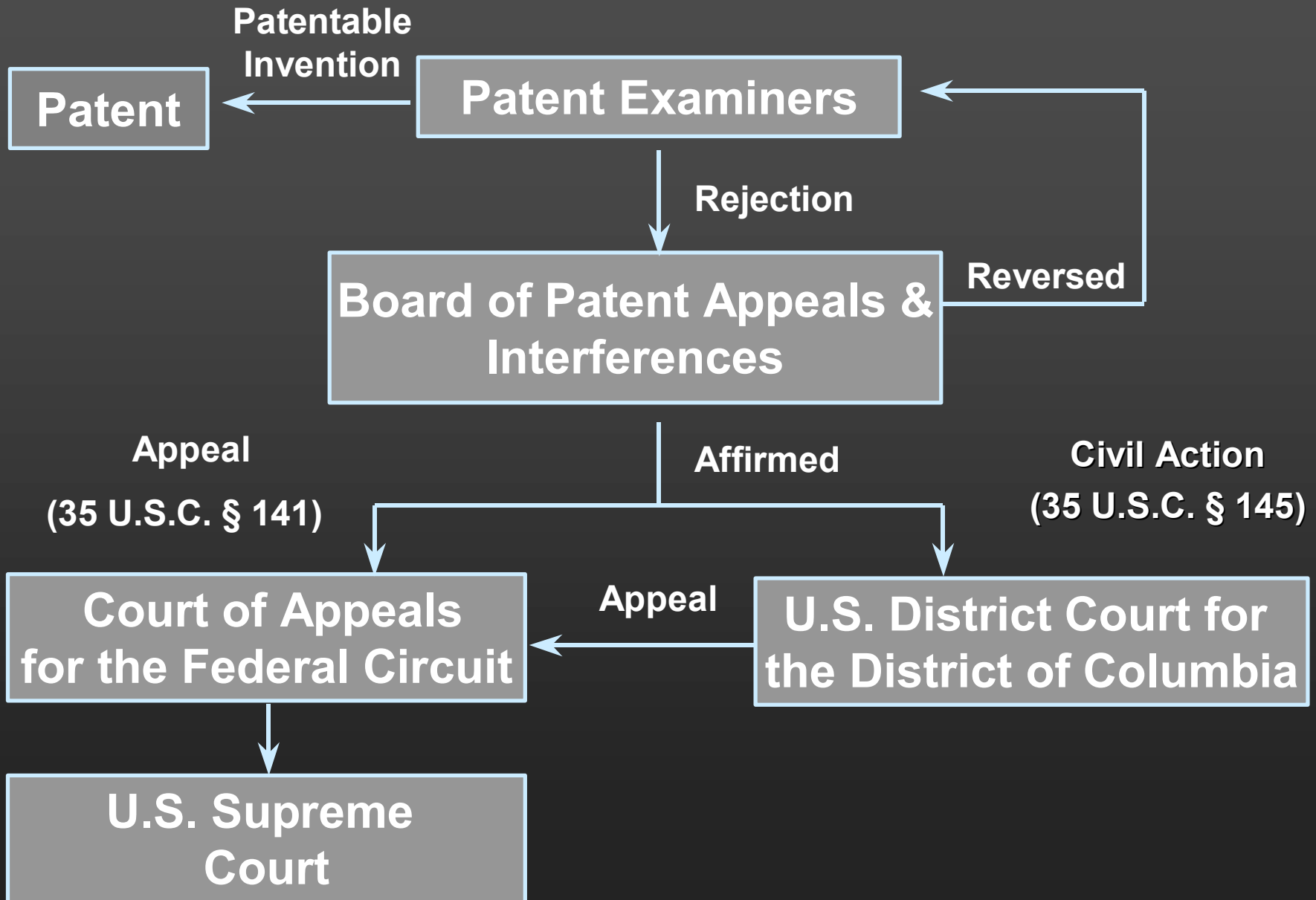
Disposed of **5085** appeals

Reduced appeal inventory to **3090** appeals
(7.7 month inventory)

Terminated **157** interferences

Reduced average interference pendency to
27 months

The Appellate Review Process



Results by Tech Center published monthly in Official Gazette and on BPAI webpage

**FISCAL YEAR 2002
BOARD OF PATENT APPEALS AND INTERFERENCES
RECEIPTS AND DISPOSITIONS BY GROUPS
EX PARTE APPEALS**

FY 2002 MONTHLY DISPOSITIONS- SEPTEMBER 2002

TECHNOLOGY CENTER	REPORTING PERIOD	PENDING BEGINNING MONTH	APPEALS RECEIVED MONTH	AFFIRMED	MODIFIED*	REVERSED	PANEL REMANDES	ADMINISTRATIVE REMANDES	DISMISSED	TOTAL	PENDING END MONTH	INCREASE/ DECREASE MONTH	PERCENT OF CASE MONTH
1600	9-1-2002 to 9-30-2002	527	14	17	9	36	8	5	3	78	463	-64	15.0
1700	9-1-2002 to 9-30-2002	864	75	143	26	80	26	5	5	285	654	-210	21.2
2100	9-1-2002 to 9-30-2002	439	28	9	7	15	3	8	0	42	425	-14	13.8
2600	9-1-2002 to 9-30-2002	609	34	7	10	35	3	8	2	68	575	-34	18.6
2800	9-1-2002 to 9-30-2002	535	28	25	12	34	3	6	0	80	483	-52	15.6
2900	9-1-2002 to 9-30-2002	6	3	3	0	0	0	1	0	4	5	-1	0.2
3600	9-1-2002 to 9-30-2002	259	45	10	7	27	3	11	2	60	244	-15	7.9
3700	9-1-2002 to 9-30-2002	291	42	14	23	42	5	8	0	92	241	-50	7.8
Board Totals		3530	269	228	94	272	51	52	12	709	3090	-440	100.0

FY 2002 CUMULATIVE DISPOSITIONS

TECHNOLOGY CENTER	REPORTING PERIOD	PENDING BEGINNING FISCAL YEAR	APPEALS RECEIVED FISCAL YEAR	AFFIRMED	MODIFIED*	REVERSED	PANEL REMANDES	ADMINISTRATIVE REMANDES	DISMISSED	TOTAL	PENDING END FISCAL YEAR	INCREASE/ DECREASE FISCAL YEAR	PERCENT OF CASE WORKLOAD
1600	10-1-01 to 9-30-02	781	315	167	36	285	84	37	24	633	463	-318	15.0
1700	10-1-01 to 9-30-02	1583	678	713	110	451	117	183	33	1607	654	-929	21.2
2100	10-1-01 to 9-30-02	543	305	101	34	167	15	102	4	423	425	-118	13.8
2600	10-1-01 to 9-30-02	678	524	125	76	266	27	126	7	627	575	-103	18.6
2800	10-1-01 to 9-30-02	872	365	206	86	273	19	162	8	754	483	-389	15.6
2900	10-1-01 to 9-30-02	10	18	13	0	6	1	3	0	23	5	-5	0.2
3600	10-1-01 to 9-30-02	230	422	80	52	184	27	57	8	408	244	14	7.9
3700	10-1-01 to 9-30-02	353	498	117	77	269	39	100	8	610	241	-112	7.8
Board Totals		5050	3125	1522	471	1901	329	770	92	5085	3090	-1960	100.0

* AFFIRMED-IN-PART

AFFD	MODIFIED	REV	PANEL REM	ADMINISTRATIVE	DISM
29.9	9.3	37.4	6.5	15.1	1.8

% DECISIONS-FISCAL YEAR TO DATE

Of the 3090 pending appeals, 2387 are currently assigned to administrative patent judge dockets.
With the exception of a limited number of appeals involving special circumstances, the Board of Patent Appeals and Interferences is currently deciding appeals received at the Board as follows:

BIOTECH	Fiscal Year 2001
CHEMICAL	Fiscal Year 2000
ELECTRICAL	Fiscal Year 2000
MECHANICAL	Fiscal Year 2002
DESIGN	Fiscal Year 2002

Interference Activity by Technology Center; FY 98 – FY 02

Interference Activity by TC FY98 - FY02(to 9/30/02)

Interference Declarations					
TC	FY98	FY99	FY00	FY01	FY02
1600	56	46	60	52	62
1700	34	21	24	31	22
2100				3	1
2600				6	1
2700	7	3	12		
2800	23	6	6	12	10
2900	0	1	8	2	0
3600	9	4	17	8	6
3700	34	10	9	10	7
Undefined	26				
TOTAL	189	91	136	124	109

Interference Terminations					
TC	FY98	FY99	FY00	FY01	FY02
1600	51	66	70	74	75
1700	52	53	38	45	30
2100				11	4
2600				4	5
2700	7	5	10		
2800	25	18	18	18	14
2900	1	3	7	1	2
3600	1	12	10	12	9
3700	46	30	25	28	18
Undefined	21				
TOTAL	204	187	178	193	157

Interference Pendency by TC for FY02

Pending and Terminated Interference Pendency by TC for FY02

Technology Center	No. of Pending Interferences	Ave. Pendency of Pending Interferences (mos.)	No. of Terminated Interferences	Ave. Pendency of Terminated Interferences (mos.)
1600	102	29.4	75	22.4
1700	30	20.9	30	37.4
2100	0	0.0	4	15.1
2600	0	0.0	5	13.0
2800	11	13.9	14	21.6
2900	0	0.0	2	10.1
3600	16	26.6	9	25.4
3700	12	36.1	18	30.0
Total Nos.	171		157	
Overall Aves.		27.1		25.7

Interferences Pending as of 9/30/02, by TC and Year of Declaration

Interferences Pending as of 9/30/02, by TC and year of declaration

TC	Total Pending	Pre-FY 98	FY 98	FY 99	FY 00	FY 01	FY 02
1600	102	22	11	1	8	8	52
1700	30	3	2	0	2	5	18
2100	0	0	0	0	0	0	0
2600	0	0	0	0	0	0	0
2800	11	0	1	0	1	2	7
2900	0	0	0	0	0	0	0
3600	16	1	1	0	7	1	6
3700	12	3	3	0	0	1	5
Total Nos.	171	29	18	1	18	17	88

Strategic Goals

By September 30, 2003:

**Decide appeals within approximately 6 months
of receipt at BPAI**

**Terminate interferences within approximately
24 months of declaration**

Revised Docketing Procedures for Appeals Arriving at the Board

Notice of revised appeal docketing procedures, adopted April 15, 2002, published Official Gazette 2 July 2002

Effective June 1, 2002, * * * the Board adopts the following appeal docketing procedures: When an application appearing to include an appeal under 35 U.S.C. 134 for decision by the Board is received from the Patents operation, it will be reviewed for (1) gross formalities (including, but not limited to, matters such as the presence of a notice of appeal, appellant's brief, examiner's answer, and evidence of an appeal conference having been held, * * *), (2) fine formalities (including, but not limited to, matters such as unacknowledged Information Disclosure Statements or other papers, and deficiencies in the brief or answer, * * *), and, (3) status matters (including, but not limited to, matters such as the presence of communications from appellant beyond the brief, such as a reply brief or a request for oral hearing). * * *

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Revised Docketing Procedures for Appeals Arriving at the Board

*** * * If the appeal is ready for docketing (that is, if no return of the case to the examiner is required per the review) three events will occur: (1) an appeal number will be assigned, (2) the Board will issue a docketing notice, identifying the relevant appeal contents (brief, reply brief if any, request for oral hearing if any, and the filing date of each such item), and (3) the appeal will be assigned to a master docket for subsequent reassignment to the docket of an individual APJ, or directly to the docket of an individual APJ. If the appeal cannot be docketed due to matters requiring further attention in the Patents operation, the appeal will be administratively returned to the Patents operation with an order indicating why the appeal cannot be docketed (essentially those reasons that exist today for administrative remands) and notification of that return, in the form of a copy of the order, will be mailed to the appellant. No appeal number will be assigned until the appeal is ready for docketing. * * ***

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Revised Docketing Procedures for Appeals Arriving at the Board

*** * * The docketing notice or order indicating why the appeal cannot be docketed will provide the appellant and examiner with notification that the appeal is: (1) at the Board in condition for referral to a panel, or (2) that the appeal is being returned to the Patents operation to resolve matters requiring attention prior to decision of the appeal. Accordingly, the appellant will know to which organization to look for the next communication in the appealed application. Within one month of receipt of the application file at the Board, the Board expects to (1) complete all reviews and issue a docketing notice, or (2) return the application file to the Patents operation with an order indicating why the appeal cannot be docketed.**

BPAI Webpage

You are here: [General Counsel Home](#) > [BPAI](#)

Board of Patent Appeals and Interferences (BPAI)

Upcoming Events

Organizations

- General Counsel
- Solicitor
- General Law
- BPAI
- TTAB
- OED
- Organization Chart

Information

- Contact Information
- Service of Process
- Employment Opportunities

Other Resources

- FOIA
- Federal Court Cases
- Department of Commerce (DOC)
- DOC General Counsel

Quick Links:

General Board Procedures

[Standard Operating Procedures](#)

[BPAI-related Official Gazette Notices](#)

[Frequently Asked Questions also in MS Word](#)

[Internship/Externship Program for Law Students also in MS Word](#)

General Board Information

[Board Statistics \(MS Excel\)](#)

[Precedential Opinions](#)

[Final Decisions](#)

[Patent Interference Information](#)

[Interference Trial Section Opinions](#)

[Interference Trial Section Forms](#)

[Interference Rulemaking](#)

[Transcripts of Interference Roundtables](#)

[Interference Practice Specialists by Technology Center](#)

"The Board of Patent Appeals and Interferences shall, on written appeal of an applicant, review adverse decisions of examiners upon applications for patents and shall determine priority and patentability of invention in interferences ... [35 U.S.C. § 6(b)]."

35 U.S.C. § 6, establishes the Board's membership as the Director, the Commissioner for Patents, the Commissioner for Trademarks, and the Administrative Patent Judges. One of the Administrative Patent Judges serves as Chief Judge, **Bruce Stoner**, while another serves as Vice Chief Judge, **Gary Harkcom**.

The Board's two main responsibilities include: (1) the review of *ex parte* appeals from adverse decisions of examiners in those situations where a written appeal is taken by a dissatisfied patent applicant and (2) the review

TABLE 25

CASES IN LITIGATION

(Selected Courts of the United States, as of September 30, 2002)

	PATENTS	TRADEMARKS	TOTAL
United States District Courts			
Civil actions pending as of 9/30/01, total	7	3	10
Filed during FY 02	15	4	19
Disposals, total	12	3	15
Affirmed	2	1	3
Reversed	1	-	1
Remanded	1	-	1
Dismissed	5	1	6
Amicus/intervene	1	-	1
Transfer	2	1	3
Civil actions pending as of 9/30/02, total	10	4	14
United States Courts of Appeals /1			
Ex parte cases			
Cases pending as of 9/30/01	28	5	33
Cases filed during FY 02	33	19	52
Disposals, total	42	9	51
Affirmed	18	5	23
Reversed	1	0	1
Remanded	13	0	13
Dismissed	10	4	14
Transfer	-	-	-
Writs of mandamus:			
Granted	-	-	-
Granted-in-part	-	-	-
Denied	-	-	-
Dismissed	-	-	-
Total ex parte cases pending as of 9/30/02	19	15	34

TABLE 25

CASES IN LITIGATION

(Selected Courts of the United States, as of September 30, 2002)

	PATENTS	TRADEMARKS	TOTAL
Inter partes cases			
Cases pending as of 9/30/01	57	125	182
Cases filed during FY 02	18	13	31
Disposals, total	15	10	25
Affirmed	4	4	8
Reversed	0	3	3
Remanded	3	-	3
Dismissed	6	3	9
Amicus/intervene	2	-	2
Total inter partes cases pending as of 9/30/02	60	128	188
Total United States Courts of Appeals cases pending as of 9/30/02	79	143	222
Supreme Court			
Ex parte cases			
Cases pending as of 9/30/01	-	-	-
Cases filed during FY 02	5	-	5
Disposals, total	4	-	4
Cases pending as of 9/30/02, total	1	-	1
Notices of Suit filed in FY 2002	4,334	8,162	12,496
- Represents zero			
1/ Includes Federal Circuit and others.			

20 Years of Statistics

FY	Applications		Patents	New		Total	New		Total,
	Applications (UPRD) filed	(UPRD) pending	(UPRD) issued	Appeals	Disposed	EOFY	Interferences	Disposed	EOFY
1981	114,170	181,727	71,010	3,871	3,822	4,968	211	268	531
1982	124,800	216,509	65,152	3,506	3,693	4,781	193	242	482
1983	105,704	223,101	59,715	3,678	3,398	5,061	180	242	420
1984	117,985	219,567	72,149	4,553	3,716	5,898	192	245	367
1985	125,931	215,512	75,302	4,812	3,692	7,018	159	206	320
1986	131,403	207,774	76,993	4,980	3,761	8,237	166	184	302
1987	137,173	209,911	88,793	4,420	4,811	7,846	179	152	329
1988	148,183	215,280	83,584	4,270	5,809	6,307	196	182	343
1989	163,306	222,755	102,712	3,289	5,594	4,542	209	166	386
1990	174,711	244,964	96,727	3,356	5,210	2,688	221	222	347
1991	178,083	254,507	101,860	3,649	4,747	1,590	212	235	324
1992	185,446	269,596	109,728	4,281	4,000	1,871	292	245	371
1993	188,099	244,646	107,332	4,487	4,085	2,273	259	235	395
1994	201,554	261,249	113,268	4,481	3,000	3,754	240	250	385
1995	236,679	298,522	114,241	5,525	3,446	5,533	147	197	334
1996	206,276	303,720	116,875	4,998	3,167	7,364	93	151	276
1997	237,045	275,295	122,977	4,639	2,802	9,201	287	115	448
1998	256,666	379,484	154,579	3,779	4,091	8,889	189	204	433
1999	278,268	414,837	159,166	4,040	4,585	8,344	91	187	337
2000	311,807	485,129	182,223	2,982	5,004	6,322	136	178	286
2001	344,717	542,007	187,822	3,854	5,126	5,050	124	193	218
2002	353,394	636,530	177,317	3,125	5,085	3,090	109	157	171

What about the future? (Part 1)

Reexamination changes:

Altered standard for ordering or continuing reexamination (“Sections 303(a) and 312(a) of title 35, United States Code, are each amended by adding at the end the following: ‘The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.’.”)

What about the future? (Part 1)

Reexamination changes:

New right of dissatisfied 3rd party to appeal to the Court of Appeals for the Federal Circuit

(“Section 315(b) of title 35, United States Code, is amended to read as follows:

“(b) THIRD-PARTY REQUESTER- A third-party requester--

“(1) may appeal under the provisions of section 134, and may appeal under the provisions of sections 141 through 144, with respect to any final decision favorable to the patentability of any original or proposed amended or new claim of the patent; and

“(2) may, subject to subsection (c), be a party to any appeal taken by the patent owner under the provisions of section 134 or sections 141 through 144.”)

TABLE 13A

EX PARTE REEXAMINATION
(FY 1998 - FY 2002)

ACTIVITY	1998	1999	2000	2001	2002
Requests filed, total	350	385	318	296	272
By patent owner	168	173	137	144	121
By third party	178	181	172	150	140
Commissioner ordered	4	31	9	2	11
Determinations on requests, total	348	367	338	342	272
Requests granted:					
By examiner	315	327	320	263	262
By petition	2	1	2	2	1
Requests denied	31	39	16	77	9
Requests known to have related litigation	66	62	80	80	52
Filings by discipline, total	350	385	318	296	272
Chemical	120	138	96	90	87
Electrical	94	107	103	89	78
Mechanical	136	140	119	117	107

TABLE 13B

INTER PARTES REEXAMINATION
(FY 2000 - FY 2002)

ACTIVITY	2000	2001	2002
Requests filed, total	-	1	4
Determinations on requests, total	-	-	5
Requests granted:	-	-	5
By examiner	-	-	-
By petition	-	-	-
Requests denied	-	-	-
Requests known to have related litigation	-	-	-
Filings by discipline, total	-	1	4
Chemical	-	1	2
Electrical	-	-	-
Mechanical	-	-	2

What about the future? (Part 2)

21st Century Strategic Plan includes a proposal for a new form of post grant proceeding; see issue paper P-05-01 which forms part of the Strategic Plan. For details, see pp. 346-374 of the pdf version of the Plan, available at <http://www.uspto.gov/web/offices/com/strat21/index.htm>.

What about the future?

Envisioned plan for post grant proceedings

- “would allow the public to petition the USPTO to cancel one or more claims in a patent within one year of its issue date” and
- would allow “anyone who is threatened with a patent infringement suit to petition for review within four months of being threatened.”

Proceedings would be *inter partes* and conducted before the Board.

Parties would have right of review in the Court of Appeals for the Federal Circuit.

Practice Tips in Ex Parte Appeals

Read MPEP Chapter 1200

Know where your case is located

New evidence after Notice of Appeal has been filed -- 37 CFR § 1.195

Separate argument of claims -- 37 CFR § 1.192(c)(7)

Ex parte hearings

Know where your case is located

Make sure your case is located at the Board
after the briefing is completed. Use PAIR
to monitor movement of your case.

37 CFR § 1.195

“Affidavits, declarations, or exhibits submitted after the case has been appealed will not be admitted without a showing of good and sufficient reasons why they were not earlier presented.”

Submissions with Appeal and/or Reply Brief

It is helpful if copies of documents/evidence relied upon in the briefing, regardless of when entered, are attached.

In discussing the documents/evidence point out where in the record they were submitted to and entered by the examiner.

Separate argument of claims

Separate argument of claims

1. If claims are to be separately argued, simply state “Claims do not stand or fall together.”
2. Use headings in “Argument” section of brief to highlight argument.

For example in the “Argument” section a series of headings such as these can be used for each rejection:

- I. Arguments in response to enablement rejection.
 - A. Separate argument for claim 1.
 - B. Claims 2-3 are not separately argued.
 - C. Separate argument for claim 4.

Hearings

Be prepared to discuss the record and especially claim scope.

No new arguments—all arguments must be set forth in briefing.

Any visual aids, models or demonstrations must be based upon the record developed in front of the examiner.