An Empirical Study of Patent Prosecution Success after the Filing of a Notice of Appeal

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During patent prosecution in the United States Patent and Trademark Office ("USPTO"), filing a notice of appeal to contest the final rejection of patent claims has traditionally been viewed as a drastic strategy of last resort. Some studies have analyzed patent appeals to the Board of Patent Appeals and Interferences ("BPAI"), and have tended to focus on final decisions made by the BPAI. Appeals decided by the BPAI are often unfavorable to patent applicants, leading to abandonment of their patent applications. However, there are a number of discrete stages between the filing of a notice of appeal and a BPAI decision. This study uses a nearly comprehensive dataset on patent appeals spanning the last decade to analyze patent outcomes at each of the following stages: (1) notice of appeal but no applicant brief or request for pre-appeal review; (2) appeal withdrawn from appeal process following request for pre-appeal review; (3) appeal exiting appeal process after applicant's brief but before examiner's reply; (4) appeal exiting appeal process after examiner's reply but before BPAI decision; and (5) patent applications receiving a BPAI decision. We find that patent applications fare surprisingly well in each of the stages preceding a BPAI decision, and we offer not only aggregate analysis across all technical arts, but also analysis for individual art units in the USPTO. Specifically, patent applications that exit the appeals process prior to a BPAI decision are far more likely to be allowed, filed as an request for continued examination, or receive either a non-final or final Office action than they are to be abandoned. This suggests that filing a notice of appeal, far from being a desperate prosecutorial act, may actually be a relatively effective strategy for garnering a positive outcome in patent prosecution prior to the delivery of a BPAI decision.