



# Federal Register

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**Tuesday,  
June 10, 2008**

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## **Part IV**

# **Department of Commerce**

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**Patent and Trademark Office**

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**37 CFR Part 41**

**Rules of Practice Before the Board of  
Patent Appeals and Interferences in Ex  
Parte Appeals; Final Rule**

**DEPARTMENT OF COMMERCE****United States Patent and Trademark Office****37 CFR Part 41**

[Docket No. PTO-P-2007-0006]

RIN 0651-AC12

**Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals****AGENCY:** United States Patent and Trademark Office, Commerce.**ACTION:** Final rule.

**SUMMARY:** The Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office amends the rules governing practice before the Board of Patent Appeals and Interferences in *ex parte* patent appeals. Amendments to the rules governing practice before the Board in *ex parte* appeals are needed to permit the Board to handle an increasing number of *ex parte* appeals in a timely manner.

**DATES:** *Effective Date:* December 10, 2008.

*Applicability Date:* The final rule shall apply to all appeals in which an appeal brief is filed on or after the effective date.

**FOR FURTHER INFORMATION CONTACT:** Fred E. McKelvey or Allen R. MacDonald at 571-272-9797.

**SUPPLEMENTARY INFORMATION:****Background**

A notice of proposed rulemaking was published in the **Federal Register** (72 FR 41,472-41,490 (Jul. 30, 2007)). The notice was also published in the Official Gazette, 1321 Off. Gaz. Pat. Office 95 (Aug. 21, 2007). The public was invited to submit written comments. Comments were to be received on or before September 30, 2007. Comments received on or before October 15, 2007, were considered. Comments received after October 15, 2007, were not considered.

Existing rules in Part 1 are denominated as "Rule x" in this **SUPPLEMENTARY INFORMATION**. A reference to Rule 136(a) is a reference to 37 CFR 1.136(a) (2007).

Existing rules in Part 41 are denominated as "Rule 41.x" in this **SUPPLEMENTARY INFORMATION**. A reference to Rule 41.3 is a reference to 37 CFR 41.3 (2007).

Proposed rules in the notice of proposed rulemaking and this final rule are denominated as "Bd.R. x" in this **SUPPLEMENTARY INFORMATION**. A reference to Bd.R. 41.3 is a reference to

Bd.R. 41.3, as proposed to be amended in the notice of proposed rulemaking, or Bd.R. 41.3 as amended by this final rule.

A portion of the Board's jurisdiction is to consider and decide *ex parte* appeals in patent applications (including reissue, design and plant patent applications) and *ex parte* reexamination proceedings.

Presently, the Board is experiencing a rapid increase in *ex parte* appeals. In FY 2007, the Board received 4639 *ex parte* appeals. The number of appeals received in FY 2007 exceeded the appeals received in FY 2006 by more than 1000 appeals. In FY 2008, the Board expects to receive more than 6000 *ex parte* appeals. The amendments to the rules governing *ex parte* appeals are one item of a five point plan to ensure that the Board will be able to handle an increasing number of *ex parte* appeals in a timely manner. Some of the changes are modeled after the Federal Circuit rules.

The amended rules make clear that the Board is not a tribunal for *de novo* examination. The rules establish procedures to determine whether an appellant has established that the examiner erred. For example, the rules require the appellant's argument shall explain why the examiner is believed to have erred as to each rejection to be reviewed. Arguments not made are waived.

A major objective of the amended rules is to avoid unnecessary returns to examiners by the Appeals Center and the Board, along with the resulting delays in application and appeal pendency. The requirements of the amended rules are believed to be more objective and, therefore, both appellants and examiners will have a better understanding of what is required, thereby minimizing, if not eliminating, a need to hold appeal briefs defective. If a rule does not require an action to be taken in connection with an appeal brief, then a brief will not be held defective for failure to take that action. Some former rules have turned out in practice to be too subjective. For example, the former rules require a summary of the invention. Appellants, as well as examiners, have given different interpretations to the requirement for a summary of the invention. The amended rules replace the requirement for a summary of the invention with a claims and drawing analysis and a means or step plus function analysis. Appellants have also had difficulty complying with the evidence appendix requirement. Compliance with the amended rules is expected to ensure that the Appeals Center and the Board, working together,

can minimize, possibly eliminate, unwarranted returns to examiners based on non-compliant appeal brief requirements.

The amended rules are directed to improving appellant briefing. A 30-page limit for the brief will promote concise and precise writing. Any statement of the real party in interest, statement of related cases, table of contents, table of authorities, status of amendments, jurisdictional statement, signature block, and appendix are excluded from the 30-page limit. The amended rules also require a "statement of facts" section where the appellant is required to set out the material facts relevant to the rejections on appeal.

The amended rules require an "argument" section where an appellant shall explain why the examiner is believed to have erred as to each rejection to be reviewed. Any explanation must address all points made by the examiner with which the appellant disagrees and must identify where the argument was made in the first instance to the examiner or state that the argument has not previously been made to the examiner. By having a clear focus on the dispute and making clear what arguments have been and have not been presented to the examiner, the USPTO reviewers as well as the examiner can make a well-informed decision on (1) whether to proceed with the appeal or (2) whether to withdraw the rejection.

Finally, the amended rules improve uniform enforcement of the rules. Petitions are decided by the Chief Administrative Patent Judge of the Board. Under former rules, petitions are decided by the Director of each Technology Center. The rules also allow for sanctions which may be imposed against an appellant for failure to comply with an applicable rule.

The rules do not amend any of the rules relating to *inter partes* reexamination appeals. Except for citation of authorities, the rules do not amend any of the rules relating to contested cases.

**Explanation of New Rules**

What follows is a discussion of the new appeal rules. Further information relevant to particular rules appears in the analysis of comments portion of this final rule.

*Definitions*

Bd.R. 41.2 amends Rule 41.2 to eliminate from the definition of "Board" any reference to a proceeding under Bd.R. 41.3 relating to petitions to the Chief Administrative Patent Judge. Action by the Chief Administrative

Patent Judge is action on behalf of the Director by delegation to the Chief Administrative Patent Judge. *See* MPEP § 1002.02(f) (8th ed., Aug., 2006).

Bd.R. 41.2 also amends Rule 41.2 to eliminate a petition under Bd.R. 41.3 from the definition of contested case. At the present time, there are no petitions authorized in a contested case.

#### *Petitions*

Bd.R. 41.3 is amended to include a delegation of authority from the Director to the Chief Administrative Patent Judge to decide certain petitions authorized by Part 41. The delegation of authority would be in addition to that already set out in the MPEP § 1002.02(f) (8th ed., Aug., 2006). The petitions would include (1) seeking an extension of time to file certain papers after an appeal brief is filed in an *ex parte* appeal and (2) enlarging the page limit of an appeal brief, reply brief, or request for rehearing.

Bd.R. 41.3(b) is amended to define the scope of petitions which can be filed pursuant to the rules. Under Bd.R. 41.3(b), a petition could not be filed to seek review of issues committed by statute to a panel. *See, e.g., In re Dickinson*, 299 F.2d 954, 958 (CCPA 1962).

#### *Timeliness*

Bd.R. 41.4(c) is amended to add the phrase "Except to the extent provided in this part" and to revise paragraph 2 to read: "Filing of a notice of appeal and an appeal brief (*see* §§ 41.31(c) and 41.37(c))." The amendment restricts Bd.R. 41.4(c)(2) to the notice of appeal and appeal brief. The Chief Administrative Patent Judge would determine whether extensions are to be granted for the filing of most other papers during the pendency of the appeal.

#### *Citation of Authority*

The notice of proposed rulemaking did not propose a change to Bd.R. 41.12 which concerns citation of authority. Rule 41.12 currently requires the public to cite to specific reporters, including some parallel citations. The Board, however, no longer follows the practice specified in Rule 41.12, and does not use parallel citations. Accordingly, Bd.R. 41.12 is being amended to make the rule consistent with Board practice and minimize the citation burden on the public. Under Bd.R. 41.12, as amended, a citation to a single source, in the priority order set out in the rule, will be sufficient.

#### *Definitions*

Bd.R. 41.30 is amended to add a definition of "Record." The Record on appeal would be the official content of the file of an application or reexamination proceeding on appeal. In the rules, a reference to "Record" with a capital R is a reference to the Record as defined in Bd.R. 41.30. The definition advises applicants of what documents the Board will consider in resolving the appeal. The definition also makes it clear to any reviewing court what record was considered by the Board.

#### *Appeal to Board*

Bd.R. 41.31(a) provides that an appeal is taken from a decision of the examiner to the Board by filing a notice of appeal. The following language would be acceptable under the rule: "An appeal is taken from the decision of the examiner mailed [specify date appealed rejection was mailed]." An appeal can be taken when authorized by the statute 35 U.S.C. 134. The provision of Rule 41.31(b) that a notice of appeal need not be signed has been removed. Papers filed in connection with an appeal, including the notice of appeal, would need to be signed in accordance with § 1.33 of this title.

Bd.R. 41.31(b) requires that the notice of appeal be accompanied by the fee required by law and would refer to the rule that specifies the required fee.

Bd.R. 41.31(c) specifies the time within which a notice of appeal would have to be filed in order to be considered timely. The time for filing a notice of appeal appears in Rule 134.

Bd.R. 41.31(d) provides that a request for an extension of time to file a notice of appeal in an application is governed by Rule 136(a). Bd.R. 41.31(d) also provides that a request for an extension of time to file a notice of appeal in an *ex parte* reexamination proceeding is governed by Rule 550(c).

Bd.R. 41.31(e) defines a "non-appealable issue" as an issue that is not subject to an appeal under 35 U.S.C. 134. Non-appealable issues are issues (1) over which the Board does not exercise authority in appeal proceedings and (2) which are handled by a petition. Non-appealable issues include such matters as an examiner's refusal to (1) enter a response to a final rejection, (2) enter evidence presented after a final rejection, (3) enter an appeal brief or a reply brief, or (4) withdraw a restriction requirement. The rules contemplate that some petitions relating to non-appealable issues are to be decided by the Chief Administrative Patent Judge. Some of those non-appealable issues include: (1) A petition to exceed the

page limit and (2) a petition to extend the time for filing a paper in the appeal after the filing of the appeal brief. An applicant or patent owner dissatisfied with a decision of an examiner on a non-appealable issue would be required to seek review by petition before an appeal is considered on the merits. Failure to timely file a petition seeking review of a decision of the examiner related to a non-appealable issue would generally constitute a waiver to have those issues considered. The language "[f]ailure to timely file" would be interpreted to mean not filed within the time set out in the rules. For example, Rule 1.181(f) provides that any petition under Rule 181 not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely. The object of the amendment to the rule is to maximize resolution of non-appealable issues before an appeal is considered on the merits. Under current practice, an applicant or a patent owner often does not timely seek to have non-appealable issues resolved, thereby necessitating a remand by the Board to the examiner to have a non-appealable issue resolved. The remand adds to the pendency of an application or reexamination proceeding and, in some instances, may unnecessarily enlarge patent term adjustment. The Office intends to strictly enforce the waiver provisions of Bd.R. 41.31(e) with the view of making the appeal process administratively efficient. While the Office will retain discretion to excuse a failure to timely settle non-appealable issues, it is expected that exercise of that discretion will be reserved for truly unusual circumstances.

#### *Amendments and Evidence Filed After Appeal and Before Brief*

Bd.R. 41.33(a) provides that an amendment filed after the date a notice of appeal is filed and before an appeal brief is filed may be admitted as provided in Rule 116.

Bd.R. 41.33(b), under two circumstances, gives the examiner discretion to enter an amendment filed with or after an appeal brief is filed. A first circumstance would be to cancel claims, provided cancellation of claims does not affect the scope of any other pending claim in the proceedings. A second circumstance would be to rewrite dependent claims into independent form.

Bd.R. 41.33(c) provides that all other amendments filed after the date an appeal brief is filed will not be admitted, except as permitted by (1) Bd.R. 41.50(b)(1) (request for amendment after remand), (2) Bd.R.

41.50(d)(1) (request to reopen prosecution after entry of new ground of rejection by the Board), and (3) Bd.R. 41.50(e) (amendment after recommendation by the Board).

Bd.R. 41.33(d) provides that evidence filed after a notice of appeal is filed and before an appeal brief is filed may be admitted if (1) the examiner determines that the evidence overcomes at least one rejection under appeal and (2) appellant shows good cause why the evidence was not earlier presented. The first step in an analysis of whether evidence may be admitted is a showing of good cause why the evidence was not earlier presented. The Office has found that too often an applicant or a patent owner belatedly presents evidence as an afterthought and that the evidence was, or should have been, readily available. Late presentation of evidence is not consistent with efficient administration of the appeal process. Under the rule, the Office would strictly apply the good cause standard. *Cf. Hahn v. Wong*, 892 F.2d 1028 (Fed. Cir. 1989). For example, a change of attorneys at the appeal stage or an unawareness of the requirement of a rule would not constitute a showing of good cause. If good cause is not shown, the analysis ends and the evidence would not be admitted. In those cases where good cause is shown, a second analysis will be made to determine if the evidence would overcome at least one rejection. Even where good cause is shown, if the evidence does not overcome at least one rejection, the evidence would not be admitted. Alternatively, the examiner could determine that the evidence does not overcome at least one rejection under appeal and does not necessitate any new ground of rejection and on that basis alone could refuse to admit the evidence.

Bd.R. 41.33(e) provides that evidence filed after an appeal brief is filed will not be admitted except as permitted by (1) Bd.R. 41.50(b)(1) (request to reopen prosecution after entry of a remand by the Board), and (2) Bd.R. 41.50(d)(1) (request to reopen prosecution after new ground of rejection entered by the Board).

#### *Jurisdiction Over Appeal*

Bd.R. 41.35(a) provides that the Board acquires jurisdiction when the Board mails a docket notice. At an appropriate time after proceedings are completed before the examiner, a docket notice identifying the appeal number would be entered in the application or reexamination proceeding file and mailed to the appellant. A new docket notice identifying a new appeal number would be mailed upon return of the case

to the Board following remand. By delaying the transfer of jurisdiction until the appeal is fully briefed and the position of the appellant is fully presented for consideration by the examiner and the Office reviewers (appeal conferees), the possibility exists that the examiner will find some or all of the appealed claims patentable without the necessity of proceeding with the appeal and invoking the jurisdiction of the Board. For this reason, jurisdiction transfers to the Board only after (1) the appellant has filed an appeal brief, (2) the examiner's answer has been mailed, and (3) the appellant has filed a reply brief or the time for filing a reply brief has expired. Rule 41.35(a) provides that the Board acquires jurisdiction upon transmittal of the file, including all briefs and examiner's answers, to the Board. Under that practice, however, an appellant may or may not know the date when a file is transmitted to the Board. Most files are now electronic files (Image File Wrapper or IFW file) as opposed to a paper file wrapper. Accordingly, a paper file wrapper is no longer transmitted to the Board. Under current practice, the Board prepares a docket notice which is (1) entered in the IFW file and (2) mailed to appellant. Upon receipt of the docket notice, appellant knows that the Board has acquired jurisdiction over the appeal. Bd.R. 41.35(a) codifies current practice and establishes a precise date, known to all involved, as to when jurisdiction is transferred to the Board.

Bd.R. 41.35(b) provides that the jurisdiction of the Board ends when (1) the Board mails a remand order (*see* § 41.50(b) or § 41.50(d)(1)), (2) the Board mails a final decision (*see* § 41.50(a) and judicial review is sought or the time for seeking judicial review has expired), (3) an express abandonment is filed which complies with § 1.138 of this title, or (4) a request for continued examination is filed which complies with § 1.114 of this title. The Board knows when it mails a remand order and when it mails a final decision. The Board does not know if an express abandonment or a request for continued examination is filed. One problem the Board has had in the past is that an appellant does not notify the Board that it has filed an express abandonment or a request for continued examination and the Board continues to work on the appeal. Often failure to notify occurs after oral hearing. Accordingly, an appellant should notify the Board immediately if an express abandonment or a request for continued examination is filed. If any notification reaches the Board after a remand order or a final decision is

mailed, the remand order or final decision will not be removed from the file.

There are two occasions when a remand is entered. First, a remand is entered when the Board is of the opinion that clarification on a point of fact or law is needed. *See* Bd.R. 41.50(b). Second, a remand is entered when an appellant elects further prosecution before the examiner following entry of a new ground of rejection by the Board. *See* Bd.R. 41.50(d)(1). Upon entry of a remand, the Board's jurisdiction ends.

The Board also no longer has jurisdiction as a matter of law when an appeal to the Federal Circuit is filed in the USPTO. *See In re Allen*, 115 F.2d 936, 939 (CCPA 1940) and *In re Graves*, 69 F.3d 1147, 1149 (Fed. Cir. 1995). A final decision is a panel decision which disposes of all issues with regard to a party eligible to seek judicial review and does not indicate that further action is needed. *See* Rule 41.2 (definition of "final"). When a party requests rehearing, a decision becomes final when the Board decides the request for rehearing. A decision including a remand or a new ground of rejection is an interlocutory order and is not a final decision. If an appellant elects to ask for rehearing to contest a new ground of rejection, the decision on rehearing is a final decision for the purpose of judicial review.

Bd.R. 41.35(c) would continue current practice and provide that the Director could *sua sponte* order an appeal to be remanded to an examiner before entry of a Board decision has been mailed. The Director has inherent authority to order a *sua sponte* remand to the examiner. Ordinarily, a rule is not necessary for the Director to exercise inherent authority. However, in this particular instance, it is believed that a statement in the rule of the Director's inherent authority serves an appropriate public notice function.

#### *Appeal Brief*

Bd.R. 41.37 provides for filing an appeal brief to perfect an appeal and sets out the requirements for appeal briefs. The appeal brief is a highly significant document in an ex parte appeal. Appeal brief experience under Rule 41.37 has been mixed. Bd.R. 41.37 seeks to (1) take advantage of provisions of Rule 41.37 which have proved useful, (2) clarify provisions which have been subject to varying interpretations by counsel, and (3) add provisions which are expected to make the decision-making process more focused and efficient.

Bd.R. 41.37(a) provides that an appeal brief shall be filed to perfect an appeal. Upon a failure to timely file an appeal brief, proceedings on the appeal would be considered terminated. The language "without further action on the part of the Office" gives notice that no action, including entry of a paper by the Office, would be necessary for the appeal to be considered terminated. Bd.R. 41.37(a) does not preclude the Office from entering a paper notifying an applicant or patent owner that the appeal has been terminated. Any failure of the Office to enter a paper notifying an applicant or patent owner that an appeal stands terminated would not affect the terminated status of the appeal. The language "proceedings are considered terminated" provides notice that when (1) no appeal brief is filed and (2) no claims are allowed, the time for filing a continuing application under 35 U.S.C. 120 would be before the time expires for filing an appeal brief. The language "terminated" is used because proceedings on appeal are over prior to mailing of a docket notice pursuant to Bd.R. 41.35(a). Dismissal of an appeal takes place after a docket notice is mailed since only the Board dismisses an appeal (Bd.R. 41.35(b)(2)).

Bd.R. 41.37(b) provides that the appeal brief shall be accompanied by the fee required by Bd.R. 41.20(b)(2).

Bd.R. 41.37(c) provides that an appellant must file an appeal brief within two months from the filing of the notice of appeal.

Bd.R. 41.37(d) provides that the time for filing an appeal brief is extendable under the provisions of Rule 136(a) for applications and Rule 550(c) for *ex parte* reexamination proceedings. Consideration was given to proposing a requirement for a petition to extend the time for filing an appeal brief. However, in view of the pre-appeal conference pilot program (*see* Official Gazette of July 12, 2005; <http://www.uspto.gov/web/offices/com/sol/og/2005/week28/patbref.htm>), and in an effort to encourage continued participation in that pilot program, further consideration on whether to require a petition will be deferred pending further experience by the Office in the pre-appeal conference pilot program.

Bd.R. 41.37(e) provides that an appeal brief must contain, under appropriate headings and in the order indicated, the following items: (1) Statement of the real party in interest, (2) statement of related cases, (3) jurisdictional statement, (4) table of contents, (5) table of authorities, (6) [reserved], (7) status of amendments, (8) grounds of rejection to be reviewed, (9) statement of facts, (10) argument, and (11) an appendix

containing (a) claims section, (b) claim support and drawing analysis section, (c) means or step plus function analysis section, (d) evidence section, and (e) related cases section. The items are otherwise defined in other subsections of Bd.R. 41.37 and, where applicable, would apply to appeal briefs and reply briefs (Bd.R. 41.41).

Bd.R. 41.37(f) requires a "statement of real party in interest" which would include an identification of the name of the real party in interest. The principal purpose of an identification of the name of the real party in interest is to permit members of the Board to assess whether recusal is required or would otherwise be appropriate. Another purpose is to assist employees of the Board to comply with the Ethics in Government Act. Since a real party in interest can change during the pendency of an appeal, there would be a continuing obligation to update the real party in interest during the pendency of the appeal. If an appeal brief does not contain a statement of real party in interest, the Office will assume that the named inventors are the real party in interest.

Bd.R. 41.37(g) requires an appeal brief to include a "statement of related cases." The statement of related cases would identify related cases by (1) application number, patent number, appeal number or interference number or (2) court docket number. The statement would encompass all prior or pending appeals, interferences or judicial proceedings known to any inventors, any attorneys or agents who prepared or prosecuted the application on appeal and any other person who was substantively involved in the preparation or prosecution of the application on appeal. A related case is one which would directly affect, or would be directly affected by or have a bearing on the Board's decision in the appeal. A copy of any final or significant interlocutory decision rendered by the Board or a court in any proceeding identified under this paragraph shall be included in the related cases section in the appendix (Bd.R. 41.37(u)). A significant interlocutory decision would include (1) a decision on a patentability motion in an interference or (2) a decision in an interference or a court interpreting a claim. A related case includes any continuing application of the application on appeal. If an appellant fails to advise the Board that it has filed a continuing application or a request for continued examination, or that it has filed an express abandonment of the application on appeal and the Board mails a decision on appeal in the application on appeal, the appellant

should expect that the decision will not be removed from the file. The time to update a statement of related cases, or notify the Board that an application on appeal has been abandoned, is when the continuing application, request for continued examination, or express abandonment is filed. Appellant would be under a continuing obligation to update a statement of related cases during the pendency of the appeal. If an appeal brief does not contain a statement of related cases, the Office will assume that there are no related cases.

Bd.R. 41.37(h) requires an appeal brief to contain a "jurisdictional statement" which would set out why an appellant believes that the Board has jurisdiction to consider the appeal. The jurisdictional statement would include a statement of (1) the statute under which the appeal is taken, (2) the date of the decision from which the appeal is taken, (3) the date the notice of appeal was filed, and (4) the date the appeal brief is being filed. If a notice of appeal or an appeal brief is filed after the time specified in the rules, the appellant also would have to indicate (1) the date an extension of time was requested, and (2) if known, the date the request was granted. A jurisdictional statement will minimize the chance that the Board will consider an appeal when the application on appeal is abandoned or a reexamination proceeding on appeal has terminated. An example of a jurisdictional statement is: "The Board has jurisdiction under 35 U.S.C. 134(a). The Examiner mailed a final rejection on August 1, 2006, setting a three-month shortened statutory period for response. The time for responding to the final rejection expired on November 1, 2006. Rule 134. A notice of appeal and a request for a one-month extension of time under Rule 136(a) was filed on November 15, 2006. The time for filing an appeal brief is two months after the filing of a notice of appeal. Bd.R. 41.37(c). The time for filing an appeal brief expired on January 16, 2007 (Monday, January 15, 2007, being a Federal holiday). The appeal brief is being filed on January 16, 2007." If during the preparation of a jurisdictional statement, an appellant becomes aware that its application is abandoned, the appellant could then take steps to revive the application, if revival is appropriate. *See* Rule 137.

Bd.R. 41.37(i) requires an appeal brief to contain a "table of contents" identifying the items listed in Bd.R. 41.37(e) along with a page reference where each item begins. In the case of a reply brief, the table of contents would

identify the items required by the reply brief rule (Bd.R. 41.41(d)).

Bd.R. 41.37(j) requires an appeal brief to contain a "table of authorities." This item would list (1) court and administrative decisions (alphabetically arranged), (2) statutes, and (3) other authorities, along with a reference to the pages of the appeal brief where each authority is cited. A similar requirement applies to a reply brief.

Bd.R. 41.37(k) is reserved.

Bd.R. 41.37(l) requires an appeal brief to indicate the "status of amendments" for all amendments filed after final rejection (e.g., entered or not entered). Examples of a status of amendments might read as follows: (1) "No amendment was filed after final rejection." (2) "An amendment filed October 31, 2006, was *not* entered by the examiner." (3) "An amendment filed November 1, 2006, was entered by the examiner." (4) "An amendment filed October 31, 2006, was not entered by the examiner, but an amendment filed November 1, 2006, was entered by the examiner."

Bd.R. 41.37(m) requires an appeal brief to set out the grounds of rejection to be reviewed, including the claims subject to each rejection. Examples might read as follows: (1) "Rejection of claim 2 as being anticipated under 35 U.S.C. 102(b) over Johnson." (2) "Rejection of claims 2-3 as being unpatentable under 35 U.S.C. 103(a) over Johnson and Young." (3) "Rejection of claim 2 as failing to comply with the written description requirement of the first paragraph of 35 U.S.C. 112." (4) "Rejection of claim 2 as failing to comply with the enablement requirement of the first paragraph of 35 U.S.C. 112." (5) "Rejection of claim 3 under 35 U.S.C. 251 based on recapture."

Bd.R. 41.37(n) requires a "statement of facts." Appellant will set out in an objective and non-argumentative manner the material facts relevant to the rejections on appeal, preferably in numbered paragraphs. A clear, concise and complete statement of relevant facts will clarify the position of an appellant on dispositive issues and assist the examiner in reconsidering the patentability of the rejected claims.

A significant requirement of Bd.R. 41.37(n) is that a fact would be required to be supported by a reference to the page number of the Record. Where appropriate, the citation should also be to a specific line or paragraph and to a drawing figure and element number of the Record (*see* Bd.R. 41.37(t)). Statements of facts should be set out in short declarative sentences, and each sentence should address a single fact.

For example, "In rejecting claims 1-5, the examiner cites Jones (col. 4, lines 1-4)." "Jones describes a widget (col. 5, lines 56-61 and Figure 1, elements 12 and 13)." A compound statement of fact is not proper, e.g., "Jones describes a widget (col. 8, lines 3-4) and Smith does not describe a widget." A statement of facts would have to be non-argumentative, meaning that an appellant would not be able to argue its appeal in the statement of facts. Rather, the statement of facts is designed to require an appellant to set out the facts which the appellant considers material for resolution of the appeal, thereby assisting the examiner initially and, if necessary, the Board thereafter to focus on the dispositive portions of the record. For example, in the case of a rejection for obviousness under section 103, the facts should address at least the scope and content of the prior art, any differences between the claim on appeal and the prior art, and the level of skill in the art. In the past, some appellants have provided minimal factual development in an appeal brief, apparently believing that the Board will scour the record to divine the facts. It should be remembered that when the appeal reaches the Board, the panel members do not know anything about the appellant's invention or the prosecution history of the application on appeal.

Likewise, too often an appellant will not support a statement of fact in an appeal brief by an explicit reference to the evidence. A statement of fact based on the specification would be proper if supported by a reference to page and line or paragraph (and where appropriate also to drawing figure and element number). A statement of fact based on a patent would be proper if it is supported by a reference to a column and line (and where appropriate also to a drawing figure and element number). A statement of fact based on an affidavit would be proper if supported by a reference to a page and line number or to a page and paragraph number of the affidavit; the affidavit would appear in the evidence section (Bd.R. 41.37(t)) in the appendix.

A specific citation is required because an appellant should not expect the examiner or the Board to search the record to determine whether a statement of fact is supported by the evidence. Bd.R. 41.37(n) is consistent with the approaches taken by federal courts concerning appeal brief practice and other briefing practice: (1) *Clintec Nutrition Co. v. Baxa Corp.*, 988 F. Supp. 1109, 1114, n.16 (N.D. Ill. 1997) (where a party points the court to a multi-page exhibit without citing a

specific portion or page, the court will not pour over the documents to extract the relevant information); (2) *Ernst Haas Studio, Inc. v. Palm Press, Inc.*, 164 F.3d 110, 112 (2d Cir. 1999) ("Appellant's Brief is at best an invitation to the court to scour the record, research any legal theory that comes to mind, and serve generally as an advocate for appellant. We decline the invitation."); (3) *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1351 (Fed. Cir. 2000) ("[W]e will not search the record on the chance of discovering \* \* \* whether the district court abused its discretion."); (4) *Gorence v. Eagle Food Centers, Inc.*, 242 F.3d 759, 762-63 (7th Cir. 2001) ("Little has been done \* \* \* to make slogging through the record here either more efficient or more pleasant. And it is simply not true, we want to emphasize, that if a litigant presents an overload of irrelevant or non-probative facts, somehow the irrelevancies will add up to relevant evidence \* \* \*"); and (5) *DeSilva v. DiLeonardi*, 181 F.3d 865, 867 (7th Cir. 1999) ("[An appeal] brief must make all arguments accessible to the judges, rather than ask them to play archaeologist with the record.") *See also* (1) *Shiokawa v. Maienfisch*, 56 USPQ2d 1970, 1975 (Bd. Pat. App. & Int. 2000) and (2) *LeVeon v. Edwards*, 57 USPQ2d 1406, 1413 (Bd. Pat. App. & Int. 2000).

Bd.R. 41.37(o) requires that an appeal brief contain an argument comprising an analysis explaining, as to each rejection to be reviewed, why the appellant believes the examiner erred. The analysis would have to address all points made by the examiner with which the appellant disagrees. The presentation of a concise, but comprehensive, argument in response to the final rejection (1) will efficiently frame any dispute between the appellant and the examiner not only for the benefit of the Board but also for consideration by the examiner and Office reviewers (appeal conferees) and (2) provide the best opportunity for resolution of the dispute without the necessity of proceeding with the appeal.

Where an argument has previously been presented to the examiner, the analysis would have to identify where any argument being made to the Board was made in the first instance to the examiner. Where an argument has not previously been made to the examiner, an appellant would be required to say so in the appeal brief so that the examiner would know that the argument is new. An example where an argument might not have been previously made to an examiner might occur under the following fact scenario. A first Office action rejects claims over Reference A. Applicant amends the

claims to avoid Reference A. The examiner enters a final rejection now relying on References A and B. Applicant elects to appeal without filing a response under Rule 116. While applicants are encouraged to file a response under Rule 116 to possibly avoid an appeal all together, at the present time there is no requirement for an applicant to file a Rule 116 response as a condition to taking an appeal to the Board. Whether such a requirement should be made in the future will be held in abeyance pending experience under the rules. The Board has found that many arguments made in an appeal brief were never earlier presented to the examiner even though they could have been presented (without filing a Rule 116 response). To promote clarity, Bd.R. 41.37(o) also requires that each rejection for which review is sought shall be separately argued under a separate heading. Also, Bd.R. 41.37(o) provides that any finding made or conclusion reached by the examiner that is not challenged would be presumed to be correct.

Bd.R. 41.37(o)(1) provides that when a ground of rejection applies to two or more claims, the claims may be argued separately (claims are considered by appellant as separately patentable) or as a group (claims stand or fall together). When two or more claims subject to the same ground of rejection are argued as a group, the Board may select a single claim from the group of claims that are argued together and decide the appeal on the basis of the selected claim alone with respect to the group of claims as to the ground of rejection. Any doubt as to whether an election has been made would be resolved against the appellant and the claims would be deemed to have been argued as a group.

For each claim argued separately, a subheading identifying the claim by number would be required. The requirement for a separate subheading in the appeal brief is to minimize any chance the examiner or the Board will overlook an argument directed to the separate patentability of a particular claim. In the past, appellants have been confused about whether a statement of what a claim covers is sufficient to constitute an argument that the claim is separately patentable. It is not. A statement that a claim contains a limitation not present in another claim would not in and of itself be sufficient to satisfy the requirement of Bd.R. 41.37(o)(1) that a separate argument be made.

Unless an appellant plans to argue the separate patentability of a claim, the appellant should not discuss or refer to the claim in the argument section of the

appeal brief. A copy of the claims will be before the Board in the "claims section" (Bd.R. 41.37(p)). In an application containing claims 1–3 where the examiner has made (1) a § 102 rejection or (2) a § 103 rejection or (3) both a § 102 and § 103 rejection, examples of a proper statement of "claims standing or falling together" would be as follows: (1) "With respect to the rejection under § 102, claims 1–3 stand or fall together." (2) "With respect to the rejection under § 103, claims 1–2 stand or fall together; claim 3 is believed to be separately patentable." (3) "With respect to the rejection under § 102, claims 1–2 stand or fall together; claim 3 is believed to be separately patentable. With respect to the rejection under § 103, the claims stand or fall together."

Bd.R. 41.37(o)(2) provides that the Board would only consider arguments that (1) are presented in the argument section of the appeal brief and (2) address claims set out in the claim support and drawing analysis section in the appendix. Appellant would waive all arguments which could have been, but were not, addressed in the argument section of the appeal brief. A first example would be where Argument 1 and Argument 2 are presented in response to a final rejection, but only Argument 1 is presented in the appeal brief. Only Argument 1 would be considered. Argument 2 would be waived. A second example would be where an applicant presents an affidavit under Rule 131 or Rule 132 to the examiner, but does not rely on the affidavit in the argument section of the appeal brief. The Board would not consider the affidavit in deciding the appeal.

Bd.R. 41.37(o)(3) requires that when responding to points made in the final rejection, the appeal brief shall specifically (1) identify each point made by the examiner and (2) indicate where appellant previously responded to each point or state that appellant has not previously responded to the point. In supporting any argument, the appellant shall refer to a page and, where appropriate, a line or paragraph, of the Record. Examples of argument formats that are acceptable under Bd.R. 41.37(o)(3) follow.

*Example 1.* In the case where an argument had been previously presented to the examiner, the following format is acceptable under Bd.R. 41.37(o)(3). "The examiner states that Reference A teaches element B. Final Rejection mailed [insert date], page x, lines y-z. In response, appellant previously pointed out to the examiner why the examiner is believed to have erred. Amendment filed [enter date], pages 8–9. The

response is [concisely state the response]." A similar format has been successfully used for some years in oppositions and replies filed in interference cases.

*Example 2.* Alternatively, in the case where an argument has not been previously made to the examiner, the following format would be acceptable under Bd.R. 41.37(o)(3). "In response to the examiner's reliance on Reference C for the first time in the final rejection (page 4), appellant's response includes a new argument which has not been previously presented to the examiner. The response is [concisely state the response]." Use of this format will minimize any chance that the examiner will overlook an argument when preparing the examiner's answer.

Bd.R. 41.37(p) would require an appeal brief to contain a "claims section" in the appendix which would consist of an accurate clean copy in numerical order of all claims pending in the application or reexamination proceeding on appeal. The claims section in the appendix would include all pending claims, not just those under rejection. The status of each claim would have to be indicated, (e.g., 1 (rejected), 2 (withdrawn), 3 (objected to), 4 (cancelled), and 5 (allowed)).

Bd.R. 41.37(q) is reserved.

Bd.R. 41.37(r) requires an appeal brief to contain a "claim support and drawing analysis section."

The claim support portion of Bd.R. 41.37(r) replaces Rule 41.37(c)(1)(v) which required a concise explanation of the subject matter defined in each of the independent claims on appeal. The claim support section, for each independent claim involved in the appeal and each dependent claim argued separately (*see* Bd.R. 41.37(o)(1)), would consist of an annotated copy of the claim indicating in bold face between braces { } after each limitation where, by page and line or paragraph numbers, the limitation is described in the specification as filed. Braces { } are used instead of brackets ([ ]) because brackets are used in reissue claim practice. Unlike the "claims section" (*see* Bd.R. 41.37(p)), only those independent claims and dependent claims being argued separately, would need to appear in the "claim support and drawing analysis section." A significant objective of the claim support requirement is to provide the examiner and the Board with appellant's perspective on where language of the claims (including specific words used in the claims, but not in the specification) finds support in the specification. Finding support for language in the claims can help the examiner and the Board construe claimed terminology and limitations when applying the prior art. The claim support requirement will help the Board

interpret the scope of claims, or the meaning of words in a claim, before applying the prior art. Practice under Rule 41.37(c)(1)(v) has not been efficient because of the diverse manners in which different appellants have attempted to comply with the current rule.

One significant problem faced by the Board under Rule 41.37(c)(1)(v) occurs when the language of a claim does not have direct antecedent language in the specification. In order for the Board to understand the scope of a claim or the meaning of a term in the claim, the Board primarily relies on the specification. Moreover, in practice before the Office, a claim is given its broadest reasonable construction consistent with the specification. However, when the language of the claim does not find correspondence in the specification, as filed, often it is difficult to determine the meaning of a particular word in a claim or to give the claim its broadest reasonable interpretation. The claim support requirement will give the examiner and the Board the appellant's view on where the claim is supported by the application, as filed. The requirement is expected to significantly improve the efficiency of the Board's handling of appeals.

The "claims support and drawing analysis section" also requires for each independent claim on appeal and each dependent claim argued separately (see Bd.R. 41.37(o)(1)), that a drawing analysis consist of an annotated copy of the claim in numerical sequence, indicating in bold face between braces ( { } ) (the same braces used to identify references to the specification) after each limitation where, by reference or sequence residue number, each limitation is shown in the drawing or sequence. A drawing analysis has been required in interference cases since 1998 and has proven useful to the Board in understanding claimed inventions described in applications and patents involved in an interference. The drawing analysis requirement is expected to be equally useful in *ex parte* appeals.

Bd.R. 41.37(s) requires an appeal brief to contain a "means or step plus function analysis section." The means or step plus function analysis section replaces the requirement of Rule 41.37(c)(1)(v) relating to identification of structure, material or acts for means or step plus function claim limitations contained in appealed claims. Under Bd.R. 41.37(s), the means or step plus function analysis section would include each independent claim and each dependent claim argued separately (see

Bd.R. 41.37(o)(1)) that contains a limitation that appellant regards as a means or step plus function limitation in the form permitted by the sixth paragraph of 35 U.S.C. 112. Further, for each such claim, a copy of the claim would be reproduced indicating in bold face between braces ( { } ) the specific portions of the specification and drawing that describe the structure material or acts corresponding to each claimed function.

The Office is requiring a particular format for the means or step plus function analysis section to avoid the confusion that arises from the variety of ways appellants employ under current practice in attempting to comply with the requirements of Rule 41.37(c)(1)(v). A means or step plus function analysis essentially tracking Bd.R. 41.37(s) has been used in interference cases since 1998 and has been helpful in determining the scope of claims involved.

Bd.R. 41.37(t) would require an appeal brief to contain an "evidence section" in the appendix. The evidence section essentially continues the practice under Rule 41.37(c)(1)(ix). The evidence section would include (1) table of contents, (2) affidavits and declarations upon which the appellant relied before the examiner, (3) other evidence upon which the appellant relied before the examiner, and (4) evidence relied upon by the appellant and admitted into the file pursuant to Bd.R. 41.33(d).

Documents in the evidence appendix would not have to be reformatted to comply with format requirements of the appeal brief. However, the affidavits, declarations and evidence required by Bd.R. 41.37(t) which is otherwise mentioned in the appeal brief, but which does not appear in the evidence section will not be considered. Rule 41.37(c)(1)(ix) has a similar provision, but appellants have not attached the evidence appendix required by that rule. Appellants will now be on notice of the consequence of failing to comply with Bd.R. 41.37(t).

If the examiner believes that other material should be included in the evidence section, the examiner would be able to attach that evidence to the examiner's answer. Pursuant to Bd.R. 41.37(v)(1), all pages of an appeal brief or a reply brief (including appendices to those briefs) will be consecutively numbered beginning with page 1.

Bd.R. 41.37(u) requires an appeal brief to contain a "related cases section" in the appendix. The related cases section consists of copies of orders and opinions required to be cited pursuant to Bd.R. 41.37(g).

Bd.R. 41.37(v) requires an appeal brief to be presented in a particular format. The appeal brief would have to comply with the format of Rule 52 as well as with other requirements set out in Bd.R. 41.37(v)(1), (2) and (4) through (6).

Bd.R. 41.37(v)(1) requires that the pages of an appeal brief, including all sections in the appendix, be consecutively numbered using Arabic numerals beginning with the first page of the appeal brief, which would be numbered page 1. This practice would prevent (1) re-starting numbering with each section in the appendix or (2) using Roman numeral page numbers, e.g., I, II, V, etc., or page numbers with letters, e.g., "a", "b", "c", "i", "ii", etc. If an appellant chooses to number the lines, line numbering may be within the left margin. Line numbering has been used for some time in interference cases and has been found to be useful when making reference in oppositions, replies, and opinions of the Board.

Bd.R. 41.37(v)(2) would require that text in an appeal brief would be double spaced except in headings, tables of contents, tables of authorities, signature blocks and certificates of service. Block quotations would be indented, but could be presented in double spaced or space and a half format. Footnotes, which are discouraged, would be double spaced.

Bd.R. 41.37(v)(3) is reserved. Bd.R. 41.37(v)(4) requires that the font size be 14 point, including the font for block quotations and footnotes.

Bd.R. 41.37(v)(5) provides that an appeal brief may not exceed 30 pages, excluding any (1) statement of the real party in interest, (2) statement of related cases, (3) jurisdictional statement, (4) table of contents, (5) table of authorities, (6) status of amendments, (7) signature block and (8) appendix. To give meaning to the 30-page limitation, an appeal brief would not be permitted to incorporate by reference arguments from other papers in the evidence appendices or from any other source. The prohibition against incorporation by reference is necessary to prevent an appellant from adding to the length of an appeal brief. *Cf. DeSilva v. DiLeonardi*, 181 F.3d 865, 866-67 (7th Cir. 1999) ("[A]doption by reference amounts to a self-help increase in the length of the appellate brief. \* \* \* [I]ncorporation [by reference] is a pointless imposition on the court's time. A brief must make all arguments accessible to the judges, rather than ask them to play archaeologist with the record.") (citation omitted). A prohibition against incorporation by reference has been the practice in interference cases since 1998 and has



minimized the chance that an argument is overlooked.

A request to exceed the 30-page limit would be made by petition under Bd.R. 41.3 at least ten calendar days prior to the date an appeal brief is due.

Bd.R. 41.37(v)(6) requires a signature block which would identify the appellant or appellant's representative, as appropriate, and a mailing address, telephone number, fax number and e-mail address.

#### *Examiner's Answer*

Bd.R. 41.39(a) provides that within such time and manner as may be directed by the Director and if the examiner determines that the appeal should go forward, the examiner shall enter an examiner's answer responding to the appeal brief. The specific requirements of what would be required in an examiner's answer would appear in the Manual of Patent Examining Procedure.

Bd.R. 41.39(b) provides that a new ground of rejection can no longer be made in the examiner's answer.

Generally, a new ground of rejection in an Examiner's Answer occurs when an applicant has not had a fair opportunity in the appeal brief to react to the "thrust of the rejection" made in the final rejection. *In re Kronig*, 539 F.2d 1300, 1302 (CCPA 1976). Stated in slightly different terms, a test for determining whether a rejection in the Examiner's Answer is "new" vis-à-vis the rejection made in the final rejection is whether the "basic thrust" of "rejection" in the Examiner's Answer and the rejection made in the final rejection "are different." *In re Ansel*, 852 F.2d 1294 (Fed. Cir. 1988) (non-precedential). *In re DeBlauwe*, 736 F.2d 699, 706 n.9 (Fed. Cir. 1984) notes that "[w]here the board makes a decision advancing a position or rationale new to the proceedings, an applicant must be afforded an opportunity to respond to that position or rationale by submission of contradicting evidence [or argument]." Whether a new ground of rejection has been made in an Examiner's Answer is evaluated on a case-by-case basis. See *Kronig*, 539 F.2d at 1303 (CCPA did not find cited precedent "controlling in view of the distinctive facts at bar"). An applicant met with a new ground of rejection in an Examiner's Answer is entitled to a response to meet the new ground, including an opportunity to present new evidence, an amendment to claims or both. In *Kronig*, there was no new ground of rejection where (1) the Examiner relied on Hoechst, Holzrichter, Yasui and Swift patents and (2) the Board used the same basis

as the Examiner, and, without disagreeing with the Examiner's approach, limited its discussion to the evidence contained in Holzrichter, Yasui and Swift. 539 F.2d at 1303. On the other hand in *Ansel*, a new ground of rejection occurred when (1) the Examiner relied on Hodakowski and Bhatia, (2) the Board dismissed Bhatia as superfluous, and (3) for the first time relied on a general and brief description in Hodakowski as to what Hodakowski considered prior art. *In re Bush*, 296 F.2d 491 (CCPA 1961), states that where a "rejection is stated to be on A in view of B instead of on B in view of A, or to term one reference primary and the other secondary" is a matter of "no significance, but merely a matter of exposition" where the relevant part of each can be found. 296 F.2d at 760. *In re Kumar*, 418 F.3d 1361 (Fed. Cir. 2005), held that the Board erred in not treating as a new ground of rejection an affirmation based on calculations made by the Board in the first instance and where the Board declined to consider evidence in a petition for rehearing. *In re Gately*, 69 Fed. Appx. 993 (Fed. Cir. 2003) (non-precedential), the Board designated as a new ground of rejection an affirmation based on calculations not previously made. In a request for rehearing to the Board, Gately elected to present only argument. On appeal to the Federal Circuit, Gately urged that he be given a further opportunity on remand to present contrary evidence. The Federal Circuit denied Gately's request, noting that the Board had given Gately the very opportunity he was then requesting, but that Gately had declined the opportunity before the Board. Under the rules, an applicant does not have to file a Rule 116 response after a final rejection citing a new reference to meet a limitation in a claim amended by the applicant in response to the first Office action. If the response to the new reference is made for the first time in the appeal brief, it would not be a new ground of rejection in an Examiner's Answer if the Examiner relies on any part of the record, or yet another reference, to meet the new argument made for the first time in the appeal brief. *Cf. In re Plockinger*, 481 F.2d 1327, 1330-1332 (CCPA 1973) ("the Solicitor should be allowed to point out to us the facts underlying Peras' concept of the index of basicity, all of which were before the board, in order to rebut appellants' contentions with regard thereto."). Appellants can avoid the *Plockinger* scenario by filing a Rule 116 response after final rejection. By not filing a Rule 116 response after final rejection, an appellant runs a risk that

it will be confronted for the first time in the Examiner's Answer with new rationale in support of the rejection or new evidence or both. The appellant would then have to elect whether to proceed with the appeal or refile the application.

#### *Reply Brief*

Bd.R. 41.41(a) provides that an appellant may file a single reply brief responding to the examiner's answer. On too many occasions, appellants have filed a first reply brief and thereafter a second reply brief. Only one reply brief is authorized under Bd.R. 41.41(a). A second reply brief will not be considered.

Bd.R. 41.41(b) provides that the time for filing a reply brief would be within two months of the date the examiner's answer is mailed.

Bd.R. 41.41(c) provides that a request for an extension of time shall be presented as a petition under Bd.R. 41.3(a) and (c). A decision on the petition shall be governed by Bd.R. 41.4(a) of this part. The provisions of Rule 136(a) would no longer apply to extensions of time to file a reply brief.

Bd.R. 41.41(d) provides that a reply brief shall be limited to responding to points made in the examiner's answer. Except as otherwise set out in the rules, the form and content of a reply brief would be governed by the requirements for an appeal brief as set out in Bd.R. 41.37. A reply brief would not be able to exceed 20 pages, excluding any (1) table of contents, (2) table of authorities, and (3) signature block. A reply brief would be required to contain, under appropriate headings and in the order indicated, the following items: (1) Table of contents, (2) table of authorities, (3) statement of additional facts, and (4) argument.

Bd.R. 41.41(e) is reserved.

Bd.R. 41.41(f) would require a statement of additional facts that appellant believes are necessary to respond to points raised in the examiner's answer. When there is a statement of additional facts, and the appellant has elected to number the facts in the appeal brief, any numbering of facts in the reply brief should start with the number following the last number in the appeal brief. For example, if Facts 1-10 are set out in the appeal brief and a statement of additional facts is required with a reply brief, the statement of additional facts in the reply brief should start with Fact 11.

Bd.R. 41.41(g) requires that an argument made in the reply brief be limited to responding to points made in the examiner's answer. Any argument raised in a reply brief which is not

responsive to a point made in the examiner's answer will not be considered and will be treated as waived. An example of an acceptable format for presenting an argument in a reply brief (where there was no new ground of rejection in the examiner's answer) might read as follows: First paragraph: "This is a reply to the examiner's answer mailed [insert the date the answer was mailed]." Last paragraph: "For the reasons given in this reply brief and in the appeal brief, reversal of the examiner's rejection is requested." All paragraphs between the first and last paragraphs should read: "On page x, lines y-z of the examiner's answer, the examiner states that [state what the examiner states]. The response is [concisely state the response]." As part of each response, the appellant should refer to the page number and line or paragraph and drawing element number of any document relied upon to support the response. Frequently, new details and arguments surface in reply briefs. Bd.R. 41.41(g) seeks to confine reply briefs to what they ought to be—a response to points raised in the examiner's answer. If it turns out that too many resources of the Office are needed to enforce the reply brief rule and considerable time is wasted in resolving improper reply brief issues, consideration may be given to further limiting the nature of replies filed in *ex parte* appeals.

Bd.R. 41.41(h) is reserved.

Bd.R. 41.41(i) provides that an amendment or new evidence may not accompany a reply brief. The Office has found that appellants continue to attempt to file amendments and evidence with reply briefs. If an appellant, after reviewing the examiner's answer, believes that an amendment is appropriate, the appellant may file a continuing application or a request for continued examination or, in the case of a reexamination proceeding, ask that the proceeding be reopened.

#### *Examiner's Response to Reply Brief*

Bd.R. 41.43 is reserved. An examiner will no longer be responding to a reply brief.

#### *Supplemental Reply Brief*

Bd.R. 41.44 is reserved. A supplemental reply brief is no longer authorized because the examiner will no longer be filing a response to a reply brief.

#### *Oral Hearing*

Bd.R. 41.47(a) provides that if the appellant desires an oral hearing, appellant must file, as a separate paper,

a written request captioned: "REQUEST FOR ORAL HEARING."

Bd.R. 41.47(b) provides that a request for oral hearing shall be accompanied by the fee required by § 41.20(b)(3).

Bd.R. 41.47(c) provides that the time for filing a request for an oral hearing would be within two months from the date the examiner's answer is mailed.

Bd.R. 41.47(d) provides that a request for an extension of time to request an oral hearing would have to be presented as a petition as specified in Bd.R. 41.3(a) and (c). A decision on the petition shall be governed by Bd.R. 41.4(a).

Bd.R. 41.47(e) provides that if an oral hearing is properly requested, a date for the oral hearing would be set.

Bd.R. 41.47(f) provides that if an oral hearing is set, then within such time as the Board may order, appellant shall confirm attendance at the oral hearing. Failure to timely confirm attendance would be taken as a waiver of any request for an oral hearing.

Bd.R. 41.47(g) provides that at the time appellant confirms attendance at the oral hearing, appellant would be required to supply a list of technical terms and other unusual words which can be provided to any individual transcribing an oral hearing. The current practice of the Board is to transcribe all oral arguments. A list of technical terms provided by appellant should improve the accuracy of any transcript.

Bd.R. 41.47(h) provides that unless otherwise ordered by the Board, argument on behalf of appellant at an oral hearing would be limited to 20 minutes.

Bd.R. 41.47(i) provides that at oral hearing only the Record will be considered. No additional evidence may be offered to the Board in support of the appeal. Any argument not presented in a brief cannot be made at the oral hearing.

Bd.R. 41.47(j) provides that notwithstanding Bd.R. 41.47(i), an appellant could rely on and call the Board's attention to a recent court or Board opinion which could have an effect on the manner in which the appeal is decided.

Bd.R. 41.47(k) provides that visual aids may be used at an oral hearing. However, visual aids must be limited to copies of documents or artifacts in the Record or a model or exhibit presented for demonstration purposes during an interview with the examiner. When an appellant seeks to use a visual aid, one copy of each visual aid (photograph in the case of an artifact, a model or an exhibit) should be provided for each judge and one copy to be added to the Record.

Bd.R. 41.47(l) provides that failure of an appellant to attend an oral hearing would be treated as a waiver of the oral hearing. Over the years, the Board has become concerned with the large number of requests for postponements. In some cases, multiple requests in a single appeal are submitted for postponement of an oral hearing. Apart from the fact that a postponement can lead to large patent term adjustments, efficiency dictates that the Board be able to set an oral hearing schedule with an expectation that in a large majority of the cases the oral hearing will timely occur or the appellant will waive oral hearing. The Board will continue to handle requests for postponement of oral hearings on an *ad hoc* basis. However, postponements would no longer be granted on a routine basis. A request for a postponement made immediately after a notice of oral hearing is mailed is more likely to receive favorable treatment, particularly since it may be possible to set an oral hearing date prior to the originally scheduled oral hearing date.

#### *Decisions and Other Actions by the Board*

Bd.R. 41.50(a) provides that the Board may affirm or reverse a decision of the examiner in whole or in part on the grounds and on the claims specified by the examiner. Bd.R. 41.50(a) continues a long-standing practice that an affirmance of a rejection of a claim on any of the grounds specified constitutes a general affirmance of the decision of the examiner on that claim, except as to any ground specifically reversed.

Bd.R. 41.50(b) provides that the Board may remand an application to the examiner. Upon entry of a remand, the Board would no longer have jurisdiction unless an appellant timely files a request for rehearing. If the request for rehearing does not result in modification of the remand, the Board would then lose jurisdiction. Upon remand, should the examiner enter an examiner's answer in response to the remand, appellant would be required to exercise one of two options to avoid abandonment of the application or termination of the reexamination proceeding. Either option would have to be exercised within two months from the date of any examiner's answer mailed in response to the remand.

Bd.R. 41.50(b)(1) specifies a first option and provides that appellant could request that prosecution be reopened before the examiner by filing a reply under Rule 111, with or without amendment or submission of evidence. Any amendment or evidence would have to be relevant to the issues set forth

in the remand or raised in any examiner's answer mailed in response to the remand. A request that complies with this paragraph would be entered and the application or patent under reexamination would be reconsidered by the examiner under the provisions of Rule 112. A request under Bd.R. 41.50(b)(1) would be treated as a request to dismiss the appeal.

Bd.R. 41.50(b)(2) specifies a second option and provides that appellant could request that the appeal be re-docketed. The request would have to be accompanied by a reply brief as set forth in Bd.R. 41.41. An amendment or evidence could not accompany the reply brief. A reply brief that is accompanied by an amendment or evidence would be treated as a request to reopen prosecution pursuant to Bd.R. 41.50(b)(1).

Bd.R. 41.50(c) provides that a remand is not a final decision. Following proceedings on remand, and with respect to affirmed rejections and claims not involved in the remand, an appellant could request the Board to enter a final decision so that the appellant could then seek judicial review as to those rejections and claims. Only a final decision of the Board is subject to judicial review. *Copelands' Enter., Inc. v. CNV, Inc.*, 887 F.2d 1065 (Fed. Cir. 1989) (*en banc*).

Bd.R. 41.50(d) provides that, should the Board have knowledge of a basis not involved in the appeal for rejecting a pending claim, the Board may enter a new ground of rejection. The pending claim could be a claim not rejected by the examiner. A new ground of rejection would not be considered final for purposes of judicial review. A new ground of rejection is not considered a final agency action because the appellant has not explained to the Board, without amendment or new evidence, or to the Office, with an amendment or new evidence or both, why the rejection is not proper. Bd.R. 41.50(d) places an appellant under a burden to explain to the Board or the Office why a new ground of rejection is not proper before it burdens a court with judicial review. A response by an appellant may convince the Office that a new ground of rejection should be withdrawn. If the Board enters a new ground of rejection, appellant would have to exercise one of two options with respect to the new ground of rejection to avoid dismissal of the appeal as to any claim subject to the new ground of rejection. Either option would have to be exercised within two months from the date of the new ground of rejection.

Bd.R. 41.50(d)(1) specifies that a first option would be to submit an

amendment of the claims subject to a new ground of rejection or new evidence relating to the new ground of rejection or both and request that the matter be reconsidered by the examiner. The proceedings would be remanded to the examiner. A new ground of rejection would be binding on the examiner unless, in the opinion of the examiner, the amendment or new evidence overcomes the new ground of rejection. In the event the examiner maintains the rejection, appellant would be able to again appeal to the Board.

Bd.R. 41.50(d)(2) specifies that a second option would be to request rehearing pursuant to Bd.R. 41.52. The request for rehearing would have to be based on the record before the Board and no new evidence or amendments would be permitted.

Bd.R. 41.50(e) continues a long-standing practice that the Board, in its opinion in support of its decision, could include a recommendation, explicitly designated as such, of how a claim on appeal may be amended to overcome a specific rejection. For the recommendation to be binding, it would have to be explicitly designated as a recommendation. For example, a conclusion or comment by the Board that a claim, notwithstanding appellant's argument, is so broad as to read on the prior art should not be taken as a recommendation that if some undefined limitation is added the claim would be patentable. When the Board makes a recommendation, appellant may file an amendment in conformity with the recommendation. An amendment in conformity with the recommendation would be deemed to overcome the specific rejection. An examiner would have authority to enter a rejection of a claim amended in conformity with a recommendation provided that the additional rejection constitutes a new ground of rejection. For example, the examiner may know of additional prior art not known to the Board that would meet the claim as amended. It is because of the possibility that an examiner may know of additional prior art that a recommendation would be expected to be a relatively rare event.

Bd.R. 41.50(f) provides that the Board could enter an order requiring appellant to brief additional issues or supply additional evidence or both if the Board believes doing so would be of assistance in reaching a decision on the appeal. Bd.R. 41.50(f) continues a practice which has been in existence since 1999. *See, e.g.*, (1) 37 CFR 1.196(d) (1999) and (2) Rule 41.50(d). Practice under Rule 41.50(d) has been highly useful and complements the authority of Office

personnel to request additional material under Rule 105. Appellant would be given a non-extendable time period within which to respond to the order. In setting the length of the non-extendable time period, the Board would take into account the extent of the information requested and the time of year a response would be due. For example, it is not likely that the Board would set a date for response between Christmas Day and New Year's Day. Failure of appellant to timely respond to the order could result in dismissal of the appeal in whole or in part. An appeal might be dismissed-in-part if the order sought further briefing or evidence or both related to one rejection but not another rejection, particularly where the two rejections apply to different claims.

Bd.R. 41.50(g) provides for extensions of time to respond to actions of the Board under Bd.R. 41.50(b) and (d). Bd.R. 41.50(g) provides that a request for an extension of time to respond to a request for briefing and information under Bd.R. 41.50(f) is not authorized. A request for an extension of time to respond to Board action under Bd.R. 41.50(b) and (d) would be presented as a petition under Bd.R. 41.3(a) and (c). A decision on the petition shall be governed by Bd.R. 41.4(a).

#### Rehearing

Bd.R. 41.52(a) authorizes an appellant to file a single request for rehearing. In the past, appellants have filed a second request for rehearing, in effect supplementing a first request for rehearing. Filing a second or subsequent request for rehearing is not authorized. Any second or subsequent request for rehearing will not be considered.

Bd.R. 41.52(b) provides that a request for rehearing is due within two months from the date the decision by the Board is mailed.

Bd.R. 41.52(c) provides that a request for an extension of time would have to be presented as a petition under Bd.R. 41.3(a) and (c). A decision on the petition would be governed by Bd.R. 41.4(a).

Bd.R. 41.52(d) provides that the form of a request for rehearing is governed by Bd.R. 41.37(v) except that a request for rehearing could not exceed 10 pages, excluding any table of contents, table of authorities, and signature block. A request for rehearing would have to contain, under appropriate headings and in the order indicated, the following items: (1) Table of contents, (2) table of authorities, and (3) argument.

Bd.R. 41.52(e) is reserved.

Bd.R. 41.52(f) provides that a request for rehearing shall state with particularity the points believed to have

been misapprehended or overlooked by the Board. In filing a request for rehearing, the argument shall adhere to the following format: "On page x, lines y-z of the Board's opinion, the Board states that [set out what was stated]. The point misapprehended or overlooked was made to the Board in [identify paper, page and line where argument was made to the Board]. The response is [state response]." As part of each response, appellant shall refer to the page number and line or drawing element number of the Record. A general restatement of the case will not be considered an argument that the Board misapprehended or overlooked a point. A new argument cannot be made in a request for rehearing, except in two instances.

Bd.R. 41.52(f)(1) would authorize in a first instance an appellant to respond to a new ground of rejection entered pursuant to Bd.R. 41.50(d)(2).

Bd.R. 41.52(f)(2) would authorize an appellant to rely on and call the Board's attention to a recent decision of a court or the Board that is relevant to an issue decided in the appeal. Generally, the recent court decision would be a decision of the Supreme Court or the Court of Appeals for the Federal Circuit.

Bd.R. 41.52(g) provides that an amendment or new evidence could not accompany a request for rehearing.

Bd.R. 41.52(h) provides that a decision will be rendered on a request for rehearing. The decision on rehearing would be deemed to incorporate the decision sought to be reheard except for those portions of the decision sought to be reheard specifically modified on rehearing. A decision on rehearing would be considered final for purposes of judicial review, except when otherwise noted in the decision on rehearing.

#### *Action Following Decision*

Bd.R. 41.54 provides that, after a decision by the Board and subject to appellant's right to seek judicial review, the proceeding will be returned to the examiner for such further action as may be consistent with the decision by the Board.

#### *Sanctions*

Bd.R. 41.56 is new and provides for sanctions. The rule is designed to put the public on notice of actions which the Office believes are detrimental to the efficient handling of *ex parte* appeals.

Bd.R. 41.56(a) provides that the Chief Administrative Patent Judge or an expanded panel of the Board may impose a sanction against an appellant for misconduct. Misconduct would include (1) failure to comply with an

order entered in the appeal or an applicable rule, (2) advancing or maintaining a misleading or frivolous request for relief or argument or (3) engaging in dilatory tactics. A sanction would be entered by the Chief Administrative Patent Judge (for matters not before a panel) or an expanded panel of the Board (for matters before a panel). A sanction would be applied against the appellant, not against a registered practitioner. Conduct of a registered practitioner could result in a sanction against an appellant. Conduct of a registered practitioner believed to be inappropriate would be referred to the Office of Enrollment and Discipline for such action as may be appropriate.

Bd.R. 41.56(b) provides that the nature of possible sanctions includes entry of (a) an order declining to enter a docket notice, (b) an order holding certain facts to have been established in the appeal, (c) an order expunging a paper or precluding an appellant from filing a paper, (d) an order precluding an appellant from presenting or contesting a particular issue, (e) an order excluding evidence, (f) an order holding an application on appeal to be abandoned or a reexamination proceeding terminated, (g) an order dismissing an appeal, (h) an order denying an oral hearing or (i) an order terminating an oral hearing.

Whether and what sanction, if any, should be imposed against an appellant in any specific circumstance would be a discretionary action.

#### **Changes Made to Rules as Proposed**

Several changes have been made to the rules as proposed in the notice of proposed rulemaking. Those changes follow with additions shown in [brackets] and deletions shown in {braces}. Only the paragraph of a rule where a change was made is reproduced.

#### *Petitions (§ 41.3)*

§ 41.3(a), as proposed, would be revised as follows:

*Deciding official.* A petition authorized by this part must be addressed to the Chief Administrative Patent Judge. {In addition to complying with all other requirements of this title, a copy of the petition must also be forwarded to the Office addressed to: Chief Administrative Patent Judge, Board of Patent Appeals and Interferences, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450.} The Chief Administrative Patent Judge may delegate authority to decide petitions.

#### *Timeliness (§ 41.4)*

§ 41.4(b), as proposed, would be revised as follows:

*Late filings.* (1) A request to revive an application which becomes abandoned or a reexamination proceeding which becomes terminated under §§ 1.550(d) or 1.957(b) or (c) of this title as a result of a late filing may be filed pursuant to § 1.137 of this title.

(2) A late filing that does not result in an application becoming abandoned or a reexamination proceeding becoming terminated under §§ 1.550(d) or 1.957(b) or [limited under § 1.957] (c) of this title may be excused upon a showing of excusable neglect or a Board determination that consideration on the merits would be in the interests of justice.

#### *Citation of Authority (§ 41.12)*

§ 41.12 (a), as proposed, would be revised as follows:

**Authority.** Citations to authority must include:

(1) *United States Supreme Court decision.* A citation to a single source in the following order of priority: United States Reports, West's Supreme Court Reports, United States Patents Quarterly, Westlaw, or a slip opinion.

(2) *United States Court of Appeals decision.* A citation to a single source in the following order of priority: West's Federal Reporter (F., F.2d or F.3d), West's Federal Appendix (Fed. Appx.), United States Patents Quarterly, Westlaw, or a slip opinion.

(3) *United States District Court decision.* A citation to a single source in the following order of priority: West's Federal Supplement (F.Supp., F.Supp. 2d), United States Patents Quarterly, Westlaw, or a slip opinion.

(4) *Slip opinions.* If a slip opinion is relied upon, a copy of the slip opinion must accompany the first paper in which an authority is cited.

(5) *Pinpoint citations.* Use pinpoint citations whenever a specific holding or portion of an authority is invoked.

§ 41.12(b), as proposed, would be revised as follows:

*Non-binding authority.* Non-binding authority may be cited. If non-binding authority is not an authority of the Office and is not reproduced in one of the reporters listed in paragraph (a) of this section, a copy of the authority shall be filed with the first paper in which it is cited.]

#### *Definitions (§ 41.30)*

§ 41.30, as proposed, would be revised as follows:

[*Record* means the official content of the file of an application or

reexamination proceeding an appeal.] *Record on appeal.* The record on appeal consists of the specification, drawings, if any, U.S. patents cited by the examiner or appellant, published U.S. applications cited by the examiner or appellant, the appeal brief, including all appendices, the examiner's answer, any reply brief, including any supplemental appendix, any supplemental examiner's answer, any supplemental reply brief, any request for rehearing, any order or decision entered by the Board or the Chief Administrative Patent Judge, and any other document or evidence which was considered by the Board as indicated in any opinion accompanying any order or decision.

#### *Appeal to Board (§ 41.31)*

§ 41.31(e), as proposed, would be revised as follows:

*Non-appealable issues.* A non-appealable issue is an issue not subject to an appeal under 35 U.S.C. 134. An applicant or patent owner dissatisfied with a decision of an examiner on a non-appealable issue shall timely seek review by petition before jurisdiction over an appeal is transferred to the Board (*see* § 41.35). Failure to timely file a petition seeking review of a decision of the examiner related to a non-appealable issue may constitute a waiver to [having] {have} that issue considered [in the application or reexamination on appeal].

#### *Amendments and Evidence After Appeal (§ 41.33)*

§ 41.33(c), as proposed, would be revised as follows:

*Other amendments.* No other amendments filed after the date an appeal brief is filed will be admitted, except as permitted by §§ {41.39(b)(1),} 41.50(b)(1), 41.50(d)(1) or 41.50(e) of this subpart.

§ 41.33(d), as proposed, would be revised as follows:

*Evidence after notice of appeal and prior to appeal brief.* Evidence filed after the date a notice of appeal is filed and prior to the date an appeal brief is filed may be admitted if:

(1) the examiner determines that the evidence overcomes [at least one rejection] {some or all rejections} under appeal [and does not necessitate any new ground of rejection], and

(2) appellant shows good cause why the evidence was not earlier presented.

§ 41.33(e), as proposed, would be revised as follows:

*Other evidence.* All other evidence filed after the date an appeal brief is filed will not be admitted, except as

permitted by §§ {41.39(b)(1),} 41.50(b)(1) or 41.50(d)(1) of this subpart.

#### *Jurisdiction Over Appeal (§ 41.35)*

§ 41.35(a), as proposed, would be revised as follows:

*Beginning of jurisdiction.* The jurisdiction of the Board begins when a docket notice is [mailed] {entered} by the Board.

§ 41.35(b), as proposed, would be revised as follows:

*End of jurisdiction.* The jurisdiction of the Board ends when[:

(1) The Board mails a remand order (*see* § 41.50(b) or § 41.50(d)(1) of this subpart),

(2) The Board mails a final decision (*see* § 41.2 of this part) and judicial review is sought or the time for seeking judicial review has expired,

(3) An express abandonment is filed which complies with § 1.138 of this title, or

(4) A request for continued reexamination is filed which complies with § 1.114 of this title.) {the Board orders a remand (*see* § 41.50(b) or § 41.50(d)(1) of this subpart) or enters a final decision (*see* § 41.2 of this subpart) and judicial review is sought or the time for seeking judicial review has expired.}

#### *Appeal Brief (§ 41.37)*

§ 41.37(e), as proposed, would be revised as follows:

*Content of appeal brief.* The appeal brief must contain, under appropriate headings and in the order indicated, the following items:

(1) Statement of the real party in interest [(*see* paragraph (f) of this section)].

(2) Statement of related cases [(*see* paragraph (g) of this section)].

(3) Jurisdictional statement [(*see* paragraph (h) of this section)].

(4) Table of contents [(*see* paragraph (i) of this section)].

(5) Table of authorities [(*see* paragraph (j) of this section)].

(6) [[Reserved.]] {Status of claims.}

(7) Status of amendments [(*see* paragraph (l) of this section)].

(8) [Grounds of rejection] {Rejections} to be reviewed (*see* paragraph (m) of this section)].

(9) Statement of facts [(*see* paragraph (n) of this section)].

(10) Argument [(*see* paragraph (o) of this section)].

(11) An appendix containing a claims section [(*see* paragraph (p) of this section)], [a claim support and drawing analysis section (*see* paragraph (r) of this section)], {a claim support section, a drawing analysis section,} a means or step plus function analysis section [(*see* paragraph (s) of this section)], an

evidence section [(*see* paragraph (t) of this section)], and a related cases section [(*see* paragraph (u) of this section)].

§ 41.37(f), as proposed, would be revised as follows:

*Statement of real party in interest.*

The "statement of the real party in interest" shall identify the name of the real party in interest. The real party in interest must be identified in such a manner as to readily permit a member of the Board to determine whether recusal would be appropriate. Appellant is under a continuing obligation to update this item during the pendency of the appeal. [If an appeal brief does not contain a statement of real party in interest, the Office will assume that the named inventors are the real party in interest.]

§ 41.37(g), as proposed, would be revised as follows:

*Statement of related cases.* The "statement of related cases" shall identify, by application, patent, appeal, interference, or court docket number, all prior or pending appeals, interferences or judicial proceedings, known to [any inventors, any attorneys or agents who prepared or prosecuted the application on appeal and any other person who was substantively involved in the preparation or prosecution of the application on appeal,] {appellant, appellant's legal representative or any assignee,} and that are related to, directly affect, or would be directly affected by, or have a bearing on the Board's decision in the appeal. [A related case includes any continuing application of the application on appeal.] A copy of any final or significant interlocutory decision rendered by the Board or a court in any proceeding identified under this paragraph shall be included in the related cases section [(*see* paragraph (u) of this section) in] {of} the appendix. Appellant is under a continuing obligation to update this item during the pendency of the appeal. [If an appeal brief does not contain a statement of related cases, the Office will assume that there are no related cases.]

§ 41.37(h), as proposed, would be revised as follows:

*Jurisdictional statement.* The "jurisdictional statement" shall establish the jurisdiction of the Board to consider the appeal. The jurisdictional statement shall include a statement of the statute under which the appeal is taken, [the date of the Office action setting out the rejection on appeal from which the appeal is taken,] {the date of the decision from which the appeal is taken,} the date the notice of appeal was filed, and the date the appeal brief is being filed. If a notice of appeal or an

appeal brief is filed after the time specified in this subpart, appellant must also indicate the date an extension of time was requested and, if known, the date the request was granted.

§ 41.37(i), as proposed, would be revised as follows:

*Table of contents.* A “table of contents” shall list, along with a reference to the page where each item begins, the items required to be listed in the appeal brief (see paragraph (e) of this section) [or]{,} reply brief (see § 41.41(d) of this subpart) {or supplemental reply brief (see § 41.44(d) of this subpart)}, as appropriate.

§ 41.37(j), as proposed, would be revised as follows:

*Table of authorities.* A “table of authorities” shall list cases (alphabetically arranged), statutes and other authorities along with a reference to the pages where each authority is cited in the appeal brief [or]{,} reply brief, {or supplemental reply brief,} as appropriate. § 41.37(k), as proposed, would be revised as follows:

[[Reserved.]] {*Status of pending claims.* The “status of pending claims” shall include a statement of the status of all pending claims (e.g., rejected, allowed, cancelled, withdrawn from consideration, or objected to).}

§ 41.37(m), as proposed, would be revised as follows:

{*Grounds of rejection* {*Rejections* to be reviewed. The “[grounds of rejection] {rejections} to be reviewed” shall set out the [grounds of rejection] {rejections} to be reviewed, including the [statute applied, the claims subject to each rejection and references relied upon by the examiner] {claims subject to each rejection}.

§ 41.37(n), proposed, would be revised as follows:

*Statement of facts.* The “statement of facts” shall set out in an objective and non-argumentative manner the material facts relevant to the rejections on appeal. A fact shall be supported by a reference to a specific page number [of a document in the Record] and, where applicable, a specific line or [paragraph, and] drawing numerals {of the record on appeal}. A general reference to a document as a whole or to large portions of a document does not comply with the requirements of this paragraph.

§ 41.37(o), as proposed, would be revised as follows:

*Argument.* The “argument” shall explain why the examiner {is believed to have} erred as to each [ground of] rejection to be reviewed. Any explanation must address all points made by the examiner with which the appellant disagrees. Any finding made or conclusion reached by the examiner

that is not challenged will be presumed to be correct. For each argument, an explanation {and} must identify where the argument was made in the first instance to the examiner or state that the argument has not previously been made to the examiner. {Any finding made or conclusion reached by the examiner that is not challenged will be presumed to be correct.} Each [ground of] rejection shall be separately argued under a separate heading. {For arguments traversing a rejection made under 35 U.S.C. 102, 103 or 112, see also paragraphs (o)(4) through (o)(7) of this section. For arguments traversing other rejections, see also paragraph (o)(8) of this section.}

(1) *Claims standing or falling together.* [For each ground of rejection applicable to two or more claims, the claims may be argued separately (claims are considered by appellants as separately patentable) or as a group (claims stand or fall together). When two or more claims subject to the same ground of rejection are argued as a group, the Board may select a single claim from the group of claims that are argued together to decide the appeal on the basis of the selected claim alone with respect to the group of claims as to the ground of rejection. Any doubt as to whether claims have been argued separately or as a group as to a ground of rejection will be resolved against appellant and the claims will be deemed to have been argued as a group. Any claim argued separately as to a ground of rejection shall be placed under a subheading identifying the claim by number.]{When a rejection applies to two or more claims, as to that rejection, the appellant may elect to have all claims stand or fall together, or argue the separate patentability of individual claims. If the appeal brief fails to make an explicit election, the Board will treat all claims subject to a rejection as standing or falling together, and select a single claim to decide the appeal as to that rejection. Any doubt as to whether an election has been made or whether an election is clear will be resolved against the appellant. Any claim argued separately shall be placed under a subheading identifying the claim by number.} A statement that merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

(2) *Arguments considered.* Only those arguments which are presented in the argument section of the appeal brief and that address claims set out in the claim support [and drawing analysis] section of the appendix will be considered. Appellant waives all other arguments [in the appeal].

(3) *Format of argument.* Unless a response is purely legal in nature, when responding to a point made in the examiner’s rejection, the appeal brief shall specifically identify the point made by the examiner and indicate where appellant previously responded to the point or state that appellant has not previously responded to the point. In identifying any point made by the examiner, the appellant shall refer to a page and, where appropriate, a line [or paragraph], of [a document in] the [Record]{record on appeal}.

{(4) *Rejection under 35 U.S.C. 112, first paragraph.* For each rejection under 35 U.S.C. 112, first paragraph, the argument shall also specify the errors in the rejection and how the rejected claims comply with the first paragraph of 35 U.S.C. 112 including, as appropriate, how the specification and drawings, if any, describe the subject matter defined by the rejected claims, enable any person skilled in the art to which the invention pertains to make and use the subject matter of the rejected claims, or set forth the best mode contemplated by the inventor of carrying out the claimed invention.}

{(5) *Rejection under 35 U.S.C. 112, second paragraph.* For each rejection under 35 U.S.C. 112, second paragraph, the argument shall also specify how the rejected claims particularly point out and distinctly claim the subject matter which appellant regards as the invention.}

{(6) *Rejection under 35 U.S.C. 102.* For each rejection under 35 U.S.C. 102 (anticipation), the argument shall also specify why the rejected claims are patentable by identifying any specific limitation in the rejected claims which is not described in the prior art relied upon in support of the rejection.}

{(7) *Rejection under 35 U.S.C. 103.* For each rejection under 35 U.S.C. 103, if appropriate, the argument shall specify the errors in the rejection and, if appropriate, specify the specific limitations in the rejected claims that are not described in the prior art relied upon in support of the rejection, and explain how those limitations render the claimed subject matter unobvious over the prior art. A general argument that all limitations are not described in a single prior art reference does not satisfy the requirements of this paragraph.}

{(8) *Other rejections.* For each rejection other than those referred to in paragraphs (o)(4) through (o)(7), the argument shall specify the errors in the rejection, including where appropriate, the specific limitations in the rejected claims upon which the appellant relies to establish error.}

§ 41.37(p), as proposed, would be revised as follows:

*Claims section.* The “claims section” of the appendix shall consist of an accurate clean copy in numerical order of all claims pending in the application or reexamination proceeding on appeal. The status of [every]{each} claim shall be set out after the claim number and in parentheses (*e.g.*, 1 (rejected), 2 (withdrawn), 3 (objected to), [4 (cancelled), and 5 (allowed)]). {and 4 (allowed).} [A cancelled claim need not be reproduced.]

§ 41.37(q), as proposed, would be revised as follows:

[[Reserved.]] {*Claim support section.* For each claim argued separately (see paragraph (o)(1) of this section), the “claim support section” of the appendix shall consist of an annotated copy of the claim indicating in bold face between braces ( { } ) the page and line after each limitation where the limitation is described in the specification as filed.}

§ 41.37(r), as proposed, would be revised as follows:

[*Claim support and*] *drawing analysis section.* [For each independent claim involved in the appeal and each dependent claim argued separately (see paragraph (o)(1) of this section), the claim support and drawing analysis section in the appendix shall consist of an annotated copy of the claim (and, if necessary, any claim from which the claim argued separately depends) indicating in bold face between braces ( { } ) the page and line or paragraph after each limitation where the limitation is described in the specification as filed. If there is a drawing or amino acid or nucleotide material sequence, and at least one limitation is illustrated in a drawing or amino acid or nucleotide material sequence, the “claims support and drawing analysis section” in the appendix shall also contain in bold face between the same braces ( { } ) where each limitation is shown in the drawings or sequence.] {For each claim argued separately (see paragraph (o)(1) of this section) and having at least one limitation illustrated in a drawing or amino acid or nucleotide material sequence, the “drawing analysis section” of the appendix shall consist of an annotated copy of the claim indicating in bold face between braces ( { } ) where each limitation is shown in the drawings or sequence. If there is no drawing or sequence, the drawing analysis section shall state that there is no drawing or sequence.}

§ 41.37(s), as proposed, would be revised as follows:

*Means or step plus function analysis section.* [For each independent claim involved in the appeal and each

dependent claim argued separately (see paragraph (o)(1) of this section) having a limitation that appellant regards as a means or step plus function limitation in the form permitted by the sixth paragraph of 35 U.S.C. 112, for each such limitation, the “means or step plus function analysis section” in the appendix shall consist of an annotated copy of the claim (and, if necessary, any claim from which the claim argued separately depends) indicating in bold face between braces ( { } ) the page and line of the specification and the drawing figure and element numeral that describes the structure, material or acts corresponding to each claimed function.] {For each claim argued separately (see paragraph (o)(1) of this section) and for each limitation that appellant regards as a means or step plus function limitation in the form permitted by the sixth paragraph of 35 U.S.C. 112, the “means or step plus function analysis section” of the appendix shall consist of an annotated copy of the claim indicating in bold face between braces ( { } ) the page and line of the specification and the drawing figure and element numeral that describes the structure, material or acts corresponding to each claimed function. If there is no means or step plus function limitation, the means or step plus function analysis section shall state that there are no means or step plus function limitations in the claims to be considered.}

§ 41.37(t), as proposed, would be revised as follows:

*Evidence section.* The “evidence section” shall contain only papers which have been entered by the examiner. The evidence section shall include:

- (1) A table of contents.
- (2) [[Reserved.]] {The Office action setting out the rejection on appeal. If the Office action incorporates by reference any other Office action, then the Office action incorporated by reference shall also appear in the evidence section.}
- (3) [[Reserved.]] {All evidence relied upon by the examiner in support of the rejection on appeal (including non-patent literature and foreign application and patent documents), except the specification, any drawings, U.S. patents or published U.S. applications.}
- (4) [[Reserved.]] {The relevant portion of a paper filed by the appellant before the examiner which shows that an argument being made on appeal was made in the first instance to the examiner.}
- (5) [*Affidavits and declarations.* Affidavits and declarations, if any, and attachments to declarations, [before the examiner and which are relied upon by

appellant in the appeal. An affidavit or declaration otherwise mentioned in the appeal brief which does not appear in the evidence section will not be considered.] {relied upon by appellant before the examiner.}

(6) [*Other evidence filed prior to the notice of appeal.*] Other evidence, if any, [before the examiner and filed prior to the date of the notice of appeal and relied upon by appellant in the appeal. Other evidence filed before the notice of appeal that is otherwise mentioned in the appeal brief and which does not appear in the evidence section will not be considered.] {relied upon by the appellant before the examiner.}

[(7) *Other evidence filed after the notice of appeal.* Other evidence relied upon by the appellant in the appeal and admitted into the file pursuant to § 41.33(d) of this subpart. Other evidence filed after the notice of appeal that is otherwise mentioned in the appeal brief and which does not appear in the evidence section will not be considered.]

§ 41.37(v), as proposed, would be revised as follows:

*Appeal brief format requirements.* An appeal brief shall comply with § 1.52 of this title and the following additional requirements:

(1) *Page and line numbering.* The pages of the appeal brief, including all sections [in] {of} the appendix, shall be consecutively numbered using Arabic numerals beginning with the first page of the appeal brief, which shall be numbered page 1. [If the appellant chooses to number the lines, line numbering may be within the left margin.] {The lines on each page of the appeal brief and, where practical, the appendix shall be consecutively numbered beginning with line 1 at the top of each page.}

(2) *Double spacing.* Double spacing shall be used except in headings, tables of contents, tables of authorities, [signature blocks and certificates of service.] {and signature blocks.} Block quotations must be {double spaced and} indented [and can be one and one half or double spaced].

(3) [[Reserved.]] {*Margins.* Margins shall be at least one inch (2.5 centimeters) on all sides. Line numbering may be within the left margin.}

(4) *Font.* The font [size] shall be [14 point,] {readable and clean, equivalent to 14 point Times New Roman,} including the font for block quotations and footnotes.

(5) *Length of appeal brief.* An appeal brief may not exceed [30] {25} pages, excluding any statement of the real party in interest, statement of related

cases, [jurisdictional statement,] table of contents, table of authorities, [statement of amendments,] signature block, and appendix. An appeal brief may not incorporate another paper by reference. A request to exceed the page limit shall be made by petition under § 41.3 filed at least ten calendar days prior to the date the appeal brief is due.

#### *Examiner's Answer (§ 41.39)*

§ 41.39(b), as proposed, would be revised as follows:

[*No new ground of rejection.*] {*New rejection in examiner's answer.*} [An examiner's answer shall not include a new ground of rejection.] {An examiner's answer may include a new rejection. If an examiner's answer contains a rejection designated as a new rejection, appellant must, within two months from the date of the examiner's answer, exercise one of the following two options or the application will be deemed to be abandoned or the reexamination proceeding will be deemed to be terminated.}

{(1) *Request to reopen prosecution.* Request that prosecution be reopened before the examiner by filing a reply under § 1.111 of this title with or without amendment or submission of evidence. Any amendment or evidence must be responsive to the new rejection. A request that complies with this paragraph will be entered and the application or patent under reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. A request under this paragraph will be treated as a request to withdraw the appeal.}

{(2) *Request to maintain the appeal.* Request that the appeal be maintained by filing a reply brief as set forth in § 41.41 of this subpart. A reply brief may not be accompanied by any amendment or evidence, except an amendment canceling one or more claims which are subject to the new rejection. A reply which is accompanied by evidence or any other amendment will be treated as a request to reopen prosecution pursuant to paragraph (b)(1) of this section.}

§ 41.39(c), as proposed, would be revised as follows:

*Extension of time to file request.* The time for filing a request under § 41.39(b)(1) is extendable under the provisions of § 1.136(a) of this title as to applications and under the provisions of § 1.550(c) of this title as to reexamination proceedings. A request for an extension of time for filing a request under paragraph (b)(2) of this section shall be presented as a petition under § 41.3 of this part.}

#### *Reply Brief (§ 41.41)*

§ 41.41(c), as proposed, would be revised as follows:

*Extension of time to file reply brief.* A request for an extension of time to file a reply brief shall be presented as a petition under § 41.3 of this {sub}part.

§ 41.41(d), as proposed, would be revised as follows:

*Content of reply brief.* {A reply brief shall be limited to responding to points made in the examiner's answer.} Except as otherwise set out in this section, the form and content of a reply brief are governed by the requirements for an appeal brief as set out in § 41.37 of this subpart. A reply brief may not exceed [20] {fifteen} pages, excluding any table of contents, table of authorities, {statement of timeliness,} [and] signature block, {and supplemental appendix} required by this section. {If the examiner enters and designates a rejection as a new rejection, the reply brief may not exceed twenty-five pages, excluding any table of contents, table of authorities, statement of timeliness, signature block, and supplemental appendix required by this section.} A request to exceed the page limit shall be made by petition under § 41.3 of this part and filed at least ten calendar days before the reply brief is due. A reply brief must contain, under appropriate headings and in the order indicated, the following items:

(1) Table of contents—*see* § 41.37(i) of this subpart.

(2) Table of authorities—*see* § 41.37(j) of this subpart.

(3) [[Reserved.]] {Statement of timeliness—*see* paragraph (e) of this section.}

(4) Statement of [additional] facts—*see* paragraph (f) of this section.

(5) Argument[—*see* paragraph (g) of this section.]

{(6) Supplemental appendix.}

§ 41.41(e), as proposed, would be revised as follows:

[[Reserved.]] {*Statement of timeliness.* The "statement of timeliness" shall include the date that the examiner's answer was entered and the date that the reply is being filed. If the reply brief is filed after the time specified in this subpart, appellant must indicate the date an extension of time was requested and the date the request was granted.}

§ 41.41(g), as proposed, would be revised as follows:

*Argument.* [Any arguments raised in the reply brief which are not responsive to points made in the examiner's answer will not be considered and will be treated as waived. {A reply brief is limited to responding to points made in the examiner's answer. Arguments

generally restating the case will not be permitted in a reply brief.}

§ 41.41(h), as proposed, would be revised as follows:

[[Reserved.]] {*Supplemental appendix.* If the examiner entered a new rejection in the examiner's answer and appellant elects to respond to the new rejection in a reply brief, this item shall include:

(1) A table of contents—*see* § 41.37(i) of this subpart.

(2) The examiner's answer.

(3) All evidence upon which the examiner relied in support of the new rejection that does not already appear in the evidence section accompanying the appeal brief, except the specification, any drawings, U.S. patents and U.S. published applications.}

#### *Examiner's response to reply brief (§ 41.43)*

§ 41.43, as proposed, would be removed:

{Upon consideration of a reply brief, the examiner may withdraw a rejection and reopen prosecution or may enter a supplemental examiner's answer responding to the reply brief.}

#### *Supplemental reply brief (§ 41.44). [new rule number]}*

§ 41.44(a), as proposed, would be removed:

{*Supplemental reply brief authorized.* If an examiner enters a supplemental examiner's answer, an appellant may file a single supplemental reply brief responding to the supplemental examiner's answer.}

§ 41.44(b), as proposed, would be removed:

{*Time for filing supplemental reply brief.* Appellant must file a supplemental reply brief within two months from the date of the mailing of the examiner's supplemental answer.}

§ 41.44(c), as proposed, would be removed:

{*Extension of time to file supplemental reply brief.* A request for an extension of time shall be presented as a petition under § 41.3.}

§ 41.44(d), as proposed, would be removed:

{*Content of supplemental reply brief.* Except as otherwise set out in this subparagraph, the form and content of a supplemental reply brief are governed by the requirements for appeal briefs as set out in § 41.37 of this subpart. A supplemental reply brief may not exceed ten pages, excluding the table of contents, table of authorities, and statement of timeliness and signature block. A request to exceed the page limit shall be made by petition under § 41.3 of this part and filed at least ten



calendar days before the supplemental reply brief is due. A supplemental reply brief must contain, under appropriate headings and in the order indicated, the following items:

(1) Table of contents—*see* § 41.37(i) of this subpart.

(2) Table of authorities—*see* § 41.37(j) of this subpart.

(3) Statement of timeliness—*see* paragraph (e) of this section.

(4) Argument—*see* paragraph (f) of this section.

§ 41.44(e), as proposed, would be removed:

*Statement of timeliness.* The “statement of timeliness” shall establish that the supplemental reply brief was timely filed by including a statement of the date the supplemental examiner’s answer was entered and the date the supplemental reply brief is being filed. If the supplemental reply brief is filed after the time specified in this subpart, appellant must indicate the date an extension of time was requested and the date the request was granted.}

§ 41.44(f), as proposed, would be removed:

*Argument.* The “argument” shall be limited to responding to points made in the supplemental examiner’s answer. Arguments generally restating the case will not be permitted in a supplemental reply brief.}

§ 41.44(g), as proposed, would be removed:

*No amendment or new evidence.* No amendment or new evidence may accompany a supplemental reply brief.}

#### Oral Hearing (§ 41.47)

§ 41.47(c), as proposed, would be revised as follows:

*Time for filing request for oral hearing.* Appellant must file a request for oral hearing within two months from the date of the examiner’s answer {or supplemental examiner’s answer}.

§ 41.47(i), as proposed, would be revised as follows:

*Oral hearing limited to [Record] {record}.* At oral hearing only the [Record] {record on appeal} will be considered. No additional evidence may be offered to the Board in support of the appeal. Any argument not presented in a brief cannot be raised at an oral hearing.

§ 41.47(j), as proposed, would be revised as follows:

*Recent legal development.* Notwithstanding {sub}paragraph (i) of this section, an appellant or the examiner may rely on and call the Board’s attention to a recent court or Board opinion which could have an effect on the manner in which the appeal is decided.

§ 41.47(k), as proposed, would be revised as follows:

*Visual aids.* Visual aids may be used at an oral hearing, but must be limited to {copies of} documents [or artifacts] in the [Record] {record on appeal} [or a model or an exhibit presented for demonstration purposes during an interview with the examiner]. At the oral hearing, appellant should provide one copy of each visual aid [(photograph in the case of an artifact, a model or an exhibit)] for each judge and one copy [to be added to the Record] {for the record}.

#### Decisions and Other Actions by the Board (§ 41.50)

§ 41.50(b), as proposed, would be revised as follows:

*Remand.* The Board may remand an application to the examiner. If in response to [a] {the} remand [for further consideration of a rejection], the examiner enters [an] {supplemental} examiner’s answer, within two months the appellant shall exercise one of the following two options to avoid abandonment of the application or termination of a reexamination proceeding:

(1) *Request to reopen prosecution.* Request that prosecution be reopened before the examiner by filing a reply under § 1.111 of this title with or without amendment or submission of evidence. Any amendment or evidence must be responsive to the remand or issues discussed in the {supplemental} examiner’s answer. A request that complies with this paragraph will be entered and the application or patent under reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. A request under this paragraph will be treated as a request to dismiss the appeal.

(2) *Request to [re-docket] {maintain} the appeal.* The appellant may request that the Board re-docket the appeal (*see* § 41.35(a) of this subpart) and file a reply brief as set forth in § 41.41 of this subpart. A reply brief may not be accompanied by any amendment or evidence. A reply brief which is accompanied by an amendment or evidence will be treated as a request to reopen prosecution pursuant to paragraph (b)(1) of this section.

§ 41.50(d), as proposed, would be revised as follows:

*New [ground of] rejection.* Should the Board have a basis not involved in the appeal for rejecting any pending claim, it may enter a new [ground of] rejection. A new [ground of] rejection shall be considered an interlocutory order and shall not be considered a final decision.

If the Board enters a new [ground of] rejection, within two months appellant must exercise one of the following two options with respect to the new [ground of] rejection to avoid dismissal of the appeal as to any claim subject to the new [ground of] rejection:

(1) *Reopen prosecution.* Submit an amendment of the claims subject to a new [ground of] rejection or new evidence relating to the new [ground of] rejection or both, and request that the matter be reconsidered by the examiner. The application or reexamination proceeding on appeal will be remanded to the examiner. A new [ground of] rejection by the Board is binding on the examiner unless, in the opinion of the examiner, the amendment or new evidence overcomes the new [ground of] rejection. In the event the examiner maintains the new [ground of] rejection, appellant may again appeal to the Board.

(2) *Request for rehearing.* Submit a request for rehearing pursuant to § 41.52 of this subpart relying on the [Record]{record on appeal}.

§ 41.50(e), as proposed, would be revised as follows:

*Recommendation.* In its opinion in support of its decision, the Board may include a recommendation, explicitly designated as such, of how a claim on appeal may be amended to overcome a specific rejection. When the Board makes a recommendation, appellant may file an amendment or take other action consistent with the recommendation. An amendment or other action, otherwise complying with statutory patentability requirements, will overcome the specific rejection. An examiner, however, [upon return of the application or reexamination proceeding to the jurisdiction of the examiner,] may enter a new [ground of] rejection of a claim amended in conformity with a recommendation, when appropriate.

§ 41.50(g), as proposed, would be revised as follows:

*Extension of time to take action.* A request for an extension of time to respond to a request for briefing and information under paragraph (f) of this section is not authorized. A request for an extension of time to respond to Board action under paragraphs (b) and (d) of this section shall be presented as a petition under § 41.3 of this {sub}part.

#### Rehearing (§ 41.52)

§ 41.52(b), as proposed, would be revised as follows:

*Time for filing request for rehearing.* Any request for rehearing must be filed within two months from the date of the

decision [mailed]{entered} by the Board.

§ 41.52(c), as proposed, would be revised as follows:

*Extension of time to file request for rehearing.* A request for an extension of time shall be presented as a petition under § 41.3 of this {sub}part.

§ 41.52(d), as proposed, would be revised as follows:

*Content of request for rehearing.* {A request for rehearing shall state with particularity the points believed to have been misapprehended or overlooked by the Board.} The form of a request for rehearing is governed by the requirements of § 41.37(v) of this subpart, except that a request for rehearing may not exceed [10] {ten} pages, excluding any table of contents, table of authorities, {statement of timeliness,} and signature block. A request to exceed the page limit shall be made by petition under § 41.3 at least ten calendar days before the request for rehearing is due. A request for rehearing must contain, under appropriate headings and in the order indicated, the following items:

(1) Table of contents—*see* § 41.37(i) of this subpart.

(2) Table of authorities—*see* 41.37(j) of this subpart.

(3) [[Reserved.]] {Statement of timeliness—*see* paragraph (e) of this section.}

(4) Argument—*see* paragraph (f) of this section.

§ 41.52(e), as proposed, would be revised as follows:

[[Reserved.]] {*Statement of timeliness.* The “statement of timeliness” shall establish that the request for rehearing was timely filed by including a statement of the date the decision sought to be reheard was entered and the date the request for rehearing is being filed. If the request for rehearing is filed after the time specified in this subpart, appellant must indicate the date an extension of time was requested and the date the request was granted.}

§ 41.52(f), as proposed, would be revised as follows:

*Argument.* [A request for rehearing shall state with particularity the points believed to have been misapprehended or overlooked by the Board.] In filing a request for rehearing, the argument shall adhere to the following format: “On page x, lines y–z of the Board’s opinion, the Board states that [set out what was stated]. The point misapprehended or overlooked was made to the Board in [identify paper, page and line where argument was made to the Board] [or the point was first made in the opinion of the Board]. The response is [state response].” As part of each response,

appellant shall refer to the page number and line or drawing number of [a document in] the [Record] {record on appeal}. [A] {No} general restatement of the case [will not be considered an argument that the Board has misapprehended or overlooked a point.] {is permitted in a request for rehearing.} A new argument cannot be made in a request for rehearing, except:

(1) *New [ground of] rejection.*

Appellant may respond to a new [ground of] rejection entered pursuant to § 41.50(d)(2) of this subpart.

(2) *Recent legal development.*

Appellant may rely on and call the Board’s attention to a recent court or Board opinion which is relevant to an issue decided in the appeal.

#### *Sanctions (§ 41.56)*

§ 41.56(a), as proposed, would be revised as follows:

*Imposition of sanctions.* [The Chief Administrative Patent Judge or an expanded panel of the Board may impose a sanction] {A sanction may be imposed} against an appellant for misconduct, including:

(1) Failure to comply with an order entered in the appeal or an applicable rule.

(2) Advancing or maintaining a misleading or frivolous request for relief or argument.

(3) Engaging in dilatory tactics.

§ 41.56(b), as proposed, would be revised as follows:

*Nature of sanction.* Sanctions may include entry of:

(1) An order declining to enter a docket{ing} notice.

(2) An order holding certain facts to have been established in the appeal.

(3) An order expunging a paper or precluding an appellant from filing a paper.

(4) An order precluding an appellant from presenting or contesting a particular issue.

(5) An order excluding evidence.

(6) [[Reserved.]] {An order requiring terminal disclaimer of patent term.}

(7) An order holding an application on appeal to be abandoned or a reexamination proceeding terminated.

(8) An order dismissing an appeal.

(9) An order denying an oral hearing.

(10) An order terminating an oral hearing.

#### **Discussion of Comments**

##### *Generally*

*Comment 1.* Several comments expressed a concern that many of the appeals rules, as proposed, are not necessary and will not help the Board resolve appeals.

*Answer.* A review of the comments as a whole suggests that many have overlooked the fact that (1) the overall appeal process begins with the notice of appeal and ends with a decision of the Board and (2) that the process from notice of appeal to decision of the Board is bifurcated within the Office. The Office bifurcates the overall appeal process because some of the steps are carried out in the Technology Centers while other steps are carried out before the Board. The notice of appeal and appeal brief are filed while the appeal process is before the Technology Center. Many of the requirements of the rules will help the Board and Technology Center personnel. For example, a table of contents and table of authorities helps Technology Center personnel (*e.g.*, the examiner and conferees in appeals) promptly locate information in a brief. A jurisdictional statement will provide a road map on whether an application on appeal is abandoned and will enable Technology Center personnel to promptly advise an applicant in the event an application is abandoned. Identification of whether an argument in an appeal brief is “new” will enable Technology Center personnel to evaluate the new argument and determine whether a rejection should be withdrawn. Additionally, if a “new” argument is made, Technology Center personnel will know that if the appeal is to go forward that the argument will need to be answered. The rules should be viewed as making the overall appeal process, albeit bifurcated, efficient so as to eliminate at an early stage appeals which should not go forward and make appeals which go forward capable of prompt resolution.

*Comment 2.* A comment maintained that the proposed rule changes are “substantive and NOT interpretive.”

*Answer.* The rules are promulgated pursuant to the Director’s authority to establish regulations which govern the conduct of proceedings in the Office, including regulations governing *ex parte* appeals. 35 U.S.C. 2(b)(2)(A). The rules are merely procedural rules, not substantive rules.

*Comment 3.* A comment suggested that the proposed appeals rules would increase application pendency, *inter alia*, because examiners would delay examination until the filing of an appeal brief. According to the comment, delays occur under the former rules.

*Answer.* The premise of the comment is that under the former rules the examiners are not doing their job and are waiting for an appeal to examine a patent application. The Director has confidence that examiners are doing their job correctly. Furthermore, most

applications are examined without the need for filing a notice of appeal. Therefore the comment is addressing a very small percentage of all applications filed in the Office. If there are some examiners who in the opinion of an applicant are not doing their job, the applicant has a responsibility to call the matter to the attention of a Director in the involved Technology Center. The Office cannot address and respond to general comments about perceived improper behavior of examiners. Like the examination of a patent application, perceived inappropriate examination can be dealt with only on a case-by-case and examiner-by-examiner basis. A Technology Center Director without knowledge of difficulties experienced by an applicant is not likely to be able take to steps to improve the examination process, whether before or after a notice of appeal is filed. See *Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 1388 (Fed. Cir. 1989) (noting that prescience is not a required characteristic of Office personnel). Unless a matter is called to the attention of an Office manager in a position to look into the facts, it is unlikely the behavior which the comment alleges occurs can be corrected.

*Comment 4.* A comment indicated that from 40 to 60 percent of appealed cases are reopened or allowed under existing rules. Another comment indicated that only 50% of the appeals are transmitted to the Board after the newly instituted appeal conferences in the Technology Centers. The comments go on to state that applicants should not have to file appeal briefs (either under the former rules or the new rules) when many appeals never reach the Board. Other comments made similar observations.

*Answer.* For appellants taking advantage of the Office's newly instituted pre-appeal brief conferences, an appeal brief is not due until the results of the pre-appeal conference are mailed to appellant. Nevertheless, an increasing number of appeals proceed to the Board for resolution. These rules establish procedures which will permit those appeals reaching the Board to be resolved in an efficient manner.

*Comment 5.* A comment suggested that many of the appeals rules place a burden on an applicant to establish patentability as opposed to requiring the Office to establish unpatentability.

*Answer.* The comment misapprehends the nature of the rules. It is the examiner's function to establish that claims are unpatentable. An applicant dissatisfied with the examiner's unpatentability holding may appeal to the Board. The appeals rules

are not designed to make the applicant prove patentability. However, they are designed to require the applicant on appeal to show that the examiner erred. The rules also require the applicant to provide enough information so that the Board can determine what fact or legal matter is in dispute and resolve any dispute. In many appeals, the Board has had to spend considerable time trying to determine what matters are in issue.

*Comment 6.* The tenor of many comments is that applicants are concerned with post-issuance matters, such as infringement cases. The premise of the comments is that an applicant (soon to be a patentee) should not have to state its position on various matters, including, e.g., (1) the meaning of claims, (2) the level of skill in the art, and (3) what element in a specification supports a means or step plus function claim. The comments imply that if an applicant has to tell the Board what its claim means, post-issuance doctrine of equivalents positions may be compromised. Some comments suggest that the more which needs to be said, the more likely an applicant will face allegations of inequitable conduct when a patent is sought to be enforced.

*Answer.* The Office is not unsympathetic to some of the concerns expressed. However, it is also true that a patent file serves a public notice function. To the extent that an applicant has to explain the meaning of its claims, etc., to the Board to secure a reversal, no applicant should be concerned. The examination process should be a transparent process where prosecution reveals much about the scope and meaning of a patent. Patent prosecution is not a procedure whereby an applicant should be allowed to maneuver during prosecution only to surprise the public when the patent issues. For these reasons, it is difficult to see why an applicant would want to resist providing the information the Board needs to determine whether an examiner erred. In this respect, the Federal Circuit recently made the following observation:

Where the applicant expressly and unambiguously states \* \* \* [an] intention to claim broadly, the claim construction issue is easier and the question becomes one of validity—whether the specification supports the full breadth of the new claims. On the other hand, where—as in this case—the patentee has not been explicit about the scope of the new claims, the case can pose interdependent problems of both claim construction and validity.

*Saunders Group, Inc. v. Comfortrac, Inc.*, 492 F.3d 1326, 1336 (Fed. Cir. 2007). The appeal rules address the Federal Circuit's observation, at least for

those cases which require an appeal to be decided by the Board.

*Comment 7.* Several comments called attention to events which are said to have transpired in particular patent applications prosecuted by those submitting the comments. According to the comments, examiners are said to have mishandled each of the applications.

*Answer.* The rule making process is not a vehicle for correcting errors which are said to have occurred during the prosecution of particular patent applications. The comments were considered only to the extent that they provided general observations and suggestions relevant to a rule under consideration.

*Comment 7A.* Several comments called attention to mathematical analysis of data compiled by the comment provider. According to the comments, the analysis argued against implementation of the rules.

*Answer.* The data and analysis have been considered only to the extent that each is relevant to a rule under consideration. The data and analysis do not provide any justification for not implementing the rules.

*Comment 8.* A comment suggested that a Regulatory Flexibility Act analysis is required. 5 U.S.C. 603.

*Answer.* A Regulatory Flexibility Act certification or analysis is required only for proposed rules that are required to be published for notice and comment. Because these rules are procedural, they are not required to be published for notice and comment. Nevertheless, the Office chose to publish these rules for comment prior to adoption of the final rules in order to solicit valuable input from the public. See the Regulatory Flexibility Act section under Rule Making Considerations of this final rule for further information regarding certification of the rules under 5 U.S.C. 605(b).

*Comment 8A.* Several comments stated that the notice of proposed rule making should have been published earlier than July 30, 2007.

*Answer.* Although prior notice and an opportunity for public comment are not required for the procedural changes in the rules as proposed, the USPTO published a notice of proposed rule making in the **Federal Register** as soon as the proposed rules were in an appropriate form for publication.

*Comment 9.* Two comments suggested that the Office has not complied with the Paperwork Reduction Act; specifically with regard to Bd.R. 41.37(t) and (u) and 41.41(h)(2) and (3).

*Answer.* Paragraphs (t) and (u) of section 41.37 have been revised and do

not require the collection of information beyond what is already required by the current rules. Paragraph (h), including subparagraphs (2) and (3), of section 41.41 have been reserved.

*Comment 9A.* A comment suggested that the Office has not complied with Executive Order 12866.

*Answer.* For reasons given at the end of this notice, the Office has complied with Executive Order 12866.

#### *Bd.R. 41.3(a)*

*Comment 10.* Several comments suggested that delegating authority to the Chief Administrative Patent Judge to decide certain petitions for extensions of time might result in delays. Other comments noted that there have been occasions when petitions have not been promptly forwarded to deciding officials within the Office.

*Answer.* Bd.R. 41.3 requires that a petition for an extension be filed with the Office and addressed to the Chief Judge. Consideration of requests for extensions decided by a single Office employee will maximize uniform treatment of petitions for an extension of time.

*Comment 11.* A comment suggested that the Chief Administrative Patent Judge would not be in a position to know examiner's hours and schedules and therefore would not be in a good position to decide petitions for an extension of time.

*Answer.* An examiner's hours or schedule are not relevant to whether an applicant should receive an extension of time.

#### *Bd.R. 41.4(a)*

*Comment 12.* A comment observed that the **Federal Register** Notice (72 FR at 41,472), under "Timeliness of Petitions," states that the Chief Administrative Patent Judge will determine (for the most part) whether extensions of time are to be granted. Other Board rules state that a request for an extension of time must be presented as a petition under Bd.R. 41.3. The comment felt that the Notice gives an impression that all requests for extensions of time under Bd.R. 41.4(a) would have to be by way of a petition under Bd.R. 41.3. If so, then the comment suggests that Bd.R. 41.4(a) should be amended to provide that a petition under Bd.R. 41.3 is required.

*Answer.* The suggestion to change Bd.R. 41.4(a) is not being adopted. Bd.R. 41.4(a) provides that extensions of time will be granted only on a showing of good cause except as otherwise provided by rule. Bd.R. 41.3 (1) applies to all cases pending before the Board, including interference cases and

requests for an extension of time by petition under Bd.R. 41.4, and (2) sets the standard under which extensions of time are granted. A petition for an extension of time under Bd.R. 41.3 is required only where another rule requires the petition to be filed, e.g. (1) Bd.R. 41.41(c) (reply brief), (2) Bd.R. 41.47(d) (request for oral hearing), and (3) Bd.R. 41.52(c) (request for rehearing).

*Comment 13.* A comment noted that possible requests for extensions of time under the current appeal process might lead to unwarranted patent term adjustment. The comment suggests that an amendment could be made to Rule 704(c)(9) to deal with abuses of the extension of time practice and the need for a petition for an extension of time is not necessary.

*Answer.* A possible amendment to Rule 704(c)(9) is beyond the scope of the notice of proposed rule making. Nevertheless, one factor in determining whether a petition for an extension of time should be granted is any possible patent term adjustment resulting from any extension. In the case where granting a petition for an extension of time would appear to result in unwarranted patent term adjustment, a decision on petition could make an extension conditioned on an appellant waiving its right to patent term adjustment equivalent to the length of the extension.

#### *Bd.R. 41.20*

*Comment 14.* A comment suggested that if an examiner makes a new ground of rejection in an examiner's answer and the applicant elects further prosecution before the examiner, then the appeal fees (notice of appeal and appeal brief) should be refunded or applied to any future appeal.

*Answer.* The rules are being amended to provide that a new ground of rejection cannot be made in the examiner's answer.

#### *Bd.R. 41.30*

*Comment 15.* One comment suggested that the transcript of oral argument be considered part of the "record on appeal."

*Answer.* Since any "transcript of oral argument" is entered in the file of the application or reexamination on appeal, it is part of the Record. However, one concern in making the transcript part of the Record will be attempts by appellants at oral hearing to raise "new" issues not previously raised. A new argument raised for the first time at an oral hearing will not be considered. See Bd.R. 41.47(i), which is based on principles announced in *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d

1352, 1360 (Fed. Cir. 2000); *Henry v. Department of Justice*, 157 F.3d 863, 865 (Fed. Cir. 1998); and *LeVeen v. Edwards*, 57 USPQ2d 1406, 1414 (Bd. Pat. App. & Int. 2000).

*Comment 16.* A comment suggested that the definition of "record on appeal" is too broad because it could include, for example, U.S. patents cited in an IDS which are not mentioned by either the examiner or the appellant. The comment suggested that the definition be limited to documents relied upon in the appeal.

*Answer.* The Record consists of the material in the official file of the application or reexamination on appeal. However, unless a particular document in the Record has been mentioned or relied upon, a document cannot form part of the "evidence" considered by the examiner or the Board. Patents cited in an IDS, but not relied upon by either the examiner or the appellant in the appeal will not be considered by the Board. Likewise, Office actions, responses to Office actions, prior art and evidence cited earlier in the prosecution, but not relied upon in the appeal, would not be considered.

*Comment 17.* A comment suggested that the record on appeal (Bd.R. 41.30 and Bd.R. 41.37(t)) should be "the entire administrative record."

*Answer.* The suggestion is adopted. A definition of "Record" has been added to the definitions in Bd.R. 41.30. However, as the answer to the previous comments makes clear, a document in the Record not called to the attention of the examiner and the Board will not be considered. A document called to the Board's attention the first time in a petition for rehearing will almost always be denied consideration. Experience shows that after an adverse decision by the Board, on appeal to the Federal Circuit an appellant will refer to documents in the court brief which were not called to the attention of the Board. The Federal Circuit is entitled to know that the document relied upon in an appeal before it was addressed in the arguments made to the Board. The appeal brief, reply brief and request for rehearing will establish what part of the Record was relied upon in the appeal by the appellant, the examiner and the Board.

*Comment 18.* A comment suggested that the definition of the record on appeal gives preferential status to U.S. patents and published U.S. applications. The comment goes on to say that published foreign applications and technical journal articles are also important.

*Answer.* Given the added definition of Record in Bd.R. 41.30, it is believed that

any concern in the comment has been answered.

*Bd.R. 41.31(c)*

*Comment 19.* A suggestion was made that Bd.R. 41.31(c) be amended to permit an appellant to file a notice of appeal without the payment of any "late" fee (see Rule 136(a) and Rule 550(c)) when there is a delay in deciding a petition (see Bd.R. 41.31(e)).

*Answer.* The suggestion is beyond the scope of the notice of proposed rule making and will not be adopted.

*Comment 20.* A comment suggested that an applicant should be able to appeal to the Board an examiner's refusal to enter an amendment.

*Answer.* The suggestion is not adopted. However, consistent with long-standing practice, review of an examiner's decision not entering an amendment will remain available by petition.

*Bd.R. 41.31(e)*

*Comment 21.* A comment suggested that the "waiver" language of Bd.R. 41.31(e) would apply to a continuing application and a request for continued examination (RCE). The comment suggested that waiver would not be appropriate in a continuation or an RCE.

*Answer.* The language "in the application or reexamination on appeal" has been added to the end of Bd.R. 41.31(e). From a practical point of view, however, a waiver in a reexamination may mean the issue has been ultimately waived for all time.

*Bd.R. 41.33(b)*

*Comment 22.* A comment suggested that Bd.R. 41.33(b) would preclude entry of an amendment requested by the examiner. The same comment noted that Bd.R. 41.37(d) would preclude entry of evidence requested by the examiner.

*Answer.* The comment misperceives the authority of the examiner and the purpose of the appeal rules in general. Bd.R. 41.33(b) and Bd.R. 41.33(d) advise applicants when they can expect that an amendment or evidence will be entered. The rules advise an applicant when it would be futile to file an amendment or evidence. However, nothing in the rule should be construed as precluding an examiner from suggesting an amendment or evidence and entering the amendment or evidence if timely filed. An appellant should realize that the examiner may reopen the prosecution. With limited exceptions, the appeal rules do not purport to require or not require action by the examiner or other Office personnel. The rules advise applicants what the Office

requires and expects from them. Practices applicable to what an examiner should do are best left to administrative orders and the Manual of Patent Examining Procedure. Stated in other terms, the Director does not need a rule to tell Office personnel what they can or cannot do; the Director has inherent authority to issue administrative instructions on how agency business is to be handled by Office personnel.

*Bd.R. 41.33(d)*

*Comment 23.* Several comments noted that Bd.R. 41.33(d) would permit evidence filed after a notice of appeal if the evidence overcomes some or all rejections. On the other hand, the supplementary information states (72 FR at 41,473, col. 3, near the end of the first full paragraph) that even where good cause is shown, if the evidence does not "overcome all rejections," the evidence would not be admitted.

*Answer.* The supplementary information should have said "overcome some or all rejections." There is a possibility that the language "some or all rejections" could be read to mean that all rejections must be overcome. The language of Bd.R. 41.33(d) has been changed to read "at least one rejection".

*Comment 24.* A comment suggested that after the notice of appeal, if the examiner has considered evidence to the extent that the evidence does not overcome some or all rejections, the evidence should be entered in the record.

*Answer.* The suggestion is not being adopted. There are two conditions which must be met for an applicant to have evidence "admitted" into the record after the filing of a notice of appeal. First, an applicant must show good cause for having not earlier presented the evidence. Second, the evidence must be of such weight and character as to overcome some or all rejections. Nothing in the rule should be construed as precluding an examiner from suggesting the presentation of particular evidence and entering the evidence if timely filed. An applicant should realize that the examiner may enter the evidence and reopen the prosecution.

*Comment 25.* A comment suggested that an applicant should have a right to file additional evidence after a notice of appeal has been filed.

*Answer.* The suggestion is not adopted. The time for evidence to be filed, except as otherwise provided in a rule, e.g., Bd.R. 41.33(d) and (e), is prior to the notice of appeal.

*Bd.R. 41.33(e)*

*Comment 26.* A suggestion was made that an appellant be authorized to submit "new" evidence to respond to a "new" fact or conclusion made by the examiner for the first time in a final rejection or an Examiner's Answer responding to an appeal brief.

*Answer.* The suggestion will not be adopted. The notice of proposed rulemaking does not address presentation of evidence in response to a final rejection. See Rule 116 for practice after final rejection. If the examiner's answer states a new fact or conclusion, an appellant may take the position that the rejection is a new ground of rejection and request that the examiner reopen prosecution to consider new evidence. If the examiner agrees, prosecution would be reopened and the evidence would be considered. If the examiner disagrees, then the evidence would not be admitted. An appellant dissatisfied with an examiner's decision should seek administrative relief by petition.

*Bd.R. 41.35(a)*

*Comment 27.* Several comments suggested that delays occur in the Office between the filing of the notice of appeal and transmittal of the appeal to the Board. Related comments suggested that the Office should impose a time limit on how long an application may remain with a Technology Center after a reply brief is filed. It was suggested that a maximum period of three months should be "imposed."

*Answer.* Under the rules, the Office expects that an application will be forwarded immediately to the Board after a reply brief is filed. Any delay in forwarding appeals to the Board following filing of a reply brief (or after the time expires for filing a reply brief) are an internal operating matter which is not appropriately addressed in a rule. Nevertheless, the Director agrees with the comment to the extent that a delay in transmitting an appeal to the Board is not appropriate. There are two steps an appellant can take which would help the Office minimize delays. First, if appellant does not intend to file a reply brief, a one-page notice to the Office to that effect would trigger the appeal being forwarded to the Board. Second, if after filing a reply brief, an appellant does not receive within a reasonable time a docket notice from the Board, a one-page notice to the Office to that effect would help the Office promptly transmit the appeal to the Board.

*Bd.R. 41.35(a)*

*Comment 28.* A comment suggested that Bd.R. 41.35(a) should be amended

to provide that jurisdiction over an appeal begins when a notice of appeal is filed. According to the suggestion, transferring jurisdiction when a docket notice is mailed could mean that a successful appellant may not receive all patent term adjustments to which it may be entitled.

*Answer.* The suggestion is not being adopted. Patent term adjustment associated with an *ex parte* appeal is governed by Rule 703(b)(4) and other provisions of Subpart F of Part 1 of 37 CFR.

*Bd.R. 41.37*

*Comment 29.* A comment suggested that the appeal brief rules will result in unnecessary exposure to allegations of inequitable conduct. It appears the comment is particularly concerned with evidence in the application file not called to the attention of the Board in the evidence section (Bd.R. 41.37(t)).

*Answer.* These rules limit the content of the evidence section compared to the content required by the rules as proposed. In any event, inequitable conduct requires intent to deceive. If in an appeal brief an appellant refers to and explains the significance of a document already in the official file of the application or reexamination on appeal, it is difficult to see how there can be intent to deceive.

*Bd.R. 41.37(a)*

*Comment 30.* A comment suggested that the language "proceedings on the appeal are terminated without further action on the part of the Office" needs clarification.

*Answer.* The language is intended to put applicants on notice that if an appeal brief is not timely filed, the appeal is "over" and that no notice to that effect should be expected from the Office.

An applicant knows when an appeal brief is due and whether the appeal brief is to be filed. Bd.R. 41.37(a) advises the applicant that it should not expect a notice that proceedings on the appeal are terminated (although the Office may nevertheless issue a notice in the form of a notice of abandonment). If there are no allowed claims, then any continuing applications (35 U.S.C. 120) would have to be filed before the date the appeal brief was due. If there are allowed claims, the application on appeal continues to be a pending application. The examiner would take such steps as may be needed to advance prosecution to issue, including making a requirement for the applicant to take certain action within a period of time. Rejected claims on appeal would be cancelled since a failure to file an

appeal brief constitutes a waiver of any right to those claims in the application on appeal. The rule does not affect the pending status of any application in which there is an allowed claim.

*Bd.R. 41.37(c)*

*Comment 31.* Several comments suggested that a review should be taken in the Technology Center after a notice of appeal is filed and that an appeal brief should not be due until the review is complete. For example, it was suggested that an SPE (supervisory patent examiner) review the claims based on the last amendment filed. Alternatively, an applicant would be permitted to specify one claim for consideration and if that claim turned out to be allowable, the applicant would forego the appeal.

*Answer.* The suggestions are not adopted principally on the ground that the reviews involved add to pendency. There are two problems associated with additional pendency. The first is overall pendency of an application. The second is patent term adjustment for time spent in appeals.

*Bd.R. 41.37(e)*

*Comment 32.* Several comments suggested that the appeal brief requirements seem disproportionately burdensome for applicants.

*Answer.* The Director recognizes that some additional burden may be imposed by these appeal rules. As a result of comments received from the public, the requirement for content of appeal briefs has been reduced, particularly in the need for an evidence section. Nevertheless, it also must be recognized that the number of appeals is expected to rise significantly in the near future. A rise in the number of appeals should not mean that an applicant taking an appeal should have to wait an unreasonable period to receive a decision on appeal. One possible way to ensure continued prompt decisions is to add judges to the Board so that an increased volume can be handled within current time frames. However, continued hiring of new employees will not by itself reduce backlogs. There is a practical limit to the number of judges and employees the Office can hire. Alternative procedures and techniques must be found to permit the Board to efficiently handle the expected rise in appeals.

Many of the comments are based on an underlying premise that the commentator's appeal will be considered and that the requirements of the rules impose an unwarranted burden in that appeal. Absent some adjustment which permits the agency to

efficiently consider and decide appeals, the premise that the commentator's appeal will be considered promptly may turn out to be incorrect; while the appeal eventually will be reached and considered, the appeal may end up in a large backlog only to be reached when time permits. The rules seek to implement procedures which will assist the Office in avoiding delays in deciding appeals. However, to avoid delays, the Office needs help from applicants taking an appeal. The rules set out the help the Office needs.

*Comment 33.* A comment made a suggestion that, under certain conditions, the Director consider a "mini-appeal brief" as an alternative to an appeal brief. Those conditions were identified as including (1) a single rejection as to all claims on appeal, (2) all claims stand or fall together, and (3) no evidence is relied upon by the applicant (*e.g.*, declarations or publications). The comment suggested that a "mini-appeal brief" could be limited to 10 pages and would not need to include all the sections required by Bd.R. 41.37(e). *See also* Comment 91.

*Answer.* The suggestion is not being adopted, principally because the content of a possible mini-brief was not the subject of the notice of proposed rulemaking. Accordingly and apart from the suggestion, the Office does not have the necessary input or experience under these rules to determine the parameters for a mini-brief. The Office will continue to study the idea of a mini-brief and after some experience under the rules as amended may again consider the viability of a mini-brief.

*Comment 34.* A comment suggested that rule changes are not needed because the Board was able to reduce a backlog of 9,000 appeals ten years ago to a manageable number of appeals.

*Answer.* The comment is correct that the number of pending appeals was reduced. However, the reduction took place by adding judges. As earlier noted, however, the Office cannot solve all of its obligations by adding personnel. In FY 1998, the Board received 4,466 appeals and had 46 judges (some of whom were assigned to handle interference cases) to handle the appeals. In FY 2000, the Board received only 2,981 appeals, but had increased the number of judges to 65 (some of whom were assigned to handle interference cases). The Board faced a significant challenge in FY 2007. The two-year growth in FY 2006 and FY 2007, of approximately 50%, is by far the largest two-year growth in patent appeal receipts in the years tracked at the Board. In FY 2007, the Board received 4,639 appeals. The FY 2007

receipts represent over a 38% increase from the prior year. In contrast, FY 1994, FY 1995, and FY 1996 receipts were: 3,667; 4,318; and 4,466 appeals, respectively (not including returns). For this three-year growth, the percent rise in patent appeal receipts was only a 21.8% increase, but resulted in a 900 appeal backlog. Adding to the challenge, the Board has lost many experienced judges due to retirement. Since the high point of 66 judges in FY 2002, Board membership fell to 55 judges at the beginning of FY 2007. Of the 66 judges on board in FY 2002, only 40 are here today. Moreover, at the end of FY 2007, approximately 38% of the judges were newly hired within the last two years. This represents the highest proportion of newly hired judges in recent Board history.

*Bd.R. 41.37(f)*

*Comment 35.* A comment suggested that the language in Bd.R. 41.37(f) “in such a manner as to readily permit a member of the Board to determine whether recusal would be appropriate” is not clear. Rather than leaving it to the applicant, the comment suggests that the rule itself spell out what information is required.

*Answer.* The requirement for an identification of a real party in interest is to avoid participation in an appeal by an administrative patent judge who has an ethical obligation of recusal. As the comment noted, when the real party in interest is an assignee, *e.g.*, a company, compliance with the rule is straightforward. However, often the real party in interest is a licensee prosecuting an application with the approval of the assignee. Sometimes, the real party in interest is a group of organizations each with varying interests. No rule can specify all possible circumstances under which an entity or individual needs to be identified. Accordingly, the rule identifies the purpose of why information is being requested so that registered practitioners, familiar with the entities and individuals involved, can exercise professional judgment to notify the Board of circumstances which might warrant recusal.

*Bd.R. 41.37(g)*

*Comment 36.* A comment suggested that the related proceedings be made clear. In addition, the comment suggested that the “known to appellant, the appellant’s legal representative, or assignee” can be a very large number of people in a large corporate environment.

*Answer.* The nature of the related cases to be identified is present in Rule 41.37(c)(1)(ii) and has not presented any

known problem to date. Rather than attempt to change the language defining a related case, the Office will leave the language the same in Bd.R. 41.37(g) and observe whether problems arise in the future.

The suggestion concerning large corporate entities has merit. If a corporation has a patent department with units in New York and Colorado or a law firm has offices in Chicago and Los Angeles, the patent department and law firm could find it difficult to comply with the rule. Accordingly, the language in Proposed Bd.R. 41.37(g) “known to appellant, appellant’s legal representative or assignee” has been changed to “known to any inventors, any attorneys or agents who prepared or prosecuted the application on appeal and any other person who was substantively involved in the preparation or prosecution of the application on appeal.” The changed language conforms closely to the individuals mentioned in Rule 56(c) and narrows the individuals who need to be consulted.

*Bd.R. 41.37(h)*

*Comment 37.* Several comments suggested that a jurisdictional statement is not necessary.

*Answer.* Reference is made to Comment 1 for an explanation of why a jurisdictional statement helps the overall appeal process.

A prudent practitioner will always check prior to filing a notice of appeal that the notice is being timely filed. Likewise, a prudent practitioner will check prior to filing an appeal brief that the appeal brief is timely filed. The jurisdictional statement will simply memorialize the practitioner’s check and will help Board personnel confirm that the application or reexamination proceeding on appeal is pending and not “abandoned” or “terminated.” In the event a check reveals that an abandonment or termination has occurred, the applicant or patent owner can take advantage of available revival remedies at an early date and avoid an unnecessary dismissal of an appeal.

*Comment 38.* A comment asked the question: When is a petition for an extension of time under Rule 136(a) granted?

*Answer.* Assuming that a petition for an extension of time complies procedurally with the rule and that the required fee is paid, a petition for an extension of time under Rule 136(a) is granted “automatically” upon its filing. In a jurisdictional statement it would be appropriate to state that: “A petition for an extension of time under Rule 136(a)

was filed and granted on [state date petition filed].”

*Bd.R. 41.37(i)*

*Comment 39.* A comment suggested that subsection (i) should precede subsections (f), (g) and (h) and that the Table of Contents should be item (1) in Bd.R. 41.37(e).

*Answer.* The suggestion is not being adopted because the comment does not indicate why a change is necessary.

*Comment 40.* A comment suggested that a table of contents is not helpful and serves no useful purpose.

*Answer.* Reference is made to Comment 1 for explanation of how the table of contents is useful in the overall appeals process. In addition, although not required by rule, the Board has received appeal briefs with tables of contents. The tables of contents have proved useful in the Board’s consideration of those appeal briefs.

*Bd.R. 41.37(j)*

*Comment 41.* A comment asked the question: How will a list of authorities assist the Board in any meaningful way?

*Answer:* Reference is made to Comment 1 for an explanation of how a table of authorities is useful during the overall appeals process. Modern word processors make creation of a table of authorities fairly easy. A table of authorities is often useful when an examiner or a member of the Board knows that a particular argument is associated with a citation of a particular statute or case. Consultation of the table of authorities will reveal where the citation, and therefore the argument, appears without a need to go through a brief page-by-page. Arguments based on a particular precedent therefore are less likely to be overlooked.

*Comment 42.* A related comment suggested that a table of authorities is not needed because appeals to the Board often do not turn on legal issues.

*Answer.* If the premise of the comment is accepted, then it would follow that few, if any, cases would be cited in a table of authorities and would involve minimal effort.

*Bd.R. 41.37(k)*

*Comment 43.* A comment suggested that the requirement of Bd.R. 41.37(k) was redundant with the requirements of Bd.R. 41.37(q).

*Answer.* While the requirements of Bd.R. 41.37(k) are not redundant with the requirements of Bd.R. 41.37(q), they are redundant with the requirements of Bd.R. 41.37(p). Both Bd.R. 41.37(k) and Bd.R. 41.37(p) deal with pending claims. Bd.R. 41.37(k) will be reserved.

*Bd.R. 41.37(n)*

*Comment 44.* Several comments noted that the rules in various places require citation to a page and line number. The comments suggest that, where appropriate, a citation to a paragraph number be authorized in place of a line number. An example where paragraph numbers are appropriate is a reference made to a published U.S. patent application.

*Answer.* The suggestion is adopted. An amendment to *Bd.R. 41.37(n)* authorizes citation to paragraphs where a paragraph citation is appropriate.

*Comment 45.* Several comments noted that it is difficult to present facts in a non-argumentative manner and therefore *Bd.R. 41.37(n)* is “unworkable” and unnecessary. By way of an example, the comment notes that the examiner may find that a reference describes certain subject matter, and applicant disagrees. The comment goes on to question why a specific reference to the record is necessary. Other comments suggested that the manner of presenting facts should be at the discretion of the applicant. On the other hand, still other comments expressed the view that a statement of facts “could be a useful innovation.”

*Answer.* A specific reference to the record is necessary so that Office personnel, including the examiner and the Board, can verify the correctness of a fact. Applicants should not expect either the examiner or the Board to necessarily believe assertions of fact unsupported by a reference to the record. A statement of fact which is immediately verifiable to a specific point in the record is highly convincing.

The observation that a statement of facts “could be a useful innovation” has merit. A well-written statement of facts can tell a “story” in an objective manner, particularly when each statement of fact is supported by a citation to a specific portion of the evidence. Often telling the story objectively convinces the trier of fact of the merit of a position. After reading an objective concise statement of facts, it is not unusual for a trier of fact to look with anticipation for an answer. There is no reason to expect that there should be any difficulty objectively setting out facts. An example follows involving *Facts 1–5: Fact 1.* The examiner found that Jones (the reference) describes a battery (col. 2, lines 4–9). *Fact 2.* Applicant disagrees. (Note that applicant disagrees is a “fact”. *Fact 2* does not include an “argument” why applicant disagrees because the argument is reserved for the argument section). *Fact 3.* Jones describes [state

what applicant believes Jones describes] (col. 1, lines 31–46). *Fact 4.* A battery must have electrodes (col. 8, lines 1–12). *Fact 5.* The device described by Jones does not have electrodes (Fig. 2). Note that no argument has been presented; only objective facts. From these objective facts the argument section can make out the case that the Jones device is not a battery. Objectively stated *Facts 3–5*, sans argument, speak for themselves and go a long way to convincing a trier of fact that applicant is correct thereby suggesting that the examiner’s finding may be erroneous.

*Comment 46.* Several comments suggested that the statement of facts addresses only the facts in dispute.

*Answer.* The suggestion is not adopted. While the examiner and the appellant may have an idea of what is involved and disputed in an application, appeal conferees and the Board do not participate in the prosecution leading up to an appeal. An understanding of the issues on appeal requires an understanding of the facts, including (1) those in dispute and (2) those not in dispute which are relevant to understanding the nature of the invention on appeal and the issues.

*Comment 47.* A comment suggested that in an *ex parte* context facts related to the level of skill in the art are not necessary.

*Answer.* The level of skill can be manifested in several ways. *In re GPAC*, 57 F.3d 1573, 1579 (Fed. Cir. 1995). In the context of an *ex parte* appeal, the level of skill is often revealed in the prior art. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) [for evidence of the level of skill, one may consider an applicant’s disclosure and the prior art (references are generally entitled to great weight because they are almost always prepared without regard to their use as evidence in the particular examination in which they are used, *Velandier v. Garner*, 348 F.3d 1359, 1371 (Fed. Cir. 2003))]. For example, in many pharmaceutical cases, a reference will say that determining a dose within disclosed ranges can be determined on the basis of weight of the patient. One skilled in the art, therefore, would know that dosage is a function of weight. Another example might be where a reference says that you cannot apply a voltage higher than 220, yet an appellant is claiming a voltage of 550. The reference would establish that one skilled in the art would not be inclined to exceed a voltage of 220.

*Bd.R. 41.37(o)*

*Comment 48.* Several comments suggested that the provision of *Bd.R. 41.37(o)* requiring an appellant to

explain why the examiner is believed to have erred “unfairly shifts the burden of proving a *prima facie* case on appeal from the PTO to the patent applicant.”

*Answer.* The necessary premise of the comment is that on appeal to the Board the examiner should be presumed to have erred and it is up to the examiner in an examiner’s answer to show otherwise. The comment misperceives the difference between (1) initial examination leading to a final rejection and (2) an appeal from that final rejection. In responding to a rejection during examination, Rule 111(b) requires an applicant to specifically point out the supposed errors in the examiner’s action. In most appellate administrative and court tribunals, a decision under review is presumed to be correct until an appellant can convince the appellate tribunal that the decision is incorrect, whether the decision involves a question of fact or an issue of law or both. As one comment correctly stated: “[t]he appellant has to make the case for error on the record.” On appeal to the Board, an appellant can overcome a rejection by showing insufficient evidence to support a *prima facie* case or rebutting any *prima facie* case with appropriate evidence. See *In re Kahn*, 441 F.3d 977, 985–86 (Fed. Cir. 2006). The rules impose no new burden on an appellant seeking review of an examiner’s rejection before the Board.

It is true that opinions of the former Court of Customs and Patent Appeals and Federal Circuit state that the initial burden is on the PTO to establish a *prima facie* case. However, the Director is not aware of any CCPA or Federal Circuit opinion which states that the decision of the Office on appeal is presumed to be erroneous. In fact, the opposite is the case because a decision of an administrative agency is presumed to be correct absent a statutory provision to the contrary. *Cf.* (1) *Morgan v. Daniels*, 153 U.S. 120, 125 (1894) (a decision of the Office must be accepted as controlling unless the contrary is established), and (2) *American Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 1359 (Fed. Cir. 1984) (deference is due to PTO examiners who are assumed to have some expertise in interpreting the references and to be familiar from their work with the level of skill in the art and whose duty it is to issue only valid patents).

If an examiner is presumed to be correct when the examiner allows a claim (and a patent issues as a result), what possible rationale would justify a presumption that the examiner is wrong when the examiner rejects a claim? It is true that an examiner has an initial burden to make out a *prima facie* case.



For example, 35 U.S.C. 102 states that an applicant “shall be entitled to a patent unless \* \* \*” Once an examiner determines that the applicant is not entitled to a patent, the “unless” provision of § 102 is facially satisfied until an interested party can show otherwise. *Cf. Hyatt v. Dudas*, 492 F.3d 1365, 1369–71 (Fed. Cir. 2007) (noting that the examiner made out a *prima facie* case and therefore Hyatt was under a duty to comply with PTO requirements).

If an appellant believes the examiner has not satisfied the examiner’s initial burden, then an appellant needs to convince the Board that there is no *prima facie* case. There is no “rule” which supports a notion that the examiner must be presumed on appeal to have erred; such a rule would be inconsistent with an efficient administration of the *ex parte* appeal process.

A suggestion was made that placing the burden on the appellant to establish that the examiner erred is not consistent with the duties of the Board as provided by 35 U.S.C. 6. The suggestion is believed to be incorrect and overlooks similarities between an appeal to the Board and a subsequent appeal to the Federal Circuit. An *ex parte* appeal may be taken to the Board from an adverse decision of an examiner. 35 U.S.C. 134(a) and (b). On written appeal, the Board is to review the adverse decision by the examiner. 35 U.S.C. 6(b). An appellant dissatisfied with a decision of the Board may appeal to the Federal Circuit. 35 U.S.C. 141. On appeal, the Federal Circuit is to review the decision from which an appeal is taken. 35 U.S.C. 144. There is no known precedent of the Federal Circuit which holds that the Director has the burden on appeal. Why should the examiner have the burden on appeal to the Board? As noted earlier, no cogent rationale could justify such a burden on the Office. Just as the Board is presumed to have been correct in the Federal Circuit, until the contrary is shown to the satisfaction of the Federal Circuit, the examiner should be presumed to have been correct on appeal to the Board until the contrary is shown to the satisfaction of the Board.

It has also been suggested that the Board is under an obligation to review a decision of the examiner *de novo*. The precise meaning of *de novo* is not apparent. No provision of law imposes an obligation for a *de novo* review and such a review is inconsistent with efficient administration of appeals. While the Board may have more latitude in an *ex parte* appeal than an Article III court, there is no cogent reason to

review facts on a “no deference” basis. An examiner performs a quasi-judicial function. *Western Electric Co. v. Piezo Technology, Inc. v. Quigg*, 860 F.2d 428, 431 (Fed. Cir. 1988) (patent examiners are quasi-judicial officials); *Compagnie de St. Gobain v. Brenner*, 386 F.2d 985, 987 (D.C. Cir. 1967) (examiner performs quasi-judicial function based on the record before PTO). The question on appeal is whether an examiner’s finding is supported by the evidence. If it is, the finding should not be second-guessed and set aside by the Board on the basis that the Board in the first instance would have made a different finding. The Board (like courts) is not in the business of substituting its judgment for that of an examiner when an examiner justifies a fact or conclusion with appropriate evidence. A contrary view undermines the authority of the examiner to carrying out the examination duties delegated by the Director to the examiner pursuant to 35 U.S.C. 131–132. On the other hand, if an examiner’s finding is not supported by appropriate evidence, the Board has authority to set aside the finding and if the finding is essential to a rejection to also set aside the rejection. The question before the Board, then, is not an examination (that already took place under 35 U.S.C. 131–132); rather, the Board’s chore is to review the examiner’s decision and correct errors which an appellant can establish were made by the examiner.

The review process is straightforward. An example and a question in a comment confirm how the process works. Suppose the examiner finally rejects claim 1 finding that reference A describes limitation Y of claim 1. Assume that the appeal brief (through a combination of a statement of facts and argument) convincingly establishes that reference A does not describe limitation Y. The comment asked what will happen. First, if the argument is convincing, the examiner may withdraw the rejection. Second, if the examiner does not withdraw the rejection and the Board agrees with the appellant, then the rejection would be set aside.

*Comment 49.* A comment suggested clarification is needed for the meaning of “[e]ach rejection shall be separately argued under a separate heading” and “[a]ny claim argued separately shall be placed under a subheading identifying the claim by number.” According to the comment, similar language in Rule 41.37(c)(1)(vii) has “proven to be elusive to the USPTO.” Presumably, the comment suggests that the Office has not uniformly applied the quoted language.

*Answer.* The comment is best answered in the form of an example. Suppose an application has claims 1–7. Claim 1 is an independent claim. Claims 2–7 depend from claim 1. Claims 1–7 are rejected under 35 U.S.C. 103(a) over Jones. Claims 1–4 are also rejected under 35 U.S.C. 102 as anticipated by Smith. With respect to the “Jones” rejection, applicant elects to argue claims 1 and 4 separately. Claims 2–3 and 5–7 would stand or fall with claim 1 as to the “Jones” rejection. With respect to the “Smith” rejection, applicant elects to argue claims 1 and 3 separately. Claims 2 and 4 would stand or fall with claim 1. The headings and subheadings of the argument section of the appeal brief would be the following:

#### ARGUMENT

##### Errors in Rejection Based on Jones

###### Claim 1

Discussion of why the examiner erred in rejecting claim 1 under § 103 over Jones.

###### Claim 4

Discussion of why the examiner erred in rejecting claim 4 under § 103 over Jones even if the examiner did not err in rejecting claim 1 over Jones. Note that when a dependent claim is separately argued, any argument should assume *arguendo* that the independent claim is unpatentable over Jones.

##### Errors in Rejection Based on Smith

###### Claim 1

Discussion of why the examiner erred in rejecting claim 1 under § 102 over Smith.

###### Claim 3

Discussion of why the examiner erred in rejecting claim 3 under § 102 over Smith even if the examiner did not err in rejecting claim 1 over Smith.

*Comment 50.* A comment suggested that requiring an appellant to challenge every finding and every conclusion reached by an examiner is not appropriate.

*Answer.* There is no requirement that every finding and conclusion be challenged. The appeal brief should challenge only those findings made and conclusions reached by the examiner with which the appellant disagrees.

*Comment 51.* A comment asked the following question: If a rejection of all claims is based on A or B in view of C or D, do there need to be four headings, one for A in view of C, B in view of C, A in view of D and B in view of D.

*Answer.* There would need to be only a single heading: Rejection based on A or B in view of C or D.

*Comment 52.* Several comments suggested that there is no need to identify a new argument made in an appeal brief.

*Answer.* Reference is made to Comment 1 for an explanation of why identification of a new argument in an appeal brief is useful during the appeal process. Identification of an argument as a new argument should prevent timely made meritorious new arguments from being overlooked.

*Comment 53.* A comment suggested that it is not always easy to determine whether an argument is “new” or not.

*Answer.* Registered practitioners are sufficiently qualified to generally recognize a “new” argument. It can also be observed that, based on agency experience, a “new” argument often surfaces when the practitioner handling the appeal is different from the practitioner handling pre-appeal prosecution. In case of doubt, an appeal brief could use the following model: “On page 5, lines 4–12, the examiner found [state what was found]. In the response to the first action (page 3, lines 3–6), appellant disagreed arguing [state what was argued]. There was no response in the final rejection to the appellant’s argument. Appellant continues to believe that the examiner erred in making the finding because [state the reason].” Alternatively, the last sentence could read “Appellant continues to believe that the examiner erred in making the finding because [state the reason]. In addition by way of possible new argument, the examiner is further believed to have erred [state the new argument].”

*Comment 54.* A comment requested clarification on whether an unchallenged finding made by an examiner (which will be presumed to be correct) is binding in a subsequent continuing application or RCE (request for continued examination).

*Answer.* While binding for the purpose of the appeal and any remand in the application which was on appeal, in a subsequent continuing application or RCE, the applicant would be free to challenge the finding.

*Comment 55.* A comment suggested that it is often useful to provide technical background to assist the Board in understanding the invention and requested clarification on how that might be done in the context of Bd.R. 41.37.

*Answer.* The comment is correct that a technical background is often useful to the examiner and the Board. The technical background can be presented as part of the statement of facts. Bd.R. 41.37(n). In presenting the technical background, reference should be made

to the record. Relevant parts of the record might include (1) the specification, (2) technical literature in the record and (3) any declaration in the record.

*Bd.R. 41.37(o)(1)*

*Comment 56.* A comment sought clarification of Bd.R. 41.37(o)(1) asking whether the appellant or the Board would “select a single claim to decide the appeal as to that rejection.”

*Answer.* The language of Bd.R. 41.37(o)(1) has been changed from that in the notice of proposed rulemaking. If claims are argued as a group, then the Board may select a single claim and review any ground of rejection on the basis of the single claim.

*Bd.R. 41.37(o)(2)*

*Comment 57.* A comment suggested that Bd.R. 41.37(o)(2) may preclude an argument being presented in an appeal, because rationale in an examiner’s answer may be more extensive than rationale in a final rejection and the appeal brief is limited to showing that the rationale in the final rejection is erroneous. According to the comment, since an argument in a reply brief (Bd.R. 41.41) was not made in the appeal brief, the argument may be waived.

*Answer.* A reply brief may respond to a finding or conclusion made in an examiner’s answer which was not made in a final rejection. If the finding was made in the final rejection and not addressed in the appeal brief, an appellant cannot address the finding for the first time in a reply brief or at oral hearing. However, where the finding is made for the first time in an examiner’s answer, an appellant may respond in a reply brief indicating why the record supports a holding that the finding is erroneous.

*Comment 58.* A comment suggested that it did not understand what is meant by only arguments presented in the argument section of the appeal brief would be considered and that all other arguments are waived. According to the comment, Rule 41.37(c)(1)(vii), providing that only arguments presented in the appeal brief and reply brief will be considered, is sufficient.

*Answer.* There have been two practical problems with former Rule 41.37(c)(1)(vii). First, notwithstanding the language of the former rule, appellants erroneously continue to believe that an argument made anywhere in the record will be considered by the examiner and the Board during an appeal. Bd.R. 41.37(o)(2) advises appellants that the argument must appear in the argument section of the appeal brief. Arguments

made in other places in the record will not be considered. Bd.R. 41.37(v)(5) precludes incorporating an argument from another paper by reference. Second, the former rule may give the impression that an argument may be made for the first time in a reply brief and will be considered. However, a new argument shall not appear for the first time in a reply brief. The “no new argument” in reply briefs policy is implemented in Bd.R. 41.41(g) providing that a reply brief may respond only to points raised in the examiner’s answer.

*Comment 59.* A comment expressed a concern that a “waiver” of an argument could mean that the argument could never again be raised in the Office.

*Answer.* Any waiver is for the purpose of the appeal. Bd.R. 41.37(o)(2) has been changed to read: “Appellant waives all other arguments in the appeal.” If an argument is waived in the appeal and the appellant wants to have the argument considered, the appellant may file a continuing application or an RCE (request for continued examination).

*Bd.R. 41.37(o)(3)*

*Comment 60.* A comment asked the question: Is an argument characterized under this section as “not previously been made to the examiner” intended to be limited to an entirely new argument, or would it include any argument which is not repeated to the Board in the appeal brief exactly as it was presented to the examiner?

*Answer.* There are at least two kinds of arguments presented in an appeal brief. The first is an argument which was made to, but rejected by, the examiner. Generally the argument will appear in a response to a first Office action or in a response to a final rejection. The second is an argument where there was no opportunity to present the argument to the examiner. For example, in an advisory action, the examiner may make a point for the first time. In responding in the appeal brief to the examiner’s advisory action point, appellant would be presenting a response for the first time and therefore the argument was not previously made to the examiner. A response to a new point in an examiner’s answer would be another instance where the argument could not have been presented to the examiner.

An appeal brief would not have to use the same wording used in a response to an Office action. Pointing out where an argument was previously made will permit the Board to efficiently determine the nature of any dispute between the examiner and the appellant. Appellant needs some leeway

to state the same argument in different words, particularly where subsequent events in the record (presentation of Rule 132 evidence or additional prior art) make the argument in the appeal brief more forceful.

*Comment 61.* A comment suggested that there is no need for an appellant to indicate whether an argument previously has been made and, if made, where it was made.

*Answer.* Indicating whether an argument previously has been made will help both the examiner and the Board recognize when a new argument has been made. When the examiner knows that a new argument is made in the appeal brief, the examiner can address the argument in the Examiner's Answer and it is less likely that a new argument will be overlooked.

*Comment 62.* A comment suggested that a requirement that the appellant explain why an examiner has erred (Bd.R. 41.37(o)) and a need to identify a point made in the rejection (Bd.R. 41.37(o)(3)) unduly handicaps appellant in presenting a case on appeal.

*Answer.* It is not apparent why the format handicaps an appellant in presenting its appeal case. After all, the appellant was under an obligation under Rule 111(b) to point out the "supposed errors" in an examiner's rejection. If an examiner made a point in a rejection which an appellant believes is erroneous, the appellant identifies the point and follows with a discussion of why an error has occurred. For example: "On page 5, line 8 of the final rejection, the examiner found that reference A teaches [state what the examiner says was taught] and therefore one skilled in the art would combine the teaching of reference A with the teachings of reference B. The examiner is believed to have erred because reference A does not teach what the examiner says it teaches. Note that col. 3, lines 3–36 of reference A explains that [say what reference A says]. The explanation at col. 3, lines 3–36 cannot be reconciled with the examiner's finding because a first element cannot be both parallel and perpendicular to a second element."

*Bd.R. 41.37(o)(4) Through (o)(8)*

*Comment 63.* Several comments questioned the need for Bd.R. 41.37(o)(4) through (o)(8) and suggested that these rules not be enacted.

*Answer.* The suggestion is adopted. An appellant is required to point out how an examiner is supposed to have erred. Bd.R. 41.37(o). Since the emphasis should focus on how the examiner erred, there is no benefit from having an appellant also comply with

the requirements of Bd.R. 41.37(o)(4) through (o)(8).

*Bd.R. 41.37(p)*

*Comment 64.* A comment suggested clarification of the meaning of a "clean" copy of the claims. The comment assumed that a "clean" copy means a copy of the pending claims that is "free from underlining and bracketing and other extraneous information." The comment also asked whether the status indicators of Rule 121(c) need to be present.

*Answer.* The comment's assumption of the meaning of "clean" is correct. An example of a proper way to comply with Bd.R. 41.37(p) in an application with cancelled claim 1 and pending claims 2–5 is:

Claim 1 (cancelled).

Claim 2 (rejected). An apparatus comprising A, B, and C.

Claim 3 (objected to). The apparatus of claim 2 further comprising D.

Claim 4 (withdrawn from consideration). A method of using an apparatus comprising A, B, and C comprising the steps of x, y, and z.

Claim 5 (allowed). An apparatus comprising A, B, C, D, and E.

Cancelled claims need not be reproduced.

The only status indicators of interest to the Board are (1) "rejected," (2) "allowed," (3) "withdrawn from consideration" (4) "objected to" and (5) "cancelled". However, if an appellant desires to say "Claim 1 (original—rejected)" or "Claim 2 (amended—objected to)" or otherwise use the Rule 121(c) status indicators, there is no objection as long as one of the five status indicators listed above is set out.

*Comment 65.* A comment suggested that only the claims on appeal should be reproduced in the claims section.

*Answer.* In considering an appeal, it is often useful to know what has been allowed, objected to, and withdrawn. If a claim has been allowed or is objected to and the claim has a significant limitation not present in the claims on appeal, this fact is highly useful and should be accessible with minimal effort to the examiner and the Board. Withdrawn claims also provide highly useful information. Often arguments relate to the subject matter of the withdrawn claims and not the claims on appeal. Additionally, the fact that an examiner has restricted out subject matter can be helpful in understanding the breadth of rejected claims.

*Bd.R. 41.37(q)*

*Comment 66:* Several comments suggested that duplication of effort

could be eliminated if Bd.R. 41.37(q) and Bd.R. 41.37(r) are combined.

*Answer.* The suggestions are being adopted. Bd.R. 41.37(q) and Bd.R. 41.37(r) are being combined in Bd.R. 41.37(r). Bd.R. 41.37(q) will be reserved.

*Comment 67.* A comment questioned the need for Bd.R. 41.37(q) and asked for guidance on the meaning of "limitation."

*Answer.* As noted in the previous comment, Bd.R. 41.37(q) is being combined with Bd.R. 41.37(r). Nevertheless, the comment will be addressed at this point since the comment mentions Bd.R. 41.37(q) and could not have known that it would be combined with Bd.R. 41.37(r). Discussion appears in the notice of proposed rulemaking explaining why Bd.R. 41.37(q) was proposed. See 72 FR at 41477, col. 3 through 41478, col. 2. It is also worth noting that in the appeal process, Office personnel considering an appeal include several individuals beyond the examiner who handled pre-appeal prosecution. Additional Office personnel include conferees in the Technology Centers and members of the Board. Additional Office personnel will not be as familiar with the claims and specification as the examiner handling the application or reexamination. All Office personnel involved in the appeal process need to understand the invention on appeal. See also Comment 1. Reading just a claim may not be enough to get a cogent grasp of the claimed invention. A claim support section is designed to make the understanding of claimed inventions efficient. An applicant knows, at least subjectively, what is intended to be covered by a claim. A reference to the relevant portion of the specification and drawings (when there is a drawing) often helps. Examiners often go through the process of reproducing claims and inserting in the claims references to the specification and drawing. Applicants often disagree with the examiner's analysis. Since it is applicant who presents the claim and applicant knows what is intended, the efficient practice is to have applicant make the reference to the specification and drawing. What cannot be included in the claim support section is an argument why a particular portion of the specification supports the claim limitation. The comment suggests that there is some confusion about the meaning of the word "limitation." Since Office actions, responses to Office actions, and Board and court decisions use the word routinely, it is somewhat difficult to understand why the word "limitation" is not generally understood in the context of a patent claim. The Office has not experienced any

difficulty with a corresponding drawing analysis requirement in contested cases. See Bd.R. 41.110(c).

*Bd.R. 41.37(r)*

*Comment 68.* Several comments suggested that the claim support section (Bd.R. 41.37(q)) and the drawing analysis could be combined thereby eliminating a need to reproduce claims twice in applications with a drawing.

*Answer.* The suggestion is being adopted. Bd.R. 41.37(q) is reserved and Bd.R. 41.37(r) is changed to incorporate the provisions of both Bd.R. 41.37(q) and Bd.R. 41.37(r). An example of how an applicant can comply with both rules in the case where there is a published U.S. application follows.

An apparatus comprising (1) a first valve {Fig. 2, element 25; ¶ 0005}, (2) a second valve {Fig. 2, element 31; ¶ 0006}, (3) a tank {Fig. 3, element 8; ¶ 0008}, (4) a pipe with the first valve disposed on one end and the tank disposed on the other end {Fig. 3, element 19; ¶ 0010}, and (5) \* \* \*.

If a paragraph of a published U.S. application is long, reference to the line or lines of the paragraph may be added, e.g. {Fig. 3, element 19; ¶ 0010, lines 18–20}.

*Comment 69.* Several comments inquired into whether the claim support and drawing analysis applies to all independent claims or just an independent claim being separately argued.

*Answer.* The answer is all independent claims on appeal and any dependent claim separately argued. A change is made in the final rule to continue the practice of Rule 41.37(c)(1)(v) instead of the practice set out in proposed Bd.R. 41.37(q), (r) and (s). Both Bd.R. 41.37(r) (claims support and drawing analysis section) and Bd.R. 41.37(s) (means or step plus function analysis section) have been changed to reflect the continuation of the practice of Rule 41.37(c)(1)(v).

*Comment 70.* A comment suggested that a drawing analysis is not necessary, noting that in a large number of applications “drawings are fluff inserted because of Office rules, not because they are actually needed to understanding the invention.”

*Answer.* A drawing analysis, along with the claim support analysis, is helpful because it assists Office personnel in understanding an invention. The statute requires a drawing in those cases which admit of a drawing. 35 U.S.C. 113. If an applicant submits a drawing responsive to § 113 and takes an appeal, it should not be difficult to prepare a drawing analysis.

*Comment 71.* A comment “fully supports” the change proposed by Bd.R. 41.37(q), which has been combined with Bd.R. 41.37(r). It was suggested that clarification be given stating that an appellant not be required to identify every part of a specification which supports a given limitation.

*Answer.* The clarification requested is appropriate. A specification can discuss a limitation in numerous places throughout the specification. A citation in the claims support section to all “places” is not necessary when those citations would be cumulative. What is necessary is a citation to the part or parts of the specification which will allow the Board to understand where the claimed limitation has antecedent basis in the specification. A significant difficulty the Board experiences is when the wording of the claim (original or amended) is not the same as the wording of the specification.

The comment made an additional suggestion that the practice of Bd.R. 41.37(r) be required for all amendments filed during prosecution. The additional suggestion is beyond the scope of the rule making to the extent it seeks changes to the rules governing pre-appeal examination practice.

*Comment 72.* A comment suggested that a drawing analysis is not necessary, indicating that the summary of the invention provisions of the former rule adequately serves the purpose which would be served by the drawing analysis section.

*Answer.* It is true that in some appeal briefs, the appellant will describe the invention using the language of the claims along with parenthetical insertions of element numbers of the drawings. Those appeal briefs have been very useful, so much so that it has been determined that it would be useful to have a drawing analysis section in all cases. Moreover, when there is no drawing analysis section, appellants should understand that the Board itself will often undertake to create a drawing analysis. In doing so, the Board may not conclude that a particular drawing element is what was intended by the appellant. Having the appellant in the first instance tell the Office which drawing element corresponds to a claim limitation will avoid unnecessary misunderstandings.

*Comment 73.* A comment suggested that if the only claim separately argued is a dependent claim, the drawing analysis should also annotate the claims from which the separately argued claims depend.

*Answer.* The suggestion is adopted, both as to the required drawing analysis as well as the claim support analysis.

The language “(and, if necessary, any claim from which the claim argued separately depends)” has been added to Bd.R. 41.37(r) and (s).

*Bd.R. 41.37(s)*

*Comment 74.* A comment requested guidance on how one would comply with Bd.R. 41.37(s).

*Answer.* An example, based on a published U.S. application with a drawing follows.

An apparatus comprising (1) a first valve, (2) a second valve, (3) a tank, (4) means for connecting the first valve to the tank {Fig. 3, element 19; ¶ 0010} and (5) \* \* \*.

*Comment 75.* A comment suggested that Bd.R. 41.37(s) should be clarified to state whether means or step plus function limitations in just contested claims need to be analyzed or whether the analysis is necessary for all claims, including non-contested claims.

*Answer.* A means or step plus function analysis is necessary only in contested claims. The rule specifies that the means or step plus function analysis is necessary “[f]or each independent claim involved in the appeal and each dependent claim argued separately.” A contested claim is a claim for which separate patentability arguments are presented, e.g., claims 1 and 4 over the Jones reference mentioned in Comment 49.

*Comment 76.* A comment “supports” Bd.R. 41.37(s), but suggested that it be made clear that there is more than one way to have a “means plus function” claim.

*Answer.* There is a presumption that a limitation reciting “means” for performing a function or a step is a limitation within the meaning of the sixth paragraph of 35 U.S.C. 112. However, as the comment points out, “program instructions for \_\_\_\_\_,” “component for \_\_\_\_\_” or “module for \_\_\_\_\_” may also be means plus function claims. In such a case, compliance with Bd.R. 41.37(s) would be necessary. The comment also indirectly suggested that appellants may try to sidestep the question of whether particular language is “means” language. The consequence of failing to identify “means” language as “means or step plus function language” may mean that the limitation will be construed to cover any element or step which performs the function.

*Bd.R. 41.37(t)*

*Comment 77.* Several comments were received questioning the need for an evidence section. According to the comments, the Office already has the material which an appellant would include in an evidence section.

*Answer.* The comments have merit. As a result of comments, the Office has decided to insert a definition of the Record in Bd.R. 41.30. The Record is the official file of the application or reexamination on appeal. The appeal will be decided on the Record consistent with the arguments presented in the appeal brief and reply brief and observations made in the examiner's answer. Nevertheless, the Office has decided to continue current practice of requiring a significantly more limited evidence section. See Rule 41.37(c)(1)(ix), requiring an evidence appendix. Under Bd.R. 41.37(t), the evidence section is limited to (1) affidavits and declarations, if any, and attachments to declarations, relied upon by appellant before the examiner, (2) other evidence, if any, relied upon by the appellant before the examiner and filed prior to the date of the notice of appeal, and (3) evidence relied upon by the appellant and admitted into the file pursuant to Bd.R. 41.33(d) of this subpart. The documents would be included in the evidence section only if they are relied upon in the appeal. Often numerous documents are relied upon during prosecution leading up to an appeal. The evidence section will eliminate any doubt about which documents an appellant intends to rely on in support of the appeal. While the scope of the evidence section is being narrowed considerably, the Office is still concerned with a potential problem that there can be confusion over a citation to a particular piece of evidence in the Record. The problem is not new with the image file wrapper (IFW) system. Neither pre-IFW paper files nor IFW files have consecutively numbered pages to which applicants, examiners, and the Board may refer. Accordingly, in presenting appeal briefs and reply briefs, appellant will want to ensure that a reference to a document in the Record is absolutely identifiable. The best identification is (a) the style of the document and (b) the date it was filed in the Office, e.g., AMENDMENT UNDER RULE 116, filed 04 February 2008, or FINAL REJECTION mailed 04 February 2008.

*Comment 78.* A comment suggested that an appellant should be authorized to include in the evidence section a clean copy of a document which may be poorly reproduced in "the current file."

*Answer.* Nothing in Bd.R. 41.37(t) would preclude an appellant from doing so. Presentation of clear documents is encouraged.

*Comment 79.* A comment suggested that an appellant be permitted to refer to PAIR (Public Application Information

Retrieval) instead of providing an evidence section.

*Answer.* The suggestion is not adopted. The examiners and the Board use the IFW file to examine applications and decide appeals. Accordingly, an appellant will want to refer to documents in a precise manner consistent with the examples set out in Comment 77.

*Bd.R. 41.37(v)(1)*

*Comment 80.* A comment asked how pages of the evidence section are to be numbered.

*Answer.* Any one of the following numbering systems would be acceptable: (1) A number, e.g., "31", at the center of the bottom of the page or (2) "Page x of y" at the center of the bottom of the page or (3) "Page x" at the center of the bottom of the page. An appeal brief, including its sections, should be consecutively page-numbered beginning with "1" on the first page and continuing with consecutive numbers through the last page of the brief. Use of consecutive numbers will permit appellants, the examiner, and the Board to make precise references to the appeal brief and the reply brief, including sections of the appeal brief.

*Comment 81.* A comment suggested that line numbers in appeal briefs and other papers are not necessary.

*Answer.* Line numbers are highly useful within the Office. While line numbers will not be required, appellants are encouraged to use line numbers. When line numbers are used, they may appear inside the left margin. Why are line numbers encouraged? With a telework program in place within the Office, many members of the Board work remotely a considerable portion of the time. Board members communicate with other Board members through a telephone and computer system. The computer system permits all involved in a telephone conference to access the record. Discussion by phone is simplified if one Board member can refer another Board member to a page and line of a brief. Modern word processors permit adding line numbers to pages with minimal difficulty.

*Bd.R. 41.37(v)(2)*

*Comment 82.* A comment suggested that 1½ line-spacing be authorized in place of double spacing.

*Answer.* The suggestion is adopted-in-part to the extent that block quotes may be presented in 1½ line-spacing. The last line of Bd.R. 41.37(v)(2) has been changed to read: "Block quotations may be 1½ line-spacing." As a general proposition, an appellant may wish to

avoid long block quotes from documents in the record. Instead, for factual material (as opposed to incorporating an argument by reference), the appellant may state the fact and refer the reader to the page and line or paragraph of the document relied upon.

*Comment 83.* A comment asked: Can line spacing greater than double-spacing (e.g., triple-spacing) be used in a brief?

*Answer.* No.

*Bd.R. 41.37(v)(3)*

*Comment 84.* A comment asked: Can a header appear within the top margin?

*Answer.* No. While Bd.R. 41.37(v)(3) has been reserved, a header cannot appear in the top margin.

*Comment 85.* A comment asked: What is the difference between "clean" and "readable"?

*Answer.* While Bd.R. 41.37(v)(3) has been reserved, Rule 52(a)(iv) requires papers in the file to be "plainly and legibly written."

*Bd.R. 41.37(v)(4)*

*Comment 86.* Several comments suggested that a font size equivalent to 14 point Times New Roman is too large. Some comments suggested a font size equivalent to Times New Roman of 12 point referring to Rule 52(a)(1)(ii) and (b)(2)(i) which states a preference for a 12 point font size. It was observed that a 12 point font size would provide some relief from the 25-page limit required by other provisions of the rules as proposed.

*Answer.* The suggestion to amend Bd.R. 41.37(v)(4) is not being adopted, although the reference in Bd.R. 41.37(v)(4) to Times New Roman is being deleted. The Rule 52(b)(2)(ii) preference for a font size of 12 (equal to pica type) and 0.125 inch high capital letters was added in 2005 to supplement a requirement (added in 2001) that letters be at least 0.08 inch high (equal to elite type). Prior to 2001, Rule 52 merely required that papers be prepared on a typewriter or mechanical printer which inherently limited the font size to either pica or elite. The font sizes specified in Rule 52(b)(2)(ii) are a vestige of earlier times and do not meet the current needs of the Board. The Board no longer physically handles papers prepared by applicants. Rather, since 2006, all papers are handled as scanned images. The quality of any font degrades as it passes through scanning and other electronic processing (e.g., photocopying by applicant, filing by fax, scanning for image storage, and scanning the stored image again for optical character recognition). Smaller fonts present a particular problem after original papers pass through numerous

levels of electronic image processing. A 14-point font size in the original paper will provide better results given the current technology used for handling applicants' papers.

*Bd.R. 41.37(v)(5)*

*Comment 87.* Several comments suggested that the 25-page limit is not sufficient to permit an appellant to properly present its case in the appeal brief. Some of those comments indicated that final rejections exceeding 25 pages had been received and suggested that when a final rejection exceeds 25 pages an appellant should be able to file an appeal brief where the statement of facts and argument is the same length as the final rejection.

*Answer.* Initially it will be noted that many administrative and judicial tribunals have page limits on briefs. An informal survey of the argument and fact portions of appeal briefs in appeals before the Board conducted *prior* to the notice of proposed rule making revealed that less than ten (10) percent of the appeal briefs exceeded 25 pages. An informal survey of 135 briefs taken *after* the notice of proposed rule making revealed that less than three (3) percent of the argument and fact portion of appeal briefs exceeded 30 pages. Eighty-three (83) percent of those appeal briefs had less than 17 pages of argument. Accordingly, Bd.R. 41.37(v)(5) addresses appeal brief length in a relatively small subgroup of appeal briefs which reach the Board. Even in appeal briefs which do not exceed 25 pages, the Board has found that many briefs contain discussion which is probably not necessary in an appeal brief before the PTO. For example, appeal briefs often contain lengthy sections explaining legal principles applicable to rejections under § 103. Appellants should assume that the examiner and the Board are aware of the basic principles governing evaluation of § 103 rejections, *e.g.*, those set out in *KSR International Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007); *Graham v. John Deere Co.*, 383 U.S. 1 (1966). The same is true for other routine rejections based on § 102 and § 112. For the most part, lengthy expositions in an appeal on applicable legal principles are not necessary in cases before the Board. Eliminating expositions on the law will also reduce the size of the table of authorities (Bd.R. 41.37(j)).

An appellant should review any proposed appeal brief to determine if it has unnecessary "boilerplate" language which does not address why an examiner is believed to have erred. After setting out the facts (Bd.R. 41.37(n)), an argument section of an appeal brief

should present arguments in the following format: "On page 4, lines 5–8 of the final rejection, the examiner found that \* \* \*. The examiner's finding is not supported by the evidence because \* \* \*." "On page 5, lines 10–11 of the final rejection, the examiner held that one skilled in the art would have found it obvious to combine A with B. The examiner's conclusion is erroneous because \* \* \*." "On page 3, lines 2–6 of the final rejection, the examiner found that \* \* \*. The examiner's finding, while correct, is not relevant to the § 103 rejection because \* \* \*."

Generally while discussion to "educate" the Board on the technology involved is helpful, it should not appear in the argument. Rather, it can and should appear in the statement of facts (Bd.R. 41.37(n)), claims support and drawing analysis section (Bd.R. 41.37(r)), and the means or step plus function section (Bd.R. 41.37(s)). In the event the Board believes that it needs more information with respect to the nature of an invention, it has authority to ask for further briefing (Bd.R. 41.50(f)).

Some have suggested that the statement of facts (Bd.R. 41.37(n)) should not be included in the 25-page limit. In motions practice in interferences, there was a time when there was a page limit for motions, including a statement of facts. At the suggestion of the bar, the statement of facts was excluded from the page limit. The result has been lengthy statements of fact which often (1) include unnecessary facts, (2) are not helpful to the Board and (3) burden the opponent. The Office does not intend to repeat the failed experiment in interferences with appeal briefs.

In response to the notice of proposed rulemaking, numerous comments suggested that a 25-page limit would restrict an appellant's ability to present its case. Taking into account the analysis set out above and the number of concerns expressed, the page limit will be increased to (1) 30 pages for appeal briefs (Bd.R. 41.37(v)(5)) and (2) 20 pages for reply briefs (Bd.R. 41.41(d)). An appellant needing more pages can obtain relief by a petition under Bd.R. 41.3 which shows good cause why additional pages are needed.

The 30 pages do not include (1) any statement of the real party in interest (Bd.R. 41.37(f)), (2) statement of related cases (Bd.R. 41.37(g)), (3) jurisdictional statement (Bd.R. 41.37(h)), (4) table of contents (Bd.R. 41.37(i)), (5) table of authorities (Bd.R. 41.37(j)), (6) status of amendments (Bd.R. 41.37(l)), (7) claims section (Bd.R. 41.37(p)), (8) claims

support and drawing analysis section (Bd.R. 41.37(r)), (9) means or step plus function analysis section (Bd.R. 41.37(s)), (10) evidence section (Bd.R. 41.37(t)), and (11) signature block. It should be noted that Bd.R. 41.37(k) and Bd.R. 41.37(q) have been eliminated and changed to "reserved". Bd.R. 41.37(v)(5) has been changed to explicitly set out what is not included in the 30-page limit.

*Comment 88.* A comment suggested that 10 additional pages be authorized by rule for each additional rejection beyond a first rejection.

*Answer.* The suggestion is not being adopted. Rather, increasing the page limit from 25 to 30 serves the function of authorizing an applicant to present an additional argument.

*Bd.R. 41.37(v)(6)*

*Comment 89.* A comment asked: If the correspondence address on the appeal brief differs from that "of record," which will the Board use?

*Answer.* The correspondence address in the appeal brief.

*Comment 90.* A comment asked: Must appellant correspond with the Office in appeal matters via fax? If not, why is a fax number required?

*Answer.* The fax and e-mail addresses are required by the rule so that the Board may easily communicate with counsel. Sometimes it is necessary for a paralegal to contact the office of counsel to obtain clarification on a particular matter. Examples include (1) clarification of a patent identified in a specification by an incorrect patent number, (2) a request for a copy of a brief in digitized form, (3) attempting to schedule a date for oral argument, and (4) a request for a legible copy of a document previously submitted by an applicant.

*Comment 91.* A comment suggested the possibility of a "mini-appeal brief" for certain appeals.

*Answer.* The suggestion has not been adopted. See Comment 33 for additional discussion.

*Bd.R. 41.39*

*Comment 92.* Several comments suggested that the rules should include a provision for the content and nature of the examiner's answer. Other comments suggested that a time-limit should be placed on the examiner for entering an examiner's answer. Still other comments suggested that the format of the examiner's answer should be the same as the format for an appeal brief.

*Answer.* While there can be rare exceptions, generally the rules are not the place for the Director to set out

administrative practice for examiners and other Office employees. The content and nature of an examiner's answer, and the time within which it is to be filed, are best left for administrative instructions or the Manual of Patent Examining Procedure.

*Bd.R. 41.39(a)*

*Comment 92A.* A comment suggested that the terminology "new ground of rejection" be retained in the proposed rules.

*Answer.* The suggestion is being adopted.

*Comment 92B.* A comment expressed concern that there is a very limited ability to reply to a new ground of rejection in an examiner's answer because the appeal must continue on the current record.

*Answer.* The rules are being amended to eliminate new grounds of rejection in an examiner's answer.

*Bd.R. 41.41*

*Comment 93.* A comment suggested that an appellant should be able to present a new argument in a reply brief where the importance of the argument is not made apparent until a review of the examiner's answer.

*Answer.* The suggestion is not being adopted. The same comment reveals that there are delays in resolving appeals and that the rules should be designed to eliminate those delays. One delay under the current practice is the perceived ability of an appellant to present a new argument in a reply brief. If a new point is made in the examiner's answer, then the appellant may fully respond to that new point apart from any argument in the appeal brief. However, prosecution of an appeal should not be delayed through presentation of new arguments which reasonably could have been made in an appeal brief.

*Comment 93A.* A comment suggested that when presenting an amendment in a reply brief that an appellant should be given an unconditional waiver from any rule limiting continuations.

*Answer.* The suggestion raises a matter beyond the scope of the notice of proposed rule making and will not be adopted.

*Bd.R. 41.43*

*Comment 94.* Several comments suggested that an examiner not be allowed to reopen prosecution after a reply brief (*see* Bd.R. 41.41) is filed. According to the comment, many practitioners believe the practice of "reopening" prosecution "is already abused" by some examiners. Some examiners are said to have re-opened

prosecution "over and over again to allow them yet further and further opportunities at the bat." One comment identified an application in which the examiner is said to have re-opened prosecution "four times."

*Answer.* The suggestion is not being adopted. Assuming, without deciding, that the comment is correct, then there is a plausible basis for holding that the conduct described might be characterized as an abuse of discretion. An abuse of discretion is not solved by an amendment to a rule. It is solved on a case-by-case basis via a petition.

Alternatively, if an applicant believes the examination process is being abused, the applicant should call the matter to the attention of the SPE (supervisory patent examiner) or the Director of the Technology Center in which the application is being examined.

*Comment 95.* Several comments suggested that a provision be added to Bd.R. 41.43 to preclude a new ground of rejection in a supplemental examiner's answer.

*Answer.* The suggestion is adopted to the extent that a new ground of rejection will no longer appear in an examiner's answer. There is no supplemental examiner's answer replying to an appellant's reply brief. It should be noted that Bd.R. 41.43 (supplemental examiner's answer) and Bd.R. 41.44 (supplemental reply) are now reserved.

*Bd.R. 41.47(c)*

*Comment 96.* A comment asked whether the time for filing a request for oral argument runs from entry of the examiner's answer or the examiner's supplemental answer.

*Answer.* Since there will no longer be an examiner's supplemental answer, the time for requesting oral argument is from the date the examiner's answer (Bd.R. 41.39) is mailed.

*Bd.R. 41.47(g)*

*Comment 97.* A comment suggested that individuals transcribing an oral hearing should be presumed to be competent and seems to question the need for a list of terms. With respect to the language "unusual terms," the same comment asked: Unusual to whom?

*Answer.* The rules authorize a list of terms to assist the court reporter. Often members of the Board supply a list so that the court reporter can prepare a more accurate transcript. Generally court reporters are not scientists familiar with technical terms. Sometimes, the names of patentees and others mentioned in the record (e.g., an affidavit) are difficult. The Board has sufficient confidence in practitioners

being able to recognize when a list of terms may help a court reporter.

*Bd.R. 41.47(k)*

*Comment 98.* A comment suggested that the rule should explicitly authorize use of enlarged visual aids suitable for placing on an easel.

*Answer.* Enlarged documents suitable for use on easel can be used at oral hearings, provided the required four copies (preferably 8½ x 11; one for each judge and one to be added to the Record) are provided to the Board.

*Comment 99.* Several comments suggested that three-dimensional objects illustrative of the claimed invention or the prior art be permitted as visual aids at oral argument.

*Answer.* The suggestions are adopted to the extent that an appellant may use as a visual aid documents and evidence in the Record or a model or exhibit presented for demonstration purposes during an interview with the examiner. An applicant should be sure that the Record makes clear that the model or exhibit was shown to the examiner. See Rule 133 and MPEP 608.03(a) (8th ed., Rev. 5, Aug. 2006). For example, an applicant may wish to place a photograph of the object shown to the examiner in the application file. In addition to using a three-dimensional object as a visual aid, an appellant may provide copies of the photograph to the Board at oral hearing.

*Bd.R. 41.50*

*Comment 100.* A comment asked: How does an appellant "signal" the Board that proceedings on a remand (Bd.R. 41.50(b)) are concluded?

*Answer.* The rule provides the answer: (1) Request that prosecution be reopened (Bd.R. 41.50(b)(1)) or (2) request to re-docket the appeal (Bd.R. 41.50(b)(2)).

*Bd.R. 41.51(f)*

*Comment 101.* A comment suggested that the time period for response to an order of the Board under Bd.R. 41.51(f) should be extendable by petition under Bd.R. 41.3 so that an appellant need not be "forced to employ the unwieldy procedure of petitioning under" Rule 183.

*Answer.* The suggestion is not being adopted. Experience under Bd.R. 41.51(f), and its predecessor rule, shows that appellants almost always timely respond to orders of the Board. The policy for setting times to respond to orders of the Board under Bd.R. 41.51(f) was set out in the supplementary information in the notice of proposed rulemaking (72 FR at 41,482, col. 2). Historically, there has not been a need

for extensions of time. Accordingly, there is no need to authorize, or encourage, requests for extension of times by petition under Bd.R. 41.3. Should a circumstance develop where an appellant has an extraordinary reason for needing an extension, a petition may be filed under Rule 183 addressed to the Chief Administrative Patent Judge.

*Bd.R. 41.52*

*Comment 102.* A comment was received that the word "rehearing" in the title and text of Bd.R. 41.52 should be changed to "reconsideration." According to the commentator, the word "rehearing" implies, incorrectly, that an oral hearing may be held.

*Answer.* The comment is correct in indicating that a "rehearing" under 35 U.S.C. 6 and Bd.R. 41.52 does not mean an oral hearing will be held. The word "rehearing" is used in the rule because it is the word used in the statute authorizing the Board to grant a "rehearing." 35 U.S.C. 6(b).

*Bd.R. 41.52(d)*

*Comment 103.* Several comments suggested that a change be made to Bd.R. 41.52(d) and (f) because it may not be appropriate for an appellant to indicate in a petition for rehearing filed pursuant to Bd.R. 41.50(d)(2) to discuss what points the Board may have misapprehended or overlooked.

*Answer.* The suggestion is not being adopted. If an appellant is dissatisfied with a "new ground of rejection" under Bd.R. 41.50(d) and the appellant elects to ask the Board for a rehearing (as opposed to further consideration by the examiner), then it is entirely appropriate for the appellant to advise the Board what fact or issue of law was misapprehended or overlooked. In filing a request for rehearing, the appellant shall rely only on the record on appeal.

*Comment 104.* A comment suggested that a request for rehearing should be able to address a new point made by the Board in its opinion in support of a decision on appeal.

*Answer.* Bd.R. 41.52 should not be understood to preclude the presentation in a request for rehearing of an argument responding to a new point made by the Board. The argument in the request for rehearing would be that the Board misapprehended the point.

*Bd.R. 41.56*

*Comment 105.* A comment claimed that Bd.R. 41.56 gives the Board authority to "assert" that an argument in an appeal brief is frivolous (see Bd.R. 41.56(a)(2)) or hold a fact to have been established (see Bd.R. 41.56(b)(2)). The

comment goes on to state that it is not clear how an applicant "appeals" from such an order other than to the courts.

*Answer.* The jurisdiction of the Board is to review adverse decisions of an examiner. 35 U.S.C. 134. If in the course of the review, the Board enters a sanction and holds a fact to have been established and based on that fact a rejection is affirmed, the applicant would have judicial review of the Board's decision in the Federal Circuit (35 U.S.C. 141-144) or the U.S. District Court for the District of Columbia (35 U.S.C. 145). If in the course of the appeal, a sanction is entered by anyone other than a panel of the Board, an applicant would have administrative review by petition.

*Comment 106.* Several comments questioned the need for Bd.R. 41.56.

*Answer.* Bd.R. 41.56 sets out conduct which is detrimental to the efficient administration of *ex parte* appeals before the Office. The comments suggest that Bd.R. 41.56 fails to give adequate notice of what might be considered "misconduct." A similar rule has existed in interference cases. Bd.R. 41.128. Sanctions are very rare in interference cases. The presence of Bd.R. 41.128 advises practitioners and others with respect to behavior which is not consistent with efficient administration of interference cases. In like manner, Bd.R. 41.56 does the same for *ex parte* appeals. The rule also provides notice of the nature of a sanction in the event there has been a violation of the rules or an order entered in an appeal. It is expected that sanctions will be rare in *ex parte* appeals. The comments note that the "standards" for whether a sanction should be imposed are "subjective" and that sanctions will be entered as a matter of discretion by the Office. The sanction provisions of other tribunals are equally subjective and are entered (or not entered) as a matter of discretion. Courts and other agencies have administered sanction rules without any apparent difficulty.

*Comment 107.* A comment asked whether Rule 11 of the Fed. R. Civ. P. and case law construing or applying the rule are relevant to the definition of "misleading" and "frivolous" in Bd.R. 41.56.

*Answer.* Both words will be construed under Bd.R. 41.56 according to their ordinary meaning. Precedent of a court may or may not be helpful. The terms will be interpreted in the context of the appeals rules. *Cf. FirstHealth of the Carolinas, Inc. v. CareFirst of Maryland, Inc.*, 479 F.3d 825, 829 (Fed. Cir. 2007) (the TTAB has discretion to reasonably interpret the meaning of "excusable

neglect" in the context of its own regulations, citing *Thomas Jefferson University v. Shalala*, 512 U.S. 504, 512 (1994) (an agency's interpretation of its own regulation is given controlling weight unless it is plainly erroneous or inconsistent with the regulation)).

*Comment 108.* A comment noted that the sanctions rule (Bd.R. 41.56) does not provide for "an appeal" and therefore constitutes a denial of due process.

*Answer.* If a sanction is entered prior to a final decision of the Board, review is available by petition and subsequently in a court to the extent authorized by Congress. As noted earlier, a sanction having an effect on the merits is reviewable along with the merits in the Federal Circuit (35 U.S.C. 141) or the U.S. District Court for the District of Columbia (35 U.S.C. 145).

*Comment 109.* A comment suggested that the sanctions are unnecessary because the Office has not shown that any of the sanctions are necessary or have been used.

*Answer.* The need for a sanction rule is based on experience in appeals over the years. A sanction rule provides important public notice of behavior which is prejudicial to the effective administration of appeals within the Office. The sanction to be applied in a particular case will depend on the facts. Generally, sanctions are not applied without giving an appellant an opportunity to explain and justify its behavior.

A sanction of not entering a docket notice may be appropriate where an appellant repeatedly declines to comply with procedural requirements to perfect an appeal.

An order holding certain facts to have been established or from contesting a certain issue might be appropriate where an appellant is asked (Bd.R. 41.50(f)) to brief certain matters and avoids directly answering specific questions posed by the Board.

An order expunging a paper might be entered where an appellant repeatedly fails to file a paper complying with the rules.

An order excluding evidence might be appropriate where an appellant refuses to properly file evidence or where knowingly "false" evidence is presented.

Other sanctions may be appropriate depending on the situation, including sanctions not specifically listed in Bd.R. 41.56(b). The expectation is that sanctions will rarely be necessary. On the other hand, having notice in the rules of possible sanctions can avoid arguments by someone that the Office has not given notice of its intent to take



action against an appellant when necessary.

### Rulemaking Considerations

#### *Administrative Procedure Act*

The changes in the rules relate solely to the procedure to be followed in filing and prosecuting an *ex parte* appeal to the Board. Therefore, these rule changes involve interpretive rules, or rules of agency practice and procedure under 5 U.S.C. 553(b)(A). Prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553(b)(A) (or any other law). See *Bachow Communications, Inc. v. F.C.C.*, 237 F.3d 683, 690 (D.C. Cir. 2001) (rules governing an application process are "rules of agency organization, procedure, or practice" and exempt from the Administrative Procedure Act's notice and comment requirement); *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543, 1549–50 (Fed. Cir. 1996) (the rules of practice promulgated under the authority of former 35 U.S.C. 6(a) (now in 35 U.S.C. 2(b)(2)) are not substantive rules (to which the notice and comment requirements of the Administrative Procedure Act apply)); *Fressola v. Manbeck*, 36 USPQ2d 1211, 1215 (D.D.C. 1995) ("[i]t is extremely doubtful whether any of the rules formulated to govern patent or trademark practice are other than 'interpretive rules, general statements of policy, \* \* \* procedure, or practice'" (quoting C.W. Ooms, The United States Patent Office and the Administrative Procedure Act, 38 Trademark Rep. 149, 153 (1948))); *Eli Lilly & Co. v. Univ. of Washington*, 334 F.3d 1264, 1269 n.1 (Fed. Cir. 2003).

#### *Regulatory Flexibility Act*

The Deputy General Counsel for General Law of the United States Patent and Trademark Office certifies to the Chief Counsel for Advocacy of the Small Business Administration that this final rulemaking, Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals (RIN 0651-AC12), will not have a significant economic impact on a substantial number of small entities. See 5 U.S.C. 605(b).

The United States Patent and Trademark Office (Office) is amending its rules in 37 CFR part 41 governing prosecution in *ex parte* appeals at the Board of Patent Appeals and Interferences (Board). There are fee changes associated with the final rules.

The changes in this final rule involve interpretive rules, or rules of agency practice and procedure, and prior notice and an opportunity for public comment

are not required pursuant to 5 U.S.C. 553(b)(A) (or any other law). Because prior notice and an opportunity for public comment are not required for the changes proposed in this rule, a Regulatory Flexibility Act analysis is also not required for the changes proposed in this rule. See 5 U.S.C. 603. Nevertheless, the Office published a notice of proposed rulemaking in the **Federal Register** and in the Official Gazette of the United States Patent and Trademark Office, in order to solicit public participation with regard to this rule package.

In response to the notice of proposed rule making, a comment was submitted that contended that a Regulatory Flexibility Act analysis is required under 5 U.S.C. 603. Because these rules are procedural, they are not required to be published for notice and comment. The Office chose, however, to publish these rules for comment prior to adoption of the final rules in order to request valuable input from the public.

The primary changes in this rule are: (1) The requirements for an appeal brief include new sections for jurisdictional statement, table of contents, table of authorities, statement of facts, new format for arguments in the appeal brief and for claim support and drawing analysis section and means or step plus function analysis section in the appendix of the appeal brief, new section for table of contents in the evidence section of the appendix, new format in 14-point font, and 30-page limit for the grounds of rejection, statement of facts, and argument sections, (2) the requirements for a reply brief include new sections for table of contents, table of authorities, statement of additional facts, new format for arguments in the reply brief, new format in 14-point font, and 20-page limit for the statement of additional facts and argument sections, (3) the requirements for a request for rehearing include new sections for table of contents, table of authorities, new format for arguments in the request for rehearing, new format in 14-point font, and 10-page limit for the argument section, (4) new grounds of rejection are no longer permitted in an examiner's answer, (5) the examiner's response to a reply brief is eliminated, (6) petitions to exceed the page limit for an appeal brief, reply brief or request for rehearing are made under Rule 41.3 which requires a \$400 fee, (7) petitions for an extension of time to file a reply brief, request for oral hearing, or request for rehearing are made under Rule 41.3 which requires a \$400 fee, and (8) a list of technical terms or unusual words to be provided to the transcriber at the oral hearing. The rules described in (1)

through (5) and (8) will apply to all appeal briefs filed with the Board. The rules described in (6) and (7) will apply only to those applicants filing certain petitions.

#### Appeal Brief (1)

Little additional cost is associated with the new appeal brief requirements.

The jurisdictional statement of the appeal brief is a highly structured, fact-based paragraph of a maximum of 5 to 6 simple sentences. It is estimated that this section would add 10 to 15 minutes to the preparation of the brief. Assuming that the jurisdictional statement is prepared by a law firm staff member at the paralegal level, at an average billing rate of \$150 an hour, the added cost for preparation of the jurisdictional statement is \$25 to \$37.50. In some cases, however, the preparation of the jurisdictional statement will result in a substantial time and cost savings to the applicant. For instance, if in the preparation of the jurisdictional statement it becomes apparent that the application is abandoned, the applicant can take advantage of available revival remedies at an early date and avoid an unnecessary dismissal of the appeal.

The table of contents and table of authorities sections add very little additional cost to the preparation of the appeal brief. Modern word processors make the creation of a table of contents or a table of authorities fairly easy when headings are used in a document. The current rules and the proposed rules require the use of headings in the appeal brief. Assuming that virtually all applicants create their documents with a word processor, it would add 5 to 10 minutes to the preparation of the brief to insert the table of contents and table of authorities. Assuming that the table of contents and table of authorities are prepared by a law firm staff member at the paralegal level, at an average billing rate of \$150 an hour, the added cost for preparation of these two tables is \$12.50 to \$25. It should be noted that in many appeals pending before the Board, the briefs contain a table of contents or table of authorities even though these sections are not currently required.

The statement of facts section will not add to the appeal brief preparation cost and in many cases it will be a small cost savings. While the statement of facts is a new section in the final rule, the information contained in this section is part of the argument section of appeal briefs submitted under the current rule. By separating the facts from the argument, the applicant needs only to list a fact once and refer to it in the argument. Under current practice, applicant often times repeats a fact if

using it to support multiple arguments. Thus, in many cases the applicant will save time by not having to repeat a fact. Furthermore, the requirement for a fact to reference a specific portion of the Record does not impact the appeal brief preparation cost as it is a requirement under the current rule.

Under the final rule, the argument section of the appeal brief has a new requirement for applicant to identify where an argument was made in the first instance to the examiner or state that it is a new argument. It is estimated that this requirement would add 10 minutes to the preparation of the brief. Assuming that the argument section is prepared by a law firm staff member at the attorney level, at an average billing rate of \$310 an hour, the added cost for preparation of the argument section is \$51.67. Compliance with this requirement should be relatively easy. An applicant can take an appeal following the second rejection of the claims by the examiner. In most cases, this will mean that the argument was made to the examiner either in response to a first Office action or in response to a second Office action, likely a final rejection. Additionally, identification of whether an argument in an appeal brief is "new" will enable senior Patent Corps personnel to evaluate the new argument and determine whether a rejection should be withdrawn. This will provide a savings to applicant in one of two ways: (1) Eliminating at an early stage appeals which should not go forward or (2) making appeals which go forward capable of prompt resolution. The identification of where an argument is made or if it is a new argument prevents arguments from being overlooked by the examiner and allows senior Patent Corps personnel to more readily assess all the arguments. If it is decided, based on the arguments in the appeal brief, that the claims are allowable, the applicant saves the time of a full appeal to the Board and waiting for a decision. The applicant also saves the possible expense of a request for oral hearing before the Board. In those appeals which are presented to the Board, the arguments in the case will be readily identifiable for the panel to review in deciding the issues. This allows the panel to be more efficient in their decision making and consequently reducing the pendency of applications at the Board. By aiding in increasing the efficiency of panel review, the applicant will reduce the time it takes to receive a Board decision.

The claim support and drawing analysis section and the means or step plus function analysis section are analogous to the current summary of the

claimed subject matter section in the appeal brief. The information required for these two newly titled sections is the same as that required by the current rules. The final rule, however, is explicit as to the format to be followed in these sections. The current rule requires an explanation of the subject matter, whereas the final rule sets forth the precise format to be used in mapping claim limitations to the support and description of the limitations in the specification and drawings. Bd. R. 41.37(r) and (s). The current rule leaves the format for the explanation of the claimed subject matter open to interpretation by the applicant. Rule 41.37(c)(1)(v). The final rule provides a standardized, easy to follow format for these sections. By following the prescribed format of the final rule, the applicant will save time in not having to create their own format to explain the claimed subject matter. Moreover, the final rule format is expected to reduce the number of applications returned to the examiner because the brief is not compliant with the explanation of the claimed subject matter section of the rule. Under the current rules, it is not uncommon for a case to be returned to the examiner because of deficiencies in the summary of the claimed subject matter section of the appeal brief. When a case is returned to the examiner for correction of a non-compliant brief, the applicant must prepare and file a corrected brief. This delays the applicant's appeal and costs the applicant money to prepare a compliant brief. By following the clear, standardized format in the final rule for the claim support and drawing analysis section and means or step plus function section, applicants can prevent a return of their application on either or both of these bases. This will save the applicant the time and expense incurred for filing a corrected appeal brief. The claim support and drawing analysis section and the means or step plus function analysis section will not add cost to the appeal brief and will provide a savings to applicants in some cases.

As reasoned above, for the table of contents and table of authorities sections, the preparation of a table of contents for the evidence section of the appeal brief appendix will add about five minutes to the time for preparing the brief. Assuming that the table of contents is prepared by a law firm staff member at the paralegal level, at an average billing rate of \$150 an hour, the added cost for preparation of the table of contents is \$12.50.

The final rule requires the font for the appeal brief to be 14 point in size. Assuming that virtually all applicants

create their documents with a word processor, no additional time or cost is incurred in the selection of a 14-point font for the document.

The final rule sets forth a 30-page limit on the combined length of grounds of rejection, statement of facts, and argument sections of the appeal brief. This limit will not have any economic impact on approximately 97% of applicants. A recent survey of appeal briefs revealed that less than 3% of appeal briefs filed exceeded 30 pages in the current grounds of rejection and argument sections.

#### Reply Brief (2)

Very little additional economic impact is associated with the new reply brief requirements.

As set forth above in the discussion of the table of contents and table of authorities in the appeal brief, the creation of these sections will add only 5 to 10 minutes to the preparation of the reply brief. Assuming that the table of contents and table of authorities are prepared by a law firm staff member at the paralegal level, at an average billing rate of \$150 an hour, the added cost for preparation of the jurisdictional statement is \$12.50 to \$25. It should also be noted that in a recent survey of cases on appeal at the Board, only 68% of the cases contained reply briefs. This added cost applies only to cases in which a reply brief is filed.

For the reasons listed above in the discussion of the statement of facts in the appeal brief, the statement of additional facts in the reply brief will not have any economic impact on the preparation of the reply brief and in many cases the applicant will save time.

Under the final rule, the argument section of the reply brief has a new requirement that arguments be responsive to points made in the examiner's answer; otherwise the argument will not be considered and will be treated as waived. This requirement does not impose any additional economic burden on the applicant. It only makes clear what arguments in the reply brief will be considered by the Board. It saves the applicant the time and expense of preparing arguments that will not be considered.

The final rule requires the font for the reply brief to be 14 point in size. Assuming that virtually all applicants create their documents with a word processor, no additional time or cost is incurred in the selection of a 14-point font for the document.

The final rule sets forth a 20-page limit on the combined length of the statement of additional facts and

argument sections of the reply brief. A recent survey of reply briefs revealed that less than 1% of reply briefs filed exceeded 20 pages.

#### Request for Rehearing (3)

With regard to the third change, very little additional economic impact is associated with the new request for rehearing requirements.

As set forth above in the discussion of the table of contents and table of authorities in the appeal brief, the creation of these sections will add 5 to 10 minutes to the preparation of the request for rehearing. Assuming that the table of contents and table of authorities are prepared by a law firm staff member at the paralegal level, at an average billing rate of \$150 an hour, the added cost for preparation of the jurisdictional statement is \$12.50 to \$25. It should also be noted that in Fiscal Year 2007, there were only 123 requests for rehearing of a Board decision filed at the USPTO, out of 3,485 Board decisions rendered. This added cost applies only to cases in which a request for rehearing is filed.

Under the final rule, the argument section of the request for rehearing has a new format requirement that requires the applicant to explicitly identify in the Record the point that applicant believes was misapprehended or overlooked by the Board. Under current Rule 41.52(a)(1), applicants are required to "state with particularity the points believed to have been misapprehended or overlooked by the Board." Citation to the Record in compliance with the final rule will add 5 to 10 minutes to the preparation of a request for rehearing. Assuming that the argument section is prepared by a law firm staff member at the attorney level, at an average billing rate of \$310 an hour, the added cost for preparation of the argument section is \$25.83 to \$51.67.

The final rule requires the font for the reply brief to be 14 point in size. Assuming that virtually all applicants create their documents with a word processor, no additional time or cost is incurred in the selection of a 14-point font for the document.

The final rule sets forth a 10-page limit for the argument section of the request for rehearing. This limit will have no economic impact on most applicants. A survey of the request for rehearing in 92 rehearing cases decided within the last year (FY 2007) revealed that only 21 requests for rehearing contained arguments exceeding 10 pages.

#### Prohibition on New Grounds of Rejection in Examiner's Answer (4)

A savings to the applicant will result from the prohibition of new grounds of rejection in an examiner's answer. The current rules permit a new ground of rejection to be made in the examiner's answer. Rule 41.39(a)(2). In response to a new ground of rejection an applicant must request that prosecution be reopened before the examiner or file a reply brief with a request that the appeal be maintained. Rule 41.39(b). If the applicant elects to respond to the new ground of rejection by filing a reply brief, the reply brief may not be accompanied by any amendment, affidavit or other evidence. Rule 41.39(b)(2). In order to present an amendment, affidavit or other evidence, the applicant must expend additional time and resources to reopen prosecution before the examiner. Recent data from the Patent Corps reveals that in Fiscal Year 2007 (FY 2007) approximately 5% of examiner's answers written that year contained a new ground of rejection. The final rules prohibit a new ground of rejection in an examiner's answer and, thus, provide a savings to applicants in not having to prepare a response to a new ground of rejection late in the appeal process.

#### Elimination of Examiner's Response to Reply Brief (5)

The final rules eliminate the requirement for an examiner's response following a reply brief. Under the current rules, examiners are required to respond to a reply brief either by filing a communication noting the reply brief or by filing a supplemental examiner's answer. Rule 41.43(a)(1). The final rules eliminate both types of examiner response to a reply brief.

The elimination of the examiner's requirement to note the reply brief allows applications on appeal to proceed directly to the Board upon filing of the reply brief, without waiting for an examiner's response. This saves the applicant valuable time in the appeal process. It also saves the applicant the expense of tracking the examiner's response to the reply brief.

The elimination of a supplemental examiner's answer in response to a reply brief also allows applications on appeal to proceed directly to the Board upon filing of the reply brief. The applicant realizes an additional savings by elimination of the supplemental examiner's answer. Current practice provides that the applicant may file another reply brief in response to a supplemental examiner's answer. In almost every appeal where a

supplemental examiner's answer is provided, the applicant submits a reply brief. By eliminating the supplemental examiner's answer, it eliminates the need for applicant to respond with another reply brief. Therefore, elimination of the supplemental examiner's answer saves the applicant the cost of preparing another reply brief.

#### Petition To Exceed the Page Limit (6)

A \$400 cost is incurred for applicants who petition to exceed the page limit for filing an appeal brief, reply brief or request for rehearing. The final rules permit an applicant to petition under Rule 41.3 to exceed a page limit requirement. Petitions under Rule 41.3 must be accompanied by a \$400 fee. Thus, the \$400 petition fee is not a new fee, but the application of the existing petition fee to a new rule. Applicants can avoid this fee by filing a brief or request for rehearing within the page limits set forth in the rules.

#### Petition for Extension of Time (7)

An additional \$200 cost is incurred for applicants who petition for an extension of time to file a reply brief, request for oral hearing or request for rehearing. Under the current rules, an applicant may request an extension of time to file the above papers under Rule 1.136(b). Rule 1.136(b) requests must be accompanied by a \$200 fee. The final rules still permit applicants to request such extensions of time; however, the request must be made by petition under Rule 41.3, which requires a \$400 fee. Thus, the net additional cost for an extension of time is \$200. Moreover, applicants can avoid this fee by filing documents within the time periods set forth in the rules.

#### List of Technical Terms or Unusual Words (8)

A small additional cost is associated with the new requirement for a list of technical terms or unusual words for the transcriber at the oral hearing. It is estimated that the list would take 5 to 10 minutes or less to prepare. Assuming that the list of terms is prepared by a law firm staff member at the attorney level, at an average billing rate of \$310 an hour, the added cost for preparation of the list of terms is \$25.83 to \$51.67. It is further assumed that this list will replace the current practice of a question and answer session with the transcriber at the end of the hearing to collect these same terms. Note that in Fiscal Year 2007, there were 965 requests for oral hearing filed at the USPTO out of 4,639 appeals received at the Board. This added cost applies only

to cases in which a request for oral hearing is filed.

If an applicant were to incur all the additional costs outlined above, the total would range from \$778.33 to \$880.01. In many cases, however, the costs will be less than \$880.01 when the savings outlined for the appeal brief, reply brief, no new grounds of rejection in examiner's answer, and no examiner response to the reply brief are realized. Moreover, the additional legal costs are not significant when compared to the cost of legal fees when filing an appeal with the Board. The net additional legal services cost, minus the Office petition fees of \$400 (to exceed page limit) and \$200 (request for extension of time), is \$178.33 to \$280.01. According to the 2007 Report of the Economic Survey by the American Intellectual Property Law Association (AIPLA), page 21, the median charge in 2006 for an appeal to the Board without government fees and without oral argument was \$4,000. An increase of \$178.33 to \$280.01, out of \$4,000, represents an increase of only 4.5% to 7%. From the same 2007 AIPLA survey, the median charge in 2006 for an appeal to the Board without government fees and with oral argument was \$6,500. Thus, an additional cost of \$178.33 to \$280.01, in a case with oral argument, represents an increase of only 2.7% to 4.3%.

These additional costs apply equally to large and small entities, but do not disproportionately impact small entities for the following reasons. In examining the additional costs associated with the final rules, the largest single additional cost is the \$400 petition fee to exceed the page limit for an appeal brief, reply brief, or request for rehearing. As will be shown the potential number of small entities impacted by this fee is a very small number.

In FY 2007, the Office processed 4,808 appeal briefs filed by small entities and 18,337 appeal briefs filed by large entities. Assuming 3% of the appeal briefs filed by small entities contained sections for the grounds of rejection and argument exceeding 30 pages (see final paragraph of Appeal Brief (1) section), this provides an estimate of 144 small entities that would find it necessary to petition to exceed the appeal brief page limitation. Similarly, in FY 2007, the Office processed 1,341 reply briefs filed by small entities and 3,606 reply briefs filed by large entities. Assuming 1% of the reply briefs filed by small entities contained sections for a statement of additional facts and argument exceeding 20 pages (see final paragraph of Reply Brief (2) section), this provides an estimate of 14 small entities that would

find it necessary to petition to exceed the reply brief page limitation. Finally, in FY 2007, the Office processed 33 requests for rehearing filed by small entities and 90 requests for rehearing filed by large entities. Assuming 23% of the requests filed by small entities contained argument sections exceeding 10 pages (see final paragraph of Request for Rehearing (3) section), this provides an estimate of eight small entities that would find it necessary to petition to exceed the request for rehearing page limitation. Thus, at most, the maximum number of small entities affected by the \$400.00 petition fee is 166 small entities. When this number is compared to the 5,977 small entities that filed a notice of appeal with the Office in FY 2007 (21,653 notices of appeal were filed by large entities in the same period), it demonstrates that the petition fee has the potential to affect only 2.8% of the small entities filing an appeal. An effect on 2.8% of the small entities filing an appeal is not a disproportionate impact on small entities, nor is the actual number of 166 impacted small entities a substantial number.

For these reasons, the Office has concluded that the changes in the Final Rules will not have a significant economic impact on a substantial number of small entities.

#### *Executive Order 13132*

This rulemaking does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

#### *Executive Order 12866*

This rulemaking has been determined to be not significant for the purpose of Executive Order 12866 (Sept. 30, 1993).

#### *Paperwork Reduction Act*

This rulemaking includes requirements for structuring information submitted to the USPTO by practitioners in order to process *ex parte* appeals before the Board of Patent Appeals and Interferences (BPAI). The agency has received comments from the public concerning the burden of these rules on the public. In order to ensure that there is opportunity for the burden impact of these actions to be open for public comment, the USPTO will be submitting to the Office of Management and Budget (OMB) a request to consider this information subject to the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*).

The USPTO will be submitting to OMB the following items associated with this rule making for inclusion in a new collection specific to the Board of

Patent Appeals and Interferences: appeal brief, petition for extension of time for filing a paper after the brief, petition to increase the page limit, reply brief and request for rehearing before the BPAI. Per the requirements of submission of an information collection request to OMB, the USPTO will publish a 60-Day **Federal Register** Notice which will invite comments on: (1) Whether the collection of information is necessary for proper performance of the functions of the agency; (2) the accuracy of the agency's estimate of the burden; (3) ways to enhance the quality, utility, and clarity of the information to be collected; and (4) ways to minimize the burden of the collection of information to respondents.

Interested persons are requested to send comments regarding this information collection, including suggestions for reducing this burden, to Kimberly Jordan, Chief Trial Administrator, Board of Patent Appeals and Interferences, United States Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450, (marked: Information Collection Comment) or to the Office of Information and Regulatory Affairs, OMB, 725 17th Street, NW., Washington, DC 20503, (Attn: PTO Desk Officer).

Notwithstanding any other provision of law, no person is required to respond to nor shall a person be subject to a penalty for failure to comply with a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information displays a currently valid OMB control number.

#### **List of Subjects in 37 CFR Part 41**

Administrative practice and procedure, Inventions and patents, Lawyers.

■ For the reasons stated in the preamble, the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office amends 37 CFR Chapter 1, part 41 as follows:

#### **PART 41—PRACTICE BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

■ 1. The authority citation for part 41 is revised to read as follows:

**Authority:** 35 U.S.C. 2(b)(2), 3(a)(2)(A), 21, 23, 32, 132, 133, 134, 135, 306, and 315.

#### **Subpart A—General Provisions**

■ 1. In § 41.2, revise the definitions of “Board” and “Contested case” to read as follows:

**§ 41.2 Definitions.**

\* \* \* \* \*

*Board* means the Board of Patent Appeals and Interferences and includes:

(1) For a final Board action in an appeal or contested case, a panel of the Board.

(2) For non-final actions, a Board member or employee acting with the authority of the Board.

\* \* \* \* \*

*Contested case* means a Board proceeding other than an appeal under 35 U.S.C. 134. An appeal in an *inter partes* reexamination proceeding is not a contested case.

\* \* \* \* \*

■ 2. In § 41.3, revise paragraphs (a) and (b) to read as follows:

**§ 41.3 Petitions.**

(a) *Deciding official*. A petition authorized by this part must be addressed to the Chief Administrative Patent Judge. The Chief Administrative Patent Judge may delegate authority to decide petitions.

(b) *Scope*. This section covers petitions on matters pending before the Board, petitions authorized by this part and petitions seeking relief under 35 U.S.C. 135(c); otherwise see §§ 1.181 to 1.183 of this title. The following matters are not subject to petition:

(1) Issues committed by statute to a panel.

(2) In pending contested cases, procedural issues. See § 41.121(a)(3) and § 41.125(c).

\* \* \* \* \*

■ 3. In § 41.4, revise paragraphs (b) and (c) to read as follows:

**§ 41.4 Timeliness.**

\* \* \* \* \*

(b) *Late filings*. (1) A request to revive an application which becomes abandoned or a reexamination proceeding which becomes terminated under §§ 1.550(d) or 1.957(b) or (c) of this title as a result of a late filing may be filed pursuant to § 1.137 of this title.

(2) A late filing that does not result in an application becoming abandoned or a reexamination proceeding becoming terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) of this title may be excused upon a showing of excusable neglect or a Board determination that consideration on the merits would be in the interests of justice.

(c) *Scope*. Except to the extent provided in this part, this section governs proceedings before the Board, but does not apply to filings related to Board proceedings before or after the Board has jurisdiction (§ 41.35), such as:

(1) Extensions during prosecution (see § 1.136 of this title).

(2) Filing of a notice of appeal and an appeal brief (see §§ 41.31(c) and 41.37(c)).

(3) Seeking judicial review (see §§ 1.301 to 1.304 of this title).

■ 4. Revise § 41.12 to read as follows:

**§ 41.12 Citation of authority.**

(a) *Authority*. Citations to authority must include:

(1) *United States Supreme Court decision*. A citation to a single source in the following order of priority: United States Reports, West's Supreme Court Reports, United States Patents Quarterly, Westlaw, or a slip opinion.

(2) *United States Court of Appeals decision*. A citation to a single source in the following order of priority: West's Federal Reporter (F., F.2d or F.3d), West's Federal Appendix (Fed. Appx.), United States Patents Quarterly, Westlaw, or a slip opinion.

(3) *United States District Court decision*. A citation to a single source in the following order of priority: West's Federal Supplement (F.Supp., F.Supp. 2d), United States Patents Quarterly, Westlaw, or a slip opinion.

(4) *Slip opinions*. If a slip opinion is relied upon, a copy of the slip opinion must accompany the first paper in which an authority is cited.

(5) *Pinpoint citations*. Use pinpoint citations whenever a specific holding or portion of an authority is invoked.

(b) *Non-binding authority*. Non-binding authority may be cited. If non-binding authority is not an authority of the Office and is not reproduced in one of the reporters listed in paragraph (a) of this section, a copy of the authority shall be filed with the first paper in which it is cited.

**Subpart B—Ex parte Appeals**

■ 5. Revise § 41.30 to add a definition of "Record" to read as follows:

**§ 41.30 Definitions.**

\* \* \* \* \*

*Record* means the official content of the file of an application or reexamination proceeding on appeal.

■ 6. Revise § 41.31 to read as follows:

**§ 41.31 Appeal to Board.**

(a) *Notice of appeal*. An appeal is taken to the Board by filing a notice of appeal.

(b) *Fee*. The notice of appeal shall be accompanied by the fee required by § 41.20(b)(1).

(c) *Time for filing notice of appeal*. A notice of appeal must be filed within the time period provided under § 1.134 of this title.

(d) *Extensions of time to file notice of appeal*. The time for filing a notice of appeal is extendable under the provisions of § 1.136(a) of this title for applications and § 1.550(c) of this title for *ex parte* reexamination proceedings.

(e) *Non-appealable issues*. A non-appealable issue is an issue not subject to an appeal under 35 U.S.C. 134. An applicant or patent owner dissatisfied with a decision of an examiner on a non-appealable issue shall timely seek review by petition before jurisdiction over an appeal is transferred to the Board (see § 41.35). Failure to timely file a petition seeking review of a decision of the examiner related to a non-appealable issue may constitute a waiver to having that issue considered in the application or reexamination on appeal.

■ 7. Revise § 41.33 to read as follows:

**§ 41.33 Amendments and evidence after appeal.**

(a) *Amendment after notice of appeal and prior to appeal brief*. An amendment filed after the date a notice of appeal is filed and prior to the date an appeal brief is filed may be admitted as provided in § 1.116 of this title.

(b) *Amendment with or after appeal brief*. An amendment filed on or after the date an appeal brief is filed may be admitted:

(1) *To cancel claims*. To cancel claims provided cancellation of claims does not affect the scope of any other pending claim in the application or reexamination proceeding on appeal, or

(2) *To convert dependent claim to independent claim*. To rewrite dependent claims into independent form.

(c) *Other amendments*. No other amendments filed after the date an appeal brief is filed will be admitted, except as permitted by §§ 41.50(b)(1), 41.50(d)(1), or 41.50(e) of this subpart.

(d) *Evidence after notice of appeal and prior to appeal brief*. Evidence filed after the date a notice of appeal is filed and prior to the date an appeal brief is filed may be admitted if:

(1) The examiner determines that the evidence overcomes at least one rejection under appeal and does not necessitate any new ground of rejection, and

(2) appellant shows good cause why the evidence was not earlier presented.

(e) *Other evidence*. All other evidence filed after the date an appeal brief is filed will not be admitted, except as permitted by §§ 41.50(b)(1) or 41.50(d)(1) of this subpart.

■ 8. Revise § 41.35 to read as follows:

**§ 41.35 Jurisdiction over appeal.**

(a) *Beginning of jurisdiction.* The jurisdiction of the Board begins when a docket notice is mailed by the Board.

(b) *End of jurisdiction.* The jurisdiction of the Board ends when:

(1) The Board mails a remand order (see § 41.50(b) or § 41.50(d)(1) of this subpart),

(2) The Board mails a final decision (see § 41.2 of this part) and judicial review is sought or the time for seeking judicial review has expired,

(3) An express abandonment is filed which complies with § 1.138 of this title, or

(4) A request for continued examination is filed which complies with § 1.114 of this title.

(c) *Remand ordered by the Director.* Prior to entry of a decision on the appeal by the Board (see § 41.50), the Director may sua sponte order an application or reexamination proceeding on appeal to be remanded to the examiner.

■ 9. Revise § 41.37 to read as follows:

**§ 41.37 Appeal brief.**

(a) *Requirement for appeal brief.* An appeal brief shall be timely filed to perfect an appeal. Upon failure to file an appeal brief, the proceedings on the appeal are terminated without further action on the part of the Office.

(b) *Fee.* The appeal brief shall be accompanied by the fee required by § 41.20(b)(2) of this subpart.

(c) *Time for filing appeal brief.* Appellant must file an appeal brief within two months from the date of the filing of the notice of appeal (see § 41.31(a)).

(d) *Extension of time to file appeal brief.* The time for filing an appeal brief is extendable under the provisions of § 1.136(a) of this title for applications and § 1.550(c) of this title for *ex parte* reexamination proceedings.

(e) *Content of appeal brief.* The appeal brief must contain, under appropriate headings and in the order indicated, the following items:

(1) Statement of the real party in interest (see paragraph (f) of this section).

(2) Statement of related cases (see paragraph (g) of this section).

(3) Jurisdictional statement (see paragraph (h) of this section).

(4) Table of contents (see paragraph (i) of this section).

(5) Table of authorities (see paragraph (j) of this section).

(6) [Reserved.]

(7) Status of amendments (see paragraph (l) of this section).

(8) Grounds of rejection to be reviewed (see paragraph (m) of this section).

(9) Statement of facts (see paragraph (n) of this section).

(10) Argument (see paragraph (o) of this section).

(11) An appendix containing a claims section (see paragraph (p) of this section), a claim support and drawing analysis section (see paragraph (r) of this section), a means or step plus function analysis section (see paragraph (s) of this section), an evidence section (see paragraph (t) of this section), and a related cases section (see paragraph (u) of this section).

(f) *Statement of real party in interest.* The “statement of the real party in interest” shall identify the name of the real party in interest. The real party in interest must be identified in such a manner as to readily permit a member of the Board to determine whether recusal would be appropriate. Appellant is under a continuing obligation to update this item during the pendency of the appeal. If an appeal brief does not contain a statement of real party in interest, the Office will assume that the named inventors are the real party in interest.

(g) *Statement of related cases.* The “statement of related cases” shall identify, by application, patent, appeal, interference, or court docket number, all prior or pending appeals, interferences or judicial proceedings, known to any inventors, any attorneys or agents who prepared or prosecuted the application on appeal and any other person who was substantively involved in the preparation or prosecution of the application on appeal, and that are related to, directly affect, or would be directly affected by, or have a bearing on the Board’s decision in the appeal. A related case includes any continuing application of the application on appeal. A copy of any final or significant interlocutory decision rendered by the Board or a court in any proceeding identified under this paragraph shall be included in the related cases section (see paragraph (u) of this section) in the appendix. Appellant is under a continuing obligation to update this item during the pendency of the appeal. If an appeal brief does not contain a statement of related cases, the Office will assume that there are no related cases.

(h) *Jurisdictional statement.* The “jurisdictional statement” shall establish the jurisdiction of the Board to consider the appeal. The jurisdictional statement shall include a statement of the statute under which the appeal is taken, the date of the Office action setting out the rejection on appeal from which the appeal is taken, the date the notice of appeal was filed, and the date

the appeal brief is being filed. If a notice of appeal or an appeal brief is filed after the time specified in this subpart, appellant must also indicate the date an extension of time was requested and, if known, the date the request was granted.

(i) *Table of contents.* A “table of contents” shall list, along with a reference to the page where each item begins, the items required to be listed in the appeal brief (see paragraph (e) of this section) or reply brief (see § 41.41(d) of this subpart), as appropriate.

(j) *Table of authorities.* A “table of authorities” shall list cases (alphabetically arranged), statutes and other authorities along with a reference to the pages where each authority is cited in the appeal brief or reply brief, as appropriate.

(k) [Reserved.]

(l) *Status of amendments.* The “status of amendments” shall indicate the status of all amendments filed after final rejection (e.g., whether entered or not entered).

(m) *Grounds of rejection to be reviewed.* The “grounds of rejection to be reviewed” shall set out the grounds of rejection to be reviewed, including the statute applied, the claims subject to each rejection and references relied upon by the examiner.

(n) *Statement of facts.* The “statement of facts” shall set out in an objective and non-argumentative manner the material facts relevant to the rejections on appeal. A fact shall be supported by a reference to a specific page number of a document in the Record and, where applicable, a specific line or paragraph, and drawing numerals. A general reference to a document as a whole or to large portions of a document does not comply with the requirements of this paragraph.

(o) *Argument.* The “argument” shall explain why the examiner erred as to each ground of rejection to be reviewed. Any explanation must address all points made by the examiner with which the appellant disagrees. Any finding made or conclusion reached by the examiner that is not challenged will be presumed to be correct. For each argument an explanation must identify where the argument was made in the first instance to the examiner or state that the argument has not previously been made to the examiner. Each ground of rejection shall be separately argued under a separate heading.

(1) *Claims standing or falling together.* For each ground of rejection applicable to two or more claims, the claims may be argued separately (claims are considered by appellants as separately

patentable) or as a group (claims stand or fall together). When two or more claims subject to the same ground of rejection are argued as a group, the Board may select a single claim from the group of claims that are argued together to decide the appeal on the basis of the selected claim alone with respect to the group of claims as to the ground of rejection. Any doubt as to whether claims have been argued separately or as a group as to a ground of rejection will be resolved against appellant and the claims will be deemed to have been argued as a group. Any claim argued separately as to a ground of rejection shall be placed under a subheading identifying the claim by number. A statement that merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

(2) *Arguments considered.* Only those arguments which are presented in the argument section of the appeal brief and that address claims set out in the claim support and drawing analysis section in the appendix will be considered. Appellant waives all other arguments in the appeal.

(3) *Format of argument.* Unless a response is purely legal in nature, when responding to a point made in the examiner's rejection, the appeal brief shall specifically identify the point made by the examiner and indicate where appellant previously responded to the point or state that appellant has not previously responded to the point. In identifying any point made by the examiner, the appellant shall refer to a page and, where appropriate, a line or paragraph, of a document in the Record.

(p) *Claims section.* The "claims section" in the appendix shall consist of an accurate clean copy in numerical order of all claims pending in the application or reexamination proceeding on appeal. The status of every claim shall be set out after the claim number and in parentheses (e.g., 1 (rejected), 2 (withdrawn), 3 (objected to), 4 (cancelled), and 5 (allowed)). A cancelled claim need not be reproduced.

(q) [Reserved.]

(r) *Claim support and drawing analysis section.* For each independent claim involved in the appeal and each dependent claim argued separately (see paragraph (o)(1) of this section), the claim support and drawing analysis section in the appendix shall consist of an annotated copy of the claim (and, if necessary, any claim from which the claim argued separately depends) indicating in boldface between braces ( { } ) the page and line or paragraph after each limitation where the limitation is described in the specification as filed. If

there is a drawing or amino acid or nucleotide material sequence, and at least one limitation is illustrated in a drawing or amino acid or nucleotide material sequence, the "claims support and drawing analysis section" in the appendix shall also contain in boldface between the same braces ( { } ) where each limitation is shown in the drawings or sequence.

(s) *Means or step plus function analysis section.* For each independent claim involved in the appeal and each dependent claim argued separately (see paragraph (o)(1) of this section) having a limitation that appellant regards as a means or step plus function limitation in the form permitted by the sixth paragraph of 35 U.S.C. 112, for each such limitation, the "means or step plus function analysis section" in the appendix shall consist of an annotated copy of the claim (and, if necessary, any claim from which the claim argued separately depends) indicating in boldface between braces ( { } ) the page and line of the specification and the drawing figure and element numeral that describes the structure, material or acts corresponding to each claimed function.

(t) *Evidence section.* The "evidence section" shall contain only papers which have been entered by the examiner. The evidence section shall include:

(1) *Contents.* A table of contents.

(2) [Reserved.]

(3) [Reserved.]

(4) [Reserved.]

(5) *Affidavits and declarations.*

Affidavits and declarations, if any, and attachments to declarations, before the examiner and which are relied upon by appellant in the appeal. An affidavit or declaration otherwise mentioned in the appeal brief which does not appear in the evidence section will not be considered.

(6) *Other evidence filed prior to the notice of appeal.* Other evidence, if any, before the examiner and filed prior to the date of the notice of appeal and relied upon by appellant in the appeal. Other evidence filed before the notice of appeal that is otherwise mentioned in the appeal brief and which does not appear in the evidence section will not be considered.

(7) *Other evidence filed after the notice of appeal.* Other evidence relied upon by the appellant in the appeal and admitted into the file pursuant to § 41.33(d) of this subpart. Other evidence filed after the notice of appeal that is otherwise mentioned in the appeal brief and which does not appear in the evidence section will not be considered.

(u) *Related cases section.* The "related cases section" shall consist of copies of orders and opinions required to be cited pursuant to paragraph (g) of this section.

(v) *Appeal brief format requirements.* An appeal brief shall comply with § 1.52 of this title and the following additional requirements:

(1) *Page and line numbering.* The pages of the appeal brief, including all sections in the appendix, shall be consecutively numbered using Arabic numerals beginning with the first page of the appeal brief, which shall be numbered page 1. If the appellant chooses to number the lines, line numbering may be within the left margin.

(2) *Double spacing.* Double spacing shall be used except in headings, tables of contents, tables of authorities, signature blocks, and certificates of service. Block quotations must be indented and can be one and one half or double spaced.

(3) [Reserved.]

(4) *Font.* The font size shall be 14 point, including the font for block quotations and footnotes.

(5) *Length of appeal brief.* An appeal brief may not exceed 30 pages, excluding any statement of the real party in interest, statement of related cases, jurisdictional statement, table of contents, table of authorities, status of amendments, signature block, and appendix. An appeal brief may not incorporate another paper by reference. A request to exceed the page limit shall be made by petition under § 41.3 filed at least ten calendar days prior to the date the appeal brief is due.

(6) *Signature block.* The signature block must identify the appellant or appellant's representative, as appropriate, and a registration number, a correspondence address, a telephone number, a fax number and an e-mail address.

■ 10. Revise § 41.39 to read as follows:

**§ 41.39 Examiner's answer.**

(a) *Answer.* If the examiner determines that the appeal should go forward, then within such time and manner as may be established by the Director the examiner shall enter an examiner's answer responding to the appeal brief.

(b) *No new ground of rejection.* An examiner's answer shall not include a new ground of rejection.

■ 11. Revise § 41.41 to read as follows:

**§ 41.41 Reply brief.**

(a) *Reply brief authorized.* An appellant may file a single reply brief responding to the points made in the examiner's answer.

(b) *Time for filing reply brief.* If the appellant elects to file a reply brief, the reply brief must be filed within two months of the date of the mailing of the examiner's answer.

(c) *Extension of time to file reply brief.* A request for an extension of time to file a reply brief shall be presented as a petition under § 41.3 of this part.

(d) *Content of reply brief.* Except as otherwise set out in this section, the form and content of a reply brief are governed by the requirements for an appeal brief as set out in § 41.37 of this subpart. A reply brief may not exceed 20 pages, excluding any table of contents, table of authorities, and signature block, required by this section. A request to exceed the page limit shall be made by petition under § 41.3 of this part and filed at least ten calendar days before the reply brief is due. A reply brief must contain, under appropriate headings and in the order indicated, the following items:

(1) Table of contents—see § 41.37(i) of this subpart.

(2) Table of authorities—see § 41.37(j) of this subpart.

(3) [Reserved.]

(4) Statement of additional facts—see paragraph (f) of this section.

(5) Argument—see paragraph (g) of this section.

(e) [Reserved.]

(f) *Statement of additional facts.* The "statement of additional facts" shall consist of a statement of the additional facts that appellant believes are necessary to address the points raised in the examiner's answer and, as to each fact, must identify the point raised in the examiner's answer to which the fact relates.

(g) *Argument.* Any arguments raised in the reply brief which are not responsive to points made in the examiner's answer will not be considered and will be treated as waived.

(h) [Reserved.]

(i) *No amendment or new evidence.* No amendment or new evidence may accompany a reply brief.

#### § 41.43 [Removed]

■ 12. Remove § 41.43.

■ 13. Revise § 41.47 to read as follows:

#### § 41.47 Oral hearing.

(a) *Request for oral hearing.* If appellant desires an oral hearing, appellant must file, as a separate paper, a written request captioned:

"REQUEST FOR ORAL HEARING".

(b) *Fee.* A request for oral hearing shall be accompanied by the fee required by § 41.20(b)(3) of this part.

(c) *Time for filing request for oral hearing.* Appellant must file a request

for oral hearing within two months from the date of the examiner's answer.

(d) *Extension of time to file request for oral hearing.* A request for an extension of time shall be presented as a petition under § 41.3 of this part.

(e) *Date for oral hearing.* If an oral hearing is properly requested, the Board shall set a date for the oral hearing.

(f) *Confirmation of oral hearing.* Within such time as may be ordered by the Board, appellant shall confirm attendance at the oral hearing. Failure to timely confirm attendance will be taken as a waiver of any request for an oral hearing.

(g) *List of terms.* At the time appellant confirms attendance at the oral hearing, appellant shall supply a list of technical terms and other unusual words which can be provided to any individual transcribing an oral hearing.

(h) *Length of argument.* Unless otherwise ordered by the Board, argument on behalf of appellant shall be limited to 20 minutes.

(i) *Oral hearing limited to Record.* At oral hearing only the Record will be considered. No additional evidence may be offered to the Board in support of the appeal. Any argument not presented in a brief cannot be raised at an oral hearing.

(j) *Recent legal development.* Notwithstanding paragraph (i) of this section, an appellant or the examiner may rely on and call the Board's attention to a recent court or Board opinion which could have an effect on the manner in which the appeal is decided.

(k) *Visual aids.* Visual aids may be used at an oral hearing, but must be limited to documents or artifacts in the Record or a model or an exhibit presented for demonstration purposes during an interview with the examiner. At the oral hearing, appellant shall provide one copy of each visual aid (photograph in the case of an artifact, a model or an exhibit) for each judge and one copy to be added to the Record.

(l) *Failure to attend oral hearing.* Failure of an appellant to attend an oral hearing will be treated as a waiver of oral hearing.

■ 14. Revise § 41.50 to read as follows:

#### § 41.50 Decisions and other actions by the Board.

(a) *Affirmance and reversal.* The Board may affirm or reverse an examiner's rejection in whole or in part. Affirmance of a rejection of a claim constitutes a general affirmance of the decision of the examiner on that claim, except as to any rejection specifically reversed.

(b) *Remand.* The Board may remand an application to the examiner. In response to a remand for further consideration of a rejection, the examiner enters an examiner's answer, within two months the appellant shall exercise one of the following two options to avoid abandonment of the application or termination of a reexamination proceeding:

(1) *Request to reopen prosecution.* Request that prosecution be reopened before the examiner by filing a reply under § 1.111 of this title with or without amendment or submission of evidence. Any amendment or evidence must be responsive to the remand or issues discussed in the examiner's answer. A request that complies with this paragraph will be entered and the application or patent under reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. A request under this paragraph will be treated as a request to dismiss the appeal.

(2) *Request to re-docket the appeal.* The appellant may request that the Board re-docket the appeal (see § 41.35(a) of this subpart) and file a reply brief as set forth in § 41.41 of this subpart. A reply brief may not be accompanied by any amendment or evidence. A reply brief which is accompanied by an amendment or evidence will be treated as a request to reopen prosecution pursuant to paragraph (b)(1) of this section.

(c) *Remand not final action.* Whenever a decision of the Board includes a remand, the decision shall not be considered a final decision of the Board. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board may enter an order making its decision final.

(d) *New ground of rejection.* Should the Board have a basis not involved in the appeal for rejecting any pending claim, it may enter a new ground of rejection. A new ground of rejection shall be considered an interlocutory order and shall not be considered a final decision. If the Board enters a new ground of rejection, within two months appellant must exercise one of the following two options with respect to the new ground of rejection to avoid dismissal of the appeal as to any claim subject to the new ground of rejection:

(1) *Reopen prosecution.* Submit an amendment of the claims subject to a new ground of rejection or new evidence relating to the new ground of rejection or both, and request that the matter be reconsidered by the examiner. The application or reexamination proceeding on appeal will be remanded to the examiner. A new ground of



rejection by the Board is binding on the examiner unless, in the opinion of the examiner, the amendment or new evidence overcomes the new ground of rejection. In the event the examiner maintains the new ground of rejection, appellant may again appeal to the Board.

(2) *Request for rehearing.* Submit a request for rehearing pursuant to § 41.52 of this subpart relying on the Record.

(e) *Recommendation.* In its opinion in support of its decision, the Board may include a recommendation, explicitly designated as such, of how a claim on appeal may be amended to overcome a specific rejection. When the Board makes a recommendation, appellant may file an amendment or take other action consistent with the recommendation. An amendment or other action, otherwise complying with statutory patentability requirements, will overcome the specific rejection. An examiner, however, upon return of the application or reexamination proceeding to the jurisdiction of the examiner, may enter a new ground of rejection of a claim amended in conformity with a recommendation, when appropriate.

(f) *Request for briefing and information.* The Board may enter an order requiring appellant to brief matters or supply information or both that the Board believes would assist in deciding the appeal. Appellant will be given a non-extendable time period within which to respond to the order. Failure of appellant to timely respond to the order may result in dismissal of the appeal in whole or in part.

(g) *Extension of time to take action.* A request for an extension of time to respond to a request for briefing and information under paragraph (f) of this section is not authorized. A request for an extension of time to respond to Board action under paragraphs (b) and (d) of this section shall be presented as a petition under § 41.3 of this part.

■ 15. Revise § 41.52 to read as follows:

**§ 41.52 Rehearing.**

(a) *Request for rehearing authorized.* An appellant may file a single request for rehearing.

(b) *Time for filing request for rehearing.* Any request for rehearing must be filed within two months from the date of the decision mailed by the Board.

(c) *Extension of time to file request for rehearing.* A request for an extension of

time shall be presented as a petition under § 41.3 of this part.

(d) *Content of request for rehearing.* The form of a request for rehearing is governed by the requirements of § 41.37(v) of this subpart, except that a request for rehearing may not exceed 10 pages, excluding any table of contents, table of authorities, and signature block. A request to exceed the page limit shall be made by petition under § 41.3 at least ten calendar days before the request for rehearing is due. A request for rehearing must contain, under appropriate headings and in the order indicated, the following items:

(1) Table of contents—*see* § 41.37(i) of this subpart.

(2) Table of authorities—*see* § 41.37(j) of this subpart.

(3) [Reserved.]

(4) Argument—*see* paragraph (f) of this section.

(e) [Reserved.]

(f) *Argument.* A request for rehearing shall state with particularity the points believed to have been misapprehended or overlooked by the Board. In filing a request for rehearing, the argument shall adhere to the following format: “On page x, lines y-z of the Board’s opinion, the Board states that (set out what was stated). The point misapprehended or overlooked was made to the Board in (identify paper, page and line where argument was made to the Board) or the point was first made in the opinion of the Board. The response is (state response).” As part of each response, appellant shall refer to the page number and line or drawing number of a document in the Record. A general restatement of the case will not be considered an argument that the Board has misapprehended or overlooked a point. A new argument cannot be made in a request for rehearing, except:

(1) *New ground of rejection.* Appellant may respond to a new ground of rejection entered pursuant to § 41.50(d)(2) of this subpart.

(2) *Recent legal development.* Appellant may rely on and call the Board’s attention to a recent court or Board opinion which is relevant to an issue decided in the appeal.

(g) *No amendment or new evidence.* No amendment or new evidence may accompany a request for rehearing.

(h) *Decision on rehearing.* A decision will be rendered on a request for rehearing. The decision on rehearing is deemed to incorporate the underlying

decision sought to be reheard except for those portions of the underlying decision specifically modified on rehearing. A decision on rehearing is final for purposes of judicial review, except when otherwise noted in the decision on rehearing.

■ 16. Revise § 41.54 to read as follows:

**§ 41.54 Action following decision.**

After a decision by the Board and subject to appellant’s right to seek judicial review, the application or reexamination proceeding will be returned to the jurisdiction of the examiner for such further action as may be appropriate consistent with the decision by the Board.

■ 17. Add § 41.56 to read as follows:

**§ 41.56 Sanctions.**

(a) *Imposition of sanctions.* The Chief Administrative Patent Judge or an expanded panel of the Board may impose a sanction against an appellant for misconduct, including:

(1) Failure to comply with an order entered in the appeal or an applicable rule.

(2) Advancing or maintaining a misleading or frivolous request for relief or argument.

(3) Engaging in dilatory tactics.

(b) *Nature of sanction.* Sanctions may include entry of:

(1) An order declining to enter a docket notice.

(2) An order holding certain facts to have been established in the appeal.

(3) An order expunging a paper or precluding an appellant from filing a paper.

(4) An order precluding an appellant from presenting or contesting a particular issue.

(5) An order excluding evidence.

(6) [Reserved.]

(7) An order holding an application on appeal to be abandoned or a reexamination proceeding terminated.

(8) An order dismissing an appeal.

(9) An order denying an oral hearing.

(10) An order terminating an oral hearing.

Dated: May 29, 2008.

**Jon W. Dudas,**

*Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.*

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