

Chapter 1200 Appeal

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1201 Introduction [R-3]

The United States Patent and Trademark Office (Office) in administering the Patent Laws makes many decisions of a *>substantive< nature which the applicant may feel deny him or her the patent protection to which he or she is entitled. The differences of opinion on such matters can be justly resolved only by prescribing and following judicial procedures. Where the differences of opinion concern the denial of patent claims because of prior art or **>other patentability issues<, the questions thereby raised are said to relate to the merits, and appeal procedure within the Office and to the courts has long been provided by statute >(35 U.S.C. 134)<.

The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the **>Director of the U.S. Patent and Trademark Office (Director)< should be carefully observed. The Board will not ordinarily hear a question **>that< should be decided by the *>Director on petition<, and the *>Director< will not ordinarily entertain a petition where the question presented is **>a matter appealable to the Board<. However, since 37 CFR 1.181(f) states that any petition not filed within 2 months from the action complained of may be dismissed as untimely and since 37 CFR 1.144 states that petitions from restriction requirements must be filed no later than appeal, petitionable matters will rarely be present in a case by the time it is before the Board for a decision. *In re Watkinson*, 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990).

>This chapter is primarily directed to *ex parte* appeals. For appeals in *inter partes* reexamination proceedings, see 37 CFR 41.60 to 41.81 and MPEP § 2674 to § 2683.<

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1202 < Composition of Board [R-3]

35 U.S.C. 6 provides for a Board of Patent Appeals and Interferences as follows:

35 U.S.C. 6. *Board of Patent Appeals and Interferences.*

**>

(a) ESTABLISHMENT AND COMPOSITION.— There shall be in the United States Patent and Trademark Office a Board of Patent Appeals and Interferences. The Director, the Deputy Commissioner, the Commissioner for Patents, the Commissioner for Trademarks, and the administrative patent judges shall constitute the Board. The administrative patent judges shall be persons of competent legal knowledge and scientific ability who are appointed by the Director.<

(b) DUTIES.— The Board of Patent Appeals and Interferences shall, on written appeal of an applicant, review adverse decisions of examiners upon applications for patents and shall determine priority and patentability of invention in interferences declared under section 135(a). Each appeal and interference shall be heard by at least three members of the Board, who shall be designated by the Director. Only the Board of Patent Appeals and Interferences may grant rehearings.

**>The Office interprets the amendment to 35 U.S.C. 6(a) in Pub. L. 107-273, sec. 13203(a), “Deputy Commissioner” to refer to the Deputy Director. As provided by 37 CFR 41.2, “Board” means the Board of Patent Appeals and Interferences and includes:

(A) For a final Board action:

(1) In an appeal or contested case, a panel of the Board;

(2) In a proceeding under 37 CFR 41.3, the Chief Administrative Patent Judge or another official acting under an express delegation from the Chief Administrative Patent Judge.

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

“Board member” means the Under Secretary of Commerce for Intellectual Property and Director of the U.S. Patent and Trademark Office, the Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the U.S. Patent and Trademark Office, the Commissioner for Patents, the Commissioner for Trademarks, and the administrative patent judges.<

1203 Administrative Handling [R-8]

Ex parte appeals to the Board, and *>documents< relating thereto filed prior to a docketing notice from the Board, are forwarded to the **>Patent Appeal Center< for processing. Appeal *>documents<, such as the notice of appeal, appeal brief, and request for extension of time to file the brief, are processed by the **>Patent Appeal Center<.

>The Patent Appeal Center will review notices of appeal, pre-appeal brief requests for review, examiner’s answers and reply brief acknowledgements. In addition, the Patent Appeal Center will notify appellant of any defect in a notice of appeal or pre-appeal brief request for review. The Patent Appeal Center will also return the application to the examiner for corrections when appropriate (e.g., an examiner’s answer that contains a new ground of rejection was not signed by the Technology Center (TC) Director or a reply brief was not acknowledged by the examiner).<

If the brief is not filed within the time designated by 37 CFR 41.37, the applicant will be notified that the appeal stands dismissed.

The Board’s docketing procedure is designed to provide notification to the appellant within one month of receipt of an appealed application at the Board that (A) the appeal has been received at the Board and docketed, or (B) the appeal is being returned to the examiner for attention to unresolved matters.

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If the appeal is ready for docketing (that is, if no return of the case to the examiner is required per the review) three events will occur:

(A) an appeal number will be assigned;

(B) the Board will issue a docketing notice, identifying the relevant appeal contents (brief, reply brief if any, request for oral hearing if any, and the filing date of each such item); and

(C) the appeal will be assigned to a master docket for subsequent reassignment to the docket of an individual Administrative Patent Judge (APJ), or directly to the docket of an individual APJ.

If the appeal cannot be docketed due to matters requiring further attention in the patent examining corps, the appeal will be administratively returned to the patent examining corps with an order indicating why the appeal cannot be docketed and notification of that return, in the form of a copy of the order, will be mailed to the appellant. No appeal number will be assigned until the appeal is ready for docketing.

The docketing notice or order indicating why the appeal cannot be docketed will provide the appellant and the examiner with notification that the appeal is: (A) at the Board in condition for referral to a panel; or (B) that the appeal is being returned to the patent

examining corps to resolve matters requiring attention prior to decision of the appeal. Thus, the appellant will know to which organization to look for the next communication in the appealed application.

“SPECIAL CASE”

Subject alone to diligent prosecution by the applicant, an application for patent that once has been made special and advanced out of turn by the United States Patent and Trademark Office (Office) for examination will continue to be special throughout its entire course of prosecution in the Office, including appeal, if any, to the Board. See MPEP § 708.02.

A petition to make an application special after the appeal has been forwarded to the Board may be addressed to the Board. However, no such petition will be granted unless the brief has been filed and applicant has made the same type of showing required by the Director under 37 CFR 1.102. Therefore, diligent prosecution is essential to a favorable decision on a petition to make special.

1204 Notice of Appeal [R-8]

35 U.S.C. 134. Appeal to the Board of Patent Appeals and Interferences.

(a) **PATENT APPLICANT.**— An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.

(b) **PATENT OWNER.**— A patent owner in any reexamination proceeding may appeal from the final rejection of any claim by the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.

(c) **THIRD-PARTY.**— A third-party requester in an inter partes proceeding may appeal to the Board of Patent Appeals and Interferences from the final decision of the primary examiner favorable to the patentability of any original or proposed amended or new claim of a patent, having once paid the fee for such appeal.

35 U.S.C. 41. Patent fees; patent and trademark search systems

(a) **GENERAL FEES.** — The Director shall charge the following fees:

(6) **APPEAL FEES.** —

(A) On filing an appeal from the examiner to the Board of Patent Appeals and Interferences, \$500.

(B) In addition, on filing a brief in support of the appeal, \$500, and on requesting an oral hearing in the appeal before the Board of Patent Appeals and Interferences, \$1,000.

37 CFR 41.31. Appeal to Board.

(a) *Who may appeal and how to file an appeal.* (1) Every applicant, any of whose claims has been twice rejected, may appeal from the decision of the examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § 41.20(b)(1) within the time period provided under § 1.134 of this title for reply.

(2) Every owner of a patent under *ex parte* reexamination filed under § 1.510 of this title before November 29, 1999, any of whose claims has been twice rejected, may appeal from the decision of the examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § 41.20(b)(1) within the time period provided under § 1.134 of this title for reply.

(3) Every owner of a patent under *ex parte* reexamination filed under § 1.510 of this title on or after November 29, 1999, any of whose claims has been finally (§ 1.113 of this title) rejected, may appeal from the decision of the examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § 41.20(b)(1) within the time period provided under § 1.134 of this title for reply.

(b) The signature requirement of § 1.33 of this title does not apply to a notice of appeal filed under this section.

(c) An appeal, when taken, must be taken from the rejection of all claims under rejection which the applicant or owner proposes to contest. Questions relating to matters not affecting the merits of the invention may be required to be settled before an appeal can be considered.

(d) The time periods set forth in paragraphs (a)(1) through (a)(3) of this section are extendable under the provisions of § 1.136 of this title for patent applications and § 1.550(c) of this title for *ex parte* reexamination proceedings.

I. APPEAL BY PATENT APPLICANT

Under 37 CFR 41.31(a)(1), an applicant for a patent dissatisfied with the primary examiner's decision in the second rejection of his or her claims may appeal to the Board for review of the examiner's rejection by filing a notice of appeal and the required fee set forth in 37 CFR 41.20(b)(1) within the time period provided under 37 CFR 1.134 and 1.136. A notice of appeal may be filed after any of the claims has been twice rejected, regardless of whether the claim(s) has/have been finally rejected. The limitation of “twice rejected” does not have to be related to a particular application. *See Ex Parte Lemoine*, 46 USPQ2d 1420, 1423 (Bd. Pat. App. & Inter. 1994) (“so long as the applicant has twice been denied a patent, an appeal may be filed”). For example, if any claim was rejected in a parent application, and the claim is again rejected in a continuing application, then applicant can choose to file an appeal in the continuing application, even if the claim was rejected only once in the continuing application. Applicant cannot file an

appeal in a continuing application, or after filing a request for continued examination (RCE) under 37 CFR 1.114, until the application is under a rejection. Accordingly, applicant cannot file a notice of appeal with an RCE regardless of whether the application has been twice rejected prior to the filing of the RCE.

Although the rules do not require that the notice of appeal identify the rejected claim(s) appealed, or be signed, applicants may file notices of appeal which identify the appealed claims and are signed. It should be noted that the elimination of the requirement to sign a notice of appeal does not affect the requirements for other papers (such as an amendment under 37 CFR 1.116) submitted with the notice, or for other actions contained within the notice, e.g., an authorization to charge fees to a deposit account or to a credit card, to be signed. See MPEP § 509. Thus, failure to sign the notice of appeal may have unintended adverse consequences; for example, if an unsigned notice of appeal contains an (unsigned) authorization to charge the notice of appeal fee to a deposit account, the notice of appeal will be unacceptable because the notice of appeal fee is lacking.

The notice of appeal must be filed within the period for reply set in the last Office action, which is normally 3 months for applications. See MPEP § 714.13. For example, failure to remove all grounds of rejection and otherwise place an application in condition for allowance or to file an appeal after final rejection will result in the application becoming abandoned, even if one or more claims have been allowed, except where claims suggested for interference have been copied. The notice of appeal and appropriate fee may be filed up to 6 months from the date of the Office action (e.g., a final rejection) from which the appeal was taken, so long as an appropriate petition and fee for an extension of time under 37 CFR 1.136(a) is filed either prior to or with the notice of appeal.

The use of a separate letter containing the notice of appeal is strongly recommended. Form PTO/SB/31 may be used for filing a notice of appeal. Appellant must file an appeal brief in compliance with 37 CFR 41.37 accompanied by the fee set forth in 37 CFR 41.20(b)(2) within two months from the date of filing the notice of appeal. See MPEP § 1205.

II. APPEAL BY PATENT OWNER

37 CFR 41.31(a)(2) and (a)(3) provides for appeal to the Board by the patent owner from any decision in an *ex parte* reexamination proceeding adverse to patentability, in accordance with 35 U.S.C. 306 and 35 U.S.C. 134. See also MPEP § 2273.

In an *ex parte* reexamination filed before November 29, 1999, the patent owner may appeal to the Board after the second rejection of the claims.

In an *ex parte* reexamination filed on or after November 29, 1999, the patent owner may appeal to the Board only after the final rejection of one or more claims in the particular reexamination proceeding for which appeal is sought.

The fee for filing the notice of appeal by a patent owner is set forth in 37 CFR 41.20(b)(1), and the time period to pay the fee is determined as provided in 37 CFR 1.134 and 37 CFR 1.550(c).

Failure to file an appeal in an *ex parte* reexamination proceeding will result in issuance of the reexamination certificate under 37 CFR 1.570.

Appeals to the Board of Patent Appeals and Interferences in *inter partes* reexamination proceedings filed under 35 U.S.C. 311 are governed by 37 CFR 41.60 through 41.81. 37 CFR 41.30 through 41.54 are not applicable to appeals in *inter partes* reexamination proceedings. See MPEP § 2674 to § 2683 for appeals in *inter partes* reexamination proceedings.

The use of a separate letter containing the notice of appeal is strongly recommended. Form PTO/SB/31 may be used for filing a notice of appeal.

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<small>PTO/SB/31 (07-09) Approved for use through 07/31/2012. OMB 0651-0031 U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE</small>									
<small>Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.</small>									
NOTICE OF APPEAL FROM THE EXAMINER TO THE BOARD OF PATENT APPEALS AND INTERFERENCES									
Docket Number (Optional) _____									
<small>I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____</small>	In re Application of _____								
	Application Number _____ Filed _____								
	For _____								
	Art Unit _____ Examiner _____								
<p>Applicant hereby appeals to the Board of Patent Appeals and Interferences from the last decision of the examiner.</p> <p>The fee for this Notice of Appeal is (37 CFR 41.20(b)(1)) \$ _____</p> <p><input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by half, and the resulting fee is: \$ _____</p> <p><input type="checkbox"/> A check in the amount of the fee is enclosed.</p> <p><input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.</p> <p><input type="checkbox"/> The Director has already been authorized to charge fees in this application to a Deposit Account.</p> <p><input type="checkbox"/> The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. _____.</p> <p><input type="checkbox"/> A petition for an extension of time under 37 CFR 1.136(a) (PTO/SB/22) is enclosed.</p> <p>WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.</p> <p>I am the</p> <table style="width: 100%; border: none;"><tr><td style="width: 50%; vertical-align: top;"><input type="checkbox"/> applicant/inventor.</td><td style="width: 50%; border-bottom: 1px solid black; text-align: center;">Signature</td></tr><tr><td style="vertical-align: top;"><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td style="border-bottom: 1px solid black; text-align: center;">Typed or printed name</td></tr><tr><td style="vertical-align: top;"><input type="checkbox"/> attorney or agent of record. Registration number _____</td><td style="border-bottom: 1px solid black; text-align: center;">Telephone number</td></tr><tr><td style="vertical-align: top;"><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</td><td style="border-bottom: 1px solid black; text-align: center;">Date</td></tr></table> <p><small>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</small></p>		<input type="checkbox"/> applicant/inventor.	Signature	<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	Typed or printed name	<input type="checkbox"/> attorney or agent of record. Registration number _____	Telephone number	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____	Date
<input type="checkbox"/> applicant/inventor.	Signature								
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	Typed or printed name								
<input type="checkbox"/> attorney or agent of record. Registration number _____	Telephone number								
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____	Date								
<input type="checkbox"/> *Total of _____ forms are submitted.									

This collection of information is required by 37 CFR 41.31. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

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III. ACKNOWLEDGEMENT

The Office does not acknowledge receipt of a notice of appeal by separate letter. However, if a self-addressed postcard is included with the notice of appeal, it will be date stamped and mailed.

Appellant may also check the status of the application and the receipt date of the notice of appeal on the Office's Patent Application Information Retrieval (PAIR) system via the Internet.

IV. DEFECTIVE NOTICE OF APPEAL

If a notice of appeal is defective, the Office will notify the applicant of the non-compliance. A notice of appeal is not a proper reply to the last Office action if none of the claims in the application has been twice

rejected. A notice of appeal is defective if it was not timely filed within the time period set forth in the last Office action, or the notice of appeal fee set forth in 37 CFR 41.20(b)(1) was not timely filed. Form PTOL-461 (Rev. 9-04 or later), Communication Re: Appeal, should be used to indicate defects in a notice of appeal.

When appellant files an appeal brief without filing a notice of appeal first, the Office should treat the appeal brief as a notice of appeal and an appeal brief. For this situation, appellant must file the brief within the time period for reply set forth in the last Office action and the fees under 37 CFR 41.20(b)(1) and (b)(2) for filing a notice of appeal and an appeal brief in compliance with 37 CFR 41.31 and 41.37.

Communication Re: Appeal	Application No.	Applicant(s)	
	Examiner	Art Unit	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

1. ☐ The Notice of Appeal filed on _____ is not acceptable because:

- (a) ☐ it was not timely filed.
- (b) ☐ the statutory fee for filing the appeal was not submitted. See 37 CFR 41.20(b)(1).
- (c) ☐ the appeal fee received on _____ was not timely filed.
- (d) ☐ the submitted fee of \$_____ is insufficient. The appeal fee required by 37 CFR 41.20(b)(1) is \$_____.
- (e) ☐ the appeal is not in compliance with 37 CFR 41.31(a)(1) in that no claim has been twice rejected.
- (f) ☐ a Notice of Allowability, PTO-37, was mailed by the Office on _____.

2. ☐ The appeal brief filed on _____ is NOT acceptable for the reason(s) indicated below:

- (a) ☐ the brief and/or brief fee is untimely. See 37 CFR 41.37(a).
- (b) ☐ the statutory fee for filing the brief has not been submitted. See 37 CFR 41.20(b)(2).
- (c) ☐ the submitted brief fee of \$_____ is insufficient. The brief fee required by 37 CFR 41.20(b)(2) is \$_____.

The appeal in this application will be dismissed unless corrective action is taken to timely submit the brief and requisite fee. See 37 CFR 41.37(a)(1). Extensions of time may be obtained under 37 CFR 1.136(a). See 37 CFR 41.37(e).

3. ☐ The appeal in this application is DISMISSED because:

- (a) ☐ the statutory fee for filing the brief as required under 37 CFR 41.20(b)(2) was not timely submitted and the period for obtaining an extension of time to file the brief under 37 CFR 1.136(a) has expired.
- (b) ☐ the brief was not timely filed and the period for obtaining an extension of time to file the brief under 37 CFR 1.136(a) has expired.
- (c) ☐ a Request for Continued Examination (RCE) under 37 CFR 1.114 was filed on _____.
- (d) ☐ other: _____.

4. ☐ Because of the dismissal of the appeal, this application:

- (a) ☐ is abandoned because there are no allowed claims.
- (b) ☐ is before the examiner for final disposition because it contains allowed claims. Prosecution on the merits remains CLOSED.
- (c) ☐ is before the examiner for consideration.

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1204.01 Reinstatement of Appeal [R-3]

If an appellant wishes to reinstate an appeal after prosecution is reopened, appellant must file a new notice of appeal in compliance with 37 CFR 41.31 and a complete new appeal brief in compliance with 37 CFR 41.37. Any previously paid appeal fees set forth in 37 CFR 41.20 for filing a notice of appeal, filing an appeal brief, and requesting an oral hearing (if applicable) will be applied to the new appeal on the same application as long as a final Board decision has not been made on the prior appeal. If, however, the appeal fees have increased since they were previously paid, then appellant must pay the difference between the current fee(s) and the amount previously paid. Appellant must file a complete new appeal brief in compliance with the format and content requirements of 37 CFR 41.37(c) within two months from the date of filing the new notice of appeal. See MPEP § 1205.<

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1205 < Appeal Brief [R-3]

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37 CFR 41.37. Appeal brief.

(a)(1)Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

(2) The brief must be accompanied by the fee set forth in § 41.20(b)(2)

(b) On failure to file the brief, accompanied by the requisite fee, within the period specified in paragraph (a) of this section, the appeal will stand dismissed.

(c)(1)The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(i) *Real party in interest.* A statement identifying by name the real party in interest.

(ii) *Related appeals and interferences.* A statement identifying by application, patent, appeal or interference number all other prior and pending appeals, interferences or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. Copies of any decisions rendered by a court or the Board in any proceeding identified under this paragraph must be included in an appendix as required by paragraph (c)(1)(x) of this section.

(iii) *Status of claims.* A statement of the status of all the claims in the proceeding (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled) and an identification of those claims that are being appealed.

(iv) *Status of amendments.* A statement of the status of any amendment filed subsequent to final rejection.

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

(vi) *Grounds of rejection to be reviewed on appeal.* A concise statement of each ground of rejection presented for review.

(vii) *Argument.* The contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown. Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

(viii) *Claims appendix.* An appendix containing a copy of the claims involved in the appeal.

(ix) *Evidence appendix.* An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the

evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) *Related proceedings appendix*. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

(e) The time periods set forth in this section are extendable under the provisions of § 1.136 of this title for patent applications and § 1.550(c) of this title for ex parte reexamination proceedings.<

1205.01 Time for Filing Appeal Brief [R-8]

37 CFR 41.37(a) provides 2 months from the date of the notice of appeal for the appellant to file an appeal brief and the appeal brief fee set forth in 37 CFR 41.20(b)(2). In an *ex parte* reexamination proceeding, the time period can be extended only under the provisions of 37 CFR 1.550(c). See also MPEP § 2274.

The usual period of time in which appellant must file his or her brief is 2 months from the date of appeal. The Office date of receipt of the notice of appeal (and not the date indicated on any Certificate of Mailing under 37 CFR 1.8) is the date from which this 2-month time period is measured. See MPEP § 512. If the notice of appeal is filed in accordance with 37 CFR 1.10 using the “Express Mail Post Office to Addressee” service of the United States Postal Service (USPS), the date of deposit with the USPS is the date from which this 2-month time period is measured because the date of deposit shown by the “date in” on the “Express Mail” label or other official USPS notation is considered to be the date of receipt. See MPEP § 513.

37 CFR 41.37(a) does not permit the brief to be filed within the time allowed for reply to the action

from which the appeal was taken even if such time is later. Once appellant timely files a notice of appeal in compliance with 37 CFR 41.31, the time period for reply set forth in the last Office action is tolled and is no longer relevant for the time period for filing an appeal brief. For example, if appellant filed a notice of appeal within one month from the mailing of a final Office action which sets forth a 3-month shortened statutory period for reply, and then the appellant filed an appeal brief after 2 months from the filing date of the notice of appeal but within 3 months from the mailing of the final action, a petition for an extension of time for one month would be required. Similarly, if the appellant files an amendment or a request for continued examination (RCE) under 37 CFR 1.114, instead of an appeal brief, after 2 months from the filing date of the notice of appeal but within 3 months from the mailing of the final action, the petition for an extension of time would be required.

This 2-month time period for a patent application may be extended under 37 CFR 1.136(a), and if 37 CFR 1.136(a) is not available, under 37 CFR 1.136(b) for extraordinary circumstances.

In the event that the appellant finds that he or she is unable to file a brief within the time period allotted by the rule, he or she may file a petition, with fee, to the Technology Center (TC), requesting additional time under 37 CFR 1.136(a). Additional time in excess of 5 months will not be granted unless extraordinary circumstances are involved under 37 CFR 1.136(b). The time extended is added to the calendar day of the original period, as opposed to being added to the day it would have been due when said last day is a Saturday, Sunday, or Federal holiday.

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¶ 12.110 Extension To File Brief - Granted

The request for an extension of time under 37 CFR 1.136(b) for filing the appeal brief under 37 CFR 41.37 filed on [1] has been **approved** for [2].

Examiner Note:

1. In bracket 2, insert the amount of time the extension of time has been approved for.
2. This form paragraph should only be used when 37 CFR 1.136(a) is not available or has been exhausted, such as in litigation reissues or when appellant requests to reopen prosecution or file a reply brief as set forth in 37 CFR 41.39(b) and 41.50(a)(2).

¶ 12.111 Extension To File Brief - Denied

The request for an extension of time under 37 CFR 1.136(b) for filing the appeal brief under 37 CFR 41.37 filed on [1] has been

disapproved because no sufficient cause for the extension has been shown.

Examiner Note:

This form paragraph should only be used when 37 CFR 1.136(a) is not available or has been exhausted, such as in litigation reissues or when appellant requests to reopen prosecution or file a reply brief as set forth in 37 CFR 41.39(b) and 41.50(a)(2).

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When an application is revived after abandonment for failure on the part of the appellant to take appropriate action after final rejection, and the petition to revive was accompanied by a notice of appeal, appellant has 2 months, from the mailing date of the Director's affirmative decision on the petition, in which to file the appeal brief. The time period for filing the appeal brief may be extended under 37 CFR 1.136.

FAILURE TO TIMELY FILE AN APPEAL BRIEF

With the exception of a declaration of an interference or suggestion of claims for an interference and timely copying of claims for an interference, the appeal ordinarily will be dismissed if the brief and the fee under 37 CFR 41.20(b)(2) are not filed within the period provided by 37 CFR 41.37(a) or within such additional time as may be properly extended.

A brief must be filed to preserve appellant's right to the appealed claims, notwithstanding circumstances such as:

(A) the possibility or imminence of an interference involving the subject application, but not resulting in withdrawal of the final rejection prior to the brief's due date;

(B) the filing of a petition to invoke the supervisory authority of the Director under 37 CFR 1.181;

(C) the filing of an amendment, even if it is one which the examiner previously has indicated may place one or more claims in condition for allowance, unless the examiner, in acting on the amendment, disposes of all issues on appeal;

(D) the receipt of a letter from the examiner stating that prosecution is suspended, without the examiner withdrawing the final rejection from which appeal has been taken or suggesting claims for an interference, and without an administrative patent judge declaring an interference with the subject application.

Although failure to file the brief and the required appeal brief fee within the permissible time will result in dismissal of the appeal, if any claims stand allowed, the application does not become abandoned by the dismissal, but is returned to the examiner for action on the allowed claims. See MPEP § 1215.04. If there are no allowed claims, the application is abandoned as of the date the brief was due. Claims which have been objected to as dependent from a rejected claim do not stand allowed. In a reexamination proceeding failure to file the brief will result in the issuance of the certificate under 37 CFR 1.570 or 1.997.

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¶ 12.109.01 Appeal Dismissed - Allowed Claims, Formal Matters Remaining

In view of applicant's failure to file a brief within the time prescribed by 37 CFR 41.37(a)(1), the appeal stands dismissed and the proceedings as to the rejected claims are considered terminated. See 37 CFR 1.197(b).

This application will be passed to issue on allowed claim [1] provided the following formal matters are corrected. Prosecution is otherwise closed.

[2]

Applicant is required to make the necessary corrections within a shortened statutory period set to expire ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this letter to avoid ABANDONMENT of the application. Extensions of time may be granted under 37 CFR 1.136.

Examiner Note:

1. This form paragraph should only be used if the formal matters cannot be handled by examiner's amendment. See MPEP § 1215.04.
2. In bracket 2, insert a description of the formal matters to be corrected.
3. Claims which have been indicated as containing allowable subject matter but are objected to as being dependent upon a rejected claim are to be considered as if they were rejected. See MPEP § 1215.04.

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If the time for filing a brief has passed and the application has consequently become abandoned, the applicant may petition to revive the application under 37 CFR 1.137, as in other cases of abandonment. See MPEP § 711.03(c). If the appeal is dismissed, but the application is not abandoned because there is at least one allowed claim, the applicant may file a petition to reinstate the claims and the appeal, but a showing equivalent to that in a petition to revive under 37 CFR 1.137 is required. See MPEP § 711.03(c). In addition to the petition and petition fee, appellant must file:

(A) A request for continued examination (RCE) under 37 CFR 1.114 accompanied by a submission (i.e., a reply under 37 CFR 1.111) and the fee as set forth in 37 CFR 1.17(e) if the application is a utility or plant application filed on or after June 8, 1995, or a continuing application under 37 CFR 1.53(b) (or a CPA under 37 CFR 1.53(d) if the application is a design application); or

(B) An appeal brief and the appeal brief fee to reinstate the appeal. A proper brief and the required fee must be filed before the petition will be considered on its merits.

Where the dismissal of the appeal is believed to be in error, filing a petition, pointing out the error, may be sufficient.

1205.02 Appeal Brief Content [R-8]

Only one copy of the appeal brief is required. Any brief filed on or after September 13, 2004 must comply with the requirements set forth in 37 CFR 41.37 and accompanied by the fee under 37 CFR 41.20(b)(2), unless the brief has a certificate of mailing date before September 13, 2004. Any brief filed (or that has a certificate of mailing date) before September 13, 2004 must comply with either the former 37 CFR 1.192 or 37 CFR 41.37. The brief, as well as every other document relating to an appeal, should indicate the number of the Technology Center (TC) to which the application or patent under reexamination is assigned and the application or reexamination control number.

An appellant's brief must be responsive to every ground of rejection stated by the examiner that the appellant is presenting for review in the appeal. If a ground of rejection stated by the examiner is not addressed in the appellant's brief, that ground of rejection will be summarily sustained by the Board.

Oral argument at a hearing will not remedy such deficiency of a brief. The fact that appellant may consider a ground to be clearly improper does not justify a failure to point out to the Board the reasons for that belief.

The mere filing of a document entitled as a brief will not necessarily be considered to be in compliance with 37 CFR 41.37(c). The rule requires that the brief must set forth the authorities and arguments relied upon. It is essential that the Board be provided with a brief fully stating the position of the appellant

with respect to each ground of rejection presented for review in the appeal so that no search of the record is required in order to determine that position. Thus, the brief should not incorporate or reference previous responses. 37 CFR 41.37(c)(1) requires that the brief contain specific items, as discussed below. The brief must have all of the required items under appropriate headings in the order indicated in 37 CFR 41.37(c)(1). The headings are required even when an item is not applicable (e.g., if there is no evidence being relied upon by appellant in the appeal, the brief is still required to have the heading "Evidence appendix."). When there is no information related to the particular section heading of the brief, the word "none" should be used under the heading. To assist appellants in complying with 37 CFR 41.37, the Board has posted checklists for notices of appeal and appeal briefs and a list of eight reasons appeal briefs have been previously held to be noncompliant, on the USPTO Web site at http://www.uspto.gov/ip/boards/bpai/procedures/guidance_noncompliant_briefs.jsp.

An exception to the requirement that all the items specified in 37 CFR 41.37(c)(1) be included in the brief is made if the application or reexamination proceeding is being prosecuted by the appellant *pro se*, i.e., there is no attorney or agent of record, and the brief was neither prepared nor signed by a registered attorney or agent. The brief of a *pro se* appellant which does not contain all of the items, (i) to (x), specified in 37 CFR 41.37(c)(1) will be accepted as long as it substantially complies with the requirements of items (i) through (iv) and (vii) through (x).

If in his or her brief, appellant relies on some reference, he or she is expected to provide the Board with a copy of it in the evidence appendix of the brief.

The specific items required by 37 CFR 41.37(c)(1) are:

(i) *Real party in interest.* A statement identifying by name the real party in interest even if the party named in the caption of the brief is the real party in interest. If appellant does not name the real party in interest under this heading, the Office will notify appellant of the defect in the brief and give appellant a time period within which to file an amended brief. See 37 CFR 41.37(d). If the appellant fails to correct the defect in the real party in interest section of the brief within the time period set forth in the notice, the appeal will stand dismissed.

The identification of the real party in interest allows members of the Board to comply with ethics regulations associated with working in matters in which the member has a financial interest to avoid any potential conflict of interest. When an application is assigned to a subsidiary corporation, the real party in interest is both the assignee and either the parent corporation or corporations, in the case of joint ventures. One example of a statement identifying the real party in interest is: The real party in interest is XXXX corporation, the assignee of record, which is a subsidiary of a joint venture between YYYY corporation and ZZZZ corporation.

(ii) *Related appeals and interferences.* A statement identifying all prior and pending appeals, judicial proceedings or interferences known to the appellant which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. Appellant includes the appellant, the appellant's legal representative and the assignee. Such related proceedings must be identified by application number, patent number, appeal number (if available) or interference number (if available). The statement is not limited to copending applications. The requirement to identify related proceedings requires appellant to identify every related proceeding (e.g., commonly owned applications having common subject matter, claim to a common priority application) which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. Copies of any decisions rendered by a court or the Board in any proceeding identified under this paragraph must be included in an appendix as required by 37 CFR 41.37(c)(1)(x). If appellant does not identify any other items under this section, it will be presumed that there are none.

(iii) *Status of Claims.* A statement of the status of all the claims in the application, or patent under reexamination, i.e., for each claim in the case, appellant must state whether it is cancelled, allowed or confirmed, rejected, withdrawn, objected to, etc. Each claim on appeal must be identified.

(iv) *Status of Amendments.* A statement of the status of any amendment filed subsequent to final rejection, i.e., whether or not the amendment has been acted upon by the examiner, and if so, whether it was entered, or denied entry. This statement should be of the status of the amendment as understood by the

appellant. Appellants are encouraged to check the Office's Patent Application Information Retrieval (PAIR) system for the status of any amendment or affidavit or other evidence filed after a final rejection or the filing of a notice of appeal.

Items (iii) and (iv) are included in 37 CFR 41.37(c)(1) to avoid confusion as to which claims are on appeal, and the precise wording of those claims, particularly where the appellant has sought to amend claims after final rejection. The inclusion of items (iii) and (iv) in the brief will advise the examiner of what the appellant considers the status of the claims and post-final rejection amendments to be, allowing any disagreement on these questions to be resolved before the appeal is taken up for decision by the Board.

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which must refer to the specification by page and line number, and to the drawing, if any, by reference characters. While reference to page and line number of the specification requires somewhat more detail than simply summarizing the invention, it is considered important to enable the Board to more quickly determine where the claimed subject matter is described in the application. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of 37 CFR 41.37(c)(1)(vii), every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. If appellant does not provide a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v), the Office will notify appellant of the defect in the brief and give appellant a time period within which to file an amended brief. See 37 CFR 41.37(d).

(vi) *Grounds of rejection to be reviewed on appeal.* A concise statement of each ground of rejection presented for review. For example, the statement "Whether claims 1 and 2 are unpatentable" would not comply with the rule, while the statements "Whether claims 1 and 2 are unpatentable under 35 U.S.C. 103 over Smith in view of Jones," and "Whether claims 1

and 2 are unpatentable under 35 U.S.C. 112, first paragraph, as being based on a nonenabling disclosure” would comply with the rule. The statement cannot include any argument concerning the merits of the ground of rejection presented for review. Arguments should be included in the “Argument” section of the brief.

(vii) *Argument*. The appellant’s contentions with respect to each ground of rejection presented and the basis for those contentions, including citations of authorities, statutes, and parts of the record relied on, should be presented in this section. A statement which merely points out what a claim recites will not be considered an argument for patentability of the claim.

37 CFR 41.37(c)(1)(vii) contains the following sentence:

Any arguments or authorities not included in the brief or reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown.

This sentence emphasizes that all arguments and authorities which an appellant wishes the Board to consider should be included in the brief or reply brief. It should be noted that arguments not presented in the brief or reply brief and made for the first time at the oral hearing are not normally entitled to consideration. *In re Chiddix*, 209 USPQ 78 (Comm’r Pat. 1980); *Rosenblum v. Hiroshima*, 220 USPQ 383 (Comm’r Pat. 1983).

This sentence is not intended to preclude the filing of a supplemental paper if new authority should become available or relevant after the brief or reply brief was filed. An example of such circumstances would be where a pertinent decision of a court or other tribunal was not published until after the brief or reply brief was filed.

Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. The failure of appellant to separately argue claims which appellant has grouped together constitutes a waiver of any argument that the Board must consider the patentability of any grouped

claim separately. See *In re McDaniel*, 293 F.3d 1379, 1384, 63 USPQ2d 1462, 1465-66 (Fed. Cir. 2002). Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number.

For example, if Claims 1 to 5 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. Y and appellant is only going to argue the limitations of independent claim 1, and thereby group dependent claims 2 to 5 to stand or fall with independent claim 1, then one possible heading as required by this subsection could be “Rejection under 35 U.S.C. 102(b) over U.S. Patent No. Y” and the optional subheading would be “Claims 1 to 5.” Another example is where claims 1 to 3 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. Z and appellant wishes to argue separately the patentability of each claim, a possible heading as required by this subsection could be “Rejection under 35 U.S.C. 102 (b) over U.S. Patent No. Z.” and the optional subheadings would be “Claim 1.,” “Claim 2.” and “Claim 3.” Under each subheading the appellant would present the argument for patentability of that claim. The best practice is to use a subheading for each claim for which separate consideration by the Board is desired.

(viii) *Claims appendix*. An appendix containing a copy of the claims involved in the appeal.

The copy of the claims should be a clean copy and should not include any markings such as brackets or underlining except for claims in a reissue application >and a reexamination proceeding<. See MPEP § 1454 for the presentation of the copy of the claims in a reissue application. >See 37 CFR 1.530(d) and (f) for reexamination proceedings, see also MPEP § 2274 for *ex parte* reexamination and MPEP § 2675 for *inter partes* reexamination.<

The copy of the claims should be double-spaced and the appendix should start on a new page.

(ix) *Evidence appendix*. An appendix containing copies of any evidence submitted pursuant to 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See 37 CFR 41.33

for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal. The appendix should start on a new page. If there is no evidence being relied upon by appellant in the appeal, then an evidence appendix should be included with the indication “none.”

(x) *Related proceedings appendix*. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to 37 CFR 41.37(c)(1)(ii). The appendix should start on a new page. If there are no such copies of decisions being submitted in the appeal, then a related proceedings appendix should be included with the indication “none.”

37 CFR 41.37(c)(1) merely specifies the minimum requirements for a brief, and does not prohibit the inclusion of any other material which an appellant may consider necessary or desirable, for example, a list of references, table of contents, table of cases, etc. A brief is in compliance with 37 CFR 41.37(c)(1) as long as it includes items (i) to (x) in the order set forth.

37 CFR 41.37(c)(2) prohibits the inclusion in a brief of any new or non-admitted amendment, affidavit or other evidence.

An example of a format and content for an appeal brief for a patent application is a brief containing the following items, with each item starting on a separate page:

(A) Identification page setting forth the applicant's name(s), the application number, the filing date of the application, the title of the invention, the name of the examiner, the art unit of the examiner and the title of the paper (i.e., Appeal Brief);

(B) Table of Contents page(s);

(C) Real party in interest page(s);

(D) Related appeals and interferences page(s);

(E) Status of claims page(s);

(F) Status of amendments page(s);

(G) Summary of claimed subject matter page(s);

(H) Grounds of rejection to be reviewed on appeal page(s);

(I) Argument page(s);

(J) Claims appendix page(s);

(K) Evidence appendix page(s);

(L) Related proceedings appendix page(s).

In accordance with the above, the brief must be directed to the claims and to the record of the case as they appeared at the time of the appeal, but it may, of course, withdraw from consideration on appeal any claims or issues as desired by appellant. Even if the appeal brief withdraws from consideration any claims or issues (i.e., appellant acquiesces to any rejection), the examiner must continue to make the rejection in the examiner's answer, unless an amendment obviating the rejection has been entered.

A timely filed brief will be referred to the examiner for consideration of its propriety as to the appeal issues and for preparation of an examiner's answer if the brief is proper and the application is not allowable. The examiner's answer may withdraw the rejection of claims, if appropriate. The examiner may also determine that it is necessary to reopen prosecution to enter a new ground of rejection. See MPEP § 1207.04.

1205.03 Non-Compliant Appeal Brief and Amended Brief [R-8]

****>**Effective March 30, 2010, the Board of Patent Appeals and Interferences (BPAI) will have the sole responsibility for determining whether appeal briefs filed in patent applications comply with 37 CFR 41.37, and will complete the determination before the appeal brief is forwarded to the examiner for consideration. The determination should be completed within approximately one month from the filing of the appeal brief. If the appeal brief is determined to be compliant with the rules or it contains only minor informalities that do not affect the BPAI panel's ability to render a decision, the BPAI will accept the appeal brief and forward it to the examiner for consideration. If the BPAI determines that the appeal brief is non-compliant with 37 CFR 41.37 and sends appellant a notice of non-compliant brief requiring a corrected brief, appellant will be required to file a corrected brief within the time period set forth in the notice to avoid the dismissal of the appeal. The BPAI will also have the sole responsibility for determining whether corrected briefs comply with 37 CFR 41.37, and will address any inquiries and petitions regarding notices of non-compliant briefs.

If appellant disagrees with the holding of noncompliance, a petition under 37 CFR 41.3 may be filed. Filing a petition will not toll the time period for reply set in the notice. Appellant must timely reply to the

notice or the Office communication that requires an amended brief.

Once an appeal brief is accepted by the BPAI as in compliance with 37 CFR 41.37, the appeal brief will not later be held as defective by the Patent Appeal Center or the examiner. The BPAI will not return or remand the application to the examiner for issues related to a non-compliant appeal brief. Furthermore, examiners are not required to review appeal briefs for the purposes of determining whether the appeal briefs comply with 37 CFR 41.37. Accordingly, the Notification of Non-Compliant Appeal Brief (PTOL-462) and form paragraphs for holding an appeal brief defective will no longer be available in OACS for the patent examining corps to use.

The revised procedure for appeal brief review will take effect on March 30, 2010, regardless of the date on which the appeal brief is filed or forwarded to the examiner for consideration. Examiners should no longer hold any appeal briefs defective including those appeal briefs that are already on the examiner's dockets because they have already been reviewed and accepted by the Patent Appeal Center. Furthermore, the BPAI will correspond directly with the appellant on non-compliant brief issues. Examiners may use form paragraphs 12.150.01 – 12.156.01 to draft examiner's answers to respond to appeal briefs filed in any format. In those rare situation where an appeal brief contains serious defects that will prevent the examiner from drafting an examiner's answer, the examiner should report the issue to the Technology Center (TC) Director who will communicate with the BPAI regarding the issue.

The responsibility of the BPAI for determining whether appeal briefs comply with 37 CFR 41.37 is not considered a transfer of jurisdiction when an appeal brief is filed, but rather is only a transfer of the specific responsibility of notifying appellants under 37 CFR 41.37(d) of the reasons for non-compliance. The patent examining corps retains the jurisdiction over the application to consider the appeal brief, conduct an appeal conference, draft an examiner's answer, and decide the entry of amendments, evidence, and information disclosure statements filed after final or after the filing of a notice of appeal. Furthermore, petitions concerning the refusal to enter amendments and/or evidence remain delegated to MPEP §§ 1002.02(b) and (c). The jurisdiction of the

application will be transferred to the BPAI when a docketing notice is entered after the time period for filing a reply brief expires or the examiner acknowledges the receipt and entry of the reply brief.<

1206 Amendments and Affidavits or Other Evidence Filed With or After Appeal [R-8]

37 CFR 41.33. Amendments and affidavits or other evidence after appeal.

(a) Amendments filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) and prior to the date a brief is filed pursuant to § 41.37 may be admitted as provided in § 1.116 of this title.

(b) Amendments filed on or after the date of filing a brief pursuant to § 41.37 may be admitted:

(1) To cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, or

(2) To rewrite dependent claims into independent form.

(c) All other amendments filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i), 41.50(b)(1) and 41.50(c).

(d)(1) An affidavit or other evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) and prior to the date of filing a brief pursuant to § 41.37 may be admitted if the examiner determines that the affidavit or other evidence overcomes all rejections under appeal and that a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented has been made.

(2) All other affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i) and 41.50(b)(1).

I. AMENDMENTS

A new amendment must be submitted in a separate paper. Entry of a new amendment in an application on appeal is not a matter of right. The entry of an amendment (which may not include a new affidavit, declaration, exhibit or other evidence) submitted in an application on appeal is governed by 37 CFR 41.33, not 37 CFR 1.116.

Amendments filed after the filing of a notice of appeal, but prior to the date of filing a brief, may be admitted only to:

(A) cancel claims;

(B) comply with any requirement of form expressly set forth in a previous action;

(C) present rejected claims in better form for consideration on appeal; or

(D) amend the specification or claims upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented. See 37 CFR 41.33(a).

If the examiner denies the entry of such an amendment, the examiner should use form PTOL-303, "Advisory Action Before the Filing of an Appeal Brief," to notify the applicant of the non-entry and the reason for non-entry.

Amendments filed **on or after** the date of filing a brief pursuant to 37 CFR 41.37 may be admitted only to:

(A) cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding; or

(B) rewrite dependent claims into independent form.

Rewriting dependent claims into independent form as permitted under 37 CFR 41.33(b)(2) includes the following situations:

(A) rewriting a dependent claim in independent form by adding thereto the limitations of the parent claim(s); and

(B) rewriting an independent claim to incorporate therein all the subject matter of a dependent claim, canceling the dependent claim and in conjunction therewith changing the dependency of claims which had depended from the dependent claim being canceled to the amended independent claim that incorporates therein all the subject matter of the now canceled dependent claim.

If the examiner denies entry of an amendment filed on or after the date of filing a brief, the examiner should use form PTOL-304, "Advisory Action After the Filing of an Appeal Brief," to notify the applicant of the non-entry and the reason for non-entry.

Examiners must respond to all amendments filed after appeal has been taken and prior to termination of the appeal. If the examiner indicates (in the advisory action) that an amendment would be entered, it is imperative for the examiner to also state (in the same advisory action) how the individual rejection(s) set forth in the final Office action will be impacted by the entry of the amendment except where an amendment merely cancels claims. If the examiner determines that an amendment clearly places the application in

condition for allowance, the examiner may enter the amendment and allow the application. Except for amendments that meet the conditions set forth above, all other amendments submitted after the date of filing a notice of appeal will not be entered except as permitted by 37 CFR 41.39(b)(1), 41.50(a)(2)(i), 41.50(b)(1) and 41.50(c).

See MPEP 714.02, 714.12 and 714.13 for the treatment of amendments, affidavits and other evidence submitted after the mailing of a final rejection or a non-final rejection, but prior to the filing of a notice of appeal under 37 CFR 41.31(a)(1)-(a)(3). Any amendment, affidavit or other evidence filed after the mailing of a final Office action and on the same date as the notice of appeal will be treated by the Office as being filed prior to the notice of appeal and treated under 37 CFR 1.116. Any amendment, affidavit or other evidence filed after the mailing of a non-final Office action and on the same date as the notice of appeal will be treated by the Office as being filed prior to the notice of appeal and treated under 37 CFR 1.111.

II. AFFIDAVITS OR OTHER EVIDENCE

Affidavits or other evidence (e.g., declarations or exhibits) submitted after the date of filing a notice of appeal, but prior to the date of filing a brief pursuant to 37 CFR 41.37, may be admitted if the examiner determines that:

(A) the affidavits or other evidence overcomes all rejections under appeal; and

(B) a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented has been made.

If the examiner denies the entry of such an affidavit or other evidence, the examiner should use form PTOL-303, "Advisory Action Before the Filing of an Appeal Brief," to notify the applicant of the non-entry and the reason for non-entry.

If the examiner determines that an affidavit or other evidence clearly places the application in condition for allowance, the examiner may enter the affidavit or other evidence and allow the application. Except as noted above, all other affidavits or other evidence filed after the date of filing a notice of appeal pursuant to 37 CFR 41.31(a)(1)-(a)(3) will not be admitted except as permitted by 37 CFR 41.39(b)(1), 41.50(a)(2)(i) and 41.50(b)(1).

An amendment, affidavit or other evidence received after jurisdiction has passed to the Board should not be considered by the examiner unless remanded or returned by the Board for such purpose. See MPEP § 1210 and § 1211.02.

Note that 37 CFR 41.37(c)(1)(iv) requires a statement as to the status of any amendment filed subsequent to the final rejection. See also MPEP § 1205.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	Examiner	Art Unit	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED _____ FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because

(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☐ They raise the issue of new matter (see NOTE below);

(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____.

Advisory Action After the Filing of an Appeal Brief	Application No.	Applicant(s)	
	Examiner	Art Unit	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The reply filed _____ is acknowledged.

1. ☐ The reply filed on or after the date of filing of an appeal brief, but prior to a final decision by the Board of Patent Appeals and Interferences, will not be entered because:

a. ☐ The amendment is not limited to canceling claims (where the cancellation does not affect the scope of any other pending claims) or rewriting dependent claims into independent form (no limitation of a dependent claim can be excluded in rewriting that claim). See 37 CFR 41.33(b) and (c).

b. ☐ The affidavit or other evidence is not timely filed before the filing of an appeal brief. See 37 CFR 41.33(d)(2).

2. ☐ The reply is not entered because it was not filed within the two month time period set forth in 37 CFR 41.39(b), 41.50(a)(2), or 41.50(b) (whichever is appropriate). Extensions of time under 37 CFR 1.136(a) are not available.

Note: This paragraph is for a reply filed in response to one of the following: (a) an examiner's answer that includes a new ground of rejection (37 CFR 41.39(a)(2)); (b) a supplemental examiner's answer written in response to a remand by the Board of Patent Appeals and Interferences for further consideration of a rejection (37 CFR 41.50(a)(2)); or (c) a Board of Patent Appeals and Interferences decision that includes a new ground of rejection (37 CFR 41.50(b)).

3. ☐ The reply is entered. An explanation of the status of the claims after entry is below or attached.

4. ☐ Other: _____

*>

1207 < Examiner's Answer [R-3]

**>

37 CFR 41.39. Examiner's answer.

(a)(1) The primary examiner may, within such time as may be directed by the Director, furnish a written answer to the appeal brief including such explanation of the invention claimed and of the references relied upon and grounds of rejection as may be necessary, supplying a copy to appellant. If the primary examiner determines that the appeal does not comply with the provisions of §§ 41.31 and 41.37 or does not relate to an appealable action, the primary examiner shall make such determination of record.

(2) An examiner's answer may include a new ground of rejection.

(b) If an examiner's answer contains a rejection designated as a new ground of rejection, appellant must within two months from the date of the examiner's answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) *Reopen prosecution.* Request that prosecution be reopened before the primary examiner by filing a reply under § 1.111 of this title with or without amendment or submission of affidavits (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. Any amendment or submission of affidavits or other evidence must be relevant to the new ground of rejection. A request that complies with this paragraph will be entered and the application or the patent under ex parte reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. Any request that prosecution be reopened under this paragraph will be treated as a request to withdraw the appeal.

(2) *Maintain appeal.* Request that the appeal be maintained by filing a reply brief as set forth in § 41.41. Such a reply brief must address each new ground of rejection as set forth in § 41.37(c)(1)(vii) and should follow the other requirements of a brief as set forth in § 41.37(c). A reply brief may not be accompanied by any amendment, affidavit (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. If a reply brief filed pursuant to this section is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under paragraph (b)(1) of this section.

(c) Extensions of time under § 1.136 (a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136 (b) of this title for extensions of time to reply for patent applications and § 1.550 (c) of this title for extensions of time to reply for ex parte reexamination proceedings.<

>After an appeal brief under 37 CFR 41.37 has been filed and the examiner has considered the issues on appeal, the examiner may:

(A) reopen prosecution to enter a new ground of rejection with approval from the supervisory patent examiner (see MPEP § 1207.04);

(B) withdraw the final rejection and allow the application if the examiner determines that the rejections have been overcome and no new ground of rejection is appropriate; or

(C) maintain the appeal by conducting an appeal conference (MPEP § 1207.01) and draft an examiner's answer (MPEP § 1207.02). Any examiner's answer mailed on or after September 13, 2004 may include a new ground of rejection (MPEP § 1207.03).<

**>

1207.01 Appeal Conference< [R-3]

An appeal conference is mandatory in all cases in which an acceptable brief (MPEP § *>1205<) has been filed. However, if the examiner charged with the responsibility of preparing the examiner's answer reaches a conclusion that the appeal should not go forward and the supervisory patent examiner (SPE) approves, then no appeal conference is necessary. >In this case, the examiner may reopen prosecution and issue another Office action. See MPEP § 1207.04.<

The participants of the appeal conference should include (1) the examiner charged with preparation of the examiner's answer, (2) a supervisory patent examiner (SPE), and (3) another examiner, known as a conferee, having sufficient experience to be of assistance in the consideration of the merits of the issues on appeal. During the appeal conference, consideration should be given to the possibility of dropping cumulative art rejections and eliminating technical rejections of doubtful value.

The examiner responsible for preparing the examiner's answer should weigh the arguments of the other examiners presented during the appeal conference. If it is determined that the rejection(s) should be maintained, the examiner responsible for preparing the examiner's answer will prepare the examiner's answer.

On the examiner's answer, below the primary examiner's signature, the word "Conferees:" should be included, followed by the typed or printed names of the other two appeal conference participants. These two appeal conference participants must place their initials next to their name. This will make the record clear that an appeal conference has been held. >If the examiner's answer contains a new ground of rejection, it must give appellant a two-month time period

to reply to the new ground of rejection. The answer must also include the signature of a Technology Center (TC) Director or designee to indicate that he or she approves the new ground of rejection. See MPEP § 1207.03 and form paragraph 12.179.01.<

Upon receipt of the appeal case by the Board of Patent Appeals and Interferences (Board), the Board should review the application prior to assigning an appeal number to determine whether an appeal conference has been held. If the examiner's answer does not contain the appropriate indication that an appeal conference has been held (i.e., including the names of the conferees and identifying themselves as the conferees along with their initials), the Board should return the application directly to the appropriate **>TC< Director for corrective action. This return procedure by the Board should not be considered as a remand of the application. This procedure applies to all examiner's answers received by the Board on or after November 1, 2000.

Before preparing the answer, the examiner should make certain that all amendments approved for entry have in fact been * entered >in the file<. The ** Board will return to the TC any application in which approved amendments have not been entered.

1207.02 Contents of Examiner's Answer [R-8]

The examiner should furnish the appellant with a written statement in answer to the appellant's brief within 2 months after the receipt of the brief by the examiner.

The answer should contain a response to the allegations or arguments in the brief **. If any rejection is withdrawn, the withdrawal should be clearly stated in the examiner's answer under subheading "***>WITHDRAWN REJECTIONS<" in the section "Grounds of Rejection to be Reviewed on Appeal." ** The examiner should treat affidavits, declarations, or exhibits filed with the notice of appeal in accordance with 37 CFR 1.116. If an affidavit, declaration, or exhibit was refused entry under 37 CFR 1.116 or prohibited by 37 CFR 41.33, the examiner should not comment on it in the examiner's answer. Likewise, it would be improper for appellant to rely on an affidavit, declaration, or exhibit, which was not entered, in an appeal brief. If appellant has grounds for challenging the non-entry of an affidavit, declaration, or exhibit, he or

she should file a timely petition seeking supervisory review of the non-entry. Any affidavits or declarations in the file swearing behind a reference should be clearly identified by the examiner as being considered under 37 CFR 1.131.

If a document being relied upon by the examiner in support of a rejection is in a language other than English, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection. >The translation may be a machine translation or an English equivalent of the non-English document.< The translation should be obtained prior to the appeal conference so that the participants of the appeal conference can consider the translation. The examiner should reference the pertinent portions of the translation at least in the grounds of rejection section of the answer. See MPEP § 706.02 for reliance upon abstracts and foreign language documents in support of a rejection.

**>Examiners are not required to make any determination whether fewer than all of the rejected claims are identified by the appellant as being appealed. If the notice of appeal or appeal brief identifies fewer than all of the rejected claims as being appealed, the issue will be addressed by the Board of Patent Appeals and Interferences (BPAI) panel. Therefore, the examiner will treat all pending, rejected claims as being on appeal, and must maintain all of the rejections set forth in the Office action from which the appeal is taken, unless appellant has overcome the rejection (e.g., by submitting persuasive arguments, an acceptable terminal disclaimer, or evidence). In situations where the appellant makes a request to hold a rejection in abeyance or did not present any argument on a rejection in the appeal brief, the examiner should maintain the rejection in the examiner's answer.<

Because of the practice of the Office in entering amendments after final action under justifiable circumstances for purposes of appeal, many cases coming before the Board for consideration contain claims which are not the claims treated in the examiner's final rejection. They are either entirely new claims or amended versions of the finally rejected claims or both. Where an amendment under 37 CFR 1.116 or 41.33 would be entered for appeal purposes, the examiner must identify (in an advisory action) how one or more individual rejections set forth in the final

rejection would be used to reject the added or amended claim(s).

If there is a complete and thorough development of the issues at the time of final rejection, it is possible to save time in preparing the examiner's answer required by 37 CFR 41.39 by copying a rejection from a prior Office action and then pasting the copied rejection into the answer. An examiner's answer should not refer, either directly or indirectly, to any prior Office action without fully restating the point relied on in the answer. Of course, if the examiner feels that some further explanation of the rejection is necessary, he or she should include it in the ground of rejection set forth in the answer. For example, if a rejected claim were amended after the final rejection by adding limitations, the examiner should address the added limitations in the ground of rejection set forth in the answer. The statement of the rejection in the answer must account for the claim as amended and the answer must also include any necessary rebuttal of arguments presented in the appellant's brief.

The examiner should reevaluate his or her position in the light of the arguments presented in the brief, and should expressly withdraw any rejections not adhered to in the “**>WITHDRAWN REJECTIONS<” subsection of the examiner's answer. **

A new ground of rejection is permitted in an examiner's answer. See MPEP § 1207.03. If reopening of prosecution is necessary, the examiner must obtain approval from the supervisory patent examiner prior to reopening prosecution after an appeal. See MPEP § 1002.02(d) and § 1207.04.

All correspondence with the Board, whether by the examiner or the appellant, must be on the record. No unpublished decisions which are unavailable to the general public by reason of 35 U.S.C. 122(a) can be cited by the examiner or the appellant except that either the examiner or the appellant has the right to cite an unpublished decision in an application having common ownership with the application on appeal.

If an examiner's answer is believed to contain a new interpretation or application of the existing patent law, the examiner's answer, application file, and an explanatory memorandum should be forwarded to the TC Director for consideration. See MPEP § 1003. If approved by the TC Director, the examiner's answer should be forwarded to the Office of the *>Associ-

ate< Commissioner for Patent Examination Policy for final approval.

Briefs must comply with 37 CFR 41.37, and all examiner's answers filed in response to such briefs must comply with the guidelines set forth below.

(A) CONTENT REQUIREMENTS FOR EXAMINER'S ANSWER. The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

(1) *Real Party in Interest*. A statement **>that the examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.<

(2) *Related Appeals and Interferences*. A statement identifying by application, patent, appeal or interference number all other prior and pending appeals, interferences or judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by, or have a bearing on the Board's decision in the pending appeal. Copies of any decisions rendered by a court or the Board in any proceeding identified under this paragraph should be included in the *Related proceedings appendix* section.

(3) *Status of Claims*. A **>listing of the claims that are rejected and pending in the application.<

(4) *Status of Amendments After Final*. A statement **>that the examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.<

(5) *Summary of Claimed Subject Matter*. A statement **>that the examiner has no comment on the summary of claimed subject matter contained in the brief.<

(6) *Grounds of Rejection to be Reviewed on Appeal*. A statement **>that the examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading “WITHDRAWN REJECTIONS.” New grounds of rejection (if any) are provided under the subheading “NEW GROUNDS OF REJECTION.”<

(7) *Claims Appendix*. A statement **>that the examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.<

(8) *Evidence Relied Upon.* A listing of the evidence relied on (e.g., patents, publications, admitted prior art), and, in the case of nonpatent references, the relevant page or pages.

(9) *Grounds of Rejection.* For each ground of rejection maintained by the examiner and each new ground of rejection (if any), an explanation of the ground of rejection.

(a) For each rejection under 35 U.S.C. 112, first paragraph, the examiner's answer, must explain how the first paragraph of 35 U.S.C. 112 is not complied with, including, as appropriate, how the specification and drawings, if any,

(i) do not describe the subject matter defined by each of the rejected claims,

(ii) would not enable any person skilled in the art to make and use the subject matter defined by each of the rejected claims without undue experimentation including a consideration of the undue experimentation factors set forth in MPEP § 2164.01(a), and

(iii) do not set forth the best mode contemplated by the appellant of carrying out his or her invention.

(b) For each rejection under 35 U.S.C. 112, second paragraph, the examiner's answer must explain how the claims do not particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(c) For each rejection under 35 U.S.C. 102, the examiner's answer must explain why the rejected claims are anticipated or not patentable under 35 U.S.C. 102, pointing out where all of the specific limitations recited in the rejected claims are found in the prior art relied upon in the rejection.

(d) For each rejection under 35 U.S.C. 103, the examiner's answer must:

(i) state the ground of rejection and point out where each of the specific limitations recited in the rejected claims is found in the prior art relied on in the rejection,

(ii) identify the differences between the rejected claims and the prior art relied on (i.e., the primary reference), and

(iii) explain why it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have modified the primary reference to arrive at the claimed subject matter.

(e) For each rejection under 35 U.S.C. 102 or 103 where there are questions as to how limitations in the claims correspond to features in the prior art even after the examiner complies with the requirements of paragraphs (c) and (d) of this section, the examiner must compare at least one of the rejected claims feature by feature with the prior art relied on in the rejection. The comparison must align the language of the claim side-by-side with a reference to the specific page, line number, drawing reference number, and quotation from the prior art, as appropriate.

(f) For each rejection, other than those referred to in paragraphs (a) to (e) of this section, the examiner's answer must specifically explain the basis for the particular rejection.

(g) The examiner must prominently identify (e.g., a separate heading with all capitalized letters) any new ground of rejection that has been approved by the TC Director or designee.

(10) *Response to Argument.* A statement of whether the examiner disagrees with each of the contentions of appellant in the brief with respect to the issues presented and an explanation of the reasons for disagreement with any such contention. The examiner must use headings and subheadings paralleling the headings and subheadings utilized in the appellant's brief.

(11) *Related Proceedings Appendix.* Copies of any decisions rendered by a court or the Board in any proceeding identified by the examiner in the "Related Appeals and Interferences" section of the answer.

(B) **FORM PARAGRAPHS.** A form suitable for the examiner's answer is as follows:

¶ 12.149 *Examiner's Answer Cover Sheet*

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: [1]

Filing Date: [2]

Appellant(s): [3]

[4]

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed [5] appealing from the Office action mailed [6].

Examiner Note:

1. This form paragraph is printed with the USPTO letterhead.
2. In bracket 1, insert the application number of the appealed application.
3. In bracket 2, insert the filing date of the appealed application.

4. In bracket 3, insert the name(s) of the appellant.
5. In bracket 4, insert the name of the registered representative of the appellant.
6. In bracket 5, indicate the date on which the brief was filed, and also indicate if any supplemental appeal brief was filed, as well as the date on which the supplemental appeal brief was filed.
7. In bracket 6, indicate the date on which the Office action being appealed was mailed.
8. Form paragraphs 12.149 to 12.179.01, as appropriate, should be used if the appeal brief was filed on or after September 13, 2004.

**>

¶ *12.150.01 Real Party in Interest*
(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

<

¶ *12.150.04 Related Appeals and Interferences*
(2) Related Appeals and Interferences

Examiner Note:

Follow this form paragraph with form paragraph 12.150.05 or 12.150.06.

¶ *12.150.05 Identification of the Related Appeals and Interferences*

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Examiner Note:

1. Follow this form paragraph with an identification by application, patent, appeal or interference number of all other prior and pending appeals, interferences or judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.
2. Include a copy of all court and Board decisions identified in this section in a related proceeding(s) appendix using form paragraphs 12.162 and 12.162.02.

¶ *12.150.06 No Related Appeals and Interferences Identified*

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**>

¶ *12.151 Status of Claims*
(3) Status of Claims

Examiner Note:

Follow this form paragraph with form paragraph 12.151.01.

¶ *12.151.01 List of Rejected Claims That Are Pending*

The following is a list of claims that are rejected and pending in the application: [1].

Examiner Note:

In bracket 1, list all the claims that are rejected and pending in the application, including any claims that are rejected but were omitted from the appellant's listing (if any) of appealed claims in the Notice of Appeal. Do not list claims which are no longer rejected.

¶ *12.152 Status of Amendments After Final*
(4) Status of Amendments After Final

Examiner Note:

Follow this form paragraph with form paragraph 12.152.01.

¶ *12.152.01 No Comment on Appellant's Statement of Status of Amendments*

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

¶ *12.153 Summary of Claimed Subject Matter*
(5) Summary of Claimed Subject Matter

Examiner Note:

Follow this form paragraph with form paragraph 12.153.01.

¶ *12.153.01 No Comment on Appellant's Statement of the Summary of Claimed Subject Matter*

The examiner has no comment on the summary of claimed subject matter contained in the brief.

¶ *12.154 Grounds of Rejection to be Reviewed on Appeal*
(6) Grounds of Rejection to be Reviewed on Appeal

Examiner Note:

Follow this form paragraph with form paragraph 12.154.01.

¶ *12.154.01 Examiner's Statement of Grounds of Rejection*

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

Examiner Note:

1. Use form paragraph 12.154.04 to introduce any new grounds of rejection.
2. Use form paragraph 12.154.05 to withdraw a ground of rejection previously made in the final Office action or last Office action.

<

¶ 12.154.04 *New Grounds of Rejection - Heading***NEW GROUNDS OF REJECTION**

[1]

Examiner Note:

1. Any new ground(s) of rejection in the examiner's answer must be prominently identified (e.g., using this form paragraph) in the following sections of the answer:

(6) *Grounds of Rejection to be Reviewed on Appeal* (form paragraph 12.154) – use this form paragraph in section (6) of the answer to provide a concise statement of each new ground of rejection presented for review in bracket 1; and

(9) *Grounds of Rejection* (form paragraph 12.159) – use this form paragraph in section (9) of the answer to set forth the new grounds of rejection.

2. Conclude an examiner's answer raising new grounds of rejection with form paragraph 12.179.01: (1) to notify applicant of the response period and options following the new grounds of rejection; and (2) to include the required approval of the TC Director or his/her designee.

¶ 12.154.05 *Withdrawn Rejections***WITHDRAWN REJECTIONS**

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. [1].

Examiner Note:

In bracket 1, insert the grounds of rejection that have been withdrawn.

**>

¶ 12.156 *Claims Appendix***(7) Claims Appendix****Examiner Note:**

Follow this form paragraph with form paragraph 12.156.01.

¶ 12.156.01 *No Comment on Appellant's Claims Appendix*

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

<

¶ 12.157 *Evidence Relied Upon***(8) Evidence Relied Upon****Examiner Note:**

Follow this form paragraph with either form paragraph 12.157.01 or 12.157.02.

¶ 12.157.01 *No Evidence Relied Upon*

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

¶ 12.157.02 *Listing of Evidence Relied Upon*

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

Examiner Note:

1. Use the following format for providing information on each reference cited:

Number Name Date

2. The following are example formats for listing reference citations:

2,717,847 VERRAIN 9-1955

1,345,890 MUTHER (Fed. Rep. of Germany) 7-1963

(Figure 2 labeled as Prior Art in this document)

3. See MPEP § 707.05(e) for additional examples.

¶ 12.159 *Grounds of Rejection***(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Examiner Note:

1. Explain each ground of rejection maintained by the examiner as provided below:

(i) For each rejection under 35 U.S.C. 112, first paragraph, the Examiner's Answer shall explain how the first paragraph of 35 U.S.C. 112 is not complied with, including, as appropriate, how the specification and drawings, if any, (a) do not describe the subject matter defined by each of the rejected claims, (b) would not enable any person skilled in the art to make and use the subject matter defined by each of the rejected claims, and (c) do not set forth the best mode contemplated by the appellant of carrying out his/her invention.

(ii) For each rejection under 35 U.S.C. 112, second paragraph, the Examiner's Answer shall explain how the claims do not particularly point out and distinctly claim the subject matter which appellant regards as the invention.

(iii) For each rejection under 35 U.S.C. 102, the Examiner's Answer shall explain why the rejected claims are anticipated or not patentable under 35 U.S.C. 102, pointing out where all of the specific limitations recited in the rejected claims are found in the prior art relied upon in the rejection.

(iv) For each rejection under 35 U.S.C. 103, the Examiner's Answer shall state the ground of rejection and point out where each of the specific limitations recited in the rejected claims is found in the prior art relied upon in the rejection, shall identify the differences between the rejected claims and the prior art relied on (i.e., the primary reference) and shall explain why it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have modified the primary reference to arrive at the claimed subject matter

(v) For each rejection under 35 U.S.C. 102 or 103 where there may be questions as to how limitations in the claims correspond to features in the prior art, the examiner, in addition to the requirements of (ii), (iii) and (iv) above, should compare at least one of the rejected claims feature by feature with the prior art relied on in the rejection. The comparison shall align the language of the claim side by side with a reference to the specific page, line num-

ber, drawing reference number and quotation from the prior art, as appropriate.

(vi) For each rejection, other than those referred to in paragraphs (i) to (v) for this section, the Examiner's Answer shall specifically explain the basis for the particular rejection.

2. If there are any new grounds of rejection, use form paragraph 12.154.04 to provide a prominent heading and use form paragraph 12.179.01 instead of form paragraph 12.179 to conclude the examiner's answer.

¶ 12.161 *Response to Argument*
(10) *Response to Argument*

Examiner Note:

1. If an issue raised by appellant was fully responded to under the "Grounds of Rejection to be Reviewed on Appeal" portion, no additional response is required here.

2. If an issue has been raised by appellant that was not fully responded to under "Grounds of Rejection to be Reviewed on Appeal," a full response must be provided after this form paragraph.

¶ 12.162 *Related Proceeding(s) Appendix*
(11) *Related Proceeding(s) Appendix*

Examiner Note:

Follow this form paragraph with either form paragraph 12.162.01 or 12.162.02.

¶ 12.162.01 *No Related Proceeding Identified*

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

¶ 12.162.02 *Copies Related to Proceeding*

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

¶ 12.179 *Conclusion to Examiner's Answer, No New Grounds of Rejection*

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

[1]

Conferees:

[2]

[3]

Examiner Note:

1. In bracket 1, insert initials of the examiner and the date.
2. In bracket 2, insert names of the conferees. The conferees must also place their initials next to their names.
3. In bracket 3, insert correspondence address of record.
4. If the examiner's answer includes a new ground of rejection, use form paragraph 12.179.01 instead of this form paragraph.

¶ 12.179.01 *Conclusion to Examiner's Answer Raising New Grounds of Rejection*

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

[1]

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

[2]

Conferees:

[3]

[4]

Examiner Note:

1. In bracket 1, insert initials of the examiner and the date.
2. In bracket 2, insert TC Director's or designee's signature. All new grounds of rejection must be approved by a TC Director or designee.
3. In bracket 3, insert names of the conferees. The conferees must also place their initials next to their names.
4. In bracket 4, insert correspondence address of record.

**>

1207.03 < New Ground of Rejection in Examiner's Answer [R-3]

37 CFR **>41.39(a)(2) permits< the entry of a new ground of rejection in an examiner's answer >mailed

on or after September 13, 2004. New grounds of rejection in an examiner's answer are envisioned to be rare, rather than a routine occurrence. For example, where appellant made a new argument for the first time in the appeal brief, the examiner may include a new ground of rejection in an examiner's answer to address the newly presented argument by adding a secondary reference from the prior art on the record. New grounds of rejection are not limited to only a rejection made in response to an argument presented for the first time in an appeal brief. At the time of preparing the answer to an appeal brief, the examiner may decide that he or she should apply a new ground of rejection against some or all of the appealed claims. In such an instance where a new ground of rejection is necessary, the examiner should either reopen prosecution or set forth the new ground of rejection in the answer. The examiner must obtain supervisory approval in order to reopen prosecution after an appeal. See MPEP § 1002.02(d) and § 1207.04. A supplemental examiner's answer cannot include a new ground of rejection, except when a supplemental answer is written in response to a remand by the Board for further consideration of a rejection under 37 CFR 41.50(a). See MPEP § 1207.05.

I. REQUIREMENTS FOR A NEW GROUND OF REJECTION

Any new ground of rejection made by an examiner in an answer must be:

(A) approved by a Technology Center (TC) Director or designee; and

(B) prominently identified in the "Grounds of Rejection to be Reviewed on Appeal" section and the "Grounds of Rejection" section of the answer (see MPEP § 1207.02). The examiner may use form paragraph 12.154.04.

The examiner's answer must provide appellant a two-month time period for reply. The examiner may use form paragraph 12.179.01 to notify appellant of the period for reply and to include the approval of the TC Director or designee. In response to an examiner's answer that contains a new ground of rejection, appellant must either file:

(A) a reply in compliance with 37 CFR 1.111 to request that prosecution be reopened; or

(B) a reply brief that addresses each new ground of rejection in compliance with 37 CFR 41.37(c)(1)(vii) to maintain the appeal.

Appellant must file the reply or reply brief within two months from the date of the examiner's answer to avoid *sua sponte* dismissal of the appeal as to the claims subject to the new ground of rejection. See 37 CFR 41.39(b) and subsection "V. APPELLANT'S REPLY TO NEW GROUNDS OF REJECTION" below.

II. SITUATIONS WHERE NEW GROUNDS OF REJECTION ARE NOT PERMISSIBLE

A new ground of rejection would not be permitted to reject a previously allowed or objected to claim even if the new ground of rejection would rely upon evidence already of record. In this instance, rather than making a new ground of rejection in an examiner's answer, if the basis for the new ground of rejection was approved by a supervisory patent examiner as currently set forth in MPEP § 1207.04, the examiner would reopen prosecution. In addition, if an appellant has clearly set forth an argument in a previous reply during prosecution of the application and the examiner has failed to address that argument, the examiner would not be permitted to add a new ground of rejection in the examiner's answer to respond to that argument but would be permitted to reopen prosecution, if appropriate. New grounds of rejection cannot be made in a supplemental examiner's answer unless it is written in response to a remand by the Board for further consideration of a rejection under 37 CFR 41.50(a).

III. SITUATIONS THAT ARE NOT CONSIDERED AS NEW GROUNDS OF REJECTION

There is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). Where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not

necessarily constitute a new ground of rejection. *Id.* at 1303, 190 USPQ at 427 (reliance upon fewer references in affirming a rejection under 35 U.S.C. 103 does not constitute a new ground of rejection).

>In addition, former< 37 CFR 1.193(a)(2) also *>provided< that if:

(A) an amendment under 37 CFR 1.116 >[or 41.33]< proposes to add or amend one or more claims;

(B) appellant was advised (through an advisory action) that the amendment would be entered for purposes of appeal; and

(C) the advisory action indicates which individual rejection(s) set forth in the action from which appeal has been taken would be used to reject the added or amended claims, then

(1) the appeal brief must address the rejection(s) of the added or amended claim(s) and

(2) the examiner's answer may include the rejection(s) of the added or amended claims. >Such rejection(s) made in the examiner's answer would not be considered as a new ground of rejection.<

The filing of such an amendment represents appellant's consent to proceed with the appeal process. For example, when an amendment under 37 CFR 1.116 >or 41.33< cancels a claim (the "canceled claim") and incorporates its limitations into the claim upon which it depends or rewrites the claim as a new independent claim (the "appealed claim"), the appealed claim contains the limitations of the canceled claim (i.e., the only difference between the appealed claim and the canceled claim is the claim number). In such situations, the appellant has been given a fair opportunity to react to the ground of rejection (albeit to a claim having a different claim number). Thus, such a rejection does not constitute a "new ground of rejection" within the meaning of 37 CFR *>41.39<.

The phrase "individual rejections" ** addresses situations such as the following: the action contains a rejection of claim 1 under 35 U.S.C. 102 on the basis of Reference A, a rejection of claim 2 (which depends upon claim 1) under 35 U.S.C. 103 on the basis of Reference A in view of Reference B and a rejection of claim 3 (which depends upon claim 1) under 35 U.S.C. 103 on the basis of Reference A in view of Reference C. In this situation, the action contains the following "individual rejections": (1) 35 U.S.C. 102

on the basis of Reference A; (2) 35 U.S.C. 103 on the basis of Reference A in view of Reference B; and (3) 35 U.S.C. 103 on the basis of Reference A in view of Reference C. The action, however, does not contain any rejection on the basis of A in view of B and C. If an amendment under 37 CFR 1.116 >or 41.33< proposes to combine the limitations of claims 1 and 2 together into **>amended claim 1 and cancels claim 2,< a rejection of ** amended claim 1* under 35 U.S.C. 103 on the basis of Reference A in view of Reference B >would be appropriate and would not be considered a new ground of rejection within the meaning of 37 CFR 41.39<, provided the applicant was advised that this rejection would be applied to **>amended claim 1 in an advisory action. Furthermore, since claim 3 (which depends upon claim 1) would include the limitations of the original claims 1, 2, and 3, a rejection of amended claim 3 (amended by the amendment to original claim 1) under 35 U.S.C. 103 on the basis of Reference A in view of Reference B and Reference C may be appropriate and would not be considered a new ground of rejection within the meaning of 37 CFR 41.39, provided applicant was advised that this rejection would be applied to amended claim 3 in the advisory action. Of course, as amended claim 3 includes the limitations of the original claims 1, 2, and 3, amended claim 3 is a newly proposed claim in the application raising a new issue (i.e., a new ground of rejection), and such an amendment under 37 CFR 1.116 or 41.33 may properly be refused entry as raising a new issue.<

It must be emphasized that * 37 CFR *>41.39(a)(2)< does not change the existing practice with respect to amendment after final rejection practice (37 CFR 1.116). The fact that 37 CFR *>41.39(a)(2)< would authorize the rejection in an examiner's answer of a claim sought to be added or amended in an amendment under 37 CFR 1.116 >or 41.33< has no effect on whether the amendment under 37 CFR 1.116 >or 41.33< is entitled to entry. The provisions of 37 CFR 1.116 >or 41.33< control whether an amendment under 37 CFR 1.116 or >41.33< is entitled to entry; the provisions of 37 CFR **>41.39(a)(2) permits a new ground of rejection to be included in an answer against< a claim added or amended in an amendment under 37 CFR 1.116 **>or 41.33<.

A new prior art reference >applied or< cited for the first time in an examiner's answer generally will constitute a new ground of rejection. If the citation of a new prior art reference is necessary to support a rejection, it must be included in the statement of rejection, which would be considered to introduce a new ground of rejection. Even if the prior art reference is cited to support the rejection in a minor capacity, it should be positively included in the statement of rejection. *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n. 3 (CCPA 1970). **>Where< a newly cited reference is added merely as evidence of the prior ** statement made by the examiner >as to what is "well-known" in the art which was challenged for the first time in the appeal brief<, the citation of the reference in the examiner's answer would not >ordinarily< constitute a new ground of rejection within the meaning of 37 CFR *41.39(a)(2)<. See also MPEP § 2144.03. **>

IV. REQUEST FOR DESIGNATION AS NEW GROUND OF REJECTION

Appellant cannot request to reopen prosecution pursuant to 37 CFR 41.39(b) if the examiner's answer does not have a new ground of rejection under 37 CFR 41.39. If appellant believes that an examiner's answer contains a new ground of rejection not identified as such, appellant may file a petition under 37 CFR 1.181(a) within two months from the mailing of the examiner's answer requesting that a ground of rejection set forth in the answer be designated as a new ground of rejection. Any such petition must set forth a detailed explanation as to why the ground of rejection set forth in the answer constitutes a new ground of rejection. Any allegation that an examiner's answer contains a new ground of rejection not identified as such is waived if not timely raised (i.e., by filing the petition within two months of the answer) by way of a petition under 37 CFR 1.181(a). The filing of a petition under 37 CFR 1.181 does not toll any time period running. If appellant wishes to present arguments to address the rejection in the examiner's answer, appellant must file a reply brief to the examiner's answer within two months from the mailing date of the examiner's answer. If the TC Director or designee decides that the rejection is considered a new ground of rejection and approves the new ground of rejection, the examiner would be required to send a

corrected examiner's answer that identifies the rejection as a new ground of rejection and includes the approval of the TC Director or designee. The appellant may then file either a request that prosecution be reopened by filing a reply under 37 CFR 1.111, or a request that the appeal be maintained by filing a reply brief or resubmitting the previously-filed reply brief, within two months from the mailing of the corrected answer. If the TC Director or designee agrees with the examiner that the rejection is not a new ground of rejection, the examiner would not be required to send a corrected examiner's answer.

V. APPELLANT'S REPLY TO NEW GROUNDS OF REJECTION

37 CFR 41.39(b) provides that:

if an examiner's answer contains a new ground of rejection, appellant must within two months from the date of the examiner's answer exercise one of the following two options to avoid *sua sponte* dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under § 1.111 of this title with or without amendment or submission of affidavits (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. Any amendment or submission of affidavits or other evidence must be relevant to the new ground of rejection. A request that complies with this paragraph will be entered and the application or the patent under *ex parte* reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. Any request that prosecution be reopened under this paragraph will be treated as a request to withdraw the appeal.

(2) Maintain appeal. Request that the appeal be maintained by filing a reply brief as set forth in § 41.41. Such a reply brief must address each new ground of rejection as set forth in § 41.37(c)(1)(vii) and should follow the other requirements of a brief as set forth in § 41.37(c). A reply brief may not be accompanied by any amendment, affidavit (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. If a reply brief filed pursuant to this section is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under paragraph (b)(1) of this section.

The two month time period for reply is not extendable under 37 CFR 1.136(a), but is extendable under 37 CFR 1.136(b) for patent applications and 37 CFR 1.550(c) for *ex parte* reexamination proceedings. See 37 CFR 41.39(c).

A. Request That Prosecution Be Reopened by Filing a Reply

If appellant requests that prosecution be reopened, the appellant must file a reply that addresses each new ground of rejection set forth in the examiner's answer in compliance with 37 CFR 1.111 within two months from the mailing of the examiner's answer. The reply may also include amendments, evidence, and/or arguments directed to claims not subject to the new ground of rejection or other rejections. If there is an after-final amendment (or affidavit or other evidence) that was not entered, appellant may include such amendment in the reply to the examiner's answer.

If the reply is not fully responsive to the new ground of rejection, but the reply is *bona fide*, the examiner should provide a 30-day or 1 month time period, whichever is longer, for appellant to complete the reply pursuant to 37 CFR 1.135(c). See MPEP § 714.03. If the reply is not *bona fide* (e.g., does not address the new ground of rejection) and the two-month time period has expired, examiner must *sua sponte* dismiss the appeal as to the claims subject to the new ground of rejection. See subsection "C. Failure to Reply to a New Ground of Rejection" below.

Once appellant files a reply in compliance with 37 CFR 1.111 in response to an examiner's answer that contains a new ground of rejection, the examiner must reopen prosecution by entering and considering the reply. The examiner may make the next Office action final unless the examiner introduces a new ground of rejection that is neither necessitated by the applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). See MPEP § 706.07(a).

B. Request That the Appeal Be Maintained by Filing a Reply Brief

If appellant requests that the appeal be maintained, the appellant must file a reply brief that addresses each new ground of rejection set forth in the answer in

compliance with 37 CFR 41.37(c)(1)(vii) within two months from the mailing of the answer. The reply brief should include the following items, with each item starting on a separate page, so as to follow the other requirements of a brief as set forth in 37 CFR 41.37(c):

- (1) Identification page setting forth the appellant's name(s), the application number, the filing date of the application, the title of the invention, the name of the examiner, the art unit of the examiner and the title of the paper (i.e., Reply Brief);
- (2) Status of claims page(s);
- (3) Grounds of rejection to be reviewed on appeal page(s); and
- (4) Argument page(s).

The reply brief can also be a substitute brief replacing the original brief by responding to both the new ground of rejection and all other grounds of rejection covered in the original brief. In such an instance, the reply brief must meet all the requirements of a brief as set forth in 37 CFR 41.37(c).

The reply brief must also be in compliance with requirements set forth in 37 CFR 41.41, e.g., it cannot include any new amendment or affidavit. If the reply brief is accompanied by any amendment or evidence, it would be treated as a request that prosecution be reopened under 37 CFR 41.39(b)(1).

The examiner may provide a supplemental examiner's answer (with TC Director or designee approval) to respond to any new issue raised in the reply brief. The supplemental examiner's answer responding to a reply brief cannot include any new grounds of rejection. See MPEP § 1207.05. In response to the supplemental examiner's answer, the appellant may file another reply brief under 37 CFR 41.41 within 2 months from the mailing of the supplemental examiner's answer. The two month time period for reply is not extendable under 37 CFR 1.136(a), but is extendable under 37 CFR 1.136(b) for patent applications and 37 CFR 1.550(c) for *ex parte* reexamination proceedings. Appellant cannot request that prosecution be reopened pursuant to 37 CFR 41.39(b) at that time.

C. Failure To Reply to a New Ground of Rejection

If appellant fails to timely file a reply under 37 CFR 1.111 or a reply brief in response to an examiner's

answer that contains a new ground of rejection, the appeal will be *sua sponte* dismissed as to the claims subject to the new ground of rejection. If all of the claims under appeal are subject to the new ground of rejection, the entire appeal will be dismissed. The examiner should follow the procedure set forth in MPEP § 1215 to dismiss the appeal. For example, if there is no allowed claim in the application, the application would be abandoned when the two-month time expired.

If only some of the claims under appeal are subject to the new ground of rejection, the dismissal of the appeal as to those claims operates as an authorization to cancel those claims and the appeal continues as to the remaining claims. The examiner must:

- (1) Cancel the claims subject to the new ground of rejection; and
- (2) Notify the appellant that the appeal as to the claims subject to the new ground of rejection is dismissed and those claims are canceled.

Examiner may use form paragraph 12.179.02 to dismiss the claims subject to the new ground of rejection.

¶ **12.179.02 Dismissal Following New Ground(s) of Rejection in Examiner's Answer**

Appellant failed to timely respond to the examiner's answer mailed on [1] that included a new ground of rejection mailed on [1]. Under 37 CFR 41.39(b), if an examiner's answer contains a rejection designated as a new ground of rejection, appellant must, within two months from the date of the examiner's answer, file either: (1) a request that prosecution be reopened by filing a reply under 37 CFR 1.111; or (2) a request that the appeal be maintained by filing a reply brief under 37 CFR 41.41, addressing each new ground of rejection, to avoid *sua sponte* dismissal of the appeal as to the claims subject to the new ground of rejection. In view of appellant's failure to file a reply under 37 CFR 1.111 or a reply brief within the time period required by 37 CFR 41.39, **the appeal as to claims [2] is dismissed, and these claims are canceled.**

Only claims [3] remain in the application. The appeal continues as to these remaining claims. The application will be forwarded to the Board after mailing of this communication.

Examiner Note:

1. In bracket 1, insert the mailing date of the examiner's answer.
2. In bracket 2, insert the claim numbers of the claims subject to the new ground of rejection.
3. In bracket 3, insert the claim numbers of the claims that are not subject to the new ground of rejection.

<

1207.04 Reopening of Prosecution After Appeal [R-8]

The examiner may, with approval from the supervisory patent examiner, reopen prosecution to enter a new ground of rejection after appellant's brief or reply brief has been filed. The Office action containing a new ground of rejection may be made final if the new ground of rejection was (A) necessitated by amendment, or (B) based on information presented in an information disclosure statement under 37 CFR 1.97(c) where no statement under 37 CFR 1.97(e) was filed. See MPEP § 706.07(a). Any after final amendment or affidavit or other evidence that was not entered before must be entered and considered on the merits.

Form paragraph 12.187 may be used when reopening prosecution:

**>

¶ **12.187 Reopening of Prosecution After Appeal Brief or Reply Brief**

In view of the [1] filed on [2], PROSECUTION IS HEREBY REOPENED. [3] set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

[4]

Examiner Note:

1. In bracket 1, insert --appeal brief--, --supplemental appeal brief--, --reply brief-- or --supplemental reply brief--.
2. In bracket 2, insert the date on which the brief was filed.
3. In bracket 3, insert --A new ground of rejection is-- or --New grounds of rejection are--.
4. In bracket 4, insert the SPE's signature. Approval of the SPE is required to reopen prosecution after an appeal. See MPEP §§ 1002.02(d) and 1207.04.
5. Use this form paragraph to reopen prosecution in order to make a new ground of rejection of claims. The Office action following a reopening of prosecution may be made final if all new grounds of rejection were either (A) necessitated by amendment

or (B) based on information presented in an information disclosure statement under 37 CFR 1.97(c) where no statement under 37 CFR 1.97(e) was filed. See MPEP § 706.07(a).

<

After reopening of prosecution, appellant must exercise one of the following options to avoid abandonment of the application:

(A) file a reply under 37 CFR 1.111, if the Office action is non-final;

(B) file a reply under 37 CFR 1.113, if the Office action is final; or

(C) initiate a new appeal by filing a new notice of appeal under 37 CFR 41.31.

If appellant elects to continue prosecution and prosecution was reopened prior to a decision on the merits by the Board of Patent Appeals and Interferences, the fee paid for the notice of appeal, appeal brief, and request for oral hearing (if applicable) will be applied to a later appeal on the same application. If, however, the appeal fees set forth in 37 CFR 41.20 have increased since they were previously paid, applicant must pay the difference between the increased fees and the amount previously paid. If appellant elects to initiate a new appeal by filing a notice of appeal, appellant must file a complete new brief in compliance with the 37 CFR 41.37 within two months from the filing of the new notice of appeal. See MPEP § 1204.01 for more information on reinstatement of an appeal.

**>

1207.05 Supplemental Examiner's Answer [R-3]

37 CFR 41.43. Examiner's response to reply brief.

(a)(1) After receipt of a reply brief in compliance with § 41.41, the primary examiner must acknowledge receipt and entry of the reply brief. In addition, the primary examiner may withdraw the final rejection and reopen prosecution or may furnish a supplemental examiner's answer responding to any new issue raised in the reply brief.

(2) A supplemental examiner's answer responding to a reply brief may not include a new ground of rejection.

(b) If a supplemental examiner's answer is furnished by the examiner, appellant may file another reply brief under § 41.41 to any supplemental examiner's answer within two months from the date of the supplemental examiner's answer.

37 CFR 41.50. Decisions and other actions by the Board.

(a)(1) The Board, in its decision, may affirm or reverse the decision of the examiner in whole or in part on the grounds and on the claims specified by the examiner. The affirmance of the 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. The Board may also remand an application to the examiner.

(2) If a supplemental examiner's answer is written in response to a remand by the Board for further consideration of a rejection pursuant to paragraph (a)(1) of this section, the appellant must within two months from the date of the supplemental examiner's answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding:

(i) *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 affidavits (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. Any amendment or submission of affidavits or other evidence must be relevant to the issues set forth in the remand or raised in the supplemental examiner's answer. A request that complies with this paragraph will be entered and the application or the patent under ex parte reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. Any request that prosecution be reopened under this paragraph will be treated as a request to withdraw the appeal.

(ii) *Maintain appeal.* Request that the appeal be maintained by filing a reply brief as provided in § 41.41. If such a reply brief is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the examiner under paragraph (a)(2)(i) of this section.

Every supplemental examiner's answer must be approved by a Technology Center (TC) Director or designee. The examiner may furnish a supplemental examiner's answer in response to any one of the following:

(A) *A reply brief that raises new issues.* The examiner may NOT include a new ground of rejection in the supplemental examiner's answer responding to a reply brief. See 37 CFR 41.43(a)(2). Appellant may file another reply brief in response to the supplemental examiner's answer within two months from the mailing of the supplemental answer. See MPEP § 1208.

(B) *A remand by the Board for further consideration of a rejection under 37 CFR 41.50(a).* See MPEP § 1211.01. In response to a supplemental examiner's answer that is written in response to a remand by the Board for further consideration of a rejection, appellant must either file: (1) a reply under

37 CFR 1.111 to request that prosecution be reopened; or (2) a reply brief to request that the appeal be maintained, within two months from the mailing of the supplemental examiner's answer, to avoid *sua sponte* dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding. Examiner may include a new ground of rejection in the supplemental examiner's answer responding to a remand by the Board for further consideration of a rejection. See MPEP § 1207.03.

(C) *A remand by the Board for other purposes that are not for further consideration of a rejection under 37 CFR 41.50(a).* The examiner may NOT include a new ground of rejection in the supplemental examiner's answer responding to a remand by the Board, unless the remand is for further consideration of a rejection under 37 CFR 41.50(a) (see item B above). Appellant may file a reply brief with two months from the mailing of the supplemental answer.

I. SUPPLEMENTAL EXAMINER'S ANSWER RESPONDING TO A REPLY BRIEF

In response to a reply brief filed in compliance with 37 CFR 41.41, the primary examiner may: (A) withdraw the final rejection and reopen prosecution (see MPEP § 1207.04); or (B) provide a supplemental examiner's answer responding to any new issue raised in the reply brief. The examiner cannot issue a supplemental examiner's answer if the reply brief raised no new issue. See MPEP § 1208 for more information on reply brief and examiner's response to reply brief. If the reply brief does raise new issues, providing a supplemental examiner's answer will avoid the need for the Board to remand the application or proceeding to the examiner to treat the new issues. Appellant does not have the option to request that prosecution be reopened in response to a supplemental examiner's answer responding to a reply brief unless appellant files a request for continued examination under 37 CFR 1.114 or a continuing application. The following are examples of new issues raised in a reply brief that would give the examiner the discretion to provide a supplemental examiner's answer:

Example 1: The rejection is under 35 U.S.C. 103 over A in view of B. The brief argues that element 4 of reference B cannot be combined with reference A as it would destroy the function performed by refer-

ence A. The reply brief argues that B is nonanalogous art and therefore the two references cannot be combined.

Example 2: Same rejection as in example 1. The brief argues only that the pump means of claim 1 is not taught in the applied prior art. The reply brief argues that the particular retaining means of claim 1 is not taught in the applied prior art.

37 CFR 41.43(a)(2) prohibits a supplemental examiner's answer responding to a reply brief from including a new ground of rejection. After the filing of a reply brief, any new ground of rejection responding to a reply brief must be by way of reopening of prosecution. See MPEP § 1207.04. The examiner's decision to withdraw the final rejection and reopen prosecution to enter a new ground of rejection requires approval from the supervisory patent examiner, which approval must be indicated in the Office action setting forth the new ground of rejection. See MPEP § 1207.04.

It should also be noted that an indication that certain rejections have been withdrawn as a result of the reply brief is not, by itself, a supplemental examiner's answer and is of course permitted. Such an indication of a change in status of claims would not give appellant the right to file another reply brief. The examiner may make the indication on form PTOL-90. An appellant who disagrees with an examiner's decision that a supplemental examiner's answer is permitted may petition for review of the decision under 37 CFR 1.181 within two months from the mailing of the supplemental examiner's answer.

The examiner may use form paragraph 12.184 in the supplemental examiner's answer to respond to a new issue raised in a reply brief.

¶ 12.184 *Supplemental Examiner's Answer -No option to Reopen Prosecution*

Responsive to [1] on [2], a supplemental Examiner's Answer is set forth below: [3].

Appellant may file another reply brief in compliance with 37 CFR 41.41 within two months of the date of mailing of this supplemental examiner's answer. Extensions of time under 37 CFR 1.136(a) are not applicable to this two month time period. See 37 CFR 41.43(b)-(c).

A Technology Center Director or designee has approved this supplemental examiner's answer by signing below:

[4]

Examiner Note:

1. In bracket 1, insert the reason the supplemental examiner's answer is being prepared, e.g., "the remand under 37 CFR

41.50(a)(1) for reasons other than for further consideration of a rejection”, or “the reply brief under 37 CFR 41.41 filed”.

2. In bracket 2, insert the date of remand or the date the reply brief was filed.

3. In bracket 3, provide the supplemental examiner’s answer (e.g., pursuant to 37 CFR 41.43(a), without raising any new grounds of rejection.

4. In bracket 4, insert the TC Director’s or designee’s signature. A TC Director or designee must approve every supplemental examiner’s answer.

II. SUPPLEMENTAL EXAMINER’S ANSWER RESPONDING TO A REMAND FOR FURTHER CONSIDERATION OF REJECTION

The examiner may provide a supplemental examiner’s answer in response to a remand by the Board for further consideration of a rejection under 37 CFR 41.50(a). Appellant must respond to such supplemental examiner’s answer and has the option to request that prosecution be reopened. A supplemental examiner’s answer written in response to a remand by the Board for further consideration of a rejection pursuant to 37 CFR 41.50(a)(1) may set forth a new ground of rejection. Any new ground of rejection made in such a supplemental examiner’s answer must comply with the requirements set forth in MPEP § 1207.03. The examiner may use form paragraph 12.185 in preparing the supplemental examiner’s answer responding to a remand by the Board for further consideration of a rejection.

¶ 12.185 Supplemental Examiner’s Answer - On Remand FOR FURTHER CONSIDERATION OF A REJECTION

Pursuant to the remand under 37 CFR 41.50(a)(1) by the Board of Patent Appeals and Interferences on [1] for further consideration of a rejection, a supplemental Examiner’s Answer under 37 CFR 41.50(a)(2) is set forth below: [2].

The appellant must within **TWO MONTHS** from the date of the supplemental examiner’s answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding:

(1) **Reopen prosecution.** Request that prosecution be reopened before the examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit, or other evidence. Any amendment, affidavit, or other evidence must be relevant to the issues set forth in the remand or raised in the supplemental examiner’s answer. Any request that prosecution be reopened will be treated as a request to withdraw the appeal. See 37 CFR 41.50(a)(2)(i).

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. If such a reply brief is accompanied by any amendment, affidavit or other evi-

dence, it shall be treated as a request that prosecution be reopened under 37 CFR 41.50(a)(2)(i). See 37 CFR 41.50(a)(2)(ii).

Extensions of time under 37 CFR 1.136(a) are not applicable to the **TWO MONTH** time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

A Technology Center Director or designee has approved this supplemental examiner’s answer by signing below:

[3]

Examiner Note:

1. In bracket 1, insert the date of the remand.

2. In bracket 2, provide reasons supporting the rejections set forth in the supplemental Examiner’s Answer.

3. In bracket 3, insert the TC Director’s or designee’s signature. A TC Director or designee must approve every supplemental examiner’s answer.

A. Appellant’s Reply

If a supplemental examiner’s answer is written in response to a remand by the Board for further consideration of a rejection pursuant to 37 CFR 41.50(a)(1), the appellant must exercise one of the following two options to avoid *sua sponte* dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding:

(i) **Reopen prosecution.** Request that prosecution be reopened before the examiner by filing a reply under 37 CFR 1.111 with or without amendment or submission of affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence. Any amendment or submission of affidavits or other evidence must be relevant to the issues set forth in the remand or raised in the supplemental examiner’s answer. A request that complies with 37 CFR 41.50(a)(2)(i) will be entered and the application or the patent under *ex parte* reexamination will be reconsidered by the examiner under the provisions of 37 CFR 1.112. Any request that prosecution be reopened under 37 CFR 41.50(a)(2)(i) will be treated as a request to withdraw the appeal.

(ii) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as provided in 37 CFR 41.41. If such a reply brief is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the examiner under 37 CFR 41.50(a)(2)(i).

The two month time period for reply is not extendable under 37 CFR 1.136(a), but is extendable under

37 CFR 1.136(b) for patent applications and 37 CFR 1.550(c) for *ex parte* reexamination proceedings.

1. Request That Prosecution Be Reopened by Filing a Reply

If appellant requests that prosecution be reopened, the appellant must file a reply that addresses each ground of rejection set forth in the supplemental examiner's answer in compliance with 37 CFR 1.111 within two months from the mailing of the supplemental examiner's answer. The reply may also include amendments, evidence, and/or arguments directed to claims not subject to the ground of rejection set forth in the supplemental answer or other rejections. If there is after-final amendment (or affidavit or other evidence) that was not entered, appellant may include such amendment in the reply to the supplemental examiner's answer.

If the reply is not fully responsive to the ground of rejection set forth in the supplemental examiner's answer, but the reply is *bona fide*, the examiner should provide a 30-day or 1 month time period, whichever is longer, for appellant to complete the reply pursuant to 37 CFR 1.135(c). If the reply is not *bona fide* (e.g., does not address the ground of rejection) and the two-month time period has expired, the examiner must *sua sponte* dismiss the appeal as to the claims subject to the rejection for which the Board has remanded the case.

Once appellant files a reply in compliance with 37 CFR 1.111 in response to a supplemental examiner's answer responding to a remand by the Board for further consideration of a rejection under 37 CFR 41.50(a), the examiner must reopen prosecution by entering and considering the reply. Examiner may make the next Office action final unless the examiner introduces a new ground of rejection that is neither necessitated by the applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). See MPEP § 706.07(a).

2. Request That the Appeal Be Maintained by Filing a Reply Brief

If appellant requests that the appeal be maintained, the appellant must file a reply brief to address each grounds of rejection set forth in the supplemental

examiner's answer in compliance with 37 CFR 41.37(c)(1)(vii) within two months from the mailing of the supplemental answer. The reply brief must also be in compliance with requirements set forth in 37 CFR 41.41 (e.g., it cannot include any new amendment or affidavit). If the reply brief is accompanied by an amendment, affidavit or other evidence, it will be treated as a request that prosecution be reopened before the examiner.

The examiner may provide another supplemental examiner's answer (with TC Director or designee approval) to respond to any new issue raised in the reply brief. The supplemental examiner's answer responding to a reply brief cannot include any new grounds of rejection. See MPEP § 1207.05. In response to the supplemental examiner's answer, the appellant may file another reply brief under 37 CFR 41.41 within 2 months from the mailing of the supplemental examiner's answer. The two month time period for reply is not extendable under 37 CFR 1.136(a), but is extendable under 37 CFR 1.136(b) for patent applications and 37 CFR 1.550(c) for *ex parte* reexamination proceedings. Appellant cannot request that prosecution be reopened pursuant to 37 CFR 41.50(a) at that time.

B. Failure To Reply to a Supplemental Examiner's Answer Under 37 CFR 41.50(a)

If appellant fails to timely file a reply under 37 CFR 1.111 or a reply brief in response to a supplemental examiner's answer that was written in response to a remand by the Board for further consideration of a rejection under 37 CFR 41.50(a), the appeal will be *sua sponte* dismissed as to the claims subject to the rejection for which the Board has remanded the proceeding. If all of the claims under appeal are subject to the rejection, the entire appeal will be dismissed. The examiner should follow the procedure set forth in MPEP § 1215 to dismiss the appeal. For example, if there is no allowed claim in the application, the application would be abandoned when the two-month time period has expired.

If only some of the claims under appeal are subject to the rejection, the dismissal of the appeal as to those claims operates as an authorization to cancel those claims and the appeal continues as to the remaining claims. The examiner must:

- (1) cancel the claims subject to the rejection; and

(2) notify the appellant that the appeal as to the claims subject to the rejection is dismissed and those claims are canceled.

Examiner may use form paragraph 12.186 to dismiss the appeal as to the claims subject to the rejection and cancel the claims.

¶ 12.186 Dismissal Following A Supplemental Examiner's Answer Written in Response to a Remand for Further Consideration of a Rejection

Appellant failed to timely respond to the supplemental examiner's answer mailed on [1] that was written in response to a remand by the Board for further consideration of a rejection mailed on [1]. Under 37 CFR 41.50(a)(2), appellant must, within two months from the date of the supplemental examiner's answer, file either: (1) a request that prosecution be reopened by filing a reply under 37 CFR 1.111; or (2) a request that the appeal be maintained by filing a reply brief under 37 CFR 41.41, to avoid sua sponte dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding. In view of appellant's failure to file a reply under 37 CFR 1.111 or a reply brief within the time period required by 37 CFR 41.50(a)(2), **the appeal as to claims [2] is dismissed, and these claims are canceled.**

Only claims [3] remain in the application. The appeal continues as to these remaining claims. The application will be forwarded to the Board after mailing of this communication.

Examiner Note:

1. In bracket 1, insert the mailing date of the supplemental examiner's answer.
2. In bracket 2, insert the claim numbers of the claims subject to the rejection for which the Board has remanded the proceeding.
3. In bracket 3, insert the claim numbers of the claims that are not subject to the rejection.

III. SUPPLEMENTAL EXAMINER'S ANSWER RESPONDING TO A REMAND FOR OTHER PURPOSES THAT ARE NOT FOR FURTHER CONSIDERATION OF REJECTION

The Board may remand an application to the examiner for a reason that is not for further consideration of a rejection, such as to consider an information disclosure statement, a reply brief that raised new issues that were not considered by the examiner, an amendment, or an affidavit. See MPEP § 1211. The examiner may provide a supplemental examiner's answer in response to the remand by the Board. Appellant may respond by filing a reply brief within two months from the mailing of the supplemental answer. Appellant does not have the option to request that prosecution

be reopened pursuant to 37 CFR 41.50(a) unless the remand by the Board is for further consideration of a rejection under 37 CFR 41.50(a).<

**>

1208 Reply Briefs and Examiner's Responses to Reply Brief< [R-3]

**>

37 CFR 41.41. Reply brief.

(a)(1)Appellant may file a reply brief to an examiner's answer within two months from the date of the examiner's answer.

(2) A reply brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.

(b) A reply brief that is not in compliance with paragraph (a) of this section will not be considered. Appellant will be notified if a reply brief is not in compliance with paragraph (a) of this section.

(c) Extensions of time under § 1.136 (a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136 (b) of this title for extensions of time to reply for patent applications and § 1.550 (c) of this title for extensions of time to reply for ex parte reexamination proceedings.

37 CFR 41.43. Examiner's response to reply brief.

(a)(1)After receipt of a reply brief in compliance with § 41.41, the primary examiner must acknowledge receipt and entry of the reply brief. In addition, the primary examiner may withdraw the final rejection and reopen prosecution or may furnish a supplemental examiner's answer responding to any new issue raised in the reply brief.

(2) A supplemental examiner's answer responding to a reply brief may not include a new ground of rejection.

(b) If a supplemental examiner's answer is furnished by the examiner, appellant may file another reply brief under § 41.41 to any supplemental examiner's answer within two months from the date of the supplemental examiner's answer.

(c) Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings.

I. REPLY BRIEF

Under 37 CFR 41.41(a)(1) and 41.43(b), appellant may file a reply brief as a matter of right within 2 months from the mailing date of the examiner's answer or supplemental examiner's answer. Extensions of time to file the reply brief may be granted pursuant to 37 CFR 1.136(b) (for patent applications)

or 1.550(c) (for *ex parte* reexamination proceedings). Extensions of time under 37 CFR 1.136(a) are not permitted. The examiner may provide a supplemental examiner's answer to respond to any reply brief that raises new issues. See MPEP § 1207.05. Normally, appellant is not required to file a reply brief to respond to an examiner's answer or a supplemental examiner's answer, and if appellant does not file a reply brief within the two month period of time, the application will be forwarded to the Board for decision on the appeal. In response to the following, however, appellant is required to file either a reply brief to maintain the appeal or a reply under 37 CFR 1.111 to reopen prosecution:

(A) An examiner's answer that contains a new ground of rejection pursuant to 37 CFR 41.39 (see MPEP § 1207.03); or

(B) A supplemental examiner's answer responding to a remand by the Board for further consideration of a rejection pursuant to 37 CFR 41.50(a) (see MPEP § 1207.05). Such a supplemental examiner's answer may contain a new ground of rejection (also see MPEP § 1207.03).

If appellant requests that the appeal be maintained in response to a new ground of rejection made in an examiner's answer or a supplemental examiner's answer, the appellant must file a reply brief to address each new grounds of rejection set forth in the answer in compliance with 37 CFR 41.37(c)(1)(vii) within two months from the mailing of the answer. The reply brief should include the following items, with each item starting on a separate page, so as to follow the other requirements of a brief as set forth in 37 CFR 41.37(c):

(A) Identification page setting forth the appellant's name(s), the application number, the filing date of the application, the title of the invention, the name of the examiner, the art unit of the examiner and the title of the paper (i.e., Reply Brief);

(B) Status of claims page(s);

(C) Grounds of rejection to be reviewed on appeal page(s); and

(D) Argument page(s).

The reply brief can also be a substitute brief replacing the original brief by responding to both the new

ground of rejection and all other grounds of rejection covered in the original brief. In such an instance, the reply brief must meet all the requirements of a brief as set forth in 37 CFR 41.37(c).

Any reply brief must also be in compliance with requirements set forth in 37 CFR 41.41. New or non-admitted affidavits, and/or other evidence are not permitted in a reply brief. Any new amendment must be submitted in papers separate from the reply brief, and the entry of such papers is subject to the provisions of 37 CFR 41.33. A paper that contains an amendment is not a reply brief within the meaning of 37 CFR 41.41. Such a paper will not be entitled to entry simply because it is characterized as a reply brief.

If a reply brief is filed in response to a supplemental examiner's answer under 37 CFR 41.50(a) that was written in response to a remand by the Board for further consideration of a rejection, any reply brief accompanied by an amendment, affidavit or other evidence will be treated as a request that prosecution be reopened before the examiner. If appellant fails to file a reply brief or a reply under 37 CFR 1.111 within two months from the mailing of the examiner's answer that contains a new ground of rejection, or a supplemental examiner's answer under 37 CFR 41.50(a), the examiner will dismiss the appeal as to the claims subject to the new ground of rejection or the rejection for which the Board has remanded the proceeding. See MPEP § 1207.03 and § 1207.05.

II. EXAMINER'S RESPONSE TO A REPLY BRIEF

If a reply brief is not in compliance with 37 CFR 41.41, the examiner must notify appellant that the reply brief has not been considered and the reason for non-compliance. The examiner may use form paragraph 12.182 on Form PTOL-90 to notify the appellant.

¶ 12.182 Reply Brief Not Considered

The reply brief filed on [1] has not been considered because it is not in compliance with 37 CFR 41.41(a). The reply brief [2].

Examiner Note:

1. In bracket 1, insert the date on which the reply brief was filed.

2. In bracket 2, insert the reasoning. For example, insert "was not filed within the non-extendable time period set in 37 CFR 41.41(a)(1)" or insert "included a new or non-admitted amendment or new or non-admitted affidavit or other evidence".

3. Use this form paragraph to notify the appellant under 37 CFR 41.41(b) that a reply brief is not being considered because it is not in compliance with 37 CFR 41.41(a).

If a reply brief is filed in compliance with 37 CFR 41.41, the primary examiner must acknowledge receipt and entry of the reply brief. The examiner may use form paragraph 12.181 on Form PTOL-90 to provide the acknowledgment.

¶ 12.181 *Acknowledgment of Reply Brief*

The reply brief filed [1] has been entered and considered. The application has been forwarded to the Board of Patent Appeals and Interferences for decision on the appeal.

Examiner Note:

1. In bracket 1, insert the date on which the reply brief was filed.
2. Use this form paragraph to notify the appellant under 37 CFR 41.43(a)(1) that a reply brief has been received and entered.
3. This form paragraph is to be printed on a blank page for attachment to a PTOL-90 or PTO-90C.
4. Include form paragraph 12.184 after this paragraph to include a supplemental examiner's answer under 37 CFR 41.43(a)(1) responding to any new issue raised in the reply brief.

In addition, the examiner may:

(A) Withdraw the final rejection and reopen prosecution to respond to the reply brief (see MPEP § 1207.04); or

(B) Furnish a supplemental examiner's answer responding to any new issue raised in the reply brief (see MPEP § 1207.05).

Any supplemental examiner's answer responding to a new issue raised in a reply brief must be approved by the Technology Center (TC) Director or designee. 37 CFR 41.43(a)(2) prohibits a supplemental examiner's answer responding to a reply brief from including a new ground of rejection. After the filing of a reply brief, any new ground of rejection responding to a reply brief must be by way of reopening of prosecution. See MPEP § 1207.04. The examiner's decision to withdraw the final rejection and reopen prosecution to enter a new ground of rejection requires approval from the supervisory patent examiner, which approval must be indicated in the Office action setting forth the new ground of rejection. See MPEP § 1207.04.

In response to the supplemental examiner's answer, the appellant may file another reply brief under 37 CFR 41.41 within 2 months from the mailing of the supplemental examiner's answer. The two month time period for reply is not extendable under 37 CFR

1.136(a), but is extendable under 37 CFR 1.136(b) for patent applications and 37 CFR 1.550(c) for *ex parte* reexamination proceedings. Appellant cannot request that prosecution be reopened pursuant to 37 CFR 41.39(b) or 41.50(a) at that time.

The acknowledgment of receipt and entry of a reply brief under 37 CFR 41.41 is an indication by the examiner that no further response by the examiner is deemed necessary. It should also be noted that an indication that certain rejections have been withdrawn as a result of the reply brief is not, by itself, a supplemental examiner's answer and is permitted. Such an indication of a change in status of claims would not give appellant the right to file another reply brief. The examiner may make the indication on form PTOL-90.<

1209 Oral Hearing [R-3]

**>

37 CFR 41.47. *Oral hearing.*

(a) An oral hearing should be requested only in those circumstances in which appellant considers such a hearing necessary or desirable for a proper presentation of the appeal. An appeal decided on the briefs without an oral hearing will receive the same consideration by the Board as appeals decided after an oral hearing.

(b) If appellant desires an oral hearing, appellant must file, as a separate paper captioned "REQUEST FOR ORAL HEARING," a written request for such hearing accompanied by the fee set forth in § 41.20(b)(3) within two months from the date of the examiner's answer or supplemental examiner's answer.

(c) If no request and fee for oral hearing have been timely filed by appellant as required by paragraph (b) of this section, the appeal will be assigned for consideration and decision on the briefs without an oral hearing.

(d) If appellant has complied with all the requirements of paragraph (b) of this section, a date for the oral hearing will be set, and due notice thereof given to appellant. If an oral hearing is held, an oral argument may be presented by, or on behalf of, the primary examiner if considered desirable by either the primary examiner or the Board. A hearing will be held as stated in the notice, and oral argument will ordinarily be limited to twenty minutes for appellant and fifteen minutes for the primary examiner unless otherwise ordered.

(e)(1) Appellant will argue first and may reserve time for rebuttal. At the oral hearing, appellant may only rely on evidence that has been previously entered and considered by the primary examiner and present argument that has been relied upon in the brief or reply brief except as permitted by paragraph (e)(2) of this section. The primary examiner may only rely on argument and evidence relied upon in an answer or a supplemental answer except as permitted by paragraph (e)(2) of this section.

(2) Upon a showing of good cause, appellant and/or the primary examiner may rely on a new argument based upon a recent relevant decision of either the Board or a Federal Court.

(f) Notwithstanding the submission of a request for oral hearing complying with this rule, if the Board decides that a hearing is not necessary, the Board will so notify appellant.

(g) Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time periods set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for *ex parte* reexamination proceedings.<

37 CFR *>41.47(b)< provides that an appellant who desires an oral hearing before the Board must request the hearing by filing, in a separate paper >captioned “REQUEST FOR ORAL HEARING,”< a written request therefor, accompanied by the appropriate fee set forth in 37 CFR *>41.20(b)(3)<, within 2 months after the date of the examiner’s answer >or supplemental examiner’s answer. Form PTO/SB/32 may be used to request an oral hearing<. This time period may only be extended by filing a request under either 37 CFR 1.136(b) or, if the appeal involves an *ex parte* reexamination proceeding, under 37 CFR 1.550(c).

>If the written request for an oral hearing is not filed in a separate paper captioned “REQUEST FOR ORAL HEARING,” the request is improper and the appeal will be assigned for consideration and decision on the briefs without an oral hearing. Likewise, if the request is not timely filed or accompanied by the appropriate fee, the request is improper and the appeal will be assigned for consideration and decision on the briefs without an oral hearing.<

A notice of hearing, stating the date, the time, and the docket, is forwarded to the appellant in due course. If appellant fails to confirm >the hearing< within the time required in the notice of hearing >or the appellant waives the hearing<, the appeal will be removed from the hearing docket and assigned on brief in due course. No refund of the fee for requesting an oral hearing will be made. Similarly, after confirmation, if no appearance is made at the scheduled hearing, the appeal will be decided on brief. Since failure to notify the Board of waiver of hearing in advance of the assigned date results in a waste of the Board’s resources, appellant should inform the Board of a change in plans at the earliest possible opportunity. If the Board determines that a hearing is not necessary (e.g., a remand to the examiner is necessary or

it is clear that the rejection(s) cannot be sustained), appellant will be notified.

If appellant has any special request, such as for a particular date or day of the week, this will be taken into consideration in setting the hearing, if made known to the Board in advance, as long as such request does not unduly delay a decision in the case and does not place an undue administrative burden on the Board.

The appellant may also file a request, in a paper addressed to the Chief Clerk of the Board, to present his/her arguments via telephone. The appellant making the request will be required to bear the cost of the telephone call.

If the time set in the notice of hearing conflicts with prior commitments or if subsequent events make appearance impossible, the hearing may be rescheduled on written request>, in a paper addressed to the Chief Clerk of the Board<. However, in view of the administrative burden involved in rescheduling hearings and the potential delay which may result in the issuance of any patent based on the application on appeal, postponements are discouraged and will not be granted in the absence of convincing reasons in support of the requested change.

Normally, 20 minutes are allowed for appellant to explain his or her position. If appellant believes that additional time will be necessary, a request for such time should be made well in advance and will be taken into consideration in assigning the hearing date. The final decision on whether additional time is to be granted rests within the discretion of the senior member of the panel hearing the case.

>At the oral hearing, appellant may only rely on evidence that has been previously entered and considered by the primary examiner and present arguments that have been relied upon in the brief or reply brief. Upon a showing of good cause, appellant and/or the primary examiner may rely on a new argument based upon a recent relevant decision of either the Board or a Federal Court.

Where the appeal involves reexamination proceedings, subject to the admittance procedures established by the Board, oral hearings are open to the public as observers unless the appellant (A) requests that the hearing not be open to the public, and (B) presents valid reasons for such a request. The Board’s current public admittance procedure is to permit a third party

observer to watch an oral hearing involving a reexamination proceeding provided the hearing has not been closed per the appellant's request and the third party observer has obtained prior written permission from the Board to observe the hearing.

37 CFR 41.47(f) provides that notwithstanding the submission of a request for oral hearing, if the Board decides that a hearing is not necessary, the Board will so notify appellant. Examples as to when it would be appropriate for the Board to decide that an oral hearing is not necessary include those where the Board has become convinced, prior to hearing, that an application must be remanded for further consideration prior to evaluating the merits of the appeal or that the examiner's position cannot be sustained.<

PARTICIPATION BY EXAMINER

If the appellant has requested an oral hearing and the primary examiner wishes to appear and present an oral argument before the Board, a request to present oral argument must be **>set forth in a separate letter on a form PTOL-90 using form paragraph 12.163.<

>

¶ 12.163 Request to Present Oral Arguments

The examiner requests the opportunity to present arguments at the oral hearing.

Examiner Note:

1. Use this form paragraph only if an oral hearing has been requested by appellant and the primary examiner intends to present an oral argument.

2. This form paragraph must be included as a separate letter on a form PTOL-90.

<

In those appeals in which an oral hearing has been confirmed and either the primary examiner or the Board has indicated a desire for the examiner to participate in the oral argument, oral argument may be presented by the examiner whether or not appellant appears.

After the oral hearing has been confirmed and the date set as provided in 37 CFR *>41.47(d)<, the **>examiner and the examiner's supervisor should be notified via e-mail of the date and time< of the hearing. In those cases where the Board requests the presentation of an oral argument by or on behalf of the primary examiner, the Board's request may, where

appropriate, indicate specific points or questions to which the argument should be particularly directed.
**

At the hearing, after the appellant has made his or her presentation, the examiner will be allowed 15 minutes to reply as well as to present a statement which clearly sets forth his or her position with respect to the issues and rejections of record. >The primary examiner may only rely on argument and evidence relied upon in the examiner's answer or the supplemental examiner's answer.< Appellant may utilize any allotted time not used in the initial presentation for rebuttal.
**

1210 Actions Subsequent to Examiner's Answer but Before Board's Decision [R-3]

>

I. < JURISDICTION OF BOARD

>

37 CFR 41.35. Jurisdiction over appeal.

(a) Jurisdiction over the proceeding passes to the Board upon transmittal of the file, including all briefs and examiner's answers, to the Board.

(b) If, after receipt and review of the proceeding, the Board determines that the file is not complete or is not in compliance with the requirements of this subpart, the Board may relinquish jurisdiction to the examiner or take other appropriate action to permit completion of the file.

(c) Prior to the entry of a decision on the appeal by the Board, the Director may sua sponte order the proceeding remanded to the examiner.<

The application file and jurisdiction of the application are normally transferred from the Technology Centers to the Board at one of the following times:

(A) After 2 months from the examiner's answer >or supplemental examiner's answer<, plus mail room time, if no reply brief has been timely filed.

(B) After ** the examiner has notified the appellant by written communication that the reply brief has been entered and considered and that the application will be forwarded to the Board (for example, by mailing a PTOL-90 with form paragraph *>12.181<, as described in MPEP § *>1208<).

Any amendment ** or other paper relating to the appeal filed thereafter but prior to the decision of the

Board, may be considered by the examiner only in the event the case is remanded by the Board for that purpose.

>

II. < DIVIDED JURISDICTION

Where appeal is taken from the second or final rejection only of one or more claims presented for the purpose of provoking an interference, jurisdiction of the rest of the case remains with the examiner, and prosecution of the remaining claims may proceed as though the entire case was under his or her jurisdiction. Also, where the examiner certifies in writing that there is no conflict of subject matter and the administrative patent judge in charge of the interference approves, an appeal to the Board may proceed concurrently with an interference. See MPEP *Chapter 2300<.

>

III. < ABANDONMENT OF APPEAL: APPLICATION REFILED OR ABANDONED

To avoid the rendering of decisions by the Board in applications which >appellants< have **>decided to abandon or to refile< as continuations, appellants should promptly inform the *>Chief Clerk< of the Board in writing as soon as they have positively decided to refile or to abandon an application containing an appeal awaiting a decision. Failure to exercise appropriate diligence in this matter may result in the Board's refusing an otherwise proper request to vacate its decision.

See MPEP § 1215.01 - § 1215.03 concerning the withdrawal of appeals.

**

1211 Remand by Board [R-3]

The Board has authority to remand a case to the examiner when it deems it necessary. For example, the Board may remand **>a case for further consideration of a rejection pursuant to 37 CFR 41.50(a)(1) such as< where the pertinence of the references is not clear, the Board may call upon the examiner for a further explanation. >See MPEP § 1211.01.< In the case of multiple rejections of a cumulative nature, the Board may also remand for selection of the preferred or best ground. The Board may also remand a case to

the examiner for further search where it feels that the most pertinent art has not been cited, or to consider an amendment**. See MPEP * § 1211.02, * § 1211.03 >and § 1211.04<. Furthermore, the Board may remand an application to the examiner to prepare a supplemental examiner's answer in response to a reply brief **>which the examiner only acknowledged receipt and entry thereof (e.g., by using form paragraph 12.181 on form PTOL-90). See MPEP § 1207.05 for more information on supplemental examiner's answer<.

>

1211.01 Remand by Board for Further Consideration of Rejection [R-3]

A supplemental examiner's answer written in response to a remand by the Board for further consideration of a rejection pursuant to 37 CFR 41.50(a)(1) may set forth a new ground of rejection. See MPEP § 1207.03.

If a supplemental examiner's answer is written in response to a remand by the Board for further consideration of a rejection pursuant to 37 CFR 41.50(a)(1) (even when there is no new ground of rejection made in the supplemental examiner's answer), the appellant must exercise one of the following two options to avoid *sua sponte* dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding:

(A) *Reopen prosecution.* Request that prosecution be reopened before the examiner by filing a reply under 37 CFR 1.111 with or without amendment or submission of affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence. Any amendment or submission of affidavits or other evidence must be relevant to the issues set forth in the remand or raised in the supplemental examiner's answer. A request that complies with 37 CFR 41.50(a)(2)(i) will be entered and the application or the patent under *ex parte* reexamination will be reconsidered by the examiner under the provisions of 37 CFR 1.112. Any request that prosecution be reopened under 37 CFR 41.50(a)(2)(i) will be treated as a request to withdraw the appeal.

(B) *Maintain appeal.* Request that the appeal be maintained by filing a reply brief as provided in 37 CFR 41.41. If such a reply brief is accompanied by any amendment, affidavit or other evidence, it shall be

treated as a request that prosecution be reopened before the examiner under 37 CFR 41.50(a)(2)(i).

See MPEP § 1207.03 for information on new ground of rejection.

See MPEP § 1207.05 for information on supplemental examiner's answer and appellant's response to a supplemental examiner's answer.

See MPEP § 1208 on reply briefs and examiner's responses to reply briefs.

The following are two examples of situations where there may be a remand by the Board for examiner action that is not for further consideration of a rejection:

(A) A remand to consider an Information Disclosure Statement; and

(B) A remand for the examiner to consider a reply brief.

37 CFR 41.50(a)(2) does not apply when the remand by the Board is not for further consideration of a rejection. The Board will normally indicate in the remand whether 37 CFR 41.50(a)(2)(i) applies. Appellant cannot request that prosecution be reopened under 37 CFR 41.50(a)(2)(i) and is not required to reply to a supplemental examiner's answer that is written in response to a remand that is not for further consideration of a rejection.

The following form paragraphs may be used in preparing the supplemental examiner's answer after a remand from the Board:

¶ 12.184 *Supplemental Examiner's Answer - No option to Reopen Prosecution*

Responsive to [1] on [2], a supplemental Examiner's Answer is set forth below: [3].

Appellant may file another reply brief in compliance with 37 CFR 41.41 within two months of the date of mailing of this supplemental examiner's answer. Extensions of time under 37 CFR 1.136(a) are not applicable to this two month time period. See 37 CFR 41.43(b)-(c).

A Technology Center Director or designee has approved this supplemental examiner's answer by signing below:

[4]

Examiner Note:

1. In bracket 1, insert the reason the supplemental examiner's answer is being prepared, e.g., "the remand under 37 CFR 41.50(a)(1) for reasons other than for further consideration of a rejection", or "the reply brief under 37 CFR 41.41 filed".

2. In bracket 2, insert the date of remand or the date the reply brief was filed.

3. In bracket 3, provide the supplemental examiner's answer (e.g., pursuant to 37 CFR 41.43(a), without raising any new grounds of rejection.

4. In bracket 4, insert the TC Director's or designee's signature. A TC Director or designee must approve every supplemental examiner's answer.

¶ 12.185 *Supplemental Examiner's Answer - On Remand FOR FURTHER CONSIDERATION OF A REJECTION*

Pursuant to the remand under 37 CFR 41.50(a)(1) by the Board of Patent Appeals and Interferences on [1] for **further consideration of a rejection**, a supplemental Examiner's Answer under 37 CFR 41.50(a)(2) is set forth below: [2].

The appellant must within **TWO MONTHS** from the date of the supplemental examiner's answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding:

(1) **Reopen prosecution.** Request that prosecution be reopened before the examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit, or other evidence. Any amendment, affidavit, or other evidence must be relevant to the issues set forth in the remand or raised in the supplemental examiner's answer. Any request that prosecution be reopened will be treated as a request to withdraw the appeal. See 37 CFR 41.50(a)(2)(i).

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. If such a reply brief is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened under 37 CFR 41.50(a)(2)(i). See 37 CFR 41.50(a)(2)(ii).

Extensions of time under 37 CFR 1.136(a) are not applicable to the **TWO MONTH** time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

A Technology Center Director or designee has approved this supplemental examiner's answer by signing below:

[3]

Examiner Note:

1. In bracket 1, insert the date of the remand.

2. In bracket 2, provide reasons supporting the rejections set forth in the supplemental Examiner's Answer.

3. In bracket 3, insert the TC Director's or designee's signature. A TC Director or designee must approve every supplemental examiner's answer.

The supervisory patent examiner must approve any action in which a remanded application is withdrawn from appeal. See MPEP § 706.07(e) and § 1002.02(d). If the examiner decides to withdraw the final rejection and reopen prosecution to enter a new ground of rejection, approval from the supervisory patent examiner is required. See MPEP § 1207.04.<

*>

1211.02 < Remand by Board To Consider Amendment [R-3]

There is no obligation resting on the Board to consider new or amended claims submitted while it has jurisdiction of the appeal. *In re Sweet*, 136 F.2d 722, 58 USPQ 327 (CCPA 1943). However, a proposed amendment **>filed after the date of filing of a brief to either cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, or to rewrite dependent claims into independent form< may be remanded for * consideration *>by< the examiner**. See MPEP § *>1206<.

If the proposed amendment is in effect an abandonment of the appeal, e.g., by canceling the appealed claims, the amendment *>must< be entered and the *>Chief Clerk< of the Board notified in order that the case may be removed from the Board's docket.

*>

1211.03 < Remand by Board To Consider Affidavits or Declarations [R-3]

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Affidavits or declarations filed with ** the filing of a notice of appeal but before jurisdiction passes to the Board (see MPEP § *>1206<) will be considered for entry only if the appellant makes the necessary showing under 37 CFR *>1.116(e)< as to why they >are necessary and< were not earlier presented. Authority from the Board is not necessary to consider such affidavits or declarations. Affidavits or declarations filed after a final rejection and prior to a notice of appeal are handled as provided in MPEP § 715.09, § 716, and § 716.01. >If such evidence has not been treated by the examiner, the Board may remand the proceeding to permit the examiner to consider such evidence.<

In the case of affidavits or declarations filed after the **>filing of a notice of appeal<, but before a decision thereon by the Board, the examiner is without authority to consider the same **>unless the examiner determines that the affidavit or other evidence overcomes all rejections under appeal and that a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented have been made. See MPEP § 1206.<

It is not the custom of the Board to remand affidavits or declarations offered in connection with a request for rehearing of its decision where no rejection has been made under 37 CFR *>41.50(b)<. Affidavits or declarations submitted for this purpose, not remanded to the examiner, are considered only as arguments. *In re Martin*, 154 F.2d 126, 69 USPQ 75 (CCPA 1946).

For remand to the examiner to consider appellant's response relating to a 37 CFR *>41.50(b)< rejection, see MPEP § 1214.01.

*>

1211.04 < Remand by Board for Further Search [R-3]

It should be >extremely< rare for the Board to remand a case to the examiner for further search. A remand to the examiner extends the total pendency of an application and may necessitate an extension of the patent term under 35 U.S.C. 154(b). See MPEP § 2710. When such a remand is necessary, the Board should conduct a search (on-line or otherwise) of at least one subclass and cite art from that subclass to demonstrate the basis on which it concludes that a search of this area would be *>material<. The art cited need not be art upon which a rejection can be made.

1212 Board Requires Appellant to Address Matter [R-3]

**>

37 CFR 41.50. *Decisions and other actions by the Board.*

(d) The Board may order appellant to additionally brief any matter that the Board considers to be of assistance in reaching a reasoned decision on the pending appeal. Appellant will be given a non-extendable time period within which to respond to such an order. Failure to timely comply with the order may result in the sua sponte dismissal of the appeal.<

37 CFR *>41.50(d)< authorizes the Board to **>additionally brief< any matter deemed appropriate for a reasoned decision on the appeal. This may include, for example: (A) the applicability of particular case law that has not been previously identified as relevant to an issue in the appeal; or (B) the applicability of prior art that has not been made of record.

The rule further provides that the appellant will be given a non-extendable time period within which to respond to the requirement. Failure to respond within the time period set by the Board may result in dismissal of the appeal.

The making of a requirement under 37 CFR 41.50(d) is discretionary with the Board. The authority granted in 37 CFR 41.50(d) does not affect the Board's authority to remand a case to the examiner in a situation where the Board considers action by the examiner in the first instance to be necessary or desirable. See MPEP § 1211. Also, after an appellant has replied to a requirement under 37 CFR 41.50(d), a remand by the Board to the examiner may be appropriate to permit the examiner to respond to the appellant's response to the Board's order.

1213 Decision by Board [R-3]

**>

37 CFR 41.50. Decisions and other actions by the Board.

(a)(1) The Board, in its decision, may affirm or reverse the decision of the examiner in whole or in part on the grounds and on the claims specified by the examiner. The affirmance of the 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. The Board may also remand an application to the examiner.

(2) If a supplemental examiner's answer is written in response to a remand by the Board for further consideration of a rejection pursuant to paragraph (a)(1) of this section, the appellant must within two months from the date of the supplemental examiner's answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding:

(i) *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 affidavits (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. Any amendment or submission of affidavits or other evidence must be relevant to the issues set forth in the remand or raised in the supplemental examiner's answer. A request that complies with this paragraph will be entered and the application or the patent under ex parte reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. Any request that prosecution be reopened under this paragraph will be treated as a request to withdraw the appeal.

(ii) *Maintain appeal.* Request that the appeal be maintained by filing a reply brief as provided in § 41.41. If such a reply brief is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the examiner under paragraph (a)(2)(i) of this section.

(b) Should the Board have knowledge of any grounds not involved in the appeal for rejecting any pending claim, it may include in its opinion a statement to that effect with its reasons for so holding, which statement constitutes a new ground of rejection of the claim. A new ground of rejection pursuant to this paragraph shall not be considered final for judicial review. When the Board makes a new ground of rejection, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new evidence not previously of record is made which, in the opinion of the examiner, overcomes the new ground of rejection stated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

(c) The opinion of the Board may include an explicit statement of how a claim on appeal may be amended to overcome a specific rejection. When the opinion of the Board includes such a statement, appellant has the right to amend in conformity therewith. An amendment in conformity with such statement will overcome the specific rejection. An examiner may reject a claim so amended, provided that the rejection constitutes a new ground of rejection.

(d) The Board may order appellant to additionally brief any matter that the Board considers to be of assistance in reaching a reasoned decision on the pending appeal. Appellant will be given a non-extendable time period within which to respond to such an order. Failure to timely comply with the order may result in the sua sponte dismissal of the appeal.

(e) Whenever a decision of the Board includes a remand, that decision shall not be considered final for judicial review. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board may enter an order otherwise making its decision final for judicial review.

(f) Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time periods set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings.

After consideration of the record including appellant's briefs and the examiner's answers, the Board writes its decision, affirming the examiner in whole or in part, or reversing the examiner's decision,

sometimes also setting forth a new ground of rejection.

37 CFR *41.50(e)< provides that a decision of the Board which includes a remand will not be considered **>final for judicial review<. The Board, following conclusion of the proceedings before the examiner, will either adopt its earlier decision as final >for judicial review< or will render a new decision based on all appealed claims, as it considers appropriate. In either case, final action by the Board will give rise to the alternatives available to an appellant following a decision by the Board.

On occasion, the Board has refused to consider an appeal until after the conclusion of a pending civil action or appeal to the Court of Appeals for the Federal Circuit involving issues identical with and/or similar to those presented in the later appeal. Such suspension of action, postponing consideration of the appeal until the Board has the benefit of a court decision which may be determinative of the issues involved, has been recognized as sound practice. An appellant is not entitled, after obtaining a final decision by the U.S. Patent and Trademark Office on an issue in a case, to utilize the prolonged pendency of a court proceeding as a means for avoiding *res judicata* while relitigating the same or substantially the same issue in another application.

An applicant may *>petition< that the decision be withheld to permit the refiling of the application at any time prior to the mailing of the decision. Up to 30 days may be granted, although the time is usually limited as much as possible. The Board will be more prone to entertain the applicant's *>petition< where the *>petition< is filed early, obviating the necessity for an oral hearing or even for the setting of the oral hearing date. If the case has already been set for oral hearing, the petition should include a request to vacate the hearing date, *not* to postpone it.

In a situation where a withdrawal of the appeal is filed on the same day that the decision is mailed, a petition to vacate the decision will be denied.

See MPEP § 1214.01 concerning the procedure following a new ground of rejection by the Board under 37 CFR *>41.50(b)<.

1213.01 Statement **>by Board of How an Appealed Claim May Be Amended To Overcome a Specific Rejection< [R-3]

**>

37 CFR 41.50. *Decisions and other actions by the Board.*

(c) The opinion of the Board may include an explicit statement of how a claim on appeal may be amended to overcome a specific rejection. When the opinion of the Board includes such a statement, appellant has the right to amend in conformity therewith. An amendment in conformity with such statement will overcome the specific rejection. An examiner may reject a claim so-amended, provided that the rejection constitutes a new ground of rejection.<

If the Board's decision includes an explicit statement **>how a claim on appeal may be amended to overcome a specific rejection<, appellant may amend the claim in conformity with the statement **. The examiner should make certain that the amendment does in fact conform to the statement in the Board's decision.

The making of a statement under 37 CFR *>41.50(c)< is discretionary with the Board. In the absence of an express statement, a remark by the Board that a certain feature does not appear in a claim is not to be taken as a statement that the claim may be allowed if the feature is supplied by amendment. *Ex parte Norlund*, 1913 C.D. 161, 192 O.G. 989 (Comm'r Pat. 1913). >A remark by the Board shall not be construed by appellant to give appellant authority to amend the claim.<

Appellant's right to amend in conformity with the statement under 37 CFR *>41.50(c)< may only be exercised within the period allowed for seeking court review under 37 CFR 1.304. See MPEP § 1216.

>An explicit statement by the Board on how a claim on appeal may be amended to overcome a specific rejection is not a statement that a claim so-amended is allowable. The examiner may reject a claim so-amended, provided that the rejection constitutes a new ground of rejection. Any new ground of rejection made by an examiner following the Board's decision must be approved by a Technology Center Director and must be prominently identified as such

in the action setting forth the new ground of rejection.<

1213.02 New Grounds of Rejection by Board [R-3]

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37 CFR 41.50. *Decisions and other actions by the Board.*

(b) Should the Board have knowledge of any grounds not involved in the appeal for rejecting any pending claim, it may include in its opinion a statement to that effect with its reasons for so holding, which statement constitutes a new ground of rejection of the claim. A new ground of rejection pursuant to this paragraph shall not be considered final for judicial review. When the Board makes a new ground of rejection, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new evidence not previously of record is made which, in the opinion of the examiner, overcomes the new ground of rejection stated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.<

**>

(f) Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time periods set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings.<

Under 37 CFR *>41.50(b)<, the Board may, in its decision, make a new rejection of one or more of any of the claims pending in the case, including claims which have been allowed by the examiner.

While ** the Board >is authorized< to reject allowed claims, this authorization is not intended as an instruction to the Board to examine every allowed claim in every appealed application. It is, rather, intended to give the Board express authority to act when it becomes apparent, during the consideration of rejected claims, that one or more allowed claims may be subject to rejection on either the same or on different grounds from those applied against the rejected claims. Since the exercise of authority under 37 CFR *>41.50(b)< is discretionary, no inference should be drawn from a failure to exercise that discretion.

See MPEP § 1214.01 for the procedure following a new ground of rejection under 37 CFR *>41.50(b)<.

1213.03 Publication of and Public Access to Board Decision [R-8]

37 CFR 41.6. *Public availability of Board records.*

(a) *Publication.* (1) *Generally.* Any Board action is available for public inspection without a party's permission if rendered in a file open to the public pursuant to § 1.11 of this title or in an application that has been published in accordance with §§ 1.211 to 1.221 of this title. The Office may independently publish any Board action that is available for public inspection.

(2) *Determination of special circumstances.* Any Board action not publishable under paragraph (a)(1) of this section may be published or made available for public inspection if the Director believes that special circumstances warrant publication and a party does not, within two months after being notified of the intention to make the action public, object in writing on the ground that the action discloses the objecting party's trade secret or other confidential information and states with specificity that such information is not otherwise publicly available. If the action discloses such information, the party shall identify the deletions in the text of the action considered necessary to protect the information. If the affected party considers that the entire action must be withheld from the public to protect such information, the party must explain why. The party will be given time, not less than twenty days, to request reconsideration and seek court review before any contested portion of the action is made public over its objection.

(b) *Record of proceeding.* (1) The record of a Board proceeding is available to the public unless a patent application not otherwise available to the public is involved.

(2) Notwithstanding paragraph (b)(1) of this section, after a final Board action in or judgment in a Board proceeding, the record of the Board proceeding will be made available to the public if any involved file is or becomes open to the public under § 1.11 of this title or an involved application is or becomes published under §§ 1.211 to 1.221 of this title.

Any Board decision is available for public inspection without a party's permission if rendered in a file open to the public pursuant to 37 CFR 1.11 or in an application that has been published in accordance with 37 CFR 1.211 through 1.221. The Office may independently publish any Board action that is available for public inspection.

Decisions of the Board which are open to the public are available in electronic form on the USPTO Web site (<http://www.uspto.gov>).

Any Board decision rendered in a file not open to the public pursuant to 37 CFR 1.11 or in an application that has not been published in accordance with 37 CFR 1.211 through 1.221 may be published or made available for public inspection under 37 CFR 41.6(a)(2) if the Director believes that special circumstances warrant publication.

1214 Procedure Following Decision by Board [R-3]

**>

37 CFR 41.54. Action following decision.

After decision by the Board, the proceeding will be returned to the examiner, subject to appellant's right of appeal or other review, for such further action by appellant or by the examiner, as the condition of the proceeding may require, to carry into effect the decision.<

After an appeal to the Board has been decided, a copy of the decision is mailed to the appellant and the original placed in the file. The ** Board notes the decision *>in< the file * and in the record of appeals, and then forwards the file to the examiner through the office of the Technology Center Director immediately if all rejections are reversed, and after about 10 weeks if any rejection is affirmed or after a decision on a request for rehearing is rendered.

1214.01 Procedure Following New Ground of Rejection by Board [R-8]

When the Board makes a new rejection under 37 CFR 41.50(b), the appellant, as to each claim so rejected, has the option of:

(A) reopening prosecution before the examiner by submitting an appropriate amendment and/or new evidence (37 CFR 41.50(b)(1)); or

(B) requesting rehearing before the Board (37 CFR 41.50(b)(2)).

The amendment and/or new evidence under 37 CFR 41.50(b)(1), or the request for rehearing under 37 CFR 41.50(b)(2), must be filed within 2 months from the date of the Board's decision. In accordance with 37 CFR *>41.50(f)<, this 2-month time period may not be extended by the filing of a petition and fee under 37 CFR 1.136(a), but only under the provisions of 37 CFR 1.136(b), or under 37 CFR 1.550(c) if the appeal involves an *ex parte* reexamination proceeding.

If an appellant files an appropriate amendment or new evidence (see paragraph I below) as to less than all of the claims rejected by the Board under 37 CFR 41.50(b), and a request for rehearing (see paragraph II below) as to the remainder of the claims so rejected, the examiner will not consider the claims for which rehearing was requested. The request for rehearing will be considered by the Board after prosecution before the examiner with respect to the first group of claims is terminated. Argument as to any of the claims rejected by the Board which is not accompanied by an appropriate amendment or new evidence as to those claims will be treated as a request for rehearing as to those claims.

I. SUBMISSION OF AMENDMENT OR NEW EVIDENCE

37 CFR 41.50(b)(1) provides that the application will be remanded to the examiner for reconsideration if the appellant submits "an appropriate amendment" of the claims rejected by the Board, "or new evidence relating to the claims so rejected, or both." An amendment is "appropriate" under the rule if it amends one or more of the claims rejected, or substitutes new claims to avoid the art or reasons adduced by the Board. *Ex parte Burrowes*, 110 O.G. 599, 1904 C.D. 155 (Comm'r Pat. 1904). Such amended or new claims must be directed to the same subject matter as the appealed claims. *Ex parte Comstock*, 317 O.G. 4,1923 C.D. 82 (Comm'r Pat. 1923). An amendment which adds new claims without either amending the rejected claims, or substituting new claims for the rejected claims, is not appropriate. The new claims will not be entered, and the examiner should return the application file to the Board for consideration of the amendment as a request for rehearing under

37 CFR 41.50(b)(2), if it contains any argument concerning the Board's rejection. The "new evidence" under the rule may be a showing under 37 CFR 1.130, 1.131 or 1.132, as may be appropriate.

If the appellant submits an argument without either an appropriate amendment or new evidence as to any of the claims rejected by the Board, it will be treated as a request for rehearing under 37 CFR 41.50(b)(2).

The new ground of rejection raised by the Board does not reopen prosecution except as to that subject matter to which the new rejection was applied. If the Board's decision in which the rejection under 37 CFR 41.50(b) was made includes an affirmation of the examiner's rejection, the basis of the affirmed rejection is not open to further prosecution. If the appellant elects to proceed before the examiner with regard to the new rejection, the Board's affirmation of the examiner's rejection will be treated as nonfinal for purposes of seeking judicial review, and no request for reconsideration of the affirmation need be filed at that time. Prosecution before the examiner of the 37 CFR 41.50(b) rejection can incidentally result in overcoming the affirmed rejection even though the affirmed rejection is not open to further prosecution. Therefore, it is possible for the application to be allowed as a result of the limited prosecution before the examiner of the 37 CFR 41.50(b) rejection. If the application becomes allowed, the application should not be returned to the Board. Likewise, if the application is abandoned for any reason, the application should not be returned to the Board. If the rejection under 37 CFR 41.50(b) is not overcome, the applicant can file a second appeal (as discussed below). Such appeal must be limited to the 37 CFR 41.50(b) rejection and may not include the affirmed rejection. If the application does not become allowed or abandoned as discussed above, once prosecution of the claims which were rejected under 37 CFR 41.50(b) is terminated before the examiner, the application file must be returned to the Board so that a decision making the original affirmation final can be entered.

The time for filing a request for rehearing on the affirmation or seeking court review runs from the date of the decision by the Board making the original affirmation final. See MPEP § 1214.03 and § 1216.

If the examiner does not consider that the amendment and/or new evidence overcomes the rejection, he or she will again reject the claims. If appropriate, the rejection will be made final.

An applicant in whose application such a final rejection has been made by the examiner may mistakenly believe that he or she is entitled to review by the Board of the rejection by virtue of the previous appeal, but under the provisions of 37 CFR 41.50(b)(1), after such a final rejection, an applicant who desires further review of the matter must file a new appeal to the Board. Such an appeal from the subsequent rejection by the examiner will be an entirely new appeal involving a different ground and will require a new notice of appeal, appeal brief, and the payment of the appropriate fees.

II. REQUEST FOR REHEARING

Instead of filing an amendment and/or new evidence under 37 CFR 41.50(b)(1), an appellant may elect to proceed under 37 CFR 41.50(b)(2) and file a request for rehearing of the Board's new rejection. The rule requires that the request for rehearing "must address the new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in rendering the decision and also state all other grounds upon which rehearing is sought." By proceeding in this manner, the appellant waives his or her right to further prosecution before the examiner. *In re Greenfield*, 40 F.2d 775, 5 USPQ 474 (CCPA 1930). A request for rehearing accompanied by an appropriate amendment of the claims rejected by the Board, and/or by new evidence, does not constitute a proper request for rehearing under 37 CFR 41.50(b)(2), and will be treated as a submission under 37 CFR 41.50(b)(1).

If the Board's decision also includes an affirmation of the examiner's rejection, a request for rehearing of the affirmation (see MPEP § 1214.03 and MPEP § 1214.06, paragraph IV) should be filed in a separate paper to facilitate consideration.

1214.03 Rehearing [R-3]

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37 CFR 41.52. *Rehearing.*

(a)(1)Appellant may file a single request for rehearing within two months of the date of the original decision of the Board. No request for rehearing from a decision on rehearing will be permitted, unless the rehearing decision so modified the original deci-

sion as to become, in effect, a new decision, and the Board states that a second request for rehearing would be permitted. The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board. Arguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) and (a)(3) of this section. When a request for rehearing is made, the Board shall render a decision on the request for rehearing. The decision on the request for rehearing is deemed to incorporate the earlier opinion reflecting its decision for appeal, except for those portions specifically withdrawn on rehearing, and is final for the purpose of judicial review, except when noted otherwise in the decision on rehearing.

(2) Upon a showing of good cause, appellant may present a new argument based upon a recent relevant decision of either the Board or a Federal Court.

(3) New arguments responding to a new ground of rejection made pursuant to § 41.50(b) are permitted.

(b) Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for *ex parte* reexamination proceedings.<

The term “rehearing” is used in 37 CFR *>41.52< for consistency with the language of 35 U.S.C. 6(b). It should not be interpreted as meaning that an appellant is entitled to an oral hearing on the request for rehearing, but only to a rehearing on the written record. It is not the normal practice of the Board to grant rehearings in the sense of another oral hearing. *Ex parte Argoudelis*, 157 USPQ 437, 441 (Bd. App. 1967), *rev’d. on other grounds*, 434 F.2d 1390, 168 USPQ 99 (CCPA 1970).

37 CFR *>41.52< provides that any request for rehearing must specifically state the points believed to have been misapprehended or overlooked in the Board’s decision. Experience has shown that many requests for rehearing are nothing more than reargument of appellant’s position on appeal. In response, the rule was revised to limit requests to the points of law or fact which appellant feels were overlooked or misapprehended by the Board. >Arguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing except (A) upon a showing of good cause, appellant may present a new argument based upon a recent relevant decision of either the Board or a Federal Court, and (B) new arguments responding to a new ground of

rejection made pursuant to 37 CFR 41.50(b). If appellant establishes good cause for a new argument based upon a recent relevant decision of either the Board or a Federal Court, a remand by the Board to the examiner to respond to that new argument may be appropriate.<

The 2-month period provided by 37 CFR *>41.52(a)< for filing a request for rehearing can only be extended under the provisions of 37 CFR 1.136(b) or under 37 CFR 1.550(c) if the appeal involves an *ex parte* reexamination proceeding.

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For extension of time to appeal to the Court of Appeals for the Federal Circuit or commence a civil action under 37 CFR 1.304(a), see MPEP § 1216 and § 1002.02(o).

For requests for reconsideration by the examiner, see MPEP § 1214.04.

>Should an Administrative Patent Judge (APJ) retire or otherwise become unavailable to reconsider a decision, normally another APJ will be designated as a substitute for the unavailable APJ.<

1214.04 Examiner Reversed [R-3]

A complete reversal of the examiner’s rejection brings the case up for immediate action by the examiner. If the reversal does not place an application in condition for immediate allowance (e.g., the Board has entered a new ground of rejection under 37 CFR *>41.50(b)<), the examiner should refer to the situations outlined in MPEP § 1214.06 for appropriate guidance.

The examiner should never regard such a reversal as a challenge to make a new search to uncover other and better references. This is particularly so where the application or *ex parte* reexamination proceeding has meanwhile been transferred or assigned to an examiner other than the one who rejected the claims leading to the appeal. The second examiner should give full faith and credit to the prior examiner’s search.

If the examiner has specific knowledge of the existence of a particular reference or references which indicate nonpatentability of any of the appealed claims as to which the examiner was reversed, he or she should submit the matter to the Technology Center (TC) Director for authorization to reopen prosecution under 37 CFR 1.198 for the purpose of entering

the new rejection. See MPEP § 1002.02(c) and MPEP § 1214.07. The TC Director's approval is placed on the action reopening prosecution.

The examiner may request rehearing of the Board decision. Such a request should normally be made within 2 months of the receipt of the Board decision in the TC. The TC Director's secretary should therefore date stamp all Board decisions upon receipt in the TC.

All requests by the examiner to the Board for rehearing of a decision must be approved by the TC Director and must also be forwarded to the Office of the Deputy Commissioner for Patent Examination Policy for approval before mailing.

>The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board. Arguments not raised in the answers before the Board and evidence not previously relied upon in the answers are not permitted in the request for rehearing except upon a showing of good cause, the examiner may present a new argument based upon a recent relevant decision of either the Board or a Federal Court.<

The request should set a period of **>2 months< for the appellant to file a reply.

If **>the request for rehearing is approved by< the Office of the Deputy Commissioner for Patent Examination Policy>, the TC< will mail a copy of the request for rehearing to the appellant. After the period set for appellant to file a reply (plus mailing time) has expired, the application file will be forwarded to the Board.

1214.05 Cancellation of Withdrawn Claims [R-3]

Where an appellant withdraws some of the appealed claims >(i.e., claims subject to a ground of rejection that the appellant did not present for review in the brief)<, and the Board reverses the examiner on the remaining appealed claims, the withdrawal is treated as an authorization to cancel the withdrawn claims. It is *necessary >for the examiner< to notify the appellant of the cancellation of the withdrawn claims. >See MPEP § 1215.03.<

1214.06 Examiner Sustained in Whole or in Part [R-8]

37 CFR 1.197. Return of jurisdiction from the Board of Patent Appeals and Interferences; termination of proceedings.

(a) *Return of jurisdiction from the Board of Patent Appeals and Interferences.* Jurisdiction over an application or patent under ex parte reexamination proceeding passes to the examiner after a decision by the Board of Patent Appeals and Interferences upon transmittal of the file to the examiner, subject to appellant's right of appeal or other review, for such further action by appellant or by the examiner, as the condition of the application or patent under ex parte reexamination proceeding may require, to carry into effect the decision of the Board of Patent Appeals and Interferences.

(b) *Termination of proceedings.*

(1) Proceedings on an application are considered terminated by the dismissal of an appeal or the failure to timely file an appeal to the court or a civil action (§ 1.304) except:

- (i) Where claims stand allowed in an application; or
- (ii) Where the nature of the decision requires further action by the examiner.

(2) The date of termination of proceedings on an application is the date on which the appeal is dismissed or the date on which the time for appeal to the U.S. Court of Appeals for the Federal Circuit or review by civil action (§ 1.304) expires in the absence of further appeal or review. If an appeal to the U.S. Court of Appeals for the Federal Circuit or a civil action has been filed, proceedings on an application are considered terminated when the appeal or civil action is terminated. A civil action is terminated when the time to appeal the judgment expires. An appeal to the U.S. Court of Appeals for the Federal Circuit, whether from a decision of the Board or a judgment in a civil action, is terminated when the mandate is issued by the Court.

The practice under the situations identified in paragraphs I-III below is similar to the practice after a decision of the court outlined in MPEP § 1216.01. Examiners must be very careful that case files that come back from the Board are not overlooked because every case, except applications in which all claims stand rejected after the Board's decision, is up for action by the examiner in the event no court review has been sought. See MPEP § 1216.01 and § 1216.02 for procedure where court review is sought.

The time for seeking review of a decision of the Board by the Court of Appeals for the Federal Circuit or the U.S. District Court for the District of Columbia is the same for both tribunals, that is, 2 months, or 2 months with the extension provided by 37 CFR 1.304 in the event a request for rehearing is timely filed before the Board, or as extended by the Director. See MPEP § 1216. When the time for seeking court

review (plus 2 weeks to allow for information as to the filing of an appeal or civil action, if any, to reach the examiner) has passed without such review being sought, the examiner must take up the application for consideration. The situations which can arise will involve one or more of the following circumstances:

I. NO CLAIMS STAND ALLOWED

The proceedings in an application or *ex parte* reexamination proceeding are terminated as of the date of the expiration of the time for filing court action. The application is no longer considered as pending. It is to be stamped abandoned and sent to abandoned files. In an *ex parte* reexamination proceeding, a reexamination certificate should be issued under 37 CFR 1.570.

Claims indicated as allowable prior to appeal except for their dependency from rejected claims will be treated as if they were rejected. The following examples illustrate the appropriate approach to be taken by the examiner in various situations:

(A) If claims 1-2 are pending, and the Board affirms a rejection of claim 1 and claim 2 was objected to prior to appeal as being allowable except for its dependency from claim 1, the examiner should hold the application abandoned.

(B) If the Board or court affirms a rejection against an independent claim and reverses all rejections against a claim dependent thereon, after expiration of the period for further appeal, the examiner should proceed in one of two ways:

(1) Convert the dependent claim into independent form by examiner's amendment, cancel all claims in which the rejection was affirmed, and issue the application; or

(2) Set a 1-month time limit in which appellant may rewrite the dependent claim(s) in independent form. Extensions of time under 37 CFR 1.136(a) will not be permitted. If no timely reply is received, the application is abandoned since no claims stand allowed.<

The following form paragraph may be used where appropriate:

¶ 12.119.01 Examiner Sustained in Part - Requirement of Rewriting Dependent Claims (No Allowed Claim)

The Board of Patent Appeals and Interferences affirmed the rejection(s) against independent claim(s) [1], but reversed all rejections against claim(s) [2] dependent thereon. There are no

allowed claims in the application. The independent claim(s) is/are cancelled by the examiner in accordance with MPEP § 1214.06. Applicant is given a ONE MONTH TIME PERIOD from the mailing date of this letter in which to present the dependent claim(s) in independent form to avoid ABANDONMENT of the application. NO EXTENSIONS OF TIME UNDER 37 CFR 1.136(a) WILL BE GRANTED. Prosecution is otherwise closed.

Examiner Note:

1. In bracket 1, enter the independent claim number(s) for which the Board affirmed the rejection(s).
2. In bracket 2, enter the dependent claim number(s) for which the Board reversed the rejection(s).

II. CLAIMS STAND ALLOWED

The appellant is not required to file a reply. The examiner issues the application or *ex parte* reexamination certificate on the claims which stand allowed. For paper files, a red-ink line should be drawn through the refused claims and the notion "Board Decision" written in the margin in red ink.

If the Board affirms a rejection of claim 1, claim 2 was objected to prior to appeal as being allowable except for its dependency from claim 1 and independent claim 3 is allowed, the examiner should cancel claims 1 and 2 and issue the application or *ex parte* reexamination certificate with claim 3 only.

If the Board affirms a rejection against independent claim 1, reverses all rejections against dependent claim 2 and claim 3 is allowed, after expiration of the period for further appeal, the examiner should either:

(A) Convert dependent claim 2 into independent form by examiner's amendment, cancel claim 1 in which the rejection was affirmed, and issue the application with claims 2 and 3; or

(B) Set a 1-month time limit in which appellant may rewrite dependent claim 2 in independent form. Extensions of time under 37 CFR 1.136(a) will not be permitted. If no timely reply is received, the examiner will cancel claims 1 and 2 and issue the application with allowed claim 3 only.

The following form paragraph may be used where appropriate:

¶ 12.119.02 Examiner Sustained in Part - Requirement of Rewriting Dependent Claims (At Least One Allowed Claim)

The Board of Patent Appeals and Interferences affirmed the rejection(s) against independent claim(s) [1], but reversed all

rejections against claim(s) [2] dependent thereon. The independent claim(s) is/are cancelled by the examiner in accordance with MPEP § 1214.06. Applicant is given a ONE MONTH TIME PERIOD from the mailing date of this letter in which to present the dependent claim(s) in independent form. NO EXTENSIONS OF TIME UNDER 37 CFR 1.136(a) WILL BE GRANTED. Failure to comply will result in cancellation of the dependent claims and the application will be allowed with claim(s) [3]. Prosecution is otherwise closed.

Examiner Note:

1. In bracket 1, enter the independent claim number(s) for which the Board affirmed the rejection(s).
2. In bracket 2, enter the dependent claim number(s) for which the Board reversed the rejection(s).
3. In bracket 3, enter the claim number(s) of the allowed claims.

If uncorrected matters of form which cannot be handled without written correspondence remain in the application, the examiner should take appropriate action but prosecution is otherwise closed. A letter such as that set forth in form paragraph 12.120 is suggested:

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¶ 12.120 Period For Seeking Court Review Has Lapsed

The period under 37 CFR 1.304 for seeking court review of the decision by the Board of Patent Appeals and Interferences rendered [1] has expired and no further action has been taken by appellant. The proceedings as to the rejected claims are considered terminated; see 37 CFR 1.197(b).

The application will be passed to issue on allowed claim [2] provided the following formal matters are promptly corrected: [3]. Prosecution is otherwise closed.

Applicant is required to make the necessary corrections addressing the outstanding formal matters within a shortened statutory period set to expire ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this letter to avoid ABANDONMENT of the application. Extensions of time may be granted under 37 CFR 1.136.

Examiner Note:

1. In bracket 1, enter the date of the decision.
2. In bracket 2, identify the allowed claims.
3. In bracket 3, identify the formal matters that need correction.

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III. CLAIMS REQUIRE ACTION

If the decision of the Board is an affirmance in part and includes a reversal of a rejection that brings certain claims up for action on the merits, such as a decision reversing the rejection of generic claims in an application or *ex parte* reexamination proceeding con-

taining claims to nonelected species not previously acted upon, the examiner will take up the application or reexamination proceeding for appropriate action on the matters thus brought up. However, the application or reexamination proceeding is not considered open to further prosecution except as to such matters.

IV. 37 CFR 41.50(b) REJECTION

Where the Board makes a new rejection under 37 CFR 41.50(b) and no action is taken with reference thereto by appellant within 2 months, the examiner should proceed in the manner indicated in paragraphs I-III of this section as appropriate. See MPEP § 1214.01.

If the Board affirms the examiner's rejection, but also enters a new ground of rejection under 37 CFR 41.50(b), the subsequent procedure depends upon the action taken by the appellant with respect to the 37 CFR 41.50(b) rejection.

(A) If the appellant elects to proceed before the examiner with regard to the new rejection (see MPEP § 1214.01, paragraph I) the Board's affirmance will be treated as nonfinal, and no request for rehearing of the affirmance need be filed at that time. Prosecution before the examiner of the 37 CFR 41.50(b) rejection can incidentally result in overcoming the affirmed rejection even though the affirmed rejection is not open to further prosecution. Therefore, it is possible for the application to be allowed as a result of the limited prosecution before the examiner of the 37 CFR 41.50(b) rejection. If an application becomes allowed, it should not be returned to the Board. Likewise, if an application is abandoned for any reason, it should not be returned to the Board. If the rejection under 37 CFR 41.50(b) is not overcome, the applicant (or patent owner in an *ex parte* reexamination proceeding) can file a second appeal (as discussed below). Such appeal must be limited to the 37 CFR 41.50(b) rejection and may not include the affirmed rejection. If an application does not become allowed or abandoned as discussed above, once prosecution of the claims which were rejected under 37 CFR 41.50(b) is terminated before the examiner, the application file must be returned to the Board so that a decision making the original affirmance final can be entered. Similarly, the file of any *ex parte* reexamination proceeding including rejections affirmed by the Board but made nonfinal for purposes of judicial review

must be returned to the Board so that the affirmance can be made final by the Board. The time for filing a request for rehearing on the affirmance or seeking court review runs from the date of the decision by the Board making the original affirmance final. See MPEP § 1214.03 and § 1216.

(B) If the appellant elects to request rehearing of the new rejection (see MPEP § 1214.01, paragraph II), the request for rehearing of the new rejection and of the affirmance must be filed within 2 months from the date of the Board's decision.

1214.07 Reopening of Prosecution [R-3]

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37 CFR 1.198. Reopening after a final decision of the Board of Patent Appeals and Interferences.

When a decision by the Board of Patent Appeals and Interferences on appeal has become final for judicial review, prosecution of the proceeding before the primary examiner will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or § 41.50 of this title without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.<

Sometimes an amendment is filed after the Board's decision which does not carry into effect any recommendation made by the Board and which presents a new or amended claim or claims. In view of the fact that * prosecution is closed, the appellant is not entitled to have such amendment entered as a matter of right. However, if the amendment is submitted with a request for continued examination (RCE) under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e), * prosecution of the application will be reopened and the amendment will be entered. See MPEP § 706.07(h), paragraph XI. Note that the RCE practice under 37 CFR 1.114 does not apply to utility or plant patent applications filed before June 8, 1995 or to design applications. See 37 CFR 1.114(d) and MPEP § 706.07(h), paragraph I. If the amendment obviously places an application in condition for allowance, regardless of whether the amendment is filed with an RCE, the primary examiner should recommend that the amendment be *>entered<, and with the concurrence of the supervisory patent examiner, the amendment will be entered. Note MPEP § 1002.02(d).

Where the amendment cannot be entered, the examiner should write to the appellant indicating that the amendment cannot be entered and stating the rea-

son why. The refusal may not be arbitrary or capricious.

Form paragraph *>12.119< should be used:
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¶ 12.119 Amendment After Board Decision, Entry Refused

The amendment filed [1] after a decision by the Board of Patent Appeals and Interferences is not entered because prosecution is closed and the proposed amendment was not suggested in an explicit statement by the Board under 37 CFR 41.50(c). As provided in 37 CFR 1.198, prosecution of the proceeding before the primary examiner will not be reopened or reconsidered by the primary examiner after a final decision of the Board except under the provisions of 37 CFR 1.114 (request for continued examination) or 37 CFR 41.50 without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

Examiner Note:

1. In bracket 1, insert the date the amendment was filed.
2. This form paragraph is not to be used where a 37 CFR 41.50(b) rejection has been made by the Board of Patent Appeals and Interferences.

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In the event that claims stand allowed in the application under the conditions set forth in MPEP § 1214.06, paragraph II, the application should be passed to issue.

Petitions under 37 CFR 1.198 to reopen or reconsider prosecution of a case after decision by the Board, where no court action has been filed, are decided by the Technology Center Director, MPEP § 1002.02(c).

The *>Director of the USPTO< also entertains petitions under 37 CFR 1.198 to reopen certain cases in which an appellant has sought review under 35 U.S.C. 141 or 145. This procedure is restricted to cases which have been decided by the Board and which are amenable to settlement without the need for going forward with the court proceeding. Such petitions will ordinarily be granted only in the following categories of cases:

(A) When the decision of the Board asserts that the rejection of the claims is proper because the claims do not include a disclosed limitation or because they suffer from some other curable defect, and the decision reasonably is suggestive that claims including the limitation or devoid of the defect will be allowable;

(B) When the decision of the Board asserts that the rejection of the claims is proper because the

record does not include evidence of a specified character, and is reasonably suggestive that if such evidence were presented, the appealed claims would be allowable, and it is demonstrated that such evidence presently exists and can be offered; or

(C) When the decision of the Board is based on a practice, rule, law, or judicial precedent which, since the Board's decision, has been rescinded, repealed, or overruled.

Such petitions will not be ordinarily entertained after the filing of the *Director's< brief in cases in which review has been sought under 35 U.S.C. 141, or after trial in a 35 U.S.C. 145 case.

In the case of an appeal under 35 U.S.C. 141, if the petition is granted, steps will be taken to request the court to remand the case to the U. S. Patent and Trademark Office. If so remanded, the proposed amendments, evidence, and arguments will be entered of record in the application file for consideration, and further action will be taken by the Board in the first instance or by the examiner as may be appropriate. In the case of civil action under 35 U.S.C. 145, steps will be taken for obtaining dismissal of the action without prejudice to consideration of the proposals.

1215 Withdrawal or Dismissal of Appeal

1215.01 Withdrawal of Appeal [R-3]

Except in those instances where a withdrawal of an appeal would result in abandonment of an application, an attorney not of record in an application or reexamination proceeding may file a paper under 37 CFR 1.34* withdrawing an appeal. In instances where no allowable claims appear in an application, the withdrawal of an appeal is in fact an express abandonment that does not comply with 37 CFR 1.138 except where a continuing application is being filed on the same date.

Where, after an appeal has been filed and before decision by the Board, an applicant withdraws the appeal after the period for reply to the final rejection has expired, the application is to be considered abandoned as of the date on which the appeal was withdrawn unless there are allowed claims in the case.

Where a letter abandoning the application is filed in accordance with 37 CFR 1.138, the effective date of abandonment is the date of recognition of the letter by

an appropriate official of the Office or a different date, if so specified in the letter itself. See MPEP § 711.01.

If a brief has been filed within the time permitted by 37 CFR *41.37< (or any extension thereof) and an answer mailed and appellant withdraws the appeal, the application is returned to the examiner.

Prior to a decision by the Board, if an applicant wishes to withdraw an application from appeal and to reopen * prosecution of the application, applicant can file a request for continued examination (RCE) under 37 CFR 1.114, accompanied by a submission (i.e., a reply responsive within the meaning of 37 CFR 1.111 to the last outstanding Office action) and the RCE fee set forth under 37 CFR 1.17(e). Note that the RCE practice under 37 CFR 1.114 does not apply to utility or plant patent applications filed before June 8, 1995, design applications, or reexamination proceedings. See 37 CFR 1.114(d) and MPEP § 706.07(h), paragraph X, for more details. An appeal brief or reply brief (or related papers) is not a submission under 37 CFR 1.114, unless the transmittal letter of the RCE contains a statement that incorporates by reference the arguments in a previously filed appeal brief or reply brief. See MPEP § 706.07(h), paragraph II. The filing of an RCE will be treated as a withdrawal of the appeal by the applicant, regardless of whether the RCE includes the appropriate fee or a submission. Therefore, when an RCE is filed without the appropriate fee or a submission in an application that has no allowed claims, the application will be considered abandoned. To avoid abandonment, the RCE should be filed in compliance with 37 CFR 1.114. See MPEP § 706.07(h), paragraphs I-II.

>Once appellant has filed a notice of appeal, appellant also may request that prosecution be reopened for the following situations:

(A) In response to a new ground of rejection made in an examiner's answer, appellant may file a reply in compliance with 37 CFR 1.111 that addresses the new ground of rejection within two months from the mailing of the examiner's answer (see MPEP § 1207.03).

(B) In response to a supplemental examiner's answer that is written in response to a remand by the Board for further consideration of a rejection under 37 CFR 41.50(a), appellant may file a reply in compliance with 37 CFR 1.111 that addresses the rejection in the supplemental answer within two months from the

mailing of the supplemental answer (see MPEP § 1207.05).<

To avoid the rendering of decisions by the Board in applications which have already been refiled as continuations, applicants should promptly inform the *>Chief Clerk< of the Board in writing as soon as they have positively decided to refile or to abandon an application containing an appeal awaiting a decision. Applicants also should advise the Board when an RCE is filed in an application containing an appeal awaiting decision. Failure to exercise appropriate diligence in this matter may result in the Board refusing an otherwise proper request to vacate its decision.

*>Upon the withdrawal of an appeal, an application< having no allowed claims will be abandoned. Claims which are allowable except for their dependency from rejected claims will be treated as if they were rejected. The following examples illustrate the appropriate approach to be taken by the examiner in various situations:

(A) Claim 1 is allowed; claims 2 and 3 are rejected. The examiner should cancel claims 2 and 3 and issue the application with claim 1 only.

(B) Claims 1 - 3 are rejected. The examiner should hold the application abandoned.

(C) Claim 1 is rejected and claim 2 is objected to as being allowable except for its dependency from claim 1. The examiner should hold the application abandoned.

(D) Claim 1 is rejected and claim 2 is objected to as being allowable except for its dependency from claim 1; independent claim 3 is allowed. The examiner should cancel claims 1 and 2 and issue the application with claim 3 only.

In an *ex parte* reexamination proceeding, an *ex parte* reexamination certificate should be issued under 37 CFR 1.570.

1215.02 Claims Standing Allowed

If an application contains allowed claims, as well as claims on appeal, the withdrawal of the appeal does not operate as an abandonment of the application, but is considered a withdrawal of the appeal as to those claims and authority to the examiner to cancel the same. An amendment canceling the appealed claims is equivalent to a withdrawal of the appeal.

1215.03 Partial Withdrawal [R-3]

A withdrawal of the appeal as to some of the claims on appeal operates as an authorization to cancel those claims from the application or reexamination proceeding and the appeal continues as to the remaining claims. The withdrawn claims will be canceled from an application by direction of the examiner at the **>time of the withdrawal of the appeal as to those claims. Examiner may use the following form paragraph to cancel the claims that are withdrawn from appeal at the time of the withdrawal:

¶ 12.121 Withdrawal of Appeal as to Some of the Claims on Appeal

The withdrawal of the appeal as to claims [1] operates as an authorization to cancel these claims from the application or reexamination proceeding. See MPEP § 1215.03. Accordingly, these claims are canceled.

Examiner Note:

1. In bracket 1, insert the claim numbers of the claims that were withdrawn from appeal.

If appellant fails to respond to a new ground of rejection made in an examiner's answer by either filing a reply brief or a reply under 37 CFR 1.111 within 2 months from the mailing of the examiner's answer, the appeal is *sua sponte* dismissed as to the claims subject to the new ground of rejection. See MPEP § 1207.03. The examiner should use form paragraph 12.179.02 to notify the appellant of the dismissal and cancel those claims.

¶ 12.179.02 Dismissal Following New Ground(s) of Rejection in Examiner's Answer

Appellant failed to timely respond to the examiner's answer mailed on [1] that included a new ground of rejection mailed on [1]. Under 37 CFR 41.39(b), if an examiner's answer contains a rejection designated as a new ground of rejection, appellant must, within two months from the date of the examiner's answer, file either: (1) a request that prosecution be reopened by filing a reply under 37 CFR 1.111; or (2) a request that the appeal be maintained by filing a reply brief under 37 CFR 41.41, addressing each new ground of rejection, to avoid sua sponte dismissal of the appeal as to the claims subject to the new ground of rejection. In view of appellant's failure to file a reply under 37 CFR 1.111 or a reply brief within the time period required by 37 CFR 41.39, **the appeal as to claims [2] is dismissed, and these claims are canceled.**

Only claims [3] remain in the application. The appeal continues as to these remaining claims. The application will be forwarded to the Board after mailing of this communication.

Examiner Note:

1. In bracket 1, insert the mailing date of the examiner's answer.
2. In bracket 2, insert the claim numbers of the claims subject to the new ground of rejection.
3. In bracket 3, insert the claim numbers of the claims that are not subject to the new ground of rejection.

Similarly, if appellant fails to respond to a supplemental examiner's answer that is written in response to a remand by the Board for further consideration of a rejection under 37 CFR 41.50(a) by either filing a reply brief or a reply under 37 CFR 1.111 within 2 months from the mailing of the supplemental answer, the appeal is *sua sponte* dismissed as to the claims subject to the rejection for which the Board has remanded the proceeding. See MPEP § 1207.05. Such supplemental examiner's answer may also include a new ground of rejection. The examiner should use form paragraph 12.186 to notify the appellant of the dismissal and cancel those claims.

¶ *12.186 Dismissal Following A Supplemental Examiner's Answer Written in Response to a Remand for Further Consideration of a Rejection*

Appellant failed to timely respond to the supplemental examiner's answer mailed on [1] that was written in response to a remand by the Board for further consideration of a rejection mailed on [1]. Under 37 CFR 41.50(a)(2), appellant must, within two months from the date of the supplemental examiner's answer, file either: (1) a request that prosecution be reopened by filing a reply under 37 CFR 1.111; or (2) a request that the appeal be maintained by filing a reply brief under 37 CFR 41.41, to avoid sua sponte dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding. In view of appellant's failure to file a reply under 37 CFR 1.111 or a reply brief within the time period required by 37 CFR 41.50(a)(2), **the appeal as to claims [2] is dismissed, and these claims are canceled.**

Only claims [3] remain in the application. The appeal continues as to these remaining claims. The application will be forwarded to the Board after mailing of this communication.

Examiner Note:

1. In bracket 1, insert the mailing date of the supplemental examiner's answer.
2. In bracket 2, insert the claim numbers of the claims subject to the rejection for which the Board has remanded the proceeding.
3. In bracket 3, insert the claim numbers of the claims that are not subject to the rejection.

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1215.04 Dismissal of Appeal [R-8]

If no brief is filed within the time prescribed by 37 CFR 41.37, the appeal stands dismissed by operation of the rule. Form PTOL-461 ** notifying the appellant that the appeal stands dismissed is not an action in the case and does not start any period for reply. If no claims stand allowed, an application is considered as abandoned on the date the brief was due. If claims stand allowed in an application, the failure to file a brief and consequent dismissal of the appeal is to be treated as a withdrawal of the appeal and of any claim not standing allowed. The application should be passed to issue forthwith. Unless appellant specifically withdraws the appeal as to rejected claims, the appeal should not be dismissed until the extended period (5 months of extension are available under 37 CFR 1.136(a)) to file the brief has expired.

Applications having no allowed claims will be abandoned. Claims which are allowable except for their dependency from rejected claims will be treated as if they were rejected. The following examples illustrate the appropriate approach to be taken by the examiner in various situations:

(A) Claim 1 is allowed; claims 2 and 3 are rejected. The examiner should cancel claims 2 and 3 and issue the application with claim 1 only.

(B) Claims 1 - 3 are rejected. The examiner should hold the application abandoned.

(C) Claim 1 is rejected and claim 2 is objected to as being allowable except for its dependency from claim 1. The examiner should hold the application abandoned.

(D) Claim 1 is rejected and claim 2 is objected to as being allowable except for its dependency from claim 1; independent claim 3 is allowed. The examiner should cancel claims 1 and 2 and issue the application with claim 3 only.

However, if formal matters remain to be attended to, the examiner should take appropriate action on such matters**>. For example (1) the examiner may handle the formal matters by examiner's amendment (see MPEP § 1302.04) or (2) the examiner may use form paragraph 12.109.01 to describe the formal matters that applicant is required to correct and set a shortened period for reply. Note that further prosecution on the application or reexamination proceeding is closed except as to such formal matters.<

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¶ 12.109.01 *Appeal Dismissed - Allowed Claims, Formal Matters Remaining*

In view of applicant's failure to file a brief within the time prescribed by 37 CFR 41.37(a)(1), the appeal stands dismissed and the proceedings as to the rejected claims are considered terminated. See 37 CFR 1.197(b).

This application will be passed to issue on allowed claim [1] provided the following formal matters are corrected. Prosecution is otherwise closed.

[2]

Applicant is required to make the necessary corrections within a shortened statutory period set to expire ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this letter to avoid ABANDONMENT of the application. Extensions of time may be granted under 37 CFR 1.136.

Examiner Note:

1. This form paragraph should only be used if the formal matters cannot be handled by examiner's amendment. See MPEP § 1215.04.
2. In bracket 2, insert a description of the formal matters to be corrected.
3. Claims which have been indicated as containing allowable subject matter but are objected to as being dependent upon a rejected claim are to be considered as if they were rejected. See MPEP § 1215.04.

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An appeal will also be dismissed if an applicant fails to timely and fully reply to a notice of noncompliance with 37 CFR 41.37(d). See MPEP § 1205.03 and 37 CFR 41.37(d). As in examples (B)-(C) above, if no allowed claims remain in an application, the application is abandoned as of the date the reply to the notice was due. The applicant may petition to revive the application as in other cases of abandonment, and to reinstate the appeal. If the appeal is dismissed, but allowed claims remain in the application, as in examples (A) and (D) above, the application is not abandoned; to reinstate the claims cancelled by the examiner because of the dismissal, the applicant must petition to reinstate the claims and the appeal, but a showing equivalent to a petition to revive under 37 CFR 1.137 is required. In either event, a proper reply to the notice of noncompliance must be filed before the petition will be considered on its merits.

1216 Judicial Review [R-8]*35 U.S.C. 141. Appeal to the Court of Appeals for the Federal Circuit.*

An applicant dissatisfied with the decision in an appeal to the Board of Patent Appeals and Interferences under section 134 of

this title may appeal the decision to the United States Court of Appeals for the Federal Circuit. By filing such an appeal the applicant waives his or her right to proceed under section 145 of this title. A patent owner, or a third-party requester in an inter partes reexamination proceeding, who is in any reexamination proceeding dissatisfied with the final decision in an appeal to the Board of Patent Appeals and Interferences under section 134 may appeal the decision only to the United States Court of Appeals for the Federal Circuit. A party to an interference dissatisfied with the decision of the Board of Patent Appeals and Interferences on the interference may appeal the decision to the United States Court of Appeals for the Federal Circuit, but such appeal shall be dismissed if any adverse party to such interference, within twenty days after the appellant has filed notice of appeal in accordance with section 142 of this title, files notice with the Director that the party elects to have all further proceedings conducted as provided in section 146 of this title. If the appellant does not, within thirty days after filing of such notice by the adverse party, file a civil action under section 146, the decision appealed from shall govern the further proceedings in the case.

35 U.S.C. 145. Civil action to obtain patent.

An applicant dissatisfied with the decision of the Board of Patent Appeals and Interferences in an appeal under section 134(a) of this title may, unless appeal has been taken to the United States Court of Appeals for the Federal Circuit, have remedy by civil action against the Director in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Director appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Patent Appeals and Interferences, as the facts in the case may appear, and such adjudication shall authorize the Director to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant.

35 U.S.C. 306. Appeal.

The patent owner involved in a reexamination proceeding under this chapter may appeal under the provisions of section 134 of this title, and may seek court review under the provisions of sections 141 to 145 of this title, with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent.

37 CFR 1.301. Appeal to U.S. Court of Appeals for the Federal Circuit.

Any applicant, or any owner of a patent involved in any *ex parte* reexamination proceeding filed under § 1.510, dissatisfied with the decision of the Board of Patent Appeals and Interferences, and any party to an interference dissatisfied with the decision of the Board of Patent Appeals and Interferences, may appeal to the U.S. Court of Appeals for the Federal Circuit. The appellant must take the following steps in such an appeal: In the U. S. Patent and Trademark Office, file a written notice of appeal directed to the Director (§§ 1.302 and 1.304); and in the Court, file a copy of the notice of appeal and pay the fee for appeal as provided by the rules of the Court. For appeals by patent owners and third party

requesters in *inter partes* reexamination proceedings filed under § 1.913, § 1.983 is controlling.

37 CFR 1.303. Civil action under 35 U.S.C. 145, 146, 306.

(a) Any applicant, or any owner of a patent involved in an *ex parte* reexamination proceeding filed before November 29, 1999, dissatisfied with the decision of the Board of Patent Appeals and Interferences, and any party to an interference dissatisfied with the decision of the Board of Patent Appeals and Interferences may, instead of appealing to the U.S. Court of Appeals for the Federal Circuit (§ 1.301), have remedy by civil action under 35 U.S.C. 145 or 146, as appropriate. Such civil action must be commenced within the time specified in § 1.304.

(b) If an applicant in an *ex parte* case, or an owner of a patent involved in an *ex parte* reexamination proceeding filed before November 29, 1999, has taken an appeal to the U.S. Court of Appeals for the Federal Circuit, he or she thereby waives his or her right to proceed under 35 U.S.C. 145.

(c) A notice of election under 35 U.S.C. 141 to have all further proceedings on review conducted as provided in 35 U.S.C. 146 must be filed with the Office of the Solicitor and served as provided in § 41.106(e) of this title.

(d) For an *ex parte* reexamination proceeding filed on or after November 29, 1999, and for any *inter partes* reexamination proceeding, no remedy by civil action under 35 U.S.C. 145 is available.

37 CFR 1.304. Time for appeal or civil action.

(a)(1) The time for filing the notice of appeal to the U.S. Court of Appeals for the Federal Circuit (§ 1.302) or for commencing a civil action (§ 1.303) is two months from the date of the decision of the Board of Patent Appeals and Interferences. If a request for rehearing or reconsideration of the decision is filed within the time period provided under § 41.52(a), § 41.79(a), or § 41.127(d) of this title, the time for filing an appeal or commencing a civil action shall expire two months after action on the request. In contested cases before the Board of Patent Appeals and Interferences, the time for filing a cross-appeal or cross-action expires:

(i) Fourteen days after service of the notice of appeal or the summons and complaint; or

(ii) Two months after the date of decision of the Board of Patent Appeals and Interferences, whichever is later.

(2) The time periods set forth in this section are not subject to the provisions of § 1.136, § 1.550(c), or § 1.956, or of § 41.4 of this title.

(3) The Director may extend the time for filing an appeal or commencing a civil action:

(i) For good cause shown if requested in writing before the expiration of the period for filing an appeal or commencing a civil action, or

(ii) Upon written request after the expiration of the period for filing an appeal or commencing a civil action upon a showing that the failure to act was the result of excusable neglect.

(b) The times specified in this section in days are calendar days. The time specified herein in months are calendar months except that one day shall be added to any two-month period which includes February 28. If the last day of the time specified for

appeal or commencing a civil action falls on a Saturday, Sunday or Federal holiday in the District of Columbia, the time is extended to the next day which is neither a Saturday, Sunday nor a Federal holiday.

(c) If a defeated party to an interference has taken an appeal to the U.S. Court of Appeals for the Federal Circuit and an adverse party has filed notice under 35 U.S.C. 141 electing to have all further proceedings conducted under 35 U.S.C. 146 (§ 1.303(c)), the time for filing a civil action thereafter is specified in 35 U.S.C. 141. The time for filing a cross-action expires 14 days after service of the summons and complaint.

I. JUDICIAL REVIEW OF PATENT APPLICATIONS

An applicant for a patent who is dissatisfied with a decision of the Board may seek judicial review either by an appeal to the U.S. Court of Appeals for the Federal Circuit (35 U.S.C. 141 and 37 CFR 1.301) or by a civil action in the U.S. District Court for the District of Columbia (35 U.S.C. 145 and 37 CFR 1.303(a)). By filing an appeal to the Federal Circuit, the applicant waives the right to seek judicial review by a civil action under 35 U.S.C. 145. See 35 U.S.C. 141 and 37 CFR 1.303(b).

II. JUDICIAL REVIEW OF EX PARTE REEXAMINATION PROCEEDINGS

****>**A patent owner who is not satisfied with the decision of the Board may seek judicial review.

In an *ex parte* reexamination filed before November 29, 1999, the patent owner may appeal the decision of the Board to either (A) the United States Court of Appeals for the Federal Circuit pursuant to 35 U.S.C. 141, or (B) the United States District Court for the District of Columbia pursuant to 35 U.S.C. 145. This is based on the version of 35 U.S.C. 141 and 35 U.S.C. 145 in existence prior to the amendment of the reexamination statute on November 29, 1999 by Public Law 106-113. This “prior version” of 35 U.S.C. 141 and 35 U.S.C. 145 applies to appeals in reexamination, where the reexamination was filed in the Office before November 29, 1999. See Section 13202(d) of Public Law 107-273.

In an *ex parte* reexamination filed on or after November 29, 1999, the patent owner may appeal the decision of the Board only to the United States Court of Appeals for the Federal Circuit pursuant to 35 U.S.C. 141. This is based on the current version of 35 U.S.C. 141 and 35 U.S.C. 145 as they were amended by Public Law 106-113. This “current version” of 35

U.S.C. 141 and 35 U.S.C. 145 applies to appeals in reexamination, where the reexamination was filed in the Office on or after November 29, 1999. See Section 13202(d) of Public Law 107-273.<

For judicial review of an *inter partes* reexamination proceeding, see 35 U.S.C. 315. Because *inter partes* reexamination procedures are found in Chapter 31 (and not in Chapter 30) of Title 35 of the United States Code, 35 U.S.C. 306 does not apply to an *inter partes* reexamination proceeding.

III. TIME FOR FILING NOTICE OF APPEAL OR COMMENCING CIVIL ACTION

The time for filing a notice of a 35 U.S.C. 141 appeal to the Federal Circuit or for commencing a civil action under 35 U.S.C. 145 is within 2 months of the Board's decision. 37 CFR 1.304(a). However, if a request for rehearing or reconsideration of the Board's decision is filed within the time provided under 37 CFR 41.52 (*ex parte* appeals) or 37 CFR 41.79 (*inter partes* appeals), the time for filing a notice of appeal to the Federal Circuit or for commencing a civil action expires 2 months after a decision on a request for rehearing or reconsideration (37 CFR 1.304(a)).

These 2-month periods meet the 60-day requirement of 35 U.S.C. 142 and 145 except for time periods which include February 28. In order to comply with the 60-day requirement, 37 CFR 1.304(b) provides that an additional day shall be added to any 2-month period for initiating review which includes February 28. Appeals will always be timely if the judicial review is initiated within 2 months of the final decision.

The times specified in 37 CFR 1.304 are calendar days. If the last day of the time specified for appeal or commencing a civil action falls on a Saturday, Sunday, or a Federal holiday in the District of Columbia, the time is extended to the next day which is neither a Saturday, Sunday, nor a Federal holiday (37 CFR 1.304(b)).

IV. TIME FOR FILING CROSS-APPEAL OR CROSS-ACTION

37 CFR 1.304(a) specifies that the time for filing a cross-appeal or a cross-action expires (A) 14 days after service of the notice of appeal or the summons and complaint or (B) 2 months after the decision to be reviewed, whichever is later.

37 CFR 1.304(a) provides that the time for filing a cross-action expires 14 days after service of the summons and complaint. The district court will determine whether any cross-action was timely filed since neither the complaint nor cross-action is filed in the U.S. Patent and Trademark Office.

V. EXTENSION OF TIME TO SEEK JUDICIAL REVIEW

In 37 CFR 1.304(a), the Office has adopted a standard which is similar to the standard used in the Federal courts for granting extensions. Under the rule, the Director may extend the time (A) for good cause if requested before the expiration of the time provided for initiating judicial review or (B) upon a showing of excusable neglect in failing to initiate judicial review if requested after the expiration of the time period. This standard is applicable once the "last" decision has been entered, i.e., either the decision (in circumstances where no timely rehearing or reconsideration is sought), the decision on rehearing of the Board in an *ex parte* appeal, or the decision on reconsideration of the Board in an interference. Extensions of time under 37 CFR 1.136(b) and 1.550(c) and fee extensions under 37 CFR 1.136(a) are not available to extend the time for the purpose of judicial review once a decision or a decision on rehearing or reconsideration has been entered. 37 CFR 1.304(a)(2) states that the provisions of 37 CFR 1.136 and 1.550(c) are not available to extend the time to initiate judicial review.

Requests for extension of time to seek judicial review under 37 CFR 1.304 should be addressed as follows:

Mail Stop 8
Director of the U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Requests may also be hand-carried to the Office of the Solicitor.

VI. APPLICATION UNDER JUDICIAL REVIEW

The administrative file of an application under judicial review, even though carried to a court, will not be opened to the public by the U.S. Patent and Trade-

mark Office, unless it is otherwise available to the public under 37 CFR 1.11.

During judicial review, the involved application or reexamination is not under the jurisdiction of the examiner or the Board, unless remanded to the U.S. Patent and Trademark Office by the court. Any amendment can be admitted only under the provisions of 37 CFR 1.198. See MPEP § 1214.07.

VII. SERVICE OF COURT PAPERS ON THE DIRECTOR

Rule 5(b) of the Federal Rules of Civil Procedure provides in pertinent part:

Whenever under these rules service is required or permitted to be made upon a party represented by an attorney the service shall be made upon the attorney unless service upon the party is ordered by the court. Service upon the attorney . . . shall be made by delivering a copy to the attorney or party or by mailing it to the attorney or party at the attorney's or party's last known address

Similarly, Rule 25(b) of the Federal Rules of Appellate Procedure provides that “[s]ervice on a party represented by counsel must be made on the party’s counsel.”

Accordingly, all service copies of papers filed in court proceedings in which the Director is a party must be served on the Solicitor of the Patent and Trademark Office. Service on the Solicitor may be effected in either of the following ways:

(A) By hand between 8:30 A.M. and 5:00 P.M. EST to the Office of the Solicitor at 600 Dulany Street, Madison West Building, Room 8C43, Alexandria, VA 22314.

(B) By mail in an envelope addressed as follows:

>Mail Stop 8<

Office of the Solicitor

**>United States Patent and Trademark Office

P.O. Box 1450

Alexandria, VA 22313-1450<

While the above mail service address may be supplemented to include the name of the particular attorney assigned to the court case, it must not be

supplemented to refer to either the Director or the U.S. Patent and Trademark Office.

Any court papers mailed to an address other than the above mail service address or delivered by hand to the U.S. Patent and Trademark Office are deemed to have been served on the Director when actually received in the Office of the Solicitor.

The above mail service address should not be used for filing a notice of appeal to the Federal Circuit. See MPEP § 1216.01. Nor should the above mail service address be used for noncourt papers, i.e., papers which are intended to be filed in the U.S. Patent and Trademark Office in connection with an application or other proceeding pending in the U.S. Patent and Trademark Office. ANY NONCOURT PAPERS WHICH ARE MAILED TO THE ABOVE MAIL SERVICE ADDRESS WILL BE RETURNED TO THE SENDER. NO EXCEPTIONS WILL BE MADE TO THIS POLICY.

1216.01 Appeals to the Federal Circuit [R-3]

35 U.S.C. 142. Notice of appeal.

When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the Patent and Trademark Office a written notice of appeal directed to the Director, within such time after the date of the decision from which the appeal is taken as the Director prescribes, but in no case less than 60 days after that date.

35 U.S.C. 143. Proceedings on appeal.

**>With respect to an appeal described in section 142 of this title, the Director shall transmit to the United States Court of Appeals for the Federal Circuit a certified list of the documents comprising the record in the Patent and Trademark Office. The court may request that the Director forward the original or certified copies of such documents during the pendency of the appeal. In an ex parte case or any reexamination case, the Director shall submit to the court in writing the grounds for the decision of the Patent and Trademark Office, addressing all the issues involved in the appeal. The court shall, before hearing an appeal, give notice of the time and place of the hearing to the Director and the parties in the appeal.<

35 U.S.C. 144. Decision on appeal.

The United States Court of Appeals for the Federal Circuit shall review the decision from which an appeal is taken on the record before the Patent and Trademark Office. Upon its determination the court shall issue to the Director its mandate and opinion, which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case.

37 CFR 1.302. Notice of appeal.

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(a) When an appeal is taken to the U.S. Court of Appeals for the Federal Circuit, the appellant shall give notice thereof to the Director within the time specified in § 1.304.

(b) In interferences, the notice must be served as provided in § 41.106(e) of this title.

(c) In *ex parte* reexamination proceedings, the notice must be served as provided in § 1.550(f).

(d) In *inter partes* reexamination proceedings, the notice must be served as provided in § 1.903.

(e) Notices of appeal directed to the Director shall be mailed to or served by hand on the General Counsel as provided in § 104.2.<

Filing an appeal to the Federal Circuit requires that the applicant, the owner of a patent involved in a reexamination proceeding, or a party to an interference proceeding: (A) file in the U.S. Patent and Trademark Office a written notice of appeal (35 U.S.C. 142) directed to the *>Director< and (B) file with the Clerk of the Federal Circuit a copy of the notice of appeal and pay the docket fee for the appeal, as provided by Federal Circuit Rule 52. 37 CFR 1.301.

For a notice of appeal to be considered timely filed in the U.S. Patent and Trademark Office, it must: (A) actually reach the U.S. Patent and Trademark Office within the time specified in 37 CFR 1.304 (including any extensions) or (B) be mailed within the time specified in 37 CFR 1.304 (including any extensions) by “Express Mail” in accordance with 37 CFR 1.10.

A Notice of Appeal to the Federal Circuit should not be mailed to the *>Director<, the Board or the examiner. Nor should it be mailed to the Solicitor’s mail service address for court papers given in MPEP § 1216. Instead, it should be filed in the U.S. Patent and Trademark Office in any one of the following ways:

(A) By mail addressed as follows, in which case the notice of appeal must actually reach the U.S. Patent and Trademark Office by the due date:

**>Mail Stop 8

Director of the U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450<

(B) By “Express Mail” (U.S. Postal Service only) under 37 CFR 1.10 addressed as follows, in which

case the notice of appeal is deemed filed on the “date-in” on the “Express Mail” mailing label:

**>Mail Stop 8

Director of the U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450<

(C) By hand to the Office of the Solicitor, **>at 600 Dulany Street, Madison West Building, Room 8C43, Alexandria, VA 22314<.

A copy of the notice of appeal and the docket fee should be filed with the Clerk of the Federal Circuit, whose mailing and actual address is:

U.S. Court of Appeals for the Federal Circuit
717 Madison Place, N.W.
Washington, DC 20439

The Solicitor, prior to a decision by the Federal Circuit, may request that the case be remanded to the U.S. Patent and Trademark Office and prosecution reopened. See MPEP § 1214.07.

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I. < OFFICE PROCEDURE FOLLOWING DECISION BY THE FEDERAL CIRCUIT

After the Federal Circuit has heard and decided the appeal, an uncertified copy of the decision is sent to the U.S. Patent and Trademark Office and to the appellant and appellee (if any).

In due course, the Clerk of the Federal Circuit forwards to the U.S. Patent and Trademark Office a certified copy of the court’s decision. This certified copy is known as the “mandate.” The mandate is entered in the file of the application, reexamination or interference which was the subject of the appeal. The date ** the mandate **>was issued by the Federal Circuit< marks the conclusion of the appeal, i.e., the termination of proceedings as that term is used in 35 U.S.C. 120. See 37 CFR 1.197(*>b<), or “termination of the interference” as that term is used in 35 U.S.C. 135(c).

The Federal Circuit’s opinion may or may not be precedential. Whether or not the opinion is precedential, the U.S. Patent and Trademark Office will not give the public access to the administrative record of an involved application, or to the file of an interference, unless it is otherwise available to the public

under 37 CFR 1.11. However, since the court record in a 35 U.S.C. 141 appeal generally includes a copy of at least part of the application, such may be inspected at the Federal Circuit. *In re Mosher*, 248 F.2d 956, 115 USPQ 140 (CCPA 1957).

In an *ex parte* appeal, after the mandate is issued, the application or reexamination file is then returned to the appropriate U.S. Patent and Trademark Office official for further proceedings consistent with the mandate. See MPEP § 1214.06 for handling of claims dependent on rejected claims.

A. All Claims Rejected

If all claims in the case stand rejected, proceedings in the case are considered terminated on the date of the Federal Circuit's mandate. Because the case is no longer considered pending, it is ordinarily not open to subsequent amendment and prosecution by the applicant. *Continental Can Company v. Schuyler*, 326 F. Supp. 283, 168 USPQ 625 (D.D.C. 1970). However, exceptions may occur where the mandate clearly indicates that further action in the U.S. Patent and Trademark Office is to be taken in accordance with the Federal Circuit's opinion.

B. Some Claims Allowed

Where the case includes one or more allowed claims, including claims allowed by the examiner prior to appeal and claims whose rejections were reversed by either the Board or the court, the proceedings are considered terminated only as to any claims which still stand rejected. It is not necessary for the applicant or patent owner to cancel the rejected claims, since they may be canceled by the examiner in an examiner's amendment. Thus, if no formal matters remain to be attended to, the examiner will pass the application to issue forthwith on the allowed claims or, in the case of a reexamination, will issue a "Notice of Intent to Issue a Reexamination Certificate and/or Examiner's Amendment." See MPEP § 2287. The examiner should set forth the reasons for allowance, referring to and incorporating a copy of the appellate brief and the court decision. See MPEP § 1302.14.

If formal matters remain to be attended to, the examiner promptly should take appropriate action on such matters, such as by an examiner's amendment or by an Office action setting a 1-month (but not less

than 30-day) shortened statutory period for reply. However, the application or reexamination proceeding is considered closed to further prosecution except as to such matters.

C. Remand

Where the decision of the court brings up for action on the merits claims which were not previously considered on the merits (such as a decision reversing a rejection of generic claims in an application containing claims to nonelected species), the examiner will take the case up for appropriate action on the matters thus brought up.

D. Reopening of Prosecution

In rare situations it may be necessary to reopen prosecution of an application after a decision by the Federal Circuit. Any Office action proposing to reopen prosecution after a decision by the Federal Circuit must be forwarded to the Office of the Deputy Commissioner for Patent Examination Policy for written approval, which will be indicated on the Office action.

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II. < DISMISSAL OF APPEAL

After an appeal is docketed in the Federal Circuit, failure to prosecute the appeal, such as by appellant's failure to file a brief, may result in dismissal of the appeal by the court. Under particular circumstances, the appeal also may be dismissed by the court on motion of the appellant and/or the Director.

The court proceedings are considered terminated as of the date of the mandate. After dismissal, the action taken by the examiner will be the same as set forth above under the heading "Office Procedure Following Decision by the Federal Circuit."

In the event of a dismissal for a reason other than failure to prosecute the appeal, the status of the application, reexamination proceeding or interference must be determined according to the circumstances leading to the dismissal.

1216.02 Civil Suits Under 35 U.S.C. 145 [R-3]

A 35 U.S.C. 145 civil action is commenced by filing a complaint in the U.S. District Court for the Dis-

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trict of Columbia within the time specified in 37 CFR 1.304 (see MPEP § 1216). Furthermore, copies of the complaint and summons must be served in a timely manner on the Solicitor, the U.S. Attorney for the District of Columbia, and the Attorney General in the manner set forth in Rule 4(i) of the Federal Rules of Civil Procedure. Regarding timely service, see *Walsdorf v. Comm'r*, 229 USPQ 559 (D.D.C. 1986) and *Hodge v. Rostker*, 501 F. Supp. 332 (D.D.C. 1980). When a 35 U.S.C. 145 civil action is filed, a notice thereof is placed in the application or reexamination file, which ordinarily will be kept in the Solicitor's Office pending termination of the civil action. >All the expenses of the proceedings shall be paid by the applicant (see 35 U.S.C. 145).<

In an action under 35 U.S.C. 145, the plaintiff may introduce evidence not previously presented to the U.S. Patent and Trademark Office. However, plaintiff will be precluded from presenting new issues, at least in the absence of some reason of justice put forward for failure to present the issue to the U.S. Patent and Trademark Office. *DeSeversky v. Brenner*, 424 F.2d 857, 858, 164 USPQ 495, 496 (D.C. Cir. 1970); *MacKay v. Quigg*, 641 F. Supp. 567, 570, 231 USPQ 907, 908 (D.D.C. 1986). Furthermore, new evidence is not admissible in district court where it was available to the parties but was withheld from the U.S. Patent and Trademark Office as a result of fraud, bad faith, or gross negligence. *DeSeversky*, 424 F.2d at 858 n.5, 164 USPQ at 496 n.5; *California Research Corp. v. Ladd*, 356 F.2d 813, 821 n.18, 148 USPQ 404, 473 n.18 (D.C. Cir. 1966); *MacKay*, 641 F. Supp. at 570, 231 USPQ at 908; *Monsanto Company v. Kamp*, 269 F. Supp. 818, 822, 154 USPQ 259.

260 (D.D.C. 1967); *Killian v. Watson*, 121 USPQ 507, 507 (D.D.C. 1958).

Upon termination of the civil action, a statement of the court's final disposition of the case is placed in the application or reexamination file, which is then returned to the examiner for action in accordance with the same procedures as follow termination of a 35 U.S.C. 141 appeal. See MPEP § 1216.01. 37 CFR 1.197(*>b<*) provides that a civil action is terminated when the time to appeal the judgment expires. Where the exact date when the civil action was terminated is material, the date may be ascertained from the Solicitor's Office.

The procedures to be followed in the U.S. Patent and Trademark Office after a decision, remand, or dismissal of the case by the district court are the same as the procedures followed with respect to 35 U.S.C. 141 appeals. See MPEP § 1216.01.

Where a civil action involving an application has been dismissed before coming to trial, the application will not be opened to the public unless it is otherwise available to the public under 37 CFR 1.11. However, the complaint and any other court papers not under a protective order are open to the public and may be inspected at the Office of the Clerk for the U.S. District Court for the District of Columbia, located in the U.S. Courthouse, 333 Constitution Avenue, N.W., Washington, DC 20001. The court papers in the Office of the Solicitor are not generally made available for public inspection.

Any subpoena by the district court for an application or reexamination file should be hand-carried to the Office of the Solicitor.

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