




UNITED STATES PATENT AND TRADEMARK OFFICE

ASSOCIATE COMMISSIONER FOR PATENT EXAMINATION POLICY

DATE: March 29, 2010

TO: Technology Center Directors

FROM: 
Robert W. Bahr
Acting Associate Commissioner
for Patent Examination Policy

SUBJECT: Revised Procedure for Appeal Brief Review

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.

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 the revised form paragraphs listed in the appendix of this memorandum for drafting examiner's answers to respond to appeal briefs filed in any format. In a 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.

In addition, 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 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.

Under the revised procedure, 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 TC Director or a reply brief was not acknowledged by the examiner).

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.

Appropriate sections of the MPEP (*e.g.*, MPEP §§ 1205.03 and 1207.02) will be revised in accordance with this memorandum in due course. The revised procedure set forth in this memorandum does not apply to reexamination proceedings. The Office is considering a streamlined procedure for review of briefs filed in reexamination proceedings, in which the BPAI will also have the sole responsibility for determining whether briefs filed in *ex parte* reexamination proceedings comply with 37 CFR 41.37

and briefs filed in *inter partes* reexamination proceedings comply with 37 CFR 41.67, 41.68, and 41.71.

Inquiries regarding this notice may be directed to Joni Y. Chang, Senior Legal Advisor, Office of Patent Legal Administration, Office of the Associate Commissioner for Patent Examination Policy, directly by telephone to (571) 272-7720, or the Office of Patent Legal Administration, by telephone at (571) 272-7701 or by electronic mail at PatentPractice@uspto.gov.

APPENDIX:

Form paragraphs not listed in this appendix are not affected by the revised procedure for appeal brief review. The following revised form paragraphs will be available in OACS:

REVISED ¶ 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.

REVISED ¶ 12.151 Status of Claims

(3) Status of Claims

Examiner Note:

Follow this form paragraph with form paragraph 12.151.01.

REVISED ¶ 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:

1. 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.

REVISED ¶ 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.

REVISED ¶ 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.

REVISED ¶ 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.

REVISED ¶ 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.

REVISED ¶ 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.

REVISED ¶ 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.

REVISED ¶ 12.156 Claims Appendix

(7) Claims Appendix

Examiner Note:

Follow this form paragraph with form paragraph 12.156.01.

REVISED ¶ 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.

The following form paragraphs and Notification of Non-Compliant Appeal Brief (PTOL-462) will no longer be available in OACS for the Patent Examining Corps to use:

- ¶ 12.112 Brief Defective – Unsigned
- ¶ 12.116 Brief Unacceptable - Fee Unpaid
- ¶ 12.117 Brief Unacceptable - Not Timely Filed
- ¶ 12.169 Heading for Notice Under 37 CFR 41.37(c)
- ¶ 12.170 Missing Section Headings
- ¶ 12.170.01 Defect in Statement of Real Party in Interest
- ¶ 12.170.02 Defect in Statement of Related Appeals and Interferences
- ¶ 12.171 Defect in Statement of Status of Claims
- ¶ 12.172 Defect in Statement of Status of Amendment Filed After Final Rejection
- ¶ 12.173 Defect in Summary of Claimed Subject Matter
- ¶ 12.174 Defect in Statement of the Grounds of Rejection to be Reviewed on Appeal
- ¶ 12.176 Defect in the Arguments of the Appellant
- ¶ 12.176.01 Separate Heading for Each Ground of Rejection
- ¶ 12.177 No Copy of Appealed Claims in Appendix
- ¶ 12.178 Period For Reply Under 37 CFR 41.37(d)
- ¶ 12.151.02 Disagreement With Statement of Status of Claims
- ¶ 12.151.03 Claims on Appeal

- ¶ *12.151.04 Status of Claims on Appeal – Substituted*
- ¶ *12.151.05 Status of Claims on Appeal – Amended*
- ¶ *12.151.07 Claims Allowed*
- ¶ *12.151.08 Claims Objected To*
- ¶ *12.151.09 Claims Withdrawn From Consideration*
- ¶ *12.151.10 Claims Canceled*
- ¶ *12.152.02 Disagreement With Appellant’s Statement of the Status of Amendments After Final*
- ¶ *12.152.03 Amendment After Final Entered*
- ¶ *12.152.04 Amendment After Final Not Entered*
- ¶ *12.152.05 No Amendments After Final*
- ¶ *12.153.02 Disagreement With the Summary of Claimed Subject Matte*
- ¶ *12.154.02 Disagreement With Appellant’s Statement of the Grounds of Rejection*
- ¶ *12.154.03 Non-Appealable Issue in Brief*
- ¶ *12.154.011 Grounds of Rejection Not on Review*
- ¶ *12.156.02 Copy of the Appealed Claims in Appendix Is Substantially Correct*
- ¶ *12.156.03 Copy of the Appealed Claims in Appendix Contain Substantial Errors*