Chapter 1200 Appeal

1201 Introduction [R-9]

The Patent and Trademark Office in administering the Patent Laws makes many decisions of a discretionary 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 material deficiencies in the disclosure set forth in the application, the questions thereby raised are said to relate to merits, and appeal procedure within the Patent and Trademark Office and to the courts has long been provided by statute.

The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Commissioner of Patents and Trademarks should be carefully observed. The Board will not ordinarily hear a question which it believes should be decided by the Commissioner, and the Commissioner will not ordinarily entertain a petition where the question presented is an appealable matter. However, since 37 CFR 1.181(f) states that any petition not filed within two 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. Note *In re Hengehold*, 440 F.2d 1395, 169 USPQ 473 (CCPA 1971).

1203 Composition of Board [R-9]

35 U.S.C. 7 provides for a Board of Patent Appeals and Interferences as follows:

35 U.S.C. 7 Board of Patent Appeals and Interferences

(a) The examiners-in-chief shall be persons of competent legal knowledge and scientific ability, who shall be appointed to the competitive service. The Commissioner, the Deputy Commissioner, the Assistant Commissioners, and the examiners-in-chief shall constitute the Board of Patent Appeals and Interferences.

(b) 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 interference declared under section 135(a) of this title. Each appeal and interference shall be heard by at least three members of the Board of Patent Appeals and Interferences, who shall be designated by the Commissioner. Only the Board of Patent Appeals and Interferences has the authority to grant rehearings.

(c) Whenever the Commissioner considers it necessary, in order to keep current the work of the Board of Patent Appeals and Interferences, the Commissioner may designate any patent examiner of the primary examiner grade or higher, having the requisite ability, to serve as examiner-in-chief for periods not exceeding six months each. An examiner so designated shall be qualified to act as a member of the Board of Patent Appeals and Interferences. Not more than one of the members of the Board of Patent Appeals and Interferences hearing an appeal or determining an interference may be an examiner so designated. The Secretary of Commerce is authorized to fix the pay of each designated examiner-in-chief in the Patent and Trademark Office at not to exceed the maximum rate of basic pay payable for grade GS-16 of the General Schedule under section 5332 of title 5. The rate of basic pay of each individual designated examiner-in-chief shall be adjusted, at the close of the period for which that individual was designated to act examiner-in-chief, to the rate of basic pay that individual would have been receiving at the close of such period if such designation had not been made.

If subsequent to the hearing, but prior to the decision, a Board member who heard the appeal becomes unable to participate in the decision for some reason, the Chairman of the Board, at his discretion, may without a rehearing substitute a different Board member for the one who is incapacitated, or he may offer the applicant the opportunity for a rehearing. See *In re Bose Corporation*, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985).

Should a member die or otherwise become unavailable (for example, retirement) to reconsider a decision, normally another member will be designated by the Chairman of the Board as a substitute for the absent member.

1204 Administrative Handling [R-9]

Ex parte appeals to the Board, and all papers relating thereto, are forwarded to the examining group for docketing. All appeal papers, such as the notice of appeal, appeal brief and request for extension of time to file the brief are processed by the appropriate examining group.

The clerk in charge of handling appeals in the examining group is solely responsible for completion of all phases of appeal clerical procedure. All communications from the Board and all signed Office communications relating to appeals from the examiners should be given to the group appeals clerk.

To insure that all records are current, memorandum form PTO-262 is attached to the file wrapper when it is remanded by the Board. It is important that this memorandum be promptly completed and forwarded by the group if the application is allowed, the prosecution is reopened, a continuation application is filed or if the appeal is discontinued for any other reason.

If the brief is not filed within the time designated by 37 CFR 1.192, the clerk will notify the applicant that the appeal stands dismissed.

"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 Commissioner or an Assistant Commissioner for examination will continue to be special throughout its entire course of prosecution in the Patent and Trademark Office, including appeal, if any, to the Board.

A petition to make a case 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 Commissioner under 37 CFR 1.102. Therefore, diligent prosecution is essential to a favorable decision on a petition to make special.

1205 Notice of Appeal [R-14]

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

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.

35 U.S.C. 41, Patent fees

(a) The Commissioner shall charge the following fees:

* * * * *

(6)>(A)< On filing an appeal from the examiner to the Board of Patent Appeals and Interferences, **>$190.<

*>(B)< In addition, on filing a brief in support of the appeal, *>$190<, and on requesting an oral hearing in the appeal before the Board of Patent Appeals and Interferences, *>$160<.

[Subpara. (a)(6) amended, Dec. 10, 1991, Public Law 102-204, sec. 5, 105 Stat. 1637]

NOTE: Under 35 U.S.C. 41(f), the amounts of the fees have been increased by rule; see 37 CFR 1.17(e) for current fee amounts.

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37 CFR 1.191. Appeal to Board of Patent Appeals and Interferences.

(a) Every applicant for a patent or for reissue of a patent, or every owner of a patent under reexamination, any of the claims of which have been twice rejected, or who has been given a final rejection (§ 1.113), may, upon the payment of the fee set forth in § 1.17(e), appeal from the decision of the examiner to the Board of Patent Appeals and Interferences within the time allowed for response.

(b) The appeal in an application or reexamination proceeding must identify the rejected claim or claims appealed, and must be signed by the applicant, patent owner or duly authorized attorney or agent.

(c) An appeal when taken must be taken from the rejection of all claims under rejection which applicant or patent 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 §§ 1.191 through 1.193 are subject to the provisions of § 1.136 for patent applications or § 1.550(c) for reexamination proceedings. See 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.

(e) Jurisdiction over the application or patent under reexamination passes to the Board of Patent Appeals and Interferences upon transmittal of the file, including all briefs and examiner's answers, to the Board. Prior to the entry of a decision on the appeal, the Commissioner may sua sponte order the application remanded to the examiner.

An applicant or patent owner in a reexamination proceeding dissatisfied with the primary examiner's decision in the second or final rejection of his or her claims may appeal to the Board for review of the examiner's rejection by filing a notice of appeal, signed by the applicant, patent owner or his or her attorney, and the required fee set forth in 37 CFR 1.17(e).

The notice of appeal must be filed within the period for response set in the last Office action, which is normally three months for applications. See MPEP § 714.13. Failure to remove all grounds of rejection and otherwise place an application in condition for allowance in the absence of new rejections 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 six months from the date of the final rejection, so long as an appropriate petition and fee for an extension of time is filed either prior to or with the Notice of Appeal. Failure to file an appeal in a reexamination proceeding will result in issuance of the certificate under 37 CFR 1.570.

37 CFR 1.191 provides for appeal to the Board by the patent owner from any decision in a reexamination proceeding adverse to patentability, in accordance with 35 U.S.C. 306. See also MPEP § 2273.

The use of a separate letter containing the notice of appeal is strongly recommended. The wording of the letter could be as follows:

NOTICE OF APPEAL FROM THE EXAMINER TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:
Serial or Patent No:
For:
Filed:
Group Art Unit:

To Commissioner of Patents and Trademarks
Sir:

Applicant or patent owner hereby appeals to the Board of Patent Appeals and Interferences from the decision dated ..... of the Examiner finally rejecting claims .....

The item(s) checked below are appropriate:

1. [ ] An extension of time to respond to the final rejection:
   a. [ ] was obtained on ..... for ..... months(s).
   b. [ ] is hereby requested under 37 CFR 1.136.
2. [ ] Appeal fee amount .....
   [ ] Extension of time fee amount .....
   a. [ ] Enclosed
   b. [ ] Charge to Deposit Account No. .....

(One additional copy of this Notice is enclosed herewith.)

_____
(Signature (37 CFR 1.191(b))

_____

_____
(Correspondence address)

MATTERS HANDLED CONCURRENTLY WITH APPEAL

The Patent and Trademark Office does not acknowledge receipt of a Notice of Appeal by separate letter. However, if a self-addressed Post Card is included with the Notice of Appeal, it will be date stamped and mailed.

Form Paragraphs 12.01-12.07 may be used to indicate defects in a Notice of Appeal.

¶ 12.01 Notice of appeal unacceptable — fee unpaid

The Notice of Appeal filed on [1] is not acceptable because the appeal fee required under 37 CFR 1.17(e) was not filed, or was not timely filed.

Applicant may obtain an extension of time under 37 CFR 1.136(a) to file the Notice of Appeal and the appropriate fee. The date on which the Notice of Appeal, the appeal fee, the petition under 37 CFR 1.136(a), and the petition fee are filed will be the date of the response and also the date for determining the period of extension and the corresponding amount of the fee. In no case may an applicant respond later than the maximum six month statutory period or obtain an extension pursuant to 37 CFR 1.136(a) for more than four months beyond the date of response set in an Office action.

¶ 12.02 Notice of appeal unacceptable — no 2nd rejection

The Notice of Appeal filed on [1] is not acceptable because there has been no second or final rejection in this application, as required under 37 CFR 1.191.

¶ 12.03 Notice of appeal unacceptable — not timely filed

The Notice of Appeal filed on [1] is not acceptable because it was filed after the expiration of the period set in the prior Office action. This application will become abandoned unless applicant obtains an extension of time under 37 CFR 1.136(a). The date on which the Notice of Appeal, the appeal fee, the petition under 37 CFR 1.136(a), and the petition fee are filed will be the date of the response and also the date for determining the period of extension and the corresponding amount of the fee. In no case may an applicant respond later than the maximum six months statutory period or obtain an extension pursuant to 37 CFR 1.136(a) for more than four months beyond the date of response set in an Office action.

¶ 12.04 Notice of appeal unacceptable — claims allowed

The Notice of Appeal filed on [1] is not acceptable because a letter of allowability was mailed by the Office on [2].

¶ 12.05 Notice of appeal defective — unsigned

The Notice of Appeal filed on [1] is defective because it is unsigned. A ratification, properly signed, is required.

APPLICANT IS GIVEN A TIME LIMIT OF ONE MONTH FROM THE DATE OF THIS LETTER OR UNTIL THE EXPIRATION OF THE PERIOD FOR RESPONSE SET IN THE LAST OFFICE ACTION, WHICHEVER IS LONGER, WITHIN WHICH TO MAKE THE NECESSARY CORRECTION TO AVOID DISMISSAL OF THE APPEAL. NO EXTENSION OF THE ONE MONTH TIME LIMIT MAY BE GRANTED UNDER EITHER 37 CFR 1.136(a) OR (b), BUT THE PERIOD FOR RESPONSE SET IN THE LAST OFFICE ACTION MAY BE EXTENDED TO A MAXIMUM OF SIX MONTHS PROVIDED THE REQUISITE FEES ARE PAID.

¶ 12.06 Notice of appeal defective — claims unidentified.

The Notice of Appeal filed on [1] is defective because it fails to identify the appealed claims(s) as required under 37 CFR 1.191(b).

APPLICANT IS GIVEN A TIME LIMIT OF ONE MONTH FROM THE DATE OF THIS LETTER OR UNTIL THE EXPIRATION OF THE PERIOD FOR RESPONSE SET IN THE LAST OFFICE ACTION, WHICHEVER IS LONGER, WITHIN WHICH TO MAKE THE NECESSARY CORRECTION TO AVOID DISMISSAL OF THE APPEAL. NO EXTENSION OF THE ONE MONTH TIME LIMIT MAY BE GRANTED UNDER EITHER 37 CFR 1.136 (a) OR (b), BUT THE PERIOD FOR RESPONSE SET IN THE LAST OFFICE ACTION MAY BE EXTENDED TO A MAXIMUM OF SIX MONTHS PROVIDED THE REQUISITE FEES ARE PAID.

¶ 12.07 Notice of appeal defective — other reasons

The Notice of Appeal filed on [1] is defective because [2].

APPLICANT IS GIVEN A TIME LIMIT OF ONE MONTH FROM THE DATE OF THIS LETTER OR UNTIL THE EXPIRATION OF THE PERIOD FOR RESPONSE SET IN THE LAST OFFICE ACTION, WHICHEVER IS LONGER, WITHIN WHICH TO MAKE THE NECESSARY CORRECTION TO AVOID DISMISSAL OF THE APPEAL. NO EXTENSION OF THE ONE MONTH TIME LIMIT MAY BE GRANTED UNDER EITHER 37 CFR 1.136 (a) OR (b), BUT THE PERIOD FOR RESPONSE SET IN THE LAST OFFICE ACTION MAY BE EXTENDED TO A MAXIMUM OF SIX MONTHS PROVIDED THE REQUISITE FEES ARE PAID.

1206 Appeal Brief [R-14]

37 CFR 1.192. Appellant's brief.

(a) The appellant shall, within 2 months from the date of the notice of appeal under § 1.191 in an application, reissue application, or patent under reexamination, or within the time allowed for response to the action appealed from, if such time is later, file a brief in triplicate. The brief must be accompanied by the requisite fee set forth in § 1.17(f) and must set forth the authorities and arguments on which the appellant will rely to maintain his appeal.

(b) On failure to file the brief, accompanied by the requisite fee, within the time allowed, the appeal shall stand dismissed.

(c) The brief shall contain the following items under appropriate headings and in the order here indicated:

(1) *Status of Claims.* A statement of the status of all the claims, pending or cancelled, and identifying the claims appealed.

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

(3) *Summary of Invention.* A concise explanation of the invention defined in the 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.

(4) *Issues.* A concise statement of the issues presented for review.

(5) *Grouping of Claims.* For each ground of rejection which appellant contests and which applies to more than one claim, it will be presumed that the rejected claims stand or fall together unless a statement is included that the rejected claims do not stand or fall together, and in the appropriate part or parts of the argument under subparagraph (c)(6) of this section appellant presents reasons as to why appellant considers the rejected claims to be separately patentable.

(6) *Argument.* The contentions of the appellant with respect to each of the issues presented for review in subparagraph (c)(4) of this section, and the basis therefor, with citations of the authorities, statutes, and parts of the record relied on. Each issue should be treated under a separate heading.

(i) For each rejection under 35 U.S.C. 112, first paragraph, the argument shall specify the errors in the rejection and how the first paragraph of 35 U.S.C. 112 is complied with, including, as appropriate, how the specification and drawings, if any,

(A) describe the subject matter defined by each of the rejected claims,

(B) enable any person skilled in the art to make and use the subject matter defined by each of the rejected claims, and

(C) set forth the best mode contemplated by the inventor of carrying out his or her invention.

(ii) For each rejection under 35 U.S.C. 112, second paragraph, the argument shall specify the errors in the rejection and how the claims particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(iii) For each rejection under 35 U.S.C. 102, the argument shall specify the errors in the rejection and why the rejected claims are patentable under 35 U.S.C. 102, including any specific limitations in the rejected claims which are not described in the prior art relied upon in the rejection.

(iv) For each rejection under 35 U.S.C. 103, the argument shall specify the errors in the rejection and, if appropriate, the specific limitations in the rejected claims which are not described in the prior art relied on in the rejection, and shall explain how such limitations render the claimed subject matter unobvious over the prior art. If the rejection is based upon a combination of references, the argument shall explain why the references, taken as a whole, do not suggest the claimed subject matter, and shall include, as may be appropriate, an explanation of why features disclosed in one reference may not properly be combined with features disclosed in another reference. A general argument that all the limitations are not described in a single reference does not satisfy the requirements of this paragraph.

(v) For any rejection other than those referred to in paragraphs (c)(6)(i) to (iv) of this section, the argument shall specify the errors in the rejection and the specific limitations in the rejected claims, if appropriate, or other reasons, which cause the rejection to be in error.

(7) *Appendix.* An appendix containing a copy of the claims involved in the appeal.

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, the appellant will be notified of the reasons for non-compliance and provided with a period of one month within which to file an amended brief. If the appellant does not file an amended brief *>during< the one month period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will be dismissed. Any arguments or authorities not included in the brief may be refused consideration by the Board of Patent Appeals and Interferences.

[53 FR 23732, June 23, 1988, effective Sept. 12, 1988]

Where the brief is not filed, but within the period allowed for filing the brief an amendment is presented which places the case in condition for allowance, the amendment may be entered since the application retains its pending status during said period. Amendments should not be included in the appeal briefs. Amendments should be filed as separate papers. See MPEP §* 1207, >§< 1215.01 and >§< 1215.02.

TIME FOR FILING APPEAL BRIEF

37 CFR 1.192(a) provides two months from the date of the Notice of Appeal for the patent owner to file an appeal brief in a reexamination proceeding. In a 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 two months from the date of appeal. However, 37 CFR 1.192(a) alternatively permits the brief to be filed "within the time allowed for response to the action appealed from, if such time is later". These time periods may be extended under 37 CFR 1.136(a), and if 37 CFR 1.136(a) has been exhausted, 37 CFR 1.136(b).

In the event that the appellant finds that he or she is unable to file a brief within the time allotted by the rules, he or she may file a petition, with fee, to the examining group, requesting additional time under 37 CFR 1.136(a). Additional time in excess of four 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.

If after an appeal has been filed, but prior to the date for submitting a brief, an interference is declared, appellant's brief need not be filed while the interference is pending, unless the examiner-in-chief has consented to prosecution of the application concurrently with the interference. See MPEP § 2315. Absent such concurrent prosecution, the examiner may, after the interference has terminated and the files have been returned to him or her, (1) set a two-month period for filing the brief, or

(2) withdraw the final rejection of the appealed claims in order to enter an additional rejection on a ground arising out of the interference. See for example MPEP §* 1109.02 and >§< 2363.03. Also, if the appellant was the losing party in the interference, claims which were designated as corresponding to the lost count or counts will stand finally disposed of under 37 CFR 1.265 or 1.663.

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 two months, from the mailing date of the Commissioner's affirmative decision on the petition, in which to file the appeal brief.

With the exception of the institution of an interference or suggestion and timely copying of claims for an interference, the appeal ordinarily will be dismissed if the brief is not filed within the period provided by 37 CFR 1.192(a) or within such additional time as may be properly extended.

Attention is directed to the fact that a brief must be filed to preserve appellant's right to the appealed claims, notwithstanding circumstances such as:

(1) 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;

(2) the filing of a petition for supervisory action under 37 CFR 1.181;

(3) 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;

(4) the receipt of a letter from the examiner stating that prosecution is suspended, without the examiner either withdrawing the final rejection from which appeal has been taken, instituting an interference with the subject application or suggesting claims for an interference.

Although failure to file the brief 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 case 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.

If the time for filing a brief has passed and the application has consequently become abandoned, 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 the application is not abandoned, the petition would be 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 § 1215.04. In either event, a proper brief must be filed before the petition will be considered on its merits.

Where the dismissal of the appeal is believed to be a mistake resulting from inadvertence, filing a petition, pointing out the error, may be sufficient.

A fee under 37 CFR 1.17(f) is required when the brief is filed. 37 CFR 1.192(a) requires the submission of three copies of the appeal brief.

APPEAL BRIEF CONTENT

The brief, as well as every other paper relating to an appeal, should indicate the number of the examining group to which the application or patent under reexamination is assigned and the serial number. When the brief is received, it is forwarded to the group where it is entered in the file, and referred to the examiner.

Appellants are reminded that their briefs in appealed cases must be responsive to every ground of rejection stated by the examiner, including new grounds stated in his or her answer.

Where an appellant fails to respond by way of brief or reply brief to any ground of rejection, appellant shall be notified by the examiner that he or she is allowed one month to correct the defect by filing a supplemental brief. 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 any paper whatever entitled as a brief cannot necessarily be considered a compliance with 37 CFR 1.192. The rule requires that the brief must set forth the authorities and arguments relied upon**. Since it is essential that the Board should be provided with a brief fully stating the position of the appellant with respect to each issue involved in the appeal so that no search of the record is required in order to determine that position, 37 CFR 1.192(c) now requires that the brief contain specific items, as discussed below.

A distinction must be made between the lack of any argument and the presentation of arguments which carry no conviction. In the former case dismissal is in order, while in the latter case a decision on the merits is made, although it may well be merely an affirmance based on the grounds relied on by the examiner.

Appellant must traverse every ground of rejection set forth in the final rejection. Oral argument at the hearing will not remedy such a deficiency in the brief. Ignoring or acquiescing in any rejection, even one based upon formal matters which could be cured by subsequent amendment, will invite a dismissal of the appeal as to the claims affected. If this involves all of the claims, the proceedings in the case are considered terminated as of the date of the dismissal. Accordingly, any application filed thereafter will not be copending with the application on appeal. If in his or her brief, appellant relies on some reference, he or she is expected to provide the Board with at least one copy of it.

The specific items required by 37 CFR 1.192(c) are:

(1) 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, rejected, etc. Each claim on appeal must be identified.

(2) 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, denied entry, or entered in part. This statement should be of the status of the amendment as understood by the appellant.

Items (1) and (2) are included in 37 CFR 1.192(c) 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 (1) and (2) 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.

(3) Summary of Invention A concise explanation of the invention defined in the claims involved in the appeal. This explanation is required to refer to the specification by page and line number, and, if there is a drawing, to the drawing by reference characters. Where applicable, it is preferable to read the appealed claims on the specification and any drawing. While reference to page and line of the specification may require 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. Since the claims are read in light of the disclosure, compliance with this requirement does not limit the claims.

(4) Issues A concise statement of the issues presented for review. Each stated issue should correspond to a separate ground of rejection which appellant wishes the Board of Patent Appeals and Interferences to review. While the statement of the issues must be concise, it should not be so concise as to omit the basis of each issue. For example, the statement of an issue as "Whether claims 1 and 2 are unpatentable" would not comply with 37 CFR 1.192(c)(4). Rather, the basis of the alleged unpatentability would have to be stated, e.g., "Whether claims 1 and 2 are unpatentable under 35 U.S.C. 103 over Smith in view of Jones", or "Whether claims 1 and 2 are unpatentable under 35 U.S.C. 112, first paragraph, as being based on a non-enabling disclosure." The statement would be limited to the issues presented, and should not include any argument concerning the merits of those issues.

(5) Grouping of Claims If an appealed ground of rejection applies to more than one claim and appellant considers the rejected claims to be separately patentable, 37 CFR 1.192(c)(5) requires appellant to state that the claims do not stand or fall together, and to present in the appropriate part or parts of the argument under 37 CFR 1.192(c)(6) the reasons why they are considered separately patentable. The absence of such a statement >and argument< will be taken by the Patent and Trademark Office as a concession by the applicant that, if the ground of rejection were sustained as to any one of the rejected claims, it will be equally applicable to all of them. 37 CFR 1.192(c)(5) is consistent with the practice of the Court of Appeals for the Federal Circuit indicated in such cases as *In re Sernaker*, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983), and *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986). 37 CFR 1.192(c)(5) requires the inclusion of "reasons" in order to avoid unsupported assertions of separate patentability. The reasons may be included in the appropriate portion of the "Argument" section of the brief. For example, if claims 1 to 4 are rejected under 35 U.S.C. 102 and appellant considers claim 4 to be separately patentable from claims 1 to 3, he or she should so state in the "Grouping of claims" section of the brief, and then give the reasons for separate patentability in the 35 U.S.C. 102 portion of the "Argument" section (i.e., under 37 CFR 1.192(c)(6)(iii)).

(6) Argument The appellant's contentions with respect to each of the issues presented for review in 37 CFR 1.192(c)(4), and the basis for those contentions, including citations of authorities, statutes, and parts of the record relied on should be presented in this section.

Included in this paragraph are five subparagraphs, (i) to (v). Subparagraphs (i) to (iv) concern the grounds of rejection most commonly involved in *ex parte* appeals, namely, 35 U.S.C. 112, first and second paragraphs, 35 U.S.C. 102, and 35 U.S.C. 103. Subparagraph (v) is a general provision concerning grounds of rejection not covered by subparagraphs (i) to (iv).

The purpose of subparagraphs (i) to (iv) is to insure that the appellant's argument concerning each appealed ground of rejection will include a discussion of the questions relevant to that ground. It is believed that compliance with the requirements of the particular subparagraphs which are pertinent to the grounds of rejection involved in an appeal will be beneficial both to the Patent and Trademark Office and appellants. It will not only facilitate a decision by the Board of Patent Appeals and Interferences by enabling the Board to determine more quickly and precisely the appellant's position on the relevant issues, but also will help appellants to focus their arguments on those issues.

For each rejection not falling under subparagraphs (i) to (iv), subparagraph (v) provides that the argument should specify the specific limitations in the rejected claims, if appropriate, or other reasons, which cause the rejection to be in error. This language recognizes that for some grounds of rejection, it may not be necessary to specify particular claim limitations; for example, a rejection under 35 U.S.C. 101, as in *Ex parte Hibberd*, 227 USPQ 443 (BPAI 1985)**.

(7) Appendix An appendix containing a copy of the claims involved in the appeal.

The copy of the claims required in the brief Appendix by 37 CFR 1.192(c)(7) should be a clean copy and should not include any brackets or underlining as required by 37 CFR 1.121(b).

For sake of convenience, the copy of the claims involved should be double spaced >and the appendix should start on a new page<.

37 CFR 1.192(c) 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 1.192(c) as long

as it includes items (1) to (7) in the order set forth (with the appendix, item (7) at the end).

REVIEW OF BRIEF BY EXAMINER

37 CFR 1.192(d) provides that if a brief is filed which does not comply with all the requirements of paragraph (c), the appellant will be notified of the reasons for non-compliance and given a one month time limit within which to file an amended brief. The appeal will be dismissed if the appellant does not timely file an amended brief, or files an amended brief which does not overcome all the reasons for non-compliance of which appellant was notified. An amended brief is timely if filed within the one month time limit or within any extension of the original period to file the brief.

>It should be noted that 37 CFR 1.192(c)(5) requires the appellant to perform two affirmative acts in his brief in order to have the separate patentability of a plurality of claims subject to the same rejection considered. The appellant must (1) state that the claims do not stand or fall together and (2) present arguments why the claims subject to the same rejection are separately patentable. Where the appellant does neither, the claims will be treated as standing or falling together. Where, however, the appellant (i) omits the statement required by 37 CFR 1.192(c)(5) yet presents arguments in the argument section of the brief or (ii) includes the statement required by 37 CFR 1.192(c)(5) to the effect that one or more claims do not stand or fall together (i.e., that they are separately patentable) yet does not offer argument in support thereof in the argument section of the brief, the appellant should be notified of the non-compliance as per 37 CFR 1.192(d). *Ex parte Schier*, 21 USPQ 2d 1016 (Bd. Pat. App. & Int. 1991); *Ex parte Ohsumi*, 21 USPQ 2d 1020 (Bd. Pat. App. & Int. 1991).<

The question of whether a brief complies with a rule is a matter within the jurisdiction of the examiner. Under 37 CFR 1.192(d), the appellant may file an amended brief to correct any deficiencies in the original brief. Moreover, if appellant disagrees with the examiner's holding of non-compliance, a petition under 37 CFR 1.181 may be filed.

*>37 CFR 1.192<(d) also contains the following sentence:

"Any argument or authorities not included in the brief may be refused consideration by the Board of Patent Appeals and Interferences."

This sentence emphasizes that all arguments and authorities which a appellant wishes the Board to consider should be included in the brief. It should be noted that arguments not presented in the 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).

37 CFR 1.192(d) is not intended to preclude the filing of a supplemental paper if a new argument or authority should become available or relevant after the brief was filed. The word "may" is used to leave open the possibility that the Board has leeway to consider arguments or authorities not included in the brief under circumstances where the failure to include them can be justified. Examples of such circumstances would be where a pertinent decision of a court or other tribunal was not published until after the brief was filed, or where a particular argument or authority was not applicable to any of the grounds of rejection in the final rejection, but was relevant to a new point of argument raised in the examiner's answer.

Once the brief has been filed, a petition to suspend proceedings may be considered on its merits, but will be granted only in exceptional cases, such as where the writing of the examiner's answer would be fruitless or the proceedings would work a hardship on the appellant.

For reply brief see >MPEP< § 1208.03.

Form Paragraphs 12.08-12.17 should be used in letters concerning the appeal brief.

¶ 12.08 Appeal dismissed — fee unpaid, no allowed claims

The appeal under 37 CFR 1.191 is dismissed because the fee for filing the Brief, as required under 37 CFR 1.17(f), was not submitted or timely submitted and the period for obtaining an extension of time to file the brief under 37 CFR 1.136 has expired.

As a result of this dismissal, the application is ABANDONED since there are no allowed claims.

Examiner Note:

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.

¶ 12.09 Appeal dismissed — fee unpaid, allowed claims

The appeal under 37 CFR 1.191 is dismissed because the fee for filing the Brief, as required under 37 CFR 1.17(f), was not submitted or timely submitted and the period for obtaining an extension of time to file the brief under 37 CFR 1.136 has expired.

As a result of this dismissal, the application will be further processed by the examiner since it contains allowed claims. Prosecution on the merits remains CLOSED.

Examiner Note:

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.

¶ 12.09.1 Appeal dismissed - allowed claims, formal matters remaining

In view of applicant's failure to file a brief within the time prescribed by 37 CFR 1.192, the appeal stands dismissed and the proceedings as to the rejected claims are considered terminated. See 37 CFR 1.197(c).

This application will be passed to issue on allowed claim(s) [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 from the mailing date of this letter.

Examiner Note:

This paragraph should only be used if the formal matters cannot be handled by examiner's amendment. See MPEP >§< 1215.04.

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.

¶ 12.10 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 1.192 filed on [1] has been approved for [2].

Examiner Note:

This paragraph should only be used when 37 CFR 1.136(a) is not available or has been exhausted, such as in litigation reissues.

¶ 12.11 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 1.192 filed on [1] has been disapproved because no sufficient cause for the extension has been shown.

Examiner Note:

This paragraph should only be used when 37 CFR 1.136(a) is not available or has been exhausted, such as in litigation reissues.

¶ 12.12 Brief defective - unsigned

The appeal brief filed on [1] is defective because it is unsigned. A ratification properly signed is required.

APPLICANT IS REQUIRED TO MAKE THE PROPER RATIFICATION WITHIN A TIME LIMIT OF ONE MONTH FROM THE DATE OF THIS LETTER OR WITHIN TWO MONTHS FROM THE DATE OF THE NOTICE OF APPEAL OR WITHIN THE TIME ALLOWED FOR RESPONSE TO THE ACTION APPEALED FROM, WHICHEVER IS LONGER, TO AVOID DISMISSAL OF THE APPEAL. NO EXTENSION OF THIS ONE MONTH TIME LIMIT MAY BE GRANTED UNDER EITHER 37 CFR 1.136 (a) OR (b), BUT THE TWO MONTH PERIOD FOR FILING THE BRIEF MAY BE EXTENDED TO A MAXIMUM OF SIX MONTHS.

¶ 12.13 Brief defective — three copies lacking

The Appeal Brief filed on [1] is defective because the three copies of the Brief required under 37 CFR 1.192(a) have not been submitted.

APPLICANT IS REQUIRED TO SUPPLY THE NECESSARY COPIES WITHIN A TIME LIMIT OF ONE MONTH FROM THE DATE OF THIS LETTER OR WITHIN TWO MONTHS FROM THE DATE OF THE NOTICE OF APPEAL OR WITHIN THE TIME ALLOWED FOR RESPONSE TO THE ACTION APPEALED FROM, WHICHEVER IS LONGER, TO AVOID DISMISSAL OF THE APPEAL. NO EXTENSION OF THIS ONE MONTH TIME LIMIT MAY BE GRANTED UNDER EITHER 37 CFR 1.136 (a) OR (b), BUT THE TWO MONTH PERIOD FOR FILING THE BRIEF MAY BE EXTENDED TO A MAXIMUM OF SIX MONTHS.

¶ 12.16 Brief unacceptable — fee unpaid

The Appeal Brief filed on [1] is unacceptable because the fee required under 37 CFR 1.17(f) was not timely filed. This application will become abandoned unless applicant obtains an extension of time under 37 CFR 1.136(a) to file the Appeal Brief. The date on which the Brief, the fee for filing the Brief, the petition under 37 CFR 1.136(a), and the petition fee are filed will be the date of the response and also the date for determining the period of extension and the corresponding amount of the fee. In no case may an applicant obtain an extension for more than four months under 37 CFR 1.136(a), beyond the two month period originally set for filing the Brief.

¶ 12.17 Brief unacceptable — not timely filed

The Appeal Brief filed on [1] is unacceptable because it was filed after the expiration of the required period for response.

This application will become abandoned unless applicant obtains an extension of time under 37 CFR 1.136(a). The date on which the Brief, the fee for filing the Brief, the petition under 37 CFR 1.136(a), and the petition fee are filed will be the date of the response and also the date for determining the period of extension and the corresponding amount of the fee. In no case may an applicant obtain an extension for more than four months under 37 CFR 1.136(a) beyond the two months originally set for filing the appeal brief.

A form suitable for noting non-compliance with 37 CFR 1.192(c)

¶ 12.69 Heading for Notice under 37 CFR 1.192(c)

NOTIFICATION OF NON-COMPLIANCE WITH THE REQUIREMENTS OF 37 CFR 1.192(c)

Examiner Note:

Use form PTOL-90 and follow with one or more of form paragraphs 12.70 -12.77 and conclude with paragraph 12.78.

¶ 12.70 Missing section headings

The brief does not contain the items of the brief required by 37 CFR 1.192(c) under the appropriate headings and/or in the order indicated. [1]

Examiner Note:

In bracket 1 insert an indication of the missing headings or errors in the order of items

¶ 12.71 Defect in statement of status of claims

The brief does not contain a statement of the status of all the claims, pending or cancelled, and identify the claims appealed as required by 37 CFR 1.192(c)(1). [1]

Examiner Note:

In bracket 1 insert an indication of the missing claim status information.

¶ 12.72 Defect in statement of status of amendment filed after final rejection

The brief does not contain a statement of the status of an amendment filed subsequent to the final rejection as required by 37 CFR 1.192(c)(2). [1]

Examiner Note:

In bracket 1 insert an indication of the amendment of which the status is missing.

¶ 12.73 Defect in explanation of the invention

The brief does not contain a concise explanation of the invention defined in the claims involved in the appeal, which refers to the specification by page and line number, and to the drawing, if any, by reference characters as required by 37 CFR 1.192(c)(3). [1]

Examiner Note:

In bracket 1 insert an indication of the missing explanation.

¶ 12.74 Defect in statement of the issues

The brief does not contain a concise statement of the issues presented for review as required by 37 CFR 1.192(c)(4). [1]

Examiner Note:

In bracket [1] insert an indication of the missing concise statement of the issues presented for review.

¶ 12.76 Defects in the arguments of the appellant

The brief does not contain arguments of the appellant with respect to each of the issues presented for review in 37 CFR 1.192(c)(4), and the basis therefor, with citations of the authorities, statutes, and parts of the record relied on as required by 37 CFR 1.192(c)(6).

Examiner Note:

Include one or more of form paragraphs 12.76.1 - 12.76.6 which apply.

¶ 12.76.1 Separate heading for each issue

Each issue should be treated under a separate heading.

¶ 12.76.2 Defect in § 112, first paragraph rejection argument

The brief does not contain for each rejection under 35 U.S.C. 112, first paragraph, an argument which specifies the errors in the rejection and how the first paragraph of 35 U.S.C. 112 is complied with, including how the specification and drawings, if any, [1].

Examiner Note:

In bracket 1 insert the following wording which is appropriate:

(A) "describe the subject matter defined by each of the rejected claims"

(B) "enable any person skilled in the art to make and use the subject matter defined by each of the rejected claims"

(C) "set forth the best mode contemplated by the inventor of carrying out his or her invention"

¶ 12.76.3 Defect in § 112, second paragraph rejection argument

The brief does not contain for each rejection under 35 U.S.C. 112, second paragraph, an argument which specifies the errors in the rejection and how the claims particularly point out and distinctly claim the subject matter which applicant regards as the invention.

¶ 12.76.4 Defect in § 102 rejection argument

The brief does not contain for each rejection under 35 U.S.C. 102, an argument which specifies the errors in the rejection and why the rejected claims are patentable under 35 U.S.C. 102, including any specific limitations in the rejected claims which are not described in the prior art relied upon in the rejection.

Examiner Note:

Specify claim(s) for which no argument of error was specified.

¶ 12.76.5 Defect in § 103 rejection argument

The brief does not contain for each rejection under 35 U.S.C. 103, an argument which specifies the errors in the rejection and, if appropriate, the specific limitations in the rejected claims which are not described in the prior art relied on in the rejection, and an explanation how such limitations render the claimed subject matter unobvious over the prior art. If the rejection is based upon a combination of references, the argument must explain why the references, taken as a whole, do not suggest the claimed subject matter, and shall include, as may be appropriate, an explanation of why features disclosed in one reference may not properly be combined with features disclosed in another reference. A general argument that all the limitations are not described in a single reference does not satisfy the requirements of 37 CFR 1.192(c)(6)(iv).

Examiner Note:

Specify claim(s) for which no argument of error was specified.

¶ 12.76.6 For any rejection other than those referred to in paragraphs (c)(6)(i) to (iv) of 37 CFR 1.192 for which no argument of error was specified.

The brief does not contain an argument which specifies the errors in the rejection and the specific limitations in the rejected claims, if appropriate, or other reasons, which cause the rejection to be in error.

Examiner Note:

Specify claim(s) for which no argument of error was specified.

¶ 12.77 No copy of appealed claims in Appendix

The brief does not contain a copy of the claims involved in the appeal in the Appendix.

¶ 12.78 Period for response under 37 CFR 1.192(d)

Appellant is required to comply with the provisions of 37 CFR 1.192(c). ** Appellant is given a TIME LIMIT of ONE MONTH from the date of this letter or any time remaining in the period under 37 CFR 1.192(a) for filing a new complete brief. If a new brief that fully complies with 37 CFR 1.192(c) is not timely submitted, the appeal will be dismissed as of the date of expiration of the period provided by 37 CFR 1.192(a). No extension of this one month time limit may be obtained under either 37 CFR 1.136(a) or (b) but the original two-month period under 37 CFR 1.192(a) for filing the brief may be extended under 37 CFR 1.136(a) up to six months from the date of the Notice of Appeal.

Examiner Note:

This paragraph has limited application. To notify appellant of non-compliance with 37 CFR 1.192(c) examiner must use form PTOL 462.

1207 Amendment Filed With or After Appeal [R-9]

To expedite the resolution of cases under final rejection, an amendment filed at any time after final rejection but before an appeal brief is filed, may be entered upon or after filing of an appeal provided the total effect of the amendment is to (1) remove issues from appeal, and/or (2) adopt examiner suggestions. Of course, if the amendment necessitates a new search, raises the issue of new matter, presents additional claims without cancelling a corresponding number of finally rejected claims, or otherwise introduces new issues, it will not be entered. Examiners must respond to all non-entered amendments after final rejection, and indicate the status of each claim of record or proposed, including the designation of claims that would be entered on the filing of an appeal if filed in a separate paper. It should be noted that an amendment placing a case in condition for allowance will be enterable by the examiner at any stage prior to forwarding the answer on appeal. Except where an amendment merely cancels claims and/or adopts examiner suggestions, removes issues from appeal, or in some other way requires only a cursory review by the examiner, compliance with the requirement of a showing under 37 CFR 1.116(b) will be expected of all amendments after final rejection.

If after appeal has been taken, a paper is presented which *on its face* clearly places the application in condition for allowance, such paper should be entered and a notice of allowability (PTOL-327) or an examiner's amendment promptly sent to applicant.

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 applicant.

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 or any objection or requirement as desired by the examiner. Note MPEP § 1208.02. No new ground of rejection or objection should be incorporated in the examiner's answer *without express approval in each case by the supervisory primary examiner.* See MPEP § 1002.02(d)(3) and MPEP § 1208.01. See MPEP § 714.13 for procedure on handling amendments filed after final action and before appeal.

Note that 37 CFR 1.192(c)(2) requires a statement as to the status of any amendment filed subsequent to the final rejection, MPEP § 1206.

1208 Examiner's Answer [R-14]

37 CFR 1.193. Examiner's answer.

(a) The primary examiner may, within such time as may be directed by the Commissioner, furnish a written statement in answer to the appellant's brief including such explanation of the invention claimed and of the references and grounds of rejection as may be necessary, supplying a copy to the appellant. If the primary examiner shall find that the appeal is not regular in form or does not relate to an appealable action, he shall so state and a petition from such decision may be taken to the Commissioner as provided in § 1.181.

(b) The appellant may file a reply brief directed only to such new points of argument as may be raised in the examiner's answer, within one month from the date of such answer. The new points of argument shall be specifically identified in the reply brief. If the examiner determines that the reply brief is not directed only to new points of argument raised in the examiner's answer, the examiner may refuse entry of the reply brief and will so notify the appellant. If the examiner's answer states a new ground of rejection appellant may file a reply thereto within two months from the date of such answer; such reply may be accompanied by any amendment or material appropriate to the new ground.

**

[Para. (c) deleted, 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992]

APPEAL CONFERENCE

Appealed cases in which the brief has been filed may be reviewed by conference in the group, those participating being (1) a primary examiner, (2) the examiner charged with preparation of the examiner's answer and (3) another examiner, known as the conferee, having sufficient experience to be of assistance in the consideration of the merits of the issues on appeal.

Non-examining time is allowed for all examiners participating in an appeal conference. This includes the examiner whose application or reexamination proceeding is being reviewed during the conference.

The group director has the discretion as to whether or not appeal conferences are necessary in the examining group and, if so, in which instances they are to be held. If an appeal conference is held, the SPE should be informed thereof.

If a conference is held, the primary examiner responsible for signing the examiner's answer should weigh the arguments of the other examiners but it is his or her responsibility to make the final decision. During the conference, consideration should be given to the possibility of dropping cumulative art rejections and eliminating technical rejections of doubtful value.

On the examiner's answer, the third person (conferee) should place his or her initials below those of the examiner who prepared the answer, thus: ABC (conf.). This does not indicate, necessarily, concurrence with the position taken in the answer.

If the examiner charged with the responsibility of preparing the answer reaches the conclusion that the appeal should not be forwarded and the primary examiner approves, no conference is held.

Before preparing the answer, the examiner should make certain that all amendments approved for entry have in fact been physically entered. The clerk of the board will return to the group any application in which approved amendments have not been entered.

ANSWER

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

The answer should contain a response to the allegations or arguments in the brief and should call attention to any errors in appellant's copy of the claims. Grounds of rejection not argued in the examiner's answer are usually treated as having been dropped, but may be considered by the Board if it desires to do so. The examiner should treat affidavits, declarations or exhibits in accordance with 37 CFR 1.195, reporting his or her conclusions only on those admitted. Any affidavits or declarations in the file swearing behind a patent should be clearly identified by the examiner as being considered under either 37 CFR 1.131 or 37 CFR 1.608(b). The distinction is important since the Board will usually consider holdings on 37 CFR 1.131 affidavits or declarations but not holdings on 37 CFR 1.608(b) affidavits or declarations in appeal cases.

If the brief fails to respond to any or all grounds of rejection advanced by the examiner, or comply with 37 CFR 1.192(c), the indicated procedure for handling such briefs set forth in MPEP § 1206 under "Appeal Brief Content" should be followed.

Because of the practice of the Patent and Trademark 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. The new claims or finally rejected claims, as amended, frequently contain limitations not in the claims treated in the final rejection and the arguments in the appellant's brief are directed to the new claims. Under such circumstances the mere reference in the examiner's answer to the final rejection for a statement of his or her position would

leave the Board, insofar as the new claims are concerned, with an uncrystallized issue and without the benefit of the examiner's view, which complicates the task of rendering a decision.

It also frequently happens that an examiner will state a position in the answer in a manner that represents a shift from the position stated in the final rejection without indicating that the last stated position supersedes the former. Such a situation confuses the issue and likewise poses difficulties for the Board since it is not clear exactly what the examiner's ultimate position is.

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 1.193 by taking any of the following steps:

A. Examiners may incorporate in the answer their statement of the grounds of rejection merely by reference to the final rejection (or a single other action on which it is based, MPEP § 706.07. Only those statements of grounds of rejection as appear in a *single* prior action may be incorporated by reference. An examiner's answer should not refer, either directly or indirectly, to more than one prior Office action. Statements of grounds of rejection appearing in actions other than the aforementioned single prior action should be *quoted* in the answer. The page and paragraph of the final action or other single prior action which it is desired to incorporate by reference should be explicitly identified. Of course, if the examiner feels that some further explanation of the rejection is necessary he or she should include it in the answer but ordinarily he or she may avoid another recital of the issues and another elaboration of the grounds of rejection. The answer should also include any necessary rebuttal of arguments presented in the appellant's brief if the final action does not adequately meet the arguments.

B. If the appellant fails to describe the invention, as required by 37 CFR 1.192, the examiner is no longer required to provide these omissions under 37 CFR 1.192(d). The examiner should, however, clarify the description and explanation in the answer if he or she feels it necessary to present properly and effectively his or her case to the Board.

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, especially if the rejection was made in an action which is incorporated by reference. This should be done even though any rejection not repeated and discussed in the answer may be taken by the Board as having been withdrawn.

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 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.

When files are forwarded, soft copies and prints of references therein should remain in the file wrapper.

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 group director for consideration, see MPEP § 1003. If approved by the group director, the examiner's answer should be forwarded to the Office of the Assistant Commissioner for Patents for final approval.

Briefs filed in cases where the notice of appeal was filed on or after September 12, 1988 must comply with amended 37 CFR 1.192 and all examiner's answers filed in response to such briefs must comply with the guidelines set forth below.

Requirements for Examiner's Answer

The examiner's answer is required to include, in the order indicated, the following items:

(1) Status of claims. A statement of whether the examiner agrees or disagrees with the statement of the status of claims contained in the brief and a correct statement of the status of all the claims pending or cancelled, if necessary. If the examiner considers that some or all of the finally rejected claims are allowable, see MPEP § 1208.02.

(2) Status of Amendments. A statement of whether the examiner disagrees with the statement of the status of amendments contained in the brief, and an explanation of any disagreement.

(3) Summary of invention. A statement of whether the examiner disagrees with the summary of invention contained in the brief, an explanation of why the examiner disagrees, and a correct summary of invention, if necessary.

(4) Issues. A statement of whether the examiner disagrees with the statement of the issues in the brief and an explanation of why the examiner disagrees, including:

(i) Identification of any issues which are petitionable rather than appealable, and

(ii) Identification of any issues or grounds of rejection on appeal which the examiner no longer considers applicable.

(5) Grouping of Claims. A statement of whether the examiner disagrees with any statement in the brief that certain claims do not stand or fall together, and, if the examiner disagrees, an explanation as to why those claims are not separately patentable.

(6) Claims appealed. A statement of whether the copy of the appealed claims contained in the appendix to the brief is correct and if not, a correct copy of any incorrect claim.

(7) References of record. A listing of the references of record relied on, and in the case of non-patent references, the relevant page or pages.

(8) New prior art. A statement of whether or not any new prior art is being applied and a listing of each such prior art reference being cited for a new ground of rejection in the examiner's answer, and in the case of non-patent prior art) the

relevant page or pages.

(9) Grounds of rejection. For each ground of rejection applicable to the appealed claims, an explanation of the ground of rejection, or reference to a final rejection or other single prior action for a clear exposition of the rejection.

(i) For each rejection under 35 U.S.C. 112, first paragraph, the examiner's answer, or the single prior action, 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 without undue experimentation, and (c) do not set forth the best mode contemplated by the appellant of carrying out his or her invention.

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

(iii) For each rejection under 35 U.S.C. 102, the examiner's answer, or single prior action, 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, or single prior action,

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 on in the rejection,

shall identify any difference between the rejected claims and the prior art relied on and

shall explain how and why the claimed subject matter is rendered unpatentable over the prior art. If the rejection is based upon a combination of references, the examiner's answer, or single prior action, shall explain the rationale for making the combination.

(v) 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 (9)(iii) and (iv) above, the examiner shall 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 number, 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) of this section, the examiner's answer, or single prior action, shall specifically explain the basis for the particular rejection.

(10) New ground of rejection. A statement of whether or not any new ground of rejection is being made in the examiner's answer and a complete statement and explanation of any such new ground. The requirements of section (9) shall be complied with for any new ground of rejection.

(11) 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. If any ground of rejection is not argued and responded to by appellant, the response shall point out each claim affected.

(12) Period of response to new ground of rejection. A statement setting the period for appellant to file a reply to any new ground of rejection, if necessary.

A form suitable for the examiner's answer is as follows:

¶ 12.50 Heading for Examiner's Answer

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed [1].

¶ 12.51 Status of claims

(1) Status of claims.

Examiner Note:

Follow ¶ 12.51 with one or more of ¶¶ 12.51.1 - 12.51.10.

¶ 12.51.1 Agreement with statement of status of claims

The statement of the status of claims contained in the brief is correct.

¶ 12.51.2 Disagreement with statement of status of claims

The statement of the status of claims contained in the brief is incorrect.

A correct statement of the status of the claims is as follows:

Examiner Note:

Indicate the area of disagreement and the reasons for the disagreement.

One or more of ¶¶ 12.51.3 - 12.51.10 must follow this paragraph.

¶ 12.51.3 Claims on appeal

This appeal involves claim [1]

Examiner Note:

1. In bracket 1, all the claims still on appeal should be specified. Do not list claims which are no longer rejected.

2. Also use form paragraphs 12.51.4 - 12.51.6 when appropriate to clarify the status of the claims on appeal that were incorrectly listed in the brief.

¶ 12.51.4 Status of claims on appeal - substituted

Claim [1] substituted for finally rejected claims.

Examiner Note:

All substituted claims on appeal must be identified if the brief incorrectly lists any substituted claims.

¶ 12.51.5 Status of claims on appeal - amended

Claim [1] amended subsequent to the final rejection.

Examiner Note:
All claims amended after final rejection must be identified if the brief incorrectly lists any claims amended after final rejection.

¶ 12.51.6 Status of claims on appeal - substituted and amended
Claim [1] substituted for finally rejected claims and claim [2] amended subsequent to the final rejection.

Examiner Note:
All claims substituted or amended after final rejection must be identified if the brief incorrectly lists any claims substituted or amended after final rejection.

¶ 12.51.7 Claims allowed
Claim [1] allowed.

Examiner Note:
All allowed claims must be identified if the brief incorrectly lists any allowed claims.

¶ 12.51.8 Claims objected to
Claim [1] objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Examiner Note:
All objected to claims must be identified if the brief incorrectly lists any claims objected to.

¶ 12.51.9 Claims withdrawn from consideration
Claim [1] withdrawn from consideration as not directed to the elected [2].

Examiner Note:
All withdrawn claims must be identified if the brief incorrectly lists any withdrawn claims.

¶ 12.51.10 Claims cancelled
Claim [1] been cancelled.

Examiner Note:
All cancelled claims must be identified if the brief incorrectly lists any cancelled claims.

¶ 12.52 Status of Amendments.
(2) Status of Amendments After Final.

Examiner Note:
Identify status of all amendments submitted after final rejection. Use one or more of ¶¶ 12.52.1 - 12.52.4, if appropriate.

¶12.52.1 Agreement with appellant's statement of the status of amendments after final
The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

¶12.52.2 Disagreement with appellant's statement of the status of amendments after final
The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

Examiner Note:
Form Paragraphs 12.52.3 and/or 12.52.4 must follow this paragraph to explain the reasons for disagreeing with appellant's statement of the status of the amendments

¶12.52.3 Amendment after final entered
The amendment after final rejection filed on [1] has been entered.

Examiner's Note:
In bracket [1] insert the date of any entered amendment.

§ 12.52.4 Amendment after final not entered
The amendment after final rejection filed on [1] has not been entered.

Examiner's Note:
In bracket [1] insert the date of any amendment denied entry.

¶12.52.5 No amendments after final
No amendment after final has been filed.

¶ 12.53 *Summary of invention*
(3) Summary of invention.

Examiner Note:
Follow ¶ 12.53 with either ¶ 12.53.1 or ¶ 12.53.2

¶ 12.53.1 Agreement with the summary of invention
The summary of invention contained in the brief is correct.

¶ 12.53.2 Disagreement with the summary of invention
The summary of invention contained in the brief is deficient because [1].

Examiner Note:
In bracket [1] explain the deficiency of the appellant's summary of the invention. Include a correct summary of the invention if necessary for a clear understanding of the claimed invention.

¶ 12.54 Issues
(4) Issues.

Examiner Note:
Follow ¶ 12.54 with ¶ 12.54.1, ¶ 12.54.2, or 12.54.3.

¶ 12.54.1 Agreement with appellant's statement of the issues
The appellant's statement of the issues in the brief is correct.

¶ 12.54.2 *Disagreement with appellant's statement of the issues*
The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: [1].

Examiner Note:
In bracket 1 explain the changes with the appellant's statement of the issues in the brief including;
(i) an identification of any issues which are petitionable rather than appealable, and/or
(ii) an identification of any issues or grounds of rejection on appeal which the examiner no longer considers applicable.
(iii) any change not covered in (i) and (ii).

¶ 12.54.3 Non-appealable issue in brief
Appellant's brief presents arguments relating to [1]. This issue relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP §§ 1002 and 1201.

¶ 12.55 Grouping of Claims

(5) Grouping of Claims.

Examiner Note:

Follow ¶ 12.55 with either ¶ 12.55.1, ¶ 12.55.2 or ¶ 12.55.3 for each grouping of claims (i.e., each ground of rejection which appellant contests).

¶ 12.55.1 No statement in brief that claims do not stand or fall together

The rejection of claims[1] stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together. See 37 CFR 1.192(c)(5).

Examiner Note:

1. Use this paragraph for each grouping of claims (i.e., ground of rejection which appellant contests) wherein the brief does not include a statement that a grouping of claims does not stand or fall together.

2. If the brief includes a statement that a grouping of claims does not stand or fall together but does not provide reasons, as set forth in 37 CFR 1.192(c)(5), use either paragraph 12.55.2 or 12.55.3.

¶ 12.55.2 No agreement with brief why claims do not stand or fall together

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because [1].

Examiner Note:

In bracket 1 explain why the claim grouping listed in the brief is not agreed with by the examiner and why, if appropriate, the claims as listed by the appellant are not separately patentable.

¶ 12.55.3 No reasons in brief why claims do not stand or fall together.

The brief includes a statement that claims [1] do not stand or fall together but fails to present reasons in support thereof. Therefore, these claims are presumed to stand or fall together.

Examiner Note:

This paragraph should be used only when no supporting reasons are presented in the brief. If reasons are presented, even if they are not agreed with, use form paragraph 12.55.2 instead of this paragraph. Reasons for disagreement are discussed in either the "Grounds of Rejection" or in the "Response to Arguments" portion of the examiner's answer.

¶ 12.55.4 Brief gives reasons why claims do not stand or fall together

Appellant's brief includes a statement that claims [1] do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(5) and (c)(6).

¶ 12.56 Claims appealed

(6) Claims appealed.

Examiner Note:

Follow ¶ 12.56 with ¶ 12.56.1, ¶ 12.56.2 or ¶ 12.56.3.

¶ 12.56.1 Copy of the appealed claims in the appendix is correct.

The copy of the appealed claims contained in the Appendix to the brief is correct.

¶ 12.56.2 Copy of the appealed claims in the Appendix is substantially correct.

A substantially correct copy of appealed claim [1] appears on page [2] of the Appendix to the appellant's brief. The minor errors are as follows: [3]

Examiner Note:

1. In bracket 1, indicate the claim or claims with small errors.

2. In bracket 3, indicate the nature of the errors.

12.56.3 Copy of the appealed claims in the Appendix contain substantial errors.

Claim [1] contain(s) substantial errors as presented in the Appendix to the brief. Accordingly, claim [2] correctly written in the Appendix to the examiner's answer.

Examiner Note:

1. Appellant should include a correct copy of all appealed claims in the Appendix to the brief. See 37 CFR 1.192(c)(7).

2. Attach a correct copy of any incorrect claims as an Appendix to the examiner's answer and draw a diagonal line in pencil through the incorrect claim in the Appendix of the appellant's appeal brief.

3. Rather than using this form paragraph, if the errors in the claim(s) are significant, appellant should be required to submit a corrected brief using form paragraphs 12.69, 12.77 and 12.78, as well as any other paragraphs 12.70 to 12.76 as may be appropriate. Where the brief includes arguments directed toward the errors, a corrected brief should always be required.

¶ 12.57 Prior art of record

(7) Prior Art of record.

Examiner Note:

Follow ¶ 12.57 with either ¶ 12.57.1 or ¶ 12.57.2

¶ 12.57.1 No prior art relied upon

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

¶ 12.57.2 Listing of the prior art of record relied upon

The following is a listing of the prior art of record 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 VERAIN 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

¶ 12.58 New prior art

(8) New prior art.

Examiner Note:

Follow ¶ 12.58 with either ¶ 12.58.1 or ¶ 12.58.2

¶ 12.58.1 No new prior art

No new prior art has been applied in this examiner's answer.

¶ 12.58.2 New reference applied

[1] been applied in a new ground of rejection in this examiner's answer and listed below: [2]

Examiner Note:

1. SPE approval for the citation of new art is required. See also ¶12.44.

2. In bracket 1 insert either "A new reference has" or "New references have".

3. In bracket 2 list the new reference(s) applied in a new rejection in the examiner's answer.

4. List all patent document references of record by number, name and date. For example: 1,736,481 Smith 6 - 87

5. In the case of non-patent references, list the relevant page or pages.

6. Copies of newly cited references should be supplied with the examiner's answer.

7. A PTO-892 must be completed for the file for use by the printer in case of issuance of the application as a patent.

¶ 12.59 Grounds of rejection
(9) Grounds of rejection.

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

Examiner Note:
Explain each ground of rejection or refer to the single prior Office action which clearly sets forth the rejection and complies with appropriate paragraphs i - iv below:

(i) For each rejection under 35 U.S.C. 112, first paragraph, the examiner's answer, or the single prior action, 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 or her invention.

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

(iii) For each rejection under 35 U.S.C. 102, the examiner's answer, or single prior action, 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, or single prior action,

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 on in the rejection,

shall identify any difference between the rejected claims and the prior art relied on and

shall explain how the claimed subject matter is rendered unpatentable over the prior art. If the rejection is based upon a combination of references, the examiner's answer, or single prior action,

shall explain the rationale for making the combination.

(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 (9)(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 number, 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) of this section, the examiner's answer, or single prior action, shall specifically explain the basis for the particular rejection.

¶ 12.60 New ground of rejection
(10) New ground of rejection.

Examiner Note:
Follow ¶ 12.60 with either ¶ 12.60.1 or ¶ 12.60.2

¶ 12.60.1 No new ground of rejection
This Examiner's Answer does not contain any new ground of rejection.

¶ 12.60.2 New ground of rejection
This examiner's answer contains the following NEW GROUND OF REJECTION.

Examiner Note:
1. Include a complete statement and explanation of the new ground. The requirements as set forth in ¶ 12.59 relating to "grounds of rejection" must also be complied with for any new ground of rejection.

2. This heading should precede each new ground of rejection made in an examiner's answer.

3. Approval by the SPE is required.

¶ 12.61 Response to argument
(11) Response to argument.

Examiner Note:
1. If an issue raised by appellant was fully responded to under "Grounds of Rejection", no additional response is required here.

2. If an issue has been raised by appellant that was not fully responded to under the "Grounds of Rejection", a full response must be provided after ¶ 12.61.

¶ 12.62 Period of response to new ground of rejection
(12) Period of response to new ground of rejection.

In view of the new ground of rejection, appellant is given a period of TWO MONTHS from the mailing date of this examiner's answer within which to file a reply to any new ground of rejection. Such reply may include any amendment or material appropriate to the new ground of rejection. Prosecution otherwise remains closed. Failure to respond to the new ground of rejection will result in dismissal of the appeal of the claims so rejected.

¶ 12.63 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:
a. an oral hearing has been requested by appellant, and
b. the primary examiner intends to present an oral argument.

2. If appellant's request for an oral hearing has been made before or with the brief, this form paragraph may be included at the end of the examiner's answer.

3. If appellant's request for an oral hearing has been made after the examiner's answer, this form paragraph may be included in a supplemental examiner's answer, an acknowledgment of reply brief (see form

paragraph 12.47), or in a separate letter on a form PTOL-90.

¶ 12.79 Examiner's Answer, Conclusion

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

Respectfully submitted,

If a new ground of rejection is raised, see MPEP § 1208.01.

For >a< case having >a< patentability report, see MPEP § 705.01(a). **

>If the examiner requests an oral hearing, see MPEP § 1209, the request should appear in the last paragraph of the examiner's answer.

The examiner should make a pencil notation "Examiner requests an Oral Hearing " on the face of the file wrapper below the box for the examiner's name when an oral hearing is requested.

12.48 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:
   a. an oral hearing has been requested by appellant, and
   b. the primary examiner intends to present an oral argument.
2. If appellant's request for an oral hearing has been made before or with the brief, this form paragraph may be included at the end of the examiner's answer.
3. If appellant's request for an oral hearing has been made after the examiner's answer, this form paragraph may be included in a supplemental examiner's answer, an acknowledgment of reply brief (see form paragraph 12.47), or in a separate letter on a form PTOL-90.<

1208.01 New Reference, New Objection or New Ground of Rejection in Examiner's Answer [R-14]

At the time of preparing the answer to an appeal brief, the examiner may decide that he or she should cite a new reference, raise a new objection, or apply a new ground of rejection (new reference, double patenting, statutory bar or other reason for rejection) against some or all of the appealed claims. All answers citing new references or containing new grounds of rejection or objection must be routed over the supervisory primary examiner's desk for review and **>signature<. If **>there is< the citation of new references, the answer will be mailed by the group and will include copies of the new references. Also, a PTO-892 listing any new references must be completed for the file for use by the printer in case of issuance as a patent. The Board will return to the group director's office any answer containing (1) a newly cited reference or (2) a new ground of rejection, where such answer does not bear **>the supervisory primary examiner's signature<.

In order to introduce a new ground of rejection it is necessary either to reopen the ex parte prosecution before the examiner or to include the new rejection in the examiner's answer, depending on existing circumstances. The choice of action to be followed will depend on such factors as (1) the history of the prosecution, (2) the number of claims affected, (3) the importance of the new ground of rejection, (4) the significance of the new reference and (5) the nature of the response to be expected. For example, if the reference is basic and materially better in meeting all of the claims, reopening of the prosecution and making the action final would ordinarily be approved if the requirements for making an action final under MPEP § 706.07(a) are met. Should appellant desire later to have the Board review the examiner's new final action, the appellant must file a new Notice of Appeal and a new brief. On the other hand, if the new reference anticipates some but not all of the claims or supplies a minor lack in art already relied on, inclusion of the new ground in the examiner's answer would normally be the approved procedure. Of course, if the new ground of rejection applies to any claim standing allowed the prosecution should be reopened.

It is important that the new ground with regard to which the supervisory primary examiner has been consulted be clearly indicated as such so that the Board can readily identify those cases where appellant is entitled to a period of two months for reply. Any new reference should be cited under the caption "New Reference(s)."

Likewise when a ground of rejection not involving a new reference is raised for the first time in the answer after consultation with the supervisory primary examiner the fact that it is a new ground should be clearly indicated. In this connection it is noted that even if the same references are relied upon in the answer as were relied upon in the final rejection, but the thrust of the rejection is changed, the examiner should identify the rejection as a new ground of rejection. See MPEP § 1208 under Requirements for Examiner's Answer".

The examiner's answer which includes a new ground of rejection should include form paragraph 12.60.2 and conclude with form paragraph 12.62.

1208.02 Withdrawal of Final Rejection [R-9]

The examiner may withdraw the final rejection at any time prior to the mailing of the examiner's answer. It is possible that after reading the brief, the examiner may be convinced that some or all of the finally rejected claims are allowable. Where the examiner is of the opinion that some of the claims are allowable, he or she should so specify in the examiner's answer and confine the arguments to the remaining rejected claims. If the examiner finds, upon reconsideration, that all the rejected claims are allowable, or where the appellant in the brief withdraws the appeal as to some of the rejected claims and the examiner finds the remaining claims to be allowable, the examiner should pass the case to issue.

In applications where an interference has resulted from the applicant copying claims from the patent which provided the basis for final rejection, the rejection based on that patent should be withdrawn and the appeal dismissed as to the involved claims.

1208.03 Reply Brief [R-9]

37 CFR 1.193 Examiner's answer

* * * * *

(b) The appellant may file a reply brief directed only to such new points of argument as may be raised in the examiner's answer, within one month from the date of such answer. The new points of argument shall be specifically identified in the reply brief. If the examiner determines that the reply brief is not directed only to new points of argument raised in the examiner's answer, the examiner may refuse entry of the reply brief and will so notify the appellant. If the examiner's answer states a new ground of rejection appellant may file a reply thereto within two months from the date of such answer; such reply may be accompanied by any amendment or material appropriate to the new ground.

* * * * *

Under 37 CFR 1.193(b), the appellant may file a reply brief if the examiner's answer contains (1) new points of argument, or (2) a new ground of rejection.

In those situations where a reply brief is *clearly* unwarranted (e.g., no new grounds of rejection or new points of argument in the examiner's answer), the examiner should refuse entry of the reply brief, and *notify* the appellant *in writing* in order to begin the two month period for petition under 37 CFR 1.181.

(1) NEW POINTS OF ARGUMENT IN EXAMINER'S ANSWER

Where new points of argument have been raised in the examiner's answer, appellant may file a reply brief within one month from the date of such answer. Appellants must clearly and specifically indicate in their reply briefs the new points of argument "raised in the examiner's answer" to which said reply briefs are directed. 37 CFR 1.193(b) does not permit general rebuttal of each statement made in the examiner's answer. If the examiner determines that the reply brief is not directed only to new points of argument raised in the examiner's answer, the examiner may refuse entry of the reply brief and will so notify the appellant.

Since the reply brief must be limited to any new points of argument raised in the examiner's answer, compliance with the requirement of the second sentence of 37 CFR 1.193(b) should facilitate both preparation of the reply brief by appellant and consideration of the reply brief by the Patent and Trademark Office. The reply brief is appropriately limited to new points of argument raised in the examiner's answer because appellants have an obligation to present arguments supporting their positions in their opening briefs. Considering an argument advanced for the first time in a reply brief would not only delay the proceeding, but also would entail the risk of an improvident or ill-advised opinion on the legal issues tendered. *Von Brimer v. Whirlpool Corp.*, 536 F.2d 838, 846, 190 USPQ 528, 534 (9th Cir. 1976).

(2) NEW GROUND OF REJECTION IN EXAMINER'S ANSWER

Where a new ground of rejection is raised in the examiner's answer, the appellant, under 37 CFR 1.193(b) has two months within which to file a reply brief. The appellant's reply, insofar as the new ground of rejection is concerned, may include any amendment or material appropriate to the new ground. Consideration will be limited to amendments and facts pertinent to the new ground >of< rejection.

An amendment limited to the new ground of rejection is entitled to entry: *Ex parte Abseck et al.*, 133 USPQ 411 (Supervisory Examiner, 1960).

Appellants are reminded that their briefs in appealed cases must be responsive to every ground of rejection stated by the examiner, including new grounds stated in the examiner's answer.

Where an appellant fails to respond in the reply brief to the new ground of rejection, appellant shall be notified by the examiner that he or she is allowed one month to correct the defect by filing a supplemental reply brief. Where this procedure has not been followed, the Board should remand the application to the examiner for compliance.

The final sentence of 37 CFR 1.193(b) provides that the reply brief may be accompanied by any amendment or material appropriate to the new ground of rejection. This makes it clear that any amendment or other material appropriate to the new ground of rejection must be presented in a separate paper, rather than in the reply itself. 37 CFR 1.193(b) requires that the appellant be notified if the reply brief is not entered because of non-compliance with the rule, and an appellant who disagrees with that ruling may seek review by way of a petition under 37 CFR 1.181.

1208.04 Supplemental Examiner's Answer [R-14]

Normally, when a reply brief has been filed by the appellant in response to a new point of argument in the examiner's answer, the case should be forwarded to the Board without any need for the preparation of a supplemental answer by the examiner. The examiner should notify appellant of consideration of the reply brief by using form paragraph 12.47. However, where good reason to respond is apparent, the examiner may issue a supplemental answer in response to the reply brief before forwarding the case to the Board. If an amendment, affidavit or declaration was filed with the reply brief, the examiner must notify the appellant in writing whether it has been entered, and if it is entered, the examiner must issue a supplemental answer in response.

¶ 12.47 Acknowledgment of reply brief

The reply brief filed [1] has been entered and considered but no further response by the examiner is deemed necessary. The application has been forwarded to the Board of Patent Appeals and Interferences for decision on the appeal.

Examiner Note:

1. Type on PTOL-90

2. Do not use this form paragraph if a Supplemental Examiner's answer is prepared.

3. Where good reason to respond is apparent, the examiner may issue a supplemental answer in response to the reply brief before

forwarding the case to the Board. If an amendment, affidavit or declaration was filed with the reply brief, the examiner must notify the appellant in writing whether it has been entered, and if it is entered, the examiner must issue a supplemental answer in response.

If the reply brief was filed in response to a new ground of rejection in the examiner's answer, the examiner must issue a supplemental answer indicating whether the new ground of rejection has been overcome, and, if it has not, explaining why not.

**

1209 Oral Hearing [R-13]

37 CFR 1.194 Oral hearing.

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

(b) If appellant desires an oral hearing, appellant must file a written request for such hearing accompanied by the fee set forth in § 1.17(g) within one month after the date of the examiner's answer. If the examiner's answer states a new ground of rejection and if appellant files a reply as provided for by § 1.193(b), then the written request must be made within three months after the date of the filing of the reply. If appellant requests an oral hearing and submits therewith the fee set forth in § 1.17(g), 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.

(c) If no request and fee for oral hearing have been timely filed by the appellant, the appeal will be assigned for consideration and decision. If the appellant has requested an oral hearing and has submitted the fee set forth in § 1.17(g), a day of hearing will be set, and due notice thereof given to the appellant and to the primary examiner. Hearing will be held as stated in the notice, and oral argument will be limited to twenty minutes for the appellant and fifteen minutes for the primary examiner unless otherwise ordered before the hearing begins.

**An additional time period is provided to the appellant for requesting an oral hearing in the event that the examiner's answer states a new ground of rejection. If the answer states a new ground of rejection, 37 CFR 1.193(b) provides that appellant's reply brief may be accompanied by any amendment or material appropriate to the new ground of rejection. Although the examiner does not normally issue a supplemental answer in response to a reply, see MPEP § 1208.04, 37 CFR 1.194(b) permits the appellant to postpone filing a request for an oral hearing until three months after the date the reply brief is filed. This gives the appellant time to receive the examiner's response, if any, to the reply brief before the appellant must decide whether to request an oral hearing.

>In the past, appellants could use fee extensions to delay the time for requesting an oral hearing at the Board of Patent Appeals and Interferences. This delayed final disposition of the appeal and causes administrative problems and duplication of effort due to the transfer of the appeal to the hearing docket. 37 CFR 1.191(d) no longer refers to 37 CFR 1.194. Fee extensions are no longer available to extend the time for requesting an oral hearing. Extensions under 37 CFR 1.136(b) are available to extend the time to request an oral hearing.<

Notice of the oral hearing will be given to the appellant and, at the same time, to the primary examiner in those cases in which the primary examiner has indicated an intention to present an oral argument.

After an oral hearing has been confirmed and the date set as provided in 37 CFR 1.194(c), the application file will be delivered to the examiner via the appropriate group director at least one week prior to the date of the hearing for those cases in which the examiner is expected to be present at the hearing. In those cases where the Board requests the presentation of an oral argument by, or on behalf of, the primary examiner, the appellant will be so notified. The Board's request for an oral argument may, where appropriate, indicate specific points or questions to which the argument should be particularly directed. The application file must be returned to the Board at least two working days before the hearing.

In those appeals in which an oral hearing has been confirmed and either the primary examiner or the Board has indicated a desire for oral argument, oral argument may be presented by the examiner whether or not appellant appears. If appellant desires to argue his or her case before the Board, he or she must file a brief and within one month of the examiner's answer and indicate he or she desires an oral hearing or , if the examiner's answer states a new ground of rejection and if appellant files a reply as provided for by 37 CFR 1.193(b), then the written request for an oral hearing must be made within three months after the date of the filing of the reply. If no request has been made by appellant, the appeal will be assigned for consideration and decision. That is, the decision will be rendered on the brief.

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 within the stated time, the appeal is 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 is 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 time set in the notice conflicts with prior commitments or if subsequent events make appearance impossible, the hearing may be rescheduled on written request. However, postponements are discouraged and will not be granted in the absence of convincing reasons in support of the requested change.

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 cases, if made known to the Board in advance, as long as such request does not unduly delay a decision in the case.

The arguments at the hearing may be presented by appellant's attorney or agent if he or she is duly authorized in accordance with 37 CFR 1.34(a).

Currently, twenty 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.

Primary examiners are permitted to present oral arguments before the Board in appeals where the appellant has been granted an oral hearing. After the appellant has made his or her presentation, the examiner will be allowed fifteen 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. Appellant may utilize any allotted time not used in the initial presentation for rebuttal.

Currently, up to two examiners are permitted to attend any one hearing as observers, where the case is related to the examiners' field of technology.

Participation by examiners is considered to be desirable not only from the standpoint of improving the overall presentation of the argument, particularly in complex cases, but also for the educational and experience benefits to the examiners themselves.

In any appeal where oral argument is to be presented by, or on behalf of, the primary examiner, the appellant will be given due notice of that fact.

**>See MPEP § 1208 concerning inclusion of a request for oral hearing in the examiner's answer.<

1210 Actions Subsequent to Examiner's Answer but Before Board's Decision [R-14]

JURISDICTION OF BOARD

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

(1) After 2 months from the examiner's answer, plus mail room time, if a "new ground of rejection" has been indicated in the examiner's answer and no reply brief has been timely filed.

(2) After one month from the examiner's answer, plus mail room time, where no new ground of rejection has been indicated in the examiner's answer and no reply brief has been timely filed.

(3) After a supplemental examiner's answer has been mailed in reply to a timely reply brief.

(4) After the examiner has determined by initialing and dating the reply brief, that he or she will not prepare a supplemental examiner's answer in response to a timely reply brief.

**

Any amendment, affidavit, 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.

DIVIDED JURISDICTION

Where appeal is taken from the 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 examiner-in-chief in charge of the interference approves, an appeal to the Board may proceed concurrently with an interference. See MPEP § 2315.

ABANDONMENT OF APPEAL

To avoid the rendering of decisions by the Board in applications which have already been refiled as continuations, appellants should promptly inform the 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-13]

The Board has authority to remand a case to the examiner for a fuller description of the claimed invention and, in the case of a machine, a statement of its mode of operation. In certain cases where the pertinence of the references is not clear, the Board may call upon the examiner for a further explanation. 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, affidavits or declarations.

The group director should approve and the Board should be notified whenever a remanded application is withdrawn from appeal under any circumstance. See MPEP §§ 706.07(c) - 706.07(e).

1211.01 Remand by Board To Consider Amendment [R-14]

While 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*, **58 USPQ 327 **>(CCPA 1943)<, a proposed amendment, affidavit, declaration, or other paper may be remanded for such consideration as the examiner may see fit to give. Such an amendment, unless filed under 37 CFR 1.193(b), will be treated as an amendment filed after appeal. See MPEP § 1207.

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

1212 Remand by Board To Consider Affidavits or Declarations [R-14]

37 CFR 1.195. Affidavits or declarations after appeal.

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

Affidavits or declarations filed with or after appeal but before the mailing of the examiner's answer will be considered for entry only if the appellant makes the necessary showing under 37 CFR 1.195 as to why they 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 a MPEP *§ 715.09 and >§< 716.

In the case of affidavits or declarations filed after the application has been forwarded to the Board, but before a decision thereon by the Board, the examiner is without authority to consider the same in the absence of a remand by the Board. When a case is remanded to the examiner for the consideration of such affidavits or declarations, the examiner, after having given such consideration as the facts in the case require, will return the case to the Board with his or her answer on remand, a copy of which should be forwarded to the appellant. If such an affidavit or declaration is not accompanied by the showing required under 37 CFR 1.195, the examiner will not consider its merits. If the delay in filing such affidavit or declaration is satisfactorily explained, the examiner will admit the same and consider its merits.

It is not the custom of the Board to remand affidavits or declarations offered in connection with a request for reconsideration of its decision where no rejection has been made under 37 CFR 1.196(b). Affidavits or declarations submitted for this purpose, not remanded to the examiner, are considered only as arguments. *In re Martin*, **69 USPQ 75 **>(CCPA 1946)<.

For remand to the examiner to consider appellant's remarks relating to a 37 CFR 1.196(b) rejection see MPEP § 1214.01.

1213 Decision by Board [R-13]

37 CFR 1.196. Decision by the Board of Patent Appeals and Interferences.

(a) The Board of Patent Appeals and Interferences, 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 >or remand the application to the examiner for further consideration<. 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.

* * * * *

After consideration of the record including appellant's brief and the examiner's answer, 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.

On occasion the Board has refused to consider an appeal until after the conclusion of a pending civil action or appeal to the C.A.F.C. 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 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 request 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 request where the request 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.

Since review of the decisions of the Board is committed by statute to the courts, its decisions are properly reviewable on petition only to the extent of determining whether they involve obvious error or abuse of discretion. Reasonable rulings made by the Board on matters resting in its discretion will not be disturbed upon petition. Thus, for example, the Board's opinion as to whether it has employed a new ground of rejection will not be set aside on petition unless said opinion is found to be clearly unwarranted.

See MPEP § 1214.01 concerning a new ground of rejection by the Board under 37 CFR 1.196(b).

1213.01 Recommendations of Board [R-14]

37 CFR 1.196. Decision by the Board of Patent Appeals and Interferences.

* * * * *

(c) Should the decision of the Board of Patent Appeals and Interferences include an explicit statement that a claim may be allowed in amended form, appellant shall have the right to amend in conformity with such statement, which shall be binding on the examiner in the absence of new references or grounds of rejection.

* * * * *

If the examiner knows of references or reasons which were not before the Board, such a favorable recommendation is not binding. Likewise, any change in a favorably recommended claim other than the amendments recommended would tend to destroy the force of such recommendation. *Ex parte Young*, 18 Gour. 24, 31.

In the absence of an express recommendation, a remark by the Board that a certain feature does not appear in a claim is not to be taken as a recommendation that the claim be allowed if the feature is supplied by amendment. *Ex parte Norlund*, 1913 C.D. 161, 192 O.G. 989 >(Comm'r Pat. 1913)<.

Appellant's right to amend in conformity with the recommendation may only be exercised within the period allowed for

seeking court review under 37 CFR 1.304. See MPEP § 1216.

1213.02 Statement as to Rejection of an Allowed Claim [R-13]

37 CFR 1.196. Decision by the Board of Patent Appeals and Interferences.

* * * * *

(d) Although the Board of Patent Appeals and Interferences normally will confine its decision to a review of rejections made by the examiner, should it have knowledge of any grounds for rejecting any allowed claim it may include in its decision a recommended rejection of the claim and remand the case to the examiner. In such event, the Board shall set a period, not less than one month, within which the appellant may submit to the examiner an appropriate amendment, a showing of facts or reasons, or both, in order to avoid the grounds set forth in the recommendation of the Board of Patent Appeals and Interferences. The examiner shall be bound by the recommendation and shall enter and maintain the recommended rejection unless an amendment or showing of facts not previously of record is filed which in the opinion of the examiner, overcomes the recommended rejection. Should the examiner make the recommended rejection final the applicant may >again< appeal to the Board of Patent Appeals and Interferences.

>(e)< Whenever a decision of the Board of Patent Appeals and Interferences includes a remand, that decision shall not be considered as a final decision. When appropriate, upon conclusion of the proceedings before the examiner, the Board of Patent Appeals and Interferences may enter an order otherwise making its decision final.

37 CFR 1.196(d) provides express authority for the Board to include, in its decision, a recommendation for rejecting any allowed claim that it believes should be considered by the examiner. 37 CFR 1.196(d) also provides that the Board may remand the case to the examiner for such consideration, and that the appellant shall have an opportunity to respond to the grounds set forth by the Board prior to consideration by the examiner. If the previously allowed claims are rejected by the examiner, the rejection may be appealed to the Board.

37 CFR 1.196(>e<) * provides that a decision of the Board which includes a remand will not be considered as a final decision in the case. ** The Board, following conclusion of the proceedings before the examiner, will either adopt its earlier decision as final 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.

In situations where the examiner concludes after consideration of all the evidence and argument that the remanded claims should be allowed, the rule dealing with reasons for allowance (37 CFR 1.109) provides an appropriate mechanism for him or her to explain, on the record, his or her reasoning for coming to this conclusion, notwithstanding the grounds set forth by the Board in its statement.

37 CFR 1.196(d) does not affect the Board's authority to remand a case to the examiner without rendering a decision in appropriate circumstances. 37 CFR 1.196(d) is not intended as an instruction to the Board to reexamine 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.

>The period set by the Board for the submission of an amendment or showing to the examiner 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). See 37 CFR 1.196(f).<

1213.03 Publication of Board Decision [R-9]

Decisions of the Board may be published at the discretion of the Commissioner. Requests by members of the public or applicants to publish a decision of the Board should be referred to the Office of the Solicitor. A decision in a pending or abandoned application will be published in accordance with 37 CFR 1.14(d).

1214 Procedure Following Decision by Board [R-9]

37 CFR 1.197. Action following decision.

(a) After decision by the Board of Patent Appeals and Interferences, the case shall be returned to the examiner, subject to the appellant's right of appeal or other review, for such further action by the appellant or by the examiner, as the condition of the case 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 clerk of the Board notes the decision on the file wrapper and in the record of appeals, and then forwards the file to the examiner through the office of the group director immediately if the examiner is reversed, and after about six weeks if the examiner is affirmed or after a decision on a request for reconsideration is rendered.

1214.01 Procedure Following New Ground of Rejection by Board [R-14]

37 CFR 1.196. Decisions by the Board of Patent Appeals and Interferences

* * * * *

(b) Should the Board of Patent Appeals and Interferences have knowledge of any grounds not involved in the appeal for rejecting any appealed claim, it may include in the decision a statement to that effect with its reasons for so holding, which statement shall constitute a new rejection of the claims. A new rejection shall not be considered final for purposes of judicial review. When the Board of Patent Appeals and Interferences makes a new rejection of an appealed claim, the appellant may exercise any one of the following two options with respect to the new ground:

(1) The appellant may submit an appropriate amendment of the claims so rejected or a showing of facts, or both, and have the matter reconsidered by the examiner in which event the application will be remanded to the examiner. The statement shall be binding upon the examiner unless an amendment or showing of facts not previously of

record be made which, in the opinion of the examiner, overcomes the new ground for rejection stated in the decision. Should the examiner again reject the application the applicant may again appeal to the Board of Patent Appeals and Interferences.

(2) The appellant may have the case reconsidered under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. The request for reexamination shall address the new ground for 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 reconsideration is sought. Where request for such reconsideration is made the Board of Patent Appeals and Interferences shall reconsider the new ground for rejection and, if necessary, render a new decision which shall include all grounds upon which a patent is refused. The decision on reconsideration is deemed to incorporate the earlier decision, except for those portions specifically withdrawn on reconsideration, and is final for the purpose of judicial review.

* * * * *

(f) See § 1.136(b) for extensions of time to take action under this section.

Under 37 CFR 1.196(b), the Board may, in its decision on an *ex parte* appeal, make a new rejection of one or more appealed claims, in which case the appellant has the option of

(1) requesting reconsideration, or

(2) submitting an appropriate amendment of the rejected claims, and/or a showing of facts.

(The appellant no longer has the option of treating the rejection as final and immediately appealable.)

(1) REQUEST FOR RECONSIDERATION

A request for reconsideration by the Board must be filed within one month from the date of the decision, the period set by 37 CFR 1.197(b). By proceeding in this manner the appellant waives his or her right to further prosecution before the examiner. *In re Greenfield,* **5 USPQ 474 >(CCPA 1930)<.

However, an appellant's request for reconsideration accompanied by an affidavit containing a showing of facts to be added to the record does not afford reconsideration by the Board as a matter of right under 37 CFR 1.196(b). The Board has authority to remand the application to the examiner and the examiner has authority to consider a new showing of facts following a new rejection by the Board and withdraw the Board's rejection based on the appellant's affidavit and accompanying remarks. In such an instance, the examiner also has authority to make any appropriate new rejection under 37 CFR 1.198 with the group director's approval.

(2) SUBMISSION OF AMENDMENT OR SHOWING OF FACTS

If the appellant elects to proceed before the examiner, he or she must take such action within the period for response set in the Board's decision, which may not exceed six months from the Board's decision. See *In re application filed July 13, 1950* at 693 O.G. 136, 1955 C.D. 3 >(Comm'r Pat. 1955)<. A shortened period for response of two months ordinarily is set in the Board's decision. Fee extension under 37 CFR 1.136(a) is not available to extend the period, 37 CFR 1.196(f). A rejection under 37 CFR 1.196(b) in effect nullifies the final rejection and reopens the prosecution of the subject matter of the claims so rejected by the Board.

The appellant may amend the claims involved, or substitute 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)<. The appellant may also submit a showing of facts under 37 CFR 1.131 or 1.132, as may be appropriate.

Argument without either amendment of the claims so rejected or the submission of a showing of facts can result only in a final rejection of the claims, since the examiner is without authority to allow the claims unless amended or unless the rejection is overcome by a showing of facts not before the Board. The new ground of rejection raised by the Board does not reopen the prosecution except as to that subject matter to which the new rejection was applied.

If the examiner does not consider that the amendment and/or showing of facts overcome the rejection, he or she will again reject the claims; if appropriate, the rejection will be made final.

37 CFR 1.196(b)(1), as amended, adds the following sentence as the penultimate sentence of the section:

> Should the examiner repeat the rejection the applicant may again appeal to the Board of Patent Appeals and Interferences.

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 fact that the application was previously on appeal. 37 CFR 1.196(b) now makes it clear that after such a final rejection, an applicant who desires further review of the matter must file a new appeal to the Board. The language of 37 CFR 1.196(b) is similar to the fourth sentence of 37 CFR 1.196(d). 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 and the payment of another fee.

In accordance with 37 CFR 1.196(f), the time periods for requesting reconsideration of the Board's new rejection under 37 CFR 1.196(b), or for submitting an amendment or showing of facts, 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).

1214.03 **Reconsideration [R-13]

37 CFR 1.197. Action following decision.

* * * * *

(b) A single request for reconsideration or modification of the decision, may be made if filed within one month from the date of the original decision, unless >the original<* decision is so modified >by the decision on reconsideration< as to become, in effect, a new decision, and the Board of Patent Appeals and Interferences so states. >The request for reconsideration shall state with particularity the points believed to have been misapprehended or overlooked in render-

ing the decision and also state all grounds upon which reconsideration is sought. See 37 CFR 1.136(b) for extensions of time for seeking reconsideration.<

* * * * *

>37 CFR 1.197(b) provides that any request for reconsideration must specifically state the points believed to have been misapprehended or overlooked in the Board's decision. Experience has shown that many requests for reconsideration are nothing more than reargument of appellant's position on appeal. The rule now limits requests to the points of law or fact which appellant feels were overlooked or misapprehended by the Board.

The one-month period provided by 37 CFR 1.197(b) for filing a request for reconsideration can only be extended under the provisions of 37 CFR 1.136(b).<

All copies of references in the file wrapper should be retained therein.

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 § 1002.02(n).

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

1214.04 Examiner Reversed [R-14]

A complete reversal of the examiner's rejection brings the case up for immediate action by the examiner.

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 has meanwhile been transferred or assigned to an examiner other than the one who finally rejected the claims. 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 non-patentability of any of the appealed claims as to which the examiner was reversed, he or she should submit the matter to the group director for authorization to reopen prosecution under 37 CFR 1.198 for the purpose of entering the new rejection. Note MPEP § 1002.02(c), item 2, and MPEP § 1214.07. The group director's approval is placed on the action reopening prosecution.

The examiner may request reconsideration of the Board decision. Such a request should normally be made within one month of the receipt of the Board decision in the group. The group director's secretary should therefore date stamp all Board decisions upon receipt in the group.

All requests by the examiner to the Board for reconsideration of a decision, must be approved by the group director and must also be forwarded to the Office of the *Assistant Commissioner for Patents for approval before mailing.

The request should set a period of one month for the appellant to file a reply.

If approved, the Office of the *Assistant Commissioner for Patents will mail a copy of the request for reconsideration 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

Where an appellant withdraws some of the appealed claims, 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 not necessary to notify the appellant of the cancellation of the withdrawn claims.

1214.06 Examiner Sustained in Whole or in Part [R-14]

37 CFR 1.197. Action following decision

* * * * *

(c) *Termination of proceedings.*

Proceedings 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: (1) where claims stand allowed in an application or (2) where the nature of the decision requires further action by the examiner. The date of termination of proceedings is the date on which the appeal is dismissed or the date on which the time for appeal to the court or review by civil action (§ 1.304) expires. If an appeal to the court or a civil action has been filed, proceedings are considered terminated when the appeal or civil action is terminated. An appeal to the U.S. Court of Appeals for the Federal Circuit is terminated when the mandate is received by the Office. A civil action is terminated when the time to appeal the judgment expires.

The time for seeking review of a decision of the Board by the Court of Appeals for the Federal Circuit or the District Court is the same for both tribunals, that is, two months, or two months with the extension provided by 37 CFR 1.304 in the event a request for reconsideration is seasonably filed before the Board, or as extended by the Commissioner. See MPEP § 1216. When the time for seeking court review (plus two 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 case for consideration. The situations which can arise will involve one or more of the following six circumstances:

A. *No claims stand allowed.* The proceedings in the application 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.

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:

1. If 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.

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

a. 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

b. Set a one-month time period 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 response is received, the examiner will cancel all rejected and objected to claims and issue the case with the allowed claims only.

The following language may be used where appropriate:

Claim(s)_____is/are incomplete because the claim(s) on which it/they depend(s) from has/have been cancelled by the examiner in accordance with MPEP 1214.06. Applicant is given a one month time limit from the date of this letter in which to present claim(s) _____ in independent form. No extensions of time under 37 CFR 1.136(a) will be granted. Failure to comply with this deadline will result in cancellation of claim(s) _____ and this application will be:

i. allowed with claim(s) _____ (if other claims are allowed), or

ii. abandoned (if there are no allowed claims).

B. *Claims stand allowed.* The appellant is not required to file a response. The examiner takes the case up and passes it to issue on the claims which stand allowed. 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 with claim 3 only.<

If uncorrected matters of form which cannot be handled without written correspondence remain in the case, the examiner should take appropriate action but prosecution is otherwise closed. Note subsection A of this section for handling of claims dependent on rejected claims. A letter such as set forth in Form Paragraph 12.20 is suggested:

¶ 12.20 Period for seeking court review has lapsed

The period 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 applicant. The proceedings as to the rejected claims are considered terminated; see 37 CFR 1.197(c).

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

Examiner Note:

In bracket 1, enter the date of the decision.

In bracket 2, identify the allowed claims.

(Set a thirty day Shortened Statutory period for response.) **

C. *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 a case containing claims to nonelected species not previously acted upon, the examiner will take the case up for appropriate action on the matters thus brought up, but the case is not considered open to further prosecution except as to such matters.

D. *37 CFR 1.196(b) rejection.* Where the Board makes a new rejection under 37 CFR 1.196(b) and no action is taken with reference thereto by appellant within six months, *or such shortened time period as may be set in the Board's decision*, the examiner should proceed in the manner indicated for situations A, B, or C, depending on which is appropriate to the case. See MPEP § 1214.01.

If the Board affirms the examiner's rejection, but also enters a new ground of rejection under 37 CFR 1.196(b), the subsequent procedure depends upon the action taken by the appellant with respect to the 37 CFR 1.196(b) rejection.

(1) If the appellant elects to request reconsideration of the new rejection, see MPEP § 1214.01, part (1), the request for reconsideration of the new rejection and of the affirmance must be filed within one month from the date of the Board's decision.

(2) If the appellant elects to proceed before the examiner with regard to the new rejection, see MPEP § 1214.01, part (2), the Board's affirmance will be treated as non-final, and no request for reconsideration of the affirmance need be filed at that time. Once prosecution of the claims which were rejected under 37 CFR 1.196(b) is terminated before the examiner, the application file must be returned to the Board so that the appeal can be dismissed, or so that a decision making the original affirmance final can be entered, depending on the circumstances. The time for filing a request for reconsideration 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.

E. *37 CFR 1.196(d) recommendation.* Where the Board makes a recommendation under 37 CFR 1.196(d) and no action is taken with reference thereto by the appellant within the time permitted for court review, ordinarily two months from the date of the decision, the examiner should proceed in the manner indicated for situations A, B, or C, depending on which is appropriate to the case. See MPEP § 1213.01.

F. *Appeal dismissed.* Where the appeal has been dismissed for failure to argue a ground of rejection involving all the appealed claims see MPEP § 1215.04.

The practice under situations A, B, and C is similar to the practice after a decision of the court outlined in MPEP § 1216.01.

In view of the above practice, examiners must be very careful that applications which come back from the Board are not overlooked because every case, except those 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. Consequently, when a file is received after decision by the Board, it must be examined and appropriate precautions taken to indicate the presence of allowed claims, if any. This may be done by writing the notation "Allowed Claims " or "Rejection Reversed " on the "Contents " page of file wrapper immediately below endorsement "Decision by Board ".

See MPEP §* 1216.01 and >§< 1216.02 for procedure where court review is sought.

1214.07 Reopening of Prosecution [R-15]

37 CFR 1.198. Reopening after decision.

Cases which have been decided by the Board of Patent Appeals and Interferences will not be reopened or reconsidered by the primary examiner, except under the provisions of § 1.196, without the written authority of the Commissioner, 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 the prosecution of the case is definitely closed, the appellant clearly is not entitled to have such amendment entered as a matter of right. However, if the amendment obviously places the case in condition for allowance, the primary examiner should endorse on the amendatory paper a recommendation that the amendment be admitted, and with the concurrence of the **>Supervisory Primary Examiner<, the amendment will be entered. Note MPEP § *>1002.02(d)<, item *>9<.

Where the amendment cannot be entered, the examiner should write to the appellant indicating that the amendment cannot be entered and stating the reason why. The refusal should never be made to appear arbitrary or capricious.

Form Paragraph 12.19 should be used:

¶ 12.19 Amendment after Board decision

The amendment filed [1] after a decision of the Board of Patent Appeals and Interferences is refused entry under 37 CFR 1.116(c) because prosecution is closed and the proposed claim(s) raise new issues which require further consideration or search.

Examiner Note:

Identify the new issues.

This paragraph is not to be used in a response to a 37 CFR 1.196(b) rejection.

In the event that claims stand allowed in the case under the conditions set forth in MPEP § 1214.06 (paragraph B), the case should be passed to issue.

Petitions under 37 CFR 1.198 to reopen or reconsider prosecution of a patent application after decision by the Board, where no court action has been filed, are decided by the group director, MPEP § 1002.02(c), item 2.

The Commissioner 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:

1. 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;

2. 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

3. 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.

Any such petition must be accompanied by the proposed amendment, evidence, or argument said to justify allowance of the claims. The petition further must point out how the case falls within one of the preceding categories. Failure to do so or failure of the case to qualify as coming within one of the categories will usually constitute basis for denying the petition. In any event, no case will be reopened unless it is for the consideration of matters not already adjudicated, and sufficient cause has been shown.

Such petitions will not be ordinarily entertained after the filing of the Commissioner'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 Patent and Trademark Office and 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-13]

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

Where, after appeal has been filed and before decision by the Board, an applicant withdraws the appeal after the period for response 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 filing of such letter.

If a brief has been filed within the time permitted by 37 CFR 1.192 (or any extension thereof) and an answer mailed and appellant withdraws the appeal, the case is returned to the examiner.

To avoid the rendering of decisions by the Board** in applications which have already been refiled as continuations, applicants should promptly inform the 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.

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:

1. 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.

2. Claims 1 - 3 are rejected. The examiner should hold the application abandoned.

3. 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.

4. 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.

1215.02 Claims Standing Allowed

If the 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

A withdrawal of the appeal as to some of the claims on appeal operates as a cancellation of those claims from the case and the appeal continues as to the remaining claims. The withdrawn claims will be canceled from an application by direction of the examiner when necessary without further action by the applicant.

1215.04 Dismissal of Appeal [R-9]

If no brief is filed within the time prescribed by 37 CFR 1.192, the appeal stands dismissed by operation of the rule. The letter (form PTOL-333) 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 the application is considered as abandoned on the date the brief was due. ** If claims stand allowed in the 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 (4 months 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:

1. 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.

2. Claims 1 - 3 are rejected. The examiner should hold the application abandoned.

3. 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.

4. 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, setting a shortened period for reply, but the application is to be considered closed to further prosecution except as to such matters. A letter such as the following is suggested:

"In view of applicant's failure to file a brief within the time prescribed by 37 CFR 1.192, the appeal stands dismissed and the proceedings as to the rejected claims are considered terminated; see 37 CFR 1.197(c).

"This application will be passed to issue on claims (*identify*) which stand allowed provided the following formal matter(s) is (are) corrected. Prosecution is otherwise closed."

(Set out formal matter(s) requiring correction.)

(Set a thirty day shortened statutory period for response.)

1216 Judicial Review [R-14]

35 U.S.C. 141. Appeal to 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 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 Commissioner 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 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 Commissioner 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 Commissioner 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 Commissioner 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. 146 Civil action in case of interference.

Any party to an interference dissatisfied with the decision of the Board of Patent Appeals and Interferences, may have remedy by civil action, if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints or as provided in section 141 of this title, unless he has appealed to the United States Court of Appeals for the Federal Circuit, and such appeal is pending or has been decided. In such suits the record in the Patent and Trademark Office shall be admitted on motion of either party upon the terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of the parties to take further testimony. The testimony and exhibits of the record in the Patent and Trademark Office when admitted shall have the same effect as if originally taken and produced in the suit.

Such suit may be instituted against the party in interest as shown by the records of the Patent and Trademark Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs. The Commissioner shall not be a necessary party but he shall be notified of the filing of the suit by the clerk of the court in which it is filed and shall have the right to intervene. Judgment of the court in favor of the right of an applicant to a patent shall authorize the Commissioner to issue such patent on the filing in the Patent and Trademark Office of a certified copy of the judgment and on compliance with the requirements of law.

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 a reexamination proceeding 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: (a) In the Patent and Trademark Office file a written notice of appeal directed to the Commissioner (see §§ 1.302 and 1.304); and (b) 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.

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 a reexamination proceeding dissatisfied with the decision of the Board of Patent Appeals and Interferences, and any party 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 a reexamination proceeding 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) If any adverse party to an appeal taken to the U.S. Court of Appeals for the Federal Circuit by a defeated party in an interference proceeding files notice with the Commissioner within twenty days after the filing of the defeated party's notice of appeal to the court (§ 1.302), that he or she elects to have all further proceedings conducted as provided in 35 U.S.C. 146, the notice of election must be served as provided in § 1.646.

37 CFR 1.304. Time for appeal or civil action.

(a) 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 reconsideration or modification of the decision is filed within the time provided under § 1.197(b) or § 1.658(b), the time for filing an appeal or commencing a civil action shall expire two months after action on the request. In interferences, the time for filing a cross-appeal or cross-action expires (1) 14 days after service of the notice of appeal or the summons and complaint or (2) two months after the date of decision of the Board of Patent Appeals and Interferences, whichever is later. The time periods set forth in this section are not subject to the provisions of §§ 1.136, 1.550(c) or § 1.645(a) or (b). The Commissioner may extend the time for filing an appeal or commencing a civil action (3) for good cause shown if requested in writing before the expiration of the period for filing an appeal or commencing a civil action, or (4) 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. The certificate of mailing procedure of § 1.8 is not available for filing a notice of appeal or cross-appeal, See § 1.8(a)(2)(ix).

(b) The times specified in this section in days are calendar days. The times 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. The certificate of mailing practice of § 1.8 is not available for filing a notice of appeal or cross-appeal. See § 1.8(a)(2)(vii).

EX PARTE AND REEXAMINATION PROCEEDINGS

The applicant in an *ex parte* proceeding or the owner of a patent involved in a reexamination proceeding 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, 306; 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, 306; 37 CFR 1.303(a)). By filing an appeal to the Federal Circuit, the applicant in an *ex parte* case or the owner of a patent involved in a reexamination proceeding waives the right to seek

judicial review by a civil action under 35 U.S.C.145. 37 CFR 1.303(b).

INTERFERENCE PROCEEDINGS

Any party to an interference who is dissatisfied with a decision of the Board may seek judicial review either by an appeal to the Federal Circuit (35 U.S.C.141; 37 CFR 1.301) or, if no 35 U.S.C. 141 appeal is pending or has been decided, by a civil action in an appropriate district court (35 U.S.C. 146; 37 CFR 1.303(a)). Furthermore, a 35 U.S.C. 141 appeal to the Federal Circuit by a dissatisfied party in an interference will be dismissed if any adverse party in the interference, within twenty (20) days after the appellant has filed a notice of appeal according to 35 U.S.C. 142, files notice with the Commissioner that such adverse party elects to have all further proceedings conducted in accordance with 35 U.S.C.146. 35 U.S.C. 141; 37 CFR 1.303(c). If, within thirty (30) days after filing of such notice of election by an adverse party, the appellant does not file a civil action under 35 U.S.C.146, the decision appealed from shall govern the further proceedings in the case. 35 U.S.C. 141. Copies of such notice of election, which must be served as provided in 37 CFR 1.646, will be transmitted by the Solicitor to the Federal Circuit for such action as may be necessary. 37 CFR 1.303(c).

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 or 146 is within two months of the Board's decision. 37 CFR 1.304(a). However, if a request for reconsideration or modification of the Board's decision is filed within the time provided under 37 CFR 1.197(b) (*ex parte* appeals) or 37 CFR 1.658(b) (*inter partes* appeals), the time for filing a notice of appeal to the Federal Circuit or for commencing a civil action expires two months after a decision on a request for reconsideration or modification. 37 CFR 1.304(a).

These two-month periods meet the sixty-day requirement of 35 U.S.C. 142, 145 and 146 except for time periods which include February 28. In order to comply with the sixty-day requirement, 37 CFR 1.304(b) provides that an additional day shall be added to any two-month period for initiating review which includes February 28. Appeals will always be timely if the judicial review is initiated within two 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).

TIME FOR FILING CROSS-APPEAL OR CROSS-ACTION

** 37 CFR 1.304(a) *specifies that the time for filing a cross-appeal or commencing a cross-action expires (1) fourteen days after service of the notice of appeal or the summons and complaint or (2) two months after the decision to be reviewed, whichever is later.

**37 CFR 1.304(a) *>also< 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 Patent and Trademark Office.

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 Commissioner may extend the time (1) for good cause if requested before the expiration of the time provided for initiating judicial review or (2) 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, i.e., either the decision (in circumstances where no timely reconsideration is sought) or the decision on reconsideration, of the Board in an ex parte appeal or interference has been entered. 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 reconsideration has been entered. 37 CFR 1.304(a) 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:

Box 8, Attention The Solicitor
Commissioner of Patents and Trademarks
Washington, D.C. 20231

Requests may also be hand carried to the Office of the Solicitor.

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 Patent and Trademark 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 Patent and Trademark Office by the court. Any amendment, such as one copying claims from a patent for interference purposes, can be admitted only under the provisions of 37 CFR 1.198. See MPEP § 1214.07.

SERVICE OF COURT PAPERS ON THE COMMISSIONER

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 himself is ordered by the court. Service upon the attorney . . . shall be made by delivering a copy to him or by mailing it to him at his last known address . . . .

Similarly, Rule 25(b) of the Federal Rules of Appellate Procedure provides that "[s]ervice on a party represented by counsel shall be made on counsel."

Accordingly, all service copies of papers filed in court proceedings in which the Commissioner of Patents and Trademarks 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:

1. By hand between 8:30 A.M. and 5:00 P.M. at the Office of the Solicitor.

2. By mail in an envelope addressed as follows:
   Office of the Solicitor
   P.O. Box 15667
   Arlington, VA 22215

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 Commissioner of Patents and Trademarks 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 Patent and Trademark Office are deemed to have been served on the Commissioner 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 non-court papers, i.e., papers which are intended to be filed in the Patent and Trademark Office in connection with an application or other proceeding pending in the Patent and Trademark Office. ANY NON-COURT 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-14]

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 Commissioner, within such time after the date of the decision from which the appeal is taken as the Commissioner prescribes, but in no case less than sixty 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 Commissioner shall transmit to the United States Court of Appeals for the Federal Circuit a certified list of documents comprising the record in the Patent and Trademark Office. The court may request that the Commissioner forward the original or certified copies of such documents during pendency of the appeal. In an ex parte case, the Commissioner 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 Commissioner 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 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.

(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 Commissioner within the time specified in § 1.304.

(b) In interferences, the notice must be served as provided in § 1.646.

(c) A notice of appeal, if mailed to the Office, shall be addressed as follows: Box 8, Commissioner of Patents and Trademarks, Washington, DC 20231.

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, (1) file in the Patent and Trademark Office a written notice of appeal (35 U.S.C. 142) directed to the Commissioner and (2) 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 Patent and Trademark Office, it must (1) actually reach the Patent and Trademark Office within the time specified in 37 CFR 1.304 (including any extensions) or (2) 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 certificate of mailing under 37 CFR 1.8 cannot be used for the purpose of effecting "filing" of a notice of an appeal to the Federal Circuit. *In re Thrifty >Corp.<*, 231 USPQ 560 (*>Comm'r< Pat. 1986), *mandamus denied mem.*, Misc. No. 137 (Fed. Cir. Nov. 21, 1986) (unpublished). Thus, a notice of appeal mailed to the Patent and Trademark Office prior to the due date with a certificate of mailing under 37 CFR 1.8 will not be considered timely unless it reaches the Patent and Trademark Office by the due date.

A Notice of Appeal to the Federal Circuit should not be mailed to the Commissioner, 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 Patent and Trademark Office in any one of the following ways:

1. By mail addressed as follows, in which case the notice of appeal must actually reach the Patent and Trademark Office by the due date:

Box 8
Commissioner of Patents and Trademarks
Washington, D.C. 20231
Attention: Office of the Solicitor

2. 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 of the Express Mail certificate:

Box 8
Commissioner of Patents and Trademarks
Washington, D.C. 20231
Attention: Office of the Solicitor

3. By hand to the Office of the Solicitor.

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, D.C. 20439

The Solicitor, prior to a decision by the Federal Circuit, may request that the case be remanded to the Patent and Trademark Office and prosecution reopened. See MPEP § 1214.07.

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 Patent and Trademark Office and to the appellant and appellee (if any).

In due course, the Clerk of the Federal Circuit forwards to the 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 of receipt of the mandate by the Patent and Trademark Office 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(c), 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 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 entered in the application or reexamination file, the file is then returned to the appropriate Patent and Trademark Office official for further proceedings consistent with the mandate. See MPEP § 1214.06 for handling of claims dependent on rejected claims.

1. All claims rejected.

If all claims in the case stand rejected, proceedings in the case are considered terminated on the date of receipt 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 Patent and Trademark Office is to be taken in accordance with the Federal Circuit's opinion.

2. 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 or by an appropriate notation in the margin of the claims, to avoid confusion of the printer. 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.

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 30 day shortened period for reply. However, the application or reexamination proceeding is considered closed to further prosecution except as to such matters.

3. 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 a case containing claims to non-elected species, the examiner will take the case up for appropriate action on the matters thus brought up, but the case is not considered open to further prosecution except as to such matters.

4. 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< Assistant Commissioner for Patents for written approval, which will be indicated on the Office action.

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 Commissioner.

The court proceedings are considered terminated as of the date of dismissal. 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-13]

A 35 U.S.C. 145 civil action is commenced by filing a complaint in the U.S. District Court for the District 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 Rules 4(d)(4) and 4(d)((5) of the Federal Rules of Civil Procedure. Regarding timely service, see *Walsdorf v. Commissioner*, 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.

In an action under 35 U.S.C. 145, the plaintiff may introduce evidence not previously presented to the Patent and Trademark Office. But 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 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 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(c) 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 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, Constitution and John Marshall Place, Washington, D.C. 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.