Chapter 1200 Appeal

1201 Introduction

The United States Patent and Trademark Office (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 the merits, and appeal procedure within the 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 2 months from the action complained of may be dismissed as untimely and since 37 CFR 1.144 states that petitions from restriction requirements must be filed no later than appeal, petitionable matters will rarely be present in a case by the time it is before the Board for a decision. *In re Watkinson*, 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990).

1203 Composition of Board

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

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

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

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

If subsequent to the hearing, but prior to the decision, an administrative patent judge who heard the appeal becomes unable to participate in the decision or any subsequent action for some reason, the Chief Administrative Patent Judge of the Board, at his or her

discretion, may without a rehearing substitute a different Board member for the one who is unavailable, or may offer the appellant the opportunity for a rehearing. See *In re Bose Corp.*, 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 Chief Administrative Patent Judge as a substitute for the absent member.

1204 Administrative Handling

Ex parte appeals to the Board, and all papers relating thereto, are forwarded to the Technology Center (TC) 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 TC.

To ensure 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 TC 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 applicant will be notified 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 United States Patent and Trademark Office (Office) for examination will continue to be special throughout its entire course of prosecution in the Office, including appeal, if any, to the Board. See MPEP § 708.02.

A petition to make an application special after the appeal has been forwarded to the Board may be addressed to the Board. However, no such petition will be granted unless the brief has been filed and applicant has made the same type of showing required by the 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

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

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

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

(c) THIRD-PARTY.— A third-party requester in an inter partes proceeding may appeal to the Board of Patent Appeals and Interferences from the final decision of the administrative patent judge favorable to the patentability of any original or proposed amended or new claim of a patent, having once paid the fee for such appeal. The third-party requester may not appeal the decision of the Board of Patent Appeals and Interferences.

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

(a) The Director shall charge the following fees:

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(6)(A)On filing an appeal from the examiner to the Board of Patent Appeals and Interferences, $300.

(B) In addition, on filing a brief in support of the appeal, $300, and on requesting an oral hearing in the appeal before the Board of Patent Appeals and Interferences, $260.

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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, and every owner of a patent under *ex parte* reexamination filed under § 1.510 for a patent that issued from an original application filed in the United States before November 29, 1999, any of whose claims has been twice or finally (§ 1.113) rejected, may appeal from the decision of the examiner to the Board of Patent Appeals and Interferences by filing a notice of appeal and the fee set forth in § 1.17(b) within the time period provided under §§ 1.134 and 1.136 for reply. Notwithstanding the above, for an *ex parte* reexamination proceeding filed under § 1.510 for a patent that issued from an original application filed in the United States on or after November 29, 1999, no appeal may be filed until the claims have been finally rejected (§ 1.113). Appeals to the Board of Patent Appeals and Interferences in *inter partes* reexamination proceedings filed under § 1.913 are controlled by §§ 1.959 through 1.981. Sections 1.191 through 1.198 are not applicable to appeals in *inter partes* reexamination proceedings filed under § 1.913.

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

(c) An appeal when taken must be taken from the rejection of all claims under rejection which the applicant or 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 and 1.192 are subject to the provisions of § 1.136 for patent applications and § 1.550(c) for reexamination proceedings. The time periods set forth in §§ 1.193, 1.194, 1.196 and 1.197 are subject to the provisions of § 1.136(b) 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.

APPEAL BY PATENT APPLICANT

Under 37 CFR 1.191(a), an applicant for a patent 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 and the required fee set forth in 37 CFR 1.17(b) within the time period provided under 37 CFR 1.134 and 1.136. A notice of appeal may be filed after any of the claims has been twice rejected, regardless of whether the claim(s) has/have been finally rejected. The limitation of "twice or finally...rejected" does not have to be related to a particular application. For example, if any claim was rejected in a parent application, and the claim is again rejected in a continuing application, then applicant will be entitled to file an appeal in the continuing application, even if the claim was rejected only once in the continuing application.

Although the rules no longer require that the notice of appeal identify the rejected claim(s) appealed, or be signed, applicants should continue to file notices of appeal which identify the appealed claims and are signed. The requirement was eliminated from 37 CFR 1.191 as being redundant of the requirements of 37 CFR 1.192 and to avoid the delay and expense to both applicant and the United States Patent and Trademark Office (Office) which is involved in treating a defective notice of appeal. It should be noted that the elimination of the requirement to sign a notice of appeal does not affect the requirements for other papers (such as an amendment under 37 CFR 1.116) submitted with the notice, or for other actions contained within the notice, e.g., an authorization to charge fees to a deposit account or to a credit card. See MPEP § 509. Thus, failure to sign the notice of appeal may have unintended adverse consequences; for example, if an unsigned notice of appeal contains an (unsigned) authorization to charge the appeal fee to a deposit account, the notice of appeal will be unacceptable because the appeal fee is lacking.

The notice of appeal must be filed within the period for reply set in the last Office action, which is normally 3 months for applications. See MPEP § 714.13. Failure to remove all grounds of rejection and otherwise place an application in condition for allowance or to file an appeal after final rejection will result in the application becoming abandoned, even if one or more claims have been allowed, except where claims suggested for interference have been copied. The notice of appeal and appropriate fee may be filed up to 6 months from the date of the 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.

APPEAL BY PATENT OWNER

37 CFR 1.191 provides for appeal to the Board by the patent owner from any decision in an *ex parte* reexamination proceeding adverse to patentability, in accordance with 35 U.S.C. 306 and 35 U.S.C. 134. See also MPEP § 2273.

In an *ex parte* reexamination of a patent that issued from an original application filed before November 29, 1999, the patent owner may appeal to the Board either (A) after final rejection of the claims, or (B) after the second rejection of the claims. This is based on the version of 35 U.S.C. 134 in existence prior to the amendment of the reexamination statute on November 29, 1999 by Public Law 106-113.

In an *ex parte* reexamination of a patent that issued from an original application filed on or after November 29, 1999, the patent owner may appeal to the Board only after the final rejection of one or more claims in the particular reexamination proceeding for which appeal is sought. See the current version of 35 U.S.C. 134.

The fee for filing the notice of appeal by a patent owner is set forth in 37 CFR 1.17(b), and the time period to pay the fee is determined as provided in 37 CFR 1.134 and 37 CFR 1.136.

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

Appeals to the Board of Patent Appeals and Interferences in *inter partes* reexamination proceedings filed under 35 U.S.C. 311 are governed by 37 CFR 1.959 through 1.981. 37 CFR 1.191 through 1.198 are not applicable to appeals in *inter partes* reexamination proceedings.

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

PTO/SB/31 (02-01)
Approved for use through 10/31/2002. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

NOTICE OF APPEAL FROM THE EXAMINER TO THE BOARD OF PATENT APPEALS AND INTERFERENCES	Docket Number (Optional)

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Assistant Commissioner for Patents, Washington D.C. 20231" on_____. Signature_____. Typed or printed name_____.	In re Application of	
	Application Number	Filed
	For	
	Group Art Unit	Examiner

Applicant hereby **appeals** to the Board of Patent Appeals and Interferences from the last decision of the examiner.

The fee for this Notice of Appeal is (37 CFR 1.17(b)) $_____.

☐ Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by half, and the resulting fee is: $_____.

☐ A check in the amount of the fee is enclosed.

☐ Payment by credit card. Form PTO-2038 is attached.

☐ The Commissioner has already been authorized to charge fees in this application to a Deposit Account. I have enclosed a duplicate copy of this sheet.

☐ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No._____. I have enclosed a duplicate copy of this sheet.

☐ A petition for an extension of time under 37 CFR 1.136(a) (PTO/SB/22) is enclosed.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☐ attorney or agent of record.

☐ attorney or agent acting under 37 CFR 1.34(a). Registration number if acting under 37 CFR 1.34(a)._____.

_____
Signature

_____
Typed or printed name

_____
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____forms are submitted.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

MATTERS HANDLED CONCURRENTLY WITH APPEAL

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

Form paragraphs 12.01-12.04 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(b) was not filed, or was not timely filed.

Applicant may obtain an extension of time under 37 CFR 1.136(a) to file the appropriate appeal 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 reply and also the date for determining the period of extension and the corresponding amount of the fee. In no case may an applicant reply later than the maximum SIX MONTH statutory period or obtain an extension pursuant to 37 CFR 1.136(a) for more than FIVE MONTHS beyond the date of reply set in an Office action.

¶ 12.02 Notice of Appeal Unacceptable - No 2nd Rejection

The notice of appeal filed on **[1]** is not acceptable under 37 CFR 1.191(a) because **[2]**.

Examiner Note:

In bracket 2, insert the following wording, as appropriate:

--there has been no second or final rejection in this patent application--;

--there has been no second or final rejection in this *ex parte* reexamination proceeding on a patent that issued from an original application filed in the United States before November 29, 1999--; or

--there has been no final rejection (37 CFR 1.113) of the claims in this *ex parte* reexamination proceeding on a patent that issued from an original application filed in the United States on or after November 29, 1999--.

¶ 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 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 under 37 CFR 1.17(a) are filed will be the date of the reply and also the date for determining the period of extension and the corresponding amount of the fee. In no case may an applicant reply later than the maximum SIX MONTH statutory period orobtain an extension pursuant to 37 CFR 1.136(a) for more than FIVE MONTHS beyond the date of reply 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 notice of allowability was mailed by the Office on **[2]**.

1206 Appeal Brief

37 CFR 1.192. Appellant's brief.

(a) Appellant must, within two months from the date of the notice of appeal under § 1.191 or within the time allowed for reply to the action from which the appeal was taken, if such time is later, file a brief in triplicate. The brief must be accompanied by the fee set forth in § 1.17(c) and must set forth the authorities and arguments on which appellant will rely to maintain the appeal. Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.

(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 indicated below unless the brief is filed by an applicant who is not represented by a registered practitioner:

(1) *Real party in interest.* A statement identifying the real party in interest, if the party named in the caption of the brief is not the real party in interest.

(2) *Related appeals and interferences.* A statement identifying by number and filing date all other appeals or interferences known to appellant, the appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

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

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

(5) *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.

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

(7) *Grouping of claims.* For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

(8) *Argument.* The contentions of appellant with respect to each of the issues presented for review in paragraph (c)(6) 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)(8)(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.

(9) *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, 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 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 stand dismissed.

Where the brief is not filed, but within the period allowed for filing the brief an amendment is presented which places the application 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 brief. 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 2 months from the date of the notice of appeal for the appellant to file an appeal brief. In an *ex parte* reexamination proceeding, the time period can be extended only under the provisions of 37 CFR 1.550(c). See also MPEP § 2274.

The usual period of time in which appellant must file his or her brief is 2 months from the date of appeal. The Office date of receipt of the notice of appeal (and not the date indicated on any Certificate of Mailing under 37 CFR 1.8) is the date from which this 2 month time period is measured. See MPEP § 512. However, 37 CFR 1.192(a) alternatively permits the brief to be filed "within the time allowed for reply to the action from which the appeal was taken, if such time is later." These time periods may be extended under 37 CFR 1.136(a), and if 37 CFR 1.136(a) is not available, under 37 CFR 1.136(b) for extraordinary circumstances.

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

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 administrative patent judge 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, (A) set a 2-month period for filing the brief, or (B) 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 § 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 1.663.

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 2 months, from the mailing date of the Commissioner's affirmative decision on the petition, in which to file the appeal brief. The time period for filing the appeal brief may be extended under 37 CFR 1.136.

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

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

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

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

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

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

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

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. 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 in error, filing a petition, pointing out the error, may be sufficient.

A fee under 37 CFR 1.17(c) 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 Technology Center (TC) to which the application or patent under reexamination is assigned and the application or reexamination control number. When the brief is received, it is forwarded to the TC where it is entered in the file, and referred to the examiner.

An appellant's brief must be responsive to every ground of rejection stated by the examiner.

Where an appeal brief fails to address any ground of rejection, appellant shall be notified by the examiner that he or she must correct the defect by filing a brief (in triplicate) in compliance with 37 CFR 1.192(c). See 37 CFR 1.192(d). Form paragraphs 12.76-12.76.06 and 12.78, or form PTOL-462, "Notification of Non-Compliance with 37 CFR 1.192(c)," may be used to notify the appellant of the deficiency. 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 paper entitled as a brief will not necessarily be considered to be in compliance with 37 CFR 1.192(c). 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) requires that the brief contain specific items, as discussed below.

An exception to the requirement that all the items specified in 37 CFR 1.192(c) be included in the brief is made if the application or reexamination proceeding is being prosecuted by the appellant *pro se*, i.e., there is no attorney or agent of record, and the brief was neither prepared nor signed by a registered attorney or agent. The brief of a *pro se* appellant which does not contain all of the items, (1) to (9), specified in 37 CFR 1.192(c) will be accepted as long as it substantially complies with the requirements of items (1), (2), and (8). If the brief of a *pro se* appellant is accepted, it will be presumed that all the claims of a rejected group of claims stand or fall together unless an argument is included in the brief that presents reasons as to why the appellant considers one or more of the claims in the rejected group to be separately patentable from the other claims in the group.

A distinction must be made between the lack of any argument and the presentation of arguments which carry no conviction. In the former case, notification of a defective appeal brief is in order, while in the latter case, the application or reexamination is forwarded to the Board for a decision on the merits. As noted above, the examiner may use form paragraphs 12.76-12.76.06 and 12.78, or form PTOL-462, "Notification of Non-Compliance with 37 CFR 1.192(c)," to notify appellant that the appeal brief is defective.

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

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

(1) *Real party in interest.* A statement identifying the real party in interest, if the party named in the caption of the brief is not the real party in interest. If appellant does not name a real party in interest, the examiner will assume that the party named in the caption of the brief is the real party in interest, i.e., the owner at the time the brief is being filed.

The identification of the real party in interest will allow members of the Board to comply with ethics regulations associated with working in matters in which the member has a financial interest to avoid any potential conflict of interest. While the examiner will assume that the real party in interest is the individual or individuals identified in the caption when the real party in interest is not explicitly set out in the brief, nevertheless, the Board may require the appellant to explicitly name the real party in interest. See MPEP § 1210.01.

(2) *Related appeals and interferences.* A statement identifying by application number and filing date all other appeals or interferences known to appellant, the appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. The appeal or interference number should also be listed. The statement is not limited to copending applications. If appellant does not identify any other appeals or interferences, the examiner will presume that there are none. While the examiner will assume that there are no related cases when no related case is explicitly set out in the brief, nevertheless, the Board may require the appellant to explicitly identify any related case. See MPEP § 1210.01.

(3) *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.

(4) *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 (3) and (4) 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 (3) and (4) 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.

(5) *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 number 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.

(6) *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)(6). 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 nonenabling disclosure." The statement would be limited to the issues presented, and should not include any argument concerning the merits of those issues.

(7) *Grouping of Claims.* For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone, unless a statement is included that the claims of the group do not stand or fall together and, in the argument section of the brief (37 CFR 1.192(c)(8)), appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable. 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)(7) 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)(8) the reasons why they are considered separately patentable.

The absence of such a statement and argument is 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)(7) is consistent with the practice of the Court of Appeals for the Federal Circuit indicated in such cases as *In re Young*, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991); *In re Nielson*, 816 F.2d 1567, 2 USPQ2d 1525 (Fed. Cir. 1987); *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); and *In re Sernaker*, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983). 37 CFR 1.192(c)(7) 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) (8) (iii)).

In the absence of a separate statement that the claims do not stand or fall together, the Board panel assigned to the case will normally select the broadest claim in a group and will consider only that claim, even though the group may contain two broad claims, such as "ABCDE" and "ABCDF." The same would be true in a case where there are both broad method and apparatus claims on appeal in the same group. The rationale behind the rule, as amended, is to make the appeal process as efficient as possible. Thus, while the Board will consider each separately argued claim, the work of the Board can be done in a more efficient manner by selecting a single claim from a group of claims when the appellant does not meet the requirements of 37 CFR 1.192(c)(7).

It should be noted that 37 CFR 1.192(c)(7) requires the appellant to perform two affirmative acts in his or her brief in order to have the separate patentability of a plurality of claims subject to the same rejection considered. The appellant must (A) state that the claims do not stand or fall together and (B) present arguments why the claims subject to the same rejec-

tion are separately patentable. Where the appellant does neither, the claims will be treated as standing or falling together. Where, however, the appellant (A) omits the statement required by 37 CFR 1.192(c)(7) yet presents arguments in the argument section of the brief, or (B) includes the statement required by 37 CFR 1.192(c)(7) 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 noncompliance as per 37 CFR 1.192(d). *Ex parte Schier*, 21 USPQ2d 1016 (Bd. Pat. App. & Int. 1991); *Ex parte Ohsumi*, 21 USPQ2d 1020 (Bd. Pat. App. & Int. 1991).

(8) *Argument.* The appellant's contentions with respect to each of the issues presented for review in 37 CFR 1.192(c) (6), 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 ensure that the appellant's argument concerning each appealed ground of rejection will include a discussion of the questions relevant to that ground. 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 U. S. 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, on the ground that the claims are directed to nonstatutory subject matter, as in *Ex parte Hibberd*, 227 USPQ 443 (Bd. Pat. App. & Inter. 1985).

37 CFR 1.192(a) contains the following sentence:

> Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.

This sentence emphasizes that all arguments and authorities which an appellant wishes the Board to consider should be included in the brief. 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(a) is not intended to preclude the filing of a supplemental paper if new authority should become available or relevant after the brief was filed. An example of such circumstances would be where a pertinent decision of a court or other tribunal was not published until after the brief was filed.

(9) *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)(9) should be a clean copy and should not include any markings such as brackets or underlining. See MPEP § 1454 for the presentation of the copy of the claims in a reissue application.

The copy of the claims 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 (9) in the order set forth (with the appendix, item (9), at the end).

REVIEW OF BRIEF BY EXAMINER

The question of whether a brief complies with the rule is a matter within the jurisdiction of the 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 noncompliance. Appellant will be given the long-

est of any of the following time periods to correct the defect(s):

(A) 1 month or 30 days from the mailing of the notification of non-compliance, whichever is longer;

(B) within the time period for reply to the action from which appeal has been taken; or

(C) within 2 months from the date of the notice of appeal under 37 CFR 1.191.

Extensions of time may be granted under 37 CFR 1.136(a) or 1.136(b). The examiner may use the form paragraphs set forth below or form PTOL-462, "Notification of Non-Compliance with 37 CFR 1.192(c)," to notify appellant that the appeal brief is defective. 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 noncompliance of which the appellant was notified.

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 noncompliance, a petition under 37 CFR 1.181 may be filed.

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 an unusual hardship on the appellant.

For a reply brief, see MPEP § 1208.03.

Form paragraphs 12.08-12.13, 12.16, 12.17, and 12.69-12.78, or Form PTOL-462, "Notification of Non-Compliance with 37 CFR 1.192(c)," may be used concerning the appeal brief.

¶ 12.08 Appeal Dismissed - Brief 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(c) was not submitted or timely submitted and the period for obtaining an extension of time to file the brief under 37 CFR 1.136(a) 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 - Brief Fee Unpaid, Allowed Claims

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

¶ 12.09.01 Appeal Dismissed - Allowed Claims, Formal Matters Remaining

In view of applicant's failure to file a brief within the time prescribed by 37 CFR 1.192(a), 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 **[1]** provided the following formal matters are corrected. Prosecution is otherwise closed.

[2]

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

Examiner Note:

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

¶ 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 form 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 form 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. 37 CFR 1.33. A ratification properly signed is required.

To avoid dismissal of the appeal, appellant must ratify the appeal brief within the longest of any of the following TIME PERIODS: (1) ONE MONTH or THIRTY DAYS from the mailing of this communication, whichever is longer; (2) within the time period for reply to the action from which appeal has been taken; or (3) within two months from the date of the notice of appeal under 37 CFR 1.191. Extensions of these time periods may be granted under 37 CFR 1.136.

¶ 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.

To avoid dismissal of the appeal, appellant must submit the necessary additional copies of the appeal brief within the longest of any of the following TIME PERIODS: (1) ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing of this communication; (2) within the time period for reply to the action from which appeal has been taken; or, (3) within two months from the date of the notice of appeal under 37 CFR 1.191. Extensions of these time periods may be granted under 37 CFR 1.136.

¶ 12.16 Brief Unacceptable - Fee Unpaid

The appeal brief filed on **[1]** is unacceptable because the fee required under 37 CFR 1.17(c) was not timely filed.

This application will become abandoned unless appellant obtains an extension of time under 37 CFR 1.136(a) and files the required appeal brief fee. The date on which the brief, the fee for filing the brief, the petition under 37 CFR 1.136(a), and the petition fee under 37 CFR 1.17(a) are filed will be the date of the reply and also the date for determining the period of extension and the corresponding amount of the fee. In no case may an appellant obtain an extension for more than FIVE MONTHS under 37 CFR 1.136(a) beyond the TWO MONTH period for filing the appeal 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 reply.

This application will become abandoned unless appellant obtains an extension of time under 37 CFR 1.136(a). The date on which the appeal brief, the fee for filing the brief, the petition under 37 CFR 1.136(a), and the petition fee under 37 CFR 1.17(a) are filed will be the date of the reply and also the date for determining the period of extension and the corresponding amount of the fee. In no case may an appellant obtain an extension for more than FIVE MONTHS under 37 CFR 1.136(a) beyond the TWO MONTH period for filing the appeal brief.

Form paragraph 12.69, followed by one or more of from paragraphs 12.69.01-12.78 may be used for noting noncompliance 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 12.69.01 to 12.77 and conclude with form paragraph 12.78.

¶ 12.69.01 Statement in Brief That Claims Do Not Stand or Fall Together - Supporting Reasons Lacking

The brief includes a statement that claims **[1]** do not stand or fall together, but fails to present reasons in support thereof as required under 37 CFR 1.192(c)(7). MPEP § 1206.

Examiner Note:

1. This form 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 12.55.02 instead of this form paragraph. Reasons for disagreement are discussed in either the "Grounds of Rejection" or in the "Response to Argument" portion of the Examiner's Answer.
2. If the brief contains neither a statement that claims do not stand or fall together nor reasons in support thereof, use form paragraph 12.55.01 in the Examiner's Answer.

¶ 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.

¶ 12.70.01 Defect in Statement of Real Party in Interest

The brief does not contain a heading identifying the real party in interest as required by 37 CFR 1.192(c)(1).

¶ 12.70.02 Defect in Statement of Related Appeals and Interferences

The brief does not contain a heading identifying the related appeals and interferences directly affected by or having a bearing on the decision in the pending appeal as required by 37 CFR 1.192(c)(2).

¶ 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 canceled, and identify the claims appealed as required by 37 CFR 1.192(c)(3). **[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)(4). **[1]**

Examiner Note:

In bracket 1, insert an identification of the amendment for 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)(5). **[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)(6). **[1]**

Examiner Note:

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

¶ 12.76 Defect 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)(6), 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)(8).

Examiner Note:

Include one or more of form paragraphs 12.76.01 to 12.76.06 which apply.

¶ 12.76.01 Separate Heading for Each Issue

Each issue should be treated under a separate heading.

¶ 12.76.02 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, as 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--, or

(c)--set forth the best mode contemplated by the inventor of carrying out his/her invention--.

¶ 12.76.03 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.

¶ 12.76.04 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.

¶ 12.76.05 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 upon 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 be properly combined with features disclosed in another reference. A general argument that all thelimitations are not described in a single reference does not satisfy the requirements of 37 CFR 1.192(c)(8)(iv).

Examiner Note:

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

¶ 12.76.06 For Any Rejection Other Than Those Referred to in Paragraphs (c)(8)(i) to (iv) of 37 CFR 1.192 for Which No Argument or 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 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 provisions of 37 CFR 1.192(c). To avoid dismissal of the appeal, Appellant must comply with the provisions of 37 CFR 1.192(c) within the longest of any of the following TIME PERIODS: (1) ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing of this communication; (2) within the time period for reply to the action from which

appeal has been taken; or (3) within two months from the date of the notice of appeal under 37 CFR 1.191. Extensions of these time periods may be granted under 37 CFR 1.136.

Examiner Note:

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

1207 Amendment Filed With or After Appeal

To expedite the resolution of cases under final rejection, an amendment filed at any time after final rejection, but before jurisdiction has passed to the Board (see MPEP § 1210), may be entered upon or after filing of an appeal brief provided that the amendment conforms to the requirements of 37 CFR 1.116. For example, 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. A new amendment, new affidavit, or other new evidence must be submitted in a paper separate from the appeal brief. Entry of a new amendment, new affidavit, or other new evidence in an application on appeal is not a matter of right. The entry of an amendment (which may or may not include a new affidavit, declaration, or exhibit) submitted in an application on appeal continues to be governed by 37 CFR 1.116, and the entry of a new affidavit or other new evidence in an application on appeal is governed by 37 CFR 1.195. Examiners must respond to all nonentered 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. If the examiner indicates (in the advisory action) that a proposed amendment of the claim(s) would be entered for purposes of appeal, it is imperative for the examiner to also state (in the same advisory action) how the individual rejection(s) set forth in the final Office action will be used to reject the added or amended claim(s) in the examiner's answer. See 37 CFR 1.193(a)(2) and MPEP § 1208.01. 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 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 form PTOL-37 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 appellant. Even if the appeal brief withdraws from consideration any claims or issues (i.e., appellant acquiesces to any rejection), the examiner must continue to make the rejection in the examiner's answer, unless an amendment obviating the rejection has been previously proposed and entered.

A timely filed brief will be referred to the examiner for consideration of its propriety as to the appeal issues and for preparation of an examiner's answer if the brief is proper and the application is not allowable. The examiner's answer may withdraw the rejection of claims, if appropriate. The examiner may also determine that it is necessary to reopen prosecution to enter a new ground of rejection. Note MPEP § 1208.02. No new ground of rejection, however, is permitted in an examiner's answer. 37 CFR 1.193(a)(2). See MPEP § 714.13 for procedure on handling amendments filed after final action and before appeal.

An amendment received after jurisdiction has passed to the Board should not be considered by the examiner unless remanded by the Board for such purpose. See MPEP § 1210 and § 1211.01.

Note that 37 CFR 1.192(c)(4) requires a statement as to the status of any amendment filed subsequent to the final rejection. See also MPEP § 1206.

1208 Examiner's Answer

37 CFR 1.193. Examiner's answer and reply brief.

(a)(1)The primary examiner may, within such time as may be directed by the Commissioner, furnish a written statement in answer to 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 appellant. If the primary examiner finds that the appeal is not regular in form or does not relate to an appealable action, the primary examiner shall so state.

(2) An examiner's answer must not include a new ground of rejection, but if an amendment under § 1.116 proposes to add or amend one or more claims and appellant was advised that the

amendment under § 1.116 would be entered for purposes of appeal and which individual rejection(s) set forth in the action from which the appeal was taken would be used to reject the added or amended claim(s), then the appeal brief must address the rejection(s) of the claim(s) added or amended by the amendment under § 1.116 as appellant was so advised and the examiner's answer may include the rejection(s) of the claim(s) added or amended by the amendment under § 1.116 as appellant was so advised. The filing of an amendment under § 1.116 which is entered for purposes of appeal represents appellant's consent that when so advised any appeal proceed on those claim(s) added or amended by the amendment under § 1.116 subject to any rejection set forth in the action from which the appeal was taken.

(b)(1) Appellant may file a reply brief to an examiner's answer or a supplemental examiner's answer within two months from the date of such examiner's answer or supplemental examiner's answer. See § 1.136(b) for extensions of time for filing a reply brief in a patent application and § 1.550(c) for extensions of time for filing a reply brief in a reexamination proceeding. The primary examiner must either acknowledge receipt and entry of the reply brief or withdraw the final rejection and reopen prosecution to respond to the reply brief. A supplemental examiner's answer is not permitted, unless the application has been remanded by the Board of Patent Appeals and Interferences for such purpose.

(2) Where prosecution is reopened by the primary examiner after an appeal or reply brief has been filed, appellant must exercise one of the following two options to avoid abandonment of the application:

(i) File a reply under § 1.111, if the Office action is not final, or a reply under § 1.113, if the Office action is final; or

(ii) Request reinstatement of the appeal. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (§§ 1.130, 1.131 or 1.132) or other evidence are permitted.

APPEAL CONFERENCE

An appeal conference is mandatory in all cases in which an acceptable brief (MPEP § 1206) has been filed. However, if the examiner charged with the responsibility of preparing the examiner's answer reaches a conclusion that the appeal should not go forward and the supervisory patent examiner (SPE) approves, then no appeal conference is necessary.

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

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

On the examiner's answer, below the primary examiner's signature, the word "Conferees:" should be included, followed by the typed or printed names of the other two appeal conference participants. These two appeal conference participants must place their initials next to their name. This will make the record clear that an appeal conference has been held.

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

Before preparing the answer, the examiner should make certain that all amendments approved for entry have in fact been physically entered. The Clerk of the Board will return to the TC 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 receipt of the brief by the examiner.

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. If any rejection is withdrawn, the withdrawal should be clearly stated in the examiner's answer under "Issues." 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 filed with or after the notice of appeal in accordance with 37 CFR 1.195. If an affidavit, declaration, or exhibit was refused entry under 37 CFR 1.195, the examiner should not comment on it in the examiner's answer. Likewise, it would be improper for appellant to rely on an affidavit, declaration, or exhibit, which was refused entry, in an appeal brief. If appellant has grounds for challenging the non-entry of an affidavit, declaration, or exhibit, he or she should file a timely petition seeking supervisory review of the non-entry. Any affidavits or declarations in the file swearing behind a patent should be clearly identified by the examiner as being considered under either 37 CFR 1.131 or 37 CFR 1.608(b).

If the brief fails to address 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 "Review of Brief by Examiner" should be followed.

Because of the practice of the U.S. 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. Where an amendment under 37 CFR 1.116 would be entered for appeal purposes, the examiner must identify (in an advisory action) how one or more individual rejections set forth in the final rejection would be used to reject the added or amended claim(s). See 37 CFR 1.193(a)(2) and MPEP § 1208.01. It is important to note that if more than a mere reference to one or more individual rejections set forth in the final rejection is necessary to explain how the added or amended claims would be rejected, then the amendment should not be entered because it raises new issues requiring further consideration and/or search. Furthermore, the mere fact that an amendment under 37 CFR 1.116 could fall within the operation of 37 CFR 1.193(a)(2) does not mean that the amendment must be entered by the examiner. That is, the provisions of 37 CFR 1.116 (and not 37 CFR 1.193(a)(2)) control as to whether an amendment under 37 CFR 1.116 is entitled to entry.

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 appearing 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 not 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. *Ex parte Emm,* 118 USPQ 180 (Bd. App. 1957).

A new ground of rejection is no longer permitted in an examiner's answer. For a discussion of what constitutes a new ground of rejection, see MPEP § 1208.01. If a new ground of rejection is necessary, prosecution must be reopened. The examiner must obtain approval from the supervisory patent examiner prior to reopening prosecution after an appeal. See MPEP § 1002.02(d).

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

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 TC Director for consideration. See MPEP § 1003. If approved by the TC Director, the examiner's answer should be forwarded to the Office of the Deputy Commissioner for Patent Examination Policy for final approval.

Briefs must comply with 37 CFR 1.192, and all examiner's answers filed in response to such briefs must comply with the guidelines set forth below.

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

(1) *Real Party in Interest.* A statement acknowledging the identification of the real party in financial interest or indicating that the party named in the caption of the brief is the real party in interest, or if the brief contains a proper heading but no real party in interest is identified, a statement that it is presumed that the party named in the caption of the brief is the real party in interest. While the examiner will make this presumption, the Board has discretion to require an explicit statement on this item from appellant.

(2) *Related Appeals and Interferences.* A statement acknowledging appellant's identification of related cases which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal, or if the appellant sets forth the required heading but does not identify any related appeals or interferences, a statement that it is presumed that there are none. While the examiner will make this presumption, the Board has discretion to require an explicit statement on this item from appellant.

(3) *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.

(4) *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.

(5) *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.

(6) *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:

(a) identification of any issues which are petitionable rather than appealable, and

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

(7) *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.

(8) *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.

(9) *References of Record*. A listing of the references of record relied on, and, in the case of nonpatent references, the relevant page or pages.

(10) *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.

(a) 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,

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

(ii) would not enable any person skilled in the art to make and use the subject matter defined by each of the rejected claims without undue experimentation, and (c) do not set forth the best mode contemplated by the appellant of carrying out his or her invention.

(b) For each rejection under 35 U.S.C. 112, second paragraph, the examiner's answer, 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.

(c) 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.

(d) For each rejection under 35 U.S.C. 103, the examiner's answer, or single prior action, shall:

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

(ii) identify any difference between the rejected claims and the prior art relied on, and

(iii) 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.

(e) For each rejection under 35 U.S.C. 102 or 103 where there are questions as to how limitations in the claims correspond to features in the prior art even after the examiner complies with the requirements of paragraphs (c) and (d) of this section, the examiner 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.

(f) For each rejection, other than those referred to in paragraphs (a) to (e) of this section, the examiner's answer, or single prior action, shall specifically explain the basis for the particular 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 replied to by appellant, the response shall point out each claim affected.

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

¶ 12.49 Examiner's Answer Cover Sheet

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
Paper No. **[1]**
Application Number: **[2]**
Filing Date: **[3]**
Appellant(s): **[4]**

_____
[5]

For Appellant
EXAMINER'S ANSWER
This is in response to the appeal brief filed **[6]**.

Examiner Note:

1. This form paragraph includes the USPTO Letterhead and should be used only if typing your own action. Answers prepared in draft form for typing by a typist should use form paragraph 12.50.
2. In bracket 1, insert the Paper No. of the examiner's answer.
3. In bracket 2, insert the application number of the appealed application.
4. In bracket 3, insert the filing date of the appealed application.
5. In bracket 4, insert the name(s) of the appellant.
6. In bracket 5, insert the name of the registered representative of the appellant.

7. In bracket 6, indicate the date on which the brief was filed, and also indicate if any supplemental appeal brief was filed, as well as the date on which the supplemental appeal brief was filed.

8. Form paragraph 12.50 should NOT follow use of this form paragraph as it is already incorporated herein.

¶ 12.50 Heading For Examiner's Answer

This is in response to the brief on appeal filed **[1]**.

Examiner Note:

1. Use this form paragraph only when having the Examiner's Answer prepared without using form paragraph 12.49.

2. In bracket 1, indicate the date on which the brief was filed, and also indicate if any supplemental appeal brief was filed, as well as the date on which the supplemental appeal brief was filed.

¶ 12.50.01 Real Party in Interest

(1) Real Party in Interest

Examiner Note:

Follow this form paragraph with form paragraph 12.50.02 or 12.50.03.

¶ 12.50.02 Acknowledgment of Appellant's Identification of a Real Party in Interest in the Brief

A statement identifying the real party in interest is contained in the brief.

¶ 12.50.03 No Identification of a Real Party in Interest in the Brief

The brief does not contain a statement identifying the Real Party in Interest. Therefore, it is presumed that the party named in the caption of the brief is the Real Party in Interest, i.e., the owner at the time the brief was filed. The Board, however, may exercise its discretion to require an explicit statement as to the Real Party in Interest.

¶ 12.50.04 Related Appeals and Interferences

(2) Related Appeals and Interferences

Examiner Note:

Follow this form paragraph with form paragraph 12.50.05 or 12.50.06.

¶ 12.50.05 Acknowledgment of Appellant's Statement Identifying the Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

¶ 12.50.06 No Related Appeals and Interferences Identified

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal. Therefore, it is presumed that there are none. The Board may, however, exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

¶ 12.51 Status of Claims

(3) Status of Claims

Examiner Note:

Follow this form paragraph with one or more of form paragraphs 12.51.01 to 12.51.10.

¶ 12.51.01 Agreement With Statement of Status of Claims

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

¶ 12.51.02 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:

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

2. One or more of form paragraphs 12.51.03 to 12.51.10 must follow this paragraph.

¶ 12.51.03 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 12.51.04 to 12.51.06 when appropriate to clarify the status of the claims on appeal that were incorrectly listed in the brief.

¶ 12.51.04 Status of Claims on Appeal - Substituted

Claim **[1]** been substituted for the finally rejected claims.

Examiner Note:

All substituted claims on appeal must be identified if the brief incorrectly lists any substituted claims. In bracket 1, insert the claim number(s) corresponding to the substitute claims, followed by --has-- or --have--, as appropriate.

¶ 12.51.05 Status of Claims on Appeal - Amended

Claim **[1]** been 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. In bracket 1, identify the claim number(s) corresponding to the claim(s) which have been amended, followed by --has-- or --have--, as appropriate.

¶ 12.51.07 Claims Allowed

Claim **[1]** allowed.

Examiner Note:

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

¶ 12.51.08 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.

¶ 12.51.09 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 Canceled

Claim **[1]** been canceled.

Examiner Note:

All canceled claims must be identified if the brief incorrectly lists any canceled claims.

¶ 12.52 Status of Amendments After Final

(4) Status of Amendments After Final

Examiner Note:

Identify status of all amendments submitted after final rejection. Use one or more of form paragraphs 12.52.01 to 12.52.04, if appropriate.

¶ 12.52.01 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.

¶ 12.52.02 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 12.52.03 and/or 12.52.04 must follow this form paragraph to explain the reasons for disagreeing with appellant's statement of the status of the amendments.

¶ 12.52.03 Amendment After Final Entered

The amendment after final rejection filed on **[1]** has been entered.

Examiner Note:

1. In bracket 1, insert the filing date of any entered after final amendment.
2. Use this form paragraph for each after final amendment which has been entered.

¶ 12.52.04 Amendment After Final Not Entered

The amendment after final rejection filed on **[1]** has not been entered.

Examiner Note:

1. In bracket 1, insert the date of any after final amendment denied entry.
2. Use this form paragraph for each after final amendment which has been denied entry.

¶ 12.52.05 No Amendments After Final

No amendment after final has been filed.

¶ 12.53 Summary of Invention

(5) Summary of Invention

Examiner Note:

Follow this form paragraph with either of form paragraphs 12.53.01 or 12.53.02.

¶ 12.53.01 Agreement With the Summary of Invention

The summary of invention contained in the brief is correct.

¶ 12.53.02 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

(6) Issues

Examiner Note:

Follow this form paragraph with form paragraphs 12.54.01, 12.54.02, or 12.54.03.

¶ 12.54.01 Agreement With Appellant's Statement of the Issues

The appellant's statement of the issues in the brief is correct.

¶ 12.54.02 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 respect to 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, and/or

(iii) any change not covered in (i) or (ii).

¶ 12.54.03 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

(7) Grouping of Claims

Examiner Note:

Follow this form paragraph with either form paragraph 12.55.01, 12.55.02 or 12.55.04 for each grouping of claims (i.e., each ground of rejection which appellant contests).

¶ 12.55.01 No Statement and Reasons 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 and reasons in support thereof. See 37 CFR 1.192(c)(7).

Examiner Note:

1. Use this form paragraph for each grouping of claims (i.e., ground of rejection which appellant contests) wherein the brief includes neither a statement that a grouping of claims does not stand or fall together nor reasons in support thereof.
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)(7), notify appellant of the non-compliance using form paragraphs 12.69, 12.69.01 and 12.78.

¶ 12.55.02 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, e.g., the claims as listed by the appellant are not separately patentable.

¶ 12.55.04 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)(7) and (c)(8).

¶ 12.56 Claims Appealed

(8) Claims Appealed

Examiner Note:

Follow this form paragraph with form paragraph 12.56.01, 12.56.02 or 12.56.03.

¶ 12.56.01 Copy of the Appealed Claims in Appendix Is Correct

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

¶ 12.56.02 Copy of the Appealed Claims in 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.

¶ 12.56.03 Copy of the Appealed Claims in 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)(9).
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

(9) Prior Art of Record

Examiner Note:

Follow this form paragraph with either form paragraph 12.57.01 or 12.57.02.

¶ 12.57.01 No Prior Art Relied Upon

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

¶ 12.57.02 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.

¶ 12.59 Grounds of Rejection

(10) 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 - vi below:

(i) For each rejection under 35 U.S.C. 112, first paragraph, the Examiner's Answer or a 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/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 appellant 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 upon 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 (ii), (iii) and (iv) above, should compare at least one of the rejected claims feature by feature with the prior art relied on in the rejection. The comparison shall align the language of the claim side by side with a reference to the specific page, line 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) for this section, the Examiner's Answer, or single prior action, shall specifically explain the basis for the particular rejection.

¶ 12.59.01 Reference to Rejection in Prior Office Action

Claim **[1]** rejected under 35 U.S.C. **[2]**. This rejection is fully set forth in prior Office action, Paper No. **[3]**.

Examiner Note:

1. In bracket 1, insert the claims subject to this ground of rejection.
2. In bracket 2, insert the section of 35 U.S.C. under which the claims are rejected.
3. In bracket 3, insert the Paper No. of the Office action in which the rejection is set forth in detail.

¶ 12.61 Response to Argument

(11) Response to Argument

Examiner Note:

1. If an issue raised by appellant was fully responded to under the "Grounds of Rejection" portion, no additional response is required here.
2. If an issue has been raised by appellant that was not fully responded to under "Grounds of Rejection," a full response must be provided after this form paragraph.

¶ 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 an oral hearing has been requested by appellant and 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 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,

[1]

Conferees:

[2]

[3]

Examiner Note:

1. In bracket 1, insert initials of the examiner and the date.
2. In bracket 2, insert names of the conferees. The conferees must also place their initials next to their names.
3. In bracket 3, insert correspondence address of record.

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

If the examiner requests an oral hearing, the request should appear in the last paragraph of the examiner's answer. See the "Participation by Examiner" discussion in MPEP § 1209.

Up to two examiners are permitted to attend any one hearing as observers, where the case is related to the examiners' field of technology. Such attendance by examiners is considered to be desirable for the experience and educational benefits to the examiners.

If the appellant has requested an oral hearing, and the examiner wishes to attend as an observer, the

examiner should include a statement that he/she will attend the hearing: (A) as the last paragraph of the examiner's answer, if appellant's request for an oral hearing has been made before or with the brief, or (B) in an acknowledgement of the reply brief or in a separate letter on form PTOL-90, if appellant's request for an oral hearing has been made after the examiner's answer. Also, the examiner should make a notation "Examiner will attend (but not participate in) hearing" on the face of the file wrapper below the box for the examiner's name.

1208.01 Prohibition Against Entry of New Ground of Rejection in Examiner's Answer

37 CFR 1.193(a)(2) prohibits the entry of a new ground of rejection in an examiner's answer. At the time of preparing the answer to an appeal brief, however, the examiner may decide that he or she should apply a new ground of rejection against some or all of the appealed claims. In such an instance where a new ground of rejection is necessary, the examiner should reopen prosecution. The examiner must obtain supervisory approval in order to reopen prosecution after an appeal. See MPEP § 1002.02(d).

There is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). Where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection. *Id.* at 1303, 190 USPQ at 427 (reliance upon fewer references in affirming a rejection under 35 U.S.C. 103 does not constitute a new ground of rejection).

37 CFR 1.193(a)(2) also provides that if:

(A) an amendment under 37 CFR 1.116 proposes to add or amend one or more claims;

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

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

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

(2) the examiner's answer may include the rejection(s) of the added or amended claims.

The filing of such an amendment represents appellant's consent to proceed with the appeal process. For example, when an amendment under 37 CFR 1.116 cancels a claim (the "canceled claim") and incorporates its limitations into the claim upon which it depends or rewrites the claim as a new independent claim (the "appealed claim"), the appealed claim contains the limitations of the canceled claim (i.e., the only difference between the appealed claim and the canceled claim is the claim number). In such situations, the appellant has been given a fair opportunity to react to the ground of rejection (albeit to a claim having a different claim number). Thus, such a rejection does not constitute a "new ground of rejection" within the meaning of 37 CFR 1.193(a)(2).

The phrase "individual rejections" in 37 CFR 1.193(a)(2) addresses situations such as the following: the action contains a rejection of claim 1 under 35 U.S.C. 102 on the basis of Reference A, a rejection of claim 2 (which depends upon claim 1) under 35 U.S.C. 103 on the basis of Reference A in view of Reference B and a rejection of claim 3 (which depends upon claim 1) under 35 U.S.C. 103 on the basis of Reference A in view of Reference C. In this situation, the action contains the following "individual rejections": (1) 35 U.S.C. 102 on the basis of Reference A; (2) 35 U.S.C. 103 on the basis of Reference A in view of Reference B; and (3) 35 U.S.C. 103 on the basis of Reference A in view of Reference C. The action, however, does not contain any rejection on the basis of A in view of B and C. If an amendment under 37 CFR 1.116 proposes to combine the limitations of claims 1 and 2 together into new claim 4 (or add the limitations of claim 2 to claim 1), 37 CFR 1.193(a)(2) would authorize a rejection of claim 4 (or amended claim 1) under 35 U.S.C. 103 on the basis of Reference A in view of Reference B, provided the applicant was advised that this rejection would be applied to claim 4 (or amended claim 1). Likewise, if an amendment under 37 CFR 1.116 proposes to combine the limitations of claims 1 and 3 together into new claim 4 (or add the limitations of claim 3 to claim 1),

37 CFR 1.193(a)(2) would authorize a rejection of claim 4 (or amended claim 1) under 35 U.S.C. 103 on the basis of Reference A in view of Reference C, provided the applicant was advised that this rejection would be applied to claim 4 (or amended claim 1). If, however, an amendment under 37 CFR 1.116 proposes to combine the limitations of claims 1, 2, and 3 together into new claim 4 (or add the limitations of claims 2 and 3 to claim 1), 37 CFR 1.193(a)(2) would **not** authorize a rejection of claim 4 (or amended claim 1) under 35 U.S.C. 103 on the basis of Reference A in view of Reference B and Reference C, even if the applicant is advised that this rejection would be applied to claim 4 (or amended claim 1). Of course, as a claim including the limitations of both claim 2 and claim 3 is a newly proposed claim in the application raising a new issue (i.e., a new ground of rejection), such an amendment under 37 CFR 1.116 may properly be refused entry as raising new issues.

It must be emphasized that amended 37 CFR 1.193(a)(2) does not change the existing practice with respect to amendment after final rejection practice (37 CFR 1.116). The fact that 37 CFR 1.193(a)(2) would authorize the rejection in an examiner's answer of a claim sought to be added or amended in an amendment under 37 CFR 1.116 has no effect on whether the amendment under 37 CFR 1.116 is entitled to entry. The provisions of 37 CFR 1.116 control whether an amendment under 37 CFR 1.116 is entitled to entry; the provisions of 37 CFR 1.193(a)(2) control the rejections to which a claim added or amended in an amendment under 37 CFR 1.116 may be subject in an examiner's answer.

A new prior art reference cited for the first time in an examiner's answer generally will constitute a new ground of rejection. If the citation of a new prior art reference is necessary to support a rejection, it must be included in the statement of rejection, which would be considered to introduce a new ground of rejection. Even if the prior art reference is cited to support the rejection in a minor capacity, it should be positively included in the statement of rejection. *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n. 3 (CCPA 1970). However, where a newly cited reference is added merely as evidence of the prior well known statement made by the examiner, the citation of the reference in the examiner's answer would not constitute a new ground of rejection within the meaning of 37 CFR 1.192(a)(2). See also MPEP § 2144.03.

Any allegation that an examiner's answer contains an impermissible new ground of rejection is waived if not timely (37 CFR 1.181(f)) raised by way of a petition under 37 CFR 1.181(a).

1208.02 Reopening of Prosecution After Appeal

The examiner may, with approval from the supervisory patent examiner, reopen prosecution to enter a new ground of rejection after appellant's brief or reply brief has been filed. The Office action containing a new ground of rejection may be made final if the new ground of rejection was (A) necessitated by amendment, or (B) based on information presented in an information disclosure statement under 37 CFR 1.97(c) where no statement under 37 CFR 1.97(e) was filed. See MPEP § 706.07(a).

Form paragraph 12.81 may be used when reopening prosecution:

¶ 12.81 Reopening of Prosecution - New Ground of Rejection After Appeal or Examiner's Rebuttal of Reply Brief

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

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

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Examiner Note:

1. Use this form paragraph to reopen prosecution in order to make a new ground of rejection of claims or to enter a rebuttal to the reply brief. The finality or non-finality of an Office action following a reopening of prosecution depends on whether the action could have been properly made final had it been entered prior to the appeal.

2. In bracket 1, insert --appeal brief--, --supplemental appeal brief--, --reply brief-- or --supplemental reply brief--.

3. In bracket 2, insert the date on which the brief was filed.

4. In bracket 3, insert --A new ground of rejection is--, --New grounds of rejection are-- or --A rebuttal to the Reply Brief is--.

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

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

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

(C) request reinstatement of the appeal.

See 37 CFR 1.193(b)(2). Whether appellant elects to continue prosecution or to request reinstatement of the appeal, if prosecution was reopened prior to a decision on the merits by the Board of Patent Appeals and Interferences, the fee paid for the notice of appeal, appeal brief, and request for oral hearing (if applicable) will be applied to a later appeal on the same application.

If reinstatement of the appeal is requested, the request must be accompanied by a supplemental appeal brief; however, no new amendments, affidavits (37 CFR 1.130, 1.131, or 1.132), or other evidence is permitted. The supplemental appeal brief must comply with the requirements of 37 CFR 1.192(c), but in doing so may incorporate by reference such parts of the previously-filed brief as may still be applicable. The arguments presented in the supplemental appeal brief need only be those relevant to the new ground(s) of rejection raised in the Office action that reopened prosecution, but the appellant should also identify all previously-raised issues and/or arguments which are still considered to be relevant. If the examiner does not consider that the supplemental appeal brief complies with the foregoing requirements, appellant should be given a 1-month time period within which to file an amended supplemental brief under 37 CFR 1.192(d). See MPEP § 1206.

After the supplemental appeal brief is filed, the examiner may issue an answer thereto, and appellant may file a reply brief. It is also 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 by submitting an appropriate amendment and the examiner finds the remaining claims to be allowable, the examiner should allow the application.

In applications where an interference has resulted from the applicant provoking an interference with 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

37 CFR 1.193. Examiner's answer and reply brief.

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(b)(1)Appellant may file a reply brief to an examiner's answer or a supplemental examiner's answer within two months from the date of such examiner's answer or supplemental examiner's answer. See § 1.136(b) for extensions of time for filing a reply brief in a patent application and § 1.550(c) for extensions of time for filing a reply brief in a reexamination proceeding. The primary examiner must either acknowledge receipt and entry of the reply brief or withdraw the final rejection and reopen prosecution to respond to the reply brief. A supplemental examiner's answer is not permitted, unless the application has been remanded by the Board of Patent Appeals and Interferences for such purpose.

(2) Where prosecution is reopened by the primary examiner after an appeal or reply brief has been filed, appellant must exercise one of the following two options to avoid abandonment of the application:

(i) File a reply under § 1.111, if the Office action is not final, or a reply under § 1.113, if the Office action is final; or

(ii) Request reinstatement of the appeal. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (§§ 1.130, 1.131 or 1.132) or other evidence are permitted.

Under 37 CFR 1.193(b)(1), appellant may file a reply brief as a matter of right within 2 months from the mailing date of the examiner's answer or supplemental examiner's answer. Extensions of time to file the reply brief may be granted pursuant to 37 CFR 1.136(b) or 1.550(c). The primary examiner must then either: (A) acknowledge receipt and entry of the reply brief by using form paragraph 12.47 on form PTOL-90; or (B) reopen prosecution to respond to the reply brief. See MPEP § 1208.02. A supplemental examiner's answer is not permitted unless the application has been remanded by the Board for such purpose.

Amendments, affidavits, and/or other evidence must be submitted in papers separate from the reply brief, and the entry of such papers is subject to the provisions of 37 CFR 1.116 and 37 CFR 1.195. A paper that contains an amendment (or evidence) is not a reply brief within the meaning of 37 CFR 1.193(b). Such a paper will not be entitled to entry simply because it is characterized as a reply brief.

While 37 CFR 1.193(b)(1) prohibits a supplemental examiner's answer (in the absence of a remand from the Board of Patent Appeals and Interference for such purpose), an examiner may (with supervisory patent examiner approval) respond to a reply brief by reopening prosecution. The acknowledgment of receipt and entry of a reply brief under 37 CFR 1.193(b)(1) is an indication by the examiner that no further response by the examiner is deemed necessary. Thus, a remand by the Board of Patent Appeals and Interference under 37 CFR 1.193(b)(1) in an application containing an acknowledgment of receipt and entry of a reply brief under 37 CFR 1.193(b)(1) for the express purpose of a response by the examiner to the reply brief (a supplemental examiner's answer) should rarely, if ever, be necessary.

It should also be noted that an indication of a change in status of claims (e.g., that certain rejections have been withdrawn as a result of the reply brief) is not a supplemental examiner's answer and is of course permitted. Such an indication of a change in status of claims may be made on form PTOL-90.

For procedure where prosecution is reopened after a reply brief has been filed, see MPEP § 1208.02.

Form paragraph 12.47 may be used to acknowledge receipt and entry of a reply brief.

¶ *12.47 Acknowledgment of Reply Brief*

Application No. **[1]**

Art Unit **[2]**

The reply brief filed **[3]** has been entered and considered. The application has been forwarded to the Board of Patent Appeals and Interferences for decision on the appeal.

Examiner Note:

1. This form paragraph is to be printed on a blank page for attachment to a PTOL-90 or PTO-90C.

2. If an amendment, an affidavit and/or a declaration has/have been filed with the reply brief, the examiner must notify the appellant in writing whether it has been entered. Unless the amendment, affidavit, and/or declaration place(s) the application in condition for allowance, entry should not be permitted. See 37 CFR 1.116 and 37 CFR 1.195. This is particularly important since a supplemental examiner's answer is not permitted, unless the application has been remanded by the Board of Patent Appeals and Interferences for such purpose. See 37 CFR 1.193(b)(1).

1209 Oral Hearing

37 CFR 1.194. Oral hearing.

(a) An oral hearing should be requested only in those circumstances in which appellant considers such a hearing necessary or desirable for a proper presentation of the appeal. An appeal decided 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, in a separate paper, a written request for such hearing accompanied by the fee set forth in § 1.17(d) within two months from the date of the examiner's answer. If appellant requests an oral hearing and submits therewith the fee set forth in § 1.17(d), 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. See § 1.136(b) for extensions of time for requesting an oral hearing in a patent application and § 1.550(c) for extensions of time for requesting an oral hearing in a reexamination proceeding.

(c) If no request and fee for oral hearing have been timely filed by appellant, the appeal will be assigned for consideration and decision. If appellant has requested an oral hearing and has submitted the fee set forth in § 1.17(d), a day of hearing will be set, and due notice thereof given to appellant and to the primary examiner. A hearing will be held as stated in the notice, and oral argument will be limited to twenty minutes for appellant and fifteen minutes for the primary examiner unless otherwise ordered before the hearing begins. If the Board decides that a hearing is not necessary, the Board will so notify appellant.

37 CFR 1.194(b) provides that an appellant who desires an oral hearing before the Board must request the hearing by filing, in a separate paper, a written request therefor, accompanied by the appropriate fee set forth in 37 CFR 1.17(d), within 2 months after the date of the examiner's answer. This time period may only be extended by filing a request under either 37 CFR 1.136(b) or, if the appeal involves an *ex parte* reexamination proceeding, under 37 CFR 1.550(c).

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 time required in the notice of hearing, the appeal will be removed from the hearing docket and assigned on brief in due course. No refund of the fee for requesting an oral hearing will be made. Similarly, after confirmation, if no appearance is made at the scheduled hearing, the appeal will be decided on brief. Since failure to notify the Board of waiver of hearing in advance of the assigned date results in a waste of the Board's resources, appellant should inform the Board

of a change in plans at the earliest possible opportunity. If the Board determines that a hearing is not necessary (e.g., a remand to the examiner is necessary or it is clear that the rejection(s) cannot be sustained), appellant will be notified.

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

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

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

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

PARTICIPATION BY EXAMINER

If the appellant has requested an oral hearing and the primary examiner wishes to appear and present an oral argument before the Board, a request to present oral argument must be included as the last paragraph of the examiner's answer, using form paragraph 12.63. See MPEP § 1208. If the appellant's request for a hearing is filed after the examiner's answer, then the examiner's request must be in an acknowledgement of reply brief, if applicable, or in a separate letter on form PTOL-90. In either case, the examiner should also make a notation "Examiner Requests an Oral Hearing" on the face of the file wrapper below the box for the examiner's name.

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

After the oral hearing has been confirmed and the date set as provided in 37 CFR 1.194(c), the application file will be delivered to the examiner via the appropriate Technology Center Director at least 2 weeks prior to the date of the hearing and the examiner will be notified of the date of the hearing. In those cases where the Board requests the presentation of an oral argument by or on behalf of the primary examiner, the Board's request may, where appropriate, indicate specific points or questions to which the argument should be particularly directed. The application file must be returned to the Board at least 2 working days before the hearing.

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.

At the hearing, after the appellant has made his or her presentation, the examiner will be allowed 15 minutes to reply as well as to present a statement which clearly sets forth his or her position with respect to the issues and rejections of record. Appellant may utilize any allotted time not used in the initial presentation for rebuttal.

If the examiner wishes to attend the oral hearing as an observer but not to present oral argument, see MPEP § 1208.

1210 Actions Subsequent to Examiner's Answer but Before Board's Decision

JURISDICTION OF BOARD

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

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

(B) After a supplemental examiner's answer, pursuant to a remand from the Board, has been mailed.

(C) After the examiner has notified the appellant by written communication that the reply brief has been entered and considered and that the application will be forwarded to the Board (for example, by mailing a PTOL-90 with form paragraph 12.47, as described in MPEP § 1208.03).

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 second or final rejection only of one or more claims presented for the purpose of provoking an interference, jurisdiction of the rest of the case remains with the examiner, and prosecution of the remaining claims may proceed as though the entire case was under his or her jurisdiction. Also, where the examiner certifies in writing that there is no conflict of subject matter and the administrative patent judge in charge of the interference approves, an appeal to the Board may proceed concurrently with an interference. See MPEP § 2315.

ABANDONMENT OF APPEAL: APPLICATION REFILED OR ABANDONED

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.

1210.01 Order for Compliance

While the examiner will assume that the real party in interest is the individual or individuals identified in the caption when the real party in interest is not explicitly set out in the brief, the Board may require the appellant to explicitly name the real party in interest. Likewise, while the examiner will assume that there are no related cases when no related case is explicitly set out in the brief, the Board may require the appellant to explicitly identify any related case. When the Board elects to require an explicit statement, an order for compliance with the rule will be entered setting a 1 - month period for reply to the Board's requirement (37 CFR 1.192(d)). Extensions of time are only available under 37 CFR 1.136(b). An entire new brief need not, and should not, be filed. Rather, a simple paper identifying the real party in interest or explicitly stating that the appellant is the real party in interest will suffice. Failure to timely respond to the Board's requirement may result in dismissal of the appeal. See MPEP § 1215.04 and MPEP § 711.02(b).

1211 Remand by Board

The Board has authority to remand a case to the examiner when it deems it necessary. For example, the Board may remand 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, affidavit, or declaration. See MPEP § 1211.01, § 1211.02, and § 1211.03. Furthermore, the Board may remand an application to the examiner to prepare a supplemental examiner's answer in response to a reply brief. The following form paragraph may be used in preparing the supplemental examiner's answer after a remand from the Board:

¶ 12.80 Supplemental Examiner's Answer - On Remand

Pursuant to the Remand under 37 CFR 1.193(b)(1) by the Board of Patent Appeals and Interferences on **[1]**, a supplemental Examiner's Answer is set forth below: **[2]**.

Examiner Note:

1. Insert the date of the Remand.

2. Provide reasons supporting the rejections set forth in the supplemental Examiner's Answer.

The supervisory patent examiner should approve and the Board should be notified whenever a remanded application is withdrawn from appeal under any circumstance. See MPEP § 706.07(e) and § 1002.02(d).

1211.01 Remand by Board To Consider Amendment

There is no obligation resting on the Board to consider new or amended claims submitted while it has jurisdiction of the appeal. *In re Sweet*, 136 F.2d 722, 58 USPQ 327 (CCPA 1943). However, a proposed amendment, affidavit, declaration, or other paper may be remanded for such consideration as the examiner may see fit to give. Such an amendment 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.

1211.02 Remand by Board To Consider Affidavits or Declarations

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 the filing of a notice of appeal but before jurisdiction passes to the Board (see MPEP § 1210) 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 MPEP § 715.09, § 716, and § 716.01.

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 an application 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 application to the Board with his or her supplemental examiner's 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 rehearing 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*, 154 F.2d 126, 69 USPQ 75 (CCPA 1946).

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

1211.03 Remand by Board for Further Search

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

1212 Board Requires Appellant to Address Matter

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

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(d) The Board of Patent Appeals and Interferences may require appellant to address any matter that is deemed appropriate for a reasoned decision on the pending appeal. Appellant will be given a non-extendable time period within which to respond to such a requirement.

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37 CFR 1.196(d) authorizes the Board to require an appellant to clarify the record by addressing any matter deemed appropriate for a reasoned decision on the appeal. This may include, for example: (A) the applicability of particular case law that has not been previously identified as relevant to an issue in the appeal; or (B) the applicability of prior art that has not been made of record.

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

The making of a requirement under 37 CFR 1.196(d) is discretionary with the Board. The authority granted in 37 CFR 1.196(d) does not affect the Board's authority to remand a case to the examiner in a situation where the Board considers action by the examiner in the first instance to be necessary or desirable. See MPEP § 1211. Also, after an appellant has replied to a requirement under 37 CFR 1.196(d), a remand to the examiner may be deemed to be appropriate.

1213 Decision by Board

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.

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

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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.

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.

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

An applicant may 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.

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

1213.01 Statement of Allowability by Board

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

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(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.

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If the Board's decision includes an explicit statement that a claim may be allowed in amended form, appellant may amend the claim in conformity with the statement and the statement would be binding on the examiner in the absence of new prior art references or grounds of rejection. The examiner should make certain that the amendment does in fact conform to the statement in the Board's decision.

The making of a statement under 37 CFR 1.196(c) is discretionary with the Board. In the absence of an express statement, a remark by the Board that a certain feature does not appear in a claim is not to be taken as a statement that the claim may be allowed if the feature is supplied by amendment. *Ex parte Norlund*, 1913 C.D. 161, 192 O.G. 989 (Comm'r Pat. 1913).

Appellant's right to amend in conformity with the statement under 37 CFR 1.196(c) may only be exercised within the period allowed for seeking court review under 37 CFR 1.304. See MPEP § 1216.

1213.02 New Grounds of Rejection by Board

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

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(b) Should the Board of Patent Appeals and Interferences have knowledge of any grounds not involved in the appeal for rejecting any pending claim, it may include in the decision a statement to that effect with its reasons for so holding, which statement constitutes a new ground of rejection of the claim. A new ground of rejection shall not be considered final for purposes of judicial review. When the Board of Patent Appeals and Interferences makes a new ground of rejection, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. The new ground of rejection is 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 of rejection stated in the decision. Should the examiner reject the claims, appellant may again appeal pursuant to §§ 1.191 through 1.195 to the Board of Patent Appeals and Interferences.

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. The request for rehearing must address the new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in rendering the decision and also state all other grounds upon which rehearing is sought. Where request for such rehearing is made, the Board of Patent Appeals and Interferences shall rehear the new ground of rejection and, if necessary, render a new decision which shall include all grounds of rejection upon which a patent is refused. The decision on rehearing is deemed to incorporate the earlier decision for purposes of appeal, except for those portions specifically withdrawn on rehearing, and is final for the purpose of judicial review, except when noted otherwise in the decision.

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(f) See § 1.136(b) for extensions of time to take action under this section in a patent application and § 1.550(c) for extensions of time in a reexamination proceeding.

Under 37 CFR 1.196(b), the Board may, in its decision, make a new rejection of one or more of any of the claims pending in the case, including claims which have been allowed by the examiner.

While 37 CFR 1.196(b) now authorizes the Board to reject allowed claims, this authorization is not intended as an instruction to the Board to examine every allowed claim in every appealed application. It is, rather, intended to give the Board express authority to act when it becomes apparent, during the consideration of rejected claims, that one or more allowed claims may be subject to rejection on either the same or on different grounds from those applied against the rejected claims. Since the exercise of authority under 37 CFR 1.196(b) is discretionary, no inference should be drawn from a failure to exercise that discretion.

See MPEP § 1214.01 for the procedure following a new ground of rejection under 37 CFR 1.196(b).

1213.03 Publication of Board Decision

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(g).

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

1214 Procedure Following Decision by Board

37 CFR 1.197. Action following decision.

(a) After decision by the Board of Patent Appeals and Interferences, the application will be returned to the examiner, subject to appellant's right of appeal or other review, for such further action by appellant or by the examiner, as the condition of the application may require, to carry into effect the decision.

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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 Technology Center Director immediately if all rejections are reversed, and after about 10 weeks if any rejection is affirmed or after a decision on a request for rehearing is rendered.

1214.01 Procedure Following New Ground of Rejection by Board

When the Board makes a new rejection under 37 CFR 1.196(b), the appellant, as to each claim so rejected, has the option of:

(A) submitting an appropriate amendment and/or a showing of facts (37 CFR 1.196(b)(1)); or

(B) requesting rehearing (37 CFR 1.196(b)(2)).

The amendment and/or showing of facts under 37 CFR 1.196(b)(1), or the request for rehearing under 37 CFR 1.196(b)(2), must be filed within 2 months from the date of the Board's decision. In accordance with 37 CFR 1.196(f), this 2-month time period may not be extended by the filing of a petition and fee under 37 CFR 1.136(a), but only under the provisions of 37 CFR 1.136(b), or under 37 CFR 1.550(c) if the appeal involves an *ex parte* reexamination proceeding.

If an appellant files an appropriate amendment or showing of facts (see paragraph I below) as to less than all of the claims rejected by the Board under 37 CFR 1.196(b), and a request for rehearing (see paragraph II below) as to the remainder of the claims so rejected, the examiner will not consider the claims for which rehearing was requested. The request for rehearing will be considered by the Board after prosecution before the examiner with respect to the first group of claims is terminated. Argument as to any of the claims rejected by the Board which is not accompanied by an appropriate amendment or showing of facts as to those claims will be treated as a request for rehearing as to those claims.

I. SUBMISSION OF AMENDMENT OR SHOWING OF FACTS

37 CFR 1.196(b)(1) provides that the application will be remanded to the examiner for reconsideration if the appellant submits "an appropriate amendment" of the claims rejected by the Board, "or a showing of facts relating to the claims so rejected, or both." An amendment is "appropriate" under the rule if it amends one or more of the claims rejected, or substitutes new claims to avoid the art or reasons adduced by the Board. *Ex parte Burrowes*, 110 O.G. 599, 1904 C.D. 155 (Comm'r Pat. 1904). Such amended or new claims must be directed to the same subject matter as the appealed claims. *Ex parte Comstock,* 317 O.G. 4,1923 C.D. 82 (Comm'r Pat. 1923). An amendment which adds new claims without either amending the rejected claims, or substituting new claims for the rejected claims, is not appropriate. The new claims will not be entered, and the examiner should return the application file to the Board for consideration of the amendment as a request for rehearing under 37 CFR 1.196(b)(2), if it contains any argument concerning the Board's rejection. The "showing of facts" under the rule may be a showing under 37 CFR 1.130, 1.131 or 1.132, as may be appropriate.

If the appellant submits an argument without either an appropriate amendment or a showing of facts as to any of the claims rejected by the Board, it will be treated as a request for rehearing under 37 CFR 1.196(b)(2).

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 Board's decision in which the rejection under 37 CFR 1.196(b) was made includes an affirmance of the examiner's rejection, the basis of the affirmed rejection is not open to further prosecution. If the appellant elects to proceed before the examiner with regard to the new rejection, the Board's affirmance of the examiner's rejection will be treated as nonfinal for purposes of seeking judicial review, and no request for reconsideration of the affirmance need be filed at that time. Prosecution before the examiner of the 37 CFR 1.196(b) rejection can incidentally result in overcoming the affirmed rejection even though the affirmed rejection is not open to further prosecution. Therefore, it is possible for the application to be allowed as a result of the limited prosecution before the examiner of the 37 CFR 1.196(b) rejection. If the application becomes allowed, the application should not be returned to the Board. Likewise, if the application is abandoned for any reason, the application should not be returned to the Board. If the rejection under 37 CFR 1.196(b) is not overcome, the applicant can file a second appeal (as discussed below). Such appeal must be limited to the 37 CFR 1.196(b) rejection and may not include the affirmed rejection. If the application does not become allowed or abandoned as discussed above, once prosecution of the claims which were rejected under 37 CFR 1.196(b) is terminated before the examiner, the application file must be returned to the Board so that a decision making the original affirmance final can be entered.

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

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

An applicant in whose application such a final rejection has been made by the examiner may mistakenly believe that he or she is entitled to review by the Board of the rejection by virtue of the previous appeal, but under the provisions of 37 CFR 1.196(b)(1), after such a final rejection, an applicant who desires further review of the matter must file a new appeal to the Board. Such an appeal from the subsequent rejection by the examiner will be an entirely new appeal involving a different ground and will require a new notice of appeal, appeal brief, and the payment of the appropriate fees.

II. REQUEST FOR REHEARING

Instead of filing an amendment and/or showing of facts under 37 CFR 1.196(b)(1), an appellant may elect to proceed under 37 CFR 1.196(b)(2) and file a request for rehearing of the Board's new rejection. The rule requires that the request for rehearing "must address the new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in rendering the decision and also state all other grounds upon which rehearing is sought." By proceeding in this manner, the appellant waives his or her right to further prosecution before the examiner. *In re Greenfield*, 40 F.2d 775, 5 USPQ 474 (CCPA 1930). A request for rehearing accompanied by an appropriate amendment of the claims rejected by the Board, and/or by an affidavit or declaration containing a showing of facts, does not constitute a proper request for rehearing under 37 CFR 1.196(b)(2), and will be treated as a submission under 37 CFR 1.196(b)(1).

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

1214.03 Rehearing

37 CFR 1.197. Action following decision.

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(b) Appellant may file a single request for rehearing within two months from the date of the original decision, unless the original decision is so modified by the decision on rehearing as to become, in effect, a new decision, and the Board of Patent Appeals and Interferences so states. The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked in rendering the decision and also state all other grounds upon which rehearing is sought. See

§ 1.136(b) for extensions of time for seeking rehearing in a patent application and § 1.550(c) for extensions of time for seeking rehearing in a reexamination proceeding.

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The term "rehearing" is used in 37 CFR 1.197(b) for consistency with the language of 35 U.S.C. 6(b). It should not be interpreted as meaning that an appellant is entitled to an oral hearing on the request for rehearing, but only to a rehearing on the written record. It is not the normal practice of the Board to grant rehearings in the sense of another oral hearing. *Ex parte Argoudelis*, 157 USPQ 437, 441 (Bd. App. 1967), *rev'd. on other grounds*, 434 F.2d 1390, 168 USPQ 99 (CCPA 1970).

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

The 2-month period provided by 37 CFR 1.197(b) for filing a request for rehearing can only be extended under the provisions of 37 CFR 1.136(b) or under 37 CFR 1.550(c) if the appeal involves an *ex parte* reexamination proceeding.

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 § 1216 and § 1002.02(o).

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

1214.04 Examiner Reversed

A complete reversal of the examiner's rejection brings the case up for immediate action by the examiner. If the reversal does not place an application in condition for immediate allowance (e.g., the Board has entered a new ground of rejection under 37 CFR 1.196(b)), the examiner should refer to the situations outlined in MPEP § 1214.06 for appropriate guidance.

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

If the examiner has specific knowledge of the existence of a particular reference or references which indicate nonpatentability of any of the appealed claims as to which the examiner was reversed, he or she should submit the matter to the Technology Center (TC) Director for authorization to reopen prosecution under 37 CFR 1.198 for the purpose of entering the new rejection. See MPEP § 1002.02(c) and MPEP § 1214.07. The TC Director's approval is placed on the action reopening prosecution.

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

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

The request should set a period of 1 month for the appellant to file a reply.

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

1214.05 Cancellation of Withdrawn Claims

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

37 CFR 1.197. Action following decision.

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(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 U.S. District Court for the District of Columbia is the same for both tribunals, that is, 2 months, or 2 months with the extension provided by 37 CFR 1.304 in the event a request for rehearing is timely filed before the Board, or as extended by the Commissioner. See MPEP § 1216. When the time for seeking court review (plus 2 weeks to allow for information as to the filing of an appeal or civil action, if any, to reach the examiner) has passed without such review being sought, the examiner must take up the application for consideration. The situations which can arise will involve one or more of the following circumstances:

I. NO CLAIMS STAND ALLOWED

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

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

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

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

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

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

II. CLAIMS STAND ALLOWED

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

If the Board affirms a rejection of claim 1, claim 2 was objected to prior to appeal as being allowable except for its dependency from claim 1 and

independent claim 3 is allowed, the examiner should cancel claims 1 and 2 and issue the application or *ex parte* reexamination certificate with claim 3 only.

If uncorrected matters of form which cannot be handled without written correspondence remain in the application, the examiner should take appropriate action but prosecution is otherwise closed. Note paragraph I of this section for handling of claims dependent on rejected claims. A letter such as that 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 appellant. 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.

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

Examiner Note:

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

III. CLAIMS REQUIRE ACTION

If the decision of the Board is an affirmance in part and includes a reversal of a rejection that brings certain claims up for action on the merits, such as a decision reversing the rejection of generic claims in an application or *ex parte* reexamination proceeding containing claims to nonelected species not previously acted upon, the examiner will take up the application or reexamination proceeding for appropriate action on the matters thus brought up. However, the application or reexamination proceeding is not considered open to further prosecution except as to such matters.

IV. 37 CFR 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 2 months, the examiner should proceed in the manner indicated in paragraphs I-III of this section as appropriate. See MPEP § 1214.01.

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

(A) If the appellant elects to proceed before the examiner with regard to the new rejection (see MPEP § 1214.01, paragraph I) the Board's affirmance will be treated as nonfinal, and no request for rehearing of the affirmance need be filed at that time. Prosecution before the examiner of the 37 CFR 1.196(b) rejection can incidentally result in overcoming the affirmed rejection even though the affirmed rejection is not open to further prosecution. Therefore, it is possible for the application to be allowed as a result of the limited prosecution before the examiner of the 37 CFR 1.196(b) rejection. If an application becomes allowed, it should not be returned to the Board. Likewise, if an application is abandoned for any reason, it should not be returned to the Board. If the rejection under 37 CFR 1.196(b) is not overcome, the applicant (or patent owner in an *ex parte* reexamination proceeding) can file a second appeal (as discussed below). Such appeal must be limited to the 37 CFR 1.196(b) rejection and may not include the affirmed rejection. If an application does not become allowed or abandoned as discussed above, once prosecution of the claims which were rejected under 37 CFR 1.196(b) is terminated before the examiner, the application file must be returned to the Board so that a decision making the original affirmance final can be entered. Similarly, the file of any *ex parte* reexamination proceeding including rejections affirmed by the Board but made nonfinal for purposes of judicial review must be returned to the Board so that the affirmance can be made final by the Board. The time for filing a request for rehearing on the affirmance or seeking court review runs from the date of the decision by the Board making the original affirmance final. See MPEP § 1214.03 and § 1216.

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

V. 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 the situations identified in paragraphs I-III of this section 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 case files which come back from the Board are not overlooked because every case, except applications in which all claims stand rejected after the Board's decision, is up for action by the examiner in the event no court review has been sought. 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 the file wrapper immediately below the endorsement "Decision by Board."

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

1214.07 Reopening of Prosecution

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 § 1.114 or § 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 is closed, the appellant is not entitled to have such amendment entered as a matter of right. However, if the amendment is submitted with a request for continued examination (RCE) under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e), the prosecution of the application will be reopened and the amendment will be entered. See MPEP § 706.07(h), paragraph XI. Note that the RCE practice under 37 CFR 1.114 does not apply to utility or plant patent applications filed before June 8, 1995 or to design applications. See 37 CFR 1.114(d) and MPEP § 706.07(h), paragraph I. If the amendment obviously places an application in condition for allowance, regardless of whether the amendment is filed with an RCE, the primary examiner should recommend that the amendment be admitted, and with the concurrence of the supervisory patent examiner, the amendment will be entered. Note MPEP § 1002.02(d).

Where the amendment cannot be entered, the examiner should write to the appellant indicating that the amendment cannot be entered and stating the reason why. The refusal may not be arbitrary or capricious.

Form paragraph 12.19 should be used:

¶ 12.19 Amendment After Board Decision, Entry Refused

The amendment filed **[1]** after a decision by the Board of Patent Appeals and Interferences is not entered because prosecution is closed and the proposed claim(s) raise new issues which require further consideration or search (37 CFR 1.116(c)). See also 37 CFR 1.198.

[2]

Examiner Note:

1. In bracket 2, identify the new issues.
2. This form paragraph is not to be used where a 37 CFR 1.196 (b) rejection has been made by the Board of Patent Appeals and Interferences.

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

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

The 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:

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

(B) When the decision of the Board asserts that the rejection of the claims is proper because the record does not include evidence of a specified character, and is reasonably suggestive that if such evidence were presented, the appealed claims would be allowable, and it is demonstrated that such evidence presently exists and can be offered; or

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

Such petitions will not be ordinarily entertained after the filing of the 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 U. S. Patent and Trademark Office. If so remanded, the proposed amendments, evidence, and arguments will be entered of record in the application file for consideration, and further action will be taken by the Board in the first instance or by the examiner as may be appropriate. In the case of civil action under 35 U.S.C. 145, steps will be taken for obtaining dismissal of the action without prejudice to consideration of the proposals.

1215 Withdrawal or Dismissal of Appeal

1215.01 Withdrawal of Appeal

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

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

Where a letter abandoning the application is filed in accordance with 37 CFR 1.138, the effective date of abandonment is the date of recognition of the letter by an appropriate official of the Office or a different date, if so specified in the letter itself. See MPEP § 711.01.

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

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

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. Applicants also should advise the Board when an RCE is filed in an application containing an appeal awaiting decision. Failure to exercise appropriate diligence in this matter may result in the Board refusing an otherwise proper request to vacate its decision.

Applications having no allowed claims will be abandoned. Claims which are allowable except for their dependency from rejected claims will be treated

as if they were rejected. The following examples illustrate the appropriate approach to be taken by the examiner in various situations:

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

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

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

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

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

1215.02 Claims Standing Allowed

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

1215.03 Partial Withdrawal

A withdrawal of the appeal as to some of the claims on appeal operates as an authorization to cancel those claims from the application or reexamination proceeding and the appeal continues as to the remaining claims. The withdrawn claims will be canceled from an application by direction of the examiner at the conclusion of the appeal proceedings, if necessary (e.g., the examiner is reversed as to the rejection of the remaining claims on appeal), without further action by the applicant.

1215.04 Dismissal of Appeal

If no brief is filed within the time prescribed by 37 CFR 1.192, the appeal stands dismissed by operation of the rule. Form PTOL-461 "Notification of Defective Notice of Appeal or Defective Brief," or form paragraph 12.17 notifying the appellant that the appeal stands dismissed is not an action in the case and does not start any period for reply. If no claims stand allowed, an application is considered as abandoned on the date the brief was due. If claims stand allowed in an application, the failure to file a brief and consequent dismissal of the appeal is to be treated as a withdrawal of the appeal and of any claim not standing allowed. The application should be passed to issue forthwith. Unless appellant specifically withdraws the appeal as to rejected claims, the appeal should not be dismissed until the extended period (5 months under 37 CFR 1.136(a)) to file the brief has expired.

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

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

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

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

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

However, if formal matters remain to be attended to, the examiner should take appropriate action on such matters, setting a shortened period for reply, but the application or reexamination proceeding is to be considered closed to further prosecution except as to such matters. Form paragraph 12.09.01 may be used for this purpose. See MPEP § 1206.

An appeal will also be dismissed if an applicant fails to timely and fully reply to a notice of noncompliance with 37 CFR 1.192(c). See MPEP § 1206 and 37 CFR 1.192(d). As in examples (B)-(C) above, if no allowed claims remain in an application, the application is abandoned as of the date the reply to the

notice was due. The applicant may petition to revive the application as in other cases of abandonment, and to reinstate the appeal. If the appeal is dismissed, but allowed claims remain in the application, as in examples (A) and (D) above, the application is not abandoned; to reinstate the claims cancelled by the examiner because of the dismissal, the applicant must petition to reinstate the claims and the appeal, but a showing equivalent to a petition to revive under 37 CFR 1.137 is required. In either event, a proper reply to the notice of noncompliance must be filed before the petition will be considered on its merits.

1216 Judicial Review

35 U.S.C. 141. Appeal to the Court of Appeals for the Federal Circuit.

An applicant dissatisfied with the decision in an appeal to the Board of Patent Appeals and Interferences under section 134 of this title may appeal the decision to the United States Court of Appeals for the Federal Circuit. By filing such an appeal the applicant waives his or her right to proceed under section 145 of this title. A patent owner in any reexamination proceeding dissatisfied with the final decision in an appeal to the Board of Patent Appeals and Interferences under section 134 may appeal the decision only to the United States Court of Appeals for the Federal Circuit. A party to an interference dissatisfied with the decision of the Board of Patent Appeals and Interferences on the interference may appeal the decision to the United States Court of Appeals for the Federal Circuit, but such appeal shall be dismissed if any adverse party to such interference, within twenty days after the appellant has filed notice of appeal in accordance with section 142 of this title, files notice with the Director that the party elects to have all further proceedings conducted as provided in section 146 of this title. If the appellant does not, within thirty days after filing of such notice by the adverse party, file a civil action under section 146, the decision appealed from shall govern the further proceedings in the case.

35 U.S.C. 145. Civil action to obtain patent.

An applicant dissatisfied with the decision of the Board of Patent Appeals and Interferences in an appeal under section 134(a) of this title may, unless appeal has been taken to the United States Court of Appeals for the Federal Circuit, have remedy by civil action against the Director in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Director appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Patent Appeals and Interferences, as the facts in the case may appear, and such adjudication shall authorize the Director to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant.

35 U.S.C. 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 Director 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 Director 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 Director 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 any *ex parte* reexamination proceeding filed under § 1.510, dissatisfied with the decision of the Board of Patent Appeals and Interferences, and any party to an interference dissatisfied with the decision of the Board of Patent Appeals and Interferences, may appeal to the U.S. Court of Appeals for the Federal Circuit. The appellant must take the following steps in such an appeal: In the U.S. Patent and Trademark Office, file a written notice of appeal directed to the Commissioner (see §§ 1.302 and 1.304); and in the Court, file a copy of the notice of appeal and pay the fee for appeal as provided by the rules of the Court. For *inter partes* reexamination proceedings filed under § 1.913, § 1.983 is controlling.

37 CFR 1.303. Civil action under 35 U.S.C. 145, 146, 306.

(a) Any applicant or any owner of a patent involved in an *ex parte* reexamination proceeding filed under §1.510 for a patent that issues from an original application filed in the United States before November 29, 1999, dissatisfied with the decision of the Board of Patent Appeals and Interferences, and any party to an interference dissatisfied with the decision of the Board of Patent Appeals and Interferences may, instead of appealing to the U.S. Court of Appeals for the Federal Circuit (§ 1.301), have remedy by civil action under 35 U.S.C. 145 or 146, as appropriate. Such civil action must be commenced within the time specified in § 1.304.

(b) If an applicant in an *ex parte* case or an owner of a patent involved in an *ex parte* reexamination proceeding filed under §1.510 for a patent that issues from an original application filed in the United States before November 29, 1999, has taken an appeal to the U.S. Court of Appeals for the Federal Circuit, he or she thereby waives his or her right to proceed under 35 U.S.C. 145.

(c) 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.

(d) For an *ex parte* reexamination proceeding filed under § 1.510 for a patent that issues from an original application filed in the United States on or after November 29, 1999, and for an *inter partes* reexamination proceeding filed under § 1.913, no remedy by civil action under 35 U.S.C. 145 is available.

37 CFR 1.304. Time for appeal or civil action.

(a)(1)The time for filing the notice of appeal to the U.S. Court of Appeals for the Federal Circuit (§ 1.302) or for commencing a civil action (§ 1.303) is two months from the date of the decision of the Board of Patent Appeals and Interferences. If a request for rehearing or reconsideration of the decision is filed within the time period provided under § 1.197(b), § 1.658(b), or § 1.979(a), 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:

(i) Fourteen days after service of the notice of appeal or the summons and complaint; or

(ii) Two months after the date of decision of the Board of Patent Appeals and Interferences, whichever is later.

(2) The time periods set forth in this section are not subject to the provisions of § 1.136, § 1.550(c), § 1.956, or § 1.645(a) or (b).

(3) The Commissioner may extend the time for filing an appeal or commencing a civil action:

(i) For good cause shown if requested in writing before the expiration of the period for filing an appeal or commencing a civil action, or

(ii) Upon written request after the expiration of the period for filing an appeal or commencing a civil action upon a showing that the failure to act was the result of excusable neglect.

(b) The times specified in this section in days are calendar days. The time specified herein in months are calendar months except that one day shall be added to any two-month period which includes February 28. If the last day of the time specified for appeal or commencing a civil action falls on a Saturday, Sunday or Federal holiday in the District of Columbia, the time is extended to the next day which is neither a Saturday, Sunday nor a Federal holiday.

(c) If a defeated party to an interference has taken an appeal to the U.S. Court of Appeals for the Federal Circuit and an adverse party has filed notice under 35 U.S.C. 141 electing to have all further proceedings conducted under 35 U.S.C. 146 (§ 1.303(c)), the time for filing a civil action thereafter is specified in 35 U.S.C. 141. The time for filing a cross-action expires 14 days after service of the summons and complaint.

JUDICIAL REVIEW OF PATENT APPLICATIONS

An applicant for a patent who is dissatisfied with a decision of the Board may seek judicial review either by an appeal to the U.S. Court of Appeals for the Federal Circuit (35 U.S.C. 141 and 37 CFR 1.301) or by a civil action in the U.S. District Court for the District of Columbia (35 U.S.C. 145 and 37 CFR 1.303(a)). By filing an appeal to the Federal Circuit, the applicant waives the right to seek judicial review by a civil action under 35 U.S.C. 145. See 35 U.S.C. 141 and 37 CFR 1.303(b).

JUDICIAL REVIEW OF *EX PARTE* REEXAMINATION PROCEEDINGS

A patent owner involved in an *ex parte* reexamination proceeding filed under 35 U.S.C. 302 for a patent that issued from an original application filed in the United States before November 29, 1999 (or from an international application designating the United States filed before November 29, 1999) 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 or by a civil action in the U.S. District Court for the District of Columbia.

Public Law 106-113, enacted on November 29, 1999, amended 35 U.S.C. 141 and 35 U.S.C 145 to read as they have been reproduced above. However, former versions of 35 U.S.C. 141 and 145 remain applicable in the case of an *ex parte* reexamination proceeding for a patent that issued from an original application filed before November 29, 1999. The former statutes provided for appeal to the Court of Appeals for the Federal Circuit (35 U.S.C. 141), or

alternatively, for a civil action against the Commissioner in the United States District Court for the District of Columbia (35 U.S.C. 145). Former 35 U.S.C. 141 further provided that by filing an appeal to the Court of Appeals for the Federal Circuit under 35 U.S.C. 141, a patent owner waived his her right to proceed to file a civil action under 35 U.S.C. 145. See 37 CFR 1.303(a)-(b).

The amended versions of 35 U.S.C. 141 and 145 that went into effect on November 29, 1999 provide that a patent owner may appeal only to the United States Court of Appeals for the Federal Circuit. Accordingly, a patent owner involved in the *ex parte* reexamination of a patent that issued from an original application filed in the United States on or after November 29, 1999 (or from an international application designating the United States filed on or after November 29, 1999) may seek judicial review only in the United States Court of Appeals for the Federal Circuit. See 37 CFR 1.303(d).

For judicial review of an *inter partes* reexamination proceeding, see 35 U.S.C. 315. Because *inter partes* reexamination procedures are found in Chapter 31 (and not in Chapter 30) of Title 35 of the United States Code, 35 U.S.C. 306 does not apply to an *inter partes* reexamination proceeding.

JUDICIAL REVIEW OF 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 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. See 35 U.S.C. 141; 37 CFR 1.303(c). If, within 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 2 months of the Board's decision. 37 CFR 1.304(a). However, if a request for rehearing or reconsideration of the Board's decision is filed within the time provided under 37 CFR 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 2 months after a decision on a request for rehearing or reconsideration (37 CFR 1.304(a)).

These 2-month periods meet the 60-day requirement of 35 U.S.C. 142, 145, and 146 except for time periods which include February 28. In order to comply with the 60-day requirement, 37 CFR 1.304(b) provides that an additional day shall be added to any 2-month period for initiating review which includes February 28. Appeals will always be timely if the judicial review is initiated within 2 months of the final decision.

The times specified in 37 CFR 1.304 are calendar days. If the last day of the time specified for appeal or commencing a civil action falls on a Saturday, Sunday, or a Federal holiday in the District of Columbia, the time is extended to the next day which is neither a Saturday, Sunday, nor a Federal holiday (37 CFR 1.304(b)).

TIME FOR FILING CROSS-APPEAL OR CROSS-ACTION

37 CFR 1.304(a) specifies that the time for filing a cross-appeal or a cross-action expires (A) 14 days after service of the notice of appeal or the summons and complaint or (B) 2 months after the decision to be reviewed, whichever is later.

37 CFR 1.304(a) provides that the time for filing a cross-action expires 14 days after service of the summons and complaint. The district court will determine whether any cross-action was timely filed since

neither the complaint nor cross-action is filed in the U.S. Patent and Trademark Office.

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 (A) for good cause if requested before the expiration of the time provided for initiating judicial review or (B) upon a showing of excusable neglect in failing to initiate judicial review if requested after the expiration of the time period. This standard is applicable once the "last" decision has been entered, i.e., either the decision (in circumstances where no timely rehearing or reconsideration is sought), the decision on rehearing of the Board in an *ex parte* appeal, or the decision on reconsideration of the Board in an interference. Extensions of time under 37 CFR 1.136(b) and 1.550(c) and fee extensions under 37 CFR 1.136(a) are not available to extend the time for the purpose of judicial review once a decision or a decision on rehearing or reconsideration has been entered. 37 CFR 1.304(a)(2) states that the provisions of 37 CFR 1.136 and 1.550(c) are not available to extend the time to initiate judicial review.

Requests for extension of time to seek judicial review under 37 CFR 1.304 should be addressed as follows:

Box 8
Commissioner of Patents and Trademarks
Washington, DC 20231
Attention: Office of The Solicitor

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 U.S. 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 U.S. 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 is ordered by the court. Service upon the attorney . . . shall be made by delivering a copy to the attorney or party or by mailing it to the attorney or party at the attorney's or party's last known address . . . .

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

Accordingly, all service copies of papers filed in court proceedings in which the 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:

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

(B) 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 U.S. 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 noncourt papers, i.e., papers which are intended to be filed in the U.S. Patent and Trademark Office in connection with an application or other proceeding pending in the U.S. Patent and Trademark Office. ANY NONCOURT PAPERS WHICH ARE MAILED TO THE ABOVE MAIL SERVICE ADDRESS WILL BE RETURNED TO THE SENDER. NO EXCEPTIONS WILL BE MADE TO THIS POLICY.

1216.01 Appeals to the Federal Circuit

35 U.S.C. 142. Notice of appeal.

When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the Patent and Trademark Office a written notice of appeal directed to the Director, within such time after the date of the decision from which the appeal is taken as the Director prescribes, but in no case less than 60 days after that date.

35 U.S.C. 143. Proceedings on appeal.

With respect to an appeal described in section 142 of this title, the Director shall transmit to the United States Court of Appeals for the Federal Circuit a certified list of the documents comprising the record in the Patent and Trademark Office. The court may request that the Director forward the original or certified copies of such documents during the pendency of the appeal. In any reexamination case, the Director shall submit to the court in writing the grounds for the decision of the Patent and Trademark Office, addressing all the issues involved in the appeal. The court shall, before hearing an appeal, give notice of the time and place of the hearing to the Director and the parties in the appeal.

35 U.S.C. 144. Decision on appeal.

The United States Court of Appeals for the Federal Circuit shall review the decision from which an appeal is taken on the record before the Patent and Trademark Office. Upon its determination the court shall issue to the Director its mandate and opinion, which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case.

37 CFR 1.302. Notice of appeal.

(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: (A) file in the U.S. Patent and Trademark Office a written notice of appeal (35 U.S.C. 142) directed to the Commissioner and (B) file with the Clerk of the Federal Circuit a copy of the notice of appeal and pay the docket fee for the appeal, as provided by Federal Circuit Rule 52. 37 CFR 1.301.

For a notice of appeal to be considered timely filed in the U.S. Patent and Trademark Office, it must: (A) actually reach the U.S. Patent and Trademark Office within the time specified in 37 CFR 1.304 (including any extensions) or (B) be mailed within the time specified in 37 CFR 1.304 (including any extensions) by "Express Mail" in accordance with 37 CFR 1.10.

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

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

Commissioner of Patents and Trademarks
Box 8
Washington, DC 20231
Attention: Office of the Solicitor

(B) By "Express Mail" (U.S. Postal Service only) under 37 CFR 1.10 addressed as follows, in which case the notice of appeal is deemed filed on the "date-in" on the "Express Mail" mailing label:

Commissioner of Patents and Trademarks
Box 8
Washington, DC 20231
Attention: Office of the Solicitor

(C) By hand to the Office of the Solicitor, 2121 Crystal Drive, Suite 714, Arlington, VA 22202.

A copy of the notice of appeal and the docket fee should be filed with the Clerk of the Federal Circuit, whose mailing and actual address is:

U.S. Court of Appeals for the Federal Circuit
717 Madison Place, N.W.
Washington, DC 20439

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

STANDARDS OF REVIEW BY THE FEDERAL CIRCUIT

In light of the Supreme Court decision in *Dickinson v. Zurko*, 527 U.S. 150, 50 USPQ2d 1930 (1999), holding that the Federal Circuit must apply one of the standards set forth in the Administrative Procedure Act ("APA"), the Federal Circuit adopted the "substantial evidence" standard for reviewing factfinding by the Board of Patent Appeals and Interferences. *In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000). The "substantial evidence" standard asks whether the agency action, findings, and conclusions were supported by substantial evidence, or, in other words, whether a reasonable factfinder could have arrived at the agency's decision. The Supreme Court has described "substantial evidence" as "more than a mere scintilla. It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion. . . . Mere uncorroborated hearsay or rumor does not constitute substantial evidence." *Consolidated Edison Co. v. NLRB,* 305 U.S. 197, 229-30 (1938)(citations omitted).

The Federal Circuit uses the *de novo* standard for reviewing questions of law. See e.g., *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1455 (Fed. Cir. 1998).

When the issue to be decided is a question of law based on underlying findings of fact (e.g., obviousness under 35 U.S.C. 103, enablement under 35 U.S.C. 112, first paragraph, or conception of an invention for purposes of 35 U.S.C. 102(g)), the Board's legal conclusion is reviewed without formal deference, while the subsidiary factual findings are reviewed for substantial evidence.

OFFICE PROCEDURE FOLLOWING DECISION BY THE FEDERAL CIRCUIT

After the Federal Circuit has heard and decided the appeal, an uncertified copy of the decision is sent to the U.S. Patent and Trademark Office and to the appellant and appellee (if any).

In due course, the Clerk of the Federal Circuit forwards to the U.S. Patent and Trademark Office a certified copy of the court's decision. This certified copy is known as the "mandate." The mandate is entered in the file of the application, reexamination or interference which was the subject of the appeal. The date of receipt of the mandate by the U.S. 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 U.S. Patent and Trademark Office will not give the public access to the administrative record of an involved application, or to the file of an interference, unless it is otherwise available to the public under 37 CFR 1.11. However, since the court record in a 35 U.S.C. 141 appeal generally includes a copy of at least part of the application, such may be inspected at the Federal Circuit. *In re Mosher*, 248 F.2d 956, 115 USPQ 140 (CCPA 1957).

In an *ex parte* appeal, after the mandate is entered in the application or reexamination file, the file is then returned to the appropriate U.S. Patent and Trademark Office official for further proceedings consistent with the mandate. See MPEP § 1214.06 for handling of claims dependent on rejected claims.

A. All Claims Rejected

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

B. Some Claims Allowed

Where the case includes one or more allowed claims, including claims allowed by the examiner prior to appeal and claims whose rejections were reversed by either the Board or the court, the proceedings are considered terminated only as to any claims which still stand rejected. It is not necessary for the

applicant or patent owner to cancel the rejected claims, since they may be canceled by the examiner in an examiner's amendment or by an appropriate notation in the margin of the claims, to avoid confusion to 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. The examiner should set forth the reasons for allowance, referring to and incorporating a copy of the appellate brief and the court decision. See MPEP § 1302.14.

If formal matters remain to be attended to, the examiner promptly should take appropriate action on such matters, such as by an examiner's amendment or by an Office action setting a 1-month (but not less than 30-day) shortened statutory period for reply. However, the application or reexamination proceeding is considered closed to further prosecution except as to such matters.

C. Remand

Where the decision of the court brings up for action on the merits claims which were not previously considered on the merits (such as a decision reversing a rejection of generic claims in an application containing claims to nonelected species), the examiner will take the case up for appropriate action on the matters thus brought up.

D. Reopening of Prosecution

In rare situations it may be necessary to reopen prosecution of an application after a decision by the Federal Circuit. Any Office action proposing to reopen prosecution after a decision by the Federal Circuit must be forwarded to the Office of the Deputy Commissioner for Patent Examination Policy for written approval, which will be indicated on the Office action.

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 the mandate. After dismissal, the action taken by the examiner will be the same as set forth above under the heading "Office Procedure Following Decision by the Federal Circuit."

In the event of a dismissal for a reason other than failure to prosecute the appeal, the status of the application, reexamination proceeding or interference must be determined according to the circumstances leading to the dismissal.

1216.02 Civil Suits Under 35 U.S.C. 145

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 Rule 4(i) of the Federal Rules of Civil Procedure. Regarding timely service, see *Walsdorf v. Comm'r*, 229 USPQ 559 (D.D.C. 1986) and *Hodge v. Rostker*, 501 F. Supp. 332 (D.D.C. 1980). When a 35 U.S.C. 145 civil action is filed, a notice thereof is placed in the application or reexamination file, which ordinarily will be kept in the Solicitor's Office pending termination of the civil action.

In an action under 35 U.S.C. 145, the plaintiff may introduce evidence not previously presented to the U.S. Patent and Trademark Office. However, plaintiff will be precluded from presenting new issues, at least in the absence of some reason of justice put forward for failure to present the issue to the U.S. Patent and Trademark Office. *DeSeversky v. Brenner*, 424 F.2d 857, 858, 164 USPQ 495, 496 (D.C. Cir. 1970); *MacKay v. Quigg*, 641 F. Supp. 567, 570, 231 USPQ 907, 908 (D.D.C. 1986). Furthermore, new evidence is not admissible in district court where it was available to the parties but was withheld from the U.S. Patent and Trademark Office as a result of fraud, bad faith, or gross negligence. *DeSeversky*, 424 F.2d at 858 n.5, 164 USPQ at 496 n.5; *California Research Corp. v. Ladd*, 356 F.2d 813, 821 n.18, 148 USPQ 404, 473 n.18 (D.C. Cir. 1966); *MacKay*, 641 F. Supp. at 570, 231 USPQ at 908; *Monsanto Company v. Kamp*, 269 F. Supp. 818, 822, 154 USPQ 259, 260 (D.D.C. 1967); *Killian v. Watson*, 121 USPQ 507, 507 (D.D.C. 1958).

Upon termination of the civil action, a statement of the court's final disposition of the case is placed in the application or reexamination file, which is then returned to the examiner for action in accordance with the same procedures as follow termination of a 35 U.S.C. 141 appeal. See MPEP § 1216.01. 37 CFR 1.197(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 U.S. Patent and Trademark Office after a decision, remand, or dismissal of the case by the district court are the same as the procedures followed with respect to 35 U.S.C. 141 appeals. See MPEP § 1216.01.

Where a civil action involving an application has been dismissed before coming to trial, the application will not be opened to the public unless it is otherwise available to the public under 37 CFR 1.11. However, the complaint and any other court papers not under a protective order are open to the public and may be inspected at the Office of the Clerk for the U.S. District Court for the District of Columbia, located in the U.S. Courthouse, 333 Constitution Avenue, N.W., Washington, DC 20001. The court papers in the Office of the Solicitor are not generally made available for public inspection.

Any subpoena by the district court for an application or reexamination file should be hand-carried to the Office of the Solicitor.