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Rules of Practice Before the Board of Patent Appeals and Interferences; Final Rule

DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Parts 1, 5, 10, 11, and 41

RIN 0651–AB32

Rules of Practice Before the Board of Patent Appeals and Interferences

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Final rule.

SUMMARY: The Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office consolidates and simplifies the rules governing practice before the Board of Patent Appeals and Interferences to reflect developments in case law, legislation, and administrative practice.

DATES: Effective date: September 13, 2004.

FOR FURTHER INFORMATION CONTACT: *Appeals:* Jeffrey V. Nase or William F. Smith, 703–308–9797.

Otherwise: Richard Torczon, 703–308–9797.

SUPPLEMENTARY INFORMATION:

Background

The Board of Patent Appeals and Interferences (Board) has significantly overhauled its operations to address concerns about the duration of proceedings before the Board. This final rule reflects these new procedures. A notice of proposed rule making on this topic was published in the **Federal Register** (68 FR 66648, Nov. 26, 2003) and in the Official Gazette of the United States Patent and Trademark Office (1277 OG 139, Dec. 23, 2003). Seventeen comments have been received in response to that notice.

Explanation of changes

In keeping with long-standing patent practice, rules in title 37, part 1, of the Code of Federal Regulations are denominated ''Rule x'' in this supplementary information.

Rules 1(a)(1)(iii), 5(e), and 8(a)(2)(i)(B), and subpart E of part 1, are removed to consolidate interference information in part 41, subparts D and E.

Rules 1(a)(1)(ii); 4(a)(2); 6(d)(9); 8(a)(2)(i)(C); 9(g); 11(e); 17(b); 36; 59(a)(1); 103(g); 112; 113(a); 114(d); 131(a)(1); 136(a)(1) and (a)(2); 181(a)(3); 191; 248(c); 292(a) and (c); 295(b); 302(b); 303(c); 304(a)(1) and (a)(2); 322(a)(3); 323; 324; 565(e); 701(c)(2)(ii); 703(a)(4), (b)(3)(ii), (b)(4), (d)(2), and (e); 704(c)(9); 959; and 993 are revised to change cross-references to Board proceedings.

Rules 17(b)–(d) and (h) are revised to remove the Board fees, which will be relocated to § 41.20.

Rules 48(a)–(c) and (i) are revised, and Rule 48(j) added, to consolidate the cross-reference correction of inventorship for applications in contested cases before the Board.

Rules 55(a)(3) and (a)(4), and 136(b) are revised to eliminate the cross-references to Board rules.

Rule 116 is amended to limit amendments after a final rejection or other final action (Rule 113) in an application or in an ex parte reexamination filed under Rule 510, or after an action closing prosecution (Rule 949) in an inter partes reexamination filed under Rule 913, to such amendments filed before or with any appeal to the Board under § 41.31 or § 41.61. Amendments after appeal currently treated under Rule 116 are moved to §§ 41.33 and 41.63. Pursuant to § 41.33(a), amendments filed after appeal and prior to the filing of the appeal brief will be treated under the same standard as Rule 116. The section title is revised to reflect the scope of the rule more accurately.

Rule 116(d) is amended to permit only an amendment canceling claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, to be made in an inter partes reexamination proceeding after the right of appeal notice has issued under Rule 953, except as provided in Rule 981 or as permitted by § 41.77(b)(1).

Rule 116(e) is added to set forth a standard for treatment of an affidavit or other evidence submitted after a final rejection or other final action (Rule 113) in an application or in an ex parte reexamination filed under Rule 510, or in an action closing prosecution (Rule 949) in an inter partes reexamination filed under Rule 913, but before or with any appeal (§ 41.31 or § 41.61). The standard would be that such an affidavit or other evidence could be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. This standard is currently in effect under Rule 195 for an affidavit or other evidence submitted after appeal.

Rule 116(f) is added to prohibit affidavits and other evidence in an inter partes reexamination proceeding after the right of appeal notice under Rule 953, except as provided in Rule 981 or as permitted by § 41.77(b)(1).

Rule 191 is amended to direct appellants under 35 U.S.C. 134(a) or (b) to part 41.

Rules 192–196 are removed and reserved.

Rule 197 is amended by changing its title to ''Return of jurisdiction from the Board of Patent Appeals and Interferences; termination of proceedings'' to reflect the two remaining paragraphs of this section. The subject matter of paragraph (b) is moved to § 41.52 and the subject matter of paragraph (c) is moved to paragraph (b) of Rule 197. Paragraph (a) is amended to return of jurisdiction of the involved application or patent under ex parte reexamination proceeding to the examiner. Rule 41(d)(2), Fed. R. App. Procedure, controls when the mandate of the Court of Appeals will issue in the event that a party filed a petition for writ of certiorari to the United States Supreme Court. Unless a party petitioning for a writ of certiorari seeks and obtains a stay of the appellate court's mandate, proceedings will be considered terminated with the issuance of the mandate, as noted in Rule 197(b)(2).

Rule 198 is amended by changing its title to ''Reopening after a final decision of the Board of Patent Appeals and Interferences'' to reflect the substance of the section and to clarify that it applies when a decision by the Board of Patent Appeals and Interferences on appeal has become final for judicial review.

Rule 324(a) and (c) are revised, and Rule 324(d) added, to consolidate cross-references to correction of inventorship for patents in contested cases before the Board.

Rule 959 is revised to direct inter partes reexamination participants to part 41 for information about appeals in such proceedings.

Rules 961–977 are removed to consolidate inter partes reexamination appeal information in part 41.

Rule 979 is amended by changing its title to ''Return of Jurisdiction from the Board of Patent Appeals and Interferences; termination of proceedings'' to reflect the two paragraphs of this section. Most of the subject matter of current paragraphs (a)–(g) is moved to §§ 41.79, 41.81 and 41.83. Paragraph (a) is amended to recite that jurisdiction over an inter partes reexamination proceeding passes to the examiner after a decision by the Board of Patent Appeals and Interferences upon transmittal of the file to the examiner, subject to each appellant's right of appeal or other review, for such further action as the condition of the inter partes reexamination proceeding may require, to carry into effect the

decision of the Board of Patent Appeals and Interferences. Paragraph (b) is amended to state that upon decision on the appeal before the Board of Patent Appeals and Interferences, if no further appeal has been taken (Rule 983), the inter partes reexamination proceeding will be terminated and the Director will issue a certificate under Rule 997.

Rule 981 is amended by changing its title to ''Reopening after a final decision of the Board of Patent Appeals and Interferences'' to better reflect the substance of the section and to clarify that it applies when a decision by the Board of Patent Appeals and Interferences on appeal has become final for judicial review.

Under 37 CFR 5.3, no interference will be declared with an application under a national secrecy order.

In the enrollment and discipline rules, 37 CFR 10.23(c)(7) and 11.6(d) are amended to change the cross-references to the interference rules.

A new part 41 consolidates rules relating to Board practice and simplifies reference to such practices. The Board will continue the practice used in part 1 of this title of citing sections without the part number. In proceedings before the Board, a party may cite ''§ 41.x'' as ''Board Rule x''.

Subpart A states policies, practices, and definitions common to all proceedings before the Board.

Section 41.1 sets forth general principles for part 41. Section 41.1(a) defines the scope of rules. Section 41.1(b) mandates that the Board's rules be construed to achieve just, speedy, and inexpensive resolutions of all Board proceedings, following the model of Rule 601 and Federal Rule of Civil Procedure 1. Section 41.1(c) explicitly extends the requirement for decorum under Rule 3 to Board proceedings, including dealings with opposing parties.

Section 41.2 sets forth definitions for Board proceedings under part 41. The preamble to § 41.2 is based on the preamble of Rule 601, which cautions that context may give a defined word a different meaning.

The definition of ''Board'' covers three distinct situations. First, for the purposes of a final agency action committed to a panel of Board members, the definition is identical in scope to 35 U.S.C. 6(b). Second, the definition includes action by the Chief Administrative Patent Judge in matters delegated in these rules to the Chief Administrative Patent Judge. Third, the definition recognizes that non-final actions are often performed by officials other than a panel or the Chief Administrative Patent Judge.

The definition of ''Board member'' follows the definition in 35 U.S.C. 6(a), under which the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, the Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the United States Patent and Trademark Office, the Commissioner for Patents, and the Commissioner for Trademarks are ex officio members of the Board.

The phrase ''contested case'' includes patent interferences (35 U.S.C. 135(a)) and proceedings with interference-based procedures (42 U.S.C. 2182 and 2457(d)).

The term ''final'' is defined pursuant to 5 U.S.C. 704 to assist parties in determining when a Board action is ripe for judicial review.

The definition of ''hearing'' reflects the holding of In re Bose Corp., 772 F.2d 866, 869, 227 USPQ 1, 4 (Fed. Cir. 1985) that a party is entitled to judicial consideration of properly raised issues, but is not entitled to an oral argument or consideration of improperly raised issues.

The definitions of ''panel'' and ''panel proceeding'' reflects the minimum quorum established in 35 U.S.C. 6(b), which reserves action on patentability and priority to panels. 35 U.S.C. 6(b).

The term ''party'' sets forth a generic term for entities acting in a Board proceeding.

The delegation of petition authority to the Chief Administrative Patent Judge in § 41.3(a) is new as a rule, but follows a delegation already published in the Manual of Patent Examining Procedure (MPEP) at § 1002.02(f).

Under § 41.3(b)(1) decisions committed by statute to the Board are not subject to petitions for supervisory review. Review of such decisions come through a request for rehearing or through judicial review. The provision in § 41.3(b)(2) for petitions in contested cases to be decided by other officials reflects the MPEP's designation of other actions typical in the ordinary course of Board proceedings as ''petitions''. See MPEP § 1002.02(g) (various procedural decisions in interferences).

Section 41.3(c) reflects current practice in requiring payment of a standard petition fee.

Section 41.3(d) reflects the current practice of not staying any action for a petition for supervisory review in Rule 181(f).

Section 41.3(e) sets times for filing petitions. As with Rule 181(f), failure to file a timely petition is sufficient basis for dismissing or denying a motion.

Section 41.4(a) and (b) follow the requirements of Rules 136(b) and 645 in providing rules for extensions of time and for acceptance of untimely papers. Section 41.4(c) points parties to timeliness rules that are related to Board proceedings, but not within the scope of the Board rules.

Section 41.5 provides a limited delegation to the Board under 35 U.S.C. 2(b)(2) and 32 to regulate the conduct of counsel in Board proceedings. Section 41.5(b) delegates to the Board the authority to conduct counsel disqualification proceedings while the Board has jurisdiction over a proceeding.

Section 41.6(a) relocates into part 41 the portions of Rule 14(e) that apply to the Board. Under § 41.6(a)(1) publicly available materials continue to be publicly available. Section 41.6(a)(2) sets forth the basis for making a determination under 35 U.S.C. 122(a) that special circumstances justify the publication of a Board action.

Section 41.6(b) generalizes to all Board proceedings the practice under Rule 11(e) of making the record of most interference proceedings publicly available eventually, although that availability might not occur until an involved patent application becomes available.

Section 41.7 recodifies the current practice of Rule 618 regarding duplicate papers and the expunging of papers, but generalizes it to all Board proceedings.

Section 41.8(a) reflects the practice under Rules 192(c)(1) and 602 regarding disclosure of the real parties-in-interest. Section 41.8(b) requires parties to provide notice of related proceedings.

Section 41.9 follows Rule 643 regarding action by an assignee to the exclusion of an inventor, but generalizes it to all Board proceedings.

Section 41.10 adds correspondence addresses for Board proceedings.

Section 41.11 codifies existing interference practice prohibiting ex parte communications about a contested case with an official actually conducting the proceeding, but generalizes the practice to include inter partes reexamination appeals as well.

Section 41.12 codifies existing interference practice regarding the citation of authority but generalizes the practice to all Board proceedings.

Section 41.20 consolidates the rules on fees associated with Board practice. Rules 22, 23, and 25–28, which govern fee practice before the Office generally, continue to apply in Board proceedings. Section 41.20(a) sets forth the petition fee, while paragraph (b) sets forth appeals-related fees.

Subpart B is added to set forth rules for the ex parte appeal under 35 U.S.C. 134 of a rejection in either a national

application for a patent, an application for reissue of a patent, or an ex parte reexamination proceeding to the Board.

Section 41.30 sets forth definitions for Board proceedings under subpart B of part 41. The preamble to § 41.30 is based on a similar provision in the preamble of former Rule 601. The term ''proceeding'' sets forth a generic term for a national application for a patent, an application for reissue of a patent, and an ex parte reexamination proceeding. The term ''applicant'' sets forth a generic term for either the applicant in a national application for a patent or the applicant in an application for reissue of a patent. The term ''owner'' sets forth a shorthand reference to the owner of the patent undergoing ex parte reexamination under Rule 510.

Section 41.31 is added to generally incorporate the requirements of former Rule 191(a)–(d). Paragraph (a) is subdivided into three parts to improve readability. Paragraph (d) is amended to refer only to the time periods referred to in paragraphs (a)(1)–(a)(3) of this section, while the current extension of time requirements for Rules 192, 193, 194, 196 and 197, formerly provided in Rule 191(e), is relocated to §§ 41.37, 41.41, 41.47, 41.50 and 41.52.

Section 41.33 is added to replace the requirements of former Rules 116 and 195. Paragraph (a) provides that amendments filed after the date of filing an appeal pursuant to § 41.31(a)(1)–(a)(3) and prior to the date a brief is filed pursuant to § 41.37 may be admitted as provided in § 1.116. Thus, amendments after final but prior to appeal and amendments filed after appeal but prior to the date the brief is filed will be treated under the same standard (i.e, § 1.116). Paragraph (b) provides that amendments filed on or after the date of filing a brief pursuant to § 41.37 may be admitted: (1) to cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, or (2) to rewrite dependent claims into independent form. A dependent claim is rewritten into independent form by including all of the limitations of the base claim and any intervening claims. Thus, no limitation of a dependent claim can be excluded in rewriting that claim into independent form. Paragraph (c) provides that all other amendments filed after the date of filing an appeal pursuant to § 41.31(a)(1)–(a)(3) will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i), 41.50(b)(1) and 41.50(c). Paragraph (d)(1) provides that affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1)–(a)(3) and prior to the date of filing a brief pursuant to § 41.37 may be admitted if the examiner determines that the affidavits or other evidence overcomes all rejections under appeal and that there is a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. Paragraph (d)(2) provides that all other affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1)–(a)(3) will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i) and 41.50(b)(1). Paragraph (d) replaces the former practice of permitting such evidence based on a showing of good and sufficient reasons why such evidence was not earlier presented set forth in former Rule 195. The Office believes that prosecution should occur before the examiner prior to an appeal being filed, not after the case has been appealed pursuant to § 41.31(a)(1)–(a)(3).

Section 41.35 is added to generally incorporate the requirements of former Rule 191(e). In addition, this section makes clear that jurisdiction over an application may be relinquished by the Board and the application returned to the examining operation to permit processing to be completed by the examining operation before the Board takes up the appeal for decision. This is consistent with the present practice of returning an appealed application to the examining operation where some matter requiring attention has been identified prior to assignment of the appeal number and docketing of the appeal. In addition, the Board is permitted to take other appropriate action to complete the file.

Section 41.37 is added to generally incorporate the requirements of former Rule 192. In addition, the following changes have been made:

(1) The title of the section has been changed from ''Appellant's brief'' to ''Appeal brief''.

(2) In paragraph (a), one copy of the brief is required rather than three copies consistent with the Office's move to an electronic file wrapper.

(3) In paragraph (a), the brief is required to be filed within two months from the date of the notice of appeal under § 41.31 even if the time allowed for reply to the action from which the appeal was taken is later, which overall simplifies docketing of the due date.

(4) In paragraph (c)(1)(i), a statement is required in the brief identifying by name the real party in interest even if the party named in the caption of the brief is the real party in interest. This provides appellant the necessary mechanism for complying with § 41.8(a) in an appeal to the Board.

(5) In paragraph (c)(1)(ii), identification is required of all other prior and pending appeals, interferences or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal, as well as to set forth a mechanism for complying with § 41.8(b) in an appeal to the Board.

(6) In paragraph (c)(1)(iii), both a statement of the status of all the claims in the proceeding (*e.g.*, rejected, allowed or confirmed, withdrawn, objected to, canceled) and an identification of those claims that are being appealed is required.

(7) In paragraph (c)(1)(v), a concise explanation of the invention is required for each of the independent claims involved in the appeal, which explanation shall refer to the specification by page and line number, and to the drawings, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. The former requirement of Rule 192(c)(5) to set forth a concise explanation of the invention defined in the claims involved in the appeal by reference to the specification by page and line number, and to the drawings, if any, by reference characters was not being followed in a great number of briefs before the Board.

(8) In paragraph (c)(1)(vi), a concise statement listing each ground of rejection presented for review is required rather than issues for review. An example of a concise statement is ''Claims 1 to 10 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. X.''

(9) The grouping of claims requirement set forth in former Rule 192(c)(7) is removed. The general purpose served by former Rule 192(c)(7) is addressed in § 41.37(c)(1)(viii). The existing grouping of claims requirement has led to many problems such as (i) Grouping of claims across multiple rejections (*e.g.*, claims 1–9 rejected under 35 U.S.C. 102 over A while claims 10–15 are rejected under 35 U.S.C. 103 over A and the appellant

states that claims 1–15 are grouped together); (ii) Claims being grouped together but argued separately (*e.g.*, claims 1–9 rejected under 35 U.S.C. § 102 over A, the appellant groups claims 1–9 together but then argues the patentability of claims 1 and 5 separately); and (iii) examiners disagreeing with the appellant's grouping of claims.

(10) In paragraph (c)(1)(vii), any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown (requirement found in former Rule 192(a)), and a separate heading is required for each ground of rejection in place of the previous grouping of claims section of the brief. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When an appellant argues as a group multiple claims subject to the same ground of rejection, the Board may select a single claim from that group of claims and treat its disposition of a ground of rejection of that claim as applying to the disposition of that ground of rejection of all claims in the group of claims. Notwithstanding any other provision of this paragraph, an appellant's failure to argue separately claims that the appellant has grouped together constitutes a waiver of any argument that the Board must consider the patentability of any grouped claim separately. *See In re McDaniel*, 293 F.3d 1379, 1384, 63 USPQ2d 1462, 1465–66 (Fed. Cir. 2002) (interpreting former Rule 192(c)(7) to require separate treatment of separately rejected claims). Any claim argued separately should be placed under a subheading identifying the claim by number and claims argued as a group should be placed under a subheading identifying the claims by number. For example, if Claims 1 to 5 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. Y and appellant is only going to argue the limitations of independent claim 1, and thereby group dependent claims 2 to 5 to stand or fall with independent claim 1, then one possible heading as required by this subsection could be *Rejection under 35 U.S.C. 102(b) over U.S. Patent No. Y* and the optional subheading would be Claims 1 to 5. As another example, where claims 1 to 3 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. Z and the appellant wishes to argue separately the patentability of each claim, a possible heading as required by this subsection could be *Rejection under 35 U.S.C. 102(b) over U.S. Patent No. Z*, and the optional subheadings would be *Claim 1, Claim 2,* and *Claim 3.* Under each subheading the appellant would present the argument for patentability of that claim.

(11) Paragraph (c)(1)(vii) states that ''Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable'', a statement in slightly different form appeared in former Rule 192(c)(7).

(12) Paragraph (c)(1)(vii) eliminates subparagraphs (i) through (v) of former Rule 192(c)(8) which related to the manner in which arguments were to be made. Although they provided useful advice as to what an effective argument ought to include, these provisions have often been ignored by appellants and, for the most part, have not been enforced as set forth in paragraph (d) of that rule.

(13) Paragraph (c)(1)(ix) is added to require appellant to include an evidence appendix of any evidence relied upon by appellant in the appeal with a statement setting forth where that evidence was entered in the record by the examiner so that the Board will be able to easily reference such evidence during consideration of the appeal.

(14) Paragraph (c)(1)(x) is added to require appellant to include a related proceedings appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section so that the Board can take into consideration such decisions.

(15) Paragraph (c)(2) is added to exclude any new or non-admitted amendment, affidavit or other evidence from being included in the brief.

(16) Paragraph (d) is added to provide that appellants will be notified of reasons for non-compliance and given a period of time to file an amended brief.

(17) Paragraph (e) is added to provide notice that the periods set forth in this section are extendable under the provisions of Rule 136 for patent applications and Rule 550(c) for ex parte reexamination proceedings. This provision appeared in former Rule 191(d).

Section 41.39 is added to generally incorporate requirements found in former Rule 193(a).

Section 41.39(a)(2) is added to permit a new ground of rejection to be included in an examiner's answer eliminating the former prohibition of new grounds of rejection in examiner's answers. Many appellants are making new arguments for the first time in their appeal brief (apparently stimulated by a former change to the appeal process that inserted the prohibition on new grounds of rejection in the examiner's answer). Because the current appeal rules only allow the examiner to make a new ground by reopening prosecution, some examiners have allowed cases to go forward to the Board without addressing the new arguments. Thus, the revision would improve the quality of examiner's answers and reduce pendency by providing for the inclusion of the new ground of rejection in an examiner's answer without having to reopen prosecution. By permitting examiners to include a new ground of rejection in an examiner's answer, newly presented arguments can now be addressed by a new ground of rejection in the examiner's answer when appropriate. Furthermore, if new arguments can now be addressed by the examiner by incorporating a new ground of rejection in the examiner's answer, the new arguments may be able to be addressed without reopening prosecution and thereby decreasing pendency.

It is envisioned that new grounds of rejection in examiner's answers would be rare, rather than a routine occurrence. The Office plans to issue instructions that will be incorporated into the MPEP requiring that any new ground of rejection made by an examiner in an answer must be personally approved by a Technology Center Director or designee and that any new ground of rejection made in an answer be prominently identified as such. It is the further intent of the Office to provide guidance to examiners that will also be incorporated into the MPEP as to what circumstances, *e.g.*, responding to a new argument or new evidence submitted prior to appeal, would be appropriate for entry of a new ground of rejection in an examiner's answer rather than the reopening of prosecution. Where, for example, a new argument(s) or new evidence cannot be addressed by the examiner based on the information then of record, the examiner may need to reopen prosecution rather than apply a new ground of rejection in an examiner's answer to address the new argument(s) or new evidence.

Paragraph (b) of § 41.39 is added to set forth the responses an appellant may make when an examiner's answer sets forth a new ground of rejection. Appellant is required within two months from the date of the examiner's answer containing a new ground of rejection either:

(1) To request that prosecution be reopened by filing a reply under Rule 111 with or without amendment or submission of affidavits (Rules 130, 131 or 132) or other evidence, which would

result in prosecution being reopened before the examiner, or

(2) To file a reply brief under § 41.41, which would act as a request that the appeal be maintained. Such a reply brief could not be accompanied by any amendment, affidavit (Rules 130, 131, or 132) or other evidence. If such a reply brief were accompanied by any amendment or evidence, it would be treated as a request that prosecution be reopened before the examiner under paragraph (b)(1) of this section. Any reply brief would have to specify the error in each new ground of rejection as set forth in § 41.37(c)(1)(viii) and should generally follow the other requirements of a brief set forth in § 41.37(c).

If in response to the examiner's answer containing a new ground of rejection, appellant decides to reopen prosecution of the application before the examiner, the Office will treat the decision to reopen prosecution also as a request to withdraw the appeal. If appellant fails to exercise one of the two options within two months from the date of the examiner's answer, the appeal will be sua sponte dismissed (*i.e.*, terminated) as to the claims subject to the new ground of rejection.

Paragraph (c) of § 41.39 is added to provide notice that the period set forth in paragraph (b) of this section is extendable under the provisions of Rule 136(b) for patent applications and Rule 550(c) for ex parte reexamination proceedings. This provision appeared in former Rule 191(d).

Section 41.41 is added to generally incorporate requirements found in former Rule 193(b). In addition:

(1) Paragraph (a)(2) is added to make explicit that a reply brief cannot include any new or non-admitted amendment, affidavit or other evidence.

(2) Paragraph (b) is added to make clear that a reply brief not in compliance with paragraph (a) would not be considered. The examiner would notify the appellant in this event.

(3) Paragraph (c) is added to provide notice that the period set forth in this section would be extendable under the provisions of Rule 136(b) for patent applications and Rule 550(c) for ex parte reexamination proceedings. This provision appeared in former Rule 191(d).

Section 41.43 is added to permit the examiner to furnish a supplemental examiner's answer to respond to any new issue raised in the reply brief. This would dispense with the need for the Board to remand the proceeding to the examiner to treat any new issue raised in the reply brief. The MPEP will provide that each supplemental examiner's answer must be approved by a Technology Center Director or designee. A supplemental examiner's answer may not include a new ground of rejection. If a supplemental examiner's answer is furnished by the examiner, the appellant is permitted to file another reply brief under § 41.41 within two months from the date of the supplemental examiner's answer.

The former prohibition against a supplemental examiner's answer in other than a remand situation is removed to permit use of supplemental examiner's answers where the examiner is responding only to new issues raised in the reply brief. As a consequence, the requirements pertaining to appellants when prosecution is reopened under former Rule 193(b)(2) are removed.

Section 41.43(a)(1) permits the examiner to furnish a supplemental examiner's answer to respond to any new issue raised in a reply brief. It should be noted that an indication of a change in status of claims (*e.g.*, that certain rejections have been withdrawn as a result of a reply brief) is not a supplemental examiner's answer and therefore would not give appellant the right to file a reply brief. Such an indication of a change in status may be made on form PTOL–90. The Office will develop examples to help the examiner determine what would or would not be considered a new issue warranting a supplemental examiner's answer. An appellant who disagrees with an examiner's decision that a supplemental examiner's answer is permitted under this rule may petition for review of the decision under Rule 181. Examples of new issues raised in a reply brief include the following:

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

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

Paragraph (a)(1) of § 41.43 also sets forth the ability of the examiner to withdraw the final rejection and reopen prosecution as an alternative to the use of a supplemental examiner's answer. The primary examiner's decision to withdraw the final rejection and reopen prosecution to enter a new ground of rejection requires approval from the supervisory patent examiner as currently set forth in MPEP 1208.02.

Paragraph (b) of § 41.43 permits appellant to file a supplemental reply brief in response to a supplemental examiner's answer within two months from the date of the supplemental examiner's answer. That two-month time period may be extended under the provisions of Rule 136(b) for patent applications and Rule 550(c) for ex parte reexamination proceedings as set forth in § 41.43(c).

Section 41.47 is added to generally incorporate the requirements of former Rule 194. In addition:

(1) Paragraph (b) requires the separate paper requesting the oral hearing to be captioned ''REQUEST FOR ORAL HEARING'' and sets forth that such a request can be filed within two months from the date of the examiner's answer or supplemental examiner's answer.

(2) Paragraph (d) is added to set forth the procedure for handling the request for oral hearing when an appellant has complied with all the requirements of paragraph (b) of this section. Since notice to the primary examiner is a matter internal to the Office, the requirement for notice to the primary examiner has been removed from the rule. It is anticipated that the primary examiner will be sent notice of the hearing time and date by e-mail.

(3) Paragraph (e)(1) is added to specifically provide that at the oral hearing (i) appellant may only rely on evidence that has been previously considered by the primary examiner and present argument that has been relied upon in the brief or reply brief except as permitted by paragraph (e)(2) of this section; (ii) the primary examiner may only rely on argument and evidence raised in the answer or a supplemental answer except as permitted by paragraph (e)(2) of this section; and (iii) that appellant opens and concludes the argument (*i.e.*, the order of the argument at the hearing is: Appellant opens, then the primary examiner argues, then the appellant concludes presuming that appellant has reserved some time for a concluding argument).

(4) Paragraph (e)(2) is added to specifically provide that upon a showing of good cause, appellant and/or the primary examiner may rely on a new argument based upon a recent relevant decision of either the Board or a Federal Court.

(5) Paragraph (f) is added to incorporate the substance found in former Rule 194. Exemplary situations where the Board may decide no hearing is necessary include those where the Board has become convinced, prior to hearing, that an application must be

remanded for further consideration prior to evaluating the merits of the appeal or that the examiner's position cannot be sustained in any event.

(6) Paragraph (g) is added to provide notice that the periods set forth in this section are extendable under the provisions of Rule 136(b) for patent applications and Rule 550(c) for ex parte reexamination proceedings. This provision appeared in former Rule 191(d).

Section 41.50 is added to generally incorporate the requirements of former Rule 196. In addition:

(1) Paragraph (a)(1) explicitly provides that the Board, in its principal role under 35 U.S.C. 6(b) of reviewing adverse decisions of examiners, may in its decision affirm or reverse the decision of the examiner in whole or in part on the grounds and on the claims specified by the examiner. The affirmance of the rejection of a claim on any of the grounds specified constitutes a general affirmance of the decision of the examiner on that claim, except as to any ground specifically reversed. The Board may also remand an application to the examiner.

(2) Paragraph (a)(2) is added to require appellant to respond to any supplemental examiner's answer issued in response to a remand from the Board to the examiner for further consideration of a rejection to avoid sua sponte dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding. Appellant must exercise one of the following two options to avoid such sua sponte dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding: (i) Request that prosecution be reopened before the examiner by filing a reply under Rule 111 with or without amendment or submission of affidavits (Rules 130, 131 or 132) or other evidence, or (ii) request that the appeal be maintained by filing a reply brief as provided in § 41.41. If such a reply brief is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the examiner under § 41.50(a)(2)(i). Any request that prosecution be reopened under this paragraph would be treated as a request to withdraw the appeal.

(3) Paragraph (b)(2) eliminates the provision relating to requests that the application or patent under ex parte reexamination be reheard, since that provision is included in § 41.52(a).

(4) Paragraph (c) provides that the opinion of the Board may include an explicit statement how a claim on appeal could be amended to overcome a specific rejection and that when the opinion of the Board included such a statement, appellant would have the right to amend in conformity therewith. Such an amendment in conformity with such statement would overcome the specific rejection, but an examiner could still reject a claim so-amended, provided that the rejection constituted a new ground of rejection.

(5) Paragraph (d) provides that appellant's failure to timely respond to an order of the Board of Patent Appeals and Interferences could result in the dismissal of the appeal.

(6) Paragraph (f) is added to provide notice that the periods set forth in this section are extendable under the provisions of Rule 136(b) for patent applications and Rule 550(c) for ex parte reexamination proceedings. This provision appeared in former Rule 191(d).

Section 41.52 is added to generally incorporate the requirements of former Rule 197(b). In addition, paragraph (a)(1) incorporates the matter from former Rule 196(b)(2) relating to the request that the application or patent under ex parte reexamination be reheard. Arguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) and (a)(3) of this section. In addition, the rule would permit the Board to simply deny a request for rehearing in appropriate cases rather than rendering a new opinion and decision on the request for rehearing. Paragraph (a)(2) provides that upon a showing of good cause, appellant may present a new argument based upon a recent relevant decision of either the Board or a Federal Court. Paragraph (a)(3) provides that new arguments responding to a new ground of rejection made pursuant to § 41.50(b) are permitted. Paragraph (b) is added to provide notice that the period set forth in this section is extendable under the provisions of Rule 136(b) for patent applications and Rule 550(c) for ex parte reexamination proceedings. This provision appeared in former Rule 191(d).

Section 41.54 is added to generally incorporate the requirements of former Rule 197(a).

Subpart C is added to provide rules for the inter partes appeal under 35 U.S.C. 315 of a rejection in an inter partes reexamination proceeding to the Board. This subpart does not apply to any other Board proceeding and is strictly limited to appeals in inter partes reexamination proceedings filed under 35 U.S.C. 311.

Section 41.60 sets forth definitions for Board proceedings under subpart C of part 41. The preamble to § 41.60 is based on a similar provision in the preamble of former Rule 601. The term ''proceeding'' provides a shorthand reference to an inter partes reexamination proceeding. The term ''owner'' provides a shorthand reference to the owner of the patent undergoing inter partes reexamination under Rule 915. The term ''requester'' provides a generic term to describe each party other than the owner who requested that the patent undergo inter partes reexamination under Rule 915. The term ''appellant'' provides a generic term for any party, whether the owner or a requester, filing a notice of appeal or cross appeal under § 41.61. If more than one party appeals or cross appeals, each appealing or cross appealing party is an appellant with respect to the claims to which his or her appeal or cross appeal is directed. The term ''respondent'' provides a generic term for any requester responding under § 41.68 to the appellant's brief of the owner, or the owner responding under § 41.68 to the appellant's brief of any requester. No requester may be a respondent to the appellant brief of any other requester. The terms ''appellant'' and ''respondent'' were defined in former Rule 962. The definition of the term ''filing'' provides a generic requirement that any document filed in the proceeding by any party must include a certificate indicating service of the document to all other parties to the proceeding as required by Rule 903.

Section 41.61 is added to generally incorporate the requirements of former Rule 959.

Sections 41.63(a) and (b) are added to replace the requirements of former Rule 116 with a prohibition of amendments submitted after the date the proceeding has been appealed pursuant to § 41.61, except for amendments permitted by § 41.77(b)(1) and amendments canceling claims where such cancellation does not affect the scope of any other pending claim in the proceeding. Section 41.63(c) replaces the requirements of former Rule 975 with a prohibition on the admission of affidavits and other evidence submitted after the case has been appealed pursuant to § 41.61 except as permitted by § 41.77(b)(1). This replaces the current practice of permitting such evidence based on a showing of good and sufficient reasons why such evidence was not earlier presented. The Office believes that prosecution of an application should occur before the examiner prior to an appeal being filed, not after the case has been appealed pursuant to § 41.61.

Section 41.64 is added to generally incorporate the requirements of former Rule 961, but would make clear that jurisdiction over a proceeding may be relinquished and the proceeding returned to the examining operation to permit processing to be completed before the Board takes up the appeal for decision.

Section 41.66 is added to generally incorporate the requirements of former Rule 963.

Section 41.67 is added to generally incorporate the requirements of former Rule 965. In addition:

(1) In paragraph (a), one copy of the brief is required rather than three copies consistent with the Office's move to an electronic file wrapper.

(2) In paragraph (c)(1)(i), a statement in the brief is required identifying by name the real party in interest even if the party named in the caption of the brief is the real party in interest. This provides appellant the necessary mechanism of complying with § 41.8(a) in an appeal to the Board;

(3) In paragraph (c)(1)(ii), clear identification is required of all other prior and pending appeals, interferences or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal, as well as to provide a mechanism of complying with § 41.8(b) in an appeal to the Board.

(4) In paragraph (c)(1)(iii), both a statement of the status of all the claims in the proceeding (*e.g.*, rejected, allowed or confirmed, withdrawn, objected to, canceled) and an identification of those claims that are being appealed is required.

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

(6) In paragraph (c)(1)(vi), a concise statement is required listing each issue presented for review. An example of a concise statement is claims 1 to 10 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. X.

(7) The grouping of claims requirement set forth in former Rule 965(c)(7) is removed. The general purpose served by former Rule 965(c)(7) is addressed in § 41.67(c)(1)(viii). The existing grouping of claims requirement has led to many problems as set forth above in the discussion of § 41.37.

(8) In paragraph (c)(1)(vii), any arguments or authorities not included in a brief permitted in this section or filed pursuant to §§ 41.68 and 41.71 will be refused consideration by the Board, unless good cause is shown, and a separate heading is required for each ground of rejection in place of the previous grouping of claims section of the brief. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When an appellant argues as a group multiple claims subject to the same ground of rejection, the Board may select a single claim from that group of claims and treat its disposition of a ground of rejection of that claim as applying to the disposition of that ground of rejection of all claims in the group of claims. Notwithstanding any other provision of this paragraph, an appellant's failure to argue separately claims that appellant has grouped together would constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. *See In re McDaniel,* 293 F.3d 1379, 1384, 63 USPQ2d 1462, 1465–66 (Fed. Cir. 2002) (interpreting analogous former Rule 192(c)(7) to require separate treatment of separately rejected claims). Any claim argued separately should be placed under a subheading identifying the claim by number and that claims argued as a group should be placed under a subheading identifying the claims by number.

(9) Paragraph (c)(1)(vii) states that ''Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.'' This statement in slightly different form appeared in former Rule 965(c)(7).

(10) Paragraph (c)(1)(vii) eliminates subparagraphs (i) through (v) of former Rule 965(c)(8) which related to the manner in which arguments were to be made. Although providing useful advice as to what an effective argument ought to include, these provisions have often been ignored by appellants and, for the most part, have not been enforced as provided in former Rule 965(d).

(11) Paragraph (c)(1)(ix) is added to require appellant to include an evidence appendix of any evidence relied upon by appellant in the appeal with a statement setting forth where that evidence was entered in the record by the examiner so that the Board would be able to reference such evidence easily during their consideration of the appeal.

(12) Paragraph (c)(1)(x) is added to require appellant to include a related proceedings appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to § 41.67(c)(1)(ii) so that the Board can take into consideration such decisions.

(13) Paragraph (c)(2) is added to exclude any new or non-admitted amendment, affidavit or other evidence from being included in an appellant's brief.

Section 41.68 is added to generally incorporate requirements found in former Rule 967 and changes similar to those in § 41.67. In addition, paragraph (b)(2) excludes any new or non-admitted amendment, affidavit or other evidence from being included in a respondent's brief.

Section 41.69 is added to generally incorporate requirements found in former Rule 969.

Section 41.71 is added to generally incorporate requirements found in former Rule 971.

Section 41.73 is added to generally incorporate the requirements of former Rule 973. In addition:

(1) Paragraph (b) requires the separate paper requesting the oral hearing to be captioned ''REQUEST FOR ORAL HEARING'' and that such a request can be filed within two months from the date of the examiner's answer.

(2) Paragraph (d) is added to provide the procedure for handling the request for oral hearing in which a party has complied with all the requirements of paragraph (b) of this section. Since notice to the primary examiner is a matter internal to the Office, the requirement for notice to the primary examiner has been removed from the rule. It is anticipated that the primary examiner will be sent notice of the hearing time and date by e-mail.

(3) Paragraph (e)(1) is added to specifically provide that at the oral hearing (i) parties may only rely on evidence that has been previously considered by the primary examiner and present argument that has been relied upon in the briefs except as permitted by paragraph (e)(2) of this section; (ii) the primary examiner may only rely on argument and evidence relied upon in the answer except as permitted by paragraph (e)(2) of this section; and (iii)

that the Board will determine the order of the arguments presented at the oral hearing.

(4) Paragraph (e)(2) is added to specifically provide that upon a showing of good cause, appellant, respondent and/or the primary examiner may rely on a new argument based upon a recent relevant decision of either the Board or a Federal Court.

(5) Paragraph (f) is added to incorporate the substance found in former Rule 194. Exemplary situations where the Board might decide no hearing is necessary include those where the Board has become convinced, prior to hearing, that the proceeding must be remanded for further consideration prior to evaluating the merits of the appeal.

Section 41.77 is added to generally incorporate the requirements of former Rule 977.

Section 41.79 is added to generally incorporate the requirements of former Rule 979 concerning rehearing before the Board. Paragraph (b) generally incorporates the requirements of former Rule 979(d). Arguments not raised in the briefs before the Board and evidence not previously relied upon in the briefs are not permitted in the request for rehearing except as permitted by paragraphs (b)(2) and (b)(3) of this section. Paragraph (b)(2) provides that upon a showing of good cause, appellant and/or respondent may present a new argument based upon a recent relevant decision of either the Board or a Federal Court. Paragraph (b)(3) provides that new arguments responding to a new ground of rejection made pursuant to § 41.77(b) are permitted. Paragraph (c) generally incorporates the requirements of former Rule 979(b). Paragraph (d) generally incorporates the requirements of former Rule 979(c). Paragraph (e) generally incorporates the requirements of former Rule 979(g).

Section 41.81 is added to generally incorporate the requirements of former Rule 979(e).

Subpart D provides rules for contested cases before the Board. Contested cases are predominantly patent interferences under 35 U.S.C. 135(a), but also include United States Government ownership contests under 42 U.S.C. 2182(3) and 2457(d).

Section 41.100 defines two terms. The term ''business day'' is defined in a manner consistent with 35 U.S.C. 21(b) to exclude Saturday, Sunday, and Federal holidays, when the closure of the Board may affect the Board's, or a party's, ability to perform an action.

The term ''involved'' appears in 35 U.S.C. 135(a) with respect to claims and is implicitly defined in Rule 601(f) (for claims) and in Rule 601(l) (for applications), but is not explicitly defined in the current rules. The rule expressly defines ''involved'' as designating any patent application, patent, or claim that is the subject of the contested case.

Section 41.101 follows the practice in Rule 611(a) and (b) for notifying parties of a contested case. As a courtesy, the Board will make reasonable efforts to provide notice to all parties. Failure to maintain a current correspondence address may result in adverse consequences.

Section 41.102 requires completion of examination for most applications (and of reexamination for most patents) before the Board will institute a contested case.

Section 41.103 follows the file jurisdiction practice in Rules 614 and 615 except to generalize the temporary transfer of jurisdiction to include parts of the Office other than the examining corps, including, for example, the Office of Public Records. Such transfers of jurisdiction will generally be for short periods and for limited purposes.

Section 41.104(a) follows the practice of Rule 610(e), which permits an administrative patent judge wide latitude in administering interferences. The decision to waive a procedural requirement is committed to the discretion of the administrative patent judge.

Section 41.104(c) clarifies that any default times set by rule may be changed by order. ''Times'' in paragraph (c) includes both dates and durations.

Section 41.106 provides guidance for the filing and service of papers. Under § 41.106(a), papers to be filed are required to meet standards very similar to those required in patent prosecution, Rule 52(a), and in filings in the Court of Appeals for the Federal Circuit, Fed. R. App. P. 32. Section 41.106(a)(1) would permit a party to file papers in either A4 format or 8½-inch × 11-inch format, but not to alternate between formats. At present, the Board prefers papers to be filed in 8½-inch × 11-inch format because the present filing system is best adapted to this paper format.

Section 41.106(b) provides guidance specific to papers other than exhibits. Section 41.106(b)(1) codifies current practices for the cover sheet of a paper. Section 41.106(b)(2) requires holes at the top of the paper consistent with Local Civil Rule 5.1(f) (1999) of the United States District Court for the District of Columbia to facilitate entry of the paper in the administrative record. The bar in § 41.106(b)(3) against incorporation by reference and combination of papers minimizes the chance that an argument will be overlooked and reduces abuses that arise from incorporation and combination.

Section 41.106(c) requires the filing of a working copy for the Board official administering the proceeding.

Section 41.106(d) provides additional guidance for special modes of filing. Section 41.106(d)(1) encourages the use of the EXPRESS MAIL® service of the United States Postal Service. Section 41.106(d)(2) permits other modes of filing.

Section 41.106(e)(1) requires papers to be served when they are filed if they have not already been served. Section 41.106(e)(3) provides for expedited service.

Section 41.106(f) provides rules for certificates of service. Section 41.106(f)(1) requires the certificate to be incorporated into each paper other than exhibits. When the exhibits are filed at the same time, the certificate may be incorporated into the exhibit list. See § 41.154(d).

Section 41.108 requires each party to identify its counsel, if any. The rule also follows Rule 613(a), which permitted the Board to require the appointment of a lead counsel.

Section 41.109 follows Rule 612 in permitting parties to obtain copies of certain Office files directly related to the contested case. Section 41.109(c) requires a party that has not received copies of a requested file to notify the Board of the problem promptly.

Section 41.110(a) requires a single clean set of the claims, analogous to the requirement for amendments ''in clean form'' in Rule 121.

Section 41.120 provides for notice of requested relief and the basis for that relief in contested cases.

Section 41.121(a)(1) redefines motions practice under Rule 633(a), (b), (c)(2), (c)(3), (c)(4), (f) and (g) to focus more specifically on the central issue in the contested case. Section 41.121(a)(1)(iii) permits a motion for judgment in the contest, which can include an attack on standing as well as a motion for relief on the central issue of the contest. Section 41.121(a)(2) and (a)(3) modifies the responsive motion and miscellaneous motion practice under Rules 633(i) and (j), 634, and 635 to ensure that the proceeding remains focused. Section 41.121(a)(3) provides for miscellaneous motions, which would offer a mechanism for requesting relief on procedural issues and other issues tangential to patentability and priority.

Section 41.121(b) places the burden of proof on the moving party, following Rule 637(a) (2003).

Section 41.121(c)(1) follows Rule 637(a) regarding the general contents of motions, but would also codify the current practice of requiring a separate paper for each motion. The numbered paragraphs stating material facts in § 41.121(c)(1)(ii) should be short, ideally just a sentence or two, to permit the opposing party to admit or deny each fact readily. Under § 41.121(c)(1)(iii), sloppy motion drafting is held against the moving party. Section 41.121(c)(2) requires the movant to make showings ordinarily required for the requested relief in other parts of the Office.

Section 41.121(d) allows the Board to raise questions of patentability.

Section 41.122 codifies the present practice regarding new arguments in replies.

Section 41.123(a) sets default times for filing motions. Section 41.123(b) provides requirements for miscellaneous motions.

A party may request an oral argument under § 41.124(a), but requests would not be automatically granted. Section 41.124(b), requires the parties to file three working copies of the papers to be considered for the panel if the hearing is set for a panel. Section 41.124(c) provides a default time of 20 minutes per party for oral arguments at the Board because they are not evidentiary hearings. Section 41.124(d) permits the use of demonstrative exhibits. Section 41.124(e) permits the transcription of the argument.

Section 41.125(a) maintains the discretion under current practice to address issues in an order that is both fair and efficient. Section 41.125(b) clarifies the current practice that a decision short of judgment is not final. Section 41.125(c) recodifies the time for requesting rehearing from Rule 640(c) and the procedural requirements of the last two sentences of Rule 655(a).

Section 41.126 recodifies the current arbitration practice.

Section 41.127(a)(1) recodifies the existing estoppel provision for interferences. Section 41.127(a)(2) restates the final disposal provision of Rule 663. Section 41.127(b) restates the conditions in Rule 662 under which the Board infers a concession of the contest. Section 41.127(c) restates the recommendation provision of Rule 659. Section 41.127(d) provides a time for requesting a rehearing.

Section 41.128(a) restates Rule 616 on sanctions, but adds the examples of misleading arguments and dilatory tactics to the list of reasons for sanctions. Section 41.128(b) restates the list of sanctions provided in Rule 616, but adds a terminal disclaimer requirement as a sanction.

Section 41.150(a) restates the present policy of limited discovery, consistent with the goal of providing contested proceedings that are fast, inexpensive, and fair. Section 41.150(b) provides for automatic discovery of materials cited in the specification of an involved or benefit disclosure. Section 41.150(c) restates existing practice under Rule 687 regarding additional testimony.

Section 41.151 continues the practice under Rule 671(i) of making failure to comply with the rules a basis for challenging admissibility.

Section 41.152 continues the current practice of using the Federal Rules of Evidence in contested cases. Section 41.152(d) permits reliance on official notice and hearsay to determine the scope and effect of foreign law.

Section 41.153 restates the practice under Rule 671(d) of admitting Office records that are available to all parties without certification. Under § 41.154(a), each Office record cited as evidence would have to be submitted as an exhibit.

Section 41.154(a) restates Rule 671(a), which sets the form of evidence, and codifies the existing practice that all evidence must be submitted as an exhibit. Section 41.154(b) restates Rule 647 regarding translation of foreign language evidence. Section 41.154(c) sets forth additional formal requirements for exhibits consistent with current practice. An exhibit list is required under § 41.154(d).

Section 41.155 sets forth rules for objecting to evidence and responding to objections. Under § 41.155(b)(1), the default time for serving an objection to evidence other than testimony is five business days. Section 41.155(b)(2) permits a party that submitted evidence ten business days after service of the objection to cure any defect in the evidence. (Standing Order ¶ 14.2 provides two weeks.) The Board would not ordinarily address an objection unless the objecting party filed a motion to exclude under § 41.155(c). Section 41.155(d) provides for a motion in limine for a ruling on admissibility.

Section 41.156(a) requires a party seeking a subpoena to first obtain authorization from the Board. Section 41.156(b) imposes additional requirements on a party seeking testimony or production outside the United States because the use of foreign testimony generally increases the cost and complexity of the proceeding for both the parties and the Board.

Section 41.157 restates existing practice regarding the taking of testimony. The time period for cross-examination set in § 41.157(c)(2) follows the current practice and sets a norm for the conference held under § 41.157(c)(1). Section 41.157(c)(3) clarifies the practice of providing documents in advance by limiting the practice to direct testimony. Since direct testimony is generally in the form of a declaration, the circumstance in which § 41.157(c)(3) would apply should rarely occur apart from compelled testimony. Section 41.157(d) codifies the existing requirement for a conference before a deposition with an interpreter.

Section 41.157(e) adopts ''officer'', the term used in 35 U.S.C. 23, to refer to the person qualified to administer testimony. The certification of § 41.157(e)(6)(vi) substantially adopts the standard of Rule 674 for disqualifying an officer from administering a deposition. Section 41.157(e)(7) requires the proponent of the testimony to file the transcript of the testimony.

Section 41.157(f) codifies the existing practice of requiring the proponent of testimony to pay the reasonable costs associated with making the witness available for cross examination, including the costs of the reporter and transcript.

Section 41.158 codifies the current practice regarding expert testimony and scientific tests and data.

Subpart E provides rules specific to patent interferences. Section 41.200(a) would specifically identify patent interferences as contested cases subject to the rules in subpart D.

Section 41.200(b) continues the practice under Rule 633(a) of looking at the applicant's specification to determine the meaning of a copied claim, not the specification from which the claim was copied.

Section 41.200(c) sets forth the policy now found in Rule 610(c) setting two years as the maximum normal pendency for patent interferences.

Section 41.201 sets forth definitions specific to patent interferences. The phrase ''accorded benefit'' is defined as the Board's designation of an application as providing a proper constructive reduction to practice for a party.

A definition is set forth for the phrase ''constructive reduction to practice'' because this phrase is used in the rules instead of ''earliest effective filing date'' to explain more precisely how benefit is accorded for the purpose of determining priority.

The term ''count'' is redefined to emphasize the relationship of the count to admissible proofs of priority under § 102(g).

The definition of ''involved claim'' is based on a similar definition in Rule 601(f) and is consistent with the definition of ''involved'' for contested cases in § 41.100 because only claims that correspond to the count are at risk in an interference, except to the extent a question is raised as to whether a claim that does not correspond should.

The definition of ''senior party'' would depart from the current definition in Rule 601(m) by focusing on the earliest constructive reduction to practice to determine which party, if any, is senior.

The phrase ''threshold issue'' is defined to include three specific issues that directly affect whether a party may participate in an interference. The first identified threshold issue is no interference-in-fact. The other two specifically identified issues, the bar under 35 U.S.C. 135(b) and lack of written description under 35 U.S.C. 112(1), are directed to the prevention of spuriously provoked interferences and would consequently be limited to motions from a party with a patent or published application against a party with an involved application.

Section 41.202(a) restates the requirements of Rules 604, 607, and 608 for applicants provoking an interference. Section 41.202(a)(5) continues the practice under Rule 633(a) of looking at the applicant's specification to determine the meaning of a copied claim, not the specification from which the claim was copied.

Section 41.202(c) restates the practice under Rule 605 of requiring an applicant to add a claim to provoke an interference, but adds requirements for applicants copying claims from patents.

Section 41.202(d) sets forth the basis for a summary proceeding when an applicant does not appear to be able to show it would prevail on priority. Section 41.202(d)(1) restates Rule 608, but eliminates the distinction between Rule 608(a) and Rule 608(b). Section 41.202(d)(2) restates Rule 617 by providing a basis for a summary proceeding on priority when the applicant fails to make a sufficient showing of priority. Under § 41.202(e), the showing must by itself, if unrebutted, warrant a determination of priority favorable to the applicant.

Section 41.203(a) states the standard for declaring a patent interference. The Director uses a two-way unpatentability test to determine whether claimed inventions interfere. Under § 41.203(b) an administrative patent judge declares the interference. Section 41.203(c) authorizes an administrative patent judge to redeclare the interference sua sponte or in response to a decision on motions. Section 41.203(d) permits a party to suggest that an administrative patent judge exercise discretion to declare a new interference or to redeclare the existing interference to accommodate such files.

Section 41.204 would define notices of requested relief in interferences. Section 41.204(a) simplifies the formal requirements for the principal notice on priority, the preliminary statement (which is renamed a ''priority statement''). Section 41.204(b) codifies the existing practice of requiring a list of motions, but under the rule a party would ordinarily be limited to filing substantive motions consistent with its notice of requested relief. No default times is set for statements in § 41.204(c).

Section 41.205 restates practice under Rule 666 regarding the filing of settlement agreements and would implement the requirements of 35 U.S.C. 135(c). Section 205(a) incorporates Rule 661. In addition, § 41.205(a) provides that after a final decision is entered by the Board, an interference is considered terminated when no appeal (35 U.S.C. 141) or other review (35 U.S.C. 146) has been or can be taken or had. If an appeal to the U.S. Court of Appeals for the Federal Circuit (under 35 U.S.C. 141) or a civil action (under 35 U.S.C. 146) has been filed the interference is considered terminated when the appeal or civil action is terminated. A civil action is terminated when the time to appeal the judgment expires. An appeal to the U.S. Court of Appeals for the Federal Circuit, whether from a decision of the Board or a judgment in a civil action, is terminated when the mandate is issued by the Court. Rule 41(d)(2), Fed. R. App. Procedure, controls when the mandate of the Court of Appeals will issue in the event that a party filed a petition for writ of certiorari to the United States Supreme Court. Unless a party petitioning for a writ of certiorari seeks and obtains a stay of the appellate court's mandate, proceedings will be considered terminated with the issuance of the mandate, as noted in § 41.205(a).

Section 41.206 revises practice regarding commonly owned patents and applications in an interference to address cases involving a real party-in-interest with the ability to control the conduct of more than one party.

Section 41.207(a)(1) recodifies the presumption regarding order of invention from Rule 657(a). Section 41.207(a)(2) recodifies the evidentiary standards for proving priority stated in Rule 657(b) and (c), but restates the standard of Rule 657(c) in terms of the date of the earliest constructive reduction to practice.

Section 41.207(b) clarifies claim correspondence practice and explicitly states the effect of claim correspondence. Section 41.207(b)(1) reflects current practice under which patentability must be determined for claims, not counts. Under § 41.207(b)(2), a claim would correspond to the count if the subject matter of the claim would have been anticipated by or obvious (alone or in combination with prior art) in view of the subject matter of the count.

The presumption in § 41.207(c) restates the presumption in Rule 637(a) that prior art cited against an opponent is presumed to apply against the movant's claims.

Section 41.208(a) focuses substantive motions on the core questions of priority.

Section 41.208(b) places the burden of proof on the movant and provides guidance on how to satisfy the burden of going forward.

Section 41.208(c)(1) requires a movant seeking to add or amend a claim to show that the added or amended claim is patentable. Section 41.208(c)(2) similarly requires a movant seeking to add or amend a count to show that the count does not include unpatentable subject matter.

Discussion of Comments

Generally

Unless otherwise indicated, rule references are to rules within chapter I of title 37, Code of Federal Regulations. Comments directed to formal errors in the proposed rule making have been gratefully considered, but will not be separately discussed.

Comment 1: One comment suggests that the Board rules are confusing because some of them apply to activities that take place before an examiner rather than during the Board proceeding itself. The comment suggests that such rules be restored to Part 1 rather than moved to Part 41 as proposed.

Answer: The problem identified is common to any set of rules covering transitions or interfaces between separate processes. For instance, the Federal Rules of Appellate Procedure (FRAP) provide directions to the clerk of the district court on what to do (FRAP 3) before the appeal is docketed (FRAP 12(a)). A choice must be made between keeping such rules with the patent prosecution rules, moving them to the Board rules, or even creating an additional part.

The best choice is to keep such rules with the Board rules. At least one such rule is triggered in relation to every Board proceeding. For instance, § 41.37

(appeal briefs) will be implicated in the majority of ex parte appeals to the Board. By contrast, a Board proceeding occurs in only about 1% of all applications. Consequently, the connection of the rules in question to Board practice is much stronger than the connection to prosecution. As a convenience to applicants and other users of the rules, § 1.191 and § 1.959 direct attention to appropriate subparts of Part 41.

Comment 2: One comment notes that § 1.1(a)(1)(iii), which provides an address for patent interference correspondence was removed but was not replicated in Part 41.

Answer: The interference address was located in proposed § 41.106(d). In view of the confusion that the proposed approach caused for the person making the comment, both § 1.1(a)(1)(ii) and § 1.1(a)(1)(iii) (and the address portion of § 41.106(d)) have been moved to a new § 41.10. Section 1.1(a)(1)(ii) has been rewritten to direct readers to § 41.10.

Comment 3: One comment notes that § 1.6(d)(9) and § 1.8(a)(2)(i)(B), which ban facsimiles and certificates of mailing in interferences, are removed. The comment suggests that the removal means these practices are now permitted.

Answer: Section 41.106 provides directions on filing papers with the Board in contested cases, including interferences. Sections 1.6(d)(9) and 1.8(a)(2)(i)(B) have been revised to direct readers to § 41.106.

Comment 4: One comment opposes moving § 1.14(e) to § 41.6 because the comment urges that this important function should remain under the control of the Director.

Answer: Several observations are in order. First, the rule is limited to Board actions, not all patent related matters. Second, the rule simply implements access that is already available under a variety of statutes. Third, the Board's administration of this provision occurs under a delegation from the Director and remains subject to the Director's ultimate supervision. Indeed, § 41.6(a)(2) expressly reserves to the Director the determination of whether special circumstances justify releasing information about an application otherwise entitled to confidentiality under 35 U.S.C. 122(a). With the advent of pre-grant publication under 35 U.S.C. 122(b), the vast majority of final Board decisions are soon expected to be routinely available at the time they are issued or shortly afterward. It is impracticable for the Director to administer disclosure of all of these decisions personally. The Board is the logical delegate to administer disclosure of Board actions.

Section 1.11(e) has been amended to simplify the language of the rule and to provide a cross reference to § 41.6.

Comment 5: One comment opposes the additional discretion in § 1.14(e)(2) to publish petition decisions.

Answer: The only changes to § 1.14 intended in this rule making were ministerial deletions of references to decisions of the Board. Another rule making, 68 FR 38624, has changed § 1.14 in a way that appears to address the concerns of the comment.

Comment 6: One comment suggests that extension of time practice in the proposed rules is confusing because it is not always clear whether § 1.136 or § 41.4 would apply.

Answer: As proposed, § 41.4(c) explained that § 41.4 applied to Board proceedings, but not during prosecution or during the time for judicial review. The rule has been amended to clarify that § 41.4 applies when a matter is actually pending before the Board. For instance, an extension of time to file an appeal brief, which is due before jurisdiction transfers to the Board, would be subject to § 1.136, while a request for additional time to file a request for reconsideration of a Board decision would be subject to § 41.4.

Comment 7: Two comments suggest that § 1.292(a) be modified to permit delegation of the conduct of public use proceedings to the Board of Patent Appeals and Interferences.

Answer: This suggestion falls outside the scope of the present rule making, in which § 1.292(a) was included simply to change a cross reference. The comments have been forwarded to the Deputy Commissioner for Patent Examination Policy for further consideration. Note, however, that § 1.292(a) would permit such a delegation without amendment.

Comment 8: One comment suggests additional modifications to § 1.292(a) as well as to subpart D of part 41 to authorize action by a single Board member and to provide relief in proceedings under 42 U.S.C. 2182(4) and 2457(d).

Answer: Subpart D provides sufficient flexibility to permit such actions without amendment.

Comment 9: Three comments suggest that the cross-reference to § 41.121(a)(2) in §§ 1.322–1.324 is too narrow because it would only permit corrections in a responsive motion. The suggested cure is to generalize the reference to § 41.121(a) because the need to correct can arise at various times and may not be in response to anything filed in a contested case.

Answer: The comments' reasoning is consistent with the filing of a miscellaneous motion (§ 41.121(a)(3)), but not with the filing of a substantive motion (§ 41.121(a)(1)). Consequently, Rules 322 to 324 have been revised to refer to § 41.121(a)(2) and (3).

Comment 10: One comment suggests that § 1.565(e) be amended to reflect the balance between the need for special dispatch in reexaminations and the need for the Office to ensure orderly proceedings, citing *Ethicon* v. *Quigg,* 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988).

Answer: The proposed revision of § 1.565(e) only changed the cross-reference. The comment suggests a change that is outside the scope of this rule making. Nevertheless, the Office is keenly aware of the need for balance on this point.

Part 41, Subpart A—General Provisions

Comment 11: One comment suggests that the lack of paragraph designations in § 41.2 for each definition is confusing, particularly since subparagraphs are numbered.

Answer: The rule conforms to the guidance the Office of the Federal Register provides for drafting definitions. **Federal Register** Document Drafting Handbook section 8.15. Given that the defined terms are listed alphabetically and italicized, in practice the format should not be confusing.

Comment 12: One comment suggests that the definition of ''Board of Patent Appeals and Interferences'' in § 41.2, which includes both Board members and Board employees for non-final actions, is inconsistent with an Office rule making published 4 December 2003 at 68 FR 67818. The comment prefers the approach taken in this final rule. The comment is more relevant to the other rule making and has been forwarded to the Deputy Commissioner for Patent Examination Policy. Note that Board employees other than Board members are only defined as the Board for the purposes of non-final actions.

Comment 13: Two comments urge that § 41.3 creates confusion for petitions relating to rules in part 41 but arising while the Board does not have jurisdiction, for example, supervisory review of an examiner's answer for failure to comply with a rule.

Answer: Section 41.3 is amended to include a scope provision that limits its scope to actions by the Board or to proceedings pending before the Board.

Comment 14: One comment suggests that § 41.3(a) be amended to bar the Chief Administrative Patent Judge from delegating authority to enter a decision on a petition to a person who

participated in the matter being petitioned.

Answer: The suggestion involves matters of Board management, which are better treated in management documents like standard operating procedures.

Comment 15: One comment notes that proposed § 41.4(a) sets a ''good cause'' standard for obtaining an extension of time, whereas § 1.136(b), relating to non-fee extensions of time, sets a ''sufficient cause'' standard. The comment suggests either the commentary describe the differences, if any, between these two standards or adopt the ''sufficient cause'' standard in proposed § 41.4(a).

Answer: The ''good cause'' standard for obtaining an extension of time under § 41.4(a) will be maintained to distinguish it from the ''sufficient cause'' standard of § 1.136(b). An extension of time under § 41.4(a) for ''good cause'' is decided by the Board while an extension of time under § 1.136(b) for ''sufficient cause'' is decided outside of the Board. The ''good cause'' standard for obtaining an extension of time has previously been used by the Board in former § 1.645 (2003) and will be maintained even though there is little, if any, difference between the standards.

To establish good cause for a filing delay, a party must show that the delay was excusable under the circumstances and that the appellant exercised due diligence in attempting to meet the filing deadline. The factors bearing on whether there is good cause for an untimely filing include the length of the delay, knowledge of the time limit, circumstances beyond the party's control that affected its ability to comply with the deadline, the party's negligence, if any, and any unavoidable harm that might have prevented timely filing. Zamot v. MSPB, 332 F.3d 1374, 1377 (Fed. Cir. 2003).

Comment 16: One comment notes that extensions of time for certain deadlines in interferences can generally be obtained by stipulation according to the current Standing Order. The comment suggests changing proposed § 41.4(a) by adding at the end ''or Order of the Board''.

Answer: The practice of permitting stipulated changes is unaffected by this provision (which existed under § 1.645(a) (2003)). An authorized, stipulated change in a deadline is not an extension of the deadline. The suggested addition could create the misapprehension that the standard itself can be changed by order. The suggestion will not be adopted.

Comment 17: One comment states that proposed § 41.4(b) is particularly confusing in that it indicates that late filings ''will not be considered absent a showing of excusable neglect or a Board determination that consideration on the merits would be in the interest of justice.'' Under current practice, when a notice of appeal or appeal brief is filed late, an applicant has the option of petitioning to revive that application under § 1.137 by showing that the delay in filing an appropriate paper or fee was unavoidable or unintentional. The comment states that it is not clear from the proposed § 41.4(b) whether the provisions of § 1.137 will be available for late filings of papers and fees after a notice of appeal is filed, or in what circumstances they will be available.

Answer: Section 41.4(b) has been revised to reflect that a late filing that results in either an application becoming abandoned or a reexamination proceeding becoming terminated under §§ 1.550(d) or 1.957(b) or (c) will be excused if the application or reexamination proceeding is revived as set forth in § 1.137. A late filing that does not result in either an application becoming abandoned or a reexamination proceeding becoming terminated under §§ 1.550(d) or 1.957(b) or (c) will be excused upon a showing of excusable neglect or a Board determination that consideration on the merits would be in the interest of justice.

Comment 18: One comment objects to the provision in § 41.5(b) of a disqualification proceeding before the Board as ill-defined and beyond the Board's competence.

Answer: The disqualification proceeding already exists in contested cases (see now-removed § 1.613 (2003)) where it appears to have worked well. The objection may be based on a misapprehension that this provision governs suspension or exclusion from practice before the Office generally rather than the special case of a suspension or exclusion from a specific case before the Board. Disqualifications at the Board typically arise out of conflicts of interest and, consequently, are more of a feature of contested cases.

The advent of appeals in inter partes reexaminations makes this provision relevant to appeals, too. Moreover, a disqualification might be appropriate in an ex parte appeal, for instance, when a former Office employee appears as counsel in a case in which he or she acted while at the Office. Note that disqualification could be in addition to other appropriate sanctions under 37 CFR part 10.

Although the comment suggests unease with the level of due process the disqualification proceeding would provide, at least two checks exist. A disqualification would not become final until the Chief Administrative Patent Judge certified the result. Counsel could seek to moot any disqualification by requesting to withdraw before the result is certified. If the Chief Administrative Patent Judge certifies the disqualification, the case becomes ripe for judicial review under 35 U.S.C. 32.

Comment 19: One comment opposes the requirement in § 41.5(c) that requires Board approval to withdraw as counsel in a Board proceeding.

Answer: The rule should not create any practical difference for counsel since approval is required for any withdrawal. The approval should come from the part of the agency with jurisdiction over the application or patent at the time of the withdrawal.

Comment 20: Two comments oppose § 41.7(a), which permits the Board to expunge unauthorized papers, because of the scope of the rule.

Answer: The rule has been clarified to state that it only applies to papers filed as part of a proceeding before the Board (§ 41.1(a)) or while the Board has jurisdiction over the file and will not be used to prune applications arbitrarily.

Comment 21: One comment suggests that expungement of papers under § 41.7(a) be limited to exceptional circumstances.

Answer: Violation of a rule or Board order, the triggers for expungement, should be an exceptional circumstance in patent practice.

Comment 22: One comment expresses concern that § 41.7(a) would prevent the entry of evidence and would result in an incomplete record. This, the comment suggests, would result in more judicial review being sought in district court rather than through direct appeal to the United States Court of Appeals for the Federal Circuit (Federal Circuit). The comment suggests that such filings are useful as a way to place papers in the record, knowing that they will not be considered by the Office, simply to get them in front of a court.

Answer: Such filings are not proper. Two remedies exist for expungement of a paper. In some cases, it may be appropriate to seek entry of new evidence in a district court under 35 U.S.C. 145 or 146. In most cases, however, the remedy would be to challenge the expungement directly by petition showing either that the paper was properly filed or that it should be retained in the interest of justice.

Comment 23: One comment recommends that a definition of ''Board proceeding'' be included in proposed § 41.2, to avoid possible inconsistencies

between the requirements of proposed § 41.7(b) and those of proposed § 41.37(c)(1)(ix).

Answer: Section 41.7(b) has been changed to read ''A party may not file a paper previously filed in the same Board proceeding, not even as an exhibit or appendix, without Board authorization or as provided by rule'' so as to avoid an inconsistency with the requirement of § 41.37(c)(1)(ix) to provide an appendix containing copies of evidence previously submitted and entered by the examiner.

Comment 24: One comment suggests that § 41.7(b) creates a burden by requiring a party to request entry of a duplicate paper that the Board may wish to have.

Answer: Parties should assume that the Board does not want the duplicate paper in the absence of a specific request or as provided by rule as discussed above.

Comment 25: Two comments suggest that § 41.8, which requires prompt reporting of changes in real party-in-interest or in related cases, is onerous as applied to appellants. In particular, they oppose the requirement to advise the Board of any change in the real party-in-interest or in related cases within 20 days of the change.

Answer: Section 41.8 has been reformatted so that the last clause referring to judicial review is now its own subsection. Proposed §§ 41.8(a) and (b) are now §§ 41.8(a)(1) and (a)(2), respectively.

The Federal Circuit requires any change in the real party-in-interest to be reported within seven days. Federal Circuit Rule (Fed. Cir. R.) 47.4(c). Section 41.8(a)(1) provides nearly triple the time the court provides in recognition of the greater number of appeals to the Board than to the court, but the Board needs to know such information just as much as the court does.

The burden to report changes in related cases is not onerous since most such changes are entirely under the control of the affected party. Such changes would include the filing of a continuation application claiming benefit of an application on appeal or the filing of a reissue application for a patent that is before the Board in a reexamination appeal. The amount of due diligence involved should be small for any party with an effective docketing system.

The last clause of § 41.8(a)(2) is now § 41.8(b) to raise its profile, but has been limited to contested cases because it is in that context, particularly in the case of judicial review under 35 U.S.C. 146, where the problems arise. Lack of adequate notice of judicial review in contested cases can result in applications that should be suspended pending the outcome of the judicial review being held abandoned or being allowed and other administrative complications.

Comment 26: One comment requests clarification of what constitutes a related case under § 41.8.

Answer: The requirement is substantially the same in scope as the requirement in Fed. Cir. R. 47.5. Now-removed § 1.656(b)(2) (2003) also imposed a similar requirement. The Board needs to know of related cases for several reasons. First, awareness of related cases facilitates scheduling and panel assignment, which can increase efficiencies for both the Board and the party. Second, a decision in a related judicial or administrative case may affect the outcome in the case before the Board.

For instance, a definition of a claim term in a related case may limit or expand the scope for the same term in a case before the Board. See *Ballard Med. Prods.* v. *Allegiance Healthcare Corp.,* 268 F.3d 1352, 1362, 60 USPQ2d 1482, 1501 (Fed. Cir. 2001) (claim limitations need not be the same); *Augustine Med., Inc.* v. *Gaymar Indus., Inc.,* 181 F.3d 1291, 1300, 50 USPQ2d 1900, 1907 (Fed. Cir. 2000) (holding that the prosecution history of a parent application may limit the scope of a later application using the same term); *Elkay Mfg. Co.* v. *Ebco Mfg. Co.,* 192 F.3d 973, 980, 52 USPQ2d 1007, 1107, 1114 (Fed. Cir. 1999) (prosecution history can apply to claim in different subsequent patent). Claims in the related case might be estopped by an adverse judgment in the interference (§ 41.127(a)(1)). A party that is aware of a related case, but nevertheless fails to disclose the case may fall short of its duty of candor to the Office. If the facts of the other case are materially different, then the related case might have no material effect on the case before the Board. *Georgia-Pacific Corp.* v. *United States Gypsum Co.,* 195 F.3d 1322, 1333, 52 USPQ2d 1590, 1599 (Fed. Cir. 1999) (inconsistent positions did not affect outcome).

Comment 27: Five comments oppose § 41.11 (which was proposed as § 41.105), the bar on ex parte communications, as too restrictive.

Answer: Proposed § 41.105 has been moved to § 41.11 in subpart A and has been revised to refer to inter partes reexaminations under subpart C and contested cases under subpart D because the concern about ex parte communications in adversarial cases is common to both types of proceedings.

The bar on ex parte communications in § 41.11 is stricter than the bar on ex parte interviews in § 1.955. Section 1.955 allows ex parte communications with an official acting on the merits as long as the merits are not discussed during the ex parte communication. Section 41.11 bars all ex parte communications with all administrative patent judges and with any Board employee acting on the merits. Non-merits ex parte communications may take place with other Board employees who are not acting on the merits of the case.

Section 41.11 is intended to be restrictive because experience has shown that ex parte communications are easily abused and easily shift from permissible topics to impermissible topics. The rule prohibits any ex parte contact about a pending case with an administrative patent judge because the administrative patent judge might be assigned to a panel in the proceeding.

Comment 28: Three comments urge that ex parte communications with Board staff can be helpful to practitioners without being injurious to the integrity of the proceeding. One comment recommends the establishment of a help desk. One of the comments suggested that the phrase ''Board employee conducting the proceeding'' be clarified.

Answer: The prohibition regarding other Board employees in § 41.11 has been clarified to say ''assigned to the proceeding'' to give parties a measure of confidence in contacting Board officials, other than administrative patent judges, that have not been expressly assigned to the case. As a general rule, support staff are not assigned to a proceeding. Other Board employees, like administrators, might be assigned an interlocutory role in a proceeding, but the party would have notice of the assignment. The Office agrees that informal contacts with support staff can be of great benefit to the parties. The rule is not intended to prohibit, and does not prohibit, such contacts.

Comment 29: Three comments note that the supplementary information in the notice of proposed rule making provides examples that appear to be more liberal than the rule. One of the comments recommended moving the examples from the supplementary information into the rule.

Answer: The examples are not exceptions to the rule. For example, when a party declines to participate in a hearing or conference, there is not an exception to the rule. Instead, it is a waiver by the non-participating party of the protections of the rule. A party cannot be permitted a heckler's veto on

the opposing party's ability to communicate with the Board. Even so, the Board will treat such one-sided communications with caution. For instance, a transcript of the communication may be required.

In another example, informing the Board in one proceeding of a related proceeding is not an ex parte communication about the contested case as long as the information does not extend beyond identifying information about the other proceeding. Such information is required under § 41.8.

Finally, citing a pending case in support of a more general proposition, again is not an ex parte communication about the contested case as long as the focus is on the general proposition and not on the merits of the cited case. For instance, citing a published opinion from a pending case has never been considered an ex parte communication. Similarly, a complaint to the Chief Administrative Patent Judge about delays in interferences generally, with a list of examples, is appropriate provided the complaint stays focused on the general problem of delays rather than issues in a particular cited proceeding. Any discussion of a particular aspect of a particular pending case must be treated formally in accordance with § 41.11.

Comment 30: One comment suggests that the rules were inconsistent in requiring parallel citation to the West Reporter System (West) and to the United States Patents Quarterly (USPQ) in contested cases, § 41.106(b)(4)(ii)(B), but not in appeals.

Answer: Proposed § 41.106(b)(4) has been relocated to new § 41.12 in subpart A to eliminate the inconsistency.

Comment 31: Three comments note that the Federal Circuit has changed its rules to eliminate the requirement for parallel citations to a West reporter and the USPQ. Two of the comments object that parallel citation imposes additional costs on parties. Two of the comments express a preference for not using the USPQ. One of the comments notes that Westlaw, the on-line West service provides much more complete coverage of current Board decisions than does the USPQ. The comments do not address the use of any other reporter or database service.

Answer: None of the comments explain why the court made this change or explain how it is applicable to Board practice. Of the printed reporters, USPQ provides much better coverage of patent decisions relevant to Board practice than West does. The Board cites to the West system as a courtesy to its reviewing courts, but principally uses the USPQ because of its greater relevance to Board practice.

If the Board were to eliminate the requirement for parallel citation, it would make more sense to eliminate the requirement to cite to the West system reporters. If citation to the USPQ were eliminated, the alternative would not be citation to West's printed reporters but to one of the on-line services, which would also raise issues of access and expense.

No reporter system is authoritative. *Hallco Mfg. Co.* v. *Foster,* 256 F.3d 1290, 1297 n.4, 59 USPQ2d 1346, 1350 n.4 (Fed. Cir. 2001) (relating an instance where the West reporter misprinted a paragraph, while the USPQ printed the decision correctly, and noting that only the court's print of the opinion is authoritative). Parallel citation thus also serves as a useful check on privately compiled reporters.

Comment 32: One comment notes that USPQ no longer provides very good coverage of Office decisions while many Board decisions are available through on-line services.

Answer: Most of the large volume of Board decisions that are available on-line are not properly citable as precedent. Consequently, the practical differences in coverage between Westlaw and the USPQ are less than the comment purports.

There is no ideal solution for which reporter system or systems should be required. This is a problem that confronts many adjudicative bodies. The Board has imposed a requirement on itself to cite both West reporters and the USPQ: the former to be responsive to the courts, the latter to address its own needs. The citation format used by parties before the Board must be consistent with Board practice.

Comment 33: One comment interprets proposed § 41.106(b)(4)(ii), now § 41.12(b), to bar citation to the Manual of Patent Examining Procedure (MPEP). The comment suggests that instead great weight should be given to the MPEP.

Answer: The rule does not bar citation to the MPEP. Rather the rule discourages the citation of authority that is not binding. Primary authority should be cited for legal issues in papers directed to the Board. Unless primary authority is unavailable, primary authority is always preferable to, and more persuasive than, any secondary authority.

Comment 34: One comment requested that the fee information in § 41.20 be restored to § 1.17, particularly since some of the § 41.20 fees must be paid before jurisdiction passes to the Board.

Answer: The fees were moved to part 41 to locate them with the rules that require the fees. Note that trademark-specific fees are located with the trademark rules in part 2. Cross-references to § 41.20 in the Board rules that require the fees should prevent confusion about where the fees are located. A cross-reference has been added at § 1.17(b) to offer further guidance.

Part 41, Subpart B—Ex Parte Appeals

Comment 35: One comment suggests that since appeals are a fairly common procedure, a notice of the changes to the appeal procedures should be mailed to each practitioner warning him or her of these changes.

Answer: The comment will not be adopted. A mailing of a notice of the changes to the appeal procedures to each practitioner is not required since it is each practitioner's responsibility under 37 CFR Part 10 to stay up-to-date on patent procedures. Nevertheless, the Board will attempt to mail a notice of the final rule making to every appellant with the docketing notice (see the Notice of revised appeal docketing procedures published in the July 2, 2002 OG) for several months.

Comment 36: One comment suggests that §§ 41.31(a)(1), (a)(2) and (a)(3) be amended to provide for appeal at any time after being twice or finally rejected, as appropriate, during pendency of the proceeding where no time period under § 1.134 is running. The comment states that the suggested change would ensure that § 41.31 would not be interpreted more restrictively than 35 U.S.C. 134, which sets forth no condition regarding when an appeal can be filed, apart from the requirements for claims being twice rejected (as in 35 U.S.C. 134(a)) or finally rejected (as in 35 U.S.C.134(b) and (c)). The comment also states that this amendment would prevent any potential inconsistency of the rules with the Board's precedential opinion, Ex *parte Lemoine*, 46 USPQ2d 1420, 1423 (BPAI 1994).

Answer: The suggestion will not be adopted. Sections 41.31(a)(1), (a)(2) and (a)(3) were proposed to generally incorporate the requirements of former § 1.191(a) (2003) and to subdivide § 1.191(a) into three parts to improve readability. Both former § 1.191(a) (2003) and §§ 41.31(a)(1), (a)(2) and (a)(3) are more restrictive than 35 U.S.C. 134 in that an appeal must be filed within the time period provided under § 1.134 for response to either a final rejection or a non-final rejection which rejects the claims for a second time, as appropriate. For example, an applicant for a patent whose claims have been twice rejected but not finally rejected, may appeal from the decision of the

examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § 41.20(b)(1) within the time period provided under § 1.134. However, if such an applicant files an amendment within the time period provided under § 1.134, the applicant may not file an appeal outside the time period provided under § 1.134. In such a situation, the applicant must wait for a new rejection by the examiner before an appeal can be filed.

Comment 37: One comment suggests that paragraphs (a)(1) and (a)(2) of § 41.31 be amended to remove the alternative clause (*i.e.*, ''or finally'') since this would make it clear that once the examiner rejects a claim for the second time (in the same application or in a continuing application), the decision as to whether to appeal the rejection or continue proceedings before the examiner will rest with the applicant. The comment notes that since a final rejection will never be made in a first rejection of a claim, the alternative language is not necessary and that the change is being suggested to reduce the periodic disputes between examiners and applicants as to whether an application under a non-final rejection was ripe for appeal.

Answer: The suggestion has been adopted. The Board's precedential opinion in *Ex parte Lemoine*, 46 USPQ2d at 1423, interpreted the language of 35 U.S.C. 134 that gives applicants the statutory right to an administrative appeal to mean that ''so long as the applicant has twice been denied a patent, an appeal may be filed.'' Thus, the alternative language of the proposed rule (*i.e.*, ''or finally (§ 1.113 of this title)'' is not necessary.

Comment 38: One comment suggests that § 41.31(a)(3) be deleted. The comment states that this would eliminate the requirement that the patent owner wait until an examiner makes a second or subsequent rejection final, before being permitted to file an appeal in a reexamination proceeding filed on or after November 29, 1999 and thus would restore to patentee the decision as to when to file an appeal in a reexamination proceeding that is subject to repeated rejections. The comment also notes that the deletion of § 41.31(a)(3) would simplify the regulations as there would no longer be a need to determine filing dates of reexamination proceedings under this section.

Answer: The suggestion will not be adopted. 35 U.S.C. 134(b) provides that ''[a] patent owner in any reexamination proceeding may appeal from the final rejection of any claim by the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.'' According to the effective date provisions of Public Law 106–113, the provisions of 35 U.S.C. 134(b) apply to any reexamination proceeding filed on or after November 29, 1999. Accordingly, by law, the patent owner must wait until an examiner makes a second or subsequent rejection final, before being permitted to file an appeal in a reexamination proceeding and therefore both §§ 41.31(a)(2) and (a)(3) are necessary to inform a patent owner when an appeal in a reexamination proceeding may be taken.

Comment 39: One comment suggests that proposed § 41.33 be amended to refer to the ''date of filing an Appeal'' as opposed to referring to ''after the date the proceeding has been appealed.'' This change would ensure consistency with Office language used in other regulations relative to ''filing dates.'' The original language is confusing as it is not clear whether the date the ''proceeding has been appealed'' is the date typed by the Applicant on the Notice of Appeal, the date of the Certificate of Mailing affixed on a Notice of Appeal, or the date of filing accorded by the Office to the Notice of Appeal. Similarly, it is not clear what the date is that an amendment was ''submitted.'' Do certificates of mailing or certificates of facsimile transmission, impact on the date of ''submission'' or the date that ''the proceeding has been appealed''? A well accepted term like ''date of filing'' used consistently throughout the paragraph would avoid any possible confusion.

Answer: The suggestions have been adopted in § 41.33 and § 41.63.

Comment 40: One comment suggests that the word ''may'' be replaced with the word ''will'' in § 41.33. The comment states that this suggestion is made to avoid any possible confusion or abuse of the regulations by examiners and that there should be no flexibility given to examiners in entering minor cosmetic amendments as envisioned in this portion of the paragraph.

Answer: The suggestion will not be adopted. The use of the word ''may'' in § 41.33 rather then the word ''will'' is appropriate since it (1) is consistent with the current use of the word ''may'' in § 1.116; and (2) connotes that entry of amendments and evidence filed after appeal is not a matter of right but that such amendments and evidence filed after appeal may be admitted under certain circumstances set forth in the rule.

Comment 41: One comment notes that § 41.33(b) should also include a reference to § 41.50(c) as to permitted amendments.

Answer: The suggestion has been adopted.

Comment 42: One comment suggests incorporating § 41.33(c) into § 41.33(b), and having § 41.33(b) refer both to ''amendments'' and ''affidavits or other evidence'' submitted after filing an appeal. The comment states that this change would avoid separate discussion of amendments, affidavits and other evidence.

Answer: The suggestion will not be adopted since the prohibition against these filings is no longer the same. See Comment 41.

Comment 43: Five comments assert that proposed § 41.33 would unduly restrict the types of amendments and evidence that can be made after a Notice of Appeal is filed. One suggested solution was to remove paragraphs (b) and (c) of § 41.33 and instead rely upon (or substitute) the provisions of § 1.116. A second suggested solution was to amend paragraphs (b) and (c) of § 41.33 to take effect once the appeal brief is filed. A third suggested solution was that amendments making claim(s) allowable be permitted thus resolving issues that would otherwise be appealed.

Answer: The comments have been adopted to the following extent. Amendments submitted on or after the date the proceeding has been appealed may be admitted as provided in § 1.116. Thus, amendments after final but prior to appeal and amendments filed after appeal but prior to the date the brief is filed will be treated under the same standard (i.e, § 1.116). Amendments filed on or after the date of filing a brief may be admitted only to cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, or to rewrite dependent claims into independent form. All other amendments submitted after the date the proceeding has been appealed will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i), 41.50(b)(1) and 41.50(c). Affidavits or other evidence submitted after the date the proceeding has been appealed and prior to the date a brief is filed overcoming all rejections under appeal may be admitted if the examiner determines that the affidavits or other evidence overcomes all rejections under appeal and a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. All other affidavits or other evidence submitted on or after the date the proceeding has been appealed will not be admitted except as permitted

by §§ 41.39(b)(1), 41.50(a)(2)(i) and 41.50(b)(1).

Comment 44: Two comments state that the proposed rules are unclear as to subsequent appeal procedures after prosecution is reopened subsequent to the filing of a first Notice of Appeal and Appeal Brief. Specifically, the comments question if prosecution is reopened under either § 41.39(b)(1), § 41.50(a)(2)(i) or § 41.50(b)(1), and a subsequent appeal is taken, would applicant be required to again pay the Notice of Appeal and Appeal Brief fees. The comments believe that this extra cost is unfair and burdensome to applicants because the reopening of prosecution would be the result of action by the examiner or the Board, not action by applicants. Accordingly, the comments suggest that provision should be made in the proposed rules that applicants need not twice pay the Notice of Appeal and Appeal Brief Fees in an application where those fees have already been paid but prosecution was then reopened.

Answer: The comment will not be adopted. The rule making did not propose to change the current procedures in this area. Currently, once a Notice of Appeal and Appeal Brief fee has been paid in a proceeding, a second Notice of Appeal and Appeal Brief fee will not be required except if a final Board decision has been made on the first appeal. For example, in an application for patent, a Notice of Appeal and Appeal Brief fees have been paid and the examiner reopens prosecution in a new Office action, new fees are not required for an applicant to appeal from that new Office action. Another example is in an application for patent, a Notice of Appeal and Appeal Brief fees have been paid and the Board in its decision makes a new ground of rejection and the applicant elects to reopen prosecution before the examiner, then new fees are required for an applicant to appeal from any new Office action by the examiner. The same procedures apply under the rules as implemented in this rule making.

Comment 45: One comment suggests that it ought to be made clear that the words of § 41.33, ''rewrite dependent claims into independent form,'' includes both of the following two situations: (1) In conjunction with the rewriting of a dependent claim in independent form, amendment(s) would be allowed changing the dependency of claims which had depended from the independent claim being canceled, and (2) rather than rewriting a dependent claim in independent form, an independent claim can be amended to incorporate therein the subject matter of a dependent claim that has been identified by the examiner as being allowable.

Answer: The suggestion is adopted to the extent that the Manual of Patent Examining Procedure will provide that rewriting dependent claims into independent form as permitted under § 41.33 includes the following situations: (1) Rewriting a dependent claim in independent form by adding thereto the limitations of the parent claim(s); and (2) rewriting an independent claim to incorporate therein all the subject matter of a dependent claim, canceling the dependent claim and in conjunction therewith changing the dependency of claims which had depended from the dependent claim being canceled to the amended independent claim that incorporate therein all the subject matter of the now canceled dependent claim.

Comment 46: One comment suggests that § 41.37(a)(1) be amended, as suggested for § 41.33, to reference the ''date of filing the notice of appeal,'' rather than the uncertainty that might be introduced by the phrase ''the date of the notice of appeal.''

Answer: The suggestion has been adopted.

Comment 47: One comment inquires if the ''date of the notice of appeal'' referred to in § 41.37(a) is the date the notice of appeal is signed, is filed, or is received by the Office.

Answer: As under current practice, the date of filing the notice of appeal is either (1) the date of deposit with the United States Postal Service if the provisions of 37 CFR § 1.10 are followed; or (2) the date of receipt by the Office.

Comment 48: One comment suggests that the clause ''or within the time allowed for reply to the action from which the appeal was taken, if such time is later'' be added at the end of paragraph 41.37(a)(1). The comment notes that this language currently appears in former § 1.192(a) (2003), and this additional time is a valuable option to applicants who file a notice of appeal with no intention of filing an appeal brief, but are filing the appeal simply to buy some additional time to permit the examiner to rule on an amendment filed under § 1.116. The comment states that any docketing benefits gained by the proposed change in this paragraph, as discussed by the proposed rule drafters, is far outweighed by the disadvantage to both applicants and the Office in having applicants file a brief simply as a strategy to maintain pendency, while the examiner renders a decision on an amendment filed under § 1.116.

Answer: The suggestion will not be adopted. The suggestion is based on the belief that the two-month period for filing an appeal brief that runs from the date of filing of the notice of appeal would expire before applicants have received a decision from the examiner on an amendment filed under § 1.116 (*i.e.*, an amendment filed after a final rejection but before or with the filing of a notice of appeal). It is expected that such a situation would be rare. In that rare situation, applicants can obtain an extension of time as provided in § 41.37(e). In addition, applicants can delay filing the notice of appeal until they have received a decision from the examiner on the amendment filed under § 1.116 especially if the amendment filed under § 1.116 is filed within two months from the date of mailing of any final rejection setting a three-month shortened statutory period for reply since it is Office policy (see MPEP 714.13) that if the advisory action is not mailed until after the end of the three-month shortened statutory period, the period for reply to the final rejection for purposes of determining the amount of any extension fee will be the date on which the Office mails the advisory action advising applicant of the status of the application, but in no event can the period for reply to the final rejection extend beyond six months from the date of the final rejection.

Comment 49: One comment inquires how the real party in interest should be identified in the appeal brief when the application involved in the appeal is assigned to a subsidiary corporation which corporation is owned by either a parent corporation or a joint venture between corporations.

Answer: When an application is assigned to a subsidiary corporation, the real party in interest is both the assignee and either the parent corporation or corporations, in the case of joint ventures. One example of a statement identifying the real party in interest is: The real party in interest is XXXX corporation, the assignee of record, which is a subsidiary of a joint venture between YYYY corporation and ZZZZ corporation.

Comment 50: One comment suggests that a requirement to identify the real party in interest should be made in contested cases, perhaps as part of a re-named § 41.108.

Answer: Section 41.8 entitled ''Mandatory notices'' already requires that at the initiation of a contested case (§ 41.101), and within 20 days of any change during the proceeding, a party must identify its real party-in-interest.

Comment 51: One comment suggests that the requirement in § 41.37(c)(1)(ii)

to identify related proceedings is ambiguous with respect to its scope. The comment believes that read broadly, it would require an appellant to identify every precedential decision that might bear on the issues on appeal and could expose an appellant to unreasonable allegations of inequitable conduct.

Answer: The requirement in § 41.37(c)(1)(ii) to identify related proceedings does not require an appellant to identify prior proceedings involving unrelated parties including precedential decisions that might bear on the issues on appeal. The requirement in § 41.37(c)(1)(ii) to identify related proceedings does require an appellant to identify every related proceeding (*e.g.*, commonly owned applications having common subject matter, claim to a common priority application).

Comment 52: One comment suggests that § 41.37(c)(1)(iii) be deleted in its entirety, as it introduces an unnecessary additional burden on appellants with no discernible benefit to the Office. The comment states that since only rejected claims are subject to an appeal, there seems to be no benefit in identifying the status of claims that are not subject to appeal and that asking appellants to make this type of listing for claims that are not rejected and thus are not subject to appeal, would introduce a risk of inadvertent error by appellants and in any event, would likely be ignored by the examiner and the Board.

Answer: The suggestion will not be adopted. Section 41.37(c)(1)(iii) generally incorporates only the requirements of former § 1.192(c)(3) (2003) that a statement of the status of all the claims be presented and an identification of those claims that are being appealed. As such it does not introduce an unnecessary additional burden on appellants. Moreover, the benefit to the Office of this requirement is that the Board is directly informed as to the status of all the claims in the proceeding (*e.g.*, rejected, allowed or confirmed, withdrawn, objected to, canceled) and which of those claims that are being appealed. For example, should the Board have knowledge of any grounds not involved in the appeal for rejecting any pending claim, the Board under the authority of § 41.50(b) may make a new ground of rejection.

Comment 53: One comment expresses concern in regard to the requirement of proposed § 41.37(c)(1)(v) that a concise explanation of the subject matter defined in each of the independent claims involved in the appeal be provided. Specifically the comment asks what is a concise statement, what is required, does the explanation have to show how each claim is different, does the requirement apply to all drawings and embodiments, or only a representative drawing? The comment states that the Office deleted a similar requirement in 1992 relating to documents submitted in an IDS because ''concise explanation'' descriptions rarely communicated any useful information, improved the quality of patent examination but provided an opportunity to attack the patent on the grounds of inequitable conduct. The comment suggests that the requirement be clarified or dropped.

Answer: A patentability determination must be performed on a claim-by-claim basis. The first step in a patentability determination is to construe a given claim and determine its metes and bounds. ''Analysis begins with a key legal question—what is the invention *claimed*?'' since ''[c]laim interpretation * * * will normally control the remainder of the decisional process.'' *Panduit Corp.* v. *Dennison Manufacturing Co.,* 810 F.2d 1561, 1567–68, 1 USPQ2d 1593, 1597 (Fed. Cir.), *cert. denied,* 481 U.S. 1052 (1987). The existing provisions of 37 CFR § 1.192(c)(5) (2003) are directed to providing a summary of the ''invention,'' not the claims. *See In re Hiniker Co.,* 47 USPQ2d 1523 (Fed. Cir. 1998): ''The invention disclosed in Hiniker's written description may be outstanding in its field, but the name of the game is the claim. *See* Giles Sutherland Rich, *Extent of Protection and Interpretation of Claims—American Perspectives,* 21 Int'l Rev. Indus. Prop.'' By statute, the Board reviews ''adverse decisions of examiners upon applications for patents.'' 35 U.S.C. 6(b). For the Board to reach an informed decision on the merits of a rejection presented for review, the record should reflect the respective positions of the examiner and appellant as to the scope of the claims. It is the experience of the Board that the prosecution and examination in a significant number of appeals forwarded for decision on appeal has taken place in the context of ''applicant's invention,'' not on a claim-by-claim basis. Thus, the Board is oftentimes confronted with a record in which no significant claim construction has occurred. Those records are not susceptible to meaningful review and result in an inordinate number of remands.

The determination of how ''concise'' the explanation must be will need to be determined on a case-by-case basis. If the prosecution and examination has been based upon a discussion of the patentability of individual claims instead of the ''invention,'' it is expected the explanation will be more ''concise'' than if the prosecution and examination has been conducted on the basis of the ''invention.'' As to what is required, the proposed rule states that reference to the specification by page and line number, and to the drawing, if any, by reference characters is required. Appellant may include any other information of record which will aid the Board in considering the subject matter of each independent claim. The explanation does not have to show how each claim is different. The purpose of the requirement is to aid the Board in considering the subject matter of the independent claims so that an informed review of the examiner's adverse determination of patentability can be made. Whether the explanation is limited to a single drawing or embodiment or is extended to all drawings and embodiments is a decision appellant will need to make.

The proposed concise explanation of the subject matter defined in each independent claim is different from a concise explanation of a reference. It is the applicant who is responsible for drafting claims and choosing the language and terms used to define the claimed invention. 35 U.S.C. 112(2) (''The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.'') As the originator of the claim language, applicant should know what is intended by the various words and phrases used to define the claimed subject matter and thus, providing a concise explanation of the subject matter of each independent claim as proposed should not be an undue burden. This is in contrast to explaining the possible relevance of a document that may not have originated from applicant. Another difference is that the number of independent claims presented for review in an appeal is a matter directly within appellant's control, while appellant does not have control over the number of documents that should be cited to the Office.

The subject matter of each independent claim needs to be concisely explained for a number of reasons. For example, if the Board decides that a rejection is to be reversed for a given independent claim, the remaining independent claims must be reviewed to determine if the reasons for reversing the rejection of the first independent claim apply to the remaining independent claims. Furthermore, if appellant chooses to argue a group of claims which includes more than one independent claim, the

Board will need to review, at the least, each independent claim to determine which claim will be selected as representative of the group. Apart from reviewing the examiner's adverse decision on patentability, the Board may also make new grounds of rejection pursuant to former § 1.196(b) (2003) or make an explicit statement that a claim would be allowable if amended under former § 1.196(c) (2003). The concise explanation of the subject matter of each independent claim will aid the Board in making these determinations.

Comment 54: Several comments address the provision of proposed § 41.37(c)(1)(v) that every means plus function and step plus function as permitted by 35 U.S.C. 112(6) used in the claims be identified and the structure, material, or acts described in the specification as corresponding to each claimed function be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. A number of comments express concern that this requirement may result in a limiting claim construction or create prosecution history estoppel. The comments also take the position that the requirement would be unduly burdensome in that appellant would need to provide this analysis whether a claim limitation was in ''issue'' in the appeal. Another comment indicates that the proposed rule is not clear as to whether it applies to ''all drawings and embodiments, or only a representative drawing.'' Another comment expresses concern that the proposed rule may be subject to abuse, as where an examiner takes the position that claims that are not couched in means-plus-function terminology of 35 U.S.C. 112(6) are nevertheless subject to the provisions of that section and this proposed rule. Suggested changes include using the rule as a procedural tool rather than a substantive requirement or to require only the identification of one or more examples of the support for each independent or separately argued claim, rather than all examples of support for every claim. Another suggested change is that any issues in regard to the Board's need for such an identification in order to reach a reasoned decision be addressed by way of an order under the existing provisions of § 1.196(d) (2003).

Answer: The suggestion is adopted to the extent that every means plus function and step plus function as permitted by 35 U.S.C. 112(6) must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters only for each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of § 41.37(c)(1)(vii). Whether a statement made by an applicant during procurement of the patent from the Office results in an estoppel is a matter that is ultimately decided during proceedings outside the Office. The decision to grant the patent by the Office must be based upon a firm and clear understanding of the scope of the individual claims. If the prosecution and examination of claims involving issues under 35 U.S.C. 112(6) has been based upon individual claims and in accordance with the procedures set forth in MPEP 2181 for claim language involving issues under this section of the statute, it is anticipated that this aspect of the rule will be based upon the statements and determinations already of record and thus does not constitute a significant burden. See MPEP 2181 (explaining that the Office must apply 35 U.S.C. 112(6) in appropriate cases, and give claims their broadest reasonable interpretation, in light of and consistent with the written description of the invention in the application, citing *In re Donaldson*, 16 F.3d 1189, 1194, 29 USPQ2d 1845, 1850 (Fed. Cir.1994)). However, if the prosecution and examination has been based upon the ''invention'' and not individual claims, it may be that appellant will be making statements regarding claim scope for the first time during the appeal proceeding. To the extent this is seen as a burden or creating a possible estoppel, it may be that this is an indication that the case, while eligible for an appeal under the statute and the rules, may not be ready for an appeal.

The comments expressing concern that the proposed rule extends to 35 U.S.C. 112(6) limitations which are not in ''issue'' are presumably based upon the perspective that appellant and the examiner have agreed upon the correct construction of such characterized limitations during the prosecution and examination of the application up to the appeal stage, not that such characterized limitations have been ignored or not commented upon during the pre-appeal proceedings. If the former has occurred, it should not be an undue burden to provide the needed analysis. If the latter applies, appellant will need to directly address each limitation so that the record is clear as to where the underlying structure, steps or materials are described in the written description of the application so that the Board can understand the subject matter of the individual claims presented for review. The suggestion that this provision apply only to the independent claims or claims that are separately argued is adopted.

Issues regarding whether the language chosen by applicant to define a claim limitation falls within 35 U.S.C. 112(6) are discussed in MPEP 2181. Whether specific claim language invokes the provisions of 35 U.S.C. 112(6) is a merits issue to the extent it involves the determination of claim scope. If an applicant believes that an examiner has not followed proper procedure, relief may be had by way of a petition under § 1.181.

The proposal to make this requirement a procedural tool instead of a substantive requirement is not adopted. Claim construction during any stage of a patentability determination is a substantive matter, not a procedural tool, as it controls the substantive application of the law and facts to the claim language under review.

Comment 55: A comment was made in regard to proposed § 41.37(c)(1)(vii) that examiners will sometimes only reject the independent claims or make a ''jumbled'' rejection where it is not clear what arguments apply to which claims. Under these circumstances the comment believes that it is a burden to require appellant to provide separate argument for each and every dependent claim. The comment also states that ''it [the rule or the rejection?] pushes Applicants into the position of having to make potentially prejudicial statements regarding claims, where the Examiner has not initially met the burden of providing a prima facie case of obviousness. Where the grounds of rejection are of the nature that the Examiner has failed to indicate what grounds of rejection apply to a group of claims, Applicants should simply be able to say this, without thereby risking that the group of claims stands or falls together.'' A second comment expresses concern that failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately may impact the ultimate presumption of each claim in an issued patent under 35 U.S.C. 282, noting that the current rule does not contain any waiver provision.

Answer: Patentability must be decided on a claim-by-claim basis. Merits decisions of the Board in ex parte appeals must determine the patentability of individual claims, not whether an ''invention'' is patentable or a group of claims is patentable. Thus, the arguments in the Appeal Brief are

preferably directed to individual claims. If appellant chooses to argue claims as a group as permitted, the Board will pick a single claim to decide the appeal to the group of claims as to that ground of rejection. If the prosecution and examination of a case has proceeded to the point of an appeal without applicant and the examiner discussing the merits of individual claims, that is an indication that the case is not ready for an appeal. If applicant believes that a rejection set forth in an Office action is ''jumbled'' or in any other manner does not clearly communicate the facts and reasons why the individual claims subject to the rejection are unpatentable, relief may be available by way of a petition under § 1.181.

The waiver provision of the proposed rule reflects the view expressed in In re McDaniel 63 USPQ2d 1462, 1468 (Fed. Cir. 2002) (Mayer, C.J. dissenting-in-part) that ''in stating that claims 53–64 stand or fall together, [McDaniel] has waived any argument that claims 55–57 are patentable for reasons independent of claim 53.''

Comment 56: One comment notes that each appeal is unique and that there ''is no good reason for making detailed requirements as to the form of presentation of explanations and arguments in an appeal brief'' as proposed in § 41.37(c)(1)(vii). The comment observes that the ''Office properly assumes that an examiner is capable of responding to any appeal brief under either the existing rule or the proposed rule each of which simply requires 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. The comment asks the questions ''Should not the same simple requirements be in effect as to the appeal brief? What's sauce for the goose should be sauce for the gander?''

Answer: The structure provided for by the requirements of § 41.37 ensures that Appeal Briefs will provide the information the Board needs to render an informed decision on the issues presented for review. While each appeal is unique in regard to the issues and arguments presented, there is certain information common to each appeal which is amenable to being provided by way of a prescribed format. The view expressed in the comment that examiners are under ''simpler requirements in preparing an Examiner's Answer than appellant is in preparing the Appeal Brief'' is misplaced. Detailed guidance to examiners as to procedural requirements in performing their duties and preparing Office actions is typically contained in the MPEP, not the rules. The procedural requirements examiners must follow in preparing an Examiner's Answer are found in MPEP 1208.

Comment 57: One comment suggests that § 41.37(c)(1)(vii) be amended to add the word ''separate'' prior to ''patentability'' in the last sentence. The comment states that this would clarify that pointing out what a claim recites will not be considered an argument for ''separate'' patentability of a claim, since such an argument could in fact establish patentability of that claim without establishing ''separate'' patentability of the claim.

Answer: The suggestion to add the word ''separate'' prior to ''patentability'' in the last sentence has been adopted in § 41.37(c)(1)(vii) and § 41.67(c)(1)(vii).

Comment 58: One comment inquires if the requirement in § 41.37(c)(1)(ix) for an evidence appendix containing copies of any evidence submitted to the examiner and relied upon by the appellant in the appeal was inconsistent with the provision in § 41.7(b) that precludes a party from filing a paper previously filed in the same Board proceeding without Board authorization.

Answer: Section 41.7(b) has been amended so that the requirement in § 41.37(c)(1)(ix) for an evidence appendix containing copies of any evidence submitted to the examiner and relied upon by the appellant in the appeal is consistent with the provisions of § 41.7(b).

Comment 59: One comment suggests that § 41.37(c)(1)(ix) be amended to require identification of ''when the evidence was submitted into the record by Applicants or where in the record that evidence was entered in the record by the Examiner.'' The comment states that this suggestion was made since examiners will frequently not make a positive statement indicating approval of entry into the record of evidence presented by applicants. The comment states that absent specific indication by the examiner that any evidence submitted was refused entry, the evidence is presumed to have been entered as of the submission date. Thus, the suggested change would remove any ambiguity regarding how to comply with this requirement should the examiner not make an affirmative entry of the evidence.

Answer: The suggestion is not adopted. Evidence submitted after final rejection is not presumed to have been entered and must be specifically admitted by the examiner as set forth in § 1.116 as amended by this rule making. Evidence submitted either before the first Office action or after a non-final rejection may be presumed to have been entered only when treated by an examiner in an Office action. Accordingly, the requirement of § 41.37(c)(1)(ix) of a statement setting forth where in the record the evidence was entered in the record by the examiner is met by an explicit statement entering the evidence or implicitly by an Office action weighing the evidence. Prior to filing an appeal brief, if applicants have submitted evidence to the examiner and it is not clear if this evidence has been entered or not entered, appellants should contact the examiner to inquire as to the status of that evidence. For example, if a § 1.132 declaration is timely filed in response to non-final Office action and the next action by the examiner is a final rejection which does not mention the § 1.132 declaration, applicants should contact the examiner to inquire as to the status of the § 1.132 declaration before filing an appeal since a brief arguing that evidence is not permitted by § 41.37(c)(1)(ix). The likely result of such an inquiry would be a new Office action treating the § 1.132 declaration or being informed that the Office has no record of the § 1.132 declaration.

Comment 60: One comment requests clarification as to whether appendixes as required by §§ 41.37(c)(ix-x) are necessary at all when no evidence or related proceedings exist, or whether an appendix must be included with the indication ''none.''

Answer: Sections 41.37(c)(ix-x) require the appeal to contain an evidence appendix and a related proceedings appendix. If no evidence or related proceedings exist, an evidence appendix should be included with the indication ''none'' and a related proceedings appendix should be included with the indication ''none.'' In addition, a brief containing a Table of Contents indicating that no evidence appendix is part of the brief or that no related proceedings appendix is part of the brief would be acceptable under the Rule since it would clearly indicate that no evidence is being relied upon by the appellant in the appeal or that no related proceedings having decisions rendered by a court or the Board exist.

Comment 61: One comment states that it would be useful to have an example of a format and content for an appeal brief that would comply with the new regulations published with the notice of final rule making and ultimately incorporated into the Manual of Patent Examining Procedure.

Answer: An example of a format and content for an appeal brief is a brief

containing the following items, with each item starting on a separate page:

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

(2) Table of Contents page(s)

(3) Real party in interest page(s)

(4) Related appeals and interferences page(s)

(5) Status of claims page(s)

(6) Status of amendments page(s)

(7) Summary of claimed subject matter page(s)

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

(9) Argument page(s)

(10) Claims appendix page(s)

(11) Evidence appendix page(s)

(12) Related proceedings appendix page(s).

Comment 62: One comment suggests that the reference to §§ 41.31–41.37 in § 41.39(a)(1) be changed to refer to § 41.31 or § 41.37.

Answer: The suggestion has been adopted. In addition, a similar change has been made to § 41.69(a)(1).

Comment 63: One comment recommends that § 41.39(a)(1) be amended to clarify the manner in which the Director will notify the public as to the time within which the primary examiner will be required to furnish a written answer to the appeal brief.

Answer: The comment will not be adopted. The Director currently notifies the public as to the time within which the primary examiner is expected to furnish a written answer to the appeal brief in the MPEP. Section 1208 of the MPEP provides that ''[t]he 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.''

Comment 64: Several comments suggest that any new ground of rejection be approved by the appeal conference in the Technology Center or by a Technology Center Director.

Answer: The suggestion is adopted to the extent that the MPEP will provide that each examiner's answer containing a new ground of rejection must be approved by a Technology Center Director or designee. An appeal conference is mandatory in all cases in which an acceptable appeal brief has been filed. The participants of the appeal conference should include (1) the examiner charged with the preparation of the examiner's answer, (2) a supervisory patent examiner (SPE), and (3) another examiner, known as conferee, having sufficient experience to be of assistance in the consideration of the merits of the issues on appeal. During the appeal conference, the participants of the appeal conference will decide whether a new ground of appeal is appropriate. On the examiner's answer, the word ''conferees'' should be included, followed by the typed or printed names of the other appeal conference participants. The appeal conference participants will place their initials next to their name to make clear that the appeal conference has been held. A Technology Center Director or designee must also initial/approve an examiner's answer containing a new ground of rejection.

Comment 65: One comment suggests that allowing the examiner to institute a new ground of rejection in the examiner's answer is unfair to the appellant and the examiner should be required to reopen prosecution.

Answer: If the examiner institutes a new ground of rejection in the examiner's answer, then the appellant has two months to either request that prosecution be reopened by filing a reply under § 1.111 or file a reply brief under § 41.41, which would act as a request that the appeal be maintained. Accordingly, although the examiner may in limited situations institute a new ground of rejection on appeal, the appellant has the right to request that prosecution be reopened. An appellant may not wish to have prosecution reopened if the new ground of rejection is similar to a prior rejection or if the evidence of record is sufficient to address the rejection. Moreover, reopening prosecution may prolong examination without any benefit to the appellant.

Comment 66: One comment suggests that the new arguments are necessary in the appeal brief because the conferees and supervisors are more experienced than the examiner and if the case proceeds to the Board, the audience is an APJ, who has quite different qualifications than either the conferee or the supervisor. Moreover, the comment suggests that the rule is unnecessary because nothing in the rule prevents the examiner from responding to new arguments raised in the appeal brief.

Answer: Former § 1.193(a)(2) (2003) prohibited an examiner's answer from including a new ground of rejection except under very limited circumstances. Accordingly, an examiner could not respond to a new argument raised in an appeal brief by adding a new ground of rejection in the examiner's answer. Because the former appeal rules only allowed the examiner to make a new ground of rejection by reopening prosecution, some examiners have allowed cases to go forward to the Board without addressing the new argument. Section 41.39(a)(2) will improve the quality of examination and possibly reduce pendency by providing for the inclusion of a new ground of rejection in an examiner's answer.

Comment 67: One comment suggests that the Office should require the examiner making a new ground of rejection to acknowledge any mistakes the examiner may have made, explain the time and circumstances in which the new ground of rejection became known to the examiner, and explicitly point out to which arguments in the brief the new ground of rejection is responsive.

Answer: The suggestion will not be adopted. The making of a new ground of rejection in an examiner's answer is in itself an acknowledgment of an error made in the rejection under appeal. Requiring the examiner to explain the time and circumstances in which the new ground of rejection became known to the examiner and to explicitly point out to which argument in the brief the new ground of rejection is responsive would delay prosecution and be of little or no value in determining the appropriateness of the new ground of rejection. As set forth above, a Technology Center Director or designee must initial/approve an examiner's answer containing a new ground of rejection. The Technology Center Director or designee will be aware that allowing a new ground of rejection in an examiner's answer is not open-ended but is envisioned to be rare rather than a routine occurrence. In addition, the Office plans to issue instructions that will be incorporated into the MPEP as to what circumstances would be appropriate for entry of a new ground of rejection in an examiner's answer rather than reopening of prosecution.

Comment 68: One comment suggests that any new grounds of rejection be limited to new rejections made in response to an argument presented for the first time in an appeal brief.

Answer: The comment is not adopted. As set forth above, the Office plans to issue instructions that will be incorporated into the MPEP as to what circumstances would be appropriate for entry of a new ground of rejection in an examiner's answer rather than reopening of prosecution. An examiner will be permitted to make a new ground of rejection in an examiner's answer in the situation where an examiner obviously failed to include a dependent claim in a rejection.

For example, in the final rejection, claims 1, 13, and 27 were rejected under 35 U.S.C. 102(b) as being anticipated by

U.S. Patent No. Y. Claim 27 depended upon claim 22 which depended upon claim 13 which depended upon claim 1. No rejection of claim 22 was set forth in the final rejection; however, the summary sheet of the final rejection indicated claims 1, 13, 22 and 27 as being rejected. In this situation, the examiner would be permitted to reject claim 22 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Y as a new ground of rejection in the examiner's answer. Accordingly, it would not be appropriate to limit new grounds of rejection to only a rejection made in response to an argument presented for the first time in an appeal brief.

Nevertheless, it will be the policy of the Office that, in general, if an appellant has previously submitted an argument during prosecution of the application and the examiner has ignored that argument, the examiner will not be permitted to add a new ground of rejection in the examiner's answer to respond to that argument but would be permitted to reopen prosecution, if appropriate.

Comment 69: Two comments suggests that if the Office introduces a new ground of rejection, then the appellant should have a full range of prosecution options available and not be limited to amendments and/or evidence responding to the new ground of rejection.

Answer: The options provided by § 41.39(b) to respond to a new ground of rejection in an examiner's answer give the appellant the choice of maintaining the appeal or reopening prosecution before the primary examiner. Moreover, if prosecution is reopened, it is reasonable to require that any amendment and/or evidence be responsive to the new ground of rejection. Any such responsive amendment and/or evidence may also be directed to claims not subject to the new ground of rejection. Furthermore, it is noted that the appellant can file a request for continued prosecution pursuant to § 1.114 and then the appellant would be able to submit an amendment and/or evidence directed only to claims unrelated to the new ground of rejection and have such considered by the examiner. Therefore, the appellant does have a full range of prosecution options.

Comment 70: Several comments suggest that although there may be circumstances where the introduction of a new ground of rejection is desirable, the situations where such new ground is introduced should be infrequent.

Answer: As noted in the proposed rule making, the change to permit new grounds of rejection in the examiner's answer is envisioned to be a rare, rather than routine, occurrence. The Office will provide guidance to the examiners in the MPEP as to what circumstances would be appropriate for entry of a new ground of rejection in an examiner's answer rather than reopening prosecution.

Comment 71: One comment suggests that § 41.39(c) be changed to state that extensions under § 1.136(a) are not applicable only to the time period for filing a reply brief under § 41.39(b)(2), thereby permitting an appellant to obtain an appropriate extension of time under § 1.136(a) for filing of a response when re-opening prosecution under § 41.39(b)(1).

Answer: The comment will not be adopted. It is believed to be beneficial to applicant to provide a single mechanism to extend the two-month time period to respond to an examiner's answer containing a new ground of rejection. Having one extension of time provision if the applicant elects to reopen prosecution before the primary examiner and another extension of time provision if the applicant elects to maintain the appeal by filing a reply brief can easily cause problems especially when the applicant has not yet decided which course of action to follow.

Comment 72: One comment asks whether a reply brief filed in response to a new ground of rejection in accordance with § 41.39(b)(2) has to address only the new ground of rejection or all remaining grounds of rejection including those covered in the original appeal brief. The comment also states that it is not clear what is intended by the requirement that the appeal brief should follow the other requirements of a brief as set forth in § 41.37(c).

Answer: A reply brief filed in response to a new ground of rejection in accordance with § 41.39(b)(2) only has to address the new ground of rejection. In such an instance, the reply brief should include the following items, with each item starting on a separate page, so as to follow the other requirements of a brief as set forth in § 41.37(c):

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

(2) Status of claims page(s)

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

(4) Argument page(s)

However, a reply brief filed in response to a new ground of rejection in accordance with § 41.39(b)(2) can be a substitute brief replacing the original brief by responding to both the new ground of rejection and all remaining grounds of rejection covered in the original appeal brief. In such an instance, the reply brief must meet all the requirements of a brief as set forth in § 41.37(c).

Comment 73: One comment suggests that proposed § 41.41 be amended to allow a reply brief to include a new or non-admitted amendment, affidavit or other evidence upon a showing of good and sufficient reasons why they are necessary and were not earlier presented.

Answer: The suggestion is not adopted. An appeal should be decided upon a fixed record, not an ever-changing one. While it is proposed to allow examiners to make a new ground of rejection once again, the appellant may request prosecution be reopened under proposed § 41.39(b)(1) to supplement the record. Absent a new ground of rejection in the Examiner's Answer, the record before the Board should remain fixed as of the date the appeal brief is filed so that a reasoned review of the record may efficiently take place.

Comment 74: Two comments express concern that the option of permitting a supplemental examiner's answer to respond to a new issue raised in a reply brief could be construed as to permit a supplemental answer in almost any case and lead to a repeated exchange between the examiner and the appellant that would not promote a just, speedy, or inexpensive resolution of the proceeding. One comment notes that there may be rare circumstances when such a supplemental examiner's answer is appropriate. That comment suggests that the number of supplemental examiner's answers be limited to one unless personally approved by the Commissioner for Patents or one of his deputies.

Answer: The suggestion is adopted to the extent that the MPEP will provide that each supplemental examiner's answer must be approved by a Technology Center Director or designee.

Comment 75: One comment suggests that the comments made in the background discussion of proposed § 41.43(a)(1) be changed to remove any prohibition on the right by the appellant to file a reply brief. The comment states that appellants should have the right to file a reply brief in any situation. The comment notes that the Office had an earlier procedure that specified situations in which reply briefs could be

filed and that this resulted in disputes and petition filings, where the examiner and the appellant disagreed as to whether the filing of a reply brief was permissible. The comment observes that the now-superseded rules no longer prohibited the filing of a reply brief and suggests that this practice should continue and that appellants should always be permitted to have the last word.

Answer: Former § 1.193(b) (2003) provided that an 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. Section 41.41(a)(1) provides that an appellant may file a reply brief to an examiner's answer within two months from the date of the examiner's answer and § 41.43(b) provides that if a supplemental examiner's answer is furnished by the examiner the appellant may file another reply brief under § 41.41 to any supplemental examiner's answer within two months from the date of the supplemental examiner's answer. Thus, the rules continue to permit the appellant to always have the last word. That is, the appellant may always 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. The background discussion of proposed § 41.43(a)(1) noted that an indication of a change in status of claims (*e.g.*, that certain rejections have been withdrawn as a result of a reply brief) is not a supplemental examiner's answer and therefore would not give the appellant the right to file a reply brief. This is not a change from current practice where an examiner is permitted to respond to a reply brief by indicating a change in status of claims (*e.g.*, that certain rejections have been withdrawn as a result of a reply brief) on form PTOL–90. This indication of a change of status is not a supplemental examiner's answer and therefore the appellant has no right to file a further reply brief.

Comment 76: One comment suggests that the second sentence (An appeal decided on the briefs without an oral hearing will receive the same consideration by the Board as appeals decided after an oral hearing) of § 41.47(a) be deleted. The comment believes that the statement that an appeal without an oral hearing will be decided the same way as an appeal with an oral hearing denies the fact oral and written presentations differ in many respects and the fact that oral presentations are not cut and dried like many written briefs.

Answer: The comment will not be adopted. While oral and written presentations do differ in many respects, an appeal decided on the briefs without an oral hearing does receive the same consideration by the Board as appeals decided after an oral hearing.

Comment 77: Four comments state that the proposed requirement of § 41.47(e) that at the oral hearing, the appellant may only rely on evidence that has been previously entered and considered by the primary examiner and present argument that has been relied upon in the brief or reply brief was too rigid. Most of the comments believe that an appellant should be able to make an argument not present in the briefs if good cause is shown such as new law or facts. One comment submits that demonstrative exhibits should not be precluded by this requirement.

Answer: Section 41.47(e) has been amended to permit the appellant and/or the primary examiner, upon a showing of good cause, to rely on a new argument based upon a recent relevant decision of either the Board or a Federal Court. In addition, a demonstrative exhibit (*e.g.*, a sample of the invention as shown in the application's drawings) solely directed to information of record that is not being relied upon to establish patentability is not precluded by this rule.

Comment 78: One comment states that there does not appear to be any limitation on the authority to cancel requested Oral Hearings as set forth in proposed § 41.47(f). The comment notes that the commentary to the proposed rule indicates that the rule would be applied where a remand to the Examiner is necessary or where the Examiner's position could not be sustained. The comment suggests that the rule could be clarified by adding, for example, ''in order to remand to the Examiner or to grant the requested relief'' after ''if the Board decides that a hearing is not necessary'' but before the comma. Another comment suggests that § 41.47(f) be amended after ''notify appellant'' to state ''and provide the appellant an opportunity to indicate whether or not to hold an oral hearing'' to make it clear that a party is entitled to an oral hearing if the party notifies the Board timely and pays the fee for an oral hearing.

Answer: The suggestions will not be adopted. The substance of § 41.47(f) is found in former § 1.194 (2003) and therefore no substantive change was proposed. Moreover, in a situation where the Board has decided that no hearing is necessary because the Board has become convinced, prior to hearing, that the examiner's position will be reversed or the proceeding needs to be remanded, there is no reason to provide the appellant with an opportunity to nevertheless hold an oral hearing. The Manual of Patent Examining Procedure will provide examples as to when it would be appropriate for the Board to decide that an oral hearing is not necessary. Currently, those examples include those where the Board has become convinced, prior to hearing, that an application must be remanded for further consideration prior to evaluating the merits of the appeal or that the examiner's position cannot be sustained in any event.

Comment 79: Three comments note that § 41.50(a)(2) did not set any time limit for taking action to respond to a supplemental examiner's answer written in response to a remand by the Board for further consideration of a rejection.

Answer: The comment has been adopted. Section 41.50(a)(2) has been amended to provide a two-month period for response.

Comment 80: One comment requests that each action and decision of the Board should explicitly set forth the options, time limits, and extension of time practice available for taking further action.

Answer: The Board will consider including options, time limits, and extension of time practice in its decision.

Comment 81: Two comments inquire as to the justification for dismissal of an appeal of all claims (proposed §§ 41.50(a)(2) and 41.50(d)) rather than those that may be subject to a new rejection as in proposed § 41.39(b). One comment urged that in the absence of a compelling reason to treat these situations in a different manner that the Office adopt the practice that results in the dismissal of the appeal only as to the claims affected by the Office action. The other comment urged with respect to § 41.50(d) that the dismissal penalty for non-response be removed and that the Board be permitted to make any appropriate presumptions in view of the non-response.

Answer: We will adopt the suggestion to the following extent. Section 41.50(a)(2) has been amended to provide that if a supplemental examiner's answer is written in response to a remand by the Board for further consideration of a rejection pursuant to § 41.50(a)(1), the appellant must exercise one of two options to avoid sua sponte dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding.

Section 41.50(d) has not been amended since it provides that failure to timely comply with an order of the Board may result in the sua sponte dismissal of the appeal. Thus, the Board may take the action that is appropriate under the facts of each proceeding.

Comment 82: One comment notes that proposed §§ 41.35(c) and 41.50(a)(1) provide for remand of an application to the examiner. The comment urges the Board to exercise the remand authority in a manner that takes into appropriate account the possible patent term extension/adjustment consequences of a remand that is tantamount to a reversal of the rejections of at least one claim in an appeal. In taking actions to dispose of appeals, the comment states that the Board needs to be aware of and take into appropriate account the possible implications of its actions on eligibility for patent term extension/adjustment and seek to avoid taking action that would possibly deny some applicants potentially very valuable rights under 35 U.S.C. 154(b). As one example, the comment asserts that the Board should not remand an appeal to the examiner when the examiner has failed to establish a prima facie case of unpatentability, but instead the Board should reverse the rejection(s) and permit the examiner to take appropriate action when the file is returned to the jurisdiction of the examining group. Another comment suggests that the examples of situations where the Board may remand an appeal to the examiner made in the background discussion of proposed § 41.50(a)(2) be deleted and that the Board in fact discontinue the practice covered by the examples. The comment states that the Board is an impartial panel resolving disputes between appellants and examiners and that no special consideration should be given by the Board to an examiner's position. The comment states that the examiner must establish a prima facie case of anticipation or obviousness, which the appellant must persuasively demonstrate to be in error. The comment asserts that just as the Board would not give the appellant an opportunity to present a more persuasive traversal, the Board should not give an opportunity to the examiner to more clearly meet his or her burden. The comment expresses the view that if a prima facie case of unpatentability was not adequately made by the examiner, the rejection should be reversed.

Answer: The comments are not adopted. It is within the discretion of the panel of the Board deciding the appeal to determine the best course of action. A panel may conclude that the best course of action in deciding a rejection is to either (1) remand to the examiner for further consideration of the rejection; (2) order the appellant to brief additionally a matter concerning the rejection; (3) reverse or vacate the rejection (with or without a remand to the examiner for further action); or (4) affirm the rejection. While the examples of situations where the Board may remand an appeal to the examiner made in the background discussion of proposed § 41.50(a)(2) could also be examples of situations where the Board may reverse the rejection, the Office believes that appellants' rights are protected in such a situation since appellants under the provisions of § 41.50(a)(2) can choose to respond to any supplemental examiner's answer written in response to a remand by the Board for further consideration of a rejection by either (1) requesting that prosecution be reopened before the examiner by filing a reply under § 1.111 of this title with or without amendment or submission of affidavits (§§ 1.130, 1.131 or 1.132 of this title) or other evidence; or (2) requesting that the appeal be maintained by filing a reply brief as provided in § 41.41. The panel of Administrative Patent Judges deciding the appeal will determine if and when a remand is appropriate. A final decision on appeal can only be reached when the record is susceptible to meaningful review. A significant number of remands result from cases that have been assigned to a merits panel for final decision where the record is unclear. For example, it has been the Board's experience that cases in which amendments and additional evidence have been filed during the appeal process including with the Reply Brief oftentimes have a confusing record. Sometimes the record does not indicate that the examiner considered the amendment and/or additional evidence or the record indicates that the amendment and/or additional evidence has been ''entered'' by the examiner without comment. Such cases need to be remanded/returned to the examiner to clarify the record as to the status of the amendment and/or additional evidence and if the material is entered have the examiner enter a substantive response. It may be that upon remand the examiner will determine upon a clarified record that the claims are patentable and pass the case to issue. It is expected that the proposed limits on the presentation of amendments and/or evidence after the notice of appeal (see § 41.33) has been filed will minimize such occurrences.

Comment 83: Two comments state that the proposed requirement of § 41.52(a) that in a request for rehearing the appellant may only rely on evidence that has been previously entered and considered by the primary examiner and present argument that has been relied upon in the brief or reply brief was too rigid. The comments believe that an appellant should be able to make an argument not present in the briefs if good cause is shown such as new law or facts.

Answer: Section 41.52(a) has been amended to permit the appellant, upon a showing of good cause, to rely on a new argument based upon a recent relevant decision of either the Board or a Federal Court.

Part 41, Subpart C—Inter Partes Appeals

Comment 84: One comment points out that the recitation in proposed § 41.66(a) that, ''if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so,'' appellants brief will be due upon ''the expiration of time for filing (by the last party entitled to do so) such notice of appeal or cross appeal'' is confusing. The comment points out that it is not clear how an appellant A can know whether another party B will file a notice of appeal or cross appeal on the last day of the time period for filing same. If such a notice of appeal is then filed by party B, party A's appellant brief would be due two months from the date the notice of appeal is filed by party B, whereas if party B does not file it, party A's appellant brief would be due by party A's ''original'' last day for filing the appellant brief.

Answer: The comment has been adopted. The comment suggests that the rule, as proposed, was open to more than one interpretation, because it can be read to suggest that the brief is due upon ''the expiration of time for filing (by the last party entitled to do so) such notice of appeal or cross appeal.'' While a fair reading of the rule as proposed would be that the brief must be filed within two months from the latest filing of the last-filed notice of appeal or cross appeal, or within two months from the expiration of time for filing such notice of appeal or cross-appeal, the comment's interpretation is also tenable. Accordingly, in the interest of clarity the rule has been amended to more clearly state that the brief is due within two months from the latest filed notice of appeal or cross appeal or within two months from the expiration of the time for filing a notice of appeal or cross appeal, whichever is later.

Comment 85: One comment suggests that § 41.68(a)(4) be amended by adding the word ''other'' to indicate that ''[a] requester's respondent brief may not address any brief of any other requester.'' The comment states that the requester should be able to refer to any arguments made in a previously filed brief by that same requester.

Answer: The comment has been adopted. The last sentence of former § 1.967(a) (2003) provided that ''a third party respondent brief may not address any brief of any other third party.'' This prohibition was to prevent multiple requesters from addressing the briefs of other requesters which would make the proceeding unmanageable. Former § 1.967 (2003) contained no prohibition preventing a requester from referring to its own previously filed brief. The word ''other'' was inadvertently omitted from the proposed § 41.68. Accordingly, the comment is adopted and the word ''other'' has been inserted in the rule as suggested.

Comment 86: One comment suggests that paragraphs (b) and (c) of § 41.69 be eliminated from the rule. The comment urges that the examiner should not be required to reopen prosecution if he or she is persuaded by the brief filed that a rejected claim is in fact patentable or that a claim found patentable is in fact unpatentable. The comment further suggests that proposed § 41.69(d) should be amended to require that ''any proposed new ground of rejection, or any proposed new determination not to make a proposed rejection, shall be stated by the examiner in a separate section of the examiner's *Answer*, and shall include reasons why the examiner has been persuaded to propose such new ground of rejection or new determination not to make a proposed rejection, referring to the corresponding arguments in the requester's or owner's briefs.''

Answer: The comment has not been adopted. Section 41.69 was proposed to generally incorporate the requirements of former § 1.969 (2003) which relate to the examiner's *Answer*. The rule making did not propose to change the current practice set forth in paragraphs (b) and (c) of § 41.69 and paragraphs (b) and (c) of former § 1.969 (2003). The comment has been forwarded to the Deputy Commissioner for Patent Examination Policy for further consideration.

Part 41, Subpart D—Contested Cases

Comment 87: One comment suggests that subpart D be modified to take title proceedings under 42 U.S.C. 2182(4) and 2457(d) into consideration. The comment does not suggest specific modification.

Answer: Subpart D is designed to address all contested proceedings that currently occur before the Board, including title proceedings under 42 U.S.C. 2182(4) and 2457(d). Title proceedings constitute a very small percentage of the overall number of contested cases (about 1%). If a need arises for special rules specific to the title cases, they would most likely be placed in a new subpart, just as subpart E addresses specific issues arising in patent interferences.

Comment 88: One comment suggests that § 41.102(a) is confusing since it suggests that examination must be complete before a contested case will be initiated, but that the declaration of an interference means that the question of priority has yet to be resolved. The comment urges that the phrase ''interfering subject matter * * * which is patentable to the applicant subject to a judgment in an interference'' from § 1.607(b) (2003) be included in § 41.102(a).

Answer: Section 41.102(a) has been amended to include similar language to that suggested, but it has been generalized since subpart D is not limited to interferences. For instance, patentability might not be an issue in a title proceeding under 42 U.S.C. 2182(4) and 2457(d).

Comment 89: Two comments express concern that the filing of a reexamination could delay the initiation of a contested case.

Answer: A simultaneously pending reexamination and interference involving the same patent has been very rare. Section 41.102 provides the Board with the flexibility to tailor a specific solution to such occurrences as they arise. See also § 1.565(e) and § 1.993. The requirement under 35 U.S.C. 305 and 314(c) for special dispatch in reexaminations will inform any solution that the Board may craft.

Comment 90: Section 41.103 suspends action in any case involved in a contested case before the Board except as the Board may order. Two comments request that § 41.103 be modified to require the Board to provide notice of when the suspension is lifted.

Answer: The judgment in the involved case will constitute adequate notice that the suspension is no longer in effect. Moreover, the suspension only applies to involved files, not to ancillary files like benefit files, which may still be pending. A response to any outstanding Office action in an ancillary file should be timely filed to avoid abandonment.

Comment 91: Two comments oppose § 41.104(b), which allows an administrative patent judge to waive or suspend a rule in subpart D subject to such conditions as the administrative patent judge may impose. Both comments fear that the rule will permit arbitrariness.

Answer: The rule does not authorize arbitrariness, which if it were to occur would be subject to correction. See § 41.125(c)(5). Moreover, the rule reflects current practice under the Standing Order at ¶ 21, under which an administrative patent judge may modify the Standing Order. The present rules incorporate many portions of the Standing Order and, consequently, incorporate the provision of the Standing Order that permits their modification.

There is a tension between adding so much detail in the rules that they become too constrictive and including so little that parties lack guidance about what is required. Section 41.104(b) is intended to strike a balance by letting the rules include more detail, and thus provide a basis for counseling clients, but also provide a remedy for when a rule does not facilitate the goal of an inexpensive, fast, and fair proceeding. See § 41.1(b). The responses that the Board has received regarding increased flexibility in interferences have been generally good. Rather than eliminate the flexibility provided in § 41.104, lest it be abused, it is better to address any abuse as it arises. No comment objected to § 41.104(c), which provides similar flexibility for the setting of times.

Comment 92: One comment discusses an instance under the previous rules in which, the comment suggests, a waiver occurred that was not fair.

Answer: Too few details were provided to make discussion of the example feasible. However, if a waiver is arbitrary or unfair, the injured party has a remedy before the Board, § 41.125(c)(5), and during subsequent judicial review. It is up to the party to preserve the issue and to pursue its remedies.

Comment 93: One comment is concerned that such waivers could change the substantive requirements for motions.

Answer: The Board has cautioned against confusing procedural requirements for motions set in the rules with the substantive requirements of the patent statutes and case law necessary to prevail in a motion. *Hillman* v. *Shyamala*, 55 USPQ2d 1220, 1221 (BPAI 2000). Moreover, only the general contested case rules in subpart D are subject to a § 41.104(b) waiver. The presumptions and showings required in subpart E are outside the scope of § 41.104(b).

Comment 94: One comment urges that a waiver provision in the rules is

contrary to administrative law, citing *United States* v. *Nixon*, 418 U.S. 683, 686 (1974).

Answer: The cited page has no bearing on waiver of rules. The case read as a whole supports the rule. At page 696, the Court explained that the Attorney General must comply with his own rule precisely because he had not reserved the power to act otherwise without changing the rule. In § 41.104(b), the rule specifically authorizes the Board to change a rule within subpart D. The rule is consistent with statute as well since a procedural requirement can be changed without notice and comment rule making. 5 U.S.C. 553.

Comment 95: One comment urges modification of § 41.106(a)(1), which requires all papers from a party to be the same size absent some compelling reason for a larger paper size. The comment suggests saying ''different'' rather than ''larger''.

Answer: Larger in this context means larger in any dimension that prevents reproduction without loss of detail. A smaller exhibit can be reproduced on standard (A4 or 8½ x 11″) paper without loss of detail. Indeed, it may sometimes be advisable to enlarge a small exhibit to take advantage of the additional space. Many larger exhibits can be effectively reduced to a standard paper size without loss of detail. The rule recognizes, however, that many exhibits will not be readily reduced to a standard paper size. Consequently, the rule provides parties with the flexibility to use a larger paper size when it is truly necessary.

Comment 96: Section 41.106(a)(2)(ii) requires papers to be double-spaced except for headings, signature blocks and certificates of service. One comment suggests that tables of contents should be added to the list of exceptions.

Answer: Section 41.106(a)(2)(ii) has been modified to include tables of contents, tables of authorities, and indices.

Comment 97: A second comment suggests additional formatting requirements, particularly a page limit or word count along the lines of Federal Rule of Appellate Procedure 32(a)(7).

Answer: The suggestion is outside the scope of what was proposed, but may be addressed in a pilot program or in a future rule making. For instance, in the electronic filing pilot program for interferences, word counts might be permitted as an incentive to parties to file text-searchable papers.

Comment 98: One comment opposes the requirement in § 41.106(b)(1)(ii) and (b)(2) for a distinctive cover sheet and two-hole punched paper, respectively. The comment suggests that the Board provide these formalities on its own.

Answer: These requirements were introduced to facilitate interference paper handling within the Board. Experience over the past five years, since these requirements were introduced, show a vast improvement over past practice. All of that improvement would be lost if the comment were adopted. As the supplementary information explained, these formalities are based on the practices of courts that regularly review Board decisions.

These requirements do not apply to interferences in the electronic filing pilot program and would not likely apply in any permanent electronic filing system. The Office expects to develop an electronic filing system for contested cases over the next several years. In the meantime, participation in the pilot program will permit a party to avoid these two formalities.

Comment 99: One comment opposes the prohibition in § 41.106(b)(3) on incorporation by reference from other papers and on combined papers.

Answer: Incorporation by reference and combination of papers are short-sighted remedies for a party. While they may reduce the length of a paper, they do so at the cost of obscuring the flow of the party's argument and often result in disjointed presentations lacking sufficient connecting explanation. Frustrating and confusing the decision-maker is never a wise strategy. The rule prohibits a practice that parties would be well-advised to avoid in any case.

Comment 100: One comment urges that a rule is not the appropriate place for § 41.106(b) formalities because a petition would be required for relief.

Answer: The formal requirements in § 41.106(b) had previously been promulgated through the Standing Order. Whether in the Standing Order or in a rule in subpart D, the remedy would be the same: A miscellaneous motion (§ 41.121(a)(3)) for relief from the requirement rather than a petition. Note that under § 41.104(a) waiver of a rule in subpart D can be granted on a motion. The reason for placing these requirements in the rule is to reflect the fact that they are presently required for nearly every paper in every case.

Comment 101: One comment seeks clarification of whether the extra copy required under § 41.106(c) applies to papers filed electronically.

Answer: Electronic filing is currently a pilot program and is administered under an additional order that waives the extra copy requirement. As noted above, electronic filing will likely eliminate many of the formalities now associated with filing in paper. Once an electronic filing system for contested cases has been developed, it is expected that a rule will be proposed to address the separate requirements for such filings.

Comment 102: Two comments call for § 41.106(d) to address hand filing expressly. One of the comments requests adoption of the current practice permitting hand filing at the Board by 10 a.m. the next business day after the due date. The other comment recommends addressing hand filing with the Office mail room and overnight delivery services.

Answer: Section 41.106(d)(2) has been amended to list hand filing expressly along with electronic filing as a filing mode that the Board may authorize by order. Hand filing with the Office mail room is not equivalent to hand filing with the Board since even subtle mistakes in the way the paper is addressed can result in its being misdirected within the Office for long periods of time.

As a matter of policy, the Office has accepted the EXPRESS MAIL® service of the United States Postal Service as equivalent to hand filing with the Office. A properly addressed EXPRESS MAIL® filing is also likely to arrive promptly. Use of overnight delivery services and other forms of hand delivery to the Board will continue to be treated by order. Although the current practice of hand filing at the Board is popular, uncertainties regarding security and access to the new Board facilities in Alexandria, Virginia, counsel against codifying this practice at this time despite its present success.

Comment 103: One comment suggests clarifying § 41.106(e)(3) to state that overnight delivery is required as the alternative to EXPRESS MAIL®.

Answer: Other forms of prompt delivery might also be appropriate, including facsimile service or electronic service (with Board authorization). The purpose of the rule is to provide parties with some latitude in meeting the service requirement, while still requiring promptness. In any case, a party whose mode of service takes much more than a day may find its options limited by order.

Comment 104: Four comments request clarification of § 41.106(e)(4) about whether the date to be excluded from calculating response periods is the date of service or the date that service is received.

Answer: The rule has been amended to ''The date of service'' to be consistent with § 41.123 and § 41.155.

Comment 105: Section 41.106(f)(3)(i) requires a certificate of service to name

each paper served. The comments suggest that the use of ''each'' is confusing since the paper named is the same paper that incorporates the certificate of service under § 41.106(f)(1).

Answer: The proposed rule referred to exhibits, which can be served as a group. To address the concern raised by the comments, § 41.106(f)(3)(i)–(iii) have been reordered to place paragraph (i) last. Moreover, the paragraph in question has been revised to say ''for exhibits filed as a group, the name and number of each exhibit served.''

Comment 106: One comment suggests that § 41.108, which addresses identification of counsel, include a reference to registered patent agents who are not attorneys.

Answer: Section 41.108 uses ''counsel'' to be consistent with § 41.5. Both rules are intended to include, not exclude, registered patent practitioners and any person recognized to act pro hac vice.

Comment 107: Section 41.109(a) does not retain the practice of § 1.612(a) (2003) of withholding access to § 1.131 and § 1.608 (2003) (now § 41.202(d)) declarations in involved applications. Three comments request that the practice be restored. Two of the comments suggest that the practice be restored for all unpublished applications, or equivalently that pre-29 November 2000 applications be grandfathered out of the rule. One comment suggests that the practice be restored for § 41.202(d) showings because, unlike § 1.131 declarations, they relate directly to the junior party's priority case without otherwise reflecting on patentability and thus, according to the comment, only serve to expose the junior party's priority case.

Answer: Part of the original intent of the rule change was to balance the playing field between applicants and patentees since any § 1.131 or § 1.608 (2003) declaration in a patent would be publicly available. In many cases, the junior party is a patentee so no showing will have been filed or it will already be publicly available. Moreover, while the declarations were removed under § 1.612(a) (2003), other papers that discussed the declarations were not, so the protection offered under the rule was not very extensive.

The difference suggested in one comment between declarations under § 1.131 and § 1.608 (2003) is not so great since in both cases the Office will have relied on the declaration to reach the conclusion that all patentability issues in the application other than priority have been resolved. The showing under § 41.202(d) does not require the applicant to put on its entire priority case. It only need put on enough of a case to show priority assuming the opposing party puts on no case at all. Often this will be much less than the applicant could or ultimately will prove. For instance, if the applicant has a filing date of August 15, while the patentee's application was filed on August 7 with an inventor's declaration dated August 5, then a proof of conception before August 5 and diligence from at least August 4 will generally suffice.

In any case, starting later this year, these papers will be available over the internet in published applications with an image file wrapper. Soon it will not make sense to try to withhold a § 1.131 declaration or a § 41.202(d) showing in most cases because it will have already been publicly available.

There may be some instances when the paper has not been made public and an applicant could show undue prejudice if the paper were made available to its opponent. Such cases are best left to case-by-case development. An applicant may promptly move (§ 41.121(a)(3)) as soon as the interference is declared to have its § 41.202 showing withheld. If the Board grants a motion to withhold a § 41.202(d) showing, it will advise the Office of Public Records, which may then remove the showing from the file after it has been printed.

Comment 108: One comment suggests that § 41.109(a) permit the requesting of certified copies. According to the comment, the Office of Public Records currently fills requests for certified copies in interferences by sending uncertified copies, which the comment asserts are more likely to have missing pages.

Answer: Nothing in § 41.109(a) prevents a party from requesting a certified copy. The rest of the comment is directed to operation of the Office of Public Records, a matter outside the scope of this rule making, and would not be solved by changing the rule as requested. Instead, the comment has been referred to the Office of Public Records.

The image file wrapper, which is now the official record of the application within the Office, should be much less prone to copying mistakes. Consequently, if pages appear to be missing, the absence of those pages accurately reflects the official contents of the file.

Comment 109: Section 41.110(a) requires each party to file a clean copy of its involved claims. One comment suggests that the requirement include uninvolved claims in the involved application or patent in case a party subsequently moves to add, or designate as corresponding to a count, one or more uninvolved claims.

Answer: The present rule strikes a balance between having a clear statement of the claims and imposing costs on parties by making a party responsible for its own involved claims. A clean copy of any claim to be added should be included with any motion to add the claim, § 41.110(c). Imposing the additional cost of providing clean copies for uninvolved claims against the possibility that one might be added would typically be an unnecessary added expense. Nothing in the rule bars a party from filing a clean copy of uninvolved claims as well if doing so would be easier for the party filing the clean copy.

Comment 110: One comment urges that annotated claims should not be required until preliminary motions, oppositions, and replies have been filed. A second comment suggests that annotated claims not be required until after preliminary motions have been decided. Four comments express concern about the potential estoppel effect of filing annotated claims.

Answer: Notice is a core function of a patent claim. *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1028 (Fed. Cir. 1997). An applicant has wide latitude to claim its invention as it sees fit, but the vital notice function of claims imposes a corresponding duty to claim clearly and distinctly. *Id.*, 127 F.3d at 1056, 44 USPQ2d at 1029. An attempt to avoid prosecution estoppel is never a valid reason for an applicant to evade a clear indication of what its claim means. *Id.*, 127 F.3d at 1056, 44 USPQ2d at 1030. The suggestion that a party should not be accountable for the meaning of its claims is utterly inconsistent with the purpose and sound functioning of the patent system.

Claim annotation is vital to the efficient administration of contested cases because it provides the Board and opposing parties with a starting point for understanding how the party intends its claim to be read. It also serves as a stimulus for the parties to take a close look at their claims to see if there are latent problems that need to be addressed before motions are filed.

The Board expects the claim annotation to be complete and accurate. As a practical matter, the Board has permitted parties to point out additional support consistent with their claim annotation. In the event that a party makes a mistake, it can seek correction through a miscellaneous motion (§ 41.121(a)(3)). Parties moving to correct, and parties opposing such

motions, should note that prejudice to the opposing party will be an important element in deciding whether to grant relief.

Comment 111: One comment opposes what it contends is a requirement to submit annotated claims more than once.

Answer: The rule does not require more than one annotation for each claim. No additional annotations are required unless a claim is added or amended (§ 41.110(c)(3)). If a claim is added or amended, it is a new claim and requires annotation. Note that the requirement could be waived at a conference call discussing the motion; for instance, a minor grammatical amendment to a claim that has otherwise been properly annotated might not require a new annotation.

Comment 112: Three comments suggest that the phrase ''add a reissue claim'' in § 41.110(c) is either a mistake or too narrow.

Answer: Section 41.110(c) is amended to delete the word reissue. The intent of the rule is to require a clean copy, a claim chart showing written description, and an annotated copy (when applicable) of any added claim, including added claims in a reissue application.

Comment 113: One comment urges that the requirements of § 41.120(a), regarding the notice of bases for relief, is too vague, particularly given the consequences that attend such notices in § 41.120(b) and (c). The comment suggests that the current motions list practice be adopted instead.

Answer: Section 41.120 authorizes the Board to require a notice outlining how a party intends to litigate a contested case. Since the type of notice will vary with the type of case, greater detail in the rule is not possible. Moreover, the notice is not automatically required except in the case of a priority statement under 41.204(a). Hence, when the Board requires such notice, it will also specify what must be shown.

Comment 114: One comment opposes § 41.120(b), which requires a party filing a notice of basis for relief to file only motions consistent with the notice. The comment considers the rule to be a trap for the unwary and particularly objects to the word ''ambiguities'', which may be construed against a party.

Answer: Under existing practice for preliminary statements, which are the closest present analog of the notices under § 41.120, a party would be strictly held to its alleged dates with ''[d]oubts as to definiteness or sufficiency of any allegation * * * resolved against the party filing the statement'', § 1.629(a) (2003). Similarly, § 1.629(e) (2003) noted that a preliminary statement was not evidence for a party, but left open the possibility that a party would be estopped from denying an allegation in its preliminary statement. Preliminary statements have been routinely used as admissions, for instance in the context of an order to show cause under § 1.640(d)(3) (2003). A comparable practice has existed with regard to § 1.608 (2003) declarations and summary judgment under § 1.617 (2003).

Section 41.120(b) does not change the requirements for finding an admission, but simply places a party on notice that its statements could be used as an admission.

Comment 115: One comment cites cases for the proposition that the standard for finding an admission is high. *Harner* v. *Barron,* 215 USPQ 743 (Comm'r Pats. 1981); *Flehmig* v. *Giesa,* 13 USPQ2d 1052 (BPAI 1989); *Suh* v. *Hoefle,* 23 USPQ2d 1321 (BPAI 1991); *Issidorides* v. *Ley,* 4 USPQ2d 1854 (BPAI 1985); *Ex parte McGaughey,* 6 USPQ2d 1334 (BPAI 1988). The comment does not, however, point to the parts of the cases that the comment considers to be inconsistent with the rule.

Answer: The cases provide examples where Board panels, or in one case a Commissioner reviewing the action of a Board employee, found a lack of an admission of the facts of the particular case. None creates a bar against finding admissions. The only effect that § 41.120(b) might have on these precedents is that, by placing the party explicitly on notice that its statements might be treated as an admission, it might make the showing of an admission somewhat easier.

Comment 116: One comment urges that the standard for correcting a notice of basis for relief in § 41.120(c) is like the standard for correcting a preliminary statement, and thus too strict for correcting motions lists.

Answer: Under § 41.204(a), the priority statement is a kind of notice of basis for relief, so the preliminary statement correction practice is appropriate in such cases. In other cases where the Board has required such notice and specified what must be shown, the strict interests-of-justice standard is also appropriate because the party has actual notice that it will be strictly bound. The rule does not prevent the Board from requiring other notices that are easier to correct.

Comment 117: One comment opposes § 41.121(a) because it views simultaneous filing of preliminary motions and priority motions as onerous and as unfair to the target of a provoked interference. A second comment applauds the removal of the prohibition on simultaneous filing of preliminary and priority motions.

Answer: The rule does not require a change in current practice and ordinarily will not result in simultaneous filing of such motions. The Board will continue to set the times for filing motions (§ 41.123(a)), including setting different times for different motions.

Preliminary motions—those affecting threshold issues, count scope, and benefit—will generally precede any priority motion since a decision on such motions will affect the scope and complexity of any priority case that must be presented. The main effect of the rule is to have the priority case presented as a motion whenever it is filed. The Board will have the authority to advance consideration of priority issues in an appropriate case, but such cases are expected to be exceptional.

Comment 118: One comment views § 41.121(a)(1) as unduly circumscribing the Board's authority under 35 U.S.C. 135(a) to reach patentability questions in an interference. The comment suggests that a ''when justice requires'' test for reaching extrinsic patentability issues would be desirable.

Answer: The rule does not limit the Board's authority to address patentability questions as long as they relate to a change in the scope of the interference or to a change in the accorded benefit, or are otherwise likely to lead to judgment in the case. It does not seem likely that justice would require the Board to address a patentability issue that cannot otherwise be plausibly related to the issues in the contested case. If a patentability issue arises that cannot be reached under § 41.121, but should be reached in the interest of justice and is otherwise within the scope of the Board's authority, a party could seek relief under § 41.104 by filing a miscellaneous motion (§ 41.121(a)(3)).

Comment 119: One comment suggests that § 41.121(a)(2) be amended to remove the authority to cancel a claim. The comment suggests that § 41.121(a)(2) is unfair because a patentee cannot cancel a claim. The comment indicates that the option of canceling a claim might be misunderstood by a party as being without cost.

Answer: A patentee can disclaim a claim under 35 U.S.C. 253.

Authorization to cancel a claim does not mean that no consequence would attach to the cancellation. For instance, cancellation of all involved claims would result in judgment against the

canceling party (§ 41.127(b)(2)). Cancellation of a claim in response to a motion attacking the claim would be a concession of the issue with respect to that claim and would create an estoppel (§ 41.127(a)), just as amending a claim can create an estoppel. Section 41.121(a)(2) is amended to remove claim cancelling as an express option to avoid its being requested too casually, although cancellation and disclaiming remain options under the ''otherwise cure a defect'' provision of § 41.121(a)(2).

Comment 120: Three comments suggest that a preponderance of the evidence standard be added to § 41.121(b).

Answer: Not all issues arising by motion are subject to a preponderance of the evidence standard. For instance, a junior party that filed its application after a patent issued to the senior party would have to prove priority under the clear and convincing evidence standard (§ 41.207(a)(2)). The default evidentiary standard in civil proceedings is the preponderance of the evidence standard. *Price* v. *Symsek,* 988 F.2d 1187, 1193, 26 USPQ2d 1031, 1035 (Fed. Cir. 1993). Codifying the default standard, would require the rules to list every exception. Consequently, the suggestion is more likely to cause confusion than to resolve it.

Comment 121: One comment notes the elimination from § 41.121(c) of precise directions for specific kinds of motions like those found in § 1.637 (2003). The comment expresses the hope that the requirements of § 1.637 (2003) not linger as an unwritten requirement.

Answer: Section 41.121(c) contains general requirements for the contents of motions. Some § 1.637-like requirements were proposed in § 41.208, but most have not been adopted in this final rule.

Section 1.637 (2003) attempted to provide movants with enough detail to avoid summary dismissal or denial. In practice, however, the rule often proved to be either over-inclusive, adding unnecessary cost, or under-inclusive, leading to dismissal or denial anyway. See *Hillman,* 55 USPQ2d at 1221 (denying motion despite compliance with § 1.637 (2003) for failure to carry its burden of proof). Ultimately, a movant must prove its case substantively whether a rule like § 1.637 (2003) exists or not. The Board may develop practice notes as its experience with the new rules increases, in which case parties would be given notice of the practice notes.

Comment 122: One comment suggests that § 41.121(c)(1)(ii) require that each material fact be stated in a single sentence.

Answer: Material facts should be stated in a manner that permits the opposing party to admit or deny the fact readily. Multi-sentence facts place a burden on the opposing party to parse the stated fact for portions that can be admitted or denied. The result is a complex tangle that does not facilitate decision-making. Even long, compound sentences are abusive. Section 41.121(c)(1)(ii) has been amended to require a statement of facts.

Section 41.121(d) has been renumbered as § 41.121(f) and a new § 41.121(d) has been inserted to address the form and content of the statement of material facts. A single-sentence requirement for material facts is added at § 41.121(d)(1).

Comment 123: One comment suggests an amendment to § 41.121(c)(1)(iii) to limit what it sees as the open-ended obligation of a party adding a claim in a contested case to address every rejection that could conceivably be made based on the prosecution history.

Answer: No such unlimited obligation exists. Generally, the obligation to ''prove patentability'' has been limited to showing compliance with the written description requirement of 35 U.S.C. 112(1) except where the party reasonably has actual notice that other patentability problems exist. Typically, such notice is provided by a prior rejection in the prosecution history of the involved application or patent or by a substantive motion by the opposing party.

If an opponent believes the movant has not met this burden, it should raise and explain the issue in its opposition. The Board views with disfavor oppositions that merely point out the problem and then do not explain it, hoping to enlist the Board's help in making the rejection. Finally, if a party believes that it did not have adequate notice of the problem, it should explain the lack of notice in its reply and then address the problem on the merits. In any case, it would be difficult to craft a rule that would cover all or even most of the possibilities that will arise.

Comment 124: Another comment suggests that the requirement in § 41.121(c)(1)(iii) for ''a detailed explanation of the significance of the evidence'' be met by citation to the specific numbered material fact or by citation to the specific portion of an exhibit.

Answer: The rule permits a party to cite to a particular material fact or portion of an exhibit, but mere citation to a fact is not an explanation of the fact. One purpose of an argument is to provide context and meaning to the relevant facts. A party that simply cites to facts without explaining them is effectively recruiting the opposing party and the Board to make out its case. The burden for explaining what the evidence means and how it justifies the relief sought in the paper remains with the party filing the paper.

Comment 125: Section 41.121(c)(2) requires compliance with any rule in 37 CFR part 1 that would ordinarily govern the relief sought if it were sought outside the context of a contested case within the Board's jurisdiction. One comment suggests requiring that a party moving to add a reissue claim also file a reissue declaration or supplemental reissue declaration addressing the claim.

Answer: One problem with the suggestion is that the movant might not be the reissue applicant. Rules cannot address every possible contingency. A party that believes it is harmed by the opponent's inadequate reissue declaration can address the problem in its opposition or can move for relief in a miscellaneous motion (§ 41.121(a)(3)) prior to filing its opposition.

Comment 126: Section 41.121(c)(4) provides that any material fact not denied will be considered admitted. One comment suggests that a fact only be considered admitted if it is not denied and it is ''placed in issue by the parties or the Board''.

Answer: The first comment is not adopted because the mere inclusion of the stated fact in a paper places the fact in issue. Any other approach would lead to fruitless argument about whether a fact was placed in issue or not. If the comment is hinting that a party might use a statement of material fact to obtain an admission on an extraneous fact for ulterior purposes, the Board would like to be informed of such abuses as they occur.

Comment 127: One comment expresses concern about § 41.121(c)(4) because a party not otherwise obliged to respond to a statement of material fact (for instance, because it does not oppose the relief sought), might nevertheless feel obliged to file a paper in order to deny a stated fact it believes is wrong. The comment suggests that a party be permitted to respond ''not admitted'' to a fact that is not supported by the exhibits.

Answer: The comment is not adopted because a denial standing by itself can be helpful to the Board. The burden on a party to deny stated facts it believes are wrong is not very great. Moreover, a ''not admitted'' response is not helpful. If the party agrees with the fact despite the inadequacy of the exhibits,

then the proper course is to admit the fact or remain silent and let it be deemed admitted; otherwise, the party should deny the fact, if only to direct the Board's attention to the issue. Perhaps best of all, the party could alert the opposing party to the defect so that any flaw in the statement could be corrected before any response is due.

Comment 128: A new § 41.121(e) has been inserted to relocate the claim chart requirement of proposed § 41.208(d) into subpart D. Two comments address proposed § 41.208(d). One comment requests greater guidance on the form and content of the claim charts and on whether they count against any page limit. The other comment opposes the requirement as costly and of questionable use.

Answer: Claim charts permit a party to explain clearly and succinctly what it thinks a claim means in comparison to something else, such as another claim, a reference, or a specification. No form is specified in the rule because each party has an incentive to produce a clear claim chart that illustrates its point. The question about page limits is moot since the rules set no page limits.

Comment 129: Section 41.122 has been retitled ''Oppositions and replies'' and the content requirements of § 41.121(c)(4) have been moved to a new § 41.122(a). Proposed § 41.122 is now § 41.122(b). As proposed, § 41.122 addressed new arguments in oppositions and replies. One comment objects to the second and third sentences of § 41.122 regarding new arguments in oppositions and replies. The comment expresses concern that the second sentence limits the scope of opposition argument, but the comment does not give an example of its concern.

Answer: The second sentence of what is now § 41.122(b) was confusing and not necessary. It has been deleted.

Comment 130: One comment expresses concern that the third sentence of what is now § 41.122(b), which addresses replies, actually permits new arguments in the reply because a movant could use the reply to cure defects in the motion first noted in the opposition. The comment prefers the wording in § 1.638(b) (2003).

Answer: Section 1.638(b) (2003) is susceptible to the same misreading the comment proposes for § 41.122(b). Under either rule, an argument first made in a reply would not be attributed to the motion, and thus would not cure the deficiency of the motion.

Comment 131: One comment proposes that replies should not be automatic, but rather should require separate Board authorization or other additional regulation to prevent abuse.

Answer: As a broad proposition, the Board has considerable authority in setting times and determining the course of the proceeding and thus authority to file an opposition or reply should be viewed as a default rather than a right. Indeed, § 41.123(b)(2) makes clear that oppositions are not automatic for miscellaneous motions. It is fairly common for a party to be advised that no opposition or reply will be authorized in cases where such filings would be moot. Nevertheless, the filing of oppositions and replies is the default practice in contested cases before the Board. The rule has been written to reflect the default practice.

Comment 132: One comment objects to the default times in § 41.123(a) for filing oppositions and responsive motions. The comment expresses concern that the default times are too short and may otherwise not be appropriate in many cases.

Answer: The default times are set as defaults in the event that no times are set by order. See § 41.104(c). The expectation is that the Board official assigned to administer a case will tailor times appropriate to each case. As in the current practice, responsive motions will typically be filed before any oppositions are required.

Comment 133: Three comments oppose § 41.123(b)(2), regarding default times for oppositions and replies for miscellaneous motions, which all three agree are too short and are unnecessary.

Answer: The default times in § 41.123(b)(2) are the same as the default times in Standing Order ¶ 13.10.2. In practice, there has not been a problem because most miscellaneous motions are unopposed or are resolved in a telephone conference. An opposed motion must be authorized, § 41.123(b)(1)(ii), in which case the parties can suggest that different times for the opposition and reply be set in the order authorizing the motion.

Comment 134: One comment suggests that a rule analogous to § 1.639 (2003) be added to require exhibits be filed and served with the paper relying on the exhibit.

Answer: A new § 41.123(c) has been added to provide as a default that an exhibit must be filed and served with the first paper citing the exhibit. An exhibit that has already been filed should not be filed again (§ 41.7(b)) and one that has been served need not be served again. The current practice is to defer the filing of most exhibits until a time shortly before the motions will be decided.

Comment 135: Two comments suggest that § 41.124(c) is unclear regarding whether a party has twenty minutes of argument time for each issue or for all issues. The comments also suggest a mechanism for requesting additional time.

Answer: The default total time for oral argument for each party is twenty minutes regardless of the number of issues for which the argument has been granted. The Board may, however, authorize a different amount of time (§ 41.104(c)). As a practical matter, if questioning from the bench is active, then more time is accorded at the discretion of the presiding administrative patent judge. A party that knows in advance that it will need more time can seek more time by filing a miscellaneous motion (§ 41.121(a)(3)).

Comment 136: Two comments recommend that § 41.124(e) be amended to state that an oral argument transcript filed with the Board becomes part of the record.

Answer: Any paper that is properly filed becomes part of the record. Cf. § 41.7(a) providing for expungement from the record of improperly filed papers.

Comment 137: Two comments address § 41.125(a) regarding the order in which the Board addresses motions. One comment requests an opportunity for the parties to opine on the best order for consideration or to explain why deferral would make sense (or not).

Answer: At present, there are several mechanisms for expressing such opinions. Parties routinely mark papers as contingent on another motion, which implies an order for consideration. Moreover, the conferences for setting times often result in a discussion of whether the order for consideration of issues should be specified. For instance, threshold issues are often advanced to the point where briefing on threshold issues is completed before other motions are even filed. By contrast, antedating proofs related to patentability attacks under 35 U.S.C. 102(a) or (e), inventorship issues, and unenforceability issues are often deferred until the priority phase. Nothing in the rule bars or should even be viewed as discouraging parties from letting the Board know of a party's opinion on the order in which issues should be considered, provided that the parties keep in mind that the order is ultimately discretionary with the Board.

Comment 138: One comment suggests explicitly requiring the order to be ''reasonable''.

Answer: In this context, ''reasonable'' simply means no abuse of discretion. All Board discretionary actions are either reasonable or are subject to attack for abuse of discretion. Consequently, the amendment is superfluous.

Comment 139: One party suggests modifying § 41.125(c)(3)(ii) regarding the requirement that a rehearing request point specifically to ''the place where the matter was previously addressed in a motion, opposition, or reply''. According to the comment, the rule does not address instances where the Board reaches an issue sua sponte.

Answer: If a party believes that the Board improperly reached an issue sua sponte, then pointing out that the issue was not previously addressed in a motion, opposition, or reply would comply with § 41.125(c)(3)(ii). The party would still need to identify what the Board misapprehended or overlooked in reaching its decision (§ 41.125(c)(3)(i)).

Comment 140: One comment seeks clarification on whether the estoppel in § 41.127(a) applies to a party that ''prevails'' on priority, but is held to have unpatentable claims.

Answer: A party that loses on patentability for an involved claim will receive an adverse judgment (that is, lose) on patentability for that claim and consequently will be estopped with regard to the patentability of the subject matter of that claim. Note that since priority is effectively a question of unpatentability under 35 U.S.C. 102(g)(1), one never prevails on priority in any absolute sense: one can only lose on the issue of priority. In re Kyrides, 159 F.2d 1019, 1022, 73 USPQ 61, 63 (CCPA 1947).

Comment 141: Two comments note that abandonment or disclaimer of the invention of the count, both grounds for adverse judgment under § 1.662 (2003), are omitted from § 41.127(b). One comment seeks clarification of the practical effect of the omission. The other comment suggests that the abandonment ground be restored.

Answer: The abandonment and disclaimer of the invention grounds were omitted as redundant with other grounds listed in § 41.127(b). Hence, their omission should have no practical effect beyond making the rule shorter.

Comment 142: One comment makes two suggestions regarding requests for reconsideration under § 41.127(d). The first parallels the comment on sua sponte Board action under § 41.125(c)(3)(ii).

Answer: As with § 41.125(c)(3)(ii), if the problem asserted is that the Board reached an issue that was not raised, then pointing out that it was not raised complies with § 41.127(d).

Comment 143: The second suggestion is that the tolling of the time for seeking judicial review be automatic rather than discretionary with the Board.

Answer: The last sentence regarding tolling has been removed because it is unnecessary under current case law. A timely request for reconsideration automatically tolls the time for seeking judicial review. *In re Graves,* 69 F.3d 1147, 1151, 36 USPQ2d 1697, 1700 (Fed. Cir. 1995). Since the decision on rehearing on the judgment is itself a final decision from which judicial review may be sought, 35 U.S.C. 141, the decision on rehearing effectively resets the time for seeking judicial review.

Comment 144: One comment recommends that proposed § 41.128 regarding termination be restated to hold interferences to be merely suspended during the period of any judicial review. The comment opposes the rule as written because it places settlements during subsequent judicial review outside the purview of 35 U.S.C. 135(c). The comment is concerned that the rule creates a trap for parties settling during judicial review if a court subsequently disagrees with the Office's construction of 35 U.S.C. 135(c) and recommends that current Rule 661 be retained.

Answer: The Office has decided that, since termination has a meaning in 37 CFR part 1, subparts D and H, and in § 1.197, that differs from the meaning proposed in §§ 41.56, 41.83, and 41.128, confusion may result. Consequently, proposed §§ 41.56, 41.83, and 41.128 are deleted and § 41.129 is renumbered as § 41.128. Further, the text of former Rule 661 has been modified and incorporated into § 41.205(a) to define termination of an interference proceeding for purposes of 35 U.S.C. 135(c). Rule 41(d)(2), Fed. R. App. Procedure, controls when the mandate of the Court of Appeals will issue in the event that a party filed a petition for writ of certiorari to the United States Supreme Court. Unless a party petitioning for a writ of certiorari seeks and obtains a stay of the appellate court's mandate, proceedings will be considered terminated with the issuance of the mandate, as noted in Rule 197(b)(2) and 41.205(a).

Comment 145: One comment, while applauding the intent of now renumbered § 41.128(a) regarding sanctions, expresses concern that the word ''misleading'' in paragraph (a)(2) is too subjective and that the provision regarding dilatory tactics in paragraph (a)(3) is redundant with the other provisions of § 41.128(a).

Answer: While the word ''misleading'' calls for the exercise of judgment, it is no more subjective than ''frivolous'', which also occurs in paragraph (a)(2). Moreover, the sanction for misleading arguments addresses a problem distinct from frivolous arguments. The history of the use of sanctions at the Board suggests that parties are appropriately restrained in requesting sanctions and that the Board is similarly restrained in applying them. Note that a frivolous charge that an opponent's argument is misleading would be sanctionable. Consequently, the inclusion of misleading arguments as a basis for sanctions is both necessary and unlikely to result in significant abuse.

The provision in paragraph (a)(3) for sanctioning dilatory tactics is not necessarily redundant. For instance, if a party requests and is granted a delay in good faith, but subsequently abuses the delay, there might not be a violation of paragraphs (a)(1) or (a)(2). In any case, the inclusion of a sanction for dilatory tactics emphasizes the Board's commitment to avoiding undue delays in light of the availability of patent term adjustments under 35 U.S.C. 154(b)(1)(C)(i).

Comment 146: One comment recommends that § 41.150(b)(1)(i) be modified to add patent applications incorporated by reference into an involved patent or application to the list of materials that must be automatically served upon request.

Answer: The comment is adopted.

Comment 147: One comment suggests that § 41.150(c) regarding additional discovery expressly state that the ''interests of justice'' must include (1) a showing that the evidence requested in discovery is not available to the movant and (2) a showing as to why the evidence requested in discovery is necessary to establish a prima facie basis for relief, so as to preclude discovery fishing expeditions.

Answer: As in the current practice, requests for additional discovery under § 41.150(c) must be authorized (usually in the form of a miscellaneous motion under § 41.121(a)(3)), which has long offered sufficient protection against fishing expeditions.

Section 41.150(c) has been divided into two parts, with the addition of a paragraph (2) to restore the production of documents and things currently available under § 1.687(b) (2003).

Section 41.152 addresses when and how the Federal Rules of Evidence are applied. Section 41.156(c), regarding the determination of foreign law, has been relocated to § 41.152(d) because it can be an exception to the use of the Federal Rules of Evidence. Moreover, it is relevant to § 41.157 as well as § 41.156.

Comment 148: Four comments oppose the requirement in § 41.155(b)(1) for objections to be filed within five business days of service of evidence.

Answer: The time period is a default and can be extended on request (§§ 41.104(c) and 41.121(a)(3)). The five-

day period has been part of the Standing Order (¶ 14.1.1) for five years. In that time, very few problems have arisen with the requirement.

Comment 149: One comment requested that the provision in Standing Order ¶ 14.1.2 that an objection not made on the record is deemed waived be included in § 41.155(b)(1).

Answer: The requirement is preserved in § 41.155(c), which requires a party filing a motion to exclude to point to where the objection was made in the record. An objection first raised in a motion to exclude would be untimely (§ 41.4(b)).

Comment 150: One comment requests that § 41.155(b)(2), regarding the filing of supplemental evidence, be amended to clarify that additional supplementation is not permitted in response to an objection to the supplemental evidence.

Answer: The rules do not authorize a second objection. The party objecting should timely make all objections to the first evidence. The supplemental evidence will either cure the objections or it will fail to do so. If the party objecting believes the supplemental evidence does not cure the objection, then rather than file a second objection it should pursue its initial objection with a motion to exclude, explaining how the supplemental evidence failed to cure the defect.

Comment 151: One comment requested clarification of the relationship between § 41.156, which deals with compelled testimony and production, and § 41.150, which deals with discovery generally.

Answer: Since compelled testimony involves the issuance of a subpoena under 35 U.S.C. 24, it involves different considerations than other discovery and testimony.

Comment 152: One comment suggests that § 41.157(b)(2)(ii), regarding testimony outside the United States, permit parties to stipulate to the taking of such testimony.

Answer: The agreement of the parties to take testimony in a foreign country is only one of many factors that influence whether such testimony might be authorized.

Comment 153: One comment states that some practitioners abuse the opportunity to note errata in testimony. The comment suggests modifying § 41.157 to require that any correction must accurately reflect the questions posed and the answers provided.

Answer: Modifying the rule will not make it so. If a correction materially alters testimony, it may be a falsification of the testimony and may expose the party or the counsel to sanctions. A party who believes that an opponent's correction substantively changes the testimony should promptly bring the matter to the attention of the Board.

Part 41, Subpart E—Patent Interferences

Comment 154: Section 41.200(b) provides a rule of construction for claims in interferences. One comment suggests a rule for interpreting counts in light of the involved specifications.

Answer: The count defines the interfering subject matter, which in turn depends on what the parties are claiming. Consequently, as with claims, the primary meaning of the count must be based on the plain language of the count, but the corresponding claims can set bounds on what the count reasonably means, particularly when the count is defined in terms of a party's claim. Since § 41.200(b) provides for reference to the specification in interpreting claims, by extension the involved specifications can influence the broadest reasonable construction of the count via the claim defining the count.

Comment 155: One comment suggests that definitions in § 41.201 be numbered as subsections.

Answer: As noted with regard to § 41.2, the Office of the Federal Register discourages numbering definitions.

Comment 156: Section 41.201 defines ''accorded benefit''. One comment inquires whether the definition of ''accorded benefit'' is intended to cover applications filed in foreign countries, particularly prior to the critical dates for the North American Free Trade Agreement and the Uruguay Round Agreement Amendments. As the comment notes, the definition is based on 35 U.S.C. 102(g).

Answer: The definition is limited to what would constitute a constructive reduction to practice under 35 U.S.C. 102(g)(1), taking into account other relevant statutes like 35 U.S.C. 104, as well as relevant case law. The point of the revised rule is to focus on priority proofs rather than the less relevant right to benefit under 35 U.S.C. 120 and related statutes.

Comment 157: Section 41.201 also defines ''constructive reduction to practice''. Five comments address this definition. They broke into three overlapping groups. One group expresses concern that the phrase ''constructive reduction to practice'' has come to have other meanings, which could lead to confusion.

Answer: The problem the first group identifies pervades patent law, where concepts are tightly, but not always smoothly, integrated. The new rules shifted away from discussing constructive reduction to practice in terms of ''benefit'' because that term was causing confusion. The term ''benefit'' occurs much more commonly in the 35 U.S.C. 120 sense than in the interference sense. Unfortunately, all of the other candidates for succinctly expressing the key idea, like ''anticipation'', are also freighted with considerable non-interference implications. While ''reduction to practice'' is occasionally used in other contexts, its primary use has been associated with priority proofs. Hence the phrase ''constructive reduction to practice'' is the best choice, but the definition has been revised to tie it more closely with the idea of anticipation under 35 U.S.C. 102(g)(1). This change represents a clarification of, rather than a change to, the current practice.

Comment 158: A second group expresses concern that the scope of the rule could be read too narrowly, for instance, to exclude an express disclosure and enablement of a genus without any disclosure of a particular species within the genus when the subject matter of the count is generic.

Answer: This concern should also be resolved by refocusing the rule on anticipation. As with other forms of anticipation directed to claims, a constructive reduction to practice can be satisfied with a disclosure and enablement of the full scope of the count or with disclosure and enablement of a something within the scope of the count.

Comment 159: The final group suggests clarification of whether co-pendency in a chain of applications is required or that a requirement of co-pendency be included in the definition.

Answer: The requirement of co-pendency appears to be implicit in the law both by the exception for abandoned, suppressed, and concealed subject matter, and by the analogy to *In re Costello,* 717 F.2d 1346, 1350, 219 USPQ 389, 391 (Fed. Cir. 1983) (a 35 U.S.C. 102(e) case). The definition provided for ''earliest constructive reduction to practice'' makes clear that continuity is required. To clarify this point, the definition of ''earliest constructive reduction to practice'' has been relocated into, and amended to be consistent with, the revised definition of ''constructive reduction to practice''.

Comment 160: One comment suggests that the use of the phrase ''patentably distinct'' in the definition of ''count'' under § 41.201 could be confusing. The comment proposes a definition based on the test for interfering subject matter in § 41.203(a).

Answer: Two counts must be patentably distinct; if not, they define

the same invention and can only support a single count. The phrase patentably distinct comes from the case law dealing with separate counts in an interference. *Hester* v. *Allgeier,* 687 F.2d 464, 466, 215 USPQ 481, 482 (CCPA 1981). The phrase has an established meaning as a difference between subject matter that would have been neither anticipated nor obvious. *Aelony* v. *Arni,* 547 F.2d 566, 570, 192 USPQ 486, 490 (CCPA 1977). Patentable distinctness is a one-way test. It is sufficient if the subject matter of either count, treated as prior art, would not have anticipated or rendered obvious the subject matter of the other count. Two-way distinctness would also justify two counts, but is not required: it is more than what is required.

Comment 161: The comment further requests clarification on what date would apply for determining whether an additional reference was available to show obviousness.

Answer: Such a determination is outside the scope of this rule making and is better left to development through adjudication. Note that since a count controls what proofs are admissible, it will often be advisable to permit a second count at least until the facts surrounding priority are in the record.

Comment 162: One comment addresses the definition of ''threshold issue'' under § 41.201. It criticizes the narrowed application of 35 U.S.C. 135(b) as a threshold issue.

Answer: The 35 U.S.C. 135(b) bar and written description issues were defined as threshold issues to address perceived abuses of interference practice and, given their standing-like ability to end an interference quickly, have been defined narrowly for the purpose of threshold issues, without any intent to narrow them for the purposes of proving unpatentability generally.

In the case of a provoked interference, the 35 U.S.C. 135(b) bar and written description serve complementary functions. The 35 U.S.C. 135(b) bar is intended to provide a patentee (or published applicant) repose from any attack more than one year after issuance or publication of the interfering claim. In short, it bars a claim that an applicant might otherwise be entitled to receive had it been entered earlier.

The use of the 35 U.S.C. 135(b) bar as a threshold issue is limited to patents or applications of the movant because the entitlement to repose is personal to the patentee or published applicant. There is no third-party entitlement to repose, particularly since the movant asserting the bar may also believe it is also entitled to an interference with the third-party patent or published application that triggers the bar. Nothing in the definition of ''threshold issue'' prevents the movant from raising the bar as an ordinary attack on patentability. The suggested clarification is unnecessary because the rule does not change the requirements for proving the bar, but rather limits the instances in which the bar will be treated as a threshold issue.

Comment 163: The comment questions the inclusion of written description as a threshold issue under § 41.201.

Answer: Written description addresses the problem complementary to repose under 35 U.S.C. 135(b): the claim was timely, but lacks an adequate written description. The use of written description as a threshold issue responds to the perception that some applicants would copy a claim simply to provoke interferences to obtain an inter partes administrative challenge to a patent, regardless of whether the applicant had actually invented the same subject matter as the patentee had claimed. See *Snitzer* v. *Etzel,* 531 F.2d 1062, 1065, 189 USPQ 415, 417 (CCPA 1976) (noting the great scrutiny under which copied claims have historically been placed).

The Office has been firm in its position that patent interferences are not generalized patent cancellation proceedings. The Office has proposed an enhanced post-grant review proceeding to fill the perceived need for such a proceeding. United States Patent and Trademark Office, The 21st Century Strategic Plan at 11 (updated 3 February 2003).

The provision for written description as a threshold issue has been amended to narrow it to provoked interferences since that is where the concern lies. The lack of an express suggestion of an interference under § 41.202(a) will not necessarily shield an applicant from a threshold motion. There will be no examination of an applicant's intent to provoke an interference where the opportunity to have done so is clear. Any other practice would open the practice to abuse and misconduct.

Comment 164: The comment questions whether enablement should also be a threshold issue.

Answer: Since the list of threshold issues is inclusive, it would permit additional issues to be treated as standing issues. Whether enablement is routinely such an issue is left to further development through adjudication. The current impression is that the enablement requirement appears to be less frequently abused, in the absence of a lack of written description, when provoking an interference.

Section 41.202(a)(2) has been modified to clarify that an applicant suggesting an interference must also propose at least one count (as defined in § 41.201) since an explanation of correspondence to the count is required in § 41.202(a)(3).

Section 41.202(a)(3) requires an applicant suggesting an interference to identify the claims that interfere and explain how they correspond to the suggested count. When the suggestion is made on the basis of a published application, the decision to declare an interference will be based on the claims pending in the published application at the time of the decision, which may differ from the published claims. Note that no interference will be declared until both applications have allowable claims that still interfere.

Comment 165: Section 41.202(a)(4) requires an applicant suggesting an interference provide a detailed explanation of why it will prevail on priority, while § 41.202(d) requires an actual showing of priority. One comment suggests that these two sections are inconsistent.

Answer: There is no inconsistency between the rules. Section 41.202(a)(4) is a general requirement that any applicant suggesting an interference provide an explanation of why it will prevail. If the applicant has the earliest effective filing date, the explanation should ordinarily be fairly simple. Section 41.202(d) addresses the case in which the applicant does not have the earlier effective filing date. In such a case, a more thorough showing is required because otherwise on the face of the record no interference is necessary to dispose of the interfering claim.

Comment 166: One comment suggests that § 41.202(a)(6)'s requirement for a chart showing supporting disclosure for an embodiment within the scope of the interfering subject matter is too narrow since it does not address instances where there is disclosure of the entire interfering subject matter, but not of a specific embodiment.

Answer: The rule is modified to refer to a constructive reduction to practice within the scope of the interfering subject matter. Since the definition of constructive reduction to practice in § 41.201 has been clarified to reflect anticipation under 35 U.S.C. 102(g)(1), this change should also address the suggestion in this comment.

Comment 167: Three comments suggest that § 41.202(b), regarding patentees seeking interferences, include a reference to § 1.99. One suggests that

§ 41.202(b) is too restrictive, while two of the comments suggest it might be inconsistent with the more restrictive § 1.99.

Answer: The rule is not intended to create, eliminate, or modify a remedy available under § 1.99 or § 1.291. The rule simply observes that the process for suggesting an interference is not available to a patentee and points to an alternative remedy. Section 41.202(b) is revised to clarify this intent and to point patentees to both § 1.99 and § 1.291.

Comment 168: One comment expresses concern about § 41.202(c), under which an examiner may require an applicant to add an interfering claim. The comment worries that the applicant is placed in an awkward position if an examiner suggests an interfering claim that the applicant believes is improper because it is not supported or because the examiner's reasoning is unclear.

Answer: The applicant's remedy in such a situation is to comply with the requirement, but also to add a better claim or to contest the requirement. See *In re Ogiue,* 517 F.2d 1382, 1390, 186 USPQ 227, 235 (CCPA 1975) (holding that refusal to copy a claim for which the applicant had support results in disclaimer). The requirement that an applicant either comply by adding the proposed claim or concede priority of the proposed subject matter is not new, see 37 CFR 1.605 (2003) and MPEP § 2305. Section 41.202(c) has been further modified to require showings like those under § 41.202(a)(2)–(a)(6) when the interference would be with a patent. Any dispute arising as to satisfaction of these added procedural requirements may be petitioned.

Comment 169: Three comments address the requirement under § 41.202(d) to show priority. Two of the comments suggest restoring some version of the reduced showing required under § 1.608(a) (2003) for an application with an effective filing date within three months of an interfering patent's effective filing date. A third comment suggests that a similar requirement be made of all junior patentees.

Answer: The three-month practice under § 1.608 (2003) was eliminated because it makes little sense in many circumstances. The comments assume that a fairly common practice prevails to spend a few months preparing applications. The argument fails for two reasons.

First, while it may be common generally, it does not appear to be common in all technologies and may be meaningless in the context of a particular case. Second, if we are to assume that the applicant spent three months preparing an application, then we should also be able to make the same assumption about the earlier-filing interfering patent, in which case the assumption does little to address whether the applicant was the first to invent. See *Paulik* v. *Rizkalla,* 760 F.2d 1270, 1282, 226 USPQ 224, 232–33 (Fed. Cir. 1985) (Rich, J., concurring; making a similar point).

Comment 170: One comment suggests distinguishing between complex and simple technologies in § 41.202(d). The comment does not offer a definition of simple or complex technology.

Answer: Such a distinction would be unworkable in practice.

Comment 171: Another comment suggests waiting until the interference is initiated to require the showing under § 41.202(d).

Answer: A practice of waiting would require the declaration of an interference, with all of the costs associated with the declaration of an interference, that the applicant might not want to contest. Moreover, since an inadequate showing under § 41.202(d) is the trigger for a summary disposition under § 41.202(d)(2), delay in making the showing would drag out the pendency of the interference.

Comment 172: One comment suggests requiring a showing under § 41.202(d) from junior patentees as well.

Answer: In an interference, the Office does not have jurisdiction over the patent until after the interference is declared. Once the Board declares an interference, a junior party must make a priority statement under § 41.204(a). Normally, the priority statement is required early in the interference. Nothing in the rules prevents a summary proceeding for a patentee that cannot show an adequate date of priority in its priority statement. Moreover, nothing prevents the Board from expediting consideration of priority in such circumstances.

Section 41.202(e) addresses what evidence is sufficient to show priority. Paragraph (2) has been added to address a situation in which a showing cannot be made because the necessary evidence is not available without a subpoena. In such cases, a detailed proffer of the expected testimony or production may suffice.

Comment 173: Eight comments address § 41.203(a)'s definition for interfering subject matter. Seven oppose the rule, while one seeks clarification.

The seven that oppose would all prefer that the Board use a one-way test for interfering subject matter.

Answer: A one-way test is not workable since it would turn a large portion of rejections under 35 U.S.C. 102(a), 102(e), and 103(a) into interferences simply because the subject matter claimed in the prior art anticipated or rendered obvious the subject matter subsequently claimed.

The one-way practice has never been the standard for interfering subject matter. Although some comments suggest that the two-way test of § 41.203(a) originated with *Winter* v. *Fujita,* 53 USPQ2d 1234 (BPAI 1999), that decision only originated the use of the term ''two-way'' in the context of interfering subject matter. The two-way test itself has long been implicit in the test for no interference-in-fact: one-way patentable distinctness. *See,* e.g., *Aelony* v. *Arni,* 547 F.2d 566, 570, 192 USPQ 486, 490 (CCPA 1977). It is worth noting that the test for interfering patents under 35 U.S.C. 291 had been framed in, if anything, even narrower terms than the test under § 41.203(a). See e.g., *Slip Track Sys.* v. *Metal Lite, Inc.,* 159 F.3d 1337, 1341, 48 USPQ2d 1055, 1058 (Fed. Cir. 1998) (''patents that claim identical subject matter'').

Comment 174: One comment suggests that the paradox of having a one-way test for both starting and ending an interference could be resolved if the test for no interference-in-fact only worked in one direction. That is, the movant must show that its claim is patentably distinct from the opponent's claim rather than showing that the opponent's claim is patentably distinct from the movant's claim. The example given is a genus claim that is anticipated by, but does not anticipate, another party's species claim.

Answer: The problem with this suggestion is that it cedes control over the interference to the party with the species claim, who can decide unilaterally whether to file for no interference-in-fact or not. The suggested directional test also ignores the Director's role under 35 U.S.C. 135(a) in deciding whether an interference exists or not.

Under the directional test, an interference would both exist and not exist. If the Director turns a blind eye to the fact that there is no interference-in-fact from one perspective, the Director has effectively enlisted on the species claimant's side. Such a result would, at a minimum, appear to be unfair.

Comment 175: Six comments urge that a one-way test is necessary so that a senior party applicant may attack a junior party patentee with a dominating claim.

Answer: The problem the comments identify as appropriate for an interference is instead a case of claim dominance. The remedy consequently is not an interference, but may be a

reexamination or some other patentability or validity contest. The Office has proposed a post-grant review process that would provide an appropriate forum for addressing such concerns. United States Patent and Trademark Office, The 21st Century Strategic Plan at 11 (updated 3 February 2003). The Office remains steadfast in its position that an interference is not a post-grant cancellation proceeding.

Comment 176: One comment notes that foreign priority proofs are treated differently under 35 U.S.C. 102(g)(1) and (g)(2). According to the comment, this difference violates treaty obligations by placing the foreign patentee at a disadvantage under 35 U.S.C. 102(g)(2). The comment urges that the Office has the initial responsibility to provide a remedy by extending the jurisdiction for interferences to cover situations that otherwise only fall within 35 U.S.C. 102(g)(2).

Answer: Even assuming the comment is correct, the problem lies in the legislative decision to treat outcomes based on 35 U.S.C. 102(g)(1) and (g)(2) differently. The effect of following the comment's suggestion would be to eliminate a distinction that the statute was only recently amended to create. The only plausible reading of 35 U.S.C. 102(g) is that Congress intended foreign priority proofs to be treated differently depending on the situation in which the issue arises. Consequently, the comment would be more appropriately directed to Congress.

Comment 177: One comment seeks clarification about whether unpatentable claims, particularly claims that are unpatentable as the result of a threshold motion, would be taken into consideration in determining whether there are interfering claims.

Answer: Ordinarily, claims that are unpatentable would not be placed into an interference. See § 41.102; *Brenner* v. *Manson,* 383 U.S. 519, 528 n.12 (1966) (observing that when a claim is unpatentable on its face, a priority contest need not ''inexorably take place''). Similarly, if all interfering claims become unpatentable as a result of a threshold motion, judgment in the interference is justified. See *Berman* v. *Housey,* 291 F.3d 1345, 1351, 63 USPQ2d 1023, 1027 (Fed. Cir. 2002) (affirming a judgment against a party with claims barred by 35 U.S.C. 135(b)).

Comment 178: One comment suggests that § 41.203(b) be modified to have the notice of declaration set forth the basis for any claim correspondence or accorded benefit.

Answer: A similar effort was made in former § 1.609 (1998) to have the examiner explain the basis for correspondence. The rule was subsequently withdrawn in the face of public complaints that it was delaying the declaration of interferences without providing much real benefit to the parties. While some explanation is required before a claim can be finally rejected, the declaration simply creates presumptions that are developed through motions. No party is subject to a rejection or cancellation of its claims without having had an opportunity to address the presumptions in the declaration.

Comment 179: Two comments address § 41.203(d) regarding the addition of a patent or application to the interference. One comment questions what happened to substituting applications under § 1.633(d) (2003) and also seeks guidance on when a motion to add a patent or an application would be timely.

Answer: The suggestion to add an application or a patent under § 41.203(d) could be raised any time, but is more likely to be granted if it is raised early in an interference. The intent of the rule is that it work like the decision to declare an interference, hence it only addresses the addition of a patent or application. A substitution of an application could be accomplished by moving to add a second application with an interfering claim and by cancelling the involved claims in the first application contingent on the addition of the second application to the interference.

Comment 180: A second comment notes that § 41.203(d) permits the addition of non-party applications or patents. While the comment approves, it suggests requiring the movant to show that the claims of the added patent or application are patentable.

Answer: The suggestion is not adopted. A proceeding in which the third party is not a participant is not a good place to explore the patentability of the third party's claims.

Comment 181: Five comments address § 41.204(a) regarding priority statements. Four of the comments urge that the rule would require too much information to be provided too early in the proceeding and suggest a return to current practice under §§ 1.621–1.628 (2003). One comment requests clarification about the nature and amount of documentary support required for the priority statement.

Answer: Section 41.204(a) is amended to clarify that any party that will put on a priority case must file a priority statement. It has also been amended to list specific requirements for the priority statement. Section 41.204(a) still requires the party to state the bases on which it believes that it is entitled to relief. Such bases might include an intent to prove derivation or to move to be accorded benefit of an additional constructive reduction to practice.

Comment 182: One comment expresses concern that senior parties must file a priority statement and suggests that parties be bound by their preliminary statements.

Answer: Parties are bound by their preliminary statements (§ 41.120(b)). Senior parties do not have to file a priority statement if they do not intend to put on a priority case.

Comment 183: One comment suggests that § 41.204(b) regarding the statement of the basis for relief for substantive motions is redundant with § 41.121(c)(1). It recommends replacing the notice with a list of motions intended to be filed with the basis for each motion as is required under current practice.

Answer: The rule has been restated in terms of a motions list, although the list will require more detail than is often provided on current lists. The list is not a substitute for a motion, but it must provide sufficient detail to place the Board and the opponent on notice of the precise relief sought. The Board needs adequate notice to facilitate scheduling. Moreover, detailed motions lists can lead to other efficiencies, such as stipulations from the opponent.

Comment 184: One comment opposes § 41.207(a)(1) regarding the presumption of the order of invention for priority. According to the comment, if two parties have identical dates for constructive reduction to practice and neither elects to put on a priority case, then the rule suggests that both would lose, while the comment believes that a patent should issue to both.

Answer: The rule codifies case law that establishes that when both parties have the same date of constructive reduction to practice, neither party is entitled to a presumption of priority. *Van Otteren* v. *Hafner,* 278 F.2d 738, 740, 126 USPQ 151, 152 (CCPA 1960) (question of joint invention); *Lassman* v. *Brossi,* 159 USPQ 182, 184 (Bd. Int. 1967) (in which both parties lost when neither established priority).

Comment 185: One comment opposes the extension under § 41.207(a)(2) of the clear and convincing evidence standard to instances where the junior party applicant first files after the publication of the senior party's application. According to the comment, the use of a higher evidentiary standard is tied to the presumption of patent validity under 35 U.S.C. 282.

Answer: The evidentiary standard for the priority case of an applicant that

filed after the opponent's patent issued is the clear and convincing evidence standard. *Price* v. *Symsek,* 988 F.2d 1187, 1190–91, 26 USPQ2d 1031, 1033 (Fed. Cir. 1993). In *Price,* the court rejected the previously applied beyond a reasonable doubt standard as inconsistent with intervening Supreme Court precedent. The court cited the presumption of validity as the reason for using a higher standard. The *Price* decision did not purport to be instituting the use of a higher standard in such cases; rather, it was following older precedent. 988 F.2d at 1192 n.2, 26 USPQ2d at 1035 n.2. The older precedent provides reason to believe that the presumption of validity is not the only, or even the primary, reason for using a higher evidentiary standard.

The best reason for believing that the presumption of validity is not the primary basis for the higher evidentiary standard is that not all patents in interferences benefit from the higher standard. Indeed, the higher standard is the exception and not the rule. ''It is important to bear in mind that merely because one of the parties has an issued patent does not mean that the other party must prove his case by [a higher evidentiary standard].'' C.W. Rivise & A.D. Caesar, 3 Interference Law & Practice at section 467 (1947); accord *Bosies* v. *Benedict,* 27 F.3d 539, 541–42, 30 USPQ2d 1862, 1864(Fed. Cir. 1994) (distinguishing *Price*). Moreover, the higher standard does not apply to questions that do not bear directly on priority. 3 Interference Law & Practice at § 471; see also *In re Etter,* 756 F.2d 856, 857, 225 USPQ 1, 4 (Fed. Cir. 1985) (in banc) (clear and convincing evidence standard does not apply to patent claims under reexamination).

While *Price* rejected the older evidentiary standard, it did not reject the reasons the older precedent gave for using a higher standard. 988 F.2d at 1192 n.2 & text, 26 USPQ2d at 1035 n.2 & text. That precedent recognized various reasons for the higher standard. *Walker* v. *Altorfer,* 111 F.2d 164, 167, 45 USPQ 317, 320 (CCPA 1940) (one of the cases *Price* cites in n.2). Among the reasons discussed were concerns about spurring and the degradation of evidence after a long delay, 111 F.2d at 168, 45 USPQ at 320. Both of these factors apply in the case of published applications as well.

Typically applications are published 18 months after their earliest claimed benefit date, 35 U.S.C. 122(b)(1), so most late filers would have to have delayed at least 18 months. As the Court of Customs and Patent Appeals cautioned in *Horwath* v. *Lee,* 564 F.2d 948, 950, 195 USPQ 701, 704 (CCPA 1977) (also cited in *Price* at n.2), an inventor should file promptly because a delay in filing raises the risk that intervening actions by another may deprive the inventor of a property right. See also 35 U.S.C. 102(e) (extending the definition of prior art to include published applications) and 35 U.S.C. 135(b) (extending the bar to include published applications).

Section 41.207(a)(2) is consistent with the patent statutes in treating published applications like patents. Unlike the statutes, however, § 41.207(a)(2) does not create a bar to patentability, but simply extends the existing heightened scrutiny for late filers so that it is triggered by publication of an application as well as issuance of a patent. Use of the clear and convincing evidence standard also furthers the important policy goal of encouraging prompt filing.

Comment 186: One comment opposes § 41.207(b) with regard to claim correspondence. The comment gives the example of a generic claim that corresponds to both a generic count and a specific count in which there is a split award. In such a case, the generic claim would be unpatentable based on its correspondence to the species count, even though the party ''won'' the generic count. The comment distinguishes *In re Saunders,* 219 F.2d 455, 104 USPQ 394 (CCPA 1955), which was discussed in the notice of proposed rule making, because it was an ex parte appeal. The comment also points to *Ex parte Hardman,* 142 USPQ 329 (BPAI 1964) for the proposition that Saunders does not create a per se rule of unpatentability for generic claims in such cases.

Answer: Although the comment urges that the rule represents a change from current practice, the rule simply formalizes the effect of the estoppel arising out of cases like *In re Deckler,* 977 F.2d 1449, 1452, 24 USPQ2d 1448, 1449 (Fed. Cir. 1992), in which a party could not subsequently seek claims that were patentably indistinct from the subject matter of the count lost in the interference. As earlier discussed, no one ''wins'' a count because surviving a priority contest for one count does not mean that one is thereby entitled to a claim. *Kyrides,* 159 F.2d at 1022, 73 USPQ at 63.

In *Saunders*, a junior party could not claim a generic invention after losing a species count. Although the case was an ex parte appeal, it arose because Saunders was a junior party who had lost a species count, but not the generic count, making the *Saunders* case directly relevant. The case law has many examples of parties who having lost interferences try, with varying degrees of success to either claim around (*e.g., In re Johnson,* 558 F.2d 1008, 194 USPQ 187 (CCPA 1977)) or to antedate (*e.g., In re Zletz,* 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989)) the subject matter of the lost count. *Hardman* was correct that *Saunders* did not create a per se rule of unpatentability for generic claims, but neither does § 41.207(b). It simply creates a presumption that must be addressed.

If a party with a generic claim that corresponds to a species count is concerned about the designation, its remedy is to move to have the generic claim designated as not corresponding to the species count. Often, the motion would be deferred until the priority phase and dismissed unless there were a split award on priority, in which case proof that the generic invention antedates the priority proofs for the lost species count would likely justify relief.

Comment 187: Nine comments oppose at least some aspect of the proposed presumption under § 41.207(d) of abandonment, suppression, or concealment when the party's effective filing date is more than one year after the party's actual reduction to practice.

Answer: The presumption has been deleted as unnecessary. Delays longer than 18 months will often result in a bar to patentability or heightened scrutiny (§ 41.207(a)(2)) anyway so the proposed rule would not have been likely to change the outcome in many interferences.

Under a priority motions practice, abandonment, suppression, or concealment can be raised in the opposition to a priority motion. Any request for additional discovery (§ 41.150(c)) or motion for compelled testimony or production (§ 41.156(a)) should be filed promptly to ensure that it is reflected in the opposition.

Comment 188: One comment suggests adding a provision to § 41.208(a)(2) to address adding counts.

Answer: Section 41.208(a)(2) has been reworded to substitute ''definition of the interfering subject matter'' for the first occurrence of ''count''. The point of the rule is to focus parties on using substantive motions to define the range of admissible proofs for priority before the priority phase begins.

Comment 189: Three comments express alarm that priority is addressed as a motion under § 41.208(a)(4). The principal concern appears to be that priority will routinely be decided at the same time as the preliminary motions.

Answer: The rules do not require priority to be decided simultaneously with the preliminary motions. Indeed,

the point of preliminary motions is to simplify the issues for consideration during the priority contest, for instance by better defining the patentable subject matter. Instead, the rules provide for contesting priority in the form of motions. On the other hand, the rules would permit priority to be taken up with, or instead of, preliminary motions in an appropriate case. The Board works out the details of how a given priority case will proceed on a case-by-case basis.

Motions practice is much more efficient than the current briefing practice since each movant must explain the evidence on which it relies rather than simply dumping it on the opposing party and waiting to see what can be made of it. Several interferences have already had priority contests in motions form. Typically, the junior party presents its motion along with its evidence of priority. The motion explains the evidence and gives the senior party an opportunity to see how the junior party is relying on the evidence. Next, the senior party presents its motion if it elects to present a case. Both parties then file oppositions and replies. A motions process eliminates the need for briefing after the evidence is served.

Comment 190: As noted previously, most of § 41.208(c) has not been adopted in the final rule. Like § 1.637 (2003), § 41.208(c) was plagued with problems of over- and under-inclusiveness. See *Hillman*, 55 USPQ2d at 1221. Section 41.208(c) is now limited to requiring a showing of patentability whenever a claim is proposed to be added or amended. Consequently, most of the comments on § 41.208(c) are moot.

Five comments address proposed § 41.208(c)(4)(ii), now part of § 41.208(c)(2), in which a party broadening the count must show the proposed count does not include prior art. Four comments address proposed § 41.208(c)(5)(i), now § 41.208(c)(1), in which a party adding a claim must show the patentability of the claim. One comment urges that the showing be limited to overcoming contrary positions taken during prosecution. The other comments oppose the rule as requiring the movant to prove a negative.

Answer: Section 41.208(c) is now limited to the requirement to show patentability. Any time a claim or count is added or amended, the movant must show that the claim or count does not run afoul of any known patentability problem. The comments are correct that the requirement often obliges the movant to prove a negative, but the alternative is to permit a movant to create a patentability issue without addressing it until the reply brief. While a requirement to prove a negative should generally be avoided, sandbagging an opponent is never acceptable. Moreover, the rule is consistent with the duty of candor to the Office, particularly since the opposing party might not oppose the motion.

Not all showings of patentability require the proof of a negative. For instance, a movant adding a claim must show where the written description for the claim can be found (§ 41.110(c)(2)). Where a negative showing is required, a party may show that it is unaware of a basis for unpatentability. When an applicable patentability question has been raised during prosecution or in an opponent's motion, however, it is not onerous for the movant to address that specific question. This is particularly true for a responsive motion seeking to address an opponent's motion alleging unpatentability. The responsive motion cannot truly be responsive without explaining how it avoids the unpatentability.

For counts, the main concern arises when a count is broadened to include additional subject matter. Since a count defines the scope of proofs admissible to prove priority, it is necessary for the count to be patentable over the prior art. Otherwise, embodiments unpatentable over the prior art could be used to prove priority. As with claims, a party may show that it is unaware of prior art that would anticipate or render obvious the subject matter of the count.

Comment 191: One comment suggests that there be a rule in interferences comparable to § 1.56 and § 1.555 requiring candor toward the Office.

Answer: Such a rule falls outside the scope of this rule making and is, in any case, unnecessary. Litigants and their counsel always have a duty of candor toward a tribunal. This is particularly true when the litigant appears before the tribunal ex parte. American Bar Association, Model Rules of Professional Conduct 3.3(d). Since the Board can independently explore questions of patentability, § 41.121(f), even parties in a contested case stand before the Board in an ex parte capacity. *Cf. SmithKline Beecham Corp.* v. *Apotex Corp.*, 365 F.3d 1306, 1321, 70 USPQ2d 1737, 1748 (Fed. Cir. 2004) (Gajarsa, J., concurring) (patentability can always be raised sua sponte). Moreover, the limited discovery in Board proceedings reduces the check usually available in adversarial proceedings, thus further increasing the duty of candor owed to the Office. Consequently, there is a duty of candor with or without a rule, and the duty is high because of the nature of the proceeding.

The Office has proposed a disciplinary rule that is not as limited in scope as § 1.56 or § 1.555 as a basis for disciplining patent practitioners. 68 FR 69442, 69555, § 11.303(d). Rather than codify the existing duty of candor in yet another narrow context, the Board will rely on its authority to sanction misconduct (§ 41.128(a)) and to regulate counsel (§ 41.5) to address violations of the duty of candor that may arise in a contested case.

Administrative Procedure Act: The notable changes in this final rule are: (1) Consolidating ex parte appeal rules, inter partes reexamination appeal rules, and patent interference rules in a new part 41 of 37 CFR; (2) providing Subpart A of new part 41 to consolidate general provisions relating to the Board of Patent Appeals and Interferences and make them consistent across different proceedings; (3) providing an express delegation from the Director of the United States Patent and Trademark Office to the Chief Administrative Patent Judge to decide petitions arising in Board proceedings; (4) providing a delegation of limited authority to handle disqualifications under 35 U.S.C. 32 from the Director to the Chief Administrative Patent Judge; (5) providing Subpart B of new part 41 setting forth the rules of practice for ex parte appeals; (6) limiting amendments filed on or after the date of filing a brief; (7) changing the format and content of the appeal brief; (8) providing Subpart C of new part 41 setting forth the rules of practice for inter partes reexamination appeals; (9) providing Subpart D of new part 41 setting forth general rules of practice for contested cases, which currently are patent interferences (35 U.S.C. 135) and ownership (42 U.S.C. 2182 and 2457(d)); (10) providing Subpart E of new part 41 setting forth rules of practice specific to patent interferences; (11) clarifying issues regarding when there is an interference-in-fact, how claims correspond to a count, and how benefit of earlier applications is accorded; (12) providing that an applicant adding a claim to provoke an interference with a patent pursuant to a requirement by an examiner must provide additional details about the count, accorded benefit, and claim correspondence for the proposed interference, and (13) clarifying that a two-way unpatentability test is used to determine whether claimed inventions interfere.

The changes in this final rule relate solely to the procedure to be followed in filing and prosecuting a patent application, filing and prosecuting an

appeal to the Board, and contested cases. Therefore, these rule changes involve interpretive rules, or rules of agency practice and procedure under 5 U.S.C. 553(b)(A), and prior notice and an opportunity for public comment were not required pursuant to 5 U.S.C. 553(b)(A) (or any other law). *See Bachow Communications Inc.* v. *FCC*, 237 F.3d 683, 690 (D.C. Cir. 2001) (rules governing an application process are ''rules of agency organization, procedure, or practice'' and exempt from the Administrative Procedure Act's notice and comment requirement); *Merck & Co., Inc.* v. *Kessler*, 80 F.3d 1543, 1549–50, 38 USPQ2d 1347, 1351 (Fed. Cir. 1996) (the rules of practice promulgated under the authority of former 35 U.S.C. 6(a) (now in 35 U.S.C. 2(b)(2)) are not substantive rules (to which the notice and comment requirements of the Administrative Procedure Act apply)); *Fressola* v. *Manbeck*, 36 USPQ2d 1211, 1215 (D.D.C. 1995) (''it is doubtful whether any of the rules formulated to govern patent and trade-mark practice are other than 'interpretative rules, general statements of policy, * * * procedure, or practice' '' (quoting C.W. Ooms, *The United States Patent Office and the Administrative Procedure Act*, 38 Trademark Rep. 149, 153 (1948).

Regulatory Flexibility Act: As previously discussed, the changes in this final rule involve interpretive rules, or rules of agency practice and procedure, and prior notice and an opportunity for public comment were not required pursuant to 5 U.S.C. 553(b)(A) (or any other law). Because prior notice and an opportunity for public comment were not required for the changes in this final rule, a final Regulatory Flexibility Act analysis is also not required for the changes in this final rule. *See* 5 U.S.C. 603.

Nevertheless, the Office published a notice of proposed rule making in the **Federal Register**, 68 FR 66648 (Nov. 26, 2003), and in the Official Gazette of the United States Patent Office, 1277 OG 139 (Dec. 23, 2003), in order to solicit public participation with regard to this rule package. Pursuant to the notice of proposed rule making, the Deputy General Counsel for General Law of the United States Patent and Trademark Office certified to the Chief Counsel for Advocacy of the Small Business Administration under the provisions of section 605(b) of the Regulatory Flexibility Act that the proposed rule would not have a significant economic impact on a substantial number of small entities. No comments were received which referenced any impact the proposed rules would have on small entities.

The Office receives approximately 350,000 patent applications annually. The final rules contained in this rule package apply to those applications where an appeal brief is filed with the Board and to those applications where an interference is suggested.

Approximately 7,300 appeal briefs are filed in the Office each year. Of this number, small entities file, on average, approximately 1,552 appeal briefs annually. For example, in Fiscal Year 2003, 1,717 small entities filed appeal briefs; in Fiscal Year 2002, 1,442 small entities filed appeal briefs; and in Fiscal Year 2001, 1,497 small entities filed appeal briefs. The average number of small entities affected by these rule changes is a very small percentage of the total number of applications processed by the Office (approximately 0.4%). These final rules do not impact a substantial number of small entities. Moreover, the fees associated with filing an appeal with the Board are set by statute and by previous rule makings, and have not been adjusted in any manner in the current rule making. The procedural rules contained in this rule making package do not increase the cost of filing or processing an appeal before the Board. Thus, these rules have no significant economic impact on small entities.

On average, about 109 interferences are declared in the Office each year. For example, in Fiscal Year 2003, 95 interferences were declared; in Fiscal Year 2002, 109 interferences were declared; and in Fiscal Year 2001, 124 interferences were declared. The Office does not maintain statistics to show the number of small entities that participate in interferences before the Office annually. Each interference involves two parties. Even assuming that every participant in an interference proceeding is a small entity (double the average number of interferences—about 218 per year), the average number of small entities possibly affected by these rule changes is a very small percentage of the total number of applications processed by the Office (approximately 0.0006%). These final rules do not impact a substantial number of small entities. Moreover, the fees associated with filing an interference with the Board are set by statute and by previous rule makings, and have not been adjusted in any manner in the current rule making. The procedural rules contained in this rule making package do not increase the cost of filing or processing an interference before the Board. Thus, these rules have no significant economic impact on small entities.

Accordingly, the Deputy General Counsel for General Law of the United States Patent and Trademark Office has certified to the Chief Counsel for Advocacy of the Small Business Administration that changes contained in this final rule will not have a significant economic impact on a substantial number of small entities.

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

Executive Order 12866: This final rule has been determined to be not significant for purposes of Executive Order 12866 (Sept. 30, 1993).

Paperwork Reduction Act: This final rule involves information collection requirements which are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*).

Currently approved forms include PTO/SB/31 (Notice of appeal) and PTO/SB/32 (Request for hearing), both of which were cleared under the OMB 0651–0031 collection, which will expire at the end of July 2006.

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

List of Subjects

37 CFR Part 1

Administrative practice and procedure, Biologics, Courts, Freedom of information, Inventions and patents, Reporting and recordkeeping requirements, Small businesses.

37 CFR Part 5

Classified information, Exports, Foreign relations, Inventions and patents.

37 CFR Part 10

Administrative practice and procedure, Inventions and patents, Lawyers, Reporting and recordkeeping requirements.

37 CFR Part 11

Administrative practice and procedure, Inventions and patents, Lawyers, Reporting and recordkeeping requirements.

37 CFR Part 41

Administrative practice and procedure, Inventions and patents, Lawyers.

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

PART 1—RULES OF PRACTICE IN PATENT CASES

■ 1. The authority citation continues to read as follows:

Authority: 35 U.S.C. 2(b)(2), unless otherwise noted.

■ 2. Amend § 1.1 to remove paragraph (a)(1)(iii) and to revise paragraph (a)(1)(ii) to read as follows:

§ 1.1 Addresses for non-trademark correspondence with the United States Patent and Trademark Office.

(a) * * *

(1) * * *

(ii) *Board of Patent Appeals and Interferences.* See § 41.10 of this title. Notices of appeal, appeal briefs, reply briefs, requests for oral hearing, as well as all other correspondence in an application or a patent involved in an appeal to the Board for which an address is not otherwise specified, should be addressed as set out in paragraph (a)(1)(i) of this section.

* * * * *

■ 3. In § 1.4, revise paragraph (a)(2) to read as follows:

§ 1.4 Nature of correspondence and signature requirements.

(a) * * *

(2) Correspondence in and relating to a particular application or other proceeding in the Office. See particularly the rules relating to the filing, processing, or other proceedings of national applications in subpart B, §§ 1.31 to 1.378; of international applications in subpart C, §§ 1.401 to 1.499; of ex parte reexaminations of patents in subpart D, §§ 1.501 to 1.570; of extension of patent term in subpart F, §§ 1.710 to 1.785; of inter partes reexaminations of patents in subpart H, §§ 1.902 to 1.997; and of the Board of Patent Appeals and Interferences in part 41 of this title.

* * * * *

§ 1.5 [Amended]

■ 4. Remove and reserve § 1.5(e).

■ 5. Amend § 1.6 by revising paragraph (d)(9) to read as follows:

§ 1.6 Receipt of correspondence.

* * * * *

(d) * * *

(9) In contested cases before the Board of Patent Appeals and Interferences except as the Board may expressly authorize.

* * * * *

■ 6. Amend § 1.8 by removing and reserving paragraph (a)(2)(i)(B) and by revising paragraph (a)(2)(i)(C) to read as follows:

§ 1.8 Certificate of mailing or transmission.

(a) * * *

(2) * * *

(i) * * *

(C) Papers filed in contested cases before the Board of Patent Appeals and Interferences, which are governed by § 41.106(f) of this title;

* * * * *

■ 7. In § 1.9, revise paragraph (g) to read as follows:

§ 1.9 Definitions.

* * * * *

(g) For definitions in Board of Patent Appeals and Interferences proceedings, see part 41 of this title.

* * * * *

■ 8. In § 1.11, revise paragraph (e) to read as follows:

§ 1.11 Files open to the public.

* * * * *

(e) Except as prohibited in § 41.6(b), the file of any interference is open to public inspection and copies of the file may be obtained upon payment of the fee therefor.

* * * * *

■ 9. Amend § 1.14 by revising paragraph (e) to read as follows:

§ 1.14 Patent applications preserved in confidence.

* * * * *

(e) *Decisions by the Director.* Any decision by the Director that would not otherwise be open to public inspection may be published or made available for public inspection if:

(1) The Director believes the decision involves an interpretation of patent laws or regulations that would be of precedential value; and

(2) The applicant is given notice and an opportunity to object in writing within two months on the ground that the decision discloses a trade secret or other confidential information. Any objection must identify the deletions in the text of the decision considered necessary to protect the information, or explain why the entire decision must be withheld from the public to protect such information. An applicant or party will be given time, not less than twenty days, to request reconsideration and seek court review before any portions of a decision are made public under this paragraph over his or her objection.

* * * * *

■ 10. In § 1.17, remove and reserve paragraphs (c) and (d), and revise paragraphs (b) and (h) to read as follows:

§ 1.17 Patent application and reexamination processing fees.

* * * * *

(b) For fees in proceedings before the Board of Patent Appeals and Interferences, see § 41.20 of this title.

* * * * *

(h) For filing a petition under one of the following sections which refers to this paragraph: $130.00.

§ 1.12—for access to an assignment record.

§ 1.14—for access to an application.

§ 1.47—for filing by other than all the inventors or a person not the inventor.

§ 1.53(e)—to accord a filing date.

§ 1.59—for expungement of information.

§ 1.84—for accepting color drawings or photographs.

§ 1.91—for entry of a model or exhibit.

§ 1.102—to make an application special.

§ 1.103(a)—to suspend action in an application.

§ 1.138(c)—to expressly abandon an application to avoid publication.

§ 1.182—for decision on a question not specifically provided for.

§ 1.183—to suspend the rules.

§ 1.295—for review of refusal to publish a statutory invention registration.

§ 1.313—to withdraw an application from issue.

§ 1.314—to defer issuance of a patent.

§ 1.377—for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.

§ 1.378(e)—for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.

§ 1.741(b)—to accord a filing date to an application under § 1.740 for extension of a patent term.

§ 5.12—for expedited handling of a foreign filing license.

§ 5.15—for changing the scope of a license.

§ 5.25—for retroactive license.

§ 104.3—for waiver of a rule in Part 104 of this title.

* * * * *

■ 11. Revise § 1.36 to read as follows:

§ 1.36 Revocation of power of attorney; withdrawal of patent attorney or agent.

(a) A power of attorney, pursuant to § 1.32(b), may be revoked at any stage in the proceedings of a case by an applicant for patent (§ 1.41(b)) or an assignee of the entire interest of the applicant. A power of attorney to the patent practitioners associated with a Customer Number will be treated as a request to revoke any powers of attorney previously given. Fewer than all of the applicants (or by fewer than the assignee of the entire interest of the applicant) may only revoke the power of attorney upon a showing of sufficient cause, and payment of the petition fee set forth in § 1.17(h). A registered patent attorney or patent agent will be notified of the revocation of the power of attorney. Where power of attorney is given to the patent practitioners associated with a Customer Number (§ 1.32(c)(2)), the practitioners so appointed will also be notified of the revocation of the power of attorney when the power of attorney to all of the practitioners associated with the Customer Number is revoked. The notice of revocation will be mailed to the correspondence address for the application (§ 1.33) in effect before the revocation. An assignment will not of itself operate as a revocation of a power previously given, but the assignee of the entire interest of the applicant may revoke previous powers of attorney and give another power of attorney of the assignee's own selection as provided in § 1.32(b).

(b) A registered patent attorney or patent agent who has been given a power of attorney pursuant to § 1.32(b) may withdraw as attorney or agent of record upon application to and approval by the Director. The applicant or patent owner will be notified of the withdrawal of the registered patent attorney or patent agent. Where power of attorney is given to the patent practitioners associated with a Customer Number, a request to delete all of the patent practitioners associated with the Customer Number may not be granted if an applicant has given power of attorney to the patent practitioners associated with the Customer Number in an application that has an Office action to which a reply is due, but insufficient time remains for the applicant to file a reply. See § 41.5 of this title for withdrawal during proceedings before the Board of Patent Appeals and Interferences.

■ 12. Amend § 1.48 by revising paragraphs (a), (b), (c) and (i), and adding paragraph (j), to read as follows:

§ 1.48 Correction of inventorship in a patent application, other than a reissue application, pursuant to 35 U.S.C. 116.

(a) *Nonprovisional application after oath/declaration filed.* If the inventive entity is set forth in error in an executed § 1.63 oath or declaration in a nonprovisional application, and such error arose without any deceptive intention on the part of the person named as an inventor in error or on the part of the person who through error was not named as an inventor, the inventorship of the nonprovisional application may be amended to name only the actual inventor or inventors. Amendment of the inventorship requires:

(1) A request to correct the inventorship that sets forth the desired inventorship change;

(2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;

(3) An oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or § 1.47;

(4) The processing fee set forth in § 1.17(i); and

(5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

(b) *Nonprovisional application—fewer inventors due to amendment or cancellation of claims.* If the correct inventors are named in a nonprovisional application, and the prosecution of the nonprovisional application results in the amendment or cancellation of claims so that fewer than all of the currently named inventors are the actual inventors of the invention being claimed in the nonprovisional application, an amendment must be filed requesting deletion of the name or names of the person or persons who are not inventors of the invention being claimed. Amendment of the inventorship requires:

(1) A request, signed by a party set forth in § 1.33(b), to correct the inventorship that identifies the named inventor or inventors being deleted and acknowledges that the inventor's invention is no longer being claimed in the nonprovisional application; and

(2) The processing fee set forth in § 1.17(i).

(c) *Nonprovisional application—inventors added for claims to previously unclaimed subject matter.* If a nonprovisional application discloses unclaimed subject matter by an inventor or inventors not named in the application, the application may be amended to add claims to the subject matter and name the correct inventors for the application. Amendment of the inventorship requires:

(1) A request to correct the inventorship that sets forth the desired inventorship change;

(2) A statement from each person being added as an inventor that the addition is necessitated by amendment of the claims and that the inventorship error occurred without deceptive intention on his or her part;

(3) An oath or declaration by the actual inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43, or § 1.47;

(4) The processing fee set forth in § 1.17(i); and

(5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

* * * * *

(i) *Correction of inventorship in patent.* See § 1.324 for correction of inventorship in a patent.

(j) *Correction of inventorship in a contested case before the Board of Patent Appeals and Interferences.* In a contested case under part 41, subpart D, of this title, a request for correction of an application must be in the form of a motion under § 41.121(a)(2) of this title and must comply with the requirements of this section.

■ 13. In § 1.55, revise paragraphs (a)(3) and (a)(4) to read as follows:

§ 1.55 Claim for foreign priority.

(a) * * *

(3) The Office may require that the claim for priority and the certified copy of the foreign application be filed earlier than provided in paragraphs (a)(1) or (a)(2) of this section:

(i) When the application becomes involved in an interference (see § 41.202 of this title),

(ii) When necessary to overcome the date of a reference relied upon by the examiner, or

(iii) When deemed necessary by the examiner.

(4)(i) An English language translation of a non-English language foreign application is not required except:

(A) When the application is involved in an interference (see § 41.202 of this title),

(B) When necessary to overcome the date of a reference relied upon by the examiner, or

(C) When specifically required by the examiner.

(ii) If an English language translation is required, it must be filed together

with a statement that the translation of the certified copy is accurate.

* * * * *

■ 14. In § 1.59, revise paragraph (a)(1) to read as follows:

§ 1.59 Expungement of information or copy of papers in application file.

(a)(1) Information in an application will not be expunged, except as provided in paragraph (b) of this section or § 41.7(a) of this title.

* * * * *

■ 15. In § 1.103, revise paragraph (g) to read as follows:

§ 1.103 Suspension of action by the Office.

* * * * *

(g) *Statutory invention registration.* The Office will suspend action by the Office for the entire pendency of an application if the Office has accepted a request to publish a statutory invention registration in the application, except for purposes relating to patent interference proceedings under part 41, subpart D, of this title.

■ 16. Revise § 1.112 to read as follows:

§ 1.112 Reconsideration before final action.

After reply by applicant or patent owner (§ 1.111 or § 1.945) to a non-final action and any comments by an inter partes reexamination requester (§ 1.947), the application or the patent under reexamination will be reconsidered and again examined. The applicant, or in the case of a reexamination proceeding the patent owner and any third party requester, will be notified if claims are rejected, objections or requirements made, or decisions favorable to patentability are made, in the same manner as after the first examination (§ 1.104). Applicant or patent owner may reply to such Office action in the same manner provided in § 1.111 or § 1.945, with or without amendment, unless such Office action indicates that it is made final (§ 1.113) or an appeal (§ 41.31 of this title) has been taken (§ 1.116), or in an inter partes reexamination, that it is an action closing prosecution (§ 1.949) or a right of appeal notice (§ 1.953).

■ 17. In § 1.113, revise paragraph (a) to read as follows:

§ 1.113 Final rejection or action.

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's, or for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section. For final actions in an inter partes reexamination filed under § 1.913, see § 1.953.

* * * * *

■ 18. In § 1.114, revise paragraph (d) to read as follows:

§ 1.114 Request for continued examination.

* * * * *

(d) If an applicant timely files a submission and fee set forth in § 1.17(e), the Office will withdraw the finality of any Office action and the submission will be entered and considered. If an applicant files a request for continued examination under this section after appeal, but prior to a decision on the appeal, it will be treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner. An appeal brief (§ 41.37 of this title) or a reply brief (§ 41.41 of this title), or related papers, will not be considered a submission under this section.

* * * * *

■ 19. Revise § 1.116 to read as follows:

§ 1.116 Amendments and affidavits or other evidence after final action and prior to appeal.

(a) An amendment after final action must comply with § 1.114 or this section.

(b) After a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):

(1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;

(2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or

(3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

(c) The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the application or reexamination proceeding from its condition as subject to appeal or to save the application from abandonment under § 1.135, or the reexamination prosecution from termination under § 1.550(d) or § 1.957(b) or limitation of further prosecution under § 1.957(c).

(d)(1) Notwithstanding the provisions of paragraph (b) of this section, no amendment other than canceling claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, can be made in an inter partes reexamination proceeding after the right of appeal notice under § 1.953 except as provided in § 1.981 or as permitted by § 41.77(b)(1) of this title.

(2) Notwithstanding the provisions of paragraph (b) of this section, an amendment made after a final rejection or other final action (§ 1.113) in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913 may not cancel claims where such cancellation affects the scope of any other pending claim in the reexamination proceeding except as provided in § 1.981 or as permitted by § 41.77(b)(1) of this title.

(e) An affidavit or other evidence submitted after a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913 but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title), may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.

(f) Notwithstanding the provisions of paragraph (e) of this section, no affidavit or other evidence can be made in an inter partes reexamination proceeding after the right of appeal notice under § 1.953 except as provided in § 1.981 or as permitted by § 41.77(b)(1) of this title.

(g) After decision on appeal, amendments, affidavits and other evidence can only be made as provided in §§ 1.198 and 1.981, or to carry into effect a recommendation under § 41.50(c) of this title.

■ 20. In § 1.131, revise paragraph (a)(1) to read as follows:

§ 1.131 Affidavit or declaration of prior invention.

(a) * * *

(1) The rejection is based upon a U.S. patent or U.S. patent application publication of a pending or patented application to another or others which claims the same patentable invention as defined in § 41.203(a) of this title, in

which case an applicant may suggest an interference pursuant to § 41.202(a) of this title; or

* * * * *

■ 21. In § 1.136, revise paragraphs (a)(1), (a)(2), and (b) to read as follows:

§ 1.136 Extensions of time.

(a)(1) If an applicant is required to reply within a nonstatutory or shortened statutory time period, applicant may extend the time period for reply up to the earlier of the expiration of any maximum period set by statute or five months after the time period set for reply, if a petition for an extension of time and the fee set in § 1.17(a) are filed, unless:

(i) Applicant is notified otherwise in an Office action;

(ii) The reply is a reply brief submitted pursuant to § 41.41 of this title;

(iii) The reply is a request for an oral hearing submitted pursuant to § 41.47(a) of this title;

(iv) The reply is to a decision by the Board of Patent Appeals and Interferences pursuant to § 1.304 or to § 41.50 or § 41.52 of this title; or

(v) The application is involved in a contested case (§ 41.101(a) of this title).

(2) The date on which the petition and the fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The expiration of the time period is determined by the amount of the fee paid. A reply must be filed prior to the expiration of the period of extension to avoid abandonment of the application (§ 1.135), but in no situation may an applicant reply later than the maximum time period set by statute, or be granted an extension of time under paragraph (b) of this section when the provisions of this paragraph are available. See § 1.304 for extensions of time to appeal to the U.S. Court of Appeals for the Federal Circuit or to commence a civil action; § 1.550(c) for extensions of time in ex parte reexamination proceedings, § 1.956 for extensions of time in inter partes reexamination proceedings; and §§ 41.4(a) and 41.121(a)(3) of this title for extensions of time in contested cases before the Board of Patent Appeals and Interferences.

* * * * *

(b) When a reply cannot be filed within the time period set for such reply and the provisions of paragraph (a) of this section are not available, the period for reply will be extended only for sufficient cause and for a reasonable time specified. Any request for an extension of time under this paragraph must be filed on or before the day on which such reply is due, but the mere filing of such a request will not affect any extension under this paragraph. In no situation can any extension carry the date on which reply is due beyond the maximum time period set by statute. See § 1.304 for extensions of time to appeal to the U.S. Court of Appeals for the Federal Circuit or to commence a civil action; § 1.550(c) for extensions of time in ex parte reexamination proceedings; and § 1.956 for extensions of time in inter partes reexamination proceedings.

* * * * *

■ 22. In § 1.181, revise paragraph (a)(3) to read as follows:

§ 1.181 Petition to the Director.

(a) * * *

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

* * * * *

■ 23. Revise § 1.191 to read as follows:

§ 1.191 Appeal to Board of Patent Appeals and Interferences.

Appeals to the Board of Patent Appeals and Interferences under 35 U.S.C. 134(a) and (b) are conducted according to part 41 of this title.

§§ 1.192, 1.193, 1.194, 1.195, and 1.196 [Removed and reserved].

■ 24. Remove and reserve §§ 1.192 through 1.196.

■ 25. Revise § 1.197 to read as follows:

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

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

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

(i) Where claims stand allowed in an application; or

(ii) Where the nature of the decision requires further action by the examiner.

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

■ 26. Revise § 1.198 to read as follows:

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

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

■ 27. In § 1.248, revise paragraph (c) to read as follows:

§ 1.248 Service of papers; manner of service; proof of service in cases other than interferences.

* * * * *

(c) See § 41.105(f) of this title for service of papers in contested cases before the Board of Patent Appeals and Interferences.

■ 28. In § 1.292, revise paragraphs (a) and (c) to read as follows:

§ 1.292 Public use proceedings.

(a) When a petition for the institution of public use proceedings, supported by affidavits or declarations is found, on reference to the examiner, to make a prima facie showing that the invention claimed in an application believed to be on file had been in public use or on sale more than one year before the filing of the application, a hearing may be had before the Director to determine whether a public use proceeding should be instituted. If instituted, the Director may designate an appropriate official to conduct the public use proceeding,

including the setting of times for taking testimony, which shall be taken as provided by part 41, subpart D, of this title. The petitioner will be heard in the proceedings but after decision therein will not be heard further in the prosecution of the application for patent.

* * * * *

(c) A petition for institution of public use proceedings shall not be filed by a party to an interference as to an application involved in the interference. Public use and on sale issues in an interference shall be raised by a motion under § 41.121(a)(1) of this title.

* * * * *

■ 29. In § 1.295, revise paragraph (b) to read as follows:

§ 1.295 Review of decision finally refusing to publish a statutory invention registration.

* * * * *

(b) Any requester who is dissatisfied with a decision finally rejecting claims pursuant to 35 U.S.C. 112 may obtain review of the decision by filing an appeal to the Board of Patent Appeals and Interferences pursuant to § 41.31 of this title. If the decision rejecting claims pursuant to 35 U.S.C. 112 is reversed, the request for a statutory invention registration will be approved and the registration published if all of the other provisions of § 1.293 and this section are met.

* * * * *

■ 30. In § 1.302, revise paragraph (b) to read as follows:

§ 1.302 Notice of appeal.

* * * * *

(b) In interferences, the notice must be served as provided in § 41.106(f) of this title.

* * * * *

■ 31. In § 1.303, revise paragraph (c) to read as follows:

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

* * * * *

(c) A notice of election under 35 U.S.C. 141 to have all further proceedings on review conducted as provided in 35 U.S.C. 146 must be filed with the Office of the Solicitor and served as provided in § 41.106(f) of this title.

* * * * *

■ 32. In § 1.304, revise paragraphs (a)(1) and (a)(2) to read as follows:

§ 1.304 Time for appeal or civil action.

(a)(1) The time for filing the notice of appeal to the U.S. Court of Appeals for the Federal Circuit (§ 1.302) or for commencing a civil action (§ 1.303) is two months from the date of the decision of the Board of Patent Appeals and Interferences. If a request for rehearing or reconsideration of the decision is filed within the time period provided under § 41.52(a), § 41.79(a), or § 41.127(d) of this title, the time for filing an appeal or commencing a civil action shall expire two months after action on the request. In contested cases before the Board of Patent Appeals and Interferences, the time for filing a cross-appeal or cross-action expires:

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

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

(2) The time periods set forth in this section are not subject to the provisions of § 1.136, § 1.550(c), or § 1.956, or of § 41.4 of this title.

* * * * *

■ 33. In § 1.322, revise paragraph (a)(3) to read as follows:

§ 1.322 Certificate of correction of Office mistake.

(a) * * *

(3) If the request relates to a patent involved in an interference, the request must comply with the requirements of this section and be accompanied by a motion under § 41.121(a)(2) or § 41.121(a)(3) of this title.

* * * * *

■ 34. Revise § 1.323 to read as follows:

§ 1.323 Certificate of correction of applicant's mistake.

The Office may issue a certificate of correction under the conditions specified in 35 U.S.C. 255 at the request of the patentee or the patentee's assignee, upon payment of the fee set forth in § 1.20(a). If the request relates to a patent involved in an interference, the request must comply with the requirements of this section and be accompanied by a motion under § 41.121(a)(2) or § 41.121(a)(3) of this title.

■ 35. Amend § 1.324 to revise paragraphs (a) and (c), and to add paragraph (d), to read as follows:

§ 1.324 Correction of inventorship in patent, pursuant to 35 U.S.C. 256.

(a) Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his or her part, the Director may, on petition, or on order of a court before which such matter is called in question, issue a certificate naming only the actual inventor or inventors. A petition to correct inventorship of a patent involved in an interference must comply with the requirements of this section and must be accompanied by a motion under § 41.121(a)(2) or § 41.121(a)(3) of this title.

* * * * *

(c) For correction of inventorship in an application, see §§ 1.48 and 1.497.

(d) In a contested case before the Board of Patent Appeals and Interferences under part 41, subpart D, of this title, a request for correction of a patent must be in the form of a motion under § 41.121(a)(2) or § 41.121(a)(3) of this title.

■ 36. In § 1.565, revise paragraph (e) to read as follows:

§ 1.565 Concurrent Office proceedings which include an ex parte reexamination proceeding.

* * * * *

(e) If a patent in the process of ex parte reexamination is or becomes involved in an interference, the Director may suspend the reexamination or the interference. The Director will not consider a request to suspend an interference unless a motion (§ 41.121(a)(3) of this title) to suspend the interference has been presented to, and denied by, an administrative patent judge, and the request is filed within ten (10) days of a decision by an administrative patent judge denying the motion for suspension or such other time as the administrative patent judge may set. For concurrent inter partes reexamination and interference of a patent, see § 1.993.

§§ 1.601 through 1.690 (Subpart E) [Removed]

■ 37. Remove and reserve subpart E of part 1.

■ 38. In § 1.701, revise paragraph (c)(2)(ii) to read as follows:

§ 1.701 Extension of patent term due to examination delay under the Uruguay Round Agreements Act (original applications, other than designs, filed on or after June 8, 1995, and before May 29, 2000).

* * * * *

(c) * * *

(2) * * *

(ii) The number of days, if any, in the period beginning on the date of mailing of an examiner's answer under § 41.39 of this title in the application under secrecy order and ending on the date the secrecy order and any renewal thereof was removed;

* * * * *

■ 39. In § 1.703, revise paragraphs (a)(4), (b)(3)(ii), (b)(4), (d)(2), and (e) to read as follows:

§ 1.703 Period of adjustment of patent term due to examination delay.

(a) * * *

(4) The number of days, if any, in the period beginning on the day after the date that is four months after the date an appeal brief in compliance with § 41.37 of this title was filed and ending on the date of mailing of any of an examiner's answer under § 41.39 of this title, an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

* * * * *

(b) * * *

(3) * * *

(ii) The number of days, if any, in the period beginning on the date of mailing of an examiner's answer under § 41.39 of this title in the application under secrecy order and ending on the date the secrecy order was removed;

* * * * *

(4) The number of days, if any, in the period beginning on the date on which a notice of appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and § 41.31 of this title and ending on the date of the last decision by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145, or on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first, if the appeal did not result in a decision by the Board of Patent Appeals and Interferences.

* * * * *

(d) * * *

(2) The number of days, if any, in the period beginning on the date of mailing of an examiner's answer under § 41.39 of this title in the application under secrecy order and ending on the date the secrecy order was removed;

* * * * *

(e) The period of adjustment under § 1.702(e) is the sum of the number of days, if any, in the period beginning on the date on which a notice of appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and § 41.31 of this title and ending on the date of a final decision in favor of the applicant by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145.

* * * * *

■ 40. In § 1.704, revise paragraph (c)(9) to read as follows:

§ 1.704 Reduction of period of adjustment of patent term.

* * * * *

(c) * * *

(9) Submission of an amendment or other paper after a decision by the Board of Patent Appeals and Interferences, other than a decision designated as containing a new ground of rejection under § 41.50(b) of this title or statement under § 41.50(c) of this title, or a decision by a Federal court, less than one month before the mailing of an Office action under 35 U.S.C. 132 or notice of allowance under 35 U.S.C. 151 that requires the mailing of a supplemental Office action or supplemental notice of allowance, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the day after the mailing date of the original Office action or notice of allowance and ending on the mailing date of the supplemental Office action or notice of allowance; or

(ii) Four months;

* * * * *

■ 41. Revise § 1.959 to read as follows:

§ 1.959 Appeal in inter partes reexamination.

Appeals to the Board of Patent Appeals and Interferences under 35 U.S.C. 134(c) are conducted according to part 41 of this title.

§§ 1.961, 1.962, 1.963, 1.965, 1.967, 1.969, 1.971, 1.973, 1.975, and 1.977 [Removed and reserved]

■ 42. Remove and reserve §§ 1.961 through 1.977.

■ 43. Revise § 1.979 to read as follows:

§ 1.979 Return of Jurisdiction from the Board of Patent Appeals and Interferences; termination of proceedings.

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

(b) Upon judgment in the appeal before the Board of Patent Appeals and Interferences, if no further appeal has been taken (§ 1.983), the *inter partes* reexamination proceeding will be terminated and the Director will issue a certificate under § 1.997 terminating the proceeding. If an appeal to the U.S. Court of Appeals for the Federal Circuit has been filed, that appeal is considered terminated when the mandate is issued by the Court.

■ 44. Revise § 1.981 to read as follows:

§ 1.981 Reopening after a final decision of the Board of Patent Appeals and Interferences.

When a decision by the Board of Patent Appeals and Interferences on appeal has become final for judicial review, prosecution of the *inter partes* reexamination proceeding will not be reopened or reconsidered by the primary examiner except under the provisions of § 41.77 of this title without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

■ 45. Revise § 1.993 to read as follows:

§ 1.993 Suspension of concurrent interference and inter partes reexamination proceeding.

If a patent in the process of inter partes reexamination is or becomes involved in an interference, the Director may suspend the inter partes reexamination or the interference. The Director will not consider a request to suspend an interference unless a motion under § 41.121(a)(3) of this title to suspend the interference has been presented to, and denied by, an administrative patent judge and the request is filed within ten (10) days of a decision by an administrative patent judge denying the motion for suspension or such other time as the administrative patent judge may set.

PART 5—SECRECY OF CERTAIN INVENTIONS AND LICENSES TO EXPORT AND FILE APPLICATIONS IN FOREIGN COUNTRIES

■ 45a. The authority citation for part 5 continues to read as follows:

Authority: 35 U.S.C. 2(b)(2), 41, 181–188, as amended by the Patent Law Foreign Filing Amendments Act of 1988, Pub. L. 100–418, 102 Stat. 1567; the Arms Export Control Act, as amended, 22 U.S.C. 2571 *et seq.*; the Atomic Energy Act of 1954, as amended, 42 U.S.C. 2011 *et seq.*; the Nuclear Non Proliferation Act of 1978; 22 U.S.C. 3201 *et seq.*; and the delegations in the regulations under these Acts to the Director (15 CFR 370.10(j), 22 CFR 125.04, and 10 CFR 810.7).

■ 46. In § 5.3, revise paragraph (b) to read as follows:

§ 5.3 Prosecution of application under secrecy orders; withholding patent.

* * * * *

(b) An interference will not be declared involving a national application under secrecy order. An applicant whose application is under secrecy order may suggest an interference (§ 41.202(a) of this title), but the Office will not act on the request

while the application remains under a secrecy order.

* * * * *

PART 10—REPRESENTATIVE OF OTHERS BEFORE THE PATENT AND TRADEMARK OFFICE

■ 46a. The authority citation for part 10 continues to read as follows:

Authority: 5 U.S.C. 500, 15 U.S.C. 1123; 35 U.S.C. 2(b)(2), 31, 32, 41.

■ 47. In § 10.23, revise paragraph (c)(7) to read as follows:

§ 10.23 Misconduct.

* * * * *

(c) * * *

(7) Knowingly withholding from the Office information identifying a patent or patent application of another from which one or more claims have been copied. See § 41.202(a)(1) of this title.

* * * * *

PART 11—REPRESENTATION OF OTHERS BEFORE THE PATENT AND TRADEMARK OFFICE

■ 47a. The authority citation for part 11 continues to read as follows:

Authority: 5 U.S.C. 500, 15 U.S.C. 1123; 35 U.S.C. 2(b)(2)(D), 32.

■ 48. In § 11.6, revise paragraph (d) to read as follows:

§ 11.6 Registration of attorneys and agents.

* * * * *

(d) *Board of Patent Appeals and Interferences matters.* For action by a person who is not registered in a proceeding before the Board of Patent Appeals and Interferences, see § 41.5(a) of this title.

■ 49. Add part 41 to subchapter A to read as follows:

Authority: 35 U.S.C. 2(b)(2), 3(a)(2)(A), 21, 23, 32, 41, 134, 135.

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

Subpart A—General Provisions

Subpart B—Ex Parte Appeals

Subpart C—Inter Partes Appeals

Subpart D—Contested Cases

Subpart E—Patent Interferences

Subpart A—General Provisions

§ 41.1 Policy.

(a) *Scope.* Part 41 governs proceedings before the Board of Patent Appeals and Interferences. Sections 1.1 to 1.36 and 1.181 to 1.183 of this title also apply to practice before the Board, as do other sections of part 1 of this title that are incorporated by reference into part 41.

(b) *Construction.* The provisions of Part 41 shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding before the Board.

(c) *Decorum.* Each party must act with courtesy and decorum in all proceedings before the Board, including interactions with other parties.

§ 41.2 Definitions.

Unless otherwise clear from the context, the following definitions apply to proceedings under this part:

Affidavit means affidavit, declaration under § 1.68 of this title, or statutory declaration under 28 U.S.C. 1746. A transcript of an ex parte deposition may be used as an affidavit in a contested case.

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

(1) For a final Board action:

(i) In an appeal or contested case, a panel of the Board.

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

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

Board member means the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, the Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the United States Patent and Trademark Office, the Commissioner for Patents, the Commissioner for Trademarks, and the administrative patent judges.

Contested case means a Board proceeding other than an appeal under 35 U.S.C. 134 or a petition under § 41.3. An appeal in an inter partes reexamination is not a contested case.

Final means, with regard to a Board action, final for the purposes of judicial review. A decision is final only if:

(1) *In a panel proceeding.* The decision is rendered by a panel,

disposes of all issues with regard to the party seeking judicial review, and does not indicate that further action is required; and

(2) *In other proceedings*. The decision disposes of all issues or the decision states it is final.

Hearing means consideration of the issues of record. *Rehearing* means reconsideration.

Office means United States Patent and Trademark Office.

Panel means at least three Board members acting in a panel proceeding.

Panel proceeding means a proceeding in which final action is reserved by statute to at least three Board members, but includes a non-final portion of such a proceeding whether administered by a panel or not.

Party, in this part, means any entity participating in a Board proceeding, other than officers and employees of the Office, including:

(1) An appellant;

(2) A participant in a contested case;

(3) A petitioner; and

(4) Counsel for any of the above, where context permits.

§ 41.3 Petitions.

(a) *Deciding official*. Petitions must be addressed to the Chief Administrative Patent Judge. A panel or an administrative patent judge may certify a question of policy to the Chief Administrative Patent Judge for decision. The Chief Administrative Patent Judge may delegate authority to decide petitions.

(b) *Scope*. This section covers petitions on matters pending before the Board (§§ 41.35, 41.64, 41.103, and 41.205); otherwise, see §§ 1.181 to 1.183 of this title. The following matters are not subject to petition:

(1) Issues committed by statute to a panel, and

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

(c) *Petition fee*. The fee set in § 41.20(a) must accompany any petition under this section except no fee is required for a petition under this section seeking supervisory review.

(d) *Effect on proceeding*. The filing of a petition does not stay the time for any other action in a Board proceeding.

(e) *Time for action*. (1) Except as otherwise provided in this part or as the Board may authorize in writing, a party may:

(i) File the petition within 14 calendar days from the date of the action from which the party is requesting relief, and

(ii) File any request for reconsideration of a petition decision within 14 calendar days of the decision on petition or such other time as the Board may set.

(2) A party may not file an opposition or a reply to a petition without Board authorization.

§ 41.4 Timeliness.

(a) *Extensions of time*. Extensions of time will be granted only on a showing of good cause except as otherwise provided by rule.

(b) *Late filings*. (1) A late filing that results in either an application becoming abandoned or a reexamination proceeding becoming terminated under §§ 1.550(d) or 1.957(b) or (c) of this title may be revived as set forth in § 1.137 of this title.

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

(c) *Scope*. This section governs all proceedings before the Board, but does not apply to filings related to Board proceedings before or after the Board has jurisdiction, such as:

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

(2) Filing of a brief or request for oral hearing (see §§ 41.37, 41.41, 41.47, 41.67, 41.68, 41.71 and 41.73), or

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

§ 41.5 Counsel.

While the Board has jurisdiction:

(a) *Appearance pro hac vice*. The Board may authorize a person other than a registered practitioner to appear as counsel in a specific proceeding.

(b) *Disqualification*. (1) The Board may disqualify counsel in a specific proceeding after notice and an opportunity to be heard.

(2) A decision to disqualify is not final for the purposes of judicial review until certified by the Chief Administrative Patent Judge.

(c) *Withdrawal*. Counsel may not withdraw from a proceeding before the Board unless the Board authorizes such withdrawal. See § 10.40 of this title regarding conditions for withdrawal.

(d) *Procedure*. The Board may institute a proceeding under this section on its own or a party in a contested case may request relief under this section.

(e) *Referral to the Director of Enrollment and Discipline*. Possible violations of the disciplinary rules in part 10 of this title may be referred to the Office of Enrollment and Discipline for investigation. See § 10.131 of this title.

§ 41.6 Public availability of Board records.

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

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

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

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

§ 41.7 Management of the record.

(a) The Board may expunge any paper directed to a Board proceeding, or filed while an application or patent is under the jurisdiction of the Board, that is not authorized under this part or in a Board order, or that is filed contrary to a Board order.

(b) A party may not file a paper previously filed in the same Board proceeding, not even as an exhibit or

appendix, without Board authorization or as required by rule.

§ 41.8 Mandatory notices.

(a) In an appeal brief (§§ 41.37, 41.67, or 41.68) or at the initiation of a contested case (§ 41.101), and within 20 days of any change during the proceeding, a party must identify:

(1) Its real party-in-interest, and

(2) Each judicial or administrative proceeding that could affect, or be affected by, the Board proceeding.

(b) For contested cases, a party seeking judicial review of a Board proceeding must file a notice with the Board of the judicial review within 20 days of the filing of the complaint or the notice of appeal. The notice to the Board must include a copy of the complaint or notice of appeal. See also §§ 1.301 to 1.304 of this title.

§ 41.9 Action by owner.

(a) *Entire interest.* An owner of the entire interest in an application or patent involved in a Board proceeding may act in the proceeding to the exclusion of the inventor (see § 3.73(b) of this title).

(b) *Part interest.* An owner of a part interest in an application or patent involved in a Board proceeding may petition to act in the proceeding to the exclusion of an inventor or a co-owner. The petition must show the inability or refusal of an inventor or co-owner to prosecute the proceeding or other cause why it is in the interest of justice to permit the owner of a part interest to act in the proceeding. An order granting the petition may set conditions on the actions of the parties during the proceeding.

§ 41.10 Correspondence addresses.

Except as the Board may otherwise direct,

(a) *Appeals.* Correspondence in an application or a patent involved in an appeal (subparts B and C of this part) during the period beginning when an appeal docketing notice is issued and ending when a decision has been rendered by the Board, as well as any request for rehearing of a decision by the Board, shall be mailed to: Board of Patent Appeals and Interferences, United States Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313–1450. Notices of appeal, appeal briefs, reply briefs, requests for oral hearing, as well as all other correspondence in an application or a patent involved in an appeal to the Board for which an address is not otherwise specified, should be addressed as set out in § 1.1(a)(1)(i) of this title.

(b) *Contested cases.* Mailed correspondence in contested cases (subpart D of this part) shall be sent to Mail Stop INTERFERENCE, Board of Patent Appeals and Interferences, United States Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313–1450.

§ 41.11 Ex Parte communications in inter partes proceedings.

An ex parte communication about an inter partes reexamination (subpart C of this part) or about a contested case (subparts D and E of this part) with a Board member, or with a Board employee assigned to the proceeding, is not permitted.

§ 41.12 Citation of authority.

(a) Citations to authority must include:

(1) *For any United States Supreme Court decision*, a United States Reports citation.

(2) *For any decision other than a United States Supreme Court decision*, parallel citation to both the West Reporter System and to the United States Patents Quarterly whenever the case is published in both. Other parallel citations are discouraged.

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

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

§ 41.20 Fees.

(a) *Petition fee.* The fee for filing a petition under this part is	$130.00
(b) *Appeal fees.* (1) For filing a notice of appeal from the examiner to the Board:	
By a small entity (§ 1.27(a) of this title)	165.00
By other than a small entity	330.00
(2) In addition to the fee for filing a notice of appeal, for filing a brief in support of an appeal:	
By a small entity (§ 1.27(a) of this title)	165.00
By other than a small entity	330.00
(3) For filing a request for an oral hearing before the Board in an appeal under 35 U.S.C. 134:	
By a small entity (§ 1.27(a) of this title)	145.00
By other than a small entity	290.00

Subpart B—Ex Parte Appeals

§ 41.30 Definitions.

In addition to the definitions in § 41.2, the following definitions apply to proceedings under this subpart unless otherwise clear from the context:

Applicant means either the applicant in a national application for a patent or the applicant in an application for reissue of a patent.

Owner means the owner of the patent undergoing ex parte reexamination under § 1.510 of this title.

Proceeding means either a national application for a patent, an application for reissue of a patent, or an *ex parte* reexamination proceeding. Appeal to the Board in an *inter partes* reexamination proceeding is controlled by subpart C of this part.

§ 41.31 Appeal to Board.

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

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

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

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

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

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

§ 41.33 Amendments and affidavits or other evidence after appeal.

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

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

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

(2) To rewrite dependent claims into independent form.

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

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

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

§ 41.35 Jurisdiction over appeal.

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

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

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

§ 41.37 Appeal brief.

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

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

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

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

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

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

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

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

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

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

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

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

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

appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

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

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

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

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

§ 41.39 Examiner's answer.

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

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

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

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

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

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

§ 41.41 Reply brief.

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

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

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

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

§ 41.43 Examiner's response to reply brief.

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

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

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

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

§ 41.47 Oral hearing.

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

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

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

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

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

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

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

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

§ 41.50 Decisions and other actions by the Board.

(a)(1) The Board, in its decision, may affirm or reverse the decision of the examiner in whole or in part on the grounds and on the claims specified by the examiner. The affirmance of the rejection of a claim on any of the grounds specified constitutes a general affirmance of the decision of the examiner on that claim, except as to any ground specifically reversed. The Board may also remand an application to the examiner.

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

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

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

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

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

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

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

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

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

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

§ 41.52 Rehearing.

(a)(1) Appellant may file a single request for rehearing within two months of the date of the original decision of the Board. No request for rehearing from a decision on rehearing will be permitted, unless the rehearing decision so modified the original decision as to become, in effect, a new decision, and the Board states that a second request for rehearing would be permitted. The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board. Arguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) and (a)(3) of this section. When a request for rehearing is made, the Board shall render a decision on the request for rehearing. The decision on the request for rehearing is deemed to incorporate the earlier opinion reflecting its decision for appeal, except for those portions specifically withdrawn on rehearing, and is final for the purpose of judicial review, except when noted otherwise in the decision on rehearing.

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

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

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

§ 41.54 Action following decision.

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

Subpart C—Inter Partes Appeals

§ 41.60 Definitions.

In addition to the definitions in § 41.2, the following definitions apply to proceedings under this subpart unless otherwise clear from the context:

Appellant means any party, whether the owner or a requester, filing a notice of appeal or cross appeal under § 41.61. If more than one party appeals or cross appeals, each appealing or cross appealing party is an appellant with respect to the claims to which his or her appeal or cross appeal is directed.

Filing means filing with a certificate indicating service of the document under § 1.903 of this title.

Owner means the owner of the patent undergoing *inter partes* reexamination under § 1.915 of this title.

Proceeding means an *inter partes* reexamination proceeding. Appeal to the Board in an *ex parte* reexamination proceeding is controlled by subpart B of this part. An *inter partes* reexamination proceeding is not a contested case subject to subpart D.

Requester means each party, other than the owner, who requested that the patent undergo *inter partes* reexamination under § 1.915 of this title.

Respondent means any requester responding under § 41.68 to the appellant's brief of the owner, or the owner responding under § 41.68 to the appellant's brief of any requester. No requester may be a respondent to the appellant brief of any other requester.

§ 41.61 Notice of appeal and cross appeal to Board.

(a)(1) Upon the issuance of a Right of Appeal Notice under § 1.953 of this title, the owner may appeal to the Board with respect to the final rejection of any claim of the patent by filing a notice of appeal within the time provided in the Right of Appeal Notice and paying the fee set forth in § 41.20(b)(1).

(2) Upon the issuance of a Right of Appeal Notice under § 1.953 of this title, the requester may appeal to the Board with respect to any final decision favorable to the patentability, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent by filing a notice of appeal within the time provided in the Right of Appeal Notice and paying the fee set forth in § 41.20(b)(1).

(b)(1) Within fourteen days of service of a requester's notice of appeal under paragraph (a)(2) of this section and upon payment of the fee set forth in § 41.20(b)(1), an owner who has not filed a notice of appeal may file a notice of cross appeal with respect to the final rejection of any claim of the patent.

(2) Within fourteen days of service of an owner's notice of appeal under paragraph (a)(1) of this section and upon payment of the fee set forth in § 41.20(b)(1), a requester who has not filed a notice of appeal may file a notice of cross appeal with respect to any final decision favorable to the patentability, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent.

(c) The notice of appeal or cross appeal in the proceeding must identify the appealed claim(s) and must be signed by the owner, the requester, or a duly authorized attorney or agent.

(d) An appeal or cross appeal, when taken, must be taken from all the rejections of the claims in a Right of Appeal Notice which the patent owner proposes to contest or from all the determinations favorable to patentability, including any final determination not to make a proposed rejection, in a Right of Appeal Notice which a requester proposes to contest. Questions relating to matters not affecting the merits of the invention may be required to be settled before an appeal is decided.

(e) The time periods for filing a notice of appeal or cross appeal may not be extended.

(f) If a notice of appeal or cross appeal is timely filed but does not comply with any requirement of this section, appellant will be notified of the reasons for non-compliance and given a non-extendable time period within which to file an amended notice of appeal or cross appeal. If the appellant does not then file an amended notice of appeal or cross appeal within the set time period, or files a notice which does not overcome all the reasons for non-compliance stated in the notification of the reasons for non-compliance, that appellant's appeal or cross appeal will stand dismissed.

§ 41.63 Amendments and affidavits or other evidence after appeal.

(a) Amendments filed after the date of filing an appeal pursuant to § 41.61 canceling claims may be admitted where such cancellation does not affect the scope of any other pending claim in the proceeding.

(b) All other amendments filed after the date of filing an appeal pursuant to § 41.61 will not be admitted except as permitted by § 41.77(b)(1).

(c) Affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.61 will not be admitted except as permitted by reopening prosecution under § 41.77(b)(1).

§ 41.64 Jurisdiction over appeal in inter partes reexamination.

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

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

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

§ 41.66 Time for filing briefs.

(a) An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant's brief or an amended appellant's brief may not be extended.

(b) Once an appellant's brief has been properly filed, any brief must be filed by respondent within one month from the date of service of the appellant's brief. The time for filing a respondent's brief or an amended respondent's brief may not be extended.

(c) The examiner will consider both the appellant's and respondent's briefs and may prepare an examiner's answer under § 41.69.

(d) Any appellant may file a rebuttal brief under § 41.71 within one month of the date of the examiner's answer. The

time for filing a rebuttal brief or an amended rebuttal brief may not be extended.

(e) No further submission will be considered and any such submission will be treated in accordance with § 1.939 of this title.

§ 41.67 Appellant's brief.

(a)(1) Appellant(s) may once, within time limits for filing set forth in § 41.66, file a brief and serve the brief on all other parties to the proceeding in accordance with § 1.903 of this title.

(2) The brief must be signed by the appellant, or the appellant's duly authorized attorney or agent and must be accompanied by the requisite fee set forth in § 41.20(b)(2).

(b) An appellant's appeal shall stand dismissed upon failure of that appellant to file an appellant's brief, accompanied by the requisite fee, within the time allowed under § 41.66(a).

(c)(1) The appellant's brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(xi) of this section.

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

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

(iii) *Status of claims.* A statement of the status of all the claims in the proceeding (*e.g.*, rejected, allowed or confirmed, withdrawn, objected to, canceled). If the appellant is the owner, the appellant must also identify the rejected claims whose rejection is being appealed. If the appellant is a requester, the appellant must identify the claims that the examiner has made a determination favorable to patentability, which determination is being appealed.

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

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

(vi) *Issues to be reviewed on appeal.* A concise statement of each issue presented for review. No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

(vii) *Argument.* The contentions of appellant with respect to each issue presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief permitted under this section or §§ 41.68 and 41.71 will be refused consideration by the Board, unless good cause is shown. Each issue must be treated under a separate heading. If the appellant is the patent owner, for each ground of rejection in the Right of Appeal Notice which appellant contests and which applies to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

(viii) *Claims appendix.* An appendix containing a copy of the claims to be reviewed on appeal.

(ix) *Evidence appendix.* An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.63 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner in any ground of rejection to be reviewed on appeal.

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

(xi) *Certificate of service.* A certification that a copy of the brief has been served in its entirety on all other parties to the reexamination proceeding. The names and addresses of the parties served must be indicated.

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63 for amendments, affidavits or other evidence after the date of filing the appeal.

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

§ 41.68 Respondent's brief.

(a)(1) Respondent(s) in an appeal may once, within the time limit for filing set forth in § 41.66, file a respondent brief and serve the brief on all parties in accordance with § 1.903 of this title.

(2) The brief must be signed by the party, or the party's duly authorized attorney or agent, and must be accompanied by the requisite fee set forth in § 41.20(b)(2).

(3) The respondent brief shall be limited to issues raised in the appellant

brief to which the respondent brief is directed.

(4) A requester's respondent brief may not address any brief of any other requester.

(b)(1) The respondent brief shall contain the following items under appropriate headings and in the order here indicated, and may include an appendix containing only those portions of the record on which reliance has been made.

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

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

(iii) *Status of claims.* A statement accepting or disputing appellant's statement of the status of claims. If appellant's statement of the status of claims is disputed, the errors in appellant's statement must be specified with particularity.

(iv) *Status of amendments.* A statement accepting or disputing appellant's statement of the status of amendments. If appellant's statement of the status of amendments is disputed, the errors in appellant's statement must be specified with particularity.

(v) *Summary of claimed subject matter.* A statement accepting or disputing appellant's summary of the subject matter defined in each of the independent claims involved in the appeal. If appellant's summary of the subject matter is disputed, the errors in appellant's summary must be specified.

(vi) *Issues to be reviewed on appeal.* A statement accepting or disputing appellant's statement of the issues presented for review. If appellant's statement of the issues presented for review is disputed, the errors in appellant's statement must be specified. A counter statement of the issues for review may be made. No new ground of rejection can be proposed by a requester respondent.

(vii) *Argument.* A statement accepting or disputing the contentions of appellant with each of the issues presented by the appellant for review. If a contention of the appellant is disputed, the errors in appellant's argument must be specified, stating the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Each issue must be treated under a separate heading. An argument may be made with each of the issues stated in the counter statement of the issues, with each counter-stated issue being treated under a separate heading.

(viii) *Evidence appendix.* An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by respondent in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the respondent's brief. See § 41.63 for treatment of evidence submitted after appeal.

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

(x) *Certificate of service.* A certification that a copy of the respondent brief has been served in its entirety on all other parties to the reexamination proceeding. The names and addresses of the parties served must be indicated.

(2) A respondent brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63 for amendments, affidavits or other evidence filed after the date of filing the appeal.

(c) If a respondent brief is filed which does not comply with all the requirements of paragraph (a) and paragraph (b) of this section, respondent will be notified of the reasons for non-compliance and given a non-extendable time period within which to file an amended brief. If respondent does not file an amended respondent brief within the set time period, or files an amended respondent brief which does not overcome all the reasons for non-compliance stated in the notification, the respondent brief and any amended respondent brief by that respondent will not be considered.

§ 41.69 Examiner's answer.

(a) The primary examiner may, within such time as directed by the Director, furnish a written answer to the owner's and/or requester's appellant brief or respondent brief including, as may be necessary, such explanation of the invention claimed and of the references relied upon, the grounds of rejection, and the reasons for patentability, including grounds for not adopting any proposed rejection. A copy of the answer shall be supplied to the owner and all requesters. If the primary examiner determines that the appeal does not comply with the provisions of §§ 41.61, 41.66, 41.67 and 41.68 or does not relate to an appealable action, the primary examiner shall make such determination of record.

(b) An examiner's answer may not include a new ground of rejection.

(c) An examiner's answer may not include a new determination not to make a proposed rejection of a claim.

(d) Any new ground of rejection, or any new determination not to make a proposed rejection, must be made in an Office action reopening prosecution.

§ 41.71 Rebuttal brief.

(a) Within one month of the examiner's answer, any appellant may once file a rebuttal brief.

(b)(1) The rebuttal brief of the owner may be directed to the examiner's answer and/or any respondent brief.

(2) The rebuttal brief of the owner shall not include any new or non-admitted amendment, or an affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63 for amendments, affidavits or other evidence filed after the date of filing the appeal.

(c)(1) The rebuttal brief of any requester may be directed to the examiner's answer and/or the respondent brief of the owner.

(2) The rebuttal brief of a requester may not be directed to the respondent brief of any other requester.

(3) No new ground of rejection can be proposed by a requester.

(4) The rebuttal brief of a requester shall not include any new or non-admitted affidavit or other evidence. See § 1.116(d) of this title for affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63(c) for affidavits or other evidence filed after the date of filing the appeal.

(d) The rebuttal brief must include a certification that a copy of the rebuttal brief has been served in its entirety on all other parties to the proceeding. The

names and addresses of the parties served must be indicated.

(e) If a rebuttal brief is timely filed under paragraph (a) of this section but does not comply with all the requirements of paragraphs (a) through (d) of this section, appellant will be notified of the reasons for non-compliance and provided with a non-extendable period of one month within which to file an amended rebuttal brief. If the appellant does not file an amended rebuttal brief during the one-month period, or files an amended rebuttal brief which does not overcome all the reasons for non-compliance stated in the notification, that appellant's rebuttal brief and any amended rebuttal brief by that appellant will not be considered.

§ 41.73 Oral hearing.

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

(b) If an appellant or a respondent desires an oral hearing, he or she must file, as a separate paper captioned ''REQUEST FOR ORAL HEARING,'' a written request for such hearing accompanied by the fee set forth in § 41.20(b)(3) within two months after the date of the examiner's answer. The time for requesting an oral hearing may not be extended. The request must include a certification that a copy of the request has been served in its entirety on all other parties to the proceeding. The names and addresses of the parties served must be indicated.

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

(d) If appellant or respondent has complied with all the requirements of paragraph (b) of this section, a hearing date will be set, and notice given to the owner and all requesters. If an oral hearing is held, an oral argument may be presented by, or on behalf of, the primary examiner if considered desirable by either the primary examiner or the Board. The notice shall set a non-extendable period within which all requests for oral hearing shall be submitted by any other party to the appeal desiring to participate in the oral hearing. A hearing will be held as stated in the notice, and oral argument will be limited to thirty minutes for each appellant or respondent who has requested an oral hearing, and twenty minutes for the primary examiner unless otherwise ordered. No appellant or respondent will be permitted to participate in an oral hearing unless he or she has requested an oral hearing and submitted the fee set forth in § 41.20(b)(3).

(e)(1) At the oral hearing, each appellant and respondent may only rely on evidence that has been previously entered and considered by the primary examiner and present argument that has been relied upon in the briefs except as permitted by paragraph (e)(2) of this section. The primary examiner may only rely on argument and evidence relied upon in an answer except as permitted by paragraph (e)(2) of this section. The Board will determine the order of the arguments presented at the oral hearing.

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

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

§ 41.77 Decisions and other actions by the Board.

(a) The Board of Patent Appeals and Interferences, in its decision, may affirm or reverse each decision of the examiner on all issues raised on each appealed claim, or remand the reexamination proceeding to the examiner for further consideration. The reversal of the examiner's determination not to make a rejection proposed by the third party requester constitutes a decision adverse to the patentability of the claims which are subject to that proposed rejection which will be set forth in the decision of the Board of Patent Appeals and Interferences as a new ground of rejection under paragraph (b) of this section. 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.

(b) Should the Board reverse the examiner's determination not to make a rejection proposed by a requester, the Board shall set forth in the opinion in support of its decision a new ground of rejection; or should the Board have knowledge of any grounds not raised in the appeal for rejecting any pending claim, it may include in its opinion a statement to that effect with its reasons for so holding, which statement shall constitute a new ground of rejection of the claim. Any decision which includes a new ground of rejection pursuant to this paragraph shall not be considered final for judicial review. When the Board makes a new ground of rejection, the owner, within one month from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal proceeding as to the rejected claim:

(1) *Reopen prosecution.* The owner may file a response requesting reopening of prosecution before the examiner. Such a response must be either an amendment of the claims so rejected or new evidence relating to the claims so rejected, or both.

(2) *Request rehearing.* The owner may request that the proceeding be reheard under § 41.79 by the Board upon the same record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

(c) Where the owner has filed a response requesting reopening of prosecution under paragraph (b)(1) of this section, any requester, within one month of the date of service of the owner's response, may once file comments on the response. Such written comments must be limited to the issues raised by the Board's opinion reflecting its decision and the owner's response. Any requester that had not previously filed an appeal or cross appeal and is seeking under this subsection to file comments or a reply to the comments is subject to the appeal and brief fees under § 41.20(b)(1) and (2), respectively, which must accompany the comments or reply.

(d) Following any response by the owner under paragraph (b)(1) of this section and any written comments from a requester under paragraph (c) of this section, the proceeding will be remanded to the examiner. The statement of the Board shall be binding upon the examiner unless an amendment or new evidence not previously of record is made which, in the opinion of the examiner, overcomes the new ground of rejection stated in the decision. The examiner will consider any owner response under paragraph (b)(1) of this section and any written comments by a requester under paragraph (c) of this section and issue

a determination that the rejection is maintained or has been overcome.

(e) Within one month of the examiner's determination pursuant to paragraph (d) of this section, the owner or any requester may once submit comments in response to the examiner's determination. Within one month of the date of service of comments in response to the examiner's determination, the owner and any requesters may file a reply to the comments. No requester reply may address the comments of any other requester reply. Any requester that had not previously filed an appeal or cross appeal and is seeking under this subsection to file comments or a reply to the comments is subject to the appeal and brief fees under § 41.20(b)(1) and (2), respectively, which must accompany the comments or reply.

(f) After submission of any comments and any reply pursuant to paragraph (e) of this section, or after time has expired, the proceeding will be returned to the Board which shall reconsider the matter and issue a new decision. The new decision is deemed to incorporate the earlier decision, except for those portions specifically withdrawn.

(g) The time period set forth in paragraph (b) of this section is subject to the extension of time provisions of § 1.956 of this title when the owner is responding under paragraph (b)(1) of this section. The time period set forth in paragraph (b) of this section may not be extended when the owner is responding under paragraph (b)(2) of this section. The time periods set forth in paragraphs (c) and (e) of this section may not be extended.

§ 41.79 Rehearing.

(a) Parties to the appeal may file a request for rehearing of the decision within one month of the date of:

(1) The original decision of the Board under § 41.77(a),

(2) The original § 41.77(b) decision under the provisions of § 41.77(b)(2),

(3) The expiration of the time for the owner to take action under § 41.77(b)(2), or

(4) The new decision of the Board under § 41.77(f).

(b)(1) The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked in rendering the Board's opinion reflecting its decision. Arguments not raised in the briefs before the Board and evidence not previously relied upon in the briefs are not permitted in the request for rehearing except as permitted by paragraphs (b)(2) and (b)(3) of this section.

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

(3) New arguments responding to a new ground of rejection made pursuant to § 41.77(b) are permitted.

(c) Within one month of the date of service of any request for rehearing under paragraph (a) of this section, or any further request for rehearing under paragraph (d) of this section, the owner and all requesters may once file comments in opposition to the request for rehearing or the further request for rehearing. The comments in opposition must be limited to the issues raised in the request for rehearing or the further request for rehearing.

(d) If a party to an appeal files a request for rehearing under paragraph (a) of this section, or a further request for rehearing under this section, the Board shall render a decision on the request for rehearing. The decision on the request for rehearing is deemed to incorporate the earlier opinion reflecting its decision for appeal, except for those portions specifically withdrawn on rehearing and is final for the purpose of judicial review, except when noted otherwise in the decision on rehearing. If the Board opinion reflecting its decision on rehearing becomes, in effect, a new decision, and the Board so indicates, then any party to the appeal may, within one month of the new decision, file a further request for rehearing of the new decision under this subsection. Such further request for rehearing must comply with paragraph (b) of this section.

(e) The times for requesting rehearing under paragraph (a) of this section, for requesting further rehearing under paragraph (c) of this section, and for submitting comments under paragraph (b) of this section may not be extended.

§ 41.81 Action following decision.

The parties to an appeal to the Board may not appeal to the U.S. Court of Appeals for the Federal Circuit under § 1.983 of this title until all parties' rights to request rehearing have been exhausted, at which time the decision of the Board is final and appealable by any party to the appeal to the Board.

Subpart D—Contested Cases

§ 41.100 Definitions.

In addition to the definitions in § 41.2, the following definitions apply to proceedings under this subpart:

Business day means a day other than a Saturday, Sunday, or Federal holiday within the District of Columbia.

Involved means the Board has declared the patent application, patent, or claim so described to be a subject of the contested case.

§ 41.101 Notice of proceeding.

(a) Notice of a contested case will be sent to every party to the proceeding. The entry of the notice initiates the proceeding.

(b) When the Board is unable to provide actual notice of a contested case on a party through the correspondence address of record for the party, the Board may authorize other modes of notice, including:

(1) Sending notice to another address associated with the party, or

(2) Publishing the notice in the Official Gazette of the United States Patent and Trademark Office.

§ 41.102 Completion of examination.

Before a contested case is initiated, except as the Board may otherwise authorize, for each involved application and patent:

(a) Examination or reexamination must be completed, and

(b) There must be at least one claim that:

(1) Is patentable but for a judgment in the contested case, and

(2) Would be involved in the contested case.

§ 41.103 Jurisdiction over involved files.

The Board acquires jurisdiction over any involved file when the Board initiates a contested case. Other proceedings for the involved file within the Office are suspended except as the Board may order.

§ 41.104 Conduct of contested case.

(a) The Board may determine a proper course of conduct in a proceeding for any situation not specifically covered by this part and may enter non-final orders to administer the proceeding.

(b) An administrative patent judge may waive or suspend in a proceeding the application of any rule in this subpart, subject to such conditions as the administrative patent judge may impose.

(c) Times set in this subpart are defaults. In the event of a conflict between a time set by rule and a time set by order, the time set by order is controlling. Action due on a day other than a business day may be completed on the next business day unless the Board expressly states otherwise.

§ 41.106 Filing and service.

(a) *General format requirements.* (1) The paper used for filings must be durable and white. A party must choose to file on either A4-sized paper or 8½

inch × 11 inch paper except in the case of exhibits that require a larger size in order to preserve details of the original. A party may not switch between paper sizes in a single proceeding. Only one side of the paper may be used.

(2) In papers, including affidavits, created for the proceeding:

(i) Markings must be in black ink or must otherwise provide an equivalently permanent, dark, high-contrast image on the paper. The quality of printing must be equivalent to the quality produced by a laser printer. Either a proportional or monospaced font may be used, but the proportional font must be 12-point or larger and a monospaced font must not contain more than 4 characters per centimeter (10 characters per inch). Case names must be underlined or italicized.

(ii) Double spacing must be used except in headings, tables of contents, tables of authorities, indices, signature blocks, and certificates of service. Block quotations may be single-spaced and must be indented. Margins must be at least 2.5 centimeters (1 inch) on all sides.

(b) *Papers other than exhibits*—(1) *Cover sheet.* (i) The cover sheet must include the caption the Board specifies for the proceeding, a header indicating the party and contact information for the party, and a title indicating the sequence and subject of the paper. For example, ''JONES MOTION 2, For benefit of an earlier application''.

(ii) If the Board specifies a color other than white for the cover sheet, the cover sheet must be that color.

(2) Papers must have two 0.5 cm (¼ inch) holes with centers 1 cm (½inch) from the top of the page and 7 cm (2 ¾ inch) apart, centered horizontally on the page.

(3) *Incorporation by reference; combined papers.* Arguments must not be incorporated by reference from one paper into another paper. Combined motions, oppositions, replies, or other combined papers are not permitted.

(4) *Exhibits.* Additional requirements for exhibits appear in § 41.154(c).

(c) *Working copy.* Every paper filed must be accompanied by a working copy marked ''APJ Copy''.

(d) *Specific filing forms.* (1) *Filing by mail.* A paper filed using the EXPRESS MAIL® service of the United States Postal Service will be deemed to be filed as of ''date-in'' on the EXPRESS MAIL® mailing label; otherwise, mail will be deemed to be filed as of the stamped date of receipt at the Board.

(2) *Other modes of filing.* The Board may authorize other modes of filing, including electronic filing and hand filing, and may set conditions for the use of such other modes.

(e) *Service.* (1) Papers filed with the Board, if not previously served, must be served simultaneously on every opposing party except as the Board expressly directs.

(2) If a party is represented by counsel, service must be on counsel.

(3) Service must be by EXPRESS MAIL® or by means at least as fast and reliable as EXPRESS MAIL®. Electronic service is not permitted without Board authorization.

(4) The date of service does not count in computing the time for responding.

(f) *Certificate of service.* (1) Papers other than exhibits must include a certificate of service as a separate page at the end of each paper that must be served on an opposing party.

(2) Exhibits must be accompanied by a certificate of service, but a single certificate may accompany any group of exhibits submitted together.

(3) A certificate of service must state:

(i) The date and manner of service,

(ii) The name and address of every person served, and

(iii) For exhibits filed as a group, the name and number of each exhibit served.

(4) A certificate made by a person other than a registered patent practitioner must be in the form of an affidavit.

§ 41.108 Lead counsel.

(a) A party may be represented by counsel. The Board may require a party to appoint a lead counsel. If counsel is not of record in a party's involved application or patent, then a power of attorney for that counsel for the party's involved application or patent must be filed with the notice required in paragraph (b) of this section.

(b) Within 14 days of the initiation of each contested case, each party must file a separate notice identifying its counsel, if any, and providing contact information for each counsel identified or, if the party has no counsel, then for the party. Contact information must, at a minimum, include:

(1) A mailing address;

(2) An address for courier delivery when the mailing address is not available for such delivery (for example, when the mailing address is a Post Office box);

(3) A telephone number;

(4) A facsimile number; and

(5) An electronic mail address.

(c) A party must promptly notify the Board of any change in the contact information required in paragraph (b) of this section.

§ 41.109 Access to and copies of Office records.

(a) *Request for access or copies.* Any request from a party for access to or copies of Office records directly related to a contested case must be filed with the Board. The request must precisely identify the records and in the case of copies include the appropriate fee set under § 1.19(b) of this title.

(b) *Authorization of access and copies.* Access and copies will ordinarily only be authorized for the following records:

(1) The application file for an involved patent;

(2) An involved application; and

(3) An application for which a party has been accorded benefit under subpart E of this part.

(c) *Missing or incomplete copies.* If a party does not receive a complete copy of a record within 21 days of the authorization, the party must promptly notify the Board.

§ 41.110 Filing claim information.

(a) *Clean copy of claims.* Within 14 days of the initiation of the proceeding, each party must file a clean copy of its involved claims and, if a biotechnology material sequence is a limitation, a clean copy of the sequence.

(b) *Annotated copy of claims.* Within 28 days of the initiation of the proceeding, each party must:

(1) For each involved claim having a limitation that is illustrated in a drawing or biotechnology material sequence, file an annotated copy of the claim indicating in bold face between braces ({}) where each limitation is shown in the drawing or sequence.

(2) For each involved claim that contains a means-plus-function or step-plus-function limitation in the form permitted under 35 U.S.C. 112(6), file an annotated copy of the claim indicating in bold face between braces ({}) the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function.

(c) Any motion to add or amend a claim must include:

(1) A clean copy of the claim,

(2) A claim chart showing where the disclosure of the patent or application provides written description of the subject matter of the claim, and

(3) Where applicable, a copy of the claims annotated according to paragraph (b) of this section.

§ 41.120 Notice of basis for relief.

(a) The Board may require a party to provide a notice stating the relief it requests and the basis for its entitlement to relief. The Board may provide for the

notice to be maintained in confidence for a limited time.

(b) *Effect.* If a notice under paragraph (a) of this section is required, a party will be limited to filing substantive motions consistent with the notice. Ambiguities in the notice will be construed against the party. A notice is not evidence except as an admission by a party-opponent.

(c) *Correction.* A party may move to correct its notice. The motion should be filed promptly after the party becomes aware of the basis for the correction. A correction filed after the time set for filing notices will only be entered if entry would serve the interests of justice.

§ 41.121 Motions.

(a) *Types of motions*—(1) *Substantive motions.* Consistent with the notice of requested relief, if any, and to the extent the Board authorizes, a party may file a motion:

(i) To redefine the scope of the contested case,

(ii) To change benefit accorded for the contested subject matter, or

(iii) For judgment in the contested case.

(2) *Responsive motions.* The Board may authorize a party to file a motion to amend or add a claim, to change inventorship, or otherwise to cure a defect raised in a notice of requested relief or in a substantive motion.

(3) *Miscellaneous motions.* Any request for relief other than a substantive or responsive motion must be filed as a miscellaneous motion.

(b) *Burden of proof.* The party filing the motion has the burden of proof to establish that it is entitled to the requested relief.

(c) *Content of motions; oppositions and replies.* (1) Each motion must be filed as a separate paper and must include:

(i) A statement of the precise relief requested,

(ii) A statement of material facts (see paragraph (d) of this section), and

(iii) A full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence and the governing law, rules, and precedent.

(2) *Compliance with rules.* Where a rule in part 1 of this title ordinarily governs the relief sought, the motion must make any showings required under that rule in addition to any showings required in this part.

(3) The Board may order additional showings or explanations as a condition for filing a motion.

(d) *Statement of material facts.* (1) Each material fact shall be set forth as a separate numbered sentence with specific citations to the portions of the record that support the fact.

(2) The Board may require that the statement of material facts be submitted as a separate paper.

(e) *Claim charts.* Claim charts must be used in support of any paper requiring the comparison of a claim to something else, such as another claim, prior art, or a specification. Claim charts must accompany the paper as an appendix. Claim charts are not a substitute for appropriate argument and explanation in the paper.

(f) The Board may order briefing on any issue that could be raised by motion.

§ 41.122 Oppositions and replies.

(a) Oppositions and replies must comply with the content requirements for motions and must include a statement identifying material facts in dispute. Any material fact not specifically denied shall be considered admitted.

(b) All arguments for the relief requested in a motion must be made in the motion. A reply may only respond to arguments raised in the corresponding opposition.

§ 41.123 Default filing times.

(a) A *motion,* other than a miscellaneous motion, may only be filed according to a schedule the Board sets. The default times for acting are:

(1) An *opposition* is due 30 days after service of the motion.

(2) A *reply* is due 30 days after service of the opposition.

(3) A *responsive motion* is due 30 days after the service of the motion.

(b) *Miscellaneous motions.* (1) If no time for filing a specific miscellaneous motion is provided in this part or in a Board order:

(i) The opposing party must be consulted prior to filing the miscellaneous motion, and

(ii) If an opposing party plans to oppose the miscellaneous motion, the movant may not file the motion without Board authorization. Such authorization should ordinarily be obtained through a telephone conference including the Board and every other party to the proceeding. Delay in seeking relief may justify a denial of the motion.

(2) An opposition may not be filed without authorization. The default times for acting are:

(i) An *opposition* to a miscellaneous motion is due five business days after service of the motion.

(ii) A *reply* to a miscellaneous motion opposition is due three business days after service of the opposition.

(c) *Exhibits.* Each exhibit must be filed and served with the first paper in which it is cited except as the Board may otherwise order.

§ 41.124 Oral argument.

(a) *Request for oral argument.* A party may request an oral argument on an issue raised in a paper within five business days of the filing of the paper. The request must be filed as a separate paper and must specify the issues to be considered.

(b) *Copies for panel.* If an oral argument is set for a panel, the movant on any issue to be argued must provide three working copies of the motion, the opposition, and the reply. Each party is responsible for providing three working copies of its exhibits relating to the motion.

(c) *Length of argument.* If a request for oral argument is granted, each party will have a total of 20 minutes to present its arguments, including any time for rebuttal.

(d) *Demonstrative exhibits* must be served at least five business days before the oral argument and filed no later than the time of the oral argument.

(e) *Transcription.* The Board encourages the use of a transcription service at oral arguments but, if such a service is to be used, the Board must be notified in advance to ensure adequate facilities are available and a transcript must be filed with the Board promptly after the oral argument.

§ 41.125 Decision on motions.

(a) *Order of consideration.* The Board may take up motions for decisions in any order, may grant, deny, or dismiss any motion, and may take such other action appropriate to secure the just, speedy, and inexpensive determination of the proceeding. A decision on a motion may include deferral of action on an issue until a later point in the proceeding.

(b) *Interlocutory decisions.* A decision on motions without a judgment is not final for the purposes of judicial review. A panel decision on an issue will govern further proceedings in the contested case.

(c) *Rehearing*—(1) *Time for request.* A request for rehearing of a decision on a motion must be filed within fourteen days of the decision.

(2) *No tolling.* The filing of a request for rehearing does not toll times for taking action.

(3) *Burden on rehearing.* The burden of showing a decision should be modified lies with the party attacking the decision. The request must specifically identify:

(i) All matters the party believes to have been misapprehended or overlooked, and

(ii) The place where the matter was previously addressed in a motion, opposition, or reply.

(4) *Opposition; reply.* Neither an opposition nor a reply to a request for rehearing may be filed without Board authorization.

(5) *Panel rehearing.* If a decision is not a panel decision, the party requesting rehearing may request that a panel rehear the decision. A panel rehearing a procedural decision will review the decision for an abuse of discretion.

§ 41.126 Arbitration.

(a) Parties to a contested case may resort to binding arbitration to determine any issue in a contested case. The Office is not a party to the arbitration. The Board is not bound and may independently determine questions of patentability, jurisdiction, and Office practice.

(b) The Board will not authorize arbitration unless:

(1) It is to be conducted according to Title 9 of the United States Code.

(2) The parties notify the Board in writing of their intention to arbitrate.

(3) The agreement to arbitrate:

(i) Is in writing,

(ii) Specifies the issues to be arbitrated,

(iii) Names the arbitrator, or provides a date not more than 30 days after the execution of the agreement for the selection of the arbitrator, and

(iv) Provides that the arbitrator's award shall be binding on the parties and that judgment thereon can be entered by the Board.

(4) A copy of the agreement is filed within 20 days after its execution.

(5) The arbitration is completed within the time the Board sets.

(c) The parties are solely responsible for the selection of the arbitrator and the conduct of proceedings before the arbitrator.

(d) Issues not disposed of by the arbitration will be resolved in accordance with the procedures established in this subpart.

(e) The Board will not consider the arbitration award unless it:

(1) Is binding on the parties,

(2) Is in writing,

(3) States in a clear and definite manner each issue arbitrated and the disposition of each issue, and

(4) Is filed within 20 days of the date of the award.

(f) Once the award is filed, the parties to the award may not take actions inconsistent with the award. If the award is dispositive of the contested subject matter for a party, the Board may enter judgment as to that party.

§ 41.127 Judgment.

(a) *Effect within Office*—(1) *Estoppel.* A judgment disposes of all issues that were, or by motion could have properly been, raised and decided. A losing party who could have properly moved for relief on an issue, but did not so move, may not take action in the Office after the judgment that is inconsistent with that party's failure to move, except that a losing party shall not be estopped with respect to any contested subject matter for which that party was awarded a favorable judgment.

(2) *Final disposal of claim.* Adverse judgment against a claim is a final action of the Office requiring no further action by the Office to dispose of the claim permanently.

(b) *Request for adverse judgment.* A party may at any time in the proceeding request judgment against itself. Actions construed to be a request for adverse judgment include:

(1) Abandonment of an involved application such that the party no longer has an application or patent involved in the proceeding,

(2) Cancellation or disclaiming of a claim such that the party no longer has a claim involved in the proceeding,

(3) Concession of priority or unpatentability of the contested subject matter, and

(4) Abandonment of the contest.

(c) *Recommendation.* The judgment may include a recommendation for further action by the examiner or by the Director. If the Board recommends rejection of a claim of an involved application, the examiner must enter and maintain the recommended rejection unless an amendment or showing of facts not previously of record is filed which, in the opinion of the examiner, overcomes the recommended rejection.

(d) *Rehearing.* A party dissatisfied with the judgment may file a request for rehearing within 30 calendar days of the entry of the judgment. The request must specifically identify all matters the party believes to have been misapprehended or overlooked, and the place where the matter was previously addressed in a motion, opposition, or reply.

§ 41.128 Sanctions.

(a) The Board may impose a sanction against a party for misconduct, including:

(1) Failure to comply with an applicable rule or order in the proceeding;

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

(3) Engaging in dilatory tactics.

(b) Sanctions include entry of:

(1) An order holding certain facts to have been established in the proceeding;

(2) An order expunging, or precluding a party from filing, a paper;

(3) An order precluding a party from presenting or contesting a particular issue;

(4) An order precluding a party from requesting, obtaining, or opposing discovery;

(5) An order excluding evidence;

(6) An order awarding compensatory expenses, including attorney fees;

(7) An order requiring terminal disclaimer of patent term; or

(8) Judgment in the contested case.

§ 41.150 Discovery.

(a) *Limited discovery.* A party is not entitled to discovery except as authorized in this subpart. The parties may agree to discovery among themselves at any time.

(b) *Automatic discovery.* (1) Within 21 days of a request by an opposing party, a party must:

(i) Serve a legible copy of every requested patent, patent application, literature reference, and test standard mentioned in the specification of the party's involved patent or application, or application upon which the party will rely for benefit, and, if the requested material is in a language other than English, a translation, if available, and

(ii) File with the Board a notice (without copies of the requested materials) of service of the requested materials.

(2) Unless previously served, or the Board orders otherwise, any exhibit cited in a motion or in testimony must be served with the citing motion or testimony.

(c) *Additional discovery.* (1) A party may request additional discovery. The requesting party must show that such additional discovery is in the interests of justice. The Board may specify conditions for such additional discovery.

(2) When appropriate, a party may obtain production of documents and things during cross examination of an opponent's witness or during testimony authorized under § 41.156.

§ 41.151 Admissibility.

Evidence that is not taken, sought, or filed in accordance with this subpart shall not be admissible.

§ 41.152 Applicability of the Federal Rules of Evidence.

(a) *Generally.* Except as otherwise provided in this subpart, the Federal Rules of Evidence shall apply to contested cases.

(b) *Exclusions.* Those portions of the Federal Rules of Evidence relating to criminal proceedings, juries, and other matters not relevant to proceedings under this subpart shall not apply.

(c) *Modifications in terminology.* Unless otherwise clear from context, the following terms of the Federal Rules of Evidence shall be construed as indicated:

Appellate court means United States Court of Appeals for the Federal Circuit or a United States district court when judicial review is under 35 U.S.C. 146.

Civil action, civil proceeding, action, and *trial* mean contested case.

Courts of the United States, U.S. Magistrate, court, trial court, and *trier of fact* mean Board.

Hearing means:

(i) In Federal Rule of Evidence 703, the time when the expert testifies.

(ii) In Federal Rule of Evidence 804(a)(5), the time for taking testimony.

Judge means the Board.

Judicial notice means official notice.

Trial or hearing means, in Federal Rule of Evidence 807, the time for taking testimony.

(d) The Board, in determining foreign law, may consider any relevant material or source, including testimony, whether or not submitted by a party or admissible under the Federal Rules of Evidence.

§ 41.153 Records of the Office.

Certification is not necessary as a condition to admissibility when the evidence to be submitted is a record of the Office to which all parties have access.

§ 41.154 Form of evidence.

(a) Evidence consists of affidavits, transcripts of depositions, documents, and things. All evidence must be submitted in the form of an exhibit.

(b) *Translation required.* When a party relies on a document or is required to produce a document in a language other than English, a translation of the document into English and an affidavit attesting to the accuracy of the translation must be filed with the document.

(c) An exhibit must conform with the requirements for papers in § 41.106 of this subpart and the requirements of this paragraph.

(1) Each exhibit must have an exhibit label with a unique number in a range assigned by the Board, the names of the parties, and the proceeding number in the following format:

JONES EXHIBIT 2001
Jones v. Smith
Interference 104,999

(2) When the exhibit is a paper:

(i) Each page must be uniquely numbered in sequence, and

(ii) The exhibit label must be affixed to the lower right corner of the first page of the exhibit without obscuring information on the first page or, if obscuring is unavoidable, affixed to a duplicate first page.

(d) *Exhibit list.* Each party must maintain an exhibit list with the exhibit number and a brief description of each exhibit. If the exhibit is not filed, the exhibit list should note that fact. The Board may require the filing of a current exhibit list prior to acting on a motion.

§ 41.155 Objection; motion to exclude; motion in limine.

(a) *Deposition.* Objections to deposition evidence must be made during the deposition. Evidence to cure the objection must be provided during the deposition unless the parties to the deposition stipulate otherwise on the deposition record.

(b) *Other than deposition.* For evidence other than deposition evidence:

(1) *Objection.* Any objection must be filed within five business days of service of evidence, other than deposition evidence, to which the objection is directed. The objection must identify the grounds for the objection with sufficient particularity to allow correction in the form of supplemental evidence.

(2) *Supplemental evidence.* The party relying on evidence to which an objection is timely filed may respond to the objection by filing supplemental evidence within ten business days of service of the objection.

(c) *Motion to exclude.* A miscellaneous motion to exclude evidence must be filed to preserve any objection. The motion must identify the objections in the record in order and must explain the objections.

(d) *Motion in limine.* A party may file a miscellaneous motion in limine for a ruling on the admissibility of evidence.

§ 41.156 Compelling testimony and production.

(a) *Authorization required.* A party seeking to compel testimony or production of documents or things must file a miscellaneous motion for authorization. The miscellaneous motion must describe the general relevance of the testimony, document, or thing and must:

(1) In the case of testimony, identify the witness by name or title, and

(2) In the case of a document or thing, the general nature of the document or thing.

(b) *Outside the United States.* For testimony or production sought outside the United States, the motion must also:

(1) *In the case of testimony.* (i) Identify the foreign country and explain why the party believes the witness can be compelled to testify in the foreign country, including a description of the procedures that will be used to compel the testimony in the foreign country and an estimate of the time it is expected to take to obtain the testimony; and

(ii) Demonstrate that the party has made reasonable efforts to secure the agreement of the witness to testify in the United States but has been unsuccessful in obtaining the agreement, even though the party has offered to pay the expenses of the witness to travel to and testify in the United States.

(2) *In the case of production of a document or thing.* (i) Identify the foreign country and explain why the party believes production of the document or thing can be compelled in the foreign country, including a description of the procedures that will be used to compel production of the document or thing in the foreign country and an estimate of the time it is expected to take to obtain production of the document or thing; and

(ii) Demonstrate that the party has made reasonable efforts to obtain the agreement of the individual or entity having possession, custody, or control of the document to produce the document or thing in the United States but has been unsuccessful in obtaining that agreement, even though the party has offered to pay the expenses of producing the document or thing in the United States.

§ 41.157 Taking testimony.

(a) *Form.* Direct testimony must be submitted in the form of an affidavit except when the testimony is compelled under 35 U.S.C. 24, in which case it may be in the form of a deposition transcript.

(b) *Time and location.* (1) *Uncompelled direct testimony* may be taken at any time; otherwise, testimony may only be taken during such time period as the Board may authorize.

(2) *Other testimony.* (i) Except as the Board otherwise orders, authorized testimony may be taken at any reasonable time and location within the United States before any disinterested official authorized to administer oaths at that location.

(ii) Testimony outside the United States may only be taken as the Board specifically directs.

(c) *Notice of deposition.* (1) Prior to the taking of testimony, all parties to the proceeding must agree on the time and place for taking testimony. If the parties cannot agree, the party seeking the testimony must initiate a conference with the Board to set a time and place.

(2) Cross-examination should ordinarily take place after any supplemental evidence relating to the direct testimony has been filed and more than a week before the filing date for any paper in which the cross-examination testimony is expected to be used. A party requesting cross-examination testimony of more than one witness may choose the order in which the witnesses are to be cross-examined.

(3) In the case of direct testimony, at least three business days prior to the conference in paragraph (c)(1) of this section, the party seeking the direct testimony must serve:

(i) A list and copy of each document under the party's control and on which the party intends to rely, and

(ii) A list of, and proffer of reasonable access to, any thing other than a document under the party's control and on which the party intends to rely.

(4) Notice of the deposition must be filed at least two business days before a deposition. The notice limits the scope of the testimony and must list:

(i) The time and place of the deposition,

(ii) The name and address of the witness,

(iii) A list of the exhibits to be relied upon during the deposition, and

(iv) A general description of the scope and nature of the testimony to be elicited.

(5) *Motion to quash.* Objection to a defect in the notice is waived unless a miscellaneous motion to quash is promptly filed.

(d) *Deposition in a foreign language.* If an interpreter will be used during the deposition, the party calling the witness must initiate a conference with the Board at least five business days before the deposition.

(e) *Manner of taking testimony.* (1) Each witness before giving a deposition shall be duly sworn according to law by the officer before whom the deposition is to be taken. The officer must be authorized to take testimony under 35 U.S.C. 23.

(2) The testimony shall be taken in answer to interrogatories with any questions and answers recorded in their regular order by the officer, or by some other disinterested person in the presence of the officer, unless the presence of the officer is waived on the record by agreement of all parties.

(3) Any exhibits relied upon must be numbered according to the numbering scheme assigned for the contested case and must, if not previously served, be served at the deposition.

(4) All objections made at the time of the deposition to the qualifications of the officer taking the deposition, the manner of taking it, the evidence presented, the conduct of any party, and any other objection to the proceeding shall be noted on the record by the officer. Evidence objected to shall be taken subject to a ruling on the objection.

(5) When the testimony has been transcribed, the witness shall read and sign (in the form of an affidavit) a transcript of the deposition unless:

(i) The parties otherwise agree in writing, (ii) The parties waive reading and signature by the witness on the record at the deposition, or

(iii) The witness refuses to read or sign the transcript of the deposition.

(6) The officer shall prepare a certified transcript by attaching to the transcript of the deposition a certificate in the form of an affidavit signed and sealed by the officer. Unless the parties waive any of the following requirements, in which case the certificate shall so state, the certificate must state:

(i) The witness was duly sworn by the officer before commencement of testimony by the witness;

(ii) The transcript is a true record of the testimony given by the witness;

(iii) The name of the person who recorded the testimony and, if the officer did not record it, whether the testimony was recorded in the presence of the officer;

(iv) The presence or absence of any opponent;

(v) The place where the deposition was taken and the day and hour when the deposition began and ended;

(vi) The officer has no disqualifying interest, personal or financial, in a party; and

(vii) If a witness refuses to read or sign the transcript, the circumstances under which the witness refused.

(7) The officer must promptly provide a copy of the transcript to all parties. The proponent of the testimony must file the original as an exhibit.

(8) Any objection to the content, form, or manner of taking the deposition, including the qualifications of the officer, is waived unless made on the record during the deposition and preserved in a timely filed miscellaneous motion to exclude.

(f) *Costs.* Except as the Board may order or the parties may agree in writing, the proponent of the testimony shall bear all costs associated with the testimony, including the reasonable costs associated with making the witness available for the cross-examination.

§ 41.158 Expert testimony; tests and data.

(a) Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight. Testimony on United States patent law will not be admitted.

(b) If a party relies on a technical test or data from such a test, the party must provide an affidavit explaining:

(1) Why the test or data is being used,

(2) How the test was performed and the data was generated,

(3) How the data is used to determine a value,

(4) How the test is regarded in the relevant art, and

(5) Any other information necessary for the Board to evaluate the test and data.

Subpart E—Patent Interferences

§ 41.200 Procedure; pendency.

(a) A patent interference is a contested case subject to the procedures set forth in subpart D of this part.

(b) A claim shall be given its broadest reasonable construction in light of the specification of the application or patent in which it appears.

(c) Patent interferences shall be administered such that pendency before the Board is normally no more than two years.

§ 41.201 Definitions.

In addition to the definitions in §§ 41.2 and 41.100, the following definitions apply to proceedings under this subpart:

Accord benefit means Board recognition that a patent application provides a proper constructive reduction to practice under 35 U.S.C. 102(g)(1).

Constructive reduction to practice means a described and enabled anticipation under 35 U.S.C. 102(g)(1) in a patent application of the subject matter of a count. *Earliest constructive reduction to practice* means the first constructive reduction to practice that has been continuously disclosed through a chain of patent applications including in the involved application or patent. For the chain to be continuous, each subsequent application must have been co-pending under 35 U.S.C. 120 or 121 or timely filed under 35 U.S.C. 119 or 365(a).

Count means the Board's description of the interfering subject matter that sets

the scope of admissible proofs on priority. Where there is more than one count, each count must describe a patentably distinct invention.

Involved claim means, for the purposes of 35 U.S.C. 135(a), a claim that has been designated as corresponding to the count.

Senior party means the party entitled to the presumption under § 41.207(a)(1) that it is the prior inventor. Any other party is a *junior party.*

Threshold issue means an issue that, if resolved in favor of the movant, would deprive the opponent of standing in the interference. Threshold issues may include:

(1) No interference-in-fact, and

(2) In the case of an involved application claim first made after the publication of the movant's application or issuance of the movant's patent:

(i) Repose under 35 U.S.C. 135(b) in view of the movant's patent or published application, or

(ii) Unpatentability for lack of written description under 35 U.S.C. 112(1) of an involved application claim where the applicant suggested, or could have suggested, an interference under § 41.202(a).

§ 41.202 Suggesting an interference.

(a) *Applicant.* An applicant, including a reissue applicant, may suggest an interference with another application or a patent. The suggestion must:

(1) Provide sufficient information to identify the application or patent with which the applicant seeks an interference,

(2) Identify all claims the applicant believes interfere, propose one or more counts, and show how the claims correspond to one or more counts,

(3) For each count, provide a claim chart comparing at least one claim of each party corresponding to the count and show why the claims interfere within the meaning of § 41.203(a),

(4) Explain in detail why the applicant will prevail on priority,

(5) If a claim has been added or amended to provoke an interference, provide a claim chart showing the written description for each claim in the applicant's specification, and

(6) For each constructive reduction to practice for which the applicant wishes to be accorded benefit, provide a chart showing where the disclosure provides a constructive reduction to practice within the scope of the interfering subject matter.

(b) *Patentee.* A patentee cannot suggest an interference under this section but may, to the extent permitted under § 1.99 and § 1.291 of this title, alert the examiner of an application claiming interfering subject matter to the possibility of an interference.

(c) *Examiner.* An examiner may require an applicant to add a claim to provoke an interference. Failure to satisfy the requirement within a period (not less than one month) the examiner sets will operate as a concession of priority for the subject matter of the claim. If the interference would be with a patent, the applicant must also comply with paragraphs (a)(2) through (a)(6) of this section. The claim the examiner proposes to have added must, apart from the question of priority under 35 U.S.C. 102(g):

(1) Be patentable to the applicant, and

(2) Be drawn to patentable subject matter claimed by another applicant or patentee.

(d) *Requirement to show priority under 35 U.S.C. 102(g).* (1) When an applicant has an earliest constructive reduction to practice that is later than the apparent earliest constructive reduction to practice for a patent or published application claiming interfering subject matter, the applicant must show why it would prevail on priority.

(2) If an applicant fails to show priority under paragraph (d)(1) of this section, an administrative patent judge may nevertheless declare an interference to place the applicant under an order to show cause why judgment should not be entered against the applicant on priority. New evidence in support of priority will not be admitted except on a showing of good cause. The Board may authorize the filing of motions to redefine the interfering subject matter or to change the benefit accorded to the parties.

(e) *Sufficiency of showing.* (1) A showing of priority under this section is not sufficient unless it would, if unrebutted, support a determination of priority in favor of the party making the showing.

(2) When testimony or production necessary to show priority is not available without authorization under § 41.150(c) or § 41.156(a), the showing shall include:

(i) Any necessary interrogatory, request for admission, request for production, or deposition request, and

(ii) A detailed proffer of what the response to the interrogatory or request would be expected to be and an explanation of the relevance of the response to the question of priority.

§ 41.203 Declaration.

(a) *Interfering subject matter.* An interference exists if the subject matter of a claim of one party would, if prior art, have anticipated or rendered obvious the subject matter of a claim of the opposing party and vice versa.

(b) *Notice of declaration.* An administrative patent judge declares the patent interference on behalf of the Director. A notice declaring an interference identifies:

(1) The interfering subject matter;

(2) The involved applications, patents, and claims;

(3) The accorded benefit for each count; and

(4) The claims corresponding to each count.

(c) *Redeclaration.* An administrative patent judge may redeclare a patent interference on behalf of the Director to change the declaration made under paragraph (b) of this section.

(d) A party may suggest the addition of a patent or application to the interference or the declaration of an additional interference. The suggestion should make the showings required under § 41.202(a) of this part.

§ 41.204 Notice of basis for relief.

(a) *Priority statement.* (1) A party may not submit evidence of its priority in addition to its accorded benefit unless it files a statement setting forth all bases on which the party intends to establish its entitlement to judgment on priority.

(2) The priority statement must:

(i) State the date and location of the party's earliest corroborated conception,

(ii) State the date and location of the party's earliest corroborated actual reduction to practice,

(iii) State the earliest corroborated date on which the party's diligence began, and

(iv) Provide a copy of the earliest document upon which the party will rely to show conception.

(3) If a junior party fails to file a priority statement overcoming a senior party's accorded benefit, judgment shall be entered against the junior party absent a showing of good cause.

(b) *Other substantive motions.* The Board may require a party to list the motions it intends to file, including sufficient detail to place the Board and the opponent on notice of the precise relief sought.

(c) *Filing and service.* The Board will set the times for filing and serving statements required under this section.

§ 41.205 Settlement agreements.

(a) *Constructive notice; time for filing.* Pursuant to 35 U.S.C. 135(c), an agreement or understanding, including collateral agreements referred to therein, made in connection with or in contemplation of the termination of an interference must be filed prior to the termination of the interference between

the parties to the agreement. After a final decision is entered by the Board, an interference is considered terminated when no appeal (35 U.S.C. 141) or other review (35 U.S.C. 146) has been or can be taken or had. If an appeal to the U.S. Court of Appeals for the Federal Circuit (under 35 U.S.C. 141) or a civil action (under 35 U.S.C. 146) has been filed the interference is considered terminated when the appeal or civil action is terminated. A civil action is terminated when the time to appeal the judgment expires. An appeal to the U.S. Court of Appeals for the Federal Circuit, whether from a decision of the Board or a judgment in a civil action, is terminated when the mandate is issued by the Court.

(b) *Untimely filing.* The Chief Administrative Patent Judge may permit the filing of an agreement under paragraph (a) of this section up to six months after termination upon petition and a showing of good cause for the failure to file prior to termination.

(c) *Request to keep separate.* Any party to an agreement under paragraph (a) of this section may request that the agreement be kept separate from the interference file. The request must be filed with or promptly after the agreement is filed.

(d) *Access to agreement.* Any person, other than a representative of a Government agency, may have access to an agreement kept separate under paragraph (c) of this section only upon petition and on a showing of good cause. The agreement will be available to Government agencies on written request.

§ 41.206 Common interests in the invention.

An administrative patent judge may decline to declare, or if already declared the Board may issue judgment in, an interference between an application and another application or patent that are commonly owned.

§ 41.207 Presumptions.

(a) *Priority*—(1) *Order of invention.* Parties are presumed to have invented interfering subject matter in the order of the dates of their accorded benefit for each count. If two parties are accorded the benefit of the same earliest date of constructive reduction to practice, then neither party is entitled to a presumption of priority with respect to the other such party.

(2) *Evidentiary standard.* Priority may be proved by a preponderance of the evidence except a party must prove priority by clear and convincing evidence if the date of its earliest constructive reduction to practice is after the issue date of an involved patent or the publication date under 35 U.S.C. 122(b) of an involved application or patent.

(b) *Claim correspondence.* (1) For the purposes of determining priority and derivation, all claims of a party corresponding to the count are presumed to stand or fall together. To challenge this presumption, a party must file a timely substantive motion to have a corresponding claim designated as not corresponding to the count. No presumption based on claim correspondence regarding the grouping of claims exists for other grounds of unpatentability.

(2) A claim corresponds to a count if the subject matter of the count, treated as prior art to the claim, would have anticipated or rendered obvious the subject matter of the claim.

(c) *Cross-applicability of prior art.* When a motion for judgment of unpatentability against an opponent's claim on the basis of prior art is granted, each of the movant's claims corresponding to the same count as the opponent's claim will be presumed to be unpatentable in view of the same prior art unless the movant in its motion rebuts this presumption.

§ 41.208 Content of substantive and responsive motions.

The general requirements for motions in contested cases are stated at § 41.121(c).

(a) In an interference, substantive motions must:

(1) Raise a threshold issue,

(2) Seek to change the scope of the definition of the interfering subject matter or the correspondence of claims to the count,

(3) Seek to change the benefit accorded for the count, or

(4) Seek judgment on derivation or on priority.

(b) To be sufficient, a motion must provide a showing, supported with appropriate evidence, such that, if unrebutted, it would justify the relief sought. The burden of proof is on the movant.

(c) *Showing patentability.* (1) A party moving to add or amend a claim must show the claim is patentable.

(2) A party moving to add or amend a count must show the count is patentable over prior art.

Dated: July 28, 2004.

Jon W. Dudas,

Acting Under Secretary of Commerce for Intellectual Property and Acting Director of the United States Patent and Trademark Office.

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